

appears, by the evidence of the plaintiff, that although at the time he testified he had owned the patent for seven years, he had never put on the market a chair constructed to conform to it. A novelty which remains unused so many years in the hands of an extensive manufacturer exclusively engaged in the special trade to which it relates must be presumed, at best, to involve a very low degree of the useful novelty which the Patent Code of the United States requires. The bill was dismissed.

Waite *v.* Robinson *et al.*, U. S. C. C., D. Mass., *Putnam, J.*, 15 Sep., 1892, 60 O. G., 1888.

20. Antedating Reference.

The mere fact that an applicant can antedate a reference patent does not necessarily clothe his improvement with patentable quality.

White, x. p., *Mitchell, Com.*, 12 Sep., 1890, 54 O. G., 387.

21. Medicinal Compound.

Examiner rejected because mischievous or of doubtful utility: *Held*, if an article is incapable of any use whatever except a dangerous or an immoral one it is not patentable; but, if it be capable of *any* beneficial use it is patentable regardless of the fact that it may be used by ignorant persons to produce a harmful result, or by wicked persons to produce an immoral result. While, however, denying the Examiner's ground of rejection, it is suggested that the case may nevertheless be open to *the objection that the compound sought to be monopolized may be within the scope of the ordinary skill of the physician in prescribing remedies familiar to his profession.*

Crippen, x. p., *Fisher, Act. Com.*, 18 Feb., 1890, C. D. Ms.
Compare Nat. Aut. Device Co. *v.* Lloyd *et al.*, (23) *infra*.

22. Electrical (alleged) curative Device.

Before an apparatus for applying electricity as a curative agent can be patented as an electrical device, it must be clear that the effects are the result of electrical treatment by means of the apparatus and not the effects of expectant attention or imagination.

Sauche, x. p., *Frothingham, Act. Com.*, 24 Mar., 1892, C. D. Ms.

Compare Crippen, x. p., (21) *supra*.

23. Patent for a Gambling Apparatus adjudged invalid.

In an action for infringement of a patent for a "Toy Automatic Race Course," injunction, *pendente lite*, refused on the ground that it was not certain that it was a *useful* invention within the meaning of the patent law, inasmuch as the proofs showed that the only use it had been put to was for gambling purposes. The United States law authorizes the issue of a patent only for a new and *useful* invention, and in an early case on that subject (*Bedford v. Hunt*, 1 Mason, 302) it was held that the word "useful," as used in the statute, means such an invention as may be applied to some beneficial use in society in contradistinction to an invention which is injurious to the morals, health, or good order of society and the principle thus enunciated has been uniformly applied ever since.

National Automatic Device Co, v. Lloyd et al., U. S. C. C., N. D. Ill. *Blodgett, J.*, 40 F. R., 89.

24. Patents should not, it seems, be granted for mere systems of keeping accounts or of penmanship and the like.

Dick, x. p., *Thacher, Act. Com.*, 26 July, 1872, 2 O. G., 148.

PATENTABLE COMBINATION.

In a patentable combination of old elements all must co-act with a new and beneficial result.

In a patentable combination of old elements, all the constituents must so enter into it as that each qualifies every other. It must form either a new machine of a distinct character and function, or produce a result due to the joint and co-operating action of all the elements, and which is not the mere adding together of separate contributions. The combination of old devices into a so-called new article, without producing any new mode of operation, is not invention (*Pickering v. McCullough*, 104 U. S., 310,*).

Florsheim et al. v. Schilling, U. S. S. C. By *Lamar, J.*, 10 Nov., 1890, 53 O. G., 1737, *.

Compare *Coes*, x. p., (1) *et seq.*, COMBINATION; also *Railway Register M'f'g Co. v. 3d Ave. R. R. Co.*, (23) INVENTION.

PATENTABLE NOVELTY.**Simplification and Reorganization.**

Where applicant's exact combination was not found in any of the references, and his combination was practically a simplification and reorganization of the construction in one of the references: *Held*, upon the showing made, that it was not clear that this simplification and reorganization did not involve invention, and the decision of the Examiners-in-Chief denying patentable novelty was reversed.

Ennis, x. p., *Simonds, Com.*, 22 Mar., 1892, C. D. Ms.

Compare *Prince, Jr.*, x. p., (18) PATENTABILITY.

"PATENT MEDICINES."

A remedial compound which is nothing more than such a compound of medicinal agents as could be made by the exercise of the skill of a physician, is not patentable.

Crippen, x. p., *Fisher, Act. Com.*, 24 May, 1890, C. D. Ms.

NOTE. — It is, perhaps, almost needless to say that the phrase "*Patent Medicine*" ordinarily applied to remedial nostrums generally is a complete misnomer. Of the innumerable "proprietary preparations" seen in every modern drug-store, very few are patented, for two valid reasons, either of them sufficient, namely: —

(1) A patent would necessarily divulge the ingredients, a thing which no concocter of proprietary merchandise was ever known voluntarily to do.

(2) Although our statutes do not expressly exclude medicinal compounds (as the patent laws of some countries do), the records show that but few applications therefor eventuate in patents, for reasons akin to those set forth in the case of Crippen, x. p., above cited.

Compare Sauche, x. p., (22) PATENTABILITY; and McClain v. Ortmyer, (2), *, PUBLIC ADOPTION.

PENALTY.

1. A penalty of "not less" than \$100, with cost of suit, is incurred by the marker of each unpatented article with the word "Patent" or like phrase with intent to deceive the public, or by one who makes unauthorized use of a patentee's mark.

R. S. 4901.

2. If a person marks an unpatented article with the word "patent," the public are thereby liable to be deceived as to the character and value of the article. The act is a species of counterfeiting. This being so,

the presumption is, until the contrary appears, that the mark was placed upon the article with intention to deceive. *Falsehood is a badge of fraud.*

Oliphant v. Salem Mills Co., Deady, J., 1878, 5 Sawyer, 128.

3. Where it is sought to recover a penalty for improperly stamping an article as patented, the penalty is incurred if he who affixes the stamp does so in entire ignorance of whether the article is patented or not.

Thompkins v. Butterfield, Nelson, J., 1 Oct., 1885, 33 O. G., 758.

4. Under the statute anybody is privileged to bring an action against the marker of an unpatented article with the word "patent." If the jury find that the person who marked such articles did so with deceptive intent, then all other questions are impertinent, and it is the duty of the jury to find a verdict of guilty. The jury have a right to infer from the evidence whether this is a patented or unpatented article, and the fact that there is no evidence of a patent is to be taken into consideration.

Kass v. Hawlowetz, Brown, J., 10 Ap., 1885, 33 O. G., 1135; and 33 O. G., 1499.

See also *Hawlowetz v. Kass, Wallace, J., 24 Nov., 1885.*

PETITION, see JURISDICTION; PRACTICE IN THE PATENT OFFICE.

PERFECTING INVENTIONS.

The law, while it requires that the original projector be diligent in perfecting his invention, is indulgent of some delay in seeking the Patent Office due to the inventor's desire to overcome all defects and to test the truth of his theory.

Where an inventor of a device as important as that in controversy, who has been diligent in reducing his

invention to practice, and in attempts to bring his machine to the knowledge of the public has merely paused, before applying for his patent, for a period of nineteen months after completing his working drawings, and ten months after he completed his machine; I cannot say that there were such *laches* as should deprive him of the reward which ordinarily attends priority of invention. Our inventors are more apt, I suppose, to go into the Patent Office with incomplete inventions than to wait too long after experiment has achieved perfection. A decision which should compel haste in applying for patents before actual practice has tested the truth of the inventor's theory and has overcome difficulties in the operation of mechanism, would, I think, be productive of more injury than a decision which, while compelling diligence in perfecting the invention, was indulgent of some delay in seeking the Patent Office.

Hubel v. Dick and *Hubel v. Tucker*, *Shipman, J.*, 16 July, 1886, 36 O. G., 939.

See also *City of Elizabeth v. Nicholson Pavement Co.*, 24 U. S., 1000; and 97 U. S., 126, *; and *Hunter v. Miller, Mitchell, Com.*, 13 Mar., 1890, 50 O. G., 1765.

See ABANDONMENT; CONSUMMATED INVENTION; DILIGENCE; INTERFERENCE; INVENTION; INVENTIVE ACTS; PUBLIC USE; REDUCTION TO PRACTICE.

PERSONAL NAME.

I. Arbitrary use of applicant's name to designate a class of manufacture forbidden.

Where the applicant employed in the specification the words "Forbes Combined Slide Hinge-Joint," to designate a certain slide joint of which he believed himself the inventor, and which was a part of the machine for which he sought a patent, but there was no proof that

the joint had become known in the art by that name : *Held*, that the Examiner was correct in requiring the name to be eliminated. If the use of such an expression is ever permissible, it is only when the machine or mechanism referred to has become commonly known by such name in the prior art.

Forbes, x. p., *Mitchell, Com.*, 14 Oct., 1889, C. D. Ms.

2. Where, in the petition and in the preamble of the specification, the inventor's name was used to designate the alleged invention, and *it did not appear that the machines alluded to were commonly known in the art or trade by the name referred to* : *Held*, that the utmost that could be allowed under such circumstances was that the applicant should be permitted to say that the machine of which his present invention is an improvement is the one for which an application for letters-patent has been filed by himself.

Ib.

Compare Street, x. p., (6) PHRASEOLOGY.

PETITION.

1. Where applicant believes that the Examiner has improperly declined to incorporate matter within the recommendation of the Examiners-in-Chief, his remedy is by petition to the Commissioner (Holt, x. p., 1887, C. D. 4).

Roberts, x. p., *Mitchell, Com.*, 18 Dec., 1890, C. D. Ms.

2. Should be explicit.

A petition under Rule 145 should set forth "concisely and clearly" the action complained of, and, if it does not, it cannot be amended by presenting in the brief what should have been presented in the petition, for the

reason that the Examiner's statement is filed in reply to the petition.

Wilson, x. p., *Mitchell, Com.*, 17 Mar., 1891, C. D. Ms.

PHRASEOLOGY.

1. Latitude of Choice permitted.

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

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

Compare, of like purport, Myers, x. p., (21) AMENDMENT; Gray & Reynolds, x. p., (2) APPLICANT; Holt, x. p., (1) NEW MATTER; and Noyes, x. p., (9) SPECIFICATION.

2. Applicant may describe his invention in his own way.

Where the terms employed by applicant are not misleading, the mere fact that the Examiner regards other terms as more desirable is not a sufficient reason for insisting upon them, although the latter may be of more general acceptance.

Wharton, x. p., *Frothingham, Act. Com.*, 18 June, 1892, C. D. Ms.

3. Applicant's Phraseology sustained.

An objection that there was no such device as a "projection," and that the trigger was operated by a "stud" not a "lever:" *Overruled*, as it was clear that, by the word "projection" was meant "lever," and that the stud was a part of the lever.

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

4. Question of Form subordinate to Question of Right.

An applicant cannot be rightfully denied adequate protection for his invention merely because *the form* of his claim differs from what is considered to be that of an ideal process-claim (Painter, x. p., 57 O. G., 999).

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

Compare Noyes, x. p., (9) SPECIFICATION; Cheeseborough, x. p., (6) RE-OPENING OF CASE.

5. Inventor's rights should not be prejudiced by imperfections of the English language.

When a man has made a new and useful invention, his right to a patent for it, or his right to a claim properly defining it, is not to be determined by the limitations of the English language.

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

Compare Ambler, x. p., (2) PIONEER INVENTION.

6. Arbitrary Name refused. — Trade-mark.

The Examiner objected to the use of a term which was purely arbitrary and had no accepted meaning, but the applicant believed it advisable for the material to have a name, and that he was the proper person to name it: *Held*, sustaining the objection, — if applicant desired a trade-mark for the term, he should apply for it in the proper way.

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

Compare Forbes, x. p., (1), (2) PERSONAL NAME.

7. A Matter of "Form."

The Primary Examiner is not estopped from objecting to the description of a device by the fact that the Examiners-in-Chief had, upon appeal, allowed the claim covering the device; for the Examiner's objection, being

one of form, was not properly before the Examiners-in-Chief for consideration on appeal.

Robbins, x. p., *Frothingham, Act. Com.*, 21 Aug., 1891, C. D. Ms.

8. Structure of Claim.

The Examiner objected to the claims on the ground that they "comprise merely a catalogue of the various parts without setting forth their structures, connection, and relation:" *Held*, that the criticism appeared to be substantially correct, and it would probably be for applicant's best interest to revise them in accordance with the suggestion contained therein; but, as the objection did not appear to be vital, if applicant wished the claims to remain in that form he should not be denied them, except for reasons on which a rejection might be based.

Wharton, x. p., *Frothingham, Act. Com.*, 18 June, 1892, C. D. Ms.

PIONEER INVENTION.

1. Permissible Language, — "Means;" "Mechanism."

The decisions indicate that 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 with reference to the prior state of the art, and that no requirements as to form should be insisted upon which would prevent an applicant from obtaining claims commensurate with his invention in view of such prior art. (See *Laskey*, x. p., 48 O. G., 539; *Ambler*, x. p., C. D. 41 Ms. 209; *Nordenfelt*, C. D. 42 Ms. 141; and *Sewing M. Co. v. Lancaster*, 129 U. S., 263; 32 L. ed., 715, *).

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

Compare *Nordenfelt*, x. p., (5) "MEANS;" also *Clouser*, x. p., (4) "MEANS," and other cases there cited.

2. "Mechanism."

Where the Examiner admitted that the invention did not reside in the *word* "mechanism," but insisted that, so far as the claims indicated, the word "mechanism" designated that portion of the claims in which the novelty resided, and that, inasmuch as there were no qualifying words setting forth construction or mode of operation, the claims were indefinite: *Held*, that the question was not free from difficulty; that it was extremely doubtful whether the claims should be interpreted in the light of the doctrine as announced with reference to the 13th claim in the case of Pacholder, x. p., (51 O. G., 295), or whether they should be interpreted in the light of the doctrine as announced in the cases cited in par. 15, *supra*, and inasmuch as the case was so near the border line between the doctrines as announced in the cases cited, and as the issue raised between the Examiner and the applicant was so nearly allied to questions relating to the "*merits*" of the case; *further held* that the more advisable course was to direct the Examiner to reject the claims if they were, in his opinion, too broad in view of the state of the art, or if they merely covered a result, than to compel applicant to limit his claims to such an extent as to make his invention an easy prey to the infringer. The claims were held to be intelligible.

Ib.

3. Where no references are found, the petitioner is entitled to the application of whatever rule is appropriate to pioneer inventions, and no questions of form are to be antecedently insisted upon which are inconsistent with the allowance of the broadest claims to which the creator of a new machine or art is entitled. Such a case distinguished from Demming, x. p., (26 O. G., 1207).

Ambler, x. p., *Mitchell, Com.*, 31 Oct., 1889, C. D. Ms.

Compare Dalton (7) INVENTION.

4. Broad Construction,—how affected by Ambiguity.

Claims ambiguous in their phraseology or to performances, functions, results, to abstract ideas or principles without reference to specified instrumentalities, are inadmissible and ought not to be granted.

Sangster v. Miller, *Nelson, J.*, 2 Fish., 563. See, also, *Continental Windmill Co.*, x. p., *Duncan, Act. Com.*, 27 July, 1870, C. D. 74; *Barrett*, x. p., 1888, C. D. 142; *Rubens & Co.*, x. p., *Fisher, Com.*, 6 Dec., 1869, C. D. 107; *Sherwood v. Searles*, *Fisher, Com.*, 20 Dec., 1869, C. D. 112; *Simonds*, x. p., *Fisher, Com.*, 14 Mar., 1870, C. D. 23.

5. Yet, rather than invalidate or weaken a patent for an important invention, courts have usually, — where the language of the claim makes it at all possible, — endeavored to construe such claim, in the first place, to mean the instrumentalities or devices described in the specifications, and, in the second place, to accord it such scope as to dominate all substantially equivalent devices even though improvements on the original.

Dolbear et al. v. Am. Bell Telephone Co., 19 March, 1888, 43 O. G., 377, ✱.

See, also, *Lull v. Clark et al.*, *Blatchford, J.*, 8 Aug., 1882, 22 O. G., 1535; *Morley Machine Co. v. Lancaster*, 4 Feb., 1889, 129 U. S., 263, ✱; *Smith and Egge M'f'g Co. v. Bridgeport Chain Co.*, *Shipman, J.*, 56 O. G., 1451; *Worswick M'f'g Co. v. City of Buffalo*, *Coze, J.*, 8 May, 1884, 27 O. G., 1239.

• See, however, *O'Reilly v. Morse*, 15 Howard, 1862, and *Detwold v. Reeves*, *Kane, J.*, Sep., 1851, 1 Fish., 127.

PLEADING.

1. Averments in Bill.

A bill for infringement of letters-patent must state that the invention had not been in public use or on sale for more than two years before the application therefor.

It is not sufficient to state that it was not in public use or on sale with the consent of the inventor (following *Blessing v. Copper Wks.*, 34 F. R., 753).

Coop v. Savage, etc., U. S. C. C., S. D. N. Y., *Shipman, J.*, 47 F. R., 899.

2. Demurrer, — General and Special.

While an averment in the bill that the patentee was "the first inventor of the improvement, and that it had not been known or used before his said invention," is sufficient to withstand a general demurrer, yet the omission of an averment that it had not been previously patented or described in a printed publication, is a defect in form, which may, however, be reached by special demurrer and should be remedied by amendment.

Ib.

3. Scandalous Answer.

An answer which alleges that complainant's patent "was obtained by trick, artifice, and deception, and with the knowledge of the Commissioner," said allegation being made after a judgment in defendant's favor in interference proceedings concerning that identical invention, is not scandalous or impertinent.

Acaubert v. Appleton, U. S. C. C., S. D. N. Y., *Coxe, J.*, 47 F. R., 893.

4. Multifariousness.

A bill which claims relief because of an alleged interference between the patents of the complainant and the defendant, and also because of defendant's alleged infringement of complainant's patent, is not multifarious.

Stonemetz Co. v. Brown Co., U. S. C. C., W. D. Pa., *Reed, J.*, 46 F. R., 72.

POWER OF ATTORNEY.**Underlying Principle of Equity.**

L and *J* have a joint application for a certain improvement on which there is at present no attorney of record.

L has a subsequently filed sole application for the same improvement with attorneys duly appointed.

J, — together with *C*, an assignee of *L*, — now present a paper appointing as attorney, in the former of these applications, an agent who has never before appeared in either.

The underlying principle of equity warrants the approval of the power of attorney presented by *J* and *C*, and it is accordingly approved and accepted.

L. W. Benjamin and J. S. Bailey, x. p., *Simonds, Com.*, 1 Mar., 1892, 59 O. G., 298.

See ATTORNEY.

PRACTICAL DEMONSTRATION.**1. Applicant's Choice of two Courses.**

Where Examiner's requirement that a working model or other practical demonstration of petitioner's alleged invention be furnished seemed reasonable and proper: *Held*, that there were only two courses open to the petitioner, — he should either make a demonstration of the operativeness of his invention, or demand a rejection from the Examiner upon the ground of inoperativeness.

Corson, x. p., *Fisher, Act. Com.*, 19 Ap., 1890, C. D. Ms.

Compare Street, x. p., ANALYSIS; also Perkins, x. p., (2) *infra*.

2. To negative Inoperativeness.

An objection that the mechanism disclosed is inoperative can be enforced in either of two ways. The Exam-

iner can either reject on the ground of inoperativeness subject to appeal to the Examiners-in-Chief, which is the best course, or he may require a practical demonstration. Applicant's objection that it would not be possible for him to make a practicable demonstration without infringing certain patents was not received as a valid excuse. The Assistant Commissioner was not willing to admit that such a demonstration would be held by the courts to constitute an infringement.

Perkins, x. p., *Fisher, Act. Com.*, 28 June, 1890, C. D. Ms.
Compare Corson, x. p., (1) *supra*.

3. When required.

Mere difficulty in examination is not sufficient ground for compelling an applicant to incur the expense of a model. The policy of the Office is *not to require a model* except when it is practically impossible to examine a given case without one.

Daudeteau x. p., *Fisher, Act. Com.*, 25 June, 1890.
Compare Corson, x. p., (1) *supra*.

PRACTICE IN THE PATENT OFFICE.

1. Objections that a claim is drawn to a bad combination, or that it is for an aggregation, or that it does not involve invention, pertain to "the merits," and an appeal lies to the Examiners-in-Chief.

Objections that a claim is indefinite, or that certain claims are substantially identical, pertain to "form," and a petition lies to the Commissioner.

The following practice is prescribed in the treatment of *ex parte* cases: —

(1) The first action (unless there are vital objections as to form) should state *all the objections* to every part of the application, and *the best references should be cited*.

(2) The application as a whole should not be rejected, but only the claims thereof.

(3) Rejection should be in plain, unmistakable terms, and the word "*reject*" should be used.

(4) Final rejection should not be given until all matters of form are settled.

(5) Final rejection should not be given until all the non-allowable claims are ready for such action.

Eastman, x. p., *Simonds, Com.*, 9 Oct., 1891, 57 O. G., 410.

2. Wherever practicable, Office action should be predicated on the Statutes and the Rules of Practice.

Interferences arise and are declared under the Statutes and the Rules of Practice [not under decisions], and, although the decision in Upton, x. p., is a very celebrated one, the practice of referring to it in declaring interferences which has heretofore obtained, to a limited extent, is one which is not to be commended, and should be wholly discontinued.

Boetney v. Curtis v. Kutsche, *Mitchell, Com.*, 1 Dec., 1890, C. D. Ms.

3. Change of Practice.

Where a decision of the Patent Office or other tribunal cannot be reconciled with the ruling of a superior tribunal or one of its own earlier rulings on the same state of facts, such decision, in accordance with a well-known principle of law, must be taken to mark a change in the practice to which subsequent actions must necessarily conform; this is very notably the case when such departure is taken with the object of making the Patent Office procedures conformable with some ruling of a United States Court, or with the provisions of some new Federal statute. This latter aspect of the case was clearly stated by Commissioner Simonds in case of Penny v. Gunn (13 Aug., 1891). Illustrations of this fundamental principle of law are given by Blackstone in such passages as: "Of two repugnant clauses in a will, the latter shall stand" (2 Com. 381); and, "Where the common law and

a statute differ, the common law gives place to the statute, and an old statute gives place to a new one; and this upon a general principle of universal law that '*leges posteriores priores contrarias abrogant*,' consonant to which it was laid down by a law of the Twelve Tables of Rome that '*quod populus postremum jussit id jus ratum esto.*'"

1 *Blackstone, Com.*, 89.

See COMMISSIONER, ETC. ; EXAMINATION ; EXAMINER ; OFFICE PRACTICE.

THE PRELIMINARY STATEMENT.

1. Return to Applicant — refused.

Where a preliminary statement had been filed by the senior party to an interference, but not used for the reason that the junior party's statement failed to overcome the filing date of the senior party's application, a petition requesting a return of the preliminary statement was denied without prejudice, because the rules require that a preliminary statement shall be filed, but make no provision for their return.

NOTE. — The Assistant Commissioner remarked, however, that in a case like the one under discussion there seemed no reason for the Rule 112 requiring retention of the preliminary statement; but that, as no brief had been filed and no argument made in support of the petition, it might be that, upon a full discussion of the question, other considerations might be presented which might lead to a modification of his views.

Baxter, x. p., *Frothingham, Act. Com.*, 10 June, 1891, C. D. Ms.

See 26, 27, 28, 29 INTERFERENCE.

2. Amendment Refused.

In discussing debatable questions it sometimes becomes profitable in a high degree to recur to fundamental prin-

ciples. Human tribunals do not proceed on the theory that they do exact justice to every suitor. That result is only possible to Omniscience. Human tribunals proceed on the theory that they do substantial justice in the great majority of cases. Certain well-known laws are based on that theory, with the full knowledge that they sometimes necessarily work injustice. . . . A preliminary statement in an interference case is based on the same kind of theory. It is a thing healthful for general application, but it must sometimes work a hardship in a particular case. But if, after the junior party has taken his testimony, the senior party, who has already once amended his preliminary statement, can again amend his preliminary statement by the addition of facts presumably within his knowledge at the time when the statement was originally filed, the rule requiring preliminary statements might as well be abrogated, and this irrespective of the question whether the new averment be true or false.

Washburn v. Hadfield, Simonds, Com., 10 Dec., 1891, 57 O. G., 1719.

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

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

See EXAMINER ; COMMISSIONER ; INTERFERENCE.

PRESUMPTIVE PATENTABILITY.

In the absence of satisfactory evidence to the contrary, the subject-matter of every patent is presumed to be useful and patentable.

Mesker et al. v. Thuener, Thayer, J., 30 Oct., 1889, U. S. Cir. Ct., E. D. Mo., 42 F. R., 329.

PRESUMPTIVE REDUCTION TO PRACTICE, see CONSTRUCTIVE REDUCTION TO PRACTICE.

PRIOR ART.

1. In pointing out the advantages of his invention, the applicant may refer generally to defects of pre-existing devices, but is forbidden to particularize such devices by name.

In the cases of *Dodge*, x. p. (Dec., 1889, M. S. 36), and *Williams*, x. p. (1872, C. D. 46), each applicant had undertaken to show the superiority of his own invention by comparing it with other inventions which were indicated directly by name, and by pointing out the respects in which they had wholly or partially failed. Elimination of such references was properly demanded; but a broad distinction is to be made between statements derogatory to the inventions of others clearly designated by the name of the inventor, or otherwise, and that permissible criticism of the prior art generally which an applicant may deem necessary in order to appropriately set forth the advantages growing out of his own invention. It may be difficult to draw the line; but the line must be drawn, and it must be held that, within reasonable limits, an applicant may, in pointing out the advantages of his invention, point out also what he regards as the defects or deficiencies common to the structures representing the unimproved art.

Shaw, x. p., *Mitchell, Com.*, 12 Feb., 1890, 50 O. G., 1129.

Compare *Wiles & Wendell et al.*, (5) *infra*.

2. Former Patent of Applicant.

Where the Examiner cited against applicant's application filed 21 June, 1888, a patent issued to him 10 July, 1888: *Held*, that it was error to treat a patent to the same party as a part of "the prior art."

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

Compare *Hill & Prentice*, x. p., (1) DEDICATION.

3. History of the prior art permissible to show that the changes were not obvious.

The subject-matter was a glove, and it was found that, while the advantage attained by applicant was fairly apparent, it also needed but little effort to find the claim met by the prior art, but the fact that the trouble which the improvement was designed to cure was one that had been made apparent by common experience, and was of such a nature that it would have been cured long ago if the mode of effecting the cure had been obvious and easily apparent, was held to make strongly in applicant's favor, and the claim was allowed. The difference over the prior art which applicant had obtained was not considered a large difference, but, nevertheless, capable of definition and highly useful in character.

Lee, x. p., *Simonds, Com.*, 15 June, 1892, C. D. Ms.

4. Where the change in form and proportion over the prior art brought with it substantial advantages, and the history of the development of the art showed that those changes were not obvious: *Held*, that the invention was patentable.

Condict, Jr., x. p., *Simonds, Com.*, 8 June, 1892, C. D. Ms.

5. General comparison with prior state of the art proper.

The Examiner required that, if applicant undertook to set forth the prior art, he should set forth the advantages of his machine over pre-existing ones nearest his construction: *Held*, that the Examiner's requirement was proper, as it did not appear that he intended the statement to be based on a certain specified patent.

Wiles & Wendell, x. p., *Frothingham, Act. Com.*, 15 Feb., 1892, C. D. Ms.

PRIORITY IN THE INVENTION.

1. The law favors that inventor to whom the public is indebted for the thing invented in working form.

The policy of the patent-law is to reward the man from whom the public actually derives the benefit received, unless, in fact, another, prior in conceiving the invention, was proceeding to give it to the world [and did so give it] with no greater delay than what was imposed by circumstances beyond his control.

Mouce v. Adams, Duncan, Act. Com., 14 Ap., 1872, 1 O. G., 1.

2. The first to conceive is held to be the true inventor if he follows up the conception by diligent embodiment of the invention in an operative machine.

Invention is not the work of the hands but of the brain. The man who first conceived the complete idea of the improvement and gave evidence of the fact by representing the device on paper [or in a model], or by a clear and undisputed oral explanation, is the first inventor, but to perfect his rights of priority, the law requires that he shall either have been the first to file an application, or if he was not the first to file application, that he shall have used due diligence in so doing or in embodying his idea in a practical working machine.

Edison v. Foote & Randall, Leggett, Com., 25 Mar., 1871, C. D. 80.

3. The primary object of the patent laws is to encourage invention, but just the opposite effect is produced if an inventor is to understand that after he has completed an invention, obtained his patent upon it, and been to the expense of bringing it before the public demonstrating its practicability, and creating a demand for it, he may then be ousted from his rights in it by

some person who invented the same thing before he did, but, for want of confidence in it or other cause, put it aside, and left him to the expense of introducing it to the world and showing its value.

Disston v. Emerson, Leggett, Com., 6 June, 1871, C. D. 162.

4. But exception from this rule is made in favor of the one last to mature the invention if he had been the first to conceive and had used reasonable diligence.

Monce v. Adams, 1 O. G., 1.

5. The patentee, having put the public in complete possession of the invention in his specification, has fulfilled his part of the contract.

The grant of a patent having once been perfected, the inventor has fulfilled his part of the contract by thus placing the public in possession of a complete knowledge of the invention, and it matters not whether or not he has reduced the invention to [actual] practice, for the grant itself supplies the place of such embodiment, and, in order to enable an applicant to succeed in defeating the title already conferred, he must show: (a) that he was first to conceive of the nascent invention; (b) that he was using reasonable diligence in reducing the same to practice; and (c) that he had actually embodied the invention in working form at the date of his competitor's reduction to practice [either actual or constructive].

Burr v. Duryee, U. S. S. C. By *Grier, J.*, 28 Mar., 1864, 68 U. S., 531; see, also, *Busha v. Phelps, Doolittle, Act. Com.*, 18 Aug., 1876, 9 O. G., 1010; *Stephenson v. Goodell, Duell, Com.*, 3 June, 1876, 9 O. G., 1195; *Dickson v. Kinsman*, 18 O. G., 1225.

Compare *Lorraine v. Thurmond* (8) *infra*.

6. Proof that an invention was made in this country prior to the date of the foreign patent is sufficient to establish priority in an interference.

Chambers v. Duncan, Doolittle, Act. Com., 16 Feb., 1877, 10 O. G., 787.

7. *A* was first to conceive and first to apply for a patent. *B* was first to reduce to practice, and, for nearly a year prior to *A*'s application had been making and selling articles embodying the invention. Several years of neglect on the part of *A* had intervened between his conception and application, including the period after *B* entered the field: *Held*, *B* was the first inventor and entitled to a patent, although a patent had previously been granted to *A*.

Manny v. Easley v. Greenwood, *Mitchell, Com.*, 16 Aug., 1890, 51 O. G., 1617.

8. Actual reduction to practice is not the only competent evidence of perfection and adaptation to use; the inventor's act in being the first to enter the Office, with an allowable application, is regarded in law as such an efficient and crowning step as to give it the standing of an invention so perfected and adapted.

Lorraine v. Thurmond, *Mitchell, Com.*, 4 June, 1890, 51 O. G., 1781.

9. The general rule is that he who is the first to conceive of an invention is entitled to a patent for it if he reduces the same to practice with reasonable diligence; but, if he does not reduce to practice with reasonable diligence, he who is subsequent to conceive but first to reduce to practice will prevail (*Reed v. Cutter*, 1 Story, 590).

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

10. The perfected invention may be abandoned to the public, but cannot be forfeited to a subsequent inventor.

He is the prior inventor and is entitled to the patent for an invention who first embodies it in a complete,

practical, working utensil and exhibits it in public, though another afterward reduces it to practice and applies for a patent before him. After such an embodiment of an invention, delay in applying for a patent can operate only as an abandonment of the invention to the public; it is not forfeited thereby in favor of a subsequent inventor.

Rice v. Winchester, Leggett, Com., 3 Ap., 1873, 3 O. G., 348.

11. When a prior inventor has carried his invention as far as a subsequent one has carried his before applying for a patent, the prior inventor must have perfected his invention if the latter has, and it is either true that the invention is not perfected in law or else that the last inventor is anticipated.

Gray v. Hale, Duncan, Act. Com., 27 May, 1871, C. D. 129.

12. Preponderance of Evidence.

The question of priority of invention is determined by a fair preponderance of evidence, and doubts raised as to accuracy of witnesses upon certain minor points are not sufficient to overcome it.

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

13. Foreign Patent to same Applicant.

In an interference between an application and a patent, where the applicant relies on a description in a foreign patent granted to him, and it is clear that the invention therein described has the advantage of priority: *Held*, that if the application, when limited to that which is set forth in said foreign patent, contains anything patentable over the prior art, applicant's right to a patent thereon is in no way affected by the patent

in interference (quoting and construing former decision, 54 O. G., 1711).

Deprez et al. v. Bernstein v. Hunter v. Gaulard et al., Mitchell, Com., 31 July, 1891, 18 O. G., 1553.

14. Foreign Transactions.

It is now settled that, as a rule, what transpires abroad is not to be considered in deciding the question of priority of invention, and where it was contended that *A* having shown a conception in this country to begin with, his subsequent actions, although performed abroad, could be considered in evidence: *Held*, that whether or not the proposition be sound in general, it could not have effect in a case where the Office had denied his opponents an opportunity to take testimony abroad to show the character of the transactions there, on the ground that such testimony would be immaterial.

Ligowski v. Peters v. Hisey, Simonds, Com., 15 Oct., 1891, C. D. Ms.

NOTE. — The only things excepted from the above general rule are foreign patents and printed publications.

See CONCEPTION; CONSTRUCTIVE REDUCTION TO PRACTICE; DILIGENCE; INTERFERENCE; REDUCTION TO PRACTICE.

PRIOR PUBLICATION.

1. To invalidate a patent, a prior publication must set forth the invention as completely as required in the specification of a patent.

When the defence relied on is that the patented invention had been described in a printed publication before the patentee's invention thereof, the sufficiency of the publication as an anticipation must be determined by the rule laid down in the case of *Seymour v. Osborne* (11 Wallace, 516,*), and that of *Cohn v. U. S. Corset Co.* (93 U. S., 696,*). The construction put, in those

cases, upon the words "described in any printed publication in this or any foreign country," appearing in Section 7 of the Act of 1836 (5 Stat., 117), in reference to the same subject, is equally applicable to the similar expression made use of in Section 24 of the Act 1870. But the description relied on must be in such full, clear, and exact terms as to enable any person skilled in the art or science to which it relates to make, construct, and practise the invention.

Downtown v. Yeager, U. S. S. C. By *Woods, J.*, 7 May, 1883, 25 O. G., 697, *.

See *Borden*, x. p., *infra*; and *Parker v. Stiles*, (1) ANTICIPATION.

2. An unpublished drawing is not sufficient reference.

It would seem that the merit of novelty should not be denied to a device upon reference to a mere (unpublished) drawing not accompanied by an explanation.

Robbins, x. p., *Thacher, Act. Com.*, 12 Nov., 1872, 3 O. G., 292.

3. A published drawing which completely discloses the invention may be cited as reference.

Even without any description, if a published drawing fully and clearly exhibits and discloses an invention sought to be patented, it is an adequate and complete reference in itself alone, and is to be considered as a "publication."

Borden, x. p., *Butterworth, Com.*, 17 Jan., 1884, 26 O. G., 439.

NOTE (i.) — On this difficult question authorities differ, but (assuming the rule for granted patents applies equally to applications) seem to preponderate in denying that a drawing alone, no matter how complete, and even if published, can constitute sufficient reference. See *Parker v. Stiles*, (1), *Thayer v. Hart*, (5), *New Process Fermentation Co. v. Koch*, and *Seymour v.*

Osborne,*, (8), *Parsons v. Colgate*, *Judson v. Cope*, *Reeves v. Keystone Bridge Co.*, and *Atterbury*, x. p., (9), and *Buhlman*, x. p., (25), ANTICIPATION.

NOTE (ii).—It will scarcely be contended that a good model is inferior, as evidence, to a drawing, yet tribunals invariably refuse to recognize a model alone as an anticipation of a completed invention. *Stephenson v. Goodell*, and *Millward v. Barnes*, (1), *Bury v. Thompson*, (2), *Schmiedl v. Booth*, (3), *Packard v. Sandford*, (6), REDUCTION TO PRACTICE; *Green v. Hall v. Siemens v. Field*, (6 and 7) MODEL.

PRIVILEGED APPLICATIONS.

What are and what are not.

Congress, by requiring all applications for patents to be filed in the Patent Office, and then directing that all applications which are discovered to interfere with caveats shall be deposited in the confidential archives (Sec. 4902 R. S.), makes such applications privileged, and amounts to an implied declaration that all other applications shall not be privileged.

Edison Elec. Lt. Co. v. U. S. Elec. Lighting Co., U. S. C. C., S. D. N. Y., *Lacombe, J.*, 5 Jan., 1891, 45 F. R., 55.

PROCESS.

1. "Process," under the Patent Law, defined.

A process is a mode of treatment of certain materials to produce a given result. It is an act or a series of acts performed upon the subject-matter to be transformed or reduced to a different state or thing.

Cochrane v. Deener, U. S. S. C. By *Bradley, J.*, Oct. term, 1876, 24 U. S. (4 Otto), 780, *.

Compare *Corning v. Burden*, *, (1) ART.

2. It is of the very essence of a patentable process that it shall exist and be capable of conception and

operation independently of the apparatus by which it may be carried out.

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

3. Result.

The result which it produces is a test always to be applied when a question of invention is to be considered, and the law ordinarily presumes the existence of the inventive faculty when a great advantage results from the operation of a particular process.

Goodwin, *x. p.*, *Fisher, Act. Com.*, 10 June, 1890, C. D. Ms.

4. A process, new in one step of it, is patentable.

If one of the steps in a process consisting of a combination of process-steps is novel for the purpose in hand, it gives novelty to the process considered as a whole, and, although the process may be a very simple one, simplicity does not negative invention, and marked utility in result coupled with novel process-step, is evidence of patentability.

Kalteyer & Bartholomew, *x. p.*, *Simonds, Com.*, 18 Aug., 1891, 57 O. G., 1127.

5. Where the separate heating of certain vapors was specified in each of the process-claims as one of the steps in the process, and none of the references disclosed that step: *Held*, that a patent could be refused only for the reason that that step had no special utility, and that such a finding would be unwarranted upon the showing made, as it would be largely a matter of mere assumption. The Examiners-in-Chief reversed.

Huston *x. p.*, *Simonds, Com.*, 26 Ap., 1892, C. D. Ms.

Of like tenor, see Manhes, (17) INVENTION.

6. Functions of a Machine, — When not mere.

The Examiner's objection that the process-claim was "thought to be simply to the necessary functions of the

machine shown for carrying out the so-called ‘ process ’ : ” *Overruled*, on the ground that it did not appear that every one of the steps specified in the first claim could not be practised by the use of other instrumentalities than those specifically described in applicant’s specification.

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

7. Process defined and distinguished from the mere Function of an Apparatus.

The objection that the alleged “ process ” was the mere function of the special apparatus described cannot be sustained where it is manifest that the process, as set forth in the claims, is not dependent upon any special mechanism.

Chisholm & Chisholm, x. p., *Mitchell, Com.*, 13 Jan., 1890, C. D. Ms.

8. Change of Form.

While it is the rule that mere changes in form and proportion do not amount to patentable invention, yet it is true, as once said by Chief Justice Marshall, that — “ It is not every change of form and proportion which is declared to be no discovery, but that which is simply a change of form or proportion and nothing more. If, by changing the form and proportion, a new effect is produced, there is not simply a change of form and proportion but a change of principle also ” (*Davis v. Palmer*, 2 Brock., 298).

Condict, Jr., x. p., *Simonds, Com.*, 3 June, 1892, C. D. Ms.

9. A part of the objection of the Examiners-in-Chief to the allowance of a patent was that “ the process here is purely a mechanical process. The material acted on is not changed in character by the process. All that is done to it by the process is to assemble sheets of it and

fold the sheets when assembled :” *Held*, that it is not necessary that a patentable process should change the character of the material acted on. It is enough, in this regard, if it change the form of that material into one of greater convenience.

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

10. Materials.

Where the Primary Examiner had held that the process disclosed in a reference was substantially the same as applicant’s, for the reason that a process must be entirely independent of the materials treated ; that is, that if the steps of two processes appear to be the same, it makes no difference that the materials subjected to the process are different : *Held*, that, as the Examiners-in-Chief did not seem to have adopted this view of the Primary Examiner, it was not necessary to discuss the matter further than to say that the action of different substances under the same treatment is so different that, in many instances, the substances treated are material factors to be considered in determining whether a process is patentable, or whether two processes are the same or different.

Goodwin, x. p., *Fisher, Act. Com.*, 10 June, 1890, C. D. Ms.

11. Naming Ingredients, — When proper.

Upon an objection that certain claims for a process of tanning were not proper process claims, because they enumerated the constituent parts of the different liquors to which the skins were subjected : *Held*, that if there be no way of properly distinguishing the liquors from those before employed in the art to which the invention appertained, except by naming their ingredients, there seemed no good reason for denying the applicant the right to so define them, in so far as the question was one of form. In view of the fact of the well-known

difficulty of determining what is and what is not a patentable process, and what is or is not an equivalent in a chemical process, I am unable to hold, as a matter of law, that it is improper to set forth, in a process of the character that this purports to be, the constituent parts of the different liquors that may be used in carrying out the steps of the process.

Vorel, x. p., *Frothingham, Act. Com.*, 15 Feb., 1892, C. D. Ms.
Compare Zalinski, x. p., (87) THE CLAIM.

12. In *Atwood*, x. p. (1888, C. D. 74), it was expressly decided that the relation between process and apparatus is not that which exists between genus and species, but that they are “wholly separate and distinct inventions.”

Crane v. Meriam, Mitchell, Com., 31 May, 1890, 51 O. G., 1783.

13. Patentable Process distinguished from the mere Functions of a Machine.

A “process,” *eo nomine*, is not made the subject of a patent in our Acts of Congress. It is included under the general term “useful art.” An art may require one or more processes or machines in order to produce a certain result or a certain manufacture. The term “machine” includes every mechanical device, and every combination of mechanical powers or devices, to perform some function or to produce a certain effect or result. But where the result or effect is produced by chemical action, or by the operation or application of some element or power of nature, or by the application of one substance to another, such modes, methods, or applications are called processes. A new process is usually the result of discovery; a machine, of invention. The arts of tanning, dyeing, making water-proof cloth, vulcanizing india-rubber, smelting ores, and numerous

others, are usually carried on by processes, as distinguished from machines. *One* may *discover* a new and useful improvement in the process of tanning irrespective of any particular form of machinery or mechanical device. *Another* may *invent* a labor-saving machine or apparatus by which this operation or process may be facilitated, and each may be entitled to his patent. As, for instance, *A* has *discovered* that, by exposing india-rubber to a certain degree of heat, in combination with certain metallic salts, he can produce a valuable product or manufacture; he is entitled to a patent for his discovery, as a process or improvement in the art, *irrespective of any machine or mechanical device*. *B*, on the contrary, may *invent* a new furnace, or stove, or steam-apparatus, by which this process may be carried on with much saving of labor and fuel; and he will be entitled to a patent for his machine as an improvement in the art. Yet *A* could not have a patent for a machine, nor *B* for a process; each would have a patent for the means or method of producing a certain result or effect, but not for the result or effect produced.

The term "process" includes all methods or means which are not necessarily effected by or dependent on any particular mechanism or apparatus.

*Substantially from Corning et al. v. Burden, Dec., 1853, U. S. S. C. By Wayne, J., 20 U. S., 503, 15 How., 252, **

NOTE. — An instructive elucidation and partial extension of the definition of "art," given in *Corning v. Burden*, *, appears in the decision of the Supreme Court in the case of *Dolbear et al. v. American Bell Telephone Company*, 19 Mar., 1888, 33 O. G., 377, (19) INVENTION (*Generic*), *. See also decision and comment of Commissioner *Simonds* in *Dalton*, x. p., 18 Feb., 1892, (3) ART.

14. Where the process could be carried into effect by the described machine, but was not dependent upon it,

both the process generally and that particular machine may be included and separately claimed in one patent.

Where the application, as filed, discloses an apparatus, and also a patentable process, and the relation between them is such that they could be joined in one application, and the apparatus only is embraced in the statement of invention or in the claims, as originally presented, there is no reason why claims for the process may not be incorporated if seasonably presented and supported by a supplemental oath. Such amendment and oath should, however, be seasonably presented, for the option accorded to applicant carries with it the responsibility of timely election and the obligation to stand by such election when decisively made.

Lillie, x. p., *Mitchell, Com.*, 6 Dec., 1890, 53 O. G., 2041.

15. Where it appeared that the process embraced in applicant's claim was such that it could be performed by machines other than that disclosed in the application, that it could be performed by hand, and that the said process was invented before the said machine was carried out: *Held*, that such process was patentable and was not a mere function of the machine, notwithstanding applicant has a pending application for patent for the machine (following Young, x. p., 46 O. G., 1635; and distinguished from McKay v. Jackman, 22 O. G., 86, and from Mosler Safe Co. v. Mosler & Co., 43 O. G., 999).

Kerr, x. p., *Fisher, Act. Com.*, 12 Aug., 1890, 53 O. G., 919.

16. 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, ✽.

17. Where the inventor of a machine was also entitled to a claim for the process, the issue of the patent without such claim was a dedication of the process to the public.

It is, of course, difficult to say that a man can have invented a process of which he was not cognizant; but, in the case supposed, the inventor's attention may have been so occupied with the mechanical construction of his machine, that, for the time being, — by reason of his ignorance or otherwise, — he failed to know that he had invented also a new process, and, if his unconsciousness should not be removed and he should come to the Office and apply for a patent without describing, defining, or claiming his process, and should take out his patent accordingly, he would probably thereby dedicate the process to the public as unconsciously as he had invented it, and be thus debarred from thereafter asserting a claim thereto.

Young, x. p., *Hall, Com.*, 18 Dec., 1888, 46 O. G., 1635.

18. It being conceded that a process is not patentable which is *merely* the effect or function of a specific mechanism, the question necessarily arises, in every case, whether the process claimed is capable of being performed by a machine differently organized from that described, or even without an organized machine, — by mere tools or by hand. Ordinarily, the necessary effects or operations of a specific mechanism are not “processes” or “methods” *within the meaning of the patent law*. A “method” or “process” such as the law recognizes as patentable must have an existence independent of the machine or appliances by which it is carried out to its result. It must be a method or process that could be carried out by hand or by various kinds or forms of mechanisms or appliances (Horr, x. p., 41 O. G., 463).

Ib.

19. New Matter.

If the Examiner is of opinion that the proposed process claim covers new matter, that is to say, that, in his opinion, it either lacks identity with or that it involves a departure from the invention originally presented: (see Rule 133) he should receive the claim for consideration, and should reject it on the ground of such departure or non-identity in order that appeal may be taken to the Examiners-in-Chief (see *Regan*, x. p., 45 O. G., 589; *Bailey*, x. p., 52 O. G., 605).

Perkins, x. p., *Mitchell, Com.*, 4 Mar., 1891, 55 O. G., 139.

20. Supplemental Oath.

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

Ib.

21. Seasonable Presentation.

The question whether the process claim was seasonably presented is an executive one, and, when that question is intended to be raised, the Examiner should refuse to incorporate and thus lay a basis for *petition to the Commissioner*.

Ib.

PATENTABILITY WAS DENIED IN THE FOLLOWING CASES

22. If a so-called "process" is dependent on a particular apparatus it is but its legitimate function and is not patentable.

Harrison, x. p., *Doolittle, Act. Com.*, 5 Aug., 1876, C. D. 170.

23. Aggregation of Processes.

A process which embraces an old process of preparing a [certain] material and supplements it with an old method of utilizing such materials to produce an old and well-known result, is not patentable. Mere aggregation of processes, of which each accomplishes, independently of the other, its well-known result, is not patentable, any more than a mere aggregation of mechanical devices.

Gent, x. p., *Mitchell, Com.*, 4 Nov., 1889, C. D. Ms.

24. A process which indicates exercise of ordinary judgment merely, — not patentable.

A process that involves merely the use of a well-known mould and an equally well-known composition, and the exercise of ordinary judgment in their manipulation, and regulation of the temperature of each, is not a patentable invention.

Higgins, x. p., *Frothingham, Act. Com.*, 31 Aug., 1891, C. D. Ms.

Compare Torrance, x. p., (1) ORDINARY RESOURCES OF THE ART.

PRODUCT.**1. Patentable product defined.**

One of the requirements of a patentable product is that it can be distinguished in the market from others of the same general character, and this is a question which relates to the "merits" and is not the subject for a petition to the Commissioner.

Reed, x. p., *Frothingham, Act. Com.*, 15 June, 1891, C. D. Ms.

Compare *Eberson v. Shea et al.*, (2) *infra*.

2. An old product not patentable because produced by new means.

It is obvious that if an article has been made by hand and has been in public use or on sale for two years, a

patent for the same article made by a machine would be invalid. A product is not patentable unless it possesses “a novelty of its own independent of the new devices, or processes, or arts by which it was produced” (*Draper v. Hudson*, 1 Holmes, 208; *Wooster v. Calhoun*, 11 Blatch., 215).

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

Compare *Reed*, x. p., (1) *supra*.

PROLIXITY.

A specification comprising two separate descriptions of the same subject-matter of invention that are substantially alike, except that one contains references to the drawings, is unnecessarily prolix.

Kinney, x. p., *Frothingham, Act. Com.*, 14 May, 1892, 60 O. G., 737.

See REDUNDANCY.

PROTEST.

See *Cretean v. Hall*, CROSS-EXAMINATION.

PUBLIC ADOPTION.

1. Resolves doubt in inventor's favor.

When the question of patentable novelty in a device sued upon is not free from doubt, a general and extensive use by the public will incline the court to resolve the doubt in favor of the patent.

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

See, of like tenor, *Shannon*, (10), (11), *Sommer*, (12), INVENTION; and *Bruce v. Marder*, (1) *et seq.*, UTILITY.

2. Public Adoption not always a safe test of Intrinsic Worth. Caution necessary in applying it. "Proprietary Medicines."

While this court has held in a number of cases, even so late as *McGowan v. N. Y. Belting and Packing Co.* (141 U. S. 322, *), decided at the present term, that in a doubtful case the fact that a patented article had gone into general use is evidence of its utility, such use 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 of its actual utility, is evident from the fact that the general introduction of manufactured articles 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 articles themselves. The popularity of a proprietary medicine, for instance, would be an unsafe criterion of its real value, since it is a notorious fact that the extent to which such preparations are sold is very largely dependent upon the liberality with which they are advertised, and the attractive manner in which they are put up and exposed to the eye of the purchaser.

McClain v. Ortmyer. By *Brown. J.*, 2 Nov., 1891, 57 O. G., 1129, *.

Compare *Washburn & Moen M'f'g Co. v. The Beat Em All Barbed Wire Fence Co.*, (7) PATENTABILITY.

PUBLIC RIGHTS AND OBLIGATIONS.

1. The public and the inventor meet on the understanding that one has a secret to communicate and the other a favor to confer in return. Hence, the monopoly granted is a temporary one, and hence, also, a full revelation of the invention is required.

The clearest insight into the peculiarities of this species of property is obtained by considering it as the

result of a contract entered into by the Executive (as representative of the public) with the patentee. The parties meet on the understanding that one has a secret to communicate, the other a favor to confer in return (Coryton, 41). Hence, all laws of this description grant only a temporary monopoly; they offer a compromise between the inventor and the rest of the community by which each party surrenders something, and for which it is proposed that he shall receive an equivalent (Phillips, 22). The right of the public is to be put into immediate possession of a complete knowledge of the invention, and it is the duty of the patentee to give this knowledge; the right of the patentee is to enjoy, unmolested, the exclusive use of the invention during the life of his patent, and it is the duty of the public to secure him in this right by the ordinary forms of legal protection and redress. These reciprocal rights and obligations are to be assured to the respective parties only by imposing upon each the necessity of fully, literally, and promptly discharging its legal duty to the other; in other words, by interpreting each side of the contract against its promisor and in favor of its promisee.

Robinson, "The Law of Patents for Useful Inventions," i. 29.

2. A patent is a contract between the public and the inventor of a new and useful art or manufacture, whereby, in consideration of a complete disclosure of the invention, the exclusive right thereto, for a limited period, is guaranteed to the inventor and his representatives.

Whitney v. Emmett, *Baldwin, J.*, 319

3. In determining the question of inventorship the public has rights, and discretion should be exercised to prevent the placing of unnecessary restrictions upon

artisans in a legitimate use of their mechanical skill and ingenuity.

Smith, x. p., *Thacher, Com.*, 11 Dec., 1872, 2 O. G., 647.

4. In considering a case under Section 4894 R. S., it is necessary to exercise great care lest it be found that, showing too great leniency to an applicant, the interests of the public at large or of other private individuals have suffered. The interest of the general public must be considered as well as the private rights of the individual.

Klenha, x. p., *Butterworth, Com.*, 22 Sep., 1884, 28 O. G., 1272; see also *Voelker v. Gray v. Edison v. Bell, Butler, J.*, 3 Mar., 1885, 30 O. G., 1092.

5. A motion for re-opening a case or for a new trial, in the United States Patent Office, is not to be determined by the same rules as prevail in courts of law. The questions here to be decided are, who is the first inventor, (and whether a patent should issue to *any* one, and if so, to whom). In order to determine these questions it is necessary that the testimony material to establish who is the first inventor and who first reduced the invention to practice should be received *at any time before the patent issues*.

Eccard v. Drawbaugh, Marble, Com., 5 July, 1883, 24 O. G., 301.

6. The history of the case [Graham's application for patent for fire-extinguisher] shows that a great public wrong had been put upon the inventor, and that the object of the act was to repair the injustice to the only persons to whom, in an historical point of view, justice could be rendered; the Act of Congress was intended as one of national gratitude.

Fire Extinguisher M'f'g Co. v. Graham, Hughes, J., 17 May, 1883, 24 O. G., 798.

7. When an applicant seeks to overthrow a patent granted to one who, though a junior in date of conception, has yet shown diligence in filing his application and reducing his invention to practice, the former must, in view of the importance of the invention [not merely to the patentee but to the general public], show entire freedom from *laches*.

Voelker v. Gray et al., Butterworth, Com., 30 O. G., 1091.

8. **As between the public and the inventor who first reduces his invention to practice, there is no obligation to diligence resting upon the inventor; it is only when another inventor appears that such obligations arise. If he forgets [neglects] or abandons the invention after a reduction to practice in private and before public use, his competitor may claim the patent. If he forgets or abandons it after public use, his competitor can take no patent, but the forfeiture will inure to the benefit of the public. A delay in application for a patent of less than two years, even after public use of the invention, is in itself no evidence of abandonment: the law authorizes such delay. Still less is a delay of two years before public use evidence of such abandonment.**

Packard v. Sandford, Paine, Com., 12 Dec., 1879, 16 O. G., 1182.

See, however, ruling of Commissioner Mitchell in *Christie v. Seybold, 54 O. G., 957.*

9. **The patentee must be held strictly to limitations that, after rejection by the Office, had been introduced by himself in order to secure the patent.**

When a claim that had been presented in complainant's original application, which would have been broad enough to cover the machine used by defendants, was rejected on reference to the prior art, and applicant

thereupon cancelled said claim and substituted the more limited claim seen in his patent, said claim cannot be so enlarged by judicial construction as to cover what was thus rejected. . . . Where, after official rejection, the patentee's claim was limited to the specific device described, in which the lever for operating the dog-bar locked when in the vertical position, and defendant's lever was so arranged as not to lock in that position: *Held*, to be no infringement.

Rodebaugh v. Jackson, Brown, J., 25 Feb., 1889, 47 O. G., 660.

10. In patents for combinations of mechanism, limitations imposed by the inventor, especially such as were introduced in an application after it had been persistently rejected, must be strictly construed against the inventor and in favor of the public, and be looked upon in the nature of disclaimers.

*Sargent v. Hall Safe & Lock Co., U. S. S. C. By Blatchford, J., 30 Mar., 1885, 31 O. G., 661, **

See also *Mott Iron Wks. v. Standard M'f'g Co., ACQUIESCENCE; Hill & Prentice, x. p. (1); Miller v. Brass Co. (4), DEDICATION; and Shaw v. Pearson, 58 O. G., 948, WAIVER.*

11. The purpose of the patent-law is to benefit the public as well as to protect the inventor, and the inventor who reduces the invention to practice in such a complete way that he at once perfects it as an invention and at the same time practically demonstrates its utility, is clearly to be preferred to one who merely made hints and suggestions to others, but failed himself to act upon them.

Green v. Hall v. Siemens v. Field, Hall, Com., 6 Mar., 1889, 46 O. G., 1515.

12. The public should not (by supplementary grants or otherwise) be prejudiced in their right, at the expiration of the patent, to whatever it covered.

Camille A. Faure, patentee of the well-known secondary battery which bears his name, sought, in an application for patent (filed May 25th, 1887), to prolong the monopoly for a special use (propulsion of vehicles) beyond the seventeen years of his original patent (granted January 3d, 1882). The application was refused because lacking in the essence of patentable invention; the combination claimed in the new application depending for its useful novelty wholly on the special form of battery of which he was for the seventeen years of his original patent the sole beneficiary, and of which, at the expiration of that patent, the public were the indisputable heirs; they could not lawfully nor equitably be debarred by subsequent patents seeking to monopolize uses which, although special, are, at the same time recognized by persons skilled in the art, as pertaining to it.

Faure, x. p., *Mitchell, Com.*, 52 O. G., 752.

The above decision by Commissioner Mitchell was confirmed by the Supreme Court of the District of Columbia. See Appeal of C. A. Faure, (13) *infra*.

13. Special Use of a Patented Invention — Not patentable.

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.

Supreme Ct. of Dist. of Col., in Gen. Term, Appeal from dec. of the Commissioner of Patents, by Camille A. Faure (Bingham, Ch. J., Hagner and James, Associate JJ.) By *Hagner, J.*, 7 July, 1890, 52 O. G., 754.

Compare with *Reed v. Landman* (14), and *Barrett*, x. p., (15) *infra*.

14. 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.

Reed v. Landman, Mitchell, Com., 26 May, 1891, 55 O. G., 1275.

15. It is not permissible to allow claims appearing in a patent to be transferred to a subsequent application by the same inventor. Such a course would extend the monopoly beyond the period of time allowed by the statute.

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

Compare with *Faure*, (12) and (13) *supra*.

16. I have never been able to satisfy myself that public policy will permit the Office to allow an assignee to prosecute an application wholly from sight of the inventor if the latter wishes to keep himself informed as to the proceedings. The Examiner was directed to permit the inspection asked for.

McLaughlin, x. p., *Mitchell, Com.*, 8 Ap., 1891, 55 O. G., 864

17. An inventor has no right to withhold from the public any material fact involved in a discovery or invention for which he holds a patent, and Section 4908 R. S. will not protect a witness from answering a question notwithstanding the effect of his answer would be to make such a disclosure.

Dornan v. Keefer, Butler, J., 58 O. G., 1093.

18. So long as the claims presented are held to be unpatentable, applicant has no right either to the institution or continuance of an interference; but, in order to afford him an opportunity to have his claims adjudged patentable, on appeal, the Office may, and sometimes does, delay the issue of a patent to the other party. Such delay, however, when granted, is *wholly in the interest of the public*, and if the applicant whose claims stand rejected does not move promptly to appeal, applications, which would otherwise be detained to await a possible interference, will be permitted to go to issue.

Abel et al. v. Maxim v. Noble, Mitchell, Com., 20 June, 1891, 56 O. G., 139.

See, also, *Westinghouse v. Thomson, 56 O. G., 142.*

19. Right to inspect for "Record Date" a pending application referred to in a patent.

Upon a request to inspect so much of a pending application as was referred to in the printed specification of a patent which contained a statement that said patent was a division of said application: *Held*, that, although it would seem to savor of injustice and to be contrary to sound principle to permit a patentee to set out in his patent that by reason of a certain record he is entitled to a certain record date of invention, and yet to deny access to the record for the verification of the statement, and that, as the public is compelled to respect the right of the patentee before suit is brought, it would seem to

be entitled, when a patent has been granted, to know its official history; yet, as such a conclusion would be in direct conflict with the practice of the Patent Office during its whole history, the remedy of the petitioner, if any, should come *through the interposition of a court*, and not through the decision of a Commissioner which would constitute an innovation upon the practice of all his predecessors.

Pennie & Goldsborough, x. p., *Mitchell, Com.*, 15 June, 1891, C. D. Ms.

Compare ABANDONED APPLICATIONS; CERTIFIED COPY.

20. Demands of Public Policy.

Section 4894 R. S., requiring that an applicant shall put his case in condition for examination within two years after filing, and shall not allow two years to elapse without prosecution of it after any Office action thereon, gives ample time to the applicant, and public policy demands that this Office shall consider it as exhausting the liberality which the law requires as regards forfeitures.

Price, x. p., *Simonds, Com.*, 11 Nov., 1891, 57 O. G., 1000.

Compare Cordrey, (2) DELAY; also Holt v. Mills (2), and Murray, x. p. (8) DILATORY METHODS.

21. Limitation of Patent by Prior Art.

In the absence from the record of references showing exactly certain features which were old, it was held, by the Supreme Court in *Phillips v. Detroit*, 111 U. S., 604, (28 L. ed., 532, *), that the rights of the public demand that judicial notice shall be taken of what is well-known to be old.

Jones, x. p., *Frothingham, Act. Com.*, 21 Dec., 1891, C. D. Ms.

Compare COMMON KNOWLEDGE; (28) *et seq.*, INVENTION; and (1) *et seq.*, ORDINARY RESOURCES OF THE ART.

22. Whatever may prove to be the condition of an application in respect to abandonment, the interests of the public, where the case is involved in interference, are best subserved by having the question of priority first determined, but if the applicant prove 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.

23. It is undoubtedly true that the limited and temporary monopoly granted to inventors was never designed for their exclusive profit or advantage; the benefit to the public or community at large was another, and, doubtless, the primary object in granting and securing that monopoly. This was, at once, the equivalent given by the public for benefits bestowed by the genius and meditations and skill of individuals, and the incentive to further efforts for the same important objects.

Kendall *v. Winsor*, U. S. S. C. By *Daniel, J.*, Dec. term, 1858, 21 Howard, 322, *.

24. The true policy and end of the patent laws enacted under this Government are disclosed in that article of the Constitution (Art. 1, Sec. 8, Cl. 8), the source of all these laws, viz., to be "to promote the progress of science and the useful arts."

Ib.

ABANDONMENT (3, 4, 7); ABANDONMENT OF APPLICATION (3); DILIGENCE; INTERFERENCE; REDUCTION TO PRACTICE; SCOPE OF PATENT.

PUBLIC RECORD.

Applications which have not matured into a patent are not a part of the public record.

See Fowler, x. p., (1) ABANDONED APPLICATIONS; U. S. v. The Com. of Pats., (1) CERTIFIED COPY; Borgfelt, x. p., (1), Chadwick, x. p., (2), CROSS-REFERENCES; and Pennie & Goldsborough, x. p., (19) PUBLIC RIGHTS, ETC.

PUBLIC USE.

1. A use for over two years prior to application, which was wholly or mainly for trade or profit, constitutes an abandonment of the invention to the public, but use wholly or chiefly for experiment does not.

The inventor's rights are not prejudiced by experiments whose purpose is to discover whether the invention be both practicable and valuable, and whether any and, if any, what additional means are required for perfecting it; furthermore, the nature of the invention may be such as to require experimental tests to be public ones, and such use in public may be for a period even longer than two years; and where, as an incident to such use, the product of its operation is disposed of by sale, such profits by its use do not change its character; but where, on the other hand, its use is mainly for the purpose of trade and profit, and the experiment is merely incidental to that, a continuance of such use for more than two years before application for patent will constitute abandonment; *the principal, and not the incident, must give character to the use.* The use implied as excepted out of the statutory prohibition is one which may be properly characterized substantially for the purpose of experiment. Where the substantial use is not for that purpose, and has been open to the public for more than two years prior to the application, it comes within the

statutory prohibition (*Smith v. Sprague*, 123 U. S., 249, *). Tested by the rule thus stated, the proofs adduced by the complainant, Henry Root, do not show a use substantially for experiment, but show such a public and commercial use of the invention as must defeat the patent. The facts are in marked contrast with those in the case of *City of Elizabeth v. Nicholson Pavement Co.* (97 U. S., 126, *); there the use was solely for experiment. In the language of the Supreme Court in that case; "Nicholson wished to experiment on his pavement; he believed it to be a good thing, but he was not sure, and the only mode in which he could test it was to place a specimen of it in a public roadway. He did this at his own expense and with the consent of the owners of the road. He wanted to know whether his pavement would stand and whether it would resist decay. Its character for durability could not be ascertained without its being subjected to use for a considerable time. He subjected it to such use in good faith for the purpose of ascertaining whether it was what it claimed to be."

Root v. Third Ave. R. R. Co., *Wallace, J.*, 5 Feb., 1889, 46 O. G., 1898.

For final affirmation, by the United States Supreme Court, of the above decision, see (2) *infra*.

2. We think that the present case does not fall within the principles laid down in *Elizabeth v. Pavement Co.* The plaintiff did not file a caveat, and there is no evidence that he did not intend to abandon his right to a patent. It does not appear that any part of the structure was made at his own expense, or that he put it down in order to ascertain its durability or its liability to decay, or that what he says he noticed in the spring of 1879 led him to make any further examination in that respect, or to test further the fear which he says he had at that time,

or that what he then saw led him to think that the structure was weak or undesirable. It cannot be fairly said from the proofs that the plaintiff was engaged in good faith, from the time the road was put into operation, in testing the working of the structure he afterward patented. He made no experiments with a view to alterations; and we are of opinion, on the evidence, that sufficient time elapsed to test the durability of the structure, and still permit him to apply for his patent within the two years. He did nothing and said nothing which indicated that he was keeping the invention under his own control (*Elizabeth v. Pavement Co.*, 97 U. S., 126, *; *Smith & Griggs M'fg Co. v. Sprague*, 123 U. S., 249, *; *Hall v. Macneale*, 107 U. S., 90, *; *Egbert v. Lippmann*, 104 U. S., 333, *).

Without examining any other of the defences raised, we are of opinion that the bill must be dismissed, for the reason stated by the Circuit Court.

Decree affirmed.

Root v. Third Avenue R. R. Co., Appeal from U. S. C. C., S. D., N. Y. (*Wallace, J.*), U. S. S. C. By *Blatchford, J.*, 21 Nov., 1892, 61 O. G., 1947.

For instance of experimental use, compare *City of Elizabeth v. Nicholson Pavement Co.*, (9) DILIGENCE.

3. Public Use and Sale.

In case of a sale and public use of a machine subsequently patented, such sale and use being more than two years before the date of the application, it being shown that such sale was for experimental purposes, then, upon the question of the reasonableness of the use in point of duration, every presumption should be made in favor of the inventor.

Innis v. The Oil City Boiler Wks., U. S. C. C., W. D. Pa., *Acheson, J.*, 29 Jan., 1885, 80 O. G., 998.

4. The invalidating two years' public use of the statute does not require the knowledge, allowance, or consent of the inventor (*Andrews v. Hovey*, 123 U. S., 267, *, and 124 U. S., 694, *).

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

See ABANDONMENT; DILIGENCE; REDUCTION TO PRACTICE.

PUNCTUATION.

In the printing of a specification for issue, the punctuation in applicant's claims must be *strictly followed*, and that in the body of the specification must not be departed from except to cure a manifest absurdity.

Order 789, *Simonds, Com.*, 26 Nov., 1892.

"RACE OF DILIGENCE."

See (1), (2), (3), (4), DILIGENCE. See, also, (11) REDUCTION TO PRACTICE, and cases there cited.

RE-ALLOWANCE

1. Before Forfeiture.

When a renewal application was made, the renewal fee paid by applicant, and the case re-allowed by the Examiner before the original application had become forfeited: *Held*, following the practice as announced in *Manny*, x. p. (44 O. G., 700), that there was no authority of law for the filing of said renewal application or for the acceptance of the renewal fee, and, consequently, there was no authority of law for the re-allowance, and that the application should be returned to the Issue

Division to await action of the applicant as an allowed case.

Nicholson, x. p., *Mitchell, Com.*, 17 June, 1890, 52 O. G., 310.

2. Failure to receive Notice of Allowance.

A petition alleging that a notice of allowance, duly sent, had not been received, and praying that another notice be sent and the petitioner be allowed to pay his final fee and receive his patent, denied. The statute is peremptory that if the final fee is not *paid* within the prescribed time, the patent shall be withheld. It would seem that the statute conclusively assumes that the notice sent was received, and apparently assumes that a failure to hear for months from the Office with reference to an application would lead to such inquiry as would prevent any injury resulting from failure to receive the notice sent.

Eames, x. p., *Mitchell, Com.*, 6 Feb., 1890, C. D. Ms.

RE-APPEAL.

1. It is a well-established practice of the Office that an Examiner is not bound by a suggestion made by the Examiners-in-Chief. This was expressly stated by the Commissioner in Holt, x. p. (1887, C. D. 5), and in Pearson, x. p., *Ib.* 37. If a claim suggested by the Examiners-in-Chief is rejected by the Primary Examiner, the appellant's remedy is by re-appeal.

Simpson, x. p., *Fisher, Act. Com.*, 21 Nov.; 1890, C. D. Ms.

2. The Primary Examiner is not bound by a recommendation contained in decision of Examiners-in-Chief (Dysart, x. p., 34 O. G., 1390; Pearson, x. p., 40 O. G., 244). Rule 139 (b) clearly implies that the Primary Examiner may reach a judgment different from that of the Examiners-in-Chief on points embraced in their

recommendation, and that a further appeal may be rendered necessary, either to the Examiners-in-Chief or to the Commissioner, according to the nature of the question presented. Such a recommendation, whatever its moral force, cannot cut off the right of the applicant to demand the independent judgment of the Primary Examiner.

Heyer, x. p., *Mitchell, Com.*, 29 Nov., 1890, C. D. Ms.

See Thomson, x. p., (2) FEES.

RE-ARRANGEMENT.

A re-arrangement of old elements which usefully reverses their customary action is patentable.

A lathe in which the block revolves rapidly and the tool-stock so slowly that at each revolution of it a block is finished, is not answered by one in which the rate of these motions is reversed.

Urmston, x. p., *Fisher, Com.*, 16 Feb., 1870, C. D. 13.

See RE-ORGANIZATION.

RE-COMBINATION.

The defendants had the same right to re-combine the same parts that the complainants had, so long as they do not use the same combination.

Pattee v. Moline Plow Co., Blodgett, J., Oct., 1881, 22 O. G., 173.

See RE-ORGANIZATION.

RE-CONSIDERATION.

Examiner's Duties.

Where, after a material amendment, the Examiner rejects without giving either reasons or new references and announces such rejection to be final, and, thereafter,

applicant offers another amendment which the Examiner refuses to consider: *Held*, that, the amendment having been of a material character, applicant was entitled to a reconsideration or to further amend if he so preferred, and, having elected the latter course, the Examiner should have incorporated this new amendment and considered the same.

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

RECORDING.

In recording assignments, the Patent Office acts in a merely ministerial capacity and has no authority to enter upon a judicial inquiry as to their validity.

Backus' Co., x. p., *Simonds, Com.*, 8 Jan., 1892, 58 O. G., 885.

The statutes give no authority for recording, or otherwise noting on the records of the Patent Office, a protest against the validity of a previously recorded assignment.

Ib.

Compare Samuel J. Murray, (2) ASSIGNEE; and Dodge & Son, (2) FOREIGN PATENTS.

REDUCTION TO PRACTICE.

L Actual reduction to practice is accomplished only by a full-size operative machine. A model, no matter how complete, is not sufficient.

Reduction to practice can be effected only by the material embodiment of the invention in the form [and of the dimensions] in which it is ultimately designed for use. It may be stated, as a legal proposition of general application, deducible from the decisions of the courts and the Patent Office, that complete invention is arrived at when the ideas, theories, and speculations of the inven-

tor have been put into such form, capable of operation, that a public use or sale of the device so constructed (not simply an experimental use), if made more than two years before the filing of an application, would constitute a bar to the granting of a patent. To satisfy the requirements of the law the inventor must have produced a full-size operative machine; a model, no matter how complete in details of construction, is not sufficient.

Stephenson v. Goodell, Duell, Com. 3 June, 1875, 9 O. G., 1195.

See also *Millward v. Barnes*, 11 O. G., 1160; and for distinction, on the one hand, between use wholly (or mainly) experimental and, on the other hand, such business use as (if made more than two years before application) would give the invention to the public, see *City of Elizabeth v. Nicholson Pavement Co.*, 95 U. S., 126,*; *Smith v. Sprague*, 123 U. S., 249,*; and *Root v. Third Avenue R. R. Co.*, 46 O. G., 1393, and 61 O. G., 1947.*

2. Definition.

In the case of a mechanical device, reduction to practice [aside from the constructive reduction involved in an application for patent] consists in the construction of *the actual thing, of dimensions suitable for practical use*, and, in case of any doubt of the practical operativeness of the device, it must have been tried sufficiently to establish its practicability.

Bury v. Thompson, Simonds, Com., 21 Aug., 1891, C. D. Ms.

3. An Operative Machine of Full Size.

In the invention of a machine, actual reduction to practice consists in the making of a machine of a size adapted for actual work, and proof of some kind—*preferably by means of actual trial*—that the machine will work practically and successfully.

Schmiedl v. Booth, Simonds, Com., 25 June, 1892, C. D. Ms.

4. It is not necessary to prove commercial success.

An invention is complete when the thought conceived is embodied in some practical and operative form. It may never prove to be profitable because of other ways devised for accomplishing the same end. 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 & Man v. Edison, Marble, Com., 8 Oct., 1883, 25 O. G., 597.

5. The invention need not have been brought to the highest degree of efficiency.

The law does not require that a discoverer or inventor, in order to get a patent for a process, must have succeeded in bringing his art to the highest degree of perfection. It is enough if he describes his method with sufficient clearness and precision to enable those skilled in the matter to understand what the process is, and if he points out some practical way of putting it into operation.

Dolbear et al. v. American Bell Tel. Co., U. S. S. C. By *Waite, Ch. J.*, 19 Mar., 1888, 43 O. G., 377, *.

6. Actual reduction to practice is reached by a single successfully operating and full-sized machine.

Reduction to practice may be effected by means of an experimental working machine as well as in any other way; if the result is a success, the work is as clearly a lawful reduction to practice as if attained by the use of the fiftieth instead of the first working machine; and, if followed within two years by an application for a patent, will accrue to the benefit of the inventor.

Packard v. Sandford, Paine, Com., 12 Dec., 1879, 16 O. G., 1182.

7. A single instance of public use for more than two years prior to the application for patent constitutes a surrender of the invention to the public.

The Clark Pomace-Holder Co. *v.* Ferguson, *Coxe, J.*, 10 Jan., 1883, 24 O. G., 1090.

8. *A* was first to conceive and first to apply for a patent. *B* was first to reduce to practice, and, for nearly a year prior to *A*'s application, had been making and selling articles embodying the invention. Several years of neglect on the part of *A* had intervened between his conception and application, including the period after *B* had entered the field: *Held*, *B* was the first inventor and entitled to the patent, although a patent had been previously granted to *A*.

Manny v. Easley v. Greenwood, *Mitchell, Com.*, 16 May, 1890, 51 O. G., 1617.

9. The inventor's act in being the first to enter the Office with an allowable application constitutes a "constructive reduction to practice."

Actual reduction to practice is not the only competent evidence of perfection and adaptation to use; the inventor's act in [being the first to enter the Office with] an allowable application is to be regarded in law as such an efficient and crowning step as to give it the standing of an invention so perfected and adapted.

Lorraine v. Thurmond, *Mitchell, Com.*, 4 June, 1890, 51 O. G., 1781.

10. Constructive Reduction to Practice.

To invalidate a patent, it must be proven that the invention had been reduced to practice before the date of the patentee's invention, the patent itself being "held in law to constitute a constructive reduction to practice," and to "relate back to the date of the original

disclosure," providing the specification in the patent is such as to enable one skilled in the art to put the invention in practice.

Murrill v. Wheeler v. Chenoweth, Fisher, Com., 14 July, 1869, C. D. 43.

See, also, *Starr & Peyton v. Farmer, Marble, Com., 22 Mar., 1883, 23 O. G., 2325*; *Morse v. Clark, Leggett, Com., 23 Mar., 1872, 1 O. G., 275.*

11. Futile Experiments nugatory.

The only office of diligence in reducing to practice is to connect reduction to practice with the original conception and disclosure. If the goal of actual reduction to practice was not *reached*, all efforts in that direction are nugatory and futile, and the respective parties must stand upon their filing dates and their diligence in coming to the Patent Office with theoretically complete inventions.

Bentley v. Wightman v. Sprague, Mitchell, Com., 19 Mar., 1890, C. D. Ms.

NOTE. — Numerous rulings, such as those of Commissioner Mitchell in *Holmes & Holmes v. Coler, 21 July, 1890*, and *Christie v. Seybold, 19 Feb., 1891*, may be taken to have now fully established the principle which makes the question of diligence applicable only to the inventor who was first to conceive. See, to like purport, *Gray v. Hale, 1871, C. D. 129*; *Monce v. Adams, 1 O. G., 2*; *Millward v. Barnes, 11 O. G., 1060*; *Habel v. Tucker, 36 O. G., 139*; *Lorraine v. Thurmond, 51 O. G., 1781*; *Merwin on Patents, Sec. 801*; and *1 Robinson on Patents, 544*. See also *Edison v. Foote v. Randall (12) infra*.

12. In case of two or more interfering applicants, the one who is first to disclose the idea is held to be the rightful claimant; providing he had with reasonable diligence reduced the invention to practice, although one later to conceive may have been the first to reduce to practice and the first to make application for patent.

In default of such reduction to practice by the originator, his inchoate right lapses, and his claim is forfeited to the next earliest discloser who can show the required diligence followed by reduction to practice.

Edison v. Foote & Randall, Leggett, Com., 25 Mar., 1871, C. D. 80.

See, also, *Corsett & Lowe v. White, Leggett, Com., 1 June, 1871, C. D. 154*; *Diston v. Emerson, Leggett, Com., 1 June, 1871, C. D. 162*; *Monce v. Adams, Duncan, Act. Com., 10. G., 1.*

13. It is not a valid defence against a patent granted in compliance with the forms of law, to show that the invention had never been reduced to actual practice.

Starr & Peyton v. Farmer, Marble, Com., 22 Mar., 1883, 28 O. G., 2825.

14. To defeat a patent already issued, it is not enough that another conceived the possibility of effecting what the patentee accomplished. To constitute a prior invention, the party alleged to have produced it must have proceeded so far as to have reduced his idea to practice and to have embodied it in some distinct form. *It must have been carried into actual operation.*

Parkhurst v. Kinsman, Nelson, J., Oct., 1849, 1 Blatchford, 486.

See ABANDONED EXPERIMENT; CONSTRUCTIVE REDUCTION TO PRACTICE; CONSUMMATED INVENTION; MODELS; PRIORITY; PUBLIC RIGHTS.

REDUNDANCY.

1. Duplication of Claim.

Where a simple invention is made the subject of numerous claims differing in mere methods of expression with no corresponding difference in the concrete subject-matter, the Office should insist that one claim only be allowed for a given subject-matter of invention, and that

mere differences in phraseology shall not be regarded when urged in defence of a needless multiplication of claims. Where the terms of a claim are clear and distinct, as they always should be, no necessity arises for repeating such claims in different forms of language, and subjecting the Office and the courts [and the *public?*] to great labor in scrutinizing them, and to doubt and annoyance as to their limitations and construction.

Johnson, x. p., *Mitchell, Com.*, 20 Jan., 1891, 54 O. G., 505.

Of like tenor see ruling of *Coxe, J.*, in *Brush Elec. Co. v. Elec. As. Co.*, (60) THE CLAIM.

For important exceptions to the above general rule, see *Perry & Lay*, x. p., (19) and *Hahn*, x. p., (20) THE CLAIM.

2. A Question of Form.

The question of the redundancy or multiplicity of claims is a question of form and properly reviewable by the Commissioner on petition (*Sawn*, x. p., 54 O. G., 1561).

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

3. Applicant's remedy is by petition to the Commissioner.

In a question of redundancy of claims, the matter to be determined is, not whether the several claims standing alone would be patentable against the public, — for it is conceivable that each one of the claims, standing alone, would be an entirely valid claim, — yet sound policy would require that not all of them should be allowed. Where the Examiner objected to certain claims on the ground of redundancy, and cited *Rodwell*, x. p. (C. D. 44, Ms. 149), in support of his position that applicant's remedy was by appeal to the Examiners-in-Chief: *Held*, that the practice generally does not accord with that

decision (see Perry & Lay, x. p., 1869, C. D. 3; Hahn, x. p., 1875, C. D. 109; Shippen, x. p., 1875, C. D. 126; and Woodruff, x. p., 1880, C. D. 90); and the better practice would seem to be for the Examiner to state definitely which of the claims he regards as coming within the objection of redundancy, and to give the applicant his election to say which of the claims so related should be prosecuted, and that, thereupon, applicant, if dissatisfied with the Examiner's decision, should petition the Commissioner for relief.

Sawn, x. p., *Mitchell, Com.*, 9 Mar., 1891, 54 O. G., 1561.

4. Upon petition from Primary Examiner's objection to certain claims that they were not substantially different from certain other claims in the application: *Held*, after pointing out certain differences, and the evident endeavor of applicant to obtain claims that will protect his invention from interchanges and reversal of elements which might be made by persons disposed to infringe, that in view of these differences, however slight they may be, it must be held that Claims 1 and 4 are not the same in scope as Claims 2 and 3 respectively, and, if there is anything in these differences, applicant ought to be allowed to claim it (Tobie, x. p., 50 O. G., 992).

Mulligan, x. p., *Frothingham, Act. Com.*, 29 May, 1891, C. D. Ms.

5. Objection of, — overruled.

On objection of redundancy overruled where Claim 2 included an element in addition to the elements in Claim 1, and Claim 3 included an element in addition to the elements in Claim 2.

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

Compare (18), (19), (20), (20'), (58), (59), (60), (61), (62), and (68) THE CLAIM.

REFERENCES.**1. Pertinency.**

Where a reference related to an art so far removed from that to which the application related, and had for its object a purpose so essentially different that the somewhat analogous construction became of very little consequence: *Held*, that as a reference it was without pertinence.

Ferry, x. p., *Mitchell, Com.*, 5 Mar., 1891, C. D. Ms.

2. An affidavit filed under Rule 75, to be effective in overcoming references cited by the Office, must be supported by proved facts; mere declarations, although accompanied by petitioner's oath, are not sufficient.

Hunter, x.p., *Fisher, Act. Com.*, 23 Oct., 1889, 49 O. G., 733.

3. Such an affidavit is not required to cover the same ground as a preliminary statement. It is necessary only to satisfy the Examiner that applicant's invention preceded the date of filing of the application of a cited patent. Such affidavits are not open to inspection either by the public or by parties in interference.

Gasser, x. p., *Paine, Com.*, 28 Feb., 1880, C. D. 94 ; 17 O. G., 507.

See also Saunders, x. p., 1883, C. D. 23 ; and Donovan, x. p., 52 O. G., 309.

See AFFIDAVITS TO OVERCOME REFERENCE; ANTICIPATION; PRIOR PUBLICATION.

RE-HEARING.

1. A motion for re-hearing in the United States Patent Office ought to be governed, as far as practicable, by the rules which, in courts, govern new trials.

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

2. The granting or refusal, absolute or conditional, of a re-hearing in equity, — as of a new trial at law, — rests in the discretion of the court in which the case has been heard or tried, and is not the subject of appeal.

Roemer v. Newman, U. S. S. C. By *Bradley, J.*, 11 Nov., 1889, 49 O. G., 1535,*.

3. Error of Fact.

The question upon a motion for re-hearing on the ground of error of fact, is not whether the trier erred in deciding against the weight of the evidence, but whether there was any substantial ground for the conclusion reached at the original hearing.

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

4. Mistakes of Judgment.

Where, upon a motion for re-hearing, it was urged, *inter alia*, that there was an error in applying to mistakes of judgment in the conduct of a pending and original application the same strictness which the courts exercise in proceedings after the patent has been granted, and that the spirit and purpose of the patent laws were sacrificed to official routine: *Held*, that the allegation of error was answered by the simple consideration that there was applied to the applicant's case the same rule which has been applied by the Patent Office to similar cases for more than ten years past. It may be further said that there must be an end somewhere to the prosecution of an application, and *the Office, in consideration of the large amount of work imposed upon it and the constant struggle to keep from falling hopelessly in arrears, is fully justified in placing restrictions upon the power to bring up for consideration matters which it had good reason to suppose had been finally disposed of.*

Jameson, x. p., Fisher, Act. Com., 14 July, 1890, C. D. Ms.

NOTE. — The italicized portion in the above decision would seem to imply belief of the Assistant Commissioner that the difficulty was, to an important extent, ministerial, and that the inadequacy of examining force (due to insufficiency of the annual appropriations) alone prevents the more just and liberal practice approved by the Commissioner (Mitchell) in person, in the case of Myers, x. p., (49 O. G., 131) (21) AMENDMENT, so lately as 24 Sep., 1889, and still more recently by the same Commissioner, in the case of Harrison, x. p., 15 Feb., 1890; RIGHTS UNDER ORIGINAL AND UNDER RE-ISSUE APPLICATIONS COMPARED. Of same tenor was the decision of Commissioner Leggett in the case of Noyes, x. p., 1872, C. D. 118. Finally, a like liberal and even indulgent treatment of original applications was (6 March, 1882) enjoined by the United States Supreme Court in the case of Heald v. Rice, 21 O. G., 1443, *.

5. Predecessor's Decisions.

Rule 144 was exhaustively considered by the present Commissioner in Daniels v. Morgan, 47 O. G., 811; and Green v. Hall v. Siemens v. Field, 47 O. G., 1631. In both cases it was held that the Commissioner has a right to re-hear a case decided by his predecessor, provided it is one which presents such a state of facts as would [in his opinion] warrant a new trial in an action at law, as for example:

- (1) Where the finding is unsupported by the evidence; or
- (2) Is manifestly the result of prejudice, bias, or passion; or where,
- (3) The facts being conceded, there had been a clear error or mistake in the application to them of the rules of law.

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

6. Denied.

The fact that the petitioner for a re-hearing had been present and heard without taking exception, warrants

denial of a re-hearing on the ground of irregularity of original procedure.

Spielman, x. p., *Simonds, Com.*, 19 Feb., 1892, C. D. Ms.

7. Insufficient Showing.

The granting of a re-hearing is not warranted by simply raising a doubt as to whether the present trier might not have come to a different conclusion upon the case as originally presented.

Bausset, x. p., *Simonds, Com.*, 9 Ap., 1892, C. D. Ms.

RE-INSTATEMENT OF FORFEITED APPLICATION.

1. In petitions to revive applications, it is necessary to set the excuses out in detail, so as to enable the Office to judge whether the delay was unavoidable.

Krieg, x. p., *Mitchell, Com.*, 6 Feb., 1891, C. D. Ms.

2. Where the applicant's ordinary expenses largely exceeded his income, and he was financially unable to prosecute his case during two years after last Office action: *Held*, that the delay was unavoidable and petition to revive was granted.

Close, x. p., *Fisher, Act. Com.*, 11 Dec., 1890, C. D. Ms.

3. Poverty and business troubles held insufficient to revive an abandoned application where the last action was a decision by the Commissioner requiring division, and it did not appear why applicant had not directed his attorney to file an amendment cancelling the claims to be divided out, and asking for action on the merits of the remaining claims.

Davis, x. p., *Simonds, Com.*, 20 Aug., 1891, C. D. Ms.

4. Where the file-wrapper bore the endorsement "notice of allowance, Aug. 17, 1889," and the file con-

tained a duplicate of the notice bearing the same date: *Held*, that petition for re-allowance of the application forfeited for non-payment of the final fee, on the ground that no notice had been received, could not be granted (Eames, x. p., 2 Gourick, 12).

Nobs, x. p., *Fisher, Act. Com.*, 10 May, 1890, C. D. Ms.

5. Where a letter containing an amendment was addressed to the Commissioner of Patents and duly mailed some two months prior to the expiration of the two years' limit: *Held*, that, as the applicant had a right to assume that the letter would and did reach the Office, and as he did not know otherwise until the two years' limit had expired, the delay was unavoidable and the application should be revived.

Knowles, x. p., 6 Nov., 1889, C. D. Ms.

6. Where it appeared that an amendment, duly addressed to the Commissioner, had been deposited in a post office in Wisconsin, in time, in the regular course of mail, to have been delivered in the Patent Office before the expiration of the two years, but, through some failure of the mail, the amendment was not received until too late, a petition to revive was granted (Pratt, x. p., 39 O. G., 1549).

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

See ABANDONED APPLICATION; APPLICATION; REVIVAL OF APPLICATION.

RE-INSTATEMENT OF AN INTERFERENCE.

1. When, in an interference proceeding, the Commissioner upon reconsideration vacates a former decision of abandonment, the re-instatement of the interference which had been dissolved by reason of the former deci-

sion follows as a necessary consequence, and an appeal from the action of the Examiner of Interferences in so re-instating it, will not lie.

Young v. Case, Simonds, Com., 26 Jan., 1892, 58 O. G., 945.

2. When one effect of suspending an interference to add a new party would be to practically re-instate a party thereto who had allowed his rights to lapse by neglecting to take his testimony within the limited time, a request to suspend will be denied.

Wein v. Northrop, Simonds, Com., 3 Mar., 1892, 58 O. G., 1416.

Compare (164) *et seq.*, INTERFERENCES.

RE-INSTATEMENT OF A WITHDRAWN CLAIM.

1. Re-instatement before final rejection permissible.

The applicant should not be precluded from inserting a claim because he had previously presented and cancelled a claim having the same scope, said claim not having been finally rejected.

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

2. Granted on sufficient showing.

Where, upon division being required, counsel directed the method claims erased, and, thereafter, the remaining claims were rejected, and, *within a few days after rejection*, counsel states that the action was a surprise to him, that he was not aware that he had filed any amendment, and that, if any had been filed, it was a mistake and he desired to withdraw it; *Held*, that the case came within exceptions to the rule (Rule 68 (2)), that an election was binding, and that the applicant's claims in this case should be re-instated upon filing an amendment in the

ordinary form asking a re-instatement of the matter erased.

Lyon *et al.*, x. p., *Fisher, Act. Com.*, 25 Feb., 1890.

3. Under Rule 165 an application will not be withdrawn from issue to permit applicant to re-insert therein a claim originally presented but voluntarily erased.

Wood, x. p., *Simonds, Com.*, 4 Jan., 1892, 58 O. G., 273.

See, however, Pierce, x. p., (1) *supra*.

4. A petition to be allowed to withdraw application from issue for further amendment granted where it appeared that applicant had prosecuted his application without an attorney, and, being ignorant of the patent law and not knowing the value of a claim, had failed to notice that his allowed claims did not cover all he was entitled to, and who, on discovering the insufficiency of his allowed claims, at once appointed an attorney, and asked that the case be withdrawn from issue and presented other claims for consideration.

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

Compare with *Rieker v. Merrill, Fisher, Act. Com.*, 24 July, 1890, Ms., (174) INTERFERENCE, in which (being a *contested* case) relief, similar to that granted in the *ex parte* case of Marx, was denied.

Compare also with Wallis, x. p., *Fisher, Act. Com.*, 25 Feb., 1890, Ms., (3) RE-OPENING OF CASE, in which, although an *ex parte* case, relief was denied because there was no special showing to justify it.

5. Ordinarily; a claim withdrawn to secure allowance cannot be re-instated after allowance.

The petitioner having, for a stated purpose and to secure early allowance, erased the claim which stood in the way of allowance, an allowance having accordingly been declared, and having subsequently changed his

mind and asked permission to withdraw the case from issue for re-instatement of said claim, and having failed to show that his case was one of special hardship, or that said erasure was made from inadvertence, accident, or mistake, — the petition was denied.

Potter, x. p., *Fisher, Act. Com.*, 14 Aug., 1890, 53 O. G., 760.

6. Where an applicant, desiring to have his case go to issue without the delay of appealing a rejected claim to the Examiners-in-Chief, withdrew the claim, which was thereupon erased and the case passed to issue: *Held*, that he could not, upon a subsequent change of mind, be permitted to withdraw the case from issue and re-instate the claim so withdrawn. Before a claim, deliberately erased, can be re-instated some good showing must be made of inadvertence, accident, or mistake in erasing the claim, or of especial hardship to the inventor.

Ib.

See Rules 142 and 68; and *Roemer v. Peddee et al.*, * (72) CLAIMS; *Sargent v. Hall*, *, (10) PUBLIC RIGHTS AND OBLIGATIONS; Pennington, x. p., (7) and (9) *infra*.

Compare, however, *Lyon*, x. p., (2), *Marx*, (4) *supra*; and *Welling*, x. p., (38) DIVISION.

7. Re-instatement, in parent application, of claims that had been eliminated on requirement of division, — denied.

Where division had been required of an application that contained claims for both an article and a process, and applicant erased the claims for the article, expressly reserving the right to prosecute them in a separate application, and, after the process claims had been rejected, sought to re-instate the article claims, — erasing the claims for the method: *Held*, that applicant was bound by his election and could not be allowed to re-instate the article claims.

Pennington. x. p., *Fisher, Act. Com.*, 8 Jan., 1890, C. D. Ms.

NOTE (i). — In this case, however, the Assistant Commissioner remarked: It is not meant to hold that claims once erased from an application can never be restored; on the contrary, in *Welling*, x. p., 15 Mar., 1892 (C. D. Ms. 173), it was held that they could be restored if any special reason was shown for such indulgence on the part of the Office.

NOTE (ii). — Applicant's proper remedy was by a separate application.

Compare *Welling*, x. p., (38) DIVISION.

8. Where the Examiner had required a division of process and article claims and, after the process claims were erased, rejected the article claims: *Held*, that applicant could not be permitted to re-instate the process claims notwithstanding the fact that the Examiner's original action was erroneous, and the two inventions might have been properly included in the same application. *Applicant stands bound by his election.*

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

NOTE. — For circumstances under which relief was, in like manner, denied, compare *Donovan*, x. p., (9), (10), *Myers*, x. p., (21) AMENDMENT; *Wallis*, x. p., (3) RE-OPENING; *Pennington*, x. p., (9) RE-INSTATEMENT OF WITHDRAWN CLAIM.

For circumstances under which relief was or would be granted, compare *Noyes*, x. p., (9) SPECIFICATION; *Rogers*, x. p., (2) EXAMINATION; *Pennington*, x. p., (7), *Lyon*, x. p., (2), *Marx*, x. p., (5) RE-INSTATEMENT; *Welling*, x. p., (38) DIVISION; and *Pennington*, (9) *infra*.

9. The Examiner's failure to furnish petitioner with sufficient information as to the state of the art to enable him to determine which branch of the case he should have pursued, is not [at this late stage in the proceedings] a sufficient reason for re-instating the claim. When petitioner wants to re-instate claims which he had stricken out, *the time to urge want of compliance with the rules was*

at the time division was required, and not several months after.

Pennington, x. p., *Fisher, Act. Com.*, 21 Feb., 1890, C. D. Ms.

10. Upon requirement of division of an application containing claims both for a process and the article manufactured, the applicant cancelled all matter and claims relating to the article: *Held*, that a petition to re-instate a claim to the article after allowance of certain process claims, must be denied for want of proper showing, inasmuch as certain affidavits filed to show such public use as would preclude filing a new application did not set forth facts from which the trier could ascertain whether or not public use had taken place, but merely the petitioner's conclusions; and, moreover, it did not appear that applicant could not properly file a divisional application for the article which would date back to the parent application.

Steffin, x. p., *Frothingham, Act. Com.*, 17 Feb., 1892, C. D. Ms.

11. To justify the re-instatement of a claim that had been deliberately erased before final rejection, it is necessary to show inadvertence, accident, or mistake, or irreparable injury, even if presented for the purpose of taking an appeal.

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

See, however, Pierce, x. p., (1) RE-INSTATEMENT OF WITHDRAWN CLAIM.

12. Re-instatement of claim withdrawn by associate attorney, — refused.

It is not sufficient ground for withdrawing an application from issue to re-instate a claim that its withdrawal from the case was done by the associate attorney who did not understand the invention, and that applicant only knew within a few days of its having been stricken out,

and that he believed it to be of very great importance and as fully marking the invention over the references.

Eilers, x. p., *Frothingham, Act. Com.*, 4 Feb., 1892, C. D. Ms. Compare (1) *et seq.*, ATTORNEY.

See, however, *Stutz v. Armstrong*, (6) RE-ISSUE.

13. Where a patentee, in his original application, had claimed a certain construction, and, upon rejection by the Patent Office, erased the claim, and his patent accordingly issued without it: *Held*, that he was thereafter estopped from asserting such a claim, and such claim in the re-issued patent was void.

Dodds v. Stoddard, Sage, J., 6 July, 1883, 24 O. G., 799.

RE-ISSUE.

THE LAW.

1. A patent with a defective specification may be surrendered and be re-issued (for the residue of the original term) in an amended form.

Whenever any patent is inoperative or invalid, by reason of a defective or insufficient specification, . . . if the error has arisen by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, the Commissioner shall, on surrender of such patent and the payment of the duty required by law, cause a new patent for the same invention and in accordance with the corrected specification, to be issued to the patentee . . . for the unexpired term of the original patent. Such surrender shall take effect upon the issue of the amended patent. The Commissioner may, in his discretion, cause several patents to be issued for distinct and separate parts of the thing patented, upon demand of the applicant and upon payment of the required fee for a re-issue for each of such re-issued letters-patent. . . . No new matter shall be introduced into the specification, nor, in case of a machine patent,

shall the model or drawings be amended except each by the other; but when there is neither model nor drawing, amendments may be made upon proofs satisfactory to the Commissioner that such new matter was a part of the original invention, and was omitted by inadvertence, accident, or mistake.

Sec. 4916 R. S.

DEDICATION.

2. Ordinarily; omission in an original application to claim matters that were described and might have been claimed must be construed a dedication of them to the public.

Suit was brought in a Circuit Court, in the District of Connecticut, to restrain infringement of a patent, etc. The patent was for an alleged improvement in lamps, and was originally granted for fourteen years, 16 Oct., 1860; was re-issued May, 1873; was extended for seven years longer in Oct., 1874; and the extended patent was, fifteen years after the original grant, revised, surrendered, and, for a second time, re-issued with new and important claims. Judgment having been denied and the case being appealed by complainant, the Supreme Court said: The invention as originally claimed had proved to be a failure, but after being changed to a form which the patentee, in his original specification, had professed to avoid and dispense with, proved to be a great commercial success, and both plaintiff and defendant made such lamps in large quantities. Fifteen years after the original patent was granted, the patentee, or rather his assignee, discovers that the improved lamp was really a part of the original invention, and that, by inadvertence and mistake, the patentee had omitted to claim it. We think, however, that the court below was clearly right in holding that the invention specified in the second claim of the re-issued patent, which is the one in question here,

is not the same invention which was described and claimed in the original patent. These after-thoughts, developed by the subsequent course of improvement, and intended, by an expansion of claims, to sweep into one net all the appliances necessary to monopolize a profitable manufacture, are obnoxious to grave animadversion. The pretence, in this case, that there was an inadvertence and oversight which had escaped the notice of the patentee for fifteen years is too bald for credence. He simply appealed from the judgment of the Office in 1860 to its judgment in 1876; from the Commissioner and Examiners of that date to the Commissioners of this.

*Edward Miller & Co. v. The Bridgeport Brass Co., U. S. S. C. By Bradley, J., 9 Jan., 1882, 21 O. G., 201. **

3. Acceptance of Original Patent. — Estoppel.

If applicant accepted the original patent containing limitations imposed by the Patent Office, and which narrowed the scope of the invention from that first described and claimed in the application, the undue restriction of the claim cannot properly be attributed to "inadvertence, accident, or mistake," within the meaning of the statute.

Smith, x. p., Frothingham, Act. Com., 20 Nov., 1891, C. D. Ms.

Compare, of like general purport, (1) *et seq.*, DEDICATION; (5) ESTOPPEL; (10) PUBLIC RIGHTS AND OBLIGATIONS; and (10) SCOPE OF PATENT.

For qualifications of above general rule, see (5), (6), and (7) *infra*.

4. Attorney's action binding.

The rejection in the original application having been deliberately acquiesced in by the attorneys, as indicated by the character of the correspondence that followed the numerous actions of the Office, and, finally, by the

cancellation of the claim before patent was allowed, the applicants would have been chargeable with knowledge of what their attorneys had done even if it had not appeared affirmatively that they had such knowledge (Hatchman, x. p., 25 O. G., 979). Affirmed by the Supreme Court of the District of Columbia, 3 Mackey, 288; Arnheim *v.* Finster, 32 O. G., 256; Dobson *v.* Lees, *per curiam*, 30 F. R., 625. Affirmed, 137 U. S., 25; 34 L. ed., 652,*; Hoeveler & McTighe *v.* Verner *v.* Nicholson, 2 Gourick, 51).

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

See, of like tenor, Binford, x. p., (1), and Tuoti, x. p., (2) ATTORNEY.

See, however, Stutz *v.* Armstrong, (6) *infra*.

5. There is no warrant for the suggestion that what is described and shown in the original specification and drawings is necessarily to be regarded as so dedicated to the public, or that, if not claimed in the original, it cannot be claimed in a re-issue.

Selden *v.* Stockwell, *Blanchford, J.*, 5 Sep., 1881, 20 O. G., 1377.

6. A claim erased from the original application through mistake of solicitor, may be re-instated in the re-issue.

Where it appears, from the original papers in the case, that a certain feature was within the contemplation of the inventor as a valuable element in the patentable combination, and it is proved that a claim embracing such feature was erased from the original application through a misunderstanding of the invention by the solicitors: *Held*, that the Commissioner of Patents committed no error in granting a re-issue containing a claim embracing such feature.

Stutz *v.* Armstrong, *Acheson, J.*, 4 July, 1884, 28 O. G., 367.

Compare Hoeveler & McTighe, (4) *supra*.

7. "Inadvertence, Accident or Mistake."

A clear mistake inadvertently committed in the wording of a claim is necessary, without reference to the length of time, to make valid the enlargement of a claim on a re-issue of the patent.

Yale Lock M'fg Co. v. Berkshire Nat. Bank, U. S. S. C. By *Blatchford, J.*, 5 May, 1890, 34 L. ed. 168, *.

8. The question whether the facts set forth in the statement filed with a re-issue 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.

9. "Inoperative or Invalid."

The words "inoperative or invalid," in the statute authorizing re-issues, mean inoperative or invalid in whole or in part, and, consequently, the words "*not fully operative*" would conform to the true intent of the law, if the law required an oath, which it does not. In the matter of applications for re-issue, there is no law requiring the applicant to take oath on the subject of the invalidity of the original patent.

Hartshorn v. Eagle Co., *Lowell, J.*, 11 Oct., 1883, 25 O. G., 1191.

10. Where the claim is not expanded, — delay is immaterial.

Re-issue No. 9148 held to be valid notwithstanding the application for it was nearly ten years subsequent to the date of original issue, that no facts in excuse for this apparent *laches* are shown or claimed to exist, and that the specification of the re-issued patent has seven claims where that of the original patent had only one ; because

the claims of the re-issued patent are, separately, within the original claim, and all combined are no more than its legal equivalent (Am. Boring Co. v. Sheldon, 33 O. G., cited and applied).

Reed *et al.* v. Chase *et al.*, *Matthews, J.*, 14 Aug., 1885, 25 Fed. Rep., 94.

11. If separable claims of re-issue cover the same invention as the original and no more, such claims would seem to be as valid as the original and would be infringed by whatever would infringe that.

Am. Diamond Rock Boring Co. v. Sheldon, *Wheeler, J.*, 9 Dec., 1885, 33 O. G., 1598.

12. A claim may be enlarged by re-issue, but where such enlargement is sought, the rule of laches will be strictly applied. — "Error of Judgment" explained.

A claim may, it is true, be enlarged in a re-issued patent, but, in such case, the rule of *laches* should be strictly applied; no one should be relieved who has slept upon his rights, and has thus led the public to rely on the implied disclaimer involved in the terms of the original patent. If a patentee who has no corrections to suggest in his specification except to make his claim broader and more comprehensive, uses due diligence in returning to the Patent Office, and says, "I omitted this," or "My solicitor did not understand that," his application may be entertained, and on a proper showing, correction may be made; but it must be remembered that *the claim of a specific device or combination and an omission to claim other devices or combinations apparent on the face of the patent, imply an admission that the latter are not his invention or constitute a dedication of them to the public.* This legal effect of the patent cannot be revoked unless the patentee promptly surrenders it and proves that the specification was so framed by real inad-

vertence, accident, or mistake, without any fraudulent or deceptive intention on his part. If two years' public enjoyment of an invention with the consent and allowance of the inventor is evidence of abandonment and a bar to application for a patent, a public disclaimer in the patent itself should be construed equally favorable to the public. While, as before stated, we do not deny that a claim may be enlarged in a re-issue patent, we are of the opinion that this can be done only when an actual mistake has occurred, not from mere error of judgment (for that may be rectified by appeal), but a real *bona fide* mistake, inadvertently committed, such as the court of chancery in cases within its ordinary jurisdiction would correct.

Edward Miller & Co. v. The Bridgeport Brass Co., U. S. S. C. By *Bradley, J.*, 9 Jan., 1882, 21 O. G., 201, *.

NOTE. — An earlier paragraph in the above decision would seem to suggest that the patentee may have neglected his proper remedy by omitting to appeal during the pendency of the application, and inasmuch as “an error” of the patentee’s “judgment” manifestly could not “be rectified by appeal,” *error of official judgment only can have been here intended*. It would hence seem that the patentee may correct *his own* oversights and errors of judgment, even to the extent of broadening his claim, providing he proceeds to do this promptly on discovery of the mistake and before conflicting rights have had time to intervene.

See, also, *Dodds v. Stoddard*, (5) ESTOPPEL; and *Hartshorn v. Eagle Co.*, (20) and *Odell v. Stout*, (33) *infra*.

13. Judge Lowell (in Jones v. Barker) referred to the fact that Mr. Justice Bradley, speaking for the Supreme Court, in Miller v. Bridgeport Brass Co., emphasized the danger and injustice of enlargements and the necessity of prompt application for them,

before new inventions have been made or new enterprises set on foot. He (Bradley, J.) intimates that two years (in analogy to the law of forfeiture) would be the utmost possible limit of time; but "as he (Lowell, J.) understood the opinion," even anything like two years would be inadmissible in ordinary cases.

Jones *v.* Barker, *Lowell, J.*, 24 Mar., 1882, 11 F. R., 597.

See also Lee, *x. p.*, *Marble, Com.*, 23 Dec., 1882, 23 O. G., 342.

14. Ordinarily; in seeking by re-issue to rectify a defective patent, a delay of more time than would be reasonably sufficient to read the patent and ascertain its need of amendment should be accounted laches in a case where enlargement of the claim is the only amendment.

Hartshorn *v.* Eagle Co., *Lowell, J.*, 11 Oct., 1883, 25 O. G., 1191.

15. The presumption is in favor of the validity of a re-issue applied for and obtained in less than two years after the issue of the original patent.

Alaska Refrig. Co. *v.* Wisconsin Refrig. Co., *Blodgett, J.*, 18 July, 1891, 57 O. G., 125.

See also Miller *v.* Bridgeport Brass Co., * : James *v.* Campbell, *, and Stutz *v.* Armstrong, (16) *infra*.

Compare, however, Hartshorn *v.* Eagle Co., (14) *supra*.

16. The fact that a re-issue application was filed within two years after the grant of the original patent, while it may not be conclusive against the charge of unreasonable delay, is entitled to some consideration in view of that provision of the patent law by which nothing less than two full years' public use of an invention is a bar to an application for a patent.

Stutz *v.* Armstrong, *Acheson, J.*, 4 July, 1884, 23 O. G., 367.

17. In determining whether an inventor is guilty of inexcusable delay, the fact that the correction of a mistake by re-issue was before any adverse rights had accrued is a consideration of paramount importance, and it ought to count something in his favor that, being of foreign birth and education, and of alien tongue, he encountered difficulties in acquiring a knowledge of our language and laws.

Ib.

18. Where application for re-issue seeks expansion of the claim, ordinarily a delay of more than two years would require special circumstances for its excuse.

No invariable rule can be laid down as to what is a reasonable time within which the patentee must seek for correction of a claim which he considers too narrow. It is for the court to judge in each case, and it will exercise proper liberality toward the patentee; but as the law charges him with notice of what the patent contains, he will be held to reasonable diligence. By analogy to the rule as to the effect of public use before an application for a patent, a delay of more than two years would, in general, require special circumstances for its excuse.

Mahn *v.* Harwood, U. S. S. C. By *Bradley, J.*, 1 Dec., 1884, 30 O. G., 657,*.

19. The settled rule is, where the claim is *expanded*, that a delay for more than two years in applying for re-issue invalidates the re-issue, unless such delay is accounted for and excused by special circumstances. It is a question of law, arising on the face of the bill, when such delay is not therein explained. Averment in the bill that Examiner had decided that applicant had satisfactorily explained the delay is not enough. The very question for judicial review is whether the

Patent Office decided rightly, and the special circumstances held to have excused delay should have been set out in the bill. Decree of Circuit Court dismissing bill for want of equity affirmed.

Woolensak v. Reiher, U. S. S. C. By *Matthews, J.*, 4 May, 1885, 31 O. G., 1301, *.

20. The re-issue, 31 Oct., 1876, of a patent whose original grant bore date 24 Sep., 1867, sustained, on the ground that the circumstances of the long delay (seven years and eight months) in making application for re-issue were unusual and grew out of an actual mistake, discovered by testimony given in court seven years after the original grant.

Hartshorn v. Eagle Co., *Lowell, J.*, 11 Oct., 1883, 25 O. G., 1191.

21. Ill health ending in insanity excuses delay.

Where the original patent was granted in Dec., 1877, and re-issue was not applied for until Aug., 1880: *Held*, that the delay was excused by the fact that the inventor was in poor health and, at times, mentally deranged during the years 1878 and 1879, so that he was, much of the time, unfit to attend to business, and finally, in the spring of 1880, became wholly insane and continued so until 1884.

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

22. If a re-issue be sought to enlarge a claim, a delay of two years from the original grant in applying therefor will ordinarily, though not always, be treated as evidence of abandonment of the new matter to the public.

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

23. Where, date of filing of an application for a re-issue was more than 14 years after the grant of the original patent, and applicant contended, *inter alia*, that he did not discover the alleged errors until certain claims of the original patent had been held by the Circuit Court not to cover a certain feature which he desired to cover by the re-issue: *Held*, that, under the decisions in *Woolensak v. Reiher* (115 U. S., 99), *, and *Mahn v. Harwood* (112 U. S., 354), *, the long delay in making the discovery was inexcusable.

Smith, x. p., *Frothingham, Act. Com.*, 20 Nov., 1891, C. D. Ms.

24. Filing date of an Application for Re-issue.

An application for re-issue, complete except as to the abstract of title required by Rule 86, will be restricted, as to filing date, to the day the abstract of title was filed, although an order for the abstract was made and the necessary funds were deposited the day the application was filed, and the delay was caused by the time taken by the Office to file the order; but such delay should not count against the applicant as far as the question of diligence in filing the application is concerned.

Flagg, x. p., *Frothingham, Act. Com.*, 9 Nov., 1891, C. D. Ms.

25. Revision of specification permissible.

The statute allows the revision and correction of the specification on an application for re-issue. In *Carew v. Fabric Co.* (3 Cliff. 356), it was held that "an applicant for re-issue may re-describe his invention and include in his description and claims, not only what was well described before, but also what is *suggested* in the original drawings, specifications, or [where one was filed] the model.

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

26. When it can be seen that the Patentee seeks, by apt words of description, to secure what he has honestly invented, and nothing more, the court should hesitate to regard with favor the accusation now so freely made against re-issued patents.

Crandall v. Parker, Coxe, J., 7 July, 1884, 28 O. G., 369.

27. The law provides for and allows re-issues for the corrections but not for alterations.

Doane & Wellington v. Smith, Wheeler, J., 27 Dec., 1882, 1883, C. D. 328; 47 O. G., 202.

28. Uses and results, not set forth in the original, may be stated and described in the re-issue.

An inventor is entitled to all the uses to which his invention can be applied, and to all the beneficial results which legitimately follow the use of his instrumentalities, as shown by the statement of his invention and the figures used to illustrate it; and such uses and results may be stated and described in an application for re-issue by the inventor, without subjecting him to the imputation of incorporating new matter.

Putnam v. Yerrington, Nixon, J., 28 Mar., 1876, 9 O. G., 689.

29. There was nothing in Morse's re-issue (No. 117, 1848) to justify the charge that the invention therein described is not the same with the one intended to be secured by the original patent. The re-issue was made by the proper lawful authority, and it was the duty of the Commissioner of Patents to see that it did not cover more than the original invention. It must be presumed, therefore, that it does not until the contrary appears. Variations from the description given in the former specification do not necessarily imply that it is for a different discovery. The right to surrender the old

patent and receive another in its place was given for the purpose of enabling the patentee to give a more perfect description of his invention, when any mistake or oversight was committed in his first. *It necessarily, therefore, varies from it.*

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

30. Enlarged Claim.

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

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

31. "Different Invention."

An invention embodied in a given structure and restrictedly claimed does not [necessarily] become a different *invention* when claimed more broadly or generically.

Edison, x. p., *Mitchell, Com.*, 6 Jan., 1891, 54 O. G., 263.

32. The Supreme Court has never so construed the Statute (R. S., Sec. 4916), which authorizes re-issues, as to deny to the patentee, on application made in due time and before adverse rights have accrued, the right to obtain a re-issue broad enough to cover his entire invention, as originally described and as he intended to claim it.

Walker v. City of Terre Haute, *Gresham, J.*, 29 Oct., 1890, 54 O. G., 507.

33. Claim may be enlarged if patentee move promptly and before the rights of others have intervened.

There is no rule fixing the precise time within which application for re-issue may be made. What is a reasonable time is a question, when re-issue is attacked, to be decided by the court upon the case presented. The rule is equitable, and therefore flexible, to be applied according to equity. Upon the authority of *James v. Campbell*, and other decisions of the Supreme Court, it is clear that the claim of a patent may be enlarged by re-issue if the patentee move promptly and before rights of others have intervened; and the delay in this case — six months — was not unreasonable.

Odell v. Stout, Sage, J., Oct., 1884, 29 O. G., 862.

34. Where an applicant has by "inadvertence" claimed less than he was entitled to claim, he may have a re-issue with enlarged claims (citing *Topliff v. Topliff et al.*, 59 O. G., 1257). The "inadvertence" upon which applicant relied was simply that he had taken a claim of less breadth than he was entitled to in his original patent. The original specification makes a suitable disclosure on which the claims now presented might be based. Neither of these claims was presented in the original case, but there was no statement distinctly negating the idea that applicant had a right to make them. In the period between the original issue and the present application no evidence appears of the manufacture, sale, or use of the invention by others than the inventor and his assigns. Decision of Examiners-in-Chief reversed.

Stanley, x. p., Simonds, Com., 22 July, 1892, 60 O. G., 735.

35. The re-issue of patents with expanded or equivocal claims where the original was clearly neither "inoperative" nor "insufficient," is a great abuse of the

privilege granted by the statute, and productive of great injury to the public. This privilege was not given to the patentee or his assignee in order that the patent may be rendered more elastic or expansive, and therefore more available for the suppression of all other inventions.

Burr v. Duryee, U. S. S. C. By *Grier, J.*, 28 Mar., 1864, 68 U. S., *.

36. A patent for a machine cannot be broadened, on re-issue, to cover a process described, but not claimed, in the original patent. If the process was patentable it should have been included in the original patent.

New v. Warren, *Wheeler, J.*, 22 July, 1882, 22 O. G., 587.

NOTE.—Or in a seasonably presented application for a separate patent on the process.

37. The right to expand a claim by re-issue exists for a reasonable time after the original patent is granted, provided the limits of the original *invention* are not exceeded, and provided the error arose by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention. After the expiration of a reasonable time, no claim may be allowed which exceeds in scope the original claim, even though the latter stated the actual invention too restrictedly. It has now become familiar law that the latter rule must be applied to an application for re-issue filed nearly four years after the granting of the original patent.

Pepper, x. p., *Mitchell, Com.*, 26 May, 1891, C. D. Ms.

For definition of a reasonable limit of time, see *Jones v. Barker*, (13), and *Odell v. Stout*, (33) *supra*.

MUST RELATE TO THE SAME INVENTION.

38. When the claims of a re-issued patent involve a total abandonment of the principles which, in the origi-

nal patent, were stated to be those of the invention, the re-issued patent is invalid.

The Parker & Whipple Co. v. The Yale Lock Co., *Shipman, J.*, 2 Oct., 1883, 25 O. G., 390.

39. It is well settled that only "*the same invention*" can be covered by the re-issue patent. It is equally well settled that the meaning of said phrase has been established to be *whatever invention was described in the original letters-patent, and appears therein to have been intended to be secured thereby* (Parker & Whipple Co. v. Yale Lock Co., 123 U. S., 87,* ; Hoskin v. Fisher, 125 U. S., 217,* ; Flower v. Detroit, 127 U. S., 563 ; and Pattee Plow Co. v. Kingman, 129 U. S., 294, *).

Smith, x. p., *Frothingham, Act. Com.*, 20 Nov., 1891, C. D. Ms.

40. Where it appeared that a patent was granted in 1872 and that the re-issue application was made in 1881, and that no question of inoperativeness or invalidity was raised during that period, and where the sole object of the re-issue was to expand and multiply the claims so as to cover patents issued subsequently to the original: *Held*, that the re-issued patent was invalid because the new claims were not for the same invention set forth in the claims of the original patent. In such a case, the delay of nearly nine years is fatal, especially as no inadvertence, accident, or mistake appears such as would authorize a re-issue with new claims.

Elec. Gas-Lighting Co. v. Boston Elec. Co., U. S. S. C., 6 Ap., 1891, 55 O. G., 429, *.

41. The rule should be;—liberality in the case of original applications;—strict construction in the case of application for re-issue.

To accord the same latitude in applications for re-issue as in original applications would open a wide door to

fraud. A patentee, if allowed to interpolate new uses, new descriptive matter, new names, etc., might, by frequent re-issues, keep full pace with the advancement of the art to which his patent appertains, and might appropriate to his own use improvements and inventions made by others. The rule should be, liberality with original applications, strict construction with applications for re-issue. In departing from the exact form of the original statement, the application should show good reason therefor.

Noyes, x. p., *Leggett, Com.*, 1872, C. D. 118.

42. Norton's re-issue for an improved post-office stamp for printing the post-mark and cancelling the postage-stamp at one blow : *Held*, to be void for the reason of not being for the same invention specified in the original.

James v. Campbell, U. S. S. C. By *Bradley, J.*, 9 Jan., 1882, 21 O. G., 337, *.

43. In such case, the court ought not to be required to explore the history of the art to ascertain what the patentee *might* have claimed. He is bound by his statement of what his invention was.

Ib.

44. If a patent fully and clearly describes and claims a specific invention, complete in itself so as not to be "inoperative or invalid by reason of a defective or insufficient specification," a re-issue cannot be had for the purpose of expanding and generalizing the claim so as to embrace any invention not specified in the original. *Burr v. Duryee* (68 U. S.), reaffirmed and applied.

Ib.

45. Rectification of Claims that were narrower than the Actual Invention.

It may be regarded as the settled rule of the Supreme Court that the power to re-issue may be exercised when

the patent is inoperative either from the fact that the specification was defective or insufficient, or from the fact that the claims were narrower than the patentee's actual invention, provided the error arose from "inadvertence, accident, or mistake," and the patentee is guilty of no fraud or deception; but that such right is subject to the following qualifications:—

(1) That the re-issue shall be for the same invention as the original patent.

(2) That due diligence was exercised in discovering the mistake.

(3) That, if the re-issue be sought for the purpose of enlarging the claim, a lapse of two years from the original grant will ordinarily—though not always—be treated as evidence of abandonment of the new matter to the public to the same extent that a failure by the inventor to apply for a patent within two years from the public sale or use of his invention is regarded by the statute as conclusive evidence of abandonment of the invention to the public.

(4) That, unless otherwise manifest from the record, the court will not review Commissioner's action on question of inadvertence.

Topliff v. Topliff, U. S. S. C. By *Brown, J.*, 2 May, 1892, 36 L. ed., 499, *.

RE-ISSUE IN DIVISIONS.

46. A re-issue is not void because one division of the re-issue is identical with the original patent.

Inter. Terra Cotta L. Co. v. Maurer, U. S. C. C., S. D. N. Y., *Coxe, J.*, 44 F. R., 118.

47. Amendment of original drawing inadmissible.

Where, in an application for re-issue, the drawings presented by applicant were, in all respects, the same as those in the patent, and the Examiner required the addition of a new figure to show a part of the machine in section, which the applicant declined to add, upon the

ground that, being a re-issue application, any amendment of the drawings is prohibited by the statute: *Held*, that (no model having accompanied the original application) a strict interpretation of the statute (4916 R. S.) would forbid any amendment of the drawings, and, while it might be true that the statute might be more liberally interpreted so as to include amendments required by the *Examiners* still there is room for doubt, and the Office would not be justified in forcing an applicant to incorporate an amendment which might possibly result in having his re-issue patent declared void.

Rogers, x. p., *Fisher, Act. Com.*, 19 Mar., 1890, C. D. Ms.

48. The Rule in *Parker & Whipple Co. v. Yale Lock Co.* (123 U. S., 87; 25 O. G., 290). Re-affirmed, that a Patent Office model alone is not to be considered the basis for a re-issue in which a change of the [scope of the] invention of the original patent is sought.

Flower et al. v. City of Detroit, U. S. S. C. By *Blatchford, J.*, 14 May, 1888, 43 O. G., 1348, *.

49. Invalidity of a claim in a re-issue does not impair the validity of a claim repeated from one in the original grant and separately stated in the re-issue.

Schillinger v. Greenway, *Blatchford, J.*, 11 July, 1883, 24 O. G., 495.

50. Where an original patent is valid, but the re-issue based thereon is invalid, there is no good reason why a second re-issue, 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.

51. No action can be sustained under a re-issued patent for damages for alleged infringement committed before the date of re-issue.

Moffitt v. Garr, *Leavitt, J.*, Ap., 1860, 1 *Fisher*, 610.

REJECTION.**1. Grounds of.**

Either a description [such as would enable an expert to practice the invention by the exercise of ordinary judgment and skill] in a patent or a printed publication antedating claimant's disclosure, or public use of the invention in the United States antedating his application by more than two years, if discovered before grant, justifies its refusal, or, if after the grant, its invalidation.

Sec. 4887 R. S.; Sec. 4920 R. S.

2. Should embrace all objections.

Rejection, in whole or part, of an application should embrace all objections, both those relating to form and those relating to substance, in order that the entire merits of the application may be determined on a single appeal to the Examiners-in-Chief.

Wiard, x. p., *Mitchell, Com.*, 19 Mar., 1890, 51 O. G., 155.

3. When a claim is criticised in matter of form only, such criticism should be put into the form of an *objection* and not a rejection. Claims should be rejected only upon grounds which are appealable to the Examiners-in-Chief.

Pfingst & Bemis, x. p., *Fisher, Act. Com.*, 24 Mar., 1890, C. D. Ms.

4. Upon a petition from rejection of a claim presented by amendment: (1) on the ground of being new matter; but also (2) from Examiner's neglect to take timely action on the merits of the claim: *Held*, that on the first point the remedy was by appeal to the Examiners-in-Chief under Rule 133; but on the second point the petition was sustained; it was the Examiner's duty, in rejecting the claim, to reject it for all the reasons which,

in his opinion, are applicable (Bailey, x. p., 52 O. G., 608. See also Roberts, x. p., 51 O. G., 155; and Wiard, x. p., 51 O. G., 155).

Blanchard, x. p., *Frothingham, Act. Com.*, 16 Dec., 1891, C. D. Ms.

5. Indefiniteness. — “Merits.”

Upon petition from rejection by Examiner of a claim for indefiniteness, and where the language in the Examiner's statement showed that his real objection was inoperativeness, because of the absence of a necessary feature and want of novelty: *Held*, that they were proper grounds for rejection on “the merits,” but not for indefiniteness, and the objection as to indefiniteness overruled, without prejudice as to rejection for inoperativeness or in view of the prior art.

Perkins, x. p., *Simonds, Com.*, 29 Dec., 1891, C. D. Ms.

6. New Matter. — Appeal to Examiners-in-Chief.

Where the objection of inoperativeness was removed by amendment, but the Examiner finally rejected the application upon the ground that the amendment constituted “new matter not shown or described in the application as originally filed:” *Held*, upon petition to the Commissioner, that appeal should have been taken to the Examiners-in-Chief, and although it seemed that the amendment set forth an operative invention “by material and obvious changes,” yet that question was for the Examiner to decide, subject to appeal to the Examiners-in-Chief.

Kinn, x. p., *Mitchell, Com.*, 28 Feb., 1891, C. D. Ms.

7. Surmise not a proper ground for rejection.

Although it may be suspected that the device in a reference has, possibly, the action that applicant's device

has, such a suspicion is not a proper basis for rejection. To treat such a suspicion as a certainty would be to read something into a patent in view of later developments.

Aldersley, x. p., *Simonds, Com.*, 17 Feb., 1892, C. D. Ms.

NOTE. — In this case the Commissioner reversed the Board's action which rejected Claim 2, but expressed the opinion that "applicant's original Claim 2 limited and specified his actual improvement better than the Claim 2 above quoted," and the Examiner in charge was recommended to adopt the same "in accordance with applicant's proposed amendment of this date."

8. References, Applicant's Right to demand.

Examiner having rejected the application for lack of novelty, but cited no references; applicant petitioned that the Examiner be instructed to either allow the case or to reject, as provided under the rules, by the citation of references: *Held*, that as it did not appear improbable that the device might be patentable if a certain scale on one of its sides were new, for that reason, if for no other reason, the applicant should, if possible, be given a reference showing that that particular scale was old, so as to enable him to judge of the propriety of further prosecuting the case by way of appeal.

Seeman, x. p., *Frothingham, Act. Com.*, 13 Oct., 1891, C. D. Ms.

9. Application of References to specific Claims, — Rule 66.

Where Examiner's letter advised applicant what elements of the various combinations claimed by him might be found in the prior art, and then said, "In view of these references the case is believed to possess no patentable novelty, and the claims are believed not to embrace patentable combinations," and applicant peti-

tioned, asking Commissioner "to rule that the Examiner shall apply the references to the claims:" *Held*, that there is no rule of the Office requiring that an "Examiner shall apply the references to the claims," and that that part of Rule 66 which requires the anticipated claims to be specified was observed in the Examiner's letter by the use of the words "the claims are not believed to embrace patentable combinations," as that meant all of the claims; and that it must be held that the Examiner had said enough to inform an experienced attorney of the substantial nature of the objections he had made. Petition denied.

Bowen, x. p., *Simonds, Com.*, 28 Dec., 1891, C. D. Ms.

10. Newly discovered References.

On discovering new ground for rejection after an appeal has been taken, the Examiner's proper course is to direct the attention to it of both applicant and the Examiners-in-Chief. The applicant, thereupon, may elect either —

(1) To continue the prosecution of the appeal, in which case, the Examiners-in-Chief render their decision, affirming or reversing the decision of the Primary Examiner *upon the "points" upon which the appeal has been taken*, considering all other matters referred to by the Examiner in a separate statement annexed to their decision, or, in case of waiver by the applicant, including them in their decision; or, on the other hand,

(2) Applicant may withdraw the appeal and, on complying with the rules, may be heard by the Primary Examiner with reference to said newly discovered ground of rejection in the same manner as if it had been discovered and cited before the appeal was taken.

Mevey, x. p., *Mitchell, Com.*, 19 Ap., 1891, C. D. Ms.

11. Second rejection not final if based on a new reference or ground of objection.

Where the first rejection was based entirely upon a prior patent and the second rejection was based on the

objection that the subject-matter of the claims was merely the result of the substitution of equivalents: *Held*, that, the second letter raised a ground of rejection which was not raised in the first letter, and that therefore the claims were not ready for final rejection.

Anderson, x. p., *Fisher, Act. Com.*, 24 Nov. 1890, C. D. Ms.

REMANDMENT.

To Primary Examiner.

Where an objection was raised before the Examiners-in-Chief by a passage in the Primary Examiner's statement: *Held*, upon a petition to re-open, that, the objection not having been raised by the Examiner when the case was before him, applicant should be afforded opportunity to contest it or to offer amendments calculated to remove it, and the petition was granted.

Ries, x. p., *Mitchell, Com.*, 23 Mar., 1891, C. D. Ms.

Compare Mevey, (4) EXAMINER.

RENEWAL OF ALLOWANCE.

1. Every patent is required to bear date as of a day not later than six months from the time at which it was passed and allowed and notice thereof was sent to the applicant or his agent; and if the final fee is not paid within that period the patent shall be withheld.

R. S., 4885.

NOTE.— If final fee is received within six months after original allowance but too late for the patent to *issue* within that time, the Office customarily renews the allowance so as to secure a valid issue.

2. There is no statute or rule by which an allowed application, on which at or before the expiration of six months the final fee remains unpaid, will be saved from

forfeiture by the fact of a new application for the same invention having been previously filed.

Manny, x. p., *Hall, Com.*, 16 July, 1888, 44 O. G., 700.

3. In case of an allowed application in which renewal fees were paid but in which the final Government fees for issue of patent on the original application were not paid before the lapse of six months from allowance; the action of the officer in charge, in permitting the filing of renewal and accepting a renewal fee, was in contravention of law and of the ruling in Manny, x. p. (44 O. G., 700), and was rescinded, and the application was directed to be placed among allowed and forfeited cases and the applicant to be notified thereof.

Nicholson, x. p., *Mitchell, Com.*, 17 June, 1890, 52 O. G., 310.

4. Nevertheless a *new* application may be made for the same invention at any time within two years after the allowance of the original application.

R. S., 4897.

See also Thomson *v.* Waterhouse, (1) RENEWED APPLICATION.

5. In presenting a renewal (under authority of R. S., sec. 4897, and of Patent Office Rules 175 and 176) of an application that, after having been allowed, had been forfeited by reason of non-payment of the final fee, the applicant has a right to present new claims if he desires.

Barrett, x. p., *Simonds, Com.*, 16 Sep., 1891, 56 O. G., 1564.

RENEWED APPLICATION.

1. An application, in lieu of one forfeited by non-payment of final fee may (within 18 months thereafter), be filed by any party in interest, and dates back to original application.

Sec. 4897, R. S., permits *any person having an interest in an application* that has been allowed and become forfeited by non-payment of the final fee, to file a new application for patent for the same invention, at any time within two years after such allowance. Such new application is held to be a continuation of the original application to the extent that it relates back to and *adopts its date*.

Delay in renewing under the statute may, however, raise a presumption of abandonment, and this should be met by applicant's oath to facts which negative such presumption.

Thomson *v.* Waterhouse, *Butterworth, Com.*, 31 Dec., 1884, 30 O. G., 177.

2. New Claims may be presented.

In renewing an application, the applicant has the right to present new claims, if he desires.

Barrett, *x. p.*, *Simonds, Com.*, 16 Sep., 1891, 56 O. G., 1564.

RE-OPENING OF CASE.

1. For new claims, must take place prior to appeal.

It is not "sufficient cause" for re-opening a case under Rule 142, that applicant would have presented the claims sooner had he not been of the opinion that the claims already in the case were clearly patentable, and would be allowed, on reconsideration, by the Examiner; and that he did not present them after final rejection and before appeal to the Examiners-in-Chief because he thought they would follow their usual custom and suggest more limited claims, if of opinion that the broad claims appealed were not patentable.

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

2. To enable presentation of claim to product after rejection of claim to process.

Where the process for making an explosive cartridge was considered the same as a patented process for treating lime to keep it pure and unslacked, the decision of Examiners-in-Chief rejecting a claim for the method was sustained, but, at the same time, the case was re-opened for the introduction of a claim for the cartridge, stating its contents and how the same was enclosed therein.

Butterfield & Batchelor, x. p., *Simonds, Com.*, 28 Jan., 1892, C. D. Ms.

Of like purport, see Rogers, x. p., (7) EXAMINATION.

Compare, however, Kinzer, x. p., (54) THE CLAIM; Phelps, x. p., (14) AMENDMENT; and Jamieson, x. p., (8) RE-INSTATEMENT OF CLAIM.

3. After allowance.

Under Rule 78, amendments are not permitted after the case has passed to issue unless some special "*showing*" is made which would warrant the re-opening of the case in order that justice may be done to the applicant, and unless, also, some explanation is given of the delay in presenting the amendment.

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

4. By Examiner's incorporation of additional claims.

Where the Examiner refused to forward an appeal filed more than two years after final rejection but within two years after his admission of an amendment presenting additional claims: *Held*, that, under the provisions of Rule 68, it is only such amendments as cancel claims, or present those rejected in better form for consideration on appeal, that may be admitted, after such action upon an application as will entitle applicant to an appeal to the Board without "a showing, duly verified, of good

and sufficient reasons why they were not earlier presented ;” hence, an amendment that presents additional claims is clearly one touching the merits of the application, and, even though the Examiner stated that the claims were admitted “for the purpose of appeal,” the incorporation into the case of such claims amounted, in effect, to a re-opening of the case.

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

5. After final rejection.

Where, after final rejection, applicant submitted an additional claim which the Examiner admitted without protest and without the “showing” required by the second clause of Rule 68 : *Held*, that the admission of the new claim amounted to a re-opening of the case, and that it was therefore error to thereafter refuse admission to an amendment comprising a new specification and new claims on the ground that the application was under final rejection.

Johnston, x. p., *Frothingham, Act. Com.*, 18 Mar., 1892, C. D. Ms.

6. On mere change of phraseology, — denied.

Where the right of appeal to the Commissioner from the action of the Examiners-in-Chief affirming the Primary Examiner’s rejection of certain claims, remained, a petition to re-open the case and substitute new claims in place of those rejected : *Denied* because the two sets of claims were substantially equivalent, and there was therefore no reason for causing the Examiner and Examiners-in-Chief to pass upon the claims proposed.

Cheesebrough, x. p., *Simonds, Com.*, 21 Aug., 1891, C. D. Ms.

Compare Gibbs, x. p., (2) and Johnson, x. p., (15) AMENDMENT.

7. Before the Primary Examiner.

Where the Examiner urged that, under Rule 142, a case which had been decided by the Examiners-in-Chief will not be re-opened except for the consideration of matter not already adjudicated: *Held*, that the power of the Examiners-in-Chief to recommend the granting of a patent on grounds not involved in the appeal is not so limited that they cannot recommend the allowance of a claim that has already been acted upon.

Roberts, x. p., *Mitchell, Com.*, 18 Dec., 1890, C. D. Ms.

8. Where, in pursuance of the recommendation of the Examiners-in-Chief under Rule 139 (a), the applicant presented two claims, one in the form recommended and the other varying slightly therefrom, and the Examiner held that the second claim fell without the recommendation, and that, taking the amendment as a whole, he was not authorized to open the case: *Held*, that the principle laid down in Holt, x. p. (1887, C. D. 4), would seem to exclude such rigor and strictness of interpretation as the Examiner applied to the recommendation of the Examiners-in-Chief, and, as the second claim could fairly be said to be within the contemplation of the recommendation, it was the Examiner's duty to have incorporated it for consideration.

Ib.

9. By act of the Examiner.

Rule 142 has been interpreted to mean that a case will not be re-opened for further action by the applicant without authority from the Commissioner, but the understanding has not been universal that the rule was intended to prevent an Examiner from citing newly discovered references without like authority.

Sutton x. p., *Mitchell, Com.*, 15 June, 1891, C. D. Ms.

NOTE. — The Commissioner quoted the last paragraph of Rule 142, and said, that from a careful scrutiny of the paragraph it would seem to be inconsistent with the exercise of a right by the Examiner to re-open the case without authority, and such a requirement would seem to be even in the interest of the public; but inasmuch as applicant's waiver of the irregularity prevented the question from arising in the case, and as the paragraph referred to is a recent one and appears for the first time in the last edition of the Rules, and as its relation to cases like the present had never received judicial consideration, and as no conclusion should be pronounced on the subject unless after much more thought and investigation than he was then able to give it, he purposely refrained from deciding that question at this time.

10. A motion for re-opening a case or for a new trial in the Patent Office is not to be determined by the same rules which obtain in courts of law. The questions here to be decided are: Who is the prior inventor, and [whether to any one, and if to any one] to whom the patent should issue. In order to determine these questions it is necessary that the testimony material to establish who was the prior inventor, and by whom [and how long before his application] the invention was first reduced to practice, should be received at any time before the patent issues.

Eccard v. Drawbaugh, Marble, Com., 5 July, 1883, 14 O. G., 301.

11. The primary test in determining a motion to take additional testimony after a case has been closed is whether the testimony was accessible or capable of being produced at the proper time by the exercise of diligence on the part of the party seeking its introduction. It is not sufficient for the party making the motion to show that he has used ordinary diligence in

the matter. He must show conclusively that he left no stone unturned in the preparation of his case, and that he was zealous and diligent in a high degree. The question of materiality is not the first to be considered, and, if it becomes a question at all, it is one of secondary consideration.

Schmiedl v. Booth, Simonds, Com., 24 Oct., 1891, 57 O. G., 695.

See also *Edison v. Maxim v. Swan*, 57 O. G., 696.

RE-OPENING OF INTERFERENCE.

Petitions of Gray and McDonough to re-open the interferences [between applications for patent for "vocal telegraphy"], and to set aside the decisions and final judgment therein: *Denied* because the showing was deemed insufficient to justify the Commissioner in setting aside former decisions and decrees, and because there was no ground for belief that another trial might change the verdict.

McDonough v. Gray v. Bell v. Edison, Hall, Com., 23 Feb., 1889, 46 O. G., 1245.

RE-ORGANIZATION.

Omission followed by re-organization may constitute patentable novelty, but mere omission does not.

McRoy, x. p., Fisher, Com., 4 Sep., 1869, C. D. 5.

See OMISSION.

REPEAL OF A PATENT.

1. United States Courts have the power to adjudge either one of two conflicting patents void in whole or in part, or to declare it inoperative or invalid in any partic-

ular part of the United States, but only to the extent of affecting the parties litigant, and not in prejudice of the right of surrender and re-issue in valid form. On the other hand, a successful suit to vacate a patent by the Government terminates the existence of the patent itself, and opens the alleged invention to the whole world.

Section 4918, R. S., permits a patentee to bring suit against the owner of an interfering patent, and authorizes the court to declare and adjudge either of the conflicting patents void in whole, or in part, or inoperative, or invalid in any particular part of the United States, according to the interests of the parties in the patent or in the invention patented; but not in prejudice of the rights of any except parties to the suit and those deriving title under them subsequent to the rendition of such judgment. Section 4920 gives a like remedy to the defendant in a suit for infringement who (having, in the general issue, impleaded ground for the avoidance of the complainant's patent) makes good his plea. But the right given to the defendant to make this defence is a right given to him personally and to him alone, and the effect of a successful defence of this character by one defendant is simply to establish the fact that, as between him and the patentee, no right of action exists, for the reasons set up in such defence. But the patentee is not prevented, by any such decision, from suing any number of other supposed infringers and putting each to an expensive defence, in which they all, or some of them, may be defeated, and compelled to pay, because they are not in the possession of the evidence on which the other defendant succeeded in establishing his defence. On the other hand, the suit of the Government, if successful, declares the patent itself void, sets it aside as of no force, vacates it or recalls it, and puts an end to all suits which the patentee can bring against anybody. It opens to the

entire world the use of the invention or discovery in regard to which the patentee had asserted a monopoly. There is nothing in the statutory provisions expressing an intention of limiting the power of the United States to get rid of a patent obtained from it by fraud or deceit; and, although the legislature may have given to private individuals a more limited form of relief, we think the argument is not sound that this specific provision was intended to supersede the affirmative relief to which the United States is entitled, to obtain the cancellation or vacation of an instrument obtained from it by fraud, — an instrument which affects the whole public whose protection from fraud is eminently the duty of the United States. The decree of the Circuit Court, dismissing the bill of plaintiff, is reversed.

The United States *v.* Am. Bell Tel. Co., 45 O. G., 1311, *.

2. Suit to vacate or cancel a patent must be brought in the name of the United States through the Attorney-General.

The accepted procedure for impeachment and vacation of an improperly granted patent appears in the case above cited. Suit in equity, in the name of the United States, was brought in the U. S. Circuit Court for the District of Massachusetts, against the American Bell Telephone Company, a corporation organized under the laws of the State of Massachusetts, and against Alexander Graham Bell, a resident of the District of Columbia. The action was instituted by George M. Stearns, the United States District Attorney for that district, by the direction of George A. Jenks, the Solicitor-General of the United States, the Solicitor-General acting as its Attorney-General in this matter, because the latter officer was under a disability to prosecute this suit.

Ib.

See VACATION OF PATENTS.

RESERVATION, — DESIGNATION.

1. Where an application comprises several inventions that are inadmissible in a single grant, applicant may reserve either one of them for consideration under said application.

If several inventions, claimed in a single application, be of such a nature that a single patent may not be issued to cover them, the inventor will be required to limit the description, drawing, and claim of the pending application to whichever invention he may elect. The other inventions may be made the subjects of separate applications, which must conform to the rules applicable to original applications. If the independence of the inventions be clear, such limitation will be made before any action on the merits; otherwise it may be made at any time before final action thereon, in the discretion of the Examiner.

P. O. R. 42.

2. When an applicant files two or more applications relating to the same subject-matter of invention, all showing, but only one claiming the same thing, the applications not claiming it must contain references to the application claiming it.

P. O. R. 43.

3. When it was desired to reserve certain claims for a cotemporary application, applicant was required to designate the particular application by stating its date of filing and its serial number.

Suffolk Co. v. Hayden, U. S. S. C. By *Nelson, J.*, 3 Wall., 315.
See, also, 21 O. G., 337, *; 25 O. G., 1190; 26 O. G., 273.

4. Cross reference admissible to cotemporary application.

A reservation for a future application of subject-matter disclosed but not claimed in a pending application, but which subject-matter might be claimed there, will not be permitted in the pending application.

P. O. R. 42.

5. A clause in a patent giving notice that the patentee reserves the right to constitute features shown in certain figures of the drawing the subject of a second application, is sufficiently specific if said application was filed before said patent issued, and was identified by its date of filing and serial number.

Rohn, x. p., 25 O. G., 1190; qualified by *dictum* in Finch, x. p., 26 O. G., 273.

See DIVISION OF APPLICATIONS.

REVERSAL: see NOVELTY; REVIVAL OF APPLICATION: see RE-INSTATEMENT OF APPLICATION.

6. Reservation in Office-record, but not in the published specification, of matter described, but not claimed, in the issued patent, — insufficient.

Where an application was rejected upon a prior patent to same applicant, in which the device claimed in the rejected application was disclosed and described, and applicant contended that, in spite of the rule laid down in Mullen & Mullen, x. p., 50 O. G., 837, he was not barred by the fact that he neither applied contemporaneously nor reserved the right to apply subsequently; (1) Because he reserved the right in connection with an amendment filed in the case; and (2) because of the recent decision in Sugar Apparatus M'f'g Co. v. Yaryan M'f'g Co., 43 F. R., 140: *Held*, (1) that the better opinion seems to be that, while the reservation in the record

rebutts such presumption of abandonment as would arise out of the act of cancellation, it does not do away with the necessity of either applying contemporaneously or of making an explicit reservation in the patent itself (Holmes Elec. Co. v. Metrop. Burg. Alarm Co., 33 F. R., 254; Derby, x. p., 26 O. G., 1208); and (2) that the Sugar Appts. M'f'g Co. v. Yaryan M'f'g Co, *supra*, was not in point, for, in that case, the matter stricken out of the claims before the issue of the first patent *was entirely eliminated from the specification*, so that the patent, on its face, did not show or describe anything which was made subject-matter of the second application, and a patent was accordingly allowed to issue thereon.

Stanford, x. p., *Mitchell, Com.*, 7 Feb., 1891, C. D. Ms.

NOTE. — In this case the Commissioner said: "I am impressed somewhat by the argument made which is based upon the decision of the Supreme Court in Webster Loom Co. v. Higgins, 105 U. S., 580, *. In that case it was held that an application on which a patent has issued is a public record which every one is presumed to know. Upon this decision applicant bases a contention that a reservation in the record is just as effective as a reservation contained in the patent granted. In view of what seems to me to be the trend of all the authoritative decisions that are directly in point, I do not see my way clear to adopt the view thus urged. I venture to express the hope, however, that if the applicant has confidence in his position, he will appeal to the Supreme Court of the District of Columbia and obtain an authoritative decision upon the question."

Compare Hill & Prentice, (1) DEDICATION, and numerous cases there cited.

RESTORATION OF INVALIDATED RE-ISSUE TO ORIGINAL FORM.

See *Giant Powder Co. v. Safety Powder Co.*, (50) RE-ISSUE.

REVOCATION OF A PATENT.

See REPEAL OF A PATENT.

RIGHT OF ACTION.

Section 4903 R. S.

Applicant's right of action, at any time within two years after rejection, being statutory under Section 4903 R. S., cannot be abridged by any rule of the Patent Office; and the last clause of Rule 171 means that, in presenting his application for re-hearing, applicant may either insist on his original claim or he may erase or modify it as he may see fit.

Irwin, x. p., *Fisher, Act. Com.*, 19 Feb., 1890, C. D. Ms.

RIGHT TO USE AND RIGHT TO SELL.

Where a patentee has assigned his right to manufacture, sell, and use within a limited district, an instrument, machine, or other manufactured product, a purchaser of such instrument or machine, where rightfully bought within the prescribed limits, acquires, by such purchase, the right to use it anywhere, without reference to other assignments of territorial rights by the same patentee.

The right to the *use* of such machines or instruments stands on a different ground from the right to make and sell them, and inheres in the nature of a contract of purchase, which carries no implied limitation of the right of use within a given locality.

Adams v. Burke, U. S. S. C. By *Miller, J.*, Oct., 1873, 17 Wall., 453, *.

See also *Standard Fold. Bed Co. v. Keeler*, U. S. C. C., Mass., 20 Feb., 1889.

RIGHTS OF GENERIC INVENTOR AND OF AN IMPROVER.

1. An improver upon an original patent has no right to use the original, nor has the original patentee a right to use the improvement without license.

Peters C. C. 399.,

See also *Crehore v. Norton*, *Nelson, J.*, 1853.

2. The patentee of an improvement holds his right to use it in subordination to the claims of the generic inventor.

The original inventor of a class has to break ground and to encounter prejudice; its eventual success incites competition, and it is but fair that subsequent improvers should pay tribute to the originator.

Carr, x. p., 1874, C. D. 11.

3. Later inventors who devise different means for accomplishing the same steps of the method, are entitled only to patents for improvements upon the method or the means of the first inventor, subject to his possession of and right to the invention itself.

Bell v. Gray et al, 15 O. G., 776.

See also 27 O. G., 99.

4. Where a result similar to that of the patent has been once obtained by one kind of a joint, the invention of a special joint for producing the same result does not make the patent cover a function. The field is still open for others to make other joints to be used in the same place for accomplishing the same results.

Pattee v. Motive Plow Co., 22 O. G., 173.

5. During pendency of application for patent for a generic invention, patent for improvement thereupon must be withheld from issue.

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 claim 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 [prolongs] the monopoly.

Upton, x. p., 27 O. G., 99.

See, however, (1) *et seq.*, ORDER OF ISSUE.

REVIVAL OF FORFEITED APPLICATION.

Where there was no evidence that the Patent Office had received an amendment [prepared by applicant's attorney] before the expiration of two years from the last Office action: *Held*, that there was a failure to prosecute within the meaning of Sec. 4894, R. S., but *also, held*, that under said section and in the light of the facts, the case might be treated as one in which the failure to prosecute was unavoidable, and the application was accordingly revived.

Humans, x. p., *Fisher, Act. Com.*, 20 Oct., 1890, C. D. Ms.

See RE-INSTATEMENT OF FORFEITED APPLICATION.

RÔLE OF AN INVENTOR.

A person does not assume the rôle of an inventor until he has devised *the means* whereby his ideas are to be made available to the public.

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

RULE AND EXCEPTION.

For "THE RULE AND THE EXCEPTION," see Dickson *v.* Kinsman, (142) INTERFERENCES, and citations following it.

RULES AND FORMS.

1. The rules of practice governing procedures in the United States Patent Office are made by the Commissioner of Patents subject to the approval of the Secretary of the Interior.

R. S. 483.

2. Conformability to those of the Federal Courts.

While it is the policy of the Patent Office to follow the rules of the Federal courts as far as those rules may be adapted to meet the peculiar conditions of practice in the Patent Office, it was never intended that the Office should not pass such rules for the proper conduct of its business and for the protection of parties before it as best meet its requirements.

Raffard *v.* de Ferranti, *Frothingham, Act. Com.*, 13 June, 1892, C. D. Ms.

3. When obstructive, must give way, — Rule 229.

After the 20 days allowed by Rule 109 for filing amendments, had expired, *L* offered a claim in the exact language of the interference-issue: *Held*, that *L*'s application having been through a prior interference, and the Office having learned thereby that he had invented what was specified in the pending issue, before *H*, his present opponent, claimed [in his preliminary statement] to have invented the same, and that it would be a *stifling of justice in its rules and forms* to permit *H* to take a patent for a thing that, upon showings in the possession of the Office, he was not the inventor of; and that while Rule 109 states what the applicant may do, the case was one which called upon *the Office* to do something of its own motion; that Rule 229 recognizes such actions, and that the Examiner should incorporate the proposed claim as a part of *L*'s application whereby it would become

involved in the interference. *Also, held*, that whether *L* was or was not entitled to make the claim in that particular application, or should file a new application, were questions which could be disposed of *ex parte* after the question of priority between *L* and *H* was finally decided.

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

Compare Designolle, x. p., (17) THE CLAIM; Coe, x. p., (6) CLASSIFICATION; Carter, x. p., (5), and McMahan, x. p., (31), DIVISION.

4. Rule 142, — intended as a check both on Examiner and Applicant.

In a case appealed to the Examiners-in-Chief, they affirmed the Primary Examiner's action except as to one claim. The Primary Examiner thereupon re-opened the case and rejected that claim, on a reference he had previously given for other claims at an earlier stage of the case, but which was not relied upon by him at the time the case was appealed and was not before the Examiners-in-Chief: *Held*, that the Primary Examiner's action was irregular. Rule 142 provides that cases which have been heard and decided by the Examiners-in-Chief will not be opened by the Primary Examiner without the approval of the Commissioner; and this rule is not, as the Examiner seemed to think, prohibitory only of opening for the purpose of admitting an amendment proposed by applicant, but that it is also intended as a check on the Examiner, and to direct that after decision by an appellate tribunal he shall not re-open a case without the approval of the Commissioner. Applicant's petition that the case be passed to issue was, however, refused, and, should the Examiner insist on rejection, the question of anticipation as to that claim can reach the Commissioner only on appeal from the Examiners-in-Chief.

Horr, x. p., *Fisher, Act. Com.*, 25 Aug., 1890.

5. It must be remembered that the *rules* were *made for the cases which arise*, and not the cases for the rules; the spirit and prime purpose of the system of practice must always be kept in mind, and mere details and incidentals subordinated thereto. The case now before me appears to be one not specifically provided for in the Rules, and the claim under consideration is one involving a vital question of form, and also one of merits, and hence falls partly under the effect of two rules of practice, but wholly within the scope of neither. Under such circumstances the claim must be disposed of in accordance with the general spirit and equity of the practice. The rights of the applicant must also be considered and protected.

Carter, x. p., *Hall, Com.*, 1 Mar., 1889, 46 O. G., 1391.

See CLASSIFICATION; DILATORY METHODS; DIVISION OF APPLICATION; REVIVAL OF APPLICATION.

SCOPE OF CLAIMS.

1. A patentee is not limited to the literal import of his description of his invention, but, in construction, he may make such modifications of it as do not involve a departure from its principle or a material change in its mode of operation. A patentee may, however, certainly restrict the comprehensiveness of his patent-right by the tenor of his claims.

Grier *v.* Castle, *McKenna, J.*, 10 Aug., 1883, 24 O. G., 1176.

2. Whether or not the claims are so limited in scope as to distinguish their subject-matter from that of the reference, can only be determined upon a consideration of such reference and of the previous state of the art. This duty devolves upon the Examiners-in-Chief upon appeal, and not upon the Commissioner antecedently to such appeal.

Miller, x. p., *Fisher, Act. Com.*, 30 Ap., 1890, C. D. Ms.

SCOPE OF PATENT.

1. 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 conceived the idea of such use or not.

Challoner *v.* Perkins, *Simonds, Com.*, 30 June, 1892, 60 O. G., 296.

2. It is no new invention to use an old machine for a new purpose. The inventor of a machine is entitled to all the uses to which it can be put, no matter whether he had conceived the idea of such use or not. Invention, such as will sustain a patent, is not attained by a new use or by a mere carrying forward of new or more extended application of the original thought, a change only in form, proportion, or degree, doing substantially the same thing in the same way by substantially the same means, with better results.

Smith *v.* Nichols, U. S. S. C. By *Swayne, J.*, Oct. term, 1874, 1 Wall., 112; 22 U. S., 566, *.

3. Invention is a mental act, but to be subject of patent it must be shown to be of practical utility by a material embodiment.

A patentable invention is a *mental* result. The machine, process, or product is but its material reflex or embodiment. It must be new and shown to be of practical utility. A new idea may be engrafted upon an old invention, be distinct from the conception that preceded it, and be an improvement. In such case it is patentable. The prior patentee cannot use it without the consent of the improver, and the latter cannot use the original invention without the consent of the former. But a mere carrying forward or a new or more extended application of the original thought, a change only in form, proportions, or degree, or the substitution

of equivalents, doing substantially the same thing in the same way by substantially the same means, with better results, is not such invention as will sustain the patent.

Ib.

4. The pioneer inventor will be secured in the fruits of what he invented and covered by his patent, even against a subsequent inventor who, though he may have greatly improved it, uses still the original invention which lies at the foundation of the art.

The *Consol. Roll. Mill Co. v. Combs*, *Brown, J.*, 20 May, 1889, 48 O. G., 255.

5. A patentee will not be permitted to say that certain elements of his claim are material and others immaterial, but where the language of the claim is susceptible of different shades of meaning, the court will aim to give it a liberal or a strict construction according to the relation of the invention to the [prior] art, and to preserve to the patentee that which the inventor actually contributed to the art, if this can be done consistently with the language he himself has chosen.

By the strictly literal interpretation of claims pertaining to the class of inventions adjudicated on in *Rodebaugh v. Jackson* (37 Fed. Rep., 882), and *Sargeant v. Hall Safe & Lock Co.* (114 U. S., 85), nothing more was intended than that where, under the state of the art and the action of the Patent Office, a patentee of a combination has modified and limited his claims, he shall be held strictly to his combination as he has described it. It has always been the law that a patentee is limited by his claims, even though his invention be broader, and that if he include a certain element in a combination he is not at liberty to say that such element is immaterial (*Vance v. Campbell*, 1 Black, 427, *).

Nevertheless, what shall be considered an infringement must depend largely upon the state of the art as it existed at the time the patent was issued, and it must be borne in mind that a combination patent covers not only the elements named, but also such as may be substituted therefor and are known as mechanical equivalents; but what shall be deemed a mechanical equivalent depends largely on the state of the [prior] art in each particular case. When we find a court using language which indicates that the patentee should be strictly limited to the terms of his claim and to the restrictions and the provisos he has inserted therein, we generally find that the invention is only a trifling deviation from or improvement upon what has gone before. When, upon the other hand, the case shows the doctrine of mechanical equivalents to be asserted and liberally applied, it will usually appear that the patent is a pioneer, or at least a marked improvement upon any device which had previously existed. The prime object in construing a patent should be to reserve to the patentee his actual invention if this can be done consistently with the language he has himself chosen. Occasionally it will happen that the patentee will, by inadvertence or mistake, claim less than he is entitled to, and the courts will be powerless to help him; but their disposition is, and should be, to deal liberally with those who have made valuable contributions to the industrial arts. Indeed, the general principle is sustained by abundance of authority that claims of patents should receive such interpretation as will enlarge or restrict them so as to cover the actual invention, when not absolutely inconsistent with the language used by the patentee (*Wimans v. Denmead*, 15 How., 330, *; *Van Martyr v. Muller*, 15 Blatch., 562). If, upon the one hand, the state of the art shows the invention to have been a narrow one, a strict interpretation will be given (*M'f'g Co. v. Ladd*,

102 U. S., 408, *), and it is of no practical consequence whether such restrictions are imposed by the Patent Office or not (*Toepfer v. Goetz*, 41 O. G., 933). If, on the other hand, the patentee has taken a decided step in advance of the then state of the art, the courts will, if possible, so construe the language of his claim as to give him the full benefit of his improvement (*Turrill v. R. R. Co.*, U. S. S. C. By *Clifford, J.*, 11 Ap., 1864, 1 Wall., 491,*. *Rubber Co. v. Goodyear*, U. S. S. C. By *Swayne, J.*, 14 Feb., 1870, 9 Wall., 788,*).

Ib.

6. Foundation Invention.

That the machines manufactured and sold by the defendants may be lighter, smaller, cheaper, more easily operated and more efficient; and that they may be a decided improvement on the Mergenthaler machine, and may, as such, commend themselves more readily to the public; that they are themselves patented, and that, if put in open competition with the earlier machines, they would prove more attractive to purchasers and users — each of which points is pressed with great force by the defendants — is wholly immaterial, if the complainant's main contention is a sound one, viz.: That the Mergenthaler "Linotype" is covered by a foundation patent; that it embodies *a combination wholly new in the printing art, and one which marks the first great step in advance taken for over four hundred years*, and which, though susceptible, as all foundation inventions are, of subsequent improvement, has yet demonstrated its ability practically and efficiently to perform the work which it was designed to do. If, upon the case now presented, it appears that Mergenthaler is a pioneer inventor, he is to be secured the fruits of what he invented and covered by his patent, even as against a subsequent inventor, who — though he may have greatly improved it — uses still *the origi-*

nal invention which lies at the foundation of the art (see cases cited in notes to section 894, Robinson on Patents).

The complainant corporations have apparently endeavored to advertise and promote the sale of their machines both here and abroad. In 1889, and again in 1890, a machine of Mergenthaler's attracted the notice of the Franklin Institute, which is claimed to be a scientific society of high standing, and which awarded two medals in recognition of its ingenuity. Certainly there is no reason to suppose that that branch of the printing art which has occasion to use such machines has for years been ignorant of the fact that an invention of the character described was claimed by Mergenthaler, was being put into practical use, and was offered to the public; but although such invention met a public need, was manifestly of great utility, apparently solved a problem that had been waiting solution for hundreds of years, and seemed destined to work a revolution in the methods of composition for the press, no one undertook to trespass upon the rights secured by the claim of the patent until the defendants' machine was put upon the market within a few months past. The complainants gave due warning by written notice to the defendants (or to those having a common interest with them) that any attempt to manufacture and sell machines such as that of the defendants' would be resisted in the courts, and promptly, upon the exhibition of such machines for sale here, this suit was begun.

There is sufficient here to fortify complainant's contention, especially as there seems so little real question about either the scope or validity of the patent, or the infringement by defendants' machine of the claim above quoted.

National Typographic Co. *et al.* v. Typograph Co. *et al.*, U. S. C. C., S. D. N. Y., *Lacombe, J.*, 11 Mar., 1891.

7. 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 construction of the identical elements which the inventor had a right to claim as new in his patent.

Saladee v. Racine Wagon & Carriage Co., Dyer, J., 28 Ap., 1884, 20 Fed. Rep., 686.

8. Estoppel.

Where a patentee declares upon a combination of elements which he asserts constitutes the novelty of his invention, he cannot, in his proofs, abandon a part of such combination and maintain his claim to the rest, even although he may have brought into his claim more than is necessary to the successful working of his device.

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

9. In an action against the United States, alleging a contract, and seeking to recover royalty for the use of a mail-bag alleged to be covered by plaintiff's patent, which claimed "a mail-bag having a bottom with turned up circumferential flange, and having sides overlapping said flange, and secured thereto by two or more rows of metal-headed rivets, substantially as described," and the same description applied to the Government bag except that only one row of rivets was used: *Held*, that an essential element of the patented combination — the additional row or rows of rivets — was absent. This, at first glance, seems a very narrow construction of the patent, but, if this patent can stand at all it must be upon very narrow grounds. . . . We do not think the

device patentable, but, if patentable, it is not found in defendant's mail-bags. Petition dismissed.

Thomson *v.* The United States, U. S. Court of Claims, No. 16,611, 14 Dec., 1891.

10. The application having been made for an improved rubber boot as distinguished from a shoe, and the whole course of proceedings in the Patent Office having been conducted on that theory, the patentee is estopped from claiming that the patent covers a rubber shoe.

Williams *v.* Goodyear Co., U. S. C. C., Ct. By *Shipman, J.*, 2 Feb., 1892, 49 F. R., 245, 58 O. G., 1257.

NOTE. — The claim in suit (Claim 1, Pat. No. 166,669) was as follows: —

“The improved boot, composed of textile fabric and rubber, having an inner upper cut to fit the last or foot, and an outer upper cut longer than the inner upper with the surplus portion thereof overlapped; substantially as described.”

The applicant, having been referred to a shoe, had claimed useful novelty in his ‘combined foot and leg covering,’ — that is to say, a boot as distinguished from a shoe or covering for the foot only, — and had pressed his application to allowance on those grounds.”

Compare *Rodebaugh v. Jackson*, (9), *Sargent v. Hall Safe & Lock Co.*, *, (10) PUB. RIGHTS AND OBLIGATIONS; *Roemer v. Peddie*, *, (72) THE CLAIM.

See INFRINGEMENT; INVENTION; PUBLIC RIGHTS AND OBLIGATIONS; STATE OF THE ART.

SEASONABLE PRESENTATION.

The question whether the process claim was seasonably presented is an executive one, and, where that question is intended to be raised, the Examiner should refuse to incorporate, and thus lay a basis for a petition to the Commissioner.

Perkins, x. p., *Mitchell, Com.*, 4 Mar., 1891, 55 O. G., 189.

SECOND APPEAL.

See (2) FEE.

SECURITY.**Pending Application.**

Because an applicant has been necessitated to introduce the record of an application in an interference procedure, it does not follow that the Office should allow any and every one to obtain copies of said application. It is a familiar legal principle that matters of necessity are not to be extended beyond the limits of that necessity (P. O. R. 15 ; U. S. Elec. Lt. Co. *v.* Com. of Pats., 54 O. G., 267).

Dyer, *x. p.*, *Simonds, Com.*, 11 Sep., 1891, 56 O. G., 1564.

Compare Fowler, *x. p.*, (1) ABANDONED APPLICATIONS ; U. S. *v.* Com'r of Patents, (1) CERTIFIED COPY.

SENIORITY.**Determined by date of filing *claim* at issue.**

R. although the earlier applicant, was treated as the junior inventor because anticipated by *M* in the date of filing of *the claim* in interference.

Rennyson *v.* Merritt, *Simonds, Com.*, 29 Feb., 1892, 58 O. G., 1415.

See BURDEN OF PROOF ; INTERFERENCE ; PRIORITY.

SIGNATURE.

Rule 40 requires applicant to subscribe to his specification and affidavit with his full name. The law recognizes but one Christian name, and that the first one. Middle names or initials are mere matters of orna-

ment, and their insertion or omission is immaterial (see *Gaines et al. v. Stiles*, 14 Pet., 332).

Gentry, x. p., *Hall, Com.*, 26 July, 1888, C. D. 115; 44 O. G., 822.

SIGNED AND SWORN TO "IN BLANK."

An application that had been signed and sworn to "in blank," ordered stricken from the files.

Where applicant prayed to be allowed to withdraw his case from issue for the purpose of re-presenting it, on the ground that the specification and claim were insufficient and had never been signed by him, and it was evident, not only from his statement, but on the face of the papers, that the application had been signed and sworn to in blank, it was directed that the application be stricken from the files.

Ayres, x. p., *Fisher, Act. Com.*, 3 Jan., 1890, 51 O. G., 1944.

SILENCE.

Silence on the part of the plaintiffs or their assignor and delay in seeking relief, where it did not beguile defendants into a continuation of business or into renewed or large expenditures, does not constitute an estoppel to injunction, but may preclude a claim to past profits.

N. Y. Grape Sugar Co. v. Buffalo Grape Sugar Co., *Shipman, J.*, 20 Nov., 1883, 25 O. G., 1076.

SIMPLICITY.

1. Does not negative invention.

Applicant's process of preparing and tempering slurry for Portland cement is a very simple one, but simplicity does not negative invention. It is really a combination

of process steps, one of which consists in testing a portion of the mass after the materials are mixed in order to determine the proportions, and no reference cited describes a test of this kind at this stage (*Fermentation Co. v. Mans*, 122 U. S., 413). That the results of this simple process are useful in a high degree sufficiently appears. This marked utility in result, coupled with this novel process step, is, in my opinion, sufficient evidence of patentability.

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

2. The allegation that an improvement claimed to be patentable was so simple as to be perfectly obvious, is negatived by the fact that up to the time of its discovery a more expensive compound was in general use.

Sommer, x. p., *Simonds, Com.*, 9 Oct., 1891, 58 O. G., 1255.

3. As a patentable characteristic.

As compared with the references, applicant has *reduced a mechanical idea to its simplest possible terms*, — so simple indeed that it seems almost strange that the two prior inventors should have gone so far around to reach the common result; but they did thus go around, — *two of them did it*, — and I cannot be sure that, in the attainment of the simplicity reached by applicant, he did not exercise the inventive faculty. Simplicity may indicate rather than negative invention. The adverse decision of the Examiners-in-Chief is therefore reversed.

Luse, x. p., *Simonds, Com.*, 17 Nov., 1891, 58 O. G., 1414.

See PUBLIC ADOPTION; OMISSION; SUCCESS AS A TEST; UTILITY.

SIMPLIFICATION.

See NOVELTY; OMISSION; SIMPLICITY.

"SKILLED IN THE ART."**Definition.**

By the words "skilled in the art" as used in the statute, is not meant extraordinary ability but merely fair or ordinary expertness in that particular line.

Kerr, x. p., *Dyrenforth, Act. Com.*, 26 Feb., 1884, 28 O. G., 95.

SOLICITOR.**Power to act ceases at applicants' death.**

Authority delegated to an attorney, solicitor, or agent ceases with the death of the applicant, and any steps relating to the application or issue thereafter taken by such agent are without authority and void (*Eagleton M'f'g Co. v. West Bradley & Cary M'f'g Co.*, 111 U. S., 149, *).

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

See ATTORNEY ; DECEASED INVENTOR.

SPECIES.**"Species" of a generic invention defined.**

In a patent for a machine, "species" (in the plural) may be practically defined as two or more devices for effecting the same purpose and having a common characteristic.

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

THE SPECIFICATION.

1. The specification must set forth the invention in such full, clear, and exact terms,—describing the best mode known to the applicant of carrying out the practice of the invention,—as to enable one skilled in the

art to which it appertains to compound and use it without making experiments of his own.

Wood *v.* Underhill, U. S. S. C. By *Taney, Ch. J.*, Jan., 1847, 5 Howard, 3, *.

Of like tenor, see R. S. 4888.

2. The patentee is bound to disclose in his specification the best method of making his machine that was known to him at the time of making the application.

Page *v.* Ferry, *Wilkins, J.*, Oct., 1857, 1 Fish., 298.

3. But failure to describe the best means for making a patented device will not invalidate a patent, unless done with fraudulent intent.

Magic Ruffle Co. *v.* Douglass, *Shipman, J.*, Feb., 1863, 2 Fish., 330.

4. The specification must be complete. No defects can be obviated by extraneous evidence at the trial; but the utmost precision in the description of a machine is not essential. Parts of machinery and processes generally known [in the art] need not be described. Nor is it essential to state the proportions or velocities of the parts; size or velocity makes no difference in the principle.

Brooks *v.* Bicknell, 3 McLean, 441.

5. If an improvement in a well-known appendage to a machine is fully described in a specification, it is not necessary to show the ordinary mode of attaching the appendage to such a machine. The patent is to be read as if the machine and its appendage were present or in the mind of the reader, and he a person skilled in the art.

Webster Loom Co. *v.* Higgins, U. S. S. C. By *Bradley, J.*, 8 May, 1882, 21 O. G., 2031, *.

6. The contract of the public is not with him who has first discovered [merely], but with him who also makes his discovery usefully known. If he has discovered much and discloses little, communicates to the world only one of the mere derivative truths of the principle he has discovered, he patents no more than he has proclaimed. He will not be allowed afterward, when the extent of his right shall be the subject of controversy, to expand into a general expression what was before limited to a particular form, and argue that he had described the whole by implication from the part.

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

7. An objection to the validity of a patent because of an insufficient specification, raised in argument but not set up as a defence in the answer, cannot be considered.

*Rubber Co. v. Goodyear, U. S. S. C. By Swayne, J., 14 Feb., 1870, 9 Wall. 807, **

See, also, *Wonson v. Peterson, Shipley, J., 11 Mar., 1878, 3 O. G., 548.*

8. A patent claim must be construed in the light of the specification.

Evans v. Kelly, Drummond, J., Jan., 1880, 23 O. G., 192.

9. Examiner should interfere as little as possible with the language chosen by the applicant in describing his invention.

In applications for patents, the Examiner should interfere as little as possible with the language chosen by the applicant in describing his invention. The largest latitude should be allowed. In applications for re-issue, on the contrary, a different rule does and should prevail. To accord the same latitude as in original applications would open a wide door to fraud. A patentee, if allowed

to interpolate new uses, new descriptive matter, new names, etc., might, by frequent re-issues, keep full pace with the advancement of the art to which his patent appertains, and might appropriate to his own use improvements and inventions made by others; the rule should be, liberality with original applications, strict construction with applications for re-issue.

Noyes, x. p., *Leggett, Com.*, 1872, C. D. 118.

Of like purport, see Myers, x. p., (21) AMENDMENT; Holt, x. p., (1) NEW MATTER; and Pacholder, x. p., (1) PHRASEOLOGY.

Compare also Lapham, x. p., (4) AMENDMENT; and Rogers, x. p., (2) EXAMINATION.

See, however, Bromley, x. p., *infra.* and Raymond, x. p., (11) THE CLAIM.

10. Applicant in trying to “*confine his description to the specific improvement and such parts as necessarily cooperate with it,*” enjoined in Rule 36, must not disregard the requirement of Rule 34 that the specification shall be couched “*in such full, clear, concise, and exact terms*” as to enable any person skilled in the art to make, construct, compound, and use the invention.

Bromley, x. p., *Mitchell, Com.*, 18 Oct., 1889, C. D. Ms.

11. All that the law requires of an inventor, so far as the description of his device in his application is concerned, is that it shall be sufficiently full, clear, and exact to enable a person skilled in the art to practise the same. Even though the description is slightly defective, yet, if it contains all that is necessary to enable a skilled reader to practise the invention by correcting the defect, it is sufficient.

Atkinson v. Bentley, *Mitchell, Com.*, 29 May, 1891, C. D. Ms.

12. One illustration sufficient.

Where the invention was applicable to and might be used in connection with a large variety of devices and apparatus: *Held*, that, for that reason if for no other, it was desirable to confine the illustration of such adaptability to one of such devices or apparatus; its adaptability to the others being obvious.

Soden, x. p., *Frothingham, Act. Com.*, 15 Oct., 1891, C. D. Ms.

13. Sufficiency of Illustration, — Examiner proper Judge of.

The question of the proper illustration of an invention is held to be largely within the sound judgment and discretion of the Examiner, who is presumed to be an expert, and it is the practice of the Office not to interfere in such cases unless the Examiner is manifestly in error.

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

SPIRIT OF THE LAW.

See (56) INTERFERENCES; (1) *et-seq.*, ORDER OF ISSUE; and (5) RULES AND FORMS.

STATE OF THE ART.

1. The patentee has, in his description, the right to assume that those who desire to understand all the conditions under which his invention could be operated are acquainted with the preceding state of the art immediately relating thereto.

Tompkins v. Gage, Shipman, J., 26 Oct., 1865, 5 Blatch., 396.

2. Matter introduced to show the state of the art in construing the patent cannot be permitted to defeat the suit by antedating the invention, when that issue was not raised by the pleadings.

Middletown Tool Co. v. Judd, Shipman, J., Feb., 1867, 3 Fish., 141.

3. A prior patent, not admissible in evidence on the question of novelty of complainant's invention because of no allegation to that effect in the answer, may be properly put in evidence to show the state of the art and to restrict the claim.

Delong v. Bickford, *Coxe, J.*, 22 July, 1882, 22 O. G., 2242.

4. Evidence of the state of the art showing the prior existence of analogous devices for substantially the same purpose, but not fully exhibiting the device patented, operates to narrow the field for the exercise of inventive faculty and to limit the range of the patent.

Washburn & Moen M'f'g Co. v. Haish, *Blodgett, J.*, 14 Oct., 1879, 10 Biss., 65 ; 18 O. G., 465.

5. Proof of the state of the art is admissible in equity cases without any averment in the answer touching the subject, and in actions at law without having given the notice required for admission of evidence to invalidate a patent, in order to distinguish what is new and to aid the court in construing the patent.

Dunbar v. Myers, U. S. S. C. By *Clifford, J.*, 18 Dec., 1876. 4 Otto, 187.

6. Testimony of witnesses examined in a case as to alleged prior use by parties not set up in the answer, can only be considered by the court for the purpose of showing the state of the art at the time of the patentee's invention. The same rule would apply to printed publications by which it is sought to anticipate the invention.

Gier v. Goetinger, *Swing, J.*, Oct., 1874, 7 O. G., 563.

7. The testimony of witnesses of whose names no notice was given by the complainants is admissible to show the state of the art, but will receive no considera-

tion upon the question whether there had been a prior knowledge and use of the invention.

La Baw v. Hawkins, Nixon, J., 6 O. G., 724.

8. Letters-patent No. 229,127 : *Held*, to be limited by the prior state of the art, and as limited not infringed.

Kampfe v. Aloe, Shipman, J., 25 Ap., 1888, 44 O. G., 1292.

9. In view of the prior art, which shows that it is old to crimp in and fold the ends of boxes of pasteboard and other stiff material, and also that it is old to turn the edge of metallic cylindrical vessels or packages : *Held*, that if the first claim of the Hoff patent can be supported at all, it can only be for the formation of the *entire* bottom of the crimped material and the resultant increase of thickness. The Hoff patent is not infringed by a coal-hod whose bottom is only partially formed by crushing in of the body-metal and closing the remaining aperture by a cap.

Hoff et al. v. Iron Clad M'f'g Co., d: 30 Mar., 1891, 55 O. G., 139,.*

10. In a suit for infringement of letters-patent, where complainant calls an expert witness to point out resemblances between the patent and the alleged infringing device, and asks him to interpret the claims of the patent in so doing, he cannot be required to refrain from considering the prior state of the art in giving his testimony.

Am. Linoleum M'f'g Co. v. Nairn Linoleum Co., Lacombe, J., 22 Dec., 1890, 55 O. G., 142.

See INFRINGEMENT; INVENTION; PATENTABILITY; SCOPE OF PATENT.

STATUTES OF LIMITATIONS.

A State Statute of Limitations is not pleadable in bar of an action at law for infringement of a patent (following *McGinnis v. Erie Co.*, 45 Fed. Rep., 91).

Cal. Art. Stone Paving Co. *v. Starr et al.*, *Hawley, J.*, 14 Dec., 1891, 58 O. G., 1094.

See also *Brickill et al. v. City of Hartford et al.*, *Shipman, J.*, 6 Feb., 1892, 58 O. G., 1417.

"STEP BY STEP ARGUMENT."**Danger of, in Citation of prior Art.**

The patentability of a process having been denied upon the ground that a claim by the same applicant in a former application for a process of manufacturing asphaltum from crude petroleum or a residuum thereof, having been held destitute of patentability, it did not make a new process to practise the same operation in the treatment of crude petroleum or a residuum of the same free from paraffin wax: *Held*, that of that proposition two things were to be said: (1) that it is never safe to determine patentability, upon such a step-by-step argument, and (2) that the substitution of material in a process where chemical or *quasi* chemical actions take place may evolve a change of substance. The probabilities as to the presence or absence of patentable novelty being in applicant's favor, the decision of the Examiners-in-Chief was reversed.

Dubbs, x. p., *Simonds, Com.*, 15 June, 1892, C. D. Ms.

Compare Smith, x. p., (8), and Keene, x. p., (9) COMBINATION.

STIPULATION.

No stipulation can be interpreted so as to require a party to do impossible things, nor should its observance

be rigidly enforced where the testimony desired cannot be so readily obtained by an action strictly in accordance with the stipulation as by one not in strict accordance with it.

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

SUBSTANTIAL AMENDMENT.

Where question involves "the merits," appeal lies to Examiners-in-Chief.

In determining whether a certain amendment of a rejected claim is sufficiently "*substantial*" to entitle applicant to two actions therein, the Commissioner will not [at that stage of the proceedings] pass judgment on the bearing of the official references, as to do so would be to decide a question pertaining to the merits of the application, which can be considered by him only on an appeal from an adverse decision of the Examiners-in-Chief.

Arnold, x. p., *Mitchell, Com.*, 6 Feb., 1890, C. D. Ms.

Compare, of same tenor, Gibbs, x. p., (2), Lapham, x. p., (5) AMENDMENT.

SUCCESS AS A TEST.

1. Accomplishment of a result that had been long unsuccessfully sought.

The patent of Thos. A. Edison, 27 Jan., 1880, related to an Incandescent Electric Lamp which consists essentially of incoming and outgoing conductors united by a carbon filament of high resistance within a vacuum in a glass receiver through which the conductors pass. The invention was consummated by Edison in the year 1879 after many months of experiment with different materials under different conditions. He had devised a platinum lamp in which success was thought to lie, but

its cost (\$1.50) rendered it unavailable for ordinary use. He continued his experiments. At length he made the discovery that carbon would stand a high temperature, even when very attenuated, without undergoing disintegration, if operated in a high vacuum. This fact he utilized, producing a lamp having a filamentary carbon burner in a nearly perfect vacuum.

Experts, called for the U. S. Elec. L't'g Co., in the progress of the case, testified that such change of material involved no invention, because the use as a substitute for platinum, of carbon of any size operated in a vacuum, would be obvious to any one skilled in the art. To this the judges could not assent. They said:—

Sawyer and Man were skilled in the art, but, even after they had learned how to force out the occluded gases and withdraw them from the lamp-chamber, they turned away from the vacuum thus ready to their hands, feeling no doubt that they were following the teachings of the art in seeking stability, by the use, not of vacuum, but of a nitrogen atmosphere.

Edison was skilled in the art, but, after he had secured the nearly perfect vacuum of the French patent, secured against leaking by the all-glass globe of Geissler and Crookes, it was only after months of patient and persistent experiment that he found, in the substitution for his platinum of a filament of carbon, the success he had long sought for but not till then attained.

Edison Elec. Co. (respondent) v. The U. S. Elec. L't'g Co. (appellant), U. S. C. C. of Appeals, *La Combe and Shipman, JJ.*, 4 Oct., 1892, *.

2. "It is the last step that wins."

Courts will sustain a patent to a man who has taken the final step which has turned a failure into a success. *In the law of patents, it is the last step that wins.*

Washburn & Moen M'fg Co. v. The Beat Em All Barbed

Wire Co., U. S. S. C. By *Brown, J.*, 27 Feb., 1892, 58 O. G., 1555, *.

Of like purport to the above ruling, see *McClain v. Ort-mayer*, *, (6), and *Chamfrey*, x. p., (8) PATENTABILITY; *Spielman*, x. p., COMMERCIAL SUCCESS; *Smith v. Goodyear Dental Vulc. Co.*, *, (1), *The Consol. Valve Co. v. The Crosby Valve Co.*, (2), and *Magowan v. N. Y. Belting Co.*, *, (11), THE DECISIVE STEP; *Bruce v. Marder*, (1), *Renwick v. Pond*, (3), *Dederick v. Cassell*, (4), *Shuter v. Davis*, (5), *Hoe v. Cotterell* (7), (8), *Brown M'fg Co. v. Deere & Co.*, (9), and *Pullman Pal. Car Co. v. Boston & Albany R. R. Co.*, (10) UTILITY; *Shannon*, x. p. (10) INVENTION; *Boyd v. Cherry*, *Gill v. Scott*, and *Green v. Hall*, all (163) INTERFERENCES; and 1 *Robinson on the Law of Patents*, 554 *et seq.*

SUGGESTION.

1. To overcome an already granted patent the incipient idea must have been followed by a conception of a means or mode of carrying it out, and that by a publicly known reduction of the same to actual practice.

Coffin v. Ogden et al., U. S. S. C. By *Swayne, J.*, Oct., 1873, 21 U. S., 821, *.

2. Mere conversations about the practicability of an improvement, or suggestions as to the manner in which it might be carried out or accomplished, will not of themselves defeat the claims to originality of him who perfects the idea and secures a patent, but information to the patentee sufficient to have enabled him to construct the thing itself would.

Judson v. Moore, *Leavitt, J.*, 1 Bond, 285.

3. A mere suggestion that a given result may be obtained is not patentable, and does not anticipate a patent producing such result.

Graham v. Gammon, *Blodgett, J.*, July, 1877, 7 Biss., 490.

4. An invention is not the less novel because the patentee developed it from ideas which were suggested to him by others.

Roberts *v.* Dickey, *Strong, J.*, 4 Brewster, 260.

5. Where an idea is suggested by one and utilized by another, — *semble*, that a joint patent should be taken out.

Thomas *v.* Weeks, *Thompson, J.*, May 1827, 2 Paine, 92.

See CONCEPTION; INTERFERENCES; INVENTION; JOINT INVENTION; REDUCTION TO PRACTICE.

SUGGESTION OF COURT.

Should be admitted for examination.

Where, upon an appeal to the Supreme Court of the District of Columbia, the court affirmed the adverse decision of the Commissioner, but made suggestions in supposed accord with which claims were subsequently presented, which the Examiner refused to entertain, because —

(1) The suggestion of the court was not sufficiently definite and clear; and (2) The construction suggested could not be claimed, as it was not disclosed in either the specification or drawings:

Held, that the Examiner should admit the claims for examination and, if of opinion that they were not allowable, reject them, so that petitioner could take an appeal to the Examiners-in-Chief.

Stone, *x. p.*, *Fisher, Act. Com.*, 17 Mar., 1890, C. D. Ms.

SUPERFLUOUS CLAIMS.

The objection of redundancy does not go to the form of claims, but to their substance, and the general question presented is whether some of the claims are not the

same in scope as certain others. The question may properly be considered by the Examiners-in-Chief upon appeal, and an Examiner is not justified in refusing to act upon the merits until the number of claims is reduced.

Rodwell, x. p., *Fisher, Act. Com.*, 29 Aug., 1890, Ms.

Compare, however, Sawn, x. p., (3) REDUNDANCY; Bickley, x. p., (62) THE CLAIM.

SUPPLEMENTAL OATH.

1. Purpose and Limitations.

The office of a supplemental oath, as set forth in Rule 48, is to justify the introduction, by amendment, of a claim not substantially embraced either in the original statement of invention or in any claim originally presented. It affords, however, no justification for the introduction of matter by way of amendment which was neither described nor disclosed in the invention as filed.

Steward v. Ellis v. Lee v. Howe, Mitchell, Com., 16 Dec., 1889, 49 O. G., 1883.

Cited and applied by Commissioner Mitchell in *Edison*, x. p., 15 Ap., 1890, C. D. Ms.

2. Where not required.

The fact that the claim under consideration is broader than the claim which was before made is not sufficient to warrant the requirement of a supplemental oath, provided such claim is within the scope of the case as originally presented (*Hood & Starn*, x. p., 39 C. D. Ms., 450; *Ransom*, x. p., 42 C. D. Ms., 402; and *Ry. Reg. M'f'g Co. v. N. Hudson Ry. Co.*, 1885, C. D. 45).

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

3. An ex parte Question.

The question whether a supplemental oath shall or shall not be required is *ex parte* in its nature, and not open to argument on the part of an opposing interference contestant.

Rennyson *v.* Merritt, *Simonds, Com.*, 29 Feb., 1892, 58 O. G., 1415.

SUPREME COURT.**1. A Finding of Fact.**

In an action at law the Supreme Court will not review, on the evidence, a finding of fact of the Circuit Court that plaintiff's invention was not anticipated by earlier patents.

Plow Works *v.* Starling, U. S. S. C. By *Blatchford, J.*, 35 L. ed., 404, *.

2. It is clearly the duty of the Patent Office to be guided by the decisions of the Supreme Court whenever that court has furnished a precedent.

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

See COMMISSIONER, ETC.; OFFICE PRACTICE.

SURPLUSAGE.**May be corrected by certificate.**

Where it was urged, as a ground for re-issue, that the statement of invention [preamble] described certain matter as being of the applicant's invention, when such matter had been stricken out during the progress of the application through the Office, and no claim therefor appeared in the patent: *Held*, that such error [although objectionable and to be avoided] does not render the patent inoperative or invalid, because the scope of the

patent must be determined by the claims taken in connection with the specification, and, in construing the patent, the matter referred to would be treated as mere surplusage. If desired, the error can be sufficiently corrected by a certificate [endorsed upon the letters-patent as prescribed in Rule 170].

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

SYMBOLS.

See DESCRIPTIVE CHARACTERS.

TERM OF A UNITED STATES PATENT.

1. Effect of earliest expiring foreign patent.

The foreclosure of a United States patent, consequent on conditions, as to term, of a previously granted foreign patent to the same inventor for the same invention, is derived from the last clause of Section 4887, Revised Statutes of the United States, which is in the following language:—

Every patent granted for an invention which has been previously patented in a foreign country shall be so limited as to expire at the same time with the foreign patent, or, if there be more than one, at the same time with the one having the shortest term.

Sec. 4887 R. S.

The judicial applications of the clause appear in the following rulings:—

2. Letters-patent No. 197,314, granted to John J. Bate, 20 Nov., 1877, for the term of seventeen years, did not expire with the original term of five years of his Canadian patent, but continued in force to the end of the term of fifteen years of the extended Canadian patent, to wit, to 9 Jan., 1892, said Canadian patent

having never ceased to exist, but having been in force *continuously* from 9 Jan., 1877.

Bate Refrig. Co. v. Hammond et al., U. S. S. C. By *Blatchford, J.*, 21 Jan., 1889, 46 O. G., 689, *.

3. Where the Canadian statute under which the extension of the Canadian patent was granted was in force when the United States patent was issued, and also when that patent was applied for, and where, by the Canadian statute, the extension of the patent for Canada was a matter entirely of right, at the option of the patentee on his payment of a required fee, and where the fifteen years term of the Canadian patent has been continuous and without interruption, the United States patent does not expire before the end of the fifteen years' duration of the Canadian patent.

Ib., *.

4. The provisions of the Act of 1870, and of section 4887, Revised Statutes, mean that the United States patent shall not expire so long as the foreign patent continues to exist, not, however, extending beyond the seventeen years of the United States grant.

Ib., *.

5. While it may be proper that the United States patent should contain a notice of the existence of such earlier expiring foreign patent, omission of such notice does not of itself constitute ground for invalidation of such United States patent.

Ib., *.

For rulings further explanatory of the same doctrine, see (6) *et seq.*, *infra*.

6. There is nothing in the statute (Section 4887, R. S.) which admits of the view that the duration of the United

States patent is to be limited by anything but the duration of the legal term of the foreign patent in force at the time of the issuing of the United States patent, or that the United States patent is to be limited by any lapsing or forfeiture of any portion of the term of such foreign patent by means of the operation of a condition-subsequent growing out of foreign statute.

*Pohl et al. v. The Anchor Brewing Co., U. S. S. C. By Blatchford, J., 24 Mar., 1890, 51 O. G., 156, **

7. Section 4887 of the Revised Statutes is to be read as if it said that the United States patent is to be so limited as to expire at the same time with the expiration of the term of the foreign patent.

*Ib., **

8. The ground of the decision in the case of *Bate Refrigerating Co. v. Hammond et al.*, (46 O. G., 689; 129 U. S., 151), was that the term of the Canadian patent was, by the Canadian statute, at all times, a term of fifteen years' duration made continuous and uninterrupted by the action of the patentee of his own right and at his own option.

*Ib., **

9. Where a foreign statute, under which patents of that country carried with them a right of extension, was in force after the time of the application for or issuance of a United States patent, and where, under such statute, extension, in the absence of certain unfulfilled conditions, was a matter entirely of right at patentee's option on payment of a required fee, the (fifteen years) term of such foreign patent being, by the affirmative action of the foreign grant in renewing it, continuous and uninterrupted: *Held*, that the United States patent does not expire before the end of the

(fifteen years) duration of such foreign patent, although, before the expiration of the first five years, the foreign patent may, in fact, have lapsed or become forfeited by the non-observance of a condition-subsequent, or by the happening of a subsequent condition imposed by a statute of the country granting such foreign patent (The rulings of the Supreme Court in *Bate v. Hammond*,*, and in *Pohl v. Anchor Co.*,*, *supra*, cited and applied).

Edison Elec. Lt. Co. v. Perkins Elec. Lamp Co., U. S. C. C., D. Ct., *Shipman, J.*, 20 May, 1890, 52 O. G., 1370.

10. The above decision of the C. C. D. Ct. was affirmed and made final by a U. S. C. C. of Appeals, *Lacombe and Shipman, JJ.*, 4 Oct., 1892, *.

11. Identity of Foreign Patent.

Whether or not the foreign patent possesses such identity with complainant's domestic patent as to bring the latter under the restrictions of Clause 2, Sec. 4887, R. S., depends on the answer to the following questions:

(i) As to the principal invention in each; is the thing patented abroad the same, in all essential particulars, as the thing patented here?

(ii) Would the home patent be infringed by a structure made in accordance with the provisions of the foreign patent?

In cases where these questions are answered in the affirmative, the United States patent falls with the date of cessation of the foreign patent having the earliest expiring term; it will not be saved by the fact that it contains improvements not found in the foreign patent (*Siemens v. Sellers*, 123 U. S., 276,*; *Com. Co. v. Fairbanks Co.*, 135 U. S., 176,*).

Brush Elec. Co. v. Elec. Accumulator Co. et al., *Coxe, J.*, 28 July, 1891, 56 O. G., 1884.

TERRITORIAL RIGHTS.**1. Right to Sell. — Right to Use.**

The purchaser of a patented article from the owner of the right for a certain territory has no right to sell the article, *in the ordinary course of trade*, in territory of which another owns the exclusive right.

Standard Folding Bed Co. *v.* Keeler, U. S. C. C., Mich., *Brown, J.*, 20 Feb., 1889, 37 F. R., 354.

2. Precedent Rights.

In a case where the patentee had conveyed to *A* all his right, title, and interest within and throughout a specified territory, a subsequent purchaser *B*, of the patented article, who has notice of such prior assignment, takes subject to the rights of *A*, and cannot use the article within *A*'s territory. The distinction, which seems to be broad and plain, between the case at bar and *Adams v. Burke* (84 U. S., 453, *), consists in the facts that the assignment here, under which the plaintiff, *A*, holds, is *first in order of time* and confers upon him the entire monopoly of the patent within his territory, and that the later assignment, under which the defendant, *B*, holds, is subject to this; while in *Adams v. Burke* the defendant's purchase antedating the assignment under which complainant held and sued, defendant's right of use could not be affected thereby.

Sheldon Axle Co. v. Standard Axle Works, U. S. C. C., E. D. Penn., *Butler, J.*, 21 Feb., 1889, 37 F. R., 789.

See ASSIGNEE; MANUFACTURE; SALE; USE.

TESTIMONY.

1. Witness having been withheld from cross-examination, his direct testimony was suppressed.

Where Examiner had adjourned the hearing at the point where a witness had been tendered for cross-

examination, and the party who offered the witness thereafter neglected to produce him for cross-examination, the entire testimony of that witness was suppressed.

Shapleigh v. Chester, &c. Co., U. S. C. C., E. D. Pa., Hanford, J., 47 F. R., 848.

Compare *Creteau v. Hall*, (179) INTERFERENCES.

2. Copies of, must be filed not less than one week before day of hearing, — Rule 162.

It is error for the Examiner of Interferences to permit the testimony to be filed on the day of hearing. Under Rule 162 copies must be filed not less than one week before the day of hearing.

Barrenburg v. Loeber, Mitchell, Com., 8 Feb., 1890, C. D. Ms.
See CROSS-EXAMINATION; INTERFERENCE; PRIORITY.

TITLE OF PATENT.

While an applicant will be allowed, within reasonable limits, to say what the title of his patent shall be, he has not an absolute right in this or any similar matter of detail, and it is the province of this Office to determine whether any title given to an invention is one which satisfies Section 4884 of the Revised Statutes.

Nickola, x. p., Simonds, Com., 27 Nov., 1891, 57 O. G., 1425.

TRANSFER OF CLAIMS FROM A FORFEITED TO A PENDING APPLICATION.

Where a mode of relief is provided for by statute the steps thereby provided should be followed.

Where an apparatus and a process in which it was employed were separately applied for and both applications were allowed but the application claiming the apparatus was withdrawn by the Office and put in an interference which was decided in favor of the applica-

tion so withdrawn, and the application was again allowed, but, pending these proceedings, the six months within which to pay the final fee on the companion application (covering the process) had been suffered to expire because it was, at that time, deemed (in view of the then prevailing decisions regarding such matters) inadvisable to issue the method case at an earlier date than the apparatus case, and the practice of the Office having, meanwhile, been changed, so that method claims and apparatus claims could be allowed in the same application; applicant sought to have the method claims which had been allowed in the (since forfeited) application placed in the pending application for the apparatus: *Held*, (intentionally refraining from deciding what action might be taken if both applications were still pending before the Office) that, section 4897, R. S., having provided a given remedy, the steps provided by the statute should be followed, not necessarily because otherwise the Office would lose a fee, but because the statute, having prescribed a method of relief, seems to impliedly prohibit relief by other methods.

Hopkinson, x. p., *Mitchell, Com.*, 24 Sep., 1890, 54 O. G., 264.

NOTE. — Sec. 4897, R. S., permits a new application to be filed any time within two years after original allowance.

TWO INTERFERING PATENTS TO SAME INVENTOR.

I. Precedence given to the Earlier Patent.

The contention of defendant was not sustained that the patent of 11 Sep., 1860, covered the same invention as did the earlier patent, — granted 1 Dec., 1857, — on a later application. But, even had defendant's allegation been correct, his conclusion would have been erroneous :

it is the *later* patent, not the earlier one, that would be void.

The Suffolk Co. *v.* Hayden, U. S. S. C. By *Nelson, J.*, Dec., 1835, 3 Wallace, 315, *.

NOTE (i). — For conditions under which the date of *application* (not that of grant) would determine the order of precedence, see *Washburn v. Barbed Wire Co.*, (2, 3), *infra*.

NOTE (ii). — As in neither *Suffolk Co. v. Hayden* nor in *Washburn v. Barbed Wire Co.* was defendant's contention of identity between the subject-matter of complainant's patents sustained by the court, its ruling in each case, as to order of precedence, must, it would seem, be taken as a mere *obiter dictum*, and not as a decision based on issues actually involved in the respective cases.

2. Precedence given to Later Patent if on an Earlier Application.

The date of the application [an act of the inventor] and not the date of the patent-grant [an official act] controls in determining the legal effect to be given to two patents issued at different dates to the same inventor and the order in which they are to be considered.

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

Compare *The Suffolk Co. v. Hayden*, (1) *supra*.

3. Where dates of Applications determine Order of Precedence.

Where two applications were filed at different times (27 Oct., 1873, and 14 Mar., 1874), for different improvements in wire-fences by one and the same inventor, and patent on the later application issued first (12 May, 1874) and where patentee, after securing a patent (24 Nov., 1874) on the earlier application, surrendered pat-

ent on later application, and (8 Feb., 1876) obtained a re-issue of said patent with a broad claim dominating the device and claim of the patent on his earlier application, which re-issue was subsequently (4 June, 1883; Washburn & Moen M'f'g Co. v. Tucks, 16 F. R., 661) adjudged invalid on each and every one of several grounds, one of said grounds being that the feature claimed in said re-issue was substantially covered in the patent already granted on said earlier application, and where, in suit brought upon this patent (pat. of 24 Nov., 1874) defendant sought to have said patent set aside on several contentions, one contention being that, inasmuch as the earlier patent, as re-issued, covered the feature sued upon, and as said re-issue had been declared invalid, the later patent necessarily fell with it: *Held*, sustaining the patent because, although of later issue, it was on an earlier application, and in such cases priority depends on date of application not on date of grant.

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, *.

NOTE (i).—The above decision of the Supreme Court proclaims, either directly or inferentially, that:

(1) He who introduces THAT which (however seemingly trifling and obvious) converts what had been a series of failures into a brilliant and operative success, is entitled to a patent.

(2) The claim or claims of a patent (whether in original or re-issued form) must be founded on subject-matter of the original application.

And that, where an applicant has, pending at the same time, two or more applications for improvements in the same art which entitle him to a generic claim and one or more specific claims:

(3) One patent can be in no wise affected by another (although in same art and to same inventor but with different subject-matter) upon a later application even although the patent upon such later application should issue earlier.

(4) A specific patent on same subject-matter must not antedate the generic patent (*Suffolk Co. v. Hayden*, 3 Wallace, 315).

(5) A claim in a later patent to a device described — without reservation — in an earlier patent to the same inventor, is void.

NOTE (ii). — The claims referred to were as follows :

Claim of patent of 24 Nov., 1874, in suit.

(Sustained, and adjudged to be infringed.)

“ A twisted fence-wire having the transverse spur-wire **D** bent at its middle portion about one of the wire-strands **a** of said fence-wire and clamped in position and place by the other wire-strand **z**, twisted upon its fellow ; substantially as specified.”

Claim of re-issue of 8 Feb., 1876.

(Previously sued upon and adjudged invalid.)

“ In combination with a fence-wire ; a barb formed of a short piece of pointed wire secured in place upon the fence-wire by coiling between its ends, forming two projecting points ; substantially as specified.”

NOTE (iii). — So far as appears, the very broad and fundamental claim of 8 Feb., 1876, would have been sustained had it formed part of patent of 24 Nov., 1874, or of a sufficiently prompt re-issue thereof.

Compare (2) ORDER OF ISSUE ; also (1) *et seq.*, and accompanying notes, DEDICATION.

UTILITY.

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 what would probably have been found out before if ordinary skill in that art could have discovered it.

Bruce v. Marder, Wheeler, J., Oct., 1881, 22 O. G., 1039.

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

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

Underwood, x. p., *Fisher, Com.*, 3 June, 1870, C. D. 52.

3. The invention of Hicks involved only slight changes in what existed before, *but those changes brought success*. When the idea of Hicks was once embodied in practice it was easy to adapt it to any form of flange. When a cartridge on the *exterior* rim was used it required only ordinary mechanical skill to take Hicks' invention and apply it to such a flange, making the spring in the hook instead of in the flange. The change embodies Hicks' invention, although it may contain some patentable improvements.

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

Of like tenor, see *Nat. Typo. Co. v. N. Y. Typo. Co.*, (29) *et seq.*, THE CLAIM; and *Shannon* (10, 11), *et seq.*, INVENTION.

4. It is no answer to a patent to say that the combination required no invention, that any mechanic might have selected the parts and combined them. The fact that no mechanic *did* before select and combine the parts and produce such a machine, notwithstanding the great need for it, is a sufficient answer to such a suggestion.

Dederick v. Cassell, *Butler, J.*, 6 Oct., 1881, 20 O. G., 1233.

5. As between patentable invention and mechanical skill, the circumstance that the value of the new article was immediately recognized, and that it supplied a want long felt but not before met, should have due weight in favor of the sufficiency of invention.

Shuter v. Davis, *Wallace, J.*, 25 May, 1883, 24 O. G., 303.

6. A change made in an old device which, though simple, is effective and produces a new and useful result: *Held*, to involve the exercise of invention.

Sewing Machine Co. v. Frame, *Butler, J.*, 19 May, 1884, 28 O. G., 96.

7. In determining the question whether there was an invention in any particular combination, the important part is to ascertain whether novelty or utility existed. It is true that these requisites may result from mere mechanical skill, and a new and useful combination may be formed by the mere mechanical addition of an old element to an old set of members; but when a device has a new mode of operation which accomplishes beneficial results, courts look with favor upon it, and are not exacting as to the degree of inventive skill which was required to produce the result. There must be some, but a little will suffice.

Hoe v. Cottrell, Shipman, J., 23 Mar., 1880, 18 O. G., 59.

8. Although, from the standpoint of after-time, it might seem difficult to see that a particular combination of old elements should have required the exercise of invention, still, the fact that, in the multiplicity of prior machines in the same line of invention, a combination of such value had not been hit upon, and that, when introduced, its utility was universally recognized, renders it evident that, in order to make such a combination, changes were necessary which the skill of the mechanic would not suggest, and that the work was practically more difficult than, to a theorist, it might now seem to be.

Ib.

9. The fact that not only the defendants in this case, but other large manufacturers of cultivators, have at

once adopted the same auxiliary lifting devices shown in complainant's patent, is evidence of the popular acceptance of this as a practical solution of many of the difficulties which had been encountered in attempts to use the older devices, and that it is such a change and improvement as required more than mere mechanical skill and is therefore such as to bring the device fairly within the domain of the patent law.

Brown M'fg Co. v. Deere & Co., Blodgett, J., 4 Aug., 1884, 28 O. G., 1187.

10. The patentee (George M. Pullman) undertook to overcome the difficulties incident to a vestibule-connection between cars, and he accomplished this by means of flexible or adjustable joints to permit of sufficient movement between individual passenger-cars. When a patented improvement possessed such marked utility and came so speedily and universally into public use as did the Pullman Vestibule System: *Held*, that the court should hesitate to declare the patent invalid for want of novelty, because these circumstances tended strongly to prove invention.

Pullman Palace Car Co. v. Boston & Albany R. R. Co., Colt, J., 9 Oct., 1890, 58 O. G., 1255.

11. Useful Novelty evidenced by extensive public Adoption.

The fact that the invention went at once into such extensive public use as almost to supersede all packings made under other methods, was pregnant evidence of its novelty, value, and usefulness.

*McGowan v. N. Y. Belting Co., U. S. S. C. By Blatchford, J., 26 Oct., 1891, *.*

12. 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'fg Co. *et al.* v. The Beat Em All Barbed Wire Co. *et al.*, U. S. S. C. By *Brown, J.*, 27 Feb., 1892, 58 O. G., 1555, *.

13. Patentability accorded to a change (even though slight) which accomplishes a useful result that had long been unsuccessfully striven for.

Where there had been several unsuccessful attempts to produce an article satisfactory to the trade, and plaintiff, who had been experimenting with the subject for years, finally produced a device which, when patented, was at once largely adopted and went into and remains in general use: *Held*, there was sufficient evidence of novelty and utility to support a patent. The Supreme Court cited its previous decision given in *McGowan v. Packing Co.*, (58 O. G., 845, *).

Gandy et al. v. Main Belting Co. et al., U. S. S. C. By *Brown, J.*, 7 Mar., 1892, 59 O. G., 1106, *.

NOTE. — Plaintiff's claim in suit was:

The improved article of manufacture consisting of a hard, even-surfaced, rigid, impervious, non-elastic belt, composed of cotton-canvas or duck, having its warp-thread larger than the weft, both warp and weft being hard spun, the fabric tight woven, and folded, stitched, and saturated with linseed oil.

Among numerous decisions of like tenor, see *The Washburn & Moen M'fg Co. v. The Beat Em All Barbed Fence Wire Co.*, *, (12) *supra*, and cases cited in that suit.

14. Public Adoption.

Where the question of patentable novelty in a device sued upon is not free from doubt, a general and exten-

sive use by the public will incline the court to resolve the doubt in favor of the patent.

Topliff v. Topliff et al. Topliff et al. v. Topliff, U. S. S. C. By *Brown, J.*, 25 Ap., 1892, 59 O. G., 1257, *.

15. Doubt resolved in Applicant's favor.

Where the references showed the practice of methods which apparently differed from that of the applicant in mere mechanical details only, and applicant's success seemed attributable *wholly* to putting old ideas into practice more intelligently than had been done before, and the Examiners-in-Chief said that "the particulars or conditions on which the applicant places his claim for novelty and invention are merely the acts of the intelligent ore-worker exercising the expected skill of his calling in working the old process: *Held*, that it could not be denied that there seemed fair ground for saying just this thing, but the proposition was negatived by the fact that men of the highest intelligence and skill and familiar with the whole art, both here and abroad, had in vain sought the success that was attained by the applicant, and hence, upon equitable consideration of the whole case, the doubt was resolved in favor of the inventor and the decision of the Examiners-in-Chief was reversed.

Blair, *a. p.*, *Simonds, Com.*, 17 Nov., 1891, C. D. Ms.

UTILIZATION.

1. The grant of a U. S. patent imposes no obligations to work the invention.

The right of patentee to proceed against an infringer is not dependent on his own manufacture or use of the thing patented or that the invention has been a source of profit to him. An accounting and assessment of dam-

ages will be ordered in proof that the defendants have made profits (*Walker on Pats.*, sec. 579 ; *Colgate v. Tel. Co.*, 17 *Blatch.*, 308).

Wirt v. Hicks, Shipman, J., 16 *Ap.*, 1891, 56 *O. G.*, 66.

2. While the patentee's monopoly is not dependent on his working the invention, his neglect to work it may bear on question of value.

The patentee may let his invention lie in the Patent Office without use, and no one else would have the right to use such invention, because it is the patentee's property ; but while this is true, as a matter of law, still, in ascertaining whether the machine is capable of use, it may be important to know that the inventor had never made or used the machine, because the presumption is, that a person obtains a patent for something practical, and not for a mere experiment. It need not be a very useful or profitable machine, but it must be capable of some use not mischievous, injurious, or immoral.

Pitts v. Wemple, Drummond, J., Dec., 1855, 1 *Biss.*, 87.

VACATION OF A PATENT.

A bill in equity lies to set aside letters-patent improperly granted, but only between the sovereignty making the grant and the grantee. To vacate a patent granted by the United States, suit must be brought in its name through its proper law officer.

The United States v. Gunning, Wallace, J., Nov., 1883, 26 *O. G.*, 356.

See **REPEAL OF PATENTS.**

VALIDITY.

Prima Facie Presumption.

The fact that the patent has been unquestioned for more than five years, during which time the machines

have been put on the market and largely advertised and over a million dollars have been invested in their manufacture, — even if there has been no prior adjudication in its favor, — sufficiently fortifies the *prima facie* presumption of the validity of the patent.

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

VEIL OF SECRECY.

See (1) ABANDONED APPLICATION; (1) CAVEAT; (109) and (194) INTERFERENCES.

WAIVER.

1. By withdrawing a rejected claim, applicant waives the right to subsequently assert it.

Where an applicant before the Patent Office originally presents broad claims, and, being rejected upon them by reference to patents already granted, amends his specification and claims, and is granted a patent upon the amended claims, he waives the broad claims of his first application and cannot afterward, in an action for infringement, broaden the scope of his invention by claiming that it was made before the anticipating patents issued.

Shaw Stocking Co. v. Pearson, *Colt, J.*, 10 Nov., 1891, 58 O. G., 949.

Among numerous applications of this doctrine, see *Roemer v. Peddie*, *, (73) THE CLAIM; *Dodds v. Stoddard*, (5) ESTOPPEL; *Hoeveler et al. v. Verner et al.*, (62*), and *Del Grande v. Mannie*, (62) INTERFERENCE; and *Sargent v. Hall Safe & Lock Co.*, *, (10) PUBLIC RIGHTS, ETC.

2. Prosecution constitutes a waiver.

After reversal by Examiners-in-Chief of the Primary Examiner's rejection, the latter, — without first obtaining

the Commissioner's permission, as required by Rule 142,—again rejected the application on new references. Thereupon, applicants requested a reconsideration and final action, and submitted a brief complaining of the delay of having their application rejected in piecemeal. The Examiner then repeated his action and made the rejection final. Thereupon applicants petitioned for redress, on the ground of irregularity of Examiner's action in re-opening the case without authority: *Held*, that applicants, by their request for reconsideration, waived whatever right they had under Rule 142, and petition was denied.

Sutton, x. p., *Mitchell, Com.*, 15 June, 1891, C. D. Ms.

For Constructive Waiver, see *Creteau v. Hall*, CROSS-EXAMINATION.

WAIVER OF OBJECTION TO TESTIMONY.

See *Hotchkiss v. Smith &c. Post*, (70), *Creteau v. Hall*, (179) INTERFERENCES.

WIFE AS A WITNESS.

1. In questions arising in the United States Patent Office, husband and wife are incompetent as witnesses for or against each other, and this rule is co-extensive with the territorial jurisdiction of the United States, and is unaffected by any of the local statutes of the respective states.

Cornish v. Rein v. Rappel, Hall, Com., 9 June, 1888, 43 O. G., 1453.

See also *Workman v. McNaught, Paine, Com.*, 25 Apr., 1879, 16 O. G., 216.

2. A wife is not a competent witness in proceedings before the Patent Office where her husband is a real party in interest and her testimony is offered on his behalf.

Dobeck v. Novotny, Simonds, Com., 30 Jan., 1892, 58 O. G., 804.

WITHDRAWAL FROM ISSUE.**1. To add a claim;—granted.**

While it is a general rule that applications which have been allowed will not be recalled for the purpose of amendment, an exception to the rule must be recognized in cases where great hardship or irreparable injury would otherwise result. Especially is this true since, under modern decisions of the courts, the right of re-issue has become so restricted that any failure to obtain in the first application full protection of an invention is, in a vast majority of cases, without remedy. Hence, where the claim sought to be incorporated is so specially pertinent to the subject-matter of the application and so inseparable in its nature from the particular invention sought to be patented that, if allowed in another application, there would be grave doubt whether the patent therefor would be valid, amendment after allowance should be permitted.

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

2. To add a claim;—denied.

Where the petition for withdrawal of an application from issue for the purpose of adding another claim was filed after the expiration of six months from allowance, and applicant alleged that the claim had been omitted by oversight of attorney, and that applicant had not noticed the omission until about a month previous, when he, *for the first time*, read a copy of his application: *Held*, that the showing did not bring the case within the exception to the general rule laid down in Myers, x. p., 49 O. G., 131, and the petition was denied.

Craigie x. p., *Fisher, Act. Com.*, 20 Dec., 1890, 45 C. D. Ms., 80.

3. For Amendment.

For the character of the showing required to warrant withdrawal of case from issue for the insertion of a proposed amendment, reference is made to Meyers, x. p., 49 O. G., 131; and Craigie, x. p., 45 C. D. Ms. 80.

Morgan, x. p., *Fisher, Act. Com.*, 8 Jan., 1891, C. D. Ms.

4. When inadmissible.

Where petitioner, — who was negotiating for the sale of his inventions abroad, — requested that his U. S. applications be withdrawn from issue for a period of thirty days, in order to preserve to the purchasers the rights in all foreign countries: *Held*, denying the petition, that the Commissioner has no authority, directly or indirectly, to extend the time for paying the final fee to a period later than six months, and that that would be the effect if the petition were granted. Rule 165 only provides for a new notice of allowance when applications are withdrawn from issue for further action on the part of the Office.

Simonson, x. p., *Mitchell, Com.*, 30 Sep., 1890, 53 O. G., 1571.

5. For Change of Date, — denied.

A petition requesting that the application be withdrawn from issue or suspended under Rule 166, for the purpose of having patent issue at the same time with another pending application: *Denied*, because it would have the effect of extending the time for paying the final fee to a period later than six months from the allowance which resulted from proceedings according to law, and that the case was not distinguishable in principle from that of Simonson, x. p., 53 O. G., 1571.

Brand, x. p., *Frothingham, Act. Com.*, 18 July, 1891, C. D. Ms.

6. To correct a Clerical Error.

Amendments after being placed on the issue docket, not affecting the merits of the application but intended to correct merely formal matters, may be admitted under Rule 78. When, however, such claims affect the merits, they cannot be made without withdrawing the case from issue. Such withdrawal will only be permitted on a proper showing (Myers, x. p., 49 O. G., 131; Meyer, x. p., 54 O. G., 265).

Cornelius, x. p., *Frothingham, Act. Com.*, 6 Ap., 1891, 56 O. G., 929.

WITHHOLDING ISSUE OF PATENT.

The Commissioner has the power to withhold a patent even after a favorable decision by one of the lower tribunals. Such a supervisory interference will not be exercised however, unless a clear case of necessity therefor is apparent.

Strong, x. p., *Simonds, Com.*, 7 Oct., 1891, 57 O. G., 274.

See COMMISSIONER.

WITNESSES.

It is to be remembered that the Commissioner of Patents has no power in the matter of taking testimony of witnesses, and 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 courts of the district in which the testimony is being taken, and either party has full authority to apply to the district judge for orders compelling the attendance and controlling the conduct of witnesses.

Wright v. Daggett, Hall, Com., 9 Aug., 1888, 44 O. G., 943, 1888, C. D. 116.

See 195 and 196 INTERFERENCES.

See, also, *Osgood v. Badger et al.*, 44 O. G., 1066, and *Blunger v. Smith*, 57 O. G., 273.

“WORD OF LIMITATION.”

In a deed [or a grant] to a person not then living, “*his heirs and assigns* ;” the word “heirs” [or “assigns”] is “a word of limitation” not of “purchase.” There being no grantee, there was no grant, and there are no heirs or assigns (5 McLean, 202).

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

Compare DECEASED APPLICANT.

CHAPTER III.

DECISIONS RELATING TO PATENTS FOR DESIGNS.

DESIGNS.

1. A design patent is allowed to any originator of a new shape or configuration of any article of manufacture, or of a new ornamental or useful design, pattern or picture, to be worked into, or printed, or painted, or cast, or otherwise attached to any article of manufacture. Government fee (\$10, \$15, or \$30), dependent on the length of term (3½, 7, or 14 years) applicant elects to demand.

R. S. 4929, 4934.

2. A patentable design relates only to an artistically devised figure for attachment to or impressment upon some article of manufacture.

Upon an application to patent a design for the exterior of a country house: *Held*, rejecting the application, that the word "manufacture" as used in sec. 4929, R. S., relating to patents for designs is to be construed to have the same meaning as the same word in prior statutes relating to mechanical patents, and must be limited to something for attachment to or impressment on a manufactured article, and any "construction" that would make it include a dwelling house or any other article of "realty" would involve a departure from the received significance of the word as employed in statutes relating to patents for mechanical devices, and must therefore be pronounced wholly inadmissible.

Lewis, x. p., *Mitchell, Com.*, 14 Mar., 1891, 54 O. G., 1890.

Compare Roy & Nourse, (11) TRADE-MARK.

3. The kinds of subjects which may respectively be protected by a copyright, or by a design patent, have been distinguished and defined as follows:—

An engraved or printed design, issued as an object of art, having a value in itself, and intended for sale as such, properly comes within the provisions of the copyright law; but when — however artistically executed — it is not produced for sale as a work of art, but is designed to be *affixed in the manner of a label to a manufactured article*, it then plainly falls under the act relating to patents for designs, and, consequently, cannot be protected by copyright.

Bishop, Com. of Pats., Aug., 1859.

See, also, Norton, x. p., (7) *infra*.

4. A design patent has reference only to configuration or figure.

A design is merely a delineation of form or figure, either plain or solid, a shape or configuration. The character of the material, the color, or the mechanical structure in which a design finds expression, forms no part of it, and is of no possible importance in describing the design itself.

Traitel, x. p., *Butterworth, Com.*, 12 Nov., 1883, 25 O. G., 783.

5. A configuration presents a suitable subject for a design patent if it *appeals to the eye*.

The validity of a patent for a design does not depend upon the exercise of the “inventive faculty of the mind” in the sense in which that expression is used in connection with inventions which relate strictly to the useful arts. The policy which protects a design is akin to that which protects the work of an artist by copyright. The design may be simple and not show a wide departure

from other designs, yet, if it produce a different impression upon the eye, it will be protected.

Untermeyer *v.* Freund, *Coxe, J.*, 15 Jan., 1889, 47 O. G., 527.

6. The fact that an article is useful does not make it less patentable as a design if it is *new as a design*.

Kraus *v.* Fitzpatrick, *Wheeler, J.*, 24 Feb., 1888, 42 O. G., 1292.

7. The expression "useful" in patents for designs has a different meaning to the same word as applied to an invention. A design is useful when, by it rendering the article of merchandise attractive, it *serves to distinguish it from other like articles in the market*.

The term "useful" (in the law authorizing grant of patents for designs) is used in contradistinction to mischievous. A design, if not mischievous, is useful if it is attractive; and utility may consist in such a shape [ornamentation] or configuration of a given article that persons needing it will purchase it because of such shape [ornamentation] or configuration in preference to other articles for the same purpose, but different in shape [ornamentation] or configuration. [Where the design relates wholly to configuration] it is not necessary that it should be ornamental (although it may be) to entitle the applicant to a patent therefor.

Norton, *x. p.*, *Marble, Com.*, 16 June, 1882, 22 O. G., 1205.

8. A design patent has no reference to mechanical functions.

Matter descriptive of the mechanical functions of a device must be omitted from a design application.

Ib.

9. Form.

An objection to descriptive phrases in the specification of a design application, as being matter which tends to indicate mechanical functions rather than design, goes to the *form* of the specification rather than to its "merits," and is properly brought to the Commissioner on petition.

Herrick, x. p., *Fisher, Act. Com.*, 23 May, 1890, Ms.

10. The design in its entirety and its segregable parts may be separately claimed.

The claims in a patent for design must be restricted to the entire design and distinctive, segregable, integral parts thereof.

Pope, x. p., *Marble, Com.*, 30 June, 1883, 25 O. G., 290.

11. Must be unitary.

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

Hess & Hess, x. p., *Frothingham, Act. Com.*, 21 Aug., 1891, 56 O. G., 1334.

12. Only one design can be the subject of a single design patent, and where applicant's specification attempts to cover more than this it is properly held defective.

Petzold, x. p., *Simonds, Com.*, 18 Nov., 1891, 57 O. G., 1277.

13. The language of the sections 4837 and 4929 of the Revised Statutes is general and implies that the permission of two years' public use before application for patent includes patents for designs.

Fenton on Design Patents, 68.

14. Previous public Use.

Original designs, like inventions and discoveries, are patentable, unless they have been in public use or on sale for more than two years prior to application for patent or have been abandoned (*Root v. Ball*, 4 McLean, 177; *Booth v. Garely*, 1 Blatchford, 247).

Anderson v. Eiler, *Reed, J.*, 22 June, 1891, 57 O. G., 410.

15. The word "manufacture," as used in sec. 4929, R. S.: *Held*, not to include such a generic term as "table-ware." A class of goods cannot receive protection under the design act.

Proeger, x. p., *Frothingham, Act. Com.*, 15 Oct., 1891, 57 O. G., 546.

Compare *Wilkinson*, x. p., (17) *infra*.

16. What may be included in.

In application for a design patent, a claim merely for a portion of the design capable of being attached to or connected with different forms to make up an entire whole, is inadmissible. The claims must be restricted to the entire design and distinctive, *segregable*, integral parts thereof.

Pope, x. p., *Marble, Com.*, 30 June, 1883, 25 O. G., 290.

17. The different articles constituting a "set" may be included under a single design patent, but extraneous and merely adjunctive parts should be omitted from drawing or be represented by dotted outline only.

In an application for a design patent, the design consisted in "the peculiar and novel shape and ornamentation of the bowl;" and the drawings, consisting of six figures, showed "the application of the bowl to the several articles usually included in a tea-set," and the Examiner required applicant to point out which one of

the figures showed his design and to eliminate the others and revise the specification accordingly: *Held*, that the evident object in illustrating the design as applied to the different articles of a tea-set was, as in Hess & Hess, x. p., (56 O. G., 1334), to deter infringers. The action of Examiner sustained, with the suggestion that, as the leading feature of the design was the bowl portion of the vessel, a figure of drawing showing the design having a conventional top and bottom portion of the vessel dotted in, would be a sufficient compliance with the requirement of the Office.

Wilkinson, x. p., *Frothingham, Act. Com.*, 17 June, 1892, C. D. Ms.

NOTE. — In answer to applicant's contention that the Office permitted the illustration of many forms of letters and numerals in patents for designs for fonts of type, the Acting Commissioner said that such a design is not sought for one particular type, but for a *font* of type, the completed article being a *font of type*, and it might be held that the design for a single letter is a design for an impression, and that, therefore, the rule would not apply to an article of manufacture.

18. Words and Numerals.

Upon petition from the action of the Examiner requiring certain words and figures to be erased from the drawing and specification in an application for a design for a spoon: *Held*, that if the words and figures objected to were not a part of the design, the action of the Examiner should be affirmed, without prejudice, however, of applicant's right to make them a part of his design; but if they were a part of the design, or applicant should thereafter make them a part thereof, the objection should take the form of a rejection.

Van Slyke, x. p., *Frothingham, Act. Com.*, 6 June, 1892, 60 O. G., 893.

NOTE. — The Acting Commissioner said, incidentally, that he was inclined to the view that it would not be advisable to lay down, as a general proposition of law, that words and figures may never form a part of the subject-matter of a design-patent.

19. Where it appeared from the specification that certain words and figures shown on the face of the design in the drawing did not constitute an essential feature of the design: *Held*, that the patent should not be permitted to seem to make them so, and that they should be erased.

Requa, x. p., *Simonds, Com.*, 12 May, 92, 60 O. G., 295.

20. A mere miniature of a well-known object or article is not patentable.

A design for jewelry-pins consisting of a piece of metal in the shape of a spoon or fork two inches long, precisely similar in appearance to common spoons or forks six inches long, lacks the novelty necessary to support a patent.

Foster v. Crosin, Gray, J., 18 Oct., 1890, U. S. C. C., R. I., 44 F. R., 62.

21. Must display artistic invention.

A design is not patentable where the difference between it and a prior existing design is a mere matter of preference calling for no exercise of inventive thought, which, although manifested in a different way, is as necessary in the case of a design patent as of a mechanical patent.

Crouch, x. p., *Mitchell, Com.*, 7 Mar., 1891, C. D. Ms.

NOTE. — In this case, the drawing was merely a representation in miniature of a well-known object.

22. Damages for infringement, — How assessed.

The Act of Congress (4 Feb., 1887) fixing a liability of \$250 against every infringer of a design patent is within the authority conferred by the eighth clause of section 8 of Article 1 of the Constitution, and is, therefore, valid. The act requires that an infringer shall be further liable for all profits in excess of \$250 made from the sale of the article or articles to which the design is applied: *Held*, that the court cannot limit the damages to the profits due merely to the design, but must take into account all the profits realized on the sale of the article made thereunder.

Untermeyer v. Freund, Coxe, J., 18 Ap., 1892, 59 O. G., 1923.

23. Refundment of fee refused.

Where the Examiner advised applicant for a design patent that his design as claimed was not patentable, and suggested that the application might be amended, but, instead of amending it, applicant requested permission to withdraw it and receive back his fee: *Held*, that the request could not be granted.

Baer, x. p., Mitchell, Com., 5 Feb., 1890, C. D. Ms.

CHAPTER IV.

DECISIONS RELATING TO TRADE-MARKS AND LABELS.

TRADE-MARKS.

1. The Act of 3 Mar., 1881, "To authorize the Registration of Trade-Marks and to protect the same," is understood to be founded on what is known as "the Commerce Clause;" viz., that clause of the Constitution of the United States, which says:

The Congress shall have power to regulate commerce with foreign nations, and among the several states, and with the Indian tribes.

Art. 1, Sec. 8, Cl. 3, CONST.

See Palmer, x. p., (2) LABELS.

2. A trade-mark registration is not a grant; neither is it a contract. It is *a mere record* permitted to an owner of a trade-mark that has been used in commerce with foreign nations or Indian tribes, who is domiciled in the United States or located in some foreign country which affords similar privileges to our citizens, of which record a certificate is given by the Commissioner of Patents. It is true that the registration is *prima facie* evidence of ownership, but in this it is only like other records.

C. A. Yale Cigar M'f'g Co. v. C. A. Yale, *Dyrenforth, Act. Com.*, 19 July, 1884, 30 O. G., 1183.

3. A trade-mark is a common-law right.

The decision of the Supreme Court in trade-mark cases (100 U. S., 82) in reference to registration does not affect the jurisdiction of Federal Courts in matters

relating to trade-marks where the jurisdiction is otherwise secured by reason of diverse citizenship of the parties, since *property in trade-marks comes from the common law, and not from the statute.*

Battle et al. v. Findlay et al., U. S. C. C., E. D. La., *Billings, J.*, 8 Ap., 1892, 60 O. G., 2072.

Compare *Harris Drug Co. v. Stucky*, (4), and *Gravelly v. Gravelly*, (9) TRADE-MARKS.

4. Trade-mark rights not dependent on statutory regulations.

The right to trade-marks and the remedies for their protection exist independently of statutory regulations; and, therefore, the fact that section 3, Act of 3 Mar., 1881, fails to enumerate descriptive words in the list of limitations on the right to registry of trade-marks, does not by implication validate a trade-mark consisting of such words.

Harris Drug Co. v. Stucky, U. S. C. C., W. D. Pa., *Reed, J.*, 46 F. R., 624.

5. The rule reaffirmed that if a manufacturer has applied a new and distinctive label to designate his goods, and has so used it, that his goods are identified by it; a court of equity will restrain another party from adopting and using one so similar that its use is likely to lead to confusion by purchasers exercising the ordinary degree of caution which purchasers are in the habit of exercising with respect to such goods. Complainant was the first to use for beer a label in which the name of the kind of beer appeared in white letters on a diagonal red band. Respondent used a diagonal red label: *Held*, to be a strong case of similarity likely to deceive, and injunction granted (*McLean v. Fleming*, 96 U. S., 245, *).

Anhauser-Busch Brewing Ass'n v. Clarke, *Morris, J.*, Jan., 1886, 34 O. G., 562.

6. A trade-mark becomes the exclusive property only of the person or firm that has first appropriated it and used it to indicate the origin, ownership, and quality of the article to which it is attached. The value of the trade-mark rests wholly on the reputation of the article and upon the implied guarantee of the former that the latter is of a certain recognized quality. The object is to prevent one person selling his goods as those of another of established reputation, to the injury of that other.

Avery & Sons *v.* Meikle & Co., 27 O. G., 1027.

7 Only the Fac-simile of the Trade-mark admissible for Registration.

The Act of March 3, 1881, under which the Office acts in registering trade-marks provides that the applicant shall cause to be "recorded in the Patent Office," along with other things, a description of the trade-mark itself, with *fac-similes* thereof, and a statement of the mode in which the same is applied and fixed to goods. So far as the trade-mark is to be represented or shown it is to be by "*fac-simile*," the mode of application being indicated by "a statement." Rule 9 of trade-mark rules provides that where the trade-mark can be represented by a *fac-simile* that conforms to the rules for drawings for mechanical patents, such a drawing may be furnished by the applicant. A *fac-simile* is an exact counterpart of an original; and a *fac-simile* represented by a drawing is an exact counterpart of an original so far as the nature of a drawing admits. A close adherence to the language of the statute would seem to require that, in each case, the trade-mark and nothing but the trade-mark should be represented by the drawing. The cases are very rare in which such registration requires or should permit the representation of any other matter.

Hudson, x. p., *Mitchell, Com.*, 15 May, 1891, 55 O. G., 1401.

FEATURE CLAIMED TO BE ESSENTIAL MUST BE THE
CONSPICUOUS FEATURE.

8. The feature claimed to be "The Essential Feature" must be so conspicuous as to strike the eye of a purchaser.

Where a trade-mark presented for registration consisted of a complex design showing a horse-shoe bearing the word "STANDARD" with a trefoil or clover-leaf within the shoe and three conventional acorns surmounting it, and the applicant described these several elements but stated that the essential feature of the trade-mark was "the figure of an acorn": *Held*, sustaining the Examiner's objection to the statement as to "the essential feature:" that *the essential feature of a trade-mark is not that which the registrant elects to designate as such, but that which would strike the public mind as its most salient feature and as lending character to the entire mark.* It cannot be said of a trade-mark consisting of three acorns that its essential feature is "an acorn," much less can it be said that one acorn constitutes the essential feature where a horse-shoe is part of the mark which certainly would strike the eye of the observer as quite as essential as the acorns.

Metropolitan Watch Co., x. p., *Mitchell, Com.*, 4 Oct., 1890.

9. A mark does not become a trade-mark until attached to a vendible article and the article put on the market.

Where, in a trade-mark interference between a registrant and an applicant, the evidence showed that the applicant had stamped, wrapped, and boxed a certain amount of "clover" soap, but did not show that he had put on the market or had sold any soap so marked, and the Examiner of Interferences awarded priority to the registrant: *Held*, that the law as to trade-marks seems

to be that a mark does not become a trade-mark until it is put upon a vendible article which, in turn, is put upon the market. This point is fully discussed in *Schneider et al. v. Williams* (44 O. G.), 1400, in which it is held that one of the three steps necessary to secure a title in a mark as a trade-mark is that the article be put on the market. *McAndrew v. Bassett*, De Gex, J. & S., 386, and *Maxwell v. Hogg*, L. R., 2 Ch. App. Cas., 314, set forth the same doctrine; and, such being the case, the decision below should be affirmed.

Procter & Gamble v. Columbia M'fg Co., *Mitchell, Com.*, 10 Oct., 1890, Ms.

“THE COMMERCE CLAUSE.”

10. Registration confers *prima facie* ownership.

Whoever is the first to adopt and use the mark in the United States, in either domestic or foreign trade, is, under the common-law, the owner of such mark on his class of goods.

The fact of the use of the mark in commerce with foreign nations or with Indian tribes gives the lawful owner a right to certificate of registration, which registration confers upon the registrant certain benefits, the principal one of which is *prima facie* ownership.

In a contest between two interfering applicants, or between an applicant and a registrant, the right belongs to the one who, as a party to a suit in a court of equity, would be adjudged the owner of the trade-mark.

The common-law owner of a trade-mark is entitled to registration whenever he shall show use “in commerce with foreign nations or with one or more Indian tribes,” and he cannot be deprived of his right to registration by reason of the [subsequent] use of the mark in foreign trade by another, even though the mark has been registered by that other.

Maintowoc M'fg Co. v. Dickson, *Frothingham, Act. Com.*, 18 Nov., 1891, 57 O. G., 1721.

NON-REGISTRABLE MARKS.

11. The language of the statutes and of the courts renders it clear that the things to which trade-marks may be affixed, so as to be protected and registered, are what are ordinarily termed in law "goods," "wares," and "merchandise," — that is, articles of ordinary commerce, such as may be transported from one country to another in contradistinction to those fixed species of property which the law includes under the term "real estate;" hence, where applicants sought to register a mark used by them in their real estate business by painting or stencilling it on their sign-boards, and by printing it on their business-cards, stationery, circulars, etc.: *Held*, that it was not a proper subject for registration.

Roy & Nourse, *Fisher*, x. p., *Act. Com.*, 14 Feb., 1891, C. D. Ms.
Compare Lewis, x. p., (2) DESIGNS.

12. Laws of the United States guaranteeing exclusive right in trade-marks have reference only to such marks when used in foreign commerce.

Where, in an action for the infringement of a trade-mark duly registered under the Act of 3 Mar., 1881, the bill did not assert that the defendants had used the trade-mark in foreign commerce, and the proof did not show a single instance of such use on their part: *Held*, that under these circumstances, since the parties to the suit are citizens of the same state, and since *the only right guaranteed to complainants by the laws of the United States is the right to use exclusively their registered trade-marks in foreign commerce*, the court was without jurisdiction, and that the bill must be dismissed.

Gravely v. Gravely, U. S. C. C., W. D. Va., *Bond, J.*, 42 F. R. 265.

Compare *Battle et al. v. Friday et al.*, (1) TRADE-MARK.

13. The "tribe" or "nation" must be specified.

The original oath to the declaration contained, *inter alia*, the statement that "said trade-mark is used . . . in commerce between the United States and foreign nations or Indian tribes (particularly with the tribes located in the Indian Territory);" and upon the Examiner requiring a substitute oath setting forth "commerce with some particular foreign nation or Indian tribe," applicant filed a supplemental oath in which he gave the name of a certain Indian tribe, and stated that the oath was in addition to his prior declaration, which he thereby made a part of the supplemental oath the same as if fully repeated in it: *Held*, that under Rule 12, which provides that the declaration cannot be amended, it was proper for the Examiner to require an entire new oath (Strasburger & Co., 1881, C. D. 23, and cases therein cited).

Schotten & Co., *Frothingham, Act. Com.*, 13 June, 1892, 60 O. G., 576.

REGISTRABLE MARKS.

14. Applicant was registrant of the word "LACE" as a trade-mark on a certain class of goods, and sought to register broadly any representation of lace without restricting himself to the specific representation of lace shown in his application. Examiner refused registration: *Held*, that it was, perhaps, doubtful whether applicant was entitled to register a trade-mark so broad as that for which he sought registration, in view of the recent decision of the Supreme Court (*N. Y. Belting & Packing Co. v. N. J. Car-Spring & Rubber Co.*, 54 O. G., 135, *); but, in view of the fact that if registration were allowed, applicant would, in a court of competent jurisdiction, only be entitled to protection to the extent of what may be adjudged his lawful trade-mark, he should be given the benefit of the doubt, and registra-

tion was accordingly ordered. (The Commissioner also considered Peper, x. p., 1879, C. D. 221; Morrison *v.* Cass, *Shipman, J.*, 2 O. G., 544; Am. Lub. Oil Co., x. p., 9 O. G., 687; and Weaver, x. p., 10 O. G., 1.)

Woodbury, x. p., *Mitchell, Com.*, 15 Feb., 1891, C. D. Ms.

15. "Pigs in Clover."

Preliminary injunction granted restraining defendant, his agents, servants, and workmen, from marking, stamping, or designating in any manner, games, toys, or any article of manufacture, with the words "PIGS IN CLOVER," or any material part thereof, or any word or designation that could be mistaken therefor, and from making games, toys, or puzzles, of the size, shape, or appearance of the exhibit, which may, in any manner, be mistaken therefor.

Lyman *v.* Barnes, U. S. C. C., N. D. Ill., *Blodgett, J.*, 15 Ap., 1889, 47 O. G., 660.

16. Arbitrary Words.

Where, in an application to register the word "SILK" as a trade-mark for soap and soap-powders, the record showed that the word was an arbitrary selection and not intended to be applied to a soap especially designed for washing silk goods: *Held*, that the term was purely fanciful, as used, and that the authorities are clear that where such is the case the trade-mark may be registered.

Ross, x. p., *Fisher, Act. Com.*, 10 July, 1890, C. D. Ms.

17. "Cramp Cure," — Figure of a Boy.

An application for registration of a trade-mark stated that it consisted "essentially of the illustration of a boy in a position indicating suffering from cramps." Immediately below the figure of the boy were the words "Cramp Cure": *Held*, that the trade-mark consisted in

the design of the suffering boy, which the application stated to be the essential feature, and that the words "Cramp Cure" formed no part thereof. Also held that the words "Cramp Cure," being descriptive of the purpose and character of the medicine, could not be appropriated as a trade-mark by the manufacturers of a remedy for the disease.

Harris Drug Co. v. Stucky, U. S. C. C., W. D. Pa., *Reed, J.*, 46 F. R., 624.

18. Geographical Name.

It appearing that the party, seeking to register the word "BERLIN" as a trade-mark for the kind of cotton goods known as *silesia*, had for some time used the mark; that he had no connection with the city bearing the name sought to be registered; that it was not shown that such a place was well-known as producing the article to which the mark was to be applied, and that, therefore, no one would be deceived or wronged: *Held*, that the mark was entitled to registration (following *Dover Stamping Co.*, x. p., 51 O. G., 1784; and *Jenkins*, x. p., 53 O. G., 759; where it was held that geographical names used in a purely arbitrary or fanciful sense may be lawful trade-marks).

Hyde & Son, x. p., *Fisher, Act. Com.*, 19 Jan., 1891, C. D. Ms.

19. The burden of showing that the place bearing the geographical name is noted for the production or sale of the class of articles to which the name is to be applied, is upon the Office, not upon the applicant; and, in case of doubt, the benefit of the doubt should be given to the applicant.

Ib.

20. Benefit of the Doubt.

Where the Examiner refused registration of the words "GINGER CHAMPAGNE," as a trade-mark for effervescent

or carbonated mineral water and ginger, upon the ground that they were merely descriptive of applicant's merchandise: *Held*, following *Stoughton v. Woodward* (39 F. R., 902), that applicant should have the benefit of the doubt, and registration was granted.

Manitou Mineral Water Co., *Mitchell, Com.*, 19 Sep., 1890, C. D. Ms.

21. Use of a surname.

In order to justify the exclusive use by a person or corporation of another man's name or a portrait, as against the man who bears the name or is represented by the portrait; some contract, relation, or estoppel must be found to exist operating to deprive the latter of what would otherwise be his right.

Richmond v. Richmond Nervine Co., *Mitchell, Com.*, 21 June, 1890, Ms.

22. It is well settled that no person can acquire, by adoption, such an interest in the name of another as to prevent that other from using his own name in a fair and honest manner in the ordinary course of business; and that, to justify such use, as against the man who bears the name, some contract relation or estoppel must be found to exist, operating to deprive the latter of what would otherwise be his right (see *Rogers v. Rogers*, Am. Trade-Mark Cases, 999; *Skinner v. Oaks*, *Ib.*, 459; *Richmond v. Richmond Nervine Co.*, 52 O. G., 307).

Finlay & Brunswig, x. p., *Frothingham, Act. Com.*, 25 Feb., 1892, C. D. Ms.

NOTE. — The Assistant Commissioner, said: "The present case is to be carefully distinguished from that class of cases wherein the name of a distinguished person is used, in a fanciful and arbitrary sense, to designate ownership or origin of the article to which it is applied, *e. g.*, 'Henry Clay' for cigars."

23. Descriptive name, when combined with a picture, admissible.

The words "WARREN HOSE-SUPPORTER," when used alone, may not constitute a valid trade-mark, but when used in connection with a cut of a hose-supporter engaged with a stocking, and placed, as labels, on boxes containing hose-supporters, the mark, in its entirety, is sufficiently arbitrary to fairly denote the origin of the goods and is entitled to protection as a trade-mark.

Frost v. Rindskopf, U. S. C. C., E. D. N. Y., *Wheeler, J.*, 42 F. R., 408.

PROHIBITED SUBJECTS OF TRADE OR OTHER COMMERCIAL MARKS.

24. The prohibition in the following sections is understood to include trade-marks, labels, advertisements, and printed designs.

Section 2 of the Act of Feb. 5th, 1867, makes it unlawful to design, engrave, print, or in any manner make or execute, or to utter, issue, distribute, circulate, or use any business or professional card, notice, placard, circular, handbill, or advertisement, in the likeness or similitude of any bond, certificate of indebtedness, certificate of deposit, coupon, United States note, Treasury note, circulating note, fractional note, postage stamp note, or other obligation or security of the United States, or of any banking association organized or acting under the laws thereof, which has been or may be issued under or authorized by any act of Congress heretofore passed or which may hereafter be passed. And any person or persons offending against the provisions of this section shall be subject to a penalty of one hundred dollars, to be recovered by an action of debt, one-half to the use of the informer.

Section 3 of the same Act makes it unlawful to write, print, or otherwise *impress* upon any bond, certificate of indebtedness, or other instrument specified in the last preceding section, any

business or professional card, notice, or advertisement, or any notice or advertisement of any goods, wares, or merchandise, or of any drug or medicine, or of any invention or patent, or of any other matter or thing whatsoever; and any person or persons offending against the provisions of this section shall be subject to a penalty of one hundred dollars, to be recovered by an action of debt, one-half to the use of the informer.

Act approved 5 Feb., 1867, — Prohibiting use or imitation of U. S. bank-notes, etc., for advertising purposes.

25. "Red Cross" for medicines.

Where applicants sought to register a trade-mark which consisted of a red cross, Greek in form, on black ground in a diamond shaped border and accompanied by the words, "RED CROSS," and the application stated that applicants had "used it as a trade-mark on their medicinal compounds since 20 Oct., 1887, and in commerce with Canada," and the Examiner rejected the application because "the name 'red cross' and the symbol of a red Greek cross have been adopted by the celebrated 'International Red Cross Society,' and are used upon its hospital-supplies, medicines, etc.," and because "the employment of the name or symbol would simply be regarded as an attempt to make profit out of the reputation of that society:" *Held*, that such a trade-mark would naturally lead the purchaser to suppose that he was purchasing an article which, even if not manufactured by the Red Cross Society, had at least its sanction or endorsement, and that such a trade-mark is, irrespective of its intent, in the nature of a false representation calculated to mislead the public (*Manhattan Med. Co. v. Wood*, U. S. S. C. By *Field, J.*, 2 Ap., 1883, 108 U. S., 218,*). Decision of the Examiner affirmed and registration refused.

Chidester Chem. Co., x. p., *Mitchell, Com.*, 3 Aug., 1889.

Compare (32) and (33) *infra*.

26. "Old Sleuth," — series of publications.

Where the plaintiff, who had been using the name "OLD SLEUTH" to designate a series of books published by them, sought to enjoin defendants from using the word "SLEUTH" on the titlepage of certain stories which they published, it was held that the word "sleuth," being a word having a place and meaning in the language, cannot be appropriated as a trade-mark.

Munro v. Beadle, Supreme Court of New York, *Ingraham, J.*, 11 Oct., 1888, 46 O. G., 448.

Compare *Munro v. Smith et al.*, (14) COPYRIGHT, where the same complainant (*Munro*) attempted unsuccessfully, under his copyright, to restrain the use in a similar publication of a picture (different from his own) of "Old Sleuth the Detective."

NOTE. — Decision in *Munro v. Beadle* permits the inference that a purely fanciful word may be registered as a trade-mark for a published serial or a series of publications.

A VERBAL TRADE-MARK MUST NOT BE DESCRIPTIVE.**27. "Indurated Fibre."**

The words "INDURATED FIBRE" as applied to wares made of wood-pulp which has been condensed and subjected to baths in linseed oil and resin, and baked, designate wood-fibre which has been subjected to a hardening process, and refer to ingredients, quality, and characteristics. These words are not so arbitrary and fanciful as to authorize a preliminary injunction in an action to restrain their use as an infringement of a trade-mark.

Indurated Fibre Co. v. Amoskeag Indurated Fibre Ware Co., U. S. C. C. D. Mass., *Colt, J.*, 21 Jan., 1889, 37 F. R., 695.

28. "Headache Capsules."

The word-phrase "HEADACHE-CAPSULES," as applied to a medicine for curing headache, refused registration

on the ground that they have no fanciful or arbitrary character, but constitute ordinary descriptive language.

Lichty, x. p., *Mitchell, Com.*, 6 May, 1891, C. D. Ms.

NOTE. — In this case, the Examiner had cited Heyman, x. p., 1880, C. D. 194, and Brigham, x. p., 1881, C. D. 38, and the Commissioner said, "To these may be added the following cases where registration has been refused on the same grounds as those taken by the Examiner in the present case. C. L. Hathaway & Sons, 1871, C. D. 97; R. J. Roberts, 1871, C. D. 113; S. Palmer, 1871, C. D. 289; Blakesley & Co., 1871, C. D. 142; Alden, x. p., 1878, C. D. 142; The Safety Powder Co., 1879, C. D. 117; Ames, x. p., 1883, C. D. 10; Kipling, x. p., 1883, C. D. 54. The law, as set forth in these decisions is believed to be in accordance with what is said by the courts in *Town v. Stetson*, 3 Daly, 53; *Larrabee v. Lewis*, 25 Alb. L. J., 203; *Gintner v. Kinney Tobacco Co.*, 12 F. R., 782; *Ayer v. Rushton*, 7 Daly, 9; *Hect v. Porter*, 6 Pac. C. L. J., 569; *Canal Co. v. Clark*, 13 Wall., 322, *, and other decisions.

29. "Tablet."

Registration of the word "TABLET," as a trade-mark for snuff, denied, on the ground that it was descriptive of snuff compressed into tablets and would operate to prevent the sale of snuff in tablet form by others.

Reed, x. p., *Mitchell, Com.*, 24 Sep., 1890, C. D. Ms.

30. Subject-matter of an expired Design Patent not Registrable.

A group of figures or characters embossed on the spool-head to indicate the grade of thread had been the subject of a design patent owned by complainant who, on said patent's expiration, sought to enjoin the use of such an embossed inscription by a competitor on the plea that it had acquired value as a trade-mark. The plea was denied and bill dismissed *because the inscription did*

not appear to possess the qualifications required in a trade-mark and consequently complainant's monopoly ceased at the expiration of his design patent.

Coats *v.* Merrick Thread Co., U. S. C. C., N. Y., *Wheeler, J.*, 28 Sep., 1888, 36 F. R., 324.

NOTE. — The fact that the embossed inscription in question was descriptive rather than arbitrary would seem to have unfitted it for claim as subject of trade-mark right (*Canal Co. v. Clark*, 13 Wall., 322, *), but the court thought it sufficient to cite the long-standing and general use of such inscriptions on thread-spools.

MISLEADING MARKS NOT REGISTRABLE.

31. "Cherry-Cocktail."

Registration of the compound word "CHERRY-COCKTAIL" as a trade-mark for "*Temperance or non-Alcoholic Beverages*;" *Denied*, on the ground that the word "cocktail" denotes a beverage containing alcohol, and its use upon non-alcoholic beverages, being misleading, would make it an unlawful trade-mark even if true that there is no such beverage known as "*cherry*" cocktail. *Also held*, that, if it were doubtful whether or not the public would be thus deceived, the doubt should be resolved against the applicant, it being held that *a doubtful trade-mark is bad*.

Rowe, x. p., *Frothingham, Act. Com.*, 2 May, 1892, C. D. Ms.

32. "Liebig's Diarrhoea Cordial"

The words "LIEBIG'S DIARRHŒA CORDIAL" refused registration as a trade-mark on the ground that the name "Liebig" would naturally lead the purchaser to suppose that he was purchasing an article which, if not manufactured by the distinguished chemist, was prepared after his formula, or at least had his sanction or endorse-

ment, and would be, irrespective of intent, in the nature of a false representation.

Finlay & Brunswig, x. p., *Frothingham, Act. Com.*, 25 Feb., 1892, C. D. Ms.

33. Misleading Name.

Applicant, having been refused registration of a name because descriptive, filed thereupon an amendment to his application in which it was stated that the word was not descriptive inasmuch as there was nothing in the compound which had any relation whatever either to the word used or to the tree known by it: *Held*, sustaining Examiner's action and refusing registration, because the mark, when applied to the compound or so-called "balsam" of the applicant would be in the nature of a misrepresentation or fraud upon the public. The Patent Office will refuse registration of a trade-mark which is liable to deceive the public with reference to the contents of bottles, boxes, etc., to which it is applied.

Johnson, x. p., *Frothingham, Act. Com.*, 13 Aug., 1892, C. D. Ms.

34. Registration refused for an already appropriated mark.

A trade-mark for soaps consisting of "the word 'YUCCA,' arranged over the representation of the yucca plant," refused upon reference to a registered mark for soaps which consisted essentially of "a representation, in elevation, of a 'Spanish bayonet plant,'" it appearing that the two names referred to the same plant, and that the distinguishing and most notable feature of each mark was a representation of a yucca plant, and that, consequently, the use of the mark sought to be registered would have a tendency to deceive and mislead purchasers using ordinary caution.

Bogardus, x. p., *Frothingham, Act. Com.*, 26 Mar., 1892, C. D. Ms.

35. "Taylor." — "Old Taylor."

The word "Taylor" being registered as a trade-mark for use on a certain class of goods, registration of the words "Old Taylor," for use on the same class of goods, refused, on the ground that the word "Taylor" was the distinguishing and most notable characteristic of not only the registered trade-mark, but also of that sought to be registered, and that therefore the latter would have a tendency to deceive and mislead purchasers having ordinary caution.

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

35'. Imitative Marks.

It is well settled that the right of registration does not extend to trade-marks the use of which would infringe pre-existing trade-marks. *Imitative marks infringe not only when they contain the entire mark previously adopted, but also when they contain enough of the prominent features of the prior mark to be likely to cause purchasers using ordinary caution to be misled.*

Ib.

36. Fraud — Competition.

The law does not visit with its reprobation a fair competition in trade; its tendency is rather to discourage monopolies, except where protected by statute, and to build up new enterprises from which the public is likely to derive a benefit. It is only when such competition is based upon fraud that the law will interfere.

The Brown Chem. Co. v. Meyer *et al.*, U. S. S. C. By *Brown, J.*, 6 Ap., 1891, 55 O. G., 287, *.

37. Reference.

A rejected trade-mark application is no more a reference for a trade-mark application than is a rejected mechanical application for a mechanical application.

Ross, x. p., *Fisher, Act. Com.*, 10 July, 1890, C. D. Ms.

38. Same Descriptive Properties.

“Roofing Composition and Materials” and “Mixed Paints and Roofing Composition :” *Held*, to be merchandise of substantially the same descriptive properties (Kyle & Co., x. p., 57 O. G., 274), and registration denied where the mark applied to the latter merchandise so nearly resembled a registered mark applied to the first as to be calculated to deceive purchasers exercising ordinary caution.

Beaver M’f’g Co., x. p., *Frothingham, Act. Com.*, 6 June, 1892, C. D. Ms.

39. Issue to assignee, — how effected.

A trade-mark registration may be applied for by the owner, whether such owner acquired his title by original adoption or by subsequent assignment, but a certificate of registration of a trade-mark will not be issued to the assignee of the applicant, although the assignment may have been recorded prior to the issue of the certificate of registration.

Bassett, x. p., *Mitchell, Com.*, 12 May, 1891, 55 O. G., 997.

40. A trade-mark that has been used in a particular business should be deemed to have passed with a transfer of the business.

Atlantic Milling Co. v. Robinson, *Wallace, J.*, 6 May, 1884, 27 O. G., 1322.

INTERFERING TRADE-MARK APPLICATIONS.

41. Where, upon a motion to dissolve an interference declared between conflicting applications for registration of a trade-mark, it was contended that the only question in such an interference is that of priority in application for registration : *Held*, sustaining the Primary Examiner’s refusal to dissolve, that, where a conflict appears to

exist between such applications, Rule 13 must be applied, which provides: "In case of conflicting applications for registration, or in any dispute as to the right to use, which may arise between an applicant and a prior registrant, the Office will declare an interference, in order that the parties may have opportunity to prove priority of adoption or right." See also sec. 3, Act of 3 Mar., 1881.

Langdon & Batcheller *v.* Thomson, *Mitchell, Com.*, 31 May, 1890.

Compare Richmond *v.* Richmond Nervine Co., *infra*.

42. In trade-mark interferences the question is the same as would arise in a court of equity if one of the parties were seeking to enjoin the other from using the trade-mark in controversy; hence the right to registration belongs to the party who should prevail in such a litigation.

Richmond *v.* Richmond Nervine Co., *Mitchell, Com.*, 21 June, 1890, C. D. Ms.

Compare Langdon & Batcheller *v.* Thomson, *supra*.

TRADE-MARK INFRINGEMENTS.

43. Trade-mark is infringed by one liable to deceive an ordinary purchaser.

As to what facts constitute infringement of a trade-mark or of a trade reputation, no rule can be formulated that will embrace every act of infringement, and a comparison with the original of the alleged imitation is of primary importance. The resemblance need not be such as would mislead an expert or such as would not easily be detected if each case must depend mainly on itself. It is enough if such resemblance exists as would lead an ordinary purchaser to suppose that he was buying the genuine article and not an imitation. If the differences

are only colorable and there is no reason for the resemblances except the purpose of deceiving the purchaser, the court will presume a fraud was intended.

Avery & Sons v. Meikle & Co., Ky. Ct. of Appeals. By *Hargis, Ch. J.*, 27 Mar., 1883, 27 O. G., 1027.

44. It is not incumbent upon the complainants to show that their trade-mark has been copied in every particular; it is sufficient if it has been imitated to an extent sufficient to deceive purchasers, and to cause the article to which it has been applied to pass as their article.

Atlantic Milling Co. v. Robinson, *Wallace, J.*, 6 May, 1884, 27 O. G., 1322.

45. False Suggestion.

Where in a suit to restrain the unlawful use of the trade-mark or symbol "SAPOLIO" it appears that, when persons called at defendant's store and asked for Sapolio soap, his salesman would (without any statement or explanation) hand out a package which did not bear the name of "Sapolio" at all, but on which "Pride of the Kitchen" was plainly marked, the size and shape of the package and appearance of wrapper being moreover entirely unlike the article sold as Sapolio: the court cited *Celluloid M'f'g Co. v. Cellonite M'f'g Co.*, *Bradley, J.*, (32 F. R., 97,) and: *Held*, that *any act or thing done to induce the belief that one article was in fact the other was unfair and unlawful*, and granted an injunction.

Morgan, Sons & Co. v. Wendover, *Green, J.*, U. S. C. C., N. Y., 43 F. R., 420.

46. Degree of Resemblance.

A trade-mark for underwear, consisting of the conventional representation of a "Sun" surrounded by rays and

having a distinctly marked human face, and, frequently though not necessarily, bearing the words: "Warmth is Life," is not infringed by a symbol having an imperfect outline somewhat resembling sun-rays, but whose characteristic feature is a circle inclosing a monogram, the label never bearing the words "Warmth is Life," but always having the name of the manufacturing company using it.

Jaros Hygienic Underwear Co. v. Simons, U. S. C. C., Mass., *Colt, J.*, 15 Feb., 1892, 49 F. R., 276.

47. There must be, between the genuine and alleged deceptive marks, such similarity or resemblance of form, color, symbols, designs, and such identity of words and their arrangement, as to have a direct tendency of misleading buyers who exercise the usual amount of prudence and caution; and there must also be such a distinctive individuality in the mark employed by the counterfeiter as to procure for him the benefit of the deception resulting from the general resemblance between the genuine and counterfeit labels and trade-marks.

Colladay v. Baird, *Ludlow, J.*, Court of Common Pleas of Phila., p. 257, Cox Am. T. M. Cas.

48. To entitle the owner of a trade-mark to an injunction to prevent its use by another person, there must be, in the [alleged] copy, such a general resemblance of the form, words, and symbols in the original as to mislead the public. A sufficient distinctive individuality must be presented so as to secure for the person himself the benefit of that deception which general resemblance is calculated to produce. *The court will not interfere where ordinary attention will enable purchasers to discriminate*, nor where the ordinary mass of purchasers, paying the usual attention, in buying the article in question, would not be deceived.

Rowley v. Houghton, *Ludlow, J.*, p. 486, Cox Am. T. M. Cas.

49. To have a word or words claimed as a trade-mark protected by injunction from use by another, it should appear the defendant's use of them was with intent to deceive or mislead the public.

Larrabee & Co. v. Lewis, Supreme Court of Georgia, Nov., 1881, p. 560, Price and Stewart Am. T. M. Cas.

REGISTRATION FEES.

50. Transfer of trade-mark fee, — refused.

A filed an application for registration of a trade-mark, but registration was refused him as his oath did not show that he had exclusive title to the mark; thereupon *B*, a foreign company and the true owner, filed a petition to register the mark, and requested that the fee paid by *A*, who was *B*'s agent, be applied to *B*'s application: *Held*, that there was no authority for the transfer of a fee from one application for a trade-mark which has received examination, to a new application presented by another person, as in the present instance.

Coventry Machinist Co., x. p., *Frothingham, Act. Com.*, 23 Feb., 1892, 59 O. G., 1923.

NOTE. — Subsequently, *B* petitioned for return of the fee paid by *A*, upon the ground that it was paid by mistake under a supposition that *A* was the proper person to sign for registration in this country, but the Assistant Commissioner denied the petition, holding that the mistake, if any, was *a mistake of LAW and not one of fact*, and that, *A*'s application having been rejected on its "merits," the fee could not be refunded.

This decision was made 12 May, 1892, and appears in 59 O. G., 1923.

51. Fee not refunded.

There is no authority, either in the law or in the regulations of the Patent Office, for re-payment of fees paid in trade-mark cases where registration is refused.

Thayer, x. p., *Chandler, 1st Assist. Sec. of Int.*, 28 Jan., 1891, 54 O. G., 957.

United States Coat of Arms,—not registrable.

Where it was admitted that the mark was substantially the coat of arms of the United States, and would be accepted as such by the ordinary mind, registration was refused, upon the ground that it was against public policy to register a coat of arms of any state or nation.

Schmachtenberg, x. p., *Frothingham, Act. Com.*, 8 Oct., 1892, C. D. Ms.

When the subject-matter of the application was clearly anticipated by a mark registered [by another] under the Act of 1870, and Examiner refused to declare an interference because of the nullity of such prior registration, and also refused registration to the second applicant because the prior registry made the mark an anticipation: *Held*, that the proper course for the Office in such a case is to give the applicant who had filed under the law of 1870, notice that an application is pending with which his registry, if it were under the existing act, would interfere, and allow him sixty days to make an application.

Am. Lead Pencil Co., x. p., *Simonds, Com.*, 27 Sep., 1892, C. D. Ms.

NOTE.—The Supreme Court having pronounced the Trade-Mark Act of 1870 unconstitutional, all registrations under it became null and void.

INFRINGEMENT IMPORTS. FOREIGN TRADE-MARKS.

52. Act of Congress approved 1 Oct., 1890, section 7, enjoins collectors and other officers of customs to refuse entry from abroad of merchandise so marked as to copy or simulate the name or the trade-mark of any domestic manufacture or manufacturer, and the Secretary of the Treasury (in regulations promulgated 31 Oct., 1890) invites proprietors of such marks and names to furnish

the department with copies thereof, and instructs officers of the department to keep the same on record, and to exercise care to prevent the entry at the custom-house of any article of foreign manufacture that copies or simulates such mark or name.

Records of Treasury Department, 31 Oct., 1890.

53. Foreign Applicants.

The United States Government guarantees to furnish foreign applicants such protection, and such protection only, as their respective governments accord to them.

Haggenmacher, x. p., *Simonds, Com.*, 27 June, 1892, 60 O. G., 438.

54. Foreigner's Rights. — Test.

A citizen of Switzerland located and having a place of business at Buda-Pesth in Austria, cannot register in the United States a trade-mark which is of a character specially excepted from protection under the laws of Austria, viz., an arbitrary word-symbol. The location or place of business, and not the citizenship, is the test.

Ib.

55. Foreign Commerce.

The fact that an applicant was the first to use the mark in foreign commerce does not entitle him to register it, if it appears that he is not presumptively the owner of the mark at common law (see *Manitowoc M'f'g Co. v. Dickerman*, 57 O. G., 1721).

Empire Mill Co., x. p., *Frothingham, Act. Com.*, 24 Dec., 1891.

LABELS.

1. The dictum of the United States Supreme Court in the case of *Higgins v. Keuffel*, may be summarized as follows :

Under the terms of the Act of 18 June, 1874, which authorizes registration of commercial labels, this kind of right is, except in the particulars specified in the said act, subject to the requirements of the general copyright law on which it is engrafted.

In the case at bar these requirements had not been complied with, and the decree of the court below dismissing the suit was therefore affirmed.

Higgins et al. v. Keuffel et al., U. S. S. C. By *Field, J.*, 11 May, 1891, 55 O. G., 1139, *.

NOTE. — A full compliance with the Copyright Act would seem to include: (a) registration precedent to publication; (b) evidence of intellectual labor, either literary or artistic; (c) the imprinting of the date of registration on each label in commercial use. To the above, the Label Act itself adds another requirement, viz. : The “print,” “picture,” or “figure” to be registered as a label must *not* be registrable as a trademark; see Sec. 3, Act 18 June, 1874.

2. Purport and Limitations of the Act of 18 July, 1874.

The cases of *Higgins v. Keuffel* (140 U. S., 428 ; 35 L. ed., 470 ; 55 O. G., 1139, *), and the Trade-Mark cases (100 U. S., 82, *), therein cited, are understood to establish the following propositions : —

(1) That section 3 of Act of 18 July, 1874, in order to be valid, must be based upon some part of the Constitution of the United States.

(2) Such basis, if it exists, must be found either in “*the Commerce Clause*” or in “*the Author’s and Inventor’s Clause*” of the Constitution.

(3) It is not found in the Commerce Clause, because it lacks the limitations inherent in said Commerce Clause.

(4) The constitutional basis for said act, if it exists, is in the Author's and Inventor's Clause.

As the Supreme Court is not understood to have definitely pronounced the above act unconstitutional, it remains for this Office to treat it as valid and as being *a part of the copyright law.*

Palmer, x. p., *Simonds, Com.*, 13 Jan. 1892, 58 O. G., 383.

3. Requirements for Registration.

A label, in order to be entitled to registry, under the copyright law, in the Patent Office, needs to possess as much artistic [or literary?] excellence as would entitle it to copyright in the Office of the Librarian of Congress, if it were not something "designed to be used for any other articles of manufacture" than "pictorial illustrations or works connected with the fine arts."

Ib.

4. Proper subject for registration illustrated.

Where applicant presented for registry as a label a piece of paper, about seven inches long by three and a half inches wide, bearing a picture of a hammock, to which the label applied and its accessories, attached at one end to the fragment of a branch of a tree and at the other to a fragment of the side of a house, with certain descriptive matter in words, the whole, so far described, being printed upon a white ground, which was, in effect, an oval panel in a section of the hammock, that hammock-section being printed in three different colors, presumably to denote the color and arrangement of the strands of the hammock: *Held*, that the design appeared to fall within the narrow limits fixed by the statute to be a proper subject for registration as a label.

Ib.

5. Qualifications for copyright registration and for label registration distinguished.

The difference between a copyright and a label is that in the copyright act the words "engraving," "cut," and "print" are applied only to pictorial illustrations or works in the fine arts, and matter pertaining to them is entered in the office of the Librarian of Congress, whereas, by the word "print" or "label" as employed in the Label Act, is understood only such a label or print (not appropriable as a trade-mark) as is to be used on an article of manufacture, and the Commissioner of Patents is charged with the control and supervision of the entry or registry of such print or label.

C. A. Yale Cigar M'f'g Co. v. C. A. Yale, Dyrenforth, Act. Com., 19 July, 1884, 30 O. G., 1183.

Compare decision of *Bishop, Com.*, in (3) DESIGNS.

6. Proper and improper subjects for label registration illustrated.

Where, in the label sought to be registered, it was clear that, while the part thereof which contained fanciful or arbitrary matter within the meaning of the trade-mark law (viz., an illustration of a mountainous sea-coast, etc.) might possess such a degree of artistic merit as would entitle it to be registered as under the copyright law [if not designed for attachment to an article of merchandise; see *Bishop, Com.*, Aug., 1859 (3) DESIGN; Norton, x. p., *Marble, Com.*, 16 June, 1882, 22 O. G., 1205], yet it was *not* a pictorial representation of the article for which it was designed to be used, and it therefore fell *without* the narrow margin allowed for the registry of labels, under the copyright law, in the Patent Office, which is permitted by the decision in *Palmer*, x. p. (58 O. G., 383).

Whitman & Son, x. p., *Frothingham, Act. Com.*, 24 Feb., 1892, C. D. Ms.

NOTE (i). — In this case the Assistant Commissioner stated that he was authorized to state that the Commissioner concurred in the conclusion reached.

NOTE (ii). — From the italicized portions of above decision it may be inferred that the picture in question might have been registered as a trade-mark.

7. Requirements for Registration.

Upon a motion for re-hearing of *Whitman & Son, x. p.*, in view of the change of the practice indicated in the case of *Palmer, x. p. : Held*, denying the motion, that it was held in the *Palmer* case that “a pictorial representation descriptive of the fabric of the hammock to which the label applies” was proper subject-matter for registration as a label. It was not, however, intended to decide in that case, nor was it in fact held therein, that a mere arbitrary or fanciful design having no special relation to the article of merchandise it was intended for, would be a proper subject for registration as a label. In *Palmer's* case the label consisted of matter not fanciful or arbitrary in the sense of the trade-mark law, but *illustrative of the article to which it was to be applied*, besides having such a degree of artistic excellence as to entitle it to protection under the copyright law.

Ib.

8. A label consisting of an engraving showing steps at the front of a house, with a kneeling female figure in the act of scrubbing the steps, and having the words “Ecker's Stone Mineral Soap” in ornamental letters upon the design, and below the engraving a description, printed in ordinary type, of the uses to which the soap could be put and for which it is particularly designed, cannot properly be registered in the Patent Office under the Act of 18 June, 1874, in view of the decision of the

Supreme Court in *Higgins v. Keuffel*, U. S. S. C. By *Field, J.*, 11 May, 1891, 55 O. G., 1139, 35 L. ed., 470, *.

Ecker, &c. Co., x. p., *Frothingham, Act. Com.*, 20 Nov., 1891, C. D. Ms.

9. A label consisting of the name of the article contained in the bottle or package to which it is applied, a statement of the uses of the article, directions for applying it, the price at which it is sold, and the name and address of the firm by which it is prepared, and which exhibits *no attempt at art or literary merit*, was not entitled to registration under the recent decision of the Supreme Court in *Higgins et al. v. Keuffel et al.*, 55 O. G., 1139, and registration was denied.

Eldridge & Co., x. p., *Mitchell, Com.*, 27 May, 1891, 55 O. G., 1278.

10. The words "Silver Shine" sought to be protected, being a fanciful one coined by applicant and not being descriptive, was proper subject of protection as a trade-mark.

It is the settled practice of the Office to consider the words "not a trade-mark," in the statute approved 18 June, 1874, referring to the registration of labels, as applying to anything appearing on a label susceptible of appropriation as a trade-mark. Label registration was refused.

Ruckstuhl, x. p., *Simonds, Com.*, 4 Aug., 1891, 56 O. G., 927.

11. Decree was denied to complaint of infringement of right to exclusive use of a representation of a horse-shoe with no letters on it. It might have been protected as a trade-mark.

Lorillard & Co. v. Drummond Tobacco Co., 22 O. G., 1203.

12. Trade-mark in label must be registered.

The doctrine of *The Wilcox & Gibbs S. M. Co. v. Marble*, 1882, C. D. 445, was overruled by the Supreme Court of the District of Columbia (*Moodie v. Butterworth*, 1885, C. D. 1), and the settled doctrine of the Office now is that labels containing or constituting trade-marks cannot be registered as labels until the trade-mark matter has already been registered in accordance with the statute regulating the registration of trade-marks (*Simpson & Sons*, x. p., 1876, C. D. 148; *Moodie*, x. p., 1884, C. D. 35; *Moodie v. Butterworth*, *supra*; *Wiesel*, x. p., 1886, C. D. 22; *Columbia S. M. Co.*, 41 Ms. C. D. 228; *Snook & Halbe*, 40 Ms. C. D. 423).

Diamond Laboratory Co., x. p., *Mitchell, Com.*, 23 July, 1890, C. D. Ms.

NOTE. — In above case the Commissioner said that, if there remained some possible doubt upon the whole case whether the trade-mark had been registered for a class of articles including that for which the label was intended, he thought the applicant should have the benefit of the doubt. 2 *Gourick*, 53.

13. Lacking the requisite "merit," — both artistic and literary.

Examiner refused to register the label, under the provisions of the Act of 1874, in view of the decisions in *Higgins v. Keuffel* (55 O. G., 1139, *); *Eldridge & Co.*, x. p., (55 O. G., 1278); and *Palmer*, x. p., (58 O. G., 383): *Held*, that the label had not that degree [either] of art or of literary merit which would entitle it to registry under the act above referred to, and that, therefore, it did not fall within that narrow margin allowed for registration of labels under the Copyright Law, which is permitted by the decision of the Supreme Court in the case of *Higgins v. Keuffel*, *supra*.

Racine Basket M'f'g Co., x. p., *Frothingham, Act. Com.*, 7 Oct., 1892, C. D. Ms.

NOTE. — The label above referred to was to be used for baskets, and had, for its principal features —

The words "Racine Basket" placed prominently on top, and, in the central part, applicant's registered trade-mark. Following this, and occupying the lower half of the label, was certain advertising matter in different sized type, which did not convey any information regarding the use of the baskets, and did not illustrate the baskets in any manner. These features were on a clouded background within an ornamental border.

14. Why not registrable, — although artistic.

Although it may be true that the thing which applicant presents for registry, as a label, is artistic, yet, if it is clear that it is merely fanciful and arbitrary, and is not descriptive of the contents of the package to which it is to be applied [it falls within the provisions for trade-marks, and hence, under the Label Act of 1874], it follows that it does not come within the narrow margin allowed for the registry of labels.

Baltz Brewing Co., x. p., *Simonds, Com.*, Oct. 26, 1892, C. D. Ms.

15. Subject-matter.

Where the matter presented for registration as a label was a dial for use upon a watchman's clock, of which it was a necessary and material part and in which it performed a given function: *Held*, that it was not a label proper, and registration must be refused.

Newman, x. p., *Fisher, Act. Com.*, 13 Feb., 1891, C. D. Ms.

APPENDIX A.

COPYRIGHTS.

1. The statutes providing for copyright registration (in common with those for label registration and those for grant of patents for inventions, whether artistic or industrial) are derived from the "Authors' and Inventors' Clause" (Cl. 8, Sec. 8, Art. 1) of the Constitution of the United States.

All records, certificates, and other matters relating to the registration of copyrights are under the control of the Librarian of Congress, subject to the supervision of the Joint Committee of Congress on the Library.

Sec. 4949, R. S.

Compare (1) TRADE-MARKS, and (2) LABELS.

2. A United States copyright is the grant to the author or proprietor (if a citizen of the United States) of any book, map, chart, dramatic or musical composition, or of any engraving, cut, or print, if a work of the fine arts, — or of any photograph or negative thereof, or of any painting, drawing, chromo, statue, statuary, or of a model or design intended to be perfected as a work of the fine arts, — (his heirs or assigns), for a term of years (extensible upon suitable request), of the sole liberty of printing, reprinting, publishing, copying, finishing, and vending the same, and, in case of a dramatic composition, of publicly performing or representing, or

causing to be performed or represented by others, with all rights of translation or dramatization of works.

C. A. Yale Cigar M'fg Co. v. C. A. Yale, Dyrenforth, Act. Com., 19 July, 1884, 30 O. G., 1183.

NOTE. — Since the above decision was rendered, U. S. Copyright privileges have been extended to citizens of countries granting like privileges to U. S. citizens. See (22) *infra*.

Compare decision of *Bishop, Com.*, (3) DESIGNS.

3. Where a report of judicial opinions is the result of intellectual labor, it may be copyrighted.

Although there can be no copyright in the opinions of judges or in the work done by them in their official capacity as judges, yet one who prepares and publishes a report thereof may obtain a copyright for the publication, and will be protected in matter which is the result of his intellectual labor.

Callaghan v. Myers, Blatchford, J., 17 Dec., 1888, 46 O. G., 565.

4. Photographs may be protected by copyright.

No doubt is entertained that the constitutional provision is broad enough to cover an act authorizing copyright of photographs so far as they are representative of original intellectual conceptions of the author.

Burrow-Giles Lith. Co. v. Sarony, U. S. S. C. By Miller, J., 17 Mar., 1884, 27 O. G., 413, *.

See (4) DESIGNS.

5. The Filing Title.

A copyright whose title recorded with the Librarian of Congress is "Under the Gas-Light: A Romantic Panorama of the Streets and Houses of New York," is not infringed by a drama entitled "Under the Gas-Light: A Drama of Life and Love in these Times."

The registered title might have been simply "Under the Gas-Light," and would then have been infringed; but when two names or descriptive terms are incorporated in the title, each becomes an integral part of it, and it may as reasonably be contended that one part of the title can be dropped out as that the other can be.

Daly v. Brady et al., *Wallace, J.*, 19 June, 1889, 39 F. R., 265.

Compare *Munro v. Beadle*, (26) TRADE-MARKS; and *Munro v. Smith et al.*, (14) *infra*.

6. Statutory Notice, — Phraseology.

It is sufficient if the notice of copyright inscribed on the photograph read "1889, Copyrighted by B. J. Falk, New York," instead of "Copyrighted 1889, by B. J. Falk," as required by the literal directions of the statute.

Falk v. Schumacher, U. S. C. C., S. D. N. Y. By *Coxe, J.*, 12 Nov., 1891, 48 F. R., 222.

7. In an action for infringement of a copyright for a photograph, in order to sustain the defence that the copy which defendant reproduced was without the statutory notice of copyright, it is not sufficient that it was without the statutory notice when it came into defendant's possession, but it must be shown that it lacked such notice when it left plaintiff's possession.

Falk v. Gast. Lith. & Engr. Co., U. S. C. C., S. D. N. Y., *Coxe, J.*, 30 Nov., 1891, 48 F. R., 262.

8. Defective Notice.

The owner of a copyright had issued several editions, in some of which the notice read "Entered according to Act of Congress" (omitting the year and by whom entered), and other editions in which the notice read "Copyright 1880" (omitting by whom): *Held*, that the

requirements of the statute were *not* complied with, and that no action could be sustained.

Thompson v. Hubbard, U. S. S. C. By *Blatchford, J.*, 13 May, 1889, 131 U. S., 123.

9. Firm Name.

A person doing business under a conventional or fictitious firm name may obtain a valid copyright under that name.

Scribner v. Allen, U. S. C. C., S. D. N. Y., *Shipman, J.*, 16 Mar., 1892, 49 F. R., 854.

10. How Transferred.

An undivided interest in a copyright may be assigned by instrument in writing, and an inchoate right to a copyright may be transferred by parole, prior to the taking of the copyright.

Black et al. v. Allen Co., U. S. C. C., S. D. N. Y., *Shipman, J.*, 42 F. R., 618.

11. A copyrighted book published, by the consent and under the license of the author, as a part of a foreign encyclopædia whose other portions are not protected by the copyright laws of the United States, does not thereby become public property, and cannot, without the consent of the author, be used in a reprint of the encyclopædia.

Ib.

12. If proven that the alien publishers of the foreign encyclopædia procured copyrighted articles from citizens of the United States for the express purpose of preventing the work from being reprinted in the United States,

that would in no wise affect their right to protect their copyright in the courts of the United States.

Ib.

13. An imported copy in a foreign language infringes the United States Copyright.

The fact that a book is published in a language other than English does not relieve it from infringement of the United States copyright. Hence, where the owner of the Norwegian copyright of a book which was also copyrighted in this country sent a copy thereof in the Norwegian language to a party in this country: *Held*, that it could not be delivered without consent of the owners of the United States copyright.

U. S. Treasury Department — Synopsis 10,269.

14. Copyright of complainant's pamphlets and magazines containing pictures of "Old Sleuth:" *Held*, not infringed by defendants' books having a picture of "Old Sleuth the Detective" on the cover, where the variations were sufficient to make the pictures very different, although it was probably true that the defendants got from the plaintiff the idea of having such a picture.

Munro v. Smith et al., Shipman, J., 5 May, 1890, U. S. C. C., S. D. N. Y., 42 F. R., 266.

Compare *Munro v. Beadle, (26) TRADE-MARKS; Daly v. Brady et al., (5) supra.*

15. Penalty for False Notice.

Where a number of chromos (for which no copyright had been secured) all bearing the word "copyrighted," in violation of sec. 4963, R. S., were struck off each day on several succeeding days, such chromos being in facsimile, except that each day's issue had printed thereon, by way of advertisement, the name of a firm different

from that appearing on every other day's issue: *Held*, that the penalty [\$100] was recoverable for *each issue*.

Taft *v.* Stevens Lith. and Engr. Co., *Thayer, J.*, 39 F. R., 781.

NOTE.—It appeared in evidence that there had been 25 issues of 2000 copies each on 25 consecutive days, = \$2,500 penalty.

16. Details of a copyrighted work need not be separately copyrighted.

Separate copyright of each map contained in a statistical atlas is unnecessary, for they are all protected by a copyright of the entire work.

Black *et al.* *v.* Allen Co., U. S. C. C., S. D. N. Y., *Shipman, J.*, 42 F. R., 618, C. D. Ms.

17. Copyrightable Dramatic Composition defined.

It is essential to a dramatic composition, within the meaning of the Copyright Act, that it should *tell some story*. The plot may be simple. It may be but the narrative or representation of a single transaction; but it must repeat or mimic some action, speech, emotion, passion, or character, real or imaginary; and when it does, it is the IDEAS thus expressed which become subject of copyright.

Fuller *v.* Bemis, U. S. C. C., S. D. N. Y., 18 June, 1892, C. D. Ms.

18. Merely mechanical movements by which effects are produced on the stage are not subjects of copyright where they convey no ideas whose arrangement makes up a dramatic composition, and where they were devised to convey to the spectator no other idea than that a comely woman is illustrating the poetry of motion in a singularly graceful fashion: *Held*, that the idea might be pleasing, but that it could hardly be called dramatic.

Ib.

19. Systems not subjects of Copyright.

The copyright of a book describing a new system of stenography does not protect the system when considered simply as a system apart from the language by which it is explained, so as to make the illustration by another person of the same system in a different book, employing totally different language, an infringement.

Griggs *v.* Perrin, *Coxe, J.*, 3 Feb., 1892, 49 F. R., 15.

Compare Dick. x. p. (24) PATENTABILITY.

20. The time for commencement of publication is not limited by any law or regulation, but the courts have held that it should take place within a reasonable time after registration.

Cir. issued by *Ainsworth R. Spofford, Librarian of Congress*, Aug., 1892.

21. Importation of Copyrighted Articles. — Regulations by the Secretary of the Treasury.

In pursuance of the provisions of the Act entitled "An Act to amend title 60, chapter 3, of the Revised Statutes of the United States relating to Copyrights," approved 3 March, 1891, and more especially of section 4 of said Act, the following regulations are hereby prescribed : —

(1) Copyrighted books and articles, the importation of which is prohibited by section 4956 of the Revised Statutes, as amended by section 3 of said Act, shall not be admitted to entry. Such books and articles, if imported, *with* the previous consent of the proprietor of the copyright, shall be seized by the Collector of Customs, who shall take the proper steps for the forfeiture of the goods to the United States under section 3082 Revised Statutes.

(2) Copyrighted books and articles imported contrary to said prohibition and *without* the previous consent of the proprietor of the copyright (being primarily subject to forfeiture

to the proprietor of the copyright), shall be detained by the collector, who shall forthwith notify such proprietor, in order to ascertain whether said collector shall institute proceedings for the enforcement of said proprietor's right to the forfeiture. If the proprietor institutes such proceedings and obtains the decree of forfeiture, the goods shall be delivered to him upon payment of the expenses incurred in the detention and storage and the duties accrued thereon. If such proprietor shall fail to institute such proceedings within sixty days from the date of notice, or shall declare in writing that he abandons his right to the forfeiture, then the director shall proceed as in the case of articles imported *with* the previous consent of the proprietor.

(3) Copyrighted articles, the importation of which is not prohibited (but which, by virtue of section 4965 of the Revised Statutes, as amended by section 8 of said Act, are forfeited to the proprietor of the copyright when imported without his previous consent, and which are moreover, subject to the forfeiture of \$1 or \$10 per copy, as the case may be, one half thereof to the said proprietor and the other half to the use of the United States), shall be taken possession of by the collector, who shall take the necessary steps for securing to the United States half of the sum so forfeited, and shall keep the goods in his possession until a decree of forfeiture is obtained and the half of the sum so forfeited, as well as the duties and charges accrued, are paid; whereupon he shall deliver the goods [and forfeit moieties] to the proprietor of the copyright.

In case of failure to obtain a decree, the goods shall be admitted to entry.

Instructions of Secretary of the Treasury to U. S. Collectors *et al.*, 3 July, 1891.

22. International Copyright Regulations.

International copyright arrangements between the United States and foreign countries now include Great Britain and her possessions, France, Belgium, Germany, and Switzerland. For an American citizen to secure copyright in Great Britain three conditions are necessary: (1) The title should be entered at Stationers Hall, London; fee, 5 shillings sterling, and 5 shillings addi-

tional if a certified copy of entry is required. (2) The work must be published in Great Britain (or in her dominions) simultaneously with its publication in the United States. (3) Five copies of the publication are required, — one for the British Museum and four (on demand of the guild of Stationers) for four other libraries. French copyright may be secured by a foreigner by depositing two copies of the publication at the Ministry of the Interior in Paris (no fee nor entry of title required). To secure copyright in Belgium a foreigner must register his work at the Department of Agriculture, Industry, and Public Works at Brussels (no fee). In Switzerland: Fee, 2 francs (registration not obligatory).

Circular issued Aug., 1892, by A. R. Ford, Librarian of Congress.

APPENDIX B.

UPWARD of sixty countries now have statutory provisions for the grant of patents for inventions, including: —

AFRICA.

	Sole term. YEARS.	Maximum term. YEARS.
Cape Colony		14
Congo Free State		20
Liberia		20
Mauritius	14	
Natal	14	
Orange Free State		14
Transvaal		14
Tunis		15

AMERICA.

United States (after examination as to novelty, etc. — Patents for medicinal preparations customarily refused)	17	
Argentine Republic (medicines excluded)		15
Bolivia		10
Brazil		15
British Guiana		14
“ Honduras		14
Canada (after examination as to novelty, etc.)		15
Chili		20
Guatemala		15
Mexico	20	
Newfoundland		14
Peru (medicines excluded)		10
United States of Columbia		20
Uruguay (medicines excluded)		9
Venezuela (medicines excluded)		15

ASIA.

Ceylon		14
Hong Kong		14
India (including Aden, Andaman Islands, Burmah, Laccadive Islands, Nicobar Islands)		14
Japan (to natives only)		15
North Borneo		14
Straits Settlements	14	

ATLANTIC.

	Sole term. YEARS.	Maximum term. YEARS.
St. Helena	14	

AUSTRALASIA.

New South Wales	14	
New Zealand		14
Queensland		14
South Australia		14
Tasmania		14
Victoria		14
West Australia		14

EUROPE.

Austria-Hungary (edibles, beverages, and medicines excluded)		15
Belgium		20
British Islands		14
Finland		12
France (including Algeria, Cochin China, Congo, Gaboon, Guadeloupe, French Guiana, La Reunion, Madagascar, Martinique, Mazotte, Micquelon, Nassi Bé, New Caledonia, St. Pierre, Senegal, Tahiti, and Tonquin. — Medicines excluded)		15
Germany and dependencies (after examination as to novelty, etc. — Edibles, beverages, and medicines excluded)		15
Italy and dependencies (medicines excluded)		15
Luxembourg		15
Malta		14
Norway		15
Portugal (including Azores, Cape Verde, Portuguese Guiana, and Madeira. — Edibles, beverages, and medicines excluded)		15
Russia and dependencies (medicines and munitions of war excluded)		10
Spain (including the Balearic, Canary, Cuba, Philippine and Porto Rico Islands. — Medicines excluded)		20
Sweden (after examination as to novelty, etc.)		15
Switzerland		15
Turkey (medicines excluded)		15

OCEANICA.

Fiji Islands	14	
Sandwich Islands	10	

WEST INDIES.

Bahamas		14
Barbadoes		14
Bermudas		14
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Leeward Islands	14	
Trinidad (with Tobago)	14	

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