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PREFACE.

THIS work is especially designed for the use of Patent Agents and Solicitors, and the Legal Profession. It is intended as a working hand-book; a book that may be readily consulted for information upon any subject under the Patents, Trade Mark, and Copyright Laws.

It contains the full text of the laws, reference to the rules of practice thereunder, and a recital of the leading decisions of the Courts, with reference to the cases or authorities under which the full text of the decisions, etc., may be found.

So far as possible, the language used is the language of the law, the rules, or the Courts; it having been our purpose to make the book authoritative, rather than an expression of our own opinions.

Last, but not least, we have provided a comprehensive subject-matter index.

We hope the book will prove as useful to our correspondents as we intend it to be. •

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HISTORY OF THE PATENT SYSTEM OF THE UNITED STATES.

The granting of patents to inventors is authorized by the eighth section of the first article of the Constitution :

“The Congress shall have power * * * * to promote the progress of Science and Useful Arts, by securing, for limited times, to Authors and Inventors the exclusive right to their respective Writings and Discoveries.”

Congress has, in pursuance of this authority, made two classes of grants: (1) Special acts, conferring some new or more exclusive privilege to individual inventors; (2) General acts, providing for the issue of letters patent by a department of the government to any person who may be found to be entitled to them. These, the decisions of the courts interpreting them, the rules of practice of the Patent Office, and the decisions of the Commissioner of Patents, constitute the body of the American patent law and practice.

The first general act was passed in 1790. This act charged the Secretary of State, the Secretary of War, and the Attorney-General, or any two of them, with the duty of granting to an inventor, whose invention they considered sufficiently useful and important, a patent securing to him the exclusive benefits of his invention for a period not exceeding fourteen years. It also prescribed the mode of making application; the proceedings to repeal unlawful patents; the penalty for infringement; and fees for the issue of patents. No examination was made as to the novelty of the invention.

The act of 1793 repealed the act of 1790, saving existing rights; confided the duty of issuing patents to the Secretary of State, subject to the approval of the Attorney-General; and provided that the applicant for patent should make oath that he believed himself the true inventor; for the assignment of interest in patents and the recording of same; for proceedings in case of interfering applications; that a patentee of an improvement is not entitled to use the original invention, or *vice versa*; that changes of form or proportions do not amount to an invention; the mode of making application; and that State patents be relinquished by patentees of United States. The term of the patent still remained fourteen years.

The act of 1794 provided for saving suits commenced under the act of 1790 from defeat by the repeal of the act in 1793.

The act of 1800 extended the privileges of the act of 1793 to resident aliens; provided that oath should be made by every applicant that to the best of his knowledge the invention was never before known or used in this or any foreign country; such use to avoid patent if obtained; and that representatives of deceased inventor might obtain patent in trust for the heirs or devisees.

The act of 1819 provided that the circuit courts of the United States should have original cognizance, at law and equity, of actions under patent laws, with writ of error or appeal to the Supreme Court.

The act of 1832, ch. 162, provided for the annual publication of lists of patents issued; for proceedings before Congress for extensions, and for proceedings for the reissue of patents because of defect in original patent.

The act of 1832, ch. 302, extended privilege of alien patentees, and required the actual use of the invention in the United States within one year after the date of the patent.

The act of 1836 reconstructed the entire patent system, adding many new and valuable elements, and established the rights and obligations of inventors and patentees very nearly as they exist now. A sub-department of the State Department was created, known as the Patent Office, to which the powers and duties of the Secretary of State, in reference to patents, were transferred. The office of Commissioner of Patents was established; a seal of Office adopted. It provided for examination as to the novelty of inventions; that applicants should be notified of the result thereof, and for appeals from such findings; for proceedings when an application interfered with an existing patent; for re-issues; that a foreign patent to same applicant should not be a bar to one in the United States within six months after issue of former. It provided that applicant should make oath that he believed himself the first inventor; that invention was not before known or used by others, or in public use or on sale at time of application, and that he did not know of its prior use or knowledge. Also, that patents might be assigned, and for a record of assignments; that representatives of deceased inventors might take out patent in trust for heirs or devisee; also for caveats, and proceedings under same; and established a Patent Office Library.

The act of 1837 provided for the re-issue of several patents should different inventions be embraced in an original patent; that applications for re-issue or for an improvement to an existing patent should be subject to the same examination as original applications; for proceedings in disclaimer; that patent might issue to an assignee at request of, and on application by, inventor; that a patent was not invalid for what was properly claimed, by reason of excessive claim.

The act of 1839 provided that a foreign patent for the same invention within previous six months should not defeat an application, if there had been no public use in the United States; in such cases the United States patent was to run fourteen years from the date of the foreign patent; for bill in equity for a patent when application was refused by the Patent Office; for appeal from Commissioner to Chief Justice of the District Court of the District of Columbia.

The act of 1842 provided for the refund of fees paid by mistake; for the issue of patents for new designs for the term of seven years; for the marking of patented articles with the date of the patent, and prescribed a penalty for falsely marking unpatented articles, and for imitating the mark of a patentee.

The act of 1846 provided for the payment and deposit of funds for Patent Office.

The act of 1848 vested power in the Commissioner to extend patents; fixed fees for recording assignments, and provided for an increase in the clerical force of the office.

The act of 1849, chap. 108, provided for the removal of the Patent Office to the Interior Department, a division of which it has ever since remained.

The act of 1852 provided that appeals, when made to the Chief Justice of District Court of the United States for the District of Columbia, might be also taken to either of the Assistant Judges of the Circuit Court for said district, and fixed the compensation of such Judges.

The act of 1861, chap. 37, provided for writ of error or appeal in patent cases from Circuit Court to the Supreme Court, at the instance of either party.

The act of 1861, chap. 88, provided for proceedings in taking testimony for use in Patent Office; for the appointment of three examiners-in-chief "of legal knowledge and scientific ability," to review and revise decisions of examiners when necessary, etc.; also that, except in interference cases, no appeal to examiners-in-chief allowed until application had been twice rejected by a primary examiner upon the same state of facts; that Commissioner might require illegible applications, etc., to be printed; and that he might refuse to recognize any person as an attorney, subject to the approval of the President; for a revision of the fees payable with respect to applications, etc.; that inventors of new and useful designs might patent the same for three and a half, seven, or fourteen years, as they desired, and fixed the fees; that applications for patents were to be regarded as abandoned when they were not completed and prepared for examination within two years after filing, unless satisfactory cause was shown; fixed time of filing applications for extensions; provided that patented articles should be so marked, otherwise infringer would not be liable to pay damages unless he knew of his infringement; for printing and selling copies of patents; fixed term of new patents at seventeen years, and no extension of such patents.

The act of 1863 provided that every patent should be dated not later than six months after notice of its allowance to patentee or his agent; that if final fees were not paid within the six months, the invention to become public property.

The act of 1865 provided that when the final fee was not paid in due time, a new application might be filed at any time within two years from the date of the allowance of the original application.

The act of 1868 provided that the examiner-in-chief having the longest official experience should act as commissioner in case of the absence or the disability of the latter.

The act of 1870, as amended by act of 1871, chaps. 5 and 132, and the joint resolution of 1871, No. 5, is still in force, and forms part of the Revision of 1874 (Revised Statutes of the United States of America). The foregoing summary does not include acts whose sole purpose was the appointment of officials or the granting of appropriations.

PATENT LAWS OF THE UNITED STATES.

CONSTITUTION.

ART. 1, SEC. 8.

The Congress shall have power * * * * to promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries.

In the exercise of this power Congress is limited to authors and inventors only, see *Livingston v. Van Ingen*, 9, Johns, 507. The power is general to grant to inventors, and it rests in the sound discretion of Congress to say when and for what length of time, and under what circumstances the patent for an invention shall be granted. There is no restriction which limits the power of Congress to cases where the invention has not been known or used by the public. All that is required is that the patentee shall be the inventor. An act which gives a patent for an invention which was in public use and enjoyed by the community at the time of its passage, is not for that reason unconstitutional. *Blanchard v. Sprague*, 2 Story, 164; *Evans v. Jordan*, 1 Brock, 248; 9 Cranch, 199; *Jordan v. Dobson*, 4 Fish, 232. The power of Congress to legislate upon the subject of patents is plenary, by the terms of the constitution, and as there are no restraints on its exercise, there can be no limitation of their right to modify them at their pleasure, so that they do not take away the rights of property in existing patents, see 2 Robb, 105. Any State legislation which undertakes to limit or restrict in any manner the privileges which the letters patent confer is an invasion of national authority, and therefore void, see *Cranson v. Smith*, 37 Mich., 309; *People v. Russell*, 25 O. G. 504.

STATUTES.

ESTABLISHMENT OF THE PATENT OFFICE.

TITLE XI, Rev. Stat., p. 80:

SEC. 475. There shall be in the Department of the Interior an office known as the Patent Office, where all records, books, models, drawings, specifications, and other papers and things pertaining to patents shall be safely kept and preserved.

OFFICERS AND EMPLOYÉS.

SEC. 476. There shall be in the Patent Office a Commissioner of Patents, one Assistant Commissioner, and three examiners-in-chief, who shall be appointed by the President, by and with the advice and consent of the Senate. All other officers, clerks, and employés authorized by law for the Office shall be appointed by the Secretary of the Interior, upon the nomination of the Commissioner of Patents. [See § 169.]

SALARIES.

SEC. 477. The salaries of the officers mentioned in the preceding section shall be as follows:

The Commissioner of Patents, four thousand five hundred dollars a year.

The Assistant Commissioner of Patents, three thousand dollars a year.

Three examiners-in-chief, three thousand dollars a year each.

TITLE XI, Rev. Stat., p. 74:

SEC. 440. There shall also be in the Department of the Interior—

* * * * *

In the Patent Office:

One chief clerk, at a salary of two thousand five hundred dollars a year.

One examiner in charge of interferences, at a salary of two thousand five hundred dollars a year.

One examiner in charge of trade-marks, at a salary of two thousand five hundred dollars a year.

Twenty-four principal examiners, at a salary of two thousand five hundred dollars a year each.

Twenty-four first assistant examiners, at a salary of one thousand eight hundred dollars a year each.

Twenty-four second assistant examiners (two of whom may be women), at a salary of one thousand six hundred dollars a year each.

Twenty-four third assistant examiners, at a salary of one thousand four hundred dollars a year each.

One librarian, at a salary of two thousand dollars a year.

One machinist, at a salary of one thousand six hundred dollars a year.

Three skilled draughtsmen, at a salary of one thousand two hundred dollars a year each.

Thirty-five copyists of drawings, at a salary of one thousand dollars a year each.

One messenger and purchasing clerk, at a salary of one thousand dollars a year.

One skilled laborer, at a salary of one thousand two hundred dollars a year.

Eight attendants in the model-room, at a salary of one thousand dollars a year each.

Eight attendants in the model-room, at a salary of nine hundred dollars a year each.

ACT JUNE 19, 1878.

[*One financial clerk, two thousand dollars, who shall give bond in such amount as the Secretary of the Interior may determine.*]

ACT JUNE 7, 1884.

[*One law clerk, two thousand dollars.*]*

DUTIES OF SECRETARY.

SEC. 441. The Secretary of the Interior is charged with the supervision of public business relating to the following subjects:

* * * * *

Fifth. Patents for inventions.

An application for a *mandamus* to compel the issue of a patent must be directed against the Secretary of the Interior and not against the Commissioner of Patents, see *U. S. v. Marble*, 22 O. G. 1365. The decisions of the Commissioner of Patents while acting in a judicial capacity are not, however, subject to review by the Secretary of the

* For the number of officers and employes of the Patent Office, and respective salaries, at any given time, see the various appropriation acts.

Interior, see *Edison v. Edison*, 9 O. G. 408. If the Commissioner declines to issue a patent because there is no novelty in the claim, no appeal lies to the Secretary of the Interior, see *ex parte* Hunt, 13 O. G. 771. The power to supervise includes the power to direct, and is applicable to executive duties, see *Edison v. Edison*, 9 O. G. 408.

If the Commissioner neglects or refuses to perform any duty required by law to be performed by him, or performs a ministerial or administrative duty improperly, the Secretary of the Interior, by virtue of his supervisory power, may direct him in its performance, see *ex parte* Sargent, 12 O. G. 475.

TITLE XI, Rev. Stat., p. 80.

SEAL.

SEC. 478. The seal heretofore provided for the Patent Office shall be the seal of the office, with which letters patent and papers issued from the Office shall be authenticated.

BONDS OF COMMISSIONER AND CHIEF CLERK.

SEC. 479. The Commissioner of Patents and the chief clerk, before entering upon their duties, shall severally give bond, with sureties, to the Treasurer of the United States, the former in the sum of ten thousand dollars and the latter in the sum of five thousand dollars, conditioned for the faithful discharge of their respective duties, and that they shall render to the proper officers of the Treasury a true account of all money received by virtue of their offices.

RESTRICTIONS UPON OFFICERS AND EMPLOYÉS.

SEC. 480. All officers and employés of the Patent Office shall be incapable, during the period for which they hold their appointments, to acquire or take, directly or indirectly, except by inheritance or bequest, any right or interest in any patent issued by the Office.

If a person makes an invention before he becomes an employé he does not thereby forfeit or dedicate the invention to the public. He is simply prevented from taking a patent while he remains an employé, see *Page v. Holmes B. S. Tel. Co.*, 17 O. G. 737. A Commissioner, after his commission ceases, may take out a patent for an invention made by him while he was in office, and in a controversy with others the invention may be referred to the true date, see *Footé v. Frost*, 14 O. G. 860.

DUTIES OF COMMISSIONER.

SEC. 481. The Commissioner of Patents, under the direction of the Secretary of the Interior, shall superintend or perform all duties respecting the granting and issuing of patents directed by law; and he shall have charge of all books, records, papers, models, machines, and other things belonging to the Patent Office.

DUTIES OF EXAMINERS-IN-CHIEF.

SEC. 482. The examiners-in-chief shall be persons of competent legal knowledge and scientific ability, whose duty it shall be, on the written petition of the appellant, to revise and determine upon the validity of the adverse decisions of examiners upon applications for patents, and for re-issues of patents, and in interference cases; and, when required by the Commissioner, they shall hear and report upon claims for extensions, and perform such other like duties as he may assign them.

The decision of the examiners-in-chief must be limited to the questions presented to them by the appeal of the party who considers himself aggrieved, see *Brown v. La Dow*, 18 O. G. 1049.

ESTABLISHMENT OF REGULATIONS.

SEC. 483. The Commissioner of Patents, subject to the approval of the Secretary of the Interior, may from time to time establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent Office.

If a rule established by the Patent Office is within the powers of the office it is just as authoritative as an act of Congress itself, see *U. S. v. Marble*, 22 O. G. 1365.

If the rules do not permit the use of affidavits in a particular case the Commissioner may pass a special order allowing them, see *ex parte Rodgers*, 16 O. G. 1223.

ARRANGEMENT AND EXHIBITION OF MODELS, ETC.

SEC. 484. The Commissioner of Patents shall cause to be classified and arranged in suitable cases, in the rooms and galleries provided for that purpose, the models, specimens of composition, fabrics, manufactures, works of art, and designs, which have been or shall be deposited in the Patent Office; and the rooms and galleries shall be kept open during suitable hours for public inspection.

DISPOSALS OF MODELS ON REJECTED APPLICATIONS.

SEC. 485. The Commissioner of Patents may restore to the respective applicants such of the models belonging to rejected applications as he shall not think necessary to be preserved, or he may sell or otherwise dispose of them after the application has been finally rejected for one year, paying the proceeds into the Treasury, as other patent moneys are directed to be paid.

LIBRARY.

SEC. 486. There shall be purchased for the use of the Patent Office a library of such scientific works and periodicals, both foreign and American, as may aid the officers in the discharge of their duties, not exceeding the amount annually appropriated for that purpose.

PATENT AGENTS MAY BE REFUSED RECOGNITION.

SEC. 487. For gross misconduct the Commissioner of Patents may refuse to recognize any person as a patent agent, either generally or in any particular case; but the reasons for such refusal shall be duly recorded, and be subject to the approval of the Secretary of the Interior.

Rules of Practice, 1892,—7, 17, 18, 19, 20, 21, 22, 23, 152.

Any person of intelligence and good moral character may appear as the agent or the attorney in fact of an applicant, upon filing a proper power of attorney.

Before an attorney, original or associate, will be allowed to inspect papers or take action of any kind, his power of attorney must be filed. But general powers given by a principal to an associate cannot be considered. In each application the written authorization must be filed. A power of attorney purporting to have been given to a firm or copartnership will not be recognized, either in favor of the firm or of any of its members, unless all its members shall be named in such power of attorney.

Substitution or association can be made by an attorney upon the written authorization of his principal; but such authorization will not empower the second agent to appoint a third.

Powers of attorney may be revoked at any stage in the proceedings of a case upon application to and approval by the Commissioner.

A patent agent does not sustain the same relation to the Patent Office as an attorney sustains to a court. An attorney is a permanent officer of the court, retained by parties in particular cases; but a patent agent is not an officer of the Patent Office, he is connected with the Patent Office only by means of the particular cases in which he is employed, see *Hoosier Drill Co. v. Ingels*, 15 O. G. 1013.

The death of the inventor revokes the power of attorney given to an agent, see *Eagleton Mfg. Co. v. W. B. & C. Mfg. Co.*, 17 O. G. 1504.

Where an inventor sends a notice to the Patent Office that he has discharged an agent, that is sufficient so far as the Patent Office is concerned, but a discharge of an agent is not effective against a third party until notice thereof is communicated to him, see *Hoosier Drill Co. v. Ingels*, 15 O. G. 1013.

An attorney is allowed to retain possession of the letters patent until his fees are paid, see *ex parte Bowers*, 16 O. G. 1004.

PRINTING OF PAPERS FILED.

SEC. 488. The Commissioner of Patents may require all papers filed in the Patent Office, if not correctly, legibly, and clearly written, to be printed at the cost of the party filing them.

PRINTING COPIES OF CLAIMS, LAWS, DECISIONS, ETC.

SEC. 489. The Commissioner of Patents may print, or cause to be printed, copies of the claims of current issues, and copies of such laws, decisions, regulations, and circulars as may be necessary for the information of the public.

PRINTING SPECIFICATIONS AND DRAWINGS.

SEC. 490. The Commissioner of Patents is authorized to have printed, from time to time, for gratuitous distribution, not to exceed one hundred and fifty copies of the complete specifications and drawings of each patent hereafter issued, together with suitable indexes, one copy to be placed for free public inspection in each capitol of every State and Territory, one for the like purpose in the clerk's office of the district court of each judicial district of the United States, except when such offices are located in State or Territorial capitols, and one in the Library of Congress, which copies shall be certified under the hand of the Commissioner and seal of the Patent Office, and shall not be taken from the depositories for any other purpose than to be used as evidence. [See § 894.]

ADDITIONAL SPECIFICATIONS AND DRAWINGS.

SEC. 491. The Commissioner of Patents is authorized to have printed such additional numbers of copies of specifications and drawings, certified as provided in the preceding section, at a price not to exceed the contract price for such drawings, for sale, as may be warranted by the actual demand for the same; and he is also authorized to furnish a complete set of such specifications and drawings to any public library which will pay for binding the same into volumes to correspond with those in the Patent Office and for the transportation of the same, and which shall also provide for proper custody for the same, with convenient access for the public thereto, under such regulations as the Commissioner shall deem reasonable.

LITHOGRAPHING AND ENGRAVING.

SEC. 492. The lithographing and engraving required by the two preceding sections shall be awarded to the lowest and best bidders for the interests of the Government, due regard being paid to the execution of the work, after due advertising by the Congressional Printer under the direction of the Joint Committee on Printing; but the Joint Committee on Printing may empower the Congressional Printer to make immediate contracts for engraving, whenever, in their opinion, the exigencies of the public service will not justify waiting for advertisement and award; or if, in the judgment of the Joint Committee on Printing, the work can be performed under the direction of the Commissioner of Patents more advantageously than in the manner above prescribed, it shall be so done, under such limitations and conditions as the Joint Committee on Printing may from time to time prescribe.*

VOLUMES, ETC., TO BE FURNISHED DEPARTMENTS.

(Act of March 3, 1875.)

Sec. 12. That it shall be the duty of the Commissioner of Patents to furnish, free of cost, one copy of the bound volumes of specifications and drawings of patents published by the Patent Office, to each of the Executive Departments of Government, upon the request of the head thereof.

PRICE OF COPIES OF SPECIFICATIONS AND DRAWINGS.

SEC. 493. The price to be paid for uncertified printed copies of specifications and drawings of patents shall be determined by the Commissioner of Patents, within the limits of ten cents as the minimum and fifty cents as the maximum price.

ANNUAL REPORT OF THE COMMISSIONER.

SEC. 494. The Commissioner of Patents shall lay before Congress, in the month of January, annually, a report, giving a detailed statement of all moneys received for patents, for copies of records or drawings, or from any other source whatever; a detailed statement of all expenditures for contingent and miscellaneous expenses; a list of all patents which were granted during the preceding year; designating under proper heads the subjects of such patents; an alphabetical list of all the patentees, with their places of residence; a list of all patents which have been

*For the provisions relating to photolithographing, etc., at any given time, see the various appropriation acts.

In the act of February 26, 1889, chap. 279, U. S. Stat., XXV, p. 787, the following language appears:

* * * * * *

Said photolithographing, or otherwise producing plates and copies referred to in this and the preceding paragraph, to be done under the supervision of the Commissioner of Patents, and in the city of Washington, if it can be there done at reasonable rates; and the Commissioner of Patents, under the direction of the Secretary of the Interior, shall be authorized to make contracts therefor.

extended during the year; and such other information of the condition of the Patent Office as may be useful to Congress or the public. [See §§ 195, 196.]

CUSTODY OF COLLECTIONS OF EXPLORING EXPEDITION.

SEC. 495. The collections of the Exploring Expedition, now in the Patent Office shall be under the care and management of the Commissioner of Patents.

DISBURSEMENTS FOR PATENT OFFICE.

SEC. 496. All disbursements for the Patent Office shall be made by the disbursing clerk of the Interior Department.

JURISDICTION.

SEC. 629. The circuit courts shall have original jurisdiction as follows:

* * * * *

PATENT AND COPYRIGHT SUITS.

Ninth. Of all suits at law or in equity arising under the patent or copyright laws of the United States.

See also notes under Sec. 4919, *post*.

The Federal courts have exclusive jurisdiction over all cases arising under the patent laws, see *Willis v. McCollin*, 38 O. G. 1017, and without regard to the citizenship of the parties, see *Duke v. Graham*, 19 Fed. Rep. 647. The existence and validity of the monopoly, as claimed under the patent, are the only questions arising under the patent laws, see *Blakeney v. Goode*, 30 Ohio St. 350; *Celluloid Mfg. Co. v. Goodyear Dental Vulcanite Co.*, 10 O. G. 41. A question of contract concerning a patent-right or a patented invention is not a question under the patent laws, see *Ingalls v. Tice*, 14 Fed. Rep. 352.

APPELLATE JURISDICTION.

SEC. 690. The Supreme Court shall have appellate jurisdiction in the cases hereinafter specially provided for.

See also Section 4919, and notes, *post*.

The right of appeal or error, without regard to value, given by this section, in cases arising under the patent laws, applies to controversies between a patentee and alleged infringer, as well as to those between patentees, see *Philip v. Nock*, 13 Wall, 185; but does not apply to controversies arising upon enforcement of contracts relative to patents, see *Brown v. Shannon*, 20 How. 55. The Supreme Court has no original jurisdiction over questions of fact, such as infringements, etc., see *Wilson v. Barnum*, 8 How. 258.

* * * * *

WRITS OF ERROR AND APPEALS.

SEC. 699. A writ of error may be allowed to review any final judgment at law, and an appeal shall be allowed from any final decree in equity hereinafter mentioned, without regard to the sum or value in dispute.

PATENT AND COPYRIGHT CASES.

First. Any final judgment at law or final decree in equity of any circuit court, or of any district court acting as a circuit court, or of the supreme court of the District of Columbia, or of any Territory, in any case touching patents rights or copyrights

See also Section 4919, and notes, *post*.

The Supreme Court has no appellate jurisdiction of a suit to enforce the specific performance of a contract in relation to a patent unless the value of the matter in controversy exceeds the jurisdictional amount (\$2,000); although it may have and exercise jurisdiction when a far less amount is in dispute, if the suit touches the title, validity or infringement of a patent, see *Brown v. Shannon*, 20 How. 55.

EXCLUSIVE JURISDICTION OF COURTS OF UNITED STATES.

SEC. 711. The jurisdiction vested in the courts of the United States in the cases and proceedings hereinafter mentioned, shall be exclusive of the courts of the several States:

* * * * *

PATENT AND COPYRIGHT CASES.

Fifth. Of all cases arising under the patent-right or copyright laws of the United States.

See also notes under Section 4919, *post*.

The jurisdiction vested in the circuit courts is exclusive where the action touches the title, validity or infringement of a patent. A State court cannot entertain a bill in equity to enjoin an infringement, see *Dudley v. Mayhew*, 3 N. Y. 9; and has no jurisdiction over an action for an infringement of a patent, see *Parsons v. Barnard*, 7 Johns, 144; nor of an action brought by a patentee to restrain another from issuing circulars warning parties against purchasing a certain article, if the latter claims the right to do so under a patent, see *Hovey v. Rubber Tip Pencil Co.*, 33 N. Y. Sup. 522. If two patents have been issued to different parties, the State courts have no jurisdiction to settle their conflicting claims, or to enjoin the subsequent patentee at the instance of the prior patentee, see *Gibson v. Woodworth*, 8 Paige, 132. A State court has no jurisdiction over an action of assumpsit to recover upon a *quantum valebat* for the use of a patented invention, see *Batten v. Kear*, 2 Phila. 301; nor can it entertain a bill for discovery and an injunction against an execution issued upon a judgment for damages rendered in an action for the infringement of a patent, see *Kendall v. Winsor*, 6 R. I. 453. A State court has jurisdiction over an action to recover damages for fraud in the sale of a patent-right, see *Hunt v. Hoover*, 24 Iowa, 231; of an action by a manufacturer against a patentee, for falsely and intentionally advertising that his manufactures were an infringement of a patent, see *Snow v. Judson*, 33 Barb. 210; of an action for the breach of a warranty, see *Wright v. Wilson*, 11 Rich. 144; of an action to rescind a contract for the sale of a patent-right, on account of a fraud, see *Lindsay v. Roraback*, 4 Jones Eq. 124; of an action to recover damages for breach of an agreement, see *Billings v. Ames*, 32 Mo. 265, and in fact all actions based on contracts between the parties.

* * * * *

TITLE XIII, Rev. Stat., p. 169:

COPIES OF RECORDS, ETC., OF PATENT OFFICE.

SEC. 892. Written or printed copies of any records, books, papers, or drawings belonging to the Patent Office, and of letters patent authenticated by the seal and certified by the Commissioner or Acting Commissioner thereof, shall be evidence in all cases wherein the originals could be evidence; and any person making application therefor, and paying the fee required by law shall have certified copies thereof.

An exemplification of the patent and specification is admissible in evidence although the drawing is not exemplified, see *Peck v. Farrington*, 9 Wend. 44.

A certified copy of an assignment is *prima facie* evidence of the genuineness of the original; and is competent evidence, and absolute evidence of the correctness of the copies from the record, see *Lee v. Blandy*, 2 Fish. 89. A transcript of certain documents

on file in the Patent Office is competent evidence, although it does not purport to be a copy of the whole proceeding, see *Tookey v. Harding*, 1 Fed. Rep. 174. The proper evidence of a patent is a copy of the patent itself duly authenticated by the official seal and certificate of the Commissioner, see *Davis v. Gray*, 17 Ohio St. 380. Certified copies of the assignments of a patent are not evidence that there is no other title of record, see *Am. D. R. B. Co. v. Sheldon*, 17 Blatch., 208.

COPIES OF FOREIGN LETTERS PATENT.

SEC. 893. Copies of the specifications and drawings of foreign letters patent certified as provided in the preceding section, shall be *prima facie* evidence of the fact of the granting of such letters patent, and of the date and contents thereof.

If a foreign patent is certified by the officer of the foreign patent office that corresponds to the Commissioner of Patents, it is admissible in evidence, see *Schoerken v. S. & C. & B. Mfg. Co.*, 19 O. G. 1493.

A certificate of the Commissioner of the correctness of a translation of a foreign patent contained in a volume in the library of the Patent Office is not competent evidence, see *Gaylor v. Case*, 1 C. L. B. 382.

PRINTED COPIES OF SPECIFICATIONS AND DRAWINGS OF PATENTS.

SEC. 894. The printed copies of specifications and drawings of patents, which the Commissioner of Patents is authorized to print for gratuitous distribution, and to deposit in the capitols of the States and Territories, and in the clerk's offices of the district courts, shall, when certified by him and authenticated by the seal of his office, be received in all courts as evidence of all matters therein contained. [See § 490.]

COSTS NOT RECOVERABLE IN CERTAIN SUITS FOR INFRINGEMENT OF PATENT UNLESS DISCLAIMER ENTERED, ETC.

SEC. 973. When judgment or decree is rendered for the plaintiff or complainant, in any suit at law or in equity, for the infringement of a part of a patent, in which it appears that the patentee, in his specification, claimed to be the original and first inventor or discoverer of any material or substantial part of the thing patented, of which he was not the original and first inventor, no costs shall be recovered, unless the proper disclaimer, as provided by the patent laws, has been entered at the Patent Office before the suit was brought.

If the plaintiff on trial abandons one claim, he cannot recover costs, see *Procter v. Brill*, 16 Fed. Rep. 971. If a patentee files a disclaimer as to one division of a re-issue, and the validity of the other division is sustained, he is entitled to recover costs, see *Elastic Fabric Co. v. Smith*, 100 U. S. 110. If a disclaimer is not filed until after the commencement of a suit, he cannot recover costs, see *Burdett v. Estey*, 16 Blatch. 105.

PATENTED ARTICLES CONNECTED WITH MARINE ENGINES.

SEC. 1537. No patented article connected with marine engines shall hereafter be purchased or used in connection with any steam vessels of war until the same shall have been submitted to a competent board of naval engineers, and recommended by such board, in writing, for purchase and use.

TITLE XVII, Rev. Stat., p. 292:

NO ROYALTY TO BE PAID BY UNITED STATES TO ITS OFFICERS FOR
PATENT MENTIONED IN PRECEDING SECTION.

SEC. 1673. No royalty shall be paid by the United States to any one of its officers or employes for the use of any patent for the system, or any part thereof, mentioned in the preceding section, nor for any such patent in which said officers or employes may be directly or indirectly interested.

PATENTS.

PATENTS, HOW ISSUED, ATTESTED AND RECORDED.

TITLE LX, Rev. Stat., chap. 1, p. 945:

SEC. 4883. All patents shall be issued in the name of the United States of America, under the seal of the Patent Office, and shall be signed by the Secretary of the Interior and countersigned by the Commissioner of Patents, and they shall be recorded, together with the specifications, in the Patent Office, in books to be kept for that purpose.

ACT FEB. 18, 1888. U. S. STAT., XXV, P. 40.

CHAP. 15.—An act to amend section four thousand eight hundred and eighty-three of the Revised Statutes to enable the Assistant Secretary of the Interior to sign patents.

SIGNING PATENTS. R. S., s. 4883, P. 945, AMENDED.

Be it enacted, etc., That section four thousand eight hundred and eighty-three of the Revised Statutes is hereby amended by inserting after the words "Secretary of the Interior" where they occur therein, the following words: "or under his direction by one of the Assistant Secretaries of the Interior;" so that the said section as amended will read as follows:

ASSISTANT SECRETARIES OF THE INTERIOR MAY SIGN PATENTS.

"Sec. 4883. All patents shall be issued in the name of the United States of America, under the seal of the Patent Office, and shall be signed by the Secretary of the Interior or under his direction by one of the Assistant Secretaries of the Interior, and countersigned by the Commissioner of Patents, and they shall be recorded, together with the specifications, in the Patent Office, in books to be kept for that purpose."

Approved, February 18, 1888.

ACT APRIL 19, 1888. U. S. STAT. XXV., P. 87.

CHAP. 126.—An act to give validity to certain patents for inventions which were irregularly executed.

PATENTS.

SIGNATURE OF ASSISTANT SECRETARY OF THE INTERIOR VALID TO
CERTAIN PATENTS.

Be it enacted, etc., That all patents for inventions signed by David L. Hawkins, Second Assistant Secretary of the Interior, or any other Assistant Secretary of the Interior, shall have the same force, effect,

and validity as though the same had been signed by the Secretary of the Interior in person at the date on which they were respectively executed.

Approved, April 19, 1888.

Rules of Practice, 1892.—134, 165, 166, 221, 222, 14, 220.

If a patent is issued without the signature of the Secretary or of an Assistant Secretary of the Interior, it is void, and a subsequent signing will not make it valid as of the date when it was issued, see *Marsh v. Nichols*, 24 O. G. 901.

The records of the Patent Office are open to inspection; persons will not, however, be allowed to make copies or tracings from the files or records of the office. Such copies or tracings will be furnished by the office upon payment of the usual fees therefor.

CONTENTS AND DURATION.

SEC. 4884. Every patent shall contain a short title or description of the invention or discovery, correctly indicating its nature and design, and a grant to the patentee, his heirs or assigns, for the term of seventeen years, of the exclusive right to make, use, and vend the invention or discovery throughout the United States and the Territories thereof, referring to the specification for the particulars thereof. A copy of the specification and drawings shall be annexed to the patent and be a part thereof.

Rules of Practice, 1892.—168.

A patent takes effect from the date of its grant, and under the present law it cannot be antedated, see *Gramme Electrical Co. v. Arnoux & Hochhausen Electric Co.*, 25 O. G. 193. The term of a patent is measured by the statute, not by the language of the grant, however, see *De Florez v. Reynolds*, 17 O. G. 503; and where an invention has been previously patented in a foreign country, its term will be affected by the term of such prior foreign patent, if same should be less than seventeen years (See Rev. Stat. 4887 and notes. *post*), otherwise the term is uniformly fixed at seventeen years. The term of a patent cannot now be extended except by special act of Congress. (See Rev. Stat. secs. 4924-4928, *post*, as to extension of patents granted prior to March 2, 1861.)

DATE OF PATENT.

SEC. 4885. Every patent shall 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.

Rules of Practice, 1892.—164, 165, 166, 167, 222.

The weekly issue closes on Thursday, and the patents of that issue bear date as of the third Tuesday thereafter, the intervening time being consumed in preparing, printing, signing and sealing the patents, printing the copies, and preparing and printing the Official Gazette. If the final fee in any application is not paid on or before Thursday, the patent will not go to issue until the following week. If a patent is withheld because of failure to pay the final fee, the application for patent may be renewed, provided that such second application be filed within two years after the allowance of the original application. See Rev. Stat., sec. 4897, *post*.

WHO MAY BE PATENTEE: WHAT INVENTIONS ARE PATENTABLE.

SEC. 4886. Any person who has invented or discovered any new and useful art, machine, manufacture or composition of matter, or any new and useful improvement thereof, not known or used by others in this country, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof, and not in public use or on sale for more than two years prior to his application, unless the same is proved to have been abandoned, may upon payment of the fees required by law, and other due proceedings had, obtain a patent therefor.

ACT OF MARCH 3, 1883, c. 143.

The Secretary of the Interior and the Commissioner of Patents are authorized to grant any officer of the Government, except officers and employes of the Patent Office, a patent for any invention of the classes mentioned in section forty-eight hundred and eighty-six of the Revised Statutes when such invention is used or to be used in the public service, without the payment of any fee: Provided, That the applicant in his application shall state that the invention described therein, if patented, may be used by the Government, or any of its officers or employes in prosecution of work for the Government, or by any other person in the United States, without the payment to him of any royalty thereon, which stipulation shall be included in the patent.

Rules of Practice, 1892.—24, 25, 26, 27, 28, 29, 30, 31, 32, 33, 40, 46.

AS TO APPLICANT.—TRUE AND FIRST INVENTOR.—The law places no restriction whatever as to citizenship or nationality, age or sex. The applicant must, however, be the original and first inventor, or the executor or administrator of a deceased inventor.

No person who is not at once the first as well as the original inventor by whom the invention has been perfected and put into actual use, is entitled to a patent. A subsequent inventor, although an original inventor, is not entitled to any patent, see *Spring v. Packard*, 7 O. G. 341; *Burrows v. Lehigh Zinc Co.* 1 Bann. & A., 521; *Reed v. Cutter*, 1 Story, 590; *Sayles v. Hapgood*, 3 Fish., 632; *Pickering v. McCullough*, 21 O. G. 73; *Roemer v. Simon*, 12 O. G. 796.

According to the Constitution, Congress has no power to grant a patent to anyone but an inventor, and to him only for his own invention, see *Robinson on Patents*, § 67. The term "original inventor" is sometimes used by the courts as synonymous with "first inventor," see *Osborne v. Winkley*, 2 Gallison 51; 1 Robb, 52; *Thomas v. Weeks*, 2 Paine, 92. In other cases the judges make a distinction between the "original" and "first" inventor, giving the former title to every true inventor, and the latter only to the foremost among true inventors, see *Lowell v. Lewis*, 1 Mason, 183; 1 Robb, 181; *Bedford v. Hunt*, 1 Mason, 302; 1 Robb, 148; *Pennock v. Dialogue*, 2 Peters, 1; *Reed v. Cutter*, 1 Story, 590; 2 Robb, 81; *Roemer v. Simm*, 5 O. G. 555. In *Pennock v. Dialogue*, 2 Peters 1, Story, J., says: "It gives the right to the first and true inventor, and to him only; if known or used before his supposed discovery, he is not the first, although he may be a true inventor." In *Reed v. Cutter*, 1 Story, 590, Story, J., says: "He is the first inventor in the sense of the Act, and entitled to a patent for his invention, who has first perfected and adapted the same to use; and until the invention is so perfected and adapted to use, it is not patentable."

Any person, except a slave, or a Patent Office employee, may become a patentee. An alien stands on the same footing with a citizen before the Patent Law, see *Thomas v. Reese*, 17 O. G. 195; *ex parte Nagel*, 17 O. G. 198; *Lander v. Crowell*, 16 O. G. 405; *Shaw v. Cooper*, 7 Peters, 292; 1 Robb, 643. A married woman may be the grantee of a patent, the rights of her husband in the patent being regulated by local law, see *Fetter v. Newhall*, 17 Fed. Rep. 841; 21 Blatch. 445; 25 O. G. 502. An infant or ward may also be the owner of a patent, see *Fetter v. Newhall*, 17 Fed. Rep. 841; 21 Blatch. 445; 25 O. G. 502. An invention by a slave can be patented neither by him nor his master, see *Opinion Atty. Gen.* 9, *Op. At. Gen.* 171, and an employee of the Patent Office may not obtain a patent during the term of his employment, see *Rev. Stat.* 1874, § 480; act of 1836, § 2; see also *Opinion of Commissioner*, 26 O. G. 637; *Page v. Holmes Burglar Alarm Tel. Co.*, 17 Blatch. 484; 17 O. G. 737.

AS TO JOINT INVENTORS.—A joint patent should always be issued for a joint invention, see *Thomas v. Weeks*, 2 Paine, 92; *Barrett v. Hall*, 1 Mason, 447; 1 Robb, 207. Neither one of two joint inventors can claim a patent to himself alone, see *Runstatler v. Atkinson*, 23 O. G. 940. A patent for a joint invention cannot issue to one of the inventors, though the other has assigned all interests to him, see *Opinion Atty. Gen.*, 2 *Op. At. Gen.* 571. A joint patent for a sole invention is void, see *Stewart v. Teak*, 41 O. G. 1502; *Royer v. Coupe*, 29 Fed. Rep. 358; 39 O. G. 289; *Ransom v. Mayor of New York*, 1 Fisher, 252; and a sole patent for a joint invention is also void, see *Carter v. Perry*, 8 O. G. 518; *Tennant's Case*, *Dav. P. C.* 429; 1 Web, 125; 1 Abb. P. C. 115; *Siemmer's Appeal*, 58 Pa. St. 155.

AS TO APPLICATION BY EXECUTOR OR ADMINISTRATOR.—The right of an inventor to a patent vests in him at the moment he completes his invention. His right descends to his heirs, and a patent will issue to his personal representatives in trust for them, see *Wilson v. Rousseau*, 4 How, 646. If the inventor dies before applying for a patent, his executor or administrator should apply; and if he dies after application, the patent should issue to his executor or administrator, see *Rice v. Burt*, 16 O. G. 1050.

In case of a deceased foreign inventor, ancillary letters of administration must be taken out in the name of a resident of the United States, and the application be made by him.

AS TO ASSIGNEES.—The right of an inventor to obtain a patent is an inchoate right which may be assigned, see *U. S. Stamping Co. v. Jewett*, 7 Fed. Rep. 869; 18 O. G. 1529; *Cammeyer v. Newton*, 94 U. S. 225; 11 O. G. 287; *Selden v. Stockwell Self-Lighting Gas Burner Co.*, 9 Fed. Rep., 390. The patent cannot issue to assignee unless the assignment contains a request to that effect, and is duly entered for record, see *Wright v. Randell*, 21 O. G. 493; 19 Blatch. 495. A patent may also issue to the assignee of an assignee, see *Consolidated Electric Light Co. v. Edison Electric Light Co.*, 25 Fed. Rep. 719; 33 O. G. 1597. It should be observed, however, that the assignee cannot make an application for patent directly in his own name. In all cases, the application papers must be signed by the inventor, if he be alive; if he be dead, then by his executor or administrator, see Rev. Stat., secs. 4888 to 4892. *post*.

AS TO IMPORTERS.—In *Livingston v. Van Ingen*, 9 Johns, 507, Kent, C. J., said: "It seems to be admitted that Congress are authorized to grant patents only to the inventor of the useful art * * * There cannot, then, be any aid or encouragement, by means of an exclusive right under the law of the United States, to importers from abroad of any useful invention or improvement." So also in *Pitts v. Hall*, 2 Blatch. 229, Nelson, J., said: "A person, to be entitled to the character of an inventor, within the meaning of the Act of Congress, must himself have conceived the idea embraced in his improvement. It must be the product of his own mind and genius, and not of another's." See also *Washburn v. Gould*, 3 Story, 122; 2 Robb, 206; *Sparkman v. Higgins*, 1 Blatch., 205. A patentee must be an inventor, not an importer, see *Thompson v. Haight*, 1 U. S. L. T. 582.

AS TO PATENTABILITY.—AN INVENTION MUST HAVE BEEN MADE.—The application must describe a complete, operative and actual invention. To be patentable, a thing must not only be new and useful, but must amount to an invention or discovery, see *May v. County of Fond du Lac*, 27 Fed. Rep. 691. In *Rosenwasser v. Berry*, 22 Fed. Rep. 841, Colt, J., said: "Not every improvement is invention; but to entitle a thing to protection it must be the product of some exercise of the inventive faculties, and it must involve something more than what is obvious to persons skilled in the art to which it relates." The exercise of inventive as distinguished from mechanical skill is essential to constitute an inventive act, see *Leonard v. Lovell*, 29 Fed. Rep. 310; *Celluloid Mfg. Co. v. Comstock & Cheney Co.*, 27 Fed. Rep. 358; 36 O. G. 1356. In *Earle v. Sawyer*, 4 Mason, 1, Story, J., said: "The thing to be patented is not a mere elementary principle or intellectual discovery, but a principle put in practice and applied to some art, machine, manufacture, or composition of matter. It must be *new* and not *known* or *used* before the application; that is, the party must have found out, created, or constructed some art, machine, etc., * * * which had not been previously found out, created, or constructed by any other person. It is of no consequence whether the thing be simple or complicated; whether it be by accident, or by long, laborious thought, or by an instantaneous flash of the mind, that it is first done. The law looks to the fact and not to the process by which it is accomplished. It gives the first inventor or discoverer of the thing, the exclusive right, and asks nothing as to the mode or extent of the application of his genius to conceive or execute it." 1 Robb, 490. An invention is complete when the thought is embodied in some practical and operative form, see *Sawyer v. Edison*, 25 O. G. 597.

AS TO PATENTABILITY.—THE INVENTION MUST BE REDUCED TO PRACTICE.—That reduction to practice is essential to the completion of an invention, see *Judson v. Bradford*, 16 O. G. 171; *Burke v. Partridge*, 58 N. H. 349; *Graham v. Gammon*, 7 Bissell, 490; 3 Bann & A. 7; *Smith v. Prior*, 2 Sawyer, 461; *Jones v. Sewall*, 8 O. G. 630; *Webb v. Quintard*, 1 O. G. 525. In *White v. Allen*, 2 Clifford, 224, Clifford, J., said: "While the suggested improvements, however, rest merely in the mind of the originator of the idea, the invention is not completed within the meaning of the patent law, nor are crude and imperfect experiments sufficient to confer a right to a patent; but in order to constitute an invention, in the sense in which that word is employed in the Patent Act, the party alleged to have produced it, must have proceeded so far as to

have reduced his idea to practice, and embodied it in some distinct form." See also *Gaylor v. Wilder*, 10 How, 498; *Parkhurst v. Kinsman*, 1 Blatch. 494; *Curtis on Patents*, § 43. In 11 Am. Law Reg. N. S. 612, 665, an able writer, after discussing the cases on the subject, says: "Before an invention can be considered as having been so reduced to practice as to give its author, without further effort on his part, an irrefragable title to it, if duly asserted, it must have been embodied in a practical working machine, capable of being operated to perform its intended functions for business purposes. If not capable of such embodiment, it must have been brought to an equivalent state of perfection in some other way. Upon this point there is no conflict in our judicial tribunals."

AS TO PATENTABILITY.—NOVELTY.—The applicant for patent must be the original inventor, not only in relation to the United States, but to other parts of the world, see *Dawson v. Follen*, 2 Wash. 311, and this is so even although he had no knowledge of the previous use or previous description, see *Whitney v. Emmett*, Baldwin 303; 1 Robb. 567. Formerly the novelty required was absolute both as to time and place. The act of 1790 limited the privilege to inventions "not before known or used;" the act of 1800 expressly excluded every invention previously known and used in this or any foreign country. In the revision of the law and the reconstruction of the patent system in 1836, however, knowledge and use in a foreign country was excluded from among the causes which prevent or defeat a patent. The restriction as to time has been more widely modified. The act of 1793 substituted for the phrase "not before known and used" as it occurred in the act of 1790, the words "not known or used before the application," and in construing the law our courts soon held that "before the application" was to be regarded as synonymous with "before discovery by the patentee," thus recognizing no use or knowledge as anticipating the invention unless it had preceded the inventive act. This construction was accepted by Congress, and was, in the act of 1836, duly formulated as one of the provisions of that statute. According to our present law, therefore, novelty exists unless the knowledge or use of the invention in this country preceded the conception of the invention by the patentee.

AS TO PATENTABILITY.—UTILITY.—The law requires that the invention must be new; it must also be useful. However new an invention may be, it cannot be legally patented unless it is also useful; and however useful it may be, it cannot be legally patented unless it is new. If it is either not new or not useful, the patent is void. *Matthews v. Skates*, 1 Fish., 602; *Clark Patent Co. v. Copeland*, 2 Fish, 221; *Eddy v. Dennis*, 95 U. S., 560; *Jones v. McMurray*, 13 O. G. 6; *Barker v. Stowe*, 14 O. G. 559; *Snow v. Taylor*, 14 O. G. 861; *Singer R. C. Co. v. Tobey F. Co.*, 23 O. G. 93. The ground on which a patent may be claimed is that something new and useful has been invented—a thing which did not exist before, see *Hotchkiss v. Greenwood*, 4 McLean, 456. The law does not look to the degree of utility. It simply requires that the invention shall be capable of use, and that the use be such as sound morals and policy do not discountenance, see *Dunbar v. Marden*, 13 N. H., 311. The invention must be useful to an appreciable extent, although the measure of that usefulness is not material. Any degree of utility appreciable by a jury is sufficient, see *Conover v. Roach*, 4 Fish, 12.

AS TO PATENTABILITY.—PRIOR KNOWLEDGE OR USE.—The prior knowledge or use, to defeat novelty, must be practical and complete; the identical invention must have been in use in this country, or it must have been patented or described in a printed publication at home or abroad before the other was invented. In *Stitt v. Eastern R. R. Co.*, 22 Fed. Rep. 649, *Colt, J.*, said: "The primary inquiry is one of identity between two things. If the identity is apparent on inspection, it is not necessary to prove actual use. If there is a reasonable doubt as to identity, want of novelty is not made out, see *Walker on Pat.*, § 72. By the weight of authority and of reason, it would seem that if the prior invention is the same as that described in the patent; if it was complete and capable of producing the same result, and was known in this country, it is sufficient to sustain the defence of want of novelty."

AS TO PATENTABILITY.—PRIOR PATENTS.—A prior patent in order to defeat a subsequent application must be (*Robinson on Patents* § 331): (1) A public document; (2) accessible to the public; (3) issued for the same invention; (4) for the same operative means; and (5) sufficient to place the idea of the inventor fully in the possession of the public. A prior patent defeats a patent for an invention subsequently made, see *Kelleher v. Darling*, 14 O. G. 673; *Muntz v. Foster*, 2 Webb, 96. A prior patent and a prior publication stand on the same ground, see *Webb v. Quintard*, 1 O. G. 525. Description in a prior specification, the patent not having been issued, is no bar, see *Graham v. McCormick*, 21 O. G. 1533, and this is true though the prior specifications were filed by the same inventor, see *Graham v. McCormick*, 21 O. G. 1533.

The word "patented" in Sec. 4886 means "made known," and this is not true of a British patent until the completed specification is filed, see *Rumpf v. Köhler*, 23 O. G. 1831. It has also been held that a provisional specification in England is not a publication until published, and not then unless it completely describes the invention, see *Coburn v. Schroeder*, 22 O. G. 419; that a patent, though issued, is no bar while kept secret, see *Schoercken v. Swift & Courtney & Beccher Mfg. Co.*, 19 O. G. 1493; that a foreign patent takes effect as such only from the period of its enrollment, see *Willimantic Linen Co. v. Clark Thread Co.*, 4 Bann. & A., 133; that the date of the invention described in the prior patent is the date of the patent, see *Rumpf v. Köhler*, 23 O. G. 1831; *ex parte Lanfrey*, 20 O. G. 892; that unless the date of the reduction to practice of the later invention precedes the date of the publication of the alleged prior patent, such patent will be a bar, see *Byerly v. Cleveland Linseed Oil Works*, 31 Fed. Rep. 73; that a prior patent, issued by the United States, does not defeat a patent the application for which was filed before the filing of the application for such prior patent, see *Allen v. City of New York*, 17 O. G. 1281; that the prior patent must be for the same invention, see *Cohn v. U. S. Corset Co.*, 6 O. G. 259; that the prior patent must cover the whole of the invention, not merely a part of it, see *Frearson v. Lee*, L. R. 9 Ch. 48 (but see *Florsheim v. Schilling*, 35 O. G. 1435); that a prior patent for a device does not defeat a patent for a combination of which such device forms one element, see *McMillan v. Rees*, 17 O. G. 1222; that a patent suggesting a result is no bar to a patent for the means by which the result is produced, see *Graham v. Gammon*, 3 Bann. & A., 7; that a prior patent for one means of producing a result does not defeat a patent for a different means of producing the same result, see *Hallett v. Hague*, 2 Bann. & A., 370; that the invention described in the patent must be complete and practical, see *Downton v. Gaeger Milling Co.*, 17 O. G. 906; that the prior patent must contain a full and precise description of the entire invention, see *Hammerschag v. Scamoni*, 20 O. G. 1449; that if a prior foreign patent so far suggests the invention that any skilled workman could make it, the anticipation is established, see *United States Bung Mfg. Co. v. Independent Bung & Bushing Co.*, 31 Fed. Rep. 76; and that a prior foreign patent to the same inventor is not a bar unless there has been two years' public use in this country, see *Vogeley v. Noel*, 18 Fed. Rep. 327.

AS TO PATENTABILITY.—PRIOR PUBLICATION.—In order that a prior publication may defeat a subsequent application it must be (see *Robinson on Patents* § 325): (1) A work of public character, intended for general use; (2) within reach of the public; (3) published before the date of the later invention; (4) a description of the same complete and operative art or instrument; and (5) so precise and particular that any person skilled in the art to which the invention belongs can construct and operate it without experiments and without further exercise of inventive skill. It has been held: that a written but unprinted description is not a publication, see *Northwestern Fire Extinguisher Co. v. Philadelphia Fire Extinguisher Co.*, 6 O. G. 34; that a picture or drawing without printed text is not a publication, see *New Process Ferm. Co. v. Koch*, 29 O. G. 535; that business circulars which are sent only to persons engaged or supposed to be engaged in the trade, are not such publications as contemplated by Sec. 4886, see *Pierson v. Colgate*, 24 O. G. 203; *in re Atterbury*, 2 O. G. 640; that a catalogue showing features of the invention is not a publication, see *Forschner v. Baumgarten*, 35 O. G. 137; that a journal devoted to a special science, printed in German and deposited in the library of the Patent Office, and in the library of the Institute of Civil Engineers—a society of 3,000 members—and there accessible to them, and catalogued under the head of "Journals" only, though proved to have been read by but one person, is a sufficient publication, see *United Telephone Co. v. Harrison, Cox-Walker & Co.*, L. R. 21 Ch. 720. That a description in an application for a patent, filed in the Patent Office, is not a publication, *Northwestern Fire Ex. Co. v. Philadelphia Fire Ex. Co.*, 6 O. G. 34; that a printed English provisional specification is a publication when once published, see *Cohn v. U. S. Corset Co.*, 6 O. G. 259; but not unless full and specific, see *Goff v. Stafford*, 14 O. G. 748; that an English specification is not a publication till completed and published, see *Coburn v. Schroeder*, 22 O. G. 419. Something beside printing is required. Publication means put into general circulation or on sale where the work is accessible to the public, see *Cottier v. Stinson*, 10 Sawyer 212, 20 Fed. Rep. 906.

AS TO PATENTABILITY.—PUBLIC USE OR SALE.—The act permits public use and sale of the invention for two years before the application. Abandonment is conclusively presumed against the inventor from the public use or sale of the invention with his consent for more than two years before his application for a patent, see *Andrews v. Hovey*, 41 O. G. 1162; *Adams & Westlake Mfg. Co. v. Rathbone*, 26 Fed. Rep. 262; *Manning v. Cape Ann Isinglass & Glue Co.*, 4 Bann. & A., 612. Public use or sale of the invention in a foreign country is no bar to a patent. It is not necessary that the use

should have been a continuous use, extending over more than two years prior to the application, to render a patent void; it is sufficient if it be a public use or sale, see *Young v. Hoard*, 2 Com. Dec. 59; *ex parte Jenkins*, 4 O. G. 351. If the inventor held the article for sale more than two years before the application, he is not entitled to a patent, although he did not make a shipment until after that time, *Hubbard v. Myers*, 16 O. G. 1051.

AS TO PATENTABILITY.—ABANDONMENT.—An invention once abandoned to the public can never be recalled by the inventor, see *Consolidated Fruit Jar Co. v. Bellaire Stamping Co.*, 35 O. G. 627; *American Hide and Leather Splitting & Dressing Mach. Co. v. Am. Tool & Mach. Co.*, 4 Fisher, 284. The intention to abandon need not be expressed in words, see *Planing Machine Co. v. Keith*, 17 O. G. 1031. Abandonment is a question of fact, not of law, see *Sprague v. Adriance*, 14 O. G. 308; and of intention, see *Johnson v. Fassman*, 2 O. G. 941. A jury has a right to infer an abandonment from the inventor's acquiescence in the use of the invention by others, his neglect to assert his claims by suit or otherwise, his neglect to make efforts to realize any personal advantage, and similar circumstances.

AS TO PATENTABILITY.—SUGGESTION.—Although the ideas of the invention and hints concerning it came to the inventor from others, still, if the suggestions simply aided him, and he was the first who gave that idea a useful and practical form, his rights are not to be defeated, see *Teese v. Phelps*, 1 McAl., 48; *Matthews v. Skates*, 1 Fish, 602; *Roberts v. Dickey*, 1 O. G. 4. If, however, the whole or any of the essential parts and principles of the machine are invented by another and introduced into the machine upon his suggestion, the whole patent is void, see *Watson v. Bladen*, 4 Wash., C. C. 580; *Agawam Co. v. Jordan*, 7 Wall, 583. Where, however, an employer has conceived the plan of an invention, and is engaged in experiments to perfect it, no suggestions from an employee, not amounting to a new method or arrangement, which is in itself a complete invention, is sufficient to deprive the employer of the exclusive property in the perfected improvement, see *Agawam Co. v. Jordan*, 7 Wall, 583, 9 O. G. 1011.

PATENTS FOR INVENTIONS PREVIOUSLY PATENTED ABROAD.

SEC. 4887.—No person shall be debarred from receiving a patent for his invention or discovery, nor shall any patent be declared invalid, by reason of its having been first patented or caused to be patented in a foreign country, unless the same has been introduced into public use in the United States for more than two years prior to the application. But 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, and in no case shall it be in force more than seventeen years.

Rules of Practice, 1892.—29, 46.

The provisions of this section relate to patents which are applied for here after the issue of a foreign patent or patents upon the same invention, see *French v. Rogers*, 1 Fish, 133. An applicant in possession of an invention that is otherwise patentable, who has already patented in a foreign country, may still obtain a perfectly valid patent in the United States, and at any time after the issue of his prior foreign patent or patents, provided: first, that the invention at the date upon which he files his application in this country has not been in public use or on sale in the United States for more than two years; and, second, that no prior foreign patent for the same invention has expired or become forfeited.

Although the application was filed (in the United States) before the filing of the application for the foreign patent, yet if the foreign patent is granted first, the United States patent must be limited so as to expire with the foreign patent, see *Bate Refrig. Co. v. Gillett*, 22 O. G. 1205, and this is so even if the patent is not so limited on its face, for the statute, not the language of the patent, limits its term, see *De Florez v. Reynolds*, 17 O. G. 503.

An American patent must be limited so as to expire at the same time as a prior foreign patent, whether the foreign patent is a secret or a public patent, see *Gramme*

Elect. Co. v. Arnoux & H. Elect. Co., 25 O. G. 193. In no case, however, can the American patent exceed the term of seventeen years, see *Weston v. White*, 13 Blatch. 364; *Siemens v. Sellers*, 23 O. G. 2234.

If a person surreptitiously, without the knowledge or authority of the inventor, takes out letters patent in a foreign country, he cannot thereby deprive the inventor of any of his rights, see *Kendrick v. Emmon*, 9 O. G. 201.

Sec. 4887 does not require that the term of a patent shall be correctly stated in the patent itself, but only limits the term, and the grant of a patent for seventeen years, therefore, does not prevent it from expiring with a prior foreign patent, see *Cavan v. Pound Mfg. Co.*, 31 O. G. 119. A domestic patent is valid, though its term is not expressly limited to that of a foreign patent, see *American Paper Barrel Co. v. Laraway*, 37 O. G. 674.

An American patent expires at the same date with the shortest foreign patent that was granted before the grant of the American patent, see *Gramme Elect. Co. v. Arnoux & H. Elect. Co.*, 25 O. G. 193; *Koechlin v. Marble*, 22 O. G. 1365; *Henry v. Providence Tool Co.*, 14 O. G. 855. The same rule applies when a single American patent covers several inventions separately patented abroad, see *ex parte Unsworth*, 15 O. G. 982; but an American patent is not limited by the term of a foreign patent unless the inventions are identical, see *Siemens v. Sellers*, 23 O. G. 2234; nor unless the foreign patent claims as well as describes the same invention, see *Holmes Elect. Protective Co. v. Metropolitan Burglar Alarm Co.*, 32 O. G. 984. The invention covered by a domestic patent will be the same as that covered by a foreign patent when the principle is the same, though it may be improved, and in this case the term of the whole patent is that of the foreign patent, see *Guarantee Insurance Trust & Safe Deposit Co. v. Sellers*, 41 O. G. 1165. It has also been held that a patent that is a mere adaptation of a foreign patent expires at the same time though some improvement be embraced in it, see *Clark v. Wilson*, 36 O. G. 456; and in *Commercial Mfg. Co. v. Fairbank Canning Co.*, 36 O. G. 1473, that if the foreign invention would be enjoined as an infringement of the domestic patent it is the same.

The date of a foreign patent when controlling the term of an American patent, is the date of its issue or publication as a patent, see *De Florez v. Reynolds*, 17 O. G. 503; and in this connection it has been held: that an English provisional specification is not a patent, see *Emerson v. Lippert*, 42 O. G. 964; that no English patent is complete until the final specification is enrolled, see *Coburn v. Schroeder*, 23 O. G. 419; that a domestic patent is not limited by an English patent unless the latter is sealed before the former is issued, whatever date the latter may bear, or unless a complete specification having the effect of a patent is filed, see *Emerson v. Lippert*, 42 O. G. 964; and that a Canadian patent takes effect when signed, sealed and registered, and from its date, not its delivery, see *Bate Refrig. Co. v. Gillett*, 22 O. G. 1205, and 40 O. G. 1029. It should be noted that these decisions relative to English patents were as to patents sealed under the 1852 act.

In case of a prior foreign patent granted for a short term but extended by one or more prolongations to its maximum term, if the term of the foreign patent is continuous and uninterrupted, the American patent will continue in force so long as the foreign patent continues to exist, not however to exceed seventeen years, see *Bate Refrig. Co. v. Hammond, et al.*, 46 O. G. 689.

Under the French law each patent of addition stands by itself like a new patent, and by its own date fixes the term of an American patent, see *De Florez v. Reynolds*, 17 O. G. 503. The forfeiture of the foreign patent by the non-fulfillment of conditions, such as the payment of annual taxes or the working of the invention, does not affect the duration of the American patent, see *Paillard v. Bruno*, 38 O. G. 900. Under Sec. 4887 the term of a domestic patent is to be equal to the remainder of the term for which the foreign patent was granted, although the latter may be forfeited by failure to pay a tax, or by other subsequent events, see *Holmes Electric Protective Co. v. Metropolitan Burglar Alarm Co.*, 21 Fed. Rep. 458; 28 O. G. 1129.

REQUISITES OF APPLICATION, DESCRIPTION, SPECIFICATION AND CLAIM.

SEC. 4888.—Before any inventor or discoverer shall receive a patent for his invention or discovery, he shall make application therefor, in writing, to the Commissioner of Patents, and shall file in the Patent Office a written description of the same, and of the manner and process of making, constructing, compounding, and using it, in such full, clear,

concise, and exact terms as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the same; and in case of a machine, he shall explain the principle thereof, and the best mode in which he has contemplated applying that principle, so as to distinguish it from other inventions; and he shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery. The specification and claim shall be signed by the inventor and attested by two witnesses.

Rules of Practice, 1892.—30 to 49.

AS TO THE APPLICATION.—The requirements of this section are prerequisites to the granting of a patent, and unless the prerequisites are complied with, a party sued for the infringement of a patent may show that they have not been complied with, and in that way defeat the patent. They are conditions precedent to the right of the Commissioner to grant a patent, see *New York v. Ransom*, 23 How. 487; *Seymour v. Osborne*, 8 Fish, 555.

AS TO THE SPECIFICATION.—The specification has two objects: one is to make known the manner of constructing the machine, if the invention is of a machine, so as to enable artisans to make and use it, and thus to give the public the full benefit of the invention after the expiration of the patent; the other is to put the public in possession of what the party claims as his own invention, so as to ascertain if he claims anything that is in common use, or is already known, and to guard against prejudice or injury from the use of an invention which the public may otherwise innocently suppose not to be patented, see *Evans v. Eaton*, 7 Wheat, 356. The specification must be perfect of itself, an imperfect description makes a patent void, see *Wayne v. Holmes*, 1 Bond, 27; it must explain the principle of the invention and state the best known mode of constructing and operating it, see *Grier v. Castle*, 17 Fed. Rep. 523; 24 O. G. 1176; it must distinguish the new from the old, see *Sawyer v. Miller*, 12 Fed. Rep. 725; and describe some practicable method of carrying the invention into effect, see *ex parte Schoonmaker* 13 O. G. 595; it is sufficient if, from it alone, a competent mechanic can construct the invention, see *Wayne v. Holmes*, 1 Bond, 27. If the description is sufficient to enable those skilled in the art to which it pertains, to make and use the invention the requirement of the law is satisfied, see *Loom Co. v. Higgins*, 21 O. G. 2031; *Roberts v. Schreiber*, 18 O. G. 125. "Persons skilled in the art" are those of ordinary and fair information, not of special excellence, see *ex parte Kerr*, 28 O. G. 95. If, on the assumption that certain matters are known to those skilled in the art, the specification is intelligible, it is sufficient, see *Hancock Inspirator Co. v. Lally*, 35 O. G. 1001; and if a description is sufficient at the date of the patent subsequent discoveries cannot make it less so, see *Celluloid Mfg. Co. v. Am. Zylonite Co.*, 40 O. G. 1453.

A failure to describe an essential element avoids the patent, see *Echneider v. Hill*, 5 Bann & A., 565. Absolute precision is not required, see *Dorsey Har. Rake Co. v. Marsh*, 6 Fisher, 387; but nothing can be patented unless it can be described, and a patentee cannot have invented what he cannot describe, see *Smith v. Downing*, 1 Fish, 64. Mistakes in naming the invention, or in assigning the invention to its proper class, as by calling it a product when it is a process, do not render the description insufficient, see *Foye v. Nichols*, 22 O. G. 2243.

Modifications and appliances which would suggest themselves to ordinary mechanics need not be mentioned, see *Union Paper Bag Co. v. Nixon*, 4 O. G. 31; nor is it necessary to describe all the uses of the invention, see *Pike v. Potter*, 3 Fisher, 55. Ambiguity in the description is fatal, irrespective of the intent of the inventor, see *Blake v. Stafford*, 3 Fisher, 294; but not unless the description is rendered unintelligible, see *Swift v. Whisen*, 2 Bond, 115.

False suggestion in a material part of the specification avoids the patent, see *Delano v. Scott*, 1 Robb, 700; and concealment by which the patentee obtains an advantage over the public, if wilful, avoids the patent, see *Heath v. Unwin*, 2 Webb, 236. If the invention relates to a machine the specification must clearly describe the exact construction and operation of every part thereof, and of the machine as a whole; if it relates to a process, it should describe the process step by step, as well as the operation as a whole; if it relates to a composition of matter, it must enumerate all the different materials entering into such composition, the proportions of each, the manner of combining them, and the essential qualities of the resulting composition.

AS TO THE CLAIM.—ITS SCOPE.—The office of the claim is to define the exact limits of the invention; the scope of the patent is governed by the claim, see *Yale Lock Co. v. Greenleaf*, 35 O. G. 386, and the invention patented is the invention set forth in the claim, and that only, see *Toohy v. Harding*, 1 Fed. Rep., 174; *McMillin v. Rees*, 17 O. G. 1222. If the claim does not define the invention the courts can give no relief, see *Del. Coal & Ice Co. v. Packer*, 24 O. G. 1273. A patent must stand or fall by its claims, see *Meissner v. Devoe Mfg. Co.*, 2 O. G. 545; and this is so even if the claimed invention be less than the real invention, see *Brass Co. v. Miller*, 5 Fisher, 48. When the terms of a claim in a patent are clear and distinct (as they always should be), the patentee, in a suit brought upon the patent, is bound by it, and cannot show that the invention is broader than the terms of the claim, see *Merrill v. Yeamans*, 12 O. G. 980. The court will not go into the history of the art, see *James v. Campbell*, 21 O. G. 337; nor enlarge the claim by the description, see *Yale Lock Co. v. Greenleaf*, 35 O. G. 386. Failure to claim described matter dedicates it to the public, see *Swift v. Jenks*, 27 O. G. 621.

AS TO THE CLAIM.—ITS FORM.—A claim must be for an operative means, see *ex parte Cornelly*, 1 O. G. 573; and be for matter so described that anyone skilled in the art can use it, see *Vogler v. Semple*, 11 O. G. 923. It must state a concrete invention, not an abstraction, see *ex parte Designolle*, 13 O. G. 227; it must not cover a principle, see *ex parte Fairbanks*, 3 O. G. 65. General truths and forces belong to all men, and cannot be claimed, see opinion Atty. Gen., 8 Op., Att. Gen., 269.

But one invention can be embraced in a single claim, see *ex parte Bland*, 15 O. G. 775. A process and its product cannot be embraced in a single claim, unless the one is absolutely dependent and inseparable from the other; nor can a machine and its product, an art and its apparatus, be covered by one claim if they are capable of use separately, see *ex parte Bates*, 16 O. G. 266.

The claim must precisely define the thing invented, see *ex parte Mayall*, 4 O. G. 210; and distinguish the invention claimed from all known inventions, see *ex parte Funck*, 14 O. G. 158; *Terry Clock Co. v. New Haven Clock Co.*, 17 O. G. 908; and must correspond with the specification, see *Knox v. Quicksilver M. Co.*, 4 Fed. Rep. 809. Every element claimed must be clearly stated, not merely inferred, see *ex parte Holt*, 29 O. G. 171; and such indefinite expressions as "means," "mechanism," etc., should not be used except to denote appliances that are not essential parts of the invention, see *ex parte Stoughton*, 43 O. G. 1345.

A claim covers all equivalents, see *Burdon v. Corning*, 2 Fisher, 477; even though the inventor never thought of them, see *McNamara v. Hulse*, 2 Web, 128; and equivalents should not be expressly claimed, see *ex parte Reid*, 15 O. G. 882.

A claim for a function is void, see *Matthews v. Schoneberger*, 18 O. G. 1464; and participial claims are improper, see *ex parte Cox*, 3 O. G. 2; nor can the claim be for a mere result or effect. A claim for the "mode of operation" is void, see *Hatch v. Moffatt*, 15 Fed. Rep. 252. The claim should be drawn to cover the construction of a machine or apparatus, not its mode of operation, or the result produced.

Alternative claims are not allowable, see *ex parte Holt*, 29 O. G. 171.

While claims for the same thing may be repeated in different language in order to prevent misunderstanding, see *ex parte Hahn*, 8 O. G. 597, the claims should not be unnecessarily multiplied.

Claims for separate but dependent inventions may be joined in a single application, see *ex parte Smith*, 2 O. G. 117; but separate and distinct inventions, capable of separate use cannot be so claimed. Their design and operation being independent of each other there is no point of view from which they can be considered as one invention; and patents embracing two or more such inventions will not be sustained. The general rule is that every art or instrument complete in itself, and capable of separate use, constitutes a distinct invention, and should form the subject matter of a separate application for patent.

The claim for a combination of elements must embrace specifically all of the essential elements necessary to produce a distinct and operative combination, see *ex parte Rhentan*, 5 O. G. 521; it should not include non-essential elements, see *Rapid Service Store R.R. Co. v. Taylor*, 42 O. G. 721; nor the connecting mechanism unless it is an element in the combination or is essential to the comprehension of what is claimed, see *ex parte Skinner*, 19 O. G. 662. A claim for an inoperative combination is void, see *Tarrant v. Duluth Lumber Co.*, 39 O. G. 1425. Each of the elements and sub-combinations, if new and patentable, may be separately claimed, as well as the combination as a whole, see *Stevens v. Pritchard*, 10 O. G. 505; *Bank v. Snediker*, 17 O. G. 508.

The claim for an art or process should enumerate each of the acts or steps of the process in the order in which they are employed, and in such manner as to identify them with the acts or steps set forth in the specification (see *Robinson on Pats.*, § 529), and

each step of a process, if a true sub-process may also be separately claimed, see *ex parte* Wilson, 16 O. G. 95. A general claim for a process covers all ways of performing it, see *Tilghman v. Procter*, 19 O. G. 859. It does not, however, necessarily cover the product, see *Goodyear v. Wait*, 5 Blatch., 468; and does not protect the product if the product can be made in any other way, see *Goodyear v. Railroad*, 1 Fisher, 626. Mere mechanical processes are not patentable, see *Medart v. Risdon Iron Works*, 71 O. G. 751.

The claim for a machine must be drawn to cover a specific piece of mechanism or apparatus; it must not be drawn so as to claim a mode of operation, a principle, an idea, a means of producing an effect or an effect produced, see *Burr v. Duryea*, 1 Wall, 531. If the invention does not embrace an entire machine, the parts invented must be distinctly claimed, see *Seymour v. Osborne*, 11 Wall, 516. Each subordinate mechanism may be separately claimed, even though not useful by itself, see *Wells v. Jacques*, 5 O. G. 364. The claim for a composition of matter should set forth its elements, the mode of combination, and the essential qualities of the resulting compound, see *ex parte* Williams, 10 O. G. 748. A composition of matter requires but a single claim, see *ex parte* Wheat, 16 O. G. 360.

The claim for a manufacture should set forth the essential qualities and the mode of making it, see *U. S. Nickel Co. v. Pendleton*, 24 O. G. 704. A manufacture must be claimed as a new product and independently of the process of making it, see *ex parte* Mayall, 4 O. G. 210.

The claim for an improvement upon a known art or machine must clearly state the exact improvement made, see *ex parte* McMurray, 8 O. G. 943; and must distinguish the new from the old, see *Brown v. Selby*, 2 Bissell, 457. It is not sufficient that persons skilled in the art can distinguish the improvement from the original invention, the claim itself must show it, see *Foxwell v. Bostock*, 10 L. T. Rep. N. S., 144.

Claims may be either generic or specific. A patent claiming the genus dominates all subsequent patents claiming only the species, see *ex parte* Ewart, 17 O. G. 448. Generic claims do not cover functions, results or effects, see *ex parte* Beairs, 16 O. G. 1233. An inventor of a species before anyone else invents the genus, or any other species, may claim the genus, see *ex parte* Gardner, 17 O. G. 626; but no patent with generic claims can be granted after one with a species, see *ex parte* Upton, 27 O. G. 99.

AS TO THE CLAIM.—ITS INTERPRETATION.—Patents for inventions are treated as a just reward to ingenious men, and as highly beneficial to the public. Specifications are, therefore, clearly entitled to a liberal construction, since they are granted, not as restrictions upon the rights of the community, but “to promote science and useful arts.” *Blanchard v. Sprague*, 2 Story, 164. Under the fair application of the rule *ut res magis valeat quam pereat*, patents are, if practicable, to be interpreted so as to uphold and not destroy the right of the inventor, see *Turrill v. Railroad Company*, 1 Wall, 491.

A claim cannot be dissected and accepted or rejected piecemeal, but must stand or fall together, see *ex parte* Smith, 1 O. G. 403. A claim may be valid for what it claims, though it does not claim the full invention, see *Wilson v. Coon*, 19 O. G. 482; but a claim exceeding the limits of the actual invention is void, see *Milligan v. Lalance & Grosjean Mfg. Co.*, 29 O. G. 367.

When several claims are present in the specification, the presence of a void claim does not affect those which are good, unless there is an evident intention to mislead the public, or an unreasonable delay in filing a disclaimer, see *Tyler v. Galloway*, 22 O. G. 2072; *Christman v. Rumsey*, 17 O. G. 903; *Burdett v. Estey*, 15 O. G. 877.

AS TO EXECUTION.—All the documents in connection with an application for patent; the petition, power of attorney (if any), specification, and oath, must be signed by the inventor, if he be alive, or by his executor or administrator, if he be dead. The signature of the inventor to the specification must be attested by two witnesses. All names should be legibly written in full.

The applicant must sign his full name in full. See *ex parte* Gentry, 44 O. G. 822.

In case of a deceased foreign inventor, it is necessary to apply for and take out ancillary letters of administration, appointing a resident of the United States, who must make the application, signing all the documents.

DRAWINGS, WHEN REQUIRED.

SEC. 4889. When the nature of the case admits of drawings, the applicant shall furnish one copy signed by the inventor or his attorney

in fact, and attested by two witnesses, which shall be filed in the Patent Office; and a copy of the drawing, to be furnished by the Patent Office, shall be attached to the patent as a part of the specification.

Rules of Practice, 1892.—49 to 56.

A drawing must be furnished, when the case admits, whether it is useful or necessary or not, see *ex parte* Chasc, 15 O. G. 809; it must show every feature claimed, see *ex parte* Crandall, 35 O. G. 625; and correspond in all essential particulars with the specifications, see *ex parte*, Witty, 29 O. G. 862. In case of simple inventions the drawings must be sufficient to supply the place of a model, see *ex parte*, Jovè, 17 O. G. 801.

RULES.—The following rules are rigidly enforced, and any departure from them will be certain to cause the rejection of the drawings.

PAPER AND SIZE.—All drawings must be made upon pure white paper of a thickness corresponding to three-sheet Bristol board. The surface of the paper must be calendered and smooth.

The size of the sheets must be exactly 10 inches (25.4 cm.) wide, by 15 inches (38.1 cm.) long (high). As many sheets may be used as may be necessary to show the invention fully, but the number of sheets must never be more than is absolutely necessary. Under the present practice, no drawing will be admitted, even for the purpose of examination, unless the sheet is of the correct size.

MARGINAL LINES AND SPACE FOR HEADING.—A single marginal line must be drawn, all around, exactly one inch (2.55 cm.) from the edge of the sheet. One of the shorter sides of the sheet is regarded as its top, and measuring downwardly from the marginal line, a clear space of not less than $1\frac{1}{4}$ inches (3.2 cm.) must be left blank for the heading, which is inserted by the Patent Office. Care must be taken that no portion of the drawing trespass within this space. Space for the signatures should be reserved at the bottom of the sheet above the marginal line.

LARGE VIEWS.—When views are larger (broader) than the width of the sheet, the sheet should be turned on its side. In this case space for the heading will be reserved at the right, and for the signatures at the left of the sheet, occupying the same position as in the upright views, and being horizontal when the sheet is held in an upright position, that is to say, these spaces for heading and signature always occupy the same positions on the sheet, whichever way the drawing itself may be placed.

POSITION OF VIEWS.—All views (and reference letters) on the same sheet must stand in the same direction.

INK, CHARACTER AND COLOR OF LINES.—All drawings must be made with the pen only. Every line and letter must be absolutely black. India ink alone must be used, to secure perfectly black and solid lines. All lines must be clean, sharp and solid, and they must not be too fine or crowded. This rule applies to all lines, however fine, to shading, and to lines representing cut surfaces in sectional views.

Drawings should be made with the fewest lines possible consistent with clearness. Surface shading when used, should be open. Sectional shading should be made by oblique parallel lines, which may be about one-twentieth of an inch apart. Shading (except upon sectional views) should be used only on convex and concave surfaces, where it should be used sparingly, and even there may be dispensed with if the drawing is otherwise well executed. Imitations of wood or surface graining should not be attempted.

The light is always supposed to come from the upper left hand corner at an angle of forty-five degrees. Heavy lines on the shade sides of objects should be used, except where they tend to thicken the work and obscure the letters of reference.

The plane upon which a sectional view is taken should be indicated upon the general view by a broken or dotted line.

SCALE OF DRAWING.—The scale upon which the drawing is made need not be indicated upon the drawing. It should be large enough, in all cases, to show the mechanism without crowding.

LETTERS AND FIGURES OF REFERENCE.—The different views should be consecutively numbered. If the same parts of an invention appear in more than one view it must always be represented by the same reference character. The same reference character should never be used to designate different parts, even in different views. Either letters or numerals may be used as reference characters. All letters and figures of reference must be carefully formed. They should measure at least one-eighth of an inch in height, and may be much larger when there is sufficient room. They must be so placed as to clearly indicate to what parts they refer, and at the same time so as never to

interfere with the thorough comprehension of the parts themselves. When necessarily grouped around a certain part, they should be placed at a little distance therefrom, where there is available space, and be connected by short broken lines with the parts to which they refer. They must never appear upon shaded surfaces, and when it is difficult to avoid this, a blank space must be left in the shading where the letter occurs, so that it shall appear perfectly distinct and separate from the work.

LITHOGRAPHS.—Lithographs will never be accepted under any circumstances, and it is useless to send them.

SIGNATURES.—The inventor need not, and preferably should not, sign the drawing, as this can be signed by the attorney under power, but if signed by the inventor, his signature should be placed at the lower right-hand corner of the sheet, and the signatures of two witnesses at the lower left-hand corner, all above and within the marginal line, but in no case should they trespass upon the drawings.

ADVERTISEMENTS NOT PERMITTED.—No advertisement of any nature, or agent's or attorney's stamp, or written address, will be permitted upon the face of the drawing, either within or without the marginal line.

DRAWINGS FOR RE-ISSUE APPLICATIONS.—Drawings for re-issue applications must be made upon the same scale as the original drawings, or upon a larger scale, unless a reduction of scale shall be authorized by the Commissioner.

BLUE PRINTS OR PHOTOGRAPHS.—Applicants are requested in Order No. 986 of the Patent Office, to furnish, with their originals, a blue print or other photographic copy of their drawings. Where this is done, Attorneys may have the originals taken to the Attorney's room for examination, etc.

The office will, upon request, furnish blue prints at a charge of five cents per sheet.

SPECIMENS OF INGREDIENTS, ETC.

SEC. 4890.—When the invention or discovery is of a composition of matter, the applicant, if required by the Commissioner, shall furnish specimens of ingredients and of the composition, sufficient in quantity for the purpose of experiment.

Rules of Practice, 1892.—62. (See also 56, 60 and 61.)

Specimens are seldom required. In cases where the article is not perishable, a specimen of the composition (if so required by the Commissioner) must be furnished, put up in proper form to be preserved by the office.

MODEL, WHEN REQUISITE.

SEC. 4891.—In all cases which admit of representation by model, the applicant, if required by the Commissioner, shall furnish a model of convenient size to exhibit advantageously the several parts of his invention or discovery.

Rules of Practice, 1892.—56 to 62.

A model will not be required unless it is useful as an aid in examining into the state of the art or in the construction of the specification and drawing, see *ex parte Jové*, 17 O. G. 801. It is usual for the office to require a model whenever the application refers to a device for producing perpetual motion, and when the invention is believed to be inoperative.

Models, when furnished, should be neatly and substantially made of durable material, metal being preferable, but when the material forms an essential feature of the invention it should be constructed of that material. It should clearly show every feature of the invention. It must be not more than 12 inches long, wide or high, except in cases in which the Commissioner shall admit working models of complicated machines of larger dimensions. If made of wood, it must be painted or varnished. Glue must not be used; the parts must be so constructed as to resist the action of heat and moisture. When practicable it should bear the inventor's name, the serial number, and the filing date of the application.

(A clear space of 1¼ inches must be left here for the heading and title that is inserted by the Patent Office.)

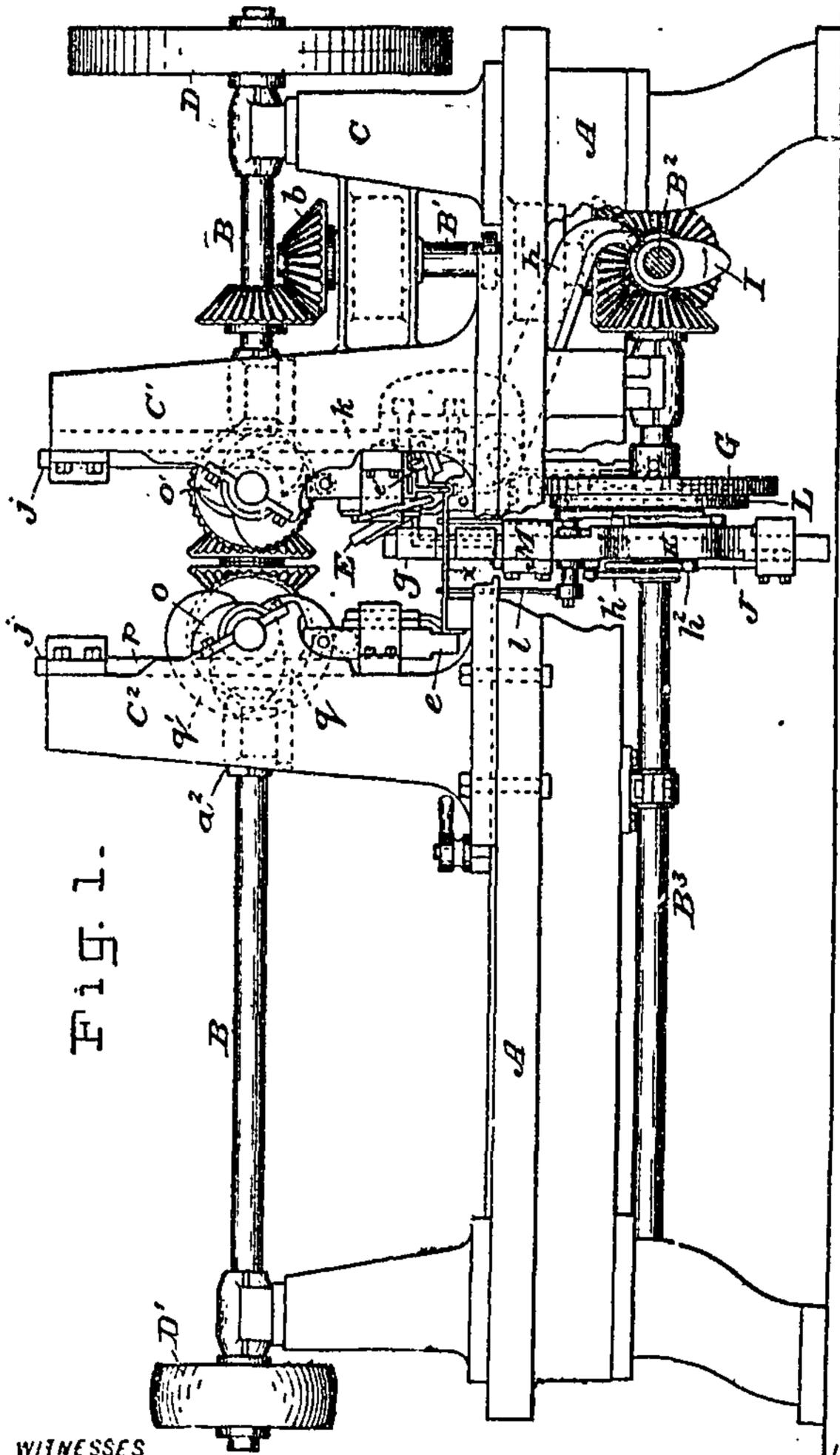


FIG. 1.

WITNESSES

INVENTOR

E F
G H

A. B.
BY C. D.

ATTORNEYS

NOTE.—The above illustrates a drawing made in accordance with the rules, where the figure, on account of its size, is placed lengthwise of the sheet. It will be observed that all requirements as to size of sheet, margin, space for heading, and space for signatures, are the same as for other drawings, and that the spaces are to be left at the same relative positions upon the sheet. See note at the bottom of the preceding page.

(A clear space of 1¼ inches must be left here for the heading and title that is inserted by the Patent Office.)

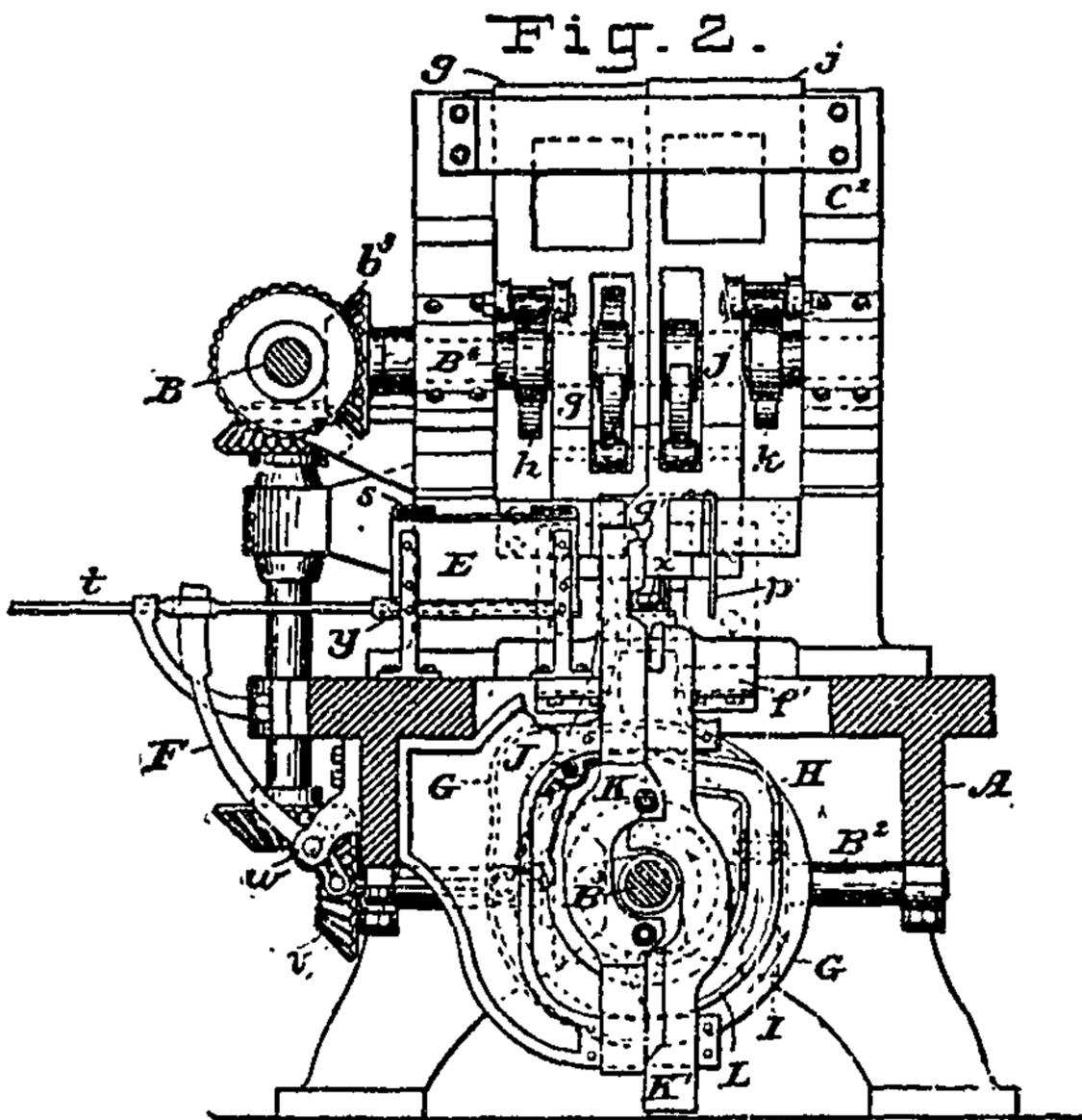


Fig. 3.

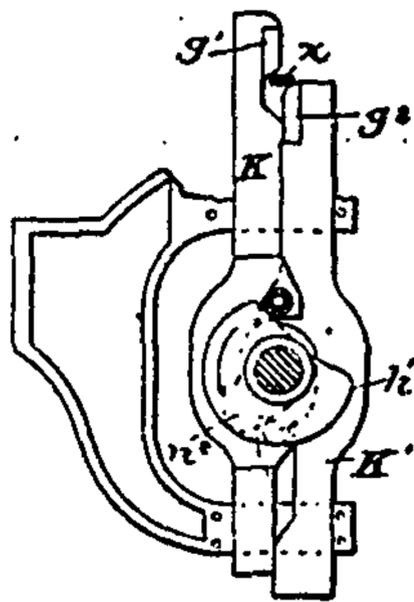


Fig. 4.

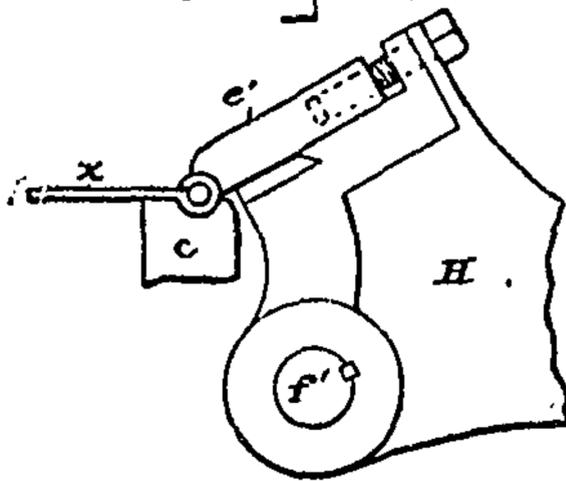
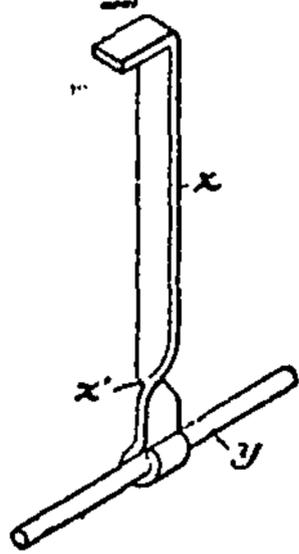


Fig. 5.



WITNESSES

E F.
G H.

INVENTOR

A. B.

BY

C. D.

ATTORNEYS

NOTE.—The above illustrates a drawing made in accordance with the rules. It shows, upon a scale about *one-half* that of the actual drawing, the relative proportions of the sheet, the margin, the blank space required to be left at the top of the sheet below the margin line, the spaces to be left for the signatures, etc.

The Patent Office will no longer knowingly accept informal drawings or lithographs, even for the purpose of examination. All drawings must be hand made, with india ink, upon white, smooth surfaced drawing board equal in thickness to three-sheet bristol board. The sheets must measure exactly ten inches wide by fifteen inches high. The margin line must be drawn exactly one inch from the edge of the sheet.

OATH REQUIRED FROM APPLICANT.

SEC. 4892.—The applicant shall make oath that he does verily believe himself to be the original and first inventor or discoverer of the art, machine, manufacture, composition, or improvement for which he solicits a patent; that he does not know and does not believe that the same was ever before known or used; and shall state of what country he is a citizen. Such oath may be made before any person within the United States authorized by law to administer oaths, or when the applicant resides in a foreign country, before any minister, chargé d'affaires, consul, or commercial agent, holding commission under the Government of the United States, or before any notary public of the foreign country in which the applicant may be.

Rules of Practice, 1892.—46 to 49.

In all applications for letters patent filed subsequent to October 24, 1882, the signature of the applicant is required to the oath.

The oath *must* be attested in all cases by the proper official seal of the officer before whom the oath or affirmation is made. When such officer is not provided with a seal his official character must be established by competent evidence, as by a certificate from a clerk of a court of record, or other proper officer having a seal.

ADDITIONAL OR SUPPLEMENTARY OATHS REQUIRED IN CERTAIN CASES.—An additional or supplemental oath will be required in certain cases, such as the following:

(1) The Commissioner may require an additional oath if the application has not been filed within a reasonable time after the execution of the original oath.

(2) To cure any defects in the original oath, such as the omission of the declaration as to foreign patents.

(3) If the applicant seeks to introduce, by amendment, any claim not substantially embraced in the statement of invention and claims originally presented, and therefore not covered by the original oath, he will be required to file a supplemental oath to the effect that the subject matter of the proposed amendment was part of his invention, and was invented before he filed his original application.

Inasmuch as in some foreign countries a notary public is not authorized by law to administer oaths it is necessary, in these countries, that the oath be made before a diplomatic or consular officer of the United States. This is the fact as to Austria, Argentine Republic, Belgium, Brazil, Costa Rica, Denmark, Hayti, Honduras, Hungary, Italy, Mexico, Netherlands, Norway, Peru, Portugal, Russia, San Salvador, Servia, Sweden, and Switzerland.

EXAMINATION AND ISSUING PATENT.

SEC. 4893.—On the filing of any such application and the payment of the fees required by law, the Commissioner of Patents shall cause an examination to be made of the alleged new invention or discovery; and if on such examination it shall appear that the claimant is justly entitled to a patent under the law, and that the same is sufficiently useful and important, the Commissioner shall issue a patent therefor.

Rules of Practice, 1892.—63 to 78. (See also notes under Section 4903 *post.*)

An application is not considered as filed and complete until all its parts have been received. After an application is completed the specification cannot be withdrawn from the office for any purpose whatever. Every part of the application is preserved in secrecy in the Patent Office, and no information is given concerning it to anyone outside of the department without due authority from the inventor, except in interference cases, or when the application has been rejected or abandoned, and in the judgment of the Commissioner its disclosure may be necessary. After an application is completed it is placed on file for examination, receiving a serial number, and thereafter is known to the office by its serial number and filing date.

CLASSIFICATION OF INVENTIONS.—Inventions are classified in two hundred and thirteen general classes, which are again subdivided into six thousand three hundred and twenty-two sub-classes. An application will be reached for examination in from

one to six months or more after it has been filed, some examiners being further behind in their work than others. The examination of applications is conducted by thirty-two principal (primary) examiners, each in charge of certain classes of inventions, assisted by thirty-four first, thirty-eight second, forty-three third, and fifty-three fourth assistant examiners, and numerous clerks and copyists.

Upon the receipt of the application at the Patent Office it is first entered of record in the office of the chief clerk. The financial clerk sees that the first government fee of fifteen dollars is paid; the application clerk that all formalities as to signatures and the oath have been properly complied with; the chief draughtsman that the drawing is made in conformity with the rules. If the application is not complete and correct in these particulars the papers are held for correction; if found correct the application receives its filing date and serial number, and is then sent to the examiner in charge of the class of inventions to which it belongs, and a receipt is forwarded to the applicant stating the filing date and the number of the application, and that it "will be taken up for examination in its order."

EXAMINATION AS TO FORM.—The first step in the examination is to determine whether the application is in all respects in proper form. Where there is a vital defect of form, the application cannot be examined on its merits, see *ex parte* Mill, 40 O. G. 918. All the parts of the application are subjected to a rigid scrutiny and all errors or omissions must be cured by amendment. If the technical terms employed are not correct they must be changed. If more than one invention is claimed, a division of the application is demanded, in which the inventor is required to limit his claims to a single invention. The Patent Office requires division not merely for its own sake, but in order that the patent may be valid, see *ex parte* Van Matteson, 24 O. G. 389. The inventor may in such case file separate applications for the matter eliminated, if he wishes to do so. If the drawing is not sufficiently full to clearly show the invention, additional views will be called for. If the specification is faulty, or does not fully describe the invention it must be revised and made complete. If the claims are not properly drawn they must be revised and corrected.

The first letter of the examiner must advise the applicant of all formal requirements, cite all references, and instruct him that action on the merits is postponed until the objections are removed. All formal matters must be settled before any claim is rejected on the merits, see *ex parte* Mill, 40 O. G. 918; *ex parte* Silliman, 34 O. G. 1889. If, however, the objections as to form are not vital, the examiner may proceed to the consideration of the application on its merits, see Rule 64.

EXAMINATION AS TO NOVELTY.—The examiner then proceeds to examine the case as to its merits, *i. e.*, to determine whether the invention is new and useful, and otherwise patentable. These examinations are usually very thoroughly conducted. The drawings of all prior patents in the class to which the invention belongs, and those in other classes, where there is a possibility that there may be any analogy, are carefully compared with those of the pending application. Not only prior United States patents, but the prior patents of all countries, and also the printed publications in the Patent Office Library are examined. The result of the examination is communicated to the applicant through his attorney, and in the great majority of cases consists of a rejection, or partial rejection of the claims presented, with the reasons therefor, and such information, and reference to prior patents or publications as will be useful to the applicant in the further prosecution of the application.

A REJECTION IS NOT A FINAL REFUSAL OF A PATENT.—Such a rejection is not a definite and final refusal to grant a patent. The examination is made with more particular reference to what *is claimed* than what *is shown* in the application, and while the invention itself may be entirely new and novel, and patentable, the examiner may properly reject the claims presented for the reason that they are so worded that they describe old and well-known devices as well as they do the applicant's invention.

An examiner, in rejecting an application, should cite references, not give his own *dictum*, see *ex parte* Fairbanks, 3 O. G. 65. All the examiner's reasons for rejecting the application must be given at once, see *ex parte* Proudfit, 10 O. G. 585. If the examiner denies the priority of the applicant and cannot cite a reference, he must support his denial by an affidavit, see *ex parte* Hill, 16 O. G. 765. The best references should be cited first, see *ex parte* Sanders, 18 O. G. 818. Pertinent references only should be cited, see *ex parte* Brownlie, 3 O. G. 212; but they need not be identical either in material, shape, or mode of use, see *ex parte* Chatillon, 2 O. G. 115.

AS TO DIVISIONAL APPLICATIONS.—Where separate and independent inventions are embraced in one application, it must be divided, see *ex parte* Mill, 40 O. G. 918; but no division can be ordered where the product or process are inseparable, see *ex parte*

Holt, 29 O. G. 171 ; and no division will be required unless each invention would be separately patentable, see *ex parte* Pintsch, 11 O. G. 597. Each additional application for the divided inventions must be supported by a new oath and possess the other requisites of an independent application, see *ex parte* Tieman, 11 O. G. 1. All the divided applications bear the date of the original, see *Graham v. Geneva Lake C. Mfg. Co.*, 21 O. G. 1536. Where an application is once divided the separated matter can never be reinstated, see *ex parte* Preston, 17 O. G. 853. A divisional application cannot be based on new matter added to the original after filing, see *ex parte* Buell, 20 O. G. 437. All divisional applications should disclaim what they do not claim, with proper references to the applications in which they are claimed, see *ex parte* Clarke, 26 O. G. 824. Whether a division is necessary is a question that the Patent Office alone can determine, see *ex parte* Kerr, 41 O. G. 463.

RIGHT TO AMEND.—The applicant has a right to amend before or after the first rejection or action ; and he may amend as often as the examiner presents new references or reasons for rejection. In so amending, the applicant should clearly point out all the patentable novelty which he thinks his invention presents in view of the state of the art disclosed by the references cited, or the objections made.

The object of such amendments is, of course, to correct errors and omissions in the specification and drawings, and to limit the claims to the precise features of novelty contained in the invention. Amendments usually consist in the re-writing of the claims. Oftentimes the change of one or two words in a claim will be sufficient. In other cases a portion of, or the entire specification and the claims must be re-written, and perhaps the drawings amended. Such an amendment having been filed, the examiner again takes up the application for consideration and continues his examination. He may find and cite new references, or objections, and additional amendments are required to overcome them. In this way from one to a dozen or more letters are written by the examiner, and as many amendments filed, before the case is disposed of by an allowance of the patent or a final rejection of the application. A rejection is not final until the examiner has twice rejected the same claim upon the same references or same state of facts.

In considering the question of rejections and amendments the following decisions will be found useful :

Amendments to the application may be offered at any time before final disposition of it has been made, in order to embrace in it everything which was specified at the outset, or to enlarge the claims, see *Railway Register Mfg. Co. v. North Hudson Co. R. Co.*, 33 O. G. 355 ; but not unless a good reason for allowing it appears, see *ex parte* Winchester, 17 O. G. 453 ; nor can new matter, changing the character of the invention, be introduced by amendment, see *ex parte* Wharton, 40 O. G. 917 ; and any amendment containing features not found in either the specification, the drawings, or the model, introduces new matter and must be made as a separate application, see *ex parte* Crandall, 35 O. G. 625. Amendments enlarging the scope of the application are not allowable, see *Eagleton Mfg. Co. v. West, B. & C. Mfg. Co.*, 17 O. G. 1504.

An applicant cannot change his ground and secure successive examinations for a single fee, see *ex parte* Holt, 29 O. G. 171. Claims struck out because inconsistent with other claims cannot be reinserted by amendment, after such other claims have been defeated, see *ex parte* Cobb, 16 O. G. 175 ; and a claim once voluntarily erased cannot be restored, but may be made the subject of a new application, see *ex parte* Johnson, 40 O. G. 574. Where an amendment is not permitted a new application may be filed, see *ex parte* Thurmond, 37 O. G. 217.

Any amendment, within the original sworn statement, may be made without a new oath, see *Railway Register Mfg. Co. v. North Hudson Co. R. Co.*, 33 O. G. 355 ; but where claims are enlarged in subject matter by amendment, a supplemental oath is necessary to show that such enlargement is not a departure from the invention as originally described, see *ex parte* Crandall, 35 O. G. 625 ; and an amendment introducing a part of the invention as originally made but not appearing in the specification as first filed, must be supported by an oath that it belonged to the original invention, see *ex parte* McDougall, 21 O. G. 1783.

Forfeited and abandoned applications will not be cited as references.

An application is open to amendment and addition (except as to new matter), within the limits fixed by the drawings and model until it is finally disposed of, see *ex parte* Dodge, 3 O. G. 179. After a second rejection of the same claim an applicant cannot amend as a matter of course, but must satisfactorily explain why he did not earlier offer the correction, see *ex parte* Donovan, 44 O. G. 698. From the refusal of an examiner to consider an amendment appeal lies to the Commissioner, see *ex parte* Bennett, 35 O. G. 1003. The rejection of claims may be appealed from but the rejected matter cannot be made the subject of a new application, see *ex parte* Ransom, 39 O. G. 119. A rejected

applicant must appeal within a reasonable time or he will not be permitted to stand in the way of other applicants, see *ex parte* Lombard, 43 O. G. 1347. By taking an appeal from the rejection of one claim the applicant forfeits no rights as to the others, see *ex parte* Gillette, 44 O. G. 819.

AS TO DILIGENCE IN AMENDING.—According to Rule 65, approved February 14, 1895, an applicant will be considered to persist in his claim for a patent without altering his specification in case he fails to act in prosecution of same for six months after the office action thereon, and thereupon the examiner will make a re-examination of the case, according to Rule 68, approved February 14, 1895. In every case pending before the office more than five years, in which the record raises the presumption that there has been intentional delay in prosecution, the examiner may require the applicant to show cause why the case was not more rapidly prosecuted, and at the hearing thereon, or upon failure of the applicant to appear, the examiner will determine, under all the circumstances of the case, whether there have been intentional and unreasonable delays in prosecution, and upon finding the fact to be so, he will reject the case for that reason.

COMPLETION OF APPLICATIONS.

SEC. 4894.—All applications for patents shall be completed and prepared for examination within two years after the filing of the application, and in default thereof, or upon failure of the applicant to prosecute the same within two years after any action therein, of which notice shall have been given to the applicant, they shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner of Patents that such delay was unavoidable.

Rules of Practice, 1892.—31, 171, 172.

The statute does not interpose an absolute bar to the granting of a patent where the application has not been completed and prepared for examination within two years. The delay may be condoned by proof that it was unavoidable. The decision of the fact is committed to the Commissioner. The sufficiency of the evidence is for him. He is the only judge to be satisfied, and his judgment is conclusive, see *McMillan v. Barclay*, 5 Fish, 189. If the inventor has been incapacitated by mental disorder, the application will not be deemed to be abandoned, see *Ballard v. Pittsburgh*, 12 Fed. Rep. 783. Although a party fails to prosecute his application within two years after he is notified of its rejection, yet he may file a new application for the same invention, for it is not the invention but the application that is decided to be abandoned, *Lindsay v. Stein*, 21 O. G. 1613.

PATENTS GRANTED TO ASSIGNEES.

SEC. 4895.—Patents may be granted and issued or re-issued to the assignee of the inventor or discoverer; but the assignment must first be entered of record in the Patent Office. And in all cases of an application by an assignee for the issue of a patent, the application shall be made and the specification sworn to by the inventor or discoverer; and in all cases of an application for a re-issue of any patent, the application must be made and the corrected specification signed by the inventor or discoverer, if he is living, unless the patent was issued and the assignment made before the eighth day of July, eighteen hundred and seventy.

Rules of Practice, 1892.—26, 215.

The words "the assignee" mean the assignee in any degree and however remote. They are not limited to the immediate assignee of the inventor, but embrace the ultimate assignee, see *Selden v. Stockwell S. L. G. B. Co.*, 20 O. G. 1737. No assignment of an unpatented invention is required to be recorded by this section, unless it is an assignment on which a patent is to be issued to "the assignee," and in such case the invention must be so identified in the assignment by a reference to a specification or an application, or otherwise, that there can be no mistake as to what particular invention is intended, see *Wright v. Randel*, 21 O. G. 493. The patent may be issued to the inventor and assignee jointly, see *Wright v. Randel*, 21 O. G. 493.

If assignments have been used, the Commissioner of Patents must be governed by the record in determining to whom a patent shall issue, see *ex parte* Edison, 7 O. G. 423.

WHEN, AND ON WHAT OATH, EXECUTOR OR ADMINISTRATOR MAY CLAIM PATENT.

SEC. 4896.—When any person, having made any new invention or discovery for which a patent might have been granted, dies before a patent is granted, the right of applying for and obtaining the patent shall devolve on his executor or administrator, in trust for the heirs at law of the deceased, in case he shall have died intestate; or if he shall have left a will, disposing of the same, then in trust for his devisees, in as full manner and on the same terms and conditions as the same might have been claimed or enjoyed by him in his lifetime; and when the application is made by such legal representatives, the oath or affirmation required to be made shall be so varied in form that it can be made by them.

Rules of Practice, 1892.—25, 26.

Patents issued to executors or administrators will be valid, although the trust is not expressed on the face thereof, for the law creates the trust, see *Stimpson v. Rogers*, 4 Blatch., 333. The import of this provision is that while the legal title to the invention is devolved upon the executor or administrator, he must take it and hold it subject to any equities existing as against the inventor in his lifetime. When the inventor parted with the equitable title, the executor or administrator holds it under exactly the same conditions, and subject to the same limitations of his interest in it, see *Northwestern Co. v. Philadelphia Co.*, 6 O. G. 34.

If an applicant dies his executor need not file a new application, but may be made a party to the pending application, see *Rice v. Burt*, 16 O. G. 1050.

An administrator with relation to letters patent is substantially a trustee for the heirs of the inventor, but in order to act he must make proof of his representative character. Foreign letters of administration are not good evidence of it, and ancillary letters of administration must be taken out in this country, see *Robert Ransome's Ex'rs*, 2 Dec. Com. 143. It follows therefore that in case of a deceased foreign inventor, ancillary letters of administration must be taken out in the name of some person resident in the United States, and the application for patent be made by this person as trustee for the heirs or other owners of the invention.

RENEWAL OF APPLICATION IN CASES OF FAILURE TO PAY FINAL FEE IN SEASON.

SEC. 4897.—Any person who has an interest in an invention or discovery, whether as inventor, discoverer, or assignee, for which a patent was ordered to issue upon the payment of the final fee, but who fails to make payment thereof within six months from the time at which it was passed and allowed, and notice thereof was sent to the applicant or his agent, shall have a right to make an application for a patent for such invention or discovery the same as in the case of an original application. But such second application must be made within two years after the allowance of the original application. But no person shall be held responsible in damages for the manufacture or use of any article or thing for which a patent was ordered to issue under such renewed application prior to the issue of the patent. And upon the hearing of renewed applications preferred under this section, abandonment shall be considered as a question of fact.

Rules of Practice, 1892.—175, 176.

Where a patent has been forfeited for non-payment of the final fee, a renewal application may be filed within two years, but not afterward, see *ex parte Hardy*, 12 O. G. 1075. After two years' delay there can be no renewal application, see *Thompson v. Waterhouse*, 30 O. G. 177. Any person interested in the invention may make the renewal application, using the original petition, oath, specification, drawing, and model, if he pleases, but paying a new fee. This second application is not considered as a

continuation of the former, but will bear date from the time of the renewal, and will be examined and passed upon like an original application. In its examination the novelty will be determined by the state of the art when the original was filed, not in its present state, as in the case of an application wholly new.

ASSIGNMENTS OF PATENTS.

SEC. 4898.—Every patent or any interest therein shall be assignable in law by an instrument in writing; and the patentee or his assigns or legal representatives may, in like manner, grant and convey an exclusive right under his patent to the whole or any specified part of the United States. An assignment, grant, or conveyance shall be void as against any subsequent purchaser or mortgagee for a valuable consideration, without notice, unless it is recorded in the Patent Office within three months from the date thereof.

Rules of Practice, 1892.—26, 210, 211, 212, 213, 214, 215, 216, 218, 219.

Any instrument amounting to any assignment, grant, mortgage, lien, incumbrance, or license, or which affects the title of the patent or invention to which it relates, will be received for record. Such instrument should identify the patent by number and date; or, if the invention is unpatented, by the name of the inventor, the serial number, and date of the application.

The assignment may be for either the right to make, to use, or to sell, or for the right to do any or all of these acts, and may be for the whole or any part of the United States, see *Howe v. Chatham*, 64 Tex., 36; *Campbell v. James*, 18 O. G. 1111. Each claim is separately transferable, see *Pope Mfg. Co. v. Gormully & Jeffrey Mfg. Co.*, 84 Fed. Rep. 893. Undivided interests may also be assigned. An assignment of an undivided part of a patent, however small the undivided interest conveyed, makes the assignee and the patentee joint owners, see *Potter v. Holland*, 4 Blatch., 206; and the holder of an undivided interest in a patent may make, use and sell, and license others to do so, without regard to its effect on his co-owners, unless there is an agreement between the parties as to profits. Joint owners of a patented invention are tenants in common, see *Dunham v. Indianapolis & St. Louis R. R. Co.*, 7 Bissell, 223. A joint interest in a patent does not make the owners partners, see *Parkhurst v. Kinsman*, 1 Blatch., 488. Each co-owner of a patent may use the right without the concurrence of the others, and license at will, see *Washburn & Moen Mfg. Co. v. Chicago G. W. F. Co.*, 109 Ill., 71. One joint-owner cannot compel another to account for a share of his profits, see *Vose v. Singer*, 4 Allen, 226; *Fraser v. Gates*, 118 Ill., 99. But it should be observed that neither a joint-owner nor his alienees can lawfully practice an infringing invention, see *Miller's Fails Co. v. Ives*, 14 O. G. 203.

Executors and administrators hold a patent in trust for the devisees; they can assign a patent and give a good title thereto, see *Donoughe v. Hubbard*, 35 O. G. 1561; and it is not necessary that all the executors or administrators should join in the assignment, see *Wintermute v. Redington*, 1 Fisher, 239.

Patented inventions are not subject to execution, nor to any ordinary method of appropriation for the benefit of creditors; a patent privilege cannot be seized and sold on execution, see *Carver v. Peck*, 13 Mass., 291; but the owner of a patented invention may be compelled by a court of equity to assign it for the benefit of creditors. For a full discussion of this subject, see *Robinson on Patents*, §§ 804, 805.

An infant must assign by guardian, but the guardian is governed by local law; the power of a married woman to assign a patent depends on the provisions of the local law, see *Fetter v. Newhall*, 25 O. G. 502.

No particular form for an assignment is prescribed, see *Siebert Cylinder Oil Cup Co. v. Beggs*, 32 Fed. Rep. 790. It must be made in writing and be signed by the assignors, see *Gottfried v. Miller*, 21 O. G. 711. A parol agreement to assign and to allow the assignee to take out the patent in his own name is valid, see *Lockwood v. Lockwood*, 33 Iowa, 509; and a verbal agreement vests in the assignee an equitable right to grant licenses, and notes given for such licenses are upon sufficient consideration, see *Burke v. Partridge*, 58 N. H., 349; but the legal title to a patent can be transferred only by a written instrument signed by the owner of the patent, see *Ashcroft v. Walworth*, 2 O. G. 546. An assignment executed by an attorney must be signed with name of the principal and sealed with his seal, see *Machesney v. Brown*, 38 O. G. 1130. An assignment by an attorney in his own name is invalid, the signature of the owner being essential, see *Pryer v. Coulter*, 1 Bailey, 517. A conveyance by a corporation with its seal,

and by its president with his seal, is good as to both, see *Campbell v. James*, 18 O. G. 979. It is not required that an assignment be under seal, see *Gottfried v. Miller*, 21 O. G. 711; nor need the signature of the assignor be witnessed or acknowledged in order to be effective.

AS TO ASSIGNMENT BEFORE ISSUE OF PATENT.—The right to an invention dates from its discovery, see *Wintermute v. Redington*, 1 Fisher, 239; and an assignment before patent is valid, see *Cammeyer v. Newton*, 11 O. G. 287. A patent cannot issue to the assignee, however, unless the assignment contains a request to that effect and is duly recorded as prescribed by the rules, see *Wright v. Randell*, 21 O. G. 493. Rule 215 requires that such an assignment be presented for record at a date not later than the day upon which the final fee is paid. The invention should be identified in the instrument by the name of the inventor, the serial number, and date of application.

ASSIGNMENT SHOULD BE RECORDED.—An unrecorded assignment, grant or conveyance, is valid between the parties thereto, see *Horne v. Chatham*, 64 Tex., 36; *Turnbull v. Weir Plow Co.*, 7 O. G. 173; and is good, except against creditors and subsequent *bona fide* purchasers, see *Holden v. Curtis*, 2 N. H., 61; for one who knows of an unrecorded assignment cannot be a *bona fide* purchaser, see *Ashcroft v. Walworth*, 2 O. G. 546; and an assignment though unrecorded is good against all who have actual notice, see *Maurice v. Devo*, 23 W. Va., 247; *Ashcroft v. Walworth*, 2 O. G. 546; but in order that the record may be constructive notice to intending purchasers, the assignment must be recorded within three months from the date of its execution. After three months without record a prior conveyance becomes invalid as against a later transfer, except in cases where the later purchaser had actual notice of the existence of the prior assignment. An assignment is not valid against innocent parties unless recorded, see *Boyd v. McAlpin*, 3 McLean, 427. It should be observed, however, that the record although made after three months have elapsed, affords constructive notice to all persons acquiring interests in the invention subsequently to the date of record, see *Brooks v. Byam*, 2 Story, 525; *Case v. Redfield*, 4 McLean, 526; also that section 4895 does not provide for recording assignments of unpatented inventions, unless the patent is to issue to the assignee, and if recorded, such record is not notice to anyone, see *Wright v. Randell*, 21 O. G. 493; also that the record of an instrument which the law does not require to be recorded is not constructive notice of anything to any person, see *Wright v. Randell*, 21 O. G. 493; and that the law provides for the recording of these instruments only: an assignment before issue, when the patent is to issue to the assignee, either alone or jointly with the inventor; an assignment after patent; a grant of a territorial interest; and a license, see *Brooks v. Byam*, 2 Story, 525. A single assignment may transfer several patents, but to avoid confusion on the records, a separate conveyance for each patent is desirable.

PERSONS PURCHASING OF INVENTOR, BEFORE APPLICATION, MAY USE OR SELL THE THING PURCHASED.

SEC. 4899.—Every person who purchases of the inventor or discoverer, or, with his knowledge and consent, constructs any newly invented or discovered machine, or other patentable article, prior to the application by the inventor or discoverer for a patent, or who sells or uses one so constructed, shall have the right to use, and vend to others to be used, the specific thing so made or purchased, without liability therefor.

The object of this provision is evidently two-fold: 1st, to protect the person who has used the thing patented by having purchased, constructed, or made the machine, etc., to which the invention is applied, from any liability to the patentee or his assignee; 2nd, to protect the rights granted to the patentee against any infringement by any other persons.

The "purchaser" here spoken of is a purchaser not from a mere wrong-doer, but from the first and true inventor before he obtained his patent, see *Pierson v. Eagle Screw Co.*, 3 Story, 402. The right of a party who has bought, or constructed a machine before the application for a patent is confined to the specific machines so bought or constructed, see *Brickill v. New York*, 18 O. G. 463.

PATENTED ARTICLES MUST BE MARKED AS SUCH.

SEC. 4900.—It shall be the duty of all patentees, and their assigns and legal representatives, and of all persons making or vending any

patented article for or under them, to give sufficient notice to the public that the same is patented; either by fixing thereon the words "patented," together with the day and year the patent was granted; or when, from the character of the article, this cannot be done, by fixing to it, or to the package wherein one or more of them is enclosed, a label containing the like notice; and in any suit for infringement, by the party failing so to mark, no damages shall be recovered by the plaintiff, except on proof that the defendant was duly notified of the infringement, and continued, after such notice, to make, use, or vend the article so patented.

The duty of marking patented articles as "patented" devolves upon the manufacturer, see *Wilson v. Singer Mfg. Co.*, 16 O. G. 1091. Unless the evidence shows that the statute has been complied with, only nominal damages can be recovered for infringements, see *McComb v. Brodie*, 2 O. G. 117. The failure to stamp prevents recovery of damages, but is no bar to an injunction either preliminary or perpetual, see *Goodyear v. Allyn*, 3 Fisher, 374. However, in *McComb v. Brodie*, 2 O. G. 117, it was held that notice otherwise given is equivalent to a mark on the articles themselves in its effect on the right to substantial damages.

PENALTY FOR FALSELY MARKING OR LABELING ARTICLES AS PATENTED.

SEC. 4901.—Every person who, in any manner, marks upon anything made, used, or sold by him for which he has not obtained a patent, the name or any imitation of the name of any person who has obtained a patent therefor, without the consent of such patentee, or his assigns or legal representatives; or

Who, in any manner, marks upon or affixes to any such patented article the word "patent" or "patentee," or the words "letters patent," or any word of like import, with intent to imitate or counterfeit the mark or device of the patentee, without having the license or consent of such patentee or his assigns or legal representatives; or

Who, in any manner, marks upon or affixes to any unpatented article the word "patent" or any word importing that the same is patented, for the purpose of deceiving the public, shall be liable, for every such offence, to a penalty of not less than one hundred dollars, with costs; one-half of said penalty to the person who shall sue for the same, and the other to the use of the United States, to be recovered by suit in any district court of the United States within whose jurisdiction such offence may have been committed.

The object of this provision is to prevent fraudulent imposition upon the community at large. The marking is an offense, though no sales result, see *Nichols v. Newell*, 1 Fisher, 647; and however the mark may be put on, *Idem*. The fine may be recovered by any person in a *qui tam* action brought in the name of the informer, not of the United States. The suit can be maintained only in the district in which the stamping was done, and not where the goods were sold, see *Pentlarge v. Kirby*, 19 Fed. Rep. 501. Acts of employees in false stamping are acts of the principal, see *Kass v. Hawlowetz*, 33 O. G. 1135. A corporation may violate this act through its officers, see *Thompkins v. Butterfield*, 33 O. G. 758.

FILING AND EFFECT OF CAVEATS.

SEC. 4902.—Any citizen of the United States who makes any new invention or discovery, and desires further time to mature the same, may, on payment of the fees required by law, file in the Patent Office a caveat setting forth the design thereof, and of its distinguishing characteristics, and praying protection of his right until he shall have matured

his invention. Such caveat shall be filed in the confidential archives of the office and preserved in secrecy, and shall be operative for the term of one year from the filing thereof; and if application is made within the year by any other person for a patent with which such caveat would in any manner interfere, the Commissioner shall deposit the description, specification, drawings, and model of such application in like manner in the confidential archives of the office, and give notice thereof, by mail, to the person by whom the caveat was filed. If such person desires to avail himself of his caveat, he shall file his description, specifications, drawings, and model within three months from the time of placing the notice in the post office in Washington, with the usual time required for transmitting it to the caveator added thereto; which time shall be indorsed on the notice. An alien shall have the privilege herein granted, if he has resided in the United States one year next preceding the filing of his caveat, and has made oath of his intention to become a citizen.

Rules of Practice, 1892.—197 to 209, 15, 154.

The purpose of a caveat is to prevent the grant of a patent for the same invention to another person, without notice to the caveator, in case an application should be filed by another inventor during the existence of the caveat. Thus it simply entitles an inventor to a certain notice. It gives him no advantage over such other applicant, and imposes no obligation upon him either to file an application for patent after receiving such notice, or to oppose the grant of a patent to the other inventor. It simply affords him the opportunity to do so, and allows him the term of three months for preparing and filing his application. If, during the time which elapses between the filing of the caveat and his application the inventor allows his invention to go into public use, his caveat will not protect him, see *Bell v. Daniels*, 1 Fisher, 377. A caveat cannot be filed for a design, as a design cannot exist at all until it is complete enough to be patented, see *ex parte Carty*, 44 O. G. 570. A caveat for a joint invention may be signed by one of the inventors only, see *ex parte Gray*, 12 O. G. 396. A patent issued on a subsequent application without notice to the caveator is "surreptitiously obtained," see *Phillips v. Brown*, 4 Blatch., 362; and gives no advantage to the patentee, but as against the caveator he will still be treated as a rival applicant, see *Ware v. Bullock*, 7 O. G. 89.

A caveat may be renewed from year to year upon payment of the fees.

NOTICE OF REJECTION OF CLAIM FOR PATENT TO BE GIVEN TO APPLICANT.

SEC. 4903.—Whenever, on examination, any claim for a patent is rejected, the Commissioner shall notify the applicant thereof, giving him briefly the reasons for such rejection, together with such information and references as may be useful in judging of the propriety of renewing his application or of altering his specification; and if, after receiving such notice, the applicant persists in his claim for a patent, with or without altering his specifications, the Commissioner shall order a re-examination of the case.

Rules of Practice, 1892.—65, 66, 67, 69 to 78.

For statement as to prosecution of application, rejections, right of applicant to amend, etc., see notes to section 4893, *ante*.

The specification is always open to amendment of its description and claims, until the application is finally disposed of by the granting of the patent or otherwise.

After a first rejection the applicant may insist upon his claim as presented. If the examiner re-affirms his former decision, without supporting it with fresh references, the rejection is final, and there is no remedy but appeal. But if the examiner gives new references, the applicant has a right to reply to them or to amend his specification, see *ex parte Appleton*, 1 Dec. Com. 8. If a reference is a domestic patent, or if it is a foreign patent or a publication, the applicant may avoid the reference by an affidavit showing his completion of the invention before the filing of the application for the

domestic patent, or before the date of the foreign patent, or the publication, and averring that he does not know or believe that the invention has been in public use or on sale in this country for more than two years prior to his application, and that he has never abandoned the invention. Foreign inventors may show that their inventions were known in this country before the dates of their applications, and can go back to the dates of any prior foreign patent granted to them for the same invention, but cannot show use abroad prior to the dates of their patents, see *ex parte* Lamfrey, 20 O. G. 892. In case the prior patent cited is an unexpired domestic patent, an interference arises upon the filing of the affidavit above referred to. (See Section 4904 and notes as to proceedings in interferences.)

INTERFERENCES.

SEC. 4904.—Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be, and shall direct the primary examiner to proceed to determine the question of priority of invention. And the Commissioner may issue a patent to the party who is adjudged the prior inventor, unless the adverse party appeals from the decision of the primary examiner, or of the board of examiners-in-chief, as the case may be, within such time, not less than twenty days, as the Commissioner shall prescribe.

Rules of Practice, 1892.—93 to 132, 146, 147.

INTERFERENCES DEFINED.—An interference is a proceeding instituted in the Patent Office for the purpose of determining the priority of the inventive act between two or more parties claiming substantially the same patentable invention. The intent of the law is that a patent shall be granted to the first and original inventor, and in an interference proceeding the sole question is that of the priority of the inventive act, see *Hicks v. Keating*, 40 O. G. 343. Where there are rival claimants for the same invention it becomes the duty of the Patent Office to ascertain which of the claimants is the true and first inventor. To determine this fact a judicial proceeding is instituted, in which each of the claimants is required to prove the date upon which he conceived the invention, each of the parties having the right to be heard by evidence and argument in defense of his own claims and in opposition to the claims of his opponents. When all the testimony has been taken, the examiner of interferences passes upon the evidence and declares which of the claimants appears to be the true and first inventor and is entitled to a patent. This judicial proceeding is called an Interference.

WHEN DECLARED.—Interferences will be declared between two or more pending applications, whether original or for re-issues; or between one or more pending applications (whether original or for re-issues) and any unexpired patent or patents, when all the parties claim substantially the same patentable invention, see *Sawyer v. Edison*, 25 O. G. 597. An interference cannot be declared between an application and an unexpired patent unless the later applicant claims priority under oath, see *Thomas v. Reese*, 17 O. G. 195. An interference cannot be declared against an expired patent, see *ex parte* Mason, 9 O. G. 1196; nor with forfeited or abandoned applications, see *Starr v. Farmer*, 23 O. G. 2325. An interference between two or more patents cannot be adjudicated in the Patent Office, see *Nicholson v. Bennett*, 16 O. G. 631; and it should be observed that a judgment against a patent in an interference proceeding does not annul the patent, but simply awards a patent to the rival, see *C. A. Yale Cigar Mfg. Co. v. Yale*, 30 O. G. 1183. As to interfering patents, see Section 4918 and notes.

Under former rules of the Patent Office an interference was declared where applications might be so amended as to include conflicting claims, although the conflicting matter was not so claimed at the time the interference was instituted. At the present time the rules forbid the declaration of an interference until the conflict appears specifically in the claims.

An application does not conflict with another application, or an unexpired patent, unless the invention covered by each specification is substantially the same, see *ex parte* Lassall, 28 O. G. 1274. Similarity or diversity in name and appearance are of no consequence, and an interference may be declared whenever the inventions conflict, see *Drawbaugh v. Blake*, 30 O. G. 259.

An application for a design patent may interfere with one for a mechanical invention, if both claim the same subject matter, see *Collender v. Griffith*, 3 O. G. 91.

When only part of the invention included in an application is involved in an interference, the applicant may file certified copies of the part or parts of the specification, claims, and drawings which cover the interfering matter, and such copies may be used in the proceeding in place of the original application. The applicant may then withdraw from his application the subject matter adjudged not to interfere, and file a new application therefor, or he may file a divisional application for the subject-matter involved, if the invention can be legitimately divided; no claim, however, can be made in either application broad enough to include matter claimed in the other, see *ex parte Wheeler*, 23 O. G. 1031; *ex parte Clarke*, 26 O. G. 824.

Amendments to an application while in interference can be made only for the purpose of withdrawing its subject-matter, wholly or in part, from the conflict in which it is involved. An applicant who prefers to abandon his claim to the contested matter rather than incur the expense, delay and risks of an interference, may file, before the date fixed for lodging his preliminary statement, a disclaimer in writing over his own signature, and attested by two witnesses, averring that he does not claim to be the inventor of the particular matter at issue. This disclaimer should be accompanied by an amendment removing the contested matter from his application and claims. Where there has been an assignment of any interest, such disclaimer must be accompanied by the written consent of the assignee, see *Laverty v. Flagg*, 16 O. G. 1141.

PROCEDURE IN INTERFERENCES.—Where a primary examiner believes that an interference exists, it becomes his duty, after all preliminary questions are settled, to forward all the papers to the examiner of interferences, who reviews them, and if he finds that the papers are complete and in form, will declare the interference by sending notice of the same to the parties interested.

No interference will be declared until all preliminary questions have been settled by the primary examiner, and the invention decided to be patentable, see *ex parte Bland*, 16 O. G. 47. The primary examiner decides whether the claims interfere, see *Faure v. Bradley*, 44 O. G. 945; *ex parte Saunders*, 23 O. G. 1224; and whenever there is any doubt in his opinion as to the conflict of the inventions it is his duty to notify the applicants, and require them to state their claims in such a manner that the nature and extent of their antagonism will become distinct and unmistakable. Upon receipt of this notice, and within the time therein specified, all the parties must put their claims in such condition that no further change in them will be required to precisely cover their respective rights. The examiner may grant an extension of time if it be found necessary or desirable. Whenever a party fails to put his application in proper condition for an interference within the time specified, the declaration of interference will not be delayed. After final judgment of priority the application of such party will be held for revision and restriction, subject to interferences with other applications.

The notices of interferences define the exact issue involved, and contain a summary of the contested matter, see *Dod v. Cobb*, 10 O. G. 826; and name a time before which the parties interested must file their preliminary statements. The time for filing a preliminary statement may be extended, upon motion duly made and served upon the other parties, if such extension be necessary. (See Rule 104.)

PRELIMINARY STATEMENTS.—The preliminary statement is a concise written recital, under oath, of the date of all the facts upon which the applicant intends to rely to support his claim of priority.

If the invention was made within the United States, the inventor must set forth in his statement:

- (1.) The date of his original conception of the invention.
- (2.) The date upon which a drawing of the invention was made.
- (3.) The date upon which a model of the invention was made.
- (4.) The date upon which the invention was first disclosed to others.
- (5.) The date of the reduction to practice of the invention.
- (6.) A statement showing the extent of use of the invention.

If a drawing or model has not been made, or if the invention has not been reduced to practice, or disclosed to others, or used to any extent, the statement must specifically disclose these facts, see *Dermody v. Pennock*, 14 O. G. 202.

If the invention was made abroad, the inventor must set forth:

- (1.) That the applicant made the invention set forth in the declaration of interference.
- (2.) Whether or not the invention was ever patented; if so, when and where, giving the date and number of each patent.

- (3.) Whether the invention was ever described in a printed publication ; if so, when and where, giving the title, place, and date of such publication.
- (4.) Whether or not the invention was ever introduced into this country ; if so, giving the circumstances, with the dates connected therewith, which are relied upon to establish the fact.

The statements should be carefully prepared, as the parties will be strictly held in their proofs to the dates set up therein. Evidence cannot be introduced contradicting the statement, see *Connor v. Williams*, 15 O. G. 387.

A preliminary statement may be amended upon motion by the permission of the Commissioner in proper cases, see *Clemson v. Fowler*, 37 O. G. 671 ; and this is so if it contains substantial errors arising from inadvertence or mistake. Clerical errors may be amended at any time, but a motion to amend in material particulars must be made, if possible, before the taking of any testimony, and as soon as practicable after the discovery of the error, see *Hopkins v. Le Roy*, 18 O. G. 859. Upon this motion all parties are entitled to be heard, and reasonable notice of its pendency must be served upon them.

The statements will be open for the inspection of the opposing parties when all have been filed, or the time for such filing (with any extension thereof) shall have expired, and they have been examined by the proper officer and found satisfactory, but any party in default in filing his statement will not have access to his opponent's statement until he has either filed his statement, or waived his rights thereto and agreed to stand upon his record date, see Rule 111.

If a statement is found to be defective, the party will be notified of the defect, and a time assigned within which he must cure the same by an amended statement. In no case will the original or amended statement be returned after it shall have been filed. If a party shall refuse to file an amended statement he will be restricted to his record date, *i. e.*, the date upon which he filed his application, in the further proceedings in the interference, see Rule 112 ; *Booth v. Lyman*, 17 O. G. 393.

When the statements are properly filed they are examined and compared with the original applications. If it appears that the date of the filing of the earliest application is not overcome by the dates fixed by the other parties in their statements, priority is awarded to the earliest applicant, see *Booth v. Lyman*, 17 O. G. 393 ; *Huntley v. Smith*, 18 O. G. 795. Where the preliminary statement of a later applicant fails to carry the date of his inventive act behind the date when earlier applications were filed, judgment is entered against him, see *Huntley v. Smith*, 18 O. G. 795. Only in cases where the date claimed in the statement of one party anticipates the filing of an earlier application by some other party does the interference proceed further, since in these cases alone is the *prima facie* presumption of priority of invention arising from the dates of filing of the respective applications rebutted, and additional evidence rendered necessary to determine which of the parties was the true and first inventor. The first applicant is regarded as the first inventor till the contrary appears, see *Starr v. Farmer*, 23 O. G. 2325.

TAKING TESTIMONY.—The time for the taking of testimony by the various parties is fixed by the examiner. The time for taking testimony may be extended in favor of either party upon a motion, disclosing under oath the reasons for his inability to obtain his evidence within the period prescribed, the names of the witnesses whose testimony he desires, the facts which he expects to prove by them, and the efforts he has made already to secure their earlier attendance. A failure to complete his testimony within the period assigned to any party is not permitted to delay the final hearing.

The same rules as to evidence apply in interference cases as in the courts of the United States, see *Millward v. Barnes*, 11 O. G. 1060. Reasonable notice must be given by parties of the time when, and place where, the testimony will be taken, and full opportunity must be afforded for the opponent to be present and cross-examine the witnesses, either in person or by attorney, see *Bell v. Gray*, 15 O. G. 776.

The several parties will be presumed to have made the invention in the chronological order in which they claimed the same in their completed applications for patents, and the burden of proof will rest upon the party who seeks to establish a different state of facts, see *McKnight v. Wagenen*, 9 O. G. 1161. The claimant against a patent has the burden of proof, see *Donoughe v. Hubbard*, 35 O. G. 1561. The latest applicant therefore must first complete his evidence in chief ; this is followed by the adverse party, who takes his testimony in reply, and finally the later applicant takes his rebutting evidence. Where there are more than two contestants their times for taking testimony are so arranged that each shall have an opportunity to prove his own case against prior applicants, and to rebut their evidence when offered in reply, and also to answer that of later applicants.

The testimony will be taken in answers to interrogations before a notary public or other officer empowered by law to administer an oath, with the questions and answers

committed to writing in their regular order, by the officer, or, in his presence, by some person not interested in the case.

Each witness before testifying must be duly sworn. The deposition, after same shall be taken, shall be carefully read over by the witnesses, or by the officer to him, and must then be subscribed by the witness in the presence of the officer.

The officer must annex to the deposition his certificate, showing—

- (1.) The due administration of the oath by the officer to the witness, before the commencement of his testimony.
- (2.) The name of the person by whom the testimony was written out, and the fact that, if not written by the officer, it was written in his presence.
- (3.) The presence or absence of the adverse party.
- (4.) The place, day, and hour of commencing and taking the deposition.
- (5.) The reading by, or to, each witness, of his deposition, before he signs the same; and
- (6.) The fact that the officer was not connected by blood or marriage with either of the parties, nor interested, directly or indirectly, in the matter in controversy.

The officer must sign the certificate and affix thereto his seal of office. He must then, without delay, securely seal up all the evidence, notices, and paper exhibits, inscribe upon the envelope a certificate, giving the title of the case, the name of each witness, and the date of sealing, address the package, and forward the same to the Commissioner of Patents.

TESTIMONY IN FOREIGN COUNTRIES.—By leave of the Commissioner first obtained upon motion, testimony may be taken in foreign countries, see *Lander v. Crowell*, 16 O. G. 405.

The motion must designate a place at which an officer duly qualified to take testimony under the laws of the United States in a foreign country shall reside, where the witnesses shall be examined; it must be accompanied by a statement under oath that the motion is made in good faith, and not for the purpose of delay, or of vexing or harassing any party to the case; it must also set forth the names of the witnesses; the particular facts to which it is expected each will testify, and the grounds upon which is based the belief that each will so testify. It must appear that the testimony is material and competent, and that it cannot be taken in this country at all, or without hardship or injury to the moving party greatly exceeding that to which the opposite party will be exposed by the taking of such testimony abroad.

Upon the granting of such motion, a time will be set within which the moving party shall file in duplicate the interrogatories to be propounded to each witness, and serve a copy of the same upon each adverse party, who may, within a designated time, file, in duplicate, cross-interrogatories. Objections to any of the interrogatories or cross-interrogatories may be filed at any time before the depositions are taken, and such objections will be considered and determined upon the hearing of the case.

As soon as the interrogatories are in proper form the Commissioner will cause them to be forwarded to the officer (usually a United States Consul), with the request that, upon payment of, or satisfactory security for, his official fees, he notify the witnesses to appear and make answer thereto under oath; and that he reduce their answer to writing, and transmit the same under his official seal and signature to the Commissioner of Patents, with the certificate provided for in the preceding section.

By stipulation between the parties the testimony may be taken upon oral interrogatories by the parties or their agents.

MOTIONS.—NOTICES TO OPPONENTS.—During the interference proceedings any proper motions may be made by either party, after proper and reasonable notice thereof to all the adverse claimants. The practice follows the ordinary course of equity practice in the courts of the United States, see *Bell v. Gray*, 15 O. G. 776. Proof of the service of notice of all motions, and copies of motions, papers and affidavits, must be made before the motion will be entertained by the Patent Office. Notices may be given to the opposing party in either of the following ways:

(1), By delivering a copy of the notice to the adverse party or his attorney; (2), by leaving same at the usual place of business of the adverse party or his attorney with some one in his employment; (3), when such party has no usual place of business, by leaving such copy at his residence with a member of his family, over fourteen years of age, and of discretion; (4), transmission by registered letter; (5), by express. Such notice shall, with sworn proof of the fact, time, and mode of service thereof, be attached to the deposition or depositions.

TESTIMONY REQUIRED TO BE PRINTED.—The testimony is required to be printed, and six or more printed copies must be furnished for the use of the Patent Office and the opposing parties.

HEARING.—When the evidence is all in, a day is fixed by the examiner of interferences for the hearing, when oral arguments may be made by the parties or their attorneys.

After the arguments have been completed, no further hearing will be accorded to either party unless at the request of the tribunal having jurisdiction of the case.

JUDGMENT OF PRIORITY.—An interference once declared cannot be determined without a formal dissolution, or a judgment on the issue of priority, see *Hicks v. Keating*, 40 O. G. 343.

This judgment may be made upon the testimony, or upon the written concession of the parties, or upon the written declaration of either of the parties that he has abandoned his application, see *Tucker v. Kahler*, 15 O. G. 966; *Hammond v. Pratt*, 16 O. G. 1235. In rendering a judgment on the testimony the examiner follows the same rules which are recognized as binding in the courts.

Where all the parties are American inventors judgment must be awarded to the claimant who establishes the real priority of his inventive act. Where one invention was made within the United States, and the other was made in a foreign country, the American inventor is entitled to priority unless the foreign invention was known or used in the United States, or patented or published, before the conception of the invention by the American inventor. If one of two foreign inventors has obtained a foreign patent, he must prevail over his opponent, even though the other was in fact the first inventor. If both foreign inventors have obtained patents the earliest patentee is entitled to a patent; if neither has a foreign patent the one that first introduced the invention into the United States must prevail, see *Lander v. Crowell*, 16 O. G. 405. A foreign patentee stands like any other applicant until a contest begins, and must then prove his priority, *idem*. If neither party seems to be the original and first inventor, judgment should run against both of them, see *Wood v. Eames*, 17 O. G. 512.

Where the decision in favor of one applicant against another is not appealed from, or is sustained upon appeal, it is equivalent to a rejection of the defeated application, and a patent is awarded to the victorious applicant alone, for the matter in controversy, see *ex parte Gardner*, 17 O. G. 626. Where an applicant establishes priority against a patent, the result is the issue of another patent to the applicant.

Unless a judgment is appealed from it is conclusive upon all the parties, see *Whitely v. McCormick*, 10 O. G. 526.

An appeal may be taken from the examiner of interferences to the examiners-in-chief; from their decision to the Commissioner of Patents, and from his adverse decision to the Court of Appeals of the District of Columbia. (See Appeals.)

DISSOLUTION, SUSPENSION AND CONSOLIDATION OF INTERFERENCES.—An interference may be dissolved if the invention should be found unpatentable, see *Green v. Hall*, 37 O. G. 1475; if there is no real conflict between the claims of the applicants, see *Smith v. Winchell*, 13 O. G. 1127; if either party fails to show that he is a true inventor of the invention claimed, see *Taylor v. Martin*, 16 O. G. 138; or, if there was such irregularity in the institution of the interference as must render any judgment therein void, see *Barney v. Kellogg*, 17 O. G. 1096.

An interference may be suspended when the patentability of the invention is in doubt, see *Lynch v. Dryden*, 3 O. G. 407; when the invention is claimed to be abandoned by public use, see *Hedges v. Daniels*, 17 O. G. 152; or if it appears that the interference was irregularly declared, see *Bigelow v. Commissioner*, 7 O. G. 603; and the case will be remanded to the primary examiner for his consideration of such matters.

When several applications interfere with one another upon the same subject-matter, presenting but a single issue, the various reciprocal interferences may be consolidated and disposed of upon one proceeding, see *Bell v. Gray*, 15 O. G. 776.

NEW TRIALS.—New trials are granted in the Patent Office upon the same grounds, and with the same restrictions as in the courts, see *Stevens v. Putnam*, 18 O. G. 519. The principal grounds for a new trial are the discovery of new and important evidence, fraud, or mistake, in the former trial as to the real points at issue, see *Hibbard v. Richmond*, 17 O. G. 1155; *Stevens v. Putnam*, 18 O. G. 519; but no new trial will be granted for new evidence unless due diligence has been used, see *Rogers v. Bear*, 16 O. G. 908; or unless the new evidence will fix the date conclusively, see *Eccard v. Drawbaugh*, 24 O. G. 301.

ASSIGNEES.—When an inventor is unable or refuses to prosecute or defend his own claims to priority, or whenever the ends of justice would be otherwise defeated, an

assignee may be permitted to protect his rights in the invention as a party to the interference, upon motion duly made to the Commissioner, and satisfactory evidence that the necessity for such permission actually exists.

DECISIONS.—The following decisions will be found useful in interpreting this section of the Act :

Priority of conception, coupled with due diligence in reducing to practice, constitutes priority of invention, see *Wheeler v. Russell*, 1 O. G. 183. As between two rival inventors, he who first perfects the invention is entitled to the patent, and it cannot avail the other to refer back to crude experiments, *Browne v. Ludlow*, 2 Dec. Com., 16. A foreign inventor cannot on an interference with an American inventor have a commission issued to prove that his invention was made in a foreign country prior to the time when it was patented or published, see *Rumpff v. Kohler*, 23 O. G. 1831. A printed specification of a foreign patent is not competent evidence to prove the date of the invention or that the patentee was the inventor in his favor, see *Lander v. Crowell*, 16 O. G. 405. A foreign inventor cannot prove that he made or used his invention in a foreign country before the date of his patent for any purpose, see *ex parte Lanfrey*, 20 O. G. 892. If an American citizen makes an invention in a foreign country and there has it patented, the earliest date that can be given to his invention as against a rival inventor in this country, is the date of the foreign patent, see *Bell v. Brooks*, 19 O. G. 290. A foreign inventor may show that he made the invention known in this country prior to the date of any prior foreign patent cited against him, see *ex parte Lanfrey*, 20 O. G. 892 ; and in interferences the date of a foreign patented invention is the date of such patent as against an invention made in the United States, see *Chambers v. Duncan*, 10 O. G. 787. The date of a foreign invention may be shown by the date upon which knowledge of the invention was introduced into the United States by samples or otherwise, see *Hovey v. Hupeland*, 2 O. G. 493. Mere descriptions and destroyed drawings are not of much weight to show priority, see *Ware v. Bullock*, 7 O. G. 39.

AFFIDAVITS AND DEPOSITIONS.

SEC. 4905.—The Commissioner of Patents may establish rules for taking affidavits and depositions required in cases pending in the Patent Office, and such affidavits and depositions may be taken before any officer authorized by law to take depositions to be used in the courts of the United States or of the State where the officer resides.

The Commissioner has established the following rules under this section :—
Rules 66, 76, 87, 93, 110, 154, 155, 156, 158, 159, 160 and 162.

SUBPŒNA TO WITNESSES.

SEC. 4906.—The clerk of any court of the United States, for any district or Territory wherein testimony is to be taken for use in any contested case pending in the Patent Office, shall, upon the application of any party thereto, or of his agent or attorney, issue a subpœna for any witness residing or being within such district or Territory, commanding him to appear and testify before any officer in such district or Territory authorized to take depositions and affidavits, at any time and place in the subpœna stated. But no witness shall be required to attend at any place more than forty miles from the place where the subpœna is served upon him.

Rules of Practice, 1892.—160.

WITNESS FEES.

SEC. 4907.—Every witness duly subpœnaed and in attendance shall be allowed the same fees as are allowed to witnesses attending the courts of the United States.

PENALTY FOR FAILING TO ATTEND OR REFUSING TO TESTIFY.

SEC. 4908.—Whenever any witness, after being duly served with such subpoena, neglects or refuses to appear, or after appearing refuses to testify, the judge of the court whose clerk issued the subpoena may, on proof of such neglect or refusal, enforce obedience to the process, or punish the disobedience, as in other like cases. But no witness shall be deemed guilty of contempt for disobeying such subpoena, unless his fees and traveling expenses in going to, returning from, and one day's attendance at the place of examination, are paid or tendered him at the time of the service of the subpoena; nor for refusing to disclose any secret invention or discovery made or owned by himself.

APPEALS FROM PRIMARY EXAMINERS TO EXAMINERS-IN-CHIEF.

SEC. 4909.—Every applicant for a patent or for the re-issue of a patent, any of the claims of which have been twice rejected, and every party to an interference, may appeal from the decision of the primary examiner, or of the examiner in charge of interferences in such case, to the board of examiners-in-chief; having once paid the fee for such appeal.

Rules of Practice, 1892.—133 to 140, 141, 143, 146 and 147.

INTERLOCUTORY AND OTHER APPEALS DEFINED.—Appeals may be based either upon the decisions of the examiner as to matters of form, in which case they are taken to the Commissioner in person, and are called "interlocutory appeals," or from his decision as to some matter of substance, in which case the appeal lies to the board of examiners-in-chief. The question of joinder is a question of form, see *ex parte* Gillette, 44 O. G. 891; whether a claim is intelligible is a question of form, see *ex parte* Doten, 12 O. G. 841; whether a claim is functional is a question of form, see *ex parte* Barrett, 45 O. G. 125; matters of office practice are appealable only to the Commissioner, see *ex parte* Proudfit, 10 O. G. 585. Such questions may be decided upon interlocutory appeals to the Commissioner without fee. (See Rule 145.)

Questions as to the patentability of inventions, see *Burney v. Kellogg*, 17 O. G. 1096; whether an invention is a true combination, see *ex parte* Gillette, 44 O. G. 819; whether an invention is operative, see *ex parte* Kitson, 20 O. G. 1750; whether an invention is new, see *ex parte* Nagel, 17 O. G. 198; whether a cited reference is pertinent, see *ex parte* Kerr, 28 O. G. 95; whether an invention is useful, see *ex parte* Buchanan, 16 O. G. 1049; whether an invention has been abandoned, see *Jenkins v. Barney*, 3 O. G. 119; whether the drawings are sufficient, see *ex parte* Kitson, 20 O. G. 1750; whether the claim distinguishes the new from the old, see *ex parte* Reynolds, 6 O. G. 641; objections to the insertion of distinct claims for non-separable parts, see *ex parte* Gerard, 43 O. G. 1235; whether an invention is a design or a mechanical invention, see *ex parte* Schulze-Berge, 42 O. G. 293; whether an amendment departs from the original by inserting new matter, see *ex parte* Lanstrom, 17 O. G. 744; whether a re-issue application covers new matter, see *ex parte* Keith, 9 O. G. 744; are all questions of substance and appealable only to the examiners-in-chief. Appeals on matters of substance must be taken to the examiners-in-chief, see *ex parte* Baker, 36 O. G. 1149. The right of appeal from a second rejection is absolute, whatever be the cause of rejection, see *ex parte* Bennett, 35 O. G. 1003.

INTERLOCUTORY APPEALS.—An interlocutory appeal to the Commissioner must be in writing and set forth the decision complained of and the reasons for the appeal. The examiner is then required, within fifteen days before the day of hearing, to file an answer disclosing the grounds of his decision, see *ex parte* Jovè, 17 O. G. 801. (a copy of his answer must be furnished the applicant), and upon hearing had, either orally or otherwise, the Commissioner decides the question, affirming, reversing or modifying the action of the examiner. This decision is final, and can only be reviewed or reconsidered by the Commissioner himself.

APPEALS TO THE EXAMINERS-IN-CHIEF.—Before an appeal can be entertained, the claim or claims as originally filed, or if amended the amended claims, must have been twice rejected by the examiner, and all questions of form must have been conclusively settled. (See Rule 134.)

The appeal must be in writing, and set forth the points of the decision upon which it is taken. (See Rule 133.) Upon the filing of the appeal it is submitted to the examiner who, if he finds it to be regular in form, must within fifteen days from the filing thereof, furnish the examiners-in-chief with a written statement of the grounds of his decision on all the points involved in the appeal, with copies of the rejected claims, and the references applicable thereto. The examiner must also furnish the applicant with a copy of his statement. If the appeal is not regular in form, the applicant may amend it, or take an interlocutory appeal from the finding of the examiner to the Commissioner. (See Rule 135.)

The appellant must, before the day of hearing, file a brief of the authorities and arguments on which he will rely to maintain his appeal; and if he desires to be heard orally before the examiners-in-chief, he will so indicate when he files his appeal; a day of hearing will then be fixed, and due notice of the same given him; otherwise the appeal will be considered and decided by the examiners-in-chief upon the record and brief presented. (See Rules 136 and 137.) In contested cases the appellant has the right to make the opening and closing arguments unless otherwise ordered. (See Rule 138.)

The examiners-in-chief in their decision will affirm or reverse the decision of the primary examiner only on the points on which appeal shall have been taken. (See Rule 139*a*.) They must suggest anything they deem important either to the office or the applicant, see *ex parte* Dodge, 3 O. G. 179; but can make no recommendations as to points not within their jurisdiction, see *ex parte* Gillette, 44 O. G. 819. If they are of opinion that a different form of claim from that rejected should be allowed they should annex to their decision a statement to that effect, with such recommendation as they think best, but the examiner is not bound by such recommendation, see *ex parte* Dysart, 34 O. G. 1390. They are not required however to absolutely determine any form of claim to be passed on by the examiner, see *ex parte* Dysart, 34 O. G. 1390; primary examiners may refuse to act on the recommendation of the examiners-in-chief, but an appeal lies from such refusal, see *ex parte* Pearson, 40 O. G. 244. Where the examiners-in-chief make a "recommendation," the party may proffer the recommended matter to the primary examiner, and if he refuses, the Commissioner may order it, or the party may, after acceptance of the matter and a new rejection, appeal, see *ex parte* Holt, 38 O. G. 227. If new references are cited by an examiner, after an appeal to the examiners-in-chief, the applicant may again appeal without a new fee, unless the new references are based on his amendment, see *ex parte* Dysart, 34 O. G. 1390.

DILIGENCE IN FILING APPEAL.—In appealable cases in which no limit of appeal is fixed, no appeal will be entertained by any tribunal in the office unless taken within six months from the action which puts the case in condition for appeal, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable. (See Rule 134.)

APPEALS IN INTERFERENCE CASES.—In interference cases parties have the same remedy by appeal to the examiners-in-chief as in *ex parte* cases. Appeals in interference cases must be accompanied by brief statements of the reasons therefor; and parties will be required to file printed briefs of their arguments before the day of hearing.

FROM EXAMINERS-IN-CHIEF TO COMMISSIONER.

SEC. 4910.—If such party is dissatisfied with the decision of the examiners-in-chief, he may, on payment of the fee prescribed, appeal to the Commissioner in person.

Rules of Practice.—139 (c) (d), 140.

This appeal, like the former, is taken by a written petition setting forth the decision complained of and the reasons of appeal, and the procedure is practically the same.

If the Commissioner, in reviewing the decision of the examiners-in-chief, discovers any apparent grounds for granting or refusing letters patent not involved in the appeal, he will, before or after final judgment, and whenever in his opinion substantial justice shall require it, give reasonable notice to the parties; and if any amendment or action thereon be proposed, he will remand the case to the primary examiner for consideration, see *ex parte* Smoot, 11 O. G. 1010. The primary examiner may refuse to act on the recommendation of the Commissioner, and an appeal will lie from such refusal as in other cases, see *ex parte* Pearson, 40 O. G. 244.

DILIGENCE IN FILING APPEAL.—The same rule applies as in case of appeal to the examiners-in-chief. The appeal should be filed within six months from the action which puts the case in condition for appeal. (See Rule 134.)

APPEALS IN INTERFERENCE CASES.—Parties in interference may appeal from an adverse decision of the examiners-in-chief to the Commissioner of Patents, the procedure being the same as in other cases. Printed briefs should be filed before the day of hearing. See Act February 9, 1893, under Sec. 4914, *post*.

FROM THE COMMISSIONER TO THE SUPREME COURT, D. C.*

SEC. 4911.—If such party, except a party to an interference, is dissatisfied with the decision of the Commissioner, he may appeal to the Supreme Court of the District of Columbia, sitting in banc.*

NOTICE OF SUCH APPEAL.

SEC. 4912.—When an appeal is taken to the Supreme Court of the District of Columbia,* the appellant shall give notice thereof to the Commissioner, and file in the Patent Office within such time as the Commissioner shall appoint, his reasons of appeal, specifically set forth in writing.

PROCEEDINGS ON APPEAL TO SUPREME COURT.*

SEC. 4913.—The court shall, before hearing such appeal, give notice to the Commissioner of the time and place of the hearing, and on receiving such notice the Commissioner shall give notice of such time and place in such manner as the court may prescribe, to all parties who appear to be interested therein. The party appealing shall lay before the court certified copies of all the original papers and evidence in the case, and the Commissioner shall furnish the court with the grounds of his decision, fully set forth in writing, touching all the points involved by the reasons of appeal. And at the request of any party interested, or of the court, the Commissioner and the examiners may be examined under oath, in explanation of the principles of the thing for which a patent is demanded.

DETERMINATION OF SUCH APPEAL AND ITS EFFECT.

SEC. 4914.—The court, on petition, shall hear and determine such appeal, and revise the decision appealed from in a summary way, on the evidence produced before the Commissioner, at such early and convenient time as the court may appoint; and the revision shall be confined to the points set forth in the reasons of appeal. After hearing the case the court shall return to the Commissioner a certificate of its proceedings and decision, which shall be entered of record in the Patent Office, and shall govern the further proceedings in the case. But no opinion or decision of the court in any such case shall preclude any person interested from the right to contest the validity of such patent in any court wherein the same may be called in question.

ACT OF FEBRUARY 9, 1893.

AN ACT TO ESTABLISH A COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA,
AND FOR OTHER PURPOSES.

Sec. 9. That the determination of appeals from the decision of the Commissioner of Patents, now vested in the general term of the Supreme Court of the District of Columbia, in pursuance of the provisions of section seven hundred and eighty of the Revised Statutes of the United

* Now Court of Appeals of the District of Columbia, see Act of February 9, 1893, under Sec. 4914, p. 48, *post*.

States, relating to the District of Columbia, shall hereafter be and the same is hereby vested in the court of appeals created by this act; and in addition, any party aggrieved by the decision of the Commissioner of Patents in any interference case may appeal therefrom to said court of appeals.

Sec. 17. That all acts and parts of acts inconsistent herewith are hereby repealed.

See Rules of Practice, 1892.—148 to 150.

This appeal is taken by a written petition, duly signed and filed with the clerk of the court, accompanied by certified copies from the Patent Office of all the original papers and evidence in the case.

The petition should be filed and the docket-fee paid at least ten days before the commencement of the term of court at which the appeal is to be heard. *Pro forma* proceedings will not be had in the Patent Office for the purpose of securing to applicants an appeal to the Court of Appeals of the District of Columbia.

The hearing of appeals are subject to the usual rules of the court.

PATENTS OBTAINABLE BY BILL IN EQUITY.

SEC. 4915.—Whenever a patent on application is refused, either by the Commissioner of Patents or by the *Supreme Court of the District of Columbia upon appeal from the Commissioner, the applicant may have remedy by bill in equity; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim, or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the Commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication, and otherwise complying with the requirements of law. In all cases, where there is no opposing party, a copy of the bill shall be served on the Commissioner; and all the expenses of the proceeding shall be paid by the applicant, whether the final decision is in his favor or not. (See § 629, ¶ 9.)

An applicant in an *ex parte* case is not entitled to a bill in equity until he has exhausted his remedies by appeal, see *Kirk v. Commissioner*, 37 O. G. 451. Mandamus will lie where a patent is allowed by the office, but the Commissioner, without denying the right of the applicant, refuses to issue it, see *Butterworth v. Hoe*, 29 O. G. 615. Where the Patent Office rejects an application, and the remedies by appeal are exhausted, the remedy is by bill in equity, see *Hull v. Commissioner*, 7 O. G. 559. The power of the Circuit Court to grant a patent is independent of the powers of the Patent Office, see *Whipple v. Miner*, 23 O. G. 2236. It has been decided by the Supreme Court of the United States in *Butterworth v. Hill*, 31 O. G. 1043, that the Commissioner's official residence is at Washington, that he can be sued only in the District of Columbia, and that he cannot waive the question of jurisdiction by appearance, consent or default. Further, that a bill to obtain a patent must be brought in the Circuit Court for the District of Columbia, the courts of other districts having no power to enforce decrees against the Commissioner, see *Prentiss v. Ellsworth*, 27 O. G. 623. For the form of a bill to obtain a patent after rejection by the Patent Office, and other proceedings, see *ex parte Greeley*, 6 Fisher, 575.

A bill in equity may be heard on any issues and with any evidence, see *Butler v. Shaw*, 21 Fed. Rep. 321.

Delay in suing in equity for a patent is delay in prosecuting an application, and a petitioner, after a delay of more than two years since the last action, must allege and prove that the delay was unavoidable, see *Gandy v. Marble*, 39 O. G. 1423.

* Now Court of Appeals of the District of Columbia.

APPEALS FROM COMMISSIONER OF PATENTS.

SEC. 780.—The Supreme Court, sitting in banc, shall have jurisdiction of and shall hear and determine all appeals from the decisions of the Commissioner of Patents, in accordance with the provisions of section forty-nine hundred and eleven to section forty-nine hundred and fifteen, inclusive, of chapter one, Title LX, of the Revised Statutes, "Patents, Trademarks, and Copyrights." (See R. S. U. S., p. 958. See R. S. U. S., Sec. 699.)

These appeals are now heard by the Court of Appeals for the District of Columbia, see amending act of February 9, 1893, creating Court of Appeals for the District of Columbia, under Sec. 4914, *ante*.

See Rules of Practice, 1892.—148 to 150.

RE-ISSUE OF DEFECTIVE PATENTS.

SEC. 4916.—Whenever any patent is inoperative or invalid, by reason of a defective or insufficient specification, or by reason of the patentee claiming as his own invention or discovery more than he had a right to claim as new, if the error has arisen by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, the Commissioner shall, on the 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, or, in the case of his death or of an assignment of the whole or any undivided part of the original patent, then to his executors, administrators, or assigns, for the unexpired part of the 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. The specifications and claim in every such case shall be subject to revision and restriction in the same manner as original applications are. Every patent so re-issued, together with the corrected specifications, shall have the same effect and operation in law, on the trial of all actions for causes thereafter arising, as if the same had been originally filed in such corrected form; but 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 proof satisfactory to the Commissioner that such new matter or amendment was part of the original invention, and was omitted from the specification by inadvertence, accident, or mistake, as aforesaid.

Rules of Practice, 1892.—53, 63, 85 to 92, 94, 170.

Amendment of a patent by way of re-issue was introduced into the patent law as early as 1832; the act of 1836 introduced some slight changes but no substantial modification in the spirit or meaning of the law; the act of 1870 and the Revised Statutes of 1874 introduced other changes in the phraseology of the provisions of the law, but the conditions and procedure are substantially identical with those of the earlier acts.

RE-ISSUES DEFINED.—Defects in existing patents which may be cured by amendment fall into three classes: (1) Clerical errors. These may be corrected, without surrender and re-issue, by the action of the Patent Office, see *Reed v. Street*, 34 O. G. 339; Rule 170. (2) Errors consisting of an excess of claim. These may also be cured

without surrender and re-issue of the patent, by way of disclaimer, see Section 4917 and notes, *post*. (3) Errors relating to the substance of the grant, whether excess, deficiency or misstatement. Errors of the latter kind can be removed only by re-issue.

The doctrines of the law with reference to re-issues may be resolved into the following propositions: (1) The sole object of a re-issue is to so amend an imperfect existing patent that it may disclose and protect the invention which it was the purpose of that patent to secure to its inventor. (2) It being an amendment of an existing patent, not the grant of a new patent, it must be confined to the invention which the patentee attempted to describe and claim in his original patent. (3) This amendment cannot be allowed unless the imperfections in the original patent arose without fraud, and from inadvertence, accident or mistake. (4) When the amendment is allowable it can be made in any form, and to any extent that may be necessary to render the patent effective for the protection of the original invention. (5) If the re-issue is allowed the original patent must be surrendered and cancelled, and an amended patent will be issued in place thereof, see *Wilson on Patents*, § 659. See also Rule 85.

“Inadvertence,” signifies want of attention; “mistake,” want of knowledge; “accident,” circumstances against which the inventor cannot guard.

Matter shown and described in an unexpired patent, and which might have been lawfully claimed therein, but which was not so claimed by reason of a defect or insufficiency in the specification, arising from inadvertence, accident or mistake, and without fraud or deceptive intent, cannot be subsequently claimed by the patentee in a separate patent, but only in a re-issue of the original patent. (See Rule 92.)

A re-issued patent supersedes the original; it is a new contract between the United States and the party who obtains it, see *Goodyear v. Providence Rubber Co.*, 2 Clifford, 351; it is not a new patent however, it is a continuation of the original patent, see *Shaw v. Colwell Lead Co.*, 11 Fed. Rep. 711.

APPLICANTS FOR RE-ISSUE, WHO MAY BE.—The application for a re-issue must be made by the inventor if he be alive, see Section 4895, Rule 85; on his own behalf if he is still the owner of the entire patent, and on behalf of the real owners if he has assigned the whole or any part of the patent, and in the latter case the application must be accompanied by the written assent of such assignee, see *ex parte Wright*, 10 O. G. 587; Rule 85. If the inventor be dead, the application may be made by the executor, see *Carew v. Boston Elastic Fabric Co.*, 1 O. G. 91; the administrator, see *Northwestern Fire Extinguisher Co. v. Phila. Fire Ex. Co.*, 6 O. G. 34; or by an assignee of any degree, however remote from the original inventor, see *Selden v. Self-Lighting Gas Burner Co.*, 20 O. G. 1377. A re-issue may, if the inventor be dead, be obtained in his own name by the assignee of the executor or administrator of the patentee, see *Carew v. Boston Elastic Fabric Co.*, 1 Holmes, 45. A patentee cannot affect the interest of his assignee by any surrender for re-issue, see *Burns v. Morgan*, 8 Hun., 703, as the surrender of an assigned patent is not valid unless made by the assignee, or with his consent, see *ex parte Wright*, 10 O. G. 587. No re-issue can affect the rights of non-assenting owners or other third parties, see *Potter v. Braunsdorf*, 7 Blatch., 97. A re-issue obtained by an inventor without the assent of the assignees is valid or invalid as they may elect. They may ratify it and enjoy the advantages arising from it, though issued only in his name, or they may repudiate it, and compel him to obtain another, or they may insist upon their privileges under the original patent, see *Potter v. Holland*, 4 Blatch., 206. A re-issue to the patentee is, however, a bar to a re-issue to an unrecorded assignee, see *Whitely v. Fisher*, 4 Fisher, 248. It should also be noted that third parties ratify the re-issue by using or selling goods under it, see *Meyer v. Bailey*, 8 O. G. 437.

THE APPLICATION.—A complete application for the re-issue of a patent comprises: (1) A petition, with power of attorney, if an attorney is appointed. (2) A specification, signed by the applicant and two witnesses. (3) A drawing, if the invention can be illustrated, made upon the same or a larger scale than the original drawing, unless a reduction of scale is authorized by the Commissioner, see Rule 53. (4) An oath which must fulfill all the requirements prescribed for oaths in case of original applications, and in addition it must also aver:

- (a.) That applicant verily believes the original patent to be inoperative or invalid, and the reason why.
- (b.) When it is claimed that such patent is so inoperative or invalid “by reason of a defective or insufficient specification,” particularly specifying such defects or insufficiencies.
- (c.) When it is claimed that such patent is inoperative or invalid “by reason of the patentee claiming as his own invention or discovery more than he had a right to claim as new,” distinctly specifying the part or parts so alleged to have been improperly claimed as new.

- (d.) Particularly specifying the errors which it is claimed constitute the inadvertence, accident, or mistake relied upon, and how they arose or occurred.
- (e.) That said errors arose "without any fraudulent or deceptive intention" on the part of the applicant.

(5) A certified copy of the abstract of title, giving the names of all assignees owning any individual interest in the patent. (6) The original patent, or, if this has been lost, an affidavit to that effect, and a certified copy of the patent. (7) The assent of the assignees, if there be any. (8) If the applicant be an executor or administrator, a duly certified copy of the letters testamentary, or of administration, must be annexed to the other papers, or, if the applicant is an assignee, proof of title.

THE SPECIFICATION.—The amended specification must correspond with the original specification unless there is some sufficient reason for a change. In *ex parte* Underwood, 1 O. G. 549, Leggett, Com., said: "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, but in applications for re-issues a different rule does and should prevail. The applicant should be held rigidly to the language adopted in his patent, except that a good reason appears for departing from such language. In objecting to the use of new terms, new descriptive matter, etc., the examiner is not bound to give reasons. It is enough that such terms and descriptive matter is new; and it devolves upon the applicant to show good reason for their introduction, or they must be stricken out. A different rule 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 in the art to which his invention pertains, and might thus appropriate to his own use the improvements and inventions made by others. The rule should be: *Liberality with original applications; strict construction with applications for re-issues.*" See also *Hatch v. Moffitt*, 15 Fed. Rep. 252. The specification of the re-issue may be made more full and precise than the original, in order to cover the real invention, see *Washburn & Moen Mfg. Co. v. Haish*, 19 O. G. 173; or may be changed to cure defects or insufficiencies, but should otherwise agree with the original specification in all particulars.

PROCEDURE IN RE-ISSUE CASES.—The procedure in re-issue cases is practically the same as in case of original applications. An examination is made both as to form and substance, and the entire application will be revised and restricted as in other cases (see Rule 90). Even if the validity of the original patent has been sustained by the courts, the Patent Office will conduct the usual examination as to novelty, utility, abandonment and the priority of the applicant's inventive act (see *ex parte* Cox, 3 O. G. 2). The novelty of the invention is determined according to the state of the art at the date of the original application, not at that of the re-issue, see *Carroll v. Morse*, 9 O. G. 453. Its utility is measured by the usual standards. Abandonment is questioned: if there had been two years' public use of the invention before the original application was filed, it will be fatal, see *Funck v. Doty*, 14 O. G. 157.

The practice in regard to objections, references, amendments, arguments, rejections, appeals, and interferences, is similar to that in cases of original applications.

Division may be required, and single original patents may be re-issued in several divisions, see *Giant Powder Co. v. Safety Nitro-Powder Co.*, 27 O. G. 59; *New v. Warren*, 22 O. G. 587; and in this case each division constitutes the subject of a separate specification descriptive of the part or parts of the invention claimed in such division, and the drawings may represent only such parts. A separate fee is required for each divisional application as well as the original application for the re-issue. Unless otherwise ordered by the Commissioner, all of the divisions of a re-issue will issue simultaneously; if there be any controversy as to one division, the others will be withheld from issue until the controversy is ended, unless the Commissioner shall otherwise order, see Rule 89. Where an original patent is thus divided, each division is treated as a separate claim under one patent, see *Penna. Salt Mfg. Co. v. Thomas*, 5 Fisher, 148; each division stands by itself as for a separate invention, see *Brown v. Selby*, 4 Fisher, 363, and one division may be valid though the others are void, see *Atwood v. Portland Co.*, 16 Fed. Rep. 283.

SURRENDER OF ORIGINAL PATENT.—ITS EFFECTS.—The original patent is required to be surrendered with the application for the re-issue, see Rule 91, but the surrender, as a matter of law and of fact, only takes effect from the date of the re-issue, see *Peck v. Collins*, 19 O. G. 1137. The surrender must be made with the concurrence of all the owners of the original patent, see *Meyer v. Bailey*, 8 O. G. 437. Grantees and licensees are not, however, so interested that their concurrence is necessary to the validity of the surrender and

re-issue. Local or individual rights acquired under the former patent remain unaffected by its surrender until the parties in whom such rights are vested voluntarily relinquish them and accept new rights under the re-issue. The original patent may thus be in force as to grantees and licensees in some portions of the United States, although as to the owners of the patent, and in other sections of the country, the re-issued patent alone is in force, see *Potter v. Holland*, 4 Blatch., 206; *Meyer v. Bailey*, 8 O. G. 437.

All rights of action under the original patent expire with its surrender and re-issue, see *Jones v. Barker*, 22 O. G. 771. The surrender is, however, not an acknowledgment that the surrendered patent was entirely void, and a surrender cannot affect rights previously acquired, see *Potter v. Holland*, 4 Blatch., 206, and, therefore, while no suit can be maintained under the original patent, nor any infringement of it be made the ground of a recovery, all closed transactions under it remain undisturbed, see *McBurney v. Goodyear*, 11 Cush. 509. Judgments obtained upon it are not vacated, see *Mers v. Conover*, 11 O. G. 1111. Moneys paid under it cannot be recovered, see *Moffitt v. Gaar*, 1 Blatch., 273. An infringement commenced before the surrender is not sanctioned by the surrender, and if it continues after the re-issue, an action may be instituted on the latter patent, and damages accruing from the date of the re-issue be obtained, see *McWilliams Mfg. Co. v. Blundell*, 22 O. G. 117; *Bliss v. Brooklyn*, 4 Fisher, 596.

WITHDRAWAL OF RE-ISSUE APPLICATIONS.—The filing of an application for the re-issue of a patent does not preclude the applicant from abandoning such application, and from resuming his rights under the original patent. As we have just seen, the surrender of the original patent does not take effect until the date of the re-issue. Therefore the applicant may, at any time before the re-issue has been granted, withdraw his application, revoke his surrender, and be restored to his original position, see *Forbes v. Barstow Stove Co.*, 2 Clifford, 379.

DATE AND TERM OF RE-ISSUED PATENT.—A re-issued patent bears the date of the original patent for all purposes, except as the foundation of an action for infringement. It lives during the remainder of the unexpired term of the original patent. All rights of action under the original patent are extinguished with the surrender of the original patent. Rights of action under the re-issued patent commence from the date of the re-issue. The terms of the original and re-issued patents are continuous and uninterrupted, the grant being for seventeen years, unless limited by a prior foreign patent.

LIMITS OF RE-ISSUE, DILIGENCE, DECISIONS.—The United States Supreme Court in 1882 rendered a decision (*Miller v. Bridgeport Brass Co.*, 21 O. G. 201) of great importance, which practically changed the entire practice with respect to re-issues. Prior to this decision it was accepted law that a patentee could, at any time during the life of his patent, re-issue it, and could not only correct any mistakes in the drawings and specifications, but also so broaden his claims as to cover anything which was shown or described in the original patent, or in the model accompanying the application. This was true, even though he had not indicated in his original patent that the matter claimed in his re-issue was his invention; so long as it was either shown in the drawings or model, or described in the specification, it was sufficient. At the same time it was well settled that a re-issue could not claim a different invention from what was described in the original patent, see *Siebert Cyl. Oil Cup Co. v. Harper Steam Lub. Co.*, 4 Fed. Rep. 328; *Putnam v. Tinkham*, 4 Fed. Rep. 411; *Giant Powder Co. v. Cal. Vigoret Pow. Co.*, 4 Fed. Rep. 720; *Flower v. Raynor*, 5 Fed. Rep. 791. The position taken by the Supreme Court in the case of *Miller v. Bridgeport Brass Co.* is in substance as follows: A patentee cannot broaden his claims by re-issue, unless the application for re-issue is made with diligence, and with no unreasonable delay after the issue of the original patent, and before other parties are in the field with modifications or improvements which the re-issue would cover; that if a patentee omits or neglects to claim that part of the invention that he shows or describes, he must make separate application for such part, otherwise he dedicates to the public all that he has not claimed; and that after the lapse of years a patentee may not change the ground of his invention by re-issue, even though he technically and literally narrows his claim.

The Supreme Court has not specifically said, nor can it say, how long a patentee shall be allowed to wait before filing his application for a re-issue for the purpose of broadening his claims; what constitutes unreasonable delay in any particular case will depend upon the facts of that case; and a time that would be reasonable and permissible under one set of facts will be unreasonable and unpermissible under a different set of circumstances. In *Ives v. Sargent*, 38 O. G. 781, it was held that an excuse for a delay longer than two years must be clearly shown; in *Arnheim v. Finster*, 84 O. G. 700, that where the error, if any, is apparent, and the articles claimed in the re-issue have gone into the market, twenty-two months is too long a delay; and in *Coon v. Wilson*, 30 O. G.

889, that a delay of three months is unreasonable where the defects are clear and other claimants intervene, if the only object is to enlarge the claims.

The invention claimed in the re-issue must be the identical invention shown and described, and that the inventor attempted to claim in the original patent; that and nothing more. In *Powder Co. v. Powder Works*, 98 U. S. 126, Bradley, J., said: "The specification may be amended so as to make it more clear and distinct; the claim may be modified so as to make it more conformable to the exact rights of the patentee; but the invention must remain the same." A re-issue cannot be expanded so as to claim matters which the patentee did not see fit to claim in the original, see *Fay v. Fraser*, 14 Fed. Rep. 652. Claims in a re-issue which expressly enlarge the invention claimed in the original are void, see *Curtis v. Branch*, 15 O. G. 919. The office of a re-issue is to correct a claim, not to enlarge it, see *Russell v. Dodge*, 11 O. G. 151.

A re-issue cannot claim either another invention or a broader invention than the one attempted to be described and claimed in the original patent, see *Worden v. Searls*, 39 O. G. 359; *ex parte Herr*, 41 O. G. 463. A re-issue is intended to cover the invention which the inventor actually made and attempted to protect in the original, see *Eames v. Andrews*, 39 O. G. 1319, and if no attempt was made to secure the invention in the original patent, it cannot be embraced in a re-issue, see *Hoskin v. Fisher*, 43 O. G. 509. A re-issue is intended to cure the inevitable defects of statement, see *Blake v. Stafford*, 6 Blatch., 195, and may correct but cannot alter, see *Doane & Wellington Mfg. Co. v. Smith*, 24 O. G. 302.

A void patent cannot be re-issued, see *Marsh v. Nichols*, 34 O. G. 901. A joint patent for a sole invention being invalid, no re-issue of it can be granted, see *ex parte Benton*, 23 O. G. 341. An expired patent cannot be re-issued, see *ex parte Siemens*, 11 O. G. 1107.

Where an original patent is valid and operative to the extent of its claims, there is no reason for the re-issue and the re-issue is void, see *Giant Powder Co. v. Cal. Vigorit Powder Co.*, 18 O. G. 1339. Where the description is not full and clear a re-issue is needed, see *Sewing Mach. Co. v. Frame*, 28 O. G. 96. Where the original patent covers but one form of the invention it cannot re-issue to cover other forms, see *Steam Gauge & Lantern Co. v. Miller*, 11 Fed. Rep. 718. A re-issue cannot cover new matter, see *Ives v. Sargent*, 38 O. G. 781. To cover a new invention by suppressing parts of the old is not allowable, see *Matthews v. Iron Clad Mfg. Co.*, 42 O. G. 827. An error in judgment as to what the patent shall cover, or in conclusions of facts, is no ground for re-issue, see *ex parte Malenken*, 49 O. G. 915. Where an American patent claimed several devices covered by separate foreign patents, of which some were expired, the devices covered by the expired patents can be excluded from the American patent by re-issue, and the patent be valid for the rest, see *ex parte Pulvermacher*, 10 O. G. 2.

A re-issue cannot claim matters for which the original has expired by reason of its limitation by a foreign patent, see *ex parte Siemens*, 11 O. G. 1107.

A re-issue cannot claim matters inconsistent with the specification, drawings, and model of the original, even though the same matters were claimed in the original patent, see *ex parte Warren*, 10 O. G. 1.

When the original patent does not describe the real invention, the remedy is by a new application and patent, not by re-issue, see *James v. Campbell*, 21 O. G. 337. The fact that a device is not mentioned in the original is evidence that a re-issue which claims it is for a different invention, see *Campbell v. James*, 18 O. G. 979.

Fraud, actual or constructive, renders a re-issue void, see *Swift v. Whisen*, 3 Fisher, 343.

The statements of an inventor in his original patent, as to the nature and scope of his invention, are binding upon him, see *James v. Campbell*, 21 O. G. 337; matters disclaimed in the original cannot be claimed in the re-issue, see *Bucher Mfg. Co. v. Atwater Mfg. Co.*, 31 O. G. 1306; the omission from the re-issue of the limitations inserted in the original, renders the re-issue void, see *Searle v. Bouton*, 22 O. G. 946.

The original claims may be reproduced in a re-issue without reference to delay, see *Yale Lock Co. v. Sargent*, 35 O. G. 497, but a re-issue cannot include claims abandoned in the first application, see *Streib v. Lauter*, 11 Fed. Rep. 309; nor claims which were withdrawn from the original in order to secure its issue, see *Shepard v. Carrigan*, 34 O. G. 1157, nor where such claim was withdrawn to escape an interference, see *Lee v. Walsh*, 15 O. G. 563. The greater the discrepancy the shorter should be the delay in applying for re issue, see *Mahn v. Harwood*, 30 O. G. 657.

Successive re issues may be allowed, until the actual invention receives the desired protection, see *Selden v. Stockwell Self-Lighting Gas Burner Co.*, 20 O. G. 1377. If a re-issue is void, the original may be re-issued in its exact language and be valid, see *Giant Powder Co. v. Safety Nitro-Powder Co.*, 27 O. G. 99. The original patent cannot

be revived by merely disclaiming all changes made by the re-issue, but a new re-issue must be obtained, see *McMurray v. Mallory*, 27 O. G. 915. Where there are several re-issues of the same patent the law always presumes that each was necessary to cure defects, see *Union Paper Collar Co. v. White*, 7 O. G. 698, 877.

DISCLAIMER.

SEC. 4917. Whenever, through inadvertence, accident or mistake, and without any fraudulent or deceptive intention, a patentee has claimed more than that of which he was the original or first inventor or discoverer, his patent shall be valid for all that part which is truly and justly his own, provided the same is a material or substantial part of the thing patented; and any such patentee, his heirs or assigns, whether of the whole or any sectional interest therein, may, on payment of the fee required by law, make disclaimer of such parts of the thing patented as he shall not choose to claim or to hold by virtue of the patent or assignment, stating therein the extent of his interest in such patent. Such disclaimer shall be in writing, attested by one or more witnesses, and recorded in the Patent Office; and it shall thereafter be considered as part of the original specification to the extent of the interest possessed by the claimant and by those claiming under him after the record thereof. But no such disclaimer shall affect any action pending at the time of its being filed, except so far as may relate to the question of unreasonable neglect or delay in filing it.

Rules of Practice, 1892.—195, 196.

A disclaimer is necessary when too much has been claimed, see *Seymour v. McCormick*, 19 How. 96. The filing of a disclaimer is a simple, expeditious and inexpensive method of curing a defect that, in its nature, is fatal to a patent. If an inventor knowingly inserts a claim in his patent covering more than is of his invention, it is a fraud which will invalidate the grant; if he knowingly persists in the claim after he has discovered that it is without foundation, it is a fraud which forfeits all his rights to the protection of any part of the invention covered by the patent, see *Robinson on Patents*, § 642.

A claim is excessive when it claims any material act or thing beyond the scope of the real invention, or more than what the inventor has shown and described in his specification, drawings and model. In *O'Reilly v. Morse*, 15 How. 62, Taney, C. J., said: "Whether, therefore, the patent is illegal in part because he claims more than he has sufficiently described, or more than he invented, he must in either case disclaim, in order to save the portion to which he is entitled." A disclaimer is necessary, however, only when the thing claimed is a material and substantial part of the art or machine invented, see *Hall v. Wiles*, 2 Blatch, 194. It should also be observed that an excessive claim is amendable only when the defect arose through mistake and without fraud, see *Schillinger v. Gunther*, 17 Blatch., 66; also, that where a foreign patent contains a disclaimer of certain features, the American patent should be limited in the same way, see *Ashroft v. Boston & Lowell R. R. Co.*, 13 O. G. 865; that a device actually discarded in practice ought to be disclaimed, see *ex parte Marsh*, 2 O. G. 197; that a disclaimer is a nullity unless the original claim is actually excessive, see *Sharp v. Tiff*, 17 O. G. 1282; that a disclaimer only affects the excess which it eliminates from the claim, neither affecting such other claims of the patent as by themselves are valid, nor the force of what is not disclaimed, see *O'Reilly v. Morse*, 15 How. 62; *White v. Gleason Mfg. Co.*, 24 O. G. 265; that it is not a method by which a defective description may be amended, see *Hailes v. Albany Stove Co.*, 123 U. S. 582; that a disclaimer may be filed after a patent has been adjudged invalid, see *Morgan v. Seaward*, 2 Carp. P. C. 104; but cannot be filed after the patent has expired, see *Yale Lock Mfg. Co. v. Sargent*, 35 O. G. 497.

DISCLAIMER. BY WHOM MADE.—A disclaimer may be filed by any party owning the entire patent, or the entire interest in any specified territory, the effect of the disclaimer being commensurate with the interest in the patent owned by the party filing same. The original patentee cannot disclaim after he has parted with his entire title to the

patent, see *Myers v. Frame*, 4 Fisher, 493. An owner of an undivided interest cannot disclaim, and thus change the form of the patent, without the co-operation of the other owners of the same interest in the patent.

If the owner of a territorial or sectional interest files a disclaimer, it will limit and define his rights within the territory owned by him, while at the same time, the owners of other sectional interests may hold under the patent in its original form, see *Potter v. Holland*, 1 Fisher, 327. Thus the same patent may be operative, in terms at least, to different extents in different sections of the United States, and may be valid as to diligent disclaimants, though void as to other owners who have unreasonably neglected to disclaim, see *idem*.

DISCLAIMER.—HOW MADE.—A disclaimer must be in writing, signed by the party making it, attested by one or more witnesses, and recorded in the Patent Office. It must state the precise interest of the disclaimant in the patent, see *Foote v. Silsby*, 1 Blatch. 445; clearly and exactly set out the excess to be disclaimed, and aver that such excess was included in the patent through inadvertence, accident or mistake, see *Schillinger v. Gunther*, 16 O. G. 905.

DILIGENCE.—Disclaimers must be filed without unreasonable delay. "Unreasonable delay" avoids the good effects of a disclaimer, see *Tuck v. Bramhill*, 6 Blatch. 95. In *Singer v. Walmsley*, 1 Fisher, 558, Giles, J., said: "'What is unreasonable delay' is a question to be settled by the court and not for the jury. * * * The court will find that the time, in reference to the question of delay, commences where the knowledge was brought home to the party that he was not the first inventor, or when it is decided by a court, of competent jurisdiction to settle the question, that he was not the first inventor; then it is that the time commences to run, and not till then," and in *Yale Lock Mfg. Co. v. Sargent*, it was held: that the allowance of claims by the Patent Office is such evidence of that validity that the patentee may rely upon it until the courts have decided to the contrary, unless of course, the knowledge is brought home to him in some other way.

EFFECT OF DISCLAIMER UPON PENDING SUITS.—No disclaimer can affect any action pending at the time of filing the same, except as to the question of unreasonable delay in filing it. This provision of the act should not be understood to mean that the claim of the patent must be construed, for the purpose of such action, as if no disclaimer had been filed. In *Tuck v. Bramhill*, 3 Fisher, 400, Blatchford, J., said: "I understand that provision to mean that a suit pending when a disclaimer is filed is not to be affected by such filing, so as to prevent the plaintiff from recovering in it, unless it appears that the plaintiff neglected or delayed to file the disclaimer. * * * It follows that if a disclaimer is made after suit brought, the plaintiff may still recover, but without costs." An excessive claim inserted by mistake, may be disclaimed pending suit, and the suit saved, though without costs, see *Matthews v. Spangenberg*, 23 O. G. 92; a disclaimer being filed during suit, the plaintiff can recover no costs, see *Hayes v. Bickelhaupt*, 32 O. G. 133.

SUITS TOUCHING INTERFERING PATENTS.

SEC. 4918. Whenever there are interfering patents, any person interested in any one of them, or in the working of the invention claimed under either of them, may have relief against the interfering patentee, and all parties interested under him, by suit in equity against the owners of the interfering patent; and the court, on notice to adverse parties, and other due proceedings had according to the course of equity, may adjudge and declare either of the patents void in whole or in part, or inoperative, or invalid in any particular part of the United States, according to the interest of the parties in the patent or the invention patented. But no such judgment or adjudication shall affect the right of any person except the parties to the suit and those deriving title under them subsequent to the rendition of such judgment.

The proceeding contemplated by this section is an ordinary proceeding in chancery. It is not a summary proceeding, it is an adversary proceeding, in which the party must file the usual bill in chancery and issue the subpoena required by chancery practice, see *L. & M. Tobacco Co. v. Miller*, 17 O. G. 798. A bill to annul a patent must be brought in the district in which the defendant resides or is found, see *Prentiss v. Ellsworth*, 27 O. G. 623. In such a suit the defendant is not compelled to file a cross-bill in order to

obtain affirmative relief, and if he does so it may be dismissed without costs, see *Am. Clay Bird Co. v. Legowski Clay Pigeon Co.*, 31 Fed. Rep. 466. Upon such a suit the question of priority of invention is the only point in controversy, and judgment is awarded to the party which establishes the fact that he is the first inventor, or to the party who derives his title from the first inventor, see *Sawyer v. Massey*, 25 Fed. Rep. 144, and the court may declare either of the patents void, in whole or in part, or inoperative or invalid, and as to any particular portion of the United States, according to the interests of the parties in the patent, or the invention patented, see *Foster v. Lindsay*, 8 O. G. 1032. In such cases, the defendant's patent may be defeated, although the plaintiff's patent is void, being anticipated by his own prior patents, see *American Clay Bird Co. v. Legowski Clay Pigeon Co.*, 31 Fed. Rep. 466. The judgment binds only the parties to the suit and their subsequent assignees, see *Mowry v. Whitney*, 1 O. G. 499. Two patents interfere within the meaning of this section when they claim the same invention in whole or in part, see *Gold & Silver Ore Co. v. U. S. Ore Co.*, 3 Fish, 489.

SUITS FOR INFRINGEMENT; DAMAGES.

SEC. 4919. Damages for the infringement of any patent may be recovered by action on the case, in the name of the party interested either as patentee, assignee, or grantee. And whenever in any such action a verdict is rendered for the plaintiff, the court may enter judgment thereon for any sum above the amount found by the verdict as the actual damages sustained, according to the circumstances of the case, not exceeding three times the amount of such verdict, together with the costs.

See Rev. Stat., Secs. 629, 690, 699, 711 and notes, *ante*.

INFRINGEMENT DEFINED.—The statute confers upon the patentee and his assigns the exclusive right to make, to use, or to sell to others to be used, the patented article. An infringement is a copy made after and agreeing substantially and in principle with the article described in the letters patent. It is therefore an infringement to make or manufacture a patented article, though it is never used by the maker. It is likewise an infringement to sell to others the article when it is manufactured by another. The law vests the exclusive right to do all these three things in the patentee, and hence for another to do any one or all of them is an infringement, see *Haselden v. Ogden*, 3 Fish, 378. It is not necessary that the defendant's machine should be an exact copy of the patentee's machine. All that is required is that the defendant's machine should be substantially like the patentee's machine, see *Waterbury Brass Co. v. N. Y. Brass Co.*, 3 Fish, 43; so long as the patentee's ideas are found in the construction and arrangement, no matter what may be its form, or shape, or appearance, the party using it is appropriating his invention, and must be held to be an infringer, see *Potter v. Wilson*, 2 Fish, 102. The question of infringement is one irrespective of motive. The defendant may have infringed without intending, or even knowing it, but he is not, on that account, the less an infringer, see *Parker v. Hulme*, 1 Fish, 44. An imperfect infringement, because the machine is imperfect, is still an infringement, *Union Paper Bag Co. v. Binney*, 5 Fish, 166.

The statute does not, and was not intended to operate beyond the limits of the United States. The patentee's right of property and exclusive use cannot extend beyond the limits of the law itself. The use of the invention beyond the limits of the United States is not an infringement of his rights. His rights do not extend to a foreign vessel entering one of our ports, and the use of the invention in the construction, fitting out, or equipment of such vessel while she is coming into or going out of a port of the United States, is not an infringement of the rights of an American patentee, provided it was placed upon her in a foreign port, and authorized by the laws of the country to which she belongs, see *Brown v. Duchesne*, 19 How. 183. The jurisdiction of the United States extends to the decks of American vessels on the high seas, however, as much as it does to all the territory of the country, and the use of a thing patented on such vessels is an infringement, see *Gardiner v. How*, 2 Cliff. 462.

PARTIES. INFRINGERS.—Any person, whether natural or artificial, may infringe a patent. Even the government of the United States cannot employ an invention, or grant to others the right to practice it without the permission of the patentee, see *James v. Campbell*, 104 U. S. 356; *Palmer v. U. S.*, 20 Ct. of Claims, 432. A municipal corporation or other public body is responsible for acts of infringement performed by its officers

and agents for its benefit, see *Bliss v. City of Brooklyn*, 4 Fisher, 596. A private corporation infringes by any act of its agents or employees, authorized or ratified by it, which wrongfully appropriates a patented invention, see *Poppenhusen v. New York Gutta-Percha Comb Co.*, 2 Fisher, 62. How far the officers, stockholders, and employees of a private corporation participate in its infringing acts and share its liability is still an open question. A joint-owner of a patent may be an infringer if he employs an infringing device, see *Millers Falls Co. v. Ives*, 14 O. G. 203. An assignor or grantor who has parted with all his right to use an invention within a specified territory, becomes an infringer if he employs the invention within that territory, as does a grantee or licensee who practices the invention outside of the territory owned by him, and, as does either of the above parties who makes, uses or sells an infringing device. All private individuals who voluntarily engage in the unauthorized manufacture, use, or sale of a patented invention, whether by itself, or as part of some more comprehensive instrument or art, are guilty of an infringement. A voluntary maker is an infringer though he is employed by another to do so, see *Bryce v. Dorr*, 3 McLean, 582; a lunatic may infringe and be liable for profits and costs, see *Avery v. Wilson*, 20 Fed. Rep. 856; infants and married women are also liable for damages for infringement, see *Robinson on Patents*, § 947.

PARTIES. WHO MAY BRING SUIT.—The plaintiff must be the person or persons in whom the legal title to the patent vested at the time of the infringement, see *Gamewell Fire Alarm Tel. Co. v. City of Brooklyn*, 22 O. G. 1978, except where the right of action was assigned together with the title to the patent; in this case the present owner of the monopoly may bring suit for an infringement committed during the ownership of his assignor, as well as for infringements during his own ownership. It follows, therefore, that the patentee, his assignee, his grantee, or his personal representatives only are able to maintain an action for infringement in a court of law; neither licensees, see *Birdsell v. Shaliol*, 112 U. S. 485, nor those who, under contract with the legal owners, have acquired an equitable title to the patent, see *Sanford v. Messer*, 5 Fisher, 411, can maintain a suit for infringement of a patent in their own names; the patentee may sue in behalf of the licensee, see *Goodyear v. McBurney*, 3 Blatch. 32, or the licensee can sue in the name of his licensor, see *Birdsell v. Shaliol*, 30 O. G. 261, but in the latter case only for such infringements as affect his own rights under the patent, see *Hayward v. Andrews*, 23 O. G. 533. A stipulation by the licensor to sue infringers does not compel the licensees to look to him on his covenants, but they may institute suits in his name against infringers, see *Goodyear v. Bishop*, 2 Fisher, 96. If the owner of a patent will not sue or cannot be found, the licensee may use his name in a suit at law, and probably in equity also, see *Wilson v. Chickering*, 23 O. G. 1730. A patentee is not obliged to sue after an assignment of his rights, see *Bicknell v. Todd*, 5 McLean, 236.

Equitable owners of patents or of interests therein, can only obtain relief in a court of equity.

No legal title exists in any one until the patent issues, see *Pontiac Knit Boot Co. v. Merino Shoe Co.*, 31 Fed. Rep. 89.

Until a patentee assigns his patent, or until it is vested in his executor or administrator at his death, all suits at law upon it must be brought in his name, see *Wheeler v. McCormick*, 4 O. G. 692. After he has transferred it he may still sue for infringements committed during his ownership, see *Moore v. Marsh*, 7 Wall, 515, and if his assignment covers only an undivided interest he must join with his assignee in suits arising out of subsequent infringements. In case of a joint patent, and in all cases of joint ownership, whatever be the exact relationship of the parties, all the patentees or co-owners must be made plaintiffs, see *Moore v. Marsh*, 7 Wall, 515; and this is so, even if one of two joint owners has assigned his interest since the infringement was committed, see *Spring v. Domestic Sew. Mach. Co.*, 22 O. G. 1445.

An assignee of the entire interest must sue alone for any infringement committed during his ownership, see *Suydam v. Day*, 2 Blatch. 20. The grantee of an exclusive territorial interest must sue alone for any infringement committed within his territory during his ownership, see *Hobbie v. Smith*, 27 Fed. Rep. 665; the personal representatives of a deceased inventor must be the plaintiffs in an action for an infringement committed during their own ownership or that of their decedent, see *Hodge v. North Missouri R. R. Co.*, 4 Fisher, 161. The right to damages for past infringements is assignable, and the assignee may sue and recover damages, see *Hamilton v. Rollins*, 3 Bam. & A. 157.

JURISDICTION.—The Federal Courts, *i. e.*, the Circuit Courts, District and Territorial Courts having Circuit Court powers, and the Supreme Court of the District of Columbia, have original and exclusive jurisdiction over all cases touching the validity, title, and infringement of patents, see Rev. Stat., Section 629; *Willis v. McCollins*, 33 O. G. 1017; *Celluloid Mfg. Co. v. Goodyear Dental Vulcanite Co.*, 10 O. G. 41; *Dale*

Tile Mfg. Co. *v.* Hyatt, 43 O. G. 249; Duke *v.* Graham, 19 Fed. Rep. 647; Kayser *v.* Arnold, 41 Hun. 275; see also White *v.* Rankin, 144 U. S. 628; Elgin Wind, Power & Pump Co. *v.* Nichols, 65 Fed. Rep. 207. An appeal from an interlocutory decree, which grants, continues, refuses, dissolves or refuses to dissolve an injunction, may be taken to the Circuit Court of Appeals, for the circuit in which such decree was rendered, at any time within thirty days from the entry of the decree, see 28 Statutes at Large, chap. 96, p. 666. An appeal lies to the Circuit Court of Appeals from any final decree or decision of a United States Circuit Court, provided it is taken within six months after the entry of the decree, see 28 Statutes at Large, Sections 6 and 11, unless the decree is only for costs, see Du Bois *v.* Kirk, 158 U. S. 67, 1895. No appeal lies from any Circuit Court of Appeals to the United States Supreme Court, except actions brought by the United States to repeal patents, see United States *v.* Bell Telephone Co., 158 U. S. 548, 1895. Any Circuit Court of Appeals, may, however, certify to the Supreme Court any question of law upon which it desires the instruction of that court for its information; and the Supreme Court may send a certiorari to any Circuit Court of Appeals requiring any action in equity for infringement of a patent to be sent to the Supreme Court for review and determination, see 26 Statutes at Large, Chap. 517, Sec. 6.

An appeal lies to the Court of Appeals of the District of Columbia from any final decree of the Supreme Court of the District of Columbia, see 27 Statutes at Large, Chap. 74, Sec. 7, p. 435; and an appeal may also be demanded from the final judgment of that Court of Appeals to the Supreme Court of the United States in any case wherein the validity of a patent is involved, see 27 Statutes at Large, Chap. 74, Sec. 8, p. 436.

The State Courts have jurisdiction, the citizenship being the same, over all actions based on contracts between the parties, whether to compel their performance, to rescind them, or to award damages for their violation, see Wren *v.* Annin, 34 Fed. Rep. 435. Actions for breach of warranty, for fraud, for royalties or purchase money, and for the non-fulfillment of other collateral contracts, are also within their exclusive jurisdiction, see Willis *v.* McCollin, 38 O. G. 1017; Ingalls *v.* Tice, 14 Fed. Rep. 352. The Federal Courts have jurisdiction over these actions also if there is a difference in the citizenship of the opposing litigants, see Wren *v.* Annin, 34 Fed. Rep. 435; Meserole *v.* Union Paper Collar Co., 3 Fisher, 483. Every action in the Federal Courts should be instituted in that one of the Circuit Courts, or in one of these equivalent tribunals, whose local jurisdiction embraces the parties to the suit.

An action at law may be brought in any district where the defendant can lawfully be served with process, see Thompson *v.* Mendelson, 5 Fisher, 187; an action in equity praying for an injunction can be brought only in the district where the defendant resides or does business, or where the infringement takes place, see Wilson Packing Co. *v.* Clapp, 13 O. G. 368. Actions against the government of the United States for compensation, under licenses, real or implied, should be brought in the Court of Claims. Where the government uses the invention without the consent of the owner of the patent, suit should be brought against those agents of the government who personally committed the infringement, see Head *v.* Porter, 48 Fed. Rep. 481. Such suits are now almost always brought to the equity side of the court, for the reason that the plaintiff can in an equity action recover the defendant's profits as well as damages, see Emigh *v.* Railroad Co., 6 Fed. Rep. 283, while in an action at law damages only are recoverable; also for the further reason that the complainant is not compelled to go into the question of damages until the court has settled the question of the validity of the patent, and of its infringement. It should be observed, however, that legal rights must be enforced in a court of law, and that equity cannot interfere where there is an adequate remedy at law, see Root *v.* Lake Shore & Mich. Southern R. R. Co., 21 O. G. 1112.

PROCESS.—The process in an action at law for infringement does not differ from that employed in other actions. The declaration must contain all the averments necessary to set up the plaintiff's right and its violation, and be as broad as is needed to establish the plaintiff's right to recover, see Stanley *v.* Whipple, 2 McLean, 35. Of these essential averments there are five: (1) The invention of the patentable subject-matter by the plaintiff or his assignor; (2) The grant of letters-patent covering the invention; (3) The legal title of the plaintiff; (4) The infringement of the defendant; (5) The resulting damage to the plaintiff, see Robinson on Patents, § 949 and *post*.

The plaintiff must allege the performance of an inventive act, tendering an issue upon every point essential to the patentability of the invention, see Wilder *v.* McCormick, 2 Blatch. 31; but need not aver the date when the invention was made, except that it was made before the application for the patent was filed, nor allege the taking of the required preliminary steps, all these being presumed from the grant of the patent, see Cutting *v.* Myers, 4 Wash. 220; citizenship is not in issue though alleged, see Fischer

v. Neil, 19 O. G. 603. He must aver that the invention was not in public use or on sale in this country for more than two years before his application for the patent, see *Gandy v. Belting Co.*, 143 U. S. 592.

Under the second averment, the plaintiff must allege and describe the application of the inventor for a patent, its allowance by the Patent Office, and the issue of letters-patent thereon, specifying the nature of the invention which it purports to protect, and making profert of the patent, see *Peterson v. Wooden*, 3 McLean, 248; *Cutting v. Myers*, 4 Wash. 220; *Pitts v. Whitman*, 2 Story, 609; *Wilder v. McCormick*, 2 Blatch. 31; *Bogart v. Hinds*, 33 O. G. 1268.

Under the third averment, the exact title of the plaintiff must be set forth, as it appears, or can be made to appear upon the records of the Patent Office, see *Gray v. James*, 1 Robb, 140.

Under the fourth averment, he must allege the infringement of the patent by the defendant, by making, using or selling the invention therein described, without authority from the owner of the patent. The breach of the patent must be stated as broadly as the right claimed in the patent, in order that it may appear that the acts of the defendant related to the precise invention thereby protected, see *Cutting v. Myers*, 4 Wash. 220; *Parker v. Haworth*, 4 McLean, 379; *Wilder v. McCormick*, 2 Blatch. 31.

Under the fifth averment, the damages sustained by the plaintiff should be set forth. No special statement of the methods in which the infringement has damaged the plaintiff need be averred, see *Wilder v. McCormick*, 2 Blatch. 31. Nominal damages are implied from the violation of the patent, see *Poppenhusen v. N. Y. Gutta-Percha Comb Co.*, 2 Fisher, 62; actual damages must be proved, see *Mayor of New York v. Ransom*, 23 How. 487. In fixing the amount the jury cannot exceed the sum named in the declaration, see *Winans v. N. Y. & Harlem R. R. Co.*, 4 Fisher, 1.

The language of the declaration is not severely scrutinized by the court, nor are objections to its modes of statement favored if it accomplishes the object for which it was intended. It must put the defendant in possession of all the facts upon which the plaintiff's case is based, and leave open to the defendant every legal defence within his right.

JOINDER OF PATENTS AND SUITS.—More than one patent may be included in the same suit, see *Bates v. Coe*, 15 O. G. 337, and separate suits between the same parties on separate patents, all infringed by the same machine, may be consolidated upon motion, see *Deering v. Winona Harvester Works*, 32 O. G. 654.

DAMAGES.—When the suit is at law, the rule is that the verdict of the jury must be for the actual damages sustained by the plaintiff, subject to the right of the court to enter judgment thereon for any sum above the verdict, not exceeding three times that amount, together with costs, see *Birdsall v. Coolidge*, 93 U. S. 64.

In equity suits the gains and profits are the proper measure of damage, except in cases where the injury sustained by the infringement is plainly greater than the aggregate made by the respondent, in which event the provision is that the complainant shall be entitled to recover, in addition to the profits to be accounted for by the respondent, the damages he has sustained thereby. The plaintiff in an equity proceeding is entitled to pray in one action for the relief both in regard to profits and damages, see *Goodyear Dental Vulcanite Co. v. Van Antwerp*, 9 O. G. 497. Nominal damages will be awarded when the amount of damages is not proven; if the plaintiff intends to claim more than nominal damages he must satisfy the jury what his actual damages are, see *Poppenhusen v. N. Y. Gutta-Percha Co.*, 2 Fisher, 62. The character and financial condition of the parties are not to be considered in estimating damages, see *Hayden v. Suffolk Mfg. Co.*, 4 Fisher, 86; nor does the good faith of the defendant excuse him, see *Hogg v. Emerson*, 11 How. 587. Only direct and immediate damages can be recovered, see *Buerk v. Imhauser*, 10 O. G. 907; remote consequential damages cannot be recovered, see *Carter v. Baker*, 4 Fisher, 404. Vindictive damages are not permitted, power being conferred upon the court to increase the amount fixed by the jury in case of malicious or persistent injury, see *Whittemore v. Cutter*, 1 Gallison, 478; *Goodyear v. Bishop*, 2 Fisher, 154.

INTEREST.—The interest allowable upon the items which compose the damages is computed from the time of the reception of the benefit or profits by the defendant, see *Sickels v. Borden*, 3 Blatch. 535; when, however, the amount of damages is based upon the injury directly inflicted on the plaintiff's own enjoyment of the invention, the date of the suit is the period at which the damages are complete and the interest begins, see *May v. County of Fond du Lac*, 27 Fed. Rep. 691. Whenever commencing, interest continues to the date of judgment and should be included in the amount awarded to the plaintiff, see *McCormick v. Seymour*, 2 Blatch. 240.

COSTS.—Costs are recoverable by all plaintiffs who secure judgments for infringement of patents, see *Merchant v. Lewis*, 1 Bond, 172, except: (1) when it appears on the trial that one or more of the claims of the patent are void for lack of being the subject of a patent, or for want of invention, or for want of novelty, and it appears that a proper disclaimer was not filed in the Patent Office before the commencement of the suit, see Rev. Stat., Secs. 973, 4917 and 4922; (2) where part of the patents sued upon are not recovered upon, see *Adams v. Howard*, 19 Fed. Rep. 319; *Schmid v. Mfg. Co.*, 37 Fed. Rep. 348; (3) and where only a small part of the infringement alleged by the plaintiff is found by the verdict, see *Marks Chair Co. v. Wilson*, 43 Fed. Rep. 304. All items of cost are specified in the United States statutes, see Rev. Stat. 823, 983; *The Baltimore*, 8 Wallace, 392; *Lyell v. Miller*, 6 McLean, 422; *Wooster v. Handy*, 23 Fed. Rep. 60. No expenses, other than taxable costs, can be lawfully inserted in any cost bill, see *Parks v. Booth*, 102 U. S. 106. One attorney's docket fee is taxable in each case, see *Dedekam v. Vose*, 3 Blatch. 153; there is no warrant for taxing a separate docket fee for each of the plaintiff's attorneys, if there be more than one, nor with a separate docket fee for each term during which a case has been pending in court, nor for taxing any docket fee in favor of any attorney of the defeated party. The fees of the clerk of the court are in general taxable against the defeated party, but copies of the record ordered by a party for his own use, copies of pleadings, depositions or other papers which form parts of the records of cases are not so taxable. The fees of a commissioner or other magistrate for taking depositions are taxable if such depositions are offered in evidence and are admitted, see *Fry v. Yeaton*, 1 Cranch, 550; *Hathaway v. Roach*, 2 Woodbury & Minot, 75; Rev. Stat. Sec. 824. Witness fees are generally taxable, but are not so when the testimony is taken by deposition, and the latter is not offered, or if offered not admitted in evidence, see Rev. Stat. Sec. 848; *Hathaway v. Roach*, 2 Woodbury & Minot, 63; nor will the fees of more than three witnesses to one fact be taxable unless the court is satisfied by affidavit that the additional witnesses were really necessary, see *Bussard v. Catalano*, 2 Cranch, 421.

The costs are taxed by the clerks of the Circuit Court under the direction of the judges. If the defeated party is dissatisfied with the result the court will hear his motion for a retaxation, and if he shows ground for a claim of error the court will order the clerk to retax the costs, the mover giving the opposite party due notice of the time and place thereof, and paying the costs occasioned thereby. If either party is then dissatisfied with the result he may appeal to the court. All these proceedings must take place at the term in which the judgment is entered, see *Blagrove v. Ringgold*, 2 Cranch, 407.

PROFITS.—The profits made by the infringement of a patent may be recovered by suit in equity. The profits thus recoverable are the profits actually made by the defendant from that infringement, see *Rubber Co. v. Goodyear*, 9 Wallace, 801; and those which resulted directly, not indirectly from the infringement, see *Piper v. Brown*, 1 Holmes, 198. Where several defendants were joint infringers, but the profits were received by only part of them, the decree for profits will be rendered against those only of the defendants who realized them, see *Elizabeth v. Pavement Co.*, 97 U. S. 140; and against each defendant for his own share of the profits only, see *Covert v. Sargent*, 38 Fed. Rep. 238. The generic rule for ascertaining the amount of the profits recoverable, is that of treating the infringer as though he were a trustee for the owner of the patent in respect of the profits realized by reason of the infringement, see *Root v. Railway Co.*, 105 U. S. 214. In a suit in equity the court may by an interlocutory decree direct a master commissioner of the court to take and report an account of the defendant's profits, or appoint a master *pro hac vice* for that purpose. The complainant must then introduce evidence before such master to prove the amount of those profits. In the course of such accounting the master has full authority to do all acts and direct all proceedings which he may deem necessary and proper. His fees must be paid by the defendant when they accrue and be borne by him in the final taxation of costs, if he is finally defeated, but must be borne by the complainant if the bill is finally dismissed. Interest on infringer's profits is allowed from the date of the master's report, which ascertains the amount of those profits, see *Tilghman v. Proctor*, 125 U. S. 160.

PLEADING AND PROOF IN ACTIONS FOR INFRINGEMENT.

SEC. 4920. In any action for infringement the defendant may plead the general issue, and having given notice in writing to the plaintiff or his attorney, thirty days before, may prove, on trial, any one or more of the following special matters:

First. That for the purpose of deceiving the public the description and specification filed by the patentee in the Patent Office was made to contain less than the whole truth relative to his invention or discovery, or more than is necessary to produce the desired effect; or

Second. That he had surreptitiously or unjustly obtained the patent for that which was in fact invented by another, who was using reasonable diligence in adapting and perfecting the same; or

Third. That it had been patented or described in some printed publication prior to his supposed invention or discovery thereof; or

Fourth. That he was not the original and first inventor or discoverer of any material and substantial part of the thing patented; or

Fifth. That it had been in public use or on sale in this country for more than two years before his application for a patent, or had been abandoned to the public.

And in notices as to proof of previous invention, knowledge, or use of the thing patented, the defendant shall state the names of patentees and the dates of their patents, and when granted, and the names and residences of the persons alleged to have invented, or to have had the prior knowledge of the thing patented, and where and by whom it had been used; and if any one or more of the special matters alleged shall be found for the defendant, judgment shall be rendered for him with costs. And the like defenses may be pleaded in any suit in equity for relief against an alleged infringement; and proofs of the same may be given upon like notice in the answer of the defendant, and with the like effect.

ACTIONS AT LAW.—In an action for infringement a defendant may plead either in abatement, by demurrer, or in bar. A plea in abatement should be filed whenever the defendant desires to object to the mode in which the proceedings have been instituted, if either the process or its service be faulty, or there be incapacity, misdescription, misjoinder or non-joinder of parties, or other actions pending between the same parties. The defendant may demur to the declaration either on account of formal defects or on the ground that it sets forth no cause of action.

DEFENSES. PLEADING.—The defenses which are pleadable in bar to an action are very numerous. Where the facts appear to warrant so doing, a defendant may plead:—

1st. That the matter covered by the letters patent was not a statutory subject of a patent:

2nd. That it was not an invention:

3rd. That the patented art or instrument did not result from the inventive act of its alleged inventor:

4th. That the alleged inventor was not the first inventor of the patented art or instrument:

5th. That it was not novel at the time of its alleged invention:

6th. That it was not useful at that time:

7th. That the inventor actually abandoned the invention:

8th. That he constructively abandoned it, by not applying for a patent on it, till more than two years after it was in public use or on sale in this country:

9th. That the alleged letters patent were in fact never granted:

10th. That the letters patent were not issued in conformity with the law:

11th. That the invention covered by the patent was not legally patentable:

12th. That the invention claimed in the original patent is substantially different from any indicated, suggested, or described in the original application therefor:

13th. That the patentee surreptitiously or unjustly obtained the patent for that which was in fact the invention of another, who was using reasonable diligence in adapting and perfecting the same:

14th. That the invention was made by another jointly with the sole applicant:

15th. That it was made by one only of two or more joint applicants:

16th. That for the purpose of deceiving the public, the description and specification filed in the Patent Office was made to cover less than the whole truth relevant to the invention, or was made to cover more than was necessary to produce the desired effect :

17th. That the description of the invention in the specification is not in such full, clear and exact terms as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the same :

18th. That the claims of the patent are not distinct :

19th. That the patentee unreasonably neglected to enter a needed disclaimer :

20th. That the original patent was surrendered and re-issued in the absence of every statutory foundation therefor :

21st. That the claims of the re-issue patent in suit are broader than those of the original, and that the re-issue was not applied for till a long time had elapsed after the original was granted :

22nd. That the re-issue patent in suit covers a different invention from any which the original patent shows was intended to be secured thereby :

23rd. That the invention claimed in the original patent is substantially identical with an invention claimed in a prior patent granted on the application of the same inventor :

24th. That the patent was repealed :

25th. That the patent legally expired before the alleged infringement began or before it ended :

26th. That the patentee made or sold specimens of the invention covered by his patent, without marking them "patented," and without notifying the defendant of his infringement :

27th. That the plaintiff has no title to the patent, or no such title as can enable him to maintain the action :

28th. That the defendant is a co-owner, or has a license, which authorized part or all of the doings which constitute the alleged infringement :

29th. That the defendant has a release discharging him from liability on account of part or all of the alleged infringement :

30th. That the defendant is not guilty of any infringement of the patent upon which he is sued :

31st. That the plaintiff is estopped from enforcing any right of action against the defendant :

32nd. That the cause of action sued upon is partly or wholly barred by some statute of limitation.

The defendant may avail himself of any or all of such of these defenses as are justified by the facts, unless he himself is estopped from urging them by his former act, or conduct, see *Lindsay v. Stein*, 21 O. G. 613; *U. S. Rifle & Cart. Co. v. Whitney Arms Co.*, 11 O. G. 373. Where several patents constitute the basis of a single suit, each may be separately attacked by any of the methods of defense herein set forth, see *Bates v. Coe*, 15 O. G. 337; and in the same manner some claims of a patent may be infringed and not others, and each may be defended against, like a separate patent, see *Kelleher v. Darling*, 14 O. G. 673. As to the form in which these various defenses should be pleaded, the authorities appear irreconcilable, some holding that the greater number should be urged under the general issue, others requiring a notice or a special plea for nearly all of them. The general issue is a sufficient plea for all defenses which deny the existence of a cause of action in the plaintiff. Every defense which, admitting the former existence of a cause of action, claims that it has been extinguished by release, by estoppel or by a former judgment, belongs in the same class. The remaining defense which recognizes an existing cause of action, but avers that by reason of laches the plaintiff has lost his right to legal remedy, requires a special plea. But while the general issue may be permitted in the foregoing cases it is not necessary that the defendant should employ it. He may plead specially any or all of his defenses, except that which denies his performance of the infringing act, and this is always his proper course when he desires to tender a specific issue to be simply traversed by the plaintiff. (For a discussion of the relation of special pleas to the general issue, see *Hubbell v. DeLand*, 22 O. G. 1883; *Robinson on Patents*, §§ 986 to 993; *Walker on Patents*, 3rd ed., §§ 442 to 472.) The same matter cannot be presented both in a special plea and by a notice under the general issue, see *Read v. Miller*, 3 Fisher, 310.

When the defendant pleads the general issue, the plaintiff closes the pleadings with a *similiter*. If the defendant pleads specially, the plaintiff may either demur or traverse, or reply with new matter, as in other common-law actions, and thence the pleadings may

proceed until an issue of law or fact is reached. See *Celluloid Mfg. Co. v. Am. Zylonite Co.*, 34 Fed. Rep. 744; *Hayden v. Oriental Mills*, 24 O. G. 601; *Read v. Miller*, 3 Fisher, 310.

NOTICES.—Notices of special matter must be in writing, and must be served on the plaintiff or his attorney at least thirty days before the trial of the case, see *Cottier v. Stinson*, 20 Fed. Rep. 906. It is not the purpose to oblige defendant to give notice of anticipating matter so that the plaintiff may tamper with the witnesses, but only to give him time to secure evidence in case the testimony of defendant is untrue.

Such notices must be sufficiently full as to facts, dates, and particulars, to relieve the plaintiff from unnecessary labor in searching for and finding prior patents or printed publications, when these are relied upon, and in case of prior knowledge or use, should state the names and residences of the persons alleged to have known or used the patented invention, see *Silsby v. Foote*, 14 Howard, 218. The names of witnesses, as such, need not be mentioned, see *Planing Mach. Co. v. Keith*, 101 U. S. 492. In equity the notice is given in the answer, and by amendment, under permission of the court the stringency of the rule as to service is sometimes avoided, see *Carrick v. McKesson*, 19 Blatch. 369.

TRIALS IN ACTIONS AT LAW.—The trial of an action at law for infringement may be by a jury, by a judge, or by a referee. The first is the only proper one except where the parties agree to substitute one of the others. By a stipulation in writing, waiving a jury, filed by the parties with the clerk of the court, a case may be tried by a judge, see Rev. Stat. Sec. 649; and with the consent of both parties, a referee may be appointed by the court to try the case, see *Heckers v. Fowler*, 2 Wallace, 123. The rules of evidence which are used in the trial of patent causes are the ordinary rules of the common law, as modified by the statutes of the particular States in which such trials occur, see *Vance v. Campbell*, 1 Black, 427, and as adapted to the circumstances of patent litigation by the decisions of the United States Courts.

Trials by a judge without a jury require that the issues of law and the issues of fact are kept entirely distinct; his decisions on the former are reviewable by the Circuit Court of Appeals, while his finding of fact has the same operation as the verdict of a jury, see Rev. Stat. 649; *St. Paul Plow Works v. Starling*, 104 U. S. 197.

Trial by a referee requires that the referee hears and determines all the issues, decide the controversy, and report to the court. Such report may be special, setting forth the details of the evidence; or general, giving only the conclusions reached. Either party may except in writing, and upon the hearing of the objections, the court may adopt or reject the report and enter judgment accordingly, or recommit the report to the referee with further directions, see *Heckers v. Fowler*, 2 Wallace, 132.

JUDGMENTS IN ACTIONS AT LAW.—The verdicts of juries, findings of judges, or reports of referees are followed by a judgment in favor of the successful party; unless the first are set aside, the second reconsidered or modified, or the last rejected or recommitment. Judgments are entered by the clerk of the court under special or general authority of the judge, and when so entered are binding as the act of the court, see *Hecker v. Fowler*, 2 Wallace, 132.

NEW TRIALS IN ACTIONS AT LAW.—The Federal Courts have authority to grant new trials for the reasons recognized by other courts as sufficient to warrant such proceedings. For the grounds of new trial in general, see 1 *Graham & Waterhouse*, N. T. Introd. 1-502; 2, 1-50; 3 *Bl. Com.* pp. 378, 386-393. The reasons consist principally of error committed by either the court or jury during the former trial, such as the admission of improper evidence, or the rejection of proper evidence; departure from the law in instructing the jury, see *Allen v. Blunt*, 2 Robb, 530; a verdict against the evidence, see *Wilson v. Janes*, 3 Blatch. 227; misconduct on the part of the jury, or departure from the law or evidence in rendering the verdict, see *Johnson v. Root*, 2 Fisher, 291; or the discovery of new evidence that would probably change the result, see *Starling v. St. Paul Plow Works*, 41 O. G. 818; *Spill v. Celluloid Mfg. Co.*, 29 O. G. 773. Mistakes and negligence of parties and counsel are not ground for new trial, see *De Florez v. Reynolds*, 16 Blatch. 397, and errors known to the party during trial are waived, unless excepted to, see *Allen v. Blunt*, 2 Robb, 530; nor will a new trial be granted in order to introduce immaterial evidence, see *Spill v. Celluloid Mfg. Co.*, 29 O. G. 773; or new cumulative evidence, see *Pfanschmidt v. P. H. Kelly Mercantile Co.*, 41 O. G. 1501.

WRIT OF ERROR IN ACTIONS AT LAW.—A writ of error from the judgment of a Circuit Court, whether the trial has been conducted with or without a jury, will carry any action at law, for an infringement of a patent, to the Circuit Court of Appeals for review, regardless of the amount involved, see *West v. Barnes*, 2 Dallas, 401; Rev. Stat. Sec. 699; *York & Cumberland R. R. Co. v. Myers*, 18 Howard, 246, but no writ of

error can carry any question of fact to that court, see *Heckers v. Fowler*, 2 Wallace, 123. The sole office of this writ is to secure a review of the questions of law involved in the case, by that tribunal. Such an action at law decided in the Supreme Court of the District of Columbia may be taken by a writ of error to the Court of Appeals for the District of Columbia, see 27 Statutes at Large, Chap. 74, Sec. 7, p. 435; and if the validity of the patent is involved, the case may be taken from that court to the Supreme Court of the United States, see 27 Statutes at Large, Chap. 74, Sec. 8, p. 436. But actions at law for the infringement of patents cannot be taken from any Circuit Court of Appeals to the Supreme Court upon a writ of error; though any such Circuit Court of Appeals may certify to the Supreme Court any questions of law upon which it desires the instructions of that court for its proper decision; and the Supreme Court may send a certiorari to any Circuit Court of Appeals, requiring any case for infringement of a patent to be sent to the Supreme Court for its review and determination, see 26 Statutes at Large, Chap. 517, Sec. 6.

BILLS OF EXCEPTION IN ACTIONS AT LAW.—Bills of exception, properly allowed, signed, or sealed by the judge, constitute the only method by which the questions of law arising during the trial of a case, can be prepared for transmission to the Supreme Court in pursuance of a writ of error, see *Insurance Co. v. Lanier*, 95 U. S. 171. But a paper, incorporated in the record, having all the substantial characteristics of a bill of exceptions, will be treated as such, see *Herbert v. Butler*, 97 U. S. 319.

ACTIONS IN EQUITY.—Under preceding sections actions in equity have been considered side by side with actions at law, and their points of difference indicated. Some of the most important of these are now to be considered more at length. As we have already seen, see *Root v. Lake Shore & Mich. Southern R. R. Co.*, 21 O. G. 1112, the distinction between law and equity is guaranteed by the Constitution; legal rights must be enforced in courts of law, and equity cannot interfere where there is an adequate remedy at law. A further principle has been established; if equity obtains jurisdiction for one purpose, it will exercise it as to all, see *Burdell v. Comstock*, 15 Fed. Rep. 305. As a result of these two principles, it follows that where equitable interference is necessary for the complete protection of the plaintiff, equity has jurisdiction for all purposes, and can hear and determine all the issues in the cause, see *Magic Ruffle Co. v. Elm City Co.*, 11 O. G. 501. The test of equity jurisdiction is whether adequate remedy can be had at law, see *McConihay v. Wright*, 121 U. S. 201. The only function of actions at law in patent cases is to give damages for past infringements. The principal function of actions in equity is to restrain future infringements by means of the writ of injunction, and having acquired jurisdiction over the parties, and the subject matter of the controversy, equity will afford such further relief as the plaintiff may require, see *Burdell v. Comstock*, 15 Fed. Rep. 305. Equity has no jurisdiction over breach of contract, see *Magic Ruffle Co. v. Elm City Co.*, 11 O. G. 501.

PARTIES IN EQUITY.—In an action at law only a legal owner of a patent can bring suit; only the owner of an equitable title can resort to equity for relief, see *Rogers v. Reissner*, 41 O. G. 351. The parties to a suit in equity comprise all persons, natural or artificial, that can be affected by the decree, see *Williams v. Bankhead*, 19 Wall, 563. All legal owners of the patent, and all equitable owners who have been or would be injured by the infringement should be joined as plaintiffs, and if they refuse to sue as plaintiffs should be made defendants, see *Jordan v. Dobson*, 4 Fisher, 232, and they must sue in their own names. All parties participating in the infringement, whether natural or artificial, may be joined as defendants, their relation to each other being shown, see *Shickle v. St. Louis Foundry Co.*, 22 Fed. Rep. 105.

PROCESS IN EQUITY.—The process in an action in equity does not differ materially from that employed in an action at law. The bill must disclose all that is necessary to set forth the plaintiff's rights and their violation by the defendant. The averments should cover every material fact, the court having no authority to consider what is proved and not alleged, or what is alleged and not supported by the evidence, see *Pelham v. Edelmeyer*, 25 O. G. 292. The five essential averments specified under Sec. 4919 as necessary in actions at law are no less necessary in actions in equity. The averment as to damages may be in general terms; that of profits must set forth such facts as to the mode in which the defendant has practiced the invention, and the benefits he has derived, as in connection with the other averments will show that there have been profits for which the plaintiff is entitled to an account, see *Vaughn v. Cent. Pac. R. R. Co.*, 4 Sawyer, 280. The bill must close with a prayer for the relief desired, and the latter must be, in part at least, of such a character that equity alone can grant, see *Dunham v. R. R. Co.*, 1 Bond, 492. The bill must be signed by counsel, and by a solicitor of the court in which it is filed,