

vided for the correction of any errors, either as to the law or facts, which the examiners-in-chief may make. In order to pass upon this branch of the motion, I must examine the case upon its merits. This I can only do upon an appeal regularly initiated by the payment of the fee prescribed by law.

“The motion is therefore overruled.” (*Commissioners' Decisions, September 21, 1870.*)

216. NO REHEARING ALLOWED EXCEPT UPON ORDER OF COMMISSIONER.—Cases which have been heard and decided by the examiners-in-chief will not be reheard by them except upon the order of the Commissioner. (*Patent Office Rules, July, 1870.*)

In the case of *Strain ex parte*, (motion,) Acting Commissioner Duncan says: “This application was rejected a second time by the primary examiner February 25, 1870, and upon appeal duly taken his decision was affirmed by the board of examiners-in-chief March 30.

“Since this decision by the board the case seems to have been reconsidered by both the primary examiner and the examiners-in-chief, numerous affidavits having been filed by applicant bearing upon the alleged novelty and utility of the invention. In these subsequent proceedings the examiner adheres to his former position, reiterating the references before cited, which in his judgment should defeat the application on the score of novelty; while the board in their second decision, rendered July 20, overrule the adverse decision of the examiner, basing their judgment upon ‘the affidavits filed since the case was last before them.’

“All the proceedings in this case since the first decision rendered by the board have been irregular and with-

out authority. While it was competent for the applicant to support his argument by affidavits, there was no authority for the examiner to reopen the case for further action, and the subsequent action of the board is in contravention of the rule that 'cases which have been heard and decided by the examiners-in-chief will not be reheard by them, except upon the order of the Commissioner.'

"The later proceedings in this case, therefore, are set aside, and the application remanded to the status which it properly held immediately upon the first rejection by the board." (*Commissioners' Decisions, July 27, 1870.*)

217. AFTER THE DECISION OF THE BOARD, A PRIMARY EXAMINER CANNOT RECONSIDER THE CASE WITHOUT AN ORDER FROM THE COMMISSIONER.—In the case of *Duthie v. Casilear* (interference) the Commissioner says: "This is a motion to dissolve an interference. Several reasons are urged by the attorney for the motion, of which only one will be considered.

"It appears that Duthie's patent was twice rejected by the examiner and once by the examiners-in-chief. Subsequently, through oversight or change of opinion, the examiner allowed a patent to Casilear. He afterward took up the application of Duthie, and, without amendment or order from the Commissioner, reconsidered it, and placed it in interference with the patent of Casilear. This course was irregular. After the decision of the board the case was removed from the jurisdiction of the examiner, and he could not reconsider the case without an order from the Commissioner. It is somewhat difficult to see, also, if the inventions interfere, how a patent was granted to Casilear, a subsequent applicant. At all events, the irregularity in the reconsideration of Duthie's

case and in the declaration of interference are such, that the motion to dissolve the interference must prevail. The interference is dissolved." (*Commissioners' Decisions*, September 15, 1870.)

218. CASE MAY BE REMANDED FOR FURTHER EXAMINATION.—When the applicant has appealed, the case is closed before the primary examiner, unless it be regularly remanded, with leave to amend or with directions for further examination. If it be so remanded, the case is reopened below, and cannot return to the appellate tribunal until the applicant has responded to the new examination, either by amendment or fresh appeal.

In the case of *Krake ex parte* the Commissioner says:

"These statements were interpolations of the most dangerous character. The examiner excuses himself for permitting them to remain in the specification, by stating that the board of examiners-in-chief did not order them to be stricken out. But this is no excuse. It was not the duty of the board to strike them out. It is the duty of the examiner to purge the specification, drawings, or model of new matter before examining the claims. His action upon such questions is not 'adverse' to the grant of letters patent, because it is not a final adjudication upon the merits. No appeal, therefore, lies from such action to the board of examiners-in-chief." (See *Decision of Commissioner Holloway, William Cleveland Hicks ex parte*, 9 *Decisions*, p. 323.) * * * "It was the duty of the examiner, therefore, at any stage of the case, to purge this application of the new matter interpolated into the amended specification. It was not the duty of the examiners-in-chief to do this, although it is undoubtedly within their power, at their discretion, to decline to entertain an ap-

peal while the application is imperfect, and to remand it to the examiner, that such imperfections might be cured.” (*Commissioners’ Decisions*, 1869, p. 100.)

219. DELEGATED DISCRETION EXERCISED BY A PRIMARY EXAMINER CANNOT BE REVIEWED.—In the case of *Mody and Hudson ex parte* the Commissioner says:

“The examiner rejected the claims of appellant upon references. I agree with the board of examiners-in-chief, that the references are not pertinent, and that the combinations claimed are novel.

“The board, however, go on to say: ‘But the emergency does not warrant the expense incurred and the inconveniences resulting from its being embodied in the instrument. Even when the tool requires such a correction as is supposed, which will very rarely occur, it would be cheaper to make a new face upon the indicator than to resort to the applicant’s apparatus. This is clearly one of those cases in which it is left to the discretion of the Commissioner to determine whether an invention is sufficiently useful and important ‘to justify the issue of a patent.’ (See § 7, *Act July 4, 1836.*)

“The examiner made no objection to the application because of lack of utility in the invention, but the board, while overruling him upon the issue of novelty, affirms his rejection of the patent upon the ground set up by themselves as above.

“This involved a two-fold error: First, If the question of utility be one of discretion vested in the Commissioner in person, the board of examiners-in-chief cannot exercise discretion for him; but if it be delegated discretion, to be exercised by the primary examiner as the agent of the Commissioner, then the exercise of it cannot be re-

viewed upon appeal. It is familiar law, that no appeal or writ of error will lie to set aside an act or reverse a decision, the making of which the law has confided to the discretion of the lower court. Second, The objection to the application, that the invention, though new and useful, is costly, and likely to be more costly than useful, is not one which the Patent Office should raise or maintain. It may well be left to the public, who buy the best and cheapest. This subject was fully discussed in *Cheeseborough ex parte*, (*Commissioners' Decisions*, May 1869, p. 11,) and the reasoning of that decision covers the present case.

“The decision of the board of examiners-in-chief is reversed.” (*Commissioners' Decisions*, 1869, p. 108.)

220. THE COMMISSIONER MAY WITHHOLD A PATENT, ALTHOUGH THE EXAMINERS-IN-CHIEF HAVE DECIDED THAT IT OUGHT TO ISSUE.—In the case of *Stephen Hull ex parte* the Commissioner says:

“The examiner refused to grant a patent upon the ground that the application had been abandoned and the invention had gone into public use.

“Applicant appealed to the board of examiners-in-chief June 1, 1869, and on August 28, 1869, the board, by two of its members, rendered a decision reversing that of the primary examiner.

“On June 9, 1869, two months and a half before the decision of the board was made, the Commissioner decided, in the case of *John W. Cochran*, involving facts almost identical with those in applicant's case, that a patent ought not to issue. This decision *affirmed* a previous decision of the board of examiners-in-chief.

“It does not appear, from the decision of the board in

the present case, that the opinion of the Commissioner in Cochran's case was considered or was before them; but it does appear that, whether with or without examining that decision, they have in effect decided that a patent ought to issue in a class of cases in which the Commissioner and themselves had already decided that it ought not to issue.

“If the decision, while departing from the rule laid down by the Commissioner, had been adverse to applicant, he would, no doubt, have sought the Commissioner by appeal, to demand that the action of the board, in neglecting to conform to that of the Commissioner, be reversed. As, however, the decision is in his favor, he demands his patent, and insists that the board of examiners-in-chief ‘are to settle for the examiners what is the law in patent cases,’ even to the extent of ignoring the decisions of the Commissioner. * * * As the head of the office, responsible for its management and for the acts of his subordinates, charged by law with the execution of all acts and things touching the granting and issuing of letters patent, it is his right, it is his duty, when he has reason to believe that, by the action of any of his subordinates, a patent is about to issue which ought not to be granted, to arrest such issue, and to take such steps as in his judgment may be necessary to correct the error and secure the public from imposition. To say that any examiner, or board of examiners, refusing to be guided by his decisions or to obey his rules, might issue patents broadcast to those who were not entitled to them, and that, because there is no appeal as against the lucky applicant, the Commissioner is by law made powerless to avert the evil—nay, more, must himself sign the patents

which he knows ought not to issue—is to force upon this act a construction which is, in my opinion, the very reverse of that intended by the legislature.

“I have examined the remarks of Judge Dunlop in *Snowden v. Pierce*. Although expressing some views adverse to the opinion I have here maintained, this point was not, as it could not be, before him. What he says is simply *obiter dictum*, provoked apparently by the argument of counsel. The question, if there be one, is of an executive rather than a judicial character, and is for the Attorney General rather than for the courts.

“In the absence of other light upon this subject than that afforded me by the statute and the practice of the office, I have no hesitation in holding, that I have the power to withhold a patent at any stage of its progress, whenever facts arise which in my judgment constitute a bar to its issue. This is the view taken by Commissioner Foote, my immediate predecessor. In his annual report for 1868 he says: ‘I have endeavored to provide some means for reviewing, briefly, favorable decisions before patents were issued upon them, but found that the force of the office was inadequate to such work in addition to the performance of other indispensable duties.’

“In this case I have suspended the issue of a patent to Stephen Hull, and have remanded the case to the board of examiners-in-chief for re-examination, in the light of the decision of the Commissioner in the cases of John W. Cochran and John W. Orr.” (*Commissioners’ Decisions*, 1869, p. 68.)

221. PETITION TO SET FORTH REASONS OF APPEAL.—A petition in writing must be filed, signed by the party or

his authorized agent or attorney, praying an appeal and setting forth briefly and distinctly the reasons upon which the appeal is taken. (*Patent Office Rules, July, 1870.*)

222. FORM OF APPEAL FROM THE EXAMINER TO THE EXAMINERS-IN-CHIEF.—

To the Commissioner of Patents.

SIR: I hereby appeal to the examiners-in-chief from the decision of the principal examiner, in the matter of my application for letters patent for an improvement in wagon brakes, which, on the 20th day of July, 1869, was rejected the second time. The following are assigned for reasons of appeal: [*Here follow reasons.*]

LEMUEL LOOKUP.

223. FORM OF APPEAL FROM THE EXAMINER IN CHARGE OF INTERFERENCES TO THE EXAMINERS-IN-CHIEF.—

To the Commissioner of Patents.

SIR: I hereby appeal to the examiners-in-chief from the decision of the principal examiner in charge, in the matter of the interference between my application for letters patent for improvement in sewing machines and the letters patent of Elias Coleman, in which priority of invention was awarded to said Coleman. The following are assigned for reasons for appeal: [*Here follow reasons.*]

WILLIAM SYPHAX.

XIII. Appeal to the Commissioner in Person.

<p>SEC. 224. Appeal from examiners-in-chief. 225. Commissioner will not review the action of his predecessor. 226. Time of hearing. 227. Motions. 228. Limit of oral arguments. 229. New assignment.</p>	<p>SEC. 230. Decisions upon questions of fact. 231. Case may be remanded to examiner. 232. Appeal from primary examiner. 233. Form of appeal.</p>
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224. APPEAL FROM THE EXAMINERS-IN-CHIEF.—If the applicant is dissatisfied with the decisions of the examiners-in-chief he may, on payment of the duty required

by law, appeal to the Commissioner in person. (*Act of July 8, 1870, § 46.*) All cases which have been acted on by the board of examiners-in-chief may be brought before the Commissioner in person, upon a written request to that effect, and upon the payment of the fee of twenty dollars required by law. (*Patent Office Rules, July, 1870.*)

225. A CASE DELIBERATELY DECIDED BY ONE COMMISSIONER WILL NOT BE DISTURBED BY HIS SUCCESSOR.—The only remaining remedy will be by appeal, in those cases allowed by law, to the supreme court of the District of Columbia sitting in banc. (*Ib.*) The Commissioner will not review the action of his predecessor, or of the appellate judge in the same case. (*J. W. Orr ex parte, Commissioners' Decisions, 1869, p. 33.*)

226. TIME OF HEARING.—All cases pending before the Commissioner will stand for argument at one o'clock on the day of hearing. If either party in a contested case, or the appellant in an *ex parte* case, appear at that time, he will be heard. (*Patent Office Rules, July, 1870.*)

227. MOTIONS.—Reasonable notice of all motions, and copies of the motion papers and affidavits, must be served upon the opposite party or his attorney; and in contested cases no motions will be heard in the absence of the other party, except upon default after due notice; nor will a case be taken up for oral argument after the day of hearing, except by consent of both parties. (*Ib.*)

228. LIMITATION OF ORAL ARGUMENTS.—Unless otherwise ordered before the hearing begins, oral arguments will be limited to one hour for each counsel. (*Ib.*)

229. NEW ASSIGNMENT.—If the engagements of the tribunal before whom the case is pending are such as to prevent it from being taken up on the day of hearing, a

new assignment will be made, or the case will be continued from day to day until heard. (*Ib.*)

230. DECISIONS TURNING UPON QUESTIONS OF FACT WILL NOT BE REVERSED UNLESS RENDERED WITHOUT OR AGAINST EVIDENCE.—The appeal to the board of examiners, and to the Commissioner and judge, was given to determine disputed points of law, rather than to review mere questions of fact. Upon such questions the examiner is as likely to be right as the Commissioner. It is familiar law, that the verdict of a jury, or the finding of a judge upon submission, upon facts, will not be disturbed by the appellate tribunal, except in cases where the verdict or judgment is manifestly without evidence, or beyond a reasonable doubt against evidence. The mere fact that the appellate judge feels that if the question had been originally tried before him he would have come to a different conclusion from the lower tribunal, (no question of law being involved,) will not justify him in disturbing the judgment of that tribunal, where there was any evidence to sustain it. (*Fawcett v. Graham, Commissioners' Decisions*, 1869, p. 113.)

In the case of *Blanchard v. Strain*, the Commissioner says :

“The testimony is very voluminous, covering some three hundred and seventy-five pages of manuscript. The examiner in charge of interferences and the examiners-in-chief have both decided in favor of Strain. The question involved is purely one of fact, depending upon the credibility of contradicting witnesses.

“I cannot believe it was ever intended that in a case like this, where no legal question is involved, the parties should be able, by appeal, to compel four tribunals to

read over a great mass of testimony, with a view of pronouncing independent judgments upon the evidence, without reference to the opinions of those who had already considered it. It is the fact that the examiner and examiners-in-chief have both found the weight of evidence with Strain is to have no weight with me—if I am to throw it aside and examine the case as if they had never looked at it—it is obvious that the two trials before them might as well have been dispensed with, and that all such cases might as well be tried before the Commissioner or appellate judge in the first instance.

“The duty of the Commissioner in this class of cases is, in my opinion, fully discharged when he has so far examined the case as to find that the question involved is purely one of fact, and that the decision of the board upon the facts is not without evidence, or against the manifest weight of evidence. (See *Fuocell v. Graham*, *Commissioners' Decisions*, 1869, p. 118.) The verdict upon the facts of four persons skilled in such examinations ought to be as persuasive with the Commissioner as the verdict of a jury with the judge upon a motion for a new trial.” (*Commissioners' Decisions*, June 6, 1870.)

In the case of *White v. Purdy*, the Commissioner says:

“Upon a state of facts substantially similar, I held, in *Fuocell v. Graham*, (*Commissioners' Decisions*, 1869, p. 118,) *Blanchard v. Strain*, (*ib.*, June, 1870, p. 26,) and *Jeffers v. Duehamin*, (*ib.*, September, 1870,) that where a case in interference turns wholly upon a question of fact, and the evidence is conflicting, and both of the tribunals below have decided the same way, the Commissioner will not reverse the former decisions, unless they have

been rendered without evidence, or against the manifest weight of the evidence.

“As the correctness of this ruling has been challenged by the appellant in the present case, it may be well to state more fully the reason and authority by which it is supported.

“The appellant seems to suppose that the fact that an appeal is allowed to the Commissioner necessarily requires that officer to disregard the findings below; that he should treat them as if they had never been made, and should take up the case and examine it as a case of first impression, giving precisely the same decision as he would have done if he had heard it originally, instead of the examiner of interferences.

“This view cannot be admitted to be sound. The appeal is from the decision of the examiner or examiners-in-chief, and it can hardly have been intended that the Commissioner should ignore the fact that there had been any decision whatever. On the contrary, it would seem manifest that the fact that a decision had been rendered, from which an appeal had been taken, must exercise such an influence in a case of doubt, or where testimony was nicely balanced, as to determine the appellate tribunal to follow and sustain the decision rather than to overturn it. For, in such a case, a mind in doubt might well suffer those doubts to be resolved in the direction in which another mind, competent to judge, had already reached and announced a decision.

“Any other view would render the trials before the examiner and examiners-in-chief worse than useless. Cases might as well be tried in the first instance by the Commissioner, and the delay and expense of the former:

hearings be saved, if the decisions upon such hearings are to be treated precisely as though they had never been rendered.

“The position of the party before the Commissioner on appeal is not different from that of one who seeks to set aside the verdict of a jury or the finding of a judge upon a question of fact, or who appeals in admiralty or equity cases from the court below to a circuit or supreme court. In cases like these we are not without the light of authority. This will appear from the following cases:

“A mere difference of opinion between the court and jury does not warrant the former in setting aside the finding of the latter; that would be, in effect, to abolish the institution of juries, and substitute the court to try all questions of fact. It must be clear that the jury has erred before a new trial will be granted, on the ground that the verdict is against the weight of evidence or unsupported by it; and if this is the rule, as it undoubtedly is, even in the court where a cause is tried, and before whom the witnesses appeared and testified, *a fortiori* ought it to be the rule when another court decides the motion for a new trial, with no other knowledge of the facts than is derived through the imperfect medium of a written statement.’ (*McGatrick v. Wason*, 4 *Ohio St. R.*, 556.)

“The findings of a court, when substituted for a jury, are entitled to the same consideration as the verdict of the latter; and it is well settled that a verdict will not be set aside upon the ground of an erroneous finding, unless it is clear that such is the case.’ (*Merrick v. Bourry*, 4 *Ohio St. R.*, 60.)

“A decree, like a verdict, will not be set aside on the ground of an erroneous finding, unless it is clearly against

the weight of the evidence or clearly unsupported by it. Where there is no evidence at all to support a decree, it will be reversed for that reason.' (*Medina County Mutual Fire Insurance Company v. Bollmeyer*, 4 Ohio St. R., 107.)

"In the case of *The Grafton*, (1 Blatchf., 177,) Nelson, J., said: 'The case involves two questions of fact.' *

* * 'Both questions strike me as being exceedingly close upon the evidence, and are so nearly balanced that it would be wrong for an appellate court to interfere. According to the impression which the examination of the proofs has left upon my mind, I should not feel justified in disturbing the conclusions of the court below, whether for or against the appellant in respect to either question, as I think different minds might very well arrive at different conclusions. To warrant a reversal upon a mere question of fact, the preponderance of the evidence should be of a somewhat decided character, such as would justify the granting of a new trial in a court of common law, on the ground that the verdict was against the weight of evidence. It seems to me that this principle should govern this court in reviewing a question of fact determined by the district court.'

"In the case of *The Ship Marcellus* (1 Black, 414) the Supreme Court say: 'The only question proposed by these pleadings is one of fact. In this, as in all other cases of the kind, there is great discrepancy and conflict in the testimony of the witnesses as to every averment in the pleadings. We have had occasion to remark more than once, that when both courts below have concurred in the decision of questions of fact, under such circumstances parties ought not to expect this court to reverse such a decree, merely by raising a doubt founded on the

number or credibility of witnesses. The appellant in such case has all presumptions against him, and the burden of proof cast on him to prove affirmatively some mistake made by the judge below in the law or in the evidence. It will not do to show that on one theory, supported by some witnesses, a different decree might have been rendered, provided there be sufficient evidence to be found on the record to establish the one that was rendered." (See also *Walsh v. Rogers*, 13 How., 284; *The Water Witch*, *ib.*, 494; *The Narragansett*, 1 Blatchf., 211; *Cushman v. Ryan*, 1 Story, 95; and *The Grace Girdler*, 7 Wall., 204.)

"These cases cover the findings of judges and the verdicts of juries upon questions of fact in cases at law, as well as the findings of fact in causes in equity and admiralty jurisdiction. They fully establish the principle announced in *Fawcett v. Graham* and *Blanchard v. Strain*." (*Commissioners' Decisions*, 1869, p. 52.)

231. CASE MAY BE REMANDED FOR FURTHER INVESTIGATION OR AMENDMENT TO EXAMINER.—Where amendments are admitted while an appeal to the Commissioner is pending, the case should be again submitted to the examiner for investigation. (*Perry v. Lay*, *ib.*, 1869, p. 3.)

In the case of *Townsend ex parte* the Commissioner says: "This case is remanded to the primary examiner, at his request, for the purpose of giving further references to the applicant." (*Ib.*, September 14, 1870.) And in the case of *Oree ex parte* the Acting Commissioner says: "So far, then, as the references go, it must be judged that applicant is entitled to a patent upon his peculiar bale. The present claim, however, is objectionable. There is no relation between this special construction of bale and the adjustable clasp around the neck of

the bottle. The function of the two are entirely distinct, and they cannot properly be claimed in combination. For this reason the decision of the examiners-in-chief is affirmed, but with leave to applicant to amend his claim and specification before the primary examiner. (*Ib.*, August 3, 1870.) In the case of *Alice Appleton ex parte* the Commissioner says: "As the case now stands, I understand the examiner to affirm that the mode already in use of connecting knit-goods in common household practice is by a crochet-stitch, substantially the same as that of the applicant. This applicant does not deny upon the record; and as no means of comparison are furnished, the statement of the examiner must be accepted as true. The decision of the board of examiners-in-chief is affirmed, with leave to the applicant to move to remand the case to offer opportunity for amendment." (*Ib.*, 1869, p. 8.)

232. APPEAL FROM PRIMARY EXAMINERS TO THE COMMISSIONER.—Decisions of examiners upon preliminary or intermediate questions, or refusals to act, twice repeated, will be re-examined, upon application, by the Commissioner in person. (*Patent Office Rules, July, 1870.*)

In the case of *Wilkinson ex parte* the Commissioner says: "This application was rejected by the examiner, because, in his opinion, the device was 'essentially deficient in patentable invention.' Thereupon the applicant demanded a reference or a patent. The examiner gave no reference, and refused a patent. Applicant reiterates his demand for a reference, and appeals to the Commissioner in person.

"He has mistaken both his rights and his remedy. Rule 37 provides, that 'upon a rejection of an application

for want of novelty, the applicant will be furnished with a specific reference,' &c. The present application is not rejected 'for want of novelty,' but for want of 'patentable invention.' This objection may concede that the thing is new, but deny that invention was involved in its production. No reference is required, either by rule or by law, to establish this ground of rejection. But if it were so, the remedy is by appeal to the board of examiners-in-chief, and not the Commissioner in person. This is not a decision upon an intermediate question, or upon a refusal to act. The examiner's decision goes to the merits of the application, and is adverse to the applicant. If the examiner gives a general reference, and the applicant is entitled to a specific reference, and demands it, the remedy is by appeal to the board, who would then hold the general reference to be no reference, or an insufficient one, and reverse the decision of the examiner in rejecting the application. The case does not differ in principle from one in which a specific reference is given, which the applicant claims to be insufficient to form the basis of a judgment of rejection. (*Commissioners' Decisions, March 8, 1870.*)

"The determination of the question of title, the number of amendments, the structure of the specification, the correspondence of the drawings with the model or the written description, and the accuracy and completeness of the description, are executive acts, although discretion is exercised in their performance; but the judgment of the examiner upon what may be called the merits, the questions of patentability and of novelty, are judicial acts. From the judicial acts of the examiner, an appeal lies to the board; from his executive acts, the

appeal is to the Commissioner." (*Krake ex parte, Commissioners' Decisions*, 1869, p. 100.)

Thus, in the case of *Collins ex parte*, the Commissioner says:

"This is an appeal from the primary examiner. Applicant claims an 'improvement in screens or beds for receiving and securing the spawn of fish, in the art of pisciculture, whereby the process is greatly simplified and the labor diminished, and it consists in the use of a revolving screen, arranged and operating as described.'

"He describes the apparatus in detail. It consists of a box placed in the race-way of a fish-pond, provided with an 'upper screen of wire-cloth covered with gravel, on which the fish lay their spawn. Below this is a second screen of finer material, forming an endless apron, which receives the spawn from the upper screen and conveys it to a box below, where it is secured for use.

"This is all very plain and intelligible. The apparatus is well described by reference to the drawings and by well-chosen terms, and no one could have the slightest difficulty in constructing it and putting it in position for operation.

"The examiner, however, declines to examine the case upon its merits, but requires the applicant 'to be more specific in his description as to the manner of the deposition of the spawn, and how it passes through the gravel-bed, and what is its condition when it enters the chamber below, where and how the water enters the tank, when and where impregnation takes place, and where the embryo is developed.

"The examiner misconceives the nature of the invention. It is not an improvement in the process of pisci-

culture, but in spawning-screens. It is a mechanical device, performing mechanical functions. It is a mere instrument, to be employed by those skilled in the art, and its nature and functions are described in terms addressed to them. It cannot be necessary to accompany such description with a treatise on fish culture; and if the applicant had embodied such a dissertation in his specification, he would be justly obnoxious to the charge of 'unnecessary prolixity,' which is condemned in terms by the statute.

"The decision of the examiner is reversed, and the case will be examined on its merits." (*Ib.*, June 8, 1870.)

And in the case of *Blanchard ex parte* the Commissioner says:

"This is an appeal from the decision of the primary examiner.

"The applicant claims, 'as an improved article of manufacture, a mold-board for ridging plows, having the concavity G, for turning a furrow, a circular recess, g', and an adjustable circular plate, H, attached thereto, all as and for the purpose described.'

"This claim was rejected by the examiner, because the claim was for an 'article of manufacture,' while the invention was, according to the description, only 'a portion of a machine.'

"The applicant seems to suppose the examiner to have denied that a part of a machine was patentable. If this were so, it would unquestionably be an error. But the examiner means to affirm no more than that a fraction of a machine cannot be claimed as 'an article of manufacture.'

"By the true construction of the word 'manufacture,'

as used in the patent act, it fairly covers only such manufactured articles or products as are complete in themselves, or, if parts of a whole, are so far complete as to be the subject of separate manufacture and sale. Thus a lamp chimney is intended to be used with a lamp and not otherwise, nevertheless it may properly be made, sold, and patented as a new manufacture.

“In this case applicant admits that ‘this mold-board is adapted and applicable only to this single kind of plow. It is, in other words, a mere fraction of a machine. If a material part, it may be claimed as such, but it is not in any proper sense an article of manufacture.

“The decision of the primary examiner is affirmed.”
(*Ib.*, June 13, 1870.)

233. FORM OF APPEAL FROM THE EXAMINERS-IN-CHIEF TO THE COMMISSIONER.—

To the Commissioner of Patents.

SIR: We hereby appeal to the Commissioner in person from the decision of the examiners-in-chief in the matter of our application for the reissue of letters patent for an improvement in cotton presses granted to Anthony Bowen, May 18, 1865. The following are assigned for reasons of appeal:
[Here follow reasons.]

WILLIAM MARTIN.

CLAUDIUS JENKINS.

XIV. Appeal to the Supreme Court of the District of Columbia.

SEC.

234. Appeal to court sitting in banc.

235. Appellant to notify Commissioner.

236. Papers accompanying notice.

237. Time of filing reasons of appeal.

238. Reasons of appeal should not be vague and unsatisfactory.

SEC.

239. Forms furnished by the office.

240. Appellant to furnish certified copies.

241. Duties of Commissioner.

242. Insufficiency of Commissioner's reasons.

- Sec.
243. Commissioner and examiners may be examined.
244. Duty of the court.
245. Revision confined to reasons of appeal.
246. Appeal tried upon evidence before Commissioner.
247. Decision to govern further proceedings.
248. Validity of patent may be contested.
249. Rules of the court.
250. Cases in which an appeal does not lie.

- Sec.
251. Court cannot order patent to issue or consider amendments which have not been examined.
252. Decision binding only upon questions submitted.
253. Decisions followed as precedents.
254. Form of petition to the court.
255. Form of certificate of Commissioner.
256. Form of notice and reasons of appeal.

234. APPEAL TO THE COURT SITTING IN BANC.—If a 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. (*Act of July 8, 1870, § 48.*)

235. APPELLANT TO NOTIFY COMMISSIONER.—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. (*Ib., § 49.*)

236. PAPERS ACCOMPANYING NOTICE.—The mode of appeal from the decision of the office to the supreme court of the District of Columbia is by giving written notice thereof to the Commissioner; said notice being accompanied by the petition, addressed to the supreme court of the District of Columbia, by the reasons of appeal, and by a certified copy of all the original papers and evidence in the case. (*Patent Office Rules, July, 1870.*)

287. **TIME OF FILING REASONS OF APPEAL.**—The reasons of appeal must be filed within thirty days after notice of the decision appealed from. (*Ib.*)

The filing of the "reasons of appeal" is essentially the appeal itself. (*Greenough v. Clark, MS. Appeal Cases, D. C., 1858.*) And where the reasons of appeal are not filed within the time prescribed by the Commissioner of Patents, the right of appeal is lost. (*Ib.*) For an appeal cannot be made after the time limited in the notice of appeal. (*Linton ex parte, ib., § 1850.*) The Commissioner may, however, enlarge the time to file such reasons. (*Greenough v. Clark, ib., 1858.*) He may extend the time of appeal; it is a matter within his discretion. (*Justice v. Jones, ib., 1859.*)

288. **REASONS OF APPEAL SHOULD NOT BE VAGUE AND UNSATISFACTORY.**—The reasons of appeal should be so expressed that the court may gather from their language what is meant by them, but they need not be according to any technical formula. (*Laidly v. James, MS. Appeal Cases, D. C., 1860.*) They should not be vague and unsatisfactory, but should involve some point affecting the decision of the Commissioner. (*Winslow ex parte, ib., 1850.*) And no assignment is sufficiently specific which does not with reasonable certainty point out the precise matter of alleged error. (*Douglass v. Blackington, ib., 1859.*) Thus, the following alleged reasons of appeal have been held to be insufficient: "That the decision of the Commissioner was inconsistent, as opposed to precedents which have governed before;" (*Winslow ex parte, ib., 1850;*) "that the decision of the Commissioner was in opposition to a clear apprehension of the merits of the case," (*ib.;*) or, "is against evidence or the weight

of evidence;" (*Douglass v. Blackington, ib.*, 1859;) "that the reasons assigned by the Commissioner for rejecting an application are irrelevant, and do not apply to the subject-matter." (*Aiken ex parte, ib.*, 1850.)

A reason of appeal, "that there was no evidence of any device or arrangement like that of the applicant," was held by Cranch, C. J., to be no ground for reversing the decision of the Commissioner, as he might have had other grounds than the evidence offered for the rejection. (*Crooker ex parte, ib.*, 1850.) And when the reason of appeal was "that the decision of the Commissioner was adverse to the opinions of skillful and competent practical and scientific men, who were peculiarly qualified to judge as to the merits of the particular invention," it was held that this reason did not involve the question of novelty, and the opinion of such experts could not affect the question of novelty. (*Winslow ex parte, ib.*)

An objection to the *opinion* of the Commissioner, as to the intention of an invention, cited as a cause of rejection, is not a good "reason of appeal." Whatever may have been his opinion, his decision may be correct. (*Crooker ex parte, ib.*, 1850.)

239. FORMS FURNISHED BY THE OFFICE.—Printed forms of notice of appeal, of the reasons of appeal, and of the petition will be forwarded on request. (*Patent Office Rules, July, 1870.*)

240. APPELLANT TO FURNISH CERTIFIED COPIES.—The party appealing shall lay before the court certified copies of all the original papers and evidence in the case. (*Act of July 8, 1870, § 51.*) The original files in the case cannot be taken from the office to the court, but certified

copies of the record and references, to be used as evidence, will be furnished at the usual rates. (*Patent Office Rules, July, 1870.*)

241. DUTIES OF COMMISSIONER.—On receiving notice of the time and place of hearing such appeal, the Commissioner shall notify all parties who appear to be interested therein, in such manner as the court may prescribe. (*Act of July 8, 1870, § 51.*) And the Commissioner shall furnish it with the grounds of his decision, fully set forth in writing, touching all the points involved by the reasons of appeal.

242. REASONS OF COMMISSIONER MAY BE INSUFFICIENT, YET HIS DECISION CORRECT.—And the insufficiency of the Commissioner's reasons for rejecting an application is not in itself evidence that his decision is wrong, and is no cause for reversing it. (*Aiken ex parte, Commissioners' Decisions, 1858.*)

And it is immaterial what reasons the Commissioner assigns for his decision; his reasons may be insufficient, and yet his decision be correct. (*Ib.*)

The court is only required to examine the *conclusions* which the Commissioner may have arrived at in any given case, and not the process or reasons by which such conclusions may have been attained. (*Spencer ex parte, Ib.*)

243. COMMISSIONER AND EXAMINERS MAY BE EXAMINED.—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 machine or other thing for which a patent is demanded. (*Ib.*)

An examiner may be inquired of as to the nature and

features of the invention under consideration and essential to the right claimed, and which may not be sufficiently set forth in the report of the Commissioner. (*Seely ex parte, ib.*, 1853.)

The officer of the Patent Office who may attend before the judge on an appeal is not considered as counsel for the Patent Office, or as an advocate of either of the parties litigant. He only attends for the purpose of explaining the decision of the Commissioner. (*Perry v. Cornell, ib.*, 1847.)

The language of the statute means, that the explanation authorized to be required of the Commissioner and examiners may be so full and clear an explanation of the principles of the thing, as to enable the judge duly to apply and weigh the evidence offered to support the issue in the case, and is not to be limited to a mere exposition of the terms used; and such explanations so given the judge is bound to respect as a part of the case. (*Richardson v. Hicks, ib.*, 1854.)

244. DUTY OF THE COURT.—It shall be the duty of said court, on petition, to hear and determine such appeal, and to 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, notifying the Commissioner of the time and place of hearing; and the revision shall be confined to the points set forth in the reasons of appeal. (*Act of July 8, 1870, § 50.*)

245. REVISION CONFINED TO POINTS SET FORTH IN REASONS OF APPEAL.—The jurisdiction of the court on appeal is confined to the reasons of appeal. (*Arnold v. Bishop, MS. Appeal Cases, D. C., 1841, ib.*, § 50; *Smith v. Flick-*

inger, *ib.*, 1843; *Cochrane v. Waterman*, *ib.*, 1844; *Aiken ex parte*, *ib.*, 1850.) And however worthy of consideration a proposition or argument may be, if not within such reasons, it must be disregarded. (*Burlew v. O'Neil*, *ib.*, 1853.) The court can revise the decision of the Commissioner only in respect to points involved in the reasons of appeal; and if the Commissioner did not err in those points, his decision must be affirmed, even though the judge should be of the opinion, upon the evidence and merits of the whole case, that such decision was wrong. (*Arnold v. Bishop*, *ib.*, 1841.) The powers and jurisdiction given to it on appeal are special and limited, and must be construed and exercised strictly. (*Pomeroy v. Connison*, *ib.*, 1842.) The court can only decide such questions and render such judgment as it is expressly authorized by the statutes to decide and render. (*Ib.*) It is not at liberty to look into every error of fact or law which may have been committed in the case, but only to such as have been specifically pointed out by the reasons of appeal. (*Laidly v. James*, *ib.*, 1860.)

246. APPEAL TRIED UPON EVIDENCE BEFORE COMMISSIONER.—The appeal will be tried upon evidence which was in the case and produced before the Commissioner. (*Act of July 8, 1870, § 50; Rules of Supreme Court, D. C., p. 94.*) And the question must be decided according to such evidence. (*Warner v. Goodyear*, *MS. Appeal Cases, D. C.*, 1846; *Perry v. Cornell*, *ib.*, 1847.) The court is limited by law to the papers and evidence which were before the Commissioner. (*Saunders ex parte*, *ib.*, 1861.) And whether his decision is correct or erroneous must depend upon the evidence and proofs before him. (*Ruggles v. Young*, *ib.*, 1853.)

The court on appeal has no power to send the case back to the Patent Office, to take proofs by competent experts as to the alleged utility of the invention, or to hear such proofs on appeal. (*Saunders ex parte, ib.*, 1861.) But where a party has been prevented from producing before the Commissioner proofs to support his claim, it is the duty of the court to pursue such a course as will afford the party an opportunity to produce such proofs, and the court will make an order authorizing the party to take and file with his appeal evidence as to the originality and utility of his invention. (*Fultz ex parte, ib.*, 1853.)

Affidavits cannot be considered on appeal which were not acted on by the Commissioner in forming his decision nor taken by his authority. (*Jackson ex parte, ib.*, 1856.) And an objection not taken at the hearing before the Commissioner cannot be made on appeal to the court. (*Smith v. Flickenger, ib.*, 1843.) But if new references are made at the trial of an appeal before the court, as grounds for the rejection of an application for a patent, and are such as are material, they will be considered as having deprived the applicant of his right of amendment, and in such case the decision of the Commissioner will be reversed, and he will be directed to proceed with the case anew. (*Root ex parte, ib.*, 1853.)

247. DECISION TO GOVERN FURTHER PROCEEDINGS 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 govern the further proceedings in the case. (*Act of July 8, 1870, § 50.*)

248. VALIDITY OF PATENT MAY BE AFTERWARDS CONTESTED.—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. (*Ib.*)

249. RULES OF THE SUPREME COURT IN APPEALS FROM THE COMMISSIONER OF PATENTS.—First. All appeals taken from the decisions of the Commissioner of Patents to the supreme court of the District of Columbia shall be entered in a docket to be kept for that purpose by the clerk of the court; and every rule, motion, or order made in every pending appeal, and the final decision made in each case, shall be recorded in the minutes of the court, to be kept by the clerk for the purpose.

Second. The party desiring to appeal from the decision of the Commissioner of Patents must give written notice thereof to the Commissioner, accompanied with his petition to the supreme court of the District of Columbia to grant him a hearing, and file the reasons of appeal.

Third. The appellant, previous to any action on and preparatory to the hearing of any appeal, must comply with the requisites of the law in the Patent Office, and his petition must state concisely, 1. The application for the patent; 2. Its nature; 3. The Commissioner's refusal; 4. The prayer of appeal; 5. Notice thereof to the Commissioner; 6. The filing of the reasons of appeal in the Patent Office.

To every petition must be annexed a certificate of the proper officer that the requisitions of the law have been complied with, or an affidavit of the truth of the facts stated in the petition.

No notice to the Commissioner will be issued until such certificate or affidavit be made or produced.

The appeal will be tried upon the evidence which was in the case and produced before the Commissioner.

Fourth. The appellant must file his argument in writing, within five days after the Commissioner shall send in his report, and the papers, models, and drawings or specimens, or within five days after the day of hearing, which argument must state the facts and law relied on, together with the authorities in support of the same.

Fifth. At the hearing oral arguments may be made, not to occupy more than one hour for each counsel engaged, and not more than two counsel in each case will in any case be heard.

Sixth. In no case will arguments before the court be heard, except made by the party in interest in person, a member of the bar of this court, the superior or supreme court of a State, Territory, or District of the United States, or a duly licensed solicitor of patents, in good standing before the Patent Office, and admitted to practice before this court as the appellate tribunal from the decisions of the Commissioner of Patents.

Seventh. The court, having fully heard the appeal, shall return to the Commissioner a certificate of its proceedings and decisions, which shall be entered of record in the Patent Office, and such decisions, so certified, shall govern the further proceedings of the Commissioner in such case.

250. CASES IN WHICH AN APPEAL DOES NOT LIE.—Nothing preliminary to the issuing of a patent, unless made so by the law authorizing appeals, is a valid ground of appeal. (*Wade v. Mathews, MS. Appeal Cases, D. C., 1850.*) No appeal lies from matter within the discretion of the Commissioner, as extending time to take testimony, &c.,

(*Hopkins v. Lewis, ib.*, 1859,) or the refusal of the Commissioner to grant a rehearing. (*Rouse ex parte, ib.*, 1854.) And questions as to the practicability or usefulness of an invention and the reducing of it to practice are matters within the discretion of the Commissioner, and are not made the subjects of appeal. (*Wade v. Mathews, ib.*, 1850.) And where the decision of the Commissioner neither affirms nor denies the right of an applicant to the patent, (which he claims,) upon the merits of the supposed invention, it is not such a decision as is the subject of appeal. The refusal, therefore, of the Commissioner to revise and revoke a decision of one of his predecessors in office rejecting an application for a patent, is not a ground of appeal. (*Janney ex parte, ib.*, 1847.)

The law requires the Commissioner to aid the inventor, by information and suitable references, to remedy a defective specification or claim, and to assist his judgment in determining whether he should withdraw or persist in a rejected application. (*Vide supra*, p. 17.) But the manner of doing so, how often, and to what extent, is left to the discretion of the Commissioner; and it is not the subject of review whether this duty is well and sufficiently performed in a certain instance. (*Chambers ex parte, MS. Appeal Cases*, 1859.) And it is not proper matter for the appellate tribunal that the Commissioner has not given a party such reasons for his decision, and made such suggestions as to enable him to judge of the expediency of abandoning or modifying his application. (*Spencer ex parte, ib.*, 1859.)

251. THE SUPREME COURT HAS NO AUTHORITY TO ORDER A PATENT TO ISSUE, OR TO DECLARE AN AMENDED SPECIFICATION ENTITLED TO A PATENT, WHICH HAS NEVER BEEN

RECEIVED OR EXAMINED AT THE OFFICE.—In the case of *Whiteley and Gage ex parte, motion*, (*Commissioners' Decisions*, 1869, p. 53,) the Commissioner says: "William Gage obtained letters patent September 16, 1856, for improvement in harvesters, which were assigned to himself and Andrew Whiteley, who on February 18, 1865, applied for permission to surrender the same, and for a reissue thereof in four divisions, designated as A, B, C, and D, respectively.

"The applications, after much correspondence and various amendments, were finally rejected by the examiner, from whose decision an appeal was taken to the board of examiners-in-chief. The board affirmed the decision of the primary examiner, and their decision, in turn, was affirmed, on appeal, by the Commissioner.

"An appeal was taken from the decision of the Commissioner to Justice Wylie, one of the judges of the supreme court of the District of Columbia, who at first reversed the decision of the Commissioner, but subsequently reopened the case, reheard it, and affirmed the Commissioner's decision. The opinion of Justice Wylie was delivered May 22, 1866.

"On May 30, 1866, applicants presented another amendment, which the office refused to receive, upon the ground that the decision of the judge was final, and that the case was no longer open for amendment.

"From this decision applicants again appealed, August 5, 1867; but no steps were taken under the appeal until August 25, 1868, more than two years after the last action of the office, when applicants appealed 'from the final action of the department refusing to grant reissued patents upon divisions A, B, C, and D.'

"The office replied to the notification of appeal, that

the alleged appeal was too indefinite in its terms to be entertained; and, further, that there had been no decision of the department (not already appealed from) from which an appeal would then lie. The office further declined to send the papers to the judge.

“On the same day that the appeal was taken, to wit, August 25, applicants presented to the office four entire new specifications, which they asked leave to substitute for the original and amended specifications, for the purpose of having the new specifications considered upon the appeal before Justice Fisher.

“On December 8, 1868, Justice Fisher rendered a decision in the matter of the appeal upon the four divisions, in the following terms: ‘I hereby reverse the decision of the Commissioner of Patents of the 30th day of May, 1866, refusing to allow the applicants to amend their specifications so as to eliminate therefrom the objectionable language which prevented their obtaining the reissue prior to that date, and order that the reissues, in divisions A, B, C, and D, be *forthwith issued, in accordance with the amended specifications filed August 25, 1868.*’

“At the time of the hearing, if hearing there were, before the learned justice, none of the original papers were before him, no amended specifications had ever been filed in the office, and there is no evidence to show upon what amended specifications he proposed ‘forthwith’ to issue the reissues. Certain papers are in the files, bearing date August 25, 1868, without office mark, and which are not identified as those which were presented to the judge. If, however, these were the specifications upon which the learned judge directed the patent to issue, it is to be remarked concerning them, that they have never yet been

before an examiner in the office, that the novelty of the improvements claimed has never been examined in any way, and that if the patents were now to issue upon these specifications, they would issue without having been subjected to the scrutiny provided by law for protection against mistake and fraud, and without applying to them any of the tests which the law has provided for ascertaining the novelty or utility of any of the improvements claimed therein. How grave an error this would be will appear when it is further stated, that the original patent granted to William Gage contained but two claims. As in contemplation of law each claim embodies a separate invention, these two claims stood, in effect, for two patents. They were very modest in their scope, and the machine which they describe was of limited value. In fact, so far as is known to the office, it has never been manufactured. Yet from this small beginning the four specifications, dated August 25, 1868, and which the learned judge orders the office to patent without examination 'forthwith,' present no less than twenty-one claims each, or eighty-four claims in all; eighty-four claims, representing eighty-four different inventions, and equivalent to eighty-four different patents, springing from two. This is expansion of the most formidable character; and yet, upon the simple presentation of this batch of inventions to the judge, the office is required to patent them forthwith, without inquiring into novelty, utility, form, or structure of claims, or any other matters which the law requires to be ascertained by the office before any patent shall issue. Nay, more than this; the learned justice, six days later, made a further order, directing these eighty-four claims, when issued, to be antedated to February 18,

1865, so that the effect would have been to make them retroactive for nearly *four years*; thus seeking to sweep within their grasp, as infringers, all manufacturers who for four years had built machines in utter ignorance of such claims, of claims which, in fact, had no existence prior to August 25, 1868.

“Each of these orders was issued in contravention of law. The learned judge had no jurisdiction to make them. They are absolutely null and void, and I am compelled to decline to execute them. The whole purpose of the establishment of the Patent Office would be destroyed. Its corps of examiners, its collection of mechanical and scientific books, its record of patents heretofore granted, its vast collection of models and drawings and of foreign patents, and, in short, all its appliances for the examination into the novelty of alleged inventions, would be useless if applicants can appeal, upon any pretext, to a judge of the supreme court of this District, and, upon such appeal, present him with a new specification and new claims, which have never been examined, and which may embody the inventions of other men, and procure from him an order to this office to issue a patent upon such specifications ‘forthwith.’

“No such power is vested in the appellate judge by law.

“The jurisdiction of the judge upon appeal from the Commissioner of Patents is limited. It extends only to a review of the reasons of the Commissioner for refusing an application for an original or reissued patent in the first instance, and to a review of the judgment of the Commissioner in interference cases. No power is given to the judges of the supreme court of the District to re-

view the executive or ministerial acts of the Commissioner, or acts the doing or not doing of which rests in his sound discretion. Until a very recent period the judges of that court have uniformly declined to take such jurisdiction or to usurp the purely executive functions of the Commissioner.

“In the present case the Commissioner refused a patent to applicants upon the claims as presented; they appealed from his decision, and their appeal was not sustained. The jurisdiction of the judge over the case ended with the decision of the appeal. Subsequently the applicants asked leave to amend. They had amended four times already, had insisted upon their application, had chosen to take a final rejection, which, upon appeal, was affirmed.

“Whether the Commissioner would allow further amendment or not was a matter entirely within his discretion. It was not a matter of right with the applicants. It is a motion for an amendment and rehearing; for a new trial. Such motions are always regarded as within the discretion of the officer to whom they are addressed. The granting or refusal to grant them is never a proper subject of appeal.

“In *Wylie v. Coxe*, (14 How., 2,) the supreme court say: ‘In relation to the order, it is plain no appeal will lie from the refusal of a motion to open the decree and grant a rehearing. The decision of such a motion rests in the sound discretion of the court below, and no appeal will lie from it.’

“In *Rouse ex parte* (*Book of Appeals*, vol. 2, p. 313) Judge Dunlop says: ‘One full, fair, and impartial trial between the same parties, and for the same matter of controversy,

is all that any citizen can claim under this statute or any other law known or practiced by the courts of this country. If, from surprise, accident, or fraud, or new-discovered proof, or any other legal cause, a fair and full trial has not been had, the remedy is by rehearing or a new trial, or some equivalent proceeding in the tribunal where the first trial took place. The sound discretion of that tribunal must be invoked, and from its refusal to interfere there is no appeal.'

"The case of Rouse, as stated by the learned judge, was as follows: 'In the present case the Commissioner, in the exercise of his discretionary power, refused to Rouse the withdrawal of the first and the filing of his second application, and refused to declare a new interference between him and Dodge; and in effect refused to give him another hearing.'

"In the case of *Raymond ex parte* (*Book of Appeals, vol. 3, p. 443*) Judge Dunlop says: 'An appeal lies by law from the decision of the Commissioner to either of the judges of the circuit court of the District of Columbia. Whichever of the judges of that court is applied to *decides it finally, and no other judge of that court can entertain another appeal in the same case* and review the former decision; that former decision is final and conclusive upon either of the other judges sitting at chambers.'

"And yet, in the present case, Justice Fisher not only reviewed the decision of Justice Wylie, his brother justice, but remarked upon that decision as follows: 'The appellants thereupon, I think, might well have treated the action of Justice Wylie in rehearing the case and reversing his own decision *as a mere nullity*, and have rightfully demanded their reissues in their several divisions,

A, B, C, and D, without offering to amend their claims in any respect whatever.'

"In the case of *Janney ex parte* (*Book of Appeals, vol. 1, p. 221*) Chief Justice Cranch says: 'The act of 1839 gives the right of appeal to the judge only in cases where an appeal was by the previous act allowed from the decision of the Commissioner to a board of examiners, and then only when a patent was refused. In the present case he has not refused a patent. He decides only that he will not examine the merits of the claim which has been twice rejected after a full examination of his predecessors in office. This refusal was not a ground for appeal to examiners under the seventh section of the act of 1836, and therefore is not a ground of appeal to the judge.'

"It is obvious, therefore, that the refusal of the Commissioner to allow further amendment, after the case had been decided upon appeal by Justice Wylie, was not upon any ground the proper subject of an appeal, and that Justice Fisher was without jurisdiction in the premises.

"But even if the appeal had been properly entertained, he was equally without jurisdiction to make the order which he entered December 8, 1868. By the terms of that order he directed 'that the reissues, in divisions A, B, C, and D, *be forthwith issued*, in accordance with the amended specifications filed August 25, 1868.'

"No power is conferred upon the appellate judge to order a patent to issue. His power, at most, extends to a reversal of the decision of the Commissioner from which an appeal is taken. The act of March 3, 1839, substituting the chief justice of the district court of the District of Columbia for the board of examiners, expressly declares that 'the Commissioner shall also lay before said

judge all the original papers and evidence in the case, together with the grounds of his decision, fully set forth in writing, touching all the points involved by the reasons of appeal, *to which the revision shall be confined.* * * *

‘And it shall be the duty of the said judge, after a hearing of any such case, to return all the papers to the Commissioner, with a certificate of his proceedings and decision, which shall be entered of record in the Patent Office; and such decision, so certified, *shall govern the further proceedings* of the Commissioner in such case.’

“The act of July 4, 1836, § 7, provided, with reference to the board of examiners, as follows: ‘And, on an examination and consideration of the matter by such board, it shall be in their power, or of a majority of them, to reverse the decision of the Commissioner, either in whole or in part; and, their opinion being certified to the Commissioner, he shall be governed thereby *in the further proceedings to be had on such application.*’

“It is obvious that nothing like an order from the judge directing the patent to issue was contemplated by these provisions. In fact, they give no power to the judge to make any order whatsoever. He may decide the question before him and may certify his decision, but he is not authorized to *order* the Commissioner to do anything whatsoever.

“This view of the statute is sustained by the decisions. In *Arnold v. Bishop* (*Book of Appeals*, vol. 1, p. 80) Chief Justice Cranch says: ‘The words of the act are that the judge’s decision *shall govern the further proceedings of the Commissioner in such case.*’ This must apply only to so much of the case as is involved in the reasons of appeal; and the appeal itself can be considered only as an appeal to so

much of the decision of the Commissioner as is affected by such reasons. If, therefore, after the judge shall have decided in favor of the applicant upon the points involved upon his reasons of appeal, other sufficient reasons remain for rejecting the claim for a patent, untouched by the decision of the judge, it would seem that the Commissioner might properly still reject it.'

"In *Potter v. Dixon* (2 *Fish.*, 381) it appeared that in an interference between Singer and Wilson an appeal had been taken to Judge Dunlop, who, upon hearing, decided in favor of Wilson, *and ordered a patent to issue to him.* After the return of the papers to the Patent Office the Commissioner discovered that the application interfered with the patent of a third party, and a new interference was declared. Upon appeal to Judge Dunlop he refused to look into the case upon its merits, but peremptorily ordered the Commissioner to execute his first order. Upon this Mr. Justice Nelson says: 'Section eleven of the act of 1839 *does not provide that the Commissioner shall issue a patent to the applicant if the decision of the chief justice is in his favor, but simply declares that it shall 'govern the further proceedings of the Commissioner in such case;'* and so it should, as it respects parties concerned, but not as to other parties who may come in and claim the benefit of the provision.

"We are quite clear, therefore, that the learned chief justice erred in refusing to entertain the appeal in the case of the interference declared with the A. B. Wilson patent, and that his order to the Commissioner, dissolving the interference and directing his order in the case of the interference with the I. M. Singer patent to be executed, *was a nullity.'*

“But the learned justice not only directed the patents to be issued forthwith, but he directed them to be antedated to February, 1865.

“Without discussing at this time the question of antedating reissues, or stopping to expose the enormity of such a practice, it is sufficient to say that this part of the order of the learned justice was equally without authority. Upon this point the supreme court, of which the learned justice is a member, sitting *in banc*, upon an application for a mandamus to compel the Commissioner, in this very case, to issue these very reissues antedated as ordered, expressly declared, Chief Justice Cartter delivering the opinion of the court: ‘In the case of *Gage and Whiteley v. The Commissioner of Patents*, the court has come to the conclusion to deny the application for the mandamus, for the want of jurisdiction in the appellate judge to make the order the violation of which is complained of.’ * * * ‘It is very clear to the mind of the court that Judge Fisher had no jurisdiction in the premises. The jurisdiction is limited. It is limited to an appeal circumscribed to the rights of the reissue of the patent.’

“It is believed, if the application for the mandamus had covered the first decision of the learned justice as well as the second, that it would have received the same condemnation from the full bench. My predecessor declined to obey these orders; and entertaining these views, and sitting here not only as the guardian of the rights of inventors, but of those of the public, and especially of the manufacturing public, I cannot, under the circumstances, consent to the issue of these reissued patents.

“As regards the division of this batch of applications which is designated as Division G, the facts are as follows:

During the pendency of the application for divisions A, B, C, and D, and before the decision of Justice Wylie, applicants amended Division A by taking therefrom the fourteenth claim and framing a new division, called Division E, with five claims of invention. On October 29, 1866, applicants filed a fresh division, called Division F, with five more claims. These divisions were both rejected by the office, on the ground that the claims presented involved no patentable subject-matter. They were appealed to the board of examiners, to the Commissioner, and finally to Justice Fisher, who overruled the action of the office, and ordered the patents to issue, with antedate to February 18, 1865, more than a year before either of the applications were filed in the office. The office declined to antedate, but finally obeyed the order so far as to issue the patents in the fall of 1868, although the novelty of the claims had never been examined. Since the last decision of Justice Fisher, upon divisions A, B, C, and D, the applicants have again proposed to amend Division A by taking therefrom the twenty-first claim, framing a new division, to be called Division G, and expanding the single claim extracted from Division A into twenty-two claims.

“It will thus be seen that the original patent of William Gage, with its two claims, has now reached, in the hands of applicants, the formidable proportions of *seven* patents, with no less than *one hundred and sixteen* claims.

“Division G, so-called, cannot be allowed. The original patent is surrendered, and has been reissued in divisions E and F.

“It has no vitality to support another division. Chief Justice Cartter, in *Whiteley, assignee of Weeks, ex parte*,

said: 'This motion raises the question simply as to the effect of the surrender of a patent. Can such patent, after its surrender, be received and treated by the office or the judge as having legal vitality in such wise as to give authority for reissue? If I correctly comprehend the subject, it cannot. The surrender of a patent, and letters patent granted in reissue for the same subject upon such surrender, is the death of the first patent in the life of the second. Whatever of title to the subject of the patent survives is to be found in the letters of reissue, and not in the patent out of which such letters grow, and any application thereafter made for reissue should be based upon the reissued letters patent. Inasmuch as this application is made upon an expired title, there is no authority in the office to comply with it.'

"It is true that this opinion of the chief justice was overruled by his associate, Justice Fisher, in the same case, and that a patent was ordered to issue 'forthwith;' but, though there be a conflict of opinion between the two justices, I still think myself justified in quoting so respectable an authority as Chief Justice Cartter.

"If it be said that Division G derives its vitality from Division A, and not from the surrendered original, the obvious answer is that Division A was no longer open for amendment. Whether the decision of Judge Wylie against it was final, or whether Justice Fisher was authorized to order it to issue 'forthwith,' it was equally removed from the power of applicant to alter or amend it in any way.

"The statute which permits a division of reissues is section 5 of the act of 1837, which provides, 'That whenever a patent shall be returned for correction and reissue

under the thirteenth section of the act to which this is additional, and the patentee shall desire several patents to be issued for distinct and separate parts of the thing patented, he shall first pay,' &c.

“This provision evidently contemplates nothing more than that, when his rights are determined and the Commissioner is willing to allow him a patent, he may receive distinct improvements in several patents. The whole transaction is single. The divisions make up but one patent, and should be treated as one application until finally disposed of. No provision is made for issuing a patent for some undisputed part of the invention, and carrying on a contest subsequently for another patent for some other part.

“Accordingly, in *Selden ex parte, Book of Appeals*, vol. 3, p. 459, Judge Morsell said: ‘The case is that application which embraces the *whole* matter, however it may become afterward divided into parts, unless the law declares it to be otherwise.’ And again: ‘The case is that which is set forth as the ground of the application in the incipient stages of it, and includes or embraces the whole, and not a part only, each part of which is only a part of one whole; and so it must be here considered, notwithstanding the after effect produced by reissuing separate patents for each part; and such has been the invariable contemporaneous practice by the office and the judges ever since the passage of the law.’

“Since, therefore, the patent of William Gage has been reissued in the divisions known as E and F, I am of opinion that no other division of reissue for the same patent can be entertained by the office.

“The fee paid by applicant is subject to his order, but

the application filed by him and marked Division G cannot be examined.

252. THE DECISION OF THE APPELLATE TRIBUNAL IS BINDING ONLY UPON THOSE QUESTIONS WHICH WERE SUBMITTED TO ITS CONSIDERATION.—In the case of Andrew Whiteley, *ex parte*, Mr. Justice Fisher says: “On the 21st day of May, 1863, Whiteley applied for a reissue in three divisions, having surrendered the reissued patent. The Commissioner of Patents refused this second reissue, on the ground that as Ball, Aultman & Co. possessed an exclusive right to the invention, under the original patent, within the limits of the State of Ohio, and as the Hawleys also had the exclusive right to said invention within the limits of the northern counties of Illinois, under the reissue of 1858, Whiteley was only the grantee of an exclusive sectional interest, and not of the entire patent.

“From this decision Whiteley prayed an appeal to a justice of the supreme court of the District of Columbia, but the Commissioner refused to grant the appeal also, which was continued to be withheld from him until the early part of the year 1867, when the Supreme Court of the United States, in a case of mandamus, to which Whiteley and the late Commissioner, D. P. Holloway, were the parties, declared that Whiteley was entitled to have his appeal as a matter of right under the patent laws, and that if the mandamus issued by the supreme court of the District of Columbia, then under consideration of the Supreme Court of the United States, had directed the Commissioner to allow the appeal, such an order would have been held correct.

“On the 9th day of April, 1867, soon after the Supreme Court of the United States had made this declar-

ation, Whiteley filed his reasons of appeal, and brought the case to hearing before Chief Justice Cartter, who, on motion of J. J. Coombs, esq., on behalf of the Commissioner of Patents, dismissed the appeal, upon the ground that on the 11th day of February, 1867, Whiteley 'had assigned all his right, title, and interest in said patent to Whiteley, Fissler & Kelly, who, on the 18th day of March, 1867, assigned all their right, title, and interest therein to Jonathan Haines,' the first patentee, and that this transfer divested him (Whiteley) of all interest or control over the title to the invention, 'and that the effect of issuing letters patent for the residue of the term—that is, of granting a reissue to Whiteley'—would be to force a title in defiance of the act of the party and in fraud of his assignee.

“The Commissioner's decision, adverse to Whiteley, had been made several years previous to the appeal being brought before Judge Cartter, and the reasons of appeal were filed also several years before, and all long before the assignment made by Whiteley to Whiteley, Fissler & Kelly, so that the ground upon which Judge Cartter dismissed the appeal was not involved at all in any of the questions raised by the assignment of errors in the appeal. The principal question raised by the errors assigned in the Commissioner's decision was whether, at the time of the surrender and application for a second reissue, on the 21st May, 1863, Andrew Whiteley was entitled, as the assignee, of the original patentee, to have a reissue, or whether, as the Commissioner decided, he was only the grantee of an exclusive sectional interest, and not the assignee of the original patent, and therefore not entitled to the reissue.

“The appeal, being thus dismissed without any decision of the question raised by the appellant’s reasons of appeal, and on matters arising long after the rendition of the Commissioner’s decision, Whiteley again appealed on the 8th March, 1868, assigning in his reasons of appeal but one error, viz, that ‘the Commissioner of Patents, then D. P. Holloway, erred by holding that the applicant was but the grantee of an exclusive sectional interest in the patent sought to be reissued, and therefore not entitled to the reissue, when the assignment showed that Haines had transferred to him the patent itself, when no interest in it was owned by any other person, and did this for enabling the assignee to procure its reissue, the same as he might have done in the absence of this assignment.’

“The first question for my decision is whether the appeal is now properly before me, an appeal having been brought in the same case and upon the same grounds substantially before Chief Justice Cartter, and dismissed by him, as before stated. If the former appeal were properly and lawfully determined or dismissed, the present appeal could not be entertained. Was the former appeal thus legally disposed of? I do not think it was. The jurisdiction of the supreme court of the District of Columbia in appeal from the decisions of the Commissioner of Patents is a special and limited jurisdiction. It is therefore the duty of the justice to whom an appeal is brought to confine himself strictly within the limits prescribed by the act conferring that jurisdiction. This jurisdiction was conferred first upon a board of examiners by act of July 4, 1836; afterwards, by act of March 3, 1839, it was transferred to the chief justice of

this District; afterwards, by act of August 30, 1852, it was extended to the assistant judges of the old court; and, by the act of March 3, 1863, it was transferred to the justices of the supreme court of the District of Columbia. Section 11 of the act of March 3, 1839, provides as follows: 'In all cases where an appeal is now allowed by law from the decision of the Commissioner of Patents to a board of examiners, provided for in the seventh section of the act to which this is additional, the party, instead thereof, shall have a right of appeal to the chief justice of the district court of the United States for the District of Columbia, by giving notice thereof to the Commissioner, and filing in the Patent Office, within such time as the Commissioner shall appoint, his reasons of appeal, specifically set forth in writing, and also paying into the Patent Office, to the credit of the patent fund, the sum of \$25. And it shall be the duty of said chief justice, on petition, to hear and determine all such appeals, and to revise such decisions in a summary way on the evidence produced before the Commissioner, at such early and convenient time as he may appoint, first notifying the Commissioner of the time and place of hearing, whose duty it shall be to give notice thereof to all parties who appear to be interested therein, in such manner as said judge shall prescribe. The Commissioner shall also lay before the said judge all the original papers and evidence in the case, together with the grounds of his decision, fully set forth in writing, touching *all the points involved by the reasons of appeal, to which the revision shall be confined.*' From the words italicized it will be seen that the only duty which the judge to whom an appeal is taken in a patent case has to perform is to de-

termine the points involved by the reasons of appeal. To this law expressly confines him. The moment he enters upon the investigation or the determination of matters *de hors* these reasons of appeal, he has transcended the limits of the jurisdiction conferred, and acting thus, without power or jurisdiction, his act becomes a mere nullity. In the case of Whiteley's former appeal, the point on which the appeal was dismissed was in nowise involved by the reasons of appeal, and the dismissal is therefore, in my judgment, a mere nullity, and does not stand in the way of the present appeal." (*MS. Appeal Cases D. C.*, 1868.)

In the case of *Abraham v. Fletcher* the Commissioner says: "It seems as though the necessity would never cease to be felt of recalling the true nature and extent of the jurisdiction conferred upon the appellate judge in patent cases. Yet it is well known that he is the mere substitute for the board of examiners provided in the seventh section of the act of 1836. It seems to be thought by many that his judicial character invests him with further prerogatives. That is an entire mistake. His office serves merely as a *designatio personæ*, the means of ascertaining who shall constitute the tribunal of appeal. He derives no authority or jurisdiction from it, but has merely those which were conferred upon the former board of examiners. How limited those are has been often conceded by the judges when acting in their appellate capacity, as may be seen in repeated decisions referred to in *Law's Digest*, 138-141. (See more particularly *Arnold v. Bishop*, 138; *Richardson v. Hicks*, 140.)

"It is true that in a case somewhat resembling the one before us, *Potter v. Dixon*, (2 *Fish.*, 381,) Judge Nelson is

reported to have said, that 'the decision of the chief justice' (the appellate judge) 'was doubtless binding on the Commissioner as between those parties, but no further.' If he had said it was binding no further, at most, than as between those parties, he would have conveyed all he probably meant to say, certainly all he was called upon to decide.

"The question how far the former decision was binding, as between the parties to it, upon the Commissioner, was not discussed before him, and probably was not considered. On the other hand, the case plainly shows that the rescript of the appellate judge was held to be of no weight, except upon the precise points submitted to him. If, notwithstanding his order that a patent issue, the Commissioner may still suspend it when another party interposes a claim to the invention, it plainly follows that he has the same power when for other reasons it appears that there are valid objections to the issue.

"The truth is, the Commissioner is bound to follow the decision above upon those points only which were raised by the appeal, and upon no other. It is for the judge to say that a decision of the Commissioner shall be affirmed or reversed; not to say that a patent shall or shall not issue. It belongs to the Commissioner alone to determine that question, and in determining it many other considerations may have to be taken into the account, besides those which have been passed upon by the judge. In *Wade v. Matthews*, (5 *Opinions Attorneys General*, 220,) it was held by Reverdy Johnson, Attorney General, that so long as the Commissioner had a patent within his control, which had been ordered to issue, he was bound to keep it back if fresh objections to it came

to his knowledge, so that he was not satisfied that it ought to issue.

“That is equally true, I apprehend, although his opinion upon other points touching the invention has been reversed on appeal. He is only precluded from raising anew an objection which has been overruled.” (*Commissioners' Decisions*, 1869, p. 50.)

253. DECISIONS NOT MERELY ADVISORY, BUT TO BE FOLLOWED AS PRECEDENTS.—In the case of *Mason v. Doellbor and Houghton* the Commissioner says: “It is conceded by the counsel for the appellant, Mason, that this case presents the precise question as to abandonment which was lately decided by Mr. Justice Fisher, upon appeal from this office, in the case of *Rowley v. Mason*. I think that the decisions of the judges of the supreme court of the District of Columbia in cases which are properly before them on appeal from this office, are, in other cases to which they apply, something more than advisory, and that where, as in the present case, it is conceded that the facts are in substance the same as the case in which a decision has been rendered, it is the duty of the Commissioner to apply and enforce such decision without hesitation, whatever might be his individual opinion of the law. The decision of the board of examiners-in-chief is therefore affirmed, upon the authority of *Rowley v. Mason*.” (*Commissioners' Decisions*, 1869, p. 26.)

254. FORM OF PETITION TO THE SUPREME COURT OF THE DISTRICT OF COLUMBIA.—

To the Supreme Court of the District of Columbia.

The petition of George Thompson, of Boston, in the county of Suffolk, and State of Massachusetts, respectfully sheweth: That he has heretofore invented a new and useful improvement in velocipedes, and has applied to the Patent Office of the United States for a patent [or for the reissue of a

patent heretofore granted] for the same, and has complied with the requirements of the several acts of Congress and with the rules of the Patent Office prescribed in such cases; that his said application has been rejected by the Commissioner of Patents on appeal to him; and that he has filed in said office due notice to the Commissioner of Patents of this his appeal, accompanied with the reasons of appeal, and with certified copies of all the original papers and evidence in the case, all which will appear from the certificate of said Commissioner of Patents, hereto annexed.

And the said George Thompson prays that his said appeal may be heard and determined by your honorable court at such a time as may be appointed for that purpose; and that the Commissioner of Patents may be duly notified of the same, and directed in what manner to give notice thereof to the parties interested.

GEORGE THOMPSON.

255. FORM OF CERTIFICATE OF COMMISSIONER.—

PATENT OFFICE, WASHINGTON, D. C., *July 17, 1869.*

I hereby certify that the above-named George Thompson has complied with the requisites of the law necessary to perfect his aforesaid appeal.

SAM'L S. FISHER,
Commissioner of Patents.

256. FORM OF NOTICE AND REASONS OF APPEAL.—

To the Commissioner of Patents:

George Thompson, of Boston, in the county of Suffolk, and State of Massachusetts, hereby gives notice that he has appealed from your decision rejecting his application for a patent [*or for a reissue of a patent granted to him July 7, 1865*] for improvement in velocipedes, and of this you are respectfully requested to take notice.

Accompanying this notice are certified copies of all the original papers and evidence in the case, and a petition addressed to the supreme court of the District of Columbia.

And the said George Thompson assigns the following reasons for appealing from the said decision of the Commissioner of Patents, viz:

The Commissioner erred in deciding that the said improvement was not patentable.

The Commissioner erred in deciding that the said invention was not new.

GEORGE THOMPSON.

XV. Mandamus to the Commissioner.

<p>SEC. 257. Mandamus a remedy against public officers.</p> <p>258. To compel the performance of ministerial duties.</p> <p>259. Distinction between ministerial acts and the ordinary discharge of official duties.</p> <p>260. Principles applicable to heads of departments applied to</p>	<p>SEC. the Commissioner of Patents.</p> <p>261. Jurisdiction of the supreme court of the District of Columbia.</p> <p>262. Mandamus to Commissioner of Patents.</p> <p>263. Parties in mandamus.</p> <p>264. Proceedings in mandamus.</p>
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257. MANDAMUS A REMEDY AGAINST PUBLIC OFFICERS.—In order to maintain a system of government which will be able to secure to the citizen his rights, it is necessary to have persons appointed or chosen to administer the law. And when persons are thus clothed with the power, and have assumed the duties of a public officer, they have taken upon themselves the obligation to perform those duties; and if they neglect or refuse to do so, any person whose rights are thereby injuriously affected is entitled to demand relief. The remedy provided by our system of law, as well as that of England, is a process issuing from the judicial branch of the government, which seeks to compel the officer to go forward and do that which is enjoined upon him by the position he holds. (*Moses on Mandamus*, 14.)

And generally, in all cases of omission or mistake, where there is no other adequate specific remedy, resort may be had to this high judicial writ. It not only lies to ministerial, but to judicial officers. In the former case

it contains a mandate to do a specific act; but in the latter only to adjudicate, to exercise a judgment, or discretion, upon a particular subject. (*Ib.*)

It may be stated as a general principle, that this writ is only granted for public persons, and to compel the performance of public duties. (3 *Stephens's Nisi Prius*, 2291.) It can be resorted to only in those cases where the matter in dispute, in theory, concerns the public, and in which the public has an interest. The degree of its importance to the public is not, however, scrupulously weighed. (1 *Swift's Digest*, 564.) A mandamus gives no right, not even a right of possession, but simply puts a man in a position which will enable him to assert his right, which in some cases he could not do without it. And "in order to lay the foundation for issuing a writ of mandamus, there must have been a refusal to do that which it is the object of the mandamus to enforce, either in direct terms, or by circumstances distinctly showing an intention in the party not to do the act required." (3 *Stephens's Nisi Prius*, 2292; *Redfield on Railways*, 441, note 5; *Moses on Mandamus*, 18.)

258. TO COMPEL THE PERFORMANCE OF MINISTERIAL DUTIES.—Where the heads of departments are the political or confidential agents of the executive, merely to execute the will of the President in cases where the executive possesses a constitutional or legal discretion, nothing can be more perfectly clear than that their acts are only politically examinable. But where a specific ministerial duty is assigned by law, and individual rights depend upon the performance of that duty, it seems equally clear that the individual who considers himself injured has a right to resort to the laws of his country

for remedy, and that mandamus is a proper remedy. (*Moses on Mandamus*, 63.)

It was held, in the case of *Marbury v. Madison*, that "It is not by the office of the person to whom the writ is directed, but the nature of the thing to be done, that the propriety or impropriety of issuing a mandamus is to be determined. Where the head of a department acts in a case in which executive discretion is to be exercised, in which he is the mere organ of executive will, it is again repeated that any application to a court to control, in any respect, his conduct, would be rejected without hesitation. But where he is directed by law to do a certain act, affecting the absolute rights of individuals, in the performance of which he is not placed under the particular direction of the President, and the performance of which the President cannot lawfully forbid, and therefore is never presumed to have forbidden, as, for example, to record a commission, or a patent for land, which has received all the legal solemnities; or to give a copy of such record; in such cases, it is not perceived on what ground the courts of the country are further excused from the duty of giving judgment, that right be done to an injured individual, than if the same services were to be performed by a person not the head of a department." (1 *Cranch*, 137.)

The doctrine that mandamus lies on the application of a private individual, and for his benefit, to compel the head of a department to perform a mere ministerial duty, where that duty is plain, seems to have been fully maintained in the case of *The Commissioners of the Land Office v. Smith*, 5 *Texas*, 471.

259. DISTINCTION BETWEEN MINISTERIAL ACTS AND THE

ORDINARY DISCHARGE OF OFFICIAL DUTIES.—A distinction is made between the ministerial acts of one of the heads of department, and those duties required in the ordinary discharge of official duties, over which the officer is required to exercise judgment and discretion. While the former can be compelled by mandamus, the latter cannot. (*Moses on Mandamus*, 65.)

In the case of *Decatur v. Paulding*, the Supreme Court of the United States, in reversing the decision of the circuit court of the District of Columbia, say: "In the case of *Kendall v. The United States*, 12 *Peters*, 524, it was decided in this court that the circuit court for Washington county, in the District of Columbia, has the power to issue a mandamus to an officer of the federal Government, commanding him to do a ministerial act." * * * "The head of an executive department of the government, in the administration of the various and important concerns of his office, is continually required to exercise judgment and discretion. He must exercise his judgment in expounding the laws and resolutions of Congress under which he is from time to time required to act. If he doubts, he has a right to call upon the Attorney General to assist him with his counsel; and it would be difficult to imagine why a legal adviser was provided by law for the heads of departments, as well as for the President, unless their duties were regarded as executive, in which judgment and discretion were to be exercised. If a suit should come before the court which involved the construction of any of these laws, the court certainly would not be bound to adopt the construction given by the head of a department. And if they supposed his decision to be wrong, they would, of course, so pronounce their judgment. But their judg-

ment upon the construction of a law must be given in a case in which they have jurisdiction and in which it is their duty to interpret the act of Congress, in order to ascertain the rights of the parties in the cause before them. The court could not entertain an appeal from the decision of one of the Secretaries nor revise his judgment in any case where the law authorized him to exercise discretion or judgment. Nor can it by mandamus act directly upon the officer, and guide and control his judgment or discretion in the matters committed to his care in the ordinary discharge of his official duties."

* * * "The interference of the courts with the performance of the ordinary duties of the executive departments of the government would be productive of nothing but mischief; and we are quite satisfied that such a power was never intended to be given to them." (14 *Peters*, 497.)

In the case of *The United States v. Guthrie*, Mr. Justice Daniel, in delivering the opinion of the court, said: "It has been ruled, that the only acts to which the power of the courts, by mandamus, extends, are such as are purely ministerial, and with regard to which nothing like judgment or discretion, in the performance of his duties, is left to the officer; but that, wherever the right of judgment or decision exists in him, it is he, and not the courts, who can regulate its exercise.

"These are the doctrines expressly ruled by this court in the case of *Kendall v. Stockton*, 12 *Peters*, 524; in that of *Decatur v. Paulding*, 14 *Peters*, 497; and in the more recent case of *Brashear v. Mason*, 6 *How.*, 92; principles regarded as fundamental and essential, and apart from which the administration of the government would be impracticable." (17 *How.*, 284.)

Mr. Justice Clifford, delivering the opinion of the court in the case of *The Secretary v. McGarrahan*, said: "Since the decision of this court in the case of *McIntire v. Wood*, (7 *Cranch*, 504,) it has been regarded as the settled law of the court that the circuit courts of the United States in the several States do not possess the power to issue writs of mandamus except in cases in which it may be necessary to the exercise of their jurisdiction. (*Riggs v. Johnson Co.*, 6 *Wallace*, 198.)

"Authority to that effect might doubtless be given to those courts by an act of Congress; but the insuperable difficulty at present is, that neither the judiciary act nor any other act of Congress has conferred upon them any such power.

"Antecedent to the decision of this court in the case of *Kendall v. The United States*, grave doubts were entertained whether any court established by an act of Congress possessed any such jurisdiction; but the majority of this court came to the conclusion that the circuit court of this District might issue the writ of mandamus to an executive officer residing here, commanding him to perform a ministerial act required of him by law, and it is not denied that the court below possesses all the power in that behalf which the circuit court of the District possessed at that time." * * * "Though mandamus may sometimes lie against an executive officer to compel him to perform a mere ministerial act required of him by law, yet such an officer, to whom public duties are confided by law, is not subject to the control of the courts in the exercise of the judgment and discretion which the law reposes in him as a part of his official functions." (9 *Wallace*, 298.)

The rule to be gathered from all the cases decided in the Supreme Court of the United States, governing mandamus, to the officers of the government, seems to be this: It cannot issue in a case where discretion and judgment are to be exercised by the officer, nor to control him in the manner of conducting the general duties of his office. It can be granted only where the act required to be done is imposed by law—is merely ministerial—and the relator without any other adequate remedy. (*Moses on Mandamus*, 78.)

260. PRINCIPLES APPLICABLE TO HEADS OF DEPARTMENTS APPLIED TO THE COMMISSIONER OF PATENTS.—The principles applied by the Supreme Court of the United States, in cases of mandamus, to heads of departments of State, would seem to be applicable in cases of mandamus to the Commissioner of Patents. (See *Commissioner of Patents v. Whiteley*, 4 *Wallace*, 522.)

261. SOURCE OF POWER TO ISSUE THE WRIT IN THE SUPREME COURT OF THE DISTRICT OF COLUMBIA.—A writ of mandamus, at common law, was a command issuing in the King's name, from the court of King's Bench, and directed to any person, corporation, or inferior court of judicature within the King's dominions, requiring them to do some particular thing therein specified, which appertains to their office and duty, and which the court of King's Bench has previously determined, or at least supposes to be consonant to right and justice. (2 *Black. Com.*, 110.) But "in America the authority to issue the writ of mandamus does not exist as a prerogative power of the courts, but is derived by grant from the Government, through the Constitution or legislative enactments. And when the power has been granted in

general terms to a court, it is to be governed by the common law rules as to when it is proper to be issued. (*Kentucky v. Dennison*, 24 *How.*, 66; *In the matter of James Turner*, 5 *O. R.*, 543;" *Moses on Mandamus*, 17.)

The power to issue the writ of mandamus was, under the provincial government of Maryland, intrusted to the provincial court; which occupied under the government the place which belongs to the King's Bench in England. The Maryland constitution of 1777 transferred the right of issuing the mandamus, with the other powers of the provincial court, to the general court. (*Evans's Practice*, 18, 403.)

It has been held by the Supreme Court of the United States, in the case of *Kendall v. The United States*, 12 *Peters*, 526, that as the act of Congress of the 27th of February, 1801, concerning the District of Columbia, and by which the circuit court of the District is organized and its powers and jurisdiction pointed out, declared that the laws of the State of Maryland, as they now exist, shall be and continue in force in that part of the District which was ceded by that State to the United States, and as at the date of that act the common law of England was in force in Maryland, and that the power to issue a mandamus in a proper case is a branch of the common law fully recognized as in practical operation in that State at the time the circuit court for the District of Columbia was organized, it was thereby vested with broader powers and jurisdiction in this respect than is vested in the circuit courts of the United States in the several States, and that it does possess the power to issue the writ of mandamus, directed to United States ministerial officers, when it is a fit and proper remedy.

And in the case of *Decatur v. Paulding*, (14 *Dallas*, 515,) Taney, C. J., in delivering the opinion of the court, said: "In the case of *Kendall v. The United States* it was decided in the court that the circuit court for Washington county, in the District of Columbia, has the power to issue a mandamus to an officer of the federal government, commanding him to do a ministerial act."

The act of Congress of the 3d of March, 1863, which established the supreme court of the District of Columbia, provided that "the supreme court organized by this act shall possess the same powers and exercise the same jurisdiction as is now possessed and exercised by the circuit court of the District of Columbia," &c.

262. MANDAMUS COMMANDING THE COMMISSIONER TO PERFORM AN ACT ENJOINED BY LAW.—It follows, therefore, that the supreme court of the District of Columbia has the jurisdiction and power, in proper cases, to grant and enforce a "writ of mandamus," commanding the Commissioner of Patents to perform an act enjoined by law.

In the case of the *Commissioner of Patents v. Whiteley*, (4 *Wallace*, 522,) the case is stated as follows: "Whiteley, the defendant in error, was the assignee of a sectional interest in a patent granted to Haines, on the 4th of September, 1855, for an improvement in mowing machines. He held, by virtue of several assignments, all the territory embraced in the patent, except the State of Ohio and the northern half of the State of Illinois; and in all the territory, except as just mentioned, was assignee of all the rights of the patentee.

"In 1863 he applied to the Commissioner of Patents for a reissue of the patent, according to the thirteenth section of the patent act of 1836.

“The assignees for the State of Ohio and of the northern half of Illinois did not join in the application.

“The Commissioner of Patents, after a laborious investigation of the law and comparison of various sections of the patent acts, decided that the applicant, not being the assignee of the whole interest in the patent, was not entitled to the reissue asked for.

“Whiteley took no appeal from the Commissioner's decision; but setting forth that his application for reissue was filed with the Acting Commissioner, and the refusal, petitioned the supreme court of the District of Columbia for a mandamus to send an application *to an examiner to be acted upon by him as though made by the patentee.*

“The Commissioner, in reply—premising that for the reason that the proposed applicant was not such an assignee as the law contemplates, and that the application, therefore, was not filed or entered upon the books of the office, and never had been, and that the fees required on such application, which had been paid by the relator to the chief clerk of the office, on the presentation of said application, had not been placed to the credit of the patent fund, but remain in the hands of the chief clerk, personally, and subject to the order of the relator—replied, among other reasons, against the mandamus:

“1. That the object of it was to carry by appeal a preliminary question solely cognizable by him to the supreme court of the District, and that such a mandamus would be nugatory.

“2. That he had decided rightly in rejecting the application, the relator not coming within the meaning of the term ‘assignee,’ as contemplated in the thirteenth section of the act of 1836. And in support of this view he sub-

mitted as part of his answer a full law argument, which now came up in the record.

“The supreme court of the District granted the mandamus, ‘commanding the Commissioner of Patents to refer said application to the proper examiner, or otherwise examine or cause the same to be examined according to law.’ The case was now here on writ of error, brought by the Commissioner of Patents, to remove the proceeding to this court. Two principal questions were raised:

“1. Supposing the decision of the Commissioner to have been erroneous, and that the assignee of a sectional interest in a patent was entitled to a reissue, did a mandamus such as that above mentioned lie to correct the decision?

“2. Did the Commissioner, in deciding as he did that the applicant as owner of but a sectional interest was not entitled to a reissue, decide correctly?”

Mr. Justice Swayne, delivering the opinion of the court, said:

“This case was brought here by a writ of error to the supreme court of the District of Columbia.

“On the 4th of September, 1855, a patent was issued to Jonathan Haines for an improvement in mowing machines.

“On the 22d of November, 1856, Haines sold and assigned to Ball, Aultman & Co. an exclusive right to the invention and patent, within the limits of the State of Ohio.

“On the 13th of April, 1858, upon the surrender of the original patent by Haines, and upon his application, without the assent of Ball, Aultman & Co., a reissue of the patent was granted to him.

“On the 15th of January, 1860, Jonathan Haines sold and assigned to his brother, Ansel Haines, one undivided third part of his interest in the patent.

“On the 25th of January, 1860, Jonathan and Ansel Haines sold and granted to Isaac and William C. Hawley the exclusive right to the invention and patent in certain counties in the State of Illinois.

“On the 10th of April, 1863, Ansel Haines resigned to Jonathan Haines all his interest in the patent.

“On the 17th of April, 1863, Jonathan Haines sold and assigned all his interest in the patent to Andrew Whiteley, the defendant in error. Haines, at the same time, delivered the patent to Whiteley, in order that he might surrender it and procure another reissue.

“Ball, Aultman & Co. were applied to, but declined to concur. It does not appear that the Hawleys were advised upon the subject.

“On the 25th of January, 1863, Whiteley filed his application in the Patent Office, in conformity with the provisions of the thirteenth section of the act of 1836.

“The Commissioner of Patents declined to entertain the application, upon the ground that the applicant was only the grantee of an exclusive sectional interest, and not of the entire patent. He also declined to allow an appeal to be taken from this decision. An application was thereupon made to the supreme court of the District of Columbia for a writ of mandamus. That court awarded a peremptory writ, commanding the Commissioner ‘to refer said application to the proper examiner, or otherwise examine or cause the same to be examined according to law.’ This writ of error is prosecuted to reverse that order. Did the court err in making it?

“The thirteenth section of the act of 1836 declares that, under the circumstances therein stated, ‘it shall be lawful for the Commissioner, upon the surrender to him of such patent, * * * to cause a new patent to be issued to the inventor, for the same invention, for the residue of the period, then unexpired, for which the original patent was granted, in accordance with the patentee’s corrected description and specifications; and, in case of his death or any assignment by him made of the original patent, a similar right shall vest in his executors, administrators, or assigns.’

“The seventh section of this act provides that, on the filing of any application for a patent and the payment of the duty required, ‘the Commissioner shall make, or cause to be made, an examination of the alleged new invention or discovery,’ &c.

“The eighth section of the act of 1837 provides, in regard to applications for the reissue of patents and the decisions of the Commissioner, that ‘in all such cases the applicant, if dissatisfied with such decision, shall have the same remedies and be entitled to the benefit of the same privileges and proceedings as are provided by law in case of original applications for patents.

“This renders it necessary to recur to the act of 1836, and to consider carefully its provisions touching the applications to which it relates.

“Both acts should be liberally construed to meet the wise and beneficent object of the legislature. Patentees are a meritorious class, and all the aid and protection which the law allows this court will cheerfully give them.

“If the Commissioner should hold that a party applying originally for a patent ‘was not the original and first

inventor,' and should decide against him upon that ground, the applicant could undoubtedly take an appeal from his decision. The Commissioner having reached this conclusion, would be under no obligation to go further and examine any other question arising in the case, and it would not be necessary to the right of appeal that he should do so.

“Here an assignee applied for *the reissue* of a patent. It was clearly competent for the Commissioner, and it was his duty, to decide whether the applicant was an assignee at all; and, if so, whether he was assignee with such an interest as entitled him to a reissue within the meaning of the statutory provision upon the subject. The latter question is an important one. It is as yet unsettled, and awaits an authoritative determination.

“The Commissioner says, in his answer to the rule, that he could not examine the application, because none had been filed in the Patent Office.

“This position is untenable. It is averred in the petition, and not denied in the answer—and, therefore, as in other like cases of pleading, to be taken as conceded—that the application was filed with the Acting Commissioner. It is also admitted in the answer that the requisite amount of fees had been paid by the relator, but, it is added, that it had not been placed to the credit of the office, and was in the hands of the chief clerk, subject to the relator's order.

“The relator had done all in his power to make his application effectual, and had a right to consider it properly before the Commissioner.

“It was so. *If it was not, a mandamus would clearly lie to compel the Commissioner to receive it.* It was his first duty

to receive the application, whatever he might do subsequently. Without this initial step there could be no examination, and, indeed, no rightful knowledge of the subject on his part. Examination and the exercise of judgment, with proper fruit, were to follow, and they did follow.

“The Commissioner found the question, whether the assignee was such a one as the law entitled to a reissue, lying at the threshold of his duties. It required an answer before he could proceed further. His decision was against the appellant. His examination of the subject was thorough, and his conclusion is supported by an able and elaborate argument. It was made a part of his reply to the rule, and is found in the record.

“From this decision, whether right or wrong, the relator had a right, under the statute, to appeal.

“*If the mandamus had ordered the Commissioner to allow the appeal, we should have held the order under which it was issued to be correct.* But the order was that he should proceed to examine the application. That he had already done. The preliminary question which he decided was as much within the scope of his authority as any other which could arise. Having resolved it in the negative, there was no necessity for him to look further into the case. Entertaining such views, it would have been idle to do so. *The question* was vital to the application, and its resolution was fatal, so far as he was concerned. Only a reversal by the tribunal of appeal could revive it and cast upon him the duty of further examination.

“The principles of law relating to the remedy by mandamus are well settled.

“It lies where there is a refusal to perform a minis-

terial act involving no exercise of judgment or discretion.

“It lies, also, where the exercise of judgment and discretion are involved and the officer refuses to decide, provided that, if he decided, the aggrieved party could have his decision reviewed by another tribunal.

“It is applicable only in these two classes of cases. It cannot be made to perform the functions of a writ of error.

“In *Decatur v. Paulding*, (14 *Pet.*, 515,) referring to an act of Congress under which the relator in that case claimed a pension which had been refused her by the Secretary of the Navy, this court said: ‘If a suit should come before this court which involved the construction of any of these laws, the court certainly would not be bound to adopt the construction given by any head of a department; and if they supposed his decision to be wrong, they would of course so pronounce their judgment. But their construction of a law must be given in a case in which they have jurisdiction, and in which it is their duty to interpret the act of Congress in order to ascertain the rights of the parties in the cause before them. The court could not entertain an appeal from the decision of one of the Secretaries, nor reverse his judgment in any case where the law authorizes him to exercise discretion or judgment; nor can it by mandamus act directly upon the officer, and guide or control his judgment or discretion in the matters committed to his care in the ordinary discharge of his official duties. * * * The interference of courts with the performance of the ordinary duties of the executive department of the government would be productive of nothing but mischief, and we are quite satisfied that such a power was never intended to be given to them.

‘This case, as presented to the court below, was within neither of the categories above mentioned. The court, therefore, erred in making the order to which the Commissioner objected.

“The main question passed upon by the Commissioner, and which was supposed to underlie this case, is not before us for consideration. If it were, as at present advised, we are not prepared to say that the decision of the Commissioner was not correct.

“The order of the court below, awarding the mandamus, is reversed with costs, and it is ordered by this court that the application of the relator be by that court overruled and dismissed.”

263. PARTIES IN MANDAMUS.—The writ of mandamus, from its very nature and definition, is “a command issuing in the name of the sovereign authority.” (*Bouvier’s Dict.*) And although it is substantially a civil remedy, (*2 Carter’s Ind. R.*, 423,) yet in the United States it has always been issued in the name of the sovereignty by which it has been authorized. (*Moses on Mandamus*, 194.)

The suit, therefore, is properly prosecuted in the name of the United States against the Commissioner of Patents.

264. PROCEEDINGS IN MANDAMUS.—The writ can only be obtained after a rule to show cause has been laid by the court and a copy of it has been served on the Commissioner of Patents. (*Brosius v. Reuter*, 1 *Harr. and Johns.*, 481.) The rule is obtained by filing a petition, in which all the facts and circumstances entitling the party to the mandamus are stated, and which is verified by oath. (*Evans’s Practice*, 404.) The petition should present to the court a *prima facie* case of duty on the part of the Commissioner to perform the act demanded,

and an obligation to perform it. (*Moses on Mandamus*, 234.) It should also appear that a demand has been made upon the Commissioner to do the thing he is sought to be compelled to do, and that he has refused or neglected to do it, (*Stephens's Nisi Prius*, 23; 9 *Mich. R.*, 328,) and that he has it in his power to perform the act. (*Ridding v. Bell*, 4 *Cal. R.*, 333.)

The Commissioner who appears to show cause why a mandamus should not be issued does so by what is sometimes called a return, sometimes an answer. (*Evans's Practice*, 404.) The return must either deny the facts on which the claim of the relator is founded or must state other facts sufficient in law to defeat the relator's claim. (10 *Wend.*, 20; 35 *Barb.*, 105; 37 *Penn. S. R.*, 237.)

When the return is made and filed, if insufficient, the relator may move to quash it, (*Evans's Practice*, 405; *People v. State*, 2 *Barb.*, 554; *Commonwealth v. Commissioners*, 32 *Penn. S. R.*, 218;) it may, however, be amended, or a supplementary return filed, should it prove defective, (*Evans's Practice*, 405,) and a return on leave of court may be amended in matters of substance even after exceptions have been made (*Doug. R.*, 135; 10 *Pick. R.*, 59.) The motion, however, for leave to amend should probably set forth specifically the points sought to be corrected. (*State v. County Judge*, 12 *Iowa*, 237.)

Motions or applications for mandamus against the Commissioner of Patents may be heard before the general term of the supreme court of the District of Columbia in the first instance, or by one of the justices at chambers, or in special term, but not until the petition, verified by affidavit and stating the grounds of the application, has been filed and docketed, and motion to quash

may be heard in the same manner. (*Rules of Supreme Court of D. C.*)

Upon argument of the law, arising upon the facts disclosed, the court decide that a mandamus shall or shall not go. (*Evans's Practice*, 404.)

The writ is served by delivering it to the person to whom it is directed. Courts enforce compliance with the peremptory writ by attachment of contempt. The application for an attachment is made by a motion, upon which the defendant may show cause, unless the contempt be gross, in which case the rule may be made absolute at first. (*Tidd's Practice*, 484.)

XVI. Designs.

SEC.	SEC.
265. Subject-matter of design patents.	monopolized under a patent for design.
266. Models may be dispensed with.	276. Applicant to elect the term of the patent on application.
267. Term for which granted.	277. No provision made for use and sale prior to application.
268. Term may be extended.	278. Design shown in a patent for mechanical invention lost.
269. Proceedings the same as in other cases.	279. Number of claims allowed.
270. Photographs.	280. Application for mechanical invention cannot be changed to application for design.
271. Classification of designs.	281. Form of petition.
272. Disputed questions.	282. Form of specification.
273. Design may embrace a class of ornaments.	283. Form of oath.
274. Designs patentable on account of utility.	
275. Modes of operation not to be	

265. SUBJECT-MATTER OF DESIGN PATENTS.—Any person who, by his own industry, genius, efforts, and expense, has invented or produced any new and original design for a manufacture, bust, statue, alto-relievo, or bas-relief;

any new and original design for the printing of woollen, silk, cotton, or other fabrics; any new and original impression, ornament, pattern, print, or picture, to be printed, painted, cast, or otherwise placed on or worked into any article of manufacture; or any new, useful, and original shape or configuration of any article of manufacture, the same not having been known or used by others before his invention or production thereof, or patented or described in any printed publication, may, upon payment of the duty required by law and other due proceedings had, the same as in cases of inventions or discoveries, obtain a patent therefor. (*Act of July 8, 1870, § 71; vide supra, p. 34, § 71.*)

266. MODELS MAY BE DISPENSED WITH.—The Commissioner may dispense with models of designs when the design can be sufficiently represented by drawings or photographs. (*Ib., § 72.*)

267. TERM FOR WHICH GRANTED.—Patents for designs may be granted for the term of three years and six months, or for seven years, or for fourteen years, as the applicant may, in his application, elect. (*Ib., § 73.*)

268. PATENTS FOR DESIGNS MAY BE EXTENDED.—Patentees of designs issued prior to March 2, 1861, shall be entitled to extension of their respective patents for the term of seven years, in the same manner and under the same restrictions as are provided for the extension of patents for inventions or discoveries issued prior to the 2d day of March, 1861. (*Ib., § 74.*) Upon extending a patent for a design its utility may be taken into account in estimating its value and importance to the public. (*B. L. Solomon ex parte, Commissioners' Decisions, 1869, p. 49.*)

269. PROCEEDINGS THE SAME AS IN OTHER CASES.—The petition, oath, specification, and other proceedings, are the same as for other patents. (*Patent Office Rules, July, 1870.*)

270. PHOTOGRAPHS.—Photographs are received for the illustration of works of design only. One must be pasted upon thick drawing-paper, but in every case where this mode of illustration is employed by an applicant he will be required to deposit in the office the glass or other “negative” from which the photograph is printed, so that exact official copies may be made therefrom when desirable. (*Ib.*)

271. CLASSIFICATION OF DESIGNS.—In the case of *Bartholomew ex parte* the Commissioner says: “Letters patent for designs have increased in importance within the last few years. Formerly, but few were granted; now, many are issued. To this day they have made so little figure in litigation that but three reported cases are known in which design patents have come into controversy. With their increase questions have arisen concerning their scope and character which have given rise to dispute and to inquiry as to the correctness of the current practice of the office in this branch of invention. While on the one hand it is insisted that the practice has always been uniform, and is therefore now fixed and definite, on the other it is asserted that there has never been, and is not now, any well defined or uniform practice either in the granting or refusal of design patents.

“The act of 1836 made no provision for the patenting of designs. The earliest legislation upon this subject is found in the act of August 29, 1842, section 3; and the

only legislation upon this subject is found in this section and in section 11 of the act of March 2, 1861.

“The definition of the subject-matter, or, in other words, of a ‘design,’ is the same in both acts. It is as follows: ‘That any citizen, &c., who by his, her, or their own industry, genius, efforts, and expense, may have invented or produced any new and original design for a manufacture, whether of metal or other material or materials, and original designs for a bust, statue, bas-relief, or composition in alto or basso-relievo, or any new and original impression being formed in marble or other material, or any new and useful pattern, print, or picture, to be either worked into or worked on, or printed, or painted, or cast, or otherwise fixed on any article of manufacture, or any new and original shape or configuration of any article of manufacture not known or used by others,’ &c.

“This definition embraces five particulars :

“1. A new and original design for a manufacture.

“2. An original design for a bust, statue, &c.

“3. A new and original impression or ornament to be placed on any article of manufacture.

“4. A new and useful pattern, print, or picture, to be worked into or worked on, or printed, or painted, or cast, or otherwise fixed on any article of manufacture.

“5. A new and original shape or configuration of any article of manufacture.

“The first three of these classes would seem to refer to ornament only; the fourth, to ornament combined with utility, as in the case of trade-marks; and the fifth, to the shapes or forms of manufactured articles, which, for some reason, were preferable to those previously adopted.”

272. DISPUTED QUESTIONS.—“The disputed questions which have thus far arisen under these definitions are: 1. What variations may be claimed or covered by the patent, consistent with unity of design? 2. Is a new shape of an article of manufacture, whereby utility is secured, a subject of protection under this act? and 3. Is mechanical function of any kind covered by it?

“As to the first of these questions, it seems to have been assumed that the design spoken of in all parts of the sections referred to covered a fixed, unchangeable figure; that the protection of the letters patent did not extend to any variation, however slight, but that such variation constituted a new design, might be covered by a new patent, and might safely be used without infringement of the first. This, it is said, is the correct theory of the law, and has been the uniform adjudication of the office.”

273. A PATENT FOR A DESIGN MAY EMBRACE A GENUS OR CLASS OF ORNAMENTS, AS WELL AS ONE SPECIES.—“Neither of these statements is absolutely correct. The law by no means defines a design with such strictness. The language is, ‘new and original design for a manufacture,’ ‘new and original impression or ornament,’ ‘new and original shape or configuration.’ It would seem to be too plain for argument that the new design, or impression, or shape might be so generic in its character as to admit of many variations, which should embody its substantial characteristics and be entirely consistent with a substantial identity of form. Thus, if the invention were of a design for an ornamental button, the face of which was grooved with radial rays, it would seem that the first designer of such a button might properly

describe a button of five rays, and, having stated that a greater number of rays might be used, might claim a design consisting generally of radial rays, or of 'five or more' rays, and that it could not be necessary for him to take out a patent for each additional ray that could be cut upon his button. So, if the design were the ornamentation of long combs by a chain of pearls, it would seem that a claim for such a design might be maintained against one who arranged the pearls either in curved or straight lines, or who used half pearls only; and that such modifications, if they had occurred to the designer, might properly have been enumerated in his specification as possible and equivalent variations. In short, I can see no reason, under the law, why designs may not be generic, why what are called 'broad claims' may not be made to them, and why the doctrine of artistic or æsthetic equivalents may not be applied to them.

"This has been recognized to a greater or less extent in the adjudication of the courts and in the practice of the office. One of the reported cases is that of *Booth v. Garelly*, (1 *Blatchf.*, 247.) The design is described as consisting of 'radially formed ornaments on the face of the molds or blocks of which the button is formed, combined with the mode of winding the covering on the same, substantially as set forth, whether the covering be of one or more colors.' The specification, in 'substantially' setting forth the design, contained this language: 'It will be obvious from the foregoing that the figures can be changed at pleasure, by giving the desired form to the face of the mold by depressions and elevations which radiate from a point, whether in the center of the mold or eccentric thereto.' In the consideration of the case

by the court no objection was made to this statement or claim. In the case of *Root v. Ball*, (4 *McLean*, 180,) the learned judge instructed the jury that 'if they should find that the defendant had infringed the plaintiff's patent by using substantially the same device, as ornamental, on the same part of the stove, they would, of course, find the defendant guilty. To infringe a patent right, it is not necessary that the thing patented should be adopted in every particular; but if, as in the present case, the design and figures were *substantially* adopted by the defendants, they have infringed the plaintiff's right. If they adopt the same principle, the defendants are guilty.

“The principle of a machine is that combination of mechanical powers which produces a certain result. And, in a case like the present, where ornaments are used for a stove, it is an infringement to adopt the design so as to produce substantially the same appearance.’

“It has been the constant practice to grant patents for designs for fonts of type, for sets of silver plate, for a series of printers' flourishes, and the like. This class of cases has always passed without objection. Two other cases which have arisen within the office deserve notice. The first was for a series of miniature shoulder-straps, with emblems denoting rank, provided with a pin, to be worn under an officer's coat, upon his vest, or as a lady's breastpin. The drawing shows eight of these pins, with emblems of rank, varying from that of second lieutenant to major general, and the specification, describing the brooch for a second lieutenant, goes on to say: 'I propose to introduce on some of them the different ornaments showing the respective ranks of the army

from a major generalship to a second lieutenancy. (See figures 2, 3, 4, 5, 6, 7, 8.)

“The second case was that of an application for a monogram visiting-card, on which the name was to be inscribed or printed in the form of a monogram. The applicant filed a drawing, showing a card upon which was a monogram of his own name. In his specification he gives certain rules for forming such monograms, and then says: ‘It is manifest that the form of the letters, as well as the letters themselves, can be changed as required by circumstances or the taste of the individual for whom the monogram is designed, and that the general form and outline of the monogram may be varied, and indeed must vary, to be adapted to the particular name it is required to represent.’ The claim was for ‘a monogram visiting-card, or visiting-card upon which the name is inscribed or printed in the form of a monogram, substantially as herein specified.’ This application was rejected by the examiner and board of examiners-in-chief, but was allowed by the Commissioner upon appeal.

“It is true that before and since this patent was issued many patents have been refused for what I have called generic designs. One man, having designed a tack-head ornamented with radial lines, was compelled to take out one patent for his tack with six radial lines, and another for the same tack with eight. There are other instances of like character, but they only serve to show that the practice of the office has not been uniform, and that the true practice is still to be adopted and followed.

“I have no hesitation in saying, in view of the premises, that a valid patent may be granted for a new genus

or class of ornaments, as well as for specific ornaments, though I do not doubt that, under the statute, every species, variety, and individual, having distinct characteristics, under such a genus, might also be patented, the patent being subordinate and tributary to that which covered the class.

“From the nature of this subject-matter there must always be more latitude in the issue of patents for trifling changes of form or outline, since it is only necessary that such changes should constitute a new design to entitle them to a patent of this class.”

274. NEW SHAPES AND CONFIGURATIONS MAY BE PATENTED AS DESIGNS ON ACCOUNT OF THEIR UTILITY, WHEN THAT IS OWING TO THEIR FORM.—“The second question relates to the element of utility in patents for designs.

“Articles have been and are being constantly patented as designs which possess no element of the artistic or ornamental, but are valuable solely because, by a new shape or configuration, they possess more utility than the prior forms of like articles.

“Of this character are designs for ax-heads, for reflectors, for lamp-shades, for the soles of boots and shoes, which have been heretofore patented as designs; and to this class might be added with great propriety that class of so-called ‘mechanical’ patents granted for mere changes of form, such as plowshares, fan-blowers, propeller blades, and others of like character.

“When, therefore, my learned predecessor, in Crane’s case, added to this number a box so designed as to hold with convenience a set of furs, he did but confirm, and not alter, the practice of the office, so far as it can be gleaned from the patented cases.

“I am of opinion that the class of cases named in the act as arising from ‘new shape or configuration’ includes within it all those new changes of form which involve increase of utility. This I take to be the spirit of the decision in *Wooster v. Crane*, (2 *Fish.*, 583.) The design was of a reel in the shape of a rhombus. The learned judge says: ‘In this case the reel itself, as an article of manufacture, is conceded to be old, and not the subject of a patent. The shape applied to it by the complainant is also an old, well-known mathematical figure. Now, although it does not appear that any person ever before applied this particular shape to this particular article, I cannot think that the act quoted above was intended to secure to the complainant an exclusive right to use this well-known figure in the manufacture of reels. The act, although it does not require utility in order to secure the benefit of its provisions, does require that the shape produced shall be the result of industry, effort, genius, or expense, and must also, I think, be held to require that the shape or configuration sought to be secured shall at least be new and original as applied to articles of manufacture. But here the shape is a common one in many articles of manufacture, and its application to a reel cannot fairly be said to be the result of industry, genius, effort, and expense. No advantage whatever is pretended to be derived from the adoption of the form selected by the complainant, except the incidental one of using it as a trade-mark. Its selection can hardly be said to be the result of effort even; it was simply an arbitrary, chance selection of one of many well-known shapes, all equally well adapted to the purpose. To hold that such an application of a common

form can be secured by letters patent would be giving the act of 1861 a construction broader than I am willing to give it.'

"It would seem from this language that if there had been 'advantage,' *i. e.*, utility, in the adoption of the form of the rhombus, it would have found more favor in the eyes of the court."

275. NEW MODES OF OPERATION OR CONSTRUCTION CANNOT BE MONOPOLIZED UNDER A PATENT FOR A DESIGN.—"The third question may be readily disposed of. Modes of operation or construction, principles of action, combinations to secure novelty or utility of movement, or compositions of matter, can hardly be said to be 'shapes, configurations, or designs;' but where the sole utility of the new device arises from its new shape or configuration I think it may fairly be included among the subjects which the act of 1842 was designed to protect."

276. APPLICANT TO ELECT THE TERM OF THE PATENT ON APPLICATION.—In the case of *Mayo ex parte*, (*motion*,) the Commissioner says: "The applicant makes application for a patent for a design. He pays ten dollars into the treasury, and adds to his petition the following proviso: 'Should the Commissioner be willing to allow a patent on this application, the undersigned wishes to pay into the treasury the further sum of twenty dollars, and have such patent granted for fourteen years, instead of three and a half years.'

"Section 11 of the act of March 2, 1861, provides that upon application for a patent for a design, 'the Commissioner, on due proceedings had, may grant a patent therefor, as in the case now of application for a patent, for the term of three and one half years, or for the term of seven

years, or for the term of fourteen years, as the said applicant *may elect in his application*: provided that the fee to be paid *in such application* shall be for the term of three years and six months, ten dollars; for seven years, fifteen dollars; and for fourteen years, thirty dollars.'

"This language contemplates an election to be made by the applicant, at the time of his application, of the term for which he desires his patent to issue, and the payment of a fee corresponding to that election. It does not contemplate the contingency of an application for one term and the payment of one fee, and a subsequent election, at the time of issue, of another term and the payment of another fee. The words are, 'elect in his application.' The choice is to be made there and not elsewhere or otherwise, and, being made, must be final.

"I can see that the practice proposed might be desirable, and might result in the granting of design patents for a longer period and the receipt of a larger revenue; but I have no power to alter the plain language of the statute, or to extend the time of election beyond the time of making the application, for any purpose.

"In the present case the applicant has paid a fee of ten dollars. His patent, if granted, can issue only for three and a half years." (*Commissioners' Decisions, February 23, 1870.*)

277. NO PROVISION MADE FOR USE AND SALE PRIOR TO APPLICATION.—In the case of *Stuart and Bridge ex parte*, (*Commissioners' Decisions, February 23, 1870,*) the Commissioner says: "The applicants, on November 3, 1868, patented the arrangement of ovens and flue in a cook stove having a peculiar external conformation. On February

5, 1870, they filed an application for a design identical with that shown in their patent of 1868.

“Upon this state of facts the examiner asks: 1. Should the application be rejected on the patent? 2. If so, can the patentees reissue in two divisions, one of which shall be for the design? 3. If so, what fees are required?”

“Section 11 of the act of March 2, 1861, provides that the new design, &c., shall not be ‘known or used by others before his, her, or their invention or production thereof, and prior to the time of his, her, or their application for a patent therefor,’ &c.

“It will be observed that no provision is made for use or sale of the invention prior to the application, as in the case of other inventions; and the reason of the distinction is found in the fact, that as designs relate to form and shape only, no time is required for experiment before the application. At all events, the language of the statute is plain. The design must not have been known or used by others prior to the application of the inventor. It is obvious that if the design be described in a prior patent, granted either to himself or others, it is known to others within the meaning of the law. The present application must therefore be rejected upon the former patent.”

278. A DESIGN SHOWN IN A PATENT FOR A MECHANICAL INVENTION IS LOST.—“The second question is, whether the original patent can be surrendered and reissued in two divisions, one of which shall be for the design?”

“Patents for designs may be granted for three and one half, seven, and fourteen years, at the election of the applicant, made at the time of application. Patents for other inventions are granted for seventeen years.

“The patent granted to applicants in November, 1868,

was of the latter kind, and was granted for seventeen years.

“It is provided by section 13 of the act of 1836 that upon applications for reissue ‘it shall be lawful for the Commissioner, &c., to cause a new patent to be issued to the said inventor for the same invention for the residue of the period, then unexpired, for which the original patent was granted.’

“This language is explicit, and it is obvious that under this section any reissue of this patent, or any division of such reissue, must be granted ‘for the residue of the period then unexpired for which the original patent was granted;’ that is, for the residue of seventeen years. But no patent for a design can be granted for seventeen years, or for the residue of an unexpired period of seventeen years; and this fact seems decisive of the question.

“The result is, that an invention of a design, if shown in a patent for a mechanical invention, is lost, and cannot be included in a subsequent application and patent for a design.”

279. NUMBER OF CLAIMS ALLOWED.—In the case of *Sheppard ex parte*, (motion,) the Commissioner says: “This case is referred to me by the primary examiner, upon the following statement: ‘In this application for patent for design of Isaac A. Sheppard, filed February 24, 1870, are found two claims: one for the central figure, (which constitutes the gist of the case,) when cast on and forming a part of a stove plate, and the other for the central figure and surrounding ornaments.

““In dealing with this case, the examiner finds that it has not been the usual practice of the office to allow more than one claim in an application for a patent for a design.

The reasons generally given to sustain this course of action are, that a design is a complete and individual device or ornament, and as such must be exact and perfect in every form, line, or configuration, the slightest deviation from what is represented operating to make a new design.

“The law evidently makes no such inflexible rule of official practice. In the Bartholomew case (*Commissioners' Decisions*, 1869, p. 111) it is observed that a certain reasonable and proper latitude is given in judging what does and what does not breathe the spirit of the invention in any given case, and that mere colorable variation is to receive no more countenance or favor in an application for a patent for a design than it would in an application for a mechanical device.

“But while the examiner is impressed with these views, he is unwilling in his first decisions, in applications of the present character, to overrule, so far as falls within his jurisdiction, the generally settled custom and rule of the office in the above particular. He desires, therefore, to refer the whole matter to the personal consideration of the Commissioner, as a question of office practice, for his decision or direction.

“L. DEANE, *Examiner.*”

“I agree with the examiner that there is no provision in, or fair construction of, the act relating to letters patent for designs, which forbids the union of two or more claims or clauses of claim in a single patent. I am at a loss to know upon what ground such a construction can be asserted or maintained. If the design contains features which are new, singly and in combination, no reason is known to me why they may not be so claimed.

“But the practice of the office has not been so uniformly adverse to the granting of double claims as seems to have been supposed. On the contrary, letters patent for designs containing more than one claim were granted in the years 1855, 1857, 1858, 1859, 1860, and 1862, and doubtless in the succeeding years, if time had permitted a further examination. Among these special reference is made to the patent granted to Apollos Richmond, in 1859, which contains one claim for the configuration of a stove plate, and another for the ornament upon the same plate; and to the patent granted to Isaac B. Woodruff, in 1862, for a design for a clock case, which contains one claim for the configuration of the whole case, and another for a gilt frame forming a subordinate part of the same whole.

“These cases fully justify the claims presented in the present application, which may, therefore, be allowed, both upon reason and precedent.” (*Commissioners' Decisions, March 8, 1870.*)

280. AN APPLICATION FOR PATENT FOR MECHANICAL INVENTION CANNOT BE CHANGED INTO AN APPLICATION FOR A DESIGN.—Applicant filed, in September, 1868, an application for a patent for “a new and useful improvement in a rolled hollow hexagonal column.” He claimed, in terms, “a hollow column of uniform thickness, hexagonal in both its interior and exterior, and rolled out from a solid or welded pile or billet of iron or steel, with a hexagonal opening through it, substantially as described and represented.” Becoming satisfied that he could not succeed in obtaining a patent for his supposed invention in this shape, he now proposes to change his application into one for a patent for a design. He asks to be allowed

to deposit a further fee of \$15, making \$30 in all. He avers that it was by inadvertence and mistake that the fee of \$30 was not paid originally, and the application made, in terms, for a patent for a design, under § 11 of the act of March 2, 1861. He presents an amended specification, in which the invention is described as a "new and original shape or configuration of steel or wrought iron rolled pipes, tubes, or hollow shafts or pillars;" and is claimed in the following terms: "As a new and original shape or configuration of tubes, pipes, hollow shafts, or hollow pillars or posts of steel, or wrought or malleable iron, a machine-rolled tube or pipe or hollow shaft or hollow post, of uniform and symmetrical hexagonal perimeter, area, and cross section, in every part of its length, and having no projections upon its surface or beyond its angles." In support of his prayer he urges that the question whether his patent be for an invention or design is merely one of classification, which is within the discretion of the Commissioner, and he insists that this is a case in which that discretion ought to be exercised in his favor.

Prior to the act of August 29, 1842, there was no law which permitted the granting of letters patent for "shapes," "configurations," "designs," "ornaments," "patterns," and the like, which did not involve some mechanical principle, or amount to a new machine or manufacture within the meaning of the patent law.

By that act and the act of March 2, 1861, these subjects were made patentable, not by enlarging the scope of the existing patent laws by the addition of new subjects of invention, but by independent legislation, providing for a new class of patents, granted to a different

class of persons, for a different class of subjects, for different periods of time, and upon the payment of different fees.

It is not a matter of discretion with the Commissioner whether the subject of an application be a machine, or a design for a manufacture; a manufacture, or a new and original shape or configuration of an article of manufacture; a composition of matter, or a composition in alto or basso-relievo; an art, or a pattern, print, or picture. It is a matter of law, in which a mistake is fatal. These subjects of invention or contrivance are in truth as distinct from each other as either is from a copyright.

The applicant treats this matter as if it were simply a matter of mistake as to the term for which he should have applied for letters patent; but in truth the error, if error there were, was in the character of the application itself. He applied for a patent for a new product, paying the fee for an examination, and paying for a patent for seventeen years. He described, not a design for a manufacture, but a manufacture. He claimed, not a new shape, but a new thing. I know of no discretion or authority vested in the Commissioner to turn this application into an application for a design, nor any process by which it can be accomplished short of a new application. A single illustration will make this sufficiently obvious. An alien may apply for letters patent for an invention, but not for a design, unless he has resided in this country for more than one year and made oath of his intention to become a citizen. It would be impossible, therefore, to turn the application of the alien for an invention into an application for a design, how-

ever clearly the subject-matter might place it in the latter class of subjects.

I regard the eleventh section of the act of 1861 as distinct from the remainder of the law as if it formed the subject of a separate statute, and the codifiers of the patent laws evidently so regarded it, for they collected all the matter relating to design patents in a separate chapter. (*Root v. Ball*, 4 *McLean*, 180.)

281. FORM OF PETITION FOR LETTERS PATENT FOR A DESIGN.—

To the Commissioner of Patents:

Your petitioner prays that letters patent may be granted to him for the new and original design set forth in the annexed specification.

THOMAS TASTY.

282. FORM OF SPECIFICATION FOR A DESIGN.—

I, Thomas Tasty, of New Haven, in the county of New Haven, and State of Connecticut, have invented and produced a new and original design for carpets, of which the following is a specification:

The nature of my design is fully represented in the accompanying photographic illustration, to which reference is made:

Claim.

I claim as my invention the design for a carpet, as shown.

THOMAS TASTY.

Witness: OLIVE OGLE,
SAMUEL MERRIWEATHER.

283. FORM OF OATH.—

STATE OF NEW YORK, }
County of Albany. } ss.

Thomas Tasty, the above-named petitioner, being duly sworn, (or affirmed,) deposes and says, that he verily believes himself to be the original and first inventor of the design for carpets described in the foregoing specification; and that he does not know and does not believe that the same was ever before known or used; and that he is a citizen of the United States.

THOMAS TASTY.

Sworn to and subscribed before me this 13th day of March, 1869.

SIMON SHALLOW,
Justice of the Peace.

XVII. Trade-Marks.

SEC.	SEC.
284. Act of July 8, 1870.	288. Record of assignment.
285. Object and effect of the law.	289. Form of petition and oath.
286. Patent Office requirements.	290. Form of transfer.
287. Duplicate copies.	291. Form of certificate.

284. ACT OF JULY 8, 1870.—For the provisions of the act of July 8, 1870, concerning trade-marks, see Part I, p. 36.

285. OBJECT AND EFFECT OF THE LAW.—In the case of *King ex parte*, (*Commissioners' Decisions*, September 19, 1870,) the Commissioner says: "Applicant tenders \$30 and asks for a patent for fourteen years for a 'design for a trade-mark.' He says: 'The distinctive features of my design consist of my portrait, placed in the center lengthwise, and surmounted by the British coat-of-arms, about which is arranged, in a semicircular form, the words "King's Sauce Royal." Upon the left of my portrait is a shield or tablet, containing the words "Shake well the bottle before using," and upon the opposite side a similar tablet, containing the words "None genuine without my portrait and signature, W. King," said signature being a fac simile of my handwriting. Although the above-named tablets are used, they are not considered as essential to the design, and may be omitted if desired.

"Having thus fully set forth the nature and merits of my invention, what I claim as new, is: The hereinbefore described design, substantially as shown.'

"Prior to the act of July 8, 1870, no protection was afforded by statute for trade-marks *eo nomine*. They were left to the protection of the common law, except where the design was of such character as to fall properly within

the subjects patentable as designs. In such case they have been patented, usually with the addition of the words 'for a trade-mark.' These words were, however, merely descriptive, and carried with them no guaranty as to the use of the trade-mark. In other words, if goods had been sold with such a design affixed, the only penalty that could have been recovered, under the statute, would have been for the infringement of the design as an ornament, and no recovery could have been had of the damage resulting to the injury to the trade of the manufacturer by a violation of his trade-mark in the sale of the articles to which it was attached.

“It was to remedy this evil, and to give promptly, by statute, that protection to trade-marks which the common law tardily afforded, that Congress passed so much of the act of July 8, 1870, as relates to this subject. By the provisions of that act, a trade-mark, whether old or new, may be registered in the Patent Office by its owner, and by the payment of \$25 protection is afforded for thirty years. As this protection is more ample, and covers more than double the time for less money, it is difficult to see why applicant, or any one else, should now seek a design patent for a trade-mark. The folly of the application does not, however, relieve me from the necessity of deciding upon its legality.

“The only clause of the designs act under which trade-marks can possibly fall is that which enumerates ‘any new and original impression, ornament, pattern, print, or picture, to be printed, painted, cast, or otherwise placed on or worked into any article of manufacture.’ This manifestly refers to the external ornamentation of manufactured articles, and it requires, first, a specific article

of manufacture to be ornamented; and, second, an impression, ornament, pattern, print, or picture to be placed upon it. It was only by a forced construction of this clause that designs which were to be used only as trade-marks or selling labels could be included within it.

“But the subject is relieved of all difficulty by § 77 of the late statute. It is there enacted ‘that any person, corporation, &c., who are entitled to the exclusive use of any lawful trade-mark, or who intended to adopt and use any trade-mark, for exclusive use within the United States, *may obtain protection for such lawful trade-mark* by complying with the following provisions.’ This provision, by prescribing the statutory mode of obtaining protection for a trade-mark, excludes all other modes not expressly provided for, and operates as a construction of § 71, in excluding trade-marks from the list of subjects intended to be protected as designs.

“In accordance with this opinion, the present application, and all others which are intended to cover trade-marks, or ‘designs for trade-marks,’ must be presented under the provisions of §§ 77–84 of the act of July 8, 1870, and not otherwise.”

286. PATENT OFFICE REQUIREMENTS.—As to who are entitled to trade-marks, requirements of the law, &c., see Part I, page 36, *et seq.*

Under the provisions of §§ 77 and 81 of the act authorizing the Commissioner to make rules, &c., the following requirements, in addition to those prescribed by law, have been established:

287. DUPLICATE COPIES.—Five duplicate copies of the proposed trade-mark, in addition to the one accompanying the statement and oath of applicant, must be depe-

ited with each application. Certified copies will be furnished at the usual rates. (*Patent Office Rules, July, 1870.*)

288. ASSIGNMENT OF TRADE-MARK TO BE RECORDED SIXTY DAYS AFTER ITS EXECUTION.—The right to the use of any trade-mark is assignable by any instrument of writing, and such assignment must be recorded in the Patent Office within sixty days after its execution. The fees will be the same as are prescribed for recording assignments of patents. (*Ib.*)

289. FORM OF PETITION AND OATH.—

To the Commissioner of Patents:

Your petitioners, Martin Scott and Henry Newman, partners under the firm name of Scott & Newman, residing in Peacedale, Washington county, Rhode Island, and engaged in the manufacture and sale of cotton sheetings at said Peacedale, represent that they have used for ten years last past, are now using, and have the right to use, a trade-mark for said sheetings, of which the design shown in the annexed drawing is a true copy; which trade-mark has been printed in blue ink upon the outside of each piece of sheetings. They further represent that no other person, firm, or corporation has a right to the use of said trade-mark, or of one substantially the same. They therefore pray that said trade-mark may be registered and recorded in the Patent Office according to law, they having paid into the treasury of the United States the sum of twenty-five dollars, and otherwise complied with the regulations in such case made and provided.

MARTIN SCOTT.

HENRY NEWMAN.

STATE OF RHODE ISLAND, }
County of Washington, } ss.

Martin Scott and Henry Newman, being sworn, make oath and say, that the foregoing statement by them subscribed is true in substance and in fact, as they verily believe.

MARTIN SCOTT.

HENRY NEWMAN.

Sworn to and subscribed before me this 15th day of July, 1870.

JOHN JUBAT,

Justice of the Peace.

290. FORM OF TRANSFER OF A TRADE-MARK.—

We, Jotham Mills and Abner Clark, of Keokuk, Iowa, partners under the firm name of Mills & Clark, in consideration of five hundred dollars, to us paid by Jarvis Case, of the same place, do hereby sell, assign, and transfer to the said Jarvis Case and his assigns the exclusive right to use, in the manufacture and sale of stoves, a certain trade-mark for stoves deposited by us in the United States Patent Office, and recorded therein July 15, 1870; the same to be held, enjoyed, and used by the said Jarvis Case as fully and entirely as the same would have been held and enjoyed by us if this grant had not been made.

Witness our hands this 20th day of July, 1870.

JOTHAM MILLS.

ABNER CLARK.

291. FORM OF CERTIFICATE.—

UNITED STATES PATENT OFFICE.

To all whom it may concern:

THIS IS TO CERTIFY, That _____ did, on the _____ day of _____, 187—, deposit in the United States Patent Office for registration a certain trade-mark for _____, whereof a copy is hereto annexed; that _____ filed therewith the annexed statement; and, having paid into the Treasury of the United States the sum of twenty-five dollars, and otherwise complied with the acts of Congress in such case made and provided, the said trade-mark has been duly registered and recorded in the said Patent Office, and will remain in force for thirty years from the _____ day of _____, one thousand eight hundred and seventy.

In testimony whereof I have caused the seal of the Patent Office to be hereunto affixed this _____ day of _____, 187—, and of the independence of the United States the ninety- _____.

[SEAL.]

Commissioner of Patents.

XVIII. Interference.

SEC.

- 292. Duty of Commissioner.
- 293. Patent to issue to prior inventor.
- 294. Definition of an interference.
- 295. When declared.
- 296. When one of the parties has obtained a patent.

SEC.

- 297. Each party to file statement under oath.
- 298. Adjudication by default.
- 299. When case is closed and may be set for hearing.
- 300. Appeal in interference cases.

SEC.	SEC.
301. Notice of declaration of interference.	310. Two years' public use.
302. Notice by publication.	311. When a second interference will be declared.
303. First applicant presumed to be the prior inventor.	312. Withdrawal of claims which do not interfere.
304. Assignment of time for taking testimony.	313. No amendments allowed.
305. Postponement of hearing.	314. Withdrawal after decision.
306. Affidavit required.	315. Interference may be opened to admit new parties.
307. Examiner in charge of interferences.	316. Abandonment in interference cases.
308. When an interference will be dissolved.	317. Classes into which cases of interference may be divided.
309. Primary examiner cannot dissolve an interference.	

292. **DUTY OF COMMISSIONER.**—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. (*Act of July 8, 1870, § 42.*)

293. **PATENT TO ISSUE TO PRIOR INVENTOR UNLESS APPEAL IS TAKEN.**—The Commissioner may issue a patent to the party who shall be adjudged the prior inventor, unless the adverse party shall appeal from the decision of the primary examiner, or of the board of examiners-in-chief, as the case may be, within some time, not less than twenty days, as the Commissioner shall prescribe. (*Ib.*)

294. **DEFINITION OF AN "INTERFERENCE."**—An "interference" is an interlocutory proceeding for the purpose

of determining which of two or more persons, each or either of whom claims to be the first inventor of a given device or combination, really made the invention first. (*Patent Office Rules, July, 1870.*)

295. **WHEN AN INTERFERENCE WILL BE DECLARED.**—An interference will be declared in the following cases:

First. When the parties have pending applications before the office at the same time, both or all the parties claiming to be the inventor of the same thing.

Second. When an applicant, having been rejected upon the prior unexpired patent or the prior application of another, claims to have made the invention before the prior applicant or patentee.

Third. When an invention is claimed in a renewed application which is shown or claimed in an application filed or unexpired patent granted prior to the filing of such renewed application.

Fourth. When an applicant for a reissue embraces in his amended specification any new or additional description of his invention, or enlarges his claim, or makes a new one, and thereby includes therein anything which has been claimed in any patent granted subsequent to the date of his original application, as the invention of another person, an interference will be declared between the application and any such unexpired patent or pending application. If the reissue application claims only what was granted in the original patent, it may be put into interference with any pending application in which the same thing is shown; provided the later applicant claims to be the prior inventor and is not barred a patent by public use or abandonment.

Fifth. When an application is found to conflict with

a caveat, the caveator is allowed a period of three months within which to present an application, when an interference may be declared.

Sixth. The office reserves to itself the right, when two applications are pending at the same time, in one of which a device may be described which is claimed in the other, to declare an interference to determine with whom is priority of invention, without reference to the order in which such applications may have been filed. (*Ib.*)

The interference must be in respect to patentable matters, (*Bain v. Morse, MS. Appeal Cases, 1849,*) and there can be no interference between applications unless there is a substantial identity of the things for which a patent is sought; if there are material and substantial differences between the two things, there can be no identity and no interference, (*Tyson v. Rankin, ib., 1853;*) and where two separate applications for patents for improvements upon the same thing were generally similar in form, and in some respects nearly identical in construction, but the principle, object, and design of each was unlike that of the other, and the end to be attained or effect intended was wholly different, it was held, notwithstanding their general similarity, that the two inventions were not substantially the same, and that there was no interference between them. (*O'Reilly v. Smith, ib., 1853.*) A patentable improvement is not an interference. (*Bain v. Morse, ib., 1849.*)

An interference may be declared between two applications, if the same invention is substantially described in each of them, though the claim in one case may not be as broad as the specification. The oath as to invention

is to be construed as extending to all described in the schedule, (*King v. Gedney, ib.*, 1856;) and where a broad claim covers what is embraced in a special or restricted claim made by another party, a conflict exists which must be determined by an interference. (*Sherwood v. Searls, Commissioners' Decisions*, 1869, p. 112.)

A subsequent application which claims a device which is shown in a prior patent interferes with that patent whether the device be or be not claimed in the patent. In the first place, if the applicant succeeds, it follows, that the patentee can no longer use the whole of that which he has described in his patent; and, in the second, if the applicant makes claim to a device which is shown in an earlier patent, the office can grant no patent to him; for, *prima facie*, he is not the first, but the second inventor. He must prove priority, and the necessity for proof creates the necessity for the interference. (*Wright ex parte, Commissioners' Decisions, June 13, 1870.*)

An interference is properly declared where no claim can be made upon the device of the party first in the office which would not be embraced in that of the other party. (*Bachelor v. Porter, Commissioners' Decisions*, 1869, p. 64.)

296. WHERE ONE OF THE PARTIES HAS OBTAINED A PATENT.—The fact that one of the parties has already obtained a patent will not prevent an interference; for, although the Commissioner has no power to cancel a patent already issued, he may, if he finds that another person was the prior inventor, give him also a patent, and thus place them on an equal footing before the courts and the public. (*Patent Office Rules, July, 1870.*)

Thus, in the matter of the interference between the

application of J. C. Stoddard and the patent of H. A. Streeter for the same invention, the Commissioner says:

“If these two cases were before me in the form of applications, I should have no hesitation in refusing a patent to both. Unfortunately, Streeter has received a patent; and the question now before me is, whether one should now be granted to Stoddard.

“Aside from the substantial existence of the inventions claimed by Streeter in the prior patents of Stoddard, I find Stoddard to be the prior inventor of the precise ‘arrangements’ claimed by Streeter. He made a machine in 1866, which was seen by several persons, and the existence of which is fully proved. He swears to the making of another in 1868, at Dayton, Ohio, and this is not contradicted. He preferred, in his earlier patent, to locate the rake in front of the axle, because he thought that when the farmers fully understood it they would rather use it in that way, and he wished it to be fully tried. The other form was made, explained to others, and held in reserve. I have already held that it involved no invention to pass from the one to the other. Nevertheless, having issued a patent to Streeter, it is probably no more than just to issue a like grant to Stoddard, the real inventor of both forms, in order that he may be able to present to the public a grant as complete in the form of its claims as that which has inadvertently been made to his competitor. The decision of the board of examiners-in-chief, awarding priority of invention to Stoddard, is affirmed.” (*Commissioners’ Decisions*, September 7, 1870.)

The case of *Luther O. Crocker ex parte* presents interesting questions for consideration. Mr. Justice Fisher says: “In April, 1867, a patent was granted to said

Luther O. Crocker and one George T. Field, they having made an application therefor as *joint inventors*. After this patent had been issued, it appears that these patentees, upon consultation with their counsel, discovered that they were really not joint inventors of the device, but that Luther O. Crocker alone was the inventor. How this misapprehension occurred does not appear; but that Crocker was and is the sole inventor seems to be admitted by Field and also by the Patent Office. That the mistake honestly occurred does not seem to be doubted, as there is no suggestion from the office that there was any fraud practiced by either Field or Crocker. I therefore assume that the mistake, in supposing that they were joint inventors, was honestly made. Finding upon consultation with their counsel that they were laboring under this misapprehension, they set about correcting the error. To this end Crocker filed an application in his own name only for a patent for the same invention, making the oath of course that he was the sole inventor. Soon after filing this separate application he also filed an affidavit made by Field, setting forth the fact that the former patent had been erroneously issued to them as joint inventors, and that, since the explanation given them by their counselor, he was satisfied that Crocker alone was the sole inventor, and renouncing any claim as inventor himself, or as a joint inventor with Crocker.

“The question then arose in the office as to how the error could be cured, and Crocker receive a patent as sole inventor. All agreed that an error had been made, and it seems also to be conceded that it was made not through any fault in the office, but through the innocent ignorance of Crocker and Field. The applicant

demanded a new original patent to be issued to him solely, without any offer on his own behalf or of Crocker and Field to surrender the joint patent for cancellation. But the examiner in charge decided that the 'remedy is not the issue of a new patent, but that the party in amicable error should assign all his interest, real or apparent, to the applicant, who could then properly control a reissue;' and he postponed further action in the case, in order, I suppose, that such assignment might be made, and a reissue granted to Crocker only.

"To this Crocker, the applicant, objected, and insisted that he was entitled to be put in interference with the patent issued to Crocker and Field jointly, and himself declared the prior and sole inventor, on the sworn acknowledgments of himself and Field. The examiner, after a consideration of the matter, adhered to his original decision, and held that 'the applicant is the party in error, and cannot, through such error, force the office into the dilemma of either deliberately granting two patents for the same identical invention, or going through the form of a "*quasi interference*."' The applicant still pressing for his new patent, the examiner finally rejected the application on the 3d of April, 1868, in order, as he says, 'to put the case in process to become subject to appeal upon the question at issue.' Accordingly Crocker made his appeal to the board of examiners-in-chief. This board decided that 'the patent issued to Crocker and Field is void *ab initio*, because it was issued to two parties as joint inventors, whereas Crocker was the sole inventor; and that thus, being void *ab initio*, an applicant for a patent cannot be put in interference with a patent which does not exist, and, for the same reason, there can be no party

to assign his interest, for he can have no interest to assign in a void patent.' From their reasoning it would seem that the applicant, Crocker, had no remedy either by a reissue or new original sole patent. Having pronounced the joint patent void, and treating it as no patent, we could hardly suppose it would support a reissue, any more than it would support an interference, which they pronounce impossible, because, as they say, the joint patent had actually no existence, and therefore there is no patent for Crocker's application to be put in interference with. They strangely enough, however, agree with the examiner that the application should be rejected, though they 'do not concur with him in the reasons which he has given for his decision or the remedy he suggests,' to wit, the assignment by Crocker and Field of the joint patent to Crocker, the surrender of the same by Crocker, and a reissue upon that surrender. They suggest, however, that the remedy of the applicant is in the surrender of the invalid patent, 'and in a reissue or granting of a new patent to the inventor (Crocker) for the residue of the period unexpired.' So that, although they say they do not concur in the remedy suggested by the examiner, they really do concur in it. The examiner suggests a reissue as the remedy; the board suggests the same remedy. They only, in fact, differ with him as to how the reissue is to be had. The examiner says it may be had by an assignment, made to Crocker alone from Crocker and Field, and then a surrender by Crocker. The board say no assignment can be made, because, the joint patent being void *ab initio*, there is nothing to assign. But it would seem that if there is nothing to assign, there can also be nothing to surrender; and, be-

sides, if, while the old patent is not assignable, it may still be surrenderable, it would seem that Crocker alone cannot surrender it. The surrender would have to be made by both Crocker and Field; and, then, what if Field were unwilling to surrender? How could Crocker compel him?

“The board suggests the remedy of reissue according to the provisions of section 13 of the act of 1836, which they quote in their opinion, and which I quote literally, except that, supposing it applies to cases of joint patentees or inventors, I substitute the plural for the singular number, in order to show that the provisions of that section could not possibly have been enacted to meet cases of the kind now under consideration. With such alterations the section would read thus: ‘Whenever any patent which has been heretofore granted, or which shall hereafter be granted, shall be inoperative or invalid by reason of a defective or insufficient description or specification, or by reason of the patentee(s) claiming in his (their) specification as his (their) own invention more than he (they) had or should have a right to claim as new, if the error has or shall have arisen by inadvertency, accident, or mistake, and without any fraudulent or deceptive intention, it shall be lawful for the Commissioner, upon the surrender to him of such patent and the payment of a further duty of \$30, to cause a new patent to be issued to the said inventor(s),’ &c. Now, under this section, as I interpret it, if this old joint patent be surrendered, the reissued patent based upon it must issue to the same or ‘said’ patentees (or to the assignee of the same patentees) who took out the original patent upon which the reissue is based, so that a reissue

would be no more valid or operative than the original, the place of which it is to take. In my judgment, this thirteenth section was not intended to correct a mistake as to the parties who take out a patent under the honest but erroneous impression that they are joint inventors. It is simply intended to correct errors which might be made in the claims of the party taking out a patent by reason of the insufficient description of the machine or thing invented, and not to correct the errors of parties who have mistakenly supposed themselves to be joint inventors. It was intended to enable an inventor who had, on the one hand, claimed too much, by describing his claim too broadly, or, on the other, by failing to describe it broadly enough to cover all his invention, to cure these errors, and not to cure errors as to the identity of the inventor. I am, therefore, clear in my conviction that reissue is not the remedy which the patent laws provide for the error committed in this case.

“The question then recurs, can the mistake be cured by the mode suggested by the applicant? Can a new *original* patent be granted to him upon a declaration of interference between his application and the patent heretofore granted to Crocker and Field? I think this is the proper and only remedy, except, perhaps, by proceeding in equity under the sixteenth section of the act of July 4, 1836.

“It is true that Commissioner Foote, in his opinion affirming the decision of the board of examiners-in-chief, says that ‘the Patent Office has no authority to issue two patents for the same invention—a joint patent to two parties and a separate one to one of them.’ Let us see, first, whether such authority does not exist to issue two patents for the same invention. There can be no doubt

that such authority does exist. Let us suppose that John Doe applies for and receives a patent for an improved ticket-cutter, having invented it six months before he makes his application. Richard Roe, having invented the same thing precisely, six months before John Doe invented it, comes in with his application within two years from the time of the making his invention. The office would not hesitate at once to declare an interference between the patentee and the applicant; and if, upon the hearing, it should appear that Roe was the prior inventor, and was without laches, he also would receive his patent for the same invention, notwithstanding Doe had received one before.

“The whole law on this subject of interference looks to nothing other than granting two patents for the same invention. It is done every month almost, if not every week; and neither party is concluded by the action of the court in granting a patent to the other, but each is free to fight out his claim of priority before the courts. But the trouble of granting two patents in this case, a joint and separate one, seems to be two-fold: First, that Luther O. Crocker was one of the persons to whom the joint patent was issued, and therefore he cannot be put in interference with himself and another as joint patentees; and, second, that because Field had admitted away his joint inventorship before the declaration of interference, therefore the interference, if declared, would merely be a quasi interference. There are no difficulties at all. If another than Crocker had made an application for the patent he now seeks, a declaration of interference would have been made at once. Then why not make it between Crocker and Field and Crocker? One

of two parties may sue the firm of which he is a member, so he may be put in interference with his firm. Nor does the fact that Field swears away the claim of priority of Field and Crocker, in advance of the declaration of interference, present any reason why the interference should not be declared and tried. It simply saves time, expense, and trouble in the trial of cases, and that is all.

“But Commissioner Fisher, in his reply to the reasons of appeal in this case, after referring to the opinion of Commissioner Foote, adds the following, viz:

“1. This appellant, having heretofore made oath that the invention was joint, cannot now be permitted to allege that it was a sole invention. To permit this would offer a premium to perjury. (*See Child v. Adams*, 1 *Fish.*, 189.)

“2. The remedy, if an honest error existed and any remedy could be afforded, should have been preceded by a surrender of the joint patent for cancellation. That this may be and has been done, see *Batten v. Taggart*, (17 *How.*, 84.)

“The very high respect which I entertain for the opinion of the present Commissioner on any question of patent law led me at first to suppose that if any remedy does exist at all for the error in this case, it could not be in the issuing of a new original patent; and, being clear in my conviction that it is not the case for a reissue, as provided for in section 13 of the act of 1836, I suppose the applicant was altogether remediless, except through a bill in equity; and yet it seemed to be hardly in consonance with the spirit of our patent system that a mistake thus honestly made, as this was admitted to be, must go entirely without relief from the office. But on look-

ing into the case of *Child v. Adams*, I find that it does not sustain the position which it is cited to sustain. The syllabus of that case, as made by the reporter, and very accurately made too, embraces the following seven propositions only, viz:

“1. Section 13 of the act of July 4, 1836, by defining the condition under which the power it confers shall be examined, necessarily excludes it in all others, except, perhaps, the correction of clerical errors.

“2. Where a statute defines the extent of power given to one who acts ministerially, the courts cannot extend it, or validate acts done without or beyond its authority.

“3. The Commissioner has no power to confirm a patent obtained by false suggestion, either by pardoning the offense or excusing it on the plea of innocent ignorance.

“4. If an alien, either through ignorance or intention, falsely represents himself as a citizen in order to obtain a patent, the patent so procured is inoperative and invalid to vest a title in the alleged invention.

“5. The oath of citizenship and other duties required by section 6 of the act of July 4, 1836, are conditions-
precedent, without which the Commissioner has no authority to grant a patent; and a defendant may allege the neglect or fraudulent omission to fulfill these conditions, or any of these, as a sufficient defense.

“6. M, an alien, made oath that he was a citizen of the United States, and obtained a patent. Eight years afterwards he surrendered his patent, made oath that he was a citizen of France, paid the balance of the fee due the Patent Office, and obtained a reissue, which recited (among other things) that said original letters were granted to him upon his belief that he was a citizen of the

United States, which belief arose from ignorance of the laws of the United States: Held, that the original and reissued patents were both invalid, the first because of false suggestions; the second from want of power in the Commissioner to grant it.

"7. Held, also, that the Commissioner could not grant a new original patent eight years after the invention had been in public use.

"Now, the court did not decide in this case that the Frenchman, having once sworn himself to be a citizen of the United States, under an honest misapprehension could not be permitted to allege himself to be a French citizen. On the contrary, it may be fairly inferred, from the opinion delivered in the case, that he might have corrected his honest mistake if he had made timely application to do so in the right way. Judge Grier expressly declares that Mini, (the Frenchman,) with the consent of his assignees, had the right to surrender his original patent to be canceled, 'and when the invention or discovery had not been in public use more than two years the Commissioner might probably grant him a new original patent on an original application,' &c. The learned judge flatly decides that the Commissioner has no power under the 13th section of the act of July 4, 1836, to grant a new patent to one who has obtained it by false suggestion, which shall retroact by way of confirmation of the original or stand in its place; but says that he *probably* has the power to grant a new original patent in such a case, provided the invention or discovery had not been in public use more than two years before filing an original application, truly stating the citizenship of the inventor. So that, in fact, the case of *Child v.*

Adams, so far from militating against the right of the applicant in this case to have a new original patent on his new original sole application, actually favors it. The second proposition of Commissioner Fisher also fails of support from the case of *Batten v. Taggart*, viz, that the remedy, if any, could only be found in a surrender of the joint patent for cancellation. The case cited only shows that such a thing had been done, but it does not appear that it was ever decided to be properly and legally done, as it legally was never challenged. It certainly does not decide that a surrender must necessarily precede the granting of a new original patent.

“As Judge Grier, in the case of *Child v. Adams*, suggests that the court might *probably* in *Mini's* case have granted a new original patent on an original application, let us see if it is not more than probable that he had the power to do so. If we refer to the language of the 8th section of the act of 1836, and consider its provisions, we find that that probability rises to a certainty. That section declares that ‘whenever an application shall be made for a patent which, in the opinion of the Commissioner, would interfere with any other patent for which an application may be pending, or with an unexpired patent which shall have been granted, it shall be the duty of the Commissioner to give notice thereof to such applicants or patentees, as the case may be; and if either shall be dissatisfied with the decision of the Commissioner on the question of priority of right or invention, on a hearing thereof, he may appeal,’ &c. In this case, it is conceded that Crocker has made an original application for a patent, which interferes and is identical with the patent issued to Crocker and Field. This being so, it was

the duty of the Commissioner at once to declare the interference, and to decide the question of priority of invention; and, upon the showing of both Field and Crocker, it appearing that Crocker was the sole inventor, it was his duty, in the absence of the testimony to the contrary, to decide priority in favor of Crocker, and to grant him a new original patent. Had Crocker neglected to make his original application for the sole patent for more than two years, his case would have been in that respect analogous to the case of the Frenchman, Mini, and he would not have been entitled to his new original patent, simply because the invention would have been too long in public use to entitle him to it, as was Mini's case. As I have before said, the fact that Crocker, individually and solely, would be a contesting party against himself and Field jointly would not in the least alter the case; nor would the fact that Field had, under oath, disclaimed all claim of inventorship be any reason for not declaring the interference. The joint patent and the sole application were conflicting claims, and required absolutely an interference to be declared. The duty of the Commissioner in such a case seems, by the terms of the 8th section of the act of 1836, to be made imperative, and, being so, it was error to have refused a declaration of interference and rejected the application for a new original patent to Crocker, as the sole inventor.

“For these reasons the decision of the Commissioner of Patents is reversed.” (*MS. Appeal Cases, 1869.*)

297. EACH PARTY TO FILE STATEMENT UNDER OATH.— Upon the declaration of an interference each party will be required, before any time is set for the taking of testimony, to file a statement under oath, giving the date and

a detailed history of the invention, showing the successive experiments, steps of development, extent and character of use, and forms of embodiment. Such statement shall not be open to inspection by the other party until both are filed, or until the time for filing both has expired. (*Patent Office Rules, July, 1870.*)

298. ADJUDICATION BY DEFAULT.—In default of such filing by either party, or if the statement of either fails to overcome the *prima facie* case made by the respective dates of application, or if it shows that the invention has been abandoned, or that it has been in public use for more than two years prior to the application of affiant, the other party shall be entitled to an adjudication by default upon the case as it stands upon the record. (*Ib.*)

299. WHEN THE CASE IS CLOSED AND MAY BE SET FOR HEARING.—Where no testimony is taken by the applicant, upon whom rests the burden of proof, or where testimony has been taken by such applicant, but not by the other party, during the time assigned to the latter, the case will be considered closed, and may, at the expiration of the time assigned to such parties respectively, be set down for hearing at any time not less than ten days thereafter. (*Ib.*)

300. APPEAL IN INTERFERENCE CASES.—In cases of interference parties have the same remedies by appeal as other applicants to the examiners-in-chief and to the Commissioner, but no appeal lies in such cases from the decision of the Commissioner. Appeals in interference cases should be accompanied with a brief statement of the reasons thereof. (*Ib.*)

301. NOTICE OF DECLARATION OF INTERFERENCE.—When an interference is declared notice will be given to both

parties or to their attorneys. When one of the parties has filed a caveat, or already received a patent, duplicate notices will be sent to the patentee or caveator and to his attorney of record. (*Ib.*)

302. NOTICE BY PUBLICATION.—Where one of the parties resides abroad and has no known agent in the United States, in addition to the notice sent by mail, notice may be given by publication in a newspaper of general circulation in the city of Washington once in a week for three successive weeks. (*Ib.*)

303. FIRST APPLICANT PRESUMED TO BE THE PRIOR INVENTOR.—In cases of interference the party who first filed so much of his application for a patent as illustrates his invention will be deemed the first inventor in the absence of all proof to the contrary. (*Ib.*)

In the case of *Smith v. Burlew* the Commissioner says: “The opinion of the board of examiners-in-chief announces, as a rule of practice, the following extraordinary proposition: ‘Heretofore, this board, in cases of interference between an applicant and a patentee, have leaned to the side of the applicant where there has been doubt as to who was the prior inventor, and have been disposed to grant the prayer of the applicant, on the ground that this is expedient in order that it may be determined in a court of law, if the parties so choose, to which of said parties is rightly issued letters-patent.’

“It is an old maxim of the law that *prior tempore, potior jure*, and when a party has made his application and obtained his patent, it would seem that his priority in point of time should entitle him to some consideration as against later and less diligent competitors. Accordingly, by the rules of this office, following the ordinary rules of

evidence, the burden of proof is put upon the last applicant to overcome by evidence the presumption of priority arising from the earlier application. The effect of this rule is to declare that, as the case stands at the declaration of interference, it must be decided in favor of the earlier applicant if no proof be offered; or, if the testimony is equally balanced, it must be decided in his favor; or, if it be simply doubtful, he is entitled to the benefit of the doubt. To give the benefit of the doubt to the last applicant is simply to presume that the first applicant is *not* the first inventor, which would neither be in accordance with law nor common sense. The logical result of such a doctrine would be, in every case where there are two applicants, neither of whom has a patent, but where the proofs raise a doubt, that a patent should issue to both, in order that the courts may decide between them.

“The truth is, that the Patent Office is made by law the tribunal where in the first instance the question of priority is to be determined, and where it is to be determined upon testimony taken and applied according to the ordinary rules of evidence. If there is error, a remedy is given by § 16, act 1836, (*vide supra*, p. 26,) by bill in equity, to either party, whether a patent be issued to him or not. This provision is ample, and takes away all necessity and excuse for foisting upon the country, in the face of the ordinary legal presumptions, two patents for the same invention, both of which may be used as means of speculations upon, or annoyance to, the innocent public.

“The decision of the board of examiners-in-chief is reversed, and the priority is awarded to Smith.” (*Commissioners' Decisions, May 16, 1870.*)

As two patents ought not to be granted for the same thing, if it can be avoided, the benefit of a doubt should be given to the patentee on an interference with an applicant. (*Wheeler and Chenoweth, Commissioners' Decisions, 1869, p. 3.*)

304. ASSIGNMENT OF TIME FOR TAKING TESTIMONY.—A time will be assigned in which the other party shall complete his direct testimony; and a further time in which the adverse party shall complete the testimony on his side; and a still further time in which both parties may take rebutting testimony, but shall take no other. If there are more than two parties, the time for taking testimony shall be so arranged, if practicable, that each shall have a like opportunity in his turn, each being held to go forward and prove his case against those who filed their applications before him. (*Patent Office Rules, July, 1870.*)

305. POSTPONEMENT OF HEARING.—There is nothing in the laws relating to the Patent Office, or in the rules adopted by the Commissioner, to prevent him from postponing the hearing of an interference, if, in his opinion, the justice of the case should require it, and especially for the correcting of an irregularity in matters of form. (*Smith v. Flickenger, MS. Appeal Cases, D. C., 1843.*)

Applications for postponement are within the discretion of the Commissioner, and it will be presumed that his discretion has been soundly exercised. (*O'Reilly v. Smith, ib., 1853.*)

Where, therefore, depositions in an interference had been correctly taken, but had not been transmitted in the form required, so that they could be considered by the Commissioner, held that the Commissioner had a

right to postpone the hearing, to allow the parties to cure the informality, if he should deem such action necessary to further the ends of justice. (*Ib.*)

306. **AFFIDAVIT REQUIRED.**—If either party wishes the time for taking his testimony, or for the hearing, postponed, he must make application for such postponement, and must show sufficient reason for it by affidavit filed before the time previously appointed has elapsed, if practicable; and must also furnish his opponent with copies of his affidavits and with reasonable notice of the time of hearing his application. (*Patent Office Rules, July, 1870.*)

Affidavits on which to move for an enlargement of the time to take testimony in an interference, on the ground that the moving party could not obtain the attendance of his witnesses at the time appointed to take their examination, should state the names, competency, and materiality of the witnesses to be examined. (*O'Reilly v. Smith, MS. Appeal Cases, D. C., 1853.*)

307. **EXAMINER IN CHARGE OF INTERFERENCES.**—Cases of interference will, when the issue is made up and the testimony taken, be tried before the examiner in charge of interferences. (*Patent Office Rules, July, 1870.*)

308. **WHEN AN INTERFERENCE WILL BE DISSOLVED.**—If an interference has been properly declared, it will not be dissolved without judgment of priority, founded upon the testimony or the written concession of one of the parties, unless the invention is found not to be patentable, or to have been abandoned, or that it has been in public use for more than two years prior to the application of either party, or that no interference in fact exists. (*Ib.*)

In the case of *Duthie v. Casilear* the Commissioner says: "This is a motion to dissolve an interference. Several reasons are urged by the attorney for the motion, of which only one will be considered.

"It appears that Duthie's patent was twice rejected by the examiner and once by the examiners-in-chief. Subsequently, through oversight or change of opinion, the examiner allowed a patent to Casilear. He afterward took up the application of Duthie, and, without amendment or order from the Commissioner, reconsidered it, and placed it in interference with the patent of Casilear. This course was irregular. After the decision of the board the case was removed from the jurisdiction of the examiner, and he could not reconsider the case without an order from the Commissioner. It is somewhat difficult to see, also, if the inventions interfere, how a patent was granted to Casilear, a subsequent applicant. At all events, the irregularity in the reconsideration of Duthie's case, and in the declaration of interference, are such that the motion to dissolve the interference must prevail. The interference is dissolved." (*Commissioners' Decisions, September 15, 1870.*)

309. PRIMARY EXAMINER CANNOT DISSOLVE AN INTERFERENCE.—In the case of *Traut v. Diston* the Commissioner says: "In this case the primary examiner, upon the filing of an application of one of the Trauts as sole inventor, made an order dissolving the above interference. This order was irregular. After the declaration of an interference it cannot be dissolved except by the order of the examiner in charge of interferences, or the Commissioner, or by the board of examiners-in-chief or Commissioner on appeal. If facts come to the notice

of the primary examiner which render it proper that the interference should be dissolved, or if new cases are filed which he thinks should be included in the interference, he can only act through the examiner in charge of interferences, to whom application must be made.

“The order made by the primary examiner is set aside and the case remanded to the examiner of interferences.”

(*Commissioners' Decisions, September 15, 1870.*)

310. TWO YEARS' PUBLIC USE, (*vide supra*, p. 264.)—In the case of *Young v. Hoard* the Commissioner says: “This is a motion to dissolve an interference, upon the ground that the invention is shown to have been in public use for more than two years prior to the application of Young, which was filed April 8, 1870.

“Affidavits have been filed on both sides, from which it appears that the patent with which Young claims an interference was, in fact, granted to John W. Hoard, R. A. Dennison, and Young himself, as assignees of Hoard; that, in company with his copatentees, he sold this patent to the Union Eyelet Company, who proceeded to manufacture under it in May, 1867, and have continued the manufacture until the present time. These facts are not denied by Young, but he asserts that, while the use of the invention by the Union Eyelet Company was begun and continued with his knowledge and consent in May, 1867, and for about six months thereafter, after that time he did not assent to such use, although he admits that it went on in spite of him.

“The admitted facts are fatal to Young's application. It is not necessary that the use should have been a continuing use, extending over a longer period than two years prior to the application, in order to render the

patent void. It is sufficient if it be a public use or sale, at any time and for any length of time, occurring more than two years before the filing of the application. (See *Hunt v. Howe*, *Book of Appeals*, vol. 2, p. 380; *Sanders v. Logan*, 2 *Fisher*, 167.)

“The motion is sustained, the interference will be dissolved, and the application of Young will be rejected, because the invention claimed by applicant was in public use for more than two years prior to his application.” (*Commissioners' Decisions*, June 13, 1870.)

311. WHEN A SECOND INTERFERENCE WILL BE DECLARED. A second interference is only a rehearing of the same case. (*Eams v. Richards*, *MS. Appeal Cases*, D. C., 1859.)

A second interference will not be declared upon a new application filed by either party during the pendency of an interference or after judgment, nor will a rehearing be granted, unless it be shown to the satisfaction of the Commissioner (in person) that the party desiring a new interference or rehearing has new and material testimony, which he could not have procured in time for the hearing, or unless other sufficient reasons be shown satisfactory to the Commissioner. (*Rules of the Patent Office*, July, 1870.)

In the case of *Abraham v. Fletcher*, the Acting Commissioner (Hodges) says: “The parties have heretofore been opposed to one another in a previous interference respecting the same invention, as well as two other parties, S. M. Clark and M. T. Gosnell. In the course of the controversy Abraham became satisfied that he was anticipated by Clark, and took no testimony, supposing he could not recover against him. The case was ultimately decided in favor of Fletcher, upon the ground that the device, which

Clark proved that he had originated before Fletcher had made the one in controversy, was not identical with it, but was a different invention. When Abraham learned this, he also ascertained, upon inquiry, that Fletcher's proof did not carry the discovery as far back as he claims that he himself had made it. He thereupon filed a second application. Upon his petition, and upon his showing the circumstances, it was ordered by the Acting Commissioner that the issue of Fletcher's patent should be suspended, and that the present interference should be declared between Abraham's second application and the previous one filed by Fletcher. Fletcher now moves, by his counsel, that this interference should be dissolved, and, secondly, that the order to suspend the issuing of Fletcher's patent should be rescinded.

“It is urged that the interference should be dissolved, in the first place, upon the ground that the decision in the former interference has settled the question as between these parties; that the question of priority has, in other words, become *res adjudicata*; and that Abraham is estopped by it from setting up any claims as a prior inventor against Fletcher. We apprehend that no such effect can be given to these decisions of the office. It is expressly provided in the 12th section of the act of 1836 that they shall not preclude the parties from contesting the validity of a patent in trials at law. There is still less reason for attributing such force to them in proceedings before the office, while the parties are yet before it. Even at law, the decision of a judicial tribunal is not regarded in that light until the term has elapsed and the case has become merged in a judgment beyond the control of the court. And so long as no patent has issued the whole matter is

still pending in the office, and there is nothing which can be regarded as *res adjudicata*, so far as to limit it in the exercise of its usual jurisdiction.

“It should be further remarked, that the doctrine contended for, if sustained, would render all second interferences between the same parties respecting the same invention utterly useless and vain. There would be no question left open between them, but their rights would be established by the result of the first interference beyond the power of the office to modify. Yet, from the earliest organization of the office, it has been the settled practice to declare such second interferences, and therein, when proper, to reverse the decision in the former one. And numerous patents have been granted to the successful parties upon such second interferences, notwithstanding patents had been granted to their adversaries upon the previous trials.

“The 8th section of the act of 1836 has, in fact, always been regarded as imperatively requiring that an interference should be declared whenever a pending application is found to be in conflict with another or with any unexpired patent. It has never been supposed that such an interference could be denied because the question to be raised had already been tried and settled by the office. When it was found that this was open to abuse, and that parties persisted in filing repeated conflicting applications, in order to delay the issuing of a patent to their successful opponents, the rule was adopted that upon the determination of an interference a patent should issue to the party recovering. If, then, the other filed a new application and demanded an interference, it should be granted between that application and the patent which had been issued.

"No more inducement usually remains, therefore, for filing such second application any more than for commencing causeless suits at law. This rule, however, is modified whenever the failing party shows cause why he should have a rehearing, just as courts grant new trials after a verdict. In such cases the issuing of the patent to the winning party is ordered to be suspended, and the interference is declared between his original application and the new application filed by the other party.

"Such were the circumstances of the present case. No question was made upon the hearing as to the reasonableness of the ground upon which the orders were made. The motion is refused." (*Commissioners' Decisions*, 1869, p. 50.)

In the case of *Diston v. Emerson*, Acting Commissioner Duncan says: "This is a motion for the reopening of the interference, which is now before the Commissioner on appeal from the decision of the examiners-in-chief in favor of the applicant.

"The patentee has taken no testimony, while the applicant appears to have carried his invention back to a date prior to the filing of the application upon which the patent was granted.

"Patentee now moves for a rehearing, on the ground that since the closing of testimony new evidence has been discovered which he deems material to the issue, said evidence being to the effect that applicant saw the invention going into public use, but neglected to assert his right thereto by warning the public to desist from the practice of that to which he himself was laying claim, and, further, that applicant denounced the invention as visionary, worthless, and impracticable; the apparent

object of this evidence being to show that at best applicant only regarded the invention as experimental and problematic in his hands until after it was reduced to practice and introduced into public use by another, or, if it is to be regarded as perfected by him, that the neglect on his part was such as to constitute a forfeiture of his right to a patent.

“Standing alone, these alleged facts would not establish either of the conclusions named; the authorities cited do not go to this extent; yet from an addendum to the opinion of the examiners-in-chief it appears that there is already in the case evidence of laches on the part of applicant. Said opinion is signed by but two members of the board, and one of these appended a postscript in these words: ‘I subscribe this with hesitation, having doubts whether Diston can be said to have exercised reasonable diligence in adapting and perfecting the invention.’

“Under these circumstances it seems desirable to have the further evidence, now offered, bearing upon the question of laches. Taken in connection with the facts already proven, it may have a significance that would not attach to it if considered separately.

“It will be to the advantage of both parties doubtless that the question should be exhaustively investigated before the Patent Office, rather than slighted here, to become, of necessity, a bone of contention before the courts.

“Applicant can hardly complain of the delay that a reopening of the case will occasion, as the record shows that he rested nearly two years after his rejection, upon reference to the patent which he is now seeking to de-

stroy, before taking action to determine the question of priority; the parties owning the patent being allowed to go on, meanwhile, developing a large manufacturing enterprise by a liberal expenditure of capital, all unwarned and unconscious of impending danger.

“The motion is granted and the case will be reopened.”
(*Commissioners' Decisions, August 25, 1870.*)

In the case of *Covel v. Maxim* the Commissioner says: “This is a motion on the part of E. Hall Covel to reopen this case for another hearing and for further testimony.

“The facts are, in substance, as follows: The interference was declared February 2, 1869. Covel, having made oath to his invention sixteen days later than the other applicants, was ruled to take his testimony first, and to close it on the second Monday in March. The day of hearing was fixed for the fifth Monday of March, 1869.

“During the five weeks allotted to him Covel took no testimony whatever; but when it had elapsed he applied to the examiner and to the Commissioner for further time. Upon this application the time was extended to April 26, and the day of hearing was postponed to the second Monday of May. Covel still took no testimony, but allowed the case to go entirely by default. The examiner, therefore, on the day of hearing, had no choice but to decide against him, as his opponents had made the prior oath, and as he, upon whom the burden of proof lay, had taken no testimony whatever.

“As soon as he was notified of this decision, Mr. Covel appeared before the Commissioner, with an application for a rehearing and for further time. Upon hearing his statements, in the presence of the examiner, the Com-

missioner declined to grant him the three months for which he asked upon his unsupported demand, but suggested that he should present affidavits showing the necessity for such an extension. At his own request he was allowed a few days to visit New York upon that errand. This was about June 1.

“Nothing further having been heard from Mr. Covel, on July 9 the examiner addressed a letter to him, notifying him that his affidavits, if he intended to produce any, must be filed within twenty days, as further delay was unreasonable. This notice he alleges he did not receive until after the twenty days had expired; and upon this point, and it is the only one, he is sustained by the affidavits of others.

“Nevertheless he had the twenty days, and when he did hear of the notice he came again to Washington, and obtained from the Acting Commissioner an extension to August 21, thus giving him over twenty days more.

“This time passed like all the former allowances. Not an affidavit was or has been filed showing what testimony he proposed to take, why he needed so long a time to take it, or disclosing any of the facts required upon every motion to open a default or grant a rehearing.

“Finally, on the 7th of September, seventeen days after the last allowance of time, and *four months* after the decision, his motion was finally denied, and the patent was ordered to issue to Maxim and Radley.

“As usual, Mr. Covel now appears again with a motion for more time. Up to the present moment he has taken no proof, has offered no affidavit except his own to show what proof he desires to offer, or that he has proof to offer; and his own affidavits give no details, but are con-

fined to statements of the most general character. The only evidence of vitality that he has shown has been exhibited when the office—its patience outraged beyond limit, and mindful of the fact that the other applicants have some rights in the premises—has notified him that it could delay no longer. It is difficult to believe that such persistent waste of time was not intended simply to delay the issue of a patent to those whom applicant already believed to be the prior inventors. He declares by affidavit that he had no such intention, and he is entitled to the benefit of the doubt; but he by no means makes a case which ought to induce the Commissioner for a moment to delay or suspend the issue of a patent to those who have so long ago been adjudged entitled to receive it, and against whose claim not an iota of testimony has yet been offered after these months of delay.

“The notice of the decision of the examiner fixed a limit of appeal, which has long since passed. This might, in a proper case, have been enlarged, upon motion to the Commissioner. Failing to do this, the right of Maxim and Radley to a patent ought not now to be disturbed, especially as, in the absence of testimony, the correctness of the decision is beyond dispute.” (*Commissioners' Decisions*, 1869, p. 78.)

312. WITHDRAWAL OF CLAIMS WHICH DO NOT INTERFERE.—When an application is adjudged to interfere with a part only of another pending application, the interfering parties will be permitted to see or obtain copies of so much only of the specifications as refers to the interfering claims. And either party may, if he so elect, withdraw from his application the claims adjudged not to interfere, and file a new application therefor: *Provided*,

That the claims so withdrawn cover inventions which do not involve the devices in interference: *And provided also,* That the devices in interference are eliminated from the new application. In such case the latter will be examined without reference to the interference from which it was withdrawn. (*Patent Office Rules, July, 1870.*)

313. NO AMENDMENTS RECEIVED DURING INTERFERENCE.—No amendments will be received during the pendency of an interference, except as provided in the foregoing section. (*Ib.*)

314. WITHDRAWAL AND REFILEING OF APPLICATION AFTER DECISION.—The Commissioner has authority to permit one of two competing applicants for a patent for a similar invention to withdraw his application, after decision upon an interference, and refile his application, and to declare a second interference between such last application and the competing one. (*Wade v. Matthews, 5 Opinions Attorneys General, 224.*)

But the permission to withdraw an application in such a case will be granted or not, as the Commissioner may be satisfied. The matter is in his discretion, to be exercised when in his opinion the spirit of the law demands it. (*Ib., 224.*)

315. INTERFERENCE MAY BE OPENED TO ADMIT NEW PARTIES.—There is nothing in the statute limiting the power of the Commissioner to a single interference, and the reason for the declaration of a subsequent interference, if any should appear before the issue of the patent, is as strong as for the first one. When, therefore, an interference was declared between the application of J G W, assignee of A & F, and a patent previously issued to J M S, in which case, upon appeal to him, the chief justice

declared in favor of J G W, and ordered a patent to issue to him, and after the return of the order, but before the issue of the patent, another interference was declared between the same application and the patent issued to A B W, and the chief justice, upon appeal, held this last interference wrongfully declared, and peremptorily ordered the issue of the patent in pursuance of his first order, which was done, it was held, that the chief justice erred, and that the patent issued in accordance with his last order was without authority and void, and should be enjoined. (*Potter v. Dixon*, 2 *Fish.*, 381.)

After closing the time for taking testimony in an interference the Commissioner may admit another party to the interference and open the further taking of testimony. (*Laidley v. James*, *MS. Appeal Cases*, 1860.)

316. ABANDONMENT IN INTERFERENCE CASES.—In the case of *Rowley v. Mason*, (*MS. Appeal Cases*, *D. C.*, 1869,) Mr. Justice Fisher says: "In this case two issues are presented: one of fact, the other of law. The question of fact is whether Mason or Rowley was really the prior inventor of the device in controversy; and the question of law is whether, supposing Mason to have been the first discoverer in point of fact, he has not forfeited his right to a patent by reason of having slept for years on his invention.

"Upon a careful consideration of all the testimony in the case, I have come to the conclusion, though with much hesitation, that Mason invented the device claimed in this case in the year 1859, and reduced his invention to a fixed, positive, and practical form, and is therefore the first inventor.

"I now proceed to the inquiry whether he has or has

not forfeited his right to a patent as against a subsequent, independent inventor, for there is no question in my mind that Rowley is such.

“Mason perfected his invention in 1859, but failed to file his application until January, 1868, a period of about nine years thus intervening between the time of the perfection of his invention and the making of his application for letters patent.

“In the meantime, to wit, during the year 1866, Rowley, without any knowledge, so far as appears to us, of the invention having been made by Mason, perfects the identical device which Mason had perfected seven years previously, and files his application November 26, 1867. Rowley seems not to have lost any time unnecessarily in making his claim, and undoubtedly would have been entitled to his patent if the device had never been invented by Mason. So, if Mason had not perfected his invention, Rowley would undoubtedly have been entitled to a patent over him. No principle of patent law is better settled than that which was declared by Justice Story in the case of *Woodcock v. Parker*, (1 Story, 590,) wherein he says: ‘In a race of diligence between two independent inventors, he who first reduces his invention to a fixed, positive, and practical form would seem to be entitled to a right to a patent therefor.’ This principle is founded in sound policy. The great object of the patent law is the promotion of the arts and sciences as rapidly as possible, by means of holding out to inventors an exclusive monopoly in their inventions for a limited term, and the principle laid down by Justice Story conforms to the spirit of our patent system. Were it otherwise than he decided, inventors would sleep upon

their inchoate inventions, and put off their reduction to practical form to a more convenient season; the result of which would be, in many instances, the loss of useful inventions and improvements which they had begun and might well have perfected, whilst other inventors would be deterred from expending their money and brain-work in perfecting inventions by the apprehension that some more sluggish genius might step in and anticipate the fruits of their labors at the eleventh hour. The same sound policy seems to me to require that, as between two independent inventors, the one who has perfected his invention, but chooses to sleep upon it for nine years, or even a less period, and is only aroused from his slumbers by the application of a subsequent inventor for his patent, has no right to complain if that application should meet with success. It is also well settled that he who has abandoned an invention, even after it has been perfected, and dedicates it to the public, no matter for what reason, the dedication cannot be recalled. (See *Ransom v. Mayor of New York*, 1 *Fish.*, 252.)

“In the case of *Adams v. Jones*, (1 *Fish.*, 527,) it was decided that a man might justly be treated as having abandoned his application for a patent if, by reason of laches on his part, his application was not prosecuted with reasonable diligence. In *White v. Allen*, (2 *Fish.*, 440,) it was decided that when an invention is voluntarily broken up and laid aside, without any controlling impediment in the way of an application for a patent, and no other in the mean time invents the same thing, without any knowledge of that which is so suspended, and reduces the same to practice, applies for and takes out his patent, and introduces the patented invention to

public use, he must be regarded as the original and first inventor of the improvement.

“These decisions are all founded upon the same sound policy to which I have alluded. It is true that the law looks with indulgence upon delays which arise from the circumstances of parties who may make an invention, but it is equally true that when the invention, although perfected, has been intentionally abandoned or neglected, or the parties show by their acts that they have not done all that they can do, the law declares that they shall not be protected. (See *Sayles v. Chicago and Northwestern Railroad Company*, 2 *Fish.*, 523.)

“In this case I fail to see any reason why Mason could not have prosecuted his claim for a patent as well in 1860 or 1861 as after Rowley had filed his application. He has certainly been guilty of laches in so long sleeping upon his invention, and I can account for his neglect in no other way than upon the ground that he has abandoned it. It would certainly be bad policy if, after the space of nine years from the perfection of an invention, during all which time it was kept a secret in the brain of the inventor, he might come into the Patent Office and defeat the claim of a subsequent and independent inventor, who, honestly believing himself to have been the first discoverer of the improvement, had invested his whole estate in an honest effort to give to the public the benefit of his labors. If one might lie by quietly for nine years, he might do so for forty. Such a rule of law, we may readily see, so far from tending to encourage the promotion of the arts and sciences, would tend greatly to its discouragement, because no man would feel safe against the dishonest practices of the marauder

or pirate, who would not find it difficult to procure, for a reward, witnesses enough to swear up his priority, and fix a period of discovery which the honest inventor would find it hard enough to disprove.

“It is admitted by Mason that if the patent for the device in question, had been obtained by Rowley, his (Mason’s) claim for a patent could not properly have been allowed. But I can see no reason for the distinction between the case when the patent has been obtained by the subsequent and independent inventor, and a case of a pending application of the latter. What is the reason why the obtaining of a patent by a subsequent inventor should operate to prevent the issuing of a patent to the original inventor sleeping for years on his discovery? It certainly cannot be because of the obtaining of the patent *per se*, for a patent may issue to one, and if afterwards application is made by another, who can show himself to be the prior inventor, and not in fault in making his application after the first patent had been issued, the obtaining of the first patent would be no impediment to his obtaining a second. There must be therefore some other reason, and I find that reason sound in policy which dictates that inventors should not be allowed to play the part of the dog in the manger, by putting aside their inventions and keeping them a secret from the world for a long period of years, and only bringing them to light when they have learned that some other inventor has made the identical discovery, and is about to benefit himself and the world by making it public.

“To my mind there can be no stronger evidence of an intention to abandon an invention than breaking it

in pieces or throwing it aside, and thus neglecting it for a period of nine years.

“For these reasons the decision of the Commissioner of Patents is reversed, and it is ordered that a patent be issued to S. B. Rowley for the invention in controversy.”

In the case of *Erbe v. Hill* the Commissioner says: “Hill applied for a patent in April, 1862, and obtained it in the following July. Erbe applied for a patent in October, 1864, more than two years after the issue of the patent to Hill. The issue of letters patent is a public act, of which Erbe was bound to take notice; and therefore, in contemplation of law, he knew of the issue of Hill’s patent, and delayed his application for more than two years afterward. He now proves his own invention to have taken place in December, 1860, but offers no excuse for his protracted delay in applying for a patent.

“If there be such a thing as a race of diligence between two inventors, Erbe has long ago been distanced; if there be such a thing as laches, he has been guilty of it. If these reasons were not fatal to his claim, it is sufficient to say that his case is not distinguishable, on principle, from that of *Rowley v. Mason*, decided by Mr. Justice Fisher in May last, and, upon the authority of that case, his application must be denied.

“The decision of the board of examiners-in-chief is affirmed.” (*Commissioners’ Decisions*, 1869, p. 29.)

The decision of the Commissioner in the case of *Erbe v. Hill* was affirmed by Mr. Justice Fisher. The learned judge says: “Erbe seems to have completed his invention in December, 1860, and then to have slept upon it until 1864, nearly four years. Meanwhile Hill, independ-

ently, perfects the same invention in the early part of the year 1862, and immediately offers it to the public by applying for letters patent, which were granted. More than two years after Hill had taken out his patent Erbe awakes from his slumbers and claims priority of invention. It is too late. It is against the spirit of our patent system, and would be subversive of its policy, if men are allowed to wait for years after others—independent, though subsequent inventors—have taken out letters patent, and then, finding those letters patent to be valuable, to establish priority, after having slept so long with their inventions buried to the world. The cases of *Rowley v. Mason* and *Carlton and Merrill v. Atwood*, lately decided by me, are directly in point.” (*Erbe v. Hill, MS. Appeal Cases, D. C., 1869.*)

It would appear from the decisions of Mr. Justice Fisher, in the cases of *Rowley v. Mason* and *Erbe v. Hill*, above cited, that if an applicant, with no sufficient impediment in the way, delays to apply for two years after a patent for his invention has issued to another, he forfeits his title.

Where there has not been a public use, and there is no proof of abandonment in fact, it should not be presumed against the first applicant on account of mere delay in making an application. (*Woerd v. Bacon, Commissioners' Decisions, 1869, p. 16.*) Affirmed by Mr. Justice Fisher. (*MS. Appeal Cases, D. C., 1869.*)

Three and a half years' delay in applying for a patent, after another person has obtained one for the same invention, cannot be excused by sickness, if the applicant has been attending meanwhile to other business. (*Wheeler v. Chenoweth & Merrill, Commissioners' Decisions, 1869, p.*

43.) Affirmed by Mr. Justice Fisher. (*MS. Appeal Cases, D. C., 1869.*)

An inventor who made a drawing of his invention, but took no further steps for six years, when he filed his application, cannot prevail against his competitor, who had, in the mean time, devised it and obtained a patent. (*Wood v. Crowell, Commissioners' Decisions, 1869, p. 107.*)

In the case of *Merrill v. Atwood*, a lamp burner, embodying the device in controversy, was held to be an abandoned experiment, it having been prepared to test another invention, and after being used several evenings laid aside for years, until the interference was declared. (*Commissioners' Decisions, 1869, p. 6, affirmed, MS. Appeal Cases, D. C., 1869.*)

In the case of *Mason ex parte, MS. Appeal Cases, D. C., 1870*, the following question was submitted: "Whether the proposition in regard to laches of the applicant, John L. Mason, was intended to apply to the case of an *ex parte* application with the same effect as when the rights of an adverse claimant were likely to be affected by such laches?" In deciding this question, Mr. Justice Fisher says: "In reply to the second question, I have to say, that the case before me being that of adverse claimants, the proposition in regard to laches had reference and was intended to apply to such cases only, and not to the case of an *ex parte* application. The view which I entertain on the subject of laches is simply this: that the inventor who conceals his invention, or fails to take the steps necessary to secure his patent therefor, does so at the risk of being postponed in his claim by the coming in of a subsequent independent inventor, who is diligent in giving the world the benefit of his invention, just as he

takes the risks of losing the benefits of his invention by consenting to or allowing its public sale or use for the time fixed in the act of Congress as a bar against him. If he conceals his invention for any length of time, no matter how long, and it does not get into public use or on sale for more than two years by his consent or allowance, and it is not subsequently invented by another, who applies before him, and there is reasonable grounds to believe that he did not abandon it, I do not suppose that lapse of time *per se* would be cause for refusing his application for a patent."

317. CLASSES INTO WHICH CASES OF INTERFERENCE MAY BE DIVIDED.—Cases of interference may be naturally divided into two leading classes. The first comprises those in which the applicants are both original and independent inventors, and the only question left for decision is, which was the *first* inventor? The parties, in this class of cases, may be, and usually are, widely separated; they have no connection whatever with each other. The coincidence of invention is accidental, or rather results from the fact that the new improvement is one which is demanded by the state of arts, and one which many men are seeking, at the same time, to discover or develop.

The question of priority in such cases is usually one of easy solution. It is to be determined by ascertaining which of the parties first reduced the invention to a practicable form, either by a drawing, sufficient of itself to enable an artisan to make the thing invented, or by a sketch, accompanied by written description, or by model, or full-sized machine. In such cases, mere conversations, as proof of invention, however explicit in detail, should not be accepted, unless such conversations consisted of

directions to workmen to enable them to construct a machine which was actually built at the time and from such directions.

The second class of interference comprises those cases in which two men have been more or less connected in the work of invention; where the relation of partner, or employer and employee, or friend or fellow-workman, has, in some form, existed; where the invention, if it be the act of both, takes place at or about the same time; and where the real question is not so much one of priority, but of originality; where, in short, it is charged or inferred that one of the parties is claiming that which he has stolen from the other. This class may be again subdivided into three: First, where the parties are fellow-townsmen or workmen, or so situated that either might have known of the movements of the other; second, where one party is in the general employment of the other, and in the course of his work has hit upon some improvement in the tools or processes with which he works; third, where the one has been specially employed by the other to assist in developing or embodying the very invention in controversy. The cases which fall within the second class are by far the most difficult. The testimony is usually contradictory, and the parties, surrounded by a troop of partisans, clerks, or workmen, appear, and, like the seamen of opposing vessels in a collision case, swear directly in each other's faces. Each is at pains to deny every fact, material and immaterial, asserted by the other, until the judge is compelled to grope painfully through a mass of contradictory evidence to find some fact, as a basis for a decision, which has escaped the fury of the conflict. There may be some presumptions which

will render it possible to approximate to the truth. It may be said, in general, that in cases falling under the first subdivision, the evidence necessary to establish priority should be substantially the same as in cases of the first class, to wit, that he is the first inventor who has first reduced the invention to practice. As to the second and third subdivisions, it may be safely asserted that the presumption is that the workman is the inventor in the former case, and that the employer is in the latter.

When workmen are employed in large establishments, it is a natural and common mistake for employers to suppose that they are entitled to the brain-work as well as the hand-work of their employees; that if a valuable invention is made, as in some measure it is the product of their capital and of the mind of their servant, they have acquired such a title to it as to be able to consider themselves the inventors. This is especially the case when the employer has conversed with the workmen during the progress of the work, or has exhibited any interest in its successful completion. They confound the supply of material with the supply of ideas, and sometimes confidently claim to be the inventors of mechanism which they would find it difficult to describe and impossible to operate.

But where a man has conceived an idea and given to it more or less development, and employs a mere workman to put it into shape, it is obvious that much confusion is likely to follow, proportioned to the mechanical skill of the workman and the lack of it in the projector. So many suggestions and hints may be furnished by the workman, that at last he ceases to remember the parentage of the underlying idea, and fancies that the whole

machine is the product of his own invention. It must be rare, however, in such cases, that the labors of the mechanic or model-maker can raise him to a higher rank than that of joint inventor with him who has the original conception, while, in the great majority of cases, the safer rule is undoubtedly that adopted by the Supreme Court of the United States in the late case of *Agawam Woolen Company v. Jordan*, (7 Wall., 583,) where it is said: "When a person has discovered an improved principle in a machine, manufacture, or composition of matter, and employs other persons to assist him in carrying out that principle, and they, in the course of experiments arising from that employment, make valuable discoveries ancillary to the plan and preconceived design of the employer, such suggested improvements are, in general, to be regarded as the property of the party who discovered the original improved principle, and may be embodied in his patent as a part of his invention." (*Foster v. Fowle, Commissioners' Decisions*, 1869, p. 35.)

XIX. Affidavits and Depositions.

SEC.	SEC.
318. Commissioner may establish rules.	327. Notice of objection.
319. Before whom taken.	328. Force and effect of rules.
320. Clerk to issue subpoena.	329. Service of notice for taking testimony.
321. Penalty for refusing to appear and testify.	330. Object and requisites of notice.
322. Rules of the Patent Office.	331. How testimony is to be taken.
323. Notice.	332. Magistrate's certificate.
324. Certified copy of caveat.	333. Formal objections.
325. Evidence to be sealed, &c.	334. Access to testimony; copies.
326. Ex parte testimony.	335. Cannot be taken before interested parties.

<p>Sec. 336. Testimony received by agreement of parties. 337. Testimony taken on former interference. 338. Assignment of time.</p>	<p>Sec. 339. Postponement. 340. Form of notice of taking testimony. 341. Form of deposition. 342. Form of certificate.</p>
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318. COMMISSIONER MAY ESTABLISH RULES FOR TAKING AFFIDAVITS AND DEPOSITIONS.—The Commissioner may establish rules for taking affidavits and depositions. (*Act of July 8, 1870, § 43.*)

319. BEFORE WHOM TAKEN.—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. (*Ib.*)

As to what officers are authorized to administer oaths *vide supra*, p. 318.

320. CLERK TO ISSUE SUBPENA.—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 his agent or attorney, issue subpoena for any witness residing or being within said district or Territory, commanding him to appear and testify before any officer in said district or Territory, authorized to take depositions and affidavits, at any time and place in the subpoena stated. (*Ib.*, § 44.)

321. PENALTY FOR REFUSING TO APPEAR AND TESTIFY. If any witness, after being duly served with such subpoena, shall neglect or refuse to appear, or, after appearing, shall refuse 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. (*Ib.*)

A person who, after being regularly served with a subpoena, refuses or neglects to attend the trial, may be proceeded against by attachment. It is presumed also that an action on the case may be maintained against him; but before an attachment will be granted it must appear that the subpoena was personally served upon him a reasonable time before the trial, and that the fees allowed by law were paid or tendered to him.

In the courts of the United States witnesses are entitled to the sum of one dollar and fifty cents for each day's attendance at the court, to the further sum of five cents per mile for traveling from their place of abode to the place where the court is holden, and to the like allowance for returning. (*Act of February 26, 1853, c. 80.*) The sum, therefore, which it is necessary to tender upon serving a subpoena is one dollar and fifty cents for one day's attendance, and ten cents for each mile of distance between the residence of the witness and the place where the court is to be held. (*Conklin's Treatise, 386.*)

322. RULES OF THE PATENT OFFICE FOR TAKING AND TRANSMITTING EVIDENCE.—In interference, extension, and other contested cases the following rules have been established for taking and transmitting evidence:

323. NOTICE.—First. That, before the deposition of a witness or witnesses be taken by either party, due notice shall be given to the opposite party, as hereinafter provided, of the time and place when and where such deposition or depositions will be taken, with the names and residences of the witness or witnesses then and there to be examined, so that the opposite party, either in person

or by attorney, shall have full opportunity to cross-examine the witness or witnesses: *Provided*, That if the opposite party or his counsel be actually present at the taking of testimony, witnesses not named in the notice may be examined, but not otherwise. And such notice shall, *with proof of service of the same*, be attached to the deposition or depositions, whether the party cross-examine or not; and such notice shall be given in sufficient time for the appearance of the opposite party.

324. CERTIFIED COPY OF CAVEAT.—Second. That, whenever a party relies upon a caveat to establish the date of his invention, a certified copy thereof must be filed in evidence, with due notice to the opposite party, as no notice can be taken by the office of a caveat filed in its secret archives.

325. EVIDENCE TO BE SEALED, &c.—Third. That all evidence, &c., shall be sealed up, entitled upon the envelope with the name of the case in which it is taken, and addressed to the Commissioner of Patents by the person before whom it shall be taken, and so certified thereon, and forwarded, *immediately upon the close of the examination*, to the Patent Office.

326. EX PARTE TESTIMONY.—Fourth. In cases of extension, where no opposition is made, *ex parte* testimony will be received from the applicant; and such testimony as may have been taken by the applicant prior to notice of opposition shall be received, unless taken within thirty days after filing the petition for the extension; *Provided*, That immediately upon receiving notice of opposition the applicant shall give notice to the opposing party or parties of the names and residences of the witnesses whose testimony has thus been taken.

327. NOTICE OF OBJECTION.—Fifth. That no evidence touching the matter at issue will be *considered* upon the day of hearing which shall not have been taken and filed in compliance with these rules: *Provided*, Notice of the objection has been given, as hereinafter prescribed, (*vide infra*, § 314:) *Provided also*, That if either party shall be unable, for good and sufficient reasons, to procure the testimony of a witness or witnesses within the stipulated time, it shall be the duty of said party to give notice of the same to the Commissioner of Patents, accompanied by statements, *under oath*, of the cause of such inability, and of the names of such witnesses, and of the facts expected to be proved by them, and of the *steps* which have been taken to procure said testimony, and of *the time or times* when efforts have been made to procure it; which last-mentioned notice to the Commissioner shall be received by him previous to the day of hearing aforesaid. (*Patent Office Rules, July, 1870.*)

328. FORCE AND EFFECT OF PATENT OFFICE RULES. The rules and regulations of the Patent Office, as to taking testimony in cases of interference, are binding upon the parties, and each is entitled to the benefits of them, and, until abrogated, they are as binding upon the Commissioner himself as if enacted by the statute itself. (*O'Hara v. Haws, MS. Appeal Cases, D. C., 1859.*)

The power granted to the Patent Office to make rules in respect to the taking of evidence gives no new right to make new rules of evidence, or to make new rules of law, or to divest vested rights by its rules of practice. (*Dyson ex parte, ib., 1860.*)

Evidence taken under the rules established by the Commissioner of Patents, under the statute, must not

only be taken agreeably to these rules, but must be evidence competent in law. (*Arnold v. Bishop, ib., 1841.*)

The rules referred to do not prohibit the Commissioner from looking into the deposition informally transmitted, or reading it and ascertaining its contents; but only prohibit him from considering it as evidence touching the matter in issue. (*Smith v. Flickenger, ib., 1843.*)

The rules of the Patent Office as to the taking of testimony are to be just and reasonable, according to the established principles and precedents in like cases. (*Nichols v. Harris, ib., 1854.*)

329. SERVICE OF NOTICE FOR TAKING TESTIMONY.—The notice for taking testimony must be served by delivering a copy to the adverse party, or his agent or attorney of record or counsel, or by leaving a copy at the party's usual place of residence, with some member of the family who has arrived at the years of discretion. The notice must be annexed to the deposition, with a certificate, duly sworn to, stating the manner and time in which the service was made. (*Patent Office Rules, July, 1870.*)

Service of notice to take testimony may be made upon applicant, upon the opponent, upon the attorney of record of either, or, if there be no attorney of record, upon any attorney or agent who takes part in the service of notice or the examination of the witnesses of either party. Where notice to take testimony has already been given to an opponent, and a new opponent subsequently gives notice of his intention to oppose, the examination need not be postponed, but notice thereof may be given to such subsequent opponent by mail or by telegraph. This rule, however, does not apply to *ex parte* examina-

tions, or those of which no notice has been given when notice of opposition is served. (*Ib.*)

330. OBJECT AND REQUISITES OF NOTICE.—The object of notice is to bring the adverse party before the examining officer. Where the party attends before such officer, such notice is mere form and technicality. (*Vide infra*, § 333; *Walker v. Forbes*, *MS. Appeal Cases*, *D. C.*, 1861.)

Where no notice of the taking of depositions has been given to the opposite party, but such opposite party or his counsel are present when they are taken, such depositions will not be excluded because of want of notice, and particularly if taken by consent of parties. (*Ib.*)

Depositions, to be used in a matter of interference before the Commissioner of Patents, taken without notice to the opposing party, cannot be used against him, unless he has waived his right to notice, and agreed to admit them to be read in evidence. (*Perry v. Cornell*, *ib.*, 1847.)

A notice of taking deposition at a place four hundred miles distant, served eleven days before the time for taking such depositions, is sufficient. (*Smith v. Flickenger*, *ib.*, 1843.)

331. HOW TESTIMONY IS TO BE TAKEN; SIGNATURE. The testimony must, if either party desires it, be taken in answer to interrogatories, having the questions and answers committed to writing in their regular order by the magistrate, or, under his direction, by some person not interested in the issue, nor an agent or attorney of one who is. The deposition, when complete, must be signed by the witness. (*Patent Office Rules*, *July*, 1870.)

332. MAGISTRATE'S CERTIFICATE.—The magistrate must append to the deposition his certificate, stating the time and place at which it was taken, the names of the wit-

nesses, (if any,) the administration of the oath, at whose request the testimony was taken, the occasion upon which it was intended to be used, the names of the adverse parties, and whether they were present. (*Ib.*) If the magistrate before whom a deposition is taken fails to certify thereon that it was sealed up by him, it is sufficient ground for excluding such deposition from the consideration of the Commissioner. (*Arnold v. Bishop, MS. Appeal Cases, D. C., 1841.*)

333. FORMAL OR TECHNICAL OBJECTION.—No notice will be taken, at the hearing, of any merely formal or technical objection, unless it shall appear to have wrought a substantial injury to the party raising the objection; and even then, as soon as the party becomes aware of the objection, he must immediately give notice thereof to the office, and also to the opposite party, informing him at the same time that, unless corrected, he shall urge his objection at the hearing. (*Patent Office Rules, July, 1870.*)

334. ACCESS TO TESTIMONY; COPIES.—In contested cases, whether of interference or of extension, parties may have access to the testimony on file prior to the hearing, in presence of the officer in charge; and copies may be obtained by them at the usual rates. (*Ib.*)

335. DEPOSITION CANNOT BE TAKEN BEFORE INTERESTED PARTIES.—Deposition cannot be taken before a magistrate or person who is the attorney or of counsel for either party, or interested in the event of the action. (*Nichols v. Harris, MS. Appeal Cases, D. C., 1854.*)

The officer before whom testimony is taken should stand indifferent between the parties, in no such relation to either of them as to bias him in favor of one more than

the other; more especially he should not be interested in the question at issue. (*Collins v. White, ib.*, 1860.)

336. TESTIMONY RECEIVED BY AGREEMENT OF PARTIES. By agreement of parties, the testimony of witnesses, otherwise incompetent, may be received and considered. (*Warner v. Goodyear, ib.*, 1846.)

337. TESTIMONY TAKEN ON A FORMER INTERFERENCE IS ADMISSIBLE ON A SECOND ONE, and may be used without being retaken, although the second interference is declared after an assignment to another party, (*Eams v. Richards, ib.*, December, 1859,) or after application is made by another party, and he is made a party to the interference. (*Carter v. Carter, ib.*, 1855.)

In the case of *Crowell v. Sim*, the Commissioner says: "A preliminary question is made as to an agreement between the parties relating to the introduction of testimony taken in a former interference. The agreement is, that the testimony may be read by the examiner in the present case. Counsel for Crowell claims that this meant nothing more than that the examiner might read the testimony, but that it was not to be treated as evidence; and they further assert that this was fully understood by the parties. Counsel for Sim deny this understanding, and claim that the agreement meant and means, that the examiner should read the former testimony as evidence in this case. As the parties cannot agree as to their verbal statements, I can only construe the paper according to its terms. My opinion is, that 'reading' the testimony can only mean reading it in evidence. Any other construction would render it practically without meaning, and Sim has so far relied upon his own understanding of it as to take no other testimony." (*Commissioners' Decisions, July 26, 1870.*)

338. ASSIGNMENT OF TIME IN INTERFERENCE CASES.—
 In cases of interference the party who first filed so much of his application for a patent as illustrates his invention will be deemed the first inventor in the absence of all proof to the contrary. A time will be assigned in which the other party shall complete his direct testimony; and a further time in which the adverse party shall complete the testimony on his side; and a still further time in which both parties may take rebutting testimony, but shall take no other. If there are more than two parties, the times for taking testimony shall be so arranged, if practicable, that each shall have a like opportunity in his turn, each being held to go forward and prove his case against those who filed their applications before him. (*Patent Office Rules, July, 1870.*)

339. POSTPONEMENT.—If either party wishes the time for taking his testimony, or for the hearing, postponed, he must make application for such postponement, and must show sufficient reason for it by affidavit filed before the time previously appointed has elapsed, if practicable, and must also furnish his opponent with copies of his affidavits and with reasonable notice of the time of hearing his application. (*Ib.*)

340. FORM OF NOTICE OF TAKING TESTIMONY.—

BOSTON, MASS., *March 29, 1869.*

In the matter of the interference between the application of Lyman Osgood for a paper collar machine and the patent No. 85,038, granted December 15, 1868, to Charles Comstock, now pending before the Commissioner of Patents.

SIR: You are hereby notified that on Wednesday, March 31, 1869, at the office of Sextus Tarquin, esq., No. 30 Court street, Boston, Massachusetts, at 9 o'clock in the forenoon, I shall proceed to take the testimony of Truman Truthful, Peter Pivot, and Welcome Story, all of Boston, as witnesses in my behalf.

The examination will continue from day to day until completed. You are invited to attend and cross-examine.

LYMAN OSGOOD,
By PETER PROCTOR, *his Attorney.*

CHARLES COMSTOCK,
Providence, R. I.

Proof of service.

Service of the above notice acknowledged.

CHARLES COMSTOCK,
By CHARLES CAVIL, *his Attorney.*

PROVIDENCE, R. I., March 30, 1869.

341. FORM OF DEPOSITION.—

Before the Commissioner of Patents, in the matter of the interference between the application of Lyman Osgood for a paper collar machine and the letters patent No. 85,038, granted December 15, 1868, to Charles Comstock.

Depositions of witnesses examined on behalf of Lyman Osgood, pursuant to the annexed notice, at the office of Sextus Tarquin, No. 30 Court street, Boston, Massachusetts, on Wednesday, March 31, 1869. Present, Peter Proctor, esq., on behalf of Lyman Osgood, and Charles Cavil, esq., on behalf of Charles Comstock.

Truman Truthful, being duly sworn, (or affirmed,) doth depose and say, in answer to interrogatories proposed to him by Peter Proctor, esq., counsel for Lyman Osgood, as follows, to wit:

Question 1. What is your name, age, residence, and occupation?

Answer 1. My name is Truman Truthful; I am forty-three years of age; I am a manufacturer of paper collars, and reside in Chelsea, Massachusetts.

Question 2, &c. * * *

And in answer to cross-interrogatories proposed to him by Charles Cavil, esq., counsel for Charles Comstock, he saith:

Cross-question 1. How long have you known Lyman Osgood?

Answer 1. * * * *

TRUMAN TRUTHFUL.

342. FORM OF CERTIFICATE OF OFFICER.—

COMMONWEALTH OF MASSACHUSETTS, } ss.
County of Suffolk.

At Boston, in said county, on the 26th day of April, A. D. 1869, before me personally appeared the above-named Truman Truthful, and made

oath that the foregoing deposition by him subscribed contains the truth, the whole truth, and nothing but the truth. The said deposition is taken at the request of Lyman Osgood, to be used upon the hearing of an interference between the claims of the said Lyman Osgood and those of Charles Comstock, before the Commissioner of Patents, on the 3d day of May, A. D. 1869.

The said Charles Comstock was duly notified, as appears by the original notice hereto annexed, and attended by Charles Cavil, esq., his counsel.

SEXTUS TARQUIN,
Justice of the Peace.

The magistrate shall seal up the testimony, and write upon the envelope a short certificate, substantially in the following form, viz:

I hereby certify that the within depositions of Truman Truthful and Peter Pivot; relating to the matter of interference between Lyman Osgood and Charles Comstock, were taken, sealed up, and addressed to the Commissioner of Patents by me this 26th day of April, A. D. 1869.

SEXTUS TARQUIN,
Justice of the Peace.

XX. Evidence.

SEC.	SEC.
343. Presumption.	351. Evidence of novelty and utility.
344. Declaration and acts of parties.	352. Examples of novelty and want of novelty.
345. Declaration &c., third parties.	353. Examination of parties.
346. Parol and secondary evidence.	354. Parties in interference cases may testify.
347. Patent Office records.	355. Competency of witnesses.
348. Evidence of abandonment.	356. Experts.
349. Evidence of priority.	
350. Evidence of prior use.	

343. PRESUMPTION.—The general head of presumptive evidence is usually divided into two branches, namely, presumptions of law and presumptions of fact. Presumptions of law consist of those rules which, in certain cases, either forbid or dispense with any ulterior inquiry. They are founded either upon the first princi-

ples of justice, or the laws of nature, or the experienced course of human conduct and affairs, and the connection usually found to exist between certain things. The general doctrines of presumptive evidence are not therefore peculiar to municipal law, but are shared by it in common with other departments of science. Thus, the presumption of a malicious attempt to kill from the deliberate use of a deadly weapon, and the presumption of aquatic habits in an animal found with webbed feet, belong to the same philosophy, differing only in the instance, and not in the principle, of its application. The one fact being proved or ascertained, the other, its uniform concomitant, is universally and safely presumed. It is this uniformly experienced connection which leads to its recognition by the law without other proof; the presumption, however, having more or less force in proportion to the universality of the experience. And this has led to the distribution of presumptions of law into two classes, namely, conclusive and disputable. (*Greenleaf on Evidence*, p. 21.)

Conclusive, or, as they are elsewhere termed, imperative or absolute, presumptions of law, are rules determining the quantity of evidence requisite for the support of any particular averment, which is not permitted to be overcome by any proof that the fact is otherwise. They consist chiefly of those cases in which the long-experienced connection before alluded to has been found so general and uniform, as to render it expedient for the common good that this connection should be taken to be inseparable and universal. They have been adopted by common consent, from motives of public policy, for the sake of greater certainty, and the promotion of peace

and quiet in the community; and therefore it is that all corroborating evidence is dispensed with, and all opposing evidence is forbidden. (*Ib.*)

The second class of presumptions of law, answering to the *præsumptiones juris* of the Roman law, which may always be overcome by opposing proof, consists of those termed disputable presumptions. These, as well as the former, are the result of the general experience of a connection between certain facts or things, the one being usually found to be the companion or the effect of the other. The connection, however, in this class, is not so intimate or so universal as to render it expedient that it should be absolutely and imperatively presumed to exist in every case, all evidence to the contrary being rejected; but yet it is so general, and so nearly universal, that the law itself, without the aid of a jury, infers the one fact from the proved existence of the other, in the absence of all opposing evidence. In this mode the law defines the nature and amount of the evidence which it deems sufficient to establish a *prima facie* case, and to throw the burden of proof on the other party; and if no opposing evidence is offered, the jury are bound to find in favor of the presumption. A contrary verdict would be liable to be set aside, as being against evidence. (*Ib.*, p. 38.)

Presumptions of fact, usually treated as composing the second general head of presumptive evidence, can hardly be said, with propriety, to belong to this branch of the law. They are, in truth, but mere arguments, of which the major premise is not a rule of law; they belong equally to any and every subject-matter; and are to be judged by the common and received tests of the truth

of propositions and the validity of arguments. They depend upon their own natural force and efficacy in generating belief or conviction in the mind, as derived from those connections which are shown by experience, irrespective of any legal relations. They differ from presumptions of law in this essential respect, that while those are reduced to fixed rules, and constitute a branch of the particular system of jurisprudence to which they belong, these merely natural presumptions are derived wholly and directly from the circumstances of the particular case, by means of the common experience of mankind, without the aid or control of any rules of law whatever. Such, for example, is the inference of guilt drawn from the discovery of a broken knife in the pocket of a prisoner, the other part of the blade being found sticking in the window of a house which, by means of such an instrument, had been burglariously entered. These presumptions remain the same in their nature and operation, under whatever code the legal effect or quality of the facts, when found, is to be decided. (*Ib.*, p. 49.)

It is a presumption of law, that when a patent has been obtained, and the specification and drawing recorded in the Patent Office, every man who subsequently takes out a patent for a similar machine has a knowledge of the preceding patent. As in chancery it is a maxim that every man is presumed to have notice of any fact upon which he is put upon inquiry by documents within his possession, if such facts could, by ordinary diligence, be discovered upon such inquiry. It is also a presumption of fact that every man, having within his power the exact means of information, and desirous of securing to himself the benefit of a patent, will ascertain, for his own

interest, whether any one on the public records has acquired a prior right. (*Odiorne v. Winkley*, 2 Gall., 55.)

All persons are bound to take knowledge of the doings of the Patent Office in relation to inventions. (*Marcy v. Trotter*, MS. Appeal Cases, D. C., 1860.)

In the case of the *Philadelphia and Trenton Railroad Company v. Stimson*, (14 Peters, 458,) Mr. Justice Story said: "It is a presumption of law that all public officers perform their proper official duties until the contrary is proved. And where, as in the present case, an act is to be done, or patent granted upon evidence and proofs to be laid before a public officer, upon which he is to decide, the fact that he has done the act or granted the patent is *prima facie* evidence that the proofs have been regularly made, and were satisfactory. No other tribunal is at liberty to reëxamine or controvert the sufficiency of such proofs, if laid before him, when the law has made such officer the proper judge of their sufficiency and competency. It is not, then, necessary for the patent to contain any recitals that the prerequisites to the grant of it have been duly complied with, for the law makes the presumption; and if, indeed, it were otherwise, the recitals would not help the case, without the auxiliary proof that these prerequisites had been, *de facto*, complied with. This has been the uniform construction, as far as we know, in all our courts of justice upon matters of this sort. Patents for lands, equally with patents for inventions, have been deemed *prima facie* evidence that they were regularly granted, whenever they have been produced under the great seal of the government, without any recitals or proofs that the prerequisites of the acts under which they have been issued have been duly

observed. In cases of patents, the courts of the United States have gone one step further, and as the patentee is required to make oath that he is the true inventor before he can obtain a patent, the patent has been deemed *prima facie* evidence that he has made the invention."

It is a presumption of law that the patentee is the first inventor of the thing patented by him, and the burden of proof is on the party denying it to disprove the fact. (*Pitts v. Hall*, 2 *Blatchf.*, 231,) and the burden of proof that a combination is not new is on the party denying that it is not new. (*Hovey v. Henry*, 3 *West. Law Jour.*, 154.)

The legal presumption is, from the action of the Patent Office, that a reissued patent is for the same invention as the original patent. (*Hussey v. McCormick*, 1 *Fish.*, 509.) The law requiring that an inventor should describe his invention with accuracy and fullness, and it being the duty of the Commissioner of Patents to see that this is done, the presumption is that the patent has been issued upon sufficient foundation. (*Judson v. Cope*, 1 *Fish.*, 615.)

A reissued patent is *prima facie* evidence that the original patent was lawfully surrendered and the new one was lawfully granted, (*Knight v. Baltimore and Ohio Railroad*, 3 *Fish.*, 1;) and, unless fraud upon the Patent Office is proved, (and it must be proved, never inferred,) it is *prima facie* evidence that there has been no abandonment of the invention to the public; and the burden of proof is on the defendant to show that any surrender to the public has taken place. (*Hoffheim v. Brandt*, 3 *Fish.*, 218.) The reissue furnishes *prima facie* evidence that everything necessary to justify the Commissioner in granting the reissue has been produced before the grant

was made, (*ib.*;) and, as the law now stands, the decision of the Commissioner is final and conclusive in cases of reissue, unless impeached for fraud in his or the patentee's acts, or for some irregularity on the face of the papers, or a clear repugnance between the original and reissued patents. (*Blake v. Stafford*, 3 *Fish.*, 294.)

However, it is in accordance with the late decisions of the courts, that the decision of the Commissioner is not conclusive upon the substantial identity of the invention claimed in the original." (3 *Fish.*, 439; *vide supra*, p. 570.)

The patent itself is *prima facie* evidence that it was lawfully issued, and that the party who claims it is the original inventor; and, if it be assailed, the proof must come from the party calling the validity in question, (*Hoffheim v. Brandt*, 3 *Fish.*, 218,) and the original presumptions of novelty and utility arising from the grant of a patent are strengthened by the extension. (*Whitney v. Mowry*, 3 *Fish.*, 157.)

It is a presumption of law that what the patentee does not distinctly assert to be his invention was known before. (*Smith v. Higgins*, 1 *Fish.*, 587.) It is to be presumed that persons obtaining patents have acquainted themselves with the state of the art in which they are interested, as made known in books or by machines built and put in use, and evidence is not admissible to prove the contrary. (*Ib.*)

The recital in a reissue of a prior assignment, and the action of the Commissioner in granting the patent, make a *prima facie* case of title. (*Middletown Tool Company v. Judd*, 3 *Fish.*, 141.)

The constructor of a machine is presumed to be the

inventor, and the burden of proof is on him who denies the fact, and claims to be the inventor, (*Atkinson v. Boardman, MS. Appeal Cases, D. C., 1847;*) but the claim of a draughtsman to an invention which he is employed to put in shape is to be viewed with suspicion, (*Doughty v. Clark, Commissioners' Decisions, 1869, p. 14,*) and where an invention is reduced to practice by an operative employed to labor upon it, the presumption is that his employer is the inventor; but, on the other hand, he is presumed to be the inventor if he is laboring under a general employment. (*Foster & Townsend v. Fowle, 35.*)

A patent is *prima facie* evidence that the grant of right in it is valid, that the things described in it are new and useful, that they required invention, and that they were the invention of the patentee; and such *prima facie* evidence must have full effect, unless rebutted by sufficient countervailing evidence, (*Potter v. Holland, 1 Fish., 327;*) but the *prima facie* force of a patent, as to priority of invention on the part of the patentee, when once destroyed by evidence of prior invention on the part of another, cannot be restored by the patent itself, but only by specific testimony from witnesses. (*Barstow v. Swan, MS. Appeal Cases, 1860.*)

Under the act of 1790 a patent was made *prima facie* evidence. That act was repealed by the act of 1793, and that provision was not re-enacted in it; hence a patent was not received in courts of justice as even *prima facie* evidence that the invention patented was new or useful; but the plaintiff was bound to prove these facts to make out his case. But the act of 1836 introduced a new system, and under it—its inquisition and examination—a patent is received as *prima facie* evidence of the truth of

the facts asserted in it. (*Corning v. Burden*, 15 How., 270.)

344. DECLARATION AND ACTS OF THE PARTIES.—The declarations of a party, at a given time, that he had invented a machine afterward patented, and which he then described, may be received in evidence; but they are not proof that he was the inventor, but only that he said he was, (*Evans v. Hetick*, 3 Wash., 410;) and in cases of interfering applications, the declaration of the parties themselves in their own favor, in the absence of each other, are not competent evidence for any purpose, but to ascertain when and what they respectively claimed to have invented. (*Atkinson v. Boardman*, MS. Appeal Cases, D. C., 1847.)

In the case of the *Philadelphia and Trenton Railroad Company v. Stimson*, (14 Pet., 462,) Mr. Justice Story, in delivering the opinion of the court, said: "The objection is, that, upon general principles, the declarations and conversations of a plaintiff are not admissible evidence in favor of his own rights. As a general rule, this is undoubtedly true. It is, however, but a general rule, and admits and requires various exceptions. There are many cases in which a party may show his declarations conflict with acts in his own favor as a part of the *res gestæ*. There are other cases again in which his material declarations have been admitted. Thus, for example, in the case of an action for an assault and battery and wounding, it has been held, that the declarations of the plaintiff as to his internal pains, aches, injuries, and symptoms, to the physician called to prescribe for him, are admissible for the purpose of showing the nature and extent of the injuries done to him.

(See 1 *Phillips on Evidence*, c. 12, § 1, p. 200-202, 8th ed., 1838.) In many cases of inventions, it is hardly possible in any other manner to ascertain the precise time and exact origin of the particular invention. The invention itself is an intellectual process or operation; and, like all other expressions of thought, can in many cases scarcely be known except by speech. The invention may be consummated and perfect, and may be susceptible of complete description in words, a month or even a year before it can be embodied in any visible form, machine, or composition of matter. It might take a year to construct a steamboat, after the inventor had completely mastered all the details of his invention, and had fully explained them to all the various artisans whom he might employ to construct the different parts of the machinery. And yet from those very details and explanations another ingenious mechanic might be able to construct the whole apparatus, and assume to himself the priority of the invention. The conversations and declarations of a patentee, merely affirming that at some former period he invented that particular machine, might well be objected to. But his conversations and declarations, stating that he had made an invention, and describing its details and explaining its operations, are properly to be deemed an assertion of his right, at that time, as an inventor, to the extent of the facts and details which he then makes known, although not of their existence at an antecedent time. In short, such conversations and declarations, coupled with a description of the nature and objects of the invention, are to be deemed a part of the *res gestæ*, and legitimate evidence that the invention was then known to and claimed by him, and

thus its origin may be fixed at least as early as that period."

Although the mere declaration of an inventor, that at a certain time he made the invention, is not evidence. (*Cochrane v. Waterman*, MS. Appeal Cases, D. C., 1844.) Yet the declarations of a party, describing, at a particular time, an alleged invention, are admissible to show what he knew or had invented at the time such declarations were made, provided they were made before a dispute or contest had arisen. (*Yearsly v. Brookfield*, *ib.*, 1853.) But the conversation and declaration of a party as to an invention are evidence of his right at the time only to the extent of the fact and details which he then describes and makes known. (*Garrett v. Davidson*, *ib.*, 1857.)

The correspondence between the office and a patentee is evidence, at least in a court of equity, for the purpose of showing the limitation placed by the patentee upon his claims. (*Pike v. Potter*, 3 *Fish.*, 55.) And the letters of a party to the Commissioner of Patents, applying for a patent for his invention, are admissible as evidence as to the fact of his being the inventor. (*Pettibone v. Derringer*, 4 *Wash.*, 219.)

Admissions or declarations as to an invention, made in a way of compromise and without the admission of any particular facts, are not admissible as evidence; but if made voluntarily, without any pending negotiation, it would seem they are admissible. (*Gibbs v. Johnson*, MS. Appeal Cases, D. C., 1860.)

The fact that a party is a witness to the application of another for a patent for a particular invention does not estop such party from afterwards claiming to be the orig-

inal inventor of such invention, and he may show that he was deceived as to the character of the invention he was witnessing. (*Herring v. Leffingwell, ib.*, 1861.)

Where a party had disclaimed those parts of his invention which were found in another patent, it was held that this was an admission of the validity of such patent. (*Waterbury Brass Company v. New York and Brooklyn Brass Company, 3 Fish.*, 43.)

It seems that evidence as to the declaration of an inventor, which referred to a specimen or model of his invention, cannot be received without the production of such model or without its non-production being accounted for, (*Richardson v. Hicks, MS. Appeal Cases, D. C.*, 1854,) and an exhibit cannot be introduced in evidence for the purpose of showing that it is like the original model, unless the non-production of the original is accounted for. (*Ib.*)

345. DECLARATIONS AND ACTS OF THIRD PARTIES.—Where a witness was asked by counsel to state what third parties had said concerning an invention, the court decided that the question was improper. The person from whom the witness received the information on the subject ought to have been called on to give it in the usual way, and that the question was an attempt to introduce mere hearsay evidence of what others told the witness. (*Evans v. Hettick, 3 Wash.*, 414.)

The declarations of a person as an agent, in relation to the business intrusted to him, and made at the time so intrusted, are competent concerning it, as a part of the *res gestæ*, if they relate to the act clearly. (*Aiken v. Bemis, 3 Wood. & Minot*, 350.)

The declarations of an assignor of a patent, after he has

parted with his interest, are inadmissible, either to show a want of title in him or to affect the quality of the article, or impair the rights of the purchaser. (*Many v. Jagger*, 1 *Blatchf.*, 376.) And the declarations of a patentee who had parted with all his interest is only hearsay evidence. (*Wilson v. Simpson*, 9 *How.*, 121, 122.)

The declarations of a third party in an interference, that he was a part inventor, are admissible to show that neither of the applicants is entitled to a patent. (*Yeorsly v. Brookfield*, *MS. Appeal Cases*, *D. C.*, 1853.)

346. PAROL AND SECONDARY EVIDENCE.—Primary evidence is that kind of proof which, under any possible circumstances, affords the greatest certainty of the fact in question, and it is illustrated by the case of a written document; the instrument itself being always regarded as the primary or best possible evidence of its existence and contents. If the execution of an instrument is to be proved, the primary evidence is the testimony of the subscribing witness, if there be one. Until it is shown that the production of the primary evidence is out of the party's power, no other proof of the fact is in general admitted. All evidence falling short of this in its degree is termed secondary. The question whether evidence is primary or secondary has reference to the nature of the case in the abstract, and not to the peculiar circumstances under which the party in the particular cause on trial may be placed. It is a distinction of law, and not of fact; referring only to the quality, and not to the strength of the proof. Evidence which carries on its face no indication that better remains behind is not secondary, but primary. And though all information must be traced to its source, if possible, yet if there are several

distinct sources of information of the same fact, it is not ordinarily necessary to show that they have all been exhausted before secondary evidence can be resorted to. (*Greenleaf on Evidence*, p. 99.)

The cases which most frequently call for the application of the rule now under consideration are those which relate to the substitution of oral for written evidence, and they may be arranged into three classes: including in the first class those instruments which the law requires should be in writing; in the second, those contracts which the parties have put in writing; and in the third, all other writings the existence of which is disputed, and which are material to the issue. (*Ib.*, p. 100.)

By written evidence, is meant not every thing which is in writing, but that only which is of a documentary and more solemn nature, containing the terms of a contract between the parties, and designed to be the repository and evidence of their final intentions. When parties have deliberately put their engagements into writing in such terms as import a legal obligation, without any uncertainty as to the object or extent of such engagement, it is conclusively presumed that the whole engagement of the parties, and the extent and manner of their undertaking, was reduced to writing; and all oral testimony of a previous *colloquium* between the parties, or of conversation or declarations at the time when it was completed, or afterwards, as it would tend in many instances to substitute a new and different contract for the one which was really agreed upon, to the prejudice, possibly, of one of the parties, is rejected. In other words, as the rule is now more briefly expressed, "parol contemporaneous evidence is inadmissible to con-

tradict or vary the terms of a valid written instrument." (Ib., p. 312.)

Parol evidence, bearing upon written contracts or papers concerning patent interests, ought not to be admitted without the production of such contracts or papers, to enable the court and jury to see whether the admission of parol evidence will trench upon the rule that parol evidence is not admissible to vary or contradict written contracts or papers. (*Philadelphia and Trenton Railroad Company v. Stimson*, 14 *Pet.*, 461.)

Certificates of manufacturers and others concerning an invention should be taken under oath, in order to be received and considered upon application for a patent, (*Jillson v. Winsor*, *MS. Appeal Cases*, *D. C.*, 1850.)

Although a letter from a third party is sent under cover of one from the inventor to the Commissioner of Patents, it is not evidence of priority of invention. (*Cochrane v. Waterman*, *ib.*, 1844.)

Copies of original memoranda and drawings are not admissible to confirm the testimony of the party who made them, but the originals might have been used to refresh the memory of the witness. (*Jones v. Wetherill*, *MS. Appeal Cases*, *D. C.*, 1855.)

Oral evidence of the meaning of parties in explanation of a written instrument respecting a patent right is inadmissible. The agreement, being in writing, must speak for itself. (*Troy Iron and Nail Factory v. Corning*, 1 *Blatchf.*, 472.)

347. PATENT OFFICE RECORDS, (*vide supra*, pp. 309, 310.) Written or printed copies of any records, books, papers, or drawings belonging to the Patent Office, and of letters patent under the signature of the Commissioner or Act:

ing Commissioner, with the seal of the office affixed, shall be competent 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. And copies of the specifications and drawings of foreign letters patent, certified in like manner, shall be *prima facie* evidence of the fact of the granting of such foreign letters patent, and of the date and contents thereof. (*Act of July 8, 1870, § 57.*)

Papers or drawings on file at the Patent Office are public records, and certified copies of them must be received in evidence when offered; if discordant, one may destroy the effect of the other, but they need not concur in every particular. (*Emerson v. Hogg, 2 Blatchf., 12.*) If such copies are erroneous, the Commissioner of Patents has the power and ought to make them conform to the patent itself and to the record, (*Woodworth v. Hall, 1 Wood. & Minot, 260;*) and a former and defective certified copy of a patent may be corrected by another certified copy. (*Brooks v. Bicknell, 3 McLean, 434.*) Certified copies of papers in the Patent Office are to be received as *prima facie* evidence of the genuineness of the originals on file and absolute evidence of the correctness of the copies from the record. (*Parker v. Haworth, 4 McLean, 371.*) A certified copy of an assignment of a patent is *prima facie* evidence of the genuineness of the original, (*Lee v. Blandy, 2 Fish., 89,*) and the production of the originals cannot be compelled. (*Brooks v. Bicknell, 3 McLean, 434.*)

348. EVIDENCE OF ABANDONMENT, (*vide supra*, pp. 264-267.)—Abandonment is in the nature of a forfeiture of right, which the law does not favor, and it should be made

out beyond all reasonable doubt, (*Pitts v. Hall*, 2 *Blatchf.*, 238;) and the law throws upon a party who seeks to obtain the benefit of a forfeiture the burden of proving it beyond all reasonable question. (*McCormick v. Seymour*, 2 *Blatchf.*, 256.) The natural presumption is, that a person who has invented a machine would not give it to the world, and there must be evidence of a distinct character as to abandonment, showing such intention. (*Hovey v. Henry*, 3 *West. Law Jour.*, 155.) Where experiments were unsatisfactory, and the inventor threw aside his temporary model, and wholly neglected for years to follow up his experiments, so as to produce a perfect machine, it was held, that such acts afforded strong and decisive evidence of an abandonment. (*Parkhurst v. Kinsman*, 1 *Blatchf.*, 494.)

In the case of *Goodyear & Bacon v. Hills*, Mr. Justice Cartter says: "The law-makers have admonished inventors and the public that if, before an application, they suffer more than two years to elapse in the use of the invention, they shall absolutely forfeit all right and title thereto. It is true that the legislative admonition relates to the period preceding the application. But it appears to me, so far as the court can be guided by its own judgment, that the inventor is left under the dominion of common-law principles in regard to any laches by which the application may be followed. Is it the law, that because an inventor files his application, which is refused by the office, he may sleep upon his rights indefinitely, and that at any period in his lifetime, or that of his representatives, the application may be revived as against the public? I think not. *Prima facie*, I think he would have to show a reason why he should be so permitted. The judgment of

condemnation by the office advertises to the country, at least, that he stands in no better position than before the application was made. The country is advised, by the deliberation of the only tribunal provided by law for the ascertainment at that stage of the invention, that he has no rights. More especially is he himself advised of that fact, for he is a party to the proceeding, and more immediately damnified by the rejection of the application. The rejection would at least be regarded, in the logic of equity, as a notice to him to proceed with diligence to traverse and reverse the judgment of the office." (3 *Fish.*, 139.)

349. EVIDENCE OF PRIORITY OF INVENTION.—When a man conceived a certain machine, no one knows except himself; when he described it, no one knew except himself and those to whom he described it. This is, from the nature of the case, the testimony upon which reliance must be placed. (*Sayles v. Hapgood*, 3 *Fish.*, 632.)

Priority of application for a patent does not decide priority of invention, (*Perry v. Cornell*, *MS. Appeal Cases*, *D. C.*, 1847;) but in cases of interference, the party who first filed so much of his application for a patent as illustrates his invention will be deemed the first inventor, in the absence of proof to the contrary. (*Patent Office Rules*, *July 1870*, *vide supra*, p. 451.) He is entitled to be placed in the condition of the defendant. His oath, being first made, gives him the benefit of the maxim, "*Potior est conditio defendentis.*" (*Waters v. Taylor*, *MS. Appeal Cases*, 1869.)

A patent is *prima facie* evidence that the patentee was the first and original inventor, (*Winans v. New York and Harlem Railroad*, 31 *Jour. Frank. Inst.*, 3d series, 320;

Ransom v. Mayor, &c., of New York, 1 *Fish.*, 252; *Ca- hoon v. Ring*, 1 *Fish.*, 397,) and must prevail, unless there is other evidence to overcome such *prima facie* presumption. (*Ransom v. Mayor, &c., of New York*, 1 *Fish.*, 252.) The patentee has a right to rest upon his patent for his invention until its validity is overthrown, and if there is a reasonable doubt as to the priority of invention, the patentee is entitled to the benefit of it, (*Washburn v. Gould*, 3 *Story*, 142;) and where one party has a patent, the proof of want of originality must be specific and decisive in order to overthrow such patent. (*Troy Iron and Nail Factory v. Corning*, 1 *Blatchf.*, 472.) Upon interference with a patentee, not only is the burden of proof upon the applicant to establish priority of invention, but he must also explain why he was not as diligent as the patentee in making his application. (*Hunt v. Wood*, *Commissioners' Decisions*, 1869, p. 34.)

Priority of knowledge and use of an invention is a question of fact, which may be decided from one witness; the question is on the credibility and not the number of witnesses. (*Whitney v. Emmett, Bald.*, 310.)

Proof that a party had made a thing at a certain time is *prima facie* evidence that it had been invented by the patentee, until other evidence is given to show that it had been previously known. (*Pennock v. Dialogue*, 4 *Wash.*, 451.) But the silence of such party as to his claim of original invention at such time may be opposed to such evidence. (*Ib.*, 542)

In considering the question of originality, the oath of the inventor, made prior to the issue of letters patent, that he was the first inventor of the thing patented, may be opposed to the oath of a witness, offered to show

that the invention was not original. (*Alden v. Dewey*, 1 *Story*, 339.)

Where a dispute arises as to the priority of invention, a patentee is allowed to show the real date of it, and to have his rights as fully secured as if he had taken out his patent at that time. (*Parker v. Hulme*, 1 *Fish.*, 44.)

The measure of proof requisite to show the date of an invention depends upon the nature of the invention, whether complicated or not, the distance of time when the facts occurred, and the capacity of witnesses. (*Stephens v. Salisbury*, *MS. Appeal Cases*, *D. C.*, 1855.)

The time of the invention of an improvement must necessarily precede the time when the improvement is applied to a machine in operation. (*Cundell v. Parkhurst*, *ib.*, 1847.)

Dates in an account book, in which was made a drawing of an invention, are not conclusive evidence that the invention was made at the time of such dates. (*Jillson v. Winsor*, *ib.*, 1850.) And sketches in a diary deserve little consideration when there are indications that they have been interpolated. (*Purdy v. White*, *Commissioners' Decisions*, 1869, p. 22.) Proof that a drawing was shown by A at a certain time, before the well-established invention of the same thing by B, but without any model, and without proof that the articles were manufactured until long after the invention of B, is not sufficient to establish priority of invention in A. (*Jillson v. Winsor*, *MS. Appeal Cases*, *D. C.*, 1850.) Drawings prepared for the hearing of the interference are of but little weight, although accompanied with proof that they represent such as existed before. (*Purdy v. White*, *Commissioners' Decisions*, 1869, p. 22.)

But when original drawings were made of an invention, they are the best evidence of such invention, and on the non-production of them, unless legally accounted for as being lost, the legal presumption is that, if produced, they would show the facts to be unfavorable. *Beech v. Tucker, MS. Appeal Cases, D. C., 1860.*) Verbal description may, however, be sufficient, without models or drawings, to show the date of an invention, (*Stephens v. Salisbury, ib., 1855;*) but, to establish the date of an invention, it is not sufficient to show that the applicant was engaged upon one of the same character, without proof of its identity. (*Black v. Locke, Commissioners' Decisions, 1869, p. 13.*)

He is the real inventor, and is entitled to a patent, who first makes a machine capable of useful operation, though others may have previously conceived the idea and made experiments toward putting it in practice, (*vide supra, pp. 247, 248, 249, 250, 251;*) and where preliminary experiments have proved unsatisfactory to both parties, reliance should be placed on the first reduction to successful practice. (*Jennings v. Winter & Harris, Commissioners' Decisions, 1869, p. 38.*)

In the matter of interference between the applications of John C. Duckworth, George Crompton, and Horace Wyman, for letters patent for improvement in looms, the Commissioner says: "In a conversation between Crompton and Wyman, in 1861, the latter made some rough sketches, which he explained verbally to the former, of a plan which, as described, embodied in a rude form the invention in controversy. Crompton had a plan of his own, however, and, after discussion, concluded to adopt it in preference to Wyman's. Wyman's sketches were

not preserved, and nothing came of his description until September, 1866, when Crompton recurred to the idea, and, as Wyman testifies, having made 'modifications and improvements' upon it, built an experimental loom, which was tried for a few days during that month in Hamilton's tape works in Worcester.

"No sketches, models, or written description of what was alleged to have been invented by Wyman in 1861 having been preserved, we are left entirely to the recollections of Crompton and Wyman, both to some extent interested witnesses. Proof of invention consisting wholly of the memory of conversations occurring or of sketches made eight years before is of the most unreliable kind. (*Foster v. Hamilton, Commissioners' Decisions*, 1869, p. 30; *Townsend & Foster v. Fowle, ib.*, p. 35; *White v. Allen*, 2 *Fish.*, p. 445; *Winans v. New York and Harlem Railroad Company, Frank. Inst. Jour.*, 3d series, vol. 61, p. 322.) I should hesitate to accept such evidence as against a subsequent invention actually reduced to practice.

"But if Wyman invented anything in 1861, he did nothing with it for seven years. This, if the invention or application of others intervened, is fatal to his case. (See *Rowley v. Mason, supra*, p. 483, as well as a long list of cases since decided, in which the doctrine of that case has been followed and applied.)

"It is said that the war intervened; but the parties expressly testify that the manufacture of looms from that cause was interrupted but for a single year, and the war ceased in 1865. It is said that there was a verbal agreement between Crompton and Wyman, by virtue of which all inventions patented by the latter were to belong to the works; but as this agreement still exists, and the ap-

plication of Wyman is being pressed confessedly for the benefit of Crompton, who is the real party in interest, Wyman is to be charged with Crompton's laches as well as his own. The interest of Wyman in the invention has always been the same as now. Crompton, who is to own the patent, cannot be allowed to say that Wyman was prevented by him from obtaining a patent. Nor can Wyman, who has no pecuniary interest in it, be allowed to play the part of an inventor under duress. This is not the case of *White v. Allen*, (2 Fish., 445,) nor anything like it. This is Wyman's application only in name. It is really made by Crompton for his own interest, and *a fortiori* he must be charged with his own laches.

“All that was done by Wyman, then, was to make a suggestion, subsequently abandoned. It was competent for any one to take up that suggestion, to modify, improve upon, or perfect it, and then to use or patent it.” (*Whitely v. Swayne*, 7 Wall., 685; *Duckworth v. Crompton*, Commissioners' Decisions, May 16, 1870.)

350. EVIDENCE OF PRIOR KNOWLEDGE OR USE IN A FOREIGN COUNTRY.—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, provided the same shall not have been introduced into public use in the United States for more than two years prior to the application, and that the patent shall 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; but in no case shall it be in force more than seventeen years. (*Act of July 8, 1870*, § 25.)

Whenever it shall appear that the patentee, at the time of making his application for the patent, believed himself to be the original and first inventor or discoverer of the thing patented, the same shall not be held to be void on account of the invention or discovery, or any part thereof, having been known or used in a foreign country before his invention or discovery thereof, if it had not been patented or described in a printed publication. (*Ib.*, § 62.)

Evidence cannot be received of actual use and knowledge of an invention in a foreign country prior to the time of the invention here, unless it appears that the invention or improvement was patented in such foreign country or described in some public work, (*Judson v. Cope*, 1 *Fish.*, 615;) and it must appear that the improvement has been so clearly and intelligibly described that the invention could be made or constructed by a competent mechanic. (*Ib.*)

The language of the act (§ 6, act of 1839) under which this limitation was made is as follows: "That no person shall be debarred from receiving a patent for any invention or discovery, &c., by reason of the same having been patented in a foreign country more than six months prior to his application: *Provided, &c., and provided, also,* That in all cases every such patent shall be limited to the term of fourteen years from the date or publication of such foreign letters patent."

It will be seen that the language is "date or publication" of the foreign letters patent. As the patent cannot have a varying term, the "or" is to be read conjunctively, and the phrase is in effect "date *and* publication;" so that, if there be a difference between the day of date

and the day of publication, the limit should run from the latest day.

Under the English law, letters patent are dated when the provisional specification is filed. The applicant is allowed six months within which to complete his invention and to file a complete and extended specification. If he does this, the patent is formally issued to him; if not, he has "provisional protection" for six months, when all protection ceases. During the six months he may amend, alter, or improve upon his invention, and if his completed specification does not describe an invention inconsistent with his title and provisional specification, he may include his alterations, amendments, and improvements in his final paper. His provisional specification is in effect a caveat. It may not be followed up by a perfect invention; when, after six months, all protection ceases.

As the invention in its perfected, completed form is not "published" until the enrollment of the final specification; as, in fact, much of the invention may be *made* between the time of the filing of the provisional and completed descriptions, it would seem that the "date and publication" which are to determine the limit of a patent in this country should be the date of the filing of the complete specification.

This was the view of the law entertained by Commissioner Ewbank, when referring to this subject in the Rules of the Patent Office published in 1851. (*Patent Office Reports*, 1851, p. 509.) He says: "No invention will be considered as patented in a foreign country unless the specification has been enrolled and the patent in all respects complete."

There are but two reported cases bearing upon this

subject. The first is that of *Brooks v. Norcross* (2 *Fish.*, 661,) decided in 1851 by Mr. Justice Woodbury. Certain French machines were offered in evidence to defeat the Woodworth patent, which machines, it was insisted, had been patented in France. The language of the court is as follows: "But were these two French inventions ever 'patented,' within the meaning of that word in the act of Congress, (July 4, 1836?) The word there is first applied in connection with the original issue of a patent, prohibiting it to be done by the Commissioner, if it had been '*patented*' abroad. (§ 7.) It is next used in connection with the defense to a patent, declaring the defense good if the invention has before been 'patented' abroad. (§ 15.)

"The word 'patented,' as here used, must of course mean covered and made known to the world by a public patent, so as to bring home to the public generally, and probably, a knowledge of its existence, and deprive any one of the credit and protection of being original, if he afterward construct a like machine.

"But in the French system of patents at that time there existed private as well as public patents, and, for aught which appears, there may have been, till after 1828, patents of the former character, and consequently not coming within the spirit or ordinary meaning of the word '*patented*,' as used here in the act of 1836 to describe what is open and should be known to the community.

"This vital fact, whether private or public, ought to be made to appear by the defendant, as he sets up the patent as if coming within the word 'patented' as used in our own law, when nothing can be within the spirit of that law except what is public and thus known, open

and hence inimitable, and no other being in use here; such being the design and principle in all objections of this class and the analogous classes, the patents must have been used publicly, if used before; a description of them printed publicly, if printed before; an invention of them been made public, if made before; and 'patented' of course publicly, if any way before."

The second case is that of *Howe v. Morton*, (1 *Fish.*, 586,) decided by Judge Sprague in 1860. In this case the learned judge says: "But it is contended that this machine was patented abroad prior to the invention here, although the specification of Fisher & Gibbons was not enrolled until after the invention of Howe here. This raises another, and, so far as I am aware, a new question upon the construction of our own statute. The language of the statute is (§ 7, act of 1836) that it had before been 'patented or described in any printed publication'—'patented in any foreign country.' Was this invention of Fisher & Gibbons patented in England before the middle of May, 1845? That depends upon what is to be deemed patenting. What was the patent taken out in December? It was as follows: 'Invention of certain improvements in the manufacture of figured or ornamental lace or net, or other fabrics.' That was the patent and whole description; and there is no pretense that it even indicates any invention of a sewing machine.

"It is only by virtue of the specification enrolled in June, 1845, that we discover anything as to the stitching mechanism in the machine.

"But it is said that when the specification was enrolled it took effect from the date of the letters patent, and, therefore, what was specified and enrolled in June afterward

was in fact patented in December, 1844. That is the argument. What is the meaning of the word 'patented' in our statute? The English government may give such effect to certain acts of their own as they see fit; they may say letters patent may be granted in general terms, and that the fourteen years they grant may begin at the date of the letters patent, though no specification be enrolled till six months after. That is the law of England; but the question is, what did the Congress of the United States intend when they used the words 'patented in any foreign country?' Did they mean that the invention might be patented before it was made? Because, under the English law, the letters patent might be granted before the specification was made, and the specification might contain inventions made after the letters patent were granted. There would be some force in the argument if by the English law nothing could be put into the specification but what was invented or known before the letters patent were granted; but that was not so. The truth is, that the patentees had these six months by the terms of the letters patent to enroll their specification, and during all that time they may have made inventions and improvements; and the very thing that is relied upon here, as anticipating Howe, for all that we know, may have been invented after the middle of May, 1845, and put into the specification in June following.

“What is meant by Congress undoubtedly is, in the first place, that there shall have been an invention; and, in the second place, that it shall have been made patent to the world, *patented*. Now, we have no satisfactory evidence that the invention was made, and we have positive evidence that it was not made known to the world by

being patented until June, 1845; it was not made patent until after the invention by Howe. I am, therefore, of the opinion that Fisher & Gibbons' invention, whatever it may have been, was not patented until after Howe's invention, and can have no effect whatever."

It will be observed that these decisions refer to the date of the foreign patent when offered as a defense upon an action brought for the infringement of an American patent, and they refer to patents not granted to the American patentee. But Mr. Justice Woodbury says, in *Brooks v. Norcross*: "But 'patented abroad' means the same thing in the defense as in the issue of letters;" and it is difficult to see why any portion of the life of the American patent should be abridged by the filing abroad of an incomplete and unpublished specification. English letters patent, therefore, in so far as they affect the term of those granted in this country, are to be held to be "dated or published" at the time of the enrolling of the final specification. (*Commissioners' Decisions*, 1869, p. 60.)

In the case of *Maynard ex parte*, the Commissioner says: "Applicant presents a proper case for an extension, unless his invention is anticipated by the reference given by the examiner to the provisional specification of John Harcourt Brown, said to have been filed in England in August, 1855.

"I have already had occasion (*James Cochrane ex parte*, *Commissioners' Decisions*, 1869, p. 60) to consider the meaning of the word 'patented,' as used in our law with reference to inventions patented in foreign countries. In that case it was said: 'English letters patent, in so far as they affect the term of those granted in this country, are to

be held to be 'dated or published' at the time of the enrolling of the final specification.'

"A provisional specification is analogous to our caveat, and is filed for the purpose of permitting the inventor to complete or perfect his invention. Sometimes it contains no more than the title, and sometimes, as in the case of the present reference, is unaccompanied with drawings. Such a grant cannot be called a patent, nor can an invention described in it be said to have been 'patented' abroad.

"But the provisional specification is found in a printed publication, which bears date in 1856. This date must be construed most strongly in favor of the applicant. He has made oath that he is the original and first inventor. That oath can only be overcome by proof that the invention was made in this country, or patented or published abroad before the date of his invention. Proof that an invention was published in 1856 will not suffice. We cannot assume it to have been published before April 18, 1856, the date of his application; indeed, it must be assumed, in the absence of proof, to have been published at a later period.

"Nor is the recital in the publication, that the provisional specification bore date in 1855, of the slightest consequence. The printed publication can be evidence only to show that *at the date of publication* the thing described had an existence, and no recitals of former dates can be received as testimony. The contents of the book may be received as a description, but not as a history of the invention. This has been expressly held by the Supreme Court of the United States in *Seymour v. McCormick*, (19 How., 107.) In that case the book offered in evidence

recited that the machine in question had worked successfully, but the court held that the publication could not be received as proof of any other fact, except that of the description of the improvement.

“It follows that the improvement patented to Maynard has not been patented abroad, nor has it been described in a printed publication of earlier date than his patent.” (*Commissioners’ Decisions, June 4, 1870.*)

As to the English laws and practice, *vide supra*, p. 85, *et seq.*

351. EVIDENCE OF NOVELTY AND UTILITY, (*vide supra*, p. .) Under the act of 1793 a patent was not even *prima facie* evidence that the invention patented was new or useful; but under the act of 1836 a patent issued after the examination required is received as *prima facie* evidence of the facts asserted in it. (*Corning v. Burden*, 15 *How.*, 270, 271.)

Whether there is novelty in an invention is a question to be determined upon a view of all the evidence in the case. (*Sickles v. Borden*, 3 *Blatchf.*, 540; *Batten v. Taggart*, 17 *How.*, 85; *Park v. Little*, 3 *Wash.*, 107.)

A combination of old parts to produce a new and useful result is an invention for which a patent may be granted. (*Evans v. Eaton*, *Pet. C. C.*, 322; *Barret v. Hall*, 1 *Mason.*, 447; *Pennock v. Dialogue*, 4 *Wash. C. C.*, 538; *Earle v. Sawyer*, 4 *Mason*, 1; *Le Roy v. Tatham*, 22 *How.*, 132.)

It is no objection to a patent for a combination that some or even all the parts have been known before. If the combination of them is new, and produces what is substantially a new and useful result, the combination is patentable. (*Pitts v. Whitman*, 2 *Story C. C.*, 609; *Hovey*

v. *Henry*, 3 *West. Law Jour.*, 153; *Hovey v. Stevens*, 1 *Wood. and Minot*, 290; *Blake v. Sperry*, 2 *N. Y. Leg. Obs.*, 251; *Buck v. Hermance*, 1 *Blatchf.*, 398; *Hall v. Wiles*, 2 *ib.*, 194.)

A patent for a combination of three distinct things is not infringed by combining two of them with a third, which is substantially different from the third element described in the specification, (*Prouty v. Ruggles*, 16 *Pet.*, 336; *Silsby v. Foote*, 14 *How.*, 219; *McCormick v. Talcott*, 20 *How.*, 402; *Vance v. Campbell*, 1 *Black.*, 427; *Eams v. Godfrey*, 1 *Wall.*, 78; *Brooks v. Jenkins*, 3 *McLean*, 432; *Brooks v. Bicknell*, 4 *McLean*, 80; *Parker v. Hayworth*, 4 *McLean*, 370; *Latta v. Shank*, 1 *Fish.*, 465; *Lee v. Blandy*, 2 *Fish.*, 89;) and a patent for a combination of two things is not a patent for a combination of one of the two things with a third and different thing. (*Nicolson Pavement Company v. Hatch*, 3 *Fish.*, 432.)

A patentee who is not the inventor of a peculiar element of a combination cannot claim that element in combination with every form of another element with which he unites it, but may claim it when constructed and combined as described in his specification. (*Larabee v. Cortlan*, 3 *Fish.*, 5.)

A combination in mechanism must consist of distinct mechanical parts, having some relation to each other, and each having some function in the organism, (*Yale and Greenleaf Manufacturing Company v. North*, 3 *Fish.*, 279;) and in considering whether one element of a combination is substantially the same as an element of another combination, the fact that one works better than the other, coupled with the fact that the change is not within the ordinary knowledge and skill of all mechanics, is highly

important, and often decisive. (*Woodman v. Stimson*, 3 *Fish.*, 98.) Though the separate parts are all as old as the mechanic arts, if they are organized into a new machine, having a new mechanical operation, and the organization of this new machine involved the exercise of original thought, and is productive of useful results, then it is patentable, (*Blake v. Stafford*, 3 *Fish.*, 294;) and a modification of the parts of a combination, by which a new result is obtained, may be the subject of letters patent, (*Turrill v. Illinois Central Railroad Company*, 3 *Fish.*, 330;) but all the parts must coact in producing the result claimed for their combination. (*Swift v. Whisen*, 3 *Fish.*, 343.)

The patent raises the presumption of novelty and utility, and the degree of utility will not be very rigidly inquired into. (*Bell v. Daniels*, 1 *Fish.*, 372; *Teese v. Phelps*, 1 *McAllis.*, 49; *Potter v. Holland*, 1 *Fish.*, 327.) This presumption, however, is not conclusive, and it may be shown that the invention is useless and worthless, (*Lee v. Blandy*, 2 *Fish.*, 89,) or that the thing had been previously known. (*Coleman v. Leesor*, *MS.*, *Ohio*, 1850.)

According to the American cases the result alone, when the effects produced are more economical, useful, and beneficial, or a better article, is not conclusive evidence of novelty of an invention; but under the English cases the result alone, under like circumstances, is conclusive evidence of invention. (*Yearsty v. Brookfield*, *MS. Appeal Cases*, *D. C.*, 1853.)

As to the utility of an invention, upon application for a patent, the testimony of disinterested, practical men will be received, and it seems will overcome apparent resemblance to other inventions, (*Hoyt ex parte*, *ib.*, 1860;

Hayden ex parte, ib. ;) so also as to the point whether an invention furnishes either a new article or a better or cheaper one. (*Arthur ex parte, MS., ib., 1861.*) But it was held by Cranch, C. J., in the case of *Winslow ex parte*, that the opinion of experts or scientific and practical men, as to the comparative merits of two inventions, cannot affect the question of their novelty. (*Ib., 1850.*)

The oath of the patentee, required upon his application for a patent, forms a legal ground for the presumption of the novelty of the claim until the contrary is proved. (*Parker v. Stiles, 5 McLean, 60.*)

The novelty of an invention can be defeated by a prior use only, by showing that such prior use accomplished the same result in the same manner. (*Foote v. Silsby, 2 Blatchf., 266.*)

Upon application for a patent the applicant cannot be required to furnish evidence of the practical result of his invention. (*Seely ex parte, MS. Appeal Cases, D. C., 1853.*)

352. EXAMPLES OF NOVELTY AND WANT OF NOVELTY.—If nothing is shown that will invalidate a patent already granted, another will not be allowed for the same thing, (*Grell v. Kunhert, Commissioners' Decisions, 1869, p. 5.*) A machine which is designed to accomplish a certain object is not anticipated by one which accomplishes the same object only occasionally, and without its having been intended, (*George W. Brown, ib., 10.*) A patent furnishes no presumption that the invention was made before the filing of the application, (*John M. Heck, ib., 19.*) A picture frame with a gilt-metal bead spun upon it from a flat band is a novelty, although such a frame with a gilt bead is old, as well as the mode of spinning metal beads, (*George Schneider, ib., 24.*) Placing advertisements

on railway tickets having been practiced, it is no novelty to designate upon them places of business in the towns at the end of the route for which they issue, (*A. N. Towne, ib., 39.*) An invention is not to be deemed old because a like effect has been produced by similar means, if it was only incidentally and occasionally, without being intended, (*Henry Waterman, ib., 51.*) Escutcheons on stamps and the like, for inclosing distinctive marks, are old and not patentable, (*Lewis Abraham, ib., 59.*) An English provisional specification, upon which no patent was issued, can be treated only as a published description in ascertaining the state of the art, (*R. O. Lowrey, ib., 85.*) A die, whose surface is formed by electrotyping from an article of straw, is not to be patented, if dies have been before made with a like surface electrotyped from a cast or model of straw, (*H. Loewenberg, ib., 92.*)

In the application: It being a mechanical expedient to insert metal into a hub in order to diminish friction, it requires no invention to insert soft metal in the eye of a wooden sash pulley for the same purpose, (*Thomas B. Stout, ib., 4.*) To use an old article in a new situation is not of itself such a novelty as to be monopolized, (*Thomas Kerr, ib., 16.*) The application of a known device may be deemed novel if it lies so far out of the beaten track as not to be suggested by the former use of it, (*Robert A. Chceseborough, ib., 18.*) It is a mere double use to apply to several steam boilers what has been applied to one before, though of a different kind, (*James Murphy, ib., 24.*) It is but a double use to apply to the casting of stove covers and centers the same process which had been previously employed in casting fire shovels and the like, (*E. C. Little, ib., 25.*) There is no novelty in practicing

on a small scale what has been practiced on a large one before, or in practicing it for a different purpose, (*Woodward v. Reist, ib., 34.*) There is no invention in employing upon a sheet-metal photographic frame a thumb-latch, which had been previously employed on other photographic frames, (*A. C. Platt, ib., 42.*) The use of a friction driver in a type-setting machine may be the ground of a patent, though old in itself, if it has never been used in such a machine before, (*Joseph Thorne, ib., 76.*) A claim for the combination of a pencil, rubber eraser, and sleeve to unite them, is not answered by the sleeve used in porte crayons, parasol handles, and the like, (*Vosburg & Ludden, ib., 80.*) Land vehicles and water craft having been employed as advertising mediums, a vessel constructed and especially adapted for the purpose in an ordinary mechanical way is not to be regarded as an invention, (*A. M. Biedler, ib., 91.*) The application of a device to a mower, which has been previously applied to a reaper in the same way, is a mere double use, (*H. M. Carter, ib., 96.*) A jointed rod to operate a caster wheel in a harvester being old, there can be no invention in substituting it for a stiff rod in the place where the latter had been used, (*H. M. Carter, ib., 96.*) Metallic springs having been used on eye-glasses to close them, and having been used on articles in the same way and for the same purpose as the applicant uses them on eye-glasses, his device is not entitled to favorable consideration, (*William Linden, ib., 108.*)

In the material: The substitution of a cheaper material for the bed of a billiard table, as cement for glass and the like, may merit favorable consideration, (*W. E. Bond, ib., 17.*) The substitution for an unelastic material

of one possessing elasticity is patentable, where that quality is made to subserve a useful purpose, as in railroad chairs, (*G. E. Deering, ib., 26.*) A sheet-metal box or frame, with a wired flange, being known, there is no novelty in substituting it for a wooden or a cast-metal box in photographic frames, (*A. C. Platt, ib., 42.*) A transparent cylinder surrounding the wick tube of a lamp, combined with a deflector above and an air distributor below, would not be patentable had an opaque cylinder been used in the same combination, (*Joseph Ridge, ib., 46.*) Change of material is not patentable where the same material has already been used for the same general purpose, and is merely put in some new relation, (*Dimond & Doolittle, ib., 64.*) To combine with a top rim flexible metallic lamp shades cannot be considered novel, as such shades are old, and shades not metallic have been combined with such a rim, (*Dimond & Doolittle, ib., 64.*) Although a process was alleged to consist in the use of alum after soap, yet if the specification and claim represent it to consist in the use of soap and alum in the combination, it is anticipated by a published process in which aluminous soap was recommended for the same purpose, (*R. O. Lowrey, ib., 85.*) Metallic springs for eye-glasses are anticipated by rubber springs, which have been used on them in a similar manner, (*William Linden, ib., 108.*)

In the form: A change in the form of the aperture which it closes does not render a damper worthy of a patent, (*E. R. Fenno, ib., 9.*) Introducing additional wheels into gearing does not alone render the combination legitimate, (*E. Z. Webster, ib., 9.*) Piano stools having been made with iron legs, having recesses for tips, and chairs with wooden legs provided with dove-tailed

recesses for tips, and with rubber cushions inserted therein, to make piano stools with iron legs, constructed with such dove-tailed recesses and provided with such cushions, is not patentable, (*P. Y. Brown, ib., 18.*) Tables vibrating in the arc of a circle having been used in sewing machines to carry the work, there is no merit in substituting a table for a horn which vibrated vertically in a straight line in another machine, (*Daniel Mills, ib., 25.*) A change of form which renders an instrument more useful is patentable, although the change is simple, (*I. D. Warner, ib., 41.*) Substituting a broad-faced stop for a pin to check the movement of the arm in a horse rake should not be patented, (*A. T. Barnes, ib., 81.*)

In the structure: The sanction of the office will not be given to extending a railroad shoe lengthwise, so as to underlie the whole rail, (*Watts Cooke, ib., 6.*) Merely reversing the operation of an apparatus is not a meritorious invention, (*George W. Blake, ib., 9.*) A claim for hoppers within the furnace, with orifices between the boilers for feeding sawdust to the grate, so that the dust shall be dried, is not answered by such hoppers outside of the furnace, with orifices outside of the boilers, (*Samuel Sykes, ib., 9.*) The mere reversal of two parts of a device in their position upon a structure is not to be regarded as a novelty, (*R. A. Leeds, ib., 13.*) To add a shoulder for receiving a spring deserves no reward from the office, (*Sherrell & Warner, ib., 15.*) To fit a tool with awls of different blades where one has been used before is not a novel conception in law, (*Wilcox v. Woodbury, ib., 17.*) It is a mere limitation and not an expansion of an invention, to make the case of a centering awl whole which another has made with a split, so as to fit coun-

tersinks of different sizes, (*ib.*) To pack bales of compressed feed in paper, retained by slats and binders, instead of straw retained by slats as usual, is an improvement deserving recognition, (*S. W. Adwen, ib., 23.*) To unite with steam boilers of different kinds a steam generator and superheater, such as has been united with one kind of boiler before, and claim the combination, is not to be allowed, (*James Murphy, ib., 24.*) Adding a hinged lid to a vignette plate, and changing the mode of holding it in position, so that the whole frame is rendered less cumbersome, deserves a favorable consideration, (*A. C. Platt, ib., 42.*) A band upon an open-grooved arrow gun, which holds the arrow in the groove while it is impelled by the spring, is not anticipated by a band which holds the arrow only before it is discharged, nor by such guns having close grooves or barrels, (*Charles Robinson, ib., 44.*) A claim for a short stud, projecting downward from the head of a railroad spike, might possibly be understood to embrace a flexible barb in the same position; and that being old, the claim should not be allowed, (*P. J. Dwyer, ib., 57.*) Mere omission of parts does not constitute patentable novelty; but, if followed by reorganization, it may, (*George McRoy, ib., 58.*) Postage stamps with coupons, to be detached when the stamps are applied, in order to cancel them, anticipate revenue stamps with like coupons, although the coupons of the latter are made to correspond with the stamps, and are preserved in order to check frauds, (*Lewis Abraham, ib., 59.*) There is no invention in changing a mill from a horizontal to a vertical position, nor in applying the driving power directly to the main roller instead of applying it through other mechanism, nor in incasing two bolts in

one casting, (*Stevens & Powers, ib., 63.*) To spring an elastic body of a lamp shade over an inflexible rim cannot be regarded as novel, an elastic rim having been before sprung into an inflexible body, (*Dimond & Doolittle, ib., 64.*) A ladies' safety belt, made with elastic pieces inserted, having been allowed a patent, it is an improvement upon it to make the belt in two pieces, connected by two buckles, so that the flaps which are attached are always opposite to each other, (*Bachelor v. Porter & Bancroft, ib., 64.*) Pumps having been made in sections, there is no invention in making hydrants in sections, (*Charles & H. Ackerson, ib., 74.*) A combination in a type-setting machine of an ejecting finger, a key to select the finger, and a carrier operated by a power separate from the key, is not answered by a combination in which the key both selects and operates the finger, (*Joseph Thorne, ib., 76.*) A cover combined with a door latch sunk into the face of a door being old, as well as a projecting cover arranged on the face of a door, there is no novelty in a projecting cover with a latch so arranged, (*P. W. Dean, ib., 77.*) A right and left screw having been used with a printer's side-stick, there is no invention in operating a quoin with one, although the side-stick can be used only in a press of a given size and a quoin can be used in any, (*F. H. Webb, ib., 78.*) Whether a claim to a pencil, rubber eraser, and sleeve to unite them, can be extended to cover a complete cylinder for a sleeve without the ring by which the semi-cylinders composing the sleeve are connected, *quere?* (*Vosburg & Ludden, ib., 80.*) To drive two rollers, one by the gear wheel on one end of a shaft and the other by another gear wheel on the other end of the same shaft, is an improvement on a similar

machine, in which one roller is driven by a gear wheel on the other, (*Powers & Stevens, ib., 81.*) A broad-faced stop with a flange extending down the side of the bar on which it is placed, so as to bear the blow better, when substituted for a pin to check the movement of the arm in a horse rake, is patentable, (*A. T. Barnes, ib., 81.*) To make a latch and weighted catch in one piece, which have before been made in two and soldered together, is not to be esteemed an invention, (*R. M. Thompson, ib., 81.*) A metal shade in one piece, with flexible springs on its inner periphery, and intended to rest by the springs on the glass chimney of a lamp, is not anticipated by one which rests by three inflexible points on a metal cap over the chimney, (*M. H. Collins, ib., 82.*) If a pinion has been secured upon the arbor of a wheel by means of a screw thread cut upon the arbor, there is no invention in securing the wheel upon the arbor of the pinion by the same means, although some slight advantages are incident to the latter construction, (*J. A. Smith, ib., 83.*) There is no merit in forming blocks for a wooden pavement with a rebate on one side, so as to form a channel for holding concretes, after such blocks have been cut with a rebate on both sides for the same purpose, and the same effect has been produced by using long blocks alternating with short ones, (*L. S. Robbins, ib., 84.*) A cork machine in which the cork was cut tapering by four cutters, which were made to approach each other during the process by means of a collar sliding upon the shaft to which they are hinged, does not anticipate one in which the cutter is in one piece, but with slits, and the edges approach each other in consequence of their form, (*M. F. Crocker, administratrix, ib., 85.*) An instrument for

kindling fires by gas, which is supplied to it by a flexible pipe attached to a tubular handle, is not anticipated by a like instrument for kindling fires having no such handle, although it was suggested that it might be used with gas, if desired, (*Jeremiah Kenney, sr., ib.*, 95.) Where the distance between two points in an instrument is all that distinguished it from others, and that distance must be varied in different applications, it will not render the instrument patentable, (*I. D. Warner, ib.*, 109.) In a paper-folding machine the addition of a spring to one of the rollers, so that it will yield to the folding knife, is entitled to favor, (*S. C. Forsaith, assignee, &c., ib.*, 111.)

353. EXAMINATION OF PARTIES.—As a general rule, a party in a patent cause cannot be a witness in his own behalf. (*Buck v. Hermance*, 1 *Blatchf.*, 324; *Foot v. Silsby*, 3 *Blatchf.*, 508.) But the judiciary act of September, 1789, § 34, (1 *Stats. at Large*, p. 92,) in adopting the laws of the several States as rules of decisions in the courts of the United States, embraced laws relating to evidence; and where, therefore, under the laws of any State, parties may be examined as witnesses in their own behalf, a plaintiff in an action in the United States courts for infringement of his patent is a competent witness as to the issues raised therein. (*Hausknecht v. Claypool*, 1 *Black*, 431; *Vance v. Campbell*, 1 *Black*, 427.)

Formerly the testimony of an inventor or a party to the record was not admissible in an interference, (*Yearly v. White*, *MS. Appeal Cases, D. C.*, 1853,) even though he had assigned all his interest in an invention to another. (*Eams v. Richards, ib.*, 1859; *Hill v. Dunklee, ib.*, 1857; *Gibbs v. Johnson, ib.*, 1860; *O'Rielly v. Smith, ib.*, 1853; *Barstow v. Swain, ib.*, 1860.) Upon this point Mr. Chief

Justice Cartter said, (*Irwin v. Merrill*, MS. Appeal Cases, D. C., 1864:) "It is an elemental rule of evidence, as repeatedly declared by my predecessors and now affirmed, that a patentee and party to the record cannot become a witness by transfer of his right pending the proceeding. I do not possess the right, if I could see the reason, for removing this disability. It is urged by the Commissioner that the legislature and courts incline to listen to the testimony of parties. If the federal legislature, the law-making power of this jurisdiction, had made parties competent as witnesses, I should not hesitate to follow, but Congress has failed to do so. * * * * The prevailing rule of all good courts is to administer the law as they find it, without attempting to make it."

354. PARTIES IN INTERFERENCE CASES MAY TESTIFY.— Since the act of July 2, 1864, relating to the law of evidence in the District of Columbia, parties to the record in interference cases, and all parties interested in the same, have been deemed competent to give evidence. The provisions of the act are as follows:

"Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That on the trial of any issue joined, or of any matter or question, or on any inquiry arising in any suit, action, or other proceeding in any court of justice in the District of Columbia, or before any person having by law, or by consent of parties, authority to hear, receive, and examine evidence within said District, the parties thereto, and the persons in whose behalf any such action or other proceeding may be brought or defended, and any and all persons interested in the same, shall, except as hereinafter excepted, be competent and compellable to give evidence,

either *viva voce* or by deposition, according to the practice of the court, on behalf of either or any of the parties to the said action or other proceeding: *Provided*, That nothing herein contained shall render any person who is charged with any offense in any criminal proceeding competent or compellable to give evidence for or against himself or herself, or shall render any person compellable to answer any question tending to criminate himself or herself, or shall in any criminal proceeding render any husband competent or compellable to give evidence for or against his wife, or any wife competent or compellable to give evidence for or against her husband, or in any proceeding instituted in consequence of adultery; nor shall any husband be compellable to disclose any communication made to him by his wife during the marriage, nor shall any wife be compellable to disclose any communication made to her by her husband during the marriage. Approved July 2, 1864.”

355. COMPETENCY OF WITNESSES.—It was also formerly held that the testimony of a witness directly or indirectly interested was not admissible in an interference, (*Marshall v. Mee*, *MS. Appeal Cases, D. C.*, 1853,) however small the amount of the interest might be, (*Arnold v. Bishop*, *MS. Appeal Cases, D. C.*, 1841;) but by the act of July 2, 1864, the disabilities of such witnesses were removed, and they are now competent and compellable to testify.

If no objection is made to the competency of a witness on his examination, and both parties examine him, it will be too late to take the objection afterward. (*Allen v. Alter*, *MS. Appeal Cases, D. C.*, 1860.)

In determining what credit is to be given to the testimony of witnesses, every circumstance affecting

their veracity should be taken into calculation, (*Evans v. Hettick*, 3 Wash., 423,) and weight should be given to it in proportion to the competency of the witness to judge of the matter sworn to. (*Allen v. Hunter*, 6 McLean, 310.) The presumption of law is, that a witness on oath testifies honestly until the contrary is known. (*New England Screw Company v. Sloan*, MS. Appeal Cases, D. C., 1853.) The testimony of witnesses otherwise incompetent may be received and considered by the agreement of the parties. (*Warner v. Goodyear*, *ib.*, 1846.)

356. EXPERTS.—To determine the question of the mechanical difference of machines, the law permits the opinions of men called experts to be given in evidence, and when such men are qualified, and free from bias, their testimony is entitled to great respect. (*Morris v. Barret*, 1 Fish., 461.)

The patent act contemplates two classes of persons as peculiarly appropriate witnesses in patent cases, namely: 1st, practical mechanics, to determine the sufficiency of the specification as to the mode of constructing, compounding, or using the patent; 2d, scientific and theoretic mechanics, to determine whether the patented thing is substantially new in its structure and mode of operation, or a mere change of equivalents; and the second class is by far the higher and more important of the two. (*Allen v. Blunt*, 3 Story, 742.)

The opinions of professional men are evidence only as to matters which relate to their profession, (*Brooks v. Bicknell*, 3 McLean, 447;) thus, in medical science a physician is an expert; in navigation, a sailor. (*Page v. Ferry*, 1 Fish., 298.) The statute defines the character of an expert as one “skilled in the art or science” to which

his opinion appertains, (*ib.*;) and one not so skilled is not a fit person to testify as to whether a specification contains a sufficient description. (*Poppenhausen v. New York G. P. C. Company*, 4 *Blatchf.*; *Allen v. Hunter*, 6 *McLean*, 307.)

The testimony of experts is useful to show the operation of devices; but when experts undertake to tell what a patent is for, they assume the duty of the court; and when they undertake to say what is or is not a violation of the patent, they not only assume the duty of the court, but the jury. (*Waterbury Brass Company v. New York and Brooklyn Brass Company*, 3 *Fish.*, 43.)

Experts may be examined to explain the meaning of terms of art on the principle, *Cuique in sua arte credendum*, (*Corning v. Burden*, 15 *How.*, 270; *Winans v. New York and Erie Railroad Company*, 21 *How.*, 100,) or as to whether a patent is void for uncertainty, (*Washburn v. Gould*, 3 *Story*, 138,) or to explain the difference between an original and reissued patent, (*Philadelphia and Trenton Railroad v. Stimson*, 14 *Pet.*, 462,) or as to the identity of different mechanical structures, (*Parker v. Stiles*, 5 *McLean*, 64,) or the state of the art at any given time, (*Winans v. New York and Erie Railroad*, 21 *How.*, 100,) or to explain machines, models, and drawings exhibited, (*ib.*;) but their opinion cannot be dignified with the mantle of authority, even on questions of science. (*French v. Rogers*, 1 *Fish.*, 133.)

XXI. Reissues.

SEC.	SEC.
357. Résumé of the law.	370. Through fault of applicant.
358. Provisions act July, 1870.	371. Divisions of a reissue.
359. To whom granted.	372. Action of the Commissioner.
360. Application made by inventor only if living.	373. Reissue must be for the same invention.
361. Concurrence of parties.	374. Specification and claim subject to revision.
362. Rights of assignees.	375. Surrender does not take effect until reissue is granted.
363. Statement of title.	376. Rights conferred by reissue.
364. Application acted on as soon as filed.	377. Petition for reissue by inventor.
365. Defects cured by reissue.	378. Petition for reissue by assignee.
366. There may be more than one reissue.	379. Oath by applicant for reissue by inventor.
367. Use under defective patent.	380. Oath by applicant for reissue by assignee.
368. Reissue during extended term.	
369. Clerical error, fault of office.	

357. RÉSUMÉ OF THE LAW CONCERNING REISSUES.—Before the British act of 5 and 6 Wm. IV. c. 83, 1835, the consequence of a defect in the specification, in England, was an absolute loss of the privilege of the patent right. By the first section of that act the patentee or his assignee “may, with the leave of the attorney or solicitor general, enter a disclaimer of any part of either the title of the invention or of the specification, stating the reason for such disclaimer, or may, with such leave, enter a memorandum of any alteration in the said title or specification, not being such disclaimer, or such alteration as shall extend the exclusive right granted by the patent;” and such disclaimer or memorandum is thereafter to be considered a part of the title or specification.

In the early American cases, after the act of 1793, it

appears to have been supposed that the law had by that act been varied from the English; so that the patent right was forfeited and lost only in case of the defects specified in the sixth section being designed and fraudulent. It is provided by that section that, in a case for an infringement, the defendant may give in evidence, in his defense, "that the specification does not contain the whole truth relative to his discovery, or that it contains more than is necessary to produce the described effect, which concealment or addition shall fully appear to have been made for the purpose of deceiving the public."

Mr. Justice Story, in giving an opinion in the circuit court, in 1813, on an examination of this section, remarked: "We think that the manifest intention of the legislature was not to allow any defect or concealment in a specification to avoid the patent, unless it arose from an intention to deceive the public." (*Whittemore v. Cutter*, 1 *Gall.*, 429.)

In the same year, Mr. Justice Washington, instructing the jury in the circuit court of the United States for Pennsylvania, said on the subject of concealment, "the matters not disclosed must appear to have been concealed for the purpose of deceiving the public, in order to invalidate the patent." (*Park v. Little*, 3 *Wash.*, 196.)

In 1817, again, these judges appear still to have entertained the same opinion. (*Lowell v. Lewis*, 1 *Mass.*, 182; *Gray v. James*, 1 *Pet. C. C.*, 401.) But it was, at the same time, remarked by Mr. Justice Story, that the doctrine was liable to grave objections on the score of expediency. (*Whittemore v. Cutter*, 1 *Gall.*, 429.) And it was subsequently abandoned, and the English doctrine adopted, that a defect in the specification, from want of com-

pliance with the requisitions of the third section of the act of 1793, rendered the patent void; but that, if the defect arose from mistake, a new patent could be taken out for the unexpired part of the term. In this respect our law on this subject differed from the English.

This doctrine, as to the surrender and renewal of the patent, was suggested by Mr. Justice Thompson in a case that came before him in 1824, in which he remarked, "I see no insuperable objection to entering a *vacatur* of the patent of record in the Department of State, if taken out inadvertently and by mistake. All the proceedings in that department, on the subject of patents, are *ex parte*, except in the case of interfering applications. The department act rather ministerially than judicially, and upon the representation of the applicant, without entering into the question of right, and there seems to be no good reason why, on a like *ex parte* application, the patent may not be surrendered, and canceled of record, if no misconduct be imputable to the patentee in taking it out. And in such case, as the exclusive right is not to exceed fourteen years, the second patent may be limited according to circumstances, and thereby secure both to the patentee and the public their respective rights." (*Morris v. Huntington*, 1 *Paine*, 355.)

This doctrine was afterward distinctly adopted by the Supreme Court. (*Townsend v. Raymond*, 6 *Pet.*, 220; *Shaw v. Cooper*, 7 *Pet.*, 292.)

In confirmation of the construction thus given to the patent law of 1793 the fifth section of the additional law of 1832 was passed, by which it is enacted that "whenever any patent shall be invalid or inoperative, by reason that any of the terms and conditions prescribed

in the third section in the said act (of 1793) have not, by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, been complied with on the part of the said inventor, it shall be lawful for the Secretary of State, upon the surrender to him of such patent, to cause a new one to be granted to the said inventor, for the same invention, for the residue of the period then unexpired, for which the original patent was granted, upon his compliance with the terms and conditions prescribed in the said third section of said act."

The law was thus put upon a liberal footing in respect to patentees, and the act of 1836, section thirteen, made a similar provision. (*Phillips on Patents*, 301.)

358. PROVISIONS OF THE ACT OF JULY 8, 1870.—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 specifications, to be issued to the patentee, or, in the case of his death or assignment of the whole or any undivided part of the original patent, to his executors, administrators, or assigns, for the unexpired part of the term of the original patent, the surrender of which shall take effect upon the issue of the amended patent; and 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 reissue of each of such reissued letters patent. And the specification and claim in every such case shall be subject to revision and restriction in the same manner as original applications are. And the patent so reissued, together with the corrected specification, shall have the effect and operation in law, on the trial of all actions for causes thereafter arising, as though 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 a part of the original invention, and was omitted from the specification by inadvertence, accident, or mistake, as aforesaid. (*Act of July 8, 1870, § 53.*)

359. TO WHOM GRANTED.—A reissue is granted to the original patentee, his legal representatives, or the assignees of the entire interest, when, by reason of a defective or insufficient specification, the original patent is inoperative or invalid, provided the error has arisen from inadvertence, accident, or mistake, and without any fraudulent or deceptive intention. (*Patent Office Rules, July, 1870.*)

The sole right to surrender is given, 1, to the patentee if he is alive and has made no assignment of the original patent; 2, to the executors and administrators of the patent after his decease, when there has been no such assignment; 3, to the assignee, after the death of the

inventor, when there has been an assignment of the original patent. Where, however, there has been an assignment of an undivided part of the whole patent the assignee of such part and the patentee become joint owners of the patent, and should join in the surrender; and if they do not, it will be invalid unless the part owner not joining shall ratify it. But a licensee or one who has had transferred to him a less or different interest than either the interest in the whole patent or an undivided part of such interest, or an exclusive sectional interest, has no legal right as assignee to surrender, and a surrender without his concurrence is valid. (*Potter v. Holland*, 1 *Fish.*, 327.)

360. APPLICATION MUST BE MADE BY INVENTOR, IF LIVING, IN CASE OF ASSIGNMENT.—Patents may be granted and issued or reissued to the assignee of the inventor or discoverer, the assignment thereof being first entered of record in the Patent Office; but in such case the application for the patent shall be made and the specification sworn to by the inventor or discoverer, and also, if he be living, in case of an application for reissue, (*Act of July 8, 1870, § 33*;) but if the inventor be dead, the application may be made and the specification sworn to by assignees.

361. CONCURRENCE OF PARTIES.—The petition must show that all parties owning an undivided interest in the patent concur in the surrender. (*Patent Office Rules, July, 1870.*)

362. RIGHTS OF ASSIGNEES.—It is not in the power of a patentee, by the surrender of his patent, to affect the rights of third persons to whom he has previously by assignment passed his interest in a whole or a part of

the patent, without the consent of such assignees. (*Potter v. Holland*, 1 *Fish.*, 327; *Woodworth v. Stone*, 3 *Story*, 750; *Smith v. Mercer*, 4 *West. Law Jour.*, 52; *McBurney v. Goodyear*, 11 *Cush.*, 571.) The reissued patent operates from the commencement of the original, and will inure to the benefit of assignees who became such before the reissue, although no assignment is made to them after the reissue. (*Woodworth v. Hall*, 1 *Wood. & Minot*, 248.)

A surrender of letters patent renders void all assignments so far as those are concerned who assent to the surrender. It is necessary that a prior assignee should have a new assignment before he can maintain an action for an invasion of the patent. (*Gibson v. Richards*, *Index Pat. Dec.*, No. 376.) Consent may be manifested by joining in the surrender, or previously authorizing it, or subsequently ratifying or approving it; and taking an advantage and benefit of it would be a ratification; and when so consented to the rights of the party consenting in and to the old patent are forever gone. (*Potter v. Holland* 1 *Fish.*, 327.) Assignees are not compelled to take under the reissued patent, and give up the right had under the old one. They may, if they prefer, rest their claims upon the specification as it stood when they purchased their right, (*Smith v. Mercer*, 4 *West. Law Jour.*, 52;) and there may be one claim of right under the old patent for one section of country and a different claim of right under the reissued patent for another section of country. (*Potter v. Holland*, 1 *Fish.*, 327.)

Where there has been an assignment of an undivided part of the whole original patent, in such case the assignee of such a part and the patentee become joint

owners of the patent, and should join in the surrender; and, if they do not, it will be invalid, unless the part owner not joining shall ratify it. (*Potter v. Holland*, 1 *Fish.*, 327.)

A person to whom the patentee has passed his interest in a part of the old patent, upon the surrender of the same by the patentee, and obtaining a reissued patent, is entitled to the same right, under the reissued patent, that he had to the old one. (*Ib.*) He may, however, elect to hold under the old patent, and it is not a valid objection, that in such case there would be different claims of right in the same invention secured to different sectional owners. (*Ib.*)

A reissue does not *inure* to the benefit of a prior assignee. He takes by ratification, not by inurement. (*Burdell v. Denig*, 2 *Fish.*, 589.)

363. STATEMENT OF TITLE.—A statement under oath of the title of the party proposing to surrender must be filed with the application. (*Ib.*)

364. APPLICATION FOR REISSUE ACTED ON AS SOON AS FILED.—Reissued patents expire at the end of the term for which the original patent was granted; for this reason applications for reissue will be acted on as soon as filed. (*Ib.*)

365. DEFECTS CURED BY REISSUE.—The act contemplates two classes of cases in which reissues may be granted: First, where the patent is *inoperative* and *invalid* by reason of a defective or insufficient specification; second, where the objection arises by reason of the patentee claiming as his own invention more than he had a right to claim as new, (*Goodyear v. Day*, MS. *New Jersey*, 1852;) but whether the defect be in the specification or claim, the

patentee may surrender his patent, and by an amended specification or claim cure the defect.

There is nothing in the act which requires the patentee to claim all things in a reissued patent which were claimed as his original invention in his original patent. A specification may be defective as well by an excess of claim as by a defect in the mode of stating it, and the inventor is always at liberty to omit part of his original invention if he deems it expedient, (*Carver v. Braintree Company*, 2 Story, 439;) and he is not bound to include in his reissued patent improvements to which he may have been actually entitled under the original patent, (*Knight v. Baltimore and Ohio Railroad Company*, 3 Fish., 1;) and where the claim in the original was for a new article of manufacture, and in the reissue it was for a combination and arrangement of the parts, it was held that the former claim was unfortunate, as changes could be made to avoid the patent while retaining the principle of the invention, and that the defect was curable by reissue. (*Middletown Tool Company v. Judd*, 3 Fish., 141.)

It is not necessary that there should have been any adjudication upon the patent in order to justify a reissue; the oath of the party as to the existence of the facts required for a reissue is enough, (*Bull ex parte*, MS. Appeal Cases, 1860;) and though the old specification had been adjudged good; yet if defective, so as to be open to litigation, and thus somewhat "inoperative," the Commissioner may reissue it. (*Woodworth v. Edwards*, 3 Wood. & Minot, 126.)

The disclaimer of a part of an invention in the original application, provided such disclaimer arose from inadvertency, accident, or mistake, will not prevent the pat-

antee from embracing the part so disclaimed in a reissue of his patent, (*Hayden ex parte*, *MS. Appeal Cases*, *D. C.*, 1860,) and a statement in an original patent that a part is old does not prevent such part being claimed in a reissued patent, though it seems it would have that effect if made advisedly. (*Laidly v. James*, *MS. Appeal Cases*, *D. C.*, 1860.)

866. THERE MAY BE MORE THAN ONE REISSUE.—There may be more than one reissue of the same patent. There is nothing in the patent acts that limits the correction of errors to such as may have been the first discovered. (*French v. Rogers*, 1 *Fish.*, 183.) The surrender and reissue, no matter how often they recur, are reciprocal, each in consideration of the other, and form together but a single act; and it is for the public interest that the surrender and reissue should be allowed to follow each other as often as the patentee is content to be more specific or modest in his claims. (*Ib.*)

But where the patentee surrendered his original patent and obtained a reissue, and afterwards surrendered the reissued patent and obtained a second reissue, it was held that the original patent having been canceled when the first reissue was granted, the second reissue was not valid unless the improvement described in it was in its principle and mode of operation the same with that intended to be described in the first reissue. (*Knight v. Baltimore and Ohio Railroad Company*, 3 *Fish.*, 1.)

When a patent has issued in one division of an application for a reissue the original patent is dead, and no new division can be entertained. (*Whitely and Gage ex parte*, *Commissioners' Decisions*, 1869, p. 63.)

And after one patent has issued, upon an application

for a reissue the original patent is annulled, and no new division can be entertained.

In the case of *Whitely ex parte*, (*MS. Appeal Cases, D. C.*, 1869,) it was held by Chief Justice Cartter that the surrender of a patent and letters patent granted in reissue, for the same subject, upon such surrender is death to the first patent and life to the second. Whatever of title to the subject of the patent survives is to be found in the letters of reissue, and not in the patent out of which such letters grow; and any application made thereafter for reissue should be based upon the reissued letters patent.

367. USE UNDER THE DEFECTIVE PATENT.—No prior use of an invention under a defective patent can take away the right to surrender and reissue such patent, or authorize a use under the renewed patent, (*Stimson v. Western Railroad*, 4 *How.*, 402;) and the fact that the thing described in an original patent had been in public use in the interval between the issue of the original and reissue, does not exclude an inventor from the right to resume them in a reissue. (*Goodyear v. Day*, *MS., N. J.*, 1852.)

368. REISSUE DURING EXTENDED TERM.—The Commissioner can lawfully reissue letters patent on an amended specification after the expiration of the original patent and during the existence of an extended term. (*Wilson v. Rosseau*, 4 *How.*, 688.) The extended patent of twenty-one years is, in such case, to be regarded as the "original patent," within the meaning of § 13 of the act of 1836, (*Gibson v. Harris*, 1 *Blatchf.*, 169;) and the reissue of a patent extended by act of Congress to twenty-eight years, after it had been previously extended to twenty-one years, stands on the same footing. There is no

difference in principle. (*Ib.*; *Woodworth v. Edwards*, 8 *Wood. & Minot*, 128.)

369. A CLERICAL ERROR WILL BE CORRECTED WITHOUT FEES IF IT OCCURRED THROUGH THE FAULT OF THE OFFICE.— Before the passage of the act of 1836, the Supreme Court of the United States held, (*Grant v. Raymond*, 6 *Pet.*, 242; *Shaw v. Cooper*, 7 *Pet.*, 314,) that a defective patent might be surrendered, canceled, and reissued to correct an honest mistake on the part of the patentee, or an error committed by the office.

The 13th section of the act of 1836 provides for surrenders and reissues in two specified cases, but is silent as to all other grounds of surrender. It is believed that the right of the patentee to surrender his patent for the correction of errors committed by the office remains unaffected by the legislation contained in that section. It could never have been the intention of the legislature to restrict the correction of mistakes to those enumerated, or to declare that the errors of the office should not be reformed as promptly as those of the patentee.

Accordingly it has been the practice of the office to correct all errors in parties' names, titles, dates, and all omissions or insertions of words made by the fault of the office, upon the surrender of a patent, without fee, but to require the patentee, when seeking the correction of his own mistakes, to pay the fee and conform to the provisions made for cases of reissue.

In *Dental Vulcanite Company v. Wetherbee*, 3 *Fish.*, 87, a patent thus corrected came under the review of the full court in the district of Massachusetts. In that case, after an assignment of the entire interest of an inventor, the application for reissue was signed by the patentee,

and the reissue was granted to him instead of to his assignee. The court, by Mr. Justice Clifford, say: "Whether the mistake was first discovered by the Patent Office, or by the party named as patentee, does not appear, but it does appear that the letters patent were immediately returned to the Commissioner, and the mistake was corrected as a clerical error. Unless it could be corrected as a clerical error it could not be corrected at all, as it was clearly not a case falling within the provision authorizing a surrender and reissue." Again: "Second surrender was asked merely to correct an error of date in the first reissue, and it is obvious that the suggestion of error was well founded, and that the correction requested was one proper to be made."

In *Detmold's case*, (4 *Opinions*, 385,) Nelson, Attorney General, held that the date of a patent may be altered to correspond with that of a foreign patent, previously taken out by the inventor, where the mistake has not arisen from any fraudulent or deceptive intention. (See also *Smith v. Ely*, 5 *McLean*, 78-86; *James Cochran*, *Commissioners' Decisions*, 1867, p. 60.)

370. ERROR THROUGH THE FAULT OF THE PATENTEE WILL BE CORRECTED ONLY BY REISSUE ON THE USUAL TERMS.—A patentee when seeking the correction of his own mistakes is required to pay the fee required by law and conform to the provisions made for cases of reissue. (*Ib.*) In the case of *Havemeyer ex parte* the Commissioner says: "This is a motion on the part of the American Papier Maché Company for the correction of an alleged clerical error. The facts are briefly as follows: Letters patent for an improvement in the manufacture of sugar molds, and other articles, were granted to Carl Kronig

in 1864. In 1868, this patent was returned with the following petition: 'The petition of Theodore A. Havemeyer, J. Lawrence Elder, and Charles F. Loosey, of New York city, respectfully represents: That your petitioners are the sole owners, by assignment, entered of record, of letters patent of the United States, granted to Carl Kronig, of Vienna, in the Empire of Austria. They therefore pray that they may be permitted to surrender the said letters patent, and that the same may be canceled and new letters patent issued *to your petitioners* on an amended specification,' &c.

"In the letter transmitting this application mention was made of an inclosed assignment from Havemeyer, Elder & Loosey to the American Papier Maché Company for record, but no request was made for the issue of letters patent to the last assignees.

"The patent was issued April 14, 1868, in accordance with the request of the petition, to Havemeyer, Elder & Loosey. The American Papier Maché Company now comes in, after a lapse of nearly two years, and asserts that the patent should have issued to it, and that the failure so to issue it was a clerical error on the part of the Commissioner, which ought to be corrected without further reissue or expense to the applicant.

"The act of March 3, 1837, § 6, provides 'That any patent hereafter to be issued may be made and issued to the assignee or assignees of the inventor or discoverer, the assignment thereof being first entered of record, and the application therefor being duly made, and the specification duly sworn to by the inventor.'

"The language is, '*may* be made and issued,' not 'shall be,' and it has been the constant practice of the