

When any doubt exists as to the applicability of Rule 48, notwithstanding the omission of the Patent Office to invoke the rule, it is by all means desirable to file the supplemental oath accompanying the subject-matter, the proper presentation of which as a part of the invention at the time of filing the application, is doubtful. Here again comes into evidence the importance of a true and complete statement of invention. By supplying the oath there is an increased factor of safety surrounding the validity of the patent, and, if desired, the affidavit may be filed at any time during the pendency of the application.

D. Rule 63—Certain Cases Having Preference

(Sec. b) While it is unusual that prompt examination of reissue applications, upon filing of the same, is overlooked, it is well to know that such applications are entitled to practically immediate consideration on the part of the Examiner, both upon the filing of such applications, and after each amendment and argument submitted therein.

(Sec. f) A valid United States patent can not be issued on an application the subject-matter of which is covered by a patent issued in a foreign country on an application filed more than twelve months previous to the filing of the United States application. Thus it is that, owing to the requirements in certain foreign countries, necessitating the issue of patents on patent applications within certain limits of time, care must be taken by the practitioner to insure the issue in the United States of the letters patent with utmost promptness. Should it happen that the applicant here has an application or applications filed abroad more than twelve months prior to his United States case, on which foreign application or applications issue of the letters patent is imminent, the patent must issue first in this country, to be valid. Cases of this kind will usually be given preference over others. The Examiner's at-

tention should be directed to the condition of affairs in writing, however, either upon filing the application, or when making amendments, but preferably by personal interview to insure against likelihood of loss of time.

E. Rule 66—Requirement That Examiner Cite Best References

There is no way in which an applicant or his counsel may compel the citation of the best references at the command of the Patent Office during the examination of the application. To some extent, the citation of many references in the rejection of an application is due to the failure of the applicant to claim his invention fully and properly at the outstart of the prosecution of his case. It is, therefore, advisable, upon the drawing up of an application, to present to the Patent Office claims which represent a substantially complete original presentation of the protection intended to be obtained. The extreme cases where counsel is constrained to feel much provoked at the persistent presentation of new references in rejection of an application, references which might have been cited at the commencement of the rejecting actions, are worthy of comment only to the extent of making more forcible the suggestion above given.

In regard to the general run of applications, the pertinency of references is either obvious, or ascertainable, with the expense of no great effort on the part of applicant or counsel. In relation, however, to complicated inventions it is to be reasonably expected of the Examiner, who is ordinarily an expert in the particular arts or classes of an art customarily examined by him, that reference patents covering complicated machines, processes, or compositions, be applied at the time of rejection. Especially is this true when it is borne in mind that the Examiner should be able to present the pertinency of a citation of which he is cognizant, with little or no trouble,

and that without an explanation a heavy burden is placed upon the applicant to determine just how the reference may apply to a particular claim or claims. While it is best not to resort to the rule unless absolutely necessary, where conditions warrant the applicant is entitled to insist that a non-obvious reference be fully explained and applied to a claim or claims, and until so applied, the applicant may reserve response to a rejection as required by Rule 68.

F. Rule 69—Duty of Applicant in Forwarding Prosecution

Where thousands and thousands of applications for patents must needs be acted upon, not only once, but in many properly contested cases again and again, the necessity of a fairly strict compliance with practise which experience has proved prerequisite to facilitating the tremendous business of the patent department, is evident. Rule 68 speaks for itself to a large extent, but some words of caution may be given which will be especially appreciated by the young practitioner. Care should be taken to observe that when an application has been once rejected it is incumbent upon the applicant to present fully, in response to the rejection, reasons why the claims contended for are not anticipated, or amend the claim or claims, or submit new claims with a view to completely distinguishing from the references. If the prosecution of the case be pursued along these lines and the applicant does not indicate any lack of understanding of the references, the Examiner, in giving the necessary reconsideration of the application, is in a position immediately to finally reject the case, should he rely upon his original grounds for refusing the patent. The precaution is, therefore, taken by most solicitors, in submitting a case for second consideration, to show fully the impropriety of the grounds of rejection and request the Examiner to point out specifically wherein he considers the references anticipatory of the claims, or explain any other of

the grounds of rejection which are not clear, the applicant at the same time offering to make amendment or otherwise revise his case upon receiving a further rejection with the desired explanation. By indicating a lack of understanding of the relevancy of the prior art when its applicability is not too obvious, possibility of a final rejection is ordinarily avoided.

The point to be observed especially is that the applicant should make a *bona fide* effort to present his invention, after rejection of his application, in such a way as to permit the Examiner to concede the allowance of his patent. The patent examiners are almost invariably capable men, and able to recognize what may be called a *bona fide* effort to advance a patent case to issue, as distinguished from a *buncombe* effort. In nine cases out of ten, furthermore, the applicant is not likely to suffer through the too severe application of Rules 68 and 69. Unfortunately, however, it is the tenth case that not infrequently proves to be exactly the one in which the applicant or his counsel most wish to prevent a peremptory conclusion of the prosecution, so that too much emphasis may not be laid upon the practise empowering the Examiner to finally reject an application if said application is submitted to consideration a second time under the following conditions:

(1) Without a definite statement sufficiently convincing to establish the contentions of the applicant.

(2) In the absence of a request of the applicant for assistance as to the manner of construing references.

(3) In the absence of a *bona fide* request of the applicant for a more complete setting forth of the ground or grounds of a rejection not clearly obvious, supplemented by the suggestion that final action be deferred until the rejection is fully understood.

(4) In the absence of a showing not requiring the citation by the Examiner of new references or new grounds of rejection.

(5) In the absence of a presentation of the applicant's case representing more than a mere unsupported allegation of error on the part of the Examiner in making the rejection.

It is doubtful whether the Patent Office is sufficiently stringent in closing up the prosecution of patent applications.

The applicant is allowed one year from an official action or rejection, in which to answer the same. The statute allowing this period must have contemplated that the mails might require two to four months, going and coming, in order to effect transmission of the papers passing between the Office and the applicant. The year period is an absurdity. On rejection it is quite appropriate that the Examiner be empowered to set from thirty to ninety days for a response such as required by the condition of the case. The burden incident to the prosecution of patent applications, commonly for periods of from two to five years or longer, might in this manner be relieved. The practise suggested is used by other countries, and our statute should long ago have been repealed, and the Commissioner of Patents empowered to control the time allowed for replies to official actions or rejections, in his discretion. For certain things, i.e., correction of informalities, fifteen days is ample time to respond; now the applicant is within his rights to take a year.

G. Rule 70—New Matter May Not Be Added to an Application Subsequent to Its Filing

It will be recalled that in the previous discussion of Rule 48 permitting the filing of a supplemental oath, the oath allowed to be submitted related to matter which was shown or described in one way or another at the time of the original presentation of the application to the Patent Office. That which constitutes new matter, therefore, must not be confused with what is a part of an invention originally presented to the

Patent Office *but not substantially embraced in the application when filed as a part of the invention.* The latter omission, due often to the non-recognition at the early stages of the prosecution of a case, of an essential part of an invention, or the failure of an inventor to properly present his invention to his counsel or to the Patent Office, or other frequently uncontrollable conditions, may be very clearly distinguished from an attempt to introduce new matter into a patent application. There are certain cases where much difficulty indeed may be experienced in determining whether belated matter introduced is new, but reference is now particularly made to the average problem involved in relation to new matter.

If the matter attempted to be introduced into the case is something which may not fairly be said to have been shown in the drawings, or described clearly or by way of clear inference in the specification or claims, in the absence of a showing in the drawing, such matter is new matter in the sense of Rule 70. If shown in the drawings it may be described; if described, it may be illustrated, and in either event it is not new matter, but is within the purview of Rule 48 under certain conditions. Where the matter attempted to be introduced is of importance, a considerable amount of care necessarily should be exercised in reaching a conclusion as to whether the applicant is entitled to include the same, and since there is a line of authorities which fully establish the practise, these authorities may be consulted with excellent results. (See chapter on *New Matter*, pages 103 to 112.)

There is suggested in the later discussion of reissues that a statutory basis exists for the introduction of new matter in a reissue application, where neither a drawing, nor a model, is used. The question arises whether this privilege extends equally to an original non-reissue application. Query: Is Rule 70 really opposed to the spirit and letter of the statute, and therefore invalid as to one class of applications at least, if not two classes?

H. Rule 75—"Swearing Back" of References. The Law of Rejection by Combining Prior Art and Prior Invention

The condition arises in practise that during the prosecution of an application for patent a reference is at times cited, consisting of a domestic or foreign patent, which shows but does not claim the invention that is covered by the application. A peculiar situation is thus created because upon the status of such a reference may rest the allowability of the entire patent, or at least, the allowance of broad claims of great relative importance.

There are two things which may be done.

First, if the applicant's invention was completed prior to the filing date of the patent, the applicant, against whom the patent has been cited in rejection, may "swear back" of the reference. By this is meant that by presenting a verified showing of facts or evidence, or both, establishing clearly a completion of his invention prior to the domestic patentee's filing date, the applicant may obtain the allowance of a patent to him, which will dominate or cover the invention of a prior applicant and patentee. Regarding a prior foreign patent the showing need only antedate the *date of the patent*.

This procedure seems strange, and by some it is deemed unwarranted, and unfair to the patentee, who has no knowledge of the proceeding whatever. Without discussing the merits of this phase of the practise, it is proper to indicate that Rule 75 is based upon the theory that the patentee had the opportunity or privilege of asking for the broad claim or claims, and not having done so, his failure must legally be ascribed to either of two things. He either dedicated the subject matter unclaimed to the public, or he did not deem himself the inventor thereof. The first assumption is a proper one to be legally inferred, though an absurd one from a fair view of the working out of the practise. The second assump-

tion is most unlikely to be true. In the memory of the author all instances where Rule 75 has been brought into use are due to inability or negligence on the part of the patent solicitor of the patentee in failing to properly claim the invention, thereby enabling the second party or applicant to do so practically in a *clandestine* manner.

The foregoing is a simple exposition of the clear operation of Rule 75.

If the conditions are as stated, and the second applicant is unable to "antedate" or "swear back" of the reference, there is nothing to do but accept the rejection as based properly on the ground of *prior invention*, not anticipation by prior art, or prior use, etc.

This brings us to an important phase of the operation of Rule 75 which it is essential to know, and which, furthermore, is most easily understood on reference to an example.

A has an application pending, and, after considerable prosecution effort, excellent claims are secured over a number of cited patents in the prior art. In the midst of the prosecution, a patent of *B* issues and has some general relation or pertinency to the invention of *A* resting in application. The Patent Examiner notes the issue of *B*'s patent, which is based on an application filed earlier than that of *A*. The Examiner thereupon rejects *A*'s application on the ground that the claims of *A* are anticipated by the patent of *B* taken in connection with *C*'s patent which was previously cited in the application of *A*.

A rejection of the above character is ordinarily improper, because the Examiner is combining a prior art patent with a patent which was not in existence prior to the filing of *A*'s application, and therefore not prior art, namely, *B*'s patent, in order to build up a basis of rejection by anticipation.

The unreasonableness of the foregoing is based upon a common sense explanation. The Examiner in effect says, "Your claims are anticipated because it was not invention to

modify the construction of *C*'s old prior art patent in accordance with *B*'s prior invention." This sounds plausible, superficially, but the fallacy lies in the fact that there are being combined to make this rejection, prior art and prior secret invention references. For this there is no warranty under a fair and reasonable interpretation of American patent practise. In a more simple expression, it is not right, under the laws of common sense, and statutory legal bars, to hold that an invention be considered as anticipated by *C*'s old patent over which a patent was allowable to the applicant *A*, owing to some prior invention of *B* that was secreted in the confidential archives of the Patent Office, never seen or heard of by *A*, never in a position to be availed of by him to assist him or any one else in evolving his invention, and never in any sense *prior art*. Had *B*'s invention been in public use, before *A*'s filing date, then it would be prior art and combinable with *C*'s prior art reference, to constitute a valid rejection. Such was not the ground of rejection, however.

The Patent Office for a long while fell into the error of making rejections of the above nature, and does now at times, but the proper law is laid down in *Ex parte Thomas* 251 O. G., page 839, elucidated in *Ex parte Allen* 267 O. G., page 487.

Under these authorities it must be understood that in a case such as outlined above, Rule 75 is inapplicable. The applicant *A* can and should properly refuse to attempt to "swear back" of *B*'s patent. He does not have to do so, in order to obtain a patent, if both references are required upon which to base the rejection.

Generally, the practise laid down by the two cases referred to is this, adhering to the example to assist in the explanation :

1. If the claims sought by *A* are readable on *B*'s patent as to all essential and patentable particulars, the issue is one of prior invention, not anticipation, and the patent of *B* is a valid reference alone. That is, if the claims could be made issues of an interference be-

tween *A* and *B* then *A* must swear back of them or *B* is available as a *prior invention* reference.

2. If an interference could not have been declared between *A* and *B*, then *B*'s patent is not a reference as a *prior invention* subject to a single qualification, leading to an opposite view.

3. The qualification of 2, *supra*, is that the only differences between *B*'s prior invention, and *A*'s invention, are inconsequential and immaterial, and do not constitute invention.

It must be recalled that in the example given at the out-start there was need to cite a second reference patent of *C*, and combine it with *B*'s patent. This indicates that there was some phase of invention to be answered by *C* and shows that *B* was inadequate, making the rejection invalid as combining prior art and prior invention alone, two things that should not and do not mix, for purposes of patent application rejections, or patent invalidation. When prior invention becomes prior art that is quite another thing.

The Patent Office was not alone in becoming lost in the maze of a mixture of prior art and prior invention grounds of anticipation. The Federal Courts have likewise unduly confused these two wholly separate and distinct statutory grounds of refusing and invalidating patents. A reading of the case of *Lemley vs. Dobson*, 243 F. R., page 391, 246 O. G. 1203, will greatly enlighten regarding the depths to which the courts have sunk in this gravely important and much misunderstood angle of patent law. That it is possible for a court to hold that new and real invention, *X*, is anticipated by a prior patented invention, *Y*, as changed or altered in the light of another invention, *Z*, prior to the new invention, *X*, but never available to the inventor because hidden away in a secret place (neither prior thing of itself constituting the invention), seems incomprehensible to thinking students of patent law. And yet such has been the holding in several instances by courts of certain circuits.

The lack of acquaintanceship of both the bench and bar with the *principles* of the law in this connection has made desirable this complete explanation, and only superficial knowledge of the true theories concerning conception of inventions could lead to the error. Until the United States Supreme Court has laid down the law finally along the lines of *Ex parte Thomas*, the courts will doubtless do much irreparable injury to the interests of inventors and patent owners. The rulings thus far are not at all consistent in different jurisdictions.*

If the law compelled more prompt issue of patents, say within eighteen months' time, there would be less application of Rule 75. At least, it would seem fair to the patentee who may be antedated under the rule that notice be given of the application of the rule, because the procedure can readily emasculate the earlier patent. The notice would lead in nine cases out of ten to a reissue of the earlier patent, and an interference determining the *true inventor*.

No "swearing back" is permitted in respect to a patent issued more than two years prior to the application.

*At the time of the publication of *Lemley vs. Dobson*, supra, the author sought to cooperate to bring this cause to the attention of the United States Supreme Court, by certiorari, but the time limit had then expired.

VIII

APPEALS

Appeal to Board of Examiners-in-Chief

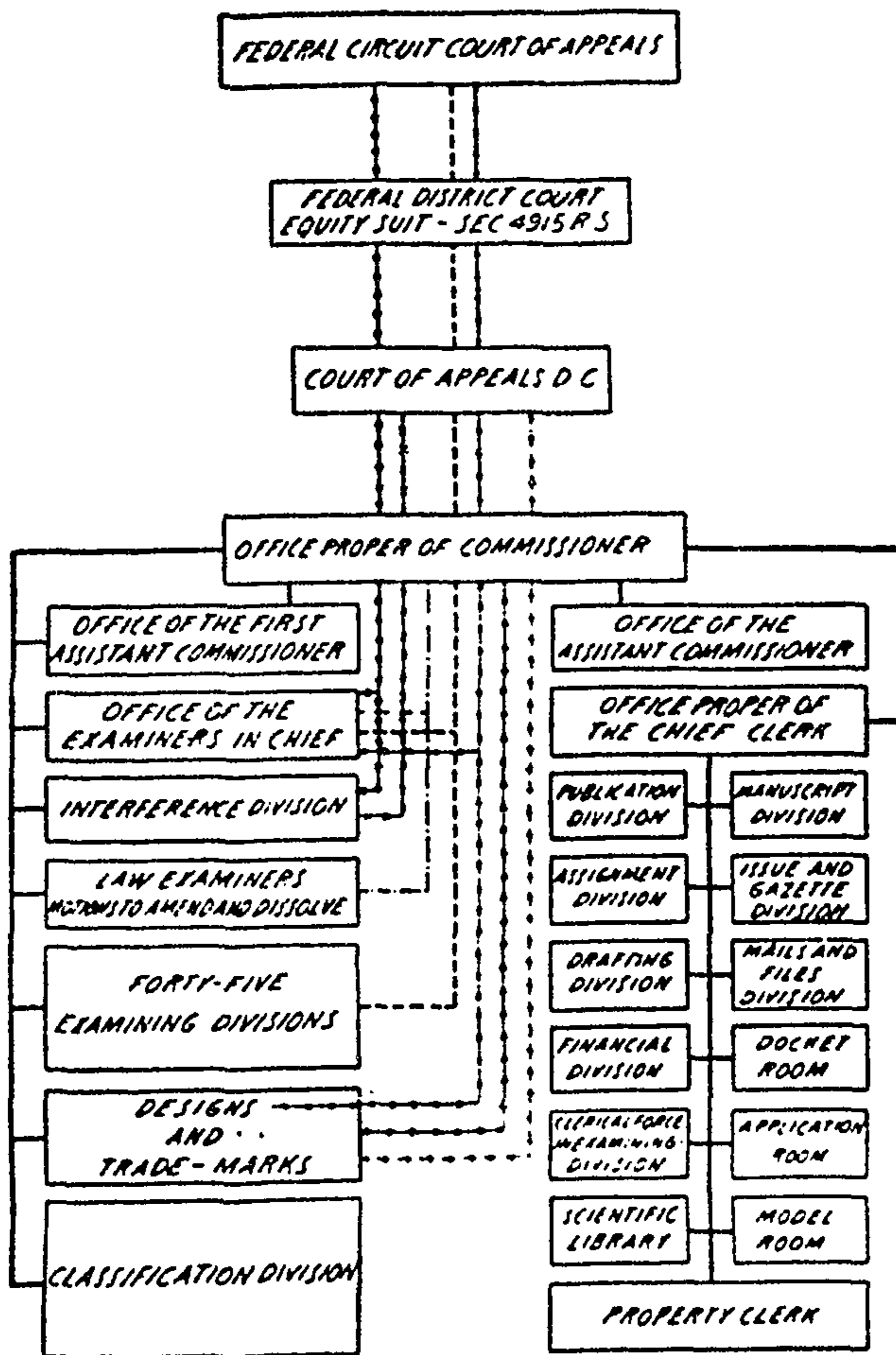
Once filed in the Patent Office, an application is examined first ostensibly by the Primary Examiner, but in reality usually by one of his assistants of whom there are often five to ten. The examination is supervised by the Primary Examiner, and the action had as a result of the examination is customarily under his direction.

The action, see specimens, pages 347 and 361, is either a rejection or allowance of claims, or both, presents objections to form, or makes the requirement for division.

Assuming the case formal and no division necessary, there ensues between the applicant (by his counsel) and the Examiner, a contest for claims as protection. In the United States practise, and with the possible exception of the German, this contest is the hardest fought of any required in the patent offices of the world. So much is this true, that on the subject of invention alone it is not uncommon for six to eight written and oral arguments to be made. It is doubtful whether in any legal proceedings anywhere, such arduous effort is required as is necessary in soliciting patents to present claimed subject matter properly.

A difference arising as to any matter of form in this proceeding would be petitionable to the Commissioner in person, see subject of Petitions, page 227, but if the difference affects the merits of the case, as when based on the patentability of the claims as combinations, aggregations, incorporating new matter, etc., the question may be raised only by appeal.

The first appeal is to the Board of Examiners-in-Chief and



LINES OF APPEAL

- ADMINISTRATIVE CONTROL
- EX PARTE TRADE-MARK APPLICATIONS
- EX PARTE DESIGN PATENT APPLICATIONS
- OTHER EX PARTE PATENT APPLICATIONS
- EX PARTE PRINTS AND LABELS
- PATENT AND DESIGN INTERFERENCES
- INTERFERENCE MOTIONS
- TRADE-MARK INTERFERENCES, CANCELLATION, AND OPPOSITION PROCEEDINGS

CHART SHOWING GENERAL LINES OF APPEAL

By M. H. Coulston—From Journal of Patent Office Society.

must be filed within one year from a final rejection. It takes a form of which an example is found on page 385, subject to reasonable modification within the discretion of counsel, and somewhat according to his whim. An appeal once filed is docketed and counsel is notified of the date of the hearing, if one is requested. A hearing may be asked or waived as desired by the appellant.

Appeals are conducted quite formally before this board which consists of five superior Examiners ranking above the Primary Examiners, and usually supplied from that class when appointed. Three of these Examiners at a time usually officiate at hearings which take place in a regular court room, the Examiners-in-Chief sitting on the bench very much the same as three judges of the United States Circuit Courts of Appeals. After the manner of courts, one of the Examiners, not announced, usually has the particular case for decision and his associates may assent or dissent to the final decision, with or without a written opinion. Opinions handed down are customarily in writing and briefly explanatory of the grounds of affirmance or reversal of the Primary Examiner.

It is questionable whether the appeal to the board represents much more in many cases than the studied opinion of one Examiner. It is not less effective, however, for that Examiner has had a large experience in regard to the merits and demerits of the rejections made by the whole corps of Principal Examiners, and with such knowledge he can ordinarily arrive at a fair conclusion in the case. What is needed most often on an appeal is a fair review, by an unbiassed third party, of the opposite contentions involved, and it is doubtful whether any legal tribunals of the country afford this as much as do those of the Patent Office. Where any ground of doubt exists as to the position of the deciding Examiner-in-Chief, that is most likely to be developed by a different view set up by a colleague. There are the usual exceptions, necessarily, to the foregoing.

Where only two Chief Examiners sit at a hearing on appeal a division has the effect of affirmance of the Primary Examiner's decision. Since the board has been enlarged to five members it has not been the experience of the author to attend hearings by two Chief Examiners sitting as the board.

An appeal may be withdrawn any time prior to the hearing and the appeal fee will be refunded.

The Examiners-in-Chief hear appeals from the Examiner of Interferences who has jurisdiction of *inter partes* cases, as distinguished from *ex parte* cases first treated herein.

The government fee on appeal to this board is \$10.00.

Appeals to Commissioner

From the decision of the Board of Examiners-in-Chief an appeal lies to the Commissioner of Patents in person. In practise this appeal is heard by either the Commissioner, the First Assistant Commissioner, or the Assistant Commissioner.

While it is very true that this appeal is helpful at times in the interest of improving the office practise, many students of official procedure including the author believe it should be dispensed with. It is an additional expense, time-consuming and frequently affords only a review of a decision of the Examiner-in-Chief by a less skilled or qualified single official.

Why this intermediate appeal, between that to the board and that to the Court of Appeals of the District of Columbia, was ever established or maintained, is not clear.

One year is again allowed in which to complete an appeal from the Examiners-in-Chief to the Commissioner. This is afforded by Section 4894 R. S., and involves a useless waste of time not conducive to expeditious issue of patents. This applies to *ex parte* cases; in interference cases the board usually sets a time limit of twenty or thirty days, something eminently desirable.

When a hearing is requested on the appeal to the Commis-

sioner, a time will be set and notice given of the date when the appeal hearing is docketed, also in regular course counsel or the applicant is advised as to whether the Commissioner, or one of his assistants, and which one, will hear the case. As a general thing, the Commissioner (or assistant) hears the argument on appeal in his chambers.

The government fee on this appeal is \$20.00, payable on filing the appeal and after a decision, another appeal may be taken to the Court of Appeals of the District of Columbia.

Petition—(A Form of Appeal)

One of two modes of questioning the propriety of a certain action or requirement of the Primary Examiner or subordinate official of the Patent Office, is by way of direct petition to the Commissioner in person.

Petitions are special appeals, so to speak, relying upon the Commissioner to exercise supervisory authority in the matter at bar.

Rule 142 affecting petitions reads as follows:

142. Upon receiving a petition stating concisely and clearly any proper question which has been twice acted upon by the Examiner, and which does not involve the merits of the invention claimed, the rejection of a claim or a requirement for division, and also stating the facts involved and the point or points to be reviewed, an order will be made directing the Examiner to furnish a written statement of the grounds of his decision upon the matters averred within five days. The Examiner shall at the time of making such statement furnish a copy thereof to the petitioner. No fee is required for such a petition. Hearing will be granted in the discretion of the Commissioner.

The intent of the remedy by petition is to afford some way in which a formal requirement of the Primary Examiners, or a question of practise of importance, may be reviewed without

appeals and with expedition. For the Commissioner to determine whether an applicant has presented a claim in suitable form to comply with the law—a purely formal matter—by the method of appeal, would require two appeals, and considerable time and expense, especially if the appeal dockets of the Board of Examiners-in-Chief and Commissioner are crowded, as usual. And, too, the question involved, while of no small importance to the applicant, is most often one of practise, and can usually be settled quite promptly, so that to have it raised by appeal would tend only to clog the already hard-worked machinery of the Patent Office bureaus.

A petition to the Commissioner, therefore, is allowable following the general rule that it does not affect the merits of the case. That is to say, the question of patentability of an invention will not be settled by the Commissioner on petition; it is appealable to the Board of Examiners-in-Chief in the first instance. A divisional requirement may not now be questioned by petition for, since the leading decision of *Steinmetz vs. Allen*,* division has become a matter of merits of the case, instead of a mere formality which latter it doubtless is from a common sense viewpoint.

Sometimes petitionable matters are difficult to distinguish, as regards whether they go to the form or merits, of the case. In such event, the chances are they will be considered by petition if they involve some point which in the judgment of the Commissioner is deemed sufficiently important for him to settle definitely for the purposes of effective administration of the Patent Office.

On page 412 is furnished a specimen of petition involving a question of form very largely, but carrying with it the important proposition of an entire change in practise. In a case of this sort the supervisory authority of the Commissioner is properly invoked, especially because the decision of no tribunal other than His Honor would really be empowered to effectuate

*109 O.G. 549.

that desired to be accomplished. It is notable upon study of the petition referred to, and of the typical case in which it was tried, that the question of whether the merits of the case were involved came up. In the instant example the propositions of form and merits were largely interlocked. But the essential thing raised was a question of practise and the application of the law along lines affecting far more than the invention at bar alone. In such cases, the authority of the Commissioner to supervise all that takes place in his office, where special authority in others is not especially delegated by law, comes into play and has been a boon to the practise in obtaining expeditious and clarifying decisions.

Before filing a petition counsel should scrutinize the grounds carefully and come to the conclusion that there is involved that which is of sufficient real weight and importance for a decision. It is far better to yield to the Examiner on other matters, than to go through the procedure of petitioning, both in the interest of saving the applicant time and money, and especially to avoid saddling upon the high officials of the Patent Office the labor of deciding the importance of the matter raised, and secondly, the petition itself. Frivolous and immaterial matter should not be raised by petition; indeed, as it is within the discretion of the Commissioner to hear a petition, such matters will commonly not be considered by him, though, in the interest of the public, considerable liberality has been shown in hearing these direct appeals.

IX

SPECIAL SUBJECTS

Renewals—Reissues—Abandonment of Inventions and Applications.

Renewals

The matter of renewal of a patent application has been viewed very largely as one of mere formal procedure, when in reality it may have much to do with the validity of the ultimate patent.

Renewal, according to its ordinary meaning, refers to the reopening of the prosecution of an application which has become forfeited for failure to pay the final government fee. Renewals are effected under the provisions of Section 4897, Revised Statutes, which is as follows:

Any person who has an interest in an invention or discovery, whether as inventor, discoverer, or assignee, for which a patent was ordered to issue upon the payment of the final fee, but who fails to make payment thereof within six months from the time at which it was passed and allowed, and notice thereof was sent to the applicant or his agent, shall have a right to make an application for a patent for such invention or discovery the same as in the case of an original application. But such second application must be made within two years after the allowance of the original application. But no person shall be held responsible in damages for the manufacture or use of any article or thing for which a patent was ordered to issue under such renewed application prior to the issue of the patent. And upon the hearing of renewed applications preferred under this section, abandonment shall be considered as a question of fact. (See prior patent statutes: Section 35, 1870; Section 1, 1865; Section 1, 1864.)

There are several important conditions to be noted:

A renewal may be made by any one who has an interest in the invention or discovery.

A renewal must be effected within two years after the allowance of the original application. This is construed to mean the first allowance.

On hearing of renewed applications, abandonment shall be considered as a question of fact.

So it appears that as regards renewed cases the question of abandonment may enter as a serious factor. Likewise, it will become evident that the question of diligence of the inventor in presenting his invention to the public is likely to be of vast importance.

Suppose a person to have a really meritorious device and that he applies for a patent. Assume that his circumstances are normal as to finances and health. May he obtain the allowance of his patent, then forfeit his application, and proceed to let the application remain idle, and the invention likewise, for a year or until the limit prescribed by law? If his application is idle in the state of forfeiture and he is earnestly working to produce his invention in a highly refined form for the benefit of the public, he is certainly operating as diligently as possible. But without the last-mentioned effort *there is lacking any reason for a situation of forfeiture*, and the proposition would seem to involve a constructive abandonment. But, if the applicant were ill over this period of forfeiture, or financially embarrassed, there would exist another ground of excusable delay. At the present time the Commissioner of Patents requires no showing to overcome a presumption of abandonment when an application has been forfeited a considerable period of time. Query: Should a showing of this sort not be required? In a case of suit based on the patent its validity might well be open to attack on this score; otherwise, why does the statute specifically include the provision that "abandonment shall be considered as a question of fact"?

Then we have the same situation of idle forfeiture unexcused as presenting a phase of equitable estoppel, one which has defeated the interests of the forfeiting applicant or inventor in interference in the Patent Office, and which seems to be suggested as menacing those interests where a patent has been issued, and where such interests may be opposed by a rival claimant of the invention.

In the case of *Barber v. Wood*, 207 O. G., 299, the Board of Examiners-in-Chief held as follows:

We are satisfied that enough is shown by the testimony to warrant the conclusion that Wood had knowledge of a rival in the field for some time prior to the renewal of his application. Coupling the fact of such knowledge with his failure to renew his application until just prior to the end of the time allowed by the statute for that purpose, a presumption of acquiescence in the use of the invention which Barber had given to the public arises, such as in our judgment establishes that Wood has lost his right to a patent. As was said by the Supreme Court in the case of *Shaw vs. Cooper*, (7 Pet., 292:)

The doctrine of presumed acquiescence, where the public use is known, or might be known to the inventor, is the only safe rule which can be adopted on this subject.

Cain v. Park, (86 O. G., 797; 1899, C. D., 278; 14 App. D. C., 42), wherein the court says:

From what has been heretofore said we are not to be understood as holding that a renewal application filed within the two years given therefor will under all circumstances relate back to the original and cut off all intermediate applicants and patentees. The statute contemplates the possible existence of facts and circum-

stances attending the action of the original applicant that might show an abandonment of the invention itself, notwithstanding there may have been no formal abandonment or withdrawal of his application. In such a case it would be wrong to allow him to come into the Office, instigated by the entry of a new and independent inventor into the field, and revive his original invention for the purpose of defeating his rival for reasons similar in their nature to those which controlled the decision of the following cases: *Mason vs. Hepburn* (C. D. 1898, 510; 84 O. G., 147) and *Warner vs. Smith*, (C. D., 1898, 517; 84 O. G., 311).

Now, a mere delay of two years in the application for a patent is not evidence of abandonment; but neglect to confer the benefits of the invention upon the public, whether it is or is not accompanied by neglect to apply for a patent, is evidence of abandonment. The inventor may voluntarily keep his invention secret as long as he sees fit to do so, provided he applies for a patent before another invents the device. He may abandon or forget his invention, provided he resumes or recalls it before another makes the invention. But his rights do not, in either case, relate back through the intermediate "vacuum" to the original invention, so as to give him the benefit of its date as against a rival inventor.

It, therefore, behoves the counselor to exercise care in the handling of forfeited applications. The utmost protection demands that it be assured that the state of forfeiture be for just ground, for only a momentary period, or that during the same the diligence of the inventor in relation to the reduction of the invention to practise be uninterrupted. For at best, while an application is a constructive reduction to practise as of its filing date, this is doubtless subject to rebuttal, the completion of the invention being necessarily either constructive, by issue of the patent, or actual, by building or actual practise of the same. An application may be abandoned and

an invention may likewise, by the omission to complete the patent to the point of giving the invention to the public.*

It has been customary for attorneys of record to sign the petition for renewal of an application, tho preferably of course the applicant should do so. In one instance, the author recalls that the validity of a patent was questioned on account of signing of the petition by the attorneys instead of the applicant. The point offers the suggestion of a controversial difficulty upon adjudication of a patent, and, in the interest of abundant caution, the applicant might best make the renewal application over his own signature, notwithstanding that the validity of the other method is hardly open to successful attack.

In renewal applications it is not necessary to file a new set of application papers and drawings, as the original ones are usable for the renewed application under a properly simplified procedure.

Where an application is not renewed within two years from the original date of allowance, it becomes abandoned, and a presumption of abandonment of invention may follow, and may only be overcome by a suitable showing if a patent, later issued, comes to the test of adjudication. Of course, if the renewal period has passed, the only method of obtaining the patent is by a new application with new papers complete.

See page 306 for typical form of Renewal Petition.

Reissues

A concise history of the beginning of reissues will assist in gaining an idea of the purpose and general method of pro-

* Note: Since the above-discussed decision was rendered and the observations written a later case treating to a large extent the question of abandonment incident to delay after forfeiture, is reported. In *Wells and Hunter vs. Honigman* 280 O. G., 590, the Court of Appeals of the District of Columbia seems unwilling to go as far as the Patent Office. The case is made to hinge upon the doctrine requiring proof of intent to abandon. The courts seem to go to extremes in protecting the negligent inventor and trade-mark owner under this doctrine. There is room for much reform in this connection and unless abandonment is more liberally construed to exist than at present, on the basis that actions speak louder than belated words, a premium is placed upon unwarranted delays and negligence by a certain class of invention owners and trade-mark proprietors.

cedure pursued in this class of cases. Quoting from Walker on Patents, we have this reliable information:

No. 210. In 1821 James Grant, of Providence, Rhode Island, received letters patent of the United States for an improved mode of manufacturing hat bodies. In 1825 he presented a petition to Henry Clay, Secretary of State, stating that the specification of his patent was defective, and praying that his patent might be canceled, and a new and correct one granted, embracing the same improvements, so far as they were set forth in certain new specifications, drawings and explanations which accompanied the petition. Though there was, at that time, no statute which authorized any such proceeding, yet, on the advice of William Wirt, the Attorney General, and in the name of John Quincy Adams, the President of the United States, Mr. Clay canceled the letters patent of Mr. Grant, and thereupon issued to him new letters patent, for the same invention, and for the residue of the term covered by the original document. Annexed to the new letters, and forming part thereof, were the new specifications, drawings and explanations, which had accompanied Mr. Grant's petition.

In the case of *Grant vs. Raymond*, the validity of this proceeding was called in question in the Supreme Court, and was argued in the negative by Daniel Webster. The Supreme Court sustained the validity of the reissued patent, on the general spirit and object of the patent law, not on its letter. In delivering the opinion Chief Justice Marshall said: "If the mistake should be committed in the Department of State, no one would say that it ought not to be corrected. All would admit that a new patent, correcting the error, and which would secure to the patentee the benefits which the law intended to secure, ought to be issued. And yet the Act does not in terms authorize a new patent, even in that case. Its emanation is not founded on the words of the

law, but it is indispensably necessary to the faithful execution of the solemn promise made by the United States. Why should not the same step be taken for the same purpose, if the mistake has innocently been committed by the inventor himself?" And his Honor further said: "If, by an innocent mistake, the instrument introduced to secure his privilege fails in its object, the public ought not to avail itself of this mistake, and to appropriate the discovery without paying the stipulated consideration. The attempt would be disreputable in an individual, and a Court of Equity might interpose to restrain him."

Then came the actual legislation—making a reissue a valid and statutory proceeding by enactments culminating in Sec. 4916 of the Revised Statutes which reads as follows:

Section 4916. Whenever any patent is inoperative or invalid by reason of a defective or insufficient specification, or by reason of the patentee claiming as his own invention or discovery more than he had a right to claim as new, if the error has arisen by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, the Commissioner shall, on the surrender of such patent and the payment of the duty required by law, cause a new patent for the same invention, and in accordance with the corrected specification, to be issued to the patentee, or, in the case of his death or of an assignment of the whole or any undivided part of the original patent, then to his executors, administrators, or assigns, for the unexpired part of the term of the original patent. Such surrender shall take effect upon the issue of the amended patent. The Commissioner may, in his discretion, cause several patents to be issued for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for a reissue for each of such reissued letters patent. The specifications and claim in every such case shall be subject to revision and restric-

tion in the same manner as original applications are. Every patent so reissued, together with the corrected specification, shall have the same effect and operation in law, on the trial of all actions for causes thereafter arising, as if the same had been originally filed in such corrected form; but no new matter shall be introduced into the specification, nor in case of a machine patent shall the model or drawings be amended, except each by the other; but when there is neither model nor drawing, amendments may be made upon proof satisfactory to the Commissioner that such new matter or amendment was a part of the original invention, and was omitted from the specification by inadvertence, accident, or mistake, as aforesaid. (See prior patent statutes: Section 53, 1870; Sections 5 and 8, 1837; Section 13, 1836; Section 3, 1832.)

The law of reissues is very voluminous and is well treated by many authors. Some practical points might be emphasized herein to advantage:

Because a patent has issued, and some inconsequential mistake is involved, does not make the case one for reissue. If an inventor takes his patent, and, being advised of its inadequacies regarding protection, permits time to elapse without any effort to correct the grant, he cannot be heard later when alleging that there was inadvertence, accident, or mistake, in the issue. These are absolutely essential to every valid reissue, just as much as lack of fraudulent or deceptive intention on the part of the reissue applicant.

The statute calls for a surrender of the original patent. Query: Must the surrender be that of the physical documentary letters when they are available, or the grant evidenced thereby? The author has in mind a case where a company claimed to own a patent but had no assignment interest of record therein. It had received the original letters through the fact that it had the same attorneys as the patentee. The patentee filed a surrender of the patent in writing and applied

for a reissue, but the company claiming ownership refused to give up the original document. In the absence of a transfer of title of record it would appear that the Commissioner should accept the surrender of him who is the legal owner of the patent; certainly the mere absence of or inability to control the actual papers should not defeat the spirit and even terms of the statute. The actual loss of the original letters patent may be averred, and a certified copy surrendered in lieu thereof.

That a patent when reissued can not validly cover other than the subject matter of the original grant is almost axiomatic. But to determine this matter is sometimes difficult in the extreme and is often a bone of contention in the courts. As a general thing the courts, however, lean toward giving great weight to the judgment of the Commissioner in sustaining as valid a reissue grant, and it is only the usual small minority of cases where invalidity on this score is found.

The established rules of new matter as affecting applications, therefore, may be applied generally in reviewing reissue cases, and considering the phase of whether the application or final grant is for the invention of the original patent. Nevertheless, the statute in its terms would appear to permit the introduction of *new matter* in one class of cases, a privilege not usually understood as existing.

In this connection these words of Sec. 4916 above quoted are to be noted:

. . . but when there is neither model or drawings, amendments may be made upon proof satisfactory to the Commissioner that such new matter or amendment, was a part of the original invention, etc.

The question is quite pertinent whether the same doctrine is applicable to non-reissue applications containing neither

model nor drawing! If so, Rule 70 of the Patent Office Rules of Practice is invalid.

The considerations governing the advisability of filing a reissue are quite weighty. Aside from the matters outlined at the commencement hereof, there are other difficult things to determine. For instance, is the reissue for the purpose of narrowing or broadening the protection? Narrowing might be effected by disclaimer (see typical form on page 307) as the proper course instead of reissuing.

When the situation is one of broadening, it must be borne in mind that generally speaking only two years may elapse after the original grant in which to file for the reissue.

Close study of the statute fails to disclose any basis for the two-year rule on the question of broadening. That is to say, both the Courts, and the Patent Office in consequence, have adopted the view that after a patent has been issued two years there springs up an estoppel (laches) which prevents a patentee from thereafter claiming more than was claimed in the original grant. The way this came about was by reason of the cases, famous in patent annals, of *Miller v. Brass Co.*, 104 U. S., 350, decided in 1882 by the Supreme Court, and the later case of *Topliff v. Topliff*, 145 U. S., 156. In effect, the Court imputes laches to a patentee if he fails to seek his broadening reissue within two years from the date of the original. A prominent author deduces from the authorities that "the general rule is that a delay for two years or more invalidates a broadened reissue, unless that delay is excused by special circumstances." Such a rule at best is a loose and unreliable one. In effect, it says that the more than two years lapse may, or may not invalidate, and we are little better off than before. The two year rule is by way of analogy with the two year public use bar.

While this question may be one largely of abstract law, it is worthy of note to indicate that a patentee may not discover for many years after his patent issues a defect making it

inoperative to cover his real invention. The defect may be pointed out ten years after the original issue, upon an adjudication by a court. Shall such a patentee be presumed to know the defect has existed all that period prior to the expiry of two years subsequent to his patent, especially if the adjudication alone showed the existence of the defect because of a certain interpretation of the patent? Decidedly no! The attempt of the Supreme Court to read into the law that which is not there, and to the mind of the author, never intended to be there, is an encroachment upon legislative power. The equities of intervening right persons or concerns are and naturally should be amply protected. To lay down a fast and hard rule as to a limiting time, or any two year rule, is decidedly beyond the province of the courts and tends to defeat the essential object of the reissue statute. The Patent Office has fallen into the same error as indicated by the tenor of the Commissioner's decision in *Ex parte Schneider*, 253 O. G., 513, 1918, where the following words of Justice Brown in the *Topliff vs. Topliff* case are cited with approval:

That due diligence must be exercised in discovering the mistake in the original patent, and that, if it be sought for the purpose of enlarging the claim, the lapse of two years will ordinarily, *tho not always*, be treated as evidence of abandonment of the new matter to the public to the same extent that a failure by the inventor to apply for a patent within two years from the public use or sale of his invention is regarded by the statute as conclusive evidence of an abandonment of the patent to the public.

But the legislators have never provided that the terms of Section 4886 R. S. shall be read into Section 4916, and until they do, this doctrine is to be deprecated as not in conformity with the spirit of Section 4916, which was enacted to deal with a condition wholly irrelevant and foreign to any contemplated by Section 4886. Section 4886 is no more entitled

to be read into Section 4916 than the court is empowered to read it out, by reason of exceptional circumstances, if the court's premise or interpretation expressed in the above words "tho not always," were well founded.

The doctrine that, after the Patent Office grants to a man a patent intended to adequately protect his invention, (for both the Office and applicant are obliged to cooperate to this end if the contract is to be completely mutual as between the parties), the patentee is obligated to be diligent in discovering if the patent is fatally defective, is fallacious and pernicious. The patentee has a right to conclude that his patent is fully operative and valid when it issues, instead of being obligated to suspect the contrary. Reiterating, how can the defect be ascertained in many instances except by trial in court, which unfortunately often ensues more than two years subsequent to the grant?

There has long since sprung up a law of intervening rights, by which he who, subsequent to the original grant, innocently, with or without knowledge thereof, proceeds to make an article which does not infringe the original patent, may not be held later to infringe a reissue made sufficiently broad to take in his product. He is viewed as having moved in the light of knowledge of the scope of the original patent, on the basis of a dedication to the public of the subject matter not claimed, and therefore possesses a special right arising in the time between the original issue and the reissue. This doctrine is well founded in equity and takes care of the interests of those having *bona fide* rights of the character outlined.

The law of intervening rights does not protect him who usurps an invention, even if he does not infringe an original patent therefor, but upon reissue is found to infringe the latter. Such an infringer cannot go into a court of equity with clean hands, or take advantage of his own wrong.

Why, therefore, presume *general* intervening rights to exist if all special rights of this character are protected by a fair ap-

plication of the doctrines of equity? *American Automotoneer Co. vs. Porter; Porter vs. American Automotoneer Co.*, 232 F., 456, 463.

A reissue is granted only for the period of the unexpired portion of the original patent.

An example of a reissue patent application file wrapper contents will be found herein.

Abandonment of Inventions and Applications

It is very easy to determine the question of abandonment when an express and voluntary statement of abandonment exists. But the difficulties arise in practise in dealing with involuntary and constructive abandonments.

In many instances we have the formal abandonment of an invention as by a disclaimer, a form of which will be found on page 307. In this instance a patentee concedes publicly and in writing that a certain defined invention does not belong to him, and he abandons all claim to it by the precise disclaiming method prescribed by law.

Suppose an inventor makes his invention and markets it for more than two years. Two years' public use is a practical dedication or abandonment of an invention when no application for a patent therefor has been filed.

During the procurement of a patent an applicant may cancel certain claims for inventions. If he deletes the claims with the reservation that their non-patentability is not conceded, or indicates clearly that he has no intention to abandon the subject matter thereof, his action may not be regarded as a disclaimer; otherwise there is a constructive abandonment.

A reissue application sometimes surrenders a patent which may be perfectly valid as to limited subject matter. Claims of the original patent are sometimes abandoned by reissue cases.

One of the most common ways in which applications become abandoned is owing to the failure of applicant, or his counsel, to take action fully responsive to the last official action of the

Patent Office within the period of one year allowed by law. While an application may become abandoned in this way, the invention of the application does not necessarily become abandoned at the same time. This class of abandonment of an application may take place purposely or inadvertently. An invention may be seen to be defective and inadequate or impractical and the application intentionally abandoned.

When abandonment of an application takes place through inadvertence, as when the applicant, or his attorney, accidentally omits to respond to an official action within the period allowed by law, it is very essential that the application be revived for the preservation of the interests of the inventor or applicant. Assuming that the prosecution of the application has been carried forward with diligence and in a manner fully responsive to the usual requirements, the mistake of accidental omission to answer an official action, giving rise to an inadvertent or constructive abandonment, is held usually to be an unavoidable error, when all reasonable care has been exercised, and the revival of the application will be allowed under such conditions within the discretion of the Commissioner. Revival is effected by petition to revive, an example of which is to be found on page 309 hereof.

X

DESIGN PATENTS

Legal Provisions—Subject Matter—Design Patent Applications: Petition, Specification and Claims—Design Drawings—Infringement.

Legal Provisions

The subject of design patent law involves problems which are far less complicated than those incident to the operation of the law governing mechanical, method or process, composition, and article of manufacture patents. Design patents are granted under the provisions of Section 4929 of the Revised Statutes, which section reads as follows:

Section 4929. Any person who has invented any new, original, and ornamental design for an article of manufacture, not known or used by others in this country before his invention thereof, and not patented or described in any printed publication in this or any foreign country before his invention thereof, or more than two years prior to his application, and not in public use or on sale in this country for more than two years prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law and other due proceedings had, the same as in cases of inventions or discoveries covered by section forty-eight hundred and eighty-six, obtain a patent therefor.

It will be apparent from the foregoing that this section is somewhat similar to Section 4886, appertaining to other classes of patents discussed herein, in that the design must be an

invented thing, it must be novel, and there are provided certain statutory bars to the grant of patent therefor.

Generally speaking, under the foregoing conditions, design inventions are largely in the same category as other classes of inventions.

Subject Matter

The conclusions to be fairly reached, after many years of application of the design patent law, are that every design must be ornamental, that is, having an appeal to the sense of the beautiful, the grotesque, or the fantastic, etc.; and that the design must be for an article of manufacture.

It is evident that the phase of ornamentality is one essentially involving appearance. Hence, in the consideration of the patentability of designs, appearance is controlling and practically solely depended on, to determine this question. So much is this true that descriptions of designs have been viewed as superfluous and are no longer used in the formulation of a design patent application.

Seemingly, whether or not the alleged design is for an *article of manufacture*, would be an easy thing to determine. But what is an article of manufacture? As the author works upon this subject he has before him a rejection of a design application for a tractor, held to be a machine and not an article of manufacture. It is apparent, therefore, that there may be diversity of opinion as regards all manufactured articles being susceptible of design protection under Section 4929, R. S.

Doubtless a treatise might be devoted to refinements of definition of an *article of manufacture*. Bearing in mind the spirit of the enabling statute, we must interpret the enactment in the light of an evident intention to create in inventors having artistic conceptions, monopolies like those grantable to inventors of mechanical, method, and similar patentable conceptions. Why should this enactment, treated other than with

the most literal interpretation of the word "article," establish any discrimination in favor of simple articles as distinguished from complicated articles, *if artistic or ornamental conceptions are present in both?* It would be gross injustice surely, to grant unto a certain inventor a monopoly in an ornamental button-hook, and refuse one for an ornamental dishwasher. The serious question immediately confronting us is whether the ornamentality of a dishwasher is not more deserving of protection than that of a button-hook, on the theory that the former is used, and comes to our view three times a day, as against a single view in favor of the button-hook. But in reality, of course, this is not the controlling factor. The makers of the design law indubitably intended that inventors of ornamental conceptions of *articles that are manufactured*, whether useful or not, shall be rewarded with the limited term protection of a patent. It is questionable that when the law was framed, the idea of ornamentality entered into the field of utilitarian machinery as it does to-day, but this in no way makes convincing the theory that an ornamental machine is not as much patentable, as a design, as any ornamental article composed of a single element or comparatively few elements. To draw a line between a simple structure, and one complicated, for purposes of application of the benefits of the design statute protection is quite an approach to the absurd. "Stream line" engines, "graceful" runabouts, "beauty" (in the sense of real artistic design) tools, are expressions heard these days respecting more or less complicated machines.

So it is fair to view the statute liberally in regard to the term "article of manufacture." Thus considered, the problem of patentable subject matter resolves itself largely down to the proposition of ornamentality and originality, the former a question of fact readily determinable ordinarily, and the latter a formality of the allegation under oath.

It is within the memory of present day practitioners that any mechanical invention, not patentable as such, could be

protected as a design. But the courts held that merely utilitarian structures, not possessing ornamentality, even tho not susceptible of mechanical patent protection otherwise, did not fall within the design statute. A plowshare of new, but not ornamental construction, usually operating under earth and adapted only for its useful purpose, had no appeal to the esthetic. As regards a horseshoe calk the case of *Rowe vs. Blodgett*, 112 F. R. 61, found the Court holding as follows:

Design patents refer to appearance, not utility. Their object is to encourage works of art, and decoration which appeal to the eye, and the esthetic emotions, and the beautiful. A horseshoe calk is a mere bit of iron and steel, not intended for display, but for an obscure use.

That all the requirements of design protection may be present in a machine is clear. The court did not concern itself with the definition of "article."

Supplementing the foregoing, the authorities discussed in the form of Petition to the Commissioner for exercise of his supervisory authority, page 412 hereof, will be enlightening as regards the law.

To merely simulate an object which is well known, in formulating a design, where the imitation involves no special inventive effort, does not ordinarily result in creating a patentable design. Thus, to make candies in the forms of apples, peaches, bananas, etc., would not be an inventive idea. But to make a decorative dish with a group of objects thereon representing pieces of fruit, such as those mentioned, might easily involve an artistic and patentable conception.

Design Patent Applications—Petition, Specification and Claims

A design patent application is comprised of a petition, a specification, an oath, and drawings, somewhat parallel to the

parts of a mechanical patent application, except that the description in the specification, and the claims, have no correspondence with those of other classes of patent applications.

As a matter of fact, a design patent application does not include as a part of the specification any description whatever of the invention involved. The courts have long declared that an understanding of a design invention is had by the vision of its appearance. In the acceptance of this view, the patentability of a design and questions of infringement of this type of invention, being susceptible of determination by study of the appearance, the practise has come to be that description of a design is mere surplusage. As to whether this should be accepted as a final view is another matter.

There was a time in the practise when design patents were obtained largely for articles of manufacture, viewing the term in a very limited sense as covering articles not composed of moving parts. This view is one which places the article of manufacture largely composed of single or stationary parts in one class, and articles of manufacture which comprise moving parts in another class; namely, that of mechanical devices or machines. There is little or no basis in fact for such a classification, as hereinbefore intimated in relation to machines, for in the industrial arts to-day it is common that things styled articles of manufacture embody moving parts.

It is the view of the author that it is not to be considered superfluous to describe design patent inventions, especially where the invention lies largely in certain features of design of a machine, many of the parts of which may be conventional, lacking design or inventive effort of any sort. What harm can be done in giving a brief description of that which an inventor believes to be his invention, is difficult to determine. That the time may come, now that machines are subject to design patent protection, when a description of the features which constitute the ornamental design will be helpful, both to the Patent Office to determine whether the design

is patentable, and to the courts to determine questions of infringement, is a fair conclusion.

Again, we have in the design application of to-day, as largely drafted, a purely formal claim which reads as follows:

The ornamental design for a _____
as shown.

That such a claim is not fitted for acceptable usage, if the ordinary rules of interpretation of other types of patent claims are had in mind, is clear. Whether the tendency of the courts has been to prevent patentees of designs from going to the extreme lengths of other kinds of patentees, in providing dangerous and unclear refinements of language to distinguish claims, can not be stated. At any rate, the form of claim of a design patent leaves to a court the determination of that which is the invention claimed in the patent, and that which is to be fairly held as an infringement of such invention. In the final analysis, therefore, the court interprets the invention in the proper spirit of its presentation in the patent, and its novelty respecting the prior art, and arrives at an equitable conclusion as to what constitutes a usurpation of the inventive idea of the original and ornamental design ultimately covered, or intended to be covered, by the claim of the patent.

A somewhat better form of claim than suggested by the Rules of Practise for design applications would be the following as applied to an ordinary article of manufacture:

The new and ornamental design for _____,
a typical form of which is shown in the accompanying drawings.

Such a claim does not restrict a patentee to the particular design as shown, but clearly indicates that the design as illustrated is only one embodiment which the inventive idea de-

veloped by the patentee may take. When it comes to a case, therefore, like that discussed herein under the subject of Design Patent Infringement, where the forms of the designs are quite distinguishable in detail, tho identical in inventive subject matter, the question could not be raised as to whether the patentee had limited himself to the particular design, as shown, by the exact terms of his claim.

In the case of machines, the time will ultimately arrive when the applicant for the design patent will be required to define what features of the machine represent his novel and ornamental design subject matter. A consideration of many design patents which have been issued more or less recently, leads to the conclusion that where machines are involved, a requirement for specific claiming such as outlined above, would lead to a refusal of a design patent in some instances. If this time does come, it is to be hoped of course that there will be no duplication of the present claims practise appertaining to other types of patents, which involves the "This is the house that Jack built" form of claim!

A typical form of design patent specification and claim will be found herein.

PETITION OF DESIGN APPLICATIONS

The petition used for a design patent application is so similar to that employed for mechanical and other kinds of patents, and subject to the same rules in so far as method of formulation and execution are concerned, that a sufficient understanding thereof may be had by merely referring to the form given herein.

OATH FOR DESIGN APPLICATIONS

The oaths of design and mechanical patent applications are quite the same, except for certain specific allegations, and similar procedure is followed in reference to the design ap-

plication oaths as presented under the subject Oaths for Patent Applications. The suggestions for drawing and execution of such oaths will not be reiterated.

DESIGN APPLICATIONS: SPECIFYING TERM

Design patents are granted for terms of three and one-half, seven, and fourteen years, and a special procedure is followed in electing the term for the ultimate patent. The method pursued is of advantage to the inventor where there may be some doubt as to the patentability of the design for which protection is sought.

The Patent Office, under the said procedure, will permit of the filing of a design application petitioning for the grant of a patent for three and one-half years, with the payment of the Government fee of ten dollars, the term of the patent as specified to be enlarged at the will of the applicant. Thus, on filing an application for the short term, after the case is prosecuted to the point of allowability of the patent, by special request in advance the Patent Office will give a regular notice to the applicant or his attorneys, as the case may be, indicating the allowability of the application, and will permit thirty days' time to ensue wherein the term for the patent may be enlarged by the filing of a request to such effect. With the filing of the request the additional amount of the Government fee, namely, five dollars, or twenty dollars, for the seven and fourteen year terms, respectively, must be paid into the Patent Office, according to which term is elected.

In view of the foregoing practise, it is evident that the possibility of a design patent being granted may be determined before the patentee has to pay the larger Government fee required for either of the two longer terms of the patent, as compared with the three and one-half year term.

The Patent Office has no power to refund a portion of the fee if the patentee of the design patent elects to obtain a seven or fourteen year patent and his case is rejected finally.

DESIGN DRAWINGS

Little need be said about design application drawings, for the drawing of this class does not embody the complications of those of mechanical cases, so called.

Designs involve largely that which appears to the eye, when it comes to illustration thereof, hence an external view or views only are required. Views in section, in other words, are not therefore appropriate. Usually side elevation and plan views are quite all that are needed. A general perspective view, however, is often the best by which to depict the design when it is a mechanical structure of several dimensions. Signature requirements are the same as regards mechanical patent drawings, but reference characters, other than figure numbers, are superfluous in the absence of any specific description.

Infringement

We can best understand the theory of patentability and infringement of design patents by referring to a concrete example.

The design patent of Pfeffer, No. 51,559, issued December 11, 1917, shows a design for a doll. The design, as customary under present practise, is not described in the patent, description being held to have little or no value to establish the patentability of design invention, or to enable the decision of questions of infringement which may affect the same. Viewing the invention, therefore, as it strikes the eye, it becomes evident that the doll is a unique idea in the way of a caricature upon a bathing female, illustrating a supposedly demure girl as she sits on the beach inviting attention to herself and costume, and with an assumed attitude of flirtation. Of course the doll is an artistic figure, and doubtless the figure as shown is quite unrealistic, having largely an appeal to the imagination and representing more than anything else a very amusing conception.



"BUCKLE" DOLL.



PEPPER "SLASH" DOLL.

There is a decided phase of invention involved in the production of this figure or doll, and it is interesting to review the decision of the Circuit Court of Appeals of the Second Circuit in the case of *Geo. Borgfeldt & Co. v. Weiss*, 265 F. R. 268, adjudicating the patent for the invention. In the lower court the bill of complaint for infringement of the patent for this design was dismissed.

There is annexed hereto an illustration of the design of the patent and a corresponding illustration of the design of the infringing article. The patented design was called "Splash-me," commercially, and the infringing design was called "Duckme." The appellate tribunal held, in respect to the infringement phases involved, as follows:

The question of infringement of a design patent for a doll is a question as to the impression produced on would-be purchasers.

Infringement of a design patent for a doll turns upon whether there is identity of appearance, whether the effect produced upon the eye is the same, and whether there is substantial identity of design; and the persons to be deceived are not experts, but ordinary observers, giving such attention to the matter as purchasers usually give.

A design patent for a doll entitles the holder to the usual range of equivalents with respect to known prior unessential details, and, tho the patent drawings show a doll with a cap, the figure shown is included within the claim of the patent, whether the doll is provided with painted hair, real hair, bathing cap, or military or naval cap, or any other standard form of headdress.

This case is very instructive with which to discuss design patents. The question arises as to whether the court has clearly expressed what is believed to be the controlling consideration in determining the patentability of the design, and whether a design patent is infringed.

Query: Is it necessary that there be identity of appearance between two designs; also, is it necessary that the effect produced upon the eye be the same in comparing two designs, one alleged to infringe the other?

The question of patentability, and the question of infringement, largely hinge upon the phase of the invention involved. In order to infringe a mechanical patent it is not necessary that there be identity of construction between two inventions under consideration. The proposition is one of whether the invention of the patent is usurped as the said invention is claimed, the substance rather than mere terms is of course controlling. Is it proper to hold in respect to a design that the question of infringement turns wholly upon the phase of appearance, or effect produced upon the eye? This must be answered in the negative, and while the courts may not have stated clearly their views in this matter, in the case which we are discussing the court undoubtedly had in mind that there is the moving consideration of usurpation of invention in determining a question of infringement. For instance, the court uses the expression—"and whether there is substantial identity of design." By this is certainly meant whether there is substantial identity of invention.

Whatever else may be said in respect to the design alleged to infringe the Pfeffer patent, there can be no question but that the two designs are distinguishable. The general postures in both are undeniably the same, but the head appearances are quite different in some respects. Of greater importance, however, is the fact that the inventive idea involved in Miss Pfeffer's design patent is bodily adopted in the infringing article. The District Court in this case said—"at a glance one would, of course, see the patent plagiarism." The Appellate Court discusses and lays down a rule bringing into play the doctrine of equivalents, so often employed in construing all other classes of patents, and holds infringement clearly to be present.

It is, therefore, conceivable that the general appearance of two designs may be quite distinctive, so much so that there would be little or no confusion, and yet one design may constitute a clean-cut usurpation of the *inventive idea* of another. Having made his invention, obtained an adjudication that there was invention in his design, and patentable novelty being properly established, the patentee of a design patent, equally with the patentee of inventions of mechanical and other classes, is certainly entitled to take into the courts for decision, the question of the *pirating of his inventive ideas*.*

In the still later case of *Wilson vs. Haber Bros.*, 275 F. R. 346, decided May 25, 1921, the Second Circuit Court of Appeals, by Judge Hough, practically reaffirmed its views in *Borgfeldt vs. Weiss*. The original "Kewpie" doll Patent No. 43,680 was under consideration regarding infringement. The following quotation is of special interest:

The proper method of investigating and declaring asserted infringement of a design patent has been much discussed at bar and in the court below; it being suggested that differing and divergent, if not incompatible, rules are to be found in our previous decisions of *Ashley vs. Tatum*, 186 Fed. 339, certiorari denied 225 U. S. 707, 32 Sup. Ct. 839, 56 L. Ed. 1266, and *Borgfeldt vs. Weiss* (C.C.A.) 265 Fed. 268. We discover no contradiction between these decisions, though they do afford illustrations of different methods of approaching solution of the same ultimate problem, which is, like every question of infringement, always an inquiry of fact.

Whether the problem be of validity, scope, or infringement, the prime difference between patents for

*NOTE: Since the foregoing was written another decision has been handed down by the District Court for the Northern District of Illinois in the case of *Pfeffer vs. Western Doll Mfg. Co.*, 271 F. R. 124, invalidating the design patent discussed above, which was sustained by the Second Circuit Court of Appeals. The Court's view in the recent case, summarized, was that the "Splashme" doll is nothing more than the "Kewpie" doll dressed "in conformity with everyday practise in dressing." Also, it was "merely the selection of a bathing suit for the doll, and was not a creative act."

In the decision the only things the court did not say the average skilled person would or could do, was to dispose the body in the peculiarly novel general attitude of the design, head tilted a certain way, arms disposed peculiarly, and legs bent in a striking relation to the arms and head. While the evidence before the court might have been very persuasive, without study thereof it is believed that the fundamentals of the appellate decision remain undisturbed.

other inventions and those for designs is that in the first class the inquiry is, "What will it do?" whereas in respect of a design one always asks, "How does it look?" *Rowe vs. Blodgett & Clapp Co.*, 112 Fed. 61, 50 C.C.A. 120.

How anything looks depends very largely on the eye of the observer; yet that observer, if a court in equity or a jurymen at law, must decide by the effect upon his eye whether there has or has not been that appropriation of essentials, or substantial appropriation, which constitutes infringement of any patent. For such a process it is inaccurate to speak of a rule in the sense that that word is properly used in relation to legal rights. No more can be done than to indicate the processes by which experienced observers arrive at conclusions.

The discussion has only illustrated how differently admitted phenomena affect different minds when all are endeavoring to apply the admittedly proper measure in respect of design patents, viz., optical effect. In respect of this particular defendant's doll it is sufficient to say that there is an even stronger external resemblance between plaintiff's "Kewpie" and defendant's so-called "best baby" than is exhibited by the drawings inserted in the opinion in *Borgfeldt vs. Weiss*, supra.

XI

ASSIGNMENTS AND CONTRACTS

Assignments—In General—Contracts: Transferring Patents and Businesses; Employer; Employee—Warranting Protection—Estoppel—Licenses: In General; Shop Rights.

Assignments—In General

The customary document used to sell or transfer a patent, or an interest in an invention resting in application, is called an assignment. Assignments may cover the whole right to an invention or patent, or the whole right to the patent in a specified territory. The last-named class of transfer is known as a territorial assignment, and in the United States often covers a certain State or group of States, or counties, or cities.

In the addenda of forms found herein a general form for assignment of inventions resting in application is found, and also one for assignment of an issued patent. These forms are such as are properly usable for record at the United States Patent Office.

The recording of assignments relating to inventions is an important matter to be attended to. Without attempting to enter into the particulars of the law controlling the recording phase, a few facts may be noted. The Patent Office will not record in its regular assignment records a document of assignment which does not completely identify the invention transferred either by supplying the serial number, or filing date, or both, as usual, respecting the application covering the invention; where the invention has been patented, patent number or patent date, usually both, must be furnished.

During the preliminary stages of an invention a transfer of the invention by a general assignment is frequently made,

the invention being identified by its name, the reciting of the inventor's name and address, and often the business in which and place where developed. A document of this sort is all that can be prepared at certain stages, but should invariably be supplemented by a complete properly identifying instrument for recording purposes, as soon as the patenting processes have proceeded sufficiently far.

While it is very common to-day for assignments of inventions to be made prior to issue of the patents therefor, strictly speaking, an invention is not an assignable monopoly until its ownership is fixed. The only method of establishing a *prima facie* ownership is by obtaining a patent.

Therefore, it is to be understood that the risk is upon the purchaser who buys an invention while it is resting under an application for patent. Proper investigations will enable the determination of the allowability of a patent, and the probable scope thereof, with a fair degree of safety. When such investigations are made there is a suitable basis for both inventor and purchaser to come to terms for the purposes of transfer of the future patent monopoly.

One of the most common phases of assignment practise is frequently not understood. It is the accepted belief, for instance, that an assignment conveying a one-half interest in an invention or patent makes the assignee (he who receives the interest) a partner with the assignor (who assigns the interest). That is, the assignor and assignee, under the foregoing conditions, are thought to have equal shares in the proceeds derived from the invention, whatever these may be. But this is not the true state of affairs. An assignee of a one-tenth interest in a patent is in reality constituted an independent owner and operator under the grant. He may move wholly free of cooperation with the assignor, and the latter is in a similar position. The odd part of the situation is that he who has a one-tenth interest is as well entrenched under the laws as he who has nine-tenths. All this lacks an appeal

to the workings of common sense, but such is the legal status of the parties.

To avoid disastrous consequences which may spring up from assignments of part interests such as discussed in the last paragraph, it is essential that the assignment instrument include provisions such that the interest conveyed vests in the then owners the right to share in the profits, and all other emoluments, which may arise from the invention and patent, in the proportion of their respective interests. Inasmuch as the conditions just stated create possibilities of sharing profits, to be mutual they should obligate the interested parties to share any losses incident to promoting the invention and patent, also in accordance with the respective interests held. In effect, the terms such as above outlined will constitute the parties involved as partners, in regard to the particular subject matter, and an agreement, rather than an assignment, is the form of document in which the obligations should be inscribed, an assignment being limited thereby.

Assignments to employers, such as are utilized for purposes of passing title to patent rights, inventions, etc., owing to the obligations of an employee, may well include a special clause by which to transfer additionally the right to apply for and pass title to all foreign patents that may be procured. Provisions for the above contingency are fair when the understanding is that any and all inventions developed by an employee during his employment shall belong to the employer. In nearly all such cases, the value of the employee's services is based upon the expectation of receiving all inventions and patent rights arising from his efforts when such rights relate to the particular business.

A provision, such as referred to, is also of advantage at times in dealing with situations arising regarding foreign patents. Occasionally, the consent of the inventor to the making of a foreign application, by the owner of the rights, is necessary. After an inventor leaves an employment this con-

sent is at times hard to obtain. An assignment covering the contingency is ample evidence of agreement on the point.

The recording of assignments at the Patent Office is an act of importance for purposes of protection. The conditions governing this matter may well be treated by way of example.

A owns a patent and assigns all rights in the same to *B*. *B* omits to record the assignment at the Patent Office. *C* comes along and makes *A* an excellent offer for the patent, and *A*, who is crooked, accepts and makes a second assignment to *C* who has no knowledge of *B* or the previous transaction. *C*, if an innocent purchaser for value without notice, will take the valid title if *B*'s assignment was not recorded at the Patent Office within three months of the date of the making thereof, or prior to the subsequent purchase or mortgage.

Contracts

TRANSFERRING PATENTS AND BUSINESS

A patentee owning a business and patent rights sometimes transfers the same for very equitable valuable considerations to new parties, in the ordinary transaction of business. In many instances, where the intent of the parties has been to pass title to the patent rights and the business with its good will, the contracts drawn between the parties have failed to realize the object in view. A common cause for this has been due to the person or persons selling out a business and patent rights, and reentering upon said business within competing territory, often very promptly after the selling out process.

It is surprizing how many instances of this kind of transaction occur, due to the fact, largely, that tho an invention is quite adequately protected from the patent standpoint, it is susceptible of improvement, or the objects accomplished thereby capable of being obtained by similar inventions not comprehended within the scope of the patent rights transferred with a certain business. The seller in a case of this sort may often have considerable inventive talent and be able to devise new

ways and constructions for accomplishing certain results, patent these things, and proceed to compete with the purchaser of his previous business to such an extent that the earlier established business is almost destroyed, or at least greatly reduced in value. So large is the reduction in value at times, that the consideration passing between the parties to the original transaction is rendered abnormally large and an unfair one, as regards the value of the business caused to be reduced or deteriorated owing to the methods of the seller. It is on account of reductions in the value of a business, caused by what may reasonably be considered to be unfair methods of the character stated, that rigid contracts should be drawn, protective of the purchaser acquiring inventions, patents, and the good will of a business connected therewith. A form of contract suitable for the protection of purchasers of patent properties and businesses associated therewith is found herein. Its essential features are these:

1. The protection of the purchaser against competition with inventions of the seller in the same line of business.

2. The protection of the purchaser against the sale by the seller, to others than the purchaser, of inventions which may be similar to or superior to those transferred by the seller to said purchaser. In this way, competing businesses are prevented from being energized against the purchaser's business, and the selling price or consideration is maintained fair, or of full value.

3. The insurance that the purchaser will receive the benefit of any like inventions of the seller already evolved but not fully identified in the agreement.

4. The insurance that the seller will cooperate with the purchaser in maintaining the inventions of patent rights valid.

5. The complete transfer of all patent rights, inventions, business, and good will to the purchaser.

6. A definite agreement as to the status of future inventions, and foreign patent rights.

EMPLOYER; EMPLOYEE

An inventor entering upon employment calling forth his inventive genius should bear in mind the general obligations which attach to his efforts, as they may affect the rights of an employer, and in all fairness he should arrange a special contract for his services if he does not propose to give up the full results of his inventions as they may appertain to the business of the employer.

Limitations respecting the right of an inventor to operate in the competitive field, and similar obligations of a contractual nature should not be inadvisedly entered into; when incurred they should be abided by. It is a bitter trial for an inventor to be indefinitely tied up against operating in the field of his experience, so that contracts governing such matters should be well considered indeed. Frequently such contracts might well be declined.

A great loss, however, is suffered when a concern or manufacturer, in the capacity of an employer, finds itself despoiled of important inventions developed in its manufactory, and at its expense. This is the common result of the service of unfaithful employees, and has caused the employer of inventing service to make himself secure by rather rigid contracts that have tended to prejudice, rather than promote, the interests of inventors and designers. If a more universal desire existed on the part of such persons to give the full result of the employment to him who pays for the inventing, many unfortunate contracts would be avoided.

But it is one thing to produce inventions during an employer's time, and another to do creative work of this sort during an employee's time. When the inventing is in a different field from the employer's business, or not the regular work for which employee was retained, it is not difficult to draw a line of distinction as to the ownership of patent rights; when such are not the cases the line to be drawn is more difficult.

A rigid agreement between an employer and employee is supplied in the addenda of forms. The provisions of this agreement are of extreme stringency, as they cover the rights of the parties thereto. In early times, when communication was difficult between people, between portions of a country, and between nations, the field of usefulness of a person in his employment was very considerably restricted. During such times the courts did not view with favor agreements limiting territorially the right of a man to pursue his occupation or vocation. By so doing, the ability of a person to earn his bread and butter may be circumscribed, something which is clearly against public policy.

Where agreements are entered into at this time, however, embodying restrictions as to time and territory, regarding the pursuit of an occupation, as this matter relates to contracts of invention and employment, the tendency of the courts to-day is to sustain such restrictions where they are reasonable. If this were not true, a person could enter the employ of a manufacturer, obtain wages based upon his inventive capacity and the value of the inventions which he might produce and intended to be owned by the employer, obtain knowledge of trade secrets, or especially evolved efficient methods of the employer, and after a certain time separate from his said employment, taking with him inventions and methods to competitors. When agreements are made in good faith in limitation of the extent to which an employee may proceed along the above lines, it is the view of the authorities that contracts of employment restricting the employee should be sustained, the reasonableness of the contract being of course always a question of importance. So it is that while a Court may in some cases restrict an employee from entering a competing business for a period of two years, such a restriction for ten years might be deemed wholly unreasonable. When phases of coercion enter into the circumstances of the contract, and where an employer seeks to take an undue advantage of an employee

under such contracts, the extent to which courts will go in sustaining an agreement may be considerably limited.

Warranting Protection—Estoppel

It is not an uncommon practise for patent owners in their efforts to dispose of patent rights, to make representations regarding the breadth of their monopolies as an inducement for the disposition of the same on the most favorable terms. Thus, as an instance, the assignor of an invention and patent at times indicates by way of inducement that his patent is exceedingly broad and covers all similar devices of the same general class. Furthermore, in selling his patent, the seller at times warrants that he will not reenter the same business, invent, or compete with the purchaser in the same line of invention, either for a term of years, or indefinitely. In respect to the warranty of the breadth of a patent, the courts are constrained to go pretty far in enforcing the contract against the assigning party and in favor of the purchaser. When the assignor of the patent rights, after transferring the title to his patent, invents and patents another and similar invention to that previously assigned, he will ordinarily be estopped from denying the infringement when attacked under his first patent and contract or assignment.

It is not consistent and fair, obviously, for a patent seller who warrants his invention to be broadly novel, and the patent therefor to be correspondingly a very complete monopoly, to promptly make a new similar invention and introduce the same, thereby despoiling the patent purchaser of the fair returns of the sale, and in effect setting aside a very important part of the consideration for the sale. The courts have gone so far as to say in such cases, that they will not enter into a study to determine nice questions of infringement such as may be involved technically speaking; they simply rule that infringement exists and will enjoin it. This is possibly a rather

strange and unusual practise, but is clearly based upon the desire of the court to give the purchaser proper and equitable relief. To a certain extent the relief appears grounded rather upon unfair competition, or the enforcement of the consideration of the contract—specific performance—than upon any doctrine of infringement law, if, in matter of fact, technical infringement does not exist. Certain authorities in connection with this practise are of interest, and are therefore noted:

Assignments—effect as estoppel.

(C. C. A. 8th Cir., 1910.) One who actively participates in the sale of a patent and receives a share of the proceeds, and all in privity with him, are estopped to deny its validity as against the purchaser or his assigns, and a corporation subsequently organized by him is so in privity with him and affected by such estoppel. (For other cases, see Patents, Cent. Dig. 182½-186; Dec. Dig. 129.) *Johnson Furnace & Engineering Co. vs. Western*, 178 F. 819.

Assignor may contend for narrow construction of claims.

(C. C. A. 2nd Cir., 1914.) Where complainant obtained its patent sued on from defendants, the fact that defendants were estopped to claim that the patent was void for lack of invention did not preclude them from contending for as narrow a construction of the language as the claims would warrant and the conditions of the prior art might require. (For other cases, see Patents, Cent. Dig. 238; Dec. Dig. 163.) *Standard Plunger Elevator Co. vs. Stokes et al.*, 212 F. 941.

Suit by assignee against assignor and company created by him.

(C. C. A. 2nd Cir., 1909.) In a suit for infringement brought by the assignee of the patentee against the patentee and a company he has created and controlled to

exploit the same appliance, an inquiry into the prior art to ascertain the validity of the patent assigned will not be undertaken, the patentee and his corporation being estopped to urge the invalidity of the patent as against his assignee. (For other cases, see Patents, Cent. Dig. 289; Dec. Dig. 202.) *Johns-Pratt Co. vs. Sachs Co. et al.*, 175 F. 70, 71.

Assignor estopped to deny validity.

The assignor of a patent, upon suit against him for infringement thereof by the transferee because of the use of the identical construction described in the patent, is estopped to challenge the validity of the patent for want of novelty and patentability. The defense of invalidity is closed to him, and he can not deny his own title to the interest assigned. *Frank et al. vs. Bernard*, 131 F. 269 (N. Y.).

Assignor may not assume inconsistent positions.

(C. C. A. 1st Cir., 1915.) The assignor of a patent for value, with covenant of warranty, is estopped to deny its validity when sued for infringement by the assignee or to claim a narrower construction of the claims than it did to induce the sale. *United States vs. Cross* 227 F. 600.

(C. C. A. 6th Cir., 1914.) While a patentee-assignor may, when made a defendant, litigate the scope of his patent, the courts will not unnecessarily construe it so narrowly as to make it worthless, but will be inclined, so far as the record permits, to make its exclusive right a real and valuable thing. *United States vs. Sanhoff* 216 F. 610.

It is also the practise of the courts, in cases in which parties agree to withdraw from the possible fields of competition as a part of the consideration of the sale of a patent, that the seller's actions be scrutinized closely when there is any attempt to

avoid the strict terms of an agreement of this character. Many have been the expedients of fraudulent sellers of patents in attempts to reenter the fields in which the patents sold may be classified, after having received liberal considerations for keeping out of such fields. When relatives are often caused to invent, or others are relied upon for this purpose, who may be very remotely connected with the fraudulent party, superficially, but very closely related through recourse to incorporation methods or secret partnerships, it well behooves the courts to study closely and afford relief to *bona fide* purchasers of patents who have parted with valuable considerations in the acquirement of the rights. Fortunately, it is the liberal spirit of the courts to dispense equity in such cases.

Estoppel to deny validity—sale of patent.

All persons who concur in the sale of a patent, either directly or indirectly, or participate in the consideration received therefor, are estopped from averring the invalidity of the patent. (Affirming decree, 111 F. 902. N. Y.) *Force v. Sawyer-Boss Mfg. Co., et al.*, 113 F. 1018; 51 C. C. A. 592 (2nd Cir.).

Where persons thus deal in a patent right and afterwards form a corporation, such corporation is likewise estopped. Thus all persons interested in the sale and in privity with the assignor are estopped as against the assignee. *Id.*

Assignment—effect as estoppel—corporation organized by assignor.

(C. C. Md., 1910.) A corporation organized by a patentee, who subscribed for two-thirds of the stock and paid for it with money received from another corporation to which he assigned the patent, is bound by his estoppel, and can not question the validity of the patent, nor introduce evidence so to limit its construction as to render it worthless. *Automatic v. Monitor*, 180 F. 983.

Corporation organized by patentee after assignment—estoppel of corporation.

(D. C. Pa., 1913.) Where a corporation alleged to infringe a patent was organized by the patentee and his family after he assigned the patent, and he has since been its president and active manager, it is bound by his estoppel and can not deny the validity of the patent but may show the prior art to define and limit the claims. *Rollman vs. Universal* 207 F. 97.

Licenses—In General

A special form of license is treated herein, known as the "shop right," which is in the nature of an *automatic* license. Generally, however, licenses are written agreements by which a patentee, or the owner of an invention, specifically grants to another the power and right to employ the invention by way of manufacturing, selling, and using, or doing any one of these things.

A well-known form of license is one which gives an exclusive right of sale, constituting a party or concern as an exclusive sales agent. As a general thing such licenses are not granted until by careful investigation it is determined that the sales agent has the proper sales equipment, force, and capability for the production of large sales. Exclusive licenses in the interest of the licensor should cover a minimum amount of sales annually, and in the event of default in this connection the license should provide for a reversion of the rights granted to the licensor. This reversion is usually handled by a special privilege granted to the licensor to revoke the license when there is default in respect to the minimum sales provisions. A corresponding method of revocation is ordinarily employed in non-exclusive licenses.

In respect to exclusive licenses the licensee is reasonably entitled to protection by provisions which give him sufficient

time to create the minimum sales required annually. An exclusive license to use is not uncommon, and an exclusive license to manufacture and sell is frequently employed. Certain general principles suggested as regards the exclusive license to sell are applicable to the exclusive license to manufacture particularly.

Limitations as to the territory in which the use, sale, or manufacture may be performed are proper and necessary for the adequate protection and understanding of the parties. It will be seen that if owners of patent rights grant unrestricted territorial exclusive licenses in the manufacture or sale, the corresponding rights in foreign territories may be vitiated.

In effect, of course, the fixing of minimum sales is the fixing of minimum royalties to be derived from said sales. In cases of exclusive licenses the requirements regarding minimum royalties or sales should be more rigid than in respect to non-exclusive licenses because, obviously, an exclusive license during its life may practically vest in the licensee nearly all of the rights and privileges of the patentee, save the title to the patent itself. Exclusive and non-exclusive licenses for limited terms are often negotiated.

From the viewpoint of the licensee it is fair that he should be protected by the licensor against infringement of the patent rights. No absolute rule may be set down in connection with this matter as regards the payment of the expense of litigation over the patent in the interest of the licensor and licensee. The circumstances may warrant that either one of these parties should stand the expense of litigation, this matter largely depending upon conditions and the status of the parties themselves, and possibly special phases of the contract. It is almost axiomatic, however, that if the licensor will not contract to defend his patent rights, the licensee should have this privilege, and be able to compel the cooperation of the licensor.

Contracts of non-exclusive license are most often employed where the owner of patent rights desires to constitute a num-

ber of different parties licensees. Often a manufacturer, in the interest of the development, and to promote the public use of his products, takes the liberal view that competition is to the interest of increasing the value of his patent rights by popular acceptance under conditions of increased distribution of the inventions constituting said products. In these circumstances, such a manufacturer frequently licenses several of his competitors under certain or all of his patent rights, and, by exacting royalties in fair amount, an overhead is placed upon each competitor, and increased advertising and distribution constitute in many cases fruitful results of this liberal attitude of mind. After all, the object in the promotion of any invention or a patent right is to obtain the widest distribution thereof, and in respect to certain arts or classes of invention such distribution is insured by a division of the monopolies of manufacture, use, or sale, instead of maintaining the exclusive ownership and use of the monopoly.

It is essential to licensees of both the exclusive and non-exclusive classes that the licensor have complete rights regarding the inspection of the books of the licensee or licensees. As a method of avoiding embarrassment it is quite proper to require returns under licenses, as to quantities manufactured, used, or sold, and royalties thus produced, to be made under oath, notwithstanding that the book inspection privilege exists.

A licensee during the pendency of a license acknowledges the validity of a patent under which the license is taken. An excellent provision in license agreements is one which requires the licensee to contract that he will not be a party, directly or indirectly, to any procedure disputing the validity or *tending to impair the value* of the letters patent under which he operates, or by which the enjoyment of full revenue from said patent, by the licensor, may be reduced. This is a broad contract provision which prevents in many instances any possibility of the licensor being caused to suffer through unfair methods of the licensee. Furthermore, the provision from a legal

viewpoint is a blanket protecting provision for the whole contract involved.

Licensing under patents is a method of a very flexible nature whereby to derive returns from an invention. Where an invention is susceptible of use for different purposes, such as in different arts, a license may be caused to run for the use, manufacture, or sale of the invention as applicable to a pre-determined art. A concrete mixer in construction may be utilized as to certain features and subject matter of patent protection, as a tumbling barrel; it may be employed possibly for the mixing of dough. Manufacturers in these several arts do not compete with one another and provisions restricting the field of operation of different licensees in the different arts form possibilities of revenue not otherwise obtainable.

Shop Rights

An inventor when employed by a company or concern, often produces an invention under the direction, and at the expense, of the employer, and in his factory or shop. It may be that at times the special circumstances of this act are such that the patent rights to the invention do not pass to the employing concern. Nevertheless, there is created automatically a license right in the concern or company, or other employer, even tho a patent may properly later be issued to the inventor.

This employer's right consists of the privilege of manufacturing for his own use the invention developed under the conditions stated. The patent may pass from hand to hand, but the automatic license which has just been treated, known as "shop right," will remain undisturbed. It is complete save for the fact that it lacks assignability. The transfer thereof is not allowable, tho the right will pass with the business owning it when the business is absorbed or taken over as a whole.

XII

INTERFERENCES

In General—Priority of Invention in Interferences—Commencement of Interference—The Declaration of Interference—Proceedings after Declaration—The Preliminary Statement—Interlocutory Proceedings; Reformation; Dissolution—Final Proceedings—Appeals.

In General

When two or more applications for a patent are pending in the Patent Office, and claim the same invention or substantially like inventions, some method of adjudging who is entitled to the patent must be employed. The same is true when a patent has issued and includes claims which one (other than the patentee) believes belong to him as the inventor. The determination of who is the true inventor is the function of the procedure known as an interference, and the cause may involve two or more copending applications, or an application or applications and an issued patent. Because a patent is issued, therefore, the patentee is not secure against an interference.

It is notable, however, that as between the parties whose applications are copending *a preponderance of the evidence* in favor of one will win for him; whereas between a patentee and an applicant who files subsequent to the issue of the patent, the patentee is favored and the applicant must produce *proofs beyond a reasonable doubt* in order to secure the judgment of priority. Here, again, the presumptions are favorable to the patentee.

The Patent Office sometimes inadvertently issues a patent

when an interference should have been declared during pendency of the application. In this case, no advantage is gained by the inadvertent issue.

While the Commissioner of Patents may not cancel a patent, he is empowered to adjudicate an interference in which a patent is involved. Priority of the invention of the patent may thus be awarded to some one else besides the patentee. Thereupon the Commissioner may issue a second patent to the winning interferent, in effect voiding the first patent.

Upon issue of a second patent under the above conditions a court of equity, under Sec. 4918, R. S., may adjudge and declare either of the patents void in whole or in part.

The burden of proof is upon him who filed his application last, called the junior party to distinguish from the senior party, as the first to file is customarily called.

If there were possibly some slogan necessary to adopt for him who embarks upon the troubled tide of interference practice, an appropriate one worthy of suggestion and in accord with modern phraseology is, "Watch Your Step." The missing of a proper and timely effort in the procedure often entails so much added effort to regain the position to which an interferent is entitled, that the prosecutor must be careful and wary to the highest degree.

A thorough study and understanding of the interference rules is requisite. Presumably, rule study will be given throughout the different classes of work treated herein, but especially is it necessary in connection with *inter partes* cases. Dealing with single party cases has its troubles truly; however, interference or plural party cases offer manifold opportunities for being caught up by errors of commission or omission on the part of the uninitiated.

There is a time to file a certain motion, and if it is not filed within the allowed period, more work will frequently be involved in making a showing to obtain a hearing for the motion than is incident to the hearing of the motion itself.

Copies of records must be filed within a limited time and if not printed in time may lead to the loss of a cause. Briefs, too, may be proffered for consideration within definite periods, and upon objection will not be considered thereafter unless the delay is sufficiently excused. An appeal date passed, and a cause is lost.

These are a few of the minor requirements which offer possibilities of penalties to the party committing an oversight, and the practise abounds in similar and even more important ones.

Priority of Invention in Interferences

Since the purpose of an interference is to ascertain who is the *first* and *true* inventor as between the parties thereto, the question of whether an outside third party is the true inventor is not judicable as a result of taking the evidence in this class of proceedings.

It may be noted that the expression *first* and *true* inventor is employed above. The first inventor is not invariably entitled to a patent. There are considerations which govern, other than merely first invention, such as abandonment, suppression or concealment, and diligence, any one of which may control the final judgment.

As an example, suppose *A* invented a machine in 1917 and produced it in a practical form which he operated successfully that year. Thereupon, being a busy man, he turns to other work and for eighteen months until December 1918 he leaves this invention untouched. Afterward, in December 1918, he files an application for patent. But meanwhile *B* in January 1918 developed the same invention and with diligence applied for a patent in April 1918. *B* never built the machine. Under the foregoing conditions, *B* is entitled to an award of priority. The reasoning involved is that *A* either temporarily abandoned his invention or suppressed it, so that when an opposing claimant entered the field he was not exercising that effort in

bringing his invention to a patented condition, or to the use of the public, which the race of diligence requires in patent procedure.

To demonstrate how small a variation in the foregoing conditions would necessitate a different judgment, suppose *A*, instead of letting his machine remain idle, had put it in a shop, even a public one, and subjected it to the tests of commercial practise during that period of eighteen months. In such circumstances, he would be the first and true inventor because his diligence is not open to attack, and the factors of suppression or abandonment are absent.

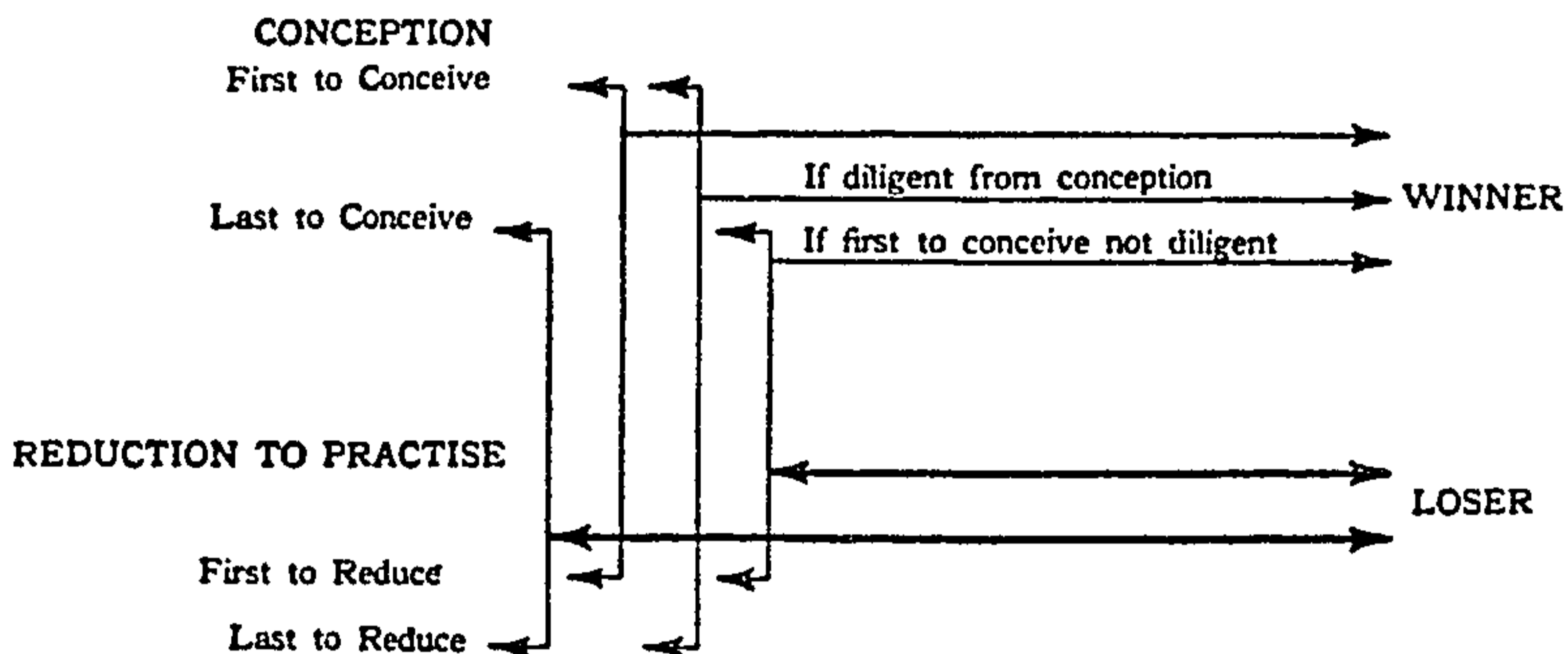


FIG. 11

The law does not compel the immediate filing of an application for patent. Two years are allowed for the filing, even after the invention is placed in public use. But if a rival inventor enters the field, the elements of diligence, abandonment, suppression, etc., become of great consequence and one or more of these factors may determine the complex question of true inventorship.

Legally, the filing of an application for patent is a great advantage. It constitutes what is known as a *constructive* reduction to practise of the invention; building and operating a successful machine, or practising a process or method successfully, constitute *actual* reductions to practise. The two classes of reduction to practise are of equal legal value in regard to their status as completing the *act of invention*. Additionally,

however, the application might be characterized as a public assertion of a claim for the invention.

This brings us to certain main and elementally important rules affecting the race of diligence determining priority of invention.

First Rule of Priority:

He who is the first to conceive and the first to reduce to practise is the first inventor.

Second Rule of Priority:

He who is the first to conceive and the last to reduce to practise is the first inventor if he demonstrated reasonable diligence from the time of his conception to the time of reducing his invention to practise.

Third Rule of Priority:

He who is last to conceive and first to reduce to practise is the first inventor when the first to conceive and last to reduce to practise was not diligent between these two primary acts of invention.

These rules may generally be relied upon as controlling the customary situations arising in regard to the relative positions of the parties in interferences. They have to do with the evidence adduced upon the taking of testimony, and not with the mere allegations of the preliminary statement.

Furthermore, the race of diligence runs between the conception and first reduction to practise of the invention. That is, if there are both actual and constructive reductions to practise, the later one may be ignored in interpreting the rules of diligence. Thus if the later reduction is the application filing and not the successful operation of the invention this filing date is immaterial, and may be ignored, and *vice versa*.

It has been held that where a party is first to conceive and first to reduce to practise, it is immaterial whether he was diligent between the times, or not.*

*Hubbard vs. Berg, 195 O.G. 818, Court of Appeals, District of Columbia.

A peculiar priority condition has arisen regarding proofs of joint inventorship in interferences, under a decision of the Court of Appeals of the District of Columbia,* holding that conception of an invention of a joint application for patent may not be proved as prior to a time of first meeting or coming together of the joint applicants.

It is not clear that a rule of this sort is applicable to all cases that may arise, though in the particular case then before the Court it may have represented the dispensing of justice.

Inventions are odd things because created in divers ways. We shall suppose that *A* conceived of a log-rolling device and even made sketches enabling a disclosure to others. Without finances he was able to go no further, though his broad conception was quite clear and equally practicable. Capital became interested, and *B*, an engineer, later met and collaborated with *A*. After considerable effort and improvement the invention was brought to a perfected or workable shape by development of features introduced by *B* and *A* cooperatively. Thereupon, an application for patent was filed for the invention as conjointly developed, including broader claims than were readable on *A*'s conception alone. Later, a machine was built and worked satisfactorily. To have built *A*'s crude conception would have been feasible, but not desirable in its imperfect state; and an application directed to it in its undeveloped construction was never made.

No invention is considered completed for patent purposes until an application is filed or a working device built. One of these things alone is necessary to bring the invention to the point of a reduction to practise, or what is viewed as equivalent. Inventions of which sketches are made, merely, are not completed inventions in the sense of the patent law. The sketches are only evidence of conception, as is a disclosure, or a model.

With a case of the class above outlined, claims for what was originally *A*'s crude conception are properly made in an appli-

* *Bayer and Brown vs. Bradley*, 237. O. G. 917; 46 Appeals A. C., 7.

cation of a joint nature presenting for the first time the completed invention. This being true the case presents an unprovable one under the noted decision, as regards the priority running back to *A*'s conception. Therefore, the original conception which inherently had to do with an uncompleted invention, can not be availed of by *A* and *B* together, tho only by their joint efforts was the invention completed, and only by *A*'s early efforts was the first conception created and the race of diligence sustained.

With a case of this nature before the court it is doubtful whether the broad declaration in *Bayer and Brown vs. Bradley* would be deemed of invariable applicability. Should it be so held, the situation would be that an invention conceived by one but completed by two, may be totally lost notwithstanding diligence continued from its conception. The one party is not the inventor because he did not complete his invention; the two are not the inventors since they did not jointly conceive the thing. To give *A* and *B* credit from the date they joined forces would not suffice when diligence runs from *A*'s conception; and *C*, a new party, entering the race with his conception alone, after *A*, but before the meeting of *A* and *B*, would win if he conceived much later than *A*, and exercised diligence to his reduction to practise, even if the latter were subsequent to that of *A* and *B*. A case of this sort would work injustice to no small degree. *Bayer and Brown vs. Bradley* is not believed to contemplate a case such as that cited above, and should be modified if it does.

In the case of *DeLaski and Thropp vs. Thropp & Sons*, 213 F. R. 464 and 226 F. R. 941, however, the lower court, sustained by the Court of Appeals of the Circuit, held:

* * * it is not to be thought, nor by the law required, that the inventive conceptions of two inventors shall develop simultaneously.

The same condition was recognized in *Worden vs. Fisher*, 11 F. R. 505; see also *Vrooman vs. Penhollow*, 179 F. F. 296.

Commencement of Interference

Interferences may be initiated upon motion of the Patent Office, so to speak, or upon motion of an applicant. In other words, the Patent Office upon noting a conflict of claims between two or more applicants' copending cases, or those of an applicant and patentee, will suggest claims to one party, or both, under Rule 96, so there may be claims common to the two cases as a basis of interference.

Again, an applicant may obtain information that another is seeking to usurp his invention, or he may note the issuance of a patent containing claims belonging to him, in his view, and thereupon suggest to the Patent Office the possible propriety of an interference in one instance; and by copying the claims create an interference in the second instance, assuming he has a right to the claims. These, in effect, are interferences really initiated on motion of the applicant.

Interferences will only be declared under the rules when one application is practically ready for allowance. An issued patent, of course, meets this condition of an allowable application.

Assuming that two applications, or an application and patent, contain one or more like claims, an interference is in order and the customary declaration will be made.

An applicant, by his attorney, should carefully determine whether he is entitled to make claims proposed to him under Rule 96, for purposes of an interference. If the claims suggested are readable on his invention in substance, as well as in terms, they should be inserted in the application as a matter of course; otherwise, the subject matter of the claims will be deemed disclaimed with all right to contest the question of priority relative thereto.

If the claims suggested can not properly be made by the applicant, it is advisable to insert them with reservations as to their allowability to him. Until the contents of the application in which they originated are studied, it is risky to dis-

claim upon first superficial consideration. The reservations submitted on entering the claims will form a basis for a later motion to dissolve. (See subject of *Dissolution of Interferences*).

The Declaration of Interferences

While the initiating of an interference may largely be effected by either an applicant for a patent or the official examiner, depending on circumstances, the declaration of the interference is almost wholly a matter of discretion with the Commissioner of Patents. The courts have made some inconsistent holdings in this particular connection, but the law is pretty well fixed by the United States Supreme Court in the case of *Ewing, Commissioner, vs. the U. S. ex rel. the Fowler Car Co.*, 238 O. G., 983, from which the following syllabus is illuminative:

It is to be remembered that the law gives the Commissioner both initial and final power.....
It is he who is to judge (be of opinion) whether an application will interfere with a pending one; it is he who, after an interference is declared and proceedings had, is the final arbiter of its only controversy, priority of invention.*

The declaration of an interference is the formal notice to the opposing parties that their applications are found to interfere. It names to each party the opposing party or parties, if more than two parties are involved, with the address and the name of the attorney of record for the opposing party, and the assignee of the application, if any. Additionally, the declaration states the issues in the form of counts which are the interfering claims to be found in both applications. Finally, the declaration calls upon the parties to file within a fixed time what are known as preliminary statements under

*NOTE: The Court of Appeals and the Equity Courts are the final arbiters.—Author.

oath, these giving certain dates affecting the inventions in conflict, which dates are to be later established by proofs. A preliminary statement from each party is required under Rule 110, and a specimen of such a statement will be found on page 328.

The declaration of an interference usually takes the following form:

*Forwarded from 25 Div. to 2-213 Paper No. 1
Examiner of Interferences (Interference)*

DEPARTMENT OF THE INTERIOR
UNITED STATES PATENT OFFICE
Washington, D. C.

November 30th, 1920

Doe & Doe,
Hanna Bldg.,
Cleveland, Ohio.

Please find below a copy of a communication from the Examiner concerning the application of R. E. Roe, filed Apr. 30, 1916, Ser. No. 98,761 ROASTING MACHINES.

Very respectfully,
ROBERT F. WHITEHEAD,
Commissioner of Patents

Room No. 135
Address only
The Commissioner of Patents
Washington, D. C.

No. 45261

The case, above referred to, is adjudged to interfere with others, hereafter specified, and the question of priority will be determined in conformity with the Rules.

The statement demanded by Rule 110 must be sealed up and filed on or before January 3, 1921, with the subject of the

invention, and the name of party filing it, indorsed on the envelope. The subject matter involved in the interference is:

A roasting machine comprising an oven, a sliding carrier arranged therein, a movable holder on the carrier, an operating device connected to the carrier to shift it back and forth in the oven, and means for causing the holder to float transversely during the shifting movement of the said carrier.

(a) The interference involves your application above identified.

(b) A patent for Roasting Oven granted to J. V. Roberts, Apr. 13, 1920, (filed Nov. 24, 1916) No. 1,962,735, whose attorney of record is Samuel Dobbs, Marquette Bldg., Chicago, Ill.

(c) The relation of the counts of the interference to the claims of the respective parties is as follows:

Count:	Roe:	Roberts:
1	26	11

Counts compared.

Examiner, Div. 25

For proper protection, when the same attorney represents two or more interfering parties, the Examiner is required under the rules to notify each party of this fact.

Proceedings after Declaration

As soon as the declaration of interference is in hand, several things must be determined.

The application held to interfere may comprise several inventions susceptible of being claimed in a single case, because intimately related or coordinated one to another. If the interference involves one of these inventions alone, it is possible for one interferent to avail himself of Rule 106, and divide out the non-interfering invention by filing a new and separate

application therefor, and thus facilitate the granting of a patent upon the latter.

If a certain mechanism only of the machine is involved, under Rule 105 the applicant is privileged to maintain the other features of his invention secret by filing a certified copy of that part of the specification, claims, and drawings, as relates to the interference, and the balance of the application may be sealed against the opponent. Liability of creating unwarranted conflicts is thus avoided.

A decision of a party not to contest an interference may be rendered effective to cause an adverse judgment by a concession of priority favoring his opponent, by default in the proceedings, or by a disclaimer by him or his assignee, representing that the subject matter held to interfere is not his invention. (A form of disclaimer is supplied herein.) These two courses will result in closing the interference by a judgment in favor of one of the parties. Every interference must conclude with such a judgment, unless it is dissolved upon a motion or motions based upon proper grounds specified in Rule 122, and which grounds will be treated hereinafter.

Assuming that the interference is to be contested and not avoided by default, disclaimer, or concession of priority, it is necessary to file the preliminary statement or pleading of facts and circumstances affecting the origin of the contested invention, and a period of thirty days is usually allowed for this step, a period which may, however, be extended.

The Preliminary Statement

As the initial pleading in the interference this statement requires very careful drafting. Upon its contents often hang the fortunes of the particular interferent, because once filed it cannot be easily amended, and under certain circumstances no amendment will be permitted.

The preliminary statement is required by Rule 110 and

gives under oath the dates of certain events and other matters germane to proving the priority of the invention, as follows:

Conception

First drawings

First disclosure to others

First written description

First date of building model (if any made)

First reduction to practise

Extent of use

Obviously the dates of conception and reducing to practise of the invention are the important things, the other dates merely involving matters supporting the above propositions when it comes to the proofs.

A model, if made, has about the same status as drawings in assisting to prove conception. (Walker on Patents.)

Technically, an invention is not viewed as complete unless it has been reduced to practise, and such is a common sense view.

When drawings, description in writing, or the actual invention, have not been made, the preliminary statement must so state.

A conception of an invention is never the mere thought of the need of doing a thing definitely desired; it resides in a complete idea of the means or method by which the desired thing or result may be attained. The conception may be disclosed by written data upon the invention, or by oral statements explanatory thereof; also by models giving to the invention form or substance.

The explanation of the extent of use is helpful to arrive at conclusions of whether the invention has proved an operative conception useful to the public and if so to what degree. After all, the greatest weight is attached to the bringing of an invention into a condition for public use, for that is the basic aim of the patent grant.

What constitutes an actual reduction to practise is fre-

quently the main point in controversy in an interference. Sometimes even an application for patent is contended as not constituting a constructive reduction to practise, as when a question arises as to whether the real contested invention is fully disclosed therein, and when the machine of the application is not operative as disclosed.

Generally, when a mechanical invention has been built and successfully operated under practical conditions of service, there is a complete reduction to practise; likewise, when a method has been completely and successfully performed. The phase of successful operation or performance is highly important *when that step is essential to a determination of the complete operativeness of an invention*. It is to be again emphasized that *actual not constructive* reduction to practise is being discussed, for the latter stands largely upon its own legs, so to speak, i.e., the disclosure of an application for patent which is a matter of record.

The qualification as to the requisite successful operation or performance respecting an actual reduction to practise is advised. As to some inventions, the operativeness phase is determinable on mere completion; respecting others, operation or performance under conditions of actual service is the required test to establish successful completion. Illustrating, a safety pin upon being finished may of itself show its full operativeness. But a machine may be complete, supposedly, and yet not a successful device in the eye of the law. In a well-known case a voting-machine contended to be a complete actual reduction to practise was held by the Court of Appeals of the District of Columbia not to be such because it was liable to failure of operation once in a hundred times. For such a machine the requisite of successful operation was, and is, accuracy to an absolute degree. Since this was not attained the machine built failed to fulfil its purpose as evidence of a successful completed invention. (McKenzie *vs.* Cummings, 112 O. G., 1481.)

The allegations of a preliminary statement as to dates of conception and reduction to practise must be made with a full comprehension of those features of the law that control these subjects; otherwise the dates may be wrongly set up.

Precaution demands that in submitting the dates in a preliminary statement any doubts as to times alleged be resolved in favor of the inventor.

It is difficult on the face of a preliminary statement to presume the real outcome of taking the testimony. Even when a constructive reduction to practise exists, the date of conception may be the burning issue, together with the race of diligence.

Failure to file a preliminary statement is the basis for the giving of judgment in favor of an opponent who presents his pleading in due form if the latter party is the first to have filed his application. When no statements are filed, the application priority controls the judgment.

Preliminary statements are filed carefully sealed up (see Rule 110) and are opened after the date of expiration of the filing period. They are then usually ready for inspection by the opposing interferences or their counsel.

On expiry of the time for filing preliminary statements, after the statement of each party is approved and opened for inspection by the opposing party, the parties' files are also released for examination. At this time, *and for the first time*, each party learns of his position in relation to his opponent as to dates of filing and contents of files.

That is to say, the relative positions of the parties, *prima facie*, are determined by the dates of their applications, and the dates alleged in the preliminary statements are merely the basis for proofs.

A party not filing any statement is restricted to the day of filing his application as the date of his (constructive) reduction to practise of his invention and he cannot be allowed to avail himself of any earlier date.

If on the opening up of the applications, *A* finds his filing date earlier than *B*'s conception date, *A* will be entitled to judgment of priority, whether or not he filed a statement, on the theory that his application is proof absolute of his completion of the invention before *B* even conceived it. If no judgment on the record, such as the above condition calls for, is in order, the next things timely under the rules are the interlocutory motions or proceedings.

Reverting to the matter of amendment of preliminary statements it is notable that, generally, the changing of the statement will be allowed if failure to do so might cause issue of a patent to one not the inventor. Customarily, the factors of injury to the opposing party, and extent of increased expense to the latter, will affect the decision as to whether or not to permit amendment. As regards the phase of injury, such as naturally follows a disclosure of the truth, a great amount of weight will not usually be attached thereto. (*Silver vs. Eustis*, 98 O. G., 2361; 1902 C. D., 91; *McDermott vs. Hildreth*, 98 O. G., 1282; *Gales vs. Berrigan*, 100 O. G., 232; 1902 C. D., 232.) After testimony in the interference has been taken the amendment of the preliminary statement will almost invariably be refused. Exception is sometimes made where the evidence which forms the basis for the motion to amend could not have been discovered by exercising proper effort and diligence at the time of making the original statement.

Under certain conditions, an assignee may and must make a preliminary statement, and defend an interference, if his interests are to be protected. Judgment on the record may properly be opposed, and often prevented, by motions to dissolve.

In conclusion, it is worthy to suggest that to allege mere fictitious dates in preliminary statements, is more harmful than beneficial. Such course shows up on proofs being taken and tends to reflect discredit upon true testimony.

Therefore all statements should be carefully prepared by being based on actual facts and by setting up accurate dates susceptible of being substantiated later, on the taking of depositions.

Interlocutory Proceedings

REFORMATION; DISSOLUTION

Interferences involve two stages, that for proceedings which are interlocutory or take place between the date of filing the preliminary statement and the commencement of the taking of evidence, and the second stage when proofs are actually adduced by depositions and a final hearing had thereon.

The interlocutory proceedings are usually directed to questions affecting the form or validity of the interference declaration, while the final proceedings have to do with the merit of the cause which is the settling of the priority contentions of the parties.

The period in which to file preliminary statements being ended, they are duly approved when received and in proper form (Rule 108). At this time, periods are set in which the parties shall take testimony, and a preliminary thirty days time is allowed for filing of interlocutory motions, subject to extension.

Motions to reform the interference should be filed at this time, if either party wishes to put in issue claims other than those on which the original interference is based, or perhaps desires to substitute or include a different application.

It may be that a party has an application containing subject matter on which the issue counts read, which application has an earlier filing than that in the interference. If said party is junior in the interference he should at this time move to shift the burden of proof.

At times, the Patent Office declares interferences by mistake.

This is due in most instances to failure to discover the most pertinent prior art or publications bearing upon the invention in controversy. Obviously, there is no advantage in determining priority of invention when the invention is not patentable. Under these conditions, a motion to dissolve on the ground of non-patentability is in order.

Again, the Patent Examiner may really misinterpret what a claim means, and on this account an interference is sometimes declared by proposing such a claim to a party who has no right to make it. When this condition arises, the party who feels that he or his opponent has no right to the claim, or that neither is entitled to the claim, may move to dissolve on such ground or grounds.

An interference may be declared by an informality precluding proper determination of the question of priority. In such event, dissolution is in order.

A motion to dissolve must state explicitly the ground or grounds on which it is brought, and explain each ground briefly enough for a clear understanding thereof. A typical motion to dissolve is found hereinafter.

Motions to dissolve are brought under Rule 122 and if in proper form will be set for hearing before a Law Examiner on a day certain.

It is usual for motions of this character to be brought by a junior party, he being the one on whom the burden of proof rests in the interference. The practise permits either party to move for dissolution, however. It is doubtful if this system operates with very great efficiency. Often, dissolution effort is used as a means of delaying judgment and can be so employed with great ease.

An improvement on the present methods of dissolution would be to have every case reexamined by an independent examiner after a possible interference is suggested. If a mistake has been made in the examination of the prior art,

or in regard to the rights of the parties to the claims, it may be rectified in good time. Motions to dissolve on the ground of non-patentability might be required in advance of opening the file wrappers to the parties, so that such motions would be entirely *bona fide*, not brought merely because a party happens to find himself on the losing side of the cause according to the positions established by the filing dates. This practise might result in hardship occasionally, because an issue count is not always clear when read independently of a specification.

Ample opportunity is, therefore, afforded to the party who feels that dissolution is proper, to put an end to an interference before contesting the question of priority. If there existed an equal opportunity to complete the whole interference cause promptly the practise would be much improved. When it is possible to hold off the taking of proofs in an interference for many years, through proper proceedings, or mere delays of the Patent Office and counsel for the parties, the operation of interferences is not what it should be.

A knowledge of the rules of dissolution is greatly to be desired for effective results in supervising the proceedings in interferences. To stop the interference at the right time is highly essential. If the conflict as established is justified, the next steps after reforming or failure to dissolve are the final proceedings.

When an applicant has copied claims from a patent to obtain an interference, he is not permitted to move for dissolution of the interference on the ground of non-patentability of the issue count or counts. The theory here is that to allow the foregoing action is simply opening the opportunity for a judgment (of dissolution) that casts a cloud upon the patent. The Patent Office holds that if the claim or count is not patentable, it is invalid and will so prove if taken into the courts; therefore, and in this way, the Office perpetuates its own mistake, occasionally. Much that is logical may be said in opposition to this particular patent practise.

Final Proceedings

If no interlocutory motions are filed, or those filed duly heard, and no dissolution is ordered, and after a reformation if needed, the parties must take their testimony.

Interference testimony is taken by depositions under Rule 154. To detail the requirements of this rule is not necessary. The provisions are strict and must be followed closely, reasonable changes in certain formalities being allowed by stipulation between counsel.

When the testimony is ready to be taken in the time allotted, that of the junior party comes first, of course. A notice of taking of depositions in the form prescribed is first sent to the opposing counsel, or interferent, usually the former, inviting him to cross-examine. Service should be made personally and an acknowledgment thereof indicated on the notice, or service had by mail under the provisions of the rules. (Rule 154 b.)

It is worthy of note to suggest that it is as poor a plan to take testimony without the careful outlining or preparation of the case, with a knowledge of the facts to be proved and evidence to put in, as to prepare a patent specification and claims with an inadequate knowledge of the invention to be covered thereby.

The actual taking of depositions calls for great care and painstaking work. The customary rules of evidence govern the proceedings, but unfortunately no court is present to determine the admissibility of testimony, or the evidence itself. Hence much is frequently presented that is irrelevant.

The parties' counsel meet, upon notice, at the place designated for the taking of the depositions, after previous arrangement for the presence of the officer before whom the depositions are to be taken. This officer is usually a notary public, or official qualified to administer an oath, tho by stipulation another may act as Special Examiner. He must not be interested in the controversy in any way.

It much simplifies matters when the officer is a reporter and can take the testimony. The testimony must be written out by this officer, or some one in his presence, under the rules. This plan is rarely followed save when the officer is the reporter. When a stenographer handles the actual taking of the depositions it is the custom to permit the notary to administer the oaths and retire, and if desired, a stipulation to this effect may be entered on the record.

Again, the rule requires that the testimony be written out in the presence of the officer, and this is seldom done. The notary so states in his certificate, however, and no one attempts to go behind this record.

It is sometimes desired by opposing counsel that the depositions be written out on a typewriter as they proceed. Cross-examination is thus facilitated when a case is of a certain character requiring close questioning of a witness or witnesses. This method may be insisted upon because strictly speaking it is required under the rule. (Rule 156.) When the depositions are taken down stenographically, and then transcribed, a stipulation is customarily and necessarily entered to the effect that such method may be pursued.

While it is required that the depositions be read over and signed by the witnesses, counsel may and often does waive the necessity for these things in the interest of the saving of time and trouble. It is rather advisable, however, to have the witnesses read their depositions since a palpable mistake of the reporter is often corrected.

Legal or foolscap paper should be employed for the depositions, a wide margin at the left maintained, the witness's name supplied at the top of each page, and the pages numbered consecutively, as well as the questions.

As is always the case, care must be exercised to offer in evidence all exhibits relied upon, after the basis for their introduction is made; also, identification should be carefully attended to.

When the depositions are completed, the officer who is to attend to the completing and forwarding to the Patent Office should be fully instructed what to do. He must attend to the following essential things:

1. Mark each exhibit with its identifying symbol and see that it is entitled properly in the cause.

2. Attend to the writing out of the depositions, submit them to the witnesses for reading, and see that they are signed.

3. Prepare a certificate in accordance with a form usually supplied to him in fairly complete condition by counsel, being Form No. 46 of the Rules of Practise.

4. Address the package containing completed and signed depositions, and paper exhibits, to the Commissioner of Patents, Washington, D. C. and certify to the same as follows:

I hereby certify that the within depositions of, relating to Interference No., entitled were taken, sealed up, and addressed to the Commissioner of Patents by me this day of, 1920.

ROBERT ROSS
Notary Public

If paper exhibits are enclosed, the above certificate may so state. If large exhibits go forward separately, a corresponding certification to this, authenticating the same, is required—on the container of such exhibits.

When the junior party has completed his depositions, the senior party takes his testimony, after which rebuttal depositions may be taken by the first named party. Surrebuttal proofs are allowed only in exceptional cases.

The officer before whom depositions are taken must promptly complete the writing out thereof, the signing, and transmission to the Patent Office.

When a witness is not obtainable otherwise, he may be subpoenaed by the clerk of a United States District Court so as to compel his attendance for examination in an interference proceeding.

The patent laws as recently amended provide that Sec. 869 of the Revised Statutes relating to the issuance of subpoenas *duces tecum* shall apply to contested cases in the Patent Office, i.e., interferences.

The effort here has been not to indicate what requirements are called for by the rules respecting the taking of the depositions, so much as just how the rules operate in practice. There is always a certain amount of mechanical working out of the details incident to the taking of testimony which results in a somewhat automatic adjustment of these details, much to the advantage of all concerned.

A word or two of caution at this point may be appropriate. It answers no good purpose to be too technical in dealing with questions arising during the taking of depositions. Experience dictates that a fair degree of liberality should be allowed an opposing counselor in conducting his case. Objections made as to those things not really affecting the merits or rights of the party represented by the objector, are of little consequence, and if persisted in may result in a prejudice against said party. The examination of witnesses is governed by well known rules of evidence and compliance with these may be insisted upon at all stages where desirable or necessary. The mutual convenience of counsel should be served as much as possible consistent with a fair degree of promptness in speeding up the completion of the taking of proofs. This latter the Patent Office requires to some extent.

If any objection, motion to strike out, etc., affecting the testimony, is to be pressed, the moving party should act quickly after the occasion for the motion arises. Mere technicalities in no way materially affecting the rights of parties are usually ignored by the Patent Office.

All depositions and evidence of the interfering parties being completed, the final hearing is had before the Examiner of Interferences who is the judge authorized in the first instance to decide the question of priority of invention. The junior party opens and closes on the arguments at final hearing.

Forty days prior to the final hearing the junior party's testimony in the form of a printed record must be filed; twenty days prior to such hearing the record of the senior party is due; and printed briefs are due at the Patent Office three days before the hearing.

Appeals

From the decision of the Examiner of Interferences, awarding priority to one of the parties to an interference, appeal lies to the Board of Examiners-in-Chief, thence to the Commissioner of Patents, and from him finally to the Court of Appeals of the District of Columbia. If the losing party is dissatisfied after the final appellate judgment, he may start anew the litigation over the question of priority by bringing a suit in equity under Sec. 4915 R. S., to compel the Commissioner of Patents to grant to him a patent. In such a suit all questions previously litigated may again be raised and new evidence offered enlarging that produced in the interference in an effort to strengthen the testimony which was originally offered.

Summarizing therefore, it is to be noted that there may be had special recourse to the Law Examiner on a motion to dissolve and that four tribunals have jurisdiction to decide a question of priority, namely, the Interference Examiner, Examiners-in-Chief, Commissioner, and the Court of Appeals. Then the decision may be reviewed by the equity suit, the latter, however, seldom resulting in a change in the decision of the Court of Appeals.

A most excellent chart of the jurisdiction of appellate tribunals over different phases of an interference has been devised by an Examiner-in-Chief of the Patent Office, F. C. Skinner, and is incorporated herein as an aid to the student and a handy guide to the experienced attorney.

APPELLATE JURISDICTION IN INTERFERENCES

Nature of the proceeding	Tribunal before whom the proceeding should be first brought	Appeal Lies To			Remarks
		Board	Commissioner	Court	
Motion to dissolve for unpatentability.	Law Exr.	Not unless it is granted.	Not unless it is granted.	No.	Interference continued unless motion is granted by last tribunal that adjudicates.
Motion to dissolve because opponent has no right to make claims.	Law Exr.	Not unless it is granted.	Not unless it is granted.	No.	If motion is refused interference is continued with right to have the matter reviewed under 130.
Motion to add claims under Rule 109.	Law Exr.	Not if it is granted.	Not if it is granted.	No.	
Question raised under Rule 130.	Exr. of Int. if there is evidence that was not before Law Exr. on motion for dissolution under Rule 122.	No, but may be reviewed on appeal from award of priority.	No, but may be reviewed on appeal from award of priority.*	No, but may be reviewed on appeal from award of priority if raised below.	In ancillary to question of priority.
Motion to shift burden of proof.	Exr. of Int.	No.	No.	No.	
Timely motions not provided for in Rules 109, 122.	The one having jurisdiction of case at the time.	No.	Yes, if appealable in his judgment.	No.	
Evidence to show priority.	Exr. of Int.	Yes.	Yes.	Yes.	Pat. Off. may afterwards consider question of patentability. Bill in equity may be brought by defeated party under 1915 R. S.

* The Commissioner has the power under his supervisory authority to correct any manifest error committed by the lower tribunals, such as: to postpone time for preliminary statements; to correct statements; to require opponent to correct statement; to withdraw parts under Rules 105 and 106; to extend time for taking testimony; to have hearing postponed; to effect stay of proceeding; to permit assignee to intervene; to dismiss petitions, etc. The number and nature of motions are limited only by the attorney's ingenuity and the party's purse, except that obviously and flagrantly dilatory motions will not be entertained. From *Journal of the Patent Office Society*.

A more unwieldy procedure than this of interferences, and one which taxes more the resources and patience of a litigant, can scarcely be imagined. How it has been possible to maintain interference practise in this complicated condition during the many years of its existence is a source of wonder to students thereof. To be critical without being constructive is useless. A remedial suggestion or two, may, therefore, be offered with some diffidence.

A single final decision in the Patent Office, with the appeal to the Court of Appeals, would suffice to ensure complete justice to the patent interferent. The elimination of decisions by the Examiner of Interference and the Commissioner would highly benefit the procedure as regards rendition of final judgment.

Printing of records and briefs for Patent Office use should be done away with at the risk of some slight inconvenience to the Examiners-in-Chief. This work takes considerable supervision and time of the attorney, and money of a litigant, and is avoidable.

To retain the jurisdiction of courts of equity under Sec. 4915, R. S., is surplusage, even tho this step by way of review is not often resorted to.

Where a patent has *inadvertently* issued, and a copending applicant claims the same subject matter, instead of the latter being compelled to go through an interference it would be far more equitable for the Commissioner to allow the injured party's patent to issue, and for the courts then to adjudicate the question of priority. Then the interfering patent could not hold up the rights of the applicant who may be entitled to the priority judgment and infringement profits, etc., as is done to-day. Sec. 4918 provides a method of doing this very thing.

If a special board of review, authorized to reexamine the whole situation preliminary to promulgating the interference, were established, many of these litigations would not be de-

clared, and the dissolution proceedings could possibly be dispensed with.

Compulsory arbitration of interferences offers a possible solution. This is the Canadian practise, but so little Canadian litigation of this sort has taken place that the success of this method has not been demonstrated. It is safe to say that no such endless procedure as a United States patent interference is to-day approved in any other country and corrective legislation is necessary. In fact, so burdensome have become the processes and delays of patent interferences that conscientious counselors hesitate long before committing clients to this class of litigation. Compromise, submission to arbitration, indeed almost any method except that established by the Government, is infinitely preferable to the endless and unsatisfactory interference, so called.

XIII

SPECIAL FORMS AND PROCEDURE

Powers of Attorney—General Power of Attorney—Associate Power of Attorney—Power of Attorney by Substitution—Power to Inspect—Form of Assignment: Of Invention Resting in Application; Of Patent After Issue—Form of Petition for Renewal—Form of Disclaimer After Patent—Typical Form of Petition for a Certificate of Correction of Letters Patent—Typical Form for a Petition to Revive an Abandoned Application—Typical Form of Non-Exclusive License—Reciprocal License Agreement—Agreement: Transfer of Patented Invention and Business—Contract Between Employer and Employees as a Group. (See Interference Forms, Chapter XIV.) (Also see Typical Cases, Chapters XV, XVI, XVII, XVIII.)

Powers of Attorney

It is at times necessary, or desirable, that during the pendency of an application a change of the attorney of record be made. To revoke the original power in an application, and constitute a new attorney with full power to prosecute the case, is within the right of the applicant. The Patent Office will not recognize two different attorneys of record, and communicate with them as such, however, nor will communication be held with both the applicant and his attorney. When a new attorney is empowered to act in the case, therefore, it is customary to revoke the previous power. If no revocation is made the Patent Office will recognize the last empowered attorney.

When the power of attorney of an attorney is revoked and no new attorney given power to act, the applicant will be recognized and correspondence thereafter conducted with him by the Patent Office.

Notice is always given by the Patent Office of both the

acceptance and revocation of a power of attorney, and all powers of attorney must be in writing.

The owner or assignee of an application has the right to control the prosecution thereof to the exclusion of the applicant or inventor signing powers for this purpose.

An original attorney, one appointed by the applicant or owner of an application, and known as the attorney of record, may appoint an associate attorney to conduct the prosecution of an application, and the associate will then be recognized until the associate power is revoked either by the original attorney of record, or automatically by the revocation of the power of the original attorney. An associate or substituted attorney cannot appoint a third agent or attorney. (Rule 19.)

Death of the applicant automatically revokes the power of attorney.

Applications will not be permitted to be prosecuted by others than the applicant, or an attorney qualified by being registered upon the roster of attorneys of the Patent Office.

A person or concern may be given power to inspect the contents of a patent application either by the applicant, his attorney, or the assignee of an application.

Following are the usual forms of powers for the purposes above outlined:

General Power of Attorney

IN THE UNITED STATES PATENT OFFICE

To the Commissioner of Patents,
Washington, D. C.

Sir:

The undersigned having on or about the _____ day of _____, made application for Letters Patent for an improvement in _____, Serial No. _____, hereby appoints the firm of _____, (_____ constituting said firm) Register No. _____, of _____, his attorneys,

with full power of substitution and revocation, to prosecute said application, to make alterations and amendments therein, to sign the drawing, to receive the patent, and to transact all business in the Patent Office connected therewith. All previous powers are hereby revoked.

Signed at _____, in the county of _____,
State of _____, this _____ day of _____,

.....

Applicant.

NOTE: The above power may be signed by the assignee of an entire interest in an invention. Rule 5.

Associate Power of Attorney

IN THE UNITED STATES PATENT OFFICE



Inventor's Name—Richard E. Roe
Title of Invention—Desk Pad
Date of Filing—Jan. 1, 1920
Serial Number—879,456

ASSOCIATE POWER OF ATTORNEY

Hon. Commissioner of Patents,
Washington, D. C.

Sir:

In the matter of the above entitled application, please recognize Messrs. _____, Washington, D. C., Reg. No. _____ as _____ associates, with full power, all prior powers of attorney being hereby revoked.

.....

Attorney in Fact.

Power of Attorney by Substitution
IN THE UNITED STATES PATENT OFFICE

Name of Inventor—Richard E. Roe
 Title of Invention—Desk Pad
 Date of Filing—Jan. 1, 1920
 Serial Number—879,456

Hon. Commissioner of Patents,
 Washington, D. C.

Sir:

In the matter of the above entitled application, I hereby substitute _____, of _____, Register No. _____, for myself as attorney of record, with full power.

.....
Attorney in Fact.

Power to Inspect
IN THE UNITED STATES PATENT OFFICE

Name of Inventor—Richard E. Roe
 Invention—Desk Pad
 Filed—Jan. 1, 1920
 Serial Number—879,456

POWER TO INSPECT

Hon. Commissioner of Patents,
 Washington, D. C.

Sir:

In the matter of the above entitled case, please permit Messrs. _____, Washington, D. C., to inspect the papers and drawings and make copies thereof.

Signed at _____, county of _____,
 State of _____, this _____ day of _____.

.....
Applicant or Attorney.

Forms of Assignment

ASSIGNMENT OF INVENTION RESTING IN APPLICATION

WHEREAS, I, RICHARD E. ROE, of Milwaukee, in the County of Milwaukee, and State of Wisconsin, have invented a certain new and useful improvement in

DOUGH MIXERS

for which I am about to make application for Letters Patent of the United States; and

WHEREAS ROE MANUFACTURING COMPANY, a corporation of Milwaukee, County of Milwaukee, and State of Wisconsin, is desirous of acquiring an interest in said invention and in the Letters Patent to be obtained therefor:

NOW, THEREFORE, to all whom it may concern, be it known that for and in consideration of the sum of One Dollar, to me in hand paid, the receipt of which is hereby acknowledged, I, the said RICHARD E. ROE, have sold, assigned and transferred and by these presents do sell, assign and transfer unto the said ROE MANUFACTURING COMPANY, the full and exclusive right to the said invention, as fully set forth and described in the specification prepared and executed by me on even date herewith, preparatory to obtaining Letters Patent of the United States therefor (including all rights to foreign patents),* and I do hereby authorize and request the Commissioner of Patents to issue the said Letters Patent in accordance with this assignment.

IN TESTIMONY WHEREOF I have hereunto set my hand and affixed my seal this _____ day of _____, 1920.

..... (SEAL)

Sworn to and subscribed before me this _____ day of _____, 1920.

(SEAL)

Notary Public.

*Use this parenthetical clause when company owns all rights to inventions.

ASSIGNMENT OF COMPLETE APPLICATION AND OTHER RIGHTS

WHEREAS, I..... a citizen of the United States and resident of.....County of..... and State of.....have invented an improvement inand have executed an application for letters patent of the United States of America, based thereon, thisday of.....; and

WHEREAS....., a duly organized corporation, having its principal place of business in....., is desirous of acquiring the entire right, title and interest in and to the said invention in and throughout the United States of America, its territories, and all countries foreign thereto, and in and to the said application for letters patent, and in and to any and all letters patent of the United States of America and countries foreign thereto, which have been or may be granted on said invention or any part thereof; have been

NOW, THEREFORE, for and in consideration of the sum of One (\$1.00) Dollar to me in hand paid, receipt whereof is hereby acknowledged, I.....do hereby sell, assign and transfer unto the said..... the entire right, title and interest in and throughout the United States of America, its territories, and all countries foreign thereto in and to said invention, said application for letters patent and any and all letters patent and extensions thereof, of the United States of America and countries foreign thereto, which have been or may be granted on said invention or any part thereof, or on said application or any divisional, continuing, renewal, reissue or other application, based in whole or in part thereon, or based upon said invention;

TO BE HELD and enjoyed by the said....., its successors and assigns, to the full ends of the terms for which said letters patent or any of them have been granted or may be granted, as fully and entirely as the same would have been held and enjoyed by me had no sale and assignment of said interest been made; and I do hereby authorize and request the Commissioner of Patents of the United States of America to issue any and all letters patent of the United States of America which may be granted upon the said applications above referred to, or any of them, or upon said invention or any part thereof, to theaforesaid; and I hereby agree for myself and for my heirs, executors, and administrators, to execute without further consideration, any further legal documents and any further assignments, and any reissue, renewal, or other application for letters patent that may be deemed necessary by the

assignee herein named, fully to secure to the said assignee its interest as aforesaid in and to said invention or any part thereof, and in and to said several letters patent or any of them.

And I do hereby covenant for myself and my legal representatives and agree with the....., its successors and assigns, that I have granted no license to make, or sell the said invention, that prior to the execution of this deed my right, title and interest in the said invention had not been encumbered, that I then had good right and title to the sale and assignment of the same, and that I have not executed and will not execute any instrument in conflict herewith.

IN WITNESS WHEREOF I have hereunto set my seal this.....day of....., 1921.

(Note: Include usual notarial acknowledgment.)

ASSIGNMENT OF PATENT—AFTER ISSUE

WHEREAS, I, _____, of _____, county of _____, State of _____, did obtain Letters Patent of the United States for an improvement in _____, which Letters Patent are numbered _____, and bear date the _____ day of _____, 19____; and whereas I am now the sole owner of said patent; and whereas _____, of _____, county of _____, State of _____, is desirous of acquiring the entire interest in the same:

NOW, THEREFORE, in consideration of the sum of _____ dollars, the receipt of which is hereby acknowledged, I, _____ by these presents do sell, assign, and transfer unto the said _____, the whole right, title, and interest in and to the said Letters Patent therefor aforesaid; the same to be held and enjoyed by the said _____, for his own use and behoof, and for the use and behoof of his legal representatives, to the full end of the term for which said Letters Patent are granted, as fully and entirely as the same would have been held by me had this assignment and sale not been made.

Signed this _____ day of _____, 19____.

Sworn to and subscribed before me this _____ day of _____, 19____.

Notary Public.

Form of Petition of Renewal

IN THE UNITED STATES PATENT OFFICE

In re application of—
Roe and Roe,
Record Mechanism,
Filed March 27, 1911,
Serial No. 617,201,
Allowed November 11, 1914.

PETITION FOR RENEWAL

Hon. Commissioner of Patents,
Washington, D. C.

Sir:

Your petitioners, Richard E. Roe, and Samuel C. Roe, citizens of the United States, residents of Hillsboro, in the county of Washington, and State of Oregon, and Portland, in the county of Multnomah, and State of Oregon, respectively, whose post office addresses are Hillsboro, Oregon, and Portland, Oregon, respectively, represent that on March 27th, 1911, they filed an application for Letters Patent for the improvement in RECORD MECHANISM, Serial Number 617,201, which application was allowed on November 11, 1914, but that they failed to make payment of the final fee within the time allowed by law. They now make renewed application for Letters Patent for said invention and request that the original specification, oath and drawings be used as a part of this application.

The renewal fee of \$20.00 is filed herewith.

Respectfully submitted,

RICHARD E. ROE
SAMUEL C. ROE

May 24, 1915.

NOTE: This petition may be signed by the attorney for the applicant or applicants.

**Form of Disclaimer After Patent
IN THE UNITED STATES PATENT OFFICE**

DISCLAIMER AFTER PATENT

Hon. Commissioner of Patents,
Washington, D. C.

Sir:—

Your petitioner, Richard E. Roe, a citizen of the United States, residing at Portland, in the county of Multnomah, and State of Oregon, represents that in the matter of a certain improvement in Sand Deliverers for which Letters Patent of the United States Number _____ were granted to said petitioner and Samuel S. Roe jointly, on the 28th day of February, 1911, he is the assignee of the interest of the said Samuel S. Roe in and to the said Letters Patent, said interest having been transferred to him by an assignment duly recorded on October 12, 1909, in Liber I 82, page 402 of the assignment records of the United States Patent Office; that he is now the sole owner of the said Letters Patent and that he has reason to believe that through inadvertence, accident and mistake the specification and claims of said Letters Patent are too broad, including that of which said patentees were not the joint inventors. Your petitioner therefore hereby enters this disclaimer to the claim in said specification which is in the following words, to wit:

Claim 4. In a sand-delivery machine, the combination of a plurality of sand receptacles, an ejector bar associated with each of said receptacles, an actuating member for moving each ejector bar and normally inoperative with relation thereto, means for operating the actuating member, and means for moving the ejector bar bodily in the plane of its ejecting movement to cause it to assume an operative position with respect to its actuating member preliminary to its operation to deliver sand.

The fee of Ten Dollars required by law for the recording of this disclaimer is herewith transmitted.

Signed at Portland, in the county of Multnomah, and State of Oregon, this _____ day of _____, 19____.

RICHARD E. ROE
(Disclaimerant)

Witnesses:

1.....

2.....

**Typical Form of Petition
For a
Certificate of Correction of Letters Patent
IN THE UNITED STATES PATENT OFFICE**

RICHARD E. ROE,
Adding & Listing Machine
Patented July 25, 1916
Patent No. 1,192,721

PETITION FOR CERTIFICATE OF CORRECTION

Hon. Commissioner of Patents,
Washington, D. C.

Sir:—

Attention is respectfully directed to the following discrepancies between the application as on record in the Patent Office and the documentary Letters Patent above noted, as issued.

Claim 3 (page 10, lines 13 and 14 of the printed patent) the words "included in the accumulating mechanism and" should be canceled. (See amendment filed May 23, 1913.)

Claim 4 (page 10, lines 28 and 29 of the printed patent) the words "the accumulating mechanism comprising" should be canceled. (See amendment filed May 23, 1913.)

In view of the foregoing it is asked that a Certificate of Correction be applied to these Letters Patent, and copies thereof, for which purpose the original Letters Patent are surrendered herewith.

Respectfully,

JOHN F. DOE,

Attorney for Patentee.

Washington, D. C.,
August 11, 1916.

Typical Form for a Petition to Revive an Abandoned Application

IN THE UNITED STATES PATENT OFFICE

PETITION TO REVIVE

Hon. Commissioner of Patents,
Washington, D. C.

Sir:—

Your petitioner, Richard E. Roe, a citizen of the United States and resident of Milwaukee, in the county of Milwaukee, and State of Wisconsin, whose post-office address is Majestic Building, Milwaukee, Wisconsin, represents that on the 14th day of April, 1910 he, jointly with James S. Roe, filed an application for Letters Patent for an improvement in Candy Delivery Machines, Serial Number 555,552, which said application on the 5th day of December, 1913, became abandoned through failure to prosecute same. Your petitioner therefore prays that said application may be revived in view of the facts and circumstances as set forth in the accompanying affidavits, and that the accompanying amendment be entered.

Signed at Milwaukee, in the county of Milwaukee, and State of Wisconsin, this day of , 1914.

RICHARD E. ROE

As the actual owner of the invention of the above application the undersigned joins in above petition.

INTERNATIONAL CANDY MACHINE COMPANY,

By.....

President.

IN THE UNITED STATES PATENT OFFICE

Richard E. Roe, et. al.
Candy Delivery Machines
Filed April 14, 1910
Serial Number 555,552

State of Wisconsin }
County of Milwaukee } ss.

Richard E. Roe, being duly sworn deposes and says that he is one of the applicants in the matter of the above entitled application; that by an instrument duly recorded in the United States Patent Office in Liber X-83, Page 448, he became the sole owner of record of all right, title and interest in and to said application.

That by certain contracts in due form of law affiant has assigned to the United Candy Company, of Milwaukee, Wisconsin, a corporation, all right, title and interest in and to the invention of this application.

That the above entitled application on December 5th, 1913, became abandoned through failure to respond to an official action on said case of date of December 5th, 1912.

That the said abandonment of the above application resulted owing to the following circumstances:

Owing to the transfer of all interest in this application by affiant, to the United Candy Company aforesaid, the last named company has for a period of approximately three years had exclusive charge of the prosecution of the application and was responsible for payment for all services rendered in relation to such prosecution. At the time of the filing of said application affiant retained Messrs. Doe & Doe as attorneys for the purpose of procurement of patent. That said firm was duly continued as attorneys of record in this case by the United Candy Company and that John F. Doe has been retained in recent years by the United Candy Company for the purpose of transacting all business connected with its various patent applications. Under date of the 11th day of November, 1913, the United Candy Company by registered mail was served with notice from the said attorney John F. Doe of his withdrawal from the prosecution of the above entitled application and all other applications for patents in which said attorney represented the said company. The cause of the said withdrawal by the said attorney, from the prosecution of the aforesaid application was as follows:

(State grounds briefly)

The patent rights and rights to manufacture the inventions of said concern are controlled by a newly organized company, International Candy Machine Company, of Milwaukee, Wisconsin.

Affiant further states that said newly organized company is now responsible to the said attorney for the prosecution of this application and has retained him for this purpose and for the purpose of presenting this petition to the Honorable Commissioner of Patents.

Affiant further states that the negotiations leading up to said reorganization, and the incorporation and establishment of the International Candy Machine Company on a financial basis have consumed practically all of the time which has elapsed since the abandonment of this application, wherefore the presentation of this petition has not been delayed except unavoidably owing to the particular conditions hereinbefore set forth.

Affiant further states that he is a director of the United Candy Company, the corporation above referred to, and therefore acquainted with the facts herein stated which to the best of his knowledge and belief are true as set forth.

Affiant further states that to the best of his knowledge and belief the conditions surrounding the abandonment of the above application were unavoidable.

RICHARD E. ROE

Subscribed and sworn to before me this _____ day of
, 1914.

JOHN SMITH,
Notary Public.

IN THE UNITED STATES PATENT OFFICE

Richard E. Roe, et al.
Candy Delivery Machines
Filed April 14th, 1910
Serial Number 555,552

District of Columbia }
City of Washington } ss.

John F. Doe, being first duly sworn, deposes and says that he constitutes the firm of Doe & Doe, in the matter of the above entitled application; that he has read the affidavit of Richard E. Roe annexed hereto and believes that the allegations are true. Affiant further states that on the 15th day of July, 1914, while affiant was at the office of International Candy Machine Company,

of Milwaukee, Wisconsin, he was authorized by the Secretary-Treasurer of said company to take the necessary steps at once for the revival of said application, and that acting in accordance with said instructions and with the understanding that said International Candy Machine Company is to pay all expenses incidental to the completion and issue of patent on this application, deponent promptly upon return to his place of business at Washington, D. C., prepared the accompanying petition and affidavit for the purpose of revival of said application.

JOHN F. DOE

Subscribed and sworn to before me this
, 1914.

day of

JOHN SMITH,

Notary Public.

IN THE UNITED STATES PATENT OFFICE

Richard E. Roe, et al.
Candy Delivery Machines
Filed April 14, 1910
Serial Number 555,552

AFFIDAVIT

State of Wisconsin }
County of Milwaukee } ss.

Samuel C. Wolley, being first duly sworn, deposes and says as follows:

First: That he is informed and believes that the above application became abandoned December 5th, 1913.

Second: That deponent during the year 1913 was auditor for United Candy Company, Milwaukee, Wisconsin, and that at the time of the abandonment aforesaid the United Candy Company was involved in legal proceedings incidental to the opposition to the appointment of permanent receivers for said company; and that during December, 1913, and January, 1914, said company was in the hands of temporary receivers.

Third: That the International Candy Machine Company of Milwaukee, Wisconsin, is a corporation organized January 29, 1914, as a manufacturing company subsidiary to the United Candy Company, now primarily a holding company.

Fourth: That under a contract between the above named companies, and under the terms of the organization of the International Candy Machine Company, all machinery in the factory of the United Candy Company then located at Racine, Wisconsin,

sin, had to be transferred to the factory of the International Candy Machine Company at Milwaukee, Wisconsin, together with patents and other property including especially stock and dies, previous to funds becoming available for the operation of the International Candy Machine Company.

Fifth: That in carrying out said agreement practically all the time from the organization of the International Candy Machine Company January 29, 1914, to April 1, 1914, the property of the United Candy Company at Racine was being prepared for shipment, and that said property was en route in shipment about thirty days. Thereupon the unloading of the said property and setting up of the same in the factory of the International Candy Machine Company required approximately two months' time, it being June 1, 1914, before the machinery of said factory was running.

Sixth: That during all of the above time the International Candy Machine Company did not have the required absolute control of the patent rights of the United Candy Company, including the above entitled application of Roe, but that being informed of the status of the above entitled application on or about the time the actual operation of its factory was started, deponent being advised as to the probable requirements for revival of this application promptly took up the matter of procuring proper affidavits to accompany a petition to revive, with the officers and inventors of the United Candy Company at Racine, Wisconsin, several weeks being consumed in getting in touch with the proper persons at Racine, having authority in regard to this particular matter and eliciting the required information. That during this time the business affairs of the said Racine company were in a chaotic condition owing to legal complications, but that deponent having secured the required information early in the month of July promptly requested the attorneys representing the International Candy Machine Company to prepare and file the petition to revive.

Seventh: Deponent further says that he is Secretary-Treasurer of the International Candy Machine Company and has actual knowledge of all the facts hereinbefore cited.

SAMUEL C. WOLLEY

Sworn to and subscribed before me this _____ day of _____, 1914.

JOHN SMITH,
Notary Public.

NOTE: A strong and complete showing of diligence is required for all petitions of this nature and must excuse and account for the whole period of delay.

DEPARTMENT OF THE INTERIOR
 UNITED STATES PATENT OFFICE
 Washington

October 15, 1914.

In the matter of the
 Application of
 Richard E. Roe, et al.
 Candy Delivery Machines
 Filed April 14, 1910
 Serial No. 555,552

PETITION TO REVIVE
 (Renewal)

Sirs:

You are hereby informed that the decision of the Commissioner on the above petition is as follows:

The showing made in the affidavit is sufficient to show that the delay in the prosecution of the application was unavoidable.

The petition is granted.

THOMAS EWING,
Commissioner.

October 15, 1914.

By direction of the Commissioner.

Very respectfully,
 W. F. WOOLARD,
Chief Clerk.

Richard E. Roe, et al..
 c/o Doe & Doe
 Washington, D. C.

Typical Form of Non-Exclusive License

AGREEMENT

(Made in duplicate)

THIS AGREEMENT made this day of ,
 1920, between Cleveland Cactus Company of Cleveland, Ohio,
 hereinafter referred to as Cleveland Company and The S. & W.
 Tree Company of Pittsburgh, Pennsylvania, hereinafter referred
 to as Tree Company, witnesseth:

WHEREAS, United States Letters Patent No. 879,610 of E.
 H. Light were issued November 11, 1919, to said Cleveland Com-
 pany for Stump Extracting Machine, and United States Letters
 Patent No. 896,522 of Roe & Roe were issued October 22, 1918,
 to the latter parties; and

WHEREAS, said Cleveland Company is the owner of all right, title, and interest in and to the said Letters Patent, and the inventions thereof, and the said Tree Company is desirous of obtaining a license under the said Letters Patent;

NOW, THEREFORE, the parties have agreed as follows:

(1) The said Cleveland Company hereby licenses the said Tree Company to manufacture and sell Stump Extracting Machines, within the United States of America, containing the improvements and inventions of the said Letters Patent, to the end of the terms for which the said Letters Patent were granted.

(2) The said Tree Company hereby agrees to pay to said Cleveland Company a royalty of Twenty-five Dollars (\$25.00) for each machine made and sold by said Tree Company containing the invention or inventions of the said Letters Patent.

(3) It is understood and agreed that the license fees or royalties herein specified shall be payable to the extent of a minimum of One Thousand Dollars (\$1000.00) annually; in other words, if the number of machines made and sold by the Tree Company are insufficient to create a total of royalties aggregating One Thousand Dollars (\$1000.00) annually, sufficient shall be added to said royalties to bring the same to the fixed minimum payment just above specified.

(4) The said Tree Company hereby agrees to keep true and accurate book records of the machines or devices made and sold by it in accordance with this license, to open up said book records for the inspection of said Cleveland Company should such inspection be desired and reasonable notice thereof, not less than ten days, be given; and said Tree Company further agrees to make true and full returns to the said Cleveland Company (under oath if requested) as of the dates January 1, April 1, July 1, and October 1, of each year, of all machines or devices containing the patented improvements manufactured and sold by it under this agreement and to pay the license fees accumulating in accordance with the terms hereof at the time of rendering said true and full returns.

(5) It is further agreed by the parties hereto that this license is a non-exclusive license and that it shall not be assignable or transferable by Tree Company.

(6) In the event of the failure of the Tree Company to return upon and render payment of license fees or royalties required by the provisions of this agreement, for a period of fifteen days after the dates above specifically named for rendering said payment, the said Cleveland Company may terminate this license by serving a written notice upon the Tree Company. Should this

agreement be terminated by default of the Tree Company as now provided for herein, said company shall not be discharged from any liability to the Cleveland Company for royalties which may have accrued at the time of the termination of this agreement under the notice above specified.

(7) The licensee, said Tree Company, hereby acknowledges the validity of the Letters Patent aforesaid, the ownership thereof by the Cleveland Company, and agrees not to be a party, either directly or indirectly, to any suit or procedure disputing the validity or tending to impair the value of said Letters Patent or to diminish the enjoyment of the said Cleveland Company of its revenue from said Letters Patent.

(8) The said Tree Company hereby agrees to mark each machine or device manufactured by it under this license, containing the patented improvements of the said Letters Patent, with an inscription:

License Notice.
Patented October 22, 1918.
“ November 11, 1919.

Also each device or improvement manufactured and sold by said licensee hereunder shall be numbered, each to have a different number, and said numbers to run in numerical order.

(9) For the purposes of this agreement, April 1, 1921, shall be considered the annual accounting commencement date.

IN WITNESS WHEREOF the parties hereto have caused their presents to be signed for and on behalf of both of said respective parties, and have caused their corporate seals to be affixed the day and year first above written.

CLEVELAND CACTUS COMPANY

By.....

(CORPORATE SEAL)

Attest:

.....
Secretary.

THE S. & W. TREE COMPANY

By.....

(CORPORATE SEAL)

Attest:

.....
Secretary.

Reciprocal License Agreement

WHEREAS, RICHARD E. ROE, manufacturer, of is owner of an application filed in the United States Patent Office by Richard E. Roe, Serial No. 20647, filed January 2, 1916, for Adding Machine, and of the invention covered thereby; and

WHEREAS, DOE MACHINE MANUFACTURING CO., a corporation of the State of Ohio, having its principal place of business at Columbus, Ohio, is owner of an application filed in the United States Patent Office by John F. Doe, Serial No. 20698, filed February 3, 1916, for Registering Machine, and of the invention covered thereby; and

WHEREAS, said RICHARD E. ROE desires a license to make, use and sell the invention covered by said application of John F. Doe, and any Letters Patent which may hereafter be granted or issued thereon; and

WHEREAS, said DOE MACHINE MANUFACTURING COMPANY desires a license to make, use and sell the invention covered by said Richard E. Roe application, and any Letters Patent hereafter granted or issued thereon:

NOW, THEREFORE, it is hereby agreed as follows: —

Said RICHARD E. ROE, in consideration of the license herein granted to him by said Doe Machine Manufacturing Company, grants to said Doe Machine Manufacturing Company a license under said application, empowering said licensee to make, use or sell machines or devices embodying the inventions or features of improvement covered by said application and by the Letters Patent hereafter granted or issued thereon; and it is agreed that this license shall be assignable or transferable to any bona-fide successor or successors of said license, and that except for this the license shall not be assignable.

The said DOE MACHINE MANUFACTURING CO., in consideration of the license herein granted to it by said Richard E. Roe, hereby grants to said Richard E. Roe a licensee under said John F. Doe application, empowering said licensee to make, use and sell machines or devices embodying the inventions or improvements covered by said application and by the Letters Patent hereafter granted or issued thereon; and it is agreed that this license shall be and is assignable or transferable by said licensee to any bona fide successor or successors thereof, and that, except for this, said license is not assignable.

It is hereby agreed and understood that the above licenses are each for the full term of the Letters Patent to be granted or issued on said Roe and Doe applications, and give each licensee

the right to sell the said inventions and improvements throughout the United States and territories thereof.

It is also hereby stipulated and agreed that the parties hereto shall have the right to make, use and sell, and to grant licenses, under any foreign patents which may be obtained for these inventions in any and all foreign countries.

Signed in duplicate

Signed at

this day of 1919.

.....COMPANY

By.....
President.

Signed at Columbus, Ohio,

this day of , 1919.

Agreement: Transfer of Patented Inventions and Business

This agreement, made as of this day of ,
192 , by and between of ,
first party, and , a corporation
of , having its principal office at
 , second party, WITNESSETH:

WHEREAS first party warrants himself to be the owner, free and clear of any assignments, liens, encumbrances, contracts, licenses, understandings, diminutions of interest, or clouds of any name or nature, of certain inventions made by him pertaining to (hereinafter abbreviated to) and of the patents and patent applications therefor hereinafter mentioned and of the business that heretofore he has conducted in making and marketing such ; and

WHEREAS first party now has pending certain litigation charging others to be unlawfully using one or more of the said inventions and infringing one or more of the said patents; and

WHEREAS second party desires to acquire said first party's inventions, improvements, patents, applications, business and rights of action and recovery pertaining to said ;

I. NOW, THEREFORE, in consideration of the principal sum of to be paid unto first party as hereinafter provided, first party does hereby:

(a) Sell, assign and transfer unto second party (1) the entire right, title and interest in and to all of his existing inventions (hereinafter called "said inventions") and (2) his entire right, title and interest in and to all other inventions and improvements in such " " that he, solely or jointly with others, has conceived or shall hereafter conceive or perfect during the period ending (all hereinafter called "said improvements"), and (3) the entire right, title and interest in and to patents, domestic and foreign, and rights to patent (all hereinafter called "said patents"), for said inventions and improvements including (without limitation of the foregoing generalities) his U. S. Patent No. , his pending application for U. S. Patent, Serial No. , and Canadian Letters Patent No. granted

(b) Sell, assign, transfer and set over unto second party (1) his business (as distinguished from his business) including good will, stock on hand and in process of manufacture, tools, dies, equipment, trade-marks, secret processes and formulae, customer lists, mailing lists, advertising cuts and the paraphernalia of every name and nature especially pertinent to and used by him in his said business together with (2) all choses in action, rights of action and recovery arising from or out of said inventions, patents, trade-marks and or business; *provided* however, and it is mutually so understood, that first party shall not turn over unto second party properties used by him in whole or in part in the conduct of his business nor yet any cash on hand or accounts receivable outstanding in his business and *provided further*, and it is mutually so understood, that second party does not assume any accounts-payable, indebtedness, obligations, or other liabilities of any name or nature contracted or incurred by or on behalf of first party or in connection with his conduct of his business; and

(c) Agree that he will (1) promptly disclose, from time to time as the acts occur and on his own initiative unto or other person or agent designated by second party, and said improvements that he may (prior to) make or conceive, develop or perfect, solely or jointly with others; and (2) at second party's request promptly execute and deliver all lawful documents of, or in any way pertaining to, patent applications and prosecution thereof, assignments and bills of sale of things and of rights, and other lawful instruments that are by second party deemed necessary or desirable for the protection of said inventions and improvements throughout the world

(to such extent as second party deems desirable) and to evidence second party's ownership of all the matters and things hereunder conveyed or hereunder to be conveyed by first party unto second party; and (3) at second party's request promptly and diligently to assist second party in the ascertainment of facts, and production of evidence that by second party may be deemed desirable or necessary for the conduct of any interference or litigation that in any way may touch or affect any of the matters or things of the said inventions or improvements or business; *provided*, however, and it is mutually so agreed, that expenses arising under the instant paragraph shall be borne by second party, that second party shall promptly reimburse first party for expenses reasonably incurred in the first instance by first party and all expenses incurred by first party on second party's request and *provided further* that if second party should call upon first party for services or assistance involving any considerable expenditures of first party's time, first party shall be reimbursed for his time-expenditures so made at second party's request at the rate of twenty-five dollars (\$25.00) per day; and

(d) Warrant that he has, before executing this instrument, directed his attorneys to take in his behalf and at his expense all steps necessary to dismiss all suits pending in which he is plaintiff touching said inventions and patents; it being understood and agreed that second party does not assume any expenses, costs or liabilities arising out of or pertaining to any litigation heretofore instituted by or on behalf of first party; and

(e) Agree to turn over to second party forthwith and without charge or expense all his patent files, and data in his or his attorney's hands, pertaining to said inventions, patents or to suits or interferences touching same or his trademarks or his business.

(f) *Provided however*, and it is so agreed, that this contract is not intended to pass title to any inventions, or patents, other than such as relate to

II. In consideration of all the foregoing second party agrees to pay unto first party the principal sum of _____ in amounts and times as follows:

(a) Forthwith upon the signing of this agreement,

(b) Monthly hereafter, beginning _____ per
respective non-interest-bearing notes herewith given by second party to first party, the successive sums of _____ and a final payment of _____

III. And it is mutually agreed that:

(a) Should second party default in its payment of any note aforesaid first party may at his option upon ten (10) days' written notice of said default delivered at second party's principal place of business cancel this agreement, to take effect at the end of said notice period should said second party fail during said notice period to make good its default, but this right of cancellation shall be alternative with, and not preclusive of, first party's right to maintain the agreement in force and sue in law or in equity for breach thereof or recovery thereunder; and

(b) Should this agreement be canceled under the next preceding paragraph (a) the instant paragraph (b) shall nevertheless remain in full force and effect, to wit, that second party shall and agrees to forthwith upon such cancellation reassign to first party in full all the property, rights, matters and things assigned unto second party by first party under this agreement, and return to first party his patent files and data, and that first party shall retain to his own use and behoof all moneys therefore received by him under this assignment and that second party's liability for any defaulted payments due before the effective date of cancellation shall not be abated; and

(c) The expenses to be paid by second party under any of the terms hereof shall in no instance include legal services rendered to first party by first party's own counsel, but second party shall pay Government fees hereafter accruing, recording fees and kindred items incurred in perfecting second party's rights under this agreement.

(d) Time where herein stated is of the essence of the agreement, and

(e) This agreement shall inure to the benefit of and be binding upon, first party's legal representatives and assigns and second party's successors and assigns.

IN TESTIMONY WHEREOF the parties have hereunto subscribed as of the day and year first above written.

.....
First Party

.....COMPANY
Second Party

By.....
Its President.

Attest:

.....
Secretary.

State of Ohio }
 County of Erie }^{ss.}

On this day of 1921,
 personally appeared before me of
 to me personally known and acknowledged that he executed the
 foregoing agreement as his free and voluntary act and deed.

.....
Notary Public.

State of Illinois }
 County of Cook }^{ss.}

On this day of , 1921, personally ap-
 peared before me of
 to me personally known, and acknowledged that as President
 of the and with due authority he
 executed the foregoing agreement in behalf of said corporation
 as the free and voluntary act and deed of said
 corporation.

.....
Notary Public.

**CONTRACT BETWEEN EMPLOYER AND
 EMPLOYEES AS A GROUP**

Employer-Employees Agreement Form

THIS AGREEMENT,

Made and entered into this day of , by
 and between certain *EMPLOYEES OF THE JOHN DOE
 COMPANY*, hereinafter referred to as "Employees," and the
JOHN DOE COMPANY, a corporation of the State of
 , hereinafter called "The Company" WITNESSETH:

WHEREAS the Company is engaged in the designing, manu-
 facturing, sale and leasing of various types of patented
 , and in the design, manufacture and sale of
 patented , patented ,
 patented and patented , and also
 of , as well as the designing and manu-
 facture of apparatus for the development of manufacturing of
 any of its products, and

WHEREAS the said products and apparatus for developing the same represent a vast amount of engineering skill, pioneering, experimenting and exploiting, the expenses of which have been borne by the Company, and

WHEREAS many of the individual Employees who are signing this agreement have expended much time and energy in experimentation and exploitation, as well as in the origination and development of the patents herein referred to, and

WHEREAS the said Company has spent for a number of years and is still spending large sums of money in educating the trade in the use of the different patented products manufactured by it, by means of advertising, traveling solicitors, trade publications, the maintenance of a large engineering and sales corps and other means, and has spent and is spending large sums of money in connection with the various experiments and work of engineers, sales and other employees looking toward the perfecting of the different products above mentioned and the apparatus for the manufacture and development of the same, and also the perfection and development of similar products which can be manufactured and marketed by the Company advantageously, and

WHEREAS it is desirable in the interests of both the Company and the undersigned Employees that each of said Employees be fully acquainted with all the work done by the Company, and that he have full access to the Company's shops, as well as to drawings, blue prints and records pertaining to the Company's work; and

WHEREAS many of the undersigned Employees are stockholders in the Company, and all of them are beneficiaries under a Profit-Sharing Plan in force at the time of the signing of this agreement, and it is to the mutual advantage of each of the Employees as stockholders or beneficiaries under the Profit-Sharing Plan, or both, that this agreement be entered into:

NOW, THEREFORE, IN CONSIDERATION of the sum of One (\$1.00) Dollar, each to the other paid, as well as in consideration of the mutual advantages to accrue through the execution of this agreement, it is mutually agreed, each with the other, and all of the Employees with the Company—

First: That it is necessary and desirable that the Company protect itself and its business by having the Employees who have subscribed hereto enter into a written agreement which will protect the said Company as aforesaid. This said protection has been fully discussed between the parties hereto, and each of said Employees has expressed his willingness to enter into this agreement;

Second: It is mutually agreed that beside the patented specialties and products specifically enumerated herein, this agreement shall cover any other patented specialties, inventions or designs which the Company may acquire during the term of employment of each of said Employees;

Third: This agreement shall continue in force as regards each individual Employee who has affixed his signature hereto for and during the term of his employment with the Company, and the termination of employment by any one or more of said Employees shall not terminate the agreement as regards the remaining Employees whose signatures have been affixed hereto;

Fourth: It is further understood and agreed that it shall be the duty of the Employee to reveal promptly to the Company any ideas which he may have relating to any of the Company's patented or other patented products, both in order that the Company may determine as to the desirability of applying for Letters Patent thereon, and also in order that the Company may give to the Employee the benefit, assistance, advice and cooperation of its other Employees in the development of such idea; and further for the purpose of applying such improvements or ideas to the improvement of the product manufactured by the Company;

Fifth: Said Employee agrees in connection with any patent, invention or design which he may develop, or which may be conceived by him in whole or part during the time of his employment with the Company relating to any of the patented products which said Company manufactures, leases or sells, such patents, inventions or designs shall be the property of the Company without further consideration than that hereinabove recited in this agreement, and said Employee, upon demand agrees to execute any paper or papers which may be necessary to vest in the Company complete and absolute title in such patent or patents or applications pending therefor, or such invention or design, and to deliver to the Company, upon request, all designs or patterns that the said Employee may have in his possession which belong to the Company or which relate to the patent or patents, inventions or designs which said Employee may have developed or conceived, in whole or in part, as applied to the patented or other patented products manufactured and sold or leased, or to be manufactured and sold or leased by the Company. Said Employee does further covenant and agree that he will upon the termination of his employment immediately deliver to said Company not only all plans, blue-prints and designs mentioned herein, but will also deliver to the Company all price lists or printed or written documents

made or issued by the Company, and all other property of the Company of whatsoever nature which may be in his possession;

Sixth: At any time that the employment of said Employee may be terminated, either by action of the Company or of the Employee, or for any other cause whatever, whether voluntary or involuntary, said Employee does hereby covenant and agree that he will not for a period of three (3) years after the termination of his employment with the Company engage directly or indirectly in a line of business in competition on any of its patented

or other patented products, nor will he enter the employ for such period of three (3) years after such termination of any person, firm or corporation engaged in the manufacture, designing, sale or leasing of any of the patented specialties or products manufactured, sold or leased by the Company, it being understood that the territory to which this covenant applies shall be that of the United States and the Dominion of Canada;

Seventh: It is further understood and agreed that the Employee herein is receiving a monthly salary which is a part of the consideration of this agreement, but that any change in salary shall not affect nor annul this contract in any manner whatsoever; that said salary shall be subject to adjustment up or down at the discretion of the Company, and such change or adjustment of salary shall not be considered as a modification of this agreement; on the contrary, all of the covenants and conditions herein contained, except as to change of salary, shall be kept, done and performed by said employee, and shall apply with equal force and effect as tho said salary had not been so modified or changed;

Eighth: It is further understood and agreed that the covenants herein contained to be kept, done and performed by said Employee to the effect that he shall not directly or indirectly engage in any business in competition with the Company on any of their patented products within the territory of the United States or the Dominion of Canada, nor shall he enter into the employ of any person, firm or corporation thus engaged during the period of three (3) years after leaving the employ of the Company, is a permanent and lasting covenant to which said Employee hereby agrees, regardless of the length of time that he may remain in the employ of the Company, and regardless of any subsequent or supplemental agreement which may be entered into between said parties hereto with reference to employment of said Employee;

Ninth: It is further understood and agreed that the duties of any of the Employees subscribing hereto may be changed

or altered according to circumstances, and each of the parties hereto agrees, in general, to do and perform such services and to observe such rules and regulations as may be prescribed and required from time to time by the officers of said Company, and that each of said Employees will devote his entire time and energy to the work of said Company;

Tenth: The term of employment provided for in the agreement shall be from month to month, and may be terminated at the option of either party by giving thirty days' written notice to the other party of his or its desire to terminate such employment.

Eleventh: It is mutually covenanted and agreed that additional signatures may be added to this agreement from time to time of employees who may subsequently enter into the employment of the JOHN DOE COMPANY, or of those who by reason of promotion or advancement may be eligible to sign this agreement, without in any way changing or altering the terms and conditions hereof, nor of affecting in any way the obligations of those originally signing the same; the matter of determining what employees may subsequently sign this agreement is hereby delegated to the President of the John Doe Company, or his successor in office, with full power to act in the premises;

Twelfth: Each of the said Employees signing this agreement does for himself individually make, constitute and appoint _____, the President of the John Doe Company, or his successor in office, his true and lawful attorney with full power in the premises to enforce all of the terms and conditions of this agreement, or to defend the same, as the case may be; to enter suit or suits on behalf of said employees as a party to this agreement and prosecute the same to final conclusion; to defend any suit or suits on behalf of said Employee arising from this agreement to final conclusion; to execute any releases, compromises, compositions, agreements or contracts in his opinion necessary and expedient in connection with any litigation arising therefrom; to commence and prosecute unto final judgment and execution any suit or suits, action or actions which he shall deem proper and necessary for the enforcement of this agreement, and in any suit, suits or actions to appear for said Employee and plead before any Courts or tribunals having prosecution thereof; and generally, to do and perform all matters and things which may be requisite or proper to effectuate all or any of the purposes of this agreement in connection with the prosecution or defense of any suit or suits

in the same manner and to all intents and purposes with the same validity as the said employee could do if personally present;

Thirteenth: It is further understood and agreed that in case of the entire sale of the assets of the Company, or in case of a change of the present controlling interests in the stock of said Company, upon such sale or change of control, this agreement shall be null and void.

JOSEPH SMITH (SEAL)

Witness:

ALICE GABLE

JOHN DOE COMPANY

Seal

By.....
President.

Attest:

RICHARD E. ROE
Secretary

XIV

INTERFERENCE FORMS.

Preliminary Statement—Motion to Dissolve—Notice of Taking
Testimony—Affidavit of Service—Opening of Deposition—
Certificate for Taking Deposition.

Form of Preliminary Statement for Interference

IN THE UNITED STATES PATENT OFFICE

ALBERT G. ROE

vs.

Interference No. 41,800.

JOHN W. ARROW

PRELIMINARY STATEMENT OF A. G. ROE

State of Maryland }
County of Harford } ss.

Albert G. Roe, of Sandusky, Ohio, being first duly sworn, deposes and says that he is a party to the Interference No. 41,800, declared by the Commissioner of Patents May 10th, 1918, between deponent's application for patent filed February 27, 1918, Serial No. 261,144, for Impression Devices and the application for patent of John W. Arrow; that he conceived the invention set forth in the declaration of interference on or about the 1st day of September, 1915; that he never made any drawings of the said invention; that he never prepared any written description of the said invention; that on or about the 1st day of October, 1915, he first explained the invention to others; that he first embodied his invention in a full-sized machine which was completed on or about October 1st, 1915; and that on or about October 1st, 1915, the said machine was first successfully operated in the town of Sandusky, Ohio; and that he has not made any other models of said machine because he ascertained by experiment that the type of machine according to his model shown in U. S. Letters Patent No. 1,522,005 was superior in all respects.

ALBERT G. ROE

Subscribed and sworn to before me this 15th day of May, 1918.

HARRY U. SIMS

SEAL

Notary Public, Harford County, Md.

Form of Motion to Dissolve

IN THE UNITED STATES PATENT OFFICE

ROE

vs.

ARROW

Interference No. 41,800.

MOTION TO DISSOLVE

And now comes Roe, by his attorneys, and moves that the above entitled interference be dissolved as to counts 2, 3, and 4 on the ground that said counts are not patentable in view of the state of the prior art as shown by German patent to Schmidt issued May 13, 1883, No. 132,344, for Apparatus for Taking Impressions of the Hands, and U. S. patent to Dodd issued May 23, 1894, No. 215,798, for Marking Device.

DISCUSSION

It is notable that owing to the existence of certain prior art classified in the Patent Office in an entirely separate class and division from that to which the applications in this interference are assigned, the above references have doubtless not come within the purview of the examination respecting the applications.

The issue counts are thought to be anticipated by the Schmidt patent alone in view of the common expedient used in printing machines, and many other printing appliances, of causing inking of an inking sheet or member as an incident to movement of said member relatively to an ink-applying part.

The issue counts are believed to be anticipated by the Dodd patent alone because Dodd shows in the modification of his construction, Figures 6 and 7, an inking member movably mounted in a receptacle or frame and made of elastic sheet material, means at D for applying and distributing ink on one side of the inking member, said inking member, which is A, being movable with respect to the said means D, and the support for a sheet to be printed, same being the table or other base upon which the marking device rests. Furthermore, the receptacle which holds the inking member, same being a frame-like device, has an opening of a size to receive an extremity of the human body.

The foregoing is an application of the references to count 2 and the remaining counts are substantially couched in about the same wording, rendering the application of the references read-

ily evident in respect thereto. As showing typical impression-taking devices wherein inking members are made of flexible material and are inked as an incident to relative movement of said members, and a suitable ink-applying and distributing device, attention is called to Jill patent No. 82,168, July 29, 1860; Kost patent No. 1,068,285, March 11, 1914; Jess patent No. 594,513, May 12, 1893; Leach patent No. 51,461, Aug. 25, 1856, which shows an endless belt type inking member; and Kost patent No. 966,166, April 13, 1901, also showing an endless belt inking member inked as an incident to movement thereof relatively to an ink-applying or distributing device.

Respectfully submitted,

DOE & DOE

Attorneys for Roe.

Service of above motion and copy thereof is acknowledged this day of _____, 1922.

JOHN SCREWBANK

Attorney for Arrow.

Form of Notice of Taking Testimony

(For Interference, Opposition, Cancellation, and Like Proceedings.)

IN THE UNITED STATES PATENT OFFICE

Before the Examiner of Interferences.

ROE & ROE

vs.

ROBERT RAY

Interference No. 40,447

NOTICE OF TAKING TESTIMONY

Cyril Butter, Esq.,
1228 Monadnock Block,
Chicago, Ill.

Dear Sir:—

You are hereby notified that on Tuesday, April 8, 1920, at the offices of Messrs. Ordway & Shea, Crocker Bldg., Des Moines, Iowa, at 10:30 A. M., before a Notary Public, or other duly

qualified officer, I shall proceed to take the testimony of the following witnesses, and possibly others whose names have not yet been ascertained, in behalf of the parties, Roe & Roe:

Richard E. Roe, Des Moines, Iowa
Samuel Green, Fairfield, Iowa.

The examination will be adjourned from time to time and from place to place, as may be necessary, and you are invited to attend and cross-examine.

J. F. DOE
Attorney for Roe & Roe.

April 5, 1920.
Cleveland, Ohio.

Service of above notice is acknowledged this 6th day of April, 1920.

CYRIL BUTTER,
Atty. for Ray.

NOTE: Omit service acknowledgment when service is to be made by mail.

Form of Affidavit of Service

AFFIDAVIT OF SERVICE

State of Ohio, }
County of Cuyahoga, } ss.

Angus McDonald being first duly sworn, deposes and says that he is an employee of the firm, Doe & Doe (of which firm John F. Doe is a member) and that on Thursday, April 4, 1920, he placed a copy of the attached Notice of Taking Testimony in a sealed envelope directed to Cyril Butter, Esq., 1228 Monadnock Block, Chicago, Ill., and deposited the said envelope in the United States registered mail, the postage on the envelope having been fully prepaid, and the registry receipt being attached hereto.

ANGUS McDONALD

Sworn to and subscribed before me this 5th day of April, 1920.

(SEAL)

E. C. GERSTRICHER,
Notary Public.

NOTE: To be used when opposing party or his counsel is to be served by mail. Annex to notice and thus make a part thereof.

Form of Opening of Deposition

Richard Roe

IN THE UNITED STATES PATENT OFFICE

Before the Examiner of Interferences.

ROE & ROE

vs.

ROBERT RAY

Interference No. 40,447

Depositions of witnesses examined on behalf of Roe & Roe, pursuant to the annexed notice, at the offices of Ordway & Shea, 608 Crocker Building, Des Moines, County of Polk, Iowa, on the 13th day of April, 1920, at the hour of 10:30 o'clock in the forenoon as the time of commencement, and completed the same day.

Present: John F. Doe, Esq. on behalf of Roe & Roe; Cyril Butter, Esq., on behalf of Ray.

Richard Roe, a witness produced on behalf of Roe & Roe being first duly sworn, doth depose and say in answer to interrogatories propounded to him by John F. Doe, Esq., as follows, to-wit:

DIRECT EXAMINATION

Q. 1. What is your name, age, residence and occupation? A. Name, Richard Roe, age 43, occupation, mechanical engineer, 1811 College Avenue, Des Moines.

NOTE: The name of the witness should appear at the top of each page of his deposition.

Officer's Certificate for Taking Deposition
IN THE UNITED STATES PATENT OFFICE

Before the Examiner of Interferences.

ROE & ROE
vs.
 ROBERT RAY

Interference No. 40,447

NOTARY'S CERTIFICATE.

State of Iowa, }
 County of Polk } *ss.*

I, Adele Sherman, a Notary Public within and for the County of Polk and State of Iowa, do hereby certify that the foregoing depositions of Richard E. Roe and Thomas Engler were taken on behalf of Roe & Roe, in pursuance of the notice annexed hereto, before me, at the offices of Ordivay and Shea, 608 Crocker Building, in the City of Des Moines, in said County, on the 13th day of April, 1920; that said witnesses were by me duly sworn before the commencement of their testimony; that the testimony of said witnesses was written out by me; that the opposing party was represented by his counsel, Cyril Butter, during the taking of said testimony; that said testimony was taken at Des Moines, Iowa, and was commenced at 10:30 o'clock, A. M., on the 13th day of April, 1920, and was concluded on the same day at 3:30 P. M.; that the depositions were read by the witnesses before they signed the same; that I am not connected by blood or marriage to either of said parties, or interested directly or indirectly in the matter in controversy.

In testimony whereof, I have hereunto set my hand and affixed my seal, et al., at Des Moines, in said County, this 13th day of April, 1920.

ADELE SHERMAN,
Notary Public.

My commission expires July 4, 1921.

XV

A TYPICAL MECHANICAL PATENT APPLICATION AS COMPLETELY PROSECUTED*

Petition

To the Commissioner of Patents:

Your petitioner, Richard E. Roe, a citizen of the United States, residing at Cleveland, in the county of Cuyahoga, and State of Ohio, and whose Postoffice address is c/o Roe Machine Company, 21st Street and Euclid Avenue, Cleveland, Ohio, prays that Letters Patent may be granted to him for the improvement in CONTROL DEVICES FOR MIXING-MACHINES, set forth in the annexed specification.

And he hereby appoints Doe & Doe, a firm consisting of F. J. Doe and C. H. Doe, Marshall Bldg., Cleveland, Ohio, Register No. 1236, his Attorneys, with full power of substitution and revocation, to prosecute this application, to make alterations and amendments therein, to sign his name to the drawings, to receive the Letters Patent, and to transact all business in the United States Patent Office and United States Courts connected therewith.

Signed at Cleveland, in the county of Cuyahoga, and State of Ohio, this 27th day of September 1920.

RICHARD E. ROE

* See File Wrapper U. S. Patent of Lichtenberg, No. 1,321,460, issued Nov. 11, 1919.

Specification

TO ALL WHOM IT MAY CONCERN:

BE IT KNOWN, That I, Richard E. Roe, a citizen of the United States, residing at Cleveland, in the county of Cuyahoga, and State of Ohio, have invented certain new and useful improvements in CONTROL DEVICES FOR MIXING-MACHINES, of which the following is a specification:

STATEMENT OF INVENTION

This invention has to do with the art of concrete mixing-machines, and mixing-machines generally.

In its preferred embodiment the invention is an attachment for concrete mixers and comprises automatic signaling, counting, and mixer discharge-controlling means. While the invention includes the combined instrumentalities above mentioned, I wish it to be understood that I consider the aforesaid means not only combinatively novel, but in so far as I am advised, certain of the devices going to make up such means are new in less combinations than the whole, and some capable of individual use, as will more clearly appear hereinafter.

To fully explain the advantages of my invention I shall refer briefly to the operation of well-known types of concrete mixing-machines. In these machines suitable mixing means, such as a power-driven mixing drum or receptacle, with internal mixing devices, are employed; loading means for the drum, of any suitable nature, are used; and, necessarily, some device of one kind or another is employed to control the discharging of the contents of the mixer after completion of mixing operation. These mixers are ordinarily used for the admixture of cement, sand, and gravel, or such materials, and it is an absolute requirement for effective and lasting construction work, whether such be building or other erection, laying of pavements, or the like, that a proper admixture of the materials be compelled.

In the employment of ordinary concrete mixing-machines

it is customary, in respect to their use on Government and other contract work, to rigidly supervise the operation of the machines to make sure that proper admixture of the plastic materials is performed; in fact, inspectors are regularly employed for this particular work to guard against both carelessness and fraud, the latter arising commonly as an incident to contractors forcing both workmen and machines to such an extent that sufficient time for mixing is not allowed.

With the foregoing in view, this invention provides a means to signal or indicate automatically, after loading the mixer with the materials to be mixed, when the minimum time required for completion of the mixing operation has elapsed. The signaling means, furthermore, is susceptible of adjustment to admit of its application to different types of machines, and to accord with different sized batches of materials handled. In addition, said means is protected against unauthorized tampering, a necessary expedient to make it effective.

Supplementing the advantages afforded by the signaling means, are those derived from utilizing cooperative discharge chute locking means, whereby the discharge of the mixed materials, previous to complete admixture, is absolutely guarded against.

From the viewpoint of the contractor or owner of the machine, it is desirable to have a device for counting the operations of loading the mixer so that the work of the machine each day, or any determinate period of time, may be readily ascertained. As before premised, special means for the last named purpose have been devised and combined with the other instrumentalities of this invention, all of which will be now described in detail on reference to the accompanying drawings, in which:—

Figure 1 is a general view in side elevation of a street paving concrete mixer having the invention applied thereto.

Figure 2 is a fragmentary and diagrammatic view showing the signaling mechanism, the counter, the lock, and controlling

connections forming the essential features of the attachment means comprising the invention.

Figure 3 is a cross sectional view taken vertically through the casing which encloses the signal bell, governor mechanism, and the counter, which casing is locked closed by any suitable means. This view is taken on the line 3—3 of Figure 2.

Figure 4 is a cross section on the line 4—4 of Figure 2.

Figure 5 is a detail view showing more clearly the circuit-closing means controlled by the governor.

GENERAL CONSTRUCTION

The term "signal," as used herein, is intended to include an indicator, or any equivalent device, for advising either visibly or audibly, or otherwise, of the completion of the mixing operation.

A very brief description of the concrete-mixing machine to which the attachment of this invention is applied will suffice, since the particular type of such machine is immaterial to the invention which has a wide range of applicability to various kinds of mixing-machines, irrespective of the specific form of the mixing mechanism *per se*.

In the drawings is illustrated what is known as a street or road paving mixer, the same embodying a suitable traveling truck *A* to render the machine portable, a mixing-drum *B* mounted on the truck for rotation in effecting the mixing operation, and a loading means for the drum including a bucket or skip *C*. The bucket or skip *C* is adapted to be raised by means of a cable *D* designed to be operated by suitable power means, and said bucket *C* is supported on the frame of the machine by a pivoting bracket *E*.

The materials may be dumped into the bucket *C* when the latter is in the full line position shown in Figure 1, and by elevating the bucket to the dotted line position, its contents will be fed into the mixing-drum *B*, this being ordinarily done while the drum is rotating. To discharge the drum *B*, I

contemplate the employment of a discharge chute *F* of the type shown in United States Letters Patent to Philip A. Koehring, No. 1,126,487, issued January 26, 1915, said chute being tiltable from a position in which it inclines into the drum *B*, to a position in which it inclines downward and outward from the discharge opening at the discharge end of said drum. In the latter position the chute *F* will discharge the contents of the receptacle *B*, the materials discharged being adapted to be carried off to a suitable point of deposit by means of a boom and bucket attachment including the boom *G*, and bucket *H* which travels back and forth on the boom. A shaft is connected with the discharge chute *F* and is operable by handle *I* whereby to effect the tilting of the chute into discharging and non-discharging positions.

The signaling, counting, and controlling attachment embodying this invention includes a suitable casing or box 1 secured in a suitable position on the frame of the machine, preferably adjacent to the bracket *E*. This box contains an ordinary electric bell 2 forming an audible signal, a counter 3, and a governor 4. The governor 4 may be of any desired type but is comprised, as shown, of a standard formed with horizontal upper and lower arms 5 and 6 respectively, together with a zigzag or tortuous groove 7, the latter being produced in one side of said standard. The arms 5 and 6 are vertically apertured so as to receive therethrough a sliding metal stem 8 to the upper end portion of which is secured a crossbar 9, and to the lower end of which is pivoted the brush or circuit closer 8. On its ends, which are preferably bent downwardly, the cross bar 9 carries the adjustable weights 10, the parts 9 and 10 forming a governor member tending to force the stem 8 downward and hold it in a position at the lower extreme of its free vertical movement upon the standard 4. The stem 8 carries at a point intermediate the arms 5 and 6 of the standard 4, a laterally movable pin 11 the opposite ends of which are headed so as to prevent its displacement from the stem.

The pin 11 is freely slidable transversely relative to the stem 8, through an opening formed in the latter, and one end of the pin 11 is adapted to engage in the groove 7 of the standard 4. The engagement of the pin 11 in the groove 7 is caused by raising the stem 8 in a manner to be hereinafter described, the outer end of the pin 11 striking a curved cam 5' on the arm 5 and being forced laterally into the desired engagement with the groove 7. Owing to the provision of the governor member 9-10, once the pin 11 engages the upper end of the groove 7, and the stem 8 is left free to gravitate, the gravitating movement of the stem will start, and the speed of such movement is variable by the adjustment of the weights 10, toward and from the point of connection of the member 9 with the stem 8, to accommodate for different sized batches handled by the mixer. Obviously during its downward movement, owing to the cooperation of the pin 11 with the groove 7, the stem 8 and parts 9 and 10 have partial rotative movement in opposite directions.

The counter 3 may be of any conventional type and is intended for the purpose of registering the number of batches of materials fed into the mixing-drum *B* by means of the skip or loading bucket *C*. The counter 3 has an actuating arm 3' at one end of the same directly actuating the units wheel of the counter, and there will be employed any suitable transfer devices intermediate its units and tens and other registering wheels of higher denominations.

A lever 12 is pivoted at a point within the box 1, preferably on the rear wall of the latter, and with its inner end engaging an offstanding pin 13 at the lower extremity of the stem 8. Said lever 12 extends through a side of the box 1, and has connected therewith an actuating bar 14, which extends upwards from the point of pivotal connection of its lower end with the outer extremity of the lever 12, to a point adjacent to the pivoting bracket *E*, and is pivotally supported intermediate its ends as at 14'. The object of this arrange-

ment of the bar 14 is to enable the bracket *E* to bump against, or impinge, the upper end of the bar 14 each time the loading bucket *C* is hoisted to supply a batch of material to the mixing drum *B*. Obviously, the impingement of the part *E* with the bar 14 depresses the lever 12 at its outer end, correspondingly raises the inner end of the lever together with the stem 8 and sets the governor 4 to operating. The object is to cause the governor, at the end of its operation, to close the circuit including the bell 2 whereby the latter will be sounded to afford an audible signal. The operation of the governor 4 is timed so that when it is set in motion by the loading means or bucket *C* a predetermined period of time will have elapsed before the signal 2 sounds. This elapsed time is at least the minimum time required for the proper mixing of the batch previously delivered to the drum *B* by the bucket *C*.

The circuit connections used are simple, circuit wires 15 and 16 leading to separated contacts 15' and 16', contact 15' being on the block 17, of a conductive substance, arranged in the box 1 beside the stem 8, and the other contact 16' being carried by the governor 4, the standard of which is also made of a conducting substance. The wire 16 leads from the contact 16' to the bell 2, and a suitable wire 18 leads from the bell 2 to a terminal of the battery 19. The circuit wire 15 leads to the battery 19 also, but has connected up in its length the electro-magnet 20. Associated with the magnet 20 is an armature lock 21, said lock being cooperative with a projection 22 on the controlling shaft, which carries the handle *I* by which the discharge chute *F* is tilted into discharging or non-discharging positions.

GENERAL OPERATION OF MACHINE

Bearing in mind that adjacent to its point of pivotal support the lever 12 is adapted to engage the actuating arm 3' of the counter 3, for tripping the counter each time the outer

end of the lever 12 is depressed, the operation of the entire mechanism will be clearly understood on reference to the following description. Assuming that the parts are in the full-line positions shown in Figure 2, with the discharge chute *F* locked at 22, when the bucket *C* is loaded the operator of the machine will cause elevation of the bucket by suitable controlling means. As the bucket reaches its uppermost position, shown in dotted lines in Figure 1, its contents will be discharged into the drum *B* and the actuating bar 14 will have been impinged and operated by the pivot bracket *E*. The above causes the lever 12 to raise the stem 8 of the governor 4 and the pin 11 engages the cam 5' and is forced laterally into engagement with the groove 7. The bucket *C* is returned to its downward receiving position for another load, and the governor means, including the parts 8, 9 and 10, are permitted to gravitate. The time required for said members to complete their full downward movement depends upon the adjustment of the weights 9 and 10.

As the stem 8 reaches the lower extreme of its movement the pin 11 engages a cam 6' on the governor 4, is forced outwards from the groove 7, and leaves the stem 8 free to be quickly forced upwards the next time the bucket *C* is raised and the bracket *E* impinges the bar 14. When the stem 8 approaches said lower extreme of its movement the brush 8', or circuit closer, at its lower end, contacts with the block 17 and closes the circuit including the several wires 15, 16, 18, battery 19, and bell 2. This causes the bell signal to sound and when the brush 8' has passed the block 17 the circuit is broken and the parts restored, the signal ceasing operation. The brush 8' has insulation on its upper side so that on its upward movement the circuit will not be closed. Said brush is pivoted to the stem 8 by a spring hinge 8*a* and swings downward on the upstroke of the stem 8. The signal bell 2 is caused to sound only while the parts 8' and 17 are in contact, and advises the operator of the machine that sufficient time

has elapsed for proper admixture of the materials previously fed into the drum *B*, whereupon the operator may actuate the handle *I* and turn the chute *F* into a discharging position. The closing of the circuit, as above described, not only causes the operation of the audible signal 2, but energizes the magnet 20, thereby attracting the armature 21 and disengaging the locking portion of said armature from the projection 22. Were it not for this disengagement it will be obvious that the operator would not be able to move the chute *F* to discharge the contents of the drum *B*.

The provision of the members 2 and 21 affords a double precaution or check against the operation of discharging the contents of the mixing drum previous to the proper admixture of the materials therein contained.

I contemplate within the purview of my invention the employment of the parts 2 and 21 combinatively, or either of them alone. When the audible signal 2 is used alone it is very advantageous, in that an inspector overseeing the use of the mixed materials is able to supervise the proper operation of the mixer even though he be some distance away from the place where the machine is located. The operator of the machine is, of course, primarily advised of the completion of the mixing operation by the signal 2, and also advised that the discharge chute is free for operation, owing to the fact that said chute is unlocked simultaneously with the sounding of the signal 2. During the operation of the lever 12 the counter 3 is actuated to register each batch loaded into the drum *B*.

It is contemplated that the casing 1 shall be supplied with a suitable door to enable access to the mechanical devices enclosed thereby, and said door shall be locked by any substantial means whereby to prevent unauthorized access thereto. Owing to the provision of a lock for the discharge chute *F*, it will be clear that the aggregates in the mixer are compulsorily retained therein until lapse of the required time for effecting proper admixture.

Having thus described the invention, what is claimed is:

1. In combination, a mixing machine, means to control its operation, and means to automatically signal a predetermined time of completion of the mixing operation of such machine.

2. In combination, a mixing-machine, means for controlling the operation of said machine, and means adapted to be actuated by the last mentioned means to automatically indicate the time of completion of a mixing operation of the machine.

3. In combination, a mixing-machine, means to automatically signal a predetermined time of completion of the mixing operation of such machine, and means to vary the action of the signal to accord with different conditions of operation of the machine.

4. In combination, a mixing-machine, means to control its operation, means to automatically signal a predetermined time of completion of the mixing operation of such machine, and means to adjust the signaling means whereby to cause its operation to conform with different sized batches of materials to be mixed.

5. In combination, a mixing-machine, means to control its operation, means to automatically signal a predetermined time of completion of the mixing operation of such machine, and means to prevent unauthorized access to said signaling means.

6. In combination, a mixing-machine, means to control its operation, means to automatically signal a predetermined time of completion of the mixing operation of such machine, means to vary the action of the signal to accord with different conditions of operation of the machine, and means for preventing unauthorized access to the two last mentioned means.

7. In combination, a mixing-machine, means to control the loading of said machine for the mixing operation, and means

operable by the last mentioned means to automatically signal when sufficient time has elapsed for the effecting of a proper admixture of the materials operated on by the machine.

8. In combination, a mixing-machine, means to control its operation, means to automatically signal a predetermined time of completion of the mixing operation of such machine, discharge means, and means to lock the machine against discharge until the operation of the signaling means.

9. In combination, a mixing-machine and means to control its operation, discharge means for the mixed aggregates handled by said mixing-machine, means to lock the discharge means against operation, and means to automatically release said locking means upon lapse of a predetermined mixing time.

10. In combination, a mixing-machine, means to control its operation, means to automatically signal a predetermined time of completion of the mixing operation of such machine, discharge means for said mixing-machine, means to lock the discharge against operation, and means to automatically release said locking means simultaneously with the operation of the signaling means.

11. In combination, a mixing-machine, means for discharging mixed materials from said machine, lock means for the discharge means, automatic governor mechanism for said lock means to release the same at a predetermined time during the mixing operation, charging means for the mixing machine, and control means for the governor mechanism operable from the charging means.

12. In combination, a mixing-machine, loading means therefor, a signal means automatically operable by the loading means to cause operation of the signal at a predetermined time in the mixing operation, discharge means for the mixing-machine, locking means for said discharge means releasable

Richard E. Roe
Inventor
By *Wm. B. Brown*
Attorney

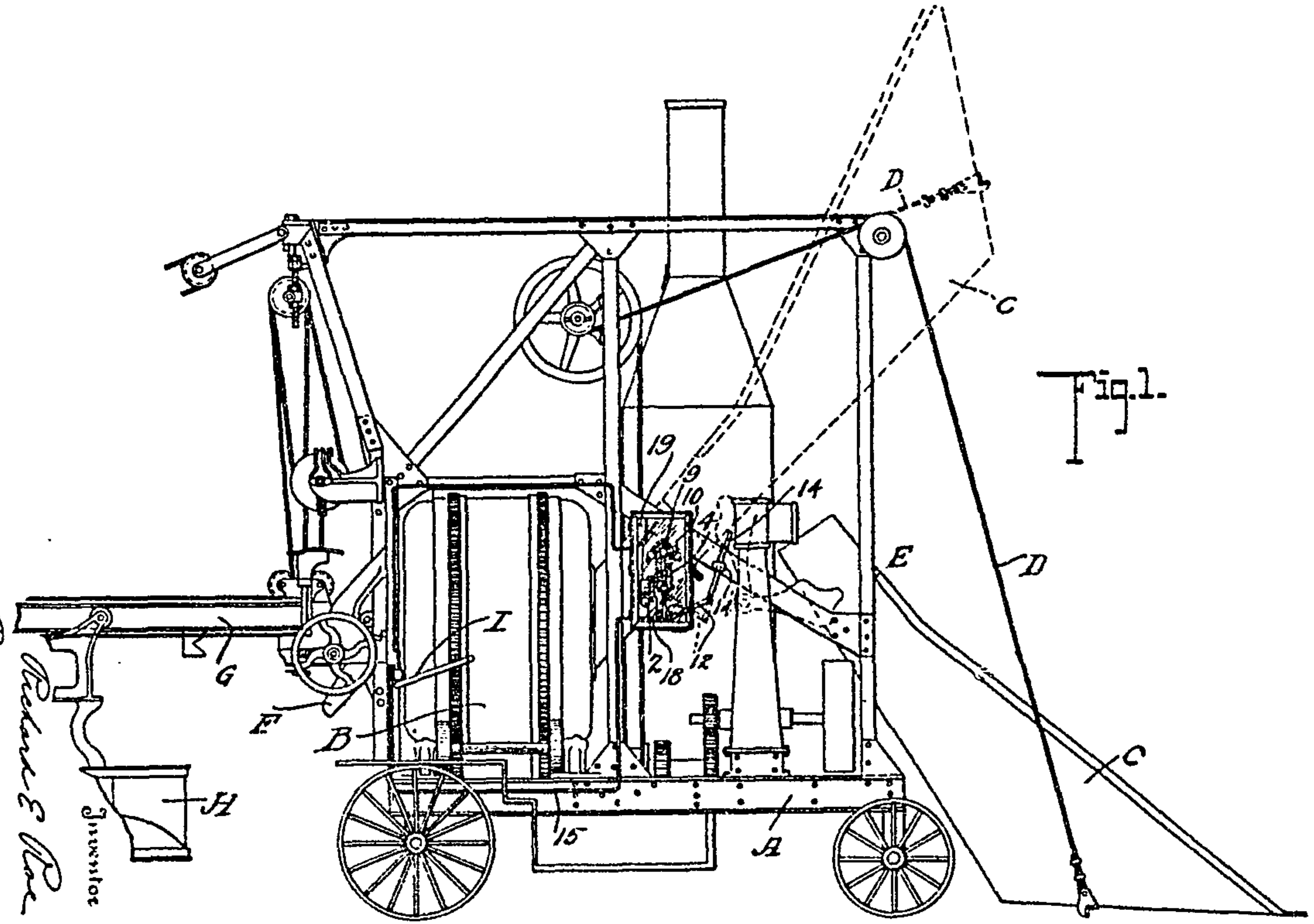
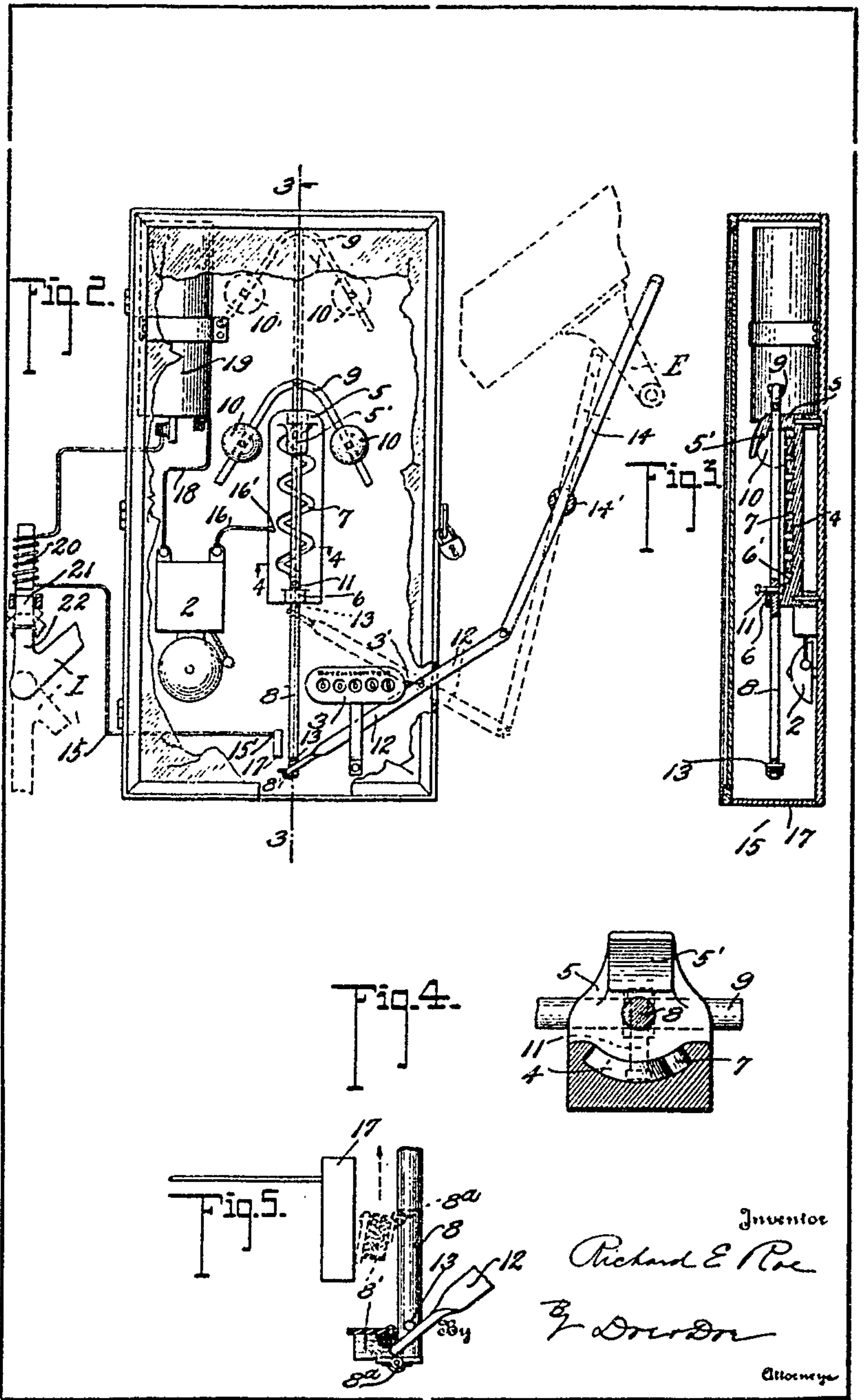


Fig. 1.



Inventor
Richard E. Roe
E. D. Dwyer
 Attorneys

simultaneously with the operation of the signal, and a counter operable by said loading means to register each operation of the latter.

13. In combination, a mixing-machine, loading means therefor, a signal, a counter for registering each operation of the loading means, and means intermediate the loading means and said signal and counter whereby to control the operation of the signal and counter automatically.

14. In combination, a mixing-device, means to supply materials to said device to be mixed, a signal to indicate when the mixing operation is completed, a counter to register each operation of the supply means, an electric circuit including said signal, a governor for closing said circuit, means intermediate the supply means and said governor and counter to automatically operate the latter, a casing enclosing said governor and signal and counter, and means to prevent unauthorized access to said casing.

15. An attachment for mixing-machines, the same comprising a signal, locking means to prevent operation of the mechanism of said machine, and means adapted to be operated by other mechanism of the machine for controlling the operation of said signal and locking means.

16. An attachment for mixing-machines, the same comprising a signal, locking means to prevent operation of mechanism of said machine, means adapted to be operated by other mechanism of the machine for controlling the operation of said signal and locking means, and a counter operable incident to the operation of the signal.

IN TESTIMONY WHEREOF, I affix my signature.

RICHARD E. ROE.

OATH

State of Ohio }
 County of Cuyahoga } ss.

Richard E. Roe, the above named petitioner, being duly sworn, deposes and says that he is a citizen of the United States of America, and resident of Cleveland, in the county of Cuyahoga, and State of Ohio; that he verily believes himself to be the original, first, and sole inventor of the improvement in CONTROL DEVICE FOR MINING-MACHINES, described and claimed in the annexed Specification; that he does not know and does not believe that the same was ever known or used before his invention or discovery thereof, or patented or described in any publication in any country before his invention or discovery thereof, or more than two years prior to this application, or in public use or on sale in the United States for more than two years prior to this application; that said invention has not been patented in any country foreign to the United States on an application filed by him or his legal representatives or assigns more than twelve months prior to this application; and that no application for patent on said improvement has been filed by him or his representatives or assigns in any country foreign to the United States.

RICHARD E. ROE.

SWORN to and subscribed before me this 27th day of March, 1919.

JOHN DOE,
Notary Public.

Address only
The Commissioner of Patents
Washington, D. C.

SERIES OF 1919
No. 618

DEPARTMENT OF THE INTERIOR
UNITED STATES PATENT OFFICE

Washington, D. C., March 29, 1919.

Sir:

I have to acknowledge the receipt of the petition, specification, oath, and drawing, with first fee of FIFTEEN DOLLARS, of your application for patent for CONTROL DEVICES FOR MIXING-MACHINE.

Your application will be considered in its order, and you will be duly advised as to the examination thereof, through your attorneys.

Very respectfully,
THOMAS EWING,
Commissioner of Patents.

RICHARD E. ROE,
c/o Doe & Doe, Attys.
Cleveland, Ohio.

Div. 25, Room 315.

Paper No. 1.

DEPARTMENT OF THE INTERIOR
UNITED STATES PATENT OFFICE

Washington, April 28, 1919.

Doe & Doe,
Cleveland, Ohio.

Please find below a communication from the EXAMINER in charge of the application of Richard E. Roe, Ser. No. 618, filed May 29th, 1919, for CONTROL DEVICES FOR MIXING-MACHINES.

THOMAS EWING,
Commissioner of Patents.

This case considered.

The locking device appears to relate to the movement of a chute and not the mixer; see lines 20 to 23 inclusive, page 3. Signals and indicators are separate devices from mixers and have no patentable combination therewith.

The apparatus shown in Figure 2 of the drawings and partially described in pages 6 to 9 inclusive of the specification appears to be an indicating device for a loader and not for a mixer as the signal (bell) appears to be given only when the

electric circuit (not fully described) is completed by a predetermined number of loads of material being discharged into the drum. From the description it is not clear by what means the time for the governor to operate is indicated nor does there appear to be an operative connection between said governor and the mechanism rotating the drum. More description seems necessary. What "times" the operation of the governor, and what determines the "minimum" time for the mixing of the batch?

Claims 1 to 14 inclusive, each having as an element therein "a mixing-machine" or a "mixing-device" are examinable under Mortar Mixers in Class 83, in Div. 25, while claims 15 and 16 are each for a signal with locking means (adapted for a chute) and means operated by other (?) mechanism (loader) for controlling the signal and locking means, claim 15 having also an indicator therein. Said claims 15 and 16 appear to be examinable under Signals, Class 116, in Div. 42. Division is required.

While no definite action can be had pending the requirement of division, it will be remarked that claims 1 and 2 are vague in the element "means to control its operation." As understood such appear to be either the loading device or the discharge chute, or both, and appear to have no patentable combination with a "mixer." The mechanism which operates or controls the mixer, i.e., its rotating mechanism, does not appear to be affected by either the loading, indicating, signaling, chute locking, or releasing mechanism set forth. What are the "means for preventing unauthorized access to the two last mentioned means" of claim 6? No patentable combination is apparent between the controlling means (?) for the "loading" and the other elements of claim 7. Said claim 7, and also claims 8 to 11 inclusive, appear to be each for an aggregation and not a patentable combination, as both the signaling and indicator devices are connected with and operated by the operation of the loader and not by the mixer; neither do they in any manner operate the mixer.

The invention, if any, appears to be in a specific signaling device, and means for actuating it after a predetermined number of operations of controlling means, and should be so claimed.

It also includes with said signaling device an automatic release lock for a lever and not the application broadly of the connection of a mixer with a signal or an indicator which, owing to the universal use of such devices with all classes of operating mechanism, would not involve patentability.

Signaling devices in connection with indicators are everyday affairs.

Examiner, Div. 25.

IN THE UNITED STATES PATENT OFFICE

RICHARD E. ROE

Control Devices for Mixing-Machines,

Filed March 29th, 1919,

Serial Number 618/19,

Last Office Action April 28th, 1919.

Room 315—Div. 25.

Hon. Commissioner of Patents,

Washington, D. C.

Sir:—

Responsive to the above noted Office action, amendment is made as follows:

Page 3, line 12, before "loading" insert *Charging or.*

Page 5, line 15, before "bucket" insert *Charging.*

Page 6, at the end of line 8 insert: *Any suitable means to discharge the mixed materials may be used within the purview of my invention;* line 17, after the comma insert *formed on an arc as seen in the cross section of Figure 4;* line 22, after "a" insert *gravitating and slightly rotative.*

Page 7, line 15, before the period insert *the extent of rotative swing of the weights 10 varying according to the adjustment.*

Page 8, after the first paragraph insert:

"As a general thing, under actual conditions of use, the signaling means is intended to be susceptible of adjustment for operation after the expiration of the time fixed for the mixing operation, ranging from three seconds to three minutes. As suggested, the time is dependent upon the size or capacity of the mixing-drum itself, or the amount of materials that may be fixed as the batches to be mixed, for a predetermined operation of the machine, say in accordance with certain specifications. Adjustment of the signal for operation of different elapsed times is controlled by the corresponding adjustment of the weights 10 in a manner described hereinbefore."

Claim 1, line 1, after "machine" insert *comprising a mixing-device;* line 2, after "means" insert *adjustable according to the construction of said mixing-device;* line 3, make "machines" read *machine.*

Cancel claim 2 and substitute:

2. The combination, with a mixing-machine comprising a mixer, means to discharge the same, and charging mechanism, of a signal adapted to indicate when the mixer has completed its operation to effect thorough admixture of the materials operated on thereby, and coacting instrumentalities between the signal

and the charging mechanism, for controlling the signal from said mechanism.

Claim 4, lines 1 and 2, cancel "means to control its operation"; line 3, before "and" insert *means to set the signaling means for operation.*

Claim 4, last line, before the period, insert *in the mixing-machine.*

Cancel claim 5 and substitute:

5. A mixer, discharge means therefor, means for charging the mixer, a signal to indicate completion of a mixing operation of the mixer, and means to set the signal for operation incident to charging of the mixer by the charging means, and means to prevent unauthorized access to the signaling means.

Cancel Claims 6 and 7, and substitute:

6. The combination, with a mixing-machine comprising a mixer, means to discharge the same, and charging mechanism, of a signal adapted to indicate when the mixer has completed its operation to effect thorough admixture of the materials operated on thereby, coacting instrumentalities between the signal and the charging mechanism for controlling the signal from said mechanism, and lock means for the means to discharge the mixer controllable by the signal.

7. The combination, with a mixing-machine comprising mixing mechanism, means to discharge the mixed materials from said mechanism, and charging means for said mixing mechanism, of lock means to prevent operating of the discharge means, and coacting instrumentalities between the charging means and the lock means to control the action of the latter by the charging means.

REMARKS

Certain of the original claims have been withdrawn, but applicant wishes to indicate clearly in the record that there is no intention by the cancellation to abandon what is believed to be essential and broadly novel subject-matter of his invention. The cancellation, on the other hand, is merely made with a view to enabling the presentation of claims that more definitely include the subject-matter of the original claims, something which we think is suggested as appropriate according to the official action.

It can not be agreed that applicant's invention, if any,

appears to be in the specific signaling device. The record fails to show a citation that has even the broadest possible bearing upon the invention submitted for protection. Applicant's invention might be briefly characterized as residing in the provision of mechanical instrumentalities, one of which is a signal, or equivalent means, corresponding to or adjusted in one way or another according to the capacity of the mixing device, or the size of the batch of materials that may be acted upon thereby, and the controlling of the operation of such a signal from the charging means forming a part of the mixing-machine, in combinations, and subcombinations; and also in the important lock feature.

The idea in the art of mixing-machinery, of employing some sort of a signal, established of course in proper cooperative relation with respect to the mixing-instrumentalities, for the purpose of apprising the operator of the machine when a thorough admixture of a predetermined batch of materials is completed, is new, and we respectfully ask the cooperation of the Examiner in the grant of protection commensurate with the novelty of the above discovery or idea. The foregoing means, broadly speaking, excepting that lock means for the discharging mechanism of the mixer, either with or without the signal, are employed, is also an entirely new invention, it being our understanding from a personal interview with the Examiner that there are no anticipatory references to cite in this case.

The claims in the application, as now submitted, are thought to more fully define the cooperative relation between the mixing-machine instrumentalities, and the signaling and discharge locking means of the invention.

For the applicant to attempt to claim his attachment *per se* without reference to a mixing-machine would be futile in affording him protection for the combination idea that he has invented. It is in the combination essentially that novelty resides.

As to formalities, it is noted that at the time of the personal interview with the Examiner the suggestion that the electric circuit was not fully described was withdrawn. The specification has been enlarged somewhat to show more fully how the adjustment of the weights 10 actually affords a variation in the time of descent of the member 8, which time, of course, controls the time elapsing after the charging of the mixer before the operation of the signal.

The means for preventing unauthorized access to the governor is referred to in the next to the last paragraph in page 11 of the description.

Further action on the case in view of the foregoing argument and explanation is requested.

Respectfully submitted,

DOE & DOE,
Attorneys for applicant.

Cleveland, Ohio, Nov. 16, 1919.

Div. 25, Room 315

Paper No. 3.

DEPARTMENT OF THE INTERIOR
UNITED STATES PATENT OFFICE

Washington, Dec. 27, 1919.

Doe & Doe,
Cleveland, Ohio:

Please find below a communication from the EXAMINER in charge of the application of Richard E. Roe, Ser. No. 618, filed March 29, 1919, for Control Devices for Mixing-Machine.

THOMAS EWING,
Commissioner of Patents.

In response to amendment filed Nov. 18, 1919.

Claim 1, as amended, is vague and also inapt in the phrase "according to the construction of said mixing-device" in the amendment to line 2 thereof.

New claim 2 seems to be an aggregation of the mixer with the other elements thereof, as such in no way affects either the

function or operation of the mixer. The essential elements of said claim appear to be a loader and a specific indicator and signal.

So far as described there does not appear to be any mechanical connection between the mixer and the other elements set forth in each of claims 3 to 5 inclusive, and these claims are held to be for mere aggregations and not for patentable combinations, hence rejected.

The "signal" of line 3, claim 6, adds nothing to the function of the other elements thereof, neither does it modify in any way the operation of the mixer. For this reason said claim 6 is rejected as without patentability.

Claims which cover a charging or loading device with an accompanying indicator and signal would be examinable in a different division of the office from that in which mixers are examined, being for a separate and independent subject matter.

The "signal means" of each of claims 8 to 10 inclusive add nothing to the patentability of the other elements of each thereof, besides rendering them objectionable as aggregations, hence rejected. If freed from said element claims 9 and 10 would be allowable as at present advised. Claim 8 would need revision.

Examiner, Div. 25.

IN THE UNITED STATES PATENT OFFICE

RICHARD E. ROE,
Control Devices for
Mixing-Machines,
Filed March 29, 1919,
Serial Number 618.
Last Office Action Dec. 27, 1919.

Room 315—Div. 25

Hon. Commissioner of Patents,
Washington, D. C.

Sir:—

Responsive to the above noted office action, amendment is made as follows:

Rewrite claim 1 to read as follows:

1. In combination, a mixing-machine comprising a mixing device, means to control its operation, and means adjustable according to the capacity of said mixing device to automatically signal a predetermined time of completion of the mixing operation of such machine.

Claim 9, last line after "means" insert *as an incident to the operation of said signal.*

Claim 10, last line, make the period a comma and add *whereby the operator is advised that the discharge means is operative owing to the release of said lock means.*

Claim 13, next to last line, substitute *signaling* for "loading"; last line, substitute *loading means* for "latter."

REMARKS

Applicant after thorough consideration of the grounds of rejection of the essential and important claims of record, and also consideration of the controlling authorities involving the questions of combinations of aggregations, is unable to acquiesce in the position of the Office refusing the allowance of said claims.

There are several propositions which are presented by the rejection now of record and which will be fully treated in an effort to promulgate the allowance of protection commensurate with the novelty of the invention submitted.

Claim 13, next to last line, substitute *signaling* for "loading"; what so as to cure the objection, several other claims having also been slightly amended so as to avoid ambiguity, but the majority of the claims are submitted for reconsideration in view of the following remarks, and no disclaimer for lack of novelty is conceded.

A fair statement of the condition of this application is that no reference has been made of record by the Office, having any bearing upon, or in any way negating the novelty of the combination covered by each contested claim. There appears also to be uppermost in the mind of the Examiner the question of classification and the effort to direct counsel toward a modification of the claims that would necessarily result, perhaps, in further divisional requirements or transfer of the application to an art foreign to the art of mixing machines.

Involved in the question of aggregation is the position of the Examiner now stated affirmatively, though negatively pre-

sented by him, that the action of the mixer must be modified by the other elements of each claim, including such mixer as an element.

We respectfully suggest that there can be little or no question regarding the novelty of applicant's invention. He is the first, in the face of the state of the art of the file record, to invent cooperative signaling—and mixing—apparatus in which the time of completion of the mixing operation of a mixer forming a part of said apparatus is automatically indicated. He is the first to employ locking means as presented. In applicant's specification the commercial advantages of his invention are fully presented and need not be reiterated. The present invention is being used extensively now commercially as a part of mixing-machinery. A new result is achieved in the operation of the invention, and no anticipation of the combinations of the claims as such, nor any suggestion of anticipation of the result attained, can be found in the record.

It is submitted that the regular practise of the Office is not being followed in the examination of this case. Giles in his lectures on Patent Office practise says as follows:

Under the present practise the Examiners-in-Chief very seldom affirm an Examiner in his decision that a claim covers an aggregation and has been twice rejected for that reason alone. References must be cited anticipating the separate devices making up the alleged aggregations, otherwise the claim will be held to be allowable if the separate devices are capable of conjoint use in the same invention.

It is respectfully maintained that the main and essential result of the present invention has to do, both from the standpoint of construction and commercial practise, with the operation of mixing-machines. By mixing-machines we have in mind a structure involving not only a mixing-drum or mixer *per se*, but the usual adjuncts found in such machines, namely charging and discharging instrumentalities. To attempt to claim the present invention independently of a mixing-machine, at

least in so far as the broadest phase of the invention is concerned, would, we think, defeat the object of the present application which has to do with an advance in the art of mixing-machines, considering the results involving the patentability of the combinations expressed. Applicant does not want a patent on his signal, or a lock, *per se*; nor does he desire protection on any mixing instrumentalities *per se*. It is the co-operative functioning of these parts that must be covered if the invention at bar is to be given the protection of the statute.

That the applicant is presumed to know his invention, and is authorized under the law to himself set the limits and define the novelty of said invention, is supported by *ex parte* Mumford, 206 O. G., 879, in which the Honorable Assistant Commissioner held:

In making a requirement of division, one of the elements of a claim cannot be ignored.

The above authority also sustains the practise indicated by Giles as controlling the Examiners-in-Chief in deciding questions of aggregation, in which connection we quote again from *ex parte* Mumford:

Claim 12 purports to be for a combination of the cable and the carriage, and the question for the Examiner to determine was whether that combination, assuming it to be a valid one, was for an invention separate from that covered by the remaining claims. If so considered, division could not properly have been required, but if the Examiner was of the opinion that the claim was not patentable because the combination of a cable and a carriage was old and therefore the invention, if any, lay in the carriage, he should have cited references to show the old combination and rejected the claim under the authority of *in re* McNeil, etc.

To a certain extent in the present case, it would appear that the Examiner is holding that applicant's invention resides in his signal, the facts therefore paralleling the condition referred to in the above decision. Our contention, however, is that the

important and new result achieved by applicant has nothing to do with any specific form of signal and cannot reside solely in the signaling means that constitutes a necessary element of the combination. In regard to this position the Commissioner, in the case above referred to, makes the following apt remarks:

Obviously, if the new element coacts with the other elements of the combination in a different manner from the corresponding elements of the old combination, and a new result is obtained thereby, the decisions referred to do not apply.

The Commissioner in this case, at the time of his decision, had in mind, of course, that a review of the references would be such as to enable a favorable conclusion as to the production of the new result.

Discussing further the question of aggregation as applied by the Examiner to the present invention, we quote from the able treatment of this subject by Mr. Examiner Groesbeck in his paper read before the Examining Corps:

What statutory basis then has a rejection on the ground that a claim is for an aggregation of elements? It is solely that of lack of invention. In other words, one who has merely juxtaposed a plurality of elements which thereafter perform only the identical functions they performed before the assembling, has not displayed and did not need to display any invention.

The Examiner's position, therefore, is virtually that all applicant has done in this case is to associate a mixing-machine with a signal, and each operates just the same as before they were associated; in other words, each functions independently of the other. Such a position is not sustainable upon a true understanding of the invention as described in the contested claims, which certainly define cooperative functioning of the mixing and signaling parts.

We believe that the conclusion of Mr. Examiner Maxson, adduced from a discussion of the authorities on combination

and aggregation, in his paper before the Examining Corps, is applicable to the claims in the present case, said conclusion being:

From these it is clear that the patentability of a group of elements does not depend upon their individual novelty, but upon their unitedly producing a new and improved result, the product of their combined operation, not the mere sum of their several individual effects.

In the present case it is essential that the signaling means be adapted and designed for the mixing-machine, to the extent that said signaling means shall indicate the time of completion of the mixing operation. This is the new result, and it is attained by employing coacting instrumentalities between certain parts of the mixing-machine and the signal. We concede that the signal is not directly operated by the mixer drum, which is only one element of the mixing-machine, but said signal is certainly controlled by parts of the mixing-machine whereby the cooperative functioning necessary to a valid combination of parts is obtained.

We concede, furthermore, in this case, that in no way is the actual operation of either the mixer-drum, or mixing elements (if they be separated from the other parts of the mixing-machine in the sense of this particular argument), modified by the operation of the signal. We speak of this, because the Examiner has reiterated the proposition of the question of whether the mixer is modified in its operation by the signal, in his actions, and seems to understand that it is necessary in a combination such as submitted that the modification of the action of the mixer be obtained. This position we can not acquiesce in, because a valid combination may be predicated upon a structure wherein all parts are not modified in action by one or more other parts, in support of which reference is made to *McCormick vs. Robinson*, 124 O. G., page 2903, where it was attempted to be maintained that there was no proper combination between the casing and the file holder, in

a device in which the indicator was attached to the file holder. The Commissioner held:

It does not appear that this contention is entitled to any weight. The main object of the invention disclosed by the issue is to provide a device whereby it may be determined which of a number of holders employed in the system of keeping accounts have been opened and used during the day. The casing becomes an essential element as a means for supporting the number of holders which it is necessary to use in the system. While it may be true that there is no direct cooperation between the indicator and the casing in this form of the invention, it is not necessary in a new combination of old elements that each element should modify or change the mode of operation of the others, but only that the combination should produce a new and useful result as a product of the combination. (National Cash Register Co. vs. American Cash Register Co. 62 O. G. 449.)

As a matter of fact, in the present case there is no attempt on the part of the applicant, and the result he obtains would make such an attempt futile, to modify the action of the mixer by the signal. The object in view is to secure cooperative functioning between the mixing-machine as a whole and the signal, the signal itself being controlled and operated by certain parts of the mixing-machine, namely the loading or charging mechanism for the latter. In the art of registering machines, in which art the Principal Examiner in charge of this case is an expert, it will be recalled that a number of patents have been granted to combinations of typewriters and adding-machines where the action of the typewriter causes operation of adding mechanism. However, in no one of the machines of the type particularly referred to is the action of the typewriter modified. In fact the typewriter works as it always does, but instrumentalities are provided to secure cooperative functioning of the two mechanisms of the main machine, which is the proposition before the Examiner in this case. We may, therefore, paraphrase the words of the Com-

missioner in *McCormick vs. Robinson* in respectfully suggesting that no direct cooperation between the signal and the mixer in this form of the invention is required.

At the time of a personal interview with the Examiner he very courteously urged counsel to eliminate the mixing-machine element of his claims with a view, perhaps, to broadening them, but the broadest phase of applicant's invention inherently requires, in his belief, the limiting of his main claims to the art of mixing-machinery wherein the important advance believed to be represented by the invention has taken place. The reason for this is that to a large extent the result achieved is locked up, so to speak, with the action of mixing in a mixing-machine and we believe, therefore, that were we to direct the claims of applicant along the lines of the Examiner's suggestion a mistake in defining the subject matter of the invention, having in view the result achieved, would be made and such mistake would not be rectified, owing to the mere approval by the Office, as well settled by the Court in the celebrated grab-hook case.

This case is now submitted in the hope that on reconsideration the claims contended for will be deemed allowable.

Respectfully submitted,

DOE & DOE,

Cleveland, Ohio, Feb. 4, 1920.

Attorneys for applicant.

Div. 10, Room 235

Paper No. 6

2-260

DEPARTMENT OF THE INTERIOR
UNITED STATES PATENT OFFICE

Washington, April 30, 1920.

Doe & Doe,
Marshall Bldg.,
Cleveland, Ohio:

Please find below a communication from the EXAMINER in charge of the application of Richard E. Roe, filed March 29,

1919, Serial No. 618, for CONTROL DEVICES FOR MIXING-MACHINES.

THOMAS EWING,
Commissioner of Patents.

Responsive to the amendment of Feb. 6, 1920:

Claims 3 and 7 to 9 are rejected in view of the following patents:

Scott, 993,557, March 30, 1911.

Simpson et al., 986,843, February 10, 1914.

Mason, 28,189, May 8, 1860.

Examiner Div. 10.

IN THE UNITED STATES PATENT OFFICE

In re application of
Richard E. Roe,
Control Devices for
Mixing-Machines,
Serial No. 618,
Filed March 29, 1919.

Room No. 315,
Div. No. 25

Hon. Commissioner of Patents,
Washington, D. C.

Sir:—

In response to the Office action of Feb. 6, 1920, we hereby amend as follows:—

The claims rejected are submitted as previously of record and reconsideration requested.

The patent of Mason is for a machine for drying sugar. If there is any mixing effect produced by the machine it is merely incidental to the drying operation. Mason's machine is not adapted to mix concrete. Aside from the inadequacy noted, Mason's machine does not meet either of the claims. There is no locking means for the valve which controls the discharge of sugar from the drying chamber.

The patent of Scott is for a tea-blending machine. The machine of this patent may be said to relate broadly to the mixing art, but it is thought not to be adapted for the mixing of concrete. The Scott machine does not respond to the terms of either of the claims. It fails to disclose the signaling means and locking means for the discharge means.

The Simpson & Thompson patent covers a coffee-roasting machine. Any mixing that might take place in the operation

of these machines would be simply incidental to the roasting operation. An essential feature of the machines of the coffee-roasting patent is that there shall be a heating mechanism for the roasting drum, and the drum shall be perforated; at least this is the disclosure of the patent. The feature of construction just referred to would prevent the employment of such machine for the purpose of mixing concrete. Furthermore, if the head *D* of the Thompson patent be regarded as the discharge means of the claims, then the locking means for the head must be the bolt 30 controlled by the thermostat *T*. This control device depending upon the heat for its operation is obviously inapplicable to a concrete mixing-machine. These patents relate to a non-analogous art, and in no way suggest the control features designed by applicant for the art of concrete mixing. There are no coacting instrumentalities between the lock means, and the charging means, to control the actions of the former by the charging means.

The references relied upon are inadequate on which to base a valid rejection of applicant's claims. We, therefore, respectfully ask a reconsideration of the rejected claims, and an allowance. While applicant's invention as presented in this case is in a crude form, instead of the actual commercial embodiment as made to-day, it represents in principle an important advance in the concrete-mixing art as previously pointed out.

Respectfully submitted,

RICHARD E. ROE,

By Doe & Doe,

Attorneys.

April 17, 1920.

DEPARTMENT OF THE INTERIOR
UNITED STATES PATENT OFFICE

Washington, May 2, 1920.

Richard E. Roe, Assor.

Sir: Your application for a patent for an IMPROVEMENT in Control Devices for Mixing-Machines, filed March 29, 1919, has been examined and ALLOWED.

The final fee, TWENTY DOLLARS, must be paid not later than SIX MONTHS, from the date of this present notice of allowance. If the final fee be not paid within that period the patent on this application will be withheld, unless renewed with an additional fee of FIFTEEN DOLLARS under the provisions of Section 4897, Revised Statutes.

The Office delivers patents upon the day of their date, and on which their term begins to run. The printing, photolithograph-

ing, and engrossing of the several patent parts, preparatory to final signing and sealing, will require about four weeks, and such work will not be undertaken until after payment of the necessary fee.

When you send the final fee you will also send, **DISTINCTLY AND PLAINLY WRITTEN**, the name of the **INVENTOR**, **TITLE OF INVENTION**, **AND SERIAL NUMBER AS ABOVE GIVEN**, **DATE OF ALLOWANCE** (which is the date of this circular), **DATE OF FILING**, and, if assigned, the **NAMES OF THE ASSIGNEES**.

If you desire to have the patent issue to **ASSIGNEES**, an assignment containing a **REQUEST** to that effect, together with the **FEE** for recording the same, must be filed in this Office on or before the date of payment of final fee.

After issue of the patent uncertified copies of the drawings and specifications may be purchased at the price of **TEN CENTS EACH**. The money should accompany the order. Postage stamps will not be received.

Final fees will **NOT** be received from other than the applicant, his assignee or attorney, or a party in interest as shown by the records of the Patent Office.

Respectfully,

THOMAS EWING,

Commissioner of Patents.

Doe and Doe,
Marshall Building,
Cleveland, Ohio.

Ser. No. 618.

DEPARTMENT OF THE INTERIOR
UNITED STATES PATENT OFFICE

Washington, July 17, 1920.

Richard E. Roe, Assor.,
Sir:

You are informed that the final fee of **TWENTY DOLLARS** has been received in your application for **Improvement in Control Devices for Mixing-Machines**.

Patent
Aug. 11, 1920
Will Issue

Date of receipt
July 15, 1920.

Very respectfully,

THOMAS EWING,

Commissioner of Patents.

Doe & Doe,
Cleveland, Ohio.

XVI

A TYPICAL COMPOSITION AND PROCESS APPLICATION AS COMPLETELY PROSECUTED*

(Including Appeal to Board of Examiners-in-Chief)

[NOTE: The Petition, Oath, and other papers corresponding to those previously given, are omitted—Author.]

TO ALL WHOM IT MAY CONCERN:

Be it known, that I, Richard E. Roe, a citizen of the United States residing at Montpelier, in the County of Rutland, and State of Vermont, have invented certain new and useful improvements in MANUFACTURE OF POLISHING STONES, of which the following is a specification:

STATEMENT OF INVENTION

This invention relates to the manufacture of polishing stones, and has particular reference to a novel composition of matter for forming stones used to polish marble, and to a novel process of producing the same.

The object of the invention is to produce a polishing stone, by the use of which a fine finish may be given to even the very poor grades of marble, and to so prepare the ingredients that a stone may be produced which will not scratch or in any way mar the surface to be polished.

Further objects are to produce a composition of the above character which will impart a superior finish to the work by the employment of simple and cheap ingredients, and to afford a novel process by which the ingredients are combined in a manner so as to obtain the most satisfactory results.

* U. S. Patent File Wrapper. Patent No. 1099831, issued June 9, 1914, to G. A. Undeen.

To these ends, the composition consists of emery-powder, shellac, and rosin mixed in the proportions hereinafter recited, with or without the addition of a relatively small quantity of sulfur. The process consists in melting a quantity of rosin and maintaining the heating thereof for a period of about two hours; in then mixing the rosin with a quantity of shellac, the fluid mixture being then strained, and in adding emery powder to the fluid mass with the accompaniment of strong stirring, after which the mass may be run into molds and cast into the desired shape.

GENERAL DESCRIPTION COMPOSITIONS

In effecting the present invention, I employ the following compositions, it being understood that the proportions refer to parts by volume:

Composition A.

Emery-Powder	1 part
Shellac	3 Parts
Rosin	2 parts

Composition B.

Emery-Powder	2 parts
Shellac	1½ parts
Rosin	2 parts

Composition A will be generally used, the proportions therein recited being best adapted for use in connection with the ordinary grades of marble, while Composition B is especially effective for use in connection with the harder grades of marble.

In practise, I use pure Turkish emery-powder No. 3F, while the ordinary commercial grades of shellac and rosin will suffice for the purpose. I will now proceed to describe the manner in which the ingredients are combined for forming the improved polishing stone.

METHOD OF COMBINING INGREDIENTS

A suitable quantity of rosin is melted and the heating is maintained for about two hours. While I have found that this protracted heating of the rosin is necessary in order to obtain a polishing stone which will not be too hard and gives the desired waxy effect, I am unable to positively state whether there is any chemical change in the rosin as a result of the heating. In view, however, of the superior effect obtained by thus heating the rosin, I am convinced that this step affords a novel and valuable feature of the process. It is likely that certain substances, which in the commercial grades of rosin are found as impurities that may have a deleterious effect on the final product, are volatilized during the heating and are thus eliminated. I then add the melted rosin to the proper quantity of shellac which may be either melted before its addition to the rosin or afterward. The molten mixture is then strained so as to eliminate solid impurities in the rosin and shellac which would tend to scratch, or otherwise mar, the surface of the marble during the polishing operation. The heating of the mixture of shellac and rosin is then continued for a short period, after which the emery-powder is added to the mass, it being necessary to strongly stir the mass during the addition of the powder, and for several minutes thereafter. At any time after the emery-powder has been added, but preferably after the mixture has cooled somewhat, a pinch of sulfur may be added to the mixture, but this is not a necessary feature of the invention. The addition of the sulfur is advantageous, however, in that it prevents the mass from agglomerating, thus rendering the operation of casting easier. After the above operations, the mass is run into molds, where it is allowed to cool and assume the shape desired.

I have found that the inclusion of the rosin prevents the mass from becoming too hard when it is formed into stones, and by the treatment of the rosin above described, that is,

heating it for a considerable period, the desired soft, waxy effect is obtained in the polishing stones.

Having thus described the invention, what is claimed as new is:

1. A composition of matter for forming polishing stones, consisting of emery-powder, shellac, and rosin.

2. A composition of matter for forming polishing stones, consisting of substantially 1-2 parts emery-powder, 1 ½ parts shellac, and 2 parts rosin.

3. A composition of matter for forming polishing stones, consisting of emery-powder, shellac, and rosin combined in substantially the proportions of one part of the emery-powder, three parts of the shellac, and two parts of the rosin.

4. A composition of matter for forming polishing stones, consisting of emery-powder, shellac, and the product resulting from the heating of rosin for about two hours.

5. A composition of matter for forming polishing stones, consisting of emery-powder, and the product resulting from the straining and heating of rosin and shellac.

6. A composition of matter for forming polishing stones, consisting of one part emery-powder, three parts shellac, and two parts of the product resulting from the heating of rosin for about two hours.

7. A composition of matter for forming polishing stones, consisting of one part emery-powder, three parts shellac, and two parts rosin, and a relatively small quantity of sulfur.

8. The process of manufacturing polishing stones, which consists in heating shellac and rosin, adding emery-powder to the mixture with accompanying stirring, and finally casting the resulting mixture into the desired shape.

9. The process of manufacturing polishing stones, which consists in heating a mixture of shellac and rosin, straining the mass, then adding emery-powder to the mass, and finally casting the mass into the desired shape.

10. The process of manufacturing polishing stones, which

consists in heating rosin for about two hours, adding shellac to the rosin, straining the mixture thus formed, then adding emery-powder to the mixture, and finally casting the mixture into the desired shape.

11. The process of manufacturing polishing stones, which consists in heating two parts of rosin for about two hours, then melting about three parts of shellac and adding same to the rosin, straining the fluid mass, then adding one part emery-powder to the mass with accompanying stirring, and finally casting the mass into the desired shape.

In testimony whereof I affix my hand and seal this 28th day of July, 1912.

GUSTAV A. UNDEEN.

Div. 27, Room 375.

Paper No. 2 Rej.

DEPARTMENT OF THE INTERIOR
UNITED STATES PATENT OFFICE

Richard E. Roe,
c/o John F. Doe,
McGill Bldg.,
Washington, D. C.

Washington, April 25, 1912.

Please find below a communication from the EXAMINER in charge of your application No. 688,284, filed April 3, 1912, Manufacture of Polishing Stones.

E. B. MOORE,
Commissioner of Patents.

Claim 2 sets forth a composition that is not disclosed, namely, "a composition containing 1½-3 parts of shellac."

Claim 7 is alternative with claims 3 and 6, which sets forth the composition designated A in the specification.

Claims 1 to 6, inclusive, and 8 to 11, inclusive, are met in the patent to

Tanner, 53,066, Mar. 6, 1866; and

English patents #1615 of 1856 to Fisher, and

#2889 of 1953 to Hannay, Class 51—1.

Examiner.

IN THE UNITED STATES PATENT OFFICE.

Richard E. Roe,
Manufacturing of Polishing Stones,
Filed April 3, 1912,
Serial No. 688,284,
Last Office Letter April 25, 1912.

Room 375.

Hon. Commissioner of Patents,
Washington, D. C.

Sir:

Responsive to the above noted official action, please amend as follows:

Cancel claims 1, 2 and 3, and adjust the ordinals of claims 3, 4, 6, 7, 8, 9, 10 and 11, to 1, 2, 3, 4, 5, 6, 7 and 8, and add the following claim:

9. The process of manufacturing polishing stones, comprising heating two parts of rosin for about two hours, then melting about three parts shellac and adding the same to the rosin, then adding one part emery-powder to the mass while stirring the same and adding a relatively small quantity of sulfur, and finally casting the mass.

REMARKS

Reconsideration of the holding of claim 7 as alternative with claims 3 and 6 is requested for the reason that the first-named claim appears to differ essentially from the other two claims only in the addition of sulfur. So far as counsel is aware there is no possible ground for objection to claiming a subcombination in the same case with a claim covering a combination of the whole. That is to say, in a structure made up of a combination consisting of A, B and C it seems a well-settled law that applicant is entitled to claim the subcombination A and B, if such combination possesses utility, and in the same case to claim the entire combination A, B and C. It might be justifiable to call for division, if in the hypothetical case suggested an attempt were made to cover subcombination A and B, and subcombination A and C, with the general combination A, B and C, because then subcombination A and B may conceivably be a distinct thing from subcombina-

tion A and C, and one or the other might properly be required to be presented in a divisional application. But such condition does not exist in the present case, wherein several elements are all named in one set of claims, and all of the same elements are named in the other claim, with an added element which makes the latter claim merely representative of the general combination including a subcombination. General combinations, and several subcombinations may even be claimed in one case, where the subcombinations are not clearly distinct inventions. Hence, favorable consideration of claim 4, former claim 7, is requested.

Favorable reconsideration of present claims 1, 2, 3, 5, 6, 7, and 8 is requested for the reason that these claims specifically set forth a particular structure and a particular process. If the Examiner will take into consideration the object which applicant proposes to attain, and does attain as set forth in the second paragraph of the specification, he will see that a conglomerate mass of almost an endless number of ingredients cannot well be said to meet the invention claimed which has a specific and particular object in view. It appears that the two foreign patents cited endeavor to set forth a large proportion, if not all of the known bonding substances, with the similar proportionate number of the abrasive substances, and of lubricating substances, without any definite or clear disclosure of any particular combination of given ones of these elements which will produce a specific result. The courts have repeatedly condemned the use of alleged anticipating references which are lacking in exactness or precision of disclosure. In the case of *Wood vs. Underhill*, 5 How. 1; 12 L. Ed. 23, the Court set forth this rule as follows:

When the specification of a mere composition of matter gives only the names of the substances which are to be mixed together, without stating any relative proportion, undoubtedly it would be the duty of the court to declare the patent void. And the same rule would prevail when it was apparent that the proportions were

stated ambiguously and vaguely. For in such cases it would be apparent on the face of the specification that no one could use the invention without first ascertaining by experiment the exact proportions.

If, as stated, a patent is void for lack of disclosure when it is ambiguous and does not give proportions, it naturally follows that such a patent is not an adequate reference for anticipating a subsequent inventor. Each of the claims as now retained in the case sets forth specifically the proportions required for giving efficient results, and more than this, certain claims, as for instance claim 2, call for the product of rosin after it has been heated for two hours. Such a specific limitation seems clearly to distinguish the invention from anything hinted at in the art. As set forth in the specification, there is a definite purpose in maintaining the heat of the rosin for the given period, and, while applicant is not able to set forth scientifically the nature of the product so far as its elemental and chemical nature is concerned, he has demonstrated beyond question that the product is far more effective than can be attained otherwise. Hence to anticipate such claims as claim 2, and such process claims as are restricted to the time limit during which the rosin must be heated, the prior art should disclose either a definite time during which rosin is heated or an equivalent of such heating, neither of which appears in the art cited. Claim 5, for example, is limited to the process including mixing and stirring while the shellac and rosin are in a plastic state, this latter limitation resulting as an inevitable necessity to enable the stirring. This step of stirring undoubtedly effects certain elemental changes which could not be attained otherwise, and the step seems to be missing from anything seen in any of the patents cited. The patent to Tanner discloses merely the mixing of sulfur with emery with the possible addition of rosin, but there is no suggestion of the proportionate amount of rosin, and no suggestion that the rosin is heated or maintained molten for

a definite time, or that the parts are stirred while mixed. There is, therefore, in this patent no disclosure of the claimed invention, and while the two foreign patents, as have been suggested, set forth a great variety of elements, they do not set forth anything sufficiently definite and distinct to enable the public to secure the benefits of the invention set forth in the present application, and, therefore, it is believed that the claims as now presented should certainly receive favorable consideration.

Favorable consideration of new claim 9 is requested for the same reasons as set forth in respect to the present claim 4, formerly claim 7, and an early and favorable action is requested.

Respectfully submitted,

JOHN F. DOE,
Attorney for Roe.

Div. 27, Room 375

Paper No. 4 Rej.

DEPARTMENT OF THE INTERIOR
UNITED STATES PATENT OFFICE

Washington, August 7, 1912.

Richard E. Roe,
c/o John F. Doe,
McGill Bldg.,
Washington, D. C.

Please find below a communication from the Examiner in charge of your application.

Manufacture of Polishing stones, filed April 3, 1912, Serial No. 688,284.

E. M. MOORE,
Commissioner of Patents.

Response to amendment filed July 23, 1912.

Claims 1 and 2 are in substance alike, and they, as well as claim 3, are met in the English patent No. 2289 of 1853, of record.

Claim 4 is met in the patents of record in view of the common practise to place sulfur in compounds for polishing stones, as shown by the patents to Mayall, No. 24039, May 17, 1869, in Cl. 51-1, and for the reason that it is stated in the specification that sulfur may or may not be used, and that it is not a necessary feature of the invention.

Claims 5, 6, 7 and 8 are in substance alike, and are met in the English patent No. 2289 of record.

Claim 9 is met in the English patent, No. 2289, for the reason given in rejecting claim 4.

Examiner.

IN THE UNITED STATES PATENT OFFICE

Richard E. Roe,
Manufacture of Polishing Stones,
Filed April 3, 1912,
Serial No. 688,284,
Last Office Letter Aug. 7, 1912.

Room 375.

Hon. Commissioner of Patents,
Washington, D. C.

Sir:

Responsive to the above mentioned Office letter, please amend as follows:—

Cancel claim 2, and accordingly adjust the ordinals of the remaining claims.

Reconsideration of the claims is requested for the reason that the British patent cited fails to disclose the compound or the process for producing the same in its specific nature as outlined in the claims presented, and for the further reason, with respect to those claims limited to the use or presence of sulfur, that applicant unquestionably has the right to present claims embodying both the combination as an entirety and certain sub-combinations.

As to the first ground for the request for consideration, attention is directed to the fact that claim 1 calls for a product, which product is a compound of certain elements not merely juxtaposed, but effectively compounded in a particular and specific manner peculiar to the invention, and not suggested in the British patent cited. That is to say, the structure set forth in claim 1 is limited to materials which have been treated in a specific

manner, namely, rosin which has been heated for two hours, and to the other elements named mixed with the product of such rosin. Nothing in the British patent cited suggests heating any of the substances named in that patent for any definite period. Applicant is able to produce a stone possessing at one and the same time, the requisite tensile strength with the requisite abrasive capacity, neither of which is by any means assured in a product produced from an effort to follow any such vague instructions as are afforded in the British patent. Applicant would not think of contending that it was a new thing to use emery-powder as an element of a compound for a grinding stone, nor would he think of making such contention with respect to shellac or with respect to rosin, and it is not the separate and distinct elements taken alone which make a novel structure of applicant's claimed invention, but it is the combination of all those elements, effected in the manner set forth, which gives the result not attained by the mere assembling of a conglomerate mass of substances, such as listed in the British patent. In other words, the British patent does not afford sufficient information to enable one to produce the stone set forth in the first claim, which stone can be produced only by the assembling of the elements named in the claim after the treatment of rosin in the manner stated in the claim.

The same argument is applicable to claim 2, even with more force, for the composition of matter therein claimed is limited to the precise proportions of elements depended upon for giving the most efficient results, and such proportions vary from anything suggested in the British patent, which added to the fact that the claim is limited to the rosin being a product of rosin, after being heated for two hours, would seem to unquestionably entitle applicant to the allowance of this claim. Vague and indefinite statements in prior patents, which are insufficient to enable a production of the compound or article set forth specifically in a given claim, are not sufficient to anticipate the claim because the claim recites one specific and particular thing, and the reference does not disclose that thing or any other one thing sufficiently definitely to enable the public to deduce information sufficient to produce the claimed thing. Hence, the lack of disclosure as well as the difference in the subject-matter of disclosure in the British patent, is such that the Examiner is requested favorably to reconsider this claim.

With respect to claim 3, the same argument as to the patentable novelty of claim 2 applies, and reconsideration is requested for the same reason, and for the further reason that the claim is limited to the use of sulfur, the use of which in other combinations, such as that of the Mayo patent cited, is certainly

not sufficient to justify anticipation of the claim. To accept the Examiner's apparent theory of rejection would be paramount to admitting it proper under the rules of law to take, in mechanical cases, an element from one machine, another element from another machine, and a third element from a third machine, and so on, and by assembling them after the manner shown in the invention in question, call the resultant assemblage an anticipation. The courts have severely, repeatedly, and continuously condemned this practise, and the practise in mechanical cases is directly analogous to composition or chemical cases, so that the Examiner has no right to select a given chemical from one compound, and another from a different compound and so on throughout a series of compounds, so that they may be united to form a reference for the compounding of these various segregated chemicals, which in itself effects a result not obtained in any of the several compounds from which the respective chemicals have been segregated, with the result that the alleged reference is in fact the product of invention. Hence it is thought that favorable action should be accorded claim 3, so far as the use of sulfur is concerned.

On the question of applicant's right to present such claim, the Examiner seems to be clearly and unequivocally in error in view of the common and uniform practise of presenting various combination claims in a given patent in mechanical cases. By way of example, an inventor of a peculiar hinge would undoubtedly be entitled to a claim for a hinge having an eye in combination with other elements, and in the same patent would be entitled to a claim for a hinge having eyes in combination with other elements, even tho the plurality of eyes might possibly be capable of being dispensed with, and even tho it might be conceded in the specification that a hinge possessed of a single eye would perform some of the valuable functions of the invention. In other words, the fact that a certain element or elements of the combination may be possibly dispensed with, and still a sufficient number of elements retained to afford some valuable results, so that the dispensed elements may be said to be unnecessary in the sense that they are not absolutely requisite, does not preclude an applicant of the right to a claim for those elements which might be dispensed with, so long as those elements actually add something of value to the combination. The fact that sulfur is not a necessary feature of the combination does not mean that sulfur is not an extremely desirable feature thereof, and being desirable may be very properly included in a combination claim presenting the desirable feature as well as the absolutely necessary feature, just the same as applicant would be entitled to the hinge with the two eyes, if the second

eye added any special function over a claim for the same hinge with a single eye.

Reconsideration of the Examiner's holding that claims 4, 5, 6 and 7 (formerly 5, 6, 7 and 8) are alike is requested for the reason that apparently each distinguishes clearly and affirmatively from all others.

Reconsideration of these claims, and also of claim 8, on the question of patentability over the English reference is requested for the reasons set forth in respect to the claim 1, the distinction in the product over the disclosure of said patent being even more pronouncedly apparent in the process.

Respectfully submitted,

JOHN F. DOE,
Attorney for Roe.

September 12, 1912.

Div. 27, Room 375

Paper No. 6 Rej.

DEPARTMENT OF THE INTERIOR
UNITED STATES PATENT OFFICE

Washington, Sept. 28, 1912.

Richard E. Roe,
c/o John F. Doe,
McGill Bldg.,
Washington, D. C.

Please find below a communication from the Examiner in charge of your application—

Manufacture of Polishing Stones, Filed April 3, 1912,
Serial No. 688,284.

E. B. MOORE,
Commissioner of Patents.

Response to amendment filed September 14, 1912.

The English patent discloses a composition of shellac, rosin, and emery. The shellac and rosin are heated in a vessel until the mixture is fused, then emery is added. The mixture is thoroughly mixed and incorporated while hot, and then placed in metallic molds of requisite form and dimensions. The steps

disclosed in the English patent in preparing the composition are the same as disclosed by applicant.

No reason is seen for changing the last Office action.

The claims are thought to be fully anticipated by the references of record, and are again rejected.

Examiner.

IN THE UNITED STATES PATENT OFFICE

Richard E. Roe,
Manufacture of Polishing Stones,
Filed April 3, 1912,
Serial No. 688,284,
Last Office Action
September 28, 1912.

Room 375.

Hon. Commissioner of Patents,
Washington, D. C.

Sir:—

Responsive to the above noted Office action, please amend the application as follows:

Cancel the claims and insert—

1. A composition of matter for forming polishing stone, consisting of emery-powder, shellac, and the product resulting from the heating of rosin for about two hours.

2. A composition of matter for forming polishing stone, consisting of one part emery-powder, three parts shellac, and two parts of the product resulting from the heating of rosin for about two hours.

3. A composition of matter for forming polishing stone, consisting of one part emery-powder, three parts shellac, two parts rosin, and a relatively small quantity of sulfur.

4. The process of manufacturing polishing stone, comprising heating two parts of rosin for about two hours, then melting about three parts shellac and adding the same to the rosin, then adding one part emery-powder to the mass while stirring the same and adding a relatively small quantity of sulfur, and finally casting the mass.

REMARKS

The claims have been rewritten, not to vary the scope thereof, but to avoid possible confusion from the several amend-

ments, and particularly from the fact that in one of the amendments instructions were given both to cancel a particular claim and to adjust the ordinal of the claim.

Counsel believes that favorable reconsideration should be accorded the claims above presented for the reason that the British patent does not disclose the use of sulfur. It does not disclose the heating of the rosin for two hours. It does not disclose the stirring of the mass when mixing while heated. It does not disclose the relative proportions named. And it does not disclose mixing or compounding the particular ingredients independent of all other ingredients.

Applicant has, by the elimination of an undesirable mass of indefinite selective substances such as mentioned in the British patent, produced a definite and precise product in a peculiar and particular manner, getting results not attainable by the employment of the conglomeration suggested in the British patent, and obtainable only by the exercise of inventive genius in the utilization of substances incidentally named in the said patent. It is certainly a well-settled principle of law that the Examiner has no right to use as a reference the disclosure of a mass of substances, so intricate and involved that no definite or adequate idea of which particular substances could be effectively used for giving a definite and particular result. Applicant was able to particularize only by careful study and long experiment and was able to produce an effective and desirable product not through any information obtainable from the publication cited, but by virtue of studious effort and constant application. The elimination of unnecessary ingredients as named in the British patent, and the substitution therefor of definite proportions, has enabled applicant to obtain his product, and without such elimination no such product could be obtained. It is therefore believed that what applicant did amounts to invention and the claims presented represent patentable subject matter.

It is thought that the Examiner errs in holding that the British patent discloses the steps utilized by applicant. The steps differ as to time, degree, quantity and substances. Greater differences are inconceivable so long as these differences produce differences in result, and of this fact there ought not be question in view of the obvious utility of the product obtained in applicant's compound.

Favorable action on the claims is therefore earnestly requested.

Respectfully submitted,

JOHN F. DOE,
Attorney for Applicant.

October 30, 1912.

Div. 27, Room 375

Paper No. S. F. R.

DEPARTMENT OF THE INTERIOR
UNITED STATES PATENT OFFICE

Washington, Nov. 15, 1912.

Richard E. Roe,
c/o John F. Doe,
McGill Bldg.,
Washington, D. C.

Please find below a communication from the Examiner in charge of your application—

Manufacture of Polishing Stones, Filed April 3, 1912,
Serial No. 688,284.

E. B. MOORE,
Commissioner of Patents.

Response to amendment filed October 31, 1912.

The claims are met in the references and reasons given in last office letter, and are rejected.

The claims being in substance the same as those previously rejected, this action is final.

Examiner.

IN THE UNITED STATES PATENT OFFICE

Richard E. Roe,
Manufacture of Polishing Stones,
Filed April 3, 1912,
Serial No. 688,284,
Last Office Action
November 15, 1912.

Room 375.

Hon. Commissioner of Patents,
Washington, D. C.

Sir:—

Responsive to the above noted Office action, please amend the application as follows:

At the end of page 4 add the following:

By experimentation I have demonstrated that the above theory regarding the volatilization of substances from the rosin by maintaining the same in a molten condition is correct, as I have, by boiling rosin for a period of two hours more or less, found that I have been able to drive off a certain oily substance, by which I largely eliminate the production of a gummy compound, as usually results from the employment of rosin from which the oily substance or other impurities have not been volatilized. As a matter of demonstration, I have boiled rosin for a period approximating two hours, varying with the grade of rosin employed, and have otherwise carried out the process as above stated, with the result that a polishing stone has been produced capable of giving the finishing polish and starting the gloss on marble. On the other hand, I find that the mere melting of rosin, without volatilization therefrom of the foreign substances, and the making of the stone by the employment of rosin with an abrasive compound, which rosin has only been melted, results in the production of a stone having a tendency to gum and adhere to the marble, producing smears and spots, which difficulties I have been able to overcome by the carrying out of the process as above set forth.

While there is no exact or definite period of time during which the rosin must be boiled, I find that approximately two hours is the correct time, and the best simple method of testing whether the volatilization has been carried out to the required extent is by the introduction of a small stick into the molten mass, and the withdrawal of the stick and cooling of the adhering rosin. Preferably the cooling for this test is accomplished by pouring cold water on the rosin-coated stick. When cold, if the coating is hard enough to break easily when the stick is bent, the vola-

tilizing process has been carried out sufficiently, but if when the stick is bent the coating of rosin appears gummy and pliable, then the heating process must be continued until the requisite extent of brittleness is attained. This is obviously only one simple test, and other tests may be utilized as preferred, the essential feature of the process, so far as the treatment of the rosin is concerned, residing in the fact that the rosin is heated to the volatilizing point and maintained at such point for a length of time giving it a consistency which will avoid the tendency on the part of the completed stone to spot or otherwise discolor the marble being polished or glossed.

Cancel claim 5 and insert:

5. The process of manufacturing polishing stone comprising mixing molten rosin, shellac and emery, the rosin being, previously to the admixture, heated to and maintained at a temperature of volatilization for a period sufficient for rendering the finished stone free from spot-producing plasticity.

AFFIDAVIT

State of Vermont }
County of Rutland } ss.

Richard E. Roe, the applicant named in the above entitled application, being first duly sworn, deposes and says that he is familiar with the various known processes of manufacturing polishing- and gloss-stones for finishing marble; that it has heretofore been common to produce such stones by the employment, among other ingredients, of rosin which has been commonly melted and mixed with the other ingredients, but stones thus produced have given rise to difficulties by virtue of the fact that they usually produce spots and smears on the marble or other stone being polished and glossed; that such spotting affiant has ascertained has been due largely to adhesion of the rosin because of its pliable and adhesive nature; that affiant in the carrying out of his process as set forth in the above identified application has found that by maintaining rosin heated sufficiently for volatilizing foreign substances therefrom for a period of about two hours, or until such foreign substances are substantially all volatilized, the bulk of the rosin is reduced approximately twelve per cent and the resultant rosin is characterized by its brittleness; that when such rosin is compounded with powdered emery and shellac the resultant product is a stone which will finish the polishing of a piece of marble and begin the gloss thereof without producing spots or smears on such marble; and that a simple and efficient test for determining whether the rosin has been

maintained at the volatilizing point for a sufficient length of time consists in cooling a small quantity of rosin on a flexible or resilient support and bending the support, whereupon, if the rosin has acquired the proper degree of density, its brittleness will be manifest by the breaking of the rosin, but if the volatilization has not been carried out sufficiently such condition will be indicated by the lack of breaking of the rosin and the manifest pliability thereof.

RICHARD E. ROE,

Subscribed and sworn to before me this 24th day of April, 1913.

.....
Notary Public,
 Rutland Co., Vermont.

REMARKS

The foregoing amendment is presented solely for the purpose of appeal, and applicant will prosecute the appeal just as soon as the amendment is entered. It is hoped that the Examiner will not object to the slight alteration in the terms of claim 5, this alteration having been made to more clearly bring out the distinction which counsel contends exists between all of the claims and the prior art cited. It is noted that the final action was taken by the Examiner in the face of the fact that new claims were presented, on the ground that the new claims were substantially the same in substance, and it is hoped, therefore, that recognizing the similarity in substance the Examiner will not object to the entry of the foregoing amendment.

While counsel would not urge the Examiner to reconsider his previous action of final rejection, he is requested to reconsider the same, if he is so inclined, in view of the affidavit herewith filed which may help to throw light on the contention which counsel has been making to the effect that the references cited all embody merely generic disclosures of processes, which in their specific adaptations are very probably essentially different from that claimed, and most certainly do not include the one essential step of volatilizing foreign substances from the rosin and maintaining the rosin at such heat as to continue

the volatilization until the rosin acquires a distinct and desirable state of density, freeing the same from the objectionable smearing effect which frequently follows with the use of stones the rosin in which has not been so treated. The accompanying affidavit makes this point clear and it is believed to be proper at this time to submit the affidavit in order that when the case goes before the Board of Examiners-in-Chief all of the facts may be readily recognized as established in the record, thus avoiding any necessity for the filing of proofs after appeal.

Respectfully submitted,

JOHN F. DOE,
Attorney for Applicant.

Div. 27, Room 375

Paper No. 12.

DEPARTMENT OF THE INTERIOR
UNITED STATES PATENT OFFICE

Washington, June 14, 1913.

John F. Doe,
McGill Bldg.,
Washington, D. C.

Please find below a communication from the Examiner in charge of the application of

Richard E. Roe, for Manufacture of Polishing Stones,
Filed April 3, 1912, Serial No. 688,284.

E. B. MOORE,
Commissioner of Patents.

Response to amendment filed April 26, 1913.

Claims 1, 2, and 5 are met in the English patents to Hannay, of record, and 2193, Coles, Aug. 2, 1862.

Claims 3 and 4 are met by Coles.

The claims are met in the references cited in the last Office action and are rejected.

Examiner, Div. 27.

IN THE UNITED STATES PATENT OFFICE

Richard E. Roe,
Manufacture of Polishing Stones,
Filed April 3, 1912,
Serial No. 688,284,
Last Office Letter
June 14, 1913.

Room 375.

Hon. Commissioner of Patents,
Washington, D. C.

Sir:—

In response to the above mentioned Office letter, please amend as follows:

Claim 1, line 3, after "rosin" insert—*to the volatilization point*—.

Claim 2, line 4, after "rosin" insert—*to the volatilization point*—.

Cancel claim 3, and insert:

3. A composition of matter for forming polishing stone consisting of emery-powder, shellac, and rosin, from which rosin spot-producing matter has been removed.

Claim 4, line 2, after "rosin" insert—*to the volatilization point*—.

REMARKS

Reconsideration of all the claims is requested for the reason that the essential feature of the invention is obviously absent from the art cited. Both the time, and the degree of heat to which the rosin is subjected, are essential characteristics of the invention. As the prior art has failed to disclose or suggest a means for obviating the spot-producing propensity of polishing or finishing stone such does not anticipate the claims and on receipt of final action on the claims as now submitted appeal will be promptly taken.

Respectfully submitted,

JOHN F. DOE,

Attorney for Roe

June 20, 1913.

Div. 27, Room 375.

Paper No. 14. Rej.

DEPARTMENT OF THE INTERIOR
UNITED STATES PATENT OFFICE

Washington, July 10, 1913.

John F. Doe,
McGill Bldg.,
Washington, D. C.

Please find below a communication from the Examiner in charge of the application of—

Richard E. Roe, for Manufacture of Polishing Stones.
Filed April 3, 1912, Serial No. 688,284.

E. B. MOORE,
Commissioner of Patents.

Response to amendment filed June 21, 1913.

Claims 5 and 6 are in substance alike. All the claims are met in the reference of record, and are finally rejected.

Examiner.

IN THE UNITED STATES PATENT OFFICE

Richard E. Roe,
Manufacture of Polishing stone,
Filed April 3, 1912,
Serial No. 688,284.

APPEAL FROM THE PRINCIPAL EXAMINER
to the
EXAMINERS-IN-CHIEF

Hon. Commissioner of Patents,
Washington, D. C.

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 Manufacture of Polishing Stones, filed April 3, 1912, Serial No. 688,284, which on the 10th day of July, 1913, was rejected a second time and finally.

The following are the points of the decision on which appeal is taken:

1. The Examiner erred in holding the rejected claims anticipated by the art cited.

2. The Examiner erred in finally rejecting the last submitted claims.

The appeal fee of Ten Dollars is enclosed herewith.

RICHARD E. ROE,

By John F. Doe,

His Attorney.

August 20th, 1913.

18.

Paper No. 18.

DEPARTMENT OF THE INTERIOR
UNITED STATES PATENT OFFICE

September 18, 1913.

Richard E. Roe,

Manufacture of Polishing Stone,

Filed April 3, 1912,

Serial No. 688,284.

} On Appeal
to the Board of
Examiners-in-Chief.

EXAMINER'S STATEMENT.

The following claims are appealed:

1. A composition of matter for forming polishing stone, consisting of emery-powder, shellac, and the product resulting from the heating of rosin to the volatilization point for about two hours.

2. A composition of matter for forming polishing stone, consisting of one part emery-powder, three parts shellac, and two parts of the product resulting from the heating of rosin to the volatilization point for about two hours.

3. A composition of matter for forming polishing stone, consisting of emery-powder, shellac, and rosin from which rosin spot-producing matter has been removed.

4. The process of manufacturing polishing stone comprising heating two parts of rosin to the volatilization point for about two hours, then melting about three parts shellac and adding the same to the rosin, then adding one part emery-powder to the mass while stirring the same and adding a relatively small quantity of sulfur, and finally casting the mass.

5. The process of manufacturing polishing stone comprising mixing molten rosin, shellac and emery, the rosin being, previously to the admixture, heated to and maintained at a temperature of volatilization for a period sufficient for rendering the finished stone free from spot-producing plasticity.

6. The process of manufacturing polishing stone comprising heating rosin to and maintaining it at a temperature of volatili-

zation for a period sufficient to render the finished stone free from spot-producing plasticity, then mixing with such molten rosin, shellac and emery, and straining the mixture for freeing the same from remaining impurities.

The claims were rejected upon the following patents:

Mayall,	24,039,	of May 17, 1869,
English Patents	1,615	of 1856, Fisher,
"	"	2,889 of 1853, Hannay, and
"	"	2,193 of 1862, Coles et al. (Cl. 51—1).

The claims cover a composition for a polishing stone and the process of making the same. The composition consists of emery-powder, shellac and rosin, and as stated in the specification a small quantity of sulphur, may or may not be used. The rosin is melted and heated for two hours, then the rosin is added to a proper quantity of shellac, the mixture is then strained, after which the emery-powder is added, and a pinch of sulfur may or may not be added.

The patent to Coles discloses a grinding tool consisting of pulverized gritty or cutting ingredients with a preparation of oxydized or other oil and sulfur, with or without the addition of resinous, gummy, mucilaginous or albuminous matter. See lines 21 to 23, page 3.

The patent to Mayall shows that the use of sulfur in polishing stones is old.

The patent to Fisher discloses a grinding tool consisting of corundum mixed with plastic or glutinous substances, such as rosin, oil, shellac, Venice turpentine, etc., reduced to a melted state, forming, when cold, a hard substance.

The patent to Hannay discloses a grinding-wheel made by mixing shellac with rosin to which heat is applied so that the mixture is well fused, then about two and one-half to three times the weight of the mixture is to be added of emery or other grinding substance. The grinding substance is heated to a temperature as high as that of the mixture which forms the bond. The whole is thoroughly mixed and incorporated while hot and while in the heated or soft state is placed in suitable molds. See lines 5-7 and 25-35, page 2 of the specification.

As the patents cited disclose a composition of shellac, rosin and emery, the shellac and rosin being heated in a vessel until the mixture is fused, then emery added, it is thought that they fully anticipate applicant's composition of matter set forth in claims 1, 2 and 3, and the process set forth in claims 4, 5 and 6.

Respectfully submitted,

.....
Examiner.

DEPARTMENT OF THE INTERIOR
UNITED STATES PATENT OFFICE

Washington

September 20, 1913.

Sir:

The case of Richard E. Roe
Serial No. 688,284, will be heard by the Examiners-in-Chief on
the 15th day of December, 1913.

The hearings will commence at one o'clock, and as soon as
the argument in one case is concluded the succeeding case will
be taken up.

If any party, or his attorney, shall not appear when the case
is called, his right to an oral hearing will be regarded as waived.

The time allowed for arguments is as follows:

Ex parte cases, thirty minutes;

Motions, thirty minutes, each side;

Interference appeals, final hearing, one hour each side.

By special leave, obtained before the argument is commenced,
the time may be extended.

The appellant shall have the right to open and conclude in in-
terference cases, and in such case a full and fair opening must
be made.

Briefs in interference appeals must be filed in accordance with
the provisions of Rule 147.

Respectfully,

THOMAS EWING,

Commissioner of Patents

To John F. Doe, Atty.,
McGill Bldg.,
Washington, D. C.

IN THE UNITED STATES PATENT OFFICE

Richard E. Roe,
Manufacture of Polishing Stone,
Filed April 3, 1912,
Serial No. 688,284.

On Appeal
Before the Board of
Examiners-in-Chief.

APPELLANT'S BRIEF

[Here follows a complete restatement of the arguments ad-
vanced before the Primary Examiner. The brief was divided

for intelligent discussion of the whole case under the following headings:

The Invention.
The Examiner's Concession of Novelty of
Driving Off Spot-Producing Matter.
The Claims.
Conclusion.

To reiterate the arguments would add nothing to this work and such is therefore not done.]

Revision and reversal of the judgment of the Primary Examiner are accordingly earnestly requested.

Respectfully submitted,
JOHN F. DOE,
Attorney of Record.

October 11, 1913.

DEPARTMENT OF THE INTERIOR
UNITED STATES PATENT OFFICE

Washington

February 28, 1914.

Sir:

Inclosed find copy of decision this day rendered by the Examiners-in-Chief in the ex parte case of—

Richard E. Roe, Serial No. 688,284.

By direction of the Commissioner:

Very respectfully,
W. F. WOOLARD,
Chief Clerk.

Mr. John F. Doe, Atty.,
McGill Building,
Washington, D. C.

UNITED STATES PATENT OFFICE

Appeal No. 6843.

Feb. 28, 1914.

Before the Examiners-in-Chief, on Appeal.

Application of Richard E. Roe for a patent for an improvement in the Manufacture of Polishing Stones, filed April 3, 1912, Serial No. 688,284.

Mr. John F. Doe, attorney for appellant.

The applicant has appealed from the action of the Primary Examiner finally rejecting the following claims:

[Here follow the claims appealed.]

The references cited are:

Mayall		24,039, May 17, 1869,
Hannay,	British	2,889, of 1853,
Fisher,	"	1,615, of 1856,
Coles, et al.	"	2,193, of 1862.

We do not understand that the Examiner contends that any of the references suggest the heating of the rosin for a period of two hours or thereabouts. Nor do we understand that the Examiner questions the useful results which are alleged in the amended specification and affidavit of record as attendant upon such heating. Under such circumstances it would seem that claims 1, 2, and 4, which are limited to the heating of the rosin for two hours or thereabouts are clearly allowable.

Claims 3, 5 and 6 are not limited to the heating of the rosin for a period of two hours or thereabouts. They set forth no definite minor limit for the period of heating. Claims 5 and 6 state that the rosin shall be made free of spot-producing characteristics by heating the same. Claim 3 states that spot-producing matter shall be removed, but is not limited to any characteristic whatsoever of the manner in which the removal of the spot-producing matter is secured. Under all the circumstances of the case we believe that the applicant is not entitled to these claims. In the first place, his application does not teach or even suggest any other way of removing the spot-producing matter than by heating the rosin for about two hours. In the second place, it is not established on the record and we are not aware that such heating of the rosin as is provided for in the various references will not, under certain circumstances, or with certain qualities of rosin, result in a product which is free from spot-producing characteristics.

The action of the Primary Examiner is reversed as to claims 1, 2, and 4, and is affirmed as to claims 3, 5, and 6.

FAIRFAX BAYARD,
FRANK C. SKINNER,
Examiners-in-Chief.

(Third member absent.)

XVII

A TYPICAL REISSUE PATENT APPLICATION FILE WRAPPER CONTENTS AND DRAWINGS*

Hon. Commissioner of Patents,
Washington, D. C.

Sir:—

In the matter of application of Richard E. Roe, for reissue of Letters Patent No. 1,063,268, filed herewith, we request that an abstract of title duly certified as required in such cases be furnished and attached to said application.

Reissue fee of thirty dollars (\$30.00) and twenty cents for said abstract are remitted herewith.

Respectfully,

DOE & DOE,
Attorneys for Roe.

PETITION

To the Commissioner of Patents:

Your petitioner, RICHARD E. ROE, a citizen of the United States and resident of Milwaukee, in the county of Milwaukee and State of Wisconsin, whose post-office address is Germania Building, Milwaukee, Wisconsin, prays that he may be allowed to surrender the Letters Patent for an improvement in CONCRETE-DISTRIBUTER, granted to him June 3, 1913, whereof he is now sole owner, and that Letters Patent may be reissued to him for the same invention upon the annexed amended specification, and he hereby appoints MESSRS. DOE & DOE, Southern Building, Washington, D. C., Registry No. 7987, his attorneys, with full power of substitution and revocation, to prosecute this application, to make alterations and amendments therein, to receive the patent when reissued, and to transact all business in the Patent Office

* See File Wrapper U. S. Patent to Kochring, Reissue No. 13617, September 16, 1913.

and U. S. Courts connected therewith, hereby revoking any and all former powers of attorney given in connection with the original application.

An abstract of title, duly certified as required in such cases, has been ordered from the Patent Office and it is requested that it be attached hereto.

Signed at Milwaukee, county of Milwaukee, and State of Wisconsin, this day of , 1913.

RICHARD E. ROE.

S P E C I F I C A T I O N

To all whom it may concern:

Be it known that I, PHILIP A. KOEHRING, a citizen of the United States, residing at Milwaukee, county of Milwaukee, and State of Wisconsin, have invented new and useful Improvements in Concrete-Distributers, of which the following is a specification.

The object of my invention is, more especially among other things, to provide a device to be used in laying walks and street pavements in connection with a concrete mixer for receiving the mixed concrete as it is discharged from the mixing drum and conveying it to the place of deposit in the walk or pavement which is being laid, and the same is explained by reference to the accompanying drawings, in which,

Figure 1 represents a side view thereof in connection with the supporting frame of an ordinary concrete mixing machine. Fig. 2 is a detail showing an end view of the cable operating mechanism by which the conveyor of concrete is operated. Fig. 3 is a diagrammatic view in perspective of the cable supporting rollers and pulleys which are employed in moving the conveyor. Fig. 4 is a detail plan of the turn-table and operating mechanism. Fig. 5 is a top view and Fig. 6 a vertical section of the concrete receptacle. Fig. 7 is a side view of the discharge-controlling operating device.

Like parts are identified by the same reference numerals throughout the several views.

1 is an ordinary concrete mixing drum, and 2 represents a portion of the end frame from which the drum is supported in connection with my concrete conveyor.

3 is a swinging jib or boom which is provided upon its side with a track 4 upon which the carriage 5 is supported and operated, said jib and its supporting parts including the frame 2 constituting a crane of special design.

6 is a receptacle into which the concrete is discharged from the drum 1 through the stationary trough 7. The receptacle 6 is connected with the inwardly canted

or inclined carriage 5 through the vertical hangers 8, and the carriage 5 is provided with a plurality of rollers 9 adapted to operate on the track 4 as the receptacle 6 is moved forwardly and backwardly along the boom 3 from the mixing drum to the place of deposit. This operation is permitted because

the form of the carriage 5 is such that the receptacle 6 may readily be moved to the position below the axis of the boom 3 and the delivery end of the trough 7. The boom 3

is supported from the vertical frame 2 through the bracket 10, trunnion 11, turntable 12, vertical lugs 13 and pivotal bolt 14. The trunnion 11 is supported at its lower end from the bracket 10, while its upper end is centrally connected with the turntable 12 with which trunnion the turntable performs a partial revolution as the boom 3 is swung to the right and left. The receptacle 6 which is adapted to be moved longitudinally on said track 4 may be brought to any desired point of deposit within the radius described by said swinging boom

15 is a worm shaft which is revolubly supported in suitable journal bearings on said bracket 10 and is adapted to engage in the teeth 16 formed in the edge of the turntable 12, whereby as the shaft 15 is turned forwardly or backwardly, the turntable 12 and the boom 3 supported therefrom are caused to describe a partial revolution to the right or left.

17 is an operating crank, which is rigidly connected with the worm shaft 15 by which the same is manually operated. While the

worm shaft 15 may be manually operated with a crank, a belt or pulley, or equivalent mechanism may be substituted therefor.

19 is a cable by which the carriage 5 and receptacle 6 supported therefrom are drawn forwardly and backwardly upon the boom. One end of said cable 19 is connected with the carriage 5 at the point 20, and it extends from thence around the outer end of the boom and passes over and upon the pulley 21 from thence around the pulley 22, from thence over the drum 23 and from thence backwardly and forwardly between the drum 23 and drum 24 around which drums it passes a plurality of times whereby the required friction is produced between said cables and the drum 24 to prevent it from slipping, when the cable passes from the pulley 23 partially around the pulley 25, from thence around the pulley 26 and from thence to the other side of the carriage 5 with which it is connected at the point 27. The pulleys 22, 25 and 26 have journal bearings in plates secured to the boom 3 at its rear end.

The drum 23 has journal bearings in the hangers 44, which hangers are suspended from the upper end of the frame 2, while the drum 24 has journal bearings in the bracket 41, and said bracket is supported from said frame 2. Thus it is obvious that as said cable is moved in one direction by revolving the drum 24, the carriage 5, together with the receptacle 6 will be moved to the outer end of the boom 3, when by a reversed movement of the drum 24 the cable 19 will be

moved in the opposite direction, whereby the receptacle 6 will be drawn back from the outer end of the boom to the point shown in Fig. 1, beneath the discharge end of the trough 7. From the foregoing it will be understood that by the swinging movement of the boom and the

horizontal movement of the carriage along such boom the receptacle 6 may be conveyed to and its contents discharged at any point within the radius described by the boom.

Motion is communicated from the mixing drum 1 to the cable 19 either forwardly or backwardly through the gear wheel 28, pinion 29, shaft 30, pinion 31 and reversely revoluble gears 32 and 33 and the drum supporting shaft 34. The gears 32 and 33 are adapted to revolve freely upon their supporting shaft 34, and motion is communicated from either one of said gears 32—33 to the drum 24 at the will of the operator through the clutch mechanisms 35 and 36. The clutch mechanisms 35 and 36 are respectively connected with the supporting shaft 34 and adapted to revolve therewith. When, however, the clutch mechanism is brought into engagement with either one of said gears 32—33, motion is communicated from said gears through said clutch mechanism to said shaft 34, and from said shaft to the drum 34', whereby said drum is revolved. When the clutch mechanism 36 upon the right is clamped to the gear wheel 33, the drum 34' is revolved in one direction. When, however, the clutch mechanism 35 upon the left is brought into engagement with the gear 32, the drum 34' is revolved in the opposite direction. When, however, both clutches are thrown out of engagement with said gears, the drum is permitted to stand at rest. Thus it will be obvious, that while the driving shaft 30 and gears 32 and 33 are continuously revolved in the same direction, the drum 34' and the cable operated thereby, may be at the will of the operator, be moved in either direction or permitted to stand at rest.

37 and 37 are slidable collars supported upon the shaft 34, and said collars are provided with outwardly diverging bearings 38—38, which are adapted to contact with the arms 39—39 of the clutch mechanism as

said collars are moved inwardly, whereby said clutch mechanism is operated and caused to impinge against the bearings of said gears 32 and 33. The collars 37 are respectively provided with radial flanges 39'—39' formed for the reception of the operating levers 40. The operating levers 40 are pivotally connected to the bracket 41 by the bolts 42, while the free ends of the levers serve as handles for operating said clutch mechanisms.

To produce the required tension and friction of the operating cable 19, the upper drum 23 is adjustably supported from the upper end of the frame 21 through the shaft 43, vertical hangers 44—44, movable journal bearings 45 and adjustable screws 46, which adjustable screws 46 have threaded bearings in the lower ends 47 of said hangers 44, whereby by turning said screws 44 upwardly and downwardly the tension of the cable 19 may be increased or diminished at pleasure.

The outer end of the boom 3 is supported at any desired angle or elevation above its pivotal support 14 by the cable 48, one end of said cable being connected with the outer end of the boom through the bracket 49 and bolt 50, when it passes from thence over the pulley 51 and from thence over the pulley 52, and from thence to the drum 53. The pulley 51 is connected with the top of the frame 2 through the bracket 54, pivotal bolt 55, link 60 and pivotal bolt 61, while the pulley 52 is connected with the outer end of the boom through said bracket 49 and bolt 50, the drum 53 being centrally supported from and connected with the boom 3 through the bracket 62 and drum supporting bolt 63. 64 is a crank by which the drum 53 is revolved. 66 is a ratchet wheel connected at one end to said drum, and 67 is a pawl operating on said ratchet wheel and serves to hold the drum at any desired point of adjustment. The pawl 67 is piv-

otally supported at its lower end from the boom 3 upon the bolt 68, and its upper end is adapted to engage the teeth of said ratchet. Thus it will be understood that when desirous to raise the outer end of the boom the crank 64 is revolved from left to right, whereby the cable 48 will be wound upon the drum 53 until the boom is brought to the desired point of adjustment, when it will be retained at such point by the drum retaining pawl 67. By the reversed movement of the crank 64, the cable 48 is slackened and the boom 3 is lowered.

For convenience in discharging the contents of the receptacle 6, the bottom of said receptacle 6 is formed in two parts 68—68, which are pivotally connected with the sides of the receptacle by the bolts 69—69, and the opposing edges of said bottom members are supported in their closed position from the carriage 5 through the rods 70, bolt 71, link 72, bolt 73, crank arm 74 and shaft 75.

76 is a crank by which the shaft 75 is turned in its bearings. When the crank 76 is in the position shown in Fig. 1, the bottom members 68—68 are retained in their closed position. When, however, the crank 76 is turned toward the right, the crank arm 73 is carried past the vertical above the shaft 75, when it is permitted to turn beneath said shaft, whereby the bottom members 68—68 are moved from their closed to their open position, when the contents of the receptacle 6 is permitted to flow therefrom to the place of deposit.

Having thus described the invention, what I claim as new is:

1. In a device of the described class, the combination of a vertical frame, a *boom* pivotally supported near one end from said frame, *manually actuated means for revolving said boom* a partial revolution about its pivotal support, a track carried by the boom, a carriage mounted upon said track, *a cable operating along said boom and connected with the carriage*, a receptacle suspended from said carriage, means for communicating a forward and backward movement to said carriage, and means carried by the boom for raising and lowering the same.

2. In a device of the described class, the combination of a vertical frame, a plurality of *drums connected with the frame*, *a cable passing about said drums*, means for raising and lowering *one of the drums*, supported from the upper end of said frame, and thereby regulating the tension of the cable, a *boom* pivotally supported at one end from said vertical frame, *manually actuated means for revolving said boom* a partial revolution around its pivotal support, a track carried by said boom, a carriage mounted on said track, *the aforesaid cable being connected with the boom and with the carriage*, a receptacle *suspended from the carriage*, a *drum* mounted on the boom, a pulley connected with the upper end of the vertical frame, a cable connecting said last mentioned drum and pulley and a crank for revolving said drum whereby as said drum is revolved in opposite directions, said boom is adapted to be raised and lowered, all substantially as and for the purpose specified.

3. In a device of the described class, the combination of a vertical frame, a boom pivotally supported near one end from said frame, means for revolving said boom a partial revolution about its pivotal support, a track carried by the boom, a carriage mounted upon said track, a cable extending along said boom and connected with the carriage, a

receptacle suspended from said carriage, means for operating the cable and thereby communicating a forward and backward movement to said carriage, and means on the boom for causing raising and lowering movement thereof.

4. In a device of the described class, the combination of a vertical frame, a boom pivotally supported at one end from said frame, means for revolving said boom a partial revolution about its pivotal axis, a track carried by said boom, a carriage mounted on said track, and inclining downwardly and inwardly toward the axis of the boom to permit a receptacle supported by said carriage to move beneath said axis, a receptacle suspended from the carriage, means for communicating a forward and backward movement to said carriage, and means for raising and lowering the boom.

This specification signed and witnessed this _____ day of _____, 1913, at _____.

RICHARD E. ROE.

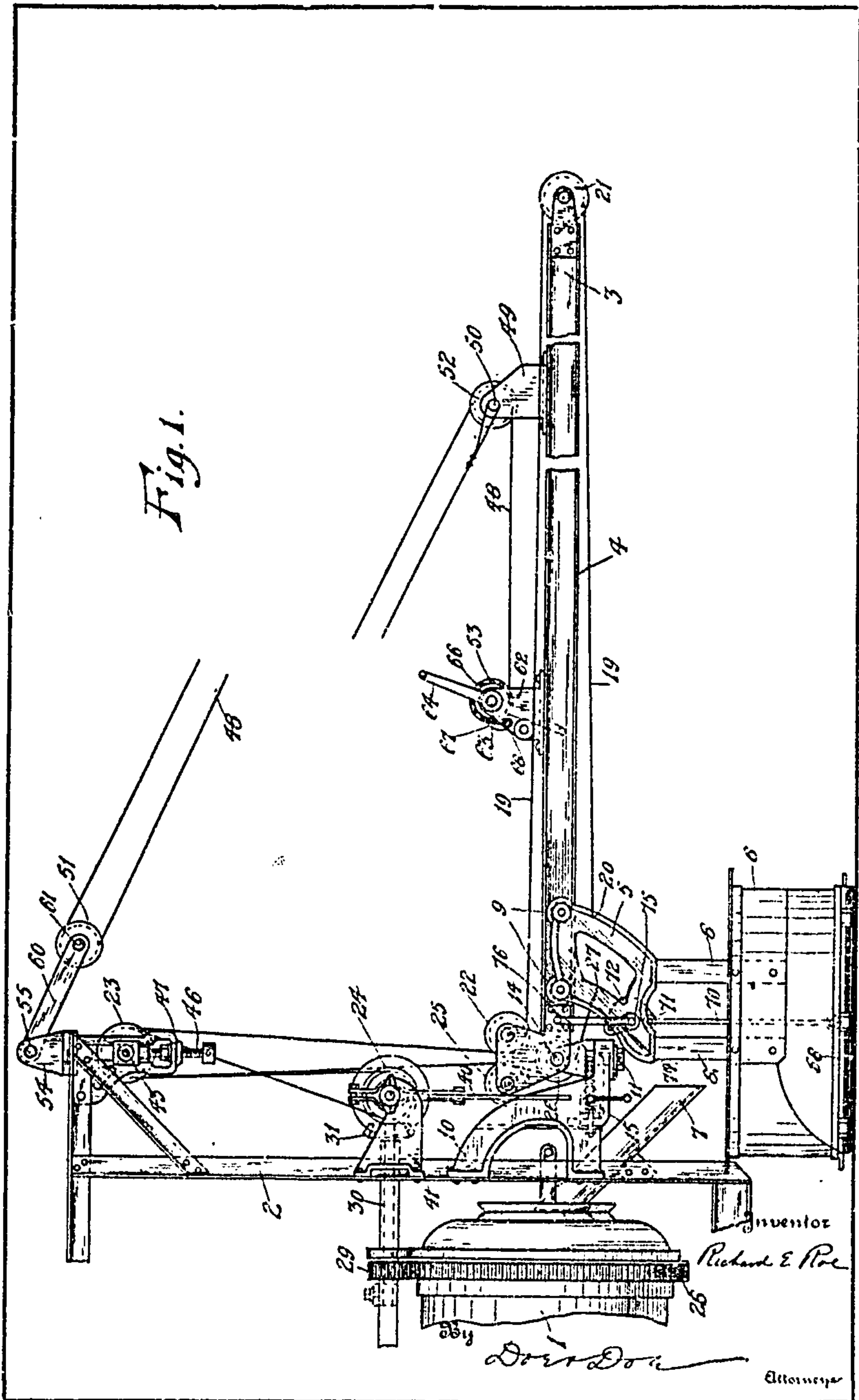
Witnesses:

- 1.
- 2.

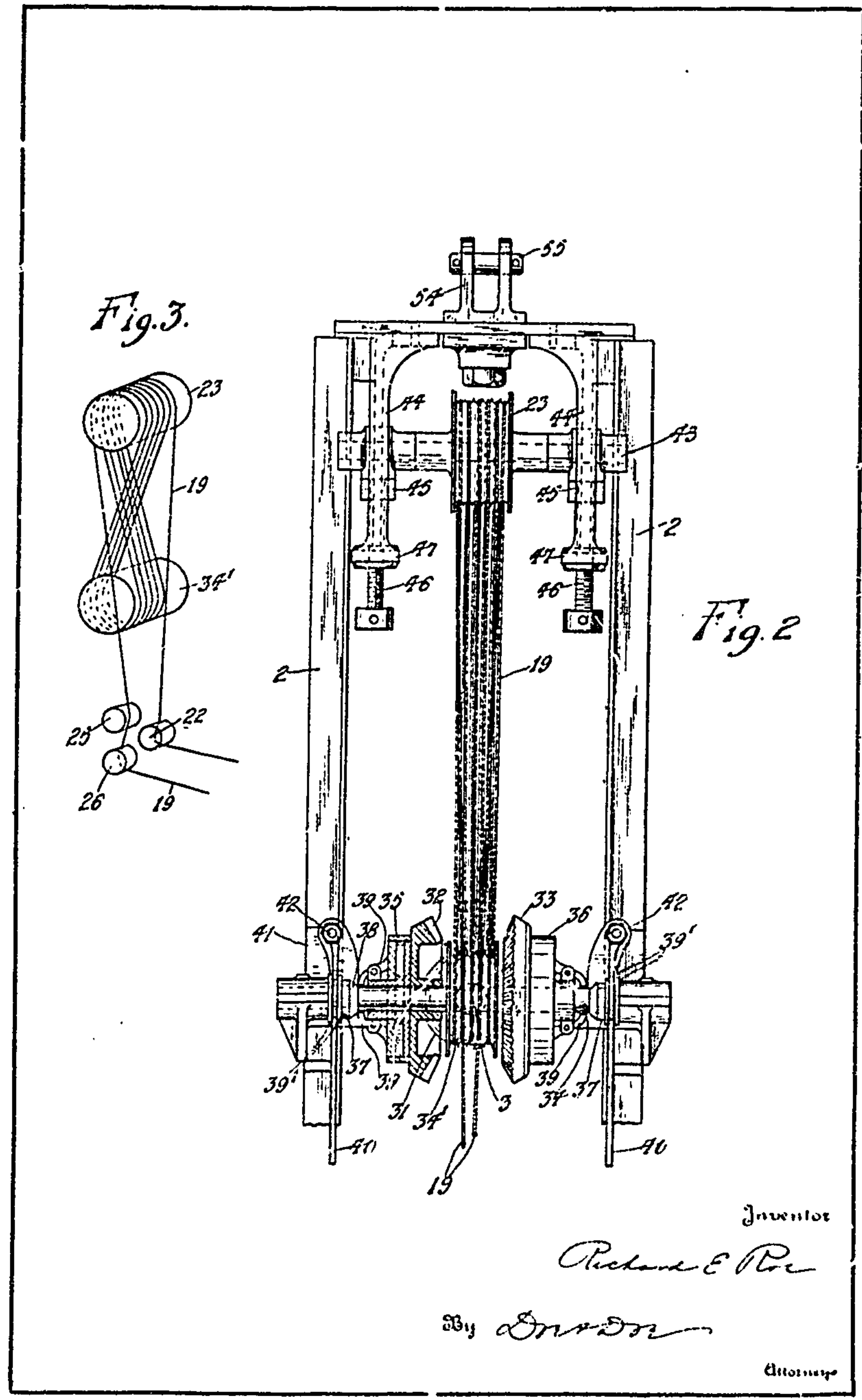
OATH

County of Milwaukee, }
State of Wisconsin, } ss.:

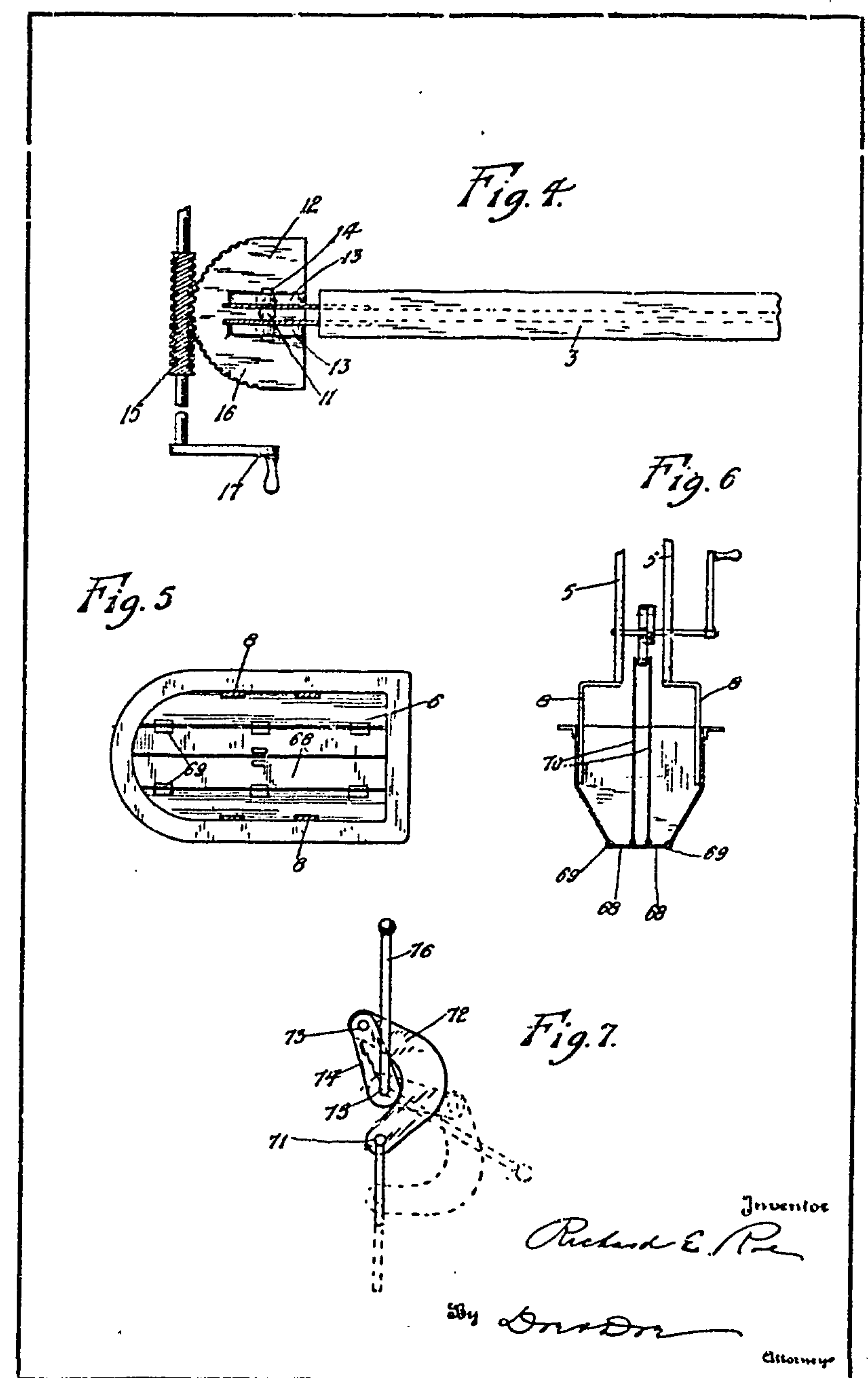
Richard E. Roe, the above named petitioner, being duly sworn, deposes and says that he verily believes himself to be the original and first inventor of the improvement set forth and claimed in the foregoing specification and for which improvement he solicits a patent; that deponent does not know and does not believe that the said improvement was ever before known or used; that deponent is a citizen of the United States, and resides at Milwaukee, in the county of Milwaukee and State of Wisconsin; that deponent verily believes that the Letters Patent referred to in the foregoing petition and specification and herewith surrendered are inoperative and invalid, for the reason that the specification thereof is defective and insufficient and that such defect



REISSUE APPLICATION DRAWINGS



REISSUE APPLICATION DRAWINGS



REISSUE APPLICATION DRAWINGS

and insufficiency consists particularly in the failure to properly define the invention described and illustrated in the claims of the patent, which claims are drawn in terms which are not readable upon said invention, and therefore unintelligible, invalid and insufficient to protect the subject matter disclosed in said patent; the failure to completely describe the construction of the carriage supported by the swinging boom, and to claim the specific form of said carriage in combination with associated parts with which it cooperates; and deponent further says that the errors which render such patent so inoperative and invalid arose from inadvertence, accident and mistake, and without any fraudulent or deceptive intention on the part of deponent; that the following is a true specification of the errors which it is claimed constitute such inadvertence, accident and mistake, relied upon:

1. The erroneous recitation in claim 1 of "manually actuated means for revolving said frame"; the erroneous claiming of "a cable suspended from said carriage"; and the erroneous claiming of "a receptacle suspended from said cable," none of the above features being disclosed in the specification and drawings of deponent's intention.

2. The erroneous recitation in claim 2 of "a plurality of pulleys connected with the respective ends of the frame, means for raising and lowering the pulleys"; the erroneous recitation of "manually actuated means for revolving said frame"; the erroneous recitation of "a cable suspended from said carriage"; and the erroneous recitation of "a receptacle suspended from said cable;" none of the above features being disclosed in the specification and drawings of deponent's invention.

3. The omission from the specification of deponent's patent of a specific and distinct claim or claims to the parts, improvements and combination which he regarded as his invention and discovery.

4. The absence from the specification of description developing the peculiarly inclined or canted formation of the carriage whereby said carriage is movable in order to bring the receptacle 6 into a position adjacent to the mixing drum 1, as set forth in line 51 of page 1 of said specification.

5. The failure to claim the specific construction of the carriage 5 in combination with associated parts of the general distributing mechanism or crane.

6. The failure to claim specifically the utilization of an operating means mounted on the boom 3 for raising and lowering said boom, combined with the general instrumentalities controlling the swinging of said boom and the movement of the carriage and receptacle longitudinally of the same.

That the errors so particularly described arose as follows:

The original patent herewith surrendered was procured by deponent through attorneys who had exclusive charge of the framing of the specifications, claims and drawings for the application upon which said patent issued. At the time of filing the application of said patent deponent avers that the specification, claims and drawings of his invention properly disclosed the same so far as he was able to judge without being skilled in the preparation and construing of patent cases. During the prosecution of the said patent by deponent's attorneys, various alterations in the claims of the original application appear to have been made and in no instance were said alterations or amendments submitted to deponent for his consideration or approval. At a certain period in the prosecution of the aforesaid application the claims of the patent appear to have been made of record and defined deponent's invention in terms which are not readable upon the disclosure of said invention in the patent specifications and drawings. The incorrectness and inadequacy of the claims of said patent appear to have been due to accident or mistake and inadvertence upon the part of said attorneys in the preparation of said claims and the prosecution of deponent's invention.

Deponent further says that within a few days after receipt of his patent Number 1,063,268 he reviewed said patent with the aim of studying the same and obtaining a general understanding of the subject matter of the claims granted in said patent. During said review deponent was led to believe that the claims of said patent embodied terms which were not applicable to the machine disclosed therein, whereupon deponent, on June 14th, 1913, instructed his attorneys, Messrs. Doe & Doe of Washington, D. C., to make a report as to whether the claims of his patent properly covered the subject matter of his invention. As a result of the foregoing instructions deponent was promptly advised by the last named attorneys that apparently through inadvertence, accident, or mistake the Letters Patent aforesaid were inoperative and invalid to cover the invention disclosed thereby and that in order to protect properly the said invention it would be necessary to reissue said Letters Patent. Deponent therefore immediately began instructions to his attorneys to prepare this reissue application so that no time might be lost in the preparation of the same and its lodgment in the Patent Office at Washington, D. C.

Deponent further says that the accompanying amended specification and drawings have been fully and carefully examined by him and that they are correct and give an accurate disclosure

of his invention as it was originally made and which it was deponent's purpose to have protected by his original patent.

Sworn to and subscribed before me this _____ day of _____, 1913.

Notary Public, Milwaukee County, Wis.

NOTE: In respect to this form of reissue the following comments will be instructive:

The specification actually used is a copy of that of the printed grant suitably cut up and provided with interlineations in type-writing readily showing to the Examiner, and to a court if later necessary, the alterations and additions incorporated.

No attempt has been made to alter the original, respecting choice of language of the applicant's first attorneys, except regarding the selection of totally inapt terminology, for it is desirable not to change an original patent by reissue save in absolutely necessary particulars.

The new terminology is italicized in the first two claims.

The original claims, two in number, are given to show the amendments made thereto by the reissue and relation of certain entirely new claims inserted in the reissue, namely claims 3 and 4.

CLAIMS OF ORIGINAL PATENT OF THIS REISSUE

(These are supplied to show defects)

1. In a device of the described class, the combination of a vertical frame, manually actuated means for revolving said frame a partial revolution around its pivotal support, a crane pivotally supported at one end from said frame, a track carried by said crane, a carriage mounted upon said track, a cable suspended from said carriage, means for communicating a forward and backward movement to said carriage, and means carried by said crane for raising and lowering the same.

2. In a device of the described class, the combination of a vertical frame, a plurality of pulleys connected with the respective ends of said frame, means for raising and lowering the pulleys, supported from the upper end of said frame, and thereby regulating the tension of a cable, manually actuated means for revolving said frame a partial revolution around its pivotal support, a crane pivotally supported at one end from said vertical frame, a track carried by said crane, a carriage mounted on said track, a cable suspended from said carriage, a receptacle suspended from said cable, a drum mounted on said crane, a pulley connected with the upper end of said vertical frame, a cable communicating between said drum and pulley, and a crank for revolving said drum, whereby as said drum is revolved in opposite directions, said crane is adapted to be raised and lowered, all substantially as and for the purpose specified.

The drawings were exact duplicates of the original except for the signatures.—Author.

XVIII

A TYPICAL SPECIMEN OF FILE WRAPPER CONTENTS OF A DESIGN PATENT APPLICATION INCLUDING PETITION FOR EXERCISE OF SUPERVISORY AUTHORITY OF COMMISSIONER*

(Exemplifying prosecution of such application)

PETITION

To the Commissioner of Patents:

Your petitioners, Edwin O. Roe and Edwin W. Roe, citizens of the United States, and residents of Saginaw, in the County of Saginaw, and State of Michigan, and Yuma, in the County of Yuma, and State of Arizona, respectively, whose post-office addresses are 707 Lyons Street, Saginaw, Michigan, and Box 82, Yuma, Arizona, respectively, pray that Letters Patent of the United States may be granted to them for a term of three and one-half years, for the new, original and ornamental design for a COMBINATION STUDY CHAIR set forth in the annexed specification.

And they hereby appoint

Messrs. DOE & DOE (a firm consisting of J. F. & H. C. Doe), Southern Building, Washington, D. C., Registration Number 7987, their attorneys, with full power of substitution and revocation, to prosecute this application, to make alterations and amendments therein, to sign their name to the drawing, to receive the patent, and to transact all business in the United States Patent Office connected therewith.

Signed at Saginaw, in the County of Saginaw, and State of Michigan, this 10th day of March, 1914.

EDWIN O. ROE.

Signed at Yuma, in the County of Yuma, and State of Arizona, this 15th day of March, 1914.

EDWIN W. ROE.

* See Klemm & Schreiber, Design Patent No. 47464, June 15, 1915.

SPECIFICATION

To all whom it may concern:

Be it known that we, Edwin O. Roe and Edwin W. Roe, citizens of the United States, residing at Saginaw, in the County of Saginaw, and State of Michigan, and Yuma, in the County of Yuma, State of Arizona, respectively, have invented a new, original and ornamental Design for A COMBINATION STUDY CHAIR of which the following is a specification, reference being had to the accompanying drawing, forming a part thereof.

Figure 1 is a front perspective view of a combination study chair embodying our design; and

Figure 2 is a rear perspective view of the same.

We claim:

The ornamental design for a combination study chair as shown.*

EDWIN O. ROE.
EDWIN W. ROE.

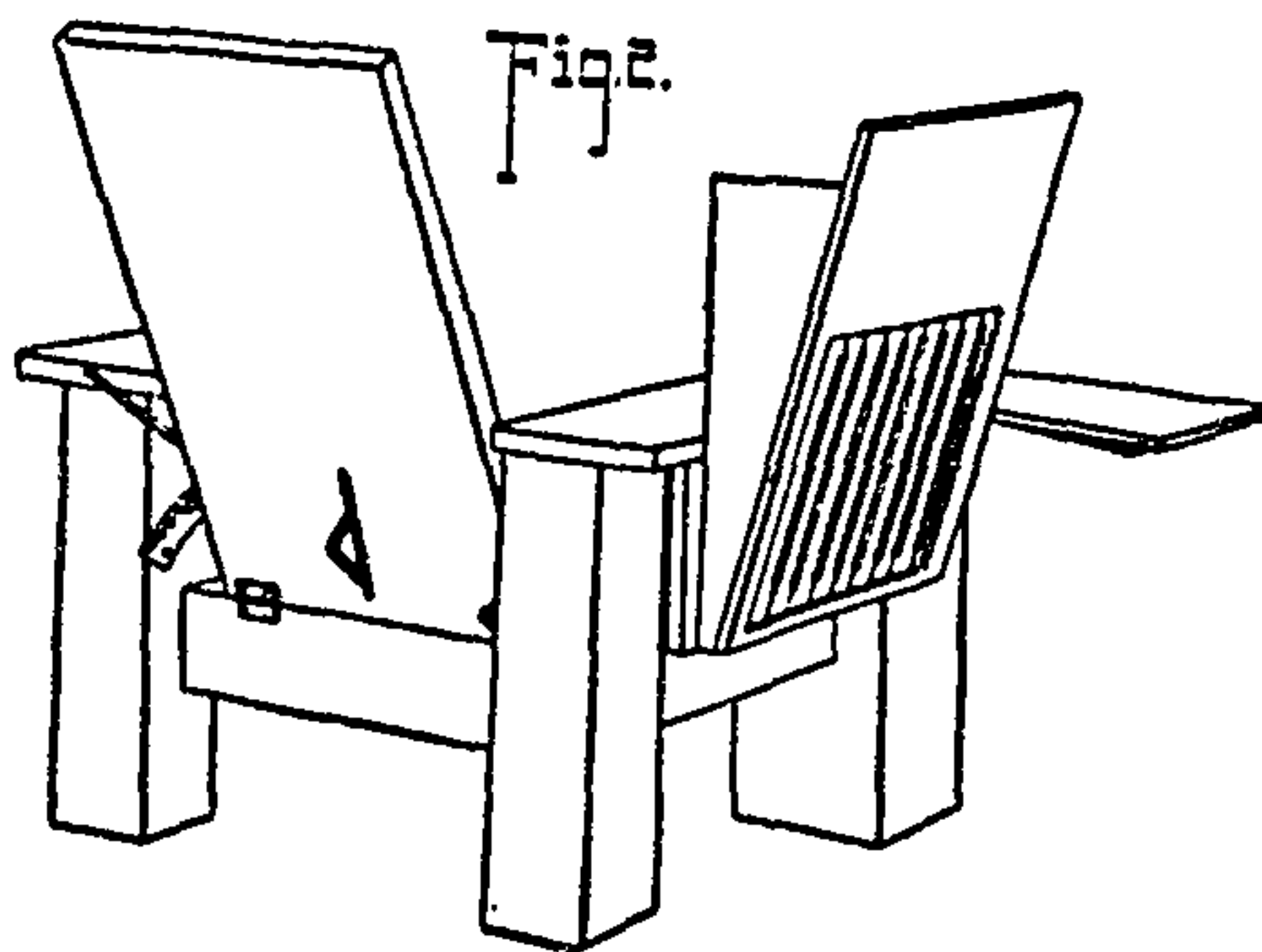
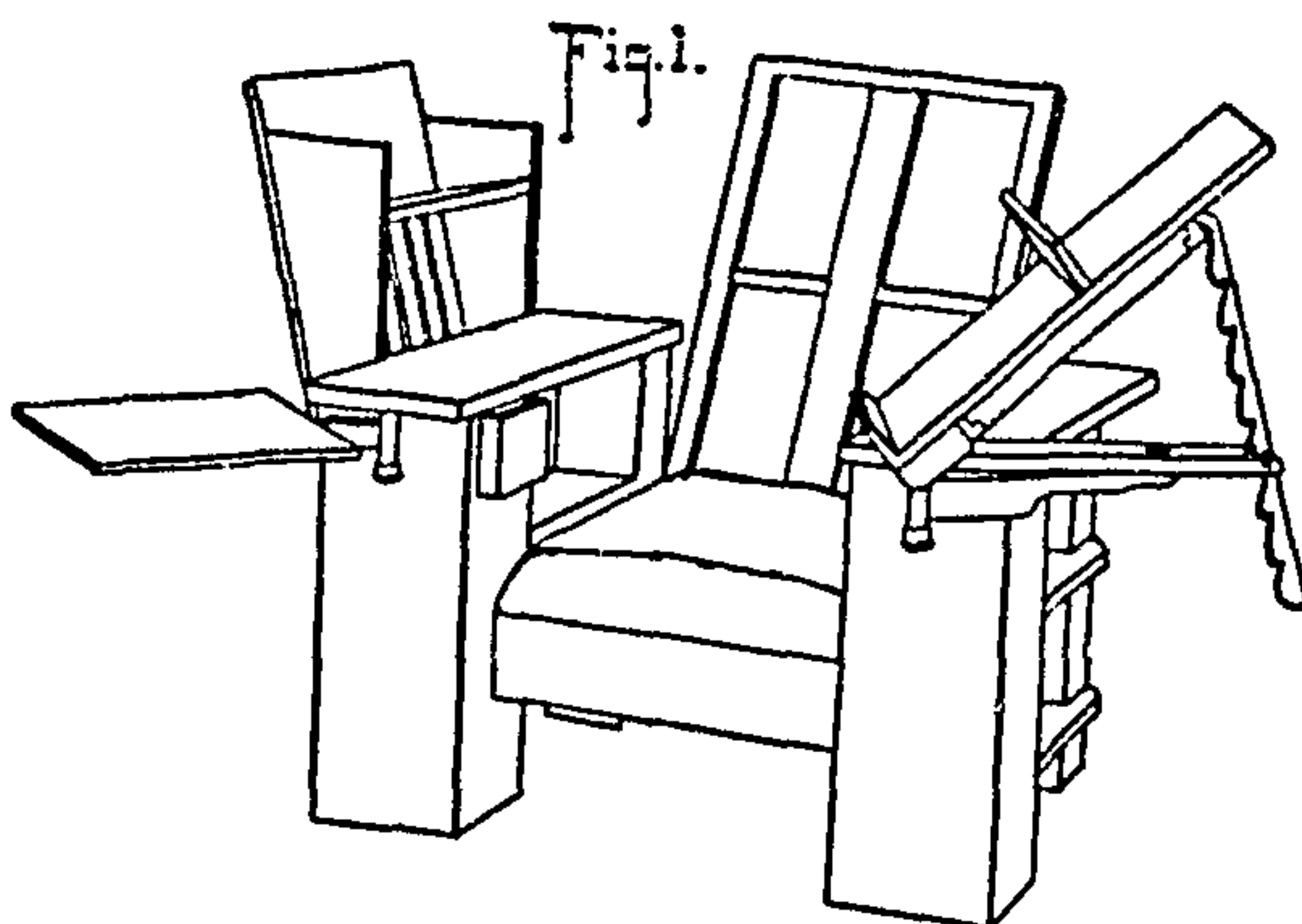
OATH

State of Michigan, }
County of Saginaw, } ss.:

State of Arizona, }
County of Yuma, } ss.:

Edwin O. Roe and Edwin W. Roe, the above named petitioners, being duly sworn, depose and say that they are citizens of the United States, and residents of Saginaw, in the County of Saginaw, and State of Michigan, and Yuma, in the County of Yuma, and State of Arizona, respectively; that they verily believe themselves to be the original, first and joint inventors of the design for a combination study chair, described and claimed in the annexed specification; that they do not know and do not believe that the same was ever known or used before their invention thereof, or patented or described in any printed publication in any country before their invention thereof, or more than two years prior to this application, or in public use or on sale in the United States for more than two years prior to this application; that said design has not been patented in any country foreign to the United States on an application filed by them or their legal representatives or assigns more than four months prior to this

*A better form of claim might read: The ornamental design for a combination study chair, a typical form of which is shown.



Inventors

Edwin O. Roe
Edwin W. Roe

By

Doerflinger

Attorneys

application, and that no application for patent on said design has been filed by them or their representatives or assigns in any country foreign to the United States.

EDWIN O. ROE.
EDWIN W. ROE.

Sworn to and subscribed before me by Edwin O. Roe this 10th day of March, 1914.

(Seal)

GERTRUDE ROEHER,
Notary Public.

Sworn to and subscribed before me by Edwin W. Roe, this 15th day of March, 1914.

(Seal)

JACKSON TALCOTT,
Notary Public.

Room 163.

Paper No. 2. Rej.

DEPARTMENT OF THE INTERIOR
UNITED STATES PATENT OFFICE

Washington

April 29, 1914.

Doe & Doe,
Southern Building,
Washington, D. C.

Please find below a communication from the EXAMINER OF TRADE-MARKS AND DESIGNS regarding the application of Edwin O. Roe and Edwin W. Roe, for design for Combination Study Chair, filed Mar. 21, 1914, Serial No. 826,419.

THOMAS EWING,
Commissioner of Patents.

The design disclosed by applicant is held not to present proper subject-matter for design patent protection for the reason that it illustrates an article made up of numerous movable or adjustable parts. It is believed that, as shown, this case falls within the class of cases inhibited in the following decisions: *ex parte* Kapp & Kapp, 83 O. G., 1993; *ex parte* Tallman, 82 O. G., 337; *ex parte* Smith, 81 O. G., 969; *ex parte* W. S. Adams, 84 O. G., 311; and *ex parte* Steck, 98 O. G., 228. It is believed that the article forming the subject-matter of applicants' case presents novel features, although in its present form it is held that same is not patentable under the design section of the statute for reasons above pointed out.

The claim is therefore rejected and a patent refused. This application would seem to be allowable when the objection above pointed out has been remedied.

.....
Examiner of Trade-Marks and Designs.

IN THE UNITED STATES PATENT OFFICE

E. O. Roe, and E. W. Roe
 Design for Combination Study Chair
 Filed March 21, 1914
 Serial No. 286,419
 Last Office Letter—April 29, 1914

Room 163.

Hon. Commissioner of Patents,
 Washington, D. C.

Sir:—

Counsel have given very careful consideration to the official action above mentioned, as well as the decisions therein mentioned, and respectfully request that the case be given the Honorable Examiner's reconsideration having in view the following remarks.

It is noted that the Examiner holds that the present design illustrates an article made up of numerous movable or adjustable parts but does not make the statement sufficiently specific to enable counsel to adequately consider whether the Examiner has a true conception as to what is movable and what is not movable in the article. The purport of all the decisions which the Examiner cites, and of his rejection of this case, appears to be that merely because the article consists of such movable parts, it is, therefore, not subject-matter for design protection.

Counsel are, however, unable to reconcile either these decisions or the present rejection with the practise of the Office as disclosed by the grant of patents extending over a considerable period of time subsequent to the rendition of these decisions. Furthermore, as the Examiner will appreciate, the movement of elements of the articles of the design can only be apparent because there is no specific mention or suggestion in the claim or application that parts of the device have any movement. It may be mentioned that one of the leading decisions cited by the Examiner states:

In the case of a single article of manufacture there may be some relative movement of the parts without changing the appearance of the article or taking it outside of the design law.

This would appear to counsel to support the contention that the present design is a single article of manufacture, and that a slight relative movement of one or more of its members would not prevent grant of patent therefor. In connection with the above remarks, counsel refer the Examiner to the fact that patent after patent has been granted for designs for stoves, as an instance, and there can be no question that said design patents show doors which are movable, and, when opened, would certainly alter the design in a very much more significant manner than if one of the stands connected to the chair of applicants' article were moved forwardly or backwardly, assuming that such could be done. Counsel's contention is that to move a stand on this chair does not in any way change the contour or the design involved. Many other patents might be referred to along this line but particular mention is made of the patent No. 45,746, for a cabinet brush, just granted. This brush consists of a body portion having a cover which is hingedly connected thereto, and which is shown in the drawing to be movable into a position opening the receptacle in the body of the brush. It is too significant to point out particularly how clearly this patent shows a part which is movable, and once moved, considerably changes the design of the article of manufacture. There can be no question that when the cover of the brush is closed there is an entirely different design from that disclosed when the cover is open, so that the grant of the patent indicates clearly that applicants' article of manufacture is also within the practise warranting the grant of design patent therefor.

It is hoped that in view of the foregoing remarks favorable consideration will be granted the present application, but should the Examiner take a contrary position, he is respectfully requested to make specific his objection in regard to the parts so that proper action may be taken in the case.

Respectfully submitted,
DOE & DOE,

Attorneys for Roe and Roc.

May 22, 1914.

ROOM 163

Paper No. 4 B.

DEPARTMENT OF THE INTERIOR
UNITED STATES PATENT OFFICE

Washington

June 4, 1914.

Doe & Doe,
Southern Bldg.,
Washington, D. C.

Please find below a communication from the EXAMINER OF TRADE-MARKS AND DESIGNS regarding the application of • Edwin O. Roe and Edwin W. Roe, for design filed March 21, 1914, Ser. No. 826,419.

THOMAS EWING,
Commissioner of Patents.

This case has been further considered in connection with the argument filed May 22, 1914.

In response to applicants' request that the Office point out the particular features deemed to be objectionable in the disclosure of the design in the several figures of the drawing, the Examiner would say that, in his opinion, the adjustable book rest and shelf shown as mounted opposite each other at the front of the chair just below the side arms are objectionable in view of the reasons and decisions noted in former Office letter. The objections urged in former Office letter are accordingly repeated.

The claim is therefore rejected and a patent refused. This application would seem to be allowable when the objections pointed out above have been remedied.

**A Typical Specimen of a Petition to the Commissioner of
Patents in Person for Exercise of Supervisory
Authority***

(Inclusive Examiner's Statement, Briefs and Decision)

IN THE UNITED STATES PATENT OFFICE

Roe & Roe
Design for Combination Study Chair
Filed March 21, 1914
Serial Number 826,419

PETITION TO THE HONORABLE COMMISSIONER OF
PATENTS

from the

HONORABLE EXAMINER OF TRADE-MARKS AND
DESIGNS

Your petitioners respectfully aver:

First: That they are the applicants in the matter of the above entitled application for design letters patent.

Second: That on April 29, 1914, the Examiner of Trade-Marks and Designs made the following action on said application, i.e.,

"The design disclosed by applicant is held not to present proper subject-matter for design patent protection for the reason that it illustrates an article made up of numerous movable or adjustable parts. It is believed that, as shown, this case falls within the class of cases inhibited in the following decisions: *ex parte* Kapp & Kapp, 83 O. G., 1993; *ex parte* Tallman, 82 O. G., 337; *ex parte* Smith, 81 O. G., 969; *ex parte* W. S. Adams, 84 O. G., 311; and *ex parte* Steck, 95 O. G., 228. It is believed that the article forming the subject-matter of applicants' case presents novel features,

* See *ex parte* Klemm & Schreiber, 218 O. G., 603.

although in its present form it is held that same is not patentable under the design section of the statute, for reasons above pointed out.

Third: That petitioners made prompt response to the official action above noted requesting the Examiner to point out just which parts of petitioners' design should be deleted to conform with the Examiner's ideas of the requirements of the practise. Furthermore, petitioners at the same time argued for a waiver of the Examiner's ruling that petitioners' design was not submitted in proper form for the grant of Design Letters Patent on the main grounds that the practise of the Patent Office in recent years does not support the official objections, and that the latter are inconsistent with the true spirit and intent of the design patent law.

Fourth: That on June 4, 1914, the Examiner for a second time asserted the objections entered against the petitioners' design as presented in the drawing of their application, and while conceding the allowability of said design, the deletion of certain features was again required, from which requirement this petition is taken for the exercise by your Honor of your supervisory authority to remedy the chaotic condition of the design practise of the Patent Office.

The following are assigned as the grounds for this petition:

A The Examiners' objections in this case are based upon certain decisions of the Patent Office, namely,

Ex parte Kapp & Kapp,	83 O. G., 1993
Ex parte Tallman	82 O. G., 337
Ex parte Smith,	81 O. G., 969
Ex parte W. S. Adams,	84 O. G., 311
Ex parte Steck,	95 O. G., 228

B The above decisions are inconsistent with one another, and not in conformity with the spirit of the design patent law of the Revised Statutes of the United States.

C The above decisions have been so frequently ignored or misconstrued, during the thirteen years since the last one was rendered, that patent after patent has been granted in non-conformance with the said decisions, until to-day the prospective applicant for a design patent is confronted with a condition absolutely preventing an intelligent determination of the patentability of *designs for articles of manufacture comprising more than one*

part. (Reference is directed to copies of design patents annexed to appended brief as indicative of the inconsistencies of legal construction incidental to the grant of such patents at the present time.)

D The design patents noted below, all granted during the period of pendency of petitioners' application, namely within the last few months, establish either that the decisions relied upon as a basis for the objections to petitioners' disclosure are of no force and effect, or that there is one design patent law for one applicant, and a different law for another. Reference is made to design patents

No. 45,746	June 23, 1914
No. 45,977	June 23, 1914
No. 46,120	July 21, 1914
No. 46,109	July 21, 1914
No. 46,187	July 28, 1914
No. 46,150	July 21, 1914

(N. B. Copies of these patents are annexed to petitioners' brief filed herewith.)

E The only decision of the United States Courts that appears to have been rendered touching on the issue in this case is *Chandler Adjustable Chair & Desk Co. vs. Heywood Bros. & Wakefield Co.*, 91 Fed., 163, and this authority completely overrules the Patent Office decisions of *ex parte Tallman*, *ex parte Smith*, *ex parte Adams*, relied on by the Examiner to support his objections in this case, along with a few other decisions of practically the same import.

Wherefore, your petitioners respectfully pray:

First: That the Examiner be advised that petitioners' design for Study Chair, as exhibited by their patent drawing, is as a whole a patentable design for a single article of manufacture, and may therefore be allowed without deletion of any portion or portions thereof; and

Second: That the future practise of the Patent Office should be in accord with the decision in *Chandler Adjustable Chair & Desk Co. vs. Heywood Bros. & Wakefield Co.*, 91 Fed., 163, wherein the Court held as follows:

The broad proposition advanced by the defendant that section 4929 of the Revised Statutes was not intended to apply to structures having movable parts is not supported by the citation of any judicial decision; and though certain rulings of the Patent Office (*ex parte Tallman*, *ex parte Adams*,

ex parte Smith, ex parte Brower) are presented to support this proposition, I am of the opinion that such a construction of the statute calls for an unwarranted and unreasonable limitation of the terms "manufacture" and "any article of manufacture" and leads to absurd and unjust results. For instance, such a construction would defeat claims like those in *Burton vs. Town of Greenville* 3 Fed. 642, and *Britton vs. Manufacturing Co.* 61 Fed. 94. To the objection of the defendant that the parts have no necessary single, infallible, and fixed relations to each other, it is sufficient to say that the complainant *describes* and shows in his drawing a single and definite arrangement of parts. Therefore, even upon the narrowest construction of his patent, he is *prima facie* entitled to the design, configuration, or shape, resulting from that special arrangement of parts exhibited in the drawing.

It is requested that a date be set for an oral hearing on this petition.

Respectfully submitted,

EDWIN O. ROE & EDWIN W. ROE.

By Doe & Doe,

Attorneys.

Washington, D. C.

DEPARTMENT OF THE INTERIOR
UNITED STATES PATENT OFFICE

Washington

Sept. 3, 1914.

Sirs:

The case of Roe & Roe,
Combination Study Chair } Petition.

Serial No. 826,419, will be heard by the Commissioner on the 10th day of September, 1914, at 10:15 A. M.

The hearings will commence at ten o'clock, and as soon as the argument in one case is concluded the succeeding case will be taken up.

If any party, or his attorney, shall not appear when the case is called, his right to an oral hearing will be regarded as waived.

The time allowed for arguments is as follows:

Ex parte cases, thirty minutes;

Motions, thirty minutes, each side;

Interference appeals, final hearing, one hour each side.

By special leave, obtained before the argument is commenced, the time may be extended.

The appellant shall have the right to open and conclude in interference cases, and in such case a full and fair opening must be made.

Briefs in interference appeals must be filed in accordance with the provisions of Rule 147.

Respectfully,

THOMAS EWING,
Commissioner of Patents.

(N. B.—This hearing will be held before Mr. Newton.)

To Doe & Doe,
Southern Bldg.,
Washington, D. C.

JHC.—F.

Paper No. 7.

UNITED STATES PATENT OFFICE

Application of Edwin O. Roe and Edwin W. Roe Design for Combination Study Chair Filed March 21, 1914 Serial No. 826,419 Southern Building Attorneys: Doe & Doe Washington, D. C.	}	Before the Commissioner on Petition
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EXAMINER'S STATEMENT

This is a petition by the applicants from the refusal of the Examiner to allow this application on the ground that the device shown in the drawing is not proper subject-matter for a patent, by reason of the practise announced in the following decisions:

Ex parte Brower,	4 O. G.,	450
Ex parte Haggard,	80 O. G.,	1126
Ex parte Smith,	81 O. G.,	969
Ex parte Tallman,	82 O. G.,	337
Ex parte Brand,	83 O. G.,	747
Ex parte Steck,	98 O. G.,	228
Ex parte Kapp & Kapp,	83 O. G.,	1993

At the outset it may be stated by the Examiner that the decision on this question is one which, it is believed, relates to the merits and in the first instance is appealable to the Examiners-in-Chief; that is to say, it is not petitionable to the Commissioner. (See, for instance, *ex parte Goldsoll*, 189 O. G., 523.) It is noted, however, that the applicants seek the exercise of supervisory authority by the Commissioner. It will therefore be treated by the Examiner on its merits.

From the decisions cited above, it is gathered by the Examiner that the general rule is that the structure embodying a design must be a unitary one; that is to say, the several parts thereof must not have a relative movement with respect to each other. When the present Examiner first had occasion to consider this question, he found that the rule had been interpreted by his predecessors in such a way that it could not be easily understood. Moreover, it seemed to the Examiner that there was a tendency in the division to construe the rule somewhat strictly. After careful consideration and discussion, the present Examiner concluded that the rule laid down in these cases was not intended to apply except where the relative movement of the several parts was such that the design as a whole was substantially different when the several parts were moved to their maximum extent. In such a case, where the effect produced on the eye was different, an attempt was made to apply the rule. In practise, it is exceedingly difficult to draw the line and practically impossible to be consistent in all cases. Nevertheless, the fact remains that under the practise announced in these decisions cited, some line must be drawn by the Examiner. In the case here under consideration, it is believed that it falls within the rule announced in the decisions *supra*, interpreted as explained above.

The Examiner joins with the applicants in hoping that some way may be found by the Commissioner to render the practise simpler and less difficult of application. This is not the first time that the Commissioner has been called upon to consider this question. Such a case was *ex parte* Clarence H. Dunlap, Ms. D. 113, p. 191. In that case the Examiner requested that:

either the decisions be overruled, or that a practise which the Commissioner believes to be in accordance therewith be indicated for the instruction of the Examiner.

The First Assistant Commissioner, in granting the petition, stated in part as follows:

It is difficult to lay down a hard and fast rule in cases of this character and the Examiner should be governed by the statute, rules and decisions and the fundamental principles upon which the statute is founded.

It is believed that the action of the Examiner in refusing this application was proper.

Very respectfully,

CARNES.

Examiner, Trade-Marks and Designs.

Sept. 5, 1914.

IN THE UNITED STATES PATENT OFFICE

Roe & Roe
Design for Combination Study Chair
Filed March 21, 1914
Serial Number 826,419

SUPPLEMENTAL BRIEF IN SUPPORT OF PETITIONERS

It is desired, after a review of the Examiner's statement disclosing matters unknown to counsel, to draw your Honor's attention to the fact that the Examiner himself joins with the applicants or petitioners in this case in hoping that some way may be found by your Honor to render the practise simpler and less difficult of application.

This petition has not been brought in any spirit of criticism of the Examiner of Designs, but merely with the aim of establishing, if possible, definiteness of the practise. As noted by the Examiner it appears that some recent case has been decided bringing up certain questions raised by this petition and in that particular case the Examiner asked that the decisions in view of which this petition is taken be overruled. Certainly it would seem time to take the above step because the practise does not follow the decisions in question and nearly all of them are virtually dead in so far as applicability to present conditions is concerned.

We failed to reach the conclusion of the Examiner, in his statement that the rejection of this application was proper for the very reason that said conclusion is not based upon what we believe to be a proper premise, something which is conceded by the Examiner himself.

Finally, in respect to the suggestion of the Examiner that the rule laid down in the cases hereinbefore mentioned is not intended to apply except where the relative movement of several parts is such that the design as a whole is substantially different, affords no basis for the grant of certain of the design patents, copies of which were submitted with our main brief filed with the petition. In other words, in several of the prior design patents recently granted, if the parts are moved to their maximum extent the whole general appearance of the design would be destroyed, something which can not be alleged to the design of applicants' STUDY CHAIR.

Respectfully submitted,

DOE & DOE,
Attorneys for Roe & Roe.

September 10, 1914.

IN THE UNITED STATES PATENT OFFICE

Roe & Roe
Design for Combination Study Chair
Filed March 21, 1914
Serial Number 826,419

} Before the Honorable
Commissioner of Patents

BRIEF IN SUPPORT OF PETITIONERS

The questions presented by this petition relate solely to that type of design inventions which are composed of a plurality of parts. We deem these questions to be especially serious owing to the present condition of the design patent practise, which as outlined in the formal petition filed herein, must be conceded to be in a very chaotic condition such as to render it impossible for even the most expert practitioners before the Patent Office to arrive at intelligent conclusions regarding the patentability of designs of the class referred to.

The first and foremost object in view in the presentation of this petition for your Honor to exercise your supervisory authority, is the establishment on the part of the Patent Office of some uniform procedure in respect to the grant of patents for articles of manufacture comprising a number of parts.

Where an article of manufacture consists of a single part only, the practise is well settled that if the construction of such an article of manufacture is such as to appeal to the artistic sense, and has required the exercise of the inventive faculty in its conception, its patentability must be conceded. Relative to such articles of manufacture as embody a plurality of parts, however, there appear to be other conditions than those incidental to determining the patentability of an article of manufacture embodying a single part or unit.

Counsel for petitioners have made a very faithful review of the entire line of decisions controlling the particular subject now presented to your Honor for determination, and a survey of all of said decisions whether they are for or against the contentions of petitioners which may be hereinafter advanced, will be given after a brief consideration of the applicants' design invention.

APPLICANTS' DESIGN

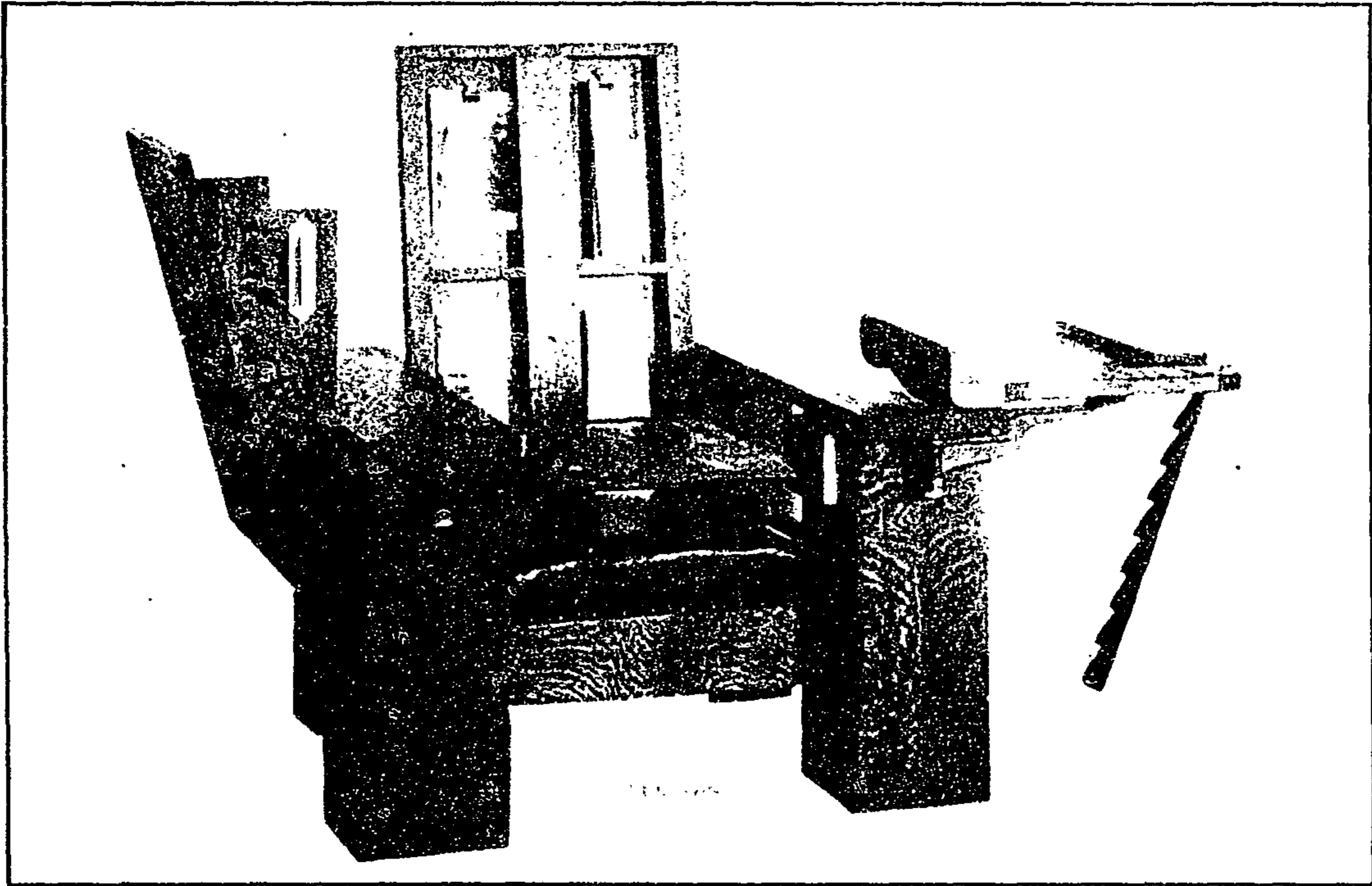
The design of petitioners consists of what is called a study chair and is an article of furniture having some similarity to what is known as the ordinary Morris chair. The design is depicted by two views on a single sheet of drawings, looking at the chair from the front and from the rear. In his actions on this

case the Examiner of Trade-Marks and Designs concedes the patentability of applicants' design for chair as a chair, with the exception, however, that objection is raised to the inclusion in the design of a certain stand carried by the right arm or pedestal of the chair and projecting outwards therefrom, and with the further exception of a book support or rest structure mounted upon the left arm or pedestal of the chair, reference being made to the front perspective view of the drawing. On the right arm or pedestal of the chair is mounted a movable drawer, and the back of the chair is of the adjustable type permitting of reclining of the occupant when desirable. The Examiner in stating his objection says as follows:

the adjustable book rest and shelf shown as mounted opposite each other at the front of the chair just below the side arms are objectionable in view of the reasons and decisions noted in former Office letter.

It is suggested by the Examiner that if these objectionable features be removed the application would be allowable.

The question before your Honor for determination in brief, therefore, is: Does the petitioners' chair as shown in the drawings comprise a single article of manufacture within the contemplation of the design patent law and is it susceptible of protection as such? Certainly it is true that the chair of the design of petitioners is a complete article of manufacture designed for a particular purpose, namely with a view to having all accessories required for the purposes of facilitating study, the accessories comprising primarily supports of different kinds for books, papers, etc., and the absence of any one of which supports would create incompleteness of the article of manufacture. Figure 1 of the drawings discloses the use of an adjusting brace for the book support at the left and while no claim is made for any moving parts, in accordance with the latest design patent practise, petitioners would not attempt to maintain the assertion that it is not contemplated that the book rest be susceptible of slight adjustments determinable possibly by the size of the person sitting in the chair, and other considerations of comfort or the like. WE DO RESPECTFULLY MAINTAIN, HOWEVER, THAT IF THE BOOK REST OF THE STRUCTURE SHOWN IN PETITIONERS' DESIGN IS MOVED UP A FEW INCHES OR DOWN A FEW INCHES THE GENERAL DESIGN OF THE CHAIR, HIGHLY ARTISTIC IN EVERY RESPECT, IS PRACTICALLY UNCHANGED, SEE ANNEXED PHOTOGRAPH. While the book rest is being used, it, of course, is maintained at some inclined adjustment.



DESIGN AS COMMERCIALY BUILT

It is contemplated, of course, that in packing the chair for shipment the book-rest as a whole might be taken off of the chair proper and this is true in respect to the typewriter stand on the right pedestal of the chair.

THE PRIOR DECISIONS

The Examiner has based his objections to petitioners' design on certain decisions of the Patent Office, all of which were rendered by the several Commissioners involved, on petitions taken by applicants for the exercise of the Commissioner's supervisory authority. It is for this reason, primarily, that we have filed a petition to your Honor in this case, the questions involved being thought to be of such a serious and acute nature as must require the ultimate consideration of Your Honor and the sooner they are raised the better, for reasons now to be presented.

Practically all of the decisions referred to are quite old, the last one being rendered by Honorable Commissioner Allen in 1901, so that in so far as we are advised there has been no recent adjudication of the points now raised nor do we believe that the conditions of the practise have required such an adjudication until comparatively recent years, during which the proposition of the protection of articles of manufacture embodying a number of parts has been again and again presented to the Patent Office.

About the first decision to which reference may be made is that of *ex parte* Smith, 181 O. G. on petition by Acting Commissioner Greely and involving a design for atomizer. The specification described "handle 5 and rod 6 which may be more or less withdrawn or forced into the body of the atomizer and to this extent will vary the appearance of the instrument." In this case the Examiner called the atomizer a "highly organized machine" and the Commissioner held:

The elements of any design should be of an unchanging character, since any change in these changes the shape or configuration of the whole . . . the movable handle in this case should not be made an element of the design.

The design patents of Farlow, Fernandez, Apple, Simenson, Webb, and Webb, copies of which are appended hereto, certainly can not be said to be granted on the authority of the above decision. The atomizer held unpatentable as a design by Commissioner Greely would have maintained a far more unchanging character of configuration, on movement of its parts, than would be true in the case of any of the patents above mentioned.

Again, in *ex parte Tallman*, Commissioner Greely held:

The design law was never intended to apply to structures having movable parts.

The effect of a movable part . . . is to change the form or contour of the structure as the part is shifted.

There is no possible ground for equivocation as to the meaning of the above decision which was rendered in reference to a can-opener, the only movable part of which was a blade holder which could not possibly have changed the general configuration of the device by any movement.

The grant of all of the design patents, copies of which are appended hereto, is an infraction of the Commissioner's ruling in the above decision which was supplemented by a further holding as follows:

If his (applicant's) intention were to make the device all in one piece, as by casting, a claim for the structural design might be proper; but it is obvious that at present as the knife is shifted the form or contour of the article will be changed.

In the case of *ex parte Kapp & Kapp*, Honorable Commissioner Duell held that the applicant instead of inventing a pair of tongs really was entitled to protection for one of the members or jaws of the tongs, and required the description and the design to be limited accordingly, stating:

In requiring this limitation applicants have not been deprived of any of their rights.

The foregoing is entirely true where a pair of tongs is involved in which both of its members are identical, but the grant of every one of the design patents of recent date above referred to is an infraction of this decision also.

In connection with the foregoing decisions counsel desire to bring out the fact that the Examiner is insisting upon the present petitioners adhering to said decisions whilst patent after patent is being granted inconsistent with said decisions.

There is another case, *ex parte Brand*, 83 O. G., 747, not mentioned by the Examiner, where the Commissioner held:

A design must be a single unchangeable article of manufacture and must not be made up of independent detachable parts.

The doctrine above established is not adhered to to-day in the practice in any sense whatever and certainly may be considered as dead law.

Honorable Commissioner Allen in *ex parte* Steck held:

A machine is not patentable as a design. Under the express provisions of the law a design patent is limited to an "article of manufacture" and there is no warrant for granting such a patent upon a machine whose parts bear certain functional relations to each other.

By any ordinary acceptation of the word "machine" it must be held that the Farlow, the Wright, the Apple, Bump, Simenson, Webb, and Webb patents embodying as they all do parts bearing certain functional relations, relatively movable, etc., are grants of design protection in absolute derogation of the doctrine pronounced in the last quoted authority. In said decision there was a limitation of the breadth of the Commissioner's meaning according to his following statement:

In the case of a single article of manufacture there may be some relative movement of the parts without changing the appearance of the article or taking it outside of the design law; but nothing which amounts to a machine can come within the law whether or not the motion of the parts materially changes the appearance of the device as a whole.

THE ONLY PERTINENT ADJUDICATION OF THE COURTS CONTROLLING THE PROPOSITION HEREIN DISCUSSED

We refer for your Honor's careful consideration to the decision mentioned in the petition, *Chandler Adjustable Chair & Desk Co. vs. Heywood Bros. & Wakefield Co.*, 91 Fed. 163, wherein was involved apparently the question of infringement of a design patent. The defense offered by the defendant was that the revised statutes were not intended to cover constructions embodying movable parts and therefore complainant's patent was invalid. The patent adjudicated was design patent No. 21,272 issued in 1897. The Court's decision was rendered in overruling a demurrer of the defendant and was as follows:

The broad proposition advanced by the defendant that section 4929 of the Revised Statutes was not intended to apply to structures having movable parts is not supported by the citation of any judicial decision; and though certain rulings of the Patent Office (*ex parte* Tallman, *ex parte* Adams, *ex parte* Smith, *ex parte* Brower) are presented to support this proposition, I am of the opinion that such a construction of the statute calls for an unwarranted and unreasonable limitation of the terms "manufacture" and "any article of manufacture" and leads to absurd and unjust results. For instance such a construction would defeat claims like those in *Burton vs. Town of Greenville* 3 Fed. 642, and *Britton vs. Manufacturing Co.* 61 Fed. 94. To the objection of the defendant that the parts have no necessary single, infallible, and fixed rela-

tions to each other, it is sufficient to say that the complainant *describes* and shows in his drawing a single and definite arrangement of parts. Therefore, even upon the narrowest construction of his patent, he is *prima facie* entitled to the design, configuration, or shape, resulting from that special arrangement of parts exhibited in the drawing.

One of the adjudications referred to by the Court, namely *Burton vs. Greenville* 3 Fed. 642, involved the validity of a design patent No. 10,497, February 19, 1878, copy of which is also appended hereto. This design patent covered a street or park lamp wherein the lamps were supported for vertical movement on a post and carried by chains that are hidden by the post. The lamp in other words was practically a machine in that the lamps proper were susceptible of raising and lowering and when lowered certain parts were exposed to view not exhibited when the lamps were raised. Nevertheless, this patent was sustained, and the adjudication maintaining its validity, as well as the decision above quoted at length, are practically the only adjudications of the courts that have been rendered on points involved in this petition, and certainly sustain the position of petitioners that they are entitled to a design patent for the study chair as submitted in their application, without elimination of any parts of the construction thereof.

CONCLUSION

In conclusion we respectfully represent to your Honor that there is no basis in law or in reason for the arbitrary limitation of the scope of a design patent according to the prior decisions of the Patent Office which the Examiner of Designs presses as applicable to this case, but which decisions have not been followed in any fair sense whatever by the actual practise of the grant of design patents. There is no reason why a design patent should not as well cover a machine, or a structure composed of detachable or movable parts, as any other organization of parts. The test of infringement of a design patent is similarity in form or artistic design between the articles of the design patent and that alleged to infringe same. Certainly a machine constructed with a view to an appeal to the artistic or aesthetic is as much entitled to design patent protection as any other article of manufacture in the absence of any contrary provision of the law, and the purposes of the law may be just as well subserved in the protection of such designs as other designs of a more conventional nature in respect to unit construction. It is believed that the condition of the design patent practise to-day is such that the Examiner of Designs must indeed find himself in a difficult position to know just what

limitations he must place upon himself in the grant of design patents, and just how far he is entitled to go in extending the protection of the design law to machines or constructions embodying a number of parts but organized especially with a view to the artistic and the aesthetic. For the foregoing reasons, it is earnestly hoped that your Honor will consider this petition favorably and will lay down in a positive and unmistakable manner your interpretation of the law such that the present chaotic condition of the design practise may be removed, and a practise based on clear-cut construction of the law and on principles equitable to the public established.

Respectfully submitted,

DOE & DOE,
Attorneys for Petitioners.

Washington, D. C.

NOTE: Briefs on petitions of this character are filed at the oral hearing or with petition.

DEPARTMENT OF THE INTERIOR
UNITED STATES PATENT OFFICE

Washington

May 4, 1915.

In the matter of the
Application of
Roe & Roe
Design for Combination
Study Chair;
Filed March 21, 1914
Serial No. 826,419

} Petition.

Sirs:

Please find enclosed herewith a copy of a decision of the First Assistant Commissioner in the above entitled case.

By direction of the Commissioner.

Very respectfully,

W. F. WOOLARD,
Chief Clerk.

Roe & Roe,
Care of Doe & Doe,
Southern Building,
Washington, D. C.

Hearing: September 10, 1914.

SET

IN THE UNITED STATES PATENT OFFICE

Ex parte Edwin O. Roe and Edwin W. Roe

Application for Design Patent

PETITION

Combination Study Chair

Application filed March 21, 1914, No. 826,419.

Messrs. Doe & Doe for applicants.

This is a petition from the rejection by the Examiner of a design claim for a chair having relatively fixed seat, arms, and legs, but an adjustable back, book rest, etc., the refusal being based on the ground that the device covered has relatively moving parts.

The rejection is appealable to the Board of Examiners-in-Chief, but since the Examiner has joined with applicants in requesting a ruling on this point, the petition will be considered on its merits.

I find a divergence in the trend of recent decisions of the Patent Office and those of the courts on this point. Symons on Patents for Designs, page 29, correctly gives the substance of the Office decisions as follows:

In *ex parte Smith* (81 O. G., 969; 1897 C. D., 170), it was decided that an atomizer was not proper subject matter for protection under the design statute because of the presence of movable parts which when moved changed the appearance of the device. It apparently was the view of the Commissioner that if the movable handle was removed it would not be objectionable as presented and a patent was subsequently issued on this application for an atomizer body. (Design Patent No. 30,293, DeWane B. Smith.) In the case of *ex parte Tallman* (82 O. G., 337, 1898 C. D., 10) a design patent for a can-opener was refused on the ground that the knife forming a part of it was a movable part and when shifted the shape or contour of the article was changed. A patent for a can-opener body was subsequently issued on this application (Design Patent No. 28,232, Tallman). A pair of tongs consisting of two members of the same shape pivoted together is an operative device and not within the purview of the design laws. (Kapp, 83 O. G., 1993; 1898 C. D., 108.) In this case the Commissioner stated:

If applicants have invented and produced anything that is novel, it is not a pair of tongs, but the shape or configuration of a member or jaw of a pair of tongs. The description and claim should be limited to this.

In the case of *ex parte Adams* (84 O. G., 11), and *ex parte Steck* (98 O. G., 1228) a design for truck side frames and for a frame for water towers, respectively, were held not patentable in that they were apparatuses having movable parts.

On the other hand, Judge Brown in *Chandler Adjustable Chair and Desk Co. vs. Heywood Bros. et al.*, 91 Fed. Rep. 163, in passing on design patent No. 27,272, held:

The broad proposition advanced by the defendant, that section 4929 of the Revised Statutes was not intended to apply to structures having movable parts, is not supported by the citation of any judicial decision; and, though certain rulings of the Patent Office (*ex parte Tallman*, 82 O. G. 337; *ex parte Adams*, 84 O. G., 311; *ex parte Smith*, 81 O. G., 969; *ex parte Brower* [1873] C. D., 151) are presented to support this proposition, I am of the opinion that such a construction of the statute calls for an unwarranted and unreasonable limitation of the terms "manufacture" and "any article of manufacture," and leads to absurd and unjust results. For example, such a construction would defeat claims like those in *Burton vs. Town of Greenville*, 3 Fed. 642, and *Britton vs. Manufacturing Co.*, 61 Fed. 94.

The design statute, Section 4929, provides that:

Any person who has invented any new, original, and ornamental design for an *article of manufacture*, . . . may obtain a patent therefor.

There seems to be no good reason for laying down a hard and fast rule that design patents can not be granted to cover devices with relatively movable parts. It is a well known fact, for example, that carriage, buggy and automobile builders are constantly striving to produce graceful and pretty designs for carriages, buggies, and automobiles as entireties, including the wheels. Pump makers exercise as much invention in producing new and artistic designs for pumps, including their relatively movable handles, as do stone workers in producing new designs for tombstones. According to sound principles of construction, the design statute should not be so construed as to deny protection to the former and extend it to the latter unless its terms are clearly to that effect, and they are not.

It is always easier to practise by rules than by the spirit of a statute, but the latter produces more equitable results and there are no great obstacles in applying the spirit of the design and mechanical sections of the patent statutes to inventions as they are presented to determine whether they fall under one statute or the other. The patentable characteristics of a design protectable under Section 4929 are found, weighed and valued by the

test of ornament. Those of a mechanical device protectable under Section 4886 are recognized by what they contribute to the performance of the function of that device, and the Office should only grant design patents for the former and mechanical patents for the latter unless the device includes both ornamental and useful characteristics, in which case probably both design and mechanical patents may be granted for the same device just as in some cases separate patents may be granted for a machine and a process practised through the instrumentality of the machine or as separate patents may be granted for a process and its product (ex parte Knothe, 102 O. G., 1294).

It has been urged that design patents should not be granted on devices with movable parts because those parts may conceivably be so moved as to produce another design. Admitting this to be true, it is only an apparent and not a substantial reason against this practise, for a design patent only purports to cover the device as shown. The decisions are uniform to the effect that modifications must not be illustrated, but patentees must leave it to the courts to say what modifications (ex parte Remington, C. D., 1905, 28). Similarly, it should be left for the courts to determine when relative movement of the parts of a design produces a different design.

In the present case, I can see no good reason for refusing a design patent on applicants' chair merely because its back may be raised or lowered, or the book support relatively moved, or even that the parts may be so moved as to produce a different design. It may be, however, that these relatively movable parts are intended primarily to produce a useful result as distinguished from an aesthetic result, and if so, the chair should be the subject of a mechanical patent, instead of a design patent. I only decide at this time that simply because it has moving parts should not preclude the grant therefor of a design patent, and to the extent indicated the petition is granted.

J. T. NEWTON,
First Assistant Commissioner.

May 4, 1915.

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