

ments may be joined in the same application.<sup>4</sup> Where several parts of the original have been improved, and such improvements can be so far treated as but one invention as to be properly included in a single Claim, the entire Claim is void if either of the alleged improvements happens to be old.<sup>5</sup> A Claim for the whole invention, when the advance is only an improvement, is invalid, though limited to the invention "as improved."<sup>6</sup> In construing a Claim for an improvement the original is always kept in view, and such an interpretation given to the Claim, if possible, as will protect the actual improvement made.<sup>7</sup>

§ 535. The Claim for a Generic Invention: its Scope.

Several distinct inventions often occupy toward some other invention the relation of species to a genus. A generic invention is one in which are represented the essential characteristics of a group of arts or instruments, each of which, in addition to the characteristics common to the group, possesses other specific characteristics which distinguish it from all the rest. The same invention may be generic to the individuals of its own genus, and specific in its relations to some wider invention representing the group to which itself belongs. Thus an invention consisting in the use of a class of substances for a certain purpose is generic as to an invention consisting in the use for the same purpose of some particular substance of that class; and the latter is, in its turn, generic toward an invention consisting in the use for the same purpose of some specific quality of that particular substance.<sup>1</sup> A patent for

<sup>4</sup> See § 478 and notes, *ante*.

<sup>5</sup> That when the Claim covers several associated improvements it is void if either be old, see *Heinrich v. Luther* (1855), 6 McLean, 345; *Moody v. Fiske* (1820), 2 Mason, 112; 1 Robb, 312.

<sup>6</sup> That where the invention is an improvement it alone can be patented, and a Claim for the whole art or instrument is void, see *Johnston Ruffler Co. v. Avery Mach. Co.* (1886), 28 Fed. Rep. 193; *Phillips v. Page* (1860), 24 How. 164; *Woodcock v. Parker* (1813),

1 Gallison, 438; 1 Robb, 37; *contra*, *Goodyear v. Matthews* (1814), 1 Paine, 300; 1 Robb, 50. See also §§ 513 and notes, *ante*, and 537 and notes, *post*.

<sup>7</sup> That if a fair interpretation shows that only the improvement is claimed the patent is valid, see *McAlpine v. Mangnall* (1846), 3 C. B. 496.

§ 535. <sup>1</sup> That a patent for the use of a substance in a process is generic in relation to a patent for the use of that substance when of a certain quality, see *Slade v. Blair* (1880), 17 O. G. 261.

the genus always covers the species, and hence every subsequent inventor of a specific invention, though entitled to protection for what he has himself conceived, holds his exclusive privilege subject to the general rights of the inventor of the generic invention.<sup>2</sup> As the creation of each one of the specific inventions includes the creation of all the characteristics common to the group, the inventor of any of the species may obtain a patent covering the genus, unless some other inventor has previously conceived the same fundamental idea, and is using due diligence in reducing it to practice.<sup>3</sup> These relations between inventions and the rights which grow out of them require attention when the Claims of patents are to be stated or construed.

**§ 536. The Claim for a Generic Invention may be Joined with a Claim for One Species.**

Where an invention possesses only the characteristics common to the group, it represents the genus as distinguished from the species, and its description will support only a generic Claim.<sup>1</sup> If in addition to these common characteristics it has special qualities of its own, it represents one species as well as the genus, and its description will support a specific as well as a generic Claim. In this case a generic Claim alone would leave the peculiar characteristics of the species unprotected; while a specific Claim alone would limit the patent to an invention having both the common qualities of

<sup>2</sup> That a patent claiming the genus covers all subsequent patents claiming only the species, see *Ex parte Ewart* (1880), 17 O. G. 448.

That a specific Claim is always subject to the generic, see *Walsh v. Shinn* (1879), 16 O. G. 1006.

That generic Claims do not cover functions and results, see *Ex parte Beavis* (1879), 16 O. G. 1233.

<sup>3</sup> That an inventor of a species before any one else invents the genus, or any other species, may claim the genus also, see *Ex parte Gardner* (1880), 17 O. G. 626; *Ex parte Ewart* (1880), 17 O. G. 448.

That no patent with generic Claims can be granted after one with a Claim for the species, see *Ex parte Upton* (1884), 27 O. G. 99.

That a generic patent must describe one or more species, see *Ex parte Wilson* (1879), 16 O. G. 95.

§ 536. <sup>1</sup> That a generic Description will support only a generic Claim, see *Ex parte McClintock* (1880), 17 O. G. 267.

That generic Claims do not cover effects, see *Ex parte Beavis* (1879), 16 O. G. 1233.



the genus and the particular qualities of the species, the genus being thus left open to the public.<sup>2</sup> The description of both genus and species will not prevent this result in the absence of a proper Claim for each; and where the description is either generic alone or specific alone the phrase "substantially as described" in the Claim confines the Claim to the generic or specific invention thus described.<sup>3</sup> Where the common characteristics of the genus constitute an operative means the genus and each one of its species are distinct inventions, and every member of the group is also an invention by itself, apart from and independent of the others.<sup>4</sup> The joinder of Claims for two or more of these must depend on their connection with each other under the usual rules upon that subject; though where the same invention represents the genus and one species, both a generic and a specific Claim may be inserted. That several species are described as embraced under the genus does not extend this power of joinder, nor does the statement in the Description that one of two described species is the best deprive the inventor of the right to claim the other and leave that unclaimed.<sup>5</sup>

<sup>2</sup> That no specific Claim can be made unless the species is described, see *Ex parte McClintock* (1880), 17 O. G. 267.

That a Claim for a species limits the patent to that species, though the Description covers a generic invention, see *Hawes v. Gage* (1871), 5 O. G. 494.

<sup>3</sup> That when the Description is specific the Claim for the invention "substantially as described" covers the species only, see *Ex parte Ewart* (1880), 17 O. G. 448.

<sup>4</sup> That a genus and each of its species are distinct inventions, see *Ex parte McClintock* (1880), 17 O. G. 267.

<sup>5</sup> In *Ex parte Ewart* (1880), 17 O. G. 448, Paine, Com. : (449) "While two species can be set forth by way of illustration in one Description, they cannot both be set forth either in separate specific Claims in one patent or in one specific Claim; nor can both or either

of them be set forth in a generic Claim. Both cannot appear in separate specific Claims in one patent, for that would admit two distinct and independent inventions into one patent. Both cannot appear in one Claim, for that would make the Claim as well as the patent double. One cannot be so shown in a generic Claim, for that would transform it into a specific Claim. Both cannot appear in a generic Claim, for they would make the Claim double as well as specific. A Claim cannot be framed to cover generically several specific inventions by merely aggregating specific Claims for those inventions. Its terms must be broad enough to cover both without specifically claiming either, and yet not broad enough to trench upon any distinct genus."

See also *Ex parte McClintock* (1880), 17 O. G. 267; *Ex parte Morrison* (1879), 16 O. G. 359.

That when the steps of an entirety

### § 537. The Claim, when Defective.

A Claim is defective when it fails to define the real invention with sufficient completeness and precision, or when it claims more than belongs to the invention. In the former case the discovery of the inventor is not properly protected.<sup>1</sup> In the latter case the Claim is absolutely void.<sup>2</sup> Both these defects may be, however, remedied by a re-issue, and the latter one is also curable by a disclaimer.<sup>3</sup> When several Claims are inserted in the specification, the presence of a void Claim does not affect those which are good, unless there is an evident intention to mislead the public or an unreasonable delay in filing a disclaimer.<sup>4</sup>

process have equivalents, a generic Claim may cover it under any form, and a specific Claim may cover the specific form, see *Ex parte McDougall* (1880), 18 O. G. 130.

That several devices constructed on the same principle may be described in one application and covered by one generic Claim, but only one device can be specifically claimed, see *Ex parte Howland* (1877), 12 O. G. 889.

That the designation of one of two species as the best does not debar the patentee from claiming the other, see *Ex parte McClintock* (1880), 17 O. G. 267. See also § 471, note 4, *ante*.

§ 537. <sup>1</sup> That the Claim may be valid for what it claims, though it does not claim the full invention, see *Wilson v. Coon* (1880), 19 O. G. 482; 6 Fed. Rep. 611; 18 Blatch. 532; and § 508, note 2, *ante*.

<sup>2</sup> That a Claim exceeding the limits of the actual invention is void, see *Milligan v. Lalancé & Grosjean Mfg. Co.* (1884), 29 O. G. 367; 21 Fed. Rep. 570; *Scott v. Ford* (1878), 14 O. G. 413; *Winans v. N. Y. & Erie R. R. Co.* (1856), 1 Fisher, 213; *Heinrich v. Luther* (1855), 6 McLean, 345; *Holliday v. Rheem* (1852), 18 Pa. St. 465; *Davis v. Bell* (1837), 8 N. H. 500; *Whitney v. Emmett* (1831), Baldwin,

303; 1 Robb, 567; *Watson v. Bladen* (1826), 4 Wash. 580; 1 Robb, 510; *Kneass v. Schuylkill Bank* (1820), 4 Wash. 9; 1 Robb, 303.

<sup>3</sup> That an excessive Claim is curable by re-issue or disclaimer, see *Silsby v. Footo* (1857), 20 How. 378; *Hovey v. Stevens* (1846), 3 W. & M. 17; 2 Robb, 567; *Peterson v. Wooden* (1843), 3 McLean, 248; 2 Robb, 116; *Stanley v. Whipple* (1839), 2 McLean, 35; 2 Robb, 1. See also §§ 642-646 and notes, *post*.

That an incomplete or inexact Claim may be cured by re-issue, see §§ 656, note 3, 668, notes 5 and 6, and 693 and notes, *post*.

That a disclaimer in a pending application must not contradict but explain and limit the Claim, see *Ex parte Hobson* (1872), 1 O. G. 141.

<sup>4</sup> That the presence of void Claims in a patent does not impair the effect of good Claims, see *Tyler v. Galloway* (1882), 22 O. G. 2072; 12 Fed. Rep. 567; 20 Blatch. 445; *Christman v. Rumsey* (1879), 58 How. Pr. 114; 17 Blatch. 148; 17 O. G. 903; 4 Bann. & A. 506; *Burdett v. Estey* (1878), 15 O. G. 877; 15 Blatch. 349; *Russell v. Place* (1876), 94 U. S. 606; 12 O. G. 53; *Carlton v. Bokee* (1873), 17 Wall. 463; 2 O. G. 520; 6 Fisher, 40; *Ca-hart v. Austin* (1865), 2 Fisher, 543;



**§ 538. The Claim, as Corrected or Allowed in the Patent Office, Determines the Validity and Scope of the Patent.**

It is the duty of the Patent Office to secure the correct statement of the Claims before it allows the issue of a patent.<sup>1</sup> That the courts might sustain a defective Claim, in order to prevent the defeat of a granted patent, is no reason for permitting such a Claim to pass the scrutiny of the department.<sup>2</sup> The Claim is to define what the Patent Office, after due examination, has ascertained to be the real discovery of the inventor, and it must be amended or withdrawn according to the judgment of the officers to whom this duty is committed. Once settled in its terms by their decision, the courts will not disturb it, either by interfering with its language or by narrowing or enlarging it by construction.<sup>3</sup>

**§ 539. The Specification: its Signature: Erasures and Corrections.**

The specification must be signed by the inventor, or by his executor or administrator, and the signature must be attested

<sup>2</sup> Clifford, 528; *Singer v. Walmsley* (1860), 1 Fisher, 558.

That void Claims may be disclaimed, see *Tyler v. Galloway* (1882), 22 O. G. 2072; 12 Fed. Rep. 567; 20 Blatch. 445.

That where of two Claims one is too broad under one interpretation, and under another is a mere repetition of a former Claim, it is void and must be disclaimed, see *Tyler v. Galloway* (1882), 22 O. G. 2072; 12 Fed. Rep. 567; 20 Blatch. 445.

That unreasonable delay in disclaiming void Claims will vitiate the entire patent, see *McCormick v. Seymour* (1854), 3 Blatch. 209; *Hall v. Wiles* (1851), 2 Blatch. 194; and notes to § 646, *post*.

§ 538. <sup>1</sup> That it is the duty of the Patent Office to see that Claims are correct, see *Keystone Bridge Co. v. Phoenix Iron Co.* (1877), 95 U. S. 274; 12 O. G. 980.

<sup>2</sup> That the courts may sustain Claims which the Patent Office ought not to allow, see *Ex parte Cornell* (1872), 1 O. G. 573.

That though the courts may sustain defective Claims the Patent Office has no right to permit them, see *Ex parte McDougall* (1880), 18 O. G. 130.

<sup>3</sup> In *Burns v. Meyer* (1879), 100 U. S. 671, Bradley J. : (672) "It is well known that the terms of the Claim in letters-patent are carefully scrutinized in the Patent Office. Over this part of the specification the chief contest generally arises. It defines what the Office, after a full examination of previous inventions and the state of the art, determines the applicant is entitled to. The courts, therefore, should be careful not to enlarge, by construction, the Claim which the Patent Office has admitted, and which the patentee has acquiesced in, beyond the fair interpretation of its terms."

See also §§ 738-743 and notes, *post*.

That a Claim cannot be dissected and accepted or rejected piecemeal, but must stand or fall together, see *Ex parte Smith* (1872), 1 O. G. 403.

by two witnesses, each signing his full name, legibly written.<sup>1</sup> The Description and Claims, and all amendments thereof, must be written in a clear and readable hand on one side of the paper only; and all interlineations and erasures must be marked in marginal or foot notes written on the same sheet of paper, for which purpose a wide margin should be reserved on the left-hand side of the page. Legal-cap paper, with the lines numbered, is recommended by the Office.

## SECTION VII.

### OF THE APPLICATION: THE DRAWINGS AND MODEL.

#### § 540. Drawings, Model, and Specimens: when Required.

In order to secure still greater accuracy and completeness in the description of that art or instrument for which the inventor claims the protection of a patent, the law requires him to furnish drawings, and a model or specimens, illustrating its distinctive characteristics, whenever in the judgment of the Patent Office the case demands them. The requirement of the statute in reference to drawings is positive, and the applicant must file them if the nature of the invention permits.<sup>1</sup> Those in reference to the model and specimens are conditional upon the order of the Commissioner, and the applicant is not obliged to furnish them unless especially directed. But as the question whether the nature of the case admits of drawings is finally determined by the Commissioner, and his decision as to their sufficiency, as well as that of the specimens or model, is conclusive,<sup>2</sup> the practical difference in this respect between these several requirements is insignificant, affecting merely the order of proceedings in the Office.

§ 539. <sup>1</sup> That the applicant must sign his first name in full, see *Ex parte Gentry* (1888), 44 O. G. 822.

§ 540. <sup>1</sup> That a drawing must be filed whenever the nature of the invention permits, see *Ex parte Chase* (1879), 16 O. G. 809.

<sup>2</sup> That the decision of the Commissioner that drawings were duly presented is final except on proceedings to avoid the patent, see *Hoe v. Cottrell* (1880), 17 Blatch. 546; 18 O. G. 59; 1 Fed. Rep. 597; 5 Bann. & A. 256.

See also § 423 and notes, *ante*.



**§ 541. Drawings must Correspond with Specification.**

The drawings filed must correspond with the specification in all the essential characteristics of the invention.<sup>1</sup> They are but another method of portraying the same art or instrument therein described in words, and a discrepancy between the two delineations may give rise to such an ambiguity in the entire description as renders the patent void.<sup>2</sup> They are connected with the specification by means of figures affixed to each drawing, and letters or figures affixed to each of its several parts, and so referred to in the language of the Description and the Claim that the verbal and pictorial representations will serve to illustrate and explain each other.<sup>3</sup>

**§ 542. Drawings to be so Clear and Full as to Supply the Place of a Model.**

The drawings filed must be so full and clear that, if the invention is a simple one, no model will be needed.<sup>1</sup> The model, being retained in the Patent Office after the patent issues, is inaccessible to the public without recourse to the place of its deposit. The drawings, on the contrary, through the copies annexed to the patent, and published in the "Gazette," or supplied on application by the Office, circulate in every direction and are open to inspection by all persons interested in the art to which the invention may belong. In pursuance of its duty to disseminate in the widest degree immediate information concerning all inventions, the Patent

§ 541. <sup>1</sup> That the drawings must correspond in all essential points with the specification, see *Ex parte Witty* (1884), 29 O. G. 862; *Ex parte Schoonmaker* (1878), 13 O. G. 595.

That the drawings must show every feature claimed, see *Ex parte Crandall* (1886), 35 O. G. 625.

<sup>2</sup> That the drawings may show the invention where the specification fails to do so, see *Banker v. Bostwick* (1880), 18 O. G. 61.

That all patentable matter shown in the specification, drawings, or model is covered by the application, see

*Singer v. Braunsdorf* (1870), 7 Blatch. 521.

That an imperfect description coupled with incomplete drawings make the patent void, see *New Process Fermentation Co. v. Koch* (1884), 29 O. G. 535; 21 Fed. Rep. 580.

<sup>3</sup> That under the act of 1793, the drawings need not have been referred to in the specification, see *Emerson v. Hogg* (1845), 2 Blatch. 1.

§ 542. <sup>1</sup> That in simple inventions the drawings must be sufficient to supply the place of a model, see *Ex parte Jovè* (1880), 17 O. G. 801.

Office properly requires that the drawings shall, as far as possible, supply the place of a model; and this in simple inventions, with the present facilities for pictorial representation, they are fully competent to do. In complicated structures, incapable of complete perspective reproduction on a plane surface, a model becomes necessary.

§ 543. **Drawings: General Requisites in each Class of Inventions.**

The drawings must exhibit every feature of the invention covered by the Claims; otherwise the language of the specification would set forth a different art or instrument from that depicted in the drawings, resulting in an ambiguity which might be fatal to the patent. In the drawings which accompany the specification for an art, every stage or sub-process capable of illustration by a drawing must be shown; but the different steps of a sub-process do not require such delineation.<sup>1</sup> In a machine or manufacture, the drawing must disclose all the essential parts in their proper places, as they would appear in the practically operative instrument.<sup>2</sup> The drawings of an improvement must exhibit, in one or more views, the improvement itself disconnected from the old structure, and also in another view so much only of the old structure as will suffice to show the connection of the improvement therewith.<sup>3</sup> A design must be shown by a drawing or a photograph, in which all the distinctive characteristics of the new configuration or ornamentation are depicted. But while the drawings must thus present every feature of the claimed invention to the eye, they need not be working-drawings nor on an operative scale.<sup>4</sup> They are not intended as a guide to the

§ 543. <sup>1</sup> That in an application covering an art every claimed stage or sub-process must, if possible, be illustrated by drawings, but not the several steps of each sub-process, see *Ex parte Carter* (1879), 16 O. G. 809.

<sup>2</sup> That a drawing must accompany an application covering an article of manufacture, see *Ex parte Chase* (1879), 16 O. G. 809.

<sup>3</sup> That in a patent covering an improvement in machinery, drawings of

the improvement are necessary, see *Burrall v. Jewett* (1830), 2 Paige (N. Y.), 134.

That in an application covering an improvement, the improvement must be shown by a model and drawings, but not the original when it is well known to the public or its description is accessible, see *Ex parte Tracy* (1875), 8 O. G. 144.

<sup>4</sup> That the drawings need not be working-drawings nor on an operative scale, see *American Hide & Leather*



mechanic in constructing the invention further than that, in connection with the written specification, they put him in possession of such knowledge of the essential attributes of the invention that through his own skill in the art he can practically create it and employ it.

**§ 544. Drawings: Special Rules Governing their Artistic Perfection.**

To render the drawings suitable for the various uses of the Patent Office they are required to attain, in their execution, to a uniform standard of excellence; and for this purpose they must conform to certain rules from time to time prescribed by the department. These rules relate chiefly to the size, materials, arrangement, and lettering of the several views given of the invention, and may be found stated at length in the published regulations of the Office. These rules are rigorously enforced, since unless it conforms to them a drawing is practically worthless; and until complied with by the applicant his case will not receive consideration. The drawing must be signed, like the specification, by the inventor or his attorney in fact, and attested by two witnesses;<sup>1</sup> their full names being given and legibly written.

**§ 545. Model not Filed until Ordered by the Patent Office.**

A model is not required until an examination of the application in the Patent Office shows it to be necessary to the full disclosure of the essential characteristics of the invention. When thus required, notice to that effect is sent to the applicant and proceedings on his application are suspended until it is furnished. A model filed, when not required, is returned to the inventor. No model of a design is requisite where it can be sufficiently represented by photographs or drawings.

**§ 546. Model: its General Requisites.**

A model must clearly exhibit every feature of the invention which forms the subject of a Claim, but should not include

*Splitting & Dressing Mach. Co. v. American Tool & Mach. Co.* (1870), 4 Fisher, 284; *Holmes*, 503. the act of 1836, could be signed either by the inventor or his authorized agent, see *Opinion Atty. Gen.* (1859), 9 Op. At. Gen. 378.

§ 544. <sup>1</sup> That the drawings, under

any other matter than that covered by the actual invention, unless it be necessary to the representation of the invention in a working model.<sup>1</sup> A working model is often desirable in order to enable the examiner to understand the precise operation of the new invention. The model must be neatly and substantially made of durable material, metal being preferred, unless the material is an essential feature of the invention, in which case the model must, of course, conform to this as well as to the other characteristic attributes of the idea of means. The size and finish of the model, with various other minor requisites, must correspond with the regulations from time to time established by the Patent Office, by whose decision the sufficiency of the model is conclusively determined.<sup>2</sup>

**§ 547. Model: its Final Disposition.**

When an application is rejected in the Patent Office, and more than two years have elapsed since such rejection, the model will be returned to the applicant upon demand, at his expense, unless it is deemed necessary to preserve it in the Office. When an applicant formally abandons a pending application and files a certificate to that effect, duly signed by him, the model will be restored. Where a patent is granted, the model remains permanently in the Patent Office, and cannot be removed therefrom except in the custody of some sworn employee of the Office, authorized for that purpose by the Commissioner.

**§ 548. Model: its Relation to other Parts of the Application.**

The filing of a model does not constitute the filing of an application, nor is it any evidence that the application is complete.<sup>1</sup> Each portion of the application must be judged by

§ 546. <sup>1</sup> That the model must correspond with the specification and drawings in all essential particulars, see *Ex parte* Schoonmaker (1878), 13 O. G. 595.

That the model must clearly show every feature claimed, see *Ex parte* Crandall (1886), 35 O. G. 625.

<sup>2</sup> That the decision of the Commissioner that the model was duly pre-

sented is conclusive except on proceedings to set the patent aside, see *Hoe v. Cottrell* (1880), 17 Blatch. 546; 18 O. G. 59; 1 Fed. Rep. 597; 5 Bann. & A. 256.

§ 548. <sup>1</sup> That the filing of a model is not the filing of an application, see *Henry v. Francetown Soapstone Stove Co.* (1880), 17 O. G. 569; 5 Bann. & A. 108; 2 Fed. Rep. 78; *Draper v. Wat-*



itself so far as regards its correspondence with established rules, although on questions of interpretation the entire application is considered. A sufficient model does not validate an imperfect Description nor an improper Claim, nor supply the place of an accurate drawing. Only when the complete application is presented to the Patent Office, with every part perfect in itself, has the applicant any standing before the department or any right to have his application duly examined and adjudged.

**§ 549. Specimens, instead of Drawings or Model, Required in Applications Covering Compositions of Matter.**

A composition of matter not being capable of representation by drawings or model, the law requires the applicant to forward to the Patent Office, on the request of the Commissioner, such specimens of the ingredients and of the composition as will be sufficient for the purpose of experimentally showing the essential features of the invention.<sup>1</sup> In all cases where the article is not perishable, a specimen of the composition claimed, put up in proper form to be preserved by the Office, must be furnished.

**SECTION VIII.**

**OF THE APPLICATION: FILING AND FEES.**

**§ 550. Filing of Application the Commencement of Proceedings to Obtain a Patent.**

The act by which the attention of the Patent Office is directed to the claims of the inventor, and his right to an examination of those claims is secured, is the filing of the application with the Commissioner of Patents. This may be

ties (1878), 16 O. G. 629 ; 3 Bann. & A. 618.

That the filing of a model does not show that the application is complete, see *Draper v. Wattles* (1878), 16 O. G. 629 ; 3 Bann. & A. 618.

§ 549. <sup>1</sup> That whether specimens of

ingredients shall be filed with an application is for the Patent Office to decide, see *Anilin v. Cochrane* (1879), 16 Blatch. 155 ; 4 Bann. & A. 215 ; *Tarr v. Folsom* (1874), Holmes, 312 ; 5 O. G. 92 ; 1 Bann. & A. 24.

done at any time after the invention is completed, provided no abandonment has taken place;<sup>1</sup> but until it is done the Office can take no notice of the invention further than to allow the inventor access to its library, records, and models, and to supply him with such copies of them as he may desire.

§ 551. **Filing of Application: in What it Consists.**

An application is filed when the petition, oath, and specification are presented in writing to the Commissioner, accompanied by such drawings as the nature of the case admits, and by such model or specimens as the Commissioner may himself require.<sup>1</sup> Neither the filing of a model, nor the writing of an application, nor the placing of the case in the hands of an attorney with instructions to apply for a patent, constitutes the filing of an application.<sup>2</sup> Nor is an application filed until all its parts have been received. It is desirable that these should be presented at the same time, and that all the papers embraced in the application should be attached together. If this is not done, each part must be accompanied by a letter accurately and clearly connecting it with the parts previously forwarded. An application not completed by the presentation of all its parts within two years from the lodgment

§ 550. <sup>1</sup> That the application may be filed at any time after the invention is completed, unless it has been abandoned, see *Shaw v. Cooper* (1833), 7 Peters, 292; 1 Robb, 643.

See also § 351 and notes, *ante*.

§ 551. <sup>1</sup> That the application is filed when presented to the Commissioner, see *Henry v. Francetown Soapstone Stove Co.* (1880), 5 Bann. & A. 108; 17 O. G. 569; 2 Fed. Rep. 78; *Graham v. McCormick* (1880), 5 Bann. & A. 244; 10 Bissell, 39; 21 O. G. 1533; 11 Fed. Rep. 859.

<sup>2</sup> That filing a model is not filing an application, see *Henry v. Francetown Soapstone Stove Co.* (1880), 5 Bann. & A. 108; 17 O. G. 569; 2 Fed. Rep. 78; *Draper v. Wattles* (1878), 16 O. G. 629; 3 Bann. & A. 618.

That writing an application is not

filing it, see *Henry v. Francetown Soapstone Stove Co.* (1880), 5 Bann. & A. 108; 17 O. G. 569; 2 Fed. Rep. 78.

That placing the invention in the hands of solicitors to have an application filed is not filing it, see *Graham v. McCormick* (1880), 10 Bissell, 39; 11 Fed. Rep. 859; 21 O. G. 1533; 5 Bann. & A. 244.

That to sign a blank application and forward it to solicitors to be filled out and filed, and their filing it is not such filing as the law requires, see *Ex parte Benton* (1882), 23 O. G. 341.

That the decision of the Commissioner that the application is properly filed cannot be collaterally attacked, see *Hoe v. Cottrell* (1880), 18 O. G. 59; 17 Blatch. 546; 1 Fed. Rep. 597; 5 Bann. & A. 256.

See also § 423 and notes, *ante*.



of the petition in the Patent Office is regarded as abandoned, unless the delay is shown to have been unavoidable.<sup>3</sup>

**§ 552. Application, once Filed, thereafter Known by Date and Number.**

When all the required parts of an application have been thus presented, it is placed on file for examination and a serial number given it, notice of which is sent to the applicant. Thenceforth the application is known both to the Office and to the inventor by its number, as well as by the title of the invention, and in all his correspondence with the Office concerning it, the inventor or his attorney must define the subject-matter of his communication by stating the name of the applicant, the title of the invention, the serial number of the application, and the date when it was filed.

**§ 553. Application, once Filed, not Withdrawn: Preserved in Secrecy.**

After an application is completed, the specification cannot be withdrawn from the Patent Office for any purpose whatever, though the model or the drawing may be returned to the applicant for such corrections as are deemed necessary. A copy of the specification may, however, be obtained by the inventor or his attorney. From all other persons outside of the department every part of the application is preserved in secrecy,<sup>1</sup> and no information is given concerning it to any one without due authority from the inventor, except in interference cases, or when the application has been rejected or

<sup>3</sup> That under the act of 1861 (Sec. 4894, Rev. Stat.), providing that all applications must be completed within two years unless the Commissioner is satisfied that the delay is unavoidable, if the application is delayed longer than two years and is then allowed, the decision of the Commissioner in allowing it is conclusive on the question of the reasonableness of the delay, see *McMillin v. Barclay* (1872), 5 Fisher, 189; 4 Brews. (Pa.) 275. See also § 578 and notes, *post*.

That an invention is not abandoned while the application lies unfiled in the hands of the attorney, unless the inventor knows of the neglect, see *Birdsall v. McDonald* (1874), 1 Bann. & A. 165; 6 O. G. 682.

§ 553. <sup>1</sup> That pending applications must be kept secret, see *Ex parte Neale* (1879), 15 O. G. 511.

That the rule requiring secrecy is reasonable and should be enforced, see *Dec. Sec. Int.* (1883), 23 O. G. 629.

abandoned, and in the judgment of the Commissioner its disclosure may be necessary.

**§ 554. Payment of Fees.**

The payment of the fees required by law is made by statute a condition of the issue of the patent, and the rules of the Patent Office prescribe their payment in advance, though when a patent issues before compliance with this requisite, it is not on that account invalid.<sup>1</sup> The fees may be paid to the Commissioner, or to the Treasurer or an Assistant Treasurer of the United States, or to any of the depositaries, national banks, or receivers of public money designated by the Secretary of the Treasury for that purpose, whose receipt, transmitted to the Patent Office, will be accepted as sufficient evidence of payment. Payment may also be made by postal order, or by money mailed to the Department. Money paid by mistake, or in excess of the required amount, will be refunded.

**SECTION IX.**

**OF THE APPLICATION: PROCEDURE IN THE PATENT OFFICE IN UNCONTESTED CASES.**

**§ 555. Examination of Application: Objections to its Form.**

All cases in the Patent Office are divided into certain classes for the purpose of examination and decision; those in the same class being examined and disposed of as far as practicable in the order in which the respective applications are completed, unless the invention is deemed of peculiar importance to some branch of the public service, and the head of a department of the government requests immediate attention to it upon that account. On the receipt of any application in the Office, and the payment of the fee, it is assigned to its proper class, and when its turn arrives is first subjected to an examination to determine whether it is in all respects in proper

<sup>1</sup> That a patent issued without payment of the fees is valid, see *Crompton v. Belknap Mills* (1869), 3 Fisher, 536.



form.<sup>1</sup> If found to be formally sufficient, an examination into the merits of the application, and the patentability of the invention therein claimed, is instituted. But if decided to be insufficient the applicant is notified of the defect, and such information is given to him as will enable him to judge of the propriety of the decision, and if possible to correct his error.<sup>2</sup> Upon this notice he may either supply the alleged defect, or he may insist upon the sufficiency of the application and file a written request for a reconsideration, distinctly and specifically pointing out the errors in the finding of the examiner. From an adverse decision of the examiner, after such reconsideration, the applicant may appeal to the Commissioner in person. Where the faults in the form of the application are not vital the examiner may, if he chooses, withhold the announcement of his decision upon those points, and proceed to consider the application on its merits;<sup>3</sup> but must then, in

§ 555. <sup>1</sup> That the examiner may insist on having the specification correspond with the forms given in the rules, if he does so when the application is first filed, see *Ex parte* Bate (1879), 15 O. G. 1012.

That an examiner ought not to allow cases when the papers are defective, whether the defect is mentioned in the rules or not, see *Ex parte* Benton (1882), 23 O. G. 341.

That where there is a vital defect of form, such as the omission of an element, etc., the application cannot be examined on its merits, see *Ex parte* Mill (1887), 40 O. G. 918; *Ex parte* Silliman (1886), 34 O. G. 1389.

<sup>2</sup> That the Patent Office must act as the friend, not the adversary, of an applicant, and its examiners must aid him to secure his actual invention, see *Ex parte* Donovan (1888), 44 O. G. 698.

That the objections of examiners must be definitely stated to the applicant and the mode of avoiding them be pointed out, see *Ex parte* Wilkins (1883), 24 O. G. 1270.

That for an examiner to say that the

defects are shown by "pencil notes" in the specification is not sufficient, see *Ex parte* Wilkins (1883), 24 O. G. 1270; *Ex parte* Evarts (1874), 5 O. G. 429.

That an applicant may insist on an examination of his application on its merits, in spite of defects in its form, unless the examiner gives him such information as will enable him to remove the defects, see *Ex parte* Templeton (1880), 17 O. G. 910.

<sup>3</sup> That the examination of an application on its merits is not conclusive on the Patent Office as to its correctness of form, see *Ex parte* Farquharson (1876), 10 O. G. 702.

That where a design patent is applied for when a mechanical patent alone is proper, the examiner, if the case is clear, should hold the application and notify the applicant; but if the case, being doubtful, is examined and rejected, a new application must be filed and a new fee paid, see *Ex parte* Bailey (1886), 37 O. G. 781.

That an application for a design patent should be rejected if the examiner

his first letter to the applicant, state all his formal objections with their reasons, and until these are disposed of no judgment can be passed upon the merits, without an order of the Commissioner.<sup>4</sup>

§ 556. Objections on the Ground of Misjoinder: Division of the Application.

When a single application embraces several independent inventions in violation of the rules regarding the joinder of inventions, the applicant will be required to limit his present application to some one of them, and may then file separate applications for the others.<sup>1</sup> If the independence of the inventions is clear on the face of the application, this division must be ordered before any examination on the merits; if not clear, the division may be required at any time when its necessity becomes evident before final action.<sup>2</sup> Whether a division shall be made rests entirely within the judgment of the Patent Office,<sup>3</sup> but none should be ordered unless each of the alleged

considers that the subject-matter is not a design, and from such rejection an appeal lies to the Board of Examiners, see *Ex parte Harris* (1886), 38 O. G. 104.

<sup>4</sup> That the first letter of the examiner must advise the applicant of all formal requirements, cite all references, and instruct him that action on the merits is postponed until the objections are removed, see *Ex parte Mill* (1887), 40 O. G. 918; *Ex parte Silliman* (1886), 34 O. G. 1389.

That all formal matters must be settled before any Claim is rejected on the merits, and no rejection on the merits should be made in terms until all formal questions are determined, see *Ex parte Mill* (1887), 40 O. G. 918; *Ex parte Silliman* (1886), 34 O. G. 1389.

§ 556. <sup>1</sup> That where separate and independent inventions are embraced in one application, it must be divided, see *Ex parte Mill* (1887), 40 O. G. 918; *Ex parte Young* (1885), 33 O. G. 1390; *Ex parte Martin* (1883), 25 O. G. 502; *Ex parte Preston* (1880), 17 O. G. 853;

*Ex parte Siemens* (1877), 11 O. G. 969.

See also §§ 468-479 and notes, *ante*.

That if a combination does not cooperate a division between the elements is necessary, see *Ex parte Herr* (1887), 41 O. G. 463.

That a division must be ordered when two independent inventions are covered, whether the divided inventions would come under any Office class or not, see *Ex parte Martin* (1883), 25 O. G. 502.

<sup>2</sup> That if an application is to be divided, it should be done before an examination on the merits, see *Ex parte Silliman* (1886), 34 O. G. 1389; *Ex parte Young* (1885), 33 O. G. 1390; *Ex parte Rice* (1874), 5 O. G. 522.

That division should not be ordered without sufficient examination to show its necessity, see *Ex parte Sanders* (1878), 13 O. G. 818.

<sup>3</sup> That whether a division is necessary is a question for the Patent Office alone, see *Ex parte Herr* (1887), 41



independent inventions would be a proper subject-matter for a separate patent;<sup>4</sup> and the examiner, in communicating the order to the applicant, must clearly point out to him the nature and extent of the required division, to enable him to file such separate applications if he so desires.<sup>5</sup> The division is effected by an amendment of the original application, confining its Claims, and so far as practicable its Description, to a single invention, and the filing of such additional applications for the other inventions as may be deemed advisable.<sup>6</sup> These additional applications are so far independent of the original that each must be attested by a new oath, and possess all the other prerequisites of a complete application;<sup>7</sup> but

O. G. 463; *McKay v. Dibert* (1881), 5 Fed. Rep. 587; 19 O. G. 1351; *Ex parte Murray* (1873), 3 O. G. 659.

See also § 469 and note 2, *ante*.

That the Patent Office requires a division not merely for its own sake but in order that the patent may be valid, see *Ex parte Van Matteson* (1883), 24 O. G. 389.

<sup>4</sup> That no division can be required unless each invention would be separately patentable, see *Ex parte Pintsch* (1877), 11 O. G. 597.

That in dividing applications the distinction between separable inventions must be regarded, not the mere distinctions between words, see *Ex parte Holt* (1884), 29 O. G. 171.

That where the Claims of two divisions must overlap each other the division is improper, see *Ex parte Holt* (1884), 29 O. G. 171.

That no division can be ordered where the process and product are inseparable, see *Ex parte Holt* (1884), 29 O. G. 171. See also § 473 and note 3, *ante*.

That divisions between parts of the same machine must not cover the same ground, see *Ex parte Holt* (1884), 29 O. G. 171.

That a divisional application cannot be based on new matter added to the

original after filing, see *Ex parte Buell* (1884), 26 O. G. 437.

<sup>5</sup> That in notifying the applicant to divide his application, the examiner must point out clearly the nature and extent of such division, see *Ex parte Knott* (1875), 8 O. G. 238.

That in ordering a division between a process and a product on the ground that the product can be produced by other processes, such other processes must be pointed out by the examiner, see *Ex parte Pastor* (1887), 42 O. G. 95.

<sup>6</sup> That where a division is ordered and matter is eliminated from the specification it must be removed from the drawings also unless necessary to the comprehension of what remains, see *Ex parte Simonds* (1888), 44 O. G. 449.

That where a division is required an amendment which simply reduces the number of the inventions, without removing the objections raised, should not be received, and if admitted only limits the right of the applicant to elect what inventions shall be covered by the application, see *Ex parte Maxim* (1888), 43 O. G. 506.

<sup>7</sup> That each additional application for the divided inventions must be supported by a new oath and possess the

when the patents are allowed, the date of the original application is regarded as the date of all the others, in reference to the questions of priority and public use, in order that the rights of the inventor to his entire invention, as first applied for, may be fully preserved.<sup>8</sup> Where all the inventions so divided relate to the same general subject-matter, and each of the applications thus describes the whole though claiming but a single part, each should disclaim all other portions, with proper references to the applications in which they are claimed.<sup>9</sup>

§ 557. **Model and Specimens Ordered when Found Necessary.**

No preliminary examination of the application is made in the Patent Office to ascertain whether or not a model will be necessary. The application, if complete in other respects, is subjected to an examination on its merits, and if in the course of this examination it appears to the examiner that a model will be useful, an order to furnish one is sent to the applicant, and proceedings are suspended until the order is obeyed. The same rule applies to specimens of a composition and of its ingredients.

other requisites of an independent application, see *Ex parte* Tieman (1877), 11 O. G. 1; *Ex parte* Heginbotham (1875), 8 O. G. 237.

That where an application is filed as a division of a former application, the first duty of the examiner is to see whether it is a legal continuation of the other, see *Ex parte* Buell (1884), 26 O. G. 437.

<sup>8</sup> That where several divisions represent different parts of the same whole, to which all the parts are necessary, all the divisions should be pending at one and the same time, see *Ex parte* Holt (1884), 29 O. G. 171.

That all the divided applications bear the date of the original, see *Graham v. Geneva Lake Crawford Mfg. Co.* (1880), 11 Fed. Rep. 138; 21 O. G. 1536; *Graham v. McCormick* (1880), 11 Fed. Rep. 859; 10 Bissell, 39; 21 O. G. 1533; 5 Bann. & A. 244.

<sup>9</sup> That all divisional applications

must disclaim what they do not claim, see *Ex parte* Clarke (1884), 26 O. G. 824.

That the rules requiring cross-disclaimers in two pending applications for the same general invention re strictly enforced, see *Drawbaugh v. Blake* (1883), 23 O. G. 1221.

That the rules requiring disclaimers in pending applications are directory only, and the issue of one patent is no bar to a second unless the matter is inseparable, see *Ex parte* Roberts (1887), 40 O. G. 573.

That where an application is once divided, the separated matter can never be re-instated, see *Ex parte* Preston (1880), 17 O. G. 853.

That no election binding on the applicant is made until he has complied with the order for a division and his action has been accepted by the Office, see *Ex parte* Maxim (1888), 43 O. G. 506.



§ 558. Examination of Application on its Merits: Two Questions Involved: their Decision.

When an application is complete in form it is entitled to an examination on its merits. This examination consists in an inquiry into the legal right of the applicant to a patent for the invention described and claimed in the application. It involves two questions: (1) Whether the subject-matter of the application is, in itself, a patentable invention; (2) Whether the applicant or his decedent was its true and first inventor. In uncontested cases the latter question is answered affirmatively by the oath of the applicant, and requires no further investigation unless the examiner has some knowledge to the contrary.<sup>1</sup> The former question is divisible into five subordinate ones: (1) Whether the subject-matter of the application is the result of a true and complete inventive act; (2) Whether it is embraced in either one of the six classes of inventions which are made patentable by the act of Congress; (3) Whether it is new, or, on the contrary, has been known or used in this country, or patented or published at home or abroad, before the date of the present application; (4) Whether it is useful; (5) Whether it has been abandoned to the public. In making this investigation the examiner is not compelled to observe the strict rules of evidence, but must ascertain, as best he can, from the publications, patents, and general knowledge at his command, whether the application should be rejected or allowed.<sup>2</sup> He is not bound by any conclusions of his predecessors, though he must follow the deci-

§ 558. <sup>1</sup> That the application-oath is *prima facie* proof of the applicant's priority, see *Ex parte Hill* (1879), 16 O. G. 765.

See also § 457 and notes, *ante*.

<sup>2</sup> That the rules of evidence do not apply to uncontested cases, see *Hedges v. Daniels* (1880), 17 O. G. 394.

That the examiner must ascertain, as best he can, whether the invention is patentable, see *Hedges v. Daniels* (1880), 17 O. G. 394.

That the identity of two designs must be decided from inspection by the

experts in the Office, see *Ex parte Gerard* (1888), 43 O. G. 1235.

That matters of public notoriety, affecting the right of the applicant to a patent will be taken notice of, see *Anson v. Woodbury* (1877), 12 O. G. 1.

That if the examiner sees that the invention is impracticable he should reject the application for want of utility, see *Ex parte De Bausset* (1888), 43 O. G. 1583.

That a patent should not be allowed merely because it can do no harm, see *Ex parte Mixer* (1872), 1 O. G. 48.

sions of the Commissioner both on matters of law and fact, whatever may be his own judgment concerning their propriety.<sup>3</sup> He is also required to conform to the rules laid down by the courts for determining the patentability of inventions. If it appears to him, as the result of his investigation, that the subject-matter of the application is patentable and that the applicant or his decedent was its true and first inventor, it is his duty to allow the application; if the contrary appears, it is his duty to reject it.<sup>4</sup> Where the investigation leaves him in doubt, it is still incumbent on him to decide either for or against the applicant, in order that the patent may be granted, or else an opportunity be given for further inquiry on a reconsideration or an appeal.

#### § 559. Rejection of Application: Notice and References.

When an application, or one of the Claims in an application, is rejected upon any ground whatever the examiner is required to notify the applicant of such rejection, stating all his reasons therefor fully and precisely, and giving him such information and references as may assist him in judging of the advisability of prosecuting his application or of altering his specification.<sup>1</sup> If the ground of the rejection be that the applicant is not the true and first inventor of the art or instrument described, the examiner must cite references establishing his assertion, or himself make oath to it, to overcome the presumption arising from the oath of the alleged inventor.<sup>2</sup>

<sup>3</sup> That the conclusions of an examiner do not bind his successor, unless embodied in a formal judgment, see *Ex parte* Buell (1884), 26 O. G. 437; *Ex parte* Starr (1879), 15 O. G. 1053.

That the former erroneous decision of an examiner is to be departed from, see *Ex parte* Traitel (1883), 25 O. G. 783.

<sup>4</sup> That the primary examiner when considering the merits of the application must look to the language of the application alone, see *Faure v. Bradley* (1888), 44 O. G. 945.

§ 559. <sup>1</sup> That an examiner, in re-

jecting an application, should cite references, not give his own *dictum*, see *Ex parte* Fairbanks (1873), 3 O. G. 65.

That all the examiner's reasons for rejecting the application must be given at once, see *Ex parte* Proudfit (1876), 10 O. G. 585.

That all references and objections are to be cited and urged by the examiner on or before final rejection, though if he overlooks a reference he may urge it as soon after final rejection as he discovers it, as *e. g.* in his appeal-statement, see *Ex parte* Parker (1886), 36 O. G. 119.

<sup>2</sup> That if the examiner denies the



If the ground of the rejection be the absence of novelty in the subject-matter of the application, the examiner must disclose to the applicant all his own information on the subject, citing the best references at his command. When these references are prior patents, each must be designated by its date and number, and by the name of the patentee and the class of the invention. When the reference is a prior publication, its title, date, page or plate, and place of publication or place where a copy may be procured, must be given. When the reference is a fact within the knowledge of the examiner or the Patent Office, the data mentioned must be as precise as the nature of the case admits, and the reference must be supported by the affidavit of the person to whom the fact is known. The pertinence of the reference cited, if not obvious on inspection, must be clearly explained and the anticipated Claim particularly specified; and where a reference shows or describes inventions other than that claimed by the applicant, the part relied on to defeat his Claim must be as accurately designated as possible. Devices cited as references need not have commercial value, nor be identical in form, material, or mode of use with that described in the application; substantial correspondence constituting them the same invention.<sup>3</sup> An abandoned or rejected application is not a public document, and cannot be referred to as disclosing prior knowledge of the invention.<sup>4</sup> In all cases, pertinent references only should be

priority of the applicant and cannot cite a reference, he must support his denial by an affidavit, see *Ex parte Hill* (1879), 16 O. G. 765.

<sup>3</sup> That devices, cited as references, need not have commercial value, see *Sargent v. Burge* (1877), 11 O. G. 1055.

That the device, cited as a reference, need not be identical with the one claimed in the application, either in material, shape, or mode of use, see *Ex parte Chatillon* (1872), 2 O. G. 115.

That a drawing without printing may be cited as a reference, see *Ex parte Borden* (1884), 26 O. G. 439.

<sup>4</sup> That an abandoned application

cannot be cited as a reference, see *Webster v. Sanford* (1888), 44 O. G. 567; *Ex parte Borden* (1884), 26 O. G. 439; *Corn Planter Patent* (1874), 23 Wall. 181; 6 O. G. 392.

That a rejected application cannot be cited as a reference, see *Webster v. Sanford* (1888), 44 O. G. 567; *Blades v. Rand, McNally, & Co.* (1886), 27 Fed. Rep. 93; 37 O. G. 99; *Northwestern Fire Extinguisher Co. v. Philadelphia Fire Extinguisher Co.* (1874), 6 O. G. 34.

That an abandoned or rejected application can be cited as a reference, see *Ex parte Gordon* (1874), 6 O. G. 543.

mentioned, and the best references should be cited first.<sup>5</sup> The examiner is under no obligation to embody in his notice any suggestions as to the proper Claims to be inserted in the application, — this being a matter for the applicant upon the information afforded to him by the Patent Office.<sup>6</sup>

§ 560. **Action of Applicant after Rejection: Insistence and Second Rejection.**

On the receipt of this notice of rejection, the applicant may either insist on the allowance of his application as it stands, or he may amend it, or he may withdraw it altogether. If he insists, he may controvert by argument the position taken by the examiner upon matters of law or upon the identity of his invention with the references cited, or he may deny the existence of the facts contained in the reference itself. To facts stated and sworn to by the examiner as within his personal knowledge, he may oppose his own affidavit or those of other persons, and these may be met by counter-proofs on the part of the examiner. If the reference is a domestic patent, or if it is a foreign patent or a publication, the applicant may avoid the reference by an affidavit showing his completion of the invention before the filing of the application for the domestic patent, or before the date of the foreign patent or the publication, and averring that he does not know or believe that the invention has been in public use or on sale in this country for more than two years prior to his application, and that he has never abandoned the invention.<sup>1</sup> A rejection upon such references

<sup>5</sup> That pertinent references only should be cited, see *Ex parte Brownlie* (1873), 3 O. G. 212.

That the best references must be cited first, see *Ex parte Sanders* (1878), 13 O. G. 818.

<sup>6</sup> That the examiner need not suggest proper Claims, this being the duty of the applicant, see *Ex parte Evarts* (1874), 5 O. G. 429.

§ 560. <sup>1</sup> That the applicant need show only such facts as will carry the date of his invention back of the references cited, see *Ex parte Lanfrey* (1881),

20 O. G. 892; *Ex parte Gasser* (1880), 17 O. G. 507.

That in order to overcome a prior patent or publication the applicant must show by competent legal proof that he had disclosed the invention to others, as fully as the patent or publication does, before the patent was granted or the publication made, see *Ex parte Saunders* (1883), 23 O. G. 1224.

That an affidavit, under the rule requiring an affidavit of prior invention after rejection on a patent or publication, must set out the facts on which



to domestic patents showing but not claiming the invention, or to foreign patents, or to publications, or on the ground of public use or sale, or that the device referred to is capable of performing the same operation in the same manner, or that the invention is inoperative or frivolous or injurious to public health or morals, opens the whole question of fact to investigation upon affidavits or depositions, denying or supporting these objections.<sup>2</sup> Upon the statement of the applicant that he insists on the allowance of his application in its original

the applicant bases his claim and if he asserts that he had made drawings or models, such drawings and models, or copies of them, must be produced, see *Ex parte Saunders* (1883), 23 O. G. 1224.

That the applicant, in his proof, must set forth the facts which show that his inventive act preceded the filing of the application named in the reference, though they need not be particularly stated nor need he allege that he made the invention before the inventor whose patent has been cited against him, see *Ex parte Gasser* (1880), 17 O. G. 507.

That the applicant's proof must show a reduction to practice or reasonable diligence in reducing, before the filing of the application for the patent cited against him, see *Ex parte Gasser* (1880), 17 O. G. 507.

That foreign inventors may show that their inventions were known in this country before the dates of their applications, but cannot show use abroad prior to the dates of their patents, see *Ex parte Lanfrey* (1881), 20 O. G. 892.

That affidavits claiming priority against an existing patent are secret, see *Ex parte Gasser* (1880), 17 O. G. 507.

In cases where the patent cited as a reference claims the invention covered by the rejected application, and is an unexpired domestic patent, an interference arises upon the filing of the affidavit described in the text, and the proceedings thenceforth follow the rules discussed in §§ 586-616, *post*.

<sup>2</sup> That the Patent Office may receive the affidavits of third persons in uncontested cases, but care must be taken to guard against fraud, and the applicant must have an opportunity to examine them and offer counter-proof, see *Hedges v. Daniels* (1880), 17 O. G. 394.

That the Commissioner may act on his personal knowledge of public use, see *Alteneck's Appeal* (1882), 23 O. G. 269.

That the inquiry of the Commissioner into the knowledge of others as to an alleged public use is a judicial inquiry, and there must be due notice and legal evidence, see *Ex parte Barricklo* (1886), 38 O. G. 417; *Alteneck's Appeal* (1882), 23 O. G. 269.

That the right and opportunity to offer rebutting evidence on the question of public use is no substitute for cross-examination of adverse witnesses, see *Alteneck's Appeal* (1882), 23 O. G. 269.

That a rejection on the ground of public use or sale on mere *ex parte* affidavits, without notice or examination, is improper, see *Ex parte Barricklo* (1886), 38 O. G. 417; *Alteneck's Appeal* (1882), 23 O. G. 269.

That affidavits, averring that the invention was in public use two years before the application was filed, authorize the Commissioner to call on the applicant to show cause why he should not prove the contrary, see *Ex parte Barricklo* (1886), 37 O. G. 672; 38 O. G. 417.

form, and the completion of the proofs and counter-proofs upon the disputed questions of fact, when such exist, the examiner is required to re-examine the case and communicate the result of this examination to the applicant. If he again rejects the application, his notice of such second rejection must, like that of the first, specifically and exhaustively allege the grounds of his adverse decision.

### § 561. Amendment of Application.

Amendments to the application may be offered at any time after it is taken up for examination and before final disposition of it has been made.<sup>1</sup> Amendments in form are optional with the applicant to any extent, and may be required by the Patent Office when necessary to correct inaccuracies of statement or undue prolixity, or to secure correspondence between the Claim and the Description. Amendments in substance can be made only within certain limits, and under certain prescribed conditions.<sup>2</sup> No new matter can under any circumstances be introduced by amendment.<sup>3</sup> New matter is that which is not found in the specification, drawings, or model, as first filed, and which involves a departure from the original invention.<sup>4</sup> Such matter must necessarily be a distinct art or

§ 561. <sup>1</sup> That an inventor may amend or enlarge his Claims at any time pending his application, in order to embrace everything which was specified at the outset, see *Railway Register Mfg. Co. v. North Hudson Co. R. Co.* (1885), 24 Fed. Rep. 793 ; 33 O. G. 355.

That an amendment may be made at any time within two years from the date of the "last action," see *Ex parte Reynolds* (1883), 24 O. G. 993.

<sup>2</sup> That an amendment cannot be made unless a good reason for allowing it appears, see *Ex parte Winchester* (1880), 17 O. G. 453.

<sup>3</sup> That new matter, changing the character of the invention, cannot be introduced by amendment, see *Ex parte Wharton* (1887), 40 O. G. 917 ; *Ex parte Dunn* (1879), 16 O. G. 1004 ; *Ex*

*parte Lamb* (1879), 16 O. G. 405 ; *Ex parte Temple* (1877), 12 O. G. 795.

That the phrase "new matter" applies to re-issues rather than amendments, see *Ex parte Holt* (1884), 29 O. G. 171.

<sup>4</sup> That any amendment containing features not found in either the specification, the drawings, or the model, when the invention is capable of illustration by model or drawings, introduces new matter and must be made as a separate application, see *Ex parte Crandall* (1886), 35 O. G. 625 ; *Ex parte Temple* (1877), 12 O. G.

That no material amendment can be allowed, see *Chicago & Northwestern R. R. Co. v. Sayles* (1878), 97 U. S. 554 ; 15 O. G. 243.

That amendments enlarging the in-



instrument, or a new and separately patentable improvement on the old, and can be now presented only in a separate application.<sup>5</sup> Amendments changing the construction or mode of operation of the invention, or describing a different embodiment of the idea, or re-instating Claims which have been eliminated to avoid certain references cited or to comply with an order for a division of the application, are all open to this objection and cannot be permitted.<sup>6</sup> Amendments not intro-

vention are suspicious, see *Chicago & Northwestern R. R. Co. v. Sayles* (1878), 97 U. S. 554; 15 O. G. 243.

That an amendment cannot insert into the application matter which has been in public use more than two years, see *Kittle v. Hall* (1887), 39 O. G. 707; 29 Fed. Rep. 508; 24 Blatch. 184.

That amendments enlarging the scope of the application are not allowable, see *Eagleton Mfg. Co. v. West, Bradley, & Cary Mfg. Co.* (1880), 18 Blatch. 218; 17 O. G. 1504; 2 Fed. Rep. 774.

That an amendment cannot introduce a different invention but only set forth more fully the one already applied for, see *Ex parte Snyder* (1882), 22 O. G. 1975.

That amendments may illustrate but cannot alter the invention applied for, see *Ex parte Howe*, (1883), 25 O. G. 1189.

That an applicant cannot change his ground and secure successive examinations for a single fee, see *Ex parte Holt* (1884), 29 O. G. 171.

<sup>5</sup> That where an amendment is not permitted a new application may be filed, see *Ex parte Thurmond* (1886), 37 O. G. 217.

<sup>6</sup> That the essential character of the invention, as originally set forth, cannot be changed by amendment, see *Ex parte Dodge* (1872), 3 O. G. 179.

That Claims rejected to meet objections of the examiner cannot be re-inserted by amendment, either in the same or a different mode of statement, see *Ex parte Andrews* (1879), 15 O. G. 1056.

That Claims struck out because inconsistent with other Claims cannot be re-inserted by amendment, after such other Claims have been defeated in an interference, see *Ex parte Cobb* (1879), 16 O. G. 175.

That a Claim once voluntarily erased cannot be restored, but may be made the subject of a new application, see *Ex parte Johnston* (1887), 40 O. G. 574.

That matter eliminated by a division of the application cannot be re-instated by amendment, see *Ex parte Preston* (1880), 17 O. G. 853.

That an applicant having elected to claim one species cannot change though he finds it unpatentable, see *Ex parte Wharton* (1887), 40 O. G. 917.

That when an application contains a generic Claim and several specific Claims, of which one is imperfect, the applicant may amend his imperfect Claim and then elect which specific Claim he will retain, see *Ex parte Johnston* (1887), 40 O. G. 574.

That when an examiner is in doubt as to want of identity in the amended application he should examine it on the merits, and if he rejects it cite his references, see *Ex parte Bennett* (1886), 35 O. G. 1003.

That where an amended application shows want of identity, it should be rejected by the examiner and an appeal taken if desired, see *Ex parte Bennett* (1886), 35 O. G. 1003.

ducing new matter may be made without a new oath when the features of the invention therein described or claimed are already apparent in the application as originally filed, and the effect of the amendment is merely to supply suitable connections, add subordinate devices, remedy manifest defects, correct clerical errors, or declare further uses for which the art or instrument may be employed.<sup>7</sup> Where drawings and a model accompanied the original specification, such amendments must conform to at least one of them as they were first filed; but if the invention does not admit of model or drawing the specification may be amended on proof satisfactory to the Commissioner that the proposed matter was part of the origi-

<sup>7</sup> In *Ex parte Snyder* (1882), 22 O. G. 1975, Marble, Com.: (1975) "The applicant will not be permitted, under the guise of an amendment, to introduce into his application a wholly different invention, nor to change the construction and operation of an invention which has been fully described and shown, nor to present a different or preferable form of his invention. He may be permitted, upon proper occasion, to supply suitable connections, to add a spring to a pawl, a handle to a crank, a belt to a pulley, teeth to a wheel, an outlet to a closed receptacle, or other manifest defects or omissions in features essential to the operation of the invention or to the completeness of the disclosure, and which were caused by a clerical error of the draftsman or the unfamiliarity of the inventor with official forms. These amendments, supplemental in their nature, may be made as completing the invention imperfectly shown and described. They add to the invention disclosed some part or feature which agrees with the construction and operation already presented. An applicant cannot be permitted, however, to erase the lines of his drawing and delineate anew the construction and operation of a part fully shown and described,

or replace a well-described but inferior arrangement by a preferable form of his invention."

That any amendment, within the original sworn statement, may be made without a new oath, etc., see *Railway Register Mfg. Co. v. North Hudson Co. R. Co.* (1885), 24 Fed. Rep. 793; 33 O. G. 355; *Ex parte Eaton* (1873), 4 O. G. 525.

That an amendment may introduce a part of a Claim covering an element additional to the combination in which the invention was said to consist, if this element is shown in the specification or drawings, see *Hoe v. Cottrell* (1880), 18 O. G. 59; 17 Blatch. 546; 1 Fed. Rep. 597; 5 Bann. & A. 256.

That an amendment may claim the process as composed of certain sub-processes if the specification describes them, see *Ex parte Wohltmann* (1879), 16 O. G. 723.

That where the specification describes the old elements of a combination as new, an amendment distinguishing the new elements from the old must be filed, see *Ex parte Gilbert* (1879), 16 O. G. 763.

That an amendment may be made showing that the invention is applicable to additional uses, see *Ex parte Slotterbeck* (1875), 8 O. G. 1073.



nal invention.<sup>8</sup> Amendments not introducing new matter, but containing features which are not substantially represented in the application as originally filed, and yet which might have been, and are claimed to be, a part of the original invention, must be accompanied by a new oath, averring that the subject of the amendment was a portion of the invention and was invented before the original application was presented;<sup>9</sup> and the

<sup>8</sup> That if the matter of an amendment can be found either in the specification, drawing, or model it suffices, see *Ex parte* Huck (1879), 16 O. G. 1052; *Ex parte* Dorman (1876), 9 O. G. 1061.

That amendments to the specification must be based on the drawing or model if any; and if none, then they must be shown by proper proof to have been embraced in the original invention, see *Ex parte* McDougall (1882), 21 O. G. 1783; *Ex parte* Shalters (1879), 15 O. G. 970.

That an invention not shown in the drawing or model, when capable thereof, cannot be inserted in an amendment, and an amendment embracing such matter should not be received, see *Ex parte* Vaile (1886), 37 O. G. 563; *Ex parte* Bennett (1886), 35 O. G. 1003.

That drawings must not be changed or erased in the Patent Office, being records of an important character, see *Ex parte* Wharton (1887), 40 O. G. 917.

That where there are neither drawings nor model the amendment must still be confined to the original invention, see *Ex parte* Crandall (1886), 35 O. G. 625.

That in cases not admitting of model or drawing an amendment must be accompanied by proof that the new matter is part of the original invention, and in the absence of such proof the amendment will not be considered, see *Ex parte* Bennett (1886), 35 O. G. 1003.

<sup>9</sup> That Claims amended in matters of substance are to be treated as new

Claims just presented, — matters of substance being such as change the character of the invention, not merely the modes of describing it, — see *Ex parte* Winchester (1880), 17 O. G. 453.

That an amendment not fairly covered by the original oath must be duly verified, see *Ex parte* Foster (1885), 33 O. G. 113.

That where Claims are enlarged in subject-matter by an amendment a supplemental oath is necessary, see *Ex parte* Crandall (1886), 35 O. G. 625; *Ex parte* Clarke (1886), 36 O. G. 120.

See also § 455 and note 3, *ante*.

That an amendment introducing a part of the invention as originally made, but not appearing in the specification as first filed, must be supported by an oath that it belonged to the original invention, see *Ex parte* McDougall (1882), 21 O. G. 1783.

That an amendment introducing what was before shown only in the model requires a new oath, see *Ex parte* Eaton (1873), 4 O. G. 525.

That an amendment filed by an administrator after the death of the original applicant requires a new oath when the matter introduced covers more than the original application, and a patent issued on such amendment without a new oath is void, see *Eagleton Mfg. Co. v. West, Bradley, & Cary Mfg. Co.* (1883), 111 U. S. 490; 27 O. G. 1237; *Eagleton Mfg. Co. v. West, Bradley, & Cary Mfg. Co.* (1880), 18 Blatch. 218; 17 O. G. 1504; 2 Fed. Rep. 774.

That the decision of the Patent Office

date of this oath is then entered on the papers and is thereafter regarded as the true date of the amended application.<sup>10</sup> By this mode of amendment a specific Claim may be inserted in an application for the generic invention, or the description of a mode of making a certain manufacture may be introduced into an application for the manufacture itself; or features essential to the invention, but not embraced within the original sworn statement, may be added to the Description and Claim already filed.<sup>11</sup> No amendment can be permitted to enlarge a specification to the prejudice of intermediate inventors;<sup>12</sup> and long delay in filing such amendments raises a strong presumption that the original application correctly limited the scope of the invention then made, and that the additions or variations disclosed by the amendment are of late discovery.<sup>13</sup>

that an attorney has been appointed with authority to amend is final, see *Hoe v. Cottrell* (1880), 17 Blatch. 546; 18 O. G. 59; 1 Fed. Rep. 597; 5 Bann. & A. 256.

<sup>10</sup> That when an amendment which requires a new oath is filed, the date of the application is changed to that of the new oath, see *Ex parte McDougall* (1882), 21 O. G. 1783.

That when an amendment introduces matter evidently just thought of by the inventor, the date of his amendment is taken as the date of the invention, see *Hull v. Lowden* (1881), 20 O. G. 741.

That applications amended by order of the Patent Office are continuous, see *International Tooth Crown Co. v. Richmond* (1887), 39 O. G. 1550; 30 Fed. Rep. 775.

<sup>11</sup> That when an application contains generic Claims only, and the oath avers that the applicant invented the things claimed, a new specific Claim cannot be inserted by amendment, see *Ex parte Heaton* (1879), 15 O. G. 1054.

That where a Claim for a manufacture is rejected because no mode in which it could be made is described,

an amendment showing such a mode can be made with a new oath, see *Ex parte Benson* (1879), 15 O. G. 512.

<sup>12</sup> In *Railway Co. v. Sayles* (1878), 97 U. S. 554, Bradley, J. : (563) "The law does not permit such enlargements of an original specification, which would interfere with other inventors who have entered the field in the mean time, any more than it does in the case of re-issues of patents previously granted. Courts should regard with jealousy and disfavor any attempts to enlarge the scope of an application once filed, or of a patent once granted, the effect of which would be to enable the patentee to appropriate other inventions made prior to such alteration, or to appropriate that which has, in the mean time, gone into public use." 15 O. G. 243 (246).

<sup>13</sup> That the insertion of an amendment broadening the Claims of the applicant after long delay tends to show that the real invention was properly presented in the original application, see *Chicago & Northwestern R. R. Co. v. Sayles* (1878), 97 U. S. 554; 15 O. G. 243.



§ 562. Amendments : when Made.

Though amendments may be made at any time when their necessity becomes apparent, they should be completed as far as possible before the Claims are passed upon by the examiner.<sup>1</sup> Amendments in substance cannot be filed, as of course, on or after an appeal from the examiner to the examiners-in-chief,<sup>2</sup> nor after a notice of the allowance of the patent has been given to the applicant ;<sup>3</sup> since in the first case the amend-

§ 562. <sup>1</sup> That amendments should be completed before the Claims are passed on by the examiner, but may be made at any later time if necessary, see *Ex parte Dodge* (1872), 3 O. G. 179.

That the application is open to amendment and addition, within the limits fixed by the drawings and model, until it is finally disposed of, see *Ex parte Dodge* (1872), 3 O. G. 179 ; *Singer v. Braunsdorf* (1870), 7 Blatch. 521.

That after a rejection the applicant cannot amend by claiming a different invention, see *Ex parte Zabel* (1888), 43 O. G. 627.

That after a second rejection an applicant cannot amend as a matter of course, but must satisfactorily explain why he did not earlier offer the correction, see *Ex parte Donovan* (1888), 44 O. G. 698.

That the filing of another application, claiming the same invention, does not prevent the prior applicant or patentee from amending his application or patent or doing any other rightful act, see *Ex parte Zay* (1881), 19 O. G. 1496.

That the object of limiting amendments is to determine when the application is complete, see *Ex parte Temple* (1877), 12 O. G. 795.

That when the examiner refuses to receive an amendment, the applicant may petition the Commissioner, and then unless it is clearly improper, the examiner may be ordered to receive it, see *Ex parte Vaile* (1886), 37 O. G. 563 ; *Ex parte Bennett* (1886), 35 O. G. 1003.

That where an amendment, received by the examiner under order of the Commissioner, contains matter which he regards as not embraced in the original invention, he must reject it, see *Ex parte Vaile* (1886), 37 O. G. 563 ; *Ex parte Bennett* (1886), 35 O. G. 1003.

<sup>2</sup> That Claims filed after an appeal to the examiners-in-chief cannot be considered unless sanctioned by the Commissioner, see *Ex parte Dodge* (1872), 3 O. G. 179.

That an amendment cannot be made in taking an appeal to the examiners-in-chief, see *Ex parte Hammond* (1872), 2 O. G. 57.

That a primary examiner cannot open a case for amendment after appeal and affirmance by the examiners-in-chief, on a mere suggestion of such examiners, but only on a clear recommendation, see *Ex parte Peterson* (1887), 40 O. G. 692.

That jurisdiction over such amendments is in the examiner with right of appeal, see *Ex parte Peterson* (1887), 40 O. G. 692 ; *Ex parte Pearson* (1887), 40 O. G. 244.

That an amendment of the specification, after the decision of the appellate tribunal, should be forwarded to the examiner, who will pass on its admissibility and merits, see *Ex parte Reynolds* (1883), 24 O. G. 993 ; *Ex parte Hitt* (1883), 25 O. G. 192.

<sup>3</sup> That an application which has passed to issue in the form selected by the applicant will not be withdrawn for amendment unless great damage would

ment would change the issue presented by the appeal, and in the second case would cause the patent to protect a subject-matter not allowed by the examiner. Amendments in form may be made after the patent is ordered to issue, and after payment of the final fee, on recommendation of the examiner, approved by the Commissioner.

§ 563. **Amendments: their Form.**

Every amendment must be written in a fair and legible hand, on one side of the paper, and on a separate sheet. No erasures can be made in the original application, but the exact word or words to be stricken out must be indicated in the amendment, and the substitutions, if any, with the place of their insertion, must be distinctly stated.<sup>1</sup> When an amendatory clause is amended it must be wholly rewritten so that no erasure or interlineation may appear when the amendments are completed. If amendments are numerous or difficult to arrange, the examiner or Commissioner may require the entire specification to be rewritten. The specification cannot be taken from the Patent Office for the purpose of alteration, nor can the drawing and model both be withdrawn at the same time.

§ 564. **Amendments Dependent on Original Application: their Scope.**

An amendment, however extensive in substance or complete in form, must always be subordinate to, and connected

otherwise result, see *Ex parte Gaboury* (1886), 37 O. G. 217.

That a petition to amend and have a new hearing, after the patent has passed to issue, will be denied, and the claimant left to file a new application, unless irreparable injury would result, see *Ex parte Page* (1888), 43 O. G. 1455.

§ 563. <sup>1</sup> That if a cancelled Claim is to be restored by amendment it must be done as a separate amendment, not by merely erasing the cancellation, see *Ex parte Mumler* (1883), 24 O. G. 1090.

That amended Claims may be inserted into an application by the attorney without the signature of the applicant, see *Railway Register Mfg. Co. v. North*

*Hudson Co. R. Co.* (1885), 24 Fed. Rep. 793; 33 O. G. 355.

That an attorney has no right to substitute a clean draft of a specification for the one signed and sworn to by the applicant, and if he does so it must be erased, see *Sheridan v. Latus* (1883), 25 O. G. 501.

That where the examiner decides that the invention is a mere aggregation and the applicant acquiesces and erases his Claim, he should also cancel all reference thereto from his specification and drawings, and cannot afterward restore his Claim by an amendment, see *Ex parte Gillette* (1888), 44 O. G. 819.



with, the original application. Two distinct applications cannot qualify or support each other.<sup>1</sup> Where a later application by the same inventor describes the same invention as an earlier one, and either claims it more precisely or alone claims it, the later application is not regarded as an amendment to the earlier, but is allowed or rejected on its own merits.<sup>2</sup> The earlier application stands also unaffected by the filing of the later, and may be amended and allowed without reference thereto. An amendment of one portion of the application does not always change the rest, except so far as, by construing the whole together, the meaning of the unaltered portions may be modified by the interpretation given to that which is amended.<sup>3</sup> A Claim may thus be amended without affecting the Description, or the Description without influencing the Claims, or the drawings or model without revising the language of the specification.<sup>4</sup>

**§ 565. Examination of Amended Application: its Rejection: Appeal.**

In offering an amendment for the purpose of removing any of the grounds on which an application has been rejected by the examiner, the applicant must point out all the patentable novelty which he thinks the case presents in view of the state of the art, as disclosed by the references cited or objections made, and must show how his amendment avoids such references or objections.<sup>1</sup> As often as the examiner produces new

§ 564. <sup>1</sup> That each application, by whomsoever filed, is regarded as that of an independent inventor, and is in no manner affected by any other, see *Ex parte* Langlois (1878), 14 O. G. 84.

<sup>2</sup> That a later application for the same invention by the same inventor neither amends nor abandons the former, see *Ex parte* Langlois (1878), 14 O. G. 84.

That a later application by the same inventor, claiming an invention described but not claimed in a former and still pending application, cannot be received as an amendment of the former, see *Ex parte* Emerson (1880), 17 O. G. 1451.

<sup>3</sup> That Claims not affected by an improper amendment must be examined on their merits, see *Ex parte* Vaile (1886), 37 O. G. 563.

<sup>4</sup> That a Claim may be amended without altering the Description if the new Claim is warranted by the drawings and present Description, see *Hoe v. Cottrell* (1880), 1 Fed. Rep. 597; 18 O. G. 59; 17 Blatch. 546; 5 Bann. & A. 256.

That where two applications describe the invention, but only one claims it, the patent issues on the latter, see *Ex parte* Emerson (1880), 17 O. G. 1451.

§ 565. <sup>1</sup> That after a rejection on the merits a case cannot be reconsidered

references or arguments, the same process of amendment and explanation may be repeated. But after the final rejection of all the Claims no amendments are allowable, unless good cause is shown for permitting them, and satisfactory reasons are given for the delay in their presentation. From the refusal of the examiner to allow amendments an appeal lies to the Commissioner.<sup>2</sup> Upon the filing of any amendment to meet the references and objections of the examiner, it is his duty to examine the case presented by the amended application in the same manner as if it were an original application, and if he rejects it to communicate his rejection with its reasons to the applicant, to which reasons the applicant may reply by argument or amendment as before. After a second rejection of the Claims as originally filed, or, if amended in substance, of the amended Claims, the right of the applicant to a hearing before the examiner ceases, and any further action must be taken by an appeal from the decision of the examiner to the examiners-in-chief.<sup>3</sup>

§ 566. Appeal in Uncontested Cases: Matters of Form and of Substance.

Appeals in uncontested cases in the Patent Office are based either upon the decisions of the examiner as to some matter of form, or upon his decision as to some matter of substance.

on mere formal amendments of the Claims and titles, but from the refusal of the examiner to consider such amendments an appeal lies to the Commissioner, see *Ex parte Hitt* (1883), 25 O. G. 192.

<sup>2</sup> That from the refusal of an examiner to consider an amendment appeal lies to the Commissioner, see *Ex parte Bennett* (1882), 35 O. G. 1003.

<sup>3</sup> That after a second rejection the examiner is not obliged to reconsider a Claim unless he thinks he has made a mistake, see *Ex parte Starr* (1879), 15 O. G. 1053.

That all the Claims of an application having been twice rejected on the same references, and no material intervening amendment being made, the

applicant cannot amend again without showing good reason for it, and why he did not sooner amend, see *Ex parte Thurmond* (1886), 37 O. G. 217.

That the rejection of Claims may be appealed from, but the rejected matter cannot be made the subject of a new application, see *Ex parte Ransom* (1884), 39 O. G. 119.

That a rejected applicant must appeal within reasonable time or he will not be permitted to stand in the way of other applicants, see *Ex parte Lombard* (1888), 43 O. G. 1347.

That by taking an appeal from the rejection of one Claim the applicant forfeits no rights as to the others, see *Ex parte Gillette* (1888), 44 O. G. 819.



An appeal upon a question of form lies to the Commissioner in person. An appeal upon a question of substance lies to the board of examiners-in-chief.<sup>1</sup> A matter of form is one that relates to the fitness of the application for an examination on its merits, or involves merely some rule of Office practice.<sup>2</sup> A matter of substance is one that pertains to the patentability of the invention as described and claimed in the application, or to the right of the inventor to a patent upon the application as presented by him.<sup>3</sup> Thus, whether a combination is a true combination or a mere aggregation, whether the Claims cover operative constructions, whether the invention is practicable, whether it is new and useful, whether it has been abandoned to the public, whether an amendment is a departure from the original application or whether it affects the form or the substance of the application,<sup>4</sup> — all these and

§ 566. <sup>1</sup> That an interlocutory appeal to the Commissioner is not based on the merits of the application, — such appeals are taken to the examiners-in-chief, — see *Ex parte* Edward (1876), 9 O. G. 794.

That petitions and motions are addressed to the Commissioner, see *Ex parte* Baker (1886), 36 O. G. 1149.

That interlocutory appeals to the Commissioner are really petitions for orders, see *Ex parte* Baker (1886), 36 O. G. 1149.

<sup>2</sup> That matters of form are those which put the application into condition to be examined on its merits, see *Ex parte* Kitson (1881), 20 O. G. 1750.

That a question of joinder is a question of form, see *Ex parte* Gillette (1888), 44 O. G. 819; *Ex parte* Mill (1887), 40 O. G. 918.

That whether a Claim is intelligible is a question of form, see *Ex parte* Doten (1877), 12 O. G. 841; *Ex parte* Reynolds (1874), 6 O. G. 641.

That whether a Claim is functional is a question of form, see *Ex parte* Barrett (1888), 45 O. G. 125.

That matters of Office practice are appealable only to the Commissioner, see *Ex parte* Proudfit (1876), 10 O. G. 585.

That whether an appeal from an examiner ordering a division is to be made to the Commissioner or the examiners-in-chief is a matter for the Patent Office to decide, see *U. S. v. Butterworth* (1884), 27 O. G. 717.

<sup>3</sup> That the question of the patentability of the invention is one of substance, and from an adverse decision thereon appeal lies to the examiners-in-chief, see *Barney v. Kellogg* (1880), 17 O. G. 1096; *Ex parte* Pressprich (1877), 11 O. G. 195; *Ex parte* Ellis (1876), 9 O. G. 1110.

<sup>4</sup> That whether an invention is a true combination is a question of substance, see *Ex parte* Gillette (1888), 44 O. G. 819; *Ex parte* Barcellos (1880), 17 O. G. 110.

That whether an invention is operative is a question of substance, see *Ex parte* Kitson (1881), 20 O. G. 1750; *Ex parte* Muhl (1880), 17 O. G. 744; *Ex parte* Keith (1876), 9 O. G. 793.

That whether an invention is a design or a mechanical invention is a

others of the same character are questions involving the merits of the application, from an adverse decision upon which an appeal lies to the examiners-in-chief.

§ 567. Appeal, on Matters of Form, to Commissioner.

An appeal to the Commissioner from an adverse decision of an examiner upon a matter of form, once repeated, is taken by a written petition, setting up the decision complained of and the reasons for the appeal, and signed by the applicant or his attorney.<sup>1</sup> The examiner is then required to file a written statement disclosing the grounds of his decision;<sup>2</sup> and upon hearing had, either orally or by written argument, the Commissioner affirms or reverses or modifies the action of the examiner as his judgment may direct. This decision is final, and can be reviewed or reconsidered only by the Commissioner himself.<sup>3</sup>

question of substance, see *Ex parte* Schulze-Berge (1888), 42 O. G. 293.

That whether the invention is new is a question of substance, see *Ex parte* Nagel (1880), 17 O. G. 198; *Ex parte* Buchanan (1879), 16 O. G. 1049; *Ex parte* Proudfit (1876), 10 O. G. 585.

That whether a cited reference is pertinent is a question of substance, see *Ex parte* Kerr (1884), 28 O. G. 95; *Ex parte* Borden (1884), 26 O. G. 439.

That whether an invention is useful is a question of substance, see *Ex parte* Buchanan (1879), 16 O. G. 1049.

That whether the invention has been abandoned is a question of substance, see *Jenkins v. Barney* (1873), 3 O. G. 119.

That whether an amendment departs from the original by inserting new matter is a question of substance, see *Ex parte* Lanstrom (1880), 17 O. G. 744.

That where a feature is struck out of one Claim and inserted in another, the question whether the latter Claim now shows a true combination is one of substance, see *Ex parte* Wenzel (1880), 17 O. G. 512.

That the question whether the draw-

ings are sufficient is one of substance, see *Ex parte* Kitson (1881), 20 O. G. 1750.

That whether a Claim distinguishes the new from the old is a question of substance, see *Ex parte* Reynolds (1874), 6 O. G. 641.

That objections to the insertion of distinct Claims for non-separable parts go to the merits and appeal lies to the examiners-in-chief, see *Ex parte* Gerard (1888), 43 O. G. 1235.

That whether a re-issue application covers new matter is a question of substance, see *Ex parte* Keith (1876), 9 O. G. 744.

§ 567. <sup>1</sup> That under the rule concerning interlocutory appeals, the principal examiner must act twice before review by the Commissioner, see *Ex parte* Bennett (1886), 35 O. G. 1003.

<sup>2</sup> That where the examiner requires a model and an appeal is taken, the examiner must show in his answer why a model is needed, see *Ex parte* Jové (1880), 17 O. G. 801.

<sup>3</sup> That examiners must abide by the decisions of the Commissioner, see *Ex parte* Kitson (1881), 20 O. G. 1750.



**§ 568. Appeal, on Matter of Substance, to Examiners-in-Chief.**

An appeal to the examiners-in-chief from an adverse decision of an examiner upon a matter of substance can be taken only after an original or amended Claim in the application has been twice rejected by the examiner, and after all the Claims have been passed upon and all questions of form conclusively settled in the manner before stated.<sup>1</sup> This appeal is instituted by a written petition, signed by the applicant or his authorized attorney, setting forth the points of the decision from which the appeal is taken and reciting the reasons for the appeal. The petition, having been duly filed, is submitted to the examiner, who, if he finds it to be regular in form, must thereupon furnish to the examiners-in-chief a written statement of the grounds of his decision on all the points involved in the appeal, with copies of the rejected Claims and the references applicable thereto. If he finds the petition irregular in form, the appellant may amend it, or may appeal from this finding to the Commissioner as upon any other question of form. The appellant, previous to the day of hearing before the examiners-in-chief, must file a brief of the authorities and arguments on which he will rely to maintain his appeal; and if he wishes to be heard orally, he must indicate it at the time of filing his petition, when a day of hearing will be fixed and proper notice given him; otherwise the case will be considered and decided by the examiners-in-chief upon the brief presented. The examiners-in-chief can affirm or reverse the decision of the examiner only upon the

§ 568. <sup>1</sup> That appeals on matters of substance must be taken to the examiners-in-chief, see *Ex parte Baker* (1886), 36 O. G. 1149.

That the right of appeal from a second rejection is absolute, whatever be the cause of rejection, see *Ex parte Bennett* (1886), 35 O. G. 1003.

That an applicant having an option of two or more modes of procedure, must elect one and abide by it, as where he can appeal or amend and chooses the latter, see *Ex parte Williams* (1887), 40 O. G. 1337.

That an application must be perfect in form before an appeal can be allowed on its merits, see *Ex parte Mewes* (1872), 2 O. G. 617.

That the jurisdiction of the examiner ceases on appeal, see *Ex parte Brunner* (1872), 1 O. G. 303.

That *ex parte* cases appealed to the examiners-in-chief are within the jurisdiction of the primary examiner as soon as the appeal is decided, see *Ex parte Pearson* (1887), 40 O. G. 244.

points on which the appeal is taken;<sup>2</sup> but if they discover any apparent grounds, not involved in the appeal, for granting or refusing letters-patent in the form claimed or in any other form, they must annex to their decision a written statement of these grounds, with such recommendations to the examiner in regard to his future action as they may deem proper.<sup>3</sup> These new grounds must then be considered by the examiner; and from his adverse decision, upon any question of substance therein presented, another appeal lies to the examiners-in-chief, or on questions of form to the Commissioner, as in other cases.<sup>4</sup>

### § 569. Appeal from Examiners-in-Chief to Commissioner.

From an adverse decision of the examiners-in-chief the applicant may appeal to the Commissioner in person. This

<sup>2</sup> That in *ex parte* cases the jurisdiction of the examiners-in-chief is limited to adverse decisions of the examiners, — all other objections they may discover must be referred to the Commissioner, — see *Ex parte Smoot* (1877), 11 O. G. 1010.

<sup>3</sup> That the examiners-in-chief must suggest anything they deem important either to the Office or the applicant, see *Ex parte Dodge* (1872), 3 O. G. 179.

That the examiners-in-chief can make no recommendation as to points not within their jurisdiction, see *Ex parte Gillette* (1888), 44 O. G. 819.

That if the examiners-in-chief are of opinion that a different form of Claim from that rejected should be allowed they should annex to their decision a statement to that effect, with such recommendation as they think best, but the examiner is not bound by such recommendation, see *Ex parte Dysart* (1886), 34 O. G. 1390.

That the examiners-in-chief are not required to absolutely determine any form of Claim to be passed on by the examiner, see *Ex parte Dysart* (1886), 34 O. G. 1390.

That a mere suggestion of the exam-

iners-in-chief is not a recommendation, see *Ex parte Holt* (1886), 38 O. G. 229.

<sup>4</sup> That primary examiners may refuse to act on the recommendation of the examiners-in-chief, but an appeal lies from the refusal, see *Ex parte Pearson* (1887), 40 O. G. 244.

That where the examiners-in-chief make a "recommendation," the party may propose the recommended matter to the primary examiner, and if he refuses, the commissioner may order it or the party may, after acceptance of the matter and a new rejection of the application, appeal, see *Ex parte Holt* (1887), 38 O. G. 229.

That if new references are cited by an examiner after appeal to the examiners-in-chief, the applicant may again appeal without a new fee, unless the new references are based on his amendment, see *Ex parte Dysart* (1886), 34 O. G. 1390.

That a mandamus will not lie to compel the Commissioner to allow an appeal from a decision of the examiner to the examiners-in-chief on a question of abandonment, pending an interference, it being a matter of his discretion,



appeal, like the former, is taken by written petition, setting up the judgment complained of and the reasons of appeal. If the Commissioner, in revising the decision of the examiners-in-chief, discovers any apparent grounds for granting or withholding a patent which are not presented by the appeal, he may at any time, either before or after final judgment, when in his opinion substantial justice requires it, give reasonable notice to the applicant, and if any amendment or other action based thereon shall be proposed, he will remand the case to the examiner for his consideration.<sup>1</sup> He may also at any time return the case to the examiner for further inquiry when any amendment is filed, or other action taken, in pursuance of the recommendation of the examiners-in-chief. From the decision of the examiner in remanded cases appeal lies to the examiners-in-chief upon matters of substance and to the Commissioner upon matters of form, according to the usual rule.<sup>2</sup>

**§ 570. Appeal from Commissioner to Supreme Court of the District of Columbia.**

From an adverse decision of the Commissioner on an appeal from the examiners-in-chief in *ex parte* cases, a further appeal may be had to the Supreme Court of the District of Columbia.<sup>1</sup> This appeal is taken by a written petition, duly signed and filed with the clerk of the court, accompanied by certified copies from the Patent Office of all the original papers and evidence in the case. On taking this appeal the appellant

see *Ex rel. Bigelow v. Thacher* (1875), 2 MacArthur, 24; 7 O. G. 603.

§ 569. <sup>1</sup> That the Commissioner must take notice of an objection to patentability, however it may be brought to his notice, see *Ex parte Smoot* (1877), 11 O. G. 1010.

<sup>2</sup> That the primary examiner may refuse to act on, the recommendation of the Commissioner and an appeal will lie from such refusal, see *Ex parte Pearson* (1887), 40 O. G. 244.

§ 570. <sup>1</sup> That in *ex parte* cases an appeal lies from the Commissioner to

the Supreme Court of the District, see *Kirk v. Commissioner* (1886), 37 O. G. 451; 5 Mackay, 229.

That the power to hear appeals, formerly vested in the Circuit Court of the District, now resides in the Supreme Court, see Opinion Atty. Gen. (1869), 13 Op. At. Gen. 79.

That an appeal lies from the Commissioner to the Supreme Court of the District of Columbia before suit brought in equity, except in interference cases, see *Butler v. Shaw* (1884), 21 Fed. Rep. 321.

must give immediate notice thereof to the Commissioner in writing, and file in the Patent Office a written statement of his reasons of appeal, which should be full and explicit and constitute a brief of the appellant's argument in support of his claims. The Commissioner must also furnish to the court the grounds of his decision, fully set forth in writing, touching all points embraced in the reasons of appeal. Notice of the time and place of hearing will be given by the court to the Commissioner and by him to the parties in interest, and upon the hearing the Commissioner or the examiner may be called upon to testify concerning the principles of the invention for which a patent is demanded. In reviewing the action of the Commissioner, the court must confine itself to the points set forth in the reasons of appeal,<sup>2</sup> and after judgment must return to the Commissioner a certificate of its proceedings and decision, which will be entered of record in the Patent Office, and will govern its further conduct of the case.<sup>3</sup> This decision does not, however, preclude any person from contesting the validity of the patent thus awarded, in any court wherein it may be called in question.

**§ 571. Remedy of Applicant in Equity after Final Rejection of his Application in the Patent Office.**

Where the Supreme Court of the District of Columbia decides against the applicant on this appeal, he may pursue his remedy by bill in equity in the Circuit Court of the District.<sup>1</sup> A copy of the bill must be served on the Commis-

<sup>2</sup> That in other cases than interference cases the Supreme Court of the District is a mere court of appeal, and is confined to the issues raised in the reasons of appeal and to the evidence produced before the Commissioner, see *Butler v. Shaw* (1884), 21 Fed. Rep. 321; *In re Conklin* (1874), 5 O. G. 235; 1 MacArthur, 375.

That an appeal to the Supreme Court of the District from a decision on a Claim for apparatus is not affected by the intermediate issue of a patent for the process in which the apparatus is

used, see *Butler v. Shaw* (1884), 21 Fed. Rep. 321.

<sup>3</sup> That the certificate of the decision of the Supreme Court of the District of Columbia on an appeal should be made and certified during the term of the justice, but may be forwarded to the Commissioner after the justice retires from office, see *Opinion Atty. Gen.* (1870), 13 Op. At. Gen. 265.

§ 571. <sup>1</sup> Remedy by bill in equity to obtain a patent exists in *ex parte* cases after an appeal to the Supreme Court of the District has been adversely



sioner, and the court having cognizance thereof, after due hearing according to the usual course of equity proceedings, may adjudge that the applicant is entitled to a patent for the whole invention claimed, or for some separable part of it, as the facts may appear.<sup>2</sup> Such an adjudication will authorize

decided. It also exists where, on an appeal to the Commissioner in an interference proceeding, the applicant has been defeated. The doctrine and notes of this paragraph, (§ 571) apply chiefly to the former case. The latter is considered in § 604 and notes, *post*.

That under Sec. 4915 a bill in equity lies upon the refusal of a patent by the Commissioner or the Supreme Court of the District, see *In re Squire* (1877), 3 Bann. & A. 133.

That the remedy in equity to obtain a patent under Sec. 4915, applies only where the Commissioner or Court decides to reject an application on the ground that the applicant is not, on the merits, entitled to it, see *Butterworth v. Hoe* (1884), 112 U. S. 50 ; 29 O. G. 615.

That an applicant in an *ex parte* case is not entitled to a bill in equity until he has exhausted his remedies by appeal, see *Kirk v. Commissioner* (1886), 37 O. G. 451 ; 5 Mackay, 229.

That where the Patent Office rejects an application the remedy is by bill in equity, not mandamus, see *Hull v. Commissioner* (1875), 7 O. G. 559 ; 2 MacArthur, 90.

That where a patent is allowed by the Office, but the Commissioner, without denying the right of the applicant, refuses to issue it, mandamus will lie, see *Butterworth v. Hoe* (1884), 112 U. S. 50 ; 29 O. G. 615 ; and cases cited under § 583, note 3, *post*.

That the power of the Circuit Court to grant a patent upon a petition is independent of the powers of the Patent Office, see *Whipple v. Miner* (1883), 15 Fed. Rep. 117 ; 23 O. G. 2236.

It has been held that a bill in equity to obtain a patent could be brought in any circuit, and that the Commissioner might bind himself and his successors by appearing or accepting service. *Vermont Farm Mach. Co. v. Marble* (1884), 22 Blatch. 128 ; 27 O. G. 622 ; 20 Fed. Rep. 117. But the contrary has been decided by the Supreme Court of the United States in *Butterworth v. Hill* (1884), 114 U. S. 128 ; 31 O. G. 1043 ; where it is declared that the Commissioner's official residence is at Washington, that he can be sued only in the District of Columbia, and that he cannot waive the question of jurisdiction by appearance, consent, or default. Further, that a bill to obtain a patent must be brought in the Circuit Court for the District of Columbia, the courts of other districts having no power to enforce decrees against the Commissioner, see *Prentiss v. Ellsworth* (1846), 27 O. G. 623.

<sup>2</sup> For the form of a bill to obtain a patent after rejection by the Patent Office, and other proceedings, see *Ex parte Greely* (1873), 6 Fisher, 575.

That the Commissioner is not a necessary party to a bill in equity to obtain a patent, under Sec. 4915, where there is an opposing party, but a patentee who has transferred his interest must be made a party, see *Graham v. Teter* (1885), 25 Fed. Rep. 555.

That in a bill in equity against the Commissioner the Secretary is not a party, see *Kirk v. Commissioner* (1886), 37 O. G. 451 ; 5 Mackay, 229.

That a bill in equity to obtain a patent may be heard on any issues

the Commissioner to issue a patent to the applicant, upon his filing in the Patent Office a copy of the judgment, and otherwise complying with the requirements of the law.<sup>3</sup>

§ 572. Appeals in the Patent Office: their General Character and Effect.

An appeal in the Patent Office is not like a writ of error, or a motion for a new trial, but resembles an appeal in equity or admiralty, and does not require for its justification that the judgment appealed from should contradict the evidence.<sup>1</sup> Only questions that were properly within the jurisdiction of the inferior tribunal can be presented on appeal, and decisions affecting matters not within the cognizance of the Patent Office, such as matters of title, are not reviewable in any manner, but are simply void.<sup>2</sup> No appeal lies from a judgment wholly in favor of the appellant, nor from any judgment until it has been duly rendered in the required official form.<sup>3</sup> The decisions of all inferior tribunals must be so ex-

and with any evidence, see *Butler v. Shaw* (1884), 21 Fed. Rep. 321.

That equity will not aid the inventor in procuring a patent under Sec. 4915, in violation of his agreement with others, see *Runstetler v. Atkinson* (1883), 23 O. G. 940.

That delay in suing in equity for a patent is delay in prosecuting an application, and the court may inquire into its reasonableness, see *Gandy v. Marble* (1887), 122 U. S. 432; 39 O. G. 1423.

That a petitioner on a bill in equity to obtain a patent, after a delay of more than two years since the last action, must allege and prove that the delay was unavoidable, see *Gandy v. Marble* (1887), 122 U. S. 432; 39 O. G. 1423.

<sup>1</sup> That a judgment in equity in a suit to obtain a patent binds only the parties and those who derive title from them, see *Butler v. Shaw* (1884), 21 Fed. Rep. 321.

That where the Commissioner is the only defendant in a suit under Sec.

4915, the plaintiff pays the costs, but where there are contesting parties costs follow the usual rule, see *Butler v. Shaw* (1884), 21 Fed. Rep. 321.

§ 572. <sup>1</sup> That an appeal in the Patent Office is not like a writ of error, but like an appeal in equity or admiralty, see *Dickson v. Kinsman* (1880), 18 O. G. 1225; *Packard v. Sandford* (1879), 16 O. G. 1182.

That an appeal in the Patent Office is not like a motion for a new trial, and the judgment below need not contradict the evidence, see *Dickson v. Kinsman* (1880), 18 O. G. 1225.

That the court below did not give due weight to evidence is ground of appeal, see *Slade v. Blair* (1879), 15 O. G. 830.

<sup>2</sup> That no appeal lies from the refusal of the Commissioner to recognize an assignee as entitled to the patent, or on any other question of title, see *Whitely v. Fisher* (1870), 4 Fisher, 248.

<sup>3</sup> That no appeal lies from a judg-



explicit that the subject of the appeal can be clearly distinguished.<sup>4</sup> The appeal is limited to the issues apparent on the record, and brings up only the particular adjudications of which complaint is made.<sup>5</sup> An appeal raising no issue will be summarily dismissed.<sup>6</sup> If evidence is admitted during an appeal to support the claims of the applicant against the references and objections of the examiner, or to vary in any manner the issues of fact concerning the patentability of the invention, the whole case must be remanded to the examiner that he may pass upon it in its new condition. In an appeal from the examiners-in-chief to the Commissioner, he acts only in a judicial capacity and as a court of appellate jurisdiction.<sup>7</sup> Cases decided by him on appeal will not be re-opened except by himself, and those which have been determined by his predecessors will not be reviewed except in accordance with the rules governing the granting of new trials.<sup>8</sup> Cases decided by the examiners-in-chief cannot be reheard by them, when no longer pending before them, without the written authority of the Commissioner.<sup>9</sup>

§ 573. Interviews of Applicants with Examiners: Motions: Procedure.

The rules of the Patent Office generally direct that the communications between the Office and applicants or their

ment affirming patentability, see *Barney v. Kellogg* (1880), 17 O. G. 1096.

That a judgment is not effective until put into the proper official form, see *Ex parte Starr* (1879), 15 O. G. 1053.

<sup>4</sup> That the judgment below must be explicit, see *Jenkins v. Barney* (1873), 3 O. G. 119.

<sup>5</sup> That an appeal is limited to the issues apparent on the record, see *Ex parte Jones* (1874), 5 O. G. 585; *Jenkins v. Barney* (1873), 3 O. G. 119.

That on an appeal the presumption is in favor of the decision appealed from, see *Pockard v. Sandford* (1879), 16 O. G. 1182.

<sup>6</sup> That an appeal raising no issue will be dismissed, see *Ex parte Everts* (1874), 5 O. G. 429.

<sup>7</sup> That on an appeal from the ex-

aminers-in-chief, the Commissioner acts only in a judicial capacity, and as an appellate tribunal, see *Stone v. Greaves* (1880), 17 O. G. 397.

<sup>8</sup> That one Commissioner cannot rehear a case decided by his predecessor except on new facts, see *Gill v. Scott* (1884), 29 O. G. 949.

<sup>9</sup> That the Commissioner has power to revise the decisions of the examiners on motions for rehearings, but is less inclined to interfere when a rehearing is granted than when it is denied, see *Loring v. Hall* (1879), 15 O. G. 471.

That on a motion for rehearing the question is whether the former findings are unsupported by, or are in conflict with, the evidence, see *Gardner v. Dudley* (1880), 18 O. G. 683.

attorneys should take place in writing. Interviews with examiners concerning applications and other pending matters may, however, be had at the examiner's rooms, during office hours, or at any other time and place specially authorized by the Commissioner, although no personal discussion of a pending application is allowed until after the first official action thereon. Motions proper to be made at all must be made and determined by the tribunal before which the case is pending at the time;<sup>1</sup> cases being regarded as pending before a given tribunal until an appeal from its decision has been taken, or until the time for an appeal has expired. An appeal from an adverse decision on a motion must be taken to the Commissioner if the motion involves only matters of form, but to the examiners-in-chief if it relates to matters of substance. A motion once made and determined without appeal cannot be renewed on the same facts.<sup>2</sup> The conduct of each case is governed by the rules in force at its inception, unless new rules are adopted which can be followed without prejudice to the applicant, in which event the latter rules prevail.<sup>3</sup> Changes in the nature or jurisdiction of any of the tribunals in the Patent Office do not interrupt the progress of pending applications, though the mode of their procedure may, to some extent, be changed.<sup>4</sup>

**§ 574. Abandonment of Application: not Abandonment of the Invention.**

The law requires the applicant to prosecute his application with reasonable diligence. After completing the invention he may delay the filing of his application at his pleasure;

§ 573. <sup>1</sup> That a motion based on a statutory bar to the granting of a patent may be made to the tribunal having charge of the application, when no other mode for taking the objection has been provided, see *Barney v. Kellogg* (1880), 17 O. G. 1096.

<sup>2</sup> That a motion once decided without appeal cannot be renewed on the same facts, see *Little v. Lillie* (1876), 10 O. G. 543.

That a motion once absolutely denied

cannot be repeated without leave, see *Clemson v. Fowler* (1886), 37 O. G. 671.

<sup>3</sup> That where a rule is changed pending an application, the proceedings will be governed by the new rule unless the applicant would be injured thereby, see *Fowler v. Benton* (1880), 17 O. G. 286.

<sup>4</sup> That a change in the jurisdiction of a tribunal does not necessitate a beginning *de novo*, see *Colt v. Young* (1852), 2 Blatch. 471.



but having filed it he cannot suffer it to lie indefinitely in the Patent Office, unacted on, without abandoning it. This abandonment of the application is not, however, an abandonment of the invention.<sup>1</sup> By an abandonment of the invention the inventor loses all right to apply for and obtain a patent to protect it. By the abandonment of the application the inventor is placed in the same situation as if he had never filed one; and while he may again apply, his later application may be subject to objections which could not have been urged against the former, and in this manner indirectly his right to a patent may be lost. Thus a public use or sale, which would not have defeated the prior application, because not preceding it at least two years, may on account of the greater lapse of time become a bar to the latter; or a claim of want of novelty or of inventive skill, which could not have been sustained by the state of the art when the first application was filed, may be made good by the advanced state of the art at the date of the new application.<sup>2</sup> The abandonment of an

§ 574. <sup>1</sup> That an abandonment of the application does not *ipso facto* abandon the invention, see *Lindsay v. Stein* (1882), 20 Blatch. 370; 10 Fed. Rep. 907; 21 O. G. 1613; *Ex parte Livingston* (1881), 20 O. G. 1747; *Clark v. Scott* (1872), 2 O. G. 4; 9 Blatch. 301; 5 Fisher, 245; *Bevin v. East Hampton Bell Co.* (1871), 9 Blatch. 50; 5 Fisher, 23; also § 353 and notes, *ante*.

That Sec. 4894 does not apply to the same cases as Sec. 4897, the former relating only to the abandonment of the application, see *Ex parte Golding* (1875), 8 O. G. 141; *Ex parte McCully* (1874), 6 O. G. 153.

That Congress can authorize the revival of an old application long after it is abandoned and a patent may then be granted thereon, the invention being examined in view of the state of the art when the application was originally filed, see *Graham v. Johnston* (1884), 21 Fed. Rep. 40.

That a delay in prosecuting an application, after it was erroneously re-

jected, was not abandonment of the invention before the act of 1870, see *Ex parte Stewart* (1873), 4 O. G. 665.

<sup>2</sup> That an application, filed after the abandonment of a prior one, is open to all objections arising since the prior application was filed, see *Ex parte Livingston* (1881), 20 O. G. 1747.

The effect of changes in the state of the art between the filing of the original and the renewed application is, of course, important only while the date of the application is regarded as the date of the applicant's inventive act. If publications, patents, or inventions, which have come into existence since his former application was filed, are cited against him, he may carry the date of his inventive act back of such advances in the art by extraneous proof, and thus maintain the patentability of his invention, so far as its novelty is concerned. The objection of an intermediate public use or sale cannot, however, be thus obviated, and may prove fatal to his claims.

application, therefore, can result in an abandonment of the invention only by the occurrence of circumstances, after it is filed and before the filing of a new one, which would have been fatal to any application had they transpired before it had been made; and the risk incurred by the inventor depends upon the fact that by the abandonment the date of the application on which his patent rests is transferred from the day on which the original application was filed to the day on which the new one was presented to the Patent Office. In the absence of such intervening circumstances, the trouble and expense of making the new application is the sole consequence of abandoning the former.<sup>3</sup>

**§ 575. Application Abandoned by Unreasonable Delay: Delay of Two Years from "Last Action" Unreasonable.**

Prior to the act of 1861 this question of the abandonment of the application by delay was determined upon general principles regarding diligence and good faith with the public. By that act, however, it was provided that all applications must be completed and prepared for examination within two years after the filing of the petition, and in default thereof should be considered as abandoned by the applicants, unless the Commissioner were satisfied that the delay was unavoidable. This provision was re-enacted in the act of 1870, and appears in the Revised Statutes, with the addition that a failure to prosecute the application within two years after any action thereon, of which notice has been given to the applicant, shall also work its abandonment.<sup>1</sup> It is thus made the

<sup>3</sup> If the doctrine of estoppel is to be applied to a negligent inventor, either in favor of the public or a rival inventor, under the circumstances discussed in §§ 346 note 1, 357 note 3, and 390 note 3, *ante*, any unreasonable delay in prosecuting a pending application, which can affect adverse interests, may properly be brought within the same rule, and forfeit his right to any further consideration of his claims.

§ 575. <sup>1</sup> In *Goodyear v. Hills* (1866), 3 Fisher, 134, Cartter, J.: (138) "Is

it the law that because an inventor files his application, which is refused by the Office, he may sleep upon his rights indefinitely, and that at any period in his lifetime, or that of his representatives, the application may be revived against the public? I think not. *Prima facie*, I think he would have to show a reason why he should be so permitted. The judgment of condemnation by the Office advertises to the country, at least, that he stands in no better position than before the application was made. The



duty of the applicant to complete his application by the presentation of all its parts to the Patent Office, and to prepare it for examination within two years after he files his petition, and also to take some active steps in prosecuting it within two years after the last action of the Office concerning it of which he has notice, under pain of having his application treated as abandoned, unless he can affirmatively satisfy the Commissioner that the delay could not have been avoided.<sup>2</sup> But this provision of the statutes does not confer upon the applicant a right to two years of inaction between each action of the Patent Office. Unreasonable delay for any period is still abandonment. These statutes merely declare that a delay of two years is *prima facie* unreasonable, and thus throw

country is advised, by the deliberation of the only tribunal provided by law for the ascertainment, at that stage of the invention, of his right, that he has none. More especially is he himself advised of that fact, for he is a party to the proceedings, and more immediately damaged by the rejection of the application. That rejection would at least be regarded, in the logic of equity, as a notice to him to proceed with diligence to traverse and reverse the judgment of the Office."

That under Sec. 4894 a failure to prosecute an application for two years abandons it, see *Ex parte Klenha* (1884), 28 O. G. 1272.

That under the provision in Sec. 35, act of 1870, allowing six months after the date of that act for the renewal of withdrawn or rejected applications, an application filed in 1845, withdrawn in 1847, and not subsequently acted on, became dead, see *Ex parte Cryer* (1880), 17 O. G. 452.

That this saving clause of the act of 1870 could be made available to the rejected applicant only by filing a formal renewal of the old application, see *Ex parte Gordon* (1874), 6 O. G. 543.

That the omission of Sec. 35, act of 1870, from the Revised Statutes did not

revive applications that were abandoned under it, see *Davies v. Hartman* (1876), 9 O. G. 351.

That an assignee is bound to the same diligence as an inventor, see *Fire Extinguisher Mfg. Co. v. Graham* (1883), 24 O. G. 793; 16 Fed. Rep. 543.

<sup>2</sup> That under Sec. 4894 (Sec. 32, Act 1870), a rejected application is abandoned if not prosecuted within two years, but a new one may be filed which will stand alone, unaided by the other on questions of abandonment, see *Lindsay v. Stein* (1882), 20 Blatch. 370; 21 O. G. 1613; 10 Fed. Rep. 907.

That eight years' delay after the rejection of an application without renewing it, other patents for substantially the same invention being granted meanwhile, operates as an abandonment, see *United States Rifle & Cartridge Co. v. Whitney Arms Co.* (1886), 118 U. S. 22; 35 O. G. 873.

That a rejected application leaves the applicant where he was when the application was made, but notifies him to proceed with due diligence, see *Goodyear v. Hills* (1866), 3 Fisher, 134.

That an abandoned application is not further noticed by the Patent Office, see *Ex parte Casilear* (1875), 8 O. G. 474.

upon the applicant the burden of proving that in his particular case the delay was justified.<sup>3</sup> In discussing them it will be sufficient to inquire what is meant by the "last action" of the Patent Office; what degree and duration of inactivity on the part of the applicant will abandon his application; and what reasons are sufficient to excuse delay. Whatever concerns the completion of the application and its preparation for examination has been already considered in its proper place.

### § 576. "Last Action" Defined.

The "last action," from which the period of two years dates, is the last interlocutory action of the Patent Office

<sup>3</sup> In *Planing Machine Co. v. Keith* (1879), 101 U. S. 479, Strong, J.: (485) "The Patent Law favors meritorious inventors by conditionally conferring upon them for a limited period exclusive rights to their inventions. But it requires them to be vigilant and active in complying with the statutory conditions. It is not unmindful of possibly intervening rights of the public. The invention must not have been in public use or on sale more than two years before the application for a patent is made, and all applications must be completed and prepared for examination within two years after the petition is filed, unless it be shown to the satisfaction of the Commissioner that the delay was unavoidable. All this shows the intention of Congress to require diligence in prosecuting the claims to an exclusive right. An inventor *cannot without cause* hold his application pending during a long period of years, leaving the public uncertain whether he intends ever to prosecute it, and keeping the field of his invention closed against other inventors. It is not unfair to him, after his application for a patent has been rejected, and after he has for many years taken no steps to re-instate it, to renew it, or to appeal, that it should be

concluded that he has acquiesced in the rejection and abandoned any intention of prosecuting his claim further. Such a conclusion is in accordance with common observation. Especially is this so when, during those years of his inaction he saw his invention go into common use, and neither uttered a word of complaint or remonstrance, nor was stimulated by it to a fresh attempt to obtain a patent. When in reliance upon his supine inaction the public has made use of the result of his ingenuity, and has accommodated its business and its machinery to the improvement, it is not unjust to him to hold that he shall be regarded as having assented to the appropriation, or, in other words, as having abandoned the invention. There may be, it is true, circumstances which will excuse delay in prosecuting an application for a patent after it has been rejected, — such as extreme poverty of the applicant, or protracted sickness." 17 O. G. 1031 (1033).

That no unreasonable delay in prosecuting the application can be permitted, see *Planing Mach. Co. v. Keith* (1879), 101 U. S. 479; 17 O. G. 1031; *Hanscom v. Latham* (1876), 9 O. G. 1157; *Marsh v. Sayles* (1872), 2 O. G. 340; 5 Fisher, 610.



affecting the progress of the application, followed by the mailing of a notice of such action to the applicant.<sup>1</sup> Such mere ministerial acts as sending a letter in reply to a request for information, or for the return of papers or a model, do not constitute the action mentioned in the statute.<sup>2</sup> Every application pending in the Patent Office is presumed to be awaiting some act, either on the part of the Office or of the applicant, which will advance it to the next stage of the proceedings; and the action performed by the Office in its turn, and rendering it necessary for the applicant to act in order that further progress may be made, is the "last action" from which the period of his delay must be computed. A "suspension of action" by the Office implies further action, and does not constitute the "last action" here described.<sup>3</sup>

§ 577. "Inaction" of Applicant Defined.

The "inaction" of the applicant is, correspondingly, his failure to perform the act devolving upon him in order to advance his case. Whatever else he may do is of no consequence in reference to this question. Letters of general inquiry, the presentation of unimportant amendments, and other similar acts do not prevent the two years from running against his application.<sup>1</sup> His action must be one which renders it incumbent on the Office to take action in its turn, or

§ 576. <sup>1</sup> That in a rejected application the "last action" of the Patent Office is the mailing of the last letter of rejection to the applicant, and unless he takes further action, within two years from that date, the application is abandoned, see *Ex parte* Blake (1873), 3 O. G. 2.

<sup>2</sup> That "last action" is some action affecting the merits of the case, not mere ministerial action, see *Ex parte* Graham (1873), 3 O. G. 211.

That an answer to a request to return a model is not "last action," see *Ex parte* Lee (1874), 5 O. G. 58.

<sup>3</sup> That "suspension of action" implies further action, see *Ex parte* Hull (1875), 9 O. G. 1.

§ 577. <sup>1</sup> That after final rejection, without appeal, unimportant amendments will not keep the application alive in the Patent Office, see *Ex parte* Jenks (1878), 14 O. G. 747.

That irregular and illegal modes of procedure do not keep an application alive and prevent its abandonment, see *Kirk v. Commissioner* (1886), 37 O. G. 451; 5 Mackay, 229.

That the suspension of an application at the request of the applicant, and at his option to proceed with it, is "inaction," and unless taken up within two years it is abandoned, see *Ex parte* Norton (1888), 42 O. G. 296.

the delay is clearly imputable to him and he must bear the loss which it entails.<sup>2</sup> In computing the two years of his inactivity, the day on which the "last action" of the Patent Office was performed is excluded.<sup>3</sup>

§ 578. Unavoidable Delay not Unreasonable.

The inaction of the applicant, however protracted, cannot prejudice his application if the delay was unavoidable. Of this the Commissioner is made the final judge, though the question as to an abandonment of the invention itself by an unreasonable delay of the application in the Patent Office may always be raised and adjudicated in the courts.<sup>1</sup> No applicant can justly be regarded as responsible for a delay which he could not avoid. If he is urging his application as rapidly as under all the circumstances he is able to do, he cannot be considered as abandoning it.<sup>2</sup> Thus poverty or sickness, or

<sup>2</sup> That a bill in equity to obtain a patent, though not a technical appeal from the Patent Office but a true suit in equity, is still a part of the application for a patent, see *Gandy v. Marble* (1887), 122 U. S. 432; 39 O. G. 1423.

That delay in filing a bill in equity to obtain a patent for more than two years since the last action must be shown to be unavoidable, or it will work an abandonment, see *Gandy v. Marble* (1887), 122 U. S. 432; 39 O. G. 1423.

<sup>3</sup> That in computing the two years the day of "last action" is excluded, see *Ex parte Musser* (1879), 16 O. G. 858.

§ 578. <sup>1</sup> That the decision of the Commissioner, that delay in prosecuting an application was unavoidable, is final, see *U. S. Rifle & Cartridge Co. v. Whitney Arms Co.* (1877), 14 Blatch. 94; 11 O. G. 373; 2 Bann. & A. 493; *McMillin v. Barclay* (1871), 5 Fisher, 189; 4 Brews. (Pa.) 275.

That under Sec. 489½ the Commissioner's discretion is judicial, not a mere whim, and the evidence must show that the delay was unavoidable,

see *Ex parte Chapman* (1884), 29 O. G. 950.

That "unavoidable delay" must be clearly proved, see *Ex parte Klenha* (1884), 28 O. G. 1272.

That under Sec. 4894 the evidence is to be heard by the Commissioner in person, see *Smith v. Dimond* (1881), 20 O. G. 742.

That too great leniency to delaying applicants, to the prejudice of the public, must not be allowed, see *Ex parte Klenha* (1884), 28 O. G. 1272.

That the decision of the Commissioner, that the invention has not been abandoned by delays in the application, is not conclusive on the courts, see *Planing Mach. Co. v. Keith* (1879), 101 U. S. 479; 17 O. G. 1031; *U. S. Rifle & Cartridge Co. v. Whitney Arms Co.* (1877), 14 Blatch. 94; 11 O. G. 373; 2 Bann. & A. 493.

<sup>2</sup> That if the applicant is prosecuting his case as rapidly as he is able, no delay will abandon it, see *Ex parte Barnitz* (1887), 41 O. G. 575; *Good-year Dental Vulcanite Co. v. Smith* (1874), 5 O. G. 585; *Holmes*, 354;



inevitable absence from the United States, or legal inability to pursue his rights, have been held sufficient to relieve him from the consequence of his delay.<sup>3</sup> Where the inaction is not truly his own but is ultimately due to the errors or misconduct of other persons, either without his knowledge or beyond his control, he ought not, and is not compelled, to suffer its results. Hence delays in the Patent Office not attributable to him nor acquiesced in by him,<sup>4</sup> mistakes in the Patent Office which induce him not to act where a correct decision would have led him to exercise due diligence,<sup>5</sup> and the neglect of his attorney to obey his orders,<sup>6</sup> have been accepted as excuses

1 Bann. & A. 201; *Ex parte* Leavitt (1873), 3 O. G. 212.

That "unavoidable" delay in prosecuting an application is such delay as prudent and diligent men, using the ordinary agencies, would not have overcome, for the law does not compel parties to resort to unusual methods, see *Ex parte* Pratt (1887), 39 O. G. 1549.

That "unavoidable delay" means hindrance by circumstances over which the inventor had no control, see *Ex parte* Klenha (1884), 28 O. G. 1272.

That delay unaccompanied by any effort to avoid it is not unavoidable, see *Smith v. Dimond* (1881), 20 O. G. 742.

That "unavoidable" delay in prosecuting an application means unavoidable during the entire two years, see *Ex parte* Root (1887), 40 O. G. 811.

<sup>3</sup> That poverty, sickness, and other causes may excuse delay, and save the application, see *Planing Mach. Co. v. Keith* (1879), 101 U. S. 479; 17 O. G. 1031.

That poverty, etc., is an excuse only when it prevents action, see *Ex parte* Klenha (1884), 28 O. G. 1272.

That involuntary absence from the country excuses delay, see *Weston v. White* (1876), 13 Blatch. 447; 2 Bann. & A. 364.

See also § 353 and notes, *ante*.

<sup>4</sup> That delays in the Patent Office do not abandon the application, unless

acquiesced in by the applicant, see *Colgate v. Western Union Telegraph Co.* (1878), 14 O. G. 943; 4 Bann. & A. 36; 15 Blatch. 365; *Smith v. Good-year Dental Vulcanite Co.* (1876), 93 U. S. 486; 11 O. G. 246; *Jones v. Sewall* (1873), 6 Fisher, 343; 3 O. G. 630; 3 Clifford, 563; *Johnsen v. Fassman* (1872), 1 Woods, 138; 5 Fisher, 471; 2 O. G. 94; *Singer v. Braunsdorf* (1870), 7 Blatch. 521; *Dental Vulcanite Co. v. Wetherbee* (1866), 2 Clifford, 555; 3 Fisher, 87; *Sayles v. Chicago & Northwestern R. R. Co.* (1865), 1 Bissell, 468; 2 Fisher, 523; *Adams v. Jones* (1859), 1 Fisher, 527; *Bell v. Daniels* (1858), 1 Bond, 212; 1 Fisher, 372; *Rich v. Lippincott* (1853), 2 Fisher, 1.

That if the applicant acquiesces in a delay of the Patent Office, his application may thereby be abandoned, see *Bevin v. East Hampton Bell Co.* (1871), 5 Fisher, 23; 9 Blatch. 50.

That a delay while an interference is pending is not abandonment, see *Taylor v. Shreffler* (1883), 24 O. G. 1175.

<sup>5</sup> That a mistake in the Patent Office, inducing inaction, does not abandon the application, see *Colgate v. Western Union Telegraph Co.* (1878), 14 O. G. 943; 15 Blatch. 365; 4 Bann. & A. 36; *Weitling v. Cabell* (1872), 2 O. G. 223.

<sup>6</sup> That delay caused by the attor-

for an inaction which otherwise would have been fatal to his application. But where he has been led to his delay by motives of personal interest, or even by more indifference to the rights of others, he must be held strictly to its penalties.<sup>7</sup> He cannot be relieved upon the ground that his pecuniary interests would not have been advanced by his compliance with the law, nor that other voluntary occupations, however profitable to himself or others, have engrossed his capital or his time.<sup>8</sup>

§ 579. **Abandonment of Application by Express Declaration of the Applicant.**

An application may be abandoned not only by unreasonable delay in completing or prosecuting it, but by the express act of the applicant.<sup>1</sup> Such an abandonment must be in writing, describing the application by the title of the invention and the date of the filing, signed by the applicant in person, and filed in the Patent Office.<sup>2</sup> The presentation of a new application for the same invention does not withdraw or abandon the original, but each is accepted and treated by the Office as independent of the others, unless the later be offered as an amendment to, or a substitute for, the former.<sup>3</sup> An aban-

ney, and not acquiesced in by the applicant, does not abandon the application, see *Howes v. McNeal* (1878), 15 O. G. 608 ; 15 Blatch. 103 ; 3 Bann. & A. 376 ; *Weston v. White* (1876), 13 Blatch. 447 ; 2 Bann. & A. 364.

That a party may rely on trustworthy employees, and if they fail unexpectedly, it is "unavoidable," see *Ex parte Pratt* (1887), 39 O. G. 1349.

<sup>7</sup> That the present pecuniary worthlessness of an invention does not excuse delay in prosecuting the application, see *Ex parte Woodbridge* (1879), 15 O. G. 564.

<sup>8</sup> See § 387 and notes, *ante*.

§ 579. <sup>1</sup> That the cancellation of all the Claims is abandonment, see *Ex parte Lasscell* (1884), 29 O. G. 861 ; 28 O. G. 1274.

<sup>2</sup> That the Patent Office may re-

quire an abandonment to be stated in terms, and in default thereof an amendment cancelling all Claims may be rejected by the examiner, see *Ex parte Lasscell* (1884), 29 O. G. 861.

That a power of attorney, giving him full authority to amend, does not authorize him to withdraw all the Claims and so destroy the application, see *Ex parte Lasscell* (1884), 28 O. G. 1274.

<sup>3</sup> That a pending application is not affected by a subsequent application for the same invention by the same inventor, nor does the later abandon the earlier application, see *Ex parte Langlois* (1878), 14 O. G. 84.

That the filing of a second application, describing but not claiming the improvement claimed in the former application, does not abandon such improvement to the public nor affect the



doned application has no legal existence or validity for any purpose. It cannot aid a subsequent one by carrying back the date of application, nor is it further noticed by the Patent Office.<sup>4</sup>

### § 580. Withdrawal and Substitution of Applications.

At any time before the final rejection or allowance of an application it may be withdrawn by the applicant, and a new application may be filed containing a new specification, oath, and drawing, and accompanied by a new fee.<sup>1</sup> Also, after the final rejection of an application, a new one may be filed in the same manner, though the rejected application cannot be withdrawn. In both these cases, the relation of the new application to the old depends upon the question of abandonment. If the original application were abandoned it can never be revived;<sup>2</sup> and in that case, or when the filing of the

prior application, see *Suffolk Co. v. Hayden* (1865), 3 Wall. 315.

That after a rejected application has lain unnoticed for several years, and a new and independent application for the invention is filed, the later is regarded as a final abandonment of the former, see *Ex parte Gordon* (1874), 6 O. G. 543.

<sup>1</sup> That an abandoned application is no longer noticed by the Patent Office, see *Ex parte Casilear* (1875), 8 O. G. 474. See also § 559, note 4, *ante*.

§ 580. <sup>1</sup> That under the act of 1836 a request for the return of the fee was not of itself a withdrawal of the application, see *Colgate v. Western Union Telegraph Co.* (1878), 15 Blatch. 365; 14 O. G. 943; 4 Bann. & A. 36; *Ex parte Sexton* (1876), 9 O. G. 251.

That the filing of a second application is not necessarily a withdrawal of the first, see *Colgate v. Western Union Telegraph Co.* (1878), 15 Blatch. 365; 14 O. G. 943; 4 Bann. & A. 36.

For a review of the cases on the withdrawal of applications, see *Colgate v. Western Union Telegraph Co.* (1878),

15 Blatch. 365; 14 O. G. 943; 4 Bann. & A. 36.

<sup>2</sup> That an application once abandoned can never be revived, see *Ex parte Mayor* (1878), 13 O. G. 912; *Marsh v. Sayles* (1872), 5 Fisher, 610; 2 O. G. 340.

That an abandonment of the invention by a final withdrawal of the application is an abandonment to the public, not to rival inventors, see *Consolidated Fruit Jar Co. v. Bellaire Stamping Co.* (1886), 27 Fed. Rep. 377; 35 O. G. 627.

That on a question of abandonment of the invention by the withdrawal of the application the lapse of time is of great weight, if not conclusive, see *Consolidated Fruit Jar Co. v. Bellaire Stamping Co.* (1886), 27 Fed. Rep. 377; 35 O. G. 627.

That a delay of fifteen years after the withdrawal of an application is abandonment of the invention, see *Consolidated Fruit Jar Co. v. Bellaire Stamping Co.* (1886), 27 Fed. Rep. 377; 35 O. G. 627.

That where eight years have elapsed

new has been unreasonably delayed or delayed beyond the two years named in the statute without an excuse satisfactory to the Commissioner, the later application must stand wholly upon its own merits on all points, including those of the novelty and the abandonment of the invention.<sup>3</sup> If the original applications were not abandoned, and if the new ones have been filed without unreasonable delay and within the two years limited by law, they are regarded as substitutes for and as continuations of the former, and on all questions of novelty and abandonment their dates relate back to the dates of the originals.<sup>4</sup>

since the former application was withdrawn, and others have meanwhile patented the same thing and the applicant has patented other things, the application is abandoned, see *U. S. Rifle & Cartridge Co. v. Whitney Arms Co.* (1877), 14 Blatch. 94; 11 O. G. 373; 2 Bann. & A. 493.

That an application being abandoned, a new one may be filed, see *Ex parte Crompton* (1876), 9 O. G. 5; *Davies v. Hartman* (1876), 9 O. G. 351; *Ex parte Golding* (1875), 8 O. G. 141; *Ex parte Casilear* (1875), 8 O. G. 474.

That after one application has been rejected, a new one cannot be filed except as a renewal of the former, see *Ex parte Sexton* (1873), 3 O. G. 409; *contra, Ex parte Sexton* (1876), 9 O. G. 251.

That after the rejection of an application by the Supreme Court of the District it is not renewable, though a new one may be filed, see *Ex parte Gordon* (1874), 6 O. G. 543.

<sup>3</sup> In *Lindsay v. Stein* (1882), 20 Blatch. 370, Blatchford, J. : (376) "The defendant contends that the effect of the act of 1870 is, that when an application is, under § 32, to be regarded as abandoned, no new application for a patent for the same thing can be subsequently made. There is nothing to prevent a subsequent application. When made, it can derive no aid, as to time, from the prior abandoned appli-

cation, and the applicant must stand, as to defences in suits on the patent, as if the new application were the first application." 10 Fed. Rep. 907 (913); 21 O. G. 1613 (1615).

That where a former application has been abandoned, and a new one is substituted for it, the later must be examined on its own merits by the state of the art at its date, see *Ex parte Gordon* (1874), 6 O. G. 543; *Ex parte Lo Van* (1872), 1 O. G. 226.

That the intention of an applicant to sever his applications will be regarded, and notice taken of the last only, see *Ex parte Golding* (1875), 8 O. G. 141.

<sup>4</sup> In *Godfrey v. Eames* (1863), 1 Wall. 317, Swayne, J. : (325) "In our judgment, if a party choose to withdraw his application for a patent, and pay the forfeit, intending at the time of such withdrawal to file a new petition, and he accordingly do so, the two petitions are to be considered as parts of the same transaction, and both as constituting one continuous application, within the meaning of the law."

That an application filed within a reasonable time after a prior application has been withdrawn or rejected, but not abandoned, is regarded as the successor to and continuation of the original application, see *Ex parte Livingston* (1881), 20 O. G. 1747; *Graham v. McCormick* (1880), 5 Bann. & A.



Whether or not two applications are continuous is a question of fact, to be decided by the circumstances of the case.<sup>6</sup>

244 ; 10 Bissell, 39 ; 21 O. G. 1533 ; 11 Fed. Rep. 859 ; *Ex parte* Sexton (1876), 9 O. G. 251 ; *Weston v. White* (1876), 13 Blatch. 447 ; 2 Bann. & A. 364 ; *Goodyear Dental Vulcanite Co. v. Willis* (1874), 7 O. G. 41 ; 1 Bann. & A. 568 ; 1 Flippin, 388 ; *Goodyear Dental Vulcanite Co. v. Root* (1874), 1 Bann. & A. 384 ; 6 O. G. 154 ; *Smith v. Prior* (1873), 2 Sawyer, 461 ; 6 Fisher, 469 ; 4 O. G. 633 ; *Blandy v. Griffeth* (1869), 3 Fisher, 609 ; *Howe v. Newton* (1865), 2 Fisher, 531 ; *Rich v. Lippincott* (1853), 2 Fisher, 1 ; *Adams v. Edwards* (1848), 1 Fisher, 1.

That though twenty years elapse in making successive applications, and endeavoring to secure a patent, the applications may be continuations of the original, see *Colgate v. Western Union Telegraph Co.* (1878), 15 Blatch. 365 ; 14 O. G. 943 ; 4 Bann. & A. 36.

That where a second application is made for part of an invention disclosed in a former and still pending application, the later is a continuation of the former so far as the question of two years' public use is concerned, see *Graham v. McCormick* (1880), 21 O. G. 1533 ; 10 Bissell, 39 ; 11 Fed. Rep. 859 ; 5 Bann. & A. 244.

That where an application has been withdrawn and the attorney is directed to file a new one but fails to do so within reasonable time, and one is afterwards filed and accepted by the Patent Office, they are regarded as the same, and no intermediate public use will work abandonment of the invention, see *Howes v. McNeal* (1878), 15 Blatch. 103 ; 15 O. G. 608 ; 3 Bann. & A. 376.

That applications are not continuous if the interval of delay was avoidable, see *Smith v. Dimond* (1881), 20 O. G. 742.

That a delay of eighteen years without action, after rejection, is abandonment, see *Marsh v. Commissioner* (1872), 3 Bissell, 321.

That an application filed ten years after the withdrawal of its predecessor, no action being meanwhile taken, is not a continuation of the original, see *Bovin v. East Hampton Bell Co.* (1871), 9 Blatch. 50 ; 5 Fisher, 23.

That the continuity of two applications may be interrupted without a technical withdrawal, see *Bovin v. East Hampton Bell Co.* (1871), 9 Blatch. 50 ; 5 Fisher, 23.

That when applications are continuous they take the date of the original on questions of novelty and abandonment, see *Henry v. Frankestown Soap-Stone Stove Co.* (1876), 2 Bann. & A. 221 ; 9 O. G. 408 ; *Howard v. Christy* (1876), 2 Bann. & A. 457 ; 10 O. G. 981 ; *Ex parte* Gordon (1874), 6 O. G. 543.

That where a substituted specification covers a different invention its date is the date of the application, as compared with that of a foreign patent, see *Globe Nail Co. v. Superior Nail Co.* (1886), 27 Fed. Rep. 450.

That an application, substituted for one already filed at the instance of the Patent Office, dates from the filing of the former as to the question of public use, see *International Tooth Crown Co. v. Richmond* (1887), 30 Fed. Rep. 775 ; 39 O. G. 1550.

<sup>6</sup> In *Weston v. White* (1876), 13 Blatch. 447, Shipman, J. : (452) "The continuity of the two applications is a question of fact, to be determined, in each case, upon an examination of its own circumstances. In order to ascertain this fact, the trier will find whether the inventor has abandoned his original application, either by his own will, or

§ 581. Substituted Applications are Continuations of the Original and Bear its Date.

It is immaterial how many of these substituted applications may be filed, or for how long a period such efforts to obtain a patent may be continued. The patent, when granted, will rest on the original application, as represented in its various successors, unaffected by the intermediate conduct of third parties or the current of events, unless some legislative act, embracing it in its provisions, has been passed.<sup>1</sup> New applications, after rejection or withdrawal, may be made by the original applicant, or if he has meanwhile deceased, by his personal representatives.<sup>2</sup>

§ 582. Allowance of Patent: Notice to Applicant.

Whenever by the decision of the examiner, or on appeal, it appears that the applicant is entitled to a patent, a notice of its allowance is sent to him, calling for the payment of the final fee within the period of six months as required by the statute, and if the fee is paid within this period the patent is prepared for issue. Until such notice to the applicant the patent is not "allowed" within the meaning of the law, nor does the case pass beyond the examiner's control, nor does the six months' period begin.<sup>1</sup> After notice is given of an allow-

by his acts, and whether the new application is substantially for the same invention which was originally claimed. If the two applications are found to be continuous, and it has been therefore proved that the delay in making the new application, after the rejection of the first, has not been unreasonable, under the circumstances of the case, and if the invention has not been abandoned to the public, the public use, in order to invalidate the patent, must be a use prior to the original and continuing application. Public or common use subsequent to the date of the original application, if that has been a continuing one, and the two petitions are 'parts of the same transaction,' will not avoid the patent." 2 Bann. & A. 364 (368).

See also *Bevin v. East Hampton Bell Co.* (1871), 5 Fisher, 23; 9 Blatch. 50.

§ 581. <sup>1</sup> That in a series of applications the first is the one on which the patent depends, see *Pelton v. Waters* (1874), 7 O. G. 425; 1 Bann. & A. 599.

<sup>2</sup> That when an inventor dies pending an application, his administrator or executor may file a new one, if such course does not affect the rights of third parties, see *Rice v. Burt* (1879), 16 O. G. 1050.

§ 582. <sup>1</sup> That a patent is not "passed and allowed" until the applicant or his agent is so notified under Sec. 4885, and up to that date the case is still controlled by the examiner, see *Ex parte Starr* (1879), 15 O. G. 1053.

That the formal judgment of the ex-



ance the case will not be withdrawn from issue except on the approval of the Commissioner, and if withdrawn for further action on the part of the Patent Office, and then allowed, a new notice of allowance must be given. After the final fee has been paid, and the case has received its date and number, it cannot be withdrawn for any purpose except on account of mistake on the part of the Office, or fraud or illegality in the application, or for interference proceedings. For these purposes the application is regarded as pending until the letters-patent are delivered.<sup>2</sup>

**§ 583. Allowance of Patent not Binding on Commissioner until Letters-Patent are Issued: Mandamus.**

The allowance of an application by the examiner, or by the examiners-in-chief upon appeal, does not oblige the Commissioner to grant the patent for which it prays. The law empowers him to withhold a patent whenever in his judgment the invention is not patentable, or the issue of the patent is forbidden by the statutes, or the patent if granted would probably be held invalid by the courts.<sup>1</sup> This power is not to be exer-

aminer is expressed by signing the file-wrapper and sending it to the Issue Division, and until this is done the case is under his control, see *Ex parte Buell* (1884), 26 O. G. 437.

That until the file-wrapper is signed and the application forwarded to the Issue Division the case is not decided by the examiner, whatever opinion he may have expressed or whatever advice his predecessor may have given, see *Ex parte Fredericks* (1887), 40 O. G. 691.

<sup>2</sup> That an application is pending until the patent is actually delivered, see *Ex parte Lawrence* (1879), 16 O. G. 955.

§ 583. <sup>1</sup> In *Ex parte Hunt* (1878), 13 O. G. 771, Schurz, Sec. : (771) "Until the seal is affixed the patent is not complete, and whether it shall be affixed or not in a given case, or in any case, where the merits of the application are directly brought to your attention, is a question which you must judicially

determine in the discharge of your official duty. After a patent is regularly allowed and signed, however, this right to refuse the attaching of the seal, so as to give the patent validity, should not be exercised except in extreme cases, where to attach it would be manifestly a violation of your duty as a public officer ; but where, as in this case, it appears that the patent, erroneously allowed by one of your subordinates, contains Claims which are neither novel nor meritorious and are manifestly old, although no fraud has been practised, I am of the opinion that it is your duty, although the patent may have been signed, to withhold the seal of your Office."

In *Hull v. Commissioner* (1875), 7 O. G. 559, Wylie, J. : (559) "The first question for the court to determine in the present case is this : Whether, *in an ex parte application* for a patent, the Commissioner possesses any author-

cised unnecessarily, nor to delay the patent in order that some collateral controversy may be judicially determined.<sup>2</sup> The remedy of the applicant against the Commissioner for an im-

ity, under the law, to withhold a patent in opposition to the report of a primary examiner, or the report of the Board of Examiners-in-Chief in its favor; in other words, whether, in such a case, the decision of the primary examiner, if favorable to the patent, is conclusive upon the Office, and if unfavorable, and the applicant has carried his case by appeal before the Board of Examiners-in-Chief, and there obtained a favorable decision, this latter decision is conclusive, so that nothing is left to the Commissioner except the ministerial act of countersigning and affixing the seal of the Office to the parchment. The petitioner for this writ claims that, according to the organization of the Patent Office, the question of the patentability of an alleged invention is to be referred for examination first to one of the primary or assistant examiners. If his decision be unfavorable, the applicant has the right to appeal to the examiners-in-chief. If their decision should also be unfavorable, he has the right of appeal to the Commissioner; and should the Commissioner's decision be unfavorable, the right of still further appeal to this court. In all this the petitioner's views of the law are correct; but he also claims that because his application is *ex parte*, and no one can take the appeal but himself, and nobody will ever appeal from a decision in his own favor, that the first favorable decision he obtains at any stage of the proceedings must be conclusive on the Office, since the case can go no further except by appeal. This view of the law we think is not correct." 2 MacArthur, 90 (102).

See also Opinion Atty. Gen. (1849), 5 Op. At. Gen. 220.

That under Sec. 4885 the Commissioner alone is to award the patent, and

he should withhold it even when the application has been allowed by the examiners if he considers its issue unlawful, see *Ex parte Neale* (1870), 15 O. G. 511; *Smith v. Perry* (1875), 9 O. G. 688.

That the knowledge of the Commissioner that the patent ought not to issue must be legal knowledge derived from sources recognized as evidence by the courts, see *Smith v. Perry* (1875), 9 O. G. 688.

That after the Commissioner has decided that an applicant is entitled to a patent he may reconsider his decision and withhold the patent for reasons satisfactory to himself, and no mandamus can then compel him to issue it, see *United States v. Butterworth* (1884), 3 Mackay, 229; 27 O. G. 519.

<sup>2</sup> That the Commissioner should not withhold a patent after the application has been allowed by the examiner, unless he deems it necessary, see *Disston v. Frank* (1872), 1 O. G. 305.

That an allowed application cannot be suspended by the Office unless some reference, publication, public use, or interference is alleged, see *Ex parte Atwood* (1888), 44 O. G. 341.

That the Commissioner should not withhold a patent merely to allow other proceedings in court to be determined, see *Ex parte Sargent* (1877), 12 O. G. 475.

That the relation between a process and its apparatus is not that of genus and species, and an application for the former cannot be suspended after allowance on the ground of an interference between an application for its apparatus and other apparatus, see *Ex parte Atwood* (1888), 44 O. G. 341.

That a patent cannot be withheld on moral grounds, see Opinion Atty. Gen. (1812), 1 Op. At. Gen. 170.



proper exercise of this power is by a writ of mandamus, directing the Commissioner to award the patent. A mandamus will not be granted to compel the Commissioner to perform acts which the law leaves to his discretion.<sup>3</sup> When granted it is conclusive only on the Patent Office and the public, not on other claimants of the invention.<sup>4</sup>

**§ 584. Application Forfeited by Failure of Applicant to Pay Final Fee: Application after Forfeiture.**

The failure of the applicant to pay the final fee within six months after the notice of allowance forfeits the application,

<sup>3</sup> That where the Commissioner refuses to issue a patent which he has once properly allowed, the remedy is by mandamus unless his refusal is based on a matter within his judicial discretion, see *Butterworth v. Hoo* (1884), 112 U. S. 50; 29 O. G. 615; *Hull v. Commissioner*, (1875), 7 O. G. 559; 2 *MacArthur*, 90.

That a mandamus will not lie against the Commissioner when the matter is within his discretion, see *United States v. Marble* (1882), 22 O. G. 1365; *Bigelow v. Commissioner* (1875), 7 O. G. 603; 2 *MacArthur*, 24.

That if the Commissioner having decided to issue a patent does not change his decision, and still unreasonably delays to issue the patent, a mandamus will lie, see *United States v. Butterworth* (1884), 3 *Mackay*, 229; 27 O. G. 519.

That the delay of the Commissioner to let the opinion of the Secretary of the Interior be taken is not an act of discretion but of deference, and a mandamus will lie, see *United States v. Butterworth* (1884), 3 *Mackay*, 229; 27 O. G. 519.

That a Commissioner, having made return to a mandamus that he withholds the patent merely to await the action of the Secretary of the Interior, cannot afterwards claim that he desires to rehear the case himself, see *Gill v. Scott* (1884), 29 O. G. 949.

That proceedings will not lie against

the Commissioner unless he refuses to issue the patent after the Secretary of the Interior has signed it, see *Whitely v. Fisher* (1870), 4 *Fisher*, 248.

That a mandamus against the Commissioner pending in the Supreme Court of the District, to which the Commissioner has duly made his return, is not affected by the laches of the petitioner, see *Withington v. Locke* (1878), 15 O. G. 426.

That the resignation of the Commissioner, after a return made on the mandamus, will abate it, see *Withington v. Locke* (1878), 15 O. G. 426.

That the refusal of the Commissioner to award a patent, on grounds within his discretion, may be reviewed by a bill in equity, see *Hull v. Commissioner* (1875), 7 O. G. 559; 2 *MacArthur*, 90.

That on a bill in equity the courts may authorize but cannot compel the Commissioner to issue a patent, see *Vermont Farm Machine Co. v. Marble* (1884), 20 *Fed. Rep.* 117; 22 *Blatch.* 128; 27 O. G. 622.

That a bill in equity to obtain a patent is not a substitute for a mandamus, see *United States v. Butterworth* (1884), 3 *Mackay*, 229; 27 O. G. 519.

<sup>4</sup> That where the court orders the Commissioner to issue a patent the order is conclusive only against the public, not against other applicants, see *Cruikshank v. Strong* (1880), 17 O. G. 511.

and no patent can be issued thereon. At any time, however, within two years after the notice of allowance has been given, the applicant, or any other person interested in the invention as its inventor or assignee, may file a new application for the same invention, using the original oath, petition, specification, drawing and model, if he pleases, but paying a new fee.<sup>1</sup> This second application is not considered as a continuation of the former, but will bear date from the time of the renewal, and will be examined and passed upon like an original application.<sup>2</sup> In its examination the novelty of the invention will be determined by the state of the art when the original was filed, not by its present state as in the case of an application wholly new, and the question of abandonment will be investigated and de-

§ 584. <sup>1</sup> That where a patent has been forfeited for non-payment of the final fee, a renewal application may be filed within two years, but not afterward, see *Ex parte Hardy* (1877), 12 O. G. 1075; *Ex parte McCully* (1874), 6 O. G. 153.

That failure to pay the final fee is an incurable forfeiture, though unavoidable, see *Ex parte Barnitz* (1887), 41 O. G. 575.

That notwithstanding *Ex parte Barnitz* (41 O. G. 575), a new original application may be filed after two years, see *Ex parte Barnitz* (1888), 42 O. G. 1061. See also *Thomson v. Waterhouse* (1884), 30 O. G. 177.

That after two years' delay there can be no renewal application, see *Thomson v. Waterhouse* (1884), 30 O. G. 177.

That a renewal application is like a motion to revive a judgment, see *Thomson v. Waterhouse* (1884), 30 O. G. 177.

That an assignee of the invention before patent has a right to renew an application after a former one by the inventor has been forfeited, see *Ex parte Eveleigh* (1872), 1 O. G. 303.

That an assignee may make and swear to a renewal application, see *Thomson v. Waterhouse* (1884), 30 O. G. 177.

That the renewal of an application by a person not the attorney of record, without the knowledge of the applicant, is void, see *Consolidated Fruit Jar Co. v. Bellaire Stamping Co.* (1886), 27 Fed. Rep. 377; 35 O. G. 627.

That the ratification of an unauthorized act of an attorney in renewing an application cannot affect intervening rights, see *Consolidated Fruit Jar Co. v. Bellaire Stamping Co.* (1886), 27 Fed. Rep. 377; 35 O. G. 627.

That there is no rule or statute which authorizes an applicant to forfeit an allowed application, file a renewal within six months, and pay the application fee, as if a forfeiture had already occurred, see *Ex parte Manny* (1888), 44 O. G. 700.

<sup>2</sup> That a renewal application within two years in lieu of a forfeited one, under Sec. 4897, is for some purposes a continuation of the other and relates back to it, taking its date, see *Thomson v. Waterhouse* (1884), 30 O. G. 177.

That where an application was allowed Dec. 22, 1877, and forfeited for non-payment, but renewed Feb. 4, 1879, the renewal was regarded as a new application and stood on its own date, as to two years' public use, see *Weir v. Morden* (1884), 29 O. G. 83.



cided as a question of fact<sup>3</sup> While an application remains forfeited no notice is given to the applicant of any subsequent applications, and neither forfeited nor abandoned applications are cited as references to defeat a later applicant.<sup>4</sup> Forfeited applications remain in the secret archives of the Patent Office, open to the inspection only of the applicants or their attorneys, but copies of them may be given to other persons when specifically ordered by the Commissioner.

§ 585. Final Fees: how Paid: Delivery of Patent.

The final fee may, like the entrance fee, be paid to the Commissioner, or to the Treasurer or any of the Assistant Treasurers of the United States, or to any of the depositaries, national banks, or receivers of public money designated by the Secretary of the Treasury for that purpose, whose receipt may be transmitted to the Patent Office. The patent will be delivered or mailed on the day of its date to the patentee, unless there be an attorney of record, in which case it will be delivered to him or to the patentee as the attorney may require, but without a special request to that effect it will not be given to an associate or substitute attorney.

<sup>3</sup> That a renewal application will be examined in the light of the state of the art at the time the original was filed, see *Ex parte Livingston* (1881), 20 O. G. 1747; *Ex parte Gordon* (1874), 6 O. G. 543.

That a new application, filed more than two years after forfeiture, is defeated by any matter in bar arising after the forfeiture, see *Ex parte Livingston* (1881), 20 O. G. 1747.

That a delay in renewing an application raises a suspicion of abandonment and the oath should negative it, see *Thomson v. Waterhouse* (1884), 30 O. G. 177.

That delay in renewing an applica-

tion is not conclusive proof of abandonment of the invention, see *U. S. Rifle & Cartridge Co. v. Whitney Arms Co.* (1877), 11 O. G. 373; 14 Blatch. 94; 2 Bann. & A. 493.

<sup>4</sup> That a forfeited application is dead and is not in the way of other applications, see *Opinion Acting-Com.* (1877), 12 O. G. 979.

That a "withheld application" is one held in abeyance and revivable on paying a new fee, but is abandoned after two years, see *Ex parte Livingston* (1881), 20 O. G. 1747.

That Sec. 35, act 1870, does not refer to applications then pending, see *Ex parte Mygatt* (1877), 12 O. G. 51.

## SECTION X.

## OF THE APPLICATION : PROCEDURE IN INTERFERENCE CASES.

## § 586. Interference Proceeding Instituted to Determine Priority between Rival Inventors.

The procedure heretofore described is that which is pursued in uncontested or *ex parte* cases. Upon all questions relating to the patentability of an invention and the fact of its discovery by the alleged inventor, the only parties in interest are the public on one side and the inventor on the other; and the examination instituted in the Patent Office upon the filing of the application is regarded as sufficient both to protect the public rights and to secure the lawful privileges of the inventor. But when there are rival claimants for the same invention, to neither of whose applications, if each stood alone, could any effectual objection be urged in the interest of the public, the question as to which of these inventors is entitled to a patent still remains, and in the investigation of this question adverse individual interests appear. The law, which authorizes the grant of but a single patent for the invention, awards it to that one of the claimants who first conceived the idea of the art or instrument described, provided he has used due diligence in reducing it to practice. To determine this fact a judicial proceeding becomes necessary, in which the several rivals are parties adverse to each other, having a right to be heard by evidence and argument in vindication of their own claims and in opposition to the claims of their antagonists, and which results in a judgment in favor of some one of them as the lawful patentee.<sup>1</sup> This judicial

§ 586. <sup>1</sup> In *Hibbard v. Richmond* (1880), 17 O. G. 1155, Doolittle, Act. Com. : (1156) "The first and original inventor, whose invention has not been in public use or on sale more than two years prior to his application, and who has not abandoned the same to the public, is entitled to a patent for his inven-

tion upon making a proper application, and if on examination of such application it shall appear that the applicant is justly entitled to a patent under the law, and that the same is sufficiently useful and important, it becomes the imperative duty of the Commissioner to grant him letters-patent. The whole



proceeding forms the only contested case now known in the Patent Office, and is called an Interference.<sup>2</sup>

§ 587. **History of Interference Proceedings.**

An interference is a proceeding instituted for the purpose of determining the priority of the inventive act between two or more parties who claim substantially the same patentable invention.<sup>1</sup> This proceeding first appeared in our law in the act of 1793, which provided that interfering applications should be submitted to the arbitration of three persons, — two chosen by the applicants and the third appointed by the Secretary of State, — whose award should be final.<sup>2</sup> The act

machinery of the Office under the law is framed for this purpose, and if the Commissioner at any time finds that he has granted a patent to one who is not the first and original inventor, but that the first and original inventor is another person whose application is pending before him, it is his duty to grant a second patent to such applicant. The manner of trying the fact as to whether an applicant in any given case is the first and original inventor when his application conflicts with another pending application or with an unexpired patent is prescribed by section 4904, Revised Statutes, and the proceeding is known as an 'interference.'

<sup>2</sup> That an interference is now the only contested case in the Patent Office, see *Little v. Lillie* (1876), 10 O. G. 543.

§ 587. <sup>1</sup> That in an interference proceeding the sole question is that of the priority of the inventive act, see *Hicks v. Keating* (1887), 40 O. G. 343; *Swift v. Rochow* (1880), 17 O. G. 450; *Laverty v. Flagg* (1879), 16 O. G. 1141; *Ex parte Knox* (1879), 16 O. G. 1048; *Miller v. Miles* (1877), 11 O. G. 197; *Lagowitz v. Topham* (1875), 9 O. G. 742; *Dana v. Greenleaf* (1875), 9 O. G. 198; *Smith v. Perry* (1875), 9 O. G. 688; *Bigelow v. Commissioner* (1875), 7 O. G. 603; 2 *MacArthur*, 24.

That disputes between patentees and their assignees cannot be determined in an interference proceeding, see *Swift v. Rochow* (1880), 17 O. G. 450.

That an interference is declared between applications rather than applicants, and is intended to find out which invention was first produced, not who has the title, and want of title may appear without a statutory bar being proved, see *Hicks v. Keating* (1887), 40 O. G. 343.

<sup>2</sup> In *Little v. Lillie* (1876), 10 O. G. 543, Duell, Com., gives the following short history of interferences: (544) "The first laws relating to interfering applications were passed in 1793, when, under the system then in practice, patents were grantable as a matter of course, the only examination being to determine whether the invention was sufficiently useful and important and the papers in proper form. Even at that early date it was found necessary to provide a means whereby to determine which of two or more persons was the first and original inventor, and for this purpose it was provided that the matter should be submitted to arbitrators. The act of 1836, establishing the Patent Office, inaugurated a new system, which, with various modifications, has since been adopted. The office of Commissioner of Patents

of 1836 gave to the Commissioner the authority to hear and decide these controversies, subject to an appeal to the board of

was then created, and his powers and duties were defined to be 'under the direction of the Secretary of State to superintend, execute, and perform all such acts and things touching and respecting the granting and issuing of patents for new and useful discoveries, inventions, and improvements, as herein provided for, or shall hereafter, by law, be directed to be done and performed.' Section 6 of said act prescribed the conditions upon which a patent should be granted, and section 7 required the Commissioner to cause an examination of each application to be made, in order to determine whether, under the statute, the party was entitled to a patent, and, if found not, then he was to refuse the grant. As a matter separate and distinct from this examination, provision is made in section 8 for interferences, as follows: 'That whenever an application shall be made for a patent, which, in the opinion of the Commissioner, would interfere with any other patent for which an application may be pending, or with any unexpired patent which shall have been granted, it shall be the duty of the Commissioner to give notice thereof to such applicants or patentees, as the case may be, and if either shall be dissatisfied with the decision of the Commissioner on the question of priority of right or invention on a hearing thereof, he may appeal from such decision on the like terms and conditions as are provided in the preceding section of this act; and the like proceedings shall be had to determine which or whether either of the applicants is entitled to receive a patent as prayed for.' The appeal, like that in cases arising from a second rejection under sections 6 and 7, was to be taken to a Board of Examiners appointed for the purpose. By the act of 1839 this Board

was abolished, and the Chief Justice of the District substituted as the appellate tribunal. The act of 1852 gave to the assistant judges the same authority to hear appeals as the Chief Justice. Section 2 of the act of 1861 created the Board of Examiners-in-Chief, whose duty it was made 'to revise and determine upon the validity of decisions made by examiners when adverse to the grant of letters-patent; and also to revise and determine in like manner upon the validity of the decisions of examiners in interference cases.' From the decision of this Board an appeal would lie to the Commissioner. The condition of the law at this time made it necessary that interferences be declared for determining the question of priority between two or more persons in order that the first and original inventor might be discovered. The primary examiners were intrusted with the decision of these cases, and, like *ex parte* cases, their action could be appealed from to the Board of Examiners-in-Chief, from them to the Commissioner, and thence to any of the justices of the District Court. On the 8th of July, 1870, the laws relating to patents were revised and the Patent Office reorganized, several marked and important changes being made in the practice. The provisions for interferences were contained in section 42 (R. S. 4904), as follows: 'Whenever an application is made for a patent, which, in the opinion of the Commissioner, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be, and shall direct the primary examiner to proceed to determine the question of priority of invention. And the Commissioner may issue a patent to the party who is adjudged the prior in-



examiners. In 1839 the right of an appeal to the Chief Justice of the District Court of the United States for the District of Columbia, instead of to the board of examiners, was conferred on the defeated party, and the decision of the Chief Justice was made conclusive as to all further proceedings in the case. The act of 1861 intrusted the determination of this question to the primary examiners, subject to appeal to the examiners-in-chief, whose judgment in its turn could be revised by the Commissioner. The act of 1870 directed that a special examiner of interferences should be appointed in the Patent Office, before whom these contested cases should be heard, and from whose finding an appeal might be taken to the examiners-in-chief and from them to the Commissioner, whose decision should be final. The latter is the present system of procedure.

**§ 588. Interference Proceedings Instituted only between Pending Applications or between a Pending Application and an Unexpired Patent.**

An interference can be instituted only between two or more pending applications, or between a pending application

ventor, unless the adverse party appeals from the decision of the primary examiner, or of the Board of Examiners-in-Chief, as the case may be, within such time, not less than twenty days, as the Commissioner shall prescribe.' A special examiner was provided to attend to interference cases. Appeal to the Board and the Commissioner was allowed as in *ex parte* cases, but here the former practice and analogy ceased. While *ex parte* cases were appealable to the Supreme Court of the District of Columbia sitting in *banc*, instead of the justices, interferences could not be taken beyond the Commissioner, his decision being final. The work of the Office was then divided into *ex parte* and contested cases, the former to be considered by the primary examiners, from whose action an appeal might ultimately be

taken to the Supreme Court of the District, and the latter to the examiner of interferences, whose action was limited to the decision of the question of priority of invention, of which the Commissioner was the last appellate tribunal. In order to facilitate the practice of the Office, the present rules were adopted. They require that the primary examiner shall settle all questions relating to the patentability of the invention before he declares the preliminary interference, for upon doing this the case is at once transferred to the examiner of interferences. The jurisdiction of the examiner of interferences extends only to the determination of the question of priority of invention and matters incidental thereto, in the manner prescribed by the rules."

and an unexpired patent. Where patents already granted conflict with one another, the Patent Office has no authority over them, and the rival patentees must seek the solution of their difficulties in the courts.<sup>1</sup> Where a patent has expired the patentee has no longer any right requiring protection or which he can be called upon to vindicate as against later applications.<sup>2</sup> Forfeited and abandoned applications have no standing in the Patent Office as the basis of any claim or the allegation of any right on the part of their applicants, and are not noticed in the examination of other applications.<sup>3</sup> The jurisdiction of the Patent Office extends to applications alone, and to those only while actually pending before it.<sup>4</sup> Its judgment upon an interference can affect only the applicant to whom it refuses or allows a patent, a rival claimant who has previously obtained a patent continuing to hold it until it is declared invalid by the courts although the later applicant has proved his own priority before the interference tribunal and received his patent.<sup>5</sup>

§ 588. <sup>1</sup> That an interference between two or more patents cannot be adjudicated in the Patent Office, see *Nicholson v. Bennett* (1879), 16 O. G. 631; *Wilson v. Yakel* (1876), 10 O. G. 944.

<sup>2</sup> That an interference cannot be declared against an expired patent, see *Ex parte Mason* (1876), 9 O. G. 1196.

<sup>3</sup> That no interference can be declared with forfeited or abandoned applications, see *Starr v. Farmer* (1883), 23 O. G. 2325; *Opinion of Acting-Com.* (1877), 12 O. G. 979; *Ex parte Spear* (1874), 5 O. G. 201.

<sup>4</sup> That an interference is declared whenever the Claims of a pending application conflict with those of another application or an unexpired patent, see *Sawyer v. Edison* (1883), 25 O. G. 597; *Western Electric Light Co. v. Chicago Electric Light Mfg. Co.* (1882), 11 *Bissell*, 427; 14 *Fed. Rep.* 691; *Little v. Lillie* (1876), 10 O. G. 543.

That an applicant is not entitled to

an interference with an unexpired domestic patent till he has been rejected thereon, see *Ex parte Massicks* (1887), 38 O. G. 1489.

That an interference should be declared between an application and an unexpired patent, although the applicant's foreign patents are older than the conflicting patent, see *Ex parte Bland* (1879), 16 O. G. 47.

That in an interference it is no advantage to have a patent unless the patentee is the original inventor, see *Ex parte Russell* (1874), 5 O. G. 149.

That an interference becomes necessary because the dates of conflicting applications are not conclusive on the question of priority, see *Thomas v. Reese* (1880), 17 O. G. 195.

<sup>5</sup> That a judgment against a patent, in an interference case, does not annul the patent, but simply awards a patent to the rival, see *C. A. Yale Cigar Mfg. Co. v. Yale* (1884), 30 O. G. 1183.



**§ 589. Interference Proceedings Instituted only between Conflicting Applications, or between an Application and a Conflicting Patent.**

An application does not conflict with another application, or an unexpired patent, unless the invention covered by each specification is substantially the same.<sup>1</sup> Similarity or diversity in name and appearance are of no consequence.<sup>2</sup> Every invention occupies toward every other the relation either of identity or of equivalence or of specific difference or of generic difference. Applications for identical or equivalent inventions are applications for the same invention. Applications for

§ 589. <sup>1</sup> That patents or applications conflict only when they claim, in whole or in part, the same invention, see *Ex parte* Lasscell (1884), 28 O. G. 1274; *Sawyer v. Edison* (1883), 25 O. G. 597; *Drawbaugh v. Blake* (1883), 23 O. G. 1221; *Gold & Silver Ore Separating Co. v. U. S. Disintegrating Ore Co.* (1869), 3 Fisher, 489; 6 Blatch. 307; *Marvin v. Lillie* (1867), 27 O. G. 299.

That on an interference the Claims actually made are considered, but the examiner must have regard to the whole specification and to the Claims which might be made, see *Ex parte* Wheeler (1883), 23 O. G. 1031.

That the rules governing interferences should be liberally construed, so that patents may be restricted to such inventions as the patentees can justly claim, see *Drawbaugh v. Blake* (1883), 23 O. G. 1221.

That if an applicant claims anything covered by a prior patent the patentee must be notified, and have a chance to contest it, see *Marvin v. Lillie* (1867), 27 O. G. 299.

Under former rules of the Patent Office, an interference was declared where applications might be amended so as to include conflicting Claims, though the conflicting matter were not claimed in the application at the time the interference was instituted. At present the rules forbid the declaration

of an interference until after the conflict appears specifically in the Claims. The foregoing cases, and also the following, should be read in view of this change in the rule.

<sup>2</sup> That an interference should be declared when the inventions conflict though the Claims do not, see *Drawbaugh v. Blake* (1885), 30 O. G. 259.

That immaterial differences in the Claims of conflicting applications will be disregarded, and an interference declared, if the matter claimed is substantially the same, see *Drawbaugh v. Blake* (1883), 23 O. G. 1221.

That the subjects of an interference are things not words, see *Ex parte* Upton (1884), 27 O. G. 99; *Greenough v. Drummond* (1879), 16 O. G. 586; *Nicholson v. Bennett* (1879), 16 O. G. 631; *Drummond v. Greenough* (1879), 16 O. G. 959.

That an interference may exist though the inventions have different names, see *Hoe v. Scott* (1878), 14 O. G. 447.

That inventions interfere if they are equivalents for each other, though they differ in appearance, see *Withington v. Locke* (1877), 11 O. G. 417.

That an application for a design may interfere with one for a mechanical invention, if both claim the same subject-matter, see *Collender v. Griffith* (1873), 3 O. G. 91.

inventions generically different are wholly distinct and independent of each other. Applications for inventions specifically different are distinct and independent, unless the inventor of one species also claims the genus to which both belong and the inventor of the other species fails to disclaim it in his application.<sup>3</sup> An interference can, therefore, be properly declared only when the inventions, as described and claimed in the applications or the patent, are identical or equivalent, or where being specifically different they do involve, or may involve, a claim to the generic invention in which both are embraced.<sup>4</sup> It is not, however, necessary that the scope of the Description or the subject-matter of the Claims, as presented in each patent or each application, should be the same. If that which is described in one is contained within the Description of the other, or if the Claims of one could by amendment be lawfully incorporated in the other, the inventions are sufficiently identical to warrant this proceeding.<sup>5</sup>

<sup>3</sup> In *Banks v. Snediker* (1880), 17 O. G. 508, Paine, Com. : (510) "The relation of two interfering inventions to each other must, in contemplation of law, always be either that of (1) identity, or (2) equivalence, or (3) specific difference, or (4) generic difference. In the first two classes of cases the earlier is absolutely fatal to the later invention; in the fourth, it presents no obstacle to the patentability of the later invention; in the third, the prior invention is no bar to a specific patent for the later invention, subject to a generic patent covering both species."

<sup>4</sup> That no interference should be declared unless an applicant claims what has been granted to or applied for by another, see *Ex parte Platts* (1879), 15 O. G. 827.

That where one application claims the genus and another the species, they will interfere unless the latter disclaims the genus, see *Ex parte Gardner* (1880), 17 O. G. 626.

That a patent with a Claim for a species will not be granted while an ap-

plication claiming the genus is pending, unless after an interference hearing, see *Ex parte Upton* (1884), 27 O. G. 99; *Ex parte Holt* (1884), 29 O. G. 171.

That where one Claim includes the other an interference should be declared, see *Ex parte Upton* (1884), 27 O. G. 99.

That if a narrow Claim be included in a broad Claim an interference is the proper method of determining who is entitled to the broad Claim, see *Ex parte Upton* (1884), 27 O. G. 99.

That Claims for inventions which are mere double uses interfere, see *Drawbaugh v. Blake* (1883), 23 O. G. 1221.

That a Claim for carrying an invention into use in a specific way does not interfere with a Claim for the invention itself, see *Drawbaugh v. Blake* (1883), 23 O. G. 1221.

That a single Claim in one application may interfere with several Claims collectively in another, see *Drawbaugh v. Blake* (1883), 23 O. G. 1221.

<sup>5</sup> That applications conflict with each



§ 590. Interference Proceedings Instituted only when the Later Applicant Claims Priority of Inventive Act.

An interference cannot be instituted between conflicting applications, or between an application and a conflicting patent, unless the later applicant claims that his own inventive act preceded that of the former applicant or patentee.<sup>1</sup> Where a conflicting patent has been issued before the filing of the rival application this claim to priority must be explicitly stated.<sup>2</sup> The grant of letters-patent raises a presumption of priority in favor of the patentee against all future applicants, and their applications are, therefore, rejected by the Patent Office on a reference to a prior patent, unless the applicant avers upon his oath that his inventive act anticipated the filing of the application upon which the patent was allowed. This presumption extends to every application for re-issue based

other when anything that is shown in one is claimed in the other, see *Bell v. Gray* (1879), 15 O. G. 776.

That an application conflicts with a patent when it claims anything shown by the patent, see *Bell v. Gray* (1879), 15 O. G. 776; *Marvin v. Lillie* (1867), 27 O. G. 299.

That two applications for combinations, one wanting an element of the other but otherwise identical in operation and effect, interfere, since the lesser anticipates the larger, and the interference can be prevented or dissolved only when the applicant for the lesser disclaims the larger, see *Banks v. Snediker* (1880), 17 O. G. 508.

That where a design can be produced only by a certain device, an application for the latter conflicts with a patent for the former and an interference should be declared, see *Collender v. Griffith* (1873), 3 O. G. 91.

That no interference will be declared with an improper divisional application, see *Ex parte Holt* (1884), 29 O. G. 171.

§ 590. <sup>1</sup> That an interference will not be declared between pending applica-

tions, or an application and an unexpired patent, unless the later applicant claims priority under oath, see *Thomas v. Reese* (1880), 17 O. G. 195; *Ex parte Nagel* (1880), 17 O. G. 198.

That where the record conclusively establishes priority no interference should be declared, see *Ex parte Nagel* (1880), 17 O. G. 198.

That the application-oath has nothing to do with priority, see *Sellon v. Hochhausen* (1885), 33 O. G. 995.

That in order to obtain an interference with a patent, an applicant must make oath that he completed his invention before the patentee's application was filed, and must state the facts which prove it, and not merely aver that he invented before the patent issued, see *Ex parte Graydon* (1883), 25 O. G. 192.

<sup>2</sup> That in a conflict between an application and a patent, the patent makes a *prima facie* case for the patentee, see *Paul v. Dorland* (1873), 4 O. G. 552.

That an applicant in conflict with a prior patent must show that he was the first to conceive and used reasonable diligence in reducing to practice, see *Hammond v. Laird* (1874), 7 O. G. 170.

upon such prior patent, which must prevail over all other applications, whether original or based on later patents, unless the later applicant alleges and proves his own priority. No such presumption, however, exists in favor of one pending original application against another,<sup>3</sup> or of a patent granted after the filing of its rival application,<sup>4</sup> or of a re-issue application based upon a patent issued after the antagonistic application had been filed. Each of such conflicting applications is regarded as hostile to the others, and so asserting a priority in favor of its own individual applicant against all the rest.

### § 591. Interference Proceedings Instituted in Nine Special Cases.

In accordance with these principles an interference can be instituted in the following cases: (1) Between two or more original conflicting applications; (2) Between an original application and an unexpired patent granted during the pendency of such original application; (3) Between an original application and an application for the re-issue of a patent granted during the pendency of such original application; (4) Between two or more applications for the re-issue of patents granted on applications pending at the same time; (5) Between an original application and an unexpired patent, granted before such application had been filed, provided the applicant, after the rejection of his application upon reference to the patent, avers on oath that he made the invention before the original application of the patentee was filed; (6) Between an original application and an application for the re-issue of a patent granted before such original application was filed, provided the applicant avers on oath that he made the invention

<sup>3</sup> That an interference is declared whenever the oath and application of one claimant is neutralized by the oath and application of another, see *Little v. Lillie* (1876), 10 O. G. 543.

<sup>4</sup> That where one of two contesting applicants has obtained a patent an interference may be declared *nunc pro tunc*, see *Ex parte Marston* (1882), 21 O. G. 633.

That an "unexpired patent" means one granted before the conflicting application was filed, see *Ex parte Marston* (1882), 21 O. G. 633.

That conflicting applications are hostile, whenever filed, and the premature issue of a patent to one does not affect the rights of the other, see *Ex parte Marston*, (1882), 21 O. G. 633.



before the original application for the patent sought to be re-issued had been filed; (7) Between two or more applications for the re-issue of patents whose original applications were not pending at the same time, provided the applicant for a re-issue of the later patent avers on oath that he made the invention before the original application on which the earlier patent issued had been filed; (8) Between an application for re-issue and an unexpired patent, provided the original applications for each patent were pending at the same time, and the re-issue applicant avers on oath that he made the invention before the original application of the other patentee was filed; (9) Between an application for the re-issue of a later unexpired patent and an earlier unexpired patent which was granted before the original application for the later patent had been filed, provided the re-issue applicant avers on oath that he made the invention before the filing of the original application for the earlier patent. In the first four cases it will be perceived that no such presumption of priority exists in favor of either party as requires an express averment on the part of the other to authorize an interference, while in the last five cases such a presumption does arise from the previous action of the Patent Office in favor of the earlier patentee, which can be rebutted only by a distinct claim under oath to a priority over the opposing applicant or patentee.<sup>1</sup>

§ 591. <sup>1</sup> In *Ex parte Nagel* (1880), 17 O. G. 198, Paine, Com. : (199) "An original application will be placed in interference with an unexpired patent if the applicant shall, by affidavit, show his ability to controvert the *prima facie* proof furnished by the date of the unexpired patent by showing that he made the invention before the patentee filed his application. So an original application may be placed in interference with a re-issue application, notwithstanding the *prima facie* evidence of priority afforded by the date of the patent of which a re-issue is sought, if the original application shall be fortified by an affidavit of the applicant showing that he made the invention before the

patentee's original application was filed. Again, an interference will be declared between applications for the re-issue of patents granted on applications not pending at the same time, if the applicant for re-issue of the later patent shall support his application with an affidavit showing that he made the invention before the application on which the earlier patent issued was filed. The same principle obtains in all other cases provided for by the rules. . . . (200) It is provided in section 4904 of the Revised Statutes that, 'whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application, or with any unexpired patent, he shall

§ 592. Interference Proceedings: Notice of Interference to the Rival Claimants.

The first step in an interference is to secure from the adverse parties an exact statement of their conflicting claims

give notice thereof to the applicants or applicant and patentee, as the case may be, and shall direct the primary examiner to proceed to determine the question of priority of invention.' This obviously does not mean that the Commissioner is to declare an interference whenever an application is filed in which is claimed an invention which is also claimed in an unexpired patent. On the contrary, as a rule, an application is to be rejected if it contains a Claim embraced in an unexpired patent. It is only when the applicant makes oath that he made the invention before the filing of the patentee's application that an interference is declared between an original application and an unexpired patent. If, instead of the *prima facie* proof furnished by the date of the patentee's application and of his patent, on the one hand, and the contradictory proof furnished by the affidavit of the applicant, the record presented conclusive proof in favor of either party, an interference would be a frivolous proceeding, for which the Commissioner would be able to find no excuse."

That no *prima facie* showing of priority on the record can prevent a later applicant from claiming an interference, upon making the proper averments under oath, see *Ex parte Nagel* (1880), 17 O. G. 198.

That an interference should be declared between an application and an unexpired patent showing the same invention, although the applicant's foreign patents are older than the patent in question, see *Ex parte Bland* (1879), 16 O. G. 47.

That an applicant for re-issue is not allowed to establish his priority against

an expired patent, see *Ex parte Mason* (1870), 9 O. G. 1196.

That an interference may be declared between a re-issue application and applications filed or patents granted since the date of the original patent, see *Sargent v. Burge* (1876), 10 O. G. 285; *Mayall v. Murphy* (1874), 5 O. G. 339; *contra*, *Carroll v. Morse* (1876), 9 O. G. 453; *Becker v. Throop* (1875), 8 O. G. 1; *Paris v. Bussey* (1875), 8 O. G. 859.

That one of two joint patentees may subsequently file a sole application and have an interference declared between it and the joint patent, whereupon if he be found to have been the sole inventor a patent will be granted to him notwithstanding his former oath as joint inventor, see *Kohler v. Kohler* (1888), 48 O. G. 247.

That when, between two successive applications by the same applicant, another application is filed by a different inventor, an interference will be declared, see *Ex parte Golding* (1875), 8 O. G. 141.

That where a patent issues on one of two pending applications without an interference, the patentee will have no advantage on that account over his rival, but an interference will be declared as if no patent had been granted, see *Gordon v. Withrington* (1876), 9 O. G. 1009; *Smith v. Barter* (1874), 7 O. G. 1; *Brookfield v. Brooke* (1873), 4 O. G. 81; *Goodman v. Scribner* (1872), 2 O. G. 673.

That when one application conflicts with two or more patents only one interference should be declared and all be made parties, see *Wilson v. Yakel* (1876), 10 O. G. 944.

That whether an interference shall



in such a form that the Patent Office can judicially act upon them. For this purpose, whenever the examiner in charge of any application discovers that its Claims conflict with those of any other application, or of any unexpired patent, or with any pending caveat, it is his duty to notify such applicants or patentees or caveators and, if necessary, to require them to state their Claims in such a manner that the nature and extent of their antagonism will become distinct and unmistakable.<sup>1</sup> Upon the receipt of this notice and within the time therein specified, all parties must put their Claims in such condition that no further change in them will be required to precisely cover their respective rights. By this method the jurisdiction of the Patent Office over all the parties and the subject-matter in controversy is rendered as complete as possible, and the issues between them are clearly and specifically defined. Any want of exactness in the statement of his Claim, on the part of either of the contestants, is a sufficient reason for requiring him to further amend it, no alteration being permitted after final judgment in the interference unless the testimony adduced upon the trial necessitates or justifies the change. Parties who fail to comply with the requirements of this notice will be excluded from the interference, but without prejudice to any other right than that of being heard therein.

**§ 593. Interference Proceedings: Examination of Conflicting Applications on their Merits.**

The next step in the interference is to ascertain the right of each claimant to a patent for the invention as against the

be declared is a matter for the Commissioner to decide and from his decision there is no appeal, see *Ex parte Gower* (1879), 15 O. G. 828.

§ 592. <sup>1</sup> Under former rules of the Office an interference could be instituted between claimants where patents or applications might be amended to claim the same patentable matter, see Rules prior to 1881, and *Ex parte Bland* (1879), 16 O. G. 47. Under present rules no interference is declared unless

the rival application or patent claims the same subject-matter.

That the primary examiner must decide whether Claims interfere, see *Faure v. Bradley* (1888), 44 O. G. 945; *Ex parte Saunders* (1883), 23 O. G. 1224.

That adverse parties in interference will be allowed to see copies of interfering Claims and specifications, but no other persons can have access to the interference files, see *Ex parte Fischer* (1887), 38 O. G. 1237.

public and irrespective of the question of priority. No applicant is entitled to become a party to an interference unless his right against the public is complete. He must have performed an entire inventive act, not only conceiving an idea of means but also reducing it to successful practice, and must have produced an art or instrument belonging to one of the protected classes, possessing novelty and utility, and not abandoned to the public.<sup>1</sup> In this inquiry each applicant stands alone, neither aided nor obstructed by the acts or achievements of any other applicant; and if it becomes apparent that on his individual merits he could not lawfully receive a patent, he cannot be permitted to engage in any contest for priority with those whose applications might be properly allowed.<sup>2</sup> Upon all the questions thus arising the examiner must pass as in ordinary *ex parte* applications, with the same rights of appeal as heretofore described.<sup>3</sup>

#### § 594. Interference Proceedings: Definition of Issues.

The third step in the interference is to define the issues upon which the judgment of the Patent Office is desired.

§ 593. <sup>1</sup> That all questions as to the patentability of the subject-matter must be disposed of before the interference is formally declared, and questions not then raised will be waived, see *Ex parte Bland* (1879), 16 O. G. 47; *Anson v. Woodbury* (1876), 11 O. G. 243.

That questions as to novelty must be settled before the interference is declared, see *Bennage v. Phillippi* (1876), 9 O. G. 1159; *Wood v. Morris* (1873), 3 O. G. 239.

That before an interference is declared it should appear that both inventions have been reduced to successful practice, see *Sargent v. Burge* (1877), 11 O. G. 1055.

That a declaration of interference rests upon the assumption that the applications or patents cover operative devices, but such presumption is not conclusive and the question of operativeness may be raised and determined at any

time in settling that of priority, see *Voelker v. Gray* (1885), 30 O. G. 1091.

<sup>2</sup> That the reduction to practice of one of the conflicting inventions cannot be inferred from that of the other, see *Sargent v. Burge* (1877), 11 O. G. 1055.

That the existence of a patent is *prima facie* evidence of reduction to practice, though no practical use is shown, see *Busha v. Phelps* (1876), 9 O. G. 1010.

That abandonment by one inventor does not affect the other, see *Harnet v. Reese* (1882), 21 O. G. 1875.

<sup>3</sup> That the examiner of interferences has no jurisdiction over the question of patentability as such, though he may dispose of the question when collaterally raised in the trial of the interference, see *Faure v. Bradley* (1888), 44 O. G. 945.



This is also the duty of the examiner.<sup>1</sup> These issues must be based upon the applications and patents of those who have been found by him to be entitled to become parties to the interference, and must represent what they actually claim, not what they might claim.<sup>2</sup> They must contain a summary of the contested matter, and point out the conflicting Claims.<sup>3</sup> Hypothetical issues cannot be permitted.<sup>4</sup> They must have the same meaning as to all the claimants; and if susceptible of various meanings that one will be adopted which sustains the interference as declared, and best agrees with the specifications of the parties.<sup>5</sup> The construction placed upon an issue by the Patent Office is conclusive.<sup>6</sup> The issues must embrace only those applications and patents which conflict with all the others, and the various cross-interferences between these should be consolidated by presenting them in different counts in the same issue.<sup>7</sup> Notices of the interference are then prepared by the examiner for all the parties, disclosing the name and residence of each contestant and those of his attorney, the date of the filing of his application,

§ 594. <sup>1</sup> That there are no formal pleadings in interference proceedings, see *Faure v. Bradley* (1888), 44 O. G. 945.

That it is the duty of the examiner to see that the subject-matter put in issue by the interference is properly defined, see *Dod v. Cobb* (1876), 10 O. G. 826.

That the primary examiner must decide whether Claims interfere, see *Ex parte Saunders* (1883), 23 O. G. 1224.

<sup>2</sup> That in declaring an interference the examiner must look to the language of the application alone, see *Faure v. Bradley* (1888), 44 O. G. 945.

That the issue in an interference must set forth what the parties do claim, not what they might claim, see *Nicholson v. Bennett* (1879), 16 O. G. 631.

<sup>3</sup> That the issue must point out the conflicting Claims and contain a summary of the contested matter, see *Stephen v. Bailey* (1877), 13 O. G. 45.

<sup>4</sup> That hypothetical issues cannot be allowed, see *Farnsworth v. Andrews* (1875), 9 O. G. 195.

<sup>5</sup> That the issue must have the same meaning as to all the parties, see *Nicholson v. Bennett* (1879), 16 O. G. 631; *Drummond v. Greenough* (1879), 16 O. G. 959.

That when the issue is open to several constructions the one which sustains the interference as declared and best agrees with the specifications of the claimants will be adopted, see *Locke v. Levalley* (1881), 20 O. G. 671.

<sup>6</sup> That the construction placed by the Patent Office on the issue is conclusive, see *Locke v. Levalley* (1881), 20 O. G. 671.

<sup>7</sup> That a single interference can embrace only such applications and patents as conflict with all the others, and these may be consolidated into one by presenting them in different counts, see *Bell v. Gray* (1879), 15 O. G. 776.

or if he is a patentee the date and number of his patent and the date of his application therefor, the ordinals of conflicting Claims, and the invention claimed, — clearly and concisely defining them in as many counts as are necessary to exhibit all interfering Claims included in the issue. These notices are transmitted with the files to the examiner of interferences, whose duty it is to ascertain whether the issues are clearly stated and the notices sufficient, and if he finds them defective in any material point to return them with his objections to the examiner for amendment. Upon the refusal of the latter to amend them the matter is referred to the Commissioner. These notices being perfected, the interference is formally declared, and the notices are sent to the parties in interest, accompanied by an order to each to file a preliminary statement of the facts, on which his claim to priority is based, within a time mentioned in the notice. The interference then becomes a contested case, and passes under the exclusive jurisdiction of the examiner of interferences, unless some questions other than those relating to priority arise, and thus compel its temporary return to the consideration of the primary examiner.<sup>8</sup>

§ 595. **Interference Proceedings : Preliminary Statements.**

The preliminary statement ordered in the notices of interference is a concise written recital, under oath, of the date of the contestant's original conception of the invention, of his construction of a drawing or model, of the disclosure of his invention to others, of its reduction to practice, and of the extent of its use.<sup>1</sup> If the invention was made abroad, the statement must declare when and where, if ever, it was patented or described in a printed publication, and when it, or the knowledge of it, was introduced into this country.<sup>2</sup>

<sup>8</sup> That the examiner of interferences has exclusive jurisdiction of the issues when declared, see *Faure v. Bradley* (1888), 44 O. G. 945.

§ 595. <sup>1</sup> That the preliminary statement must declare the character and extent of the use of the invention from the time of its perfection until the ap-

plication was filed, see *Dermody v. Pennock* (1878), 14 O. G. 202.

That the extent of the use of the invention need not be given if it is evident that it was completed within two years before the application, see *Ex parte Wheat* (1878), 14 O. G. 787.

<sup>2</sup> That an applicant for an invention



As the principal object of these statements is to fix the relative times of the inventive acts of the several contestants, the dates given therein are considered as conclusive, and the evidence afterwards offered must confirm, not contradict, them.<sup>3</sup> This statement must also embrace, in general, all the facts which the applicant intends to rely on to support his claim, whether they are to be proved by the records of the Patent Office or by extrinsic testimony.<sup>4</sup> It must be sealed up before filing, and cannot be opened for examination by the opposing parties until all are filed or the time for filing has expired, and until the examiner of interferences has inspected it and found it satisfactory. Either of the contestants may be required by the examiner to correct defects in his statement within a specified period, but neither the original nor the amended statement can be returned to him after it has once been filed. The time for filing or amending the statements may be extended upon motion made before the expiration of the interval first limited for that purpose, and after proper notice to the adverse parties. Claimants refus-

conceived abroad may claim the date of the arrival of the inventor or his agent in the United States as that of his discovery, see *Thomas v. Reese* (1880), 17 O. G. 195.

<sup>3</sup> That the preliminary statement need not fix the exact date of the invention, nor must the proof necessarily correspond with the exact date fixed, see *Connor v. Williams* (1878), 15 O. G. 387.

That "on or about" such a date means that exact date, not an earlier one, see *Bering v. Haworth* (1878), 14 O. G. 117.

That the earliest dates given to the inventive act in the preliminary statement are conclusive on the claimant, as against his future claim for an earlier date, see *Connor v. Williams* (1878), 15 O. G. 386; *Walpuski v. Jacobsen* (1876), 9 O. G. 964.

That a statement fixing dates by belief only may be corrected by evidence, see *White v. Farmer* (1874), 5 O. G. 338.

That a claimant fraudulently misled is not bound by his statement, see *Allen v. Gilman* (1872), 2 O. G. 293.

That if the claimant were insane when he made his statement he may amend or disavow it, see *Ex parte Brooks* (1874), 6 O. G. 296.

That a preliminary statement works no estoppel in the courts, see *Union Paper Bag Mach. Co. v. Crane* (1874), 6 O. G. 801; *Holmes*, 429; 1 *Bann. & A.* 494.

<sup>4</sup> That where the later applicant had filed an application before the earliest of the contesting applicants, his later application must so refer to it as to connect the two, or it will not be noticed, see *Huntley v. Smith* (1880), 18 O. G. 795.

That a disclaimer of the invention in conflict is not a preliminary statement, see *Laverty v. Flagg* (1879), 16 O. G. 1141.

ing to amend their statements when required to do so, will be restricted to their record dates during the further proceedings in the case.

§ 596. **Interference Proceedings: Effect of Failure to File Preliminary Statement.**

The failure of any party to file his preliminary statement within the time prescribed forfeits his right to be further heard, by evidence or argument, in favor of an earlier date for his inventive act than that *prima facie* date fixed by the filing of his application.<sup>1</sup> Hence, if he is the later of two conflicting applicants, judgment goes against him at once upon the record. If he is the later of three or more conflicting applicants, he is no longer recognized as a party to the interference, which proceeds in its regular course as to the others.<sup>2</sup> If his antagonist is a patentee whose patent was granted on an application prior to his own, judgment is rendered forthwith for the patentee.<sup>3</sup> In applications for re-issue, as well as in patents put in interference, the date of the original application on which the first patent issued is the *prima facie* date of the inventive act of the patentee or re-issue applicant; and in the absence of his preliminary statement this date is taken as the true date of his conception of the idea of the invention, and his claim to priority is determined by its relation to the dates fixed by the adverse parties in their applications or by their preliminary statements and the proof that may be afterward adduced in their support. Thus if an applicant, by his preliminary statement, fixes the date of his inventive act at a time previous to the filing of the original application for a conflicting patent, and the patentee

§ 596. <sup>1</sup> That failure to file a preliminary statement leaves the party to the date of his application, see *Booth v. Lyman* (1880), 17 O. G. 393.

That the rule requiring a preliminary statement and prescribing its form and contents, is reasonable and must be obeyed, see *Smith v. Cowles* (1885), 30 O. G. 343.

<sup>2</sup> That if the later of three or more

conflicting applicants fails to file his statement he is no longer a party to the interference, see *Ex parte Evans* (1873), 3 O. G. 180.

<sup>3</sup> That a prior patentee in interference is entitled to a judgment unless the contesting applicant files his statement and offers evidence, see *Loring v. Hall* (1879), 15 O. G. 471.



presents no preliminary statement, the applicant is entitled to a decision in his favor upon showing that he made the invention before the date on which such original application was filed. Or if an applicant for the re-issue of a later patent, based upon a later original application, by his preliminary statement carries the date of his invention beyond the date of the original application for the prior patent, and the prior patentee fails to file his statement as required, the former will be found to be the prior inventor if his inventive act is proved to have preceded the filing of the application for the earlier patent. Where no preliminary statement is filed by any of the parties, priority is awarded to the senior applicant.<sup>4</sup>

**§ 597. Interference Proceedings: Amendment of Preliminary Statement.**

The allegations of a preliminary statement are presumed to be correct, and are conclusive upon the party filing it, unless he has been fraudulently misled.<sup>1</sup> Evidence offered to support them must conform to these allegations in all material points or it will be disregarded.<sup>2</sup> Corrections in the preliminary statement, especially in regard to dates, thus become of vital importance, and if as first filed it contains substantial errors arising from inadvertence or mistake, amendments may be made on motion showing to the satisfaction of the Commissioner that they are essential to the ends of justice.<sup>3</sup>

<sup>1</sup> That the senior applicant will receive the patent in the absence of any preliminary statement from either party, even though the junior applicant's oath discloses that he received a British patent before the senior application was filed, see *Sellon v. Hochhausen* (1885), 33 O. G. 995.

That where no statement is filed, the junior applicant cannot have a patent even though the senior applicant for the present disclaims the invention, if his application covers it, see *Sellon v. Hochhausen* (1885), 33 O. G. 995.

§ 597. <sup>1</sup> That a preliminary statement procured by fraud is not binding,

see *Allen v. Gilman* (1872), 2 O. G. 293.

That insanity of the maker avoids a preliminary statement, see *Ex parte Brooks* (1874), 6 O. G. 296.

<sup>2</sup> That the claimant cannot introduce evidence contradicting his statement, see *Connor v. Williams* (1878), 15 O. G. 387.

<sup>3</sup> That a preliminary statement may be amended by permission of the Commissioner in proper cases, see *Clemson v. Fowler* (1886), 37 O. G. 671; *Moore v. Brown* (1882), 22 O. G. 1882.

That an error in a preliminary statement in reference to a date may be

Clerical errors may be corrected at any time, but a motion to amend in material particulars must be made, if possible, before the taking of any testimony and as soon as practicable after the discovery of the error.<sup>4</sup> Upon this motion all parties are entitled to be heard, and reasonable notice of its pendency must be served upon them. No amendment can

amended on satisfactory proof that it was made in good faith and that the applicant was misled or acted without negligence, see *Clemson v. Fowler* (1886), 37 O. G. 671; *Robinson v. Seymour* (1885), 33 O. G. 113.

That an earlier date, if inconsistent with the proof, cannot be inserted by amendment, see *Cutting v. Kaylor* (1872), 2 O. G. 704.

That an amendment of the statement will not be allowed if the error arose through negligence, see *Clemson v. Fowler* (1886), 37 O. G. 671; *Smith v. Cowles* (1885), 30 O. G. 343.

That if a defect in a preliminary statement occurs through failure to obey orders, or neglect in finding out what the applicant ought to know, no amendment will be allowed, see *Smith v. Cowles* (1885), 30 O. G. 343.

That a party who protests against the adverse statement and obtains its amendment, and after the evidence in chief is taken moves to amend his own statement in order to carry his dates back of those of the adversary, cannot be allowed to do so, being guilty of laches, see *Donnelan v. Berry* (1887), 41 O. G. 1499.

That a party filing a preliminary statement, which he knows to be defective, cannot amend it after he has become familiar with his adversary's case, see *Donnelan v. Berry* (1887), 41 O. G. 1499.

That a preliminary statement may be amended before evidence is taken if the amendment is made as soon as possible after the error is discovered, see *Smith v. Cowles* (1885), 30 O. G. 343.

<sup>4</sup> In *Hopkins v. Le Roy* (1880), 18 O. G. 859; *Marble, Com.* (859): "When a party makes and files his preliminary statement it is to be presumed that he has fully canvassed all the facts in his case, and that the statement as filed, as far as is necessary, is a correct statement of such facts. Unless the party having made such statement asks to amend the same before any testimony is taken in the case, all parties have a right to proceed on the issue as made in the respective statements. It may be that a statement made contains an erroneous date as is claimed in this case; if so, the party making the statement should correct that date before his opponent has been put to the expense of taking testimony to sustain his own case. A party has no right to wait until his opponent has fully developed all the facts in his case and then for the first time make known the error that he has committed in his preliminary statement. Proper diligence on his part would have placed him in possession of the facts upon which he could have corrected his statement before such testimony was taken. If through carelessness or negligence he has failed to have such correction made, other parties should not be injured by such negligence."

That clerical errors may be corrected at any time, if no injustice will result, see *Allen v. Gilman* (1872), 2 O. G. 293.

That a preliminary statement ought not to be amended after the evidence is taken or published, see *Hopkins v. Le Roy* (1880), 18 O. G. 859; *Oliver v. Zeller* (1876), 10 O. G. 416.



be permitted after the reception of evidence on the ground of ignorance of law or of the neglect of an attorney, and when permitted on any ground, at this stage of the proceedings, ample time is allowed to the adverse parties to contradict the amended allegations by additional proof.<sup>5</sup> No defective preliminary statement ought to be received by the examiner; but if received, and not objected to by the other contestants, the right to insist on its exclusion will be waived.<sup>6</sup>

§ 598. **Interference Proceedings: Examination of Preliminary Statements.**

When the time for filing the preliminary statements has elapsed, such as have been filed are subjected to examination and are compared with the original applications on which the claims of the contestants rest. If it appears from this examination that the date of the filing of the earliest application is not anticipated by the dates fixed by the other parties for their own conception of the invention, priority is awarded to the earliest applicant.<sup>1</sup> Where the preliminary statement of a later applicant fails to carry the date of his inventive act behind the date when earlier applications were filed, judgment is entered against him.<sup>2</sup> Only in cases where the date claimed for his inventive act in the preliminary statement of one party anticipates the filing of an earlier application by some other party does the interference proceed further, since in these cases alone is the *prima facie* presumption of priority arising from the dates of filing the respective appli-

<sup>5</sup> That ignorance of the rules of the Patent Office or the carelessness of an attorney are no reasons for allowing an amendment after the evidence is in, see *Guest v. Finch* (1876), 10 O. G. 165.

That when the statement is amended after evidence taken the adverse party may be allowed, on motion, to take further evidence, see *Moore v. Brown* (1882), 22 O. G. 1882.

<sup>6</sup> That a defective statement ought not to be received, but if it is the defect is waived unless objected to, see *White v. Farmer* (1874), 5 O. G. 338.

§ 598. <sup>1</sup> That where an examination of the statements shows that no one is earlier than the first applicant judgment will be rendered in his favor on notice to the other parties; otherwise a hearing will be held, see *Booth v. Lyman* (1880), 17 O. G. 393.

<sup>2</sup> That unless the statement of a later applicant carries his date of conception beyond the date when the first application was filed, judgment will go against him, see *Huntley v. Smith* (1880), 18 O. G. 795.

cations rebutted, and additional evidence rendered necessary in order to determine between the antagonistic claimants.

**§ 599. Interference Proceedings : Taking Testimony.**

If the interference proceeds, the time is then fixed by the examiner for the taking of the testimony by the several parties.<sup>1</sup> A period is limited within which the latest applicant must complete his evidence in chief, followed by a period for the adverse party to finish his testimony in reply, and this by a third period for the rebutting evidence of the later applicant. Where there are more than two contestants their periods for taking testimony are so arranged that each shall have an opportunity to prove his own case against prior applicants, and to rebut their evidence when offered in reply, and also to answer that of later applicants. The time for taking evidence may be extended in favor of either party upon a motion disclosing under oath the reasons for his inability to obtain his evidence within the period prescribed, the names of the witnesses whose testimony he desires, the facts which he expects to prove by them, and the efforts he has made already to secure their earlier attendance.<sup>2</sup> A failure to complete his testimony within the period assigned to any party is not permitted to delay the final hearing. The hearing may be postponed for sufficient reasons by the examiner in charge, but unless thus postponed a later applicant, whose evidence has been completed within the time prescribed, may insist upon a hearing and judgment, after that time has elapsed, upon the evidence as it then appears.

**§ 600. Interference Proceedings : Burden of Proof : Evidence Admissible.**

The general rules of evidence apply in interference cases to the same extent and in the same manner as on similar issues

§ 599. <sup>1</sup> That in an interference with a patent the time for taking evidence will not be made coincident with the later dates fixed in another interference with the same patent, unless there is some reason for it other than

that the facts are the same, see *Keith v. Faure* (1883), 25 O. G. 289.

<sup>2</sup> That the courts are liberal in extending the time for taking testimony if the party has been diligent, see *Osgood v. Badger* (1888), 44 O. G. 1065.



in the courts.<sup>1</sup> Priority of inventive act consists in the prior conception of the idea of means and the prior embodiment of this idea in some practically operative art or instrument, or reasonable diligence in perfecting such embodiment; and the successful claimant must establish this priority by a clear preponderance of evidence, though not necessarily beyond reasonable doubt.<sup>2</sup> In order to do this he must not only overcome the presumptions against him arising out of earlier applications and patents on behalf of other parties, but must affirmatively establish his right to priority as against such parties themselves, by proofs sufficient to defeat their patents in the courts.<sup>3</sup> Thus he must show that his conception of the in-

§ 600. <sup>1</sup> That the same rules of evidence apply in interference cases as in the courts, see *Millward v. Barnes* (1877), 11 O. G. 1060; *Palm v. Behel* (1876), 10 O. G. 701; *Berry v. Stockwell* (1876), 9 O. G. 404.

That the examiner of interferences has the exclusive right to decide as to the competency, construction, scope, and legal meaning of all foreign patents or other evidence, and to determine whether they cover the same invention as the one in interference, see *Faure v. Bradley* (1888), 44 O. G. 945.

<sup>2</sup> That on an interference the party having the burden of proof must show that he first completed the invention, see *McKnight v. Wagenen* (1876), 9 O. G. 1161.

That a claimant against a patent has the burden of proof, see *Donoughe v. Hubbard* (1886), 27 Fed. Rep. 742; 35 O. G. 1561; *Cushman v. Parham* (1876), 9 O. G. 1108.

That where the *prima facie* proof arising from the patent is outbalanced by evidence of prior invention, the burden of proof shifts to the patentee, see *Hazelip v. Richardson* (1876), 10 O. G. 747.

That on interference the averment that an applicant is not an original inventor must be conclusively proved by

the party who alleges it, see *Hockhausen v. Weston* (1880), 18 O. G. 857.

That an applicant in interference with a patent need not prove priority beyond reasonable doubt, see *Fulgham v. Westcott* (1879), 16 O. G. 1005.

That the assertion of an applicant that he "invented" at a certain date is of little weight against facts showing the contrary, see *Slade v. Blair* (1880), 17 O. G. 261.

That where one of two joint patentees applies for a sole patent he must overcome by evidence the presumption arising from his oath as joint-inventor, as well as the *prima facie* case presented by the prior patent, or judgment on the interference will be against him, see *Lovrien v. Banister* (1880), 18 O. G. 299.

<sup>3</sup> That in an interference between an application and a patent, the applicant must offer such evidence of priority as would defeat the patent in the courts, see *Gill v. Scott* (1883), 23 O. G. 2511; *Withington v. Locke* (1877), 11 O. G. 417; *Palm v. Behel* (1876), 10 O. G. 701; *Stoddard v. Perry* (1874), 6 O. G. 33.

That if a junior inventor, using due diligence in reduction and application, obtains a patent and a senior inventor afterward applies, the latter must show entire freedom from laches or a patent

vention antedated that of every other claimant, and that at the date of their conceptions he had either reduced, or was using reasonable diligence in reducing, his own conception to successful practice.<sup>4</sup> In proving his conception of the invention the claimant may present any evidence which tends to show that the idea of means was fully developed in his own mind at the date alleged. Verbal descriptions, drawings or sketches, models, other devices equivalent in principle or embracing all the features on which conflict now arises, and any other manifestation or embodiment of his idea sufficient for its complete expression may be offered to support his claim.<sup>5</sup>

will be denied him and all doubts resolved in favor of the patentee, see *Voelker v. Gray* (1885), 30 O. G. 1091.

That the first applicant is regarded as the first inventor till the contrary appears, see *Starr v. Farmer* (1883), 23 O. G. 2325, 2327.

That where an application is complete and duly filed the subsequent applicant must show that he invented, or conceived the idea and was diligently reducing to practice, before the prior application was filed, see *Starr v. Farmer* (1883), 23 O. G. 2325, 2327.

That if one of the applications in interference is a division of one previously filed, the date of the original will be regarded in determining on whom is the burden of proof, see *Henderson v. Reese* (1883), 25 O. G. 191.

<sup>4</sup> That the successful claimant must show that he was the first to conceive and used reasonable diligence in reducing to practice, see *Hammond v. Laird* (1874), 7 O. G. 170.

That where two persons separately make the same invention the question is which is the first inventor, see *Hall v. Johnson* (1883), 23 O. G. 2411.

That where each one of two persons who united in reducing the invention to practice claims to be the inventor, the question is which conceived it, see *Hall v. Johnson* (1883), 23 O. G. 2411.

See also § 370-391 and notes, *ante*.

<sup>5</sup> That on an interference the *prima facie* date of a patented invention is the date of filing the application on which the patent issues, though other records of the Patent Office may be consulted, see *Booth v. Lyman* (1880), 18 O. G. 132.

That the uncontradicted oath of the applicant that he made drawings of the invention at a certain time, if supported by one other credible witness, is sufficient though the drawings have been destroyed, see *Smith v. Edson* (1875), 7 O. G. 827.

That the production of sketches prepared for the occasion profits little except as illustrating other evidence, see *McCullough v. Watkins* (1875), 8 O. G. 1074.

That mere descriptions and destroyed drawings are not of much weight to show priority, see *Ware v. Bullock* (1874), 7 O. G. 39.

That a machine embracing all the features over which the interference contest has arisen may serve to show the date of the invention, though it lacks certain improvements found in pending applications, see *Hockhausen v. Weston* (1880), 18 O. G. 857.

That devices produced by the applicant which are equivalent in principle may fix the date of the invention, see *Bird v. Walsh* (1878), 14 O. G. 234.

That an abandoned application is not



In proving reduction to practice he must establish the existence of an operative art or instrument, capable of practical employment.<sup>6</sup> Upon this point models, drawings, and descriptions have but little weight. Diligence in reducing to practice may be shown by any testimony applicable to the peculiar circumstances of the case. No claimant is allowed by evidence to carry the date of his conception of the invention behind the date assigned to it in the preliminary statement; and any substantial variation between such statement and the evidence on any point renders the evidence suspicious.<sup>7</sup> Where the statement fixes its dates by belief and information the testimony may render them more certain

considered in fixing the burden of proof, see *Henderson v. Reese* (1883), 25 O. G. 191.

That an abandoned experiment cannot be revived so as to secure priority on an interference, see *Sheridan v. Latus* (1883), 25 O. G. 501.

See also §§ 380, 381 and notes, *ante*.

<sup>6</sup> In *Stover v. Clark* (1877), 12 O. G. 188, Spear, Com.: (188) "The question in controversy is one capable of easy solution if the bearing of the Office in relation to interference proceedings, in which one of the parties is a patentee, is kept clearly in mind. In this class of cases the adverse applicant must show conclusively that prior to the time of the invention by the patentee he (the applicant) had fully reduced it to a form or condition capable of standing the test of actual practical use. An experimental reduction, the illustration of a theory by a model, will not suffice of itself to establish that completion which is alone regarded by the law as sufficient to impeach the title of the patentee. As was said in *Coffin v. Ogden*, 18 Wall. 124, 'If the thing were embryotic or inchoate; if it rested in speculation or experiment; if the process pursued for its development had failed to reach the point of consummation, — it cannot avail to defeat a patent founded upon a discovery or invention which

was completed, while in the other case there was only progress, however near that progress may have approximated to the end in view."

See also *Gardner v. Dudley* (1880), 17 O. G. 801; *Halladie v. Paino* (1877), 12 O. G. 1077; *Sargent v. Burge* (1877), 11 O. G. 1055.

That a patent is *prima facie* proof that the patentee had completed his invention, though its practical use is not shown, see *Busby v. Phelps* (1876), 9 O. G. 1010.

That the assertion of a party that he conceived the invention at a certain time amounts to very little unless he then completed it, see *McCullough v. Watkins* (1875), 8 O. G. 1074.

<sup>7</sup> That the evidence must conform to the statement or it will be rejected, see *Hovey v. Hufeland* (1872), 2 O. G. 493.

That any substantial variance between the statement and the evidence renders the evidence suspicious, see *McCullough v. Watkins* (1875), 8 O. G. 1074.

That the evidence as to the date of the invention need not agree with the statement, but must not show it to be earlier than the one therein alleged, see *Connor v. Williams* (1878), 15 O. G. 386; *Walpuski v. Jacobsen* (1876), 9 O. G. 964.

and correct.<sup>8</sup> A foreign patentee cannot prove an earlier date for his invention than the date of his foreign patent, and a foreign inventor who has not patented his invention abroad cannot anticipate by his evidence the date on which the knowledge of his invention was first brought to the United States, either by himself or by his confidential agent.<sup>9</sup> A preliminary statement is not admissible in evidence in favor of the party making it, although it may be used against him as rebutting or limiting the other evidence which he presents.<sup>10</sup>

### § 601. Interference Proceedings: Rules of Evidence.

The statute authorizes the Commissioner to make rules for taking testimony in cases pending in the Patent Office, and provides for the issue of *subpœnas* from the Federal courts in the districts where the witnesses reside, and for compelling the attendance of those witnesses who disregard the ordinary

<sup>8</sup> That a statement fixing dates by belief only may be corrected by the evidence, see *White v. Farmer* (1874), 5 O. G. 338.

<sup>9</sup> That an applicant for an invention conceived abroad may carry the date of his invention back to the arrival of the inventor or his agent in the United States, see *Thomas v. Reese* (1880), 17 O. G. 195.

That a foreign inventor cannot carry the date of his invention back by showing acts done in a foreign country, see *Boulton v. Illingworth* (1888), 43 O. G. 508.

That whether a foreign patentee can carry his date back to that of his foreign patent is doubtful, see *Thomas v. Reese* (1880), 17 O. G. 195.

That a foreign patentee cannot go behind the date of his patent to show the time of his invention, see *Rumpff v. Köhler* (1882), 23 O. G. 1831, 1832; *Chambers v. Duncan* (1876), 10 O. G. 787.

That evidence that one applicant published his invention abroad before the other made it here defeats the ap-

plication of the other, and also possibly his own, see *Thomas v. Reese* (1880), 17 O. G. 195.

That Sec. 4887, limiting the term of the domestic by that of a foreign patent, cannot be invoked to carry the date of invention back to the date of a previously issued British patent, where the two patents are not alike, see *Gandy v. Main Belting Co.* (1886), 37 O. G. 1357.

For a discussion of the value of an English specification as evidence, see *Lauder v. Crowell* (1879), 16 O. G. 405.

On the whole matter of priority in reference to foreign inventors and patentees, see § 382 and notes, *ante*.

<sup>10</sup> That a preliminary statement is not affirmative evidence in favor of the party making it, see *Lauder v. Crowell* (1879), 16 O. G. 405.

That the original statement and the fact of its amendment will be considered on the merits as affecting the evidence concerning the actual date, see *Robinson v. Seymour* (1885), 33 O. G. 113.



summons.<sup>1</sup> In the exercise of the authority thus conferred upon him the Commissioner has established certain regulations, prescribing that all evidence offered in contested cases must be presented in depositions, taken upon due notice to the adverse parties in the form of interrogatories and replies, and sealed up, addressed, and forwarded to the Commissioner by the officer before whom they were given.<sup>2</sup> Where witnesses reside abroad, such depositions may be taken before an American consul, or other proper officer, by order of the Commissioner, based upon the motion of the claimant and his sworn averment that the motion is not made for purposes of delay or vexation to the adverse party and that the evidence cannot be otherwise conveniently obtained.<sup>3</sup> After these depositions are returned to the Commissioner and duly opened, they are subject to inspection by the parties, but cannot be withdrawn. Unless for satisfactory reasons to the contrary they must be printed by some person appointed by the Office for that purpose, and copies must be furnished to the Office and to each of the contestants. Caveats and other official records, and any special matter contained in printed publications, may be filed and used as evidence upon due notice to the adverse parties, when competent and pertinent to the issue. No evidence touching the matters in dispute can be considered at

§ 601. <sup>1</sup> That the rules of evidence in interference proceedings are those of the law in force in the District of Columbia, see *Marsh v. Rein* (1888), 43 O. G. 1453; *Koen v. Quint* (1883), 23 O. G. 1329.

That witnesses are under the control of the courts, not of the Commissioner, see *Osgood v. Badger* (1888), 44 O. G. 1065.

That husband and wife are not competent witnesses for or against each other in interference proceedings, see *Marsh v. Rein* (1888), 43 O. G. 1453; *contra*, *Koen v. Quint* (1883), 23 O. G. 1329.

That where one party to an interference attacks the patentability of the invention he must offer all his evidence

on this point as well as that of priority before his opponent can be obliged to put in his proof, see *Clark v. La Dow* (1888), 43 O. G. 248.

<sup>2</sup> That a notice to take testimony after so short an interval that the party must travel night and day to get there is not reasonable notice, see *Hoag v. Abbott* (1879), 15 O. G. 471.

That a failure to appear to take a deposition after reasonable notice is a waiver of all technical irregularities, see *Hoosier Drill Co. v. Ingels* (1879), 15 O. G. 1013.

<sup>3</sup> That the Commissioner may order depositions to be taken abroad before consuls, see *Lauder v. Crowell* (1879), 16 O. G. 405.

the hearing unless obtained in accordance with these rules. But merely technical objections, not working any substantial injury to the party raising them, will not be regarded, and where such injury is inflicted the injured party must make his objection as soon as he becomes aware of its existence, and notify the Office and the adverse party that unless the objection is removed it will be urged against him at the hearing.<sup>4</sup>

### § 602. Interference Proceedings: Arguments of Contestants.

The rules advise that arguments and briefs in all contested cases should also be printed and filed before the hearing, and parties neglecting to avail themselves of this advantage in due season have no right to an extension of time for that purpose. Upon the day named for the hearing, any party appearing will be heard, but no case will be taken up for oral argument after the day appointed, except by the consent of all parties. After the arguments have been completed, no further hearing will be accorded to either party unless at the request of the tribunal having jurisdiction of the case.

### § 603. Interference Proceedings: Judgment of Priority.

An interference having been once declared, it cannot be determined without a formal dissolution, or a judgment on the issue of priority.<sup>1</sup> This judgment may be rendered either

\* That objections to the evidence must be urged at the hearing, under the rules, see *Hoag v. Abbott* (1879), 15 O. G. 471.

That a deposition improperly taken may be objected to at the interference hearing, though ordinary objections which may be cured by a new commission to take testimony, or formal objections merely, should be taken by motion to suppress, see *Milligan v. Niedringhaus* (1886), 38 O. G. 103.

That it is always better to move to suppress in advance of the hearing, see *Milligan v. Niedringhaus* (1886), 38 O. G. 103.

That a motion to suppress will be

denied, except in extreme cases, if the party moving has neglected to take proper steps for his protection, see *Osgood v. Badger* (1888), 44 O. G. 1065.

That a motion to suppress must be made without unreasonable delay, see *Milligan v. Niedringhaus* (1886), 38 O. G. 103.

That if a witness in an interference refuses to answer a proper question on cross-examination his entire testimony will be excluded, see *Milligan v. Niedringhaus* (1886), 38 O. G. 103.

§ 603. <sup>1</sup> That where an interference exists the proceedings cannot terminate without a judgment on account of the



upon the testimony, or upon the written concession of the adverse parties, signed by the parties themselves and not merely by their attorneys, or upon the written declaration of either of the parties that he has abandoned his application.<sup>2</sup> Such written concession must be consistent with the facts, — no false or fraudulent admission of priority authorizing a judgment contrary to the truth.<sup>3</sup> In rendering a judgment on the testimony the examiner of interferences must follow the same rules concerning the performance and completeness of the inventive act which are recognized as binding in the courts. The several parties are presumed to have made the invention in the chronological order in which they filed their original applications, and the burden of proof rests on those who endeavor to establish any different order of invention.<sup>4</sup> Where all the parties are American inventors judgment must be awarded to the claimant who establishes the real priority of his inventive act. Where one of the parties is a foreign inventor and the others are American, the latter is entitled to priority unless the invention of the former was known or used in the United States, or patented or published, before the conception of the invention by the latter. If one of two foreign inventors has obtained a for-

abandonment of his application by one party, if the other party claims it, see *Adler v. Van Wagener* (1875), 8 O. G. 728.

That a judgment must be rendered except in cases where the rules otherwise provide, see *Hicks v. Keating* (1887), 40 O. G. 343.

<sup>2</sup> That an agreement conceding priority is not good unless signed by the adverse party himself, the attorney having no authority to sign it, see *Tucker v. Kahler* (1879), 15 O. G. 966.

That a concession of priority is not available except between the parties and in reference to pending proceedings, see *Hammond v. Pratt* (1879), 16 O. G. 1235.

<sup>3</sup> That a concession of priority contrary to the truth is void, see *Hammond v. Pratt* (1879), 16 O. G. 1235; *Packard*

*v. Sandford* (1879), 16 O. G. 1182; *Allen v. Gilman* (1872), 2 O. G. 293.

See also § 363 and notes, *ante*.

<sup>4</sup> That unless a contrary right appears priority will be awarded to the party who first filed a complete application, including petition, specification, drawings, model, and fee, see *Lapham v. Bettendorf* (1879), 16 O. G. 137.

That priority cannot be awarded to the earliest applicant, who has merely conceived the idea and filed an application, against one who, before the filing of such application, had reduced the idea to practice, see *Gardner v. Dudley* (1880), 17 O. G. 801.

That priority will be awarded to the first perfecter of the invention though the other party were the first to practically use it, see *Martin v. Bogle* (1877), 12 O. G. 625.

foreign patent, he must prevail over his adversary, although the other was in fact the first inventor; if both have obtained foreign patents the earliest patentee has the superior right; if neither has a foreign patent the earliest introducer into the United States prevails.<sup>5</sup> Where the decision in favor of one applicant against another is not appealed from, or is sustained upon appeal, it is equivalent to a rejection of the defeated applications, and a patent is awarded to the victorious applicant alone.<sup>6</sup> But when an applicant establishes his own priority against a patent, the patent cannot be affected by the judgment, and the sole result is the issue of another patent to the applicant. Where neither party proves priority judgment is rendered against both, in order that both may be enabled to appeal.<sup>7</sup> The wrongful issue of a patent to one applicant, pending an interference, does not warrant the issue of another to his rival where the priority of the latter is not proved.<sup>8</sup>

<sup>5</sup> That an invention made in the United States has priority over a foreign invention unless the foreign invention were used in the United States, or were published or patented, before the domestic invention was made, see *Lauder v. Crowell* (1879), 16 O. G. 405.

That as between two foreign inventions the first applicant in the United States has priority, if he is an original inventor, see *Lauder v. Crowell* (1879), 16 O. G. 405.

That as between two foreign inventors who are applicants in the United States, if one of them has a foreign patent he is entitled to priority, though the other was the first inventor, see *Lauder v. Crowell* (1879), 16 O. G. 405.

That when two foreign applicants are both foreign patentees, the earliest patentee is entitled to priority, see *Lauder v. Crowell* (1879), 16 O. G. 405.

That a foreign patentee stands like any other applicant until a contest begins, and must then prove his priority, see *Lauder v. Crowell* (1879), 16 O. G. 405.

<sup>6</sup> That the applicant for a specific invention, having been defeated in an interference with the applicant for the generic invention, cannot have a patent for the species subject to that for the genus unless he disclaims the genus or takes some other further action, see *Ex parte Gardner* (1880), 17 O. G. 626.

<sup>7</sup> That if neither party seems to be the original and first inventor judgment should run against both, see *Wood v. Eames* (1880), 17 O. G. 512.

<sup>8</sup> In *Ex parte Frick* (1872), 1 O. G. 574, Leggett, Com.: (574) "It is claimed by the applicant in this case that during the pendency of his application a patent has been issued to other parties for substantially the same thing, and he now asks that a patent be allowed him without being called upon to prove priority of invention in an interference with the existing patent. If it be true (which I now neither admit nor deny) that a patent has issued during the pending of this application with which this application at the time interfered, then the Office has committed



§ 604. **Interference Proceedings: Appeal from Judgment of Priority.**

Unless appealed from, the decision of the examiner of interferences is conclusive upon all the parties to the interference.<sup>1</sup> Such an appeal will lie only on some question involved in the issue of priority, and is taken in the first instance to the examiners-in-chief and from their adverse judgment to the Commissioner in person.<sup>2</sup> An appeal in

a grave error; but this error would not be corrected by granting the motion now made by the applicant. Two wrongs would not make one right. If the Office has committed a blunder by illegally issuing one patent, it cannot now correct that blunder by illegally issuing another. The action now must have reference to the present condition of the two cases. The existing patent, though prematurely issued, is beyond the control of the Office, and cannot be recalled. Another patent cannot be legally issued for the same invention, except upon interference trial it be shown that the applicant is the prior inventor. The motion of the applicant must, therefore, be refused."

§ 604. <sup>1</sup> That an interference must first be heard before the examiner of interferences, see *Farnsworth v. Andrews* (1875), 9 O. G. 195.

That the decision of the examiner of interferences is conclusive unless appealed from, see *Whitely v. McCormick* (1876), 10 O. G. 826; *Jenkins v. Barney* (1873), 3 O. G. 119.

<sup>2</sup> That the relation of the examiner of interferences and of the examiners-in-chief to the Commissioner is the same as that of one court to another, see *Berry v. Stockwell* (1876), 9 O. G. 404.

That the jurisdiction of an examiner terminates upon an appeal, see *Ex parte Brunner* (1872), 1 O. G. 303.

That no appeal lies from the refusal of an examiner to dissolve the inter-

ference on the ground that the adverse applicant had no right to make the Claims, no party having any other rights against his adversary than the whole public has, and it being presumed that the Patent Office will protect these, see *Faure v. Bradley* (1887), 40 O. G. 243.

That in an interference case a notice to the defeated party of the adverse decision, limiting the time for appeal to ten days, means ten days from the receipt of the notice, and is, therefore, uncertain, see *Pearson v. Lister* (1883), 24 O. G. 1175.

That on an appeal to the Commissioner in an interference the applicant is entitled to have his case considered on the law and the evidence, see *Sellers v. Walter* (1886), 37 O. G. 1001.

That if, pending an appeal to the Commissioner in an interference, he is notified that the applications should be rejected on the ground of public use, he should refer that question to the examiner, see *Finch v. Bailey* (1883), 25 O. G. 191.

That where the Commissioner is ordered by mandamus to hear an interference in person the patent cannot issue until the mandamus has been obeyed, see *Withington v. Locke* (1878), 15 O. G. 426.

That on an appeal the concurrent opinions of the examiner of interferences and the examiners-in-chief on a question of fact are of great weight, see *Berry v. Stockwell* (1876), 9 O. G. 404.

an interference case must be accompanied by a brief statement of the reasons therefor, and is governed by the same general rules that are applied to appeals in *ex parte* cases. From the decision of the Commissioner there is no appeal, and patents issue to successful applicants without further opposition on the part of rival claimants.<sup>3</sup> But a defeated claimant still has a remedy for the assertion of his own rights by a bill in equity upon which all adverse parties, whether applicants or claimants, may be heard; and if he then obtains a judgment another patent will be issued in his favor.<sup>4</sup>

§ 605. **Interference Proceedings: Dissolution of the Interference.**

If it becomes apparent during the course of an interference that its further prosecution would be useless, a motion to dissolve it may be made before the examiner of interferences, by whom the motion, with the files and papers, must be transmitted to the primary examiner for his decision on the points involved.<sup>1</sup> This motion may be offered whenever the testi-

<sup>3</sup> That no appeal will lie to the Supreme Court of the District of Columbia from a decision of the Commissioner in an interference case, the only remedy being by bill in equity under Sec. 4915, see *Kirk v. Commissioner* (1886), 37 O. G. 451; 5 *Mackay*, 229; *Butler v. Shaw* (1884), 21 *Fed. Rep.* 321.

That the Secretary of the Interior has no power to revise the decision of the Commissioner on the subject of priority, see *Butterworth v. Hoe* (1884), 112 U. S. 50; 29 O. G. 615; *United States v. Butterworth* (1884), 3 *Mackay*, 229; 27 O. G. 519.

<sup>4</sup> That a decision in interference is not final except in the Patent Office, and a bill in equity to annul the adverse patent will lie in favor of the defeated party, see *Union Paper Bag Mach. Co. v. Crane* (1874), 1 *Bann. & A.* 494; *Holmes*, 429; 6 O. G. 801.

That the remedy in equity provided by Sec. 4915 applies to decisions in interference cases as well as all other

decisions on the merits of an application, see *Butterworth v. Hoe* (1884), 112 U. S. 50; 29 O. G. 615.

That the successful applicant cannot be enjoined from accepting his patent on the ground that the Commissioner was mistaken as to priority, see *Whipple v. Miner* (1883), 23 O. G. 2236; 15 *Fed. Rep.* 117.

That the power of the Circuit Court to grant a patent is independent of the Patent Office, but the defeated party cannot decide when the court shall act by injunction, see *Whipple v. Miner* (1883), 23 O. G. 2236; 15 *Fed. Rep.* 117.

That the filing of a bill in equity to obtain a patent by the defeated party to an interference does not stay proceedings in the Patent Office nor justify the Commissioner in withholding a patent from the successful party, see *Wells v. Boyle* (1888), 43 O. G. 753.

§ 605. <sup>1</sup> That an examiner of interferences cannot dissolve an interference



mony introduced or the arguments urged or the concession of either of the parties renders it evident that the interference cannot lawfully proceed.<sup>2</sup> The grounds on which it may be based are the non-patentability of the invention,<sup>3</sup> the absence

on *ex parte* affidavits alleging non-patentability, etc., though he may suspend and remand to the primary examiner, see *Hedges v. Daniels* (1880), 17 O. G. 152.

That if a motion to dissolve an interference is based on want of patentability, etc., it must be sent to the primary examiner, see *Green v. Hall* (1886), 37 O. G. 1475.

That when an interference is remanded to the primary examiner for want of patentability, etc., the interference is dissolved *pro hac vice*, the applications become *ex parte*, the original jurisdiction of the examiner attaches, and the right of appeal exists as in other *ex parte* cases, see *Faure v. Bradley* (1887), 40 O. G. 243.

<sup>2</sup> That a motion to dissolve may be made at any time, see *Banks v. Snediker* (1879), 16 O. G. 1096.

That if a motion to dissolve the interference is not filed within twenty days after the statement is approved the delay must be explained, or the examiner of interferences will not send the case to the primary examiner, though from his refusal to do so appeal lies to the Commissioner, see *Green v. Hall* (1886), 37 O. G. 1475.

That a motion to dissolve an interference must state the reasons, and recite the grounds, and show all the facts on which the motion is based, see *Green v. Hall* (1886), 37 O. G. 1475.

That adverse parties must be served with a notice of a motion to dissolve an interference and with the reasons therefor, and have an opportunity to be heard, see *Green v. Hall* (1886), 37 O. G. 1475.

That an irregular motion to dissolve an interference will be dismissed on mo-

tion of the adverse party, see *Green v. Hall* (1886), 37 O. G. 1475.

That if the later applicant disclaims the invention the interference will be dissolved, see *Laverty v. Flagg* (1879), 16 O. G. 1141.

<sup>3</sup> That a motion to dissolve an interference must be based on the application alone, not on the preliminary statement or other outside matter, see *Faure v. Bradley* (1888), 44 O. G. 945.

That an interference may be dissolved on the ground that the invention is not patentable, see *Stone v. Greaves* (1880), 17 O. G. 397; *Hockhausen v. Weston* (1880), 18 O. G. 857.

That on proof of facts showing a bar to the patent, as distinguished from a mere want of title, the interference may be dissolved, see *Hicks v. Keating* (1887), 40 O. G. 343.

That want of novelty is a ground for dissolution, see *Ex parte Knox* (1879), 16 O. G. 1048.

That if only one of the inventions is useful and operative a dissolution will be ordered, see *Fuller v. Brush* (1879), 16 O. G. 1188.

That where abandonment by public use is suspected the examiner of interferences may be ordered to investigate it, or the case may be remanded to the primary examiner, from whom an appeal lies, see *Ex parte Finch* (1887), 40 O. G. 1027.

That a motion to dissolve on the ground of non-patentability should be made at the outset, see *Blinn v. Gale* (1879), 16 O. G. 459.

For the practice in cases where a statutory bar appears, see *Hicks v. Keating* (1887), 40 O. G. 343.

of any real conflict between the Claims of the several contestants,<sup>4</sup> the failure of either party to show that he is a true inventor of the invention claimed,<sup>5</sup> or such irregularity in the institution of the interference as must render any judgment therein void.<sup>6</sup> From the decision of the primary examiner upon this motion an appeal lies in the usual manner to the examiners-in-chief;<sup>7</sup> but if no appeal is taken within the

<sup>4</sup> That unless both devices are embraced in the interference it should be dissolved, see *Smith v. Winchell* (1878), 18 O. G. 1127.

That if both parties do not claim the same subject-matter the interference will be dissolved, see *Sawyer v. Edison* (1883), 25 O. G. 597; *Dod v. Cobb* (1876), 10 O. G. 826.

That where two machines in interference are different, and only one is operative, the difference will be treated as essential, see *Bradford v. Imlay* (1879), 16 O. G. 314.

<sup>5</sup> That if the contestants appear to be joint inventors dissolution will be ordered, see *Taylor v. Martin* (1879), 16 O. G. 138.

That if a motion to dissolve is made on the ground that the adverse party is not an original inventor, the allegation must be conclusively proved, see *Hockhausen v. Weston* (1880), 18 O. G. 857.

That if it appears that the patentees in a joint conflicting patent were not joint inventors, the interference will be dissolved, see *Walton v. Dennis* (1879), 16 O. G. 959.

<sup>6</sup> That a motion to dissolve on account of non-interference or irregularity in the proceedings will be heard by the tribunal before which the case is pending, see *Barney v. Kellogg* (1880), 17 O. G. 1096.

That no motion to dissolve an interference should be sent to the primary examiner unless it alleges either that there is no interference in fact, or that the interference has been so irregularly declared that no judgment can be ren-

dered, or that the invention is not patentable, or that the applicant has no right to claim it, see *Edison v. Phelps* (1887), 38 O. G. 539.

That on hearing a motion to dissolve an interference nothing will be considered but what appears on the face of the motion, and the papers filed, see *Green v. Hall* (1886), 37 O. G. 1475.

That on a motion to dissolve an interference counter affidavits may be filed at the time named for the hearing and without notice, and if the adverse party be taken by surprise, a continuance may be granted, see *Green v. Hall* (1886), 37 O. G. 1475.

That on a motion to dissolve an interference affidavits of the adverse party, filed without leave, will not be noticed, see *Green v. Hall* (1886), 37 O. G. 1475.

<sup>7</sup> That where a primary examiner overrules a motion to dissolve, and affirms his previous finding of patentability, the mover may make protest to the Commissioner against the issue of the patent, see *Fowler v. Benton* (1880), 17 O. G. 266.

That no appeal lies from a decision affirming "the right of the applicant to make the Claims," and so overruling a motion to dissolve, see *Faure v. Bradley* (1888), 44 O. G. 945.

That an appeal from the order to dissolve for want of patentability lies to the examiners-in-chief, see *Fuller v. Brush* (1879), 16 O. G. 1188.

That if an interference is dissolved, and both applications are rejected, and one party appeals to the Supreme Court of the District, the other by two years



time limited for that purpose, or if the right to an appeal is expressly waived by the party entitled to it, the examiner returns the files and papers, with his own judgment upon the matters embraced in the motion, to the examiner of interferences, who dissolves or continues the interference in accordance with the facts found by the primary examiner. Two motions to dissolve on the same ground are not permitted, the remedy of the party claiming it being exhausted by one motion with the privilege of an appeal.<sup>8</sup>

§ 606. *Interference Proceedings: Suspension of the Interference.*

Whenever the examiner of interferences or the examiners-in-chief upon appeal discover any fact not bearing on the question of priority, but showing that no conflict actually exists between the inventions of the several claimants, or that the invention is not patentable to either party, or that the interference was irregularly declared, it is their duty to suggest it to the Commissioner, in order that he may suspend the interference and remand the case to the primary examiner for his consideration of the matters thus discovered.<sup>1</sup>

failure to prosecute his application may abandon it, see *Cruikshank v. Strong* (1880), 17 O. G. 511.

<sup>8</sup> That two motions to dissolve cannot be entertained on the same ground; one motion only with an appeal or rehearing being allowed, see *Banks v. Snediker* (1880), 17 O. G. 508.

§ 606. <sup>1</sup> That the examiner of interferences has no jurisdiction over questions of patentability, see *Little v. Lillie* (1876), 10 O. G. 543.

That when, on an interference, the patentability of the invention seems doubtful, the interference should be suspended and the question referred to the examiner for decision, see *Lynch v. Dryden* (1873), 3 O. G. 407; *Wood v. Morris* (1873), 4 O. G. 131; *Ex parte Neuboecker* (1873), 4 O. G. 319.

That if the invention is claimed to have been abandoned by public use, a suspension will be ordered and the case

sent to the examiner, see *Hedges v. Daniels* (1880), 17 O. G. 152.

That an interference will not be arrested by the Commissioner before an appeal and referred to the examiner on a question of public use, unless the proof is clear, see *Finch v. Bailey* (1883), 25 O. G. 191.

That an examiner of interferences cannot consider affidavits as to public use, and on that ground reject an application and dissolve the interference, see *Hedges v. Daniels* (1880), 17 O. G. 152.

That an examiner of interferences may be directed to investigate a question of public use, see *Ex parte Finch* (1887), 40 O. G. 1027.

That the examiner of interferences, by order of the Commissioner, may fix times for taking evidence on the question of public use, see *In re Alteneck* (1883), 23 O. G. 2233.

An interference may also be suspended by the Commissioner, upon the request of the primary examiner, for the purpose of adding new parties or when the examiner has found new references which seem to him to cast a doubt upon the patentability of the invention.<sup>2</sup> After the decision of the primary examiner upon these matters, or that of the examiners-in-chief on an appeal, the interference will be dissolved or re-instated as the character of such decision may require.<sup>3</sup> Judgment in an interference case which is otherwise ready for decision will not be suspended in order that different questions, not affecting the defeated party may be first determined.<sup>4</sup> Hearings before the primary examiners upon these suspensions, as well as upon motions to dissolve, and appeals from their judgments to the examiners-in-chief or the Commissioner, are governed by the rules heretofore discussed in reference to *ex parte* cases.

#### § 607. Interference Proceedings : Motions : Practice.

During the proceedings in an interference any other proper motions may be made by either party after reasonable notice

<sup>2</sup> That where the evidence on interference shows any other defects, suspension may be ordered and the case sent back to the examiner, see *Bigelow v. Commissioner* (1875), 7 O. G. 603 ; 2 *MacArthur*, 24.

That suspension may be ordered to add new parties, see *Maloney v. Kidwell* (1879), 16 O. G. 1139.

That if, pending an interference, an application is filed, which the examiner thinks should be included therein, he must report it to the examiner of interferences, who must ascertain whether any evidence has been taken ; if not, he may suspend the interference and admit the new party, otherwise report to the Commissioner, see *Reed v. Jordan* (1887), 38 O. G. 661.

That an interference opened by the primary examiner to let in new parties stands as if it had just been originally declared, and neither party has a right, at this stage, to interfere in the framing

of the issues or inspect the papers now admitted, see *White v. Demarest* (1887), 41 O. G. 1161.

<sup>3</sup> That if the decision of the examiner denies the patentability of the invention, the interference will be dissolved, unless appeal is taken, see *Stone v. Greaves* (1879), 17 O. G. 260.

<sup>4</sup> That the Commissioner will not suspend his judgment on an interference to await the decision of other questions not affecting the defeated party, see *Smith v. Dimond* (1881), 20 O. G. 742.

That an interference with a patent will not be suspended to await the decision of a suit as to its ownership, unless the interfering applicant is connected with the suit, or the parties to the suit are likely to be injured by the action of the Patent Office and are trying to protect their rights, see *Keith v. Faure* (1883), 25 O. G. 289.



to the adverse claimants.<sup>1</sup> Such motions are addressed to the tribunal having immediate jurisdiction of the interference, but an appeal from the decision thereby rendered may be taken to the examiners-in-chief on questions relating to the merits of the case and on other questions directly to the Commissioner, as provided in the general rules which govern all appeals. A motion does not necessarily operate as a stay of the proceedings. To effect this a special application must be made to the same tribunal, which may upon sufficient grounds order a suspension of the interference until the motion is decided.<sup>2</sup> The practice upon all motions in contested cases, where not particularly indicated by the rules of the Patent Office, follows the ordinary course of equity practice in the courts of the United States.

**§ 608. Interference Proceedings: Amendment of Application by Disclaiming Contested Matter.**

Amendments to an application while in interference can be made only for the purpose of delivering its subject-matter, wholly or in part, from the conflict in which it is apparently involved. An applicant who prefers to abandon any claim to the contested matter rather than incur the expense, delay, and risks of an interference, may file in the Patent Office, before the date fixed for the presentation of his preliminary statement, a disclaimer in writing over his own signature and attested by two witnesses, averring that he does not claim to be the inventor of the particular matter in issue. This disclaimer must be accompanied by such an amendment to his specification as removes the contested matter from his Claims as therein stated. Judgment will then be rendered<sup>3</sup> against him in the interference, and his disclaimer and amendment will be embodied in his remaining application, which will

§ 607. <sup>1</sup> That an interference is a contested case, even in its preliminary stages, and motions cannot be made without notice to the other party, see *Bell v. Gray* (1879), 15 O. G. 776; *Gray v. Bell* (1878), 15 O. G. 385.

That notice must be given to all other parties, since every application or

patent involved in the interference is hostile to all the rest, see *Bell v. Gray* (1879), 15 O. G. 776.

<sup>2</sup> That a motion does not stay proceedings in interference unless a petition to that effect is also offered and granted, see *Dubois v. McCloskey* (1880), 17 O. G. 1158.

thereafter be examined and determined as an *ex parte* case.<sup>1</sup> This disclaimer has no relation to the disclaimer of a patentee, filed for the purpose of amending an already granted patent.<sup>2</sup> Where there has been an assignment of the invention before or pending the application, such disclaimer must be accompanied by the written consent of the assignee.

§ 609. **Interference Proceedings: Amendment of Application by Withdrawing Uncontested Matter for New Application.**

Where an application covers several complete inventions, and an interference has been declared between it and another application or a patent embracing less than all the inventions therein claimed, the applicant may file an amendment withdrawing from his application the uncontested matters, in order to make these the subject of a new application, while the interference proceeds to judgment in reference to the matters in dispute.<sup>1</sup> In such new application no Claim can be inserted whose language includes anything still claimed in the original application, though the devices shown in the original may be described in the new, so far as may be necessary to render the subject-matter of the new intelligible to

§ 608. <sup>1</sup> That where the later applicant disclaims the conflicting invention the interference will be dissolved, see *Laverty v. Flagg* (1879), 16 O. G. 1141.

That the decision of the Commissioner, on appeal, that an amendment does not warrant a dissolution of an interference, is binding until duly reversed, *Ex parte Gardner* (1880), 17 O. G. 626.

<sup>2</sup> That an interference is not dissolved on account of a disclaimer made *pendente lite*, see *Waring v. Wilkerson* (1878), 15 O. G. 246.

That where a defeated party to an interference cancels the interfering Claims he cannot be required to disclaim such matter though his Claims may be made so specific as not to impose on the public, see *Ex parte Firm* (1887), 39 O. G. 1199.

§ 609. <sup>1</sup> That a party to an interference may remove from his application all his own peculiar separable inventions and not await the decision in the contest, see *Ex parte Wheeler* (1883), 23 O. G. 1031.

That a party to an interference cannot make in a separate application any Claim which the adverse party might also make, see *Ex parte Wheeler* (1883), 23 O. G. 1031.

That where in an interference the undisputed matter is withdrawn, and made the basis of a separate application, and a patent disclaiming all not claimed therein and reserving the right to apply for the disclaimed matter issues, and then a third application is filed claiming all in both the others, the latter is treated as a division of the first, see *Ex parte Clarke* (1884), 26 O. G. 824.



persons skilled in the art. The new application will be then examined and proceeded with as an *ex parte* case, unless some other interference is discovered.

**§ 610. Interference Proceedings: Discovery of Non-Patentability of the Invention pending the Interference.**

In rendering their decision on the question of priority, it is the duty of the examiner of interferences, or of the examiners-in-chief upon appeal, to call the attention of the Commissioner to any points they may discover relating to the general merits of the applications.<sup>1</sup> The Commissioner may then remand the case to the primary examiner for his consideration, the parties having the same rights of appeal from his determination of these questions as in other cases.<sup>2</sup> On an appeal from the examiners-in-chief to the Commissioner, upon the issue of priority, if he perceives that any matter relating to the patentability of the invention, or to the rights of either of the claimants as against the public, still remains undetermined, he may in the same manner provide for its examination and decision.<sup>3</sup>

**§ 611. Interference Proceedings: Effect of Judgment.**

A judgment in an interference, if not appealed from, is conclusive on the parties to the interference as far as the action of the Patent Office is concerned, and a second interference will not be declared between the same parties in reference to the same invention, either upon the same or upon

§ 610. <sup>1</sup> That all questions as to the patentability of the invention ought to be settled before the interference is declared, but if afterwards arising they must be considered, see *Wood v. Morris* (1873), 3 O. G. 239.

That if questions as to patentability first appear on the interference hearing they may be noted, and afterward passed upon by the primary examiner, see *Anson v. Woodbury* (1876), 11 O. G. 243.

That on an appeal to the examiners-in-chief in an interference, if the devices

are found not to interfere, this question is not in issue but may be noted in a postscript for further action, see *Brown v. La Dow* (1880), 18 O. G. 1049.

<sup>2</sup> That a hearing on an interference will be opened to let in newly discovered evidence as to the novelty of the invention, see *Wood v. Morris* (1873), 3 O. G. 239.

<sup>3</sup> That the Commissioner must take notice of an objection to patentability, however it may be brought to his attention, see *Ex parte Smoot* (1877), 11 O. G. 1010.

amended or new applications.<sup>1</sup> The former decision, if erroneous either in fact or in law, can, however, be reviewed, when substantial justice requires it, on a new trial granted according to the principles governing such proceedings in ordinary cases.

**§ 612. Interference Proceedings : Number Unlimited : Consolidation of Interferences.**

Any number of interferences may be instituted between a given application and conflicting patents or applications ; and these may be concurrent or successive, as the circumstances may require.<sup>1</sup> When several applications interfere with one another upon the same subject-matter, presenting but a single issue, the various reciprocal interferences may be consolidated and disposed of upon one proceeding.<sup>2</sup> When a new application is filed pending an interference between others, every one of which conflicts with it on different points relating to the invention therein described, each of the former parties may so amend his application as to include all the points claimed in the later, and a new interference embracing all the applications will be then declared.<sup>3</sup> But if an application is in

§ 611. <sup>1</sup> That a second interference will not be declared between the successful party and his opponents, on other applications, although they show features described but not claimed in the successful application, unless the Commissioner so order, see *Hovey v. Muller* (1873), 3 O. G. 149.

§ 612. <sup>1</sup> In *Potter v. Dixon* (1863), 5 Blatch. 160, Nelson, J. : (163) "It is supposed by the learned Chief Justice that there can be but one interference declared by the Commissioner on an application for a patent, and that the decision of the Chief Justice is conclusive upon the Commissioner, though in the meantime, and before the patent issues, another case of interference should appear or be presented. There is certainly nothing in the statute limiting the power of the Commissioner in this respect, and the reason for the hearing in

the second case is as strong as for that in the first. The object of the provision is one that pervades the whole of the statute, namely, to secure to the real inventor the exclusive privileges therein provided for. Besides, a hearing and decision between the applicant for a patent and A, whether in favor of the one or the other, forms no rule for a decision between the applicant and B, in case of an interference declared between them. The proceedings are independent and *inter alios*." 2 Fisher, 381 (384).

That evidence as to priority must be received by the Patent Office if offered at any time before the patent issues, see *Eccard v. Drawbaugh* (1883), 24 O. G. 301.

<sup>2</sup> That interferences may be consolidated, see *Bell v. Gray* (1879), 15 O. G. 776.

<sup>3</sup> That when a new application is



conflict with another only upon one divisible member of the invention, and with still another only on a different member of the invention, the issues presented are entirely distinct, and the interference proceedings must be separate and independent of each other. A judgment in one interference does not prevent the successful contestant from being made a party to another interference with different opponents, and for this purpose his patent may be withheld from issue even after the allowance of his application and the payment of the final fee.<sup>4</sup>

§ 613. **Interference Proceedings: Judgment how far Conclusive.**

The doctrine of *res adjudicata* is recognized and applied in the Patent Office as well as in the courts.<sup>1</sup> But a judgment in one interference furnishes no guide in others, and is binding only on the parties to the record, and on them only in reference to further proceedings on the same questions in the Patent Office.<sup>2</sup> Before the courts the adverse parties still stand

filed, interfering with two or more applications already in interference, a new interference will be declared and the former parties may amend their Claims so as to meet the last application, see *Ex parte Smith* (1880), 17 O. G. 447.

<sup>4</sup> That an application is pending until the patent has been recorded, and up to that time it may be put in interference, whatever orders or payments may have been made, see *Ex parte Osgood* (1885), 33 O. G. 1265.

That the patent will not be withheld, after payment of the final fee, for the purpose of declaring an interference with a new conflicting application filed after a judgment for the patentee in a former interference, see *Wright v. Reese* (1877), 11 O. G. 329.

That no delay in interference proceedings against the consent of the applicant can abandon the application, see *Taylor v. Shreffler* (1883), 24 O. G. 1175; *Weston v. White* (1876), 13 Blatch. 447; 2 Bann. & A. 364.

§ 613. <sup>1</sup> That the doctrine of *res adjudicata* applies to proceedings in the Patent Office, see *Ex parte Burge* (1877), 13 O. G. 498; *Whitely v. McCormick* (1876), 10 O. G. 826.

That an interference-judgment is binding in interference cases in the Patent Office, though it may not be in the courts, see *Nicholson v. Bennett* (1879), 16 O. G. 631.

That an interference-judgment is conclusive in the Office upon all points which might by due diligence have been presented at the hearing, except in special cases, see *Whitely v. McCormick* (1876), 10 O. G. 826; *Harlow v. Guernsey* (1875), 7 O. G. 513.

<sup>2</sup> That a judgment in one interference can only indirectly affect others, see *Ex parte Hedderwick* (1879), 15 O. G. 472.

That the decision of the Chief Justice of the District of Columbia on an appeal under the act of 1839 did not prevent the declaration of an interference between the prevailing party and

upon equal ground, and the defeated claimants may be heard, like any other persons, in denial of the claims of the successful party, or in affirmation of their own.<sup>3</sup> The judgment of the Patent Office in an interference is, however, noticed by the courts as an indication that priority is justly claimed by the prevailing party till the contrary appears, and has been held to be a sufficient reason for granting him an injunction forbidding the infringement of his patent by the others until the controversy can be legally determined.<sup>4</sup>

other applications, see *Potter v. Dixon* (1863), 2 Fisher, 381; 5 Blatch. 160.

That a patent does not issue as of course upon a decision in interference for one party, see *Potter v. Dixon* (1863), 2 Fisher, 381; 5 Blatch. 160.

<sup>3</sup> In *Union Paper Bag Machine Co. v. Crane* (1874), 1 Bann. & A. 494, Lowell, J.: (495) "The decision of the Patent Office is never final upon the question of the novelty or priority of an invention. The rule may have been adopted at first from a consideration of the *ex parte* character of the proceedings at Washington, but it has never been confined, as is now maintained by the complainant, to cases in which no contest was had; and it is obvious that it cannot be so limited, because, if one party to an interference is concluded as against the other party, the result may be that a patent is valid as against him, which is void as against all the rest of the world." 6 O. G. 801 (801), Holmes, 429 (430).

See also *Minneapolis Harvester Works v. McCormick Harvester Mach. Co.* (1886), 37 O. G. 566; 28 Fed. Rep. 565; *Celluloid Mfg. Co. v. Chrolithion Collar & Cuff Co.* (1885), 24 Fed. Rep. 275; 32 O. G. 383; *Whipple v. Miner* (1883), 15 Fed. Rep. 117; 23 O. G. 2236; *Perry v. Starrett* (1878), 14 O. G. 599; 3 Bann. & A. 485.

That an interference-judgment between a patent and a later application is never conclusive on the patentee, see

*Perry v. Starrett* (1878), 3 Bann. & A. 485; 14 O. G. 599.

That a decision in an interference against a patentee does not bar him from suing to have the other's patent annulled, see *Hubel v. Tucker* (1885), 23 Blatch. 297; 22 Fed. Rep. 701.

That an interference-judgment is not conclusive except as to priority between the same parties, and on them only when they accept and act upon it, see *Peck, Stow, & Wilcox Co. v. Lindsay* (1879), 18 O. G. 68; 2 Fed. Rep. 688; 5 Bann. & A. 390.

That an interference-judgment is *res adjudicata* between the parties, see *Shuter v. Davis* (1883), 16 Fed. Rep. 564; 24 O. G. 303.

<sup>4</sup> That the decision of the Commissioner on priority, though not conclusive, is of great weight, see *Gloucester Isinglass & Glue Co. v. Brooks* (1884), 19 Fed. Rep. 426.

That an interference decision not appealed from is not conclusive on the parties but raises a strong presumption against the defeated party, see *Kirk v. Du Bois* (1887), 42 O. G. 297.

That an interference-judgment raises no presumption against any one but the defeated party and his privies, see *Edward Barr Co. v. N. Y. & N. H. Automatic Sprinkler Co.* (1887), 32 Fed. Rep. 79.

That an interference-judgment is ground for an injunction in favor of the successful against the defeated party,



§ 614. Interference Proceedings : Estoppel.

The doctrine of estoppel is also enforced in the Patent Office.<sup>1</sup> A party may be estopped either by his acts or admissions in relation to the matter in dispute, as against all other parties whose conduct in regard to the same matter has been based in good faith on his own.<sup>2</sup> A concession of priority binds him who makes it as to the pending proceedings and in favor of the other parties to the interference, and after such concession he cannot claim a new interference either upon the same grounds or on any other grounds which might have been taken advantage of in such proceedings.<sup>3</sup> A device once contended for in an interference as material and patentable in the form in which it is presented in the application cannot afterwards be claimed by the same party to have been insufficiently or erroneously described.<sup>4</sup> But the doctrine is confined within the narrow limits here specified, and is not applied in favor of third parties nor in reference to other controversies than the one to which the act or the admission specially relates.<sup>5</sup>

see *Celluloid Mfg. Co. v. Chrolithion Collar and Cuff Co.* (1885), 24 Fed. Rep. 275 ; 32 O. G. 383 ; *Smith v. Halkyard* (1883), 16 Fed. Rep. 414 ; 23 O. G. 1833. See also § 1183 and notes, *post*.

That the concurrent judgment of the examiner of interferences and the board of examiners is of great weight, but not conclusive, see *Sellers v. Walter* (1886), 37 O. G. 1001.

That the defeated party in an interference has the burden of proof in any future controversy as to priority, see *Wire Book Sewing Mach. Co. v. Stevenson* (1882), 15 Phila. 481 ; 11 Fed. Rep. 155.

§ 614. <sup>1</sup> That the doctrine of estoppel applies in interference cases, see *Berry v. Stockwell* (1876), 9 O. G. 404 ; *Ex parte Roe* (1874), 5 O. G. 397.

<sup>2</sup> That a party to an interference is not estopped by his conduct or admissions, unless the other party has been induced to act on them in relation to

the invention in controversy, see *Taylor v. Bourguignon* (1879), 16 O. G. 958.

<sup>3</sup> That a concession of priority binds the parties to the interference, see *Burgess v. Wetmore* (1879), 16 O. G. 765.

That a party, having conceded priority to his rival, and the patent having issued on such concession, cannot claim a new interference on the same grounds or on any which might have been advanced at the former hearing, see *Harlow v. Guernsey* (1875), 7 O. G. 513.

<sup>4</sup> That a device, once contended for in an interference, cannot afterwards be declared by the contestants to have been erroneously or insufficiently described in the application, see *Ex parte Kirby* (1879), 16 O. G. 1095.

<sup>5</sup> That the defeated party in an interference is not estopped from objecting to the patent of his rival on the ground of want of novelty, see *Smith v. Halkyard* (1883), 16 Fed. Rep. 414 ; 23 O. G. 1833.

### § 615. Interference Proceedings: New Trials.

Now trials are granted in the Patent Office for the same reasons and with the same restrictions as in other judicial tribunals.<sup>1</sup> The principal grounds for a new trial are the discovery of new evidence, fraud, or mistake of the tribunal on the former trial as to the real points at issue.<sup>2</sup> A new trial will be granted on the ground of newly discovered evidence only when the evidence is important, was not previously procurable by the use of due diligence, is not cumulative, proves a new and independent fact, and has become known to the party since the former trial.<sup>3</sup> If the petitioner failed to employ reasonable diligence in ascertaining the necessity for such evidence and in procuring it before the former trial, or if he were put on inquiry by evidence already given and failed to make the proper application for a continuance in order to secure it if he found it necessary to his case, or if the evidence in itself would manifestly not change the result, his prayer must be denied.<sup>4</sup> No new trial can be permitted

§ 615 <sup>1</sup> That new trials in the Patent Office are governed by the same rules as in the courts, see *Stevens v. Putnam* (1880), 18 O. G. 519; *Wicks v. McAvoy* (1880), 18 O. G. 859; *contra*, *Eccard v. Drawbaugh* (1883), 24 O. G. 301.

That the Commissioner cannot rehear matters adjudged by his predecessors, except on new facts or by way of new trial, see *Lee v. Walsh* (1879), 15 O. G. 563.

<sup>2</sup> That no rehearing in an interference will be allowed, except on such grounds as give the right to a new trial, see *Ex parte Pattee* (1872), 2 O. G. 618.

That a new trial may be granted on the ground of fraud or newly discovered evidence, though a patent has already been awarded to the former successful party, see *Hibbard v. Richmond* (1880), 17 O. G. 1155; *Richmond v. Hibbard* (1879), 16 O. G. 908.

<sup>3</sup> That a new trial for newly dis-

covered evidence will be granted only when the evidence is (1) important; (2) not previously procurable by due diligence; (3) not cumulative; (4) proves a new and independent fact; and (5) became known to the party since the former trial, see *Stevens v. Putnam* (1880), 18 O. G. 519.

<sup>4</sup> That no new trial will be granted for new evidence unless due diligence had been used, see *Rogers v. Bear* (1879), 16 O. G. 908.

That no rehearing will be granted unless the new evidence will fix the date conclusively, see *Eccard v. Drawbaugh* (1883), 24 O. G. 301.

That where the new evidence will not change the result, or where the party was put on inquiry by the evidence already given, and might have procured that now offered as new evidence, a new trial will be denied, see *Josselyn v. Swezey* (1879), 15 O. G. 702.

That where the new evidence is really important its recent discovery



on the ground of ignorance, inadvertence, or mistake of the party or his counsel, or of surprise in matters of law, or of misstatements of attorneys, or of the omission of the former tribunal to give due weight to the evidence admitted or to conform its decision to evidence excluded as inadmissible.<sup>5</sup> A new trial for a judgment against evidence will not be allowed unless the judgment is either wholly unsupported by, or is in direct conflict with, the evidence received.<sup>6</sup> The right to a new trial may be forfeited by an unreasonable delay.<sup>7</sup> The decision of the examiner on an application for a new trial may be revised by the Commissioner; and where sufficient ground appears for granting it a new interference may be declared, and the question of priority again investigated, although the prevailing party on the former hearing has already received his patent.<sup>8</sup>

and former diligence of the applicant are not necessary, see *Eccard v. Drawbaugh* (1883), 24 O. G. 301.

That a new trial will not be granted on the ground that the former evidence was taken pending a motion to dissolve the interference, see *Dubois v. McCloskey* (1880), 17 O. G. 1158.

That on a motion for a rehearing evidence which might have been produced on the original hearing will not be regarded unless satisfactory reasons for not then producing it are given, see *Burdsall v. Curran* (1887), 42 O. G. 1167.

<sup>5</sup> That ignorance, inadvertence, or mistake of a party or his counsel, or surprise in matters of law, are not grounds for new trial, see *Dod v. Cobb* (1876), 10 O. G. 462.

That a misstatement by counsel in argument is not ground for new trial, see *Wicks v. McAvoy* (1880), 18 O. G. 859.

That the court below mistook the issue, and did not give due weight to certain evidence, is ground for appeal, not new trial, see *Slade v. Blair* (1879), 15 O. G. 830.

That a case decided in spite of evidence offered and excluded as inadmis-

sible will not be re-opened to let in other evidence to establish the same fact, see *Farcot v. Rice* (1879), 15 O. G. 563.

<sup>6</sup> That a rehearing will be granted where there has been a manifest error as to the real question at issue, see *Hull v. Lowden* (1881), 20 O. G. 741.

That the concurrent decisions of lower tribunals on questions of fact will be set aside only for evident error, see *Hazelip v. Richardson* (1876), 10 O. G. 747.

That on a motion for new trial the question is whether the former findings are either wholly unsupported by, or clearly in conflict with, the evidence, see *Gardner v. Dudley* (1880), 18 O. G. 683.

<sup>7</sup> That the right to new trial may be lost by laches, see *Jones v. Greenleaf* (1879), 15 O. G. 560.

That the right to a rehearing or new trial is waived by an appeal, though the appellate court has no jurisdiction, see *Gill v. Scott* (1884), 29 O. G. 949.

<sup>8</sup> That the declaration of a new interference is governed by the same rules as a new trial, see *Marsh v. Dodge* (1872), 2 O. G. 643.

§ 616. **Interference Proceedings: Parties to: Assignees.**

The parties to an interference are usually the rival inventors themselves, and from the nature of the case and the required proceedings no interference can be properly conducted without their participation. But when an inventor is unable or refuses to prosecute or defend his own claims to priority, or whenever the ends of justice would be otherwise defeated, an assignee may be permitted to protect his rights in the invention as a party to the interference, upon motion duly made to the Commissioner and satisfactory evidence that the necessity for such permission actually exists.

SECTION XI.

OF THE FORM AND EFFECT OF LETTERS-PATENT.

§ 617. **Issue of Patent is a Judgment that all Prerequisites are Fulfilled.**

The issue of letters-patent is a judgment that all prerequisites have been performed, and that all the conditions necessary to the granting of a patent privilege have been fulfilled.<sup>1</sup> Upon mere formal matters this judgment is final.<sup>2</sup> Upon questions relating to the merits of the invention and the title of the patentee it is *prima facie* correct, and casts the burden of proof upon any one who controverts the presumption raised by the patent.<sup>3</sup> Upon material points concerning the regu-

§ 617. <sup>1</sup> That the issue of a patent is a judgment that all the facts entitling the patentee to the patent do exist, see *Konold v. Klein* (1878), 3 Bann. & A. 226.

<sup>2</sup> That the decision of the Commissioner is final as to the sufficiency of all formal acts and proofs prerequisite to a patent, see *Mahn v. Harwood* (1884), 112 U. S. 354; 30 O. G. 657; U. S. Rifle & Cartridge Co. v. Whitney Arms Co. (1877), 14 Blatch. 94; 11 O. G. 378; 2 Bann. & A. 493.

That after the patent issues the Patent Office cannot inquire whether the

patentee made a false oath, see *Ex parte Gillen* (1877), 11 O. G. 419.

<sup>3</sup> That the issue of the patent constitutes *prima facie* evidence of all facts entitling the patentee to the grant, see *Eagleton Mfg. Co. v. West, Bradley, & Cary Mfg. Co.* (1880), 17 O. G. 1504; 18 Blatch. 218; 2 Fed. Rep. 774; *Konold v. Klein* (1878), 3 Bann. & A. 226; *Sands v. Wardwell* (1869), 3 Clifford, 277; *Philadelphia & Trenton R. R. Co. v. Stimpson* (1840), 14 Peters, 448; 2 Robb, 46.

That the decision of the Commissioner is never conclusive on a question



larity of the proceedings in the Patent Office it is so far conclusive that the patent cannot be collaterally attacked upon such grounds, although they may present reasons for its repeal on a bill in equity, or an information.<sup>4</sup>

### § 618. Protest against the Issue of Letters-Patent.

A protest against the issue of a patent may be filed by any person, though not a party to the application nor otherwise connected with the proceedings, for the purpose of calling the attention of the Patent Office to objections urged against the application, or of asserting or saving his own rights as a claimant of the invention. In reference to the objections stated in such protest the Commissioner may take whatever action he deems necessary. As a notice to the Office of the claims of the protestant, it may furnish evidence in some future controversy to rebut presumptions of abandonment or acquiescence in the issue of the patent to another claimant. The protest must show that an application has been or will be filed, and that the protestant's knowledge of the existence of such application has been lawfully obtained through its voluntary communication to him by the applicant.<sup>1</sup>

### § 619. Letters-Patent, to whom Issued.

The grantee of a patent is usually the applicant himself. But when an inventor dies pending his application, the patent

of law, see *Gardner v. Herz* (1886), 118 U. S. 180; 35 O. G. 999; *Mahn v. Harwood* (1884), 112 U. S. 354; 30 O. G. 657.

That the decision of the Commissioner is not conclusive upon questions of abandonment or other matters relating to the merits, see *Planing Mach. Co. v. Keith* (1879), 101 U. S. 479; 17 O. G. 1031; *Wilson v. Barnum* (1849), 2 Fisher, 635; 1 Wall. Jr. 847; 2 Robb, 749. See also § 578 and notes, *ante*.

That the decision of the Commissioner is not conclusive on any question on which a defence in the courts may be based under the statutes, see *Mahn v. Harwood* (1884), 112 U. S. 354; 30 O. G. 657.

<sup>4</sup> That the regularity of a patent cannot be collaterally attacked, see *Hoe v. Cottrell* (1880), 18 O. G. 59; 17 Blatch. 546; 1 Fed. Rep. 597; 5 Bann. & A. 256; *Doughty v. West* (1869), 6 Blatch. 429; 3 Fisher, 580.

See also, as to all the matter of this paragraph, §§ 423, 451, and notes, *ante*, and §§ 967, 1016, 1032, and notes, *post*. As to whether and when a patent can be repealed, see §§ 716-730 and notes, *post*.

§ 618. <sup>1</sup> That a protest against the issue of a patent can be made only under the rules of the Patent Office, and must show that an application has been, or is about to be, filed and that the protestant's knowledge of it has been lawfully acquired, see *Ex parte Neale* (1879), 15 O. G. 511.

issues to his executor or administrator, in trust for his heirs at law or devisees. When an applicant assigns the whole interest in the expected patent or the entire invention, the patent will be granted to the assignee upon the request of the applicant; and when the assignment transfers only an undivided interest, the patent will, upon a similar request, be awarded jointly to the original applicant and the assignee. To secure the issue of the letters-patent to an assignee, either as the sole or part owner of the invention, however, the assignment must contain an express petition to that effect, and must be received at the Patent Office for record at a date not later than the day on which the final fee is paid.<sup>1</sup>

### § 620. Form and Contents of Letters-Patent.

The patent itself is exceedingly brief and simple. It consists of a short title or description of the invention, correctly indicating its nature and purpose, and a grant to the patentee, his heirs or assigns, of the exclusive right to make, use, and vend the invention described in the title and the annexed specification throughout the United States and its territories during the period prescribed by law. No recital of proceedings in the Patent Office is required, all presumptions being in favor of their correctness;<sup>1</sup> but a copy of the specification and drawings is appended to and is by law made part of the grant.<sup>2</sup> All patents issue in the name of the United States, under the seal of the Patent Office, and must be signed by the Secretary of the Interior and countersigned by the Commissioner. This signature of the Secretary is essential to the validity of the patent, and a patent accidentally issued without it cannot be amended after his term of office has expired.<sup>3</sup>

§ 619. <sup>1</sup> For the matter of this paragraph see also §§ 367, 368, 403-414, and notes, *ante*, and §§ 769-772, 800-802, 836, 844, and notes, *post*.

§ 620. <sup>1</sup> That a patent need not recite that the prerequisites have been fulfilled, see *Gear v. Grosvenor* (1873), *Holmes*, 215; 6 *Fisher*, 314; 3 *O. G.* 380; *Philadelphia & Trenton R. R. Co. v. Stimpson* (1840), 14 *Peters*, 448; 2 *Robb*, 46.

<sup>2</sup> That the specification might have been made part of the patent before 1836, at the request of the patentee, see *Hogg v. Emerson* (1850), 11 *How.* 587.

That under the act of 1790 the allegations of the petition were recited in the patent, see *Evans v. Chambers* (1807), 2 *Wash.* 125; 1 *Robb*, 7.

<sup>3</sup> That a patent is not valid unless signed by the Secretary, and if accidentally issued without his signature it



The patent is not complete until duly sealed; but when allowed and signed it is the duty of the Commissioner to affix the seal, unless it is evident to him that the issue of the patent would be contrary to law.

**§ 621. Date and Delivery of Letters-Patent.**

Every patent must bear date as of a day not later than six months from the allowance of the application and the mailing of the notice and request for the final fee. On payment of the fee the patent is prepared for issue, and receives its date and number, and is delivered to the patentee or his attorney, as the attorney may direct. In no case can a patent be antedated.<sup>1</sup> It takes effect as the grant of an exclusive privilege from the date of issue, although as evidence of an inventive act, and for many other purposes, it relates back to the date of the application upon which it is based.<sup>2</sup>

cannot be amended by his successor, see *Marsh v. Nichols* (1883), 15 Fed. Rep. 914; 24 O. G. 901.

That it is doubtful whether a patent issued without the signature of the Secretary becomes good from the date of his subsequently signing it, see *Marsh v. Nichols* (1883), 24 O. G. 901; 15 Fed. Rep. 914.

That the omission of the Secretary's signature cannot be aided by showing the perfect patent on the record (an imperfect grant not being saved by a perfect record), nor be amended by his successor though he were the Acting Secretary when the omission occurred, nor be cured by affixing the true signature after the Secretary's official term has expired, see *Marsh v. Nichols* (1883), 24 O. G. 901; 15 Fed. Rep. 914. See also *McGarrahan v. Mining Co.* (1877), 96 U. S. 316; *Goodman v. Randall* (1877), 44 Conn. 321.

§ 621. <sup>1</sup> That under the present law a patent cannot be antedated, see *Gramme Electrical Co. v. Arnoux & Hochhausen Electric Co.* (1883), 17 Fed. Rep. 838; 21 Blatch. 450; 25 O. G. 193.

That prior to 1836 a patent could not be antedated, see *Opinion Atty. Gen.* (1820), 5 Op. At. Gen. 722.

That under the acts of 1861 and 1836, a patent could be dated from the filing of the specification, if not preceding its issue more than six months, see *Burdett v. Estey* (1880), 3 Fed. Rep. 566; 19 Blatch. 1.

<sup>2</sup> That a patent takes effect from the date of the grant, see *Gramme Electrical Co. v. Arnoux & Hochhausen Electric Co.* (1883), 17 Fed. Rep. 838; 25 O. G. 193; 21 Blatch. 450.

That a patent may not always take its date from the day when it begins to run, as when it begins from the date of a foreign patent, see *De Florez v. Reynolds* (1880), 17 O. G. 503; 17 Blatch. 436; 8 Fed. Rep. 434; 5 Bann. & A. 140.

That a patent relates back to the date of the application, see *Johnsen v. Fassman* (1872), 5 Fisher, 471; 2 O. G. 94; 1 Woods, 138.

That in the absence of all other proof the date of the patent will be assumed to be the date of the application and of

§ 622. **Term of Patent Privilege Limited by Express Statute or by Foreign Patents.**

The term of a patent is measured by the statute, not by the language of the grant.<sup>1</sup> Where the invention has not been previously patented in a foreign country, the term is uniformly fixed at seventeen years from the date of the grant.<sup>2</sup> But where a foreign patent has already been obtained, a different rule has been adopted. It is the policy of our government not to impose upon our own public a greater restriction than has been or may be placed upon a foreign people in the use of the invention; and where the invention has been disclosed abroad by a patent, and will become the property of the foreign public after a given period of time, it is the purpose of our statutes to permit no more extended monopoly to the inventor in the United States. Various rules have been from time to time established to secure this result. Under the act of 1836 a foreign patent was a bar to a domestic application unless it had been granted and published within six months preceding the filing of the latter, thus making the terms of both substantially the same.<sup>3</sup> The act of

an assignment before patent, see *Worley v. Loker Tobacco Co.* (1882), 104 U. S. 340; 21 O. G. 559.

That a patent on a renewal application is to be dated six months after the renewal application is allowed, see *Thomson v. Waterhouse* (1884), 30 O. G. 177.

§ 622. <sup>1</sup> That the statute, not the language of the patent, limits its term, see *De Florez v. Reynolds* (1880), 17 O. G. 503; 8 Fed. Rep. 434; 17 Blatch. 436; 5 Bann. & A. 140.

That the patent ought to express its actual duration, see *Opinion Sec. Int.* (1882), 21 O. G. 1197.

That Sec. 4887 does not require that the term of a patent shall be correctly stated in the patent itself, but only limits the term, and the grant of a patent for seventeen years, therefore, does not prevent it from expiring with a prior foreign patent, see *Canan v.*

*Pound Mfg. Co.* (1885), 31 O. G. 119; 23 Blatch. 173; 23 Fed. Rep. 185.

That a domestic patent is valid, though its term is not expressly limited to that of a foreign patent, see *American Paper Barrel Co. v. Laraway* (1886), 28 Fed. Rep. 141; 37 O. G. 674.

That in the absence of fraud the date of a patent may be altered to correspond with that of a foreign patent, see *Opinion Atty. Gen.* (1844), 4 Op. At. Gen. 335.

<sup>2</sup> That under the act of 1861 patents "remain in force" seventeen years, not run seventeen years from the date of the patent, see *De Florez v. Reynolds* (1880), 17 O. G. 503; 8 Fed. Rep. 434; 17 Blatch. 436; 5 Bann. & A. 140.

<sup>3</sup> That under the act of 1836 a foreign patentee applying for a domestic patent, within the time prescribed, could enjoy the full statutory term, see *American Diamond Rock Boring Mach. Co. v. Sheldon* (1879), 17 Blatch. 303.



1839 provided that the term of the American patent should be limited to fourteen years from the date of publication of the foreign patent, thereby delivering the invention from the protection of the patent at the time when it would have come into the possession of the public if the American and foreign patents had been simultaneously issued.<sup>4</sup> Under the act of 1861 the period of seventeen years was substituted for that of fourteen years in this as well as in those cases where no previous foreign patent had been granted.<sup>5</sup> In 1870 the present law was enacted, requiring the term of the American patent to be so limited as to expire at the same time with the foreign patent; or, if there be more than one, with that having the shortest term, but in no case to be more than seventeen years.<sup>6</sup>

<sup>4</sup> That under the act of 1839 the inventor might have a patent for the full term, though a prior foreign patent had been granted within six months, see *Kendrick v. Emmons* (1875), 2 Bann. & A. 208; 9 O. G. 201.

That before the act of 1861 patents were not limited by the term of a foreign patent, see *Goff v. Stafford* (1878), 14 O. G. 748; 3 Bann. & A. 610.

That the act of 1839 did not apply to cases where the foreign specification was filed less than six months before the application in the United States, see *American Diamond Rock Boring Mach. Co. v. Sheldon* (1879), 17 Blatch. 303.

<sup>5</sup> That the act of 1861 does not repeal the provisions of the act of 1839 on this subject, but modifies them to make the term seventeen instead of fourteen years, see *Ex parte Siemens* (1877), 11 O. G. 1107.

That under the act of 1861 the American patent was limited to seventeen years from the date of the previous foreign patent, see *Guarantee Insurance, Trust, & Safe Deposit Co. v. Sellers* (1887), 41 O. G. 1165; *Siemens v. Sellers* (1883), 16 Fed. Rep. 856; 23 O. G. 2234; 16 Phila. 554; *De Florez v. Reynolds* (1880), 17 O. G. 503; 8 Fed.

Rep. 434; 17 Blatch. 436; 5 Bann. & A. 140; *Nathan v. N. Y. Elevated R. R. Co.* (1880), 2 Fed. Rep. 225; 5 Bann. & A. 280.

That the act of 1861 caused the domestic patent to expire seventeen years from the date when the prior foreign patent took effect in favor of the patentee, see *De Florez v. Reynolds* (1880), 17 O. G. 503; 8 Fed. Rep. 434; 17 Blatch. 436; 5 Bann. & A. 140.

That the act of 1861 changes the date when the term ends, not the date of its beginning, see *Guarantee Insurance, Trust, & Safe Deposit Co. v. Sellers* (1887), 41 O. G. 1165.

<sup>6</sup> That the act of 1870 causes an American patent to expire at the same date with the shortest foreign patent that was granted before the grant of the American patent, see *Gramme Electrical Co. v. Arnoux & Hochhausen Electric Co.* (1883), 21 Blatch. 450; 17 Fed. Rep. 838; 25 O. G. 193; *Koechlin v. Marble* (1882), 2 Mackay, 12; 22 O. G. 1365; *Henry v. Providence Tool Co.* (1878), 14 O. G. 855; 3 Bann. & A. 501.

That the foreign patent limits the domestic, though the applicant here is the foreign patentee or some one to

§ 623. Term of Patent Privilege: When Limited by Foreign Patents.

In order that the term of the foreign patent may thus limit that of the domestic patent, it is essential that the inventions covered by the two patents should be identical,<sup>1</sup> and that the foreign patent should take effect before the issue of the domestic patent. The foreign patent takes effect when it is so issued as to create a monopoly in favor of the inventor, whether the patent is then disclosed to the general public or

whom the inventor caused the foreign patent to be granted, or is an American citizen, see *Edison Electric Light Co. v. U. S. Electric Lighting Co.* (1888), 43 O. G. 1456.

That the act of 1870 was not retroactive and did not apply to previous American patents or their re-issues, see *Anilin v. Hamilton Mfg. Co.* (1878), 3 Bann. & A. 235; 13 O. G. 273; *Goff v. Stafford* (1878), 3 Bann. & A. 610; 14 O. G. 748.

That an American patent cannot run over seventeen years, and will expire with any shorter prior foreign patent, see *Weston v. White* (1876), 9 O. G. 1196; 13 Blatch. 364; 2 Bann. & A. 321.

That to limit the term of a domestic by that of a foreign patent is to make both expire at the same time, see *Ex parte Siemens* (1877), 11 O. G. 969.

That the same rule applies when a single American patent covers several inventions separately patented abroad, see *Ex parte Unsworth* (1879), 15 O. G. 882.

§ 623. <sup>1</sup> That an American patent is not limited by the term of a foreign patent unless the inventions are identical, see *Siemens v. Sellers* (1883), 16 Phila. 554; 23 O. G. 2234; 16 Fed. Rep. 856; *Ex parte Siemens* (1877), 11 O. G. 969.

That the invention covered by a domestic patent will be the same as that covered by a foreign patent when the principle is the same though it may be

improved, and in this case the term of the whole patent is that of the foreign patent, see *Guarantee Insurance, Trust, & Safe Deposit Co. v. Sellers* (1887), 41 O. G. 1165.

That a domestic patent is not limited by a foreign patent unless the latter claims as well as describes the same invention, see *Holmes Electric Protective Co. v. Metropolitan Burglar Alarm Co.* (1884), 22 Fed. Rep. 341; 32 O. G. 384.

That a patent which is a mere adaptation of a foreign patent expires at the same time, though some slight improvement be embraced in it, see *Clark v. Wilson* (1886), 28 Fed. Rep. 95; 36 O. G. 456.

That if the foreign invention would be enjoined as an infringement of the domestic patent it is the same, see *Commercial Mfg. Co. v. Fairbank Canning Co.* (1886), 27 Fed. Rep. 78; 36 O. G. 1473.

That if a representation in an application that the invention is identical with that covered by a foreign patent is made in good faith it does not estop the applicant from subsequently denying it, see *Commercial Mfg. Co. v. Fairbank Canning Co.* (1886), 27 Fed. Rep. 78; 36 O. G. 1473.

That the validity of a domestic patent cannot depend on that of a foreign patent, though its duration may, see *Cornely v. Marekwald* (1883), 21 Blatch. 367; 24 O. G. 498; 17 Fed. Rep. 83.



is by law confined to the knowledge of a certain class of persons.<sup>2</sup> It has been held in several cases that the foreign patent must have issued before the filing of the application in the United States;<sup>3</sup> but this doctrine was not consistent with the purpose of the rule, and later cases have therefore decided that it is sufficient if the foreign patent take effect before the actual grant of the domestic.<sup>4</sup> Where both are

<sup>2</sup> That the date of a foreign patent, when controlling the term of an American patent, is the date of its issue or publication as a patent, see *Do Florez v. Reynolds* (1880), 17 O. G. 503; 17 Blatch. 436; 8 Fed. Rep. 434; 5 Bann. & A. 140; *Weston v. White* (1876), 13 Blatch. 364; 9 O. G. 1196; 2 Bann. & A. 321.

That an English "complete specification" gives the same protection as if the patent were already issued, see *Emerson v. Lippert* (1887), 31 Fed. Rep. 911; 42 O. G. 964.

That the foreign patent limits the domestic whether it be open or secret, see *Gramme Electrical Co. v. Arnoux & Hochhausen Electric Co.* (1883), 17 Fed. Rep. 838; 21 Blatch. 450; 25 O. G. 193.

That no English patent is complete until the final specification is enrolled, see *Coburn v. Schroeder* (1882), 22 O. G. 419; 20 Blatch. 392; 11 Fed. Rep. 425; *Lorillard v. Dohan* (1881), 20 O. G. 1587; 20 Blatch. 63; 9 Fed. Rep. 509; *Bell v. Brooks* (1881), 19 O. G. 290; *Ex parte Mann* (1880), 17 O. G. 330; *American Diamond Rock Boring Mach. Co. v. Sheldon* (1879), 17 Blatch. 303; *Chambers v. Duncan* (1876), 10 O. G. 787; *Chambers v. Duncan* (1876), 9 O. G. 741.

That an English provisional specification is not a patent, see *Emerson v. Lippert* (1887), 42 O. G. 964; 31 Fed. Rep. 911.

That a domestic patent is not limited by an English patent unless the latter is sealed before the former is issued, whatever date the latter may bear, or unless

a complete specification, having the effect of a patent, is filed, see *Emerson v. Lippert* (1887), 42 O. G. 964; 31 Fed. Rep. 911.

That under the act of 1861 when the domestic patent was applied for before the English provisional specification was filed, and was dated before the English patent was sealed (though the latter was dated earlier than the American patent), the term of the American patent was not limited by the English, see *Gold & Stock Telegraph Co. v. Commercial Telegram Co.* (1885), 23 Blatch. 199; 23 Fed. Rep. 340; 31 O. G. 1558.

That a Canadian patent takes effect when signed, sealed, and registered, not from its delivery, see *Bate Refrigerating Co. v. Gillett* (1882), 22 O. G. 1205; 13 Fed. Rep. 553.

That a Canadian patent takes effect from its date, though withheld from delivery on account of non-fulfilment of conditions, see *Bate Refrigerating Co. v. Gillett* (1887), 31 Fed. Rep. 809; 40 O. G. 1029.

<sup>3</sup> That the rule limiting the term of an American patent by that of a foreign patent does not apply to cases where the American patent was applied for before the issue of the foreign patent, see *Ex parte Mann* (1880), 17 O. G. 330; *French v. Rogers* (1851), 1 Fisher, 133.

That when a foreign patent is granted on the day the application is filed in the United States, it does not limit the American patent, see *Ex parte Mann* (1880), 17 O. G. 330.

<sup>4</sup> In *Gramme Electrical Co. v. Arnoux & Hochhausen Electric Co.* (1883), 17

granted on the same day, the domestic patent is regarded as the older, and its term is unaffected by that of the foreign patent.<sup>5</sup>

§ 624. **Term of Patent Privilege: How Limited by Foreign Patents.**

The term to which the American patent is thus restricted is the term of the original foreign patent.<sup>1</sup> Where the laws

Fed. Rep. 838, Blatchford, J.: (840)

“The meaning of section 25 of the act of 1870 is that the United States patent shall expire at the same time with the foreign patent having the shortest time to run, which was granted before the United States patent was granted, and not that it shall expire at the same time with the foreign patent having the shortest time to run, which was granted before the time when the application for the United States patent was made.” 21 Blatch. 450 (452); 25 O. G. 193 (194).

See also *Bate Refrigerating Co. v. Gillett* (1882), 13 Fed. Rep. 553; 22 O. G. 1205.

That the term of a domestic patent will be limited by that of a foreign patent granted pending the application for the domestic patent, see *Bate Refrigerating Co. v. Gillett* (1887), 31 Fed. Rep. 809; 40 O. G. 1029.

That where a foreign patent is applied for after the application for a domestic patent, but is granted before the issue of the domestic, it will still limit the duration of the latter, see *Gramme Electrical Co. v. Arnoux & Hochhausen Electric Co.* (1883), 21 Blatch. 450; 25 O. G. 193; 17 Fed. Rep. 838.

That the term of an American patent will be limited by that of a prior foreign patent, though the American application had been filed and the invention put in use in the United States before the foreign application was made, see *Edison Electric Light Co. v. U. S. Electric Lighting Co.* (1888), 43 O. G. 1456.

That where an application in the United States antedates an application in England, and the American patent issues before the English patent is sealed, or a complete specification is filed, the latter has no effect on the term of the former, see *Emerson v. Lippert* (1887), 42 O. G. 964; 31 Fed. Rep. 911.

<sup>5</sup> That where domestic and foreign patents are granted, or applications are filed, on the same day, the foreign are not prior to the domestic, see *Ex parte Mann* (1880), 17 O. G. 380.

§ 624. <sup>1</sup> That the term of the American patent should be fixed by ascertaining how long the foreign patent, as originally granted, was to run after the issue of the domestic, see *Paillard v. Bruno* (1886), 38 O. G. 900; 29 Fed. Rep. 864; *Ex parte Siemens* (1877), 11 O. G. 969.

That the term of a foreign patent, so far as it affects that of a domestic patent, is the term for which it is originally granted, whether it be extended or not, or forfeited for non-payment of periodical fees or not, or increased in statutory duration by subsequent legislative action, see *Bate Refrigerating Co. v. Gillett* (1887), 31 Fed. Rep. 809; 40 O. G. 1029.

That if a foreign patent, limiting the term of a domestic patent, is vacated *ab initio*, the domestic patent is not limited thereby, see *Bate Refrigerating Co. v. Gillett* (1887), 31 Fed. Rep. 809; 40 O. G. 1029.



of the country in which it was issued permit of its extension, this capability of extension forms no part of the grant. Its actual term as specified in the original letters-patent measures the life of the domestic patent, and its extension, if it be extended, does not prolong the monopoly in the United States.<sup>2</sup> The same rule prevails where an original patent may be enlarged by new grants as the inventor makes improvements to the original invention, thereby extending indirectly the term of the original. Each of these new grants or additions is considered as a different patent, having its own date of issue and its own term, and thus does not remove the limitation placed by the original patent on the term of the American.<sup>3</sup> Nor on the other hand does the premature expiration of the foreign patent, on account of the failure of the patentee to comply with the conditions essential to the completion of its granted term, extinguish the American patent, nor curtail the term fixed for it by the foreign patent at the date when it was issued.<sup>4</sup>

**§ 625. Term of Patent Privilege: How Calculated when not Limited by Foreign Patents.**

In calculating the term of a patent whose duration is not affected by that of a prior foreign patent, the day of its date

<sup>2</sup> That the capacity of extension is not part of a grant, and a foreign patent measures the domestic by its granted term, not by its possibilities of extension, see *Gramme Electrical Co. v. Arnoux & Hochhausen Electric Co.* (1883), 17 Fed. Rep. 838; 21 Blatch. 450; 25 O. G. 193.

That the extension of a foreign patent does not affect the American, see *Paillard v. Bruno* (1886), 38 O. G. 900; 29 Fed. Rep. 864; *Bate Refrigerating Co. v. Gillett* (1882), 13 Fed. Rep. 553; 22 O. G. 1205; *Reissner v. Sharp* (1879), 16 O. G. 356; 16 Blatch. 383; 4 Bann. & A. 366; *Henry v. Providence Tool Co.* (1878), 14 O. G. 855; 3 Bann. & A. 501.

<sup>3</sup> That under the French law each "addition" stands by itself like a new patent, and by its own date fixes the term

of a subsequent American patent, see *De Florez v. Reynolds* (1880), 17 Blatch. 436; 17 O. G. 503; 8 Fed. Rep. 434; 5 Bann. & A. 140.

<sup>4</sup> That the forfeiture of the foreign patent by the non-fulfilment of conditions does not affect the duration of the American patent, see *Paillard v. Bruno* (1886), 38 O. G. 900; 29 Fed. Rep. 864.

That under Sec. 4887 the term of a domestic patent is to be equal to the remainder of the term for which the foreign patent was granted, although the latter has been forfeited by not paying a tax or by other subsequent events, see *Holmes Electric Protective Co. v. Metropolitan Burglar Alarm Co.* (1884), 21 Fed. Rep. 458; 22 Blatch. 471; 28 O. G. 1189.

is excluded, and it will expire on the last hour of the same day and month, seventeen years after its issue.<sup>1</sup> Its term is unrestricted by that of any other patents, although the invention described in one patent may be so far dependent on those protected by others as to be incapable of use without them, and thus the public may be debarred from the free employment of any until all the patents have expired.<sup>2</sup> The term of a design patent has a different limitation, such patents being granted for three and a half, seven, or fourteen years, as the inventor may elect.

### § 626. Effect of Clerical Errors in Letters-Patent.

Mere clerical errors in the language of a patent do not affect its validity nor imperil the rights of the patentee. A mistake in his Christian name, or of a single letter in his surname, is of no consequence if he is otherwise sufficiently described; and the same liberal construction prevails in reference to other immaterial defects.<sup>1</sup> Where such mistakes occur through the fault of the Patent Office, they are corrected on the record at the request of the patentee. Errors upon material points must be cured by an amendment of the patent by a re-issue or disclaimer.

§ 625. <sup>1</sup> That a patent expires on the last hour of the same month and day, seventeen years after its issue, see *Johnson v. McCullough* (1870), 4 Fisher, 170.

<sup>2</sup> That separate patents for different inventions, having separate dates, will each expire at the end of its own term, though neither invention is capable of use without the others, see *McKay v. Dibert* (1881), 19 O. G. 1351; 5 Fed. Rep. 587.

But see *McKay v. Jackman* (1882), 20 Blatch. 466; 22 O. G. 85; 12 Fed. Rep. 615.

That where a patent having been issued with its term limited by that of a foreign patent is not accepted by the patentee, and a new patent is then

granted for seventeen years, the new patent will run from the date of its issue, not from that of the former patent, see *Railway Register Mfg. Co. v. North Hudson C. R. Co.* (1885), 23 Fed. Rep. 593; 32 O. G. 519.

§ 626. <sup>1</sup> That a mistake in the Christian name of the patentee does not affect the patent, if he is otherwise sufficiently pointed out, see *Northwestern Fire Extinguisher Co. v. Philadelphia Fire Extinguisher Co.* (1874), 1 Bann. & A. 177; 6 O. G. 34; 10 Phila. 227.

That one erroneous letter in the name of the patentee may be of no consequence, see *Bignall v. Harvey* (1880), 18 O. G. 1275; 4 Fed. Rep. 334; 18 Blatch. 353.



§ 627. Recording of Letters-Patent: Copies of the Records.

All letters-patent are recorded, with their specifications, in books kept for that purpose in the Patent Office.<sup>1</sup> The record of a patent, like that of every other instrument which the law requires to be recorded, is constructive notice of its contents to all parties subsequently becoming interested in the invention, and is binding throughout the world.<sup>2</sup> After the patent is recorded, its record, with its specifications, drawings, model, and all other documents relating to the case, are open to general inspection in the Patent Office. No private individual is permitted to make copies or tracings from the files and records of the Office; but certified copies may be obtained by any one who civilly requests them, upon payment of the lawful fees.<sup>3</sup> These copies have the same weight, as evidence in any controversy in the courts or Patent Office, as would be given to the originals themselves.<sup>4</sup>

§ 628. Patented Articles to be Stamped.

The law requires that every patentee and his assigns and legal representatives, and all other persons making or vend-

§ 627. <sup>1</sup> That the grant of a patent is not complete, nor does any title pass, until it is recorded, see *Ex parte Osgood* (1885), 33 O. G. 1265.

That a title by the grant of letters-patent is a title of record, and no delivery is necessary to make it good, see *Ex parte Osgood* (1885), 33 O. G. 1265.

<sup>2</sup> That the record of a patent and its title is notice to all the world, see *National Car Brake Shoe Co. v. Terre Haute Car & Mfg. Co.* (1884), 19 Fed. Rep. 514; 28 O. G. 1007.

That the record of an instrument, which the law does not require to be recorded, is no notice of anything to any person, see *Hamilton v. Kingsbury* (1879), 17 Blatch. 264; 17 O. G. 147.

That where some papers not required to be recorded are recorded and others are not, a person who acts upon those recorded in ignorance of the others is bound by the latter as if they were

known, see *Hamilton v. Kingsbury* (1879), 17 Blatch. 264; 17 O. G. 147.

See also § 785 and notes, *post*.

<sup>3</sup> In *Boyden v. Burke* (1352), 14 How. 575, Grier, J.: (583) "These records being in the care and custody of the Commissioner of Patents, it is his duty to give authenticated copies to any person who shall demand the same, as soon as he conveniently can, on payment of the legal fees. Where there is a right on the one side, and a corresponding duty imposed on the other, a refusal to perform such duty, on the reasonable request of the party entitled to demand it, will subject the officer to an action."

<sup>4</sup> That copies of the records in the Patent Office are evidence, see *Brooks v. Jenkins* (1844), 3 McLean, 432. See also §§ 1015-1017, and notes, *post*.

That an incorrect transcript from the Patent Office may be corrected by a new transcript, see *Brooks v. Jenkins* (1844), 3 McLean, 432.

ing any patented article for or under them, shall give sufficient notice to the public that such article is patented.<sup>1</sup> This notice may be given by marking the article itself with the word "patented," together with the date of the patent, or where this is impracticable by affixing to the article, or to the package in which it is enclosed for the market, a label containing the same word and date.<sup>2</sup> A failure to comply with this requirement prevents the owner of the patent, in any suit for its infringement, from recovering other than nominal damages against the defendant,<sup>3</sup> unless he can affirmatively prove that in some manner practically equivalent to this the defendant has received notice that his acts were an infringement of the patent, and after such notice has continued in his violation of the plaintiff's rights.<sup>4</sup>

§ 628. <sup>1</sup> That the duty of marking patented articles as "patented" devolves upon the manufacturer, see *Wilson v. Singer Mfg. Co.* (1879), 9 Bissell, 173 ; 4 Bann. & A. 637 ; 16 O. G. 1091.

That the object of the statute requiring patented articles to be stamped is to secure the public right to use unpatented articles, and prevent imposition under the claim that the articles have been patented, see *Nichols v. Newell* (1853), 1 Fisher, 647.

That this statute is to be strictly construed, see *Wilson v. Singer Mfg. Co.* (1879), 9 Bissell, 173 ; 4 Bann. & A. 637 ; 16 O. G. 1091 ; *United States v. Morris* (1866), 2 Bond, 23 ; 3 Fisher, 72.

<sup>2</sup> That where the mark cannot be put on the article itself it may be placed on the package, see *Sessions v. Romadka* (1884), 28 O. G. 721 ; 21 Fed. Rep. 124.

<sup>3</sup> That unless the evidence shows that the statute has been complied with only nominal damages can be recovered for infringements, see *McComb v. Brodie* (1871), 1 Woods, 153 ; 5 Fisher, 384 ; 2 O. G. 117.

That this statute applies to suits in equity as well as at law, see *New York*

*Pharmical Association v. Tilden* (1882), 21 Blatch. 190 ; 23 O. G. 272 ; 14 Fed. Rep. 740.

That the failure to stamp prevents recovery of damages, but is no bar to an injunction either preliminary or perpetual, see *Goodyear v. Allyn* (1868), 3 Fisher, 374 ; 6 Blatch. 38.

That Sec. 13, act March 2, 1861, does not require that the plaintiff's bill in equity aver that his articles were stamped, see *Goodyear v. Allyn* (1868), 3 Fisher, 374 ; 6 Blatch. 33.

That to prevent a recovery of actual damages by reason of Sec. 13, act March 2, 1861, it must appear either from the bill or the proofs that the patentee has made or sold articles under the patent, see *Goodyear v. Allyn* (1868), 3 Fisher, 374 ; 6 Blatch. 33.

<sup>4</sup> In *New York Pharmal Association v. Tilden* (1882), 14 Fed. Rep. 740, Wallace, J. : (741) "Patentees are therefore required to give 'sufficient notice to the public' that the article is patented, . . . 'together with the day and year the patent was granted,' by stamping or labelling the article. It is a fair interpretation to hold that when any equivalent notice has been given, the defendant has been 'duly notified.' As



### § 629. Stamping Patented Articles by Infringers Prohibited.

As the complement of the foregoing rule, the law forbids any person, other than the patentee and those who claim or practise the invention under the protection of the patent, to mark on any article made, used, or sold by him the name or imitation of the name of its true patentee, without obtaining his consent or that of his assigns or legal representatives. It also prohibits every one, except with the consent of the true patentee or his assigns or legal representatives, from marking any patented article with the words "patented," "patentee," or "letters-patent," or any word of similar import, with intent to imitate or counterfeit the mark of the real owner of the patent.<sup>1</sup> The object of the first provision

the sufficient notice prescribed includes a specification of the time when the patent was granted, it is reasonable to conclude that any notice, verbal or written, that includes this information, will suffice." 23 O. G. 272 (272); 21 Blatch. 190 (191).

That notice otherwise given is equivalent to a mark on the articles themselves, in its effect on the right to substantial damages, see *McComb v. Brodie* (1871), 1 Woods, 153; 5 Fisher, 384; 2 O. G. 117.

That under Sec. 4900 no recovery of substantial damages can be had while articles were unstamped unless notice is given or knowledge is possessed by the infringer, and even then he is liable to pay substantial damages only for infringements committed with knowledge or after notice, see *Allen v. Deacon* (1884), 21 Fed. Rep. 122; 10 Sawyer, 210.

§ 629. <sup>1</sup> In *Washburn & Moen Mfg. Co. v. Haish* (1879), 9 Bissell, 141, Blodgett, J. : (142) "I am very clear that the defendant has no right, upon the admitted facts in the case, to mark his goods with any words or terms indicating that they are manufactured under complainant's patent. He has the right, and it is his duty, to mark

his goods with his own patent-mark; but this does not give him the right to put upon the goods any *indicia* showing that they are made under another man's patent or a patent which he does not own and has no right to use. Several reasons occur to me why he should not be allowed to do this. In the first place, the owner of a patent has the right to regulate the quality of goods bearing the patent-mark. The value of a patent to its owner may largely depend upon the quality of goods manufactured under it. By manufacturing and selling a poor article purporting to be made under complainant's patent the value of the patent itself may be seriously impaired and the complainant damaged. In the second place, the public would be imposed upon and led to believe that they were purchasing a genuine article made by the patentee or under his patent. This reason applies the more forcibly because the law makes it the duty of a patentee, or those manufacturing goods under a patent, to mark his goods with the word 'patented,' with the date of the patent; and persons purchasing such goods with the belief that they were made and vended by the patentee, or those acting under his license, might be liable for an

of the statute is to protect the patentee and his assignees or licensees against the fraudulent and tortious imitation of his name upon an article apparently made under the monopoly created by his patent. The object of the second is to protect them against the intentional proximate representation of their patent-mark by an infringer. These wrongful acts tend to depreciate the value of the patent by casting doubts upon the scope of the invention, or by enabling the infringer to throw on the market inferior articles under the patent-mark, and thereby destroy the confidence of the public in the utility of the invention. The law cannot permit its own requirement of the patentee to be thus turned into a weapon against him, and hence attaches to these acts a penalty distinct from that which the wrong-doer would incur by a mere infringement.

### § 630. Stamping Unpatented Articles Prohibited.

A third provision of the statute forbids the marking or affixing to any unpatented article the word "patent," or any word importing that the same is patented, for the purpose of deceiving the public. The object of this provision is to prevent fraudulent impositions upon the community at large.<sup>1</sup> The fact that an article is patented is an indication to the public of its merit, and tends to promote its sale and use; and the unauthorized mark is thus a false pretence by which the purchaser is liable to be deceived. The marking of an article is also a notice to the public that its manufacture, use, and sale are under the protection of a patent, and cannot be engaged in without the license of the patentee; and if this notice be untrue, the public are fraudulently restricted in the enjoyment of their natural rights. Fraud being thus the gist of the offence forbidden, the penalty is not incurred unless the marking is performed with the intention to deceive.<sup>2</sup> To

action of infringement by the owner of the patent; and, thirdly, such an act is a direct violation of the property interest which the law vests in the owner of a patent." 4 Bann. & A. 571 (572); 18 O. G. 465 (465).

§ 630. <sup>1</sup> That the law forbidding the marking of unpatented articles as "pat-

ented" was intended to prevent fraud, see *Wilson v. Singer Mfg. Co.* (1879), 9 Bissell, 173; 4 Bann. & A. 637; 16 O. G. 1091.

<sup>2</sup> In *Walker v. Hawxhurst* (1867), 5 Blatch. 494, Nelson, J.: (495) "The counsel for the plaintiff requested the Court to charge that if the jury be-



mark in joke, or in evident derision, or in the belief that the article comes within the scope of a patent, does not constitute the crime. But where the intent to deceive exists, it is immaterial whether the article is patentable or not, or whether a patent has been applied for and is expected to issue, or how the mark is made and attached to the article, or whether the article is ever sold or offered for sale in the market.<sup>3</sup> Where

lied that the defendant intended the public to understand, by the words and figures he caused to be put on the article, that he had got a patent for it, he was liable for the penalty. The Court refused so to charge, but charged that if the defendant used the marks, knowing he had no right to, and with the intention of deceiving the public, then he was liable; but if he used them, supposing he had a right to, and with no intention to deceive the public, then he was not liable. I am of opinion that the Court did not err in refusing to charge as requested by the counsel. The request leaves out altogether the element of fraud and deceit, which is clearly, and even in terms, made essential to bring a party within the penalties of the statute. According to the interpretation of the counsel, the simple act of marking the article, indicating that it was patented when it was not, would be sufficient, because of necessity the party must mean and intend that the public should understand what he has thus explicitly expressed. But this is not the statute. The marking must not only give the public to understand the fact of a patent, but the act must be done *malo animo*, with an intent to deceive; and this ingredient of the offence, which is essential to make it complete, must be left to and be found by the jury. The Court, therefore, was right in submitting it to them."

See also *Nichols v. Newell* (1853), 1 Fisher, 647.

That an "intent to deceive" is an intent to make the public believe that

the article is covered by a patent, and this intent exists where the party stamps an article without knowing or caring whether or not it is patented, and without an affirmative belief that it is patented, see *Tompkins v. Butterfield* (1885), 25 Fed. Rep. 556; 33 O. G. 758.

That a corporation may violate this act through its officers, see *Tompkins v. Butterfield* (1885), 25 Fed. Rep. 556; 33 O. G. 758.

That where a defendant is proved to have falsely stamped articles with intent to deceive the public, he is guilty of the offence, and no other matter is pertinent, see *Kass v. Hawlowitz* (1885), 33 O. G. 1135.

<sup>3</sup> In *Oliphant v. Salem Flouring Mills Co.* (1878), 5 Sawyer, 128, Deady, J. : (129) "The first two clauses of this section are evidently intended to protect the patentee of a patented article against the fraudulent use of his name or device upon a spurious article, and it is equally manifest that the third clause is intended to protect the public against the fraudulent use of the word 'patent.' What art, machine, composition, process, or result may be patented, is largely a question of fact, which in most cases lies beyond the knowledge or observation of the mass of mankind, the public. To say whether an article is both novel and useful, has 'a sufficiency of invention' to entitle it to be patented, is often a difficult question, and one which in most cases requires the skill and research of experts to determine. It may be useful but not new, or the re-

this intent is wanting, an article manufactured under an ex-

verse, and in neither case is it patentable. But the word 'patent' upon an article is *prima facie* an assertion that it has some peculiar value or merit sufficient to induce the government, upon a thorough examination of the subject, to give the inventor the exclusive right to make and vend the same. The impression which the fact ordinarily makes upon the mind is that the article marked 'patent' is in some respects more useful or desirable than articles of the same general kind or use which are not so marked. If, then, a person marks an unpatented article with the word 'patent,' the public are thereby liable to be deceived as to the character and value of the article. The act is a species of counterfeiting. This being so, the presumption is, until the contrary appears, that the mark was placed on the article with the intention to deceive. The falsehood is a badge of fraud. To my mind it is clear, both upon the reason of the thing and the plain words of the statute, that the penalty is incurred by marking an unpatented article with the word 'patent,' whether the same is patentable or not. The statute is made for the protection of the public, and is intended to prevent unscrupulous persons from imposing upon the community by the unauthorized and false use of the word 'patent.' But it must also appear that the article was so falsely marked with intent to deceive the public. Cases may arise in which it is apparent that the marking was done on unpatented articles in jest or ridicule, or as a mere fancy or caprice under such circumstances that it is not possible that any one could be misled or deceived by it. A person might mark his dog or horse with the word 'patent,' but hardly with the intention to make the public believe that either was of any more use or value than any other

like animal. And in such an extreme case the Court might be able to say, on demurrer to the complaint, that there could not by any possibility have been any intention to deceive. But in all ordinary cases, or cases in which there can be any doubt about it, the question of fraudulent intent or purpose to deceive is one for the jury. In passing upon it, the probability or improbability of the public being deceived by the alleged false marking will be taken into consideration by them." 8 Bann. & A. 256 (257).

In *Nichols v. Newell* (1853), 1 Fisher, 647, Sprague, J. : (659) "If there was a purpose, at the time these words were affixed, to deceive the public, although the party may have expected a patent shortly, or within any time (if in the mean time they intended to put forth the articles and thereby deceive the public), then the offence would be committed. If they intended to deceive the public for a short time, and believed that they should then have their patent, still the offence is committed, because the statute forbids deceiving the public at any time."

That to mark "patented" on articles evidently not patentable and which cannot deceive the public is not an offence, see *U. S. v. Morris* (1866), 2 Bond, 23 ; 3 Fisher, 72.

That the marking is an offence, though no sales result, see *Nichols v. Newell* (1853), 1 Fisher, 647.

That the offence is committed by marking falsely, not by carrying the marked articles into another district with intent to sell, see *Pentlarge v. Kirby* (1884), 19 Fed. Rep. 501.

That the offence is committed however the mark may be put on, see *Nichols v. Newell* (1853), 1 Fisher, 647.



pected patent, or one formerly protected by a patent which has now expired, may lawfully bear this inscription.<sup>4</sup>

§ 631. Procedure and Penalty for Falsely Stamping Infringing or Unpatented Articles.

The statute embracing these provisions is penal in its nature, and must be strictly construed.<sup>1</sup> The punishment for its violation is a fine of one hundred dollars and costs,<sup>2</sup> to be recovered by any person in a *qui tam* action brought to the District Court of the United States within whose jurisdiction the offence may have been committed.<sup>3</sup> The person falsely

<sup>4</sup> That articles may be marked "patented" when a patent is expected, if there is no intent to deceive, see *Nichols v. Newell* (1853), 1 Fisher, 647.

That articles are patented and may be so marked, although the patent has expired, if the date of the patent is included in the mark, see *Wilson v. Singer Mfg. Co.* (1882), 11 Bissell, 298; 12 Fed. Rep. 57; *Wilson v. Singer Mfg. Co.* (1879), 9 Bissell, 173; 4 Bann. & A. 637; 16 O. G. 1091.

That a patentee has no right to mark his articles "patented," after the patent expires, under Sec. 4900, Rev. Stat., the act of marking showing an intent to deceive, see *N. Y. Consolidated Card Co. v. Union Playing Card Co.* (1886), 39 Hun, 611.

§ 631. <sup>1</sup> That the statute against false marking must be strictly construed, see *Pentlarge v. Kirby* (1884), 19 Fed. Rep. 501; *United States v. Morris* (1866), 2 Bond, 23; 3 Fisher, 72.

<sup>2</sup> That the penalty must be exactly one hundred dollars, see *Stimpson v. Pond* (1855), 2 Curtis, 502.

That the full penalty may be imposed for each article falsely stamped and sold, see *Tompkins v. Butterfield* (1885), 25 Fed. Rep. 556; 33 O. G. 758.

<sup>3</sup> That any person may maintain a *qui tam* action on this statute, see *Kass*

*v. Hawlowetz* (1885), 33 O. G. 1135; *Winne v. Snow* (1884), 19 Fed. Rep. 507.

That the suit must be brought in the name of the informer, not of the United States, see *United States v. Morris* (1866), 3 Fisher, 72; 2 Bond, 23.

That a suit for false stamping under Sec. 4901 can be maintained only in the district where the stamping was done, and not where the stamped goods were sold, see *Pentlarge v. Kirby* (1884), 19 Fed. Rep. 501; *Winne v. Snow* (1884), 19 Fed. Rep. 507.

That a corporation is liable for the act of its superintendent in wrongfully stamping if he knew or should have known that the article was not patented, but not if he was ignorant and acted in good faith, see *Tompkins v. Butterfield* (1885), 25 Fed. Rep. 556; 33 O. G. 758.

That acts of employees in false stamping are acts of the principal, see *Kass v. Hawlowetz* (1885), 33 O. G. 1135.

That in a suit for false stamping in New York the plaintiff need not allege the tort as committed on a certain day, but "on or about the month of" is sufficient, see *Fish v. Manning* (1887), 31 Fed. Rep. 340.

That in a suit for falsely stamping

marking articles as protected by a given patent may be thereby estopped to deny its validity.<sup>4</sup>

§ 632. Failure of Alien Inventor to put his Invention into Market in the United States.

Under the act of 1836 it was the duty of an alien inventor and patentee to put his patented invention into the market in this country within eighteen months after the issue of the patent. To put his invention into the market consisted in offering it for sale at a reasonable price; and his failure to do

an article with the name or patent-mark of the true patentee in New York the declaration must point out the section of the statute sued on, and must allege that the defendant had no patent, that his device contained the patented improvement, and that it was stamped without consent of the patentee or his assigns or representatives, see *Fish v. Manning* (1887), 31 Fed. Rep. 340.

That in a suit for false stamping by a foreign corporation in New York, service upon the person who has general control of the business in which the stamping is done, is on the "managing agent" and is sufficient, see *Hat-Sweat Mfg. Co. v. Davis Sewing Mach. Co.* (1887), 31 Fed. Rep. 294.

That in a suit for false stamping the question of the identity of the stamped device with the patented invention is a question of law, where the want of identity is evident from the patent itself, see *Tompkins v. Butterfield* (1885), 33 O. G. 758; 25 Fed. Rep. 556; *Hawlowetz v. Kass* (1885), 33 O. G. 1499; 23 Blatch. 395; 25 Fed. Rep. 765.

That whether a stamped article, which is not covered by any patent before the court, is patented or not is a question for the jury, see *Kass v. Hawlowetz* (1885), 33 O. G. 1135.

That in a suit for a penalty for false stamping, under Sec. 4901, if the defendant has a patent which he claims covers the articles, the court should de-

termine the scope and effect of the patent, see *Hawlowetz v. Kass* (1885), 23 Blatch. 395; 33 O. G. 1499; 25 Fed. Rep. 765.

That the charge of false stamping must be proved beyond reasonable doubt, see *Tompkins v. Butterfield* (1885), 25 Fed. Rep. 556; 33 O. G. 758.

That in a suit for false stamping the plaintiff is not bound to prove his case as fully as under an indictment, see *Hawlowetz v. Kass* (1885), 23 Blatch. 395; 33 O. G. 1499; 25 Fed. Rep. 765.

That in a suit for stamping with intent to deceive the plaintiff need not prove that the stamped articles are patentable, it being for the defence to show that they are not patentable and that the public could not be deceived, see *Winne v. Snow* (1884), 19 Fed. Rep. 507.

That in a suit for infringement the defendant cannot show that he has not stamped the infringing device as patented, especially if he does not set it up in his answer, see *Herring v. Gage* (1878), 15 Blatch. 124.

<sup>4</sup> That a person marking articles "patented," under a patent to which he has no right, cannot dispute the validity of such patent, on a motion to enjoin him from falsely stamping, see *Washburn & Moen Mfg. Co. v. Haish* (1879), 9 Bissell, 141; 4 Bann. & A. 571; 18 O. G. 465.



this within the time prescribed forfeited his right to recover for an infringement of the patent.<sup>1</sup> This requirement did not extend to the native assignees of an alien patentee, and was removed even from the latter by the act of 1870.<sup>2</sup> At present no obligation rests upon any patentee to develop his invention or to bring it into practical use.<sup>3</sup>

§ 632. <sup>1</sup> That "to put into market," under this statute, is to be willing to sell at reasonable prices, see *Tatham v. Lowber* (1847), 2 Blatch. 49.

<sup>2</sup> That this provision did not apply to native assignees of alien inventors, see *Tatham v. Lowber* (1847), 2 Blatch. 49.

<sup>3</sup> See § 31 and note, *ante*.

## CHAPTER II.

## OF THE AMENDMENT OF LETTERS-PATENT.

**§ 633. Patentee Bound by the Language of his Patent as Construed by the Courts, whether or not his Actual Invention is thereby Adequately Protected.**

AN inventor who has complied with all the provisions of the law on his part is entitled to the complete protection of his invention. The protection actually afforded by his patent, however, is limited and defined by the language it employs for describing and claiming the invention, as such language is interpreted by the courts. From many causes it may happen that the patent, thus construed, fails to cover the invention really made and intended to be patented; and the inventor, being concluded by his patent, is in this manner, therefore, liable to be defeated in the endeavor to secure his rights. In the early history of Patent Law no method existed by which this evil could be remedied. Whatever might be the character or merit of the invention, the patentee must take his letters-patent as they were granted to him; and if they were inaccurate or incomplete the consequences of these defects were inevitable and must be endured. He was regarded as responsible for all discrepancies between the language of the patent and the invention it pretended to describe. If it attempted, in the opinion of the courts, to cover more than the true invention, it was considered as a fraud upon the public, inasmuch as it deprived them of the right to use what was already known. If it departed from the essential characteristics of the invention, it was condemned as a fraudulent concealment from the public of such information as the patentee was bound to disclose. Thus, whether it described and claimed too much, or described and claimed too little, or



incorrectly stated what it did describe and claim, it was alike void and the patentee was left without redress.<sup>1</sup>

**§ 634. Power to Amend the Defective Language of a Patent Necessary to the Protection of the Patentee.**

With the amelioration of public sentiment toward inventors these burdens have been substantially removed. The custom of correcting defective patents by their surrender and the issue of amended patents was early established in this country, and received the sanction and approbation of the courts.<sup>1</sup> This practice has been formally adopted by the acts of Congress and made a permanent feature of our Patent Law.<sup>2</sup> Other statutes have provided simpler methods by which a mere redundancy of description or an excess of claim may be eliminated from the patent, while errors and mistakes which do not qualify the rights conferred by the patent are either wholly disregarded by the courts or may be amended by the Patent Office at the request of the inventor.

**§ 635. The Power to Amend the Defective Language of a Patent does not Include the Power to Change the Nature of the Patented Invention or the Person of the Patentee.**

The concession to the inventor of this power to amend his patent has not, however, in any degree obliterated the distinction between a new patent and an amended patent. By no process of emendation can the grant of an exclusive privilege to one person for one invention be transformed into the grant of an exclusive privilege to a different person or for a different invention. A patent is the bestowal of the right to a specific art or instrument upon a specific patentee, and through all the variations which its language may assume its identity as a patent must remain unchanged.<sup>1</sup> The scope of the

§ 633. <sup>1</sup> See §§ 14, 15, and notes, *ante*.

§ 634. <sup>1</sup> See *Grant v. Raymond* (1832), 6 Pet. 218; 1 Robb, 604.

<sup>2</sup> Act of 1832, § 3.

§ 635. <sup>1</sup> Nearly all the difficulties which have attended the subject of Re-issue might have been avoided by a

proper recognition of the principle here stated. A patent is the grant of a monopoly in an invention. This monopoly cannot be conferred except in an invention completely existing at the time of the grant, and upon an application for a patent for that invention by the inventor or his representatives; and

amending power is limited to such alterations of description and assertion as do not affect the essential character of the invention or the person of the patentee. For a mistake in these the only remedy is by the issue of a new original patent upon an independent application.

§ 636. **Defects and Modes of Amendment, each of Three Classes.**

Defects which fall within the scope of the amending power may be divided into three classes, as indicated by the methods now provided for their removal: (1) Clerical errors; (2) Errors consisting in an excess of claim; and (3) Errors of any kind, whether by excess or deficiency or misstatement, in any matter relating to the substance of the grant. The third

when conferred it is limited in scope to the invention for which the patent has been sought. Here are three inexorable rules which cannot be affected by the concession of the amending power: (1) That the invention must have existed at the issue of the original patent, clearly perceived as well as conceived by the inventor, and fully reduced to practice; (2) That in his application for the original patent the inventor must have attempted to describe and claim every attribute of the invention which he desired to bring within the monopoly created by that patent; (3) That the monopoly created by that patent must thenceforth be regarded as commensurate with the invention which the inventor then endeavored to protect, and if the language of the patent, either through deficiency or excess of statement, fails to correspond with the monopoly as thus created, amendments for the purpose of curing this defect must be permitted until the language of the patent and the scope of the monopoly exactly correspond. The first rule precludes the introduction into the amended patent of any patentable matter which was not clearly in the mind of the inventor or had not been reduced to practice at the date of the

original patent. The second rule forbids the insertion of any matter which the patentee did not endeavor to incorporate into the claims of his patent as originally granted, whether his purpose was to abandon the unclaimed matter to the public, or to reserve it for a future application. The third rule at once compels him and entitles him to change the terms in which his original patent describes and claims the invention it attempted to protect, whenever he discovers that its present language is inadequate. These rules are recognized in many cases, especially in *Parker & Whipple Co. v. Yale Clock Co.* (1887), 123 U. S. 87; 41 O. G. 811; *Powder Co. v. Powder Works* (1878), 98 U. S. 126; 15 O. G. 289; etc., where it is held that a re-issue is valid whenever it is confined to the invention which the inventor intended to describe and claim in the original patent, unless meanwhile he has abandoned it to the public. The application of these rules in the Patent Office and in the courts in a few of the earlier cases would have simplified the whole matter, and probably have saved numerous and expensive contests in which the subject of amending patents seems only to become more difficult and obscure.



class includes the second, so far as the nature of the defects are concerned; but the second has a peculiar remedy in addition to that by which the other errors of the third class are corrected. Defects of the first class are amended by the action of the Patent Office at the suggestion of the patentee. Defects of the second class may be cured by Disclaimer. Defects of the third class are removed by a Re-issue. Each of these remedies, with the method of applying them, will now be examined.

### SECTION I.

#### OF THE AMENDMENT OF LETTERS-PATENT: CLERICAL ERRORS.

##### § 637. Clerical Errors Defined: How Corrected.

Under the head of clerical errors may be embraced all the mistakes in the patent which do not affect the substance of the grant, and which occur through the fault of the employees of the Patent Office.<sup>1</sup> Upon his discovery of any such mistake after the delivery of the patent, the patentee or his assignee may make an application to the Commissioner for its correction, and if the error is clearly disclosed by the files or records of the Office, a certificate showing the fact and nature of the mistake will be signed by the Secretary of the Interior, countersigned by the Commissioner, sealed with the seal of the Patent Office, endorsed upon the patent, and duly recorded in the records of original patents as a part of that on which it is endorsed.<sup>2</sup> A printed copy of this certificate will also be

§ 637. <sup>1</sup> That an error in the number of a patent is a clerical error, see *Reed v. Street* (1884), 34 O. G. 339.

That a mistake in the Christian name of a patentee does not invalidate the patent, if he is otherwise so described as to be identified, see *Northwestern Fire Extinguisher Co. v. Philadelphia Fire Extinguisher Co.* (1874), 6 O. G. 34; 1 Bann. & A. 177; 10 Phila. 227.

That an error in one letter of the surname of a patentee may be of no consequence, see *Biguall v. Harvey* (1880),

18 O. G. 1275; 4 Fed. Rep. 334; 18 Blatch. 353.

That a mistake of the Patent Office in engrossing the specification is a clerical error, see *In re Johnson's Patent* (1877), L. R. 5 Ch. D. 503.

<sup>2</sup> That clerical errors may be corrected, without surrender and re-issue, by the action of the Patent Office, see *Reed v. Street* (1884), 34 O. G. 339.

That a clerical error in a patent could be corrected, under the act of 1836, only by the Secretary of State,

attached to each printed copy of the specifications and drawings issued from the Office.

**§ 638. Errors of Substance not Corrected as Clerical Errors.**

Errors affecting the substance of the grant cannot be corrected in this summary manner, although occurring through the fault of the employees of the Patent Office. Mistakes whose ordinary remedy is a re-issue can be removed only by that proceeding, from whatever cause they may arise; but when a re-issue becomes necessary through official negligence no fees are charged for its allowance, unless it operates as an amendment of other defects than those for which the Patent Office is responsible.

**§ 639. Correction of Clerical Errors not to affect Intervening Rights.**

The correction of a clerical error relates back to the date of the patent, and the amended instrument is thenceforth regarded as the original form of the grant. But such an amendment cannot affect intervening rights. While the patent remains uncorrected the public may safely act upon it as it stands, and the delay of the patentee in procuring its correction is regarded as an acquiescence in whatever rights or privileges others meanwhile may have lawfully acquired.<sup>1</sup>

SECTION II.

OF THE AMENDMENT OF LETTERS-PATENT: DISCLAIMER.

**§ 640. Disclaimer: Its Twofold Purpose: To Amend Defective Patent: To Save an Otherwise Lost Suit.**

Errors consisting in an excess of claim, whereby the protection of the patent is extended to matters not embraced

though his signature was not necessary, see *Woodworth v. Hall* (1846), 1 W. & M. 389; 2 Robb, 517.

§ 639. <sup>1</sup> That the correction of a clerical error relates back to the date of the error unless intervening rights would be thereby affected, see *Woodworth v. Hall* (1846), 1 W. & M. 389; 2 Robb, 517.

That if the correction be material it can operate only on subsequent cases, see *Woodworth v. Hall* (1846), 1 W. & M. 248; 2 Robb, 495.

That the right to the correction of clerical errors may be lost by delay, see *In re Blamoud's Patent* (1860), 3 L. T. Rep. n. s. 800.



within the actual invention, may be amended by disclaimer. Disclaimer forms the subject of two distinct provisions of the statutes, embraced in different sections and having no direct connection with each other. Section 4917 relates to disclaimer as a method of amending a defective patent. Section 4922 relates to it as a method by which the plaintiff, in a suit for infringement, may avoid the defence that his original patent claimed more than his invention, and in spite of this defect may recover proper damages for the injury he has sustained. Although these two provisions were incorporated into our Patent Law by the same act of Congress, this distinction between their purposes and scope is of great importance, and the failure to observe it has led, in some cases, to serious misunderstanding.<sup>1</sup>

**§ 641. Origin and Nature of Disclaimer as a Method of Amending a Defective Patent.**

A disclaimer, considered as a method of amending a defective patent, is a development of that amending power which formerly could be exercised only by a re-issue. As will hereafter appear, the re-issue of a patent necessitated the surrender of the original patent and the destruction of all rights arising therefrom. It was also a proceeding attended with expense and delay, and required the co-operation of all the owners of the patent in the surrender of the old patent and the application for the new. And yet in the absence of this proceeding, under the acts of 1832 and 1836, the rights of the patentee could not be vindicated against an infringer if his patent claimed more than his actual invention, although the actual invention were sufficiently described, and the portions properly claimed could be clearly distinguished from the excess. It was soon perceived, however, that for the purposes of this species of amendment, no such formidable and cautious procedure was demanded. The restriction of an ex-

§ 640. <sup>1</sup> That disclaimers under Secs. 4917 and 4922 rest on the same grounds though used for different purposes, see *Hailes v. Albany Stove Co.* (1887), 123 U. S. 582; 42 O. G. 95.

That a disclaimer does not admit that the patent is void, see *Stocker v. Waller* (1845), 9 Jur. 136; 1 C. B. 147.

cessive Claim is the simple abandonment of an apparent right. It prejudices no one except him who relinquishes what he has hitherto asserted, and may be made by any owner of a separate interest in a patent without affecting the privileges of his co-owners or the public. Hence in the act of 1837 it was provided that this particular amendment might be made by any owner of the whole patent, or of a sectional interest therein, by filing in the Patent Office a written disclaimer of the excess, and that, as modified by this disclaimer, the original patent should thereafter be construed in all cases where the rights of the disclaimant were involved. A disclaimer is thus an inexpensive and expeditious method of removing from a patent a defect which could at first be cured only by a re-issue, and which may still be remedied at the option of the owners of the entire patent by that more elaborate proceeding.<sup>1</sup>

**§ 642. Disclaimer a Method of Amending only an Excessive Claim.**

The defect which a disclaimer is intended to remove is one that, in its nature, is fatal to the patent.<sup>1</sup> An inventor has

§ 641. <sup>1</sup> That a disclaimer is allowed in reference to patents that were issued before the act was passed, see *Hotchkiss v. Oliver* (1848), 5 Denio (N. Y.), 314.

§ 642. <sup>1</sup> That a disclaimer is necessary when too much has been claimed, see *Seymour v. McCormick* (1856), 19 How. 96.

That superfluous Claims may be disclaimed, but cannot be rejected by the courts, see *Parker v. Sears* (1850), 1 Fisher, 98.

That a void Claim may be disclaimed, see *Tyler v. Galloway* (1882), 12 Fed. Rep. 567 ; 20 Blatch. 445 ; 22 O. G. 2072.

That a Claim, if too broad, may be narrowed by disclaimer, see *Terry Clock Co. v. New Haven Clock Co.* (1879), 17 O. G. 909 ; *Rice v. Garnhart* (1874), 34 Wis. 453.

That where the original patent claims

two methods, the disclaimer may relinquish one, see *Tuck v. Bramhill* (1868), 6 Blatch. 95 ; 3 Fisher, 400.

That a patent covering distinct improvements may be amended by disclaiming all but one, see *Sessions v. Romadka* (1884), 28 O. G. 721 ; 21 Fed. Rep. 124.

That expanded and unlawful Claims inserted by re-issue may be abandoned by disclaimer, see *Schillinger v. Cranford* (1885), 4 Mackay, 450 ; 37 O. G. 1349 ; *Atlantic Giant Powder Co. v. Hulings* (1884), 21 Fed. Rep. 519 ; *Schillinger v. Gunther* (1879), 17 Blatch. 66 ; 16 O. G. 905.

That the original patent cannot be revived merely by disclaiming all changes made by the re-issue, but a new re-issue must be had, see *McMurray v. Mallory* (1884), 111 U. S. 97 ; 27 O. G. 915.



no more right under the modern law than he had under the ancient law to claim what he has not invented, and thus deprive the public of their vested privileges. Knowingly to insert such Claims in his original patent is a fraud which invalidates his grant, and knowingly to persevere in them, after he has discovered that they are without foundation, is a fraud which forfeits all his rights to the protection of any part of the invention covered by the patent. In cases of excessive Claim an amendment by disclaimer or re-issue is thus necessary to save any portion of the privilege conferred by the patent; and at whatever period, during the life of the patent, the patentee becomes aware of this defect he must remove it or the value of his patent is destroyed.

§ 643. **Claim when Excessive: How Excess Ascertained.**

A Claim is excessive when it claims any material and substantial act or thing beyond the scope of the real invention of the patentee, or beyond the scope of what he has described in his specification, drawings, or model, as his invention.<sup>1</sup> Immaterial and unessential features of the art or instrument protected by the patent are never regarded as covered by the Claim, nor does their mention in the Claim in any degree affect the character of the patented invention. Excess in these particulars is, therefore, not a fault which calls for any amendment, unless its presence in the Claims renders them obscure and thus requires their correction by re-issue.<sup>2</sup> Whether the Claim is broader than the Description may be discovered by comparing them with each other as they appear on the face of the patent. Whether it exceeds the real invention is determined by ascertaining the precise limits of the idea of means embodied in the invention, and inquiring if the

§ 643. <sup>1</sup> In *O'Reilly v. Morse* (1853), 15 How. 62, Taney, C. J.: (121) "Whether, therefore, the patent is illegal in part because he claims more than he has sufficiently described, or more than he invented, he must in either case disclaim, in order to save the portion to which he is entitled."

<sup>2</sup> In *Hall v. Wiles* (1851), 2 Blatch. 194, Nelson, J.: (199) "The pro-

vision in question applies only in the case where the part claimed by the patentee, of which he is not the inventor, is a material and substantial part of the thing patented. A disclaimer is necessary, therefore, only where the thing claimed without right is a material and substantial part of the machine invented."

allegations of the Claim cover any substantial instrument or operation not embraced in this idea. The former investigation is governed by the ordinary rules of interpretation. The latter may be pursued in any manner tending to disclose the actual nature of the invention made. Thus if the patentee has received a foreign patent in which his invention is described and claimed within narrower limits than in the domestic patent, or if in actual use certain features which the patent claims as material parts of the invention are discarded as non-essential, or if by any evidence it is established that the Claim includes features already known at the date of the invention, — in these and in all other proper ways the identity of the invention made with the invention claimed may be tested, and the extent and nature of the excess, if any, may be ascertained.<sup>3</sup> This excess, if separable from the other portions of the Claim, or if constituting one of several Claims in the patent, may form the subject-matter of a disclaimer. When not separable from the other portions of the Claim, the entire Claim is void and can be cured only by re-issue; and when the patent contains no other Claims than this indivisible, excessive Claim, the patent itself is inoperative and should be surrendered and re-issued.

**§ 644. Excessive Claim Amendable by Disclaimer only when the Defect Arose through Mistake and without Fraud.**

An excessive Claim can be amended by disclaimer only when the error arose through inadvertence, accident, or mistake, and without any fraudulent or deceptive intention.<sup>1</sup> A

<sup>3</sup> That where a foreign patent (English) contains a disclaimer of certain features, the American patent must be limited in the same way, see *Ashcroft v. Boston & Lowell R. R. Co.* (1877), 97 U. S. 189; 13 O. G. 865.

That a device actually discarded in practice ought to be disclaimed, see *Ex parte Marsh* (1872), 2 O. G. 197.

That immaterial parts may be removed by disclaimer, see *Lister v. Leather* (1858), 8 El. & B. 1004; *Reg. v. Mill* (1851), 14 Beav. 312.

That a claimed element of a combi-

nation cannot be disclaimed, see *Vance v. Campbell* (1861), 1 Black, 427; *Foxwell v. Bostock* (1864), 4 De G. J. & S. 298.

That the correction of a mistake as to the effect produced must be made by re-issue, not by disclaimer, see *Schillinger v. Gunther* (1878), 14 O. G. 713; 15 Blatch. 303.

§ 644. <sup>1</sup> In *Schillinger v. Gunther* (1879), 17 Blatch. 66, Blatchford, J. : (69) "But no disclaimer can be allowed to be operative unless the unlawful claim was made through inadvertence, accident, or mistake, and without



patentee is not allowed to speculate on the chances of an attack upon his patent for its unwarranted assertions, nor on the submission of the public to his improper claims. The law requires of him the utmost good faith, with reasonable diligence and skill in the description of his invention and the statement of his claims, and does not hold him responsible for errors into which, in spite of honesty and caution, he is liable to fall. But to the patentee who wilfully endeavors to mislead the public, it lends no aid either in the correction of his errors or in avoiding their consequences, but leaves him to meet his merited fate in the rejection of his patent by the courts.

**§ 645. Excessive Claim Amendable by Disclaimer only when the Amended Claim would cover a Patentable Invention.**

An excessive Claim can be amended by disclaimer only when the Claim as amended would cover a patentable invention.<sup>1</sup> The patentee has no right to any patent whatever unless he has invented something which may lawfully become the subject-matter of a patent, and no mistake of his in coupling with his own production such instruments or operations as give to the described invention its entire patentable character can entitle him to retain the patent for what is truly his, after disclaiming that excess in which the attributes

any fraudulent or deceptive intention; nor can a plaintiff recover on a patent which claims anything not *bona fide* the patentee's, unless the claim to the thing not *bona fide* his was made through inadvertence, accident, or mistake, and without any wilful default or intent to defraud or mislead the public." 16 O. G. 905 (906).

That a disclaimer is proper where the mistakes were mistakes of fact, see *Schillinger v. Gunther* (1879), 16 O. G. 905; 17 Blatch. 66.

That the burden of proof rests on those who allege that the excess was originally claimed through fraud, see *Hotchkiss v. Oliver* (1848), 5 Denio (N. Y.), 314.

For a discussion of inadvertence, etc., see §§ 658, *ante*, and 685-692, and notes, *post*.

§ 645. <sup>1</sup> That a disclaimer is of no avail unless the part rightfully claimed is a material and substantial part of the matter patented, and is distinguishable from the rest, see *Hotchkiss v. Oliver* (1848), 5 Denio (N. Y.), 314.

That an element of a combination is not a distinguishable part, see *Vance v. Campbell* (1861), 1 Black, 427.

That a part may be useful and yet neither material nor substantial nor distinguishable, see *Hotchkiss v. Oliver* (1848), 5 Denio (N. Y.), 314.

of a patentable invention alone reside. No one, therefore, can be permitted to disclaim, unless he or the alleged inventor from whom he derives his title has performed an inventive act, resulting in some material and substantial part of the thing patented which is so far separable from the excess that the patent can be valid for it, and protect it, after the excess has been disclaimed.

**§ 646. Excessive Claim not Amendable by Disclaimer after Unreasonable Delay.**

An excessive Claim can be amended by disclaimer only when the amendment is attempted without unreasonable delay. The same principle which forbids a patentee to assert a right to more than he has actually invented compels him to disavow the right as soon as he discovers that it has been unjustly claimed. Unreasonable delay in disclaiming is thus tantamount to an original fraudulent Claim, and through it the patentee loses the privilege of making the amendment by which alone his patent could be saved.<sup>1</sup> The question of unreasonable delay is a question for the court, upon the facts as found either by its own investigation or the verdict of a jury.<sup>2</sup> Delay begins whenever the patentee becomes aware that he has claimed more than he has invented or described. In cases where the excess is not apparent at once upon the inspection of the patent by the patentee, the allowance of his

§ 646. <sup>1</sup> That "unreasonable delay" avoids the good effect of a disclaimer, see *Tuck v. Bramhill* (1868), 6 Blatch. 95; 3 *Fisher*, 400; *Singer v. Walmsley* (1860), 1 *Fisher*, 558; *Seymour v. McCormick* (1856), 19 *How.* 96; *Brooks v. Jenkins* (1844), 3 *McLean*, 432.

That a delay in filing a disclaimer does not prejudice the patentee unless it is unreasonable, see *Hotchkiss v. Oliver* (1848), 5 *Denio* (N. Y.), 314.

That no disclaimer can be filed after the patent has expired, see *Yale Lock Mfg. Co. v. Sargent* (1886), 117 *U. S.* 536; 35 *O. G.* 497; *Vacuum Oil Co. v. Buffalo Lubricating Oil Co.* (1885), 23 *Fed. Rep.* 891.

<sup>2</sup> In *Singer v. Walmsley* (1860), 1 *Fisher*, 558, *Giles, J.* : (575) "What is 'unreasonable delay' is a question to be settled by the court and not for the jury. . . . The court will find that the time, in reference to the question of delay, commences when the knowledge was brought home to the party that he was not the first inventor, or when it is declared by a court, of competent jurisdiction to settle the question, that he was not the first inventor; then it is that the time commences to run, and not until then."

See also *Seymour v. McCormick* (1856), 19 *How.* 96; *Brooks v. Jenkins* (1844), 3 *McLean*, 432.



Claim by the Patent Office raises such a presumption in its favor that he may rely on its validity until a court of competent jurisdiction decides that it is broader than his real invention.<sup>8</sup>

§ 647. **Disclaimer, by Whom Made.**

Where an excessive Claim can be cured by disclaimer, the disclaimer must be filed by a party owning an interest in the patent and whose interest is distinct from that of his co-owners.<sup>1</sup> The original patentee cannot disclaim after he has parted with his entire title to the patent.<sup>2</sup> An owner of an undivided interest cannot disclaim, and thus change the form of the patent, without the co-operation of the other owners of the same interest in the patent. But an owner either of the entire patent, or of the entire interest within a specified territory, may file a disclaimer; and when the disclaimant is a territorial owner its effect upon the patent will be commen-

<sup>8</sup> In *O'Reilly v. Morse* (1853), 15 How. 62, Taney, C. J. : (121) "It appears that no disclaimer has yet been entered at the Patent Office. But the delay in entering it is not unreasonable. For the objectionable Claim was sanctioned by the head of the Office; it has been held to be valid by a circuit court, and differences of opinion in relation to it are found to exist among the justices of this court. Under such circumstances the patentee had a right to insist upon it, and not disclaim it until the highest court to which it could be carried had pronounced its judgment."

See also *Seymour v. McCormick* (1856), 19 How. 96.

That the allowance of Claims by the Patent Office is such evidence of their validity that the patentee may rely upon it until the courts have decided to the contrary, see *Yale Lock Mfg. Co. v. Sargent* (1886), 117 U. S. 536; 35 O. G. 497; *Stutz v. Armstrong* (1884), 28 O. G. 367; 20 Fed. Rep. 843; *Burdett v. Estey* (1878), 15 Blatch. 349; 15 O. G. 877.

That delay in disclaiming cannot exist until the need of a disclaimer is made known, see *Kittle v. Hall* (1887), 30 Fed. Rep. 239.

That a disclaimer may be filed after a patent has been adjudged invalid, see *Morgan v. Seaward* (1838), 2 Carp. P. C. 104; *In re Derosne's Patent* (1835), 1 Carp. P. C. 698.

§ 647. <sup>1</sup> That a disclaimer must be made by one who owns an entire right within a given territory, see *Myers v. Frame* (1871), 4 Fisher, 493; 8 Blatch. 446.

<sup>2</sup> That a disclaimer by a patentee is not valid unless he is still the owner of the patent, see *Myers v. Frame* (1871), 4 Fisher, 493; 8 Blatch. 446.

That under the English statute a disclaimer may be filed by a patentee who has parted with his interest, see *Spilsbury v. Clough* (1842), 1 Web. P. C. 255.

That a disclaimer by an attorney does not necessarily bind a patentee, see *Mann v. Bayliss* (1876), 10 O. G. 789.

surate only with his interest; and the patent as amended will thereafter limit and define his rights, while other parties hold under the patent in its original form.<sup>3</sup> Thus the same patent may be operative, in terms at least, to different extents in different sections of the United States, and may be valid as to diligent disclaimants, though void as to other owners who have unreasonably neglected to disclaim.

#### § 648. Disclaimer, how Made.

A disclaimer must be made in writing, must be signed by the disclaimant and attested by one or more witnesses, and must be recorded in the Patent Office. It must state the exact interest of the disclaimant in the patent, and distinctly set out the excess which is to be disclaimed, averring that it was included in the patent through inadvertence, accident, or mistake.<sup>1</sup> Upon the receipt and recording of this disclaimer, it is considered as part of the original specification, to the extent of the interest possessed by the disclaimant and by those deriving title from him after the disclaimer is recorded.<sup>2</sup>

<sup>3</sup> In *Potter v. Holland* (1858), 1 Fisher, 327, *Ingersoll, J.* : (339) "The owner of a sectional interest, however, can make a disclaimer for his sectional interest, which is to be taken as a part of the original specification, for the section owned by him, and no greater extent. After such disclaimer a different claim of right is secured to the disclaimant, the owner of a sectional interest, from what is purported to be secured to the patentee, the owner of the remaining interest; different claims of right in the same invention are secured to different sectional owners; there are two specifications for the same invention, one making one claim of right to an invention for one section of country, and the other making another and different claim of right to the same invention, for another section of country. In effect it makes two patents out of one, one securing a claim of right to one person, and the other securing a

different claim of right to another person. This is expressly authorized by the Patent Law." 4 Blatch. 206 (217).

That the word "claimant" in Sec. 4917 Rev. Stat. means disclaimant, see *Union Metallic Cartridge Co. v. United States Cartridge Co.* (1884), 112 U. S. 624; 30 O. G. 771.

§ 648. <sup>1</sup> That a disclaimer, under Sec. 7, act of 1837, must state the interest of the disclaimant, or it will be invalid, see *Foote v. Silsby* (1849), 1 Blatch. 445; *Brooks v. Jenkins* (1844), 3 McLean, 432.

<sup>2</sup> That a disclaimer becomes part of the specification and is considered in construing the patent, see *Dunbar v. Myers* (1877), 94 U. S. 187; 11 O. G. 35.

That a disclaimer may relate to one figure only in a drawing, see *Brush v. Condit* (1884), 28 O. G. 451; 22 Blatch. 246; 20 Fed. Rep. 826.



§ 649. Disclaimer not a Method of Amending a Defective Description.

From the nature of a disclaimer, and of the defect it is intended to remedy, it is evident that it cannot be employed for the alteration or reformation of the Description, but only for the elimination of superfluous matter from the Claims.<sup>1</sup> If the Description requires amendment in order to give effect to a Claim, or if the Claim itself demands restatement to avoid obscurity, or if new Claims are necessary to protect the actual invention, these objects must be sought by a re-issue, not by

§ 649. <sup>1</sup> In *Hailes v. Albany Stove Co.* (1887), 123 U. S. 582, Bradley, J. : (587) "A disclaimer is usually and properly employed for the surrender of a separate Claim in a patent, or some other distinct and separable matter, which can be excised without mutilating or changing what is left standing. Perhaps it may be used to limit a Claim to a particular class of objects, or even to change the form of a Claim which is too broad in its terms; but certainly it cannot be used to change the character of the invention. And if it requires an amended specification or supplemental Description to make an altered Claim intelligible or relevant, while it may possibly present a case for a surrender and re-issue, it is clearly not adapted to a disclaimer. A man cannot by merely filing a paper drawn up by his solicitor make to himself a new patent, or one for a different invention from that which he has described in his specification." 42 O. G. 95 (97).

In *Union Metallic Cartridge Co. v. United States Cartridge Co.* (1884), 112 U. S. 624, Blatchford, J. : (642) "It is a patentee who 'has claimed more than that of which he was the original or first inventor or discoverer,' and only 'such patentee,' or his assigns, who can make a disclaimer, and the disclaimer can be a disclaimer only 'of such parts of the thing patented as he shall not choose to claim or hold by

virtue of the patent or assignment.' A disclaimer can be made only when something has been claimed of which the patentee was not the original or first inventor, and when it is intended to limit a Claim in respect to the thing so not originally or first invented. It is true that, in so disclaiming or limiting a Claim, descriptive matter on which the disclaimed Claim is based may, as incidental, be erased, in aid of, or as ancillary to, the disclaimer. But the statute expressly limits a disclaimer to a rejection of something before claimed as new or as invented, when it was not new or invented, and which the patentee or his assignee no longer chooses to claim or hold. It is true that this same end may be reached by a re-issue, when the patentee has claimed as his own invention more than he had a right to claim as new; but if a Claim is not to be rejected or limited, but there is merely 'a defective or insufficient specification,' — that is, Description, as distinguished from a Claim, — the only mode of correcting it was and is by a re-issue." 30 O. G. 771 (775).

That a disclaimer cannot be used to make a patent cover what is not described or claimed as part of the invention, see *White v. Gleason Mfg. Co.* (1883), 24 O. G. 205; 21 Blatch. 364; 17 Fed. Rep. 159; *Foxwell v. Bostock* (1864), 4 De G. J. & S. 298.

a disclaimer. But where excessive Claims are to be remedied by a disclaimer, such parts of the Description as serve no other purpose than to support the excess disclaimed may also be withdrawn by the disclaimer, and the distinction between the actual invention and the excess be thus more clearly indicated.<sup>2</sup> In the same manner objectionable phrases in the

<sup>2</sup> In *Hailes v. Albany Stove Co.* (1883), 16 Fed. Rep. 240, Wallace, J. : (242) "If it is true that the patentees defectively or insufficiently described the invention, and claimed more than they had a right to claim as new, they were entitled to a re-issue of their patent upon surrender of the original. But it is not the office of a disclaimer to reform or alter the Description of the invention. If a patentee has claimed more than that of which he was the inventor, his patent may be valid for all that part which is justly and truly his own, and he may recover upon his patent if the part which is his own be definitely distinguished from the parts claimed without right; but in such case he cannot recover costs unless a disclaimer has been entered before suit commenced. When there are several Claims, some of which he is entitled to and others of which he is not entitled to, the part of the invention which is his own may be definitely distinguishable from that which is not his own, and a disclaimer before suit brought will put him right, and enable him to recover upon his patent as though it had originally been confined to the proper Claims; and there would seem to be no objection in such a case to eliminating by his disclaimer such parts of the Description as relate to the Claims to which he is not entitled and which he abandons. This, however, is a very different thing from converting a Claim from one thing into a Claim for something else, and amending the Description to effectuate the Claim. This might give the patentee a new patent;

it certainly would enable him to grant himself a re-issue without the concurrence of the Commissioner of Patents. It would enable him, after others had occupied the field of invention, and by their intellect and experiments discovered what he had never pointed out or claimed, except, perhaps, so vaguely that his information was valueless, to deprive them of the fruit of their efforts. When there are distinct Claims in the patent, some of which are valid and others not; or, where there is a single Claim, but a specification by which the public can definitely distinguish what is new and belongs to the patentee, and what does not really belong to him, although he had claimed it, a disclaimer will right the patentee's mistake, and will work no injustice to others." 21 Blatch. 271 (273); 24 O. G. 391 (392).

In *Schillinger v. Gunther* (1879), 17 Blatch. 66, Blatchford, J. : (69) "It is true, that, strictly, Sec. 4917 contemplates only a disclaimer of some Claim, or part of a Claim; but, in connection with a disclaimer of a Claim, or of a part of a Claim, it is not improper to eliminate or withdraw, by the same writing, the parts of the body of the specification on which the disclaimed Claim, or part of a Claim, is founded. The disclaimer is none the less a disclaimer of a Claim or of a part of a Claim because, in addition, it disclaims such parts of the body of the specification. The disclaimer being a proper one, in form and substance, it is, by the statute, to be, after its filing, 'considered as part of the original specification.' The re-issued specification is to be



specification may be removed, and false statements of fact may be expunged, provided that no new construction is thereby given to what remains.<sup>8</sup> For the sole purpose of a disclaimer is to amend excessive Claims by eliminating from them the separable excess; and whatever else it may accomplish must be wholly subordinate and auxiliary to that end.

**§ 650. Disclaimer Affects only the Excess which it Eliminates from the Claim.**

The effect of a disclaimer is confined to the excess which it removes from the apparent protection of the patent. Except as to this the patent remains operative to the same extent as before the disclaimer was filed.<sup>1</sup> The disclaimer of a void Claim does not affect such other Claims of the patent as by themselves are valid, nor does the disclaimer of the excessive portion of a Claim impair the force of what is not disclaimed. Thus the disclaimer neither adds to the patent, nor makes it cover more than it formerly embraced.<sup>2</sup> The disclaimer of a species does not affect a Claim for the genus which includes it, nor does the disclaimer of an apparatus except when used for a particular purpose prevent the patentee from claiming it in connection with the purpose so described.<sup>3</sup> The patent stands

thereafter read as if the disclaimer were incorporated in it." 16 O. G. 905 (906).

That a disclaimer may eliminate all of the descriptive matter which relates to the parts disclaimed, see *Tarrant v. Duluth Lumber Co.* (1887), 39 O. G. 1425; 30 Fed. Rep. 830.

That a disclaimer may remove matter first set up in a re-issue, and may relate to the Description as well as to the Claim, see *Schillinger v. Gunther* (1879), 16 O. G. 905; 17 Blatch. 66.

<sup>8</sup> That objectionable phrases in the specification may be removed by disclaimer, see *American Wood Paper Co. v. Heft* (1867), 3 Fisher, 316.

That an unintelligible specification cannot be cured by disclaimer, see *Ralston v. Smith* (1865), 11 H. L. 223.

§ 650. <sup>1</sup> That the matter disclaimed

ceases to be part of the invention, see *Dunbar v. Myers* (1877), 94 U. S. 187; 11 O. G. 35.

That a void Claim being disclaimed the rest are good, see *O'Reilly v. Morse* (1853), 15 How. 62.

<sup>2</sup> That a disclaimer adds nothing to the patent nor can it make the patent cover more than it did before, this being the province of a re-issue, see *White v. Gleason Mfg. Co.* (1883), 17 Fed. Rep. 159; 21 Blatch. 364; 24 O. G. 205; *Foxwell v. Bostock* (1864), 4 De G. J. & S. 298.

<sup>3</sup> That the disclaimer of one species does not affect the genus, see *Walsh v. Shinn* (1879), 16 O. G. 1006.

That a disclaimer of apparatus except when used for a special purpose does not admit it to be old, or bar the patentee from claiming it for that purpose, see

after the disclaimer as if it had been originally issued in the amended form, and both its Claims and its Descriptions are interpreted and applied without reference to the matter that has been withdrawn.<sup>4</sup>

§ 651. **Origin and Nature of Disclaimer as a Method of Saving an Otherwise Lost Suit.**

A disclaimer, considered as a method of avoiding a defence based on an excessive Claim, was also introduced into our Patent Law by the act of 1837. Prior to that act the patentee could not recover on a patent in which he claimed more than he had actually invented. It was his duty not only to describe his invention with exactness, neither withholding from the public the knowledge of any material part thereof nor misleading them by asserting the materiality of that which in itself was not essential, but to distinguish the invention to be covered by the patent from all other arts or instruments by a certain and specific Claim. Upon this Claim the fortunes of the patent turned. If it were narrower than the invention the scope of the protection afforded by the patent was nevertheless restricted to its terms. If it were broader than the actual invention it was false, at least in part, and as the court had no means of determining, as matter of law, how far the Claim was true nor of separating the true allegations from the false, the entire Claim was necessarily regarded as invalid. The act of 1836, while it made this defect curable by re-issue, also provided that when a defendant in an action for infringement prevailed over the

*Black v. Thorne* (1872), 10 Blatch. 66 ;  
5 Fisher, 550 ; 2 O. G. 388.

<sup>4</sup> That an unfounded Claim being disclaimed the patent stands for the residue as if so originally issued, see *McCormick v. Seymour* (1854), 3 Blatch. 209 ; *Clark v. Kenrick* (1843), 12 M. & W. 221.

That after an amendment by disclaimer a patent cannot be so construed as to render the amendment nugatory, see *Atlantic Giant Powder Co. v. Hullings* (1884), 21 Fed. Rep. 519.

That where a disclaimer withdraws a new re-issue Claim, and leaves only what was covered by the original, if any new matter remains in the Description it must be discarded, see *Schillinger v. Cranford* (1885), 4 Mackay, 450 ; 37 O. G. 1349.

That a disclaimer cannot be used to explain that which remains in the patent, see *Tetley v. Easton* (1857), 2 C. B. N. s. 706.



plaintiff on this ground of defence, the court might award costs to either party in its discretion, if the defendant had used any part of the invention which was truly claimed as new. This provision enabled the court to shield the honest but mistaken patentee from some of the consequences of his error, leaving him, under other provisions of the same act, to amend his Claim and thus protect himself from further violations of his rights. The act of 1837 extended, and made more immediately applicable, these benign provisions. While conferring on the owner of the patent the power to amend at once by filing a disclaimer, it enacted that in all those cases where a disclaimer might properly be filed the patent should be good and valid for so much of the invention claimed as was truly and honestly the invention of the patentee, if it were in itself a patentable invention and separable from the matter falsely claimed. It further enacted that the plaintiff claiming under such a patent should be entitled to maintain his suit in spite of this defect, if the right to amend the patent by disclaimer had not been already forfeited by an unreasonable delay, but that he should recover no costs against the defendant unless he had filed such disclaimer in the Patent Office prior to the commencement of the suit.<sup>1</sup>

§ 651. <sup>1</sup> In *Tuck v. Bramhill* (1868), 3 Fisher, 400, Blatchford, J. : (406) "But the defendant contends that the disclaimer in this case, if properly made at all, cannot affect the issues in this suit, because it was not filed till after the commencement of the suit. In other words, the defendant contends that the plaintiff cannot recover in this suit because the Claim, as it stood when the suit was brought, embraced more than that of which the plaintiff was the first inventor. In urging this view, the defendant relies on the general principle of law to that effect, as recognized before the act of March 3, 1837, was passed, and on the provision of section 7 of that act, that 'no such disclaimer shall affect any action pending at the time of its being filed, except so far as may relate to the question of

unreasonable neglect or delay in filing the same;' and he insists that the Claim of the patent must be construed, for the purposes of this suit, as if no disclaimer had been filed. . . . (408) This is not so. It is true that Judge Story, in *Reed v. Cutter*, 1 Story, 590, 600, says that if a disclaimer is filed during the pendency of a suit, the plaintiff will not be entitled to the benefit thereof in that suit, and that the same judge, in *Wyeth v. Stone*, 1 Story, 273, 294, says that the disclaimer mentioned in section 7 must be interpreted to apply solely to suits pending when the disclaimer is filed in the Patent Office, and the disclaimer mentioned in section 9 to apply solely to suits brought after the disclaimer is so filed, and that the proviso to section 7, as to the disclaimer's affecting a pending suit, prevents its affect-

Under these provisions the patent is no longer open to this defence except where the disclaimer was unreasonably de-

ing in any manner whatsoever a suit pending at the time it is filed. . . . (409) I cannot concur, however, in Judge Story's view of the provision in section 7 as to the disclaimer's affecting a pending suit. I understand that provision to mean that a suit pending when a disclaimer is filed is not to be affected by such filing, so as to prevent the plaintiff from recovering in it, unless it appears that the plaintiff unreasonably neglected or delayed to file the disclaimer. The 'unreasonable neglect or delay' mentioned in section 7 manifestly refers to the unreasonable neglect or delay mentioned in section 9, and the disclaimer mentioned in section 9 is clearly the disclaimer provided for in section 7. Moreover, the provision of section 9, that the plaintiff, where he is entitled to recover under that section, shall not recover costs unless he has entered a disclaimer, prior to the commencement of the suit, of what he claimed without right, is a strong implication that where he does not enter the disclaimer until after the commencement of the suit he may still recover in the suit, if otherwise entitled to do so, but without recovering costs. And such has been the view heretofore held by Mr. Justice Nelson, in this circuit. In *Guyon v. Serrell*, 1 Blatch. 244, he allowed a recovery, without costs, in a case where a disclaimer was filed after suit was brought; and in *Hall v. Wiles*, 2 Blatch. 194, 198, he says: 'If the disclaimer was entered in the Patent Office before the suit was instituted, the plaintiff recovers costs in the usual way, independently of any question of disclaimer. But if, in the progress of the trial, it turns out that the disclaimer ought to have been made as to part of what is claimed, the plaintiff may recover, but will not be entitled to costs.' Of

course, it follows that if a disclaimer is made after suit brought, the plaintiff may still recover, but without costs.' 6 Blatch. 95 (102).

That the plaintiff may recover for the infringement of his actual invention though he has filed no disclaimer, unless he has been guilty of unreasonable delay, see *O'Reilly v. Morse* (1853), 15 How. 62; *Hall v. Wiles* (1851), 2 Blatch. 194.

That an excessive Claim inserted by mistake may be disclaimed pending suit and the suit saved, though without costs, see *Matthews v. Spangenberg* (1882), 23 O. G. 92; 20 Blatch. 482; 19 Fed. Rep. 823.

That where a proper disclaimer has been filed the plaintiff may recover on the Claims not disclaimed, see *Schillinger v. Gunther* (1879), 17 Blatch. 66; 16 O. G. 905.

That a patentee may have his remedy though no disclaimer is filed, it not being a condition precedent, see *Hotchkiss v. Oliver* (1848), 5 Denio (N. Y.), 314.

That the court may increase the damages under Sec. 14, act of 1836, though no disclaimer was filed, see *Guyon v. Serrell* (1847), 1 Blatch. 244.

That under the act of 1837, when the patent claims too much, a suit can be saved only where the thing rightfully claimed can be distinguished from the excess, see *Vance v. Campbell* (1861), 1 Black, 427.

That in order to save the costs a disclaimer must be filed before suit, as well as with reasonable diligence, see *Tuck v. Bramhill* (1868), 6 Blatch. 95; 3 Fisher, 400; *Reed v. Cutter* (1841), 1 Story, 590; 2 Robb, 81.

That the filing of a disclaimer before suit affects only the costs, if there is no question of unreasonable delay, see *Dunbar v. Myers* (1877), 94 U. S. 487; 11



ferred, but the defendant is not liable for costs on any action brought while the patent still remains in its defective state.<sup>2</sup>

§ 652. Disclaimer a Nullity unless Original Claim Actually Excessive.

A disclaimer filed without sufficient cause is a nullity under this as well as the former section of the act.<sup>1</sup> If there is no real excess of Claim, according to the construction given to its language by the court, the filing of a disclaimer by the plaintiff, pending suit, does not admit his inability to recover costs.<sup>2</sup> A disclaimer leaving the patent to claim the entire invention, as the courts must have construed it had the disclaimer not been filed, is equally inoperative both as an amendment and upon the costs.<sup>3</sup> The same is true of a disclaimer of a part or act not claimed in the patent, and of such

O. G. 35 ; Tuck *v.* Bramhill (1868), 3 Fisher, 400 ; 6 Blatch. 95.

That a disclaimer being filed during suit, the plaintiff can recover no costs, see Hayes *v.* Bickelhaupt (1885), 32 O. G. 133 ; 23 Fed. Rep. 183 ; Burdett *v.* Estey (1878), 15 O. G. 877 ; 15 Blatch. 349.

That under the act of 1837 a disclaimer may be filed after the commencement of a suit, and the court will duly protect the interest of the defendants, see Smith *v.* Nichols (1874), 21 Wall. 112.

<sup>2</sup> That under Sec. 9, act of March 3, 1837, the plaintiff can recover for the infringement of such part of the device as is truly his, though his specification embraces more than he has a right to claim and no disclaimer is filed, see Tuck *v.* Bramhill (1868), 3 Fisher, 400 ; 6 Blatch. 95.

That Claims not sued on need not have been cured by disclaimer, in order to warrant a preliminary injunction, see Duff *v.* Calkins (1883), 25 O. G. 601.

That where the Claim of a patent is declared invalid too nearly to the expiration of the patent to allow of the

filing of a disclaimer, the patentee can recover on the valid Claims, notwithstanding his failure to disclaim, see Kittle *v.* Hall (1887), 30 Fed. Rep. 239.

That where a disclaimer was made pending suit, and the defendant was not prejudiced thereby, the proceedings need not be recommenced, see Libbey *v.* Mt. Washington Glass Co. (1886), 36 O. G. 572 ; 26 Fed. Rep. 757.

§ 652. <sup>1</sup> That a disclaimer, filed without necessity, is a nullity, and does not affect the costs of the suit, see Sharp *v.* Tift (1880), 17 O. G. 1282 ; 18 Blatch. 132 ; 2 Fed. Rep. 697 ; 5 Bann. & A. 399.

<sup>2</sup> That a disclaimer of something not claimed in the patent is a nullity, see Sharp *v.* Tift (1880), 17 O. G. 1282 ; 18 Blatch. 132 ; 2 Fed. Rep. 697 ; 5 Bann. & A. 399.

<sup>3</sup> That where a disclaimer leaves the patent to claim the whole thing invented just as it must have been construed before, it has no effect on the costs, see Sharp *v.* Tift (1880), 18 Blatch. 132 ; 17 O. G. 1282 ; 2 Fed. Rep. 697 ; 5 Bann. & A. 399.

features as the court finds merely formal and not essential to the idea of means embodied in the invention as originally claimed.

### SECTION III.

#### OF THE AMENDMENT OF LETTERS-PATENT: RE-ISSUE.

##### § 653. Origin of Re-issue as a Method of Amending a Defective Patent: Re-issues Prior to the Act of 1832.

Amendment by re-issue was introduced into our statute law by the act of 1832. Prior to this act, the right of the inventor to a patent, whose protection was commensurate with the invention he had made and had endeavored to describe in his specification, had been distinctly recognized by the courts as well as by the government itself. The practice of surrendering such patents as failed to afford this protection, and of issuing corrected patents by which the purposes of the law on behalf of the inventor were fulfilled, had been established, and had been repeatedly sanctioned by judicial decisions.<sup>1</sup> Such defective patents were regarded as invalid and inoperative whether the defect consisted in an insufficient or

§ 653. <sup>1</sup> In *Grant v. Raymond* (1832), 6 Peters, 218, Marshall, C. J. : (243) "It has been said that this permission to issue a new patent on a reformed specification, when the first was defective through the mistake of the patentee, would change the whole character of the act of Congress. We are not convinced of this. The great object and intention of the act is to secure to the public the advantages to be derived from the discoveries of individuals, and the means it employs are the compensation made to those individuals for the time and labor devoted to these discoveries, by the exclusive right to make, use, and sell the things discovered for a limited time. That which gives complete effect to this object and intention, by employing the same means for the correction of inadvertent error which

are directed in the first instance, cannot, we think, be a departure from the spirit and character of the act." 1 Robb, 604 (635). This case was tried in the Circuit Court in 1828. The original patent was granted in 1821, and on account of its defective specification was surrendered and re-issued in 1825. Against an objection, at the trial, that such surrender and re-issue were not authorized by law, the patent was sustained, and the decision on this point was affirmed in the Supreme Court at the January Term, 1832. The act of 1832 was approved in the following July.

See also *Shaw v. Cooper* (1833), 7 Peters, 292; 1 Robb, 643; Opinion Atty. Gen. (1831), 2 Op. At. Gen. 454; *Morris v. Huntington* (1824), 1 Paine, 348; 1 Robb, 448.



obscure description of the invention or in an inaccurate statement of the true line of distinction by which the new matter described was separated from the old. The principle on which this practice rested is easily discernible. The inventor, having a right under the law to a patent for his actual invention, and not having succeeded in obtaining such a patent by his first attempt, was entitled to make another application and receive a more perfect patent. But in doing this he was liable to be met by the objection that his invention had already gone into public use and that his right to any protection had been thereby lost. To avoid this objection the method of securing the same object by amending the original patent was devised, to the mutual advantage both of the inventor and the public, — the inventor escaping the objection before mentioned, and the public becoming completely possessed of the invention at the expiration of the term of the original patent, instead of being compelled to await the passage of a new term dating from the issue of a later patent.<sup>2</sup> As this practice is the origin and foundation of the entire body of rules relating to re-issues, its purposes, spirit, and methods form the key by which the conflicts and problems arising under the later law are to be resolved.<sup>3</sup>

#### § 654. Re-issues under the Act of 1832.

The act of 1832 recognized this mode of amendment and prescribed definite rules for its performance. It provided

<sup>2</sup> That a re-issue for the purpose of perfecting the patent is promotive of the public interest, see *French v. Rogers* (1851), 1 Fisher, 133.

That the privilege of a re-issue is invaluable to inventors, see *Blake v. Stafford* (1868), 6 Blatch. 195; 3 Fisher, 294.

<sup>3</sup> The first act of Parliament which authorized the amendment of existing patents was passed in 1835. Prior to this date, however, the power had been exercised to a limited extent in cases where the error was merely verbal, was apparent on the face of the patent, and had arisen through accident or mistake.

See *In re Whitehouse's Patent* (1830), 1 Web. 649, note; *In re Redmund's Patent* (1828), 1 Web. 649, note; and § 16 and notes, *ante*. Mr. Ogden's argument in *Grant v. Raymond* (1832), 6 Peters, 218, refers to *Ex parte Beck* (1784), 1 Bro. Ch. Rep. 575, as showing that the surrender of a defective patent and the issue of a new one in its stead was under the English practice "a matter of course." Other cases of amendment of letters-patents (not apparently relating to inventions, however), are cited in a note to 1 Web. 647.

that whenever any patent should be invalid or inoperative, through the non-compliance of the inventor with the terms and conditions mentioned in the third section of the act of 1793, the patent might be surrendered and re-issued if the error had arisen from inadvertence, accident, or mistake, and without any fraudulent or deceptive intention.<sup>1</sup> The invalidity and inoperativeness of the patent were thus made dependent on the failure of the patentee to fulfil the obligations imposed by the third section of the act of 1793, and his right to a re-issue was denied only when such failure had resulted from an intention to deceive, or from some other cause than inadvertence, accident, or mistake. The obligations imposed upon the patentee by the third section of the act of 1793 were threefold: (1) To make oath that he believed himself to be the true inventor of the art or instrument for which he sought a patent; (2) To deliver to the government a written description of his invention in such complete and exact language as would distinguish it from all other things before known and would enable any person skilled in the art to construct and use it; (3) To furnish with this description such drawings, model, or specimens, as the nature of the case might require.<sup>2</sup> Now it is obvious that a failure to comply with

§ 654. <sup>1</sup> Act of 1832, § 3: "Wherever any patent . . . granted to any inventor in pursuance of the act of Congress . . . passed . . . in the year of our Lord 1793, . . . shall be invalid or inoperative by reason that any of the terms or conditions prescribed in the third section of the said . . . act, have not, by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, been complied with on the part of said inventor, it shall be lawful for the Secretary of State, upon the surrender to him of such patent, to cause a new patent to be granted," etc.

<sup>2</sup> Act of 1793, § 3: "That every inventor, before he can receive a patent, shall swear or affirm that he does verily believe that he is the true inventor or discoverer of the art, machine, or improvement, for which he solicits a pat-

ent, which oath or affirmation may be made before any person authorized to administer oaths, and shall deliver a written description of his invention and of the manner of using, or process of compounding the same, in such full, clear, and exact terms, as to distinguish the same from all other things before known, and to enable any person skilled in the art or science of which it is a branch, or with which it is most nearly connected, to make, compound, and use the same. And in the case of any machine, he shall fully explain the principle, and the several modes in which he has contemplated the application of that principle or character, by which it may be distinguished from other inventions; and he shall accompany the whole with drawings and written references, where the nature of the case



these conditions, through inadvertence, accident, or mistake, can rarely occur, except in reference to the second condition, or to so much of the third as is directly related to the second. A breach of the first condition must consist either in making no oath whatever, — a defect too glaring to escape attention, — or in making a false oath, which would be a wilful fraud. A breach of the third could take place only when no drawings, model, or specimens were furnished, — another open and apparent defect, — or when they failed to correspond with the invention, and thus rendered the description of which they were a part ambiguous and uncertain. Hence, in the vast majority of cases in which the patent was invalid or inoperative, its defects must have resided in the description given of the invention in the specification, drawings, model, or specimens, and it was chiefly to cure these defects that the remedy by re-issue was provided by the statute. The third section of the act of 1793 prescribed two rules concerning the description: (1) That its terms should be so full, clear, and exact as to enable any person skilled in the art to make and use the invention; (2) That its terms should be so full, clear, and exact as to distinguish the invention from all other things before known. Defects in this description, rendering the patent invalid and inoperative were, therefore, of two classes: (1) Defects in the disclosure of the invention to the public; (2) Defects in defining the precise limits of the invention by distinguishing it from things already known. At this early period of our Patent Law, the modern distinction between the Description and the Claim, as parts of the written specification, was unknown. The same statements and recitals served both purposes, — the scope of the protection afforded by the patent, and the explication of the invention for the information of the public, being gathered from the

admits of drawings, or with specimens of the ingredients, and of the composition of matter, sufficient in quantity for the purpose of experiment, where the invention is of a composition of matter; which description, signed by himself and attested by two witnesses, shall be filed in the office of the Secretary of

State, and certified copies thereof shall be competent evidence in all courts, where any matter or thing touching such patent right shall come in question. And such inventor shall, moreover, deliver a model of his machine, provided the Secretary shall deem such model to be necessary."

entire document without attaching particular significance to any special clause therein contained. But the act of 1793 was at least as stringent as any later statute has been in requiring the presence of such language in the written specification as should completely fulfil both these purposes. The right of the inventor to his patent was made contingent upon the fulness, clearness, and exactness with which the terms of his specification defined the invention which he claimed, and communicated to the public a knowledge of its construction and mode of use; and if in either of these respects the specification was deficient, the patent was invalid and inoperative, and became a proper subject for re-issue under the act of 1832. By virtue of this act the patentee might thus amend those portions of the specification which related to his claim for protection as readily as he could those portions which explained the method of making and using the invention. His right to what was actually his own was treated as commensurate with his duty of disclosure to the public, and the privilege of correcting a mistake, when the correction would redound to his advantage, was as fully recognized as was his obligation to correct it whenever the information afforded by his specification to the public was erroneous or incomplete.

§ 655. **Re-issues under the Act of 1836.**

The act of 1836 introduced into these provisions certain changes of phraseology, but no substantial variation either in the spirit or the meaning of the law. The requirements of the third section of the act of 1793 in reference to the description were preserved almost in the same language, except as to the method of distinguishing the new invention from all other things before known. The words relating to this matter in the act of 1793 were omitted in the act of 1836, and, instead thereof, it was prescribed that the inventor should particularly specify and point out that which he claimed to be his own invention or discovery.<sup>1</sup> This particular statement

§ 655. <sup>1</sup> Act of 1836, § 6: "But before any inventor shall receive a patent for any such new invention or discovery, he shall deliver a written description of his invention or discovery, and of the manner and process of mak-



of his claim is called throughout this act by the name of the "specification," — a name afterwards in use to denote sometimes the Description as distinguished from the Claim, sometimes the entire instrument embracing both, but in the act of 1836 evidently referring mainly to the clause or clauses in which the inventor attempted to specify and point out the exact limits of the invention which he claimed.<sup>2</sup> Thus the terms "description" and "specification," when coupled together in this act, indicate, not the same entire instrument or the same portions of the instrument, but two distinct portions, — the former being the detailed delineation of the invention given for the information of the public and as a basis for the Claim; the latter being the specific statement and definition of the invention claimed. Attention to this use of the word in this act is essential to the true interpretation of its provisions in relation to re-issues.

ing, constructing, using, and compounding the same, in such full, clear, and exact terms, avoiding unnecessary prolixity, as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the same; . . . and shall particularly specify and point out the part, improvement, or combination which he claims as his own invention or discovery."

<sup>2</sup> Act of 1836, § 5: "Descriptions, specifications, and drawings;" "specifications . . . specifying what the patentee claims as his invention or discovery." Sec. 6: "Written description of his invention or discovery, . . . and specify and point out the part . . . which he claims as his own invention." Sec. 7: "Application, description, and specification;" "altering his specification to embrace only that part of the invention or discovery which is new." Sec. 12: "Description, specifications, drawings, and model;" "specifications of claim." Sec. 13: "Defective or insufficient description or specification;" "claiming in his specification as his

own invention;" "corrected description and specification;" "original description and specification." Sec. 15: "Description and specification;" "specification of claim," etc. An examination of the context in which these phrases occur renders it perfectly apparent that "specification" signifies the Claim as distinguished from the Description.

In *Wilson v. Coon* (1880), 18 Blatch. 532, Blatchford, J.: (536) "The provision of Sec. 13 of the act of 1836 was that a patent might be re-issued when it was "inoperative or invalid by reason of a defective or insufficient description or specification," and the new patent was to be issued with a corrected "description and specification." This language was based on that of Sec. 6 of the act of 1836, which required the inventor to give in writing a description of his invention and of the manner of making and using it, and also to "particularly specify and point out" what he claimed as his invention. Under this language the "specification was the Claim, and the rest was the description." 6 Fed. Rep. 611 (616); 19 O. G. 482 (483).

§ 656. Re-issues under the Act of 1836: Variations from the Act of 1832.

The language of the act of 1836 in reference to re-issues limited their allowance to cases where a patent was "inoperative or invalid, by reason of a defective or insufficient description or specification, or by reason of the patentee claiming in his specification, as his own invention, more than he had, or shall have, a right to claim as new."<sup>1</sup> Of the import of this language two different views have been taken. It has been held, on the one hand, that the words "description" and "specification" are synonymous and are applied to the delineation of the invention given for the information of the public; that any mistake or insufficiency in this delineation is remediable by re-issue; that the only form of defective Claim which is recognized by the statute or is therein made curable by a re-issue is an excessive Claim; and consequently that a too restricted Claim, though it may wholly fail to afford the patentee that protection which the law endeavors to confer upon him, cannot be so corrected and enlarged as to secure to him the actual invention except by virtue of the general provisions of the law or under the doctrines applied to similar cases in courts of equity.<sup>2</sup> On the other hand, it

§ 656. <sup>1</sup> Act of 1836, Sec. 13.

<sup>2</sup> In *Mahn v. Harwood* (1884), 112 U. S. 354, Bradley, J. : (362) "The truth is (as was shown in *Miller v. The Brass Company*) that this class of cases, namely, re-issues for the purpose of enlarging and expanding the Claim of a patent, was not comprised within the literal terms of the law which created the power to re-issue patents." 30 O. G. 657 (659).

In *Miller v. Brass Co.* (1881), 104 U. S. 350, Bradley, J. : (352) "The power given by the law to issue a new patent upon the surrender of the original, for the correction of errors and mistakes, has been greatly misunderstood and abused. It was first contained in the act of July 3, 1832, c. 357; and the law was adopted in view of suggestions made in several judgments of

this court. But it was carefully confined to cases where the patent was invalid or inoperative by reason of a failure to comply with any of the terms and conditions prescribed by the law for giving a clear and exact description of the invention, and where such failure was due to inadvertence, accident, or mistake, without any fraudulent or deceptive intention. This being shown, a new patent, with a correct specification, was authorized to be issued for the same invention. The act of July 4, 1836, c. 45, enlarged the power to grant re-issues by adding an additional ground for re-issue; namely, that the patentee had inadvertently claimed in his specification, as his own invention, more than he had a right to claim as new. And, with that addition, the law has continued substantially the same to the



has been declared that the words "description" and "specification" relate to two distinct portions of an entire instru-

present time. The fifty-third section of the act of 1870, c. 230, which was the law on this subject when the re-issue in the present case was granted, is in the following words: '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.' It will be observed that while the law authorizes a re-issue when the patentee has claimed too much, so as to enable him to contract his Claim, it does not, in terms, authorize a re-issue to enable him to expand his Claim. The great object of the law of re-issues seems to have been to enable a patentee to make the description of his invention more clear, plain, and specific, so as to comply with the requirements of the law in that behalf, which were very comprehensive and exacting. The third section of the act of 1793, c. 11, required an applicant for a patent 'to deliver a written description of his invention, and of the manner of using, or process of compounding the same, in such full, clear, and exact terms as to distinguish the same from all other things before known, and to enable any person skilled in the art or science of which it is a branch, or with which it is most nearly connected, to make, compound, and use the same. And in the case of any machine, he shall fully explain the principle, and the several modes in which

he has contemplated the application of that principle or character, by which it may be distinguished from other inventions; and he shall accompany the whole with drawings and written references, where the nature of the case admits of drawings.' This careful and elaborate requirement was substantially repeated in the sixth section of the act of 1836, with this addition: 'And shall particularly specify and point out the part, improvement, or combination which he claims as his own invention or discovery.' Although it had been customary to append a Claim to most specifications, this was the first statutory requirement on the subject. It was introduced into the law several years subsequently to the creation of re-issues; and it was in the thirteenth section of this act of 1836 that provision was made for a re-issue to correct a Claim which was too broad in the original. Now, in view of the fact that a re-issue was authorized for the correction of mistakes in the specification before a formal Claim was required to be made, and of the further fact that when such formal Claim was required express power was given to grant a re-issue for the purpose of making a Claim more narrow than it was in the original, without any mention of a re-issue for the purpose of making a Claim broader than it was in the original, it is natural to conclude that the re-issue of a patent for the latter purpose was not in the mind of Congress when it passed the laws in question. It was probably supposed that the patentee would never err in claiming too little. Those who have any experience in business at the Patent Office know the fact that the constant struggle between the Office and applicants for patents has reference to the Claim. The patentee seeks the

ment,—the former being the what is now known as “the

broadest Claim he can get. The Office, in behalf of the public, is obliged to resist this constant pressure. At all events, we think it clear that it was not the special purpose of the legislation on this subject to authorize the surrender of patents for the purpose of re-issuing them with broader and more comprehensive Claims, although, under the general terms of the law, such a re-issue may be made where it clearly appears that an actual mistake has inadvertently been made. But by a curious misapplication of the law it has come to be principally resorted to for the purpose of enlarging and expanding patent Claims. And the evils which have grown from the practice have assumed large proportions. Patents have been so expanded and idealized, years after their first issue, that hundreds and thousands of mechanics and manufacturers, who had just reason to suppose that the field of action was open, have been obliged to discontinue their employments, or to pay an enormous tax for continuing them. Now, while, as before stated, we do not deny that a Claim may be enlarged in a re-issued patent, we are of opinion that this can only be done when an actual mistake has occurred, not from a mere error of judgment (for that may be rectified by appeal), but a real *bona fide* mistake, inadvertently committed, such as a court of chancery, in cases within its ordinary jurisdiction, would correct. Re-issues for the enlargement of Claims should be the exception and not the rule; and when, if a Claim is too narrow,—that is, if it does not contain all that the patentee is entitled to,—the defect is apparent on the face of the patent and can be discovered as soon as that document is taken out of its envelope and opened, there can be no valid

Description proper, the latter Claim;” that a patent is in-

excuse for delay in asking to have it corrected. Every independent inventor, every mechanic, every citizen, is affected by such delay, and by the issue of a new patent with a broader and more comprehensive Claim. The granting of a re-issue for such a purpose after an unreasonable delay is clearly an abuse of the power to grant re-issues, and may justly be declared illegal and void. It will not do for the patentee to wait until other inventors have produced new forms of improvement, and then, with the new light thus acquired, under pretence of inadvertence and mistake, apply for such an enlargement of his Claim as to make it embrace these new forms. Such a process of expansion, carried on indefinitely, without regard to lapse of time, would operate most unjustly against the public, and is totally unauthorized by the law. In such a case, even he who has rights and sleeps upon them justly loses them.” 21 O. G. 201 (202).

The statements contained in the foregoing extract are responsible for the widely-spread impression that the case of *Miller v. Brass Co.* introduced radical changes into the law of re-issues. But the case itself, taken as a whole, warrants no such impression. In view of the facts apparent on the record, the judgment of the court was eminently just. The conclusions of the learned judge who delivered the opinion,—that a re-issue is proper only where the defect to be amended was “a *bona fide* mistake inadvertently committed;” that an unreasonable delay in applying for a re-issue indicates that the allegation of original “inadvertence or mistake is a mere pretence;” that when the defect is evident on an inspection of the patent, as is usually the case where it consists in an undue restriction of the



operative or invalid when either the Description or the Claim is defective or insufficient, or when the Claim ex-

Claim, any avoidable delay is unreasonable, — are supported not only by sound reason and the general analogies of the law, but by an almost unbroken current of judicial decisions. In reaching these conclusions, however, the court pursues the novel line of argument set forth in the passage above quoted, and seems to find the ground for its refusal to recognize the re-issued patent in the equitable doctrine that laches may forfeit an existing right, rather than in the rule of Patent Law that laches in re-issuing is inconsistent with the original existence of the right itself. An analysis of this argument results in the following propositions :—

(1) That prior to the act of 1836 the law did not require a formal Claim of the invention to be inserted in the specification.

(2) That prior to this act, therefore, the errors contemplated by the law governing re-issues, and curable by that mode of amendment, were errors in the Description, not the Claim.

(3) That when the Claim was made an essential part of the specification the law of re-issues was enlarged to embrace errors arising in the Claim.

(4) That as this extension of the law of re-issues expressly related only to errors consisting in an excess of Claim, it impliedly excluded from the operation of that law all errors which result from an undue restriction of the Claim.

(5) That, being thus excluded, the correction of an unduly restricted Claim is not within the special purpose of the legislation concerning re-issues; and, though permitted, must find its warrant in the general terms of the law and in the principles of equity.

(6) That the correction of restricted Claims is, therefore, lawful only where

a court of chancery, if the case were within its jurisdiction, would order the amendment; and though otherwise proper, may be refused whenever the patentee has slept upon his rights or when the interests of others would be unjustly prejudiced by the re-issue.

In the case under consideration the final judgment must have been the same whether attained by this mode of reasoning or by that which, treating the correction of restricted Claims as within the ordinary amending powers conferred by the statutes, regards unreasonable delay, etc., as bearing only upon the question of original inadvertence or mistake. The same would probably be true in nearly every case where the lawfulness of a re-issue was to be determined by the Patent Office or the courts. But since the propositions above enumerated in effect transfer this class of re-issues from the statutory jurisdiction of the Patent Office to the chancery jurisdiction of the courts, and render their validity dependent not merely on the conditions named in the statute but on the equities arising after the issue of the patent, thus opening a wide and deep gulf of separation between these re-issues and all others; and since these several propositions, taken as the statement of special doctrines of Patent Law, have led to decisions in many later cases which are evidently erroneous in principle; — it is important that so far as they are incorrect they should be, if possible, refuted. The fundamental error seems to reside in the deduction drawn in the second proposition from the fact stated in the first. It is true that before the act of 1836 the law did not require a *formal* Claim to be inserted in the specification; but it does not follow from this that under the provisions of preceding statutes no claim

ceeds the limits of the actual invention; and consequently that whatever may be the nature of the error, or in whatever

was necessary, or that the modes therein prescribed for avoiding or correcting errors applied solely to the Description as distinguished from the Claim. On the contrary, a claim in some form has always been an essential feature of the specification. Whether couched in words of petition or in words of grant, whether incorporated in the general description or constituting an independent clause, this definition and assertion of the exclusive right of the inventor was never absent from the instrument creating his monopoly. Moreover, this statement of his claim has always been liable to the same defects, both of undue restriction and undue excess, resulting in the partial or entire destruction of his rights, and the amending power was thus as indispensable to him for the correction of imperfect claims as for the removal of obscurities from his description. Hence, as this power was granted professedly for his protection, it might safely be assumed that an amendment by enlarging restricted claims in order that they may include the whole invention, or by restricting claims to exclude what he had at first improperly embraced, should be as lawful and as readily permitted as the substitution of a clearer or a more complete description. Our courts proceeded upon this assumption before the act of 1832 was passed. In *Morris v. Huntington* (1824), 1 Paine, 348, Thompson, J. advances the opinion that where the patentee has claimed too much he may surrender, and take out an amended patent. In *Grant v. Raymond* (1832), 6 Peters, 218, the amendment which the court sustained was an enlargement of the Claim; and in the decision, Marshall, C. J., states that both the statutes which confer the patent, and the amending power which corrects its inadvertent errors, have for

their chief object the protection of the inventor in the enjoyment of his actual invention; replying to the argument that by such amendments public interests are prejudiced by saying: "the communication of the discovery to the public has been made in pursuance of law with the intent to exercise a privilege which is the consideration paid by the public for the future use of the machine. If, by an innocent mistake, the instrument introduced to secure this 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." The act of 1832 was enacted, as Baldwin, J., declares in *McClurg v. Kingsland* (1843), 1 How. 202, in affirmance of the principles laid down in *Grant v. Raymond* and other cases. Among the re-issues while this statute was in force, was that involved in *Stimpson v. Westchester R. R. Co.* (1846), 4 How. 380, in which the claims of the patent had been enlarged by including an element referred to in the original Description but omitted from its Claim. The Supreme Court, through McLean, J., held that this enlargement of the Claim did not, as matter of law, invalidate the re-issue. These cases, as well as the reason of the law itself, sufficiently demonstrate that before the act of 1836, though no "formal Claim" was required by law, the existence of the claim, its susceptibility to error, and the power to amend it by restriction or extension as might be necessary to render the patent valid and operative in the interest of the inventor, were as clearly recognized as by any subsequent statute or decision. Indeed, this entire



part of the instrument it may occur, the statute provides for

portion of the argument appears to rest upon a misconception of the act of 1832 in its relation to the act of 1793, and of the true meaning of the term "specification" as it is employed in the act of 1836. See § 654, *ante*.

With the demolition of this fundamental error, the other portions of the argument also fall. If the Claim in some form had always been a feature of the specification, and if its faults of excess or deficiency were amendable by re-issue under and prior to the act of 1832, evidently no extension of the law of re-issues was intended or effected by the enumeration in the act of 1836 of the excessive Claim among the subjects of amendment. And if no such extension of the law occurred, there is no ground for the inference contained in the fourth proposition that a restricted Claim is not among the faults which a re-issue was expressly designed to cure, or for that in the fifth which bases the privilege of re-issuing in these cases upon general principles, and by the operation of the sixth imposes upon them conditions which are foreign to re-issues for the removal of other unintentional defects.

The extent to which these controverted opinions have been shared or adopted may be seen in the cases cited in the remaining portion of this note. It may fairly be questioned whether in most of them the position taken on this subject represents the deliberate judgment of the court. The ease with which sweeping statements, shorn of all qualifying phrases, are caught up and enunciated, especially in the reasonings as distinguished from the final decision of a judge, may account for what seems a striking departure from the general current of authority as exhibited in the succeeding note. In several of these cases, also,

there are other statements which clearly show that the court had no intention to deny the right to correct an unduly restricted Claim in the same manner and upon the same conditions as any other defect occurring in the specification.

That a re-issue is not allowed except to give a more perfect description of the invention intended to be claimed in the original patent, or to narrow an excessive Claim, see *Giant Powder Co. v. California Vigorit Powder Works* (1880), 6 Sawyer, 508; 18 O. G. 1339; 4 Fed. Rep. 720; *Knight v. Baltimore & Ohio R. R. Co.* (1840), 3 Fisher, 1; Taney, 106.

That a re-issue cannot enlarge or expand the Claims of the original, see *Dunbar v. White* (1883), 15 Fed. Rep. 747; 23 O. G. 1446; *Nye v. Allen* (1883), 15 Fed. Rep. 114; 23 O. G. 2328; *Fay v. Preble* (1882), 14 Fed. Rep. 652; *Moffitt v. Rogers* (1882), 106 U. S. 423; 23 O. G. 270; *New v. Warren* (1882), 22 O. G. 587; *James v. Campbell* (1881), 104 U. S. 356; 21 O. G. 337.

That a re-issue cannot claim what is described but not claimed in the original, see *Reed v. Chase* (1885), 25 Fed. Rep. 94; 33 O. G. 996; *Ex parte Pfaudler* (1882), 22 O. G. 1881.

That it is the office of a re-issue to correct a Claim, not to enlarge it, see *Russell v. Dodge* (1876), 93 U. S. 460; 11 O. G. 151.

That the enlargement of the Claims of the original makes a re-issue void, as against the public as well as against intervening patentees, see *Dunbar v. White* (1883), 15 Fed. Rep. 747; 23 O. G. 1446.

The numerous cases, found in the notes to ensuing paragraphs, which assert that unreasonable delay, or the existence of intervening rights, or the

its amendment by re-issue.<sup>8</sup> That the latter view is the true one there are several indications in the body of the act itself.

appropriation of the unclaimed matter by the public, etc., work a forfeiture of the patentee's right to a re-issue, generally draw their erroneous doctrine from the same source, regardless of the principle that a privilege conferred by the statutes upon certain conditions cannot be abrogated by the courts if those conditions are fulfilled, whatever power the courts may have to determine by what kind and degree of evidence their fulfillment must be proved.

<sup>8</sup> In *Odell v. Stout* (1884), 22 Fed. Rep. 159, Sage, J. : (162) "It is to be kept in mind, however, that enlarging the Claim may be an entirely different thing from broadening the invention. He may, under proper circumstances, so enlarge his Claim as to make it extend to the limits of his invention, but he is bound by those limits. He may not enlarge the invention. . . . (164) Upon the authority of these cases it is clear that the Claim of a patent may be enlarged by a re-issue, if the patentee move promptly and no rights of others have intervened ; and we are of opinion that in this case the delay was not unreasonable." 29 O. G. 862 (863).

In *Combined Patents Can Co. v. Lloyd* (1882), 21 O. G. 713, Butler, J. : (714) "That this statute authorizes the insertion of new Claims, founded on the original invention as exhibited by the specifications or drawings, in re-issues when the omission results from 'inadvertence, accident, or mistake,' and where the claimant has not by some act or omission estopped himself from exercising the right to amend, has been uniformly held, not only by the several circuit courts, but by the Supreme Court also. In *Seymour v. Osborne* (11 Wall. 516), the latter court said : 'Power is unquestionably conferred upon the Commissioner to allow the specifications to

be amended if the patent is inoperative or invalid, and in that event to issue the patent in proper form ; and he may under that authority allow the patentee to re-describe his invention and to include in the Description and Claims of the patent not only what was well described before, but whatever else was suggested or substantially indicated in the specifications or drawings which properly belonged to the invention as actually made and perfected.' The re-issue there involved, it is true, antedated the statute now in force, but as respects the question here involved this is unimportant, as before indicated. In the last cases in which this subject is discussed (*Miller & Co. v. The Brass Company*, and *James v. Campbell et al.*) . . . the right to insert new and enlarged Claims is clearly stated. In the first of these cases the court says : 'If a patentee who has no corrections to suggest in his specifications except to make his Claims broader and more comprehensive, uses due diligence in returning to the Patent Office, and says, "I omitted this," or "my solicitor omitted that," his application may be entertained, and on proper showing correction may be made.' And again, 'While, as before stated, we do not deny that a Claim may be enlarged in a re-issued patent, we are of opinion that this can only be done where an actual mistake has occurred, . . . a real *bona fide* mistake, inadvertently committed, such as a court of chancery in cases within its ordinary jurisdiction would correct. Re-issues for the enlargement of Claims should be the exception.' In the last of these cases it is said, 'Of course, if by actual inadvertence, accident, or mistake, innocently committed, the Claim does not fully assert or define the patentee's right in the invention specified in the patent, a speedy appli-



In the first place, this view gives full effect to the language of the act in reference to this subject. It preserves the distinc-

tion for its correction before adverse rights have accrued may be granted, as we have explained in the recent case of *Miller et al. v. The Brass Company.*" 11 Fed. Rep. 149 (150); 15 Phila. 481 (482).

See also *James v. Campbell* (1881), 104 U. S. 356; 21 O. G. 337.

In *Marsh v. Seymour* (1877), 97 U. S. 348, Clifford, J. : (355) "Patents, in a proper case, may be surrendered and re-issued, but the re-issued patent must be for the same invention as the original patent, else the re-issue is invalid; but the patentee may redescribe his invention, and include in the Description and Claims of the specification not only what was well described before, but whatever else was suggested or substantially indicated in the old specification, drawings, or Patent-Office model, which properly belonged to the invention as actually made and perfected. Corrections may be made in the Description, specification, or Claims of the patent where the patentee has claimed as new more than he had a right to claim, or where the Description, specification, or Claim is defective or insufficient; but he cannot, under such an application, make material additions to the invention which were not described, suggested, nor substantially indicated in the original specifications, drawings, or Patent-Office model." 13 O. G. 723 (725).

In *Welling v. Rubber-Coated Harness Trimming Co.* (1875), 2 Bann. & A. 1, Nixon, J. : (4) "It is a well-settled principle that a patentee may so limit his Claim as to deprive himself of the full benefit of his invention or discovery. It was to remedy such a difficulty or omission that the privilege of surrender and re-issue was granted in the Patent Laws. Patentees often fail to realize any substantial advantage

from some of the most useful inventions owing to their too narrow Claims, until such surrender, amendment, and re-issue have been made." 7 O. G. 608 (609).

In *Calkins v. Bertrand* (1875), 2 Bann. & A. 215, Blodgett, J. : (217) "This re-issue was made on the 26th of April, 1870, and while the Patent Office was acting under the law of 1836, as amended. . . . This law has been construed to authorize a patentee to claim on a re-issue whatever shall clearly appear to have been a part of his original invention as described or shown in his original specifications, drawings, or models. There are ample authorities upon that point construing the act of 1836 with amendments up to 1861, in that regard, and giving the inventor the right to a re-issue where the new Claim is clearly justified by his drawings, or specifications, or models, or either, and allowing him to amend his specifications, if necessary, so as to cover more fully what, upon experience, has proven to be a meritorious part of his invention. *Battin v. Taggart*, 17 How. 74; *Gallahue v. Butterfield*, 10 Blatchf. C. C. R. 232; *Wheeler v. Clipper Co.*, 6 Fisher, 1; *Seymour v. Osborne*, 11 Wall. 544." 6 Bissell, 494 (496); 9 O. G. 795 (796).

In *Wells v. Jacques* (1874), 1 Bann. & A. 60, Nixon, J. : (68) "With regard to the first objection, it is undoubtedly true that it is not the province or the design of a re-issue to enlarge the original right of the inventor, but to cure some defect arising from inadvertency or mistake, and not from fraud, in drawing the specifications or Claims of the first patent. Every inventor is entitled to the benefit of all that he invents; and if he fails, for the reason above assigned, to acquire a right to his whole invention in his letters-patent,

tion which the act evidently makes between the Description and the specification, and recognizes a defect or insufficiency

he may surrender them and have a re-issue from time to time, until his specifications and Claims cover the whole ground." 5 O. G. 364 (366).

In *Blake v. Stafford* (1868), 6 Blatch. 195, Shipman, J. : (198) "Inventors are not usually sufficiently skilled in the art of nice composition to enable them to accurately draft their own specifications. They must, therefore, resort to others; and it not unfrequently happens that the draftsman employed to describe a particular invention, either through want of skill or from haste or ignorance of the state of the art, gives, in the specification, a very imperfect description of the thing invented. He sometimes narrows the scope of the inventor's ideas and combinations, and at other times expands them over instruments and devices which are not the product of his original thoughts. He may fail to set forth some feature of the invention which at the time is deemed unimportant, and which subsequently may be proved to be vital, or at least of great value. If the invention is of considerable pecuniary consideration, the public examine it with scrutinizing eyes, and if an inch of ground within the true scope of the discovery is unoccupied by the specification, it is at once seized upon by parties to whose business the new improvement has a near relation. If a fatal or damaging error has crept into the description, that fact is soon ascertained by those who desire to avail themselves of whatever improvement has been discovered. The privilege of surrender and re-issue is, therefore, invaluable to inventors, for without it they would often lose that protection for the offspring of their skill and labor which it is the immediate object of all patent laws to afford. It is, indeed, to be regretted that so great a

proportion of the industry and intellectual acumen expended upon patents should be devoted to assailing, circumventing, or defeating them, rather than to their original construction. But the greatest skill and most untiring patience would not always be able to guard against all error. The privilege of surrender and re-issue is, therefore, necessary for the protection of inventors, and the act of Congress has explicitly stated the cases to which it shall extend, and conferred upon the Commissioner the power of determining when a patentee has brought himself within its provisions." 3 Fisher, 294 (299).

In *Swift v. Whisen* (1867), 3 Fisher, 343, Leavitt, J. : (352) "On this subject I may remark in deciding what a party may claim under a re-issued patent, there has been a tendency to great liberality in the action of the courts, and it has been held that whatever was the invention of the original patentee, whether expressly claimed in the original patent or not, when incorporated in the re-issued patent, will be held to be within the Claim of the original patent, and that it is the right of the assignee or holder of the patent to claim everything that was claimed, or everything which belonged rightfully, by fair construction, to the original patentee. I may not be understood. If there is evidence that the original patentee claimed, as a part of his invention, a certain feature, or that a certain feature was a part of his invention which he omitted to claim in his specification and Claim, upon the surrender of that patent by himself, or by an assignee, he has a right to incorporate in the re-issued patent that element, though not claimed specially in the first patent. And in determining this question, that



in either as a proper matter for amendment. It treats the adjectives "defective" and "insufficient" as covering two different classes of errors, the former consisting in want of exactness, the latter in want of completeness, instead of regarding the second as a substantial repetition of the first. It makes the field of amendment commensurate with the field of error, — all possible errors being comprised in inexactness and incompleteness of the Description, and in inexactness, incompleteness, and excessiveness of the Claim. In the second

is, the substantial identity of the invention covered by the original patent with that covered and described in the re-issued patent, it is competent for the jury to look into the drawings of the original patent to determine whether the inventions are the same. The drawings, as well as the specifications, are to be looked to in giving a construction to the Claims of a patent, in determining what was the invention of the original patentee. If, for instance, the drawings show an element of the invention which the patentee has not included specially in his Claim, it is evidence nevertheless that it was a part of his invention, and he or his assignee has a right to incorporate that element in the re-issued patent." 2 Bond, 115 (127).

Further, that the re-issue may so enlarge or otherwise modify the Claims of the original as to secure the actual invention, see *Jenkins v. Stetson* (1887), 32 Fed. Rep. 398; *Becker v. Hastings* (1884), 28 O. G. 98; 22 Fed. Rep. 827; *Ex parte Long* (1883), 25 O. G. 1189; *Crandall v. Watters* (1881), 9 Fed. Rep. 659; 20 Blatch. 97; 21 O. G. 945; *Smith v. Merriam* (1881), 6 Fed. Rep. 713; 19 O. G. 601; *Waring v. Johnson* (1881), 19 O. G. 1068; 19 Blatch. 38; 6 Fed. Rep. 500; *Miller v. Brass Co.* (1881), 104 U. S. 350; 21 O. G. 201; *Anilin v. Higgin* (1878), 15 Blatch. 290; 14 O. G. 414; 3 Bann. & A. 462; *Lorillard v. McDowell* (1877), 2 Bann. & A. 531; 11 O. G. 640; 13

Phila. 461; *Westinghouse v. The Gardner & Ranson Air Brake Co.* (1875), 9 O. G. 538; 2 Bann. & A. 55; *Seymour v. Marsh* (1872), 2 O. G. 675; 6 Fisher, 115; 9 Phila. 380.

That a Claim is part of the specification and therefore amendable, see *Smith v. Merriam* (1881), 19 O. G. 601; 6 Fed. Rep. 713.

That an enlarged Claim is allowable in a re-issue, if there are no adverse rights to be affected by it, see *Stutz v. Armstrong* (1884), 20 Fed. Rep. 843; 28 O. G. 367; *McArthur v. Brooklyn Railway Supply Co.* (1884), 19 Fed. Rep. 263; 21 Blatch. 558.

That a re-issue is the proper mode of securing what was described but not claimed in the original patent, see *Asmus v. Alden* (1886), 27 Fed. Rep. 684; 36 O. G. 231; *Hill v. Commissioner* (1885), 33 O. G. 757; 4 Mackay, 266; *Ex parte Cottrell*, (1876), 9 O. G. 495; *Richardson v. Lockwood* (1870), 4 Clifford, 128.

That a re-issue is the only mode of securing what was accidentally omitted from the original, see *Keystone Bridge Co. v. Phoenix Iron Co.* (1877), 95 U. S. 274; 12 O. G. 980.

That an element shown but not claimed in a prior patent, yet patentable thereby if it had been claimed, can be secured by re-issue or by a separate patent, see *Loring v. Hall* (1879), 15 O. G. 471.

place, this view is in harmony with the entire tenor of the act. The act is characterized by a spirit of great liberality toward inventors. The benefits which it confers upon them are incalculable. Even in the very section which provides for a re-issue the privilege of incorporating subsequent improvements and additions into an existing patent, with the same effect in law as if embraced in the patent as originally issued, was accorded, — a privilege far beyond the scope of any conceivable amendment in the Description or Claim of the original invention; and it can scarcely be supposed that the same legislature which conferred this privilege intended to deprive inventors of that remedy for insufficient Claims which had already been found necessary by the courts and had been granted by the act of 1832. In the third place, this view is the only one under which the remedy by re-issue is of any practical advantage to inventors. The value of a patent to the patentee depends upon the completeness with which it protects his actual invention, and as the limits of the protection are fixed by the Claim, a mistake by which the Claim is unduly restricted is, more than any other error, injurious to the inventor, and in his interest more imperatively demands correction. To permit him to amend by giving more specific information to the public, or by narrowing the Claims of his original patent, or by stating in more precise language the Claim that he has already made to the invention, affords him no adequate relief against the evils that inevitably arise out of the inherent difficulty which attends the endeavor to put into words a complete delineation of those essential characteristics in which the identity and individuality of the invention reside. If in any portion of the instrument error is likely to occur it is here; and if any error seriously prejudices his interests it is the one by which his patent is made narrower than his invention. And hence, if any error ought to be corrected, when occurring without wilful fault on his part, it is the one whereby he is deprived of that right to which he is entitled both by the spirit and the letter of the law. For these three reasons, and others which a careful study of the act itself suggests, it seems that of the two views of the rule above described the latter is correct; and that this act con-



fers the privilege of a re-issue whenever the Description or the Claim is inexact or incomplete, or when the Claim is broader than the actual invention, provided the error has arisen from inadvertence, accident, or mistake, and without any fraudulent or deceptive intention.<sup>4</sup>

§ 657. **Re-issues under the Act of 1870 and the Revised Statutes of 1874.**

Under the act of 1870 and the Revised Statutes, the law governing re-issues is the same as under the act of 1836. The phrasology of these later acts differs from that of the earlier in some unimportant respects, but it is evident that no intent to change the rules existed at the passage of these statutes, and that the language used was regarded as substantially identical with that of the former act.<sup>1</sup> This being the case, the law may now be considered as providing for

<sup>4</sup> That both the Description and the Claims may be corrected by re-issue, see *Sewing Mach. Co. v. Frame* (1884), 24 Fed. Rep. 596 ; 28 O. G. 96 ; *Hailes v. Albany Stove Co.* (1883), 16 Fed. Rep. 240 ; 24 O. G. 391 ; 21 Blatch. 271 ; *Wilson v. Coon* (1880), 6 Fed. Rep. 611 ; 19 O. G. 482 ; 18 Blatch. 532 ; *Anilin v. Higgin* (1878), 14 O. G. 414 ; 15 Blatch. 290 ; 3 Bann. & A. 462 ; *Tucker v. Tucker Mfg. Co.* (1876), 10 O. G. 464 ; 4 Clifford, 397 ; 2 Bann. & A. 401 ; *Carew v. Boston Elastic Fabric Co.* (1871), 3 Clifford, 356 ; 5 Fisher, 90 ; 1 O. G. 91 ; *Batten v. Taggart* (1854), 17 How. 74.

§ 657. <sup>1</sup> Act of 1870, Sec. 53: "That 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," etc. Act of 1836, Sec. 13: "That whenever any patent . . . shall be inoperative or invalid, by reason of a defective or insufficient [description or] specification, or by reason of the patentee claiming [in his specification] as his own invention

more than he had or shall have a right to claim as new," etc. The difference between these two provisions consists simply in the omission from the act of 1870 of the words here included in brackets in the act of 1836. The change is evidently verbal, not substantial. The word specification is used in its modern sense as covering the Description as well as the Claim, and the patent is treated as a proper subject for re-issue when either is defective or insufficient. That this alteration in language was not intended to limit re-issues to cases where the Description as distinguished from the Claim is defective or insufficient appears from the final clause of Sec. 53, which permits the introduction into the re-issue specification of matter wholly omitted from the original, upon proof that it constituted part of the original invention, and was omitted by inadvertence, accident, or mistake. The Revised Statutes, Sec. 4916, follow the act of 1870, Sec. 53, so far as this point is involved. See *Wilson v. Coon* (1880), 6 Fed. Rep. 611; 19 O. G. 482; 18 Blatch. 532.

the re-issue of a patent whenever it becomes necessary to amend either the Description or the Claim in order to make the actual invention accessible to the public, or to afford it that complete and exact protection to which its inventor is entitled.<sup>2</sup>

§ 658. **Conditions of Re-issue the Same under all the Foregoing Statutes.**

The conditions upon which an amendment by re-issue might be made have remained the same under all these statutes. These are that the defect or insufficiency should have arisen through inadvertence, accident, or mistake, and without any fraudulent or deceptive intention. A defective or insufficient statement, purposely inserted with intent to deceive the public, is regarded as a fraud which vitiates the entire patent and justly forfeits all right of the inventor to any consideration from the government. Such a statement cannot be amended in any form. A defective or insufficient statement, occurring otherwise than through inadvertence, accident, or mistake, is also not amendable. "Inadvertence" signifies want of attention; "mistake," want of knowledge; "accident," circumstances against which the inventor cannot guard. A statement, made without inadvertence, accident, or mistake, is a statement made voluntarily and with sufficient knowledge and attention. If a statement thus made in the Description is defective or insufficient, the inventor is guilty of wanton negligence, if not of fraud, and certainly ought not to be permitted to amend. If a statement thus made in the Claim is incomplete, the inventor is precluded from correcting it on the ground that he has either abandoned the unclaimed matter to the public, or has excluded it from the present monopoly and reserved it for the protection of an independent patent. If the Claim is wilfully and with knowledge and attention made obscure or broader than his actual invention, it is evidently fraudulent and void. Of these questions of inadvertence, accident, mistake, and fraud, the Patent Office is to judge upon an application for re-issue; though where an

<sup>2</sup> See Sec. 656, note 3, *ante*, for cases on this subject decided since the passage of the act of 1870.



alleged incompleteness in the Claim is so apparent upon a comparison of the Description with the Claim that it could not have occurred involuntarily or through any want of knowledge or attention, or where unreasonable delay in obtaining a re-issue, or other circumstances in the history of the application or the patent, show that no inadvertence, accident, or mistake could have originally existed, the courts regard it as conclusive evidence that the inventor intended to exclude from his original patent all that was not duly claimed, and treat a re-issue which endeavors to reclaim it as to that extent invalid.

**§ 659. The Fundamental Principles Governing Amendment by Re-issue Reducible to Four Propositions.**

This review of the historical development of the subject of re-issues suggests the following propositions as representing the present doctrines of the law in reference thereto:<sup>1</sup> (1) That the sole object of a re-issue is to so amend an imperfect existing patent that it may disclose and protect the patentable subject-matter which it was the purpose of that patent to secure to its inventor; (2) That being the amendment of an existing patent, and not the grant of a new patent, it must be confined to the invention which the patentee attempted

§ 659. <sup>1</sup> The first three of these propositions express the fundamental conditions of amendment by re-issue, the absence of any one of which is a perfect bar to its allowance. The original patent must be an existing patent, otherwise there is nothing to amend; and it must be an imperfect patent, otherwise there can be no defect requiring an amendment. The subject-matter of the amendment must be the invention which the patentee endeavored to describe and claim in the original patent, otherwise the re-issue would be a new patent for a different invention, and not a mere amendment of the old. The defect must have occurred through inadvertence, accident, or mistake, and without fraud, or the pretended amendment would, in the first case, be a recla-

mation of matter already voluntarily excluded from the patent; or in the second, the original patent, and therefore the re-issue, would be wholly void. The absence of either one of these conditions is thus fatal to the re-issue. If two or all of them are wanting, the effect on the re-issue is the same. Hence it makes no stronger case against a re-issued patent to combine objections based upon the failure of these requisites than if one alone were proved. Caution to this effect would be unnecessary were not many decisions to be found in which the concurrence of these faults is given as the reason for rejecting the re-issue, — as if a partial one could be supported by the existence of the others, or as if one alone were not sufficient to render it invalid.

to describe and claim in his original patent; (3) That this amendment cannot be allowed unless the imperfections in the original patent arose without fraud, and from inadvertence, accident, or mistake; (4) That when the amendment is allowable it can be made in any form and to any extent that may be necessary to render the patent effective for the protection of the original invention. The discussion of these propositions, and of the proceedings in obtaining a re-issue, will occupy the remainder of this section.

**§ 660. First Proposition: Sole Purpose of a Re-issue is to so Amend an Imperfect Patent that it may Protect the Patentable Subject-Matter which the Original Patent Attempted to Secure to its Inventor.**

The truth of the first proposition, — that the sole purpose of a re-issue is to amend an imperfect patent in order that it may disclose and protect the proper subject-matter of the original patent — is self-evident. Being the method of amending a patent it pre-supposes a patent to amend. A patent void *ab initio* from any cause, as where it issues on a false oath of citizenship, or to alleged joint-inventors for a sole invention, is not an existing patent nor capable of becoming one by any process of amendment.<sup>1</sup> Whatever remedy there may be in such a case must be sought by an application for new letters-patent, not by a re-issue of the old. A perfect patent requires no re-issue. Changes in its language cannot

§ 660. <sup>1</sup> That a void patent cannot be re-issued, see *Marsh v. Nichols* (1883), 15 Fed. Rep. 914; 24 O. G. 901; *Ex parte Benton* (1882), 23 O. G. 341; *Child v. Adams* (1854), 1 Fisher, 189; 3 Wall. Jr. 20.

That where the defect in the original consists in a false oath of citizenship, it is void and cannot be re-issued to cure the defect, see *Child v. Adams* (1854), 1 Fisher, 189; 3 Wall. Jr. 20.

That a patent issued on an application signed and sworn to in blank, and afterwards filled out by the attorney, is void, and cannot be re-issued, see *Ex parte Benton* (1882), 23 O. G. 341.

That a joint patent for a sole invention being invalid no re-issue of it can be granted, see *Ex parte Benton* (1882), 23 O. G. 341; *Ex parte Boursaloux* (1878), 14 O. G. 233.

That if it appears on the face of the re-issue application that the original patent was void, the application will be dismissed, see *Ex parte Benton* (1882), 23 O. G. 341.

That an expired patent cannot be re-issued, see *Ex parte Siemens* (1877), 11 O. G. 1107; *Ex parte Pulvermacher* (1876), 10 O. G. 2.



be amendments unless the language were before defective, and though the former patent may have been surrendered and a new one has been granted by the Patent Office, yet if the former needed no amendment, the two are in all respects substantially the same, and the last is a mere duplication of the other.<sup>2</sup> An existing imperfect patent is thus the sole subject for a re-issue. The defects by which an existing patent can be rendered imperfect are specified by the statutes as any invalidity or inoperativeness arising from inexactness or incompleteness in the Description, or from inexactness, or

<sup>2</sup> By a "perfect patent," as the phrase is here employed, is meant a patent which completely covers and protects the invention which the patentee endeavored to secure. As appears hereafter in this paragraph, a patent may be perfect *in itself*; *i. e.*, it may cover patentable subject-matter and be free from all ambiguity, and thus be valid and operative when judged by the standard of such patentable subject-matter, and yet be wholly invalid and inoperative when measured by the actual invention which it was intended to include. That in this case the patentee is entitled to a re-issue cannot now be doubted. See notes 5 and 6, *post*. Certain decisions, however, are reported in which the power of the Commissioner to re-issue a patent that is valid and operative in itself seems to be denied, and in some of these the courts are said to have authority to review the judgment of the Commissioner on this point, and, on finding the original patent perfect *per se*, to declare the re-issue void. See § 714 and note, *post*.

Thus that no re-issue is proper unless the original is inoperative or invalid for a defective specification, or claims too much, and if the original shows on its face that this is not so, the re-issue will be void, see *James v. Campbell* (1881), 104 U. S. 356; 21 O. G. 337; *Flower v. Rayner* (1881), 19 O. G. 425; 5 Fed. Rep. 793; *Giant Powder*

*Co. v. California Powder Works* (1875), 3 Sawyer, 448; 2 Bann. & A. 131; *Burr v. Duryee* (1863), 1 Wall. 531.

That where the original is valid and operative to the extent of its Claim, there is no reason for the re-issue and the re-issue is void, see *Giant Powder Co. v. California Vigorit Powder Co.* (1880), 18 O. G. 1339; 4 Fed. Rep. 720; 6 Sawyer, 508.

That where the only difference between the original and the re-issue is that the re-issue specification has the broader scope, the original would be valid if the re-issue is, and hence there was no reason for the re-issue and the re-issue will be void, see *Giant Powder Co. v. California Vigorit Powder Co.* (1880), 18 O. G. 1339; 4 Fed. Rep. 720; 6 Sawyer, 508.

As shown in § 714 and note, these positions are not correct. A re-issue cannot be held void even on the ground that it apparently reproduces the original patent, the decision of the Commissioner on the necessity for a re-issue being final. And that the validity and operativeness of the original patent, with reference to one invention, constitute no bar to its re-issue whenever the monopoly which it defines is not co-extensive with that which the patentee intended and attempted to secure, is evidenced by numerous decisions hereafter cited. See also *Smith v. Merriam* (1881), 6 Fed. Rep. 713; 19 O. G. 601.

incompleteness, or excess in the Claim. By enumerating these the statutes exclude all others, and confine the remedy to these alone.<sup>3</sup> "Invalidity" is any defect on account of which a patent might be declared invalid by the courts. It occurs whenever the Description is not sufficiently precise and complete to enable persons skilled in the art to practise the invention, or where the Claim is broader than the actual invention.<sup>4</sup> "Inoperativeness" is any defect, by reason of which the patent fails to give to the invention the protection which it was intended to afford. This occurs whenever the Claim is so obscure or so restricted that the exact limits of the invention entitled to protection are not clearly and correctly defined. In judging as to the existence of these defects, the nature of the invention which the patent was intended to protect must be kept constantly in view. A patent may be valid and operative as to one invention and not as to another. Thus where an invention is reached by several steps, or is composed of several parts, each of which is a separate invention, either of these may be sufficiently described and claimed, and yet the patent be invalid and inoperative as to the principal invention which it was chiefly intended to secure. That a patent is valid and operative to the extent that it discloses and protects some patentable invention does not, therefore, render it a perfect patent.<sup>5</sup> The object of the in-

<sup>3</sup> In *Giant Powder Co. v. California Vigorit Powder Co.* (1880), 6 Sawyer, 508, Field, J. : (520) "As thus seen, a re-issue can only be had when the original patent is inoperative or invalid from one of two causes,—either 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. And even then the patentee can only obtain a re-issue where the error has arisen from inadvertence, accident, or mistake, and without any fraudulent or deceptive intention." 4 Fed. Rep. 720 (723); 18 O. G. 1339 (1340).

That the provisions of the statute

defining the conditions under which a patent may re-issue impliedly forbid it under any other conditions, see *Ex parte Whitely* (1886), 36 O. G. 1243; *Child v. Adams* (1854), 1 Fisher, 189; 3 Wall. Jr. 20.

<sup>4</sup> That where the Description is not full and clear a re-issue is needed, see *Sewing Mach. Co. v. Frame* (1884), 28 O. G. 96; 24 Fed. Rep. 596.

<sup>5</sup> In *Giant Powder Co. v. Safety Nitro Powder Co.* (1884), 10 Sawyer, 23, Sawyer, J. : (24) "A patent may be inoperative in my judgment, when it is inoperative in part. I do not think it must be absolutely inoperative in its entirety. If it is inoperative so far as not to cover all that the party is entitled



ventor in procuring it, and of the government in granting it, was to render accessible to the public, and for the time being to secure to the inventor, a specific invention or group of inventions, and if the patent, as it stands, does not accomplish this object it is invalid and inoperative within the meaning of the law, and may be amended by re-issue.<sup>6</sup>

§ 661. Failure to Describe or Claim Matter outside the Invention not a Defect in the Patent.

It is obvious that no patent can be invalid and inoperative by reason of its failure to describe and claim matter lying outside the limits of that invention which, having been conceived by the inventor and reduced to practice, the govern-

to claim, and what he is entitled to claim appears in the specifications, it being inoperative to that extent, I think it would be inoperative within the meaning of the provisions of the statute, and entitle the party to a re-issue covering his entire invention." 19 Fed. Rep. 509 (510); 27 O. G. 99 (100).

In *Wilson v. Coon* (1880), 18 Blatch. 532, Blatchford, J. : (536) "A patent may be inoperative from a defective or insufficient description, because it fails to claim as much as was really invented, and yet the Claim may be a valid Claim, sustainable in law, and there may be a description valid and sufficient to support such Claim. In one sense such patent is operative and is not inoperative; yet it is inoperative to extend to or claim the real invention, and the description may be defective or insufficient to support a Claim to the real invention, although the drawings and model show the things in respect to which the defect or insufficiency of description exists, and show enough to warrant a new Claim to the real invention. It can never be held, as it never has been held in a case where the point arose for decision, that a patent cannot be re-issued where a suit could be sustained on the specifica-

tion and Claim as they were." 6 Fed. Rep. 611 (615); 19 O. G. 482 (483).

See also *Hartshorn v. Eagle Shade Roller Co.* (1883), 18 Fed. Rep. 90; 25 O. G. 1191.

That "not fully operative" is "inoperative," see *Hartshorn v. Eagle Shade Roller Co.* (1883), 25 O. G. 1191; 18 Fed. Rep. 90.

That a specification may be inoperative as to some parts of the invention and not as to others, and its inoperativeness as to the others may not have been discovered until long after its issue, see *Thomson v. Wooster* (1885), 114 U. S. 104; 31 O. G. 913.

That where the original patent is ambiguous and on that account inoperative, it may be explained by a re-issue if the Commissioner is satisfied that the inventions are the same, see *Ex parte Gottstein* (1877), 11 O. G. 1061.

<sup>6</sup> That where the Claims of the original patent were unnecessarily restricted, the re-issue may correct them and cover the whole invention, see *Schuessler v. Davis* (1878), 13 O. G. 1011.

That a re-issue is proper when the specification is imperfect, though the drawings and model are perfect, see *Wilson v. Coon* (1880), 6 Fed. Rep. 611; 18 Blatch. 532; 19 O. G. 482.

ment, by issuing that patent, originally endeavored to protect. If the idea of means had possibilities of further development or application, which the inventor did not then perceive, these did not enter into his actual invention. If his idea, as already conceived and apprehended, was divisible into other ideas of means, only a part of which had been reduced to practice, the latter alone could have constituted his invention. If his idea presented different aspects, capable of embodiment in essentially distinct inventions, each of which would have formed matter for an independent patent, the one selected by him as the subject of the patent whose amendment is in question is the sole invention which that patent could, if perfect, have secured. The limits of this invention thus exclude all new developments of the idea of means which have taken place since the original patent issued, all ideas which were not reduced to practice before the application for the original patent, and all distinct and independent parts or forms of the invention which were not embraced within the subject-matter of the patent already issued; and therefore no defect or insufficiency of statement concerning these can render the original patent inoperative or invalid, or furnish an occasion for its amendment. All that it can be made to cover, by any degree or species of correction is that completely *conceived*, *perceived*, and practically operative means for which the inventor then sought and the government then bestowed protection.<sup>1</sup> Intervening inventions, whether wholly distinct

§ 661. <sup>1</sup> In *Manufacturing Co. v. Ladd* (1880), 102 U. S. 408, Bradley, J.: (413) "A re-issue can only be granted for the same invention which was originally patented. If it were otherwise, a door would be opened to the admission of the greatest frauds. Claims and pretensions shown to be unfounded at the time might, after the lapse of a few years, a change of officers in the Patent Office, the death of witnesses, and the dispersion of documents, be set up anew, and a reversal of the first decision obtained without an appeal, and without any knowledge of the previous investigations on the subject. New

light breaking in upon the patentee as the progress of improvement goes on, and as other inventors enter the field, and his monopoly becomes less and less necessary to the public, might easily generate in his mind an idea that his invention was really more broad and comprehensive than had been set forth in the specification of his patent. It is easy to see how such new light would naturally be reflected in a re-issue of the patent, and how unjust it might be to third parties who had kept pace with the march of improvement. Hence there is no safe or just rule but that which confines a re-issued patent to the



or consisting in substantial variations in or improvements on the old, subsequently discovered attributes of the invention

same invention which was described or indicated in the original." 19 O. G. 62 (64).

That a re-issue cannot cover more than the original invention as determined by the state of the art at the date of the first patent, see *Carlton v. Bokee* (1873), 17 Wall. 463; 6 Fisher, 40; 2 O. G. 520.

That a re-issue cannot embrace any invention other than that which the patentee had fully invented and the government had endeavored to protect by the original patent, see *Cornell v. Weidner* (1888), 127 U. S. 261; 43 O. G. 985; *Haines v. Peck* (1886), 26 Fed. Rep. 625; 35 O. G. 1227; *Hubel v. Dick* (1886), 24 Blatch. 139; 28 Fed. Rep. 656; 37 O. G. 1480; *Schilling v. Cranford* (1885), 4 Mackay, 450; 37 O. G. 1349; *Farmers' Friend Mfg. Co. v. Challenge Corn Planter Co.* (1885), 23 Fed. Rep. 42; 30 O. G. 661; *Reed v. Chase* (1885), 25 Fed. Rep. 94; 33 O. G. 996; *Flower v. Detroit* (1884), 22 Fed. Rep. 292; *Dryfoos v. Wiese* (1884), 19 Fed. Rep. 315; 26 O. G. 639; 22 Blatch. 19; *Parker & Whipple Co. v. Yale Clock Co.* (1883), 18 Fed. Rep. 43; 25 O. G. 290; 21 Blatch. 485; *McKay v. Stowe* (1883), 17 Fed. Rep. 516; *Hoffheins v. Russell* (1883), 107 U. S. 132; 23 O. G. 2030; *Andrews v. Hovey* (1883), 26 O. G. 1011; 5 McCrary, 181; 16 Fed. Rep. 387; *Lorillard v. McAlpin* (1882), 14 Fed. Rep. 112; *Newton v. Furst & Bradley Mfg. Co.* (1882), 14 Fed. Rep. 465; 11 Bissell, 405; *Neacy v. Allis* (1882), 13 Fed. Rep. 874; 22 O. G. 1621; *Hayes v. Seton* (1882), 20 Blatch. 484; 12 Fed. Rep. 120; *Streit v. Lauter* (1882), 11 Fed. Rep. 309; *Hart v. Thayer* (1882), 10 Fed. Rep. 746; 20 Blatch. 315; 21 O. G. 791; 22 O. G. 1787; *Meyer v. Maxheimer* (1881), 9 Fed.

Rep. 99; 20 Blatch. 15; 20 O. G. 1162; *Averill Chemical Paint Co. v. National Mixed Paint Co.* (1881), 9 Fed. Rep. 462; 20 Blatch. 42; 22 O. G. 585; *Putnam v. Tinkham* (1880), 4 Fed. Rep. 411; *Giant Powder Co. v. California Vigorit Powder Co.* (1880), 4 Fed. Rep. 720; 6 Sawyer, 508; 18 O. G. 1339; *American Middlings Purifier Co. v. Atlantic Milling Co.* (1879), 5 Dillon, 127; 4 Bann. & A. 148; 15 O. G. 467; *Curtis v. Branch* (1879), 4 Bann. & A. 189; 15 O. G. 919; *Kerosene Lamp Heater Co. v. Littell* (1878), 3 Bann. & A. 312; 13 O. G. 1009; *Powder Co. v. Powder Works* (1878), 98 U. S. 126; 15 O. G. 289; *Vogler v. Semple* (1877), 11 O. G. 923; 2 Bann. & A. 556; 7 Bissell, 382; *Manufacturing Co. v. Ladd* (1877), 2 Bann. & A. 488; 11 O. G. 153; *Russell v. Dodge* (1876), 93 U. S. 460; 11 O. G. 151; *Ex parte Aldrich* (1876), 9 O. G. 407; *Ex parte Baldwin* (1876), 9 O. G. 639; *Putnam v. Yerrington* (1876), 9 O. G. 689; 2 Bann. & A. 237; *Tucker v. Tucker Mfg. Co.* (1876), 10 O. G. 464; 2 Bann. & A. 401; 4 Clifford, 397; *Stevens v. Pritchard* (1876), 10 O. G. 505; 4 Clifford, 417; 2 Bann. & A. 390; *Giant Powder Co. v. California Powder Works* (1875), 3 Sawyer, 448; 2 Bann. & A. 131; *La Baw v. Hawkins* (1874), 1 Bann. & A. 428; 6 O. G. 724; *Ball v. Withington* (1874), 1 Bann. & A. 549; 6 O. G. 933; *Ex parte Wheeler* (1873), 4 O. G. 5; *Dorsey Harvester Rake Co. v. Marsh* (1873), 6 Fisher, 387; *Aultman v. Holley* (1873), 6 Fisher, 534; 11 Blatch. 317; 5 O. G. 3; *Wells v. Gill* (1873), 6 Fisher, 574; 4 O. G. 669; *Carew v. Boston Elastic Fabric Co.* (1871), 1 O. G. 91; 5 Fisher, 90; 3 Clifford, 356; *Brown v. Selby* (1871), 4 Fisher, 363; 2 Bissell, 457; *Parham v. American But-*