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1. DELAY IN FILING APPLICATION—ABANDONMENT.—The inventor is allowed a reasonable time within which to mature his invention, according to the circumstances of the case, and his right can be affected by no lapse of time short of that which will be sufficient to show an abandonment of his claims, during which time no subsequent inventor, however original or *bona fide*, can deprive him of his priority. *Stevens* v. *Salisbury*, 379.

2. ABANDONMENT—SECTION 7, ACT OF 1839.—It seems that such conduct and the acquiescence in the sale of the machines is a bar also upon the principles of patent law upon the ground of abandonment. The case does not fall within the exception of section 7 of the act of 1839, since the sales were not made by the applicant nor by those claiming under him. *Carroll* v. *Gambrill et al.*, 581.

3. ABANDONMENT—JURISDICTION THEREOF.—The Commissioner and the judge upon appeal have jurisdiction of the question of the abandonment of an invention. *Ellithorp* v. *Robertson*, 585.

4. ABANDONMENT—SECTION 7 OF THE ACT OF 1839 CONSTRUED.—Under the seventh section of the act of 1839 the Commissioner is authorized to reject an application upon proof that the invention has been abandoned to the public. *Wickersham* v. *Singer*, 645.

5. ABANDONMENT MEANS ABANDONMENT TO THE PUBLIC.—The true meaning of the word abandonment, as used in the acts of Congress relating to patents, is an abandonment of the invention to the public—a dedication of the discovery to the free use of his fellow-beings. It is, as said by Judge Story, "like the dedication of a public way or other easement, and is to be proved in the same manner by evidence of some acts inconsistent with the retention of the exclusive property himself; and in this regard his acts are to be construed liberally." *Babcock* v. *Degener*, 607.

6. SM—WITHHOLDING INVENTION FROM PUBLIC NOT ABANDONMENT.—Merely withholding an invention from the public can never amount to abandonment, however it may, if too long continued, increase the difficulties in the

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way of proving priority of invention over another inventor. It may raise up an equity in favor of the junior discoverer which will call for the fullest measure of proof on the part of the first inventor to dispel the cloud of distrust with which he has thereby enveloped his case, but of itself it cannot defeat his right. *Id.*

7. Pomeroy *v.* Connison (*ante*, p. 40) considered and disapproved. *Id.*

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MERE SPECULATION (ABANDONED EXPERIMENT?) NOT PATENTABLE.—If the invention be the mere speculation of a philosopher or a mechanician in his closet, and he takes no steps towards obtaining a patent, but keeps his invention secret, and another person who is also an original but subsequent inventor of the same thing obtains a patent for it and brings it into use, it has been held, both in England and in this country, that the patentee in a suit at law is to be considered as the first inventor. *Heath* v. *Hildreth*, 12.

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1. ANTICIPATION—ACCIDENT AND DESIGN IMMATERIAL ON QUESTION OF.—If the thing claimed by the applicant has been done before, it is immaterial to the question of anticipation whether it was done by accident or design. *In Re Kemper*, 1.

2. SM—SM—SYSTEM OR PLAN.—An applicant will not be entitled to a patent for doing an old thing because he is the first to do the thing with the "intent" to produce a certain beneficial effect, which was before obtained, but not observed, nor for producing that effect in accordance with a preconceived "system" or "plan," which refers at most to the purpose or intent with which the thing is done. *Id.*

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1. REDUCTION TO PRACTICE—NOT REQUIRED—BRINGING INTO USE.—Reducing to practice differs from bringing into use. There is no law requiring the applicant to reduce his invention to actual use before he can obtain a patent. *Perry* v. *Cornell*, 68.

2. REDUCTION TO ACTUAL USE—NOT REQUIRED BY LAW BEFORE PATENT.—There is no express requirement in the patent laws that an inventor shall reduce his invention to actual use before he can obtain a patent, nor is there any time limited within which he is to disclose his invention before application for a patent. *Stevens et al.* v. *Salisbury*, 379.

3. REDUCED TO PRACTICE—PATENTABILITY.—Although an invention has not been reduced to actual practical use, yet if it appear to be capable of being so reduced, it will be sufficient to entitle the party to a patent. *Chandler* v. *Ladd*, 493.

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ACQUIESCENCE IN PUBLIC USE PRESUMED FROM CIRCUMSTANCES.—A knowledge of and acquiescence in the public use and sale of the invention by another may be presumed from the circumstances of the case, as where the application of the subsequent inventor for a patent and his commercial use of that invention were matters of notoriety in the locality where the first inventor resided. *Savary* v. *Lauth*, 69.

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1. ADMISSIONS OF THE PARTY.—The admissions of a party to an interference, made before the controversy arose, to the effect that his opponent was the inventor, taken as conclusive evidence against his right to the patent. *Clark* v. *Cramer*, 173.

2. GROUND OF ESTOPPEL.—In a case where admissions are made to induce others to act upon them, such admissions do not operate merely as presumptive evidence of the actual truth of the facts, which must give way to positive proof of the contrary, but precludes, and, as it were, estops the party on grounds of policy. *Carroll* v. *Gambrill et al.*, 581.

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1. AFFIDAVITS NOT PROPERLY FILED.—Affidavits not taken by the authority of the Commissioner, nor acted upon by him in forming his decision, cannot be considered by the court upon appeal. *In Re Jackson*, 485.

2. AFFIDAVIT NOT PROPERLY FILED.—An affidavit relating to the merits of a case not laid before the Commissioner cannot be considered by the judge on appeal. *Nichols* v. *Harris*, 302.

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ANALOGOUS USE—NEW USE.—A mere analogous use is not patentable; but when a new or improved manufacture is produced by new contrivances, combinations, or arrangements, a new principle may be constituted, and the application or practice of old things will of course be new also. *In Re Smith*, 255.

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ANSWER TO REASONS OF APPEAL—EX-PARTE AND CONTESTED CASES.—Under the eleventh section of the act of 1839, the Commissioner is bound to furnish to the court upon appeal his answer to the reasons of appeal in *ex-parte* as well as in contested cases. *In Re Henry*, 467.

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1. PRELIMINARY QUESTIONS—APPEALS—UTILITY AND OPERATIVENESS QUESTIONS FOR THE COMMISSIONER.—The practicability and usefulness of the invention, and the reducing of it to practice, are matters for the consideration and within the discretion of the Commissioner, and cannot be made the subject of appeal. Nothing preliminary to the issuing of the patent is a valid ground of appeal, unless made so by the law. *Matthews* v. *Wade*, 143.

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2. COMMISSIONER'S REFUSAL TO ADMIT EVIDENCE, APPEALABLE—REHEARING BEFORE HIM.—If the Commissioner refuse to admit competent and material evidence offered by the applicant, the applicant may assign such refusal as a reason of appeal, and the Commissioner, in stating the grounds of his decision, is bound fully to answer such reason and the judge to decide it, and the judge may then make an order directing the evidence to be admitted and the case to be reheard by the Commissioner. *In Re Fultz*, 178.
3. DEPOSITION NOT BEFORE COMMISSIONER EXAMINED AS TO MATERIALITY.—In the decision of such a reason of appeal, the depositions and testimony may be considered to determine their relevancy, materiality, and competency. *Id.*
4. INTERFERENCE—JURISDICTION OF JUDGE THEREOF.—The judge is not precluded by the action of the Commissioner from considering upon appeal in interference cases whether the thing in controversy is patentable. He is by law directed to determine in all such cases which, or whether either, of the applicants is entitled to receive a patent as prayed for. *Yearsley* v. *Brookfield et al.*, 193.
5. SM—SM.—The judge upon appeal has jurisdiction of the question of patentability of the invention, and may reverse the decision of the Commissioner on this point. *Burrows* v. *Wetherill*, 315.
6. QUESTION ON APPEAL.—Features of novelty and utility not embraced in the claims, and brought out for the first time upon the argument before the judge, can have little influence in the determination of the questions before him. *In Re Bishop*, 519.

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1. SECTION 12 OF THE ACT OF 1839.—The provisions of the act of 1836 relating to a board of examiners were repealed by the twelfth section of the act of 1839. *In Re Aiken*, 126.

2. BOARD OF EXAMINERS—ITS JURISDICTION DISTRIBUTED—POWER OF COMMISSIONER.—When the board of examiners created by the act of 1836 was abolished by the act of 1839 its original jurisdiction was vested in the Commissioner and its appellate jurisdiction in the chief justice of the District of Columbia. *Hunt* v. *Howe*, 366.

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ORIGINALITY OF INVENTION—FIRST MACHINE—PRESUMPTIONS.—In the absence of all evidence to the contrary, the presumption is that the person who constructed the first machine is the real inventor; and where another person claims to be the author of such machine, the burden of proof rests

on him to show, not merely that he suggested the abstract idea of the machine, but that he invented the improvements which entitle it to a patent. *Atkinson* v. *Boardman*, 80.

CAVEAT.

See SURREPTITIOUS PATENT.

1. CAVEAT—NOT NECESSARY TO PRESERVE RIGHT TO PATENT.—An inventor is not required by the twelfth section of the law of 1836 to file a caveat to preserve his right to a patent. That section was introduced for the benefit of the inventor, but was not necessary to the preservation of his right. It only enables him to have notice of any interfering application. *Heath* v. *Hildreth*, 12.
2. EVIDENCE—CAVEAT—EFFECT OF.—A caveat is admissible in evidence as part of the *res gestæ* in proof of the invention so far as it contains a description of the invention and the machinery which was then constructed. *Jones* v. *Wetherill*, 409.

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1. MERE CHANGE OF FORM OR PROPORTION—NEW EFFECT.—A mere change of form or proportion is not patentable; but if by changing the form or proportion a new effect is produced, it is not simply a change of form or proportion, but a change of principle, and is the proper subject of a patent. *In Re Fultz*, 178.
2. SM—SM—INCIDENTAL CHANGES.—Incidental changes in the arrangement of the parts of a structure, arising out of an obvious application of the same to a new use, and effected by the means of well-known devices, are not patentable. *Stevens et al.* v. *Salisbury*, 379.
3. SM—COLORABLE ALTERATIONS—DOUBLE USE.—Where the change consists merely in the employment of an obvious substitute, the discovery and application of which could not have involved the exercise of the inventive faculty in any considerable degree, the change will then be treated as merely an unsubstantial colorable variation, or a double use. *Id.*

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4. EFFECT OF CHANGE—BURDEN OF PROOF.—When it is impossible to predict what the result of the change proposed by the applicant will be, the burden of proof rests on him to show what the actual results are. *In Re Jackson*, 485.

5. SM—CHANGE AND ITS CONSEQUENCES.—Whenever the change and its consequences, taken together and viewed as a sum, are considerable, there must be a sufficiency of invention to support a patent. (Webster on Subject-Matter, p. 29.) *Id.*

6. NOVELTY—AFFIDAVITS AS TO.—The alleged invention examined in connection with affidavits offered to show that the consequences of the proposed change are of great practical importance and found to be devoid of patentable novelty. *In Re Littlefield*, 574.

CHANCERY.

See NEW TRIAL, 2.
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1. INVENTION—CHANGE OF MATERIAL—METALLIC CARTRIDGE.—The mere selection of a superior material, which is so by reason of its well-known qualities—as substituting steel or case-hardened iron for sheet metal in constructing the firing end of a cartridge—is not invention. *In Re Maynard*, 536.

2. SM—SM—BETTER ARTICLE.—Within the range of materials known to possess the proper qualities for the purpose, it is not invention to select that one which exhibits these qualities in a more marked degree, and thereby make a better article than had before been made. *Id.*

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1. CLAIM—CONSTRUCTION OF—NOT TAKEN ALONE.—The claim of the United States patent is not separately construed, and with the same strictness, as the title or claiming part of the British patent. Under our law, the specifications and the drawing, as a whole, are included in and made component parts of the patent, and they should be taken in construction together in explanation of whatever is dubious; and according to this rule, one part of the specification and drawing may be resorted to to explain any other. *King* v. *Gedney*, 443.

1 METALLIC NUTS—CONSTRUCTION OF CLAIM.—A claim for "the preliminary

shaping of the end of the metallic bar to make it correspond on all sides save one with the cross section of the finishing die box, by which the necessity of cutting off by the punch of more than one side of the nut to be formed is prevented, and from which results a very great saving of metal in manufacturing many-sided nuts at the same time, at a considerable saving of power, as produced in operating the machine. But this I only claim when the said preliminary shaping of the exterior portion of a nut is accomplished immediately in front of the mouth of a die box, substantially in the manner herein set forth"—construed to be for a combination of the parts specified, arranged, and operating, as described in the specification, to accomplish the desired result, and *held* to be patentable. *In Re Cole*, 539.

3 CLAIM MUST BE LIMITED TO THE EXACT INVENTION.—The law makes special requisition for clearness and definiteness of claims in the specifications for machines, by declaring that the applicant 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 shall particularly specify and point out the part, improvement, or combination which he claims as his own invention or discovery. *In Re Davis*, 628.

4 SM—A claim for the whole combination, without particularly specifying the changes in the construction and arrangement of the parts of the combination which are set out as the real invention in the specification: *Held*, To be too broad and indefinite. *Id.*

CLERICAL ERROR.

See TERM OF PATENT, 2.

POWER OF COMMISSIONER OVER CLERICAL ERRORS.—As a court can correct the errors of its clerk in the discharge of his ministerial duties, the Commissioner of Patents, no doubt, may do the same as to his clerks in correcting a merely clerical error in a patent, but he cannot thus correct an error of judgment as to his power and authority under the law. *In Re Cushman*, 577.

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1. OLD AND NEW DEVICES IN COMBINATION—MUST CO-OPERATE.—When an apparatus is made up of new and old devices the inventor is not bound to take his patent for the new elements or devices by themselves. He is at liberty to ask for a patent for a limited use of those new matters, to wit,

COMBINATIONS—*continued.*

in combination with the old, if the devices all co-operate to form a new combination. *Bain* v. *Morse*, 90.

2. SM—ELEMENTS OF COMBINATION SEPARATELY PATENTABLE.—A new combination is none the less patentable that certain elements or parts thereof are new and patentable by themselves. *Id.*

3. FORM AND STRUCTURE ESSENTIAL IN MACHINES.—When the application is for a combination of machinery and materials, form and structure become substance. They are the essence of the invention; and if changes in these respects enable the operator to do the work in a better manner, or with more ease or at less expense, or in less time, they are all improvements for which the inventor may have a patent. *Id.*

4. COMBINATION OF OLD ELEMENTS.—There may be a patent for a new combination of machines to produce a certain effect or effects, whether the machines constituting that combination be new or old. In such case the thing patented is not the separate machines, but the combination alone. *In Re Boughton*, 278.

5. SM—IN PART OLD.—Under a patent for a combination, proof that the machine or any part of the structure existed before forms no objection to the patent, unless the combination had existed before, for the reason that the patent is limited to the combination. *Id.*

6. COMBINATION.—When the claim is for a combination, proof that the machine or any part of its structure existed before forms no objection to the patent, unless the combination has existed before, for the reason that the invention is limited to the combination. *In Re Halsey*, 439.

7. COMBINATION.—When the claim is for a combination of parts, it is immaterial that the elements of which the combination is made up have been before used for different purposes. If these have been brought together for the first time, and produce a new and useful result, it will be a patentable combination. *In Re Wagner*, 510.

8. NEW COMBINATION—OLD PURPOSE.—The rule that an old device or combination applied to a new purpose is not patentable does not apply to the case where a new combination is applied to an old purpose. *In Re Hebbard*, 543.

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See ACQUIESCENCE.

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CASE REMANDED.—Where the Commissioner's answer virtually abandoned the reference originally referred to, and relied upon references then for the first time presented, the decision overruled and case remanded. *In Re Jewett & Root*, 259.

COMMISSIONER AND EXAMINERS UNDER OATH.

1. COMMISSIONER AND EXAMINERS EXAMINED UNDER OATH—SECTION 11 OF ACT OF 1839 CONSTRUED.—The provisions of the eleventh section of the law of 1839, that the Commissioner and the examiners in the Patent Office may be examined under oath in explanation of the principles of the machine or

COMMISSIONER AND EXAMINERS UNDER OATH—*continued.*

other thing, &c., must be considered in connection with the similar provisions of the seventh section of the code of 1836, governing appeals to the board of examiners. *Richardson* v. *Hicks*, 335.

2. SM—EXAMINATION MAY BE AT LARGE.—The section (section 11, act of 1839) means that the explanation which it authorizes to be required of the Commissioner and examiners may be so full and clear an explanation of the principles as to enable the judge duly to apply and weigh the evidence offered to support the issue in the case, and not to be limited to a mere exposition of the terms used. Such explanation, so given, the judge is bound to respect as part of the case. *Id.*

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1. COMPOSITION OF MATTER—INVENTION—ARTIFICIAL HONEY.—An artificial honey, consisting of sugar, water, rosin, butter, cream of tartar, gum arabic, honey, essence of peppermint, and isinglass, compounded in a described manner and in definite proportions, and forming a substance which closely resembles the genuine article in appearance, taste, and flavor, and which would seem to be a wholesome article of consumption, is a new and useful composition of matter, and forms the proper subject-matter of a patent. *In Re Corbin and Martlett*, 521.
2. COMPOSITION—INGREDIENTS—NEW COMBINATION.—It is not necessary that the ingredients of a composition of matter should be new, or that they have not been before used for similar purposes, if the combination is new; that is, if they have not been before compounded in the same proportions. *Id.*
3. SM—SM—NOVELTY—UTILITY.—It is not an objection to such an imitation, on the ground of novelty, that it closely resembles the natural product, since that varies in composition from natural causes, and is made in an entirely different manner, nor, on the ground of utility, that it is a deception, and calculated to impose an inferior article upon the public, since the specification expressly declares its factitious character and furnishes the formula by which it is made. *Id.*
4. NATURAL PRINCIPLES—PRACTICAL APPLICATIONS.—Natural principles and operations cannot be appropriated; but when they have been practically applied, as in this case, to produce a cheap and healthy substitute for a useful article of diet, there is sufficient utility to support a patent. *Id.*

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RULES FOR TAKING TESTIMONY.

CONTINUOUS APPLICATION.

See PUBLIC USE AND SALE, 19.
WITHDRAWAL OF APPLICATION, 1, 2.

CONTINUOUS APPLICATION—APPLICATION INSTANTLY RENEWED—FOREIGN PATENT.—Where an application was withdrawn, but was instantly renewed in the same words: *Held*, That there was a continuous application, and that the application would not be affected by a foreign patent taken out by a subsequent inventor intervening the first and second application. *Matthews* v. *Wade*, 143.

SECOND APPLICATION—WHEN WILL RELATE BACK TO PRIOR APPLICATION.—The doctrine, with relation to grants of the Government, that a subsequent

CONTINUOUS APPLICATION—*continued.*

application may relate back to a prior application, so as to cut off intervening claims, will not be applied to a case which does not present the element of "due diligence in applying for and pursuing his application for a patent until he obtained the same." *Wickersham* v. *Singer*, 645.

COPY AS EVIDENCE.

See EXAMINATION OF WITNESSES, 1.

ORIGINAL AND COPY.—A witness, whether an expert or not, cannot be called to testify to the sufficiency of secondary evidence by a party who has the original and refuses to produce it. To admit such evidence would in principle be a violation of the rule that no evidence of a copy, though sworn to, will be admitted until proof has been given that the original cannot be produced. *Richardson* v. *Hicks*, 335.

CORRECTING DATE OF PATENT.

See TERM OF PATENT, 12.

CONSTITUTION.

See DISCOVERY, 1.

COUNSEL.

See JURISDICTION OF THE JUDGE.
MAGISTRATE OF COUNSEL.
OFFICERS OF THE PATENT OFFICE, 1.

COLLATERAL ISSUE.—Where an affidavit was filed by counsel on a collateral matter, showing an informality in taking the testimony in the case, and where the facts concerning the alleged informality were stated by the magistrate in his return and noticed by the Commissioner: *Held*, That it should be considered. *Nichols* v. *Harris*, 302.

CREDIT OF WITNESS.

See EVIDENCE, 17, 19.
EXAMINATION OF WITNESSES, 2, 3, 4.
TESTIMONY, 1.
WITNESSES, 1, 4, 5, 10.

TESTIMONY GROSSLY IMPROBABLE.—The rule of law is, that where a witness stands wholly unimpeached by extrinsic circumstances, credit ought to be given to his testimony, unless it is so grossly improbable as to show that he is not to be trusted.

CROSS-EXAMINATION.

See EXAMINATION OF WITNESSES, 1, 2, 3, 4, 5.
NOTICE, 1, 4, 5.

DATE OF INVENTION.

See DRAWING, 1.
EVIDENCE, 20.

DATE OF INVENTION—*continued.*

See EVIDENCE OF INVENTION, 2.
FIRST INVENTOR, 1.
FOREIGN PATENT.
MEASURE OF PROOF.
WITNESSES, 2, 7.

DATE OF INVENTION—DRAWING.—An invention may date from the time a drawing was made disclosing the same. *Stevenson* v. *Hoyt*, 292.

DATE OF PATENT.

See TERM OF PATENT, 1, 2.

DEGREE.

See IDENTITY OF INVENTION, 2.
SUFFICIENTLY USEFUL AND IMPORTANT.

DELAY.

See DELAY IN APPLYING FOR REISSUE.
DELAY IN FILING APPLICATION.
LACHES.
PRIOR INVENTION, 5.
POVERTY.

DELAY IN APPLYING FOR REISSUE.

REISSUE—DELAY IN APPLYING FOR—LACHES.—*Semble*, that when a patentee has slept upon his rights for thirteen years, it is too late to seek redress by way of reissue. No tribunal ought to encourage or countenance such gross negligence. *In Re Cushman*, 577.

DELAY IN FILING ARGUMENT.

DELAY IN FILING ARGUMENTS.—An argument not filed within the time limited, and for that reason objected to, may be received if a reasonable excuse is offered in explanation of the delay. *Screw Co.* v. *Sloan*, 210.

DELAY IN FILING APPLICATION.

See ABANDONED EXPERIMENT.
DISCLOSURE OF INVENTION.
LACHES, 2.
PUBLIC USE AND SALE, 16.
SECRET INVENTION, 1, 2, 3.

1. DELAY IN APPLICATION UNIMPORTANT—ABANDONMENT.—The statute does not limit any time within which an inventor must apply for a patent, nor does it declare a forfeiture by reason of any delay. The delay, therefore, seems unimportant, unless it amounts to evidence of abandonment of the claim. Delay is not one of the specified grounds upon which the Commissioner is authorized by the seventh section of the act of 1836 to refuse a patent. *Heath* v. *Hildreth*, 12.

2. DELAY—QUESTION FOR JURY.—*Semble*, that a matter of defense—such as

DELAY IN FILING APPLICATION—*continued.*

delay in filing an application for a patent—which it is the peculiar province of the jury to decide, and which is not by the seventh section of the act of 1836 made a ground for the refusal of a patent by the Commissioner, should be left by him to be decided by the jury in a subsequent *action at law*. *Id.*

3. ESTOPPEL—FAILURE TO APPLY.—The fact that an alleged inventor neglected to apply for a patent, although he knew that other persons had filed applications for the same invention, brings him within the reason of the rule that when a man has been silent when in conscience he ought to have spoken he will be debarred from speaking when conscience requires him to be silent. *McCormick* v. *Howard*, 238.

4. REASONABLE DILIGENCE—CIRCUMSTANCES OF THE CASE.—No particular time is limited for filing the application for the patent by the statute; yet it is very clear, according to a fair construction of its spirit and meaning, that it ought to be done within a reasonable time; otherwise the right may be lost by the laches of the party. What is or is not a reasonable time depends on the circumstances of each case. *Ellithorp* v. *Robertson*, 585.

5. DELAY IN APPLYING FOR A PATENT.—An inventor who seeks the monopoly afforded by a patent must present his perfected invention to the Patent Office at once. He cannot privately use the invention for his own gain during several years, and then claim and expect protection for fourteen years longer. *Spear* v. *Belson*, 699.

DELAY IN PROSECUTING APPLICATION.

DELAY IN PROSECUTING APPLICATION—MISTAKE OF THE OFFICE.—A mistake on the part of the Office in its judgment upon a case which does not create a delusion in the mind of the party as to his rights does not authorize him to indefinitely delay the further prosecution of the case, either by endeavoring to convince the Office on rehearing of a palpable error or by resorting to the easy and expeditious means for revising the decision upon appeal, as the statutes provide. *Wickersham* v. *Singer*, 585.

DELIVERY OF PATENT.

See JURISDICTION OF COMMISSIONER, 2, 3.
RIGHT OF APPEAL, 6.
TIME FOR FILING APPEAL, 2.

DEPOSITION.

See APPEAL, GROUND OF, 3.
EVIDENCE, 3.
EXAMINATION OF WITNESSES, 6.
NEW PARTY.
NEW TRIAL, 7.
NOTICE, 4.
RULES OF THE PATENT OFFICE, 2, 3.
TESTIMONY, 2.

DEPOSITION—*continued.*

1. INFORMAL DEPOSITIONS—COMMISSIONER MAY INSPECT.—Where a deposition was not transmitted in due form, so that it could be considered at the day of hearing under the rules of the Patent Office, the Commissioner was, nevertheless, at liberty to inspect the deposition and to postpone the hearing, if he deemed it essential to the ends of justice to permit an informality to be corrected. *Smith* v. *Flickenger*, 46.
2. SM—SM—NOT TO BE CONSIDERED AS EVIDENCE.—The prohibition contained in the rule is not to the Commissioner's looking into the deposition thus informally transmitted, or to his reading it and ascertaining its contents, but to his considering it on the day of hearing as evidence touching the matter at issue. *Id.*
3. DEPOSITIONS TAKEN IN FORMER CASE—WHEN MAY BE USED.—Depositions taken in a former interference may be read at the trial when the subject-matter at issue in the former case was the same and the parties in interest, assignors of the entire right, were the same, so that the party against whom the deposition is offered has had full opportunity to cross-examine the witness. *McCormick* v. *Howard*, 238.
4. NEW TRIAL—DEPOSITIONS.—In a rehearing or new trial of an interference the depositions taken on the first trial may be used. *Carter et al.* v. *Carter et al.*, 388.

DESIGNS.

1. DESIGN—LETTER OF THE ALPHABET—USEFUL PURPOSE.—A drawing, pattern, or casting of the letter G, or any other letter of the alphabet, is not patentable of itself as a new design. To give it any novelty or usefulness, it must have some purpose in combination with something else—as when used as a frame to support the working machinery of a sewing machine. *Gibbs* v. *Ellithorp*, 699.
2. SM—WORKING MACHINERY—SPECIFICATION.—The claim for the design in such a case would not depend on the novelty of the machinery; but to perfect the design and make it patentable, the working machinery must be applied or shown to the Office to be capable of application. It is not necessary, however, to describe the machinery in the specification. *Id.*

DILIGENCE.

See ABANDONMENT, 1.
ACTUAL USE, 2.
CONTINUOUS APPLICATION.
DELAY IN APPLYING FOR REISSUE.
DELAY IN FILING APPLICATION.
ORIGINAL INVENTOR, 1, 3.
PRIOR INVENTION, 3, 6, 7.
PUBLIC USE AND SALE, 19.
SECRET INVENTION, 1.
WITHDRAWAL OF APPLICATION, 2.

1. FIFTEENTH SECTION OF ACT OF 1836—REASONABLE DILIGENCE IN ADAPTING AND PERFECTING.—But the doctrine that when two men independently

discover the same thing, the one who first communicates it to the public (by reducing it to practice and using) is deemed the first inventor and entitled to a patent, is not supported to that extent by the cases cited, and would be unjust if it were, as it makes no exception of the *bona-fide* inventor who is "*using reasonable diligence in adapting and perfecting*" his invention, whose right is saved by the spirit if not by the letter of the fifteenth section of the act of 1836. *Heath* v. *Hildreth*, 12.

2. REASONABLE DILIGENCE—SECTION 15 OF THE ACT OF 1836 DOES NOT APPLY TO APPLICANT.—Nor is it necessary that the first inventor should use "reasonable diligence in adapting and perfecting his invention." The fifteenth section of the act of 1836, providing that the defendant may show, in order to vacate a patent *already granted*, that it was surreptitiously obtained for an invention which was being diligently prosecuted by another, does not apply to the case of contending applicants. *Perry* v. *Cornell*, 68.

3. REASONABLE DILIGENCE—EFFECT OF.—On the other hand, when a prior inventor has been using reasonable diligence to perfect and adapt the invention to practice, all his rights will be preserved and protected, although his success may not have been perfect. *McCormick* v. *Howard*, 238.

4. QUESTION OF DILIGENCE—DOES NOT ARISE IN AN INTERFERENCE—PATENT SURREPTITIOUSLY OBTAINED.—The diligence referred to in section 15 of the act of 1836 has no application to the case of interfering applicants. It applies to the case of a prior inventor defending against a patent surreptitiously granted to a subsequent inventor, and directly only in such a case, or where it appears that analogous principles are involved, and then only by an equitable construction of the rule. *Stevens et al.* v. *Salisbury*, 379.

5. REASONS FOR REQUIREMENT OF DILIGENCE—The main object of the patent laws is to bring inventions as soon as possible into public and unrestricted use; and this forms an essential part of the consideration—the *quid pro quo*. The public has a right to the knowledge as early as possible, consistently with the rights of the inventor in using such reasonable diligence on his part as may be necessary in adapting and perfecting his invention. *Ellithorp* v. *Robertson*, 585.

6. DUE DILIGENCE—POVERTY AS AN EXCUSE FOR DELAY.—The measure of poverty which one must possess before he is required to exercise any diligence to prosecute his rights is not to be found in the statute. It is an excuse very readily made, which yet should not be too readily listened to. If a man be utterly destitute of money and without friends, and incapable thereby of prosecuting an enterprise, much indulgence may be shown him; but when he has the means of carrying on sundry enterprises of a kindred sort, equally demanding money and friends, and does carry them on, his election to pursue those other enterprises will not be regarded in the law as an excuse for delay in the other, where valuable rights of others, equally meritorious with himself, and in the outset of their successful struggles equally poor, are to be prejudiced. *Wickersham* v. *Singer*, 645.

DISCLAIMER.

See INTERFERENCE, 6.

DISCLAIMER IN SPECIFICATION—EFFECT OF.—The general sense of a disclaimer embodied in the specification must be restrained to the purpose for which it was used in connection with that specification, and will not estop the inventor from subsequently maintaining a claim for the invention so disclaimed in another proceeding. *Hill* v. *Dunklee*, 475.

DISCLOSURE OF INVENTION.

See REDUCTION TO PRACTICE, 6, 7.
ORIGINAL INVENTOR, 1.

NO DILIGENCE REQUIRED—ABANDONMENT.—Before a patent is granted to any one for an invention, there is no law that requires the inventor to disclose his invention within any limited time. There is no limitation of his right to obtain a patent, unless the lapse of time be sufficient to show an abandonment of the invention. *Perry* v. *Cornell*, 68.

DISSOLUTION OF INTERFERENCE.

See INTERFERENCE, 4.

DISCOVERY.

See ACCIDENT AND DESIGN, 1, 2.
JOINT INVENTION, 1.
PRINCIPLE, 1, 3, 4.

1. "DISCOVERY" AND "INVENTION" SYNONYMOUS—NAKED DISCOVERY NOT PATENTABLE.—A mere naked discovery, in the sense of bringing to light something which existed before, but was not known, is not the proper subject of a patent. The word "discovery," as used in the Constitution and laws of the United States relating to patents, is synonymous with the word "invention." *In Re Kemper*, 1.

2. SM—MUST BE CONTRIVANCE OF SOMETHING NEW.—No discovery will entitle the discoverer to a patent which does not in effect amount to the contrivance or production of something which did not before exist, or, in other words, to an invention. *Id.*

3. SM—PLACING BLOCKS OF ICE EDGEWISE NOT AN INVENTION.—The discovery of a beneficial effect, resulting from doing a thing in the same manner in which it has been done before—as when a person discovered or found out by observation that blocks of ice placed edgewise keep longer than when placed differently—is not the invention of something which did not before exist; it is not an invention. *Id.*

DISCRETION.

See INTERLOCUTORY ACTIONS.
LIMIT OF APPEAL, 4, 5.
NEW TRIAL, 2, 4, 5, 6.
POWER OF COMMISSIONER, 2.
REHEARING, 1.

DOUBLE USE.

See ANALOGOUS USE.
CHANGE, 2, 3.
INVENTOR, 1, 2.
PARTICULAR INVENTIONS, 1, 4, 12.

INVENTION—PRINCIPLE—DOUBLE USE.—An invention must involve a new principle. When the principle of the alleged invention has been discovered and applied before, the new application of it will be what is called a double use. In such cases, although there may be in the new application some degree of novelty—something may have been discovered or found out that was not known before—yet, unless the new occasion on which the principle is applied leads to some kind of new manufacture or to some new result, it will be but a double use. *In Re Blandy*, 552.

DOUBTFUL CASES, RULE IN.

See RULE IN DOUBTFUL CASES.

DRAWINGS.

See CLAIMS, 1.
DATE OF INVENTION.
EVIDENCE OF INVENTION, 3.
LACHES, 1.
MEASURE OF PROOF.
OATH OF INVENTION, 2.
PERFECTED INVENTION.
PREREQUISITES TO A PATENT.
REDUCTION TO PRACTICE, 1, 6.
SPECIFICATION, 1.

1. EVIDENCE—DRAWINGS WITHOUT TESTIMONY NO EVIDENCE.—A drawing in an account-book in the possession of one of the parties to the interference not of itself evidence that the invention therein shown was the invention of such party, and not taken as evidence of the existence of the invention at the date of the surrounding entries in the book, in the absence of corroborating circumstances or the positive testimony of witnesses. *Jillson* v. *Winsor*, 136.

2. SPECIFICATION—DRAWINGS.—The patent law requires every specification of a claim for machinery to be accompanied by drawings signed by the inventor and attested by two witnesses. *In Re Henry*, 467.

DROPPING AN ELEMENT.

See REARRANGING PARTS OF MACHINE.

DUE DILIGENCE.

See DILIGENCE.

DUE PROCEEDINGS.

See PUBLIC USE AND SALE, 2.
SURREPTITIOUS PATENT.

DUTIES OF THE COMMISSIONER.

See OFFICERS OF THE PATENT OFFICE, 3.

ESTOPPEL.

See ADMISSIONS OF PARTY, 2.
DELAY IN FILING APPLICATION, 3.
DISCLAIMER.
EMPLOYER AND EMPLOYEE, 1, 2.

1. EVIDENCE—ESTOPPEL.—Where a person stands by and hears another person describe a certain invention or improvement as his own, without asserting any claim to the invention, and at the same time seeking further information of the same, the inference will be warranted that the principles of such invention were not at that time known to him. *Ruggles* v. *Young*, 160.

2. ESTOPPEL—ACQUIESCENCE IN ANOTHER'S RIGHT.—Where it appears that before the interference arose one of the parties was aware that the other party claimed the invention as his own, and had obtained a patent for the same, and he further acted as the patentee's agent in introducing and selling the patented machines, distributing circulars, recommending the machines, &c., without asserting any claim to the invention, but constantly repeating upon inquiry that he was not interested: *Held*, That he was estopped from subsequently asserting a claim to the invention. *Carroll* v. *Gambrill*, 581.

EMPLOYER AND EMPLOYEE.

1. ORIGINAL INVENTOR—PRESUMPTION IN FAVOR OF ONE WHO MADE THE MACHINE—REBUTTED BY CIRCUMSTANCES—ESTOPPEL.—The *prima-facie* evidence of inventorship, arising out of the fact that the machine in controversy was made by one of the parties to the interference, is rebutted by evidence showing that such party was at the time in the employ of the other party as a machinist, and that he made the machine at his employer's request and for his benefit, and made no claim to the invention until long afterwards, but, on the contrary, stood by and saw his employer apply for and obtain a patent without objection. *Warner* v. *Goodyear*, 60.

2. Under such circumstances, the presumption is that the machine was made according to the directions of the party beneficially interested, and in pursuance of his invention. *Id.*

3. EMPLOYER AND EMPLOYEE—ORIGINAL CONCEPTION—MECHANICAL DETAILS.—If the employer conceives the result embraced in an invention, or the general idea of a machine upon a particular principle, and in order to carry his conception into effect it is necessary to employ manual dexterity, or even inventive skill, in the mechanical details and arrangements requisite for carrying out the original conception, in such cases the employer will be the inventor and the servant will be the mere instrument by which he realizes his idea. *Wellman* v. *Blood*, 432.

4. EMPLOYER AND EMPLOYEE—GENERAL DIRECTIONS—MECHANICAL SKILL.—If an employer conceives the result embraced in an invention, or the general idea of a machine upon a particular principle, and then, to carry his conception into effect it is necessary to employ manual dexterity, or even

EMPLOYER AND EMPLOYEE—*continued*..

inventive skill, in the mechanical details and arrangements requisite for carrying out the original conception, in such cases the employer will be the inventor and the servant will be a mere instrument through which he realizes his ideas. *King* v. *Gedney*, 443.

EQUIVALENTS.

See IDENTITY OF INVENTION, 3, 4.
INTERFERENCE, 12.
PARTICULAR INVENTIONS, 11, 14.
RIGHT OF APPEAL, 8.
SECOND PATENT FOR SAME INVENTION.
UTILITY, 3.

1. EQUIVALENTS—NEW PATENT THEREFOR.—A patent covers all equivalent modes of carrying the invention into effect, although they are not specifically described in the specification, and the patentee is not entitled to a new patent for those equivalent modes. *Bowen* v. *Herriet*, 310.
2. MECHANICAL EQUIVALENT—ROD AND ENDLESS CHAIN.—A rod is the known equivalent of an endless chain in machinery when it can be used for the same purpose and to accomplish the same effect, and they are not, therefore, when so used, substantially different. *Spain et al.* v. *Gamble et al.*, 358.
3. INVENTION—PRINCIPLE—EQUIVALENTS.—The first and original inventor is entitled to protection against all other means of carrying the principle into effect. *Nichols* v. *Harris*, 362.
4. EQUIVALENTS—HOW DETERMINED.—Equivalents are to be known by an inference drawn from all the circumstances of the case, by attending to the consideration whether the new contrivance is used for the same general purpose, performs the same kind of duties, or is applicable to the same object as the old device. *In Re Nutting*, 455.
5. EQUIVALENTS—ADDITIONAL EFFECTS.—If the change introduced by the appellant constitutes a mechanical equivalent in reference to the means used by a patentee, and besides being such an equivalent it accomplishes some other advantages beyond the effect or purpose accomplished by the patentee, such further advantages may make it a patentable subject as an improvement upon the former invention. *In Re Hebbard*, 543.

EVIDENCE.

See ABANDONMENT, 5, 6.
ADMISSIONS OF PARTY, 1, 2.
APPEAL, GROUND OF, 2, 3.
BURDEN OF PROOF.
CAVEAT, 2.
COPY AS EVIDENCE.
COUNSEL.
CREDIT OF WITNESS.
DATE OF INVENTION.
DELAY IN FILING APPLICATION, 3.
DISCLAIMER.

EVIDENCE—*continued.*

See DRAWING, 1.
EMPLOYER AND EMPLOYEE, 1, 2.
ESTOPPEL, 1, 2.
EVIDENCE OF INVENTION, 2, 3.
EXAMINATION OF WITNESSES, 1, 2, 3, 4, 6.
EXPERT.
HUSBAND AND WIFE.
INTEREST IN THE SUIT, 1, 2.
INTERFERENCE, 3, 11, 15.
INTERLOCUTORY ACTIONS, 1.
LACHES, 1.
MAGISTRATE OF COUNSEL.
MEASURE OF PROOF.
NOTICE, 3.
NOVELTY, 1.
OATH OF INVENTION, 2.
OFFICERS OF THE PATENT OFFICE, 2.
OPERATIVENESS OF INVENTION.
PATENT.
PERFECTED INVENTION.
PERJURY.
PRESUMPTIONS.
PUBLIC USE AND SALE, 4, 9, 11, 13, 14, 15.
REASONS OF APPEAL, 9, 12.
RULES OF THE PATENT OFFICE, 3, 4.
TESTIMONY.
UTILITY, 2.
WITNESSES.

1. EVIDENCE—DECLARATIONS OF PARTY.—The declaration of a party to an interference that at some former time he made the invention for which he seeks a patent, is not competent evidence. *Cochrane* v. *Waterman*, 52.

2. INTERFERENCE—MUST BE DECIDED UPON THE EVIDENCE.—The decision of the Commissioner and the judge upon appeal can only proceed upon the evidence properly in the case. *Id.*

3. EVIDENCE—SAME AS BEFORE COMMISSIONER.—The judge, upon appeal, can consider only such evidence as was properly before the Commissioner. *Perry* v. *Cornell*, 68.

4. DEPOSITION TAKEN WITHOUT NOTICE.—Depositions taken in an interference without notice to a party, as depositions taken before he became a party to the case, are not evidence against him, and cannot be considered by the judge upon appeal. *Id.*

5. EVIDENCE—DECLARATIONS OF PARTIES INADMISSIBLE.—The declarations of the parties to an interference in their own behalf and in the absence of each other, incompetent evidence for any other purpose than to show when or what they have respectively claimed to have invented. *Atkinson* v. *Boardman*, 80.

6. EVIDENCE—CERTIFICATE UNDER OATH.—Certificates not under oath in due

form of law cannot be received as evidence in an interference proceeding. *Jillson* v. *Winsor*, 136.

7. EVIDENCE.—Whether the decision of the Commissioner is correct or erroneous, must appear from the proofs and evidence which have been acted on in the trial before the Commissioner. *Ruggles* v. *Young*, 160.

8. TESTIMONY INTRODUCED UNDER A PATENT OF ADDITION (THIRTEENTH SECTION, 1836).—Testimony taken to show that a certain invention annexed to a patent under the thirteenth section of the law of 1836, as an improvement invented subsequent to the date of the patent, was in fact invented by the patentee before the date of the patent, is receivable in evidence to show that an applicant is not the inventor, whether or not the patentee under the circumstances named could sustain his patent. *Burlew* v. *O'Neil*, 168.

9. EVIDENCE—INTRODUCING SAME ON APPEAL.—Section 11 of the act of 1839, read in connection with sections 7 and 8 of the law of 1836, upon which it is engrafted, gives to the applicant, on appeal to the judge, the right to support his claim by, and to be heard upon, the evidence or facts deemed by him essential to a just decision, although not produced before the Commissioner at the hearing before him. *In Re Fultz*, 178.

10. SM—SM—EVIDENCE BEFORE THE COMMISSIONER—MERITS OF THE CASE.—The restrictive part of the section confining the judge in his decision to "the evidence adduced before the Commissioner" applies to the merits of the case. *Id.*

11. EVIDENCE—PARTY TO THE RECORD—STATUS OF APPLICANT.—An applicant for a patent involved in interference is within the reason of the rule which makes a party an incompetent witness in a cause, although the interference proceedings do not, strictly speaking, constitute a record. *Yearsley* v. *Brookfield et al.*, 193.

12. SM—SM—PARTY RELEASED.—Such a party to an interference cannot be released by an assignment of his invention so as to make him a competent witness. *Id.*

13. SM—SM—LOSS OF ORIGINAL DOCUMENT.—From a principle of necessity, however, the party is a competent witness to establish the loss of an original paper if lost out of his own custody, and not destroyed by fraud. *Id.*

14. SM—STATEMENTS OF PARTY AT TIME—RES GESTÆ.—The statements and declarations of the inventor made before the contest arose, describing orally or by drawings a certain invention, are admissible in evidence as part of the *res gestæ* to show that he knew of or had made the invention at that time. *Id.*

15. INVENTOR NOT A PARTY—TESTIMONY OF.—The testimony of a witness to the effect that he was a joint inventor with one of the applicants is competent evidence as against that applicant, though it would not, it seems, be admissible in his own behalf if he were a party to the record. *Id.*

16. TESTIMONY—BEST EVIDENCE—MACHINES THEMSELVES—PAROL EVIDENCE.—Upon an issue of priority of invention in an interference proceeding it is not true that the machines themselves are the best evidence, and must be produced, or their absence satifactorily accounted for, before parol testimony

EVIDENCE—*continued.*

can be admitted to prove their character and construction, and that otherwise the parol testimony is inadmissible. *Screw Co.* v. *Sloan*, 210.

17. HEARSAY EVIDENCE.—Testimony to the effect that the witness had been informed that a machine had been made and used at some former time is not evidence. *Id.*

18. EVIDENCE—TESTIMONY OF PARTY WHO HAS ASSIGNED HIS INTEREST.—While the natural interest which an inventor may be supposed to retain in his invention after he has parted with all pecuniary interest in the same will not render him an incompetent witness for his assignee in an interference with a rival inventor, the circumstance should be allowed due weight in considering the credit to be given to his testimony. *Id.*

19. EVIDENCE—STATEMENT TAKEN AS A WHOLE.—When a part of an applicant's statement in correspondence with the Office is used, the whole of the cotemporaneous statement should be received, the part which operates for him as well as that which makes against him. *In Re Boughton*, 278.

20. DECLARATIONS AND CONVERSATIONS OF PARTY—EXCEPTION TO RULE IN PATENT CASES.—The exception in patent cases to the rule that the declarations and conversations of the plaintiff are not admissible in evidence is founded upon necessity and to prevent a failure of justice by reason of the impossibility of otherwise proving an invention; and such declarations, when admitted, should be free from suspicion and accompanied by acts forming the *res gestæ*, to which the credit is to be given, and not to the declarations. *Richardson* v. *Hicks*, 335.

21. SM—MACHINE NOT PRODUCED IN EVIDENCE.—*Doubted*, whether the rule laid down in Railroad Company *v.* Stimpson, that the conversations and declarations of an inventor stating that he had made an invention, and describing its details and explaining its operation, are properly to be deemed an assertion of his right at that time as an inventor to the extent of the facts and details which he then makes known, and admissible in evidence, can be applied to a case where the declarations relate to an actual machine already made, which was not produced in evidence, nor its non-production accounted for. *Id.*

22. SM—PAROL EVIDENCE.—While it may be true that a machine is not written or higher evidence, within the technical terms of the rule that secondary evidence will not be admitted when written or higher evidence exists and may be obtained, it is within the meaning of the larger rule of evidence that no evidence of a merely substitutionary character will be received when the original or primary evidence is producible. *Id.*

23. EVIDENCE—DECLARATION OF PARTY—RES GESTÆ—The conversations and declarations of an inventor, stating that he had made an invention, coupled with a description of its nature and objects, are to be deemed as part of the *res gestæ*, and legitimate evidence that the invention was then known to and claimed by him; and thus its origin may be fixed at least as early as that period. (Philadelphia and Trenton R. R. Co. *v.* Stimpson, 14 Peters, 462.) *Stevens et al.* v. *Salisbury*, 379.

24. COPIES OF MEMORANDUMS AND LETTERS—EFFECT OF.—Records of memorandums and copies of letters cannot be considered as evidence *per se*. The

EVIDENCE—*continued.*

originals might have been used to refresh the memory of the witness; but where it does not appear that this has been done, the copies cannot be used as confirmatory of the testimony of the witness. *Jones* v. *Wetherill*, 409.

25. SM—INCOMPLETE RECORDS.—Where the party presents copies of his memoranda, which are incomplete in important respects, it affords grounds for an unfavorable inference. *Id.*

26. EVIDENCE—PARTY AS WITNESS—EFFECT OF ASSIGNMENT.—A party named on the record cannot be released by an assignment of his invention so as to constitute him a competent witness. *Hill* v. *Dunklee*, 475.

27. TESTIMONY—CONVERSATIONS AND DECLARATIONS OF INVENTOR, EVIDENCE OF WHAT.—The conversations and declarations (of the patentee), stating that he had made an invention, and describing its details, are properly to be deemed an assertion of his right at that time as an inventor to the extent of the facts and details which he then makes known. (P. & T. R. R. Co. *v.* Stimpson, 14 Peters, 448.) *Davidson* v. *Lewis*, 599.

EVIDENCE OF INVENTION.

See LACHES, 1.

1. SLIGHT EVIDENCE OF INVENTION REQUIRED.—But slight evidence of invention is required where the nature of the invention is pointed out and where proof is given of its practical utility. *In Re Fultz*, 178.

2. WITNESS TO INVENTION NEED NOT BE AN EXPERT.—It is not necessary that a witness should qualify as an expert to testify to the fact and date of an invention, if his knowledge and memory are sufficient to enable him to truly relate the facts on the subject which he has heard and seen. *Screw Co.* v. *Sloan*, 210.

3. INVENTION NOT EVIDENCED BY DRAWINGS OR MODELS.—If an invention has been evidenced by oral description, it is not necessary that it should be reduced to the form of drawings or models until the application is filed. *Stephens et al.* v. *Salisbury*, 379.

EXAMINATION OF APPLICATION.

See ABANDONMENT, 4.
COMMISSIONER'S ANSWER.
JURISDICTION OF THE COMMISSIONER, 3.
JUDGE'S DECISION, EFFECT OF.
OFFICERS OF THE PATENT OFFICE, 2.
PUBLIC USE AND SALE, 3, 10.
REASONS OF APPEAL, 11.
SUFFICIENTLY USEFUL AND IMPORTANT, 2, 3, 5.

1. SIXTH AND SEVENTH SECTIONS OF ACT OF 1836 MUST BE TAKEN TOGETHER IN EXAMINING APPLICATIONS.—The seventh section of the act of 1836, authorizing the Commissioner to reject the application in certain specified cases, must be taken in connection with the sixth section, which declares what persons may obtain a patent; and if the subject of the application is not a new and useful art, &c., within the meaning of section 6, the Commissioner

EXAMINATION OF APPLICATION—*continued.*

is bound to refuse it, although it may not be liable to the particular objections specified in the seventh section. *In Re Kemper*, 1.

2. NEW OATH—NOT REQUIRED ON APPEAL.—An applicant is not required to file a new oath, after being finally rejected, to enable him to appeal. *In Re Crooker*, 134.

3. SM—ERRORS AND MISTAKES IN SPECIFICATIONS.—The new oath referred to in the seventh section of the act of 1836 is to be taken only when the applicant persists in his application, after having been informed by the Commissioner of the errors and defects of his specification. This happens before his claim is finally rejected. *Id.*

4. REJECTION OF APPLICATION—NOTICE THEREOF—NEW REFERENCES ON APPEAL.—When an application for a patent is rejected, the applicant is entitled to notice thereof, and to be furnished with such information and references as may be useful in judging of the propriety of renewing his application or altering his specification; and it would be a substantial denial of this right for the judge, upon appeal, to rest an adverse decision upon references for the first time presented in the Commissioner's answer to the reasons of appeal. *In Re Jewett and Root*, 259.

5. The object of the last part of the seventh section appears to be (on refusal to grant the patent) to direct a proceeding whereby the applicant will be allowed, under the particular circumstances stated, to withdraw or modify his specification; and if he persists in the latter, to give him the benefit of an appeal to a board of examiners. This construction is necessary in order to make one part of the section consistent with the other. *Hunt* v. *Howe*, 366.

6. OFFICE PRACTICE—FORMS OF PROCEDURE IN THE OFFICE—NOT APPEALABLE.—As the manner in which the Commissioner shall aid the inventor—by information and suitable references, so as to assist his judgment in determining whether he shall persist in or abandon his claim—is submitted to the discretion of the Commissioner, no appeal lies from his action in this regard to the Circuit Court. *In Re Chambers*, 641.

EXAMINATION OF WITNESS.

See EVIDENCE, 24.
NOTICE, 1, 3, 4.
WITNESSES, 8.

1. EVIDENCE—CROSS-EXAMINATION WAIVES OBJECTION.—Where a party to the case, otherwise an incompetent witness, is produced to prove the loss of original drawings and sketches, and is cross-examined at large, his answers are thereby made evidence for himself. *Perry* v. *Cornell*, 68.

2. PLEA OF DISCLOSING PRIVATE AFFAIRS.—Where a witness on direct examination has voluntarily referred to his own affairs in connection with the history of the invention, he cannot on cross-examination refuse to divulge the full particulars of the same on the ground that it will expose his private business. *Nichols* v. *Harris*, 302.

3. SM—LATITUDE ON CROSS-EXAMINATION.—Nor was it necessary for counsel to state that the purpose of the examination was to effect the credit of the

EXAMINATION OF WITNESS—*continued.*

witness, as that would defeat its very object. Much greater latitude is allowed on cross-examination than on direct. *Id.*

4. EVIDENCE—PARTIAL EXAMINATION.—Where a witness has fixed the date of the invention by reference to a device of his own invention, it is competent for the other side, on cross-examination, to call out a full description of the device and when made, with a view of showing that the witness was mistaken in his dates. *Id.*

5. REFUSAL TO ANSWER ON CROSS-EXAMINATION.—A witness, on cross-examination, is bound to answer all material and proper questions; and his refusal to do so, or the giving of an evasive answer, shows a want of fairness on his part that must be considered as affecting the credit to be given to his testimony. *Cornell* v. *Hyatt*, 423.

6. RE-EXAMINATION AS TO NEW MATTER.—After a witness has been examined in chief and cross-examined, he cannot be recalled and re-examined as to new matter. The re-examination must be confined to a reaffirmance of the facts already stated and in explanation of the facts stated upon cross-examination. A second deposition taken in violation of this rule, suppressed. *Hill* v. *Dunklee*, 475.

EXAMINERS OF THE PATENT OFFICE.

See OFFICERS OF THE PATENT OFFICE.

EXPERIMENT.

See ABANDONED EXPERIMENT.

EXPERT.

COMPARATIVE MERIT OF INVENTIONS.
COPY AS EVIDENCE.
EVIDENCE OF INVENTION.
SPECIFICATIONS, 2.
UTILITY, 1.

TESTIMONY OF EXPERTS.—The testimony of practical persons versed in the art to which the invention relates may be considered in judging of the substantial identity of the inventions. *Stevenson* v. *Hoyt*, 292.

EXTENT OF USE.

See INVENTOR NOT AWARE OF THE VALUE OF THE INVENTION.

EXTENDING TIME, MOTION FOR.

See INTERLOCUTORY ACTIONS, 3.

MOTION TO EXTEND TIME—ESSENTIALS THERETO.—On a motion to extend the time of taking testimony in an interference proceeding in the Patent Office, the affidavits should state the names, competency, and materiality of the witnesses to be examined. *Screw Co.* v. *Sloan*, 210.

FEE.

See WITHDRAWAL OF APPLICATION, 1, 2.

FIRST INVENTOR.

See INTERFERENCE, 10.
INVENTOR NOT AWARE OF THE VALUE OF THE INVENTION.
PRIOR INVENTION, 2.

1. INTERFERENCE—PRIORITY OF INVENTION—FIRST ORIGINAL INVENTOR.—It is not sufficient to show as against a contending applicant that the invention was original, and that the inventor had no notice of the rival invention. The law requires that the patentee should not only be an original, but the first original inventor. *Spain et al.* v. *Gamble et al.*, 358.
2. FIRST INVENTOR—BEFORE ALL OTHERS.—The expression in our statute means that the patentee must have been the inventor first in point of time before all others. *Wellman* v. *Blood*, 432.

FORFEITURE.

See ORIGINAL INVENTOR, 3.
PRIOR INVENTION, 5.
PUBLIC USE AND SALE, 21.

FOREIGN PATENT.

See CONTINUOUS APPLICATION.

FOREIGN PATENT—MUST BE PRIOR TO INVENTION.—*Semble*, that a foreign patent, to bar the domestic applicant, must have been issued before the date of the domestic invention. *Matthews* v. *Wade*, 143.

FORM.

See CHANGE, 1.
COMBINATION, 3.
IDENTITY OF INVENTION, 3.
INTERFERENCE, 8.
PARTICULAR INVENTIONS, 5.

FORMER COMMISSIONER, DECISION OF.

1. DECISION OF FORMER COMMISSIONER—REFUSAL TO REHEAR NOT APPEALABLE.—The refusal of one Commissioner to rehear a case decided by his predecessor is not a ground of appeal to the judge. The acts of 1836 and 1839 only give an appeal from the refusal of the Commissioner to issue a patent. *In Re Janney*, 86.
2. NO LIMITATION OF APPEAL.—*Semble*, that the applicant might still appeal from the decision of the former Commissioner, there being in the act no limitation of time as to the appeal. *Id.*
3. DECISION OF FORMER COMMISSIONER.—The practice of reviving cases decided by a former Commissioner upon frivolous grounds commented upon and disapproved. *In Re Littlefield*, 574.

FORMER INTERFERENCE.

See DEPOSITIONS, 3, 4.
NEW PARTY.
WITNESSES, 10.

FORMER DECISION.

See FORMER COMMISSIONER, DECISION OF, 1.

FRAUD.

See PREMATURE ISSUANCE OF PATENT.

GENERAL USE.

See PUBLIC USE AND SALE, 5, 14.
UTILITY, 4.

GROUNDS OF COMMISSIONER'S DECISION.

See APPEAL, GROUND OF, 2.
EVIDENCE, 7.
EXAMINATION OF APPLICATION, 4.
REPLY TO COMMISSIONER'S ANSWER.
REVISION OF COMMISSIONER'S DECISION.

REASONS OF APPEAL—SUFFICIENCY OF.—It is immaterial what reasons the Commissioner assigns for his decision. His reasons may be insufficient, and yet the decision may be correct. Such insufficient reasons are no ground for revising his decision. *In Re Aiken*, 126.

HEARSAY EVIDENCE.

See EVIDENCE.

HUSBAND AND WIFE.

TESTIMONY OF WIFE INADMISSIBLE.—The wife of an applicant for a patent is an incompetent witness for him in an interference proceeding. *Nichols* v. *Harris*, 302.

IDENTITY OF INVENTION.

See COMBINATION, 3.
EXPERT.
INTERFERENCE, 4, 5, 8, 12, 13, 14, 16, 18, 19.
PARTICULAR INVENTIONS, 2, 11.
PRINCIPLE, 2.
PRINCIPLE OF MACHINE.

1. SUBSTANTIAL IDENTITY—PURPOSE.—Two inventions are the same in principle when they produce the same result by substantially the same mode of operation—as protecting the rear step of an omnibus by a shield moving with the door—notwithstanding the form of the devices and their mode of attachment may be different. *Stevenson* v. *Hoyt*, 292.

2. IDENTITY OF INVENTIONS—SAME IN PRINCIPLE AND RESULT.—When two machines are substantially the same, and operate in the same manner to produce the same result, they must be in principle the same; and it is to be understood that when the results are referred to as a test of the identity of the machines, the results must be the same in kind though they may differ in degree. *Nichols* v. *Harris*, 362.

IDENTITY OF INVENTION—*continued.*

3. FORM—PRINCIPLE.—A machine is the same in substance as another if the principle be the same in effect, though the form of the machine be different. *In Re Nutting*, 455.

4. INVENTION—IDENTITY—IMMATERIAL CHANGES.—When two devices perform the same function in substantially the same way, mere details of mechanical construction—as size, position, and mode of attachment—regarded as immaterial to the question of identity. *In Re Bishop*, 519.

IMITATION OF NATURAL PRODUCT.

See COMPOSITION OF MATTER.

IMPLIED LICENSE.

IMPLIED LICENSE SUFFICIENT TO EXCLUDE WITNESS.—Where a person took an assignment under an impression that a certain improvement upon the original invention was included in the patent, and he used such improvement with the consent and permission of the patentee: *Held*, That he had an implied license from the patentee to continue the use of said improvement, which would discontinue upon the issuance of a patent to another inventor, and that he was an incompetent witness for his licensor in an interference proceeding. *Screw Co.* v. *Sloan*, 210.

IMPROVEMENT.

See CLAIM, 1.
EQUIVALENT, 5.
IMPLIED LICENSE.
UTILITY, 4.

INCHOATE RIGHT.

See LACHES, 1.
PRIOR INVENTION, 4.
SECRET INVENTION, 1.

INFRINGEMENT SUIT.

See INTERFERENCE, 1, 21.
OATH OF INVENTION, 1.
PRINCIPLE, 2.
PRIOR INVENTION, 5.

INTENTION.

See ACCIDENT AND DESIGN, 1, 2.
COMBINATION, 8.
PUBLIC USE AND SALE, 20.

INGREDIENTS.

See COMPOSITION OF MATTER.

INTEREST IN THE SUIT.

See EVIDENCE, 1, 5, 11, 12, 14, 15, 18, 20, 26.
IMPLIED LICENSE.
TESTIMONY, 1.
WITNESSES, 1.

1. COMPETENCY OF WITNESS—INTEREST IN THE SUIT.—When a question is raised as to the competency of a witness on the ground of interest, the usual test is to consider whether the witness will be affected by the event of the suit; that is, whether he has an interest, legal or equitable, (if real,) which will be secured or continued to him in the event of success, or lost in the event of the defeat, of the party in whose favor he is called as a witness. *Screw Co.* v. *Sloan*, 210.

2. SM—TESTIMONY OF ASSIGNEE OR LICENSEE INADMISSIBLE.—An assignee or licensee has an interest in the issuance of a patent to his assignor or licensor as against a rival claimant. *Id.*

INTERFERENCE.

See APPEAL, GROUND OF, 4.
CAVEAT, 1.
DILIGENCE, 4.
EVIDENCE, 1, 2, 3, 6, 11, 18.
EXPERT.
IDENTITY OF INVENTION, 1, 2.
IMPLIED LICENSE.
JURISDICTION OF COMMISSIONER, 3.
MAGISTRATE OF COUNSEL.
NEW PARTY.
NEW TRIAL, 1, 3.
OPERATIVENESS OF INVENTION.
POWER OF COMMISSIONER, 1.
PRINCIPLE, 2.
PRINCIPLE OF MACHINE.
PRIOR INVENTION, 5, 8.
PUBLIC USE AND SALE, 9, 11, 15.
REDUCTION TO PRACTICE, 4.
REHEARING, 1, 2.
UTILITY, 3.

1. INTERFERENCES—NOT GOVERNED BY RULINGS IN INFRINGEMENT SUITS.—The doctrines as laid down by the courts in infringement suits in considering whether patents already granted are invalidated by prior use are wholly inapplicable to the determination of interference controversies in the Patent Office where the only question is whether the Commissioner shall issue the patent. When a patent is thus issued, its validity is still an open question for the courts, and one which can be conclusively settled by the courts only. *Heath* v. *Hildreth*, 12.

2. INTERFERENCE—QUESTION IS WHETHER APPLICANT IS ENTITLED TO A PATENT.—In an interference between an applicant and a patentee the question is

INTERFERENCE—*continued.*

whether the applicant is the first inventor; for if he is not, it is immaterial to the cause who is. *Warner* v. *Goodyear*, 60.

3. INTERFERENCE PROCEEDINGS—DECISIONS OF THE COURTS DO NOT APPLY.—The cases cited from the books are all cases in law or in equity in actions for violation of patents already granted. The proceedings before the Commissioner are initiatory. The question is whether the patent shall be granted, not whether it shall be vacated; and a patent may be granted upon less evidence than would be required to sustain or amend it. *Perry* v. *Cornell*, 68.

4. PRIORITY OF INVENTION IMPLIES INTERFERENCE—COMMISSIONER AND JUDGE HAVE JURISDICTION.—The question of priority of right or invention necessarily implies interference. If there is no interference between the parties, no question of priority can arise. Both the Commissioner in the premises and the judge upon appeal must pass upon the question of interference as preliminary to and as giving them jurisdiction of the question of priority. *Bain* v. *Morse*, 90.

5. NOTICE OF INTERFERENCE NOT CONCLUSIVE—STILL QUESTION FOR FINAL HEARING.—In notifying the parties to appear before him in accordance with the provisions of the eighth section of the act, the Commissioner decides *pro hac vice*, and for that purpose only, that an interference exists. Upon the hearing he decides finally whether or not an interference in fact exists. From that decision either party may appeal to the judge. *Id.*

6. SUBJECT OF INTERFERENCE—MUST BE PATENTABLE—AND CLAIMED BY BOTH PARTIES.—The interference mentioned in the eighth section of the act of 1836 must be an interference with respect to patentable matters, and the claims of the applicants must be limited to the matter specifically set forth in their respective specifications; and what is not thus claimed may, for the purpose of this preliminary inquiry, be considered disclaimed.—*Id.*

7. SM—SM—APPEAL TO JUDGE.—Upon appeal to the judge in an interference, the question is, does the appellant claim a patent for any matter now patentable for which the other party claims a patent. *Id.*

8. CLAIMS OF BAIN AND MORSE DO NOT INTERFERE.—It appearing from a consideration of the state of the art that the specifications and claims of Bain and Morse, respectively, must be construed as limited to the combination of elements therein set forth, and that there is an important difference in the form and structure of the devices constituting these combinations, and that the claim of Bain is further limited to the use of the invention in combination with certain old devices not included in Morse's apparatus: *Held*, That no interference in fact exists between the respective applications, and that each party is entitled to a patent for the matter claimed by him. *Id.*

9. INTERFERENCE—QUESTION AT ISSUE.—A question raised in connection with an application not in interference cannot be considered by the judge upon appeal. *Ruggles* v. *Young*, 160.

10. INTERFERENCE—APPLICANT AND PATENTEE—QUESTION AT ISSUE.—In an interference between an applicant and a patentee, the only question of importance is whether the applicant is the first inventor; for if he is not, it is immaterial to the case who is. *Burlew* v. *O'Neil*, 168.

INTERFERENCE—*continued.*

11. SM—SM—ADMISSIBLE TESTIMONY IN SUCH CASE.—Testimony taken in such a case, showing that the patentee made the invention before the applicant, is properly receivable in evidence, and is decisive of the cause, though the testimony might at the same time disclose valid objections to the grant of a patent to the patentee if that question were still open for consideration. *Id.*

12. INTERFERENCE—SUBJECT OF—HOW DETERMINED.—The nature of the invention in interference is to be determined by regarding the essential principles common to the conflicting inventions, and disregarding mere formal differences and the substitution of equivalents. *Yearsley* v. *Brookfield et al.*, 193.

13. QUESTION OF PRIORITY OF INVENTION—IMPLIES INTERFERENCE—INTERFERING MACHINES.—The question of priority of invention can only arise in such manner as to defeat an application for a patent when there is an interference according to the principles of the patent law, by which principles there must exist substantially an identity; and in the case of interfering machines the *modus operandi* may be looked to as a test. *Tyson* v. *Rankin et al.*, 262.

14. INTERFERENCE DISSOLVED—DIFFERENCE IN CONSTRUCTIVE OPERATION—PURPOSE.—The interference dissolved, it appearing that while there was a general similarity in the inventions of the respective parties, in the fact that both inventions contemplated the addition of flanges to the ends of propeller blades, the disposition of the flange with reference to the blade was different in each case, was intended for a different purpose, and accomplished a different result. *Id.*

15. INTERFERENCE—PATENTEE—HOW RESTRICTED IN HIS PROOFS.—In an interference proceeding a patentee is not restricted in his proofs to the exact point of invention covered by his patent that is claimed therein. If he prove to be the prior inventor of anything claimed by the applicant, the Commissioner may act upon such information, and his decision thereon may be reviewed by the judge upon appeal. The question is not the same as in a suit for the infringement of the patent. *Stephenson* v. *Hoyt*, 292.

16. INTERFERENCE—QUESTION STATED.—In an interference the question is not whether one invention is better in some respects than the other, but whether there is a substantial interference in the principle of the two inventions. *Id.*

17. PATENTABILITY OF ISSUE—PRACTICE OF THE OFFICE—PRESUMPTIONS THEREFROM NOT CONCLUSIVE.—The fact that it is the uniform practice of the Office never to raise the issue of interference until after the patentability of an invention, which is supposed to be a previous and preliminary point, has been favorably settled in the mind of the Commissioner, does not raise a presumption of patentability which is conclusive in the further proceedings in the case. *Burrows* v. *Wetherill*, 315.

18. INTERFERENCE—MATTER CLAIMED.—When two applications are properly in interference upon their claims as made it is unnecessary to consider whether there are differences between the two machines which might entitle one

INTERFERENCE—*continued.*

or the other party to a patent if the claims had been presented in a different shape. *Spain et al.* v. *Gamble et al.*, 358.

19. INTERFERENCE — PATENTABILITY — JURISDICTION. — Construing the sixth, seventh, and eighth sections of the act of 1836 together, it is clear that the interference referred to in the eighth section is an interference between patentable inventions. That is a preliminary question necessarily involved in the Commissioner's decision upon priority of invention, and may be considered by the judge upon appeal. *Jones* v. *Wetherill*, 409.

20. INTERFERENCE—NOT CONFINED TO CONFLICTING CLAIMS.—An interference exists between two applicants who describe in their specifications the same invention, although the claim of one of the parties is not as broad as his specification. *King* v. *Gedney*, 443.

21. PRESUMPTION FROM PATENT—DECISIONS IN INFRINGEMENT SUITS.—The presumption of invention arising out of the grant of the letters-patent, and against which the defendant in an infringement suit must contend, does not exist as between contending applicants for patent; and the application of the decisions of the courts to interference cases is modified by that circumstance. *Hill* v. *Dunklee*, 475.

22. INTERFERENCE—PRACTICE OF THE OFFICE—PATENTABILITY OF THE ISSUE.—The practice of the Office in determining the patentability of the invention before the interference is declared is a proper one, and should be strictly observed. *Chandler* v. *Ladd et al.*, 493.

INTERLOCUTORY ACTIONS.

See APPEAL, GROUND OF, 1.
DEPOSITIONS, 1, 2.
LIMIT OF APPEAL, 2, 4.
NEW TRIAL, 2, 4, 5, 6.
POWER OF COMMISSIONER, 1.
POSTPONING HEARING.
REASONS OF APPEAL.

1. INTERLOCUTORY ORDER BY JUDGE—ADMITTING NEW EVIDENCE.—If, therefore, a party has been denied the privilege of submitting proper proofs of his invention, it is the duty of the judge, by reasonable regulations similar to those directed by section 12, to pursue such a course as to afford an opportunity to the party to produce and lay before him on the trial his proof to support his claim. *In Re Fultz*, 178.

2. DECISION OF COMMISSIONER NOT APPEALABLE.—The decision of such a motion is wholly within the discretion of the Commissioner, and will not be reviewed upon appeal to the court. *Screw Company* v. *Sloan*, 210.

3. RIGHT OF APPEAL—INTERLOCUTORY DECISIONS NOT APPEALABLE—EXTENDING TIMES FOR TAKING TESTIMONY.—Interlocutory questions which arise in the course of the trial before the Commissioner, such as the question whether the times for taking testimony shall be extended, are submitted to the sound discretion of the Commissioner; and from his decision no appeal lies to the court, unless in case of gross abuse, which is not to be presumed. *Wellman* v. *Blood*, 432.

ISSUANCE OF PATENT.

See JURISDICTION OF THE COMMISSIONER, 1.
POWER OF COMMISSIONER, 1, 2.
PREMATURE ISSUANCE OF PATENT.
REISSUE.
RIGHT OF APPEAL, 6.
REDUCTION TO PRACTICE, 3.

INVALID PATENT.

See REISSUE.

INVENTION.

See ACCIDENT AND DESIGN, 1, 2.
ACCIDENTAL DISCOVERY.
ACTUAL USE, 3.
ANALOGOUS USE.
ARTICLE OF MANUFACTURE.
CHANGE, 3, 5.
CHANGE OF MATERIAL.
COMBINATIONS.
DISCOVERY.
DOUBLE USE.
EQUIVALENT, 2, 3, 4, 5.
EVIDENCE OF INVENTION, 1.
IDENTITY OF INVENTION, 4.
NOVELTY, 1, 2.
OATH OF INVENTION, 1, 4.
ORIGINAL INVENTOR, 1.
PARTICULAR INVENTIONS.
PRINCIPLE, 1, 3, 4.
REARRANGING PARTS OF MACHINE.
RESULT, 1, 2, 3.
SUFFICIENTLY USEFUL AND IMPORTANT, 1, 4.
UTILITY, 3.

1. INVENTION—DOUBLE USE.—The application of an ordinary power to an ordinary purpose is not an invention within the meaning of the patent law. *Cochrane* v. *Waterman*, 52.

2. SM—SM—APPLICATION OF ENDLESS SCREW AND WHEEL TO CAPSTAN NOT PATENTABLE.—The endless screw and wheel is a common mechanical power applicable to an indefinite number of machines, and the mere application of it to the segmental-rack or quadrant on the rudder-head for the first time is not an invention, although it enables the helmsman to hold and stay the rudder with more ease. *Id.*

3. AMOUNT OF INVENTION.—It is no objection that a combination appears to be simple, and the invention not very great, if it be not frivolous and foolish. *In Re Smith*, 255.

4. INVENTION—CHANGE—IMPROVED RESULT.—When the change in the construction and mode of operation is slight, but the consequences of that change

INVENTION—*continued.*

are considerable, as established by the affidavits of persons who have made actual tests of the devices in question, there is sufficient invention to support a patent. *In Re Walsh*, 530.

5. INVENTION—ICE PITCHER—COMBINATION.—In an ice pitcher, the combination of an interior lining of porcelain or glazed ware to resist the action of acids, an outer metallic shield and an interposed elastic non-conducting material, to prevent the fracture of the porcelain and intercept the rays of heat: *Held*, Not to be anticipated by a double-walled pitcher composed entirely of metal, in which the intervening air-space was not designed, and did not in fact operate, as a non-conducting medium. *In Re Hebbard*, 543.

INVENTOR NOT AWARE OF THE VALUE OF HIS INVENTION.

See ACCIDENTAL DISCOVERY.

INVENTOR NOT AWARE OF THE VALUE OF HIS INVENTION.—An inventor may not be aware of the full value of his invention, but under the patent laws the fact of invention, and not a knowledge of the degree of its utility, is the proper subject of inquiry. If an inventor omits to test the value of his invention, and fails to bring it into use, and remains ignorant of the extent of its value, he is yet entitled to a patent as against a subsequent discoverer. *Farley* v. *National Steam-Gauge Co.*, 618.

JOINT INVENTION.

See EVIDENCE, 13.

1. SOLE AND JOINT INVENTION DEFINED—NEITHER CAN OBTAIN A SOLE PATENT.—The man who reduces to practice the theory of another, who assists in the reduction of it to practice, cannot be considered as the sole inventor of the machine. The invention consists both in the discovery of the principle and the reduction of it to practice. In such a case neither party can be considered as sole inventor. *Arnold* v. *Bishop*, 27.

2. JOINT INVENTOR CANNOT TAKE PATENT IN HIS OWN NAME.—A joint inventor cannot take a patent in his own name. By the sixth section of the act of 1836 the applicant must be the inventor. But one of several joint inventors cannot with propriety be called *the* inventor; and if he applies for a patent, the Commissioner is bound to refuse it, although that is not expressly named in the seventh section as one of the grounds upon which he is authorized to refuse a patent. *Arnold* v. *Bishop*, 36.

JUDGE'S DECISION, EFFECT OF.

See PROCEEDINGS BEFORE COMMISSIONER, 1.

EFFECT OF DECISION OF JUDGE ON FURTHER PROCEEDINGS IN CASE.—*Semble*, on the other hand, that the judge's decision will govern the further proceedings of the Commissioner in the case only so far as it is decisive of the points raised in the reasons of appeal; and if other sufficient reasons remain for rejecting the claim for a patent, untouched by the decision of the judge, the Commissioner may properly still reject it. *Arnold* v. *Bishop*, 36.

JURISDICTION OF THE COMMISSIONER.

See ABANDONMENT, 3, 4.
EVIDENCE, 2.
INTERFERENCE, 4, 15.
POWER OF COMMISSIONER, 3.
PUBLIC USE AND SALE, 2, 3, 10, 11.

1. PATENT GRANTED—JURISDICTION OF COMMISSIONER.—When a patent has issued, the jurisdiction of the Commissioner is exhausted. He has no further control over it, except in the case provided for in the thirteenth section of the act of 1836, when the patent is inoperative or invalid by reason of a defective or insufficient specification. *Pomeroy* v. *Connison*, 40.
2. JURISDICTION OF THE COMMISSIONER.—The Commissioner of Patents is now vested with the whole and only original initiatory jurisdiction that exists up to the granting and delivering of the patent. *Hunt* v. *Howe*, 366.
3. REFUSAL OF APPLICATION—DELIVERY OF THE PATENT.—The jurisdiction of the Commissioner to refuse a patent continues after interference is declared and until the patent is delivered. *Mowry* v. *Barber*, 563.

JURISDICTION OF THE JUDGE.

ABANDONMENT, 3.
APPEAL.
APPEAL, GROUND OF, 4, 5.
BOARD OF EXAMINERS, 2.
COMMISSIONER AND EXAMINERS UNDER OATH, 2.
DELAY IN FILING APPLICATION, 2.
EVIDENCE, 2, 10.
INTERFERENCE, 4, 7, 9.
INTERLOCUTORY ACTION, 1.
OFFICERS OF THE PATENT OFFICE, 3.
REASONS OF APPEAL.
REHEARING, 1.
RIGHT OF APPEAL, 4, 10.

JURISDICTION OF THE JUDGE—REASONS OF APPEAL.—The jurisdiction of the judge on appeal is limited and confined to the reasons of appeal; and whatever weight the judge may think is due to the arguments of counsel, he must disregard them if not within the reasons. *Burlew* v. *O'Neil*, 168.

JURY.

See DELAY IN FILING APPLICATION, 2.
PREMATURE ISSUANCE OF PATENT.

JUST AND REASONABLE REGULATIONS.

See RULES FOR TAKING TESTIMONY.

LACHES.

See ABANDONMENT, 1.
ACTUAL USE, 2.

LACHES—*continued.*

DELAY IN APPLYING FOR REISSUE.
DELAY IN FILING APPLICATION.
DILIGENCE.
DISCLOSURE OF INVENTION.
POVERTY.
PUBLIC USE AND SALE, 19.
SECRET INVENTION, 2.

1. LACHES—DRAWING ELEVEN YEARS BEFORE—RIGHT TO PATENT FORFEITED.—When an applicant in interference with a patent issued to an original and independent inventor, four years before his application was filed, based his claim to priority on a drawing made eleven years before, and it did not appear that he had in the meantime taken any steps to perfect his invention or bring it into notice, the only explanation offered for the delay being that he had supposed—erroneously, as it appears—that his original drawing of the invention was lost: *Held*, That by his laches he had lost his inchoate right to a patent. *Ellithorp* v. *Robertson*, 585.
2. The right of the first and original discoverer to a patent cannot be defeated by a subsequent patentee unless the latter shows that the former has been guilty of culpable neglect and laches. *Spear* v. *Belson*, 699.

LAPSE OF TIME.

See ABANDONMENT, 1.
DISCLOSURE OF INVENTION.
MEASURE OF PROOF.
WITNESSES, 6, 7.

LICENSE.

See CONSTRUCTION OF THE STATUTE.
IMPLIED LICENSE.
PROCESS, 1.

LIMIT OF APPEAL.

See FORMER COMMISSIONER.
RIGHT OF APPEAL, 6.
TIME FOR FILING APPEAL, 1.

1. LIMITATION OF RIGHT OF APPEAL.—No appeal from the decision of the Commissioner can be considered unless the reasons of appeal were filed within the specified time. *Greenough* v. *Clark*, 173.
2. LIMIT OF APPEAL ABSOLUTE—MOTION TO REHEAR DOES NOT EXTEND.—After the expiration of the time set by the Commissioner, under authority of section 11, act of 1839, for filing the reasons of appeal, the right of appeal is gone, nor will the pendency of a motion to rehear the case of itself enlarge the time for filing the reasons of appeal without a special order by the Commissioner to that effect. *Id.*
3. LIMIT OF APPEAL.—When the Commissioner has fixed no time within which

LIMIT OF APPEAL—*continued.*

the party may appeal, an appeal may be taken at any time. *Carter et al.* v. *Carter et al.*, 388.

4. LIMIT OF APPEAL—MAY BE ENLARGED.—When the appeal in other respects had pursued its regular course, but it appeared that the "reasons of appeal" were filed a few days after the expiration of the limit of appeal, it was assumed by the judge that the Commissioner, in the exercise of his discretion, had enlarged the limit of appeal. *Blackinton* v. *Douglass*, 622.

5. LIMIT OF APPEAL—DISCRETION OF COMMISSIONER—HOW FAR AFFECTED BY ORDER OF THE SECRETARY.—The Commissioner may, in his discretion, enlarge the limit of appeal from his decision; and his act in that regard is not reviewable by the judge upon appeal, although he so extended the time upon the suggestion or order of the Secretary of the Interior. If he should refuse to comply with such a request of the Secretary, a question might then arise for the court to decide. *Justice* v. *Jones*, 635.

LIMITATION OF PATENT.

See TERM OF PATENT.

LOSS OF ORIGINAL PAPER.

See EVIDENCE, 11.
EXAMINATION OF WITNESSES, 1.

MAGISTRATE OF COUNSEL.

MAGISTRATE OF COUNSEL.—Neither upon principle nor authority is it just or reasonable that the evidence taken in a contested proceeding in the Patent Office should be taken before a magistrate who is of counsel for one of the parties; and depositions so taken held to be legally incompetent and inadmissible evidence in the case. *Nichols* v. *Harris*, 302.

MANUAL DEXTERITY.

See EMPLOYER AND EMPLOYEE, 3, 4.

MATTER SHOWN BUT NOT CLAIMED.

See PRIOR PATENT, 2.
SECOND PATENT FOR SAME INVENTION.

MEASURE OF PROOF.

ABANDONMENT, 6.
EVIDENCE OF INVENTION, 1, 3.
INTERFERENCE, 3, 11.
NOVELTY, 1.
OPERATIVENESS OF INVENTION.

MEASURE OF PROOF VARIES—VERBAL DESCRIPTION OF INTRICATE DEVICES.—The measure of proof requisite to show the date of an invention on an issue of priority depends upon the nature of the invention, the capacity of the wit-

MEASURE OF PROOF—*continued.*

nesses, and the distance of time. Where the invention is complicated of many parts, contrivances, and devices, mere verbal description may be insufficient to establish the priority of invention without the support of contemporaneous drawings or models. *Stevens et al.* v. *Salisbury*, 373.

MECHANICAL SKILL.

See ANALOGOUS USE.
CHANGE, 2, 3.
EMPLOYER AND EMPLOYEE, 3, 4.
IDENTITY OF INVENTION, 4.
ORIGINAL INVENTOR, 1.
PARTICULAR INVENTIONS, 14.

MERITS OF THE CASE.

See EVIDENCE, 10.
REASONS OF APPEAL, 5.

MISTAKE.

See CLERICAL ERROR.
DELAY IN PROSECUTING APPLICATION.
TERM OF PATENT, 2.
WITNESSES, 5.

MODE OF OPERATION.

See IDENTITY OF INVENTION, 1.
INTERFERENCE, 13.
INVENTION, 4.

MODEL.

See EVIDENCE OF INVENTION, 3.
MEASURE OF PROOF.
OATH OF INVENTION, 2.
PERFECTED INVENTION.
REDUCTION TO PRACTICE, 1, 5, 6.
SPECIFICATION, 1.

MOTION.

See LIMIT OF APPEAL, 2.
NEW TRIAL, 2, 4, 5.
RIGHT OF APPEAL, 6.
UTILITY, 1.

NAKED DISCOVERY.

See DISCOVERY.

NATURAL PRODUCT.

See IMITATION OF NATURAL PRODUCT.

NEGATIVE TESTIMONY.

See TESTIMONY, 3, 5, 6.

NEW APPLICATION.

See CONTINUOUS APPLICATION.
PUBLIC USE AND SALE, 19.
RIGHT OF APPEAL, 8.
SECOND PATENT FOR SAME INVENTION.
WITHDRAWAL OF APPLICATION, 1, 2.

NEW PARTY.

NEW PARTY—NOT A NEW CASE.—When a new party is included in such rehearing or new trial of an interference it does not become a new case within the spirit of the rule excluding depositions taken in another case not between the same parties. Following the chancery rather than the common-law practice, the new party applicant comes in subject to the depositions already taken; and as between the original parties there is no lack of *mutuality*, since the parties and the subject-matter are the same. *Carter et al.* v. *Carter et al.*, 388.

NEW PATENT.

See EQUIVALENT, 1.

NEW TRIAL.

See NEW PARTY.
TESTIMONY, 2.
WITNESSES, 7.

1. FILING A SECOND APPLICATION AFTER INTERFERENCE—STATUS OF.—The filing of a second application by the defeated party to an interference is in effect an effort to have the decision reviewed and reversed upon a hearing or new trial of the first case; and from the refusal of the Commissioner to declare a new interference thereon between the same parties no appeal lies to the judge. *In Re Rouse*, 286.
2. REHEARING—NEW TRIALS—NOT APPEALABLE.—Motions to rehear in chancery and for new trials at law are motions addressed to the discretion of the court, from the refusal to grant which there lies no appeal. *Id.*
3. SECTION 8, ACT OF 1836, CONSTRUED.—There is nothing in section 8 of the act of 1836 which makes it imperative upon the Commissioner to declare as many interferences between the same parties as the defeated party may seek by filing successive applications. The words of the law are satisfied by giving one trial between the same parties upon the same subject-matter. *Id.*
4. ONE TRIAL ONLY BY LAW.—One full, fair, and impartial trial between the same parties and for the same matter of controversy is all that any citizen can claim under this statute or any other law known or practiced by the courts of this country. *Id.*
5. SM—NEW TRIAL UPON MOTION—DISCRETION OF TRIBUNAL.—If such a trial has not been had, the remedy is by rehearing or new trial, or some equivalent

NEW TRIAL.—*continued.*

proceeding in the tribunal where the first trial took place. The sound discretion of that tribunal must be invoked; and from its refusal to interfere there is no appeal. *Id.*

6. SM—SM.—The discretion of the Commissioner ought to be governed by the rules of law; and I know no better guide for him than the rules and principles applicable in courts of justice in cases of rehearing and new trials. *Id.*

7. JURISDICTION—POWER OF COMMISSIONER TO GRANT NEW TRIAL.—Where the decision of the Commissioner was reversed by the judge upon the ground that the depositions of the prevailing party were improperly taken, it is competent for the Commissioner to grant a new trial to afford the parties the opportunity of having their testimony fully and impartially taken. *Nichols* v. *Harris*, 362.

NEW OATHS.

See EXAMINATION OF APPLICATION, 2, 3.

NEW USE OF OLD MACHINE.

See ANALOGOUS USE.
CHANGE, 2, 3.
UTILITY, 3.

COMPARATIVE UTILITY—CAPABLE OF USE.—If an inventor by the dint of his own genius and discovery has found out a new and appropriate manner of operating an old machine to produce a new result he is entitled to a patent therefor, but he is not entitled to claim the machine itself. Where the invention is a machine or substantial thing, which has been completed so as to be capable of use, it is not essential to the validity of the claim that the success of the means made use of should be complete, or that the thing invented should supersede anything else used for the same purpose. The law looks only to the fact that the invention is capable of use. *Burrows* v. *Wetherill*, 315.

NOTICE.

See EVIDENCE, 3.
FIRST INVENTION, 1.
INTERFERENCE, 1, 5.
PREMATURE ISSUANCE OF PATENT.
SECRET INVENTION, 2.
TIME FOR FILING APPEAL, 1.

1. SHORTNESS OF NOTICE—WAIVED BY APPEARANCE.—Objection to shortness of the notice of taking testimony is waived by the appearance at place of examination and cross-examination of the witness. *Arnold* v. *Bishop*, 28.

2. INSUFFICIENCY OF NOTICE OF TAKING TESTIMONY—NOT A GROUND OF APPEAL.—The objection to the insufficiency of the notice of taking testimony must be made at the hearing; otherwise, it appears, it is no ground of appeal. *Smith* v. *Flickenger*, 46.

3. SUFFICIENT NOTICE.—A notice of eleven days before taking testimony at a distance of four hundred miles considered reasonable. *Id.*

NOTICE—*continued.*

4. EVIDENCE—NOTICE—WAIVER.—Depositions taken without notice cannot be read in evidence unless the other party has waived his right to notice and agreed to admit them into the case. *Perry* v. *Cornell*, 66.

5. SM—SM.—A notice from the other party to have the depositions produced before a commissioner for inspection is not a waiver of the right to notice, nor is an offer to have the witness again before the commissioner for cross-examination and the refusal to cross-examine when so produced. The party has a right to be present at the direct examination-in-chief. *Id.*

6. NOTICE—OBJECT OF—HOW WAIVED—RULE 90.—The object of notice generally, and as provided in Office Rule 90, is to bring the adverse party before the examining officer, and to give him the opportunity to cross-examine the witnesses. But if the adverse party voluntarily comes, and is present and cross-examines, notice and proof of service are thereby waived, the substance is obtained, and they are mere form. The adverse party, under such circumstances, is also bound to take notice of the adjournment. *Gibbs* v. *Ellithorp*, 702.

NOTARY PUBLIC.

See MAGISTRATE OF COUNSEL.
RULES OF THE PATENT OFFICE, 3.

NOVELTY.

See ANTICIPATION.
ARTICLE OF MANUFACTURE.
CHANGE, 2, 6.
COMBINATIONS.
COMPARATIVE MERIT OF INVENTION.
COMPOSITION OF MATTER.
DESIGN.
DOUBLE USE.
INVENTION, 1, 5.
OATH OF INVENTION, 1, 4.
PARTICULAR INVENTIONS, 1, 3, 4, 5, 6, 8, 9, 10, 12, 14, 15.
PRINCIPLE, 1, 4.
PROCESS, 2, 3.
RESULT, 2.
SUFFICIENTLY USEFUL AND IMPORTANT, 3.

1. NOVELTY—INVENTION—ENGLISH AND AMERICAN CASES CONTRASTED.—The difference between the English and the American cases on the questions of novelty and invention relate rather to the kind and degree of evidence required. According to the English cases the result of the change alone may furnish a conclusive test of the invention and novelty, while the American authorities hold that it must appear by some other evidence than a mere inspection of the result that the effect was produced by some new process, device, contrivance, mode, manner, or means. *Yearsley* v. *Brookfield et al.*, 193.

2. NOVELTY—RULE IN DOUBTFUL CASES.—On an application for a patent it is

NOVELTY—*continued.*

not proper to question too vigorously the novelty of the invention. The applicant is entitled to the benefit of the doubts that arise upon this subject, for the reason that if his application is unjustly refused it will work an irremediable injury, whereas, if it should appear that the invention is not new, that fact may be established in other proceedings before the courts. *In Re Cole*, 539.

NEW OCCASION.

See DOUBLE USE.

OATH OF INVENTION.

1. OATH OF INVENTOR PRIMA-FACIE EVIDENCE.—The oath of the inventor, unopposed, is some evidence of the novelty, invention, and usefulness of the improvement. The rule of law is that a patent issuing, grounded upon the oath of the patentee, under such circumstances will be considered as *prima-facie* evidence in an action for the infringement of a patent right. *In Re Fultz*, 178.
2. OATH OF INVENTION PRIMA-FACIE EVIDENCE—REDUCTION TO PRACTICE.—The oath of invention accompanying the application is *prima-facie* evidence that the invention therein set forth has been made, and none of the patent laws have ever required that the invention should have been in use or reduced to actual practice before the issuing of the patent otherwise than by furnishing a model, drawing, and description of the invention as required by law. *In Re Seely*, 248.
3. OATH OF INVENTION—COVERS ALL MATTERS DESCRIBED.—The oath of invention attached to the specification covers all matters described therein, and not merely the matters specified in the claim. *King* v. *Gedney*, 443.
4. OATH OF INVENTION—EFFECT OF.—The oath attached to the application is *prima-facie* evidence of the novelty of the invention disclosed therein. *In Re Wagner*, 510.

OFFICERS OF PATENT OFFICE.

See PROCEEDINGS BEFORE COMMISSIONER, 2.

1. OFFICER OF THE PATENT OFFICE AT HEARING.—An officer of the Patent Office may attend the hearing before the judge for the purpose of explaining the decision of the Commissioner. He cannot be considered, however, as counsel for the Commissioner, nor as advocate for either of the parties litigant. *Perry* v. *Cornell*, 66.
2. BOARD OF EXAMINERS—DUTIES OF THE EXAMINERS.—The examiners in the Patent Office are the assistants of the Commissioner in the discharge of his duties, but the Commissioner cannot transfer to them, or any of them, his own power to decide. The examination of the alleged invention required by the seventh section of the law of 1836 may be made by the Commissioner alone, or with the aid of such examiners as he may assign for that purpose, but he cannot constitute them a "board of examiners," known to the law as such. *In Re Aiken*, 126.
3. COMMISSIONER AND EXAMINERS EXAMINED UNDER OATH.—Taking the sections

of the acts of 1836 and 1839, relating to appeals from the decision of the Commissioner, together, it is evident that the judge succeeded to the power formerly conferred upon the board of examiners to require the Commissioner and the examiners in the Patent Office to furnish such information as they might possess relative to the matter under consideration, and so *held:* That, an examiner might be interrogated under oath as to the peculiar nature and features of the invention in dispute. *In Re Seely*, 248.

OPERATIVENESS OF INVENTION.

See APPEAL, GROUND OF, 1.

OPERATIVENESS OF INVENTION—EVIDENCE THEREOF—SUCCESSFUL USE BY OTHERS.—It is essential that the improvement (in case of a machine), as described in the specification, shall, as a matter of fact, be capable of operating in the manner described; and it will be sufficient evidence of this fact if it shall appear in the course of testimony taken in a interference proceeding that the invention has been successful in the hands of others, although the applicant himself, having a mistaken idea of the capacity of the machine, has failed to obtain successful results. *Burrows* v. *Wetherill*, 315.

OLD ELEMENTS.

See COMBINATIONS.
EMPLOYER AND EMPLOYEE, 1, 2.
PARTICULAR INVENTION, 3.

ORIGINAL INVENTOR.

See BURDEN OF PROOF.
UNSUCCESSFUL EXPERIMENT, 2.

1. DISTINCTION BETWEEN SUGGESTION AND DISCLOSURE OF INVENTION.—One person may have suggested to another the idea of some new machine, and yet that other person may be the inventor of that peculiar combination of mechanical principles which is the real invention. *Atkinson* v. *Boardman*, 80.

2. ORIGINAL INVENTOR—SUGGESTIONS BY ANOTHER MERELY AUXILIARY.—Where an inventor has conceived of the improvement and its principle, and is using reasonable diligence to perfect the mechanical details, he will not be deprived of his patent by the fact that another, during the construction of the machine, suggested a merely auxiliary and mechanical device to improve its operation, not requiring the exercise of invention, and capable of being made and applied by any skillful machinist. *Marshall* v. *Mee*. 228.

3. INVENTION OF MACHINE—IMPROVED METHOD OF USING THE SAME.—Where a person has devised a new machine—as a furnace for manufacturing white oxide of zinc—but, having adopted an erroneous plan for using the same—mixing the ore and fuel in improper proportions—has failed to produce good results, another person with a full knowledge of this fact, who shall then discover and apply the proper method of using the machine, is not

ORIGINAL INVENTOR—*continued.*

entitled to a patent for such machine. It would be giving to him the whole invention for the merit of discovering a subordinate part of the same. *Burrows* v. *Wetherill*, 315.

4. ORIGINAL INVENTOR—DELAY—EFFECT OF.—When the invention is "suggested" by one of the parties to the interference, and is reduced to practice by the other in accordance with such suggestion, the party first named is the first and only inventor, and the second party can acquire no title to the invention by the failure of the real inventor to follow up and perfect his invention with reasonable diligence. In such a case the invention would be forfeited, if at all, to the public. *Stearns* v. *Davis*, 696.

ORIGINAL DOCUMENT.

See LOSS OF ORIGINAL PAPER.

PAROL EVIDENCE.

See EVIDENCE.

PARTICULAR INVENTIONS.

See CLAIMS, 2.
ORIGINAL INVENTOR, 2.

1. BRICK PRESS.—It is not a mere change of form to adapt a brick press to the manufacture of tubular brick, by providing the mold-box with a core and a hollow bottom or plunger fitted to discharge the tubular brick; nor is such a machine sufficiently analogous in its uses to be anticipated by a cracker machine, which is similarly provided with a core and a hollow discharging plunger; nor is it anticipated by a brick machine with a solid plunger and a core extending part way only into the brick; nor by all of these together. *In Re Wagner*, 510.

2. BRIDGE RAILS.—Two inventions are not necessarily the same because they have a common purpose. So an interference held to have been improperly declared, it appearing that the common purpose of strengthening bridge rails at the joints was effected in one case by using a two-part rail and sliding the upper part upon the lower, the two parts thus reciprocally breaking joint and supporting each other throughout their length, while, in the other case, a short additional piece of splice-plate was fitted in a similar manner to and placed beneath the adjoining ends of the rails, which were otherwise unaltered, and extended a short distance only from the joint in either direction. *Screw Co.* v. *Sloan*, 210.

3. FIRE-ARMS.—In a fire-arm, the invention of a priming-tube extending from the cap through the charge, and perforated at its forward end next the ball, to fire the charge at that point, is not anticipated by the needle-gun, which fires the charge at the same point by different means, nor by similar priming-tubes, which fire the charge at the rear end, the middle, and the whole length respectively, nor by all of them. It is a new combination, though formed of the substantial constituents of each of the inventions referred to. *In Re Halsey*, 459.

PARTICULAR INVENTIONS—*continued.*

4. GLASS FURNACE.—The use of anthracite coal as a fuel with a blast to produce a diffused heat around the smelting pots in a glass furnace, held not to be a mere analogous or double use of anthracite coal and a blast, as previously used to produce a concentrated heat for various purposes; but a specification which failed to particularly describe and point out the mode of thus regulating the diffusion of the heat, held to be too vague and indefinite. *Yearsley* v. *Brookfield et al.*, 193.

5. ILLUMINATED VAULT COVERS.—It being impossible to determine upon principle what would be the final result of substituting polygonal glasses of an inverted pyramidal form for the lens shaped glasses previously used in illuminated vault covers, and the applicant having offered no evidence of the actual results in practice: *Held*, That the change appeared to be one of form merely, and not patentable. *In Re Jackson*, 485.

6. LETTER FILE.—A blank book or letter file prepared for immediate use, by coating the margins of the leaves with suitable adhesive preparations at the time of manufacture, is not anticipated by the practice of pasting scraps or letters in a blank book not previously prepared, nor by the use of adhesive paper. *In Re Smith*, 255.

7. LIGHTNING RODS.—When an alleged invention—which in this case consisted in surrounding the part of a lightning-rod embedded in the earth with a galvanic battery to facilitate the discharge of the electricity—appears to be on principle wholly incapable of effecting the desired result: *Held*, That the application should be rejected as not sufficiently useful and important. *In Re Cushman*, 569.

8. LIME-KILN.—The application for the first time to a lime-kiln of a blast fan, or of both blast and suction fans, or of an arrangement whereby the heating of the boiler of the blowing engine is effected by the same furnace that heats the kiln, held to be patentable inventions, it appearing that if these features should operate in the manner described they would effect a considerable saving of fuel. *In Re Seely*, 248.

9. MANUFACTURE OF COTTON—GINNING, CARDING, AND SPINNING CONTINUOUSLY.—A claim for a new principle or process of manufacturing cotton, by carding and spinning the cotton in its fleecy state as it comes from the gin in a continuous operation, and before the fibres are disturbed by baling, and the other treatment before used in the process of manufacture to restore it to its original state: *Held*, To be anticipated as a process by Bryant's improvement on the Columbian spinner. *In Re Henry*, 467.

10. METALLIC PAINTS.—A claim for a composition of matter—a metallic paint—possessing no new ingredient or quality in itself, and obtained by well-known methods of treatment from a refuse or waste material which was known to contain the elements of the composition in suitable proportions, is not rendered patentable by the fact that the applicant was the first to utilize the waste in that manner. *In Re Maule*, 271.

11. PRINTING-PRESS.—In a printing-press, an eccentric shaft or pin, passing through or behind the platen, for the purpose of regulating the distance between the platen and the bed, is not the equivalent of an eccentric shaft which passes through the platen and crank arms, having a handle on the

PARTICULAR INVENTIONS—*continued.*

extreme end, the effect of which is to lengthen or shorten the crank arms, and so throw off or on the impression during the operation of the machine. *Ruggles* v. *Young*, 160.

12. STEAM-ENGINE—HOLLOW BED-PLATE.—The application to a portable steam-engine of a hollow bed-plate fastened to the boiler, and supporting the operative parts of the engine out of contact with the boiler, whereby these parts will not be affected by the expansion and contraction of the boiler: *Held*, Not to be a patentable invention, in view of the fact that similar bed-plates had previously been used in various parts of the engine for a similar purpose. It is an obvious application and a mere double use of an old device. *In Re Blandy*, 552.

13. STEAM-PRESSURE GAUGES.—Where the invention consisted in merely substituting a volute spring of a described character for the springs before used in steam-pressure gauges, and the inventor had actually constructed such a spring with the surrounding parts, and had declared that the apparatus was designed as an improvement in steam-pressure gauges: *Held*, That he had sufficiently manifested his invention to those skilled in the art, and that it was not necessary to the completeness of the invention that he should have actually put the device upon an engine. *Farley* v. *National Steam Gauge Co.*, 618.

14. WATER GAUGE.—In a steam-boiler water gauge, merely lengthening the pipe within the chamber connected with the boiler by coiling the same or by uniting several straight lengths of pipes for the purpose of increasing the effect is not a patentable invention. It is an ordinary expedient for multiplying the heating surface, and in this sense is a mechanical equivalent of the straight pipe. *In Re Nutting*, 455.

15. WEED CUTTER.—A combination may be new, although its elements, separately considered, are old. Thus, where the cutting-shear or blade of a weed-cutting plow was old, and the mechanism by which it was raised and lowered has been before used to perform the same office for cultivator teeth, and in other counections: *Held*, That a claim to the combination of the share and its controlling mechanism was patentable. *In Re Boughton*, 278

PARTY AS WITNESS.

See EVIDENCE, 1, 4, 10, 11, 12, 13, 14, 19.

PATENT.

See ACCIDENTAL DISCOVERY.
ACTUAL USE, 3.
CLAIMS, 1.
CLERICAL ERROR.
DELAY IN FILING APPLICATION, 5.
DILIGENCE, 6.
EVIDENCE, 8.
INTERFERENCE, 3, 11, 21.
JURISDICTION OF COMMISSIONER, 2.

PATENT—*continued.*

OATH OF INVENTION, 1.
POWER OF COMMISSIONER, 2.
PREMATURE ISSUANCE OF PATENT.
PUBLIC USE AND SALE, 12.

PATENT, CONSTRUCTIVE NOTICE.—The patent is *prima-facie* evidence of the title of the patentee to make, use, and sell the invention publicly to whom and as he deems best, and is constructive notice to all who may be concerned. *Ellithorp* v. *Robertson*, 585.

PATENTABILITY.

See APPEAL, GROUND OF, 5, 6.
CHANGE, 1, 3.
CHANGE OF MATERIAL.
CLAIMS, 2.
COMBINATIONS.
COMPOSITION OF MATTER.
DESIGNS.
EQUIVALENT, 5.
EVIDENCE, 8.
INTERFERENCE, 17, 22.
INVENTION.
JOINT INVENTION, 1, 2.
NATURAL PRINCIPLES.
NOVELTY, 2.
PARTICULAR INVENTIONS.
PERFECTED INVENTION.
PREREQUISITES TO A PATENT.
PRINCIPLE, 4.
REDUCTION TO PRACTICE, 2, 4, 7.
RESULT, 1, 3.

PATENT OF ADDITION.

See EVIDENCE, 8.

PATENTED MACHINERY.

See PROCESS, 1.

PATENTEE IN INTERFERENCE.

See EVIDENCE, 8.
INTERFERENCE, 2, 10, 11, 15.
PREMATURE ISSUANCE OF PATENT.
PRIOR INVENTION, 8.
REDUCTION TO PRACTICE, 4.

PATENT LAWS.

See DISCOVERY, 1.
OATH OF INVENTOR, 2.

PATENT LAWS—*continued.*

See REDUCTION TO PRACTICE, 1, 2.
RULES OF THE PATENT OFFICE, 1, 4, 5.

PERFECTED INVENTION.

PRIOR INVENTION—PERFECTED INVENTION, WHAT—HOW MANIFESTED.—To constitute a perfected invention which will entitle a party to a patent, it is not necessary that he should have actually constructed the machine which is the subject of his invention. If, having conceived a valuable idea, he has manifested it before the world in any form which evidences the completeness of the idea, and which is sufficient, when communicated to others, to enable those skilled in the particular art to reproduce his invention, he has done enough to entitle himself to a patent, and this whether such evidence consist of written description, drawings, models, or a complete machine. *Farley* v. *National Steam-Gauge Co.*, 618.

PERJURY.

See WITNESSES, 5.

CREDIT OF WITNESS—SUBORNATION—EFFECT OF.—A witness who gives false testimony as to one particular cannot be credited as to any, according to the legal maxim *falsus in uno, falsus in omnibus.* And if there be reason to suppose that his perjury or prevarication is the result of subornation, it affords a reasonable ground in a doubtful case for suspecting the testimony of other witnesses adduced by the same party. *Wellman* v. *Blood*, 432.

POSTPONING HEARING.

COMMISSIONER MAY POSTPONE HEARING UPON HIS OWN MOTION.—There is nothing in the laws relating to the Patent Office, or in the rules adopted by the Commissioner, to prevent him from postponing, upon his own motion, the hearing of a cause, if in his opinion the justice of the case should require it, and especially for the correcting of irregularities in matters of form. To deny him this power would be to stifle justice in her own forms. *Smith* v. *Flickenger*, 46.

POWER OF COMMISSIONER.

See CLERICAL ERROR.
DELAY IN FILING APPLICATION, 1.
EXAMINATION OF APPLICATION, 1, 6.
INTERLOCUTORY ACTION, 2.
JURISDICTION OF THE COMMISSIONER, 1.
LIMIT OF APPEAL, 2, 4.
NEW TRIAL, 7.
OFFICERS OF THE PATENT OFFICE, 2.
POSTPONING HEARING.
PROCEEDINGS BEFORE COMMISSIONER, 2.
PUBLIC USE AND SALE, 4.
REDUCTION TO PRACTICE, 3.

POWER OF COMMISSIONER—*continued.*

See REHEARING, 1, 2.
REISSUE.
RULES FOR TAKING TESTIMONY.
RULES OF THE PATENT OFFICE, 2.
SUFFICIENTLY USEFUL AND IMPORTANT, 2, 8.
TIME FOR FILING APPEAL, 2.

1. POWER OF COMMISSIONER CONTINUES UP TO ISSUANCE OF PATENT.—The power vested in the Commissioner to examine and determine the right of an applicant to a patent continues until the patent actually issues, and is not exhausted by any preliminary or intervening opinion he may form—as a decision in an interference case—which does not result in the grant of a patent. It is his duty to be satisfied at the moment of issuing the patent of the existence of all the conditions necessary, under the seventh section of the act of 1836, to a valid grant. *Matthews* v. *Wade*, 143.

2. SM—POWER OF COMMISSIONER.—The Commissioner of Patents, up to the moment of issuing the patent, has the discretion to rehear a case before decided by him, and ought to do so until his mind is convinced that the patent is to issue to the true inventor. *In Re Rouse*, 186.

3. POWER OF COMMISSIONER PLENARY WITHIN ITS LIMITS.—It is true that the jurisdiction of the Commissioner of Patents is a limited one, but it is equally true that it is to be understood not only from what is expressly stated, but from what ought necessarily to be inferred, and is as absolute within its proper legal limits as a tribunal of general jurisdiction would be. *Hunt* v. *Howe*, 366.

4. POWERS OF THE COMMISSIONER OF PATENTS.—While the Commissioner must look to the statutes creating his office and defining his duties for every power which he can exercise, it by no means follows that every power and jurisdiction must appear upon the face of the statute in words of express reference and definition. It would be a strange construction of the law to require the Commissioner of Patents to issue a patent upon a state of facts which, when made apparent to a court of law or equity, would require the court to pronounce the patent utterly void. It is said that the law never requires vain things to be done; but to require the Commissioner of Patents to issue a worthless and void patent would be worse than vain—it would be to direct that persons should be armed with a warrant, under the great seal of the United States, to go into all the courts of justice in the land and hunt down their fellow-citizens with oppressive, idle, and vexatious litigation. *Wickersham* v. *Singer*, 645.

POVERTY.

See DILIGENCE, 6.

LACHES—POVERTY.—Poverty of the inventor and inability to engage in the manufacture of the invention considered as excuses for delay. *Hill* v. *Dunklee*, 475.

PRACTICE OF THE PATENT OFFICE.

See DEPOSITIONS, 1.
EXAMINATION OF APPLICATION, 6.

PRACTICE OF THE PATENT OFFICE—*continued.*

See INTERFERENCE, 1, 3, 5, 17, 22.
INTERLOCUTORY ACTIONS, 3.
NOTICE, 5.
POWER OF COMMISSIONER, 1.
POSTPONING HEARING.

PREMATURE ISSUANCE OF PATENT.

FRAUD IN PREMATURE ISSUE OF PATENT NOT CONSIDERED IN AN INTERFERENCE—QUESTION FOR JURY.—The question of fraud involved in the premature issue of a patent to one of two conflicting applicants, without notice to the other, will not be considered by the judge upon appeal in an interference between the patentee and the applicant. It must be tried by a jury in a direct suit brought for that purpose. *Burlew* v. *O'Neil*, 168.

PREREQUISITES TO A PATENT.

See POWER OF COMMISSIONER, 1.
REDUCTION TO PRACTICE, 3.
SUFFICIENTLY USEFUL AND IMPORTANT, 2.

PREREQUISITES TO A PATENT—APPLICATION DULY FILED—REDUCTION TO PRACTICE.—Where an inventor has complied with the provisions of the law by duly filing an application clearly showing and describing the nature and operation of the invention by specification and drawings verified by oath, he has reduced the principle of the invention to practice for the purpose of obtaining a patent; and if the invention is patentable, he is entitled to the grant of a patent therefor. *Burrows* v. *Wetherill*, 315.

PRESUMPTIONS.

See ACQUIESCENCE.
ADMISSIONS OF PARTY, 2.
EMPLOYER AND EMPLOYEE, 1, 2.
INTERFERENCE, 17, 21.
PATENT.
PUBLIC USE AND SALE, 12, 13, 18.
WITNESSES, 3, 4.

PRIMA-FACIE PROOF.

See BURDEN OF PROOF.
EMPLOYER AND EMPLOYEE, 1.
OATH OF INVENTION, 1.

PRINCIPLE.

See COMPOSITION OF MATTER, 4.
DOUBLE USE.
UNSUCCESSFUL EXPERIMENTS, 1.

1. PRINCIPLE—HOW APPLIED—NEW CONTRIVANCE OR MEANS.—The doctrine that

PRINCIPLE—*continued.*

a discovery of a fact or principle, when practically applied to produce some new and useful effect in the arts, is patentable, is modified by the condition that the new effect must be produced by means that are new, by some *invention*, some contrivance, or the production of something that did not before exist. *In Re Kemper*, 1.

2. PRINCIPLE OR EFFECT NOT PATENTABLE.—There cannot be a patent for a principle, nor for the application of a principle, nor for an effect. Two persons may use the same principle and produce the same effect by different means without interference or infringement, and each would be entitled to a patent for his own invention. *Bain* v. *Morse*, 90.

3. INVENTION—PRINCIPLE THEREOF—INADEQUATE DEVICE FOR CARRYING INTO EFFECT.—The most important part of an invention may consist in the conception of the original idea, in the discovery of the principle in science, or of the law of Nature, stated in the patent, and little or no pains may have been taken in working out the best manner of practically applying that principle to the purpose set forth in the patent. Still, if the principle is stated to be applicable to any special purpose, so as to produce any result previously known in the way and for the purpose described, the patent is good. *Burrows* v. *Wetherill*, 315.

4. PRINCIPLE—PRACTICAL APPLICATION THEREOF—SUBSEQUENT INVENTIONS OF MACHINERY.—A well-known principle or truth of natural science, as well as a newly-discovered one, is patentable to the one who first applies it to the useful arts; but having been once made known and applied, any subsequent application of it, even though more perfect, must, to insure a patent, rest upon the new machinery or combination of machinery, and not upon the principle the novelty of which has been exhausted. *In Re Henry*, 417.

PRINCIPLE OF MACHINE.

See ANALOGOUS USE.
CHANGE, 1.
CLAIMS, 3.
DOUBLE USE.
EMPLOYER AND EMPLOYEE, 3.
EQUIVALENT, 3.
IDENTITY OF INVENTION, 1, 2, 3.
INTERFERENCE, 16.
JOINT INVENTION, 1.
OFFICERS OF THE PATENT OFFICE, 3.
ORIGINAL INVENTOR, 1, 2.
PREREQUISITES TO A PATENT.
Result, 3.

PRINCIPLE OF MACHINE.—The true legal meaning of the principle of a machine with reference to the patent act is the peculiar structure or constituent parts of such machine. The principles of two machines may be very different, though their external structures may have great similarity. *In Re Boughton*, 278.

PRIOR INVENTION.

See ABANDONMENT, 1, 6.
ABANDONED EXPERIMENT.
ACTUAL USE, 2.
DATE OF INVENTION.
DILIGENCE.
DRAWINGS, 1.
EMPLOYER AND EMPLOYEE, 1, 2, 3, 4.
EVIDENCE, 16.
FIRST INVENTOR, 1, 2.
FOREIGN PATENT.
INTERFERENCE, 1, 2, 4, 10, 13, 15, 19, 21.
INVENTOR NOT AWARE OF THE VALUE OF THE INVENTION.
LACHES, 1.
MEASURE OF PROOF.
ORIGINAL INVENTOR, 1, 2.
PERFECTED INVENTION.
POWER OF COMMISSIONER, 2.
PRINCIPLE, 3.
PRIOR PATENT, 1, 2.
PUBLIC USE AND SALE, 15.
REDUCTION TO PRACTICE.
SURREPTITIOUS PATENT.

1. PRIOR INVENTION—ACT OF 1836—NEED NOT BE REDUCED TO PRACTICE.—The sixth section of the act of 1793, in enumerating the defenses to a patent, expressly specified that the prior invention must have "been in use." Under the corresponding section (section 15) of the act of 1836, from which these words are carefully excluded, the defense "that the patentee was not the original and first inventor or discoverer of the thing patented" is complete without showing that the first inventor had put his invention into practice. *Heath* v. *Hildreth*, 12.
2. PRIORITY OF INVENTION—NATURE OF THE ISSUE.—Upon the issue of priority of invention, the question is not whether one of the parties obtained better results than the other, but rather which of the parties first invented or discovered the subject-matter in controversy. *Matthews* v. *Wade*, 143.
3. PRIORITY OF INVENTION—FIRST TO CONCEIVE—REASONABLE DILIGENCE.—He who first conceives of an invention, and uses reasonable diligence in perfecting the same, and does perfect it, is entitled to the patent as against an inventor who was later to conceive but first to reduce the invention to practice. *Marshall* v. *Mee*, 229.
4. PRIOR INVENTOR—FIRST TO CONCEIVE AND DISCLOSE TO OTHERS.—An invention being an intellectual process or conception, for the purpose of showing who, in point of time, is the prior inventor, he who first makes it known sufficiently by describing it in words or drawings will be considered to be the first discoverer, and vested with an inchoate right to its exclusive use, which he may embody, perfect, and make absolute by proceeding to mature it in the manner which the law requires. *Hill* v. *Dunklee*, 475.
5. SM—BEARING OF DECISIONS IN INFRINGEMENT SUITS.—The dicta of the judges

PRIOR INVENTION—*continued.*

in infringement suits, to the effect that the person who reduces the invention to practice, and he only, is entitled to a patent, are not applicable to all cases of interference, but they may well apply to those cases where, from a long and unreasonable delay and unsuccessful experiments, or an acquiescence in the inventions becoming public, evidence is furnished of an abandonment by the person claiming to be the first and original inventor, so that his prior right is forfeited and lost. *Id.*

6. PRIORITY OF INVENTION—REASONABLE DILIGENCE.—He who invents first shall have the prior right, if he is using reasonable diligence in adapting and perfecting the invention, although the second inventor has in fact perfected the same and reduced it to practice in positive form. (Reed *v.* Cutter, 1 Story, 590.) *Chandler* v. *Ladd et al.*, 493.

7. PRIOR INVENTOR—FIRST TO CONCEIVE—DUE DILIGENCE—UNSUCCESSFUL EXPERIMENTS.—The first inventor is not necessarily the one who made and perfected the first machine or instrument, but he who appears from the evidence to have been the first to conceive the idea, and to so describe it by words or drawings that a skillful workman would be enabled to bring it into useful, practical operation; for such a person shall be said to have made the first claim, and will be protected against the claim of any subsequent inventor who may have been first in adapting a machine or instrument to the invention, provided such first discoverer has been using due diligence in effecting the same end, and that, although he may have been unsuccessful in some of his experiments, if, by following them up, he at length succeeds. *Davidson* v. *Lewis*, 599.

8. PUBLIC USE AND SALE—QUESTION OF PRIORITY NOT DETERMINED.—When on appeal to the judge it appears from the testimony submitted in an interference proceeding between an applicant for a patent and a patentee that the applicant is debarred from receiving a patent by reason of the public use of his invention, it is unnecessary to determine the question of priority of invention. *Justice* v. *Jones*, 635.

PRIOR USE.

See PRIOR INVENTION.

PRIORITY OF INVENTION.

See PRIOR INVENTION.

PRIOR PATENT.

See EQUIVALENT, 1.
FOREIGN PATENT.
SECOND PATENT FOR SAME INVENTION.

1. PRIOR PATENT—MUST BE PRIOR TO INVENTION, NOT APPLICATION.—It is evident from a comparison of the seventh section of the act of 1836 with the sixth, eighth, and fifteenth sections that the patent which would bar the issuing of a patent to the applicant must be a patent issued prior to his *invention*, and not merely prior to his *application*. *Heath* v. *Hildreth*, 12.

PRIOR PATENT—*continued.*

2. MATTER SHOWN IN PRIOR PATENT—EFFECT OF.—A subsequent inventor may have a patent for matters included in a prior patent, but not particularly specified and claimed therein, if he be an independent inventor, and the invention was not perfected, but was abandoned by the patentee. *Stephenson* v. *Hoyt*, 292.

PRIVATE USE.

See PUBLIC USE AND SALE, 14.

PROCEEDINGS BEFORE COMMISSIONER.

See APPEAL, 1.
EVIDENCE, 9, 10.
EXAMINATION OF APPLICATION, 5.
INTERFERENCES, 3, 5, 17.
LIMIT OF APPEAL, 2.
PUBLIC USE AND SALE, 2.
REASONS OF APPEAL, 10.
REHEARING, 2.
RIGHT OF APPEAL, 1.
TIME FOR FILING APPEAL, 1.

1. PROCEEDINGS IN THE OFFICE SUSPENDED.—After the Commissioner has laid before the judge the papers and evidence in the case, together with the grounds of his decision, the case is no longer before the Commissioner. Nothing further can be done in the case in the Patent Office until the decision of the judge and his proceedings shall be certified to the Commissioner. *In Re Aiken*, 130.

2. JURISDICTION OF THE COMMISSIONER—CONTROL OVER THE PROCEEDINGS IN THE OFFICE.—The proceedings in the Office are all under the superintendence and control of the Commissioner, who acts immediately under the law, and who is uncontrolled in the discharge of the duties of his office, except so far as an appeal is expressly given by law. *Matthews* v. *Wade*, 143.

PROCESS.

1. PROCESS—PATENTED MACHINERY.—It seems that the use of a new process involving patented machinery must be by the license or permission of the patentee or his assigns. *Jones* v. *Wetherill*, 409.

2. SM—TEST OF NOVELTY—IMPROVED RESULT.—In support of a claim for a new method or process, it must appear that the result produced is an improvement in the trade—using those words in a commercial sense, as meaning the manufacture of the article as good in quality and at a cheaper rate, or better in quality at the same rate, or with both of these consequences partially combined. *Id.*

3. PROCESS—NOVELTY OF DEVICES IMMATERIAL.—Upon a claim for a process, it is unnecessary to inquire as to the novelty or utility of the arrangement of machinery described in the specification; for however novel or useful the arrangement or combination may be, if it be not the ground of claim,

and relied on as such, no patent will be issued for it upon such a claim. *In Re Henry*, 467.

PROPORTIONS.

See CHANGE, 1.
SECOND PATENT FOR SAME INVENTION.

PUBLIC POLICY.

See ADMISSIONS OF PARTY, 2.

PUBLIC USE AND SALE.

See ABANDONMENT, 2.
ACQUIESCENCE.
CONSTRUCTION OF STATUTES.
PATENT.
PRIOR INVENTION, 8.
SECRET INVENTION, 2, 3, 4.

1. APPLICATION BARRED BY PUBLIC USE.—Under the provisions of section 15 of the act of 1836 and the seventh section of the act of 1839 an application will be barred by proof that the invention has been in public use for more than two years prior to filing the application. *Arnold* v. *Bishop*, 28.
2. PUBLIC USE AND ABANDONMENT—COMMISSIONER MAY INVESTIGATE—DUE PROCEEDINGS.—The Commissioner of Patents has jurisdiction to try and determine the questions of public use and abandonment arising in connection with an application by due proceedings suitable to the nature of the inquiry. *Hunt* v. *Howe*, 366.
3. SM—SM—SECTIONS 6 AND 7, ACT OF 1836, CONSTRUED.—The negative prerequisites to a patent—that the invention has not been in public use or on sale, &c.—as mentioned in the sixth section of the act of 1836, are equally binding upon the Commissioner with the others therein named, and are expressly submitted to his examination by the opening provisions of section 7 of the same act. *Id.*
4. SM—SM—MAY COMPEL ATTENDANCE OF WITNESSES.—It would seem that the Commissioner has power to compel the attendance of witnesses for the purpose of investigating the questions of public use and abandonment under the clause of section 12 of act of 1839, providing that the Commissioner shall have power to make such regulations in respect of the taking of evidence to be used in contested cases before him as may be just and reasonable. *Id.*
5. PUBLIC USE—SECRET USE.—A public use, as meant by the statute, is a use in public. The invention need not be generally adopted by the public. Public is not equivalent to general use, but is distinguished from secret use—used in a public manner. *Id.*
6. CONSENT AND ALLOWANCE—PRESUMED FROM CONDUCT.—When the machine of a rival inventor has been publicly used for years, with the knowledge

of the applicant, or of which he might have had knowledge, he will be presumed to have acquiesced in and consented to such public use of the invention. *Id.*

7. SM—SM—SALE—ABANDONMENT—REPURCHASE.—An unconditional sale by the inventor himself of his invention, together with a machine embodying the invention, more than ten years before filing the application, and the public exhibition of the machine by the purchaser, is conclusive proof that the invention was in public use, with the consent and allowance of the inventor; and he cannot then resume his right to a patent by the repurchase of such invention and machine. *Id.*

8. PUBLIC USE FOR TWO YEARS—SECTION 7, ACT OF 1839.—Under the seventh section of the act of 1839 an inventor cannot obtain a patent if his invention was in public use more than two years prior to filing his application. *Rugg* v. *Haines*, 420.

9. SM—ESTABLISHED BY TESTIMONY IN INTERFERENCE.—An applicant must be rejected upon testimony taken in an interference proceeding showing a sale and use of the invention more than two years prior to filing the application. *Id.*

10. PUBLIC USE OR SALE—JURISDICTION OF THE COMMISSIONER.—Under the seventh section of the act of 1836, directing the Commissioner to cause an examination to be made of the alleged new invention, and to issue a patent if it shall not appear, *inter alia*, that the invention had been in public use or on sale with the applicant's consent or allowance prior to the application, the Commissioner has authority to investigate and determine the question of public use arising in connection with an application for a patent. *Mowry* v. *Barber*, 563.

11. PUBLIC USE OR SALE—TESTIMONY IN INTERFERENCE.—Where it appeared from the testimony taken in an interference proceeding that the invention claimed by the applicant had been in public use and on sale for more than two years prior to filing his application: *Held*, That the Commissioner was authorized to reject his application for that reason. *Id.*

12. PRESUMPTION OF PUBLIC USE FROM GRANT OF PATENT.—The fact that a patent was taken out by another inventor four years before the application in question was filed raises a strong presumption that the invention has been in public use with the consent and allowance of the applicant, and in the absence of any proof that the patent was surreptitiously or unjustly obtained casts the burden of proof on the applicant to show that the fact is otherwise. *Ellithorp* v. *Robertson*, 585.

13. SM.—The obvious purpose of incurring the expense and trouble of taking out letters-patent is to carry the invention into public operation, use, and sale, and it is natural to suppose that this the patentee has done. *Id.*

14. USE UNDER A PATENT, PUBLIC USE—DISTINGUISHED FROM SECRET AND PRIVATE USE.—The use and sale of an invention under a patent is a public use within the meaning of section 7 of act of 1836, although such use is limited by the grant or monopoly to the patentee and those deriving title under him. It is not meant by the statute that there must be a general knowledge of and right to use the invention. The words "public use" mean use

PUBLIC USE AND SALE—*continued.*

in public, as distinguished from secret or private use; and such a use by a single person will defeat the patent. *Id.*

15. PUBLIC USE OR SALE—CORSETS—TESTIMONY IN INTERFERENCE.—Where it appeared from the testimony submitted in an interference that the applicant in the case—the other party being a patentee—had permitted several persons to make, for their own personal use and wear, corsets embracing his invention, without restriction or reservation, for more than two years before his application was filed: *Held*, That his application was barred under the law by reason of public use, and that it was unnecessary under such circumstances to determine the question of priority of invention. *Blackinton* v. *Douglass*, 622.

16. PUBLIC USE AND SALE BY ANOTHER—ACQUIESCENCE OF INVENTOR.—The omission by an inventor to apply for a patent within two years after he learns that another is publicly using the invention and claiming it as his own, and the failure to interpose any warning or objection whatever, makes out a clear case of disability to prosecute a claim for a patent within the seventh section of the act of 1839. *Justice* v. *Jones*, 635.

17. The meaning of section 7 of the act of 1839 is given by inverting the order of the parts of the section so as to read as follows: No patent shall be held to be invalid by reason of such purchase, sale, or use prior to the application aforesaid, except on proof that such purchase, sale, or prior use has been for more than two years prior to said application for a patent, or by abandonment of said invention to the public. *Wickersham* v. *Singer*, 645.

18. PUBLIC USE AND SALE—CONSENT AND ALLOWANCE.—The acquiescence of an inventor in the public use of his invention can in no case be presumed when he has no knowledge of such use; but this knowledge may be presumed from the circumstances of the case. (Shaw *v.* Cooper, 7 Peters, 292.) *Id.*

19. W. filed an application for the invention in 1850, which was at once returned to him as informal. In the same year he transmitted new drawings and specifications, omitting therefrom the invention in dispute. Upon further objection he withdrew the application in 1851, received the return fee, and took no further steps until he filed a new application, October 6th, 1858. S. made application for a patent in 1850, obtained a patent in 1851, and put the invention into extensive public use from 1853 on; of all of which facts W. was fully informed as early as April, 1856: *Held*, W. had abandoned the invention by not using due diligence in applying for and prosecuting his application for a patent; that his application of 1858 did not relate back to the date of the original application, and that his right to the patent was barred by reason of the public use and sale of the invention, with his consent and allowance, more than two years prior to filing his second application. *Id.*

20. SM.—Whatever may be the intention of the inventor, if he suffers his invention to go into public use through any means whatever, without an immediate assertion of his right, he is not entitled to a patent; nor will a patent obtained under such circumstances protect his right. (Shaw *v.* Cooper, 7 Peters, 29.) *Savary* v. *Lauth*, 691.

PUBLIC USE AND SALE—*continued.*

21. B. invented and perfected and privately used the invention in 1853. In 1858 his neighbor S. independently invented and patented the same thing, and put it into public use with the full knowledge of B., who applied for a patent one year later: *Held*, That B. has shown gross and culpable negligence, and has forfeited his right to a patent. *Spear* v. *Belson*, 699.

REARRANGING PARTS OF MACHINE.

INVENTION—REARRANGING AND SIMPLIFYING MACHINE PATENTABLE.—Rearranging the parts of a machine so as to dispense with several expensive pieces before considered necessary, thereby simplifying the machine and improving its operation, is a patentable invention. *Wellman* v. *Blood*, 432.

REASONABLE DILIGENCE.

See DILIGENCE.

REASONABLE NOTICE.

See NOTICE.

REASONS OF APPEAL.

See ANSWER TO REASONS OF APPEAL.
APPEAL.
APPEAL, GROUND OF, 3, 6.
EXAMINATION OF APPLICATION, 4.
GROUND OF COMMISSIONER'S DECISION.
JUDGE'S DECISION, EFFECT OF.
JURISDICTION OF THE JUDGE.
LIMIT OF APPEAL, 1, 2, 4.
REVISION OF COMMISSIONER'S DECISION.
TIME FOR FILING APPEAL, 1.

1. REASONS OF APPEAL—COMMISSIONER AND JUDGE CONFINED THERETO.—By the eleventh section of the act of March 3d, 1839, the judge is to confine his revision of the Commissioner's decision to the points involved in the reasons of appeal, and the Commissioner is to lay before the judge the grounds of his decision touching the same points. *In Re Kemper*, 1.
2. REASONS OF APPEAL.—By the eleventh section of the act of 1839 the revision of the decision of the Commissioner is to be "confined to the grounds of his decision, fully set forth in writing, touching the points involved by the reasons of appeal." *Cochrane* v. *Waterman*, 52.
3. JURISDICTION OF JUDGE—REASONS OF APPEAL.—By limiting the jurisdiction of the judge to the points involved in the reasons of appeal, the law has affirmed it to that extent. *Bain* v. *Morse*, 90.
4. JURISDICTION OF JUDGE.—By the eleventh section of the act of 1839, in case of an appeal from the decision of the Commissioner rejecting an application for a patent, the revision of the judge is confined to "the points involved in the reasons of appeal" filed in the office. *In Re Winslow*, 123.
5. VAGUE AND INDEFINITE REASONS OF APPEAL.—Where an application is rejected for lack of novelty, assignments of error that the "decision is in oppo-

REASONS OF APPEAL—*continued.*

sition to a clear apprehension of the merits of the case," and "inconsistent with the precedent," are too vague and indefinite. *Id.*

6. REASONS OF APPEAL—MUST ASSIGN ERROR IN DECISION.—The insufficiency of the Commissioner's reasons is not of itself evidence that his decision was wrong, and is not, therefore, a good "reason of appeal." *In Re Aiken*, 130.

7. REASONS OF APPEAL.—An objection to the opinion of the Commissioner in regard to the sufficiency of a reference is not a good reason of appeal. Whatever may have been his opinion, his decision may have been correct. *In Re Crooker*, 134.

8. ERROR IN JUDGMENT, NOT IN REASONING.—The reasons of appeal must show that the decision of the Commissioner was wrong, and not merely that he was mistaken in his reasoning. *Id.*

9. REASONS OF APPEAL—DECISION CONFINED THERETO.—The refusal of the Commissioner to receive as evidence certain certificates of manufacturers and others not having been assigned as error in the reasons of appeal, cannot be considered as such by the judge upon appeal. *Jillson* v. *Winsor*, 136.

10. REASONS OF APPEAL—WHEN ONCE FILED, MUST BE HEARD AND DECIDED.—The filing of the reasons of appeal is a proceeding in the Office over which the judge has no control. If the Commissioner has received and filed the reasons of appeal, the judge cannot order him to strike them out. They must be heard and decided; and when brought before him on appeal, if they are not valid, he will overrule them. *Matthews* v. *Wade*, 143.

11. VALID REASON OF APPEAL.—No reason of appeal can be regarded as valid which would not justify the Commissioner in refusing the patent. *Id.*

12. REASONS OF APPEAL—FORM OF—VAGUE AND INDEFINITE.—A reason of appeal "that the decision rejecting the application was against the evidence and the weight of evidence" is entirely too vague and indefinite to be considered within the provisions of the eleventh section of the act of 1839 as a substantive reason of appeal, "specifically set forth in writing." *Blackinton* v. *Douglas*, 622.

13. SM—SM.—No assignment of error can be regarded as sufficiently specific which does not point out the precise matter of alleged error with reasonable certainty. *Id.*

RECORD.

See EVIDENCE, 10, 11, 15, 26.
REPLY TO COMMISSIONER'S ANSWER.

REDUCTION TO PRACTICE.

See ACTUAL USE, 2, 3.
APPEAL, GROUND OF, 1.
APPLICATION.
DILIGENCE, 1, 3, 5.
JOINT INVENTION, 1.
OATH OF INVENTION, 2.
OPERATIVENESS OF INVENTION.
ORIGINAL INVENTOR, 3.

REDUCTION TO PRACTICE—*continued.*

See PERFECTED INVENTION.
PREREQUISITES TO A PATENT.
PRINCIPLE, 3.
PRIOR INVENTION.
UNSUCCESSFUL EXPERIMENTS, 1.

1. REDUCTION TO PRACTICE—NOT REQUIRED BY LAW TO OBTAIN A PATENT.—None of the patent laws have ever required that the invention should be in use or reduced to practice before the issuing of the patent otherwise than by a model, drawings, and specification containing a written description of the invention. *Heath* v. *Hildreth*, 12.
2. PUTTING INTO USE—UNITED STATES AND ENGLISH LAW CONTRASTED.—As distinguished from the English law—that if the thing is in use before the issuing of the patent the patent is void—our law (section 7, act of 1839) provides that the use of the thing, even by leave of the inventor, for two years before his application for a patent, shall not invalidate it; *a fortiori*, the use of it by a third person or subsequent inventor after the first inventor, and before the issuing of the patent to the first inventor, without his consent, will not be a bar to such patent. *Id.*
3. PREREQUISITES TO A PATENT ARE ALL SPECIFIED IN SECTION 7 OF ACT OF 1836.—By the seventh section of the act of 1836 the Commissioner is bound to issue a patent upon the compliance on the part of the applicant with the conditions there named, and upon the appearance of certain facts; and the reduction of the invention to practice is not named as one of these conditions. *Id.*
4. REDUCTION TO PRACTICE BY SECOND INVENTOR IMMATERIAL.—There being no law which requires the inventor to put his invention into practice or use before obtaining his patent, it is immaterial to him whether the second inventor has put it in practice or not. That fact cannot affect his rights when involved in interference with a patentee under the eighth section of the act of 1836. Neither that section nor any other section of that or any other act makes the right of the patentee or of the applicant depend upon the fact of the invention being reduced to actual practice, except in the case of the *alien patentee*. *Id.*
5. REDUCTION TO PRACTICE NOT BRINGING INTO USE—COMPLETION OF THE INVENTION.—The expression "reduced to practice" does not import the bringing the invention into actual use. When applied to an invention, it generally means the reducing it into such form that it may be used so as not to be a mere theory. A small model, demonstrating the practicability of the invention, is a sufficient reduction to practice. Size is of no importance. *Id.*
6. REDUCTION TO PRACTICE DEFINED.—An inventor has reduced his invention to practice when he has so described it upon paper, with such drawings or model as will enable any person skilled in the art to make and use the same; but he is not obliged to furnish drawings or model until he makes his application. *Perry* v. *Cornell*, 68.
7. PHILOSOPHICAL SPECULATION—REDUCTION TO PRACTICE.—Where the invention is not of a mere philosophical speculation, abstraction, or theory, but

REDUCTION TO PRACTICE—*continued.*

of something corporeal, something to be manufactured, the applicant need not show that he has reduced his invention to practice otherwise than by filing his specification and furnishing drawings and a model, as required by the statute, where the nature of the case admits of drawings or a representation by model. *Screw Co.* v. *Sloan*, 210.

8. REDUCTION TO PRACTICE.—For the purpose of obtaining a patent, it is not necessary to show that the invention has been reduced to practice if it appear that the invention was devised and explained to others, and was not subsequently abandoned. *Hill* v. *Dunklee*, 475.

REFERENCES.

See ANTICIPATION.
COMMISSIONER'S ANSWER.

REFUSAL TO TESTIFY.

See EXAMINATION OF WITNESSES, 2, 3, 4, 5.

REFUSAL OF PATENT.

See DELAY IN FILING APPLICATION, 2.
EXAMINATION OF APPLICATION.
JOINT INVENTION, 2.
JURISDICTION OF COMMISSIONER, 3.
REASONS OF APPEAL, 11.
RIGHT OF APPEAL, 3, 4, 5, 9, 10, 11, 13.
RULE IN DOUBTFUL CASES.

REHEARING.

See APPEAL, GROUND OF, 2.
DELAY IN PROSECUTING APPLICATION.
DEPOSITIONS, 4.
FORMER COMMISSIONER, DECISION OF, 1, 3.
LIMIT OF APPEAL, 2.
NEW PARTY.
NEW TRIAL, 1, 2, 3, 4, 5, 6.
POWER OF COMMISSIONER, 2.
RIGHT OF APPEAL, 6.
TIME FOR FILING APPEAL, 2.

1. REHEARING—WITHIN COMMISSIONER'S DISCRETION.—The Commissioner, in the exercise of his discretionary power, may set aside his own decision in an interference proceeding and rehear the parties thereto. It is an act over which the judge has no control or jurisdiction, and cannot form a valid ground of appeal. *Matthews* v. *Wade*, 143.

2. SM—COMMISSIONER MAY REHEAR THE PARTIES.—The Commissioner may, therefore, rehear the parties to an interference upon the same question and revise his former decision in the case. *Id.*

REISSUE.

See CLERICAL ERROR.
DELAY IN APPLYING FOR REISSUE.
JURISDICTION OF COMMISSIONER, 1.
TERM OF PATENT, 1, 2.

REISSUE—ALTERING TERM OF THE ORIGINAL PATENT.—Under the thirteenth section of the act of 1836, relating to the reissuing of invalid and defective patents, the Commissioner has no power to alter the date of a previously-granted antedated patent. *In Re Cushman*, 577.

REJECTION OF APPLICATION.

See EXAMINATION OF APPLICATION, 2, 3, 4, 6.
JUDGE'S DECISION, EFFECT OF.

REJECTION OF APPLICATION WHAT—INFORMAL PAPERS RETURNED.—When application papers are filed without the due formalities required by law it is the duty of the Office (under the sixth section of the act of 1836) to decline to act upon them in their imperfect state; and this action on the part of the Office does not amount to a rejection of the application. *Wickersham* v. *Singer*, 645.

REPEAL OF STATUTE.

See BOARD OF EXAMINERS, 1.

REPLY TO COMMISSIONER'S ANSWER.

COMMISSIONER'S ANSWER—REPLY THERETO.—No reply to the grounds of the Commissioner's decision can be admitted before the judge upon appeal, nor can such reply be filed in the Patent Office to be recorded with the proceedings. *In Re Aiken*, 130.

RESULT.

See ARTICLE OF MANUFACTURE.
CHANGE, 1, 4, 5.
COMBINATIONS, 8.
DOUBLE USE.
IDENTITY OF INVENTION, 2.
INVENTION, 4.
NEW USE OF OLD MACHINE.
ORIGINAL INVENTOR, 2.
PARTICULAR INVENTIONS, 13.
PRINCIPLE, 3.
PRIOR INVENTION, 2.
PROCESS, 2.
SUFFICIENTLY USEFUL AND IMPORTANT, 2.

1. INVENTION—COMBINATION OF OLD DEVICES—NEW RESULT.—When a certain particular combination of old instruments or devices produces a new and useful effect in the art—as the combination for the first time in a machine for making corrugated or shirred India-rubber goods of calen-

ders, rollers, endless apron, and a stitching frame—that combination becomes the lawful subject of a patent. *Warner* v. *Goodyear*, 60.

2. INVENTION—USE OF OLD DEVICES—NEW AND BENEFICIAL EFFECT.—A patentable invention may consist of the use of an old thing in a known manner, to produce effects already known, when the result is new and better in the sense that the effects are more economically or beneficially enjoyed by the public. *In Re Seely*, 248.

3. In this class of cases the result is considered all-important. There must, however, be thereby evolved a principle such as will regularly, and not merely occasionally, in the use thereof, produce a like effect. *Jones* v. *Wetherill*, 409.

RETURN OF FEE.

See WITHDRAWAL OF APPLICATION, 1, 2.

REVISION OF COMMISSIONER'S DECISION.

See APPEAL.
GROUND OF COMMISSIONER'S DECISION.
FORMER COMMISSIONER, DECISION OF.
REASONS OF APPEAL.

REASONS OF APPEAL—REVISION CONFINED THERETO.—The judge in hearing and determining appeals from the Commissioner of Patents, under the eleventh section of the act of 1839, is authorized to revise the decisions of the Commissioner only in respect to the points involved in the reasons of appeal. If the Commissioner did not err in those points his decision must be affirmed, although the judge should be of opinion, upon the whole case, that the patent ought to have been granted. *Arnold* v. *Bishop*, 36.

REVOCATION OF RULE.

See RULES OF THE PATENT OFFICE, 2.

RIGHT OF APPEAL.

See INTERLOCUTORY ACTIONS, 2, 3.
LIMIT OF APPEAL, 1, 2, 3.

1. INTERFERENCE—PATENTEE CANNOT APPEAL.—In an interference between an applicant and a patentee no appeal can be taken to the judge by the patentee from a decision of the Commissioner favorable to the applicant. *Pomeroy* v. *Connison*, 40.

2. PROCEEDINGS BEFORE COMMISSIONER INITIATORY.—The proceedings before the Commissioner and before the judge are all initiatory, and relate to the question whether a patent shall issue. They cannot affect a patent already granted. *Id.*

3. OBJECT OF APPEAL—ERROR IN REFUSING PATENT.—The general object of giving an appeal from the decision of the Commissioner is to correct his errors in refusing to grant patents for which otherwise there would be no remedy. His error in granting a patent may be corrected by the ordinary tribunals of the country when it is made a subject of litigation and there is no need of a special tribunal for that purpose. *Id.*

RIGHT OF APPEAL—*continued.*

4. SM—SM.—These words qualify the general language of the first part of the section giving to either party the right to appeal, and restrict the right of appeal to the case where patents have been refused as prayed for. *Id.*
5. JURISDICTION OF JUDGE SPECIAL AND LIMITED—SECTION 8 OF THE ACT OF 1836.—The power and jurisdiction given by the patent laws to the Board of Examiners and to the judge are special and limited, and must be construed and exercised strictly. The judge can only decide such questions and render such judgment as he is expressly authorized by the statutes to decide and render. In the case stated in the eighth section of the act of 1836 the judge is only to determine "which, or whether either, of the *applicants* is entitled to receive a patent as prayed for." *Id.*
6. SM—SM.—There is no section or clause of either of the acts relating to patents which gives a patentee a right of appeal from the decision of the Commissioner granting a patent to another person, unless that right be given by the eighth section of the act of 1836 relating to interferences. *Id.*
7. RIGHT OF APPEAL LOST.—The time for filing the reasons of appeal having expired, pending a motion before the Commissioner to rehear the case, the motion having been denied and a patent issued to the successful party, the right of appeal is lost. *Greenough* v. *Clarke*, 173.
8. RIGHT OF APPEAL—PATENTEE.—In an interference proceeding a patentee has no right of appeal from an adverse decision of the Commissioner. *Bowen* v. *Herriet*, 310.
9. SM—SM—EFFECT OF NEW APPLICATION.—Where a patentee involved in interference filed a new application for merely substitute or equivalent means for carrying the invention disclosed in his patent into effect, and this application was also included in the interference: *Held*, That he had no independent status as an applicant, and that an appeal by him from the adverse decision of the Commissioner was virtually an appeal by a patentee. *Id.*
10. INTERFERENCE—APPEAL BY PATENTEE DISMISSED.—An appeal in an interference by a patentee from a decision of the Commissioner, not referring or rejecting, but granting, the application, dismissed for want of jurisdiction or authority. *Whipple* v. *Renton*, 332.
11. JURISDICTION OF JUDGE—APPEAL BY PATENTEE.—The judge has no jurisdiction in case of an appeal taken by a patentee from a decision of the Commissioner, not refusing or rejecting, but granting, the application for letters-patent. *Hopkins* v. *Barnum*, 334.
12. JURISDICTION OF JUDGE—APPEAL BY PATENTEE.—The judge has no jurisdiction to hear and determine any appeal on behalf of a patentee from a decision of the Commissioner in favor of an interfering applicant. *Drake* v. *Cunningham*, 378.
13. APPEAL—WHEN WILL LIE.—An appeal will lie to the judge from the decision of the Commissioner refusing a patent to all of the applicants involved in an interference although he did not award priority to either. The appeal is from the refusal to grant the patent. *Carter et al.* v. *Carter et al.*, 388.
14. RIGHT OF APPEAL—CONTENDING APPLICANTS—PATENTEE.—The judge can only act in a case when there are contending applicants for a patent, and

RIGHT OF APPEAL—*continued.*

those applicants must have prayed for a patent. A patentee has already obtained all he asked for, and he cannot appeal from a decision adverse to himself but favorable to the applicant contestant. *King* v. *Gedney*, 443.

15. RIGHT OF APPEAL—SUBSTANTIAL REFUSAL OF A PATENT.—In such a case, therefore, an appeal will lie to the judge from a decision of the Commissioner granting a patent to each of the applicants for the matter claimed by him although he has not in terms refused a patent. (His granting a patent to both parties substantially refuses a patent to one of them as prayed for?) *Id.*

16. PATENTEE IN INTERFERENCE MAY APPEAL TO THE JUDGE.—Under the eighth section of the act of 1836 a patentee has equal right of appeal from a decision of the Commissioner in favor of an applicant to one of the judges of the Circuit Court of the District of Columbia that an applicant for a patent has under the same section from an adverse decision in favor of a prior patentee. *Babcock* v. *Degener*, 607.

RULES OF THE PATENT OFFICE.

See DEPOSITIONS, 1.
INTERLOCUTORY ACTIONS, 1.
NOTICE, 5.
POSTPONING HEARING.
RULES FOR TAKING TESTIMONY.

1. RULES OF THE COMMISSIONER BINDING AS THE LAW.—Rules made by the Commissioner in conformity with the law, while they remain unabrogated, are as binding upon the Commissioner as the law itself. *Arnold* v. *Bishop*, 27.

2. REVOCATION OF RULES NOT RETROACTIVE.—After a deposition has been taken while the rules were in force, the dispensation of the Commissioner cannot affect that deposition; a revocation of the rules can only affect subsequent proceedings. *Id.*

3. INFORMAL TESTIMONY REJECTED.—Evidence rejected which was not taken in accordance with a rule that provided that all evidence shall be sealed up and addressed to the Commissioner of Patents by the persons before whom it was taken, and so certified thereon. *Id.*

4. EFFECT OF A RULE CONSIDERED.—A rule which says "that no evidence, statement, or declaration touching the matter at issue will be considered upon the day of hearing which shall not have been taken and filed in compliance with these rules," is a restraint imposed upon the Commissioner himself as much as if the very words of the rule had been contained in the statute. *Id.*

5. EFFECT OF THE RULES OF THE OFFICE.—Whatever may be the meaning or effect of rule 7 of the Patent Office rules, the law must always be looked to, and whatever principle stated in the rules is not found in the provisions of the law cannot be depended on. *Stephens et al.* v. *Salisbury*, 379.

RULES FOR TAKING TESTIMONY.

See INTERLOCUTORY ACTIONS, 1.
PUBLIC USE AND SALE, 4.
RULES OF THE PATENT OFFICE, 2, 3, 4.

RULES FOR TAKING TESTIMONY—*continued.*

REGULATIONS FOR TAKING TESTIMONY—"JUST AND REASONABLE."—By the twelfth section of the act of 1839 the Commissioner is authorized to establish such regulations in respect to the taking of evidence as shall be just and reasonable; and to understand what the Legislature meant by just and reasonable in this connection it must be supposed that they had in mind the established principles and precedents in like cases. *Nichols* v. *Harris*, 362.

RULE IN DOUBTFUL CASES.

See NOVELTY, 2.
PERJURY.
SUFFICIENTLY USEFUL AND IMPORTANT, 1.

RULE IN DOUBTFUL CASES—REMEDY BY BILL IN EQUITY.—The rule that a patent should be granted in doubtful cases was perhaps a reasonable one when, under the law, the decision of the Commissioner, if affirmed by the Board of Examiners, was final; but as the applicant has now a further remedy by bill in equity, under the provisions of the tenth section of the law of 1839, when his patent is refused for any cause either by the Commissioner or the judge, the reason of the rule fails, and it will not be considered as binding upon the judge. *In Re Kemper*, 1.

SALE.

See PUBLIC USE AND SALE.

SCOPE OF CLAIMS.

See CLAIMS.

SECOND PATENT FOR SAME INVENTION.

COMPOSITION OF MATTER—EQUIVALENT INGREDIENTS—NEW APPLICATION.—Where the patent was for a composition of matter consisting of gutta-percha, oxide of iron, and oxide of antimony in described proportions, which was shown by the testimony to be the preferred form of the invention: *Held*, That the patentee could not prosecute a new application for a composition in which the oxides of iron and antimony were replaced by a variety of substances which operated in the same manner, but with less success, and were at best but equivalents of the ingredients named in the patent. Case of Pomeroy *v.* Connison (*ante*, p. 40) cited and approved. *Bowen* v. *Herriet*, 310.

SECOND INTERFERENCE.

See NEW TRIAL, 1, 3.

SECONDARY EVIDENCE.

See EVIDENCE.

SECRET INVENTION.

See ABANDONED EXPERIMENT, 1.
DELAY IN FILING APPLICATION, 5.
PUBLIC USE AND SALE, 21.

SECRET INVENTION—*continued.*

1. DILIGENCE IN APPLYING FOR PATENT.—Although an inventor has a right to keep his inchoate title to his invention concealed from the public as long as he pleases, yet when he desires to perfect his right by a patent he must proceed with vigilance to secure his protection by filing his application as early as practicable. *Ellithorp* v. *Robertson*, 585.
2. SECRET INVENTION—SUBSEQUENT INVENTOR'S PUBLIC USE AND SALE.—Where an inventor keeps his invention secret for years, and suffers a subsequent and independent inventor to engage extensively in the manufacture and sale of the same invention without protest or notice of his prior claim, he thereby forfeits his right to a patent. Under such circumstances, his delay will not be excused by the fact that his application was filed before the patent issued to the rival inventor. *Savary* v. *Lauth*, 691.
3. S. perfected his invention in 1854, and kept it secret until August, 1858, when he filed his application, and in the meantime, in June, 1858, L. independently made the invention, introduced it into public use with the knowledge of S., and filed an application for a patent March, 1858: *Held*, That S. was debarred from receiving a patent. *Id.*
4. SECRET INVENTION—PUBLIC USE AND SALE.—The statutory bar in section 7 of the act of 1839 to the inventor who sells his invention more than two years before his application would seem by analogy properly applicable to the inventor who secretes his invention more than two years, and thereby injures the public. *Spear* v. *Belson*, 699.

SECRETARY OF THE INTERIOR.

See LIMIT OF APPEAL, 5.

SECRET USE.

See PUBLIC USE AND SALE, 5, 14.
SECRET INVENTION.

SOLE INVENTOR.

See JOINT INVENTOR.

SPECIAL ORDER.

See LIMIT OF APPEAL, 2.

SPECIFICATION.

See CLAIMS, 1, 3, 4.
DESIGNS, 2.
DISCLAIMER.
DRAWINGS, 2.
EQUIVALENT, 1.
EXAMINATION OF APPLICATION, 3.
OATH OF INVENTION.
PARTICULAR INVENTION, 4.
PREREQUISITES TO A PATENT.
REDUCTION TO PRACTICE, 1.

SPECIFICATION—*continued.*

1. DRAWING AND MODEL TO BE CONSULTED.—The drawing and model filed with an application are to be taken together in explanation of the specification. *Stephens et al.* v. *Salisbury*, 379.
2. SPECIFICATION—LIBERALLY CONSTRUED—REQUIREMENTS OF.—The construction which ought to be given to the specification should not be too strict and technical. The proper inquiry is, has the specification substantially complied with that which the public has a right ro require; has the appellee communicated to the public the manner of carrying his invention into effect, so that a skillful workman can carry into execution the plan of the invention? *Id.*

SPECULATION.

See ABANDONED EXPERIMENT.
APPLICATION.
REDUCTION TO PRACTICE, 5.

STIPULATION.

See TESTIMONY, 1.

SUBORNATION OF PERJURY.

See PERJURY.

SUBSTITUTION OF MATERIAL.

See CHANGE OF MATERIAL.

SUCCESS OF INVENTION.

See DILIGENCE, 3.
NEW USE OF OLD MACHINE.
OPERATIVENESS OF INVENTION.
UNSUCCESSFUL EXPERIMENTS, 2.

SUFFICIENTLY USEFUL AND IMPORTANT.

See PARTICULAR INVENTIONS, 7.

1. "USEFUL AND IMPORTANT"—DEGREE IMMATERIAL.—The degree of usefulness or importance to be exhibited by the alleged invention is not defined by the statute (act of 1836), nor is the degree material if the invention does not interfere with any prior right or claim, and is in itself innocent. If good may be the result of granting a patent, and evil cannot be, the patent should be allowed, especially as it is doubtful whether a rejected applicant has any means of having his right to a patent brought before a court of law to be tried by a jury. *In Re Aiken*, 130.
2. UTILITY OF THE INVENTION—ADDITIONAL EVIDENCE IN SUPPORT OF.—Where an applicant has complied with all the formal requirements of the law by duly filing his application, and it is not found upon examination that the invention is subject to any of the objections mentioned in the law as fatal to the grant of a patent, it is not competent for the Commissioner to require additional evidence as to the practical result of the invention. *In Re Seely*, 248.

SUFFICIENTLY USEFUL AND IMPORTANT—*continued.*

3. "USEFUL AND IMPORTANT"—NOT A MATTER OF DEGREE—NOT FRIVOLOUS OR MISCHIEVOUS.—The question whether the invention is sufficiently useful and important does not refer to its degree of utility as compared with other inventions of the same kind, but rather to its purpose, as whether, being capable of use, it is destined for some beneficial purpose, or is merely frivolous, insignificant, or mischievous to society. *Id.*

4. SM—SM—SLIGHT UTILITY.—The fact that the difference of construction is only brought into play on rare occasions is no sufficient reason to deny the utility of the invention. *Chandler* v. *Ladd et al.*, 493.

5. PATENTABILITY—"SUFFICIENTLY USEFUL AND IMPORTANT."—Under the seventh section of the act of 1836, one of the conditions necessary to the granting of the patent is that upon the examination thereby directed, the "Commissioner shall deem it [the invention] to be sufficiently useful and important." *In Re Cushman*, 569.

SUGGESTION.

See BURDEN OF PROOF.
ORIGINAL INVENTOR, 1, 2, 3.

SURREPTITIOUS PATENT.

See DILIGENCE, 2, 4.
PUBLIC USE AND SALE, 12.
PREMATURE ISSUANCE OF PATENT.

"SURREPTITIOUSLY AND UNJUSTLY OBTAINED"—CAVEAT OVERLOOKED.—The fact that a caveat filed by another inventor was pending and in force when an interfering patent was granted, does not of itself show that the patent was surreptitiously obtained and void, nor does it authorize the Commissioner to grant a patent to the caveator until he shall establish his priority of invention in a regular proceeding for that purpose. *Cochrane* v. *Waterman*, 52.

SYSTEM.

See ACCIDENT AND DESIGN, 1, 2.

TERM OF PATENT.

1. INVENTOR MAY TAKE PATENT FOR LESS THAN FULL TERM.—The patentee is not obliged to claim the whole term of fourteen years for which a patent may be granted. Under the eighth section of the act of 1836, he may waive his claim to part of the term in favor of the public by antedating the patent in the manner and under the conditions there specified; and if he knowingly acquiesces in the antedating, and takes the deed so, he is in like condition. *In Re Cushman*, 577.

2. SM—ALTERING TERM OF PATENT AS A CLERICAL ERROR.—Neither can he in such a case correct the date of the patent as a clerical error, where it appears from the proceedings in the case that the antedating of the patent was a deliberate act on the part of the Commissioner, made in supposed accordance with the provisions of the law, upon the express request of the patentee, who accepted and acquiesced in the patent so granted. *Id.*

TESTIMONY.

APPEAL, GROUND OF, 3.
COUNSEL.
CREDIT OF WITNESS.
DEPOSITIONS.
DRAWINGS, 1.
EVIDENCE, 3, 5, 8, 11, 12, 13, 18, 20, 27.
EXAMINATION OF WITNESSES, 2, 3, 4, 5.
EXPERT.
HUSBAND AND WIFE.
INTEREST IN THE SUIT, 1, 2.
INTERFERENCE, 11, 15.
INTERLOCUTORY ACTIONS, 1, 3.
MAGISTRATE OF COUNSEL.
NEW PARTY.
NEW TRIAL, 7.
NOTICE, 1, 2, 3, 4, 5.
PERJURY.
PUBLIC USE AND SALE, 9, 11, 15.
UTILITY 2.

1. INADMISSIBLE TESTIMONY MAY BE STIPULATED IN, SUBJECT TO CREDIBILITY.—Testimony otherwise inadmissible may be admitted upon stipulation, but the interest of the witnesses in the matter in controversy may still go to their credit and have its due weight. *Warner* v. *Goodyear*, 60.
2. It would be unnecessarily oppressive to require the party, merely to gratify form, to take his testimony over again, as well as uselessly expensive. *McCormick* v. *Howard*, 238.
3. POSITIVE AND NEGATIVE TESTIMONY—RELATIVE WEIGHT.—The rule of law is, that if one witness swears positively that he saw or heard a fact, and another merely swears that he was present, but did not see or hear it, and the witnesses are equally faithworthy, the general principle would, in ordinary cases, create a preponderance in favor of the affirmative. *Cornell* v. *Hyatt*, 423.
4. SM—MUST BE RECONCILABLE.—This rule, however, is to be understood with this explanation: That the principle supposes that the positive testimony can be reconciled with the negative without violence and constraint. *Id.*
5. SM—SUPERIORITY OF NEGATIVE TESTIMONY WHEN IRRECONCILABLE.—Evidence of a negative nature may, under particular circumstances, not only be equal, but superior, to positive evidence. This must always depend upon the question whether, under the particular circumstances, the negative testimony can be attributed to inattention, error, or defective memory. *Id.*
6. SM—WEIGHT OF TESTIMONY—FAIRNESS OF WITNESS.—The negative testimony of a single witness, who is in a position to know the fact, may outweigh the positive testimony of two witnesses, particularly where they are shown by their answers to be unfair in their testimony. *Id.*

TIME FOR FILING APPEAL.

See LIMIT OF APPEAL, 3.
RIGHT OF APPEAL, 6.

TIME FOR FILING APPEAL—*continued.*

1. NOTICE OF APPEAL—SUSPENDS PROCEEDINGS.—On receiving notice from the party of his intention to appeal, it becomes the duty of the Commissioner, and his exclusively, to fix a reasonable time for filing the reasons; within which time all further action upon the application within the Office is to be suspended, and within which time the reasons of appeal must be filed, unless for good cause shown the Commissioner directs the time to be enlarged. *Greenough* v. *Clark*, 173.
2. TIME OF APPEAL MAY BE ENLARGED.—The power to enlarge the time for filing the reasons of appeal, and to rehear the case, remains with the Commissioner not only until the patent issues, but until it is actually delivered; after which his power over the case is exhausted. *Id.*

TITLE.

See PATENT.

UNSUCCESSFUL EXPERIMENTS.

See PRIOR INVENTION, 7.

1. PRINCIPLE—UNSUCCESSFUL EXPERIMENTS—REDUCTION TO PRACTICE.—A mere principle or idea, until it assumes a practical form, is not patentable; and a long course of mere fruitless experiments to reduce the principle to practice would not prevent a subsequent original inventor who had perfected his invention without knowledge of the prior invention from obtaining a patent. *McCormick* v. *Howard*, 238.
2. UNSUCCESSFUL EXPERIMENTS—PROCESS.—Where the proofs offered by an inventor in support of his claim to have invented and discovered a new process—as of manufacturing white oxide of zinc—indicate that he did not in his experiments observe the proper chemical conditions—as the proper admixture of the ore and fuel, the depth of the charge, the regulation of the blast, &c.—and that as a matter of fact he failed to obtain successful results: *Held*, That his efforts amounted to no more than an unsuccessful experiment, and did not entitle him to a patent as against an independent inventor. *Jones* v. *Wetherill*, 409.

USEFUL AND IMPORTANT.

See SUFFICIENTLY USEFUL AND IMPORTANT.

UTILITY.

See ACCIDENTAL DISCOVERY.
ANTICIPATION.
APPEAL, GROUND OF, 1.
CHANGE, 6.
COMPARATIVE MERIT OF INVENTIONS.
COMPOSITION OF MATTER, 1, 3.
DESIGNS.
EVIDENCE OF INVENTION, 1.
INTERFERENCE, 16.

UTILITY—*continued.*

INVENTION, 3.
INVENTOR NOT AWARE OF THE VALUE OF THE INVENTION.
NEW USE OF OLD MACHINE.
OATH OF INVENTION, 1.
PARTICULAR INVENTIONS, 7.
PROCESS, 3.
SUFFICIENTLY USEFUL AND IMPORTANT.

1. UTILITY OF INVENTION—FILING AFFIDAVITS THERETO PENDING APPEAL.—Pending the decision of an appeal from the Commissioner, an applicant will be permitted, on motion, to procure and file affidavits of competent persons touching the practical utility and advantages of his invention. *In Re Fultz*, 178.
2. TESTIMONY AS TO UTILITY, COMPETENT.—The testimony of witnesses is admissible to show the practical effect or utility of an invention. *Id.*
3. INVENTION—INSTRUMENT CAPABLE OF A NEW USE.—When there is a palpable difference of construction—as in the substitution of an entire graduated circle for a graduated semi-circle in a pendulum level—which is shown to fit the new instrument for use in situations where the old form of instrument could not be used, there is a patentable invention. *Chandler* v. *Ladd et al.*, 493.
4. SM—SM.—It is not necessary that the utility should be great; it is sufficient if the invention is an improvement at all. If it is of a different construction from former articles of the same kind, and of any use, that is sufficient. It need not come into general use. *Id.*

WAIVER.

See NOTICE, 3, 4.
TERM OF PATENT, 1.

VOID PATENT.

See POWER OF COMMISSIONER, 4.

VALUE OF INVENTION.

See INVENTOR NOT AWARE OF VALUE OF INVENTION.

VALIDITY OF PATENT.

See INTERFERENCE, 1, 11.
POWER OF COMMISSIONER, 1.

WITHDRAWAL OF APPLICATION.

See EXAMINATION OF APPLICATION, 5.
PUBLIC USE AND SALE, 19.

1. WITHDRAWAL OF APPLICATION—EFFECT OF.—The withdrawal of an application and the return of the fee under the seventh section of the act of 1839 is a final abandonment of the application, and effects an entire extinction of all protection, saving, and privilege thereunder. Such an application

WITHDRAWAL OF APPLICATION—*continued.*

cannot be revived by filing a new application for the same invention Such new application will not relate back to, or be considered as a revival of, the withdrawn application for the purpose of avoiding the objection of intervening public use. *Mowry* v. *Barber*, 563.

2. ABANDONMENT—WITHDRAWAL OF APPLICATION—HOW REGARDED.—The withdrawal of an application and the return of the fee is not of itself an abandonment or dedication of one's invention to the public, but is an equivocal act, to be interpreted by surrounding circumstances, and to be affected upon a second application for the same invention by the subsequent conduct of the party—his diligence or his neglect and delay—in the same manner as his conduct is to be weighed in regard to an original application. *Wickersham* v. *Singer*, 645.

WITNESSES.

See DRAWINGS, 2.
EVIDENCE, 1, 5, 11, 12, 14, 18, 20, 26, 27.
EXAMINATION OF WITNESSES, 6.
IMPLIED LICENSE.
INTEREST IN THE SUIT, 1, 2.
MEASURE OF PROOF.
PUBLIC USE AND SALE, 4.
TESTIMONY.

1. INTEREST—NOT AFFECTED BY RESULT OF CONTROVERSY.—The interest of a witness in the matter in controversy not objectionable when his relations to the parties are such that his interest will remain unaffected by any issue of the suit. *Arnold* v. *Bishop*, 27.

2. DIRECT AND CIRCUMSTANTIAL EVIDENCE.—The positive testimony of a credible witness fixing the date of an invention outweighs circumstantial evidence merely raising a doubt as to the correctness of the witness' recollections. *Cundell* v. *Parkhurst*, 63.

3. EVIDENCE—WITNESSES NOT CALLED.—The fact that an inventor has not produced as witnesses in his behalf the workmen in the same shop, who might be supposed to be most familiar with his invention, does not raise a presumption against him in a case where by publicity he might have deprived himself of the benefit of his invention. *Screw Co.* v. *Sloan*, 210.

4. WITNESSES—PRESUMPTION OF HONESTY—DISCREPANCIES UPON IMMATERIAL POINTS.—The presumption is that a witness under oath testifies honestly, until the contrary is shown. Contradictions and inconsistencies upon immaterial points, not proceeding from corrupt motives, do not entirely destroy his testimony. *Id.*

5. EVIDENCE—CREDIT OF WITNESS—IMMATERIAL MISTAKE.—A mistake by a witness in an immaterial fact ought not to discredit him. The maxim *falsus in uno, falsus in omnibus* only applies where there is a willful, corrupt falsehood in one particular amounting to perjury. *Marshall* v. *Mee*, 229.

6. WITNESSES—EXAMINED LONG AFTER THE EVENT—CREDIT TO BE GIVEN TO.—Under any circumstances, a great lapse of time, which has taken place before the witnesses are called upon to state the facts relating to a case

WITNESSES—*continued.*

where a nice point of invention is to be established, must in the nature of things make it very difficult to get at the real facts in the case, unless they were reduced to writing at the time. *Carter et al.* v. *Carter et al.*, 388.

7. WITNESSES EXAMINED ON NEW TRIAL.—When witnesses have been once examined upon the facts in the case, and then upon a new trial endeavor to supplement the deficiency of their former testimony, as pointed out in the decision, their testimony should be received with great caution, and particularly where the occurrences to which they testify were twenty years old, and involved a nice point of invention. *Id.*

8. SM.—Exhibiting to witnesses the opinion in the former case is calculated to lead their minds to the further proof necessary in the case; and in its fairest aspect this proceeding would be as great, if not more objectionable, than leading questions would be, answers to which are inadmissible in evidence. *Id.*

9. SM—INCONSISTENCIES AND DISCREPANCIES IN TESTIMONY—EFFECT OF.—When there are deliberate inconsistencies and discrepancies in a witness' testimony in material matters, proceeding from design, no credit can be given to the same, in accordance with the rule *falsus in uno, falsus in omnibus.* When such inconsistencies arise from ignorance or a careless inadvertence, all confidence in the truth of his testimony must still be lost. *Id.*

10. CONTRADICTION IN TESTIMONY—COMPARED WITH DEPOSITION.—The testimony of a witness may be compared with his deposition in a former interference relating to the same matter; and gross contradictions thereby appearing, not accounted for by any satisfactory explanations, will discredit his testimony. *Wellman* v. *Blood*, 432.