ANNUAL

DIGEST OF THE DECISIONS

OF THE

SUPREME COURT OF THE UNITED STATES

THE FEDERAL COURTS

AND OF

THE COMMISSIONER OF PATENTS

(INCLUDING MANUSCRIPT DECISIONS)

IN MATTERS

RELATING TO PATENTS, TRADEMARKS, DESIGNS
LABELS AND COPYRIGHTS

FOR 1899

BY

LOUIS M. SANDERS

ASSISTANT EXAMINER U. S. PATENT OFFICE

WASHINGTON:
JOHN BYRNE & CO.
1900

PREFACE.

SEVERAL new features have been added to the "Digest for 1899," which, it is believed, will be of value to users of the book. Among these may be mentioned the following: Such of the unpublished or MS. decisions of the Commissioner and Assistant Commissioner of Patents as are accessible to the public; lists of all appealed cases and their disposition on such appeal; lists of all patents adjudicated upon where the decision has been published, etc., etc. The Court, jurisdiction and date of decision has been annexed to the several *syllabi*.

It will be noted that a new classification has been adopted for all matter pertaining to the Application during its pendency as such. Matters pertaining to Interferences, however, have been left under the general head of Interferences.

The * precedes all Federal Court decisions. The † precedes the decisions of the Secretary of the Interior. The decisions of the Commissioner and Assistant Commissioner are unmarked.

L. M. S.

WASHINGTON, D. C., *January, 1900.*

JUSTICES

OF THE

SUPREME COURT OF THE UNITED STATES.

MELVILLE WESTON FULLER, CHIEF JUSTICE.

JOHN MARSHALL HARLAN,	ASSOCIATE JUSTICES.
HORACE GRAY,	
DAVID JOSIAH BREWER,	
HENRY BILLINGS BROWN,	
GEORGE SHIRAS, JR.,	
EDWARD DOUGLASS WHITE,	
RUFUS W. PECKHAM,	
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JUDGES OF THE UNITED STATES CIRCUIT COURTS OF APPEALS, AND THE CIRCUIT AND DISTRICT COURTS.

1ST CIRCUIT.

HORACE GRAY, CIRCUIT JUSTICE.

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NATHAN WEBB,	Me.,	DISTRICT JUDGES.
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ARTHUR L. BROWN,	R. I.,	

2D CIRCUIT.

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NATHANIEL SHIPMAN,	

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HOYT H. WHEELER,	Vt.,	

3D CIRCUIT.

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WILLIAM BUTLER,[1]	E. D. Pa.,	
JOHN B. MCPHERSON,[2]	E. D. Pa.,	
JOSEPH BUFFINGTON,	W. D. Pa.,	

* Additional Judgeship created Jan. 25, 1899.

[1] Retired Jan. 31, 1899. [2] Commissioned Mar. 2, 1899.

4TH CIRCUIT.

MELVILLE W. FULLER, CIRCUIT JUSTICE.

NATHAN GOFF, CHARLES H. SIMONTON, } CIRCUIT JUDGES.

THOMAS J. MORRIS,	Md.,	DISTRICT JUDGES.
THOMAS R. PURNELL,	E. D. N. Car.,	
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WILLIAM R. BRAWLEY,	E. & W. D. S. Car.,	
EDMUND WADDILL, JR.,	E. D. Va.,	
JOHN PAUL,	W. D. Va.,	
JOHN J. JACKSON,	W. Va.,	

[1] Commissioned Apr. 13, 1899.

5TH CIRCUIT.

EDWARD D. WHITE, CIRCUIT JUSTICE.

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JOHN BRUCE,	N. D. Ala.,	DISTRICT JUDGES.
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CHARLES SWAYNE,	N. D. Fla.,	
JAMES W. LOCKE,	S. D. Fla.,	
WILLIAM T. NEWMAN,	N. D. Ga.,	
EMORY SPEER,	S. D. Ga.,	
CHARLES PARLANGE,	E. D. La.,	
ALECK BOARMAN,	W. D. La.,	
HENRY C. NILES,	S. D. Miss.,	
DAVID D. BRYANT,	E. D. Tex.,	
EDWARD R. MEEK,	N. D. Tex.,	
THOMAS S. MAXEY,	W. D. Tex.,	

* Additional Judgeship created Jan. 25, 1899.

6TH CIRCUIT.

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HORACE H. LURTON,		CIRCUIT JUDGES.
WILLIAM R. DAY,*		CIRCUIT JUDGES.
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WALTER EVANS,[2]	Ky.,	DISTRICT JUDGES.
HENRY H. SWAN.	E. D. Mich.,	DISTRICT JUDGES.
HENRY F. SEVERENS.	W. D. Mich.,	DISTRICT JUDGES.
AUGUSTUS J. RICKS.	N. D. Ohio,	DISTRICT JUDGES.
GEORGE R. SAGE,[3]	S. D. Ohio,	DISTRICT JUDGES.
ALBERT C. THOMPSON,[4]	S. D. Ohio,	DISTRICT JUDGES.
CHARLES D. CLARK.	E. & M. D. Tenn.,	DISTRICT JUDGES.
ELI S. HAMMOND.	W. D. Tenn.,	DISTRICT JUDGES.

* Additional Judgeship created Jan. 25, 1899.

[1] Retired Feb. 21, 1899. [2] Commissioned Mar. 3, 1899.

[3] Resigned. [4] Commissioned Sept. 23, 1899.

7TH CIRCUIT.

HENRY B. BROWN, CIRCUIT JUSTICE.

WILLIAM A. WOODS.		CIRCUIT JUDGES.
JAMES G. JENKINS.		CIRCUIT JUDGES.
JOHN W. SHOWALTER.[1]		CIRCUIT JUDGES.
PETER S. GROSSCUP.[2]		CIRCUIT JUDGES.
PETER S. GROSSCUP.[3]	N. D. Ills.,	DISTRICT JUDGES.
CHRISTIAN C. KOHLSAAT.[4]	N. D. Ills.,	DISTRICT JUDGES.
WILLIAM J. ALLEN,	S. D. Ills.,	DISTRICT JUDGES.
JOHN H. BAKER.	Ind.,	DISTRICT JUDGES.
WILLIAM H. SEAMAN.	E. D. Wis.,	DISTRICT JUDGES.
ROMANZO BUNN.	W. D. Wis.,	DISTRICT JUDGES.

[1] Deceased Dec. 10, 1898. [2] Commissioned Jan. 23, 1899.

[3] Resigned to take effect upon his qualifying as Circuit Judge.

[4] Commissioned Feb. 28, 1899.

8TH CIRCUIT.

DAVID J. BREWER, CIRCUIT JUSTICE.

HENRY C. CALDWELL.		CIRCUIT JUDGES.
WALTER H. SANBORN.		CIRCUIT JUDGES.
AMOS M. THAYER.		CIRCUIT JUDGES.
JOHN A. WILLIAMS.	E. D. Ark.,	DISTRICT JUDGES.
JOHN H. ROGERS.	W. D. Ark.,	DISTRICT JUDGES.
MOSES HALLETT.	Colo.,	DISTRICT JUDGES.
OLIVER P. SHIRAS.	N. D. Ia.,	DISTRICT JUDGES.
JOHN S. WOOLSON.	S. D. Ia.,	DISTRICT JUDGES.

Cassius G. Foster,[1]	Kan.,	District Judges.
William C. Hook,[2]	Kan.,	
William Lochren,	Minn.,	
Elmer B. Adams,	E. D. Mo.,	
John F. Philips,	W. D. Mo.,	
W. H. Munger,	Neb.,	
Charles F. Amidon,	N. Dak.,	
John E. Carland,	S. Dak.,	
John A. Marshall,	Utah,	
John A. Riner,	Wy.,	

[1] Resigned Feb. 28, 1899. [2] Commissioned Feb. 13, 1899.

9th circuit.

Joseph McKenna, Circuit Justice.

William W. Morrow,		Circuit Judges.
William B. Gilbert,		
Erskine M. Ross,		
John J. De Haven,	N. D. Cal.,	District Judges.
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Hiram Knowles,	Mont.,	
Cornelius H. Hanford,	Wash.,	
Thomas P. Hawley,	Nev.,	
Charles B. Bellinger,	Ore.,	
James H. Beatty,	Id.,	
Charles S. Johnson,	Alaska,	

COURT OF APPEALS OF THE DISTRICT OF COLUMBIA.

Richard H. Alvey, Chief Justice.

Martin F. Morris,	Associate Justices.
Seth Shepard.	

UNITED STATES PATENT OFFICE.

HON. CHARLES HOLLAND DUELL,
COMMISSIONER OF PATENTS.

HON. ARTHUR PHILIP GREELEY.
ASSISTANT COMMISSIONER OF PATENTS.

TABLE OF CONTENTS.

ANNUAL

DIGEST OF DECISIONS

IN

PATENT, TRADEMARK, DESIGN, LABEL, AND COPYRIGHT CASES.

Abandonment of Invention. (See Applications, Abandoned.)

I. In General.

II. By Failure to Claim.

I. In General.

1. The failure of an inventor to show that he made his invention at a date prior to the filing of the application for a patent, which is cited as anticipating the claims of his application, and the acceptance of a patent with claims so narrowed as to exclude the anticipated matter, is an abandonment of such matter to the public; and the inventor will not be allowed, in a suit upon the patent so narrowed, to claim a construction which would cover the matter thus abandoned. (C. C., D. N. J. May 25, 1899.)

Gray, J.] *Maier *et al.* v. Bloom *et al.*, 95 Fed. Rep. 159.

2. Where after a reduction to practice of an invention an applicant delayed for eleven years in filing an application because of the fixed and determined purpose on the part of the owner of the invention to keep it from the public and to prevent his partners from obtaining any benefit whatever therefrom until the expiration of certain patents and he could find it profitable to dispose of certain machines that he had on hand, and in the meantime third parties had applied for and obtained a patent

for the same invention, *Held* that there was no excuse or justification whatever for the want of diligence in making the application. (C. A. D. C. June 6, 1899.)

ALVEY, J.] *Mower *v.* Duell, Com'r of Patents, 88 O. G. 191.

3. Under such circumstances, to say the least of the matter, there was not much consideration given to the public in this scheme of delay, however much it may have inured to the benefit and advantage of the owner of the invention. **Id.*

4. Where an applicant reduced an invention to practice and delayed for about eleven years in filing an application, and during this delay subsequent and independent inventors of the same device came into the Office with their completed invention and applied for and obtained a patent at much cost and trouble, and put the invention into operation and gave the public the benefit of it, *Held* that to grant a patent to the first to reduce the invention to practice and thereby defeat the patent of three years' standing would neither be equitable nor just, nor would it be promotive of the great object of the patent laws. (Bates *v.* Coe, 98 U. S. 31, cited.) **Id.*

5. The patent laws are founded in a large public policy to promote the progress of science and the useful arts. The public, therefore, is a most material party to and should be duly considered in the application for a patent securing to the individual a monopoly for a limited time in consideration of the exercise of his genius and skill. **Id.*

6. The arts and sciences will not be promoted by giving encouragement to inventors to withhold and conceal their inventions for an indefinite time or to a time when they may use and apply their inventions to their own exclusive advantage irrespective of the public benefit, and certainly not if the inventor is allowed to conceal his invention to be brought forward in some after time to thwart and defeat a more diligent and active inventor who has placed the benefit of his invention within the reach and knowledge of the public. **Id.*

7. In withholding the invention after its completion, when a patent could be obtained therefor, for an undue and unreasonable time until after other inventors have by their skill and ingenuity perfected a similar invention and obtained a patent therefor, the first or original inventor shows himself to be un-

mindful of both the public and individual rights, and one of the reasons why the statute has confided such large powers to the Commissioner of Patents in refusing a patent is to prevent such abuse. *Id.*

8. Under section 4893, Revised Statutes, an invention claimed must not only be shown to be new and useful, but it must also be made to appear that a claimant is justly entitled to a patent therefor. A claimant cannot be justly entitled if a patent when granted would or could operate a wrong either to the public or a rival inventor and that wrong be the result of the claimant's own laches or negligent delay in asserting his rights. *Id.*

9. Where it was urged that under section 4886, Revised Statutes, there can be no abandonment of a right to a patent unless such abandonment be affirmatively proved, *Held* that affirmative facts may be proved by negative evidence, and where the acts and conduct of a party are of such nature as to give rise to a rational presumption of a fact, that presumption, after the rights of other parties have intervened and attached, cannot be removed or gotten rid of by simply denying the intention to produce the result. *Id.*

10. Parties must be bound by the consequence of their own acts, and this principle is true in the patent law as it is in all other departments of the law. A deliberate intentional delay and non-action in a matter of either a public or private concern is proof of a very cogent nature, and the party chargeable with such conduct must bear the consequences of it, and will not be heard to excuse himself by simply declaring that he did not intend to prejudice the rights of others or to waive rights of his own that would have been available to him if they had been timely exercised. *Id.*

II. By Failure to Claim. (See Patents, Construction of, In General.

1. The failure of an applicant to claim separately the steps of the process additional to those set forth in other claims is not a confession by him that he was not the inventor of them; such failure goes no further than a dedication to the public of such steps if he was the inventor of them. (Oct. 9, 1899.)

Duell, C.] *Ex parte* Fauche, 68 MS. Dec. 29.

2. A description of a device or combination, which is not claimed in the drawing or specification of a patent, estops the patentee from securing a monopoly of its use by a subsequent patent as well as by any other means. (C. C. A., 8th Cir. Oct. 9, 1899.)

SANBORN, J.] *McBride *v.* Kingman *et al.;* Same *v.* Sickels *et al.;* Same *v.* Randall *et al.;* Same *v.* Ainsworth *et al.*, 97 Fed. Rep. 217.

Amendment to Patent Law in Regard to Insane Persons.

[PUBLIC—No. 91.]

An Act to amend section forty-eight hundred and ninety-six of the Revised Statutes.

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That section forty-eight hundred and ninety-six of the Revised Statutes is hereby amended by inserting after the words "in his life-time" the following words: "and when any person having made any new invention or discovery for which a patent might have been granted becomes insane before a patent is granted, the right of applying for and obtaining the patent shall devolve upon his legally appointed guardian, conservator, or representative in trust for his estate, in as full manner and on the same terms and conditions as the same might have been claimed or enjoyed by him while sane;" and by inserting at the end of said section the following words: "The foregoing section, as to insane persons, is to cover all applications now on file in the Patent Office or which may be hereafter made," so that the said section as amended will read as follows:

"SEC. 4896. When any person, having made any new invention or discovery for which a patent might have been granted, dies before a patent is granted, the right of applying for and obtaining the patent shall devolve on his executor or administrator, in trust for the heirs at law of the deceased, in case he shall have died intestate; or if he shall have left a will, disposing of the same, then in trust for his devisees in as full manner and on the same terms and conditions as the same might have been claimed or enjoyed by him in his lifetime; and when any person having made any new invention or discovery for which a

patent might have been granted becomes insane before a patent is granted, the right of applying for and obtaining the patent shall devolve on his legally appointed guardian, conservator, or representative in trust for his estate, in as full manner and on the same terms and conditions as the same might have been claimed or enjoyed by him while sane; and when the application is made by such legal representatives, the oath or affirmation required to be made shall be so varied in form that it can be made by them.

"The foregoing section, as to insane persons, is to cover all applications now on file in the Patent Office or which may be hereafter made."

Approved, February 28, 1899.

Anticipation.

I. PATENTS AND PRINTED PUBLICATIONS.
II. PRIOR ART.
III. PRIOR USE.
IV. PUBLIC USE OR SALE.

I. PATENTS AND PRINTED PUBLICATIONS.

1. Where a patent discloses in the drawing clearly and completely everything set forth in the claims of an application, though the descriptive part of the specification of the patent does not describe or refer to the construction, *Held*, to be a proper reference, and to anticipate the claims in question. (Dec. 5, 1899.)

GREELEY, A. C.] *Ex parte* Scott, 68 MS. Dec. 251.

2. A party is entitled to a patent only when he gives to the public a novel invention, and that invention is not novel if it has been previously disclosed to the public by another in such manner that one skilled in the art can make and use it. If that disclosure is complete and puts the public in full possession of the invention, it is immaterial how it was made, whether by the drawing or by the description. The question in each case is, whether or not the invention is, in fact, fully disclosed to the public. *Id.*

3. A material consisting of the comminuted cellular portion of corn-pith freed from sappy, deleterious, and adherent matters

by subjecting the pith to the action of a blast of air, preferably heated, *Held* to be not anticipated by applicant's prior patent disclosing corn-pith obtained by passing cornstalks through breakers and then separating the pith from the fiber and outside shell, as there is no description in the patent that the pith is subjected to air at a high temperature. (C. A. D. C. Feb. 8, 1899.)

MORRIS, J.] *Marsden *v.* Duell, Com'r of Patents, 87 O. G. 1239.

4. When it is sought to invalidate a United States patent under Revised Statutes, sections 4885 and 4920, by an alleged prior foreign patent, it has been repeatedly held that such alleged foreign patent must be one that is open and accessible to the public—one that is a public and not a secret one. (June 23, 1899.)

DUELL, C.] Roschach *v.* Walker, 88 O. G. 1333.

5. It does not appear that the Bundy device was ever put to practical use; and from the time of Bundy to the time of Simonds, dies constructed according to the mechanical laws covering those of both inventors, so far as shaping various articles is concerned, are not found in the art. Bundy had been buried for more than three-quarters of a century when Simonds gave to the world his patent, which admittedly revolutionized the art of the production by power of articles circular in cross-sectional area. It would be strange, indeed, if a patent like that of Bundy, buried so long as his, and originating when forging by power rolls and power dies was unknown, could be held to anticipate so important an advance on the subject-matter of forging by power as the invention of Simonds, expressed in his patent. (C. C., D. Me. July 30, 1898.)

PUTNAM, J.] *Simonds Rolling-Mach. Co. *v.* Hathorn Mfg. Co. *et al.*, 90 Fed. Rep. 201.

6. A patent which fails to show the one feature upon which invention rests is valueless as an anticipation. (C. C., S. D. N. Y. Nov. 15, 1898.)

COXE, J.] *Gormully & J. Mfg. Co. *v.* Stanley Cycle Mfg. Co. *et al.*, 90 Fed. Rep. 279.

7. A design patent *Held*, anticipated by a patent for the article

of manufacture, granted more than two years prior to the filing date of the application for the design patent, both patents covering the same subject-matter and granted to the same inventor. (C. C., S. D. N. Y. Nov. 22, 1898.)

WHEELER, J.] *Cary Mfg. Co. *v.* Neal *et al.*, 90 Fed. Rep. 725.

8. There is a manifest difference between the necessities of a system for varying the illuminating effects of incandescent lamps in a room and the needs of electric mechanism for regulating the current to be conveyed to electric motors, and thus regulating the speed of a car. The patent for the one with its groups of electric lights told nothing to the inventor who was trying to protect an electric car motor in action from the inflow of a current dangerous both to machinery and passengers. (C. C. A., 2d Cir. Dec. 7, 1898.)

SHIPMAN, J.] *Electric Car Co. of America *et al.* *v.* Nassau Electric R. Co., 91 Fed. Rep. 142.

9. Where a prior patent is alleged to anticipate the patent in suit, the description in the prior patent must be tested for sufficiency by the knowledge of persons skilled in the art as it existed at the date of the prior patent. (C. C., N. D. Cal. Dec. 12, 1898.)

MORROW, J.] *Bowers *v.* San Francisco Bridge Co., 91 Fed. Rep. 381.

10. The granting of a patent raises a presumption in favor of its operativeness and utility (Dashiell *v.* Grosvenor, 162 U. S. 425, 16 Sup. Ct. 805); and when the defects therein are merely in minor details of construction, such defects will not defeat the efficiency of the patent as an anticipation, provided it sufficiently discloses the principle of the alleged invention. (Pickering *v.* McCullough, 104 U. S. 310; Electric Ry. Co. *v.* Jamaica & B. R. R. Co., 61 Fed. Rep. 655.) (C. C., D. Conn. Jan. 24, 1899.)

TOWNSEND, J.] *Patent Button Co. *v.* Scovill Mfg. Co., 92 Fed. Rep. 151.

11. Where it was contended that the prior art, as disclosed in all of the alleged anticipatory patents, was in 1882 so suggestive as to make the car-coupler of the patent in suit obvious to an intelligent and skilled mechanic; and with a view of demon-

strating this obviousness the defendant, in 1896, submitted the Janney construction, under the 1879 patent, to three skilled mechanics, and, without further instructions, asked them to substitute a vertical lock in lieu of the side or laterally working lock of the patent of 1879, which they did, and their results fairly show the device of the patent in suit, *Held*, that the action of these mechanics is not a fair test of obviousness for two reasons: First, they did their work in 1896 instead of 1882, the date of the patent, and it does not follow that if a mechanic in 1896, with all the light of advanced knowledge in the art, could apply the mechanical knowledge as it existed in 1882 to a new result, such mechanic could have done so if he had made the effort in 1882. Second, the question submitted to the mechanics practically stated the object to be accomplished. A part of the invention was to apprehend that there could be an effectively working vertical pin, and this part of the invention was imparted to the mechanics. (C. C., E. D. Mo.; E. D. Feb. 14, 1899.)

ADAMS, J.] *McConway & Torley Co. *v.* Shickle, Harrison & Howard Iron Co., 92 Fed. Rep. 162.

12. Unless the prior publication describes the invention in such a full, clear and intelligible manner as to enable persons skilled in the art to comprehend it and reproduce the process or article claimed, without assistance from the patent, the publication is insufficient as an anticipation. (Cases cited.) (C. C., S. D. N. Y. May 8, 1899.)

COXE, J.] *Badische Analin & Soda Fabrik *v.* Kalle *et al.*, 94 Fed. Rep. 163.

13. A description which is insufficient to support a patent cannot be relied on as an anticipation. In each instance the same precision is required. **Id.*

14. If prior patents and publications can be reconstructed by extrinsic evidence to fit the exigencies of the case, the inquiry will no longer be confined to what the publication communicates to the public, but it will be transferred to an endeavor to ascertain what the author intended to communicate. The question is, What does the prior publication say? not what it might have said or what it should have said. The court has simply to consider what the publication has contributed to the art. If

it fails to show the invention which it is said to anticipate, the contention that its author knew enough to write an anticipation is grotesquely irrelevant. Were such a rule established, the law upon this subject would be thrown into inextricable confusion. *Id.*

15. The criterion by which to determine whether or not a foreign patent is an anticipation of a patent granted in the United States is to ascertain whether or not the description and drawings of the foreign patent are so full, clear and exact as to enable any person skilled in art to which they relate to practice theinvention of the U. S. patent, and if so found, then the U. S. patent is void for anticipation. (C. C., E. D. Mo. E. D. June 26, 1899.)

ADAMS, J.] *Springfield Furnace Co. *et al.* v. Miller Down-Draft Furnace Co. *et al.*, 96 Fed. Rep. 418.

16. To sustain the defense of anticipation, it is necessary that the anticipatory matter should clearly show the invention subsequently patented in such manner as to enable any person skilled in the art or science to which it relates to make or construct and practically use the invention for the purposes contemplated in the subsequent patent. (C. C. A., 3d Cir. Oct. 4, 1899.)

BRADFORD, J.] *McNeely *et al.* v. Williames *et al.* Williames *et al.* v. McNeely *et al.*, 96 Fed. Rep. 978.

II. PRIOR ART.

1. An inventor is entitled to be protected to the extent of what he practically accomplishes, and no more; and in this particular, anticipatory matter which has never gone into practical use is to be narrowly construed; (citing Ford v. Bancroft, 85 Fed. Rep. 457, 461.) because, otherwise, the effect given to an invention of doubtful utility "would operate rather to the discouragement than to the promotion of inventive talent." (Citing Deering v. Harvister W'ks, 155 U. S. 286, 295; 15 Sup. Ct. 118; 69 O. G. 1641; C. D. 1894.) (C. C., D. Me. July 30, 1898.)

PUTNAM, J.] *Simonds Roller-Mach. Co. v. Hathorn Mfg. Co. *et al.*, 90 Fed. Rep. 201.

2. In determining whether what a patentee has done involved real invention, the court is bound to assume that the patentee knew everything about the art to which the alleged invention pertains which was contained in printed publications or in the public history of that art, and upon that assumption to say whether the step taken required the exercise of the inventive faculty. (C. C., S. D. Ohio, W. D. Dec. 2, 1898.)

TAFT, J.] *Fry *v.* Rookwood Pottery Co. *et al.*, 90 Fed. Rep. 495.

3. An impracticable prior device, not capable of performing the function of a subsequent patented device that is practicable and useful, is no anticipation. (C. C., N. D. Cal. Dec. 12, 1898.)

MORROW, J.] *Bowers *v.* San Francisco Bridge Co., 91 Fed. Rep. 381.

4. It is not sufficient to constitute an anticipation that a prior device might, by modification, be made to accomplish the function performed by the device of the patent, if it was not designed by its maker, nor adapted nor actually used for the performance of such functions. (C. C., E. D. Wis. July 5, 1898.)

SEAMAN, J.] *Western Electric Co. *v.* American Rheostat Co. *et al.*, 91 Fed. Rep. 650.

5. A claim for a compound bar for making cutting-tools, consisting of an inner bar of harder metal and an inclosed bar of softer metal pressed on the same, etc., contains nothing that is patentably new in view of a patent which shows a bar of hard steel surrounded or partly surrounded by a bar of softer steel and another patent which shows a bar for cutting-blades made by partly surrounding the hard steel by iron. (C. A. D. C. Mar. 8, 1899.)

ALVEY, J.] *Bedford *et al. v.* Duell, Com'r of Pats., 87 O. G. 1611.

6. Where a protest was entered in the German Patent Office to the grant of a claim for a *method* for making steel bars for tools by combining two bars of different grades of steel so that the superior steel is inserted in a bar of inferior steel, on the ground that the method was already known, and the protest was overruled, *Held*, that the action of the German Office can

have no influence upon the determination of the present case, as there is no evidence that the references before the Patent Office here were before the German Office. *Id.*

7. The similitude in the invention relied on as matter of anticipation with the invention for which a patent is sought need not be exact in form or structure; but if the information contained therein is full enough and sufficiently precise to enable any person skilled in the art to which it relates to perform the process or make the thing covered by the claim of invention sought to be patented, it will be sufficient to establish the fact of anticipation and the want of novelty in the alleged invention. *Id.*

8. A claim for a traveling carrier of a hog-hoisting machine the essential feature of which is chain-pendants permanently attached to the carrier, *Held*, to be anticipated by an endless carrier for hoisting building material, having rod-pendants permanently attached thereto, the uses of the two devices being practically the same, as by substituting the chain for the rod attached to the carrier of the reference the latter would be available for drawing hogs from the pen to the hoisting-point in the manner described by appellant. (C. A. D. C. Apr. 4, 1899.)

SHEPARD, J.] *Lowry *v.* Duell, Com'r of Patents, 88 O. G. 717.

9. An accidental result not contemplated by a prior inventor cannot anticipate a later patent. (C. C., D. Mass. Apr. 7, 1899.)

COLT, J.] *Tannage Patent Co. *v.* Donallan, 93 Fed. Rep. 811.

10. A patent for an ordinary street-car trolley with an ordinary buffer spring so constructed as to come into operation when the trolley has assumed a vertical position, and by engaging therewith prevent damage being done to the trolley, or by the trolley to the car upon which it is placed, *Held*, anticipated by the common device for throwing glass target-balls wherein a buffer spring is used for a similar purpose, *i. e.*, to prevent damage to the projector or its mechanism. (C. C., D. N. J. July 7, 1899.)

KIRKPATRICK, J.] *Thomson-Houston Electric Co. *v.* Rahway Electric Light & Power Co., 95 Fed. Rep. 660.

11. It is not sufficient to constitute anticipation, that the device relied on might, by modification, be made to accomplish the functions performed by the invention alleged to be anticipated, if it were not designed by its maker, nor adapted, nor actually used for the performance of such functions; neither will mere accidental use of the features of an invention, without recognition of its benefits, anticipate a patent. (C. C., D. N. J.)

KIRKPATRICK, J.] *Ryan *v.* Newark Spring Mattress Co., 96 Fed. Rep. 100.

12. The mere secret practice of a process or the physical presence of a product or manufacture in this country is insufficient as an anticipation, unless and until the public acquires, or has an opportunity to acquire, therefrom such knowledge as would enable one skilled in the art to practice the invention. Such alleged anticipation, whether by foreign printed publication or physical presence in this country, must so embody the patented article, that a specification could be based thereon. (C. C., S. D. N. Y. July 29, 1899.)

TOWNSEND, J.] *Acme Flexible Clasp Co. *v.* Cary Mfg. Co., 96 Fed. Rep. 344.

13. By knowledge and use, the legislature meant knowledge and use accessible to the public. The knowledge and use of an invention in a foreign country by persons residing in this country will not defeat a patent which has here been granted to a *bona fide* patentee, who, at the time, was ignorant of the existence of the invention or its use abroad. It is the inventor who is the first to confer on the public in this country the benefit of his invention, who is entitled to a patent. **Id.*

III. PRIOR USE.

1. Experiments producing unsatisfactory results, and abandoned in consequence, cannot be held to establish a prior use which would close the door to further invention by which a commercially valuable and useful product can be placed upon the market. (C. C., D. N. J. July 14, 1899.)

KIRKPATRICK, J.] *Westinghouse Electric & Mfg. Co. *v.* Beacon Lamp Co. *et al.*, 95 Fed. Rep. 462.

2. The application for the patent in suit was filed on Dec. 22, 1883. Articles differing in degree only from those covered by the patent were imported and sold in May, 1883, seven months prior to the date of the application, but subsequent to the invention and commercial introduction of the articles in England. *Held*, that the patentee should be permitted to carry the date of his invention back to what was done by him in England prior to his arrival in this country, in order to overcome the defense of prior use. (C. C., S. D. N. Y. Aug. 4, 1899.)

TOWNSEND, J.] *Hanifen *v.* Price *et al.*, 96 Fed. Rep. 435.

3. In interference cases a foreign inventor can only carry back the date of his invention in a foreign country by a patent or a publication, or, in this country, by the date of the arrival in this country of knowledge of said invention. But there is a distinction between the provisions of § 4923 R. S., which provides for the protection of the patentee against proof of prior knowledge or use of his invention, without publication, in a foreign country, and the general grant by § 4886 R. S., of the right to a patent to any person who has made an invention not known or used by others in this country, and nowhere patented or described in any printed publication. The natural interpretation of the language of § 4886 indicates an intention to confer the benefit of the patent law upon any individual who could show a prior completed inventive conception, regardless of the place where the invention was conceived. **Id.*

IV. PUBLIC USE OR SALE.

1. The fairly constant use of a bicycle rim made of wood, for a period of four or five years, though at a time when the demand for bicycles, and the bicycle art as well, were in the formative stage, yet in a locality which was probably the most important manufacturing center for bicycles at that stage of the art, was manifestly a "public use," within the meaning of the patent law, such as to render a later production of identical means non-patentable, without regard to actual knowledge of such prior discovery and use. (C. C., E. D. Wis. Nov. 27, 1898.)

SEAMAN, J.] *Indiana Novelty Mfg. Co. *v.* Crocker Chair Co.; Same *v.* Smith Mfg. Co., 90 Fed. Rep. 488.

2. It is the fact of use given to and received by the community at large, in contradistinction to shop experiments, or mere occasional exhibitions, or use by the inventor alone, which must control; and it is not to be measured by degrees or territorial extent, nor made dependent upon any probability of fact that knowledge of such use should have reached the later claimant. *Id.*

3. So far as concerns the question of anticipation, it is immaterial whether a patentee knew, or did not knew of the anticipating machine, at the time he claims to have invented the machine covered by his patent. The court, in passing upon his device, is bound to assume that he had the anticipating machine before him. (C. C., S. D. Cal. Jan. 30, 1899.

WELLBORN, J]. *Lettelier *v.* Mann *et al.*, 91 Fed. Rep. 909.

4. Where a machine is used for profit, not experiment, and particularly where it is exposed to the view of persons other than the inventor and his employés pledged or enjoined to secrecy, such use is public use, and in order to invalidate a patent, such use must be established by proof that is clear and convincing. (C. C., S. D. Cal. Jan. 30, 1899.)

WELLBORN, J.] *Lettelier *v.* Mann *et al.*, 91 Fed. Rep. 917.

5. Where it is shown that the patentee and his partner used in their business a number of machines essentially the same as the one patented for more than two years prior to the application for the patent, such use being for the common profit of the firm, and that the employés of the firm not enjoined to secrecy, as well as the patentee's partner, saw the machines in operation, such proof will invalidate the patent; for to constitute public use it is not necessary that more than one person should have known of that use. *Id.*

6. Improvements in a machine which are not of the substance of the patent and do not add anything patentable to the machine, do not save the patent from the invalidating effect of a prior public use. *Id.*

7. "Whenever," under R. S. § 4923, "it appears that a patentee, at the time of his application for a patent, believed himself to be the original and first inventor or discoverer of the thing patented," a prior use in a foreign country will not defeat

the patent. The law limits the inquiry as to prior use to this country. (C. C., S. D. N. Y. May 8, 1899.)

COXE, J.] *Badische Analin & Soda Fabrik *v.* Kalle *et al.*, 94 Fed. Rep. 163.

Appeal. (See INTERFERENCES, APPEAL.)

I. FROM PRIMARY EXAMINER TO COMMISSIONER.

II. TO THE BOARD OF EXAMINERS-IN-CHIEF.

III. FROM THE COMMISSIONER TO THE COURT OF APPEALS, D. C.

IV. RETURN OF APPEAL FEES.

V. TO THE CIRCUIT COURT OF APPEALS.

I. FROM EXAMINER TO THE COMMISSIONER.

1. Upon the requirement of an Examiner that an applicant present, in addition to his own affidavits, affidavits of third parties, *Held*, that the question raised is reviewable by petition to the Commissioner. (Oct. 27, 1899.)

DUELL, C.] *Ex parte* Johnson, 89 O. G. 1341.

2. *Held*, further, that such requirement is unauthorized, as Rule 75 does not provide in terms for corroborative affidavits. If, however, the Examiner believes that an applicant's affidavit is fraudulent and so charges, the applicant should be given leave to file corroborative affidavits. (*Ex parte* Hurlbut, 52 O. G. 1062, cited.) *Id.*

3. From an Examiner's requirement that the original model, structure or drawing, referred to in an affidavit filed under the provisions of Rule 75, be produced, petition may be taken to the Commissioner. *Id.*

II. TO THE BOARD OF EXAMINERS-IN-CHIEF.

1. The failure of an examiner to carry into effect a decision by the Commissioner, is a proper matter to be brought up on petition; but the application of the rulings of a decision rendered in one case to the facts of another case for the purpose of determining whether or not the claims of that case are allowable, requires a judicial determination, and is clearly a matter of merits which should be reviewed by the examiners-in-chief in the first instance. (Sept. 27, 1899.)

GREELEY, A. C.] *Ex parte* Ryley, 67 MS. Dec. 495.

2. So long as the decision was not rendered in the case under consideration, it is immaterial that it was rendered in another case filed by the same party, since it could give no more force than if it were rendered in a case filed by some other party. Examiners are expected to follow the decisions of the Commissioner although rendered in other cases, but where the action of the examiner indicates no hesitation to give full force and effect to a decision of the Commissioner, but holds that it is not applicable to the case in hand, a question of merits is involved which is appealable to the board of examiners-in-chief. *Id.*

3. Division was required by the examiner and acquiesed in by the applicant, who filed divisional applications, one of which was allowed. The examiner rejected a claim of the other application in view of certain claims in the allowed application taken in connection with other references. Whereupon petition was taken and it was requested that the examiner be instructed in effect to allow the application. *Held*, that the question presented was one of merits which should not be passed upon by the Commissioner prior to an adverse decision by the examiners-in-chief; to hold otherwise would be to deprive the petitioners in case of an adverse decision on the question of patentability, of the right of appeal to the Court of Appeals of the District of Columbia. (Sept. 27, 1899.)

DUELL, C.] *Ex parte* Lawton *et al.*, 67 MS. Dec. 492.

4. The examiner held that an application covers separate and independent inventions which should not be claimed in one case and preparatory to requiring division rejected certain claims on the ground of aggregation. Certain patents were cited as showing the state of the art, without specifically applying them to all of the claims or attempting to give a full and complete action upon the merits of the claims. Appeal was taken from the action of the examiner in finally rejecting the claims for aggregation. In his answer to the appeal, the examiner applied the references cited to the appealed claims and held that they are anticipated aside from the question of aggregation. *Held*, that the question of anticipation was not brought up by the appeal and should not have been discussed by the examiner, since the sole question is as to whether or not the claims cover aggregations, and that is the only question which

can be decided by the examiners-in-chief upon the appeal. (Nov. 11, 1899.)

GREELEY, A. C.] *Ex parte* Carleton, 68 MS. Dec. 189.

4. When claims are rejected on the applicant's prior patent, a review of the facts in the case to determine the correctness of that action must be had in the first instance on appeal to the examiners-in-chief, and not on petition. (Nov. 8, 1898.)

GREELEY, A. C.] *Ex parte* Wellman, 86 O. G. 1986.

5. Where petition was taken from an action of the examiner on the ground that a single reference had not been cited showing in combination all of the features covered by the claims, but several references were cited said to show substantially the several features, and the claim was rejected on the ground that no invention was involved in bringing those features together in one device, *Held*, that this is a question of merits which is appealable to the examiners-in-chief and cannot properly be brought up on petition. (June 1, 1899.)

GREELEY, A. C.] *Ex parte* Perkins, 88 O. G. 548.

6. When objections to the sufficiency of an affidavit to overcome a rejection based upon a prior patent are raised by the examiner, the question presented goes to the merits, and an appeal lies in the first instance to the examiners-in-chief. (*Ex parte* Boyer, 49 O. G. 1985, cited.) (Oct. 27, 1899.)

DUELL, C.] *Ex parte* Johnson, 89 O. G. 1341.

III. FROM THE COMMISSIONER TO THE COURT OF APPEALS, D. C.

1. Where the decision of the Commissioner of Patents appealed from to the Court of Appeals of the District of Columbia was dated December 10, 1898, but entry was not made on the file-wrapper until December 12, 1898, when the notice of the decision was sent to appellant, and appeal was taken to the court on January 20, 1899, *Held*, that the appeal was taken too late under Rule XX. of the court, which requires an appeal to be taken within forty days from the date of the decision of the Commissioner, and not afterward. (C. A. D. C. Apr. 4, 1899.)

ALVEY, J.] *Burton *v.* Bentley, 87 O. G. 2326.

2. The rule limiting the time of appeal from the decision of

the Commissioner to the court has no reference to the notice of the decision given to appellant. It is from the date of the decision that the time for taking the appeal must be reckoned, and not from the time of sending notice of the decision to the party against whom it is made. *Id.*

3. The terms of the rule must be allowed their ordinary meaning and import, and they plainly limit the commencement of the period of forty days within which an appeal can be taken from the date of the decision appealed from, excluding the day of the date. (Bemis *v.* Leonard, 116 Mass. 502, and Sheets *v.* Selden, 2 Wall. 189, cited.) *Id.*

4. Where it is not pretended that appellant has been surprised or in any manner prejudiced by computing the time of taking the appeal, as he has had ample time within which to appeal, and as he has thought proper to delay the appeal until after the time for taking it had elapsed, *Held*, that he has no one to blame but himself, and the appeal must be dismissed. *Id.*

IV. RETURN OF APPEAL FEES.

In all cases in which additional references or reasons for rejection are given prior to the actual hearing and decision of the appeal, the applicant is permitted to withdraw his appeal and to have his appeal fee returned; but where the appellate tribunal affirmed the decision of the examiner on the record, calling attention to additional references, not for the purpose of giving ground for rejection where none existed before, but merely for strengthening the position taken by the examiner, the appeal fee should not be returned. (Oct. 24, 1899.)

GREELEY, A. C.] *Ex parte* Carr, 68 MS. Dec. 77.

V. TO THE CIRCUIT COURT OF APPEALS.

1. An exception upon the sole ground that a question, allowed by the trial judge to be answered, is leading, is never tenable, for the ruling upon such a question is discretionary with the trial judge. (C. C. A., 2d Cir. Dec. 7, 1898.)

WALLACE, J.] * Ross *v.* Raphael Tuck & Sons Co., 91 Fed. Rep. 128.

2. Whether the several observations of the trial judge, when giving his exposition of the meaning of a statute, were correct

or not need not be considered on appeal, and if the ultimate ruling is right, it is quite immaterial whether or not it was reached upon a correct process of reasoning. *Id.*

3. When all of the steps necessary to perfect an appeal to an appellate court have been properly taken, the action is within the control of that court, and a trial court should not engage in undoing or modifying the proceedings by which such jurisdiction has been obtained, and a motion for leave to substitute an appeal bond should be addressed to that court. (C. C., E. D. N. Y. Jan. 28, 1899.)

THOMAS, J.] *Morrin *v.* Lawler, 91 Fed. Rep. 693.

4. It is the allowance of the appeal by the trial court, and not the perfecting of all the steps necessary to a hearing of the appeal in the court above, which saves the appellant or plaintiff in error from the bar of the statutory period fixed for the bringing of appeals and writs of error. Neither the issuing of the citation nor the giving of bond is jurisdictional. (C. C. A., 6th Cir. Mar. 28, 1899.)

PER CURIAM.] *Noonan *v.* Chester Park Athletic Club Co., 93 Fed. Rep. 576.

5. Where there is an issue of fact in the circuit court, and a jury is waived, and the cause is submitted to the court, as permitted in §§ 649 and 700 Rev. St., there is nothing to review in the appellate court, except (1) rulings of the court in the progress of the trial, if excepted to at the time and duly presented by a bill of exceptions, and (2) when the finding is special, the review may extend to the determination of the sufficiency of the facts found to support the judgment. (C. C. A., 5th Cir. Apr. 11, 1899.)

PARDEE, J.] *Sarrazin *v.* W. R. Irby Cigar & Tobacco Co., Lim., 93 Fed. Rep. 624.

Applications.

I. ABANDONED.

(*a*) *In General.*

(*b*) *Revival of.*

II. AFFIDAVITS. *To Obtain Interferences.*

III. Amendments.

(*a*) *In General.*
(*b*) *Election and Division.*
(*c*) *After Final Rejection.*
(*d*) *New Matter.*
(*e*) *After Allowance under Rule 78.*

IV. Attorneys.

(*a*) *Powers of.*
(*b*) *Use of Assignment Records.*
(*c*) *Disbarred.*

V. Claims.

(*a*) *Duplicate or Redundant.*
(*b*) *Functional or Indefinite.*
(*c*) *Two Inventions in One Claim.*
(*d*) *Order in Relation to Punctuation.*

VI. Complete.

Order in Relation to.

VII. Division of.

(*a*) *Classification in the Patent Office.*
(*b*) *Practice.*
(*c*) *Process and Apparatus.*
(*d*) *Process and Product.*
(*e*) *Different Processes.*
(*f*) *Status of Invention in the Arts.*

VIII. Drawings.

(*a*) *In General.*
(*b*) *Order in Relation to.*

IX. Examination of.

(*a*) *Information and Advice to Applicants.*
(*b*) *Rejection.*
(*c*) *Actions Other than Rejection.*

X. Fees.

Order.

XI. Forfeited.

Renewal of.

XII. Model.

I. ABANDONED.

(*a*) *In General.*

1. After a decision of the examiner-in-chief affirming the decision of the primary examiner rejecting claims of an application on the ground of aggregation, the applicant requested the examiner to cite references referred to in a general way by the examiners-in-chief in their decision, which request was refused, and the statement made that applicant's remedy was by appeal to the Commissioner on the merits or petition to re-open. More than two years after the decision the petition was filed. *Held*, that the case did not come under Rule 66, even if the examiner had authority to re-open, since it does not appear that he did not cite the best references at his command, and that the application is abandoned. (Feb. 2, 1899.)

GREELEY, A. C.] *Ex parte* Merrell, 66 MS. Dec. 244.

2. Where an amendment, presented in supposed compliance with the decisions and recommendations on appeal, but was not a complete and definite compliance with such decisions and

recommendations, in that it failed to direct the cancellation of the rejected claims, though the amendment was presented in good faith, and such failure to cancel the claims was due to oversight. *Held*, sufficient to save the case from abandonment, and provided an amendment be promptly filed directing the cancellation of the rejected claims, the Examiner is directed to enter it and re-open the case for the consideration of the previous amendment. (June 7, 1899.)

GREELEY, A. C.] *Ex parte* Herzog, 67 MS. Dec. 151.

3. Where it was shown that an amendment had been mailed in ample time to reach the office before the expiration of the two years, but owing to the blizzard of February, 1899, the trains were delayed, and the amendment did not reach the city in time to be delivered until the day after, *Held* to be sufficient to save the case from abandonment. The fact that in other cases "this applicant is in the habit of taking the full statutory period in prosecuting his cases," thereby unnecessarily prolonging the pendency of his applications, urged by the examiner as a reason why the rule should be enforced with more than usual stringency against him, is not a sufficient ground for making an exception unfavorable to applicant. (June 5, 1899.)

GREELEY, A. C.] *Ex parte* Herzog, 67 MS. Dec. 147.

4. On July 7, 1899, an applicant made an amendment to the specification, which the examiner held was not a compliance with the requirements of the office letter of July 9, 1898, in which all of the claims had been rejected and a new reference cited, and on July 11, 1899, held that the application was abandoned by failure to prosecute within one year from July 9, 1898; *Held*, that since the action of July 9, 1898, was not a final rejection, applicant was entitled to a reconsideration either with or without amendment, and the amendment of July 7, 1899, was virtually a request for a reconsideration of all matters not covered by the amendment, and therefore the question as to whether or not the amendment was a compliance with the requirement before made was immaterial, and it was not necessary for applicant to amend to keep the case alive. The case is not abandoned, and applicant is entitled to an action on the merits. (Aug. 17, 1899.)

GREELEY, A. C.] *Ex parte* Carroll, 67 MS. Dec. 374.

5. An application was filed May 18, 1899, and acted on by the Office July 2, 1897. The attorney in the case was disbarred from practice Oct. 1, 1897, and a new attorney was appointed Nov. 13, 1897. No further action was taken in the case until July 24, 1899, and the examiner properly held the case to be abandoned. The disbarment of the attorney did not change the condition of the case itself in any respect or the kind of action required, but merely changed the person who would be permitted to take that action, and while such disbarment might be advanced as an excuse for part of the delay in acting on the case under a request to revive under rule 172, yet it could not be considered under a petition from the action of the examiner holding the case abandoned. (Oct. 24, 1899.)

GREELEY, A. C.] *Ex parte* Larson, 68 MS. Dec. 79.

6. On March 2, 1897, the examiner rejected a series of claims in an application which had been filed some eight years before. On July 23, 1897, the applicant presented an argument in regard to the examiner's position, but did not amend the claims. On July 29, 1897, the examiner finally rejected the claims referred to. On July 29, 1899, the applicant filed another argument, which the examiner held was not such an action as the condition of the case required at that time, and that therefore the case was abandoned because of applicant's failure to take proper action, namely, appeal, within two years from the date of the last office action. *Held*, that the examiner's action was correct and that the case is abandoned. (Nov. 3, 1899.)

GREELEY, A. C.] *Ex parte* Hunter, 68 MS. Dec. 111.

7. A mistake by an examiner in rejecting claims is no valid excuse for an applicant's failure to take proper action within two years. The statutes and rules clearly indicate that an appeal is the proper remedy when an applicant thinks an examiner has improperly rejected his claims, and they specifically provide that such appeal must be taken within a specified time, irrespective of the question whether or not the rejection was in fact proper. *Id.*

8. If an amendment and proceedings relative thereto, as provided in rule 68, will not save a case from abandonment, it is clear that a mere argument unaccompanied by an amendment

will not save it, and is not such action as the condition of the case requires. *Id.*

9. The contention that an application "was prosecuted within the two years' limit by the preparation and forwarding on August 22, 1899 of the amendment and argument, the same being deposited in the mail in proper season to have been delivered in the Patent Office in one day * * *" and was therefore "such action on the part of applicants" as to constitute a "legitimate prosecution of the case within the statutory limit," cannot be granted since the Office cannot recognize anything as an action until it is actually received. The mere preparation of the amendment within the time is not sufficient, since that does not change the condition of the case in any respect until it is filed. *Held*, therefore, that as the statutory period expired on August 23, 1899, and the amendment not having been received until August 24, 1899, the application is abandoned. (Nov. 10, 1899.)

GREELEY, A. C.] *Ex parte* Hall and Hall, 68 MS. Dec. 140.

10. By analogy to the rule prohibiting one of two joint applicants from abandoning an application by an instrument in writing without the consent of the other applicant and any assignees, *Held*, that one of two joint applicants should not be permitted to indirectly abandon a case by refusal to join in its prosecution. (Dec. 1, 1899.)

GREELEY, A. C.] *Ex parte* Franklin and Tonnar, 68 MS. Dec. 235.

11. The mere appointment of an attorney is not such an action as will save a case from abandonment, since it is not within the meaning of the rule, but is merely a power to some other person to act. *Id.*

12. The record shows that after various actions the claims were rejected on references on Nov. 9, 1895. On May 5, 1896, applicant requested "re-examination of claim 24," without referring to other rejected claims, and on May 9, 1896, the examiner finally rejected claim 24 and other claims on the reasons and references before cited. On Apr. 4, 1898, nearly two years later, applicant filed an amendment canceling all the claims and substituting 24 new claims, but failed to make any showing or

even a statement as to why the amendment was not earlier presented. *Held*, that the case became abandoned on May 9, 1898. (Apr. 29, 1899.)

GREELEY, A. C.] *Ex parte* Stebbins, 88 O. G. 1335.

13. The office action of Jan. 19, 1897, and those prior thereto, contain rejections of claims on references and a formal requirement of division. On Dec. 29, 1898, affidavits were filed under rule 75 to overcome certain of the references, and the examiner refused to consider the same on the ground that they were not completely responsive to the requirement of division, and in support of his action cites *ex parte* Rappleye, 85 O. G. 2096; and further, on Jan. 23, 1899, the examiner held that the case became abandoned on Jan. 13, 1899. *Held*, that the filing of the affidavits, while not completely responsive to every requirement, yet it was responsive to the action rejecting the claims, and was such as the condition of the case required, and therefore saved it from abandonment, since it was apparently made in good faith. (Apr. 29, 1899.)

GREELEY, A. C.] *Ex parte* Wright & Stebbins, 88 O. G. 1161.

14. Action by an applicant made in good faith, which is such action as the condition of the case requires, is sufficient to save the case from abandonment, although it is not completely responsive to every requirement made. *Id.*

15. It cannot be properly held that an application has no standing before the Office because the inventor is dead and the executor has not asserted his rights. The legal representatives of the deceased have the right to prosecute the application, and the mere fact that they are not known to the Office and that they have not actually prosecuted the case by any action on their part cannot be considered an abandonment of the application until the expiration of the two years allowed by law for amendments. (Decker *v.* Loosley, 77 O. G. 3140. Refrigerating Co. *v.* Featherstone, 62 O. G. 741.) (July 3, 1899.)

DUELL, C.] Handley *v.* Bradley, 89 O. G. 522.

16. Although an applicant's death may be legally established, his application is a legal pending application and an interference cannot be dissolved upon the ground that his application has no standing in the Office. *Id.*

I. ABANDONED.

(*b*) *Revival of.*

1. Where at the time of filing the application, the applicant had entered into a partnership for developing the invention and all his means were in said business, which failed while the application was pending, and was sold out by the sheriff, *Held*, that the failure to prosecute was sufficiently excused, and being unable to file a new application because of more than two years' public use and because of the granting of a foreign patent, the petition for revival was granted. (Mar. 23, 1899.)

DUELL, C.] *Ex parte* Seyfang, 66 MS. Dec. 407.

2. Where an applicant arranged with his licensee to attend to the prosecution of the application, to keep applicant posted as to the progress of the case, to confer with the attorneys and to direct them as to the prosecution of the application, the licensee occupied the place of the applicant and the attorneys were powerless in the case except by express direction of the licensee, and if by inaction on his part or by any miscarriage of the arrangements, failure to take action in order to avoid abandonment ensued, the applicant was alone to blame, and his petition to revive denied. (Aug. 28, 1899.)

GREELEY, A. C.] *Ex parte* Noyes, 67 MS. Dec. 409.

3. A communication had been filed within the two years allowed for action, but by reason of the fact that it did not correctly identify the application intended or any application on file, it was not entered and was returned. Two days after the two years had expired an amendment had been filed properly identifying the case, but was properly refused admission on the ground that the case was abandoned. The facts of the case, however, show that there was an attempt to act on the case within the two years, and the failure to do so was due to inadvertence or mistake, and the circumstances warrant a revival of the application under the provisions of rule 172. (Sept. 27, 1899.)

GREELEY, A. C.] *Ex parte* Shaw, 67 MS. Dec. 497.

4. Where the claims of an application were rejected July 20, 1899, and an amendment filed July 20, 1899, containing an additional claim which was held not to be responsive to the last

Office action, and the case was therefore declared to be abandoned; later applicant was notified that his proper remedy was by petition to revive under rule 172. *Held*, that the excuse for delay being that when the case was taken up for amendment the Office letter could not be found and it was too late to procure a copy, and further, applicant was engaged in some experimental work which progressed slowly from lack of funds, the application could be revived and applicant given leave to file a responsive amendment, to be examined on its merits. (Oct. 6, 1899.)

DUELL, C.] *Ex parte* Penner, 68 MS. Dec. 28.

5. The reason for not acting sooner is set forth as follows: "Pecuniary reasons, however, prevented our pushing the prosecution of the case to such extent as we desired, and we have been unable to devote money to this work owing to prolonged business depression, resulting in bankruptcy proceedings, which are still pending."

It is not definitely stated that applicants were unable to take action in the case at any time within the two years prescribed by the statute, and even if the above-quoted statement is construed as meaning that they were unable to take such action during the business depression, there is nothing to show that the depression extended over the entire period of two years. No particulars are given, and the mere fact that there was a business depression does not show that action could not have been taken as well within the two years as one day after that time had expired. (Nov. 10, 1899.)

GREELEY, A. C.] *Ex parte* Hall & Hall, 68 MS. Dec. 140.

6. Where a statement is intended to convey the impression that a device has been in public use for more than two years and that as a consequence a new application cannot be filed, it must contain something more than a mere inference from vague and indefinite statements to establish the fact that hardship would be worked by refusing to revive the case. *Id.*

7. Where it was shown that A and B are joint applicants; that A refused to join in the prosecution of the application and it was impossible for B to take action until the Office recognized his right to do so without the acquiescence of A; that B appointed his attorneys within the two years allowed by law, but

neither he nor his attorneys could take action in that time in view of the refusal of the Office to recognize his right to prosecute the case alone, *Held*, that in so far as B is concerned the delay was unavoidable, and therefore the case is revived under rule 172. (Dec. 1, 1899.)

GREELEY, A. C.] *Ex parte* Franklin and Tonnar, 68 MS. Dec. 235.

II. AFFIDAVITS.

To Obtain Interference.

1. Where two applications were pending at the same time and one went to patent having claims that the other did not contain, which claims were subsequently inserted in the application remaining in the Office, and an interference was demanded with the patent, upon petition from the examiner requiring that an affidavit should be filed under rule 94 (2) before the interference would be declared, *Held*, that in view of rule 96, which requires an examiner to notify one party of the claims made by the other, the patent was inadvertently allowed, and the applicant should not be prejudiced by the fact that the examiner overlooked or ignored rule 96. (Nov. 24, 1899.)

DUELL, C.] *Ex parte* Tizley, 89 O. G. 2259.

2. *Held*, further, that had the examiner observed the rule he would not have required an affidavit under rule 94 (2), but would have declared the interference under section 1 of that rule. In such a case as this the second section of the rule does not apply, and the interference should be declared and the rights of the parties determined on the same ground as if both were applicants. *Id.*

III. AMENDMENTS.

(a) In General.

1. Courts, in passing upon a patent which has been granted and which is not open to amendment like an application, overlook many formal defects, in order that the grant may not fail entirely, which they would not sanction if it were possible to correct them by amendment; but so long as an application is pending and is open to amendment the same reason for overlooking formal defects does not exist, and it is the recognized

duty of the Office to see to it that the statutory requirement that applicants clearly and properly set forth their inventions, both in the specification and claims, so that there will be no uncertainty as to what is included, is complied with. (Apr. 10, 1899.)

GREELEY, A. C.] *Ex parte* Averell, 66 MS. Dec. 442.

2. The insertion by amendment in an original application of the term "preferably" in describing the structure of certain features should be permitted and cannot properly be objected to as involving a departure from the original disclosure. (Jan. 6, 1899.)

GREELEY, A. C.] *Ex parte* Hollis, 86 O. G. 489.

3. So long as an application is pending before this Office the applicant may be permitted to amend in the direction of broadening the statement of his invention, provided he does not change the invention on which that statement is based, and if his specification and claims as filed do not adequately express the full breadth of his invention he may amend in such way as to secure full protection. *Id.*

III. AMENDMENT.

(*b*) *Election and Division.*

When the primary examiner required a division, holding that the claims covered two independent inventions, and applicant complied by erasing the claims as to one invention, *Held*, that having his election as to which invention he would claim, applicant is estopped from recalling it, the claims remaining in the case now being under rejection. (Aug. 28, 1899.)

GREELEY, A. C.] *Ex parte* Clausen, 88 O. G. 2242.

III. AMENDMENT.

(*c*) *After Final Rejection.*

1. Where after final rejection claims are submitted which not only change the form of expression, but also change the scope of the claims, they cannot properly be entered on the ground that they place the claims already in the case in better form for appeal, since they are not the same in substance but are new claims requiring a new examination to determine their patentability. (Nov. 11, 1899.)

GREELEY, A. C.] *Ex parte* Waring, 68 MS. Dec. 170.

2. A statement that applicant thought the claims would be allowed as they stood upon reconsideration and that amendment was unnecessary, is not a verified showing as contemplated by rule 68, and is alone clearly no good reason upon which to reopen a case after final rejection, since such a statement could be made in every case in which the claims are finally rejected, and it would thus be impossible to bring the prosecution of any case to a conclusion except at the will of the applicant. *Id.*

3. Rule 68, prohibiting the entry of amendments touching the merits after a case is in condition for appeal except upon a proper showing, unless the case is in fact in condition for appeal and the consideration before the primary examiner has been properly closed, presupposes that the final action by the examiner was proper and in order; for otherwise the alleged final action has no force or validity and does not in fact place the case in condition for appeal, notwithstanding the allegation to that effect in the action itself. *Id.*

III. AMENDMENT.

(*d*) *New matter.*

1. After the termination of public use proceedings, an amendment to the application was presented, which the examiner refused to enter on the ground of new matter. In the application the applicant stated that one of the steps in his process was one "commonly used," and in the amendment he stated that this step was not old, and was a part of his present invention. This, under the circumstances, was a departure from the original invention, and could not be claimed in the present application, but only in a separate application as provided in rule 70. (July 27, 1899.)

GREELEY, A. C.] *Ex parte* France, 67 MS. Dec. 324.

2. The question whether or not matter sought to be introduced into a pending application is to be refused as new matter is quite a different question from the question whether or not such matter may be introduced in a re-issue application. (Jan. 6, 1899.)

GREELEY, A. C.] *Ex parte* Hollis, 86 O. G. 489.

3. When a patent has issued, the specification and claims are

no longer open, as a matter of course, to the same amendments which could have been made before issue, since the applicant for re-issue must show not only that the amendment is necessary to the protection of his rights, but also satisfactory reasons why it was not made before the issuance of the patent. *Id.*

III. AMENDMENTS.

(*d*) *After allowance under Rule 78.*

1. Where a claim was offered in an allowed application which the examiner stated to be patentable over the art, but the admission of which he refused to recommend under Rule 78, *Held*, that this is clearly a case where the amendment should be permitted, for Rule 78 was amended to meet just such cases. (Oct. 4, 1899.)

DUELL, C.] *Ex parte* O'Connor, 89 O. G. 1141.

2. *Held*, further, that had the examiner recommended that the amendment be admitted without withdrawing the case from issue, justice would have been done to the applicant, his attorney would have been saved the labor of preparing a brief, while the examiner and the clerical force of the Office would have been spared much unnecessary labor. *Id.*

ORDER.

Hereafter all amendments proposed to allowed applications, and all petitions and requests relating thereto, shall be filed with the docket clerk, and transmitted by him to the primary examiner for report. If the examiner shall report favorably to the admission of such amendment, the matter will be laid before the Commissioner for immediate determination. If the examiner shall report unfavorably, the case will be docketed, and will be heard and decided by the Commissioner in regular course, unless good reasons shall appear for immediate action.

IV. ATTORNEYS.

(*a*) *Powers of.*

1. Where a company had entered into an agreement with an applicant, respecting the subject matter of his application, but there was no assignment of record, and the application even was not on file at the time of entering into such agreement, the protest of said company against the revocation of the power of

attorney by the applicant, cannot receive favorable consideration. (Aug. 25, 1899.)

GREELEY, A. C.] *Ex parte* Swan, 67 MS. Dec. 398.

2. In order for such a protest to receive favorable consideration it must appear of record that the company are assignees of an entire interest in the application of record as provided by rule 20, but in view of the showing made the company should be allowed access to the files of this application, and this through an attorney of their own selection; and also, when requested, to have copies, at usual rates of all actions, either by the Office or by the applicant, during the progress of the case. *Id.*

3. An attorney appointed by alleged assignees will not be recognized in the prosecution of an application unless an assignment clearly identifies that particular application, so that there can be no doubt that it is the one referred to. The Office requires certainty and not mere probability in such matters. (Aug. 18, 1899.)

GREELEY, A. C.] *Ex parte* Williamson, 88 O. G. 2065.

4. An applicant is bound by the acts of his attorney, whether made by the principal attorney or by his associate of record. (Aug. 28, 1899.)

GREELEY, A. C.] *Ex parte* Clausen, 88 O. G. 2242.

5. Where it appeared that an applicant had entered into an agreement with a company to assign all the inventions pertaining to the subject-matter of his application, but had not actually made such an assignment, *Held*, that the Office should not interfere to prevent the revocation of the power of attorney given by applicant. (*Ex parte* Gallatin, 59 O. G. 1104, cited.) (May 29, 1899.)

DUELL, C.] *In re* McPhail, 89 O. G. 521.

6. *Held*, further, that even if the agreement between the company and the applicant should be considered as an assignment, the Office should not recognize the right of the company to appoint an attorney to prosecute the case, as the application is not identified in the agreement. (*Ex parte* Chillingsworth, 80 O. G. 1892, cited.) *Id.*

7. It is the practice of the Office to refrain from settling the private rights of an applicant and an alleged assignee in such

matters as that raised by this petition, as they are properly determined by a court of equity. *Id.*

IV. ATTORNEYS.

(*b*) *Use of Assignment Records.*

It has been brought to my attention that certain attorneys and other persons had made use of the assignment records to obtain the addresses of persons having applications pending before this office, in order to send them letters and circulars offering to secure foreign patents or to transact other business which it may be presumed the attorneys of record in such applications are competent and willing to do. Such use of the assignment records is not a proper or legitimate use. These records are not open to the public for any such purpose.

It is hereby ordered that any attorney or other person who is known to make such use of the assignment records of this Office will be denied access thereto. C. H. DUELL, Commissioner.

IV. ATTORNEYS.

(*c*) *Disbarred.*

Order.

It is hereby directed that any person who has been disbarred from practice before the Patent Office by order of the Commissioner be denied access to the files of the Office, either in his own capacity or as the representative of any other person or firm.

86 O. G. 1.

V. CLAIMS.

(*a*) *Duplicate or Redundant.*

1. A fair amount of tautology and reiteration in the claims may be prudent and permissible, and the general rule that claims should be patentably different from each other should not always be insisted upon, particularly in cases where it is found difficult to express in language the invention intended to be covered in its full breadth. But the multiplication of claims, particularly where the invention is simple and readily understood, should not be permitted to be carried to such an extent as to obscure rather than make clear what invention or discovery is intended to be particularly pointed out and distinctly claimed. (Apr. 10, 1899.)

GREELEY, A. C.] *Ex parte* Averell, 66 MS. Dec. 442.

2. The fact that all of the claims "call for the same substantive improvement," does not prevent the applicant from claiming specifically what he has claimed broadly; while the differences may be slight, yet the applicant is entitled to full protection for his invention, and the Office is not disposed to unnecessarily limit him in presenting claims defining it. (July 26, 1899.)

GREELEY, A. C.] *Ex parte* Perlinsky, 67 MS. Dec. 314.

3. Where one of the claims defined a method of treating ores without reference to the employment of any particular kind of furnace, and the other claim limited its employment in an ordinary blast furnace, a clear distinction in the claims is apparent and they are not identical in scope. (Aug. 4, 1899.)

GREELEY, A. C.] *Ex parte* Ellershausen, 67 MS. Dec. 343.

4. Where the examiner held that the claims of an application were needlessly multiplied and refused to act further in the case until this objection was removed, without citing references or in any manner indicating whether or not the claims were regarded as covering patentable subject-matter, *Held*, that these actions are not in accord with rule 64 and the present practice of the Office, which require that the examiner shall act fully and completely on a case, and set forth fully and clearly the reasons for his action. (Dec. 1, 1899.)

GREELEY, A. C.] *Ex parte* Kokernot, 68 MS. Dec. 240.

5. The examiner has no authority to determine which claims are to be canceled where several claims are duplicates, but he should state specifically which claims he regards as duplicates and why he so regards them. The applicant is entitled to be informed on these questions so that he may intelligently argue the matter or determine for himself which of the alleged duplicate claims he will cancel. He is entitled to an action on the merits of the claims, under the provisions of rule 64, before the formal objections are insisted upon. *Id.*

V. CLAIMS.

(*b*) *Functional and Indefinite.*

1. Where claims contain no statement as to the structure of a device, and depend entirely for an indication of that structure

upon the statement of the function to be performed, and cover any and every device for effecting such function, and contain no qualifying words setting forth the function or capacity of the device, *Held*, that such claims are vague and indefinite, and in effect cover only the result produced without regard to the means employed. (June 23, 1899.)

GREELEY, A. C.] *Ex parte* Blackmore, 67 MS. Dec. 210.

2. The mere fact that a claim includes functional statements does not make its allowance in that form improper, provided the structural combination actually set forth is patentable. *Id.*

3. The statement in a claim that "one of said segments is provided with a recess on one side thereof," does not necessarily imply that other segments have no such recess, and the objection that such was the implication from the statement quoted should not be insisted on. (Aug. 19, 1899.)

GREELEY, A. C.] *Ex parte* Burke, 67 MS. Dec. 385.

4. A claim is objectionable which includes a "projection adapted to fit in said recess" without including the segment having the projection, as obviously there could be no projection unless there is something from which it projects. *Id.*

V. CLAIMS.

(*c*) *Two Inventions in One Claim.*

1. It is the settled policy of the Office, founded upon good and substantial reasons, not to permit two separate inventions to be covered by one claim. To do so would lead to uncertainty in the meaning of the claim. The fact that the courts have sustained claims which thus cover two separate inventions, because of necessity in order that an invention might be adequately protected, is not to be taken as an approval of such a practice. (Apr. 10, 1899.)

GREELEY, A. C.] *Ex parte* Averell, 66 MS. Dec. 442.

2. A method is a separate invention from an apparatus, and both inventions should not be included in one claim. *Id.*

V. CLAIMS.

(*d*) *Order in relation to punctuation.*

It is hereby directed that in the printing of claims of applications for patents the punctuation of the claims as made by

applicants be strictly followed, and that the punctuation of the specification made by applicants be not departed from, except to cure a manifest absurdity. 86 O. G. 350.

VI. Complete.

Order in relation to.

It is hereby ordered that applications shall not be given serial numbers as complete applications, and forwarded to the examining divisions for examination, (1) when the petition has not been signed by the inventor; (2) when the specification and claims have not been signed by the inventor and the signature attested by two witnesses (Sec. 4888, Rev. Stats.); (3) when the drawing has not been signed by the inventor or his attorney in fact, and the signature attested by two witnesses; (Sec. 4889, Rev. Stats.,) and (4) when the oath to the application does not fill the requirements of Sections 4887 and 4892, Revised Statutes.

The requirements of Section 4896, Revised Statutes, respecting the right of executor or administrator to make application for a patent for the invention of a deceased person must also be observed before the application will be considered as complete and forwarded for examination. The legal requirements in cases where the application is made by a foreign administrator are stated in *ex parte Ransome* (C. D. 1870, 143).

Under existing law no right is given to the guardian of an insane person to make an application for a patent for the invention of said insane person, and such application will not be received for examination.*

This order, so far as applicable, relates to applications for the registration of trade-marks, labels and prints, which must in all respects comply with the requirements of the statutes.

86 O. G. 185.

VII. Division of.

(*a*) *Classification in the Patent Office.*

1. The requirement of the examiner that the different parts of a dental chair, consisting of a hydraulic lifting mechanism, a head-rest, a back-rest, and a foot-rest, should be made the subject of separate applications, sustained as to the lifting

* See "Amendment to Patent Law in Regard to Insane Persons," p. 4, *supra*.

mechanism and head-rest, but reversed as to the back-rest and foot-rest. (Mar. 7, 1899.)

DUELL, C.] *Ex parte* Wilkerson, 87 O. G. 513.

2. Although foot-rests and adjustable backs of a dental chair are separately classified in the Office, yet from the showing made by applicant the claims for these two inventions may be permitted to remain in the application, as it does not appear that they form the subject of separate invention or that other foot-rests or back-rests may be substituted for those made for the particular chair shown. *Id.*

3. The hydraulic means for raising and lowering the chair is a mere improvement on old devices and does not in any manner modify the operation of the devices covered by the other claims, and therefore should be made the subject of separate invention. *Id.*

4. The head-rest is a mere improvement and is not especially adapted for the particular chair shown, and other head-rests may be substituted for this one, and as it is separately classified in the Office classification from other parts of a dental chair and has been made the subject of separate invention, it should be put in an application separate from the other parts of the chair. *Id.*

5. Where devices are independent of each other and do not mutually contribute to produce a single result and the action of one does not in any manner modify or affect the action of the other, they should not be permitted to be covered by one application. (*Ex parte* Williams, 83 O. G. 1346, cited.) *Id.*

6. Although it has been the practice of the Office to allow all parts of a dental chair to be claimed in one application should applicant so elect, the time has come, owing to the increased number of patents in the Office and the extension of the field of search, when this practice should be discontinued. *Id.*

7. When an application shows, describes and claims a device which in its entirety presents subjects-matter which are classified in different divisions of the Office, *Held*, that division should be required and separate applications presented, each of which should include only claims to devices which are classified in a single division. (July 27, 1899.)

GREELEY, A. C.] *Ex parte* Rouse, 88 O. G. 2242.

VII. DIVISION OF.

(*b*) *Practice.*

1. Where the examiner in requiring division had made a cursory examination, and given the applicant the result of his examination, *Held*, that this is all the practice of the Office requires. (May 16, 1899.)

DUELL, C.] *Ex parte* Patrick. 67 MS. Dec. 58.

2. Where an application is held to cover two distinct inventions, but has claims on alleged combinations of those inventions which are held to be mere aggregations, *Held*, that division should not be insisted upon until the question of aggregation is determined. (Aug. 24, 1899.)

GREELEY, A. C.] *Ex parte* Feucht, 88 O. G. 2066.

3. Amended Rule 41 applies to applications filed prior to the promulgation of the rule as well as to those filed subsequently thereto. (Oct. 10, 1899.)

DUELL, C.] *Ex parte* Farquhar, *et al.*, 89 O. G. 706.

4. It is a well-settled principle that enactments which are remedial in their nature and which impair no vested rights or the obligations of a contract are retroactive. *Id.*

5. It has been the practice of the Office whenever amendments to the rules have been made to apply the amended rules, so far as they were applicable, to all pending cases. (*Ex parte* Macmaster, 80 O. G. 1475.) *Id.*

6. The Rules of Practice of this Office themselves are authority for applying amended Rule 41 to applications filed prior to its promulgation. Rule 42 provides that it is within the discretion of the primary examiner to require division at any time before final action on the case. Under this rule it matters not whether the claims have been considered on the merits before requiring division. This requirement may be made at any time during the examination of the case. *Id.*

7. An applicant who has had his claims considered on the merits before the requirement of division has been favored by the Office to the extent that he has had an action on the merits on all of his claims instead of on only one set thereof, as would have been the case had division been made before such action was given. *Id.*

VII. DIVISION OF.

(c) *Process and Apparatus.*

1. Process and apparatus are separate and independent inventions, and claims covering both should not be joined in the same application. (July 11, 1899.)

DUELL, C.] *Ex parte* Boucher, 88 O. G. 545.

2. The argument that claims for the process and apparatus should be permitted to be joined in the same application in the interest of inventors to save them from the expense of filing two applications is of little force in view of the fact that the statutory charge for the examination of an application is reasonable, and it would be unjust to the Government, to the public at large, and to other inventors to permit one of their number to present several inventions for examination under a single fee and receive more of the time of the examiner than he had paid for. (*Ex parte* Yale, C. D. 1869, 110, cited.) *Id.*

3. The argument that claims for process and for apparatus should be permitted to be joined in the same application because the courts have not declared patents invalid as covering more than one invention does not rest on any firm foundation, and the answer to it is that while there are numerous cases in which it has been held that a patent once granted is to be liberally construed, and that it is to be presumed that public officers do their duty, that the court will not inquire into slight defects or mere informalities in the grant of Letters Patent where there is a meritorious invention, yet it would be a grave error to found upon such decisions a rule of action for the Commissioner, for it by no means follows because a patent has been sustained notwithstanding certain informalities in the issue, that every succeeding patent is to exhibit the same informalities. (*Ex parte* Yale, C. D. 1869, 110, cited.) *Id.*

4. Process and apparatus should not be joined in the same application because they are examinable in the same division. The classification of inventions is necessarily subject to frequent changes through the advance in the arts, requiring the organization of new divisions and the establishment of new classes and sub-classes. It naturally follows that a decision based upon this ground, while applying at the time when it was rendered to the

case in point, might not apply to an identically similar case thereafter. *Id.*

5. While it may be that a perfect examination as to the novelty of an apparatus requires the same labor on the part of the examiner that would be required if process and apparatus were both claimed in the same application, yet this cannot always be so, and even though one examination will answer for both process and apparatus claims, yet that affords no good reason for permitting two inventions to be claimed in one application. An examination system to be of value must be a perfect one, and perfection will be more readily attained by the requirement that separate applications be filed for a process and an apparatus. *Id.*

6. The prior decisions on the question of devision between process and apparatus reviewed and *Held*, that the practice of the Office on this question would be less liable to frequent change if a rule clearly setting forth the line of action to be followed were promulgated, and change in rule 41 indicated. *Id.*

VII. Division of.

(*d*) *Process and Product.*

Where the examiner required division between a set of claims covering processes of making alloys, and a claim covering an alloy which upon examination was found to be the product of the process of one of the set of claims, and furthermore, both process and product are examinable in the same division, *Held*, that the claims should not be separated. (May 16, 1899.)

Duell, C.] *Ex parte* Patrick, 67 MS. Dec. 58.

VII. Division of.

(*e*) *Different Processes.*

1. Where in one claim a step in a process covered by another claim is omitted without changing the order in which the other steps in the process are performed, *Held* that the claims do not cover such different processes that it is necessary to put them in separate applications. (May 1, 1899.)

Greeley, A. C.] *Ex parte* Oxnard and Baur, 88 O. G. 1526.

2. An applicant may properly in one case have claims covering the principal or essential steps of a process and other claims

including those steps, together with other specific steps which are not absolutely necessary to the performance of the process, but which add to its efficiency or make its operation more perfect. *Id.*

VII. Division of.

(*f*) *Status of Invention in the Arts.*

1. In an application for a patent on a voting machine, division was properly required between the registering mechanism and the voting mechanism, inasmuch as registering mechanism has acquired a definite place in art and manufacturing, and can be used in other relations than with the voting mechanism shown in the case. (Jan. 7, 1899.)

Greeley, A. C.] *Ex parte* Tuttle, 66 MS. Dec. 145.

2. Division was properly required between the apparatus for bending metallic printing forms to approximately the shape of the printing cylinder, and the apparatus for further bending them into exact form and ascertaining the relation the engraved surface should have to the impression surface, so that by "underlaying" at the proper places the lights and shades of the printed picture may be properly brought out. The first belongs to the art of metal-bending, and the second to the art of printing. (Aug. 29, 1898.)

Greeley, A. C.] *Ex parte* Osborne, 86 O. G. 492.

VIII. Drawings.

(*a*) *In General.*

1. A party may upon showing a single specific structure present claims of such breadth as to include many different modifications of it, but that does not give him the right subsequently to show every modification he chooses merely because his claim is broad enough to apply to it. (Feb. 21, 1899.)

Greeley, A. C.] *Ex parte* Sattley, 66 MS. Dec. 345.

2. Where the subject-matter of two figures of a drawing was not covered by any claim, but such figures were used to illustrate modified forms of certain adjuncts of the device covered by the claims, so as to show that applicant was not limited to the use of any specific form of such adjuncts, they were allowed to remain in the case, but applicant was required to amend the

description to set forth that these figures were used for that purpose only. (May 19, 1899.)

DUELL, C.] *Ex parte* Lilly, 67 MS. Dec. 80.

3. After applicant had complied with the requirement of division and properly limited his claims, the examiner required the cancellation of certain figures of the drawings, for the reason that they were unnecessary to the disclosure of the invention claimed. *Held*, that such figures should ordinarily be canceled, but inasmuch as they were on the same sheet with another figure which it was necessary to retain, and which could not be transferred to another sheet, and such cancellation would not reduce the number of sheets, and, further, some such means as illustrated in such figures were necessary to the operation of the devices claimed, they should be allowed to remain, together with the short description thereof which appeared in the specification. (Aug. 19, 1899.)

GREELEY, A. C.] *Ex parte* Person, 67 MS. Dec. 382.

4. Where it seemed obvious that the device would not operate as described in the original specification so long as a certain aperture shown in the drawings was not closed, and that this would be recognized by any mechanic upon examining the device, it seemed clear that such aperture was shown by the draftsman through clerical error, inasmuch as the description of the function of such aperture was inconsistent with the description of the operation of the device, *Held*, therefore, that the failure to show the aperture closed and the insertion of the description of its function were due to inadvertence and constituted such clerical errors as may be corrected by amendment, and such amendment would not involve the introduction of new matter into the application. (Sept. 7, 1899.)

GREELEY, A. C.] *Ex parte* Chace, 67 MS. Dec. 427.

5. Rule 49, as well as the statute, provides that when the nature of the case admits of a drawing the applicant shall furnish one; therefore where the results of the successive steps of a process could be represented in a drawing, such drawing was properly required. (Sept. 8, 1899.)

GREELEY, A. C.] *Ex parte* Daniel, 67 MS. Dec. 432.

6. Where a mistake was made by the Office in issuing a

patent, and upon request of the patentee it was decided to reissue the patent under rule 170 at the expense of the Office. *Held* that a new drawing should be prepared, notwithstanding some person whose authority does not appear, had endorsed upon the reissue file "Old drg. to be used" and the examiner had not required a new drawing. (Nov. 6, 1899.)

GREELEY, A. C.] *Ex parte* Boutell, 68 MS. Dec. 87.

7. Where a drawing, although informal, was admitted for the purpose of examination, *Held* that the requirement that the objections thereto be removed before an appeal is taken, was improper and should not have been insisted upon. Rule 54 provides for the admission of such a drawing, and means that it need not be corrected until the case is ready for issue. Rule 134 was not intended to and does not in fact nullify this provision. (Dec. 7, 1899.)

GREELEY, A. C.] *Ex parte* Cathrae, 68 MS. Dec. 259.

8. The drawing should show the entire thing described in the specification as constituting the invention and not merely a section thereof. (Nov. 25, 1898.)

GREELEY, A. C.] *Ex parte* Le Febvre, 86 O. G. 995.

VIII. DRAWINGS.

(*b*) *Order in Relation to Drawings and Blue-Prints.*

Erasures and alterations in drawings forming part of applications will not be permitted, except as herein provided.

No alteration will be permitted in a drawing forming any part of an application by an applicant, or any person acting for him, except where a blue-print or other photographic copy has been filed in the case. When, however, the examiner makes a requirement for a change in the original drawing and no blue-print or other copy has been furnished by the applicant, the Office will make such copy without charge, and thereupon the required alteration may be made by the applicant, under the direction of the examiner, subject to his approval; or, upon request, it will be made by the Office at the expense of the applicant.

Requirements of the Office for alterations in original drawings will be made in writing, and the applicant's response must also be in writing. The copy of the drawing, the requirement to

alter, and the applicant's response will form part of the record in the case.

Alterations in drawings cannot be made in the Attorneys' Room, except upon written permission of the examiner in charge of the application.

Action on the merits by the Office will not be suspended pending the change of a drawing, if the invention claimed may be understood by the examiner.

Applicants are requested to furnish with their originals a blue-print or other photographic copy of all drawings forming part of an application, and when this is done such copy shall be made a permanent part of the record in the case; or, upon the request of applicants, the Office will make blue-prints for five cents a sheet.

In appeal cases and upon the declaration of an interference, a blue-print or other copy of the drawings will be sent forward with the files, the examiner retaining the original drawing until the day of hearing.

Applicants may inspect their drawings in the Attorneys' Room before blue-prints are filed.

Violation of the requirements and provisions of this order will be considered ground for disbarment.

Orders No. 986, of January 25, 1894, and No. 1,134, of June 5, 1897, are hereby revoked. 86 O. G. 1.

IX. Examination of.

(*a*) *Information and Advice to Applicants.*

1. Where the Office letter stated "It is thought that the case could be materially abridged with a great gain in clearness and without unduly restricting the scope of the invention," *Held* the sentence was too general in its character, and did not give the applicant such full information as would enable him to overcome the examiner's objections. Applicant is entitled to have pointed out to him wherein "the case could be materially abridged" so as to make it more clear, and such information should be given in a supplementary letter. (Sept. 8, 1899.)

Greeley, A. C.] *Ex parte* Daniel, 67 MS. Dec. 1899.

2. Where a petition contained numerous requests for general instructions to the examiner as to his duty in acting upon ap-

plications, and did not ask for specific relief from any particular action taken, *Held* that general or moot questions of this kind cannot be properly brought up on petition and will not be ruled upon. If an applicant is dissatisfied with any specific action by an examiner he may have that action reviewed on petition, but the Office will not answer hypothetical questions merely because they are presented by an applicant. (Sept. 6, 1899.)

GREELEY, A. C.] *Ex parte* Laperle & Boulard, 67 MS. Dec. 429.

3. There is no authority for the statement by the examiner that "he will not again consider the case until duplicate claims are cancelled and each claim is made distinguishable from every other," since it is contrary to the settled practice of the Office to refuse to act upon a case of this kind. The mere presence of claims which the examiner regards as equivalents is no good reason for refusing to act on the case, particularly when the applicant has never been informed as to which claims were regarded as equivalents. *Id.*

4. In such a case each claim should be treated fully as to its merits and the applicant should be clearly and specifically informed as to which claims are regarded as duplicates, and the reasons upon which the action is based should be fully and clearly set forth. *Id.*

5. Where an examiner failed to state specifically that such claims as were not rejected were allowable, *Held*, that that is the natural and obvious inference from his action, since it is a well recognized practice with some examiners to mention only the claims that are rejected, and omit all reference to those that are regarded as allowable. (Nov. 3, 1899.)

GREELEY, A. C.] *Ex parte* Hunter, 68 MS. Dec. 111.

6. It would be better practice for the examiner to mention each claim and state whether or not it is allowable, but in view of the recognized custom, his failure to do so in a particular case is not such irregularity as to render his action of no effect. *Id.*

7. Where an applicant was, after the first action in the case, aware of the references relied on by the examiner, but not aware of the reasons why he regarded those references as anticipations until apprised of them in the letter giving a final rejection, *Held*, that the final action was premature, as the applicant had

not been furnished with the full information which would enable him to intelligently amend the claims so as to meet the examiner's views and avoid the references. (Nov. 11, 1899.)

GREELEY, A. C.] *Ex parte* Waring, 68 MS. Dec. 170.

8. An applicant is entitled to fully understand the examiner's position while he has the right of amendment, and not merely after the prosecution before the examiner is closed. The right of amendment is more important than the right of appeal, and it is essential that the applicant and the examiner understand each other's position before the right of amendment is lost. *Id.*

9. Where the examiner rejected claims on references showing different features of the matter claimed, and gave little explanation of his reasons for rejection, and it was apparent from the correspondence that the applicant did not understand the examiner's position in rejecting the claim, *Held*, that the examiner's action was not as full as should have been. (*Ex parte* Barnes, 80 O. G. 2038, cited.) (Mar. 15, 1899.)

GREELEY, A. C.) *Ex parte* Perkins, 88 O. G. 945.

IX. EXAMINATION OF.

(*b*) *Rejection.*

1. Where in giving a final rejection the examiner cited certain decisions in support of his position, *Held* that this was not a new reason for rejection and therefore did not reopen the case for further amendment. The tribunals of the Office, like the courts, take judicial notice of decisions which have been rendered, and may properly cite them at any and all stages in the prosecution of an application. (Feb. 16, 1899.)

GREELEY, A. C.] *Ex parte* Telfer, 66 MS. Dec. 286.

2. It is well settled that claims in an application may properly under certain circumstances be rejected on a patent granted to the same party on a copending application. (*Ex parte* Mullen & Mullen, 50 O. G. 837.) (Nov. 8, 1898.)

GREELEY, A. C.] *Ex parte* Wellman, 86 O. G. 1986.

3. Since mere disclosure in a patent of matter properly divisible from the invention claimed is no bar to the allowance of claims to that matter if presented in a copending application, the examiner should, if he insists upon a rejection of the claims,

point out more fully the reasons therefor. Rule 92 does not prevent the allowance of claims coming under the second class of cases mentioned in *ex parte* Mullen & Mullen. *Id.*

4. Claims for an alleged combination may properly be rejected on references none of which shows the combination, but which show the elements to be old, if it is clear that by assembling the elements in one structure no new effect different from the sum of the effects of the separate elements is secured. (June 1, 1899.)

GREELEY, A. C.] *Ex parte* Perkins, 88 O. G. 548.

5. The applicant's request for reconsideration of one claim while other claims were under rejection, was properly construed as applying to the entire case, for otherwise it would not be a proper request and could not be granted. (Apr. 29, 1899.)

GREELEY, A. C.] *Ex parte* Stebbins, 88 O. G. 1335.

6. If applicants were permitted to prosecute each claim separately to a conclusion before taking action in reference to other claims in the same case, it would be practically impossible for the Office to bring the prosecution of any case to a conclusion. Such piecemeal action has not been and cannot be permitted. *Id.*

7. Where the examiner in his first action rejected claim 1 on a British patent and claim 3 on a United States patent, and in his second action gave reasons for refusing the claims which did not appear in the first action, viz., that there is no invention in making an ordinary diaphragm with a serrated edge and that the combination recited in claim 3 lacks invention, in view of the British patent, taken in connection with the United States patent, *Held* that new reasons for refusing the claim having been given the application was not under final rejection, under the rules and practice of the Office, and the amendment presented after the second action on the case should be admitted. (Oct. 2, 1899.)

DUELL, C.] *Ex parte* Valiquet, 89 O. G. 354.

IX. EXAMINATION OF.

(c) *Actions Other than Rejection.*

1. A model is only necessary as an alternative of failure to properly describe an invention, and this defect can often be

removed by compliance with objections definitely stated by the examiner. (Nov. 25, 1898.)

GREELEY, A. C.] *Ex parte* Isenhart, 87 O. G. 179.

2. An examiner in making the objection of inoperativeness should point out the particulars in respect to which the device objected to is inoperative, if there be any such. *Id.*

X. FEES.

Order.

DEPARTMENT OF THE INTERIOR,
UNITED STATES PATENT OFFICE,
Washington, D. C., November 23, 1898.

The attention of all those who purchase certificates of deposit to be sent to this Office is called to the following regulation, which was made by the United States Treasury Department and is still in force:

Hereafter all certificates of deposit issued for patent fees must state on their face the name and address of the person on whose behalf the deposit is made, (the name of the attorney not being sufficient,) and the particular invention, improvement, or object to which their amounts are to be applied.

Unless this information accompanies each deposit of this kind the deposit should be refused.

C. H. DUELL, *Commissioner.*

86 O. G. 1327.

XI. FORFEITED.

Renewal of.

Where an application had been once forfeited and renewed, and became forfeited a second time for non-payment of the final fee within the prescribed six months, and more than two years had elapsed since the date of allowance in the first instance, *Held*, that no renewal could now be allowed or permitted. The only recourse now open to applicant is the filing of an entirely new and separate application, provided, of course, that his invention has not been patented or described in any printed publication in this or any foreign country for more than two years prior to his application, and not in public use or on sale in this country for such length of time. (Aug. 17, 1899.)

GREELEY, A. C.] *Ex parte* Kellow, 67 MS. Dec. 377.

XII. MODEL.

It is within the examiner's discretion to permit a drawing of a model or structure or a copy of an original drawing to be filed; but whenever required the original model, structure, or drawing should be produced for the inspection of the Office, with leave to the applicant to withdraw the same after it has served the purpose for which it was produced. In case of withdrawal a drawing of the original should be filed. (Oct. 27, 1899.)

DUELL, C.] *Ex parte* Johnson, 89 O. G. 1341.

XIII. NAMES OF APPLICANTS.

Order.

When the full first name of the applicant does not appear either in his signature or in the preamble to the specification, the examiner will, in his first official letter, require an amendment supplying the omission, and he will not pass the application to issue until the omission has been supplied, unless an affidavit shall have been filed setting forth that the full first name of the applicant is the one originally given by him.

86 O. G. 350.

XIV. OATH.

(*a*) *New or Renewed.*

1. Where applicant filed a new oath in compliance with the requirement of the examiner and said oath referred to "the annexed specification" and no such specification accompanied the oath, but the oath was intended to apply to an application already on file, *Held* that the oath did not properly identify the application by serial number and date of filing and that a new oath should be furnished properly identifying the application to which it is to be applied. (June 3, 1899.)

DUELL, C.] *Ex parte* Heusch, 88 O. G. 1703.

2. As rules 10 and 32 of the Rules of Practice require that a letter concerning an application must properly identify the application, and that when all parts of an application are not filed together a letter should accompany each part accurately and clearly connecting it with the other parts of the application,

Held that these rules apply to an oath as well as to any other papers relating to an application. *Id.*

XIV. Oath.

(*b*) *Supplemental.*

1. Where an examiner held that certain claims in an amendment covered new matter and required a supplemental oath, and stated that when such oath had been supplied the claims would be rejected as covering new matter, *Held*, that if these claims introduced new matter into the case they could not be supported by any oath, but should be rejected on the ground of new matter without requiring a new oath, so that an opportunity could be afforded for appeal to the various tribunals on the ground of rejection. (Mar. 25, 1899.)

Duell, C.] *Ex parte* Marsh, 66 MS. Dec. 416.

2. Where the question as to whether or not a claim was for matter substantially embraced in the statement of invention or claim originally presented is not free from doubt, under the particular circumstances of the case, the doubt should be resolved in favor of the petitioner. (Oct. 20, 1899.)

Duell, C.] *Ex parte* Marsh, 68 MS. Dec. 67.

3. When a reputable attorney makes the statement "that if it were possible to obtain a supplemental oath from the applicant, such a course would have been pursued; but the applicant has refused to make such affidavit as well as to execute an application which was intended to be filed in lieu of the present application," the Office should accept that statement and not allow itself to be made a party to a "hold-up." *Id.*

XIV. Oath.

(*c*) *In Foreign Countries. Order.*

It is hereby directed that oaths accompanying applications for patents made within the following-named foreign countries must be taken before a minister, chargé d'affaires, consul, or commercial agent holding commission under the Government of the United States:

Austria-Hungary.	Brazil.
Argentine Republic.	Costa Rica.
Belgium.	Denmark.

Haiti.	Portugal.
Honduras.	Russia.
Italy.	San Salvador.
Mexico.	Servia.
Netherlands.	Sweden.
Norway.	Switzerland.
Peru.	

Applications filed in this Office presenting oaths not executed in compliance with this order will be treated as incomplete.

XV. PENDING.

Access to.

ORDER NO. 1,271.

DEPARTMENT OF THE INTERIOR,

UNITED STATES PATENT OFFICE,

Washington, D. C., March 27, 1899.

Hereafter no person except the applicant, the assignee whose assignment is of record, or the attorney of record will be permitted to have access to the file of any application, except as provided for under the interference rules, unless written authority from the applicant, assignee, or attorney, identifying the application to be inspected, is filed in the case to become a part of the record thereof, or upon the written order of the Commissioner, which will also become a part of the record of the case.

C. H. DUELL, *Commissioner.*

XVI. PETITION.

It is possible that the name of the town and county, wherein an applicant resides, given in the petition, is also his complete postoffice address; but under the rule (33) that fact, if it is true, must appear positively from the petition itself and not left to conjecture. (Dec. 7, 1899.)

GREELEY, A. C.] *Ex parte* Cathrae, 68 MS. Dec. 259.

XVII. PUBLIC USE PROCEEDINGS.

1. Rule 130 provides that amendments to the specification will not be received during the pendency of an interference except as provided in rules 106, 107 and 109; this rule is equally applicable to a proceeding to determine the question of public use. (July 27, 1899.)

GREELEY, A. C.] *Ex parte* France, 67 MS. Dec. 324.

2. Applicant's claims were finally rejected as a result of a public use proceeding, and his right of appeal existed and therefore the question of public use had not been finally determined. No amendment of the application involved in such a proceeding is legitimate or proper until such question is finally disposed of, and applicant should await such final disposition before attempting to amend. *Id.*

3. A protest was filed against the grant of a patent to D. on the ground that the invention had been in public use for more than two years prior to the filing of D.'s application. M., who claimed the same invention, was put in interference with D., and his assignee was permitted to take part in the interference proceeding. A copy of M.'s application was obtained by protestants against the wish of M. *Held*, that it is not necessary for the conduct of public use proceedings that the protestants should have a copy of M.'s application, and the copy obtained by them should be returned to the Office. (Oct. 9, 1899.)

DUELL, C.] *In re* Nat'l Phonograph Co., 89 O. G. 1669.

4. *Held*, further, that as protestants have filed affidavits alleging that certain machines had been made and were in public use, it is incumbent upon them to prove their allegations by proper evidence. When this evidence is before the Office, it will judge whether the machines were in public use at the time alleged, and whether the evidence is sufficient to prevent the grant of a patent. *Id.*

Held, further, that as M.'s assignee has been made a party to the public use proceeding at its request and has the right to cross-examine the witnesses produced on behalf of protestants, the evidence may be used against M. in the consideration of his application on the question of patentability. *Id.*

XVIII. REISSUE.

New Matter.

It is well recognized in the practice of the Office and in the courts that the question whether or not matter sought to be introduced into a pending application is to be refused as new matter is quite a different question from the question whether or not such matter may be introduced in a reissue application. So long as an application is pending before this Office the

applicant may be permitted to amend in the direction of broadening the statement of his invention, provided he does not change the invention on which that statement is based. In other words, if his specification and claims as originally filed do not adequately express the full breadth of the invention which he has disclosed, he may amend in such a way as to secure full protection. When a patent has issued, the specification and claims are no longer open, as a matter of course, to the same amendments which could have been made before issue. The burden of proof is then upon the patentee who seeks to amend by an application for reissue to show not only that the amendment desired is necessary to the protection of his rights, but to show also satisfactory reasons why the amendment was not made before issuance of the patent. This is because other questions are to be decided and other surrounding circumstances are to be considered in passing upon an amendment in a reissue application. (Jan. 6, 1899.)

GREELEY, A. C.] *Ex parte* Hollis, 86 O. G. 489.

XIX. SPECIFICATION.

(*a*) *In General.*

It is the policy of the Office to permit an applicant in describing his invention to select his own terms of reference so long as their use does not lead to ambiguity. (Jan. 6, 1899.)

GREELEY, A. C.] *Ex parte* Hollis, 86 O. G. 489.

XIX. SPECIFICATION.

(*b*) *Sufficiency of Description.*

1. Where, in describing and illustrating an electrical invention, the specification was in general terms, and conventional forms were used such as are employed to a great extent in illustrating electrical inventions. *Held* that for these reasons the application does not disclose an inoperative device, though lacking in mechanical detail. To hold that an application is insufficient because of the use of such forms and general description, would upset the practice of the Office and necessitate the rejection of a great number of applications now on file and accepted as reduction to practice of the invention disclosed. (Mar. 8, 1899.)

DUELL, C.] Brown *v.* Hoopes, 66 MS. Dec. 375.

2. It is the policy of the Office to permit an applicant to select his own terms of reference in describing his invention so long as their use does not lead to confusion and uncertainty. (Apr. 10, 1899.)

GREELEY, A. C.] *Ex parte* Averell, 66 MS. Dec. 442.

3. Where an application bore evidence of having been drawn abroad without that realization of the requirements of this Office which is reasonably expected of attorneys practicing before this Office, and it is obvious that it needed a very full and careful revision, it is proper to grant the request of the applicant that the examiner cite such references as are at his immediate command to aid applicant to properly restrict the application, as a compliance with the request might materially facilitate the progress of the application. (Aug. 19, 1899.)

GREELEY, A. C.] *Ex parte* Theisen, 67 MS. Dec. 388.

4. Section 4888 of the Revised Statutes and Rule 34 require that specifications state the manner of using the invention; but in the present case this has been done within the meaning of the statute and the rule. The purpose of this requirement is that upon reading the patent others will clearly understand the invention, and the manner of using it. The rod-coupling shown in this case is obviously adapted for use wherever it is desired to connect two sections of a rod, and neither the wording nor the spirit of the rule requires that the use to which the rod is to be put should be stated. The purpose and use of the coupling pin are the same in whatever apparatus and for whatever purposes the rod is used. (Aug. 28, 1899.)

GREELEY, A. C.] *Ex parte* Hinkle and Ashmore, 88 O. G. 2410.

XX. SUSPENSION OF ACTION ON.

1. Where the examiner suspended action on an application until the termination of an interference in which an earlier case is involved, of which the one under consideration is a division, and which the examiner states contains the same claims as the earlier application, *Held*, that proceedings should not be suspended and the application indefinitely delayed, but the applicant should at the present time be permitted to contest the

matter by such action as the condition of the case requires. (May 3, 1899.)

GREELEY, A. C.] *Ex parte* Bullier, 88 O. G. 1161.

2. If the claims in the present application are the same as the issue of the interference, or cover the same invention as the application of the other party to the interference, it is clear that the applicant's right to the claims cannot be determined until the decision on the question of priority, but the possibility that the examiner may be mistaken in holding that the claims in this case are not patentable over the invention disclosed by the other party to the interference must be contemplated just as the rules providing for appeals contemplate the possibility of mistake in rejecting claims on references, and the applicant should be permitted to contest the question at the present time instead of waiting until the interference is decided. *Id.*

3. The question to be determined is of the same kind as if the decision had been rendered against the applicant in the interference, and it would be unjust to him to cause him the delay when the matter can be settled at the present time. *Id.*

4. It is contrary to the well-settled policy of the Office to suspend action on an application unless such suspension is absolutely necessary to determine the right of an applicant to a patent on that application. As pointed out in *ex parte* Drawbaugh (64 O. G. 155), action on one of several divisional cases should not be suspended to await the allowance of another application. *Id.*

XXI. BY ADMINISTRATOR OF DECEASED INVENTOR.

1. Where an application was filed by a party as an administrator of the estate of a deceased person, unaccompanied by letters of administration duly taken out in the United States, *Held*, that said application has no standing in the Patent Office. (*Ex parte* Ransome, C. D. 1870, 143, cited.) (Mar. 3, 1899.)

DUELL, C.] *Ex parte* Langen, 87 O. G. 697.

2. The fact that such an application had been given a serial number, and that oral instructions had been given to forward it for examination, does not make it a legal application or relieve the applicant or his attorney from the responsibility of filing an application by an administrator duly appointed in this

country, so as not to be affected by the statute which prohibits the grant of a patent in this country when a foreign patent had been obtained on an application filed more than seven months prior to the filing of the application in this country. *Id.*

3. As said application has no standing, an administrator appointed in this country after the application is filed cannot be substituted for the present applicant or be permitted to sign the application *nunc pro tunc*, as the application would then lack the oath of the proper administrator, and would not be a complete application until such oath was filed. *Id.*

XXII. JOINT AND SOLE.

1. Where each of two joint inventors files a petition, specification, and oath separately signed and executed by him, the specifications being duplicates and the papers reciting the fact that the parties are joint inventors, *Held*, that they constitute a valid application under the law, and that it is not necessary to file a new petition, specification, and oath signed by both parties. (Aug. 14, 1899.)

GREELEY, A. C.] *Ex parte* Wellman *et al.*, 88 O. G. 2065.

2. Where duplicate specifications have been filed by joint inventors, the attorney for the applicants should for the convenience of the Office substitute by amendment a single copy of the specification for the two on file, so as to prevent confusion in the entry of amendments and the printing of the patent. *Id.*

Assignment.

I. IN GENERAL.

II. OF FUTURE IMPROVEMENTS.

I. IN GENERAL.

1. Where an instrument, purporting to be an assignment, was clearly nothing more than an executory contract; did not convey the legal title to the invention, but was merely an agreement to transfer the patent to be granted upon the performance of certain conditions specified; and was not such an assignment as the Office could recognize. *Held*, that in an interference proceeding it was not necessary that a concession of priority made by the alleged assignor be signed by the alleged assignee. (Apr. 25, 1899.)

GREELEY, A. C.] Bates *v.* Johnson, 66 MS. Dec. 477.

2. A patent right is an incorporeal kind of personal property and in a certain sense analogous to property in a share of stock. The discoverer of a new and useful improvement is vested by law with an inchoate right to its exclusive use which he may perfect and make absolute by securing a patent from the government in the manner provided by law. This right the inventor may, under the law, assign before the patent is issued, and request that the patent be issued to the assignee. When the patent is issued, an exclusive right to the invention for the statutory period has been created and vested in the assignee. (C. C., N. D. Cal. May 22, 1899.)

MORROW, J.] *Fruit-Cleaning Co. *v.* Fresno Home-Packing Co. *et al.*, 94 Fed. Rep. 845.

3. An oral agreement for the sale or assignment of the right to obtain a patent is not invalid; if sufficiently proved it can be specifically enforced in equity. **Id.*

4. It is common knowledge that a partnership may acquire the title to an invention in the name of the partnership after the patent has issued, and there does not appear to be any good reason why it may not do so before the patent is issued. The grant in the patent does not change the character of the property, and under the law a patent is not void because the grant of an exclusive right has been made to a co-partnership. **Id.*

II. OF FUTURE IMPROVEMENTS.

Where an employé of a manufacturing company granted to the company "all the patents, inventions and improvements by him," now existing and used by "the company" in the manufacture and sale "of certain machinery;" also "all inventions and improvements in said machinery made by" him; also "all new designs of such machinery hereafter made by" him; also "all inventions and improvements hereafter made by" him, "in the machinery covered by such new designs." *Held*, that the "inventions and improvements" of the second clause were to pass by the grant, even though made after the grantor left the company's employ; *Held* further that the "new designs" of the third clause, and "inventions and improvements" of the fourth clause passed while the employment con-

tinued (but were impliedly reserved if they were made after the employment ceased), unless the "new designs" were so divergent from the "machinery" in question, were so thoroughly typical, and so different in plan and structure as to be radically distinctive. (C. C., E. D. Penn. Jan. 31, 1899.)

DALLAS, J.] *Geiser Mfg. Co. *et al.* *v.* Frick Co., 92 Fed. Rep. 189.

Cases Distinguished.

1. In the case of Palmer *v.* Mfg. Co., 84 Fed. Rep. 454, 457, each of the two patents involved was really for a machine, the machine in the earlier patent merely needing well-known connections to accomplish the results of the machine of the later patent; so that the two patents were clearly for the same subject-matter; but the case at bar is not one of this kind, as Simonds' earlier patent was clearly for a mechanism, and the later one clearly for an art. (C. C., D. Me. July 30, 1898.)

PUTNAM, J.] *Simonds Rolling Mach. Co. *v.* Hathorn Mfg. Co. *et al.*, 90 Fed. Rep. 201.

2. The case of Potts *v.* Creager, 155 U. S. 597, 15 Sup. Ct. 194, 70 O. G. 494, laid down no new principles of law, neither did it overrule any of the cases cited in Briggs *v.* Ice Co., 60 Fed. Rep. 87. On the contrary, it indicates quite clearly that the question of so-called double use, *i. e.*, whether the new use is so nearly analogous to the former one that the applicability of the device to its new use would occur to a person of ordinary mechanical skill, is one dependent upon the peculiar facts of each case. (C. C. A., 2d Cir. Apr. 4, 1899.)

LACOMBE, J.] *Briggs *v.* Duell, Com. of Patents, 93 Fed. Rep. 972.

Comity.

1. The circuit court of appeals and the circuit court also must take up all cases which involve the invalidity of patents upon their merits and determine them independently of the rulings of other circuits, except so far as the decisions of such other circuits are instructive upon the subject under consideration. (Stover Mfg. Co. *v.* Mast, Foos & Co., 32 C. C. A. 231, 89 Fed. Rep. 333; Sand. Pat. Dig., 1898, 51.) (C. C., N. D. Ill. Nov. 28, 1898.)

GROSSCUP, J.] *Ross *v.* City of Chicago, 91 Fed. Rep. 265.

2. Ordinarily, it is proper practice upon the question of granting a preliminary injunction to accept and follow the decision of a circuit court of appeals of another circuit sustaining and construing a patent; but where the circumstances are so unusual as to require a court to make an independent investigation as to the validity and scope of the patent and to determine whether the rights of the patent owner have been violated by another alleged infringer, such decision may not be followed. (C. C. A., 3d Cir. Dec. 21, 1898.)

ACHESON, J.] *Horn & Brannen Mfg. Co. *v.* Pelzer, 91 Fed. Rep. 665.

3. Where, in a second suit, it appears that 12 years after the grant of the patent sued upon, it was declared invalid and shortly thereafter an application for a reissue thereof was made, which application was subsequently granted, and further that the alleged infringing device is made under a patent antedating the reissue patents, such facts raise proper questions for such independent investigation and consideration. **Id.*

4. As a general rule, and especially in patent cases, the decision of a circuit court of appeals of one circuit should be followed in another circuit upon final hearing with respect to the issues determined, if based upon substantially the same state of facts, unless it should appear that there was manifest error. (C. C. A., 1st Cir. Feb. 13, 1899.)

COLT, J.] Beach *v.* Hobbs *et al.*, Hobbs *et al. v.* Beach, 92 Fed. Rep. 146, 87 O. G. 1961.

5. On a motion to dissolve a preliminary injunction, when the court has before it the opinions of two circuit courts of appeal covering the question at issue in the suit at bar, in which opinions antagonistic conclusions are reached, it may closely examine the reasoning of each of the said courts and the grounds upon which they arrive at their respective conclusions, in addition to the facts brought out at the hearing of the case at bar, and adopt the reasoning of either of said courts in so far as it may impress the court as being correct and applicable to the case at bar. (C. C., N. D. Ills. Apr. 13, 1899.)

KOHLSAAT, J.] *Pelzer *v.* Newhall *et al.*, 93 Fed. Rep. 684.

6. Where the court of appeals of one circuit had gone into the

claims of a patent fully and given a decision in regard to one claim, which caused a reissue of the patent and the modification of that claim, and later the same court, on motion for preliminary injunction, had held that claim as modified by reissue to be invalid, while the court of appeals of another circuit had, upon final hearing, held the claim to be valid, both courts having gone equally into the merits of the case as the basis of their respective decisions, *Held*, that upon a motion for preliminary injunction in the court of still another circuit, the case does not fall within the customary rule, that as between conflicting decisions of two circuit courts of appeals of other circuits respecting the validity of a patent, that one will be followed which was rendered upon final hearing rather than one which was rendered upon a preliminary motion. (C. C., N. D. Ill. N. D. May 23, 1899.)

KOHLSAAT, J.] *Maitland *v.* Graham, 96 Fed. Rep. 247.

7. A circuit court of appeals is not in the least concluded by the decision of a circuit court of another circuit upon the question of the validity of a patent, nor do considerations of comity toward a circuit court with respect to its rulings have the same potency with a circuit court of appeals as they may properly have with a circuit court when confronted with the alternative of following or departing from the ruling of another circuit court. (C. C. A., 3d Cir. Oct. 4, 1899.)

BRADFORD, J.] *McNeely *et al. v.* Williames *et al.*
Williames *et al. v.* McNeely *et al.*, 96 Fed. Rep., 978.

8. The circuit courts and the circuit courts of appeals throughout the United States are respectively of equal dignity, and there is no reason why, unless in cases of clear error or oversight, each of these courts should not follow the rule practiced by the two divisions of the court of appeal, sitting under the English judicature acts, to the effect that each division accepts the decisions of the other as of binding force, thereby avoiding the just complaints, and the substantial detriment to the administration of the law, which come from inconsistent proceedings of several tribunals of like authority. (C. C., D. Mass. Oct. 4, 1899.)

PUTNAM, J.] *Duff Mfg. Co. *v.* Norton, 96 Fed Rep. 986.

Contracts.

I. Construction of.

II. Specific Performance.

I. Construction of.

1. Where each party to a contract grants to the other a license under all United States patents owned and controlled by it, subject to outstanding licenses, but neither is permitted to grant licenses to its territorial licensees under the patents of the other party, though neither is authorized nor forbidden to sell to its licensees the apparatus covered by the patents of the other party, and such sales are recognized, the contract cannot be construed as an express covenant not to make such sales, so as to afford a basis for a suit by one party to enjoin the other from making them, but it leaves both parties, so far as such sales are concerned, as they stood prior to the making of the contract. (C. C., N. D. N. Y. May 22, 1899.)

Coxe, J.] *Westinghouse Electric & Mfg. Co. *v.* General Electric Co., 94 Fed. Rep. 381.

2. Where an inventor made an invention, and entered into an agreement with a company whereby it was to pay him "all the costs and expenses of making and perfecting such invention, and obtaining patents," which were to be assigned to the company, in consideration whereof the inventor was to have the right to manufacture the invention at a reasonable profit, and in such quantities as the company should put upon the market; whereupon the inventor perfected one sample or specimen of the invention and obtained a patent therefor and the company paid the weekly bills presented for labor, materials, etc., and for obtaining the patent, *Held*, that this was a practical construction of the contract by the parties, and the company could not thereafter, in respect to subsequent inventions of the same character, set up that its obligations covered only the expenses of obtaining the patent. (C. C. A., 6th Cir. June 6, 1899.)

Lurton, J.] *Hartz *v.* Cleveland Block Co., 95 Fed. Rep. 681.

II. Specific Performance.

Where one of the objects of a bill in equity is to obtain the specific performance of a contract whereby it is alleged that one

of the defendants agreed not to manufacture patented articles for a period specified, and the bill fails to set out the contract or make profert thereof, or have a copy thereof annexed, no opportunity is afforded the court to determine the rights of the parties thereunder, and it would not be justified in forbidding said defendant to follow an employment which he says is necessary for the support of himself and his family. (C. C., D. N. Jer. Dec. 14, 1898.)

KIRKPATRICK, J.] *Richmond Mica Co. *v.* De Clyne *et al.*, 90 Fed. Rep. 661.

Copyrights.

I. COPYRIGHTABLE SUBJECT-MATTER.
II. FALSE MARKING.
III. INFRINGEMENT.
(*a*) *In General.*
(*b*) *Injunction.*
IV. PENALTIES.
V. PUBLICATION AND SALE.

I. COPYRIGHTABLE SUBJECT-MATTER.

A reporter of the decisions of a court may not copyright the opinions of the court nor the statements or headnotes of cases as prepared by the court or any member thereof (Banks *v.* Manchester, 128 U. S. 244; 9 Sup. Ct. 36); but he can obtain a copyright for it as an author, and such copyright will cover the parts of it of which he is the author, but not the opinions themselves. (Callaghan *v.* Myers, 128 U. S. 617, 645, 650; 9 Sup. Ct. 177.) The compiler and annotator of a volume of state statutes may also copyright his book, and such copyright covers all in it which may fairly be deemed the result of his labors, such as marginal references, notes, memoranda, table of contents, indexes, and digests of judicial decisions prepared by him from original sources of information. (C. C. A., 6th Cir. Nov. 9, 1898.)

HARLAN, Cir. Jus.] *Howell *v.* Miller *et al.*, 91 Fed. Rep. 129.

II. FALSE MARKING.

1. R. S. § 4963, as it read prior to the amendment of 1897,

imposed a penalty upon "any person who shall insert or impress" a copyright notice in or upon any book for which he has not obtained a copyright, and did not apply to a person "who shall issue or sell" such a book bearing a fictitious copyright notice, where it is shown that he did not make the book nor cause the notice to be inserted; such latter provision was the purpose of the amendment of 1897. (C. C. A., 2d Cir. Dec. 7, 1898.)

WALLACE, J.] *Ross *v.* Raphael Tuck & Sons Co., 91 Fed. Rep. 128.

2. An essential element of the copyright notice, as required by R. S. § 4962, is the date of the copyright. The phrases in § 4963, viz., "such notice of copyright or words of the same import" and "a notice of United States copyright," refer most clearly to the notice specified in § 4962; and while the courts have been liberal in holding any form of notice sufficient which contains the essentials of "name," "claim of exclusive right," and "date when obtained," they have not yet sustained the sufficiency of a notice which wholly omits one of these three essentials. (C. C., S. D. N. Y. June 8, 1899.)

LACOMBE, J.] *Hoertel *v.* Raphael Tuck & Sons Co., 94 Fed. Rep. 844.

III. INFRINGEMENT.

(*a*) *In General.*

1. A state cannot authorize its officers or agents to violate a citizen's right of property in a copyright, and then invoke the eleventh amendment of the constitution of the United States to protect those officers or agents against suit by the owner of the copyright for the protection of his rights against injury by such officers or agents. (C. C. A., 6th Cir. Nov. 9, 1898.)

HARLAN, Cir. Jus.] *Howell *v.* Miller *et al.*, 91 Fed. Rep. 129.

2. If property be the subject of litigation, such property belonging to the state and in its actual possession by its officers, a suit against such officers to enjoin them from using or controlling the property would be regarded as a suit against the state, and, for the reasons stated in Belknap *v.* Schild, 161 U. S. 10, 25, 16 Sup. Ct. 443, would be dismissed. **Id.*

3. By an act of the Michigan legislature in 1895 it was pro-

vided that all the general laws of the state should be collected and compiled, without alteration, under appropriate heads and titles, with marginal notes, references, index, and complete digest of the supreme court of the state relating to such general laws. In 1897 provision was made for the printing, binding, distribution and sale of such compilation from the prepared manuscript. The manuscript of the compilation is the property of the state, and the mere preparation of such manuscript and the possession of it by the state do not constitute a legal wrong to the plaintiff, who had some years before published and copyrighted "Howell's Annotated Statutes." He may, however, invoke the aid of a court of equity to restrain the printing and publishing such manuscript, if the printing and publishing of it would infringe his rights under the laws of the United States. **Id.*

4. If the plaintiff has a valid copyright he is entitled, under the constitution and laws of the United States, to the sole liberty of printing, reprinting, publishing and vending the books copyrighted by him. R. S. § 4952. The jurisdiction conferred by statute (R. S. § 4970) upon the federal courts may be exercised for the protection of an individual against any injury to his rights under the copyright statutes by officers of a state. Those officers cannot interpose their official character, or the orders of the state, against such relief as may properly be granted. **Id.*

5. The author of a literary composition may claim it in whatever language or form of words it can be identified as his production. The true test of piracy is, not whether a composition is copied in the same language or the exact words of the original, but whether, in substance, it is reproduced; not whether the whole, but whether a material part is taken without authority. (C. C., N. D. Ills. April 26, 1899.)

SEAMAN, J.] *Maxwell *v.* Goodwin, 93 Fed. Rep. 665.

6. The rule in patent causes at law, that issues of infringement and identity must be passed upon by the jury, is equally applicable to the issues of piracy and infringement of copyright. Under the same rule the court is authorized to set aside a verdict unsatisfactory to itself as against the weight of evidence. **Id.*

7. Where it was the duty of a salaried employé, *inter alia*, to compile, prepare, and revise certain instruction and question papers, the literary product of such work became the property of the employer, which he was entitled to copyright, and which when copyrighted, the employé, after severing his connection with the employer, would have no more right than a stranger to reproduce or copy. (C. C., S. D. N. Y. Apr. 4, 1899.)

LACOMBE, J.] *Colliery Engineer Co. *v.* United Correspondence Schools Co. *et al.*, 94 Fed. Rep. 153.

8. While he was not at liberty to reproduce so much of his work as had been copyrighted by his employer for whom it was prepared, even by availing himself of his recollection of the contents of the copyrighted books and pamphlets, yet the employé was not debarred after his contract terminated from making a new compilation, nor from using the same original sources of information, nor from availing of such information and experience as he may have acquired in the course of his employment. *Id.*

9. Where the chief purpose of a copyrighted pamphlet was to advertise the business of its author and publisher, no copies of the pamphlet being sold or offered for sale but large numbers having been distributed free, and where it is of doubtful commercial value in other respects, *Held*, that these facts afford insufficient foundation to warrant an award of substantial damages for the infringement of the copyright. (C. C., W. D. Mo. June 12, 1899.)

PHILIPS, J.] *D'Ole *v.* Kansas City Star Co., 94 Fed. Rep. 840.

III. INFRINGEMENT.

(*b*) *Injunction.*

1. When the legislature of a state has determined that the public interests require a new compilation of the laws of the state, and the work has been completed, a court of equity should not interfere by injunction to restrain an alleged infringement of copyright, unless the right to such relief is clearly manifest from the evidence. (C. C. A., 6th Cir. Nov. 9, 1898.)

HARLAN, Cir. Jus.] *Howell *v.* Miller *et al.*, 91 Fed. Rep. 129.

2. Where the answer to the question of fact upon which a suit for the piracy of a copyrighted publication turns is not

clear, the granting of a preliminary injunction would be practically a judgment in advance of hearing and might work irreparable damage to the defendants. Under such circumstances it is best to relegate the question to final hearing. (C. C., S. D. N. Y. Apr. 4, 1899.)

LACOMBE, J.] *Colliery Engineering Co. *v.* United Correspondence Schools *et al.*, 94 Fed. Rep. 152.

IV. PENALTIES.

1. The action authorized by § 4965 R. S. in so far as it relates to the recovery of money is one to enforce a penalty and not an action to recover compensation for the actual damage which the plaintiff has sustained by reason of the alleged infringement of his copyright. The money judgment for which the statute provides is one for a penalty, and its character in this respect is not at all affected by the fact that its recovery is to be had in a civil action and not by a criminal prosecution. Nor can the action under this statute be regarded as remedial, because one-half of any judgment recovered is for the use of the plaintiff whose rights have been invaded by the infraction of the law. No provision is made for the recovery of any sum by the plaintiff except as part of an entire penalty, to be divided, it is true, but only by the same judgment by which it is inflicted upon the defendant; and it is apparent that the statute does not contemplate that any recovery shall be had unless the case presented shows that the defendant is justly subject to the entire penalty which the statute provides for its violation. (D. C., N. D. Cal. July 17, 1899.)

DE HAVEN, J.] *McDonald *v.* Hearst, 95 Fed. Rep. 656.

2. Section 4965 R. S. provides for the recovery of a penalty for the infringement of a copyright obtained pursuant to the provisions of § 4956 R. S.; hence, a plaintiff may not maintain an action for the recovery of penalty under § 4965 unless he has complied with the conditions precedent stated in § 4956, which should be strictly construed, because it contains the condition precedent to the recovery of heavy penalties. (C. C. A., 2d Cir. July 18, 1899.)

THOMAS, J.] *Bennett *v.* Carr, 96 Fed. Rep. 213.

3. Section 4956 R. S. provides that; "No person shall be

entitled to a copyright unless he shall * * * * deliver * * * or deposit * * * a printed copy of the title of the book, or a description of the painting; * * * * nor unless he shall also * * * deliver or deposit * * * two copies of such copyright book * * * or in case of a painting * * * a photograph of the same," in the Library of Congress. The statute therefore specifically states that in case of a painting, there must be a description thereof and a photograph of the same, and it may not be read to mean that the deposit of a photograph shall fulfill both requirements, so as to enable the painter to recover penalties for infringement. *Id.*

V. Publication and Sale.

1. "Publication" in copyright law is "the act of making public a book; offering to public notice; that is, offering or communicating it to the public by sale or distribution of copies." Without undertaking to state the qualifications of this definition, as applied to certain incidents, by which the book might be exhibited by its author prior to copyrighting it without amounting to a publication within the spirit of the statute, it is safe to say that the appearance of a book or pamphlet, after its delivery to the plaintiff by the printer or publisher, in a public hotel, subject to be seen and read by any one about the place, was "rendering it accessible to public scrutiny," and was likewise "communicating it to the public by distribution of copies" and rendered a subsequent copyright upon the book void. (C. C., W. D. Mo. June 12, 1899.)

Philips, J.] *D'Ole *v.* Kansas City Star Co., 94 Fed. Rep. 840.

2. The serial publication of a book in a monthly magazine prior to any steps taken toward securing a copyright is such a publication of the same within the meaning of the act of February 3, 1831, as to vitiate a copyright of the whole book obtained subsequently, but prior to the publication of the book as an entity. (Sup. Ct. U. S. Apr. 24, 1899.)

Brown, J.] *Holmes *v.* Hurst, 89 O. G. 189. 174 U. S. 82.

3. It is the settled law of this country and England that the right of an author to a monopoly of his publication is determined by the copyright act, which superseded the common law. *Id.*

4. The right secured by the copyright act is not a right to the use of certain words, because they are the common property of the human race, nor is it the right to ideas alone, since in the absence of means to communicate them they are of value to no one but the author; but the right is to that arrangement of words which the author has selected to express his ideas. **Id.*

5. If the several parts of a publication had been once dedicated to the public and the monopoly of the author thus abandoned, it cannot be reclaimed by collecting such parts together in the form of a book. **Id.*

6. If an author permits his intellectual productions to be published, either serially or collectively, his right to a copyright is lost as effectually as the right of an inventor to a patent upon an invention which he deliberately abandons to the public, and this, too, irrespective of his actual intention to make such abandonment. **Id.*

7. The word "book" as used in the statute is not to be understood in its technical sense of a bound volume, but any species of publication which the author selects to embody his literary production. There is no distinction between the publication of a book and the publication of the contents of such book, whether such contents be published piecemeal or *en bloc*. **Id.*

8. There is no fixed time within which an author must apply for copyright, so that it be "before publication," and if the publication of the parts serially be not a publication of the book a copyright might be obtained after the several parts, whether published separately or collectively, had been in general circulation for years. This cannot be within the spirit of the copyright act. **Id.*

Damages and Profits.

I. Estimation and Measure of.

II. Nominal.

I. Estimation and Measure of.

1. Generally, the profit derived by a defendant from his incorporation of an infringing article into his ultimate product, is to be measured by the excess in price which he has received for that product by his wrongful inclusion therein of the patented

thing. But this measure is not exclusive of all others. If there has been a profit in fact and that profit can be shown in any legitimate mode, the plaintiff is entitled to recover it; and it would be quite as legitimate to establish the existence of a profit by showing that the defendants by using the infringing article had cheapened the cost of their product, as by showing that by such use they had enhanced the price of that product. (C. C., E. D. Penn. Dec. 21, 1898.)

DALLAS, J.] *Rose *v.* Hirsch *et al.*, 91 Feb. Rep. 149.

2. The law is solicitous that wrongdoers shall not profit by wrongdoing, but it does not sanction the substitution of unfounded conjecture for proof in determining either the fact of the existence of profit or the amount thereof, and where the plaintiff has failed to adduce evidence from which a finding of profits upon any theory can be founded, no decree for profits can be given. **Id.*

3. In an action at law for damages for the infringement of a patent, if the plaintiff shows no established license fee, no market price, and no other use than that of the defendant, there is no basis for computation of substantial damages, and he can only recover nominal damages. (C. C. A., 1st Cir. Dec. 9, 1898.)

PUTNAM, J.] *City of Boston *v.* Allen, 91 Fed. Rep. 248.

4. In proving profits it is necessary to show a saving by the use of the infringing tool over the cost of operating any other tool which the defendant was free to use. (C. C. A., 2d Cir. Jan. 5, 1899.)

LACOMBE, J.] *Hohorst *v.* Hamburg-American Packet Co. *et al.*, 91 Fed. Rep. 655.

5. Where it is shown that prior to November, 1894, the patented articles could not be purchased except from the patentee, who alone made them and who maintained a close monopoly of their manufacture, and that the infringers purchased such articles from him and thus acquiesced in the monopoly of his patent from 1891 to June, 1894, at which latter date they ceased buying of the patentee and thereafter deliberately infringed his patent until enjoined in this case, it is reasonable to conclude that if they had not thus deliberately and wantonly

become infringers and wrongfully trespassed upon the patentee's rights, they would have purchased from him the articles they used. (C. C. A., 3d Cir. May 4, 1899.)

BUFFINGTON, J.] *Rose *v.* Hirsh *et al.*, 94 Fed. Rep. 177.

6. These facts unite to afford substantial, not mere conjectural grounds upon which to base the conclusion that the patentee, by the infringers' wrongful acts lost the sale of articles purchased elsewhere, and to that extent he was damaged. **Id.*

7. Where the operations of the manufacturing patentee are exceedingly simple, and the cost of raw materials used is easily ascertained, a comparatively easy basis is afforded for determining the operative cost and the cost of the product of his manufacture, and where the evidence as to such cost is not only not disputed, but is corroborated by the evidence for the defendant infringers, no grounds exist for the conclusion of the master that "the evidence presents no definite basis upon which damages can be assessed." **Id.*

8. In ascertaining the profits of a corporation, due to its manufacture and sale of an article in infringement of a patent, where such manufacture and sale constitute but a minor part of the business, it is improper, in computing general expenses, to include such items as interest on dividends to stockholders, insurance, taxes, attorneys' fees, or physicians' fees while in attendance upon an injured employee; but a sum paid to a commercial agency for information as to credits, etc., is a proper part of sale expenses and may be included, inasmuch as it is the ordinary method by which business men regulate their sales. (C. C., S. D. Ohio, W. D. July 10, 1899.)

TAFT, J.] *Nat'l Folding-Box & Paper Co. *v.* Dayton Paper Novelty Co. *et al.*, 95 Fed. Rep. 991.

9. It is also proper in such a case to include "the usual salaries of the managing officers" as a part of the general expenses, but where such salaries seem to be excessive, and to be really a division of profits, they should be cut down to a reasonable figure. **Id.*

10. Where in a suit upon the same patent in another circuit, and against parties in privity with the defendants in the suit at bar, the finding of the circuit court of appeals that all of

the profits from the sale of the infringing articles were due to the patented invention of complainant, is binding upon the court. *Id.*

11. The profits allowed in equity for the injury that a patentee has sustained by the infringement of his patent are to be considered as a measure of unliquidated damages, which, as a general rule and in the absence of special circumstances, do not bear interest until their amount has been judicially ascertained; infringement of a fraudulent or wanton character may justify the imposition of interest under the decisions of the supreme court. (C. C., S. D. Ohio. Nov. 2, 1899.)

TAFT, J.] *Nat'l Folding-Box & Paper Co. *v.* Dayton Paper Novelty Co. *et al.*, 97 Fed. Rep. 331.

II. NOMINAL.

Where the defendant has derived an advantage from the use of the infringing device, but the character of the testimony by which this fact was established was so conflicting and uncertain, and the knowledge of the witnesses was so limited in scope, that it was manifestly impossible to obtain therefrom any basis of calculation from which to determine with any degree of certainty, either the extent of the use of the infringing devices, or the saving effected, or profits derived from such use, nominal damages only can be recovered. (C. C. A., 2d Cir. Jan. 5, 1899.)

LACOMBE, J.] *Hohorst *v.* Hamburg-American Packet Co. *et al.*, 91 Fed. Rep. 655.

Decisions of the Commissioner of Patents.

I. AFFIRMED ON APPEAL TO COURT OF APPEALS, D. C.

II. REVERSED ON APPEAL TO COURT OF APPEALS, D. C.

III. AFFIRMED IN PART AND REVERSED IN PART.

I. AFFIRMED ON APPEAL TO THE COURT OF APPEALS, D. C.

Marvel *v.* Decker *et al.*, 86 O. G. 348. Dec. 9, 1898. Morris, J.

Nimmy *v.* Com'r of Patents, 86 O. G. 345. Dec. 9, 1898. Morris, J.

Pickles *v.* Aglar, 86 O. G. 346. Dec. 9, 1898. Morris, J.

Cain *v.* Park, 86 O. G. 797. Jan. 3, 1899. Shepard, J.

Esty *v.* Newton, 86 O. G. 799. Jan. 3, 1899. Shepard, J.

Traver *v.* Brown, 86 O. G. 1324. Jan. 3, 1899. Shepard, J.

Winslow *v.* Austin, 86 O. G. 2171. Jan. 10, 1899. Alvey, C. J.

Smith *v.* Duell, Com'r of Pats., 87 O. G. 893. Feb. 7, 1899. Shepard, J.

Fowler *v.* Dodge, 87 O. G. 895. Apr. 4, 1899. Morris, J.

Barratt *v.* Duell, Com'r of Pats., 87 O. G. 1076. Morris, J.

Cross *v.* Phillips, 87 O. G. 1399. Feb. 8, 1899. Shepard, J.

Bedford *v.* Duell, Com'r of Pats., 87 O. G. 1611. Alvey, C. J.

Williams *v.* Ogle, 87 O. G. 1958. Jan. 17, 1899. Alvey, C. J.

Reute *v.* Elwell, 87 O. G. 2119. May 4, 1899. Shepard, J.

Mower *v.* Duell, Com'r of Pats., 88 O. G. 191. June 6, 1899. Alvey, C. J.

Lowry *v.* Duell, Com'r of Pats., 88 O. G. 717. Apr. 4, 1899. Shepard, J.

Foster *v.* Antisdel, 88 O. G. 1527. May 2, 1899. Alvey, C. J.

Hulett *v.* Long, 89 O. G. 1141. Oct. 4, 1899. Alvey, C. J.

II. Reversed on Appeals to Court of Appeals, D. C.

Tracy *et al. v.* Leslie, 87 O. G. 891. Jan. 10, 1899. Shepard, J.

Marsden *v.* Duell, Com'r of Patents, 87 O. G. 1239. Feb. 8, 1899. Morris, J.

III. Affirmed in Part and Reversed in Part on Appeal to the Court of Appeals, D. C.

Bader *v.* Vajen, 87 O. G. 1235. Feb. 8, 1899. Morris, J.

De Wallace *v.* Scott *et al.*, 88 O. G. 1704. June 6, 1899. Shepard, J.

Griffin *v.* Swenson, 89 O. G. 919. June 6, 1899. Morris, J.

Decisions of the Federal Courts.

I. Affirmed on Appeal.

II. Reversed on Appeal.

III. Appeals Dismissed.

IV. Disposition of Motions for Rehearing.

I. Affirmed on Appeal.

1. Norton *et al. v.* Jensen, 81 Fed. Rep. 494. Appealed from the Circuit Court of the United States for the District of

Oregon. Judgment of the court below affirmed. (C. C. A., 9th Cir. Oct. 24, 1898.)

MORROW, J.] *Norton *et al. v.* Jensen, 90 Fed. Rep. 415.

2. Vermilya *v.* Pennsylvania Steel Co. *et al.*, 87 Fed. Rep. 481. Appealed from the Circuit Court of the United States for the Eastern District of Pennsylvania. Decree of the Circuit Court affirmed. (C. C. A., 3d Cir. Nov. 28, 1898.)

ACHESON, J.] *Pennsylvania Steel Co. *et al. v.* Vermilya, 90 Fed. Rep. 493.

3. Brill *v.* St. Louis Car Co. *et al.*, 80 Fed. Rep. 909. Appealed from the Circuit Court of the United States for the Eastern District of Missouri. Decree of the Circuit Court affirmed. (C. C. A., 8th Cir. Nov. 28, 1898.)

THAYER, J.] *Brill *v.* St. Louis Car Co. *et al.*, 90 Fed. Rep. 666.

4. United States Glass Co. *v.* Atlas Glass Co. *et al.*, 88 Fed. Rep. 493. Sand. Pat. Dig. '98, 5, 119. Appealed from the Circuit Court of the United States for the Western District of Pennsylvania. (C. C. A., 3d Cir. Dec. 6, 1898.)

DALLAS, J.] *United States Glass Co. *v.* Atlas Glass Co. *et al.*, 90 Fed. Rep. 724.

5. Van Camp Packing Co. *v.* Cruikshanks Bros. Co., not reported. Appealed from the Circuit Court of the United States for the Western District of Pennsylvania. Refusing grant of preliminary injunction. Appeal dismissed and order of the lower court affirmed. (C. C. A., 3d Cir. Nov. 28, 1898.)

BUTLER, J.] *Van Camp Packing Co. *v.* Cruikshanks Bros. Co., 90 Fed. Rep. 814.

6. Solvay Process Co. *v.* Michigan Alkali Co., not reported. Appealed from the Circuit Court of the United States for the Eastern District of Michigan. Decree of the Circuit Court affirmed. (C. C. A., 6th Cir. Nov. 28, 1898.)

TAFT, J.] *Solvay Process Co. *v.* Michigan Alkali Co. *et al.*, 90 Fed. Rep. 818.

7. Societe Anonyme du Filtre Chamberland Systeme Pasteur *et al. v.* Allen *et al.*, 84 Fed. Rep. 812. Sand. Pat. Dig. '98, 47, 49. Appealed from the Circuit Court of the United States

for the Western Division of the Northern District of Ohio. Order of lower court refusing injunction affirmed. (C. C. A., 6th Cir. Nov. 9, 1898.)

TAFT, J.] *Societe Anonyme du Filtre Chamberland Systeme Pasteur *et al. v.* Allen *et al.*, 90 Fed. Rep. 815.

8. United States Mitis Co. *v.* Carnegie Steel Co. Lim., 89 Fed. Rep. 206, 343. Sand. Pat. Dig. 1898, 101, 131. Appealed from the Circuit Court of the United States for the Western District of Pennsylvania. No opinion. Affirmed. (C. C. A., 3d Cir. Oct. 21, 1898.)

*Carnegie Steel Co. Lim. *v.* United States Mitis Co., 90 Fed. Rep. 829.

9. Von Mum *et al. v.* Witteman *et al.*, 85 Fed. Rep. 966. Appealed from the Circuit Court of the United States for the Southern District of New York. Decree of the Circuit Court affirmed. (C. C. A., 2d Cir. Dec. 7, 1898.)

PER CURIAM.] *Von Mum *et al. v.* Witteman *et al.*, 91 Fed. Rep. 126.

10. Ross *v.* Raphael Tuck & Sons Co., not reported. In Error to the Circuit Court of the United States for the Southern District of New York. Judgment of the Circuit Court affirmed. (C. C. A., 2d Cir. Dec. 7, 1898.)

WALLACE, J.] Ross *v.* Raphael Tuck & Sons Co., 91 Fed. Rep. 128.

11. Howell *v.* Miller *et al.*, not reported. Appealed from the Circuit Court of United States for the Eastern District of Michigan. The order denying injunction affirmed. (C. C. A., 6th Cir. Nov. 9, 1898.)

HARLAN, Cir. Jus.] *Howell *v.* Miller *et al.*, 91 Fed. Rep. 129.

12. Electric Car Co. of America *et al. v.* Nassau Electric Ry. Co., 89 Fed. Rep. 204. Appealed from the Circuit Court of the United States for the Eastern District of New York. Order of the Circuit Court granting a preliminary injunction affirmed. (C. C. A., 2d Cir. Dec. 7, 1898.)

SHIPMAN, J.] *Electric Car Co. of America *et al. v.* Nassau Electric Ry. Co., 91 Fed. Rep. 142.

13. Lovell *v.* Johnson, 82 Fed. Rep. 206. Appealed from

the Circuit Court of the United States for the District of Massachusetts. Decree of the Circuit Court dismissing the bill affirmed. (C. C. A., 1st Cir. Dec. 27, 1898.)

COLT, J.] *Lovell *v.* Johnson, 91 Fed. Rep. 160.

14. Deering Harvester Co. *v.* Whitman & Barnes Mfg. Co., 86 Fed. Rep. 764. Sand. Pat. Dig. 1898, 153. Appealed from the Circuit Court of the United States for the Northern District of Ohio. Decree of the Circuit Court affirmed. (C. C. A., 6th Cir. Dec. 19, 1898.)

LURTON, J.] *Deering Harvester Co. *v.* Whitman & Barnes Mfg. Co., 91 Fed. Rep. 376.

15. Hohorst *v.* Hamburg-American Packet Co., 84 Fed. Rep. 354. 82 O. G. 898, Sand. Pat. Dig. 23. Appealed from the Circuit Court of the United States for the Southern District of New York. Decree of the Circuit Court affirmed. (C. C. A., 2d Cir. Jan. 5, 1899.)

LACOMBE, J.] *Hohorst *v.* Hamburg-American Packet Co. *et al.*, 91 Fed. Rep. 655.

16. Thomson-Houston Electric Co. *v.* Athol and Orange St. Ry. Co., 83 Fed. Rep. 203. Sand. Pat. Dig. 1898, 114. Appealed from the Circuit Court of the United States for the District of Massachusetts. Decree of Circuit Court affirmed. (C. C. A., 1st Cir. Jan. 26, 1899.)

COLT, J.] *Thomson-Houston Electric Co. *v.* Athol and Orange St. Ry. Co., 91 Fed. Rep. 767.

17. William Schollhorn Co. *v.* Bridgeport Mfg. Co. *et al.*, 84 Fed. Rep. 674. Appealed from the Circuit Court of the United States for the District of Connecticut. Decree of Circuit Court affirmed. (C. C. A., 2d Cir. Jan. 2, 1899.)

SHIPMAN, J.] *Bridgeport Mfg. Co. *et al.* *v.* William Schollhorn, 91 Fed. Rep. 775.

18. Thatcher Mfg. Co. *v.* Creamery Package Mfg. Co. *et al.*, not reported. Appealed from the Circuit Court of the United States for the Northern District of Illinois, Northern Division. Decree of the Circuit Court, dismissing the bill for want of equity, affirmed. (C. C. A., 7th Cir. Feb. 7, 1899.)

PER CURIAM.] *Thatcher Mfg. Co. *v.* Creamery Package Mfg. Co. *et al.*, 91 Fed. Rep. 919.

19. Schrei *et al. v.* Morris *et al.*, 87 Fed. Rep. 217. Appealed from the Circuit Court of the United States for the Northern District of Illinois. Decree of the Circuit Court dismissing the bill affirmed. (C. C. A., 7th Cir. Feb. 16, 1899.)

BUNN, J.] Schrei *et al. v.* Morris *et al.*, 91 Fed. Rep. 992.

20. Doig *v.* Morgan Machine Co., 89 Fed. Rep. 489. Sand. Pat. Dig., 1898, 50. Appealed from the Circuit Court of the United States for the Northern District of New York. Order granting preliminary injunction affirmed. (C. C. A., 2d Cir. Jan. 5, 1899.)

PER CURIAM.] * Doig *v.* Morgan Machine Co., 91 Fed. Rep. 1001.

21. Graham *v.* Earl, not reported. In error to the Circuit Court of the United States for the Northern District of California. Judgment of the Circuit Court affirmed. (C. C. A., 9th Cir. Oct. 24, 1897.)

DE HAVEN, J.] * Graham *v.* Earl, 82 Fed. Rep. 737; 92 Fed. Rep. 155.

22. Wilson *et al. v.* McCormick Harvesting Mach. Co., not reported. Appealed from the Circuit Court of the United States for the Northern District of Illinois, Northern Division. Decree dismissing complainant's bill affirmed. (C. C. A., 7th Cir. Feb. 16, 1899.)

WOODS, J.] * Wilson *et al. v.* McCormick Harvesting Mach. Co., 92 Fed. Rep. 167.

23. Western Electric Co. *v.* Western Tel. Const. Co., 81 Fed. Rep. 572. Appealed from the Circuit Court of the United States for the Northern District of Illinois, Northern Division. Decree dismissing complainant's bill affirmed. (C. C. A., 7th Cir. Feb. 16, 1899.)

WOODS, J.] * Western Electric Co. *v.* Western Tel. Const. Co., 92 Fed. Rep. 181.

24. Proctor & Gamble Co. *v.* Globe Refining Co., not reported. Appealed from the Circuit Court of the United States for the District of Kentucky. Order denying a preliminary injunction affirmed. (C. C. A., 6th Cir. Mar. 7, 1899.)

SEVERENS, J.] * Proctor & Gamble Co. *v.* Globe Refining Co., 92 Fed. Rep. 357.

25. Ginna *et al. v.* Mersereau Mfg. Co., 69 Fed. Rep. 344. Appealed from the Circuit Court of the United States for the District of New Jersey. Decree of the Circuit Court dismissing the bill affirmed. (C. C. A., 3d Cir. Jan. 25, 1899.)

DALLAS, J.] *Ginna *et al. v.* Mersereau Mfg. Co., 92 Fed. Rep. 369.

26. Universal Milling Co. *v.* Willimantic Linen Co., 82 Fed. Rep. 228. Appealed from the Circuit Court of the United States for the District of Connecticut. Decree affirmed. (C. C. A., 2d Cir. Jan. 25, 1899.)

PER CURIAM.] *Universal Milling Co. *v.* Willimantic Linen Co., 92 Fed. Rep. 391.

27. Chambers Bros. Co. *v.* Penfield, not reported. Appealed from the Circuit Court of the United States for the Northern District of Ohio. Decree affirmed as to claim 24 of patent No. 297,671. (C. C. A., 6th Cir. Mar. 7, 1899.)

TAFT, J.] *Penfield *v.* Chambers Bros. Co., 92 Fed. Rep. 630.

28. Loewenbach *v.* Hake-Stirn Co., not reported. Appealed from the Circuit Court of the United States for the Eastern District of Wisconsin. Decree dismissing bill affirmed. (C. C. A., 7th Cir. Feb. 23, 1899.)

PER CURIAM.] *Loewenbach *v.* Hake-Stirn Co., 92 Fed. Rep. 661.

29. Kelly *et al. v.* Springfield Ry. Co. *et al.*, 81 Fed. Rep. 617. Appealed from the Circuit Court of the United States for the Southern District of Ohio, Western District. Decree dismissing the bill affirmed. (C. C. A., 6th Cir. Mar. 7, 1899.)

TAFT, J.] *Kelly *et al. v.* Springfield Ry. Co. *et al.*, 92 Fed. Rep. 614.

30. E. Ingraham Co. *v.* E. N. Welch Mfg. Co., 87 Fed. Rep. 1000. Sand. Pat. Dig. 1898, 106, 107. Appealed from the Circuit Court of the United States for the District of Connecticut. Decree of the Circuit Court affirmed. (C. C. A., 2d Cir. Mar. 1, 1899.)

PER CURIAM.] *E. Ingraham Co. *v.* E. N. Welch Mfg. Co. *et al.*, 92 Fed. Rep. 1019.

31. Wm. Mumsen & Sons *v.* Manitowoc Pea-Packing Co.,

not reported. Appealed from the Circuit Court of the United States for the Eastern District of Wisconsin. Order of the Circuit Court affirmed. (C. C. A., 7th Cir. Apr. 11, 1899.)

Woods, J.] *Manitowoc Pea-Packing Co. *v.* Wm. Mumsen & Sons, 93 Fed. Rep. 196.

32. Palmer *v.* Curnen *et al.*, 84 Fed. Rep. 829. Appealed from the Circuit Court of the United States for the Southern District of New York. Decree of Circuit Court affirmed. (C. C. A., 2d Cir. Mar. 1. 1899.)

Per Curiam.] *Palmer *v.* Curnen *et al.*, 93 Fed. Rep. 464.

33. Sarrazin *v.* W. R. Irby Cigar & Tobacco Co. Lim., not reported. In Error to the Circuit Court of the United States for the Eastern District of Louisiana. Judgment of the Circuit Court affirmed. (C. C. A., 5th Cir. Apr. 11, 1899.)

Pardee, J.] *Sarrazin *v.* W. R. Irby Cigar & Tobacco Co. Lim., 93 Fed. Rep. 624.

34. Richardson *v.* D. M. Osborne & Co. *et al.*, 82 Fed. Rep. 95. Appealed from the Circuit Court of the United States for the Northern District of New York. Decree of the Circuit Court affirmed. (C. C. A., 2d Cir. Apr. 4, 1899.)

Shipman, J.] *Richardson *v.* D. M. Osborne & Co. *et al.*, 93 Fed. Rep. 828.

35. Warren *v.* Casey *et al.*, 91 Fed. Rep. 653. Appealed from the Circuit Court of the United States for the Eastern District of Pennsylvania. Decree of the court below that the charge of infringement had not been made out, affirmed. (C. C. A. May 1, 1899.)

Kirkpatrick, J.] *Warren *v.* Casey *et al.*, 93 Fed. Rep. 963.

36. Christy *et al. v.* Hygeia Pneumatic Bicycle Saddle Co. *et al.*, 87 Fed. Rep. 902. Appealed from the Circuit Court of the United States for the District of Maryland. Decree dismissing the bill affirmed. (C. C. A., 4th Cir. May 2, 1899.)

Goff, J.] *Christy *et al. v.* Hygeia Pneumatic Bicycle Saddle Co. *et al.*, 93 Fed. Rep. 965.

37. Ryan *v.* Runyon *et al.*, not reported. Appealed from the Circuit Court of the United States for the District of New

Jersey. Decree of the Circuit Court affirmed. (C. C. A., 3d Cir. May 4, 1899.)

ACHESON, J.] *Ryan *v.* Runyon *et al.*, 93 Fed. Rep. 970.

38. Briggs *v.* Duell, Commissioner of Patents, 87 Fed. Rep. 479. Appealed from the Circuit Court of the United States for the District of Connecticut. Decree dismissing the bill affirmed. (C. C. A., 2d Cir. Apr. 4, 1899.)

LACOMBE, J.] *Briggs *v.* Duell, Com. of Patents, 95 Fed. Rep. 972; 87 O. G. 1077.

39. Sarrazin *v.* Augustus Craft Co., Lim. In error to the Circuit Court of the United States for the Eastern District of Louisiana. The pleadings, rulings and other questions involved in this case are the same as those involved in Sarrazin *v.* Tobacco Co. 93 Fed. Rep. and for the reasons therein stated, the judgment of the Circuit Court is affirmed. (C. C. A., 5th Cir. Apr. 11, 1899.)

PARDEE, J.] *Sarrazin *v.* Augustus Craft Co. *et al.*, 93 Fed Rep. 988.

40. Overweight Counterbalance Elevator Co. *v.* Improved Order of Red Men's Hall Association of San Francisco, 86 Fed. Rep. 338; Sand. Pat. Dig. '98, 46, 47. In error from the Circuit Court of the United States for the Northern District of California. Judgment of the Circuit Court affirmed. (C. C. A., 9th Cir. Feb. 13, 1899.)

HAWLEY, J.] *Overweight Counterbalance Elevator Co. *v.* Improved Order of Red Men's Hall Association of San Francisco, 94 Fed. Rep. 155.

41. Sarrazin *v.* Preston *et al.* In error to the Circuit Court of the United States for the Eastern District of Louisiana. For the reasons given in Sarrazin *v.* W. R. Irby Tobacco Co., 93 Fed, Rep. 624, the judgment of the Circuit Court is affirmed. (C. C. A., 5th Cir. June 1, 1899.)

PER CURIAM.] *Sarrazin *v.* Preston *et al.*, 94 Fed. Rep. 1023.

42. Blakey *et al. v.* Nat'l Mfg. Co. *et al.* Appealed from the Circuit Court of the United States for the Western District of Pennsylvania. Decree of the lower court denying preliminary

injunction affirmed for the reason that infringement was not clearly established. (C. C. A., 3d Cir. June 1, 1899.)

DALLAS, J.] *Blakey *et al. v.* Nat'l Mfg. Co., 95 Fed. Rep. 136.

43. United States Repair & Guaranty Co. *et al. v.* Standard Paving Co., 87 Fed. Rep. 339. Appealed from the Circuit Court of the United States for the Northern District of New York. Decree of lower court affirmed. (C. C. A., 2d Cir. May 25, 1899.)

SHIPMAN, J.] *United States Repair & Guaranty Co. *et al. v.* Standard Paving Co., 95 Fed. Rep. 137.

44. Nelson *et al. v.* A. D. Farmer & Son Type Founding Co., 91 Fed. Rep. 418. Appealed from the Circuit Court of the United States for the Southern District of New York. Decree of lower court affirmed in the main but modified as to several of the claims in question. (C. C. A., 2d Cir. May 25, 1899.)

SHIPMAN, J.] *Nelson *et al. v.* A. D. Farmer & Son Type Founding Co. *et al.*, 95 Fed. Rep. 145.

45. Western Electric Co. *v.* Millheim Electric Tel. Co. *et al.*, 88 Fed. Rep. 505; Sand. Pat. Dig., 1898, 5, 6, 116. Appealed from the Circuit Court of the United States for the Western District of Pennsylvania. Decree of lower court affirmed. (C. C. A., 3d Cir. June 8, 1899.)

KIRKPATRICK, J.] *Millheim Electric Tel. Co. *et al. v.* Western Electric Co., 95 Fed. Rep. 152.

46. Cushman Paper Box Mach. Co. *v.* Goddard *et al*, 90 Fed. Rep. 727; Sand. Pat. Dig. 1899. Appealed from the Circuit Court of the United States for the District of Massachusetts. Decree affirmed. (C. C. A., 1st Cir. June 1, 1899.)

PUTNAM, J.] *Cushman Paper Box Mach. Co. *v.* Goddard *et al.* 88 O. G. 2410, 95 Fed. Rep. 664.

47. Sprague Electric Ry. & Motor Co. *v.* Nassau Electric Ry. Co., 91 Fed. Rep. 786. Sand. Pat. Dig. 1899. Appealed from the Circuit Court of the United States for the Eastern District of New York. The part of the order denying an injunction is affirmed; the part granting an injunction is reversed. (C. C. A., 2d Cir. May 25, 1899.)

PER CURIAM.] *Sprague Electric Ry. & Motor Co. *v.* Nassau Electric Ry. Co., 95 Fed. Rep. 821.

48. MacColl *v.* Knowles Loom W'ks, 87 Fed. Rep. 727, Sand. Pat. Dig. 1898, 117. Appealed from the Circuit Court of the United States for the District of Massachusetts. Decree affirmed. (C. C. A., 1st Cir. May 31, 1899.)

COLT, J.] *MacColl *v.* Knowles Loom W'ks, 95 Fed. Rep. 982.

49. MacColl *v.* Crompton Loom W'ks, 87 Fed. Rep. 731. Appealed from the Circuit Court of the United States for the District of Massachusetts. Decree affirmed. (C. C. A., 1st Cir. May 31, 1899.)

COLT, J.] *MacColl *v.* Crompton Loom W'ks, 95 Fed. Rep. 987.

50. Bass *et al. v.* Henry Zeltner Brewing Co., 87 Fed. Rep. 468. Appealed from the Circuit Court of the United States for the Southern District of New York. Decree affirmed upon opinion of court below. (C. C. A., 2d Cir. Mar. 17, 1899.)

PER CURIAM.] *Bass *et al. v.* Henry Zeltner Brewing Co., 95 Fed. Rep. 1006.

51. Flomerfelt *v.* Newwitter *et al.*, 88 Fed. Rep. 696. Sand. Pat. Dig. 1898, 6, 30. Appealed from the Circuit Court of the United States for the Southern District of New York. Decree affirmed on opinion of court below. (C. C. A., 2d Cir. Mar. 15, 1899.)

PER CURIAM.] *Flomerfelt *v.* Newwitter *et al.*, 95 Fed. Rep. 1006.

52. Wm. Rogers Mfg. Co. *v.* Rogers, 84 Fed. Rep. 639. Appealed from the Circuit Court of the United States for the Eastern District of New York. Order denying preliminary injunction affirmed. WALLACE, C. J. concurring in opinion of court below and SHIPMAN, C. J. dissenting. (Before WALLACE and SHIPMAN, C. Js.)

PER CURIAM.] *Wm. Rogers Mfg. Co. *v.* Rogers, 95 Fed. Rep. 1007.

53. Thompson *et al. v.* N. T. Bushnell Co., 88 Fed. Rep. 81. Appealed from the Circuit Court of the United States for the District of Connecticut. Decree affirmed. WALLACE, J. dissenting. (C. C. A., 2d Cir. May 25, 1899.)

LACOMBE, J.] *Thompson *et al. v.* N. T. Bushnell Co., 96 Fed. Rep. 238.

54. Way *v.* McClarin, 91 Fed. Rep. 663. Sand. Pat. Dig., 1899. Appealed from the Circuit Court of the United States for the Eastern District of Pennsylvania. Decree affirmed and appeal dismissed. (C. C. A., 3d Cir. May 9, 1899.)

BUFFINGTON, J.] *Way *v.* McClarin, 96 Fed. Rep. 416.

55. Ball & Socket Fastener Co. *v.* C. A. Edgarton Mfg. Co. Appealed from the Circuit Court of the United States for the District of Massachusetts. Decree dismissing bill affirmed. (C. C. A., 1st Cir. May 26, 1899.)

PUTNAM, J.] *Ball & Socket Fastener Co. *v.* C. A. Edgarton Mfg. Co., 96 Fed. Rep. 489.

56. Union Switch & Signal Co. *et al. v.* Philadelphia & R. R. Co. *et al.*, 87 Fed. Rep. 906. Appealed from the Circuit Court of the United States for the Eastern District of Pennsylvania. Decree affirmed. (C. C. A., 3d Cir. Sept. 13, 1899.)

KIRKPATRICK, J.] *Union Switch & Signal Co. *et al. v.* Philadelphia & R. R. Co., 96 Fed. Rep. 761.

57. Westinghouse Air-Brake Co. *v.* New York Air-Brake Co. *et al.*, 87 Fed. Rep. 882. Appealed from the Circuit Court of the United States for the Southern District of New York. Decree of the Circuit Court affirmed. LACOMBE, J., dissenting. (C. C. A., 2d Cir. July 18, 1899.)

SHIPMAN, J.] *Westinghouse Air-Brake Co. *v.* New York Air-Brake Co. *et al.*, 96 Fed. Rep. 991.

58. Buzzell *v.* Reynolds, not reported. Appealed from the Circuit Court of the United States for the District of Massachusetts. Decree of the Circuit Court affirmed. (C. C. A., 1st Cir. Sept. 14, 1899.)

COLT, J.] *Reynolds *v.* Buzzell, 96 Fed. Rep. 997.

59. C. & A. Potts & Co. *v.* Creager *et al.*, 77 Fed. Rep. 454. Appealed from the Circuit Court of the United States for the Southern District of Ohio. Decree of the Circuit Court dismissing the bill as to the patent to Potts, No. 368,898, affirmed. (C. C. A., 6th Cir. Oct. 23, 1899.)

TAFT, J.] *C. & A. Potts & Co. *v.* Creager *et al.*, 97 Fed. Rep. 78.

60. Westinghouse Electric & Mfg. Co. *v.* Triumph Electric

Co., not reported. Appealed from the Circuit Court of the United States for the Southern District of Ohio. Decree dismissing bill affirmed. (C. C. A., 6th Cir. Oct. 3, 1897.)

TAFT, J.] *Westinghouse Electric & Mfg. Co. *v.* Triumph Electric Co., 97 Fed. Rep. 99.

61. McBride *v.* Kingman *et al.* Same *v.* Sickels *et al.* Same *v.* Randall *et al.* Same *v.* Ainsworth *et al.*, 72 Fed. Rep. 908. Appealed from the Circuit Court of the United States for the Southern District of Iowa. Decree dismissing bills affirmed. (C. C. A., 8th Cir. Oct. 9, 1899.)

SANBORN, J.] *McBride *v.* Kingman *et al.* Same *v.* Sickels *et al.* Same *v.* Randall *et al.* Same *v.* Ainsworth, *et al.*, 97 Fed. Rep. 217.

62. Coburn Trolley-Track Co. *v.* Chandler *et al.*, 91 Fed. Rep. 260. Sand. Pat. Dig. 1899. Appealed from the Circuit Court of the United States for the District of Massachusetts. Decree affirmed. (C. C. A., 1st Cir. Sept. 14, 1899.)

PUTNAM, J.] *Coburn Trolley-Track Mfg. Co. *v.* Chandler *et al.*, 97 Fed. Rep. 333.

63. Kenney *v.* Bent, 91 Fed. Rep. 259. Sand. Pat. Dig. 1899. Appealed from the Circuit Court of the United States for the District of Massachusetts. Decree affirmed. (C. C. A., 1st Cir. Sept. 14, 1899.)

PUTNAM, J.] *Kenney *v.* Bent, 97 Fed. Rep. 337.

64. Kisinger-Ison Co. *v.* Bradford Belting Co., not reported. Appealed from the Circuit Court of the United States for the Southern District of Ohio, Western Division. Decree affirmed as to the Kisinger patent. (C. C. A., 6th Cir. Oct. 3, 1899.)

TAFT, J.] *Kisinger-Ison Co. *v.* Bradford Belting Co., 97 Fed. Rep. 502.

II. REVERSED ON APPEAL.

1. Thomas Roberts Stevenson Co. *v.* McFassell, 88 Fed. Rep. 278. Sand. Pat. Dig. 1898, 115. Appealed from the Circuit Court of the United States for the Eastern District of Pennsylvania. Decree of the Circuit Court reversed, and the case re-

manded to that court with direction to enter a decree in favor of the complainant in the bill. (C. C. A., 3d Cir. Nov. 28, 1898.)

ACHESON, J.] *Thomas Roberts Stevenson Co. *v.* McFassell, 90 Fed. Rep., 707.

2. Palmer Pneumatic Tire Co. *v.* Lozier, 84 Fed. Rep. 659. Sand. Pat. Dig. '98, 36, 95. Appealed from the Circuit Court of the United States for the Eastern Division of the Northern District of Ohio. Decree of the Circuit Court reversed, and the cause remanded, with direction to dismiss the bill and deny the relief prayed for by the answer, for the reason that the court finds that the respective patents alleged in the bill to be interfering patents are void in respect to the claims in controversy, for lack of invention. (C. C. A., 6th Cir. Dec. 5, 1898.)

SEVERENS, J.] *Palmer Pneumatic Tire Co. *v.* Lozier, 90 Fed. Rep. 732.

3. Hughes *et al. v.* American Box-Mach. Co., not reported. Appealed from the Circuit Court of the United States for the Southern District of New York. Interlocutory order granting an injunction *pendente lite* reversed, with costs. *Held*, also, that the patent in suit was not infringed. (C. C. A., 2d Cir. Dec. 7, 1898.)

SHIPMAN, J.] *American Box-Mach. Co. *v.* Hughes *et al.*, 91 Fed. Rep. 147.

4. Stuart *v.* F. G. Stewart Co. *et al.*, 85 Fed. Rep. 778. Appealed from the Circuit Court of the United States for the Northern District of Illinois. Decree of the Circuit Court reversed and the cause remanded with directions to enter a decree in favor of the complainant (appellant) pursuant to the prayer of the bill. (C. C. A., 7th Cir. Jan. 3, 1899.)

JENKINS, J.] *Stuart *v.* F. G. Stewart Co. *et al.*, 91 Fed. Rep. 243.

5. Allen *v.* City of Boston, not reported. In error to the Circuit Court of the United States for the District of Massachusetts. Judgment of the Circuit Court reversed and the case remanded to that court with directions to set aside the verdict and proceed thereafter according to law unless the plaintiff below shall, within such time as that court may direct, remit all

damages in excess of one dollar. (C. C. A., 1st Cir. Dec. 9, 1898.)

PUTNAM, J.] *City of Boston *v.* Allen, 91 Fed. Rep. 248.

6. Joliet Mfg. Co. *v.* Sandwich Enterprise Co., not reported. Appeal from the Circuit Court of the United States for the Northern District of Illinois, Northern Division. Decree reversed and cause remanded with directions to the court below to dismiss the bill. (C. C. A., 7th Cir. Jan. 3, 1899.)

BUNN, J.] *Sandwich Enterprise Co. *et al. v.* Joliet. Mfg. Co., 91 Fed. Rep. 254.

7. Pelzer *v.* Horn & Brannen Mfg. Co., 87 Fed. Rep. 869. Appealed from the Circuit Court of the United States for the Eastern District of Pennsylvania. Order of the Circuit Court granting preliminary injunction reversed and the cause remanded for further proceedings. (C. C. A., 3d Cir. Dec. 21, 1898.)

ACHESON, J.] *Horn & Brannen Mfg. Co. *v.* Pelzer, 91 Fed. Rep. 665.

8. Heap *v.* Greene *et al.*, 75 Fed. Rep. 405. Appealed from the Circuit Court of the United States for the District of Massachusetts. Decree of the Circuit Court dismissing the bill reversed and the case remanded to that court with direction to enter a decree in favor of the complainant. (C. C. A., 1st Cir. Jan. 30, 1899.)

BROWN, J.] *Heap *v.* Greene *et al.*, 91 Fed. Rep. 792.

9. Centaur Co. *v.* Neathery, not reported. Appealed from the Circuit Court of the United States for the Eastern District of Texas. Order of Circuit Court refusing preliminary injunction reversed, and the cause remanded with instructions to grant same. (C. C. A. 5th Cir. Dec. 13, 1898.)

SWAYNE, J.] *Centaur Co. *v.* Neathery, 91 Fed. Rep. 891.

10. Centaur Co. *v.* Hughes Bros. Mfg. Co., not reported. Appealed from the Circuit Court of the United States for the Northern District of Texas. Order of Circuit Court refusing preliminary injunction reversed, and the cause remanded with instructions to grant same. (C. C. A., 5th Cir. Dec. 13, 1898.)

SWAYNE, J.] *Centaur Co. *v.* Hughes Bros. Mfg. Co., 91 Fed. Rep. 901.

11. Centaur Co. *v.* Reinecke, not reported. Appealed from the Circuit Court of the United States for the Northern District of Texas. Order of the Circuit Court refusing preliminary injunction reversed and the cause remanded with instructions to grant same. (C. C. A., 5th Cir. Dec. 13, 1898.)

SWAYNE, J.] *Centaur Co. *v.* Reinecke, 91 Fed. Rep. 1001.

12. Saxlehner *v.* Neilson, 88 Fed. Rep. 71. Appealed from the Circuit Court of the United States for the Southern District of New York. Decree of the Circuit Court reversed and the cause remitted with instructions to dismiss the bill. (C. C. A., 2d Cir. Jan. 5, 1899.)

PER CURIAM.] *Saxlehner *v.* Neilson, 91 Fed. Rep. 1004.

13. Beach *v.* Hobbs *et al.*, 82 Fed. Rep. 916. Appealed from the Circuit Court of the United States for the District of Massachusetts. Decree of the Circuit Court reversed as to claims 1, 2 and 3, and affirmed as to claim 6, and the cause remanded with directions to proceed in conformity with this opinion. (C. C. A., 1st Cir. Feb. 13, 1899.)

COLT, J.] *Beach *v.* Hobbs *et al.*—Hobbs *et al. v.* Beach, 92 Fed. Rep. 146.

14. American Graphophone Co. *v.* Nat'l Gramophone Co. *et al.*, 90 Fed. Rep., 824. Appealed from the Circuit Court of the United States for the Southern District of New York. Order granting an injunction *pendente lite* reversed. (C. C. A., 2d Cir.)

SHIPMAN, J.] *American Graphophone Co. *v.* Nat'l Gramophone Co. *et al.*, 92 Fed. Rep. 364.

15. Hart & Hegeman Mfg. Co. *v.* Anchor Electric Co. *et al.*, 82 Fed. Rep. 911. Appealed from the Circuit Court of the United States for the District of Massachusetts. Decree reversed, and case remanded for further proceedings. (C. C. A., 1st Cir. Mar. 13, 1899.)

LOWELL, J.] *Hart & Hegeman Mfg. Co. *v.* Anchor Electric Co. *et al.*, 92 Fed. Rep. 657.

16. Chambers Bros. Co. *v.* Penfield, not reported. Appealed from the Circuit Court of the United States for the Northern District of Ohio. Decree reversed as to claims 7, 9, 10, 11 and 12 of patent No. 362,204, claim 2 of patent No.

297,675, claim No. 6 of patent No. 207,673, and claim 1 of patent No. 275,467 on the ground that the claims are invalid for want of invention. (C. C. A., 6th Cir. Mar. 7, 1899.)

TAFT, J.] *Penfield *v.* Chambers Bros. Co., 92 Fed. Rep. 630.

17. Palmer *et al. v.* John E. Brown Mfg. Co., 92 Fed. Rep. 925. Appealed from the Circuit Court of the United States for the District of Massachusetts. Decree of Circuit Court reversed and cause remanded with direction to enter a decree in favor of complainants sustaining the validity of claims 9, 10, 14, 16, 18, 19, 22 and 24 of complainants' patent No. 308, 981, Dec. 9, 1884, adjudging that said claims have been infringed, and other relief prayed. (C. C. A., 1st Cir. Mar. 16, 1899.)

BROWN, J.] *Palmer *et al. v.* John E. Brown Mfg. Co., 92 Fed. Rep. 925.

18. Dodge *et al. v.* Fulton Pulley Co. *et al.*, not reported Appealed from the Circuit Court of the United States for the Northern District of New York. Order granting a preliminary injunction reversed. (C. C. A., 2d Cir. Dec. 7, 1898.)

LACOMBE, J.] *Dodge *et al. v.* Fulton Pulley Co. *et al.*, 92 Fed. Rep., 995.

19. Peck, Stow & Wilcox Co. *v.* Fray *et al.*, 88 Fed. Rep. 784. Sand. Pat. Dig. 1898, 47. Appealed from the Circuit Court of the United States for the District of Connecticut. Order granting preliminary injunction reversed. (C. C. A., 2d Cir. Nov. 15, 1898.)

PER CURIAM.] *Peck, Stow & Wilcox Co. *v.* Fray *et al.*, 92 Fed. Rep. 1021.

20. Batcheller *v.* Thomson (2 cases). Thomson *v.* Batcheller, 86 Fed. Rep. 630. Sand. Pat. Dig. 1898, 152. Appealed from the Circuit Court of the United States for the Southern District of New York. Decrees of the Circuit Court reversed. (C. C. A., 2 Cir. April 4, 1899.)

SHIPMAN, J.] *Batcheller *v.* Thomson (2 cases).
Thomson *v.* Batcheller, 93 Fed. Rep. 660.

21. Wheatfield *v.* Reubens *et al.*, not reported. Appealed from the Circuit Court of the United States for the Northern District of Illinois. Order granting a preliminary injunction

reversed, as the patent sued on is invalid. (C. C. A., 7th Cir. Feb. 7, 1899.)

Woods, J.] *Rubens *et al. v.* Wheatfield, 93 Fed. Rep. 677.

22. Thompson *v.* Third Avenue Traction Co. *et al.*, 89 Fed. Rep. 321. Appealed from the Circuit Court of the United States for the Western District of Pennsylvania. Decree of the Circuit Court reversed and the cause remanded to that court with direction to enter a decree in favor of complainant. (C. C. A., 3d Cir. May 1, 1899.)

Acheson, J.] *Thompson *v.* Third Avenue Traction Co. *et al.*, 93 Fed. Rep. 824.

23. Simonds Rolling-Machine Co. *v.* Hathorn Mfg. Co., 90 Fed. Rep. 201, Sand. Pat. Dig. 1899. Appealed from the Circuit Court of the United States for the District of Maine. Decree of the Circuit Court modified as to requiring an accounting by each individual defendant. (C. C. A., 1st Cir. Apr. 25, 1899.)

Colt, J.] *Simonds Rolling-Mach. Co. *v.* Hathorn Mfg. Co. *et al.* Hathorn Mfg. Co. *et al. v.* Simonds Rolling-Mach. Co., 93 Fed. Rep. 958.

24. Warren *v.* Casey *et al.*, 91 Fed. Rep. 653, Sand. Pat. Dig. 1899. Appealed from the Circuit Court of the United States for the Eastern District of Pennsylvania. Decree of the court below holding the patent in suit invalid reversed. (C. C. A. May 1, 1899.)

Kirkpatrick, J.] *Warren *v.* Casey *et al.*, 93 Fed. Rep. 963.

25. Tower *v.* Eagle Pencil Co., 90 Fed. Rep. 662. Appealed from the Circuit Court of the United States for the Southern District of New York. Decree of lower court reversed with instructions to dismiss the bill. (C. C. A., 2d Cir. Apr. 4, 1899.)

Wallace, J.] *Tower *v.* Eagle Pencil Co., 94 Fed. Rep. 361.

26. Nat'l Cash Register Co. *v.* Leland *et al.* Same *v.* Wright *et al.*, 77 Fed. Rep. 242. In error to the Circuit Court of the United States for the District of Massachusetts. The judgment of the Circuit Court is reversed, the verdict set aside and the case remitted to that court for further proceedings in accordance with law. (C. C. A., 1st Cir. Apr. 12, 1899.)

Lowell, J.] *Nat'l Cash Register Co. *v.* Leland *et al.* Same *v.* Wright *et al.*, 94 Fed. Rep. 502.

27. Crosby Steam Gage and Valve Co. *v.* Ashton Valve Co., not reported. Appealed from the Circuit Court of the United States for the District of Massachusetts. Decree of Court below reversed and the case remanded with directions to dismiss the bill. (C. C. A., 1st Cir. May 4, 1899.)

PUTNAM, J.] *Crosby Steam Gage & Valve Co. *v.* Ashton Valve Co., 94 Fed. Rep. 516.

28. Bundy Mfg. Co. *v.* Detroit Time-Register Co., not reported. Appealed from the Circuit Court of the United States for the Eastern District of Michigan. Decree of the Circuit Court reversed, and case remanded with directions to enter a decree finding defendant guilty of infringement and for an injunction and account. (C. C. A., 6th Cir. May 2, 1899.)

LURTON, J.] *Bundy Mfg. Co. *v.* Detroit Time-Register Co., 94 Fed. Rep. 524.

29. Elgin Nat'l Watch Co. *v.* Illinois Watch Case Co. *et al.*, 89 Fed. Rep. 487. Sand. Pat. Dig. 1898, 145. Appealed from the Circuit Court of the United States for the Northern District of Illinois. Decree of the court below reversed and the cause remanded with direction to dismiss the bill. (C. C. A., 7th Cir., June 6, 1899.)

JENKINS, J.] *Illinois Watch Case Co. *et al.* *v.* Elgin Nat'l Watch Co., 94 Fed. Rep. 667. 87 O. G. 2323.

30. Huntington Dry Pulverizer Co. *et al.* *v.* Whitaker Cement Co. *et al.*, 89 Fed. Rep. 323. Sand. Pat. Dig. 1898, 43, 118. Appealed from the Circuit Court of the United States for the District of New Jersey. Decree of the Circuit Court reversed and cause remanded with direction to dismiss the bill. (C. C. A., 3d Cir. July 6, 1899.)

DALLAS, J.] *Whitaker Cement Co. *et al.* *v.* Huntington Dry Pulverizer Co. *et al.*, 95 Fed. Rep. 471.

31. Hartz *v.* Cleveland Block Co., not reported. Appealed from the Circuit Court of the United States for the Eastern Division of the Northern District of Ohio. Decree reversed. (C. C. A., 6th Cir. June 6, 1899.)

LURTON, J.] *Hartz *v.* Cleveland Block Co., 95 Fed. Rep. 681.

32. Pelzer *v.* City of Binghampton *et al.*, not reported.

Appealed from the Circuit Court of the United States for the Northern District of New York. Order denying injunction reversed; cause remanded with instructions to issue order of injunction *pendente lite*. (C. C. A., 2d Cir. Apr. 4, 1899.)

SHIPMAN, J.] *Pelzer *v.* City of Binghampton *et al.*, 95 Fed. Rep. 823.

33. Carr *v.* Bennett, not reported. In error to Circuit Court of the United States for the Southern District of New York. Judgment reversed. (C. C. A., 2d Cir. July 18, 1899.)

THOMAS, J.] *Bennett *v.* Carr, 96 Fed. Rep. 213.

34. Welsbach Light Co. *v.* Apollo Incandescent Gaslight Co. *et al.*, 94 Fed. Rep. 1005. Sand. Pat. Dig., 1899. Appealed from the Circuit Court of the United States for the Southern District of New York. Order denying preliminary injunction reversed. (C. C. A., 2d Cir. Apr. 4, 1899.)

SHIPMAN, J.] *Welsbach Light Co. *v.* Apollo Incandescent Gaslight Co. *et al.*, 87 O. G. 1784; 96 Fed. Rep. 332.

35. Carnegie Steel Co. Lim. *v.* Cambria Iron Co., 89 Fed. Rep. 721. Sand. Pat. Dig., 1898, 5, 11, 31, 116. Appealed from the Circuit Court of the United States for the Western District of Pennsylvania. Decree reversed and cause remanded with directions to dismiss the bill. (C. C. A., 3d Cir. Aug. 21, 1899.)

KIRKPATRICK, J.] *Cambria Iron Co. *v.* Carnegie Steel Co. Lim., 96 Fed. Rep. 850.

36. Williames *et al. v.* McNeely *et al.*, 64 Fed. Rep. 766. Appealed from the Circuit Court of the United States for the Eastern District of Pennsylvania. Decree reversed. (C. C. A., 3d Cir. Oct. 4, 1899.)

BRADFORD, J.] *McNeely *et al. v.* Williames *et al.*
Williames *et al. v.* McNeely *et al.*, 96 Fed. Rep. 978.

37. C. & A. Potts & Co. *v.* Creager *et al.*, 77 Fed. Rep. 454. Appealed from the Circuit Court of the United States for the Southern District of Ohio. Decree dismissing the bill as to

the Potts patent No. 322,393 reversed. (C. C. A., 6th Cir. Oct. 23, 1899.)

TAFT, J.] *C. & A. Potts & Co. *v.* Creager *et al.*, 97 Fed. Rep. 78.

38. Magic Light Co. *v.* Economy Gas-Lamp Co., not reported. Appealed from the Circuit Court of the United States for the Northern Division of the Northern District of Illinois. Decree granting preliminary injunction reversed, and cause remanded with directions to dismiss the bill. (C. C. A., 7th Cir. Oct. 3, 1899.)

WOODS, J.] *Magic Light Co. *v.* Economy Gas-Lamp Co., 97 Fed. Rep. 87.

39. Celluloid Co. *v.* Arlington Mfg. Co., 85 Fed. Rep. 449. Sand. Pat. Dig. 1898, 6. Appealed from the Circuit Court of the United States for the District of New Jersey. Decree reversed. (C. C. A., 3d Cir. Sept. 22, 1899.)

BRADFORD, J.] *Arlington Mfg. Co. *v.* Celluloid Co., 97 Fed. Rep. 91.

40. Kisinger-Ison Co. *v.* Bradford Belting Co., not reported. Appealed from the Circuit Court of the United States for the Southern District of Ohio, Western Division. Decree reversed as to the Morrison patent. (C. C. A., 6th Cir. Oct. 3, 1899.)

TAFT, J.] *Kisinger-Ison Co. *v.* Bradford Belting Co., 97 Fed. Rep. 502.

41. Fenton Metallic Mfg. Co. *v.* Office Specialty Mfg. Co., 12 C. A. D. C. 201. Appealed from the Court of Appeals for the District of Columbia. Decree of the court below reversed and case remanded with directions that the bill be dismissed. (Sup. Ct. U. S. May 15, 1899.)

BROWN, J.] *Office Specialty Mfg. Co. *v.* Fenton Metallic Mfg. Co., 87 O. G. 1608.

III. APPEALS DISMISSED.

1. Von Emperger *v.* City of Detroit. Appealed from the Circuit Court of the United States for the Eastern District of Michigan. Dismissed for failure to print record. (C. C. A., 6th Cir. Mar. 7, 1899.)

*Von Emperger *v.* City of Detroit, 92 Fed. Rep. 1023.

2. Western Electric Co. *v.* Citizens Telephone Co., 89 Fed. Rep. 670. Sand. Pat. Dig., 1898, 121. Appealed from the Circuit Court of the United States for Western District of Michigan. Dismissed on motion of appellant. (C. C. A., 6th Cir. Mar. 27, 1899.)

* Western Electric Co. *v.* Citizens Telephone Co. *et al.*, 92 Fed. Rep. 1023.

3. E. T. Burrowes Co. *v.* Adams & Westlake Co. *et al.*, 93 Fed. Rep. 462. Sand. Pat. Dig. 1899. Appealed from the Circuit Court of the United States for the District of Maine. Appeal dismissed. (C. C. A., 1st Cir. Apr. 27, 1899.)

PER CURIAM.] * E. T. Burrowes Co. *v.* Adams & Westlake Co. *et al.*, 93 Fed. Rep. 987.

4. Welsbach Light Co. *v.* Rex Incandescent Light Co. *et al.*, 87 Fed. Rep. 477. Sand. Pat. Dig. 1898, 124. Appealed from Circuit Court of the United States for the Southern District of New York. Appeal dismissed and cause remanded to the Circuit Court with instructions to entertain another motion for an injunction. (C. C. A., 2d Cir. Apr. 27, 1899.)

PER CURIAM.] * Welsbach Light Co. *v.* Incandescent Light Co. *et al.*, 93 Fed. Rep. 989.

5. Carter-Crume Co. *v.* Ashley *et al.*, 68 Fed. Rep. 378. Appealed from the Circuit Court of the United States for the Northern District of New York. Appeal dismissed on motion of appellee. (C. C. A., 2d Cir. Nov. 10, 1897.)

PER CURIAM.] * Carter-Crume Co. *v.* Ashley *et al.*, 96 Fed. Rep. 1004.

6. Tannage Patent Co. *v.* Donallan, 93 Fed. Rep. 811. Sand. Pat. Dig. 1899. Appealed from the Circuit Court of the United States for the District of Massachusetts. Appeal dismissed per stipulation. (C. C. A., 1st Cir. Nov. 2, 1899.)

PER CURIAM.] * Donallan *v.* Tannage Patent Co., 96 Fed. Rep. 1004.

7. New York Filter Mfg. Co. *v.* Elmira Water W'ks Co., 83 Fed. Rep. 1013. Appealed from the Circuit Court of the United States for the Northern District of New York. Appeal

dismissed on consent pursuant to the 20th rule. (C. C. A., 2d Cir. Mar. 16, 1898.)

PER CURIAM.] *Elmira Water W'ks Co. *v.* New York Filter Mfg. Co., 96 Fed. Rep. 1005.

8. Brown *et al. v.* Reed Mfg. Co., 81 Fed. Rep. 48. Appealed from the Circuit Court of the United States for the Northern District of New York. Appeal dismissed on consent pursuant to 20th rule. (C. C. A., 2d Cir. Mar. 10, 1898.)

PER CURIAM.] *Reed Mfg. Co. *v.* Brown *et al.*, 96 Fed. Rep. 1005.

IV. DISPOSITION OF PETITION FOR REHEARING.

1. Antisdel *v.* Chicago Hotel Cabinet Co., 89 Fed. Rep. 308. Sand. Pat. Dig. 1898, 24, 37, 104, 109. Petition for rehearing denied. (C. C. A., 7th Cir. Dec. 1, 1898.)

*Antisdel *v.* Chicago Hotel Cabinet Co., 90 Fed. Rep. 828.

2. Atwater *et al. v.* Castner *et al.*, 88 Fed. Rep. 642. Petition that mandate be recalled and a rehearing be ordered dismissed.

*Atwater *et al. v.* Castner *et al.*, 90 Fed. Rep. 828.

3. Willcox & Gibbs Sewing-Mach. Co. *v.* Merrow Mach. Co., 93 Fed. Rep. 206; 85 O. G. 1078. Sand. Pat. Dig. 1898, 43, 108, 131. Application for rehearing was allowed upon the single "question of similarity of equivalency of defendants' hoop looper to complainants' double-jawed looper." No cause for modifying the original opinion appears. (C. C. A., 2d Cir. Mar. 1, 1899.)

LACOMBE, J.] *Willcox & Gibbs Sewing-Mach. Co. *v.* Merrow Mach. Co. *et al.*, 93 Fed. Rep. 215.

4. Hart & Hegeman Mfg. Co. *v.* Anchor Electric Co. *et al.*, 92 Fed. Rep. 657. Sand. Pat. Dig. 1899. Petition for rehearing denied. (C. C. A., 1st Cir. Aug. 1, 1899.)

PER CURIAM.] *Hart & Hegeman Mfg. Co. *v.* Anchor Electric Co. *et al.*, 97 Fed. Rep. 224.

Decisions of Foreign Courts.

The decisions of courts of a foreign country that a certain process is patentable, are in no way controlling upon the courts of this country, but they are valuable as the opinions of trained

experts in the country of the inventor where the particular art in question is best understood. The opinions of such men, learned, able and disinterested, officially expressed after thorough examination, are persuasive to say the least. (C. C., S. D. N. Y. May 8, 1899.)

COXE, J.] *Badische Analin & Soda Fabrik *v.* Kalle *et al.*, 94 Fed. Rep. 163.

Defenses.

I. IN GENERAL.
II. BURDEN OF PROOF.

I. IN GENERAL.

1. The interveners may make any defense which the original defendants could make, but they cannot strengthen that defense by showing that if they had themselves been sued, their position would have been stronger, nor set up a defense not open to the original defendants. (C. C., E. D. Penn. Fed. 23, 1899.)

DALLAS, J.] *Powell *et al. v.* Leicester Mills *et al.*, 92 Fed. Rep. 115.

2. Abandonment, not appearing on the face of the bill, is a defense which must be interposed by answer showing the facts. (Walk. Pat. § 602.) (C. C., D. Conn. Feb. 22, 1899.)

TOWNSEND, J.] *Warren Featherbone Co. *v.* Warner Bros. Co., 92 Fed. Rep. 990.

II. BURDEN OF PROOF.

1. The burden of proof to show that the patent in suit has been anticipated by prior patents is upon the party who alleges such anticipation, and he must establish the fact of anticipation and want of originality by clear and convincing evidence and place the matter beyond a reasonable doubt; particularly so where the patent in suit has been held valid in another suit. (C. C., N. D. Cal. Dec. 12, 1898.)

MORROW, J.] *Bowers *v.* San Francisco Bridge Co., 91 Fed. Rep. 381.

2. Anticipation to defeat a patent must be proved beyond a reasonable doubt. (C. C., S. D. N. Y. Dec. 16, 1898.)

WHEELER, J.] *Nelson *et al. v.* Farmer Type-Founding Co. *et al.*, 91 Fed. Rep. 418.

3. The burden of proving anticipation rests upon the defendants, and every reasonable doubt should be resolved against them. (C. C., S. D. N. Y. May 8, 1899.)

COXE, J.] *Badische Analin & Soda Fabrik *v.* Kalle *et al.*, 94 Fed. Rep. 163.)

4. The existence of doubt defeats anticipation. **Id.*

Designs.

I. APPEAL AND PETITION.
II. CONSTRUCTION OF STATUTES.
III. INFRINGEMENT.
IV. LIMITED TO A SINGLE INVENTION.
V. INTERFERENCE.
VI. PRACTICE IN THE PATENT OFFICE.
VII. TEST OF IDENTITY.

I. APPEAL AND PETITION.

1. Where a petition was taken to the Commissioner praying that the examiner be advised that applicant's article can be protected under the design statute and that the said application should be allowed unless the design be found to be fully anticipated, *Held*, that this is a question which goes to the merits of the case and is appealable to the examiners-in-chief. (Oct. 25, 1899.)

DUELL, C.] *Ex parte* Groves, 89 O. G. 1671.

2. Where the Commissioner was asked by petition to advise the examiner what is or is not a competent reference, *Held* that this is a question not to be settled by petition. The examiner in the first instance is the judge of the pertinency of the reference or ground of rejection. The Commissioner may differ with him, and when the case comes to him on appeal he may properly make that difference of opinion known; but he is not authorized in an irregular way to coerce the independent judgment of the examiner. *Id.*

3. Where it was prayed that the examiner be instructed that originality and utility are proper grounds to justify the grant of design patent to the applicant, *Held* that this is a question of merits which is appealable to the examiners-in-chief in the first instance. *Id.*

4. Where an applicant claimed a design for inner and outer tubes forming the fire-walls between the inner and outer flame of a hydrocarbon-burner, and the examiner required him to amend his case to set up a single definite article of manufacture and not two articles, on petition to the Commissioner, *Held* that the question presented is one involving the merits of the claim rather than its form, and that therefore it is not reviewable on petition. (*Ex parte* Brower, 4 O. G. 450; *ex parte* Smith, 81 O. G. 969; *ex parte* Tallman, 82 O. G. 337; *ex parte* Brand, 83 O. G. 747, and *ex parte* Kapp, 83 O. G. 1993, modified.) (Nov. 3, 1899.)

GREELEY, A. C.] *Ex parte* Sherman and Harms, 89 O. G. 2067.

5. Where an applicant asks for a design patent covering a certain form of device, the Office cannot properly refuse to act upon the merits of the case and require him to substitute therefor a claim to some other article, as to do so would deprive him of the statutory right of appeal to the examiners-in-chief, to the Commissioner, and to the Court of Appeals. *Id.*

6. The holding that two or more elements covered by a single claim should be divided is in effect a holding that such claim cannot be allowed, and is such a refusal of the claim as entitles applicant to a review of that action by the several tribunals mentioned in the statutes, since it is based upon the subject-matter covered and not the mere form of the claim. *Id.*

II. CONSTRUCTION OF STATUTES.

1. The broad proposition that R. S. § 4929 was not intended to apply to structures having movable parts, is not supported by the citation of any judicial decision; and although certain rulings of the Patent Office are cited to support the proposition, (*Ex parte* Tallman, 82 O. G. 337; *ex parte* Adams, 84 O. G. 311; *ex parte* Smith, 81 O. G. 969; *ex parte* Brower, C. D. 1873, 151), such a construction of the statute calls for an unwarranted and unreasonable limitation of the terms "manufacture" and "any article of manufacture," and leads to absurd and unjust results. (C. C., D. Mass. Dec. 5, 1898.)

BROWN, J.] *Chandler Adjustable Chair & Desk Co. *v.* Heywood Bros. & Wakefield Co., 91 Fed. Rep. 163.

2. The whole purpose of Congress in authorizing the grant of

design patents was to give encouragement to the decorative arts. It contemplated not so much utility as appearance. Section 4929 provides among other things that "Any person who * * * has invented and produced * * * * any new, *useful* and original shape or configuration of any article of manufacture * * * * may * * * obtain a patent therefor." The word "useful," introduced by revision of the patent laws into the statute does not have the same meaning as it has in the section providing for patents for useful inventions, but was probably inserted out of abundant caution to indicate that things which were vicious and had a tendency to corrupt, and in this sense were not useful, were not to be covered by the statutes. (C. C. A., 6th Cir. Oct. 3, 1899.)

TAFT, J.] *Westinghouse Electric & Mfg. Co. *v.* Triumph Electric Co., 97 Fed. Rep. 99.

III. INFRINGEMENT.

1. Where a design patent differs from prior design patents only in the shape or contour of a certain specified feature, *Held*, that it is not infringed by a design in which the shape or contour of that feature is different. (C. C., S. D. N. Y. Nov. 19, 1898.)

WHEELER, J.] *Mesinger Bicycle Saddle Co. *v.* Humber *et al.*, 94 Fed. Rep. 672.

2. Where the similarity of appearance between an alleged infringing design and the design of the patent grows out of the general similarity in designs of such articles, rather than out of the particular similarity of the alleged infringing design to the design of the patent, and the patent was not of a primary nature. *Held*, there was no infringement. (C. C., S. D. N. Y. May 11, 1899.)

WHEELER, J.] *Mesinger Bicycle Saddle Co. *v.* Humber *et al.*, 94 Fed. Rep. 674.

IV. LIMITED TO A SINGLE INVENTION.

1. Designs have relation to external appearance merely and are not concerned with internal structure. (Oct. 26, 1899.)

GREELEY, A. C.] Feder v. Poyet, 89 O. G. 1343.

2. In design patents it is the showing of the design which is

of primary importance, the description being merely auxiliary to the showing. The language of the description cannot be used to give to the design a generic meaning which would include designs so far different from the design shown that they would not be mistaken for it. (*Ex parte* Traitel, 25 O. G. 783; C. D., 1883, 92.) *Id.*

3. There is no such distinction of generic and specific in design patents as there is in mechanical patents. If an inventor has a generic design capable of modification—that is, a design made up of a small number of simple elements to which other elements may be added without modification of the essential elements—he should in order to secure protection for the generic design show the design in his application in its simplest form. He must show the genus stripped of additions. *Id.*

V. Interference.

1. The issue in the present case being the conventional claim for the design shown and described, its meaning is to be ascertained from the drawing and description to which it refers. (Oct. 26, 1899.)

Greeley, A. C.] Feder *v.* Poyet, 89 O. G. 1343.

2. If there is doubt as to the meaning of the issue and one party has a patent granted before the filing of the other party's application, its meaning is to be ascertained from the patent as well in design as in mechanical cases. *Id.*

3. *Held*, that the designs produced by F. prior to P.'s filing date do not embody the invention in issue, and therefore priority awarded to P. *Id.*

VI. Practice in the Patent Office.

1. Where a claim was for "a design for ornament for the handle of a tooth-brush," etc., and the examiner required that the invention should be claimed as "a design for the handle of a tooth-brush," etc., *Held*, that the examiner's requirement should be sustained, as such an ornament is an intangible thing which should not under the circumstances and decisions be patented as a design, but the design patent should be granted for the instrument which applicant has invented and produced. (Mar. 31, 1899.)

Duell, C.] *Ex parte* Hewitson, 87 O. G. 515.

2. *Held*, further, that although applicant's design is produced by ornamentation instead of by shape there is no more reason why it should be claimed as a design for an ornament than that a design consisting of the shape of an article or a design for a pattern for carpet should be claimed as a design for the shape or pattern instead of as a design for the article shaped or a design for the carpet. *Id.*

3. To require division between the elements covered by a claim of the kind under consideration is analogous to requiring division between the elements covered by an alleged combination claim in a mechanical application. It has been repeatedly held in such cases that, although the claim covers a mere aggregation and not a true combination, division between the elements covered by it should not be insisted upon, but the claim should be rejected. (Nov. 3, 1899.)

GREELEY, A. C.] *Ex parte* Sherman and Harms, 89 O. G. 2067.

VII. TEST OF IDENTITY.

The true test of identity of design is sameness of appearance, in other words, sameness of effect upon the eye of the ordinary observer, and if two designs are so much alike that one may be readily taken for the other by an ordinary observer, the earlier is an anticipation of the later, even though there may be differences in detail and in non-essential matters. (C. C., E. D. Penn. July 10, 1899.)

MCPHERSON, J.] *Sagendorph *v.* Hughes, 95 Fed. Rep. 478.

Disclaimer.

I. CONSTRUCTION OF.

II. DELAY IN FILING.

III. UNDER THE STATUTE, 4917 R. S.

I. CONSTRUCTION OF.

1. In considering the scope and effect to be given a disclaimer, the same rules are to be observed as in construing any other written instrument, and so as to carry out the intention of the person executing it, as indicated by its language when construed with reference to the proceedings of which it forms a part. It cannot be read independently of its relation to the original

specification of which it becomes a part when recorded. (C. C. A., 9th Cir. Oct. 24, 1897.)

DEHAVEN, J.] *Graham *v.* Earl, 82 Fed. Rep. 737; 92 Fed. Rep. 155.

2. By disclaiming the broad claims of his patent and retaining the narrower ones, the patentee intended to limit his patent to the specific invention described in such narrower claims, and not to abandon them. **Id.*

3. Where it was manifest that an invention might be applied to any one of four varieties of an article of manufacture, but if applied to two of those varieties, it would subserve no useful purpose and the patent for such invention might fairly be held void for lack of utility, and when applied to the other two of those varieties it would accomplish a "desirable result," as both the Circuit Court and Court of Appeals held, *Held*, that there was an actual, separable invention, and that the specification and claim was broader than the invention. *Held*, further, that a disclaimer to the application of the invention to the two varieties was proper, and leaves the patent in force as to the other two varieties of the class of articles to which it added a desirable result. (C. C. A., 2d Cir. May 25, 1899.)

LACOMBE, J.] *Thompson *et al. v.* N. T. Bushnell Co., 96 Fed. Rep. 238.

II. DELAY IN FILING.

Where the Circuit Court, from the evidence before it, did not consider a disclaimer to certain features of a patent in suit necessary, and it was only when the decision of the Circuit Court of Appeals was filed that the owners of the patent were apprised of the necessity of such disclaimer, which was duly filed within six weeks thereafter. *Held*, that said patent owners acted with reasonable promptness in filing such disclaimer. (C. C. A., 2d Cir. May 25, 1899.)

LACOMBE, J.] *Thompson *et al. v.* N. T. Bushnell Co., 96 Fed. Rep. 238.

III. UNDER THE STATUTE. § 4917 R. S.

1. A disclaimer to be effective under the statute must give up some material or substantial part of the thing patented of which

the patentee was not the original inventor. The statute expressly limits a disclaimer to a rejection of something claimed as new. (C. C. A., 3d Cir. Aug. 21, 1899.)

KIRKPATRICK, J.] *Cambria Iron Co. *v.* Carnegie Steel Co. Lim., 96 Fed. Rep. 850.

2. No disclaimer in a patent is necessary to the recovery of damages or costs in a suit for the infringement of the patent unless the patentee has included in the claims sued upon something to which he was not entitled. (C. C. A., 3d Cir. Oct. 4, 1899.)

BRADFORD, J.] *McNeely *et al. v.* Williames *et al.* Williames *et al. v.* McNeely *et al.*, 96 Fed. Rep. 978.

Equity.

I. BILL.
(*a*) *In General.*
(*b*) *Multifariousness.*
II. DEMURRER.
III. PLEA.
IV. ANSWER.
V. JURISDICTION.
VI. MASTER'S REPORT.
VII. RES ADJUDICATA.

I. BILL.

(*a*) *In General.*

Where the complaint sets forth the invention of the patent upon which suit is brought by the name given it in the patent, and makes special reference to the patent "for further and fuller description of the invention therein patented," such reference imports into the complaint the description contained, and is controlling as to the nature of the invention patented. (C. C. A., 9th Cir. Oct. 18, 1897.)

DEHAVEN, J.] *Graham *v.* Earl, 82 Fed. Rep. 737; 92 Fed. Rep. 155.

I. BILL.

(*b*) *Multifariousness.*

1. Unlawful competition before the grant of a patent is en-

tirely distinct from any infringement after; the acts are separate and their consequences distinct. The setting up of both acts as grounds for relief makes two cases for distinct relief in the same bill. The demurrer for multifariousness was sustained. (C. C., S. D. N. Y. Dec. 5, 1898.)

WHEELER, J.] *Ball & Socket Fastener Co. *v.* Cohn *et al.*, 90 Fed. Rep. 664.

2. The objection of multifariousness is one which addresses itself to the sound discretion of the court, and should not be sustained where the relief prayed for is of the same kind with respect to the matters complained of in the bill, and no hardship or injustice is likely to result from the inclusion of such matters in one suit. (C. C., D. Del. May 5, 1899.)

BRADFORD, J.] *Dennison Mfg. Co. *v.* Thomas Mfg. Co., 94 Fed. Rep. 651.

3. A bill which sets up a claim for damages under the anti-trust law of July 2, 1892, and also sets forth facts upon which the complainants ask that defendants be enjoined from using complainants' trade-mark and trade-name is multifarious, inasmuch as it joins two distinct causes of action, having no connection with each other, the one triable at law and the other is of equitable cognizance. (C. C., S. D. Ohio, W. D. July 31, 1899.)

THOMPSON, J.] *Block *et al.* *v.* Standard Distilling & Distributing Co., 95 Fed. Rep. 978.

4. Where the bill of complaint is based upon the infringement of several patents each covering a device which is sold separately, and all used in various relations, no one machine using them all at one time, and such bill does not seek to restrain the infringement of any specific combination, it is bad for multifariousness. (C. C., N. D. Ill. N. D. July 19, 1899.)

KOHLSAAT, J.] *Louden Mach. Co. *v.* Montgomery Ward & Co., 96 Fed. Rep. 232.

5. Such a case does not come within the rule which permits a plurality of patents to be sued upon in one action where the invention covered by those patents are embodied in one infringing process, machine, process, or composition of matter. **Id.*

II. Demurrer.

The failure of a bill to allege that the inventions set forth and claimed in the patents in suit were not abandoned before the application therefor, is no ground for demurrer. Abandonment, not appearing in the face of a bill, is a defense which must be interposed by answer showing the facts. (C. C., D. Conn. Feb. 22, 1899.)

Townsend, J.] *Warren Featherbone Co. *v.* Warner Bros., 92 Fed. Rep. 990.

III. Plea.

Where the hearing was upon the plea, a general replication and the evidence taken in support of the plea, such plea being a special answer to the bill, nothing is put in issue so far as the plea extends, but the truth of the matter pleaded. And where the original plea was set down for argument as insufficient in law, and the court permitted it to be amended, and no error having been assigned upon the ruling of the court in sustaining the plea as sufficient in law, the only question open to review on appeal is as to whether the court erred in holding that the plea was sustained by the evidence. If it was not supported it should have been overruled and the defendant ordered to answer, and if supported, the bill should have been dismissed. (C. C. A., 6th Cir. June 6, 1899.)

Lurton, J.] *Hartz *v.* Cleveland Block Co., 95 Fed. Rep. 681.

IV. Answer.

Where an amendment to the answer pleads the effect of certain written instruments in the nature of an assignment, which were filed in the case subsequent to the original answer but long before the case was submitted, and such amendment does not affect the facts of the case, but may be said to be an amendment to conform to the proof, there is no reason why it should not be allowed to be filed. (C. C., D. Ky. June 3, 1899.)

Evans, J.] *Patent Button Co. *v.* Pilcher, 95 Fed. Rep. 479.

V. Jurisdiction.

1. The authorities are fairly uniform that where a patent will expire a few days subsequent to the commencement of a suit, and the return day of the subpœna follows by a few days the

expiration of the patent, equity will not take jurisdiction even though the bill of complaint contain a prayer for injunction both preliminary and permanent, and the usual prayer for discovery and accounting. Where no special circumstances are shown over the ordinary cases of account, which would make the accounting so intricate as to make a suit at law an inadequate and incomplete remedy, and nothing appears from the bill to show that adequate discovery cannot be had at law, equity will not interfere. (C. C., N. D. Ill. N. D. July 19, 1899.)

KOHLSAAT, J.] *Overweight Counterbalance Elevator Co. *v.* Standard Elevator Co. Same *v.* Eaton & Prince Co. *et al.* Same *v.* Crane Elevator Co. Same *v.* J. W. Reedy Elevator Mfg. Co., 96 Fed. Rep., 231.

2. A mere allegation that complainant has no adequate remedy at law, unaccompanied by allegations of facts supporting the same will not confer jurisdiction upon equity. **Id.*

3. A court of equity will not take cognizance of a case simply for the purpose of construing the meaning or scope of a patent. Where the ultimate object sought is the payment of royalties the suit is essentially one on a contract, and a suit on a contract of license under letters patent is not a suit arising under the patent laws. (C. C., N. D. Ill. N. D. July 27, 1899.)

KOHLSAAT, J.] *Perry *v.* Noyes *et al.*, 96 Fed. Rep. 233.

VI. MASTER'S REPORT.

1. The procedure enjoined by the 83d rule of equity with respect to the filing of the master's report does not deprive the court of the power and jurisdiction to permit the master to withdraw the report for amendment, nor, by virtue of the rule, do the parties to the suit acquire a vested right in the report akin to the right of property, of which they cannot be divested except by due process of law. (C. C., S. D. Ohio W. D. Feb. 4, 1899.)

TAFT, J.] *Nat'l Folding-Box & Paper Co. *v.* Dayton Paper-Novelty Co., 91 Fed. Rep. 822.

2. The order of the court giving the master leave to withdraw his report for amendment, necessarily gave him authority to

make an amended report, and he was as much master of the court when he made the second report as when he made the first. *Id.*

3. After the master has made and filed his report, he should not upon re-reference for amendment, reverse his rulings on the evidence and law without giving the parties notice. *Id.*

VII. RES ADJUDICATA.

An order dismissing a bill for want of prosecution is not a bar to another bill. (C. C., D. Mass. Jan. 24, 1899.)

BROWN, J.] *Whitaker *v.* Davis *et al.*, 91 Fed. Rep. 720.

Where a plea merely avers that the parties are the same or in privity, that the letters patent relied on are the same and that the acts of infringement are the same as those on a former suit, wherein the bill for relief for infringement was dismissed for want of prosecution, *Held*, that it does not show that the matter is *res judicata*. *Id.*

Equivalents.

1. While it is an abuse of the term "equivalent" to employ it to cover every combination of devices in a machine which is used to accomplish the same result, yet where a device was a well known and proper substitute for the one described in complainant's specification at the date of his patent, it is a mechanical equivalent therefor, according to repeated expressions of the Supreme Court left unqualified by the decision in Westinghouse *v.* Power Brake Co., 170 U. S. 537, 18 Sup. Ct. 707, 83 O. G. 1067, and recognized in that case by its citation of Imheuser *v.* Buerk, 101 U. S. 647, 656. (C. C. A., 1st Cir. Feb. 13, 1899.)

COLT, J.] *Beach *v.* Hobbs *et al.* Hobbs *et al. v.* Beach, 92 Fed. Rep. 146, 87 O. G. 1961.

2. Neither the words "substantially as described" in the claims nor the proceedings in the Patent Office in which the patentee acquiesced in the decision that these words must be inserted after the word "mechanism" in the claims, prohibit the patentee from invoking the doctrine of equivalents with respect to alleged infringers. Nor in dealing with a broad invention which represents a distinct advance in the art, does it estop

a meritorious inventor from asking the court to apply a more liberal rule as to what constitutes equivalents, than is applicable to a narrow invention which is only an improvement on what was old and well known. *Id.*

3. Where, at the date of the patent, pivoted and fixed switch rails or tracks were old and familiar devices for transferring cars from one track to another, well known equivalents, and the substitution of one for the other in the combination of the patent works no new or different result whatever. (C. C. A., 3d Cir. May 1, 1899.)

ACHESON, J.] *Thompson *v.* Third Avenue Traction Co. *et al.*, 93 Fed. Rep. 824.

4. The range of equivalents depends upon the nature and extent of the invention. The meritoriousness of an improvement depends, first, upon the extent to which the former art has taught or suggested the step taken; and second, upon the advance made in the usefulness of the machine as improved. To be entitled to the benefit of the doctrine of equivalents, it is not essential that the patent be for a pioneer invention in the broadest sense of the term. If the invention has marked a decided step in the art and has proven of value to the public, the inventor or patentee will be entitled to the benefit of the rule of equivalents, though not in so liberal a degree as if the invention was of a primary character. (C. C. A., 6th Cir. May 2, 1899.)

LURTON, J.] *Bundy Mfg. Co. *v.* Detroit Time-Register Co., 94 Fed. Rep. 524.

5. A patent covers only known equivalents, and where at the time of the issue of a patent a different device was not known to be a mechanical equivalent of the device of the patent, and in fact such equivalency had been expressly denied by the patentee in his correspondence with the Patent Office, the fact that such different device was afterward shown to accomplish the same result as that of the patent does not make its use for such purpose an infringement of the patent. (C. C. A., 7th Cir. Oct. 3, 1899.)

WOODS, J.] *Magic Light Co. *v.* Economy Gas-Lamp Co., 97 Fed. Rep. 87.

6. Where a claim is drawn to include an entire group of chemical agents or elements, such as alkalies, and only certain elements of the group are capable of carrying out the specific objects of the patent, such claim cannot be held to include as equivalents such other elements of the group as are incapable of carrying out such objects. (C. C., D. Conn. Aug. 28, 1899.)

TOWNSEND, J.] *Rickard *et al. v.* Du Bon, 97 Fed. Rep. 96.

Estoppel.

1. The defendants originally filed a plea of license to the bill in equity for infringement of a patent, but by leave of court before hearing withdrew the same and filed an answer in which the license was not pleaded, *Held*, that defendants are not estopped to deny the validity of the patent by reason of such plea, as it is not before the court. (C. C., S. D. Ohio, W. D. Dec. 2, 1898.)

TAFT, J.] *Fry *v.* Rookwood Pottery Co. *et al.*, 90 Fed. Rep. 495.

2. If one not a party of record nor in privity with a party of record desires to avail himself of the judgment as an estoppel on the ground that he in fact defended the action resulting in the judgment, he must not only have defended the action, but must have done so openly to the knowledge of the opposite party and for the defense of his own interests. That he employed an attorney who appeared for the defendant of record and appeared as a witness for such defendant, is not sufficient where these facts are not known to the plaintiff. (C. C. A., 9th Cir. Feb. 13, 1899.)

GILBERT, J.] *Cramer *v.* Singer Mfg. Co., 93 Fed. Rep. 636.

3. The fact that an alleged infringer at one time held a license, since expired, and marked his machines as made under the patent sued on is not an estoppel against him on the question of infringement when the record does not show whether or not his conduct in obtaining such license and so marking his machines was because he misconstrued the patentee's rights under his claims or was merely not disposed to make any contest for the time being. (C. C. A., 1st Cir. June 1, 1899.)

PUTNAM, J.] *Cushman Paper Box Mach. Co. *v.* Goddard *et al.*, 88 O. G. 2410, 95 Fed. Rep. 664.

4. The doctrine of equitable estoppel applies in the administration of the patent law, as it does in other cases, for the prevention of injustice. (C. A. D. C. June 6, 1899.)

ALVEY, J.] *Mower *v.* Duell, Com'r of Patents, 88 O. G. 191.

5. The law does not favor estoppels, and the facts relied on to estop a defendant from denying the validity of a patent must be clearly established and not matters of inference. As a general rule, fraud is an essential element of an estoppel *in pais*. (C. C., N. D. Ill. N. D. July 27, 1899.)

KOHLSAAT, J.] *Burrell *et al. v.* Elgin Creamery Co., 96 Fed. Rep. 234.

6. Each of the parties had manufactured the articles covered by a design patent for about a year and a half prior to the issue of the patent. Prior to said issue complainant requested defendant to discontinue manufacture of said articles as a patent had been granted to him. Defendant then requested information as to when and where the patent was issued. Complainant replied that the patent "has been granted and gone to issue, and as soon as we have a copy from the Patent Office will forward same to you." The patent was duly issued but complainant never sent defendant a copy, and defendant kept on manufacturing for a year and a half when complainant without notice brought suit. *Held*, that notwithstanding the broken promise of the complainant, he was not estopped to claim full damages upon an accounting. (C. C., D. Conn. Aug. 14, 1899.)

TOWNSEND, J.] *Jennings *et al. v.* Rogers Silver Plate Co., 96 Fed. Rep. 340.

7. Where a patentee acquiesced in the action of the Patent Office in rejecting two of his three claims, leaving the third claim exactly as it was originally drawn, *Held*, that a mere remark of the examiner that "It is not seen that there is any material difference in the claims," does not estop the patentee from claiming the construction shown by the specification and such original claim, nor does it limit him to a construction embraced only by the rejected claim. It is the construction of the patent as finally issued which is to be considered. (C. C., S. D. N. Y. July 29, 1899.)

TOWNSEND, J.] *Acme Flexible Clasp Co. *v.* Cary Mfg. Co., 96 Fed. Rep. 344.

Evidence.

I. Admissibility.

II. Suppression on Motion.

III. Weighing.

I. Admissibility.

1. In an action at law to recover damages for the infringement of a patent, evidence of what was paid for royalties under a distinct patent held by a stranger, especially when the allegations in the declaration fail to shut out the possibility that that patent covered more than the patent in issue is incompetent and inadmissible on the question of damages, as is also evidence as to amounts received in settlement of claims against other infringers. (C. C., D. Mass. Dec. 22, 1898.)

Putnam, J.] *Ewart Mfg. Co. *v.* Baldwin Cycle-Chain Co. *et al.*, 91 Fed. Rep. 262.

2. The rule that a compromise of litigation affords no satisfactory evidence of the value of the property litigated is an underlying one, and recognizes no distinctions not of a fundamental character. **Id.*

3. Where a patent is introduced in evidence as showing the prior state of the art and merely to illustrate its connection with the question of infringement, and not for the purpose of anticipating the patent in suit, there is no error under R. S. § 4920 in admitting it, even though notice of such patent has not been given. (C. C. A., 9th Cir. Feb. 13, 1899.)

Hawley, J.] *Overweight Counterbalance Elevator Co. *v.* Improved Order of Red Men's Hall Association of San Francisco, 94 Fed. Rep. 155.

II. Suppression of, on Motion.

The defendant should complete his evidence with respect to the state of the art before the taking of the complainant's testimony in rebuttal; additional testimony and exhibits, even though introduced for the sole purpose of narrowing the claims of the patent, if introduced after the evidence of the complainant has all been taken, will be suppressed on motion. (C. C., E. D. Penn. May 26, 1899.)

Dallas, J.] *Smith *et al. v.* Ulrich, 94 Fed. Rep. 865.

III. Weighing.

Where an elaborate opinion of a court of last resort upon the evidence is published, and the weaknesses of the losing side are clearly brought out, and the defeated party is thereafter given an opportunity to strengthen the defects of his case by evidence as to transactions long past, and machinery long since cast into the scrap heap, there is great danger that the exigencies of the case may lead witnesses to round out evidence beyond that which exact truth would permit. Such evidence must be taken with great caution, and weighed in the light of this danger. (C. C. A., 6th Cir. Oct. 23, 1899.)

Taft, J.] *C. & A. Potts & Co. *v.* Creager *et al.*, 97 Fed. Rep. 78.

Foreign Patents and Publications.

The patents (if printed) and other official patent publications of the following governments may be found in the Scientific Library of the U. S. Patent Office:

Austria-Hungary.
Barbadoes.
Belgium.
British Honduras.
Canada.
Ceylon.
Denmark.
Fiji.
Finland.
France.
Germany.
Great Britain.
Hungary.
Hawaii.
India.
Italy.
Jamaica.
Japan.
Leeward Islands.
Luxemburg.
Malta.
Mauritius.
Mexico.
Netherlands.
New South Wales.
New Zealand.
Norway.
Portugal.
Queensland.
Russia.
South Australia.
Spain.
Straits Settlements.
Sweden.
Switzerland.
Tasmania.
Trinidad.
Victoria.
West Australia.

Infringement.

I. In General.
II. Claims for Combination.
III. Contributory.
IV. By Cities and Corporations.
V. Process.
VI. Particular Cases.

I. In General.

1. Infringement is a tort which must be proved. It cannot rest wholly upon inference and conjecture. (C. C., S. D. N. Y. Dec. 5, 1898.)

Coxe, J.] *King *et al. v.* Anderson *et al.*, 90 Fed. Rep. 500.

2. The defendant's device is in accord with patents dated March 3, 1896 and March 16, 1897, under which justification is asserted but cannot be sustained, as complainant's patent was granted upon an application filed March 5, 1895, and antedated the application in both of the other patents. The fact that complainant's application was forfeited for inadvertence and subsequently reinstated, cannot affect this priority of any invention in the device. (C. C., E. D. Wis. July 5, 1898.)

Seaman, J.] *Western Electric Co. *v.* American Rheostat Co. *et al.*, 91 Fed. Rep. 650.

3. The fact that the alleged infringing device was more cumbersome and involved delays in its use, is only an ordinary feature of colorable infringements and does not avail to escape infringement. (C. C. A., 1st Cir. Jan. 30, 1899.)

Brown, J.] *Heap *v.* Greene *et al.*, 91 Fed. Rep. 792.

4. One who appropriates the exact device of a valid claim of a patent cannot escape infringement simply because he uses it in slightly differing environments. (C. C., N. D. N. Y. Jan. 3, 1899.)

Coxe, J.) *Deere *et al. v.* Arnold, 92 Fed. Rep. 186.

5. Invasion of the rights of a patentee may be avoided, however nearly approached, if the subject-matter of the grant be not substantially taken; but if the principle of the invention be appropriated, liability for infringement cannot be evaded

upon the ground that the mechanism employed by the infringer does not, in form and structure, precisely correspond with that described in the patent. (C. C., E. D. Penn. Mar. 6, 1899.)

DALLAS, J.] *Rood *et al. v.* Evans *et al.*, 92 Fed. Rep. 371.

6. A change of form does not avoid infringement of a patent unless the patentee specifies a particular form as a means by which the effect of the invention is produced, or otherwise confines himself to the particular form of what he describes. Even where a change of form somewhat modifies the construction, the action, or the utility of a patented thing, non-infringement will seldom result from such a change. (C. C., N. D. Cal. Jan. 23, 375.)

MORROW, J.] *Risdon Locomotive & Iron W'ks *v.* Trent, 92 Fed. Rep. 375.

7. An infringer cannot evade liability for his infringement by deliberately diminishing the utility of the invention, without materially changing its form, its chief function, or its manner of operation. (C. C. A., 6th Cir. Mar. 7, 1899.)

TAFT, J.] *Penfield *v.* Chambers Bros. Co., 92 Fed. Rep. 630.

8. It is an infringement for the licensee of the owner of a patent for a machine for setting lacing studs to use the machine for setting studs obtained from others, where the conditions of the license are that the licensee shall only use the studs manufactured by the licensor, the studs themselves not being patented. (C. C., D. Mass. July 29, 1898.)

LOWELL, J.] *Tubular Rivet & Stud Co. *v.* O'Brien *et al.*, 93 Fed. Rep. 200.

9. By the general principles of law and by analogy with other torts, a director of a corporation who, as director by vote or otherwise, specifically commands the subordinate agents of the corporation to engage in the manufacture of an infringing article, is liable individually in an action at law for damages brought by the owner of the patent so infringed. As with other infringers, it is immaterial whether the director knew or was ignorant that the article manufactured and sold did infringe a patent. (C. C. A., 1st Cir. Apr. 12, 1899.)

LOWELL, J.] *Nat'l Cash Register Co. *v.* Leland *et al.* Same *v.* Wright *et al.*, 94 Fed. Rep. 502.

10. One may not escape infringement by the mere joinder of two elements into one integral part. If the united part effects the same results in substantially the same way as the separate parts before the union, the change is colorable. (C. C. A., 6th Cir. May 2, 1899.)

LURTON, J.] *Bundy Mfg. Co. *v.* Detroit Time-Register Co., 94 Fed. Rep. 524.

11. An improvement may itself be patentable, but the inventor of an improvement acquires no right to appropriate the main invention to which his improvement relates; and it is of no consequence if the patented article be so dealt with as to impair its usefulness, if its essential features be retained. (C. C., E. D. Penn. May 26, 1899.)

DALLAS, J.] *Smith *et al. v.* Ulrich, 94 Fed. Rep. 865.

12. A person will not be permitted to appropriate a patented invention by adding thereto a new function which in no way changes the action of the patented combination. (C. C., N. D. N. Y. June 14, 1899.)

COXE, J.] *Consolidated Fastener Co. *v.* Hays *et al.*, 95 Fed. Rep. 168.

13. That the infringing device is so constructed as to secure only a part of the advantages derived from the device infringed is no defense; where the essential features of an invention have been appropriated, it is immaterial that the infringing device works poorly or is not so practicable as the one infringed. (C. C., S. D. N. Y. June 13, 1899.)

TOWNSEND, J.] *Cimiotti Unhairing Co. *et al. v.* Bowsky, 95 Fed. Rep. 474.

14. Where the president of a recently organized corporation was at the time of organization a licensee under complainant's patent, and the treasurer had but a short time before made a compromise with the complainant for past infringements, *Held*, that their knowledge was the knowledge of the corporation, and in a suit against the corporation for infringement of the patent, the corporation is precluded from setting up that the infringe-

ment was entered upon under the belief that the complainant's rights were worthless or abandoned. (C. C., D. N. J.)

KIRKPATRICK, J.] *Ryan *v.* Newark Spring Mattress Co., 96 Fed. Rep. 100.

II. CLAIMS FOR COMBINATION.

1. In a patent for a combination the alleged infringing machine must contain all of the elements of the combination or their mechanical equivalents. (Prouty *v.* Ruggles, 16 Pet. 337; Stimpson *v.* Ry. Co., 10 How. 329; Eames *v.* Godfrey, 1 Wall. 78; Seymour *v.* Osborne, 11 Wall. 516; Dunbar *v.* Myers, 94 U. S. 187; Fuller *v.* Yentzer, 94 U. S. 298; Merrill *v.* Yeomans, 94 U. S. 568; Water-Meter Co. *v.* Desper, 101 U. S. 332; Miller *v.* Brass Co., 104 U. S. 350; Rowell *v.* Lindsay, 113 U. S. 97; 5 Sup. Ct. 507.) (C. C. A., 9th Cir. Oct. 24, 1898.)

MORROW, J.] *Norton *et al.* *v.* Jensen, 90 Fed. Rep. 415.

2. Where the specification describes some details of the device which are made elements of the claim and which are not essential to the combination covered by the claim, it is not essential to constitute an infringement that the infringing device should contain such details. A description of such details is to be held as only pointing out the better method of using the combination. (C. C. A., 1st Cir. Dec. 9, 1898.)

PUTNAM, J.] *City of Boston *v.* Allen, 91 Fed. Rep. 248.

3. Where a patent is limited by the express terms of the claim, as well as by the description in the specification to the special details of construction, it is not infringed by a construction which omits one of the details with a corresponding omission of function. (C. C. A., 2d Cir. Apr. 4, 1899.)

WALLACE, J.] *Tower *v.* Eagle Pencil Co., 94 Fed. Rep. 361.

III. CONTRIBUTORY.

1. Where a defendant is engaged deliberately in manufacturing and selling a device designed and intended by him to enable an individual user thereof to employ complainant's patented process, said device being useful for no other process than in the practice of said process, he is guilty of intentional contributory infringement. (C. C., E. D. Mo., E. D. Dec. 27, 1898.)

ADAMS, J.] *New York Filter Mfg. Co. *v.* Jackson, 91 Fed. Rep. 422.

2. Where the defendant was a member of a firm of architects which advertised by means of circulars and otherwise to furnish mills similar to the one which is found to infringe, and while never having had a foundry or machine shop or iron works of their own when orders were secured, the firm have invited bids from various manufacturers for making the required machinery from plans furnished by themselves; and said defendant having made plans for the infringing mill which the owner made at his own manufactory, *Held*, that his position is that of a contributing infringer. (C. C., N. D. Cal. Jan. 23, 1899.)

MORROW, J.] *Risdon Iron & Locomotive W'ks *v.* Trent, 92 Fed. Rep. 375.

3. A person who sells a machine which is useful only for the purpose of making a patented article, or makes such sale with the knowledge that the thing sold is to be used to produce an infringing article, is himself liable as an infringer. (C. C., E. D. Penn. Feb. 25, 1899.)

DALLAS, J.] *American Graphophone Co. *v.* Hawthorne *et al.*, 92 Fed. Rep. 516.

4. One who sells an unpatented article to another, knowing the use to be made of it becomes liable as a contributory infringer if the proposed use is an infringement of a patent. (C. C., D. Mass. July 29, 1898.)

LOWELL, J.] *Tubular Rivet & Stud Co. *v.* O'Brien *et al.*, 93 Fed. Rep. 200.

5. The doctrine of contributory infringement has never been applied to a case where the thing alleged to be contributed is one of general use, suitable to a great variety of other methods of use, and especially where there is no agreement or definite purpose that the thing sold shall be employed with other things so as to infringe a patent right. (C. C., W. D. Mich. S. D. June 13, 1899.)

SEVERENS, J.] *Edison Electric Light Co. *et al. v.* Peninsular Light, Power & Heat Co. *et al.*, 95 Fed. Rep. 669.

IV. BY CITIES AND CORPORATIONS.

Where a city accepted a bid for electric light and gas fixtures,

and purchased the same after having been notified that they were being sold in infringement of a patent, taking a bond of indemnity from the bidder against the result of lawsuits, such city has no equity, on the ground of impropriety of enjoining a municipal corporation, to claim exemption from a preliminary injunction against using the fixtures pending a suit for the infringement, particularly where other fixtures can be substituted with little delay. (C. C. A., 2d Cir. Apr. 4, 1899.)

SHIPMAN, J.] *Pelzer *v.* City of Binghampton *et al.*, 90 Fed. Rep. 823.

V. PROCESS.

Two processes cannot be said to be substantially alike where the successive steps which they involve are different; and where several of the steps which are requisite to the one are wholly omitted from the other, identity of method cannot exist. (C. C. A., 3d Cir. Dec. 6, 1898.)

DALLAS, J.] *United States Glass Co. *v.* Atlas Glass Co., 90 Fed. Rep. 724.

VI. PARTICULAR CASES.

1. The legitimate rights of the holder of a patent for a valance for hammocks, canopies, lambrequins and similar articles where hanging drapery is commonly used, cannot be invaded by one who protects from wear the bottom of women's skirts; the two fields are wide apart and have nothing in common. (C. C., S. D. N. Y. Nov. 15, 1898.)

COXE, J.] *Palmer *et al.* *v.* De Yongh, 90 Fed. Rep. 281.

2. The only differences between the patented device and the alleged infringing device are: (1) in the latter, the catch is released by a movement radially outward, while in the former the releasing movement is radially inward. In this respect, the two devices are mechanical equivalents, the one of the other. (2) The device of the patent is operated by a flat spring, one end of which is attached to a stud depending from a spring plate; the infringing device is operated by a spiral spring, the corresponding end of which is attached either to a small cap at the top of the hub just beneath the operating handle, or is fas-

tened by passing through the handle itself, the cap in that case being omitted. *Held*, that the spiral spring is the equivalent of the flat spring, and the cap in which the end of the spring is inserted is the equivalent of the spring plate and depending stud, and that the patent is infringed. (C. C. A., 1st Cir. Mar. 13, 1899.)

LOWELL, J.] *Hart & Hegeman Mfg Co. *v.* Anchor Electric Co. *et al.*, 92 Fed. Rep. 657.

3. Where a patent for a roller-coasting structure claims "tracks running parallel with each other and having the starting and terminal stations at the same elevation." *Held*, that mathematical precision as to elevation is not necessary and not prescribed, and that the claim is infringed by another similar structure where the difference in elevation of starting and terminal stations is only six inches or a foot. (C. C. A., 3d Cir. May 1, 1899.)

ACHESON, J.] *Thompson *v.* Third Avenue Traction Co. *et al.*, 93 Fed. Rep. 924.

4. A claim for a combined bathing shoe and stocking having the sole formed of cork coated with rubber cement and having an outer covering of cotton or other fabric, *Held*, not infringed by a similar shoe and stocking with a sole made of linoleum and an outer covering of canvas. (C. C., S. D. N. Y. May 26, 1899.)

SHIPMAN, J.] *S. Rauh & Co. *v.* Guinzburg, 95 Fed. Rep. 151.

5. The Helouis process of treating lime crayons which is relied upon as anticipation in the case seems quite different in object and result from that of the patent. Within the broad range of equivalents indicated in Welsbach Light Co. *v.* Sunlight Incandescent Gas Lamp Co., 87 Fed. Rep. 221, the process of defendant is an infringement, and preliminary injunction ordered. (C. C., S. D. N. Y. July 19, 1899.)

LACOMBE, J.] *Welsbach Light Co. *v.* New York Chemical Refining Co., 95 Fed. Rep. 1007.

Injunction.

I. In General.
II. Dissolution.
III. Preliminary.
(*a*) *In General.*
(*b*) *When Granted.*
(*c*) *When Denied.*
IV. Prior Judgment.
V. Public Acquiescence.
VI. Violation of.

I. In General.

1. It is not the purpose of the patent laws to compel the discontinuance of the lawful manufacture and sale of known products in public use by reason of the mere recognition by some one that they possess merits not theretofore appreciated. (C. C., D. N. Jer. Feb. 13, 1899.)

Bradford, J.] *McEwan Bros. Co. *v.* McEwan *et al.*, 91 Fed. Rep. 787.

2. The owner of a patent is entitled to protection against the repetition of accidental or unintentional infringements. (C. C. A., 2d Cir. May 25, 1899.)

Lacombe, J.] *Thompson *et al. v.* N. T. Bushnell Co., 96 Fed. Rep. 238.

II. Dissolution.

Where the Circuit Court granted an injunction *pendente lite* upon the theory that the complainant's construction of the claim alleged to have been infringed had been positively adopted by the Circuit Court of Appeals in a prior suit upon the same patent, the only question to be determined on appeal from the order granting the injunction is whether that theory is well grounded, by ascertaining the scope of the decision in the prior suit, and *Held*, that the injunction was granted on a misunderstanding as to the scope of such decision and the order granting the same reversed. (C. C. A., 2d Cir.)

Shipman, J.] *American Graphophone Co. *v.* Nat'l Gramophone Co. *et al.*, 92 Fed. Rep. 364.

III. PRELIMINARY.

(*a*) *In General.*

1. The weight to be given to the circumstances of non-disclosure by the defendant or his witnesses upon a preliminary hearing with reference to the question of infringement was a matter which addressed itself to the court below in the exercise of a sound legal discretion as to whether a preliminary injunction should issue or not. Unless that discretion has been abused the action of the court below should not be reversed. (C. C. A., 6th Cir. Nov. 9, 1898.)

TAFT, J.] *Societe Anonyme du Filtre Chamberland Systeme Pasteur *et al.* *v.* Allen *et al.*, 90 Fed. Rep., 815.

2. The function of a court of appeals in reviewing an order of a lower court granting or refusing a preliminary injunction is such that it may properly affirm an order refusing a preliminary injunction in one case and an order granting it in another on substantially the same evidence, because it is easy to conceive a case presenting upon a preliminary hearing such an evenly balanced controversy that the court above would affirm the action of the court below, whether one way or the other, when that action involves the exercise, not of exact judicial judgment, but merely judicial discretion. **Id.*

3. The question to be determined on appeal from an order denying a preliminary injunction is whether the discretion of the court below was improvidently exercised, and *not* whether upon final hearing, upon full view of all of the facts in the case, the appellate court would, upon the evidence before it, reach the same conclusion as the court below. To justify an appellate court in reversing an order of this kind it must be quite clearly apparent that a mistake was committed by the court below. (C. C. A., 6th Cir. Mar. 7, 1899.)

SEVERENS, J.] *Proctor & Gamble Co. *v.* Globe Refining Co., 92 Fed. Rep. 357.

4. The three things essential to maintaining a preliminary injunction in a patent case are: (1) That the patent is valid; (2) that the plaintiff is the owner of a legal or equitable interest therein, and (3) that the defendant is about to commit an act of infringement. In order to entitle a complainant to a pre-

liminary injunction when the patent sued upon has never been adjudicated, he must show that the public has long used the invention and has acquiesced in the validity of the patent; and has never undertaken by litigation to question the patentee's exclusive rights thereunder or the validity thereof. (C. C., N. D. Ohio, E. D. Dec. 3, 1898.)

RICKS, J.] *Elliott *et al.* *v.* Harris *et al.*, 92 Fed. Rep. 374.

5. The rule as to public acquiescence or prior adjudication to support and warrant a preliminary injunction is as applicable to the case of design patents as it is to patents for machines. (C. C., D. Conn. Feb. 20, 1899.)

TOWNSEND, J.] *Smith *v.* Meriden Britannia Co., 92 Fed. Rep. 1003.

III. PRELIMINARY.

(*b*) *When granted.*

1. Infringement of the patent by defendant prior to the institution of this suit clearly appears by the use of an infringing attachment which may be readily connected and disconnected, and the fact that shortly prior to the institution of this suit, and when it was imminent, defendant disconnected such attachment and informed the complainant that he would no longer use the same, does not constitute sufficient ground for denying a preliminary injunction. The adaptability of the device to such facile changes affords a constant temptation to defendant, as well as a constant menace to complainant, and complainant is entitled to greater security against a once-existing infringement than the mere statement by defendant that he will no longer infringe. (C. C., E. D. Mo. E. D. Apr. 20, 1899.)

ADAMS, J.] *New York Filter Mfg. Co. *v.* Chemical Bl'dg Co., 93 Fed. Rep. 827.

2. Upon the question of infringement, the complainant must in order to obtain a preliminary injunction, satisfy the court beyond a reasonable doubt. (C. C., N. D. N. Y. May 21, 1899.)

COXE, J.] *Consolidated Fastener Co. *v.* American Fastener Co., 94 Fed. Rep. 523.

3. Where the court starts with the proposition that a patent

is valid, and since it is not disputed that the alleged infringing article responds to all of the tests required by the patent, such article must be held to be an infringement and an injunction will issue. (C. C., S. D. N. Y. June 8, 1899.)

LACOMBE, J.] *Badische Anilin & Soda Fabrik *v.* Matheson *et al.*, 94 Fed. Rep. 1021.

III. PRELIMINARY.

(*c*) *When denied.*

1. Where an essential element of a claim of a patent is omitted from the alleged infringing device, there is no infringement of the claim, and assuming that the patent is valid, it is limited in scope by the prior art; a case of infringement, such as would justify the granting of a preliminary injunction is not made out under these circumstances. (C. C., D. Mass. Oct. 31, 1898.)

COLT, J.] *Consolidated Fastener Co. *v.* Wisner *et al.*, 90 Fed. Rep. 104.

2. Where the patent sued on has never been adjudicated upon and the bill of complaint does not disclose any use, or public acquiescence in its validity, a preliminary injunction will not be granted to restrain an alleged infringement of it. (C. C., D. N. Jer. Dec. 14, 1898.)

KIRKPATRICK, J.] *Richmond Mica Co. *v.* De Clyne *et al.*, 90 Fed. Rep. 661.

3. Where the court in a prior suit against another defendant had decreed the validity of the patent which is the foundation of the present suit, and had enjoined the defendant therein from the manufacture, sale and use of machines declared to be infringing, an appeal in which suit is still pending, and the defendants in the present suit are users of some 21 of the infringing machines, in their extensive business in which they employ some 200 persons, and have large orders for future delivery of the products of said machines, and are financially responsible to answer in damages for any award which may be made against them, while the complainant has not been at any time and is not now able to supply defendants with the patented machine, except gradually as they could be built and even then at a large expenditure of money, *Held*, that an injunction against the use of such infringing machines would not be granted, for the

damages to the defendant would far outweigh the advantages accruing to the complainant. (C. C., D. N. Jer. Jan. 9, 1899.)

KIRKPATRICK, J.] *Huntington Dry Pulverizer Co. *et al.* *v.* Alpha Portland-Cement Co. *et al.*, 91 Fed. Rep. 535.

4. A preliminary injunction was denied where it sought to prevent the replacing of a part of a patented machine which wears out quickly, even though such part is the subject-matter of a separate claim of the patent and specially protected thereby. (C. C., N. D. Cal. Mar. 16, 1899.)

MORROW, J.] *Alaska Packers' Ass'n *v.* Pacific Steam Whaling Co. *et al.*, 93 Fed. Rep. 672.

5. Where there is a conflict of testimony, both expert and otherwise it would be an unwise exercise of judicial discretion to grant a restraining order before the hearing upon pleadings and proofs. (C. C., S. D. N. Y. Mar. 6, 1899.)

LACOMBE, J.] *Thomson-Houston Electric Co. *v.* Bullock Electric Co., 93 Fed. Rep. 991.

6. Where the patent has never been adjudicated and there has been no general acquiescence in its validity, and infringement is stoutly denied, the rule is well-nigh universal that a preliminary injunction should not issue. (C. C., N. D. N. Y. May 21, 1899.)

COXE, J.] *Consolidated Fastener Co. *v.* American Fastener Co., 94 Fed. Rep. 523.

7. Upon an application for preliminary injunction the question was raised whether or not by reason of the lapsing of a prior foreign patent subsequent to the application, but prior to the issue of the United States patent, such United States patent was improperly issued. Under decisions of the Supreme Court there is so much doubt as to the correct answer to this question, that it should not be decided upon preliminary motion, but upon final hearing, so that the defeated party may be in a position to apply to that court for a certiorari should it be so advised. (C. C., S. D. N. Y. July 12, 1898.)

LACOMBE, J.] *Welsbach Light Co. *v.* Apollo Incandescent Gaslight Co., 94 Fed. Rep. 1005.

8. Where a prior foreign patent lapsed between the date of application for the patent in suit and the date of its issuance, questions are raised as to the validity of the patent which ought not to be decided upon a preliminary motion, and where a preliminary injunction has been denied in another subsequent suit upon these facts, there is no good reason why a particular defendant should be enjoined while others are left free to infringe, and a motion to vacate a preliminary injunction will be granted. (C. C., S. D. N. Y. Aug. 1, 1898.)

LACOMBE, J.] *Welsbach Light Co. *v.* Rex Incandescent Light Co., 94 Fed. Rep. 1005.

9. A preliminary injunction should never be awarded where the right is doubtful or the wrong uncertain; and in a patent case it should not be awarded where infringement is not clearly established. (C. C. A., 3d Cir. June 1, 1899.)

DALLAS, J.] *Blakey *et al.* *v.* Nat'l Mfg. Co., 95 Fed. Rep. 136.

10. Where the question of infringement is doubtful and depends for its determination upon a broader construction of the claims of the patent in suit than was touched upon in prior adjudications, it should not be resolved upon a motion for preliminary injunction, but should be reserved until the final hearing of the cause. (C. C. A., 2d Cir. May 25, 1899.)

PER CURIAM.] *Sprague Electric Railway & Motor Co. *v.* Nassau Electric Ry. Co., 95 Fed. Rep. 821.

IV. PRIOR JUDGMENT.

1. Where the validity of a patent has been established by repeated adjudications, and no new case has been made out against its validity the earlier decisions are to be followed in granting a motion for preliminary injunction. (C. C., S. D. N. Y. Feb. 26, 1898.)

LACOMBE, J.] *New York Filter Mfg. Co. *v.* Loomis-Manning Filter Co., 91 Fed. Rep. 421.

2. Where the validity of a patent has been repeatedly upheld and injunctions have been granted against its infringement, its validity is no longer an open question upon a motion for a preliminary injunction, unless some new defense is interposed and the evidence offered to support it is so cogent and persuasive as

to impress the court with the conviction that, if it had been presented and considered in the former case, it would probably have availed to a contrary conclusion. (C. C., E. D. Mo., E. D. Dec. 27, 1898.)

ADAMS, J.] * New York Filter Mfg. Co. *v.* Jackson, 91 Fed. Rep. 422.

3. While it may not be improbable that the defendant may succeed at the final hearing in establishing the defenses upon which it relies in defeating complainant's patent, yet if the new evidence is not cogent, the questions presented thereby should not be determined adversely to complainants upon affidavits, with the result of depriving him, upon motion for a preliminary injunction, of the benefit of a prior adjudication in his favor after a strenuously contested litigation. (C. C. A., 2d Cir. Jan. 5, 1899.)

PER CURIAM.] * Doig *v.* Morgan Machine Co., 91 Fed. Rep. 1001.

4. Where there has been a prior, thoroughly considered decision on the question of infringement, the rule as to prior adjudication supporting a preliminary injunction, necessarily applies with the same effect as to a question of validity of the patent. In many cases one issue is involved in the other, and in either case the court to which the later application for preliminary injunction is made has a right to rely on a presumption that all the defenses of value were presented and considered in the earlier litigation. A different practice would deprive an inventor of the substantial advantages of protracted litigation in the first case, and would subject him, on the subsequent application, to all the labor and cost of investigating the merits on every discovery of some supposed anticipatory matter, not brought forward in the prior suits. Therefore, unless on all such issues the court accepts the results of such prior litigation except for some clear and cogent matter, the beneficent rule with reference thereto would be lost. (C. C., D. Mass. Mar. 15, 1899.)

PUTNAM, J.] * Duff Mfg. Co. *v.* Norton, 92 Fed. Rep. 921.

5. Where the patents sued on have been the subject of strenuous litigation in the federal courts of one circuit where their validity was sustained both by the Circuit Court and the Cir-

cuit Court of Appeals, the general rule of comity requires the court of another circuit to award a preliminary injunction, if there is infringement, and postpone to the final hearing the determination of the questions relating to the validity of the patents, unless there is some new evidence of such a clear and persuasive character as to leave no fair doubt that the former decisions were erroneous in point of fact and would have been different if the new matter had been before the court. (C. C., W. D. Mich. Aug. 3, 1898.)

SEVERENS, J.] *Duff Mfg. Co. *v.* Kalamazoo R. R. Velocipede & Car Co., 94 Fed. Rep. 154.

6. When a patent has been established by a decision of a Circuit Court after careful consideration upon a full record, another judge sitting subsequently in the same court upon application for preliminary injunction on *ex parte* papers, might well deem himself constrained, contrary even to his own judgment, to adopt the rulings of his own court, since he does not sit as a court of review to reverse upon substantially the same record the decision of a judge of co-ordinate jurisdiction. A re-examination of the rulings made upon the original hearing is to be sought, not in the Circuit Court, but in the Circuit Court of Appeals. (C. C., S. D. N. Y. May 26, 1899.)

LACOMBE, J.] *Welsbach Light Co. *v.* Rex Incandescent Light Co., 94 Fed. Rep. 1006.

V. PUBLIC ACQUIESCENCE.

In order to take the place of an adjudication, acquiescence must be long continued in such circumstances as to induce the belief that infringements would have occurred but for the fact that a settled conviction existed in the minds of manufacturers, vendors and users that the patent was valid and must be respected. A patent which is not molested simply because it is for no one's interest to infringe, is not acquiesced in within the legal acceptation of that term. (C. C., N. D. N. Y. May 21, 1899.)

COXE, J.] *Consolidated Fastener Co. *v.* American Fastener Co., 94 Fed. Rep. 523.

VI. VIOLATION OF.

1. Where the question of the violation by a defendant of an

injunction issued in a suit for infringement of a patent, depends upon whether or not a new article sold by defendant since the granting of the injunction is an infringement of complainant's patent, which is an intricate question dependent upon structure, requiring a comparison of the article with others and a consideration of other patents, the court will not attempt to determine it on a motion for an attachment, but, no intentional violation being claimed, will deny the motion, and leave the complainant to his remedy by a new bill. (C. C., S. D. N. Y. Feb. 28, 1899.)

WHEELER, J.] *United States Playing-Card Co. *v.* Spalding Bros. *et al.*, 93 Fed. Rep. 822.

2. Where a suit for the infringement of a patent was brought against "Frank Armstrong, *alias* James," defendant, his true name being James, and an order was issued restraining "the said defendant Frank Armstrong" from further infringement, the order being served upon the defendant, *Held*, that he being in fact the person guilty of the infringement, he was bound by the order, and his subsequent violation of the order subjected him to punishment for contempt. (C. C., S. D. N. Y. May 24, 1899.)

LACOMBE, J.] *Dickerson *v.* Armstrong, 94 Fed. Rep. 864.

3. An order imposing a fine for the violation of a preliminary injunction cannot be reviewed except upon an appeal from the final decree in the cause. (C. C. A., 2d Cir. May 25, 1899.)

DEHAVEN, J.] *Nassau Electric Ry. Co. *v.* Sprague Electric Ry. & Motor Co., 95 Fed. Rep. 415.

Interferences.

I. IN GENERAL.

II. ACCESS TO AND PRODUCTION OF PAPERS.

III. AMENDING APPLICATIONS, RULE 109.

IV. APPEAL.

(*a*) *In General.*

(*b*) *No Appeal Lies.*

V. BURDEN OF PROOF.

(*a*) *In General.*

(*b*) *When one Contestant is a Patentee.*

I. In General.

1. The practice of the defeated party to an interference attempting to retry the interference by filing or having filed in his behalf another application or by amending an application, and thus delaying the issue of a patent to the successful party to the first interference, cannot be too strongly condemned. (Feb. 17, 1899.)

Duell, C.] Bechman *v.* Wood, 87 O. G. 1073.

2. The motion for reconsideration of the Commissioner's decision of February 17, 1899, denied. (Feb. 23, 1899.)

Duell, C.] Bechman *v.* Wood, 87 O. G. 1074.

3. Where a claim is suggested to an applicant and every opportunity afforded him to place his application in condition for interference, *Held*, that his neglect to do so fairly raises the presumption that he is not the inventor of the subject-matter of the interference. (Apr. 13, 1899.)

Duell, C.] *Ex parte* Calm, 87 O. G. 1397.

4. Where an equitable owner of an application involved in interference petitioned to defend the interference, as applicant would not do so, *Held*, that there being no assignment of record and it appearing that the respective rights of the parties have been submitted for settlement to a competent court, it is not wise for this Office to do more than preserve the rights of the parties so far as it is able. (Sept. 27, 1899.)

Duell, C.] Reiner *v.* McPhail, 89 O. G. 521.

5. *Held*, further, that the applicant has the right to conduct the interference by an attorney of his own selection. *Id.*

6. *Held*, further, that under all the circumstances of the case

the equitable owner is entitled to be kept fully informed of the status of the interference, and to be furnished copies of the interference proceedings. *Id.*

II. ACCESS TO AND PRODUCTION OF PAPERS.

1. The purpose of rule 105 is to prevent the disclosure of other inventions than the one in controversy, and not to prevent the disclosure of the full record of the invention which is in controversy. (Jan. 6, 1899.)

GREELEY, A. C.] Hutin and Leblanc *v.* Fairfax, 66 MS. Dec. 142.

2. It was never intended by rules 105 and 106 that a party should be permitted to conceal from his opponent in interference anything but a clearly divisible invention not claimed by his opponent, and this construction is in harmony with rule 108. (Mar. 27, 1899.)

DUELL, C.] *Ex parte* Walrath, 87 O. G. 1397.

3. To permit a party to disclose to his opponent only the claim involved in interference when he has other claims based upon the same indivisible structure upon which the interfering claim is based would be in effect to nullify rule 109. *Id.*

III. AMENDING APPLICATIONS. *Rule* 109.

1. Under rule 109 an interferent is not restricted to the introduction of claims identical with the issue, but may introduce more specific claims directed to the same subject-matter, and if he desires to claim the invention at all, he should be allowed to do so with as few restrictions as those imposed upon the multiplicity and scope of claims of an original application. (Jan. 6, 1899.)

GREELEY, A. C.] Crocker *v.* Allderdice, 66 MS. Dec. 140.

2. Rule 109, under present practice, has but little bearing upon such cases, since the results intended to be accomplished by it are now accomplished prior to the declaration of the interference. But if the rule opens the way to amendment to one of the parties, it also opens the way to amendment to any other party, and neither is given an unfair advantage. *Id.*

3. While the purpose of rule 109 is to have the question of priority as to all matters which can be contested between the

parties settled in one proceeding, it does not follow that each of the claims admitted under the rule must be such as will constitute a separate count of the interference issue. If they are drawn to the same subject-matter, although they are not of the same scope as those made by the other party, they are admissible notwithstanding the fact that on account of the difference in scope there is no interference in fact under the present practice. The question of interference in fact between the claims is not decisive of the question as to whether they shall be admitted. (Feb. 10, 1899.)

GREELEY, A. C.] Uebelacker *v.* Brill, 66 MS. Dec. 271.

4. Motion to amend an application in interference under the provisions of rule 109 should, if seasonably presented, be transmitted to the primary examiner for decision even where judgment of priority has been rendered on the record under rule 114. (Nov. 25, 1898.)

GREELEY, A. C.] Dempsey *et al. v.* Wood, 86 O. G. 182.

5. It is the policy of the Office to have all questions which may be presented brought up and considered at one time and in one proceeding, and since the contested proceedings are not at an end until the limit of appeal has expired it is proper within that time to make a motion to amend under rule 109 after judgment on the record. *Id.*

6. It may be that no substantial advantage is apparent in a particular case for considering the matter on motion, but it is always best that the course of procedure should follow that seemingly indicated in the rule unless there is some good reason why the rule does not and was not intended to apply. *Id.*

7. It is a well-settled and long-established practice of the Patent Office to allow amendments to applications to be made under proper circumstances to supply omissions and defects in the original specifications and claims as filed which have occurred by mistake, oversight, or inadvertence, or want of the requisite skill in the preparation and presentation of cases to the Office, and the making of such amendments should not be allowed to operate to the prejudice of the claims of applicants, if made in due and reasonable time and in good faith. (C. A. D. C. Oct. 4, 1899.)

ALVEY, J.] *Hulett *v.* Long, 89 O. G. 1141.

8. While it is permissible to amend an application after the issue of a patent so as to provoke an interference with such patent where the application as originally filed disclosed the invention, such amendment should not be permitted where the invention itself is sought to be changed by such amendment. (Nov. 13, 1899.)

DUELL, C.] Grinnell *v.* Buell, 89 O. G. 1863.

IV. APPEAL.

(*a*) *In General.*

1. Even in the absence of any motion by a party to an interference, the Office will of its own motion, take notice of the limit set by it within which action must be taken. (Feb. 10, 1899.)

GREELEY, A. C.] Uebelacker *v.* Brill, 66 MS. Dec. 271.

2. A party is deprived of his right of appeal by the expiration of the limit set by the Office, and it requires no action on the part of his opponent to make that limitation effective. *Id.*

3. The Office is not bound by the strict rules of practice that obtain in the courts, and the Commissioner has authority to extend the limit of appeal in a proper case, even after the limit of appeal has expired; but it is well settled practice not to extend such limit except upon a showing of good and sufficient reasons. (July 26, 1899.)

GREELEY, A. C.] Ancora *v.* Keiper, 67 MS. Dec. 317.

4. Where it was clear that the failure to pay the fee and thus perfect the appeal before the limit of appeal had expired was due to inadvertence, accident or mistake, and the delay was not due to any intention or negligence on the part of appellant, the motion to extend the limit of appeal was granted. *Id.*

5. Where an applicant fails to make a claim suggested by the examiner for the purpose of interference and as a result the examiner rejects any claim of the application for the reason that failure to make the claim and to become a party to the interference will "be interpreted as equivalent to a concession," *Held*, that appellant's remedy is by appeal to the Examiners-in-Chief and not by petition to the Commissioner. (Apr. 13, 1897.)

DUELL, C.] *Ex parte* Calm, 87 O. G. 1397.

IV. APPEAL.

(*b*) *No Appeal Lies.*

1. Rule 124 provides that no appeal can be taken from the decision of the examiner, holding that a party has a right to make a claim, and this rule applies whether the question is raised by amendment under rule 109 or comes up under some other rule. (Feb. 10, 1899.)

GREELEY, A. C.] Uebelacker *v.* Brill, 66 MS. Dec. 271.

2. The rule prohibiting an appeal from a favorable decision on patentability applies, whatever reason is given for that decision, since it is well settled that the appeal must be from the decision and not from the reasons advanced in support of it. (*Bread v. Smith*, 84 O. G., 809.) The rule is not founded on the presumption that no mistake will ever be made in holding a claim patentable, but is for the reason that it is essentially an *ex parte* matter in which no person other than the applicant can have such interest as to entitle him to be heard. It is the well-settled policy of the Office to refuse to entertain an appeal from such a decision. (Jan. 6, 1899.)

GREELEY, A. C.] Woodward *v.* Newton, 86 O. G. 490.

3. There being no direct appeal from the examiner's decision affirming patentability, a contestant will not be permitted to obtain indirectly a review thereof upon appeal by merely misnaming the action and calling it a petition. (Manny *v.* Easley *v.* Greenwood, 48 O. G. 538, cited.) *Id.*

4. When a motion to dissolve alleging that the device of one of the parties is inoperative was denied by the Primary Examiner, no right of appeal existed and the Examineri-in-Chief properly dismissed such appeal. (Dec. 15, 1898.)

GREELEY, A. C.] Fowler *v.* Dodge, 86 O. G. 1497.

5. A party will not be permitted after the interference is decided to prevent action on his opponent's application or the issue of his patent by merely filing an appeal when it has been decided that he has no right of appeal. *Id.*

6. Where an appeal was taken to the Commissioner from the decision of the examiner denying a motion to dissolve an interference on questions which relate to the merits of the invention,

Held, that as under the rules and the uniform practice of the Office the Commissioner has declined to take jurisdiction of such questions either by appeal or petition, the appeal should be dismissed. (Manny *v.* Easley *et al.*, 48 O. G., 548; Stewart *v.* Ellis *et al.*, 49 O. G., 1983, and Edison *v.* Stanley, 57 O. G., 273, cited.) (Jan. 19, 1899.)

DUELL, A. C.] Breul *v.* Smith, 86 O. G., 1635.

7. The practice of the Office under which the Commissioner declines to take jurisdiction of questions relating to the merits brought to him by petition or appeal from the decision of the Primary Examiner on a motion to dissolve should be followed unless there should appear some extraordinary reason for departing therefrom. *Id.*

V. BURDEN of PROOF.

(*a*) *In General.*

1. To overcome a case made by an earlier application the same weight of evidence is not required as in criminal cases. It is only necessary that the burden of proof should be sustained by the junior applicant by a preponderance of testimony. (C. A., D. C. Jan. 3, 1899.)

SHEPARD, J.] *Esty *v.* Newton, 86 O. G. 799.

2. Upon him who would overcome the presumption that to the person who has first reduced to practice belongs the merit also of priority of conception, the burden rests of doing so by satisfactory evidence. (C. A., D. C. Feb. 8, 1899.)

MORRIS, J.] *Bader *v.* Vajen, 87 O. G. 1235.

3. A reissue applicant is entitled to the date of his original application as his date of filing in determining the question of burden of proof under Rule 116. (Aug. 31, 1899.)

GREELEY, A. C.] Walsh *v.* Hallbauer, 88 O. G. 2409.

4. A reissue can be granted only for an invention clearly disclosed and intended to be claimed in the original patent, and therefore if a party is entitled to a claim by reissue it follows that the original application clearly disclosed the matter covered by it. *Id.*

V. Burden of Proof.

(*b*) *When one Contestant is a Patentee.*

1. When an applicant comes into the Patent Office to overthrow a prior patent, he assumes the position, with all its burdens, of a defendant in a suit who sets up to defeat the right of a plaintiff, the want of novelty and invention covered by the patent held by the plaintiff, or the fact of existence of priority of invention by the defendant or some third person having a right to the invention superior to that claimed by the plaintiff. In such case the patent held by the plaintiff furnishing *prima facie* evidence that the patentee is the first inventor of the device described in the patent and of its novelty, that *prima facie* effect can only be overcome and defeated by clear and indubitable evidence. In Cantrell *v.* Wallich, 35 O. G. 871; 117 U. S. 690, the Supreme Court of the United States in speaking of the effect of a patent in such case said: The burden of proof is upon the defendant to establish this defense; for the grant of letters patent is *prima facie* evidence that the patentee is the first inventor of the device described in the letters patent and of its novelty. Smith *v.* Goodyear Dental Vulcanite Co., 11 O. G. 246; 93 U. S. 486; Lehmbeuter *v.* Holthaus, 21 O. G. 1783; 105 U. S. 94. Not only is the burden of proof to make good this defense upon the party setting it up, but it has been held that every reasonable doubt should be resolved against him. Citing Coffin *v.* Ogden, 5 O. G. 270; 18 Wall. 120, 124, and Washburn *v.* Gould, 2 Story 122, 142. (C. A., D. C. Jan. 17, 1899.)

Alvey, J.] *Williams *v.* Ogle, 87 O. G. 1958.

2. E., the senior party and patentee, filed his application January 28, 1896, and R. filed November 6, 1896. To overcome E.'s case, R. alleged conception on January 17, 1895, and reduction in February or March, 1895. *Held*, that R., on whom was the burden of proof and who under the rules is required to prove his case by evidence so cogent as to leave no reasonable doubt, has failed to discharge the onus placed upon him, and priority is therefore awarded to E. The decision of the Commissioner of Patents, Ruete *v.* Elwell, 65 MS. Dec. 256, affirmed. (C. A., D. C. May 4, 1899.)

Shepard, J.] *Reute *v.* Elwell, 87 O. G. 2119.

VI. Declaration of.

(*a*) *In General.*

1. It is not proper to include several claims in one application under one issue, since they cannot all mean the same thing, and therefore confusion as to the meaning of the issue would be likely to result in taking testimony. (Wolfenden *v.* Price, 83 O. G. 1801.) (Jan. 16, 1899.)

Greeley, A. C.] Sadtler *v.* Carmichael *v.* Smith, 86 O. G. 1498.

2. It is proper to include two applications of the same party under one issue when the invention in controvery is disclosed and claimed in both cases. *Id.*

3. Where the issue of the interference was for a process and the examiner included under that issue claims for an article of manufacture which were not made by one of the parties, *Held*, that the interference was improperly declared and that the article claims should not have been included in the interference. (Feb. 5, 1899.)

Greeley, A. C.] Calm *v.* Schweinitz *v.* Dolley *v.* Geisler, 86 O. G. 1633.

4. Where the claims of the applications were rejected and the examiner declared the interference, he in effect withdrew the rejection of the claims; but it is bad practice to declare an interference before the parties have been notified that there is an interference and given an opportunity to remove the objections and overcome the references. *Id.*

5. When the claim of one party includes a step in the process not included in the issue or the claim of the other party, there is no interference in fact. (Dec. 21, 1898.)

Greeley, A. C.] Bullier *v.* Willson, 87 O. G. 180.

6. When the specification clearly and fully sets forth the advantages of using an alternating instead of a direct current, it cannot be held that when the limitation to the use of an alternating current was inserted in the claim it was intended to or does in fact apply to the use of any current broadly. *Id.*

7. In the consideration of an interference the Office is no more competent than the courts to say that an element which an applicant has placed in his claims is an immaterial one,

especially when in framing the issue the Office had made the element a part thereof. (Hammond *v.* Hart, 83 O. G. 743, and Wolfenden *v.* Price, 83 O. G. 1801, cited.) (Mar. 2, 1899.)

DUELL, C.] Streat *v.* Freckleton, 87 O. G. 695.

8. Where there is but a single issue in the interference, but the interference letter states that said issue constitutes claim 2 of H.'s original application, and also embraces the substance of claims 1 and 4, respectively, of two divisional applications, *Held*, that under the present practice H. should be notified that these claims will be held to await the result of the interference, and will be rejected at the termination of the interference if priority is awarded to his opponent. If, however, they are not substantially the same claims and such claims are made by his opponent, then said claims should be placed in one or more different interferences. In any event the divisional applications are not properly involved in this interference. (May 12, 1899.)

DUELL, C.] Eastman *v.* Houston, 87 O. G. 1781.

VI. DECLARATION OF.

(*b*) *Application and Patent.*

1. If it is clear that a patentee's claim is limited to a specific construction and the later applicant chooses to claim the same invention generically and can establish a *prima facie* right to the claim under the rules, such generic claim may be allowed without an interference. So, too, if the later applicant limits his claim to a species not claimed by the patentee. (Feb. 1, 1899.)

GREELEY, A. C.] Edison *v.* White, 66 MS. Dec. 240.

2. An applicant cannot be permitted, by merely wording his claim differently from that of a patent granted before the filing of his application, to secure a patent for the same invention unless and until he has established his right thereto in an interference proceeding. *Id.*

3. B's application was not filed until after R's patent had been granted, and he had been notified that he (B) was infringing said patent. R had also manufactured the device and placed it on the market a year before B commenced to manufacture it. *Held*, that in order to prevail, B must prove his

case beyond a reasonable doubt, and not merely by a preponderance of evidence. (Mar. 25, 1899.)

GREELEY, A. C.] Bragger *v.* Rhind, 66 MS. Dec. 409.

4. If the evidence in an interference between an application and a patent is susceptible of two interpretations, one sustaining and one destroying the patent, the one sustaining it must be accepted. *Id.*

5. Where an interference was found to exist between an application and a patent, and upon request of applicant the interference was immediately declared without waiting to determine the question of the patentability of the claims of his application which did not interfere, *Held*, that this is proper practice, since nothing is to be gained by delaying the declaration in cases of this kind, and it is to the advantage of all parties, and is the purpose of the rules to have interferences settled as soon as possible. (Aug. 22, 1899.)

GREELEY, A. C.] Shaffer *v.* Dolan, 67 MS. Dec. 392.

6. That portion of rule 96 relating to the putting of an application in condition for allowance, applies as well where one of the parties to an interference is a patentee, and an interference need not be delayed because of the failure of the applicant to put his case in condition for allowance. *Id.*

VI. DECLARATION OF.

(*c*) *Claims; Subjects-Matter must Conflict.*

A condition precedent to the declaration of an interference under the present practice is, that interfering claims of one interfering party must be read upon the structure of the other party, and where this condition is absent no interference should be declared. (Jan. 6, 1899.)

GREELEY, A. C.] Crocker *v.* Allderdice, 66 MS. Dec. 140.

VI. DECLARATION OF.

(*d*) *Suggesting Claims.*

The examiner having held that G's original disclosure supported the claim of the issue which was H's claim and had been suggested to G, and that G had a right to make the claim, and it appearing that H substantially admitted that there was an interference if G had a right to make the claim. *Held*, that

upon appeal from the examiner's denial of H's motion to dissolve on the ground of no interference in fact, and irregularity in declaring the interference, the examiner's decision should be affirmed. (May 16, 1899.)

DUELL, C.] Gathman *v.* Hurst, 67 MS. Dec. 61.

VI. DECLARATION OF.

(*e*) *Genus and Species.*

1. A generic and specific claim do not interfere even when based on the same species, and valid patents may issue to different inventors—to one for the specific claim, to the other for the generic claim—and the law does not require that before the patents issue it should be determined in the Patent Office that one is the first inventor of the species and the other the first inventor of the genus. (Reed *v.* Landman, 55 O. G. 1275, overruled.) (May 6, 1899.)

DUELL, C.] Williams *v.* Perl, 87 O. G. 1607.

2. The case of Miller *v.* Eagle Manufacturing Co. (66 O. G. 845) does not hold that a patent cannot issue to A with a generic claim and to B with a specific claim, both based on the disclosure of the same species. *Id.*

3. The presumption is that the one to make the specific claim is the first inventor of the species and that the one who makes the generic claim is the first inventor of the genus, and this presumption is strengthened, as in the present case, when neither applicant will make both generic and specific claims upon the suggestion of the Office. *Id.*

4. It does not follow from the fact that two inventors finally reach the same species that both of them first conceived or embodied the invention in the form of that species shown by both. Either or both of them might have independently conceived of the genus in a different specific form. *Id.*

5. Notwithstanding the fact that two inventors filing independent applications disclose the same species, it does not follow that the first inventor of the species shown by both was the first inventor of the genus. The one earlier in the field may have reached the species by a process of evolution. The one later in the field may have conceived and disclosed the species shown at the very outset of his creative act. *Id.*

VI. Declaration of.

(*f*) *Claims Identical in Scope.*

1. Both parties disclose a lubricator of the type known as "balanced hydrostatic sight-feed lubricators." They disclose suitable cylinder and equalizing-pipe connections. In W's claim in interference these connections are specified, while in E's' they are not. Both parties disclose a valve for controlling the by-passage automatically, and it is recited as an element in the respective claims of the parties. W's claim recites that this valve is automatically regulated "by variations of pressure within the duct," such a statement not being in E's' claim. *Held*, that under the practice of the office the limitations found in one claim and not in the other cannot be construed as non-essential, and the interference was improperly declared. (Sept. 21, 1899.)

Duell, C.] Essex *v.* Woods, 89 O. G. 353.

2. *Held*, further, that had the examiner believed that E's device was inoperative without the use of suitable cylinder and equalizing-pipe connections and without the valve being automatically operated by variations of pressure within the duct, and called upon E to amend his claim accordingly, there would have been no necessity for placing a construction upon E's claim by reading into it certain limitations. *Id.*

3. *Held*, further, that had E refused to comply with the examiner's suggestion, the examiner would have been justified in rejecting E's claim as being for an inoperative device and as unpatentable over the W invention. *Id.*

4. An interference is not sufficiently clear and definite which requires that certain limitations in the claims of one party should be held to be immaterial, and that the other limitations should be read into the claims of either one or the other party to the proposed interference in order to make them the issue of the interference. (Wolfenden *v.* Price, 83 O. G. 1801, cited.) *Id.*

VII. Dissolution.

(*a*) *In General.*

1. It would be contrary to equity and good practice to dissolve an interference after the parties had both taken testimony,

and proceeded to trial, if the dissolution would be followed immediately by a redeclaration on an issue founded upon the same structure; but where only one of the parties had taken testimony, and under the present practice there is no interference in fact, and the interference should not have been declared in its present form. *Held*, that dissolution was proper. (Jan. 6, 1899.)

GREELEY, A. C.] Crocker *v.* Allderdice, 66 MS., Dec. 140.

2. When under the present practice the interference was improperly declared by reason of the fact that the claims of the parties are not of the same scope, but it appears that the party with the specific claim can make and intends to make the broad claim, although he has not actually presented such claim by amendment, *Held*, that the interference should not be dissolved, since a dissolution would merely result in a redeclaration on the same issue. (Dec. 1, 1898.)

GREELEY, A, C.] Morss *v.* Henkle, 86 O. G. 183.

3. It is irregular to include several claims of one party under one issue; but when judgment has been rendered on the record and no testimony is to be taken, it is not such irregularity as to preclude a proper decision on priority, and is therefore not a good ground for dissolution. *Id.*

4. Motion for dissolution cannot be made in the first instance before the Primary Examiner, although the interference is before him for the consideration of another motion, but it must be made before and transmitted by the Examiner of Interferences before the Primary Examiner can take jurisdiction of it. (Dec. 8, 1898.)

GREELEY, A. C.] Howard *v.* Hey, 86 O. G. 184.

5. Since the decision in Hammond *v.* Hart (83 O. G. 743) it has been the practice of the Office to dissolve an interference where each party has not made the claim of the other, if no testimony has been taken and the parties will not be injured by the dissolution. (Feb. 5, 1899.)

GREELEY, A. C.] Calm *v.* Schweinitz *v.* Dolly *v.* Geisler, 86 O. G. 1633.

6. Certain affidavits filed in the case on motion to dissolve

should not be considered, as they were not entitled in the cause, (Goldstein *v.* Whelan, 69 O. G. 124;) but the memorandum filed on behalf of one of the parties referring to certain publications to show that the invention as described by another of the parties is inoperative, should be considered to the extent of examining the publications referred to in that paper to ascertain whether they show that the process is inoperative. *Id.*

7. The allegation that the testimony shows that joint applicants who are parties to the interference are not joint inventors is not a proper ground for a motion to dissolve or for a suspension of the interference. (Dec. 16, 1898.)

GREELEY, A. C.] Shiel *v.* Lawrence *et al.*, 87 O. G. 180.

8. To pass on the question of joint invention would require as full consideration of the testimony as would the question of originality, and therefore both questions should be decided at one time. *Id.*

9. The question as to whether L and K are original inventors is just as important as is the question whether they are joint inventors, and therefore the question of joint invention will not be given the preference at the mere option of their opponent. *Id.*

10. The Commissioner of Patents is vested with power to dissolve an interference on his own motion whenever he considers that justice and equity demand that it should be done. (Bender *v.* Hoffmann, 85 O. G. 1737, and Beehman *v.* Wood, 68 O. G. 2087, cited.) (Apr. 13, 1899.)

DUELL, C.] *Ex parte* Calm, 87 O. G. 1397.

11. Where a motion was made to dissolve an interference on the ground of (1) no interference in fact, (2) no right of one of the parties to make a claim, and (3) irregularity in declaring the interference, and the examiner in his decision treated the grounds as raising only the question of the right of one of the parties to make the claim and decided that there was such right and refused to fix a limit of appeal, *Held*, that the examiner's refusal to set a limit of appeal raises a question which if carried to its logical conclusion would nullify rule 124 and make the primary examiner the sole tribunal to determine whether or not an interference should continue. (July 12, 1899.)

DUELL, C.] Silverman *v.* Hendrickson, 88 O. G. 1703.

12. Where motion is made to dissolve an interference based upon various grounds, some of which are appealable to the Commissioner under rule 124, it cannot be successfully maintained that the primary examiner by grouping the appealable grounds with a ground which is not appealable may prevent the Commissioner from reviewing his action. It is not within the power of a primary examiner by such ingenious action to nullify an office rule. *Id.*

13. As both parties consented to and did present the question of merits for decision, *Held*, that it is unnecessary to remand the case to the primary examiner for the purpose of setting a limit of appeal, and the appeal disposed of. *Id.*

14. It is the almost uniform practice of the Office not to transmit motions to dissolve an interference until after the preliminary statements are filed and approved. In the exceptional cases where such motions have been transmitted prior to the approval of the statements, it has been for the reason that the hearing could be had "under such circumstances as would make it just to hold parties to the result of a contest as *res adjudicata*." (Laurent-Cely *v.* Payen, 51 O. G. 621.) (Dec. 7, 1899.)

DUELL, C.] King & Badendreier *v.* Libby, 89 O. G. 2653.

15. A motion to dissolve an interference on the ground that there has been such irregularity in declaring the interference as would preclude the proper determination of the question of priority and that no interference in fact exists should not be transmitted to the primary examiner until the preliminary statements have been approved. *Id.*

16. The questions raised by such a motion cannot be so correctly determined without an inspection of the opponent's specification and drawings as it can with it. It cannot at the present time be so heard and determined that the parties could be justly held to be bound by it in subsequent proceedings. *Id.*

17. Moving to dissolve an interference upon any of the grounds stated in rule 122 before the preliminary statements are opened and approved is a practice not to be encouraged. *Id.*

18. Even though a decision should be *res adjudicata* between the parties upon one or two questions presented by a motion to

dissolve before the preliminary statements are opened, the other grounds upon which motions to dissolve might be made as a matter of right within twenty days after the statements are opened and approved could still be considered, and the condition of disposing of motions to dissolve by piecemeal would result, thus entailing an unnecessary burden upon parties to an interference and increasing the expense of proceedings and unnecessarily prolonging them. *Id.*

VII. DISSOLUTION.

(*b*) *Rule 122.*

1. A petition praying that the examiner "* * * be advised that from every motion based upon the ground of irregularity, wherein it is contended by the moving party that the ground of irregularity involves something more than the question of patentable invention of the issue, a limit of appeal should be fixed to enable such moving party to appeal;" cannot be granted, since the Office must, without regard to the views of the parties, determine for itself whether the grounds urged as showing what the moving party calls irregularity do in fact relate to the merits. In each case it is not a question as to the opinion of the parties or their contentions, but it is one of fact. If the reasons stated as showing irregularity really involve the question of patentability or the applicant's right to make the claim, it involves the merits, and a party cannot transform it into another question by merely calling it irregularity. The four grounds for dissolution set forth in rule 122—namely, interference in fact, irregularity, patentability, and right to make the claim—have distinct and independent meanings, which should not be confused by parties bringing motions under that rule. Each ground which it is desired to urge should be separatedly alleged and should be given the proper title specified in the rule. (Jan. 6, 1899.)

GREELEY, A. C.] Woodward *v.* Newton, 86 O. G. 490.

2. Interference in fact refers to the question of conflict in subject-matter claimed, as set forth in Hammond *v.* Hart, (83 O. G. 743), and irregularity means some vital formal defect which will preclude a proper decision on priority, although there may be a conflict in subject-matter, such as indefiniteness

or uncertainty in the wording of the issue. These questions relate strictly to the conduct of the interference proceedings without involving the merits of the invention or either party's right to a patent, and are therefore essentially *inter partes* questions which are appealable directly to the Commissioner. *Id.*

3. The question of patentability and the right of an applicant to make the claim clearly relate to the merits, and when appealable at all are *ex parte* questions between the applicant whose claim is affected and the Office. (Painter *v.* Hall, 83 O. G. 1803.) As stated in Zeidler *v.* Leech, (54 O. G. 503:)

> Questions involving the "merits of an invention" are questions concerning the meritorious or unmeritorious attitude of an alleged invention to the antecedent rights of the public; or, in other words, questions other than questions of "form" arising between the applicant and the Office. * * * If they were not *ex parte*—that is to say, if the questions which go to the Examiners-in-Chief in the first instance under rule 124 were not always and necessarily *ex parte* questions—the rule which denies to all but one of the parties the right to be heard would be formulated injustice and nothing else. *Id.*

4. The question of patentability of course relates generally to the question as to whether there is a bar to the grant of a patent containing the claim in controversy, whereas the question of the right of an applicant to make the claim involves the question whether that particular applicant has a right to claim that invention aside from any independent or general bar to the grant of a patent covering it—such, for instance, as new matter introduced after the case is on file. *Id.*

5. When two applications of one party are included under one issue, the allegation that the applicant has no right to make the claim in one of those cases, although it is admitted that he has such right in the other case, is a proper ground for a motion to dissolve. (Jan. 16, 1899.)

GREELEY, A. C.] Sadtler *v.* Carmichael *v.* Smith, 86 O. G. 1498.

6. It is to be presumed that claims which have not been specifically rejected are regarded as allowable. Even if claims have been rejected their inclusion in an interference is in effect a waiver of that rejection. The failure of the examiner to state that the claims included are allowable is therefore no good ground for a dissolution of an interference. *Id.*

7. Whether or not an applicant's device will operate in the manner set forth by him, his description of his method and his

claim to it must be accepted in so far as the question of interference in fact is concerned. A claim cannot be construed to mean something different from that intended and clearly indicated by the terms employed. *Id.*

6. When the claim of a party covers a method which includes a step not claimed or disclosed by the other parties, there is no interference in fact, whether or not he has the right to claim that method himself. *Id.*

VII. DISSOLUTION.

(*c*) *Time Allowable for Filing Motions.*

After judgment has been rendered on the record under rule 114, a motion for dissolution may be made at any time within the limit of appeal from such judgment. This includes not merely the limit of appeal first set, but any extension thereof granted with the approval of the Office. (Law *v.* Woolf, 55 O. G. 1527.) (Dec. 1, 1898.)

GREELEY, A. C.] Morss *v.* Henkle, 86 O. G. 183.

VII. DISSOLUTION.

(*d*) *Statutory Bars.*

1. The question of public use will not be inquired into during the progress of an interference. The fact that it is alleged to be shown by the statements of the parties in interest in another proceeding in which they were involved is no ground for making this case an exception to the rule. (Dec. 8, 1898.)

GREELEY, A. C.] Howard *v.* Hey, 86 O. G. 184.

2. Where a motion was made to dissolve an interference on the ground that "the invention disclosed in the issue of said interference is not patentable to Leonard Paget or his assignees, the Reliance Lamp Electric Company, by virtue of concessions made in the testimony taken in behalf of said Leonard Paget, which concessions allege that the subject-matter of the issue embraces no invention over the subject-matter disclosed in a prior patent, No. 618,993, granted to said Leonard Paget on the 7th day of February, 1899," *Held*, that the motion being based upon grounds arising out of testimony taken on the question of priority, it should not under the settled practice of the Office be transmitted to the primary examiner. (Cook *v.* Leach, 42 MS.

Dec. 370; Potter *et al. v.* Soden, 47 MS. Dec. 119; Thomson *et al. v.* Hisley, 66 O. G. 1596, cited.) (Oct. 30, 1899.)

DUELL, C.] Paget, *v.* Bugg, 89 O. G. 1342.

3. *Held*, further, that the testimony on which the motion is based is such testimony as should be considered on the question of priority, and if the examiner of interferences or the examiners-in-chief are of the opinion that it establishes a statutory bar to the grant of a patent, rule 127 provides relief for the appellant in that these tribunals may call the Commissioner's attention to the statutory bar. *Id.*

VII. DISSOLUTION.

(*e*) *Transmittal of Motion to Primary Examiner.*

1. It is well settled that when a motion for dissolution is transmitted to the primary examiner he does not have jurisdiction of the interference for all purposes, but merely to decide the particular motion which has been transmitted to him. (Dec. 8, 1898.)

GREELEY, A. C.] Howard *v.* Hey, 86 O. G. 184.

2. A motion to dissolve made after testimony has been taken should not be transmitted to the primary examiner when no excuse is given for the delay except in so far as it is based upon the testimony. Such motions cannot properly be based upon the testimony. (Dec. 16, 1898.)

GREELEY, A. C.] Shiels *v.* Lawrence, *et al.*, 87 O. G. 180.

VIII. EFFECT OF PATENT OFFICE DECISIONS IN THE COURTS.

1. There is a great difference between inoperativeness and imperfection. It is well known that many invention were extremely crude in their inception, and it is not always easy to recognize the original conception in the perfect device. (C. A. D. C., Apr. 4, 1899.)

MORRIS, J.] *Fowler *v.* Dodge, 87 O. G. 895.

2. As it is not usual for courts to disturb the conclusions of the Patent Office on such a question as the operativeness of a device as shown and described by an application for patent without very cogent proof of error, and there being no such proof in this case, *Held*, that the decision of the Patent Office

that the D application describes an operative device should be affirmed. *Id.*

IX. *Ex Parte* Proceedings.

1. Whether the claims made by the defeated party to an interference, and read upon the disclosure made in his application are or are not met by the disclosure made by the successful party, is a question to be determined *ex parte* and the practice approved in *ex parte* Guilbert, 85 O. G. 454; Sand. Pat. Dig. 1898, 76, 94, should be followed. (Feb. 23, 1899.)

Greeley, A. C.] Richards *v.* Nickerson, 66 MS. Dec. 312.

2. The question of patentability and the right of an applicant to make the claim clearly relate to the merits, and when appealable at all, are *ex parte* questions between the applicant whose claim is affected and the Office. (Painter *v.* Hall, 83 O. G. 1803. (Jan. 6, 1899.)

Greeley, A. C.] Woodward *v.* Newton, 86 O. G. 490.

X. Issue.

1. For the purposes of the interference, the issue should be construed, whenever by reason of material differences found to exist between the inventions disclosed in the applications of the parties it becomes necessary to construe the issue, with reference rather to the disclosure made in the application of the senior party than that of the junior party, and where priority is awarded to the senior party, the effect of such construction is to make his application as to the claim of the issue as read upon the disclosure made by him, a part of the prior art so far as the junior party is concerned—to make it, in short, a reference which the junior party must avoid in drawing his claims. (Feb. 23, 1899.)

Greeley, A. C.] Richards *v.* Nickerson, 66 MS. Dec. 312.

2. The issue of an interference is to be strictly construed, and where an applicant copies the claims of a patent for the purpose of an interference, the issue must be construed in the light of the specification of the patent. (June 24, 1899.)

Duell, C.] Thomas *v.* Chapman, 67 MS. Dec. 223.

3. Where one of the parties to an interference who is an

applicant had before him when he prepared his application the patent of his opponent and adopted the claims of said opponent for the apparent purpose of an interference, *Held*, that the applicant is not entitled to demand a construction of the claim of the patentee which would render it invalid by reason of that which he himself had accomplished if it can be upheld by any other reasonable interpretation not necessarily inconsistent with the statement of the patentee. (C. A. D. C. May 4, 1899.)

SHEPARD, J.] *Reute *v.* Elwell, 87 O. G. 2119.

4. Neither the rules nor the practice of this Office provide for raising and testing the question as to whether an interference issue is anticipated by prior patents in the manner attempted in this case. (June 20, 1899.)

DUELL, C.] Huber *v.* Aiken, 88 O. G. 1525.

5. To permit a party to an interference to take up the question of anticipation of the issue by prior patents and call experts to testify at length on such matter would be in effect to suspend the interference proceeding and is unwarranted by the rules. *Id.*

6. When a party to an interference is of the opinion that the issue is anticipated by the prior art, he should proceed to raise this question, as provided by rule 122. *Id.*

7. Mere similarity in the wording of claims does not show that there is an interference in fact unless those words construed in the light of the disclosures made by the parties mean the same thing. (Oct. 10, 1899.)

DUELL, C.] Edgecombe *v.* Eastman *v.* Houston, 89 O. G. 707.

8. Where the claim of one party, when read in connection with his disclosure and the terms employed are given their ordinary and intended meaning, covers features not disclosed by the other party, *Held*, that there is no interference in fact. *Id.*

9. Where a claim is held allowable on appeal on the ground that it contains a certain limitation as distinguishing it from the prior art, *Held*, that the issue in an interference subsequently based upon that claim cannot be construed as not including that limitation. *Id.*

10. Where both parties are applicants, an issue should not be formulated which includes features not disclosed by one of the

parties merely because in the examiner's opinion the devices are not patentably different; but if there is a common patentable invention that invention alone should be made the issue if the parties desire to and do in fact make claim to it. *Id.*

XI. JUDGMENT ON THE RECORD.

Where priority was awarded to the senior party to an interference by the examiner of interferences and the junior party took an appeal on the ground that the application of the senior party did not disclose the invention of the issue, *Held*, that the senior party's original application did not disclose the invention of the issue, and that he is not entitled to an award of priority based upon that application, which is the only evidence of his claimed invention, and the decision of the examiners-in-chief in awarding priority to such party affirmed. (Nov. 13, 1899.)

DUELL, C.] Grinnell *v.* Buell, 89 O. G. 1863.

XII. MOTIONS GENERALLY.

1. Where W made a motion that certain additions be made to the certified copies of the parts of his application involved in an interference, which motion was regularly presented to the examiner and granted, and subsequently H, the other party, appealed from the examiner's decision granting the motion, while in the meantime the examiner had requested the suspension of the interference for the purpose of adding a new party thereto under rule 129, *Held*, that, inasmuch as the whole question raised by the appeal is the right of W to make the claim of the interference issue based upon the additions allowed by the examiner, it is unnecessary to pass upon it at this time, since if the new party is added and the interference redeclared, any of the parties thereto have a right to bring any of the motions provided by the rules, and therefore under such circumstances H can bring his motion to dissolve the interference as redeclared. (Nov. 29, 1899.)

DUELL, C.] Weikly *v.* Hodges, 68 MS. Dec. 227.

2. Where a motion for dissolution filed by one party and a motion to amend under rule 109 filed by the other party are transmitted to the primary examiner, he should decide both motions and not suspend action on the motion to amend until

the decision on the other motion becomes final. (Nov. 30, 1898.)

GREELEY, A. C.] Uebelacker *v.* Brill, 87 O. G. 1783.

3. In accordance with the general spirit of the practice all questions which can fairly be considered at the same time should be so considered. The object of this practice is to diminish the number of appeals and expedite the final determination of cases. *Id.*

4. Where the real contention on which a motion is based is that the matter in issue was not disclosed in one party's case as originally filed, *Held*, that the question involves the merits and that it cannot be changed into one which is reviewable by the commissioner on appeal by merely misnaming the action and calling it a motion to shift the burden of proof. (Aug. 21, 1899.)

GREELEY, A. C.] Walsh *v.* Hallbauer, 88 O. G. 2409.

XIII. PRACTICE ON FINAL HEARING AND AFTER JUDGMENT.

1. A decision on priority makes the successful party's invention a part of the prior art in so far as his opponent is concerned to the same extent that it would be if shown in a prior patent; it is if anything a better reference, since in regard to certain matters the defeated party is estopped from disputing its pertinency. (Feb. 10, 1899.)

GREELEY, A. C.] Uebelacker *v.* Brill, 66 MS. Dec. 271.

2. Where, after judgment on the record in an interference proceeding between foreign applicants, a motion made by the defeated party to reopen the case to try the question of originality was granted, *Held*, that the burden of proof is upon said defeated party to prove beyond a reasonable doubt that his opponent obtained a knowledge of the invention from him, and upon his failure to sustain such burden or to show that his opponent was not in fact the original inventor, there is no warrant for withholding a patent from the successful party. (Nov. 18, 1899.)

DUELL, C.] Shiels *v.* Lawrence & Kennedy, 68 MS. Dec. 201.

3. The claims of a defeated party to an interference to be allowable, must not only be patentable over the issue itself, but

over the structure of the successful party to which that issue was drawn. The structure to which the claim is drawn and not merely the claim itself is the thing that is in controversy, and after a decision on priority, the defeated party obviously should not be permitted to insert other claims to the same matter, although they may contain specific differences, and thereby provoke a second interference in regard to the same device previously contested. To do so would be to provide a way whereby a defeated party to an interference could by successive interferences indefinitely delay the issue of a patent to the successful party. (Nov. 11, 1899.)

GREELEY, A. C.] Harkness *v.* Strohm, 68 MS. Dec. 157.

4. Rule 127 provides that "A second interference will not be declared upon a new application for the same invention filed by either party, and it necessarily follows that a second interference between the same applications will not be declared." "The same invention" means the same substantive matter, and not that it shall be claimed in the same way. These words mean practically the same thing in reference to successive interferences, as they are defined by the courts as meaning in the rulings made by them that a party cannot have two patents for the same invention. (Miller *v.* Eagle Mfg. Co., 66 O. G. 845, C. D. 1894, 147; Fassett *v.* Ewart Mfg. Co., 64 O. G. 439.)

Id.

5. The examiner's action in suggesting to a defeated party claims filed by a successful party to an interference, after the decision of priority of invention for the purpose of a second interference was irregular and improper, and the second interference in regard to those claims should not have been declared.

Id.

XIV. PRELIMINARY STATEMENTS.

(*a*) *In General.*

1. The filing of a preliminary statement by an applicant stating that he made the invention of the issue at a certain date does not estop that party from afterward alleging in a motion for dissolution that he does not claim that invention. Preliminary statements are necessarily made with reference to the

invention disclosed in a party's own case upon the presumption that the issue applies to that invention. (Jan. 16, 1899.)

GREELEY, A. C.] Sadtler *v.* Carmichael *v.* Smith, 86 O. G. 1498.

2. The rule of the Patent Office prescribing that "the parties will be strictly held in their proofs to the dates set up" in their preliminary statements is in accordance with right, reason, and with the principles of justice, for otherwise parties might be misled to their detriment. (C. A. D. C., Feb. 8, 1899.)

MORRIS, J.] *Bader *v.* Vajen, 87 O. G. 1235.

3. Interferences are declared for the purpose of determining the question of priority or originality of invention between two or more parties. Preliminary statements are the pleadings of the parties, and set forth certain facts as to conception, disclosure, and reduction to practice, and to the allegations set up in the preliminary statements the evidence must respond. (June 20, 1899.)

DUELL, C.] Huber *v.* Aiken, 88 O. G. 1525.

4. It is important that the extent of use of a completed invention be disclosed in the preliminary statement; but it is not necessary that such disclosure should be prolix and give unnecessary details; but it should set forth in concise and explicit terms the extent of use of the completed invention. (Oct. 26, 1899.)

DUELL, C.] Loeben *v.* Hamrick, 89 O. G. 1672.

XIV. PRELIMINARY STATEMENTS.

(*b*) *Amendment of.*

1. The bare statement of an interferent that he did not recollect certain circumstances material to his cause is not a good ground upon which to permit an amendment to his preliminary statement, particularly where it carries his date of reduction to practice back of that alleged by his opponent, for such a statement could be made in every case, and there is no way of controverting it. A party who relies exclusively upon his own memory and subsequently finds himself mistaken, must accept the consequences, since they are due to his own negligence. The allegation in the original statement may in fact be wrong

and the error may be material to the moving party's case, but that alone is not decisive of the question where it is due to carelessness or negligence, since the rights of other parties are to be considered. (Nov. 6, 1899.)

GREELEY, A. C.] Warner *v.* Gorton *v.* Smith, 68 MS. Dec. 125.

2. It has been the uniform practice of the Office, founded upon good and substantial reasons, to require a party to exercise diligence and care in discovering and alleging his correct dates in his original statement, and to refuse to permit an amendment in a material matter unless such diligence and care have been clearly shown. If an amendment were permitted in every case where a party relied solely upon his own memory without making any efforts to confirm his opinion, merely because he subsequently found himself mistaken, the useful effect of preliminary statements would be destroyed. (Nov. 7, 1899.)

GREELEY, A. C.] Silverman *v.* Hendrickson, 68 MS. Dec. 130.

3. After decision on priority had been rendered by the Examiner of Interferences and an appeal from his decision had been taken, a petition asking that the jurisdiction of the Examiner of Interferences be restored for the consideration of a motion to amend a preliminary statement was granted under the circumstances of this case. (Jan. 11, 1899.)

GREELEY, A. C.] Richardson *v.* Humphrey, 86 O. G. 1804.

4. When it is contended that the mistake in the preliminary statement was not discovered until it was made apparent by the decision of the Examiner of Interferences on priority and the moving party uses reasonable diligence thereafter in presenting his motion to amend, *Held*, that the jurisdiction of the Examiner of Interferences will be restored to consider the motion. *Id.*

5. On a petition that the jurisdiction of the Examiner of Interferences be restored for the purpose of considering an amendment to a preliminary statement, the question as to whether or not that amendment shall be admitted is not up for consideration, but merely the question whether proper diligence has been exercised in presenting that motion. *Id.*

6. While motions to amend preliminary statements are to be decided in view of the particular facts disclosed in each case, and therefore no cast-iron rule can be applied to all cases, it

may be said that amendments to preliminary statements should be permitted only when the motion has been made promptly after the discovery of the error, and then only when equity and justice demand it—as, for example, in a case where the testimony of neither party has been taken, or, if it has been taken, where the other party will not be injured, save as the true state of facts may be injurious, and the opponent would not be misled nor the expenses of the proceeding increased. (Jan. 28, 1899.)

DUELL, C.] Whitney *v.* Gibson, 86 O. G. 1983.

7. An amendment to a preliminary statement was admitted where a mistake therein was not discovered until the beginning of the taking of testimony and notice of an intention to amend was given at that time. (Webb *v.* Levedahl, 84 O. G. 810.) (Dec. 8, 1898.)

GREELEY, A. C.] Ancora *v.* Keiper, 86 O. G. 2171.

8. An amendment made to correct a mistake in a preliminary statement may be admitted where it does not change the date of conception, disclosure, or reduction to practice. (Maltby *v.* Miehl, 82 O. G. 749.) *Id.*

9. Where a party to an interference took testimony to prove a reduction to practice of his invention at a date prior to that set up in his preliminary statement, *Held*, that said testimony without amendment to the preliminary statement duly made by the authority of the Commissioner of Patents was inadmissible and entitled to no consideration. (Colhoun *v.* Hodgson, 70 O. G. 276.) (C. A. D. C. Feb. 8, 1899.)

SHEPARD, C.] *Cross *v.* Phillips, 87 O. G. 1399.

10. The requirement of specific preliminary statements by the contending parties under oath is a reasonable one, and experience has demonstrated its special adaptation to the conditions that ordinarily exist in interference cases. **Id.*

11. The dates of conception and reduction to practice are peculiarly within the knowledge of the inventor, and the facts by which they may be established are naturally of difficult contradiction by his adversary. Hence it is quite important to the administration of justice in contests between them that he be required to state those dates with reasonable certainty before

notice of the foundations of his adversary's claim. These preliminary statements constitute what may be called the "pleadings" in the case, and to their allegations the evidence must respond. *Id.*

12. The rule of the Patent Office which permits the statement of either party to an interference to be amended where material error has been committed through inadvertence or mistake and its correction, is essential to the ends of justice, is reasonable and just and seems to conform as near as may be, considering the peculiar character of interference cases, to the general rule prevailing in courts of equity. *Id.*

13. In courts both of law and equity the right to amend is not an absolute one, but rests in the discretion of the court, and the exercise of this discretion is not reviewable unless it may be in case of its palpable abuse. Necessarily the allowance or refusal of leave to amend a preliminary statement in an interference case rests in like manner in the discretion of the Commissioner of Patents, and it might be said for even a stronger reason, because he is vested with the authority to make the needful rules for the regulation of the practice of his Office without the supervising power of an appellate tribunal. *Id.*

14. Appeals do not lie to this court from all or any preliminary decisions in matters of interferences, though seriously affecting the rights of the parties, but only from those wherein the priority of the claim to the invention has been finally awarded. (Westinghouse *v.* Duncan, 66 O. G. 1009.) *Id.*

15. If the exercise of the discretion of the Commissioner in the matter of allowing and refusing leave to amend preliminary statements be subject to review by the Court of Appeals of the District of Columbia at all, it must be confined to those cases where the question comes up properly with the appeal from the decision on the merits and where it can be made clearly to appear that this discretion has been abused to the extent of causing a palpable miscarriage of justice. *Id.*

16. After a decision on priority an amendment to the preliminary statement may be permitted where a material error has occurred through inadvertence or mistake and it clearly appears that there was no negligence in discovering the error or in

bringing the motion to amend and that the correction is essential to the ends of justice. (July 7, 1899.)

GREELEY, A. C.] Richardson *v.* Humphrey, 88 O. G. 2241.

17. After testimony has been taken an amendment to a preliminary statement will not be permitted where no excuse whatever is given for not making the motion to amend earlier or for not sooner discovering the alleged error in the original statement. (Aug. 14, 1899.)

GREELEY, A. C.] Miehle *v.* Read, 89 O. G. 354.

18. The suggested possibility that the Office may throw out of consideration entirely evidence of an earlier date of invention than that alleged in the preliminary statement and so may not accord to a party even the date alleged, *Held*, not alone a sufficient ground upon which to permit an amendment to the statement, since to so hold would virtually nullify the rule requiring diligence. The statement would then have no useful purpose or effect, since in all cases it would be changed to conform to the testimony. *Id.*

19. Where a motion was made by a party to an interference that his opponent be required to amend his preliminary statement by adding thereto a statement showing the extent of use of the invention or, if it has not been used to any extent, specifically disclosing that fact, *Held*, that under rule 110 the motion should be granted. (Oct. 26, 1899.)

DUELL, C.] Loeben *v.* Hamirick, 89 C. G. 1672.

XV. PRIORITY.

(*a*) *In General.*

1. Where P made the application drawing for A and put on said drawing A's name as the inventor and made no claim at that time that he was the inventor, *Held*, that such actions are strongly against his claim to be the inventor, and as his claim to the invention is not supported by any testimony except his own he cannot prevail over A, the senior party. (C. A. D. C. Dec. 9, 1898.)

MORRIS, J.] *Pickles *v.* Aglar, 86 O. G. 346.

2. Where W relied upon his record date to prove priority and A took testimony and claimed that he disclosed the inven-

tion to W before W filed his application, *Held*, that W's failure to rebut this assertion of A's furnished convincing evidence that A was the prior inventor. (C. A. D. C. Jan. 10, 1899.)

ALVEY, J.] *Winslow *v.* Austin, 86 O. G. 2171.

3. The fact that A took an assignment from L and K, who were the assignees of W, ought not to be taken as an admission on his part that he in reality and truth had no claim to the invention involved in the issue, and that the sole and exclusive right was in W. **Id.*

4. It is a well-settled principle in patent law that as between rival inventors the date of invention may be fixed and will take precedence from the time at which a complete and intelligible embodiment of the subject of invention is produced, by which those skilled in the art could readily understand it. (C. A. D. C. Oct. 4, 1899.)

ALVEY, J.] *Hulett *v.* Long, 89 O. G. 1141.

5. W, the senior party, filed his application on October 28, 1893. B, the junior party, filed on October 26, 1895. The interference was declared on the broad issue, which was covered by a broad claim made by B when he filed his application. W, however, did not make the broad claim until April 29, 1896. The testimony shows that W was the first to conceive of the invention and that B did not in any manner reduce it to practice prior to W's filing date. *Held*, that if the broad claim is patentable it must belong to the first inventor of the specific machine, if to any one, and that one is W. It certainly cannot be allowed to any subsequent inventor of any other specific mechanism. (C. A. D. C. Apr. 4, 1899.)

MORRIS, J.] *Bechman *v.* Wood, 89 O. G. 2459.

6. *Held*, further, that the broad claim is not patentable to either party—not to B, because he was not the first to invent an "independent transferring mechanism" in printing-machines in the combination described; not to W, because he did not make the claim before his rival made the discovery of his own patentable invention. **Id.*

7. *Held*, further, that it is not competent for W, who had failed to make a broad claim and thus left the field open for other specific inventions than his own, to seek to control all

such specific inventions by procuring a patent on the broad claim which he did not advance prior to the making thereof by B. If the broad claim could be held to be patentable to W, the effect of a patent upon it to him would be unjustly retrotractive, for it would sweep within its control all specific inventions in the same field made previously to the time when he made his claim. (Chicago & Northwestern Railroad Co. *v.* Sayles, 15 O. G. 243; 97 U. S. 554, cited.) *Id.*

8. *Held*, further, that while both parties to the interference are or may be entitled to patents for their respective specific devices, neither one of them is entitled to a patent for the broad claim of the issue, and therefore there should be no judgment of priority of invention to either party with reference to the broad claim. *Id.*

9. Where an applicant for a patent has restricted himself in the first instance to a narrow claim for a specific device to effect a certain result and subsequently another applicant comes into the Office with another narrow claim for another specific device to effect the same result and thereafter the first applicant broadens his claim into a generic one, so as to cover and dominate all specific devices to effect such result, assuming that their specific devices have actually been invented in the order of their application to the Office, the utmost liberality of amendment will not justify the destruction of the rights of the second applicant to his own specific device, and the fact that the second applicant may have been the first to make the broad generic claim and that the first applicant then broadened his claim into generic proportions cannot affect this conclusion. (C. A. D. C., Dec. 6, 1899.)

MORRIS, J.] *Bechman *v.* Wood, 89 O. G. 2462.

10. Where the first applicant was found to be the true first and original inventor of his own specific device and apparently the first inventor of any device of the kind, and the second applicant was likewise found to be the true first and original inventor of the specific device stated in his application, this being the order of invention, *Held*, that the second applicant could not, under any principle of law or any theory of justice, be allowed the broad claim which would have dominated the invention of his predecessor in the field, and neither could that pre-

decessor be allowed the broad claim, for the reason that he had not advanced it before the arrival of the other party on the field of invention. *Id.*

11. *Held*, further, that by making the narrow claim for a specific device in the first instance the first applicant left the field open for all who would make other different devices to accomplish the same purpose, and it would not be right or just that he should, after the invention of such another device by another person be permitted to go back and broaden his claim so as to sweep this second device within the scope of his own original application, even though the broad claim might properly have been advanced in the beginning, and even though under other circumstances he might have effectively broadened his claim in the course of the prosecution of the application and procured or entitled himself to a patent for such broad claim. *Id.*

12. If an inventor comes to the Patent Office with an application in which he first restricts himself to a narrow claim for a specific device, but which he is entitled by the process of amendment to broaden into a generic claim, and if he does in fact so broaden it, he may entitle himself to a patent for the broad claim unless in the meantime the right of some other person has accrued to some other narrow claim for a similar device to effect the same purpose which would be dominated by the broader claim of the first applicant. It is not just that rights which have previously accrued should be overthrown by amendments subsequently made. (Chicago & Northwestern Railway Co. *v.* Sayles, 97 U. S. 554; 15 O. G. 243, cited.) *Id.*

13. Neither party to this interference is entitled to prevail against the other on the broad claim of the issue, the first being estopped from setting it up against the second applicant in consequence of the intervening rights of the latter to his own specific device, and the second applicant being precluded from having the benefit of it for the reason that he was not the first on the field of invention. *Id.*

14. The former decision holding that as W did not advance the broad claim of the issue until after B had filed his application therefore he is not entitled to a judgment of priority for such broad claim, and that neither party is entitled to a judgment of

priority of invention or to a patent for the broad issue is adhered to. *Id.*

XV. PRIORITY.

(*b*) *Abandoned Experiments.*

Where T constructed and tried an apparatus embodying the issue in February, 1889, which proved unsatisfactory and disappointing to him, and which he boxed up and laid away in his shop until the latter part of 1892, when he shipped it to his attorney upon hearing that B had appeared with a successful device of the same general character, *Held*, that what T did in 1889 amounted to no more than an experiment, which was abandoned and revived only after B's appearance in the field, and priority of invention awarded to B. (C. A. D. C., Jan. 3, 1899.)

SHEPARD, J.] *Traver *v.* Brown, 86 O. G. 1324.

XV. PRIORITY.

(*c*) *Employer and Employe.*

1. The first inventor cannot be deprived of an award of priority because he was at one time employed by his opponent, who had disclosed to him a portion of the issue of the interference, when it appeared that he was not employed to devise or perfect an invention being developed by the employer, or the suggestions or improvements made by the first inventor were not merely "ancillary to the plan and preconceived design of the employer." (Mar. 2, 1899.)

DUELL, C.] Streat *v.* Freckleton, 87 O. G. 695.

2. An employe performing all the duties assigned to him in his department of service may exercise his inventive faculties in any direction he chooses with the assurance that whatever invention he may thus conceive and perfect is his individual property. (Solomons *v.* U. S., 137 U. S. 342.) *Id.*

XV. PRIORITY.

(*d*) *Foreign Patents.*

R applied for a Swiss patent on March 2, 1896, and on June 30, 1896, a certificate was issued by the Swiss Patent Office stating that a provisional specification, dated March 2, 1896,

had been registered under No. 11,743 and that the patent document would immediately after the publication of the description and drawing be executed. Notice of the registration was published in the *Patent-Liste* of the Swiss office, a copy of which publication was received in the United States Patent Office on August 7, 1897; but it contained no description of the Swiss patent. The making public of the specification of the Swiss patent and its publication and printing were postponed for six months, which ended September 2, 1896. *Held*, that R's Swiss patent was a secret patent until September 2, 1896, a date subsequent to W's filing date in this country, and that no date can be given to R's Swiss patent which will overcome W's date of filing his application in this country, and priority awarded to W. (June 23, 1899.)

DUELL, C.] Roschach *v.* Walker, 88 O. G. 1333.

XV. PRIORITY.

(*e*) *Invention made by third party.*

1. Where A, the junior party, made out a *prima facie* case in support of his claim for priority of invention and F did not attempt to rebut or overcome it, but relied upon the evidence of L, one of A's witnesses, to show that L and not A was the inventor of the subject-matter of the invention, *Held*, that L's testimony cannot be used in favor of F, and priority of invention is therefore awarded to A. [The decision of the Assistant Commissioner, Antisdel *v.* Foster, 65 MS. Dec. 390, affirmed.] (C. A. D. C. May 2, 1899.)

ALVEY, J.] *Foster *v.* Antisdel, 88 O. G. 1527.

2. Interference proceedings are instituted to determine as between the parties thereto which of them is entitled to an award of priority of the invention claimed. Both cannot be entitled to it, but one may be entitled as against the other, though there may be some third party who might, if the claim of that person were placed in issue as between that person and one or both of the parties to the interference proceeding, show that he was in fact and in reality entitled to an award of priority of the invention in controversy. *Id.*

3. Evidence that some other party than the parties to the interference proceeding is really the inventor of the device in

issue is impertinent to the issue and cannot be received or considered by those charged with the duty of determining the issue. *Id.*

4. If the practice obtained of allowing the claims or pretensions of any or all persons though not parties to the interference proceedings to be set up as a means of defeating the claims of one of the parties, it would be difficult if not impossible in many cases to try the interference issue as between the immediate parties to it. Such practice would open the door to collusion, and perjury would be the recourse of many who failed to support their claims by legitimate evidence. *Id.*

XVI. Reduction to Practice.

(*a*) *In General.*

1. It is an elementary principle in patent law that he who first reduces to practice is to be regarded as the true inventor of the idea or device so reduced from a mere abstraction to a concrete form, in the absence of proof that he has only elaborated the ideas of others or of proof that there has been prior conception of the invention by another, with a showing of due diligence in the way of effort to reduce it to practice. (C. A. D. C., Feb. 8, 1899.)

Morris, J.] *Bader *v.* Vajen, 87 O. G. 1235.

2. Reduction to practice by B would not avail him as against V if it were shown that B was merely obeying the instructions of V and giving effect to the conceptions of the latter. *Id.*

3. A reasonable doubt as to what constitutes a reduction to practice will be resolved against the inventor, and special circumstances—as for example, unreasonable delay in making practical or commercial use of the invention or in applying for a patent or the like—would have a tendency to raise this doubt in a particular case. (C. A. D. C. May 4, 1899.)

Shepard, J.] *Reute *v.* Elwell, 87 O. G. 2119.

XVI. Redection to Practice.

(*b*) *Actual.*

1. By actual reduction to practice the right to the invention becomes perfect, and can only become subordinate to the claim of a subsequent *bona fide* inventor by some such course of con-

duct as that shown in Mason *v.* Hepburn, (84 O. G. 147) (C. A. D. C., Jan. 3, 1899.)

SHEPARD, J.] *Esty *v.* Newton, 86 O. G. 799.

2. The importance of mere delay while the inventor is engaged in the prosecution of other improvements in the same art is of more or less weight, according to circumstances, in determining whether the attempted reduction to practice amounted to an actual reduction or an abandoned experiment. *Id.*

3. A fodder-shredder in which a cutter-bar was taken out of an old machine, leaving an inch of open space between the edges of the cutter-teeth and the periphery of the lower feed-roll at the point of nearest approach, is not a reduction to practice of an issue which calls for cutters arranged in immediate relation to the lower feed-roll, whereby the points of the teeth of the cutter are brought close to the said feed-roll. (C. A. D. C., Jan. 10, 1899.)

SHEPARD, J.] *Tracy *et al. v.* Leslie, 87 O. G. 891.

4. Where the records of the case show that the primary examiner had found no novelty in the omission of a cutter-bar in the old form of fodder-shredder from the new combination and had "with doubt and hesitation" declared novelty to exist in the restricted action of the cutter-teeth in immediate relation with the lower feed-roll acting as a cutter-bar in the very closest approach that could be accomplished, *Held*, that the slight difference in arrngement being the very thing and the only thing that gave novelty to the new combination, it must follow that the practical test of a combination which did not fall within the specific combination is not a reduction to practice of that combination. (Breul *v.* Smith, 78 O. G. 1906, cited.) *Id.*

XVI. REDUCTION TO PRACTICE.

(*c*) *Constructive.*

Where a second application was filed while a first application was forfeited, and a comparison of the two applications shows that the drawing of the first is the same as one sheet of the second and that the specification of the first is incorporated in the second, and additional drawings are filed with the second application and additional matter is included in the specification

thereof which embodies some features not in the first, *Held*, that on an interference on the second application the applicant should have the benefit of his original application as a constructive reduction to practice of the invention set forth therein and embodied in the second application. (C. A. D. C., Jan. 3, 1899.)

SHEPARD, J.] *Cain *v.* Park, 86 O. G. 797.

XVI. REDUCTION TO PRACTICE.

(*d*) *Diligence.*

1. Where the party first to conceive but the last to reduce to practice did nothing for nine years between his conception and reduction to practice except to make drawings and talk about the invention occasionally and to urge one or two persons "to take it up," and in the meantime had taken out patents on the same subject-matter, *Held*, that there is no sufficient excuse offered for delay in reducing to practice. (C. A. D. C. Dec. 9, 1898.)

MORRIS, J.] *Marvel *v.* Decker *et al.*, 86 O. G. 348.

2. Although M was the first to conceive, he did not show reasonable diligence in reducing his invention to practice, and D having conceived and reduced to practice in the meantime, *Held*, that the decision of the commissioner should be affirmed and priority awarded to D. **Id.*

3. Where an inventor made and tested a device and then partially dismantled it and put it in a private drawer where it remained for five years before applying for a patent, when he had ample means to patent it and the evidence showed that he had taken out other patents, *Held*, that his right to a claim of priority is barred where it is shown that during his concealment of his invention his rival had entered and taken possession of the field and reduced the invention to practice and given its benefits to the public. (Mar. 21, 1899.)

DUELL, C.] Davis *v.* Forsyth and Forsyth, 87 O. G. 516.

4. The bare statement of the first inventor that he never abandoned his invention counts for naught in the light of such circumstances. *Id.*

5. An inventor may conceal his invention for an unlimited

time without forfeiting his right to a patent, provided, however, that no statutory bar intervenes and provided, further, that no other person during such period makes the same invention and secures a patent therefor. (Bates *v.* Coe, 15 O. G. 337, and Mason *v.* Hepburn, 84 O. G. 147, cited.) *Id.*

6. The right of the first inventor to an award of priority becomes barred by the designed or negligent concealment of his invention from the public upon the entry of a later inventor into the same field. *Id.*

7. Where it appeared that the first inventor to conceive could have completed a drawing in a short time after it was begun, but he took five months to do so because there was no hurry for it, and after the drawing was finished his assignee still further delayed for one year and four months in reducing the invention to practice because there was no hurry to reduce it to practice, as it was not sooner needed, *Held*, that there was no excuse for such delay and priority of invention awarded to the second to conceive but the first to reduce to practice. (Feb. 27, 1899.)

DUELL, C.] Kasson *v.* Hetherington, 88 O. G. 1157.

8. Diligence cannot wait upon the convenience or business arrangements of an inventor or his company. (Dailey *v.* Jones, 67 O. G., 1719, cited.) *Id.*

9. Where it was shown that the one to first conceive of the invention did not have the money with which to actually reduce it to practice, but there was nothing to show that he could not have filed an application which would have been a constructive reduction to practice and would have given him the benefits of an actual reduction, *Held*, that there was no excuse for delay and priority awarded to second to conceive. *Id.*

10. There is no general rule of what constitutes due diligence, that being a question to be determined by all the facts and surrounding circumstances in the particular case. *Id.*

11. De Wallace had a complete conception of the invention on December 1, 1896, when he employed a skilled mechanic to embody his ideas in a working machine. Scott *et al.* proved conception on December 8, 1896, and reduced the invention to practice prior to reduction to practice by De Wallace. *Held*, that as De Wallace was actually engaged in his efforts to reduce

the invention to practice when Scott *et al.* entered the field, and as his delay in reducing to practice was not unreasonable under all the circumstances disclosed by the evidence, priority should be awarded to De Wallace over Scott *et al.* (Decision of the Commissioner, Scott *et al. v.* De Wallace, 66 MS. Dec., 30, overruled.) (C. A. D. C., June 6, 1899.)

Shepard, J.] De Wallace *v.* Scott *et al.*, 88 O. G., 1704.

12. No hard and fast rule can be laid down as to what constitutes diligence. What is or is not diligence in a given case must depend upon its special facts and circumstances. Some indulgence is generally extended to an inventor who is engaged in a *bona fide* attempt to perfect his invention. (McCormick *v.* Cleal, 83 O. G., 1514, cited.) *Id.*

13. While circumstances such as poverty, sickness, etc., tend to excuse delay in reducing an invention to practice, they will not justify indefinite postponement of action for a period of years, for to allow them to have that effect would be in many cases to close entirely the field of invention against competition and to nullify the purposes of the patent law. (C. A. D. C., June 6, 1899.)

Morris, J.] *Griffin *v.* Swenson, 89 O. G., 919.

14. Where an inventor interested a third party to coöperate with him in exploiting and testing an invention and procuring a patent therefor, but without any steps whatever being taken toward the object in view beyond the mere determination to have the invention tested at some time, *Held*, that such undeveloped intentions unaccompanied by any action cannot be held to be due diligence on the part of the inventor. **Id.*

15. Neither the delay that is proper in one case nor the diligence that is due in the other can in the absence of any statutory limitation of time in this regard be measured by any arbitrary standard. It has been repeatedly held that the question of due diligence is one to be determined in each case by its own circumstances. **Id.*

16. While less harm is done and the policy of the law better promoted by a rigid insistence upon the requirement of diligence than by laxity in the encouragement of delay, it does not seem that the rule of diligence should be pushed to a harsh and un-

reasonable extent. What the law requires is reasonable, not extraordinary, activity. *Id.*

XVI. Reduction to Practice.

(*c*) *Drawings and Models.*

1. The contention that a drawing demonstrating efficiency and operativeness is the full equivalent of an actual machine and just as effectively embodies the adoption and perfection of the invention cannot be sustained by any authority. (Feb. 27, 1899.)

Duell, C.] Kasson *v.* Hetherington, 88 O. G. 1157.

2. That a drawing or a model cannot be used as showing a completion of invention seems to be too well settled for argument. (Stephenson *v.* Goodell, 9 O. G. 1195; Green *v.* Hall, 46 O. G. 1115, and 47 O. G. 1631; Hunter *v.* Stykeman, 85 O. G. 610; Mason *v.* Hepburn, 84 O. G. 147; Telephone Cases, 126 U. S. 535; Porter *v.* Louden, 73 O. G. 1551; Croskey *v.* Atterbury, 76 O. G. 1613, cited.) *Id.*

XVII. Reinstatement or Reopening of.

1. Motions to reopen interferences must be heard and decided in the first instance by the examiner of interferences, and the only question to be determined upon a petition to reopen to take additional testimony, which, with an additional showing of facts, was in effect a renewal of a similar petition which was denied for insufficient showing of diligence, is as to whether the jurisdiction of the examiner of interferences should be restored for the purpose of considering the matter of reopening. (Apr. 19, 1899.)

Greeley, A. C.] Jobes *v.* Roberts *v.* Hauss, 66 MS. Dec. 471.

2. Where the showing set forth facts indicating diligence on the part of the petitioner, both in discovering new evidence and in bringing the petition to reopen, *Held*, to be sufficient to warrant the transmission of the case to the examiner of interferences for the purpose of deciding the question *Id.*

XVIII. Service of Notice.

1. Where notices to a party to file his preliminary statement had been sent and the preliminary statement was not filed, but

the Office was notified that the party was dead, the examiner of interferences instructed to send new notices setting a new date for the filing of the preliminary statement, and that date should be set so as to give an opportunity for the appointment of an administrator, notices being sent to the heirs of the deceased. (July 3, 1899.)

DUELL, C.] Handley *v.* Bradley, 89 O. G. 522.

2. The examiner of interferences having called the Commissioner's attention to the fact that no response had been made to the notices sent under the order of the Commissioner in the case of Handley *v.* Bradley, of July 3, 1899, the examiner is directed to set times for taking testimony and to send notices thereof to the assignee of the part interest of the deceased at the addresses which have been furnished to the Office. If the other party closes his testimony and there is no testimony presented on behalf of the deceased, the examiner of interferences shall, if proper motion is made, consider the testimony offered and enter judgment in the case accordingly. (Sept. 25, 1899.)

DUELL, C.] Handley *v.* Bradley, 89 O. G. 524.

XIX. SUSPENSION.

1. Under rule 126 a suspension of proceedings for the consideration of an alleged statutory bar is not granted as a matter of right on the part of one of the parties, but merely in the discretion of the Commissioner in a proper case in order to terminate needless contests. (Dec. 16, 1898.)

GREELEY, A. C.] Shiels *v.* Lawrence *et al.*, 87 O. G. 180.

2. Even where the Commissioner's attention is called to an alleged statutory bar as provided in the rule, the interference will not be suspended for a determination thereof unless substantial justice demands it. *Id.*

3. When the only right which S. had to the continuance of the contest was to determine the question of originality of invention, he will not be permitted to turn the contest off upon some other question, and thus possibly avoid a decision on the only question which he really has the right to contest. *Id.*

4. Where it appeared that a statutory bar of two years' public use existed, which would prevent the issue of a patent to A,

Held, that as no testimony had been taken by either party the interference should be suspended and the statutory bar determined. Thomson *et al. v.* Hisley, 66 O. G. 1599; Tyler *v.* Arnold, 84 O. G. 1584, and Howard *v.* Hey, 86 O. G. 184, distinguished from the present case. (June 26, 1899.)

DUELL, C.] Sanford Mills *v.* Aveyard, 88 O. G. 385.

5. To refuse to institute public-use proceedings at this time and to refuse to suspend the interference would be a hardship and would add unnecessarily to the expense of both parties. *Id.*

6. It being a well-settled rule of law that it is within the sound discretion of a court to stay proceedings when there is another action between the same parties involving the same issues pending in a court of a sister State or in a court of the United States, by analogy the facts herein set forth warrant staying the interference proceedings in this case and the institution of public-use proceedings. *Id.*

7. As rule 126 provides for the suspension of an interference proceeding by the Commissioner before judgment on priority to determine a statutory bar which has been called to his attention by the examiner of interferences or the examiners-in-chief, there is no reason for delaying the institution of public-use proceedings in this case until after one of these tribunals has called the commissioner's attention to the existence of the statutory bar. *Id.*

8. Protestants having made out a *prima facie* case against the grant of a patent to A, formal proceedings to establish legally the alleged facts set forth by protestants will be instituted upon certain conditions to be complied with. *Id.*

XX. TESTIMONY.

(*a*) *In General.*

1. The fact that negotiations were pending between the parties looking to a settlement of the controversy without prosecuting the interference cannot be received as a valid excuse for the failure to take testimony. (Jan. 17, 1899.)

GREELEY, A. C.] Igleheart Bros. *v.* Houston, Meeks & Co., 86 O. G. 631.

2. Where testimony was introduced to prove things alleged to

have been done prior to the dates set up in a preliminary statement, *Held*, that such testimony cannot be regarded as having any weight. (C. A. D. C., Feb. 8, 1899.)

MORRIS, J.] *Bader *v.* Vajen, 87 O. G. 1235.

XX. TESTIMONY.

(*b*) *Time for Taking.*

When a preliminary statement is amended to conform to the evidence after decision on priority, *Held*, that new times for taking testimony should be set, so as to give the opposing party an opportunity to cross-examine the witnesses in regard to the matter. (July 7, 1899.)

GREELEY, A. C.] Richardson *v.* Humphrey, 88. O. G. 2241.

XX. TESTIMONY.

(*c*) *Interested Parties.*

1. If the testimony of an interferent, upon whom rests the burden of proof, is entirely clear and satisfactory, it is well settled that it would not be sufficient to establish his case without corroboration. (March 25, 1899.)

GREELEY, A. C.] Bragger *v.* Rhind, 66 MS. Dec., 409.

2. While it is true that the fact of conception by an inventor for the purpose of establishing priority cannot be proved by his mere allegation or his unsupported testimony, where there has been no disclosure to others or embodiment of invention in some clearly perceptible form, such as drawings or models, with sufficient proof of identity in point of time, it does not follow from this principle that the party upon whom is cast the onus of proving the fact of priority of invention is an incompetent witness to testify in his own behalf as to the facts of priority. (C. A. D. C. Jan. 10, 1899.)

ALVEY, J. *Winslow *v.* Austin, 86 O. G. 2171.

3. Where V swore to the disclosure which evidences his alleged conception of the invention and B denied that disclosure, which is not claimed to have been made to any other person than himself, *Held*, that the utmost that can be said in favor of V is that the testimony is balanced. (C. A. D. C. Feb. 8, 1899.)

MORRIS, J.] *Bader *v.* Vajen, 87 O. G. 1235.

XX. TESTIMONY.

(*f*) *Irrelevant.*

1. H's testimony in rebuttal consisted of that of an expert on the question of non-patentability of the issue. A objected to this testimony during the taking thereof and later made a motion to strike it out on the ground that it was not proper rebuttal testimony. H contends that as the word "rebuttal" was not used in the objection on the record it is now too late to move to strike out on this ground. *Held*, that although A did not raise the specific objection to the testimony, yet the motion is considered and the testimony being outside of the interference question is improper rebuttal and should be stricken out. (June 20, 1899.)

DUELL, C.] Huber *v.* Aiken, 88 O. G. 1525.

2. Testimony should not be taken in an interference proceeding merely for the purpose of showing that the issue of an interference is anticipated or devoid of patentability in view of the prior art when the opposing party objects to such testimony. Testimony should be confined to the question of priority of invention. (Straus *v.* Cook, 43 MS. Dec. 65, cited.) *Id.*

XXI. VACATING JUDGMENT.

1. The discovery of new evidence in one interference is no reason for the vacation of the judgment on priority and setting new times for taking testimony in another merely because in the moving party's opinion the interferences are closely related. (Jan. 17, 1899.)

GREELEY, A. C.] Iglehcart Bros. *v.* Houston, Meeks & Co., 86 O. G. 631.

2. A party who voluntarily fails to prosecute one interference because in his opinion he cannot prevail in another closely-related interference, is bound by his election and cannot afterward obtain a vacation of judgment merely because he finds himself mistaken as to that other interference. *Id.*

3. When a *prima facie* case of newly-discovered evidence and reasonable diligence was made out after decision by the examiner of interferences on the question of priority and after appeal had been taken from his decision his jurisdiction was restored

for the consideration of a motion to vacate the decision on priority and set new times for taking testimony. (Jan. 17, 1899.)

GREELEY, A. C.] Igleheart Bros. *v.* Land *et al.*, 86 O. G. 632.

4. The question as to whether the showing warrants the vacation of the judgment and setting new times for taking testimony is not up for decision, the sole question being whether it warrants the transmission of the case to the examiner of interferences for a determination of that question. *Id.*

5. The jurisdiction of the examiner of interferences will not be restored for the consideration of a motion to vacate the decision on priority and set new times for taking testimony on the ground of newly-discovered evidence where it clearly appears that the moving party did not use reasonable diligence either in discovering the evidence or in bringing the motion. (Jan. 24, 1899.)

GREELEY, A. C.] Jobes *v.* Roberts *v.* Hauss, 86 O. G. 1805.

6. When a party relies on his own memory and fails to consult parties whom he knows to be equally familiar with the facts of the case, *Held*, to show a lack of diligence on his part in discovering the evidence which those parties may be able to produce. *Id.*

Interfering Patents.

I. TO THE SAME INVENTOR.

II. TO DIFFERENT INVENTORS.

I. TO THE SAME INVENTOR.

1. For a long time after Rubber Co. *v.* Goodyear, 9 Wall. 788, 796, in connection with Suffolk Co. *v.* Hayden, 3 Wall. 315, 378, if not before the date of the expressions found in those cases, it was understood that an inventor might lawfully divide his invention so far as to take out independent patents for his machine, his process, and his product, *provided*, the applications were all pending in the Patent Office before either patent issued, or were pending otherwise under such circumstances as to save him from the abandonment implied in taking out a patent for less than his whole invention. This statement is sustained historically by Judge COLT in Eastern Paper-Bag Co. *v.* Standard

Paper-Bag Co., 30 Fed. Rep. 63; 41 O. G. 231; C. D. 1887, although some of the *dicta* in that case as to abandonment may need modification in view of later decisions of the Supreme Court—among the rest, Underwood *v.* Gerber, 149 U. S. 224, 230; 13 Sup. Ct. 854; Deering *v.* Harvester W'ks, 155 U. S. 286, 296; 15 Sup. Ct. 118; 69 O. G. 1641; C. D. 1894. The proposition that independent patents may certainly be taken for the machine, the art, and the product involved in the same fundamental invention, when applications therefor are pending at the same time in the Patent Office, has been very much embarrassed by the expressions found in Lock Co. *v.* Mosler, 127 U. S. 354, 361; 8 Sup. Ct. 1148; 43 O. G. 1115; C. D. 1888, and in Underwood *v.* Gerber, *ubi supra*. In each of those cases it appeared that the various applications were filed at different times in the Patent Office; yet, although all were pending before any patent issued, only the earlier patent was sustained. (C. C., D. Me. July 30, 1898.)

PUTNAM, J.] *Simonds Rolling Mach. Co. *v.* Hathorn Mfg. Co. *et al.*, 90 Fed. Rep. 201.

2. One cannot lawfully have two patents for the same invention; when once the invention has been used as consideration of a grant, its value for that purpose is spent, and there is nothing in it on which a second grant can be supported. And the rule holds good though the scope of the patents may be different. A patentee cannot extract an essential element of his invention from his former patent, without which such patent would not have been granted, and make it the subject of a second patent. It is not necessary to the rule that the patents should be for coextensive inventions or that the subject matter should be technically the same. The rule rests upon the broad and obvious ground that, if the second patent is for an invention that was necessary to the use of the invention first patented, it cannot be sustained. (C. C. A., 6th Cir. Dec. 5, 1898.)

SEVERENS, J.] *Palmer Pneumatic Tire Co. *v.* Lozier, 90 Fed. Rep. 732.

3. The conception of a mechanism capable merely of producing motion in a predetermined form, and the conception of this mechanism combined, with other elements, in a machine pro-

ducing work theretofore done only by hand are distinct, and where an inventor has made such distinct conceptions the subjects matter of separate patents, particularly where the "mechanical movement" is capable of use in other machines, he should not be deprived of the protection of letters patent for that which he regards as his chief invention, commercially considered. (C. C. A., 1st Cir. Mar. 16, 1899.)

BROWN, J.] *Palmer *v.* John E. Brown Mfg. Co., 92 Fed. Rep. 925.

II. DIFFERENT INVENTORS.

1. In suits brought under R. S. § 4918 to obtain an adjudication of priority of invention covered by two interfering patents, the court is not confined to the single determination of priority, with the consequent determination that the patent to the later inventor is void. On the contrary, the court is bound to determine whether upon identifying the subject-matter of the interfering patents, the matter stated therein is patentable. If upon inspection of the complainant's patent or in the course of the investigation it must make to determine the nature of the alleged invention, the court should see that the patents are void for lack of patentable subject-matter, it ought not to proceed to an inquiry as to who first discovered the thing which the court finds to be null, and decree thereon, but should dismiss the bill, and deny relief to either party. (C. C. A., 6th Cir. Dec. 5, 1898.)

SEVERENS, J.] *Palmer Pneumatic Tire Co. *v.* Lozier, 90 Fed. Rep. 732.

2. R. S. § 4918 necessarily involves the presence of patentable invention as the subject-matter of the litigation, and the court cannot close the door to all inquiry as to whether such subject-matter for controversy exists. The court is, by the terms of the statute, empowered, as a sequel to its inquiry, to determine either of the patents void in whole or in part. **Id.*

Judicial Notice.

1. Where a certified copy of an application was introduced in evidence, but no proof was made as to the application having been allowed, *Held*, that as the commissioner had examined the

files of his office and found that the said application had been formally allowed and had considered the fact in making his decision, it was sufficient proof that the application had been allowed. (C. A. D. C., Jan. 3, 1899.)

SHEPARD, J.] *Cain *v.* Park, 86 O. G. 797.

2. While as a general rule nothing is to be considered as evidence in an interference case unless introduced into the record before final submission, yet neither the general purpose nor the efficiency of the rule is impaired by the creation of an exception thereto in favor of the consideration of a relevant and material fact shown by a record in the Patent Office entered in the regular course of proceedings therein. **Id.*

3. While the allowance of an application is not evidence for the interested party in the ordinary sense, yet it is a record of an official action in the Office and under the authority of the commissioner of which the Court of Appeals may take notice in order that justice may be done. **Id.*

4. In passing upon an application for a patent the commissioner may go outside of the record and take notice of the official entries made in his own office and under his own supervision in order that justice may be done to parties. **Id.*

5. For the purpose of ascertaining the state of the art when it concerns a matter of general interest the court may take judicial notice of what is disclosed by its own records in a previous case involving an invention appertaining to the same art. (C. C. A., 1st Cir. June 1, 1899.)

PUTNAM, J.] *Cushman Paper Box Mach. Co. *v.* Goddard *et al.*, 88 O. G. 2410; 95 Fed. Rep. 664.

6. The court may take judicial notice that the alleged invention is nothing more than the application to a rope or cord of the devices from time immemorial applied to garters, suspenders, curtain cords, and tag strings. (C. C., S. D. N. Y. Aug. 9, 1899.)

TOWNSEND, J.] *Covert *v.* Travers Bros. Co., 96 Fed. Rep. 568.

Jurisdiction.

I. COMMISSIONER OF PATENTS.

II. SECRETARY OF THE INTERIOR.

III. FEDERAL COURTS.

(*a*) *Court of Appeals, District of Columbia.*

(*b*) *Circuit Courts.*

I. COMMISSIONER OF PATENTS.

1. As under the Constitution Congress has power to make laws which shall be necessary and proper for carrying out that express power of the Constitution in regard to protecting patents, it follows that Congress may provide such instrumentalities in relation to the matter as in its judgment will be best calculated to effect that object. (Sup. Ct. U. S. Jan. 23, 1899.)

FULLER, C. J.] *U. S. *ex rel.* Bernardin *v.* Duell, Comr. of Pats., 86 O. G. 995.

2. As one of the instrumentalities designated by Congress in execution of the power granted the office of Commissioner of Patents was created, and though he is an executive officer, matters in the disposal of which he exercises functions judicial in their nature may properly be brought within the cognizance of the courts. **Id.*

3. In deciding whether or not a patent shall issue the Commissioner acts on evidence, finds facts, applies the law, and decides questions affecting not only public but private interests, and so as to reissues or extensions or interferences between contesting claimants. In all this he exercises judicial functions. (Butterworth *v.* Hoe, 29 O. G. 615; 112 U. S. 50, cited. **Id.*

4. While the Commissioner of Patents is an executive officer and subject in administrative or executive matters to the supervision of the Secretary of the Interior, his actions in deciding patent cases are essentially judicial in their nature and not subject to review by the executive head, an appeal to the courts having been provided for. (Butterworth *v.* Hoe, 29 O. G. 615; 112 U. S. 50, cited.) **Id.*

5. The different statutes show that in the gradual development of the policy of Congress in dealing with the subject of granting patents the recognition of the judicial character of the questions involved became more and more pronounced. **Id.*

6. Although rule 124 provides that from a decision of the Primary Examiner affirming the patentability of a claim or the right to make it no appeal can be taken, and rule 126 provides that the lower tribunals may call the Commissioner's attention to matter which amounts to a statutory bar to the grant of a patent, *Held*, that under the supervisory power conferred upon the Commissioner by statute he may review a favorable decision of the Primary Examiner on the question of patentability, notwithstanding rule 124, and even when his attention has not been called to the matter, as provided for by rule 126. (Oct. 16, 1899.)

DUELL, C.] Anderson & Dyer *v.* Lowry, 89 O. G., 1861.

7. As the statute has imposed upon the Commissioner of Patents the superintending or performing of all duties relating to the granting and issuing of patents, any rule that would prevent the Commissioner from exercising such power would be invalid. *Id.*

8. It being impossible for the Commissioner to "*perform* all duties respecting the granting and issuing of patents," that fact does not relieve him from the duty of superintendence, and he has no power to make a rule which would prevent him from performing his statutory duties. *Id.*

9. Under the proper construction rules 124 and 126 do not deprive the Commissioner of his supervisory power, and it would be a very anomalous condition of affairs if the examiners, who are appointed upon the nomination of the Commissioner, are above his superintendence. If he has no power to superintend and revise the action of the examiners, he could not superintend the granting and issuing of patents. *Id.*

10. The Commissioner should not refuse in a proper case to exercise his supervisory power, and it would be nonfeasance for him to refuse. The courts which have appellate jurisdiction over the Patent Office have more than once held that the Commissioner may refuse patents, even after favorable decision by subordinates, under his general supervisory power. *Id.*

11. The reserve supervisory power of the Commissioner should be used in the treatment of cases of the class to which the present one belongs only where some extraordinary reason for such action is disclosed. *Id.*

II. Secretary of the Interior.

1. The general powers of discretion and superintendence given by law to the Secretary of the Interior over the several Bureaus of the Interior Department do not have the same application to the Patent Office as to the General Land Office, the Pension Office, and the Indian Office for the reason that Congress in the one case has provided another and exclusive manner of correcting errors in the decisions of the Commissioner, while in land, pension, and Indian matters no such other or exclusive remedy is provided. (Feb. 20, 1899.) Opinion of the Asst. Atty. Gen. for the Department of the Interior. †Poole *v.* Avery, 87 O. G. 357.

2. The decision of the Commissioner of Patents in placing the burden of proof in an interference case is not the act of an administrative officer and purely ministerial in its nature, but is the act of a judicial officer, and therefore the Secretary of the Interior is without jurisdiction or authority over the matter presented to him by appeal. †*Id.*

3. The duty imposed upon the Commissioner to determine which of certain rules were applicable to an interference and upon whom the burden of proof should be placed involved the exercise of a judicial discretion and authority the same as the admission or rejection of evidence or the making of any other interlocutory ruling, and for that reason his decision on this question cannot be reviewed by the Secretary of the Interior on appeal to him from the decision of the Commissioner. †*Id.*

III. Federal Courts.

(*a*) *Court of Appeals, Dist. of Columbia.*

1. The act of Congress approved February 9, 1893, which gave the Court of Appeals of the District of Columbia the power to review the decisions of the Commissioner of Patents, is such an act as Congress was authorized to pass under the Constitution, and in the matter of such appeal no encroachments of the judicial department of the Government on the domain of the executive department are found to justify the courts in holding that the act in question is unconstitutional. (Sup. Ct. U. S. Jan. 25, 1899.)

Fuller, C. J.] *U. S. *ex rel.* Bernardin *v.* Duell, Com'r. of Pats., 86 O. G. 995.

2. Where appeal was taken to the Court of Appeals on the ground that the Commissioner of Patents erred (1) in refusing to consider whether a patent granted to one of the parties to the interference was for the same invention as that involved in the interference and if so whether it is not a statutory bar to the grant of a patent for said invention to said party; (2) in holding that this question of a statutory bar was an *ex parte* one and therefore not involved in the interference; (3) in declining to consider whether an application as filed disclosed the invention in controversy, and (4) in refusing to hold that the subject-matter of the interference was inserted in one of the applications by amendment after the application had been filed in the Patent Office and subsequently to the application filed by the other party, upon which his patent had issued, *Held*, that these questions are of a preliminary nature and do not arise for consideration by the Court of Appeals upon a decision by the Commissioner of Patents in an interference case. (C. A. D. C. Oct. 4, 1899.)

ALVEY, J.] *Hulett *v.* Long, 89 O. G, 1141.

3. *Held*, further, that the mode of raising these questions in the Patent Office and of their determination therein is specially provided for and prescribed by rules 122, 124 and 126 of the rules of practice of that office. *Id.*

4. The appeal allowed to the Court of Appeals for the District of Columbia by the act of Congress of February 9, 1893, in case of interferences, is for the purpose of having the final decision of the Commissioner of Patents on the question of priority of invention reviewed and determined as that question is contemplated and provided for in section 4904, Revised Statutes, and not for the purpose of having decisions upon collateral or interlocutory questions reviewed and decided. *Id.*

5. If all collateral and interlocutory proceedings in the Patent Office were subjects of appeal to the Court of Appeals, the proceedings for patents might be made almost interminable, to say nothing of the enormous costs that would be incurred in prosecuting and defending against such appeals. *Id.*

6. Where it was urged on appeal to the Court of Appeals from the decision of the commissioner in an interference case that the application of one of the parties as originally filed did

not claim or disclose the subject-matter of the interference and that the matter of interference is new matter put in the case by amendment since the original application was filed, and therefore said party had no right to make the claim in issue, and that he could not be given the benefit of constructive reduction to practice as of the date of filing his original application, *Held*, that this is a preliminary question which has been disposed of by the tribunals of the office on motion to dissolve under rule 122. *Id.*

7. It is competent for parties to an interference case to show in the development of their testimony that their devices are different, and thereby preclude any adjudication of priority that would prevent either one from being protected in the possession of his own device. The *prima facie* and *ex parte* adjudication of identity which was the necessary prerequisite to the declaration of interference might be shown upon judicial investigation to have been erroneous, and the interests of justice would seem to demand that it should be open to the parties to make such showing, and when such showing is made as part of the cause and in the ordinary course of the litigation upon the merits it enters into the substance of the cause and is proper to be considered by the Court of Appeals on appeal from the final decision of the commissioner. (C. A. D. C. Apr. 4, 1899.)

MORRIS, J.] *Bechman *v.* Wood, 89 O. G. 2459.

8. As a general proposition, the power of the Court of Appeals in interference cases is limited to the determination of the question of priority of invention as between the parties to the interference, and neither the question of patentability of the invention nor the propriety of the declaration of interference is open to consideration. (C. A. D. C., Dec. 6, 1899.)

MORRIS, J.] *Bechman *v.* Wood, 89 O. G. 2462.

III. FEDERAL COURTS.

(*b*) *Circuit Courts.*

1. Having obtained jurisdiction of a suit in equity, when brought, the court does not lose such jurisdiction merely because by reason of subsequent events the right to relief by injunction

may have been lost. The court will hold the cause until final disposition. (C. C., S. D. N. Y., Mar. 25, 1899.)

LACOMBE, J.] *Lalance & Grosjean Mfg. *et al. v.* Haberman Mfg. Co. Same *v.* Matthai *et al.* 93 Fed. Rep. 197.

2. When both complainant and defendant are corporations of the same state, and therefore for purposes of jurisdiction, citizens of that state, a federal court can have no jurisdiction of a cause of action arising out of a contract of license under a patent. The failure to pay royalties upon which a claim of forfeiture of license is grounded, is a breach of contract cognizable in a court of common law. That and the cancellation of the contract of license or other equitable remedy in that regard are matters justiceable in a state court, but in the absence of diverse citizenship are clearly outside the jurisdiction of a federal court. (C. C., E. D. Penn. June 27, 1899.)

GRAY, J.] *Standard Dental Mfg. Co. *v.* Nat'l Tooth Co., 95 Fed. Rep. 291.

3. The allegation in a bill that the defendant corporation was "organized under and pursuant to the laws of the state of New Jersey" is an affirmative statement that it is a citizen of New Jersey, and therefore sufficient to confer jurisdiction upon a federal court, inasmuch as the complainant is a resident of another state. (C. C., S. D. Ohio, W. D. July 31, 1899.)

THOMPSON, J.] *Block *et al. v.* Standard Distilling & Distributing Co., 95 Fed. Rep. 978.

Labels.

1. Where the Examiner refused to accept application papers signed by the attorney for applicant on the ground that there is no provision in the copyright law which permits the application to be signed by any other than the proprietor or owner of a label, *Held*, as that there is no provision in the copyright law that requires an application to be signed by the proprietor, and as it has been the uniform practice of this Office and the Librarian of Congress to register for an author, designer, etc., books, etc., upon an application made by his agent or attorney the application should be accepted. (Oct. 29, 1898.)

DUELL, C.] *Ex parte* McLoughlin Bros., 86 O. G. 1633.

2. Where the Examiner refused to accept application papers for registration of a label which were signed by the attorney for applicant on the ground that there was no written power of attorney, *Held*, that as it has been the practice to receive applications so signed without a written power the application should be received. (Blake *et al. v.* Allen & Co., 56 F. R., 764, cited.) *Id.*

3. Where the Examiner required that as the forms in the Rules of Practice of the Patent Office relating to the registration of prints and labels provided for the signing of the application by the owner or proprietor of the label these forms should be followed, *Held*, that the forms in the Print and Label Rules are merely suggestive and it is not mandatory on an applicant that he should follow them. *Id.*

License.

I. In General.

II. Implied.

III. To Make, Use and Sell.

I. In General.

1. Where an applicant in certain instruments assigned his right, title and interest in an invention, retaining for himself the exclusive right to employ the invention in the manufacture of a certain class of machines, *Held*, that such instruments do not convey the entire interest in the invention or an undivided part thereof; and they are construed to be nothing more than licenses. (Gaylor *v.* Wilder, 10 How., 477, and Waterman *v.* Mackenzie, 54 O. G. 1562, cited. Oct. 5, 1899.)

Duell, C.] *Ex parte* Rosback, 89 O. G. 705.

2. *Held*, further, that under the authorities and the settled practice of the office, the office was justified in construing such instruments as not conveying such an interest in the invention and the patent as would authorize the commissioner under the provisions of rule 26 to issue the patent to the party named as assignee. *Id.*

3. A license does not become void *ipso facto* by failure to pay stipulated royalties; even though a provision is made in the contract of license that such failure to pay shall work forfeiture

of such license, the licensee has a right to be heard as to the facts upon which such forfeiture or annulment is made to depend. The license would remain operative and pleadable and therefore defeat an action for infringement, until rescinded by a court of equity. The obvious course of procedure would be either to sue for damages for non-payment of royalties, or by bill in equity seek the rescission of the contract of license, and that being obtained, to pursue the licensee in a federal court for infringement, and not by a suit which has the dual object of rescinding the contract and obtaining the remedy for infringement at the same time in the same bill. C. C., E. D. Penn., June 27, 1899.)

GRAY, J.] *Standard Dental Mfg. Co. *v.* Nat'l Tooth Co., 95 Fed. Rep. 291.

4. A mere breach of covenant (if such breach be established) does not, *ipso facto*, annul a license. In order to annul it there must be some proper proceeding and a rescission in equity. (C. C., E. D. Penn., June 19, 1899.)

GRAY, J.] *Hanifen *v.* Lupton *et al.*, 95 Fed Rep. 465.

5. Where, under a license, the licensee was empowered to deal in, import, use and sell certain articles covered by patent at certain specified royalties, and he covenanted not to deal in, handle, take orders for, etc., such articles so patented made by any person in this country who is not licensed under the patent "*unless* he pays the royalties thereon himself." *Held*, that it is not important whether the last clause is treated as an estoppel upon the licensor to treat as infringers those manufacturers with whom the licensee dealt in accordance with the license, or as an implication of license to such manufacturers to make and sell their product through the licensee, for the effect of it is, as to the articles thus dealt in, that the patent monopoly was waived. **Id.*

6. Where a license under a patent contained the provision: "This royalty shall be paid only upon said sales and said business done by the party of the second part, the orders for which are taken subsequent to April 1, 1896; and at the expiration or termination in any wise of the agreement, the said royalties shall be paid on all orders taken prior to such expiration or ter-

mination, whether the goods are delivered prior thereto or subsequent thereto," the implication is very strong that deliveries upon new orders must cease. It was not the intention of the agreement that goods could be accumulated by the licensee during the continuance of the license, and, although not ordered before its voluntary cancellation, could be subsequently sold in competition with other licensees. Such sales made after cancellation are unauthorized. (C. C. A., 2d Cir. Apr. 4, 1899.)

SHIPMAN, J.] *Pelzer *v.* City of Binghampton *et al.*, 95 Fed. Rep. 823.

7. A suit on a contract of license under letters patent is not a suit arising under the patent laws. (C. C., N. D. Ill. N. D. July 27, 1899.)

KOHLSAAT, J.] *Perry *v.* Noyes *et al.*, 96 Fed. Rep. 233.

II. IMPLIED.

1. The existence of an implied license from an employé to his employer has always been treated as a mixed question of law and fact, and the determination of the question in one suit cannot make a decisive precedent for another, because the results of such questions may be caused to differ by slight circumstances. (C. C. A., 1st Cir. Dec. 9, 1898.)

PUTNAM, J.] *City of Boston *v.* Allen, 91 Fed. Rep. 248.

2. An implied license, if it relates to an improvement in a process, ordinarily authorizes the employer to continue to practice the process during the whole period of the patent, for the reason that the subject matter of the process is indivisible. But, if the invention pertains to a machine, only the specific machine or machines set up during the time of employment are protected. The rule, however, is more for the application of facts than a rule of law, and therefore is not rigid. **Id.*

3. The permitted use of one or more devices at one locality at one time does not raise any presumption, either of law or fact, in favor of a permission to use others at another locality some years later. **Id.*

4. If the circumstances indicate such an intention, a license to use implies a license to make the thing to be used, and a license to use a thing which one is authorized to make, in the absence of controlling circumstances, imports a license to use it

during the life of a patent. If any restriction was intended it is reasonable to suppose it would have been stipulated for at the time. (C. C., W. D. Mich. S. D. June 13, 1899.)

SEVERENS, J.] *Edison Electric Light Co. *et al. v.* Peninsular Light, Power & Heat Co., 95 Fed. Rep. 669.

III. TO MAKE, USE AND SELL.

1. The complainant, being the owner of letters patent of the United States, No. 264,586, Sept. 19, 1882, for an improvement in soda-water apparatus, executed a license to a firm, conferring upon it, among other things, the exclusive right to make, use and sell the patented invention as applied to new soda-water apparatus "of their own manufacture only," and providing that the license "shall be binding on the parties hereto, their heirs, successors, administrators or assigns and shall be valid until the 19th day of September, 1899, unless sooner terminated by the written consent of both parties hereto," *Held* on consideration of all the provisions in the license, that in imposing the restriction "of their own manufacture only," the complainant intended that the right to make, use and sell the patented invention as applied to new apparatus should only be confined to such person or persons as should hold the license from time to time during its term and manufacture such apparatus, and not exclusively to the firm, and that the license was assignable. (C. C., D. N. Jer. Mar. 16, 1899.)

BRADFORD, J.] *Waldo *v.* American Soda-Fountain Co., 92 Fed. Rep. 623.

2. In accordance with the controlling rules of law, the sale and construction of apparatus embodying the substance of a patented invention, as the electric lighting fixtures in a building, carries with it the right to use such subsidiary and co-operating elements as are, in the contemplation of the parties to the sale, necessary to make the invention useful. (C. C., W. D. Mich. S. D. June 13, 1899.)

SEVERENS, J.] *Edison Electric Light Co. *et al. v.* Peninsular Light, Power & Heat Co. *et al.*, 95 Fed. Rep. 669.

Marking Articles Patented.

1. Where a patent has lain absolutely dormant, the requirement of the statute (R. S. § 4900), with reference to marking patented articles, becomes physically impossible, and does not apply so as to prevent recovery of damages in an action at law for the infringement of the patent. (C. C., D. Mass. Dec. 22, 1898.)

PUTNAM, J.] *Ewart Mfg. Co. *v.* Baldwin Cycle-Chain Co. *et al.*, 91 Fed. Rep. 262.

2. Where the complainant gave notice to the whole public, thus including the defendants by properly marking the manufactured articles, or the inclosing packages with the word "patented," or affixing thereto a label with such a notice, defendants, whose infringement is not denied, cannot avoid liability by denying actual knowledge of the patent at the time of the infringement. It is not material that they did not have actual knowledge provided the constructive knowledge is shown, in the marking as provided by R. S. § 4900. (C. C., E. D. Penn. May 26, 1899.)

MCPHERSON, J.] *Hogg *v.* Gimbel, *et al.*, 94 Fed. Rep. 518.

3. Where in an action to recover penalties for falsely marking articles "patented," the plaintiff alleged that defendant, on a certain date and each and every day thereafter, until the commencement of this suit, did "mark upon 1500 spring-balance computing scales the words and figures 'Patented Feb. 13, '94,'" and asks judgment for $150,000 one-half payable to the United States and the other half to the plaintiff. *Held*, that while it is doubtful whether the continuous markings of a day or given time would constitute more than a single cause of action, yet the defendant is, under the provisions of the statute of the state in which the action is brought, entitled to have the different causes of action separately stated and numbered. (D. C., S. D. Ohio W. D. July 22, 1899.)

THOMPSON, J.] *Hoyt *v.* Computing Scale Co., 96 Fed. Rep. 250.

Patentability.

I. IN GENERAL.

II. COMBINATION.

I. In General.

1. Where patentable novelty has been denied not only by one but by all the expert tribunals of the Patent Office, the applicant must make out a very clear case of invention, (Barratt *v.* Commissioner of Patents, 79 O. G. 2020, cited,) and this is but another application of the same principle that governs in those cases where a patent having been regularly granted all doubt in respect of invention is resolved in favor of the patentee. Fenton Co. *v.* Office Specialty Co., 12 App. D. C. 201, cited. (C. A. D. C., Feb. 7, 1899.)

Shepard, J.] *Smith *v.* Duell, Commissisoner of Patents, 87 O. G. 893.

2. It is as necessary to the validity of a claim that the construction covered by it involve invention as that it involve novelty. (June 1, 1899.)

Greeley, A. C.] *Ex parte* Perkins, 88 O. G. 548.

3. An idea or discovery unaccompanied by any inventive act or practical application of an inventive nature is not within the scope of the patent laws. (C. C., D. N. Jer. Feb. 13, 1899.)

BRADFORD, J.] *McEwan Bros. Co. *v.* McEwan *et al.* 91 Fed. Rep. 787.

4. A mere abstract idea is not patentable irrespective of the means described for carrying it into execution. If when the question arises the answer is self-evident, there can be no patentable novelty in carrying out the idea. (C. C., S. D. N. Y. May 8, 1899.)

COXE, J.] *Badische Analin & Soda Fabrik *v.* Kalle *et al.*, 94 Fed. Rep. 163.

II. COMBINATION.

1. When the combination as a whole performs a duty that no combination of such parts has performed before, that gives it patentability. (C. C., E. D. N. Y. Oct. 6, 1898.)

THOMAS, J.] *Morrin *v.* Lawler. Same *et al. v.* Edison Electric Illuminating Co. of Brooklyn, 90 Fed. Rep. 285.

2. Where the combination was one of old elements, but it was a novel arrangement of those devices, so that by their action a result was attained which had not before been successfully accomplished, such a combination is patentable. (C. C. A., 2d Cir. May 25, 1899.)

SHIPMAN, J.] *Nelson *et al. v.* A. D. Farmer & Son Type Founding Co. *et al.*, 95 Fed. Rep. 145.

3. A combination of old elements, patented or non-patentable in themselves, may be the result of invention, and thus in itself be patentable. But such a combination must possess attributes distinct from those of its constituent elements, and the old elements must so coöperate with each other as to produce a new and useful result. A mere duplication of old elements may be useful, but it does not produce a result differing from what would be produced by the same elements separately, except in quantity or degree. There must be some attribute or quality in the combination distinct from those of its elements,

so as to distinguish it from a mere aggregation of parts. (C. C., D. N. J. May 25, 1899.)

GRAY, J.] *Maier *et al. v.* Bloom *et al.*, 95 Fed. Rep. 159.

III. INVENTION AND SKILL DISTINGUISHED.

1. The use of dowel pins and holes for centering one part of a device upon another is so old and well-known as to be a matter of common knowledge, and was in fact shown in some of the references cited, and to substitute this old centering means for the means shown in the patents cited, would not involve invention but merely the exercise of good judgment. (June 8, 1899.)

GREELEY, A. C.] *Ex parte* Pridmore, 67 MS. Dec. 123.

2. A mechanic, skilled in shaping metal, confronted with the practical idea of avoiding friction between a trolley wheel and the track or groove would easily devise means for accomplishing this result. If a wheel did not revolve freely in a groove of given shape it would almost necessarily occur to him that the groove should be so shaped as not to offer resistance or obtrude friction; and while such change in shape may produce a desirable improvement in the domain of construction, yet it would be the result of ordinary judgment and mechanical skill, and would not involve inventive genius. It would be going too far to hold that one who had found that a wheel of given shape could revolve more freely in circular or rounded grooves than in angular grooves should be given the monopoly of all the half-round or circular trolley track which the business of this country may require. (C. C., D. Mass., Dec. 2, 1898.)

ALDRICH, J.] *Coburn Trolley-Track Mfg. Co. *v.* Chandler *et al.*, 91 Fed. Rep. 260.

3. Where the sweater was felt to be objectionable, but was still worn, and there was no struggle to devise something to take its place, in which the patentee was alone successful, the production of a garment which would be divested of so much of the sweater as objectionally increased the clothing of the wearer required no special power of discernment to distinguish the portion to be discarded, but was only the exercise of mechanical skill. (C. C., E. D. Penn. Jan. 18, 1899.)

DALLAS, J.] *Way *v.* McClarin, 91 Fed. Rep. 663.

4. Mere structural changes, or changes in the location of parts of an operative and successful machine, which only add to the capacity of the machine, involve only mechanical skill, and not invention. (C. C., S. D. Cal. Jan. 30, 1899.)

WELLBORN, J.] *Lettelier *v.* Mann *et al.*, 91 Fed. Rep. 909.

5. Where the change in size and shape of a part of an old machine was but such an adaption of an old thing to a new purpose as would occur to a mechanic of ordinary skill, it did not justify a patent. **Id.*

6. The idea of providing a coiled-wire handle for implements which come in contact with heat, thus permitting the circulation of air and ensuring sufficient coolness of the handle to permit of ready manipulation at all times, having once been put into practical form, the subsequent work of fitting the handle to the bails of different vessels and adjusting it to new environments is within the domain of the skilled mechanic. (C. C., N. D. N. Y. Feb. 27, 1899.)

COXE, J.] *Gaitley *v.* Greene, 92 Fed. Rep. 367.

7. The substitution of a heavy "momentum" pulley for a light pulley may be advantageous in a particular case, but the advantage results from the use of ordinary mechanical skill and without the exercise of inventive faculty. (C. C., D, Mass. Feb. 24, 1899.)

BROWN, J.] *Parsons *v.* Seelye, 92 Fed. Rep. 1005.

8. As soon as the want of a high back as well as a high front to overalls should be felt, the exercise of mechanical skill, without inventive genius would provide it. (C. C., D. Ver. Apr. 1, 1899.)

WHEELER, J.] *Corser *v.* Brattleboro Overall Co., 93 Fed. Rep. 805.

9. The placing of garment patterns in a particular way for the purpose of economizing cloth does not amount to invention. If the order of placing is not new it is merely a good way; if it is new, it is merely a better way, and amounts only to a matter of judgment, producing good workmanship, and not a matter of invention, producing a distinctively new method. (C. C., D. Ver. Apr. 1, 1899.)

WHEELER, J.] *Corser *v.* Brattleboro Overall Co., 93 Fed. Rep. 809.

10. A patent must combine utility, novelty and invention. It may in fact embrace utility and novelty in a high degree, and still be only the result of mechanical skill as distinguished from invention. It must amount to invention. (C. C. A., 4th Cir. May 2, 1899.)

GOFF, J.] *Christie *et al. v.* Hygeia Pneumatic Bicycle Saddle Co. *et al.*, 93 Fed. Rep. 965.

IV. INVENTION AND SUGGESTION DISTINGUISHED.

Merely telling a skilled workman to fix an old device so that it will perform a new function, would not have produced a new device, unless the workman, in addition to his mechanical skill, possessed sufficient ingenuity to contrive the new device, and if such new device involved patentable invention, the original suggestion would not defeat the right to a patent therefor. Such a suggestion is mere information, the receiving and acting upon which are not surreptitious or unjust. (C. C., D. Ver. Apr. 1, 1899.)

WHEELER, J.] *Corser *v.* Brattleboro Overall Co., 93 Fed. Rep. 809.

V. EVIDENCE OF EXTENSIVE USE.

1. Although it may appear that a device is of superior utility over other devices, as it has gone into general use, the fact that it has gone into such use, even to the displacement of other devices, has no weight upon the question of patentable novelty except when it is otherwise in doubt. (C. A. D. C. Feb. 7, 1899.)

SHEPARD, J.] *Smith *v.* Duell, Com'r. of Pat., 87 O. G. 893.

2. In a doubtful case, the fact that the patented device has gone into general use, and superseded other devices, may be sufficient to turn the scale, and sustain the presumption of patentability arising from the grant of the patent. (C. C. A., 3d Cir. Nov. 28, 1898.)

ACHESON, J.] *Thomas Roberts Stevenson Co. *v.* McFassell, 90 Fed. Rep., 707.

3. The question of anticipation or lack of novelty not being free from doubt, the success with which the patented product

has met has weight in turning the scale in favor of the invention. (C. C., D. N. Jer. Feb. 13, 1899.)

BRADFORD, J.] *McEwan Bros. Co. *v.* McEwan *et al.*, 91 Fed. Rep. 787.

4. Where the differences between the patented devices and the alleged anticipating devices are slight, yet are sufficient to make the patented device commercially successful, the magnitude of that success aids the court in resolving doubtful considerations in favor of the patent in suit. (C. C., S. D. N. Y. Dec. 27, 1898.)

THOMAS, J.] *Rubber Tire Wheel Co. *v.* Columbia Pneumatic Wagon Wheel Co., 91 Fed. Rep. 978.

5. Where the sales of an article and its extensive use have been phenomenal they may be considered as evidence of novelty, value and usefulness of the article, but it does not necessarily follow that invention was required to design and construct it, and where invention is lacking a patent for the article cannot be sustained. (C. C. A., 4th Cir. May 2, 1899.)

GOFF, J.] *Christy *et al. v.* Hygeia Pneumatic Bicycle Saddle Co., 93 Fed. Rep. 965.

VI. EVIDENCE OF RESULT.

1. The addition of improvements to an old but commercially unsuccessful machine, whereby a great increase of speed and great saving in cost of operation results, thereby bringing the machine up to commercial requirements, so that it may be considered as the first successful machine, entitles the improver to a place among inventors. (C. C., N. D. Cal. May 22, 1899.)

MORROW, J.] *Fruit Cleaning Co. *v.* Fresno Home-Packing Co. *et al.*, 94 Fed. Rep. 845.

2. Where a machine turned out satisfactory work, but it was not commercially successful, for the reason that it did not turn out the work with desirable rapidity, *Held*, that such device was not so inoperative as to be deficient in patentability. (C. A. D. C. Apr. 4, 1899.)

MORRIS, J.] *Beehman *v.* Wood, 89 O. G, 2459.

VII. UTILITY.

1. While utility is a circumstance to be considered in deter-

mining the question of novelty, it is not necessarily conclusive of the question; for, if so, every improvement in a machine, however slight and although resulting from mechanical skill only, would be patentable, and this, according to the unquestionable weight of authority, is not the law. (C. C., S. D. Cal. Jan. 30, 1899.)

WELLBORN, J.] *Lettelier *v.* Mann *et al.*, 91 Fed. Rep. 909.

2. The utility of an invention must be gauged by the state of the art at time the patent was applied for, and it is immaterial that since then other means have been employed to accomplish the same result at still less cost. (C. C, D. N. J. July 14, 1899.)

KIRKPATRICK, J.] *Westinghouse Electric Mfg. Co. *v.* Beacon Lamp Co. *et al.*, 95 Fed. Rep. 462.

3. Mere utility does not establish patentability. It is not every improvement in a mechanism that is the result of the exercise of the inventive faculty. In the progress of the arts, improvements are constantly being developed which are clearly the result of obvious mechanical suggestion, and to grant patent monopolies for such improvements would not be to encourage invention, but would impose upon mechanics and the public generally burdens for which there would be no adequate compensation. (C. C., E. D. Penn. Aug. 9, 1899.)

GRAY, J.] *Shoe *v.* Gimbel *et al.*, 96 Fed. Rep. 96.

IX. NOVELTY AND INVENTION.

(*a*) *New Use or Adaptation.*

1. A device that effects a valuable function should not be declared unpatentable or lacking in novelty because some one has used one of the parts here and another there to secure the same result, but has used them so awkwardly and illy associated with other parts that the result was not obtainable. (C. C., S. D. N. Y. Dec. 27, 1898.)

THOMAS, J.] *Rubber Tire Wheel Co. *v.* Columbia Pneumatic Wagon Wheel Co., 91 Fed. Rep. 978.

2. It is established by various decisions that a novel conception of the application of old means to produce an unusual or unexpected result is not a double use and may be patented.

The question in such cases is whether or not the conception involves invention. (C. C., D. Conn. Sept. 5, 1899.)

TOWNSEND, J.] * Yale & Towne Mfg. Co. *v.* Sargent & Co., 97 Fed. Rep. 106.

IX. NOVELTY AND INVENTION.

(*b*) *Process or Method.*

1. In view of the case of Westinghouse *v.* Boyden Co., 83 O. G. 1067; 170 U. S. 537, it cannot be claimed that the case of Risdon Works *v.* Medart, 71 O. G. 751; 158 U. S. 68, decided that a process to be patentable necessarily involves a chemical or other similar elemental action. (Apr. 10, 1899.)

DUELL, C.] *Ex parte* Rogers & Winslow, 87 O. G. 699.

2. From the decision of Westinghouse *v.* Boyden Co. it may be deduced, first, that processes which involve "some chemical or other elemental action" are patentable; second, that processes which involve "nothing more than the operation of a piece of mechanism of the function of a machine" are not patentable, and, third, that processes may be patentable which "though ordinarily and most successfully performed by machinery may also be performed by simple manipulation." *Id.*

3. Processes which consist in the manipulation of a blank to make abrasive pad-covers for buffing-machines, the steps of which consist substantially in holding the edge of the blank, stretching and forming the center of the blank, and manipulating the blank so that the edges will be brought over the central part, *Held*, to fall within the third class of processes and to be patentable. *Id.*

4. Some processes of manufacture are certainly patentable, though no test by which they may be distinguished from those which are not, and which can be definitively applied to all cases, has been authoritatively established. But there is no warrant in the authorities for the assumption that, unless a chemical change be effected by a process, no patentable invention or discovery can be involved in it. It is true that in both Corning *v.* Burden, 15 How. 252, and Locomotive Works *v.* Medart, 158 U. S. 71, 15 Sup. Ct. 745, 71 O. G. 751, processes involving chemical reaction were contrasted with methods which comprise nothing but successive mechanical steps to produce a merely mechan-

ical change in the substances operated upon; but in so doing the courts were illustrating, not defining, the difference between a patentable and an unpatentable process. (C. C., E. D. Penn. Jan. 12, 1899.)

DALLAS, J.] *Melvin *et al.* *v.* Thomas Potter, Sons & Co., 91 Fed. Rep. 151.

5. A discovery to be patentable must have the attributes of invention, but the mental operation is somewhat different in one who invents a machine and one who discovers a process. The basic truth upon which rests a process may come to the discoverer suddenly and unexpectedly. He may not understand the law upon which the process operates, and he may be unable to explain the cause of certain phenomena; nevertheless, if he be the first to give to the world as a result of his method a new and valuable article of manufacture, he is entitled to protection. (C. C., S. D. N. Y. May 8, 1899.)

COXE, J.] *Badische Analin & Soda Fabrik *v.* Kalle *et al.*, 94 Fed. Rep. 163.

IX. NOVELTY AND INVENTION.

(*c*) *Products.*

If one discovers a new and useful product he is entitled to the full benefit thereof no matter how it may be produced. A patent for a product must produce, by the process it describes, that article and no other. If the article be old, it cannot be the subject of a patent even though made artificially for the first time. A product is not patentable upon the ground that an already known article is made more perfectly by the new process or machine than it was before. If this rule were otherwise the product of each successive machine would be patentable, but improvements in degree or quality are not patentable. (C. C., S. D. N. Y. May 8, 1899.)

COXE, J.] *Badische Analin & Soda Fabrik *v.* Kalle *et al.*, 94 Fed. Rep. 163.

IX. NOVELTY AND INVENTION.

(*d*) *Substitution of Materials.*

1. The substitution of one material for another having the same general characteristics, involves no patentable invention,

particularly where the substitution is simple and obvious, involving no novelty of construction nor anything substantially new in the resulting product. But where the substituted material possessed new and theretofore unknown properties which produce better results and save time, labor and money, then such substitution involved invention. (C. C., S. D. N. Y. Dec. 5, 1898.)

COXE, J.] *King *et al.* *v.* Anderson *et al.*, 90 Fed. Rep. 500.

2. The substitution of hydrated lime for powdered marble in a compound for restraining the too rapid setting of plaster of Paris where the resulting compound is better calculated to mix evenly with the plaster and its action is more uniform, prompt and reliable, and further, where the difference between the old compound and that with the substituted lime hydrate was the difference between partial and complete success, involved patentable invention. **Id.*

IX. NOVELTY WITHOUT INVENTION.

(*a*) *Aggregation.*

1. The combination here claimed has not produced a new device differing in character and function from others then in existence and common use, nor does it accomplish a novel result through the co-operative action of old agencies. The applicant has done nothing more than exercise mechanical skill in bringing old devices into juxtaposition, and thereby constituting an aggregation merely of separate elements. (C. A. D. C. Feb. 7, 1899.)

SHEPARD, J.] *Smith *v.* Duell, Com. of Pat., 87 O. G. 893.

2. Where a combination of old devices produces a new result such combination is doubtless patentable, but where the combination is not only of old elements, but of old results, and no new function is evolved from such combination, it falls within the rulings of this court in Hailes *v.* Van Wormer, 5 O. G. 89; 20 Wall. 353, 368; Reckendorfer *v.* Faber, 10 O. G. 71; 92 U. S. 347, 356; Phillips *v.* City of Detroit, 17 O. G. 191; 111 U. S. 604; Brinkerhoff *v.* Aloe, 146 U. S. 515, 517; Palmer *v.* Corning, 70 O. G. 1497; 156 U. S. 342, 345; Richards *v.* Chase Ele-

vator Co., 71 O. G. 1456; 158 U. S. 299. (Sup. Ct. U. S. May 15, 1899.)

BROWN, J.] *Office Specialty Mfg. Co. *v.* Fenton Metallic Mfg. Co., 87 O. G. 1608.

X. NOVELTY WITHOUT INVENTION.

(*b*) *Arrangement.*

1. Where a mechanical result is obtained by the movement of one element upon another element of a combination, it does not usually involve invention to reverse the operation, and secure the same result by making the first element stationary and the second movable. And so, where the resultant motion is secured by a stationary cam guiding a tool, it may often be an obvious change to reverse the parts by making the cam movable and the tool stationary. But the question whether or not such change is obvious is to be determined by examination of the particular machine in which it is made. (C. C. A., 6th Cir. Mar. 7, 1899.)

TAFT, J.] *Penfield *v.* Chambers Bros. Co., 92 Fed. Rep. 630.

2. While it is true that the exact counterpart of the patented device is not found in the prior art, every feature of it is to be found in earlier patented devices combined in the same immediate relations and performing the same functions as in the combinations of the patented device; and whatever of novelty there may be said to be in the combination is a matter of selection and arrangement, and did not involve invention. (C. C. A., 7th Cir. Feb. 23, 1899.)

PER CURIAM.] *Lowenbach *v.* Hake-Stern Co. *et al.*, 92 Fed. Rep. 661.

3. After dynamic-electric machines and electric motors of sufficient power to serve as a propelling force for driving street cars were invented, it did not involve the exercise of the inventive faculty to substitute good machines in an old combination for the defective ones when the functions to be performed had been clearly outlined in the prior art. (C. C. A., 6th Cir. Mar. 7, 1899.)

TAFT, J.] *Kelly *et al. v.* Springfield Ry. Co. *et al.*, 92 Fed. Rep. 614.

X. Novelty Without Invention.

(*c*) *Composition of Matter.*

In order to sustain a patent for a compound, it is not only necessary that its production in the manner prescribed in the specification shall be novel, but it is necessary that such production shall also involve invention. (C. C. A., 3d Cir. Sept. 22, 1899.)

Bradford, J.] *Arlington Mfg. Co. *v.* Celluloid Co., 97 Fed. Rep. 91.

X. Novelty Without Invention.

(*d*) *Double or Analogous Use.*

1. The courts have held that the mere use of an apparatus is not an art, machine, manufacture or composition of matter, and therefore does not come within the definition of a patentable invention. This holding is not inconsistent with the accepted doctrine that invention may sometimes be displayed in the adoption of an old device in a different art, but even in such a case the thing itself and not the bare idea of using it, should be made the subject of the claims. (Apr. 10, 1899.)

Greeley, A. C.] *Ex parte* Averell, 66 MS. Dec. 442.

2. An improvement in a stocking-supporter, consisting in raised lugs on the side of the slot-plate to prevent the stud over which the upper end of the stocking is gripped from rising in the slot and becoming disengaged, does not rise to the dignity of invention in view of the fact that lugs for the same purpose have been used in suspender-clasps. (C. A. D. C. Feb. 7, 1899.)

Shepard, J.] *Smith *v.* Duell, Commissioner of Patents, 87 O. G. 893.

3. There is no such remoteness in the use of the slot-plate with the lugs in the clasp of the suspender as is sufficient to raise its adaptation to use in a stocking-supporter from the plane of mechanical ingenuity to that of invention. The use is clearly analogous. (Potts *v.* Creager, 155 U. S., 597, and Briggs *v.* Commissioner of Patents, 78 O. G., 169, cited.) **Id.*

4. The art of painting on canvas and paper is so nearly

allied to painting or decorating clay that it involved no invention to transfer the use of the atomizer from one art to the other, and the use of the atomizer to apply pigments to clay is only a case of applying what was on its face expressly intended for all arts to a special art for which it was peculiarly adapted. (C. C., S. D. Ohio, W. D. Dec. 2, 1898.)

TAFT, J.] *Fry *v.* Rookwood Pottery Co. *et al.*, 90 Fed. Rep. 495.

5. A device having transverse pipes arranged in horizontal series in a vessel into which beer was allowed to drip, and through which pipes there was a continuous flow of cold water to cool the beer, having been shown to be old, *Held*, that no invention was involved in using a substantially similar series of pipes in the Solvay bicarbonate column, particularly in view of the fact that other quite similar means had also been used to cool the bicorbonate mixture of the Solvay column. (C. C. A., 6th Cir. Nov. 28, 1898.)

TAFT, J.] *Solvay Process Co. *v.* Michigan Alkali Co. *et al.*, 90 Fed. Rep. 818.

6. If the patentee had invented some practical method of overcoming the tendency of street-railway rails to expand and contract, according to changes in temperature, he would have invented something new and useful, but he is not entitled to a monopoly of such supposed invention merely because the well-known old process of his patent fell into a use made available by the adaptation of new conditions to new needs, with which the patentee had no concern. The application of an old and well-known method to a new use in an art analogous to that to which the old method had been applied does not involve patentable invention. (C. C., E. D. Mo., E. D. Jan. 10, 1899.)

ADAMS, J.] *Falk Mfg. Co. *v.* Missouri Ry. Co. *et al.*, 91 Fed. Rep. 155.

7. As overalls with high fronts or bibs were old, the patent could only be valid for specific improvements if valid at all, and if the improvement could be said to cover the extension of the back of overall to the same height as the bib in front, for the protection of the back of the wearer, the extension would be like the bib in front and would be merely putting that device

to the same use in a new place in the same garment, for the same purpose. Such putting to a new use does not constitute patentable invention. (C. C., D. Ver. Apr. 1, 1899.)

WHEELER, J.] *Corser *v.* Brattleboro Overall Co., 93 Fed. Rep. 805.

8. The question of double or analogous use, *i. e.*, whether the new use is so nearly analogous to the former one that the applicability of the device to its new use would occur to a person of ordinary mechanical skill, is one dependent upon the peculiar facts of each case. (C. C. A., 2d Cir. Apr. 4, 1899.)

LACOMBE, J.] *Briggs *v.* Duell, Com. of Patents, 93 Fed. Rep. 972; 87 O. G. 1077.

X. NOVELTY WITHOUT INVENTION.

(e) Process or Method.

1. A process or method of forming a rail-joint consisting of, (1) Cleaning the surfaces of the rails for a short distance from the ends to be joined; (2) heating the cleaned rail ends; (3) forming and adjusting a mould upon and around the rail ends; (4) pouring molten metal into this mould and letting it remain there until it solidifies, belongs to the domain of mechanical skill and not to the domain of invention, for each and every step of the process was well-known to foundrymen and artisans in iron, steel and metals long before its particular application to the forming of rail joints. (C. C., E. D. Mo., E. D. Jan. 10, 1899.)

ADAMS, J.] *Falk Mfg. Co. *v.* Missouri Ry. Co. *et al.*, 91 Fed. Rep. 155.

2. Where the process is simply the mechanical operation of a combination of mechanical elements, with no chemical or similar elemental action involved in producing the desired result, the operation is simply the function of a machine, and as such is not the subject of a patent. (C. C., D. N. Jer.)

KIRKPATRICK, J.] *Stokes Bros. Mfg. Co. *v.* Heller *et al.*, 96 Fed. Rep. 104.

IX. NOVELTY WITHOUT INVENTION.

(f) Substitution of Materials or Parts.

1. It is well settled that the mere substitution of one mate-

rial for another does not involve patentable novelty, although the substituted material may be superior for the purpose to that before in use. (Feb. 2, 1899.)

GREELEY, A. C.] *Ex parte* Cochran, 66 MS. Dec. 247.

2. The substitution of direct driving for indirect driving by countershaft and gearing is a mere substitution of a well-known equivalent, and there is no invention in applying to a main shaft the same mechanism which was formerly applied to a countershaft. (C. C., D. Mass. Feb. 24, 1899.)

BROWN, J. *Parsons *v.* Seelye, 92 Fed. Rep. 1005.

IX. NOVELTY WITHOUT INVENTION.

(*g*) *Particular Cases.*

1. A pliable metallic capsule for bottles having applied to its inner surface a coating of material which becomes adhesive when moistened, *Held*, to be not patentable, as cemented appliances—such as envelopes, labels and postage-stamps—requiring merely the application of moisture to put them into use are old. (C. A. D. C. Dec. 9, 1898.)

MORRIS, J.] *Nimmy *v.* Commissioner of Patents, 86 O. G. 345.

2. Mere cheapness is not patentable. Cheap boxes have been made from time immemorial, and it is no new thing and involves no patentable invention, to make a box so cheap that it may be better thrown away or used to kindle a fire than to reship, and whether a box shall be made slightly and cheaply so as to be thrown away after one shipment, or more permanently and substantially at a greater cost, so as to be used in many shipments, is a question of construction and good, prudent business management, rather than of invention. (C. C. A., 7th Cir. Feb. 16, 1899.)

BUNN, J.] *Schrei *et al.* *v.* Morris *et al.*, 91 Fed. Rep. 992.

3. Where the art discloses that an open loop without an anti-friction roller in over-check guides for bridles was old, and a closed loop with an anti-friction roller was also old, *Held*, that no invention was involved in combining the two to produce an open loop with the anti-friction roller. (C. C., N. D. N. Y. Apr. 12, 1899.)

COXE, J.] *Smith *v.* Maxwell, 93 Fed. Rep. 466.

4. In a patent for a safety valve, the only novelty covered by the claim in issue is the extension upward within and through the top of the valve case, and above the muffler, of means for controlling from the outside the regulating device. The thought involved in the mere idea of having some contrivance by which any interior work can be controlled by a rod extending exteriorly, thus avoiding the necessity of taking apart, is a primary one in all the arts; so that the suggestion of making such a connection in this case clearly involved no invention. (C. C. A., 1st Cir. May 4, 1899.)

PUTNAM, J.] *Crosby Steam Gauge & Valve Co. *v.* Ashton Valve Co., 94 Fed. Rep. 516.

5. The substitution of a frame of buckram and coarse cloth for a wire and gauze frame, for a hat support used in trunks and hat-boxes whereby the hat may be securely fastened and held by a hat-pin does not rise to the dignity of patentable invention. (C. C., S. D. N. Y. May 28, 1899.)

SHIPMAN, J.] *Lyons *v.* Bishop *et al.*, 95 Fed. Rep. 154.

Patents.

I. IN GENERAL.

II. PRESUMPTION OF VALIDITY.

III. DEFECTIVE OR VOID.

IV. CONSTRUCTION OF.

(*a*) *In General.*
(*b*) *Liberal or Broad.*
(*c*) *By Drawings.*
(*d*) *By Specification.*
(*e*) *By State of the Art.*

V. CLAIMS.

(*a*) *Ambiguous, How Construed.*
(*b*) *For Combination.*
(*c*) *For Specific Element of Combination.*
(*d*) *Limited by Amendment in Patent Office.*
(*e*) *Limited by their Terms.*
(*f*) *"Substantially as Described," etc.*

VI. CORRECTION OF.

(*a*) *By Certificate of Correction.*

I. In General.

1. A patent for an invention which the patentee refuses to make available himself, and refuses to allow others to make useful, is not within the spirit of the constitution, which assigns as a reason for securing exclusive rights to authors and inventors a desire "to promote the progress of science and the useful arts," and patents so held are entitled to scant, though necessarily to some, recognition at law, and to none whatever in equity. They are not the equivalent of a highly cultivated field, surveyed, plotted and fenced in by the owner; but they constitute, for all useful purposes, a waste from which the public is sought to be excluded for reasons of which equity takes no cognizance. (C. C., D. Mass. Dec. 22, 1898.)

Putnam, J.] *Ewart Mfg. Co. *v.* Baldwin Cycle Chain Co. *et al.*, 91 Fed. Rep. 262.

2. While an improver may have made it possible, through his improvements of a pre-existing successful machine, to largely increase the capacity thereof, yet by such improvement he does not entitle himself to the pre-existing subject-matter to which it related. (C. C. A., 3d Cir. Jan. 25, 1899.)

Dallas, J.] *Ginna *et al. v.* Mersereau Mfg. Co., 92 Fed Rep. 369.

II. Presumption of Validity.

1. Where two patents apparently describe the same art or article, the question of identity is open for examination, with the presumption in favor of their diversity. Rob. Pat. § 896. The presumption is that the patentee invented something new, or he would not have secured the second patent. (C. C. A., 9th Cir. Oct. 24, 1898.)

Morrow, J.] *Norton *v.* Jensen, 90 Fed. Rep. 415.

2. The rule that a patent is *prima facie* evidence of novelty and invention, is a mere rule of evidence, which, although it casts the burden of proof upon the alleged infringer, does not take from the courts authority to declare what constitutes novelty and invention. (C. C., S. D. Cal. Jan. 30, 1899.)

WELLBORN, J.] *Lettelier *v.* Mann *et al.*, 91 Fed. Rep. 909.

3. Where a patent has been declared valid after a protracted litigation it raises a strong presumption in its favor, and new alleged anticipatory matter must clearly convince the court that the former decisions were wrong. If any doubt exists on this point the former adjudications should stand. (C. C., D. Mass. Feb. 9, 1899.)

COLT, J.] *Tripp Giant Leveller Co. *v.* Bresnahan *et al.*, 92 Fed. Rep. 391.

4. All the elements of the combination had been used before and the functions of each were well known in the art, but it does not appear that they had ever similarly specifically combined for effecting the purpose accomplished by the device of the patent. The grant of the patent carries with it the presumption of patentability and this presumption is strengthened by the general acceptance of the device, the acquiescence of those skilled in the art and their willingness to accept licenses thereunder. (C. C. A., 3d Cir. June 8, 1899.)

KIRKPATRICK, J.] *Millheim Electric Tel. Co. *et al. v.* Western Electric Co., 95 Fed. Rep. 152.

III. DEFECTIVE OR VOID.

1. There is no authority which holds that a patent regularly issued and valid on its face can be declared void because of a clerical error of an examiner in failing to follow the local rules of practice in the Patent Office. (C. C., N. D. N. Y. June 14, 1899.)

COXE, J.] *Deere *et al. v.* Arnold, 95 Fed. Rep. 169.

2. Under the authority of Ry. Co. *v.* Sayles, 97 U. S. 564, and subsequent cases it is doubtful if a patent, granted on a feature which did not appear in the original specification, and not until some months later by amendment, is valid, especially

where such amendment is not sworn to by applicant. (C. C., D. Ky. June 3, 1899.)

EVANS, J.] *Patent Button Co. *v.* Pilcher, 95 Fed. Rep. 479.

IV. CONSTRUCTION OF.

(*a*) *In General.*

1. Notwithstanding the apparent concessions of counsel on each side as to the scope of the patent in suit, the court, which, with reference to questions so far affecting the public as those of validity and construction of patents, is not bound by stipulations of parties, cannot accept their conclusion when the specification of the patent is clearly insufficient to reach anything beyond what is expressly described in it. (C. C., D. Me. July 30, 1898.)

PUTNAM, J.] *Simonds Roller Mach. Co. *v.* Hathorn Mfg. Co., 90 Fed. Rep. 201.

2. The law intends that the patent shall be preserved, unless the invalidity appear beyond a reasonable doubt; and when a machine created pursuant to the specification of letters patent has reached in its domain the greatest distinction for useful operation, while others who have sought the same ends have failed substantially, and when the rights are of great pecuniary value and have enlisted large financial undertakings, a court of equity should not be diligent to discover nice resemblances to former inventions, especially in behalf of a person who had recognized its validity through years of service in commending it to the public, and whose own signature acknowledged its validity. (C. C., E. D. N. Y. Oct. 6, 1898.)

THOMAS, J.] *Morin *v.* Lawler. Same *et al.* *v.* Edison Electric Illuminating Co. of Brooklyn, 90 Fed. Rep. 285.

3. The difference between a pioneer inventor and an improver, in the construction of patents, is very marked. An original inventor, a pioneer in the art, he who evolves the original idea and brings it to some successful, useful and tangible result, is by the law of patents entitled to a broad and liberal construction of his claims; whereas an improver is only entitled, and justly so, to what he claims, and nothing more. Further-

more, an application for a patent which has been rejected and subsequently amended to conform to the objections of the Patent Office is strictly construed. (Sargent *v.* Lock Co., 114 U. S. 63; 5 Sup. Ct. 1021; Water Meter Co. *v.* Desper, 101 U. S. 332; Gage *v.* Herring, 107 U. S. 640; 2 Sup. Ct. 819; Fay *v.* Cordesman, 109 U. S. 408, 420; 3 Sup. Ct. 236. (C. C. A., 9th Cir. Oct. 24, 1898.)

MORROW, J.] *Norton *et al. v.* Jensen, 90 Fed. Rep. 415.

4. While a feature of construction described in the specification may be read into the claims with a view of showing the connection in which the device is used, and proving that it is an operative device, yet it may not be done for the purpose of making out a case of novelty or infringement, and where an element is expressly included in one claim, it cannot be read into another claim where it is not mentioned. (C. C. A., 7th Cir. Feb. 16, 1899.)

WOODS, J.] *Wilson *et al. v.* McCormick Harvesting Mach. Co., 92 Fed Rep. 167.

5. Where a claim is distinctly, exclusively and broadly for a new combination, there is no authority or principle of law which, so reading it, would warrant the conversion of it by construction into a claim for mere details. (C. C., N. D. Cal. Jan. 23, 1899.)

MORROW, J.] *Risdon Iron & Locomotive W'ks. *v.* Trent, 92 Fed. Rep. 375.

6. The more meritorious the invention, the greater the step in the art, the less the suggestion of the improvement in the prior art, the more liberal are the courts in applying the doctrine of equivalents in favor of the patentee. The narrower the line between the faculty exercised in inventing a device and mechanical equivalents, the stricter are the courts in rejecting the claim of equivalents by the patentee in respect of alleged infringements. (C. C. A., 6th Cir. Mar. 7, 1899.)

TAFT, J.] *Penfield *v.* Chambers Bros. Co., 92 Fed. Rep. 630.

7. Where the fundamental rules of construction applicable to ordinary instruments solve the case it is not necessary to resort to any of those peculiar and somewhat artificial rules of construction which are sometimes assumed to be appropriate with

reference to letters patent issued to inventors. (C. C., D. Me. Mar. 22, 1899.)

PUTNAM, J.] *Adams & Westlake Co. *et al.* *v.* E. T. Burrowes Co., 93 Fed. Rep. 462.

8. Where the language of a claim is clear and simple there is no room for construction, and such a claim for an article cannot be sustained, if to sustain it is necessary to import into it the method or process used in producing such article. (C. C., N. D. N. Y. Apr. 12, 1899.)

COXE, J.] *Lappin Brake-Shoe Co. *v.* Corning Brake-Shoe Co., 94 Fed. Rep. 162.

9. Where a patentee might have claimed a process, or an article used in carrying out the process, but has done neither, the court is prohibited from giving him a patent for a product produced by means of an alleged ingenious device, which is not even mentioned in the claim. Were the rule otherwise it would be a dangerous menace to public rights, which might be destroyed, not by the patent emanating from the Patent Office, but by a different patent subsequently granted by the court.

Id.

10. While the claims of a patent are necessarily confined to the specific combinations which they describe, yet their scope should not be so restricted as to admit of the avoidance of infringement by resort to merely colorable and evasive variations. (C. C., E. D. Penn. May 26, 1899.)

DALLAS, J.] *Smith *et al.* *v.* Ulrich, 94 Fed. Rep. 865.

11. In the construction of a patent, the omission of the patentee to point out or refer in his specification or claims to the special feature which he subsequently maintains is the most important part of his invention, is very significant and should be carefully scrutinized. In McClain *v.* Ortmayer, 57 O. G. 1229, 141 U. S. 419, 12 Sup. Ct. 76, the court held:

"The object of the patent law in requiring the patentee to 'particularly point out and distinctly claim the part, improvement or combination which he regards as his invention or discovery,' is not only to secure to him all to which he is entitled, but to apprise the public of what is still open to them. The claim is the measure of his right to relief."

(C. C. A., 1st Cir., May 31, 1899.)

COLT, J.] *MacColl *v.* Knowles Loom Works, 95 Fed. Rep. 982.

12. A patent to the original inventor of a machine which first performs a useful function, protects him against all mechanisms which perform the same functions by equivalent mechanical devices; but a patent to one who has simply made a slight improvement on a device that performed the same function before as after the improvement is protected only against those who use the very improvement that he describes and claims, or mere colorable evasions of it. (C. C. A., 8th Cir. Oct. 9, 1899.)

SANBORN, J.] *McBride *v.* Kingman *et al.* Same *v.* Sickels *et al.* Same *v.* Randall *et al.* Same *v.* Ainsworth *et al.*, 97 Fed. Rep. 217.

13. The statute requires the inventor to particularly point out and distinctly claim the improvement or combination which he claims as his discovery. R. S. § 4888. When under this statute the inventor has made his claims he has thereby disclaimed and dedicated to the public all other combinations and improvements apparent from his specification and claims that are not mere evasions of the device, combination or improvement, which he claims as his own. While the patent is notice of the claims which it contains and allows, it constitutes an estoppel of the patentee from claiming under that or any subsequent patent any combination or improvement there shown which he has not clearly pointed out and distinctly claimed as his discovery or invention when he received his patent. It is a complete and a legal notice to every one—notice on which every one has a right to rely—that he may freely use such improvements and combinations without claim or molestation from the patentee. It would constitute rank injustice to permit an inventor, after a combination or device that he did not distinctly claim in his patent had gone into general use, and years after his patent had been granted, to read that combination into one of the claims of his patent and to recover for its infringement of every one who had used it upon the faith of his solemn declaration that he did not claim it. *Id.*

IV. CONSTRUCTION OF.

(*b*) *Liberal or Broad.*

1. It is of no legal consequence that a patentee fails to ex-

plain the physical laws of which he makes use in the practice of his invention, because an inventor is not deprived of the fruits of his genius by the fact, if it exists, that he is neither a mathematician nor a physicist. (C. C., D. Me. July 30, 1898.)

PUTNAM, J.] *Simonds Rolling. Mach. Co. *v.* Hathorn Mfg. Co., 90 Fed. Rep., 201.

2. While it is the ordinary rule, often stated, that a patentee is entitled to claim all the uses and advantages which belong to his patent, whether foreseen by him or not, yet this is limited so as to exclude uses which require further exercise of the inventive faculty, and uses the means for accomplishing which are not so indicated in the specification as to make them available to persons of ordinary skill in art. **Id.*

3. It is not enough that a patent suggests an object to be accomplished, if it does not also suggest or point out practically the means for its accomplishment. (Citing Gordon *v.* Warder, 150 U. S. 47, 50; 14 Sup. Ct. 32.) **Id.*

4. Where a patentee's contribution to the art constituted an invention, not a great or primary invention, but yet a distinct advance in an art crowded with skilled mechanics, the court should uphold his patent. (C. C., S. D. N. Y. Nov. 15, 1898.)

COXE, J.] *Gormully & J. Mfg. Co. *v.* Stanley Cycle Mfg. Co. *et al.*, 90 Fed. Rep. 279.

5. The rule that an inventor of a machine is entitled to the benefit of all the uses to which it can be put, whether he knew of them or not, cannot operate to sweep within the patent structures which do not embody the invention claimed and only resemble some of its subordinate features, and to infringe the defendant must use the invention which the patentee has described and claimed. (C. C., S. D. N. Y., Nov. 15, 1898.)

COXE, J.] *Palmer *et al. v.* De Yongh, 90 Fed. Rep. 281.

6. Where it appears that a patented process has proved commercially successful, and not only revolutionized the art to which it pertains both as to time saved and to superior product, but also has resulted in displacing other processes of a similar

nature, the court is disposed to sustain it, unless it is clearly invalid under the law. Nor does it detract from the merit of such an invention that prior inventions had nearly solved the problem or had reached a successful experimental stage in its solution. When the prior art is brought to bear upon any important invention, this is often found to be the situation. (C. C., D. Mass. Apr. 7, 1899.)

COLT, J.] *Tannage Patent Co. *v.* Donallan, 93 Fed. Rep. 811.

7. Previous efforts and previous failures add to the importance of the work of the successful inventor or discoverer. A process carefully conducted by a skilled expert may be adequate to tan skins, and yet be commercially worthless. Such experimental success should have little or no weight in determining the scope of a patent for a commercially successful process.

**Id.*

8. In determining the question of anticipation, if the identity of method and result of the patented device with that of the alleged anticipatory matter is doubtful, the doubt must be resolved in favor of the successful patentee, who has in a practical way materially advanced the art. (C. C. A., 1st Cir. Apr. 25, 1899.)

COLT, J.] *Simonds Rolling Mach. Co. *v.* Hathorn Mfg. Co. *et al.*

*Hathorn Mfg. Co. *et al.* *v.* Simonds Rolling Mach. Co., 93 Fed. Rep. 958.

9. A patentee who is the original inventor of a device or machine—a pioneer in the art—is entitled to a broad and liberal construction of his claims; but an inventor who only claims to be an improver is only entitled to what he claims and nothing more. In other words, the original inventor of a device or machine has the right to treat as infringers all who make devices or machines operating on the same principle, and performing the same functions by analogous means or equivalent combinations. (C. C. A., 9th Cir. Feb. 13, 1899.)

HAWLEY, J.] *Overweight Counterbalance Elevator Co. *v.* Improved Order of Red Men's Hall Ass'n of San Francisco, 94 Fed. Rep. 155.

10. Where an inventor has devised a machine or tool for

doing work which had previously been done by hand, and the utility of the device is at once recognized by the trade, the court should hesitate to declare the patent therefor void for want of invention because what was done may be effected by the modification of an old structure used for a different purpose. (C. C. A., 1st Cir. Sept. 14, 1899.)

COLT, J.] *Reynolds *v.* Buzzell, 96 Fed. Rep. 997.

IV. CONSTRUCTION OF.

(*c*) *By Drawings.*

1. The mere fact that a patent expressly shows a scale upon which the drawings are made is not of a controlling character; for it is of little consequence whether the relative dimensions of the parts of a device are gathered from a scale expressly shown, or from the apparent proportions indicated by the drawings without a scale; and in either event, the dimensions shown are not to be taken as elements in the claim, unless the patentee has expressly limited himself within the rules stated by the Court of Appeals in Reece Buttonhole Mach. Co. *v.* Globe Buttonhole Machine Co., 10 C. C. A. 194; 61 Fed. Rep. 958; 67 O. G. 1720; C. D. 1894. (C. C., D. Me. July 30, 1898.)

PUTNAM, J.] *Simonds Rolling Mach. Co. *v.* Hathorn Mfg. Co., 90 Fed. Rep. 201.

2. If there be any invention, it is not to be found in the combination described in the claims, but by reference to the drawing and in the words "substantially as described." This would confine the plaintiff to a metallic frame divided longitudinally into three sections, each fitted with short rollers, two of which project above and forward of the front bar of the frame, which is bent inward in front of the middle section to form the "re-entrant bend or recess" for the insertion of the hand. (Sup. Ct. U. S. May 15, 1899.)

BROWN, J.] *Office Specialty Mfg. Co. *v.* Fenton Metallic Mfg. Co., 87 O. G. 1608.

IV. CONSTRUCTION OF.

(*d*) *By the Specification.*

1. A description of details, in a specification, which the claim does not make elements of the combination, and which are not

essential to it, is to be held as only pointing out the better method of using the combination. (C. C. A., 1st Cir. Dec. 9, 1898.)

PUTNAM, J.] * City of Boston *v.* Allen, 91 Fed. Rep. 248.

2. While the claim and specification of a patent may be read together for the purpose of better understanding the meaning of the claim (Sulphate Pulp Co. *v.* Falls Pulp Co., 80 Fed. Rep. 395, 405) the specification cannot be accepted as enlarging or extending the invention stated in the claim itself. (C. C., D. Mass. Dec. 2, 1898.)

ALDRICH, J.] *Coburn Trolley-Track Mfg. Co. *v.* Chandler *et al.*, 91 Fed. Rep. 260.

3. In construing a patent, if explanation is required, the entire description of the invention is applicable to a true interpretation of the claims. (C. C., N. D. Cal. May 22, 1899.)

MORROW, J.] *Fruit Cleaning Co. *v.* Fresno Home-Packing Co. *et al.*, 94 Fed. Rep. 845.

4. The description of non-essentials in the specification of a patent merely amounts to a statement of the better method of using the combination claimed. (C. C., S. D. N. Y. June 13, 1899.)

TOWNSEND, J.] *Cimiotti Unhairing Co. *et al. v.* Bowsky, 95 Fed. Rep. 474.

5. Where a claim does not include a particular element which is necessary to the operativeness of the invention as set forth in the specification, in order to sustain it the court may resort to the specification and read such element into the claim. (C. C., D. Mass. July 28, 1899.)

BROWN, J.] *Miller *v.* Mawhinney Last Co., 96 Fed. Rep. 248.

IV. CONSTRUCTION OF.

(*e*) *By State of the Art.*

Where an invention is not of a primary, but of a subordinate character, the claims of a patent therefor must be limited to the specific devices shown. (C. C., D. N. J. June 20, 1899.)

ACHESON, J.] *Union Writing Mach. Co. *v.* Domestic Sewing Mach. Co., 95 Fed. Rep. 140.

V. CLAIMS.

(*a*) *Ambiguous. How Construed.*

Where the language of a claim, abstractly considered, is susceptible of either of two constructions, it must be read in the light of the actual condition of things, and if technical and defining, the proper meaning would be determined from the evidence of those skilled in the art. (C. C., E. D. Penn. Jan. 12, 1899.)

DALLAS, J.] *Melvin *et al. v.* Thomas Potter, Sons & Co., 91 Fed. Rep. 151.

V. CLAIMS.

(*b*) *For Combination.*

1. A claim for combination cannot be defeated by showing that each of its elements, separately considered, was old. The proof must show that the combination was old, and failure in such proof is irretrievable failure. (C. C., S. D. N. Y. Nov. 15, 1898.)

COXE, J.] *Gormully & J. Mfg. Co. *v.* Stanley Cycle Mfg. Co. *et al.*, 90 Fed. Rep. 279.

2. While all of the elements of the claim of the patent in suit are contained in the claim of a prior patent to the same inventor, the latter patent has in combination an additional mechanism which is necessary to enable it to accomplish the purpose for which it was designed. The claims of the patents are therefore not co-extensive, and the inventor was entitled to a separate patent for each. Claims are not co-extensive where one specifies all the features of any or all the parts of its subject, while one omits one of those subjects." (C. C., D. N. Jer.)

KIRKPATRICK, J.] *Ryan *v.* Newark Spring Mattress Co., 96 Fed. Rep. 100.

V. CLAIMS.

(*c*) *For Specific Element of a Combination.*

1. The failure to claim a specific element of a combination as a device by itself, is, in effect, an admission that the particular element is old or was not invented by the patentee. (C. C. A., 9th Cir. Feb. 13, 1899.)

HAWLEY, J.] *Overweight Counterbalance Elevator Co. *v.* Imp. Order of Red Men's Hall Association of San Francisco, 94 Fed. Rep. 155.

2. Every element of a combination claim is presumed to be material, and it is the combination of elements that is presumed to be new, and not the elements themselves, when considering claims for a combination. *Id.*

V. CLAIMS.

(*d*) *Limited by Amendment in Patent Office.*

1. "Limitations and provisos imposed by the inventor, especially such as were introduced into the application after it had been persistently rejected, must be strictly construed against the inventor, and in favor of the public, and looked upon in the nature of disclaimers." Mr. Justice Blatchford in Sargent *v.* Lock Co., 114 U. S. 63, 5 Sup. Ct. 1021. (C. C. A., 9th Cir. Oct. 24, 1898.)

MORROW, J.] *Norton *et al. v.* Jensen, 90 Fed. Rep. 415.

2. In view of the amendment of the specification and claims to meet the objections—and it is immaterial whether those objections were proper or not—of the Patent Office, the patentee cannot now be heard to assert that the amendment was immaterial nor to insist upon a construction of his claims which would cover a method of making his device which he was required to abandon or disclaim for the purpose of obtaining favorable action on his application. It is too late now to assert that he was entitled to his original claims, or that the claims as finally allowed are as broad as the original claims. (Sutter *v.* Robinson, 119 U. S. 530, 7 Sup. Ct. 376; Shepard *v.* Carrigan, 116 U. S. 593, 6 Sup. Ct. 493; Rubber Co. *v.* Tire Co., 28 U. S App. 470, 515–517, 16 C. C. A., 632, 70 Fed. Rep. 58, and cases there cited.) (C. C. A., 8th Cir. Nov. 28, 1898.)

THAYER, J.] *Brill *v.* St. Louis Car Co. *et al.*, 90 Fed. Rep. 666.

3. Acquiescence in a Patent Office rejection and amendment of claims and specification amounts to a disclaimer by the patentee of matter eliminated by such amendment. (C. C., E. D. Mo. E. D. Feb. 7, 1899.)

ADAMS, J.] *Michaelis *et al. v.* Larkin *et al.*, 91 Fed. Rep. 778.

4. Where a patent is entitled to a broad construction, an amendment of the specification during the pendency of the

application in the Patent Office, by striking out a reference to certain well-known mechanical equivalents for reversing motion, is immaterial, and does not exclude the application of the doctrine of equivalents, which doctrine is so effective that under ordinary circumstances it supersedes the usual rule of interpretation,—*Expressio unius est exclusio alterius.* (C. C. A., 1st Cir. Jan. 30, 1899.)

BROWN, J.] *Heap *v.* Greene, *et al.*, 91 Fed. Rep. 792.

5. Where the Patent Office rejects a claim covering a certain device, on its merits, and such rejection is acquiesced in, and the patent issues, the patentee cannot afterwards be allowed a construction of the other allowed claims broad enough to cover the claim which was rejected. (C. C. A., 6th Cir. May 2, 1899.)

LURTON, J.] *Bundy M'f'g Co. *v.* Detroit Time-Register Co., 94 Fed. Rep. 524.

6. To be estopped by the action of the Patent Office, the patentee must be shown to have surrendered something which he now claims in order to obtain that which was allowed.

** Id.*

7. The estoppel which arises when claims are limited by amendment to meet the rulings of the Patent Office, is in the nature of estoppel by contract, not equitable estoppel or estoppel in pais, and its scope in a particular case, like the meaning of a contract, is a matter of interpretation and construction of the terms used according to their fair meaning. (C. C. A., 7th Cir. Oct. 3, 1899.)

WOODS, J.] *Magic Light Co. *v.* Economy Gas-Lamp Co., 97 Fed. Rep. 87.

V. CLAIMS.

(*e*) *Limited by their Terms.*

The law requires the applicant for a patent to make specific claim or claims defining his invention for the information of the public, and when so made and granted it cannot be enlarged in his interest beyond the plain import of its terms. When necessary to its understanding, the specification and drawings, if any, may be resorted to. The claim may also be limited by the specification when such is the necessary effect of its recitals and its true meaning ascertained from the context. (Tilghman *v.*

Proctor, 19 O. G. 859; 102 U. S. 707, 721, 728; Howe Machine Co. *v.* National Needle Co., 51 O. G. 475; 134 U. S. 388, 394; White *v.* Dunbar, 37 O. G. 1002; 119 U. S. 47, 51; McLain *v.* Ortmayer, 57 O. G. 1129; 141 U. S. 419, 425; Celluloid Mfg. Co. *v.* Arlington Mfg. Co., C. D. 1893, 483, 488; 64 O. G. 1263.) (C. A. D. C. May 4, 1899.)

SHEPARD, J.] *Reute *v.* Elwell, 87 O. G. 2119.

V. CLAIMS.

(*f*) "*Substantially as Described*," *etc.*

1. The words "herein described" are more positive in their effect than the ordinary expression, "substantially as described" or "substantially as set forth;" and even these latter expressions have, in many cases, been held to limit a claim, and sometimes to save it. (C. C., D. Me. July 30, 1898.)

PUTNAM, J.] *Simonds Rolling Mach. Co. *v.* Hathorn Mfg. Co., 90 Fed. Rep. 201.

2. The "yoke-shaped axle-box pedestals, C," referred to in the claim are the pedestals which, in every instance, are described in the specification as extending below the axle-boxes. The words "substantially as set forth," with which the claim concludes, refer to the specification, and make the description of the housings therein contained an essential part of the claim. "General language in a claim which points to an element or device more fully described in the specification is limited to such an element or device as is there described." (Adams Elec. Ry. Co. *v.* Lindell Ry. Co., 40 U. S. App. 482, 512, 23 C. C. A. 223, 77 Fed. Rep. 432–439; Mitchell *v.* Tilghman, 19 Wall. 287; Sterratt *v* Mfg. Co., 27 U. S. App. 13, 47, 10 C. C. A. 216, 61 Fed. Rep. 980.) (C. C. A., 8th Cir. Nov. 28, 1898.)

THAYER, J.] *Brill *v.* St. Louis Car Co. *et al.*, 90 Fed. Rep. 666.

3. The words "substantially as specified" have been uniformly held to import into the claim the particulars of the specification and the court is not at liberty to disregard what the patentee terms one of the most important features of his invention without unduly extending the claim. (C. C., D. Mass. Feb. 24, 1899.)

BROWN, J.] *Parsons *v.* Seelye, 92 Fed. Rep. 1005.

4. Express phraseology, commencing with the closing words of the claim (substantially as and for the purpose set forth) connected through the specifications, with the drawings is as effectual as though everything contained in the specification and drawing were set out in the claims. On the general and natural rules of construction it is impossible to reject what is expressly inserted, and clear language must prevail over doubts incidentally raised. (C. C., D. Me. Mar. 22, 1899.)

PUTNAM, J.] *Adams & Westlake Co. *et al.* *v.* E. T. Burrowes Co., 93 Fed. Rep. 462.

5. If a claim of a patent contain the phrase "substantially as described" or its equivalent, the entire specification is entitled to be considered in connection with the claim. (C. C., N. D. Cal. May 22, 1899.)

MORROW, J.] *Fruit Cleaning Co. *v.* Fresno Home-Packing Co. *et al.*, 94 Fed. Rep. 845.

VI. CORRECTION OF.

(*a*) *By Certificate of Correction.*

1. As certificates of correction are granted by the office only for the purpose of correcting a discrepency between the patent as printed and the record, *Held*, that no mistake was made in omitting the place of incorporation of a company which appears as assignee of record and to which the patent was granted, and a petition requesting a certificate of correction stating that the patent should have been issued to said company, "a corporation organized under the laws of the state of New Jersey," denied, as the uniform practice of the office had been followed. (Apr. 4, 1899.)

DUELL, C.] *In re* Lamson Consolidated Stove Service Co., 66 MS. Dec. 437.

2. Where the examiner had criticised one of the claims of an applicant, and in view of such criticism applicant had amended the claim to read as it appeared in the patent, *Held*, that a reissue could not be granted at the expense of the Office, and a certificate of correction could not be granted because the patent as printed corresponded to the records of the Office, and certifi-

cates of correction are granted only to correct an error made by the Office. (Sept. 15, 1899.)

DUELL, C.] *In re* Moses S. Okun, 67 MS. Dec. 429.

3. It is the practice of the Office to issue certificates of correction only for the purpose of making the patent as issued correspond to the record of the case and not for the purpose of correcting mistakes of an applicant. (Apr. 10, 1899.)

DUELL, C.] *Ex parte* Burson, 87 O. G. 698.

4. Where the Office in amending a claim literally followed the directions given by an applicant, *Held*, if there is any mistake or ambiguity in the claim it cannot be said that such mistake was incurred through the fault of the Office, and certificate of correction should be refused. *Id.*

5. Where the Office did not notify the interested parties that the request to issue a patent to an alleged assignee would not be granted, because the Office did not consider the instruments as conveying such interest as would authorize the issuing of the patent as requested, *Held*, that this is not sufficient ground to warrant the issue of a certificate of correction, as the parties are presumed to know the rules and practice of the Office. (Oct. 5, 1899.)

DUELL, C.] *Ex parte* Rosback, 89 O. G. 705.

6. Certificates of correction of patents are issued only for the purpose of making the patent when issued correspond to the records of the Office. *Id.*

VI. CORRECTION OF.

(b) By Reissue.

1. If by reason of inadvertence or mistake in the drawings or specification, a patent is rendered in part inoperative, and the patentee promptly applies for a reissue, and no substantial rights are affected, or fraudulent intent charged, the Commissioner has the right under § 4916 R. S. to cause a new patent to issue, and under such circumstances his decision is conclusive. (C. C. A., 1st Cir. Feb. 13, 1899.)

COLT, J.] *Beach *v.* Hobbs *et al.* Hobbs *et al. v.* Beach, 92 Fed. Rep. 146; 87 O. G. 1961.

2. Where a reissue was granted to correct the error of a single

word in the specification (by changing "hole" to "slot"), and a corresponding modification was made in a single feature of one of the eleven figures illustrating the patent, the error having been caused by oversight and being in no way connected with the gist of the invention, though its adoption rendered the machine inoperative (no change was made or needed in the claim), *Held*, that if the patentee made a meritorious invention, he ought not to lose the benefit of it by reason of a defect so narrow and technical. (C. C. A., 1st Cir. Mar. 13, 1899.)

LOWELL, J.] *Hart & Hageman Mfg. Co. *v.* Anchor Electric Co. *et al.*, 92 Fed. Rep. 657.

VII. LIMITATION OF, BY FOREIGN PATENT.

1. Where a French patent was granted for a term of fifteen years before the date of application for the United States patent for the same invention and the French patent was in full force at that date, but lapsed for the non-payment of annuity before the United States patent issued, *Held*, that there was no bar to the issue of the United States patent under section 4887, Revised Statutes. (C. C. A., 2d Cir. Apr. 4, 1899.)

SHIPMAN, J.] *Welsbach Light Co. *v.* Apollo Incandescent Gaslight Co., *et al.*, 87 O. G., 1784; 96 Fed. Rep. 332.

2. When a foreign patent is allowed to lapse by reason of non-compliance with some statutory provision before application is made in the United States, the grant of a patent in the United States is not prohibited by section 4887 of the Revised Statutes, but such patent is invalid under a different section on the ground of abandonment of the invention before the application was filed. **Id.*

3. "To expire at the same time" in section 4887, Revised Statutes, should be taken to mean that the United States patent expires at the end of the term prescribed in the previous foreign patent without regard to mishaps occurring after the application was filed in this country, since the applicant was at that time entitled to his patent and could then have obtained it if the Office could have been more prompt. **Id.*

VIII. Reissue.

Where, 12 years after the grant of a patent, it was held to be invalid and was subsequently reissued, and in the meantime and prior to the adjudication and reissue, other patents had been granted for devices which are covered by the reissue claims, which devices have been in extensive public use, *Held*, that in view of the intervening private and public rights which have sprung up and the unreasonable delay in applying for the reissue, the said reissue must be held to be invalid. (C. C. A., 3d Cir. Dec. 31, 1898.)

Acheson, J.] *Horn & Brannen Mfg. Co. *v.* Pelzer, 91 Fed. Rep. 665.

(Butler, J,. dissented on the ground that the decision in Maitland *v.* Mfg. Co., 29 C. C. A. 607, 86 Fed. Rep. 124, 85 O. G. 776. Sand. Pat. Dig. 1898, 129, by this Circuit Court of Appeals for the second circuit should control, inasmuch as the proofs were the same in both cases, and the defendant in the present case was associated in the other case.)

IX. Valid and Infringed.

1. The Simonds patents No. 319,754, granted June 9, 1885, for improvements in faces for car-axle dies, and No. 419,292, granted Jan. 14, 1890, for a method of making rolled-metal forgings that are circular in cross-sectional area, *Held*, valid and infringed. (C. C., D. Me. July 30, 1898.)

Putnam, J.] *Simonds Rolling Mach. Co. *v.* Hathorn Mfg. Co. *et al.*, 90 Fed. Rep. 201.

2. Patent No. 398,158, Feb. 19, 1889, to T. B. Jeffery, for improvements in velocipedes, *Held*, valid and infringed. (C. C., S. D. N. Y. Nov. 15, 1898.)

Coxe, J.] *Gormully & Jeffery Mfg. Co. *v.* Stanley Cycle Mfg. Co. *et al.*, 90 Fed. Rep. 279.

3. Patent No. 309,727, Dec. 23, 1884, to T. F. Morrin and W. W. Scott, for improvements in steam generators, *Held*, valid, not anticipated, and infringed as to claim 2.

Patent No. 463,307, Nov. 17, 1891, to T. F. Morrin for improvements in steam generators, *Held*, valid, not anticipated, and infringed as to claims 1 and 2.

Patent No. 463,308, Nov. 17, 1891, to T. F. Morrin, for improvements in sectional casings for steam generators, *Held*, valid, not anticipated and infringed. (C. C., E. D. N. Y. Oct. 6, 1898.)

THOMAS, J.] *Morrin *v.* Lawler. Same *et al.* Edison Electric Illuminating Co. of Brooklyn, 90 Fed. Rep. 285.

4. On the authority of Wilgus *v.* Germain *et al.*, 44 U. S. App.; 19 C. C. A. 188; 72 Fed. Rep. 773, that patent to Wilgus, No. 443,734, Dec. 30, 1890, for "improvements in lawn sprinklers," was a mere adaptation of the device of the patent to Gauthier, No. 386,121, July 7, 1888, *Held*, that articles made in conformity with said Wilgus patent are substantial copies of the device of, and infringe said Gauthier patent. (C. C., S. D. Cal., Nov. 21, 1898.)

ROSS, J.] *Newton Mfg. Co. *v.* Wilgus, 90 Fed. Rep. 483.

5. The patent to Brahn No. 248,990, Nov. 1, 1881, for an improvement in railway switches (though not of the highest order, yet was new and useful and involved invention), *Held*, valid and infringed by the switch bar made under patent No. 308,373. (C. C. A., 3d Cir. Nov. 28, 1898.)

ACHESON, J.] *Pennsylvania Steel Co., *et al. v.* Vermilya, 90 Fed. Rep. 493.

6. The patent to King No. 397,296, Feb. 5, 1899, for an improvement in compounds to restrain the setting of plaster, *Held* valid, not anticipated and infringed. (C. C., S. D. N. Y. Dec. 5, 1898.)

COXE, J.] *King *et al. v.* Anderson *et al.*, 90 Fed. Rep. 500.

7. The patent to Tower No. 378,223, Feb. 21, 1888, for a pen-holder with a cork sleeve, *Held* valid, and infringed. (C. C., S. D. N. Y. Nov. 19, 1898.)

WHEELER, J.] *Tower *v.* Eagle Pencil Co., 90 Fed. Rep. 663.

8. The patent to Hayes No. 310,276, Jan. 6, 1885, for an improvement in ranges and stoves. *Held* valid not anticipated and infringed. (C. C. A., 3d Cir. Nov. 28, 1898.)

ACHESON, J.] *Thomas Roberts Stevenson Co. *v.* McFassel, 90 Fed. Rep. 707.

9. The patent to Bisler No. 525,941, Sept. 11, 1894, for an apparatus for playing duplicate whist. *Held*, valid and infringed as to claims 1, 2 and 4. (C. C., S. D. N. Y. Nov. 23, 1898.)

WHEELER, J.] *United States Playing-Card Co. *v.* Spalding *et al.*, 90 Fed. Rep. 729.

10. The patent to Bell & Tainter, No. 341,214, May 14, 1886, for an improvement in recording and reproducing speech. *Held*, valid and infringed as to claim 21, on motion for preliminary injunction. (C. C., S. D. N. Y. Dec. 10, 1898.)

LACOMBE, J.] *American Graphophone Co. *v.* National Gramophone Co. *et al.*, 90 Fed. Rep. 824.

11. The patent to Condict, No. 393,323, Dec. 4, 1888, for an improvement in switches for electric motors, *Held* valid, not anticipated and infringed as to claims 20, 21, 22, 27, 28, 29 and 31, on appeal from an order directing a preliminary injunction. (C. C. A., 2d Cir. Dec. 7, 1898.)

SHIPMAN, J.] *Electric Car Co. of America *et al. v.* Nassau Electric R. Co., 91 Fed. Rep. 142.

12. The patent to Melvin, No. 412,279, Oct. 8, 1889, for a process of manufacturing linoleum floor-cloth, *Held*, to disclose a patentable invention, valid, not anticipated and infringed. (C. C., E. D. Penn. Jan. 12, 1899.)

DALLAS, J.] *Melvin *et al. v.* Thomas Potter, Sons & Co., 91 Fed. Rep. 151.

13. The design patented to Hill, No. 27,272, June 29, 1897, for a design for a furniture support, *Held* valid on demurrer. (C. C., D. Mass. Dec. 5, 1898.)

BROWN, J.] *Chandler Adjustable Chair & Desk Co. *v.* Heywood Bros. & Wakefield Co., 91 Fed. Rep. 163.

14. The patent to Bowers, No. 318,859, May 26, 1885, for a dredging machine as to claims 9, 10, 11, 12, 16, 22, 25, 53, 54, 59 and 87; No. 318,860, May 26, 1885, for the art of dredging, as to claims 3 and 5, and No. 372,956, Nov. 8, 1887, for an excavator, as to claims 1, 12, 13 and 15, *Held* valid, not anticipated and infringed. (C. C., N. D. Cal. Dec. 12, 1898.)

MORROW, J.] *Bowers *v.* San Francisco Bridge Co., 91 Fed. Rep. 381.

15. The Hochstedt *et al.* patents, No. 352,869, Nov. 16, 1886, and No. 354,060, Dec. 7, 1886, and the Rettig patent, No. 354,935, Dec. 28, 1886, all for improvements in type-casting machines, *Held* valid, not anticipated by the patent to Mason, No. 187,880, Feb. 27, 1877, and infringed. (C. C., S. D. N. Y., Dec. 16, 1898.)

WHEELER, J.] *Nelson *et al.* *v.* Farmer Type-Founding Co. *et al.*, 91 Fed. Rep. 418.

16. The patent to Hyatt, No. 293,740, Feb. 14, 1884, for an improvement in the art of filtration of water, *Held* valid, and infringed on motion for preliminary injunction in each case. (C. C., S. D. N. Y. Feb. 26, 1898.) 1st case. (C. C., E. D. Mo. E. D. Dec. 27, 1898.) 2d case.

LACOMBE, J.] *New York Filter Mfg. Co. *v.* Loomis-Manning Filter Co., 91 Fed. Rep. 421.

ADAMS, J.] *New York Filter Mfg. Co. *v.* Jackson, 91 Fed. Rep. 422.

17. The patent to Warner, No. 565,867, Aug. 11, 1896, for a cut-out for electric motors, *Held*, valid, not anticipated and infringed as to claims 1, 2 and 3. (C. C., E. D. Wis. July 5, 1898.)

SEAMAN, J.] *Western Electric Co. *v.* American Rheostat Co. *et al.*, 91 Fed. Rep. 650.

18. The patent to Huntington, No. 277,134, May 8, 1883, for a stone and ore-crushing machine, *Held*, valid as to claim 1 and infringed on motion for preliminary injunction. (C. C., S. D. N. Y. Jan. 23, 1899.)

LACOMBE, J.] *Huntington Dry Pulverizer Co. *v.* Newell Universal Mill Co., 91 Fed. Rep. 661.

19. The patent to Bernard, No. 427,220, May 6, 1890, for an improvement in pliers, *Held*, valid and infringed as to claim 1, but not infringed as to claim 2. (C. C. A., 2d Cir. Jan. 2, 1899.)

SHIPMAN, J.] *Bridgeport Mfg. Co. *et al.* *v.* William Schollhorn Co., 91 Fed. Rep. 775.

20. The patent to Anderson, No. 250,700, Dec. 31, 1881, and the patent to McNutt, No. 378,934, Mar. 6, 1888, both for ma-

chines for pointing skewers, construed and *Held*, valid, the former as to claim 1, and the latter as to claim 3. (C. C., E. D. Penn. Jan. 24, 1899.)

DALLAS, J.] *American Skewer Co. *v.* Helms, 91 Fed. Rep. 784.

21. The patent to Sprague, No. 324,892, Aug. 25, 1885, for an electric railway motor, *Held*, valid and infringed as to claims 2 and 4. (C. C., E. D. N. Y. Jan, 24, 1899.)

LACOMBE, J.] *Sprague Electric Ry. and Motor Co. *v.* Nassau Electric Ry. Co., 91 Fed. Rep. 786.

22. The patent to McEwan *et al.*, No. 492,937, Mar. 7, 1893, for an improvement in paper-board, construed and *Held*, valid and infringed. (C. C., D. N. Jer. Feb. 13, 1899.)

BRADFORD, J.] *McEwan Bros. Co. *v.* McEwan *et al.* 91 Fed. Rep. 787.

23. The patent to Grosselin, No. 377,151, Jan. 31, 1888, for a cloth-napping machine, *Held*, valid and infringed. (C. C. A., 1st Cir. Jan. 30, 1899.)

BROWN, J. *Heap *v.* Greene *et al.*, 91 Fed. Rep. 792.

24. The patent to Elliott, No. 350,727, Oct. 12, 1886, for a folding paper, *Held*, valid, not anticipated and infringed. (C. C., E. D. N. Y. Dec. 9, 1898.)

THOMAS, J.] *Whitney *v.* Gair, 91 Fed. Rep. 905.

25. The patent to Grant, No. 554,675, Feb. 18, 1896, for a rubber tired wheel, *Held*, valid, not anticipated and infringed. (C. C., S. D. N. Y. Dec. 27, 1898.)

THOMAS, J.] *Rubber Tire Wheel Co. *v.* Columbia Pneumatic Wagon Wheel Co., 91 Fed. Rep. 978.

26. The reissue patented to Beach, No. 11,167, May 26, 1891 (original No. 447,225, Feb. 24, 1891), for an improvement in machines for attaching stays to the corners of boxes, *Held* to be for a broad invention and entitled to cover known equivalents at the date of the patent and infringed as to claims 1, 2 and 3. (C. C. A., 1st Cir. Feb. 13, 1899.)

COLT, J.] *Beach *v.* Hobbs *et al.* Hobbs *et al. v.* Beach, 92 Fed. Rep. 146.

27. The reissue patent to Earl, No. 11,324, Apr. 18, 1893, (original, No. 465,615, Dec. 22, 1891), for a ventilator and combined ventilator and refrigerator car, construed and *Held*, not invalid because of any expansion over the original patent, and infringed by a car made according to patent to Kerby, No. 537,293, Apr. 9, 1895. (C. C. A., 9th Cir. Oct. 24, 1897.)

De Haven, J.] *Graham *v.* Earl, 82 Fed. Rep. 737; 92 Fed. Rep. 155.

28. The patent to Janney, No. 254,093, Feb. 21, 1882, for an improvement in car couplers, *Held*, valid, not anticipated and infringed. (C. C., E. D. Mo., E. D. Feb. 14, 1899.)

Adams, J.] *McConway & Torley Co. *v.* Shickle, Harrison & Howard Iron Co., 92 Fed. Rep. 162.

29. The patent to Barley, No. 256,619, Apr. 19, 1882, for improvements in harrows, *Held*, valid and infringed. (C. C., N. D. N. Y. Jan. 3, 1899.)

Coxe, J.] *Deere *et al.* *v.* Arnold, 92 Fed. Rep. 186.

30. The patent to Rood and Vaughan, No. 383,918, June 5, 1888, for improvements in machines for shaving hides or skins covers a meritorious invention, and the claims should be so construed as to adequately protect the invention, and *Held*, valid and infringed. (C. C., E. D. Penn. Mar. 6, 1899.)

Dallas, J.] *Rood *et al.* *v.* Evans *et al.*, 92 Fed. Rep. 371.

31. The patent to Schierholz, No. 538,884, May 7, 1895, for an ore crusher, *Held*, to be for a pioneer invention, and therefore entitled to a broad range of equivalents and infringed. (C. C., N. D. Col. Jan. 23, 1899.)

Morrow, J.] *Risdon Iron & Locomotive Wks. *v.* Trent, 92 Fed. Rep. 375.

32. The patent to Cutcheon, No. 384,893, June 19, 1888, for improvements in machines for beating out the soles of boots and shoes, *Held*, valid, not anticipated and infringed. (C. C., D. Mass. Feb. 9, 1899.)

Colt, J.] *Tripp Giant Leveller Co. *v.* Bresnahan *et al.*, 92 Fed. Rep. 391.

33. The reissue patent to Hart, No. 11,395 (original No. 459,706), Dec. 12, 1893, for electric snap switches, *Held*, valid,

not anticipated and infringed by the switches made in accordance with the patent to Marshall, No. 547,149, Oct. 1, 1895. (C. C. A., 1st Cir. Mar. 13, 1899.)

LOWELL, J.] *Hart & Hegeman Mfg. Co. *v.* Anchor Electric Co. *et al.*, 92 Fed. Rep. 657.

34. The patent to Chambers, No. 297,671, Apr. 29, 1884, for improvements in brick machines, *Held*, valid as to claim 24 and infringed. (C. C. A., 6th Cir. Mar. 7, 1899.)

TAFT, J.] *Penfield *v.* Chambers Bros. Co., 92 Fed. Rep. 630.

35. The patent to Palmer, No. 308,981, Dec. 9, 1884, for a machine for sewing and quilting fabrics, *Held*, valid as to claims 9, 10, 14, 16, 18, 22 and 24, and infringed. (C. C. A., 1st Cir. Mar. 16, 1899.)

BROWN, J.] *Palmer *et al. v.* John E. Brown Mfg. Co., 92 Fed. Rep. 925.

36. The patent to Willcox & Borton, No. 472,094, Apr. 5, 1892, for machines for making overseams in sewing knit goods, construed and *Held*, valid and infringed as to claims 2 and 5. (C. C. A., 2d Cir. Mar. 1, 1899.)

LACOMBE, J.] *Willcox & Gibbs Sewing Mach. Co. *v.* Merrow Mach. Co. *et al.*, 93 Fed. Rep. 215.

37. The patent to Crissen, No. 513,307, Jan. 23, 1894, for window or curtain fixtures, *Held*, valid and infringed as to all of the claims. (C. C., D. Me. Mar. 22, 1899.)

PUTNAM, J.] *Adams & Westlake Co. *et al. v.* E. T. Burrowes Co., 93 Fed. Rep. 462.

38. The patent to Moore, No. 524,502, Aug. 14, 1894, for improvements in hoisting and conveying apparatus employed in digging sewer trenches, construed and *Held*, to disclose patentable invention and infringed. (C. C., N. D. N. Y. Apr. 12, 1899.)

COXE, J.] *Moore *v.* Marnell, 93 Fed. Rep. 467.

39. The patent to Corser, No. 372,062, Oct. 25, 1887, for combined metallic buckle and button holder. *Held*, valid and infringed. (C. C., D. Ver. Apr. 1, 1899.)

WHEELER, J.] *Corser *v.* Brattleboro Overall Co., 93 Fed. Rep. 807.

40. The patent to Woodward, No. 354,499, Dec. 14, 1886, for an improvement in sewing machines, construed, *Held*, valid and infringed as to claims 4 and 6. (C. C., D. Me. Jan. 24, 1899.)

PUTNAM, J.] *Pentucket Variable Stitching-Mach. Co. *v.* Jones Special Mach. Co., 93 Fed. Rep. 669.

41. The patent to Jensen, No. 281,767, July 24, 1883, for a can-filling machine, *Held*, infringed, on motion for preliminary injunction. (C. C., N. D. Cal. Mar. 16, 1899.)

MORROW, J.] *Alaska Packers' Ass'n *v.* Pacific Steam Whaling Co. *et al.*, 93 Fed. Rep. 672.

42. The patents to Schultz, Nos. 291,784 and 291,785, Jan. 8, 1884, for a process of tawing hides and skins, known as "chrome tanning," *Held*, valid, not anticipated and infringed. (C. C., D. Mass. Apr. 7, 1899.)

COLT, J.] *Tannage Patent Co. *v.* Donallan, 93 Fed. Rep, 811.

43. The patent to Thompson, No. 310,966, Jan. 20, 1885, for a roller-coasting structure, construed and *Held*, valid and infringed as to claim 1. (C. C. A., 3d Cir. May 1, 1899.)

ACHESON, J. *Thompson *v.* Third Avenue Traction Co. *et al.*, 93 Fed. Rep. 824.

44. The patent to Hyatt, No. 293,740, Feb. 14, 1884, for an improvement in the art of filtering water, *Held*, infringed, on motion for preliminary injunction. (C. C., E. D. Mo. E. D. Apr. 20, 1899.)

ADAMS, J.] *New York Filter Mfg. Co. *v.* Chemical Bldg. Co., 93 Fed. Rep. 827.

45. The patent to Simonds, No. 319,754, June 9, 1885, for improvements in dies for forging articles circular in cross-section, *Held*, valid, not anticipated and infringed. (C. C. A., 1st Cir. Apr. 25, 1899.)

COLT, J.] *Simonds Rolling-Mach. Co. *v.* Hathorn Mfg. Co. *et al.* Hathorn Mfg. Co. *et al. v.* Simonds Rolling-Machine Co., 93 Fed. Rep. 958.

46. The patent to Simonds, No. 419,292, Jan. 14, 1890, for

a method of making rolled-metal forgings that are circular in cross-sectional area, *Held*, valid, not anticipated and infringed. **Id.*

47. The patents to Barrett, Nos. 455,993, July 11, 1891, and 527,102, Oct. 9, 1894, for lifting jacks, *Held*, valid and infringed, the former as to claims 1 and 6, and the latter as to claim 19; on motion for preliminary injunction. (C. C., W. D. Mich. Aug. 3, 1898.)

SEVERENS, J.] *Duff Mfg. Co. *v.* Kalamazoo R. R. Velocipede & Car Co., 94 Fed. Rep. 154.

48. The patent to Julius, No. 524,254, Aug. 7, 1894, for improvements in the manufacture of blue coloring matter, *Held*, valid and infringed. (C. C., S. D. N. Y. May 9, 1899.)

COXE, J.] *Badische Analin & Soda Fabrik *v.* Kalle *et al.*, 94 Fed. Rep. 163.

49. The patent to Disbrow and Payne, No. 490,105, Jan. 17, 1893, for a combined churn and butter worker, being the first to combine the double function in a satisfactory manner, is entitled to the liberal construction accorded to pioneer inventions and *Held*, valid and infringed. (C. C., D. Minn. Feb. 1, 1899.)

LOCHREN, J.] *Owatonna Mfg. Co. *v.* F. B. Fargo & Co., 94 Fed. Rep. 519.

50. The patent to Bundy, No. 452,894, May 26, 1891, for a workman's time recorder, construed broadly and *Held*, valid and infringed as to claims 3 and 4 by the time recorder made under the patent to Watson, No. 515,805, Mar. 6, 1894. (C. C. A., 6th Cir. May 2, 1899.)

LURTON, J.] *Bundy Mfg. Co. *v.* Detroit Time Register Co., 94 Fed. Rep. 524.

51. The patent to La Due, No. 543,834, July 30, 1895, for a fruit-seeding machine, construed and *Held*, valid, not anticipated and infringed as to claims 1, 2, 3, 4 and 5 by a machine made under the patent to Cox, No. 608,108, July 26, 1898, but not infringed as to claims 6, 7 and 8. (C. C., N. D. Cal. May 22, 1899.)

MORROW, J.] *Fruit Cleaning Co. *v.* Fresno Home Packing Co. *et al.*, 94 Fed. Rep., 845.

52. The patent to Smith, No. 522,435, July 3, 1894, for improvements in spring-tooth harrow, construed and *Held*, valid and infringed as to claims 1 and 2. (C. C., E. D. Penn. May 26, 1899.)

DALLAS, J.] *Smith *et al. v.* Ulrich, 94 Fed. Rep. 865.

53. The patent to Tesla, No. 511,559, Dec. 26, 1893, for improvements in electrical transmission of power is not void on its face, as covering a mode of operation involving only the function of a machine or apparatus, but is for a new method of producing an electrical result, and the new method is carried out or produced by the use of apparatus. (C. C., S. D. N. Y. May 17, 1899.)

SHIPMAN, J.] *Westinghouse Electric & Mfg. Co. *v.* Catskill Illuminating & Power Co., 94 Fed. Rep. 868.

54. The patent to Rawson *et al.*, No. 407,963, July 30, 1889, for improvements in incandescent mantles for gaslights, in view of prior adjudication, *Held*, valid and infringed on motion for preliminary injunction. (C. C., S. D. N. Y. Apr. 23, 1898.) (Injunction dissolved, see *supra* p. 123.)

LACOMBE, J.] *Welsbach Light Co. *v.* Rex Incandescent Light Co., 94 Fed. Rep. 1004.

55. The patent to Rawson, No. 407,963, July 30, 1889, for improvements in incandescent mantles for gaslights, *Held*, not anticipated by the French patent to Welsbach, No. 172,064, Nov. 4, 1885, nor the English patent to Welsbach, No. 15,266, Dec. 12, 1885, and valid and infringed, on motion for preliminary injunction. (C. C., S. D. N. Y. May 26, 1899.)

LACOMBE, J.] *Welsbach Light Co. *v.* Rex Incandescent Light Co., 94 Fed. Rep. 1006.

56. The patent to Rittig, No. 354,935, Dec. 28, 1886, for improvements in moulds for casting type, *Held*, not anticipated, valid and infringed as to claims 6 and 7, but void as to claims 4 and 5. (C. C. A., 2d Cir. May 25, 1899.)

SHIPMAN, J.] *Nelson *et al. v.* A. D. Farmer & Son Type Foundry Co. *et al.*, 95 Fed. Rep. 145.

57. The Hochstadt *et al.* patents, Nos. 352,869, Nov. 16, 1886, and 354,060, Dec. 7, 1886, for improvements in moulds for casting type, *Held*, not anticipated, valid and infringed, the former as to claims 1, 3 and 4, the latter as to claims 1, 2, 3 and 4. Claim 6, however, of the former patent is invalid for want of invention. *Id.*

58. The patent to Mead, No. 325,430, Sept. 1, 1885, for improvements in buttons, *Held*, infringed by the device of the patent to Pringle, No. 600,114, on motion for a preliminary injunction. (C. C., N. D. N. Y. June 14, 1899.)

COXE, J.] *Consolidated Fastener Co. *v.* Hays *et al.*, 95 Fed. Rep. 168.

59. The patent to Barley, No. 265,619, Apr. 19, 1882, for improvements in harrows, *Held*, not anticipated as to the 5th claim by the patent to Wiard & Bullock, No. 229,217, June 22, 1880. (C. C., N. D. N. Y. June 14, 1899.)

COXE, J.] *Deere *et al.* *v.* Arnold, 95 Fed. Rep. 169.

60. The patent to Stanley, No. 323,372, July 28, 1885, for a process for manufacturing carbon conductors for incandescent lamps, *Held*, valid and infringed. (C. C., D. N. J. July 14, 1899.)

KIRKPATRICK, J.] *Westinghouse Electric & Mfg. Co. *v.* Beacon Lamp Co. *et al.* 95 Fed. Rep. 462.

61. The patent to Sutton, No. 383,258, May 22, 1888, for a machine for removing hairs from fur skins construed and *Held*, valid as to claim 8, and infringed by the device of the patent to Jenik No. 557,129, of 1896. (C. C., S. D. N. Y. June 13, 1899.)

TOWNSEND, J.] *Cimiotti Unhairing Co. *et al.* *v.* Bowsky, 95 Fed. Rep. 474.

62. The patent to Palmer, No. 251,630, Dec. 27, 1881, for a bed or mattress supporting frame, construed, *Held*, valid, not anticipated, and infringed. (C. C., D. N. Jer.)

KIRKPATRICK, J.] *Ryan *v.* Newark Spring Mattress Co., 96 Fed. Rep. 100.

63. The patent to Miehle, No. 317,663, May 12, 1885, for

improvements in printing machines, construed and *Held*, valid, not anticipated and infringed. (C. C., N. D. Ill. N. D. July 27, 1899.)

KOHLSAAT, J.] *Miehle Printing-Press & Mfg. Co. *v.* Campbell Printing-Press & Mfg. Co., 96 Fed. Rep. 226.

64. The patent to Perkins, No. 560,599, May 19, 1896, for an apparatus for repairing asphalt pavements, *Held*, valid and infringed. (C. C., N. D. Ill. N. D. June 27, 1899.)

KOHLSAAT, J.] *United States Repair & Guarantee Co. *v.* Assyrian Asphalt Co. *et al.*, 96 Fed. Rep. 235.

65. The patent to Fowler, No. 328,019, Oct. 13, 1885, for an improvement in metal cutting saws, construed and *Held*, valid and infringed. (C. C. A., 2d Cir. May 25, 1899.)

LACOMBE, J.] *Thompson *et al.* *v.* N. T. Bushnell Co., 96 Fed. Rep. 238.

66. The patent to Rawson, No. 407,963, July 30, 1889, for improvements in mantles for incandescent gas lamps, *Held*, not void because of lapse, for failure to pay an annuity of a prior French patent for the same invention, pending the application for the U. S. patent. (C. C. A., 2d Cir. Apr. 4, 1899.)

SHIPMAN, J.] *Welsbach Light Co. *v.* Apollo Incandescent Gaslight Co. *et al.*, 87 O. G. 1784. 96 Fed. Rep. 332.

67. The patent to Swett, No. 314,204, Mar. 17, 1885, for a staple fastener for wooden vessels, construed, *Held*, valid, not anticipated and infringed. (C. C., S. D. N. Y. July 29, 1899.)

TOWNSEND, J.] *Acme Flexible Clasp Co. *v.* Cary Mfg. Co., 96 Fed. Rep. 344.

68. The patent to Parmly, No. 540,800, June 11, 1895, for an electric arc lamp, construed, *Held*, valid, not anticipated and infringed. (C. C., W. D. Penn. May 13, 1899.)

ACHESON, J.] *Elliptical Carbon Co. *v.* Solar Carbon & Mfg. Co. *et al.*, 96 Fed. Rep. 413.

69. The patent to Bywater, No. 374,888, Dec. 13, 1887, for

improvements in knitted fabrics, *Held*, valid, not anticipated and infringed. (C. C., S. D. N. Y. July 31, 1899.)

TOWNSEND, J.] *Hanifen *v.* Price *et al.*, 96 Fed. Rep. 435.

70. The patent to Low, No. 238,940, Mar. 15, 1881, for improvements in dentistry, *Held*, valid, not anticipated and infringed. (C. C., S. D. N. Y. July 31, 1899.)

TOWNSEND, J.] *International Tooth-Crown Co. *v.* Kyle, 96 Fed. Rep. 442.

71. The patent to Anderson, No. 412,155, Oct. 1, 1889, for an improvement in electric railway contact devices, construed and *Held*, valid as to claim 8, not anticipated and infringed. (C. C., D. N. Jer. Aug 1, 1899.)

KIRKPATRICK, J.] *General Electric Co. *v.* Rahway Electric Light & Power Co., 96 Fed. Rep. 563.

72. The patent to Williames, No. 256,089, Apr. 4, 1882, for an improvement in heating apparatus, construed and *Held*, valid, not anticipated and infringed. (C. C. A., 3d Cir. Oct. 3, 1899.)

BRADFORD, J.] *McNeely *et al. v.* Williames *et al.*, Williames *et al. v.* McNeely *et al.*, 96 Fed. Rep. 978.

73. The patent to Barrett, No. 455,993, July 14, 1891, for an improvement in lifting jacks, construed and *Held*, valid and infringed. (C. C., D. Mass. Oct. 4, 1899.)

PUTNAM, J.] *Duff Mfg. Co. *v.* Norton, 96 Fed. Rep. 986.

74. The patent to Buzzell, No. 317,622, May 12, 1885, for a tool for grinding and polishing the front of boot and shoe heels, *Held*, valid, not anticipated and infringed. (C. C. A., 1st Cir. Sept. 14, 1899.)

COLT, J.] *Reynolds *v.* Buzzell, 96 Fed, Rep. 997.

75. The patent to Marqua, No. 301,908, July 15, 1884, for improvements in sending-traps for flying targets, *Held*, valid and infringed. (C. C., D. N. Jer. Oct. 5, 1899.)

BRADFORD, J.] *Cleveland Target Co. *v.* Empire Target Co. *et al.*, 97 Fed. Rep. 44.

76. The patent to Potts and Potts, 322,393, July 14, 1885,

for a clay disintegrator, construed, *Held*, valid and infringed. (C. C. A., 6th Cir. Oct. 23, 1899.)

TAFT, J.] *C. & A. Potts & Co. *v.* Creager *et al.*, 97 Fed. Rep. 78.

77. The patent to Morrison, No. 428,123, May 20, 1890, for a fence-wire coupling, construed and *Held*, valid and infringed by the device shown in the patent to Gerard & Lawrence, No. 575,641, Jan. 19, 1897. (C. C. A., 6th Cir. Oct. 3, 1899.)

TAFT, J.] *Kisinger-Ison Co. *v.* Bradford Belting Co., 97 Fed. Rep. 505.

X. VALID, BUT NOT INFRINGED.

1. Assuming the patent No. 325,430, granted Sept. 1, 1885, to A. G. Mead, to be valid, yet in view of the limited scope of the patent as defined by the prior art, it is not infringed. (C. C., D. Mass. Oct. 31, 1898.)

COLT, J.] *Consolidated Fastener Co. *v.* Weisner *et al.* Same *v.* Lehr, 90 Fed. Rep. 104.

2. The patent to J. A. Brill, No. 432,115, July 15, 1890, for an improvement in car trucks, construed as to claims 1, 4 and 6, and *Held*, limited to a combination the essential element of which is the "pedestal which extends below the bottom of the axle box," and not infringed. (C. C. A., 8th Cir. Nov. 28, 1898.)

THAYER, J.] *Brill *v.* St. Louis Car Co. *et al.*, 90 Fed. Rep. 666.

3. The patent to Munro, No. 298,879, May 20, 1884, for an improvement in box trimming and covering machines, construed and *Held*, limited to specific forms of mechanism described and claimed and not infringed as to claims 2, 3 and 6. (C. C. A., 2d Cir. Dec. 7, 1898.)

SHIPMAN, J.] *American Box-Mach. Co. *v.* Hughes *et al.*, 91 Fed. Rep. 147.

4. The patent to Entebrouk, No. 230,409, July 27, 1880, for an improvement in breech-loading firearms, construed and *Held*, valid when limited as it is by the proceedings in the Patent Office, and the language of the specification and claim, to the functions of the two essential elements of the claim, and not

infringed by a device which omits one of these elements. (C. C. A., 1st Cir. Dec. 27, 1898.)

COLT, J.] *Lovell *v.* Johnson, 91 Fed. Rep. 160.

5. The patent to Gillet, No. 247,388, Sept. 20, 1881, for improvements in corn-shellers, *Held*, valid, but not infringed. (C. C. A., 7th Cir. Jan. 3, 1899.)

BUNN, J.] *Sandwich Enterprise Co. *et al. v.* Joliet Mfg. Co., 91 Fed. Rep. 254.

6. The patent to Michaelis, No. 322,194, July 14, 1885, for improvements in the manufacture of chloroform and acetic acid, construed and *Held*, valid, but not infringed. (C. C., E. D. Mo. E. D. Feb. 7, 1899.)

ADAMS, J.] *Michaelis *et al. v.* Larkin *et al.*, 91 Fed. Rep. 778.

7. The patent to Hipperling, No. 281,508, June 17, 1883, for an improvement in machines for double-seaming the head and bottom of rectangular shaped tin cans, must in view of the prior art, be confined to the particular form of construction shown, and *Held*, that the 2d and 3d claims are not infringed by a machine made under the patent to Adriance, No. 472,284. (C. C. A., 3d Cir. Jan. 25, 1899.)

DALLAS, J.] *Ginna *et al. v.* Mersereau Mfg. Co., 92 Fed. Rep. 569.

8. The patent to Wardwell, No. 480,157, Apr. 2, 1892, for a machine for winding cops construed, and, *Held*, not infringed. (C. C. A., 2d Cir. Jan. 25, 1899.)

PER CURIAM.] *Universal Winding Co. *v.* Willimantic Linen Co., 92 Fed. Rep. 391.

9. The patent to Chambers, No. 362,204, Mar. 3, 1887, for improvements in brick machines, construed and *Held*, not infringed as to claims 7, 9, 10, 11 and 12. (C. C. A., 6th Cir. Mar. 7, 1899.)

TAFT, J.] *Penfield *v.* Chambers Bros. Co., 92 Fed. Rep. 630.

10. The patents to Green, Nos. 465,407 and 465,432, Dec. 15, 1891, for an electric railway and means of operating the same, if construed to be valid must be confined to specific de-

vices disclosed in them and *Held*, not infringed. (C. C. A., 6th Cir. Mar. 7, 1899.)

TAFT, J.] *Kelly *et al. v.* Springfield Ry. Co. *et al.*, 92 Fed. Rep. 614.

11. The patent to Ewig, No. 408,300, Aug. 6, 1889, for a waist-band fastener for trousers, contains only one novel feature, narrowly construed, and *Held*, not infringed. (C. C., D. Md. Feb. 5, 1899.)

MORRIS, J.] *Blum *et al. v.* Kerngood, 92 Fed. Rep. 992.

12. The patent to Dodge and Philion, No. 260,462, July 4, 1882, for a separable pulley, construed and *Held*, limited to a pulley in which the parts contact at the rim but are separated at the hub, and not infringed by a pulley in which the parts contact at both rim and hub. (C. C. A., 2d Cir. Dec. 7, 1898.)

LACOMBE, J.] *Dodge *et al. v.* Fulton Pulley Co. *et al.*, 92 Fed. Rep. 995.

13. The patent to Warren, No. 589,676, Sept. 7, 1897, for an eye-glass case, *Held*, valid, but not infringed. Warren *v.* Casey *et al.*, 91 Fed. Rep. 953, reversed as to decree of invalidity. (C. C. A., 3d Cir. May 1, 1899.)

KIRKPATRICK, J.] *Warren *v.* Casey *et al.*, 93 Fed. Rep. 663.

14. The patent to Gail, No. 399,867, Mar. 19, 1899, for an improvement in woven-wire mattresses and bed-bottoms, construed and *Held*, limited by the prior art to the specific form shown, and not infringed. (C. C. A., 3d Cir. May 4, 1899.)

ACHESON, J.] *Ryan *v.* Runyon *et al.*, 93 Fed. Rep. 970.

15. The patent to Ryan, No. 403,143, May 14, 1889, for improvements in woven-wire mattresses and bed-bottoms, construed and *Held*, limited by the prior art to the specific form shown. **Id.*

16. The patent to Tower, No. 378,223, Feb. 21, 1888, for a pen-holder with a cork sleeve, construed and *Held*, not infringed. (C. C. A., 2d Cir. Apr. 4, 1899. (Tower *v.* Eagle Pencil Co., 90 Fed. Rep. 662, reversed.)

WALLACE, J.] *Tower *v.* Eagle Pencil Co. 94 Fed. Rep. 361.

17. The patent to Bauer, No. 305,882, Sept. 20, 1884, for a

watchman's time-detector, construed, limited and *Held*, not infringed by the time-recorder made under the patent to Watson, No. 515,805, Mar. 6, 1894. (C. C. A., 6th Cir. May 2, 1899.)

LURTON, J.] *Bundy Mfg. Co. *v.* Detroit Time-Register Co., 94 Fed. Rep. 524.

18. The patent to Perkins, No. 501,537, July 18, 1893, for an improved method of repairing asphalt pavements, an essential feature of which consists in the perfect commingling of old and new material in the process of repairing, is not anticipated by the so-called Crochet process in which the old material is removed and new material put in its place, and *Held*, not infringed by process in which no such commingling is attempted, but the old material is removed, the depression carefully cleaned and coated with cement to cause adhesion with the new material which is then added. (C. C. A., 2d Cir. May 25, 1899.)

SHIPMAN, J.] *United States Repair & Guaranty Co. *et al. v.* Standard Paving Co., 95 Fed. Rep. 137.

19. The patent to Brooks, No. 454,845, June 30, 1891, for improvements in typewriting machines, if valid must, in view of the state of the art, be limited as to claims 5, 6, 7, 8 and 9, to the precise construction shown and described. (C. C., D. N. J. June 20, 1899.)

ACHESON, J.] *Union Writing Mach. Co. *v.* Domestic Sewing Mach. Co., 95 Fed. Rep. 140.

20. The patent to Rauh, No. 347,442, Aug. 17, 1886, for a combined bathing shoe and stocking, construed and in view of the state of the art, *Held*, limited to the precise construction shown and not infringed. (C. C., S. D. N. Y. May 26, 1899.)

SHIPMAN, J.] *S. Rauh & Co. *v.* Guinzburg, 95 Fed. Rep. 159.

21. The patent to Huntington, No. 277,134, May 8, 1883, for a crushing mill, construed and *Held*, not infringed. (C. C. A., 3d Cir. July 6, 1899.)

DALLAS, J.] *Whitaker Cement Co. *et al. v.* Huntington Dry Pulverizer Co. *et al.*, 95 Fed. Rep. 471.

22. Claim 1 of Letters Patent No. 364,161, issued May 31, 1887, to George H. Cushman, for improvement in paper-box

machines, *Held*, to be limited in view of the prior state of the art to the specific form of mechanism shown and described, and as so construed not infringed. (C. C. A., 1st Cir. June 1, 1899.)

PUTNAM, J.] *Cushman Paper-Box Mach. Co. *v.* Goddard *et al.*, 88 O. G. 2410, 95 Fed. Rep. 664.

23. The patents to MacColl, Nos. 570,259 and 570,260, Oct. 27, 1896, for improvements in lappet looms, construed and *Held*, not infringed. (C. C. A., 1st Cir. May 31, 1899.)

COLT, J.] *MacColl *v.* Knowles Loom Works, 95 Fed. Rep. 982.

*MacColl *v.* Crompton Loom Works, 95 Fed. Rep. 987.

24. The patents to Stokes, Nos. 376,400, Jan. 10, 1888, 397,254, Feb. 5, 1889, for rasp-cutting machines, and No. 383,999, June 5, 1899, for a rasp as an improved article of manufacture, construed, and *Held*, valid, but not infringed. (C. C., D. N. Jer.)

KIRKPATRICK, J.] *Stokes Bros. Mfg. Co. *v.* Heller *et al.*, 96 Fed. Rep. 104.

25. The patent to Miehle, No. 322,309, July 14, 1885, for improvements in printing machines, construed, and *Held*, not infringed as to claims 1, 2 and 4. (C. C., N. D. Ill. N. D. July 27, 1899.)

KOHLSAAT, J.] *Miehle Printing Press & Mfg. Co. *v.* Campbell Printing Press & Mfg. Co., 96 Fed. Rep. 226.

26. The patent to Westinghouse, Jr., No. 538,001, Apr. 23, 1895, and the patent to Dixon, No. 382,032, May 1, 1888, both for improvements in air-brakes for railroad cars, construed, and *Held*, limited to the specific devices shown and described, and not infringed. (LACOMBE, J., dissenting as to Westinghouse patent.) (C. C. A., 2d Cir. July 18, 1899.)

SHIPMAN, J.] *Westinghouse Air-Brake Co. *v.* New York Air-Brake Co. *et al.*, 96 Fed. Rep. 991.

XI. VALIDITY NOT DETERMINED, NOT INFRINGED.

1. It is unnecessary to determine whether, in view of certain

exhibits, it involved invention to produce the valance of the 3d claim of the patent to Palmer, No. 474,997, May 17, 1892, for an improvement in woven valances for hammocks, for the reason that the claim cannot be broadened to cover the alleged infringing article without including the said exhibits also. The bill is dismissed. (C. C., S. D. N. Y. Nov. 15, 1898.)

COXE, J.] *Palmer *et al. v.* De Yongh, 90 Fed. Rep. 1898.

2. Claim 8 of the patent to Alexander McTammany, No. 290,697, Dec. 25, 1883, which relates to a device for "feeding, winding and guiding the perforated music sheets" used in automatic musical instruments, does not cover a primary invention, and the complainant is therefore not entitled to a broad range of equivalents, and since defendant's device differs so radically from complainant's he cannot be held as an infringer, even if the claim were entitled to a broad interpretation. The bill is dismissed. (C. C., S. D. N. Y. Nov. 15, 1898.)

COXE, J.] *McTammany *et al. v.* Paillard, 90 Fed. Rep. 283.

3. The facts disclosed by the file-wrapper in the Norton patent, No. 267,214, Nov. 7, 1882, for improvements in can-heading machine, show that it is not for a primary invention, and it must therefore be strictly construed. Machines made under the patent to Mathias Jensen, No. 443,445, Dec. 23, 1890, for machine for capping and crimping cans, does not infringe the Norton patent; nor do such machines infringe the following patents: Norton and Hodgson, No. 274,363, Mar. 20, 1883; Norton and Hodgson, No. 294,065, Feb. 26, 1884; Jordan, No. 322,060, July 14, 1885. (C. C. A., 9th Cir. Oct. 24, 1898.)

MORROW, J.] *Norton *et al. v.* Jensen, 90 Fed. Rep. 415.

4. The patent to Arbogast, No. 260,819, July 11, 1882, for an improvement in the method of manufacturing glass ware, construed and *Held*, not infringed. (C. C. A., 3d Cir. Dec. 6, 1898.)

DALLAS, J.] *United States Glass Co. *v.* Atlas Glass Co. *et al.*, 90 Fed. Rep. 724.

5. The patent to Cushman, No. 364,161, May 31, 1887, for an improvement in paper-box machines, construed, and in view of the prior state of the art, limited to the specific mechanism

shown and described, and *Held*, not infringed. (C. C., D. Mass. Dec. 5, 1898.)

COLT, J.] *Cushman Paper-Box Mach. Co. *v.* Goddard *et al.*, 90 Fed. Rep. 727.

6. The patent to Rice, No. 448,260, Mar. 17, 1891, for an improvement in motor suspension for railway cars. *Held*, not infringed by the motor suspension made in accordance with the patent to Uebelacker, No. 554,353, Feb. 11, 1896, or the patent to Short, No. 546,360, Sept. 17, 1895. (C. C. A., 1st Cir. Jan. 26, 1899.)

COLT, J.] *Thomson-Houston Electric Co. *v.* Athol and Orange St. Ry. Co., 91 Fed. Rep. 767.

7. The patent to Barnhart, No. 411,368, Sept. 17, 1889, for improvements in means for capping and sealing milk bottles, construed and *Held*, not infringed. (C. C. A., 7th Cir. Feb. 7, 1899.)

PER CURIAM] *Thatcher Mfg. Co. *v.* Creamery Package Mfg. Co. *et al.*, 91 Fed. Rep. 919.

8. The patent to Smith, No. 233,035, Oct. 5, 1880, for an improved mowing machine, *Held*, not infringed. (C. C. A., 7th Cir. Feb. 16, 1899.)

WOODS, J.] *Wilson *et al. v.* McCormick Harvester Mach. Co., 92 Fed. Rep. 167.

9. The patent to Roosevelt, No. 215,837, May 27, 1879, for an improvement in telephone switches, *Held*, to be for a narrow invention at most and not infringed. (C. C. A., 7th Cir. Feb. 7, 1899.)

WOODS, J.] *Western Electric Co. *v.* Western Tel. Const. Co., *et al.*, 92 Fed. Rep. 181.

10. The patent to Palmer, No. 271,510, Jan. 30, 1883, for an improvement in hammocks or bed-bottoms, claims 1 and 2 of which have for their fundamental characteristic suspension loops formed of the unwoven warp threads of the fabric, construed and *Held*, not infringed by a hammock, the suspension loops of which are made of the completely woven fabric. Claim 4, covering the pillow pocket, *Held*, to be for the specific construction of such pocket as described in the patent, and not infringed. (C. C., E. D. Penn. Feb. 28, 1899.)

DALLAS, J.] *Palmer *v.* Knight, 92 Fed. Rep. 365.

11. The patent to Warren, No. 327,626, Oct. 6, 1885, for a method of attaching stiffenings for dress waists, is not void on its face for want of novelty and invention. (C. C., D. Conn. Feb. 22, 1899.)

TOWNSEND, J.] *Warren Featherbone Co. *v.* Warner Bros. Co., 92 Fed. Rep. 990.

12. The patent to Williams & Lade, No. 439,920, Nov. 4, 1890, for an improvement in buttons, construed and *Held*, not infringed. (C. C., D. Ky. June 3, 1899.)

EVANS, J.] *Patent Button Co. *v.* Pilcher, 95 Fed. Rep. 479.

13. The patent to Hawley, No. 447,179, Feb. 24, 1991, for an improvement in furnaces if valid, must be limited as to claim 1, to the specific devices enumerated, and *Held*, not infringed. (C. C., D. Mass. Aug. 7, 1899.)

COLT, J.] *Hawley Furnace Co. of N. E. *v.* Braintree & W. St. Ry. Co., 96 Fed. Rep. 221.

14. The patent to Ericson, No. 491,012, Jan. 31, 1893, for a bicycle bell, *Held*, limited by specification and not infringed. (C. C., D. Mass.)

BROWN, J.] *Nutter *et al.*, *v.* Brown *et al.*, 96 Fed. Rep. 229.

15. The patent to Fay, No. 319,215, June 2, 1885, for spring calipers and dividers, *Held*, not infringed. (C. C., D. Mass. July 29, 1899.)

BROWN, J.] *Starrett *v.* J. Stevens Arms & Tool Co. Same *v.* Athol Mach. Co., 96 Fed. Rep. 244.

16. The patent to Smith, No. 395,668, Jan. 1, 1889, for a shoe-last, construed as to claim 2 and *Held*, not infringed. (C. C., D. Mass. July 28, 1899.)

BROWN, J.] *Miller *v.* Mawhinney Last Co., 96 Fed. Rep. 248.

17. The patent to Richardson, No. 412,296, Oct. 8, 1889, for improvements in fastenings for gloves and other articles, construed and limited to the precise form shown and described and *Held*, not infringed by the fastener of the patent to Adams, No. 566,731, Sept. 1, 1896. (C. C. A., 1st Cir. May 26, 1899.)

PUTNAM, J.] *Ball & Socket Fastener Co. *v.* C. A. Edgarton Mfg. Co., 96 Fed. Rep. 489.

18. The patents to Gassett, No. 233,746, Oct. 26, 1880, and No. 246,492, Aug. 30, 1881, for electric railway signalling apparatus, limited to precise construction shown and *Held*, not infringed. (C. C. A., 3d Cir. Sept. 13, 1899.)

KIRKPATRICK, J.] *Union Switch & Signal Co. *et al.* *v.* Philadelphia & R. R. Co. *et al.*, 96 Fed. Rep. 761.

19. The Gassett & Fisher patent, No. 227,102, May 4, 1880, and the patent to Means, No. 273,377, Mar. 6, 1883, for connectors for electric track circuits, *Held*, not infringed. **Id.*

20. The patent to Jones, No. 404,414, June 4, 1889, for a process of mixing molten metal, *Held*, not infringed. (C. C. A., 3d Cir. Aug. 21, 1899.)

KIRKPATRICK, J.] *Cambria Iron Co. *v.* Carnegie Steel Co., Lim., 96 Fed. Rep. 850.

21. The patent to Hebbard, No. 371,839, Oct. 1887, for improvements in target-traps construed, and if it is to be sustained at all in view of the prior art must be limited to the precise construction shown and described, and *Held*, not infringed. (C. C., D. N. Jer. Oct. 5, 1899.)

BRADFORD, J.] *Cleveland Target Co. *v.* Empire Target Co. *et al.*, 97 Fed. Rep. 44.

22. The design patent to Williams, No. 30,147, Feb. 7, 1899, for a fixture for generating and burning gas from liquid hydrocarbons, *Held*, not infringed. The patent to Williams, No. 606,435, June 28, 1898, for improvements in gas-generating gas fixtures, construed, and *Held*, not infringed. (C. C. A., 7th Cir. Oct. 3, 1899.)

WOODS, J.] *Magic Light Co. *v.* Economy Gas-Lamp Co., 97 Fed. Rep. 87.

23. The patent to Rickard & Long, No. 604,338, May 17, 1898, for an improvement in the art of maturing tobacco leaves, construed, and *Held*, not infringed. (C. C., D. Conn. Aug. 28, 1899.)

TOWNSEND, J.] *Rickard *et al.* *v.* Du Bon, 97 Fed. Rep. 96.

24. The patent to Roulstone, No. 508,557, Nov. 14, 1893, for adjustable supports for school furniture, construed and limited

to exact devices shown, and *Held*, not infringed. (C. C., D. Conn. Oct. 11, 1899.)

TOWNSEND, J.] *Chandler Adjustable Chair & Desk Co. *v.* Town of Windham, 97 Fed. Rep. 107.

25. The patent to Coburn, No. 365,240, June 21, 1887, for an improved trolley-track, construed, and without determining the question of invention, *Held*, not infringed. (C. C. A., 1st Cir. Sept. 14, 1899.)

PUTNAM, J.] *Coburn Trolley-Track Mfg. Co. *v.* Chandler *et al.*, 97 Fed. Rep. 333.

XII. VOID IN WHOLE OR IN PART.

1. The patent to McKee & Harrington, No. 506,430, Oct. 10, 1893, for "improvements in wood rims for bicycles," *Held*, to be anticipated as to claims 1 and 4 by prior public use and prior art.

The patent to Marble, No. 547,732, Oct. 8, 1895, for improvements in bicycle wheels, the tongue and groove-joint in the rim of which was the sole feature for which novelty was claimed, *Held*, anticipated as to claims 1 and 2 by prior publications and letters patent. (C. C., E. D. Wis. Nov. 7, 1898.)

SEAMAN, J.] *Indiana Novelty Mfg. Co. *v.* Crocker Chair Co. Same *v.* Smith Mfg. Co., 90 Fed. Rep. 488.

2. The patent to Laura A. Fry, No. 399,029, Mar. 5, 1889, for an improvement in the art of decorating pottery ware, *Held*, to be void for lack of patentable novelty and for anticipation. (C. C., S. D. Ohio, W. D. Dec. 2, 1898.)

TAFT, J.] *Fry *v.* Rookwood Pottery Co. *et al.*, 90 Fed. Rep. 495.

3. The patent to J. A. Brill, No. 432,115, July 15, 1890, for an improvement in car trucks, *Held*, anticipated as to claim 3 by the patent to Woodbury, 40,008, May 30, 1865. (C. C. A., 8th Cir. Nov. 28, 1898.)

THAYER, J.] *Brill *v.* St. Louis Car Co. *et al.*, 90 Fed. Rep. 666.

4. The design patent to Cary, No. 28,142, Jan. 11, 1898 (application filed Oct. 15, 1894), for a box-fastener, *Held*, anticipated by (article of manufacture) patent to the same inventor,

Cary, No. 450,753, Apr. 21, 1891, for the same subject-matter, granted more than two years prior to the filing date of the application for the design patent. (C. C., S. D. N. Y. Nov. 22, 1898.)

WHEELER, J.] *Cary Mfg. Co. *v.* Neal *et al.*, 90 Fed. Rep. 725.

5. The patent to Palmer, No. 493,220, Mar. 7, 1893, for a fabric made of elastic and impervious material, such as rubber, *Held*, void on the ground that such fabric constituted the essential feature of the invention covered by patent No. 489,714, Jan. 10, 1893, to the same patentee, for a rubber tube for pneumatic and other purposes.

The patent to Huss, No. 539,234, May 14, 1895, for the same fabric, *Held*, void for the same reasons, on prior patent to Huss, No. 495,975, April 25, 1893, for improvement in pneumatic tires.

Suit was brought under R. S. § 4918, to determine priority of invention between the above noted patents, but as both were declared void, it was held that determination of priority was unnecessary. (C. C. A., 6th Cir. Dec. 5, 1898.)

SEVERENS, J.] *Palmer Pneumatic Tire Co. *v.* Lozier, 90 Fed. Rep. 732.

6. The patent to Cogswell, No. 362,938, May 17, 1887, for apparatus for cooling saline solutions, *Held*, void, in view of prior art. (C. C. A., 6th Cir. Nov. 28, 1898.)

TAFT, J.] *Solvay Process Co. *v.* Michigan Alkali Co. *et al.*, 90 Fed. Rep. 818.

7. The patent to Falk, No. 545,040, Aug. 20, 1895, for an improvement in rail-joints and methods of forming the same, *Held*, void, for want of patentable invention and anticipation. (C. C., E. D. Mo. E. D. Jan. 10, 1899.)

ADAMS, J.] *Falk Mfg. Co. *v.* Missouri Ry. Co. *et al.*, 91 Fed. Rep. 155.

8. The patent to Kenney, No. 549,370, Nov. 5, 1895, for a device for holding woven wire fabrics, is for a mechanical conception and appliance pure and simple, discloses no patentable invention and is void. (C. C., D. Mass. Dec. 8, 1898.)

ALDRICH, J.] *Kenney *v.* Bent, 91 Fed. Rep. 259.

9. The patent to Coburn, No. 365,240, June 21, 1887, for a trolley track, *Held*, void as to claim 1, for lack of patentable invention. (C. C., D. Mass. Dec. 2, 1898.)

ALDRICH, J.] *Coburn Trolley-Track Mfg. Co. *v.* Chandler *et al.*, 91 Fed. Rep. 260.

10. The patent to Bragg, No. 173,261, Feb. 8, 1876, for an electro-magnetic power generator, *Held*, void as to claim 2 for want of invention. (C. C., N. D. Ill. Nov. 28, 1898.)

GROSSCUP, J.] *Ross *v.* City of Chicago, 91 Fed. Rep. 265.

11. The patent to Warren, No. 589,676, Sept. 7, 1897, for a spectacle case, *Held*, void for want of invention. (C. C., E. D. Penn. Feb. 2, 1899.) (See PATENTS. VALID BUT NOT INFRINGED, § 13.)

DALLAS, J.] *Warren *v.* Casey *et al.*, 91 Fed. Rep. 653.

12. The patent to Way, No. 593,954, Nov. 16, 1897, for a chest and neck protector, *Held*, void for want of invention. (C. C., E. D. Penn. Jan. 18, 1899.)

DALLAS, J.] *Way *v.* McClarin, 91 Fed. Rep. 663.

13. The reissue patent to Stieringer, No. 11,478, Mar. 12, 1895 (original No. 259,235, June 6, 1882), for an improvement in electrical fixtures, *Held*, void as to claim 1 as not being supported by the claims and specification of the original patent and for unreasonable delay in applying for reissue. (C. C. A., 3d Cir. Dec. 21, 1898.)

ACHESON, J.] *Horn & Branner *v.* Pelzer, 91 Fed. Rep. 665.

14. The patent to Lettelier, No. 482,484, Sept. 13, 1892, for a machine for making box binding channel strips, construed and *Held*, void for want of invention. (C. C., S. D. Cal. Jan. 30, 1899.)

WELLBORN, J.] *Lettelier *v.* Mann *et al.*, 91 Fed. Rep. 909.

15. The patent to Lettelier, No. 549,375, Nov. 5, 1895, for an improvement in box machines, *Held*, void on account of prior public use, of more than two years. (C. C., S. D. Cal. Jan. 30, 1899.)

WELLBORN, J.] *Lettelier *v.* Mann *et al.*, 91 Fed. Rep. 917.

16. The patent to Schrei, No. 547,185, Oct. 1, 1885, for an

improvement in refrigerator crates, *Held*, void for lack of invention. (C. C. A., 7th Cir. Feb. 16, 1899.)

BUNN, J.] *Schrei *et al* *v.* Morris *et al.*, 91 Fed. Rep. 992.

17. The patent to Jackson and Platt, No. 429,530, June 3, 1890, for a button, construed and *Held*, not infringed by a button made under the patent of Shepley, No. 548,143, Oct. 15, 1895, or if construed to cover the Shipley button then it is void for lack of novelty. (C. C., D. Conn. Jan. 24, 1899.)

TOWNSEND, J.] *Patent Button Co. *v.* Scovill Mfg. Co., 92 Fed. Rep. 151.

18. The patent of Gaitley, No. 338,506, Mar. 23, 1886, for a bail for lifting and carrying kettles, *Held*, void for want of invention. (C. C., N. D. N. Y. Feb. 27, 1899.)

COXE, J.] *Gaitley *v.* Greene, 92 Fed. Rep. 367.

19. The patents to Wardwell, No. 480,158, Aug. 2, 1892, for a method of winding cops, and No. 486,745, Nov. 2, 1892, for a cop which is the product of such process, *Held*, void for lack of novelty. (C. C. A., 2d Cir. Jan. 25, 1899.)

PER CURIAM.] *Universal Winding Co. *v.* Willimantic Linen Co., 92 Fed. Rep. 391.

20. The patents to Chambers, Nos. 207, 343, Aug. 27, 1878, as to claim 6, 297,675, Aug. 29, 1884, as to claim 2 and 275,467, Apr. 10, 1883, as to claim 1. *Held*, void for lack of invention. (C. C. A., 6th Cir. Mar. 7, 1899.)

TAFT, J.] *Penfield *v.* Chambers Bros. Co., 92 Fed. Rep. 630.

21. The patent to Loewenbach, No. 390,087, Sept. 25, 1888, for an improvement in receipt and record books, *Held*, void for want of invention. (C. C. A., 7th Cir. Feb. 23, 1899.)

PER CURIAM.] *Loewenbach *v.* Hake-Stirn Co. *et al.*, 92 Fed. Rep. 661.

22. The patent to Warren, No. 389,993, Sept. 25, 1888, for an improved dress or garment stay, *Held*, void for want of novelty. (C. C., D. Conn. Feb. 22, 1899.)

TOWNSEND, J.] *Warren Featherbone Co. *v.* Warner Bros. Co., 92 Fed. Rep. 990.

23. The patent to Parsons, No. 386,108, Aug. 9, 1887, for a machine for cutting leather or other materials, construed and

Held, invalid as to claims 3 and 4 and not infringed as to claim 5. (C. C., D. Mass. Feb. 24, 1899.)

BROWN, J.] *Parsons *v.* Seelye, 92 Fed. Rep. 1005.

24. The patent to Palmer, No. 272,311, Feb. 13, 1883, for improvements in hammocks, *Held*, to be void as to claims 4 and 8, unless construed as limited to the exact construction set forth in the specification and claims, in which case they are not infringed. (C. C. A., 2d Cir. Mar. 1, 1899.)

PER CURIAM.] *Palmer *v.* Curnen *et al.*, 93 Fed. Rep. 464.

25. The patent to Smith, No. 315,672, Apr. 14, 1885, for an improvement in loops for bridles, *Held*, void for lack of invention. (C. C., N. D. N. Y. Apr. 12, 1899.)

COXE, J.] *Smith *v.* Maxwell, 93 Fed. Rep. 466.

26. The patent to Ewig, No. 408,300, Mar. 9, 1890, for an improved waistband fastener, *Held*, void for anticipation and lack of invention. (C. C. A., 7th Cir. Feb. 7, 1899.)

WOODS, J.] *Rubens *et al.* *v.* Wheatfield, 93 Fed. Rep. 677.

27. The patent to Corser, No. 366,621, July 12, 1887, for improvements in overalls, *Held*, void for want of invention. (C. C., D. Ver. Apr. 1, 1899.)

WHEELER, J.] *Corser *v.* Brattleboro Overall Co., 93 Fed. Rep. 805.

28. The patent to Corser, No. 364,219, June 7, 1887, for improvements in coats and methods of making them, *Held*, void as to all but the 3d claim for want of invention. (C. C., D. Ver. Apr. 1, 1899.)

WHEELER, J.] *Corser *v.* Brattleboro Overall Co., 93 Fed. Rep. 809.

29. The patent to Christy, No. 532,444, Jan. 15, 1895, for a bicycle saddle, *Held*, void for lack of invention. (C. C. A., 4th Cir. May 2, 1899.)

GOFF, J.] *Christy *et al.* *v.* Hygeia Pneumatic Bicycle Saddle Co., 93 Fed. Rep. 965.

30. The patent to Wohlfarth, No. 543,072, July 23, 1895, for an improvement in brake-shoes, *Held*, void for want of invention. (C. C., N. D. N. Y. Apr. 12, 1899.)

COXE, J.] *Lappin Brake-Shoe Co. *v.* Corning Brake-Shoe Co., 94 Fed. Rep. 162.

31. The patent to Lohbiller, No. 496,058, Apr. 25, 1893, for improvements in safety valves, *Held*, void for lack of invention. (C. C. A., 1st Cir. May 4, 1899.)

PUTNAM, J.] *Crosby Steam Gage & Valve Co. *v.* Ashton Valve Co., 94 Fed. Rep. 516.

32. The patent to Lyons, No. 573,789, Dec. 22, 1896, for improvements in hat boxes or trunks, *Held*, void on its face for lack of patentable invention. (C. C., S. D. N. Y. May 28, 1899.)

SHIPMAN, J.] *Lyons *v.* Bishop *et al.*, 95 Fed. Rep. 154.

33. The patent to Maier, No. 303,393, Apr. 12, 1884, for a spring bed-bottom, *Held*, void on the ground of abandonment of invention as shown by the record, and also that the claims cover an unpatentable aggregation. (C. C., D. N. J. May 25, 1899.)

GRAY, J.] *Maier *et al.* *v.* Bloom *et al.*, 95 Fed. Rep. 159.

34. The reissue patent to Hedbavny, No. 11,079, May 27, 1890, (original No. 408,879) for a machine for removing hairs from fur skins, *Held*, void as to claims 1 and 2 for want of invention; claim 3, if valid, must be limited to the precise construction shown, and neither it nor claim 4 is infringed by the patent to Jenik, No. 557,129, of 1896. (C. C., S. D. N. Y. June 13, 1899.)

TOWNSEND, J.] *Cimiotti Unhairing Co. *et al.* *v.* Bowsky, 95 Fed. Rep. 474.

35. The design patent to Sagendorph, No. 17,235, for a design for metallic siding for buildings, *Held*, void as anticipated by the patent to Hardy, No. 163,991, June, 1875. (C. C., E. D. Penn. July 10, 1899.)

MCPHERSON, J.] *Sagendorph *v.* Hughes, 95 Fed. Rep. 478.

36. The patent to Baker, No. 437,961, Oct. 7, 1890, for an improvement in trolley devices for electric railways, *Held*, anticipated by prior patents for throwing glass balls, and void. (C. C., D. N. J. July 7, 1899.)

KIRKPATRICK, J.] *Thomson-Houston Electric Co. *v.* Rahway Electric Light & Power Co., 95 Fed. Rep. 660.

37. The patent to Rulifson, No. 364,603, June 7, 1887, for

improvements in bean-harvesters, construed in view of the prior state of the art and, *Held*, void as to claims 1, 3, 4, 7, 8 and 9, for lack of invention. (C. C., N. D. N. Y. July 6, 1899.)

COXE, J.] *Rulifson *et al.* *v.* Johnson, 95 Fed. Rep. 825.

38. The patent to Shoe, No. 558,218, Apr. 14, 1896, for improvements in bicycles saddles, *Held*, void for lack of patentable invention. (C. C., E. D. Penn. Aug. 9, 1899.)

GRAY, J.] *Shoe *v.* Gimbel *et al.*, 96 Fed. Rep. 96.

39. The patent to Stokes, No. 408,936, Aug. 13, 1889, for a method of forming teeth on a rasp blank, *Held*, void as covering the mechanical operation or function of a machine. (C. C., D. N. Jer.)

KIRKPATRICK, J.] *Stokes Bros. Mfg. Co. *v.* Heller *et al.*, 96 Fed. Rep. 104.

40. The patent to Orr, No. 456,202, Apr. 30, 1890, for improvements in fire proof buildings, construed and *Held*, void for want of invention in view of the prior art. (C. C., E. D. Penn. Aug. 7, 1899.)

MCPHERSON, J.] *New Jersey Wire-Cloth Co. *v.* Merrill *et al.*, 96 Fed. Rep. 216.

41. The patent to Lawrence, No. 295,180, May 18, 1884, for a process of treating milk, construed and *Held*, void for lack of patentable invention and for anticipation. (C. C., N. D. Ill. N. D. July 27, 1899.)

KOHLSAAT, J.] *Burrell *et al.* *v.* Elgin Creamery Co., 96 Fed. Rep. 234.

42. The patent to Perkins, No. 501,537, July 18, 1893, for an improvement in the method of repairing asphalt pavements, *Held*, void for anticipation. (C. C., N. D. Ill. N. D. June 7, 1899.)

KOHLSAAT, J.] *United States Repair & Guaranty Co. *v.* Assyrian Asphalt Co. *et al.*, 96 Fed. Rep. 235.

43. The patent to Leslie, No. 581,123, Apr. 20, 1897, for an improvement in temporary binders, known as "perpetual ledgers," construed and *Held*, void as to claims 8 to 13, inclu-

sive, for lack of patentable invention. (C. C., N. D. Ill. N. D. June 6, 1899.)

KOHLSAAT, J.] *William Mann Co. *v.* Hoffman, 96 Fed. Rep. 237.

44. The patent to Davey, No. 555,434, Feb. 25, 1896, for an improvement in pegging-machines, *Held*, void as to claims 1, 2, 3 and 10, for lack of invention. (C. C., D. Mass. Aug. 4, 1899.)

BROWN, J.] *Davey Pegging-Mach. Co. *v.* Isaac Prouty & Co., *et al.*, 96 Fed. Rep. 336.

46. The patent to Chatillon, No. 304,172, Aug. 26, 1884, for an improvement in scale-pans, which consists in applying to an enameled flanged scale-pan, a protecting metal ring which overlaps the edge of the pan and the bottom edge of the flange, *Held*, void for want of invention. (C. C., S. D. N. Y. Aug. 7, 1899.)

TOWNSEND, J.] *Chatillon *v.* Forschner *et al.*, 96 Fed. Rep. 342.

47. The patent to Way, No. 593,954, Nov. 16, 1897, for chest and neck protector, *Held*, void for want of novelty, 91 Fed. Rep. 663, Sand. Pat. Dig. 1899, affirmed. (C. C. A., 3d Cir. May 9, 1899.)

BUFFINGTON, J.] *Way *v.* McClarin, 96 Fed. Rep. 416.

48. The patent to Hawley, No 447,179, Feb. 24, 1891, for an improvement in furnaces, *Held*, anticipated and void. (C. C., E. D. Mo. E. D. June 26, 1899.)

ADAMS, J.] *Springfield Furnace Co. *et al. v.* Miller Down-Draft Furnace Co. *et al.*, 96 Fed. Rep. 418.

49. The patent to Johnston, No. 490,849, Jan. 31, 1893, for an improvement in ore concentrators, *Held*, void in view of the prior state of the art. (C. C., N. D. Cal. Aug. 7, 1899.

MORROW, J.] *Johnston *v.* Woodbury, 96 Fed. Rep. 421.

50. The patent to Covert, No. 208,157, Sept. 18, 1878, for an improvement in rope clamps, *Held*, anticipated and void. (C. C., S. D. N. Y. Aug. 9, 1899.)

TOWNSEND, J.] *Covert *v.* Travers Bros. Co., 96 Fed. Rep. 568.

51. The patent to Westinghouse, No, 270,867, Jan. 16, 1883, for improvements in electric circuits for railway signalling, *Held*, void because of two years prior public use and description and publication more than two years prior to application for the patent. (C. C. A., 3d Cir. Sept. 13, 1899.)

KIRKPATRICK, J.] *Union Switch & Signal Co. *et al.* *v.* Philadelphia & Reading R. R. Co. *et al.*, 96 Fed. Rep. 761.

52. The patent to Sperry, No. 267,032, Nov. 7, 1882, for a fanning mill, discloses a combination of old elements producing no new results, and *Held*, void for lack of invention. (C. C., D. Minn., 4th Div. Oct. 19, 1899.)

LOCHREN, J.] *Sperry Mfg. Co. *v.* J. L. Owens Co., 96 Fed. Rep. 975.

53. The patent to Barrett, No. 511,923, Jan. 2, 1894, for an improvement in lifting jacks, *Held*, void for lack of invention. (C. C., D. Mass. Oct. 4, 1899.)

PUTNAM, J.] *Duff Mfg. Co. *v.* Norton, 96 Fed. Rep. 986.

54. The patent to Potts and Potts, No. 368,898, Aug. 23, 1887, for an improvement in clay disintegrators, construed and *Held*, void for lack of patentable invention. (C. C. A., 6th Cir. Oct. 23, 1899.)

TAFT, J.] *C. & A. Potts & Co. *v.* Creager *et al.*, 97 Fed. Rep. 78.

55. The patent to Stevens & Harrison, No. 546,360, Sept. 17, 1895, for a method of producing a pyroxyline compound in imitation of onyx, *Held*, void for lack of novelty and invention.

The patent to Thurber & Schaefer, No. 542,452, July 9, 1895, for an improvement in celluloid articles and process of manufacturing the same, *Held*, void both as to product and as to process. (C. C. A., 3d Cir. Sept. 22, 1899.)

BRADFORD, J.] *Arlington Mfg. Co. *v.* Celluloid Co., 97 Fed. Rep. 91.

56. The design patent to Schmid, No. 21,416, Mar. 22, 1892, for a design for the frame of an electric machine, *Held*, void as

not disclosing patentable invention. (C. C. A., 6th Cir. Oct. 3, 1899.)

TAFT, J.] *Westinghouse Electric & Mfg. Co. *v.* Triumph Electric Co., 97 Fed. Rep. 99.

57. The patent to Taylor, No. 373,107, Nov. 15, 1887, for an improved lock, construed and *Held*, void for lack of invention. (C. C., D. Conn. Sept. 5, 1899.)

TOWNSEND, J.] *Yale & Towne Mfg. Co. *v.* Sargent & Co., 97 Fed. Rep. 106.

58. The patents to McBride, No. 199,082, Jan. 8, 1878, and No. 284,036, Aug. 28, 1883, for improved riding attachments for plows, *Held*, anticipated and void. (C. C. A., 8th Cir. Oct. 9, 1899.)

SANBORN, J.] *McBride *v.* Kingman *et al.* Same *v.* Sickels *et al.* Same *v.* Randall *et al.* Same *v.* Ainsworth *et al.*, 97 Fed. Rep. 217.

59. The patent to Kenney, No. 549,370, Nov. 5, 1895, for a device for holding woven wire fabrics on a mattress frame, *Held*, void as to claim, for lack of patentable invention. (C. C. A., 1st Cir. Sept. 14, 1899.)

PUTNAM, J.] *Kenney *v.* Bent, 97 Fed. Rep. 337.

60. The patent to Kisinger, No. 492,811, Mar. 7, 1893, for a trolley-wire connector, *Held*, anticipated by the Morrison patent, No. 428,123, May 20, 1890, and void. (C. C. A., 6th Cir. Oct. 3, 1899.)

TAFT, J.] *Kisinger-Ison Co. *v.* Bradford Belting Co., 97 Fed. Rep. 502.

61. The patent to Hoffman, No. 450,124, Apr. 7, 1891, for improvements in storage cases for books, *Held*, void as to claims 1 and 2. (Sup. Ct. U. S. May 14, 1899.)

BROWN, J.] *Office Specialty Mfg. Co. *v.* Fenton Metallic Mfg. Co., 87 O. G. 1608.

Practice in the United States Courts.

Where the lower court correctly instructed the jury in relation to the law applicable to each of the questions of novelty and infringement, they being mixed questions of law and fact, the verdict of the jury is conclusive on writ of error to an appellate

court as to every fact embraced within the issues submitted to the jury for decision, unless there was an entire want of evidence upon which to base the verdict returned by the jury. This results from the well-settled rule that on a writ of error the appellate court can only consider errors of law, and that the review under such writ does not extend to matters of fact. (C. C. A., 9th Cir. Oct. 18, 1897.)

DE HAVEN, J.] *Graham *v.* Earl. 82 Fed. Rep. 737; 92 Fed. Rep. 155.

Prints.

1. An arbitrary and fanciful representation to be placed upon cards and letter-heads as an ornamentation thereof is not a print within the meaning of the copyright law such as may be registered in this Office. (May 31, 1899.)

GREELEY, A. C.] *Ex parte* Barnhart Bros. & Spindler 87 O. G. 2118.

2. When an alleged print possesses artistic merit, but does not relate to the trade or pertain to an article of manufacture within the meaning of the statute, which requires that it shall be for some article of manufacture, *Held*, that it is not registrable as a print, whatever right the designer may have to protection in some other form. *Id.*

3. "For any article of manufacture" in the statute and "pertaining to an article of manufacture" in the rule have reference to the subject-matter of the print itself, and if that subject-matter does not suggest or in some manner indicate some other article of manufacture it is not registrable in this Office. The article indicated must be separate and independent of the print itself. *Id.*

4. Aside from the rule that a print to be registrable must not be borne by the article to which it pertains, *Held*, that the alleged print in this case does not pertain to cards and letter-heads within the meaning of the statute, since its subject-matter does not suggest them, and it is merely an ornamental design which might be placed upon a variety of articles. *Id.*

5. Proofs or prints do not pertain to the plate from which printed in the sense of the statute requiring that they shall be for an article of manufacture. To so hold would render mean-

ingless the statutes distinguishing between copyrights, prints and designs. *Id.*

6. Prints are designed to give protection in the use of the print itself in whatever manner produced as a representation or indication of the article of manufacture to which it pertains, but not in the manufacture and use of the article itself. *Id.*

Prints and Labels.

DEPARTMENT OF THE INTERIOR,
UNITED STATES PATENT OFFICE,
Washington, D. C., March 3, 1899.

The attention of all persons ordering copies of Prints and Labels from this Office is respectfully called to the following notice, in view of which a written statement, setting forth the particular use to which the copy is to be applied, will in each case be required:

DEPARTMENT OF THE INTERIOR,
UNITED STATES PATENT OFFICE,
Washington, D. C., January 20, 1899.

Hereafter copies of Prints and Labels will be furnished only upon an order from the Commissioner.

By direction of the Commissioner.

Prior Adjudication.

1. The matters in controversy in the present suit are not *res adjudicata* by reason of the case of Norton *v.* Jensen, 7 U. S. Ap. 103; 1 C. C. A. 452; 49 Fed. Rep. 859. The parties are the same; the patents here involved are the same as were held valid as against Jensen's first machine in that suit. But here a different patent of Jensen's is now involved, not the same but a second patent which the Patent Office deemed proper to allow him. There is *prima facie* a lack of identity in the subject-matter of the two cases, and therefore upon the face of the record there is no estoppel either in judgment or in evidence. (C. C. A., 9th Cir. Oct. 24, 1898.)

MORROW, J.] *Norton *et al. v.* Jensen, Fed. Rep. 415.

2. Where, in a prior suit at law for the infringement of a patent, the verdict and judgment were based upon the ground that the patent was a mere adaptation of the device of a prior patent, and therefore invalid, *Held*, that the judgment thus given—the court having jurisdiction of the subject-matter and

of the parties—is good as a plea in bar, and conclusive when given in evidence in a subsequent suit between the same parties or their privies, upon the same point, not only of the invalidity of the patent sued upon, but also that articles made in conformity with that patent are substantial copies of the device of the prior patent. (C. C., S. D. Cal. Nov. 21, 1898.)

Ross, J.] *Newton Mfg. Co. *v.* Wilgus, 90 Fed. Rep. 483.

3. To apply a prior judgment and give effect to the adjudication actually made, resort may be had to extrinsic evidence, such for example as the special verdict of the jury, and the evidence in the prior suit as embodied in the transcript of the record of that suit. **Id.*

4. Where an applicant appealed to the Court of Appeals from the decision of the Commissioner of Patents, holding that his invention was without patentable novelty, and the court sustained the decision of the Commissioner and suggested to applicant to file a bill in equity, and applicant instead of following the suggestion filed a new application for the same matter that was in the first application, *Held*, on appeal to the court on the second application, that the question of patentable novelty will not be again passed upon, as that question is *res adjudicata*. (C. A. D. C. Feb. 9, 1899.)

Morris, J.] *Barratt *v.* Duell, Comr. of Patents, 87 O. G. 1075.

5. When an application for patent is after due examination rejected and finally determined against the applicant after exhaustion of the right of appeal allowed to him, *Held*, that it is not incumbent upon the Patent Office as a duty to entertain such second application, and that if the Commissioner refuses to entertain it he has a perfect legal right to do so. **Id.*

6. There is no provision of law for a second application where a previous application has been adjudicated and a patent denied. The absence of such provision is sufficient evidence that the right to have a second application considered after the refusal of a patent upon a previous application does not exist. **Id.*

7. While the rules that govern the finality and conclusiveness of adjudication at the common law do not apply in the strict sense to administrative or quasi-judicial actions in the Execu-

tive Departments of the Government, yet in such actions as well as in judicial proceedings it is both expedient and necessary that there should be an end to controversy. * *Id.*

8. Where in a court of law there has been one investigation and one adjudication, such action becomes final and can only be reviewed, if at all, by the way of appeal. Subsequent suit for the same subject-matter and between the same parties cannot be sustained, and there is no good reason why the course of procedure should be different in the Patent Office. * *Id.*

9. The principles applicable to the proceedings in the Patent Office are so nearly akin to judicial proceedings as to be most properly designated as quasi-judicial, and it is only by regarding these proceedings as such that the validity of the legislation which authorizes appeals to the Court of Appeals from the decision of the Commissioner of Patents can be sustained. * *Id.*

10. In an action between the same parties, or those in privity with them upon the same claim or demand, a prior judgment or decree upon the merits is conclusive of every matter that was or might have been litigated in the earlier suit. (C. C. A., 8th Cir. June 19, 1899.)

SANBORN, J.] *Fish Bros. Wagon Co. *v.* Fish Bros. Mfg. Co., 95 Fed. Rep. 457.

Protection of Patents in Territory Subject to Military Government by United States Forces.

[*Circular No. 12.*]

DIVISION OF CUSTOMS AND INSULAR AFFAIRS.
WAR DEPARTMENT,
Washington, D. C., April 11, 1899.

The following is published for the information and guidance of all concerned:

In territory subject to military government by the military forces of the United States, owners of patents, including design patents, which have been issued or which may hereafter be issued, and owners of trade-marks, prints, and labels, duly registered in the United States Patent Office under the laws of the United States relating to the grant of patents and to the regis-

tration of trade marks, prints, and labels, shall receive the protection accorded them in the United States under said laws; and an infringement of the rights secured by a lawful issue of a patent or by registration of a trade-mark, print, or label, shall subject the person or party guilty of such infringement to the liabilities created and imposed by the laws of the United States relating to said matters: *Provided*, That a duly certified copy of the patent or of the certificate of registration of the trade-mark, print, or label, shall be filed in the office of the Governor General of the island wherein such protection is desired; and, *Provided further*, That the rights of property in patents and trade-marks secured in the Islands of Cuba, Porto Rico, the Philippines, and other ceded territory, to persons under the Spanish laws, shall be respected in said territory, the same as if such laws were in full force and effect.

G. D. MEIKLEJOHN,
Acting Secretary of War.

[*Circular No. 21.*]

DIVISION OF CUSTOMS AND INSULAR AFFAIRS.

WAR DEPARTMENT,
Washington, D. C., June 1, 1899.

The following is published for the information and guidance of all concerned:

Parties who desire protection in territory under government of the military forces of the United States for patents, trade marks, prints, or labels, as provided in Circular No. 12, Division of Customs and Insular Affairs, War Department, should forward a certified copy of the patent or of the certificate of registration of the trade-mark, print, or label, together with a letter of transmittal to the Governor-General, requesting that such copy be filed in his office for reference.

Upon the receipt of such certified copy the Governor-General will issue his formal receipt therefor and forward it to the party filing the same.

A fee of one dollar will be charged for filing such copy and should be inclosed with the letter of transmittal to the Governor-General.

The requirements for filing under the provisions of Circular

No. 12, above referred to, apply only to patents duly issued, and to trade-marks, prints, or labels duly registered in the United States Patent Office under the laws of the United States. The only certification required is that issued by the Commissioner of Patents. Communications should be addressed to the Governor-General of Cuba, Havana, Cuba; or Governor-General of Porto Rico, San Juan, Porto Rico; or Governor-General of the Philippine Islands, Manila, Philippine Islands.

G. D. MEIKLEJOHN,
Assistant Secretary of War.

[*Circular No. 34.*]

DIVISION OF CUSTOMS AND INSULAR AFFAIRS,
WAR DEPARTMENT,
Washington, D. C., September 25, 1899.

The following is published for the information and guidance of all concerned:

So much of Circular No. 21, of the Division of Customs and Insular Affairs, War Department, dated June 1, 1899, as requires the payment of a fee for filing certified copies of patents or certificates of registration of trade marks, prints, or labels is hereby rescinded.

Said Circular No. 21 is hereby further amended by the addition thereto of the following paragraphs:

"A power-of-attorney from the owner thereof authorizing another for him and in his name, place and stead to file a certified copy of a patent or a certificate of registration of a trade-mark, print or label must be filed with such certified copy or certificate of registration in each of the islands wherein the protection of such patents, trade-marks, prints or labels is desired.

"Assignments of patents, trade-marks, prints, or labels, or certified copies thereof, must be filed in the same manner as herein provided for filing certified copies of patents and certificates of registration of trade-marks, prints or labels."

G. D. MEIKLEJOHN,
Assistant Secretary of War.

Reopening Cases in the Patent Office.

I. *Ex Parte.*

II. Interferences.

I. *Ex Parte.*

1. The examiners-in-chief affirmed the rejection by the examiner, whereupon appeal was taken to the Commissioner, and appellant contends that the case was not in condition for appeal, and that he was prematurely forced by the examiner to take such appeal, and requests that the case be remanded to the examiner for reconsideration, and that he be permitted to file an amendment, *Held*, that certain of the appealed claims are vague and indefinite, and were not in condition for appeal at the time they were finally rejected. Under such circumstances he should have been given an opportunity, and, in fact, should have been required to make such claims clear and definite before an appeal was permitted. The case is therefore re-opened and remanded to the examiner for further consideration. (June 1, 1899.)

Greeley, A. C.] *Ex parte* Herzog, 67 MS. Dec. 139.

2. Rule 142 provides that cases decided upon appeal will not be reopened before the primary examiner without specific authority from the Commissioner, and it is the settled practice of the Office not to re-open such cases except for good and sufficient reasons. Where there was no recommendation by the examiners-in-chief, under rule 139, that any of the appealed claims would be allowable if amended, and there was nothing in their decision to warrant the admission of the amendment presented, and the only reason given for the failure to sooner present the amended claims was that applicant did not realize the necessity for amending until after the decisions on appeal, *Held*, that such reason is insufficient to warrant the re-opening of the case. (June 17, 1899.)

Greeley, A. C.] *Ex parte* Betz, 67 MS. Dec. 194.

3. Where a case was remanded by the examiners-in-chief to the primary examiner for reconsideration, the entire case was re-opened, and it was necessary for him to use his own judgment in treating the claims without being bound by the opinions of

the examiners-in-chief; for if he were to be absolutely bound by their rulings there would be no useful purpose served in remanding the case to him. (June 29, 1899.)

GREELEY, A. C.] *Ex parte* Hunter, 67 MS. Dec. 248.

4. Where an applicant was furnished by the office with a defective copy of the principal reference relied on in the rejection of his application by the examiner, the board of examiners-in-chief and the Commissioner, *Held*, that the case should be reopened and remanded to the examiner with instructions to enter and consider the amendment presented and such other amendments as are presented in regular order. (Dec. 7, 1899.)

GREELEY, A. C.] *Ex parte* Robertson, 68 MS. Dec. 260.

5. Where the claims of an application have been finally rejected and the applicant has taken and prosecuted an appeal to the examiners-in-chief, it is too late to raise the question whether the examiner in his rejections fully explained the pertinency of the references. (Nov. 25, 1898.)

GREELEY, A. C.] *Ex parte* Hardie, 86 O. G. 181.

6. While the Office is disposed to assist applicants unfamiliar with the practice in bringing out the patentable novelty in their cases, the practice cannot properly be carried to the extent of re-opening cases which have proceeded as far as this one has merely for the purpose of further amendment. To do so would make it practically impossible to bring the prosecution of a case to a conclusion, and, as stated in *ex parte* Snow, (80 O. G. 1271)—

> There must be an end somewhere to the prosecution of an application, and the Office is justified in restricting the power to bring up for consideration matters which should have been presented and disposed of prior to the closing of the case before the primary examiner.
>
> *Id.*

II. INTERFERENCE.

Where judgment of priority had been rendered by the examiner of interferences and his action affirmed by the board of examiners-in-chief, a petition to reopen the case for the purpose of presenting additional testimony not newly discovered, denied. (May 3, 1899.)

GREELEY, A. C.] Estes *v.* Gause, 88 O. G. 1336.

Repair of Patented Machines.

1. The purchaser of a patented machine may repair the machine which he has purchased by replacing worn out parts, so long as the identity of the machine is not destroyed. The sale of an entire machine carries with it the right to replace a part which, in relation to the whole structure, is temporary in its nature, although such part may be one of the novel or valuable devices covered by the claims of the patent. But the right to repair does not include the right to build a new machine, or to reconstruct or rebuild an old one. (Authorities cited.) (C. C., N. D. Cal. Mar. 16, 1899.)

MORROW, J.] *Alaska Packer's Ass'n *v.* Pacific Steam Whaling Co. *et al.*, 93 Fed. Rep. 672.

2. There is a distinction between a patent covering an entire machine composed of several separate and distinct parts, and a machine not patented as an entirety, but in parts, and such parts covered by different patents. In the former case the purchaser will not infringe by replacing temporary parts as they wear out, so long as the identity of the machine is retained, while in the latter, the manufacture and sale of the parts constitute infringement. **Id.*

3. It may be that this distinction will not satisfactorily determine all cases, particularly where separate parts are covered by separate claims in the patent; but the other distinction, which gives the purchaser of a patented machine under an ordinary sale the right to preserve its normal life by replacing temporary parts when worn out, is a distinction that can be applied in all cases of repair, and is in accordance with the just rights of ownership of the property. **Id.*

Rules of Practice.

DEPARTMENT OF THE INTERIOR,
UNITED STATES PATENT OFFICE,
Washington, D. C., July 14, 1899.

The sixteenth edition of the Rules of Practice of this Office has been adopted and duly approved by the Secretary of the Interior, to take effect on July 18, 1899. The changes made in the rules of the fifteenth revised edition of June 18, 1897, and the second edition thereof, December 1, 1897, are as follows:

Rules 9, 18, 25, 33, 41, 46, 47, 60, 77, 78, 91, 96, 107, 110, 112, 124, 128, 149, 154, 156 and 162 are amended, the changes noted in the appendix of the second edition of December 1, 1897, and those appearing in THE OFFICIAL GAZETTE since the publication of the fifteenth edition have been incorporated in the rules, and rule 214 has been added.

Forms 1 to 17 and 37 have been amended, a new form 7 added, and the forms renumbered as necessary.

C. H. DUELL,
Commissioner.

Rules 9, 41 and 47 as Amended to Take Effect July 18, 1899.

9. A separate letter should in every case be written in relation to each distinct subject of inquiry or application. Assignments for record, final fees, and orders for copies or abstracts must be sent to the Office in separate letters.

Papers sent in violation of this rule will be returned.

41. Two or more independent inventions cannot be claimed in one application; but where several distinct inventions are dependent upon each other and mutually contribute to produce a single result they may be claimed in one application.

A machine, a process, and a product are separate and independent inventions, and claims for each must be presented in a separate application.

47. If the application be made by an executor or administrator of a deceased person *or the guardian, conservator or representative of an insane person*, the form of the oath will be correspondingly changed.

The oath or affirmation may be made before any person within the United States authorized by law to administer oaths, or, when the applicant resides in a foreign country, before any minister, chargé d'affaires, consul, or commercial agent holding commission under the government of the United States, or before any notary public of the foreign country in which the applicant may be, the oath being attested in all cases, in this and other countries, by the proper official seal of the officer before whom the oath or affirmation is made. When the person before whom the oath or affirmation is made is not provided with a seal, his official character shall be established by com-

petent evidence, as by a certificate from a clerk of a court of record or other proper officer having a seal.

An oath taken before a notary public or magistrate will not be accepted unless a certificate of the official character of the person administering the oath, stating the date of appointment and term of office, is filed. To obviate the necessity of a separate certificate in each application, a certificate may be furnished with the request that it be filed in the Patent Office for general reference.

DEPARTMENT OF THE INTERIOR,
UNITED STATES PATENT OFFICE,
Washington, D. C., September 2, 1899.

Rule 47 of the Rules of Practice in the United States Patent Office, edition of July 18, 1899, is amended by canceling the last paragraph thereof, which reads as follows:

An oath taken before a notary public or magistrate will not be accepted unless a certificate of the official character of the person administering the oath, stating the date of appointment and term of office, is filed. To obviate the necessity of a separate certificate in each application, a certificate may be furnished with the request that it be filed in the Patent Office for General reference.

C. H. DUELL,
Commissioner.

Approved:
E. A. HITCHCOCK,
Secretary of the Interior.

DEPARTMENT OF THE INTERIOR,
UNITED STATES PATENT OFFICE,
Washington, D. C., December 5, 1899.

Rule 47 of the Rules of Practice of the United States Patent Office, edition of July 18, 1899, is amended to read as follows:

"47. If the application be made by an executor or administrator of a deceased person or the guardian, conservator, or representative of an insane person, the form of the oath will be correspondingly changed.

"The oath or affirmation may be made before any person within the United States authorized by law to administer oaths, or, when the applicant resides in a foreign country, before any minister, chargé d'affaires, consul or commercial agent holding commission under the Government of the United States, or before any notary public of the foreign country in which the applicant may be, *who is authorized by the laws of his country to administer oaths*, the oath being attested in all cases, in this and other countries, by the proper official seal of the officer before whom the oath or affirmation is made. When the person before whom the oath or affirmation is made is not provided with a seal, his official character shall be established by competent evidence, as by a certificate from a clerk of a court of record or other proper officer having a seal.

"*When the oath is taken before an officer in a country foreign to the United States, all the application papers must be attached together and a ribbon passed one or more times through all the sheets of the application, and the ends of said ribbon brought together under the seal before the latter is affixed and impressed, or each sheet must be impressed with the official seal of*

the officer before whom the oath was taken, or if he is not provided with a seal, then each sheet must be initialed by him."

C. H. DUELL,
Commissioner.

DEPARTMENT OF THE INTERIOR, *December 6, 1899.*

Approved, the last paragraph of this rule to take effect May 1, 1900.

E. A. HITCHCOCK,
Secretary of the Interior.

Revenue Stamps.

DEPARTMENT OF THE INTERIOR,
UNITED STATES PATENT OFFICE.
Washington, D. C., September 16, 1898.

The attention of persons having business before this Office is called to the following ruling of the Commissioner of Internal Revenue in relation to affixing revenue stamps to trade mark, print, and label certificates issued by this Office:

TREASURY DEPARTMENT,
OFFICE OF THE COMMISSIONER OF INTERNAL REVENUE,
Washington, D. C., September 3, 1898.

HON. C. H. DUELL,
Commissioner of Patents, Interior Department.

SIR: I have the honor to acknowledge the receipt of your letter of current date, submitting three forms which are used by your Office and asking in regard to their liability to the internal revenue tax under Schedule A of the War Revenue Act of June 13, 1898.

These forms are as follows:

Exhibit "A" is a certificate of registration of trade mark. Exhibit "B" is a certificate that there has been deposited in your Office for registration a print; and Exhibit "C" is a certificate that there has been deposited in your Office for registration a label.

These certificates are all required by law and are given for private use. In conformity with the opinion of the Attorney-General and the rulings of this Office, each of these certificates required a ten-cent stamp.

Very respectfully, W. B. SCOTT,
Commissioner.

The Commissioner of Internal Revenue has also ruled that a

certificate of acknowledgement accompanying an assignment, in accordance with section 4898 of the Revised Statutes as amended March 3, 1897, requires a revenue stamp to the value of ten cents to be affixed thereto.

C. H. DUELL,
Commissioner.

DEPARTMENT OF THE INTERIOR,
UNITED STATES PATENT OFFICE,
Washington, D. C., June 15, 1899.

By an act of Congress approved June 13, 1898, entitled "An Act to provide ways and means to meet war expenditures and for other purposes," certain certificates are required to have affixed thereto a revenue stamp to the value of ten cents. The Commissioner of Internal Revenue, in view of certain decisions of the Attorney-General of the United States, has decided that certificates of registration of trade marks, prints and labels, and such certificates as are issued by this Office certifying to copies of the records, come under the provisions of said act, and as they are for the benefit of the person to whom they are issued, a proper revenue stamp must be furnished by said person to be affixed to said certificate.

To save annoyance to this Office and delay in delivering the certified copies of records and certificates of registration of trade marks, prints and labels, it is requested that the order for certified copies of the records be accompanied by a ten-cent revenue stamp for each certificate to be issued, and that upon receipt of notice that an application for the registration of a trade mark, print or label has been allowed, a ten-cent revenue stamp be promptly forwarded to this Office.

As this Office does not deal in revenue stamps or keep accounts with the public for such purpose, a stamp must be furnished by the interested party. The Office will not purchase stamps out of cash forwarded by or on deposit to the credit of said party. Attention is also called to the fact that postage stamps will not be accepted in lieu of revenue stamps.

By direction of the Commissioner.

Amending regulations as to cancellation of documentary and proprietary stamps.

[*Circular No. 142—Int. Rev., No. 549.*]

TREASURY DEPARTMENT,
OFFICE OF COMMISSIONER OF INTERNAL REVENUE,
Washington, D. C., December 1, 1899.

To Collectors of Internal Revenue and others:

Existing regulations providing for the cancellation of adhesive revenue stamps by writing or stamping thereon, with ink, the initials of the name and the date when attached, or by cutting and canceling said stamp with a machine or punch which will affix the initials and date as aforesaid, and the cancellation of imprinted stamps on checks, drafts or other instruments by filling out the dates and blank lines on said instruments in the usual manner of drawing checks and drafts, or by perforating through the stamp and paper to which it is attached the amount in figures for which said instrument was drawn, having proved inadequate to prevent frauds on the revenue which have been, and now are, extensively practiced, said regulations are hereby amended by adding thereto the following provision and requirement:

In all cases where a documentary stamp of the denomination of 10 cents or any larger denomination shall be used for denoting any tax imposed by the act of June 13, 1898, the person using or affixing the same shall, in addition to writing or stamping thereon, with ink, the initials of his name and the date when affixed, mutilate said stamp by cutting three parallel incisions lengthwise through the stamp, beginning not more than one-fourth of an inch from one end thereof, and extending to within one-fourth of an inch of the other end.

Where such stamp is canceled by cutting or perforating in any manner authorized by existing regulations, as aforesaid, the mutilations herein provided will not be required.

This provision shall take effect and be in force on and after December 15, 1899.

G. W. WILSON,
Commissioner.

Approved:
L. J. GAGE,
Secretary.

Statutes, Construction of.

§ 861 of the Revised Statutes provides that the "mode of proof in the trial of actions at common law shall be by oral testimony and examination of witnesses in open court," and while under a state law the mode of proof may be by interrogatories addressed to the opposite party, such mode cannot be jus-

tified under § 914 of the Revised Statutes, which provides that the "practice, pleadings and forms and modes of proceeding in civil causes, in the Circuit Courts, shall conform, as near as may be, to the practice, pleadings and forms and modes of proceeding existing at the time in like causes in the courts of record of the state within which such Circuit Courts are held," for, as stated by the Supreme Court in *ex parte* Fisk, 113 U. S. 713, 5 Sup. Ct. 724, "if Congress has legislated upon this subject and prescribed a definite rule for the government of its courts, it is to that extent exclusive of any legislation of the states in the same matter." (C. C. A., 1st Cir. Apr. 12, 1899.)

LOWELL, J.] *Nat'l Cash Register Co. *v.* Leland *et al.* Same *v.* Wright *et al.*, 94 Fed. Rep. 502.

Suits.

I. ATTORNEYS.
II. COSTS.
III. LACHES.
IV. PARTIES.
V. TITLE.

I. ATTORNEYS.

Where a motion is made by complainants for a direction by the court to the former solicitors of said complainants to cancel and withdraw from the retainer of other defendants in later suits, and forbidding them during the prosecution of such later suits to accept any other retainer from such defendants the motion must be denied, for the reason that the acceptance of the later retainer was in the full belief that the former litigations had terminated, and the whole matter may be left to the solicitors themselves. The honorable obligation of a reputable member of the bar is a better assurance that professional secrets will be respected than would be an order of the court. (C. C. A., 7th Cir. Apr. 11, 1899.)

WOODS, J.] *Lalance & Grosjean Mfg. Co. *et al. v.* Haberman Mfg. Co. Same *v.* Matthai *et al.*, 93 Fed. Rep. 197.

II. COSTS.

Where the larger part of the record on both sides in a patent

suit is wholly useless, and overloaded with matter, mainly the the testimony of experts abounding in repetition and irksome and prolix disquisitions wholly irrelevant and immaterial. *Held*, that a successful defendant should be denied costs in the proportion which such testimony bears to the whole amount of evidence in the record.

COXE, J.] *Edison Electric Light Co. *v.* E. G. Bernard Co. *et al.*, 91 Fed. Rep. 694.

III. LACHES.

1. Where the owners of a patent have been reasonably diligent in prosecuting other infringers, and sustaining the validity of the patent upon two successive appeals to the circuit court of appeals, they cannot be held to have been guilty of laches in not sooner proceeding against other infringers, such as would defeat them in such suits. (C. C., S. D. N. Y. Feb. 26, 1898.)

LACOMBE, J.] *New York Filter Mfg. Co. *v.* Loomis-Manning Filter Co., 91 Fed. Rep. 421.

2. Where the owners of a patent warned a prospective infringer of their claim to a monopoly, and cautioned him against infringement, and prior to this warning suits had been instituted against another infringer, and the patent sustained both by the trial court and the court of appeals, of which suits and its results the prospective infringer was notified, and the owners instituted and prosecuted successfully other suits against other infringers and from time to time notified the prospective infringer who in the mean time had become an active infringer, of each recurring favorable adjudication, until they finally reached his case, some five years later, these facts present no case for the application of the doctrine of laches, for he had expended no money, incurred no obligations or changed no situation in reliance upon the owners' acquiescence. (C. C., E. D. Mo., E. D. Dec. 27, 1898.)

ADAMS, J.] *New York Filter Mfg. Co. *v.* Jackson, 91 Fed. Rep. 422.

3. Failure to prosecute to final judgment a suit against an insolvent infringer, who has disappeared, does not constitute

such laches as to disentitle a patentee or patent owner to recover for other and later infringements by different parties. (C. C., S. D. N. Y. Jan. 23, 1899.)

LACOMBE, J.] *Huntington Dry-Pulverizer Co. *et al.* *v.* Newell Universal Mill Co. *et al.*, 91 Fed. Rep. 661.

4. The failure of the owner of a patent at any time during a period of fourteen years to take steps to enforce his rights under the patent, during which period he had been cognizant of the extensive and increasing manufacture of alleged infringing machines, constitutes such laches as will preclude him from maintaining a suit for the infringement of such patent. (C. C. A., 2d Cir. Apr. 4, 1899.)

SHIPMAN, J.] *Richardson *v.* D. M. Osborne & Co. *et al.*, 93 Fed. Rep. 828.

5. Equity is indisposed to assist parties who have slept upon their rights, and acquiesced in their appropriation by others for a great length of time. (C. C., S. D. N. Y. May 23, 1899.)

WALLACE, J.] *La Republique Francaise *et al.* *v.* Schultz, 94 Fed. Rep. 500.

6. Where a patent owner delays bringing suit for an alleged infringement, for a period of 10 years after knowledge of such infringement and correspondence with the alleged infringer, who contended in evident good faith for such a construction of the patent as would avoid infringement, *Held*, that such laches are such as to debar not merely a claim for profits, but any claim to interposition by a court of equity. (C. C., D. Mass. July 29, 1899.)

BROWN, J.] *Starrett *v.* J. Stevens Arms & Tool Co. Same *v.* Athol Mach. Co., 96 Fed. Rep. 244.

7. Where the complainant knew that the defendant had been manufacturing the alleged infringing device for 14 years before he brought suit, *Held*, such laches are a bar to a decree for an accounting. (C. C., S. D. N. Y. Aug. 9, 1899.)

TOWNSEND, J.] *Covert *v.* Travers Bros. Co., 96 Fed. Rep. 568.

IV. PARTIES.

1. The complainant may properly maintain a suit on a pat-

ent, if he owned it when the suit was commenced and continues to own it. (C. C., S. D. N. Y. Nov. 15, 1898.)

COXE, J.] *Gormulley & Jeffery Mfg. Co. *v.* Stanley Cycle Mfg. Co. *et al.*, 90 Fed. Rep. 279.

2. The rule that a mere workman or servant who makes, uses or vends for another, and under that other's immediate supervision, a patented article, is not liable in an action for damages which may have been sustained by the patentee by reason thereof, is an exception to the general principle of law which makes all who participate in a tort of misfeasance, principals, and liable in damages therefor, and should not be so extended as to exempt from liability the general manager of a business which infringes the exclusive right of a patentee to make, use and vend the invention protected by his patent. (C. C. A., 9th Cir. Oct. 24, 1897.)

DE HAVEN, J.] *Graham *v.* Earll, 82 Fed. Rep. 737; 92 Fed. Rep. 155.

3. Where the manufacturers of an infringing article assumed the defense in a suit against the dealers in said article, without becoming technical parties thereto, and the resulting injunction ran against the dealers, their officers, trustees, etc. and "manufacturers," *Held*, that the "manufacturers" were included in the writ, not as agents and manufacturers of everybody with whom they might do business, but as agents and manufacturers of the defendant dealers, and sales of the infringing article to other dealers having no connection with or relation to the defendant dealers, do not bring the manufacturers within the prohibition of the writ. They are therefore not in contempt for continuing their sales to such other dealers. (C. C., S. D. N. Y. Feb. 24, 1899.)

WHEELER, J.] *U. S. Playing Card Co. *v.* Spalding *et al.*, 92 Fed. Rep. 368.

4. The execution of an assignment and a release by one of the joint owners of a patent of his right to damages from an infringer of the patent does not destroy the co-owner's right to recover his damages from such infringer. (C. C., S. D. N. Y. Mar. 25, 1899.)

LACOMBE, J.] *Lalance & Grosjean Mfg. Co. *et al. v.* Haberman Mfg. Co. Same *v.* Matthai *et al.*, 93 Fed. Rep. 197.

5. Where there seems to be no necessity for it, the court will not undertake at an early stage of the case by an order to make a party complainant, whose interest may be with the defendants, a defendant, but at final hearing will arrange the parties and administer relief as their respective rights may require. But should the co-complainant undertake to delay, harass or impede the orderly progress of the cause, the motion to make such co-complainant a party defendant may be renewed. *Id.*

6. In an infringement suit brought against a corporation and several individual defendants, it is not necessary to limit the decree to the joint infringement of all the defendants, but each individual defendant may be required to account for his several infringements. (C. C. A., 1st Cir. Apr. 25, 1899.)

COLT, J.] *Simonds Rolling Machine Co. *v.* Hathorn Mfg. Co. *et al.* Hathorn Mfg. Co. *et al. v.* Simonds Roll-Machine Co., 93 Fed. Rep. 958.

7. The patentees, by contract in writing, granted to complainant the exclusive right to manufacture and sell throughout the United States articles made under their patent. As this writing did not by its terms convey the exclusive right to use the patented invention, it did not amount to a transfer of the title of the patent, and must therefore be classified as a license, leaving the holder of the title a necessary party to any suit for infringement of the patent for technical reasons, although in every case of infringement by an unauthorized manufacture or sale of the patented article the complainant alone would, in equity, be entitled to all damages recovered, and if the owner of the patent refused to join the complainant in a suit against infringers he might be brought into the suit by being joined as defendant. (C. C., D. Minn. Feb. 1, 1899.)

LOCHREN, J.] *Owatonna Mfg. Co. *v.* F. B. Fargo & Co., 94 Fed. Rep. 519.

8. In a suit in equity, where the complainant has all the substantial right to the relief and to the recovery, if he omits to join a technically necessary, though really formal, party, he will be allowed to bring such party in by amendment; and where the complainant actually acquired the technical title to a patent just after the suit was begun, he was properly allowed to allege

that fact by supplemental bill. There was no longer any reason to make the prior holder of the title to the patent a party, as even in respect to the past infringements alleged, the equitable and substantial right of recovery was in the complainant alone. *Id.*

9. The specific averment as to parties composing a firm or partnership named as complainant discloses the real parties in interest and informs the respondents of the names of their adversaries. These are the parties to whom the court will resort if necessary, to compel obedience of orders and to enforce the payment of any costs awarded in favor of the respondents. (C. C., N. D. Cal. May 22, 1899.)

MORROW, J.] *Fruit Cleaning Co. *v.* Fresno Home-Packing Co. *et al.*, 94 Fed. Rep. 845.

V. TITLE.

If a party improvidently or mistakenly institutes a suit and claims that his title is of a certain character, he is not thereby precluded in another suit against other parties from claiming his true title, nor if in the latter case he should prove the claim to be true is he precluded from securing a judgment the reverse of what he may have recovered in the former suit. (C. C., D. Ind. Feb. 10, 1899.)

BAKER, J.] *Centaur Co. *v.* Robinson, 91 Fed. Rep. 889.

Testimony of Experts.

1. The court is not bound to accept the testimony of expert witnesses as conclusive, for it has the unquestioned right to draw its own conclusions from an exhibition and inspection of the machines in controversy or models thereof as well as from the opinions of such expert witnesses. It considers the facts upon which the opinions of the witnesses are based and determines from all the evidence in the case whether the conclusions given by the witnesses are sound and substantial. (C. C. A., 9th Cir. Feb. 13, 1899.)

HAWLEY, J.] *Overweight Counterbalance Elevator Co. *v.* Improved Order of Red Men's Hall Ass'n of San Francisco, 94 Fed. Rep. 155.

2. More weight is given to the testimony of a witness based

upon facts within his own knowledge and experience, than to the testimony of a witness which is largely the assertion of theory. *Id.*

3. The rule, that the trial court not only has the power but it is its duty, where the evidence is insufficient to support a verdict for the plaintiff, to instruct the jury to find a verdict for the defendant, is applicable to patent as well as other cases, and it is as applicable to the question of infringement as to any other material or controlling question involved in the case. *Id.*

4. An expert witness may describe the results of the omission of certain elements of a device, but he may not be permitted to call such an omission a "fatal fault," for the word fatal contains an inference that goes beyond the province of an expert. (C. C. A., 1st Cir. Apr. 12, 1899.)

LOWELL, J.] *Nat'l Cash Register Co. *v.* Leland *et al.* Same *v.* Wright *et al.*, 94 Fed. Rep. 502.

Trade Marks and Trade Names.

I. IN GENERAL.
II. ABANDONMENT.
III. ALTERNATIVES.
IV. ANTICIPATION.
V. ARBITRARY.
VI. ARBITRARY DESCRIPTIVE.
VII. ASSIGNMENT.
VIII. DESCRIPTIVE.
IX. ESSENTIAL FEATURES.
X. FOREIGN WORDS.
XI. GENERIC TERMS.
XII. GEOGRAPHICAL NAMES.
  (*a*) *Indicating Locality.*
  (*b*) *Used Arbitrarily or Fancifully.*
XIII. INFRINGEMENT.
  (*a*) *In General.*
  (*b*) *Particular Cases.*
XIV. INJUNCTION.

I. In General.

1. Where T was the owner and originator of a trade-mark which he used upon the entire product of his factory in England, stamped it in England upon all goods which he sold to T. L. & Co., a firm of which he was a partner, and subsequently permitted the firm to use it upon the product of their factory at Bridgeport, Conn., U. S. A., *Held*, that this licensed use in the business of a firm of a trade-mark owned by one partner does not place the trade-mark in the firm as a part of its assets. T's permission or allowance to the firm to use his trade-mark did not make it partnership property. (C. C. A., 2d Cir. Apr. 4, 1899.)

Shipman, J.] *Batcheller *v.* Thomson (2 cases).
Thomson *v.* Batcheller, 92 Fed. Rep. 660.

2. Upon the dissolution of the partnership and the transfer by T of his interest in the factory property, he could rightfully continue in the purchaser the right to use the trade-mark which he had previously permitted the firm to use in their factory. The ownership and right to a general use remained in T, the limited right to use for a limited period being continued in the purchaser individually. *Id.*

3. Where T had been continuously and still was the owner of the trade-mark and also an extensive manufacturer of the goods to which it was affixed, *Held*, that the relinquishment of a license which he had granted to another was not void, on the ground that the trade-mark, as distinct property separate from

the article created by the original manufacturer, is not the subject of sale, as it was merely the relinquishment to the owner of the right to use his own property. *Id.*

4. The function of a trade-mark is to indicate to the public the origin, manufacture or ownership of articles to which it is applied, and thereby secure to its owner all the benefit resulting from his identification by the public with articles bearing it. No other person than the owner of a trade-mark has a right, without the consent of such owner, to use the same on like articles, because by so doing he would in substance falsely represent to the public that his goods were of the manufacture or selection of the owner of the trade-mark, and thereby would or might deprive the latter of the profit he otherwise might make by the sale of the goods which the purchaser intended to buy. Where a trade-mark is infringed the essence of the wrong consists in the sale of the goods of one manufacturer or vendor as those of another, and that is the ground upon which a court of equity protects trade-marks. It is not necessary that a trade-mark should on its face show the origin, manufacture or ownership of the article to which it is applied; it is sufficient that by association with such articles in trade it has acquired with the public an understood reference to such origin, manufacture or ownership. (C. C., D. Del. May 5, 1899.)

BRADFORD, J.] *Dennison Mfg. Co. *v.* Thomas Mfg. Co., 94 Fed. Rep. 651.

5. A trade-mark may consist of a name, mark, form, brand, device or symbol, although well-known, but not previously used in connection with the same article; and subject to certain qualifications, it may consist of letters or figures. No one has a right to the exclusive use of any words, letters, figures or symbols, which have no relation to the origin or ownership of the articles to which they are applied, but only indicate their names or quality. *Id.*

6. Nothing can be legally appropriated by any one as a trade mark which, aside from superiority in excellence, popularity or cheapness of the articles bearing it, would practically confer upon him a monopoly in the production or sale of like articles. *Id.*

7. A trade mark is designed to enable one to legitimately

build up or protect his business, but not to deprive others of the right to use necessary or proper means for carrying on an honorable competition in trade. *Id.*

8. No one has the right to appropriate a sign or a symbol which, from the nature of the fact it is used to signify, others may employ with equal truth, and therefore have an equal right to employ for the same purpose. Hence, no one can acquire an exclusive right to the use, as a trade mark, of a generic name or word which is merely descriptive of an article or a sign, symbol, figure, letter, brand, form or device, which either on its face or by association, indicates or denotes merely grade, quality, class, shape, style, size, ingredients or composition of an article, or a word or words in common use designating locality, section or region of country. *Id.*

9. The word "quality" is used in different senses in the different cases. It is employed in some to denote grade, ingredients or properties of an article, and in others to indicate generally the merit or excellence of an article as associated with or coming from a certain source. While there can be no valid trade-mark as denoting quality when used merely in the former sense, there may be a valid trade-mark as indicating quality when used in the latter sense. *Id.*

II. ABANDONMENT.

1. In view of the continued and increasing appropriation by competitors of his label and of his trade name (as a general designation) a complainant who has for nine years done nothing towards maintaining or even asserting his original rights cannot be heard to suppress the competition which his supineness has has allowed, and even invited and encouraged to grow up. The delay or acquiescence has continued so long and under such circumstances as to defeat the right itself. (C. C. A., 2d Cir. Jan. 5, 1899.)

LACOMBE, J.] *Saxlehner *v.* Eisner & Mendelsohn Co. Same *v.* Siegel Cooper Co. Same *v.* Gies. Same *v.* Marquet, 91 Fed. Rep. 537.

2. The provisions of a treaty with a foreign country are not to be construed as to hold that when the public in this country has acquired through the owner's laches the right to use a trade

name and a trade-mark, such right is abrogated whenever, by the operation of some subsequent law of such foreign country, the trade name and trade-mark is secured to him in such foreign country. (C. C. A., 2d Cir. Jan. 25, 1899. On motion for re-argument.) *Id.*

III. ALTERNATIVES.

1. It is well settled that a picture and a word cannot be covered by one registration unless they are true alternatives. (Mar. 30, 1899.)

DUELL, J.] *Ex parte* Muir, 87 O. G. 357.

2. The representation of a rose and the words "American Beauty" are not true alternatives and cannot be registered as one trade-mark. *Id.*

IV. ANTICIPATION.

1. The word "Dyspepticide" refused registration as at rademark for certain named medicinal preparations as it is anticipated by the registered mark "Dyspepticure" for the same class of goods. (Apr. 29, 1899.)

DUELL, C.] *Ex parte* Foley & Co., 87 O. G. 1957.

2. The differences either to the eye or ear are no greater between "dyspepticure" and "dyspepticide" than between "saponite" and "sapolio," or between "cellonite" and "celluloid," or between "wamyesta" and "wamsutta," or between "maizharina" and "maizena." Between such words the courts have found "infringing resemblances." *Id.*

3. Where it was contended that as the endings of "dyspepticure" and "dyspepticide" are distinctly different and have different meanings and therefore the mark of the application should be registered, *Held*, that in order to correctly decide whether or not an alleged trade-mark is likely to cause confusion or mistake because of its resemblance to a registered lawful mark, the marks must be taken as a whole. In the case of a word the ordinary purchaser is not expected to analyze it and resolve it into its component parts. It is only required that the purchaser should consider the word as an entirety. *Id.*

V. ARBITRARY.

Where the examiner refused to register the word "Otaka" as

a trade-mark for biscuits on the ground that it so nearly resembled the mark "Uneeda" already registered as to be likely to cause confusion in the mind of the public, *Held*, that the differences between the appearance and sound of the two words are marked, as is also the idea conveyed by them, and that the word should be registered. (Oct. 23, 1899.)

DUELL, C.] *Ex parte* Lorenz, 89 O. G. 2067.

VI. ARBITRARY, DESCRIPTIVE.

1. Applicant having filed an affidavit that the words "Royal Blue" are not descriptive of the general color of the carpet-sweeper in connection with which the words are used. *Held*, that these words when so applied to carpet-sweepers as not to be indicative of the color of the sweepers cannot be refused registration, as they have an arbitrary suggestive meaning. (May 12, 1899.)

DUELL, C.] *Ex parte* Grand Rapids School Furniture Company, 87 O. G. 1957.

2. The general principle upon which registration has been refused by this Office for words used deceptively is, that a fraud is practiced upon the public. Examples are numerous—"Tamarac Balsam" for a medical compound in which admittedly no tamarac was used; "American Sardines" as a mark for fish of another kind. The general rule is that words should not be registered whenever it clearly and distinctly appears that the proposed trade-mark constitutes a misrepresentation of such a character that the courts would not protect. (*Ex parte* Bloch & Co., 40 O. G. 443.) *Id.*

3. Where an applicant sought to register as a trade-mark for powdered soap "the picture of a bag having the open end thereof held closed by a tie," *Held*, that the mark is either descriptive or deceptive and cannot be registered. (Nov. 13, 1899.)

GREELEY, A. C.] *Ex parte* Martin, 87 O. G. 2259.

4. The objection to registering a descriptive mark is not alone on the ground that it does in fact describe the goods to which an applicant actually attaches it, but because others have the right to use the same mark to describe their goods, and

therefore the exclusive right to the mark cannot be given to one person. *Id.*

5. The mark may not be descriptive of the particular goods sold by an applicant; but at the same time it may be descriptive of similar goods sold by another party, and that other party cannot be prevented from using that descriptive mark on his goods. *Id.*

6. While letters and figures arbitrarily may not, and often do not, of themselves indicate shape, size, grade or quality, yet if they be attached to articles to distinguish different shapes, sizes, styles, grades or qualities, they may become by association just as descriptive as words expressly defining the same. (C. C., D. Del. May 5, 1899.)

BRADFORD, J.] *Dennison Mfg. Co. *v.* Thomas Mfg. Co., 94 Fed. Rep. 657.

VII. ASSIGNMENT.

Every trade-mark is assignable, together with the business in which it is used, unless it is strictly personal, and if a trade-mark belongs to the class of assignable trade-marks, it is transferred, by the operation of the insolvency or bankrupt laws, to the assignee, as part of the bankrupt's assets. (C. C. A., 5th Cir. Apr. 11, 1899.)

PARDEE, J.] *Sarrazin *v.* W. R. Irby Cigar & Tobacco Co., Lim., 93 Fed. Rep. 624; 88 O. G. 387.

VIII. DESBRIPTIVE.

1. The words "Bromo Soda Mint" refused registration as a trade-mark for remedies for certain named diseases, as they are indicative of the ingredients and characteristics of the preparation to which they are applied, as any one reading said words would gather that soda-mint, an article well-known to pharmacists, is combined with bromin or a bromid. (Nov. 26, 1898.)

DUELL, C.] *Ex parte* Spayd, 86 O. G. 631.

2. The phrase "Apple and Honey" is descriptive. It may not be *entirely* descriptive, but it is sufficiently so under the decisions of the Federal courts to compel me to refuse registration. The case most in point is that of Brown Chemical Co. *v.* Meyer (55 O. G. 287; 139 U. S. 540, 542). It is there said:

The general proposition is well established that words which are merely descriptive of the character, qualities or composition of an article, or of the place where it is manufactured or produced, cannot be monopolized as a trade-mark (Canal Company *v.* Clark, 13 Wall. 311; Amoskeag Manufacturing Company *v.* Trainer, 17 O. G. 1217; 101 U. S. 51; Caswell *v.* Davis, 35 N. Y. 281; Thomson *v.* Winchester, 19 Pick. 214; Raggett *v.* Findlater, L. R., 17 Eq. 29); and we think the words "Iron Bitters" are so far indicative of the ingredients, characteristics and purposes of the plaintiff's preparation as to fall within the scope of these decisions.

"Iron Bitters" are no more indicative than are "Apple and Honey" as used by applicants. (Mar. 4, 1899.)

DUELL, C.] *Ex parte* G. F. Heublein & Bro., 87 O. G. 179.

3. The words "Chill Stop" refused registration as a trade-mark for chills and fever, malaria, and intermittent fever, as they express a quality of the article upon which they are used. (Mar. 7, 1899.)

DUELL, C.] *Ex parte* Hance Bros. & White, 87 O. G. 698.

4. While the arrangement of the words "Chill Stop" is somewhat different from the ordinary and they do not express quality in the most grammatical form, they being catchy and slangy, they are nevertheless descriptive as well as advertising. (*Ex parte* Brigham, 20 O. G. 891, cited.) *Id.*

5. The rearrangement of descriptive words in common use cannot clothe them with attributes not possessed when not so arranged. *Id.*

IX. ESSENTIAL FEATURES.

1. The words "Nickel Soap" cannot be registered as a trade-mark, as the word "Soap" is merely the name of the goods to which the mark is applied and is made the essential feature of the mark. (Apr. 27, 1899.)

DUELL, C.] *Ex parte* Butler, 87 O. G. 1781.

2. The word "nickel" as applied to soap does not indicate the price at which the soap is sold and may be registered as a trade-mark. *Id.*

3. Nickel is the name of a metal, and it is not robbed of its primary significance by the fact that in some localities it has a secondary meaning in that it is used as a name for a coin. This subordinate or fanciful meaning does not bar its adoption and use as a trade-mark for soap. The words "eagle" and "crown" have been held to be subject to exclusive appropriation as lawful trade-marks, and yet they have a subordinate or

secondary meaning in that certain coins are designated and known by such names. *Id.*

4. Tested by the definitions given to the term "trade-mark" and applying the rules laid down as guides, it is *Held*, that the term "Ever-Ready," plainly meaning *always ready*, as applied to a domestic coffee-mill intended for ordinary and daily household use is not a trade-mark, in that it lacks the essential characteristics of individuality and exclusiveness. (May 18, 1899.)

DUELL, C.] *Ex parte* The Bronson Company, 87 O. G. 1782.

5. The facsimile of the mark presented for registration discloses the flag of the United States crossed diagonally by a band or panel, upon which appears the word "Standard," and distributed about the flag are stars, the whole being inclosed in concentric circles, between which appear the words "Standard Fashion Company, New York." The essential features are recited as consisting of "the representation of a standard or flag and a number of stars distributed about the standard or flag;" *Held*, that as presented the mark is not registrable. (Sept. 19, 1899.)

DUELL, C.] *Ex parte* Standard Fashion Co., 89 O. G. 189.

6. *Held*, further, that the band or panel diagonally crossing the flag gives to it a distinctive feature, and the examiner was justified in holding it to be an essential feature of applicant's mark. *Id.*

7. *Held*, further, that none of the words can properly be said to constitute an essential feature of the mark, and they are not so claimed. *Id.*

8. *Held*, further, that the concentric circles are merely accessories, but but not essential features, and to insist upon their being included in the statement of essential features might tend to the injury of applicant and the benefit of an infringer. *Id.*

9. The essential feature of a trade-mark is not that which the applicant elects to designate as such, but that which would strike the public mind as its most salient feature. *Id.*

X. FOREIGN WORDS.

1. The words "Gold Label," which are unregistrable in Eng-

lish characters, do not become registrable when produced in Hebrew characters, although there may be no words in the Hebrew language corresponding to these English words. (Dec. 22, 1899.)

DUELL, C.] *Ex parte* Stuhmer, 86 O. G. 181.

2. The fact that the English words "Gold Label" are produced in Hebrew characters, which may be illegible to the majority of English-speaking people, is no reason why such words may become subject to adoption as a lawful trade mark. *Id.*

3. The word "Matzoon" (or "Madzoon") having been used in Armenia for centuries to designate an article of food or diet made from sterilized and fermented milk, cannot be appropriated as a trade mark by the person who introduced both the name and the article into this country; nor can the defendants be enjoined on the theory that the word has become, in a special and secondary sense, a mark of the origin of complainant's goods, where the defendant's label clearly distinguishes their own product from that of complainant. (C. C., D. Mass. Dec. 1, 1898.)

COLT, J.] *Dadirrian *v.* Yacubian *et al.*, 90 Fed. Rep. 812.

XI. GENERIC TERMS.

A term which can be truthfully used by many in the description of a business or occupation cannot be exclusively appropriated by any one of them. The word "Continental" is a generic term, and it is not the policy of the law to permit the exclusive appropriation of words or terms which are generic; that is, which pertain to a class of related things, and which are of general application. The right to use such words should remain vested in the public. (C. C., N. D. Texas. Oct. 10, 1899.)

MEEK, J.] *Continental Ins. Co. *v.* Continental Fire Ass'n, 96 Fed. Rep. 846.

XII. GEOGRAPHICAL NAMES.

(*a*) *Indicating Locality.*

1. The name "Bowdoin," being the name of a township in Maine, the name of a college (situated in the same state), which

was named after James Bowdoin, is both geopraphical and a surname, and therefore refused registration. The fact that "Bowdoin" is the name of a college does not serve to make an exception of the word. If it did, then "Columbia," "Cornell" and names of other well-known colleges would be subject to exclusive appropriation, although such words are geographical or surnames. (Nov. 29, 1899.)

DUELL, C.] *Ex parte* Shaw, Hammond & Carney, 68 MS. Dec. 229.

2. While the word "Gibraltar" has a certain arbitrary and fanciful meaning, implying firmness and strength, yet that is secondary to its geographical meaning, and it should not be registered as a trade-mark. (Feb. 23, 1899.)

DUELL, C.] *Ex parte* Nave & McCord Mercantile Co., 86 O. G. 1985.

3. The fact that no one carries on the manufacture of goods at any of the places named Gibraltar should not be controlling, as the applicant by appropriating the word cannot bar another who may hereafter manufacture goods at Gibraltar from marking his goods with that word. *Id.*

4. The name "Vichy" is not a trade-mark or trade-name in the strict legal sense of the term, but is a geographical name applied by the various owners of mineral springs at or near Vichy, France, to designate the locality of origin, and indicate the general characteristics of the waters. A suit by such owners can therefore be maintained against a defendant who applies the name to artificial waters, only upon the theory of unfair competition. (C. C., S. D. N. Y. May 23, 1899.)

WALLACE, J.] *La Republique Francaise *et al.* *v.* Schultz, 94 Fed. Rep. 500.

5. It is not now a question that no one can acquire an exclusive right to the use of geographical names as trade-marks, as that question has been settled by a long line of court decisions. (C. C. A., 7th Cir. June 6, 1899.)

JENKINS, J.] *Illinois Watch Case Co. *et al.* *v.* Elgin Nat'l Watch Co., 94 Fed. Rep. 667; 87 O. G. 2323.

6. The decision of the court below sustaining the bill upon the ground that the word "Elgin" had acquired a secondary sig-

nification, and through a long course of business had come as applied to watches to designate the manufacture of appellee as an article of approved excellence, and that therefore the word in that connection performed distinctly the function of a trade-mark, and could be registered and upheld as such under the act of Congress, *Held*, to be erroneous and that the word "Elgin" was not and could not be made a trade-mark. (Elgin Watch Co. *v.* Illinois Watch Case Co., 89 Fed. Rep. 487, Sand. Pat. Dig. 1898, 145, reversed.) *Id.*

XII. Geographical Names.

(*b*) *Used Arbitrarily or Fancifully.*

1. On appeal from the decision of the examiner refusing to register the word "Hansa" as a trade-mark for lard, sausages and bacon on the ground that as it is the name of a trading league comprising the cities of Hamburg, Lubeck, and Bremen, known as "the Hansa," it is geographical in character, *Held*, that the word has no such geographical character to-day as would forbid its registration. (June 10, 1899.)

Duell, C.] *Ex parte* Tietgens & Robertson, 87 O. G. 2117.

2. As the word "Hansa" was registered in Germany under the German law, which prohibits registration of words which are of a geographical character, any doubt of the propriety of registering it here should be waived, as the German Patent Office is eminently qualified to pass upon the question of the geographical character of the word, and its decision is entitled to respect, although in no manner controlling. (Carter *v.* Wollschlaeger, 53 Fed. Rep. 573, cited.) *Id.*

A word-symbol to be refused registration because of its geographical character must refer to some specific locality. *Id.*

3. The words "Buffalo Pitts" as a trade-mark for agricultural machinery refused registration, the word "Pitts" being an ordinary surname and a salient feature of applicant's name and the word "Buffalo" being a geographical term and also a part of applicant's name, it being well settled that ordinary surnames and geographically-descriptive words are not registrable. (Nov. 24, 1899.)

Duell, C.] *Ex parte* Buffalo Pitts Co., 89 O. G. 2069.

XIII. INFRINGEMENT.

(a) In General.

No one, who has counterfeited a legitimate trade-mark and applied the spurious symbol in competition with the genuine, can avoid the charge of infringement by showing that the false mark has, in practice, been so accompanied, on labels, capsules or otherwise, by trade-names, designations, descriptions or other accessories, not forming part of it, as to render it unlikely that the public has been deceived. Such a showing, while it may effect the nature or measure of the relief to be granted cannot defeat a suit for infringement. (C. C., D. N. Jer. Aug. 5, 1899.)

BRADFORD, J.] *Bass, Ratcliff & Gretton, Lim. *v.* Christian Feigenspan, 96 Fed. Rep. 206.

XIII. INFRINGEMENT.

(b) Particular Cases.

1. The word "Uneeda" as applied to a biscuit is a proper trade-mark, and the owner thereof is entitled to an injunction against the use of the word "Iwanta" when applied by another to a similar biscuit put up and sold to dealers in similar packages such as would be likely to deceive the public. It is immaterial that the dealers themselves are not deceived. No one expects they will be. It is the probable experience of the public that the court considers. (C. C., S. D. N. Y. June 27, 1899.)

LACOMBE, J.] *Nat'l Biscuit Co. *v.* Baker *et al.*, 95 Fed. Rep. 135.

2. The complainant's trade-mark for pale-ale, consisting of an equitateral triangular figure, which, as applied to bottled pale-ale, is colored red, is infringed by the defendant's mark as applied to pale-ale and half-and-half, consisting of a red triangle nearly equilateral, a narrow gold border surrounding and binding it, a monogram composed of the letters C and F in the middle, and some fine scroll ornamentation in the middle. (C. C., D. N. Jer. Aug. 5, 1899.)

BRADFORD, J.] *Bass, Ratcliff & Gretton, Lim. *v.* Christian Feigenspan, 96 Fed. Rep. 206.

3. Courts should not be astute to recognize in favor of a trade-mark infringer, fine distinctions between different articles of merchandise of the same general nature, and should resolve against the wrongdoer any fair doubt whether the public may or may not be deceived through the the application of the spurious symbol; and hence, pale-ale and half-and-half must, as against an infringer of a trade-mark for the former, be treated as malt liquors substantially similar to each other and belonging to the same class. *Id.*

XIV. INJUNCTION.

1. The soap sold by the defendants is like that of the complainants in shape and size, and in the mark "a base de Glycerine." It differs however in color and has for a distinctive name "Rose de France" instead of "La Parisienne." It has not been made to appear that any one has been deceived or induced by similarity to buy the soap sold by the defendants for that of the complainants, and the facts presented do not furnish a sufficient ground upon which to base a right to a preliminary injunction restraining defendants from selling soap such as described, upon the ground of deceit, or that by so doing they unfairly compete in trade with the complainants. (C. C., D. N. J. May 15, 1899.)

KIRKPATRICK, J.] *Kroppf *et al.* *v.* Furst *et al.*, 94 Fed. Rep. 150.

2. He who applies a false trade-mark has no just cause of complaint if he is prevented from further violating the exclusive right of the lawful employer of the genuine symbol, and he should not be allowed, at the peril of the latter, fraudulently to experiment in the use of such false mark with accessories of varying character, with the double purpose of filching the custom of a business rival, and at the same time shielding himself from the consequences of infringement. (C. C., D. N. Jer. Aug. 5, 1899.)

BRADFORD, J.] *Bass, Ratcliff & Gretton, Lim. *v.* Christian Feigenspan, 96 Fed. Rep. 206.

3. Relief by injunction is sometimes granted in cases where the party enjoined is using as a trade-mark or distinguishing name which is geographical or descriptive in character, and

therefore could not be exclusively appropriated by the party securing the relief, but the relief is granted, not because of an exclusive right to appropriate such words, but because of fraud and deception in their adoption, and similar methods of their use with the purpose and intention of attracting customers away from rivals in business. (C. C., S. D. Texas. Oct. 10, 1899.)

MEEK, J.] *Continental Ins. Co. *v.* Continental Fire Ass'n, 96 Fed. Rep. 846.

4. Where, in a suit to enjoin the infringement of a trade-mark, no allegation or showing is made as to any insolvency of defendant, and no showing of irreparable injury to plaintiff as liable to occur during the pendency of the suit, nor that the output of defendant's works is so great as materially to affect the market as against plaintiff's output, meanwhile, *Held*, that a preliminary injunction should not issue without strong showing therefor, and especially where the right to relief prayed for is squarely put in issue, and result not clear beyond the pleadings, and where its issuance would tend to disturb the established and long-continued business of a manufacturing concern. (C. C., S. D. Iowa C. D. Sept. 12, 1899.)

WOOLSON, J.] *E. T. Fairbanks & Co. *v.* Des Moines Scale & Mfg. Co., 96 Fed. Rep. 972.

XV. INTERFERENCE.

1. It is not an essential and important prerequisite that a mark should be *affixed* or *attached to* the goods with which it is used to make it a valid trade-mark. It is sufficient if the mark is so *associated with* the goods as to distinguish them by the particular mark. (Jan. 27, 1899.)

DUELL, C.] Hay & Todd Mfg. Co. *v.* Querns Bros., 86 O. G. 1323.

2. Where a mark was used by a company and it became recognized by the trade as the distinguishing mark of its goods, although not actually affixed thereto, *Held*, that it is in a position to invoke the aid of equity for the protection of its rights. *Id.*

3. Where the mark in question had been so associated with the goods of the junior party, although not actually affixed thereto, that they had become known to the trade by that

mark, it would be an injustice to award priority to its adversary, who actually affixed the mark to the goods, but was the later to adopt it. *Id.*

4. Where an interference was declared between an application of B, for the registry of the words "American Volunteer" for men's boots and shoes, and an application of R for the registry of the word "Volunteer" for overshoes, the issue being stated to be "The word 'Volunteer,' for overshoes," *Held*, that the issue in respect to the class of goods is narrower than the class of goods upon which B uses his mark, and under the rule in Hernsheim *et al. v.* Hargrave *et al.* (81 O. G. 503) there has been such irregularity in declaring the interference that it should be dissolved. (Oct. 13, 1899.)

DUELL, C.] Joseph Bannigan Rubber Co. *v.* Bloomingdale, 89 O. G. 1670.

5. *Held*, further, that as the parties have taken testimony and the case has been submitted on final hearing, and as there is no dispute as to the facts disclosed by the record, no good purpose would be subserved by directing the examiner to redeclare the interference; but it is decided that as B had used the words "American Volunteer" in connection with men's shoes before R used the word "Volunteer" in connection with overshoes, he is entitled as between the two to have the mark registered. *Id.*

6. *Held*, further, that whether or not R is entitled to have his mark "Volunteer" registered for use in connection with overshoes is an *ex parte* question to be determined in the first instance by the examiner. *Id.*

XVI. JURISDICTION OF COURTS.

1. In the case of the infringement of a trade-mark existing at the common law, or in cases of unfair trade, in order to confer jurisdiction upon the courts of the United States, there must exist diverse citizenship of the parties, and that diverse citizenship must appear upon the record. The term "inhabitant" or "resident" does not necessarily imply "citizenship" and cannot be substituted for it. (C. C. A., 7th Cir. Nov. 11, 1898.)

JENKINS, J.] *Allen B. Wrisley Co. *v.* Geo. E. Rouse Soap Co. *et al.*, 90 Fed. Rep. 5.

2. In the absence of the proper allegations of citizenship, in order to bring the case within the provisions of the statute (21 Stat. 502) there must be a showing that the trade-mark involved is used upon goods intended to be transported to a foreign country, or in lawful commercial intercourse with an an Indian tribe. Otherwise, the federal courts are without jurisdiction. *Id.*

3. The fact that the word "Elgin" had acquired a secondary signification might be forceful if the word were shown to be used to palm off the goods of one as the goods of another, which, coupled with other evidence evincing intent to mislead and defraud, would be operative to move a court of equity to prevent the wrong, and the Federal Court would not have jurisdiction in such case unless there exist and appear from the record the necessary diverse citizenship of the parties. The remedy for fraud existed before the statute relating to trade-marks and was not given by it, but recognizing the invalidity of the trade-mark was applied for the prevention of fraud. (C. C. A., 7th Cir. June 6, 1899.)

JENKINS, J.] *Illinois Watch Case Co. *et al. v.* Elgin Nat'l Watch Co., 94 Fed. Rep. 667; 87 O. G. 2323.

4. The courts of the state furnish ample remedy for the wrong, if any, under which the appellee suffers, and the Federal Courts have no right to redress or prevent trespass upon the common-law rights of the appellee, the citizenship of the parties forbidding jurisdiction. If it were allowable to a Federal Court to assume jurisdiction to grant equitable relief upon the ground of fraud, the relief could only extend in restraint of the wrong so far as it affected foreign commerce and commerce with the Indian tribes. *Id.*

XVII. PRACTICE IN THE PATENT OFFICE.

1. It is incumbent upon the various tribunals of the Patent Office having in charge the registration of trade-marks when an application for registration is filed to decide at the outset two questions: (1) Is applicant the owner, and (2) is that which he seeks to register a trade-mark? (May 18, 1899.)

DUELL, C.] *Ex parte* The Bronson Company, 87 O. G. 1782.

2. The tribunals of the Patent Office in deciding the question of ownership are not precluded by the statement and declaration of ownership made by the applicant from considering and deciding whether he is or is not the owner of the thing sought to be registered. *Id.*

3. It is the province and duty of the tribunals of the Patent Office having jurisdiction of the registration of trade-marks to decide whether the thing presented for registration is a trade-mark. An applicant may be the owner of the thing alleged to be his trade-mark, and yet the thing presented for registration may not be a trade-mark. The statement and declaration of applicant that the thing presented for registration is a trade-mark are not conclusive. *Id.*

XVIII. REGISTRATION.

1. An association of manufacturers which as an association does not make, brand, or sell the article of merchandise in connection with which the trade-mark is used is not entitled under the Act of March 3, 1881, to register a trade-mark. (Feb. 3, 1899.)

DUELL, C.] *Ex parte* The Anti-Adulteration League, 86 O. G. 1803.

2. The right to register a trade-mark in the Patent Office is a statutory one, and the action of the Office in registering trade-marks is limited by the terms of the Acts of March 3, 1881, and August 5, 1882. The latter act need not be considered, and if there is a statutory right vested in appellant to register the mark it must be found in the Act of March 3, 1881. By that act it is provided—

that the owners of trade-marks used in commerce with foreign nations or with the Indian tribes, provided such owners shall be domiciled in the United States or located in any foreign country or tribe, which, by treaty, convention, or law, affords similar privileges to citizens of the United States, may obtain registration of such trade-marks by complying with certain requirements.

Section 2 provides that the statement which is to be recorded must be accompanied by—

a written declaration verified by the person, or by a member of a firm, or by an officer of a corporation applying, to the effect that such party has at the time a right to the use of the trade-mark sought to be registered, and that no other person, firm or corporation has the right to such use, either in the identical form or in any such near resemblance thereto as might be calculated to deceive.

Authority is vested in the Commissioner to decide the presumptive lawfulness of claim to the alleged trade-mark. *Id.*

3. While appellant has *adopted* the mark, and without doubt is entitled to it, yet within the meaning of the term "*owners*" as employed in the trade-mark act it does not own the mark. The only ownership vested in appellant is that which arises from the adoption, and that under the law is not sufficient. Adoption must be followed by use. *Id.*

4. There is no authority in the trade-mark act permitting the Patent Office to register a trade-mark the right to use which is farmed out and which is not actually used by the would-be registrant. *Id.*

5. The Office should not register a composite trade-mark all the features of which are objectionable either as being anticipated or not a proper subject for registry. (Feb. 15, 1899.)

DUELL, C.] *Ex parte* Guenther Milling Co., 86 O. G. 1986.

XIX. RIGHT TO USE NAME OF PATENTED ARTICLE.

1. The patent under which the medicine known by the name of "Castoria" was manufactured and sold having expired in 1885, the name which was descriptive of the article became public property and no trade-mark right exists therein, nor could such right be acquired by subsequent use. The right to manufacture Castoria and the right to use the name in selling it are both public property. (Singer Mfg. Co. *v.* June Mfg. Co., 163 U. S. 169; 16 Sup. Ct. 1002.) (C. C., W. D. Mo. W. D. Feb. 6, 1899.)

PHILLIPS, J.] *Centaur Co. *v.* Marshall *et al.*, 92 Fed. Rep. 605.

2. Where the trade-mark antedated the patent relating to the article to which the trade-mark was applied by more than 2½ years, and so far as can be seen, it was the name and not the patent which gave value to the article. *Held*, that the exclusive right to use the trade-mark did not cease upon the expiration of the patent. (C. C. A., 2d Cir. Apr. 4, 1899.)

SHIPMAN, J.] *Batcheller *v.* Thomson (2 cases).
Thomson *v.* Batcheller, 93 Fed. Rep. 630.

XX. Right to Use Personal Name.

1. The word "'Featherstone' in script letters, in a diagonal line, and with a forwardly-extending understroke or flourish," is merely the name of the applicant and is not registrable in view of section 3 of the trade-mark act of March 3, 1881. (Jan. 27, 1899.)

Duell, C.] *Ex parte* A. Featherstone & Co., 86 O. G. 1497.

2. The name of an applicant does not cease to be merely the name of the applicant because it is in script letters and disposed diagonally. Its use is an attempt to appropriate that which cannot be lawfully appropriated against others of the same name. *Id.*

3. Where an applicant sought to register as a trade-mark the words "Guenther's Best" surrounded by the representation of a circular belt or zone bearing a wreath of wheat-ears, *Held*, that the mark should not be registered, as "Guenther" is an ordinary surname and the salient feature of applicant's name, while the word "Best" is descriptive, and that the circular belt or zone cannot impart any registrable quality to the symbol, as the belt or zone is non-essential. (Feb. 15, 1899.)

Duell, C.] *Ex parte* Guenther Milling Co., 86 O. G. 1986.

4. "While the right can be denied to no one to employ his name in connection with his business, or in connection with articles of his own production, so as to show the business or product to be his, yet he should not be allowed to designate his article by his own name in such way as to cause it to be mistaken for the manufacture or goods of another already on the market under the same or a similar name. Whether it be his name or some other possession, every one, by the familiar maxim, must so use his own as not to injure the possession or rights of another." (C. C. A., 7th Cir. Jan. 3, 1899.)

Jenkins, J.] *Stuart *v.* F. G. Stewart Co. *et al.*, 91 Fed. Rep. 243.

5. A man may not use his own name to accomplish a fraud, designed or constructive. **Id.*

6. A man has no right to use his own name, if he uses it in such a way as that he misleads the public, to their injury, by imposing upon them articles of his manufacture as those man-

ufactured by somebody else, who has a prior right to use the same name as his. (C. C., D. Ind. Feb. 10, 1899.)

BAKER, J.] *Centaur Co. *v.* Robinson, 91 Fed. Rep. 889.

7. While one cannot obtain the exclusive right to use a geographical name as a trade-mark, and cannot make a trade mark of his own name to deprive another of the same name from using it in his business, that other may not resort to artifice to do that which is calculated to deceive the public as to the identity of the business or of the article produced and so create injury to the other beyond that which results from the similarity of the name. (C. C. A., 7th Cir. June 6, 1899.)

JENKINS, J.] *Illinois Watch Case Co. *et al.* *v.* Elgin National Watch Co., 94 Fed. Rep. 667; 87 O. G. 2323.

8. This doctrine does not proceed upon the ground of the infringement of a trade-mark, but upon the ground of fraud, and that equity will not permit one, aside from any question of trade-mark, to palm off his goods as the goods of another and so deceive the public and injure that other. **Id.*

9. It is not necessary in such cases in order to give a right to an injunction that a specific trade-mark should be infringed, but that the conduct of the party should show an intent to palm off his goods as the goods of another. The allegations respecting trade-marks are in such cases only "regarded as matter of inducement leading up to the question of actual fraud." **Id.*

XXI. STATUTE, CONSTRUED.

1. The phrase "owners of trade-marks" appearing in the act of March 3, 1884, manifestly limits the right of registration to such person or persons, natural or artificial, as possess the legal title to that for which registration is sought, and it further limits the right of registration to that which is a trade-mark. (May 18, 1899.)

DUELL, C.] *Ex parte* The Bronson Company, 87 O. G. 1782.

2. There is nothing in section 13 of the trade-mark act which takes this case outside the authorities because registration is desired for the purpose of registering the alleged trade-mark in

a foreign country, where as a condition precedent to such foreign registration prior registration in the home country of the applicant must first be had. (Nov. 24, 1899.)

DUELL, C.] *Ex parte* Buffalo-Pitts Co., 89 O. G. 2069.

3. No additional rights are conferred upon citizens and residents of this country under section 13 of the trade-mark act which are not conferred upon them under the other provisions of the act. *Id.*

4. A foreigner is not entitled to any other or further rights than those given to citizens of the United States. The phrase "as is above allowed to foreigners" renders section 13 of the trade-mark act meaningless. *Id.*

5. Congress did not intend to permit the registration of unlawful trade-marks simply for the purpose of permitting the owner of such unlawful trade-marks to register the same in a foreign country. *Id.*

6. The trade-mark act does not make the Patent Office merely a registration office and compel the Commissioner to register a trade-mark without permitting him to pass upon the lawfulness of the trade-mark presented for registry. *Id.*

7. The registry of a trade-mark under the Act of Mar. 3, 1881, neither adds anything to nor takes anything from the right of ownership in such trade-marks, and in a suit not pitched upon the statute (*i. e.*, in a suit between citizens of different states, alleging infringement generally, covering state and interstate commerce) the fact that the trade-mark is registered *vel non*, is a matter of utter irrelevance, for the act above referred to only makes registry *prima facie* evidence of ownership. Trade-marks do not lie in the sphere of patents and copyrights. The former are common law rights of property in devices used in trade to indicate origin, quality, grade or source of manufacture of certain articles, while the latter are governmental grants of exclusive privileges, and the federal government has sole and exclusive legislative authority over them. (C. C. A., 5th Cir. Apr. 11, 1899.)

PARDEE, J.] *Sarrazin *v.* W. R. Irby Cigar & Tobacco Co. Lim., 93 Fed. Rep. 624. 88 O. G. 387.

8. The constitutionality of the trade-mark act approved

March 3, 1881, held to be fairly doubtful. (C. C. A., 7th Cir. June 6, 1899.)

JENKINS, J.] *Illinois Watch Case Co. *et al.* *v.* Elgin Nat'l Watch Co., 94 Fed. Rep. 667. 87 O. G. 2323.

9. The trade-mark act does not define what shall constitute a trade-mark. To determine what the trade-mark is which is protected by the act, reference must be made to the common law. **Id.*

XXII. UNFAIR COMPETITION.

1. The defendant's use of boxes or cartons similar to the plaintiff's and nothing more, could not be complained of, for it is a common method of packing various articles of merchandise; and even if the complainant was the first to apply it to packing catsup, he has not thereby obtained a monopoly of its use for that purpose. Where the question as to whether the imitation of packages, boxes and stamps complained of is such as is likely to impose on ordinary purchasers, exercising such care only as is commonly used in purchasing such articles, cannot be answered with certainty or safety, in the absence of proof that any one has actually been misled, a motion for a preliminary injunction was properly denied. (C. C. A., 3d Cir. Nov. 28, 1898.)

BUTLER, J.] *Van Camp Packing Co. *v.* Cruikshanks Bros. Co. 90 Fed. Rep. 814.

2. Complainants originated, and have for many years used, a rose or brilliant copper-colored soft metal capsule embossed with their name, and other devices as a distinguishing mark for their wine; and by reason of the practice of serving such wine from an ice-chest or in coolers, the bottle is liable to lose its labels before it is shown to the customer, so that in such case the capsule is the only easily-available means of identification. Defendants are not producers or dealers in champagne, but make and sell bottlers' supplies.—The widespread use of colored capsules among producers of champagne, however, does not preclude protection to each separate producer in the use of his own color without depriving some new comer of the right himself to select and use a colored capsule. The possible combinations of color are so manifold that it is hard to conceive how such new comer, honestly endeavoring to dress his goods

in such wise as to mark them as his own, could experience any difficulty in devising a new capsule. Complainants are not entitled to a decree enjoining the sale merely of a rose-colored capsule, unembossed, or even with the words "Extra Dry" impressed thereon, though of the same size and shape, in the absence of evidence that it was not used in a manner to deceive customers to complainants' damage, where it is capable of such a use as not to injure complainants. (C. C. A., 2d Cir. Dec. 7, 1898.)

PER CURIAM.] *Von Mum *et al. v.* Witteman *et al.*, 91 Fed. Rep. 126.

3. Where a wrapper for a medicine package contains an erroneous statement as to the general character of the contents of the package, but truthfully gives the formula in accordance with which the medicine is made, it does not constitute such fraud as will defeat the manufacturer's right to relief from unfair competition. (C. C., D. Ind. Feb. 10, 1899.)

BAKER, J.] *Centaur Co. *v.* Robinson, 91 Fed. Rep. 889.

4. If the Centaur Co. through years of experience and labor in building up a trade, has caused the public to become acquainted with an article of its manufacture to which they have given the name "Castoria," even though it may not have the exclusive right to the use of that name, still other persons have no right to appropriate the name in connection with a medicine put up in bottles and having wrappers, and a dressing up of the goods in such a way that an intending purchaser would be deceived into buying it when he intended to buy that prepared by the Centaur Co. **Id.*

5. Where the most casual inspection of the wrappings of defendant's packages, their size, shape, the method of wrapping, and the general impression from the imprint on them, shows that they do not have such dissimilarity as would arouse the suspicion of a careless or unwary purchaser, it amounts to evidence of an intended imposition which will be restrained.

**Id.*

6. While the manufacture of "Castoria" is free to all since the expiration of the patent, yet no one has the right to dress his goods up in such a manner as to deceive an intending pur-

chaser, and induce him to believe that he is buying those of the complainant. Inasmuch as the issue raised in such cases is one of fraud, of deceitful representation, or perfidious dealing, the intent of the defendant when clearly made out is often illuminative of the question to be decided, and such intent may be made out from not only direct testimony, but also from clear inference from all the circumstances, even where the defendant protests that his intention was innocent. (C. C. A., 5th Cir. Dec. 13, 1898.)

SWAYNE, J.] *Centaur Co. *v.* Neathery, 91 Fed. Rep. 891.

7. In putting the article on the market the new manufacturer must clearly identify his goods, and not engage in unfair competition, nor do anything which will tend to deceive the public, and induce it to take his goods under the belief that they are the goods which it has heretofore been accustomed to purchase under the same name; and where the similarity of the labels has that tendency to deceive, and such similarity evidently the result of design the use of the deceptive label, or any label substantially similar to the original label, which is calculated to deceive the public will be enjoined. **Id.*

8. Where the respondents' packages of "Castoria" have been so bottled, labeled, prepared, and put upon the market in such a form as is calculated to deceive, and does deceive the public into the belief that they are buying the preparation manufactured and put up by the complainant, they have thus infringed upon its lawful rights and are likely to interfere with its legitimate profits in the sale of its preparation, and are guilty of unfair and fraudulent business methods, and will therefore be restrained. (C. C. A., 5th Cir. Dec. 13, 1898.)

SWAYNE, J.] *Centaur Co. *v.* Hughes Bros. Mfg. Co., 91 Fed. Rep. 901.

9. It is not the test of infringement to find, upon comparison, dissimilarities in two trade-mark wrappers. The purchaser has not the advantage of comparison, and he is required only to use that care which persons ordinarily exercise under like circumstances. A specific article of approved excellence comes to be known by certain catch-words easily retained in memory, or by a certain picture which the eye readily recognizes, and where a

purchaser desiring the remedy to which his attention had been attracted by advertisement, or which he had before purchased, and knew the remedy as "Stuart's Dyspepsia Tablets," and that it was in a blue wrapper, the name and the color were present to him; and it would require more than the care ordinarily used under like circumstances to expect that he would be warned by the prefix "Dr.," or to expect that his artistic taste should be cultivated to a degree to detect the difference between a light blue wrapper and an indigo blue wrapper in a hurried purchase of the remedy. (C. C. A., 7th Cir. Jan. 3, 1899.)

JENKINS, J.] *Stuart *v.* F. G. Stewart Co. *et al.*, 91 Fed. Rep. 243.

10. The cardinal rule upon the subject of unfair competition is that no one shall, by imitation or any unfair device, induce the public to believe that the goods he offers for sale are the goods of another, and thereby appropriate to himself the value of the reputation which the other has acquired by his own products or merchandise. (C. C. A., 6th Cir. Mar. 7, 1899.)

SEVERENS, J.] *Proctor & Gamble Co. *v.* Globe Refining Co., 92 Fed. Rep. 357.

11. One cannot make an exclusive appropriation of words or marks which he puts upon his goods, and which simply indicate their superiority, or popularity, or universality in use, and no more. If he could, he might thus absorb a privilege which is common to all. **Id.*

12. However innocent a person may be of intentional simulation of another's trade-mark, the equitable principles which underlie the question of fair trade and by which courts of equity are guided, will not permit the use of such trade-mark if such use amounts to infringement or constructive fraud. The act, however innocent, is considered constructively fraudulent if the result would tend to unfair trade, to confusion of goods, and to interference with the rights of another. (C. C. A., 7th Cir. Apr. 11, 1899.)

WOODS, J.] *Manitowoc Pea-Packing Co. *v.* William Numson & Sons, 93 Fed. Rep. 196.

13. "The defendants have no right to dress their goods up in such manner as to deceive intending purchasers, and induce

them to believe they are buying those of the plaintiff;" (Coats *v.* Thread Co., 149 U. S. 562, 13 Sup. Ct. 966) but the similarity of dress which will warrant the interference of the court must be determined by the circumstances of each case. (C. C., D. N. J. May 15, 1899.)

KIRKPATRICK, J.] *Kroppf *et al. v.* Furst *et al.*, 94 Fed. Rep. 150.

14. Where the testator of defendant began the manufacture of artificial water in New York in 1862, and continued to manufacture and sell large quantities, advertising it as "Schultz's Vichy Water," and was solicitous to have the water with his name as its manufacturer, and so far from attempting to palm it off upon the public as natural Vichy water, he sought to commend it as an artificial water having substantially the ingredients and properties of the natural water, but of greater purity and excellence than the water manufactured by his competitors, *Held*, that while the use of the name "Vichy" in connection with the water made by Schultz may have tended to divert to some extent the sales of the complainants', yet it did not tend to appreciably confuse the identity of the two articles, for if any part of the public bought or used "Shultz's Vichy Water" supposing it to be natural Vichy water, they must have been very careless or very ignorant persons. (C. C., S. D. N. Y. May 23, 1899.)

WALLACE, J.] *La Republique Francaise *et al. v.* Schultz, 94 Fed. Rep. 500.

15. The infringement of trade-marks is the violation by one person of an exclusive right of another person to the use of a word, mark or symbol. Unfair competition in trade, as distinguished from infringement of trade-marks, does not involve the violation of any exclusive right to the use of a word, mark or symbol. Two rivals in business competing with each other in the same line of goods may have an equal right to the use of the same words, marks or symbols on similar articles produced and sold by them respectively, yet if such words, marks or symbols were used by one of them before the other and by association have come to indicate to the public that the goods to which they are applied are of the production of the former, the latter

will not be permitted, with intent to mislead the public, to use the words, marks or symbols in such a manner by trade-dress or otherwise, as to deceive or be capable of deceiving the public as to the origin, manufacture or ownership of the articles to which they are applied: and the latter may be required, when using such words, marks or symbols, to place on the articles of his own production or the packages in which they are usually sold, something clearly denoting the origin, manufacture or ownership of such articles, or negativing any idea that they were produced or sold by the former. (C. C., D. Del. May 5, 1899.)

BRADFORD, J.] *Dennison Mfg. Co. *v.* Thomas Mfg. Co., 94 Fed. Rep. 651.

16. The rule is now settled that a preliminary injunction against unfair competition should be awarded only where the right is plain and the wrong beyond reasonable doubt; and where an examination of the envelopes in which the defendants enclose and sell their goods discloses that they are a misleading and intentional simulation of those of the plaintiff, an injunction against their use will be awarded. (C. C., E. D. Penn. June 27, 1899.)

DALLAS, J.] *Draper *v.* Skerrett *et al.*, 94 Fed. Rep. 912.

17. The courts have been advancing with respect to the question of protecting persons in their legitimate business enterprises from appropriation by others. They will restrain persons who are engaged in what is called "unfair competition in trade" and will prevent them from appropriating the fruits of skill and enterprise of others, "Irrespective of any question of trademarks, rival manufacturers have no right, by imitative devices, to beguile the public into buying their wares under the impression that they are buying those of their rivals." (Coats *v.* Thread Co., 149 U. S. 562; 13 Sup. Ct. 966.) (C. C., N. D. Cal. June 5, 1899.)

MORROW, J.] *California Fig-Syrup Co. *v.* Worden *et al.*, 95 Fed. Rep. 132.

18. The fact that a preparation may not as a medicine accomplish all that is claimed for it is not sufficient evidence of fraud to deprive the manufacturers thereof of the right to relief in a court of equity. *Id.*

19. Where complainant's goods had for 25 years been put up in packages of cylindrical form, enclosed in a red wrapper, and sold as "Franck's Red Roll Chicory," and as such had acquired a certain degree of popularity in certain localities, a rival company known as the "Frank Chicory Company" will be restrained from putting up and offering for sale similar goods in similar packages under the same colored wrappers, where such packages and wrappers are colorable imitations of those of complainant, even though the name of the rival company is changed so that its distinctive part no longer resembles that of the complainant. (C. C., E. D. Wis. June 12, 1899.)

SEAMAN, J.] *Franck *et al. v.* Frank Chicory Co. *et al.*, 95 Fed. Rep. 818.

20. Where the bill alleges that the complainants and defendant are competitors in the same line of business; that the defendant has assumed a trade-name similar to, and in imitation of complainants' trade-name, and the public has been deceived thereby, and great confusion and injury has resulted to complainants' business therefrom; that the incorporators of the defendant corporation, before its organization, knew of the existence and character of complainants' business, and the trade-name under which it was being carried on; and, notwithstanding its attention has since been called to the injury which it has done to complainants' business, it refuses to desist from the use of the name so wrongfully used. *Held*, that such bill states a cause of action for unfair competition, and these facts being admitted by demurrer, they are sufficient to justify relief by injunction. (C. C., S. D. Ohio W. D. July 31, 1899.)

THOMPSON, J.] *Block *et al. v.* Standard Distilling & Distributing Co., 95 Fed. Rep. 978.

21. The fact that complainants were doing business as a partnership, under the name "Standard Distilling Company" is not sufficient to warrant the assumption as a fact in the case that the complainants thereby intended to mislead and cheat the public, or that the public was thereby cheated or misled, neither is it sufficient to warrant the assumption that they represented themselves as a corporation, by using such name without more for the purpose of deceiving the public. The

misrepresentation which would justify the court in refusing relief by injunction against unfair competition must be such as is intended to or does in fact mislead or cheat the public, such as operates as a fraud upon the public. *Id.*

22. Originally the name "Waltham" was used in a geographical sense, but by continued use it has acquired a secondary meaning as a designation of watches of a particular class, and purchasers have come to understand that watches stamped with the name "Waltham" are watches made by the American Waltham Watch Co., and the use of the word by another company upon the plates of its watches without some accompanying statement which shall clearly distinguish its watches from those manufactured by the American Waltham Watch Co. constitutes unfair competition, and will be enjoined. (C. C., S. D. N. Y. July 28, 1899.)

TOWNSEND, J.] *American Waltham Watch Co. *v.* Sandman, 96 Fed. Rep. 330.

XXIII. USE AND SALE AS ESTABLISHING TITLE.

Property in a trade-mark arising from its use in connection or association with articles manufactured by a certain party naturally excludes every other person from the right to use the same mark upon the same articles. (Collins Co. *v.* Cohen, 3 K. & J., 428; *ex parte* Langdon and Batcheller, 61 O. G. 286, cited.) (Feb. 3, 1899.)

DUELL, C.] *Ex parte* The Anti-Adulteration League, 86 O. G. 1803.

XXIV. WHAT DOES NOT CONSTITUTE.

Where a system of using letters and numerals upon the parts or pieces composing a machine, was originally adopted and used with no other purpose than to conveniently designate the size, shape and capacity of the article, and to distinguish it from other parts, sizes, shapes and adaptability, and with no intention to thereby indicate its origin or manufacture, no trade-mark right is acquired. Such mark or symbol must be designed, as its primary object and purpose, to distinguish each of the articles to which it is affixed from like articles produced by others, *i. e.*, to point out distinctly the origin or ownership of the

article to which it is affixed. (C. C. A., 6th Cir. Dec. 19 1898.)

LURTON, J.] * Deering Harvester Co. *v.* Whitman & Barnes, Mfg. Co., 91 Fed. Rep. 376.

TABLE OF CASES.

A

B

C

D

E

F

G

H

I

J

K

L

M

N

O

P

Q

R

S

T

U

V

W

Y

INDEX TO SUBJECT MATTER.

A

B

C

D

E

F

G

I

J

L

M

N

O

P

Q

R

S

T

U

V

W