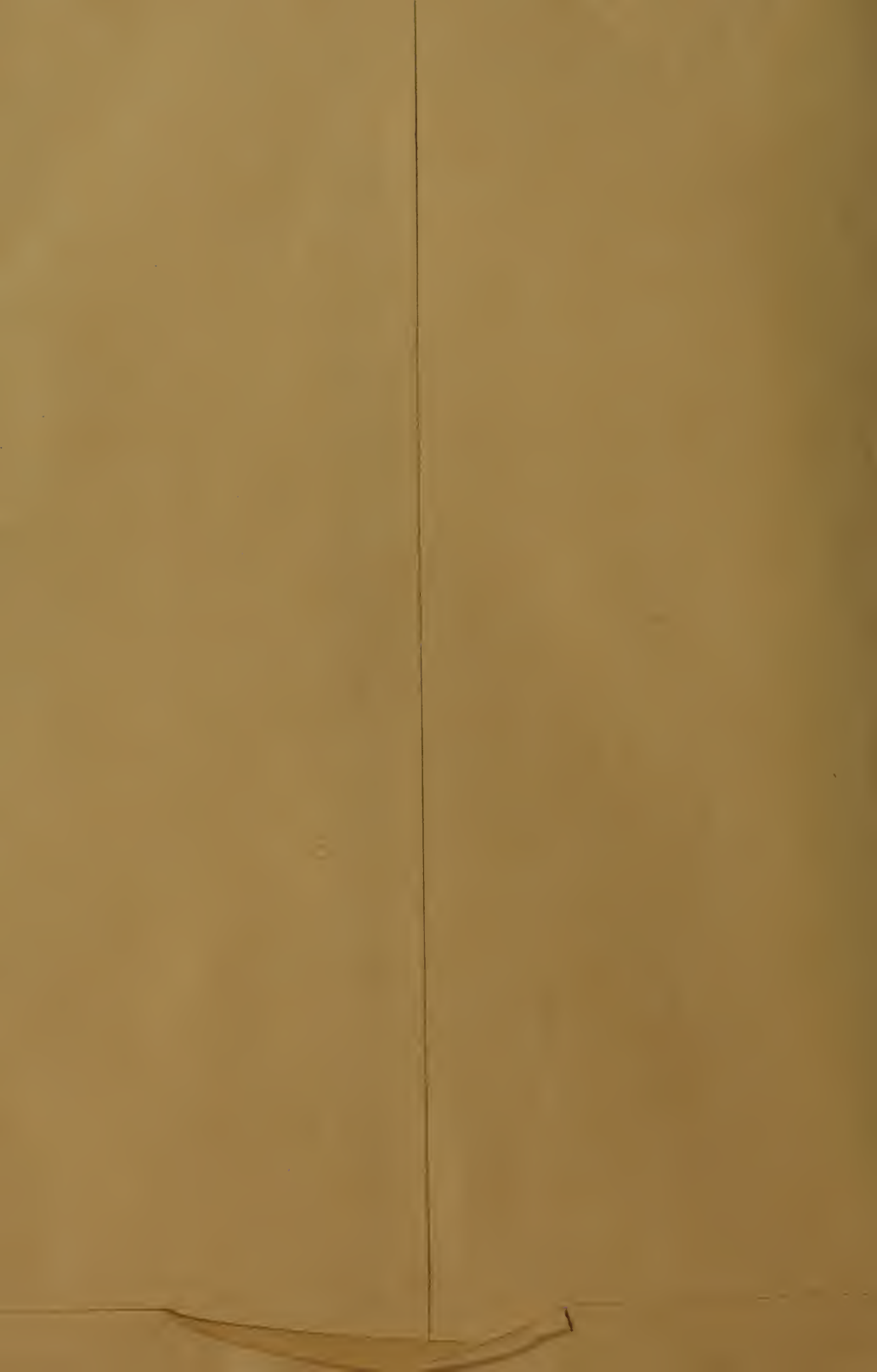


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Patents and the Preparation and Prosecution of Applications by Applicants Themselves

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Patents and the Preparation and Prosecution of Applications by Applicants Themselves

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A PATENT.

A patent is a Government grant to an inventor, securing to him for the period of seventeen years the exclusive privilege of making, using and vending and of authorizing others to make, use and vend, any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvement thereof.

Patents are also granted for designs but this paper is restricted to the consideration of only such patents as are referred to in the definition just stated.

According to Walker on Patents, 4th Edition, paragraph 172:

“Letters-Patent are documents consisting of the grant and the specification; and where drawings form a part of the application, they also form a part of the letters-patent. The grant is a paper, issued in the name of the United States, under the seal of the Patent Office, and signed by the Commissioner of Patents. It contains a short title of the invention, and purports to grant to the patentee, his heirs or assigns, for the term of seventeen years, the exclusive right to make, use and vend the invention, throughout the United States and the territories thereof; and it refers to the specification for the particulars of the invention covered by the grant, and each of the three rights granted by letters-patent is a separate substantive right.”

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Inventors should study the Patent Laws and the Rules of Practice in the United States Patent Office.

Pamphlet copies of the "Patent Laws" and of the "Rules of Practice" may be obtained free of cost upon request therefor addressed to the Commissioner of Patents.

The decisions of the Commissioner are published in the "Official Gazette," published weekly, and furnished to subscribers for \$5.00 a year, payable in advance, and in the bound volumes of the Commissioner's Decisions, published annually and sold in law binding for \$2.00 per volume and in paper covers for \$1.00 per volume. Subscriptions to the Official Gazette and copies of the Commissioner's Decisions should be addressed to the Superintendent of Documents, Government Printing Office.

Throughout this paper reference to the laws is by Section number and to the Rules of Practice by Rule number.

Decisions of the Commissioner are referred to in the Official Gazette by the title of the case, and the Volume and page, as: Branna, 97 O. G., 2533, and in the Commissioner's Decisions by title of the case, year and page, as, Branna, C. D., 1901, 232.

PATENTEES.

To ascertain who may obtain a patent for an invention reference may be made to Section 4886 of the Revised Statutes, which provides that:

"Any person who has invented or discovered any new and useful art, machine, manufacture or composition of matter, or any new and useful improvements thereof, not known or used by others in this country, before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof, or more than two years prior to his application, and not in public use or on sale in this country for more than two years prior to his application, unless the same is proved to have been abandoned,

may, upon payment of the fees required by law and other due proceedings had, obtain a patent therefor."

And to Section 4887 which, in part, provides that:

"No person otherwise entitled thereto shall be debarred from receiving a patent for his invention or discovery, nor shall any patent be declared invalid by reason of its having been first patented, or caused to be patented, by the inventor or his legal representatives or assigns in a foreign country, unless the application for said foreign patent was filed more than twelve months, in cases within the provisions of Section forty-eight hundred and eighty-six of the Revised Statutes, prior to the filing of the application in this country in which case no patent shall be granted in this country."

And to Section 4923 which provides that:

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

Such patent or printed publication if published in any country prior to the invention by the applicant is a bar to the grant of a patent in this country, but not so if the applicant made the invention prior to the date of the patent or printed publication unless the date of such patent or publication is two years prior to the date of filing of the application in this country.

It may be here noted that the date of the completion of an invention may antedate the filing of an application by a considerable period of time.

There are no restrictions to the personality of the

inventor to prevent him from obtaining a patent for his invention except as provided in Section 480, that "all officers and employees of the Patent Office shall be incapable, during the period for which they hold their appointments, to acquire or take directly or indirectly except by inheritance or bequest, any right or interest in any patent issued by the Office."

The applicant may be man, woman or child, of any nationality or color.

The law, Section 4896, even provides for the protection of the inventions of insane persons by their legally appointed conservators, guardians, or representatives and in event of the death of the inventor the patent may be applied for by the executor or administrator of the estate of the deceased inventor.

Furthermore, Section 4898 provides that the inventor may convey all or part of his interest in an invention to another, as follows:

ASSIGNMENTS.

"Every patent or any interest therein is assignable in law by an instrument in writing; and the patentee or his assigns or legal representatives may, in like manner, grant and convey an exclusive right under the patent to the whole or any specified part of the United States.

"An assignment, grant, or conveyance will be void as against any subsequent purchaser or mortgagee for a valuable consideration without notice unless recorded in the Patent Office within three months from the date thereof."

The assignment records of patents in the Patent Office are open to the inspection of the public and any recorded assignment constitutes a notice to the public of the contents of such assignment. Anyone desiring a fuller knowledge of the Patent Office assignment records should consult Mr. Magruder's valuable paper entitled "The Records of Assignments of Paper Prop-

erty" read before the Examiners of the Patent Office, May 28, 1914.

"Patents may be granted and issued to the assignee of the inventor or discoverer; but the assignment must first be entered of record in the Patent Office. And in all cases of an application by an assignee for the issue of a patent, the application shall be made and the specification sworn to by the inventor or discoverer if he is living." Section 4895.

Rule 26 of the Rules of Practice in the United States Patent Office requires that the request of the applicant for the grant of the patent to the assignee or to the inventor and assignee as joint patentees must be embodied in the assignment and that the assignment must be entered of record at a day not later than the date of payment of the final fee; and if it be dated subsequently to the execution of the application it must give the date of execution of the application, or the date of filing, or serial number, so that there can be no mistake as to the particular invention intended.

It is important to particularly note the provisions of Rule 186 relating to assignments:

"No instrument or writing will be recorded which is not in the English language and which does not, in the judgment of the Commissioner, amount to an assignment, grant, mortgage, lien, incumbrance, or license, or which does not affect the title (or legal ownership) of the patent or invention to which it relates. Such instrument or writing should identify the patent by its date and number; or, if the invention be unpatented, the invention should be identified by a statement of the name of the inventor, the serial number of the application and the date of filing of the application."

When an applicant has assigned his rights in an application embracing two or more inventions and such application is divided it is the uniform practice of the Office to apply to the divisional applications assignments

of the original cases and the Commissioner of Patents has said no good reason is seen why the same practice should not be applied to subsequent applications for the same subject-matter by the same inventor. Wurtz, 120 O. G., 2441.

"It is a firmly established rule that a part owner of a patent has a legal right to convey to others the right to make, use and vend the invention without the consent of his co-owners." *Lalace Grosjean Manufacturing Co. vs. National Enameling Co.*, 108 Fed. Rep., 77.

"An assignee of a half interest can not prosecute the application to the exclusion of the inventor; but, on the contrary, the inventor can prosecute it to the exclusion of every one save the assignee of the entire interest." 113 O. G., 850; C. D., 1904.

"An assignee of an equitable interest in an invention has the right to inspect the file and obtain copies of the same." *Hertford*, 113 O. G., 851; C. D., 1904.

Inventors should carefully note the distinction between the terms "joint inventors" and "joint patentees." Joint inventors are persons who have jointly discovered and developed an invention. Joint patentees are persons who are joined in the grant but who were not joined in discovering and developing the invention.

The term "joint inventors" does not properly belong to an inventor and one who has received a grant of a part interest in the invention. The inventor and the assignee may become joint patentees (Section 4895).

INFORMATION FOR CORRESPONDENTS.

All business with the Office should be transacted in writing in compliance with Rules 1, 2, 8, 9 and 10 of the Rules of Practice.

To avoid delay in obtaining information from the Office, applicants should particularly note and comply with the requirements of Rule 8.

When a letter concerns an application, it should state the name of the applicant, the title of the invention, the serial number of the application and the date of filing the application. Rule 9. If the letter is in response to an examiner's action on the case the letter should refer

to such action by the words "in response to the Office Letter of . . ." and to further facilitate correspondence, in response to an examiner's action the letter should refer to the examiner's division by the caption—"Before the Examiner in Division . . ."

Applicants should preserve lineal and verbatim copies of all papers filed in the Office to facilitate making amendments and corrections.

The Office can not respond to inquiries as to the novelty of an alleged invention in advance of the filing of an application for a patent, nor to inquiries propounded with a view to ascertaining whether any alleged improvements have been patented, and, if so, to whom. Rule 14. Should the inventor desire to ascertain what has already been done by predecessors in a certain line of invention he can purchase a "Classification Index" from the Commissioner of Patents at a cost of twenty-five cents. He can then obtain from the Commissioner an estimate of the cost of all of the patents in a selected class or sub-class of inventions or he may order any number, as, the last ten of the patents granted in that particular class or sub-class, the cost of which will be five cents each, payable in advance. A study of these patents will generally give the inventor a fair idea of the state of the prior art and will also furnish him with examples of the character of drawings and specifications required and the nature of what his claims should be. If he does not wish to purchase a copy of the Classification Index, he may write to the Commissioner asking for an estimate of the number of patents relating to his particular invention, describing it in general terms, as—spring jaw rat traps, rotary egg beaters, disk harrows, etc., and after such information has been obtained he may purchase as many copies of such patents as he desires.

"The Office can not act as an expounder of the patent law, nor as counselor for individuals, except as to questions arising within the Office." The Office can not undertake to advise an inventor whether his invention infringes, or, if patented, whether his patent is infringed by others. Such questions are for the courts to decide

when the questions are properly brought before them for decision.

“Of the propriety of making an application for a patent, the inventor must judge for himself. The Office is open to him, and its records and printed drawings pertaining to all patents granted may be inspected either by himself or any attorney or expert he may call to his aid.” Rule 14.

Since this paper is prepared for the assistance of inventors who desire to prepare and prosecute their applications for patents without the assistance of an attorney, reference will not be herein made to attorneys except to say that although an applicant or an assignee of the entire interest may prosecute his own case, he is advised, unless familiar with such matters, to employ a competent patent attorney, as the value of patents depends largely upon the skilful preparation of the specification and claims.

The Office can not aid in the selection of an attorney.

THE APPLICATION.

30.
“A complete application comprises the first-fee of \$15.00, a petition, a specification, and oath; and drawings, when required.” Rule 30.

“An application will not be placed upon the files for examination until all its parts shall have been received.” Rule 31.

When a complete application has been filed in the Application Division of the Office, it is given a serial number in its regular order and the applicant is notified of its serial number and its date of filing. A record of the application is made in the Application Division to identify the application and the division to which it is sent for examination.

The examination of the application on its merits is made in the Examiner's division in accordance with the provisions of Section 4893.

All the papers of a complete application should be

attached together and deposited in the Office at the same time; otherwise a letter must accompany each part accurately and clearly connecting it with the other parts of the application.

STATUTORY REQUIREMENTS OF APPLICATIONS.

The Statutes require a written application comprising a specification and claim:

“Before any inventor or discoverer shall receive a patent for his invention or discovery, he shall make application therefor, in writing, to the Commissioner of Patents, and shall file in the Patent Office a written description of the same, and the manner and process of making, constructing, compounding and using it, in such full, clear, concise and exact terms as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound and use the same; and in case of a machine, he shall explain the principle thereof, and the best mode in which he has contemplated applying that principle, so as to distinguish it from the other inventions; and he shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery. The specification and claim shall be signed by the inventor.”
Section 4888.

To properly prepare a specification and claims requires a thorough knowledge of the Patent Laws and Office Rules of Practice and skill in writing clear, technical descriptions of inventions. These qualifications are acquired by specification writers only by long study and constant practice.

The preparation of an application is the subject-matter of Rules 30 to 55.

The requirements of a petition are stated in Rule 33 and perhaps the best way of preparing a satisfactory petition is by following the proper form from the Ap-

pendix of Forms. It will be noted that there are seven forms given and of these seven but one is the proper one to be copied.

"It sometimes happens that the petition does not refer to or identify a specification. Such a petition is defective." Mason, 43 O. G., 627; C. D., 1888.

"It (the petition) does not itself disclose the invention, and is therefore incomplete unless it refers to some paper which does disclose it." Buddington, 84 O. G., 1728; C. D., 1898.

SPECIFICATION.

By referring to the forms for a specification given in the Appendix of Forms published in the Rules of Practice, it will be observed that all specifications begin with the set or formal words "To all whom it may concern:" followed by a paragraph constituting a formal preamble which should be copied verbatim, with the blanks filled in, and the proper title of the invention substituted for that given therein.

All the requirements of Rules 34 to 40, inclusive, of the Rules of Practice should be closely studied and observed in the preparation of the specification.

The full first name of the applicant should be given in the preamble and if the first name resembles an abbreviation of a well known name, as Fred or Jack, or a diminutive form of a name, as Harry or Johnnie, the oath or affidavit of invention should have added to it a statement that the first name as given by the applicant is his full first name.

"The form of applicant's name should appear the same in the different places in the papers constituting an application. Where different forms appear, one of them presumably a corruption or nickname, an affidavit will be required stating which is the correct form of the applicant's name. Where the incorrect form appears in the preamble, correction may be made by amendment. Where the abbreviated form or nickname appears in the signature, the patent may issue after filing of the affidavit above referred to." Clark, 124 O. G., 910; C. D., 1906.

“Where a foreigner declares his intention of becoming a citizen of this country, he remains a citizen of the foreign country until his citizenship of this country becomes effective.” Rhodes, 105 O. G., 1261; C. D., 1903.

Following the preamble there should be a general statement of the object and nature of the invention. This should, in a few well-selected words, state in general terms the purpose of the invention and in what it consists, see examples in the “Appendix of Forms” before referred to.

“A statement of invention should not be made in a specification which amounts practically to a mere repetition of the claims in different language.” Edwards, 137 O. G., 1711; C. D., 1908.

In recent years it has become customary to reduce the statement to a mere formality such as:

“The invention consists in the construction and novel combination and arrangement of parts hereinafter fully described, illustrated in the accompanying drawings and pointed out in the claims hereunto appended.”

Such statement appears to be sufficient since the courts look to the claims for the definite statement of the invention.

If the invention is capable of illustration the statement of invention in the specification should be followed by a brief description of each of the several figures of the drawing.

Then should follow a detailed description of the invention with reference to each of the several parts by a reference numeral applied to such part in each of the several figures of the drawing. If the reference numeral be applied to the part it represents in each of the several figures of the drawing, it will greatly assist in reading and understanding the drawing.

The detailed description should start with the framework, if the specification be that of a machine, and work towards the details. Everything necessary to a clear understanding of the invention should be described referring in the specification to the parts of the drawing by

reference numerals and no important part of the invention should be overlooked. But it is not necessary to mention every bolt or connection, nor should dimensions be stated unless essential.

At the end of the detailed description in the specification should be the words "I claim" followed by one or more formal claims and the signature of the inventor.

Rule 34, founded upon section 4888, requires the description "to be in such full, clear, concise terms as to enable any person skilled in the art or science to which the invention or discovery appertains or with which it is most nearly connected, to make, construct, compound and use the same."

By persons skilled in the art is meant persons having the usual or expected skill of those engaged in that art. Not those having the highest skill, but those having the average skill and intelligence of persons engaged in the business to which the art relates.

"A patent is addressed to those having a peculiar and technical knowledge of the subject." *Webster Loom Co. vs. Higgins*, 105 U. S., 580; 54 O. G., 388; C. D., 1888.

"If the description of a patent be so vague and uncertain that no one can tell, except by independent experiments, how to construct the patented device, the patent is void." *De Lamar vs. De Lamar Mineral Co.*, 54 C. C. A., 272; 117 Fed. Rep., 240.

One would not be required to describe his invention in the glass maker's art in such terms as to be understood by those engaged in felt hat making, or vice versa, although there might be many engaged in the hat making art who would understand a clear specification of the invention in glass making. The terms used by the glass maker might be familiar to the ears of glass makers generally, yet strange and unintelligible to the hat maker.

"The specification must set forth the precise invention for which a patent is solicited, and explain the principle thereof, and the best mode in which the applicant has contemplated applying that principle, in such

manner as to distinguish it from other inventions.” (Rule 35.)

The specification should not merely define in general terms the type to which the invention relates but should direct the description to just what has been invented by the applicant. The prior art is presumed to be known to those skilled in the art, and to describe in a specification what is already known is not the purpose of a specification. Sometimes it is permissible to refer briefly to the prior art for the purpose of more clearly bringing out by comparison the distinction between the applicant's invention and the prior art but the main reliance for the distinction should be the full, clear and distinct description of what the applicant has invented.

“It is not necessary to state what others have failed to do, but merely what the applicant has done. If the invention is a pioneer, it will receive a liberal construction because of that fact, if claimed, whether or not a statement to that effect is included in the descriptive part of the specification. A statement such as, ‘Many attempts have been made to impart drying properties to the non-drying fatty oils in combination with pigments, but, up to the present time, all such attempts have failed and these oils are still unsuitable for use for many purposes’ should be omitted.” Blakeman, 98 O. G., 791; C. D., 1902.

“A party may in his specification distinguish between what is old and what is new, but there is no warrant for permitting a party to recite the history of the art as he understands it, together with statements as to the disadvantages of the several old forms and the advantages of his invention thereover, or to illustrate in his drawings the old devices which he regards as constituting the prior art.” Wadsworth, 92 O. G., 1798; C. D., 1900.

“Statements should not be included in the specification which are merely laudatory of the applicant's invention.” Blakeman, 98 O. G., 791; C. D., 1902, and

“Matter which is of an advertising nature will not be permitted.” Wellington, 113 O. G., 2218; C. D., 1904.

The specification should not be verbose, nor should it refer to prior art in disparaging terms. Should the specification be objectionable on these grounds, it would

be the duty of the Examiner to require the cancellation of such remarks.

“Under no circumstances should an applicant in his specification make derogatory statements as to the inventions of others; within reasonable limits he may point out the advantages of his invention and indicate also what he regards as the defects or delinquencies common to structures representing the unimproved art.” Heylman, 126 O. G., 1066; C. D., 1907.

“The Office will not knowingly permit a patent to contain a false suggestion of fact which may mislead the public to its prejudice.” Lewis & Ungerer, 106 O. G., 543; C. D., 1903.

“In case of a mere improvement, the specification must particularly point out the parts to which the improvement relates, and must by explicit language distinguish between what is old and what is claimed as new; and the description and the drawings as well as the claims, must be confined to the specific improvement and such parts as necessarily cooperate with it.” (Rule 36.)

If the applicant has invented a yieldable pitman for a mowing machine it is not necessary to describe an entire mowing machine nor even the specific construction of cutter bar with which the pitman is connected. It is enough to say that the pitman was designed for use in a mowing machine, although not restricted to that use since it might be useful in other machines.

It has been held that where the claims were directed to the bearings and mode of connecting the driving device of a centrifugal machine the title “Centrifugal Machine” did not correctly indicate the nature and design of the invention as required by section 4884, Revised Statutes.

“The specification of a patent is sufficient if it fully discloses the principle of the invention and it is not necessary that the relation of the parts should be stated with mathematical exactness.” *Hancock vs. Boyd & Getty*, 170 F., 600.

“The discussion of the theoretical result to be attained by the use of the invention is not proper matter for a patent specification. A specification for a patent should

be confined to a description of the structure of the device and the manner of its use. Such matter, while proper for advertising circulars, should not be included in a specification which is to form part of a patent." *Wellington*, 113 O. G., 2218; C. D., 1904, 564.

"Where a patent discloses means by which a novel and successful result is secured, it is immaterial whether the patentee understands or correctly states the theory or philosophical principles of the mechanism which produces the new result." *Van Epps vs. United Box Board & Paper Co.*, 143 F., 869.

If not inaccurate, the applicant may use the terms with which he is most familiar to describe his invention.

"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." *Hollis*, 86 O. G., C. D., 1899; *Petzold*, 58 O. G., 1091; C. D., 1892.

"A patentee in describing his invention may assume that what is already known in the art is understood and may begin at the point where his invention begins and describe what he has made that is new and what it replaces of the old." *Carnegie Steel Company vs. Cambria Iron Co.*, 99 O. G., 1066; C. D., 1902.

"The operation of the invention should be set out in the specification." *Bradford and Chatfield*, 152 O. G., 731; C. D., 1910.

"Where a specification fails in any material respect to make the invention fully known and accessible to the public skilled in the art to which the invention relates, it is fatally defective, and the patent based upon it ipso facto becomes void." *The Tannage Patent Co. vs. Zahn*, 71 O. G., 1161 (1895).

"When a specification requires to be supplemented by experiment and inventive skill, it is fatally defective and the patent is void." *Id.*

CLAIM.

"The specification must conclude with a specific and distinct claim or claims of the part, improvement, or combination which the applicant regards as his invention or discovery. (Rule 37.)

"A patentee's claim is the measure of his right to relief, and while the specification may be referred to to limit the claim it can never be made available to expand it. *McClain vs. Ortmayer*, 57 O. G., 1129; C. D., 1891.

"The terms of the claim are coextensive with the description of the patent." *Perrin vs. Manhattan Ry. Co.*, 69 O. G., 1209 (1893).

"The true meaning of claims must be gathered by comparing them with the context of the specification." *Celluloid Co. vs. Arlington Mfg. Co.*, 64 O. G., 1263 (1893).

"Where the claims in a patent are not supported by a description in the patent, such claims are of no validity." *Pacific Cable Ry. Co. vs. Butte City Street Ry. Co.*, 66 O. G., 1758 (1894).

Walker says:

"It is a proper practice to make a generic claim and also a specific claim, in an application for a patent on a generic invention, even where only one species is described in the specification. In such a case, if the inventor's understanding that his invention is primary turns out to be true, both claims will be valid. But, if some invention is afterwards discovered in the prior art, which relegates the patent to a secondary place, the specific claim may stand and be valid, though the generic claim is too broad to be maintained." *Walker on Patents*, 4th Ed., sec. 116.

"A claim should itself clearly set forth the structure which it is intended to cover, and not merely by the use of reference letters to the drawing and specification for a disclosure of it. A claim which relies entirely upon reference letters to indicate structure is objectionable." *Osborne*, 92 O. G., 1797; C. D., 1900.

The claim must be complete in itself and definitely outline and limit the invention.

"It is no more permissible on principle to refer to the description for some of the limitations which should be and are intended to be included in a claim than it is to refer to the description for all of the limitations." *Shepler*, 102 O. G., 468; C. D., 1903.

"If the claim does not include sufficient mechanical elements to effect the function stated, it will be rejected

on the ground that it does not comply with section 4888 of the Revised Statutes." Hoge, 173 O. G., 1081; C. D., 1911.

Nor should a claim be verbose or prolix.

"A claim may be so prolix as not to comply with the requirements of the statute that an applicant 'shall particularly point out and distinctly claim the particular improvement or combination which he claims as his invention or discovery.'" Iagan, 162 O. G., 538; C. D., 1911.

"Claims will not be allowed merely because they represent a multitude of elements all of which do not appear in one or two or even more references." Sheppler, 102 O. G., 468; C. D., 1903.

The elements specified in claims for combinations should be substantive and tangible.

"An 'opening' should not be made a positive or direct element in combination claims, for the reason that an opening is not a tangible thing. It can exist only in connection with some other elements. If it is desired to describe this element as provided with an opening there is no objection to such a course." Davin, 100 O. G., 452; C. D., 1902.

"A claim for an article of manufacture should not, as a rule, be defined by the process of producing it; but when an article of manufacture is a new and useful thing and embodies invention and can not be properly defined except by reference to the process of producing it, a case is presented which constitutes a proper exception to the rule." Painter, 57 O. G., 999; C. D., 1891. Scheckner, 106 O. G., 765; C. D., 1903, 315.

"Where a claim to an article refers to an etched plate. This is not objectionable on the ground that it defines the article by the process of making it, since etched plates have well-known physical characteristics." Scheckner, 106 O. G., 765; C. D., 1903, 365.

"One can not have a valid patent for a principle or law of nature. But, having invented and practically exemplified a process for utilizing this principle he is entitled to a patent for that process." U. S. Supreme Ct. in *Tilghman vs. Proctor*, 19 O. G., 859; C. D., 1881, 163.

"A principle covers every mode, apparatus or process that accomplishes the result." *Id.*

Claims must not be worded to merely set forth a result. They must define a composition, a structure, a process or a method.

"It is a well-settled law that a patent can not issue for a result sought to be accomplished by the inventor of a machine, but only for the mechanical means or instrumentalities by which that result is to be obtained. One can not describe a machine which will perform a certain function and then claim the function itself and all other machines that may be invented by others to perform the same function." Gardner, 140 O. G., 256; C. D., 1909.

"But where a claim distinctly specifies a certain structure which is adapted to perform a particular function there is no objection to setting that function out in the claim." Hoge, 173 O. G., 1081; C. D., 1911.

"If the claim does not include sufficient mechanical elements to effect the function stated, it will be rejected on the ground that it does not comply with section 4888 of the Revised Statutes." *Id.*

"An applicant can not be permitted to use in his claims terms which are indefinite and general in their meaning without such qualifying words as shall make clear what is intended to be covered by them and shall be expressive of the purpose, location or function of the elements intended." Hamilton, 85 O. G., 1742; C. D., 1898.

"The terms of description used in the claims should accurately describe the construction disclosed in the application." Mueller et al., 118 O. G., 270; C. D., 1905.

"A claim should not be drawn in an alternative form even where the alternative elements are equivalents, but should use some broad term of description which will include both forms."

"A claim including a description of an element as 'brick or the like' is alternative in form and is indefinite, since the word 'like' fails to identify the characteristics of the substance." Caldwell et al., 120 O. G., 2125; C. D., 1906.

The phrase "brake or locking device" is either alternative or so inapt to define the desired construction as to be objectionable on the ground of indefiniteness." Leon, 164 O. G., 250; C. D., 1911.

"To merely state in a claim the function or result with-

out first including therein the structure by means of which the function or result is obtained renders a claim vague and indefinite." *Kotter*, 95 O. G., 2684; C. D., 1901.

"A statement of the purpose, result, operation, or advantages of a mechanical invention should not be included in the claims, but should be embodied in the specification. The claims should be limited to statements of structure." *Schweitzer*, 97 O. G., 1371.

"In a combination claim the use of the word "means" limited by a statement of function has long been recognized as the proper method of stating an element of the combination." *Young vs. Eick*, 113 O. G., 547; C. D., 1907.

"Where the invention claimed is a combination the term 'means' followed by a statement of function is properly readable on a structure in which such means consists of more than one element." *Lacroix vs. Tyberg*, 148 O. G., 831; C. D., 1909.

"To imply as elements of a claim parts not named therein for the purpose of limiting its scope, so that it may be accorded novelty is contrary to a well-settled rule of patent law." *Fred'k R. Stearns & Co. vs. Russell*, 84 O. G., 1434; C. D., 1898.

"Where an element is mentioned in a claim and intended to be included as an element of the combination it is in the interest of clearness and good form to positively and directly include it instead of making an indefinite reference to it." *Vincke*, 96 O. G., 2061; C. D., 1901.

A claim may be had because it does not set out a complete combination or because it includes more than is necessary.

"A patent based on an alleged combination which is inoperative without the addition of another element is void." *Terrant vs. Duluth Co.*, 39 O. G., 1425 (1887).

"It is fatal to a patent for a process that a patentee claims as essential a step which is unnecessary." *Van Camp vs. The Maryland Pavement Co.*, 43 O. G., 884 (1888).

"It is unnecessary to include in the claim such words as 'substantially as described' since the law makes the description a part of the patent, and therefore the claim must be construed with reference to the description

whether the words are included or not." Shepler, 102 O. G., 468; C. D., 1903.

"The Patent Office in determining the meaning and legal effect of a claim regards the presence or absence of the words 'substantially as described' as immaterial." Id.

"A claim which differs from another merely by the use of the words 'substantially as described' can not be permitted in the patent, since the words impart no definite limitation into the claim where used." Id.

"An applicant should not needlessly multiply claims by the inclusion of well-known elements which do not cooperate therewith to produce a new result or in any manner add to the patentable novelty of the device." Griffith, 85 O. G., 936; C. D., 1898.

"The practice of presenting a needless multiplicity of claims of substantially the same scope is to be condemned." Kadow, 154 O. G., 1412; C. D., 1910.

"Where the claims in an application are drawn to cover a mechanical structure capable of performing several functions and the claims differ from each other only in the statements of function attributed to the device it has been held that the claims are substantial duplicates, for upon elimination of the statements of function each claim would cover the same combination of elements." Jacobson, 107 O. G., 1378; C. D., 1903.

"Where the invention can be clearly defined by means of four claims, the presentation of twelve claims is objectionable because then the claims are unnecessarily multiplied." Carpenter, 112 O. G., 503; C. D., 1904.

"Where it appears that one claim includes limitations not found in the other, such claims are not duplicates." Massie, 113 O. G., 2505; C. D., 1904.

"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." Oxnard & Baur, 88 O. G., 1526; C. D., 1899.

If there are more than one claim they should be consecutively numbered.

"It is to avoid confusion in examining cases that claims must be numbered in consecutive or regular order." Tuttle, 102 O. G., 1781; C. D., 1903.

DIVISION.

“An applicant is permitted to show several species of an invention when the state of the art permits a claim to be presented and allowed which is broad enough to cover all of the species shown and described.” Herreshoff, 106 O. G., 1779; C. D., 1903.

“He may include in one case generic claims and claims to one species, but may not include claims limited to different species.” Dallas, 106 O. G., 996; C. D., 1903; Eagle, C. D., 1870, 137.

For example:

“Joints for metal plates have acquired a distinct status in art and manufacture and one form may be used as a substitute for another. Two forms constitute two species of the invention and can not be claimed in the same case.” Burmeister, 101 O. G., 662; C. D., 1902.

“Two different constructions for fastening calks to horseshoes constitute independent inventions although both might be used on one shoe.” Rodinbaugh & Laurentz, 101 O. G., 1830; C. D., 1902.

DRAWINGS.

“When the nature of the case admits of drawings, the applicant shall furnish one copy signed by the inventor or his attorney in fact.” Section 4889.

Formerly the specification and drawing were both required by statute to be signed by the inventor, or the drawing might be signed by the attorney in fact, and the signatures were required to be attested by two witnesses. Now, however, by recent amendments to the Statutes and to the Rules of Practice in conformity therewith, the requirement for witnesses is not made.

When the invention can be illustrated by drawings the formal and technical requirements of the Rules of Practice concerning drawings should be strictly observed, and, inasmuch as the artistic requirements of patent drawings are beyond the ability of most inventors and applicants, applicants are advised to employ competent draftsmen to make drawings for them. If the services of such are

not available elsewhere, the Office will furnish drawings at cost to the applicant as promptly as the draftsmen can make them.

"The statute requiring a drawing means one showing what is described, and a part can not be omitted any more than the whole of it. The question is not whether the construction can be understood without a drawing, but is whether it can be illustrated." Edgerton, 101 O. G., 1131; C. D., 1902.

"It is a great desideratum of Patent Office drawings that they should tell their story to the eye without making it necessary to go into the specification for explanation; which should be apparent upon inspection." Sturtevant et al., 108 O. G., 563; C. D., 1904.

"Where the invention relates to the arrangement of engines, tanks, receivers, and connecting pipes and valves all of known construction, diagrammatic illustration is probably clearer than views showing parts in detail." Clark, 109 O. G., 2169; C. D., 1904.

"When possible, a drawing should be so complete that the purpose and operation of the invention may be readily understood by one skilled in the art by a mere inspection of the drawing." Hartley, 97 O. G., 2746; C. D., 1901.

"Where a conventional device is referred to in the specification and it does not form part of the invention it should either be illustrated in a conventional way, in order that any one skilled in the art can understand from a mere inspection of the drawings what the device is, or if it is illustrated in an unconventional way an amendment should be made to the specification clearly describing the construction and operation of said device." Morse, 97 O. G., 2982; C. D., 1901.

"It is not necessary in Patent Office drawings that the exact proportions of the parts should be indicated. All that is required is that such an operative device be shown that one skilled in the art can make and use the same." Creveling, 98 O. G., 1708; C. D., 1902.

The drawing must show the structure so completely as to enable one skilled in the art to construct it.

"It is not sufficient for the purpose of a Patent Office drawing that the illustration be such that a person skilled in the art could supply the parts not shown; but when

possible the drawing should be so complete that the purpose and operation of the machine illustrated may be readily understood by one skilled in the art by means of a mere inspection of the drawing." Motsinger, 110 O. G., 601; C. D., 1904.

"Where a party discloses two or more forms of some of the elements of his invention in the drawings and claims the general combination of parts and the specific form of some of the elements he should include the preferred form of the elements in the figure of the drawings illustrating the combination which he wishes to claim, so that all claims will read upon the device shown in a single figure." Welch, 93 O. G., 2104; C. D., 1900.

"A modification of the invention should not be shown in dotted lines on the same figure which shows the preferred form in full lines, but should be shown if at all, in separate figures and in full lines." Badger, 97 O. G., 1696; C. D., 1901.

"When the application fully discloses the construction of the alleged invention which is of general application, the illustration of the invention applied to a particular use will not be required." Perkins, 142 O. G., 855; C. D., 1909.

"The number of sheets of a drawing in an application should not be greater than is necessary to clearly illustrate the invention." Roadhouse, 111 O. G., 1368; C. D., 1904.

"Nor should the drawing include matter which is unnecessary and ineffective for a clear understanding of the invention claimed." Anderson, 113 O. G., 2504; C. D., 1904.

"There are two principal reasons for the rule requiring drawings to be limited to as few sheets as possible consistent with a clear showing of the invention; one is that it has now come to be a serious problem to find space for the storage of drawings, whether they form a part of a patent or of an abandoned application, and the other is that it is a useless expense to photolithograph an unnecessary number of sheets of drawings for the purpose of attaching the same to patents." Pfautz, 159 O. G., 489; C. D., 1910.

OATH.

Section 4892 requires that the inventor shall make oath to certain matters therein mentioned and Rule 46 further requires that the oath shall be signed by the inventor.

In case of the death of the inventor the application and oath may be made by his executor or administrator, and in case of the insanity of the inventor the application and oath may be made by his legally appointed guardian, conservator or representative. Section 4896. (Rule 25.)

The acknowledgment of the oath before a notary, or other proper officer designated in section 4892 and Rule 47, should be executed shortly before filing the application in the Office.

The form of the oath should be copied from that given in Form No. 18 in the Appendix of Forms in the Rules of Practice. Particular attention should be given the explanatory footnotes concerning the blanks to be filled in in the form. By carefully following the directions delay and annoyance will be avoided.

If the full first name of the applicant resembles an abbreviation of a nickname the oath should have added to it the words "and the first name as given by the applicant is his full first name."

An additional oath will be required under Rule 46 where the delay in filing the application after the execution of the original oath is longer than three weeks in addition to the time which may naturally be expected to be required in transmitting the papers by mail to the Patent Office. Branna, 97 O. G., 2533; C. D., 1901, 232.

EXAMINATION.

On the filing of the application and the payment of the filing fee an examination will be made in compliance with section 4893, and if any claim is found to be unpatentable for any reason whatever, it will be rejected under the provisions of section 4903, which also gives the applicant the privilege of amending the claim or asking for a reconsideration on the merits.

The order of examination of applications is stated in Rule 63.

"Applications must be examined in regular order; the Office can not give one case precedence over others because of the applicant's business arrangements which are dependent upon a speedy allowance of the patent." *Bischoff*, 100 O. G., 2603; C. D., 1902.

In an action on the merits of a case in the examination thereof—

"Rule 66 merely requires that an Examiner in citing references shall, if the pertinence of the same is not obvious, clearly explain the grounds upon which he has rejected the claims. It is necessary only that the Examiner's position be made plain upon the record, so that the applicant may intelligently amend his claim or present his case for appeal. The rule does not require that the Examiner shall 'meet' every argument advanced by an applicant." *Stier*, 110 O. G., 599; C. D., 1904.

"Where the Examiner has clearly and explicitly given his reasons for rejection yet admits that the disclosure of the references is not in all respects identical with the applicant's disclosure, on which the rejected claim is based the provisions of Rule 66 have been complied with and the issue between the Examiner and the applicant should be determined on appeal." *Fletcher*, 114 O. G., 545; C. D., 1905.

"In many cases a mere statement that the claims are rejected on specified references is sufficient, in view of the character of the invention; but in all cases where references are grouped together it should be clearly stated whether the claims are anticipated by each of the references separately or in what manner the references are to be combined." *Harris*, 140 O. G., 756; C. D., 1909.

"When the pertinency of the references is obvious, as where the disclosure is simple or includes only the invention of the applicant, a detailed application of the references is unnecessary." *Inman*, 160 O. G., 1038; C. D., 1910.

"But where an Examiner rejected claims upon an 'old way' of doing a thing and upon request of the applicant refused to make a particular citation of this old way or to furnish the affidavit required by Rule 66, there is no excuse for failure on the part of the Examiner to be guided by the Rules of Practice, particularly where the

language admits of but one construction." Garms, 93 O. G., 190; C. D., 1900.

"Where an applicant is attempting in good faith to further the prosecution of his application the Office should give him all reasonable assistance." Starr, 106 O. G., 263; C. D., 1903.

"If any doubt exists as to the interpretation placed by the Examiner upon a feature of the drawing or portion of one specification, he will furnish an explanation in response to a specific request making clear the uncertainty existing in the mind of the applicant." Lincoln, 127 O. G., 3216; C. D., 1907.

AMENDMENTS.

"When claims are rejected as anticipated by prior patents they should be amended, if possible to set out the difference between the applicant's construction and that shown in the patent; the differences must be indicated in the wording of the claim. The patentability of claims can not properly be predicated on alleged differences of construction which are not specified therein. *McNeil vs. Sturtevant*, 124 O. G., 2177; C. D., 1906.

In amending his specification, drawings or claims the requirements of Rules 68 to 78 should be observed and closely followed.

The heading of an applicant's letter amending an application should have the name of the inventor, title of the invention, serial number, and date of filing placed in one corner, at the top of the page, and in the opposite corner of the page should be placed the division number and room number, which may be found at the top of the Examiner's letters. The applicant's letter should be addressed to "The Commissioner of Patents" and should open with the clause "In response to the Office action of (date) amendment is hereby made as follows:"

Following the specific directions for amendment should be the "remarks," signature of the inventor, and the date of the letter.

"The applicant when amending his case by canceling rejected claims should request that the claims be renumbered consecutively. Should he neglect to do so the Examiner may properly so renumber them and the ap-

plicant should be notified of the renumbering." Tuttle, 102 O. G., 1781; C. D., 1903.

"Amendments to an application should be actually signed by the applicant or his attorney with pen and ink or equivalent writing material. Amendments signed by means of a rubber stamp will not be accepted." Minehan, 134 O. G., 1298.

"When there has been an assignment of an undivided part of an invention the amendments to an application must be signed by both the inventor and assignee." (Rule 6.)

"It is a well-settled practice of the Office that an amendment can not be entered in part, since for the Examiner to undertake to enter an amendment so far as it is responsive and to refuse to enter the remainder thereof would lead to endless confusion." Hodge, 173 O. G., 1079; C. D., 1911.

"A substitute specification is objectionable and in general should not be filed unless required by the Office in view of the number and nature of the amendments to the original specification." Orewailer, 170 O. G., 481; C. D., 1911, 100.

REQUESTS FOR RECONSIDERATION.

"A mere request for second consideration without explanation or argument, and without 'distinctly and specifically pointing out the supposed errors in the Examiner's action,' Rule 69, is not sufficient to entitle an applicant to reconsideration." Appel, 84 O. G., 1145; Krejci, 121 O. G., 1011; C. D., 1906.

"Should the applicant file a paper containing merely such request it would be proper for the Examiner to inform the applicant that the paper is not responsive to the Examiner's action and should the proper response not be filed by the applicant within the year running from the date of the Examiner's previous action the application will become abandoned." La France, 105 O. G., 262; Busenbenz, 117 O. G., 600; C. D., 1905.

The action of the applicant should be fully responsive to the Examiner's action.

UNRESPONSIVE AMENDMENTS.

“Should an applicant present an amendment canceling two of his six rejected claims and substitute others therefor and take no action whatever as to the remaining claims, the action would be considered unresponsive and insufficient to save the application from abandonment.” Schmitt and Tanody, 121 O. G., 688; C. D., 1906.

“Where the Examiner has made requirements as to matters of form and has found that any of the claims are allowable, an amendment which does not comply with the requirement of matters of form or point out wherein they were improperly made is not completely responsive.” Fox, 211 O. G., 955; C. D., 1915.

AMENDMENTS TO DRAWINGS.

“Where an applicant makes claims to a certain feature of an invention clearly described in the specification but not illustrated in the drawing an amendment to the drawing illustrating the feature described and claimed is justified.” 110 O. G., 1428; C. D., 1904, Zwiebel.

“Where photographic prints of the original drawings have been made part of the record, it is permissible to make slight changes in the original drawing, but not such changes as practically obliterate the identity of any of the original figures.” Kuhlman et al., 102 O. G., 229; C. D., 1903.

Permissible changes in the construction shown in any drawing may be made only by the Office and after an approved photographic copy has been filed (Rule 72). No changes should be made in the drawings until the approval of the Examiner of the proposed changes has been obtained.

SUPPLEMENTAL OATH.

“Where an amendment is filed claiming matter not covered by the original statement of invention or claim, a supplemental oath should be attached to the amendment, since an oath to matter presented for the first time after filing is just as important as is the original oath.” Rurich & Bode, 106 O. G., 765; C. D., 1903.

“An applicant for a patent may properly file new claims

in the Patent Office without verification where they are within the invention disclosed in the specification and drawings and narrower than the original claims." *Gen'l Elec. Co. vs. Morgan Gardner Electric Co.*, 168 F., 52.

NEW MATTER.

"New matter can not be inserted in a case by amendment simply because the invention originally shown is inoperative and the amendment will make it operative." (*Ex parte Snyder*, 22 O. G., 1975; construed) *Willits*, 115 O. G., 1064.

"Mere clerical or draftsman's errors may be corrected where the errors are clear from the application itself; but changes can not be made in the application based upon allegations of fact not shown in the record." *Id.*

"Matter not originally shown in a second application can not be entered therein by amendment, although shown in a prior application abandoned in favor of the latter application." *Hagey*, 173 O. G., 1081; C. D., 1911.

"Matter can not be read into a case or inserted merely because it was invented before the application was filed and was intended to be included." *Dow vs. Converse*, 106 O. G., 2291; C. D., 1903.

"A general statement in the original specification as to a modification of the invention does not warrant an amendment to the drawing showing a species of the invention not originally disclosed." *Mothes*, 113 O. G., 1146.

"The fact that no claim is made to new matter inserted by amendment furnishes no good reason for permitting it to remain in the case." *Id.*

FINAL REJECTION.

"Where an applicant files an argument traversing the action of the Examiner and the Examiner insists upon his action without citing new reasons for rejection, a final rejection is in order." *Casselman*, 102 O. G., 230; C. D., 1903.

"Where the amendments or reasons presented by an applicant in response to an action by the Office do not necessitate the citation by the Examiner of additional

references or reasons, applicant's rights to further prosecution of the application before the Examiner is at an end, and the permission of further amendment is within the discretion of the Office." Miller, 139 O. G., 730; C. D., 1909.

"Where the Examiner points out certain formal objections in his letter finally rejecting the claims of an application the final rejection is not thereby rendered premature." Green, 130 O. G., 299; C. D., 1907.

AMENDMENTS PRESENTED AFTER FINAL REJECTION.

"Where after a final rejection an amendment was filed directing that the finally rejected claims be canceled and presenting new claims, held that a statement that neither the applicant nor his attorney had looked for a final rejection and in view of the Examiner's action applicant was willing to take narrower claims was not such a showing as required by Rule 68." (Citing *Ex parte Miller*, 91 O. G., 1033); Dietrick, 174 O. G., 829; C. D., 1911.

That the importance of features covered by proposed claims was previously overlooked is not a sufficient excuse for failure to file them before final action. Nettles, 107 O. G., 541; C. D., 1903.

That an applicant did not properly understand the invention is not a sufficient reason to warrant the admission of an amendment after final rejection. Schmidt, 100 O. G., 2602; C. D., 1902, 327.

An amendment presenting new claims filed after final rejection will be refused admission where the applicant has had ample opportunity to present such claims and the only excuse given for failure to do so was that it did not appear to be desirable until he was convinced that the broader claims presented were unpatentable in view of the references cited. Lange, 163 O. G., 727; C. D., 1911.

An applicant will not be permitted after a final rejection to file an amendment canceling the original rejected claims and inserting in lieu thereof new claims if such new claims differ in scope from the original claims and are not merely the original claims presented in better form. Landsing, 96 O. G., 2063; C. D., 1901, 129.

A party can not demand the admission of an additional claim after final rejection as placing the case in better forms for appeal, since if it differs from other claims it affects the merits. *Downing*, 100 O. G., 2176; C. D., 1902, 317.

SUBSTANTIVE PATENT LAW.

In preparing claims in an application an applicant should know that in the patent law—

“A combination as claimed is an entirety and disappears with the removal of one of its elements, and therefore it is a stated principle of law that where an element of the combination claimed is omitted there is no infringement.” *Lane vs. Levi*, 104 O. G., 1898; C. D., 1898.

“No one is an infringer of a combination claim unless he uses all the elements thereof.” *Cimiotti Unhairing Co. vs. American Fur Refining Co.*, 116 O. G., 1452; C. D., 1905.

“Where claims cover a product disclosed in references the fact that the references propose to produce the product by different processes is immaterial.” *Pratt*, 224 O. G., 1407; C. D., 1916.

“Under the court decisions the introductory phrase is not an element of the combination and does not limit the claim to such apparatus.” *Casler*, 90 O. G., 448; C. D., 1899.

The Circuit Court of Appeals has held a claim to a grab-hook bad because it included a draft appliance as an element of the combination. The grab-hook was new but grab-hooks and draft appliances in combination were old. The patentee did not invent the combination and should not have claimed it. The draft appliance acted in the same way as heretofore in the combination; that is, the new grab-hook did not act differently in the combination from old grab-hooks; hence the combination was not the new invention of the patentee. *Langan v. Warren Axe and Tool Co.*, C. D., 1911.

The mere function or effect of the operation of a machine can not be the subject-matter of a lawful patent but a process is something different.

“A process is a mode of treatment of certain materials to produce a given result. It is an act, or a series of acts,

performed upon the subject-matter to be transformed to a different state or thing. If new and useful, it is just as patentable as a piece of machinery. In the language of the patent law, it is an art. The machinery pointed out as suitable to perform the process may or may not be new or patentable, while the process itself may be altogether new, and produce an entirely new result. The process requires that certain things should be done with certain substances, and in a certain order; but the tools to be used in doing this may be of secondary consequence." *Cochrane vs. Deener*, C. D., 1877, 242; 94 U. S., 78.

Applicants unfamiliar with patent laws frequently can not understand why their claim is rejected on two or more patents, taken together. To such, the decision of Assistant Commissioner Newton in *Ex parte McCollum*, as follows, may be of assistance:

"When legitimate combination claims . . . are rejected on two or more references, the trend of the best authorities indicates that at least one of the references ordinarily should show the general combination claimed. . . . Then if the specific features claimed and shown by the other reference or references may be substituted without such changes as require invention and perform the function intended the two references may be legitimately combined against the claim; otherwise not. . . .

Legitimate combination claims are for constructions or mechanisms for performing a function, and it is improper to reject them on ideas extracted from various references unless those ideas are accompanied by constructions that may be put together without so changing them as to require invention to adapt them to perform the desired result.

In determining the patentability of a claim found only in a plurality of references, it is necessary to consider the structural differences specified in the claims, as well as their functional difference or result. If the structures of the several references can not be combined without the exercise of invention, even though the result is old the claims should be allowed. If the structures of the references may be combined or substituted one for the other and the combined function or result is new, the claim should be allowed. It is only when both the structural features found in the references may be com-

bined without invention to meet the structure called for by the claim and the function or result involves no invention that the claim should be rejected." *McCollum*, 204 O. G., 1046; C. D., 1914.

DESCRIBED IN PRINTED PUBLICATION.

A device is "described in a printed publication" within the meaning of the Revised Statutes, section 4886, and therefore not patentable as a new invention, where it is shown in the drawings of a prior patent. *Keene et al. vs. New Idea Spreader Co.*, C. C. A., 230 O. G., 1185; C. D., 1916.

The question whether a patented device is the result of invention, or only mechanical skill, is one of fact. *Id.*

Where the elements of a combination claim were not merely old, but in point of equivalency had for years been devoted to the same uses in the same art and with substantially like results, the combination shows mechanical skill rather than invention. *Id.*

While a patented combination may not be anticipated by any single prior patent, such patents showing elements of the combination, are a part of the prior art, properly to be considered on the question whether invention or only mechanical skill was required to make the combination. *Id.*

COMPOSITION OF MATTER.

Where a claim for a composition of matter gives the names of the substances which are to be mixed together without stating any relative proportion, so that it would require experimentation to determine what proportions were necessary to secure the described result, the claim is void for failure to describe the invention in such full, clear and exact terms as to enable a person skilled in the art to practice the invention. *Panze vs. Battle Island Paper Co.*, 138 F., 48.

Where the only novelty involved in a device lies in the proportions of the parts and the description does not set forth these proportions, the patent therefor must be invalid for lack of sufficient description. *Electro-Dynamic Co. vs. Westinghouse Electric & Mfg. Co.*, 191 F., 506.

EQUIVALENTS.

The range of equivalents depends upon the extent and nature of the invention. If the invention is broad and primary in its character, the range of equivalents will be correspondingly broad under the liberal construction which the courts give to such inventions. *Continental Paper Bag Co. vs. Eastern Paper Bag Co.*, 136 O. G., 1297; C. D., 1908.

IMPROVEMENT IN DEGREE.

The mere carrying forward of an original conception, resulting in an improvement in degree simply, is not invention. *Keene et al. vs. New Idea Spreader Co.*, C. C. A., 230, O. G., 1185; C. D., 1916.

CLAIMS OF UNWARRANTED BREADTH.

Claims broader than an applicant's conception, presented for the purpose of covering something different than the essential elements of the applicant's idea of means would be rejected.

An applicant will not be allowed claims made broader than the essential element of his idea of means by the use of indefinite terms or by the omission of things essential to his idea as conceived and disclosed. *Fritts*, 237 O. G., 737; C. D., 1916.

APPEALS.

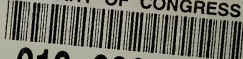
Should an applicant traverse the propriety of a final rejection of his claim by an Examiner he may appeal from such rejection to the Examiners-in-Chief as provided in Rules 133 to 137.

INTERFERENCES.

An applicant, unless he has had previous experience, is advised against attempting to personally prosecute an interference proceeding should he be advised by the Office that his claim interferes with that of another applicant. The prosecution of an interference proceeding is so technical and complicated as to require the services of a competent patent attorney.

March 8, 1917.

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