Argument for the appellant.

he has seen at the Patent Office the model he made for Mr. Atkinson. Mr. Atkinson did not give him any idea of the principle or construction of the pump before he took him to Doctor Jones' office; he called the model at Doctor Jones' office *his* model; he did not examine the drawing particularly; he only took a glance at it; Doctor Jones held it in his hands and took it away immediately, and told him he could sketch better from the model. Upon a careful consideration and comparison of the evidence on both sides, I am of opinion that the preponderance is greatly in favor of William Boardman, Jr., as the inventor of the improvement in the steam pump for which he has now applied for a patent; and I do therefore affirm the decision of the honorable Commissioner of Patents in this cause.

Keller & Greenough, for the appellant.

Z. C. Robbins, for the appellee.

IN RE EDWIN JANNEY. APPEAL FROM REFUSAL TO GRANT PATENT.

DECISION OF FORMER COMMISSIONER—REFUSAL TO REHEAR NOT APPEALABLE.—The refusal by one Commissioner to rehear a case decided by his predecessor is not a ground of appeal to the judge. The acts of 1836 and 1839 only give an appeal from the refusal of the Commissioner to issue a patent.

NO LIMITATION OF APPEAL.—*Semble*, that the applicant might still appeal from the decision of the former Commissioner, there being in the act no limitation of time as to the appeal.

(Before CRANCH, Ch. J., District of Columbia, December, 1847.)

J. J. Greenough for the appellant.

1. There is and can be but one Commissioner of Patents, and the rule of action should be the same whether an application is brought up for consideration under the same or a different incumbent of the office.

2. The Commissioner does not pretend to extend the rule stated by him to his final action in cases that have been presented since

The Commissioner's answer.

he filled the office, and in fact, some of those have been repeatedly rejected and re-examined, as the records of the office will show.

3. The law does not make two, three, or any given number of rejections conclusive against an applicant's right, and it is not therefore within the power of the Commissioner to establish such a rule of practice A rule of the office, not recognized by the statute, that curtails the right of an applicant is in contravention of the whole spirit and letter of the patent law.

4. The position taken by the Commissioner that he has not decided this case, and that hence no appeal can be taken, is clearly erroneous. The Commissioner, by affirming, adopts the decision of his predecessor; otherwise the applicant's rights fall to the ground if the former incumbent has twice made an erroneous decision in his case. For this reason the rule announced by the Commissioner is not a reasonable rule.

5. The opinions of the Attorney-General, referred to by the Commissioner in support of his rule—to the effect that financial officers of the executive are bound by the actions of their predecessors—are not applicable to the Patent Office, established under a special clause of the Constitution, by acts which place its decisions directly under the supervision of the chief justice of the District. No rule of the executive can curtail that jurisdiction.

6. This appeal brings up the question of the validity of the rule and the whole merits of the appellant's application.

7. The remedy proposed by the Commissioner, viz., to file a new application, thereby levies a fine of ten dollars upon the applicant, and by merely extending the operation of the rule the Commissioner might levy a tax of ten dollars upon every application which has been twice or once rejected, for if he may establish the one rule he may the other.

8. The case presents an entirely different question from that decided in case of Pomeroy *v.* Connison.

From the Commissioner's Answer.

1. I declined to entertain the request to again take up and examine the application, on the ground that it had been solemnly adjudicated and settled by my predecessor. The principle upon which I determined to settle the practice of the Patent Office in such cases is, that when it shall satisfactorily appear that my

The Commissioner's answer.

predecessor had upon mature and serious consideration decided upon the merits of an application for a patent adversely to the claim of the applicant, the decision should not be disturbed, and the question should be considered as finally settled. And as a general rule of evidence in such cases, I further determined that the proof of such final decision should be two rejections of the same case. Of course any other proof sufficient to show the fact would be equally satisfactory.

2. The only matter decided (if it can be called a decision) is, that I will not take up and reopen the application for any purpose whatever. I have made no decisions on the merits of the case, *i. e.*, whether or not the applicant is entitled to a patent as originally claimed by him nor as set forth in his proposed new claim, which has never been properly before me for decision.

3. This official act, from which this appeal has been taken, is not a judicial but an executive act. It is not an act of which the honorable chief justice has jurisdiction, but it is an act for which I am only amenable to the supreme executive power of the Government. The appeal must not be dismissed for want of jurisdiction.

4. The right to establish reasonable rules of practice, not inconsistent with law, to regulate and facilitate the transaction of business is incident to every court and public officer. The reasonableness of the rule laid down by me in this case is apparent when it is considered that without some such rule rejected applications would never be considered as finally settled, and would be liable to be brought up for reconsideration at any time, however remote in time, to the great and continued prejudice of the regular business of the office.

5. Assuming, however, that the court has jurisdiction, yet, according to the practice of the executive officers and of other departments of the Government, which have been decided by several Attorneys-General to be in conformity with the true intent and meaning of the Constitution, the Commissioner is right in refusing to re-examine applications which have been solemnly adjudicated and settled by his predecessor. (2 Op. Att'ys-Gen., 8; 3 Op. Att'ys-Gen., 1.)

6. Other grounds failing, the appeal must be dismissed for the

reason that no patent has been refused Mr. Janney. (Pomeroy *v.* Connison, *ante*, p. 41.)

7. The applicant's remedy is by filing a new application.

CRANCH, J.

This is an appeal from the decision of the Commissioner of Patents, in the following words, contained in a letter from him to Mr. Janney, dated Patent Office, October 28th, 1847:

"SIR: It appears by the records of this office that your application for letters-patent for alleged improvement in machinery for sawing stones was examined and rejected, for reasons assigned, on the 3d of August, 1843; that on the 7th of September following the case was reconsidered, and the decision was again revised and affirmed. All these actions took place under the administration of the late Commissioner Ellsworth. Under these circumstances the decision heretofore made cannot be disturbed, and your application must stand rejected. Respectfully yours,

"EDMUND BURKE.

"EDWARD JANNEY, Esq.,
"Care J. J. Greenough, Washington, D. C."

The last application for a patent was made on the 27th of October, 1847, some small amendment having been made in the specification not affecting the merits of the claim, so that it was, in effect, an application to the present Commissioner to revise and revoke the two decisions made by Mr. Ellsworth, the former Commissioner. His refusal so to revise and revoke these decisions is not a ground of appeal under the acts of 1836 and 1839. The act of 1839 gives the right of appeal to the judge only in cases where an appeal was by the previous act allowed from the decision of the Commissioner to a Board of Examiners, and then only when a patent was refused. In the present case he has not refused a patent. He decides only that he will not examine the merits of the claim, which has been twice rejected after a full examination by his predecessor in office. This refusal was not a ground for appeal to Examiners under the seventh section of the act of 1836, and therefore is not a ground of appeal to the judge.

Having no jurisdiction of such an appeal, it is not for me to

say whether the refusal under the circumstances of the case was right or wrong. There is no limit of time as to the appeal, and I do not perceive any reason why Mr. Janney may not now appeal from the decision of Mr. Ellsworth, and have the merits of his invention decided. I understand the merits of both applications are alike. Having no jurisdiction of this appeal, I suppose it must be considered as dismissed.

J. J. Greenough, for appellant.

W. P. N. Fitzgerald, for Commissioner.

ALEXANDER BAIN, APPELLANT,

vs.

S. F. B. MORSE, APPELLEE. INTERFERENCE.

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

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

JURISDICTION OF JUDGE—REASONS OF APPEAL.—By limiting the jurisdiction of the judge to the points involved in the reasons of appeal, the law has affirmed it to that extent.

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

SM—SM—APPEAL TO JUDGE.—Upon appeal to the judge in an interference, the