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Appeal No. : 122 U.S. 432

Appellant : Gandy

Respondent : Marble

Judgement :

Gandy v. Marble - 122 U.S. 432 (1887)
U.S. Supreme Court Gandy v. Marble, 122 U.S. 432 (1887)

Gandy v. Marble

Argued April 29, May 2, 1887

Decided May 27, 1887

122 U.S. 432

APPEAL FROM THE SUPREME COURT

OF THE DISTRICT OF COLUMBIA

SYLLABUS

On a bill in equity filed under 4315 of the Revised Statutes to obtain an adjudication in favor of the granting of a patent, the plaintiff must allege and prove that a delay of two years and more to prosecuting the application after the last action therein of which notice was given to him was unavoidable, or the application will be regarded as having been abandoned, within the provision of 4894.

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This is an appeal by the plaintiff in a suit in equity brought in the Supreme Court of the District of Columbia against the Secretary of the Interior and the Commissioner of Patents from a decree of the general term of that court dismissing the bill. The suit was brought by Maurice Gandy against H. M. Teller, as Secretary of the Interior, and E. M. Marble as Commissioner of Patents. The bill was founded upon 4915 of the Revised Statutes, which provides as follows:

"SEC. 4915. Whenever a patent on application is refused either by the Commissioner of Patents or by the Supreme Court of the District of Columbia upon appeal from the Commissioner, the applicant may have remedy by a bill in equity, and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention as specified in his claim or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the Commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication and otherwise complying with the requirements of law. In all cases where there is no opposing party, a copy of the bill shall be served on the Commissioner, and all the expenses of the proceeding shall be paid by the applicant, whether the final decision is in his favor or not."

The facts of the case are these:

On the first of December, 1877, Gandy filed in the Patent Office an application for a patent for "improvements in belts or bands for driving machinery." The application was rejected on the merits. After due proceedings, an appeal was

taken to the Commissioner of Patents in person, who, on the 7th of April, 1879, affirmed the decision rejecting the application. Gandy appealed to the Supreme Court of the District of Columbia, which, on a hearing, on the 30th of January, 1880, dismissed the petition of Gandy and directed that a copy of its decree be transmitted to the Commissioner of Patents. The bill states that the ground of the action of the Patent Office and of the Supreme Court of the District of Columbia in rejecting the application

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was that the invention was not patentable, having been anticipated in prior patents. The bill alleges that the application was erroneously rejected, and prays that the court will hear and determine the right of the plaintiff to a patent for what he claims or for such parts thereof as he may be justly entitled to, and will decree accordingly.

The bill was filed on the third of May, 1883. A subpoena was issued upon it and served upon the Secretary of the Interior and the Commissioner of Patents on the 5th of May, 1883. On the 19th of October, 1883, the solicitor for the plaintiff served on the Secretary of the Interior and the Commissioner of Patents, in person, a notice that he would on the next day move the court for leave to enter their default in the case and thereupon to proceed with the cause *ex parte* to final hearing. On the 20th of October, 1883, the court made an order setting forth that the process of the court and a copy of the bill had been duly served upon the defendants; that they had not appeared or answered, and that, on proof of service of the above-named motion, no one appearing for the defendants, it was ordered that the plaintiff have leave to enter the default of the defendants and to proceed with the cause *ex parte,* and that he have sixty days to take and put in his proofs. It also specified the officers before whom proofs might be taken. Documentary and oral proofs were put in, the former including a copy of the proceedings in the Patent Office, by which it appeared that the date of the last proceeding in the application was the making of the decree of January 30, 1880, by the Supreme Court of the District of Columbia. No one appeared for the defendants on the taking of any of the proofs. On the 14th of April, 1884, the supreme court, in special term, no one

appearing for the defendants, made an order that the cause by heard in the first instance by the general term. On the 30th of April, 1884, Benjamin Butterworth, having succeeded Mr. Marble as Commissioner of Patents, moved the court, in general term, to dismiss the bill, and set aside the order entering the default of the defendants, and for leave to make a defense in the cause, assigning as grounds for the motion that the Secretary of the Interior was not a proper

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party to the suit; that Mr. Butterworth had succeeded Mr. Marble as Commissioner of Patents, and that the application for the patent had been abandoned by reason of the failure to prosecute the same within two years after the last action thereon, of which notice was duly communicated to the applicant. The court in general term made an order allowing the plaintiff to amend his bill, striking out the name of the Secretary of the Interior as a defendant and adding as a defendant the successor in office of Mr. Marble. On the same day, the court in general term made a decree, on a hearing of counsel for both parties, dismissing the bill with costs. From that decree the plaintiff has appealed to this Court.

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MR. JUSTICE BLATCHFORD, after stating the case as above reported, delivered the opinion of the Court.

We are of opinion that this decree must be affirmed. It is provided by 4894 of the Revised Statutes as follows:

"SEC.

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4894. All applications for patents shall be completed and prepared for examination within two years after the filing of the application, and in default thereof, or upon failure of the applicant to prosecute the same within two years after any action therein, of which notice shall have been given to the applicant, they shall be

regarded as abandoned by the parties thereto unless it be shown to the satisfaction of the Commissioner of Patents that such delay was unavoidable."

The applicant failed to prosecute his application within two years after the last action therein, of which notice was given to the applicant. The decree of the Supreme Court of the District of Columbia was made on the 30th of January, 1880, and this bill was not filed until the 3d of May, 1883. No excuse for the laches and delay is set up in the bill, and none is shown in the proofs, nor is it alleged in the bill that the delay was unavoidable. Although, as was said by this Court in *Butterworth v. United States,* 112 U. S. 50 , 112 U. S. 61 (citing *Whipple v. Miner,* 15 F. 117; *In re Squire,* 3 Ban. & Ard. 133, and *Butler v. Shaw,* 21 F. 321), the proceeding by bill in equity, under 4915, on the refusal to grant an application for a patent, intends a suit according to the ordinary course of equity practice and procedure, and is not a technical appeal from the Patent Office nor confined to the case as made in the record of that office, but is prepared and heard upon all competent evidence adduced, and upon the whole merits, yet the proceeding is in fact and necessarily a part of the application for the patent. Section 4915 declares that the judgment of the court, if in favor of the right of the applicant, is to be a judgment that the applicant

"is entitled, according to law, to receive a patent for his invention, as specified in his claim, or for any part thereof, as the facts in the case may appear,"

and that if the adjudication be in favor of the right of the applicant, it shall authorize the Commissioner to issue the patent on the filing in the Patent Office by the applicant of a copy of the adjudication and on his "otherwise complying with the requirements of law." One requirement of law is, by 4894, that the application shall be regarded as abandoned if the applicant fails to prosecute the same within two years

after any action therein of which notice shall have been given to him, "unless it be shown to the satisfaction of the Commissioner of Patents that such delay was

unavoidable." All that the court which takes cognizance of the bill in equity under 4915 is authorized to do is to adjudge whether or not "the applicant is entitled, according to law, to receive a patent," and, after an adjudication in his favor to that effect, the Commissioner is not authorized to issue a patent unless the applicant otherwise complies with the requirements of law. In the present case, there would be no compliance with the requirements of law, in view of the delay for more than two years, unless it be shown to the satisfaction of the court that the delay was unavoidable. The jurisdiction of the application being transferred *pro tanto* to the court by virtue of the bill in equity, it cannot adjudge that the applicant is entitled according to law to receive a patent unless he shows to the satisfaction of the court that the delay was unavoidable, under an allegation to that effect in the bill. The presumption of abandonment, under 4894, unless it is shown that the delay in prosecuting the application for two years and more after the last prior action, of which notice was given to the applicant, was unavoidable exists as fully in regard to that branch of the application involved in the remedy by bill in equity as in regard to any other part of the application, whether so much of it as is strictly within the Patent Office or so much of it as consists of an appeal to the Supreme Court of the District of Columbia under 4911. The decision of the court on a bill in equity becomes, equally with the judgment of the Supreme Court of the District of Columbia on a direct appeal under 4911, the decision of the Patent Office, and is to govern the action of the Commissioner. It is therefore clearly a branch of the application for the patent, and to be governed by the rule as to laches and delay declared by 4894 to be attendant upon the application.

Decree affirmed.