ON MOTION FOR REHEARING.

LACOMBE, J. The precise point raised on this motion for reargument is thus stated by complainants: May 23, 1888.

"The question under discussion is whether this decision of the court is correct, namely, that when, in an interference proceeding between a granted patent and an applicant, a patent is granted to the applicant, then the patentability of the subject-matter is so established by the decision that on a motion for preliminary injunction the original patentee cannot be permitted to controvert it by anything known to him during the interference; but that when, under those circumstances, the patent is refused to the applicant, he is permitted to set up, on a motion for preliminary injunction, that the subject-matter for which he applied for a patent is not patentable by reason of facts known to him when he was asserting patentability on the interference. This proposition is affirmed in the decision, and is founded upon the supposition that in the latter case the patentability of the subject-matter was not 'necessarily' decided in the patent-office, and in the former case it was. There is no other reason given for discriminating the two cases, and if that reason is not well-founded, then the discrimination must fall."

The decision in the former case, above set forth, is one which the statute expressly requires the patent-office to make. The decision in the other case is one which the patent-office has by its rules of procedure required itself to make. Whether this distinction is, as complainants contend, a purely arbitrary one, or whether it does in fact connote a substantial difference in the attitude of the patent-office towards questions which it is required by express statute to answer, and towards those which it volunteers to ask and answer, it is still a perfectly apparent distinction. On one side or other of the line indicated each case as it arises can be at once grouped. In the opinion heretofore filed authorities were cited to the proposition that under the uniform ruling of the courts of the United States for more than half a century, if there had been no decision on the patent by a United States court, on the merits, a preliminary injunction would be refused, except where the complainant showed sufficient acquiescence by the public, or where the validity of the patent was not attacked or needed no argument in its support.

This ruling was accepted as a "wholesome and salutary one." Within the past 10 years, however, numerous decisions in this and other circuits have accepted certain determinations of the patent-office as the equivalent of a decision on the merits by a federal court. Whether, in view of the present current of decision in the supreme court, and of the character of many of the patents which are presented for adjudication, these determinations should hereafter be accorded the same weight as heretofore, need not now be considered. It seemed sufficient, for the purposes of the motion for a preliminary injunction, to show that all the patent-office determinations up to this time accepted by the courts had been such as a statute required that office to make. The denial of complainants' motion in the case at bar was but a refusal to advance the existing rule beyond the limit already reached, or to give the same weight to determinations made by the patent-office solely because of the requirements of its own procedure. Though the line between these two groups may be arbitrary, it is well defined, and, having followed the authorities up to such line, this court now declines to take the step which will establish a precedent for passing it.