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OF

ALL NATIONS:

COMPILED AND ANNOTATED

BY

BENJAMIN VAUGHAN ABBOTT.

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PATENT LAWS OF ALL NATIONS.

VOL. II.

UNITED STATES–WURTEMBURG.

UNITED STATES.

I. CONSTITUTIONAL AND GENERAL PRINCIPLES.

1. *The Constitutional Grant of Power.*

The Congress shall have power . . .

8. To promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries. *Const.* Art. I. § VIII.

2. *Extent of the Power Granted.**

Congress has plenary power over the subject of granting exclusive rights to inventors; it can modify, at pleasure, the law respecting patents, provided property in existing patents is not impaired (McClurg *v.* Kingsland, 1 *How.* 202); and can determine when, and for what length of time, and under what circumstances, the patent for an invention shall be granted; and is not restricted from granting patents in cases where the invention has not been known or used by the public. An act of Congress granting a

* The extent and limits of the power granted to Congress have been discussed and expounded instructively, in Bump Pat. 9 ed. 1; Pomeroy Const. L. 3 ed. §§ 413, 414; 2 Story Const. 4 ed. §§ 1151–1157; Walker Pat. c. 7; Walker Am. L. § 60; Wharton Com. § 450; Paschal Const. 121.

patent is not unconstitutional because it acts retrospectively, and gives a patent for an invention which was previously in public use. Blanchard *v.* Sprague, 3 *Sumn.* 535 ; 2 *Story*, 164.

To make special grants to inventors is within the constitutional power of Congress, and that body can grant an extension of a patent after it has been once extended under the general act. Bloomer *v.* Stolley, 5 *McLean*, 158 ; 8 *West. L. J.* 158. Congress has the constitutional right to confer, by special act, a new and special term on a patentee ; and that even after the expiration of the first patent. Blanchard *v.* Haynes, 6 *West. L. J.* 82 ; Blanchard's Gunstock Turning Factory *v.* Warner, 1 *Blatchf.* 258 ; Jordan *v.* Dobson, 2 *Abb. U. S.* 398 ; 7 *Phila.* 533 ; Evans *v.* Robinson, 1 *Cur. L. Repos.* 209. Congress may renew a patent right, or refuse to do so ; the grant of an exclusive privilege to an inventor for a limited time does not imply a binding and irrevocable contract, that at the expiration of the period the invention shall become public property. Evans *v.* Eaton, *Pet. C. Ct.* 322, 337.

A reservation in favor of assignees in an act extending a patent will not make the act unconstitutional on the ground that Congress is authorized to confer privileges only on inventors ; the power to reserve rights and privileges to assignees is incidental to the general power conferred to promote the progress of the useful arts. Blanchard's Gunstock Turning Factory *v.* Warner, 1 *Blatchf.* 258.

3. *Its Limitations and Exceptions.*

The power exercised by Congress in the enactment of the patent laws is domestic in its character, and is necessarily confined within the limits of the United States. Those laws cannot operate beyond such limits ; nor can the right of the patentee extend beyond the limits within which the law by which the right is created is confined. The use of his invention outside the jurisdiction of the United States is no infringement of his rights, and gives him no claim to compensation. Thus, the rights granted to a patentee do not extend to a foreign vessel lawfully entering our ports ; and the use on such vessel of an improvement patented in this country is not an infringement of the rights of an American patentee, provided it was placed upon her in a foreign port and authorized by the laws of the country to which she belongs. Where a vessel was built and rigged in France and equipped with gaffs which had been patented in the United States, and, so equipped, came to one of our ports, *held*, that as the gaffs were placed on the vessel when she was built

and as part of her original equipment, in a foreign country, by persons not within our jurisdiction, the use of them was not within the application of our patent laws. Brown *v.* Duchesne, 19 *How.* 183, 198; aff'g 2 *Curt.* 371.

Though our patent laws afford no protection to inventions beyond the jurisdiction of the United States, yet that jurisdiction extends to the decks of American vessels on the high seas, as much as it does to all the territory of the country, and for many purposes is even more exclusive. Gardiner *v.* Howe, 2 *Cliff.* 462.

Congress cannot authorize an inventor to recall rights which he has granted to others, or re-invest him with rights of property which he has before conveyed for a valuable consideration. Bloomer *v.* McQuewan, 14 *How.* 539.

4. *History of the Acts of Congress.*

The legislation of Congress upon the subject of patents began early. The act first passed was that of April 10, 1790, 1 *Stat.* 109. c. 7.

This act was repealed by the act of February 21, 1793 (1 *Stat.* 318, c. 11), which latter act, as amended and extended by a series of acts passed in 1794 (1 *Stat.* 393, c. 58), 1800, 1819 (2 *Stat.* 37, c. 25), and 1832 (3 *Stat.* 481, c. 19; 4 *Stat.* 559, c. 162; *Id.* 577, c. 203), formed the basis of our patent law down to 1836. In that year a general revision of the law of the subject was made, and a new and comprehensive act was passed,—the act of July 4, 1836,—by which former acts were repealed, and which established a system destined to continue in force, with some amendments and additions, till 1870. These amendatory or additional acts are, the act of March 3, 1837 (5 *Stat.* 191, c. 45), regulating recording and effect of records as evidence, enabling patents to be issued to assignees of the original inventor, and allowing a disclaimer of any excess in a specification, or a correction of the specification in cases of re-issue, and allowing a patent to be sustained in part;—the act of March 3, 1839 (5 *Stat.* 353, c. 88), protecting patentees notwithstanding sales of the article made during a term not exceeding two years before the patent is issued;—the acts of August 29, 1842 (5 *Stat.* 543, c. 263), and March 2, 1861 (12 *Stat.* 246, c. 88), allowing patents for designs; and requiring the date of the patent to be stamped upon or affixed to each patented article offered for sale;—the act of February 18, 1861 (12 *Stat.* 130, c. 37), authorizing the Supreme Court to review circuit court decisions in patent cases

without regard to the value in controversy;—the act of March 2, 1861, abolishing extensions (12 *Stat.* 246, c. 88).*

The laws thus far mentioned still possess some historic interest; and a knowledge of them, even of their precise language, is often useful in reading the decisions of former years. But they have almost lost force as respects existing rights. Few patents which were granted or extended under them are operated; the laws themselves have been repealed sufficiently long ago to allow the ordinary rights of action under them to have become extinct; and very few suits begun before the repeal are still pending.† The commissioners to revise the statutes, appointed under the first law for that purpose (who adopted the working plan of allotting distinct subjects to individual members of the board for preparation of a revised version of the laws), framed a revision of the laws on patents and copyrights which they reported to Congress; and their report became (with the addition of a chapter on trademarks inserted by Congress and afterwards pronounced unconstitutional by the Supreme Court) the basis of the act of July 8, 1870, c. 230, 16 *Stat.* 198. This act is substantially reproduced in *Rev. Stat.* tit. LX. c. 3. It was technically repealed by the revision; but the interval between the two was so short, the provisions are so nearly identical, and the general saving clause of the revision is so liberal, that the difference between the act of 1870 and the Revised Statutes is unimportant in any general study of the subject, though cases may easily occur in which it will deserve attention. The acts since the revision are: The law authorizing a resort to jury trial in patent suits (act of Feb. 16, 1875, 18 *Stat.*

* The above enumeration embraces only provisions affecting the law of patents strictly speaking, and excludes enactments relative to organization of the patent-office, powers and proceedings of officers, jurisdiction of courts, appropriations, and the like. Comprehensive collections of all the various patent laws, reprinted in chronologic order, are given in the Appendixes to the treatises of Curtis and Walker. Mr. Bump gives a convenient "List of the Laws relating to Patents, Trademarks and Copyright, showing the time of repeal and the part of the Revised Statutes where an analogous provision may now be found." (Bump Pat. 2 ed. xi.) It would be more convenient to one studying patent law exclusively, if the three sorts of laws were distinguished from each other.

For a mention of some points in decisions of the courts under former patent laws which seem inapplicable to the Revised Statutes, see Abb. Nat. Dig. tit. Patents, VIII.

† Oliver v. Rumford Chemical Works, 109 U. S. 75, is an example of a case in which so lately as 1884 it was necessary to adjudicate a suit according to the long-repealed laws; but this was because the right was acquired under them, and the question had been kept open by an unusual concurrence of death of a party and delay of litigation.

316), and a few provisions regulating conduct of business in the patent-office. For all practical purposes one who wishes to see the statute law in force at the present time (March, 1886), needs to consult only the Revised Statutes.

5. *Construction of Acts of Congress.*

Patent laws should be liberally construed, to effect the general object of securing the rights of inventors. Grant *v.* Raymond, 6 *Pet.* 218, 242; Commissioner *v.* Whiteley, 4 *Wall.* 522; Brooks *v.* Jenkins, 3 *McLean*, 432.

The general words granting the exclusive right, found in the patent law (of 1836) must be taken in connection with the whole statute or statutes on the subject and the objects and policy of the law as indicated by its various provisions, and must be construed so as to carry into execution the will of Congress. They should not be construed so as in any degree to disarm government of any of its powers, or enable an individual to embarrass it. And as attention of Congress when legislating to protect inventors is necessarily drawn to the constitutional power given for that purpose, the courts ought not to presume that the exercise of another power (here, the treaty-making power) was intended. Brown *v.* Duchesne, 19 *How.* 183, 194.

A private act of Congress authorizing the issuing of a patent to an inventor is to be considered as engrafted on the general acts for the promotion of the useful arts, and such a patent is issued in pursuance of both. Evans *v.* Eaton, 3 *Wheat.* 454, 518; Jordan *v.* Dobson, 2 *Abb. U. S.* 398; 7 *Phila.* 533.

Even if it is within the power of Congress to decide the fact that an individual is an inventor, without leaving the question of invention open to investigation, the courts will never presume Congress to have decided that question in an act, the words of which do not render such a construction unavoidable. Evans *v.* Eaton, *supra.*

A grant of exclusive right in an invention, for a specific term, does not imply a right on behalf of the people that at the end of that term the invention shall be public property. Evans *v.* Eaton, *Pet. C. Ct.* 322.

An act extending a single patent should be construed in connection with, or as engrafted upon a general law allowing extensions. Bloomer *v.* McQuewan, 14 *How.* 539.

An act granting a patent should not be construed so that it will

operate retrospectively, unless such construction is unavoidable. Blanchard *v.* Sprague, 3 *Sumn.* 535 ; 2 *Story*, 164.

6. *Nature of a Patent Right.*

The applicant must bring himself within the terms of the law before he can derive any title to demand or hold a patent. Pennock *v.* Dialogue, 2 *Pet.* 1, 18 ; aff'g 4 *Wash.* 359.

The right which an inventor has to the exclusive use of his invention is the creature of the statute ; the supreme court has always held that he has no right upon which he can maintain suit, unless he obtains letters patent according to the statute ; and his right is regulated and measured by the provisions of the act, and cannot go beyond them. Brown *v.* Duchesne, 19 *How.* 183 ; aff'g 2 *Curt.* 371 ; S. P., Morton *v.* New York Eye Infirmary, 5 *Blatchf.* 116 ; 2 *Am. L. Reg. N. S.* 672 ; 2 *Fish. Pat. Cas.* 320 ; Waterbury Brass Co. *v.* Miller, 9 *Blatchf.* 77 ; 5 *Fish. Pat. Cas.* 48 ; Sissons *v.* Gilbert, *Id.* 109.

A patent is not a "monopoly," but resembles a contract between the government and the inventor, securing to him, for a limited time, the exclusive enjoyment of the practice of his invention, in consideration of his disclosure of the secret to the public, and his relinquishment of his invention to the public at the end of the term. Attorney-General *v.* Rumford Chemical Works, 9 *Pat. Off. Gaz.* 1002 ; McKeever *v.* United States, 14 *Ct. of Cl.* 396.*

A patent in this country is a matter of right, on complying with the conditions prescribed by law. Whitney *v.* Emmett, *Baldw.* 303.

Congress having power to secure, "for limited times," to inventors, the exclusive right to their discoveries, in consideration of the benefit which the public will derive from the invention after the expiration of the term, whatever was patented to the inventor and enjoyed by the inventor and those operating in any way under him during the term, belongs to the public and is free to all at the expiration of the term. Hence, an exclusive right under the protection solely of patents, to make frames for sewing-machines in

* The opinion gives an extended and interesting account of the rise in England, of opposition to monopolies, and of the reasons why grants of patent rights were and should be excepted from it. See, on the same subject, op. Bradley, J., in Butcher's Union Co. v. Crescent City Co., 111 U. S. 746, 761 ; and, for the Act Concerning Monopolies, 2 post, 1, and note.

the shape of the letter G, cannot be maintained after the expiration of the patents on the ground that such shape is a trademark. Wilcox, &c. Sewing Machine Co. *v.* Frame, 17 *Fed. Rep'r*, 623 ; 21 *Blatchf.* 431 ; 24 *Pat. Off. Gaz.* 1272.

7. *No Right Reserved to Government.*

In the United States, where the grant of a patent partakes the nature of a recognition and protection of the patentee's right, such grant excludes the government from using the invention without either obtaining the license of the inventor, or making him compensation therefor.* James *v.* Campbell, 104 *U. S.* 356 ; rev'g 17 *Blatchf.* 42 ; 8 *Rep'r*, 455 ; 4 *Bann. & A. Pat. Cas.* 456 ; 18 *Pat. Off. Gaz.* 979 ; Brady *v.* Atlantic Works, 10 *Pat. Off. Gaz.* 702 ; McKeever *v.* United States, 14 *Ct. of Cl.* 396.

Use of a patented machine, by officers of the government, although in prosecuting public works, does not constitute such a taking of private property for public use as gives the Court of Claims jurisdiction of a claim for compensation. Thus where a warden of United States penitentiary set up six patented broom-making machines in the prison, and employed the convicts in making brooms, but there was nothing like a bargain between him and the inventor, the court held that for want of some contract binding the government to pay, no judgment could be rendered. Pitcher *v.* United States, 1 *Ct. of Cl.* 7.

A suit may be brought in the court on a special contract with a patentee, for the use of his invention by the government at an agreed price. Thus where a patented army tent was adopted by the war department, and a contract was made by direction of the secretary, with the inventor, to pay him a royalty (which was not paid), on proof of the special contract he recovered judgment. Burns *v.* United States, 4 *Ct. of Cl.* 113 ; aff'd *sub nom.* United States *v.* Burns, 12 *Wall.* 246.

The Court of Claims has jurisdiction in an action brought

* As long ago as 1856 a claim was preferred to the secretary of war for payment for government use of a patent cut-off. The government contracted with M. to build a steamboat. M. attached the cut-off to the engine without paying royalty, considering that government was entitled to the free use of the invention. The inventor applied to the secretary of war, and that officer asked the opinion of the attorney-general. The attorney-general of the day, Judge Black, advised that the government was equally bound with an individual to pay a royalty ; and that the secretary might pay one if there were an appropriation available. 9 Op. Att.-Gen. 135. Patents, &c. act, 1883, § 27, disclaims right of the crown.

upon an implied license to manufacture a patented article, or on an implied contract that government shall make compensation.* McKeever *v.* United States, 14 *Ct. of Cl.* 396; aff'd, 18 *Id.* 757; 1880, Morse Arms Manuf. Co. *v.* United States, 16 *Id.* 296; and see Dahlgren *v.* United States, *Id.* 30; Hollister *v.* Benedict Manuf. Co., 113 *U. S.* 59.

Upon proof that a patented article was submitted by the inventor to the war department and adopted and used by the secretary of war, the Court of Claims will not presume that a gratuitous license was intended by the one party, or a tortious infringement by the other; but rather that the government used the invention under an implied license and engagement to pay a reasonable royalty. McKeever *v.* United States, *supra.*

Where the government, on the invitation of an inventor, manufactures a patented military device having no market value, the implication is that the government shall pay for the valuable right to use, and not for the valueless right to manufacture. Palmer *v.* United States, 19 *Ct. of Cl.* 669.

The government, when it manufactures after a patented device but under an implied license, is as responsible as an individual. The ordnance department has no more right to manufacture a patented article for experiment than for use. Palmer *v.* United States, 20 *Ct. of Cl.* 432.

An officer of government (here, a postmaster) who, without license, uses a patented invention in the performance of the business under his charge, thereby saving expense to the government, renders himself personally liable as an infringer, to the owner of the patent;† and the sum so saved is a proper measure of the profits recoverable. Campbell *v.* James, 8 *Rep'r,* 455; Campbell *v.* James, 2 *Fed. Rep'r,* 338; 17 *Blatchf.* 42; 18 *Pat. Off. Gaz.* 1111; 10 *Rep'r,* 103; rev'd, 104 *U. S.* 356. See other decisions

* What circumstances will *not* raise a presumption or implication of a contract that government shall pay for its use of a patent, see Shavor v. United States, 4 Ct. of Cl. 440; Fletcher v. United States, 11 Id. 748.

† Inasmuch as officers of the United States, when they use articles manufactured in violation of the rights of patentees, are liable to suit therefor, therefore, where articles are advertised for by the United States, and it is claimed by another party that the successful bidder, in order to furnish the articles, must make them in violation of his patent, it is proper that the successful bidder should be required to furnish a satisfactory bond of indemnity for the security of the officer against any suit for infringement of patent by the use of the articles. 16 Op. Att.-Gen. 136.

in the cause, 3 *Fed. Rep'r*, 513 ; 10 *Rep'r*, 686 ; 18 *Pat. Off. Gaz.* 300 ; 5 *Bann. & A. Pat. Cas.* 630.

In a suit in the circuit court to enjoin an infringement, proof that respondents are manufacturing the article in question under a contract with the government and for its use does not constitute a defense. Such contract cannot confer any right to use the complainant's patent. Brady *v.* Atlantic Works, 10 *Pat. Off. Gaz.* 702.

8. *Powers of State Legislatures.*

The power conferred on Congress to grant letters patent for inventions, does not prevent the several States from legislating to protect their communities against the sale of deleterious or dangerous manufactured articles. Articles which, by the application of the invention or discovery for which letters-patent have been granted by the United States, come into existence, are, to the same extent as that of any other species of property, subject to States control. Patterson *v.* Kentucky, 97 *U. S.* 501.

Letters-patent for an invention do not authorize the patentee to sell the article within a State, in defiance of her laws enacted in the exercise of the police power forbidding or restraining such sales. Webber *v.* Virginia, 103 *U. S.* 344.

The grant of the right to the exclusive use of an invention, by a special statute of a State, does not amount to a contract securing the public use after expiration of the patent ; and if it did, Congress might, notwithstanding, grant a renewed patent. There is nothing in the constitution which forbids Congress to pass laws violating the obligations of contracts, though such a power is denied to the States individually. Evans *v.* Eaton, *Pet. C. Ct.* 322.

A State statute requiring that any note given in consideration of a sale of a patent right, shall contain a recital that it was so given, is unconstitutional and void for infringing the exclusive power of Congress to regulate the subject of patents. *Exp.* Robinson, 2 *Biss.* 309; Castle *v.* Hutchinson, 25 *Fed. Rep'r*, 394. Only Congress can prescribe special regulations as to the mode in which a patent-right may be sold and conveyed. Any interference by a State with the right to assign a patent, is void. Woolen *v.* Banker, 17 *Alb. L. J.* 72 ; 5 *Rep'r*, 259.

9. *Analogous Decisions Relative to Copyright.*

Congress has power to prescribe the conditions on which a copyright shall be obtained and owned ; and no person can avail himself

of the right, without a substantial compliance with the conditions. The courts cannot dispense with the requirements clearly prescribed by statute, because they may seem unimportant. The use of the word "securing" in the constitutional grant, does not import that an author has a natural right in his work, after publication, which the courts can protect, independent of, or beyond the act of Congress. Wheaton *v.* Peters, 8 *Pet.* 591.

Congress has power to extend the protection of the copyright law to a photographer, who, by labor and thought, artistic design and skill in placing a person before the camera, arranging costume, drapery, &c., planning light and shade, contributes to the value of a photographic portrait. Hence *Rev. Stat.* § 4952,—allowing copyright in photographs,—is constitutional, so far as its application to photographs involving such artistic labor and skill is concerned. The grant of power is not limited to protection of "books" and "authors," in the strict and limited sense; it is broad enough to authorize a copyright law protecting photographs which embody original intellectual conceptions. Barrow-Giles Lithographic Co. *v.* Sarony, 111 *U. S.* 53; aff'g 17 *Fed. Rep'r*, 591. See also Schreiber *v.* Thornton, 17 *Fed. Rep'r*, 603.

The constitution does not invest Congress with power to grant copyright (or letters patent), to a mere owner of a work as such, irrespective of his being, or having derived title from the original author, designer, composer (inventor), &c. Yuengling *v.* Schile, 12 *Fed. Rep'r*, 97; 20 *Blatchf.* 452; 13 *Rep'r*, 517.

That Congress has not power to pass a law conferring the privilege of copyright upon immoral or indecent works or compositions; the power embraces such works only as tend to "promote the progress of science and useful arts," see Martinetti *v.* Maguire, 1 *Abb. U. S.* 356.

A State cannot interfere with rights of individuals acquired under the copyright laws. Little *v.* Gould, 2 *Blatchf.* 165, 171.

10. *Relative to Trade-marks.*

The trade-marks legislation of Congress, particularly the act of Aug. 14, 1876 (19 *Stat.* 141), is unconstitutional; because the patent and copyright power does not extend to trade-marks; and the legislation in question is not sufficiently limited to foreign and interstate commerce to admit of sustaining it under the commercial power. Trademark Cases, 100 *U. S.* 82; 25 *Law. ed.* 550; 10 *Pat*

Off. Gaz. 999. To same effect were Leidersdorf *v.* Flint, 18 *Am. L. Reg. N. S.* 37 ; 7 *Cent. L. J.* 405 ; 6 *Rep'r*, 739.

A manufacturer of a patented article cannot claim protection, after expiration of his patent, against another person's making the article in imitation of the form, color, &c., of that manufactured by plaintiff ; nor enforce a right to continue the use of the stamp "——'s patent" as a trade-mark. Neither a patent nor a trade-mark relates to the accidental exterior appearance. The patent (while it lasted) protected only the novel, substantial mechanism, and the trade-mark only forbids representing defendant's article as being of the manufacture of plaintiff. Fairbanks *v.* Jacobus, 14 *Blatchf.* 337. To the same general effect, Consolidated Fruit Jar Co. *v.* Dorflinger, 2 *Am. L. T. N. S.* 571 ; Singer Manuf. Co. *v.* Strange, 6 *Fed. Rep'r*, 279 ; 2 *McCrary*, 512; 11 *Rep'r*, 661 ; Same *v.* Riley, 11 *Fed. Rep'r*, 706 ; Wilcox, &c. Sewing Machine Co. *v.* Gibbens Frame, 17 *Id.* 623 ; 24 *Pat. Off. Gaz.* 1272 ; Singer Manuf. Co. *v.* Larsen, 8 *Bis.* 151 ; 3 *Bann. & A. Pat. Cas.* 246 ; Tucker Manuf. Co. *v.* Boyington, 9 *Pat. Off. Gaz.* 455 ; Leclancha Battery Co. *v.* Western Electric Co., 21 *Fed. Rep'r*, 538.

Where complainants were the first to adopt and use, as a mark for their product, tin tags variously colored, with the name of their brand and their own name stamped thereon and fastened upon the outside of their plugs of tobacco,—*Held*, although their patent therefor was declared void after surrender and reissue, that they had the right to the device as a trade-mark, the public having come to know their tobacco by the tags of their peculiar color, shape, and size. Lorillard *v.* Wright, 15 *Fed. Rep'r*, 383.

II. THE PATENT-OFFICE.

11. *Authority of the Secretary of the Interior.*

The secretary of the interior is charged with the supervision of public business relating to the following subjects :

. . . . . .

5. Patents for inventions. *Rev. Stat.* § 441.

The authority of the secretary is supervisory rather than appellate. Supervisory power applies to executive or administrative duties, and includes authority to direct the performance of them. Thus, if the commissioner neglects or refuses to perform such a duty, or performs it improperly, the secretary may give the appro

priate direction. Edison *v.* Edison, 9 *Pat. Off. Gaz.* 403; James *v.* Sargent, 12 *Id.* 475. But decisions rendered by the commissioner, acting judicially, are not reviewable by means of an appeal to the secretary. Edison *v.* Edison, *supra;* Franklin B. Hunt, 13 *Pat. Off. Gaz.* 771; Workman *v.* McNaught, 16 *Id.* 216. A mandamus to compel the issuing of a patent runs to the secretary, not to the commissioner. United States *v.* Marble, 22 *Pat. Off. Gaz.* 1365.

Gill applied for a patent. An interference was declared, and the commissioner decided in favor of his claim to priority, and adjudged that a patent issue to Hoe & Co., his assignees. Scott, however, the claimant of the interfering invention, appealed to the secretary of the interior, who heard the appeal and adjudged Scott the first inventor, and Gill not entitled to a patent for it. The commissioner, because of this reversal of his decision, refused to receive Hoe & Co.'s final fee, or to cause the patent to be issued. They then applied to the supreme court of the District of Columbia for a mandamus, directing him to accept the fee and prepare, seal and countersign the patent, and submit it to the secretary, &c. The commissioner resisted the application; but solely to procure a decision upon the relative authority of commissioner and secretary. *Held*, reviewing the legislation, decisions and past practice elaborately, that the mode of reviewing a commissioner's decision refusing a patent, except in cases of interference, is by appeal to the supreme court of the District of Columbia (*Rev. Stat.* § 4911); and the mode of reviewing such decision in interference cases is by bill in equity under *Rev. Stat.* § 4915. Unless such appeal or bill is taken or filed, the commissioner's decision is final. The power of supervision vested in the secretary over the acts of the commissioner relates to his performance of executive and administrative duties; it does not extend to a review of the action of the commissioner in cases in which he is by law appointed to exercise his discretion judicially. In issuing or withholding patents he exercises quasi judicial functions, and his decisions can be reviewed only in the modes provided by law. Butterworth *v.* Hoe, 112 *U. S.* 50. Even admitting that so far as the public alone is concerned, the secretary may satisfy his duty of direction and superintendence by prescribing general rules for the conduct of the public business, and securing, by general oversight, conformity to them, yet whenever a private person acquires by law a personal interest in the performance by the commissioner of any act, he thereby also acquires an individual in the direction and supervision of the secretary, to correct any error,

or supply any omission or defect in its performance tending to his injury; so that the official duty of direction and supervision on the part of the secretary implies a correlative right of appeal to him, from the commissioner. Per MATTHEWS, J., Butterworth *v.* Hoe, 112 *U. S.* 50, 57.

12. *Establishment of the Patent-Office. Seal.*

There shall be in the department of the interior, an office known as the patent-office,* where all records, books, models, drawings, specifications, and other papers and things pertaining to patents shall be safely kept and preserved. *Rev. Stat.* § 475.

The seal heretofore provided for the patent-office shall be the seal of the office, with which letters patent and papers issued from the office shall be authenticated. *Rev. Stat.* § 478.

13. *Officers and Employes. Salaries.*† *Bonds.*

There shall be in the patent-office, a commissioner of

* An account of the management of departmental business connected with the patent-office, is given in Elmes Exec. Depts. c. 28; it is, however, very little more than a concise statement of matters presented in greater detail in the patent laws as published by the patent-office, and the rules of practice in the patent-office.

† The sections of the Revised Statutes purporting to fix the salaries of the above mentioned officers, and to enumerate the subordinate employes, and fix their salaries, are Nos. 477 and 440. They are omitted from this compilation not merely because they are of small importance in connection with the law of patents, but chiefly because they are likely to mislead, inasmuch as the appropriations made often vary from them. Thus, section 477 fixes the salary of the commissioner at $4,500; the appropriation for the year 1885–86 is $5,000. Stat. 1885, c. 343. Section 440 allows the office seventy-two assistant examiners arranged in three ranks; the appropriation gives it one hundred and twenty-one, arranged in four ranks. Theoretically, such changes should be authorized by some previous, independent law; and in many cases they are. Often, however, without any previous legislation, the appropriation for a subordinate post is reduced, or even omitted, for a year or two; or, on the other hand, a temporary need of additional force is supplied by appropriations continued only while the need lasts, without, in either case, taking the trouble to change the general law. The result is that the actual organization and personel of the office is best ascertained by collating with the enactments of the Revised Statutes the items in the appropriation act for the year current.

patents,* one assistant commissioner, and three examiners-in-chief, who shall be appointed by the President, by and with the advice and consent of the Senate. All other officers, clerks, and employes, authorized by law for the offices shall be appointed by the secretary of the interior, upon the nomination of the commissioner of patents. *Rev. Stat.* § 476. (See *Id.* § 169.)

The commissioner of patents and the chief clerk, before entering upon their duties, shall severally give bond, with sureties, to the treasurer of the United States, the former in the sum of $10,000, and the latter in the sum of $5,000, conditioned for the faithful discharge of their respective duties, and that they shall render to the proper officers of the treasury a true account of all money received by virtue of their offices. *Rev. Stat.* § 479.

14. *Restrictions upon Officers and Employes.*

All officers and employes of the patent-office shall be incapable, during the period for which they hold their

* The office of commissioner was created by the act of 1836. The following persons have held it.

Name.	Whence appointed.	Date of commission.
Henry L. Ellsworth	Connecticut	July 4, 1836
Emund Burke	New Hampshire	May 5, 1845
Thomas Ewbank	New York	May 9, 1849
Silas H. Hodges	Vermont	November 1, 1852
Charles Mason	Iowa	March 24, 1853
Joseph Holt	Kentucky	September 9, 1857
William D. Bishop	Connecticut	May 7, 1859
Phillip F. Thomas	Maryland	February 15, 1860
David P. Holloway	Indiana	March 28, 1861
Thomas C. Theaker	Ohio	August 15, 1865
Elisha Foote	New York	July 28, 1868
Samuel S. Fisher	Ohio	May 1, 1869
Mortimer D. Leggett	Ohio	January 16, 1871
John M. Thatcher	Virginia	November 1, 1874
R. Holland Duell	New York	October 1, 1875
Ellis Spear	Maine	January 30, 1877
Halbert E. Paine	Wisconsin	November 1, 1878
Edgar M. Marble	Michigan	May 7, 1880
Benjamin Butterworth	Ohio	November 1, 1883
Martin V. Montgomery	Michigan	March 23, 1885

appointments, to acquire or take, directly or indirectly, except by inheritance or bequest, any right or interest in any patent issued by the office. *Rev. Stat.* § 480.

The law does not disqualify a commissioner of patents from obtaining a patent after his term of office has expired, for an invention made by him while holding such office; and in such case the invention will date back to the time when it was actually made, although he could not then have obtained a patent for it. Foote *v.* Frost, 3 *Bann. & A. Pat. Cas.* 607.

The provision of the act of 1836 (5 *Stat.* 118),—disqualifying an employe in the patent-office from acquiring an interest in a patent,—did not disqualify such employe from obtaining a patent after such employment had ceased, for an invention made prior to the commencement of such employment. Page *v.* Holmes Burglar Alarm Tel. Co., 17 *Blatchf.* 484; 1 *Fed. Rep'r*, 304; 17 *Pat. Off. Gaz.* 737; 5 *Bann. & A. Pat. Cas.* 165.

See the following somewhat analogous provisions: No patented article connected with marine engines shall hereafter be purchased or used in connection with any steam vessels of war until the same shall have been submitted to a competent board of naval engineers, and recommended by such board, in writing, for purchase and use. *Rev. Stat.* § 1538.

No royalty shall be paid by the United States to any one of its officers or employes for the use of any patent for the system, or any part thereof, mentioned in the preceding section [viz., the breech-loading system for muskets and carbines, known as "the Springfield breech-loading system"], nor for any such patent in which said officers or employes may be directly or indirectly interested. *Rev. Stat.* § 1673.

15. *Duties of Commissioner.*

The commissioner of patents, under the direction of the secretary of the interior, shall superintend or perform all duties respecting the granting and issuing of patents directed by law; and he shall have charge of all books, records, papers, models, machines, and other things belonging to the patent-office. *Rev. Stat.* § 481.

The authority of the commissioner of patents to issue patents is not of the nature of jurisdiction, in its common law and technical acceptation; and the doctrine appertaining to acts or judgments of inferior tribunals, that he who sets up such judgment must aver and prove that the tribunal had jurisdiction in the matter, does not apply to his acts. Wilder *v.* McCormick, 2 *Blatchf.* 31.

An application for an extension of a patent, under the act of 1836, § 18, was pending at the time of the passage of the act of 1848,—which conferred upon the commissioner of patents, solely, the power previously vested in the board created by the act of 1836. *Held*, that it was not necessary to renew the application, but that the commissioner had the power to go on with the proceedings, as having been already properly instituted, and complete them by granting the extension. Colt *v.* Young, 2 *Blatchf.* 471.

Whether the commissioner of patents has authority to refuse a patent after a favorable decision of the board of examiners in chief; and as to his supervisory powers over examiners generally, see Hull *v.* Commissioner of Patents, 2 *MacArthur*, 90; *Id.* 125; 8 *Pat. Off. Gaz.* 46.

The act of July 4, 1836,—empowering the commissioner of patents to issue a patent in certain cases whenever the supreme court of the District of Columbia shall decide that an applicant is entitled to a patent,—does not authorize the court to compel the commissioner, by mandamus or injunction, to issue the patent. Mason *v.* Rowley, 2 *Am. L. T. U. S. Cts.* 8.

An action of trespass will not lie against the commissioner of patents for refusing to issue a patent; for the duty of issuing letters-patent devolves upon the secretary of the interior; only the duty of countersigning and affixing the seal of office to the patent, upon the commissioner. Whitely *v.* Fisher, 4 *Fish. Pat. Cas.* 248.

16. *Acting Commissioner.*

The term "acting commissioner" is used, not on the idea of there being any distinct officer known to the law by that title, but as designating a person who, in case of the death or resignation, or during the absence or sickness of the commissioner, may be temporarily authorized to perform his duties. For the provisions by which a person may thus act as commissioner, see *Rev. Stat.* §§ 178, 179. Their application is not peculiar to the office of commissioner of patents, and the necessity of resort to section 179 with

respect to that office is greatly diminished by the creation of the office of "assistant commissioner." See *Rev. Stat.* §§ 476, 478.

A patent is not invalid because it is certified by a person as "acting commissioner," instead of being certified by the commissioner himself. A patent signed by an "acting commissioner of patents" is valid upon its face. The courts will judicially take notice of the persons who preside over the patent-office, whether permanently or transiently. Wilson *v.* Rosseau, 4 *How.* 646, 663; York & Maryland R. R. Co. *v.* Winans, 17 *How.* 30, 41; Woodworth *v.* Hall, 1 *Woodb. & M.* 248; 6 *Pa. L. J.* 173.

A patent otherwise duly issued, but countersigned by an "acting commissioner," is valid, when no allegation of fraud or usurpation is made, and his act is sanctioned by the commissioner acting in person.* Smith *v.* Mercer, 5 *Pa. L. J.* 529; 4 *West. L. J.* 49.

In a case where the bill on an extended patent alleged that the extension had been granted "by the commissioner of patents," but the proof was that it was granted by H., who was examiner in chief, as "acting commissioner," McKennan, J. (*E. Dist. Pa.*, 1873), sustained the suit; saying that a provisional officer invested by law with the functions of the commissioner is properly described (in pleading) as commissioner; that his lawful authority is presumed from his actual incumbency, and even if this presumption is not conclusive (which it seemingly is, Rubber Co. *v.* Goodyear, 9 *Wall.* 796), no affirmative proof is needful; absence, &c., of the commissioner is presumed; the burden of showing non-existence of the contingency on which the substitute might lawfully act is upon the party who denies the validity of the ostensible act of the officer. Dorsey Harvester Rake Co. *v.* Marsh, 6 *Fish.* 387; 9 *Phila.* 395.

17. *Duties of Examiners in chief.*

The examiners in chief shall be persons of competent legal knowledge and scientific ability, whose duty it shall be, on the written petition of the appellant, to revise and determine upon the validity of the adverse decisions of examiners upon applications for patents, and for reissues of

* Compare a case of a patent accidentally issued without signature of the secretary of the interior, and afterward signed by "acting" secretary. Marsh v. Nichols, 18 Fed. Rep'r, 914; 24 Pat. Off. Gaz. 901.

patents, and in interference cases; and, when required by the commissioner, they shall hear and report upon claims for extensions, and perform such other like duties as he may assign them. *Rev. Stat.* § 482.

18. *Establishment of Regulations.*

The commissioner of patents, subject to the approval of the secretary of the interior, may from time to time establish regulations, not inconsistent with law, for the conduct of proceedings in the patent-office. *Rev. Stat.* § 483.

Congress in creating the patent-office has by express legislation given that office the power to enact rules for its conduct; those rules, if within the powers of the office and reasonable, are just as authoritative as the laws of Congress itself. United States *v.* Marble, 22 *Pat. Off. Gaz.* 1365.

A comprehensive code of regulations, entitled Rules of Practice in the United States Patent-Office,* has been compiled and is published for gratuitous distribution. Copies may be obtained on application to the commissioner. They are accompanied by Forms, the observance of which in all cases to which they may be applicable, is recommended to inventors and attorneys.

19. *Arrangement and Exhibition of Models, &c. Disposal.*

The commissioner of patents shall cause to be classified and arranged in suitable cases, in the rooms and galleries provided for that purpose, the models, specimens of composition, fabrics, manufactures, works of art, and designs, which have been or shall be deposited in the patent-office; and the rooms and galleries shall be kept open during suitable hours for public inspection. *Rev. Stat.* § 484.

* The substance of the important rules is embodied in this work, in connection with the statutes or decisions on the subjects to which the rules relate. The edition in use at the time of writing, March, 1886, is: Eighth revised edition, November 16, 1883, under which rules 31, 32, 33, 34, 35, 36, 37, 38, 39, 40, 41 44, 45, 47, 86, 140, 144, and 145 were amended.

The commissioner of patents may restore to the respective applicants such of the models belonging to rejected applications as he shall not think necessary to be preserved, or he may sell or otherwise dispose of them after the application has been finally rejected for one year, paying the proceeds into the treasury, as other patent moneys are directed to be paid. *Rev. Stat.* § 485.

In all cases where an application has been rejected more than two years, the model, unless it is deemed necessary that it should be preserved in the office, may be returned to the applicant upon demand, and at his expense; and the model, in any pending case of less than two years' standing, may be returned to the applicant upon the filing of a formal abandonment of the application, signed by the applicant in person. (See Rule 165.) Models belonging to patented cases will not be taken from the office except in the custody of some sworn employe of the office specially authorized by the commissioner. *Rules of Practice, Pat. Off.* No. 59.

Models filed as exhibits in contested cases, may be returned to the applicant. If not claimed within a reasonable time they may be disposed of, at the discretion of the commissioner. *Id.* No. 60.

20. *Library.**

There shall be purchased for the use of the patent-office a library of such scientific works and periodicals, both foreign and American, as may aid the officers in the discharge of their duties, not exceeding the amount annually appropriated for that purpose. *Rev. Stat.* § 486.

Library regulations. No persons are allowed to enter the alcoves, or take books from the library, except officers of the bureau and members of the examining corps. All books taken from the library must be entered in a register kept for the purpose, and returned on the call of the librarian. Any book lost or defaced must be replaced by a copy of the same. *Rules of Prac.* No. 217.

21. *Correspondence with the Office.*

All business with the office should be transacted in writing. Unless by the consent of all parties, the action of the office will be

* By the act of Aug. 4, 1854, c. 242, § 8, 10 Stat. 572, the collections of the Exploring Expedition, are placed under the care and management of the commissioner of patents.

based exclusively on the written record. No attention will be paid to any alleged oral promise, stipulation, or understanding, in relation to which there is disagreement or doubt. *Rules of Practice, Pat. Off.* No. 1.

All office letters must be sent in the name of the "Commissioner of Patents." All letters and other communications intended for the office must be addressed to him. *Id.* No. 2.

Express charges, freight, postage, &c., on matter sent to the patent-office must be prepaid. *Id.* No. 3.

The personal attendance of applicants at the patent-office is unnecessary. Their business can be transacted by correspondence. *Id.* No. 4.

The assignee of the entire interest of an invention is entitled to hold correspondence with the office to the exclusion of the inventor. *Id.* No. 5.

Where there has been an assignment of an undivided part of an invention, the inventor and the assignee will both be recognized as the proper parties to hold correspondence with the office, and all amendments and other actions in such cases must be signed by both parties; but official letters will be sent in such case to the post-office address of the inventor, unless he shall otherwise direct. *Id.* No. 6.

When an attorney shall have filed his power of attorney, duly executed, the correspondence will be held with him. *Id.* No. 7.

A double correspondence with the inventor and an assignee, or with a principal and his attorney, or with two attorneys, cannot generally be allowed. *Id.* No. 8.

A separate letter should in every case be written in relation to each distinct subject of inquiry or application. Assignments for record, final fees and orders for copies or abstracts must be sent to the office in separate letters. *Id.* No. 9.

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 (see Rule 31), and the date of filing the same. *Id.* No. 10.

When the letter concerns a patent, it should state the name of the patentee, the title of the invention, and the number and date of the patent. *Id.* No. 11.

No attention will be paid to *ex parte* statements or protests of persons concerning pending applications to which they are not parties, unless information of the pendency of such applications shall

have been voluntarily communicated by the applicants. *Id.* No. 12.

Letters received at the office will be answered, and orders for printed copies filled, without unnecessary delay. Telegrams, if not received before 3 o'clock p. m. cannot ordinarily be answered until the following day. *Id.* No. 13.

The office cannot respond to inquiries as to the novelty of an alleged invention in advance of an application for a patent, nor to inquiries propounded with a view of ascertaining whether any alleged improvements have been patented, and, if so, to whom; nor can it act as an expounder of the patent law, or as counselor for individuals, except as to questions arising within the office. 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 models pertaining to all patents granted may be inspected either by himself or by any attorney or expert he may call to his aid, and its reports are widely distributed. (See Rule 216.) Examiners' digests are not open to public inspection. *Id.* No. 14.

Caveats and pending applications are preserved in secrecy. (See Rule 171.) *Id.* No. 15.

After a patent has issued, the model, specification, drawings, and all documents relating to the case are subject to general inspection, and copies, except of the model, will be furnished at the rates specified in Rule 209. *Id.* No. 16.

22. *Patent Agents and Attorneys.**

Any person of intelligence and good moral character may appear as the agent or the attorney in fact of an applicant, upon filing a proper power of attorney. *Rules of Practice*, No. 17.

Before any attorney, original or associate, will be allowed to inspect papers or take action of any kind, his power of attorney must be filed. No power of attorney purporting to have been given to a firm or copartnership will be recognized, either in favor of the

* The rules advise that the assistance of competent counsel will, in most cases, be of advantage to an applicant; that the office cannot aid an inventor in selecting an attorney, or assume any responsibility for an attorney's acts; that it will be unsafe to trust those who pretend to the possession of any facilities except capacity and diligence for procuring patents in a shorter time, or with broader claims than others, and that applicants should not impose on senators or representatives, labor in attending to applications.

firm or any of its members, unless all its members shall be named in such power of attorney. *Id.* No. 18.

Substitution or association can be made by an attorney upon the written authorization of his principal; but such authorization will not empower the second agent to appoint a third. *Id.* No. 19.

Powers of attorney may be revoked * at any stage in the proceedings of a case upon application to and approval of the commissioner; and when so revoked, the office will communicate directly with the applicant, or such other attorney as he may appoint. Attorneys will be promptly notified by the examiner in charge of the case, of the revocation of their powers of attorney. An assignment of an undivided interest will not operate as a revocation of the power previously given, but the assignee of the entire interest may be represented by an attorney of his own selection. *Id.* No. 20.

Attorneys will be required to conduct their business with the office with decorum and courtesy. Papers presented in violation of this requirement will ordinarily be returned. Complaints against examiners and other officers must be made in separate communications, and will be promptly investigated. *Id.* No. 22.

For gross misconduct the commissioner of patents may refuse to recognize any person as a patent agent, either generally or in any particular case; but the reasons for such refusal shall be duly recorded, and be subject to the approval of the secretary of the interior. *Rev. Stat.* § 487.

In Boyden *v.* Burke, 14 *How.* 575, B. had made application to the commissioner, accompanied with an insulting letter, for copies of certain papers of record; but the commissioner refused them on the ground of B.'s incivility, &c. B., without making any apology, wrote to a third person requesting him to apply as B.'s agent for

* The death of the inventor revokes a power of attorney given by him to a patent agent. Eagleton Manuf. Co. v. West, &c. Manuf. Co., 2 Fed. Rep'r, 774; 18 Blatchf. 218; 5 Bann. & A. 475; 17 Pat. Off. Gaz. 1504. This is the ordinary rule as to principal and agent. Hunt v. Rousmanier, 8 Wheat. 174; and applies even to an act of agency performed while the death of the principal is yet unknown to the agent. Galt v. Galloway, 4 Pet. 331. See also, as to effect of death of principal, 19 Am. L. Reg. N. S. 401; and 39 Am. Dec. 81, note.

the papers. The agent tendered the fees and demanded the papers; but the commissioner renewed his refusal, saying that until B. "comes to the conclusion to treat this office with civility," &c., "this office will have no intercourse with him, directly or through the agency of others." In B.'s action for damages, *Held*, that a person desiring official services must request it in a proper manner; a demand accompanied with rudeness and insult is not a legal demand; and the letter which accompanied the plaintiff's first demand justified the commissioner in refusing it. But the demand afterwards made through the agent was made in a proper manner, and the commissioner was not justified in refusing it on account of B.'s former misconduct. For the second refusal B. was entitled to at least nominal damages. Boyden *v.* Burke, 14 *How.* 575.

23. *Printing of Papers. Engraving, &c. Distribution and Sale.*

The commissioner of patents may require all papers filed in the Patent-Office, if not correctly, legibly, and clearly written, to be printed at the cost of the party filing them. *Rev. Stat.* § 488.

The commissioner of patents may print, or cause to be printed, copies of the claims of current issues, and copies of such laws, decisions, regulations, and circulars as may be necessary for the information of the public. *Rev. Stat.* § 489.

The commissioner of patents is authorized to have printed, from time to time, for gratuitous distribution, not to exceed one hundred and fifty copies of the complete specifications and drawings of each patent hereafter issued, together with suitable indexes, one copy to be placed for free public inspection in each capital of every State and Territory, one for the like purpose in the clerk's office of the district court of each judicial district of the United States, except when such offices are located in State or Territorial capitals, and one in the Library of Congress,

which copies shall be certified under the hand of the commissioner and seal of the patent-office, and shall not be taken from the depositories for any other purpose than to be used as evidence. *Rev. Stat.* § 490. See *Id.* § 894.

See also the following enactment: It shall be the duty of the commissioner of patents to furnish, free of cost, one copy of the bound volumes of specifications and drawings of patents published by the patent-office, to each of the executive departments of the government, upon the request of the head thereof. Act of March 3, 1875, c. 130, § 12, 18 *Stat.* 402; *Rev. Stat.* 1 *Supp.* 166.

The commissioner of patents is authorized to have printed such additional numbers of copies of specifications and drawings, certified as provided in the preceding section, at a price not to exceed the contract price for such drawings, for sale, as may be warranted by the actual demand for the same; and he is also authorized to furnish a complete set of such specifications and drawings to any public library which will pay for binding the same into volumes to correspond with those in the patent-office, and for the transportation of the same, and which shall also provide for proper custody for the same, with convenient access for the public thereto, under such regulations as the commissioner shall deem reasonable. *Rev. Stat.* § 491.

The lithographing and engraving required by the two preceding sections shall be awarded to the lowest and best bidders for the interests of the government, due regard being paid to the execution of the work, after due advertising by the congressional printer under the direction of the joint committee on printing; . . . or if . . . . the work can be performed under the direction of the commissioner of patents more advantageously than in the manner above prescribed, it shall be so done, under such limitations and conditions as the joint committee on printing may from time to time prescribe. *Rev. Stat.* § 492.

The appropriation for photolithographing, or otherwise producing plates for the Official Gazette, and copies of designs, trade-marks and pending applications, and for the reproduction of exhausted copies, for the fiscal year 1885–86, was coupled with a proviso: "said photolithographing, or otherwise producing plates and copies" . . . . "to be done under the supervision of the commissioner of patents, and in the city of Washington, if it can be there done at reasonable rates; and the commissioner of patents, under the direction of the secretary of the interior, shall be authorized to make contracts therefor."

The price to be paid for uncertified printed copies of specifications and drawings of patents shall be determined by the commissioner of patents, within the limits of ten cents as the minimum and fifty cents as the maximum price. *Rev. Stat.* § 493.

24. *Certified Copies, &c., to be Evidence.*

Written or printed copies of any records, books, papers, or drawings belonging to the patent-office, and of letters patent, authenticated by the seal and certified by the commissioner or acting commissioner thereof, shall be evidence in all cases wherein the originals could be evidence; and any person making application therefor, and paying the fee required by law, shall have certified copies thereof. *Rev. Stat.* § 892.

Papers or drawings on file in the patent-office are public records, and certified copies of them are admissible in evidence; so far as they may be discordant, one may destroy the effect of the other; but they need not concur in every particular. Emerson *v.* Hogg, 2 *Blatchf.* 1, 12; Toohey *v.* Harding, 5 *Bann. & A. Pat. Cas.* 195.

The letters of the plaintiff to the secretary of state, containing applications for a patent, and specifications, certified under the seal of that department, as papers remaining in that office, were *held* proper evidence. Pettibone *v.* Derringer, 4 *Wash.* 215.

A certified copy from the patent office, of an assignment, is *prima facie* evidence of the genuineness of the original, and may be read in evidence to the jury. Lee *v.* Blandy, 1 *Bond*, 361;

2 *Fish. Pat. Cas.* 89; Brooks *v.* Jenkins, 3 *McLean*, 432; 2 *West. L. J.* 11.

Certified copies of papers in the patent-office must be received as *prima facie* evidence of the genuineness of the originals on file, and absolute correctness of the copies from the record. Parker *v.* Haworth, 4 *McLean*, 370.

A certified copy of a patent, surrendered and canceled, is admissible in evidence to show that an improvement subsequently patented is not original, though it does not specify when it was canceled, or how, or for what defect. Delano *v.* Scott, *Gilp.* 489.

Letters patent granted under the great seal of the government, are *prima facie* evidence that they have been regularly issued, (Philadelphia & Trenton R. R. Co. *v.* Stimpson, 14 *Pet.* 448; Wilder *v.* McCormick, 2 *Blatchf.* 31; Orr *v.* Badger, 7 *L. Rep'r*, 467;) and that the patentee has made the invention for which the patent is granted. Philadelphia & Trenton R. R. Co. *v.* Stimpson, 14 *Pet.* 448; Haskell *v.* Shoe Machinery Manuf. Co., 3 *Bann. & A. Pat. Cas.* 553; Konold *v.* Klein, 5 *Rep'r*, 427. They are also received as *prima facie* evidence of the facts asserted in them as to the novelty and utility of the invention patented. Corning *v.* Burden, 15 *How.* 252, 270; Union Sugar Refinery *v.* Matthiesson, 3 *Cliff.* 639; Wilson *v.* Barnum, 2 *Fish. Pat. Cas.* 635; 1 *Wall. Jr. C. Ct.* 346; Allen *v.* Hunter, 6 *McLean*, 303; Heinrich *v.* Luther, *Id.* 345. The patent is, however, but very slight evidence of the novelty and utility of an invention. Lowell *v.* Lewis, 1 *Mas.* 182.

The act of the commissioner in extending letters patent is evidence of all the facts which he is required to find in order to grant such extension, in the absence of fraud and excess of jurisdiction. Clum *v.* Brewer, 2 *Curt.* 506.

A joint patent is *prima facie* evidence that the invention was joint, but such fact may be disproved at the trial. Hotchkiss *v.* Greenwood, 4 *McLean*, 456; see aff'ce, 11 *How.* 248.

A signature to the certificate of copies by a person styling himself "acting commissioner," is sufficient on its face, in controversies between the patentee and third persons; as the law recognizes an acting commissioner to be lawful. Woodworth *v.* Hall, 1 *Woodb. & M.* 248.

Under Rev. Stat. §§ 892, 893, a copy of a French patent, certified by the director of the National Conservatory of Arts and Manufactures, under its seal, and verified by the ministers of agriculture

and commerce, and of foreign affairs, under their seals, but not under the Great Seal of France, is properly authenticated, and admissible in evidence. Schoerken *v.* Swift, &c. Co., 7 *Fed. Rep'r*, 469; 19 *Blatchf.* 209; 19 *Pat. Off. Gaz.* 1493.

If copies of a patent are erroneous, the commissioner ought to make them conform to the patent itself and to the record. Woodworth *v.* Hall, 1 *Woodb. & M.* 248, 260; 6 *Pa. L. J.* 178.

Inaccuracies in a transcript from the patent-office may be shown by another transcript, duly certified. Brooks *v.* Jenkins, 3 *McLean*, 432; 2 *West. L. J.* 11.

Patents are public records, and all persons are entitled to copies of them, upon demand made in a proper manner, and tender of the legal fees. Boyden *v.* Burke, 14 *How.* 575.

25. *Copies of Foreign Letters Patent.*

Copies of the specifications and drawings of foreign letters patent, certified as provided in the preceding section, shall be *prima facie* evidence of the fact of the granting of such letters patent, and of the date and contents thereof. *Rev. Stat.* 893.

26. *Printed copies of Specifications and Drawings of Patents.*

The printed copies of specifications and drawings of patents, which the commissioner of patents is authorized to print for gratuitous distribution, and to deposit in the capitols of the States and Territories, and in the clerk's offices of the district courts, shall, when certified by him and authenticated by the seal of his office, be received in all courts as evidence of all matters therein contained. *Rev. Stat.* § 894. [See *Id.* § 490.]

27. *Annual Report of the Commissioner.*

The commissioner of patents shall lay before Congress, in the month of January, annually, a report, giving a detailed statement of all moneys received for patents, for

copies of records or drawings, or from any other source whatever; a detailed statement of all expenditures for contingent and miscellaneous expenses; a list of all patents which were granted during the preceding year; designating under proper heads the subjects of such patents; an alphabetical list of all the patentees, with their places of residence; a list of all patents which have been extended during the year; and such other information of the condition of the patent-office as may be useful to congress or the public. *Rev. Stat.* § 494. [See *Id.* §§ 195, 196.]

28. *Disbursements for Patent-Office.*

All disbursements for the patent-office shall be made by the disbursing clerk of the interior department. *Rev. Stat.* § 496.

III. AUTHORITY FOR ISSUING PATENTS.

29. *How issued, attested and recorded.*

All patents shall be issued in the name of the United States of America, under the seal of the patent-office, and shall be signed by the secretary of the interior and countersigned by the commissioner of patents, and they shall be recorded, together with the specifications, in the patent-office, in books to be kept for that purpose. *Rev. Stat.* § 4883.

Only the government can raise the objection that the seal appearing regularly affixed to a patent was placed upon it without due authority; the point is not available in defense of a suit upon the patent. Doughty *v.* West, 6 *Blatchf.* 429; 3 *Fish. Pat. Cas.* 580.

Patents cannot be withheld on moral grounds relating to the conduct of the applicant. 1 *Opp. Att. Gen.* 170. They cannot be granted to every applicant, but only to such persons as show them-

selves to be within the description of the statute, as entitled to receive one. 2 *Op. Att. Gen.* 511. In cases of doubt as to the patentability of an invention, it will accord with the policy of the law to issue a patent to the petitioner, thereby giving him an opportunity of trying the validity of his right. 2 *Opp. Att. Gen.* 52.

The commissioner of patents in issuing letters patent does not warrant the same, nor does the patent bind the government more than it does private persons; but the validity of such patent is open to inquiry, either in whole or in part, whether at the instance of private persons or of the government. A patent does not conclude anybody. 8 *Opp. Att. Gen.* 277.

A patent must be signed by the commissioner of patents and the secretary of the interior; if signed by the commissioner and not by the secretary, it is a nullity, though the omission be accidental. A patent thus erroneously signed cannot be sustained by the production of the record of the patent-office showing a complete patent; nor can it be amended by affixing the signature of the secretary's successor in office. Marsh *v.* Nichols, 15 *Fed. Rep'r*, 914; 24 *Pat. Off. Gaz.* 901.

30. *Contents and Duration.*

Every patent shall contain a short title or description of the invention or discovery, correctly indicating its nature and design, and a grant to the patentee, his heirs, or assigns, for the term of seventeen years, of the exclusive right to make, use, and vend the invention or discovery throughout the United States and Territories thereof, referring to the specification for the particulars thereof. A copy of the specification and drawings shall be annexed to the patent and be a part thereof. *Rev. Stat.* § 4884.

An inventor has a right to call his invention or patented article what he pleases, provided he do not assume an already existing and popular name, to the prejudice of those who have preoccupied the name. 2 *Op. Att. Gen.* 109.

31. *Embracing two Inventions in a single Patent.*

As a general rule, a single patent cannot embrace two devices which are wholly independent of each other; or embody distinct

improvements upon unconnected machines. But where two or more devices relate to one subject or are connected in nature and operation they may be secured by a single patent. Hogg *v.* Emerson, 6 *How.* 437 : aff'g Emerson *v.* Hogg, 2 *Blatchf.* 1 ; Barrett *v.* Hall, 1 *Mas.* 437 ; Moody *v.* Fiske, 2 *Mas.* 112 ; Wyeth *v.* Stone, 1 *Story*, 273 ; 4 *Law Rep.* 54 ; Maxheimer *v.* Meyer, 9 *Fed. Rep'r*, 460 ; 20 *Blatchf.* 17 ; 20 *Pat. Off. Gaz.* 1162 ; Root *v.* Ball, 4 *McLean*, 177.

Whether both process and product may be included in one patent. Welling *v.* Rubber Coated, &c. Co., 7 *Pat. Off. Gaz.* 608; 97 *U. S.* 7; Gage *v.* Kellogg, 23 *Fed. Rep'r*, 891.

Whether an invention or improvement ought to be embraced in one or in several patents, is discretionary with the patent-office. Bennett *v.* Fowler, 8 *Wall.* 445 ; McKay *v.* Dibert, 5 *Fed. Rep'r*, 587 ; 19 *Pat. Off. Gaz.* 1351 ; 11 *Rep'r*, 386.

Rev. Stat. § 4884, by implication requires that each patent shall embrace but one invention. Sessions *v.* Romadka, 21 *Fed. Rep'r*, 124.

An inventor took out a patent, but in an action for an infringement thereof, it was proved that as to a part of the invention he was not the first inventor, and therefore the court held that his patent was void, as being too broad ; he afterward took out another patent for those parts of his invention not known before ; and it was then *held* , that the two patents were not for the same invention. Treadwell *v.* Bladen, 4 *Wash.* 703.

32. *Issuing several Patents for one Invention.*

A patentee cannot have in use at the same time two valid patents for the same invention. The first patent obtained by an inventor, while it remains unrepealed, is an estoppel to any future patent for the same invention. Barrett *v.* Hall, 1 *Mas.* 447 ; Odiorne *v.* Amesbury Nail Factory, 2 *Mas.* 28. If, however, several patents are taken out by several patentees for a several invention, and the same patentees afterward take out a joint patent for the same as a joint invention, the parties are not absolutely estopped by the former patents from asserting the invention to be joint, but the former patents are very strong evidence against the joint invention. Barrett *v.* Hall, 1 *Mas.* 449.

Where the patent-office grants a patent for one invention, and afterward, upon a claim filed previously to that on which such patent has been granted, issues another, the second patent, not the first is void. Suffolk Co. *v.* Hayden, 3 *Wall.* 315 ; 3*rd Circ.* (*Pa.*), 1880,

McMillin *v.* Rees, 1 *Fed. Rep'r*, 722; 17 *Pat. Off. Gaz.* 1222; 9 *Rep'r*, 554 ; 5 *Bann. & A. Pat. Cas.* 269.

A patentee cannot claim in a patent the same thing claimed by him in a prior patent ; nor cover what he omitted to claim in a prior patent in which the invention was described, unless he reserved the right to claim it in a separate patent, and seasonably applied therefor. James *v.* Campbell, 104 *U. S.* 356; rev'g 17 *Blatchf.* 42 ; 18 *Pat. Off. Gaz.* 979; 8 *Rep'r*, 455.

The issue of a design patent more than two years prior to the issue of a mechanical patent to the same patentee and for the same device does not invalidate the mechanical patent. Collender *v.* Griffith, 2 *Fed. Rep'r*, 206; 18 *Blatchf.* 110; 18 *Pat. Off. Gaz.* 241; 10 *Rep'r*, 8; 5 *Bann. & A. Pat. Cas.* 372.

When a person has, within the meaning of the patent law, made an invention which he has described in an application for a patent, and a patent has been issued on such application for other matters of invention, he should not be precluded for that reason alone from applying for and obtaining a patent for that which was described but not claimed in the first patent. Graham *v.* Geneva Lake Crawford Manuf. Co., 11 *Fed. Rep'r*, 138; 21 *Pat. Off. Gaz.* 1536; Graham *v.* McCormick, 11 *Fed. Rep'r*, 859; 21 *Pat. Off. Gaz.* 1533; 10 *Biss.* 39; 5 *Bann. & A. Pat. Cas.* 244.

33. *Or for distinct Parts of the same Invention.*

Although there cannot be more than one valid patent for an invention, nor can the grantee of a patent sustain an action upon another patent for the same invention, issued afterward, yet separate patents for separate and distinct parts of the same invention are nevertheless valid. Jones *v.* Sewall, 3 *Cliff.* 563; 3 *Pat. Off. Gaz.* 630 ; 6 *Fish. Pat. Cas.* 343 ; and see reversal, 91 *U. S.* 171 ; also Bain *v.* Morse, 6 *West. L. J.* 372.

An inventor may have distinct patents for several distinct devices, although he may have included them in one, making a separate claim for each device. Wheeler *v.* McCormick, 4 *Pat. Off. Gaz.* 692.

Separate patents for severable parts of the same invention may be granted, although the whole invention is fully described in each of them to explain the purpose and mode of operation of the parts covered by the claims in such patents. McMillan *v.* Rees, 1 *Fed. Rep'r*, 722; 17 *Pat. Off. Gaz.* 1222; 9 *Rep'r*, 544; 5 *Bann. & A. Pat. Cas.* 269.

34. *Joint Inventors and Patents.*

A joint patent may well be granted for a joint invention. When an invention is the result of the combined mental operations of two persons acting together, as neither can claim to be the sole inventor, the invention is joint, and they are jointly entitled to a patent. Barrett *v.* Hall, 1 *Mas.* 447, 472. In other words, if the circumstances are such as to show that two parties contributed to an invention, so as to make them joint inventors, a joint patent should be taken out. Thomas *v.* Weeks, 2 *Paine,* 92; Watson *v.* Bladen, 4 *Wash.* 580; Arnold *v.* Bishop, 1 *Macar. & M.* 36; with which compare Gottfried *v.* Philip Best Brewing Co., 17 *Pat. Off. Gaz.* 675; 5 *Bann. & A. Pat. Cas.* 4; Worden *v.* Fisher, 11 *Fed. Rep'r,* 505; 21 *Pat. Off. Gaz.* 1957. Hence, where two are joint inventors of a machine, if one of them, without acquiring the other's interest, obtains a patent in his own name, he will be deemed guilty of fraud, and will in equity be considered as a trustee for the other. Reutgen *v.* Kanowrs, 1 *Wash.* 168. And where there was a mutual agreement between a patentee and the inventor of an improvement upon his device, that the patentee should surrender his individual right, and a new patent for the improved device should be applied for by the two parties jointly, it was *held,* that in equity they were joint owners of the patent as improved by the subsequent invention, and that the inventor of the improvement could restrain the patentee from using his patent except for their joint benefit. Duke *v.* Graham, 19 *Fed. Rep'r,* 647.

But a joint patent cannot be sustained upon a sole invention of either of the patentees, for the patent act gives no right to a patent except to the inventor; and no person can be at the same time the sole and a joint inventor of the same invention. Barrett *v.* Hall, 1 *Mas.* 447, 472. Where one of two persons claiming as joint inventors had transferred his interest in the invention to the defendants, who also owned, by assignment from the rival inventor, the patent upon which the joint application was rejected; and the bill (which was filed after rejection of plaintiff's application on an interference, to obtain a decree for a patent) treated the defendants as wrongful and fraudulent holders of their patent, and ignored wholly their rights to any interest in the invention, it was *held,* that the patent should not be issued to the joint inventors, for a court of equity will not aid the inventor to obtain a patent in direct violation of his agreement transferring the property in his invention. Runstetler

v. Atkinson, 23 *Pat. Off. Gaz.* 949; 1 *Macar. & M.* 382. Where a patent was issued to B., J. and L., jointly, in conformity to their application as joint inventors, when in fact the device patented was not the joint invention of all of the applicants, but the sole invention of B., the others (J. and L.) being his assignees only,—*Held*, that it was not within the power of the interior department to correct the patent thus issued so as to show that B. was the inventor of the device and that J. and L. are the assignees thereof; the patent issued upon such application being void, the department cannot, by means of alterations or corrections, impart validity thereto. 16 *Op. Att. Gen.* 116

35. *Date of Patent.*

Every patent shall bear date as of a day not later than six months from the time at which it was passed and allowed, and notice thereof was sent to the applicant or his agent; and if the final fee is not paid within that period the patent shall be withheld. *Rev. Stat.* § 4885.

It has been held that to antedate a patent is not unlawful, unless special circumstances render it so, as where it might override an intermediate improvement by another person (5 *Op. Att. Gen.* 722); indeed, the Act of 1836 expressly allowed it within limits (*Re* Cushman, 1 *Macarthur Pat. Cas.* 577), and under that Act an infringer might, in a proper case, be held liable for profits realized between the nominal date of the patent and the actual issue, Burdett *v.* Esty, 3 *Fed. Rep'r*, 566; 10 *Blatchf.* 1. But the present rule of the patent-office is that a patent will not be antedated. *Rules of Prac.* No. 161. Were a patent antedated to be issued by mistake, and accepted by the patentee, it might probably be sustained, as towards an infringer, upon the principle that the error operated as a waiver of part of the term (*Re* Cushman, *supra*; also, *Op. Att. Gen.* Gilp. ed. 168); though no similar suggestion can be made in behalf of a patent which should be inadvertently dated *after* the time allowed by law. Compare the copyright cases: Myers *v.* Callaghan, 10 *Biss.* 139; Baker *v.* Taylor, 2 *Blatchf.* 82.

36. *Delivery.*

The patent will be delivered or mailed, on the day of its date, to the patentee, unless there be an attorney of record, in which case it

will be delivered to him or the patentee, as the attorney may request; but it will not, without a special request to that effect, be delivered to an associate or substitute attorney. *Rules of Practice*, No. 163.

37. *Correction of Errors.*

Where a mistake, incurred through the fault of the office, is clearly disclosed by the records or files of the office, a certificate, showing the fact and nature of such mistake, signed by the secretary of the interior, countersigned by the commissioner of patents, and sealed with the seal of the patent-office, will, at the request of the patentee or his assignee, be indorsed without charge upon the letters patent, and recorded in the records of patents, and a printed copy thereof attached to each printed copy of the specification and drawings.

Where a mistake, incurred through the fault of the office, constitutes a sufficient legal ground for a reissue, such reissue will be made, for the correction of such mistake only, without charge of office fees, at the request of the patentee.

Mistakes not incurred through the fault of the office, and not affording legal grounds for reissues, will not be corrected after the delivery of the letters patent to the patentee or his agent.

No changes or corrections will be made in letters patent after the delivery thereof to the patentee or his agent, except as above provided. *Rules of Practice*, No. 164.

38. *Suit by United States to Annul Patent Fraudulently Obtained.*

Where a patent is obtained from the United States by fraud, the proper remedy is a simple bill in equity brought by the United States against the defendant, praying that the patent be annulled and surrendered by a decree in chancery, without any attempt of assimilating the proceeding to an information brought by the attorney-general on behalf of the crown, in England, to repeal a patent. But the court will not dismiss a proceeding in the latter form. United States *v.* Hughes, 11 *How.* 552; Mowry *v.* Whitney, 14 *Wall.* 434; Attorney-General *v.* Rumford Chemical Works, 9 *Pat. Off. Gaz.* 1062.

There is no distinction between letters patent for an invention and for land, as regards the rights and remedies for vacating them when obtained by fraud. The right is the same as that which a

State has, to annul the charter of a corporation created by its legislature, if obtained by fraud. United States *v.* Gunning, 18 *Fed. Rep'r*, 511; 16 *Rep'r*, 741; 21 *Blatchf.* 516; 26 *Pat. Off. Gaz.* 356; United States *v.* Throckmorton, 98 *U. S.* 61.

A suit to set aside, annul or declare void a patent issued by the government, except in cases where two patents have been granted for the same thing, cannot be sustained unless brought in the name of the government, or by the authority or permission of the attorney-general, so as to be under his control. History of the remedies by scire facias and bill in equity, reviewed. Mowry *v.* Whitney, 14 *Wall.* 434.

Proceedings to annul letters patent are wholly within the control of the United States attorneys; there is no absolute duty imposed upon them to commence such proceedings at the request of any party who declares a patent to be invalid. New York, &c. Coffee Polishing Co. *v.* New York Coffee Polishing Co., 9 *Fed. Rep'r*, 578; 20 *Blatchf.* 174; modified, 11 *Fed. Rep'r*, 813.

A bill in equity stated that it was brought by the United States at the relation of certain persons, and did not state that the United States brought it by their district attorney, but was subscribed by other persons as solicitors for the plaintiffs; and the prayer was that certain letters patent of the United States issued to the defendant might be surrendered to be canceled. It was *held*, on demurrer, that the bill was bad, as not stating a case which entitled the United States to the relief sought. United States *v.* Doughty, 7 *Blatchf.* 424.

Upon demurrer to a bill in equity filed in the name of the United States to annul a patent on the ground that the patentee, in his application for the patent, falsely made an affidavit that the device for which the patent was asked had not been previously known and used, the device having in fact been fully described in a previous patent issued to him and long since expired, it appeared that the use of the name of the United States in the suit had been procured by persons specially and directly interested in defeating the patent, but to whom the matters alleged would be a complete defense to any action against them on the patent; and that they had indemnified the United States against all costs of the suit. *Held*, that the bill should be dismissed for want of equity. United States *v.* Frazer, 22 *Fed. Rep'r*, 106.

The United States cannot be heard to ask an injunction restraining the commencement or prosecution of suits for infringement of

a patent for the repeal of which they have begun an action. United States *v.* Colgate, 21 *Fed. Rep'r*, 318; 22 *Blatchf.* 412.

A bill in equity to set aside a patent for the fraud of the alleged inventor in obtaining it, was *held* sustained in the particular case by evidence showing that he was not, and knew that he was not, the original inventor. United States *v.* Gunning, 22 *Fed. Rep'r*, 653; S. C. on rehearing, 23 *Id.* 668; 32 *Pat. Off. Gaz.* 1468.

IV. WHO MAY OBTAIN PATENTS; AND FOR WHAT.

39. *The general Statutory Definition.*

Any person who has invented or discovered any new and useful art, machine, manufacture or composition of matter, or any new and useful improvement thereof, not known or used by others in this country, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof, and not in public use or on sale 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. *Rev. Stat.* § 4886.

40. *What constitutes Inventing.*

The application by a patentee of an old process to a new subject without any exercise of the inventive faculty, and without the development of any idea which can be deemed new or original in the sense of the patent laws, is not the subject of a patent. Brown *v.* Piper, 91 *U. S.* 37.

The design of the patent laws is to reward those who make some substantial discovery or invention which adds to human knowledge, and advances the useful arts; they do not grant a monopoly for every trifling device, every shadow of an idea, such as may naturally and spontaneously occur to any skilled mechanic or operator in the ordinary progress of manufactures, or be gleaned by a speculator from watching the progress of science. Atlantic Works *v.* Brady, 107 *U. S.* 192; 2 *Sup. Ct. Rep'r*, 225.

An imperfect and incomplete invention, resting in mere theory, or in intellectual notion, or in uncertain experiments, and not actually reduced to practice and embodied in some distinct machinery, apparatus, manufacture, or composition of matter, is not patentable; nor do illustrated drawings of conceived ideas constitute an invention. Draper *v.* Potomaska Mills Corp., 13 *Pat. Off. Gaz.* 276; 3 *Bann. & A. Pat. Cas.* 214.

A mere suggestion that a given result can be obtained is not patentable, and does not anticipate a patent by another; but some mechanism or design by which the suggested result is obtained must be described. A patent issued upon a mere suggestion, and without proper description of mechanism or design, does not constitute a good plea for want of novelty in a valid patent. Graham *v.* Gammon, 7 *Biss.* 490.

The accidental making of an improved article, in a single instance, without knowledge on the part of the producer of how to accomplish it, or to produce another like it, is not invention. Pelton *v.* Waters, 7 *Pat. Off. Gaz.* 425.

As to what constitutes inventing, considered as a mental process within the protection of the patent laws, see McCormick *v.* Seymour, 2 *Blatchf.* 240; and 3 *Blatchf.* 209; Teese *v.* Phelps, *McAll.* 48; Devoll *v.* Brown, 3 *West. L. J.* 151; Forbush *v.* Cook, 10 *L. Rep'r, N. S.* 664; Detmold *v.* Reeves, 1 *Fish. Pat. Cas.* 127; Howe *v.* Underwood, *Id.* 160; Matthews *v.* Skates, *Id.* 602; Rich *v.* Lippincott, 2 *Fish. Pat. Cas.* 1; Ellithorpe *v.* Robertson, *Id.* 83; Magic Ruffle Co. *v.* Douglas, *Id.* 330; Union Manuf. Co. *v.* Lounsbury, *Id.* 389; White *v.* Allen, *Id.* 440; Waterman *v.* Thompson, *Id.* 461; Hotchkiss *v.* Greenwood, 4 *McLean*, 456.

41. *Who is a "Person who has Invented," &c.*

Whoever first brings a machine to perfection and makes it capable of useful operation is the real inventor and entitled to the patent; although others may previously have had the idea, and made some experiments toward putting it in practice. Agawam Co. *v.* Jordan, 7 *Wall.* 583.

Inquiries made, or information or advice received from men of science, in the course of an inventor's researches, will not impair his right to the character of an inventor. It makes no difference whether an inventor derives his information from books, or from conversation with men skilled in science. O'Reilly *v.* Morse, 15 *How.* 62, 111.

If one suggests an idea as to an invention, which is indispensable to its operation, and which in reality constitutes its whole value, and another adopts such suggestion and takes out a patent therefor, the patent is void; the invention not being his. Thomas *v.* Weeks, 2 *Paine*, 92.

A person, to be entitled to the character of an inventor, must himself have conceived the idea embodied in his improvement. If, however, he is aided by the suggestion of others in arriving at the useful result, and if, after all the suggestions, there was something left for him to devise and work out by his own skill and ingenuity, he is still to be regarded as the first and original discoverer. But if the suggestions and communications of others go to make up a complete and perfect machine, embodying all that is embraced in the patent subsequently issued to the party to whom the suggestions were made, the patent is invalid. Pitts *v.* Hall, 2 *Blatchf.* 229.

Merely improving the conceptions of another by change in form, proportion or degree, is not such an invention as will sustain a patent. Theberath *v.* Rubber, &c. Harness Trimming Co., 15 *Fed. Rep'r*, 246; 23 *Pat. Off. Gaz.* 1121.

42. *This Question, between Employer and Workman.*

If a person employed in the manufactory of another, while receiving wages, makes experiments at the expense and in the manufactory of the employer, has his wages increased in consequence of the useful result of the experiments, makes the article invented, and permits his employer to use it, no compensation for its use being paid or demanded, and then obtains a patent for it, the patent is invalid and void. McClurg *v.* Kingsland, 1 *How.* 202; Worley *v.* Tobacco Co., 104 *U. S.* 340.

Persons employed, as well as employers, are entitled to their own independent inventions; but where the employer has conceived the plan of an invention, and is engaged in experiments to perfect it, no suggestions of an employe, not amounting to a new method or arrangement which in itself is a complete invention, are sufficient to deprive the employer of the exclusive property in the perfected improvement. Agawam Co. *v.* Jordan, 7 *Wall.* 583.

An improvement which becomes necessary in the manufacture of a patented improvement, in order to overcome a difficulty growing out of a departure from the model, and which is introduced into it by the workmen, without the knowledge of the patentee, cannot be appropriated by him as his invention. If such an improve-

ment is embodied by the assignees of the patentee in a reissue, they cannot recover upon it, against others who use it. Berdan Fire Arms Manuf. Co. *v.* Remington, 3 *Pat. Off. Gaz.* 688.

The fact that a mechanic or workman employed by one who has devised the idea of a new invention, to make experiments, construct machinery or models, or otherwise to aid in reducing the idea to practice, has suggested improvements in the plan, will not deprive the inventor of the merit of the invention, nor affect the validity of the patent if they are embraced within it. Pennock *v.* Dialogue, 4 *Wash.* 538; aff'd, 2 *Pet.* 1; Watson *v.* Bladen, 4 *Wash.* 580.

One who is the first discoverer of a process is entitled to a patent therefor, even against one in whose employ he was at the time of the discovery, and at whose request and expense he was making experiments which led to the discovery. Damon *v.* Eastwick, 14 *Fed. Rep'r*, 40; 14 *Rep'r*, 644; 22 *Pat. Off. Gaz.* 1709.

If an inventor furnishes the idea to produce the result, he is entitled to avail himself of the mechanical skill of others to carry out his contrivance in practice. Thus where the plaintiffs devised designs for oilcloths, which were carried out by another person,—*Held*, that the plaintiffs, and not the pattern-maker, were the inventors. Sparkman *v.* Higgins, 1 *Blatchf.* 205; 5 *N. Y. Leg. Obs.* 122; 6 *Pa. L. J.* 344.

An employe who, before obtaining a patent for a device, introduces the device into his employers' business without their consent, and without a special agreement to pay him, and who develops his invention and brings it to a practical condition at the employers' expense, is not entitled, after obtaining a patent therefor, to royalties or profits, and damages from the employers for the use by them of the tools so introduced into their business. Barry *v.* Crane Bros. Manuf. Co., 22 *Fed. Rep'r*, 396.

One to whom the conception of an invention belongs has the right to the invention, although others contribute, at his request, the necessary mechanical skill to embody it in an operative form. He does not thereby lose the merit due to inventive suggestiveness. Yoder *v.* Mills, 25 *Fed. Rep'r*, 821.

43. *Mere change in Materials, Form, &c. not enough.*

A mere change in the form of a machine, or in the proportions of its parts; or the mere substitution of one mechanical equivalent

for another; or an alteration in unimportant parts, causing no substantial change in the principle of operation, does not constitute an invention such as can be the subject of a patent. O'Reilly *v.* Morse, 15 *How.* 62; Winans *v.* Denmead, *Id.* 330; Woodcock *v.* Parker, 1 *Gall.* 438; Lowell *v.* Lewis, 1 *Mas.* 182; Carver *v.* Braintree Manuf. Co., 2 *Story*, 432; Bean *v.* Smallwood, *Id.* 408; Devoll *v.* Brown, 3 *West. L. J.* 151; Forbush *v.* Cook, 10 *L. Rep'r, N. S.* 664; Blanchard's Gun-stock Turning Factory *v.* Warner, 1 *Blatchf.* 258; Buck *v.* Hermance, *Id.* 398; Hall *v.* Wiles, 2 *Blatchf.* 194; McCormick *v.* Seymour, *Id.* 240; rev'd on other points, 16 *How.* 480; Tracy *v.* Torrey, 2 *Blatchf.* 275; American Pin Co. *v.* Oakville Co., 3 *Blatchf.* 190; 3 *Am. L. Reg.* 136; McCormick *v.* Seymour, 3 *Blatchf.* 209; aff'd, 19 *How.* 96; Whitney v. Emmett, *Baldw.* 303; Davis *v.* Palmer, 2 *Brock. Marsh.* 298; Stanley *v.* Whipple, 2 *McLean*, 35; Smith *v.* Pearce, *Id.* 176; McCormick *v.* Manny, 6 *McLean*, 539; 4 *Am. L. Reg.* 277.

A mere carrying forward a new or more extended application of the original thought, a change only in form, proportions, or degree, doing substantially the same thing in the same way, by substantially the same means, with better results, is not such an invention as will sustain a patent. Smith *v.* Nichols, 21 *Wall.* 112; aff'g 1 *Holmes*, 172; 6 *Fish. Pat. Cas.* 61; 2 *Pat. Off. Gaz.* 649; Roberts *v.* Ryer, 91 *U. S.* 150. S. P., Putnam *v.* Yerrington, 9 *Pat. Off. Gaz.* 689.

The mere change in an instrument or machine of one material into another,—as substituting iron for wood, or wood strengthened with iron,—is not "invention" in the sense of the patent laws, and not the subject of a patent; the purpose and means of accomplishment, and form and mode of operation of each instrument—the new as of the old—being each and all the same. The new instrument being better than the old one does not alter the case; it does not bring the case out of the category of more or less excellence of construction. Hicks *v.* Kelsey, 18 *Wall.* 670. S. P., Crouch v. Roemer, 103 *U. S.* 797; Stow *v.* Chicago, 8 *Biss.* 47: 3 *Ban. & A. Pat. Cas.* 83; aff'd, 104 *U. S.* 547.

There must be difference in principle to constitute a patentable difference. A mere change of form will not do, unless form is a part of the thing invented, and is essential to its value. Where, however, the form is a material part of the discovery and is essential to its value, then a departure from the form would be a substantial

departure. Many *v.* Jagger, 1 *Blatchf.* 372. S. P., 1st *Circ.* (*Mass.*), 1814, Odiorne *v.* Winckley, 2 *Gall.* 51.

A new mode or method of doing a thing, or producing an old result, may be protected by a patent. Whitney *v.* Emmett, *Baldw.* 303; 7*th Circ.* (*Ohio*), 1835, Heinrich *v.* Luther, 6 *McLean*, 345.

It is no new invention to use an old machine or process for a new purpose. The inventor of a machine is entitled to the benefit of all the uses to which it can be put, no matter whether he had conceived the idea of the use or not. Evans *v.* Eaton, 7 *Wheat.* 356; aff'g 3 *Wash.* 443; 1875, Roberts *v.* Ryer, 91 *U. S.* 150. See also, Ames *v.* Howard, 1 *Sumn.* 482; Howe *v.* Abbott, 2 *Story*, 190; Winans *v.* Boston & Providence R. R. Co., *Id.* 412; Matter of Arkell, 15 *Blatchf.* 437; Crandall *v.* Watters, 9 *Fed. Rep'r*, 659; 20 *Blatchf.* 97; 21 *Pat. Off. Gaz.* 945; Western Electric Manuf. Co. *v.* Ansonia Brass, &c. Co., 9 *Fed. Rep'r.* 706; 20 *Blatchf.* 170; Couse *v.* Johnson, 16 *Pat. Off. Gaz.* 719; 4 *Bann. & A. Pat. Cas.* 501; Rowell *v.* Lindsay, 6 *Fed. Rep'r*, 290; 10 *Biss.* 217; 19 *Pat. Off. Gaz.* 1565.

A novelty in principle may consist in a new and valuable mode of applying an old power; effecting it not merely by a new instrument or form of the machine, or any mere equivalent, but by something giving it a new or greater advantage. Hovey *v.* Stevens, 1 *Woodb. & M.* 290.

Where an invention involves a new result first thought of by the patentee, the fact that the mechanical changes by which the result is produced are not difficult, is not necessarily important. Stewart *v.* Mahoney, 5 *Fed. Rep'r*, 302; 4 *Bann. & A. Pat. Cas.* 84.

While a patent may hardly be sustained for a process or method which consists only in applying an old machine to a new use, it will only be supported when the new use is so remote from the old use that it is evident that a new idea has been discovered. Moffitt *v.* Rogers, 8 *Fed. Rep'r*, 147.

A new adaptation and arrangement of applying and using old articles for a certain purpose may be the subject of letters-patent. Blake *v.* Sperry, 2 *N. Y. Leg. Obs.* 251.

The application of a thing already known to a new and useful purpose may be the subject of a patent, provided the new use is not analogous to the old, and requires the exercise of the inventive faculties. Winans *v.* Schenectady & Troy R. R. Co., 2 *Blatchf.* 279.

It is the development of something new, and not the arrival at comparative superiority or greater excellence in that which was always known, which the law protects as exclusive property, and which it secures by patent. Putnam *v.* Yerrington, 9 *Pat. Off. Gaz.* 680. But a result which required calculation and experiment beyond mechanical skill and good workmanship is entitled to be classed as inventive. Davis *v.* Fredericks, 19 *Fed. Rep'r*, 99. There cannot, however, be a patent for a mere form, unless the form is of the essence of the invention. Wilson Packing Co. *v.* Clapp, 8 *Rep'r*, 262. Thus, merely reducing the size of a thing in common use, though with effect to render it available for a new use, cannot support a claim to a patent. Double Pointed Tack Co. *v.* Mann, 5 *Bann. & A. Pat. Cas.* 465.

44. *Discovery of a Principle, Law, or Fact.*

The discovery of an abstract principle, of a theory or fact, of a new property of matter, such as the anæsthetic effect of ether, or of a new power in nature, such as steam or electricity, unless carried on to the contriving and development of a practical machine, method or process for rendering such discovery available and useful in affairs is not patentable; the law does not enable a person to acquire an exclusive right in a natural principle, power or fact merely because he has been the first to observe it. Leroy *v.* Tatham, 14 *How.* 156, 175; Burr *v.* Duryea, 1 *Wall.* 531; Lowell *v.* Lewis, 1 *Mas.* 182; Barrett *v.* Hall, *Id.* 447; Blanchard *v.* Sprague, 3 *Sumn.* 535; Stone *v.* Sprague, 1 *Story*, 270; Wyeth *v.* Stone, *Id.* 273; 4 *L. Rep'r*, 54; American Bell Telephone Co. *v.* Dolbear, 15 *Fed. Rep'r*, 448; 23 *Pat. Off. Gaz.* 535; 28 *Alb. L. J.* 69; Morton *v.* New York Eye Infirmary, 5 *Blatchf.* 116; 2 *Am. L. Reg.* 672; 2 *Fish. Pat. Cas.* 320; 8 *Op. Att. Gen.* 269; Piper *v.* Brown, 4 *Fish. Pat. Cas.* 175; 3 *Pat. Off. Gaz.* 97; New Process Fermentation Co. *v.* Maus, 20 *Fed. Rep'r*, 725; Bain *v.* Morse, 6 *West. L. J.* 372; Grant *v.* Mason, 1 *L. Inst. & Rev.* 22; Sickles *v.* Borden, 3 *Blatchf.* 535; Evans *v.* Eaton, *Pet. C. Ct.* 322, 341; Whitney *v.* Emmett, *Baldw.* 303.

When the discovery of a principle, law or fact is coupled with the devising of an apparatus, process or method by which the new property of nature is made useful to man in the production of things or effects not known before, there is a patentable invention. In all such cases, the processes used to extract, modify, and concentrate natural agencies, constitute the invention. The elements of

the power exist; the invention is not in discovering them, but in applying them to useful objects. The principle may be the new and valuable discovery, but the practical application of it to some useful purpose is the test of its value. Leroy *v.* Tatham, 14 *How.* 156, 175; American Bell Telephone Co. *v.* Dolbear, 15 *Fed. Rep'r*, 448; 23 *Pat. Off. Gaz.*,535; 28 *Alb. L. J.* 69. In other words, where the discoverer of a new principle or force has gone beyond the mere domain of discovery, and has laid hold of the new principle, force, or law, and connected it with some particular medium or mechanical contrivance by which or through which it acts on the material world, then he can secure the exclusive control of it under the patent law, through the means by which he has brought it into practical action; for it is then an invention, although it embraces a discovery. Every invention may, in a certain sense, embrace more or less of discovery, for it must always include something that is new; but it by no means follows that every discovery is an invention. Morton *v.* New York Eye Infirmary, 5 *Blatchf.* 116; 2 *Am. L. Reg.* 672; 2 *Fish. Pat. Cas.* 320. He who has discovered some new element or property of matter may secure to himself the ownership of his discovery so soon as he has been able to illustrate it practically and to demonstrate its value. His patent in such case will be commensurate with the principle which it announces to the world, and may be as broad as the mental conception itself. But the mental conception must have been embodied in some mechanical device or some process of art. The patent must be for a thing, not for an idea merely. Detmold *v.* Reeves, 4 *Am L. J. N. S.* 186. Thus, where a patentee claimed the application of the expansive and contractive power of a metal rod, by various degrees of heat, to open and close a damper governing the admission of air into a stove, it was *held*, that this claim was not one for a mere principle, and that the patent was good. Silsby *v.* Foote, 20 *How.* 378; aff'g 2 *Blatchf.* 260. Likewise, where a person discovered that articulate sounds could be transmitted by undulatory vibrations of electricity, and invented the art or process of transmitting such sounds by means of such vibration, it was *held* that the mere fact that such art or process is the only way by which speech can be transmitted by electricity, did not lessen the merit of the invention, or the protection which the patent law would give to it. American Bell Telephone Co. *v.* Dolbear, 15 *Fed. Rep'r*, 448; 23 *Pat. Off. Gaz.* 535; 28 *Alb. L. J.* 69.

But, generally, in these cases, to entitle the discoverer of a prin-

ciple, force or fact to a patent he must give such a description of a method or apparatus or process for making his discovery practically available in producing results new and useful to man as will enable skillful persons to produce them.

45. *Discoveries of "Processes."*

Although "processes" are not by that name declared patentable, yet the law embraces them; and its application to them has been explained in leading cases in the Supreme Court. Processes are included under the general term "useful arts." And an art may require one or more processes or machines in order to produce a certain result or manner. The term "machine" includes every mechanical device or combination of mechanical powers and devices to perform some function and produce a certain effect or result. But where the result or effect is produced by chemical action, by the operation or application of some element or power of nature, or of one substance to another, such modes, methods or operations are called "processes." A new *process* is usually the result of discovery; a *machine*, of invention. The arts of tanning, dyeing, making water-proof cloth, vulcanizing India-rubber, smelting ores, &c., are usually carried on by processes, as distinguished from machines. One person may discover an improvement in a process, irrespective of any particular form of machinery; and another may invent a labor-saving machine, by which the operation or process may be performed, and each may be entitled to a patent—the first for the process, but not for a machine; the second for a machine, but not for a process. It is when the term "process" is used to represent some means or method of producing a result that a process is patentable, and the term thus used includes all means or methods which are not effected by mechanism or mechanical combination. Corning *v.* Burden, 15 *How.* 252, 263. Again, it is said that the term "process" is often used in a more vague sense; as when one says that a board is undergoing the process of being planed, grain is under the process of being ground, iron under that of being hammered, or cooled. In this use of the term it represents the function of a machine, or the effect produced by it on the material subjected to its action. A "process," using the term in this sense, cannot be the subject of a patent. *Ib.* But in the more technical sense of a mode of treatment of certain materials to produce a given result, or an act or a series of acts, performed upon the subject-matter, to transform and reduce it to a different state or thing, a process, if

new and useful, is just as patentable as is a machine. In the language of the patent law, it is an "art."

And a process may be patentable, irrespective of the particular form of the instrumentalities used. If one of the steps of a process be that a certain substance is to be reduced to a powder, it may not be at all material what instrument or machinery is used to effect that object, whether a hammer, a pestle and mortar, or a mill. Either may be pointed out; but (if the patent is not confined to that particular tool or machine), the use of the other would be an infringement, the general process being the same. So the machinery pointed out as suitable to perform the process may or may not be new or patentable, whilst 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 *v.* Deener, 94 *U. S.* 780.

A patent may be granted for a process, irrespective of the particular mode or form of apparatus for carrying it into effect; but in order that such patent be valid, the patentee should be the first and original inventor of the process, and claim it in his application as granted. If the means of carrying it out are not obvious to ordinary mechanics skilled in the art, the specification should describe some mode of carrying it out which will produce a useful result. Tighlman *v.* Proctor, 102 *U. S.* 707.

Where a result or effect is produced by mechanical action, a patent can ordinarily only be for the mechanical appliances or means employed; where the result is attained or effect produced by chemical action, by the operation or application of some element or power of nature, or of some property in matter, or of one substance to another, then the patent may be for the art, process, or method. Piper *v.* Brown, 4 *Fish. Pat. Cas.* 175; 3 *Pat. Off. Gaz.* 97. The discoverer of a new art is entitled not to the abstract right to the art without regard to the means, but to all means and processes which he has both invented and claimed (American Bell Telephone Co. *v.* Spencer, 8 *Fed. Rep'r*, 509; 20 *Pat. Off. Gaz.* 299); for although a mere principle is not patentable, and a patent will not be issued to the discoverer of a natural force or scientific fact, yet the inventor of a process by which a certain effect of one of the forces of nature is made useful to mankind is entitled to a patent, and he is not restricted to any particular form of mechanism or apparatus by which the process is carried out. A subsequent

inventor of an improved form or apparatus embodying the same process is entitled to a patent for the apparatus, but he must obtain the consent of the inventor of the process before using that process in his apparatus. American Bell Telephone Co. *v.* Dolbear, 15 *Fed. Rep'r*, 448; 23 *Pat. Off. Gaz.* 535; 28 *Alb. L. J.* 69. A new process or method of operation is patentable, when it amounts to a successful application of known things; and the patent is *prima facie* evidence of novelty of the invention. Roberts *v.* Dickey, 4 *Brewst.* 260; 3 *Pittsb.* 352; 1 *Pat. Off. Gaz.* 4; 4 *Fish. Pat. Cas.* 532.

What is such a process as may be the subject of a patent, see New Process Fermentation Co. *v.* Maus, 20 *Fed. Rep'r*, 725; MacKay *v.* Jackman, 12 *Fed. Rep'r*, 615; 20 *Blatchf.* 466; 22 *Pat. Off. Gaz.* 85.

46. *Patentability of Effects and Products.*

An end to be accomplished or a result to be produced, is not patentable independently of some new and useful means, process, machinery, &c., devised for accomplishing it. To allow a mere effect or result to be patented, would enable persons to engross results and prohibit all other persons from producing them by any means whatever; which would discourage rather than promote the progress of useful arts. Carver *v.* Hyde, 16 *Pet.* 513; Leroy *v.* Tatham, 14 *How.* 156, 175; O'Reilly *v.* Morse, 15 *How.* 62, 112; Whittemore *v.* Cutter, 1 *Gall.* 478; Howe *v.* Abbott, 2 *Story*, 190; New Process Fermentation Co. *v.* Maus, 20 *Fed. Rep'r*, 725; Bain *v.* Morse, 6 *West. L. J.* 372; *Re* Merrill, 1 *McArth'r*, 301.

Thus, a patentee cannot have a patent to protect "the motive power of electro-magnetism, *however developed*, for marking characters at a distance;" his patent must be confined to the manner and process described and invented by him. O'Reilly *v.* Morse, 15 *How.* 62, 112. So no patent can be obtained for the admeasurement of time, or the expansive operations of steam; but only for a new mode of new application of machinery to produce these effects; and, therefore, if new effects are produced by an old machine in its unaltered state, no patent can be legally supported, for such patent is for an effect only. Whittemore *v.* Cutter, 1 *Gall.* 478. A patent for a ruffle to be made by machinery cannot be sustained where the ruffle is identical, in mechanical construction, with a ruffle before made, although the machinery, or the process it works, performs at one operation what before required more than one; for the product

of a machine is not patentable merely because the machine makes an already known article more perfectly than it has been, or can be made without a machine. Wooster *v.* Calhoun, 11 *Blatchf.* 215; 6 *Fish. Pat. Cas.* 514. But printing, by copper-plate or letter-press, on both sides of bank-notes, to prevent their counterfeiting, is an art for which a patent will be granted; such a patent is not a patent for an *effect*, but for the method of printing by which the effect is produced. Kneass *v.* Schuylkill Bank, 4 *Wash.* 9. The proper mode of enameling the proper quality of paper to enable a turned-down or folded collar to be made wholly of paper, without any danger of crumbling or breaking the enamel by the operation of folding, is a patentable invention; the collar made from such enameled paper being a new article of manufacture. Hoffman *v.* Stiefel, 7 *Blatchf.* 58; 3 *Fish. Pat. Cas.* 638.

He who produces an old result by a new mode or process is entitled to a patent for the mode or process (Howe *v.* Abbott, 2 *Story*, 190); and although an inventor has obtained a patent for a process, he may have another for the product, if new. Jones *v.* Sewall, 3 *Cliff.* 563; 6 *Fish. Pat. Cas.* 343; 3 *Pat. Off. Gaz.* 630. A patentee who has invented a new process in the arts, whereby an article of manufacture is produced, new in kind and not before known, may separately claim and patent both the art and the manufacture; he cannot indeed properly combine them in one claim; but he may claim broadly the new product, however made, or may claim the new product when made by his described process. Merrill *v.* Yeomans, 1 *Holmes*, 331. But the fact that the product is new as an article of commerce, is not enough to warrant granting a patent; there must have been an exercise of invention in devising the means of producing it. There is no inventing in reducing an article formerly sold in chunks to a powder—comminuting glue—when it is not improved by adding some new ingredient, or by subtracting one or more. Milligan, &c. Glue Co. *v.* Upton, 6 *Pat. Off. Gaz.* 837. The process of making and the article made are, in legal contemplation, distinct inventions, which may both be included in a single patent, though a full, clear and exact description, according to the statute, is indispensable in each case. Kelleher *v.* Darling, 14 *Pat. Off. Gaz.* 673.

47. *Machines.*

If the principles of a machine are new, to produce either a new or an old effect, the inventor is entitled to the exclusive right of the

whole machine. And by "the principles of a machine," as here used, is meant not the original, elementary principles of motion, which philosophy and science have discovered, but the *modus operandi*, the peculiar manner or device of producing any given effect. If two machines produce the same effects by the same mode of operation, the principles of the two are the same; if the same effects are produced by combinations of machinery operating substantially in a different manner, the principles are different. Where a specific machine already exists, producing certain effects, if a mere addition is made to such machine to produce the same effects in a better manner, a patent cannot be taken out for the whole machine, but for the improvement only; on the other hand, if well-known *effects* are produced by machinery, in all its combinations *entirely new*, a patent may be claimed for the whole machine. Whittemore *v.* Cutter, 1 *Gall.* 478.

Inventions pertaining to machines may be divided into four classes. 1. Where the invention embraces the entire machine, as a car for a railway, or sewing-machine. Such inventions are seldom made; but when made and duly patented, any person is an infringer who, without license, makes or uses any portion of the machine. Under such a patent the patentee holds the exclusive right to make and use, and vend to others to be used, the entire machine; and if another, without license, makes, uses, or vends any portion of it, he invades the right of the patentee. 2. Those which embrace one or more elements of a machine, but not the entire machine, as the coulter of a plow, or the divider of the reaping-machine. In patents of that class, any person may make, use, or vend all other parts of the machine, and he may employ a coulter or divider in the machines mentioned, provided it be substantially different from that embraced in the patent. 3. Those which embrace both a new element and a new combination of elements previously used and well known. The property of the patentee in such a case consists in the new element and in the new combination. No one can lawfully make, use, or vend a machine containing such new element or such new combination. They may make, use or vend the machine without the patented improvements, if it is capable of such use, but they cannot use either of those improvements without making themselves liable as infringers. 4. Those where all the elements of the machine are old, and where the invention consists in a new combination of those elements, whereby a new and useful result is obtained. Most of the modern inventions are of this latter class, and many of them are of

great utility and value. The rule is, that the property of an inventor, if duly secured by letters patent, is in all cases exactly commensurate with his invention. Such an invention, however, is but an improvement on an old machine, and consequently the patentee cannot treat another as an infringer who has also improved the original machine by the use of a substantially different combination, although the machine may produce the same result. But every inventor is entitled to the full benefit of his invention as described and secured in his patent, and no one charged with infringing the same can successfully defend himself against the charge, merely because the machine he makes, uses, or vends, differs from that of the plaintiff in form or in any respect which does not render the machine so made, used, or vended, substantially different from the patented machine. Inventions of the fourth class are just as meritorious as those of any other class, and the property of the inventors is entitled to the same protection. Union Sugar Refinery Co. *v.* Matthiessen, 2 *Fish. Pat. Cas.* 600.

The mere function of a machine is not a patentable subject; but a mechanical device, adapted to perform specific functions, is patentable, whether its operative efficiency depends upon its combination with other mechanism or not. Parham *v.* American Buttonhole, &c. Machine Co., 4 *Fish. Pat. Cas.* 468.

A machine need not be automatic to be patentable. Improvements in any tool or implement used by hand in an art or industry are patentable. Coupe *v.* Weatherhead, 16 *Fed. Rep'r*, 673; 23 *Pat. Off. Gaz.* 1927.

48. *Compositions.*

The invention of a new composition for making a familiar article may be patentable; and this even though both the article and the means employed to adapt the new composition to its manufacture are old or well known; but the mere idea of employing a well-known composition as a material for making a familiar article, the only novelty being that the composition has not been used for making that article, does not involve invention, and is not patentable. Hotchkiss *v.* Greenwood, 11 *How.* 248, 265; aff'g 4 *McLean*, 456. It is not necessary, in order to render a composition patentable, that every ingredient, or that any one ingredient used by the patentee in his invention, should not have been used before for that purpose. The right to a patent depends upon the question whether the combination of materials used by the patentee is substantially new as a

combination. If the ingredients have never been combined together in the manner stated in the patent, but the combination is new, the invention of the combination is patentable. Ryan *v.* Goodwin, 3 *Sumn.* 514; 3 *L. Rep'r*, 220.

There is a wide difference between the invention of a new method or process by which a known fabric, product or manufacture is produced in a better and cheaper way, and the discovery of a new compound, substance or manufacture having qualities never found to exist together in any other material. In the first case, the inventor can patent nothing but his process—not his composition of matter; in the latter, both are new and original, and both patentable, not severally, indeed, but as one discovery or invention. Goodyear *v.* Railroad, 2 *Wall. Jr.* 356; 1 *Fish. Pat. Cas.* 626.

The introduction of a flavoring extract, whether in substitution for another or as an additional ingredient of a beverage composition otherwise well known, may be a patentable improvement, if new and advantageous results follow; for in such case there is a new composition. Rogers *v.* Ennis, 14 *Pat. Off. Gaz.* 601.

Patentability of medicines is discussed in Coffeen *v.* Brunton, 4 *McLean*, 516; 7 *West. L. J.* 59; Scoville *v.* Toland, 6 *West. L. J.* 84.

49. *Improvements.*

For discussions of the patentability of improvements considered from various points of view, see Whittemore *v.* Cutter, 1 *Gall.* 478; Barrett *v.* Hall, 1 *Mas.* 447, 476; Hall *v.* Wiles, 2 *Blatchf.* 194; Evans *v.* Eaton, 3 *Wheat.* 454, 516; rev'g *Pet. C. Ct.* 322; Gray *v.* James, *Pet. C. Ct.* 394; Huggins *v.* Hubby, 3 *West. L. Month.* 347. In general, one who devises a substantial change in the structure or mode of operation of a machine,—such as omission of certain parts and replacing them by others really new and different, thereby producing a machine better adapted to the purpose,—is entitled to a patent for the change, as an "improvement." Miller's Falls Co. *v.* Backus, 17 *Pat. Off. Gaz.* 852; 5 *Bann. & A. Pat. Cas.* 53; Coupe *v.* Weatherhead, 23 *Pat. Off. Gaz.* 1927. This is so, notwithstanding the change made in the machine is slight and simple, if a valuable result, not before attained in a similar way, is produced (Isaacs *v.* Abrams, 3 *Bann. & A. Pat. Cas.* 616; Eppinger *v.* Richey, 23 *Int. Rev. Rec.* 319; Strobridge *v.* Lindsay, 5 *Bann. & A. Pat. Cas.* 411); and even though the change consists only in introducing old elements, if they, when introduced into an organi-

zation in which they have not before been tried, produce new and improved results, or produce the former result by a new and improved mode. Child *v.* Boston, &c. Iron Works, 6 *Fish. Pat. Cas.* 606; Gottfried *v.* Phillip Best Brewing Co., 17 *Pat. Off. Gaz.* 675; 5 *Bann. & A. Pat. Cas.* 4.

But to warrant a patent for an improvement, the change made must be one involving invention, and the result must be new and useful. There must be something accomplished beyond what is obvious in the thing itself, to persons skilled in the art to which it relates. Mulford *v.* Pearce, 102 *U. S.* 112; 18 *Pat. Off. Gaz.* 1223; rev'g 14 *Blatchf.* 141; 2 *Bann. & A. Pat. Cas.* 542; also, 13 *Blatchf.* 173; 9 *Pat. Off. Gaz.* 204; 2 *Bann. & A. Pat. Cas.* 193; Hall *v.* Wiles, 2 *Blatchf.* 194; McCormick *v.* Seymour, 3 *Id.* 209; aff'd 19 *How.* 96. A mere enlargement of the parts of a machine, a merely colorable change or re-arrangement of relative location of parts, is not a patentable improvement. Phillips *v.* Page, 24 *How.* 164; *Re* Greeley, 4 *Pat. Off. Gaz.* 612; Pearl *v.* Ocean Mills, 11 *Pat. Off. Gaz.* 2; Miller's Falls Co. *v.* Backus, 17 *Pat. Off. Gaz.* 852; 5 *Bann. & A. Pat. Cas.* 53. There are many changes which may be suggested by the manufacturer, or by the particular uses to which the article produced is to be applied, as well as many exhibitions of superior skill in producing an article of greater excellence, which are not invention. The law gives no monopoly to industry, to wise judgment, or to mere mechanical skill in the use of known means, nor to the product of either, if it be not new. It is invention of what is new, and not comparative superiority or greater excellence in what was before known, which the law protects as exclusive property, and it is that alone which is secured by patent. Thus if a fabric be already known and in use, change of color, change of mere material, or change in its degree of fineness—if these changes involve nothing new in construction, nor in the relations of its parts, nor in the office or function of either part—does not constitute invention. Smith *v.* Elliott, 5 *Fish. Pat. Cas.* 315; 1 *Pat. Off. Gaz.* 331.

In general, the fact that the result produced by a change is greatly superior to that attained by the former machine or method is regarded as having a tendency to satisfy the courts, in a doubtful case, that the change is real and substantial, and so patentable as an improvement. Pearl *v.* Ocean Mills, 11 *Pat. Off. Gaz.* 2; Hall *v.* Wiles, 2 *Blatchf.* 194.

50. *Combinations.*

A new and useful combination,—that is an arrangement of devices so that they shall co-operate in a manner not previously known and produce a valuable result,—is patentable, independent of either of the separate devices being new; the contriving how the several parts shall work together is of itself invention, and may warrant a patent although the contriver is not inventor of either of the parts considered alone. Loom Co. *v.* Higgins, 105 *U. S.* 580; rev'g 15 *Blatchf.* 446; 16 *Pat. Off. Gaz.* 675; 4 *Bann. & A. Pat. Cas.* 88; Gray *v.* James, *Pet. C. Ct.* 394; Bussey *v.* Wager, 9 *Pat. Off. Gaz.* 300; Wood *v.* Packer, 17 *Fed. Rep'r,* 650; Hoffman *v.* Young, 2 *Fed. Rep'r,* 74; 26 *Int. Rev. Rec.* 155; 10 *Rep'r,* 259; 18 *Pat. Off. Gaz.* 794; 5 *Bann. & A. Pat. Cas.* 316; Double Pointed Tack Co. *v.* Two Rivers Manuf. Co., 3 *Fed. Rep'r,* 26; 9 *Biss.* 258; 18 *Pat. Off. Gaz.* 683; S. C., *sub nom.* Double Pointed Tack Co. *v.* Mann, 5 *Bann. & A. Pat. Cas.* 465. Thus, although a mere change of relative location of the parts of a machine is not patentable, yet, where change of location brings the devices constituting the machine into a new combination, and they operate, by reason of such new combination, to produce a new and useful result, such new combination is patentable. Gilbert, &c. Manuf. Co. *v.* Walworth Manuf. Co., 9 *Pat. Off. Gaz.* 746; Marsh *v.* Dodge, &c. Manuf. Co., 6 *Fish. Pat. Cas.* 562; 5 *Pat. Off. Gaz.* 398. The devising a way in which a device already patented may be used in combination with other known devices, is the proper subject of a patent; and so is a new and useful improvement upon a combination already patent; though in cases of this kind the new patentee only acquires what he himself has invented; he cannot, without a license, use the former's patented device or combination, nor can the patentees of these use his combination or improvement without his license. McMillan *v.* Rees, 1 *Fed. Rep'r,* 722; 17 *Pat. Off. Gaz.* 1222; 9 *Rep'r,* 544; 5 *Bann. & A. Pat. Cas.* 269; Pitts *v.* Wemple, 6 *McLean,* 558.

51. *Various Specific Objections to Patenting Them.*

Combinations, to be patentable, must produce a different force or effect, or result, in the combined forces or processes, from that given by their separate parts; there must be a new result produced by their union. Reckendorfer *v.* Faber, 92 *U. S.* 347, 357; aff'g 12 *Blatchf.* 68; 1 *Bann. & A. Pat. Cas.* 229; Pickering *v.* McCul-

lough, 104 *U. S.* 310; aff'g 6 *Rep'r*, 101; 13 *Pat. Off. Gaz.* 818; 3 *Bann. & A. Pat. Cas.* 279. Also, a combination must differ materially and substantially from former combinations; there is no new invention if all the parts of a combination have been applied to a different object before, and they are now only applied to a new object. Hovey *v.* Henry, 3 *West. L. J.* 153. Moreover a combination of old elements is not patentable unless they all so enter into it as that each qualifies every other, and so that the new arrangement either forms a new machine of distinct character and function, or produces a result which is not the mere aggregate of separate contribution, but is due to the joint and co-operating action of all the elements. Pickering *v.* McCullough, 104 *U. S.* 310; aff'g 6 *Rep'r*, 101; 13 *Pat. Off. Gaz.* 818; 3 *Bann. & A. Pat. Cas.* 279. Followed, and the rules there stated applied to a patent for an improved school desk. Peard *v.* Johnson, 23 *Fed. Rep'r*, 507; 32 *Pat. Off. Gaz.* 895. It has been said that the results produced are a better test of whether the operation of a combination is substantially new, than the opinions of experts; or at least are good evidence of novelty; if the results are different from those produced by any previous combination, there must be a substantial change in the mode of operation; results cannot well differ when the means are the same. Devoll *v.* Brown, 3 *West. L. J.* 151; Forbush *v.* Cook, 2 *Fish. Pat. Cas.* 668; 20 *L. Rep'r*, 664.

A patent may be obtained for a combination notwithstanding some of its parts or (as several of the cases hold), all its parts separately considered, have been known and used before, provided the arrangement, union or co-operation of them is new, and produces an effect which is new and either better or more economically produced than the old. Le Roy *v.* Tatham, 22 *How.* 132; Parks *v.* Booth, 102 *U. S.* 96; aff'g 1 *Flippin*, 381; 1 *Bann. & A. Pat. Cas.* 225; Hailes *v.* Van Wormer, 20 *Wall.* 353; aff'g 7 *Blatchf.* 443; Barrett *v.* Hall, 1 *Mas.* 447; Moody *v.* Fiske, 2 *Mas.* 112; Earle *v.* Sawyer, 4 *Mas.* 1; Evans *v.* Eaton, *Pet. C. Ct.* 322; Pitts *v.* Whitman, 2 *Story*, 609; Devoll *v.* Brown, 3 *West. L. J.* 151; Hovey *v.* Henry, *Id.* 153; Hovey *v.* Stevens, 1 *Woodb. & M.* 290; Blake *v.* Sperry, 2 *N. Y. Leg. Obs.* 251; Buck *v.* Hermance, 1 *Blatchf.* 398; Hall *v.* Wiles, 2 *Blatchf.* 194; Clark Pomace Holder Co. *v.* Ferguson, 17 *Fed. Rep'r*, 79; 24 *Pat. Off. Gaz.* 1090; 21 *Blatchf.* 376; Pennock *v.* Dialogue, 4 *Wash.* 538; aff'g 2 *Pet.* 1; Whitney *v.* Emmett, *Baldw.* 303; Watson *v.* Cunningham, 4 *Fish. Pat. Cas.* 528; Kerosene Lamp Heater Co. *v.* Littell, 3 *Bann. & A. Pat. Cas.*

312; 1 *N. J. L.* 195; Tyler *v.* Deval, 1 *Code Rep'r*, 30; Gould *v.* Commissioner of Patents, 1 *McArthur*, 410. And a subsequent inventor may obtain a patent for a combination of the same elements as those which compose a prior one, provided the new combination is substantially different from the old, and accomplishes new and useful results. Sands *v.* Wardwell, 3 *Cliff.* 277. So patents may be granted for combinations, some of the elements of which are old and some are new; and whatever is new may also be separately secured to the inventor; although such new part may be of no practical use whatever, except in the combination described, or some similar combination. Wheeler *v.* Clipper Mower, &c. Co., 6 *Fish. Pat. Cas.* 1. But a combination, all the elements of which are devices or substantial equivalents for devices used in previously patented inventions, and which accomplishes the same result by merely a different method, is not a patentable invention. Gilbert *v.* Weir Plow Co., 22 *Fed. Rep'r*, 428; 29 *Pat. Off. Gaz.* 1129.

It has been held in a charge to the jury, that the fact that a device comprising several patentable elements has been patented as a whole will not prevent the patentee from afterwards securing a patent for a combination of any number of the elements less than the whole, provided he applies for it before the lesser combination has been two years in public use. Cahn *v.* Wong Town On, 19 *Fed. Rep'r*, 424; 9 *Sawyer*, 630; 27 *Pat. Off. Gaz.* 299.

Moreover, it is not necessary, in order to make a valid claim for a combination, that the several elementary parts of the combination should act simultaneously; but if such parts are so arranged that the successive action of each contributes to produce one result, and this result is the product of the simultaneous or successive action of all such parts, a patent for combining such elementary parts may be obtained. Forbush *v.* Cook, 2 *Fish. Pat. Cas.* 668; 20 *L. Rep'r*, 664; Hoe *v.* Cottrell, 1 *Fed. Rep'r*, 597; 17 *Blatchf.* 546; 18 *Pat. Off. Gaz.* 59; 5 *Bann. & A. Pat. Cas.* 256; Hoffman *v.* Young, 2 *Fed. Rep'r*, 74; 26 *Int. Rev. Rec.* 155; 10 *Rep'r*, 259; 18 *Pat. Off. Gaz.* 794; 5 *Bann. & A. Pat. Cas.* 316; Birdsell *v.* McDonald, 6 *Pat. Off. Gaz.* 682.

52. *How Patents for Combinations Should be Issued*

Under early patent laws it was held that if an invention consisted in a new combination of machinery, or in improvements upon an old machine, to produce a new effect, the patent should be for

the combined machinery, or improvements on the old machine, and not for a mere mode or device for producing such effects, detached from the machinery. Earrett *v.* Hall, 1 *Mas.* 447.

A patent may be obtained for a machine combining several distinct improvements, if each is the invention of the patentee, and may include a right to each of the several and distinct improvements; in other words, the patentee may in such case take out a valid patent for the combination, and also include therein a right to each distinct improvement severally contained in the same machine. Pitts *v.* Whitman, 2 *Story*, 609, 621.

A patent may embrace both a combination consisting of several elements, which, together, compose an organized machine, and subcombinations consisting of fewer members of the same elements. Stevens *v.* Pritchard, 10 *Pat. Off. Gaz.* 505; 4 *Cliff.* 417.

A broad claim in a patent cannot be sustained for merely putting together two old tools for convenience of manipulation in their several and distinct uses; the patent must be limited to some patentable improvement, either in the method of combining the tools, or in one or more of the tools themselves. Tower *v.* Bemis, &c. Hardware Co., 19 *Fed. Rep'r*, 498.

An inventor may claim in one patent a combination of devices, when they are so connected as to operate in a certain way; and in another, he may claim in combination with some of those devices, another one, by means of which, especially, the operation so described is produced. Wheeler *v.* McCormick, 4 *Pat. Off. Gaz.* 692; 6 *Fish. Pat. Cas.* 551; 11 *Blatchf.* 334.

If the same combination existed before, up to a certain point, and the invention consists in adding some new machinery, in some improved mode of operation, or some new combination, the patent must be limited to the improvement. Whitney *v.* Emmett, *Baldw.* 303.

53. *Rule that the Invention must be "New."*

To entitle one claiming as an inventor, to a patent, his invention must be "new;" novelty is, by the statute, an essential condition. Bedford *v.* Hunt, 1 *Mas.* 302; Perfection Window Cleaner Co. *v.* Bosley, 2 *Fed. Rep'r*, 574; 9 *Biss.* 385; 5 *Bann. & A. Pat. Cas.* 449; 10 *Rep'r*, 67; Wood *v.* Pacher, 17 *Fed. Rep'r*, 650. If his invention is a combination, his claim can be sustained only by establishing the novelty of the combination as a whole; though novelty of all or any of the parts need not be shown. Le Roy *v.* Tatham,

14 *How.* 156, 178. And, generally, the question upon an application for a patent is whether this thing has been made before; in case of a machine, whether it has been substantially constructed before; in case of an improvement of a machine, whether that improvement has ever been applied to such a machine before, or whether it is substantially new. Earle *v.* Sawyer, 4 *Mas.* 1. That an improved result is produced is not enough, standing alone, to entitle to a patent; improvement in the result has a tendency to show novelty; but if the superiority is attained by the application of known means, in a known way, to produce a known result, though a better one, there is not such novelty as is required by the patent law. Smith *v.* Nichols, 21 *Wall.* 112; aff'g 1 *Holmes*, 172; 6 *Fish. Pat. Cas.* 61; 2 *Pat. Off. Gaz.* 649; Le Roy *v.* Tatham, 14 *How.* 156, 178; Smith *v.* Nichols, 1 *Holmes*, 172; 6 *Fish. Pat. Cas.* 61. The invention must be substantially different from what has gone before; if it is so, and the result which it produces is different from and better than any produced by previous devices having the same purpose, it is patentable. Wood *v.* Packer, 17 *Fed. Rep'r*, 650.

As to what constitutes "novelty" in an invention, within the requirements of the patent laws, see Adams *v.* Edwards, 1 *Fish. Pat. Cas.* 1; Carr *v.* Rice, *Id.* 198; Wintermute *v.* Redington, *Id.* 239; Hays *v.* Sulsor, *Id.* 532; Judson *v.* Moore, *Id.* 544; Matthews *v.* Skates, *Id.* 602; Wayne *v.* Holmes, 2 *Fish. Pat. Cas.* 20; Clarke's Patent Steam, &c. Co. *v.* Copeland, *Id.* 221; Forbush *v.* Cook, *Id.* 668; 20 *L. Rep'r*, 664.

54. *Rule that it must be "Useful."*

To entitle an inventor to a patent the invention must be "useful;" utility is a statutory condition; but almost any small degree of utility is sufficient to satisfy the requirement. The term "useful" in the patent law, is used in opposition to "frivolous" or "noxious;" that the thing invented should be the best possible of its kind is not required. Lowell *v.* Lewis, 1 *Mas.* 182; Doherty *v.* Haynes, 4 *Cliff.* 291; 6 *Pat. Off. Gaz.* 118; 1 *Bann. & A. Pat. Cas.* 289; Winans *v.* Schenectady & Troy R. R. Co., 2 *Blatchf.* 279, 290; Kneass *v.* Schuylkill Bank, 4 *Wash.* 9; Whitney *v.* Emmett, *Baldw.* 303; Roberts *v.* Ward, 4 *McLean*, 565.

By "useful" is meant that the invention may be applied to some beneficial purpose in society, in contradistinction to an invention

which is injurious to the public morals, health or good order; and not that it must be of such general utility as to supersede all other inventions in practice to accomplish the same purpose. The law does not look to the degree of utility. Bedford *v.* Hunt, 1 *Mas.* 302; Many *v.* Jagger, 1 *Blatchf.* 372; Wilbur *v.* Beecher, 2 *Blatchf.* 132; Evans *v.* Eaton, *Pet. C. Ct.* 322. To be patentable, inventions need not be superior to or better than all other things known before; that they are useful in themselves is sufficient, provided they are also new. Shaw *v.* Colwell Lead Co., 11 *Fed. Rep'r*, 711; 20 *Blatchf.* 417; Crouch *v.* Speer, 6 *Pat. Off. Gaz.* 187; Strobridge *v.* Lindsay, 2 *Fed. Rep'r*, 692; 18 *Pat. Off. Gaz.* 62; 5 *Bann. & A. Pat. Cas.* 411; Pennsylvania Salt Manuf. Co. *v.* Thomas, 8 *Phila.* 144; Miller, &c. Manuf. Co. *v.* Du Brul, 12 *Pat. Off. Gaz.* 351; 2 *Bann. & A. Pat. Cas.* 618. But, devising a trivial improvement, not involving invention, does not entitle to a patent, [citing and approving 107 *U. S.* 192; 110 *U. S.* 490; 20 *Wall.* 353; 111 *U. S.* 604; 11 *How.* 248; 24 *How.* 164; 21 *Wall.* 112; 94 *U. S.* 187; 104 *U. S.* 737;] Morris *v.* McMillin, 112 *U. S.* 244; Hollister *v.* Benedict, 113 *U. S.* 59; Blake *v.* San Francisco, *Id.* 679.

The omission from a composition of matter, of an ingredient previously supposed to be essential, but now found to be unnecessary, which omission renders the composition simpler and cheaper in manufacture, while it is equally effective in operation, is patentable. Tarr *v.* Folsom, 1 *Holmes*, 312; 5 *Pat. Off. Gaz.* 92; 1 *Bann. & A. Pat. Cas.* 24.

By analogy to what has been decided under the copyright laws, it seems that while the fact that that article is necessarily immoral or injurious should render it unpatentable (Martinetti *v.* Maguire, 1 *Abb. U. S.* 356); yet if it is capable of an innocent, beneficial use it should not be excluded from the benefit of the patent laws because it may also be put to wrong uses; the fact that printed playing cards may be used for gambling does not preclude a design for them from being protected by injunction from infringement. Richardson *v.* Miller, 12 *Pat. Off. Gaz.* 3.

As to what constitutes "utility" in an invention, within the requirement of the patent laws, see Adams *v.* Edwards, 1 *Fish. Pat. Cas.* 1; Many *v.* Sizer, *Id.* 17; Carr *v.* Rice, *Id.* 198; Wintermute *v.* Redington, *Id.* 239; Hays *v.* Sulsor, *Id.* 532; Judson *v.* Moore, *Id.* 544; Pitts *v.* Wemple, 2 *Fish. Pat. Cas.* 10; Wayne *v.* Holmes, *Id.* 20; Lindsay *v.* Stein, 10 *Fed. Rep'r*, 907; 20 *Blatchf.* 370; 21 *Pat. Off. Gaz.* 1613.

55. *The Completeness or Perfection necessary.*

An imperfect and incomplete invention, resting in mere theory or intellectual notion, or in uncertain experiments, and not actually reduced to practice and embodied in some distinct machinery, apparatus, manufacture or composition of matter, is not patentable. Reed *v.* Cutter, 1 *Story*, 590; Draper *v.* Potomska Mills Corp., 13 *Pat. Off. Gaz.* 276; 3 *Bann. & A. Pat. Cas.* 214; Wheeler *v.* Clipper Mower, &c. Co., 10 *Blatchf.* 181; 6 *Fish. Pat. Cas.* 1; 2 *Pat. Off. Gaz.* 442; Judson *v.* Bradford, 16 *Pat. Off. Gaz.* 171. Neither is a process which is ineffectual until some means shall be invented to accomplish the result. Downton *v.* Yaeger Milling Co., 5 *Bann. & A. Pat. Cas.* 112. So, developing the idea of an invention by drawings does not amount to perfecting and adapting the invention, nor complete the inventor's right to a patent; he must have carried the idea into actual practice in material form. Reeves *v.* Keystone Bridge Co., 9 *Phila.* 368. An invention is not complete, so as to entitle the inventor to claim letters patent, until it is embodied in a form capable of successful and useful operation. Richardson *v.* Noyes, 10 *Pat. Off. Gaz.* 507; 2 *Bann. & A. Pat. Cas.* 398; Lyman Ventilating, &c. Co. *v.* Chamberlain, 10 *Pat. Off. Gaz.* 588; 2 *Bann. & A. Pat. Cas.* 433.

But with respect to completeness or perfection, the question is not whether the entire machine in which an improvement is embodied is a "perfect" machine, in the usual sense of that word, but whether it is perfect in the sense that it embodies a complete invention; whether, so far as it covers improved devices, it is a perfect machine, as respects those devices. American Hide, &c. Co. *v.* American Tool, &c. Co., 4 *Fish. Pat. Cas.* 284; 1 *Holmes*, 503.

The fact that a machine, when first applied in practice, does not perfectly accomplish the work for which it was designed, or does not accomplish all that its inventor supposed it would, is not enough to secure its rejection as a patentable invention; but if, taken as a whole, it is, in its construction and operation, an advance upon the state of the art to which it appertains, furnishing a better (though still imperfect) method of performing a useful function than was before available, it is not to be discarded as destitute of patentable merit. Seymour *v.* Marsh, 6 *Fish. Pat. Cas.* 115; 2 *Pat. Off. Gaz.* 674; 9 *Phila.* 380. If the invention is such that when the thing invented shall be constructed according to the model and specifications filed, it will operate successfully as a prac-

tical and useful thing, the inventor has satisfied the law, and may have a patent without going on to actually construct it. Wheeler *v.* Clipper Mower, &c. Co., 10 *Blatchf.* 181 ; 6 *Fish. Pat. Cas.* 1; 2 *Pat. Off. Gaz.* 442. An invention need not in fact be constructed in order to preserve a patent, when the patentee is a citizen of the United States, and the invention is capable of construction and operation from the model and specifications filed in the patent-office. Broadnax *v.* Central Stock-Yard, &c. Co., 4 *Fed. Rep'r*, 214 ; 11 *Rep'r*, 6 ; 5 *Bann. & A. Pat. Cas.* 609.

An invention is not patentable until a machine has been perfected ; and, if not actually used, made capable of useful operation. Moore *v.* Thomas, 3 *Bann. & A. Pat. Cas.* 13.

56. "*Not Known or Used by Others,*" &c.

The provision of *Rev. Stat.* § 4886,—that, to entitle a person to a patent his invention must be "not known or used by others in this country,"—is not to be construed as requiring one who contests the novelty of an invention for non-compliance with the requirement, to prove that it has been used as well as known, here. Stitt *v.* Eastern R. Co., 22 *Fed. Rep'r*, 649.

57. *Not Patented, or Described in any Printed Publication.*

If the thing patented was actually described in a published work previous to the discovery or invention of it by the applicant for a patent in this country, he cannot obtain a valid patent for it, even though he had no knowledge of such prior publication, but his invention of it was original with himself ; the restriction in the law is founded on a presumption that he may have known it, which is not allowed to be rebutted. This was so held under early patent laws (in Evans *v.* Eaton, 3 *Wheat.* 454, 514 ; rev'g *Pet. C. Ct.* 323 ; Rentgen *v.* Kanowrs, 1 *Wash.* 148), and under the act of 1836, in Allen *v.* Hunter, 6 *McLean*, 303, 314. Under the Revised Statutes the restriction has been modified (by § 4887, formerly Act of July 8, 1870, c. 230, § 25, 16 *Stat.* 201), so far as effect of a foreign patent is concerned ; and an inventor can obtain a patent here, by proving that he is the original inventor here, unless the thing has been introduced into use here for more than two years prior to his application ; the only effect of the foreign patent being to limit the term of the American. Cornely *v.* Marckwald, 17 *Fed. Rep'r*, 83 ; 24 *Pat. Off. Gaz.* 493 ; 16 *Rep'r*, 102. See *Rev. Stat.* § 4887, *infra.*

In order to defeat an American patent on the ground that the invention has been already patented abroad, the foreign *patent* must have been completed (in the case of an English patent, by enrollment of the specification), before the *invention* here was made; the fact that the foreign patent was applied for before application in this country, is not enough to bring a case within the restriction. Howe *v.* Morton, 13 *L. Rep'r, N. S.* 70; Coburn *v.* Schroeder, 22 *Pat. Off. Gaz.* 419. So, a description in a printed publication will not avoid a patent unless the description was published before the invention in this country (not the application) was made. Bartholomew *v.* Sawyer, 1 *Fish. Pat. Cas.* 516; 41 *Hunt Mer. Mag.* 575.

The description in a prior printed publication which will avoid a patent obtained by an inventor in good faith, must be sufficiently full and precise to enable a person skilled in the art to make the thing, repeat the process, &c., in all material respects like that covered by or described in the plaintiff's patent. Seymour *v.* Osborne, 11 *Wall.* 516; Colin *v.* United States Corset Co., 93 *U. S.* 366; Downton *v.* Yeager Milling Co., 108 *U. S.* 466; Hood *v.* Boston Car Spring Co., 21 *Fed. Rep'r*, 67; Parker *v.* Stiles, 5 *McLean*, 44, 61; 7 *West. L. J.* 168; Hays *v.* Sulsor, 1 *Fish. Pat. Cas.* 532; Judson *v.* Cope, *Id.* 615; Nathan *v.* New York Elevated R. R. Co., 2 *Fed. Rep'r*, 225; 9 *Rep'r*, 504; 5 *Bann. & A. Pat. Cas.* 280. Anticipation by others of a patented invention is not established by descriptions in publications which show nothing more than suggestions and speculations of scientific writers, who had never tested the practicability of their suggestions or demonstrated the truth or value of their speculations. Jensen *v.* Keasbey, 24 *Fed. Rep'r*, 144.

The decisions are not agreed whether a description of an invention given in a former patent issued to the same inventor, for another invention, and in which the invention in question is not claimed, will defeat a patent afterwards issued to him for the invention before omitted. Marvin *v.* Lillie, 27 *Pat. Off. Gaz.* 299; Vermont Farm Machine Co. *v.* Marble, 19 *Fed. Rep'r*, 307; 22 *Blatchf.* 32; 27 *Pat. Off. Gaz.* 621.

Mere use abroad, if there has been no patent and no published description, does not prevent one who has originally invented it, and makes oath that he believes himself the first inventor, from obtaining a valid patent. O'Reilly *v.* Morse, 15 *How.* 62, 110; Hays *v.* Sulsor, 1 *Fish. Pat. Cas.* 532; Judson *v.* Cope, *Id.* 615; Worswick Manuf. Co. *v.* Steiger, 17 *Fed. Rep'r*, 250; 5 *Op. Att.*

Gen. 18; and see Cornely *v.* Marckwald, 17 *Fed. Rep'r*, 83; 24 *Pat. Off. Gaz.* 498; 16 *Rep'r*, 102; 21 *Blatchf.* 367.

58. *Public use or Sale.*

The conditions imposed on granting a patent which have been illustrated in the previous sections (40–57) are primarily for the consideration of the commissioner; the required proofs and examination before him must afford reason to believe that the thing to be patented is new and useful, that the applicant is the inventor, that the invention has not been patented or described in any printed publication. Notwithstanding his favorable decision upon an *ex parte* application, however, the same questions may arise in a way to be contested upon opposing evidence, in an interference proceeding, in a suit in court between competing claimants to a patent, or in a suit for infringement. The plan of the foregoing notes has been to present the decisions so far as they seem to be instructive upon the duty of the commissioner in passing upon an uncontested application for a patent; but to reserve those which assume that the inventor's right is in litigation, for discussion in connection with those provisions of the statute which treat of the litigations which may arise over a patentee's right.

Two negative conditions imposed by the statute remain to be mentioned here. We refer to the requirements that the invention has not been in public use or on sale, and that it has not been abandoned. But as these are merely negative, and from their nature can rarely be developed in the office examination, but will usually arise only when the validity of the patent comes to be contested, they will only be mentioned; the more convenient place for presenting the decisions in which they are discussed, is in connection with the statute provisions regulating contests over patents.

Should it appear from facts elicited in the office examination of an application that the invention has been in public use or on sale for more than two years prior to the application, the commissioner is not authorized to grant a patent. It has been held, however, that an application cannot be rejected on this ground when the only proof before the commissioner consists of mere *ex parte* affidavits taken without notice and cross-examination. *Re* Alteneck, 23 *Pat. Off. Gaz.* 269. It was also ruled under the similar provision in the Act of 1836, that the law refers to some use or sale authorized or allowed by applicant; the analogous matter of a use or sale of substantially the same invention unknown to the applicant, by other

persons who have had the same idea, is covered by the anterior clause, "not known or used by others in this country." Bartholomew *v.* Sawyer, 4 *Blatchf.* 347; 1 *Fish. Pat. Cas.* 516; 41 *Hunt Mer. Mag.* 575. The current of opinion in the cases has been that the condition is not violated by any use of the invention, incidental to the experiments needful to developing and perfecting it, although such use may have been in public view and very generally known (Graham *v.* McCormick, 11 *Fed. Rep'r*, 859; 10 *Biss.* 39; 21 *Pat. Off. Gaz.* 1533; 5 *Bann. & A. Pat. Cas.* 244); as where the inventor of a new kind of pavement laid it in a portion of a city street, and allowed it to be used for a considerable time, merely, however, for the purpose of testing its qualities, and making sure of its merits (Elizabeth *v.* Pavement Co., 97 *U. S.* 126; 24 *Lawyers' Ed.* 1000); or where an inventor sold one of the articles at mere cost, for the purpose of having the buyer test it by actual use. Innis *v.* Oil City Boiler Works, 20 *Fed. Rep'r*, 780; 30 *Pat. Off. Gaz.* 998.

59. *Abandonment.*

Abandonment of an invention, likewise, if established, precludes any right to a patent; for it renders the invention public property, and there is no ground on which the inventor can resume his title to it. Hence the inventor, and he alone, is deemed competent to abandon; no use, unless by his knowledge or assent, can operate to deprive him of his right. Pierson *v.* Eagle Screw Co., 3 *Story*, 402. Abandonment is in the nature of a forfeiture of a right; the law does nor presume, or favor it, but requires proof that is clear and complete (Pitts *v.* Hall, 2 *Blatchf.* 229); and will construe acts of an inventor claimed to indicate abandonment, liberally in his favor (Mellus *v.* Silsbee, 4 *Mas.* 108); thus his saying that he means to dedicate his invention to the public, will not be regarded as equivalent to his doing so; there must be some acts of actual dedication. Pitt *v.* Hall, *supra.* On the other hand, abandonment does not turn wholly upon the intention of the inventor; whatever may be his intention, if he suffers his invention to go into public use, through any means whatever, without an immediate assertion of his right, he is not entitled to a patent; nor will a patent, obtained under such circumstances, protect his right. Shaw *v.* Cooper, 7 *Pet.* 292, 320. And it makes no difference by what means an invention may be communicated to the public before a patent is obtained; any acquiescence in the public use, by the inventor, will be an abandonment of his right. *Ib.* See the decis-

ions collated in connection with the statutes relative to interposing abandonment as a defense.

60. *Patents for Inventions previously patented Abroad.*

No person 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 in a foreign country, unless the same has been introduced into public use in the United States for more than two years prior to the application. But every patent granted for an invention which has been previously patented in a foreign country shall be so limited as to expire at the same time with the foreign patent, or, if there be more than one, at the same time with the one having the shortest term, and in no case shall it be in force more than seventeen years. *Rev. Stat.* § 4887.

This is substantially the provision of Act of July 8, 1870, c. 230, § 55, 16 *Stat.* 201. There were provisions on the same subject in the patent Acts of 1836, 1839, and 1861; as to which and their construction, see O'Reilly *v.* Morse, 15 *How.* 62, 112; Smith *v.* Ely, *Id.* 137; Goff *v.* Stafford, 14 *Pat. Off. Gaz.* 748; De Florez *v.* Raynolds, 8 *Fed. Rep'r*, 434; 17 *Blatchf.* 436; 17 *Pat. Off. Gaz.* 503; 5 *Bann. & A. Pat. Cas.* 140.

Among other things, the section has been held not retroactive (Badische, Anilin, &c. Fabrik *v.* Hamilton Manuf. Co., 13 *Pat. Off. Gas.* 273; 3 *Bann. & A. Pat. Cas.* 235); to relate to patents which are applied for in this country after issue of a patent abroad (French *v.* Rogers, 1 *Fish. Pat. Cas.* 133; American Leather Co. *v.* American Tool Co., 1 *Holmes*, 503; 4 *Fish. Pat. Cas.* 284); and to allow a foreign inventor to obtain a patent here, notwithstanding invalidity of a patent granted him abroad. Cornely *v.* Marckwald, 17 *Fed Rep'r*, 83; 24 *Pat. Off. Gaz.* 498; 16 *Rep'r*, 102; 31 *Blatchf.* 367. See also, *infra*, p. 482.

61. *Limiting Term by that of any Foreign Patent.*

The former patent-office rule requiring applicants to make known the existence of their foreign patents has been adjudged to have been made in accordance with law, and a failure to comply with

the rule renders the application defective, and it remains so, unless the office subsequently accepts and acts upon information respecting such foreign grants. *Exp.* Bland, 15 *Pat. Off. Gaz.* 828. An applicant may lawfully be required to disclose what patents he has procured abroad. United States *v.* Marble, 22 *Pat. Off. Gaz.* 1365.

But an omission (if inadvertent, and not attributable to bad faith) to limit the American patent in express terms to the duration of the foreign patent does not render the American void as a whole. The office in issuing the American will limit its duration so that it shall expire at the same time with the foreign, or with the shortest foreign if there are more than one (in no case, of course, giving the American more than seventeen years to run); according to the best information within its power (*Rules of Prac.* No. 29); if however, the American patent is not in fact by its terms limited to correspond with the shortest foreign, the effect is that the American is good until the expiration of the foreign; at which time the statute terminates it in favor of any one interested to raise the objection. O'Reilly *v.* Morse, 15 *How.* 62; Morse *v.* Bain, 9 *West. L. J.* 106; Tilghman *v.* Proctor, 102 *U. S.* 707; Goff *v.* Stafford, 14 *Pat. Off. Gaz.* 748; 2 *Bann. & A. Pat. Cas.* 610; Weston *v.* White, 13 *Blatchf.* 364; 9 *Pat. Off. Gaz.* 1196; 2 *Bann. & A. Pat. Cas.* 321; Nathan *v.* N. Y. Elevated R. R. Co., 5 *Bann. & A. Pat. Cas.* 280; 2 *Fed. Rep'r*, 225; American Diamond Rock-boring Co. *v.* Sheldon, 17 *Blatchf.* 303; 4 *Bann. & A. Pat. Cas.* 603; De Florez *v.* Reynolds, 17 *Blatchf.* 426; 17 *Pat. Off. Gaz.* 503; 8 *Fed. Rep'r*, 434; 5 *Bann. & A. Pat. Cas.* 140; Siemens *v.* Sellers, 23 *Pat. Off. Gaz.* 2234. In other words, the provision does not require the limitation to be expressed in the patent, but only controls the duration of the grant. Canan *v.* Pound Manuf. Co., 23 *Fed. Rep'r*, 185; 31 *Pat. Off. Gaz.* 119. Compare, however, contrary views expressed in Smith *v.* Ely, 15 *How.* 137, below, 5 *Mc Lean*, 137; Paillard *v.* Gautschi, 20 *Pat. Off. Gaz.* 1893. The attorney-general has advised that under such circumstances the date of the American patent may be altered to correspond with that of the foreign. 4 *Op. Att. Gen.* 335.

The courts have decided that the statute applies, and the American patent must expire coincidently with the foreign one having the shortest time to run, notwithstanding the American application was made before the application abroad, if the foreign patent was earlier granted (Bate Refrigerating Co. *v.* Gillett, 22 *Pat. Off. Gaz.* 1205; 13 *Fed. Rep'r*, 553; 28 *Int. Rev. Rec.* 280; 14 *Rep'r*, 357;

Gramme Electric Co. *v.* Arnoux, &c. Co., 7 *Fed. Rep'r*, 838; 21 *Blatchf.* 450; 25 *Pat. Off. Gaz.* 193; 16 *Rep'r*, 353*), and notwithstanding the foreign patent is a secret one. Gramme Electric Co. *v.* Arnoux, &c. Co., *supra.* A patent issued here is not affected as to its duration, by the subsequent issue of a patent abroad (Gold & Stock Tel. Co. *v.* Commercial Tel. Co., 23 *Fed. Rep'r*, 340; and see Same *v.* Same, 22 *Id.* 838); nor has a foreign patent which does not actually patent the invention, any influence on the term for which letters may be issued for it here. Holmes Electric Protective Co. *v.* Metropolitan Burglar Alarm Co., 22 *Fed. Rep'r*, 341.

An extension of the foreign patent does not enlarge the term of the American; that still expires at the date fixed for the expiration of the foreign as originally issued. Henry *v.* Providence Tool Co., 3 *Bann. & A.* 501; 14 *Pat. Off. Gaz.* 748; and again, *Id.* 855; Bate Refrigerating Co. *v.* Gillett, *supra;* Reissner *v.* Sharp, 16 *Blatchf.* 383; 16 *Pat. Off. Gaz.* 355; 4 *Bann. & A. Pat. Cas.* 366. On the other hand the failure of the foreign patent attributable to the patentee's default in payment of yearly fees, will not impair the American; that will run until the date fixed for the termination of the foreign, as issued, is reached. Badische Anilin, &c., Fabrik *v.* Hamilton Manuf. Co., 13 *Pat. Off. Gaz.* 273; 3 *Bann. & A.* 235. The provision means that the term of the patent here shall be as long as the remainder of the term for which the foreign patent was granted, without reference to incidents occurring after the grant: such as the lapse of the foreign patent for non-payment of tax. Holmes Electric Protective Co. *v.* Metropolitan Burglar Alarm Co., 22 *Blatchf.* 471; 21 *Fed. Rep'r*, 458.

A patent for an invention was issued indorsed with a reference to a foreign patent, the effect of which was to limit the term of the patent to the period the foreign patent had to run. Such indorsement was made by mistake, and for that reason the inventor refused to accept and returned the patent, and it was canceled and a new patent issued to him. *Held*, that the time intervening between the issue of the first patent and the allowance of the new patent should

* By rule of the Austrian Office taking effect July 16, 1884, all patents are granted for the term of 15 years subject to the payment of an annual tax. Formerly they were granted for *one* year with the privilege of prolongation to 15 years, and the Bate, and Gramme cases, cited in the text, *held*, that the U. S. patent granted after an Austrian patent applied for after the U. S. patent was applied for, lasted only *one* year. See commissioner's decision in Exp. Mann, 17 Pat. Off. Gaz. 330. For the rule, see 1 *ante*, 31.

not be deducte . from the term of the latter. Railway Register Manuf. Co. *v.* North Hudson C. R. Co., 23 *Fed. Rep'r*, 593.

V. APPLICATION AND ISSUE.

62. *Requisites of Application, Description, 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 of 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 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 and attested by two witnesses.—*Rev. Sta'.* § 4888.

In practice, a complete application comprises the petition, specification, oath, and drawings, the model or specimen, when either is required, and the first fee of $15. The petition, specification, and oath must be written in the English language. From the standpoint of the patent-office it is very desirable that all parts of the complete application be deposited in the office at the same time, and that all the papers embraced in the application be attached together. Circumstances may, however, put this out of an inventor's power. Where such is the case, the parts may be sent separately; but a letter must accompany each part, accurately and clearly connecting it

with the other parts of the application. And no application for a patent will be placed upon the files for examination until all its parts, except the model or specimen, are received. The petition, which (with the oath), is the first of the papers to be sent, must be addressed to the commissioner of patents, and state the name and residence of the petitioner, requesting the grant of a patent for the invention therein designated by title, with a reference to the specification for a full disclosure thereof. By *Rev. Stat.* § 4894, *post*, the application must be completed by sending the specification, &c., and prepared for examination within two years after the filing of the petition; and in default thereof, it will be regarded as abandoned, unless the commissioner is satisfied that such delay was unavoidable.

When upon an application for a patent, papers are filed without due formalities and not authenticated as required by law, it is the duty of the patent-office to decline to act upon them in their imperfect state, and to return them to the party, with such suggestions as may present themselves for his better information; but such action on the part of the patent-office does not amount to a rejection of the application, and does not excuse subsequent want of diligence on the part of the applicant in pursuing his application, by which his invention becomes abandoned to public use. Wickersham *v.* Singer, 1 *MacArthur Pat. Cas.* 645, 688.

The various applications, as they are completed, are numbered in regular order; the series now running having been begun January 1, 1880. The office informs each applicant of the number attached to his application. *Rules of Practice*, Nos. 30–32.

With respect to the limit of the time after making an invention, within which the inventor should file his petition, it has been held there is no limit positively imposed, the inventor should act within a reasonable time (else he exposes himself to the presumption of abandonment) but what is such reasonable time, and what measure of diligence is required, depend upon the circumstances of each case. Stephen *v.* Salisbury, 1 *MacArthur Pat. Cas.* 379; Ellithorp *v.* Robertson, *Id.* 585. See also Ellithorp *v.* Robertson, *Id.* 634; Wickersham *v.* Singer, *Id.* 645, 678; Savary *v.* Lauth, *Id.* 691; Spear *v.* Belson, *Id.* 699. Under the act of 1839, the omission of an inventor to apply for a patent within two years after he became aware that another was publicly using and claiming the invention, and his interposing no warning, or objection whatever, —was held in one case to constitute a clear case of disability to

prosecute a claim for a patent within section 7 of the Act. Justice *v.* Jones, 1 *MacArthur Pat. Cas.* 635.

It has been said, perhaps some qualification should be made, that admissions by a patentee, in his specification or application for a patent, cannot afterward be contradicted by him. Moffitt *v.* Rogers, 8 *Fed. Rep'r*, 147.

63. *General requisites of Description or Specification.*

The chief feature of the specification is the written description which it contains of the invention or discovery, and of the manner and process of making, constructing, compounding, and using the same. This is required to be in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which the invention appertains, or with which it is most nearly connected, to make, construct, compound, and use the same. It must set forth the precise invention for which a patent is solicited, explaining the principle thereof and the best mode in which the applicant has contemplated applying that principle, so as to distinguish it from other inventions.

It would be difficult to over-state the necessity of clearness, accuracy and precision in making description of the invention. The description must be neither too broad, embracing more than has been invented, nor too narrow, excluding some needful element. It must present the new invention precisely. This is necessary for several reasons. 1. To enable the commissioner to judge whether the matter claimed is new or too broad. 2. To enable the courts, when the patent is afterward contested, to form a like judgment. 3. To enable the public to understand what the patent is, and refrain from its use unless licensed. 4. To enable others to make improvements upon the device, and thus "promote the progress of the useful arts." 5. To enable licensed persons to make and use the invention. 6. To enable other inventors to judge what part of the field remains unoccupied; and, 7. To inform government what exclusive privilege has been granted, and what will become public property when the invention expires. Evans *v.* Eaton, 7 *Wheat.* 356, 433; aff'g 3 *Wash.* 443; Hogg *v.* Emerson, 6 *How.* 437; Gill *v.* Wells, 22 *Wall.* 1; 22 *Lawyers' Ed.* 699; Davoll *v.* Brown, 1 *Woodb. & M.* 53; Sullivan *v.* Redfield, 1 *Paine*, 441; Parker *v.* Stiles, 5 *McLean*, 44; 7 *West. L. J.* 168.

Another reason, perhaps more influential, is found in the nature

of an American patent right ; it is, that a patent is a grant by government of an exclusive privilege to an individual, and that such a privilege would be an odious monopoly, unless it was founded on a return of a just equivalent to the public. The statute holds out encouragements to stimulate invention and improvement in the arts and manufacture, by securing to the inventor a remuneration for his outlay and a reward for his ingenuity, and the consideration for which the patent issues to him is the benefit he confers on the community, by his discovery eventually becoming public property. The patentee may be regarded a purchaser from the public, being bound to so communicate his secret by specifications, drawings and models, that it shall be successfully available to the whole community at the expiration of the patent. Wintermute *v.* Redington, 1 *Fish. Pat. Cas.* 239. Thus the grant and acceptance of a patent are in the nature of a contract between the government and the inventor, in which the latter gives the public his invention from after the expiration of seventeen years, and in consideration thereof the former undertakes to protect him in the exclusive control of it during that time. This view of the relation of the parties being accepted, the duty resting upon the inventor of making a correct, useful disclosure of his invention becomes obvious. Thus it is established law that the description must be so explicit as to distinguish the invention from all others of the same kind, and so as to enable any person skilled in the art to make and use it. It should be accommodated to the comprehension of any practical mechanic, without taxing his genius or inventive powers. Gray *v.* James, *Pet. C. Ct.* 394. S. P., Teese *v.* Phelps, *McAll.* 48 ; Loom Co. *v.* Higgins, 105 *U. S.* 580; 1 *Op. Att. Gen.* 64. The patent is void unless the specification describes the invention claimed, sufficiently to enable a person skilled in the art to make and use it. Grant *v.* Raymond, 6 *Pet.* 218, 245 ; O'Reilly *v.* Morse, 15 *How.* 62, 119 ; American Pin Co. *v.* Oakville Pin Co., 3 *Blatchf.* 190 ; 3 *Am. L. Reg.* 136; Park *v.* Little, 3 *Wash.* 196.

Upon the one hand, the whole invention must be truly disclosed ; the contract of the public is not with him who has discovered, but him who also makes his discovery usefully known ; if he has discovered much and discloses little, he patents no more than he has proclaimed ; he will not be allowed afterward, when the extent of his right shall be the subject of controversy, to expand into a general expression what was before limited in a particular form, and argue that he had described the whole by implication from the first ;

Detmold *v.* Reeves, 4 *Am. L. J. N. S.* 189. Upon the other, it must not be exceeded, in the description; a patent may be adjudged void when it appears that the patentee, in his specification, instead of specifying distinctly what he has invented, has endeavored to anticipate, and include future inventions for the same object, and in so doing has rendered his specification ambiguous and adapted to mislead the public (Carlton *v.* Bokee, 17 *Wall.* 463; 6 *Fish. Pat. Cas.* 40); or where the specification endeavors to include an idea, or a function of the human system, or a quality of objects in nature, instead of a particular instrumentality, or concrete form of applying that idea, or function, or quality in use. 7 *Op. Att. Gen.* 276.

Still more clear is it that any fraudulent concealment in or addition to the specifications of a patent will avoid it. Lowell *v.* Lewis, 1 *Mas.* 182.

But it is settled that, although the specification is obscure, or imperfectly expressed, yet if it communicates the invention to the public in manner to enable the courts to identify, and mechanics skilled in the art to reproduce the patented device or improvement, it is sufficient. Whitney *v.* Emmett, *Baldw.* 303; St. Louis Stamping Co. *v.* Quimby, 16 *Pat. Off. Gaz.* 135; 4 *Bann. & A. Pat. Cas.* 192.

The following order of arrangement should be observed in framing the specification:

1. Preamble stating the name and residence of the applicant, and the title of the invention, and, if the invention has been patented in any country, the country or countries in which it has been so patented, and the date and number of each patent.

2. General statement of the object and nature of the invention.

3. Brief description of the several views of the drawings (if the invention admits such illustration).

4. Detailed description.

5. Claim or claims.

6. Signature of inventor.

7. Signatures of two witnesses. *Rules of Pract.* No. 39.

Two or more independent inventions cannot be claimed in one application, but where several distinct inventions are dependent upon each other and mutually contribute to produce a single result they may be claimed in one application. An application should not ordinarily embrace matters belonging to distinct official classes, nor

matters belonging to distinct subclasses in cases where a contrary practice has heretofore prevailed among applicants. *Id.* 40.

It is not necessary that the inventor correctly explain the scientific principle underlying his invention, or employ skilfully the appropriate scientific terms in explaining it. Andrews *v.* Cross, 8 *Fed. Rep'r*, 269; 19 *Blatchf.* 294; 19 *Pat. Off. Gaz.* 1705; Hovey *v.* Stevens, 3 *Woodb. & M.* 17; St. Louis Stamping Co. *v.* Quimby, *supra.* And he is not required to suggest all the possible modes by which the invention may be varied and yet the effect produced; to state the modes which he contemplates to be the best, and add, that other mere formal variations from these modes he does not deem to be unprotected by his patent is sufficient. Carver *v.* Braintree Manuf. Co., 2 *Story*, 432. See some further discussions of the necessity and duty on the part of a patentee, of accompanying his application with a description and specification of his invention: Wyeth *v.* Stone, 1 *Story*, 273; 4 *L. Rep'r*, 54; Sargent *v.* Carter, 11 *L. Rep'r, N. S.* 651; 1 *Fish. Pat. Cas.* 277. The danger of employing generic language of description instead of specific, pointed out. 7 *Op. Att. Gen.* 133.

64. *Description; in the case of Machines.*

All that the law requires of an inventor of a machine is that he shall describe the manner of making, constructing, and using it in such full, clear, concise and exact terms as will enable any one skilled in the art to which it appertains, to make, use and construct the same, and shall explain the principle thereof and the best mode in which he contemplated applying that principle, so as to distinguish it from other inventions. Grier *v.* Castle, 17 *Fed. Rep'r*, 523; 24 *Pat. Off. Gaz.* 1176. He is not, generally, limited by the literal import of his description of his invention, but may, in its construction, make such modifications as do not involve a departure from its principle, or a material change in its mode of operation. *Ib.*

In patents for complicated machines, it is essentially proper that the specification should clearly set forth what the patent admits to be old, and what he claims to be of his invention. But in anomalous cases, when a product has been discovered and the process of compounding it or obtaining it is disclosed, the patentee, by stating his discovery and revealing his process, has done all that he is required to do or can do. The careful separation of new from old, the limitation of claims to particular parts or combinations,

cannot in such cases be required as a substantial part of the specification. Goodyear *v.* Railroad, 2 *Wall. Jr.* 356 ; 1 *Fish. Pat. Cas.* 626.

If the specification is sufficiently explicit in its details to enable a skillful machinist to construct the patented improvement or invention, without other aid, the patent is not void because some of the minor details of the machine are not set forth at large. Union Paper Bag Co. *v.* Nixon, 6 *Fish. Pat. Cas.* 402 ; 9 *Pat. Off. Gaz.* 691 ; 2 *Bann. & A. Pat. Cas.* 244 ; 1 *Flippin*, 491 ; Brooks *v.* Bicknell, 3 *McLean*, 250 ; 1 *West. L. J.* 150 ;Vogler *v.* Semple, 7 *Biss.* 383 ; 11 *Pat. Off. Gaz.* 923 ; 23 *Int. Rev. Rec.* 112 ; 2 *Bann. & A. Pat. Cas.* 556.

A specification need not particularly describe the operation of mechanism which is well known by persons acquainted with the art. Knease *v.* Schuylkill Bank, 4 *Wash.* 9.

A specification need not state of what material, whether wood or iron, every part of the machine should be made. Brooks *v.* Bicknell, 3 *McLean*, 250 ; 1 *West. L. J.* 150.

Some inventions embrace an entire machine, and in such cases it is sufficient if it appears that the claim is co-extensive with the patented improvement. Other inventions embrace only one or more parts of a machine, and in such cases the part or parts claimed must be specified and pointed out, so that constructors, other inventors and the public may know what the invention is and what is withdrawn from general use. Parks *v.* Booth, 102 *U. S.* 96 ; aff'g 1 *Flippin*, 381 ; 1 *Bann. & A. Pat. Cas.* 225.

65. *In the case of Improvements.*

In case of a mere improvement, the specification must particularly point out the parts to which it 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, should be confined to the specific improvement and such parts as necessarily co-operate with it. *Rules of Prac.* No. 36.

Where a patent is for an improvement, the specification must describe, in full, clear and exact terms, what the improvement is: 1, to enable the public to enjoy the full benefit of the discovery when the monopoly is expired, by having it so described on record that it can be constructed ; and 2, to put every citizen on his guard, that he may not through ignorance violate the law, by infringing the rights of

the patentee. Evans *v.* Hettich, 7 *Wheat.* 453; aff'g 3 *Wash.* 408. If the description is so uncertain and obscure as to what is in fact the novelty, that the commissioner cannot determine whether the improvement consists in the combination of all the parts, or only of some of them, and of which—or in an invention of some new parts and if so, of what—the uncertainty will be fatal, and the patentee will have to make a new specification, setting forth his claim with greater certainty, accuracy and clearness, and disclaiming all not new. Phillips *v.* Page, 24 *How.* 164.

In a patent for an improvement, the patentee should not only describe the machine, with all its parts, but he should distinguish what is new. Whatever is the particular improvement must be clearly stated; both that the public may know what he claims as new, and that parties may know what they are to defend against. Hovey *v.* Stevens, 3 *Woodb. & M.* 17, 25. Phillips *v.* Page, 24 *How.* 164; Barrett *v.* Hall, 1 *Mas.* 447, 476; Sullivan *v.* Redfield, 1 *Paine*, 441; Blake *v.* Sperry, 2 *N. Y. Leg. Obs.* 251.

A patent for an improvement must show the extent of the improvement, so that a person who understands the subject may know in what it consists (Whitney *v.* Emmett, *Baldw.* 303); a general statement that the patented article is, in all respects, without stating what these are, an improvement on an old article, is no specification at all. Barrett *v.* Hall, 1 *Mas.* 447, 478.

In describing an improvement on a machine, the old and well known machinery, with which the new contrivance is to be connected, need not be described, or delineated in the drawing, when no change in their forms or proportions enters into the new invention. Emerson *v.* Hogg, 2 *Blatchf.* 1. So, giving a particular description of former machines of the same kind is not required; a general reference or reference to some one which is well known, accompanied by such a description of the improvement as will enable a workman to distinguish what is new, will be sufficient. Davis *v.* Palmer, 2 *Brock. Marsh.* 298. And the structure in detail of the entire and improved machine need not be given. To describe the improvement itself by showing the parts of which it consists, and the effects which it produces, is enough. Brooks *v.* Bicknell, 3 *McLean*, 250; 1 *West. L. J.* 150.

In a case of an improvement in the construction of railroad cars, the most essential feature of which consisted in locating the two sets of trucks as remotely from each other as convenient for the support of the carriage, and bringing the two axles of each truck as

near as possible to each other, it was *held*, that the specification need not specify in feet and inches the exact distance from the ends of the car body at which it would be best to arrange the trucks, or the exact distance between the two axles. Winans *v.* Schenectady & Troy R. R. Co., 2 *Blatchf.* 279.

66. *Of Compositions of Matter.*

The specification to accompany a patent for a new substance to be formed by means of chemical combinations of known materials should state the component parts of the new manufacture claimed with clearness and precision, and not leave the person attempting to use the discovery, to find out the exact proportions by experiment. The law requires the applicant to deliver a written description of the manner and process of making and compounding his newly-discovered compound. Giving the names of the materials only, without stating the proportions, or stating them vaguely, is not a sufficient specification, as it will not enable a person to make the compound. Wood *v.* Underhill, 5 *How.* 1; Tyler *v.* Boston, 7 *Wall.* 327; Jenkins *v.* Walker, 1 *Holmes*, 120.

67. *Of Combinations.*

The requirement of the patent law that the invention shall be fully and exactly described in the specification, applies with full force to an invention which consists in a new combination of old ingredients. Gill *v.* Wells, 22 *Wall.* 1. If the invention consists merely of a new combination of old elements the specification is sufficient if these are named, their mode of operation given, and the result pointed out. An invention may, however, embrace both a new device or element and a new combination of old devices embodied in the same apparatus or machine. In such a case particular description of the improvement is required in the specification, as the property of the patentee consists not only in the new device, but also in the new combination. Parks *v.* Booth, 102 *U. S.* 96; aff'g 1 *Ellippin*, 381; 1 *Bann. & A. Pat. Cas.* 225.

A peculiarity of construction of a patented device, which, although shown in the drawings, was not described in the specifications or claimed in the patent, and appeared not to have been, in the mind of the patentee, a part of the essence of the invention, and the effect produced by which was not a part of the expressed

object of the invention, was *held* not sufficiently stated or claimed, to sustain, alone, the patent for a combination, other elements of which had been previously in use. Bradley & Hubbard Manuf. Co. *v.* Charles Parker Co., 25 *Fed. Rep'r*, 907; 34 *Pat. Off. Gaz.* 249.

68. *The 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. *Rules of Prac.* No. 37.

If several inventions, claimed in a single application, be of such a nature that a single patent may not be issued to cover them, the inventor will be required to limit the description, drawing and claim of the pending application to whichever invention he may elect. The other inventions may be made the subjects of separate applications, which must conform to the rules applicable to original applications. If the independence of the inventions be clear, such limitation will be made before any action upon the merits; otherwise it may be made at any time before final action thereon, in the discretion of the examiner. *Id.* No. 41.

The scope of letters patent must be limited to the invention covered by "the claim," and the latter cannot be enlarged by the language used in other parts of the specification. Railroad Co. *v.* Mellon, 104 *U. S.* 112. The patentee must describe, with reasonable certainty, both in what his invention consists, and what his particular claim is. Wyeth *v.* Stone, 1 *Story*, 273; 4 *L. Rep'r*, 54. Delaware Coal Co. *v.* Packer, 5 *Bann. & A. Pat. Cas.* 296; 1 *Fed. Rep'r*, 851; 24 *Pat. Off. Gaz.* 1273.

Failure to state in the claim the nature, extent and character of the invention is the common defect; but a specification may be defective as well by an excess of claim as by a defect in the mode of stating it. Carver *v.* Braintree Manuf. Co., 2 *Story*, 432; Root *v.* Lamb, 7 *Fed. Rep'r*, 222; 19 *Pat. Off. Gaz.* 937.

Pending an application for a patent, and before it is issued, the claims may be amended to embrace anything contained in the original specifications; and such amended claims need not be verified by the oath and signature of the applicant. Railway Register Manuf. Co. *v.* North Hudson Co. R. Co., 24 *Fed. Rep'r*, 793.

Where the invention falls within the category of machines, a claim not only for the mechanism but also for the mode of opera-

tion generally, is void. Hatch *v.* Moffit, 15 *Fed. Rep'r*, 252. A claim for an effect or function cannot be sustained ; the means by which the effect is produced, or the function performed, must be specified. Wheeler *v.* Simpson, 6 *Pat. Off. Gaz.* 434. And a patentee who, under pretext of securing an invention of his own, enlarges his claim so as to embrace what really was invented by another, only imperils his title to that which is his. Adjustable Window Screen Co. *v.* Boughton, 10 *Phila.* 251 ; 1 *Bann. & A. Pat. Cas.* 327.

Where an invention consists of an improvement on a machine, the claim should exclude the old parts and claim only the new by which the old were adapted to the new use, producing the new result. Phillips *v.* Page, 24 *How.* 164 ; Evans *v.* Eaton, 3 *Wheat.* 454 ; rev'g *Pet. C. Ct.* 322 ; Barrett *v.* Hall, 1 *Mas.* 447, 476.

A claim in a patent for a process does not cover a condition in the material used in the process which is not referred to and described in the specification and claim within the requirements of Rev. Stat. § 4888. Western Electric Manuf. Co. *v.* Ansonia Brass &c. Co., 114 *U. S.* 447.

Both process and product may be included in one patent; but in such case the description of the invention in the specification and claims should disclose that the inventor had both results in his mind. Welling *v.* Rubber Coated, &c. Co., 7 *Pat. Off. Gaz.* 606; 2 *Bann. & A. Pat. Cas.* 1.

Where a device is patentable only as used in connection with a particular combination, the claim for such device must limit it to the particular combination of which it so forms a part. Stewart *v.* Mahoney, 5 *Fed. Rep'r*, 302; 4 *Bann. & A. Pat. Cas.* 84.

A claim for a whole combination of machinery and the manner of operating it, which does not set forth and claim particularly the points of novelty constituting the matter of the discovery of the applicant, is too broad, and is properly rejected. *Re* Davis, 1 *Mac Arthur Pat. Cas.* 628.

Claims in a patent for a combination need include only such elements as are essential to the peculiar combination, and are affected by the invention ; although the combination would be inoperative without other elements not claimed. Hancock Inspirator Co. *v.* Jenks, 21 *Fed. Rep'r*, 911.

69. *Amendment of Application.*

The supreme court has said that the law does not permit enlargements of an original specification any more than it does where letters patent already granted are re-issued; and it regards with jealousy and disfavor any attempt to enlarge the scope of an application once filed, or of letters patent once granted, the effect of which would be to enable the patentee to appropriate other inventions made prior to such alteration, or improvements which have gone into public use. Railway Co. *v.* Sayles, 97 *U. S.* 554.

Nevertheless the rules of the patent-office permit amendments to a limited extent, as follows: The applicant has a right to amend before or after the first rejection; and he may amend as often as the examiner presents any new references or reasons for rejection. In so amending the applicant must clearly point out all of the patentable novelty which he thinks the case presents, in view of the state of the art disclosed by the references cited or objections made. He must also show how the amendments avoid such references or objections. After appeal, or after such action on all the claims as shall entitle the applicant to an appeal to the board of examiners-in-chief, amendments will not ordinarily be allowed. If such amendments are offered, good and sufficient cause therefor must be shown, together with the reasons why they were not earlier presented; and, if satisfied on these points, the examiner may admit and consider them. If the examiner shall refuse to admit and consider such amendments, an appeal will lie to the Commissioner, as in other cases. No amendment can be made between hearing on appeal and decision; and after decision of any appellate tribunal amendments can be made only in accordance with such decision, except as provided in rule 137. *Rules of Prac.* No. 67.

70. *Drawings, When Requisite.*

When the nature of the case admits of drawings, the applicant shall furnish one copy signed by the inventor or his attorney in fact, and attested by two witnesses, which shall be filed in the patent-office; and a copy of the drawing, to be furnished by the patent-office, shall be attached to the patent as a part of the specification. *Rev. Stat.* § 4889.

The courts have held that drawings accompanying an original application for a patent, have the same force and effect as if they were referred to in the specification, and are to be deemed and taken as part of it. Winans *v.* Schenectady & Troy R. R. Co., 2 *Blatchf.* 279. In reducing his patent to practical application a patentee is not held to strictly and entirely follow the mere mechanical device shown in his drawings, but he may deviate so long as he does not violate the principle involved in his patent. Weir *v.* North Chicago Rolling Mill Co., 14 *Fed. Rep'r*, 42 ; 9 *Biss.* 508 ; 23 *Pat. Off. Gaz.* 191. The drawings serve to explain the description, and may be used to relieve ambiguity or uncertainty therein ; but cannot supply the entire want of a description or of a claim. Tinker *v.* Wilber Eureka Mower, &c. Co., 1 *Fed. Rep'r*, 138 ; 9 *Rep'r*, 273 ; 5 *Bann. & A. Pat. Cas.* 92 ; Howes *v.* Nute, 4 *Cliff.* 173 ; Untermeyer *v.* Jeannot, 20 *Fed. Rep'r*, 503. The drawing and model may be taken together in explanation of the description. Stephens *v.* Salisbury, 1 *MacArthur Pat. Cas.* 379. The drawing performs substantially the same office as the model (Emerson *v.* Hogg, 2 *Blatchf.* 1) ; and in many cases may render a model unnecessary (Loom Co. *v.* Higgins, 105 *U. S.* 580 ; rev'g 15 *Blatchf.* 446 ; 16 *Pat. Off. Gaz.* 675 ; 4 *Bann. & A. Pat. Cas.* 88) ; though whether a model shall be required or not rests in the discretion of the commissioner (*Rev. Stat.* § 4891); and the whole subject is chiefly regulated by the office regulations.

In case the applicant seeks by amendment to introduce any claim not substantially embraced in the statement of invention or claim originally presented, and, therefore, not covered by the original oath, he will be required to file a supplemental oath to the effect that the subject-matter of the proposed amendment was part of his invention and was invented before he filed his original application, and such supplemental oath must be attached to and properly identify the proposed amendment. *Rules of Prac.* No. 47.

In original applications which are capable of illustration by drawing or model, all amendments of the model, drawings, or specification or of additions thereto must conform to at least one of them as they were at the time of the filing of the application. Matter not found in either involving a departure from the original invention can be shown or claimed only in a separate application If the invention does not admit of illustration by drawing or model amendment of the specification is permitted upon proof satisfactory to the commissioner that the matter covered by the proposed

amendment was a part of the original invention; the affidavits prescribed in Rule 47 may or may not be sufficient. *Id.* No. 69.

The specification must be amended and revised, when required, for the purpose of correcting inaccuracies of description or unnecessary prolixity, and of securing correspondence between the claim and the other parts of the specification. *Id.* No. 70.

After the completion of the application the office will not return the specification for any purpose whatever. The model or drawing (but not both at the same time) may be withdrawn for correction. If applicants have not preserved copies of such papers as they wish to amend, the office will furnish them on the usual terms. *Id.* No. 71.

All amendments of specifications or claims must be made on sheets of paper separate from the original. Even when the amendment consists in striking out a portion of the specification or of the claims, the same course must be observed. Erasures must not be made by the applicant. In every case of amendment the exact word or words to be stricken out or inserted must be clearly specified, and the precise point indicated where the erasure or insertion is to be made. (See Rule 44.)

When an amendatory clause is amended it must be wholly rewritten, so that no interlineation or erasure shall appear in the clause, as finally amended, when the case is passed to issue. If the number or nature of the amendments shall render it otherwise difficult to consider the case, or to arrange the papers for printing or copying, the examiner or commissioner may require the entire specification to be rewritten.

Amendments must be plainly written or printed on but one side of the paper. All interlineations and erasures must be clearly marked in marginal or foot notes written on the same sheet. *Rules of Prac.* No. 44.

Applications in interference can be amended only as provided in Rules 94, 125. After notice of allowanance of an application for a patent, no amendments will be received (unless by authority of the commissioner). Amendments not affecting the merits may be made after allowance and after payment of the final fee, on the recommendation of the primary examiner, approved by the commissioner, without withdrawing the application from issue.

71. *Office Rules as to Drawings.*

The applicant for a patent is required by law to furnish a drawing of his invention where the nature of the case admits of it. *Rules of Prac.* No. 48.

The drawing must be signed by the inventor or by his attorney in fact, and attested by two witnesses, and must show every feature of the invention covered by the claims, and when the invention consists of an improvement on an old machine, it must exhibit, in one or more views, the invention itself, disconnected from the old structure, and also, in another view, so much only of the old structure as will suffice to show the connection of the invention therewith. *Id.* No. 49.

Three several editions of patent drawings are printed and published: one for office use, certified copies, &c., of the size and character of those attached to patents, the work being about 6 by 9½ inches; one reduced to half that scale, or one-fourth the surface, of which four will be printed on a page to illustrate the volumes distributed to the courts; and one reduction—to about the same scale—of a selected portion of each drawing to illustrate the Official Gazette. This work will all be done by the photolithographic or other analogous process, and therefore the character of each original drawing must be brought as nearly as possible to a uniform standard of excellence, suited to the requirements of the process, and calculated to give the best results, in the interest of inventors, of the office, and of the public generally. The following rules will therefore be rigidly enforced, and any departure from them will be certain to cause delay in the examination of an application for letters patent:

1. Drawings must be made upon pure white paper of a thickness corresponding to three-sheet Bristol board. The surface of the paper must be calendered and smooth. India ink alone must be used, to secure perfectly black and solid lines.

2. The size of a sheet on which a drawing is made must be exactly 10 by 15 inches. One inch from its edges a single marginal line is to be drawn, leaving the "sight" precisely 8 by 13 inches. *Within this margin all work and signatures must be* included. One of the shorter sides of the sheet is regarded as its top, and, measuring downward from the marginal line, a space of not less than 1¼ inch is to be left blank for the heading of title, name, number, and date.

3. All drawings must be made with the pen only. Every line and letter (signatures included) must be absolutely black. This direction applies to all lines, however fine, to shading, and to lines representing cut surfaces in sectional views. All lines must be clean, sharp, and solid, and they must not be too fine or crowded. Surface shading, when used, should be open. Sectional shading should be made by oblique parallel lines, which may be about one-twentieth of an inch apart.

4. Drawings should be made with the fewest lines possible consistent with clearness. By the observance of this rule the effectiveness of the work after reduction will be much increased. Shading (except on sectional views) should be used only on convex and concave surfaces, where it should be used sparingly, and may even there be dispensed with if the drawing is otherwise well executed. The plane upon which a sectional view is taken should be indicated on the general view by a broken or dotted line. Heavy lines on the shade sides of objects should be used, except where they tend to thicken the work and obscure letters of reference. The light is always supposed to come from the upper left-hand corner, at an angle of forty-five degrees. Imitations of wood or surface-graining should not be attempted.

5. The scale to which a drawing is made ought to be large enough to show the mechanism without crowding, and two or more sheets should be used if one does not give sufficient room to accomplish this end; but the number of sheets must never be increased unless it is absoluely necessary.

6. Letters and figures of reference must be carefully formed. They should, if possible, measure at least one-eighth of an inch in height, so that they may bear reduction to one-twenty-fourth of an inch; and they may be much larger when there is sufficient room. They must be so placed in the close and complex parts of drawings as not to interfere with a thorough comprehension of the same, and therefore should rarely cross or mingle with the lines. When necessarily grouped around a certain part, they should be placed at a little distance, where there is available space, and connected by short broken lines with the parts to which they refer. They must never appear upon shaded surfaces, and, when it is difficult to avoid this, a blank space must be left in the shading where the letter occurs, so that it shall appear perfectly distinct and separate from the work. If the same part of an invention appear in more than one view of the drawing it must always be represented by the same

character, and the same character must never be used to designate different parts.

7. The signature of the inventor is to be placed at the lower right-hand corner of the sheet, and the signatures of the witnesses at the lower left-hand corner, all within the marginal line. The title is to be written with pencil on the back of the sheet. The permanent names and title will be supplied subsequently by the office in uniform style.

When views are longer than the width of the sheet, the sheet is to be turned on its side, and the heading will be placed at the right, and the signatures at the left, occupying the same space and position as in the upright views, and being horizontal when the sheet is held in an upright position; and all views on the same sheet must stand in the same direction.

8. As a rule, one view only of each invention can be shown in the Gazette illustrations. The selection of that portion of a drawing best calculated to explain the nature of the specific improvement will be facilitated, and the final result improved, by the judicious execution of a figure with express reference to the Gazette, but which may, at the same time, serve as one of the figures referred to in the specification. For this purpose, the figure may be a plan, elevation, section, or perspective view, according to the judgment of the draftsman. It must not cover a space exceeding sixteen square inches. All its parts should be especially open and distinct, with very little or no shading, and it must illustrate the invention claimed only, to the exclusion of all other details. When well executed, it will be used without curtailment or charge; but any excessive fineness, or crowding, or unnecessary elaborateness of detail, will necessitate its exclusion from the Gazette. [The pamphlet of Rules of Practice contains a specimen drawing illustrative of the applications of these directions.]

9. Drawings should be rolled for transmission to the office, not folded. No agent's or attorney's stamp, or advertisement, or written address, will be permitted upon the face of a drawing within or without the marginal line. *Id.* No. 50.

There are modifications of these rules in relation to drawings for design patents and for re-issue applications, which are mentioned in the appropriate places. The rules as to drawings generally are rigidly enforced; and although a drawing not artistically executed in conformity to them may be admitted for purposes of examination, if it sufficiently illustrates the invention, yet a new

and correctly prepared one must be furnished before the application can be allowed. The office will furnish drawings at cost, as promptly as its draftsman can make them, for applicants who cannot otherwise conveniently procure them. *Id.* Nos. 51–54.

72. *Specimens of Ingredients, &c.*

When the invention or discovery is of a composition of matter, the applicant, if required by the commissioner, shall furnish specimens of ingredients and of the composition, sufficient in quantity for the purpose of experiment. *Rev. Stat.* § 4890.

In all cases where the article is not perishable, a specimen of the composition claimed, put up in proper form to be preserved by the office, must be furnished. *Rules of Prac.* No. 61.

Proof that the samples deposited in the patent-office with the original application do not correspond with the ingredients specified in the re-issue will not impair its validity; whether an applicant has complied with the requisites for obtaining a patent is for the commissioner to determine, and the court will not revise his action. Tarr *v.* Folsom, 5 *Pat. Off. Gaz.* 92; 1 *Holmes*, 312; 1 *Bann. & A. Pat. Cas.* 24.

A patent cannot be held void because the application was not accompanied by specimens; it was for the commissioner to decide whether they were needful. Badische Anilin, &c. Fabrik *v.* Cochrane, 16 *Blatchf.* 155; 4 *Bann. & A. Pat. Cas.* 215.

73. *Model, when requisite.*

In all cases which admit of representation by model, the applicant, if required by the commissioner, shall furnish a model of convenient size to exhibit advantageously the several parts of his invention or discovery. *Rev. Stat.* § 4891.

74. *Oath required from Applicant.*

The applicant shall make oath that he does verily believe himself to be the original and first inventor or discoverer of the art, machine, manufacture, composition, or improvement for which he solicits a patent; that he does

not known and does not believe that the same was ever before known or used; and shall state of what country he is a citizen. Such oath may be made before any person within the United States authorized by law to administer oaths, or when the applicant resides in a foreign country, before any minister, chargé d'affaires, consul, or commercial agent, holding commission under the government of the United States, or before any notary public of the foreign country in which the applicant may be. *Rev. Stat.* § 4892.

The rules of the office prescribe that besides stating of what country he is a citizen, he shall state where he resides. And: "in every original application the applicant must distinctly state, under oath, whether the invention has or has not been patented to himself, or to others with his consent or knowledge, in any country, and if it has been, the country or countries in which it has been so patented, giving the date and number of each patent, and that it has not been patented in any other country or countries than those mentioned, and must state that, according to his knowledge and belief, the same has not been in public use or on sale in the United States for more than two years prior to the application in this country." *Rules of Prac.* No. 45. A general provision of statute allows applicants to make affirmation instead of taking oath.

The oath should be attested in all cases, in this and other countries, by the proper official seal of the officer before whom the oath or affirmation is made; or when he is not provided with a seal his official character must be established by competent evidence, such as a certificate from a clerk of a court of record or other proper officer having a seal.* *Id.* No. 46.

No patent can properly issue unless oath is duly made (1 *Op. Att. Gen.* 339); if, however, a patent is issued without oath, the omission does not invalidate. Whittemore *v.* Cutter, 1 *Gall.* 429; Crompton *v.* Belknap Mills, 3 *Fish. Pat. Cas.* 536; Hartshorn *v.* Eagle Shade Roller Co., 18 *Fed. Rep'r*, 90; 25 *Pat. Off. Gaz.* 1191.

* In all applications for letters patent filed in this office subsequent to October 24, 1882, the signature of the applicant is required to the oath, in accordance with form 17, page 63 of Rules of Practice.

A certificate of the official character of a magistrate, stating date of appointment and term of office, may be filed in the patent-office, which will obviate the necessity of separate certificates in individual cases.

The oath must be taken by the applicant in person ; and cannot be by his agent or attorney ; for it relates to matters, some of which can only be written from personal knowledge of the inventor ; if they were sworn to by an agent, the evidence could be nothing but hearsay. 10 *Op. Att. Gen.* 137.

If the application be made by an executor or administrator, the form of the oath will be correspondingly varied. The former attorneys of a deceased inventor have no authority to amend an application for letters patent unsupported by the oath of the personal representative of the decedent. Eagleton Manuf. Co. *v.* West, &c. Manuf. Co., 2 *Fed. Rep'r*, 774; 18 *Blatchf.* 218; 17 *Pat. Off. Gaz.* 1504; 10 *Rep'r*, 297.

The oath is to be considered as extending to the specification. Hogg *v.* Emerson, 6 *How.* 437, 482

75. *Examination, and Issuing Patent.*

On the filing of any such application and the payment of the fees required by law, the commissioner of patents shall cause an examination to be made of the alleged new invention or discovery ; and if on such examination it shall appear that the claimant is justly entitled to a patent under the law, and that the same is sufficiently useful and important, the commissioner shall issue a patent therefor. *Rev. Stat.* § 4893.

All cases in the patent-office are classified and taken up for examination in regular order, those in the same class of invention being examined and disposed of, as far as practicable, in the order in which the respective applications are completed ; but applications which have received action by an examiner and have been put into condition for further action on his part shall be entitled to precedence over completed applications in the same class of invention which have received no action. Cases within classes specified in the rule have also precedence, in time of examination, over ordinary applications. *Rules of Prac.* No. 62.

The first step in the examination of an application will be to determine whether it is, in all respects, in proper form. If, however, the objections as to form are not vital, the examiner may proceed to the consideration of the application on its merits ; but in

such case he must if possible, in his first letter to the applicant, state all his objections, whether formal or otherwise, and until the formal objections are disposed of no further action will be taken upon its merits without the order of the commissioner. *Id.* No. 63.

The hearing before the commissioner of patents, on an application for a patent, is informal and summary, and not final. The application may be renewed from time to time, on the same or additional evidence. The previous hearings and decisions create no further bar to a further investigation. Gay *v.* Cornell, 1 *Blatchf.* 506.

The examiner in a patent case has no power to rule upon the admissibility of evidence, and defendant, as a witness, has a right, upon doubtful questions, to take the opinion of the court; and where he acts in good faith, and under the advice of counsel, his refusal to answer will not be punished as for a contempt, even though he acted mistakenly. Roberts *v.* Walley, 14 *Fed. Rep'r*, 167; 29 *Int. Rev. Rec.* 47; 15 *Rep'r*, 39.

Where the plaintiff, at the time, interposed no objection to the testimony of the witnesses of the defendant, in an examination before an examiner in a patent case, it was *held* too late to raise an objection to such testimony on the hearing before the court on the proofs. Every objection which could have thus been taken, and which did not appear by the record to have been specifically taken, must be considered as having been waived. Brown *v.* Hall, 6 *Blatchf.* 401; 3 *Fish. Pat. Cas.* 531.

Section 7 of the Act of 1836 contained the same condition, if it shall appear, that the invention "is sufficiently useful and important;" and under that statute it was *held* that the degree of usefulness or importance is not described or limited; and is not material, if the invention interferes with no prior right or claim, and is in itself innocent. *Re* Aiken, 1 *McArthur Pat. Cas.* 130. If it is capable of use for some beneficial purpose, the degree of utility, whether larger or smaller, is not a subject for consideration by the commissioner. *Re* Seely, 1 *McArthur Pat. Cas.* 248. But see *Re* Cushman, *Id.* 569.

Mandamus will lie to compel a commissioner who has adjudged that a patent issue, but refuses to prepare it, lay it before the secretary and countersign it, to compel him to perform these ministerial acts; and the writ is properly addressed to the commissioner. Butterworth *v.* Hoe, 112 *U. S.* 50, 68.

76. *Limitation upon Time of completing Applications.*

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. *Rev. Stat.* § 4894.

There is no limitation of time within which a patent must be taken out, after specification filed. 5 *Op. Att. Gen.* 701. Nothing in the acts of Congress requires that a patent should be issued within a given time, after the application is filed, or which forbids the postponement of it for a time at the suggestion either of the applicant or the office. O'Reilly *v.* Morse, 15 *How.* 62, 126; Allen *v.* Blunt, 2 *Woodb. & M.* 121.

Whether an invention was long antecedent to the application for a patent, or directly preceding it, is wholly immaterial to the validity of the patent. Wilder *v.* McCormick, 2 *Blatchf.* 31. The right of the inventor is protected from the time of his application; delay which may occur in the patent-office, in making out a patent, cannot operate to the injury of the applicant. Root *v.* Ball, 4 *McLean*, 177.

Where an inventor keeps his invention a secret, mere delay in applying for a patent will not forfeit his right thereto, or bar his subsequent application; and delay of less than two years will not constitute a defense against a patent in any case. Miller *v.* Smith, 5 *Fed. Rep'r*, 359; 18 *Pat. Off. Gaz.* 1047.

Of the two original inventors, the first will be entitled to letters patent, unless the other puts the invention into public use more than two years before the application for them. Loom Co. *v.* Higgins, 105 *U. S.* 580; rev'g 15 *Blatchf.* 446; 16 *Pat. Off. Gaz.* 675; 4 *Bann. & A. Pat. Cas.* 85.

77. *Abandoned, Forfeited, and Renewed Applications.*

An abandoned application is one which has not been completed and prepared for examination within two years after the filing of

the petition, or which the applicant has failed to prosecute within two years after any action therein, of which notice has been duly given (see Rules 31 and 76), or which the applicant has expressly abandoned by filing, in the office, a written declaration of abandonment, signed by himself (and assignee, if any), identifying his application by title of invention and date of filing.

Prosecution of an application, to save it from abandonment, must include such proper action as the condition of the case may require. *Rules of Prac.* No. 165.

Before an application abandoned by failure to complete or prosecute can be renewed, it must be shown to the satisfaction of the commissioner that the delay in the prosecution of the same was unavoidable. *Id.* No. 166.

When a new application is filed in place of an abandoned or rejected application, a new specification, oath, drawing, and fee will be required; but the old model, if suitable, may be used. *Id.* No. 167.

A forfeited application is one upon which a patent has been withheld for failure to pay the final fee within the prescribed time. *Id.* No. 168.

Where the patent has been withheld by reason of non-payment of the final fee, any person, whether inventor or assignee, who has an interest in the invention for which such patent was ordered to issue, may file a new application for the same invention; but such second application must be made within two years after the allowance of the original application. Upon the hearing of such new application, abandonment will be considered as a question of fact. *Id.* No. 169.

In such renewal, the oath, petition, specification, drawing, and model of the original application may be used for the second application; but a new fee will be required. The second application will not be regarded as a continuation of the original one, but will bear date from the time of renewal, and be subject to examination like an original application. *Id.* No. 170.

Forfeited and abandoned applications will not be cited as references. No notice will be given to applicants, while their cases remain forfeited, of the filing of subsequent applications. Certified copies of the files in cases of rejected and abandoned applications may be furnished to applicants or to other persons when specifically ordered by the Commissioner. *Id.* No. 171. See *post*, § 80.

78. *Applications Renewed after Withdrawal.*

If an applicant for a patent withdraws his application, intending at the time of such withdrawal to file a new petition, and accordingly does so, the two petitions are to be considered as parts of the same transaction, and both as constituting one continuous application. Godfrey *v.* Eames, 1 *Wall.* 317.

The general rule is, that the first in a series of applications for a patent is the one on which the patent, when granted, depends. And if, between the first and a second application, the patentee has manifested an actual intention to abandon the first, his patent will have relation to the last one only. Pelton *v.* Waters, 7 *Pat. Off. Gaz.* 425.

Where an application is made for a patent, and is afterward amended by the withdrawal of parts of the invention, and a second application is filed claiming such parts, and patents afterward issue on both, the two applications will be considered as parts of one continuous proceeding. In such case, the continuity of the proceedings originating in the first application, will be considered unbroken in determining when the two years begin to run in which the invention claimed on the second application could be sold and publicly used without invalidating such patent. Graham *v.* Geneva Lake Crawford Manuf. Co., 11 *Fed. Rep'r*, 138 ; 21 *Pat. Off. Gaz.* 1536. Various applications for a patent, extending over a period of more than nineteen years, were *held* one continuous application. Colgate *v.* Western Union Tel. Co., 4 *Bann. & A. Pat. Cas.* 36.

The commissioner may permit one of two competing applicants for a patent to withdraw and refile his application after he has expressed an opinion favorable to the priority of the other. Such intervening opinion or decision is no bar to the issue of a patent on the new application, if, upon full examination of the whole subject, he considers the applicant entitled to it. 5 *Op. Att. Gen.* 220.

The withdrawal of an application for a patent and the return of a part of the patent fee do not necessarily constitute an abandonment or dedication of the invention to the public, but are equivocal, and to be interpreted by circumstances, and to be affected upon a second application by the subsequent conduct of the party—his diligence or his neglect and delay—in the same manner as his conduct is to be weighed in regard to an original application. Wickersham *v.* Singer, 1 *MacArthur Pat. Cas.* 645, 687. They have been held, in Mowry *v.* Barber, 1 *MacArthur Pat. Cas.* 563, to

be an abandonment, and in Colgate *v.* Western Union Tel. Co., 4 *Bann. & A. Pat. Cas.* 36, not to be one.

79. *Patents Granted to Assignee.*

Patents may be granted and issued or reissued 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; and in all cases of an application for a reissue of any patent, the application must be made and the corrected specification signed by the inventor or discoverer, if he is living, unless the patent was issued and the assignment made before the eighth day of July, eighteen hundred and seventy. *Rev. Stat.* § 4895.

In case of an assignment of the whole interest in the invention, or of the whole interest in the patent to be granted, the patent will, upon request of the applicant, issue to the assignee; and if the assignee hold an undivided part interest, the patent will, upon like request, issue jointly to inventor and assignee; but the assignment in either case must first have been entered of record, and at a day not later than the date of the 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 the serial number, so that there can be no mistake as to the particular invention intended. The application and oath must be made by the actual inventor, if alive, even if the patent is to issue to an assignee. If the inventor be dead, it may be made by the executor or administrator. *Rules of Prac.* No. 26.

The assignment contemplated by the above section and rule is an assignment of the *invention* and inchoate right to obtain a patent; and is quite distinct from the assignment of the *letters patent* when obtained; which is covered by section 4898. The law allows an inventor to transfer his invention before patenting it; after which an application may be prosecuted by the transferee or assignee, and the patent issued to him; and the inventor becomes estopped by his antecedent contract of assignment from claiming any adverse title to the patent subsequent to its issue. Herbert *v.*

Adams, 4 *Mas.* 15; Rathbone *v.* Orr, 5 *McLean*, 131. Even though an application has been made in the name of the inventor, so that the patent must issue to him; and even though the application has been rejected and an appeal taken, an assignment of the invention is valid; and operates to vest in the assignee the right to the patent when issued. Gay *v.* Cornell, 1 *Blatchf.* 506; United States Stamping Co. *v.* Jewell, 7 *Fed. Rep'r*, 869; 18 *Blatchf.* 469; 18 *Pat. Off. Gaz.* 1829. So an inventor may sell whatever improvements he may make in the future, as well as those he has already made. Nesmith *v.* Calvert, 1 *Woodb. & M.* 34.

The designation in an assignment of an invention, of the subject matter assigned, as the exclusive right to an invention described in a specification already prepared and executed by the assignor, is sufficient, since the means of ascertainment are furnished. Fisk *v.* Hollander, *MacArthur & Mac.* 355. The designation, in such an assignment, of the assignees by the name and style of the partnership firm, does not render void the assignment or the patent issued to them thereon; since such designation may be applied to the parties intended, by proof of the existence of a partnership bearing that name, and of an actual delivery of the assignment to the partnership so known and designated. *Ib.* An implied license or equitable right to use a patentable improvement, which would be terminated by the issue of a patent to another than the licensor, has been *held*, sufficient to render the licensee incompetent as a witness in interference proceedings, upon the ground of interest, in Cressler *v.* Custer, 1 *MacArthur Pat. Cas.* 216.

The purpose of the provision of Rev. Stat. § 4895—that "patents may be granted, and issued or re-issued to the assignee of the inventor or discoverer, but the assignment must first be entered of record in the patent-office"—is to permit a patent to issue to the person who has the title to the invention upon the records of the patent-office. This purpose is attained when the patent runs to the ultimate assignee of the invention. It is equally well attained when the patent runs to the inventor, or to the inventor's assignee, if, by force of an assignment on record at the time, the grant inures, as soon as the patent issues, to the ultimate assignee. And inasmuch as the grant runs to the grantee named in the patent and his assigns, and operates, therefore, in favor of the ultimate assignee, to convey to him a record title as completely as if he had been named in the patent, and as it is not essential that the grantee named be one who owns the invention when the patent issues, a

patent may be valid when issued to any assignee of record. Nothing in the language of section 4895 or other sections of the patent laws, implies that a patent cannot be properly issued to any assignee whose assignment is duly recorded, when it can be done without impairing the rights of any other person having a paramount title to the invention. Consolidated Electric Light Co. *v.* Edison Electric Light Co., 25 *Fed. Rep'r*, 719 ; 33 *Pat. Off. Gaz.* 1597. See also, Selden *v.* Stockwell Self-Lighting Gas-Burner Co., 19 *Blatchf.* 544 ; 9 *Fed. Rep'r*, 390 ; Read *v.* Bowman, 2 *Wall.* 591 ; U. S. Stamping Co. *v.* Jewett, 18 *Blatchf.* 469 ; 7 *Fed. Rep'r*, 869 ; Perkins *v.* U. S. Electric Light Co., 21 *Blatchf.* 308 ; 10 *Fed. Rep'r*, 513.

In every case where it is desired that the patent shall issue to an assignee, the assignment must be recorded in the patent-office at a date not later than the day on which the final fee is paid. The date of the record is the date of the receipt of the assignment at the office. *Rules of Prac.* No. 200.

80. *When and on what Oath, Executor or Administrator may claim Patent.*

When any person, having made any new invention or discovery for which a patent might have been granted, dies before a patent is granted, the right of applying for and obtaining the patent shall devolve on his executor or administrator, in trust for the heirs at law of the deceased, in case he shall have died intestate ; or if he shall have left a will, disposing of the same, then in trust for his devisees, in as full manner and on the same terms and conditions as the same might have been claimed or enjoyed by him in his lifetime ; and when the application is made by such legal representatives, the oath or affirmation required to be made shall be so varied in form that it can be made by them. *Rev. Stat.* § 4896.

Numerous decisions have recognized the principle established by the statute, that the death of an inventor before a grant of letters patent does not abate or impair his inchoate right, but it passes to

his heirs at law or devisees by a patent to be granted to his administrator or executor, as trustee for the person entitled; and the trust declared by the law is implied from the existence of the facts which create the trust. The principle embraces a renewal or reissue, and while extensions were allowed, included extensions. Woodworth *v.* Wilson, 4 *How.* 712; Wilson *v.* Rosseau, *Id.* 646; Rubber Co. *v.* Goodyear, 9 *Wall.* 788; Washburn *v.* Gould, 3 *Story*, 122; 1 *West. L. J.* 465; 7 *L. Rep'r*, 276; Woodworth *v.* Sherman, 3 *Story*, 171; 7 *L. Rep'r*, 279; Woodworth *v.* Hall, 1 *Woodb. & M.* 248; 5 *Pa. L. J.* 178; Brooks *v.* Bicknell, 3 *McLean*, 250; 1 *West. L. J.* 150; Brooks *v.* Jenkins, 3 *McLean*, 432; S. C., *sub nom.* Brooks *v.* Bicknell, 2 *West. L. J.* 11; Stimpson *v.* Rogers, 4 *Blatchf.* 333. There is no necessity that the patent should in terms declare that it is granted to the representative in trust. Rubber Co. *v.* Goodyear, *supra;* Stimpson *v.* Rogers, *supra.*

81. *Renewal of Application in cases of Failure to pay Fees in season.*

Any person who has an interest in an invention or discovery, whether as inventor, discoverer, or assignee, for which a patent was ordered to issue upon the payment of the final fee, but who fails to make payment thereof within six months from the time at which it was passed and allowed, and notice thereof was sent to the applicant or his agent, shall have a right to make an application for a patent for such invention or discovery the same as in the case of an original application. But such second application must be made within two years after the allowance of the original application. But no person shall be held responsible in damages for the manufacture or use of any article or thing for which a patent was ordered to issue under such renewed application prior to the issue of the patent. And upon the hearing of renewed applications preferred under this section, abandonment shall be considered as a question of fact. *Rev. Stat.* § 4897. See *ante*, §§ 76–78.

VI. ASSIGNMENTS, LICENSES AND OTHER CONTRACTS.

82. *Assignments of Patents.*

Every patent or any interest therein shall be 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 his patent to the whole or any specified part of the United States. An assignment, grant, or conveyance shall be void as against any subsequent purchaser or mortgagee for a valuable consideration, without notice, unless it is recorded in the patent-office within three months from the date thereof. *Rev. Stat.* § 4898.

There are three classes of persons in whom the patentee can vest an interest of some kind in the patent. 1. An assignee: one who has transferred to him in writing the whole interest of the original patent, or an undivided part of such whole interest in every portion of the United States. And no one, unless he has such an interest transferred to him, is an assignee. 2. A grantee: one who has transferred to him in writing the exclusive right, under the patent, to make and use, and to grant to others to make and use, the thing patented within and throughout some specified part or portion of the United States. Such right must be an exclusive sectional right excluding the patentee therefrom. 3. A licensee: one who has transferred to him in writing or orally a less or different interest than either the interest in the whole patent, or an undivided part of such whole interest, or an exclusive sectional interest. Potter *v.* Holland, 1 *Fish. Pat. Cas.* 327.

The monopoly granted by a patent is for an entire right: the right of making, using and vending the improvement. This right may be assigned entire, for a limited territory only, but cannot be split by assignment of the right to use and sell as distinguished from the right to make. Any instrument which purports to transfer only the right to use and sell, reserving to the patentee the right to make, can operate only between the parties and as a license merely. The legal right in the monopoly remains in the patentee, and he alone can maintain suits for an infringement. Sanford *v.* Messer,

1 *Holmes*, 140; Hill *v.* Whitcomb, *Id.* 317; 5 *Pat. Off. Gaz.* 430; 1 *Bann. & A. Pat. Cas.* 34. See *post*, 98.

Upon the question how far in special cases a patent right may be susceptible of subdivision, see Whittemore *v.* Cutter, 1 *Gall.* 429; Brooks *v.* Byam, 2 *Story*, 525; Blanchard *v.* Eldridge, 1 *Wall. Jr.* 337; Suydam *v.* Day, 2 *Blatchf.* 20; Pitts *v.* Hall, 3 *Blatchf.* 201; Parker *v.* Haworth, 4 *McLean*, 370.

Interests in patents may be vested in assignees, in grantees of exclusive sectional rights and mortgagees, and in licensees. 1. An assignee is a transferee of the whole interest of the original patent or of an undivided part of such whole interest, extending to every portion of the United States. The assignment must be written or printed, and duly signed. 2. A grantee acquires by the grant the exclusive right, under the patent, to make and use, and to grant to others the right to make and use, the thing patented, within and throughout some specified part of the United States, excluding the patentee therefrom. The grant must be written or printed, and duly signed. 3. A mortgage must be written or printed, and duly signed. 4. A licensee takes an interest less than or different from either of the others. A license may be oral, or written or printed, and duly signed. *Rules of Prac.* No. 202.

All interests in a patent are assignable in writing, and a purchaser thereof has a right to rely upon the title as appearing from the records of the patent-office. A conveyance by a party of all his property excepting such as is exempt by law from levy and sale under execution, will not pass the title to a patent, though it may operate upon a chose in action for past infringement. Campbell *v.* James, 2 *Fed. Rep'r*, 338; 18 *Blatchf.* 92; 18 *Pat. Off. Gaz.* 1111; 10 *Rep'r*, 103; 5 *Bann. & A. Pat. Cas.* 354.

If a power of attorney is executed for the purpose of providing that a right in a patent may inure to the benefit of another, it is, in a court of equity, equivalent to an assignment, and is not revocable. Day *v.* Candee, 3 *Fish.* 9.

83. *Parties to Assignments.*

Upon the death of a patentee, the title to the patent vests in his personal representatives. Bradley *v.* Dull, 19 *Fed. Rep'r* 913; Pelham *v.* Edelmeyer, 25 *Pat. Off. Gaz.* 292; Hodge *v.* North Missouri R. R., 1 *Dill.* 104. "Legal representatives" in the patent act means executors or administrators. Shaw Relief Valve

Co. *v.* New Bedford, 28 *Pat. Off. Gaz.* 283; 19 *Fed. Rep'r*, 753. An administrator of a patentee may assign the patent which has been renewed in his own name; or grant an interest therein. Brooks *v.* Jenkins, 3 *McLean*, 432; S. C., *sub nom.* Brooks *v.* Bicknell, 2 *West. L. J.* 11.

A married woman, an infant, or a person under guardianship may take a patent as patentee or assignee. In case of an assignment by such a person, all that the United States law requires is that it shall be in writing so as to be recorded, but the capacity to make it must be found in the State law. Fetter *v.* Newhall, 17 *Fed. Rep'r*, 841; 25 *Pat. Off. Gaz.* 502; 16 *Rep'r*, 360.

An assignee in insolvency or a receiver under State laws does not, by virtue of his general assignment or appointment acquire patent rights issued to the assignor. Alger *v.* Murray, 105 *U. S.* 126; Dick *v.* Struthers, 25 *Fed. Rep.* 103. Neither an assignee in insolvency nor a receiver can acquire or pass a title to a patent, except by a written instrument, signed by the owner of the patent and duly recorded. Gordon *v.* Anthony, 16 *Pat. Off. Gaz.* 1135. The title of an insolvent debtor to, or his interest in, letters-patent for an invention, does not pass to his assignee in insolvency. The patent act contemplates a written instrument, signed by the owner of the patent, and duly recorded in the patent-office, as necessary to vest the legal title in the purchaser. *So held*, of an insolvent assignment, made by a judge of probate and insolvency, under the insolvency law of Massachusetts. Ashcroft *v.* Walworth, 1 *Holmes*, 152; 2 *Pat. Off. Gaz.* 546; 5 *Fish. Pat. Cas.* 528. But a court of equity may direct the sale of the interest of an inventor in his patent, in order to satisfy a judgment obtained against him in a court of law (the writ of execution having been returned *nulla bona*), and for that purpose will require the patentee to make an assignment of the patent as provided in Rev. Stat. § 4898; and in the event of the refusal of the patentee to do so, will appoint a trustee with authority to execute the same. Murray *v.* Ager, 1 *Mackey*, 87; s. c. 105 *U. S.* 126. Where a patent has been transferred by the patentee in fraud of his creditors, a creditor's suit may be maintained in a United States circuit court, by a judgment creditor whose judgment was recovered in a State court, to subject the patent right to the payment of his judgment; the citizenship of the parties and the amount in demand being such as to give the circuit court jurisdiction. Gorrell *v.* Dickson, 26 *Fed. Rep'r*, 454.

84. *Requisites and Sufficiency.*

As a general rule, an assignment of an interest in a patent must be in writing, for the reason that such transactions are required to be recorded. Baldwin *v.* Sibyl, 1 *Cliff.* 150. The statute authorizes assignments only in writing, and the legal ownership can be acquired only by written instruments. Jordan *v.* Dobson, 4 *Fish.* 232; 2 *Abb. U. S.* 398. A conveyance of a right under a patent, of a character to create an interest in the patent itself, must be in writing; though a license to make and use a machine need not be in writing, as it need not be recorded, and conveys neither an interest in the patent itself, nor a power authorizing a third person to construct the patented invention. Baldwin *v.* Sibley, 1 *Cliff.* 150.

The execution of an assignment by a corporation and by S., president, was *held*, to be a good execution by S. for his individual interest. Campbell *v.* James, 17 *Blatchf.* 42; 4 *Bann. & A. Pat. Cas.* 456; 18 *Pat. Off. Gaz.* 979. See reversal, 104 *U. S.* 357.

Under the New York statutes, assignments of patents duly acknowledged before a notary are sufficiently proved; the complainant need not prove the signatures of the assignors. Houghton *v.* Jones, 1 *Wall.* 702; New York Pharmical Association *v.* Tilden, 23 *Pat. Off. Gaz.* 272; 14 *Fed. Rep'r*, 740; 21 *Blatchf.* 190. A certified copy of an unacknowledged instrument recorded in the patent-office, purporting to be a duly executed assignment of a patent was *held* in a suit for infringement, sufficient proof of assignment, in the absence of countervaling testimony. Dederick *v.* Whitman Agricultural Co., 26 *Fed. Rep'r*, 763. In general, a certified copy of an assignment from the patent-office is *prima facie* evidence of the genuineness of the original. Lee *v.* Blandy, 2 *Fish.* 89; 1 *Bond*, 361.

Where there is reason to doubt the construction of an assignment, its language should be taken against the grantor, as he is chargeable with any obscurity in this respect. Smith *v.* Selden, 1 *Blatchf.* 475; May *v.* Chaffee, 5 *Fish. Pat. Cas.* 160; 2 *Dill.* 385.

Validity.

An assignment of a patent may be made as well before the issuing of the patent as afterward. The thing to be assigned is not the mere parchment, but the monopoly conferred—the right of property which it creates; and when the party has acquired an

inchoate right, an assignment of it is legal. After the patent has been issued no new assignment is necessary ; the legal right to the monopoly and the property it created is vested by operation of the assignment in the assignee. *So held*, when the assignment has been recorded before the patent issued. Gayler *v.* Wilder, 10 *How.* 477, 493. See *ante*, p. 90.

If an assignment is duly made, the motive for making it is not material. The legal title passes to the assignee, who may maintain suit for infringement without joining the patentee. Siebert Cylinder Oil Cup Co. *v.* Phillips Lubricator Co., 10 *Fed. Rep'r*, 677.

An assignment of all the grantor's interest in certain letters patent, "except a number of counties heretofore conveyed," is not void for uncertainty because the counties reserved are not named. They may be identified by extrinsic evidence, or by averment in pleading not traversed. Washburn, &c. Manuf. Co. *v.* Haish, 4 *Fed. Rep'r*, 900 ; 10 *Biss.* 65 ; 19 *Pat. Off. Gaz.* 173.

An instrument purporting to be an assignment of an expired patent can have no operation as an assignment. Bell *v.* McCullough, 1 *Fish. Pat. Cas.* 280 ; 1 *Bond*, 194.

Delay in making an assignment of a patent after an agreement to sell, is not, of itself, evidence of fraud. Troy Iron, &c. Factory *v.* Corning, 14 *How.* 193 ; rev'g 1 *Blatchf.* 467.

Where a person, feeble in mind and body, and incapable of exercising control over his property, or of managing it in a prudent, careful manner, or of making any contract with reference thereto, was unduly influenced to purchase an interest in a patent-right of doubtful utility, and in consideration therefor to assign notes and a mortgage on real property to the defendant, it was *held* that such assignment was void, and transferred no title to the assignee. Colburn *v.* Van Velzer, 11 *Fed. Rep'r*, 795 ; 3 *McCrary*, 650.

Parol evidence of fraudulent representations in obtaining an assignment of a patent, is admissible to impeach the instrument. Day *v.* New England Car Spring Co., 3 *Liv. L. Mag.* 44.

An assignee of a patent was *held* not relieved from the payment of royalties to his assignor because of alleged fraud in withholding the fact that another patent, afterward adjudged invalid, covered a part of the invention. Shaw *v.* Soule, 20 *Fed. Rep'r*, 790.

86. *What Property of Interest passes.*

A patent is a triple right; it includes to make, to use and to sell, the patented invention. Adams *v.* Burke, 17 *Wall.* 453; Dorsey Rake Co. *v.* Bradley Manuf. Co., 12 *Blatchf.* 202; 1 *Bann. & A.* 330. A patentee may grant to another the right to make, or to make and sell for use here, and retain to himself the exclusive right to make and sell for export, or use in other countries. Dorsey R. H. Rake Co. *v.* Bradley M'f'g Co., *supra.* A patentee has the exclusive right to make, use and vend the device patented, and it is his privilege to grant the exclusive right to make to one person, to use to another, and to vend to another. Steam Stone Cutter Co. *v.* Sheldon, 5 *Fish.* 477; 10 *Blatchf.* 1; Adams *v.* Burke, 4 *Fish.* 392; 1 *Holmes*, 40; 1 *Pat. Off. Gaz.* 282; Bicknell *v.* Todd, 5 *McLean*, 236. A patentee may convey the right to make so as to include the right either to sell or use. He also may convey the right to use so as to imply the right to sell. The circumstances, nature, and terms of each grant must decide the construction. Woodworth *v.* Curtis, 2 *Woodb. & M.* 524. A grant of an exclusive right to make, use, and vend patented articles within certain territory, confers the right to make and vend within said territory for use elsewhere, and any person who manufactures said machines within said territory without the consent of the grantee, infringes his right, although the machines may neither be sold nor used within said district. Jenkins *v.* Greenwald, 2 *Fish. Pat. Cas.* 37; 1 *Bond*, 128. See *ante*, 91.

A deed by a patentee of an invention, conveying all the right, title and interest which he has in the said "invention," as secured to him by letters patent, and also all right, title and interest which may be secured to him from time to time, the same to be held by the assignee for his own use and for that of his legal representatives, "to the full end of the term for which said letters patent are or may be granted," was *held* to carry the entire invention and all alterations and improvements, and all patents whatsoever, issued and extensions alike, to the extent of the territory specified. Railroad Co. *v.* Trimble, 10 *Wall.* 367.

An assignment under a specific patent does not authorize the assignee to use subsequent improvements, although they may have been invented and attached to the original device at the time the transfer was executed. American Hide and Leather Company *v.*

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American Tool & Machine Co., 4 *Fish. Pat. Cas.* 284; 1 *Holmes*, 503.

An assignment by the inventor, of a patent, together with the right to improvements to be subsequently invented or patented, does not include a later patent where the construction and mode of operation are substantially different. Stebins Hydraulic Elevator Mfg. Co. *v.* Stebins, 17 *Pat. Off. Gaz.* 1348; 1 *Fed. Rep.* 445; 5 *Bann. & A. Pat. Cas.* 199.

The sale of an "invention" carries with it the exclusive right to all present or future patents by the same inventor for the particular invention sold. Hammond *v.* Hunt, 4 *Bann. & A. Pat. Cas.* 111.

The inventor is vested by law with an inchoate right to the exclusive use of his device which he may perfect by proceeding as prescribed by law. An assignment of his whole interest is equally within the act, whether made before or after the patent is issued. If made before the issuing of the patent, it transfers the legal title to the assignee, although the patent afterwards issues to the inventor. Gayler *v.* Wilder, 10 *How.* 477; Rathbone *v.* Orr, 5 *McLean*, 131; Rich *v.* Lippincott, 2 *Fish. Pat. Cas.* 1; Herbert *v.* Adams, 4 *Mas.* 15.

Refusal of assignee to perform conditions subsequent, cannot revest the title to the invention in the assignor; his remedy is action for damages. Mallory *v.* Mackaye, 22 *Pat. Off. Gaz.* 915; 12 *Fed. Rep.* 328.

The assignment of a patent does not carry with it a transfer of the right to damages for an infringement committed before such assignment. Moore *v.* Marsh, 7 *Wall.* 515.

Patent standing in the name of one partner, does not pass by assignment of the "firm property." McWilliams Manuf. Co. *v.* Blundell, 22 *Pat. Off. Gaz.* 177.

Two persons owning exclusive patent rights covering different territories, desiring to effect a community of interest in the whole property, conveyed the rights to a third person as trustee, authorizing him to sell rights, grant licenses, &c. It was *held* the legal effect of the instrument was to make the trustee their agent, to carry out their joint instructions. Ladd *v.* Mills, 22 *Blatchf.* 242; 20 *Fed. Rep.* 792.

An assignment of a patent to an assignee in trust, gives him the legal title. Campbell *v.* James, 17 *Blatchf.* 42; 4 *Bann. & A. Pat. Cas.* 456; 18 *Pat. Off. Gaz.* 979, rev'd, 104 *U. S.* 357.

Whether one of two persons holding a patent as trustees, administrators, or the like, can assign it, acting alone, see Barker *v.* Stowe, 11 *Fed. Rep'r*, 303; 22 *Pat. Off. Gaz.* 258; Wintermute *v.* Redington, 1 *Fish. Pat. Cas.* 239. Under a conveyance of the entire legal title to patents to joint trustees, with full power to dispose of them at their discretion, the joint deed of both is required to convey any title to, or interest in, the patents. Westcott *v.* Wayne Agricultural Works, 11 *Fed. Rep.* 208.

87. *Rights of the Parties in other Respects.*

An assignment of an exclusive right to make, use and vend to others a patented machine within a certain territory only, does not prohibit the assignee from selling elsewhere, out of the said territory, the products of such machines. The restriction in the assignment applies solely to the using of the machine, and is no restriction as to place of the sale of the product. Simpson *v.* Wilson, 4 *How.* 709.

An assignee of a patent taking with knowledge of an existing agreement by the assignor licensing others to make and sell the patented article, is bound by such agreement, and may be restrained from violating negative covenants on the part of his assignor contained in it. Hapgood *v.* Rosenstock, 23 *Fed. Rep'r*, 86.

The assignee of all the right, title and interest of the patentee in his invention and patent in a specified territory, without any restriction upon his right to vend in said territory, may, as opposed to the rights of a subsequent assignee for other territory, lawfully sell the patented article within his own territory, without restriction or condition. McKay *v.* Wooster, 2 *Sawyer*, 373; 3 *Pat. Off. Gaz.* 441; 6 *Fish. Pat. Cas.* 375; 6 *Am. L. T.* 169.

A grantee for a specified territory cannot be restrained from advertising and selling within it merely because the purchasers may take the patented articles outside. Hatch *v.* Hall, 30 *Pat. Off. Gaz.* 1096; 22 *Fed. Rep.* 438.

The sale of a patent-right creates an implied warranty as to title, growing out of the sale itself, and draws to it any after-acquired right of the warrantor. Even if the patent be invalid, the warrantor may be estopped from using the thing sold, within the territory for which he sold his alleged right. Faulks *v.* Kamp, 3 *Fed. Rep'r*, 898; 17 *Blatchf.* 432; 17 *Pat. Off. Gaz.* 851; 9 *Rep'r*, 304; 5 *Bann. & A. Pat. Cas.* 73. The assignee of a patent has

the right, as against the assignor, to manufacture under the patents though it be void as to the rest of the world ; and cannot be precluded, by reason of an older patent, control of which is procured by the assignor, from exercising his rights under the assignment. Curran *v.* Burdsall, 20 *Fed. Rep'r*, 835. The warranty of title to a patent, or the right to a warranty, draws to it any after-acquired right or title of the warrantor. *Ib.*

Assignees of a patented invention are not concluded or estopped by the statement made by their assignor, in his application for the patent, of the date of his invention, from proving (on a question of interfering patents) that the true date was earlier. Union Paper Bag Machine Co. *v.* Crane, 1 *Holmes*, 429 ; 6 *Pat. Off. Gaz.* 801. A license to use a patent contained a provision that it should not be transferred without the consent of the licensor. It appeared that after an assignment, without consent, the assignee of the licensor made a settlement and received royalties from the assignees. It was *held*, the assignee was estopped from urging the invalidity of the transfer. Bloomer *v.* Gilpin, 4 *Fish. Pat. Cas.* 50. If one of several joint patentees assigns to a third person, the estoppel on the assignor works a license to the assignee to use the patent, and the joint owners must look to the one who assigned, for an accounting. Curran *v.* Birdsall, 20 *Fed. Rep'r*, 835. One of two owners in common of two patents, one of which was for an improvement on the other, granted his interest in the later patent to his associate, in consideration of the latter's assignment to him of the earlier patent. It was *held*, that he who thus became sole owner of the earlier patent was estopped from claiming that the later one was an infringement upon it. Rumsey *v.* Buck, 20 *Fed. Rep'r*, 697. The assignee of a patent stands in full privity to a decree for infringement obtained by the assignor (Dayton *v.* Wright, 11 *Pat. Off. Gaz.* 197) ; and is estopped by one which binds his assignor. Pennington *v.* Hunt, 20 *Fed Rep'r*, 195.

The legal title to a patent will prevail over the equitable title, unless the rights of the holder of the legal title were acquired with notice of the equities of the one in whom the equitable title was. Davis Improved Wrought-iron Wagon Wheel Co. *v.* Davis Wrought-iron Wagon Co., 20 *Fed. Rep'r*, 699.

One who took an assignment of the rights in litigation of a defendant in an action for violating a patent, pending an application for an injunction, was *held*, to have no other or higher

rights than his assignor, and not to be entitled to be deemed an independent infringer. Parkhurst *v.* Kinsman, 2 *Blatchf.* 78.

An assignment of all interest in a patent, was *held* to have dissolved the partnership for working it. Parkhurst *v.* Kinsman, 1 *Blatchf.* 488 ; 8 *N. Y. Leg. Obs.* 146.

Where an assignment of a right under a patent refers to the patented improvement as being in use by a certain party, such reference is express information to the assignee of the fact of such use; and, the party referred to being in possession to the extent of such use, such possession is constructive notice of the claim of right under which the possession and use are had. Prime *v.* Brandon Manuf. Co., 16 *Blatchf.* 453 ; 4 *Bann. & A. Pat. Cas.* 379.

No guaranty of title is binding against the setting up of unfounded claims. *So held* of a patent. Shaw *v.* Soule, 20 *Fed Rep'r*, 790.

Where, through several assignments, an individual becomes the owner of a number of distinct patents, his rights are no greater than those of his assignors respectively. Washburn, &c. Manuf. Co. *v.* Griesche, 16 *Fed. Rep'r*, 669.

When a patent has been assigned upon condition of re-assignment under certain contingency, the court will decree a re-transfer when the contingency arises. Andrews *v.* Fielding, 20 *Fed. Rep'r*, 123.

88. *Illustrative Cases determining Rights under Particular Assignments.*

An assignment expressed to run "to the full end of the term for which letters patent are or may be granted," includes reissues, renewals, and extensions. Railroad Co. *v.* Trimble, 10 *Wall.* 367 ; Ruggles *v.* Eddy, 5 *Fish. Pat. Cas.* 581 ; 10 *Blatchf.* 52 ; Thayer *v.* Wales, 5 *Fish.* 448 ; Phelps *v.* Comstock, 4 *McLean*, 353 ; Case *v.* Redfield, 4 *McLean*, 526 ; Gear *v.* Holmes, 6 *Fish.* 595 ; Emmons *v.* Sladdin, 9 *Pat. Off. Gaz.* 352 ; 2 *Bann. & A. Pat. Cas.* 199; Goodyear *v.* Cary, 4 *Blatchf.* 271.

An assignment of a re-issued patent, transferring to the assignee all the right, title and interest which the patentee has "in the said invention and letters patent," &c., was *held*, to transfer an extension and renewal notwithstanding the patent was reissued subsequently to the assignment. Nicholson Pavement Co. *v.* Jenkins, 4 *Wall.* 452.

T. transferred to S. all his right, title and interest in a patent, and afterward transferred to D. all his right, title and interest in the same patent. Subsequently S. transferred to T. all the interest T. had conveyed to him. It was *held*, that D. acquired nothing by the transfer to him, and that such transfer to T. did not inure to the benefit of D. so as to perfect his title. Perry *v.* Corning, 7 *Blatchf.* 195.

A. and B., general owners of a patent, except for certain counties in Michigan, united with C., the owner of those counties, in appointing B., their attorney and agent, to sell the patent improvement in whole or in part. In a conveyance of a right to manufacture and sell in Chicago, Ill., the agent signed the names of A. and B., but not C. It was *held*, that C. had no interest in the territory conveyed, and that he need not join in the grant. May *v.* Chaffee, 5 *Fish. Pat. Cas.* 100.

An agent employed to sell, having secretly purchased from the owner, and afterward sold the invention at considerable advance, is deemed a trustee for the principal as to the surplus realized, and he cannot re-acquire the rights and compel his employer to accept them. Jeffries *v.* Wiester, 2 *Sawyer*, 135.

D. applied, in August, 1866, for a patent for a hand-mirror, and at the same time for a patent for "a brush in which the bristles are inserted through a perforated plate, or holder, imbedded in a composition or cement of any suitable substance, as described, which cement shall, in common with a base-piece and stiffener of metal, or other material, form the back and handle of the brush, substantially as specified." The back of the hand-mirror, for which a patent was applied, was to be substantially of the same construction as the back of the brush. While the applications for both patents were pending, D. assigned to a corporation all his inventions "in the manufacture of composition brush-backs and handles, with suitable strengtheners," and all applications for a patent "therefor," and certain apparatus, used by him "in said manufacture," with all his useful information "for making and selling said composition brush backs and handles," "meaning hereby to transfer" all his rights "to the manufacture and sale of said composition brush-backs and handles." It was *held*, that this was only an assignment of the brush-back, and of the application for the brush patent, and did not carry a right to the invention of the hand-mirror. Clark *v.* Scott, 5 *Fish. Pat. Cas.* 245.

The expression "right, title, and interest" contained in an

assignment from a person holding under the patentee, is enough to put the assignee on inquiry, and to charge him with notice of what such inquiry, if made of the first grantor, would have disclosed. Hamilton *v.* Kingsbury, 17 *Pat. Off. Gaz.* 847; 5 *Bann. & A. Pat. Cas.* 157; 17 *Blatchf.* 460; 4 *Fed. Rep.* 428.

S. and E., patentees, executed an agreement, sale and grant to B. of "the said invention and letters-patent or extensions to be hereafter obtained on account of said invention," and containing certain convenants and agreements of quiet enjoyment of all rights under the patent so assigned, and not to make or sell, or cause to be made or sold any other machine for the purpose to which such patented machine was applicable. Subsequently S. and L. took out a patent and obtained a reissue thereof for inventions of the same character and purpose of that described in the sale or assignment to B., and brought suit against the plaintiffs herein, who were the purchasers and assignees of B.'s interest. It was *held*, that the title of S. and L. must be held to be only in trust for B. and his assigns, so far as the letters-patent of the United States embraced any inventions made by S. before the conveyance to B. and incorporated in the agreement of sale and grant to B. by S. and E. Emmons *v.* Sladdin, 9 *Pat. Off. Gaz.* 352.

A patentee granted to V. the exclusive right to construct and use and vend within a certain territory, ten *planing, tongueing and grooving* machines, and the grant declared that V. was to enjoy an exclusive use of the patent within said territory, limited to said ten machines; and afterward the patentee granted to K. the exclusive right under the patent of making, using and vending, within the same territory, *moulding planing machines.* It was *held*, that the grant first made to V. conveyed the entire interest of the patentee, and that the subsequent grant to K. was void. Ritter *v.* Serrell, 2 *Blatchf.* 379.

An inventor caused a patent to be granted to himself and two others under an agreement to that effect, and that they should have the exclusive right to manufacture and sell, until the patent expired. Later, he caused a patent to issue to himself alone, and afterward assigned it to the complainant. It was *held*, that the legal title to the last-mentioned patent was in the complainant. Graham *v.* McCormick, 5 *Bann. & A. Pat. Cas.* 244.

An assignment of a patent, paid for partly in cash and partly by several notes, contained a condition that the assignment should be void if the assignee failed to pay any one of the notes within ten

days after it was due. It was *held*, that a failure to pay a number of the notes last due worked a forfeiture of the assignment, so as to make a license granted by him after such failure void. Abbett *v.* Lusi, 5 *Bann. & A. Pat. Cas.* 38; 3 *N. J. L. J.* 47.

The sale by a patentee, for a term of years, of the exclusive right in a patent, reserving certain shop-rights, does not debar him from bringing suit against a third party for infringement, as he has a beneficial interest in the right secured by the patent. Still *v.* Reading, 20 *Pat. Off. Gaz.* 1025; 9 *Fed. Rep'r*, 40; 4 *Woods*, 345.

89. *Recording.*

For the statute on this subject, see *ante*, pp. 93, 94.

No instrument will be recorded which does not, in the judgment of the commissioner, amount to an assignment, grant, mortgage, lien, incumbrance or license, or affect the title of the patent or invention to which it relates. *Rules of Prac.* No. 204.

Assignments which are made conditional on the performance of certain stipulations, as the payment of money, if recorded in the office, are regarded as absolute assignments, until canceled with the witten consent of both parties, or by the decree of a competent court. The office has no means of determining whether such conditions have been fulfilled. *Id.* 205.

The receipt of assignments is not generally acknowledged by the office. They are recorded in regular order as promptly as possible, and then transmitted to the persons entitled to them. *Id.* 207.

An assignment to an assignee in bankruptcy, of all patents owned by the bankrupt, is not required to be recorded. Rev. Stat. § 5046, vests patent-rights at once in the assignee. Prime *v.* Brandon Manuf. Co., 4 *Bann. & A. Pat. Cas.* 379; 16 *Blatchf.* 453.

As between the parties, recording is not necessary. The effect of the statute is that as against a subsequent purchaser from the patentee, for a valuable consideration, acting in good faith and without notice, the assignment, if unrecorded for three months from the time when it was made, is invalid. Perry *v.* Corning, 7 *Blatchf.* 195; Hall *v.* Speet, 1 *Pittsb.* 513; 6 *Pitts. Leg. J.* 403.

But an unrecorded assignment of all the grantor's right, title, and interest, in and to a certain patent, is good as against a subse-

quent recorded assignment made by the same grantor to a purchaser having notice of the previous assignment. Ashcroft *v.* Walworth, 1 *Holmes*, 152 ; 2 *Pat. Off. Gaz.* 546 ; 5 *Fish. Pat. Cas.* 528. So an agreement which operates as a transfer of a patent is good as against the patentee and those who purchase with notice, though not recorded. Continental Windmill Co. *v.* Empire Windmill Co., 4 *Fish.* 428 ; 8 *Blatchf.* 295. The subsequent assignment may, by its mere terms, give notice of a prior one ; thus it has been held that a conveyance of "all my right, title, and interest in and to" a patent, though properly recorded, does not include the right for territory covered by a prior conveyance, although the prior conveyance was not recorded in the patent-office. Turnbull *v.* Weir Plow Co., 14 *Fed. Rep'r*, 108 ; 9 *Biss.* 334 ; 23 *Pat. Off. Gaz.* 91 ; 5 *Bann. & A. Pat. Cas.* 288. A purchaser has the right to rely upon the apparent record title, so long as he acts in good faith; he must, however, have parted with a consideration large enough to make it inequitable for him to be required to give up the property to one who has not the apparent legal title, and this consideration should be set forth in amount, in a plea setting forth the title. Seconbe *v.* Campbell, 2 *Fed. Rep'r*, 357 ; 18 *Blatchf.* 108 ; 9 *Rep'r*, 708 ; 5 *Bann. & A. Pat. Cas.* 429.

The term of three months is merely directory ; any subsequent recording of an assignment of a patent will suffice to vest the assignee with title except as to intermediate *bona fide* purchasers without notice. Pitts *v.* Whitman, 2 *Story*, 609 ; Brooks *v.* Byam, 2 *Story*, 525 ; Boyd *v.* McAlpin, 3 *McLean*, 427 ; Case *v.* Redfield, 4 *McLean*, 526. And with respect to the assignment of an invention, recording at any time before the issuing of the patent is sufficient. Gay *v.* Corneil, 1 *Blatchf.* 506.

With respect to an assignee's right to maintain suit, it is not complete until he has recorded his assignment. Wyeth *v.* Stone, 1 *Story*, 273. But the fact that the recording does not take place till after suit commenced does not defeat the suit. Pitts *v.* Whitman, 2 *Story*, 609. And a conveyance, made after the patent has expired, of the mere right to sue for infringements which were committed during its lifetime does not need recording. Gear *v.* Fitch, 16 *Pat. Off. Gaz.* 1231.

The statute as to recording assignments does not extend to licenses (Brooks *v.* Byam, 2 *Story*, 525 ; Chambers *v.* Smith, 5 *Fish. Pat. Cas.* 12 ; Farrington *v.* Gregory, 4 *Id.* 221) ; and a purchaser of the right granted by one such, which is recorded, takes

subject to others which may have been executed cotemporaneously with it, but were not recorded. Hamilton *v.* Kingsbury, 17 *Blatchf.* 264 ; 17 *Pat. Off. Gaz.* 147; 4 *Bann. & A. Pat. Cas.* 615.

90. *What is a License.*

A license is the mere right to use the invention ; and is neither an assignment nor a grant within the meaning of Rev. Stat. § 4928. Wooster *v.* Seidenburg, 10 *Pat. Off. Gaz.* 244. The transfer only of a right to use and vend the invention for limited purposes in specified places, is not a transfer of an undivided part of an entire patent, and the transferee is merely a licensee. Gamewell Fire Alarm Co. *v.* Brooklyn, 14 *Fed. Rep'r*, 255 ; 22 *Pat. Off. Gaz.* 1979 ; 15 *Rep'r*, 40. The construction and use of a device, with consent of the inventor, before application for patent, operates as a special license to continue to use the specific thing. Magoun *v.* N. E. Glass Co., 3 *Bann. & A. Pat. Cas.* 114. While employment to invent and perfect machinery for a particular purpose will operate as a license to the employer, it will not of itself confer upon the employer any legal title to the invention or to the letters patent protecting it. Whiting *v.* Graves, 3 *Bann. & A. Pat. Cas.* 222 ; 13 *Pat. Off. Gaz.* 455 ; Wilkens *v.* Spafford, 3 *Bann. & A. Pat. Cas.* 274 ; 13 *Pat. Off. Gaz.* 675.

An agreement by which a patentee conveys to a grantee the exclusive right to make and vend the thing patented, within a certain territory, reserving to the grantor the right to make and sell within the same territory, is not an assignment of an exclusive interest in the patent, but is only a license. Gaylor *v.* Wilder, 10 *How.* 477. S. P., Sanford *v.* Messer, 2 *Pat. Off. Gaz.* 470 ; 5 *Fish. Pat. Cas.* 411 ; Theberath *v.* Celluloid Manuf. Co., 3 *Fed. Rep'r*, 143 ; 10 *Rep'r*, 326 ; 5 *Bann. & A. Pat. Cas.* 597.

An exclusive right to use, within a specified territory, a patented acid in making self-raising flour, and to use and sell the flour so made within such territory, was *held*, (under 5 Stat. 121, §§ 11, 14, in force at the time the right was granted), to be a mere personal license, and not an assignment or grant of an exclusive right which would go to executors, administrators or assigns, in the absence of express words showing an intent to so extend it. [Citing 10 How. 477, 494 ; 13 How. 193, 416 ; and distinguishing 10 Heisk. 322.] Oliver *v.* Rumford Chemical Works, 109 *U. S.* 75.

A patentee, in consideration of weekly payments, assigned and

released all his right, title and interest in the patent, so far only as to include the exclusive right of manufacturing and vending for a term of years; and stipulated that in case of default of payment the patentee should have the right to claim and take back the interest. It was *held*, that this agreement conveyed no interest in the patent right, but amounted to a mere license with a limitation or condition as to its continuance. Armstrong *v.* Hanlenbeck, 3 *N. Y. Leg. Obs.* 43.

Where A. erected, on his own premises and at his own expense, a machine, the invention of B., and B. then leased the machine of A. for a term of years, covenanting to deliver the same to A. at the end of the term, it was *held*, that this amounted to a license or a consent in writing (under the patent act of 1790, § 4), to use the machine after the end of such term. Keutgen *v.* Kanowrs, 1 *Wash.* 168.

91. *Presumption or Proof of a License.*

Licenses are not required to be in writing, neither need the amount of fee be shown by writing; the whole may be shown by parol. Wooster *v.* Simonson, 28 *Pat. Off. Gaz.* 918; 20 *Fed. Rep'r*, 317.

If an employer has any right to the invention made by an employé during the period of his employment, it is a mere naked license to make and sell the patented improvement as a part of his business, and is not transferable. Hopgood *v.* Hewitt, 21 *Pat. Off. Gaz.* 1786; 11 *Biss.* 184; 11 *Fed. Rep'r*, 422.

If a person employed in the manufactory of another, whilst receiving wages, makes experiments at the expense and in the manufactory of his employer, has his wages increased in consequence of the useful result of the experiments, makes the article invented, and permits his employer to use it, no compensation for its use being paid or demanded, and then obtains a patent, these facts will justify a presumption of a license to use the invention. McClure *v.* Kingsland, 1 *How.* 202.

A patentee knowingly and for a considerable time acquiesced in the use of his patented machine by another who had previously constructed and used the same by his permission, and actually and voluntarily accepted a compensation for such use from the person in possession, as just payment for such use. It was *held*, that these acts of the patentee were evidence from which a license might

be inferred, unless controlled by the circumstances. Blanchard *v.* Sprague, 1 *Cliff.* 288.

An exclusive license for the use of certain patented machinery, invented and constructed during the term of service, results to an employer where the workman agreed to give the employer the exclusive benefit of his inventive faculties, and of such inventions as he should make in a particular class of machinery during the period of employment. Wilkins *v.* Spafford, 13 *Pat. Off. Gaz.* 675. So, too, an agreement that the employer shall have the exclusive benefit of the workman's service in making machinery and improvements in the employer's premises, operates to license the use of machinery perfected and constructed, or in course of construction, during the term of service, although it had actually been invented and patented by the workman prior to such service. *Ib.*

B., being in the employ of the Empire Windmill Co., contracted with them that he was to receive from them five hundred dollars for any patentable improvements which he might make; and afterward made such improvements, and obtained a patent therefor in his own name. It was *held*, that, by virtue of the contract, the Empire Windmill Co. acquired, and had, an equitable if not legal right to use the improvements. Continental Windmill Co. *v.* Empire Windmill Co., 8 *Blatchf.* 296; 4 *Fish. Pat. Cas.* 428. B. also attempted a clandestine transfer of the improvements to one of the officers of the Empire Windmill Co., for the private benefit of B. and such officer. It was *held*, that such transfer was fraudulent as to the company, and no less so because a court of chancery would decree that such officer held as trustee for the company's use; and further, that as the suit was brought in equity, the fact that the defendant had an equitable, not a legal right to use the improvement, was not material. An equitable title is just as good as a legal title, as to matters within the jurisdiction of a court of equity. *Ib.*

A patentee, while in defendants' employment, made certain experiments at their expense, for the results of which he subsequently obtained a patent. Before this, a contract was made between patentee and defendants for the manufacture for defendant of a certain number of articles afterwards so patented, and the transfer to defendants of the tools used in their manufacture. It was *held*, that from these facts a license to the defendants to continue the manufacture after patent must be conclusively presumed. Chabat *v.* American Button-hole, &c. Co., 9 *Phila.* 378; 16 *Int. Rev. Rec.* 164.

One who sold a machine containing a patented invention warranted the title to it and the right to use it. He afterward acquired a part interest in the letters patent. It was *held*, that the sale, so far as he was concerned, operated as a license to the vendee to use the machine. Gottfried *v.* Miller, 104 *U. S.* 521; aff'g 10 *Fed. Rep'r*, 471.

Payment by a partnership of the expenses of perfecting, procuring and sustaining a patent issued to a partner, the inventor, for which the firm was fully reimbursed by the profits from its use, was *held*, not to give rise to a license to another partner to use it after dissolution of the partnership. Keller *v.* Stolsenbach, 20 *Fed. Rep'r*, 47; 27 *Pat. Off. Gaz.* 209.

A decree for nominal damages in a suit for infringement of a patent against the manufacturer of infringing machines, does not operate as a license to the manufacturer or his vendee as to all existing infringing machines made by the manufacturer. Blake *v.* Greenwood Cemetery, 25 *Pat. Off. Gaz.* 89; 16 *Fed. Rep'r*, 676.

92. *Construction.*

A licensee who is authorized to use two machines constructed according to the patent, may use two at all times, whether constructed by himself or another. Burr *v.* Duryee, 1 *Wall.* 531; 2 *Fish. Pat. Cas.* 275.

A license to use an invention by a person only at "his own establishment," does not authorize a use at an establishment owned by himself and others. Rubber Co. *v.* Goodyear, 9 *Wall.* 788; aff'g 2 *Cliff.* 351; 2 *Fish. Pat. Cas.* 499.

Where defendants held a license under complainant's patent, granting them "the right, license and privilege to manufacture and vend landau carriages, with the said invention attached," containing the provision that "the right, privilege and license hereby granted, are not, nor is any part of the same, to be transferred or assigned, or in any manner imparted to any other person or persons whatsoever; but they shall be exercised solely and only by the licensees personally, or by workmen in their employment, in their own manufactory or manufactories, warehouse or warehouses;" and the further provision, "nor shall this license authorize or empower said licensees to sell, exchange, or in any manner dispose of any part, parts, or portions of carriages with, or fitted or adapted for, the said invention, otherwise than in a finished state, and ready for market;'

it was *held*, that these restrictions do not prohibit defendants from procuring the patented fixtures to be made wherever they can be manufactured, and still less do they prohibit them from sending fixtures, already cast, to another establishment to be finished. Wood *v.* Wells, 6 *Fish. Pat. Cas.* 382. Such a license does not, indeed, grant the right to deal in the fixtures, as general merchandise. If they are sold apart from the carriage, there is an infringement on the patent, but such sale does not work a forfeiture of the license. *Ib.*

Where a person is enjoined from infringing a patent, and instead of contesting the validity of the patent and moving for a dissolution of the injunction, renews a license formerly had to use the patent such renewal will not be regarded as made under duress, and will be binding upon him. McKay *v.* Zackman, 17 *Fed. Rep'r*, 641; 24 *Pat. Off. Gaz.* 1177; 16 *Rep'r*, 163.

Where a machine is licensed for use in a particular territory, the use of it, by subsequent purchasers, in territory other than that for which it is licensed, is unlawful. The mere fact that the agent of the patentee, after the transfer of the machine to the unlicensed territory, demands of the purchasers the back royalties due upon it, confers no right to use it outside of the territory named in the license. Wicke *v.* Kleinknecht, 7 *Pat. Off. Gaz.* 1098; 1 *Bann. & A. Pat. Cas.* 608.

A license granting the right to use a patented invention, only upon the payment of a specific sum on each machine upon which the invention is used, will not include other machines where the same invention is used, unless the same is paid for in accordance with the terms of the license. Wooster *v.* Seidenburg, 10 *Pat. Off. Gaz.* 244.

A grant of a full and exclusive right to "use and sell" a patented invention within a limited territory, contained a reservation of a right (but not an exclusive right) in favor of the grantor, to "make." It was *held*, that giving the grantees a right to make must have been intended, because, 1, if the invention could not be made except at the will of the grantor, the granted right to use and sell would be worthless; and 2, if the right to make did not otherwise pass from the grantor, the reservation of a right to him to make was nugatory. Hamilton *v.* Kingsbury, 15 *Blatchf.* 64; 14 *Pat. Off. Gaz.* 448; 3 *Bann. & A. Pat. Cas.* 346.

W., the patentee of inventions in steam stone-cutting machines, granted to a corporation "the right to use said patented machine,

or any number of said machines," in its quarry at S. C. succeeded to the rights of W., and another corporation to the rights of the corporation grantee, in the quarry. D. was making a machine embodying the patented inventions, for the new corporation, for use in said quarry, and C. sought to enjoin D. from making such machine. It was *held*, that the grant conveyed the right to make machines for said use, including the right to procure them to be made, and covered the making of them by the person procured to make them. The foundation of this construction is the presumed intention of the grantor to make his grant effectual. Steam Stone Cutter Co. *v.* Shortsleeves, 16 *Blatchf.* 381; 4 *Bann. & A. Pat. Cas.* 364.

A license to use a patented invention upon the locomotives used by a railroad company on its road, or on "any road or roads now owned or that may hereafter be owned or operated by said company," was *held* to embrace not only locomotives in use at the date of the license upon roads then owned and operated by the company, but also such other locomotives as it might thereafter use and other roads which it might thereafter operate. Mathew *v.* Pennsylvania R. Co., 8 *Fed. Rep'r*, 45; 27 *Int. Rev. Rec.* 234; 12 *Rep'r*, 264.

Where a railroad fifty-eight miles long, having a license to use a patented improvement, subsequently acquired, by consolidation and change of name, two hundred and ten miles more, it was *held*, that the license did not extend to or protect the newly-acquired portion. Emigh *v.* Chicago, Burlington, &c. R. R. Co., 2 *Fish. Pat. Cas.* 387.

An agreement to pay license fees for the use of machinery under patents during the continuance of their terms, and each of them, was contrued to mean during the term of every one of them, till the last expired. Potter *v.* Berthelet, 20 *Fed. Rep'r*, 240.

A license giving the right of manufacturing under any patent the licensee might obtain by or through his application then filed, was *held* to cover the patent issued in accordance with the claims as modified by the requirement of the commissioner of patents. Kelly *v.* Porter, 17 *Fed. Rep'r*, 519; 8 *Sawyer*, 482.

The words "licensed to use once only," stamped upon each article, were held to have imparted notice that there was a restriction in the use. American Cotton Tie Supply Co. *v.* Bullard, 17 *Pat. Off. Gaz.* 389.

Where both parties to a license have acted upon a certain construction of an ambiguous document, that construction, if in itself

admissible, will be adopted by the court. Foster *v.* Goldschmidt, 28 *Pat. Off. Gaz.* 915; 22 *Blatchf.* 287; 21 *Fed. Rep.* 70.

A license granted the right to use a machine embodying the invention contained in a patent particularly described, and other patents which the licensor had or might obtain, applicable to said machine, for the term of the existence of said patents or any of them, and of all renewals and extensions of the same. It was *held*, that the license continued in force until the expiration of the term of the youngest patent embodied in the machine. McKay *v.* Mace, 23 *Fed. Rep'r*, 76.

93. *Validity and Obligations.*

A license to make, use and sell a patented invention, within a specified territory, by mutual mistake not made exclusive, which mistake the licensor offered to correct, was *held* to be a valid contract, binding upon the licensee so as to make him liable for royalties under it, and not to be set aside as for a failure of consideration; no loss to the licensee having been shown from the defect. Laver *v.* Dennett, 109 *U. S.* 90.

Enlarging one's factory and business carried on under a license to use a number of patented machines does not increase his liability for royalty if the number of the machines used is not increased. England *v.* Thompson, 3 *Cliff.* 271.

A corporate body gave the plaintiffs an exclusive license to sell machines, embodying inventions of which it held the patents, and agreed to furnish the machines at a stipulated price. It was *held* that the company might be prohibited from taking measures to dissolve its organization; and that its assignee of the patents in trust for a new association, should be forbidden to dispose of them. Singer Manuf. Co. *v.* Union Buttonhole, &c. Co., 4 *Pat. Off. Gaz.* 553.

No one can justify making and selling a patented article under a license from the patentee, after he has repudiated the license, and refused to pay the stipulated royalty; and one who purchases from such licensee, with knowledge of his having renounced the contract, will also be liable for the sale of the articles he purchases, as well as for sale of those he makes afterward. Moody *v.* Tabor, 5 *Pat. Off. Gaz.* 273.

A license to use a patent was granted in consideration of notes given by the licensee; with an agreement that if the notes were

not paid, the license should be void. It was *held*, optional with the grantor to enforce the collection of the notes, or treat the rights of the licensee as forfeited under the stipulation. Woodworth *v.* Weel, 1 *Blatchf.* 165.

Unless there has been an eviction or its equivalent, the royalties agreed to be paid by a licensee for the use of a patent, must be paid; even though he has signed the license without reading it, he is bound by its terms, unless he lacked capacity to comprehend what he was doing. *Ib.*; McKay *v.* Yackman, 17 *Fed. Rep'r*, 641; 24 *Pat. Off. Gaz.* 1177; 16 *Rep'r*, 163.

An exclusive license to use a patented invention, in a specified city, during the term of the patent, has been *held* liable, in equity, to be subject to sale for the payment of a judgment debt. Matthews *v.* Green, 19 *Fed. Rep'r*, 649.

Under a contract giving a license to use a patent on certain conditions, it has been *held*, that the licensee might be enjoined from using the patent beyond the limits fixed by the contract, and from using it at all except on performance of the conditions; and that a breach on the part of the licensor was not an excuse for non-payment of the tariff. Brooks *v.* Stolley, 3 *McLean*, 523; 2 *West. L. J.* 390.

Inasmuch as joint patentees are tenants in common of the right, a license signed by only one of them clothes the licensee with the right to use it; and the licensee cannot refuse a tender of such a license, and defend an action for the royalty on the ground that another or others have not signed it. Dunham *v.* Indianapolis & St. Louis R. R. Co., 7 *Biss.* 223; 2 *Bann. & A. Pat. Cas.* 327.

94. *Estoppel, arising from a License.*

If a licensor seeks to set aside a license on account of a breach of contract, the defendant is not estopped from denying the validity of a patent by the recitals in the contract. Burr *v.* Duryee, 1 *Wall.* 531; 2 *Fish. Pat. Cas.* 275;

When parties have, after long negotiation, with full opportunities for knowing what they are doing, entered into contracts for the use of inventions covered by rival patents, and no fraud or imposition is alleged, the case of a party sued upon such a contract must be very clear to establish as a defense the invalidity of the patent for which he has agreed to pay a royalty. Eureka Co. *v.* Bailey Co., 11 *Wall.* 488. And when such a party has furnished,

under the contract, a model of the machine which he proposes to make, on which he agrees to pay a royalty, he cannot deny that such machine contains matter covered by the patent, unless he alleges and proves circumstances which would set aside the contract for fraud, mistake, or surprise. *Ib.*

The owners of a patent are estopped from prosecuting those who have worked the invention under a license from a third party, relying upon the admission of the owners that such third party had the right to grant such license. Whether such admission can avail the respondents, will depend on whether the acts relied on to prove infringements were after, and in consequence of these admissions, and before they had notice that they were recalled and withdrawn. Gear *v.* Grosvenor, 1 *Holmes*, 215; 3 *Pat. Off. Gaz.* 380; 6 *Fish. Pat. Cas.* 314.

Selling goods manufactured under a license is a recognition or admission of title in the licensor; and the licensee cannot dispute the validity of the patent, by way of defense to an action of covenant for the recovery of royalties. Wilder *v.* Adams, 2 *Woodb. & M.* 329; Sargent *v.* Larned, 2 *Curt.* 340. Not so, however, of selling goods which defendant had on hand when the patent was obtained. White *v.* Harris, 3 *Fed. Rep.* 161; 5 *Bann. & A. Pat. Cas.* 571.

Licensees are entitled, if they fulfill the stipulations of their licenses, to practice the invention within the terms and conditions of the instrument, to the extent of the authority conferred, without question or impediment by the owner of the patent; but if they refuse to perform on their part, deny the validity of the patent, and repudiate the license and title of the licensor, he may have his remedy by suit upon the license, or he may elect to treat them thenceforth as infringers of his exclusive rights under the patent. Being infringers, they cannot set up the license in defense of a suit any more than if they had never possessed any such authority. Colm *v.* National Rubber Co., 15 *Pat. Off. Gaz.* 829; 5 *Bann. & A. Pat. Cas.* 568.

For a licensee to take a license to use an unlimited number of machines for a limited period, is a waiver of any prior right which he may have had, even though the license was taken under a mistake of law. Wooster *v.* Taylor, 12 *Blatchf.* 384; 8 *Pat. Off. Gaz.* 644; 1 *Bann. & A. Pat. Cas.* 594.

If a license contains a covenant on the part of the licensee which implies the validity of the patent, and if he has had the enjoyment of the license, he is estopped from impeaching the

patent. Magic Ruffle Co. *v.* Elm City Co., 13 *Blatchf.* 151; 8 *Pat. Off. Gaz.* 773; Birdsall *v.* Perego, 5 *Blatchf.* 251.

L. sued J. in equity for infringing a patent. J. set up, by plea, that in June, 1875, L. sued T. for infringing the same patent; that T. was a licensee under a patent granted to W. before the patent to L. was granted, which embodied the improvement described in the patent to L.; that W. assumed the defense of that suit; that it was therein adjudged that W. was the first inventor, and that the patent to L. was void of want of novelty; and that J. was a licensee of W., under a license granted in October, 1874, and was making the article described in the patent to W. The fact that the license was granted before the judgment was rendered was *held*, to be alone sufficient to prevent the judgment from operating as an estoppel against the plaintiff. Ingersoll *v.* Jewett, 16 *Blatchf.* 378; 9 *Rep'r*, 105; 4 *Bann. & A. Pat. Cas.* 361.

An assignor of a patent, who agrees to stop manufacturing the patented machines, and pays a license fee to his assignee for the privilege of selling machines he has on hand, is estopped from denying its validity, in a suit against him by the assignee for its infringement by manufacture and sale under letters patent issued subsequent to the assignment. Consolidated Middlings Purifier Co. *v.* Guilder, 9 *Fed. Rep'r*, 155; 3 *McCrary*, 186. And execution and acceptance of a written license, was *held*, under the circumstances, to estop the licensor from recurring to the prior parol agreement, and the licensee from impeaching the validity of the patent, in Evory *v.* Candee, 17 *Blatchf.* 200; 4 *Bann. & A. Pat. Cas.* 545. But defendants are not estopped from denying infringement, by reason of having formerly acted under a license from complainant, which has expired. Blatherwick *v.* Carey, 9 *Fed. Rep'r*, 202; 10 *Biss.* 484; 27 *Int. Rev. Rec.* 361. And an offer to take a license from a patentee to use his invention does not take away the right of the person making such offer to deny that the patentee was the original inventor. Evans *v.* Eaton, *Pet. C. Ct.* 322, 347.

The government, after using a patented invention under circumstances which warrant implication that it does so under a license and an obligation to pay a royalty, cannot defend an action in the court of claims for compensation on the ground that the invention is valueless. Palmer *v.* United States, 20 *Ct. of Cl.* 432.

95. *Rights Created by License.*

A licensee, unless he is estopped by his contract, is at liberty to manufacture and sell as many articles as he pleases, either by the old method or by any new machine which may be invented. Burr *v.* Duryee, 1 *Wall.* 531.

Where the owners of a patent granted a license to use it, to a firm consisting of two persons, which firm was afterward dissolved, one of the partners buying out the entire interest of the other, an injunction to restrain the use of the invention by such purchasing partner was refused; on the ground that the dissolution of the firm and the withdrawal of one partner did not, of themselves, operate to extinguish the license. Belding *v.* Turner, 8 *Blatchf.* 321 ; 4 *Fish. Pat. Cas.* 446.

Every person who pays the patentee for a license to use his process, becomes the owner of the product, and may sell it to whom he pleases, or apply it to any purpose, unless he binds himself by covenants to restrict his right of making and vending certain articles that may interfere with the special business of some other licensee. Metropolitan Washing Machine Co. *v.* Earle, 2 *Fish. Pat. Cas.* 203 ; 3 *Wall. Jr.* 320.

A mere license cannot be apportioned so as to permit the licensee to grant to others separate rights to use or work the patent, by subdividing the rights that may have been granted to him. Consolidated Fruit Jar Co. *v.* Whitney, 1 *Bann. & A. Pat. Cas.* 356.

Where a licensee of a patented machine took it apart and used some of its parts to construct a new one, it was *held*, that his license did not give him permission to use it. Gottfried *v.* Phillip Best Brewing Co., 5 *Bann. & A. Pat. Cas.* 4.

A grant by a patentee, of "the sole and exclusive right to manufacture and sell machines of the patented invention" in a specified city, gives, by implication, to a purchaser from such manufacturer, the right to use the machine until it was worn out, wherever he pleases. May *v.* Chaffee, 2 *Dill.* 385; 5 *Fish. Pat. Cas.* 160.

The owners of a patent granted to F. and G., the sole and exclusive right to manufacture and sell the patented machines in Chicago, Ill. F. and G. sold the patented machine to the defendants, who took it to Faribault, Minn., where they resided, and used it there. Complainants acquired, by proper conveyances, the exclu-

sive right to use, and sell to others to use, the patented machine, within Fairbault. It was *held* that the defendant had a right to use the machine without liability to the complainant. May *v.* Chaffee, *supra.*

When a member of a firm makes an invention, but manufactures the machines at the firm's expense, and permits the firm to use them, all the partners have an equal proportionate right in them and their use. Wade *v.* Metcalf, 16 *Fed. Rep'r*, 130.

96. *Assignments of Licenses. Sub-license.*

The general doctrine as to licenses is, that express words of assignability are needful to render them transferable; a grant of a license to a person or persons, only, does not pass to an assignee. Troy Iron & Nail Co. *v.* Corning, 14 *How.* 193; Oliver *v.* Rumford Chemical Works, 109 *U. S.* 75; 3 *Sup. Ct. Rep'r*, 61; Baldwin *v.* Sibley, 1 *Cliff.* 150; Goodyear *v.* Providence Rubber Co., 2 *Cliff.* 351; 2 *Fish. Pat. Cas.* 351; Lightner *v.* Boston & Albany R. R. Co., 1 *Low.* 338; Curran *v.* Craig, 22 *Fed. Rep'r*, 101; Eclipse Windmill Co. *v.* Woodmansee Windmill Co., 21 *Fed. Rep'r*, 650; 32 *Pat. Off. Gaz.* 1605. Thus a license to manufacture at a specified place, or to use a patented process at the licensee's place of business, and associate others with him in it, is not transferable. Searls *v.* Bouton, 20 *Blatchf.* 426, 12 *Fed. Rep'r*, 140; 21 *Pat. Off. Gaz.* 1784; Gibbs *v.* Hoefner, 19 *Fed. Rep'r*, 323. An agreement between a patentee and an individual by which the former licenses and grants to the latter, without adding "executors, administrators or assigns," or anything equivalent, the exclusive right to manufacture, sell, &c., during a specified term of years, and that he will engage in the manufacture and sale, will use all his business tact and skill, &c., is a mere license to the grantee personally; is not assignable; and on his death, even before the specified term has expired, no right to manufacture or to sue infringers under it passes to the representatives of the licensee. Oliver *v.* Rumford Chemical Works, 109 *U. S.* 75. Generally, however, whether a license is or is not assignable is to be determined not merely by the term "license," but by an inquiry into the intention of the parties; not only by the words of the license, but by the nature of the transaction, the consideration paid, and other circumstances showing that an assignable right was conferred. Dorsey R. H. Rake Co. *v.* Bradley Manuf. Co., 12 *Blatchf.* 202; 1 *Bann. & A.* 930.

A license that runs to the administrators and executors of the licensees, as well as to their assigns, is apportionable and may be transferred in severalty. Adams *v.* Howard, 22 *Fed. Rep'r*, 656.

A license to make and use a patented invention, which reserves no royalty to the owner of the patent, and grants the right to the persons named as parties of the second part, and to their executors, administrators and assigns, is assignable, and the whole right of one of the licensees may be transferred by him in severalty. Adams *v.* Howard, 22 *Fed. Rep'r*, 654.

Permission to use a patent may be transmissible by succession to a corporation formed of a union of two licensees, and succeeding to the rights and obligations of both. Lightner *v.* Boston & Albany R. R., 1 *Lowell*, 338.

A patentee executed an instrument agreeing to "grant, bargain, sell, assign and transfer to B., his executors, administrators and assigns, the right and privilege of making, using and selling friction matches," as patented, to have and to hold "the right and privilege of manufacturing the said matches, and to employ in and about the same six persons and no more, and to vend said matches in any part of the United States;" and the instrument further provided that nothing therein contained should prevent or restrict the patentee from "making and vending the same, or of selling and conveying similar rights and privileges to others;" and that B. should not manufacture in certain places. It was held, that the right granted by the deed was a license or authority, coupled with an interest in the execution, to the grantee and six persons to be employed by him in making matches; that the right was an entirety, incapable of being apportioned or divided among different persons; that, therefore, an assignment by B. of a right to make as many matches as one person could roll up was void. Brooks *v.* Byam, 2 *Story*, 525.

In general a patentee who licenses a person to use the patent reserving a royalty, has no lien upon the license as against an assignee to secure payment of the royalty accruing before the assignment was made. But where D. had an exclusive license to use the patent of G. for a particular purpose, covenanting not to use it for other purposes, and to pay a specified tariff for such use, and C. took an assignment of such license, it was *held*, that C. took the license subject to the obligation to pay the specified tariff on what he should make under it. Goodyear *v.* Congress Rubber Co., 3 *Blatchf.* 449.

A patentee authorized a license to use and manufacture his invention "for his own proper business," to a specified amount per annum. It was held, in the absence of affirmative authority, that a sub-license was not authorized by such agreement. Putnam *v.* Hollender, 6 *Fed. Rep'r*, 882 ; 19 *Blatchf.* 48 ; 19 *Pat. Off. Gaz* 1423.

97. *Right of Patentee to sue Licensee, for Royalties.*

A suit to collect moneys due as royalties under a license to use a patent does not arise under the laws of the United States, and is not cognizable in a circuit court unless by reason of citizenship. Albright *v.* Texas, 106 *U. S.* 613 ; 1 *Sup. Ct. Rep'r*, 550, Kelly *v.* Porter, 8 *Sawyer.* 482, 17 *Fed. Rep'r*, 519.

An employé who is the owner of a patent cannot introduce his patented device into his employer's business and demand royalties for its use without the employer's consent. Barry *v.* Crane Manuf. Co., 22 *Fed. Rep.* 396.

The patentee may elect whether to sue at law for recovery of the promised royalties, or to file a bill in equity for cancellation of the license. Hartell *v.* Tilghman, 99 *U. S.* 547. If the suit be in equity, founded upon the non-performance of the conditions of a license, the original patentee is properly joined as party plaintiff with the assignee, notwithstanding the whole beneficial interest is in the assignee, inasmuch as he was a party to the agreement or license, and may be interested in the patent and interested in upholding it. Woodworth *v.* Cook, 2 *Blatchf.* 151. And equity will enjoin a licensee from operating under a patent unless he pays the license-fee, whether the license is forfeited at law or not. Day *v.* Hartshorn, 3 *Fish.* 32.

To an action of covenant upon an agreement which granted a license to make and vend a patented article, the licensee agreeing to keep an account of the articles manufactured, and to pay a fixed price per pound on those sold, it is no defense that the patent is invalid. Wilder *v.* Adams, 2 *Woodb. & M.* 329.

The true doctrine is that a licensee may defend a suit for license fees by evidence that the validity of the patent has been successfully impeached, so that the license has not given him the right and protection intended, though evidence merely that it is valid, is not a defense, for it may have protected him, notwithstanding. [6 El. & B. 930 ; 1 Gray, 114 ; 66 N. Y. 206 ; 82 N. Y. 526.] Yet

some cases have held that a license cannot impeach the patentee's title [2 Ad. & E. 278; 6 C. B. N. S. 771; 2 Woodb. & M. 329; 10 H. L. Cas. 293; L. R. 2 App. Cas. 423]; and some have held that invalidity of the patent may always be proved [124 Mass. 553]. White *v.* Lee, 23 *Pat. Off. Gaz.* 1621.

But a licensee is at liberty to contest the question whether the articles made by him embody the invention or any material part thereof; and a stipulation to the contrary in the contract is of no effect. *Ib.*

A bill in equity for an accounting of royalties under a license to use a patent cannot be maintained by executors of the licensor and trustees of the patent against the licensees, the remedy at law being plain, adequate and complete. That the licensees claim to have made a settlement with the heirs and devisees of the licensor, which they can only set up as a defense in a court of equity, does not give complainants claiming such royalties the right to invoke the aid of equity. Crandall *v.* Piano Manuf. Co., 24 *Fed. Rep'r*, 738; Crandell *v.* Piano Manuf. Co., 32 *Pat. Off. Gaz.* 1123.

In an action for the recovery of a sum agreed to be paid to the patentee of a machine, as a license fee for the exclusive right to make and sell the machines, in a given territory, it is no defense, that the plaintiff has himself infringed such exclusive right, or that the plaintiff was not the first and original inventor of what his patent claims. Birdsall *v.* Perego, 5 *Blatchf.* 251; Morse Arms Manuf. Co. *v.* United States, 16 *Ct. of Cl.* 296.

When the sale of licenses by the patentee has been sufficient to establish a price for such licenses, that price may be the measure of his damages against an infringer; but a royalty, to be binding on a stranger to the licenses which established it, must be uniform. Westcott *v.* Rude, 27 *Pat. Off. Gaz.* 719; 19 *Fed. Rep.* 830. The recovery of the license or patent-fee from an infringer, and its payment, authorizes him to use the particular articles for which recovery has been had. Perrigo *v.* Spaulding, 12 *Pat. Off. Gaz.* 352; 13 *Blatchf.* 389.

In determining what was the established price of a license under a patent at the time of an infringement, as a proper compensation in damages for such infringement, agreements which appear to have been made chiefly to secure the introduction of the patented machine into public use, are not to be considered as unqualified licenses. A license providing for the payment of a certain royalty, subject to a reduction if paid promptly, may be considered as pro-

viding for a royalty at the lower rate. In a doubtful case, even an abandoned and revoked license may be considered. Graham *v.* Geneva Lake Crawford Manuf. Co., 24 *Fed. Rep'r*, 642; 32 *Pat. Off. Gaz.* 1603. But see Bussey *v.* Excelsior Manuf. Co., 5 *Bann. & A. Pat. Cas.* 135; 17 *Pat. Off. Gaz.* 744; 1 *McCrary*, 161; 1 *Fed. Rep'r*, 640.

Although where there appears to be a subsisting license between the complainant and the respondent, the jurisdiction of the circuit court, under the patent law, will not be extended to cover a suit to enforce the terms of the license or to forfeit the license, on the ground that the terms thereof have been violated, yet where a suit is brought for infringement, and the existence of a license is alleged by the respondent and denied by the complainant, it is competent for the court to determine whether, at the time of the filing of the bill, there was a subsisting license between the parties. Hammacher *v.* Wilson, 26 *Fed. Rep'r.* 230.

A license to manufacture under a patent contained a condition that if the proprietors of the patent should grant a license at a less royalty to any other party, the royalty to be exacted from the licensee should be reduced to correspond; and also contained a provision that the proprietors of the patent might terminate the license upon written notice to the licensee on any non-payment of license fees. The licensee filed a bill in equity alleging that the proprietors of the patent had granted a license to another party at a lower royalty, and had concealed the fact from him for more than a year, so that he had largely overpaid the license fees properly due at the reduced rate; and praying that they might be ordered to reduce his license fee, and to repay the sums overpaid, and that the licensors might not claim any other or further sums than at such less license fee, and might be enjoined from giving notice, during the pendency of the suit, to terminate the license, and from attempting to collect the license fees. It was *held*, that this showed no ground for relief in equity. The licensee had a remedy in his own hands, and could protect himself without the aid of any court. None of the peculiar grounds of equitable jurisdiction existed. Florence Sewing Machine Co. *v.* Singer Manuf. Co., 8 *Blatchf.* 113; 4 *Fish. Pat. Cas.* 329.

In an action growing out of the alleged failure of the defendant to act up to the terms of a license granted him by the complainant, to sell a patented article, if the complainant refuses to fulfill his obligation in matters of substance, under the license, a

court of equity will not interfere to assist him in compelling the defendant to observe the obligations upon his part. Where, however, one of the conditions of such license was that the complainant (the licensor) should use reasonable diligence in prosecuting unlicensed persons who should sell imitations of the article licensed, it was *held*, that if the action of complainant was such that it resulted, practically, in stopping infringements, he fulfilled the spirit and meaning of the obligation to the defendant to use reasonable diligence in prosecuting. Foster *v.* Goldschmidt, 21 *Fed. Rep'r*, 70.

A person agreed with a patentee to pay him a certain sum on every patented article manufactured by him. The patentee brought his action for money had and received. It was *held*, that the jury might infer the receipt of money from the fact of sale of the article, and that judgment should be rendered for the plaintiff as upon an executed contract. Stanley *v.* Whipple, 2 *McLean*, 35.

The licensee from a patentee under a license which stipulated that he should pay no greater royalty than any licensee under the patent, obtained an injunction on the ground that less was exacted from other licensees than from him, against a suit for royalties, and also against the patentee's declaring the license forfeited for non-payment. It was *held*, that the suit should not be restrained, as an ample defense at law existed, but that the injunction should be continued with respect to the license, since the announcement of its revocation would injure the licensee's business. Baker Manuf. Co. *v.* Washburn, &c. Manuf. Co., 18 *Fed. Rep'r*, 172.

A reservation by a licensor that he would hold responsible for the royalty the party for whom a licensee has contracted to do certain work under a license, is inconsistent with the license and therefore void. Bigelow *v.* City of Louisville, 3 *Fish. Pat. Cas.* 602.

The government cannot, after a patent is issued, make use of the improvement without obtaining a license from the inventor, or making him compensation. Cammeyer *v.* Newton, 94 *U. S.* 225; Colgate *v.* International Ocean Tel. Com., 17 *Pat. Off. Gaz.* 194; 17 *Blatchf.* 308.

In an action to recover a royalty from government, founded on an implied contract to pay one, where the defense was that the department using claimant's invention had previous, to his patent manufactured the same articles, the claimant showed that he had made applications for a patent a considerable time before it was

granted. It was held that he might go into such history of his efforts and achievements in the art as would tend to show that he was the first inventor. Hubbell *v.* United States, 20 *Ct. of Cl.* 354.

As to measure of damages for use of a patented device, by a licensee thereof, continued after the expiration of his license, where the device is only a part of the mechanism used, see Porter Needle Co. *v.* National Needle Co., 22 *Fed. Rep'r*, 829.

98. *Right of a Patentee or Licensee to sue Infringers.*

A mere license, although exclusive, to manufacture and sell a patented article does not authorize the licensee to maintain actions for damages against infringers who are not infringing the patent in those respects. Hayward *v.* Andrews, 106 *U. S.* 672.

A mere license to make and use, without the right to grant to others to make and use, the thing patented, though exclusive, will not authorize the licensee to bring suit in his own name for infringement without joining the patentee. Wilson *v.* Chickering, 23 *Pat. Off. Gaz.* 1730.

A mere licensee cannot bring suit for infringement, either at law or in equity, in his own name; but must join with him the owner of the legal title. Nelson *v.* McMann, 16 *Blatchf.* 139; 4 *Bann. & A. Pat. Cas.* 203; 16 *Pat. Off. Gaz.* 761; Hammond *v.* Hunt, 4 *Bann. & A. Pat. Cas.* 111; Gamewell Fire Alarm Co. *v.* Brooklyn, 14 *Fed. Rep'r*, 255; 22 *Pat. Off. Gaz.* 1978; 15 *Rep'r*, 40. But compare Goodyear *v.* McBurney, 3 *Blatchf.* 32.

A licensee may enjoin a party who has actually infringed his right under the license. Brammer *v.* Jones, 3 *Fish. Pat. Cas.* 340; 2 *Bond*, 100.

Where a contract provided that the net proceeds from all suits for infringement of a patent should be equally divided between licensor and licensee, and forbade the instituting of a suit without the consent of both parties, it was *held*, that the licensee was authorized to compromise with the infringing party. Burdell *v.* Denig, 2 *Fish. Pat. Cas.* 588.

In one case the laches of a patentee in regard to infringements of his patent was *held* sufficient, under the circumstances, to defeat the enforcement, in equity, by his assignee, of pecuniary claims for such infringements before the assignment of such claims and the patent to the complainant. New York Grape Sugar Co. *v.* Buffalo Grape Sugar Co., 24 *Fed. Rep'r*, 604; 32 *Pat. Off. Gaz.* 1356.

99. *Revocation or Forfeiture.*

Upon the breach of the conditions of a license, the patentee or licensor has a right to avoid the contract and be remitted to his original rights, and may prosecute the licensees for an infringement of the patent. Woodworth *v.* Cook, 2 *Blatchf.* 151; Wilson *v.* Sherman, 1 *Blatchf.* 536; Brooks *v.* Stolley, 3 *McLean*, 523. But non-performance of conditions does not, of itself, work a rescission of a license; the forfeiture must be enforced. Stanley Rule & Level Co. *v.* Bailey, 14 *Blatchf.* 510; 3 *Bann. & A. Pat. Cas.* 297; Adams *v.* Meyrose, 7 *Fed. Rep'r*, 208; 2 *McCrary*, 360. See Wilson *v.* Sherman, 1 *Blatchf.* 536; Woodworth *v.* Weed, *Id.* 165; Armstrong *v.* Hanlenbeck, 3 *N. Y. Leg. Obs.* 43. If the license provides in terms for a written notice as the agreed mode of terminating it, such notice must be given. White *v.* Lee, 3 *Fed. Rep'r*, 222; 5 *Bann. & A. Pat. Cas.* 575.

A stipulation for terminating a license by written notice is valid, and may be enforced by a suit for infringement begun after failure to pay royalties and service of such notice, notwithstanding subsequent offers to pay the sums due. Hammacher *v.* Wilson, 26 *Fed. Rep'r*, 239. And in general, provisions in a license prescribing a forfeiture, may be enforced according to their terms; if mere neglect to use the invention is to operate as an abandonment of the license, no formal notice from the licensor that he considers such neglect an abandonment, is necessary. Wilson *v.* Stolley, 5 *McLean*, 1.

In general, an infringement of a patent does not forfeit a license under it, unless, in his infringement, the licensee has assumed such a hostile attitude toward the patent as amounts to a repudiation of the license. Wood *v.* Wells, 6 *Fish. Pat. Cas.* 382. If a licensee neglects to pay his license-price for a long time, and finally, when prosecuted, abandons his license, or defends upon inconsistent grounds, he will be liable as an infringer. Bell *v.* McCullough, 1 *Bond*, 194; 1 *Fish. Pat. Cas.* 380. On the other hand, revocation of a license releases the licensee from any provision in the license forbidding him to dispute the validity of the patent; and if he is afterward sued for infringing, he may contest it as any other infringer might. Wooster *v.* Singer Manuf. Co., 23 *Pat. Off. Gaz.* 2513; 15 *Rep'r*, 524. The bringing of an action, or the recovery of judgment for recovery of arrears due under a license does not re-affirm the license

after default and notice of termination. Armstrong *v.* Haulenbeck, 3 *N. Y. Leg. Obs.* 43. If some of several licensees have surrendered the license, the others are not thereby released ; and the latter may be sued without joining the former. Theberath *v.* Celluloid Manuf. Co., 3 *Fed. Rep'r*, 143 ; 10 *Rep'r*, 328 ; 5 *Bann. & A. Pat. Cas.* 577.

An agreement for an exclusive license stipulated that the payments of royalty should " be made quarterly; that is to say, on the first day of January, April," &c., and that the license should be null and void if the licensee should fail well and truly to make the payments above referred to, or to execute or fulfill any of the other conditions contained in the agreement. It was held, that the failure to render a statement or make a payment on the first day of April, did not, *ipso facto*, work a forfeiture of rights under the agreement ; that in the absence of stipulation as to place of payment the licensor should apply to the licensee for an account and a payment, and that he could not in the meantime, without the assent of the latter, re-license the patent to third parties, and that a subsequent license issued without the consent of the original licensee, and after a complete tender of the royalties then due, was void where the parties had notice of the prior agreement. Dare *v.* Boylston, 6 *Fed. Rep'r*, 493 ; 18 *Blatchf.* 548 ; 19 *Pat. Off. Gaz.* 725.

A. entered into an agreement with defendant, by the terms of which the defendant was to manufacture a certain plow, under two patents which belonged to A., and to pay him royalty and a commission on sales made by him. Subsequently, A. assigned to J. B. & Co., all royalty due or to become due, and his interest in the patents, as security for a debt, which right and interest were by them assigned to the plaintiffs, who filed a bill praying that the defendant's license be decreed forfeited, and that he be required to account to them for royalties. It was *held*, that as the assignment made by A. did not extend to commissions upon sales, a decree annulling defendant's license would not be granted, as it would not only affect the commissions but work a rescission of the entire agreement ; and *further*, that as the assignment was but partial, the defendant could only be required to account for royalties becoming due after he had assented to it. Cook *v.* Bidwell, 8 *Fed. Rep'r*, 452 ; 2 *Pat. Off. Gaz.* 1083 ; 12 *Rep'r*, 554.

A license to use a patent, given pending the application therefor, unlimited as to time, providing only that it should be void on failure to procure the patent, and covenanting to protect the licensee in

its use during the application, and after the patent shall have been obtained, was held irrevocable. Kelly *v.* Porter, 17 *Fed. Rep'r*, 519 ; 8 *Sawyer*, 482.

100. *Federal and State Jurisdiction over Contracts involving Patents.*

Contracts in relation to a patented machine or implement are regulated by the laws of the several States, and are subject to State jurisdiction. Wilson *v.* Sanford, 10 *How.* 99 ; Bloomer *v.* McQuewan, 14 *How.* 539 ; Chaffee *v.* Boston Belting Co., 22 *How.* 217.

By a valid sale and purchase of a patented machine it becomes the private, individual property of the purchaser, and is no longer subject to the laws of the United States, but to the laws of the State. Chaffee *v.* Boston Belting Co., 22 *How.* 217 ; Bloomer *v.* McQuewan, 14 *How.* 539.

Where the controversy turns, not upon the letters-patent themselves, but only upon contracts concerning them, the circuit court has no jurisdiction except as the citizenship of the parties may give it. The subject-matter of such contracts, where neither the validity of the patent nor an infringement of it are concerned in the controversy, does not give the courts of the United States jurisdiction ; to have that effect the rights of the patentee under the patent laws must be directly and not collaterally brought in issue. Burr *v.* Gregory, 2 *Paine*, 426 ; Landolph *v.* Robinson, 2 *N. J. L. J.* 171 ; Teas *v.* Albright, 13 *Fed. Rep'r*, 406 ; 28 *Int. Rev. Rec.* 290 ; 22 *Pat. Off. Gaz.* 2069 ; 14 *Rep'r*, 712. Thus the federal courts have no power under the patent laws to determine upon the fulfillment or non-fulfillment of a contract of license. Tilghman *v.* Hartell, 11 *Phila.* 500 ; 2 *Bann. & A. Pat. Cas.* 260. So, in a suit where all the parties to the suit were citizens of New York, it was held, that the circuit court had no power to decree that the defendant execute to the plaintiff a transfer of letters-patent. Perry *v.* Littlefield, 17 *Blatchf.* 242 ; 17 *Pat. Off. Gaz.* 51 ; 4 *Bann. & A. Pat. Cas.* 624.

Property in inventions exists by virtue of the laws of Congress, and a State law restricting the sale of patent rights or in any way interfering with its enjoyment in the State, is unconstitutional and void. *Exp.* Robinson, 2 *Biss.* 309 ; 4 *Fish. Pat. Cas.* 188. A statute of a State imposing a restriction or condition upon the sale or transfer of patent rights,—such as an act requiring any person

who may take any obligation in writing for which a patent right shall form the whole or any part of the consideration, to insert in the body of such written obligation the words "given for a patent right,"—is contrary to the Federal constitution; the States can impose no restrictions in respect of a right in letters patent. Castle *v.* Hutchinson, 25 *Fed. Rep'r*, 394; *Ex parte* Robinson, 4 *Fish. Pat. Cas.* 186; 2 *Biss.* 309. After a patentee has fully complied with the laws of Congress on the subject, he is at liberty to sell his right in open market any where within the United States. Webber *v.* Virgina, 103 *U. S.* 344; *Exp.* Robinson, 4 *Fish. Pat. Cas.* 186; 2 *Biss.* 309. A State or municipality may, however, require dealers in manufactured articles, notwithstanding they are patented, to take out a license and pay a license fee by way of tax on their sales. Webber *v.* Virgina, 103 *U. S.* 344. For when a patented machine passes into the hands of a purchaser, it becomes subject to State taxation like other individual property. Bloomer *v.* McQuewan, *supra*; Chaffee *v.* Boston Belting Co., *supra*.

101. *Construction and effect of such Contracts.*

Contracts concerning the use and enjoyment of patented inventions are to be construed in the same way as contracts respecting other species of property,—that is, so as to carry into effect the intention of the parties as collected from the language employed, the subject-matter, and the surrounding circumstances. Star Salt Castor Co. *v.* Crossman, 4 *Cliff.* 568; 3 *Bann. & A. Pat. Cas.* 281. In other words, while the exclusive rights of a patentee are specially guarded from intrusion, the contracts which he makes to share them with third persons are interpreted and enforced in the same manner as other legal engagements. Morse *v.* O'Reilly, 6 *Pa. L. J.* 501; 4 *L. J. Rep.* 75; 5 *Whart. Dig.* 414.

Where a contract provides for a certain mode of ascertaining what amount of fuel has been saved by the use of certain machinery, after evidence has been given pursuant to that mode, the party may confirm it by other tests. Washington, &c. Packet Co. *v.* Sickles, 10 *How.* 419, 438.

Where a contract stipulates that an arbitration is to be a condition precedent to the right to sue upon the contract, or even if that may be inferred upon construction, no suit can be maintained until the plaintiff has made all reasonable efforts to procure arbitration. Perkins *v.* United States Electric Light Co., 24 *Pat. Off. Gaz.* 294;

21 *Blatchf.* 308; 10 *Fed. Rep.* 513. But a company which has agreed to pay a certain sum to be determined by arbitration, and then prevents arbitration, may be sued at law. Humaston *v.* Telegraph Co., 20 *Wall.* 20.

The word "invention," as used in a contract to assign a patent, does not embrace inventions, or reissues or extensions thereof, other than those described in the patent to be assigned. United Nickel Co. *v.* American Nickel Plating Works, 4 *Bann. & A. Pat. Cas.* 74.

An agreement between joint owners of a patent to account to each other for profits derived from the use of the invention does not constitute them partners; they are merely tenants in common. Fraser *v.* Gates, 20 *Rep'r*, 427.

An exclusive right to sell a patented article, given under seal, is a contract, and is not a revocable power of attorney. Goddard *v.* Wilde, 17 *Fed. Rep'r*, 845; 16 *Rep'r*, 617.

102. *In particular Cases.*

A patentee applied for a patent on a new combination of parts, which parts had before been patented by him; and, at the time of such application, granted to the defendants by one instrument the exclusive right to make, use, and vend, under the patent for the parts, as such; also, by another contract, the right to make, use and sell the parts in the particular combination described in the application. A patent for the combination having not been granted, the assignees of the extended term of the patent for the parts sued defendants, for using the parts in the combination. It was *held* that defendants' contract with the inventor at the time of his application for a patent on the combination secured them the right to make, use, and sell the combination, without reference to their license under the patent for the parts; that, as they were using only the specific combination, they were not liable to complainants, in the suit brought. Hammond *v.* Mason, &c. Organ Co., 92 *U. S.* 724; aff'g 1 *Holmes*, 296; 6 *Fish. Pat. Cas.* 599.

In an agreement for the manufacture and sale of patent medicines, a stipulation that under certain circumstances one party shall cease their manufacture of such machines is not void, as being in restraint of trade; and if it were, this would be no defense to the patentee's claim for an accounting under the contract. Kinsman *v.* Parkhurst, 18 *How.* 289; aff'g 1 *Blatchf.* 488; *N. Y. Leg. Obs.*

146. An agreement made with a patentee to manufacture his machines under his patent upon certain conditions, and making and selling such machines under the patentee's title, estops the manufacturer from alleging the invalidity of the patent as a defense to an action by the patentee for an account under the contract. *Ib.*

An agreement between a patentee and a third person as trustee, that the latter should hold the patent, and have the control thereof for the benefit of those who had a right to use the same, under contracts with the patentee, transfers the entire interest and ownership, legal and equitable, of the patentee in the patent, to such trustee, for the benefit of those interested. Hartshorn *v.* Day, 19 *How.* 211. An agreement between a patentee who was about to apply for a renewal of his patent, with another, that in case of renewal he would convey to him such renewed patent in consideration of a certain sum, was held to convey to the assignee an equitable title to the entire interest of the assignor, convertible into a legal title by paying or offering to pay the agreed consideration. *Ib.*

An agreement, made in consideration of a promise to assign the invention, as soon as the patent shall issue, that the patentee shall give his promissory notes, is not impaired by the fact that no patent will issue until after the day when the last note would have been payable. Read *v.* Bowman, 2 *Wall.* 591.

An agreement or compromise between patentees has been held not to operate as a license to either to do more than use his existing method of manufacture. Troy Iron, &c. Factory *v.* Corning, 14 *How.* 193; rev'g 1 *Blatchf.* 467.

Minors were interested in a manufacturing establishment, as beneficiaries under a deceased partner. The administrator, who was also their guardian, in entire good faith allowed the business to be continued by the surviving partners for several years, without filing any inventory or account. The property meantime suffered no deterioration, but increased in value, and was afterwards, under a special law, transferred to a corporation created for the purpose. The beneficiaries, for more than seven years after this transfer and their coming of age, received annual stated accounts, and dividends on their shares of the stock. It was *held*, that such acquiescence prevented their maintaining a bill in equity for an account of the original estate. Hoyt *v.* Sprague, 103 *U. S.* 613.

R., the agent of the patentee, authorized the firm of H., C. & N., for a valuable consideration, to construct for use at their place

of business, the device (a furnace) involved in the patent. The defendants, who had all the rights of the firm of H., C. & N., were sued for infringement, because of the use of the device. It was *held*, 1. After the transaction with H., C. & N., the patentee had no right or interest with respect to the particular device and its use during the time of his original patent, and acquired none by the extension of his patent afterward. 2. Those who constructed the device under the authority of the patentee, and the defendants who acquired it of them, have had and still have the right to use it at the particular place, clear of any claim of infringement by the patentee or his representatives. 3. Though the right to use may not have been acquired by lawful conveyance (according to the statutes) of that right as a subject of conveyance by itself, it was acquired by constructing the device for use, with the consent of the patentee obtained and paid for. Black *v.* Hubbard, 12 *Pat. Off. Gaz.* 842.

Validity of an agreement by which the patentee of a patent which had expired, having claims for damages for its infringement made a written agreement with G., giving to G. the exclusive right to control the claims, and collect or compromise them; G. undertaking to bear all expenses, except that the patentee was to bear the taxable costs of any suit in which a recovery for costs should be had against him; and G. being entitled to receive, as compensation for his time and all expenses, except such taxable costs, one-half of the gross amount he might collect,—examined with reference to the objections of champerty and maintenance; and *held*, that as it was, in terms, to operate in many States, it must be tested by the general rules of common law and equity, and should be adjudged void for conflict with those; although by the statute law of New York, where it was made, it might be sustainable. Gregerson *v.* Imlay, 4 *Blatchf.* 503.

An inventor made an agreement with F. that, in consideration of the performance of certain covenants by him, he (F.) should have an interest in a patent. The covenants were not performed, in consequence of which default the inventor notified F. of the forfeiture of his rights. F. then presented the inventor a bill for the amount he had advanced, under his agreement with the inventor, it was *held*, that by this action F. abandoned to the inventor all his rights under the agreement. Kittle *v.* Frost, 9 *Blatchf.* 214; 5 *Fish. Pat. Cas.* 132.

Under an agreement between the owners of conflicting patents,

which defined their respective rights and provided a fund for maintaining them and for purchasing, as joint property, patents deemed necessary for their mutual protection, a patent does not pass, which had been previously purchased by one of the parties and was subsequently assigned to the original inventors, and, after having been extended, was reassigned to the same party. Aultman *v.* Holley, 5 *Pat. Off. Gaz.* 3.

Construction and effect of a peculiar contract for right to use one machine under a patent. Steam Cutter Co. *v.* Sheldon, 10 *Blatchf.* 1; 5 *Fish. Pat. Cas.* 477.

An agreement in writing between W. and M. & S., provided for the sale by W., to M. & S., of two-thirds of his mineral lease of lands in Lehigh county, from C., including tools and all appurtenances, and also of "two-thirds of all his machinery, furnaces, &c. now on or about the premises of Wetherill Zinc Company, in the town of W., with rights to use all his patents and process for the manufacture of zinc oxide, retorts, &c., which said W. now has, or has in contemplation to obtain; it being understood that the patents, heretofore referred to, mean only those which he holds in his own right." W. had previously transferred interests in his process patent, and was, therefore, only part owner of it. W.'s patent was subsequently renewed. It was *held*, 1. The interpretation of this contract must be made from the instrument itself, irrespective of the declarations of either party; but in aid thereto, it was proper to consider facts cognate to the subject of the contract, and within the knowledge of the parties. 2. The interests in the lease, and in the machinery conveyed, were separate and independent. 3. The right to use W.'s patents and processes was to be exercised in connection with the buildings, machinery, &c., and, consequently, was local and restricted. 4. The qualifying words, "The patents heretofore referred to, mean only those which he holds in his own right," apply only to patents, of which W. was the apparent but not the real owner. They did not exclude patents of which his tenure was not exclusive. 5. As the process patent was the only one for the manufacture of zinc oxide, then held by W., it was clearly conveyed by the contract; the words of the grant could apply to no other. 6. A transfer of an interest in a subsisting patent will not extend beyond the terms of the patent, unless there are words indicating an intention to convey more than a present interest. 7. The words "Now has, or has in contemplation to obtain," merely individuate the patents which the contract was

intended to embrace; they would include patents subsequently obtained for which caveats had already been filed. Wetherill *v.* Passaic Zinc Co., 2 *Pat. Off. Gaz.* 471; 16 *Int. Rev. Rec.* 156.

A contract between owners of two patents concurrently useful in the manufacture of an article, governing the manner in which the manufacture of the article should be carried on, was *held*, valid; and obligatory on licensees of either patentee, who subsequently took their licenses with notice of the restrictions which the contract imposed on manufacture under the patents. Morse *v.* O'Reilly, 6 *Pa. L. J.* 501; 4 *L. J. Rep.* 75; 5 *Whart. Dig.* 4, 414.

A patent owned by A. and B. was assigned by them, as to certain States, to E., a corporation, part of the consideration being a prescribed number of shares of stock in E. The contract required the payment of a royalty to A. and B., and also, under penalty of forfeiture, the use by E. of its best endeavors to make the corporate scheme a success. On the other hand, A. and B. agreed to exercise reasonable diligence to promote the success of the enterprise, under the penalty of forfeiture of all rights of reversion. On failure of the corporation, F., a large stockholder, purchased its assets, including the patent right, but did not subsequently comply with the condition as to diligence, &c. Suit was brought by A. and B. to have the right acquired by F. declared forfeited. *Held*, that, as it appeared that the plaintiffs had received the full value of their patent right, and were stockholders in E., which they had caused to be formed, and that as there was failure on their part to comply with their promises as to making the business a success, no right of reverter or forfeiture existed. Buckley *v.* Sawyer Manuf. Co., 7 *Fed. Rep'r*, 358; 2 *McCrary*, 350.

One who aided in perfecting an invention, but afterward recognized the validity of the nominal inventor's claim, in dealings which resulted in the purchase of the patent therefor, was *held* estopped from setting up a claim to being the inventor against such purchasers. National Feather Duster Co. *v.* Hibbard, 9 *Fed. Rep'r*, 558; 11 *Biss.* 76; 21 *Pat. Off. Gaz.* 635.

What contract made to promote the development of a patent will give the undertaking party an interest or title in or to the invention, see Dounton *v.* Allis, 9 *Fed. Rep'r*, 766.

Construction of a contract whereby a creditor of a patentee took patented machines in payment of his demand, considered; and the right of the creditor to use the machines without paying royalty,

determined. Porter Needle Co. *v.* National Needle Co., 17 *Fed. Rep'r*, 536.

By an agreement between patentees and a manufacturer of the patented articles, the former gave to the latter the privilege of purchasing the patent, at any time within a year, for a stipulated price, and he agreed that, if he did not purchase it, he would assign to them any and all improvements upon the invention described in the patent, or relating thereto, which he might make or patent. Upon his electing not to purchase the patent, the patentees were *held* entitled to assignments of those improvements only which were made or patented by him during the term of a year specified in the agreement. Bunker *v.* Stevens, 26 *Fed. Rep'r*, 245.

A patentee and an inventor of an improvement on his device, obtained a new patent, by agreement between them, as joint patentees. It was *held*, that in equity they were joint owners of both patents, and that the second inventor could enjoin the first from using his patent except in connection with the second patent. Duke *v.* Graham, 19 *Fed. Rep'r* 647.

An agreement between owners of patents and alleged infringers, whereby the latter accept licenses from the former, will not be specifically enforced against the licensees, where it appears that the licensors have themselves repeatedly violated the terms of the contract, even though the licensees were guilty of the first breach. The remedy of the licensors, if any, is at law. Ohio Steel Barb Fence Co. *v.* Washburn & Moen Manuf. Co., 26 *Fed. Rep'r*, 702.

A contract for the use of an invention, requiring the payment of $30 for each of the first 400 locomotive engines to which the invention should be applied, $6,000 to be paid within thirty days, and the remainder within one year, can not be construed as an agreement to apply the invention to 400 locomotives and pay $30 for each. Babcock *v.* Northern Pacific R. Co., 26 *Fed. Rep'r*, 756.

103. *Persons purchasing of Inventor, before Application, may use or sell the Thing purchased.*

Every person who purchases of the inventor, or discoverer, or with his knowledge and consent constructs any newly invented or discovered machine, or other patentable article, prior to the application by the inventor or discoverer for a patent, or who sells or uses one so constructed, shall

have the right to use, and vend to others to be used, the specific thing so made or purchased, without liability therefor. *Rev. Stat.* § 4899.

The use of an invention prior to an application for a patent, with the knowledge and consent of the inventor, and unforbidden by him entitles the person so using, to continue the use after the patent has been granted. McClurg *v.* Kingsland, 1 *How.* 202.

The above enactment (as found in Act of 1839) was limited to the specific things made or bought; it did not extend to a general right to practice the invention. Brickill *v.* New York City, 18 *Blatchf.* 273; 7 *Fed. Rep'r*, 479; 18 *Pat. Off. Gaz.* 463.

The sale by an inventor, and the public use by the purchaser, of a machine embodying the completed invention, more than two years before the application for a patent, does not invalidate the patent, where such sale is upon condition that the machine should work satisfactorily, and is made at an under price, without profit to the seller, and the use is for the purpose of securing a fair test of the invention. And when proof has been made that the use was experimental, upon the question of its reasonableness every presumption should be made in favor of the inventor. Innis *v.* Oil City Boiler Works, 22 *Fed. Rep'r*, 780; 30 *Pat. Off. Gaz.* 998.

Consent, by the inventor of an apparatus, to the public use by others, before his application for a patent therefor, of one such apparatus sold by him to them, *held*, under the circumstances of the particular case, sufficiently shown to entitle them to continue to use the specific machine, under Rev. Stat. § 4899, without compensation to him, after the patent had been granted. Duffy *v.* Reynolds, 24 *Fed. Rep'r*, 855; 33 *Pat. Off. Gaz.* 621.

104. *Sales and Purchases of Patented Articles.*

The invalidity of a patent does not make the sale of the machine illegal, so as to taint with illegality the obligation of the person who is manufacturing them under an agreement with the patentee, and who receives the proceeds, to account to the patentee, under the contract. Kinsman *v.* Parkhurst, 18 *How.* 289; 1 *Blatchf.* 488.

The sale of a patented machine by a sheriff, under an execution, does not, in and of itself, convey to the purchaser any right to use the machine in the manner pointed out in the patent right. The purchaser acts at his own peril. Sawin *v.* Guild, 1 *Gall.* 485.

A patented machine, and the right of use attached to it, may pass, by sale, devise, or levy of execution, or assignment of an insolvent's effects. Woodworth *v.* Curtis, 2 *Woodb. & M.* 524. But see Stevens *v.* Gladding, 17 *How.* 447. Whatever right to use a patented machine the defendant in an execution may have, passes with the machine to the purchaser upon a sale thereof by the sheriff. The lawful sale of a patented machine takes it out of the monoply, either altogether or *pro tanto*, according to the nature of the contract. The purchaser of a machine from the patentee acquires no right in the patent itself, and needs none to enable him to enjoy his acquisition. By implication he is invested with a license to use that particular machine, and, in the absence of express stipulation to the contrary, such license passes with the machine to successive owners as an incident of proprietorship. That such is the law in case of a voluntary sale of a patented machine by the patentee is incontrovertible, and it is equally applicable to sale upon execution. Thus a sheriff's sale of a factory "with machinery for manufacturing" certain things, carries with it the title to pieces of machinery used in said factory and for the purpose specified, although detached and separate from the realty. Wilder *v.* Kent, 15 *Fed. Rep'r*, 217; 23 *Pat. Off. Gaz.* 831; 15 *Rep'r*, 525.

The granting clause of a deed containing the following words: —"Give, grant, bargain, and sell one of Baldwin's peg-splitting machines and the right to use the same, and of vending to others to be used in the county of Cheshire, excepting the town of Hinsdale, being the same machine for which letters-patent were issued," &c.,—does not authorize the grantee to construct any machine whatever; it is the conveyance of a single machine already in existence, and of the right to use and sell that single machine within the described territory. Baldwin *v.* Sibley, 1 *Cliff.* 150.

Whenever a patentee, assignee, licensee, or other legally authorized party, sells an absolute and unconditional right to any patented article or product, the purchaser acquires the absolute right, so far as the vendor, as patentee, assignee, &c., is concerned, to use and control such patented article or product as he sees fit. And if such article be in the nature of a manufacture, the purchaser may rework it for the manufacture of any new variety or of the same variety of goods, although such goods retain a part or all the qualities peculiar to the original product or manufactured article. Goodyear *v.* Beverly Rubber Co., 1 *Cliff.* 348.

Where only the right to use a patent results from the purchase

of a machine, such right is co-extensive with the existence of the machine and expires with it. Day *v.* Union Rubber Co., 3 *Blatchf.* 488; aff'd on other points, 20 *How.* 216.

When the owner of a patent himself sells a machine, the operation of which involves using his invention, he is understood to have to that extent parted with his exclusive right. Thus a sale of patented machines and other property, made under foreclosure of a mortgage, and by consent of the owner of the patents, was *held*, under the circumstances, to carry the right to use the machines under the patent, as well as the ownership of them as corporeal things. Detweiler *v.* Voege, 8 *Fed. Rep'r*, 600; 19 *Blatchf.* 482; 12 *Rep'r*, 198.

The purchase of a patented article from the owner of the patent confers upon the purchaser the right to use it to the extent that he could if it were not the subject of the patent; but such sale does not import the permission of the seller to its use in a way to interfere with his exclusive property in another invention. Roosevelt *v.* Western Electric Co., 20 *Fed. Rep'r*, 724.

The sale of the product of a patented machine does not violate another person's exclusive right to use, construct, or sell the machine itself. Goodyear *v.* New Jersey Central Railroad, 1 *Fish.* 626; 2 *Wall. Jr.* 356. So the purchase of the product of a patented machine or process does not make the purchaser an infringer of the patents for the machine or process. Brown *v.* District of Columbia, 3 *Mackey*, 502.

The rightful purchaser from a licensee of a material or article manufactured under a patent has a right to convert it to any use he pleases, unrestricted by any covenant between the licensee and the owner of the patent. Another licensee cannot obtain an injunction restricting him to a use of the product in its original form or for its original purpose, upon the ground that his vendor is under covenant not to employ it otherwise. Thus where Goodyear, as patentee of the vulcanized rubber compound, sold to B. an exclusive right to use it for making "tubes," and to W. the exclusive right to use it for making "wringers," and C. bought tubes of B., converted them into wringers, and undersold W., and filed a bill to enjoin such conversion, it was *held*, that the suit was not maintainable. Washing Machine Co. *v.* Earle, 3 *Wall. Jr.* 320.

A buckle or bale-tie sold for ordinary commercial use passes beyond the monopoly of the patent; and cannot be followed or controlled in its subsequent disposition. Even where the words

"licensed to use once only" were stamped upon the buckles, and words of like import were contained in the bill-heads and invoices, yet,—it was *held*, that the nature of the article and of its use were such that there was an implied parting with the unrestricted title at the time of sale which was inconsistent with any such reservation or limitation. American Cotton Tie Co. *v.* Simons, 13 *Pat. Off. Gaz.* 967.

A purchaser of machines from the patentees may repair and perfect them, and his using them is not an infringement; such purchase does not, however, authorize the use of machines containing the patented inventions unless they are the identical machines purchased. Union Metallic Cartridge Co. *v.* U. S. Cartridge Co., 2 *Bann. & A. Pat. Cas.* 593; 8 *Fed. Rep.* 446.

The right to make carries the right to sell, but not necessarily the right to use the machine when made and sold. Jenkins *v.* Greenwald, 2 *Fish.* 37; 1 *Bond*, 128; Bicknell *v.* Todd, 5 *McLean*, 236.

Where one licensed to run a patented machine sells such machine, the license to run does not necessarily pass with the machine. Wilson *v.* Stolley, 4 *McLean*, 275; 4 *West. L. J.* 412.

Unconditional sale of a patented article confers the whole title therein, and impliedly warrants full ownership on part of the vendor. Holliday *v.* Matheson, 24 *Fed. Rep.* 185; 30 *Pat. Off. Gaz.* 452; 31 *Id.* 1444.

105. *Territorial Limits of Buyer's Right.*

Where a patentee has assigned his right to manufacture, sell, and use within a limited district an instrument, machine or other manufactured product, one who buys from the assignee, within the limits of the district, one of such instruments or machines, acquires the right to use it anywhere, without reference to other assignments of rights for other territories which may have been made by the patentee. The right to use such machines or instruments stands on a different ground from the right to make and sell them, and inheres in the nature of a contract of purchase, which carries no implied limitation of the right of use within a given locality. Thus where the assignee, for a limited district, of a patent for an improvement in coffins, manufactured and sold, within the district, coffins containing the patented improvement, it was *held*, that the purchaser of a coffin could put it to use in an interment anywhere;

he was not restricted to a use of it within the district designated
assignment. Adams *v.* Burke, 17 *Wall.* 453; 1 *Pat. Off.*
aff'g 1 *Holmes*, 40; McKay *v.* Wooster, 5 *Am. L.*
Sawyer, 373; 3 *Pat. Off. Gaz.* 441; May *v.* Chaffee, 2
385; 5 *Fish. Pat. Cas.* 160.

If the vendor of a machine be an assignee of the patent for a
cified territory, the machines sold by him pass out of the mon-
ly, and the property sold passes from under the protection of
patent laws, and is subject, like other property, only to the operation of the laws of the State. Hawley *v.* Mitchell, 1 *Pat. Off. Gaz.* 306; 4 *Fish. Pat. Cas.* 388; 1 *Holmes*, 42.

One who purchases patented articles from a grantee of an exclusive right to manufacture and sell under the patent in a specified part of the United States, has not the right to sell the articles in the course of trade outside the designated limits covered by the grantee to his vendor. Hatch *v.* Adams, 22 *Fed. Rep'r*, 434; 29 *Pat. Off. Gaz.* 776. But see Hatch *v.* Hall, *Id.* 438; 30 *Pat. Off. Gaz.* 1096.

Where the owner of a patent sells the patented article, without restriction or conditions, in a foreign country, the use or sale of such patented article in this country, by a purchaser of it from the vendee of the patentee in the foreign country, is not an infringement of the patent. Holiday *v.* Matheson, 24 *Fed. Rep'r*, 185; 31 *Pat. Off. Gaz.* 1444. See previous decision, S. C., 30 *Pat. Off. Gaz.* 452.

106. *His Right, how limited by Term of Patent.*

The right acquired by a purchaser of the exclusive privilege of making or selling, in a particular place, a patented thing terminates at the time limited by the law which created it for its duration; unless the sale is expressly made broader. Bloomer *v.* McQuewan, 14 *How.* 539; Bloomer *v.* Millinger, 1 *Wall.* 340; Blanchard *v.* Whitney, 3 *Blatchf.* 307; Hawley *v.* Mitchell, 4 *Fish. Pat. Cas.* 388; 1 *Holmes*, 42; 1 *Pat. Off. Gaz.* 306.

The right to use a machine after the expiration of the patent is an incident to the right to use it during the original term; if that fails (here, on account of fraud), the incident falls with it. Union Paper-Bag Machinery Co. *v.* Nixon, 9 *Pat. Off. Gaz.* 691; 1 *Flippin*, 491; 2 *Mann. & A. Pat. Cas.* 244.

Articles manufactured without right during the lifetime of a

patent, cannot be lawfully sold after its expiration. Am. Diamond Rock Boring Co. *v.* Sheldon, 1 *Fed. Rep'r*, 870; 18 *Blatchf.* 50.

A manufacturer of a patented article after the expiration of the patent, has a right to represent that it is made according to the patent, and to use the name of the patentee for that purpose. Wilcox & Gibbs Sewing Machine Co. *v.* Gibbons Frame, 17 *Fed Rep'r*, 623; 24 *Pat. Off. Gaz.* 1272; 21 *Blatchf.* 431; see *ante*, p. 11.

VII. MARKING ARTICLES "PATENTED." FALSE MARKING.

107. *Patented Articles must be Marked as such.*

It shall be the duty of all patentees, and their assigns and legal representatives, and of all persons making or vending any patented article for or under them, to give sufficient notice to the public that the same is patented; either by fixing thereon the word "patented," together with the day and year the patent was granted; or when, from the character of the article, this cannot be done, by fixing to it, or to the package wherein one or more of them is inclosed, a label containing the like notice; and in any suit for infringement, by the party failing so to mark, no damages shall be recovered by the plaintiff, except on proof that the defendant was duly notified of the infringement, and continued, after such notice, to make, use, or vend the article so patented. *Rev. Stat.* § 4900.

The requirement of the above section,—that patented articles shall be marked with the word "patented," &c.,—may be sufficiently complied with, where the articles are so small that it is difficult to stamp them, by stamping and labeling the packages in which they are shipped and the invoices. Sessions *v.* Romadka, 21 *Fed. Rep'r*, 124; 28 *Pat. Off. Gaz.* 721.

Upon the trial of an action for infringement in which defendant claims the benefit of this section, the burden is in the first instance

upon the defendant to show that the plaintiff has made or sold articles under a patent, and has failed to mark them as required; and then the burden rests upon the plaintiff to show that defendant had notice that he was infringing. Goodyear *v.* Allyn, 6 *Blatchf.* 33; 3 *Fish. Pat. Cas.* 374.

It is not an excuse for a patentee's omission to mark a patented article as such, that such marking would have been expensive, and must have enhanced the price. The law exacts the marking, unless, from the character of the article, it cannot be done; the impossibility or impracticability is not made dependent on the question of pecuniary loss or gain to the patentee. Putnam *v.* Sudhoff, 1 *Bann. & A. Pat. Cas.* 198.

When ignorance of facts may excuse from statute penalties, discussed; and *held*, that one who manufactures an article which is not marked "patented," &c., without knowledge of the patent, is not liable in damages for so manufacturing; but becomes liable, upon acquiring notice, for manufacturing done afterward. Allen *v.* Deacon, 21 *Fed. Rep'r*, 122. What actual notice that an article is patented is equivalent to stamping it as patented, for the purpose of rendering an infringer liable, see New York Pharmical Assoc. *v.* Tilden, 14 *Fed. Rep'r.* 710; 23 *Pat. Off. Gaz.* 272; 15 *Rep'r.* 98.

The patentee may prove against one whom he sues as licensee but who denies the license, that the defendant marked the articles as patented; such mark is an acknowledgment that they were manufactured under a patent. Jones *v.* Vankirk, 2 *Fish. Pat. Cas.* 586.

108. *Penalty for Falsely Marking or Labeling Articles as "Patented."*

Every person who, in any manner, marks upon anything made, used, or sold by him for which he has not obtained a patent, the name or any imitation of the name of any person who has obtained a patent therefor without the consent of such patentee, or his assigns or legal representatives; or

Who, in any manner, marks upon or affixes to any such patented article the word "patent" or "patentee," or the words "letters patent," or any word of like import, with

intent to imitate or counterfeit the mark or device of the patentee, without having the license or consent of such patentee or his assigns or legal representatives ; or

Who, in any manner, marks upon or affixes to any unpatented article the word "patent," or any word importing that the same is patented, for the purpose of deceiving the public, shall be liable, for every such offense, to a penalty of not less than one hundred dollars, with costs ; one-half of said penalty to the person who shall sue for the same, and the other to the use of the United States, to be recovered by suit in any district court of the United States within whose jurisdiction such offense may have been committed. *Rev. Stat.* § 4901.

This section is to be strictly construed. It makes penal the *act of marking* only ; hence, taking the marked articles into another jurisdiction than that in which they were marked, with intent to sell them there, is not within its provisions. Such act cannot be regarded as a repetition or continuance of the original offense. Pentlarge *v.* Kirby, 19 *Fed. Rep'r*, 501.

The purpose of prohibiting under penalties the marking of an unpatented article is to prevent deceiving the public (Wilson *v.* Singer Manuf. Co., 9 *Biss.* 173 ; 16 *Pat. Off. Gaz.* 1091 ; 4 *Bann. & A. Pat. Cas.* 637) ; and in order to render a person liable, the marking must not only give the public to understand the fact of a patent, but it must be done *quo animo*, with intent to deceive. Walker *v.* Hawxhurst, 5 *Blatchf.* 494. The intent to create a belief in a present subsisting patent is necessary. If the patents marked upon the machine have all expired, and there is no subsisting patent upon the machine or any part of it, the offense is incomplete (Wilson *v.* Singer Manuf. Co., 12 *Fed. Rep'r*, 57 ; 11 *Biss.* 298 ; 28 *Int. Rev. Rec.* 176) ; as where the patentee continued to stamp the patented article with the word "patented" and the date when the patent was issued, after the patent had expired. Wilson *v.* Singer Manuf. Co., 9 *Biss.* 173 ; 16 *Pat. Off. Gaz.* 1091 ; 4 *Bann. & A. Pat. Cas.* 637, (See *ante*, pp. 10, 11). The question of the intent to deceive is for the jury. Walker *v.* Hawxhurst, *supra ;* Oliphant *v.* Salem Flouring Mills, 5 *Sawyer*, 128 ; 3 *Bann. & A. Pat. Cas.*

256. Whether the provision applies though the article is not of a patentable nature, so that in a legal point of view there cannot have been any deception, see Oliphant *v.* Salem Flouring Mills, *supra*; United States *v.* Morris, 2 *Bond*, 23; 3 *Fish. Pat. Cas.* 72.

The question of the liability of a corporation for the act of its superintendent in wrongfully affixing the word "patented" to an unpatented article is considered in the charge to the jury in the case of Tompkins *v.* Butterfield, 25 *Fed. Rep'r*, 556; 33 *Pat. Off. Gaz.* 758.

The second subdivision of the section does not include the case of a patented article stamped with the mark of a person who has no patent embracing or affecting the article stamped, but only a patent for a different article, and no penalty can be recovered therefor. French *v.* Foley, 11 *Fed. Rep'r*, 801. The remedy of the person whose mark is improperly used must be sought independent of this section (*Id.*); and the courts will restrain such unlawful use. Washburn, &c. Manuf. Co. *v.* Haish, 9 *Biss.* 141; 18 *Pat. Off. Gaz.* 465; 4 *Bann. & A. Pat. Cas.* 571.

The penalty "of not less than $100" imposed, means a penalty of $100 *only*. Stimpson *v.* Pond, 2 *Curt.* 502. The suit therefor must be brought in the name of the informer and not in that of the United States (United States *v.* Morris, 2 *Bond*, 23; 3 *Fish. Pat. Cas.* 78); however, it being a *qui tam* action, plaintiff may properly describe himself as suing for himself and the United States, and a demurrer for misjoinder of parties will not be sustained for so doing. Wimne *v.* Snow, 19 *Fed. Rep'r*, 507. Special injury is no part of the cause of action; averments of it may be struck out as irrelevant, under New York Code of Procedure, but are not ground of demurrer. *Ib.* Patentability of the article need not be shown. *Ib. Contra*, U. S. *v.* Morris, *supra*. Proof on the part of the plaintiff to make out his case beyond a reasonable doubt is not required. Hawlowetz *v.* Kass, 34 *Pat. Off. Gaz.* 1499; aff'g S. C., *nom.* Kass *v.* Hawlowetz, *Id.* 1135.

The plaintiff in an action for this penalty must prove beyond a reasonable doubt: 1. That the defendant affixed or caused to be affixed the word upon the article; 2. That he has no patent; 3. That he affixed the word with the intent to deceive the public. Nichols *v.* Newell, 1 *Fish.* 647.

VIII. CAVEATS.

109. *Filing and Effect of Caveats.*

Any citizen of the United States who makes any new invention or discovery, and desires further time to mature the same, may, on payment of the fees required by law, file in the patent office a caveat setting forth the design thereof, and of its distinguishing characteristics, and praying protection of his right until he shall have matured his invention. Such caveat shall be filed in the confidential archives of the office and preserved in secrecy, and shall be operative for the term of one year from the filing thereof; and if application is made within the year by any other person for a patent with which such caveat would in any manner interfere, the commissioner shall deposit the description, specification, drawings, and model of such application in like manner in the confidential archives of the office, and give notice thereof, by mail, to the person by whom the caveat was filed. If such person desires to avail himself of his caveat, he shall file his description, specifications, drawings, and model within three months from the time of placing the notice in the post-office in Wa hington, with the usual time required for transmitting it to the caveator added thereto; which time shall be indorsed on the notice. An alien shall have the privilege herein granted, if he has resided in the United States one year next preceding the filing of his caveat, and has made oath of his intention to become a citizen. *Rev. Stat.* § 4902.

A caveat, under the patent law, is a notice given to the office of the caveator's claim as inventor, in order to prevent the grant of a patent to another for the same alleged invention upon an applica-

tion filed during the life of the caveat without notice to the caveator. *Rules of Prac.* No. 189.

If at any time within one year after the filing or renewal of a caveat another person shall file an application with which such caveat would in any manner interfere, and if, within the year, the application shall be found patentable, then such application will be suspended, and notice thereof will be sent to the person filing the caveat, who, if he shall file a complete application within the prescribed time, will be entitled to an interference with the previous application, for the purpose of proving priority of invention, and obtaining the patent, if he be adjudged the prior inventor. The caveator, if he would avail himself of his caveat, must file his application within three months from the expiration of the time regularly required for the transmission to him of the notice deposited in the post-office at Washington; and the day when the time for filing expires will be mentioned in the notice or indorsed thereon. *Id.* No. 196.

The caveator will not be entitled to notice of any application pending at the time of filing his caveat, nor of any application filed after the expiration of one year from the date of the filing or renewal thereof. The caveat may be renewed by the payment of a second caveat fee of ten dollars, and it will continue in force for one year from the date of the payment of such second fee. Subsequent renewals may be made with like effect. If a caveat be not renewed, it will be preserved in the secret archives of the office. *Id.* No. 197.

A caveat answers a double purpose; first, to give notice of the inventor's claim, and second, to prevent a patent from issuing to another for the same thing. Allen *v.* Hunter, 6 *McLean*, 303.

The filing of a caveat is not necessary to preserve the right of an inventor to a patent; it only entitles him to notice of any interfering application. Heath *v.* Hildreth, *Curtis's Pat. Dec.* 96; 1 *MacArthur Pat. Cas.* 12. It protects the inventor filing it from all interfering applications made within one year after the filing it by requiring the office to notify him of such application so that he may resist the interference. Bell *v.* Daniels, 1 *Fish. Pat. Cas.* 372; 1 *Bond*, 212. In other words, its purpose is to save the inventor from the principle which awards the patent to him who first perfects and introduces the invention. Phelps *v.* Brown, 1 *Fish.* 479; 4 *Blatchf.* 362. It confers no rights and affords no protection except as to notice of an interfering application filed during its

life giving the caveator the opportunity of proving priority of invention if he so desires. *Rules of Prac.* No. 198. It may be used as evidence in contests. See *Id.* No. 150. But it is not conclusive evidence that the patent to which it relates, was not, at the time of filing, perfected. Johnson *v.* Root, 1 *Fish. Pat. Cas.* 351. If, during the interval between filing the caveat and applying for the patent, the inventor allows his invention to go into public use, the caveat will not protect him. Bell *v.* Daniels, *supra.* Or, if he delays or neglects to perfect his invention, and in the meantime some one else conceives the same idea and perfects it, the caveator cannot in virtue of his caveat appropriate what has thus been embraced in a practical machine between his caveat and his patent. Johnson *v.* Root, *supra.* An application for a patent cannot be prejudiced by the failure of the officers of the patent-office to give information of his application to a person who makes inquiry there in regard to it. Sparkman *v.* Higgins, 1 *Blatchf.* 205; 5 *N. Y. Leg. Obs.* 122; 6 *Pa. L. J.* 344. A failure of the commissioner to perform his duty of giving notice to the caveator of an interfering application will not be allowed to prejudice his right, but the commissioner may issue to him a junior patent to enable him to secure it. Phelps *v.* Brown, *supra.* And the fact that the earlier patent was granted while a caveat was pending and in force will not render the patent void. Cochrane *v.* Waterman, *Crauch Pat. Dec.* 121.

There is no provision of law making the caveat assignable; although the alleged invention therein set forth is assignable, and the caveat may be used as means of identifying the invention transferred in an assignment. *Rules of Prac.* No. 199.

Caveat papers cannot be withdrawn from the office after they have once been filed; but copies of the papers may be obtained at the usual rates by the caveator or any person duly authorized by him. Additional papers, if containing new matter, must be filed as a separate caveat with another fee. *Rules of Prac.* No. 200.

For decisions on the effect of caveats in particular cases, see Robertson *v.* Seconbe Manuf. Co. 10 *Blatchf.* 481; 3 *Pat. Off. Gaz.* 412; 6 *Fish. Pat. Cas.* 268; also, 4 *Pat. Off. Gaz.* 132; Goodyear Dental Vulcanite Co. *v.* Gardiner, 3 *Cliff.* 408; 4 *Fish. Pat. Cas.* 224; 5 *Pat. Off. Gaz.* 586.

110. *Requisites and Sufficiency.*

The caveat must comprise a specification, oath, and, when the nature of the case admits of it, a drawing, and, like the application, must be limited to a single invention or improvement. *Rules of Prac.* No. 192.

The same particularity of description is not required in a caveat as in an application for a patent; but the caveat must set forth the object of the invention and the distinguishing characteristics thereof, and it should be sufficiently precise to enable the office to judge whether there is a probable interference when a subsequent application is filed. If upon examination a caveat be found defective in this respect, amendment will be required. Without compliance with Rules 190, 192, 193 and 195, the caveator will not be entitled to the notice provided for in Rule 196. *Id.* No. 192.

The oath of the caveator must set forth that he is a citizen of the United States, or, if he be an alien, that he has resided for one year last past within the United States, and has made oath of his intention to become a citizen thereof, and that he believes himself the original and first inventor of the art, machine, or improvement set forth in his caveat. *Id.* No. 196.

When practicable, the caveat should be accompanied by full and accurate drawings, separate from the specification, well executed on tracing muslin or paper that may be folded.

Where the caveat contains no description or representation sufficient to enable a practical working apparatus to be made from it, and the ideas suggested by it do not appear to have been afterward developed, but a different plan is followed in a patent subsequently obtained by the party filing the caveat, such undeveloped suggestions are not sufficient to invalidate a subsequent patent to another party. Renwick *v.* Cooper, 6 *Fish. Pat. Cas.* 31; 10 *Blatchf.* 201.

That although a caveat be informal, yet if it is followed up with reasonable diligence and a patent is eventually granted for the invention, it will prevent any right from being acquired by another person, in the meantime,—see Sparkman *v.* Higgins, 1 *Blatchf.* 205; 5 *N. Y. Leg. Obs.* 122; 6 *Pa. L. J.* 344.

IX. REJECTIONS AND INTERFERENCES. MOTIONS. TESTIMONY.

111. *Notice of Rejection of Claim for Patent to be given to Applicant.*

Whenever, on examination, any claim for a patent is rejected, the commissioner shall notify the applicant thereof, giving him briefly the reasons for such rejection, together with such information and references as may be useful in judging of the propriety of renewing his application or of altering his specification; and if, after receiving such notice, the applicant persists in his claim for a patent, with or without altering his specifications, the commissioner shall order a re-examination of the case. *Rev. Stat.* § 4903.

A rejected application for letters-patent is no bar to a patent; at least not where there is no evidence to show that the alleged prior invention which it discloses was ever perfected or brought to practical use, or that it was not abandoned and never revived by the original inventor. Rubber Step Manuf. Co. *v.* Metropolitan R. R. Co., 13 *Pat. Off. Gaz.* 549.

If an application after rejection is renewed and granted, the date when it was first made, not that of its renewal, is taken as the date of application. Henry *v.* Francestown Soapstone Stove Co., 9 *Pat. Off. Gaz.* 408; 2 *Bann. & A. Pat. Cas.* 221.

A patent should not be granted for an invention every feature of which was shown and described, but not claimed, in a previous patent issued to the same applicant, a re-issue of which cannot be obtained because of undue delay. The omission, in the prior patent, to claim the invention, is a dedication of it to the public. Hill *v.* Commissioner of Patents, 34 *Pat. Off. Gaz.* 757. The mechanic who executes the conception of his employer is not entitled to a patent; even though he use inventive skill as well as mechanical dexterity in carrying out his employer's design. Wellman *v.* Blood, 1 *MacArthur Pat. Cas.* 432; Warner *v.* Goodyear, *Id.* 60; King *v.* Gedney, *Id.* 443.

The question whether a delay in an application should be construed as an abandonment, is for the determination of the jury as matter of fact; it is not made, by the act of 1836, a ground for refusal, by the commissioner, to grant a patent. Heath *v.* Hildreth, 1 *MacArthur Pat. Cas.* 12.

The decision of the commissioner of patents rejecting an application for a patent on the ground of abandonment of the invention is not final. Abandonment is a question of fact, and the decision is reviewable. This is so when the decision was made on renewal of an application equally as when made on the original application. United States Rifle, &c. Co. *v.* Whitney Arms Co., 14 *Blatchf.* 94; 11 *Pat. Off. Gaz.* 373; 2 *Bann. & A. Pat. Cas.* 493.

Upon the abolition, by the act of 1839, of the board of examiners created by the act of 1836, the original jurisdiction of the board vested in the commissioner of patents; and under sections 6 and 7 of the act of 1836, he was authorized to investigate and determine questions of public use of an alleged invention arising upon an application for a patent. The negative requirement—that the invention has not been in the public use or on sale, &c., stands in the statute in the same category with the other requisites, and their existence is to be determined by the commissioner according to a due course of proceeding had by him. Hunt *v.* Howe, 1 *MacArthur Pat. Cas.* 366; Mowry *v.* Barber, *Id.* 563. And see Ellithorp *v.* Robertson, *Id.* 585.

Proof of a public use of a device for two years prior to the application (Act of 1839, § 7) requires the commissioner to reject the application. Rugg *v.* Haines, 1 *MacArthur Pat. Cas.* 420.

The commissioner of patents was authorized, under section 7 of the act of 1839, to reject an application for a patent upon proof that the invention had been abandoned to the public. Mowry *v.* Barber, 1 *MacArthur Pat. Cas.* 563; Ellithorp *v.* Robertson, *Id.* 585; Same *v.* Same, *Id.* 634; Wickersham *v.* Singer, *Id.* 645, 678.

The withdrawal of an application for a patent and the return of part of the patent fee is not of itself an abandonment or dedication of the invention to the public; but is an equivocal act, to be interpreted by surrounding circumstances, and to be affected upon a second application by the subsequent conduct of the party—his diligence or his neglect or delay—in the same manner as his conduct is to be weighed in regard to an original application. Wickersham *v.* Singer, 1 *MacArthur Pat. Cas.* 645, 689.

The rejection by the commissioner of patents, of the application of Wickersham for a patent for improvements in the feed mechanism of sewing machines, upon an interference with patents issued to Singer—affirmed, upon appeal, notwithstanding Wickersham appeared to have been the prior inventor, on the grounds that he had abandoned the invention by failing to use due diligence in applying for and prosecuting his application for a patent; that his application subsequent to that of Singer, did not, under the circumstances, relate back to the date of an earlier application; and that the invention had been in public use, with his knowledge and consent, more than two years before his second application. Wickersham *v.* Singer, 1 *McArthur Pat. Cas.* 645.

112. *Statement of Reasons and References.*

If, upon the re-examination, the application is again rejected, the reasons therefor will be fully and precisely stated. See *Rules of Prac.* Nos. 64, 89.

The rules further provide that upon the rejection of an application for want of novelty, the examiner must cite the best references at his command. If patents be cited, their dates and numbers, the names of the patentees, and the classes of invention must be stated. When the reference shows or describes inventions other than that claimed by the applicant, the particular part relied on will be designated as nearly as practicable. The pertinence of the reference, if not obvious, must be clearly explained and the anticipated claim specified. If printed publications be cited, the title, date, page, or plate, and place of publication, or place where a copy can be found, will be given. When reference is made to facts within the personal knowledge of an employé of the office, the data will be as specific as possible, and the reference must be supported by the affidavit of such employé, which shall be subject to contradiction, explanation, and corroboration by the affidavits of the applicant and other persons. If the patent or other printed matter, plates, or drawings, so referred to, are in the possession of the office, copies will be furnished at cost upon the order of the applicant. *Rules of Prac.* No. 65; and see *Id.* 171. And whenever, in the treatment of an *ex parte* application, an adverse decision is made upon any preliminary or intermediate question, without the rejection of any claim, notice thereof, together with the reasons therefor, will be given to the applicant, in order that he may judge of the propriety

of the action. If, after receiving such notice, he traverse the propriety of the action, the matter will be reconsidered. *Id.* No. 66.

113. *Interferences.*

Whenever an application is made for a patent which, in the opinion of the commissioner, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be, and shall direct the primary examiner to proceed to determine the question of priority of invention. And the commissioner may issue a patent to the party who is adjudged the prior inventor, unless the adverse party appeals from the decision of the primary examiner, or of the board of examiners-in-chief, as the case may be, within such time, not less than twenty days, as the commissioner shall prescribe. *Rev. Stat.* § 4904.

114. *What constitutes an Interference.*

An interference is a proceeding instituted for the purpose of determining the question of priority of invention between two or more parties claiming substantially the same patentable invention. *Rule of Prac.* No. 92.

Two patents "interfere" only when they claim, wholly or partially, the same invention. Wold, &c., Separating Co. *v.* United States Disintegrating Ore Co., 6 *Blatchf.* 307; 3 *Fish. Pat. Cas.* 489. The provision of *Rev. Stat.* § 4918, respecting interfering patents, cannot be invoked, unless it is asserted that the two patents are substantially for the same invention; that the patentee, in whose behalf the statute is pleaded, is the real discoverer of the invention therein set forth; and that the defendant has wrongfully appropriated the fruits of his invention. Celluloid Manuf. Co. *v.* Goodyear Dental Vulcanite Co., 10 *Pat. Off. Gaz.* 1. Interferences are confined by the statute to cases where an applicant claims that for which a patent has already been granted, or that which is claimed or can be claimed in a previous pending application. Hence a reissue applicant cannot be placed in interference with an unexpired patent in which the record-date of original

application filed is subsequent to that of the reissue patentee, and which does not claim the subject-matter in conflict. *Exp.* Platts, 15 *Pat. Off. Gaz.* 827.

115. *When Declared.*

Interferences will be declared in the following cases, when all the parties claim substantially the same patentable invention: 1. Between two or more original applications. 2. Between an original application and an unexpired patent, when the applicant, having been rejected on the patent, shall file an affidavit showing that he made the invention before the patentee's application was filed. 3. Between an original application and an application for the reissue of a patent granted during the pendency of such original application. 4. Between an original application and a reissue application, when the original applicant shall file an affidavit showing that he made the invention before the patentee's original application was filed. 5. Between two or more applications for the reissue of patents granted on applications pending at the same time. 6. Between two or more applications for the reissue of patents granted on applications not pending at the same time, when the applicant for reissue of the latter patent shall file an affidavit showing that he made the invention before the application on which the earlier patent was granted was filed. 7. Between a reissue application and an unexpired patent, if the original applications were pending at the same time, and the reissue applicant shall file an affidavit showing that he made the invention before the original application of the other patentee was filed. 8. Between an application for reissue of a later unexpired patent and an earlier unexpired patent granted before the original application of the latter patent was filed, if the reissue applicant shall file an affidavit showing that he made the invention before the original application of the earlier patent was filed. *Rules of Prac.* No. 93.

The fact that one of the parties has already obtained a patent will not prevent an interference; for, although the commissioner has no power to cancel a patent, he may grant a patent for the same invention to another person who proves to be the prior inventor. *Id.* No. 92.

116. *When Refused.*

An applicant whose foreign patent is antecedent to any record date of the domestic patent cited in refusal of the application, is entitled to the issue of his patent, without interference; when the domestic patent makes no claim to the common subject-matter. *Exp.* Bland, 15 *Pat. Off. Gaz.* 828.

A claim, by an applicant for a patent, of that which is shown but not claimed in a previous patent, is not ground for declaring an interference. Marvin *v.* Lillie, 27 *Pat. Off. Gaz.* 299.

An interference should not be declared merely because the purpose of both parties is the same, and both have invented improved means which are supposed to be adequate for the purpose, unless the means are substantially the same. That the specification of one party is, in some of its terms, broad enough to cover some of the forms of the invention of the other, is not conclusive. O'Reilly *v.* Smith, 1 *MacArthur Pat. Cas.* 218.

No interference will be declared between pending applications, nor between a pending application and an unexpired patent, unless there are conflicting claims; but where an application is involved in an interference in part and shows and describes, without claiming, a patentable invention claimed by another party thereto, the applicant may, at any time within twenty days after the statements of the parties have been received and approved, on motion duly made, as provided in Rule 149, file an amendment of his application duly claiming such invention, and on the admission of such amendment the invention shall be included in the interference. [Subsequent proceedings thereon prescribed.] *Id.* No. 94.

Before the declaration of interference all preliminary questions must be settled by the primary examiner, and that issue must be clearly defined; the invention which is to form the subject of the controversy must be decided to be patentable, and the claims of the respective parties must be put in such condition that they will not require alteration after the interference shall have been finally decided, unless the testimony adduced upon the trial shall necessitate or justify such change. *Id.* No. 95.

Where, however, a party who is required to put his case in a condition proper for an interference fails to do so within a reasonable time specified, the declaration of interference will not be delayed. After final judgment of priority the application of such

party will be held for revision and restriction, subject to interferences with other applications or new references. *Id.* No. 46; and see *Id.* No. 93.

117. *Examiner of Interferences. Notices. Disclaimer.*

When an interference is found to exist and the applications are prepared therefor, the primary examiner will forward to the examiner of interferences, together with the files and drawings, notices of interference for all the parties, as specified in Rule 102 (*post*, p. 155), which will disclose the name and residence of each party and that of his attorney, and if any party, as such, be a patentee, the date and number of the patent, and the date of its application, the ordinals of conflicting claims, and the invention claimed, which shall be clearly and concisely defined, in so many counts or branches as may be necessary in order to include all interfering claims. Whenever it shall be found that two or more parties whose interests are in conflict are represented by the same attorney, the examiner in charge will notify each of said principal parties, and also the attorney, of this fact. *Rules of Prac.* No. 97.

Upon receipt of the notices of interference, the examiner of interferences will make an examination thereof, in order to ascertain whether the issue between the parties has been clearly defined, and whether it is otherwise correct. If he be of opinion, upon such examination, that the notices are ambiguous in this particular, or are imperfect in any material point, he will transmit his objections to the primary examiner, who will promptly notify him of his decision to amend or not to amend them. *Id.* No. 98.

In case of a material disagreement between the examiner of references and the primary examiner, they shall refer the points of difference to the commissioner for decision. *Id.* No. 99.

The primary examiner will retain jurisdiction of the case until the declaration of interference is made. *Id.* No. 100.

When the notices of interference have been settled, the examiner of interferences will add thereto a designation of the time within which the statements required by Rule 105 (*post*, p. 156) must be filed, and will, *pro forma*, institute and declare the interference by forwarding the notices to the several parties to the interference. *Id.* No. 101.

Notices of interference will be forwarded by the examiner of interferences to all the parties, or to their attorneys, or, in case the

application or patent in interference has been assigned, to the assignees. When one of the parties has received a patent, a notice will be sent to the patentee and to his attorney of record. When one of the parties resides abroad and has no known agent in the United States, notice, in addition to that sent by mail, may be given by publication in the *Official Gazette* for such period of time as the commissioner may direct. *Id.* No. 102.

Upon the institution and declaration of the interference, as provided in Rule 101 (*ante*, p. 154), the examiner of the interferences will take jurisdiction of the same, which will then become a contested case; but the primary examiner will determine the motions mentioned in Rule 116 (*ante*, p. 158), as herein provided. *Id.* No. 103.

An applicant involved in an interference may, with the written consent of the assignee, when there has been an assignment, before the date fixed for the filing of his statement, in order to avoid the continuance of the interference, disclaim under his own signature, attested by two witnesses, the invention of the particular matter in issue, and upon such disclaimer and the cancellation of any claims involving such interfering matter judgment shall be rendered against him, and the disclaimer shall be embodied in and form part of his specification. *Id.* 104.

118. *Preliminary Statements.*

Each party to the interference will be required to file a concise statement, under oath, showing the date of his original conception of the invention, of the making of a drawing, of the making of a model, of its disclosure to others, of its reduction to practice, and of the extent of its use. The parties will be strictly held in their proof to the dates set up in their statements. The statement must be sealed up before filing (to be opened only by the examiner of interferences), and the name of the party filing it, the title of the case, and the subject of the invention indicated on the envelope. The statements shall not be opened to the inspection of the opposing parties until both shall have been filed, or the time for filing both with any extension thereof shall have expired, nor then unless they have been examined by the proper officer and found to be satisfactory. When the invention was made abroad the statement should set forth when and where, if ever, the invention was patented (giving the date and number of the patent) and when, if ever,

it was described in a printed publication (giving the title, date and place of publication), and when, if ever, it was introduced, or knowledge of it was introduced, into this country (giving the circumstances which are thought to establish the facts thereof). *Rules of Prac.* No. 105.

If, on such examination, a statement is found to be defective in any particular, the party shall be notified of the defect, and a time assigned within which he must cure such defect by an amended statement; but in no case will any original or amended statement be returned after it has been once filed. If a party shall refuse to file the amended statement herein referred to, he will be restricted to his record date in the further proceedings in the case. *Id.* No. 106.

If the junior party to an interference fail to file a statement, or if his statement fail to overcome the *prima facie* case made by the respective dates of application, the other may demand an immediate adjudication of the case upon the record. When there are more than two parties to the interference, and any one of them fails to file his statement, judgment may be rendered upon the record as to the party failing to file his statement, unless he be the senior party, and the interference will proceed between the remaining parties. *Id.* 107.

If any party to an interference fail to file a statement, no testimony will subsequently be received from him to prove that he made the invention at a date prior to his application. The statement can in no case be used as evidence in behalf of the party making it. *Id.* No. 108.

If either party require a postponement of the time for filing the statements, he will present his motion duly served on the other parties, with his reasons therefor, supported by affidavit, prior to the day previously fixed upon. But the examiner of interferences may, in his discretion, dispense with service of notice of such motion. *Id.* No. 109.

In case of material error in the statement, arising through inadvertence or mistake, it may be corrected on motion, upon showing to the satisfaction of the commissioner that its correction is essential to the ends of justice. The motion to correct the statement must be made, if possible, before the taking of any testimony, and as soon as practicable after the discovery of the error. *Id.* No. 110.

119. *Presumptions and Evidence.*

In original proceedings in cases of interference the several parties will be presumed to have made the invention in the chronological order in which they filed their completed applications for patents clearly illustrating and describing the invention; and the burden of proof will rest upon those who shall seek to establish a different state of facts. *Rules of Prac.* No. 111.

A time will be assigned in which the junior applicant shall complete his testimony in chief, and a further time in which the other party shall complete the testimony on his side, and a further time in which the junior applicant may take rebutting testimony, but shall take no other. If there be more than two parties, either patentees or applicants, the times for taking testimony will be so arranged that each shall have an opportunity to prove his case against prior applicants and to rebut their evidence, and also to meet the evidence of junior applicants. *Id.* No. 112.

If either party fail to take his testimony within the time assigned to him, all junior applicants having duly taken theirs, the case may, on motion duly made and served on such party, be set for hearing at any time not less than ten days after the hearing of the motion. *Id.* No. 113.

Powers of the commissioners in cases of interferences, and the usual practice of the office in respect to such cases, stated. Potter *v.* Dixon, 2 *Fish. Pat. Cas.* 381; Hanford *v.* Westcott, 16 *Pat. Off. Gaz.* 1181; United States *v.* Thatcher, 2 *MacArthur*, 24.

The rules as to the admissibility of evidence in an interference are the same as at common law. Nichols *v.* Harris, 1 *MacArthur Pat. Cas.* 302.

The applicant in an interference must show that he was the first original inventor, and it is not sufficient to show that he was an original inventor merely. Spain *v.* Gamble, 1 *MacArthur Pat. Cas.* 358.

Admissions of an applicant in derogation of his rights, made *ante litam motam*, are admissible against him in the interference proceedings. Clarke *v.* Cramer, 1 *MacArthur Pat. Cas.* 473.

In an interference case, the fact of invention, and not a knowledge of the degree of its utility, is the proper subject of inquiry. If a party omit to test the value of his invention, and fail to bring it into use, and himself remain ignorant of the extent of its value, yet if it be the same with that of a subsequent discoverer, he is

entitled to a patent over the latter. Farley *v.* National Steam-Gauge Co., 1 *MacArthur Pat. Cas.* 618.

120. *Motions and Incidental Practice.*

If either party desire to have the hearing postponed, he will make application for such postponement by motion, and will show sufficient reason therefor by affidavit. *Rules of Prac.* No. 114; see *Id.* 149.

If either party desire an enlargement of the time assigned to him for taking testimony, he will make application therefor as provided for in Rule 150, subd. 5. *Id.* No. 115.

Motions to dissolve an interference upon the ground that no interference in fact exists, or that there has been such irregularity in declaring the same as will preclude a proper determination of the question of priority between the parties, or which deny the patentability of an applicant's claim, should, if possible, be made within twenty days after the statements of the parties have been received and approved. Such motions, when in proper form, will be transmitted by the examiner of interferences, with the files and papers, to the proper primary examiner for his determination, and he will return the files and papers to the examiner of interferences, with his decision, at the expiration of the time limited for appeal if no appeal shall have been taken, or sooner if the party entitled to appeal shall file a waiver in writing of his right of appeal, and such decision will be binding on the examiner of interferences unless reversed or modified on appeal. *Id.* No. 116; see *Id.* 118.

All lawful motions, except those mentioned in Rule 116, will be made before and determined by the tribunal having jurisdiction at the time. The filing of motions will not operate as a stay of proceedings in any case. To effect this, motion should be made before the tribunal having jurisdiction of the interference, which will, sufficient grounds appearing therefor, order a suspension of the interference pending the determination of such motion. *Id.* 117.

Appeal may be taken directly to the commissioner from decisions on all motions, except motions to dissolve interferences denying the patentability of applicants' claims, or their right to make the claims, and other lawful motions involving the merits of the case, which, when appealable, may be appealed to the board of examiners-in-chief. From a decision affirming the patentability of

e claim or the applicant's right to make the same no appeal can taken. *Id.* No. 118.

After the interference is finally declared, it will not, except as herein otherwise provided, be determined without judgment of priority founded either upon the testimony, or upon a written concession of priority by one of the parties, signed by the inventor himself, and also, in the case of an assignment, by the assignee, or upon a written declaration of abandonment of his application, as provided by Rule 165. *Id.* No. 119.

In their decision of the question of priority, or before such decision, the examiner of interferences and the examiners-in-chief will direct the attention of the commissioner to any matter not relating to priority which may have come to their notice, and which, in their opinion, establishes the fact that no interference exists, or that there has been irregularity in declaring the same (Rule 116), or which amounts to a statutory bar to the grant of a patent to either of the parties for the claim or claims in interference. The commissioner may, before judgment on the question of priority of invention, suspend the interference and remand the case to the primary examiner for his consideration of the matters to which attention has been directed, and his decision will be subject to appeal, as in other cases. If the case shall not be so remanded, the primary examiner will, after judgment, consider any matter affecting the rights of either party to a patent which may have been called to his attention, unless the same shall have been previously disposed of by the commissioner. *Id.* No. 120; see *Id.* No. 116.

A second interference will not be declared upon a new application on the same invention filed by either party, nor will a decision be set aside after judgment, except in accordance with the principles governing the granting of new trials. *Id.* No. 121.

If at any time during the pendency of an interference the primary examiner discover new references, he may request a suspension of the interference for their consideration *ex parte* until their pertinency shall be determined, when the files and papers will be returned to the examiner of interferences and the interference dissolved or reinstated in accordance with such determination. *Id.* No. 122.

The primary examiner may request a suspension of an interference for the purpose of adding new parties; but no new parties will be added after the taking of testimony without the special order of the commissioner. *Id.* No. 123.

No amendments to the specification will be received during the pendency of an interference, except as provided in Rules 94, 104, 125. *Id.* No. 124.

When a part only of the claims of an application are involved in an interference, the applicant may withdraw from his application the claims adjudged not to interfere, and file a new application therefor, if the application can be legitimately divided, and if no more of the devices claimed in one is shown or described in the other than is necessary to an intelligent understanding of the invention claimed in the latter: Provided, That no claim shall be made in the second application, broad enough to include matter claimed in the first application as amended. *Id.* No. 125; see *Id.* No. 42.

When applications are declared to be in interference, the interfering parties will be permitted to see or obtain copies of the interfering claims, and of so much of the specifications as relate thereto, after the statements referred to in Rule 105 have been received and approved; but no information of an application will be furnished by the office to an opposing party, except as provided in Rules 97 and 102, until after the approval of such statement. *Id.* No. 126.

When it shall appear, on motion duly made, and upon satisfactory proof, that, by reason of the inability or refusal of the inventor to prosecute or defend an interference, or from other cause, the ends of justice shall require that an assignee of an undivided interest in the invention be permitted to prosecute or defend the same, the commissioner may so order. *Id.* No. 127.

121. *Principles of Decision.*

In an interference between an applicant and a patentee, the only question raised is whether the former was the prior inventor. Warner *v.* Goodyear, 1 *MacArthur Pat. Cas.* 60; Burlew *v.* O'Neil, *Id.* 168.

The jurisdiction of the commissioner in an interference is not limited to the naked question of priority; he may inquire into the patentability of the invention and determine questions relating to the public use and abandonment. Hunt *v.* Howe, 1 *MacArthur Pat. Cas.* 366.

Upon an objection, in interference proceedings, to a specification, as being vague and indefinite, the construction to be given to the specification should not be too strict and technical; if it communicates to the public the manner of carrying the invention into

effect, so that a skillful workman can carry into execution the plan of the inventor, it is sufficient. Stephens *v.* Salisbury, 1 *MacArthur Pat. Cas.* 379.

Where, in an interference proceeding, it appears that the idea or suggestion of the invention was communicated by one of the parties to the other, by whom it was practically applied, producing the desired result, the former is the sole inventor; and the latter can acquire no right to the invention by the failure of the real inventor to perfect it with due diligence. Stearns *v.* Davis, 1 *MacArthur Pat. Cas.* 696.

A decision upon the question of interference is necessary to confer jurisdiction upon the question of priority; and the jurisdictional matter must be first determined. Bain *v.* Morse, 1 *MacArthur Pat. Cas.* 90; Stephenson *v.* Hoyt, *Id.* 292.

An application for a patent may be rejected on the ground of interference, although the invention of the applicant may be a better and improved mode of accomplishing the object of the patented invention, if the former be a substantial interference with the principle of the latter. Stephenson *v.* Hoyt. 1 *MacArthur Pat. Cas.* 292.

122. *Effect of Commissioner's Decision.*

Even where an interference is claimed, and as against the parties to that hearing, the commissioner's decision is not conclusive. Upon reasoning and on authority the new patent granted after a hearing merely makes out a *prima facie* case for the successful applicant. Union Paper Bag Machine Co. *v.* Crane, 1 *Holmes*, 429; 6 *Pat. Off. Gaz.* 80; 1 *Bann. & A. Pat. Cas.* 494.

The decisionof the patent-office upon an interference proceeding is sufficient to entitle the successful party, as against the defeated party or his privies, to a preliminary injunction upon the question of priority of invention; but the defeated party is not precluded from raising in another action the question of novelty. Smith *v.* Halkyard, 23 *Pat. Off. Gaz.* 1832; 16 *Fed. Rep'r*, 414.

An interference in the patent-office in which priority of invention was awarded against the patent in suit does not conclude the complainant from maintaining an action thereon, if the parties are not the same. Perry *v.* Starrett, 14 *Pat. Off. Gaz.* 599; 3 *Bann. & A. Pat. Cas.* 485

The decision of the commissioner on a question of interference

will be sustained in the courts, and a preliminary injunction granted according to the priority of right as declared by him, unless it is shown to have been manifestly wrong. Pentlarge *v.* Beeston, 14 *Blatchf.* 352 ; 3 *Bann. & A. Pat. Cas.* 142.

The decision of the patent-office in an interference suit as to the priority of a certain invention binds the assignees of the inventors and purchasers from them. Peck, &c. Co. *v.* Lindsay, 2 *Fed. Rep'r*, 688 ; 18 *Pat. Off. Gaz.* 63 ; 5 *Bann. & A. Pat. Cas.* 300.

The decision of the patent office in favor of one of the parties in interference proceedings is not conclusive as an adjudication upon the question of priority of invention between them, in a suit between them as interfering patents under Rev. Stat. § 4918. Hubel *v.* Tucker, 24 *Fed. Rep'r*, 701.

123. *Affidavits and Depositions.*

The commissioner or patents may establish rules for taking affidavits and depositions required in cases pending in the patent-office, and such affidavits and depositions may be taken before any officer authorized by law to take depositions to be used in the courts of the United States, or of the State where the officer resides. *Rev. Stat.* § 4905.

The following rules have been established for taking and transmitting testimony in extensions, interferences, and other contested cases ;

1. Before the depositions of witnesses are taken by either party due notice shall be given to the opposite party, as hereinafter provided, of the time and place when and where the depositions will be taken, of the cause or matter in which they are to be used, and of the names and residences of the witnesses to be examined, so that the opposite party shall have full opportunity, either in person or by attorney, to cross-examine the witnesses. If the opposite party shall attend the examination of witnesses not named in the notice, and shall either cross-examine such witnesses or fail to object to their examination, he shall be deemed to have waived any objection to their examination based on want of notice thereof.

Neither party shall take testimony in more than one place at the same time, or so nearly at the same time as not to allow reasonable time to travel from one place of examination to the other.

2. The notice for taking testimony or for motions must be served (unless otherwise stipulated in an instrument in writing filed in the case) upon the attorney of record, if there be one, or, if there be no attorney of record, then upon the adverse party; and it must give the opposite party reasonable time to reach the place of examination. Such service may be made by delivering a copy of the notice to the adverse party or attorney, by leaving a copy at the usual place of business of the party or attorney with some one in the employment of such party or attorney, or by leaving a copy at the party's usual place of residence with a member of his family, or by transmission by registered letter, or by express, or when it shall be shown, to the satisfaction of the commissioner, that neither of the other modes of service herein prescribed is practicable, by publication in the *Official Gazette;* and such notice shall, with sworn proof of the fact, time, and mode of service thereof, be attached to the deposition or depositions, whether the opposing party shall have cross-examined or not.

3. Each witness before testifying shall be duly sworn according to law by the officer before whom his deposition shall be taken. The depositions shall be carefully read over by the witness, or by the officer in his hearing, and shall then be subscribed by the witness, in the presence of the officer. The officer shall annex to the deposition his certificate showing, (1) the due administration of the oath by the officer to the witness before the commencement of his testimony; (2) the name of the person by whom the testimony was written out, and the fact that, if not written by the officer, it was written in his presence; (3) the presence or absence of the adverse party; (4) the place, day and hour of commencing and taking the depositions; and (5) the fact that the officer was not connected, by blood or marriage, with either of the parties, nor interested directly or indirectly in the matter in controversy. The officer shall sign the certificate and affix thereto his seal of office, if he have such seal. He shall then, without delay, securely seal up all the evidence, notices, and paper exhibits, inscribe upon the envelope a certificate, giving the title of the case, the name of each witness, and the date of sealing, address the package, and forward the same to the commissioner of patents. If the weight or bulk of an exhibit shall exclude it from the mails, it shall be authenticated by the officer and transmitted in a separate package, marked and addressed as above provided.

4. In cases of extension, where no opposition shall be made, *ex*

parte testimony will be received from the applicant; and such testimony as may have been taken by the applicant prior to notice of opposition will be received unless taken within thirty days after filing the petition for the extension. But upon receiving notice of opposition, the applicant shall immediately give notice to the opposing party or parties of the names and residences of the witnesses whose testimony shall have been thus taken.

5. If either party shall be unable to procure the testimony of a witness within the time limited, any motion which he may make for an extension of his time must be accompanied by a statement, under oath, of the cause of such inability, the name of such witness, the facts expected to be proved by him, the steps which have been taken to procure said testimony, and the dates at which efforts have been made to procure it.

6. When a party relies upon a caveat to establish the date of his invention, the caveat itself, or a certified copy thereof, must be filed in evidence, with due notice to the opposite party.

7. Upon notice given to the opposite party before the closing of the testimony, any official record, and any special matter contained in a printed publication, if competent evidence and pertinent to the issue, may be used as evidence at the hearing. *Rules of Prac.* No. 150.

The pages of each deposition must be numbered consecutively, and the name of the witness plainly and conspicuously written at the top of each page. The testimony must be taken upon legal-cap or foolscap paper, with a wide margin on the left-hand side of the page, and with the writing on one side only of the sheet. *Id.* No. 151.

The testimony will be taken in answer to interrogatories, with the questions and answers committed to writing in their regular order by the officer, or, in his presence, by some person not interested in the case, either as a party thereto or as attorney. But, with the written consent of the parties, the depositions may be written out by other persons in the presence of the officer. No officer who is connected by blood or marriage with either of the parties, or interested, directly or indirectly, in the matter in controversy, either as counsel, attorney, agent, or otherwise, is competent to take depositions, unless with the written consent of all the parties. *Id.* 152.

By leave of the commissioner, first obtained, testimony may be taken in foreign countries:

1. Such permission will be granted only upon motion duly made. *Id.* No. 153; See *Id.* No. 140.

The motion must designate a place for the examination of the witnesses, at which an officer duly qualified to take testimony under the laws of the United States in a foreign country shall reside, and it must be accompanied by a statement, under oath, that the mention is made in good faith, and not for purposes of delay or of vexing or harassing any party to the case; it must also set forth the names of the witnesses, the particular facts to which it is expected each will testify, and the grounds on which is based the belief that each will so testify.

2. It must appear that the testimony desired is material and competent, and that it cannot be taken in this country at all, or cannot be taken here without hardship and injury to the moving party greatly exceeding that to which the opposite party will be exposed by the taking of such testimony abroad.

3. Upon the granting of such motion, a time will be set within which the moving party shall file in duplicate the interrogatories to be propounded to each witness and serve a copy of the same upon each adverse party, who may, within a designated time, file, in duplicate, cross-interrogatories. Objections to any of the interrogatories may be filed at any time before the depositions are taken, and will be considered and determined upon the hearing of the case.

4. As soon as the interrogatories and cross-interrogatories are decided to be in proper form, the commissioner will cause them to be forwarded to the proper officer, with the request that, upon payment of, or satisfactory security for, his official fees, he notify the witnesses named to appear before him within a designated time and make answer thereto under oath; and that he reduce their answers to writing, and transmit the same, under his official seal and signature, to the commissioner of patents, with the certificate prescribed in Rule 150, subd. 3.

5. By stipulation of the parties the requirements of paragraph 3, as to written interrogatories and cross-interrogatories may be dispensed with, and the testimony may be taken before the proper officer upon oral interrogatories by the parties or their agents.

6. Unless false swearing in the giving of such testimony before the officer taking it shall be punishable as perjury, under the laws of the foreign state where it shall be taken, it will not stand on the same footing, in the patent-office, as testimony duly taken in the

United States; but its weight in each case will be determined by the tribunal having jurisdiction of such case.

No evidence touching the matter at issue will be considered on the hearing which shall not have been taken and filed in compliance with these rules. But no notice will be taken of any merely formal or technical objection which shall not appear to have wrought a substantial injury to the party raising it; and in case of such injury it must be made to appear that, as soon as the party became aware of the ground of objection, he gave notice thereof to the office, and also to the opposite party, informing him at the same time that, unless it should be removed, he should urge his objection at the hearing. This rule is not to be so construed as to modify established rules of evidence, which will be applied strictly in all practice before the office. *Id.* No. 154.

The law requires the clerks of the various courts of the United States to issue subpœnas to secure the attendance of witnesses whose depositions are desired as evidence in contested cases in the patent-office. *Id.* No. 155.

After testimony is filed in the office it may be inspected by any party to the case, but it cannot be withdrawn for the purpose of printing. It may be printed by some one specially designated by the office for that purpose, under proper restrictions. *Id.* No. 156.

Six or more printed copies of the testimony must be furnished—five for the use of the office, and one for the use of each of the opposing parties. The statement required by Rule 105 must be printed as a part of the record. These copies must be filed not less than one week before the day of hearing. They will have wide margins, with the names of the witnesses at the top of the pages over their testimony, and will contain indexes with the names of all witnesses, and references to the pages where their testimony may be found, and also to the pages where copies of papers and documents introduced as exhibits are shown. Printing can only be dispensed with on special application based upon satisfactory reasons, in which case manuscript copies must be furnished—one for the office and one for each adverse party. *Id.* No. 157.

It is desirable that arguments and briefs in all contested cases should be submitted in printed form, and filed before the hearing. If either party fail to comply with this regulation, no extension of time will be granted for the purpose, except upon consent of the adverse parties. *Id.* 158.

Rules to govern the taking and transmission of evidence, made

by the commissioner in conformity to statutory provisions, have all the binding force of statutes; both as regards the commissioner himself and parties litigant before him. Arnold *v.* Bishop, 1 *MacArthur Pat. Cas.* 27. And no notice of the taking of testimony before the examiner is waived by an appearance and cross-examination. *Ib.*

An objection to the formal sufficiency of a deposition must be raised at the hearing before the commissioner or it is unavailable on appeal. But the deposition may be considered on an application for an adjournment, although too informal to be admissible on final hearing. Smith *v.* Flickmyer, 1 *MacArthur Pat. Cas.* 46.

Informality in the caption of a deposition is not waived by a notice to have the deposition produced before the commissioner for inspection. Perry *v.* Cornell, 1 *MacArthur Pat. Cas.* 66.

Depositions taken in an interference may be used in a subsequent interference, when the issue is the same and the parties or their predecessors in title are the same. McCormick *v.* Howard, 1 *MacArthur Pat. Cas.* 238; Carter *v.* Carter, *Id.* 388.

Depositions used upon the original hearing before the commissioner may be used upon a re-hearing against a new party who came in subsequently to the taking of them. Carter *v.* Carter, 1 *MacArthur Pat. Cas.* 388.

124. *Subpœnas to Witnesses.*

The clerk of any court of the United States, for any district or Territory wherein testimony is to be taken for use in any contested case pending in the patent-office, shall, upon the application of any party thereto, or of his agent or attorney, issue a subpœna for any witness residing or being within such district or Territory, commanding him to appear and testify before any officer in such district or Territory authorized to take depositions and affidavits, at any time and place in the subpœna stated. But no witness shall be required to attend at any place more than forty miles from the place where the subpœna is served upon him. *Rev. Stat.* § 4906

125. *Witness Fees.*

Every witness duly subpœnaed and in attendance shall be allowed the same fees as are allowed to witnesses attending the courts of the United States. *Rev. Stat.* § 4907.

126. *Penalty for failing to Attend, or refusing to Testify.*

Whenever any witness, after being duly served with such subpœna, neglects or refuses to appear, or after appearing refuses to testify, the judge of the court whose clerk issued the subpœna may, on proof of such neglect or refusal, enforce obedience to the process, or punish the disobedience, as in other like cases. But no witness shall be deemed guilty of contempt for disobeying such subpœna, unless his fees and traveling expenses in going to, returning from, and one day's attendance at the place of examination, are paid or tendered him at the time of the service of the subpœna; nor for refusing to disclose any secret invention or discovery made or owned by himself. *Rev. Stat.* § 4908.

X. APPEALS. BILL IN EQUITY

127. *Appeals from Primary Examiners to Examiners-in-chief.*

Every applicant for a patent or for the reissue of a patent, any of the claims of which have been twice rejected, and every party to an interference, may appeal from the decision of the primary examiner, or of the examiner in charge of interferences in such case, to the board of examiners-in-chief; having once paid the fee for such appeal. *Rev. Stat.* § 4909.

The fee prescribed is ten dollars. See *Rev. Stat.* § 4934 ; *Rules of Prac.* 128.

To allow such appeal there must have been two rejections of the claims as originally filed, or, if amended in matter of substance, of the amended claims, and all the claims must be passed upon, and all preliminary and intermediate questions relating to matters not affecting the merits of the invention settled, before the case is appealed to the examiners-in-chief. *Rules of Prac.* No. 129.

Upon the filing of the appeal the same shall be submitted to the primary examiner, who, if he find the appeal to be regular in form, shall furnish the examiners-in-chief with a written statement of the grounds of his decision on all the points involved in the appeal, with copies of the rejected claims, and with the references applicable thereto. If the primary examiner shall decide that the appeal is not regular in form, an appeal from such decision may be taken directly to the commissioner, as provided in Rule 140. *Id.* No. 130.

The appellant shall, before the day of hearing, file a brief of the authorities and arguments on which he will rely to maintain his appeal. *Id.* No. 131.

If the appellant desire to be heard orally before the examiners-in-chief, he will so indicate when he files his appeal ; a day of hearing will then be fixed, and due notice of the same given to him. *Id.* No. 132.

In contested cases the appellant shall have the right to make the opening and closing arguments unless it shall be otherwise ordered by the tribunal having jurisdiction of the case. *Id.* No. 133.

The examiners-in-chief in their decision will affirm or reverse the decision of the primary examiner only on the points on which appeal shall have been taken. (See Rule 128.) If they shall discover any apparent grounds not involved in the appeal for granting or refusing letters patent in the form claimed, or in any other form, they will annex to their decision a statement to that effect, with such recommendation as they shall deem proper. *Id.* No. 134.

From any judgment of the primary examiner, on points embraced in the recommendation annexed to the decision adverse to the appellant, appeal may be taken on questions involving the merits to the board of examiners-in-chief and on other questions to the commissioner, as in other cases. *Id.*

If an appeal shall be taken from the decision of the examiners-in-chief to the commissioner, the commissioner, whenever, in his opinion, substantial justice shall require it, may, either before or

after final judgment, remand the case to the primary examiner for consideration of any amendment or action based upon the recommendation annexed to the decision of the examiners-in-chief. *Id.*

If the commissioner, in revising the decision of the examiners-in-chief, shall discover any apparent grounds for granting or refusing letters patent not involved in the appeal, he will, before or after final judgment, whenever, in his opinion, substantial justice shall require, give reasonable notice thereof to the parties; and if any amendment or action based thereon shall be proposed, he will remand the case to the primary examiner for consideration. *Id.*

From decisions of the primary examiner, in cases remanded, as herein provided, appeal will lie to the board of examiners-in-chief, or directly to the commissioner, as in other cases.

If affidavits be received, under Rule 75 or 86, after the case has been appealed, the application will be remanded to the primary examiner for reconsideration. *Id.* No. 135.

128. *From Examiners-in-chief to Commissioner.*

If such party is dissatisfied with the decision of the examiners-in-chief, he may, on payment of the fee prescribed, appeal to the commissioner in person. *Rev. Stat.* § 4910.

The fee prescribed is twenty dollars. See Rev. Stat. § 4934; *Rules of Prac.* No. 136.

Cases which have been heard and decided by the commissioner on appeal will not be reopened except by the commissioner; cases which have been decided by the examiners-in-chief will not be reheard by them, when no longer pending before them, without the written authority of the commissioner; and cases which have been decided by either the commissioner or the examiners-in-chief will not be reopened by the primary examiner without like authority, and then only for the consideration of matters not already adjudicated upon, sufficient cause being shown. *Rules of Prac.* No. 137. See also *Id.* No. 67.

Cases will be regarded as pending before a tribunal until appeal has been taken from its decision, or until the limit of appeal which must be fixed in contested cases has expired. *Id.* No. 138.

Cases which have been deliberately decided by one commissioner will not be reconsidered by his successor except in accordance with

the principles which govern the granting of new trials. *Id.* No. 139.

Upon receiving a petition which shall state concisely and clearly any proper question, which has been twice acted upon by the examiner, and which does not involve the merits of the case, or the rejection of a claim, and which shall also state the facts involved and the point or points to be reviewed, an order will be made fixing a time for hearing such petition by the commissioner, and directing the examiner to report upon or answer the matters averred in such petition at least five days before such day of hearing. *Id.* 140.

In cases of interference parties have the same remedy by appeal to the examiners-in-chief and to the commissioner as in *ex parte* cases; but no appeal lies in such cases from the decision of the commissioner. *Id.* No. 141.

Appeals in interference cases must be accompanied with brief statements of the reasons therefor; and both parties will be required to file briefs of their arguments before the day of hearing. Printed briefs are in all cases preferred. *Id.* No. 142.

The commissioner may, in his discretion, order a rehearing, and upon such rehearing may revise his original decision. Matthews *v.* Weede, 1 *MacArthur Pat. Cas.* 144; *Re* Rouse, *Id.* 286; Nichols *v.* Harris, *Id.* 362.

129. *From the Commissioner to the Supreme Court, District of Columbia.*

If such party, except a party to an interference, is dissatisfied with the decision of the commissioner, he may appeal to the Supreme Court of the District of Columbia, sitting in banc. *Rev. Stat.* § 4911.

It is no longer customary in the patent-office to allow *pro forma* proceedings, in order to give opportunity for an appeal to the Supreme Court of the District. *Rules of Prac.* No. 145.

The rules and forms for these appeals are given in the Appendix to the Rules.

The refusal by the commissioner of patents to grant a patent to an assignee does not form the subject of an appeal to a judge at chambers in the Supreme Court of the District of Columbia. Whitney *v.* Fisher, 4 *Fish. Pat. Cas.* 248.

No appeal lies from a decision of the commissioners upon the

relative priority of two pending interfering applications for a patent. *Exp.* Gower, 15 *Pat. Off. Gaz.* 828.

Patentee has no right of appeal from the decision of the commissioner in an interference between the patentee and the applicant for a patent; the latter only has the right, the patentee being left to his remedy by action. Pomeroy *v.* Connison, 1 *McArthur Pat. Cas.* 40.

An appeal did not lie from the refusal of a commissioner to reopen a hearing upon an application under the acts of 1836 and 1839. *Re* Janney, 1 *MacArthur Pat. Cas.* 86. Under the act of 1839, the reasons of appeal filed upon appealing from a decision of the commissioner limit the jurisdiction of the appellate court, and where these reasons are vague and indefinite they will not be considered by the court. *Re* Winslow, 1 *MacArthur Pat. Cas.* 123; Jillson *v.* Winsor, *Id.* 136; Burlew *v.* O'Neil, *Id.* 168.

Upon appeal the court will pass upon the merits of the case without regard to the reasons which the commissioner assigned for his decision; those reasons may be wrong and still the decision be correct. *Re* Aiken, 1 *MacArthur Pat. Cas.* 126; *Re* Aiken, *Id.* 130; *Re* Crooker, *Id.* 134.

Upon appeal the ruling of the commissioner upon the admission of evidence cannot be reviewed, unless such ruling was specifically set forth in the reasons of appeal. Jillson *v.* Winsor, 1 *MacArthur Pat. Cas.* 136.

The right to appeal from the decision of the commissioner, given by section 11 of the act of 1839, is lost by failing to file the reasons of appeal within the time prescribed therefor, although a motion for a rehearing is pending, unless a special order enlarging the time is made. Greenough *v.* Clark, 1 *MacArthur Pat. Cas.* 173.

Refusal of the commissioner to admit competent and material evidence offered by an applicant was ground for appeal from his decision, under the acts of 1836 and 1839, and upon each appeal an order might be made directing the case to be reheard and the evidence to be admitted before the commissioner. *Re* Fultz, 1 *MacArthur Pat. Cas.* 178.

The court cannot review the commissioner's exercise of his discretionary power in extending time for taking testimony in an interference proceeding; granting a rehearing, &c. Mathews *v.* Weede, 1 *MacArthur Pat. Cas.* 144; O'Reilly *v.* Smith, *Id.* 218; *Re* Rouse, *Id.* 287; Nichols *v.* Harris, *Id.* 362.

A decision of the commissioner rejecting an application for a patent for want of novelty, upon references to other inventions, should be reversed upon appeal, where the references originally relied upon are virtually abandoned and others presented for the first time on the appeal. *Re* Jewett, 1 *MacArthur Pat. Cas.* 259.

That a commission to take testimony in interference proceedings was executed before a magistrate who was of counsel for one of the parties is ground for reversal of a decision of the commissioner founded upon the depositions so taken. Nichols *v.* Harris, 1 *MacArthur Pat. Cas.* 302.

Decision of the commissioner against an applicant in an interference case upon the ground that the invention was not operative, reversed upon appeal, the testimony of witnesses that they had tested the device and found that it would not work being overcome by the production and operation in court of the machine itself. Bell *v.* Hill, 1 *MacArthur Pat. Cas.* 351.

In determining an appeal from the commissioner of patents, the supreme court of the District of Columbia will look only into the reasons of appeal, and into the records and proceedings in the case which are applicable to these reasons. *Re* Conklin, 1 *MacArthur Pat. Cas.* 375; 5 *Pat. Off. Gaz.* 235.

The jurisdiction of the appellate court in interference cases is not limited to cases where the commissioner has awarded priority; but an appeal may be taken from his refusal to grant any patent. Carter *v.* Carter, 1 *MacArthur Pat. Cas.* 388.

Decision of the commissioner in an interference case, reversed, upon the evidence, the negative testimony of a single witness who was in a position to know the fact testified being deemed sufficient, under the circumstances, to overweigh the positive testimony of two witnesses, whose answers appeared to be evasive and unfair. Cornell *v.* Hyatt, 1 *MacArthur Pat. Cas.* 423.

No appeal lies from an interlocutory decision of the commissioner, such as a refusal to extend the time for taking testimony. Wellman *v.* Blood, 1 *MacArthur Pat. Cas.* 432.

A claim filed upon an application for a patent, construed, upon appeal from a rejection, by giving it the interpretation most favorable to the applicant, and *held* to be for a patentable combination, although in each of the features of the improvement, separately considered, there was strong resemblance to known things and known results; the combination differing from each and all in the

specific result, and appearing by the united action to accomplish the desired result with a saving of material and of operative force. *Re* Cole, 1 *MacArthur Pat. Cas.* 539.

Under section 8 of the act of 1836, an appeal from a decision of the commissioner of patents in an interference case might be taken by a patentee where the decision was in favor of the patentee. Babcock *v.* Degener, 1 *MacArthur Pat. Cas.* 607. Overruling on this point, Pomeroy *v.* Connor, *Id.* 40, which had been followed in the following cases: Brown *v.* Herrick, *Id.* 310; Whipple *v.* Renton, *Id.* 332; Hopkins *v.* Barnum, *Id.* 334; Drake *v.* Cunningham, *Id.* 378; King *v.* Gedney, *Id.* 443.

The commissioner of patents had the power, under section 11 of the act of 1839, to enlarge the time for taking an appeal from his decision. Justice *v.* Jones, 1 *MacArthur Pat. Cas.* 635.

The owner of a label entitled to registration made application to the commissioner for its registration, and had complied with all the requirements of the law; but the examiner rejected the application on the ground that the label was not of the class entitled to registration. The applicant, instead of appealing to the commissioner, petitioned the Supreme Court of the District of Columbia for a mandamus to compel the commissioner to register his label. The commissioner, in his answer to the rule to show cause, recited the facts of the failure of the applicant to appeal to the commissioner from the examiner's decision, but at the same time approved of and indorsed the reasons of the examiner for refusing to register the label. It was *held*, that a peremptory mandamus to register the label should issue. United States *v.* Marble, 1 *Mackey*, 284; 2 *Pat. Off. Gaz.* 1366.

Under the act of 1839 the attorney general advised, that, in order to be effectual, the certificate of the proceedings and decision of a justice of the Supreme Court of the District of Columbia in an appeal from the commissioner of patents, required to be delivered and returned by him to the commissioner, must be made and certified by the justice while he is in office; but, if so made and certified, it may be transmitted by him to the commissioner after he has ceased to be a justice. 13 *Op. Att. Gen.* 265.

The requirement of section 7 of the act of 1836 that the applicant shall make oath anew when he persists in his application after having been informed by the commissioner of the errors or defects of his specification, does not make a new oath necessary to enable

him to appeal when his application is finally rejected. *Re* Crooker, 134.

130. *Notice of and Proceedings on such Appeals.*

When an appeal is taken to the supreme court of the District of Columbia, the appellant shall give notice thereof to the commissioner, and file in the patent-office, within such time as the commissioner shall appoint, his reasons of appeal, specifically set forth in writing. *Rev. Stat.* § 4912.

The court shall, before hearing such appeal, give notice to the commissioner of the time and place of the hearing, and on receiving such notice the commissioner shall give such notice of such time and place in such manner as the court may prescribe, to all parties who appear to be interested therein. The party appealing shall lay before the court certified copies of all the original papers and evidence in the case, and the commissioner shall furnish the court with the grounds of his decision, fully set forth in writing, touching all the points involved by the reasons of appeal. And at the request of any party interested, or of the court, the commissioner and the examiners may be examined under oath in explanation of the principles of the thing for which a patent is demanded. *Rev. Stat.* § 4913.

131. *Determination of such Appeal, and its Effect.*

The court, on petition, shall hear and determine such appeal, and revise the decision appealed from in a summary way, on the evidence produced before the commissioner, at such early and convenient time as the court may appoint; and the revision shall be confined to the points set forth in the reasons of appeal. After hearing the case the court shall return to the commissioner a certificate of its proceedings and decisions, which shall be entered of record in the patent-office, and shall govern the further proceedings in

the case. But no opinion or decision of the court in any such case shall preclude any person interested from the right to contest the validity of such patent in any court wherein the same may be called in question. *Rev. Stat.* § 4914.

The Revised Statutes of the District of Columbia, Provide, on the subject of "Appeals from Commissioner of Patents," as follows: "The supreme court" [of the District of Columbia], "sitting in banc, shall have jurisdiction of and shall hear and determine all appeals from the decisions of the commissioner of patents," in accordance with the provisions of section 4911 to section 4915, inclusive of the Revised Statutes of the United States. *Rev. Stat. Dist. Col.* § 780.

132. *Patents obtained by Bill in Equity.*

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 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 proceedings shall be paid by the applicant, whether the final decision is in his favor or not. *Rev. Stat.* § 4915; and see *Id.* § 629.

Rev. Stat. § 4915 does not give the courts general appellate jurisdiction in cases of interference. And it would be improper for a court to enjoin the applicant who prevails before the commissioner from receiving his patent, upon the mere suggestion that the commissioner erred in his decision. Whipple *v.* Miner, 15 *Fed. Rep'r*, 117; 23 *Pat. Off. Gaz.* 2236.

The jurisdiction of the circuit courts to grant a patent, notwithstanding an adverse decision of the commissioner of patents, is an independent original jurisdiction; it is not within the discretion of the defeated party to say when and under what circumstances the action of the office shall be suspended. *Ib.*

If an applicant is dissatisfied with limitations imposed by the commissioner, he should resort to the courts in the same manner as from a rejection of his application. New York Belting, &c. Co. *v.* Sibley, 15 *Fed. Rep'r*, 386; 23 *Pat. Off. Gaz.* 1444.

The circuit court has jurisdiction of a bill to obtain the issue of a patent refused by the commissioner of patents; and the commissioner, by accepting service of process has been *held* to subject himself to such jurisdiction in a district in which he did not reside. Vermont Farm Machine Co. *v.* Marble, 20 *Fed. Rep'r*, 117.

The suit in equity authorized under Rev. Stat. § 4915, is an original and not an appellate proceeding. It is conducted according to equity rules, and a party contesting his right to a patent thereunder need not be confined to matters existing of record in the patent-office or in the supreme court of the District of Columbia. In this case a motion to appoint a special examiner, under the rules of the court, for the purpose of taking additional testimony, was accordingly granted. *Re* Squire, 12 *Pat. Off. Gaz.* 1025; 3 *Bann. & A. Pat. Cas.* 133.

Upon a suit under Rev. Stat. § 4915, a court of equity will not aid the inventor to obtain a patent himself in direct violation of his agreement transferring the property in his invention. Runstetler *v.* Atkinson, 23 *Pat. Off. Gaz.* 940.

Rev. Stat. § 4915, providing a remedy by bill in equity for an erroneous decision on an interference case, means a proceeding in a court of the United States having original equity jurisdiction under the patent laws, according to the ordinary course of equity practice and procedure; not a technical appeal confined to the case as made in the record of the patent-office, but a suit prepared and heard upon all competent evidence, and the whole merits; the

decree in which is conclusive on the department. Matthews, J., in Butterworth *v.* Hoe, 112 *U. S.* 50, 61.

Such bill is the only mode allowed, of reviewing a commissioner's decision on an interference; there is no appeal from such decision. Butler *v.* Shaw, 21 *Fed. Rep'r*, 321.

The commissioner need not be a party to such bill; an assignee of defendant's patent should be a defendant. Graham *v.* Teter, 25 *Fed. Rep'r*, 555; 33 *Pat. Off. Gaz.* 758.

XI. SURRENDER AND REISSUE.

133. *Reissue of Defective Patents.*

Whenever any patent is inoperative or invalid, by reason of a defective or insufficient specification, or by reason of the patentee claiming as his own invention or discovery more than he had a right to claim as new, if the error has arisen by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, the commissioner shall, on the surrender of such patent and the payment of the duty required by law, cause a new patent for the same invention, and in accordance with the corrected specification, to be issued to the patentee, or, in the case of his death or of an assignment of the whole or any undivided part of the original patent, then to his executors, administrators, or assigns, for the unexpired part of the term of the original patent. Such surrender shall take effect upon the issue of the amended patent. The commissioner may, in his discretion, cause several patents to be issued for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for a reissue for each of such reissued letters patent. The specifications and claim in every such case shall be subject

to revision and restriction in the same manner as original applications are. Every patent so reissued, together with the corrected specifications, shall have the same effect and operation in law, on the trial of all actions for causes thereafter arising, as if the same had been originally filed in such corrected form; but no new matter shall be introduced into the specification, nor in case of a machine patent shall the model or drawings be amended, except each by the other; but when there is neither model nor drawing, amendments may be made upon proof satisfactory to the commissioner that such new matter or amendment was a part of the original invention, and was omitted from the specification by inadvertence, accident, or mistake, as aforesaid. *Rev. Stat.* § 4916.

134. *General Nature, Scope and Extent of the Right of Reissue.*

A reissue is granted to the original patentee, his legal representatives, or the assignees of the entire interest, when, by reason of a defective or insufficient specification, or by reason of the patentee claiming as his invention or discovery more than he had a right to claim as new, the original patent is inoperative or invalid, provided the error has arisen from inadvertence, accident, or mistake, and without any fraudulent or deceptive intention. In the cases of patents issued and assigned prior to July 8, 1870, the applications for reissue may be made by the assignees; but in the cases of patents issued or assigned since that date the applications must be made and the specification sworn to by the inventors, if they be living. *Rules of Prac.* No. 84.

Matter which is shown and described, and might have been lawfully claimed, in an unexpired patent, but was not claimed by reason of a defect or insufficiency in the specification, arising from inadvertence, accident or mistake, and without fraud or deceptive intent, cannot be subsequently claimed by the patentee in a separate patent, but only in a reissue of the original patent. *Rules of Prac.* No. 91.

If an inventor has produced a new and useful combination, which composes an organized machine, and also made new inventions of a less number of elements of the same combination than what compose the entire machine, he may, with the proper descriptions, claim the whole combination, and also the lesser ones, or ones composed of fewer elements than what make up the whole machine. He may, if he choose, make the several claims in one patent. If by inadvertence, accident, or mistake, he has failed in his original patent to claim any of the lesser combinations not embracing the whole machine, he can surrender his patent, and obtain a reissue for any additional claims so omitted in the original. Stevens *v.* Pritchard, 4 *Cliff.* 417 ; 10 *Pat. Off. Gaz.* 505 ; 2 *Bann. & A. Pat. Cas.* 390.

Prior use under a defective patent will not authorize the use of the invention after the issue of a renewed patent. McWilliams Manuf. Co. *v.* Blundell, 11 *Fed. Rep'r,* 419 ; 22 *Pat. Off. Gaz.* 177 ; Hussey *v.* Bradley, 5 *Blatchf.* 134 ; 2 *Fish. Pat. Cas.* 362.

As to reissue of patents which have been already extended, see Woodworth *v.* Edwards, 3 *Woodb. & M.* 120 ; Gibson *v.* Harris, 1 *Blatchf.* 167 ; Wilson *v.* Rousseau, 4 *How.* 646.

That a patent may be amended and reissued as often as errors are discovered,—see Morse *v.* Bain, 9 *West. L. J.* 106.

135. *Surrender; How Made, and its Effect.*

The surrender of a patent extinguishes it ; cancels it ; and no right can afterward be asserted upon it. Suits pending for an infringement of a patent fall with its surrender, because the foundation upon which they were commenced no longer exists (Moffitt *v.* Garr, 1 *Black,* 273 ; Peck *v.* Collins, 103 *U. S.* 660); but a person who under an honest misapprehension surrenders a valid patent, and takes out a reissue which proves to be void, is entitled to a reissue of the first patent in the identical language originally used. Giant Powder Co. *v.* Safety Nitro Powder Co., 19 *Fed. Rep'r,* 509.

That when a reissue is adjudged invalid, the surrender which preceded it will also be invalidated ; and the original patent will be treated as remaining in force,—see Woodworth *v.* Hall, 1 *Woodb. & M.* 248 ; 6 *Pa. L. J.* 178 ; Woodworth *v.* Hall, 1 *Woodb. & M.* 389 ; Woodworth *v.* Edwards, 4 *Woodb. & M.* 129.

136. *Loss of the Right, by Delay.*

The right to have corrections made by reissue may be abandoned and lost by unreasonable delay. Miller *v.* Brass Co., 104 *U. S.* 350; aff'g 14 *Blatchf.* 282; 12 *Pat. Off. Gaz.* 667; 3 *Bann. & A. Pat. Cas.* 20; Turrell *v.* Bradford, 23 *Pat. Off. Gaz.* 1623; 15 *Fed. Rep'r*, 808; Wollensak *v.* Reiher, 115 *U. S.* 96.

Where a specific device or combination is claimed, the non-claim of other devices or combinations apparent on the face of the specification is, in law, so far as the patentee is concerned, a dedication of them to the public, and will so be enforced, unless he with all due diligence surrenders his patent for reissue, and proves that his omission to claim them arose wholly from inadvertence, accident, or mistake. Miller *v.* Brass Co., *supra.* Followed, in case of a patent reissued 14 years after the original. Baltimore Car Wheel Co. *v.* North Baltimore Passenger R. Co., 21 *Fed. Rep'r*, 47.

The right to have a mistake in a patent corrected does not depend upon what information the patentee or his assignee actually had of the mistake, but as to what they might have had if they had availed themselves of the opportunities at their command to discover it. Ives *v.* Sargent, 17 *Fed. Rep'r*, 447.

Action of the patent-office in granting a reissue is not conclusive on the question of laches of the patentee in applying for it; the question is ultimately one of law for the court, and if there was delay and it cannot be accounted for, it may invalidate the reissue. Wollensak *v.* Reiher, 115 *U. S.* 96. Two years' delay in applying for a reissue, was *held* not unreasonable where no adverse rights had accrued meantime. Stutz *v.* Armstrong, 20 *Fed. Rep'r*, 843. The application for a reissue is not an application for a patent, but for the amendment of one, and is not such an application as must be made before two years of public use have been had. Shaw *v.* Colwell Lead Co., 11 *Fed. Rep'r*, 711; 20 *Blatchf.* 417.

The facts that a patentee was a foreigner, unfamiliar with the English language, and ignorant of the omission from his patent of a claim contained in his application but rejected, the rejection having been acquiesced in by his solicitors, was *held*, not sufficient to excuse delay of more than two years in applying for a reissue. Boland *v.* Thompson, 26 *Fed. Rep'r*, 633.

137. *Who may Surrender for Reissue: Rights of Assignees.*

In respect to the right of a patentee to surrender a defective patent and take out a new one, there is no difference between a citizen and an alien. Shaw *v.* Cooper, 7 *Pet.* 292, 315.

A patentee, to be entitled to a reissue, must have been the first to disclose the invention in the record existing in the patent-office. *Exp.* Platts, 15 *Pat. Off. Gaz.* 827.

There was nothing in the act of 1836 to restrict the right of surrendering a patent and taking a renewal thereof upon amended specifications because of special or limited grants or licenses previously made. Smith *v.* Plympton, 4 *West. L. J.* 49. Compare Brooks *v.* Bicknell, 4 *McLean*, 64; 3 *West. L. J.* 35; Smith *v.* Mercer, 5 *Pa. L. J.* 529.

Where a patent had by the death of the patentee devolved upon his executor, and had been by him assigned, the assignee may take a reissue in his own name and for his own benefit; the statutory provisions authorizing a reissue are remedial, and are to be liberally construed. Carew *v.* Boston Elastic Fabric Co., 1 *Holmes*, 45. And see another proceeding in same case, 3 *Cliff.* 356; 1 *Pat. Off. Gaz.* 91; 5 *Fish. Pat. Cas.* 90.

Under Rev. Stat. § 4895,—which provides for reissues of patents to assignees, the ultimate assignee may apply, though there may be intermediate ones through whom he derived the interest of the inventor; and if the inventor parted with his interest before July 8, 1870, it is not necessary that he join in the application. Selden *v.* Stockwell Self-lighting Gas-burner Co., 9 *Fed. Rep'r*, 390; 19 *Blatchf.* 544; 20 *Pat. Off. Gaz.* 1377. To same effect, under previous statutes, Swift *v.* Whisen, 2 *Bond*, 115; 3 *Fish. Pat. Cas.* 343.

Where there has been an assignment of an undivided part of the whole original patent, the assignee of such part and the patentee become joint owners of the patent, and should join in the surrender; if they do not, it will be invalid, unless the part owner not joining shall ratify it. Potter *v.* Holland, 4 *Blatchf.* 206; 1 *Fish. Pat. Cas.* 327. And see Commissioner of Patents *v.* Whiteley, 4 *Wall.* 522.

A patentee cannot, by a surrender of his patent, affect the rights of third persons, to whom he had previously, by assignment, passed

his interest in the whole or a part of the patent, without the consent of such assignee. Woodworth *v.* Stone, 3 *Story*, 749. Such persons are entitled, upon the surrender of the patent and the obtaining of a reissued patent by the patentee, to the same right, under the reissued patent, that they had to the old one; but they cannot be compelled to take under the reissued one. Potter *v.* Holland, 4 *Blatchf.* 206; 1 *Fish. Pat. Cas.* 327. Where a patentee had sold all his right, title, and interest in his patent, except as to a little town; and subsequently, at the request of the assignees, applied for, and obtained, a reissue of the patent in his own name, which reissued patent he assigned as before, it was *held*, that the surrender of the original patent, at the request of the true owners, was valid; and that if the reissue to the patentee was a clerical error, he had corrected it by the subsequent assignment. Wing *v.* Warren, 5 *Fish. Pat. Cas.* 548.

Assent to the surrender of a patent by a transferee of an interest in it, who is not an assignee within the meaning of the statute, is not essential to the validity of a reissued patent. Meyer *v.* Bailey, 2 *Bann. & A. Pat. Cas.* 73; 3 *Pat. Off. Gaz.* 437. If an assignee accepts the reissue of a patent and transfers a part of the interest in it which was originally vested in him by the patentee, it is a ratification by him of the act of the patentee in securing the reissue, although he did not join in the surrender of the original patent. *Ib.*

Although an inventor has conveyed all his interest, yet if his assignment has not been recorded, the assignee cannot, after the patent has been reissued, demand issue of a patent to himself. Whitely *v.* Fisher, 4 *Fish. Pat. Cas.* 248; 5 *Id.* 528.

Amendments to a patent made on a reissue thereof will inure to the benefit of the assignees and grantees under the patent as it stood before such reissue; but such grantees may, if they prefer, rest their claims upon the specification as it stood when they purchased their right. Smith *v.* Plympton, 4 *West. L. J.* 49. See, also, Smith *v.* Mercer, 5 *Pa. L. J.* 529.

138. *The Application for a Reissue.*

The petition for a reissue must be accompanied with a certified copy of the abstract of title, giving the names of all assignees owning any undivided interest in the patent; and in case the appli-

cation is made by the inventor, it must be accompanied with the written assent of such assignees. *Rules of Prac.* No. 85.

Applicants for reissue, in addition to the requirements of rule 45, must also file with their petitions a statement on oath as follows:

1. That applicant verily believes the original patent to be inoperative or invalid, and the reason why.

2. Where it is claimed that such patent is so inoperative or invalid "by reason of a defective or insufficient specification," particularly specifying such defects or insufficiencies.

3. Where it is claimed that such patent is inoperative or invalid "by reason of the patentee claiming as his own invention or discovery more than he had a right to claim as new," distinctly stating such part or parts so alleged to have been so improperly claimed as new.

4. Particularly specifying the errors which it is claimed constitute the inadvertence, accident, or mistake relied upon, and how they arose or occurred.

5. That said errors arose "without any fraudulent or deceptive intention" on the part of the applicant. *Rules of Prac.* No. 86.

A reissue claiming matters not in the original patent, and which did not infringe it, was *held* invalid, where, owing to the death of the inventor before the application for reissue, it was not supported by his oath as to inadvertence, accident or mistake. Wooster *v.* Handy, 22 *Blatchf.* 307; 21 *Fed. Rep'r*, 51; 28 *Pat. Off. Gaz.* 629.

The applicant for a reissue is not required to take any oath on the subject of the invalidity of his original patent. Hartshorn *v.* Eagle Shade Roller Co., 18 *Fed. Rep'r*, 90; 25 *Pat. Off. Gaz.* 1191. He need not use the exact phraseology of the statute, if he employs language which conveys its legal meaning. Gold, &c. Telegraph Co. *v.* Wiley, 17 *Fed. Rep'r*, 234; 16 *Rep'r*, 129.

Where an applicant for reissue of a patent has done all in his power to make his application effectual—has filed his application with the acting commissioner and paid the requisite amount of fees—the application is to be considered as properly before the commissioner. Commissioner of Patents *v.* Whiteley, 4 *Wall.* 522. A mandamus will lie to compel the commissioner of patents to receive an application for a reissue of a patent; or to allow an appeal from his decision refusing a reissue. *Ib.*

Although a surrender of an original patent is the act of the

party making the application, still the application for a surrender and reissue may be withdrawn, under leave of a commissioner, for good cause shown, at any time before the proceedings are fully completed. Forbes *v.* Barstow Stove Co., 2 *Cliff.* 379.

The application for a reissue must be accompanied by a surrender of the original patent, or, if that is lost, by an affidavit to that effect, and a certified copy of the patent; but if a reissue be refused, the original patent will, upon request, be returned to the applicant. *Rules of Prac.* No. 90.

139. *The Hearing.*

In cases of application for reissue, an original claim, if reproduced in the amended specification, is subject to re-examination, and the entire application will be revised and restricted in the same manner as original applications. *Rules of Prac.* 89.

A patentee is not entitled to have his patent reissued, unless he shows, by satisfactory evidence, that the error he seeks to have corrected was owing to "inadvertence, accident or mistake, and without any fraudulent or deceptive intention," and states particularly wherein the inadvertence, accident or mistake consisted. Conklin's Case, 5 *Pat. Off. Gaz.* 235; S. C., 1 *MacArthur*, 375.

In the case of the surrender for a defective or insufficient specification, under the act of 1836, the commissioner is to decide whether the invention claimed in the original patent and that claimed in the amended one is substantially the same. He is to inquire and ascertain whether the specification s defective or insufficient in point of law or fact, and whether the inventor has claimed more than he has invented, and in each case whether the error has arisen from inadvertency, accident, or mistake, or with a deceptive or fraudulent intention. Allen *v.* Blunt, 3 *Story*, 742; 8 *L. Rep'r*, 165. He is not confined to the claims, nor even to the evidence furnished by the specification, models and drawings accompanying the original application; but any legal proof to show it to be the same invention should be received. Even a statement, in an original patent, that a part is old, or a disclaimer of a part, does not necessarily prevent such part from being claimed in a reissued patent, though it would have that effect if made advisedly. Hussey *v.* Bradley, 5 *Blatchf.* 134; 2 *Fish. Pat. Cas.* 362. The commissioner has no jurisdiction to hear testimony as to what the original

invention was, and to allow the claims and specification to be amended so as to embrace what the proofs show was invented, where the reissue may thus show improvements neither described, suggested, nor indicated in the model, drawings, or specification of the original. Cahart *v.* Austin, 2 *Cliff.* 528.

140. *Powers and Duties of the Commissioner.*

The power of accepting the surrender of the original patent and of granting a reissue of it is confided exclusively to the commissioner, and is to be exercised judicially by him. Parham *v.* American Buttonhole, &c. Co., 4 *Fish. Pat. Cas.* 468; Parham *v.* Machine Co., 1 *Leg. Gaz.* 145; Carew *v.* Boston Elastic Fabric Co., 1 *Pat. Off. Gaz.* 91; 5 *Fish. Pat. Cas.* 90; 3 *Cliff.* 356; Thomas *v.* Shoe Machinery Co., 16 *Pat. Off. Gaz.* 541; Dunbar *v.* White, 15 *Fed. Rep'r*, 747; 4 *Woods*, 116; 23 *Pat. Off. Gaz.* 1446.

The commissioner has power to reissue a patent to cure defects in the specification; but not to cure false statements in the application; as, that the applicant is a citizen, when in fact he is an alien. Mini *v.* Adams, 3 *Wall. Jr.* 20.

It is for the commissioner to decide whether an applicant for a reissue is an assignee within the meaning of the act. Commissioner of Patents *v.* Whiteley, 4 *Wall.* 522.

The power of the commissioner to cancel a patent and issue another for the purpose of correcting an error in it not embraced by the statute authorizing reissue, considered. Dental Vulcanite Co. *v.* Wetherbee, 2 *Cliff.* 555; 3 *Fish. Pat. Cas.* 87.

Under the act of 1836, where a patent was antedated in supposed accordance with the provisions of that act, and upon the express request of the patentee, who acquiesced in and accepted the patent so granted, it was *held* that the commissioner could not subsequently alter the date of the patent, the error, if any, being not merely clerical, but an error of judgment as to his duty and authority under the law. *Re* Cushman, 1 *MacArthur Pat. Cas.* 577.

146. *What Defects in a Patent, warrant a Reissue.*

The statute, only authorizes a reissue when, from an unintentional error in the description of the invention, the patent is invalid or inoperative, or when the claim of the patentee exceeds his invention. Giant Powder Co. *v.* California Vigorit Powder Co., 4 *Fed. Rep'r*, 720; 6 *Sawyer*, 508; 18 *Pat. Off. Gaz.* 1339. Whenever a patent fails to secure all that the patentee was by his specifications entitled to claim, it is inoperative within the meaning of the statute, and he is entitled to a reissue. Giant Powder Co. *v.* Safety Nitro Powder Co., 19 *Fed. Rep'r*, 509. If a patentee, in the description and claim in his original patent, erroneously set forth something short of his real invention, it is a proper case for a reissue, although his real invention may be fully shown in the drawings and model. Wilson *v.* Coon, 6 *Fed. Rep'r*, 611; 18 *Blatchf.* 532; 19 *Pat. Off. Gaz.* 482. A reissue is not invalid merely because the claim of the original patent was valid, and suit could be sustained thereon. *Ib.*

A reissue is valid when made in order to correct a claim which might not fully secure the invention, and which was so ambiguous as to suggest doubt of its sufficiency; and where the mistake was not so obvious as to be instantly suggested on reading the claim. Western Union Tel. Co. *v.* Baltimore, &c., Telegraph Co., 25 *Fed. Rep'r*, 30.

Where, on application for a patent, the examiner denied the application on the ground that he deemed certain claims anticipated by a prior device, this is not a "mistake or inadvertence" such as will entitle the assignee of the patentee to a reissue; the remedy in such cases is by appeal. Putnam *v.* Hutchinson, 12 *Fed. Rep'r*, 127; 11 *Biss.* 233; 28 *Int. Rev. Rec.* 177.

Where, upon application for a patent, one of the claims presented is rejected because covered by previous inventions, and thereupon the duly authorized attorney of the applicant orders such claim to be erased and withdrawn, and a patent for the remaining claims is issued and is accepted by the applicant, he is not entitled to a reissued patent containing the claim so erased and withdrawn. There is, under such circumstances, no error arising by inadvertence, accident or mistake, within the meaning of the patent law, which would authorize an application for a reissue. *Re* Hatchman, 3 *Mackey*, 288; 26 *Pat. Off. Gaz.* 738.

Under the act of 1836, whether the defect be in the specification or claim, the patentee may surrender his patent, and, by an amended specification or claim, cure the defect. When the specification or claim is so vague as to be inoperative and invalid, an amendment might give it validity and protect the rights of the patentee against subsequent infringements. Battin *v.* Taggart, 17 *How.* 74. A specification may be insufficient or defective so as to allow a reissue, either by a mistake of law as to what is required to be stated therein in respect to the claim of the inventor, or by a mistake of fact in omitting things which are indispensable to the completeness and exactness of the description of the invention, or of the mode of constructing, or making, or using the same. Allen *v.* Blunt, 3 *Story*, 742; 8 *L. Rep'r*, 165.

The practice of surrendering valid patents and of granting reissues thereon in cases where the original patent was neither inoperative nor invalid, and where the specification was neither defective nor insufficient, condemned. Burr *v.* Duryee, 1 *Wall.* 531; aff'g 2 *Fish. Pat. Cas.* 275.

142. *What Changes may be made by a Reissue.*

No new matter shall be introduced into the reissue specification, nor in case of a machine shall the model or drawings be amended except each by the other; but when there is neither model nor drawing, amendments may be made upon proof satisfactory to the commissioner that such new matter or amendment was a part of the original invention, and was omitted from the specification by inadvertence, accident, or mistake. *Rules of Prac.* No. 87.

It is a legitimate and important function of a reissue of a patent to modify or change the claims of the original patent so as to cover the invention set forth therein. Westinghouse *v.* Garden, &c. Air-brake Co., 9 *Pat. Off. Gaz.* 538; 2 *Bann. & A. Pat. Cas.* 55. Compare Cornell *v.* Downer, &c. Brewing Co., 7 *Biss.* 346.

The commissioner may allow the original specification to be amended in the reissue, and he may permit the applicant for a reissue to re-describe his invention, including in the new description and claims not only what was well described before, but also what was suggested or indicated in the original specification, drawings or patent-office model. Carew *v.* Boston Elastic Fabric Co., 3 *Cliff.* 356; 1 *Pat. Off. Gaz.* 91; 5 *Fish. Pat. Cas.* 90; Tucker *v.* Tucker,

Manuf. Co., 10 *Pat. Off. Gaz.* 464; 4 *Cliff.* 397; 2 *Bann. & A. Cas.* 401; Draper *v.* Potomska Mills Corp., 13 *Pat. Off. Gaz.* 276; 3 *Bann. & A. Pat. Cas.* 214; Woven Wire Mattrass Co. *v.* Wire Web Bed Co., 8 *Fed. Rep'r*, 87; Gold, &c., Tel. Co. *v.* Wiley, 17 *Fed. Rep'r*, 234; 16 *Rep'r*, 120.

In case of a reissue of a patent, the patentee may claim something when he is informed of its importance which he had before described as one mode of making his machine or article. Atwood *v.* Portland Co., 10 *Fed. Rep'r*, 283; 5 *Bann. & A. Pat. Cas.* 533.

The provision of Rev. Stat. § 4916, forbidding amending model and drawings of a machine patent except by each other, does not preclude an amendment which does not affect the claim. Pearl *v.* Appleton Co., 3 *Fed. Rep'r*, 153; 5 *Bann. & A. Pat. Cas.* 553. The specifications for the reissue of a patent may be amended by the model deposited in the patent-office as well as by the drawings. Hendy *v.* Golden State, &c., Iron Works, 17 *Fed. Rep'r* 515; 8 *Sawyer*, 468.

A patent for a combination of old elements may be reissued for a combination of a fewer elements than were contained in the combination originally claimed. Herring *v.* Nelson, 14 *Blatchf.* 293; 3 *Bann. & A. Pat. Cas.* 55; Christman *v.* Rumsey, 17 *Blatchf.* 148; 17 *Pat. Off. Gaz.* 903; 4 *Bann. & A. Pat. Cas.* 506; 58 *How. Pr.* 114.

In the absence of an error arising from inadvertence, accident or mistake, a patent for a machine will not sustain a reissue for a process. Eachus *v.* Broomall, 115 *U. S.* 489, 529.

Reissued patent in 1879 for an improvement in electric lamps, known as the "clamp patent," considered, and *held* anticipated by the invention of the same clamp in 1876, although only one clamp and one lamp were ever made by the latter inventor, and were used together two and one-half months only; such use having been public and practical, in ordinary work and with reasonable success. Brush *v.* Condit, 22 *Blatchf.* 246; 20 *Fed. Rep'r*, 826.

The legal effect of the changes which, in various cases, may be introduced into the language of a patent, by surrender and reissue, explained. Dunbar *v.* White, 4 *Woods*, 116; 23 *Pat. Off. Gaz.* 1146 · 15 *Fed. Rev'r* 747.

143. *Dividing a Patent by Reissue.*

The commissioner may, in his discretion cause several patents to be issued for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for each division of such reissued letters patent. Each division of a reissue constitutes the subject of a separate specification descriptive of the part or parts of the invention claimed in such division; and the drawing may represent only such part or parts, subject to the provisions of rule 49. Unless it shall be otherwise ordered by the commissioner, all the divisions of a reissue will issue simultaneously; if there be controversy as to one, the others will be withheld from issue until the controversy is ended, unless he shall otherwise order. *Rules of Prac.* No. 88.

Where a patent claims a combination of several devices, it may be reissued to claim the devices separately, if new and useful, even though the aggregate combination claimed in the original patent was not, by itself, useful, or was even impracticable; provided the reissue points out how the devices, separately claimed, may be reduced to practical use. Wheeler *v.* Clipper Mower, &c., Co., 2 *Pat. Off. Gaz.* 442; 10 *Blatchf.* 181; 6 *Fish. Pat. Cas.* 1. But the patent cannot be broadened by reissuing it in divisions any more than if reissued together. New *v.* Warren, 22 *Pat. Off. Gaz.* 587. The thing patented may be separated on the reissue of a reissued patent as on the first reissue. Selden *v.* Stockwell Self-lighting Gas-burner Co., 9 *Fed. Rep'r*, 390; 19 *Blatchf.* 544; 20 *Pat. Off. Gaz.* 1377.

Where a patentee has, in his original patent, patented an aggregate of several devices, he may, in obtaining a separate reissue for each device, give the same identical description in each issue, of all the devices in the original. If, in such case, the claim of each reissue is for a distinct and severable part of the invention described and shown in the original patent, the reissues are not open to the objection that there are several patents for the same invention. Wheeler *v.* McCormick, 4 *Pat. Off. Gaz.* 692; 6 *Fish. Pat. Cas.* 551; 11 *Blatchf.* 334. Where an application for reissue for two or more divisions is made whilst the original patent is in existence, the commissioner of patents has power to issue a patent for one or more of the divisions of the reissue application, and subsequently to issue a patent for the remaining divisions, if it be

deemed that otherwise the applicant is entitled thereto. Until such application is ended in all its divisions, the vitality of the original patent continues, so far as required to support that portion of the application which remains undecided. 16 *Op. Att. Gen.* 560

Where an original patent describes a new article made by a new process, the reissue may be in two parts, one for the process, and one for the article of manufacture. Tucker *v.* Burditt, 4 *Bann. & A. Pat. Cas.* 569 ; Badische Anilin, &c. Fabrik *v.* Hamilton Manuf. Co., 13 *Pat. Off. Gaz.* 273; 3 *Bann. & A. Pat. Cas.* 235, Same *v.* Higgins, 15 *Blatchf.* 290; 3 *Bann. & A. Pat. Cas.* 462.

A division of the original patent, upon a reissue, into two claims, though unnecessary to effectuate the invention, will not necessarily impair the validity of the reissues. Salt Manuf. Co. *v.* Thomas, 3 *Leg. Gaz.* 316· 1 *Leg. Gaz. Rep'r*, 275.

14. *The Invention must not be Enlarged.*

The general rule that reissued letters patent expanded beyond, the claim of the original letters, are void, is sustained by Miller *v.* Brass Co., 104 *U. S.* 360; aff'g 14 *Blatchf.* 282; 12 *Pat. Off. Gaz.* 667; 3 *Bann. & A. Pat. Cas.* 20; James *v.* Campbell, 104 *U. S.* 356; rev'g 17 *Blatchf.* 42; 18 *Pat. Off. Gaz.* 979; 8 *Rep'r*, 455; 4 *Bann. & A. Pat. Cas.* 456 ; Nye *v.* Allen, 23 *Pat. Off. Gaz.* 2328; 15 *Rep'r*, 114; Lorillard *v.* McAlpin, 14 *Fed. Rep'r*, 112; 22 *Pat. Off. Gaz.* 1208 ; Dryfoos *v.* Wiese, 19 *Fed. Rep'r*, 315; 22 *Blatchf.* 19 ; 26 *Pat. Off. Gaz.* 639 ; Adjustable Window Screen Co. *v.* Boughton, 10 *Phila.* 251 ; 1 *Bann. & A. Pat. Cas.* 327; Edgarton *v.* Furst, &c. Manuf. Co., 9 *Fed. Rep'r*, 450; 10 *Biss.* 402 ; 27 *Int. Rev. Rec.* 383 ; 21 *Pat. Off. Gaz.* 267 ; Wood Paper Patent, 23 *Wall.* 566; Russell *v.* Dodge, 93 *U. S.* 460; Powder Co. *v.* Powder Works, 98 *U. S.* 126; Ball *v.* Langles, 102 *U. S.* 128; Manufacturing Co. *v.* Ladd, *Id.* 408; Manufacturing Co. *v.* Corbin, 103 *U. S.* 786; Carew *v.* Boston Elastic Fabric Co., 3 *Cliff.* 356; 5 *Fish. Pat. Cas.* 90 ; 1 *Pat. Off. Gaz.* 91; Rayer, &c., Seaming Machine Co. *v.* American Printing Co., 19 *Fed. Rep'r*, 428; Tarr *v.* Webb, 10 *Blatchf.* 96 ; 5 *Fish. Pat. Cas.* 503 ; 2 *Pat. Off. Gaz.* 568 ; Meyer *v.* Maxheimer, 9 *Fed. Rep'r*, 99 ; 20 *Blatchf.* 15 ; 20 *Pat. Off. Gaz.* 1162 ; Averill Chemical Paint Co. *v.* National Mixed Paint Co., 9 *Fed. Rep'r*, 462 ; 20 *Blatchf.* 42 ; 22 *Pat. Off. Gaz.* 585 ; Dunbar *v.* White, 4 *Woods*, 116 ; 23 *Pat. Off. Gaz.* 1146 ; 15 *Fed. Rep.* 747·

Vogler *v.* Semple, 7 *Biss.* 382 ; 23 *Int. Rev. Rec.* 112 ; 11 *Pat. Off. Gaz.* 923 ; 2 *Bann. & A. Pat. Cas.* 556; Driven Well Cases, 16 *Fed. Rep'r*, 387; 26 *Pat. Off. Gaz.* 1011.

The privilege of surrendering a patent and obtaining a reissue cannot be extended to afford the patentee an opportunity to expand his exclusive privilege, so as to enable him to suppress an invention made subsequent to his own, which does not conflict with the invention prescribed in the patent which he surrenders. Gill *v.* Wells, 22 *Wall.* 1.

Where a reissued patent is granted upon a surrender of the original, for its alleged defective or insufficient specification, such specification cannot be substantially changed in the reissued patent, either by the addition of new matter or the omission of important particulars, so as to enlarge the scope of the invention, as originally claimed. A defective specification can be rendered more definite and certain, so as to embrace the claim made, or the claim can be so modified as to correspond with the specification ; but, except under special circumstances, this is the extent to which the operation of the original patent can be changed by the reissue. Russell *v.* Dodge, 93 *U. S.* 460 ; Yale Lock Manuf. Co. *v.* Scovill Manuf. Co., 3 *Fed. Rep'r*, 288 ; 18 *Blatchf.* 248 ; 5 *Bann. & A. Pat. Cas.* 519. By new matter, with reference to the reissue of a composition, is meant not merely the introduction of a new ingredient, but any change in the original specification and claim, whereby a new and substantially different composition is secured. United States, &c., Felting Co. *v.* Haven, 1 *L. & Eq. Rep'r*, 16; 2 *Bann. & A. Pat. Cas.* 164. It is in cases where a patent is inoperative or invalid, by reason of a defective or insufficient description, specification, or claim, and not where the device is not described or specified at all, that permission is given to reissue the patent ; devices, not described or specified, may, if they are the invention of the patentee, be the subject of a patent, subject to all other rules governing the inventor's right ; but it is not the office of the reissue to embrace them. Sarven *v.* Hall, 9 *Blatchf.* 524 ; 1 *Pat. Off. Gaz.* 437 ; 5 *Fish. Pat. Cas.* 415.

A reissued patent shown to be broader than the original cannot be sustained by proof that the patentee had invented, before making his original application, all the things added in the reissue, and might rightfully have claimed them at first. Manufacturing Co. *v.* Ladd, 102 *U. S.* 408 ; aff'g 2 *Bann. & A. Pat. Cas.* 488. And see Atwater Manuf. Co. *v.* Beecher Manuf. Co., 8 *Fed. Rep'r*,

608 ; Kells *v.* McKenzie, 9 *Fed. Rep'r*, 284 ; 20 *Pat. Off. Gaz.* 1363 ; Dederick *v.* Cassell, 9 *Fed. Rep'r*, 306 ; 27 *Int. Rev. Rec.* 400 ; 20 *Pat. Off. Gaz.* 1263. Where it appears, as matter of law, on a comparison of the two instruments, that a reissued patent is not for the same invention as that embraced and secured in the original patent, the reissued patent is invalid. Sickles *v.* Evans, 2 *Cliff.* 203 ; 2 *Fish. Pat. Cas.* 417 ; Tucker *v.* Tucker Manuf. Co., 10 *Pat. Off. Gaz.* 464; 2 *Bann. & A. Pat. Cas.* 201. If a patent, containing a single claim for a combination, is reissued, with the same description as before, but with two claims, the one a repetition of the original claim, and the other for a combination of some of the elements only, the reissue is valid as to the repetition of the original claim but invalid as to the new claim ; to uphold the latter would be to enlarge the claim, which must not be done by reissue. Gage *v.* Herring, 107 *U. S.* 640 ; 2 *Sup. Ct. Rep'r*, 819. Compare McMurray *v.* Mallory, 111 *U. S.* 97 ; Washburn, &c., Manuf. Co. *v.* Fuchs, 16 *Fed. Rep'r*, 661 ; Terrell *v.* Bradford, 15 *Fed. Rep'r*, 808 ; 23 *Pat. Off. Gaz.* 1623.

145. *Illustrations.*

A patent for a machine cannot be broadened on reissue to cover a process described in the original patent ; if the process were patentable it should have been included in the original patent. New *v.* Warren, 22 *Pat. Off. Gaz.* 587. Neither can a patent limited to a product when made in a certain method be expanded to cover the product without reference to the manner in which it is produced. Vacuum Oil Co. *v.* Buffalo Lubricating Oil Co., 22 *Blatchf.* 266 ; 28 *Pat. Off. Gaz.* 1101.

Where the original patent covers a mechanism to accomplish a specific result, and the reissued patent covers the process by which that result is attained, without regard to the mechanism used to accomplish it, the reissue is broader than the original patent, for it covers every mechanism which can be contrived to carry on the process ; it is, therefore, void. Bedford *v.* Burton, 106 *U. S.* 338 ; 1 *Sup. Ct. Rep'r*, 98 ; Powder Co. *v.* Powder Works, 98 *U. S.* 126 ; rev'g 3 *Sawyer*, 448 ; 2 *Bann. & A. Pat. Cas.* 131 ; James *v.* Campbell, 104 *U. S.* 356 ; rev'g 17 *Blatchf.* 42 ; 18 *Pat. Off. Gaz.* 979 ; 8 *Rep'r*, 455 ; 4 *Bann. & A. Pat. Cas.* 456. The patentee may not strike out the entire description of one of the ingredients of a combination, and insert in lieu thereof a descrip-

tion of other devices, unless it be alleged that such other devices are equivalents of the device stricken out. Tucker *v.* Tucker Manuf. Co., 10 *Pat. Off. Gaz.* 464.

A patent granted for a combination, one element of which was described in the specification as being adapted by its shape to perform specified functions, was surrendered and a reissue taken which expanded some of the claims so as to cover any form of this element, whether adapted to perform these functions, or not. It was *held* that as to these expanded claims the reissue was void. McMurray *v.* Mallory, 111 *U. S.* 97.

When divisional reissues are granted for a part of the original invention, they must not contain anything substantially new or different; thus original letters for a process will not support reissued letters for a composition, unless it is the result of the process, and the invention of the one involves the invention of the other; so letters granted for certain processes of exploding nitro-glycerine will not support reissued letters for a composition of nitro-glycerine and gunpowder or other substances, even though the original application claimed the invention of the process and the compound; these are distinct inventions. Powder Co. *v.* Powder Works, 98 *U. S.* 126; rev'g 3 *Sawyer*, 448; 2 *Bann. & A. Pat. Cas.* 131.

Where the specification of the original patent suggested no invention, save the one contained in the entire combination, the claim in the reissue for a lesser number of elements than it embraced was declared void. Had it been intimated in the original patent that the lesser number of elements could be used in combination, this would have justified a claim to them on reissue; but without such suggestion the claim was invalid, for departure from the original invention. Miller *v.* Bridgeport Brass Co., 14 *Blatchf.* 282; 12 *Pat. Off. Gaz.* 667; 3 *Bann. & A. Pat. Cas.* 20. See affirmance, 104 *U. S.* 350.

When form is of the substance of an invention it is not to be disregarded; thus where the original invention was for a particular form of wooden bushing, wooden bushings having been previously patented, a broad claim in a reissue for any form of wooden bushings was *held* invalid. New York Bung, &c. Co. *v.* Hoffman, 9 *Fed. Rep'r*, 199; 20 *Pat. Off. Gaz.* 1451; 20 *Blatchf.* 3.

Where the patent was for a process of treating bark-tanned lamb or sheep-skin, by means of a compound in which heated fat liquor was an essential ingredient, and a change was made in the

original specification, by eliminating the necessity of using the fat liquor in a heated condition, and making, in the new specification, its use in that condition a mere matter of convenience, and by inserting an independent claim for the use of fat liquor in the treatment of leather generally, the character and scope of the invention as originally claimed were held to be so enlarged as to constitute a different invention. Russell *v.* Dodge, 93 *U. S.* 460.

146. *Scope and Limits of the above Rule.*

Where the amended specification and new claim only secure to the applicant what he had originally described, the reissue is valid. Richardson *v.* Lockwood, 4 *Cliff.* 128; Wells *v.* Gill, 6 *Fish. Pat. Cas.* 574; Draper *v.* Wattles, 16 *Pat. Off. Gaz.* 629; 3 *Bann. & A. Pat. Cas.* 618; Putnam *v.* Yerrington, 9 *Pat. Off. Gaz.* 689; 2 *Bann. & A. Pat. Cas.* 237.

Upon reissue of a patent, the claim may be enlarged where there was clearly mistake or inadvertence and no unreasonable delay in applying for the correction, and no rights of others have intervened. Wooster *v.* Handy, 21 *Fed. Rep'r*, 51; Odell *v.* Stout, 22 *Fed. Rep'r*, 159; 29 *Pat. Off. Gaz.* 862. The mistake must not be from mere error of judgment, but a *bona fide* mistake inadvertently committed, such as a court of chancery, in cases within its ordinary jurisdiction, would correct. Jones *v.* Barker, 11 *Fed. Rep'r*, 597; 22 *Pat. Off. Gaz.* 771.

A reissue may be had for any invention substantially described, though not claimed, in the original specification. Pennsylvania Salt Manuf. Co. *v.* Thomas, 8 *Phila.* 144; 5 *Fish.* 149. See McArthur *v.* Brooklyn Railway Supply Co., 19 *Fed. Rep'r*, 263; Lorillard *v.* McDowell, 11 *Pat. Off. Gaz.* 640; Combined Patents Can Co. *v.* Lloyd, 11 *Fed. Rep'r*, 149; 21 *Pat. Off. Gaz.* 713. Or whatever was substantially suggested or indicated in the surrendered specifications, drawings or patent-office model. Stevens *v.* Pritchard, 4 *Cliff.* 417; 10 *Pat. Off. Gaz.* 505; 2 *Bann. & A. Pat. Cas.* 390. Compare Kelleher *v.* Darling, 14 *Pat. Off. Gaz.* 673; Stephenson *v.* Second Ave. R. R. Co., 5 *Bann. & A. Pat. Cas.* 116; Meyer *v.* Goodyear's India Rubber Glove Manuf. Co., 22 *Pat. Off. Gaz.* 681; Seymour *v.* Marsh, 6 *Fish. Pat. Cas.* 115; 9 *Phila.* 330; Reissner *v.* Anness, 13 *Pat. Off. Gaz.* 870.

It is of no consequence that a reissue states that certain co.a-

binations are found in the machine which will act in a certain way and effect certain results, when the original did not contain these statements, provided the combinations in fact existed in a machine made according to the drawings and description in the original patent, or provided the modes of operation and results in fact followed in a machine so made. Potter *v.* Stewart, 7 *Fed. Rep'r*, 215; 18 *Blatchf.* 561; 19 *Pat. Off. Gaz.* 997.

The reissue of a patent in which nothing more is done than to make a correction in the description in the original patent, without any enlargement of claim or material variation in terms, and where the effect is identical, is valid. Sewing Machine Co. *v.* Frame, 24 *Fed. Rep'r*, 596; 28 *Pat. Off. Gaz.* 96.

Where the patentee, when he applied for his patent, evidently attached more importance to one form of his invention than the other, but afterward changed his opinion and reissued, laying more stress on the second form, it was *held*, that such modification of opinion on his part did not disturb the fact that both forms were described, though imperfectly, in his first specifications. American Nicolson Pavement Co. *v.* Elizabeth, 6 *Fish. Pat. Cas.* 424.

Where the claim in a reissue, while differing verbally from the claim in the original patent, is substantially and in legal effect a mere repetition of that claim, the claim in the reissue may be sustained. National Pump Cylinder Co. *v.* Gunnison, 17 *Fed. Rep'r*, 812. If new claims in the reissue are only restatements of the functions and mode of operation of the elements of one of the claims of the original, in combination with the other parts of the machine, then they are valid. Fay *v.* Fraser, 11 *Biss.* 422.

The original patent having called the absorbent material with which the nitro-glycerine was mixed, "inexplosive," it was *held*, that to omit the term upon reissue was no enlargement of the invention. The word was ambiguous, since it was clear from the original description that the patentee did not contemplate the use of materials which, though explosive, were not so in comparison and under like conditions with nitro-glycerine. Atlantic Giant Powder Co. *v.* Goodyear, 13 *Pat. Off. Gaz.* 45.

Whether a reissued patent is (as it always should be) for the same invention as the original, is a question, not of fact, but of legal construction of the two instruments. Stevens *v.* Pritchard, 4 *Cliff.* 417; 10 *Pat. Off. Gaz.* 505; 2 *Bann. & A. Pat. Cas.* 390; Tucker *v.* Tucker Manuf. Co., 10 *Pat. Off. Gaz.* 464; 4 *Cliff.* 397; 2 *Bann. & A. Pat. Cas.* 401.

147 *Effect of the Commissioner's Decision: Presumptions.*

The action of the commissioner of patents in accepting a surrender and granting a reissue of letters-patent is judicial in its character, and presumed correct, but is not conclusive upon the court. Flower *v.* Rayner, 5 *Fed. Rep'r*, 793; 19 *Pat. Off. Gaz.* 425; 11 *Rep'r*, 555. It is final and conclusive as to all matters of fact involved in the hearing of the application (Judson *v.* Bradford, 16 *Pat. Off. Gaz.* 171; 3 *Bann. & A. Pat. Cas.* 539), and as to the mere necessity of a reissue (Smith *v.* Merriam, 6 *Fed. Rep'r*, 713; 19 *Pat. Off. Gaz.* 601. Compare Conklin's Case, 1 *Mac. Arthur*, 375; 5 *Pat. Off. Gaz.* 235); but it is not conclusive as to his own jurisdiction (Cahart *v.* Austin, 2 *Cliff.* 528. Compare Whitley *v.* Swayne, 4 *Fish. Pat. Cas.* 117; Giant Powder Co. *v.* California Vigorit Powder Co., 4 *Fed. Rep'r*, 720; 6 *Sawyer*, 503; 18 *Pat. Off. Gaz.* 1339), nor as to the reasonableness of the delay. Wollensak *v.* Reeher, 115 *U. S.* 96.

The correct performance of all those preliminaries on which the validity of a reissued patent depends is always examinable in the court in which a suit for its violation is brought. Odell *v.* Stout, 22 *Fed. Rep'r*, 159.

The general rule is that the decision of commissioner of patents is conclusive in a suit for infringement, unless it is apparent on the face of the patent that he has exceeded his authority. Wells *v.* Gill, 2 *Pat. Off. Gaz.* 590; 6 *Fish. Pat. Cas.* 89. S. P., American Nicolson Pavement Co. *v.* Elizabeth, *Id.* 424; Spaeth *v.* Barney, 22 *Fed. Rep'r*, 828; 30 *Pat. Off. Gaz.* 997.

The commissioner's authority being limited to a reissue for the same invention, the two patents may be compared to determine the identity of the invention. If the reissued patent, when thus compared, appears on its face to be for a different invention, it is void, the commissioner having exceeded his authority in issuing it. Russell *v.* Dodge, 93 *U. S.* 460; Sickles *v.* Evans, 2 *Fish. Pat. Cas.* 417; 2 *Cliff.* 203; Carhart *v.* Austin, 2 *Fish. Pat. Cas.* 543; Swift *v.* Whisen, 2 *Bond*, 115; 3 *Fish. Pat. Cas.* 343; Goodyear *v.* Berry, *Id.* 189; 3 *Fish. Pat. Cas.* 439.

The decision of the commissioner can only be impeached in the courts on the ground of, 1. Fraud or collusion between the commissioner and the applicant; 2. An excess of authority on the part of the commissioner, apparent on the face of the patents; or, 3. A

clear repugnance between the new and old patent. House *v.* Young, 3 *Fish. Pat. Cas.* 335; Hussey *v.* Bradley, 5 *Blatchf.* 134; 2 *Fish. Pat. Cas.* 362; Blake *v.* Stafford, 6 *Blatchf.* 195; 3 *Fish. Pat. Cas.* 294; Swift *v.* Whisen, 2 *Bond*, 115; 3 *Fish. Pat. Cas.* 343; Crompton *v.* Belknap Mills, 3 *Fish. Pat. Cas.* 536; Jordan *v.* Dobson, 2 *Abb. U. S.* 398; 7 *Phila.* 533; Stimpson *v.* Westchester R. R. Co., 4 *How.* 380, 404; Battin *v.* Taggart, 17 *How.* 74; Woodworth *v.* Stone, 3 *Story*, 749; Reissner *v.* Amess, 13 *Pat. Off. Gaz.* 870; Miller, &c. Manuf. Co. *v.* Du Brul, 12 *Pat. Off. Gaz.* 351; 2 *Bann. & A. Pat. Cas.* 618; Andrews *v.* Wright, 6 *Rep'r*, 193.

Some cases hold that the action of the commissioner is conclusive against a charge of fraud in obtaining the reissue, as well as all other objections, unless it appears upon the face of the papers that the new patent is not for the same invention as the original. La Baw *v.* Hawkins, 6 *Pat. Off. Gaz.* 724; 1 *Bann. & A. Pat. Cas.* 428; Milligan, &c. Glue Co. *v.* Upton, 6 *Pat. Off. Gaz.* 837; Union Paper Collar Co. *v.* White, 7 *Pat. Off. Gaz.* 698, 877. To justify the rejection of a reissue, therefore, on the ground of "new matter," it must clearly appear that such matter has been introduced. Nothing plainly embraced in the specifications, model or drawings of the original, is "new matter." Dederick *v.* Cassell, 9 *Fed. Rep'r*, 306; 27 *Int. Rev. Rec.* 400; 20 *Pat. Off. Gaz.* 1233. Compare Kells *v.* McKenzie, 9 *Fed. Rep'r*, 284; 20 *Pat. Off. Gaz.* 1663.

An objection to the validity of a reissued patent that the surrendered patent was not inoperative by reason of a defective specification, on which ground the application for a reissue was made, is conclusively decided by the commissioner's granting the reissue, and will not be reviewed by the circuit court. Selden *v.* Stockwell Self-lighting Gas-burner Co., 9 *Fed. Rep'r*, 390; 19 *Blatchf.* 544; 20 *Pat. Off. Gaz.* 1377; Kerosene Lamp Heater Co. *v.* Littell, 3 *Bann. & A. Pat. Cas.* 312; 1 *N. J. L.* 195.

When the commissioner has decided that an applicant for a reissue is not an assignee within the meaning of the act of 1836, a mandamus will not lie commanding him to refer the application to "the proper examiner, or otherwise examine or cause the same to be examined according to law;" the preliminary question was within the scope of his authority. Commissioner of Patents *v.* Whiteley, 4 *Wall.* 522.

The granting of a reissue is *prima facie* evidence of inadver-

tence, accident or mistake, as the granting of original letters is *prima facie* evidence of invention. Odell *v.* Stout, 22 *Fed. Rep'r*, 159.

It is the duty of the commissioner to see that a reissued patent does not cover more than the original one; and the presumption is, until the contrary appears, that it does not. O'Reilly *v.* Morse, 15 *How.* 62, 112. Compare Tatham *v.* Lowber, *Mir. Pat. Off.* 146; Stevens *v.* Pritchard, 4 *Cliff.* 417; 10 *Pat. Off. Gaz.* 505; 3 *Bann. & A. Pat. Cas.* 390; Jordan *v.* Dobson, 2 *Abb. U. S.* 398; 7 *Phila.* 533; Guidet *v* Barber, 5 *Pat. Off. Gaz.* 149; Morris *v.* Royer, 2 *Bond*, 66; Smith *v.* Whisen, *Id.* 115; 3 *Fish. Pat. Cas.* 343; Bantz *v.* Elsas, 6 *Fish. Pat. Cas.* 117; Chicago Fruit House Co. *v.* Busch, 4 *Fish. Pat. Cas.* 395. But such inference or presumption in respect to identity may be rebutted by evidence, which should be submitted to the jury. Allen *v.* Blunt, 2 *Woodb. & M.* 121, 139.

In an action for an infringement, the duty devolves upon the court to determine whether the reissue claims more than the original specification shows the patentee to have invented. Woodward *v.* Dinsmore, 4 *Fish. Pat. Cas.* 163. Compare Parham *v.* Machine Co., 1 *Leg. Gaz. Rep.* 145.

When as a defense to a reissue patent, it is set up that the reissue covers more than was embraced in the original, the respondent must introduce in evidence the original to support the allegation; otherwise it will be assumed that the invention described in the reissue is the same as that secured by the original. Doherty *v.* Haynes, 4 *Cliff.* 291; 6 *Pat. Off. Gaz.* 118; 1 *Bann. & A. Pat. Cas.* 289.

Reissued patent, *held* valid, notwithstanding errors apparent on its face in stating the number of the surrendered patent for which it was re-issued, and in expressing the claim. Reed *v.* Street, 34 *Pat. Off. Gaz.* 339.

148. *Validity of Reissued Patents.*

A reissue can only be impeached for fraud by a bill in equity brought for the purpose by the government. Birdsell *v.* McDonald, 6 *Pat. Off. Gaz.* 682.

The fact of procuring a patent for a machine under the assumption of a reissue, which was not useful as patented in the surrendered

patent, for want of some parts used in the reissued patent, would present a question of fraud committed on the public by the patentee, by giving his reissued patent date as an original discovery, made at the time of the original patent, and thereby overreaching similar inventions made between the time of the original patent and the time of the reissued patent. Brooks *v.* Fiske, 15 *How.* 212.

A reissued patent need not contain any recitals that the prerequisites to the grant of it,—as, that it was reissued for errors arising not from inadvertency, accident, or mistake,—have been duly complied with ; for the law makes the presumption that they have been. Philadelphia & Trenton R. R. Co. *v.* Stimpson, 14 *Pet.* 448, 458.

A reissued patent is not the less valid because it contains a full account of processes, which, although adverted to in the original, were not described at length, because they were well known in the art. Goodyear Dental Vulcanite Co. *v.* Smith, 5 *Pat. Off. Gaz.* 585; 1 *Holmes*, 354.

Where the reissue covers only claims which do not appear on the face of the original, it is invalid. Singer Manuf. Co. *v.* Goodrich, 15 *Fed. Rep'r*, 455.

It is no objection to the validity of a reissue, that the object of it was to extend the monopoly secured by the patent beyond the limits assigned to it by a judicial decision upon it in its original form. Poppenhusen *v.* Falke, 5 *Blatchf.* 46 ; 2 *Fish. Pat. Cas.* 213.

A reissue is not invalidated by immaterial difference between it and the original. McCreary *v.* Pennsylvania Canal Co., 26 *Int. Rev. Rec.* 379 ; 10 *Rep'r*, 723 ; S. C., *sub nom.* McCrary *v.* Pennsylvania Canal Co., 5 *Fed. Rep'r*, 367. See, also, Smith *v.* Mercer, 5 *Pa. L. J.* 529.

A reissue of a patent is not void for stating modes of operating the invention not stated in the original, the invention being the apparatus or combination of parts and not any particular instrumentality by which it is operated. Broadnax *v.* Central Stock Yard, &c. Co., 5 *Bann. & A. Pat. Cas.* 609 ; 4 *Fed. Rep'r*, 214 ; 11 *Rep'r*, 6.

A reissued patent to John Deuchfield is not void because the original was granted to John Deuchfield, the change of the letter being a clerical mistake. Bignall *v.* Harvey, 4 *Fed. Rep'r*, 334 ; 18 *Blatchf.* 353 ; 18 *Pat. Off. Gaz.* 1275 ; 5 *Bann. & A. Pat. Cas.* 636.

A reissued patent may be valid, notwithstanding the invalidity of one of its claims, if it appears that such claim was made in good faith by the inventor, and was not intended to broaden the original claims for the purpose of covering intermediate inventions or improvements. Odell *v.* Stout, 22 *Fed. Rep'r*, 159; 29 *Pat. Off. Gaz.* 862.

A reissue granted on an application made after unreasonable delay, and for the purpose of enlarging the specification and claims in order to bring within the exclusive privilege an invention, patented after the original patent was granted, is void as to the new claims. Torrent Arms Lumber Co. *v.* Rodgers, 112 *U. S.* 659.

149. *Reissued Patents void in Part only.*

Although the reissue of a patent may be void as to new or expanded claims, it may be good as to claims not expanded or which do not show a different invention from the original patent. A patentee may recover on an infringement of the valid claim. Havemeyer *v.* Randall, 21 *Fed. Rep'r*, 404; Havemeyer *v.* Bonnell, *Id.* 406; Gage *v.* Herring, 107 *U. S.* 646; 2 *Sup. Ct. Rep'r*, 819; Worden *v.* Searls, 21 *Fed. Rep'r*, 406; Gould *v.* Spicer, 15 *Fed. Rep'r*, 344; Cote *v.* Moffitt, *Id.* 345; Starrett *v.* Athol Machine Co., 14 *Fed. Rep'r*, 910; 23 *Pat. Off. Gaz.* 1729; Reay *v.* Raynor, 19 *Fed. Rep'r*, 308; Dryfoos *v.* Wiese, *Id.* 315; Wood *v.* Packer, 17 *Fed. Rep'r*, 650.

When a patent is reissued in several divisions, no one of them is void merely because they, every one, describe all the mechanism shown in the original, provided the claim in each is for a different device which is already described, and there is no conflict between them. Wheeler v. McCormick, 4 *Pat. Off. Gaz.* 692; 11 *Blatchf.* 334; 6 *Fish. Pat. Cas.* 551.

150. *Grounds on which they may be adjudged Void.*

Reissued patent declared invalid because the affidavit filed to obtain it was not drawn in compliance with the statute. Poage *v.* McGowan, 15 *Fed. Rep'r*, 398.

Whenever the power of reissue has been fraudulently or corruptly abused, the renewal will be avoided. Woodworth *v.* Edwards, 3 *Woodb. & M.* 120.

An application for a patent was rejected because of want of novelty, on reference to a prior invention; but on a re-application it was granted because of a disclaimer by the patentee of certain claims made on the prior application; it was *held*, that a reissue to the assignee of the inventor, on claims including those disclaimed by the prior patentee, is invalid as to such claims. Putnam *v.* Hutchinson, 12 *Fed. Rep'r*, 127; 11 *Biss.* 233; 28 *Int. Rev. Rec.* 177.

Where, upon the application for a patent for an improvement in cotton presses, a claim of the applicability of the invention to a certain class of presses was abandoned; it was *held*, that a reissue of the patent by which the invention was made applicable to that class of presses was improper and void. Wicks *v.* Stevens, 2 *Woods*, 310; 2 *Bann. & A. Pat. Cas.* 318.

On an application by J., as assignee of a patent, for a reissue, the commissioner declared an interference between it and a patent previously issued to S., and rendered his decision in favor of S. On appeal, the decision of the commissioner was reversed and a reissue ordered to J. Before the reissue was granted, the owner of a patent issued to W., prior to the application of J., applied to the commissioner to declare an interference between it and the application of J. The interference was declared, and the commissioner decided in favor of the patent to W. On appeal by J. from this decision, the second interference was held to have been wrongfully declared, on the ground that no second interference could be declared under the statute (act of 1836, § 8), and the reissue to J. was peremptorily ordered. The reissue was granted, and the owner of the patent to W. then filed a bill against the owners of the reissued patent to J., to have that patent declared void. On an application for a preliminary injunction,—it was *held*, that the order declaring the second interference and directing the reissue to J. was a nullity, and the reissued patent void; and the injunction was granted. Potter *v.* Dixon, 5 *Blatchf.* 160.

151. *Construction and Effect of reissued Patents.*

A reissued patent has the same effect and operation in law as though it had been originally filed in the corrected form, only on the trial of actions brought on it for causes thereafter arising, and has no such effect in any other case, or for any other purpose. United States Stamping Co. *v.* King, 7 *Fed. Rep'r*, 830; 17

Blatchf. 55; 17 *Pat. Off. Gaz.* 1399; 4 *Bann. & A. Pat. Cas.* 469.

The correction of the patent by reissue relates back, and, except as to suits for infringements before the reissue, it operates from the date of the original. Woodworth *v.* Hall, 1 *Woodb. & M.* 248; 6 *Pa. L. J.* 178; Stanley *v.* Whipple, 2 *McLean*, 35; Smith *v.* Pearce, *Id.* 176; Bloomer *v.* Stolley, 5 *McLean*, 158; 8 *West. L. J.* 158; Grant *v.* Raymond, 6 *Pet.* 218. And being only a continuation of the first one, the rights of the patentee are to be ascertained by the law under which the original application was made. Shaw *v.* Cooper, 7 *Pet.* 292, 315.

Where in the case of a reissued patent, the complainants had adopted the surrender and accepted the new patent, it was *held*, that they were estopped from denying either the authority of the applicant, or that of the commissioner. Dental Vulcanite Co. *v.* Wetherbee, 2 *Cliff.* 555; 3 *Fish. Pat. Cas.* 87.

Where one paragraph in a reissue specification would seem to lead to a construction which would make void the reissue, explanation of its meaning may be sought in a succeeding one. Carew *v.* Boston Elastic Fabric Co., 3 *Cliff.* 356; 1 *Pat. Off. Gaz.* 91; 5 *Fish. Pat. Cas.* 90.

Where the process and purpose are plainly suggested and understood, and the language in an original specification is suggestive of new terms and names used in the reissue, such new names and terms do not show that the reissue is descriptive of an invention different from that set out in the original. *Ib.*

If a patentee uses certain words in his first specification and afterwards withdraws them in his amended specification in a reissued patent, he is not estopped by the words which have been so withdrawn and canceled. Allen *v.* Blunt, 2 *Woodb. & M.* 121, 143.

Reissuing a patent which has been adjudged void for want of novelty cannot give it validity. Jones *v.* McMurray, 2 *Hughes*, 527; 3 *Bann. & A. Pat. Cas.* 130. Nor will the invalidity of a claim in a reissue impair the validity of a claim in the original patent which is repeated and separately stated in the reissue. Schillinger *v.* Greenway Brewing Co., 17 *Fed. Rep'r*, 244; 24 *Pat. Off. Gaz.* 495; Fetter *v.* Newhall, 17 *Fed. Rep'r*, 841; 25 *Pat. Off. Gaz.* 502; 16 *Rep'r*, 360.

The novelty of a patented invention is not impeached by a prior patent which did not originally describe the invention, but has since been enlarged by reissue so as to include it. Vogler *v.* Semple, 7

Biss. 382; 11 *Pat Off. Gaz.* 923; 23 *Int. Rev. Rec.* 112; 2 *Bann. & A. Pat. Gaz.* 556.

Where, by a prior decision of a case involving the validity of a patent, it was decided that the present reissue was not patentable by reason of an earlier patent, argument against the propriety of such decision will not be entertained. Meyer *v.* Goodyear India-Rubber Manuf. Co., 11 *Fed. Rep'r*, 891; 20 *Blatchf.* 91.

Features of an invention which have been disclaimed by the patentee on applying for and obtaining a patent cannot be afterward secured by surrendering the patent and taking a reissue embracing them. If such reissued patent is erroneously granted by the commissioner, it will not sustain a suit for infringement of the parts of the invention originally disclaimed. Leggett *v.* Avery, 101 *U. S.* 256.

Where an inventor inserts a description of a modified or improved form in an application for reissue, and is required, by the commissioner of patents, to disclaim this description as a condition precedent to granting of the reissue, he is not estopped from enjoining the use of machines containing such modification or improvement. The admission or disclaimer is not of a fact of invention, but of the propriety of inserting a certain clause in the descriptive part of the specification. If the patentee's invention and his patent rightly included a certain form as an equivalent, it was a mere nullity to confess that it did not include it. Union Metallic Cartridge Co. *v.* United States Cartridge Co., 7 *Fed. Rep'r*, 344.

Where a patentee invented an apparatus for breaking coal, and combined it with an apparatus for screening coal, which he did not invent, and took a patent for the combination only, and afterward took a patent for the breaking apparatus, and then surrendered both patents and took one for the breaking apparatus alone; it was *held*, that his describing and not claiming the breaking apparatus in his first patent and the surrender and cancellation of the second did not deprive him of his right to a patent for the breaking apparatus. Battin *v.* Taggart, 17 *How.* 74. And see 2 *Wall. Jr.* 101.

XII. DISCLAIMERS. INTERFERENCE SUITS.

152. *Disclaimers authorized.*

Whenever, through inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, a patentee has claimed more that that of which he was the original or first inventor or discoverer, his patent shall be valid for all that part which is truly and justly his own, provided the same is a material or substantial part of the thing patented ; and any such patentee, his heirs or assigns, whether of the whole or any sectional interest therein, may, on payment of the fee required by law, make disclaimer of such parts of the thing patented as he shall not choose to claim or to hold by virtue of the patent or assignment, stating therein the extent of his interest in such patent. Such disclaimer shall be in writing, attested by one or more witnesses, and recorded in the patent-office ; and it shall thereafter be considered as part of the original specification to the extent of the interest possessed by the claimant and by those claiming under him after the record thereof. But no such disclaimer shall affect any action pending at the time of its being filed, except so far as may relate to the question of unreasonable neglect or delay in filing it. *Rev. Stat.* § 4917.

See also *Rev. Stat.* § 4922 ; which is as follows :

Whenever, through inadvertence, accident, or mistake, and without any willful default or intent to defraud or mislead the public, a patentee has, in his specification, claimed to be the original and first inventor or discoverer of any material or substantial part of the thing patented, of which he was not the original and first inventor or discoverer, every such patentee, his executors, administrators, and assigns, whether of the whole or any sectional interest

in the patent, may maintain a suit at law or in equity, for the infringement of any part thereof, which was *bona fide* his own, if it is a material and substantial part of the thing patented, and definitely distinguishable from the parts claimed without right, notwithstanding the specifications may embrace more than that of which the patentee was the first inventor or discoverer. But in every such case in which a judgment or decree shall be rendered for the plaintiff no costs shall be recovered unless the proper disclaimer has been entered at the patent-office before the commencement of the suit. But no patentee shall be entitled to the benefits of this section if he has unreasonably neglected or delayed to enter a disclaimer.

Rev. Stat. § 973 also provides :

When judgment or decree is rendered for the plaintiff or complainant, in any suit at law or in equity, for the infringement of a part of a patent, in which it appears that the patentee, in his specification, claimed to be the original and first inventor or discoverer of any material or substantial part of the thing patented, of which he was not the original and first inventor, no costs shall be recovered, unless the proper disclaimer, as provided by the patent laws, has been entered at the patent office before the suit was brought.

153. *Nature and Uses of a Disclaimer.*

The disclaimers mentioned in section 4917 must be distinguished from those which are embodied in original or reissue applications, as at first filed or subsequently amended, referring to matter shown or described, but to which the disclaimant does not choose to claim title ; and also from those made to avoid the continuance of interferences, which require no fee, but must, like all other disclaimers, be signed by the applicants in person and duly witnessed. *Rules of Prac.* No. 168.

When an applicant makes two or more applications relating to the same subject matter of invention, all showing, but only one claiming, the same thing, those not claiming it must contain disclaimers thereof, with references to the application claiming it.

The law requiring and permitting a patentee to disclaim is not penal, but remedial. It is intended for the protection of the patentee as well as the public, and should not receive a construction

that would restrict its operation within narrower limits than the words of the law fairly import. Whether a patent is illegal in part because of claiming more than the inventor has described, or more than he has invented, the patentee must in either case disclaim in order to save the portion to which he is entitled; and he is allowed to do this when the error was committed by mistake. O'Reilly *v.* Morse, 15 *How.* 61, 121.

Where, in a disclaimer, the party states that he was the patentee, and nothing is said in respect to a transfer of any interest, the fair presumption is, that he still owns the whole; and it is a sufficient compliance with the requirement of the act of 1837,—that the party making a disclaimer should state the extent of his interest in the patent,—to say "that such disclaimer is to operate to the extent of his interest therein." Silsby *v.* Foote, 14 *How.* 218; aff'g 1 *Blatchf.* 445.

It is not competent for a patentee who has surrendered his letters-patent and made oath that he believes that by reason of an insufficient or defective specification the surrendered letters are inoperative and void, and has taken out reissued letters on a new specification and for new claims, to abandon the reissue and resume the original patent by a disclaimer. McMurray *v.* Mallory, 111 *U. S.* 97.

Where a patent for the infringement of which suit is brought, appears to cover separate and distinct inventions, without connection between them, either in purpose, design or operation, other than that all are designed for use upon the same article, each being a distinct improvement, the court may, as a condition of granting the relief sought, require the complainants to file in the patent-office a disclaimer of all the claims except that alleged to be infringed. Sessions *v.* Romadka, 21 *Fed. Rep'r*, 124.

An acquiescence in a decision requiring a disclaimer as a condition precedent to granting a patent (here, an extension) and filing a disclaimer pursuant to it, are as operative to estop the disclaimant from afterward recovering on the invention disclaimed as from claiming it on a subsequent reissue. Cartridge Co. *v.* Cartridge Co., 112 *U. S.* 624, 644.

Justice BLATCHFORD suggests that "the word 'claimant' is an evident error* for disclaimant." *Ib.*

* As one of the late commissioners to revise the statutes, I will say that I do not remember whether the board had special discussion over the word "claimant" in this section; but I think it is correct. The sense is, *the person claiming the inven-*

What persons, under act of 1870, c. 230, § 54 (Stat.) 205, might make a disclaimer, of what, and its effect, explained. *Ib.*

Limitations and provisos introduced by an inventor into his application, especially if it has been rejected, must be deemed equivalent to disclaimers. Sargent *v.* Hall Safe and Lock Co., 114 *U. S.* 63.

If the patentee has assigned his patent in part, and a joint suit is brought in equity for a perpetual injunction, a disclaimer by the patentee alone without the assignee's uniting in it will not entitle the parties to the benefit of the act of 1837, §§ 7 and 9. Wyeth *v.* Stone, 1 *Story*, 273; 4 *L. Rep'r*, 54.

Where the thing claimed without right is a part of a machine, if it is not an essential part and was not introduced into the patent through the willful default of the patentee, or with intent to defraud or mislead the public, the want of a disclaimer in regard to it affords no ground for invalidating the patent. Hall *v.* Miles, 2 *Blatchf.* 194.

A disclaimer may embrace subject-matter set up for the first time without right in the reissue patent; and it may apply not only to the invalid claim, but to statements in the body of the specification upon which the invalid claim or part of claim is founded. The reissue specification is to be thereafter read as if the disclaimer were incorporated in it. Schillinger *v.* Gunther, 17 *Blatchf.* 66; 16 *Pat. Off. Gaz.* 905; 4 *Bann. & A. Pat. Cas.* 479. Where the statements in the specification and claim of the reissue patent, which the disclaimer seeks to modify, were mistakes in fact and were founded upon experiments made after the date of the original patent, it was *held*, that the disclaimer was lawful both to remedy the misstatements and to save the reissue from impeachment as for a different invention, it appearing that the inventor had acted, throughout, in good faith. *Ib.*

tion. In the preceding sentences the statute is speaking of the person filing the disclaimer, and disclaimant is used, properly. In this sentence the sense changes to that of the person who in the "original specification" laid claim to the invention. Were "disclaimant" substituted for "claimant," in this sentence, what would be the force of the clause "to the interest possessed by the disclaimant?" How can a disclaimant, strictly as such, possess an interest? In so far as he is a disclaimant he disavows interest. Take, also, the words next following: "and by those claiming under him." How can persons be said to "claim under" a disclaimant, as contrasted with a claimant? The change of term corresponds to the change of sense. B. V. A.

Where parts of the thing patented in claims which had been infringed were definitely distinguishable from parts claimed in other claims made by mistake, without any willful default, or intent to defraud or mislead the public, and the complainant had not been unreasonably negligent in not entering a disclaimer,—*held*, that he might, on entering a disclaimer, maintain the suit brought for infringement, but without costs. Matthew *v.* Spangenberg, 10 *Fed. Rep'r*, 823; 20 *Blatchf.* 482.

A disclaimer limiting the actual invention of the patentee, the result of an error or mistake on the part of the patent-office, may be omitted in a reissue. American Shoe Tip Co. *v.* National Shoe Toe Protecting Co., 11 *Pat. Off. Gaz.* 740; 2 *Bann. & A. Pat. Cas.* 501.

Where on application for a patent, the specification, as filed, disclaims a certain principle, the generality of such disclaimer will be restricted to the purpose for which it is used, as intended to be considered upon that application; it will not estop the applicant from subsequently claiming, in another application, the invention so disclaimed. Hill *v.* Dunklee, 1 *MacArthur Pat. Cas.* 475.

154. *Effect.*

Where, upon the purchase of a patent, the purchaser in a reissue of such patent disclaims a portion of the mechanism as insufficient to produce the desired result, a third person has the right to improve such part of the machine by changing its internal form so as to effect a result which the purchaser of the patent, in his reissue, disclaims for it. Hatch *v.* Moffitt, 15 *Fed. Rep'r*, 252.

Where a patentee has defectively or insufficiently described his invention, and claimed more than he has a right to claim as new, he is entitled to a reissue of his patent upon his surrender of the original; but it is not the office of a disclaimer to reform [illegible] the description of an invention. Hailes *v.* Albany Stove [illegible] *Fed. Rep'r*, 240; 24 *Pat. Off. Gaz.* 391; 16 *Rep'r*, 65.

Where there are several claims, some of which be [illegible], and the part of the invention which is his own [illegible] distinguished from that which is not his own, a disclaimer before suit brought will put him right, and enable him to recover upon his patent as though it had originally been confined to the proper claims; but he cannot convert a claim for one thing into a claim

for something else, and amend the description to effectuate such claim. *Ib.*

A disclaimer can add nothing to the patent. It can take away from what was described as the invention and claimed as such, so as to be covered by the grant of the patent, but it has no office to make the patent cover any thing, however clearly shown in the patent, not described and claimed as a part of the invention. White *v.* E. P. Gleason Manuf. Co., 17 *Fed. Rep'r*, 159; 24 *Pat. Off. Gaz.* 205.

If inventions not new or original with the patentee are included in the specification by mistake, accident, or inadvertence, or without willful defraud or intent to defraud or mislead the public, the patent is good and valid for so much of the invention or discovery as is truly and *bona fide* the invention of the patentee. But if no disclaimer be entered in the patent-office before suit is brought, the plaintiff cannot recover costs against the defendant, although infringement of the valid claim be proved. But if, when the patentee applied for a reissue of his original patent, he well knew he was not the first inventor of the invention mentioned in any of his claims, then his patent is void, and no recovery can be had thereon. Singer *v.* Walmsley, 1 *Fish. Pat. Cas.* 558.

A disclaimer of part of an invention cannot affect a prior grantee under the patent, unless he accepts it; he may refuse to be affected by it. Smith *v.* Mercer, 5 *Pa. L. J.* 529.

A motion for a preliminary injunction in a suit for infringement may be granted, notwithstanding the filing by plaintiffs of a disclaimer after suit was brought, if the defendants' rights have not been in any degree prejudiced by the disclaimer. Libbey *v.* Mt. Washington Glass Co., 26 *Fed. Rep'r*, 757.

155. *Neglect or Delay in filing.*

A disclaimer may be made after as well as before a suit for infringement; but the court has power to protect the defendant from surprise, &c., and to take into consideration the fact of delay. Smith *v.* Nichols, 21 *Wall.* 112; aff'g 1 *Holmes*, 172; 2 *Pat. Off. Gaz.* 649; 6 *Fish. Pat. Cas.* 61.

The disclaimer, to be effectual under the act of 1837, §§ 6, 7 (now Rev. Stat. § 4922), must be filed in the patent-office before suit is brought. If it is filed during the pendency of the suit, the

plaintiff will not be entitled to the benefit thereof in that suit. Unless it is so filed, the plaintiff will not be entitled to recover costs in such suit, even if he should establish at the trial that a part of the invention not disclaimed has been infringed by the defendant. But whether filed before or after suit brought, the plaintiff will not be entitled to the benefit of a disclaimer if he has unreasonably neglected and delayed to file it. Such neglect or delay is a good defense to the suit. Reed *v.* Cutter, 1 *Story*, 590

Section 7 of the act of 1837 (5 Stat. 193),—providing for the making of a disclaimer when a claim to a patent is too broad,—does not affect a suit pending when the disclaimer is filed, so as to prevent the plaintiff from recovering in it, unless there was unreasonable neglect or delay in filing the disclaimer. Tuck *v.* Bramhill, 6 *Blatchf.* 95 ; 3 *Fish. Pat. Cas.* 400.

Where, on the hearing of a bill to enjoin infringement of a patent, the claim appears too broad, but the complainant offers to disclaim the excess, there may be a decree for an injunction without waiting for filing an actual disclaimer in the patent-office ; but the complainant cannot have costs. Aiken *v.* Dolan, 3 *Fish. Pat. Cas.* 196.

It is not a good objection to the grant of a preliminary injunction under a valid claim, that a disclaimer was not filed as to other claims before suit was brought. Such claims having the sanction of the commissioner, and the question of their validity being one of law, to be ultimately decided by the courts, it cannot be said that the plaintiffs have unreasonably neglected or delayed to enter a disclaimer. Duff *v.* Calkins, 25 *Pat. Off. Gaz.* 601.

A disclaimer in a suit on a patent, under Rev. Stat. § 4922, need not be filed, except where costs are sought, until the court has passed upon the contested claims alleged to contain that of which the patentee was not the inventor. Stutz *v.* Armstrong, 20 *Fed. Rep'r*, 843.

What amounts to unreasonable delay or neglect in filing a disclaimer. Silsby *v.* Foote, 20 *How.* 378 ; modifying 2 *Blatchf.* 278 ; Seymour *v.* McCormick, 19 *How.* 96 ; aff'g 3 *Blatchf.* 209 ; O'Reilly *v.* Morse, 15 *How.* 62.

As to effect upon right to costs, under Rev. Stat. § 4922, of failure to file disclaimer before bringing suit for infringement,—see Elastic Fabrics Co. *v.* Smith, 100 *U. S.* 110 ; aff'g 1 *Holmes*, 340 ; 5 *Pat. Off. Gaz.* 329; 1 *Bann. & A. Pat. Cas.* 58 ; Reed *v.*

Cutter, 1 *Story*, 590; Hall *v.* Wiles, 2 *Blatchf.* 194; Aiken *v.* Dolan, 3 *Fish. Pat. Cas.* 197; Stutz *v.* Armstrong, 20 *Fed. Rep'r*, 843.

156. *Suits touching interfering Patents.*

Whenever there are interfering patents, any person interested in any one of them, or in the working of the invention claimed under either of them, may have relief against the interfering patentee, and all parties interested under him, by suit in equity against the owners of the interfering patent; and the court, on notice to adverse parties, and other due proceedings had according to the course of equity, may adjudge and declare either of the patents void in whole or in part, or inoperative, or invalid in any particular part of the United States, according to the interest of the parties in the patent or the invention patented. But no such judgment or adjudication shall affect the right of any person except the parties to the suit and those deriving title under them subsequent to the rendition of such judgment. *Rev. Stat.* § 4918.

Where two patents have been issued, each claiming, broadly, the same invention, and the earlier patentee is held to be the first inventor, the claim in the second patent must be restricted to the particular devices specially described. Richardson *v.* Noyes, 10 *Pat. Off. Gaz.* 507; 2 *Bann. & A. Pat. Cas.* 398.

It is not material to the patentee's right that in the interval of delay, other inventors have devised and patented the same thing, if this was wholly without the knowledge or acquiescence of the first inventor. Sprague *v.* Adriance, 14 *Pat. Off. Gaz.* 308; 3 *Bann. & A. Pat. Cas.* 124.

In an action under Rev. Stat. § 4918, where the plaintiff seeks to have the defendant's patent declared void on the ground that it is for the same invention as, and subsequent to, the plaintiff's patent, a plea in bar which admits the priority of the plaintiff's patent for the same invention, but sets out a fact which would render the plaintiff's patent void for want of novelty, must be over-

ruled, because the fact is immaterial in such proceeding. Pentlarge *v.* Pentlarge, 19 *Fed. Rep'r*, 817.

Where a patentee has been defeated in an interference proceeding and a patent has been granted to the other party on the ground that he was the prior inventor, the defeated party will not be allowed to plead, in an action against him for the continued use of the invention, that neither party was in fact the first inventor, if he acted in bad faith. Greenwood *v.* Bracher, 3 *Bann. & A. Pat. Cas.* 302; 1 *Fed. Rep.* 856; 17 *Pat. Off. Gaz.* 1151.

In a suit against an interfering patentee under Rev. Stat. § 4918, the defendant need not file a cross-bill to obtain affirmative relief. Lockwood *v.* Cleaveland, 6 *Fed. Rep'r*, 721; 11 *Rep'r*, 557.

The sole question that can be litigated under Rev. Stat. § 4918, is the question of priority between two interfering patents. Lockwook *v.* Cleaveland, 20 *Fed. Rep'r*, 164.

Under the provisions of Rev. Stat. § 4918,—in respect to interfering patents,—the circuit court has authority to adjudge either of the interfering patents void in whole or in part, and, upon proper issues and proof, to authorize a decree that both patents are void. Foster *v.* Lindsay, 3 *Dill.* 128; 2 *Bann. & A. Pat. Cas.* 172.

There is no provision of law whereby in proceedings for relief against owners of an interfering patent, under Rev. Stat. § 4918, persons who are not inhabitants of and cannot be served in the district, can be brought in as defendants; a service of a mere notice that the suit is pending is inoperative. Liggett, &c. Tobacco Co. *v.* Miller, 1 *Fed. Rep'r*, 203; 1 *McCrary*, 31; 17 *Pat. Off. Gaz.* 798; 5 *Bann. & A. Pat. Cas.* 237.

XIII. INFRINGEMENT.

157. *Nature of the Right which must not be infringed.*

The invention itself, before the patent is issued, is "property" in the inventor, and continues to be such, without the protection of a patent, until he abandons the same to the public, unless he suffers the patented product to be in public use or on sale, with his consent and allowance, for more than two years before he files his applica-

tion for a patent. Jones *v.* Sewell, 6 *Fish. Pat. Cas.* 343 ; 3 *Cliff.* 563; 3 *Pat. Off. Gaz.* 630.

But the right which an inventor has to control the exclusive use of his invention after he has suffered it to be used in public, is the creature of the statute ; the supreme court has always held that he has no right upon which he can maintain suit, unless he obtains letters patent according to the statute ; and his right is regulated and measured by the provisions of the act, and cannot go beyond them. Brown *v.* Duchesne, 19 *How.* 183 ; aff'g 2 *Curt.* 371. S. P., Morton *v.* New York Eye Infirmary, 5 *Blatchf.* 116 ; 2 *Am. L. Reg. N. S.* 672 ; 2 *Fish. Pat. Cas.* 320 ; Waterbury Brass Co. *v.* Miller, 9 *Blatchf.* 77 ; 5 *Fish. Pat. Cas.* 48 ; Sisson *v.* Gilbert, *Id.* 109 ; 9 *Blatchf.* 185 ; *Re* Brosnahan, 18 *Fed. Rep'r*, 62. The exclusive right does not rest alone upon the discovery, but also upon the legal sanctions which have been given to it, and the forms of law with which it has been clothed. Shaw *v.* Cooper, 7 *Pet.* 292, 320.

The applicant must bring himself within the terms of the law before he can derive any title to demand or hold a patent. Pennock *v.* Dialogue, 2 *Pet.* 1, 18 ; aff'g 4 *Wash.* 359.

But (in this country) it is a matter of right, on complying with the conditions prescribed by law. Whitney *v.* Emmett, *Baldw.* 303. It is not a "monoply," but resembles a contract between the government and the inventor, securing to him, for a limited time, the exclusive enjoyment of the practice of his invention, in consideration of his disclosure of the secret to the public, and his relinquishment of his invention to the public at the end of the term (Attorney-General *v.* Rumford Chemical Works, 9 *Pat. Off. Gaz.* 1062 ; McKeever *v.* United States, 14 *Ct. of Cl.* 396 ; 23 *Pat. Off. Gaz.* 1325; Ames *v.* Howard, 1 *Sumn.* 482 ; Blanchard *v.* Sprague, 3 *Sumn.* 535; 2 *Story*, 164); though it is a contract only as between the parties to it, namely, the United States on one side and the patentee on the other. *Re* Brosnahan, 18 *Fed. Rep'r*, 62.

No right of property vests in the public, in the sense of the 5th amendment of the Constitution, because of the consent of the inventor to the public use of his invention, such as will prevent the subsequent allowance, by act of Congress, of a patent for such invention, unless there was, in a particular case, a reduction of the invention to use and practice, by its embodiment in some apparatus, prior to the issue of such patent. Page *v.* Holmes Burglar Alarm Co., 1 *Fed. Rep'r*, 304 ; 17 *Blatchf.* 484 ; 17 *Pat. Off. Gaz.* 737 ; 5 *Bann. & A. Pat. Cas.* 165.

But a patent if valid, gives to the patentee a right of property in the thing patented, which is entitled to full protection in the courts. Whitney *v.* Emmett, *Baldw.* 303. And see Kittle *v.* Merriam, 2 *Curt.* 475; Smith *v.* Pearce, 2 *McLean*, 176.

Although a patentee was the first to conceive of the convenience and utility of the mechanism patented by him, his right to a patent rests upon the novelty of the means he contrives to carry his idea into practical application. Changes in old instrumentalities, made to adapt them to a use for which they were not originally intended, which involve only the exercise of ordinary mechanical skill, do not sanction the patent. Aron *v.* Manhattan R. Co., 26 *Fed. Rep'r*, 314; 34 *Pat. Off. Gaz.* 1508.

As invention is an intellectual process or conception, he who first makes an invention known sufficiently, by describing it in words or drawings, will be considered to be the first discoverer, and vested with an inchoate right to its exclusive use, which he may embody, perfect and make absolute, by proceeding to mature it in the manner which the law requires. Delay in so doing, caused by poverty of the inventor and his inability to engage in the manufacture of the invention, does not prejudice his rights. Hill *v.* Dunklee, 1 *MacArthur Pat. Cas.* 475.

With respect to cases where one person conceives a new and useful idea, which others co-operate with him in developing, the general rule is that the invention and the patent belong to him who forms the conception, especially if he employs them to assist him, pays their wages, and, generally, furnishes means for carrying on the necessary experiments. McClurg *v.* Kingsland, 1 *How.* 202; Worley *v.* Tobacco Co., 104 *U. S.* 340; Sparkman *v.* Higgins, 1 *Blatchf.* 205; 5 *N. Y. Leg. Obs.* 122; 6 *Pa. La. J.* 344; Soler *v.* Mills, 25 *Fed. Rep'r*, 321. Employes may make and patent independent inventions, even though improvements in the machinery used in the employer's business (Hapgood *v.* Hewitt, 11 *Biss.* 184; 21 *Pat. Off. Gaz.* 1786; 11 *Fed. Rep'r*, 422; Berdan Fire Arms Manuf. Co. *v.* Remington, 3 *Pat. Off. Gaz.* 688; Damon *v.* Eastwick, 14 *Fed. Rep'r*, 40; 14 *Rep'r*, 644; 22 *Pat. Off. Gaz.* 1709); but assistance rendered to an employer in development of his conceptions; and suggestions and advice, incidental thereto, do not, in general, give a right under the patent laws. Agawam Co. *v.* Jordan, 7 *Wall.* 583; Pennock *v.* Dialogue, 4 *Wash.* 538; aff'd, 2 *Pet.* 2; Watson *v.* Bladen, 4 *Wash.* 580.

158. *Its Scope and Extent.*

Not only is a patentee's right bounded by the law, it is limited by the patent even though the patent is not as broad as the law under which it is issued, yet the right is under the patent, and not under the law. See Evans *v.* Eaton, *Pet. C. Ct.* 322, 340. See reversal, 3 *Wheat.* 454.

An inventor must be assumed to know of what his invention consists, and his patent does not secure him the exclusive right in anything more than he claims to have invented. Rich *v.* Close, 8 *Blatchf.* 41 ; 4 *Fish. Pat. Cas.* 279.

The grant of a patent gives an exclusive right to the patented invention for all uses to which it can be put, whether contemplated by the inventor or not. But the invention must in some way be covered by the patent before he can acquire an exclusive right to it for any purpose. Tinker *v.* Wilber Eureka Mower, &c. Co., 1 *Fed. Rep'r*, 273 ; 5 *Bann. & A. Pat. Cas.* 92.

A patentee is entitled to all benefits which result from his invention, whether he has specified all the benefits in his patents or not. California Artificial Stone Paving Co. *v.* Perine, 8 *Fed. Rep'r*, 821 ; 7 *Sawyer*, 190 ; 20 *Pat. Off. Gaz.* 813.

In reducing his patent to practical application a patentee is not held to strictly and entirely follow the mere mechanical device shown in his drawings, but he may deviate so long as he does not violate the principle involved in his patent. Weir *v.* North Chicago Rolling Mill Co., 23 *Pat. Off. Gaz.* 191 ; 14 *Fed. Rep'r*, 42 ; 9 *Biss.* 508.

A patentee is not generally limited by the literal import of his description of his invention, but may, in construction, make such modifications of it as do not involve a departure from its principle, or a material change in its mode of operation. Grier *v.* Castle, 17 *Fed. Rep'r*, 533 ; 24 *Pat. Off. Gaz.* 1176.

A naked principle is not patentable ; nor is the application of the *effect* of a principle ; the same effect may therefore be produced by various persons by different means without infringement. Bain *v.* Morse, 1 *MacArthur Pat. Cas.* 90 ; *Re* Halsey, *Id.* 459.

A patentee has the right to grant the right to make and sell the patented invention within specified territory, and to make that right exclusive in the grantee, and yet limit the use of the thing so made and sold, within specified limits; or, while granting to another

a right to make or to make and sell, he may retain to himself the exclusive right to make and sell for export or use in other countries. Dorsey, &c. Rake Co. *v.* Bradley Manuf. Co., 12 *Blatchf.* 202.

The owner of a useful invention has the right to sell it to all who will purchase, subject only to restraint from some party having a conflicting patent. He holds the right from the general law of the land, and needs no act of Congress to enable him to make or vend his article, and obtains no such right from Congress. He obtains from the patent laws only the power to restrain another from unlawfully making, using or vending his invention. Celluloid Manuf. Co. *v.* Goodyear Dental Vulcanite Co., 13 *Blatchf.* 375; 10 *Pat. Off. Gaz.* 41; 2 *Bann. & A. Pat. Cas.* 334.

The sole object and purpose of the patent laws is to give to the inventor a monopoly of what he has discovered. What is granted to him is the exclusive right; not the abstract right, but the right in him to the exclusion of everybody else. He is not authorized by the patent laws to manufacture and sell the patented article in violation of the laws of the state. His enjoyment of the right may be modified by the exigencies of the community to which he belongs, and regulated by laws which render it subservient to the general welfare, if held subject to State control. *Re* Brosnahan, 18 *Fed. Rep'r*, 62.

One who invents a new machine never used before, and procures letters patent therefor, acquires a monopoly as against all merely formal variations thereof; but if the advance toward the thing desired is gradual, and proceeds step by step, so that no one can claim the complete thing, each inventor is entitled only to his own specific form of device. Railway Co. *v.* Sayles, 97 *U. S.* 554.

When an invention is simply an improvement on a known machine, by a mere change of form or of combination of parts, the inventor is entitled only to the specific form of device which he has produced; and he cannot invoke the doctrine of equivalents to suppress other improvements except such as are mere colorable invasions of his own. But where an inventor preceedes others, and his machine performs a function never performed by any earlier machine, the court will treat as infringers all who accomplish the same result by substantially the same or substantially equivalent means. Morley Sewing Machine Co. *v.* Lancaster, 23 *Fed. Rep'r*, 344.

An inventor who first applies an old device to a new use is not entitled to the exclusive use of such device when applied in other

mechanisms not analogous to produce a new effect. Judd *v.* Babcock, 8 *Fed. Rep'r*, 665 ; 23 *Pat. Off. Gaz.* 92.

Where a patent clearly shows and describes a machine whose use necessarily involves the production of a certain process, no other person can afterwards patent that process. The patentee is entitled to his mechanism for every use of which it is capable, and there is no invention in the use of an old machine for a new purpose. New Process Fermentation Co. *v.* Koch, 21 *Fed. Rep'r*, 586; 29 *Pat. Off. Gaz.* 535.

Although an invention be a primary one and the machine invented be the first practical one for accomplishing the result, and although the patent for it declares that the machine described is only one of different mechanisms contemplated by the patentee which may be effectually employed for carrying out the main feature of his invention, he is entitled only to the exclusive use of the particular contrivance to make the idea practically useful ; the patent does not give an exclusive right to the principle, or to groups of instrumentalities, independent of the mechanism desired. Morley Sewing Machine Co. *v.* Lancaster, 23 *Fed. Rep'r*, 344.

159. *How long it endures.*

Congress having power to secure, "for limited times," to inventors, the exclusive right to their discoveries, in consideration of the benefit which the public will derive from the invention after the expiration of the term, whatever was patented to the inventor and enjoyed by the inventor and those operating in any way under him during the term, belongs to the public and is free to all at the expiration of the term. Wilcox, &c. Sewing Machine Co. *v.* The Gibbons Frame, 17 *Fed. Rep'r*, 623 ; 21 *Blatchf.* 431 ; 24 *Pat. Off. Gaz.* 1272 ; McCormick *v.* Manny, 6 *McLean*, 539 ; 4 *Am. L. Reg.* 277. The patentee cannot claim to continue the exclusive use on the ground that the shape, name, design, etc., under which he has been accustomed to sell the invention has become a trademark. Wilcox, &c. Sewing Machine Co. *v.* The Gibbons Frame, *supra* ; Fairbanks *v.* Jacobus, 14 *Blatchf.* 337 ; Consolidated Fruit Jar Co. *v.* Dorflinger, 2 *Am. L. T. N. S.* 571 ; Singer Manuf. Co. *v.* Stanage, 6 *Fed. Rep'r*, 279 ; 2 *McCrary*, 512 ; 11 *Rep'r*, 661 ; Same *v.* Riley, 11 *Fed. Rep'r*, 706 ; Singer Manuf. Co. *v.* Larsen, 8 *Biss.* 151; 3 *Bann. & A. Pat. Cas.* 246 ; Tucker Manuf. Co. *v.* Boying-

ton, 9 *Pat. Off. Gaz.* 455; Leclancha Battery Co. *v.* Western Electric Co., 21 *Fed. Rep'r*, 538. But see Lorillard *v.* Wight, 15 *Fed. Rep'r*, 383.

Devices made according to a patent, but which have been made and combined since the expiration of the patent, are not an infringement of the patent, or violative of an injunction order restraining infringements during the term of the patent. American Diamond Rock-Boring Co. *v.* Sutherland Falls Marble Co., 2 *Fed. Rep'r*, 353; 18 *Blatchf.* 148; 10 *Rep'r*, 9; 5 *Bann. & A. Pat. Cas.* 247.

A patent, bearing date May 15, 1855, does not expire until the last hour of May 15, 1869. Johnston *v.* McCullough, 4 *Fish. Pat. Cas.* 170.

Where, under the acts of July 4, 1836, and March 3, 1839, a patent was taken out for a machine for the manufacture of a specific article, and subsequently, and within two years, patents were granted for the process of manufacturing such article, and also for the product of such process as a new article of manufacture,—it was *held*, that the patents for the process and product did not terminate with the expiration of the patent for the mechanism, although it might be of no value except to carry on such patent process and manufacture such patent product. McKay *v.* Dibert, 5 *Fed. Rep'r*, 587; 19 *Pat. Off. Gaz.* 1351; 11 *Rep'r*, 386.

The burden of proof is on a party seeking to limit the duration of a patent, to show the facts which limit it. American Diamond Rock-Boring Co. *v.* Sheldon, 17 *Blatchf.* 303; 4 *Bann. & A. Pat. Cas.* 603.

The intent of the act of 1861, declaring that all patents hereafter issued shall remain in force for seventeen years, and repealing inconsistent acts, was simply to increase the duration of all patents thereafter issued, giving to each an additional period of three years. Siemens *v.* Sellers, 23 *Pat. Off. Gaz.* 2234; 16 *Fed. Rep'r*, 856.

For the statute and decisions limiting patents for inventions patented abroad, see Rev. Stat. § 4887; *ante*, pp. 60–65.

160. *General Rules for Construction of Patents.*

A patent must be construed and passed upon according to the laws in force at the time of granting it; the repeal of such acts cannot impair the right of property existing in a patentee. McClurg *v.* Kingsland, 1 *How.* 202; Hogg *v.* Emerson, 6 *How.* 437, 479; aff'g 2 *Blatchf.* 1.

Patents are to be construed in a liberal manner, so as to give them effect, and to secure the rights of the patentees. Grant *v.* Raymond, 6 *Pet.* 218; Simpson *v.* Wilson, 4 *How.* 709; Turrill *v.* Michigan Southern, &c. R. R. Co., 1 *Wall.* 491; Ames *v.* Howard, 1 *Sumn.* 482; Blanchard *v.* Sprague, 3 *Sumn.* 535; 2 *Story*, 264; Ryan *v.* Goodwin, *Id.* 514; 3 *L. Rep'r*, 220; Davoll *v.* Brown, 1 *Woodb. & M.* 53; Carew *v.* Boston Elastic Fabric Co., 3 *Cliff.* 356; 5 *Fish. Pat. Cas.* 90; 1 *Pat. Off. Gaz.* 91; Goodyear Dental Vulcanite Co. *v.* Gardiner, 3 *Cliff.* 408; 5 *Pat. Off. Gaz.* 586; 4 *Fish. Pat. Cas.* 224; Goodyear *v.* Railroad, 2 *Wall. Jr.* 356; 1 *Fish. Pat. Cas.* 626; Davis *v.* Palmer, 2 *Brock. Marsh.* 298; Bloomer *v.* Stolley, 5 *McLean*, 158; 8 *West. L. J.* 158; Allen *v.* Hunter, 6 *McLean*, 303; Latta *v.* Shawk, 1 *Fish. Pat. Cas.* 465; 1 *Bond*, 259.

That they should be construed strictly, because in derogation of common right, see *Re* Kemper, *MacArthur Pat. Cas.* 1.

The true rule of construction is to apply plain and ordinary principles, and not to yield to subtleties and technicalities unsuited to the subject, and not in keeping with the liberal spirit of the age, and likely to prove ruinous to a class of the community so inconsiderate and unskilled in business as men of genius and inventors usually are. Hogg *v.* Emerson, 6 *How.* 437, 485. See also, Davoll *v.* Brown, 1 *Woodb. & M.* 53; Woodworth *v.* Hall, *Id.* 248; 6 *Pa. L. J.* 178; Winans *v.* Denmead, 15 *How.* 332; Imlay *v.* Norwich & Worcester R. R. Co., 4 *Blatchf.* 227; 1 *Fish. Pat. Cas.* 340; Henderson *v.* Cleveland Co-operative Stove Co., 2 *Bann. & A. Pat. Cas.* 604.

The rule that patents are to be construed liberally, so as, if possible, to carry out the construction claimed by the patentee, and sustain the patent, applies to a reissue as well as an original patent; thus, where the meaning of the specification and claim in the reissue is not perfectly clear, they may be read by the light of the specification and claim of the original patent, and, if consistent with the language there used, be sustained by them. Klein *v.* Russell, 19 *Wall.* 433. See, also, Bussey *v.* Wager, 9 *Pat. Off. Gaz.* 200.

In patents for combinations of mechanism, limitations and provisos imposed by the inventor, especially such as were introduced into an application after it had been persistently rejected, must be strictly construed, against the inventor. Sargent *v.* Hall Safe & Lock Co., 114 *U. S.* 63, 29.

In construing a patent, the court looks through the whole patent and specification, in order to ascertain what is the thing claimed and patented in it. There is no artificial or universal rule of interpretation of such an instrument beyond that which common sense furnishes, which is, to construe the instrument as a whole, and extract from the descriptive words and the claim what the invention is which is intended to be patented, and how far it is capable of exact ascertainment, and how far it is maintainable in point of law, supposing it clear from all ambiguity. Carver *v.* Braintree Manuf. Co., 2 *Story*, 432, 446. S. P., Pitts *v.* Whitman, 2 *Story*, 609; Carew *v.* Boston Elastic Fabric Co., 3 *Cliff.* 356; 1 *Pat. Off. Gaz.* 91; 5 *Fish. Pat. Cas.* 90; Sullivan *v.* Redfield, 1 *Paine*, 441; Goodyear *v.* Railroad, 2 *Wall. Jr.* 356; 1 *Fish. Pat. Cas.* 626; National Car Brake Shoe Co. *v.* L. S. & M. S. Ry. Co., 4 *Fed. Rep'r*, 219; 9 *Biss.* 503; 18 *Pat. Off. Gaz.* 1179.

In deciding on the sufficiency of a patent, the court inspects the whole description as one paper, which they assume to be true in fact; and if found to be in conformity with the requisitions of the law, so that it appears with reasonable certainty, either from the words used or by necessary implication, in what the invention consists, though the description may be somewhat obscure, or imperfect, or defective, in form or mode of explanation, as claimed by the patentee, it will be adjudged sufficient. Carver *v.* Braintree Manuf. Co., 2 *Story*, 432; Whitney *v.* Emmett, *Baldw.* 303.

The power to correct mistakes in letters patent does not belong to the courts, but it is confided to the commissioner. The court can only construe the specification and claim as they stand, and determine the legal effect of the claim. Kittle *v.* Merriam, 2 *Curt.* 475.

A patent, being a pioneer and foundation patent, both as to process and machine, is not to be construed as confined to specific details, if it fairly admits of the liberal construction to which such a patent is entitled. Hammerschlag *v.* Seamoni, 7 *Fed. Rep'r*, 584; 20 *Pat. Off. Gaz.* 75.

In the construction of letters patent, reference will be made to the existing state of the art at the time of the invention. Wollensak *v.* Reiher, 115 *U. S.* 87, 29. Patents are to be construed in the light of what was before known to persons skilled in the art to which they relate, in order to give effect to the true meaning of what is there described. Webster Loom Co. *v.* Higgins, 16 *Pat. Off. Gaz.* 675.

Decisions and opinions as to the validity of a patent are authorities in all similar cases, but not estoppels in any, except such as may arise between those very parties, or others claiming under them. But where there was no *prima facie* evidence to impeach the validity of a patent sustained in previous cases, it was construed with reference to prior existing devices to ascertain its scope. Day *v.* Combination Rubber Co., 2 *Fed. Rep'r*, 570; 17 *Pat. Off. Gaz.* 1347; 5 *Bann. & A. Pat. Cas.* 385.

An inventor is supposed to describe in his patent the best mode of practicing his invention; but it is not necessarily limited to the precise constructions shown, so as to exclude a method differing from it only in a single detail, but producing the same result. Lorillard *v.* McDowell, 11 *Pat. Off. Gaz.* 640; 23 *Int. Rev. Rec.* 90; 13 *Phila.* 461; 2 *Bann. & A. Pat. Cas.* 531.

Whether two patents cover the same invention must be determined by the tenor and scope of their claims, not by the description in the patent. McMillan *v.* Rees, 1 *Fed. Rep'r*, 722; 17 *Pat. Off. Gaz.* 1272; 9 *Rep'r*, 544; 5 *Bann. & A. Pat. Cas.* 269.

The court should sustain the interpretation of a patent claimed for it by the patentee, if this can be done consistently with the language he has employed. Bradley *v.* Dull, 19 *Fed. Rep'r*, 913; 27 *Pat. Off. Gaz.* 625.

A construction of a patent which would render a disclaimer altogether nugatory should not be adopted. Atlantic Giant Powder Co. *v.* Hulings, 21 *Fed. Rep'r*, 519.

Though the construction of the patent must certainly depend on the words of the instrument, where the words are ambignous, there may be circumstances which ought to have great influence in expounding them. The intention of the parties, if that intention can be collected from sources which the principles of law permit the courts to explore, are entitled to great consideration. Therefore, a special act may be referred to, as well as the patentee's petition, and such construction should be given to the grant as will make it, with such documents forming a part of it, not contradictory with itself. Evans *v.* Eaton, 3 *Wheat.* 454, 506; rev'g *Pet. C. Ct.* 322.

Declarations of a patentee and former owner of a patent, undertaking to restrict the invention within a narrower compass than that stated in his specification, will not be allowed to vary the construction which would otherwise be given to the patent. Union

Paper Bag Machine Co. *v.* Pultz, &c. Co., 15 *Blatchf.* 160; 15 *Pat. Off. Gaz.* 423; 3 *Bann. & A. Pat. Cas.* 403.

161. *Of Specifications.*

The schedule or specification annexed to the letters-patent is, under our laws and practice, to be regarded as a competent part of the letters-patent, and may be referred to explain or add to the title of the patent. Hogg *v.* Emerson, 6 *How.* 437, 478; aff'g 2 *Blatchf.* 1. See Evans *v.* Eaton, *Pet. C. Ct.* 322.

The patent and specification are connected together and dependent upon each other for support. The specification should maintain the title of the patent; the latter should not indicate one thing, and the former describe another, as to the subject of the grant. Sullivan *v.* Redfield, 1 *Paine*, 441; Goodyear *v.* Railroad, 2 *Wall. Jr.* 356; 1 *Fish. Pat. Cas.* 626.

Sometimes the preamble, even, may be resorted to for ascertaining the object of the specification, sometimes the body of the specification, sometimes the summing up, and sometimes the formal clause at the end of the specification. Generally, all of them are examined together, unless the formal clause seems explicitly to exclude the rest. Davoll *v.* Brown, 1 *Woodb. & M.* 53.

If the specification of a patent, taken as a whole, leaves no reasonable doubt concerning the intention of the patentee to include in his claim a certain part of a combination, though there may be an error in describing it, it will be considered as included. Kittle *v.* Merriam, 2 *Curt.* 475.

If the specification is wholly ambiguous and uncertain, so loosely defined and so inaccurately expressed, that the court cannot, upon fair interpretation of the words, and without vague conjecture of intention, gather what it is, the patent is void for such defect. But if the court can fairly see, by a reasonable use of the means of interpretation of the language used, taking the whole into connection, what is the nature and extent of the claim, then the plaintiff is entitled to the benefits of it, however imperfectly and inartificially he may have expressed himself. Ames *v.* Howard, 1 *Sumn.* 482. S. P., Ryan *v.* Goodwin, 3 *Sumn.* 514; 3 *L. Rep'r*, 220; Emerson *v.* Hogg, 2 *Blatchf.* 1. See affirmance, 6 *How.* 437; Parker *v.* Stiles, 5 *McLean*, 44, 57; 7 *West. L. J.* 168. Such a construction as will allow an inventor to couch his specifi-

cation in such ambiguous terms that its claims may be expanded or contracted to suit the emergency should not be allowed. Detmold *v.* Reeves, 5 *Pa. L. J. Rep* 99.

The words of the specification are to be taken together, and they are to be so construed as to give effect to the meaning and intention of the persons using them. Words are not to be distorted so as to effect what may be supposed to have been the intention of the one using them; but they are to have a reasonable construction, as connected with the sentence in which used. Allen *v.* Hunter, 6 *McLean*, 303.

A general description of the nature of the invention at the beginning of a specification, is not to be taken alone, in determining what is covered by the patent, but should be construed with a description of the invention itself, also contained in the specification, which gives instructions as to how the patented device is made, and specific directions as to characteristics which it must possess. Holt *v.* Kendall, 26 *Fed. Rep'r*, 622

162. *Claims*

In general, when a patentee describes a machine and then claims it as described, he is understood to intend to claim, and by law does actually cover, not only the precise forms he has described, but all other forms which embody his invention. Winans *v.* Denmead, 15 *How.* 342. Followed, Grier *v.* Castle, 17 *Fed. Rep'r*, 523; 24 *Pat. Off. Gaz.* 1176.

Where the "claim" immediately follows the description, it may be construed in connection with the explanations contained in the specification; and be restricted accordingly. Turrill *v.* Michigan Southern, &c. R. R. Co., 1 *Wall.* 491. See, also, Hovey *v.* Stevens, 3 *Woodb. & M.* 17; Winans *v.* Denmead, 15 *How.* 330; Matthews *v.* Shoneberger, 4 *Fed. Rep'r*, 635; 18 *Blatchf.* 357; 18 *Pat. Off. Gaz.* 1464; Roberts *v.* Dickey, 4 *Brews.* 260; 3 *Pittsb.* 352; 1 *Pat. Off. Gaz.* 4; 4 *Fish. Pat. Cas.* 532; McMillin *v.* Rees, 5 *Bann. & A. Pat. Cas.* 269.

A claim for a combination of several devices, so combined together as to produce a particular result, is not good as a claim for "any mode of combining those devices which would produce that result," and can only be sustained as a valid claim for the peculiar combination of devices invented and described. Case *v.* Brown, 2 *Wall.* 320; aff'g 2 *Fish. Pat. Cas.* 268.

The courts of this country cannot always indulge the same latitude which is exercised by English judges in determining what parts of a machine are or are not material. Our law requires the patentee to specify particularly what he claims to be new, and if he claims a combination of certain elements or parts, the court cannot declare that any one of these elements is immaterial. The patentee makes them all material by the restricted form of his claim. The courts can only decide whether any part omitted by an alleged infringer is applied by some other device or instrumentality which is its equivalent. Water Meter Co. *v.* Desper, 101 *U. S.* 332. And see Lefever *v.* Remington, 22 *Pat. Off. Gaz.* 1537.

The courts should be careful not to enlarge, by construction, the "claim" which the patent-office has admitted, and which the patentee has acquiesced in, beyond the fair interpretation of its terms. Burns *v.* Meyer, 100 *U. S.* 671.

The scope of letters patent should be limited to the invention covered by the claim, and this cannot be enlarged by the language in other parts of the specification. Western Electric Manuf. Co. *v.* Ansonia Brass & Copper Co., 114 *U. S.* 447, 29.

Where, after an application for a patent for combination is rejected, the applicant, in order to obtain a patent, upon a new application, narrows his claim by the introduction of a new element, and a patent is thereupon issued to and accepted by him, he cannot afterwards, in a suit for infringement, enlarge the patent by construction so as to cover elements not falling within its terms and which he had explicitly abandoned. Shepard *v.* Carrigan, 116 *U. S.* 593.

Where a wholly new method or art has been discovered by a patentee, the courts will construe the claims of his patent broadly, and so as to cover all such mechanical means as embody the real invention. Standard Measuring Machine Co. *v.* Teague, 15 *Fed. Rep'r*, 390. S. P., Kimball *v.* Hess, *Id.* 393; 15 *Rep'r*, 583.

Where two patents have been issued, each claiming, broadly, the same invention, and the earlier patentee is held to be the first inventor, the claim in the second patent must be restricted to the particular devices there specially described. Richardson *v.* Noyes, 10 *Pat. Off. Gaz.* 507; 2 *Bann. & A. Pat. Cas.* 398.

The technical claims in a patent are to be construed with reference to the state of the art, so as to limit the patentee to, and give him the full benefit of, the invention he has made. Estabrook *v.* Dunbar, 19 *Pat. Off. Gaz.* 909; 2 *Bann. & A. Pat. Cas.* 427.

Although it is true that in the construction of a claim, reference may be had to the specification, to ascertain the true interpretation of the claim, yet, where the claim is such as to leave no room for construction, where it is clear and explicit, and especially, where there is nothing in the specification which shows that the patentee did not mean just what the plain language of the claim imports, the court is not aided by, and has no need of aid from, such specification. Rich *v.* Close, 8 *Blatchf.* 41 ; 4 *Fish. Pat. Cas.* 279.

A patent covers only the devices which are claimed, although others are described by way of explaining them or illustrating the way in which they operate. Wheeler *v.* McCormick, 4 *Pat. Off. Gaz.* 692 ; 11 *Blatchf.* 334 ; 6 *Fish. Pat. Cas.* 551. S. P., Couse *v.* Johnson, 16 *Pat. Off. Gaz.* 719 ; 4 *Bann. & A. Pat. Cas.* 500.

Where a claim is not limited to a particular form of construction of device, and the specification does not assign as a peculiar merit or claim, any new result of a product of its conformation, such form cannot be considered as an essential part of the invention. Couse *v.* Johnson, *supra.*

Where a claim of the patent appears to be for a result, produced substantially "in the manner and for the purposes" described, the claim will be construed to be for the mechanism set forth in the specifications, by which the result is produced, and not for the result itself. The principle, of construing a claim for a result to be a claim for the means by which the result is produced, is applied to all cases where a result is claimed, whether there is any reference to the specifications in the claim or not. Henderson *v.* Cleveland Co-operative Stove Co., 2 *Bann. & A. Pat. Cas.* 604.

Where a particular result is claimed by an inventor of an improvement, the patent protects only such result as a whole ; not each particular entering into it. Huggins *v.* Hubby, 3 *West. L. Month.* 347.

A patent claim must be construed in the light of the specifications ; and where the specifications describe the entire article, parts of the description cannot be separately considered, to show an infringement of one of the parts. Evans *v.* Kelly, 13 *Fed. Repr.* 903 ; 9 *Biss.* 251 ; 26 *Int. Rev. Rec.* 349 ; 23 *Pat. Off. Gaz.* 192 ; 5 *Bann. & A. Pat. Cas.* 71. See Haselden *v.* Ogden, 3 *Fish. Pat. Cas.* 378.

Where there is a slight change in a machine, by which a new result is brought about, and which might be the subject of a patent, courts do not feel inclined to extend the invention beyond the mere

change, although they may be inclined to sustain the patent; but where something elementary has been discovered and constitutes fairly a part of the invention of the patentee, no other inventor or manufacturer ought to be permitted to use that elementary part without paying tribute to the first inventor or originator. Cornell *v.* Downer, &c. Brewing Co., 7 *Biss.* 340; 11 *Pat. Off. Gaz.* 331; 2 *Bann. & A. Pat. Cas.* 514.

The claim in a patent cannot be enlarged by construction, even though it might have been made broader, in view of the invention described in the specifications and drawings. Becker *v.* Hastings, 22 *Fed. Rep'r*, 827; 28 *Pat. Off. Gaz.* 98. S. P., Wyeth *v.* Stone, 1 *Story*, 274.

A claim, in a patent for a new manufacture, of a coloring matter obtained "substantially in the manner set forth, or by any other method which will produce a like result," was construed as covering any method of treatment the equivalent of the process described, producing like results; and chemical identity of an article produced by alleged infringers, *held, prima facie* sufficient proof of infringement by them. Pickhardt *v.* Packard, 22 *Fed. Rep'r*, 530; 20 *Pat. Off. Gaz.* 170. See Knox *v.* Martha, 9 *Blatchf.* 205; 5 *Fish.* 170.

In the construction of claims in a patent, however careful the courts should be not to enlarge a claim, they may apply intelligently and fairly, for the purpose of ascertaining the actual meaning, every part of the specification to which it refers; and may consider as embodied in the claim, whatever by fair interpretation is drawn into it from the other parts. Thus, where the form and proportions and arrangement and position of the elements of a combination are mentioned in the claim, it may be understood as referring to a combination of those elements when they are formed or proportioned or placed substantially as there described, and for the purpose there stated. Fisk *v.* Hollander, *MacArthur & M.* 355.

163. *Drawings, Models, &c.*

Models and drawings are a part of the letters-patent, and may be resorted to for clearer information respecting the invention described in the specification. Hogg *v.* Emerson, 6 *How.* 437, 435; aff'g 2 *Blatchf.* 1. Compare Grant *v.* Mason, 1 *L. Int. & R. v.* 22.

Drawings annexed and referred to in the specification constitute

a part thereof ; and they may be resorted to to aid the description, and to distinguish the thing patented from other things known before. Earle *v.* Sawyer, 4 *Mas.* 1 ; Washburn *v.* Gould, 3 *Story*, 122 ; 1 *West. L. J.* 465 ; 7 *L. Rep'r*, 276 ; Knight *v.* Gavit, *Mir. Pat. Off.* 183. S. P., Hogg *v.* Emerson, 11 *How.* 587, 606 ; 2 *Blatchf.* 1 ; Howes *v.* Nute, 4 *Fish. Pat. Cas.* 263 ; Heinrich *v.* Luther, 6 *McLean*, 345.

The question as to the sufficiency of a description must be determined, like a question of construction, from what is written, aided by the drawings, and, if need be, by the patent-office model. Particular passages in a description must not be separated from what precedes or follows them in the same connection ; but one part of the instrument must be compared with another, and the whole considered together, in order to determine whether it is incomplete and ambiguous, or sufficient to uphold the claim. If the drawings are clear, reference to them may be made in the written description, to aid in an understanding of the nature of the invention. Howes *v.* Nute, 4 *Cliff.* 173. See Seymour *v.* Osborne, 11 *Wall.* 516.

The drawing may be examined by the court in an infringement case to explain an ambiguity in the specification, but not to supply a part lacking. Tinker *v.* Wilbers Eureka Mower, &c. Manuf. Co., 5 *Bann. & A. Pat. Cas.* 92 ; 1 *Fed. Rep'r*, 138 ; 9 *Rep'r*, 273 ; Banker *v.* Bostwick, 5 *Bann. & A. Pat. Cas.* 463.

When the invention patented consists of a combination of old elements to produce a new result, mere matters of adjustment of the individual elements are not limited or controlled by the drawings, unless, 1. They are expressly so limited by the specifications as well ; or, 2. Such limitation and control are essential to produce the result claimed. Hamilton v. Ives, 3 *Pat. Off. Gaz.* 30 ; 6 *Fish. Pat. Cas.* 244.

For the weight to be given to drawings filed with a patent issued prior to December 15, 1836, by virtue of the act of March, 1837, § 1 (5 Stat. 191), see Emerson *v.* Hogg, 2 *Blatchf.* 1 ; and affirmance, 6 *How.* 437 ; Winans *v.* Schenectady & Troy R. R. Co., 2 *Blatchf.* 279, 298.

164. *Referring to Application, &c*

The original application for letters-patent (with its accompanying drawings and model), filed by an inventor, should possess great weight in showing what his invention really was, especially where

it remains unchanged for a considerable period, and is afterward amended so as to have a broader scope. But amendments embracing any material variation from the original application cannot be sustained on the original application, and should not be allowed; if they were, great injustice might be done to others who may have invented or used the same things in the meantime. Railway Co. *v.* Sayles, 97 *U. S.* 554.

Neither the correspondence between the commissioner of patents and the applicant nor the proceedings in the patent-office, pending an application, are admissible as evidence to enlarge, diminish, or vary the language of the claim of a patent. Goodyear Dental Vulcanite Co. *v.* Gardiner, 3 *Cliff.* 408; 5 *Pat. Off. Gaz.* 586; 4 *Fish. Pat. Cas.* 224.

In an action for infringement of a patent, letters of the plaintiff to the patent-office, containing his application for a patent, and inclosing a specification substantially agreeing with his patent afterward issued, and asserting his claim as inventor to the invention described, are properly admissible in evidence to show the existence of such facts. Pettibone *v.* Derringer, 4 *Wash.* 215. Ambiguity in a patent and specification may be explained by the affidavit annexed to the specification. *Ib.*

In interpreting the language of a patent, in order to know what construction the patentee himself placed upon it, recourse may be had to the files of the application, to ascertain what changes were made in the original specification and claims, and the significance of those changes as revealed by the history of the case. Trader *v.* Messmore, 7 *Pat. Off. Gaz.* 385; 1 *Bann. & A. Pat. Cas.* 639.

If the field of invention be bounded by prior patents, though referring to the objects of the patent in issue only by general terms known in the art to which they belong, to include them, the description of what the inventor undertook to cover must be construed in the light of their existence. Parsons *v.* Colgate, 15 *Fed. Rep'r,* 600; 24 *Pat. Off. Gaz.* 203.

165. *Consulting Experts on Questions of Construction.*

The opinion of experts cannot be received as to the construction of a patent. Experts may be examined as to the meaning of terms of art, on the principle of *cuique in sua arte credendum;* but not as to the construction of written instruments. Corning *v.* Burden,

15 *How.* 252, 270 ; Winans *v.* New York & Erie R. R. Co., 21 *How.* 88, 100.

The established practice of taking testimony of experts on the diversity of the inventions embraced in two different patents, instead of requiring courts to compare the specifications and give the jury instructions on the question as one of law, does not trench upon the doctrine that the construction of written instruments is the province of the court alone: for it is not the construction of the instrument, but the character of the thing invented, which is sought in questions of identity and diversity of inventions. Bischoff *v.* Wethered, 9 *Wall.* 812.

Whether a patent is void for uncertainty or ambiguity in the description, is a matter of fact to be decided upon the evidence of experts. Washburn *v.* Gould, 3 *Story*, 122, 138 ; 7 *L. Rep'r*, 276; 1 *West. L. J.* 465

Two different translations of a phrase in a French patent for a firearm, equivalent to "breech-loading," were urged upon the court, supported by testimony of experts. The court adopted that which was more literal, which better accorded with the other parts of the instrument not involved in doubt, and was germane to the invention and more in harmony with the other language of the patent. White *v.* Allen, 2 *Cliff.* 224 ; 2 *Fish. Pat. Cas.* 440.

The mere opinion of an expert, that two pieces of machinery constructed to produce the same results and working out those results by means so nearly identical as to create a strong presumption of a common origin, are essentially different in mechanical structure and mode of operation, when he does not point out the particular differences or coincidences between the two, is not enough to determine the right to a preliminary injunction. United States Annunciator, &c. Manuf. Co. *v.* Sanderson, 3 *Blatchf.* 184.

166. *Application of Rules of Construction in peculiar cases.*

Patent granted to Goodwin, in 1876, for improvements in harvesters, was construed, as to its claim of a pivotal rock-shaft, and *held* to be restricted to the specific device claimed, and therefore not infringed by a different, although perhaps substantially equivalent device. Goodwin *v.* Randolph, 21 *Fed. Rep'r*, 575.

Patent granted to Lull and Porter, in 1854, for an improvement

in shutter hinges, was construed, and *held* to include in its claim, substantially two claims; one for such of the described mechanism as is necessary to secure the described swinging and locking of the shutter, and the other for such of the described mechanism as is necessary to secure the result described as to strain on the spindle. The former claim was *held* infringed by a device which was a mere formal variation therefrom, having the same mode of operation. Lull *v.* Clark, 21 *Blatchf.* 95.

Patent granted to Adams, in 1860, for an improvement in the electro-deposition of nickel, was construed, with regard to the validity and extent of its claims, and *held* infringed by the use of a solution which, though not the same as that described by Adams, accomplished the same results by the same electro-chemical mode of operation, by the same process, with the absence of the same injurious elements. United Nickel Co. *v.* Pendleton, 21 *Blatchf.* 226.

A claim in a patent for a combination, the elements or parts of which were old, was construed, in connection with the state of the art, as limited substantially to the special character of parts and the particular organization described; and *held*, not infringed by a machine differing from that described in the specifications in construction and organization, and also in mode of operation and the result produced. Buzzell *v.* Andrews, 25 *Fed. Rep'r*, 822; 34 *Pat. Off. Gaz.* 830.

Patent granted to Clark in 1877, for an improvement in lubricators, construed, and compared with the device for which a patent was granted to Swift, in 1884. That device was *held* not an infringement of the patent to Clark; the doctrine of equivalents not being applicable to the case, and the difference in details of construction of the Swift device, from the earlier patents, appearing to be so great that it might fairly be deemed a patentable invention. Jenks *v.* Swift, 25 *Fed. Rep'r*, 722; 34 *Pat. Off. Gaz.* 609.

The claim of the original patent granted to Garner, in 1869, to a circular-shaped harrow tooth "constructed and used in the manner and for the purposes herein specified," construed, with the drawings and specifications referred to, and *held* to include within its grant the exclusive right not only to harrow teeth made literally according to the drawings and descriptions of the specifications, but also all similar harrow teeth fastened at one end to the bars or frame of the harrow, and curved so as to form an arch, above the plane of the bars or frame of the harrow, and descend between the bars, in a curve, to the ground, their points inclining forward; and

therefore to cover everything embraced in the seven claims of the reissued patent for the same invention granted in 1880. Reed *v.* Chase, 25 *Fed. Rep'r*, 94 ; 33 *Pat. Off. Gaz.* 996.

Patents issued to Black, in 1870, and to Garland in 1871, for improvements in automatic relief valves, were construed, with reference to prior inventions, and *held* to be limited to the specific mechanisms described in the patents, or their equivalents ; and that, so limited, neither patent was infringed by mechanism substantially different from that described in it. Shaw Relief Co. *v.* City of New Bedford, 26 *Fed. Rep'r*, 331.

Patent issued to Martin, in 1877, for improvement in furniture casters, was construed, with reference to the prior state of the art. It was *held* to be limited to certain details of construction, and therefore was not infringed in the particular case. It appeared that the combination patented accomplished no new result in mechanics, and differed from previous known combinations designed for the same and similar purposes, only in the construction of one or two of the parts, whereby perhaps a better but certainly not a different kind of result was accomplished than had been before effected. Phœnix Caster Co. *v.* Spiegel, 26 *Fed. Rep'r*, 272.

A patentee who accepts a narrow claim can not be allowed to extend it by construction so as to cover devices not within its terms. Roemer *v.* Peddie, 27 *Fed. Rep'r*, 702.

167. *What constitutes Infringement, generally.*

Inventions pertaining to machines may be divided into four classes. 1. Where the invention embraces the entire machine. 2. Where the invention embraces one or more of the elements of the machine, but not the entire machine. 3. Where the invention embraces both a new element and a combination of elements previously known. 4. Where all the elements are old, and a new combination, producing a new result, is made out of them. Union Sugar Refinery *v.* Mathiessen, 3 *Cli.* 639 ; 2 *Fish. Pat. Cas.* 600 ; Sanford, *v.* Merrimac Hat Co., 10 *Pat. Off. Gaz.* 466.

A person is an infringer of a patent of the first class who, without license, makes any portion of the machine ; of the second when the part new and patented is made or used ; of the third, when the new element or new combination is used ; of the fourth, when the patented combination is pirated. Union Sugar Refinery

v. Mathiessen, *supra.* See Haseldean *v.* Ogden, 3 *Fish. Pat. Cas.* 378.

There may be an infringement by the use of the patented article for a purpose not mentioned in the patent and for which it was not intended. Zinn *v.* Weiss, 7 *Fed. Rep'r*, 914.

A change in the mode of a device, where all its benefits are secured thereby, is an infringement. Union Paper Bag Co. *v.* Nixon, 9 *Pat. Off. Gaz.* 691; 1 *Flippin*, 491; 2 *Bann. & A. Pat. Cas.* 240.

Every manufacture for sale abroad, followed by actual sale, of a machine on which an American patent has been issued, is an infringement of the American patentee's rights of property and exclusive use. Ketchum Harvester Co. *v.* Johnson Harvester Co., 8 *Fed. Rep'r*, 586; 19 *Blatchf.* 367; 12 *Rep'r*, 553.

If a machine is so constructed as to conform to the description in the patent except as to one particular, but with the design that this effect shall be attained by the action or wearing of the parts in use, there is an infringement. American Diamond Rock-boring Co. *v.* Sullivan Machine Co., 14 *Blatchf.* 119; 2 *Bann. & A. Pat. Cas.* 522.

Where a party sells an article to persons who intend to use it in the combination claimed in the patent, and it is advertised and sold for that very purpose, such sale is an infringement, although the manufacture and sale would not, *per se*, be an infringement. Bowker *v.* Dows, 15 *Pat. Off. Gaz.* 510; 3 *Bann. & A. Pat. Cas.* 518. Thus the making and sale by defendants of an article, which, of necessity, to their knowledge, was to be used for the purpose of infringing the complainant's patent was *held* to render them liable as infringers. Travers *v.* Beyer, 26 *Fed. Rep'r*, 450.

It is not necessary to constitute an infringement that a man should work by the specification contained in the patent. He might not even know that there was such a patent, and still infringe it. Matthews *v.* Skates, 1 *Fish. Pat. Cas.* 602; Parker *v.* Haworth, 14 *McLean*, 370.

Infringement of a patent can occur only by actually making, using or selling the patented device. Advertising it for sale, though not of itself a violation of an injunction restraining sales, is yet strong evidence of an intent to violate; but to warrant convicting a defendant of selling in contempt of court, a clear case must be made out. Allis *v.* Stowell, 19 *Pat. Off. Gaz.* 727.

A machine is not infringed if the same result is produced by

the defendant by instrumentalities other than those which were claimed in the patent. Toohey *v.* Harding, 1 *Fed. Rep'r*, 174 ; 4 *Hughes*, 253 ; 5 *Bann. & A. Pat. Cas.* 195 ; Dittmar *v.* Rix, 1 *Fed. Rep'r*, 342 ; 17 *Pat. Off. Gaz.* 973 ; 5 *Bann. & A. Pat. Cas.* 240 ; Hall *v.* Stern, 15 *Fed. Rep'r*, 463 ; 25 *Pat. Off. Gaz.* 206 ; Rich *v.* Lippincott, 2 *Pittsb.* 38.

Use of old devices is not an infringement, although they are equivalents for those in the patent. Dennis *v.* Cross, 6 *Fish. Pat. Cas.* 138 ; 3 *Biss.* 389.

The fact that the infringement is not perfect because the machine is imperfect does not exonerate defendant ; it is still an infringement. Union Paper Box Co. *v.* Binney, 5 *Fish. Pat. Cas.* 106.

If changes of form or arrangement introduce a new principle, power, or mode of operation producing a new kind of result, the patent is not infringed. Many *v.* Sizer, 1 *Fish. Pat. Cas.* 17.

Dividing an invention and making two operations where only one is necessary is an infringement. Baldwin *v.* Bernard, 5 *Fish. Pat. Cas.* 75 ; 9 *Blatchf.* 509 n.; 2 *Pat. Off. Gaz.* 320.

Where a plaintiff claims several distinct and independent improvements in the same machine, and procures a patent for them in the aggregate, he is entitled to recover against any person who shall use any one of the improvements so patented, notwithstanding there has been no violation of the other improvements. Moody *v.* Fiske, 2 *Mas.* 112.

A party may sue for an infringement of any one of the separate and distinct inventions that may be covered by his patent. McComb *v.* Ernest, 1 *Woods*, 195.

If a patent is for two distinct machines conducing to a common end, to use either one is an infringement. Wyeth *v.* Stone, 1 *Story*, 273 ; 4 *L. Rep'r*, 54 ; Emerson *v.* Hogg, 2 *Blatchf.* 1 ; and see affirmance, 6 *How.* 437, 485.

It is no infringement of a patent embracing an old invention, to imitate the old part, so long as there is no interference with the new. Simon *v.* Neumann, 20 *Fed. Rep'r*, 196.

Where the machine described and claimed in complainant's patent, and respondents' machines, each contained four elements operating together to produce the same result, although formal differences existed between certain of the elements of the two, yet, the same not being substantially different in object or operation, it was held that the respondents' machine was an infringement of

complainant's patent. Storrs *v.* Howe, 4 *Cliff.* 388 ; 10 *Pat. Off. Gaz.* 421 ; 2 *Bann. & A. Pat. Cas.* 420.

Where a portion of the structure was useless ; was not sold to be used, and was not used in any infringing structure, the patent is not infringed in making and selling it ; an article is not an infringement, unless it is to be used in the manner pointed out in the patent. Campbell *v.* Kavanaugh, 11 *Fed. Rep'r*, 83 ; 20 *Blatchf.* 250.

Where a patentee claims three distinct improvements in the same patent, he must show himself entitled to each, to sustain an action for an infringement. Heinrich *v.* Luther, 6 *McLean*, 345.

If a machine in its mechanical operation and effect is the same as the patentee's, a difference in cost, adjustability or other peculiarity in construction, will not prevent its being an infringement. Foss *v.* Hubert, 2 *Fish. Pat. Cas.* 31 ; 1 *Biss.* 21.

If the result is the same in kind it is not necessary that it be the same in degree. Whipple *v.* Middlesex Co., 4 *Fish. Pat. Cas.* 41.

A substitute for the original invention, or an old instrument used to accomplish a new result, is no infringement, unless the defendant uses substantially the same instrument in substantially the same manner as that set forth in the patent. Johnson *v.* Root, 1 *Fish. Pat. Cas.* 351.

A patent depending on a novel use of water is infringed by a similar use of water in less quantity. Roberts *v.* Roter, 5 *Fish. Pat. Cas.* 529.

Two patents may both be valid where the second is an improvement on the first ; and, if the second includes the first, neither of the two owners can lawfully use the invention of the other without such other's consent. Star Salt Castor Co. *v.* Crossman, 4 *Cliff.* 508 ; 3 *Bann. & A. Pat. Cas.* 281.

The use of all the elements of a patented improvement, with an addition which does not take the place of the device patented, is as much an infringement as the use without such addition. Roemer *v.* Simon, 28 *Pat. Off. Gaz.* 194. And see Williams *v.* B. & O. R. R. Co., 16 *Pat. Off. Gaz.* 906 ; 17 *Blatchf.* 21 ; 4 *Bann. & A. Pat. Cas.* 441.

Embodying a patentee's invention in defendant's machinery, however it may be combined with other machinery, is an appropriation, the same as if it were used alone and separate from those connections. Sickels *v.* Borden, 3 *Blatchf.* 535 ; Pitts *v.* Wemple, 6 *McLean*, 558 ; Foster *v.* Moore, 1 *Curt.* 279 ; Johnson *v.* Root, 1

Fish. Pat. Cas. 351 ; Mallory *v.* White, 4 *Fish.* 628 ; 8 *Blatchf.* 552 ; Hoffheins *v.* Brandt, 3 *Fish. Pat. Cas.* 218 ; Waterbury Brass Co. *v.* N. Y. Brass Co., 3 *Fish. Pat. Cas.* 43 ; Flint *v.* Roberts, 4 *Bann. & A. Pat. Cas.* 165.

The general principle is that, where the claim of a patent is limited to a particular product when produced in a particular way, there is no infringement unless the article described is produced, by employment of substantially the same means to accomplish the result. This principle was applied, in a case of a new article of manufacture in the form of a cast copper tube or cylinder free from blow-holes and other similar defects. Adams *v.* Bridgewater Iron Co., 26 *Fed. Repr.* 324 ; 34 *Pat. Off. Gaz.* 1045.

Where a modification displaces and supersedes the patented invention it is not an infringement. Whipple *v.* Middlesex Co., 4 *Fish. Pat. Cas.* 41.

Unless the same result is produced by the same means, there is no infringement of the invention ; hence in an action for infringement on letters patent for a lock, where the defendant does not use the same combination, and employs no device as an equivalent and substitute for the omitted element, he will not be liable as an infringer. Yale Lock Manuf. Co. *v.* Sargent, 117 *U. S.* 373.

An improvement on a patent may infringe the original patent. Tate *v.* Thomas, 27 *Fed. Rep'r*, 306.

Where a patentable improvement on a device contains all the essentials of the original patent, it infringes. Hoff *v.* Iron-Clad Manuf. Co., 27 *Fed. Rep'r*, 307.

Results the same in kind, though not the same in degree, constitute an infringement. May *v.* County of Fond du Lac, 27 *Fed. Rep'r*, 691.

Embodiments of the new idea and similarity of mechanical construction are what constitutes infringement. May *v.* County of Fond du Lac, 27 *Fed. Rep'r*, 691.

Where a party avails himself of the invention of another without such variation as constitutes a discovery, there is an infringement. May *v.* County of Fond du Lac, 27 *Fed. Rep'r*, 691.

168. *Motive.*

To constitute an infringement for which an action will lie, the making of a machine must be with intent to infringe the patent

right, and deprive the owner of the lawful rewards of his discovery. Sawin *v.* Guild, 1 *Gall.* 485.

The question of infringement is one irrespective of motive. The defendant may have infringed without intending, or even knowing it; but he is no less the infringer. Parker *v.* Hulme, 1 *Fish. Pat. Cas.* 44; 7 *West. L. J.* 417.

The making of a patented machine, fit for use, and with a design to use it for profit, in violation of the patent right, is an infringement. Whittemore *v.* Cutter, 1 *Gall.* 429; 1 *Robb.* 28; Bloomer *v.* Gilpin, 4 *Fish. Pat. Cas.* 50.

The making of a patented machine merely for philosophic experiments, or for the purpose of ascertaining the sufficiency of the machine to produce its described effects, is not an infringement of the right. Whittemore *v.* Cutter, 1 *Gall.* 429; Poppenhusen *v.* Falke, 2 *Fish. Pat. Cas.* 181; 5 *Blatchf.* 493.

Whoever erects or uses a patented machine does it at his peril. He takes upon himself all the chances of the patent being originally valid; or being afterward made so by a surrender and the grant of a new one, which may cure all defects. Ames *v.* Howard, 1 *Sumn.* 482. And see Evans *v.* Weiss, 2 *Wash.* 342; 3 *Am. L. J.* 180; McClurg *v.* Kingsland, 1 *How.* 202; 17 *Pet.* 228; Stimpson *v.* Westchester R. R. Co, 4 *How.* 380; Simpson *v.* Mad River R. R. Co., 6 *McLean*, 603.

The keeper of a hotel who uses a patented hotel register without right, is liable as an infringer, and not the less so because he did not intend to violate the rights of the patentee, and desisted when notified. Hawes *v.* Washburne, 5 *Pat. Off. Gaz.* 491.

One selling a machine to be used for the purpose of infringing a patented combination is liable as an infringer himself. Holly *v.* Vergennes Machine Co., 4 *Fed. Rep'r*, 74; 18 *Blatchf.* 327; 18 *Pat. Off. Gaz.* 1177.

169. *Identity of Devices.*

To constitute identity of invention, and therefore infringement, not only must the result obtained be the same, but in case of a combination of known elements, the elements combined must be the same, and combined in the same way, so that each element shall perform the same function; provided, however, that the differences alleged are not merely colorable, according to the rule forbidding

the use of known equivalents. Electric R. Signal Co. *v.* Hall R Signal Co., 114 *U. S.* 87.

If two machines, having the same mode of operation, do the same work in substantially the same way and accomplish substantially the same result, they are the same, though differing in form, shape, or name. Union Sugar Refinery *v.* Mathiesen, 3 *Cliff.* 639; 2 *Fish. Pat. Cas.* 600. S. P., Alden *v.* Dewey, 1 *Story*, 336; 3 *L. Rep'r*, 383; Dixon *v.* Moyer, 4 *Wash.* 68; Rich *v.* Lippincott, 1 *Fish.* 31; 2 *Fish. Pat. Cas.* 1; Spring *v.* Domestic Sewing Machine Co., 9 *Fed. Rep'r*, 505; 21 *Pat. Off. Gaz.* 633.

Where the end to be accomplished by two devices is the same, and the substantial means to accomplish the end are the same, the two devices are identical, though one may accomplish the end more effectually than the other. Imlay *v.* Norwich & Worcester R. R. Co., 4 *Blatchf.* 227; 1 *Fish. Pat. Cas.* 340.

If there is infringement, a person of competent skill will be able to make a machine like defendants from the description given in plaintiff's patent. Schneider *v.* Lovell, 22 *Pat. Off. Gaz.* 499; 10 *Fed. Rep'r*, 666; Many *v.* Sizer, 1 *Fish. Pat. Cas.* 17.

If mechanical differences exist, but the two products and the general mode of construction are the same, as would appear by a comparison of the two manufactures, the court will hold that infringement is proved. This doctrine applied in a suit for infringement of patent for improvement in billiard tables. Collender *v.* Came, 4 *Cliff.* 393; 10 *Pat. Off. Gaz.* 467; 2 *Bann. & A. Pat. Cas.* 412.

Where, in mechanics, one device does a particular thing, or accomplishes a particular result, every other known device which skilled workmen know will do the same thing or produce the same result is a known mechanical substitute (Carter *v.* Baker, 1 *Sawyer*, 512; 4 *Fish. Pat. Cas.* 404); *e. g.*, a handle used in place of a lever to produce the same result. Brown *v.* Guild, 23 *Wall.* 181. See also Cahoon *v.* Ring, 1 *Fish. Pat. Cas.* 397; 1 *Cliff.* 592; Smith *v.* Downing, 1 *Fish. Pat. Cas.* 64; Johnson *v.* Root, 1 *Fish. Pat. Cas.* 351; Burden *v.* Corning, 2 *Fish. Pat. Cas.* 477. Mechanical equivalents are not those merely which produce the same result. Smith *v.* Marshall, 10 *Pat. Off. Gaz.* 375; 2 *Bann. & Ard.* 371.

A person, to invoke the doctrine of equivalents, must be the first inventor of the principle and not only of the machine which carries it out. Singer *v.* Walmsley, 1 *Fish. Pat. Cas.* 558. As to the term equivalents in chemicals, see Tyler *v.* Boston, 7 *Wall.* 327. Known

equivalents to ingredients in a composition are covered by a patent for such composition. Matthews *v.* Skates, 1 *Fish. Pat. Cas.* 602; Woodward *v.* Morrison, 5 *Fish. Pat. Cas.* 357; 1 *Holmes*, 124; 2 *Pat. Off. Gaz.* 120.

It is an infringement of a patented machine to make and use a machine which operates, or may operate if the owner is disposed to use it so, in the manner pointed out by the patent. Holbrook *v.* Small, 10 *Pat. Off. Gaz.* 508.

Where a device effects the same results in substantially the same way, it is an infringement on plaintiff's patent, although it presents great simplicity and cheapness as compared to complainant's patent. Eyory *v.* Burt, 15 *Fed. Rep'r*, 112; 23 *Pat. Off. Gaz.* 312. That it was not known at the date of plaintiff's invention, is immaterial. Potter *v.* Stewart, 18 *Blatchf.* 561; 19 *Pat. Off. Gaz.* 997; 7 *Fed. Rep'r*, 215.

Where a greater number of persons have to be employed in the operation of a machine formerly in use than in a patented machine, this tends to prove that the machines are not alike. Coupe *v.* Weatherhead, 16 *Fed. Rep'r*, 673; 23 *Pat. Off. Gaz.* 1927.

It is not necessary, to continue an infringement, that the whole invention be taken. Fetter *v.* Newhall, 17 *Fed. Rep'r*, 841; 25 *Pat. Off. Gaz.* 502; 16 *Rep'r*, 360; 21 *Blatchf.* 415.

Where a patented machine is capable of performing several functions, as Blanchard's machine for turning irregular forms, and a person constructs a machine to perform but one of such functions, as the turning of wagon spokes, it is an infringement. Blanchard *v.* Beers, 2 *Blatchf.* 411.

In order to constitute an infringement, it is not necessary that the arrangement and combination of the party charged with the infringement should be the same to the eye as the patented invention. If they embody the ideas of the patentee, and the machinery of the defendant operates by such adoption and appropriation, then, though the arrangement may be apparently different, in reality and in judgment of law an infringement exists. Smith *v.* Higgins, 1 *Fish. Pat. Cas.* 537.

Where the defendant in an action for infringement uses substantially the same devices as plaintiff, and produces the same result and certain other results differing from those produced by plaintiff, it will still be considered that the patent of plaintiff has been infringed and that defendant appropriates the invention of

complainant. New York Rubber Co. *v.* Chaskel, 9 *Pat Off. Gaz.* 923.

The true test of identity between two designs is their sameness of effect upon the eye of an ordinary observer, bringing to the examination of the designs that degree of observation which men of ordinary intelligence give. In what cases the court may make the comparison. Jennings *v.* Kibbe, 10 *Fed. Rep'r*, 669 ; 20 *Blatchf.* 353 ; 22 *Pat. Off. Gaz.* 331.

To constitute an infringement there must be similarity of design, and substantial identity of purpose and result. Where similarity of design exists and a similar result is attained, in substantially the same way, by the use of a device which, although intended to operate in a different way, did not so operate, such use will nevertheless be an infringement. Henderson *v.* Co-operative Stove Co., 2 *Bann. & A. Pat. Cas.* 604.

It must always be very much a matter of judgment to the eye, in the examination of two machines, and in observing their modo of operation, whether the one, in the whole, or in any of its parts, is a mere colorable or formal alteration of the other. If a patentee has invented a combination of two or more old things, so as to produce a new and useful result, he has a right to treat as infringers all who have used his invention, in order to accomplish something more or better, when, without the aid of such invention, it could not be effected. Sayles *v.* Chicago & North-western R. R. Co., 4 *Fish. Pat. Cas.* 584; but see reversal, 97 *U. S.* 554.

A patent cannot be defeated by dividing a patented device into two parts, which, when combined, produce the same result in substantially the same way. Strobridge *v.* Lindsay, 6 *Fed. Rep'r*, 510 ; 19 *Pat. Off. Gaz.* 1285 ; 11 *Rep'r*, 734.

A patent for the application of heat to a particular purpose is infringed by the use of the same process for the same purpose, and with the same result, although a higher degree of heat is used. Cary *v.* Wolff, 24 *Fed. Rep'r*, 139 ; 32 *Pat. Off. Gaz.* 257 ; Cary *v.* Lovell Manuf. Co., 24 *Fed. Rep'r*, 141 ; 32 *Pat. Off. Gaz.* 1009 ; Cary *v.* Domestic Spring Bed Co., 34 *Pat. Off. Gaz.* 1158.

A patent for a fabric is infringed by the use, without license, of the fabric, although less is used than the patentee uses in the manufacture of similar articles. Celluloid Manuf. Co. *v.* Chrolithion Collar, &c. Co., 23 *Fed. Rep'r*, 397 ; 31 *Pat. Off. Gaz.* 519. Adhered to on rehearing, 25 *Id.* 482.

Where contrivances or devices are substantially identical, there

is an infringement Yale Lock Manuf. Co. *v.* Sargent, 117 *U. S.* 536.

170. *Identity in Principle, sufficient.*

A difference in mechanism, such that the same result is produced in a different way, is a difference in principle. Silsby *v.* Foote, 14 *How.* 218; 1 *Blatchf.* 445.

To constitute an infringement, the thing used by the defendant must be such as substantially to embody the patentee's mode of operation, and thereby attain the same kind of result as was reached by his invention. It is not necessary that the defendant should employ the plaintiff's invention to as good advantage as he employed it, or that the result should be precisely the same in degree; but it must be the same in kind. But, generally, where a patentee describes a machine, and then claims it as described, to copy the principle, or mode of operation described, is an infringement, however unlike the original the copy may be. Winans *v.* Denmead, 15 *How.* 330.

That is a substantial identity which comprehends the application of the principle of the invention. If a defendant's device merely adopts a different mode of carrying the same principle into effect, and the principle admits a variety of forms, there is an identity of principle, although not an identity of mode. Page *v.* Ferry, 1 *Fish. Pat. Cas.* 298.

An improvement in the principle of a machine is no invasion of the rights of the inventor and patentee of such machine. The rule is otherwise when it is only an improvement in the form. Reutgen *v.* Kanowrs, 1 *Wash.* 168; Park *v.* Little, 3 *Wash.* 196; Smith *v.* Pearce, 2 *McLean*, 176.

It is generally true that when a patentee describes a machine, and then claims it as described, he covers not only the precise forms he has described, but all other forms which embody his invention; and to copy a principle or mode of operation described, is an infringement, although such copy is totally unlike the original in form or proportions. Grier *v.* Castle, 17 *Fed. Rep'r*, 523; 24 *Pat. Off. Gaz.* 1176.

It is no defense to an infringement that the machine or product is not as good as the patentee's, if it operates or is produced in substantially the same way (Roberts *v.* Harnden, 2 *Cliff.* 500); nor that defendant's machine is superior to the patentee's, unless it is

shown that there is a substantial difference. Alden *v.* Dewey, 1 *Story*, 336; 3 *L. Rep'r*, 383.

If the principle on which the machinery works is the same, and the effect is similar in both, the machines are identical in law. Brooks *v.* Bicknell, 3 *McLean*, 250; 1 *West. L. J.* 150.

To establish an infringement, it is not necessary that the structure or machine used by the defendant should be the same in appearance, form or proportions, as that invented and patented by the plaintiff. If the operative principles of the two machines be the same, the substantial identity contemplated by the patent law is established. Parker *v.* Stiles, 5 *McLean*, 44; 7 *West. L. J.* 168.

A well known principle or truth of natural science, as well as a newly discovered one, is patentable to the first applicant of it in the useful arts; but having once been made known and applied, any subsequent application must, to insure a patent, rest upon new machinery or combination of machinery, and not upon the principle the novelty of which has been exhausted. Even though the application of the principle, in prior patents, was not so perfectly made as it might have been or as it would be made by using the forms of machinery suggested in the specifications of an applicant for a new patent, this does not entitle the latter to a patent for the principle. *Re* Henry, 1 *MacArthur Pat. Cas.* 467.

Patent issued to Nobel, in 1865, relating to use of nitro-glycerine as a substitute for gunpowder, was *held* not to cover the use of a capsule or percussion cap, operating by its detonation, as a means of exploding nitro-glycerine; the principle of the patent being explosion effected by heat and pressure. Atlantic Giant Powder Co. *v.* Hulings, 21 *Fed. Rep'r*, 519.

Two devices or inventions infringe if they are substantially alike. In determining the question of infringement, the court or jury are not to judge about similarities or differences by the names of things, but are to look at the machines or their several devices or elements in the light of what they do or what office or function they perform, and to find that one thing is substantially the same as the other, if it performs substantially the same function in substantially the same way, to obtain the same result; and should always bear in mind that devices in a patented machine are "different" in the sense of the patent law when they perform different functions, or in a different way, or produce a substantially different result. Cantrell *v.* Wallick, 117 *U. S.* 689.

171. *What is the "Principle" of a Machine.*

In an action for an infringement, the first question for consideration is whether the machine used by the defendant is substantially, in its principles and mode of operation, like the plaintiff's. If so, it is an infringement to use it. Odiorne *v.* Winkley, 2 *Gall.* 51; Howe *v.* Abbott, 2 *Story*, 190; Grant *v.* Mason, 1 *L. Int. & Rev.* 22; Parker *v.* Haworth, 4 *McLean*, 370.

What constitutes form, and what principle, is often a nice question to decide. The safest guide to accuracy in making the distinction is to ascertain what is the result to be obtained by the discovery; and whatever is essential to that object, independent of the mere form and proportions of the thing used for the purpose, may generally, if not universally, be considered as the principle of the invention. Treadwell *v.* Bladen, 4 *Wash.* 703, 706; Gray *v.* James, *Pet. C. Ct.* 394; Olcott *v.* Hawkins, 2 *Am. L. J. N. S.* 319; Imlay *v.* Railroad Co., 1 *Fish. Pat. Cas.* 340; 4 *Blatchf.* 227.

Principle, in machines, is not a new mechanical power—none such have been discovered for centuries. That is a principle which applies, modifies or combines mechanical powers to produce a certain result. Smith *v.* Pearce, 2 *McLean*, 176.

Where two machines or things are made to operate substantially in the same way, so as to produce the same result, they are considered the same in principle. Thus, where any of the mechanical powers, the lever, screw, wheel, &c., are used to accomplish certain purposes, the same powers being used, the fact that they are used in a somewhat different form, to do the same thing, will not constitute a difference in principle. Whether the mechanical instruments be larger or smaller, whether their action be horizontal or vertical, the principle is the same. Roberts *v.* Ward, 4 *McLean*, 565.

The principle of a machine is the particular means of producing a given result by a mechanical contrivance (Parker *v.* Stiles, 5 *McLean*, 44, 63; 7 *West. L. J.* 168; Brooks *v.* Jenkins, 3 *McLean*, 432; 2 *West. L. J.* 11), independent of mere form. Olcott *v.* Hawkins, 2 *Am. L. J. N. S.* 317. And see Le Roy *v.* Tatham, 22 *How.* 132; Tatham *v.* LeRoy, 2 *Blatchf.* 474; 7 *West. L. J.* 431.

The machinery or apparatus by which a principle is applied to practical uses is not of the essence of the invention, when a patent

is sought for the process ; and lack of novelty or utility in the mere arrangement of machinery described in the specification is no objection to such an application. *Re* Henry, 1 *MacArthur Pat. Cas* 467.

172. *Formal Changes.*

A change in or variation from the plaintiff's machine, which affects merely its form or proportions, &c., or involves merely the substitution of one mechanical equivalent for another, does not constitute such a change as will relieve the defendant from the charge of infringement. Winans *v.* Denmead, 15 *How.* 330, 342 ; Wyeth *v.* Stone, 1 *Story*, 273 ; 4 *L. Rep'r*, 54 ; Gorham *v.* Mixter, 1 *Am. L. J. N. S.* 543 ; 19 *Hunt Mer. Mag.* 296 ; 5 *West. L. J.* 525 ; Sargent *v.* Larned, 2 *Curt.* 340 ; Miller's Falls Co. *v.* Backus, 17 *Pat. Off. Gaz.* 852 ; 5 *Bann. & A. Pat. Cas.* 53 ; McWilliams Manuf. Co. *v.* Blundell, 11 *Fed. Rep'r*, 419 ; 22 *Pat. Off. Gaz.* 177 ; Blanchard *v.* Beers, 2 *Blatchf.* 411 ; American Pin Co. *v.* Oakville Co., 3 *Blatchf.* 190 ; 3 *Am. L. Reg.* 136 ; Sickels *v.* Borden, 3 *Blatchf.* 535 ; Poppenhusen *v.* Falke, 5 *Wash.* 46 ; Dixon *v.* Moyer, 4 *Wash.* 68.

Where one particular geometrical form alone is capable of embodying the invention, that form must be used, to amount to an infringement. Otherwise, where that form is the best, but other forms may and do embody the invention. Winans *v.* Denmead, 15 *How.* 330.

Form, when of the essence of an invention, is necessarily material ; and, if it be inseparable from the successful operation of the machine, the attainment of the same object by a machine different in form is not an infringement. Werner *v.* King, 96 *U. S.* 219.

Patent issued to Tate, in 1871, for an improvement in quilting machines, was *held* to be infringed by a machine involving a change by which no new result was obtained, although an aggregation of results was accomplished. Tate *v.* Thomas, 22 *Fed. Rep'r*, 660 ; 30 *Pat. Off. Gaz.* 345.

Except where form is of the essence of the invention, it has but little weight in the decision of an issue whether two patents have been issued for the same invention. The correct rule is, that in determining the question of infringement, the court or jury, as the case may be, are not to judge about similarities or differences

by the name of things, but are to look at the machines or their several devices or elements in the light of what they do, or what office or function they perform, and how they perform it, and to find that one thing is substantially the same as another, if it performs substantially the same function in substantially the same way, to obtain the same result; always bearing in mind that devices in a patented machine are "different" in the sense of the patent law when they perform different functions, or in a different way, or produce a substantially different result. Machine Co. *v.* Murphy, 97 *U. S.* 120.

A formal change in an important part of a machine, requiring a modification of other parts to meet the change, is an infringement. Union P. B. M. Co. *v.* P. & U. Co., 15 *Pat. Off. Gaz.* 423; 15 *Blatchf.* 160; 3 *Bann. & A. Pat. Cas.* 403.

Where a patent extends only to the form or parts of the machine as set out, and made of any kind of materials, or saying nothing as to materials, the right would be violated by a machine of like form, as the form would be the only matter patented. But if the patentee chooses to go further, and cover the material of which a part of his machine is made, he entirely endangers his right to prosecute when a different and inferior material is employed, and especially one rejected by himself. Aiken *v.* Bemis, 3 *Woodb. & M.* 348.

Though, as a general rule, a patent only covers the improvement precisely described, and is not violated unless the defendant make use of the precise thing described in the patent, yet if the imitation be so nearly exact as to satisfy the jury that the imitator attempted to copy the model, and to make some almost imperceptible variation for the purpose of evading the right of the patentee, this will be considered a fraud upon the law, and such slight variation will be disregarded. Davis *v.* Palmer, 2 *Brock. Marsh.* 298.

Where the differences are merely in the form and not in the substance, and defendant's machine really shows the various parts described in the complainant's patent; or where the various parts of defendant's machine exhibit mechanical parts equivalent to those in complainant's machine, and producing the same result, an infringement is established. Graham *v.* Geneva Lake Crawford Manuf. Co., 11 *Fed. Rep'r*, 138; 21 *Pat. Off. Gaz.* 1536.

The use of a patented device, with all its beneficial results, is an infringement of the patent, notwithstanding a mechanical change in the form and arrangement of the parts, by which an effect addi-

tional to the one previously produced is obtained. Hartford Woven Wire-Mattress Co. *v.* Peerless Wire-Mattress Co., 23 *Fed. Rep'r*, 587.

A patent for a machine is infringed by another machine which does the same work, in the same manner, and by the same means, although there are structural differences in parts of the infringing machine, and the manner of using it is different. Sewing Machine Co. *v.* Frame, 24 *Fed. Rep'r*, 596; 28 *Pat. Off. Gaz.* 96.

A patent for a new manufacture was *held* to be infringed by manufacturing a similar article with a change in the method employed, which, while it might be an improvement upon the patent or upon the specific arrangements therein detailed, was merely a change in construction. Reed *v.* Street, 34 *Pat. Off. Gaz.* 339.

A patent for an improvement in apple-paring machines consisted in so attaching the knife-block to the rod which moved it as to allow the knife-block to rotate round the rod at right angles, to accommodate itself to any irregularities in the surface of the fruit. The defendants, instead of making the knife movable in the rod, made the rod movable in its socket, but the knife-block had the same motion. This was *held* only a change of form, and therefore an infringement. Sargent *v.* Larned, 2 *Curt.* 340.

A change in the size of a machine, making it larger or smaller, while its mode of operation is not improved or affected, is not a patentable change; and when there is nothing in the patent as to the size of the machines to be made under it, the patentee has a right to make a machine just as large or just as small as he chooses under the specification of his patent. Montross *v.* Bullard, 27 *Fed. Rep'r*, 64.

Simple difference in size, form and degree does not escape the charge of infringement. Armus *v.* Alden, 27 *Fed. Rep'r*, 684.

Where two devices are essentially similar in construction of a particular element thereof, with a slight and immaterial variation in the method of attachment, but perform the same functions in each, there is an infringement. Thayer *v.* Spaulding, 27 *Fed. Rep'r*, 66.

173. *Nature and Measure of the Protection accorded to patented Process or Product.*

A person who, after a patent issued for a process, discovers a new mode of carrying out the process, and obtains letters patent

therefor, is not entitled to use the process without the consent of the prior patentee. Tilghman *v.* Proctor, 102 *U. S.* 707.

Unauthorized making an article according to a patented process, or selling it, is an infringement. Bridgeport Wood Finishing Co. *v.* Hooper, 5 *Fed. Rep'r*, 63 ; 18 *Blatchf.* 459 ; 20 *Pat. Off. Gaz.* 156.

A patent for a new manufacture is infringed by the manufacture of the new product by any process whatever. Badische Anilin, &c. Fabrik *v.* Hamilton Manuf. Co., 13 *Pat. Off. Gaz.* 273 ; 3 *Bann. & A. Pat. Cas.* 235.

A patent for "ornamenting bracelets and other articles of jewelry" was *held* to be infringed by using the process on buttons. Royce *v.* Fifield, 18 *Fed. Rep'r*, 262.

A patent containing two claims,—one for a certain process set forth and the other for the compound made by the process,—is not infringed by the manufacture of a similar compound not made by the patented process. Dittmar *v.* Rix, 1 *Fed. Rep'r*, 342 ; 17 *Pat. Off. Gaz.* 973 ; 5 *Bann. & A. Pat. Cas.* 240.

In a patent for a process, every successive step enumerated in the claim must be regarded as an essential part, and must be employed by defendants in order to render them liable to the charge of infringement. Hammerschlag *v.* Garrett, 10 *Fed Rep'r*, 479 ; 28 *Int. Rev. Rec.* 40.

Where a patent process consists of a number of steps, all well known except the first and last, the use of all except the first and last steps will not infringe the patent. Heller *v.* Bauer, 19 *Fed. Rep'r*, 96.

To constitute an infringement of a patented process, the process must be substantially followed. Royer *v.* Chicago Manuf. Co., 20 *Fed. Rep'r*, 853.

If the patent does not fully describe everything essential to the making of the thing patented, there will be no infringement by the invention of processes which the patentee has withheld from the public. An infringement will not take place unless the invention can be practiced completely by following the specifications. Page *v.* Ferry, 1 *Fish. Pat. Cas.* 298.

Difference in degree of the process by which an end or result is attained is not a new or different process. Commercial Manuf. Co. Fairbank Canning Co., 27 *Fed. Rep'r*, 78.

It being known to an art that a certain process will accomplish a certain result, the discovery that a better result may be obtained

by pursuing the process further is not a patentable discovery. Smith *v.* Murray, 27 *Fed. Rep'r*, 69.

A process the exact equivalent of an earlier patented process is an infringement. Hobbie *v.* Smith, 27 *Fed. Rep'r*, 656.

174. *Protection accorded to an Improvement of a Device already patented.*

If improvements be made upon an invention which has been patented, by any person other than the inventor or patentee, the inventor of the original thing and those claiming under him have no right to use the improvements without a license from the inventor thereof; nor can the inventor of such improvements or any other person lawfully use the principal machine without the license of the inventor thereof. Gray *v.* James, *Pet. C. Ct.* 394; Washburn *v.* Gould, 3 *Story*, 122; 1 *West. L. J.* 465; 7 *L. Rep'r*, 276. S. P., Goodyear *v.* Railroad, 2 *Wall. Jr.* 356; 1 *Fish. Pat. Cas.* 626; Filley *v.* Littlefield, 25 *Fed. Rep'r*, 282; Pitts *v.* Wemple, 6 *McLean*, 558; Whipple *v.* Baldwin Manuf. Co., 4 *Fish. Pat. Cas.* 29.

The fact that defendant has made improvements upon, or additions to, the invention patented by plaintiff, gives him no right to use the plaintiff's invention. Alden *v.* Dewey, 1 *Story*, 336; 3 *L. Rep'r*, 383; Woodworth *v.* Rogers, 3 *Woodb. & M.* 135; Gorham *v.* Mixter, 1 *Am. L. J. N. S.* 543; 19 *Hunt Mer. Mag.* 296; 5 *West. L. J.* 525; Foster *v.* Moore, 1 *Curt.* 279; Howe *v.* Morton, 13 *L. Rep'r, N. S.* 70; Howes *v.* Nute, 4 *Cliff.* 173; White *v.* Heath, 10 *Fed. Rep'r*, 291; 22 *Pat. Off. Gaz.* 500; Parkhurst *v.* Kinsman, 1 *Blatchf.* 488; 8 *N. Y. Leg. Obs.* 146; Howes *v.* McNeal, 15 *Pat. Off. Gaz.* 608; 15 *Blatchf.* 103; 3 *Bann. & A. Pat. Cas.* 376; La Baw *v.* Hawkins, 6 *Pat. Off. Gaz.* 724; 1 *Bann. & A. Pat. Cas.* 428; Union Stone Co. *v.* Allen, 14 *Fed. Rep'r*, 353: Westinghouse *v.* Gardner, &c. Air Brake Co., 9 *Pat. Off. Gaz.* 538; 2 *Bann. & A. Pat. Cas.* 55; Foye *v.* Nichols, 13 *Fed. Rep'r*, 125; 8 *Sawyer*, 201; 22 *Pat. Off. Gaz.* 2243; 13 *Fed. Rep'r*, 125.

Any person may improve a patented invention, but all that he can patent is his improvement. Colt *v.* Mass. Arms Co., 1 *Fish. Pat. Cas.* 108.

A mere change of form in arrangement of parts does not enable

him who has devised it to treat as an infringer one who improves the form or combination. Otherwise, when something elementary is newly discovered which fairly constitutes a part of the invention. Taylor *v.* Garretson, 5 *Fish. Pat. Cas.* 116; 9 *Blatchf.* 156; Merriam *v.* Van Nest, 13 *Pat. Off. Gaz.* 597; Cornell *v.* D. & B. Brewing Co., 11 *Pat. Off. Gaz.* 331; 7 *Biss.* 346; 2 *Bann. & A. Pat. Cas.* 514.

A patent for an improvement embraces nothing more than the improvement described and claimed as new; any one who afterward discovers a method of accomplishing the same object, substantially and essentially differing from the one described, has a right to use it. O'Reilly *v.* Morse, 15 *How.* 62, 119.

If an invention is only an improvement on a known machine, the patentee cannot treat another as an infringer who has improved the original machine by using a different form or combination performing the same functions. McCormick *v.* Talcott, 20 *How.* 403.

Where a party having made application for a patent for certain improvements, afterward, with his claim still on file, makes application for another but distinct improvement, but does not in such second application claim it as original, the description in such second application, and non-claim of it there, is not a dedication of the first invention to the public. Suffolk County *v.* Hayden, 3 *Wall.* 315.

When several patents are issued for improvements upon the same general structure, each patentee is liable to all prior patentees to the extent to which he adopts their improvements. Warth *v.* Browning, 17 *Pat. Off. Gaz.* 624; 5 *Bann. & A. Pat. Cas.* 341.

Although improvements may be made in the separate devices constituting a combination, which improvements may be the proper subject of a patent, yet if the combination made by the defendant embraces and shows the elements of the plaintiff's invention, operating substantially in the same manner to produce the same results, it must be treated as an infringement. Hartshorn *v.* Shorey, 9 *Pat. Off. Gaz.* 595.

An improvement in the construction of a portion of a patented mechanism, by which it performs an additional function to that in the original invention, does not justify the use of the original invention. Nor does the fact that some of the devices of the combination are old defeat the validity of the patent. Strobridge *v.* Lindsay, 2 *Fed. Rep'r*, 692; 18 *Pat Off. Gaz* 62; *Bann. & A. Pat. Cas.* 411.

A patent for a mere improvement if limited in its scope to the method of arrangement of devices described and claimed in it as new, is not infringed by the use of substituted devices, different in character and dissimilar in form, although they may perform some of the functions of the patented devices, or may effect the same general result. Dyer *v.* National Hod Elevating Co., 24 *Fed. Rep'r.* 182.

Letters patent for an improvement on a patented invention cannot be declared void because they include such patented invention. And a party who is infringing both the improvement and the original invention cannot set up the existence of the first patent as an excuse for infringing the improvement. Cantrell *v.* Wallick, 117 *U. S.* 689.

A patent for an improvement can not be so extended as to include the older process of the art of the process or science. Globe Nail Co. *v.* Superior Nail Co., 27 *Fed. Rep'r*, 450.

Where there are a number of devices, all acting substantially upon the same principle, and a patent is granted for a device which has, in addition to the elements common to all, a special feature possessed by it alone, the patent can be upheld so as to protect such special feature ; but it cannot be so construed as to include other machines which are mere adaptations or simplifications of other older devices. Montross *v.* Bullard, 27 *Fed. Rep'r*, 64.

175. *To a Combination.*

To constitute an infringement of a patent for a combination of several elements, the defendant must have used all the elements of the combination. If he has used some of them only, omitting one or more, without substituting any equivalent therefor, there is no infringement. Prouty *v.* Ruggles, 16 *Pet.* 336 ; aff'g 1 *Story*, 568 ; Stimpson *v.* Baltimore & Susquehanna R. R. Co., 10 *How.* 329 ; Brooks *v.* Fiske, 15 *How.* 210 ; McCormick *v.* Talcott, 20 *How.* 402 ; Eames *v.* Godfrey, 1 *Wall.* 78 ; Barrett *v.* Hall, 1 *Mas.* 447 ; Moody *v.* Fiske, 2 *Mas.* 112 ; Howe *v.* Abbott, 2 *Story*, 190 ; Aiken *v.* Bemis, 3 *Woodb. & M.* 348 ; Gorham *v.* Mixter, 1 *Am. L. J. N. S.* 543 ; 19 *Hunt Mer. Mag.* 296 ; 5 *West. L. J.* 525 ; Evans *v.* Eaton, *Pet. C. Ct.* 322 ; Gray *v.* James, *Id.* 394 ; Brooks *v.* Bicknell, 4 *McLean*, 70 ; 3 *West. L. J.* 109 ; Root *v.* Ball 4 *McLean*, 177 ; Parker *v.* Haworth, *Id.* 370 ; McCormick

v. Manny, 6 *McLean*, 539 ; 4 *Am. L. Reg.* 277; Pitts *v.* Wemple, 6 *McLean*, 558 ; Fay *v.* Allen, 24 *Fed. Rep'r*, 804 ; 32 *Pat. Off. Gaz.* 1355 ; adhered to on rehearing, 25 *Pat. Off. Gaz.* 201. And see Foster *v.* Moore, 1 *Curt.* 279 ; Sands *v.* Wardell, 3 *Cliff.* 277 ; Storrs *v.* Howe, 4 *Cliff.* 388 ; 10 *Pat. Off. Gaz.* 421; 2 *Bann. & A. Pat. Cas.* 421 ; Sanford *v.* Merrimac Hat Co., 10 *Pat. Off. Gaz.* 466; Gould *v.* Spicers, 20 *Fed. Rep'r*, 317 ; Matteson *v.* Caine, 17 *Fed. Rep'r*, 525 ; Huggins *v.* Hubby, 3 *West. L. Month.* 347; Howe *v.* Neemes, 18 *Fed. Rep'r*, 40 ; Saladee *v.* Racine Wagon, &c. Co., 20 *Fed. Rep'r*, 686 ; 27 *Pat. Off. Gaz.* 1133 ; Hovey *v.* Henry, 3 *West. L. J.* 153 ; Westlake *v.* Carter, 4 *Pat. Off. Gaz.* 636 ; 6 *Fish. Pat. Cas.* 519.

Where, in an action for an infringement of a patent for an invention, which, as claimed in the patent, consists of several elements in combination, the defendant shows that in his article one of the elements claimed by the plaintiff is not used, the plaintiff will not be allowed to avoid that defense by setting up that such element is immaterial. Vance *v.* Campbell, 1 *Black*, 427 ; rev'g 1 *Fish. Pat. Cas.* 483.

Where a patent is made up of several constituent steps of which the patentee is not the inventor, he has no claim to the constituents singly ; his patent only secures him their use when arranged in the process. Mowry *v.* Whitney, 14 *Wall.* 620.

If the subsequent combination is new, or if the ingredient substituted for the one withdrawn is a newly discovered one, or even an old one performing some new function, and was not known at the date of the patent as a proper substitute for the ingredient withdrawn, there is no infringement; for a new combination, or a newly discovered ingredient substituted for the one omitted, or even an old one performing a new function not known at the date of the patent as a proper substitute for the one withdrawn, is not an equivalent for the ingredient omitted, within the meaning of the patent law. Fuller *v.* Seutzer, 94 *U. S.* 299 ; 1 *Bann. & A. Pat. Cas.* 520 ; Seymour *v.* Osborne, 11 *Wall.* 516.

Where the thing patented is an entirety, consisting of a separate device, or of a single combination of old elements incapable of division or separate use, a defense on the ground of want of novelty cannot be established by proving that a part of the entire invention is found in one prior patent, printed publication or machine, and another part in another, and so on indefinitely, and from the whole or any given number allowing the court to determine the issue of

novelty adversely to the complainant. Common justice forbids such a defense, as it would work a virtual repeal of so much of the patent act as gives to inventors the right to a patent consisting of old elements, where the combination itself is new and produces a new and useful result. New elements in such a patent are not required, and if such a defense were allowed, not one patent of the kind in a thousand of modern date could be held valid. Nor is such a defense consistent with the regulations enacted by Congress in respect to the procedure in litigations in respect to patent rights. Parks *v.* Booth, 102 *U. S.* 96; aff'g 1 *Ilippin*, 281; 1 *Bann. & A. Pat. Cas.* 225.

A patent for a combination is not infringed by using one part of it combined with other devices substantially different from those described in the patent, in form or mode of arrangement and combination with the other parts. McMurray *v.* Mallory, 111 *U. S.* 97.

A patent for a combination is not infringed by a use of one element in the combination unless it be used in connection with mechanical equivalents known when the patent was granted, substituted for the omitted element. Rowell *v.* Lindsay, 113 *U. S.* 97; Voss *v.* Fisher, *Id.* 213. S. P., Schillenger *v.* Cranford, 2 *Cent. Rep'r*, 680.

A subordinate device is not an "element," within the rule which requires the use of all the elements of a combination to constitute an infringement. Smith *v.* Fay, 6 *Fish. Pat. Cas.* 446.

If a substance was not known as a substitute for a certain element in a combination, at the time of the invention of the combination, the use of it in lieu of that element is not an infringement. Colgate *v.* Law Tel. Co., 5 *Bann. & A. Pat. Cas.* 437.

If the patentee names a specific material for one element of his combination, using another material for that element is not an infringement. Harris *v.* Allen, 15 *Fed. Rep'r*, 106.

The improvement of one element of a combination does not give the right to use or appropriate the original combination. Stainthorp *v.* Humiston, 4 *Fish.* 107; Converse *v.* Cannon, 2 *Woods*, 7; 9 *Pat. Off. Gaz.* 105.

If the defendant has merely substituted an equivalent for one of the elements of the patented combination, he infringes it, although his combination includes other functions and produces other effects not attainable by the patented combination. Sarven *v.* Hall, 5 *Fish* 415; 9 *Blatchf.* 524; 1 *Pat. Off. Gaz.* 437; Whee-

ler *v.* Clipper Co., 6 *Fish.* 1; 10 *Blatchf.* 181; 2 *Pat. Off. Gaz.* 442.

If the defendant has a patent for a combination which contains as one of its elements the principle embodied in the complainant's patent, it is an infringement. Cleveland *v.* Towle, 3 *Fish. Pat. Cas.* 525.

A combination is patentable only when the several elements of which it is composed produce by their joint action a new and useful result, or an old result in a cheaper or otherwise more advantageous way. Stephenson *v.* Brooklyn Cross-Town Railroad Company, 114 *U. S.* 149; 5 *Sup. Ct. Rep'r*, 781.

Where a defendant, in constructing his machine, omits entirely one of the ingredients of the plaintiff's combination, without substituting another, he does not infringe; nor does he infringe in case he substitutes another in place of the one omitted, which performs a different function, or which is new, or which, though old, was not known, at the date of the plaintiff's invention, as a proper substitute for the omitted ingredient. Gould *v.* Rees, 15 *Wall.* 187.

Inasmuch as a combination of old elements is only an improvement upon what was before known, and without the new combination the whole would have been the property of the public, when such a combination is patented, it is infringed by every subsequent combination of the same elements as those which compose it; and no subsequent combination is substantially different from the patented one, merely because it was in a single device different from one of its elements, provided such substituted device was at the date of the patent a well-known substitute for the omitted one. Sands *v.* Wardell, 3 *Cliff.* 277.

Where all the elements of a machine are old, and the invention consists solely in the combination, by which a new and useful result is effected, as compared with the old machine on which the improvement is made, no one can be held as an infringer who does not use all of the elements of the new combination. But if defendant uses the same elements in substantially the same way and so as to produce substantially the same result, he is liable. Roberts *v.* Harnden, 2 *Cliff.* 500.

Although one person has patented a combination, which, however, turns out to be useless, if another adds to the combination another element, and thereby makes the whole practically useful, the person who adds this last element is not an infringer, but is

entitled to use, not merely his improvement,—requiring first a license to use the former combination,—but he may use the whole. Robertson *v.* Hill, 4 *Pat. Off. Gaz.* 132 ; 6 *Fish. Pat. Cas.* 465.

A patent for a mere combination of three distinct devices is not infringed by the use of only two of such devices without the other, if there is a substantial difference between the two machines. Rich *v.* Close, 8 *Blatchf.* 41 ; 4 *Fish. Pat. Cas.* 279.

If a patent is for a mere arrangement or combination of old devices to produce a somewhat better result in a known art, the substitution of a new element, not known at the date of the patent, may avoid infringement. American Bell Telephone Co. *v.* Spencer, 8 *Fed. Rep'r*, 509 ; 20 *Pat. Off. Gaz.* 299.

The use of a worthless patented combination, in connection with a new element that renders the whole useful, cannot be punished as an infringement of the patent for the worthless combination. Bliss *v.* Brooklyn, 6 *Fish. Pat. Cas.* 289.

Where a patented invention is merely a combination subordinate to pre-existing devices and has been limited to such sub-combination by the language of the claim, the patentee cannot successfully insist that he is entitled to cover by such claim the pre-existing devices ; and this is true where one of the joint inventors of the junior invention is also the inventor of the senior inventions. The Hopkins, &c. Manuf. Co. *v.* Corbin, 14 *Blatchf.* 396.

A patent for a combination of new elements with old may secure the new elements by themselves as well as the combination. American Diamond Rock Boring Co. *v.* Sutherland Falls Marble Co., 2 *Fed. Rep'r*, 353 ; 18 *Blatchf.* 148 ; 10 *Rep'r*, 9 ; 5 *Bann. & A. Pat. Cas.* 347.

Where a patent for a combination of known parts is not infringed by the use of any number of the parts less than the whole, yet if some of the parts are new, the like use of such parts, though with different devices from the rest of the combination, is an infringement to that extent. Sharp *v.* Tifft, 2 *Fed. Rep'r*, 697 ; 18 *Blatchf.* 132 ; 17 *Pat. Off. Gaz.* 1282 ; 5 *Bann. & A. Pat. Cas.* 390.

Complainant filed a bill for infringement of a patent for a combination against one who had erected a machine containing all the parts of the patented combination but one. After the filing of the bill this latter part was added. It was *held* that the bill must be dismissed, as there was proof that this part was not a necessary incident to the machine, and that its use was not contemplated at

the time of the construction of the machine. Maynard *v.* Pawling, 3 *Fed. Rep'r*, 711; 18 *Pat. Off. Gaz.* 244; 5 *Bann. & A. Pat. Cas.* 551.

If a patented combination of numerous parts includes in it other new and useful combinations of less of the parts, the patentee is entitled to the exclusive use of the lesser combinations as well as the exclusive use of the whole. Holly *v.* Vergennes Machine Co., 4 *Fed. Rep'r*, 74; 18 *Blatchf.* 327; 18 *Pat. Off. Gaz.* 1177.

Using a part of a patented combination is an infringement, if that part is separable and was new and patentable to the inventor. Adair *v.* Thayer, 4 *Fed. Rep'r*, 441; 17 *Blatchf.* 468; 9 *Rep'r*, 401; 4 *Bann. & A. Pat. Cas.* 118.

A combination for a fruit-preserving jar, all the elements of which, except a device to secure more effectual sealing are old, is a new and original invention. If all the essential elements of the combination have not been before embodied and employed together, it is to be taken as original. McCulley *v.* Cunningham, 3 *Pittsb.* 366.

The elements of a combination being old *per se*, the essence of the invention consists in the novelty of their combination and its adaptation to the use for which it is intended; and its infringement will consist in the use of a machine substantially embodying the combination in its entirety for the same purpose. Smith *v.* Marshall, 10 *Pat. Off. Gaz.* 375; 2 *Bann. & A. Pat. Cas.* 371.

A distinct claim for each of the constituents of a combination of old elements will not protect such combination where there has been no specific claim for the same. Delaware Coal, &c. Co. *v.* Packer, 1 *Fed. Rep'r*, 851; 24 *Pat. Off. Gaz.* 1273; 5 *Bann. & A. Pat. Cas.* 296.

Any new combination of old ingredients is patentable when any new, useful results follow; but the mere exercise of judgment or mechanical skill in selecting a few ingredients from a larger number already known and specified in prior patents is not an invention. Welling *v.* Crane, 14 *Fed. Rep'r*, 571; 23 *Pat. Off. Gaz.* 189.

It is not essential to a patentable combination that the several devices or elements should co-act upon each other, provided all co-operate. Stutz *v.* Armstrong, 20 *Fed. Rep'r*, 843; 28 *Pat. Off. Gaz.* 367.

The manufacture and sale by a defendant of stove-pipes, elbows, valves and the like apparatus, such as are used and which are intended to be used in a patented combination of such articles with

others not manufactured and sold by the defendant, but which may be and are used in other combinations, do not necessarily infringe the patent for the particular combination. Millner *v.* Schofield, 4 *Hughes*, 258.

A patent claiming combinations separate in their nature but capable, if desired, of separate use, was *held* not to be a unit, and use of all the parts was adjudged not necessary to constitute an infringement. Densmore *v.* Schofield, 4 *Fish. Pat. Cas.* 148.

No one infringes a patent for a combination who does not employ all the ingredients of the combination; but if he employs all the ingredients, or adopts mere formal alterations, or substitutes for one ingredient another which was well known at the date of the patent as a proper substitute for the one withdrawn, and which performs substantially the same function as the one withdrawn, he does infringe. King *v.* Louisville Cement Co., 4 *Pat. Off. Gaz.* 181; 6 *Fish. Pat. Cas.* 336.

If the patent is for a combination, and on that a recovery is sought, the complainant may recover for the element that he has added. Ingels *v.* Mast, 1 *Flippin*, 424; 2 *Bann. & A. Pat. Cas.* 24.

Where the invention consists not only in the combination, but in the improvement of several of the parts of the combination, the violation of one of them is an infringement for which an action will lie. Parker *v.* Haworth, 4 *McLean*, 370.

If the whole of the combination be taken, though something be added, still it is an infringement. Pitts *v.* Wemple, 6 *McLean*, 558.

A patent for a combination of known parts is not infringed by the use of any number of the parts less than the whole; or by the substitution of a new element, or of one that performs a substantially different function; or by the substitution of an old element not known at the date of the patent as a proper substitute for the omitted ingredient; or by a new combination of the existing elements of the patented combination. A combination must be maintained as an entirety, and no one separate element can be regarded as the distinctive and essential feature of the invention. Rowell *v.* Lindsay, 6 *Fed. Rep'r*, 290; 10 *Biss.* 217; 17 *Pat. Off. Gaz.* 1565.

A patent for the combination of old parts is not infringed by a different combination of the same parts to produce the result. Pattee *v.* Moline Plow Co., 9 *Fed. Rep'r*, 821; 10 *Biss.* 377; 22.

Pat. Off. Gaz. 173; Washburn, &c. Manuf. Co. *v.* Griesche, 16 *Fed. Rep'r*, 669; 5 *McCrary*, 246.

A patent for a combination of mechanical devices is not infringed by the use of a mere element of the combination previously well known. Underwood *v.* Warren, 24 *Fed. Rep'r*, 182.

Using one of the important parts of a combination may be an infringement of a patent for the combination. Matthews *v.* Spangenberg, 15 *Rep'r*, 261.

Where old devices are brought together to co-operate in producing a result which has not been produced before by the same elements, the invention is patentable although the same result may have been produced before by some of the elements of the combination acting with others, but in a substantially different way. Hoe *v.* Knap, 27 *Fed. Rep'r*, 204.

In patents for combinations of mechanisms, limitations and provises imposed upon the inventor are to be strictly construed. The production of an old result by a more effective combination of old elements, by one patentee, will not prevent another patentee from making new combinations of such elements to produce the same result, if the latter does not use the combination of parts claimed in the first patent. Otis Bros. Manuf. Co. *v.* Crane Bros. Manuf. Co., 27 *Fed. Rep'r*, 550.

A device is patentable although the elements are old, if the combination is new, and produces a new and useful result, and if to produce it required more than mere mechanical skill. May *v.* County of Fond du Lac, 27 *Fed. Rep'r*, 691.

A combination of old elements for a new purpose is patentable. Donoughe *v.* Hubbard, 27 *Fed. Rep'r*, 742.

A patent for an improved baggage-check holder, claiming only a combination which included flanges bent over for holding the check securely, was *held* not infringed by a device for the same purpose having such flanges but no other element of the combination. Abbott *v.* Hoole Manuf., &c. Co., 31 *Pat. Off. Gaz.* 156.

The claim of a specific device or combination in a patent, and the omission to claim other devices or combinations apparent on its face, are in law a dedication to the public of that which is not claimed. Hill *v.* Comrs. of Patents, 1 *Cent. Rep'r*, 91.

In a patent for a new and useful improvement in the mode of forming rails for railroad carriages, for use in cities, &c., "where it is desirable that the wheels of ordinary carriages should not be subjected to injury or obstruction," the patentee claimed the em-

ployment of plates or rails having narrow grooves on each side of the track for the flanges of the car wheels to run in, by which they were adapted to the unobstructed passing over them of the various kinds of common carriages, such rails being also sunk to a level with the surface of the street. It was *held* that such patent consisted of the combination of such grooves with the rail, on both sides of a railroad track, such combination being depressed to a plane corresponding with the street; and that the use by the defendant of a double iron rail, with a groove or interval between large enough for the flange of the wheel, placed on the inner side of a curve, the ordinary flat iron rail being used on the exterior line of the same curve, and the whole constructed on the same plane with the general track of the road, without regard to the convenience of carriages to pass over it, was not an infringement of such combination, it having used but one element of the plaintiff's combination. Stimpson *v.* Baltimore & Susquehanna R. R. Co., 10 *How.* 329, 346.

In a patent for a combination, with other elements, of heating pipes described in the specification as constructed with flexible tubes, gum tubing or suitable rock-joints, so as to permit the elevation and lowering of the pipes without interfering with the circulation of steam through them, the flexible joints are distinguishing and essential features of the construction of the pipes; and a machine without hinge joints is not an infringement of the combination. Sheeder *v.* Shannon, 25 *Fed. Rep'r*, 824.

176. *To a Composition of Matter.*

In a patent for an improvement in making friction matches, the invention was not a compound of new ingredients, but was simply a new combination of materials before in use for that purpose, consisting of a composition formed of phosphorus with the earthy materials and glutinous substance only, without chlorate of potash or other like objectionable ingredients. It was *held* that any person might use any one or all the materials forming the composition, provided he did not use them in the combination patented, or that any one might use them in combination with chlorate of potash, as they were formerly used. But a mere colorable difference or slight variation of such a combination will not exempt a person from the charge of infringement. Byam *v.* Eddy, 2 *Blatchf.* 521; 23 *Vt.* 666.

In an action for an infringement of a patent for a compound, if the defendants do not use the entire combination, but use another ingredient producing another result, they do not infringe. Smith *v.* Murray, 27 *Fed. Rep'r*, 69.

177. *The Doctrine of Equivalents, in General.*

In the administration of the patent law the substantial equivalent of a thing is deemed the same as the thing itself. Two devices which perform the same function in substantially the same way, and accomplish substantially the same result, are treated as the same, though they may differ in name or form. Machine Co. *v.* Murphy, 97 *U. S.* 120.

Where all the elements of a machine are old, the patentee cannot invoke the doctrine of equivalents to suppress all other improvements on the old machine. But he is an infringer who makes or vends the patented improvement with no other change than the employment, as a substitute for one of its elements, of a device well known in the state of the art to be such at the date of the invention, and which any constructor acquainted with the art would then know how to employ. Such substitution of one well-known element for another is a mere colorable evasion of the patent. Union Sugar Refinery *v.* Mathiessen, 3 *Cliff.* 639; 2 *Fish. Pat. Cas.* 600.

The term "equivalent" has two meanings; the one relates to the results that are produced, and the other to the mechanism by which those results are produced. Two things may be equivalent, that is, the one equivalent to the other as producing the same result when they are not the same mechanical means. In other words there may be equivalents in the sense of producing the same result, each of which is an independent matter of invention. Johnson *v.* Root, 1 *Fish. Pat. Cas.* 351: Burden *v.* Corning, *Id.* 477.

The action of the commissioner of patents, in requiring a disclaimer of so much of the reissued patent as claimed in specific terms the use of a specified equivalent, is not conclusive upon complainants. The patentee, without describing equivalents, is entitled to use equivalents and to treat the use of equivalents by others as an infringement. Union Metallic Cartridge Co. *v.* United States Cartridge Co., 11 *Pat. Off. Gaz.* 1113.

One substance does not constitute the equivalent of the other

when each produces a different product under the same conditions. Clarke *v.* Johnson, 4 *Fed. Rep'r*, 437; 18 *Blatchf.* 450; 18 *Pat. Off. Gaz.* 1276.

The defendant employed the plaintiffs' patented process of treating tobacco, with the exception that he made use of an equivalent for the gum arabic used by the plaintiffs to produce the same effect as that rendered by the plaintiffs' process. This was *held* an infringement. Kimball *v.* Hess, 15 *Fed. Rep'r*, 393; 15 *Rep'r*, 583; 26 *Pat. Off. Gaz.* 107.

Mechanical equivalents are not those merely which produce the same result; a mechanical equivalent, as generally understood, is where one device may be adopted instead of another to perform the known function of the latter, by a person skilled in the art, from his knowledge of the art. Smith *v.* Marshall, 10 *Pat. Off. Gaz.* 375; 2 *Bann. & A. Pat. Cas.* 371; Johnson *v.* Root, 1 *Fish. Pat. Cas.* 351; Burden *v.* Corning, 2 *Id.* 477.

Though the defendant's machine may be simpler, cheaper, and possibly better than the complainant's patented machine, yet if its chief efficiency arises from the use of equivalents to the complainant's patent, it is infringement. Odiorne *v.* Denney, 3 *Bann. & A. Pat. Cas.* 287; 1 *N. J. L. J.* 183.

Where a person procures a patent for the building of a machine which produces certain novel and useful results by means of certain mechanical contrivances and appliances, any application of known mechanical powers which will produce such results, although different in form from the means employed by the original patentee, is a mechanical substitute and equivalent of the same. Wilt *v.* Grier, 5 *Fed. Rep'r*, 450; 19 *Pat. Off. Gaz.* 427.

A device is the equivalent of one that is patented, if it performs substantially the same function, in the same way, and produces the same result; though it may be of a different form and bear a different name, its use will be an infringement. Westlake *v.* Cartter, 4 *Pat. Off. Gaz.* 579; 6 *Fish. Pat. Cas.* 519.

evices are equivalents when those skilled in the science or art know that one will produce the same result as the other. May *v.* County of Fond du Lac, 27 *Fed. Rep'r*, 691.

One patent infringes another when the second device works out the same result as the first by substantially the same means, using equivalent parts to perform the functions performed by the elements of the first mechanism. Holliday *v.* Covel, 27 *Fed. Rep'r*,

217 ; Conover *v.* Roach, 4 *Fish. Pat. Cas.* 12 ; Merriam *v.* Drake, 5 *Id.* 259 ; 9 *Blatchf.* 336.

A rod is the known equivalent of an endless chain in machinery, where it can be used for the same purpose and with like effect. According to the principles of patent law, they are not substantially different. Spain *v.* Gamble, 1 *MacArthur Pat. Cas.* 358.

A contrivance which is used for the same general purpose as a patented device, which performs the same kind of duties, or is applicable to the same object as the latter, will be regarded as its equivalent and is not patentable. *Re* Nutting, 1 *MacArthur Pat. Cas.* 455.

The doctrine of mechanical equivalents is *held* not applicable to a case of alleged infringement where the inventors of complainant's device were not the first to show the use of such a device for the particular purpose. Tobey Furniture Co. *v.* Colby, 26 *Fed. Rep'r*, 100 ; 34 *Pat. Off. Gaz.* 1276.

178. *Application of the Doctrine of "Equivalents" to Combinations.*

Bona fide inventors of a combination are as much entitled to equivalents as the inventors of other patentable improvements ; by which is meant that a patentee in such a case may substitute another ingredient for any one of the ingredients of his invention, if the ingredient substituted performs the same function as the one emmitted in the patented combination. Hence, it is clear that an alteration in a patented combination which merely substitutes another (old) ingredient for one of those in the combination, is an infringement, if the substitute merely performs the same function and was well known, at the date of the patent, as a proper substitute for the omitted ingredient. Gould *v* Rees, 15 *Wall.* 187. S. P., Water Meter Co. *v.* Desper, 101 *U. S.* 332 ; Imhauser *v.* Burke, *Id.* 647 ; Storrs *v.* Howe, 4 *Cliff.* 388 ; 10 *Pat. Off. Gaz.* 421 ; 2 *Bann. & A. Pat. Cas.* 420 ; Welling *v.* Rubber Coated Harness Trimming Co., 7 *Pat. Off. Gaz.* 606 ; 2 *Bann. & A. Pat. Cas.* 1 ; Dederick *v.* Cassell, 9 *Fed. Rep'r*, 306 ; 27 *Int. Rev. Rec.* 400 ; 20 *Pat. Off. Gaz.* 1233 ; King *v.* Louisville Cement Co., 4 *Pat. Off. Gaz.* 181 ; 6 *Fish. Pat. Cas.* 336 ; Whittlesey *v.* Ames, 13 *Fed. Rep'r*, 893 ; 9 *Biss.* 225 ; 18 *Pat. Off. Gaz.* 357 ; 5 *Bann. & A. Pat. Cas.* 96.

It is not always sufficient evidence that two combinations of elements are equivalent, to show that each element of the combination in one may be regarded, under some circumstances, as the equivalent of the corresponding element in the other, when the elements are separately considered. If the mechanical combinations of the members of the two machines are such that the action and mode of operation differ in the two machines, then one is something more than a new mechameal equivalent for the other. Blake *v.* Rawson, 3 *Biss.* 77; 3 *Pat. Off. Gaz.* 122; 6 *Fish. Pat. Cas.* 74.

When a substitute is used for one ingredient in a patented combination which has every property and performs every function of the original in the combination, it does not cease to be an equivalent because, in addition, it does something more and better. Atlantic Giant Powder Co. *v.* Goodyear, 13 *Pat. Off. Gaz.* 45; Adams *v.* Joliet Manuf. Co., 12 *Pat. Off. Gaz.* 93.

Where, by a claim in a patent for an improvement in grain drills, a lever or its equivalent as a mechanical instrument was made an essential element, it was *held*, that the use of the human hand instead of the lever was not a mere equivalent constituting an infringement, although in the patented machine the hand was applied to work the lever. Brown *v.* Davis, 116 *U. S.* 237.

A different arrangement of the parts of the machine from that of the complainant's, and producing a different and better result, is not an infringement. Habeman *v.* Whitman, 5 *Bann. & A. Pat. Cas.* 530.

A patent for an "improvement in floating mowing machines," arranged and adapted to cut weeds and grass under water, claimed only the combination of the old cutting device of a mowing machine with a boat to float upon the water, transmitting motion to the cutter by means of a vibrating lever. It was *held* that the substitution of a vertical crank-shaft for such vibrating lever, the shaft performing the same functions as the lever and no other, and being a known equivalent for the lever, was an infringement of the patent. Piper *v.* Shedd, 26 *Fed. Rep'r*, 151.

A patent for a machine for washing bottles, which claimed the combination of a stationary water supply-pipe, a sleeve shaft mounted upon and adapted to be revolved about said stationary pipe, and a brush or scraper, with other devices, was *held* to be infringed by a machine with a revolving supply pipe covering the brush at its forward end and joined at its rear to the stationary

supply-pipe, these devices being fairly equivalents. Hoyt *v.* Slocum, 26 *Fed. Rep'r*, 329.

Patent granted to Walworth and Buschick, in 1867, for improvements in looms was *held* not infringed by a device which did not contain an important element of the claim or any equivalent therefor. Taft *v.* Steere, 26 *Pat. Off. Gaz.* 1020.

A patent for an improvement in hammocks, claiming six elements, was *held* not infringed by a hammock in which three of them were not used. Travers *v.* Palmer, 25, *Fed. Rep'r*, 511; 31 *Pat. Off. Gaz.* 382.

A patent for an improvement in wardrobe bedsteads, covering a device for an arrangement of folding doors, which used, described, and specifically claimed three doors, was *held* not infringed by a device which accomplished, substantially the same result, by the use of only two folding doors. Tobey Furniture Co. *v.* Colby, 26 *Fed. Rep'r*, 100; 34 *Pat. Off. Gaz.* 1276.

179. *To Compositions of Matter.*

The substitution of a mere known equivalent in place of one element in a composition of matter is an infringement of a patent for such composition; but where the patentee of a composition does not embrace equivalents in his claim, but confines himself to the specific ingredients or things, and expressly excludes all others, or expressly excludes some or one other, a use, in a similar combination, of the thing disclaimed is no infringement. Where a patent was for sawing matches in sheets, so as to leave them united at one end, and then wrapping them in paper in a particular manner, it was *held* that the patent was for the entire and complete mode described, and was not infringed by putting up matches attached at one end, but not wrapped in slips of paper. Byam *v.* Farr, 1 *Curt.* 260.

Patents are infringed by the substitution of chemical equivalents, as well as of mechanical equivalents; even if in some respects they are improvements on the original process patented. To constitute an infringement of a chemical process, it is not necessary that the substituted ingredient be the equivalent in every respect, and for every purpose, of that in place of which it is used; it must only be an equivalent in the particular process, contributing to produce the same composition of matter, by substantially the same

chemical action. Thus a paste consisting of flour, salt, alum, and corrosive sublimate, is infringed by a compound consisting of flour, chloride of zinc, alum, corrosive sublimate and oil of cloves ; and where the patentee of an improved paste used the chloride of sodium mainly for increasing the solubility of the antiseptic agent employed, and assisting in its diffusion through the mass of the paste, the use of the chloride of zinc, which in the particular process produced practically the same result, was *held* to be an infringement. Woodward *v.* Morrison, 1 *Holmes*, 124 ; 2 *Pat. Off. Gaz.* 120 ; 5 *Fish. Pat. Cas.* 357.

The substitution in a patented mixture, of an ingredient which, although not precisely the same in its action, produces all the valuable and beneficial results attending that for which it was substituted, and in substantially the same manner, is an equivalent, and an infringement of the patent. Atlantic Giant Powder Co. *v.* Mowbray, 12 *Pat. Off. Gaz.* 560 ; 2 *Bann. & A. Pat. Cas.* 442 ; Knox *v.* Great Western Quicksilver Mining Co., 14 *Pat. Off. Gaz.* 897 ; 6 *Sawyer*, 430 ; 7 *Rep'r*, 325 ; 4 *Bann. & A. Pat. Cas.* 25.

Where the ingredients in a compound are the same, and the change is merely in the mode of combining them, or there is a substitute of one ingredient having the same qualities and producing the same result, there is an infringement. Allen *v.* Hunter, 6 *McLean*, 303, 313.

Selling materials in dry packages with printed directions whereby an article or effect can be produced essentially similar to that covered by a patent, infringes such patent. Alabastine Co. *v.* Payne, 27 *Fed. Rep'r*, 559.

180. *Rights of Purchaser of a Specific Article from the Patentee or his Licensee.*

For Rev. Stat. § 4899, securing this right, see *ante*, 135.

By the sale of a patented machine, it becomes the property of the purchaser, and is no longer protected by the patent laws. The purchaser may use it, repair it, improve it, &c., in the same manner as any other chattel belonging to him. Chaffee *v.* Boston Belting Co., 22 *How.* 217.

Use of an invention with knowledge and without prohibition of an inventor, before application, entitles the person so using to continue the use after the patent has been granted. McClurg *v.* Kingsland, 1 *How.* 202 ; 17 *Pet.* 228

Repairing partial injuries, whether they occur from accident or wear, is only refitting a machine for use. And it is no more than that, though it shall be a replacement of an essential part of a combination. But if a patented machine as a whole should happen to be broken so that its parts could not be re-adjusted, or be so much worn as to be useless, a purchaser cannot make or replace it by another, but must buy a new one. To do either would be reconstruction. Wilson *v.* Stimson, 9 *How.* 109, 124.

Thus the right to replace the cutters in Woodworth's planing machine was *held* to vest in a purchaser; as the use of the machine depends upon the replacement of such cutters, and as a machine will last several years, whereas the cutters must be replaced every sixty or ninety days. *Ib.*

A grant of a right, by a patentee, to make and use a patented machine within a term for which it has been granted, will give the purchaser of machines from such grantee the right to use the individual machine as long as the machine itself lasts; nor will this right to use a machine cease because an extension of the patent, not provided for when the patentee made his grant, has since been allowed, and the machine sold has lasted and is used by the purchaser within the term of the time covered by this extension. Bloomer *v.* Millinger, 1 *Wall.* 340. S. P., Bloomer *v.* Stolley, 5 *McLean*, 158; 8 *West. L. J.* 158.

A patented article, when rightfully bought, may be used anywhere. Hobbie *v.* Smith, 27 *Fed. Rep'r*, 656.

Where a patentee has assigned his right to manufacture, sell and use within a limited district an instrument, machine or other manufactured product, a purchaser of such instrument or machine, when rightfully bought, within the prescribed limits, acquires by such purchase the right to use it anywhere, without reference to other assignments of territorial rights by the same patentee. The right to the use of such machines or instruments stands on a different ground from the right to make and sell them, and inheres in the nature of a contract of purchase, which carries no implied limitation of the right of use within a given locality. The assignee, for a limited district, of a patent for an improvement in coffins, made and sold within the district, coffins containing the patented improvements; it was *held*, that the purchaser of a coffin could put it to use in an interment anywhere. He was not restricted to use within the district designated in the assignment. Adams *v.* Burke,

17 *Wall.* 453. S. P., McKay *v.* Wooster, 6 *Am. L. T. Rep.* 169; 3 *Pat. Off. Gaz.* 441; 2 *Sawyer*, 373; 6 *Fish. Pat. Cas.* 375.

The assignee of a particular territory may sell within that territory, although he knows the article is to be used in the territory of another assignee. Hobbie *v.* Smith, 27 *Fed. Rep'r*, 656.

To entitle the purchaser of a machine to the benefits of the act of 1839, § 7, he must be one who has used the invention before the application for a patent by license from the inventor himself, and not a fraudulent purchaser, or a purchaser from a wrong-doer, without the knowledge or against the will of the inventor. Pierson *v.* Eagle Screw Co., 3 *Story*, 402.

When a patentee has himself constructed a machine, and sold it without any conditions, or has authorized another to construct, sell and deliver it, or to construct and use and operate it without any conditions, and the consideration has been paid to him for the thing patented, the rule is well established that the patentee must be understood to have parted to that extent with all his exclusive right, and that he ceases to have any interest whatever in the patented machine so sold and delivered, or authorized to be constructed and operated. When such circumstances appear, the owner of the machine, whether he built it or purchased it, if he has also acquired the right to use and operate it during the continuance of the patent, may continue to use it until it is worn out, in spite of any and every extension subsequently obtained by the patentee or his assigns. Wooster *v.* Seidenberg, 13 *Blatchf.* 88; 10 *Pat. Off. Gaz.* 244. See, also, Wooster *v.* Taylor, 12 *Blatchf.* 384; 8 *Pat. Off. Gaz.* 644.

If one has a right to a patented machine, and to the use of it, he has a right to work it himself, or by his servants, or to lease it out to any other person. Reutgen *v.* Kanowrs, 1 *Wash.* 168.

An agreement between the patentee and his licensees, that the latter will not manufacture certain articles, cannot prevent third persons, who purchase from the licensees articles which they are authorized to make and sell, from afterward converting them into the prohibited articles. The public cannot be compelled to notice or regard agreements between the patentee and his licensees as to the limitation of the use of the article made by them. Such a contrivance to destroy competition may be valid, but the covenant binds only the parties to it. If a stranger purchase the product from one licensed to use the process, he need look no further, and may use it for his own purposes, without inquiring for or regard-

ing any private agreement of licensees not to compete with one another. Metropolitan Washing Machine Co. *v.* Earle, 2 *Fish. Pat. Cas.* 203.

Buying and using a second time articles stamped "licensed to use once only," and sold to defendants' vendor upon that express condition, *held* an infringement. American Cotton Tie Supply Co. *v.* Bullard, 17 *Blatchf.* 160; 17 *Pat. Off. Gaz.* 388; 9 *Rep'r*, 70; 4 *Bann. & A. Pat. Cas.* 520: Same *v.* Simmons, 106 *U. S.* 89.

181. *Rights of Purchaser from an Infringer*

The purchaser of a manufactured article made in violation of a patent of a third person, but without any connection on the part of such purchaser with the manufacturer except as a purchaser, will not make the party buying guilty of an infringement of the rights of the patentee, as having used the patented invention. Thus, in general, a contract to buy all the product of a patented machine, during a certain period, does not render the purchaser liable to an action of infringement for the use of the machine on which it is made. Otherwise, if such contract is only a colorable purchase of the products, and is in reality a hiring of the machine. Keplinger *v.* De Young, 10 *Wheat.* 358.

Purchasers of an article manufactured by infringers of a patented machine, are not liable as infringers. Goodyear *v.* Railroad, 2 *Wall. Jr.* 356; 1 *Fish. Pat. Cas.* 626; Anon., 3 *West. L. J.* 144; Blanchard's Gun-stock Turning Factory *v.* Jacobs, 2 *Blatchf.* 69.

The sale of the products of a patented machine is not an infringement. The products cannot be reached except in the hands of some one in some manner connected with the use of the patented machine. Boyd *v.* McAlpine, 3 *McLean*, 427; Goodyear *v.* Railroad, 2 *Wall. Jr.* 356; 1 *Fish. Pat. Cas.* 626.

When a patentee recovers from an infringing manufacturer full damages and profits on account of the infringement, the purchaser from the manufacturer, who is a user of the machine, will be protected in such use against a suit for infringement, as he would be if he were a licensee from the patentee. But this could only be held on a clear showing that the purchaser was using the same patented machine or instrument as that involved in the suit between the patentee and the infringing manufacturer, and that the user was a vendee of such manufacturer. Probably, it must further

appear that the patentee's claim to profits and damages against the manufacturer has been actually paid and satisfied. Allis *v.* Stowell, 16 *Fed. Rep'r*, 783.

An agreement between owners of a patent and infringers, by which the former release to the latter all claims against them by reason of the manufacture and sale of the patented article, and also all claims against all other persons who had purchased or sold the same article when manufactured by the infringers, makes purchasers from the infringers lawful owners of the articles so purchased; and a re-sale by them of such articles is not an infringement. Alabastine Co. *v.* Richardson, 26 *Fed. Rep'r*, 620.

182. *What has been held to be or not to be Infringement, in peculiar Cases.*

A patent claiming only a particular style of spring was *held* not to be infringed by employing for the same purpose a spring differing somewhat in style. Field *v.* De Comeau, 116 *U. S.* 187.

A patent for covering the upper surface and front edge of a key board with a single sheet of plaster composition was *held* infringed by covering the surface with a strip and the front edge with another strip of such composition. Celluloid Manuf. Co. *v.* Pratt, 22 *Blatchf.* 367; 21 *Fed. Rep'r*, 313. See 23 *Id.* 38.

Patent for covering piano keys with celluloid, in a "continuous strip or roll"—was *held* not infringed by a device using a separate strip for each key. Celluloid Manuf. Co. *v.* Comstock, 23 *Fed. Rep'r*, 38.

A patent for improving locks by making part of the mechanism more yielding than the rest, was *held* not infringed by the device of making the other parts stronger than those which in the patentee's lock were weakened. Newbury *v.* Mossman, 21 *Fed. Rep'r*, 579; 29 *Id.* 271.

A patent for causing a steamboat capstan to revolve by connecting it with the vessel's engine, *held* not infringed by accomplishing the same thing by connecting an independent engine with the capstan. McMillin *v.* St. Louis & Vicksburg Anchor Line, 22 *Fed. Rep'r*, 169.

A patent for forming a pavement by laying concrete in sections so that any single block could be raised separately, was *held* infringed by laying the concrete in a mass while yet plastic, and

immediately dividing it into blocks. Kuhl *v.* Mueller, 21 *Fed. Rep'r*, 510; 28 *Pat. Off. Gaz.* 541.

A plainly declared element of a combination cannot be eliminated by judicial construction, although using it is not necessary to the result. Thus a patent for straining out sand by a screen working in water in a closed vessel is not infringed by disusing the vessel and using the same strainer in the open river. Williams *v.* Stoltzenback, 23 *Fed. Rep'r*, 39; 30 *Pat. Off. Gaz.* 891.

A patent for an improvement in telegraphic printing instruments, the principal feature of which was the independent rotation of the two type wheels, standing contiguous, "so as to be impressed separately or jointly upon the same strip of paper," was *held* infringed by a machine the type wheels of which could not rotate together, although they could not print simultaneously. Gold & Stock Tel. Co. *v.* Commercial Tel. Co., 23 *Fed. Rep'r*, 340; 31 *Pat. Off. Gaz.* 1559. See Same *v.* Same, 22 *Fed. Rep'r*, 838.

A patent for improving flanging machines by throwing the lower roll beyond the upper, is infringed by the device of throwing the upper roll back of the lower roll. Phillips *v.* Carroll, 23 *Fed. Rep'r*, 249; 31 *Pat. Off. Gaz.* 265.

A patent for "a horse collar, consisting of a frame combined with a number of detachable pads" was *held* not infringed by the use of detachable pads, or sweat-cloths with detachable pads, independent of a collar. Osmer *v.* J. B. Sickles Saddlery Co., 23 *Fed. Rep'r*, 724.

A patent for a leather cutting-press, claiming "the revolving cutting-block, in combination with the cutting-press," was *held* not infringed by a machine using a revolving block and cutting-die, but not *the* cutting-press described in the specification and drawings of the patent. Richardson *v.* Bresnahan, 23 *Fed. Rep'r*, 897.

A patent for an air-cooling apparatus, using ice as the cooling agent was *held*, not infringed by an apparatus in which the refrigerating effect was produced by the compression and expansion of air, not by contact with ice. Bate Refrigerating Co. *v.* Eastman, 24 *Fed. Rep'r*, 645; 32 *Pat. Off. Gaz.* 517.

Patent for improvement in pocket check-books was *held* not limited to any particular manner of binding, and therefore infringed by a device in which the checks were unbound. Norrington *v.* Merchants' Nat. Bank, 25 *Fed. Rep'r*, 199.

Patent for improvements in tilting chairs was construed; and *held*, that it included a chair whose seat and occupant were sup-

ported by a central spiral spring interposed between the seat frame and the base, but not a chair where the weight of the occupant was sustained by rockers, and the only function of the spring was to impart the tilting motion. Bunker *v.* Stevens, 26 *Fed. Rep'r*, 245.

A patent for an improvement in cultivators, consisting in runners pivoted to the wheel spindles or axle, so as to be held out of contact with the ground when the machine was used for field operations, and to be held in contact with the ground when the plows were suspended from the axle for transportation, was *held* not infringed by the use of hinged runners, which were folded up by hand for field operations, and folded down and locked for transportation. *Pattee Plow Co. v. Kingman*, 23 *Fed. Rep'r*, 801.

A patent for a combination, constituting an improvement in tables for tile machines, was *held* not infringed by similar mechanism not employing a flexible standard which appeared to be an indispensable part of the patented combination. Leach *v.* Chandler, 24 *Fed. Rep'r*, 791 ; 33 *Pat. Off. Gaz.* 237.

The use of celluloid in the fitting of artificial teeth was *held* not an infringement of a patent involving the use of hard rubber or vulcanite for the same purpose. Goodyear Dental Vulcanite Co. *v.* Brightwell, *MacArthur & M.* 74.

Patent for improvements in the construction of lumber-driers, was *held* infringed by a drier in the construction of which the main features of the patented devices were involved, and which was, in principle, the same as that intended to be described in the patents, notwithstanding some slight mechanical deviations from the specific directions given in the patents for the construction of the driers described. Burdsall *v.* Curran, 27 *Pat. Off. Gaz.* 1320

A patent covering the process of maturing and browning coffee in an uncured condition by subjecting it to the direct action of steam, is not infringed by the application of heat only to the coffee in that condition. Arnold *v.* Phelps, 29 *Pat. Off. Gaz.* 538.

XIV. JURISDICTION OF COURTS OVER INFRINGEMENTS.

183. *Distinction between the Legal and the Equitable Remedy.*

Different rules for the assessment of damages prevail in suits of equity, from those which are recognized in actions at law, but in all other respects the rights of the parties depend upon the same considerations. Hudson *v.* Draper, 4 *Fish. Pat. Cas.* 256 ; 4 *Cliff.* 178.

In case of infringement, the patentee may elect to sue at law for damages, usually measured by his royalty, or in equity—for profits and an injunction. Cowing *v.* Rumsey, 4 *Fish. Pat. Cas.* 275 ; Bragg *v.* City of Stockton, 27 *Fed. Rep'r*, 509.

Even when a suit at law will lie for infringement of a patent, proceedings in equity may usually be maintained, as affording a more practical and efficient remedy. Hill *v.* Whitcomb, 5 *Pat. Off. Gaz.* 430 ; 1 *Holmes*, 317 ; 1 *Bann. & A. Pat. Cas.* 34.

A bill for an accounting of profits is not maintainable unless a right to an injunction or some other substantive ground of equitable relief is shown. Spring *v.* Domestic Sewing Machine Co., 13 *Fed. Rep'r*, 446 ; 22 *Pat. Off. Gaz.* 1445 ; 29 *Int. Rev. Rec.* 22 ; 14 *Rep'r*, 711.

A bill in equity will not lie solely to recover damages for the infringement of a patent ; but if it pray for an injunction, or for a discovery and account of profits, it will be maintained. Vaughan *v.* East Tennessee, Virginia, &c. R. R. Co., 11 *Pat. Off. Gaz.* 789 ; 1 *Flippin*, 621 ; 2 *Bann. & A. Pat. Cas.* 537.

The principle upon which courts of equity have jurisdiction in patent cases, and upon which injunctions are granted to patentees, is not that there is no remedy at law in favor of those whose property is invaded, but that the remedy at law involves a multiplicity of suits, and does not afford means of taking an account of profits. Motte *v.* Bennett, 2 *Fish. Pat. Cas.* 642.

184. *Original Jurisdiction of Circuit Courts.*

The circuit courts shall have original jurisdiction as follows :

. . . . . .

Ninth. Of all suits at law or in equity arising under the patent or copyright laws of the United States. *Rev. Stat.* § 629.

Originally the circuit courts had not jurisdiction of a suit for infringement of patents. Livingston *v.* Van Ingen, 1 *Paine*, 45 ; 4 *Am. L. J.* 46. This jurisdiction was conferred by section 7 of the act of 1836. Smith *v.* Plymouth, 4 *West. L. J.* 49 ; Goodyear *v.* Hullihen, 3 *Fish. Pat. Cas.* 251 ; 2 *Hughes*, 492. See note to *Rev. Stat.* 4921, *post.*

When a controversy turns, not upon the letters patent themselves, but only upon contracts concerning them, the circuit court has no jurisdiction except as citizenship of the parties may give it. The subject-matter of such contracts, where neither the validity of the patent nor a question of infringement of it is involved, does not give a court of the United States jurisdiction ; such court can act only where rights of the patentee under the patent laws are directly brought in question. Burr *v.* Gregory, 2 *Paine*, 426; Landolph *v.* Robinson, 2 *N. J. L. J.* 171 ; Teas *v.* Albright, 13 *Fed. Rep'r*, 406 ; 28 *Int. Rev. Rep'r*, 290 ; 22 *Pat. Off. Gaz.* 2069; 14 *Rep'r*, 712.

In a suit where all the parties to the suit were citizens of New York, the circuit court was *held* powerless to decree that defendant execute to plaintiff a transfer of letters patent. Perry *v.* Littlefield, 17 *Blatchf.* 272 ; 17 *Pat. Off. Gaz.* 51 ; 4 *Bann. & A. Pat. Cas.* 624.

Where one circuit court has sustained a patent, another circuit court should, unless plain mistake be shown, follow such decision in a suit upon the same patent in which the same evidence is relied on. Hammerschlag *v.* Garrett, 9 *Fed. Rep'r*, 43 ; 27 *Int. Rev. Rec.* 309. S. P., McCloskey *v.* Hamill, 15 *Fed. Rep'r*, 750 ; 23 *Pat. Off. Gaz.* 2122.

Where suit is brought in a circuit court upon a patent the validity of which has been sustained by judgments of other circuit

courts, the respect due to such decisions and the importance of consistency and uniformity of decisions in courts of co-ordinate jurisdiction where the same subject-matter is involved, require the court to adopt such judgments. American Ballast Log Co. *v.* Cotter, 11 *Fed. Rep'r*, 728; 31 *Pat. Off. Gaz.* 1030.

Where a patent has been established by a decision of a circuit court, after careful consideration, that decision is entitled to very great weight in a subsequent application, either before the same court or any other, for a preliminary injunction or for any preliminary relief. American Middlings Purifier Co. *v.* Christian, 3 *Bann. & A. Pat. Cas.* 42.

The provision of section 11 of the judiciary act of 1789 (now Rev. Stat. 739), that no civil suit shall be brought against an inhabitant of the United States, in any other district than that in which he is an inhabitant or in which he is found at the time of serving the writ, applies to suits for infringement, notwithstanding the legislation of Congress giving exclusive jurisdiction of such writs to courts of the United States. Chaffee *v.* Hayward, 20 *How.* 208; Allen *v.* Blunt, 1 *Blatchf.* 480; Day *v.* Newark India Rubber Manuf. Co., 1 *Blatchf.* 628. The decisions have settled that, under section 11, in order to give jurisdiction to a circuit court, the defendant must be an inhabitant of the district in which the suit is brought, or be found within that district at the time of service of original process. Day *v.* Newark India Rubber Manuf. Co., *supra.* The provision applies to a suit in equity brought under Rev. Stat. § 4915. Butterworth *v.* Hill, 114 *U. S.* 128.

For the jurisdiction of district courts over actions for penalties for false marking, see Rev. Stat. § 4901, *ante.*

185. *Their Jurisdiction does not embrace Suits to enforce Licenses.*

A suit, the real nature and object of which appears upon hearing to be to recover an additional license fee or royalty for the use of a patent under an agreement between a patentee and the defendant, and which does not involve the validity of the patent, is not within the jurisdiction of the circuit court as a suit under the patent laws, but can only be entertained there upon the ground of citizenship of the parties. The fact that the pleadings may aver facts sufficient to authorize taking cognizance of the suit, is not conclu-

sive; if it appears at the trial that no question arising under the patent laws is involved in the case, the suit must be dismissed. Blanchard *v.* Sprague, 1 *Cliff.* 288.

The subject-matter of an action to enforce or annul a license to use a patent right, is not within the jurisdiction of the courts of the United States; and is not brought within their jurisdiction by the fact that the controversy ultimately turns upon the validity of the patent; to give a circuit court jurisdiction of such a cause the plaintiff must aver himself and defendant to be citizens of different States. Merserole *v.* Union Paper Collar Co., 6 *Blatchf.* 356; 3 *Fish. Pat. Cas.* 483. S. P., Goodyear *v.* Union India Rubber Co., 4 *Blatchf.* 63. And see McKay *v.* Jackman, 17 *Fed. Rep'r*, 641; 24 *Pat. Off. Gaz.* 1177; 19 *Rep'r*, 163. Whether a suit be one by a licensor, to enforce the covenants contained in a license granted under a patent, or by a licensee, to destroy and annul a license and its covenants, the rule is the same; the suit is not within the jurisdiction of a circuit court. *Ib.*

The courts of the United States have no power under the patent laws to determine upon the fulfillment of a contract of license. Tilghman *v.* Hartell, 11 *Phila.* 500; 2 *Bann. & A. Pat. Cas* 260. See 99 *U. S.* 547.

Where a license provides that the patentee may terminate it by giving notice, and he does so, his suit to enjoin subsequent sales by the licensee is a suit for infringement, of which the circuit court has jurisdiction irrespective of citizenship of parties, rather than a suit to establish rights under the license. Smith *v.* Standard Laundry Machinery Co., 19 *Fed. Rep'r*, 825; 20 *Blatchf.* 360.

A license was granted under a patent, with covenants that the licensee should pay certain tariffs, keep correct accounts, and permit his books to be examined, but there was no express provision that if the covenants were broken, the rights granted should revert to the licensor; and a bill was filed by the licensor against the licensee, praying for a decree that the covenants should be performed, and for an injunction to prevent the use of the patent under the license, until the covenants should be performed; but the citizenship of the parties was not such as to give jurisdiction. It was *held*, that the suit was not one to prevent the violation of any right secured by any law of the United States, but was one to prevent the violation of the rights secured by the covenants; and therefore the court had no jurisiction of the case from the subject matter. Goodyear *v.* Union India Rubber Co., 4 *Blatchf.* 63.

B., a patentee, granted to S. the exclusive right to make and vend the invention during the life of the patent, for a royalty; and S. sued B. in the circuit court sitting in equity, alleging that he was infringing the patent. It was *held* that whether S. was a licensee or a grantor, he was suing B. on an infringement, and therefore the court had jurisdiction of the suit. Stanley Rule, &c. Co. *v.* Bailey, 14 *Blatchf.* 510; 3 *Bann. & A. Pat. Cas.* 297.

186. *Or other Contracts.*

The jurisdiction of courts of the United States in reference to patent rights, does not extend to protecting one who purchases a patented article for the purpose of using it in right of property. A purchaser of a patented article exercises no rights created by the acts of Congress, nor does he derive title by virtue of the franchise or privilege granted to the patentee. When the machine passes to the hands of the purchaser, it is no longer under the protection of Congress, but becomes private property, protected by the laws of the State where it is situated; and if the right to it is infringed, redress is to be sought in the courts of the State, according to the laws of the State, and not in the courts of the United States, nor under the laws of Congress. Bloomer *v.* McQuewan, 14 *How.* 539, 550; Chaffee *v.* Boston Belting Co., 22 *How.* 217.

A suit between citizens of the same State can not be sustained in the circuit court as arising under the patent laws of the United States, where the defendant admits the validity and his use of the plaintiff's letters patent, and a subsisting contract is shown, governing the rights of the parties in the use of the invention. Relief in such a suit is founded on the contract, and not on those laws. Hartell *v.* Tilghman, 99 *U. S.* 547.

The circuit court cannot take jurisdiction of a suit between citizens of the same State, brought to recover for violation of a contract, merely because the subject-matter of the contract is a patent right.* Goodyear *v.* Day, 1 *Blatchf.* 565. S. P., Hill *v.* Whitcomb, 5 *Pat. Off. Gaz.* 430; 1 *Holmes*, 317; 1 *Bann. & A. Pat. Cas.* 34; Ingalls *v.* Tice, 14 *Fed. Rep'r*, 552; 22 *Pat. Off.*

* Upon like grounds it has been *held* that a suit brought upon an agreement for the publication of a manuscript, to determine the rights of the parties under it, is not a suit under the copyright laws, of which the circuit court can take jurisdiction by reason of the subject matter. Pulte v. Derby, 5 McLean, 328.

Gaz. 2160; 14 *Rep'r*, 714; Nesmith *v.* Calvert, 1 *Woodb. & M.* 34; Burr *v.* Gregory, 2 *Paine*, 426; Brooks *v.* Stolley, 3 *McLean*, 523; 2 *West. L. J.* 396.

One who purchases a patented article for the purpose of using it, stands on different grounds from a purchaser of the right to make and sell it. In the former case, when the patented article rightfully passes from the patentee to the purchaser, the article is no longer within the limits of the monopoly, or under the protection of the patent act. Redress for injury in such a case must be sought in the State courts. Aiken *v.* Manchester Print Works, 2 *Cliff.* 435.

Where the controversy does not involve the validity of letters patent, but turns upon the effect and force of some contract under them, the State courts are the proper tribunals for the adjudication and the Federal courts cannot properly assert jurisdiction, unless the residence or citizenship of the parties confers it. Consolidated Fruit Jar Co. *v.* Whitney, 2 *Bann. & A. Pat. Cas.* 30.

An original patentee may, in selling rights by districts, prohibit each assignee from vending the article beyond his district. But, in such case, his remedy is on the contract, and not under the patent law. Boyd *v.* Brown, 3 *McLean*, 295.

187. *Jurisdiction of the Supreme Court of the District of Columbia.*

The powers and jurisdiction of the supreme court of the district in patent cases are the same (as well in equity as at law), as those of a circuit court. Cochrane *v.* Deener, 94 *U. S.* 780.

That the supreme court of the district has power to issue a mandamus, but whether the power is so broad as to embrace compelling the issue of a patent, see Secretary *v.* McGarrahan, 9 *Wall.* 298; United States *v.* Schurz, 102 *U. S.* 378, 393.

The supreme court of the District of Columbia, being charged with the special jurisdiction of appeals from the commissioner of patents, must decide on the merits, with the assistance of determinations upon the same subjects of the circuit and district courts of the United States; but the decrees of those courts will not be considered as *res judicata*. Schillinger *v.* Cranford, 2 *Cent. Rep'r*, 680.

For the appeals allowed to be taken by a party dissatisfied with

a decision of the commissioner, to the supreme court of the district, see *Rev. Stat.* §§ 4911–4914; *Id.* § 780; *ante.*

For the jurisdiction of a bill in equity, filed to procure issue of a patent which the commissioner has refused, see *Rev. Stat.* § 4915, *ante.*

188. *Jurisdiction of the Court of Claims.*

The court of claims cannot take jurisdiction of claims against government founded on mere torts (Milwaukee, &c. Canal Co. *v.* United States, 1 *Ct. of Cl.* 187; Spicer *v.* United States, *Id.* 316; Dennis *v.* United States, 2 *Ct. of Cl.* 210; Johnson *v.* United States, 2 *Ct. of Cl.* 391); and, therefore, cannot entertain a suit founded on an infringement considered as a tort merely; but may entertain a suit as founded on contract, where the circumstances under which the invention was used are such as warrant a finding of a promise, express or implied, to make compensation, or pay a license fee. See *ante*, 7.

189. *Appellate Jurisdiction of Supreme Court.*

The supreme court shall have appellate jurisdiction in the cases hereinafter specially provided for. *Rev. Stat.* § 690.

The right of appeal or error, without regard to value, given by *Rev. Stat.* § 699, in cases arising under the patent laws, applies to controversies between a patentee and alleged infringers, as well as to those between rival patentees (Philip *v.* Nock, 13 *Wall.* 185); but does not apply to controversies arising upon enforcement of contracts relative to patents. Brown *v.* Shannon, 20 *How.* 55.

190. *It is not Dependent on Amount in Controversy.*

A writ of error may be allowed to review any final judgment at law, and an appeal shall be allowed from any final decree in equity hereinafter mentioned, without regard to the sum or value in dispute:

First. Any final judgment at law or final decree in equity of any circuit court, or of any district court acting as a circuit court, or of the supreme court of the District of Columbia, or of any Territory, in any case touching patent rights or copyrights. *Rev. Stat.* § 699.

The supreme court has no appellate jurisdiction of a suit to enforce the specific performance of a contract in relation to a patent unless the value of the matter in controversy exceeds the jurisdictional amount; although it may exercise jurisdiction when a far less amount is in dispute, if the suit be for the infringement of a patent right. Brown *v.* Shannon, 20 *How.* 55.

191. *Exclusive Jurisdiction of Courts of the United States.*

The jurisdiction vested in the courts of the United States in the cases and proceedings hereinafter mentioned, shall be exclusive of the courts of the several States:

Fifth. Of all cases arising under the patent right or copyright laws of the United States. *Rev. Stat.* § 711.

State courts, although they may adjudicate on assignments and other contracts involving patent rights, have no jurisdiction to enjoin infringement of patent, even in a case depending on extent of the right which has been vested by an assignment. The jurisdiction of the United States courts is exclusive. Continental Store Service Co. *v.* Clark, 1 *Cent. Rep'r*, 530.

XV. RIGHT OF ACTION AT LAW FOR DAMAGES.

192. *Suits for Infringement; Damages.*

Damages for the infringement of any patent may be recovered by an action on the case, in the name of the party interested, either as patentee, assignee, or grantee. And whenever in any such action a verdict is rendered for the plaintiff, the court may enter judgment thereon for any sum above the amount found by the verdict as the actual damages sustained, according to the circumstances of the case, not exceeding three times the amount of such verdict, together with the costs. *Rev. Stat.* 4919.

193. *Limitation of Time for bringing an Action.*

While there is no act of Congress limiting the time for suing under the patent laws, the statute of limitations of the State in which the court is held, governs, so far at least as actions at law are concerned. The act of Congress of July 8, 1870, c. 230, § 55 (16 *Stat.* 206), prescribed a limitation of six years. But this statute is generally considered to have been repealed by the omission of it from the Revised Statutes. See Sayles *v.* Oregon Central R. R. Co., 6 *Sawyer*, 31; 3 *Rep'r*, 424; 4 *Bann. & A. Pat. Cas.* 429; Sayles *v.* Richmond, Fredericksburgh, &c. R. R. Co., 4 *Bann. & A. Pat. Cas.* 239; Sayles *v.* Oregon Central R. R. Co., 8 *Rep'r*, 424; Vaughn East Tennessee, Virginia, &c. R. R. Co., 11 *Pat. Off. Gaz.* 789; 1 *Flippin*, 621; 2 *Bann. & A. Pat. Cas.* 537; Hayden *v.* Oriental Mills, 15 *Rep'r*, 742; 24 *Pat. Off. Gaz.* 601; 17 *Fed. Rep'r*, 605; Rich *v.* Ricketts, 7 *Blatchf.* 230. But the decisions have been somewhat conflicting. See Hayward *v.* St. Louis, 11 *Fed. Rep'r*, 427; 3 *McCrary*, 614; Anthony *v.* Carroll, 9 *Pat. Off. Gaz.* 199; 2 *Bann. & A. Pat. Cas.* 195; Read *v.* Miller, 2 *Biss.* 12; 3 *Fish. Pat. Cas.* 310; Sayles *v.* Louisville City R. Co., 9 *Fed. Rep'r*, 512; Sayles *v.* Dubuque & Sioux City R. Co., *Id.* 516, *note*; 5 *Gill*, 561.

The above mentioned phrases of the question of the application of the statute of limitations have lost interest by lapse of time. The present question of importance is whether to consider the State statute as applying directly in the case of an action at law, and by an analogy to a suit in equity, to actions and suits now brought. The affirmative is held in Hayden *v.* Oriental Mills, 15 *Rep'r*, 742 ; 24 *Pat. Off. Gaz.* 601 ; 17 *Fed. Rep'r*, 605 ; Parker *v.* Hawk, 2 *Fish. Pat. Cas.* 58 ; Rich *v.* Ricketts, 7 *Blatchf.* 239 ; Sayles *v.* Louisville City R. Co., 9 *Fed. Rep'r*, 512 ; Sayles *v.* Dubuque & Sioux City R. Co., *Id.* 516, *note.* Contrary views have been expressed in Anthony *v.* Carroll, 2 *Bann. & A. Pat. Cas.* 195; 9 *Pat. Off. Gaz.* 199 ; Parker *v.* Hallock, 2 *Fish. Pat. Cas.* 543, *note ;* Wetherill *v.* New Jersey Zinc Co., 1 *Bann. & A. Pat. Cas.* 489 ; Collins *v.* Peebles, 2 *Fish. Pat. Cas.* 540. See Reed *v.* Miller, 2 *Biss.* 12 ; 3 *Fish. Pat. Cas.* 310.

194. *Nature of the Remedy by Action at Law.*

The sale of machines embodying the patented inventions of another, to one for use, is an invasion of the patentee's rights, and such a conversion of his property as will render the party so selling the invention liable in an action for tort ; though in such case, the plaintiff may waive the tort and sue in assumpsit for the money received from the sale. Steam Stone Cutter Co. *v.* Sheldons, 15 *Fed. Rep'r*, 608 ; 24 *Pat. Off. Gaz.* 703. In an action or proceeding for the money, the measure of damages would be the amount of money received, not the amount of damages done, and all right of recovery beyond that would be waived. This is the effect of waiving the tort. The recovery of satisfaction in either form would pass the right to that for which satisfaction was had, and there could be no damages beyond. Consequently, when the plaintiff has recovered and received satisfaction for the tort committed, the title to so much of his property as was wrongfully converted, will have passed by the sale and conversion, and no damages will accrue to him on account of further use of that property. *Ib.*

The infringement of a patent is a tort ; but the wrongful act not being committed with direct force, the form of action is that description of tort called trespass on the case. Stein *v.* Goddard, *McAll.* 82. A reiteration of infringements of a patent, like a

repetition of torts of any other kind, may be sued for in one action. Wilder *v.* McCormick, 2 *Blatchf.* 31.

The granting of a patent confers upon the patentee the right to bring suits thereon for its infringement, and a court is not authorized to grant an injunction to restrain him from so doing pending a suit to invalidate his patent, especially when such patent was granted after an interference. Asbestos Felting Co. *v.* United States, &c. Felting Co., 10 *Pat. Off. Gaz.* 828; 13 *Blatchf.* 453; 2 *Bann. & A. Pat. Cas.* 369

195. *Right of Action of Patentee.*

An action for an infringement cannot be maintained by an inventor before patent obtained. Gayler *v.* Wilder, 10 *How.* 477.

By the statute (act of 1836, § 14, last cl.), requiring an action for damages for infringement of a patent to be brought in the name of the person interested, the right of action is given to the person owning the patent at the time the infringement is committed; and a transfer of the exclusive right is no bar to an action to recover damages for an infringement committed before such transfer. Moore *v.* Marsh, 7 *Wall.* 515.

Where a patentee has a partner in the manufacture and sale of his patented article, such patentee is entitled to recover full damages for an infringement, notwithstanding such partnership. Yale Lock Manuf. Co. *v.* Sargent, 117 *U. S.* 536.

No person who is not the patentee or such an assignee or grantee as the statute points out can bring a suit for profits or infringement. And a claim to recover profits or damages for past infringement cannot be severed from the title by assignment or grant so as to give a right of action for such claim in disregard of the statute. The profits or damages for infringement cannot be sued for except on a basis of a title as patentee, or as such assignee, or grantee to the whole or a part of the patent; nor on the basis merely of an assignment of a right to a claim for profits and damages severed from such title. Gordon *v.* Anthony, 16 *Pat. Off. Gaz.* 1135.

An action for infringement must be brought in the name of the real and beneficial party in interest. Goldsmith *v.* American Paper Collar Co., 2 *Fed. Rep'r*, 239; 18 *Blatchf.* 82; 18 *Pat. Off. Gaz.* 192; 9 *Rep'r*, 640; 5 *Bann. & A. Pat. Cas.* 300.

A patentee is entitled to recover for a violation of his patent,

no matter what private agreement subsists between him and any other one, as to an interest in his invention, unless he has made a legal assignment and transfer of his interest in the invention. Park *v.* Little, 3 *Wash.* 196.

Two patents cannot support or supplement each other; and in a suit for infringement, the question is whether the defendant uses the combination shown in each patent, and not whether parts in each combination can be found in each patent. Blades *v.* Rand, McNally & Co., 27 *Fed. Rep'r*, 93.

A patentee whose rights are fully covered and protected by a suit he has brought against a manufacturer may, in a proper case, be enjoined from suing purchasers from the manufacturer. Birdsall *v.* Hagerstown Agricultural Implement Manuf. Co., 1 *Hughes*, 64.

A patentee who has sold the exclusive right to use his invention for a term of years short of the full life of the patent can maintain an action for an infringement during such term. The petition in such action, however, is demurrable, unless it affirmatively shows that the alleged infringer is not using the invention under the authority of the licensee. Still *v.* Reading, 9 *Fed. Rep'r*, 40; 4 *Woods*, 345; 20 *Pat. Off. Gaz.* 1025.

A patentee may reserve to himself the right to prosecute for piracies within the particular district where the right of use is conveyed. But if he afterward assigns all his right to such district, owner of the patent may sue. Bicknell *v.* Todd, 5 *McLean*, 236.

196. *Of Joint, or Deceased, Patentee.*

Upon the death of the patentee his interest passes to the personal representative in the State of the domicile of the patentee, and remains in him until assignment to the parties beneficially interested therein. In order that he may sue for an infringement it is not necessary that letters patent should be taken out in the State in which the suit is brought. Hodge *v.* North Missouri R. R., 1 *Dill.* 103; 34 *Fish. Pat. Cas.* 161.

A suit by one of two joint inventors to establish his right and interest as such in an improvement for which his fellow inventor has fraudulently taken out a patent alone, and to restrain him from using the patent except for their joint benefit, is within the juris-

diction of the circuit court irrespective of citizenship of parties. Duke *v.* Graham, 10 *Fed. Rep'r*, 647.

Actions may be maintained by joint owners of a patent, who have not transferred their claims for damages and profits, to recover past damages for infringement within the period of time of their ownership, though when the suit was instituted neither of the joint owners had any interest in the title to the patent. Spring *v.* Domestic Sewing Machine Co., 13 *Fed. Rep'r*, 446; 22 *Pat. Off. Gaz.* 1445; 29 *Int. Rev. Rec.* 22; 14 *Rep'r*, 711.

S. and W. conveyed to S. and B. all their right, title and interest in and to an invention, within the State of Massachusetts, except the right to build the patented machines. In a suit against one who had infringed by making the patented invention, it was *held*, that the suit was properly brought in the name of S. and W., without joining S. and B. Sanford *v.* Messer, 2 *Pat. Off. Gaz.* 470; 5 *Fish. Pat. Cas.* 411

197. *Of Assignee.*

The grantee of an exclusive right under a patent, though such right may be limited to the use of a certain number of machines within a certain territory or district, has such an exclusive right as will enable him to sue for an infringement of the patent within that district, under the act of 1836, § 14. Wilson *v.* Rousseau, 4 *How.* 646, 686; Nellis *v.* Pennoch Manuf. Co., 13 *Fed. Rep'r*, 451; 28 *Int. Rev. Rec.* 297; 22 *Pat. Off. Gaz.* 1131; 14 *Rep'r*, 260.

An assignor who retains an interest in a patent may be joined as a party complainant with an assignee of the exclusive interest in a certain territory in which such assignor has no interest, in a bill for an injunction to restrain the violation of the patent in that territory. Woodworth *v.* Wilson, 4 *How.* 712. Compare Railroad Co. *v.* Trimble, 10 *Wall.* 367; Brooks *v.* Bicknell, 3 *McLean*, 250; 1 *West. L. J.* 150; Whittemore *v.* Cutter, 1 *Gall.* 429.

To enable an assignee of a sectional interest in a patent to sue in his own name, he must have the exclusive right, or entire and unqualified monopoly which the patentee held in the territory specified, excluding the patentee as well as others. Gayler *v.* Wilder, 10 *How.* 477; Blanchard *v.* Eldridge, 1 *Wall. Jr.* 387. S. P., Littlefield *v.* Perry, 21 *Wall.* 205; Washburn *v.* Gould, 3 *Story*, 122; 1 *West. L. J.* 465; 7 *L. Rep'r*, 276.

In case of infringement subsequent to an assignment of an

undivided part of a patent, action must be brought in the joint names of the parties owning the entire interest. Per CLIFFORD, J. Moore *v.* Marsh, 7 *Wall.* 515.

Under the patent laws of the United States, an assignee of a patent must be regarded as acquiring his title to it with a right of action in his own name, only by force of the statute. Suydam *v.* Day, 2 *Blatchf.* 20.

An exclusive right of action exists in favor of a sole aasignee of a patent only in two cases: namely, where he acquires by assignment the whole interest in the patent; or, by a grant or conveyance, the whole interest within some particular district or territory. Suydam *v.* Day, 2 *Blatchf.* 20. And see Tyler *v.* Tuel, 6 *Cranch*, 324; Washburn *v.* Gould, 3 *Story*, 122; 1 *West. L. J.* 465; 7 *L. Rep'r*, 276.

An absolute assignment of a patent, for a valuable consideration, although limited to a specified territory, if it is, as to such district, unqualified, and excludes the patentee from any interest in or control over the rights secured by the letters patent, is a grant of the exclusive right under the patent to use and to grant to others to make and use the thing patented within and throughout a specified part of the United States, and warrants a suit in the name of the grantee or assignee for an infringement within the territory named. Perry *v.* Corning, 7 *Blatchf.* 195.

A grant of a right, though exclusive, to manufacture or sell under a patent within a limited territory, does not carry an interest in the patent such as will enable the grantee to maintain a suit for infringements, though committed within that territory. Ingalls *v.* Tice, 14 *Fed. Rep'r*, 297; 22 *Pat. Off. Gaz.* 2160; 13 *Rep'r*, 676.

The assignee of an exclusive right to use, but not to make the thing patented, within specified territory, may maintain an action against an infringer in his own name. Chambers *v.* Smith, 5 *Fish. Pat. Cas.* 12; 7 *Phila.* 575.

A declaration in a patent suit which avers an assignment of the invention before the issuing of the patent, and claims title under such an assignment, is not demurrable; such assignment being sufficient in law. Rathbone *v.* Orr, 5 *McLean*, 131.

Under the provision of Rev. Stat. § 4919, that damages for infringement may be recovered in the name of the party interested, an assignee of a patent whose assignment includes, in terms, all claims for prior infringements, may sue in his own name for all infringements, including those of date prior to the assignment to

him. Adams *v.* Bellaire Stamping Co., 25 *Fed. Rep'r*, 270; 33 *Pat. Off. Gaz.* 623.

The right to sue for infringements of a patent is assignable. It is not within the rule prohibiting assignments of unliquidated damages. Jenkins *v.* Greenwald, 1 *Bond*, 126; 2 *Fish. Pat. Cas.* 37; Hamilton *v.* Rollins, 4 *L. & Eq. Rep'r*, 561; 5 *Dill.* 495; 3 *Bann. & A. Pat. Cas.* 157.

The assignees of a patent, though their title accrues to them by several deeds, may all join, as the holders of the title, in an action for the recovery of damages for an infringement of the patent. Stein *v.* Goddard, *McAll.* 82.

Certain instruments,—*Held* not to amount to such an assignment by a patentee for a process patent, as to preclude him from suing third persons who infringe his patent. Downton *v.* Yaeger, Milling Co., 3 *McCrary*, 414.

Where a patent has been assigned for a particular territory, the assignor retaining the right to use in common with assignee in part of such territory, the assignee may sue alone for an infringement outside of the reserved territory. Hobbie *v.* Smith, 27 *Fed. Rep'r*, 656.

The claims for profits or damages arising from infringement prior to a purchase of the patent are choses in action, and the assignee takes the title subject to all the equities existing against the assignors. Such claims do not pass by a mere assignment of the patent. The assignee of a patent seeking to recover for infringements before the assignments must allege an assignment of the claims for past infringement. New York Grape Sugar Co. *v.* Buffalo Grape Sugar Co., 18 *Fed. Rep'r*, 638; 25 *Pat. Off. Gaz.* 1076; 21 *Blatchf.* 519.

The mere assignment of a patent would give the assignee no right to damages or profits already accrued; otherwise where the language of the assignment, or the circumstances attending it, show that the parties did not intend to transfer such already existing claims. Merriam *v.* Smith, 11 *Fed. Rep'r*, 588; Dibble *v.* Auger, 7 *Blatchf.* 86. See Consolidated O. W. P. Co. *v.* Eaton, 12 *Fed. Rep'r*, 865.

A suit may be maintained to recover past damages for infringement, although at the time when the suit was brought, the parties plaintiff had parted with their interest in the patent. Spring *v.* Domestic Sewing Mach. Co., 22 *Pat. Off. Gaz.* 1445; 13 *Fed. Rep'r*, 446; 29 *Int. Rev. Rec.* 22; 14 *Rep'r*, 711.

198. *Licensee.*

A licensee cannot, as such, sue for an infringement, but must assert his rights in the name of the original patentee. Paper Bag Cases, 105 *U. S.* 766; Grover & Baker Sewing Machine Co. *v.* Sloat, 2 *Fish. Pat. Cas.* 112.

A mere license to make and use, without the right to grant to others to make and use the thing patented, though exclusive, will not authorize the licensee to bring suit in his own name for infringement, without joining the patentee. Wilson *v.* Chickering, 14 *Fed. Rep'r*, 917; 23 *Pat. Off. Gaz.* 1730; North *v.* Kershaw, 4 *Blatchf.* 70; Bogart *v.* Hinds, 25 *Fed. Rep'r*, 484; 33 *Pat. Off. Gaz.* 1268. S. P., Cottle *v.* Krementz, 25 *Fed. Rep'r*, 494.

Where an exclusive license has been granted, the licensee and the patentee are both necessary parties to a suit for infringement. Hammond *v.* Hunt, 4 *Bann. & A. Pat. Cas.* 111.

An action at law, brought in the name of the patentee for the benefit of his licensee, cannot be discontinued by the nominal plaintiff; but the real parties in interest will be permitted to show their interest, in answer to a release by the nominal plaintiff. The nominal plaintiff may, however, claim indemnity against costs, and the court, on a proper application, will provide for it. Goodyear *v.* Bishop, 4 *Blatchf.* 438; 2 *Fish. Pat. Cas.* 96.

Where a license includes a large number of patents, and provides that the licensee shall pay a stipulated royalty on all machines manufactured by him "embodying in their construction or mode of operation the inventions and improvements shown and described in each, all or either of said letters patent," as long as the licensee uses either of the patents he will be liable to pay the stipulated royalty. Pope Manf. Co. *v.* Owsley, 27 *Fed. Rep'r*, 100.

Where a license to manufacture and sell under a patent is subject to revocation by written notice by the licensor, a postal card reading: "Your royalty return for February has not come to hand. Failure to forward same for five days from March 10th, subjects your license to revokement," is not notice in writing of the revocation or termination of the license. *Ib.*

A reservation of a right to sue for a royalty, *held* inconsistent with a license to use which accompanied a sale of the thing patented, by the patentee. Bigelow *v.* Louisville, 3 *Fish. Pat. Cas.* 602.

Money voluntarily paid under license for use of a patent cannot be recovered on subsequent determination of invalidity of patents. Schwarzenbach *v.* Odorless Excavating Co., 2 *Cent. Rep'r*, 859.

199. *Who may or should be Sued.*

Where a structure consisting ot several parts is patented as a combination, one who manufactures and sells some of the parts, they being useless without the residue, with the understanding and intent that such residue should be supplied by another and the whole go into use in its complete form, is liable as an infringer. Wallace *v.* Holmes, 9 *Blatchf.* 65 ; 1 *Pat. Off. Gaz.* 117. S. P., Craig *v.* Fisher, 2 *Sawyer*, 345; 5 *Pac. L. R.* 52.

One joint owner of a patent for a machine can use and sell machines made according to the patent, only in respect to his own right. If he uses or sells them without the authority of his co-owner as respects the right of the latter, he is liable to an action by such co owner for an infringement of the patent. In such action the plaintiff may recover his actual and proper damages, proportioned to the value and extent of his undivided interest, without regard to the amount which his co-proprietor has received by means of the infringement. Pitts *v.* Hall, 3 *Blatchf.* 201.

An agent selling an article which infringes on the plaintiff's patent may be joined as a party defendant with the one who manufactures such article, as they are joint trespassers, and are liable to be sued jointly. Buck *v.* Cobb, 1 *Brunner Col. Cas.* 550.

That the assignee of gains and profits assigned after the decree awarding them can recover them in his own name, see Campbell *v.* James, 5 *Bann. & A. Pat. Cas.* 630.

The use of a patented invention by an officer of the government, in the performance of his duties for the benefit of the government, may render him liable as an infringer. Campbell *v.* James, 17 *Blatchf.* 42 ; 18 *Pat. Off. Gaz.* 979 ; 4 *Bann. & A. Pat. Cas.* 456 ; 8 *Rep'r*, 455 ; reversed on another point, 104 *U. S.* 357.

Armor for a vessel was constructed by Q., under an order given for that purpose by the secretary of the navy, and was applied to a vessel built for the United States, and was paid for to Q. by the secretary of the navy. It was *held*, that although the armor might have been the same in arrangement as that covered by a patent for the application or employment of armor on vessels, Q.

was not liable in a suit on the patent for any value which the armor may have been to the United States. The putting of the armor on a vessel owned by the United States was not a making, or using, or a vending to be used, of the armor. Heaton *v.* Quintard, 7 *Blatchf.* 73.

A mere workman employed by a person other than the patentee to make parts of a patented article is not liable to an action for damages. Delano *v.* Scott, *Gilp.* 489.

Manufacturers of an article are not liable as infringers where the infringement consists in a special use of it made by one who procured it from them. Their privity with the unlawful use will not be presumed. Keystone Bridge Co. *v.* Phœnix Iron Co., 9 *Phila.* 374.

Action against administrator survives, if there has been an infringement; the latter being held as a trustee for the owner. Atterbury *v.* Gill, 2 *Hippin*, 239; 13 *Pat. Off. Gaz.* 276.

An action for infringement will lie against the parties making a machine which is patented, though such persons are employed by others to do the work. But if such parties have acted without a knowledge of the plaintiff's rights, only nominal damages should be found against them. Bryce *v.* Dorr, 3 *McLean*, 582.

A part owner of a patent has no right to use an infringing device. If he does, he is liable to his co-owner for the wrong done. Herring *v.* Gas Consumers' Assoc., 9 *Fed. Rep'r*, 556; 3 *McCrary*, 206; 21 *Pat. Off. Gaz.* 203.

Suit cannot be sustained against an administrator to charge the estate for his having undertaken to sell patented articles in violation of a patent right. He cannot charge the estate for a tort. Thompson *v.* Canterbury, 2 *McCrary*, 332; 12 *Fed. Rep'r*, 485.

One who is manufacturing and selling a patented article under a license from the patentee cannot be sued as an infringer; the only remedy which the patentee can claim against him is such as may be afforded by the contract of license. Kelly *v.* Porter, 17 *Fed. Rep'r*, 519; 8 *Sawyer*, 482.

In what case, and to what extent a landlord is liable for an infringement because the manufacture is carried on in his building and he receives a rent graduated by the amount of sales, see Starrett *v.* Athol Machine Co., 14 *Fed. Rep'r*, 910; 23 *Pat. Off. Gaz.* 1729.

One who sells a compound he knows cannot be applied without

making the user a trespasser, is accessory to the infringement. Albertine Co. *v.* Payne, 27 *Fed. Rep'r*, 559

200. *Cases involving Corporations.*

A town which had maintained a ferry in violation of an exclusive franchise granted to a corporation by the legislature of the State was *held*, liable for damages. East Hartford *v.* Hartford Bridge Co., 10 *How.* 541.

The only persons who can be held for damages for the infringement of a patent are those who own or have some interest in the business of making, using or selling the thing which is an infringement; an action at law cannot be maintained against the directors, shareholders or workmen of a corporation which infringes a patented improvement. United Nickel Co. *v.* Worthington, 13 *Fed. Rep'r*, 392; 23 *Pat. Off. Gaz.* 939.

The board of directors of a railroad company authorized their chairman to make a certain contract. Pursuant to that authority he made and signed in behalf of the corporation a contract with a manufacturer for the construction of a number of cars, to be delivered to the railroad company. The cars were to be furnished with a certain patented improvement, which the manufacturer had no license to use. In a suit by the patentee against the chairman for an infringement of the patent, it was *held*, that the contract of the chairman could not be construed as authorizing or contemplating any trespass upon the rights of the patentee, and that he was not liable. The fact that the cars were run on the road after completion gave no right of action against the chairman, as his authority extended only to the making of the contract. Lightner *v.* Brooks, 2 *Cliff.* 287.

A transportation company was organized for the purpose of providing a through line for freight between certain cities in the eastern and others in the western States; and contracted with the companies owning railroads between those cities, to furnish cars for use throughout the line. The defendant was the general agent of the transportation company, with power to contract for the carriage of goods, but without power to say in what cars they should be carried, or what axle-boxes should be used on the cars. Axle-boxes which infringed the plaintiff's patent were used on the cars in which the goods were so forwarded by the transportation com-

pany. It was *held*, that defendant was not liable to an action as an infringer of the plaintiff's patent. Lightner *v.* Kimball, 1 *Low.* 211. The defense of the agent in such a case is not that he is the servant of the transit company in doing the wrong, but that he is a stranger to the wrong done; that he has neither the property, the custody, nor the control of the cars in which this contrivance is used; that he can neither command the use nor the discontinuance of it; and that his duties have relation to an entirely distinct subject-matter. *Ib.*

An action may be maintained against a corporation for the infringment of a patent, upon proof of a wrongful manufacture by agents of the corporation with its approval and for its benefit. Corporations can act only by their agents. They can act only by those who are in their employ. And when one in the employment of a corporation, in the business of his employment, does an act for their benefit, and which they adopt and approve and take advantage of, they will be deemed to have authorized the act, and will be as much bound by it as though expressly authorized. Poppenhusen *v.* New York Gutta Percha Comb Co., 2 *Fish. Pat. Cas.* 62; 4 *Blatchf.* 184.

If a few persons form themselves into a corporation under the Missouri statute, the business of which is a necessary infringement of a patent, they cannot escape individual liability for the acts done in the corporate name. St. Louis Stamping Co. *v.* Quinby, 18 *Pat. Off. Gaz.* 571; 5 *Bann. & A. Pat. Cas.* 275.

One who was president and sole shareholder of a corporation, was *held*, under the circumstances, personally liable for an infringement committed in the course of the company's business. Smith *v.* Standard Laundry Machinery Co., 19 *Fed. Rep'r*, 826; 25 *Pat. Off. Gaz.* 393; 15 *Rep'r*, 74.

A corporation is responsible for the conduct of its superintendent in affixing the word "patented" to unpatented articles. Tompkins *v.* Butterfield, 25 *Fed. Rep'r*, 556.

A city is liable in its corporate capacity for the infringement of a patent. Munson *v.* New York, 5 *Fed. Rep'r*, 338; 18 *Blatchf.* 237; 10 *Rep'r*, 135; 5 *Bann. & A. Pat. Cas.* 486.

A city will be held responsible for infringements of patents by its fire department, though separately incorporated. Brickill v. New York, 7 *Fed. Rep'r*, 479; 18 *Blatchf.* 273; 18 *Pat. Off. Gaz.* 463.

The act of the legislature of New York, passed March 28, 1862

(Laws 1862, c. 63), has no effect to relieve the corporation of the city of Brooklyn from liability to pay the patentee of a patent for an improvement in hose-couplings used by it without his license. Bliss *v.* Brooklyn, 8 *Blatchf.* 533 ; 4 *Fish. Pat. Cas.* 596.

The city of Brooklyn is not liable to the patentee of a patented seat, for the use thereof in the public schools of the city, under the direction of the board of education, which purchased and owns the seats ; the corporation of the city not using them and having no power by law, to direct the discontinuance of their use. Allen *v.* Brooklyn, 8 *Blatchf.* 535 ; 4 *Fish. Pat. Cas.* 598.

The board of education of the city of New York purchased patented seats for use in public schools. It was *held*, that the city was liable in a suit for infringement, notwithstanding the board was an independent corporation created by the State government. Allen *v.* New York, 17 *Blatchf.* 350 ; 17 *Pat. Off. Gaz.* 1281 ; 5 *Bann. & A. Pat. Cas.* 57.

XVI. GROUNDS OF DEFENSE.

201. *Interest of the Public in Inventions and Patents.*

From the principle established by many decisions, that the application of an old process or machine to a similar or analogous subject, with no change in the manner of application and no result substantially distinct in its nature, will not sustain a patent, it follows that where the public has acquired in any way the right to use a machine or device for a particular purpose it has the right to use it for all the like purposes to which it can be applied; and no one can take out a patent to cover the application of the device to a similar purpose. Blake *v.* San Francisco, 113 *U. S.* 679.

A patentee is bound either to use his patent himself or permit others to do so on reasonable and equitable terms. Hoe *v.* Knap, 27 *Fed. Rep'r*, 204.

The public have an equity in patents which must always be regarded. Consolidated Fruit Jar Co. *v.* Bellaire Stamping Co., 27 *Fed. Rep'r*, 377.

One who invents, or discovers and keeps secret, a process of manufacture, has a property therein, which the courts will protect. Salomon *v.* Hertz, 2 *Cent. Rep'r*, 182.

202. *Fraud.*

A patentee brought a suit for damages against a British corporation on the following facts: The "managing agent" of the British corporation had been sent to this country and had fraudulently pretended, in a series of negotiations, to conclude an agreement with the plaintiff, to make use of his patent. The real purpose of the agent, as alleged by the plaintiff, had been, by means of protracted consultations and drafts of agreements, to prevent him (the plaintiff) from using his invention during a certain period, and thus gain time for his principal to introduce another invention in which it was largely interested. A charge that, if the corporation never gave any authority to its managing agent to assent to the draft of agreement in its behalf and in its name, and never sanctioned it as a corporate act, suit for such a fraud as above indicated could not be maintained, was *held* erroneous, upon the ground that the suit not being upon a contract, the corporation might be responsible for the fraud, notwithstanding its authority and sanction were never given. Butler *v.* Watkins, 13 *Wall.* 456.

In a case of alleged infringement, if the parties deal at arms-length, and the defendant is given his choice between a settlement on the terms offered by the complainant, and a law-suit with time sufficient for reflection and investigation, the fact that the defendant feared the result of litigation on his business, and therefore settled, is not sufficient to support the charge of fraud. Pope Manuf. Co. *v.* Owsley, 27 *Fed. Rep'r*, 100. The mere fact that the owner of a patent alleges an infringement, and threatens suit unless a settlement is made with him, cannot be held to make such settlement void for fraud or intimidation. *Ib.*

Where a patentee claims an infringement, the fact that at the time of making a settlement of the claim for past manufacturing and sale, and granting a license, the patent had expired, though in force when negotiations were begun, does not render the transaction fraudulent. *Ib.*

A party who has owned the recorded title of a patent for more than six months, may, for a valuable consideration, convey the

same to a corporation competent to purchase and hold it; and t title thus conveyed will not be open to attack for fraud in t assignor. Racine Seeder Co. *v.* Joliet Wire-Check Row Co., ' *Fed. Rep'r*, 367.

203. *Estoppel.*

Declarations on the part of an inventor that he intended not to take out a patent, but to let the public have his invention, will estop such party, or any one holding under him, from asserting his right against a person acting on the faith of such declarations. Pitts *v.* Hall, 2 *Blatchf.* 229.

A mechanic, working at his employment for wages, who permits his employer to apply for and obtain a patent without objection, upon a machine which the mechanic has perfected, will be deemed to have waived any rights he may have had as a prior inventor. Fraim *v.* Keen, 25 *Fed. Rep'r*, 820; 34 *Pat. Off. Gaz.* 1048. S. P., Ruggles *v.* Young, 1 *MacArthur Pat. Cas.* 160; Warner *v.* Goodyear, 1 *MacArthur Pat. Cas.* 60; McCormick *v.* Howard, *Id.* 238.

A disclaimer at the close of a specification estops the patentee from setting up any privilege to the part disclaimed. Whitney *v.* Emmett, *Baldw.* 303.

A disclaimer made by an attorney in the prosecution of an application for a patent, does not necessarily estop the patentee from maintaining that his claim embraces the matter so referred to. Mann *v.* Bayliss, 10 *Pat. Off. Gaz.* 789.

A patentee is not estopped by his silence in omitting to assert his claim to an invention, unless it has misled another to his hurt. Railroad Co. *v.* Dubois, 12 *Wall.* 47.

A certified copy of the model does not conclude the defendant, but he may show that the model has been changed. Johnson *v.* Beard, 8 *Pat. Off. Gaz.* 435; 2 *Bann. & A. Pat. Cas.* 50.

A patentee can not repudiate one of the parts of his combination after another inventor has taught him how to dispense with it. Hale *v.* Stimpson, 2 *Fish. Pat. Cas.* 565; Cooledge *v.* McCone, 2 *Sawyer*, 571; 5 *Pat. Off. Gaz.* 458; 1 *Am. L. T. N. S.* 214; 1 *Bann. & A. Pat. Cas.* 78.

Where one has advertised a patented article as one of the most useful of inventions, and one which has superseded all other similar articles; and has also sold such article for use; such person is

estopped, in an action against him for an infringement, from denying the utility of the invention. Stanely *v.* Whipple, 2 *McLean*, 35, 39.

In a suit for infringement of a patent, against a purchaser from a licensee, in which the complainant treats the license as no longer in force, the defendant is not estopped from denying the validity of the patent. Baltimore Car Wheel Co. *v.* North Baltimore Passenger R. Co., 21 *Fed. Rep'r*, 47.

Estoppel of patentee, as against assignee of patent, to allege its invalidity in suit for infringement. Rumsey *v.* Buck, 20 *Fed. Rep'r*, 697; Underwood *v.* Warren, 21 *Fed. Rep'r*, 573.

A licensee under a patent is not estopped to deny its validity, when he has not done or claimed anything under it, and the licensor has had knowledge of his position. Brown *v.* Lapham, 27 *Fed. Rep'r*, 77. He is estopped to deny its validity on any question arising out of that relation between the parties (*Ib.*), so long as the license remains in force. Pope Manuf. Co. *v.* Owsley, 27 *Fed. Rep'r*, 100.

A licensee who agrees not to contest the validity of the patent or the title of the licensor thereby admits the validity of the patent, and waives all questions of limiting or escaping the claims by the prior art; the only question being whether the machines made are within the terms of the patent. The date and duration of a patent are matters of public record which the licensee is as much bound to know as the licensor. *Ib.*

Where it is claimed that a patentee has estopped himself to deny that his American patent was for the same invention as was patented to him in prior foreign patents, by representing that it was for the same, in his application, if the patentee was laboring under a mistake as to this point, his rights ought not to be defeated, or seriously abridged by such mistake. Commercial Manuf. Co. *v.* Fairbank Canning Co., 27 *Fed. Rep'r*, 78.

A decree dismissing a former bill for failure to show infringement, does not estop the plaintiff, or his assignees, from suing the same defendant for infringing the same patent. Steam-Guage & Lantern Co. *v.* Meyrose, 27 *Fed. Rep'r*, 213.

The equitable doctrine of estoppel is applied to a patentee who, after unreasonable delay, applies for an amendment and enlargement of his claim. Asmus *v.* Alden, 27 *Fed. Rep'r*, 684.

Where the terms of a claim in a patent are clear and distinct, the patentee, in a suit brought upon the patent, is bound by it, and

cannot show that his invention is broader than the terms of his claim; or, if the invention is broader, he must be held to have surrendered the surplus to the public. Blades *v.* Rand, McNally & Co., 27 *Fed. Rep'r*, 93.

Where a patentee, in the first instance, made broad claims, which were denied, it was *held* that by accepting a patent for a restricted claim, he abandoned his claim by construction, so far as what was in terms refused him was concerned; and that his action became part of the law of the patent, and controlled the assignee as well as the original patentee. Blades *v.* Rand, McNally & Co., 27 *Fed. Rep'r*, 93; Otis Bros. *v.* Crane Bros. Manuf. Co., 27 *Fed. Rep'r*, 550; Roener *v.* Peddie, 27 *Fed. Rep'r*, 702.

The inventor of a certain mechanism assigned the invention to a manufacturing company of which he was superintendent, by which it was patented; and he caused mechanism to be made by the company, representing it to be one of the modifications of the invention patented; for the construction of which the company had special tools made, and which it introduced to the public as covered by the patent. It was *held*, after he had left the company, that he and all in privity with him, were estopped from denying that the mechanism so constructed was covered by the patent; and that, as to him and them, an injunction against its reproduction should issue. Time Telegraph Co. *v.* Himmer, 19 *Fed. Rep'r*, 322.

Patent was issued to Armstrong and Hutchinson, in 1875, for an improvement in machines for finishing horse-shoe nails. It was *held* to be shown by a preponderance of evidence in a suit for infringement, to have been obtained by them for devices invented and put in use by them while they were in the employ of the defendant under such terms as to preclude them from making any claims against the defendant for such devices. Bensley *v.* Northwestern Horse Nail Co., 26 *Fed. Rep'r*, 250.

A patentee of an improvement consisting in securing a loose case or jacket around a hydrant, in such manner that the hydrant might be withdrawn without disturbing the case, was *held* not estopped by procuring a patent therefor, from patenting a further improvement, consisting in so connecting the case with the hydrant that the upheaval of the case a few inches by the frost would not injure or break the hydrant. Mathews *v.* Flower, 25 *Fed. Rep'r*, 830; 33 *Pat. Off. Gaz.* 887.

A patent for the change of old parts of a combination to effect efficient co-operation must be limited to the express improvement

made. Troy Laundry Machinery Co. *v.* Bunnell, 27 *Fed. Rep'r*, 810.

The holder of a patent for a combination of devices for a sliding door for railroad cars, claiming as part of the combination guiding rods and staples, and expressly disclaiming the use of grooves as an equivalent, is estopped from insisting, to establish an alleged infringement, that the grooves are equivalent to the rods, or that the rods and staples are not essential to his combination. Watson *v.* Cincinnati, I. &c. R. Co., 23 *Fed. Rep'r*, 443.

204. *Former Adjudication.*

A former verdict, or dismissal of a bill filed for an injunction to restrain the use of a patented invention, is not a bar to a subsequent action at law for damages, in another State, unless a judgment was rendered on such verdict against the plaintiff, or the dismissal was on the merits. Allen *v.* Blunt, 2 *Woodb. & M.* 121, 132.

The defendant in a suit at law for infringement agreed with the plaintiff, for a valuable consideration, to discontinue the manufacture of the infringing article; and subsequently suffered interlocutory judgment to be entered against himself by default. Afterward he continued to make and sell an article differing but slightly from the former, and a clear infringement of the one patented. A bill in equity having been brought to restrain the unlicensed manufacture, and it appearing that the defenses set up in the answer were within the defendant's knowledge at the time of the action at law, it was *held*, that he was concluded by the agreement of compromise; and should not be permitted to contest the validity of the patent. Brooks *v.* Moorhouse, 13 *Pat. Off. Gaz.* 499; 3 *Bann. & A. Pat. Cas.* 229.

A verdict sustaining a patent, and judgment thereon, in an action between an owner of a territorial right under such patent and an infringer is not admissible in evidence in an action brought by another owner of another territorial right under the same patent for the purpose of establishing his right; but would be admissible on a notice for a provisional injunction, as affording strong evidence of the validity of the patent and of the title. Buck *v.* Hermance, 1 *Blatchf.* 322; 1 *L. Rep'r, N. S.* 321.

A patentee and his assignee brought a suit in equity, in the

circuit court of Louisiana, against a junior patentee, seeking to have the junior patent declared void for interference with their patent. The bill was dismissed on the merits. Subsequently the same plaintiffs brought an action at law, in another circuit for infringement of their patent, against a person who had not been a party to the record in the suit in Louisiana, but who had obtained an interest in the junior patent, after the commencement of the Louisiana suit, and before the judgment of dismissal. It was *held*, that the rights of the parties to the action at law would have been bound by a judgment in the Louisiana suit declaring either patent void; but that the judgment of dismissal did not import the invalidity of the senior patent, and could not be pleaded in bar of the action at law. To constitute such a judgment a bar to such subsequent action, it should have been direct and affirmative in its terms, and have asserted the interference of the patents, and have declared the patent void in whole or in part, or inoperative and invalid in some part of the United States. Tyler *v.* Hyde, 2 *Blatchf.* 308.

The validity of a patent having been in part sustained in one circuit, suit was brought in another circuit for infringement by a party who had contributed to the payment of the counsel who had defended the first suit. The defendant was *held* estopped by the adjudication in the other circuit, and that the proper practice to introduce new evidence as to prior use, would be to move for a rehearing in the other circuit. Miller *v.* Liggett, &c. Tobacco Co., 7 *Fed. Rep'r*, 91; 2 *McCrary*, 375; 27 *Int. Rev. Rec.* 295; 19 *Pat. Off. Gaz.* 1138.

A judgment recovered in a prior action, was *held*, under the circumstances, not to preclude impeaching the patent in a subsequent suit. Russell *v.* Place, 94 *U. S.* 606.

An adjudication against the defendant in a suit for infringement of a patent binds his servants or agents only through their relation to their employer or principal, and they are not thereby precluded from setting up any defense to a new suit against them for an alleged new infringement by them acting in their own right. Hayes *v.* Bickelhoupt, 24 *Fed. Rep'r*, 806; 32 *Pat. Off. Gaz.* 136.

In an action at law, by patentees, for damages for the use of machines covered by their patent, an answer which sets up the recovery by the plaintiffs against a third person of a decree in equity for an accounting of profits in manufacturing and selling such machines in infringement of the patent; an accounting had

a certain sum awarded to them as such profits; and that the machines for the use of which the action at law is brought were purchased by defendant from such third person, and the profits of their manufacture and sale included in such decree, but which does not allege that such decree has been satisfied by payment or otherwise, or that the accounting included the machines in question, does not state a defense. Fisher *v.* Consolidated Amador Mine, &c., 25 *Fed. Rep'r*, 201.

Where a licensee accepts a license agreeing not to contest the licensor's title or the validity of the patent, a subsequent decision of a court declaring the patent void will not affect the license. Pope Manuf. Co. *v.* Owsley, 27 *Fed. Rep.* 100.

The rule that parties directly interested in the subject-matter of a suit and a right to make a defense, are concluded by the judgment therein is applied in patent cases. American Bell Telephone Co. *v.* National Improved Telephone Co., 27 *Fed. Rep'r*, 633.

205. *That the Device Patented does not Involve Invention.*

"Invention," in the sense of the patent law, means finding out, contriving or creating, by intellectual act, something which did not previously exist. Conover *v.* Roach, 4 *Fish. Pat. Cas.* 12. The word implies exercise of genius, and production of a new idea. New York Belting & Packing Co. *v.* Magowan, 27 *Fed. Rep'r*, 362. See also, pages 36, 37, *ante.*

There may be invention in the adaptation of an old article to a new purpose, producing a useful result. Yale Lock Manuf. Co. *v.* Norwich Nat. Bank, 19 *Blatchf.* 123; 6 *Fed. Rep'r*, 377; Washing Machine Co. *v.* Lincoln, 4 *Fish. Pat. Cas.* 379. But merely bringing old devices into such juxtaposition as will allow each to work out its own effect, but without causing either to contribute any new function or mode of operation, is not invention. Troy Laundry Machinery Co. *v.* Bunnell, 27 *Fed. Rep'r*, 810.

The mere selection, for a particular purpose, from materials known to possess the proper qualities, of materials specially adapted to that purpose—as a choice of steel, or case-hardened iron, for combination with softer metal, in gun-cartridges—is not invention. *Re* Maynard, 1 *MacArthur Pat. Cas.* 536. S. P., Putnam *v.* Yerrington, 2 *Bann. & A. Pat. Cas.* 237; 9 *Pat. Off. Gaz.* 689. And

so, of the substitution of a more appropriate or economical material for one previously in use. New York Bung, &c. Co. *v.* Doelger, 23 *Fed. Rep'r*, 191 ; 32 *Pat. Off. Gaz.* 651 ; Hotchkiss *v.* Greenwood, 11 *How.* 248. But the substitution of one material for another may involve contrivance or ingenuity ; may involve a new mode of construction, or result in developing new properties or uses ; and where this is the case, the rule that there must be exercise of invention is satisfied, and the process or result is patentable. Hicks *v.* Kelsey, 18 *Wall.* 673 ; Smith *v.* Goodyear Dental Vulcanite Co., 93 *U. S.* 486 ; aff'g 1 *Holmes*, 354; Goodyear Dental Vulcanite Co. *v.* Root, 1 *Bann. & A. Pat. Cas.* 384; 6 *Pat. Off. Gaz.* 154 ; Goodyear Dental Vulcanite Co. *v.* Willis, 1 *Flippin*, 385 ; 1 *Bann. & A. Pat. Cas.* 568 ; 7 *Pat. Off. Gaz.* 41 ; Putnam *v.* Weatherbee, 1 *Holmes*, 497 ; 2 *Bann. & A. Pat. Cas.* 78 ; 8 *Pat. Off. Gaz.* 320 ; Dalton *v.* Nelson, 13 *Blatchf.* 357 ; 2 *Bann. & A. Pat. Cas.* 225 ; 9 *Pat. Off. Gaz.* 1112 ; United States Stamping Co. *v.* King, 17 *Blatchf.* 55 ; 4 *Bann. & A. Pat. Cas.* 469 ; 7 *Fed. Rep'r*, 860 ; 17 *Pat. Off. Gaz.* 1399.

206. *But only Mechanical Skill.*

To sustain a patent, the device must involve exercise of the inventive faculties; that it is merely new, or useful, or shows mechanical skill, is not enough. Thompson *v.* Boisselier, 114 *U. S.* 1, 29 ; Yale Lock Manuf. Co. *v.* Greenleaf, 117 *U. S.* 554 ; Brown *v.* Guild, 23 *Wall.* 181 ; 6 *Pat. Off. Gaz.* 731 ; Celluloid Manuf. Co. *v.* Comstock & Cheney Co., 27 *Fed. Rep'r*, 358 ; May *v.* Fond du Lac County, 27 *Fed. Rep'r*, 691. See Hill *v.* Biddle, *Id.* 560.

A change in an old device, producing a new and useful result, in which invention is involved, is patentable. Sewing Machine Co. *v.* Frame, 24 *Fed. Rep'r*, 596 ; 28 *Pat. Off. Gaz.* 96. S. P., Reed *v.* Street, 34 *Pat. Off. Gaz.* 339.

A patent for a combination is not necessarily invalid because all the parts are old; yet merely assembling them together, or placing them in juxtaposition does not indicate invention ; but some new or peculiar function, produced by such a combination, must be developed, or the new arrangement is the mere exhibition of mechanical skill (Scott Manuf. Co. *v.* Sayre, 26 *Fed. Rep'r*, 153); and a device which does not involve invention, but mechanical skill simply, is not patentable. Butler *v.* Steckel, 27 *Fed. Rep'r*,

219; Calkins *v.* Oskosh Carriage Co., *Id.* 296. Though new and useful, an invention, to be patentable, must be the result of something more, and different from, mechanical skill. Celluloid Manuf. Co. *v.* Comstock & Cheney Co., 27 *Fed. Rep'r*, 358.

Mere mechanical skill applied to an old idea, modifying it and making it more practical, is not patentable unless some new and useful result is obtained. New York Belting & Packing Co. *v.* Magowan, 27 *Fed. Rep'r*, 362.

207. *Novelty in the Invention, Lacking*

It is a valid defense to a suit for infringement (as well as a sound objection to the original application for a patent), to show that the device for which the patent has been granted was not new. Novelty is essential; the patent law requires a thing to be new as well as useful, in order to entitle it to protection by patent. Stanley Works *v.* Sargent, 8 *Blatchf.* 344; 4 *Fish. Pat. Cas.* 443. If there is nothing new in the process, or the machinery for applying it, the result is not patentable. Collar Co. *v.* Van Deusen, 23 *Wall.* 530; 5 *Pat. Off. Gaz.* 910; aff'g 5 *Fish. Pat. Cas.* 597; 10 *Blatchf.* 109; 2 *Pat. Off. Gaz.* 361. Novelty and utility combined determine patentability. Celluloid Manuf. Co. *v.* Comstock & Cheney Co., 27 *Fed. Rep'r*, 358. See also *ante*, p. 55.

Novelty is variously defined; but the cases agree that the substance or article need not have been non-existent, prior to the invention patented; the inventor's right is secured if his ingenuity, method, or device has given the thing new properties, brought it into uses before impracticable, imparted to it a new value, invested it with a new mode of operation, made it substantially better or cheaper, or the like. Glue Co. *v.* Upton, 97 *U. S.* 3; aff'g 4 *Cliff.* 237; 1 *Bann. & A. Pat. Cas.* 497; 6 *Pat. Off. Gaz.* 837; Salt Manuf. Co. *v.* Thomas, 3 *Leg. Gaz.* 316; 1 *Leg. Gaz. Rep.* 275; Furbush *v.* Cook, 2 *Fish. Pat. Cas.* 668; Strong *v.* Noble, 3 *Id.* 586; 6 *Blatchf.* 477.

Novelty in the result or effect only, is not, in general, sufficient; there must be evidence that the effect is produced by some new process, device, contrivance, mode, manner, or means, or by some new machinery; for a patent cannot be granted for an effect only. Where, however, such a result is shown, slight evidence only of the existence of novelty and invention will suffice. Yearsley *v.* Brookfield, 1 *MacArthur Pat. Cas.* 193.

Where the principle of an alleged invention has been previously discovered and applied, although there may be in the new application some degree of novelty, and something may have been discovered or found out that was not known before, it is not patentable unless the new occasion on which the principle is applied, leads to some kind of new manufacture, or to some new result. *Re* Blandy, 1 *MacArthur Pat. Cas.* 552.

Although a mere analogous use is not patentable, yet where a new or improved manufacture is produced by new contrivances, combinations or arrangements, a new principle may be constituted, and the application or practice of old things will of course be new also in the result. The usual test is whether the production of the article is as good in quality at a cheaper rate, or better in quality at the same rate, or with both these consequences partly combined; and so is the like principle in mechanism. That a combination appears to be simple, and the invention not very great, is not sufficient objection if the invention be not frivolous and foolish. *Re* Smith, 1 *MacArthur Pat. Cas.* 255.

In order to constitute patentable novelty and utility, it must appear that, in a *new process* of manufacture, the result produced was an improvement in the trade, and for the public good or advantage, by the manufacture either of a new or better article, or one cheaper to the public than that produced by the old method. Jones *v.* Wetherill, 1 *MacArthur Pat. Cas.* 409.

In the case of combinations, the fact that one or more of the elements of which it is formed have been used before for other purposes, is not such want of novelty as will defeat an application for a patent; if the combination is substantially new, the invention of the combination is patentable. *Re* Watson, 1 *MacArthur Pat. Cas.* 510. See Brown *v.* Whittemore, 5 *Fish. Pat. Cas.* 524; 2 *Pat. Off. Gaz.* 248.

If the article or result patented can be produced without the aid of the description given in the patent, there is lack of novelty Lockwood *v.* Faber, 27 *Fed. Rep'r*, 63.

208. *Utility Lacking.*

Although a mere change of form or proportion is not a patentable invention, if by such a change a new effect is produced, and proof of its practical utility is given, it may be patentable. *Re* Fultz, 1 *MacArthur Pat. Cas.* 178.

The question of utility pertains chiefly to the examination of the application before the commissioner; it can seldom be raised with good effect as a defense to a suit for infringement, for the courts will not usually revise the decision of the patent-office as to utility (Doherty *v.* Haynes, 4 *Cliff.* 291; 6 *Pat. Off. Gaz.* 118; 1 *Bann. & A. Pat. Cas.* 289), but are inclined to treat the fact that defendant thought worth his while to appropriate plaintiff's invention as sufficient proof that it was a useful one. See *ante*, p. 56; Hobbie *v.* Smith, 27 *Fed. Rep'r*, 656.

In order to sustain a patent as well as to obtain one, the machine, device, improvement, combination or other thing for which it has been granted must appear to be useful, as well as new. But a high degree of utility is not required; nor is utility the sole test of patentability. Stanley Works *v.* Sargent, 8 *Blatchf.* 344; 4 *Fish. Pat. Cas.* 443. If an invention produces either a new result which is useful, or an old result more cheaply or advantageously, than was formerly practicable, it is "useful." Niles Tool Works *v.* Betts Machine Co., 27 *Fed. Rep'r*, 301; Hobbie *v.* Smith, 27 *Ib.* 656.

A change in the construction and mode of operation of a mechanical device, although but slight, may be patentable, where the consequences of the change are considerable, resulting in a very great saving of expense. *Re* Walsh, 1 *MacArthur Pat. Cas.* 530. But see *Re* Littlefield, *Id.* 574.

209. *Typical Cases illustrating Application of the Rules requiring Invention, Novelty, Utility, &c.*

The decisions are very numerous which, without establishing any new principles of the law of patents, determine the application of the principles presented in the last three sections to particular inventions. *The following are the more instructive examples of* THINGS NOT PATENTABLE *which have been adjudged so for want of invention, novelty, utility, or for like objections.*

A combination of machinery used to form lead pipes in a new way; such machinery in principle being the same as that commonly employed to make maccaroni, and clay pipes. Le Roy *v.* Tatham, 14 *How.* 156.

A wagon-reach made of iron instead of wood as formerly used. Hicks *v.* Kelsy, 18 *Wall.* 670.

A combination which consists only of the application of a piece

of rubber to one end of the piece of wood which makes a lead pencil. Rubber Tip Pencil Co *v.* Howard, 20 *Wall.* 498 ; aff'g 5 *Fish. Pat. Cas.* 377 ; 9 *Blatchf.* 490 ; Reckendorfer *v.* Faber, 92 *U. S.* 347 ; aff'g 12 *Blatchf.* 68 ; 1 *Bann. & A. Pat. Cas.* 229.

A claim of a woven elastic fabric, differing from those previously used only in being more tightly woven, and more elastic by reason of a greater proportion of elastic strands. Smith *v.* Nichols, 21 *Wall.* 112.

A product consisting merely of a metallic ring envelope in a composition of ivory or similar material,—being an improved form of rings for martingales. Rubber-Coat Harness Trimming Co. *v.* Welling, 97 *U. S.* 7.

The grinding or powdering an article of commerce,—in this instance glue,—to render it easier of handling, and more readily dissolved for use. Glue Co. *v.* Upton, 97 *U. S.* 3 ; aff'g 4 *Cliff.* 237 ; 6 *Pat. Off. Gaz.* 837 ; 1 *Bann. & A. Pat. Cas.* 497.

The use of wedge-shaped blocks in making a pavement ; that being the principle long since applied in laying cobble-stone pavements ; also the mere exercise of judgment as to the amount of force or degree of force to be used in ramming or swaging. Stow *v.* Chicago, 8 *Biss.* 47 ; 8 *Bann. & A. Pat. Cas.* 83 ; aff'd, 104 *U. S.* 547.

A contrivance consisting merely in putting an additional pane of glass in a fare-box in a street car, opposite the side next the driver, so that the passengers can see the interior of the box through it ; for this requires no more invention than the placing of an additional pane of glass in a show-case, or the putting of an additional window in a room. Slawson *v.* Grand Street R. R. Co., 107 *U. S.* 649.

The use in succession of two distinct pairs of dies, of well-known kinds, not combined in one machine, nor co-operating to one result, but each pair doing by itself its own work. Beecher Manuf. Co. *v.* Atwater Manuf. Co., 114 *U. S.* 523.

A combined hose-carriage and fountain-standard, consisting in the combination of "a wheeled carriage provided with a foot or brace to sustain it in an upright vertical position, a nozzle-holding device, and a reel of large diameter to allow water to flow through the hose when partially wound there ;" the proof showing that a fountain-standard and hose-reel, similarly mounted, had been previously used in combination. Preston *v.* Manard, 116 *U. S.* 661

The making of a part of an old manufacture as a separate article of trade. Seligman *v.* Day, 14 *Blatchf.* 72; 2 *Bann. & A. Pat. Cas.* 467.

A paper bag made with a notch cut with jagged or serrated edges with a view to facilitate the opening of the mouth, instead of with smooth edges as previously used. Matter of Arkell, 15 *Blatchf.* 437.

An improvement in distributors for copy for compositors, which, instead of the device previously in use, of a series of hooks lettered to correspond with letters systematically placed upon the leaves of copy, also marked upon the type, employed a galley holder with compartments for galleys permanently lettered to correspond with the lettering on the hooks. Brainard *v.* Evening Post Assoc., 22 *Blatchf.* 61.

An improvement in the application of palm-leaf to stuffing beds, &c., which same process had been used in preparing hair for like uses, so that there was no invention of any new process. Howe *v.* Abbott, 2 *Story*, 190.

An improvement consisting only in a change in the manner of attaching several knives, instead of one, on a cylinder by screws, instead of attaching it to the cylinder by rings at the end. Hovey *v.* Stevens, 1 *Woodb. & M.* 290.

An improvement in the known mode of making car-wheels by placing a heated tire of cast steel in a mould, and then pouring in molten cast iron at the center of the mould, thus producing a weld or union between the iron and the steel; which consisted merely in introducing the molten iron through a series of openings or "sprues" just inside the heated rim or tire. Needham *v.* Washburn, 4 *Cliff.* 254; 7 *Pat. Off. Gaz.* 649; 1 *Bann. & A. Pat. Cas.* 537.

An improvement in locks and door-fastenings, consisting in making them double-faced, so that the same lock or fastening may be used for a right or left-hand door; locks that might be applied in the same way, though not used or made for that precise purpose, being in public use. Livingston *v.* Livingston, 1 *Fish. Pat. Cas.* 521.

Where the patentee of an improvement in chewing-gum took the crude chickly of commerce, washed it in hot water to remove the coloring matter and impurities, and claimed the product as a new invention; but there was proof that the same process had long been used for washing and purifying India rubber and gutta-percha,

which are products of the same vegetable family as chickly. Adams *v.* Loft, 8 *Rep'r*, 612 ; 4 *Bann. & A. Pat. Cas.* 495.

The preparing and cutting up meat, and putting it in a can which is then hermetically sealed ; and the construction of the can of a particular form. Wilson Packing Co. *v.* Clapp, 8 *Rep'r*, 262 ; 8 *Biss.* 545 ; 4 *Bann. & A. Pat. Cas.* 355.

A method by which hair is put in small packages and compressed into convenient shape for sale to plasterers, so that the compressed bale may be separated into convenient smaller packages as desired. King *v.* Frostel, 8 *Rep'r*, 490 ; 8 *Biss.* 510 ; 4 *Bann. & A. Pat. Cas.* 236.

The mere change of the form of a die so as to change the form of that which was manipulated under the die. Smith *v.* American Bridge Co., 8 *Biss.* 312 ; 3 *Bann. & A. Pat. Cas.* 565.

The mere change of the spaces of lines embossed on paper so that they might be used for writing. Cone *v.* Morgan Envelope Co., 4 *Bann. & A. Pat. Cas.* 107.

Merely attaching prongs to a disk to serve the same purpose as the disk. Lorillard *v.* Ridgway, 4 *Bann. & A. Pat. Cas.* 564 ; 16 *Pat. Off. Gaz.* 1231.

A lady's hair-net made of coarse threads interspersed with fine threads, instead of fine threads alone, as already in use. Dalton *v.* Jennings, 5 *Pat. Off. Gaz.* 615.

A patent for apparatus in which the acid and alkaline solutions for forming carbonic acid gas were kept separate until required to extinguish a fire, when they could be readily mingled ; it appearing that similar apparatus had been employed in soda-fountains for the supply of beverages. Northwestern Fire Extinguisher Co. *v.* Philadelphia Fire Extinguisher Co., 6 *Pat. Off. Gaz.* 34 ; 10 *Phila.* 227 ; 1 *Bann. & A. Pat. Cas.* 177.

The mere making of a model of an invention, was *held* not to constitute invention, as against a patent subsequently granted to another for the same thing. Stilwell, &c. Manuf. Co. *v.* Cincinnati Gas-light, &c. Co., 7 *Pat. Off. Gaz.* 829.

A claim for making in iron, a frame which has before been made in wood. Holbrook *v.* Small, 10 *Pat. Off. Gaz.* 503.

Combining a curved metal receiver with an elevated, instead of a horizontal, delivery. Mann *v.* Bayliss, 10 *Pat. Off. Gaz.* 789.

The putting a second cover on a base-ball, to harden it ; there being proof that a double cover had previously been used for the

like purpose upon softer balls. Mahn *v.* Harwood, 3 *Bann. & A. Pat. Cas.* 515; 14 *Pat. Off. Gaz.* 859.

The fastening of one or more fire-lighters to each bundle of the common article known as bundle or kindling wood; or the "accompanying" the bundle with a fire-lighter. Alcott *v.* Young, 16 *Pat. Off. Gaz.* 403.

The use of kerosene oil in a stove by means of prior devices; though such prior devices were intended for illuminating purposes, and alcohol or other combustible fluids were to be used. Couse *v.* Johnson, 16 *Pat. Off. Gaz.* 719; 4 *Bann. & A. Pat. Cas.* 501.

A metallic roofing or covering, made of a series of corrugated shingles, to be secured to the roof by nails, as are ordinary wooden shingles, one shingle overlapping another, so as to cover the nail holes in the lowest shingle. American Iron Co. *v.* Anglo-American Rooling Co., 16 *Fed. Rep'r*, 915; 24 *Pat. Off. Gaz.* 1274; 15 *Rep'r*, 779.

A change in form of corrugated iron to be applied to a building, or making the nail-holes in it elongated. Belt *v.* Crittenden, 2 *Fed. Rep'r*, 82; 1 *McCrary*, 209; 18 *Pat. Off. Gaz.* 191; 5 *Bann. & A. Pat. Cas.* 131.

A window cleaner, consisting of a holder with an elastic strap attached. Perfection Window Cleaner Co. *v.* Bosley, 2 *Fed. Rep'r*, 574; 9 *Biss.* 385; 10 *Rep'r*, 67; 5 *Bann. & A. Pat. Cas.* 449.

The use of the same mechanism for the purpose of applying a blast of hot air to the interior of beer casks to heat them, as had been previously used to apply a blast of hot air, of the same character, to the interior of moulds and other receptacles for the same purpose. Gottfried *v.* Crescent Brewing Co., 9 *Fed. Rep'r*, 762; 22 *Pat. Off. Gaz.* 497.

The employment of sheet metal as a lining for the bottom of a vessel to obtain liquids. New York Grape Sugar Co. *v.* American Grape Sugar Co., 10 *Fed. Rep'r*, 835; 20 *Blatchf.* 386; 13 *Rep'r*, 548.

An improvement in stoves, consisting in the substitution of a flat grate for a dished grate (Perry *v.* Co-operative Foundry Co., 12 *Fed. Rep'r*, 149); or the substitution of an old grate made in two parts for another old grate made in one part. *Id.* 436.

A can adapted to hold liquids, constructed after a device previously patented for a can to hold dry substances. Norton *v.* Haight, 22 *Fed. Rep'r*, 787.

A composition for an artificial ivory, consisting of a mechanical mixture of kaolin and shellac; where it appeared that the use of

those ingredients in combination was not new, and that the proportions stated in the patent did not produce any new or useful result. Welling *v.* Crane, 21 *Fed. Rep'r*, 707; 29 *Pat. Off. Gaz.* 451.

Alleged improvements in dissolving xyloidine, consisting in the use of camphor in conjunction with alcohol as a solvent; and in bleaching xyloidine, consisting in the application of ordinary bleaching materials, which had not before been used. Spill *v.* Celluloid Manuf. Co., 22 *Blatchf.* 441; 21 *Fed. Rep'r*, 631.

An improvement in sectional honey-frames, consisting of making them by bending and uniting the ends of a blank consisting of a single piece. Forncrook *v.* Root, 21 *Fed. Rep'r*, 328; 29 *Pat. Off. Gaz.* 775.

Application to the turning of machine awls and needles, from metal, of mechanism old and familiar in the art of wood-turning. Howe Machine Co. *v.* National Needle Co., 21 *Fed. Rep'r*, 630.

A claim of a process for preserving animal and vegetable substances, which process had been previously known; although the apparatus described might carry out the process better than that previously in use. Alden Evaporating Fruit Co. *v.* Bowen, 24 *Fed. Rep'r*, 787; 32 *Pat. Off. Gaz.* 1355.

An improvement in bushings for bungs, consisting in a change, in an old device, of one known material for another which had been previously used for kindred purposes. New York Bung, &c. Co. *v.* Doelger, 23 *Fed. Rep'r*, 191; 32 *Pat. Off. Gaz.* 651.

A patent for an improvement in construction of mosaic flooring, consisting of laying such flooring of hard wood upon a foundation of soft wood, tongued and grooved together. Kappes *v.* Hartung, 23 *Fed. Rep'r*, 187; 32 *Pat. Off. Gaz.* 652.

A claim of an improved tap-sole for rubber boots; the essence of the invention being in the form or shape. Woonsocket Rubber Co. *v.* Candee, 23 *Fed. Rep'r*, 797.

An improvement in type-writers, covering a combination of key levers of the third order of levers, and shields for covering the exposed ends of the levers; both of which were previously known and used in type-writers, although not in combination; the improvement involving a mere change of location of the shields to meet the different points of exposure. Phipps *v.* Yost, 26 *Fed. Rep'r*, 447.

An improvement in spittoons, consisting in loading the bottom

with sand secured by a metal plate. Havemeyer *v.* Randall, 21 *Fed. Rep'r*, 404 ; Havemeyer *v.* Bonnell, *Id.* 406.

An improvement in soldering process, involving a mere change of process from that of turning the article to be soldered in molten solder, while heated, to that of pouring melted solder into the joint from a ladle. Adams & Westlake Manuf. Co. *v.* Wilson Packing Co., 21 *Fed. Rep'r*, 648.

An improved mode of uniting small biscuit pans together in clusters, consisting in providing the pans with horizontal flanges and riveting them. Lalance & Grojean Manuf. Co. *v.* United States Stamping Co., 23 *Fed. Rep'r*, 800.

An improvement in a process of treating oleaginous seeds, consisting only in certain mechanical changes in carrying into effect the well-known old steps of the process. Lowther *v.* Hamilton, 21 *Fed. Rep'r*, 811 ; 29 *Pat. Off. Gaz.* 449.

An improvement in dummies for displaying clothing, consisting in the substitution of paper or papier mache for the wire previously used in making such dummies ; but that material had been used before in constructing lay figures, representing celebrated personages clothed with costumes. Palmenburg *v.* Buehholz, 21 *Blatchf.* 162.

Patent for an improvement in the manufacture of hydrogen peroxide, or oxygenated water ; the alleged improvement consisting merely in the stirring, by a well-known and simple mechanical device, of a liquid which, in the prior process, had been stirred by hand. Marchand *v.* Emken, 26 *Fed. Rep'r*, 629 ; 34 *Pat. Off. Gaz.* 1275.

An improvement in tools for reaming and squaring pipes ; being only an adaptation, perhaps to a new use, of a tool long previously well known, requiring mere mechanical change. Barry *v.* Crane Bros. Manuf. Co., 22 *Fed. Rep'r*, 396.

An improvement in scale-pans for weighing, describing the scale-pans as "made entire of glass," with strong lugs, on each side, through holes in which were passed double suspending bows ; there having been prior knowledge and use of scale-pans made of glass and glazed porcelain, and of metallic scale-pans suspended on bows similar to those described. Forschner *v.* Baumgarten, 26 *Fed. Rep'r*, 858.

An improvement in marking plug, claiming, as a new article of manufacture, a plug of tobacco marked with indentations to serve as guides for cutting the plug into measured quantities ; the same

device having been applied to other articles, and for the same purpose. Drummond *v.* Venable, 26 *Fed. Rep'r*, 243.

A corset with an elastic gore or gusset, for wearing apparel; the difference between these and previous patents for similar articles appearing to involve only the substitution of one material for another, and to require no inventive ability, but mere mechanical skill or adaptation. Florsheim *v.* Schilling, 26 *Fed. Rep'r*, 256.

A peculiar form of packing ice, for shipment or storage, consisting in placing the blocks close together, in a manner to prevent percolation of water. *Re* Kemper, 1 *MacArthur Pat. Cas.* 1.

The discovery that attaching an advertisement permanently to a balloon is a good mode of advertising. Gould *v.* Commissioner, 1 *MacArthur*, 410 ; 5 *Pat. Off. Gaz.* 121.

The application of a known and ordinary power to an ordinary purpose,—such as the combination of an endless screw and cog-wheel for steering apparatus to vessels. Cochrane *v.* Waterman, 1 *MacArthur Pat. Cas.* 52. S. P., Walker *v.* Rawson, 4 *Bann. & A. Pat. Cas.* 128.

The application of a mere mechanical device, requiring no invention, to a machine which was conceived by another and is being actually reduced to practice. Marshall *v.* Mee, 1 *MacArthur Pat. Cas.* 229.

The mere repetition of a well known process by which a metallic paint, heretofore known, may be obtained from waste matter. *Re* Maule, 1 *MacArthur Pat. Cas.* 271.

The use, in illuminated vault covers, of polygonal glasses of an inverted pyramidal form instead of lens-shaped glasses previously used, there being no evidence of the actual results in practice. *Re* Jackson, 1 *MacArthur Pat. Cas.* 485.

An improvement which consists merely in the employment of an obvious substitute, but does not involve, to any considerable extent, the exercise of ingenuity. *Re* Everson, 1 *MacArthur Pat. Cas.* 406 ; May *v.* Fond du Lac County, 27 *Fed. Rep'r*, 691.

Otherwise, if the substitute is not obvious, and is new and useful. Ladd *v.* Tucker Manuf. Co., 4 *Bann. & A. Pat. Cas.* 344.

A mere change in the details of mechanical construction of a device, as in the relative position and mode of attachment of its parts, but producing no new effect (*Re* Bishop, 1 *MacArthur Pat. Cas.* 518 ; Dane *v.* Illinois Manuf. Co., 6 *Fish. Pat. Cas.* 124 ; 3 *Biss.* 374 ; Hancock Inspirator Co. *v.* Lally, 27 *Fed. Rep'r*, 88) ; though a change in arrangement of old parts of a combination

which effects efficient co-operation may involve invention. Troy Laundry Machinery Co. *v.* Bunnell, 27 *Fed. Rep'r*, 810.

An alleged invention of an improved mode of protecting objects from the effect of lightning, by surrounding that part of the lightning-rod which is imbedded in the earth with a galvanic battery. *Re* Cushman, 1 *MacArthur Pat. Cas.* 569.

211. *Cases of Patents sustained against Objections of Want of Invention, Novelty, Utility, &c.*

A process of nickel plating, doubts existing whether nickel plating was reduced by previous discoveries to a practical art. United Nickel Co. *v.* California Electrical Works, 25 *Fed. Rep.* 475.

A process of manufacturing spoons and forks from steel, and the product resulting from such process; the result being attained by a succession of processes, which, though separately old, had not previously been practically grouped in the order employed. Wallace *v.* Noyes, 21 *Blatchf.* 83.

The subjection of spiral steel wire springs to heat, not merely for the purpose of tempering the steel, but also to restore strength and elasticity of the wire, lost by the displacement of its particles from being made into springs. Cary *v.* Wolff, 24 *Fed Rep'r*, 139; 32 *Pat. Off. Gaz.* 257; Cary *v.* Lovell Manuf. Co., 24 *Fed. Rep'r*, 141; 32 *Pat. Off. Gaz.* 1009; Cary *v.* Domestic Spring Bed Co., 34 *Pat. Off. Gaz.* 1158.

An improved automatic fire extinguisher, in which the seal was placed at the extreme outer end of the water pipe, and so near to the distributer, that, when the joint of the seal was melted, the seal itself was forced into the distributer and the water was left unobstructed. Parmelee *v.* Burritt Hardware Co., 24 *Fed. Rep'r*, 735; 33 *Pat. Off. Gaz.* 237.

The creation of a new device from an old one, by altering the structure at tops of childrens' carriages, so as to abandon the principal thing which the old device was created to do, and so as to change the principle of the mechanism in order to accomplish what the old structure did not undertake to do. Parker *v.* Stow, 23 *Fed. Rep'r*, 252; 31 *Pat. Off. Gaz.* 117; Parker *v.* Montpelier Carriage Co., 23 *Fed. Rep'r*, 886; 31 *Pat. Off. Gaz.* 1088; Parker *v.* McKee, 24 *Fed. Rep'r*, 808; 32 *Pat. Off. Gaz.* 137.

An improvement in cake-pans, where all the parts were known before, but not in the same connection and arrangement. Bell *v.* United States Stamping Co., 22 *Blatchf.* 27.

An improvement in kerosene stoves, consisting in holding the chimneys between upper and lower plates, so that the lower plate rested directly over the burners, while the upper plate furnished facilities for holding the cooking utensils. The fastening the chimney between the two plates, in this device, caused its success. Adams & Westlake Manuf. Co. *v.* Rathbone, 26 *Fed. Rep'r*, 262.

An improvement in friction drums for pile-drivers and hoisting machines, being for new combination, making a more compact, economical and useful machine than those previously in use. Mundy *v.* Lidgerwood Manuf. Co., 27 *Pat. Off. Gaz.* 718.

The substitution in a pendulum level of an entire graduated circle for a graduated semi-circle; the improvement involving a difference of construction which was shown to fit the new instrument for use in places where the old form could not be used; although opportunities for its use were rare. Chandler *v.* Ladd, 1 *MacArthur Pat. Cas.* 493.

An improved brick machine adapted to the manufacture of tubular or perforated brick, by providing the mold box with a core and an annular bottom or plunger for expelling the brick; held more than a mere change in the form of previous machines. *Re* Wagner, 1 *MacArthur Pat. Cas.* 510.

A pavement composed of stone blocks, of which the ends lying in the end of travel were smooth and fitted close together, while the sides lying across the street were left rough, with spaces between them in which the horses' feet might take hold. Guidet *v.* Barber, 5 *Pat. Off. Gaz.* 149.

A blank book with spaces numbered for bonds and coupons outstanding against the proprietor of the book, arranged for keeping them for reference as they should come in and be paid. Munson *v.* New York, 3 *Fed. Rep'r*, 338; 18 *Blatchf.* 237; 10 *Rep'r*, 135;

A hotel register, whose side margin was occupied with advertisements, and the middle left vacant for names of guests. Hawes *v.* Washburne, 5 *Pat. Off. Gaz.* 491. See also Hawes *v.* Cook, *Id.* 493; Hawes *v.* Gaze, *Id.* 494.

A fare register and recorder, consisting of a new arrangement of working together of old devices. Railway Register Manuf. Co. *v.* Broadway & Seventh Ave. R. R. Co., 22 *Fed. Rep'r*, 655; 30 *Pat.*

Off. Gaz. 180; but see decision granting rehearing, 32 *Pat. Off. Gaz.* 257; and decision on rehearing, 34 *Pat. Off. Gaz.* 921.

An improvement in manufacturing artificial teeth by substituting a vulcanizable rubber plate in place of other material formerly used. Smith *v.* Goodyear Dental, &c. Co., 93 *U. S.* 486.

An improvement in a bottle-stopper fastener, consisting in forming the fastener at the part that comes over the cork, of a piece of wire of a U form, with the ends returned and connected to the bottle in order that the pressure on the cork or stopper, may cause the fastener to hold more securely; a prior patent having been issued for a similar fastener made of tin. Putnam *v.* Yerrington, 9 *Pat. Off. Gaz.* 689.

An improvement in a compressed steam-guage cock, consisting in the substitution of vulcanized rubber in the opposing surfaces in place of brass or lead, leather or cork, as previously used. Dalton *v.* Nelson, 13 *Blatchf.* 357.

An improvement consisting in the substitution of an intermittent rotary seed-wheel for an oscillatory seed-wheel. Brown *v.* Deere, 6 *Fed. Rep'r*, 484.

An improvement in regulating the draft of stoves, consisting in the application of the principle of expansion or contraction of a metallic rod by means of the heat produced by the stove itself, thereby producing a self regulator. Foote *v.* Silsby, 1 *Blatchf.* 445; 2 *Blatchf.* 260; aff'd 20 *How.* 378.

A number of rollers, acting in pairs, arranged for a particular purpose. Knight *v.* Gavit, *Mir. Pat. Off.* 132. S. P., Parker *v.* Hulme, 7 *West. L. J.* 417; 1 *Fish. Pat. Cas.* 45.

An invention of a peculiar form of a last. Mabie *v.* Haskell, 2 *Cliff.* 507.

The placing of a rivet at the corners of a pocket opening. Strauss *v.* King, 17 *Pat. Off. Gaz.* 1450; 18 *Blatchf.* 88; 5 *Bann. & A. Pat. Cas.* 338; 2 *Fed. Rep'r*, 236.

The discovery that the foam in beverages can be increased by the use of soapine. Bowker *v.* Dows, 15 *Pat. Off. Gaz.* 510; 3 *Bann. & A. Pat. Cas.* 518.

A float-valve placed at the mouth of an air eduction-pipe in a night-soil cask, so as to close such pipe and stop the operation of the air-pump when the cask is filled; notwithstanding similar valves had been before used in steam-boilers and water-tanks to close eduction passages. Odorless Excavating Apparatus Co. *v.* Clements, 16 *Pat. Off. Gaz.* 854; 4 *Bann. & A. Pat. Cas.* 540.

An improvement in the art of curing fish, by removing a part of the mucous membrane not before known to be injurious to the keeping quality of the fish. 1 *Fed. Rep'r*, 140; 3 *Bann. & A. Pat. Cas.* 478.

A vulcanized rubber packing for boxes of pistons, sustained against the objection of lack of invention, because it disclosed a new and better method of obtaining a tight joint between the packing and the piston-rod than had been before obtained. New York Belting, &c. Co. *v.* Magowan, 34 *Pat. Off. Gaz.* 1159.

An improvement in floating mowing machines, consisting of the combination of the cutting apparatus of a mowing-machine with a boat, in such a way as to make it operate successfully for mowing under water. Piper *v.* Shedd, 26 *Fed. Rep'r*, 151.

Where an old device, with serious defects, was changed, and an improved result obtained. Asmus *v.* Alden, 27 *Fed. Rep'r*, 684.

A new combination of old and well-known mechanical appliances, the patent being limited to the *combination* alone. *Re* Boughton, 1 *MacArthur Pat. Cas.* 278; Frink *v.* Petry, 11 *Blatchf.* 422; 5 *Pat. Off. Gaz.* 201; 1 *Bann. & A. Pat. Cas.* 1; Forbush *v.* Cook, 2 *Fish. Pat. Cas.* 668; *Re* Hebbard, 1 *MacArthur Pat. Cas.* 543.

An imitation honey, which could be made more cheaply than real honey, and was not unwholesome; although purchasers might easily mistake it for the real. *Re* Corbin, 1 *MacArthur Pat. Cas.* 521.

212. *Irregularities or Defects in the Patent or the Proceeding to obtain it.*

Although an inventor cannot obtain a valid patent until he has in some sense completed or perfected his invention (Colt *v.* Massachusetts Arms Co., 1 *Fish. Pat. Cas.* 108; National Oil Co. *v.* Arctic Oil Co., 4 *Id.* 514; 8 *Blatchf.* 416; and see p. 58, *ante*), yet a patent duly issued will not be adjudged void because the invention was not literally and completely reduced to practice before the patent was issued; the phrase "reduced to practice," simply means that the thing must be so described, modeled, or otherwise exhibited in working condition, as to demonstrate that it does not rest in mere theory. Heath *v.* Hildreth, 1 *MacArthur Pat. Cas.* 12; *Re* Seely, *Id.* 248. It is in this sense that an invention is said not to be

patentable until "perfected." Moore *v.* Thomas, 3 *Bann. & A. Pat. Cas.* 13.

The filing of an application containing a clear and distinct description of the invention by specification and drawing, is a sufficient compliance with the requirement of a reduction to practice to entitle the applicant to a patent; and the fact that it has been used by others, although the applicant has not himself been able to use it successfully, is sufficient evidence of its capability of being used in the manner described. Burrows *v.* Wetherill, 1 *MacArthur Pat. Cas.* 315.

The descriptive language in a specification or claim, if clear, should be followed in its natural and ordinary meaning (Mitchell *v.* Tilghman, 19 *Wall.* 287; and see *ante*, pp. 68–76; 220–229), or, if ambiguous, should be favorably read, so as to give effect to the true intention of the patentee, considered as probably inexpert in the use of scientific language (French *v.* Rodgers, 1 *Fish. Pat. Cas.* 133; Page *v.* Ferry, *Id.* 298); and disregarding an error of expression which is apparent, and by which no one could be misled (Kneass *v.* Schuylkill Bank, 4 *Wash.* 9), without, however, forcing it beyond the true meaning of the language used. Masury *v.* Anderson, 6 *Fish. Pat. Cas.* 457; 11 *Blatchf.* 162; 4 *Pat. Off. Gaz.* 55.

But the description must clearly specify the various elements which the patentee claims as his invention, so fully that a competent artisan, skilled in the art, could construct the invention from the description given, without other aid (Webster Loom Co. *v.* Higgins, 16 *Pat. Off. Gaz.* 675), and so distinctly that the court can say what is the improvement or invention claimed by the patentee, and to what it is limited (Barrett *v.* Hall, 1 *Mas.* 447, 476; Lowell *v.* Lewis, 1 *Mas.* 182; Langdon *v.* De Groot, 1 *Paine*, 203; Parker *v.* Stiles, 5 *McLean*, 44; 7 *West. L. J.* 168; Tyler *v.* Deval, 1 *Code Rep'r*, 30); or can determine what parts or features of the machine, &c., are essential to the proposed result; without this (even though they may be distinguishable in the patent-office model), other persons are not forbidden to imitate them (Barry *v.* Gugenheim, 5 *Fish. Pat. Cas.* 452; 1 *Pat. Off. Gaz.* 382). Portions of the invention, which are omitted from the description, are not protected by the patent (Burden *v.* Corning, 2 *Fish. Pat. Cas.* 477); if, however, the description states lucidly what the patentee claims, it need not characterize what he does not claim as

"old" (Brown *v.* Guild, 23 *Wall.* 181), or describe it otherwise than in general terms. *Ib.;* Many *v.* Jagger, 1 *Blatchf.* 372.

An original patent is said to be entitled to a broader construction than a mere improvement. May *v.* Fond du Lac County, 27 *Fed. Rep'r*, 601.

A claim in the patent for more than plaintiff was the first and original discoverer and inventor of, will not avoid as to that which is new; and if his process in the separate preparation of either of the ingredients named in his patent was before named and used, yet if his combination of them is new, and the result produced is new and useful, his patent is valid. Stephens *v.* Felt, 11 *Hunt Mer. Mag.* 266.

When the claim expresses a combination of several elements without particularly pointing out the special construction of one embodying the actual novelty and invention, and the general combination is old, the patent is broader than the actual invention, and invalid. Terry Clock Co. *v.* New Haven Clock Co., 17 *Pat. Off. Gaz.* 908; 3 *Bann. & A. Pat. Cas.* 332.

If it is apparent from the specifications that the patent is for an invention which is frivolous, the court may declare it inoperative. Wilson *v.* Janes, 3 *Blatchf.* 227.

A patent for a composition, where the specification clearly describes the composition and all the ingredients and proportions, in language intelligible to those skilled in the art, cannot be invalidated by evidence of a failure to deposit in the patent-office a sample of one of the ingredients. It is for the commissioner to decide, before granting the letters-patent, whether this requirement has been complied with. A patent once granted cannot be subsequently impeached by evidence tending to show a want of compliance with the law as to giving notice, or paying fees, or performing the other acts required to be done before the patent is granted, and the performance of which is to be proved to the satisfaction of the commissioner, whose decision on these questions is final where he has jurisdiction. Tarr *v.* Folsom, 1 *Holmes*, 312; 5 *Pat. Off. Gaz.* 92; 1 *Bann. & A. Pat. Cas.* 24.

A claim to a patent for a compound is not void because the specification does not prescribe exact and unvarying proportions in the ingredients of the compound. Klein *v.* Russell, 19 *Wall.* 433.

Subject to general principles such as these (more fully explained *ante*, pp. 68–76, 220–229), not only may the commissioner reject an application for its obscurity or deficiency of language, but an

alleged infringer may object that the scope of a patent cannot be extended beyond its language (see Rapp *v.* Bard, 1 *Fish. Pat. Cas.* 196; Renwick *v.* Pond, 10 *Blatchf.* 39; 5 *Fish. Pat. Cas.* 569; 2 *Pat. Off. Gaz.* 392; Roemer *v.* Neumann, 26 *Fed. Rep'r*, 102); that the grant must be limited to the invention covered by the claim, and while the claim may be illustrated, it cannot be enlarged by language used in other parts of the specification (Yale Lock Manuf. Co. *v.* Greenleaf, 117 *U. S.* 554); or where the claims and specifications are repugnant, and the claim does not cover what is covered or described in the specifications, may contend that the patent is void for uncertainty. Smith *v.* Murray, 27 *Fed. Rep'r*, 69.

Whether alterations made in an application, after it has been filed, impair the validity of a patent issued upon it, see Gill *v.* Wells, 22 *Wall.* 1; Robertson *v.* Seecombe Manuf. Co., 10 *Blatchf.* 481; 3 *Pat. Off. Gaz.* 412; 6 *Fish. Pat. Cas.* 268; Globe Nail Co., 27 *Fed. Rep'r*, 450; also *ante*, p. 78.

With respect to official errors in preparing and issuing the patent, the cases have *held*, that the point that a patent was issued unintentionally, through the blunder of a subordinate in the patent office, cannot be raised in a suit brought on the patent. The seal of the United States and the signature of the proper officers to the grant must be respected, in the absence of fraud, so long as the United States do not themselves question the grant. Doughty *v.* West, 6 *Blatchf.* 429; 3 *Fish. Pat. Cas.* 580. See also, Tarr *v.* Folsom, *supra*; Railway Reg. Manuf. Co. *v.* North Hudson C. R. Co., 23 *Fed. Rep'r*, 593; 32 *Pat. Off. Gaz.* 519.

A grant (here, letters-patent) is not necessarily void by reason of an error in the Christian name of the grantee; and where it contains any other matter descriptive of the person for whom it was intended, extrinsic proof of such matter is admissible to identify the grantee. Northwestern Fire Extinguisher Co. *v.* Philadelphia Fire Extinguisher Co., 10 *Phila.* 227; 6 *Pat. Off. Gaz.* 34; 1 *Bann. & A. Pat. Cas.* 177.

The decision of the commissioner of patents in the allowance and issue of a patent creates a *prima facie* right only; and, upon all the questions involved therein, the validity of the patent is subject to examination by the courts. Reckendorfer *v.* Faber, 92 *U. S.* 347. S. P., Agawam Co. *v.* Jordan, 7 *Wall.* 583, 596; Union Paper Bag Machine Co. *v.* Crane, 1 *Holmes*, 429; 6 *Pat. Off. Gaz* 801; 1 *Bann. & A. Pat. Cas.* 494; Whipple *v.* Miner, 15 *Fed*

Rep'r, 117 ; 23 *Pat. Off. Gaz.* 2236 ; Gloucester Isinglass, &c. Co. *v.* Brooks, 19 *Fed. Rep'r*, 426.

The decision of the commissioner of patents is conclusive as to the law and facts arising under the application for a patent, unless it be impeached for fraud or connivance between him and the patentee, or unless his excess of authority be manifest on the face of the papers. Allen *v.* Blunt, 3 *Story*, 742 ; 8 *L. Rep'r*, 165. But compare Allen *v.* Blunt, 2 *Woodb. & M.* 121.

The questions of the regularity of the proceedings in petitioning for and obtaining a patent, and of the correctness of the judgment of the officer in awarding it, cannot be inquired into. Wilder *v.* McCormick, 2 *Blatchf.* 31.

The decision of the commissioner of patents that the drawings and model required by statute have been presented, that the attorney of the applicant was properly so constituted and had authority to amend or alter the specification, and that the specification was duly sworn to, cannot be reviewed collaterally ; but only in a proceeding to set aside the patent. Hoe *v.* Cottrell, 1 *Fed. Rep'r*, 597; 17 *Blatchf.* 546 ; 18 *Pat. Off. Gaz.* 59.

In a suit for infringement of a patent issued under the act of 1836, regular upon its face, and which recited that the patentee had made oath to his application therefor, it was *held*, that an objection to the validity of the patent, upon the ground that the records of the patent-office showed that the supplementary or amended application upon which the patent was granted was verified, not by the oath of the patentee, but by that of his attorney, could not be considered. Hancock Inspirator Co. *v.* Jenks, 21 *Fed. Rep'r*, 911 ; De Florez *v.* Reynolds, 14 *Blatchf.* 505.

213. *Disputing Plaintiff's Title to the Invention.*

As to the right of an alleged infringer to defend, on the ground that the patent was wrongfully issued to plaintiff, who is not the true inventor, or not the sole inventor, or that another person is jointly interested with him. Pitts *v.* Wemple, 1 *Biss.* 87 ; 2 *Fish. Pat. Cas.* 10 ; Worden *v.* Fisher, 11 *Fed. Rep'r*, 505 ; 21 *Pat. Off. Gaz.* 1957 ; Barker *v.* Woodruff, 1 *Pat. Off. Gaz.* 256 ; Collar Co. *v.* Deusen, 23 *Wall.* 530 ; aff'g 10 *Blatchf.* 109 ; *ante* 41, 280–286.

The relation between employer and employee may be such, and the suggestions of the latter in aid of developing a device or

machine, may involve so much independent invention, that the employee ought to be joined with the employer in the patent, and, consequently in an action for infringement. Collar Co. *v.* Deusen, *supra*; Hoe *v.* Kahler, 12 *Fed. Rep'r*, 111.

The employee in such cases is, however, at most only a joint inventor; he cannot sustain a patent in his own name alone. Arnold *v.* Bishop, 1 *MacArthur Pat. Cas.* 27; *Id.* 36. But where the inventor assigned the improvement to another person, on the agreement that the latter should take out a patent, and pay a royalty on manufactures under it, and a patent was obtained in the name of the assignee which the parties acted on as good, the invalidity of the patent as toward the public was *held* no defense to an action by the true inventor, against the assignee and patentee for agreed royalty. Milligan *v.* Lalance, &c. Manuf. Co., 21 *Fed. Rep'r*, 570; 29 *Pat. Off. Gaz.* 367.

The right to a patent for a practical application of a known principle is in the person who first conceived that application; any subsequent patent issued for an improved application must rest upon and be limited to the improvement the second patentee has made. *Re* Henry, 1 *MacArthur Pat. Cas.* 467.

A new application for a patent, made by an attorney without authority, is invalid; and a subsequent ratification does not relate back. Consolidated Fruit Jar Co. *v.* Bellair Stamping Co., 27 *Fed. Rep'r*, 377.

A party sued for infringement by one claiming sole interest who procures an assignment and release from infringement of claims, takes with notice and subject to equities. Kearney *v.* Lehigh Valley R. Co., 27 *Fed. Rep'r*, 699.

214. *Defenses Allowable under General Issue and Notice, by Rev. Stat.* § 4920 (*Act of* 1836, § 15).

In any action for infringement the defendant may plead the general issue, and having given notice in writing to the plaintiff or his attorney, thirty days before, may prove on trial any one or more of the following special matters:

First. That for the purpose of deceiving the public the description and specification filed by the patentee in the

patent-office was made to contain less than the whole truth relative to his invention or discovery, or more than is necessary to produce the desired effect ; or,

Second. That he had surreptitiously or unjustly obtained the patent for that which was in fact invented by another, who was using reasonable diligence in adapting and perfecting the same ; or,

Third. That it had been patented or described in some printed publication prior to his supposed invention or discovery thereof ; or,

Fourth. That he was not the original and first inventor or discoverer of any material and substantial part of the thing patented ; or,

Fifth. That it had been in public use or on sale in this country for more than two years before his application for a patent, or had been abandoned to the public.

And in notices as to proof of previous invention, knowledge, or use of the thing patented, the defendant shall state the names of patentees and the dates of their patents, and when granted, and the names and residences of the persons alleged to have invented, or to have had the prior knowledge of the thing patented, and where and by whom it had been used ; and if any one or more of the special matters alleged shall be found for the defendant, judgment shall be rendered for him with costs. And the like defenses may be pleaded in any suit in equity for relief against an alleged infringement ; and proofs of the same may be given upon like notice in the answer of the defendant, and with the like effect. *Rev. Stat.* § 4920.

215. *First. Fraudulent Defect or Excess in Specification.*

A patent from the government cannot, in a collateral proceeding, be impeached for fraud in procuring it. The allegation, that

"the same was procured by fraud, misrepresentation, and in violation of law," is simply an allegation of a conclusion of law from facts, which facts are not pleaded. Gear *v.* Grosvenor, 1 *Holmes*, 215; 3 *Pat. Off. Gaz.* 380; 6 *Fish. Pat. Cas.* 314.

The degree of evidence required to prove a fraudulent intent in a defective specification of a patent rests with the jury. Positive evidence is not necessary. The intention may be presumed from circumstances,—*e. g.*, when the parts concealed are so essential and so obviously necessary to be disclosed, that no mechanic skilled in the art could reasonably be expected to understand the subject so as, from the description given, to make the machine. But such a presumption would be weakened by the testimony of skillful persons that they could not hesitate in supplying the omissions. Gray *v.* James, *Pet. C. Ct.* 394.

216. *Second. Patent Surreptitiously or Unjustly Obtained.*

A charge that the original patentee of an invention fraudulently and surreptitiously obtained a patent on what he well knew was invented by another, constitutes no defense to the charge of infringement, unless accompanied by the further allegation that the alleged first inventor was at the time using reasonable diligence in adapting and perfecting the invention. Agawam Co. *v.* Jordan, 7 *Wall.* 583. S. P., Reed *v.* Cutter, 1 *Story*, 590.

If a patent has been obtained by the plaintiff, upon the defendant's refusal to submit to an arbitration, according to the act of February 21, 1793, § 9 (1 Stat. 318), and the defendant subsequently obtains a patent for the same invention, this is not conclusive proof that the latter was obtained surreptitiously, or upon false suggestion. Stearns *v.* Barrett, 1 *Mas.* 153, 174.

In the race of diligence between two independent inventors, he who first reduces his invention to a fixed position and practical form would seem to be entitled to a priority of right to a patent therefor. But this right was qualified by the act of 1836, § 15,—which provided that in such cases the first inventor shall have the prior right, if he is using reasonable diligence in adopting and perfecting the same, although the second inventor has, in fact, first perfected the same and reduced the same to practice in a positive form. Reed *v.* Cutter, 1 *Story*, 590; Reed *v.* Robinson, 4 *L. Rep'r*, 342. S. P., Washburn *v.* Gould, 3 *Story*, 122; 1 *West. L. J.* 465; 7 *L.*

Rep'r, 276; Bedford *v.* Hunt, 1 *Mas.* 302; Many *v.* Jagger, 1 *Blatchf.* 372; Parkhurst *v.* Kinsman, *Id.* 488; 8 *N. Y. Leg. Obs.* 146; Allen *v.* Hunter, 6 *McLean*, 303.

That a person constructed and used his machine before another took out a patent for a similar machine is not a justification, if in fact the former was copied from the machine subsequently patented. Hovey *v.* Stevens, 1 *Woodb. & M.* 290.

In order to bring a case within the meaning of the clause of the act of July 4, 1836, § 15 (now Rev. Stat. § 4920, subd. 2),—which specifies, as a defense to an action for the infringement of a patent, that the "plaintiff had surreptitiously or unjustly obtained the patent for that which was in fact invented or discovered by another, who was using reasonable diligence in adapting and perfecting the same,"—it is not necessary to implicate the good faith of the plaintiff or his assignees. The injustice relied on may be rather injustice in the abstract than injustice resulting from any intentional wrong. The term was used and intended to be used in its broadest sense. Phelps *v.* Brown, 4 *Blatchf.* 362; 1 *Fish. Pat. Cas.* 479; 18 *How.* 7.

Sections 12 and 15 of the act, taken together, were designed to protect the right of the first inventor, although he may not have been the first to adapt his invention to practical use, provided he has filed his caveat and has used reasonable diligence in perfecting his discovery. The purpose of the caveat is to save the discoverer from the effect of the rule of law which gives to the inventor who first adapts his invention to practical use the right to the grant of the patent. *Ib.* A. filed a caveat in the patent-office April 17, 1851. B. made application for a patent for the same invention November, 1854. No notice was given to A. of this application, but a patent was granted to B., January 9, 1855. A patent was subsequently granted to A. In a suit by the assignees of B. against the assignees of A., it was *held*, that the omission to give notice to A. might be set up as one of the defenses under section 15 of the act of July 4, 1836, as proof that B. "had surreptitiously or unjustly obtained the patent for that which was, in fact, discovered by another," &c. A patentee should not be prejudiced for the error or oversight of the patent-office. *Ib.*

In an action for infringement of a patent, the minutes of a company of which the plaintiffs were members and at whose suggestion and expense the subject of the patent was claimed to have been invented, may be read in evidence to prove that the

plaintiffs were not the original inventors of the thing patented; but not to show that the plaintiffs had surreptitiously obtained a patent for another's invention, unless notice of such defense and intention has been given to the plaintiffs. Pennock *v.* Dialogue, 4 *Wash.* 538.

The mere existence of a previous patent, or specification of an improvement, is not sufficient to establish the fact of fraud in obtaining a subsequent patent for a similar improvement; actual knowledge of the former patent by the subsequent patentee must be proved. Delano *v.* Scott, *Gilp.* 489.

217. *Third. Prior Patent or Published Description.*

Prior printed publications relied upon to defeat a patent, are sufficient for the purpose, if they describe the process covered by the patent so fully and clearly, as to enable persons skilled in the art to which the invention relates, to carry on the process. Downton *v.* Yeager Milling Co., 108 *U. S.* 466; aff'g 1 *Fed. Rep'r*, 199; 1 *McCrary*, 26; 17 *Pat. Off. Gaz.* 906; 9 *Rep'r*, 462; 5 *Bann. & A. Pat. Cas.* 112.

When properly pleaded and proven, the statutory defense "that the invention had been patented, or described in some printed publication, prior to the supposed invention" by the patentee, is sustained, if the conflicting patent, whether foreign or domestic, was duly issued or the complete description was published prior to the date of the patent in contest. Kelleher *v.* Darling, 14 *Pat. Off. Gaz.* 673; 4 *Cliff.* 424. Whether the rival patent or the printed description must in all cases have appeared before the patentee's invention was made; and whether a crude machine, made and used only as an experiment or specimen, may be introduced in proof that such invention existed, see *Ib.*; Elizabeth *v.* Pavement Co., *infra*; Gottfried *v.* Phillip Best Brewing Co., 17 *Pat. Off. Gaz.* 675; 5 *Bann. & A. Pat. Cas.* 4; Bartholomew *v.* Sawyer, 4 *Blatchf.* 347; 1 *Fish. Pat. Cas.* 516; 11 *Hunt Mer. Mag.* 575.

Upon a question of the validity of a patent, it is admissible to show that the invention had been described in publications prior to the issuing of the patent; and such publication may be proved by the production of the book, or by parol testimony. Allen *v.* Hunter, 6 *McLean*, 303, 314.

Use or sale of an invention before it is perfected, necessarily

made as an aid to the inventor in ascertaining its usefulness and deficiencies and in perfecting it, is not such a use or sale as defeats the right to a patent. Graham *v.* McCormick, 11 *Fed. Rep'r*, 859 ; 10 *Biss.* 39 ; 21 *Pat. Off. Gaz.* 1533 ; 5 *Bann. & A. Pat. Cas.* 244.

Under the act of 1836, § 6, it was *held* that a prior construction and use of the thing patented, in one instance only, never made public, and which had been finally forgotten, or abandoned, so that, at the time of the invention by the patentee, the invention did not exist, would not render a patent invalid; for, by the phrase, "knowledge and use" referred to in the act, was meant knowledge and use existing in a manner accessible to the public. Gayler *v.* Wilder, 10 *How.* 477.

A foreign patent or publication describing an invention, unless published anterior to the making of the invention or discovery secured by letters-patent issued by the United States, is no defense to a suit upon them. Elizabeth *v.* Pavement Co., 97 *U. S.* 126.

The only exception to the rule, that in order to confer an exclusive right on the patentee, the thing patented must have been original with the inventor and not known to others, is where an individual obtains a patent believing the invention to be original, and it is made to appear that it had been known in a foreign country, but not patented there, nor described in any printed publication. Parker *v.* Stiles, 5 *McLean*, 44, 61 ; 7 *West. L. J.* 168.

The mere fact that an invention patented was known and used in a foreign country before its discovery by the patentee, is not sufficient (under the act of 1836) to avoid the patent, provided the patentee, at the time of making his application for a patent, believed himself to be the first inventor of the thing patented. Bartholomew *v.* Sawyer, 4 *Blatchf.* 347 ; 1 *Fish. Pat. Cas.* 516 ; 41 *Hunt Mer. Mag.* 575 ; Boemer *v.* Simm, 5 *Pat. Off. Gaz.* 555 ; Doyle *v.* Spaulding, 19 *Fed. Rep'r*, 744.

No description, in any printed publication, of the thing patented, can avoid the patent, unless such description was prior, in point of time, to the invention of the patentee ; that the description in the printed publication was prior to the application for the patent, is not enough. Bartholomew *v.* Sawyer, *supra.*

The fact that the use of the invention before the patentee originated it was unknown to him, will not prevent such use from avoiding the patent, if the use was in this country. Boemer *v.* Simm, *supra.*

If it is proved that the invention, or something substantially like it, has been described in a book, or has been the subject of a patent in a foreign country, this is a good defense to an action for infringement in this country. Judson *v.* Cope, 1 *Fish. Pat. Cas.* 615 ; 1 *Bond*, 327.

If the jury find that the patentee, when he made application for his patent, believed himself to be first inventor, his patent will not be invalidated by the existence of the thing abroad. Forbush *v.* Cook, 10 *L. Rep'r, N. S.* 664.

Previous use or knowledge of an invention abroad is no defense against a patent, unless such invention was described in some printed publication so clearly as to enable others to put it in practice. Jones *v.* Sewall, 3 *Cliff.* 563 ; 6 *Fish. Pat. Cas.* 343 ; 3 *Pat. Off. Gaz.* 630. S. P., Cahill *v.* Brown, 15 *Pat. Off. Gaz.* 697 ; 3 *Bann. & A. Pat. Cas.* 580 ; Atlantic Giant Powder Co. *v.* Parker, 16 *Pat. Off. Gaz.* 495 ; Roberts *v.* Dickey, 1 *Pat. Off. Gaz.* 4 ; 4 *Fish. Pat. Cas.* 532 ; 4 *Brews.* 260 ; 3 *Pittsb.* 352.

Foreign patents urged as anticipations of domestic patents, where the article is not properly proved to have been known or used in this country, or the patentee's circular to the trade was not a printed publication, or his provisional specification did not make the invention described in it patented, within the meaning of the act of 1836, §§ 7, 15, will not be considered. Parsons *v.* Colgate, 15 *Fed. Rep'r*, 600 ; 24 *Pat. Off. Gaz.* 203.

An English patent, taken out surreptitiously by any person, who, without the knowledge of the American inventor, and without authority from him, endeavored to appropriate the benefits of his invention, would not thereby deprive the real inventor of any of his rights. Kendrick *v.* Emmons, 9 *Pat. Off. Gaz.* 201 ; 2 *Bann. & A. Pat. Cas.* 208.

An invention is not patented in England within the meaning of Rev. Stat. § 4920, subd. 3, until the completed specification has been filed; unless it has been described in some printed publication within the meaning of *Rev. Stat.* § 4920, subd. 3. Coburn *v.* Schroeder, 11 *Fed. Rep'r*, 425 ; 20 *Blatchf.* 392 ; 22 *Pat. Off. Gaz.* 419.

In 1861, a certain description and drawings were published in England, from which the United States, in 1863, caused to be constructed and placed on a vessel, certain armor. One Heaton conceived, in 1856, the idea of armor, and experimented by firing pistols at small pieces of wood and iron. In 1861, he began to make

a model of a war vessel. In 1862, it was completed. It was *held*, that his invention was later than the publication in England. An idea, to be considered an invention, in the frequent sense of the word, must be embodied in some distinct form. Webb *v.* Quintard, 9 *Blatchf.* 352; 1 *Pat. Off. Gaz.* 525; 5 *Fish. Pat. Cas.* 276.

The patent law protects simplicity and economy of construction as against prior complex and expensive combinations; and although the general and abstract effect may be analogous, if the two mechanisms produce their respective results by essentially different processes, the one being more simple and capable of being operated with greater economy than the other, it is not anticipated thereby. In order that a prior patent or publication should anticipate a patent, the description must appear to embody substantially the same organized mechanism, operating substantially in the same manner as that described in the patent claimed to have been anticipated. Gottfried *v.* Phillip Best Brewing Co., 17 *Pat. Off. Gaz.* 675; 5 *Bann. & A. Pat. Cas.* 4.

Apparently a description is not in a "printed publication" in the sense of the statute, unless copies have been printed and disseminated to render the work somewhat generally accessible. Coburn *v.* Schroeder, 20 *Blatchf.* 392. See Keene *v.* Wheatley, 9 *Am. L. Reg.* 33; 5 *Pa. L. J.* 501. And so *held* of printed circulars, limited in distribution, and giving a meager description of the invention. New Process Fermentation Co. *v.* Koch, 21 *Fed. Repr.* 580; 29 *Pat. Off. Gaz.* 535.

Test proposed, for determining whether the inventions described in an American and a foreign patent are the same, see Commercial Manuf. Co. *v.* Fairbanks Canning Co., 27 *Fed. Repr.* 78.

218. *Fourth. Patentee not "First Inventor."*

By "the original and first inventor" is meant not necessarily he who first conceived the idea of the invention, but he who first gave to the idea a useful and practical form and matured for it a plan of material means by which it could have actual operation. Foote *v.* Silsby, 14 *How.* 218; aff'g 1 *Blatchf.* 445; Teese *v.* Phelps, *McAll.* 48; Goodyear *v.* Day, 2 *Wall. Jr.* 283.

In the sense of the term above indicated, "first inventor" means the person who first devises means to put the invention into practice; he, and he only, is entitled to the patent. Bedford *v.* Hunt, 1 *Mas.* 302; Union Sugar Refinery *v.* Matthiesen, 3 *Cliff.* 639; 2

Fish. Pat. Cas. 600; Jones *v.* Sewall, 6 *Fish. Pat. Cas.* 343; 3 *Cliff.* 563; 3 *Pat. Off. Gaz.* 630; Ellithorp *v.* Robertson, 4 *Blatchf.* 307; 2 *Fish. Pat. Cas.* 83; Evans *v.* Weiss, 2 *Wash.* 342; 3 *Am. L. J.* 180; Parker *v.* Hulme, 1 *Fish. Pat. Cas.* 44; 7 *West. L. J.* 417; Reeves *v.* Keystone Bridge Co., 1 *Pat. Off. Gaz.* 466; 5 *Fish. Pat. Cas.* 456; 5 *Am. L. T. U. S. Cts.* 150; 9 *Phila.* 368; Miller *v.* Force, 9 *Fed. Rep'r*, 603; 21 *Pat. Off. Gaz.* 947; Allen *v.* Hunter, 6 *McLean*, 303, 321; Teese *v.* Phelps, *McAll.* 48; Brodie *v.* Ophir Silver Mining Co., 4 *Fish. Pat. Cas.* 137; 5 *Sawyer*, 608; Nichols *v.* Harris, 1 *MacArthur Pat. Cas.* 362.

In determining questions of priority of invention, it is not so much he who made and perfected the first machine or instrument who is to be considered the first inventor, as he who first conceived the idea and so described it by words or drawings as to have been sufficient to enable a skillful workman to bring it into useful practical operation. Such a person will be protected against the claim of any subsequent inventor who may have been first in adapting a machine or instrument to the invention, provided such first discoverer has been using due diligence in effecting the same end, so that, although he may have been unsuccessful in some of his experiments, by following them up he at length succeeds. Davidson *v.* Lewis, 1 *MacArthur Pat. Cas.* 599.

An inventor who reduces to practice his invention with reasonable diligence, has priority over one who subsequently conceives, though actually reducing to practice first, the device. Marshall *v.* Mee, 1 *MacArthur Pat. Cas.* 229; Heath *v.* Hildreth, *Id.* 12; Perry *v.* Corneil, *Id.* 60; McCormick *v.* Howard, *Id.* 238; Chandler *v.* Ladd, *Id.* 493.

He who invents first has the prior right, if he uses reasonable diligence in adapting and perfecting his invention, although a second inventor in fact perfects it and reduces it to practice in positive form before him. Electric R. R. Signal Co. *v.* Hall R. R. Signal Co., 6 *Fed. Rep'r*, 603. S. P., Reeves *v.* Keystone Bridge Co., 1 *Pat. Off. Gaz.* 466; 5 *Fish. Pat. Cas.* 456; 5 *Am. L. T. U. S. Cts.* 150; 9 *Phila.* 368; 2 *Ham. & A. Pat. Cas.* 256.

Even before a patent has been granted, the property in an invention belongs, generally, to him who is the first inventor; therefore, any person who, knowing that another is the first inventor, yet doubting whether that other will ever apply for a patent, proceeds to construct a machine so invented by another, acts at his peril and with the full knowledge of the law that a subsequent

patent may out him out of the use of the machine thus erected (Evans *v.* Weiss, 2 *Wash.* 342 ; Evans *v.* Jordan, 1 *Brock. Marsh.* 248; aff'd, 9 *Cranch*, 199) ; *a fortiori*, where the party constructing know that the inventor had obtained a patent which was afterward declared invalid, but under a subsequent act of Congress a valid patent was secured. Evans *v.* Weiss, *supra*.

Where plaintiff's patented machine is anticipated by a machine containing parts different in form but performing the same functions as the like parts in complainant's machine, the scope of his patent will be limited to the improvements in form made in his patented machine. Williams *v.* Barker, 2 *Fed. Rep'r*, 649 ; 18 *Pat. Off. Gaz.* 243 ; 5 *Bann. & A. Pat. Cas.* 453.

The first inventor is entitled exclusively to a patent right, though a subsequent person may have also been an original inventor. The law gives the right, as among inventors, to him who is first in point of time. Lowell *v.* Lewis, 1 *Mas.* 182 ; Reed *v.* Cutter, 1 *Story*, 590 ; Reed *v.* Robinson, 4 *L. Rep'r*, 342 ; Allen *v.* Blunt, 2 *Woodb. & M.* 121.

A complete invention is not anticipated by a partial embodiment of the idea which was lacking in just those features necessary to its success (Richardson *v.* Noyes, 10 *Pat. Off. Gaz.* 507 ; 2 *Bann. & A. Pat. Cas.* 398); nor will crude and imperfect experiments, equivocal in their results, and therefore abandoned and given up, be permitted to prevail against an original inventor who has perfected his improvement and obtained his patent. Union Sugar Refinery *v.* Mathieson, 3 *Cliff.* 639 ; 2 *Fish. Pat. Cas.* 600 ; Roberts *v.* Dickey, 1 *Pat. Off. Gaz.* 4 ; 4 *Fish. Pat. Cas.* 532 ; 4 *Brews.* 260 ; 3 *Pittsb.* 352 ; Roberts *v.* Schreiber, 2 *Fed. Rep'r*, 855 ; 18 *Pat. Off. Gaz.* 125 ; 5 *Bann. & A. Pat. Cas.* 491 ; Whittlesey *v.* Ames, 9 *Biss.* 225 ; 18 *Pat. Off. Gaz.* 357 ; 5 *Bann. & A. Pat. Cas.* 96 ; Fay *v.* Allen, 24 *Fed. Rep'r*, 804 ; Yale Lock Manuf. Co. *v.* Berkshire National Bank, 26 *Id.* 104.

Although a person has engaged in producing some new and useful instrument or contrivance, and has embodied it in a machine and endeavored to reduce it to practice by experiment, yet if those trials fail, if he fail in success and abandon the effort, the consideration affords no impediment to another person who has taken up the same idea, or class of ideas, and who has gone on perseveringly in his studies, trials and experiments, until he has perfected the new idea and brought it into practical and useful operation. The latter is the person, the meritorious inventor, who is entitled to the

protection of the law. Winans *v.* New York & Harlem R. R., 31 *Jour. Fr. Inst.* 3*rd S.* 322.

Although a party had conceived of the invention before the patentee, and made some progress toward completing a model, yet, if he suspended his labors, and before he resumed them, the patentee perfected the invention, and embodied it in a practical working machine, the patent will be sustained. Smith *v.* O'Connor, 4 *Pat. Off. Gaz.* 633 ; 6 *Fish. Pat. Cas.* 469.

Where the anticipatory device of defendant was discontinued, but not until its practicability had been demonstrated, it was *held,* sufficient to defeat the plaintiff's patent. McNish *v.* Everson, 5 *Bann. & A. Pat. Cas.* 484 ; 2 *Fed. Rep'r,* 899 ; 17 *Pat. Off. Gaz.* 1506.

The chance operation of a principle unrecognized at the time, without the knowledge of its method of employment, will not defeat the claim of one who first puts it into practical use, and makes it available. Andrews *v.* Carman, 13 *Blatchf.* 307 ; 9 *Pat. Off. Gaz.* 101 ; 2 *Bann. & A. Pat. Cas.* 277.

Mere speculations, not practically used, do not deprive a subsequent inventor who puts his invention into practice, of the proper reward. Rich *v.* Lippincott, 1 *Pittsb.* 31 ; 2 *Fish. Pat. Cas.* 1.

To constitute such a prior invention as will avoid a patent, there must be proof that some one, before the patentee, not only conceived the idea of doing what the patentee has done, but also reduced his idea to practice, and embodied it in some practical and useful form. The making of drawings of conceived ideas is not such an embodiment of such conceived ideas in a practical and useful form, as will defeat a patent which has been granted. Ellithorp *v.* Robertson, 4 *Blatchf.* 307 ; 2 *Fish. Pat. Cas.* 83 ; Reeves *v.* Keystone Bridge Co., 1 *Pat. Off. Gaz.* 466 ; 5 *Fish. Pat. Cas.* 466; 5 *Am. L. T. U. S. Cts.* 150 ; Detroit Lubricator Manf. Co. *v.* Renehard, 9 *Fed. Rep'r,* 293.

Although drawings by an inventor before application for a patent by him, may carry back the date of the invention, if reasonable diligence is shown, merely making drawings is not such an embodiment of an invention as will defeat a patent subsequently granted. Odell *v.* Stout, 22 *Fed. Rep'r,* 159 ; 29 *Pat. Off. Gaz.* 862.

Where the invention described and claimed is of a machine of specified construction, it is anticipated by a prior machine of substantially the same construction although a new, and perhaps

patentable use of the machine is suggested in the specification of the patent. Boston Elastic Fabrics Co. *v.* East Hampton Rubber Thread Co., 1 *Holmes*, 372; 9 *Pat. Off. Gaz.* 745; 1 *Bann. & A. Pat. Cas.* 222.

It is no objection to a patent for a combination of machinery that any part of the structure existed before, unless the combination has existed before. *Re* Halsey, 1 *MacArthur Pat. Cas.* 459.

A patentee cannot embrace in a subsequent patent any invention embraced in a prior one granted to himself. Hill *v.* Commissioner of Patents, 1 *Cent. Rep'r*, 91.

Contract by employee of inventor of undisclosed process of manufacture, not to divulge the secret, is limited to term of employment. Salomon *v.* Hertz, 2 *Cent. Rep'r*, 132.

219. *Anticipation of an Invention by one earlier. Priority between Competitors.*

The first inventor is entitled to the benefits of his invention if he reduce it to practice and obtain a patent therefor, and a subsequent inventor cannot, by obtaining a patent, oust the first inventor of his right, or maintain an action against him. Woodcock *v.* Parker, 1 *Gall.* 438.

As between rival inventors he is entitled to a patent whose inceptive invention was the earliest, who was diligent in perfecting and adapting it, and in applying for a patent. Kneeland *v.* Sheriff, 5 *Bann. & A. Pat. Cas.* 482; 2 *Fed. Rep'r*, 901; 10 *Rep'r*, 234; 18 *Pat. Off. Gaz.* 242.

If two machines be substantially the same, and operate in the same manner, to produce the same result, though they may differ in form, proportions, and utility, they are the same in principle; and the one last discovered has no other merit than that of being an improved imitation of the one before discovered and in use, for which no valid patent can be granted to any o ·; because he cannot be considered as the original inventor of the machine. And it makes no difference as to the patentee's rights, whether the prior machine or invention has fallen into disuse or not; if it was used before his discovery he cannot obtain a patent for it. Evans *v.* Eaton, 3 *Wash.* 443; aff'd, 7 *Wheat.* 356.

A patent relates back to the date of the application; and

patents granted to other inventors during the pendency of such application, so far as they cover the same invention, are void, and no protection to an infringer. Johnson *v.* Fassman, 1 *Woods*, 138; 5 *Fish. Pat. Cas.* 471.

Where a dispute arises as to priority of invention, a patentee is allowed to show the real date of it, and to have his rights as fully secured as if he had taken out his patent. Parker *v.* Hulme, 1 *Fish. Pat. Cas.* 44; 7 *West. L. J.* 417. And see MacDonald *v.* Blackmer, 4 *Bann. & A. Pat. Cas.* 78

An article which could be made only as a mere curiosity, and not as an article for the trade, will not defeat a subsequent invention of a machine to make it. Lamb *v.* Hamblen, 11 *Fed. Rep'r*, 722.

In order to determine whether the mechanism of two machines is the same, an examination should be made not only of the mechanism itself, that is, the devices and their arrangements, but also of their mode of operation and their effects and results. Eames *v.* Cook, 2 *Fish. Pat. Cas.* 146.

Whether the one device is the same in substance or principle as another, depends on whether it is the same kind of instrument or not, and whether it acts in the same way in substance, and produces the same result in substance. Colt *v.* Mass. Arms Co., 1 *Fish. Pat. Cas.* 108, 118; Platt *v.* Manuf. Co., 5 *Fish. Pat. Cas.* 265; 9 *Blatchf.* 342; 1 *Pat. Off. Gaz.* 524; Rumford Works *v.* Lauer, 5 *Fish. Pat. Cas.* 615; 10 *Blatchf.* 122; 3 *Pat. Off. Gaz.* 249; Singer *v.* Braunsdorf, 7 *Blatchf.* 521; Wilcox *v.* Komp, 7 *Blatchf.* 126.

Where the real inventor obtains the later patent he may have the prior patent canceled. Sturges *v.* Van Hagan, 6 *Fish. Pat. Cas.* 572.

Making a device which will serve the same useful purpose as one afterward perfected, is not necessarily anticipating the latter. Where the mechanical means of two machines employed are different, and the mechanical result is different, one does not anticipate the other. Buerk *v.* Valentine, 5 *Fish. Pat. Cas.* 366; 9 *Blatchf.* 479; 2 *Pat. Off. Gaz.* 295.

Where two devices are similar in construction, but there is a difference in the elements of which they are necessarily composed, and in the use to which they are to be applied, there is a patentable difference. Thayer *v.* Spaulding, 27 *Fed. Rep'r*, 66.

If the inventor produced a new article he is entitled to a patent, although others approached very near to the invention without

producing it exactly. M. & P. Manuf. Co. *v.* Du Bruil, 2 *Bann. & A. Pat. Cas.* 618.

Where the claim of a patent is a combination claim, consisting of several elements that co-operate together to produce the device claimed, such device can only be anticipated by a prior device, having identically the same elements, or the mechanical equivalents, of those that are not used. It will not do to find a portion of these elements in one machine, and a portion in a second, and a third, and so on, and then say that the device is anticipated. Worswick Manuf. Co. *v.* Steiger, 17 *Fed. Rep'r*, 250.

220. *Examples of Anticipation and Priority.*

A patent for an improvement in tools for attaching sheet metal mouldings was *held* to be invalid, the invention having been anticipated by a machine for putting moldings on combs, although the latter was comparatively small, and was used only for combs; nothing appearing in the patented invention more than an adaptation of that machine not requiring the exercise of the inventive faculty. Peters *v.* Active Manuf. Co., 21 *Fed. Rep'r*, 319; 28 *Pat. Off. Gaz.* 1102.

Improvements, by Bell, in telegraphy and electric telephony, covering the electric speaking-telephone, were *held* patentable to him, notwithstanding a claim that they had been anticipated by Drawbaugh; it appearing that the latter had made no effort to secure a patent for his invention for ten years after the time he claimed to have completed and demonstrated it. American Bell Telephone Co. *v.* People's Telephone Co., 22 *Blatchf.* 531; 22 *Fed. Rep'r*, 309; 29 *Pat. Off. Gaz.* 1029.

In an action for damages for infringement of a patent for an improvement in perches for dump-cars, it was shown that dump-cars embodying the same invention were constructed some years before the patent, and that forty such cars were ordered built for a foreign railroad company, and were shipped to that company, presumably for use. Upon this showing, the court *held* the defense of want of novelty established. Stitt *v.* Eastern R. Co., 22 *Fed. Rep'r*, 649.

In an action between patentees under different patents, in which the senior patentee alleged an infringement of his patent by the junior patentee, an adjudication that the senior patentee was not

the first inventor of the thing patented to him, was *held*, not to enlarge or affect the estate of the junior patentee; where the thing patented to junior was not the same as that claimed by the senior; although the junior could not make the article the subject of his invention without using the invention patented by the senior patentee; and it was further *held* that such adjudication was not a bar to a subsequent suit by the senior patentee against a licensee of the junior, whose license was taken after the commencement of the first suit, and with notice thereof. Brush *v.* Naugatuck R. Co., 24 *Fed. Rep'r*, 371; 32 *Pat. Off. Gaz.* 894.

221. *Fifth. Public Use or Sale before Application.*

The cases collected under this topic were decided, a part of them, under the act of 1836, § 15 (usually read in connection with the act of 1839, § 7, the others under the act of 1870, § 61, *Rev. Stat.* § 4920, subd. 5).

The language of the two acts is different, but the supreme court, per SAWYER, J., in Consolidated Fruit Jar Co. *v.* Wright, 94 *U. S.* 92, 94, seems to have treated the difference as unimportant; the cases are therefore gathered without special discrimination.

Upon the general rule, under the successive statutes, that the fact that an inventor permits public use or sale of his invention (by the existing law) "for more than two years before his application for a patent" renders any patent he may obtain, void,—see McClurg *v.* Kingsland, 1 *How.* 202; Egbert *v.* Lippman, 104 *U. S.* 333; Consolidated Fruit Jar Co. *v.* Wright, 94 *U. S.* 92; Worley *v.* Tobacco Co., 104 *U. S.* 340; Manning *v.* Cape Ann Isinglass, &c. Co., 108 *U. S.* 462; aff'g 9 *Rep'r*, 337; 4 *Bann. & A. Pat. Cas.* 612.

If an invention has, through the acts of the inventor, gone into public use beyond his control, his right to a patent is forfeited. Jones *v.* Sewall, 3 *Cliff.* 563; 3 *Pat. Off. Gaz.* 630; 6 *Fish. Pat. Cas.* 343. To same effect, Plimpton *v.* Winslow, 14 *Fed. Rep'r*, 919; 23 *Pat. Off. Gaz.* 1731; Rich *v.* Lippincott, 1 *Pittsb.* 31.

If an inventor allows his machine to be used by other persons generally, or if it is, with his consent, put on sale for such use, then it will be in public use and on public sale, within the meaning of the law. Elizabeth *v.* Paving Co., 97 *U. S.* 126.

The public use of on invention, by its inventor, for more than two years prior to his application for a patent, deprives him of his

right and invalidates a patent obtained after such use. Russell Manuf. Co. *v.* Mallory, 10 *Blatchf.* 140; Guidet *v.* Palmer, *Id* 217; McMillan *v.* Barclay, 5 *Fish. Pat. Cas.* 189; 4 *Brews.* 275; 3 *Pittsb.* 377.

The effect of allowing public use of an invention cannot be avoided by afterward assigning an interest in the invention to the persons who were allowed to use it. Worley *v.* Tobacco Co., 104 *U. S.* 340.

The fact that an invention was in public use and on sale, with the consent and allowance of the inventor, more than two years before his application for a patent; renders the patent invalid, however great the hindrances to the application, and whether caused by the want of pecuniary means or other misfortune. Sisson *v.* Gilbert, 9 *Blatchf.* 185; 5 *Fish. Pat. Cas.* 109.

Mere delay in applying for a patent after invention made, works no forfeiture of right. But if other persons practice the invention in this country, whether with or without the knowledge or consent of the patentee, more than two years prior to the filing of his application, the patent is invalid. Kelleher *v.* Darling, 14 *Pat. Off. Gaz.* 673; 4 *Cliff.* 424.

The effect of the act of March 3, 1839, § 7, is to require that an inventor shall not permit his invention to be used in public at a period earlier than two years prior to his application for a patent, under the penalty of having his patent rendered void by such use. Consent and allowance by the inventor are not necessary to such invalidity. But *a fortiori*, consent to a use in public, not followed by an application for a patent within two years afterward, makes the patent, when granted, invalid. Egbert *v.* Lippman, 15 *Blatchf.* 295; 14 *Pat. Off. Gaz.* 822; aff'd, 104 *U. S.* 333.

As to when the two years' limitation for filing the application for a patent on an invention in public use begins to run,—see Graham *v.* McCormick, 5 *Bann. & A. Pat. Cas.* 244; 11 *Fed. Rep'r*, 859; 10 *Biss.* 39; 21 *Pat. Off. Gaz.* 1533.

222. *What Constitutes a Public Use.*

Use of an invention made by the inventor in good faith, for the purpose of testing its operation, ascertaining defects and maturing improvements, is not a public use which debars from obtaining a patent. The fact that he does not find need to make improvements; that the use is long continued; that it is on premises

not owned by the inventor; that it is open to public inspection, and the public incidentally derive benefit from it, makes no difference. So long as he does not voluntariiy allow others to make it and use it, and so long as it is not on sale for general use, he keeps the invention under his own control, and does not lose his title to a patent. Elizabeth *v.* Pavement Co., 97 *U. S.* 126.

If an inventor, having made his device, gives or sells it to another, to be used by the donee or vendee without limitation or restriction, or injunction of secrecy, and it is so used, such use is public, even though the use and knowledge of the use may be confined to one person. Egbert *v.* Lippman, 104 *U. S.* 333.

Where an inventor allows the unrestricted use of his invention by another without injunction of secrecy or other condition, for more than two years prior to his application for a patent, although such use may be secret, this will constitute a public use and render the patent subsequently issued void. Manning *v.* Cape Ann Isinglass, &c. Co., 108 *U. S.* 462; aff'g 9 *Rep'r*, 337; 4 *Bann. & A. Pat. Cas.* 612; Burton *v.* Greenville, 3 *Fed. Rep'r*, 642; 5 *Bann. & A. Pat. Cas.* 541; 18 *Pat. Off. Gaz.* 411.

Public use, in the sense of the patent law, is proved by a single unrestricted use by any person not the inventor, or by the inventor in an open way, provided the use is not experimental. Jones *v.* Barker, 11 *Fed. Rep'r*, 597; 22 *Pat. Off. Gaz.* 771. S. P., Clark Pomace Holder Co. *v.* Ferguson, 17 *Fed. Rep'r*, 79; 24 *Pat. Off. Gaz.* 1090.

The use of an invention in a factory where any person may see it, is a public use; and after two years of such use the invention becomes a public right. Manning *v.* Cape Ann Isinglass, &c. Co., 108 *U. S.* 462; aff'g 9 *Rep'r*, 337; 4 *Bann. & A. Pat. Cas.* 612; see Adams *v.* Edwards, 1 *Fish. Pat. Cas.* 1.

The phrase means a use in a public manner, not use by the public generally. Hunt *v.* Howe, 1 *MacArthur Pat. Cas.* 366; Henry *v.* Providence Tool Co., 14 *Pat. Off. Gaz.* 855; 3 *Bann. & A. Pat. Cas.* 501. But compare to the contrary, American Hide, &c. Dressing Machine Co. *v.* American Tool Co., 1 *Holmes*, 503; 4 *Fish. Pat. Cas.* 284; and Egbert *v.* Lippman, 104 *U. S.* 333, 336.

The decisions are not agreed whether consent of the inventor to the public use, or sale, is necessary to render it operative in avoidance of the patent; though the language of the opinion of Justice Wood, in Manning *v.* Cape Ann Isinglass & Glue Co., 108 *U. S.* 462, implies that its necessity is not recognized. To like effect, see

Egbert *v.* Lippman, 15 *Blatchf.* 295, aff'd on other points, 104 *U. S.* 333 ; Andrews *v.* Hovey, 16 *Fed. Rep'r*, 387, 403 ; Kelleher *v.* Darling, 14 *Pat. Off. Gaz.* 673 ; and to the effect that unless the inventor consents to the prior use he does not lose his right, Davis *v.* Fredericks, 19 *Fed. Rep'r*, 99 ; Emery *v.* Cavanagh, 17 *Fed. Rep'r*, 242 ; Campbell *v.* Mayor, 9 *Fed. Rep'r*, 500 ; Elizabeth *v.* Paving Co., 97 *U. S.* 126, 136.

Under the act of 1793, §§ 3, 6, and the act of 1836, §§ 6, 15, the public use or sale of an invention, in order to deprive the inventor of his right to a patent, must be a public use or sale by others with his knowledge and consent, before his application for a patent. If the use or sale is without such knowledge or consent, or if the use be merely experimental, to ascertain its value or utility, or the success of the invention by putting it into practice, that is not such a use as will deprive the inventor of his title. Ryan *v.* Goodwin 3 *Sumn.* 514 ; 3 *L. Rep'r*, 220 ; Wyeth *v.* Stone, 1 *Story*, 273 ; 4 *L. Rep'r*, 54 ; Pierson *v.* Eagle Screw Co., 3 *Story*, 402 ; Jones *v.* Sewall, 3 *Cliff.* 563 ; Wimans *v.* New York & Harlem R. R., 31 *Jour. Fr. Inst.* 3*rd S.* 32 ; Campbell *v.* New York, 9 *Fed. Rep'r*, 500 ; 20 *Blatchf.* 67 ; 20 *Pat. Off. Gaz.* 1817.

223. *Limits and Exceptions to the Rule Restricting Public Use.*

The use of an invention by the inventor himself, for the purposes of experiment, though continued for more than two years, will not deprive him of his right to a patent (Jones *v.* Sewall, 3 *Cliff.* 563 ; 3 *Pat. Off. Gaz.* 650 ; 6 *Fish. Pat. Cas.* 343 ; Sisson *v.* Gilbert, 9 *Blatchf.* 185 ; 5 *Fish. Pat. Cas.* 109 ; Morris *v.* Huntington, 1 *Paine*, 348 ; McMillin *v.* Barclay, 4 *Brews.* 275 ; 3 *Pittsb.* 377 ; 5 *Fish. Pat. Cas.* 189 ; Birdsell *v.* McDonald, 6 *Pat. Off. Gaz.* 682), especially where it has resulted in a change in the construction of the machine. Andrews *v.* Carman, 13 *Blatchf.* 307.

Public use of an invention, unless by the patentee himself, for profit, or by his consent or allowance, will not work a forfeiture of his title, as forfeiture is not favored, unless it clearly appears that the use was solely for profit, and not with a view of further improvements or of ascertaining its defects, or for any other purpose of experiment in reducing the invention to practice. Emery *v.* Cavanagh, 17 *Fed. Rep'r*, 242 ; 16 *Rep'r*, 100.

Under the laws of 1793 and 1839, § 7, it was *held*, that the

public use, to avoid a patent, must not be a private or surreptitious use in fraud of the patentee, but a public use by his consent, by a sale by himself, or by others with his acquiescence, by which he abandoned his right, or disabled himself from complying with the law; a patentee might take a reasonable time to try experiments with his invention, or might exhibit and explain it to persons whom he desired to consult; only such prior use as implied an abandonment involved a forfeiture of the right. Sanders *v.* Logan, 2 *Pittsb.* 241; Whitney *v.* Emmett, *Baldw.* 303.

Proof of use of the thing patented between the dates of the original and the reissued patents, will not defeat an action for infringement of the reissued patent. Battin *v.* Taggart, 17 *How.* 74, 84.

To constitute a prior use in public, which impairs a patent, the use must have been of the very improvement patented. Where it was of a less perfect article (not merely a colorable variation), no dedication results, although such article may embody features in common with what was patented thereafter. Draper *v.* Wattles, 16 *Pat. Off. Gaz.* 629; 3 *Bann. & A. Pat. Cas.* 618.

224. *Effect of Placing Invention on Sale.*

A single conditional sale of an invention, more than two years before an application, works a forfeiture of the patent. Henry *v.* Francestown Soapstone Co., 2 *Fed. Rep'r*, 78; 17 *Pat. Off. Gaz.* 563; 9 *Rep'r*, 706; 5 *Bann. & A. Pat. Cas.* 108.

A patent is void, if, more than two years before the application therefor was filed, the patentee sold the patented articles for the double purpose of realizing the proceeds and of seeing if they would sell, and others had them in actual use. Consolidated Fruit Jar Co. *v.* Wright, 6 *Pat. Off. Gaz.* 327; 12 *Blatchf.* 149.

If necessary, in making tests, an inventor may sell a machine on trial so as to get it fully and fairly tested in practical use, by the class of persons for whose use it is intended; and such sale or use, even for more than two years, if made for the purpose of practical test, will not be a sufficient sale or public use to invalidate the patent. Graham *v.* Geneva Lake Crawford Manuf. Co., 11 *Fed. Rep'r*, 138; 21 *Pat. Off. Gaz.* 1536.

The claim to an invention is not invalidated by a stipulation for its sale, made before it was completed. Sparkman *v.* Higgins, 1 *Blatchf.* 205.

The law permits an inventor to place a machine he is developing in friendly hands for the purpose of testing it, and if the machine is strictly an experiment, made solely with a view to perfect the device, the exclusive right of the inventor remains unimpaired. But when he puts his incomplete device upon the market, and sells it as a manufacturer more than two years before he applies for his patent, he gives to the public the device in the stage of development in which he sells it, and the patent cannot relate back to cover the forms it then had. Lyman *v.* Maypole, 19 *Fed. Rep'r*, 735.

225. *Decisions Illustrating the Doctrine as to Public Use or Sale.*

Laying a new kind of wooden pavement in a public city street, where it was in public view and was traveled upon for several years, done after filing a caveat for the invention and for purposes of experiment and improvement, was *held* not such public use as would avoid a patent. Elizabeth *v.* Pavement Co., 97 *U. S.* 126.

A machine used for a number of years in the ordinary course of business, was *held* not an experimental machine; and, that such use was "public" although the shop where the machine was operated was kept locked, and no one but the workmen were allowed to examine it. Perkins *v.* Nashua Card, &c. Co., 2 *Fed. Rep'r*, 451; 17 *Pat. Off. Gaz.* 1852; 10 *Rep'r*, 7; 5 *Bann. & A. Pat. Cas.* 395.

In the case of an improvement in the construction of cars for railroads, it was *held*, that as experiments to test the value of the invention could not be made except by putting the car into the service of lines of railroads, the use of cars, for such purpose, did not render the patent void. Winans *v.* Schenectady & Troy R. R. Co., 2 *Blatchf.* 279. To the contrary, in a case of a prolonged use of an improvement upon steamboats. McMillin *v.* Barclay, 4 *Brews.* 275; 3 *Pittsb.* 377.

Nearly eight years before applying for a patent, the inventor voluntarily, and without reserve, sold a device embodying the invention, to a third party; knowing that it would be (and it was) publicly used. Such public use was *held* to have invalidated the patent. Schneider *v.* Thill, 5 *Bann. & A. Pat. Cas.* 565.

The public use of an invention was *held* not experimental, where the inventor himself manufactured and sold machines containing the invention, and allowed such machines to be used for

several years before applying for his patent. Sisson *v.* Gilbert, 9 *Blatchf.* 185 ; 5 *Fish. Pat. Cas.* 109.

A public use of an invention (an improvement in steam fire-engine pumps), which was in its nature intended for public use, was *held*, under the circumstances, experimental merely, and not to render subsequent patent invalid. Campbell *v.* New York, 9 *Fed. Rep'r*, 500 ; 20 *Blatchf.* 67 ; 20 *Pat. Off. Gaz.* 1817.

Where a machine, for which a patent was afterwards claimed, was freely put into numerous mills which the inventors were employed to construct, throughout a period exceeding two years the facts were *held* to show a clear case of abandonment ; as such use of the invention could not be called experimental. Sanders *v.* Logan, 2 *Fish. Pat. Cas.* 167 ; 9 *Am. L. Reg.* 475 ; 2 *Pittsb.* 241.

The use of an invention for a fare register and recorder upon street railway cars, in the only manner in which it could be conveniently used, for the purpose of actual experiment to ascertain the best mode of construction, was *held* not such a public use as would invalidate a patent for the invention applied for more than two years afterwards. Railway Register Manuf. Co. *v.* Broadway & Seventh Ave. R. Co., 22 *Fed. Rep'r*, 655 ; 30 *Pat. Off. Gaz.* 180. But see decision granting rehearing, 32 *Pat. Off. Gaz.* 257 ; and in action on rehearing, 34 *Pat. Off. Gaz.* 921.

In an action for infringement of a patent for corset steels, it appeared that more than two years before applying for a patent the inventor made a pair of steels, and afterwards another pair for a lady to whom he was engaged, and who wore them until they were worn out ; also that he made a third pair for another lady. It was *held* that this was a use of the invention which was equivalent to an abandonment. It was not a use for experiment, or a use in private ; but a practical use of the completed article. No secrecy was maintained or enjoined. It was a disposal of the article for the general use of the recipient. Egbert *v.* Lippman, 15 *Blatchf.* 295 ; 14 *Pat. Off. Gaz.* 822 ; aff'd, 104 *U. S.* 333.

226. *The Invention had been Abandoned to the Public.*

The question of abandonment does not turn upon the intention of the inventor ; whatever may be his intention, if he suffers his invention to go into public use, through any means whatever, without an immediate assertion of his right, he is not entitled to a patent; nor will a patent, obtained under such circumstances, protect

his right. And it makes no difference by what means an invention may be communicated to the public before a patent is obtained; any acquiescence in public use, by the inventor, will be an abandonment as towards the public. Shaw *v.* Cooper, 7 *Pet.* 292, 320.

Acts of an inventor claimed to be a dedication, are to be construed liberally; that is, he is not estopped by licensing a few persons to use his invention, in order to ascertain its utility, or by any such acts of peculiar indulgence and use, as may fairly consist with the clear intention to hold the exclusive privilege. Mellus *v.* Silsbee, 4 *Mas.* 108.

The inventor alone is competent to abandon his invention, and no use by the public, except with his knowledge and consent, can be deemed an abandonment of his patent. Pierson *v.* Eagle Screw Co., 3 *Story*, 402.

Acquiescence by the patentee in the use by the defendant of an original defective patent, does not authorize the use of the invention after the issuing of a reissued patent.. McWilliams Manuf. Co. *v.* Blundell, 22 *Pat. Off. Gaz.* 177; 11 *Fed. Rep'r*, 419.

Neither a stipulation for the sale of an invention before it is completed, nor a sale of such invention during the application for the patent, is an abandonment, or such a use as gives it to the public. Sparkman *v.* Higgins, 1 *Blatchf.* 205; 5 *N. Y. Leg. Obs.* 122; 6 *Pa. L. J.* 313.

Abandonment or dedication of an invention is in the nature of a forfeiture of a right. The law does not favor it, and it should be made out beyond all reasonable doubt. Pitts *v.* Hall, 2 *Blatchf.* 229. And see Seymour *v.* McCormick, 16 *How.* 480; rev'g 2 *Blatchf.* 240; McMillin *v.* Barclay, 4 *Brews.* 275; 3 *Pittsb.* 377; Hovey *v.* Henry, 3 *West. L. J.* 153.

An invention may be abandoned to the public within two years prior to the procurement of a patent. The mere use or sale of the invention, however, within the two years, will not alone or of itself work an abandonment. The use or sale must be accompanied by some declaration or acts going to establish an intention on the part of the inventor to give to the public the benefit of the improvement. Pitts *v.* Hall, 2 *Blatchf.* 229.

But declarations of an intention to dedicate an invention to the public will not be regarded as equivalent to an actual dedication. Besides words, there must be acts, in order to fasten on a patentee the intention, which, in judgment of law, will work an abandonment of his invention. *Ib.*

Adverse knowledge and use of the device claimed, prior to the patentees' invention thereof, on a machine which was never completed, the device itself not being patented or otherwise given or made accessible to the public until long after the issue of complainant's patent, will not invalidate the exclusive right of the patentees. Bullock Printing Press Co. *v.* Jones, 13 *Pat. Off. Gaz.* 124; 3 *Bann. & A. Pat. Cas.* 195.

The omission by an inventor to claim a combination or device apparent upon the face of his patent, amounts to a dedication of the neglected contrivance to the uses of the public. Swift *v.* Jenks, 19 *Fed. Repr.* 641. To same effect, Hawes *v.* Gage, 5 *Pat. Off. Gaz.* 494; *Re* Conklin, 1 *MacArthur*, 375.

Where a device has been used by a prior inventor, but discontinued, a subsequent inventor cannot take it up and appropriate it exclusively. The invention thus becomes public property. Shoup *v.* Henrici, 22 *Int. Rev. Rec.* 114; 11 *Phila.* 514; 2 *Bann. & A. Pat. Cas.* 249.

An abandonment of a mechanical structure, the operative merit of which has been demonstrated by trial, will inure to the public, and an injunction cannot be obtained by a subsequent (even though original), inventor of substantially the same machine, who has obtained a patent therefor. Pickering *v.* McCullough, 6 *Rep'r*, 101.

The abandonment of a practical device by its inventor furnishes no warrant for a subsequent patentee to claim it as inventor. McNish *v.* Everson, 2 *Fed. Rep'r*, 899; 17 *Pat. Off. Gaz.* 1506; 5 *Bann. & A. Pat. Cas.* 484.

An abandoned experiment is not such a publication as will render invalid a patent subsequently granted for an invention similar to the thing experimentally produced. Pickering *v.* Miller, 15 *Rep'r*, 645; 25 *Pat. Off. Gaz.* 89.

The rule on the question of abandonment of an invention after application for letters patent is, that after the issue of letters patent, the abandonment must be shown to be positive, actual and intentional, by some act or declaration of the inventor, or by such gross laches as indicates unmistakably an intention to abandon the invention to the public. Johnsen *v.* Fassman, 1 *Woods*, 138; 5 *Fish. Pat. Cas.* 471.

The true meaning of the word "abandonment," as used in the acts of Congress relating to patents, is an abandonment of the invention to the public; a dedication by the inventor of his discov-

cry to the free use of his fellow-beings. His merely withholding his invention from the public can never amount to an abandonment, however it may increase the difficulty of asserting and proving priority over another inventor. Babcock *v.* Degener, 1 *MacArthur Pat. Cas.* 607.

If an inventor abandon his invention, any patent subsequently issued to him therefor is invalid. Consolidated Fru't Jar Co. *v.* Bellaire Stamping Co., 27 *Fed. Rep'r*, 377.

227. *By Delay in applying for Patent, or in prosecuting Application.*

Although the invention was original with the patentee and he was otherwise entitled, on seasonable application, to a patent, yet if the inventor delayed applying, and made his invention known, and suffered it to be used by the public without objection, his doing so will operate as an abandonment or dedication of it to the public. Pennock *v.* Dialogue, 2 *Pet.* 1; aff'g 4 *Wash.* 538; Kendall *v.* Winsor, 21 *How.* 322; Whittemore *v.* Cutter, 1 *Gall.* 478; Mellus *v.* Silsbee, 4 *Mas.* 108; Thompson *v.* Haight, 1 *U. S. L. J.* 375; Winans *v.* Schenectady & Troy R. R. Co., 2 *Blatchf.* 270; Evans *v.* Eaton, *Pet. C. Ct.* 322; see reversal, 3 *Wheat.* 454; Treadwell *v.* Bladen, 4 *Wash.* 703; Whitney *v.* Emmett, *Baldw.* 303.

The mere forbearance on the part of an inventor to apply for a patent during the progress of experiments, and until he has perfected his invention, and tested its value by actual practice, affords no just grounds for any presumption that he has abandoned his invention, and surrendered or dedicated it to the public. Agawam Co. *v.* Jordan, 7 *Wall.* 583; Jones *v.* Sewell, 8 *Pat. Off. Gaz.* 630; 3 *Cliff.* 363; 6 *Fish. Pat. Cas.* 343; Henry *v.* Francestown Soapstone Stove Co., 9 *Pat. Off. Gaz.* 408; 2 *Bann. & A. Pat. Cas.* 221; Russell, &c. Manuf. Co. *v.* Mallory, 10 *Blatchf.* 140; 2 *Pat. Off. Gaz.* 495; *Fish. Pat. Cas.* 632; Locomotive Engine Safety Truck Co. *v.* Pennsylvania R. R. Co., 10 *Phila.* 252; 1 *Bann. & A. Pat. Cas.* 470.

If the prior invention was only an experiment, never perfected, but abandoned, the mere fact of an unsuccessful application for a patent makes no difference; it can only have a bearing on the

question of prior invention or discovery. Brown *v.* Guild, 23 *Wall.* 181 : Putnam *v.* Hutchinson, 12 *Fed. Rep'r*, 127.

Inventors may, if they can, keep their inventions secret, and, if they do, no neglect to petition for a patent will forfeit their right to apply for one. Bates *v.* Coe, 98 *U. S.* 31.

Where an invention is voluntarily broken up and laid aside, through discouragement or dissatisfaction, yet not wholly with the intention of abandonment, and without any controlling impediment in the way of an application for a patent, and another, in the meantime, invents the same thing, without any knowledge of that which was so suspended, and having reduced the same to practice, applies for and takes out his patent, and introduces the patented invention into public use, the latter must be considered as the original inventor, rather than the one who laid his invention aside. But where some of the parts used in an inventor's experiment were preserved by him and finally embodied in his model for the patent office, and the evidence indicates that he only intended to postpone his application for the patent until certain objections to his making such application, not relating to the completeness of his invention, ceased to exist, it was *held* that the invention had not been abandoned. White *v.* Allen, 2 *Cliff.* 224 ; 2 *Fish. Pat. Cas.* 440.

Unavoidable delay while an application for a patent is pending is no ground for imputing abandonment. Jones *v.* Sewall, 3 *Cliff.* 563 ; 3 *Pat. Off. Gaz.* 630 ; 6 *Fish. Pat. Cas.* 343.

While an inventor has an application for a patent pending in the patent-office, and presses it from time to time as his means allow, he cannot be charged with having abandoned his improvement, although eight years elapse before he succeeds. Goodyear Dental Vulcanite Co. *v.* Smith, 1 *Holmes*, 354 ; 5 *Pat. Off. Gaz.* 585.

Where it appeared, by the admissions of the patentee, that the improvement claimed was invented in 1844, and that it was not embodied in the original patent of 1845, or noticed therein, until more than fourteen years after the invention, it was *held* that this rendered the claim void. Sickels *v.* Falls Co., 4 *Blatchf.* 508 ; 2 *Fish. Pat. Cas.* 202.

If a party, upon the rejection of his application, withdraws all the papers except a drawing, and then permits his invention to go into notorious public use for a long time, the application will be deemed to be abandoned. Bevin *v.* East Hampton Bell Co., 5 *Fish. Pat. Cas.* 23 ; 9 *Blatchf.* 50.

The effect of the provision of the act of 1870, § 35 (now Rev. Stat. § 4897),—that upon the hearing of the renewed application therein referred to, abandonment should be considered as a question of fact,—is that delay is not, of itself, conclusive evidence of abandonment, but the decision of each case depends upon the peculiar circumstances, treating the question as one of fact and not of law. United States Rifle, &c. Co. *v.* Whitney Arms Co., 11 *Pat. Off. Gaz.* 373; 14 *Blatchf.* 94; 2 *Bann. & A. Pat. Cas.* 493.

Rev. Stat. § 4894, —which provides that upon failure to prosecute an application within two years after action is had thereon by the patent-office, it shall be regarded as abandoned,—refers to the application, not the invention; and does not prevent a subsequent application for the same invention. But such subsequent application can derive no aid as to the time from the prior abandoned application. The applicant must stand as to defenses in suits on the patent, as if the new application were the first. Lindsay *v.* Stein, 10 *Fed. Rep'r*, 997; 20 *Blatchf.* 370; 21 *Pat. Off. Gaz.* 1613.

Delay caused by public officials or courts cannot affect the rights of an applicant for a patent, where gross laches cannot be imputed to him; but one who does not prosecute his application with reasonable diligence may justly be treated as having abandoned it. Adams *v.* Jones, 2 *Pittsb.* 73.

So, if two distinct improvements in the same machine, are applied for jointly and covered by one patent, and if the inventor is mistaken as to one of the improvements claimed, but is entitled to a patent as to the other, he cannot be justly said to have abandoned either, during a litigation as to his right to both. *Ib.*

Delay in filing an application for a patent, or in prosecuting one punctually filed is no ground for charging the inventor with abandonment where the cause was, that he resided in the insurrectionary States during the rebellion. Knox *v.* Lowerce, 6 *Pat. Off. Gaz.* 802; 1 *Bann. & A. Pat. Cas.* 589.

A patentee cannot be charged with having abandoned his invention because his solicitors, without his knowledge, neglect to file his application in the patent-office for more than two years after it has been sworn to, and was in all respects complete. Birdsell *v.* McDonald, 6 *Pat. Off. Gaz.* 682.

The provision of the act of 1870, § 35, for the renewal of rejected and withdrawn applications, is subject to the implied condition that the applicant has not lost his right to make the

application by abandonment or surrender of the same. Marsh *v.* Commissioner of Patents, 3 *Biss.* 321 ; S. C., *sub nom.* Marsh *v.* Sayles, 2 *Pat. Off. Gaz.* 340 ; 5 *Fish. Pat. Cas.* 610.

A patentee, who delays prosecuting infringers, for the reason that his patent is defective, and a reissue is necessary, but who meantime collects information which will enable him to sue the infringers, is not guilty of laches. American Middlings Purifier Co. *v.* Christian, 3 *Bann. & A. Pat. Cas.* 42.

As to abandonment of drawings, or of a model, of a machine made in the course of experiments which the inventor did not prosecute, and a patent for which he never applied. See Lyman V. & R. Co. *v.* Lalor, 12 *Blatch.* 303 ; 1 *Ban. & Ard.* 403; 6 *Pat. Off. Gaz.* 642 ; Eickemeyer Machine Co. *v.* Pearce, 6 *Fish.* 219 ; 3 *Pat. Off. Gaz.* 150 ; 10 *Blatch.* 403.

If an application for a patent on an invention is refused, and the inventor casts aside his invention, he thereby makes it public property, and cannot take it back and make it again his own. Consolidated Fruit Jar Co. *v.* Bellaire Stamping Co., 27 *Fed. Rep'r,* 377.

228. *Examples of Abandonment under Peculiar Circumstances.*

One sued for an infringement has the right to show long delay of the inventor to prosecute his application for a patent when at first rejected ; it is an abandonment. W., in 1849, applied for letters patent for an improvement in planing machines. It was rejected, and he was notified he might " withdraw or appeal." He did not appeal ; and in 1852 the attorney by whom the application was made withdrew it. W. made no attempt to have it reinstated until 1870. During the intervening period he was not prevented by sickness or poverty from prosecuting the claim, had he desired; for he took out other patents. And machines embodying the principle of his invention came into use. It was *held,* that his delay was an abandonment ; and avoided a patent which was finally granted to him on the application made in 1870. Woodbury Planing-machine Co. *v.* Keith, 4 *Bann. & A. Pat. Cas.* 100 ; aff'd, 101 *U. S.* 479.

When an inventor takes out a patent founded on a claim which does not include his whole invention, and rests for twelve years, and then surrenders his patent and takes a reissue with a broader

claim, under circumstances which warrant the conclusion that the act is caused by successful competition of a rival, he will be held to have dedicated to the public so much of his invention as was not included in the original claim. Turner & Seymour Manuf. Co. *v.* Dover Stamping Co., 111 *U. S.* 319.

An inventor, at the time of making his invention, intended to apply for a patent, but was misled and induced to believe his invention had been anticipated by a patent of prior date. While laboring under this impression he decided to keep the invention secret, and practice it for his own benefit. As soon as he was undeceived, he began his preparations for an application for a patent. It was *held*, that such delay did not render him liable to forfeit his right to the patent. Ayling *v.* Hull, 2 *Cliff.* 494.

Where a machine similar to that described in the plaintiff's patent existed twenty years before, and only a single person testified to more than an experimental use of it, and it was soon after abandoned, it was *held*, that it did not invalidate the patent. Blake *v.* Rawson, 3 *Biss.* 77; 3 *Pat. Off. Gaz.* 122; 6 *Fish. Pat. Cas.* 74.

A machine was constructed in 1852, was kept in the cellar of the maker, was occasionally used there, and existed at the time of the plaintiff's invention, but its existence and use were not made public; the defendant, though the son of the maker, constructed a different machine for the same purpose, until he heard of the machine of plaintiff, in 1864, when he remembered and brought out and used the old machine. It was *held*, that this machine was an abandoned and lost invention, and its existence was no bar to a recovery by plaintiff, especially as the plaintiff had no knowledge of its existence at the time of his invention. Hall *v.* Bird, 6 *Blatchf.* 438; 3 *Fish. Pat. Cas.* 595.

An invention was *held* to have been abandoned when the author, after having reduced it to perfection and actual practice, took no further measures with it for nine years and suffered the molds to be lost, and meanwhile others, independently of him, reduced it to practice and introduced it extensively into market. Consolidated Fruit Jar Co. *v.* Wright, 6 *Pat. Off. Gaz.* 327; 12 *Blatchf.* 149.

Where an inventor perseveres in his application for a patent, although he may file several applications, some of which are withdrawn, and merely suspended operations until he could obtain means, the delay was *held* not an abandonment. Adams *v.* Edwards, 1 *Fish. Pat. Cas.* 1, 11.

Where an inventor made application for a patent for his invention, which was denied by the commissioner and affirmed on appeal to the circuit court, but afterward allowed by a new commissioner, the inventor continually insisting upon his rights, it was *held* that these involuntary delays, being mistakes of public officers or the delays of courts, and not caused by laches of the inventor, should not work an abandonment. Adams *v.* Jones, *Id.* 527; see also, Sayles *v.* Chicago & Northwestern R. R. Co., 2 *Fish. Pat. Cas.* 523.

Where an inventor has delayed eighteen years after completion of his invention before applying for a patent, and after having obtained a patent, delayed five years before applying for a reissue, and during this time made several improvements for which he obtained patents; it was *held* that the subject-matter not claimed in the original was abandoned to the public. *Re* Conklin, 1 *MacArthur*, 375.

As to what amounts to abandonment, see, also, Bell *v.* Daniels, 1 *Fish. Pat. Cas.* 372; American Hide, &c. Dressing Machine Co. *v.* American Tool, &c. Co., 1 *Holmes*, 503; 4 *Fish. Pat. Cas.* 284; Thompson *v.* Haight, 1 *U. S. L. J.* 563; McGaw *v.* Bryan, *Id.* 582.

Where an inventor applied for a patent and his application was rejected, he making no appeal, nor any application for a re-examination, until ten years had elapsed, when he made a new application, paying a new fee; and where, in the meanwhile, his invention had gone into general use, it was *held*, that the first application had been abandoned, and that the patent upon the second was void, because of the public use, long continued, with the inventor's approval. Bevin *v.* East Hampton Bell Co., 9 *Blatchf.* 50; 5 *Fish. Pat. Cas.* 23.

H. and T. filed their application January 27, 1855. It was rejected, and they withdrew it June 11, 1856, for the purpose of filing a new application, which was prepared and sent to their attorney in April, 1857; but the latter failed to file it until February 26, 1858, and the patent was issued thereon March 15, 1858. It was *held*, that there was a continuous application, and no evidence of abandonment. Howes *v.* McNeal, 15 *Pat. Off. Gaz.* 608; 15 *Blatchf.* 103; 3 *Bann. & A. Pat. Cas.* 376.

Where nothing was relied upon to defeat complainant's patent but the inventor's delay in prosecuting his application, it having been finally rejected by the commissioner April 11, 1857, and not appealed until August 16, 1860, during four years of which time

the patent-office was closed to him, by reason of his residence in a State that was in rebellion, it was *held*, that no direct or implied abandonment was shown. Johnsen *v.* Fassman, 5 *Fish. Pat. Cas.* 471 ; 1 *Woods*, 138.

Where an inventor whose application was rejected and withdrawn in 1851, delayed to renew it until 1869, and meanwhile, in 1859, a patent, on substantially the same improvement, was granted to another, the existence of which patent became known to the first inventor in 1865, it was *held*, that the legal inference from these facts was, that he acquiesced in the action of the patent office, and abandoned whatever claim he had to the public. Marsh *v.* Commissioner of Patents, 3 *Biss.* 321 ; S. C., *sub nom.* Marsh *v.* Sayles, 2 *Pat. Off. Gaz.* 340 ; 5 *Fish. Pat. Cas.* 610.

It is not material whether the rejection of his claim was right or wrong. Even if wrong, he was obliged, if he insisted on his claim, to take some action on the subject within a reasonable time, either by an appeal from the commissioner, or by a bill in equity, in the proper court. *Ib.*

An application for a patent made within the two years required by the statute, was rejected, the claim being defective and not covering the real invention. Another application was made within a reasonable time, but not within the two years from the date of public use, upon the same specifications and drawings, with a corrected claim covering the invention, upon which a patent issued. It was *held*, that under the circumstances, the two applications, for the purposes of the two years, would be regarded as one continuous proceeding dating from the filing of the first application. Smith *v.* Prior, 2 *Sawyer*, 461 ; 4 *Pat. Off. Gaz.* 633 ; 6 *Fish. Pat. Cas.* 469.

A claim in a reissued patent of a device not suggested in the original patent or in the drawing annexed thereto, but only by a model preserved in the patent-office, was *held*, under the circumstances of the case, invalid ; the omission of the patentee, for a period of eight years, to obtain a correction of his patent being deemed to operate as a dedication to the public of all not claimed by him in the original. Flower *v.* Detroit, 22 *Fed. Rep'r*, 292. And see Matbews *v.* Flower, 25 *Id.* 830.

Continued poverty, sickness and mental alienation are *held* sufficient excuses for delay in procuring a patent, there being no circumstances in the case showing any intention of abandonment.

Celluloid Manuf. Co. *v.* Crofut, 24 *Fed. Rep'r*, 796; 33 *Pat. Off. Gaz.* 235.

229. *Failure to Mark the Article "Patented."*

By Rev. Stat. § 4900, it is made a good defense to a recovery of damages for infringement, that the article was sold without being marked "patented" (with date of patent) unless the defendant continued dealing in it after notice that he was infringing. (See *ante*, p. 141.)

The defense of omission of the stamp "patented," fails if the word was affixed in any manner or on any part of the article; or if defendant had even oral notice of the patent. New York Pharmical Assoc. *v.* Tilden, 23 *Pat. Off. Gaz.* 272; 15 *Fed. Rep'r*, 98.

It is not defeated by proof that the nature of the article was such as to render affixing the mark specially expensive. Putnam *v.* Sudhoff, 1 *Bann. & A. Pat. Cas.* 198.

That this defense should be set up by answer, see Rubber Co. *v.* Goodyear, 9 *Wall.* 788; Herring *v.* Gage, 15 *Blatchf.* 124; 3 *Bann. & A. Pat. Cas.* 396.

230. *Matters of Defense Peculiar to Reissue Patents.*

Rights upon a reissue patent will not be defeated because the reissue appears not to be for the same invention as the original, if such result may be avoided by giving it a liberal construction. Glue Co. *v.* Upton, 4 *Cliff.* 237; 1 *Bann. & A. Pat. Cas.* 497; 6 *Pat. Off. Gaz.* 837; see aff'ee 97 *U. S.* 3.

No action can be brought for acts infringing a patent, where, after the acts complained of, the patent has been surrendered for reissue; for surrender for reissue is equivalent to a distinct admission that the original patent has no such validity as will entitle the patentee to an action for infringement; and the new patent, as a ground of action, can be operative only from its date. Moffitt *v.* Farr, 1 *Black*, 273; aff'g 1 *Bond*, 315.

A reissued patent for a process of compressing the coating used in the insulation of telegraph wires, was *held* void for anticipation by English patents; and the patent for the process being void, the invalidity of the patent for the product follows as a consequence.

Western Electric Manuf. Co. *v.* Ansonia Brass, &c. Co., 114 *U. S.* 447.

The fact that a new claim embodied in a reissue patent is adjudged void, does not impair the validity of another, which is only a restatement of one in the original patent; but the patentee, upon disclaiming the void claim, may have a decree (without costs) for infringement of the old and valid one. Yale Lock Manuf. Co. *v.* Sargent, 117 *U. S.* 536.

A patentee cannot be charged with fraud for asserting the validity of his reissue and claiming damages for its infringement, when the reissue was valid at the time of reissue, but by reason of a subsequent change in the rule of construction in the courts, has become invalid. Pope Manuf. Co. *v.* Owsley, 27 *Fed. Rep'r*, 100.

A reissue is void if there is an unwarrantable enlargement of the original patent. Hoe *v.* Knap, 27 *Fed. Rep'r*, 204.

When a patent has been surrendered for the purpose of securing a wider monopoly, and the specifications and claims of the reissue are identical with those of the original, the patent is abandoned and the reissue is a nugatory grant, because the precedent conditions therefor did not exist. Celluloid Manuf. Co. *v.* Zylonite Brush & Comb Co., 27 *Fed. Rep'r*, 291.

The taking of a second or subsequent reissue, in order to reinstate the specification and claims of the original, precludes the assumption that the original was inoperative or invalid. A reissue of a patent granted merely to re-instate a patentee to an invention which he had surrendered, in order to obtain a wider monopoly, is valid. Where a patentee accepts a reissue containing the same claims as the original, he thereby declares that as to the invention he now claims, the original was not inoperative and void. *Ib.*

A reissue which seeks to cover something not suggested in the original patent, is void because of unlawful expansion. Schultz *v.* Ostrander, 27 *Fed. Rep'r*, 295.

The appropriate remedy where integral portions of an invention, proper subject-matter for a patent have been omitted from it, is a reissue; the rights omitted cannot be secured by a distinct patent for them; nor can the legal effect of the patent first issued be removed, except by surrender. Hill *v.* Commissioner of Patents, 1 *Cent. Rep'r*, 91.

Charge of fraud in a reissue will not be considered in a suit for infringement. Schillenger *v.* Crawford, 2 *Cent. Rep'r*, 680.

231. *Various Excuses for the Infringement Charged.*

It is no excuse for infringing a part of a patented invention that such part is not necessary to the successful working of the invention as patented. Blaisdell *v.* Puffer, 4 *Bann. & A. Pat. Cas.* 500.

An agreement for the transfer of the invention for the joint benefit of the inventors and those who will advance money for the manufacture or use of the machines invented, not carried into execution, and unaccompanied by any public use of the machine, but being prospective in its character, not consummated until within two years of the application, does not affect the validity of the patent. Elm City Co. *v.* Wooster, 6 *Fish. Pat. Cas.* 452 ; 4 *Pat. Off. Gaz.* 83.

Defendants were authorized to use one patented machine, and only one. They constructed and used two. It was *held* that they were not relieved from liability, by proof that both were never in operation at the same time. Bloomer *v.* Gilpin, 4 *Fish. Pat. Cas.* 50.

A person who infringes a patent is liable for the infringement, although what he does may be an improvement upon the patented device. De Florez *v.* Raynolds, 14 *Blatchf.* 505 ; 3 *Bann. & A. Pat. Cas.* 292. S. P., Turrell *v.* Spaeth, *Id.* 458.

When a license has been revoked by a plaintiff, and a defendant is sued as a naked infringer, he is at liberty to avail himself of any defense ordinarily open to a defendant charged with infringement. Wooster *v.* Singer Manuf. Co., 23 *Pat. Off. Gaz.* 513 ; 15 *Rep'r*, 524.

It is no defense to an infringement suit that the complainant has not put his alleged invention into practical use. Broadnax *v.* Central Stock Yard, &c. Co., 5 *Bann. & A. Pat. Cas.* 609 ; 4 *Fed. Rep'r*, 214 ; 11 *Rep'r*, 6.

A license under a patent, other than the one sued upon, can have no independent efficacy in protecting the defendants. If such patent is for the same invention as the patent sued upon and of earlier date, it renders the patent sued upon void. If not for the same invention as the patent sued upon, it can confer no right to appropriate that invention. Stuart *v.* Shantz, 2 *Pat. Off. Gaz.* 524 ; 6 *Fish. Pat. Cas.* 35 ; 9 *Phila.* 376.

The manufacture of a separate element of a patented combina-

tion without intent of aiding an infringement, and not proved to be made for use in connection with the other elements, is not an infringement. Saxe *v.* Hammond, 1 *Bann. & A. Pat. Cas.* 629 1 *Holmes*, 456 ; 7 *Pat. Off. Gaz.* 781.

XVII. MEASURE OF RECOVERY OF DAMAGES, OR PROFITS, FOR INFRINGEMENT.

232. *Compensation for Actual Injury the General Rule.*

The plaintiff can recover only for actual damages, and he must show the damages by evidence. Where his profit is in the form of a royalty paid by licensees, and there are no peculiar circumstances, the recovery will be regulated by that standard. An instruction to the jury to award to the plaintiff "such sum as they should find to be required to remunerate him for the loss sustained by the wrongful act of the defendants, and to reimburse him for all such expenditures as have been necessarily incurred by him in order to establish his right," was *held* to be too broad and vague, and under which the jury could hardly doubt that it was their duty to allow counsel fees, and perhaps other charges and expenditures equally inadmissible. Philip *v.* Nock, 17 *Wall.* 460.

In cases where profits are the proper measure of damages, such profits as the infringer has made, or ought to have made, govern, and not those which the plaintiff can show that he might have made. This rule applies peculiarly and mainly to cases in equity, and is based upon the idea that as to such profits the infringer of the patent should be treated as a trustee for the owner thereof. In actions at law, the rate at which sales of licenses of machines were made, or the established royalty, constitutes the primary and true criterion of damages. In the absence of satisfactory evidence of that class, which is more appropriate in the forum where the case is pending, the other class may be resorted to as furnishing one of the elements on which the damages, or the compensation may be ascertained. Burdell *v.* Denig, 92 *U. S.* 716.

Although the defendant may have made no profits, and no license fee was established, yet where the sale of the infringing device has caused an enforced reduction of the price of the patented

device, this is the proper measure of damage. Yale Lock Co. *v.* Sargeant, 117 *U. S.* 536.

The rule is, that the verdict of the jury must be for the actual damages sustained by the plaintiff, subject to the right of the court to enter judgment for any sum not exceeding three times the amount of the verdict, together with costs. Birdsall *v.* Coolidge, 93 *U. S.* 64 ; 10 *Pat. Off. Gaz.* 748.

Where the unlawful acts consist in making and selling a patented improvement, or in its extensive and protracted use, without palliation or excuse, evidence of an established royalty will, in an action at law, undoubtedly furnish the true measure of damages ; but where the use is a limited one and for a brief period, the arbitrary and unqualified application of that rule is erroneous. *Ib.*

The plaintiffs must furnish evidence by which the jury may estimate actual damages. Damages cannot be calculated without certain data on which to proceed. If the plaintiff rest his case after merely proving an infringement, he is only entitled to nominal damages. New York *v.* Ransom, 23 *How.* 487. To same effect, Blake *v.* Robertson, 94 *U. S.* 728 ; Black *v.* Thorne, 111 *U. S.* 122 ; Whittemore *v.* Cutter, 1 *Gall.* 429. And see Knight *v.* Gavit, *Mir. Pat. Off.* 135 ; Whitney *v.* Emmet, *Baldw.* 303 ; Schillinger *v.* Gunther, 15 *Blatchf.* 303 ; 14 *Pat. Off. Gaz.* 713 ; Garretson *v.* Clark, 15 *Blatchf.* 70 ; 14 *Pat. Off. Gaz.* 485 ; Matthews *v.* Spangenberg, 14 *Fed. Rep'r*, 350 ; 14 *Rep'r*, 773 ; Burdell *v.* Denig, 2 *Fish. Pat. Cas.* 588.

The owner of a patent granted his interest in it to another, in consideration of certain payments to be made by the latter to third parties, &c. None of the payments were ever made ; and by mutual consent no part of the contract was ever carried out, because of the inability of the grantee. The grantor was obliged to pay the money which the grantee had agreed to pay ; and the latter, during his life, claimed no interest in the contract, but, on the contrary, recognized the exclusive right of the grantor, and acted as his agent in the patent, under a power of attorney, paying him part of the profits for the privilege. It was *held*, after the grantee's death, that the agreement did not prevent the grantor's bringing suit for the infringement of the patent without joining the grantee. Railroad Co. *v.* Trimble, 10 *Wall.* 367.

The price for which the plaintiff has sold his rights to certain territory is no criterion by which to determine the value of his patent, or the damages sustained from its infringement. Nor are

such damages to be estimated solely by the profits which the defendant actually realized, for he may have conducted his business unskillfully. The true question is, what advantage might the defendant, by skill, have obtained by using the patented device instead of the old device. Campbell *v.* Barclay, 5 *Biss.* 179.

In applying the provision of the statute, § 4921, that in a suit in equity the court may award, "in addition to the profits to be accounted for by the defendant, the damages complainant has sustained," it is pertinent to inquire as to whether the plaintiff has seen fit to retain a close monopoly of his invention, in which case the damages are computed by investigating the defendant's profits; or whether he saw fit to grant licenses to every one who offered to pay the stipulated fee, in which case the amount of such fee would be the proper measure of damage, except in cases of wanton infringement. Goodyear Dental Vulcanite Co. *v.* Van Antwerp, 2 *Bann. & A. Pat. Cas.* 252.

The rate of damages may now be said to be generally, 1. That the plaintiff may recover in equity the profits which the infringer has made from the use of the invention; or, 2. That he may recover at law the profits which were lost; and where it can properly be done, these profits will be regarded as simply the fee which would have been charged if the infringer had procured a license. But where the plaintiff has evinced an intention to exercise an exclusive user of his invention, and where the sales of licenses have been too few to establish a criterion of their actual or market value, courts have sought for other elements or evidences to determine the profits lost. McKeever *v.* United States, 14 *Ct. of Cl.* 396; 23 *Pat. Off. Gaz.* 1525; aff'd, *Id.* 1530; 18 *Ct. of Cl.* 757.

A patentee may either proceed in equity for the profits the defendant has made; or he may sue at law for the loss he has suffered. In the first case, if the defendant has realized no profit there can be no recovery; in the second, he may recover the damages he has sustained, whether the defendant has made any profit or not. Cowing *v.* Rumsey, 4 *Fish. Pat. Cas.* 275. But see Dental Vulcanite Co. *v.* Van Antwerp, 2 *Bann. & A. Pat. Cas.* 252.

There must be injury and damage; injury by a violation of the right, and damage, at least nominal, presumed by law to arise from such violation. Byam *v.* Bullard, 1 *Curt.* 100; 1 *Am. L. Reg.* 139.

But a sale of the thing patented to an agent of the patentee, employed by him to make the purchase, and on account of the

patentee, is not an act from which damage will be presumed, as it must be supposed to have been done for the patentee's benefit, or at least not to have been to his loss. Such a sale, however, accompanied by other circumstances, may warrant a jury in finding an infringement by sales to others than the patentee. *Ib.*

The general principle is, that the plaintiff is entitled to recover a fair and adequate compensation for the loss or injury he has sustained by the infringement. Taylor *v.* Carpenter, 2 *Woodb. & M.* 1; 10 *L. Rep'r*, 35; Hall *v.* Wiles, 2 *Blatchf.* 104; Pitts *v.* Hall, *Id.* 220; McCormick *v.* Seymour, 2 *Blatchf.* 240; Buck *v.* Hermance, 1 *Blatchf.* 398; Kneass *v.* Schuylkill Bank, 4 *Wash.* 9; Parker *v.* Hulme, 1 *Fish. Pat. Cas.* 44; 7 *West. L. J.* 428.

When a user of a machine in violation of a patent is proved, the value of the use of such a machine during the time of the illegal user is the measure of damage. Whittemore *v.* Cutter, 1 *Gall.* 478.

It is difficult to establish any general rule as to damages. The better course is not to lay down any particular rule of damages, but to leave the jury at large to estimate the actual damages according to the circumstances of each particular case. Earle *v.* Sawyer, 4 *Mas.* 1, 14.

The scope of a patented invention having been defined, and the court having declared that the damages could not exceed the profits arising from the use of the improvement, a failure to show any such profits makes nominal damages alone recoverable. Gould's Manuf. Co. *v.* Cowing, 14 *Blatchf.* 315; 12 *Pat. Off. Gaz.* 942; 3 *Bann. & A. Pat. Cas.* 75. And it was *held* no compliance with the rule that the profits arising from the use shall be proven, to show that wherever the particular patented improvement was introduced, other kindred devices could not be sold. *Id.*; Black *v.* Munson, 14 *Blatchf.* 265; but see 105 *U. S.* 253.

Where a patentee fraudulently leads a party to infringe his patent, and then brings an action against him, only nominal damages should be given. Washburn *v.* Gould, 3 *Story*, 122, 137; 7 *L. Rep'r*, 270; 1 *West. L. J.* 465.

When a patented invention, which is useless in itself, has been made useful by being combined with something else invented by another, or has been changed in its operation by an invention to which the owner of the worthless machine had no title or claim, the patentee of such worthless machine is not entitled to damages

for the use of it, although an injunction will be granted. Whitney *v.* Emmett, *Baldw.* 303, 329.

That, where a patent has been surrendered, and a reissue granted, no damages can be recovered for any acts of infringement committed prior to the reissue, see Peck *v.* Collins, 103 *U. S.* 660.

Upon a reference to ascertain the profits recoverable for infringement of a patent for improvements of devices previously in use, the burden is upon the complainant to prove the proportion of profits justly ascribable to his invention, and failing to prove this, he is entitled to only nominal damages. Bostock *v.* Goodrich, 25 *Fed. Rep'r*, 819 ; 34 *Pat. Off. Gaz.* 1047.

The profits of which the patentee is deprived by the manufacture or use of the device, only a single element of which is covered by his patent, constitute the measure of damages. Putnam *v.* Lomax, 10 *Biss.* 546 ; 9 *Fed. Rep'r*, 448.

Each claim of a patent covers a complete invention, and is, in substance, an independent patent. Celluloid Manuf. Co. *v.* Zylonite Brush & Comb Co., 27 *Fed. Rep'r*, 291.

Where there is no evidence as to the value of the use of a patent, only nominal damages can be allowed. Moffit *v.* Cavanagh, 27 *Fed. Rep'r*, 511.

The measure of damages for infringement is the amount the plaintiff would have made, had it not been for defendant's unlawful action. Hobbie *v.* Smith, 27 *Fed. Rep'r*, 656.

Where the claims infringed are unimportant, only nominal damages can be allowed. Moffit *v.* Cavanagh, 27 *Fed. Rep'r*, 511.

233. *Exemplary or Punitive Damages not Allowable.*

The jury are not to award what are known as exemplary, vindictive, or punitive damages. Seymour *v.* McCormick, 16 *How.* 480, 489 ; Whittemore *v.* Cutter, 1 *Gall.* 478 ; Hall *v.* Wiles, 2 *Blatchf.* 194 ; Pitts *v.* Hall, *Id.* 229, 238 ; Stimpson *v.* The Railroads, 1 *Wall. Jr.* 164, 169. To the contrary, Parker *v.* Corbin, 4 *McLean*, 492.

Punitive damages for infringement are not to be visited upon a defendant who is not a willful infringer, but manufactures under a rival patent. Buerk *v.* Imhaueser, 10 *Pat. Off. Gaz.* 907 ; 14 *Blatchf.* 19 ; 2 *Bann. & A. Pat. Cas.* 452.

The question of damages is exclusively with the jury, and if

they are of the opinion that the defendant has unlawfully infringed, they ought to award plaintiff such sum, as, in their judgment, founded upon the evidence, would fully indemnify him for the actual damages he had suffered beyond the taxable costs. Foote *v.* Silsbee, 1 *Blatchf.* 445, 459 ; aff'd, 14 *How.* 218.

Where the defendants entered upon the violation of the plaintiff's patent, after having been warned of the consequences, and went on with their eyes open, disregarding the claims of the patentee, and showing a willingness to avail themselves of the profits of his discovery, and to deprive him of the fruits of his genius, time and expense ; it was *held*, that liberal damages were warrantable. *Ib.* 467.

When the defendant purchased the machine in the open market, not knowing that it was patented, and abandoned all the patented appliances on being notified of their infringement, it was *held*, that the case was not one for exemplary damages. Emerson *v.* Simm, 3 *Pat. Off. Gaz.* 293 ; 6 *Fish. Pat. Cas.* 281.

In patent cases, damages should be compensatory, not vindictive. The object is not punishment, but indemnity. The profits which the defendant has derived should be regarded, and the amount of loss which the plaintiff has sustained should be regarded also. Knight *v.* Gavit, *Mir. Pat. Off. Gaz.* 135.

234. *Referring to License Fees, Royalties, &c., to Fix Damages.*

The general rule is that if a patentee has established a fixed price at which he is accustomed to sell rights to manufacture under his patent, the jury may take that license fee as their guide in estimating damages against an infringer. Hogg *v.* Emerson, 11 *How.* 587, 607 ; Seymour *v.* McCormick, 16 *How.* 480, 488 ; McCormick *v.* Seymour, 3 *Blatchf.* 209 ; aff'd in part, 19 *How.* 96 ; Sickles *v.* Borden, 3 *Blatchf.* 535 ; Wooster *v.* Simonson, 20 *Fed. Rep'r*, 316 ; 28 *Pat. Off. Gaz.* 918 ; May *v.* Fond du Lac County, 27 *Fed. Rep'r*, 691.

So when it is difficult to ascertain the profits with exactness, a license fee may be adopted as the standard of profits. Emigh *v.* Baltimore & O. R. R. Co., 4 *Hughes*, 271 ; 19 *Pat. Off. Gaz.* 935 ; 6 *Fed. Rep'r*, 283.

The above rule may be applied in determining the sum to be paid to a patentee, in a case where the user had been by consent of

the patentee but without any stipulation as to compensation, as well as in cases of unqualified infringement; the reason being even stronger in such a case. Packet Co. *v.* Sickles, 19 *Wall.* 611.

The license fee or royalty must have become uniform to warrant making it a measure of recovery against an infringer who has not assented to it; and proof of a single license is not sufficient to establish a market price for licenses. Westcott *v.* Rude, 19 *Fed. Rep'r*, 830; 27 *Pat. Off. Gaz.* 719.

Thus, if the patentee has been accustomed to take small fees in many cases, in order to get his invention introduced, the jury must take that fact into account in making their award. Sickles *v.* Borden, 3 *Blatchf.* 535.

A transfer of "the sole and exclusive right and monopoly of manufacturing" under a patent, by the owners, of their entire interest in the patent, to be paid for by a certain royalty, is not the establishment of an "ordinary license fee" within the rule, and the sum cannot be invoked as a safe criterion of damages, unless evidence is offered showing that the licensees of the complainants were deprived of the sale of the number of machines which the defendants manufactured and sold. La Baw *v.* Hawkins, 2 *Bann. & A. Pat. Cas.* 561.

An agreement by a licensee to pay a certain price, whether he use the entire invention or a part only, is no criterion by which to estimate the damages for an infringement of only one or two distinct claims in the patent, each of value. Westcott *v.* Rude, 19 *Fed. Rep'r*, 830; 27 *Pat. Off. Gaz.* 719. So the amount of plaintiff's established license fee cannot be adopted as a measure of damages where a part only of the patented invention is used by defendant. Burdsall *v.* Coolidge, 93 *U. S.* 64.

A rescinded contract for payment of a royalty is not competent in determining the measure of damages for an infringement. Bussey *v.* Excelsior Manuf. Co., 1 *Fed. Rep'r*, 640; 1 *McCrary*, 161; 5 *Bann. & A. Pat. Cas.* 135.

It has been held that the award of damages reached by comparison with the patentee's usual license fee may be mitigated, if the maker of the machine was ignorant of the existence of the patent right, and did not intend any infringement, although such ignorance will not completely exonerate from damages. Hogg *v.* Emerson, 11 *How.* 587, 607.

If there is not an established, uniform license fee, the plaintiff must produce general evidence of actual damages sustained; such

as proof of the utility and advantage of the invention over the old modes or devices that had been used for working out similar results (Suffolk Co. *v.* Hayden, 3 *Wall.* 315) ; and if the proofs show that the same results were produced by other methods in common use, nominal damages only are recoverable. Black *v.* Thorne, 111 *U. S.* 122.

Occasional contracts of license cannot be considered a measure of damages. Greenleaf *v.* Yale Lock Manuf. Co., 17 *Blatchf.* 253 ; 17 *Pat. Off. Gaz.* 625 ; 4 *Bann. & A. Pat. Cas.* 583.

235. *Damages Awarded in Peculiar Cases.*

When the language used by the judge in instructions to the jury was " exemplary damages," and open to be construed beyond this rule, but the jury appeared not to have gone beyond the actual injury sustained, it was *held*, that the verdict should not be disturbed. Taylor *v.* Carpenter, 2 *Woodb. & M.* 1 ; 10 *L. Rep'r*, 35.

Where the case admitted of only general evidence on the part of the plaintiff, and the defendants offered no proof on the question of damages, it was *held*, that the jury were warranted in exercising a liberal discretion. The defendants should have shown the amount of their sales, if necessary to prevent an excessive award. Stephens *v.* Felt, 2 *Blatchf.* 37.

When the invention was one of improvements in a pump only, numerous parts of which were in general use prior to the patent, and where plaintiff fails to show that the profits or damages arose from the improvement as distinguished from the entire machine, nominal damages only can be recovered. Gould's Manuf. Co. *v.* Cowing, 12 *Blatchf.* 243; 8 *Pat. Off. Gaz.* 277; but see 105 *U. S.* 253.

The distinction in respect to the measure of damages between a patent which covers an entire machine, and one for improvement on a machine, stated. Seymour *v.* McCormick, 16 *How.* 480, 491 ; Tuttle *v.* Gaylord, 28 *Fed. Rep'r*, 97.

The patentee of a hotel register book is entitled to recover, as damages, not only the profit he might have made upon the book if he had sold it, but what he might have obtained from those who advertised in it. Hawes *v.* Washburne, 5 *Pat. Off. Gaz.* 491.

In an action for damages for the infringement of a patent of a water-wheel, one-fourth of the proceeds being estimated as the

profits of the mill, the damages were assessed at that amount. Parker *v.* Bamker, 6 *McLean*, 631.

If the defendants used other improvements with the patented device which enhanced their value, they should have a corresponding reduction. The burden rests upon the defendant to show the value of such improvements. Mulford *v.* Pearce, 14 *Blatchf.* 141.

They will also be allowed to deduct royalty paid for improvement and cost of introducing the improvement. American Nicolson Pavement Co. *v.* Elizabeth, 6 *Pat. Off. Gaz.* 764.

When the patented device is distinguishable as an improved article of manufacture from that which is open to the public, the damages are not limited to the advantages derived by defendant in using improved article over that open to the public. Mulford *v.* Pearce, 14 *Blatchf.* 141.

Where a part owner of a patent sues a co-owner for using an infringing device, the recovery, if any, will be in proportion to their respective interests. Herring *v.* Gas Consumers' Assoc., 9 *Fed. Rep'r*, 556; 3 *McCrary*, 206; 21 *Pat. Off. Gaz.* 203.

In what cases jury may consider costs in fixing damages, see Day *v.* Woodworth, 13 *How.* 363.

Principle on which damages should be computed where the injury caused by the infringement consists in compelling patentee to reduce his price. See Fitch *v.* Bragg, 16 *Fed. Rep'r*, 243; 21 *Blatchf.* 302; Stephens *v.* Felt, 2 *Blatchf.* 37; Yale Manuf. Co. *v.* Sargeant, 7 *Sup. Ct. Rep'r*, 934.

The measure of damages for the infringement of patents, determined, in view of particular facts. Buerk *v.* Imhaeuser, 10 *Pat. Off. Gaz.* 907; 14 *Blatchf.* 19; 2 *Bann. & A. Pat. Cas.* 452; Cowing *v.* Ramsey, 8 *Blatchf.* 36; McKeever *v.* United States, 14 *Ct. of Cl.* 396; 23 *Pat. Off. Gaz.* 1525.

In a suit for infringement of a patent for a machine, the infringement was limited to eighteen months as to four machines, and to three years as to two machines; and the damages therefor were assessed by the master at the rate per machine of a sum which he found to be the fixed royalty for the term of the patent, the patentee having made his patent available exclusively by the sale of licenses for its use at such fixed sum. It was *held*, that this rule of damages was, under the circumstances, properly applied; the infringement by the defendants having been deliberate, and their use of the invention, considering the nature of it and the business to which it was applied, having been extensive and protracted. Stutz *v.* Armstrong, 25 *Fed. Rep'r*, 147.

236. *Trebling the Damages.*

The proper course is for the jury to find the actual damages sustained by the patentee by the infringement, and it is discretionary with the court, in view of the circumstances of the case, to render judgment for any sum not exceeding three times the amount of the verdict. Wilbur *v.* Beecher, 2 *Blatchf.* 132, 143; Conover *v.* Dohrman, 3 *Fish. Pat. Cas.* 382; Judson *v.* Bradford, 16 *Pat. Off. Gaz.* 171; 3 *Bann. & A. Pat. Cas.* 539; Stephens *v.* Felt, 2 *Blatchf.* 37; Guyon *v.* Serrell, 1 *Blatchf.* 244; Hall *v.* Wiles, 2 *Id.* 194; Parker *v.* Hulme, 1 *Fish. Pat. Cas.* 44, 56. To nearly same effect, Seymour *v.* McCormick, 16 *How.* 480; Livingston *v.* Woodworth, 15 *How.* 546; Saunders *v.* Logan, 2 *Fish. Pat. Cas.* 167; 9 *Am. L. Reg.* 475; 2 *Pittsb.* 241.

The actual damages are, as a general rule, all that can be reasonably claimed for an infringement, though cases may arise where the circumstances are aggravated, and such as to repel altogether the *bona fides* of the infringement, in which the power to increase the verdict should be exercised. Each case must depend upon its own circumstances. Guyon *v.* Serrell, 1 *Blatchf.* 244; Peck *v.* Frame, 9 *Blatchf.* 194; 5 *Fish. Pat. Cas.* 113. See, also, Russell *v.* Place, *Id.* 134. They may be increased notwithstanding plaintiff, by reason of delay in filing a disclaimer, cannot recover costs. Guyon *v.* Serrell, 1 *Blatchf.* 244.

Previous to the act of 1836, the courts were compelled to treble the damages. Since that act they are not compelled to do so, but may increase them or not, at their discretion, within the threefold limit. In the exercise of that discretion, the court will not increase them if, in their opinion, the jury have already exceeded their proper measure (Stimpson *v.* Railroads, 1 *Wall. Jr.* 164; see, also, Allen *v.* Blunt, 2 *Woodb. & M.* 121); or where no special reasons are shown, such as malice, insufficiency of the verdict, or the like, for trebling (Schwarzel *v.* Holenshade, 2 *Bond*, 29; 3 *Fish. Pat. Cas.* 116); or when the action was brought after the expiration of the patent, and is prosecuted merely to collect damages (Bell *v.* McCullough, 1 *Bond*, 194; 1 *Fish. Pat. Cas.* 389); or in favor of a mere assignee of the right of action. Schwarzel *v.* Holenshade, 2 *Bond*, 29; 3 *Fish. Pat. Cas.* 116.

The power has been granted chiefly for the purpose of empowering the courts to remunerate parties driven to litigation to sustain

their patents, by wanton and persistent infringement. Brodie *v.* Ophir Silver Mining Co., 5 *Sawyer*, 608 ; 4 *Fish. Pat. Cas.* 137.

The Federal courts sitting in equity had no power, under the act of July 4, 1836, § 14, to treble the damages found by them for violating a patent right, as they might do when sitting at law, and on a verdict and judgment. Livingston *v.* Jones, 3 *Wall. Jr.* 330 ; 2 *Fish. Pat. Cas.* 207.

That the power of "trebling," as conferred by Rev. Stat. §§ 4119, 4121, does not extend to profits, but is limited to damages, see Campbell *v.* James, 5 *Bann. & A. Pat. Cas.* 630 ; rev'd on other points, 104 *U. S.* 356. But under *Rev. Stat.* § 4919, where it appeared, in a suit in equity for infringement of a patent, that the defendant's profits derived from the use of the plaintiff's invention, did not amount to as much as the plaintiff's damages arising from the infringement, it was *held* that the court might add to the amount of such profits, a sum sufficient to make the amount decreed equal to the plaintiff's damages. Simpson *v.* Davis, 22 *Blatchf.* 113 ; 22 *Fed. Rep'r*, 444 ; Willimantic *v.* Clark Co., 27 *Fed. Rep'r*, 865.

237. *Right to recover Profits.*

Another mode of ascertaining the damages is by inquiring what profits the infringer has realized from his unlawful use of the invention. In this class of cases, the plaintiff's measure of damages is the amount of profits actually received by the defendant from the sales complained of. Lowell *v.* Lewis, 1 *Mas.* 182 ; Wilbur *v.* Beecher, 2 *Blatchf.* 132, 143. S. P., Hall *v.* Wiles, *Id.* 194 ; Pitts *v.* Hall, *Id.* 229, 239.

In an action on the case for an infringement, it is erroneous to instruct the jury that the true rule in regard to damages is the profits made by the defendant by the infringement. The true rule is, what the plaintiff has lost, and not what the defendant has gained. Cowing *v.* Rumsey, 4 *Fish. Pat. Cas.* 275.

Where a patentee claims as damages a loss of profits caused by a loss of sales, resulting from an infringement, he must establish, by satisfactory evidence, that he would have sold more of the patented articles than he did sell, if the infringing articles had not been sold, and what profit he would have made on them, and what part of such profit is to be assigned to the invention patented. Such evidence must not be conjecture and speculation. Ingersoll

v. Musgrove, 14 *Blatchf.* 541 ; 13 *Pat. Off. Gaz.* 966 ; 3 *Bann. & A. Pat. Cas.* 304.

The measure of damages for infringement of a patent is the profits that the plaintiffs would have made on the sales of the patented article had they supplied the customers to whom the defendants sold such article. In estimating the amount of such profits the cost of manufacture and sale should be deducted, and on sales of a large amount, clerk-hire, storage, freight, &c., should be considered as part of such cost. Zane *v.* Peck, 23 *Pat. Off. Gaz.* 191.

The measure of damages for an infringement, where the defendant sold articles similar to those patented, at a loss, was *held* to be the profits the plaintiff would have made on the trade he would have had, and not on the amount of sales made by the defendant ; since it was to be inferred that the plaintiff at his price would not have sold as many as the defendant did at his. Hall *v.* Stern, 20 *Fed. Rep'r*, 788.

Should a party invent a machine having no value alone, and unsalable, and then use, in connection with his machine, the invention of another, which gives to the former a market value, the measure of damages is not the entire amount of profit, but the profit derived from the connection. Whitney *v.* Mowry, 4 *Fish. Pat. Cas.* 141 ; rev'd on other points, 14 *Wall.* 620.

Where the patent is for an improvement, the patentee is not entitled to all the profits that accrued in the manufacture of the whole article, but merely to the profits which were realized as the consequence of the improper use of the improvement. Littlefield *v.* Perry, 21 *Wall.* 205 ; 7 *Pat. Off. Gaz.* 964 ; Ingels *v.* Mast, 1 *Flippin*, 424 ; 2 *Bann. & A. Pat. Cas.* 24 ; Gould's Manuf. Co. *v.* Cowing, 12 *Blatchf.* 243 ; 8 *Pat. Off. Gaz.* 277 ; 1 *Bann. & A. Pat. Cas.* 375; Gould's Manuf. Co. *v.* Cowing, 14 *Blatchf.* 315; 12 *Pat. Off. Gaz.* 942 ; 3 *Bann. & A. Pat. Cas.* 75 ; Black *v.* Munson, 14 *Blatchf.* 265; 2 *Bann. & A. Pat. Cas.* 623; Vaughan *v.* Cent. Pac. R. R. Co., 4 *Saw.* 280; 3 *Bann. & A. Pat. Cas.* 27 ; Star S. C. Co. *v.* Crossman, 4 *Bann. & A. Pat. Cas.* 566; Maier *v.* Brown, 17 *Fed. Rep'r*, 736. See Manuf. Co. *v.* Cowing, 105 *U. S.* 253.

On an injunction bill to restrain the infringement of a patent, where there is no dispute as to the title, the circuit court has jurisdiction, under the act of 1836, § 17 (5 Stat. 124), to refer the case to a master to take an account of the profits of which the plaintiff has been deprived by reason of the infringement. The defendant

is regarded as having been in the use and enjoyment of the property of the patentee, and as being bound in equity to account for the profits. Allen *v.* Blunt, 1 *Blatchf.* 480 ; 8 *N. Y. Leg. Obs.* 105

An infringer of a patent is, in equity, a trustee of the patentee, of the gains derived by him from the infringement. Wetherill *v.* New Jersey Zinc Co., 1 *Bann. & A. Pat. Cas.* 485.

A party who has earned profits by the infringement of a patent is chargeable as trustee for the use of the real owner. Vaughan *v.* East Tennessee, Virginia, &c. R. R. Co., 11 *Pat. Off. Gaz.* 798 ; 1 *Flippin*, 621 ; 2 *Bann. & A. Pat. Cas.* 537.

There is no right of action recognized, to recover profits for infringing a patent, founded on the theory that such profits should be treated as trust funds, and the infringer considered as a trustee *de son tort.* The act of infringement is but a simple taking and using another's property, without authority, for one's own advantage ; and this, of itself, does not confer equity jurisdiction. Sayles *v.* Richmond, Fredericksburgh, &c. R. R. Co., 3 *Hughes*, 172 ; 25 *Int. Rev. Rec.* 209 ; 16 *Pat. Off. Gaz.* 43 ; 7 *Rep'r*, 743 ; 4 *Bann. & A. Pat. Cas.* 239.

The profits recoverable in equity by the owner of a patented invention from an infringer are such only as result directly and immediately from the infringement. Remote and contingent profits are not recoverable. Where the defendants in a suit in equity, by their use of the complainant's patented process of preserving fish, were enabled to withdraw fish from the market and thus obtain a higher price for their unpreserved fish than they would otherwise have received, it was *held*, that the profits resulting from such increased price were too remote and indirect to be charged against the defendants as profits realized from their infringement. Piper *v.* Brown, 1 *Holmes*, 196 ; 6 *Fish. Pat. Cas.* 240.

Where a patentee is entitled to profits, he is entitled to any profit the infringer has made by the unlicensed use of the contrivance included in the monopoly, and of that alone, without regard to profit or loss on the whole structure or machine of which such mechanism forms a part, and without recoupment for losses on other infringing mechanisms made or sold. Graham *v.* Mason, 1 *Holmes*, 88 ; 5 *Fish. Pat. Cas.* 200 ; 1 *Pat. Off. Gaz.* 609. Compare Calkins *v.* Bertrand, 8 *Fed. Rep'r*, 755 ; Putnam *v.* Lomax, 9 *Fed. Rep'r*, 448 ; 10 *Biss.* 546 ; 23 *Wall.* 261.

Where the infringer has made a profit on one fraction of the

mechanisms made and sold, but has met with losses on a larger fraction, so that a correct account of the whole operation would show a loss on the total manufacture, the patentee is entitled to the profits made on a bill counting generally against the infringer, without offset or deduction for losses made in the manufacture and sale of other infringing mechanism. Graham *v.* Mason, *supra*.

Where the patented invention consisted of a "bridle-motion" attachment for looms,—*held*, that the complainants had no right to any portion of the profits which the defendants made upon the looms to which the infringing mechanism was attached. *Ib.*

Where some of the infringing mechanisms made and sold by the defendant in a suit in equity on a patent, were made after a pattern of his own, differing from the complainant's in form, which was claimed to increase the value, and lessen the cost of manufacture of the mechanism,—*held*, that the complainants were entitled to recover all the profits on all the articles sold, including those made according to the defendant's own pattern. *Ib.*

And where an infringer sold parts of infringing mechanisms to repair and restore such mechanisms previously sold by him,—*held*, that the complainants were entitled in equity to recover the profits made on the sales of such parts, as well as on the sales of the original mechanism. *Ib.*

In cases in which gains and profits alone are to be awarded, when the defendant has used the infringing machine so unskillfully, or in a manner so unbusiness-like, that he has made no profit, the complainant can recover none. But the defendant cannot prejudice complainant's right to recover, by applying the gains arising from the use of an infringing machine, to make up losses on other branches of his business. Conover *v.* Mers, 11 *Blatchf.* 197; 6 *Fish. Pat. Cas.* 506.

An infringer is liable for profits although he might have employed some other contrivance than the one used to quite the same profit. Burdett *v.* Estey, 3 *Fed. Rep'r*, 566; 19 *Blatchf.* 1.

No profits will be decreed on accounting for infringement where none have accrued; but in proper cases damages may be had under Rev. Stat. § 4921. *Ib.*

The rule, that the profits which a plaintiff, who has made and patented an improvement upon an existing machine or manufacture, is to recover, must be those only which can be proved to have resulted from his own particular improvement upon the existing machine or manufacture, and that the burden of proof of such

profits is upon him, stated and applied. Star Salt Caster Co. *v.* Crossman, 4 *Bann. & A. Pat. Cas.* 566. See, also, Garretson *v.* Clark, 15 *Blatchf.* 70; 14 *Pat. Off. Gaz.* 485; 4 *Bann. & A. Pat. Cas.* 536; also 16 *Pat. Off. Gaz.* 806; 4 *Bann. & A. Pat. Cas.* 536; Kirby *v.* Armstrong, 5 *Fed. Rep'r*, 801; 10 *Biss.* 135; 19 *Pat. Off. Gaz.* 661; Calkins *v.* Bertrand, 8 *Fed. Rep'r*, 755; 10 *Biss.* 445; Willimantic Thread Co. *v.* Clark Thread Co., 27 *Fed. Rep'r*, 865.

In cases of willful infringement, respondents ought to be held to the most rigid accountability, and no intendment ought to be made in their favor founded upon the alleged inconclusiveness of the complainant's proof of loss. Such proof ought to be interpreted most liberally in favor of complainants, within the limit of an approximately accurate ascertainment of their damages. Bigelow Carpet Co. *v.* Dobson, 10 *Fed. Rep'r*, 385; 13 *Rep'r*, 265.

Where a patentee is himself the infringer of rights under the patent which he has assigned, equity looks upon him as a trustee faithless to his trust; the violator of rights which he was bound to protect. It will accordingly charge him for all profits improperly made, as well for profits on original patents, the subject of original bill, as for profits made on reissues obtained *pendente lite*, and the subject of a supplemental bill. Littlefield *v.* Perry, 21 *Wall.* 205.

No stipulations between a patentee and his assignee, as to royalty to be charged, can prevent the latter from recovering from an infringer the whole profits realized by reason of the infringement. Elizabeth *v.* Pavement Co., 97 *U. S.* 126.

Where it appears that some of the defendants have not been jointly concerned in the infringement for the whole time covered by the account, the several liability of all must be apportioned in making up the decree. Tatham *v.* Lowber, 4 *Blatchf.* 86.

In a suit against three defendants, it is proper to award against all three the profits made by them jointly, while partners, and against two of them the profits they made after their partnership with the third defendant was dissolved, and while they were using the patented invention in conjunction with a fourth person, not a defendant. Herring *v.* Gage, 15 *Blatchf.* 124; 3 *Bann. & A. Pat. Cas.* 396.

Where the thing patented was made in one district and used in another, and the bill prays for profits from both making and using and for an injunction, plaintiff may recover profits resulting from either making or using within the jurisdiction of the court,

and obtain an injunction against making, using and vending within the same. Locomotive Engine Safety Truck Co. *v.* Erie Ry. Co., 6 *Fish. Pat. Cas.* 187; 10 *Blatchf.* 292; 3 *Pat. Off. Gaz.* 93.

Since Rev. Stat. § 4921, a court of equity has power, in a suit for infringement, to award damages for such loss as complainant has sustained, in addition to the profits he has lost. But profits continue to be proper measure of damages in equity, except where the injury is greater than the aggregate of what was made by defendant. Willimantic Thread Co. *v.* Clark Thread Co., 27 *Fed. Rep'r*, 865.

238. *How Profits are Ascertained or Estimated.*

The damages recoverable upon a bill in equity for an infringement, do not extend to the entire profits realized by the infringer; whether the patent is for a machine or a process of manufacture. The question is as to the advantage derived by the infringer by his act. Such advantage is the measure of profit to be accounted for. Mowry *v.* Whitney, 14 *Wall.* 620; Cawood Patent, 94 *U. S.* 695. S. P., Knox *v.* Great Western Quicksilver Min. Co., 7 *Rep'r*, 325; 14 *Pat. Off. Gaz.* 897; 4 *Bann. & A. Pat. Cas.* 25; 6 *Sawyer*, 430.

If the patentee does not sell rights to others, but uses his invention exclusively himself, and furnishes the products to the community himself out of his own manufactory, the profits of sales may become the criterion of the actual damages of the patentee. Seymour *v.* McCormick, 16 *How.* 480, 490; rev'g 2 *Blatchf.* 240; see Seymour *v.* McCormick, 19 *How.* 96; aff'g 3 *Blatchf.* 209, 225.

The measure is, the difference between cost of manufacture and price upon sale; and a controlling consideration is that the wrongdoer shall not reap an advantage from his wrong. American S. Co. *v.* Emerson, 8 *Fed. Rep'r*, 806.

Where the profits made by a defendant from the unlawful use of a patented invention amount to more than the license fees for such use would amount to, the plaintiff, although exercising his monopoly by the granting of licenses, is entitled to recover such profits on an accounting for profits, and is not limited to such license fees. Wooster *v.* Taylor, 14 *Blatchf.* 403; 3 *Bann. & A. Pat. Cas.* 241.

Where the infringement shown is of the invention as an entirety;

as, where not merely the new parts in a combination of new and old, but the entire combination was used, the whole profits of infringer's sales are profits of infringement. Ruggles *v.* Eddy, 2 *Bann. & A. Pat. Cas.* 627; 12 *Pat. Off. Gaz.* 716.

Where the entire value of the whole machine as a marketable article is properly and legally attributable to the patented features, the profits may be estimated by showing the profits derived from making and selling the article containing the patented features, and the profits realized from the manufacture and sale of other forms of the same article not embodying the same features. Garretson *v.* Clark, 16 *Pat. Off. Gaz.* 806; 4 *Bann. & A. Pat. Cas.* 536.

Where the infringed patent is for an art, a fair measure of the infringer's actual profits is the saving in cost of production by the use of the appropriate invention, over the cost of production by cognate means, used and available. Wetherill *v.* New Jersey Zinc Co., 1 *Bann. & A. Pat. Cas.* 435. Compare Munson *v.* New York, 16 *Fed. Rep'r*, 560; 16 *Rep'r*, 99.

When a patent covers but one of many features of a machine, the gains on the whole machine cannot be reckoned as damages for infringement thereof, but only the gains arising from the use of the special device or element claimed by such patent. The burden of proof is upon the complainant to separate or apportion the defendant's profits and complainant's damages between the features infringed and not infringed, and such evidence must be reliable and tangible, not conjectural or speculative; or he must show by equally reliable and satisfactory evidence that the profits and damages are to be calculated on the whole machine for the reason that the entire value of the whole machine as a marketable article is properly and legally attributable to the patentable features. Calkins *v.* Bertrand, 8 *Fed. Rep'r*, 755; 10 *Biss.* 445.

The general principle is that a patentee is limited in his recovery of damages for infringement to such profits as may be properly apportioned to the use of his improvement. He can only recover profits upon the entire article when such article is wholly his own invention, or when its entire value is properly and legally attributable to the patented feature. Thus, if one discovers a new composition of matter, such as gun-cotton, nitro-glycerine, or vulcanized rubber, or invents some new machine, such as the telephone, or some new article of manufacture, such as barbed wire, or a new pavement, he is entitled to damages arising from the manufacture

and sale of the entire article. But if his invention be limited to some particular part of a large machine, such as the cut-off of an engine, the axle of a wagon, or the seat upon a mowing-machine, it is equally clear that his recovery must be limited to such profits as arise from the manufacture and sale of the patented feature. His damages, too, must be proved, and not left to conjecture; and the fact that it is impossible to separate the profits arising from the improvement from those incident to the manufacture of the whole machine, is an insufficient reason for awarding the plaintiff more than he is justly entitled to receive. In case he is unable to prove how much of the entire profit upon the machine is due to his patent, he can recover only nominal charges. Maier *v.* Brown, 17 *Fed. Rep'r*, 736; 10 *Biss.* 546; 16 *Rep'r*, 585; Fitch *v.* Bragg, 16 *Fed. Rep'r*, 243; 21 *Blatchf.* 302.

In estimating profits made by the infringer,—the saving to him by the use of the patented machine,—comparison must be made between the use of the patented invention, and the use of what was known and open to the public before the date of the patent, not with subsequent appliances. Turrell *v.* Illinois Central Ry. Co., 20 *Fed. Rep'r*, 912; Knox *v.* Great Western Quicksilver Mining Co., 14 *Pat. Off. Gaz.* 897; 7 *Rep'r*, 325; 4 *Bann. & A. Pat. Cas.* 25.

In estimating the profits realized from infringement of a patent, compensation is not allowed the infringer for his time and labor. Piper *v.* Brown, 1 *Holmes*, 196; 6 *Fish. Pat. Cas.* 240.

An allowance to the respondents of charges for extra work and materials upon condition of their assignment of the charges to the complainant will, if the arrangement is an equitable one, be confirmed by the court. Brady *v.* Atlantic Works, 15 *Pat. Off. Gaz.* 965; 3 *Bann. & A. Pat. Cas.* 577.

The profits for which an infringer is chargeable are to be computed, for a machine, by deducting from the articles made all the elements of costs in their production. Troy Iron, &c. Factory *v.* Corning, 6 *Blatchf.* 328; 3 *Fish. Pat. Cas.* 497.

In an accounting for profits, the defendant cannot be credited with a sum of money as a salary earned by, and paid to himself, while engaged in the business which earned the profits. Williams *v.* Leonard, 9 *Blatchf.* 476; 5 *Fish. Pat. Cas.* 381.

Interest on the cost of a device, and the cost of power, are to be allowed as deductions from profits, only when it is shown they

have been paid or incurred as debts. Herring *v.* Gage, 15 *Blatchf.* 124; 3 *Bann. & A. Pat. Cas.* 396.

In what cases the defendant is accountable only for what profits he actually made, not for what, by diligence and skill, he might have received, see Livingston *v.* Woodworth, 15 *How.* 546, Dean *v.* Mason, 20 *How.* 198; Brady *v.* Atlantic Works, 15 *Pat. Off. Gaz.* 965; 3 *Bann. & A. Pat. Cas.* 577.

Where the defendants are manufacturing under a patent which, although an infringement of the complainant's patent, contains valuable improvements upon it, and for which the defendants pay a royalty, the amount of the royalty paid by them is a proper item to be deducted from the aggregate amount of profits realized by them. The fact that the defendants have not actually paid the license fee to the owner of the subsequent patent does not change the rule, when it is shown that they are liable for the amount of such royalty. La Baw *v.* Hawkins, 2 *Bann. & A. Pat. Cas.* 561.

There cannot be any rule for estimating profits which will apply equally to all cases. The mode of estimating profits must depend upon the peculiar nature of the monopoly granted. Mason *v.* Graham, 5 *Fish.* 290; 1 *Holmes*, 88; 1 *Pat. Off. Gaz.* 608; reversed on other points, 7 *Pat. Off. Gaz.* 833; 23 *Wall.* 261.

239. *What Awards of Profits have been made under Special Circumstances.*

A question of infringement had been settled in favor of plaintiffs, and reference made to a master to report the amount of damages sustained by plaintiffs for the use by defendants of their invention. The master in his report based his opinion upon the productive capacity of the machines employed. It was *held*, that the calculation should have been made on the actual production of such machines of the article manufactured. Webster *v.* New Brunswick Carpet Co., 9 *Pat. Off. Gaz.* 203; 2 *Bann. & A. Pat. Cas.* 67.

Where the suit was for infringing patents for certain improvements in coal stoves (coal stoves generally and various improvements on them having been long known), and decretal order directed account of all the profits which the defendants have received from the manufacture, use, or sale "of stoves, &c., embracing the improvements described in and covered by the said letters patent and the reissues thereof, or any of them," it was

held, that the order was too broad. The true question is, "What advantage did the defendant derive from using the complainant's invention over what he had in using other processes then open to the public, and adequate to enable him to obtain an equally beneficial result?" And the fruits of that advantage are his profits, and to be accounted for. Littlefield *v.* Perry, 21 *Wall.* 205.

The defendants, vendors of organs generally, and selling, sometimes organs having a patented invention consisting of a combination of what was called a "tremolo attachment" with the organ, and sometimes organs without the attachment, were decreed guilty, in their sales of organs with the attachment, of infringing the complainant's patent. It was *held*, that in ascertainment of profits made by them from the sales of the organs with the tremolo attachment, it was proper to let them prove the general expenses of their business in effecting sales of organs generally, and deduct a ratable proportion from the profits made by the tremolo attachment. The Tremolo Patent, 23 *Wall.* 518; aff'g 9 *Blatchf.* 385, 550; 5 *Fish. Pat. Cas.* 310, 537.

An order in a suit in equity, requiring the defendant to file a monthly account, on oath, of all "iron safes hereafter manufactured and sold by him," will be sufficiently complied with, by giving their number and inside dimensions, without stating the prices at which sold, or the names of the purchasers. It is sufficient to describe the articles in the account, so that persons in the trade can determine the value or price of them in the market, with a view to the amount of profits. Wilder *v.* Gayler, 1 *Blatchf.* 511.

The proper principles on which profits are to be computed against an infringer, explained, where the patent infringed was for an improved kind of fuel, and the master proceeded on the principle of charging as profits the value of the wood which, but for the use of the patented fuel, defendant must have burned. Black *v.* Thorne, 12 *Blatchf.* 20; 7 *Pat. Off. Gaz.* 176; 1 *Bann. & A. Pat. Cas.* 155.

Proper mode of computing profits determined, in a case where the master allowed the plaintiff for each article sold by defendant, the plaintiff's selling price, less cost and commission for making sales; and this was *held* erroneous because there was no proof that all who bought from defendant would have bought from plaintiff. Buerk *v.* Imhaeuser, 14 *Blatchf.* 19; 10 *Pat. Off. Gaz.* 907; 2 *Bann. & A. Pat. Gaz.* 452.

The proper mode of ascertaining the profits made by an infringer

explained; and *held*, that in the particular case the proper inquiry was, not what saving the defendant had made by using the patented device, over the saving which he might have made if he had used any or all of various other devices, but what saving he had made directly by using the patented device. Herring *v.* Gage, 15 *Blatchf.* 124; 3 *Bann. & A. Pat. Cas.* 396.

An interlocutory decree directing an account of the gains, savings and advantages due to the infringement of a patent, in addition to the *profits*, and awarding *costs*, was *held* proper. Coburn *v.* Schroeder, 8 *Fed. Rep'r*, 521; 19 *Blatchf.* 493; 20 *Pat. Off. Gaz.* 1085; 12 *Rep'r*, 380.

In a former action against the maker of the infringing machine, there was a stipulation "that the amount of recovery to be adjudged against the defendants in case of a decree for complainant shall be fixed and determined upon the evidence in the case submitted at final hearing, and both parties request the court, in case of a decision against the defendant, to fix, as the amount of recovery, such amount of damages as is proved by such testimony." It was *held*,

1. The court, by giving nominal damages in the absence of proof, did not thereby adjudge in that case that one dollar was the value of the invention.

2. The amount of damages to be recovered against the user of the infringing machine was the profit which the plaintiff ordinarily received on the sale of a machine of the same size, using the patent so infringed; if such profits could not be ascertained, they could not be recovered. Blake *v.* Greenwood Cemetery, 16 *Fed. Rep'r*, 676; 25 *Pat. Off. Gaz.* 89; 15 *Rep'r*, 741.

Plaintiff was the owner of a patented improvement in trunks, which consisted in covering the frame of the trunk with narrow strips of wood, laid in close proximity to each other, all around its top and sides. Defendant infringed by manufacturing and selling trunks containing the patented covering. It was *held*, that plaintiff could not recover the net profits made by defendant in the manufacture and sale of the entire trunk, but was limited to such as were properly attributable to his improvement. A proper method of estimating damages would be to take the profits made by the defendant upon one of these trunks, and deduct from them the profits upon an ordinary trunk of similar size and general description. The difference might be properly credited to plaintiff's invention. Maier *v.* Brown, 17 *Fed. Rep'r*, 736; 16 *Rep'r*, 585; 10 *Biss.* 546.

Where Congress consent to an action "for damages occasioned by the annulment" of the claimant's contract, "and also for the use" of said Nock's patent in the manufacture of mail locks subsequent to such annulment," the claimant may recover the profits which he would have made under his contract as manufacturer, or a royalty under the patent; but he cannot have both. Damages for the use of his patent are included in his profits as manufacturer. Nock *v.* United States, 2 *Ct. of Cl.* 451.

Various principles governing the estimate and allowance of profits against a corporation found chargeable with infringement; and the computation of expenses of manufacture which the corporation is entitled to have deducted from the gross prices realized from sales, explained. Steam Stone Cutter Co. *v.* Windsor Manuf. Co., 17 *Blatchf.* 24; 4 *Bann. & A. Pat. Cas.* 445.

How profits are to be ascertained, in cases when they may be allowed, are determined, with references to the circumstances of particular cases. Wilbur *v.* Beecher, 2 *Blatchf.* 132, 143; Tatham *v.* Lowber, 4 *Blatchf.* 86; Marsh *v.* Warren, 14 *Blatchf.* 265; Bigelow Carpet Co. *v.* Dobson, 10 *Fed. Rep'r*, 385; 13 *Rep'r*, 265; Kendrick *v.* Emmons, 15 *Pat. Off. Gaz.* 966.

240. *Effect of Recovery and Payment of Damages.*

The recovery of a verdict by the plaintiff, in an action for infringement, does not pass any legal right to the defendant to use the machine made by him. Every future use will be an infringement of the plaintiff's patent. Whittemore *v.* Cutter, 1 *Gall.* 478, 484. S. P., Suffolk Co. *v.* Hayden, 3 *Wall.* 315. But compare Sickels *v.* Borden, 3 *Blatchf.* 535.

When a patentee gets his remuneration by the sale of his patented machine for use by others, a recovery of profits and damages from the manufacturer of an infringing machine, followed by payment, is a full compensation for his injury, and places him in the same position as if he had made and sold the machine himself; and confers on defendant the right to use the machine while its lasts. The patentee has obtained all that the law gives him, and the particular article or machine becomes, in effect, licensed by the patentee. Perrigo *v.* Spaulding, 13 *Blatchf.* 389; 12 *Pat. Off. Gaz.* 352; 2 *Bann. & A. Pat. Cas.* 348. S. P., Booth *v.* Seevers, 19 *Pat. Off. Gaz.* 1140; Spaulding *v.* Page, 1 *Sawyer*, 702; 4 *Fish. Pat. Cas.* 461; 4 *Am. L. T. U. S. Cts.* 166.

When a patentee gets his remuneration in the exclusive use of his machine and the sale of its products, a recovery will not give the infringer any right to the further use of the infringing machine. *Ib.*

The damages recovered in a suit for infringement are merely a satisfaction for prior use, and do not free the parties infringing from the operation of the patent. Matthews *v.* Spangenberg, 23 *Pat. Off. Gaz.* 1624; 15 *Fed. Rep'r*, 813.

The recovery of nominal damages in an action for infringement of a patent, and the tender of such sum by the maker of the machine so infringing, do not operate as a license to the maker or his vendees as to existing infringing machines so made, nor as a bar to a recovery in another action against a subsequent user of the same machine. Blake *v.* Greenwood Cemetery, 16 *Fed. Rep'r*, 676; 25 *Pat. Off. Gaz.* 89; 15 *Rep'r*, 741.

A party who has elected to take judgment for profits in an action for damages for infringement of a patent, which judgment has not been reversed, cannot prosecute a second action for other damages arising out of the same acts of infringement. For a single wrong, the damages for which are capable of ascertainment, and which is not in the nature of a continuing nuisance or trespass, only one action will lie, and the damages must be assessed once for all. Child *v.* Boston, &c. Iron Works, 19 *Fed. Rep'r*, 258.

The owner of a patent who, in an action against an infringer who has made and sold for use machines covered by the patent, has recovered the profits of such sales, cannot afterwards recover from a purchaser of such machines profits derived by him from the use of them. Steam Stone Cutter Co. *v.* Sheldon, 22 *Blatchf.* 484; 21 *Fed. Rep'r*, 875.

241. *Statutory Recovery of Damages, in Equity.*

The object of the new provision in the act of July 8, 1870, § 59 (now Rev. Stat. § 4921),—that a complainant in equity may recover, in addition to the profits accounted for by defendant, the damages the complainant has sustained,—was to enable the plaintiff, by bringing a suit in equity, to recover in such suit, not only the profits made by the defendant by means of the infringement, but also the damages sustained by the plaintiff thereby. In the absence of this provision, this could not have been done. But under this provision a plaintiff cannot recover, as damages, any items which

he could not recover as damages in an action on the case. Bancroft *v.* Acton, 7 *Blatchf.* 505.

In a suit in equity for an infringement, brought before the passage of the act of 1870, both profits and damages could not be recovered. Williams *v.* Leonard, 9 *Blatchf.* 476; 5 *Fish. Pat. Cas.* 381.

Where a decree is entered for complainant, he may recover, in addition to the profits to be accounted for by the respondent, the damages he has sustained, and the court may, in its discretion, assess the same. Profits are to be accounted for in such case by the respondent whenever the decretal order to that effect is entered; and if the injuries sustained by the complainant from the infringement are greater than the gains and profits realized by the respondent, then the complainant is entitled to recover compensation for the excess of the injuries beyond the amount estimated for profits of the respondent. Carew *v.* Boston Elastic Fabric Co., 3 *Cliff.* 356; 5 *Fish. Pat. Cas.* 90; 1 *Pat. Off. Gaz.* 91.

A suit in equity for infringement may be maintained for damages sustained from the infringement as well as for an account of profits; but if the profits exceed the damages the former only will be allowed. And the damages must be confined to the direct and immediate consequences of the infringement, and not embrace those which are both remote and conjectural. Buerk *v.* Imhaenser, 10 *Pat. Off. Gaz.* 907; 14 *Blatchf.* 19; 2 *Bann. & A. Pat. Cas.* 452.

The terms "profits" and "damages," as used in the patent act, are not convertible. Damages are to be awarded "in addition" to profits. "Profits" refers to what the defendant has gained by the unlawful use of the patented invention, and "damages" to what the claimant has lost. In equity, under the existing laws, a complainant can recover both profits and damages. But the amount of the license fee fixed by the complainant is usually considered a proper compensation in damages, except in those cases where the evidence warrants an allowance of exemplary or punitive damages by reason of a wanton infringement. Goodyear Dental Vulcanite Co. *v.* Van Antwerp, 9 *Pat. Off. Gaz.* 497.

The damages to be recovered by Rev. Stat. §§ 4917, 4921, are "actual damages," and may properly be awarded in a case where sale of an infringing device has enforced a reduction of price of plaintiff's device, even though defendant made no profits and the

defendant may have had no license fee. Yale Lock Manuf. Co. *v.* Sargent, 117 *U. S.* 536.

Where it appeared that the defendant had derived no gains profits or advantages by reason of his infringement, the complainant was *held* entitled to damages only, to be limited to the amount of the license fee established by him. Locomotive Engine Safety Truck Co. *v.* Pennsylvania R. R. Co., 2 *Fed. Rep'r*, 677 ; 10 *Rep'r*, 39 ; 5 *Bann. & A. Pat. Cas.* 514 ; Williams *v.* Rome, Watertown, &c. R. Co., 2 *Fed. Rep'r*, 702 ; 18 *Blatchf.* 181 ; 17 *Pat. Off. Gaz.* 1447 ; 5 *Bann. & A. Pat. Cas.* 423.

In an accounting before a master in an infringement suit, it appeared that the defendants had made no profits on the articles sold by them. It was *held*, that the complainant company could not recover as damages the profits it would have made on the articles sold by the defendants. St. Louis Stamping Co. *v.* Quinby, 5 *Bann. & A. Pat. Cas.* 275.

A court of equity has no jurisdiction of a suit to recover damages for the infringement of a patent, unless there is a valid demand in the bill for an injunction against further infringement. Burdell *v.* Comstock, 15 *Rep'r*, 742.

Profits are the net gains of the infringer from the use of the patented invention, while damages are the losses sustained by the owner in consequence of the infringement. Sometimes the profits of the infringer form the sole criterion of the actual damages sustained by the patentee, and then a report of the net gains covers the whole ground of profits and damages. In other instances it would be the duty of the master to add together the net gains of the infringer and the license fee which the patentee has fixed, and to make the aggregate the measure of the profits and damages which the wrongdoer ought to pay. La Baw *v.* Hawkins, 2 *Bann. & A. Pat. Cas.* 561.

Compensatory damages for the infringement of letters patent may be allowed in equity, notwithstanding the business of the infringer was so improvidently conducted as to yield no substantial profits. Marsh *v.* Seymour, 97 *U. S.* 348.

No profits will be decreed on accounting for infringement, where none have accrued, but in proper cases damages may be had under Rev. Stat. § 4921. Burdett *v.* Estey, 3 *Fed. Rep'r*, 566 ; 19 *Blatchf.* 1.

Where the master reported that there were no damages and no profits, but that the use of the patent restored the salable character

of the article the defendant made, and thus saved the defendant from loss. It was *held*, that the money value of such advantage could be recovered as compensation. Sargent *v.* Yale Lock Manuf. Co., 17 *Blatchf.* 249 ; aff'd, 117 *U. S.* 536 ; 17 *Pat. Off. Gaz.* 106 ; 4 *Bann. & A. Pat. Cas.* 579.

242. *Interest.*

Under the general rule that interest upon unliquidated damages is not recoverable, interest is not allowable upon profits awarded to be paid over by an infringer of a patent, to the patentee, until from date of final decree. Mowry *v.* Whitney, 14 *Wall.* 620. To same effect, Silsby *v.* Foote, 20 *How.* 378 ; rev'g 2 *Blatchf.* 260 ; Parks *v.* Booth, 102 *U. S.* 96 ; Brady *v.* Atlantic Works, 15 *Pat. Off. Gaz.* 965 ; 3 *Bann. & A. Pat. Cas.* 577 ; Holbrook *v.* Small, 17 *Pat. Off. Gaz.* 55.

As a general rule, interest on profits is not allowable. Special circumstances may, however, justify the addition of interest. Littlefield *v.* Perry, 21 *Wall.* 205.

Interest allowed, in particular cases, on the damages reported by a master for an infringement of patent. Illinois Central R. R. Co. *v.* Turrill, 110 *U. S.* 301 ; Tatham *v.* Lowber, 4 *Blatchf.* 86 ; Burdett *v.* Estey, 3 *Fed. Rep'r*, 566 ; 19 *Blatchf.* 1 ; Steam Stone Cutter Co. *v.* Windsor Manuf. Co., 18 *Blatchf.* 47 ; 5 *Bann. & A. Pat. Cas.* 335.

Interest is properly allowable on a decree for profits on the infringement, from the time the report is in proper form for exceptions. Turrill *v.* Illinois Central Ry. Co., 20 *Fed. Rep'r*, 912.

Interest on amounts received by infringer, and how affected by filing of a disclaimer under Rev. Stat. § 4922, considered. Burdett *v.* Estey, 5 *Bann. & A. Pat. Cas.* 308.

Interest may be allowed on damages for infringement. May *v.* Fond du Lac County, 27 *Fed. Rep'r*, 691.

243. *Allowance for Counsel Fees, and other Expenses.*

Counsel fees are not a proper element for the consideration of the jury in the estimation of damages, in an action for an infringement. Teese *v.* Huntington, 23 *How.* 2 ; Phillip *v.* Nock, 17 *Wall.* 460. And see Whittemore *v.* Cutter, 1 *Gall.* 429 ; Pierson

v. Eagle Screw Co., 3 *Story*, 402; Stimpson *v.* Railroads, 1 *Wall. Jr.* 164; Parker *v.* Hulme, 1 *Fish. Pat. Cas.* 44; 7 *West. L. J.* 429; Simpson *v.* Leiper, 2 *Whart. Dig.* 414; Blanchard Gun-Stock Turning Factory *v.* Warner, 1 *Blatchf.* 258; 272, *note* 1. To the contrary, Boston Manuf. Co. *v.* Fiske, 2 *Mas.* 119; Parker *v.* Corbin, 4 *McLean*, 462; Allen *v.* Blunt, 2 *Woodb. & M.* 121.

In an action for infringement, copies of an assignment of the patent, made by the plaintiff, being proved by the defendant for the purpose of showing that the plaintiff had not retained an interest which authorized him to recover, the charge of the copies is taxable. But a copy of the plaintiff's patent, procured by the defendant, is not taxable, as the plaintiff is bound by law to offer it in evidence. Hathaway *v.* Roach, 2 *Woodb. & M.* 63.

The expense of making or procuring models cannot be included among the taxable costs, nor can models properly be classed as "exemplifications," under the act of February 26. Parker *v.* Bigler, 1 *Fish. Pat. Cas.* 285; 14 *Leg. Intel.* 18.

Models of the invention described in the plaintiff's patent, procured by the defendant in good faith, may be included in the taxation of costs; but not other models. Woodruff *v.* Barney, 1 *Bond*, 528; 2 *Fish. Pat. Cas.* 244. Copies of patents, either that of the plaintiff or others, procured by the defendant, cannot be taxed as costs to the plaintiff. *Ib.*

A patentee is not entitled to reimbursement for counsel fees paid or expenses incurred by him, other than his taxable costs. Parks *v.* Booth, 102 *U. S.* 96; aff'g 1 *Flippin*, 381; 1 *Bann. & A. Pat. Cas.* 225.

Profits recoverable in a suit for infringement do not include expenses of suit. Holbrook *v.* Small, 17 *Pat. Off. Gaz.* 55; 2 *Bann. & A. Pat. Cas.* 596.

Counsel fees paid by complainant in a suit in equity for infringement of a patent are not recoverable as damages, under the act of 1870, § 55 (16 Stat. 206), any more than they were under the corresponding provisions of the act of 1836, § 14. Bancroft *v.* Acton, 7 *Blatchf.* 505.

XVIII. REMEDY BY INJUNCTION.

244. *Power of United States Courts to Grant Injunctions and Estimate Damages.*

The several courts vested with jurisdiction of cases arising under the patent laws shall have power to grant injunctions according to the course and principles of courts of equity, to prevent the violation of any right secured by patent, on such terms as the court may deem reasonable; and upon a decree being rendered in any such case for an infringement, the complainant shall be entitled to recover, in addition to the profits to be accounted for by the defendant, the damages the complainant has sustained thereby; and the court shall assess the same or cause the same to be assessed under its direction. And the court shall have the same power to increase such damages, in its discretion, as is given to increase the damages found by verdicts in actions in the nature of actions of trespass upon the case. *Rev. Stat.* § 4921.

245. *General Nature of the Jurisdiction to Enjoin.*

Section 7 of the act of 1836 has removed the objection to the jurisdiction in equity over infringement, that the patentee might have a remedy at law, and has conferred a jurisdiction of cases arising under the patent laws, which is exclusive. Goodyear *v.* Hullihen, 3 *Fish. Pat. Cas.* 251; Smith *v.* Plymouth, 4 *West. L. J.* 49. See McMillin *v.* St. Louis & Mississippi Valley Transp. Co., 18 *Fed. Rep'r*, 260.

Although the machine may be constructed or used beyond the jurisdiction of the court, yet if the court have jurisdiction of the defendant, he may be restrained from using the machine and selling

the product. Boyd *v.* McAlpine, 3 *McLean*, 427; Wilson *v.* Sherman, 1 *Blatchf.* 536.

The jurisdiction of the circuit courts sitting in equity over controversies under the patent laws is not merely a jurisdiction ancillary to courts of law, but a substantive jurisdiction conferred by direct grant from Congress. Blank *v.* Manufacturing Co., 3 *Wall. Jr.* 196; Saunders *v.* Logan, 2 *Pittsb.* 241; Jenkins *v.* Greenwald, 1 *Bond*, 126; 2 *Fish. Pat. Cas.* 37.

History of equity jurisdiction and of the statutes conferring it on the circuit courts, in patent cases, explained; with special reference to the question whether an injunction suit begun after expiration of a patent can be maintained, even for the purpose of compelling an accounting. Root *v.* Railway Co., 105 *U. S.* 189. See also *post*, note 249.

An accounting may be decreed, in a proper case, notwithstanding no right to a discovery or an injunction or other distinct head of equitable relief is shown; as, where the patent expired pending the suit, leaving nothing in litigation but the right to an account. Blank *v.* Manufacturing Co., 3 *Wall. Jr.* 196. To same effect, Gottfried *v.* Moerlein, 14 *Fed. Rep'r*, 170; Burdell *v.* Comstock, 15 *Fed. Rep'r*, 395.

A single infringement will not warrant a suit for an injunction; there being no threat to continue infringing; the remedy is by suit for damages. Smith *v.* Sands, 20 *Rep'r*, 326.

Where the injury done to a patentee by infringement is not in the use of his invention, but in making use of it without compensating the patentee therefor, it being the interest of the patentee that his invention should be used and adopted by all, the proper remedy is not an injunction but an award of damages, viz: the price or value of a license to use it. Sanders *v.* Logan, 2 *Fish. Pat. Cas.* 167; 9 *Am. L. Reg.* 475; 2 *Pittsb.* 241.

On an injunction bill filed by a patentee, where there is no dispute as to title, a circuit court has power to refer the case to a master to take and state an account of the profits made by the defendant instead of sending it to a court of law to assess the damages. Allen *v.* Blunt, 1 *Blatchf.* 480.

As the circuit courts have jurisdiction of patent cases conferred upon them by statute, and are not confined to such jurisdiction as is ancillary to that of courts of law, the rule of the English cases that if an injunction is refused a decree for an account cannot be made, but that the plaintiff must sue at law, does not apply in this

country. Sickles *v.* Gloucester Manuf. Co., 1 *Fish. Pat. Cas.* 222. S. P., Sanders *v.* Logan, 9 *Am. L. Reg.* 475 ; 2 *Fish. Pat. Cas.* 167 ; 2 *Pittsb.* 241.

A circuit court has power to enjoin infringement of a patent, independently of making award of any other relief thereon. American Cotton Tie Supply Co. *v.* McCready, 17 *Blatchf.* 291 ; 17 *Pat. Off. Gaz.* 565 ; 4 *Bann. & A. Pat. Cas.* 588.

If the validity of the patent has been established, or is admitted, a bill will lie for an injunction, upon well-grounded proof of an apprehended intention of the defendant to violate the patent right. Such bill is substantially a bill *quia timet*, which is an ordinary remedial process in equity. Woodworth *v.* Stone, 3 *Story*, 749.

The circuit court has jurisdiction of a suit demanding a discovery of the extent of an infringement of a patent and an account of the profits realized therefrom (as being a case arising under the patent laws), as well as of one where an injunction is asked. Nevins *v.* Johnson, 3 *Blatchf.* 80.

An injunction will issue to restrain the use of a machine differing from a patented machine only by slight and unimportant alterations which the description of the invention would naturally, if not necessarily, suggest, without the aid of much ingenuity or skill. Gibson *v.* Harris, 1 *Blatchf.* 167.

Under peculiar circumstances, where the defendant commenced his manufacture without notice of plaintiff's patent, and plaintiff had no knowledge of the infringement for a considerable time, so that there had been no fault on either side,—it was *held*, that the court should grant an injunction as to the future, and an accounting from the date of defendant's first notice of plaintiff's rights. Merriam *v.* Smith, 11 *Fed. Rep'r*, 588.

An injunction ought not to issue where the special circumstances render granting one inequitable between the parties ; as where the defendant was engaged in fulfilling a contract for the manufacture of articles containing the invention, which contract had been entered into on the understanding, on the part of the defendant, that the question between him and the plaintiff was one of compensation, and defendant was willing to make compensation. Smith *v.* Sharp's Rifle Manuf. Co., 3 *Blatchf.* 545.

Where the court is itself satisfied that the defendants are infringing the plaintiff's rights, although the majority of experts called as witnesses are of the opinion that there is no infringement, it is its duty to grant an injunction to restrain such infringement.

Wilson *v.* Barnum, 1 *Wall. Jr.* 347 ; 6 *West. L. J.* 464 ; 2 *Fish. Pat. Cas.* 635.

Where the defendant, sued for an infringement, admitted the infringement but pleaded his lunacy at the time, ascertained by a commission, as a defense, it was *held*, that a perpetual injunction, accounting, and costs should be awarded the plaintiff, and that expenses incurred by the defendant by reason of his lunacy should not be deducted. Avery *v.* Wilson, 20 *Fed. Rep'r*, 856.

Injunction, in case of infringement, issues on the principle of a clear and certain right to the enjoyment of the subject in question, and an injurious interruption of that right, which on just and equitable grounds ought to be prevented. Property in a patent is as much under the protection of the law as property in land. Cook *v.* Ernest, 2 *Pat. Off. Gaz.* 89 ; 5 *Fish. Pat. Cas.* 396.

Where, on a final hearing of a bill to restrain an infringement, the court finds that the patent is valid, that the defendant is chargeable with infringing, and that the complainant is entitled to a permanent injunction, and refers the case to a master to ascertain damages, the injunction should be allowed at once ; and not suspended until the master's report comes in, unless some special reasons for that course are shown. Potter *v.* Mack, 3 *Fish. Pat. Cas.* 428. To same effect, Parker *v.* Halfield, 4 *McLean*, 61.

A court of equity should not sustain a suit to enjoin infringement, where the nature of the invention is such that there can be no profits, in a proper sense of the term, of which an account can be decreed ; but the limit of the injury for the use of the invention must necessarily be the value of the license fee ; for here the patentee has a full, speedy, complete and adequate remedy at law. Vaughan *v.* Central Pacific R. R. Co., 4 *Sawyer*, 280.

246. *Various Relief obtainable in Equity.*

Where, upon trial, the plaintiff abandons one claim of his patent and the defendant does not dispute his liability upon the other, a decree should issue against defendant. New York Coffee Polishing Co. *v.* Wilson, 2 *Fed. Rep'r*, 904.

After a decree against an infringer he cannot be restrained from paying the proceeds of the decree by the suit of a third party, seeking to recover them, where the party claims title to the patent

adversely to the plaintiff in the original suit. Secombe *v.* Campbell, 5 *Fed. Rep'r*, 804 ; 10 *Rep'r*, 686 ; 5 *Bann. & A. Pat. Cas.* 632.

A bill in equity cannot be maintained in behalf of an individual patentee to procure an adjudication that his patent does not interfere with a patent previously granted to another person for an invention apparently similar. Such a bill would be in effect a suit to limit the operation of the earlier patent. A suit of this description can be brought only by the attorney-general in the name of the United States. Celluloid Manuf. Co. *v.* Goodyear Dental Vulcanite Co., 10 *Pat. Off. Gaz.* 41 ; 13 *Blatchf.* 375 ; 2 *Bann. & A. Pat. Cas.* 334. The jurisdiction granted by the patent laws to the courts to entertain suits in equity brought in behalf of patentees can be exercised only in protecting the right of a patentee to exclude other persons from manufacturing or selling the thing covered by his patent. Presumably every patentee has the right to maintain such a suit against any infringer of his patent. *Ib.*

Where the plaintiffs in a bill for infringements have obtained a decree for an account, and have commenced suits in the courts of other districts for like infringements, the court may, on motion, stay the accounting in the original suit, as to any matters which the plaintiffs have precluded themselves from recovering in it by equitable proceedings. But the court will not, on mere motion, enjoin the plaintiffs from prosecuting suits which they have commenced before other courts, for the recovery of damages such as they are endeavoring to obtain in the suit pending before it, especially after the plaintiffs have been allowed to proceed so far in the foreign suits as to commence taking accounts. Rumford Chemical Works *v.* Hecker, 5 *Pat. Off. Gaz.* 644 ; 5 *Fish. Pat. Cas.* 629.

Where an injunction was obtained, in a suit for license fees, upon condition that the disputed fees should be deposited in court, it was *held*, upon an application by each party to have the fund paid over to him, that though the money belonged to complainant, yet the protection he had received from the court gave the defendant an equitable lien upon the same, and hence, it would be retained until the final determination of the controversy. Florence Sewing Machine Co. *v.* Singer Manuf. Co., 4 *Fish. Pat. Cas.* 348.

Where a bill discloses an agreement by which the defendants were to report monthly the number of machines made under their license to manufacture and sell, and a covenant not to make machines, except of a certain description, and not to dispute the validity of the patents mentioned in the license ; and that the

defendants had violated all their agreements in these particulars, clear case is established for the interposition of a court of equity. The covenant to make monthly reports is, in fact, a covenant for a monthly discovery by defendants of the work done by them under the complainant's patents. Where the licenses do not give an unlimited use of any of the patents, but only a restricted right to make machines of certain sizes and descriptions, if the licensees make machines not in conformity to these licenses, they violate, not only their express covenant not to do so, but also the licensor's patents, or some of them, covering such machines. Pope Manuf. Co. *v.* Owsley, 27 *Fed. Rep'r*, 100.

Equity cannot entertain a bill for an accounting of royalties under a license, upon allegations that the patentee does not know the number of machines which defendant has sold under the license and therefore cannot collect the royalties at law. Crandall *v.* Piano Manuf. Co., 20 *Rep'r*, 237.

To show that a decree has been recovered against a manufacturer, for infringing, does not constitute a defense in favor of one who purchased from him, although such decree included defendant's machine. Satisfaction of the decree must be shown. Fisher *v.* Consolidated Amador Mine Co., 20 *Rep'r*, 452.

247. *Suit to Annul a Patent on the Ground of Interference.*

Jurisdiction of United States courts in equity to adjudge a patent void because of interfering with an earlier one does not rest wholly on their general equity jurisdiction, but is supported by *Rev. Stat.* § 4918. See *ante*, p. 213. Such a suit is not, however, treated as a mere statutory remedy, it is an adversary suit, to be commenced by service of process; though no specific provision of law is made whereby a person who is not an inhabitant of and cannot be served within the district in which such suit has been brought, can be brought in as defendant. Liggett, &c. Tobacco Co. *v.* Miller, 1 *Fed. Rep'r*, 203; 1 *McCrary*, 31; 17 *Pat. Off. Gaz.* 798; 5 *Bann. & A. Pat. Cas.* 237.

A preliminary injunction may be issued in an interference suit; it is authorized by the general principles of equity, though not

expressly mentioned in section 4918. Potter *v.* Dixon, 5 *Blatchf.* 160.

The suit thus authorized raises only the question of relative priority of the competing inventions (Lockwood *v.* Cleaveland, 20 *Fed. Rep'r*, 164); if the defendant concedes that plaintiff's patent is first in date, he cannot prevail by attacking that patent for want of novelty (Pentlarge *v.* Pentlarge, 19 *Fed. Rep'r*, 817); either by plea or answer (Pentlarge *v.* Pentlarge, 22 *Blatchf.* 10); still less may he deny that either party was the first inventor; see Greenwood *v.* Bracher, 5 *Bann. & A. Pat. Cas.* 302; 1 *Fed. Rep'r*, 856; 17 *Pat. Off. Gaz.* 1151.

A decree dismissing a bill seeking relief under section 4918 is not conclusive in a subsequent suit; the decree must be such as asserts the interference of the patents and declares one of them void. Tyler *v.* Hyde, 2 *Blatchf.* 310.

A cross bill is not required in these suits in order to enable defendant to have the affirmative relief of a decree annulling the complainant's patent. Lockwood *v.* Cleaveland, 6 *Fed. Rep'r*, 721.

After a decision by the commissioner of patents in an interference proceeding awarding letters patent to an inventor whose application was filed subsequently to that of another applicant, who had obtained letters patent covering the invention in controversy, priority of invention constitutes the material issue between the parties, when the defeated party files his bill in equity to have the patent of his adversary declared void. Sawyer *v.* Massey, 25 *Fed. Rep'r*, 144.

The substantial question on an interference is as to the identity of the two inventions, in principle. Tyson *v.* Rankin, 1 *MacArthur Pat. Cas.* 262.

The court has authority to adjudge either of the interfering patents void in whole or in part, or may, upon proper issues and proof, decree that both patents are void. Foster *v.* Lindsay, 3 *Dill.* 126; 2 *Bann. & A. Pat. Cas.* 172. But see 19 *Fed. Rep'r*, 817; 22 *Blatchf.* 11; 20 *Fed. Rep'r*, 164; 6 *Id.* 721; *contra.*

Where two patents have been issued, each claiming, broadly, the same invention, and the earlier patentee is adjudged to be the first inventor, the claim in the second patent must be restricted to the particular devices specially described. Richardson *v.* Noyes, 10 *Pat. Off. Gaz.* 507; 2 *Bann. & A. Pat. Cas.* 398. General evidence that the patentee in the junior patent applied for it with such

knowledge of the invention as would debar him from obtaining a patent, may be received as warranting the court in declaring the junior patent null. Hutchinson *v.* Everett, 26 *Fed. Rep'r*, 531.

248. *Necessity of Establishing Plaintiff's Title by Action at Law, before Resorting to Equity.*

A circuit court may entertain a bill to restrain infringements of a patent, without waiting until a trial at law establishing the validity of the patent, has been had. Cochrane *v.* Deener, 94 *U. S.* 780; Goodyear *v.* Gloucester Manuf. Co., 3 *Wall. Jr.* 196; Sickels *v.* Mitchell, 3 *Blatchf.* 548; Goodyear *v.* Day, 2 *Wall. Jr.* 283; Sanders *v.* Logan, 2 *Pittsb.* 241; 2 *Fish. Pat. Cas.* 167; 9 *Am. L. Reg.* 475; McMillin *v.* Barclay, 4 *Brews.* 275; 3 *Pittsb.* 377; 5 *Fish. Pat. Cas.* 189.

The courts of the United States are authorized to take up a patent, and, upon final hearing, to pass upon it, without reference to the fact whether it has been before a jury or not. Doughty *v.* West, 2 *Fish. Pat. Cas.* 553.

The supreme court of the District of Columbia has the same power in this respect as the circuit courts. Cochrane *v.* Deener, 94 *U. S.* 780.

The former rule that the circuit courts would interfere in aid of a patentee only where his patent had been established by long acquiescence, or by a trial at law, is now relaxed. The current of decisions of the last few years has been that the grant of jurisdiction is as full in equity as it is at law. Sanders *v.* Logan, 2 *Fish. Pat. Cas.* 167; Hoffheins *v.* Brandt, 3 *Fish. Pat. Cas.* 218; Shelly *v.* Brannan, 4 *Id.* 198. See Buchanan *v.* Howland, 2 *Fish. Pat. Cas.* 341.

It appeared on the final hearing on pleadings and proofs, of a suit in equity for an injunction and an account, that the bill was filed within three months after the issuing of the patent, that the defendant denied the infringement and the novelty of the invention, and that there had been no trial at law. It did not appear that there had been any exclusive possession under the patent, or any public acquiescence in the exclusive right of the patentee. Objections were made to the sufficiency of the specification, and the evidence on the question of infringement was indefinite and unsatisfactory. The court, under the circumstances, ordered the

cause to stand over a sufficient time for the bringing of a suit at law against the defendant for an infringement. Muscan Hair Manuf. Co. *v.* American Hair Manuf. Co., 4 *Blatchf.* 174; 1 *Fish. Pat. Cas.* 320.

Even after the validity of a patent has been established in a suit, it may be shown in another suit on the patent against another defendant, or on a motion for a preliminary injunction, that the right claimed by the plaintiff in the new suit was not, either as to its nature or its extent, fairly in controversy in the former suit, or that there are relevant matters not considered in the former suit. Page *v.* Holmes Burglar Alarm Tel. Co., 2 *Fed. Rep'r*, 330; 18 *Blatchf.* 118; 9 *Rep'r*, 775; 5 *Bann. & A. Pat. Cas.* 439.

For some decisions recognizing the former rule requiring an adjudication of the right, at law, before equity would act on a bill for an injunction, most of which cases, however, were rendered many years ago, see Orr *v.* Merrill, 1 *Woodb. & M.* 376; Day *v.* Hartshorn, 3 *Fish. Pat. Cas.* 32; Thomas *v.* Weeks, 2 *Paine*, 92; Pentlarge *v.* Pentlarge, 14 *Rep'r*, 579; 22 *Blatchf.* 10.

249. *Or of showing long Possession and Public Acquiescence.*

For many years before the jurisdiction of the circuit courts to entertain a bill for an injunction without awaiting a trial at law was established as firmly as it now is by the cases cited in the preceding note, there was a large body of decisions holding if there had been an exclusive possession of some duration, and without serious dispute, of the rights of a patentee, under a patent, such claim and public acquiescence would warrant a court of equity in granting an injunction without requiring the holder of the patent to first establish his right at law. Washburn *v.* Gould, 3 *Story*, 122; 1 *West. L. J.* 465; 7 *L. Rep'r*, 276; Orr *v.* Littlefield, 1 *Woodb. & M.* 13; 8 *L. Rep'r*, 314; Sullivan *v.* Redfield, 1 *Paine*, 441; Ogle *v.* Ege, 4 *Wash.* 584; Foster *v.* Moore, 1 *Curt.* 279; Sargent *v.* Seagrave, 2 *Curt.* 553; Miller *v.* Androscoggin Pulp Co., 5 *Fish. Pat. Cas.* 340.

Injunctions in patent right cases are granted without a previous trial at law, in cases where the owner of a patent shows a clear case of infringement and has been in the possession and enjoyment of the exclusive right for a term of years without any successful

impeachment of its validity. Such possession and enjoyment, aided by the presumptions arising from the patent itself, are sufficient to warrant an injunction to restrain infringement. There is no fixed rule as to the length of time the possession and enjoyment of the right under the patent shall have continued. It must be sufficient to justify a presumption in favor of the validity of the patent. Potter *v.* Muller, 2 *Fish. Pat. Cas.* 465.

It is not possible to fix any term of years during which the exclusive possession must have continued in order to entitle the proprietor to a provisional injunction. Each case must depend upon its own circumstances,—*e. g.*, the extent of the use or sales by the patentee, the degree of the utility of the invention, and the number of persons whose business is affected by it, and who are interested to question the exclusive right, and the completeness of the acquiescence under it. Foster *v.* Moore, 1 *Curt.* 279; Sargent *v.* Seagrave, 2 *Curt.* 553.

The acquiescence of the public in the use by the patentee of his invention before applying for a patent is entitled to more or less weight, according to the degree of the utility of the machine, and the number of persons whose trade or business is affected by it. An exclusive possession of about eight years, under a patent for a useful machine which affected the trade and business of large numbers of persons; many of such machines having been constructed and put in operation in different States, was *held* sufficient. Foster *v.* Moore, *supra.*

The sale of an invention, and its use by the inventor and his vendors, is sufficient evidence of an exclusive possession by claim and color of title, to entitle him to be protected in the continued enjoyment, whatever doubts may exist as to the validity of the patent. Cooper *v.* Matthews, 8 *L. Rep'r*, 413, 419.

Long possession and use under one patent and recoveries upon it will not inure in favor of another patent, as to which an injunction is asked, even though the two patents are very useful and necessary for each other, unless there is some connection in law between them, or one is auxiliary to or part of the other. Hovey *v.* Stevens, 1 *Woodb. & M.* 290.

To entitle a patentee to the extraordinary writ of injunction, it is not sufficient for him merely to show his patent and infringement of it. His right must be further substantiated, either by a possession accompanied by an actual use and enjoyment of the right for a sufficient length of time to afford a reasonable presumption of the

acquiescence of the public in its validity, or, by a judgment in his favor in a trial at law. Brown *v.* Hinkley, 3 *Pat. Off. Gaz.* 384; 6 *Fish. Pat. Cas.* 370.

On an application for an injunction against the infringement of a patent, the bill should show, either that the validity of the patent has been established in an action at law, or that the right of the complainant under the patent has been recognized and acquiesced in by long unquestioned use and enjoyment, or other equivalent acts. Gutta-percha Co. *v.* Goodyear Co., 3 *Sawyer*, 542; 2 *Bann. & A. Pat. Cas.* 212.

A court of equity will not grant an injunction to restrain a party using, and in possession of, an invention, where he has been so for a long time, and under color of right. Hall *v.* Speer, 1 *Pittsb.* 513.

250. *Effect of Expiration of Patent on the Jurisdiction of Equity.*

A circuit court has not jurisdiction, upon a bill filed after the expiration of a patent, to ascertain a past infringement, and decree an accounting of profits, unless the bill shows citizenship of parties in different States, or the existence of some special ground of equitable jurisdiction, or that complainant has not an adequate remedy at law. The fiction that the infringer holds the profits he has realized, as a trustee for the patentee, will not support the suit. Root *v.* Railway Co., 105 *U. S.* 189;* Lord *v.* Whitehead, &c. Machine Co., 24 *Fed. Rep'r*, 801; 3 *Pat. Off. Gaz.* 498; Vaughan *v.* Cen-

* Before the decision of the Supreme Court in Root *v.* Railway Co., 105 *U. S.* 189, there appears to have been some conflict of opinion in the circuit courts, as to whether a suit for a discovery and account of profits could be maintained, after the expiration of the patent had terminated the right to an injunction. The preponderance of authority, however, was that the jurisdiction of equity continued. Howes *v.* Nute, 4 *Fish. Pat. Cas.* 263; 4 *Cliff.* 173; McComb v. Beard, 10 Blatch. 350, 361; Smith v. Baker, 5 Pat. Off. Gaz. 496; Nevins v. Johnson, 3 Blatch. 80; Gordon v. Anthony, 16 Pat. Off. Gaz. 1135; Atwood v. Portland Co., 10 Fed. Rep'r, 283; 5 Bann. & A. Pat. Cas. 533; Stevens v. Kansas Pacific Ry. Co., 5 Dill. 486. S. P., Sayles v. Dubuque & Sioux City R. R. Co., Id. 561.

But see Draper v. Hudson, 1 Holmes, 208; Sayles v. Richmond & Fredericksburgh R. R. Co., 4 Bann. & A. Pat. Cas. 239; 7 Rep'r, 743.

tral Pacific R. R. Co., 4 *Sawyer*, 280; Burdell *v.* Comstock, 15 *Fed. Rep'r*, 395; Davis *v.* Smith, 19 *Fed. Rep'r*, 823.

Where the assignee of damages for an infringement has an adequate remedy at law for an infringement of the patent which expired before the assignment was made, a demurrer to a bill will be sustained; without prejudice to a suit at law for damages. Hayward *v.* Andrews, 12 *Fed. Rep'r*, 786; aff'd, 106 *U. S.* 672.

Equity will not refuse to entertain a bill for an injunction and account, merely because the patent is about to expire, unless the time it has to run is so short as to show that the bill was a mere device to oust the common law jurisdiction. Dick *v.* Struthers, 25 *Rep'r*, 103.

Where a bill in equity, alleging infringement of a patent and praying for an injunction and an account was filed only five days before the expiration of the patent and no effort was made to obtain an injunction, it was *held* that the court never acquired jurisdiction. Burdell *v.* Comstock, 15 *Fed. Rep'r*, 395.

The intricacy of the accounting claimed is not ground for jurisdiction of equity over infringements of a patent expired. Lord *v.* Whitehead & Atherton Machine Co., 24 *Fed. Rep'r*, 801.

Bills were filed about a month before an extended term of a patent expired, one of them seeking to recover for infringements during the original term, the other for those during the extended term. It was *held*, that the court had no jurisdiction of the bill relating to the original term; but, that as there were grounds of equitable relief for the bill for the extended term, at the time when it was filed, and there was nothing to show that the suit was a mere desire to transfer the jurisdiction of law to equity, by commencing suit at this late day, the court did not lose jurisdiction by expiration of the patent. Adams *v.* Bridgewater Iron Co., 26 *Fed. Rep'r*, 324; 34 *Pat. Off. Gaz.* 1045. S. P., Gottfried *v.* Moerlein, 14 *Fed. Rep'r*, 170.

An injunction against an infringing machine, made during the life of the patent, will continue in force after the expiration of the patent. But an injunction will not issue against the use of a patented device, after the expiration of the term of the patent, upon a bill which does not allege that defendant is using machines made during the term of the patent and infringing it, or that the complainant fears such use. American Diamond Rock Boring Co. *v.* Rutland Marble Co., 2 *Fed. Rep'r*, 355; 1 *Blatchf.* 146; 5 *Bann. & A. Pat. Cas.* 346.

Although a patent has expired, and the device covered by it can be used only in connection with other devices embraced in a patent still in life, the latter cannot be used without the consent of the patentee, though in connection with the first. Wheeler *v.* McCormick, 4 *Pat. Off. Gaz.* 692 ; 11 *Blatchf.* 334 ; 6 *Fish. Pat. Cas.* 551.

There is a broad distinction between the use of an invention and the use of a patented machine. While the right to use the invention expires with the end of the term of the original patent, the right to the continued use of the machine, which embodies it, is protected. Wetherill *v.* Passaic Zinc Co., 6 *Fish. Pat. Cas.* 50 ; 16 *Int. Rev. Rec.* 156 ; 2 *Pat. Off. Gaz.* 471 ; 9 *Phila.* 385.

Courts of equity are authorized to grant an injunction after the expiration of a patent, to prevent the sale of articles manufactured during its life. New York Belting & Packing Co. *v.* Magowan, 27 *Fed. Rep'r*, 111 ; 34 *Pat. Off. Gaz.* 1278.

A bill in equity filed more than a year after the expiration of a patent cannot be sustained, merely because it seeks relief by way of injunction, against the use or sale by the defendants of articles embodying the patented invention, should any be found in their possession, and also against the use of the tools and paraphernalia of infringement made during the life of the patent, for the purpose of infringement. Consolidated Safety Valve Co *v.* Ashton Valve Co., 26 *Fed. Rep'r*, 319.

In a suit in equity for infringement of a patent, a preliminary injunction against the defendants was denied, but they were required to give bond and make a monthly statement, under oath, of their sale. Before a final decision on the merits, the patent expired. It was *held*, that under the circumstances, a decree in favor of the complainants should include an injunction against the defendants using or selling the infringing articles manufactured by them during the life of the patent. New York Belting & Packing Co. *v.* Magowan, 27 *Fed. Rep'r*, 111 ; 34 *Pat. Off. Gaz.* 1278.

251. *Effect of Expiration in Particular Instances.*

A., to whom letters-patent had been assigned, filed, after their expiration, which took place July 6, 1873, his bill against B., charging that the latter had during their term infringed them by using the patented invention, whereby he realized gains, profits and

savings, which he should be compelled to account for and pay to the complainant. The bill was, on demurrer, dismissed. It was *held*, that the decree below was proper, the bill being merely for an account of profits and damages against an infringer, and it not appearing from the case thereby made that any ground of equitable jurisdiction existed, or that A. had not a complete remedy at law whereby damages for the wrongs complained of could be recovered. History and limits of the jurisdiction explained. Root *v.* Railway Co., 105 *U. S.* 189.

A bill was sustained, under the circumstances of the case, notwithstanding the patent had expired, on the ground that it was not necessarily to be treated as a bill for infringement, but might be deemed founded on an agreement proved between the parties, and which amounted to an executed license ; and that, viewed in this aspect, the bill was not open to the objection that there was a complete and adequate remedy at law, because an account and a discovery were necessary to ascertain the facts from which the damages to the plaintiffs could be computed, and the bill was a bill for an account and a discovery. Magic Ruffle Co. *v.* Elm City Co., 13 *Blatchf.* 151 ; 8 *Pat. Off. Gaz.* 773.

After a bill in equity had been filed for the infringement, the patent was surrendered, and a reissued patent was granted. The plaintiff then moved for leave to file a supplemental bill founded on the reissued patent and for an injunction. It was *held*, that the motions must be denied, on the ground that, by the surrender and reissue, the suit was at an end, and that the plaintiff must proceed by original bill founded on the reissued patent. Fry *v.* Quinlan, 13 *Blatchf.* 205. To same effect, Jones *v.* Barker, 11 *Fed. Rep'r*, 597 ; 22 *Pat. Off. Gaz.* 771.

Filley invented and patented a new stove, known as the "Charter Oak ;" but for a long time allowed Jacobus to make and sell it, and to use that name. It was *held*, that he could not, after the patent expired, have an injunction to forbid Jacobus from continuing the sale under the name "Charter Oak," so long as the latter did not represent the stoves he sold as having been made by Filley. Filley *v.* Child, 16 *Pat. Off. Gaz.* 261 ; 16 *Blatchf.* 376 ; 4 *Bann. & A. Pat. Cas.* 353.

A manufacturer of scales cannot claim protection, after expiration of his patent for scales, against another person's making scales in imitation of the form, color, &c., of those manufactured by plaintiff. Neither a patent or a trade-mark relates to the accidental

exterior appearance of such an article. The patent (while it lasted) protected only the novel, substantial mechanism ; and the trade-mark only forbids representing defendant's article as being of the manufacture of plaintiff. Fairbanks *v.* Jacobus, 14 *Blatchf.* 337.

The use of machines made in the life-time of a patent and infringements thereof when made,—enjoined after it had expired. Reay *v.* Raynor, 19 *Fed. Rep'r*, 308; 22 *Blatchf.* 13 ; 26 *Pat. Off. Gaz.* 1111.

A bill in equity for infringement of a patent, asking an account of profits and damages, and an injunction, provisional and perpetual, was filed only four days before the expiration of the patent. It was *held*, that as notice of eight days of a motion for an injunction was required by the rules of the court, and no injunction could therefore be obtained, and the sole object of the bill appeared to be pecuniary compensation in the form of profits or damages, a demurrer should be sustained. Mershon *v.* J. F. Pease Furnace Co., 24 *Fed. Rep'r*, 741 ; 32 *Pat. Off. Gaz.* 1011.

But where a bill, although filed only twenty-six days before the expiration of the patent, set forth that the plaintiff, having retained the exclusive right to make and sell the patented article, was exercising it, and was able to supply the market, and that defendants were making machines containing the invention, and threatened to make them in large quantities, and intended to put on the market, after the expiration of the patent, infringing machines made before it expired, and prayed an injunction restraining the sale, after as well as before the expiration of the patent, of machines unlawfully made before it expired ; it was *held*, that a demurrer to the bill should be overruled. Toledo Mower, &c. Co. *v.* Johnston Harvester Co., 24 *Fed. Rep'r*, 739 ; 32 *Pat. Off. Gaz.* 1010.

A bill in equity for infringement of a patent was filed May 5th, 1885, and process was served on the defendants two days afterward, but no steps were taken to secure a preliminary injunction. The patent expired June 16th, 1885. It was *held*, that a demurrer to the bill should not be sustained because of the expiration of the patent, the case being cognizable in equity at the time the bill was filed. Dick *v.* Struthers, 25 *Fed. Rep'r*, 103 ; 34 *Pat. Off. Gaz.* 131.

Three patents were used in one process, and therefore must be considered in connection in estimating profits. One of them had only three months to run, when the bill was filed. This was *held*

no ground for dismissing the bill. New York Grape Sugar Co. *v.* Peoria Grape Sugar Co., 21 *Fed. Rep'r*, 878 ; 32 *Pat. Off. Gaz.* 138.

In a suit in equity for infringement of a patent, in which an injunction and accounting were sought, several changes of parties were made by amendment of the bill, by one of which the heirs at law of one of the patentees were made parties. Pending the suit, the patent expired, and not until afterwards was the administrator of the deceased patentee made a party, by a further amendment of the bill. It was *held* that the suit must be regarded as commenced when such administrator was brought in, and, the patent having then expired, a court of equity had no jurisdiction. Hewitt *v.* Pennsylvania Steel Co. 24 *Fed. Rep'r*, 367 ; 31 *Pat. Off. Gaz.* 1687.

252. *Effect of Abandonment, Acquiescence, or Delay, on the Jurisdiction.*

Equity will not interfere in behalf of patentee, either to grant an injunction, or give him any other relief in respect to an alleged violation of his patent, if, after having obtained his patent, he has dedicated it to the public, or acquiesced for a long period in the public use thereof, without objection ; in such a case his own conduct may be considered as having led to the use of the invention complained of. Wyeth *v.* Stone, 1 *Story*, 273 ; 4 *L. Rep'r*, 54.

A court of equity is reluctant, even when satisfied that a patent is valid, to enforce it by enjoining infringements, where the patentee is chargeable with laches in seeking relief. And this principle extends to assignees of the patent under an extension. Goodyear *v.* Honsinger, 3 *Fish. Pat. Cas.* 147 ; 2 *Biss.* 1.

Mere delay in bringing suit for infringement is not sufficient to establish an abandonment or dedication. There must be an acquiescence in the appropriation of the right, of such character as reasonably to induce the belief that the owner intended to relinquish it to the public. Williams *v.* Boston & Albany R. R. Co., 16 *Pat. Off. Gaz.* 906 ; 17 *Blatchf.* 21 ; 4 *Bann. & A. Pat. Cas.* 441

Thus, if a patentee has neglected to file a disclaimer, in a case where he ought to do so, until after suit is brought, a court of equity will not interfere to grant a perpetual injunction, whatever

may be his right and remedy at law. Wyeth *v.* Stone, 1 *Story*, 273; 4 *L. Rep'r*, 54.

Where there were satisfactory reasons for the delay, it will be excused. Thus, where the validity of a patent was in litigation, it was *held* not laches on the part of the patentee to wait until a decision was rendered, before bringing suit against infringers. Green *v.* Barney, 19 *Fed. Rep'r*, 420. And a patentee will not be deemed to have acquiesced in the use of his invention so as to deprive him of the right to an injunction, because he first proceeded against only the more palpable and obvious violations of his patent, or because he has not brought suit against all persons infringing upon it. Van Hook *v.* Pendleton, 1 *Blatchf.* 187.

253. *Effect of Delay, &c. in Particular Instances.*

Twenty days before the expiration of a patent for a "self-raising" flour, motions for injunctions in over fifty suits, to restrain the infringement of the patent, were made. All of the suits but one were against grocers who were selling the flour. One was against a manufacturer. The patent had been sustained on final hearing in other suits, but had been much litigated, and until recently. Since then, there had been no unnecessary delay. It was *held*, that no laches could be imputed to the plaintiff. An apprehension that the grocers may fear to sell non-infringing flours, and thus cause injury to the manufacturers of such flours, was no ground for withholding injunctions against the grocers. Rumford Chemical Works *v.* Vice, 14 *Blatchf.* 179; 2 *Bann. & A. Pat. Cas.* 584.

Where the patentee gave prompt notice to an infringer to cease infringing, and, within two years thereafter, and before the commencement of legal proceedings, repeated the notice three times, and the business engagements of the patentee were many and pressing, and he gave no affirmative encouragement to the infringer. It was *held*, that the right to a preliminary injunction, in a case otherwise plain, would not be affected by the delay. Collignon *v.* Hayes, 8 *Fed. Rep'r*, 912; 20 *Pat. Off. Gaz.* 447.

Where the patentee had knowledge of the infringement for nearly two years before applying for an injunction, and had warned the defendants that they were infringers. It was *held*, that a motion for an injunction should be denied for want of diligence. Sperry *v.* Ribbands, 3 *Bann. & A. Pat. Cas.* 260; 1 *N. J. L. J.* 115.

The loss of a patent issued under the act of 1793, and which by that act was required to be recorded, is no excuse for delay in applying for an injunction for its infringement. A copy would be as good evidence of the right as the original, or as a new patent issued under the act of 1837. Cooper *v.* Matthews, 8 *L. Rep'r*, 413.

From a bill in equity for infringement of a patent, it appeared that the patent had been in existence for about 15 years, and that the infringement had continued 13 years; and no excuse for the delay on the part of complainant was shown. It was *held*, that a demurrer should be sustained, on the ground of laches. McLaughlin *v.* People's R. Co., 21 *Fed. Rep'r*, 574; 29 *Pat. Off. Gaz.* 277.

Delay for more than seven years in proceeding against open infringers of complainants' patent was *held*, ground for refusing a preliminary injunction against the same parties, notwithstanding the owners of the patent had, during that time, been engaged in disputes among themselves, and in establishing their rights against other infringers. Ladd *v.* Cameron, 25 *Fed. Rep'r*, 37.

254. *Proper Persons to be Complainants in a Suit in Equity.*

Only the patentee, or an assignee of the entire and exclusive right for a specific territory can bring suit in equity for infringement. An assignee of a part only of the right, as an assignee of the right to use and sell but not to manufacture cannot sue in his own name. Hill *v.* Whitcomb, 5 *Pat. Off. Gaz.* 430; 1 *Holmes*, 317; 1 *Bann. & A. Pat. Cas.* 34.

In a suit in equity brought on letters patent for a machine, to restrain the defendant from making the patented machines and selling them to parties who buy them for exportation to and use in foreign countries, the owner of the legal title to the patent should be joined as plaintiff with the holder of the exclusive right to make and vend the patented invention for use in foreign countries. Dorsey, &c. Rake Co. *v.* Bradley Manuf. Co., 12 *Blatchf.* 202.

In a suit for infringement, those who have a title to the patent are necessary parties; if others are joined as parties, it is not necessary to dismiss the bill, but merely strike off their names. Edgarton *v.* Breck, 5 *Bann. & A. Pat. Cas.* 42.

A bill to enjoin infringement, which does not join all the owners of the patent, is fatally defective; but this rule requires the joinder of only those persons to whom interests have been transferred by assignments in writing duly authenticated. Jordan *v.* Dobson, 2 *Abb. U. S.* 398; 7 *Phila.* 533.

A motion to dismiss a bill for an injunction, on the ground that complainant has parted with all his interest in the suit, will be denied if it appears that the assignment was made after the computation of profits ended. Dean *v.* Mason, 20 *How.* 198.

A patent granted to the administrator of an inventor is held by him, *prima facie*, in trust for the heirs; and they must be parties to a suit in equity on the patent, so long as they retain such an interest; if, however, the inventor sold his interest prior to his decease, the assignee must be made the party, and not the heirs. North-western Fire Extinguisher Co. *v.* Philadelphia Fire Extinguisher Co., 6 *Pat. Off. Gaz.* 34; 10 *Phila.* 227; 1 *Bann. & A. Pat. Cas.* 177.

One of a number of joint tenants in a patent cannot enjoin the other from the use or sale of the patent; nor can the equitable owner of a patent be enjoined from using it, upon a bill filed by one holding the legal title only. Clum *v.* Brewer, 2 *Curt.* 506.

Where the legal and the equitable right to a patent are in different persons, both should join as plaintiffs in a suit in equity for an injunction and an account. Stimpson *v.* Rogers, 4 *Blatchf.* 333.

The next of kin of a patentee cannot be united with the personal representatives, as parties plaintiff in a bill to enjoin the infringement of the rights secured by the patent, and for an accounting. Hodge *v.* North Missouri R. R. Co., 1 *Dill.* 104; 4 *Fish. Pat. Cas.* 161.

A former owner of a patent, who, in the instrument conveying it, reserved to himself the right to use and to license others to use the patented process to a certain specified extent, is not a necessary party to a suit by the person to whom he conveyed, as against third persons, to restrain infringement. Frankfort Whisky Process Co. *v.* Pepper, 26 *Fed. Rep'r*, 336.

If the owner of an equitable right or interest in a patent institute a suit in equity for his own benefit in the name of the owner of the legal title, for an injunction and an account, he will be made a co-plaintiff with the owner of the legal title upon application to the court, even after answer is filed, testimony published, and the

case is placed on the term calendar for final hearing. Patterson *v.* Stapler, 7 *Fed. Rep'r*, 210 ; 27 *Int. Rev. Rec.* 171 ; 11 *Repr*, 731.

A party alleged to have an interest in a patent sued on may disclaim all interest in favor of complainant, and thus obviate the objection that he should be joined as a party. Graham *v.* Geneva Lake Crawford Manuf. Co., 11 *Fed. Rep'r*, 138 ; 21 *Pat. Off. Gaz.* 1536.

A bill for an infringement was founded not on the title of the original patentee, but on the derivative title of the complainant first named in the bill, to whom, as executor of the deceased inventor, the patent was reissued. It was *held* that the objection to the right of the complainants to maintain their bill, because only one of the persons named as executors in the last will and testament of the original patentee was made a party to the bill, could not be sustained ; the reissued patent, under the circumstances, was a new contract between the government and the executor, subsequent to the decease of the original patentee. Goodyear *v.* Providence Rubber Co , 2 *Cliff.* 351 ; 2 *Fish. Pat. Cas.* 499.

A suit for an accounting of profits for infringement of a patent by a corporation cannot be sustained on behalf of parties who, as officers and managers of the corporation, were actively engaged in such infringement, but subsequently sold their stock in the corporation and purchased the patent. New York Grape Sugar Co. *v.* Buffalo Grape Sugar Co., 24 *Fed. Rep'r*, 604 ; 32 *Pat. Off. Gaz.* 1356.

Who is such assignee as may sue in his own name. See Littlefield *v.* Perry, 21 *Wall.* 205.

The fact that an assignee cannot sue at law in his own name does not entitle him to resort to equity. Hayward *v.* Andrews, 106 *U. S.* 672.

A patentee may maintain an action at law upon a patent, in his own name, although he is under a contract to assign it to others so long as the assignment has not been executed ; but equity regards that as already done which the patentee has agreed to do, and will require that the proposed assignees be made parties to any bill in chancery brought against infringers. If, however, the other parties to such a contract release to the patentee all their interest in the patent, he may maintain a bill in his own name for all subsequent infringements, but not for those committed previous to the release ; neither can he recover damages for any infringements committed after he has sold and assigned the patent.

Wheeler *v.* McCormick, 4 *Pat. Off. Gaz.* 692 ; 11 *Blatchf.* 334 ; 8 *Fish. Pat. Cas.* 551.

One who is only a licensee cannot sue in equity in his own name, but must join with him the owner of the legal title as plaintiff. Nelson *v.* McMann, 16 *Pat. Off. Gaz.* 761 ; 16 *Blatchf.* 139 ; 4 *Bann. & A. Pat. Cas.* 203.

In an equitable suit brought by a married woman in the circuit court in the district of New York for infringement, the husband need not be joined. Lorillard *v.* Standard Oil Co., 21 *Alb. L. J.* 492.

The receiver of a corporation appointed under the law of Pennsylvania, being, by the law of that State, the mere custodian of the property of the corporation, cannot maintain in his own name a suit for infringement of a patent owned by the corporation. Dick *v.* Struthers, 25 *Fed. Rep'r*, 103 ; 20 *Rep'r*, 643

255. *Proper Persons to be Made Defendants.*

A patentee should not be joined with his licensee, as defendant in a suit for infringing an earlier patent by manufacturing and selling the licensed machine, if the patentee made defendant has no other connection with the infringement than receiving the royalty. The licensee is the party liable for his sales. Hussey *v.* Bradley, 5 *Blatchf.* 134 ; 2 *Fish. Pat. Cas.* 362.

The use of a patented machine under a license by an assignee of the license may be enjoined, where the assignee refuses to pay the tariff agreed upon as the consideration for such license ; but the assignee cannot be enjoined by reason of a default in paying the tariff happening prior to the assignment ; he is liable only for his own default. Goodyear *v.* Congress Rubber Co., 3 *Blatchf.* 449.

In a suit for infringement the bill alleged that the defendants had "jointly and collectively, and also separately," used and sold bottle-stoppers containing the patented invention. It was *held* that although no joint sale or use was shown, yet as the bill was framed to recover for separate infringements and was not demurred to on that ground, and the case went on upon that issue, that the plaintiff could maintain the suit as a suit against each defendant separately. Putnam *v.* Hollander, 6 *Fed. Rep'r*, 882 ; 19 *Blatchf.* 48 ; 19 *Pat. Off. Gaz.* 1423.

The unauthorized use of a patent by the agent of a joint stock

association, in its business, for the benefit of its stockholders, must be considered as a use by each of them, from which each of them may be enjoined; notwithstanding that under the laws of the State, there being more than seven shareholders, the association might have been sued as a whole by suing the president, without making all the shareholders parties. Tyler *v.* Galloway, 13 *Fed. Rep'r*, 477; 22 *Pat. Off. Gaz.* 1294; 14 *Rep'r*, 771; 21 *Blatchf.* 66.

256. *In what Cases Agents, Contractors, Laborers, Corporate Officers, may be Sued.*

An injunction will not be granted against a person, restraining him from using a patented machine, unless it is shown that he actually used it, or employed others to use it for him, or received profits from its use; except that, to prevent evasions, a workman on a machine, though not interested in it, is liable to be restrained. Woodworth *v.* Hall, 1 *Woodb. & M.* 248. Later it was *held*, in the same district, that a decree for an account cannot be had against a mere workman, who has been instrumental, while in the employment of another, in the infringement; he having had nothing to do with the profits. Sargent *v.* Larned, 2 *Curt.* 340. Where a person runs a machine which others own, and which machine is a violation of a patent, an injunction may issue against all for the violation. Woodworth *v.* Edwards, 3 *Woodb. & M.* 120.

When contractors laid, for a city, a pavement which infringed the patent of N.; and the city paid them as much therefor as it would have had to pay him had he constructed the improvement, it was *held*, in a suit in equity, to recover profits, brought against the city and the contractors, that the latter alone were responsible. The city might have been enjoined before the completion of the work, and perhaps would have been liable in an action for damages; but it was not chargeable for profits, because it had not realized any; the profits had inured to the benefit of the contractors. Elizabeth *v.* Pavement Co., 97 *U. S.* 126.

The directors of a manufacturing corporation, who manage and superintend its business, and under whose direction it manufactures and sells articles which are an infringement of a patent, and its agents, who conduct its business of selling such articles, are responsible for such infringement, and may be joined as defendants in an injunction suit. Goodyear *v.* Phelps, 3 *Blatchf.* 91. So an officer

of a corporation owning a patent, who has personally executed an agreement on behalf of the corporation, a third person to furnish the infringing machines under a tariff as rent, is a proper defendant to a suit to restrain such manufacture, brought on the ground that it is an infringement of a prior patent owned by the complainant. Nichols *v.* Pearce, 7 *Blatchf.* 5. But see a case where officers were *held* not liable for royalty, where they had derived no personal benefit, and had acted in good faith (Phillips *v.* Detroit, 16 *Pat. Off. Gaz.* 627); and a case where corporate officers were *held* liable, because they refused to disclose to the patentee the names of the persons really responsible. American Cotton Tie Supply Co. *v.* McCready, 17 *Blatchf.* 291 ; 17 *Pat. Off. Gaz.* 565 ; 4 *Bann. & A. Pat. Cas.* 588.

The fact that a defendant who has sold an article which infringes on a patent, sold it on behalf of its owner, and had no interest in it or its sale, is no ground for refusing to grant an injunction against him. Maltby *v.* Bobo, 14 *Blatchf.* 53 ; 2 *Bann. & A. Pat. Cas.* 459.

A man worked for the defendant by the piece, in the defendant's manufactory, and there used, in the defendant's business, folding-guides, his own property, which infringed the plaintiff's patent. It was *held*, in a suit in equity, that the defendant had infringed the patent. Wooster *v.* Marks, 17 *Blatchf.* 368 ; 9 *Rep'r*, 201 ; 5 *Bann. & A. Pat. Cas.* 56.

An employee may be liable to account for the commissions derived by him from the sale of infringing goods, and may be enjoined from making any further sales. And a suit against the employer, brought in another district, for such sales, cannot be pleaded in bar to a suit against such employee for an account and injunction. Steiger *v.* Heidleberger, 4 *Fed. Rep'r*, 455 ; 18 *Blatchf.* 426 ; 18 *Pat. Off. Gaz.* 1463 ; 11 *Rep'r*, 212.

An assignment of the revenues of a railroad to a preferred creditor, and the use, by the assignee, of cars which have patented brakes attached to them, does not render him liable to account for infringement of the patent, if the brakes had been licensed to the company ; the assignee uses the brakes as agent of the company, not as purchaser. Emigh *v.* Chamberlain, 1 *Biss.* 367 ; 2 *Fish. Pat. Cas.* 192 ; 1 *Am. L. Reg. N. S.* 207.

In a suit for infringement of a patent, against a corporation, its president, L., and another, the subpœna was not served on L., but a solicitor appeared for the defendants, without naming them, and

their answer was sworn to by L. as one of the defendants and signed by his individual name. It was *held*, that he had become personally a party, so that a decree for relief asked in the bill against him personally might properly be made. Lewis *v.* Standard Laundry Machinery Co., 21 *Blatchf.* 184.

A bill for a discovery may be maintained, in aid of an action at law for damages for infringement of a patent, against a corporation as defendant, without making its officers parties. That similar relief could be obtained by the complainant in his action at law under the local practice, does not deprive the court of its equitable jurisdiction to compel a discovery in such cases. Colgate *v.* Compagnie Francaise du Telegraphe, 23 *Fed. Rep'r*, 82.

A son, who is employed in the shop of his father as superintendent, having no interest in the business, is not liable for an infringement of a patent, merely because the infringing machine is used in the shop under his direction. McDonald *v.* Whitney, 24 *Fed. Rep'r*, 600; 32 *Pat. Off. Gaz.* 1465.

257. *The Right to a Preliminary Injunction in General.*

To entitle complainant in equity to the remedy of a preliminary injunction, his title by the patent, and the proof of infringement by defendant must be free from doubt. Marks *v.* Corn, 11 *Fed. Rep'r*, 900; 23 *Pat. Off. Gaz.* 94; Steam Gauge, &c. Co. *v.* Miller, 11 *Fed. Rep'r*, 718; Steam Gauge & Lantern Co. *v.* Miller, 8 *Fed. Rep'r*, 314; 20 *Pat. Off. Gaz.* 889; Bradley, &c. Manuf. Co. *v.* Charles Parker Co., 17 *Fed. Rep'r*, 240; 24 *Pat. Off. Gaz.* 995; Illingworth *v.* Spaulding, 9 *Fed. Rep'r*, 154; 12 *Rep'r*, 354. See Isaacs *v.* Cooper, 4 *Wash.* 259; Woodworth *v.* Hall, 1 *Woodb. & M.* 248; *Id.* 389; 6 *Pa. L. J.* 178.

The mere fact that the complainant has obtained a patent is not enough, standing alone, to entitle him to an injunction, before a hearing upon the merits. Orr *v.* Littlefield, 1 *Woodb. & M.* 13; 8 *L. Rep'r*, 314.

The grant of a patent by the patent-office is not, of itself, a bar to an interlocutory injunction in favor of a person claiming to be a prior patentee of the same thing; particularly when such person had no notice to appear and be heard at the patent-office, and the court is satisfied that the last granted patent was an interference. Wilson *v.* Barnum, 1 *Wall. Jr.* 347; 6 *West. L. J.* 464; 2 *Fish. Pat. Cas.* 635.

Where an interference between complainant and defendants' assignor was decided in favor of complainant, to whom a patent was granted, and he subsequently moved for an injunction thereon, it was *held*, that the interference proceedings did not estop defendants from setting up as a defense that the invention patented was anticipated by another device. Peek, &c. Co. *v.* Lindsay, 5 *Bann. & A. Pat. Cas.* 390. Compare Smith *v.* Halkyard, 16 *Fed. Rep'r*, 414; 23 *Pat. Off. Gaz.* 1832.

Where the commissioner of patents has granted a reissue with an expanded claim, a preliminary injunction may be awarded to restrain infringement of the patent. Lorillard *v.* McDowell, 23 *Int. Rev. Rec.* 90.

Where the validity of a patent is fully established, the plaintiff is entitled to protection by an injunction; and the fact that great injury may thereby be caused to the infringer by interrupting his business as a common carrier, even though to the inconvenience of the public, is no ground for refusing it. Hodge *v.* Hudson River R. R. Co., 6 *Blatchf.* 165.

Where a defendant sued for infringement of plaintiff's patent shows that he is acting under a patent which has been issued to himself, an injunction before the trial should not be allowed. Goodyear *v.* Dunbar, 1 *Fish. Pat. Cas.* 472.

Where the defendant has done the acts complained of under the authority of a patent, and with the knowledge of the plaintiff, and unmolested for a length of time, and has invested money in the business sought to be stopped, plaintiff is not entitled to ask a preliminary injunction; except in a case free from all reasonable doubt. North *v.* Kershaw, 4 *Blatchf.* 70.

If defendant has used the patented invention unlawfully and without making compensation, the plaintiff is not deprived of his right to a preliminary injunction by the fact that defendant has discontinued such use and disclaims any intention of resuming it. Sickles *v.* Mitchell, 3 *Blatchf.* 548; Rumford Chemical Works *v.* Vice, 14 *Blatchf.* 179; 2 *Bann. & A. Pat. Cas.* 584; Poppenhusen *v.* New York Comb Co., 4 *Blatchf.* 184; 2 *Fish. Pat. Cas.* 79. S. P., Buck *v.* McGill, 4 *McLean*, 174; Potter *v.* Crowell, 1 *Abb. U. S.* 89; 3 *Fish. Pat. Cas.* 112. The complainant in such a case is not obliged to rest his interests on the mere asseveration of the party that he will not repeat the act of infringement. Having once been a wrongdoer, the law supposes the possibility of his being so again, and will impose the proper restraint to prevent the repetition

of the wrongful act. Jenkins *v.* Greenwald, 1 *Bond*, 126; 2 *Fish. Pat. Cas.* 37.

258. *The Application; how Made, and how Heard and Determined.*

In patent causes, the United States courts may, in a proper case, grant a preliminary injunction without requiring notice to be given. Yuengling *v.* Johnson, 1 *Hughes*, 607; 3 *Bann. & A. Pat. Cas.* 99.

Informality in the notice of motion is cured by appearance of the defendant. Brammer *v.* Jones, 3 *Fish. Pat. Cas.* 340.

To grant a motion for a preliminary injunction on a patent, on a theory, which, although it may be true, is not supported by affidavits, is not proper. American Diamond Rock Boring Co. *v.* Sullivan Machine Co., 14 *Blatchf.* 119; 2 *Bann. & A. Pat. Cas.* 522.

Upon a motion for an injunction to restrain an infringement, the plaintiff should include in or subjoin to his bill a special affidavit to the truth of the allegations therein, and that he was the original and first inventor, as he believed, of the thing patented, and that the same had not been in use or described anterior to his invention. The formal oath to originality of the invention, made when applying for the patent, does not suffice, for the motion. Rogers *v.* Abbott, 4 *Wash.* 514. S. P., Sullivan *v.* Redfield, 1 *Paine*, 441.

The applicant for a preliminary injunction should state facts sufficient to allow the court to decide whether or not there has been an infringement; his affidavit merely that there has been one is not sufficient. Kirby Bung Manuf. Co. *v.* White, 5 *Bann. & A. Pat. Cas.* 263; 1 *Fed. Rep'r*, 604; 1 *McCrary*, 155; 17 *Pat. Off. Gaz.* 974.

Where the bill states an exclusive possession of the invention for which the plaintiff has obtained a patent, a preliminary injunction may be granted, although the court may feel doubts as to the validity of the patent. Issacs *v.* Cooper, 4 *Wash.* 259. To nearly same effect, Woodworth *v.* Hall, 1 *Woodb. & M.* 248; 6 *Pa. L. J.* 178.

Under the rules of the circuit court in the second circuit, the court, or a judge out of a court, has power, on a motion for a provisional injunction where the defendant sets up a license in defense,

to permit the plaintiff to put in proofs in rebuttal of the proofs put in by the defendant ; and the order to admit such rebutting proofs, when made by the court, is regular, although not made till such rebutting proofs are received. The defendant is not entitled to reply to such rebutting proofs by further proofs on his part. Day *v.* New England Car Spring Co., 3 *Blatchf.* 154.

On a motion for a preliminary injunction to restrain the infringement of letters patent, the court will not look further into the case than to ascertain whether or not, upon established principles of equity, the interference of the court is required to prevent an irreparable injury pending the litigation. And unless the right is clear upon the papers and proofs presented in favor of the plaintiffs, the injunction will be refused. Sickels *v.* Youngs, 3 *Blatchf.* 293.

An application for a provisional injunction, to restrain a defendant from continuing an alleged infringement of a patent owned by the complainant, is addressed to the discretion of the court. Wyeth *v.* Stone, 1 *Story*, 273, 295 ; 4 *L. Rep'r*, 54 ; Orr *v.* Badger, 7 *L. Rep'r*, 465 ; 1 *Brunner Col. Cas.* 537 ; Forbush *v.* Bradford, 21 *L. Rep'r*, 471 ; 1 *Fish. Pat. Cas.* 317 ; Orr *v.* Littlefield, 1 *Woodb. & M.* 13 ; 8 *L. Rep'r*, 314 ; Earth Closet Co. *v.* Fenner, 5 *Fish. Pat. Cas.* 15 ; Irwin *v.* Dane, 4 *Fish. Pat. Cas.* 359.

In granting injunctions against the violation of patent rights, the court proceeds according to the course and principles of courts of equity in similar cases. Sullivan *v.* Redfield, 1 *Paine*. 441.

On an application for a preliminary injunction to restrain infringements of a patent which had been reissued, and had been frequently adjudicated upon and sustained, it was *held*, that the court would not entertain questions as to the originality of the invention, or the validity of the reissued patent. Gibson *v.* Betts, 1 *Blatchf.* 163.

Although, on a motion for an injunction to restrain an infringement of letters-patent, the proofs should show that, on the trial of an issue awarded in the cause, on the question of infringement, the jury found in favor of the plaintiff, still the court will not, as a matter of course, adopt the verdict, but will examine the whole case, including the evidence given before the jury, and will grant or withhold the injunction according to its own judgment thereon. Sickels *v.* Youngs, 3 *Blatchf.* 293.

Where the answer in an infringement suit denies that the patentee was the true inventor, or denies that the defendant uses the plaintiff's invention, an injunction will be refused. American Car-

pet Lining Co. *v.* Beale, 5 *Bann. & A. Pat. Cas.* 520; Isaacs *v.* Cooper, 4 *Wash.* 259.

If the complainant's patent has been sustained in a suit to the defense of which the defendants contributed, he is entitled to a provisional injunction against them, although they allege in their answer that they have a witness to the prior use of the invention, who was not examined on the trial. Birdsall *v.* Hagerstown Agricultural Implement Manuf. Co., 6 *Pat. Off. Gaz.* 604; 1 *Bann. & A. Pat. Cas.* 420.

The person who originally took out the patent will not be allowed, when sued to enjoin him from infringing it, to dispute the novelty or utility of the invention. Onderdonk *v.* Fanning, 4 *Fed. Rep'r*, 148; 5 *Bann. & A. Pat. Cas.* 85.

In a suit to restrain an infringement, where issues of fact are presented, supported on one side by affidavits and contradicted by affidavits on the other side, so that they neutralize each other, a motion for the allowance of such an injunction will be denied. Beane *v.* Orr, 9 *Pat. Off. Gaz.* 255.

If, on a motion for an injunction, there appears, from the affidavits of the parties or witnesses, such a repugnancy in point of fact, as makes it necessary to decide on the relative truth of their conflicting statements, or the credibility of the affirmants, the injunction will not be granted. Cooper *v.* Matthews, 8 *L. Rep'r*, 413. But where a motion for an injunction against infringement rests upon affidavits of dealers in the article, stating their opinion as to its composition, and is opposed by counter-affidavits of the manufacturer of the article, who states the composition from his personal knowledge, the repugnancy is not irreconcilable; but the statements founded on personal knowledge are deemed more reliable, and the injunction will be denied. Gutta percha Co. *v.* Goodyear Co., 3 *Sawyer*, 542; 2 *Bann. & A. Pat. Cas.* 212.

A preliminary injunction ought never to be issued, unless the right of a patentee is an established or admitted one, and unless the alleged invasion of the right is proved beyond reasonable doubt. Parker *v.* Sears, 4 *Pa. L. T. Rep.* 443; 1 *Fish. Pat. Cas.* 93. Batten *v.* Sillman, 3 *Wall. Jr.* 124; American Nicholson Pavement Co. *v.* Elizabeth, 4 *Fish. Pat. Cas.* 189; 3 *Pat. Off. Gaz.* 522; Bailey Wringing Machine Co. *v.* Adams, 5 *Cent. L. J.* 425; 3 *Bann. & A. Pat. Cas.* 96; Irwin *v.* Dane, 4 *Fish. Pat. Cas.* 359; Evans *v.* Kelly, 13 *Fed. Rep'r*, 903; 9 *Biss.* 251; 26 *Int. Rev. Rec* 349; 23 *Pat. Off. Gaz.* 192; 5 *Bann. & A. Pat. Cas.* 71.

Application for preliminary injunction may be granted as to articles embraced in the suit which are clearly infringements and denied as to others which are doubtful. Allis *v.* Stowell, 23 *Pat. Off. Gaz.* 1033 ; 15 *Fed. Rep'r*, 242.

A district judge cannot sign a writ of injunction by himself in vacation when the circuit court is sitting and can be applied to. Goodyear Dental Vulcanite Co. *v.* Folsom, 5 *Bann. & A. Pat. Cas.* 590 ; 3 *Fed. Rep'r*, 509 ; 26 *Int. Rev. Rec.* 251.

The patent having been sustained upon final hearing against a corporation intimately connected with the defendant, the latter, in adducing new matter, must show a strong probability, that if it had been put in evidence in former suit, a different result would have been reached. Colgate *v.* Gold & Stock Telegraph Co., 16 *Pat. Off. Gaz.* 583.

Although the court should examine anew the case, the defendant not having been a party to any former suits, yet if the points presented are the same, former decisions must be given great weight. Potter *v.* Whitney, 3 *Fish. Pat. Cas.* 77.

Where a plaintiff moves for an injunction, and it is denied on defects pointed out, it is too late, after defendant has closed his proofs for final hearing, to renew his motion upon papers designed to cure such defects. Wooster *v.* Howe Sewing Machine Co., 16 *Pat. Off. Gaz.* 314.

259. *Necessity of First Establishing Plaintiff's Title at Law.*

A patent is *prima facie* evidence of a right ; but to grant an injunction upon the mere exhibition of a patent, and an allegation that it has been infringed, is not matter of course; the court should be reasonably satisfied as to the validity of the patent, either by result of some judicial investigation or by proof of long public acquiescence. Sullivan *v.* Redfield, 1 *Paine*, 441 ; Grover, &c. Sewing Machine Co. *v.* Williams, 2 *Fish. Pat. Cas.* 133 ; Tappan *v.* National Bank Note Co. *Id.* 195.

So long as there is room for doubt whether the patent under which the complainant claims is valid, the court will not grant a provisional injunction, but will require him first to establish its validity, in an action at law. Washburn *v.* Gould, 3 *Story*, 122 ; 1 *West. L. J.* 465 ; 7 *L. Rep'r*, 276 ; Concord *v.* Norton, 16 *Fed.*

Rep'r, 477 ; Sullivan *v.* Redfield, 1 *Paine*, 441 ; Thomas *v.* Weeks, 2 *Paine*, 92 ; Isaac *v.* Cooper, 4 *Wash.* 259 ; Ogle *v.* Ege, *Id.* 584 ; Miller *v.* McElroy, 1 *Pa. L. J. Rep.* 304 ; Brooks *v.* Bicknell, 4 *McLean*, 70 ; 3 *West. L. J.* 109.

In general, a preliminary injunction is granted only, 1, where the right of the complainant has been established at law ; or, 2, where he has enjoyed the patent, avowedly and as against the public, for a considerable period unquestioned ; or, 3, where his right is clear and unquestionable. North *v.* Kershaw, 4 *Blatchf.* 70 ; Toppan *v.* National Bank Note Co., *Id.* 509 ; 2 *Fish. Pat. Cas.* 202 ; Irwin *v.* McRoberts, 16 *Pat. Off. Gaz.* 853. To nearly same effect, Doughty *v.* West, 2 *Fish. Pat. Cas.* 553.

Although a decision has been made against the validity of the original patent on account of defects in the specifications, yet a preliminary injunction may be granted on a reissue. Schneider *v.* Bassett, 13 *Fed. Rep'r*, 351 ; 22 *Pat. Off. Gaz.* 1447.

Whether the judgment at law relied upon to support an application for a preliminary injunction must have been rendered in the same circuit or district as that wherein the suit in equity is filed, or whether a judgment in another circuit or district is sufficient, see Wells *v.* Gill, 2 *Pat. Off. Gaz.* 590 ; 6 *Fish. Pat. Cas.* 89 ; Pennsylvania Salt Co. *v.* Myers, 1 *Week. N. of Cas.* 377 ; Spring *v.* Domestic Sewing Machine Co., 2 *N. J. L. J.* 274 ; De Ver Warner *v.* Bassett, 7 *Fed. Rep'r*, 468 ; 12 *Rep'r*, 35.

Prior adjudications on the same issues in other circuits will be sufficient for the purpose of granting a temporary injunction. American Bell Telephone Co. *v.* National Improved Telephone Co., 27 *Fed. Rep'r*, 663.

Whether a judgment rendered upon consent of the parties is such an adjudication as will sustain the plaintiff in making application for a provisional injunction against a third person, see Orr *v.* Littlefield, 1 *Woodb. & M.* 13 ; 8 *L. Rep'r*, 314 ; De Ver Warner *v.* Bassett, 7 *Fed. Rep'r*, 468 ; 12 *Rep'r*, 35.

For decisions of the courts in former years which determine questions of detail in the application of the rule that a patent must have been sustained at law before equity will grant a preliminary injunction, see the following : Verdict without judgment sufficient. Orr *v.* Badger, 7 *L. Rep'r*, 465 ; 1 *Brunner Col. Cas.* 537. Recoveries against other persons sufficient against an infringer. Hovey *v.* Stevens, 1 *Woodb. & M.* 290 ; Woodworth *v.* Hall, *Id.* 248 ; 6 *Pa. L. J.* 178. Efforts to obtain adjudications, causing great delay

and loss, but frustrated by disagreements of juries, sufficient. Buck *v.* Cobb, 9 *L. Rep'r*, 545 ; 1 *Brunner Col. Cas.* 550. Where there had been an adjudication sustaining the claim of the patent which defendant was infringing, although the patent contained another claim which was in dispute. Colt *v.* Young, 2 *Blatchf.* 471. Where there had been an adjudication sustaining the patent, but it was under review in the supreme court. Wells *v.* Gill, 2 *Pat. Off. Gaz.* 590 ; 6 *Fish. Pat. Cas.* 89. Decree against buyers and users, sufficient against manufacturer. United States, &c. Salamander Felting Co. *v.* Asbestos Felting Co., 10 *Pat. Off. Gaz.* 828.

For decisions holding simply that adjudications or public acquiescence in a patent, or both combined, will warrant a preliminary injunction, see Van Hook *v.* Pendleton, 1 *Blatchf.* 187 ; Robertson *v.* Hill, 4 *Pat. Off. Gaz.* 132 ; 6 *Fish. Pat. Cas.* 465 ; Odorless Excavating Co. *v.* Lauman, 12 *Fed. Rep'r*, 788 ; 4 *Woods*, 129 ; Kirby Bung Manuf. Co. *v.* White, 5 *Bann. & A. Pat. Cas.* 263 ; 1 *Fed. Rep'r*, 604 ; 1 *McCrary*, 155 ; 17 *Pat. Off. Gaz.* 974.

Previous adjudications in favor of a patent entitle complainants to the relief of a preliminary injunction against what seems to be a clear infringement. Thayer *v.* Wales, 9 *Blatchf.* 170 ; 5 *Fish. Pat. Cas.* 130. S. P., Blaisdell *v.* Dows, 4 *Bann. & A. Pat. Cas.* 499.

Long public acquiescence in the complainant's patent, together with the adjudications in favor of its validity, are *prima facie* sufficient reasons for the grant of a preliminary injunction when the infringement is palpable. American Shoe Tip Co. *v.* National Shoe Toe Protector Co., 11 *Pat. Off. Gaz.* 740 ; 2 *Bann. & A. Pat. Cas.* 551.

A decision upon an interference, although not conclusive in an action between the parties for an infringement of the patent granted in pursuance of such decision, is an adjudication upon the patentability of the invention and the right of the successful party to the patent, to lay a foundation for a preliminary injunction. Alleged anticipation of the invention by others, or prior invention by defendants themselves, unless made clearly to appear, will not avail them to prevent an injunction. Celluloid Manuf. Co. *v.* Chrolithian Collar, &c. Co., 24 *Fed. Rep'r*, 275 ; 32 *Pat. Off. Gaz.* 383.

Aequiescence for a considerable time, by a complainant in the infringement of his patent, is ground for refusing him a preliminary injunction in his suit for such infringement. Mundy *v.* Kendall, 23 *Fed. Rep'r*, 591 ; 32 *Pat. Off. Gaz.* 1237.

The fact that a patent is recent, and has not been judicially declared to be valid, is not, alone, ground for refusing a preliminary injunction in a suit for infringement. 1885, Foster *v.* Crossin, 23 *Fed. Rep'r*, 400.

Where the patent was not disputed, it was *held*, that the fact that the defendant had accepted and operated under a license was proof enough of validity of the patent, to sustain a temporary injunction. Brown *v.* Lapham, 27 *Fed. Rep'r*, 77.

Where in previous litigation a patent has been sustained against all the defenses ordinarily set up in patent cases, the question of its validity is hardly an open one on an application for a preliminary injunction. Cary *v.* Domestic Spring Bed Co., 27 *Fed. Rep'r*, 299.

260. *Or by Long Public Acquiescence.*

Where acquiescence alone is relied upon as a basis for the motion for a preliminary injunction, the infringement must be palpable; if the defendants are using a machine openly made, sold and used under patents, and manufactured in good faith in open competition, there is reason why the court should hesitate to interfere before final decree. Burleigh Rock-Drill Co. *v.* Lobdell, 1 *Holmes*, 450; 7 *Pat. Off. Gaz.* 836; 1 *Bann. & A. Pat. Cas.* 625.

An inventor may make and sell his invention for two years before his patent, and the public may acquiesce in his claim during such period; and such acquiescence may be entitled to weight, in considering his right to a temporary injunction; and where sufficient possession is thus established, a doubt concerning the validity of the patent will not necessarily prevent an injunction. Sargent *v.* Seagrave, 2 *Curt.* 553.

To show lapse of time without objection raised, does not prove public acquiescence; there must be circumstances indicating that no doubt existed of the patent. Guidet *v.* Palmer, 10 *Blatchf.* 217; 6 *Fish. Pat. Cas.* 82.

Where complainant has for a number of years been in the extensive and undisputed use of patents, and during all that period there has been a public acquiescence in the monopoly, a provisional injunction to restrain infringement will be granted, unless some special facts appear to take it out of the general rule. McKay *v.* Dibert, 5 *Fed. Rep'r*, 587; 19 *Pat. Off. Gaz.* 1351; 11 *Rep'r*, 380.

So *held*, as to acquiescence in the claim to the invention during the two years preceding the application. Sargent *v.* Seagrave, 2 *Curt.* 553.

Where an invention is new and useful, want of public acquiescence cannot avail parties infringing the patent therefor, to defeat a preliminary injunction. Hussey Manuf. Co. *v.* Deering, 20 *Fed. Rep'r*, 795.

A reissue patent, containing claims not in the original, is to be treated as a new patent so far as its standing as to acquiescence and acceptance by the public is concerned. Irwin *v.* McRoberts, 16 *Pat. Off. Gaz.* 854.

261. *Equitable Reasons for Granting a Preliminary Injunction on the Merits.*

A preliminary injunction is grantable where, upon appearance of defendant to notice, he contests plaintiff's title without successfully rebutting the allegation of infringement. Blackwell *v.* Armistead, 5 *Am. L. T. U. S. Cts.* 85.

Under an agreement to manufacture and sell a patented article, equity will enjoin the breach of negative covenants and decree a specific performance of the agreement between the parties. Hapgood *v.* Rosenstock, 23 *Fed. Rep'r*, 86.

Under a contract giving the exclusive right of sale of a patented article, an injunction against sales by the grantor will be allowed, until the contract is set aside, although he claims that the contract was obtained by fraud. Goddard *v.* Wilde, 17 *Fed. Rep'r*, 845; 16 *Rep'r*, 617.

Although equity might have decreed a surrender and cancellation of the contract giving plaintiff the exclusive right in the patent, yet until this has been done he must be deemed to continue in the enjoyment of the right, and to be entitled to an injunction against infringement. Gibson *v.* Barnard, 1 *Blatchf.* 388.

A person who has a license to use a patented machine, upon certain conditions, may be enjoined from using it except upon those conditions, but a failure to perform such conditions is not necessarily a forfeiture of his license, such as entitles the plaintiff to an absolute injunction against all use of the machine. Brooks *v.* Stolley, 3 *McLean*, 523; 2 *West. L. J.* 396; Wilson *v.* Sherman, 1 *Blatchf.* 536.

But where it appeared that the licensee had violated the restriction under a misapprehension of his rights, and had discontinued the violation, the injunction was refused. Wilson *v.* Sherman, 1 *Blatchf.* 536.

One who, for a good consideration, has covenanted not to further infringe a patent, may be enjoined from further infringing, unless he shows some equitable reason why the agreement should not be enforced. Sargent *v.* Larned, 2 *Curt.* 340.

A party to a mutual and reciprocal covenant respecting a patent, who has broken it, cannot obtain the aid of a court of equity to restrain the other covenantor from its violation. Otherwise, where the covenants are independent, or only collaterally connected; or where the breach is of such a nature that it may be fully repaired. Clum *v.* Brewer, 21 *L. Rep'r*, 390.

262. *Preliminary Injunctions Granted Under Special Circumstances.*

A corporation, owner of certain patents, granted an exclusive license to the complainant to sell machines, and agreed to furnish the machines at a certain price; but, afterward, refused to deliver them; assigning the patent to one having knowledge of the contract, in trust for another association; and took measures for its own dissolution. At the suit of the licensee, a preliminary injunction was granted restraining the corporation from dissolving its organization, and the assignee in trust of the patents from transferring them. Singer Sewing Machine Co. *v.* Union Button-hole, &c. Co., 1 *Holmes*, 253; 4 *Pat. Off. Gaz.* 553.

After the lapse of much time, the affidavit of a single witness that the patentee was not the first inventor was *held* not enough to outweigh the oath of the patentee and the general presumption arising from the grant of the letters-patent; and that an injunction should be granted. Woodworth *v.* Sherman, 3 *Story*, 171; 7 *L. Rep'r*, 279.

The complainant having been long in the enjoyment of his patent, a preliminary injunction was ordered, restraining the defendants from infringing, notwithstanding affidavits were filed, showing that articles embodying the alleged invention had been in use before the complainant made it, there being evidence to the contrary, and none of the alleged anticipating articles being produced.

Chase *v.* Wesson, 4 *Pat. Off. Gaz.* 476 ; 1 *Holmes*, 274 ; 6 *Fish. Pat. Cas.* 517.

Where a party held a license under a patent, in which the patentee reserved the power, upon default of payment of the agreed price for the privilege, to claim and take back the right ; and an action was brought to recover the arrears, the patentee was *held* entitled to an injunction to restrain the licensee from further use of privilege ; the action for the arrears, and judgment therein, being adjudged no waiver of the forfeiture. Armstrong *v.* Hanlenbeck, 3 *N. Y. Leg. Obs.* 431.

The right to a patent having been established in a suit at law, a preliminary injunction against a like apparatus was granted, although the defendant claimed that the apparatus used by him was patented and had been adopted by him in good faith. Sickles *v.* Tileston, 4 *Blatchf.* 109.

Preliminary injunction in a suit for infringement of a patent was granted, where it appeared that a refusal would work great and perhaps irreparable injury to complainant's business, and defendant, being a merchant and not a manufacturer, would not be materially injured by being required to discontinue his sales until the questions at issue should be finally determined. Covert *v.* Curtis, 25 *Fed. Rep'r*, 43.

In the case of a license to use a patented machine in consideration of the licensee's promissory notes, with a stipulation in writing that if any one of the notes should become due and be unpaid, the license should be void, and should revert, a provisional injunction against further use was granted, unless the licensee should in sixty days pay the amount of the due and unpaid note. Woodworth *v.* Weed, 1 *Blatchf.* 165.

Notwithstanding the use of the infringed combination was stopped upon suit brought, an injunction and account were decreed, where the defendants had made no disclaimer of the right to use, and it did not appear that the previous use, though disadvantageous to themselves, was without damage to complainants ; and where other evidence as to profits might be given on an accounting Bullock Printing Press Co. *v.* Jones, 13 *Pat. Off. Gaz.* 124 ; 3 *Bann. & A. Pat. Cas.* 195.

The fact that defendant has, by government grants, the exclusive right to operate a submarine telegraph, so that patentee of an invention which defendant is using could not make use of his invention over the line, does not exempt defendant from injunction

to restrain his use of the invention. Colgate *v.* International Ocean Tel. Co., 17 *Blatchf.* 308; 9 *Rep'r*, 166; 4 *Bann. & A. Pat. Cas.* 609.

A decree for an injunction and account granted upon the circumstances in the particular case, against several defendants who owned, rented or occupied premises in which were placed driven wells which were used by them, and against a defendant who purchased and rented out, but never personally occupied premises containing a driven well. Green *v.* Gardner, 22 *Pat. Off. Gaz.* 683; 5 *N. J. L. J.* 174.

The main and principal feature of the art of canning foods of various kinds, being old and well known, a patent for any particular article of canned goods "as a new article of commerce," must be clearly sustained, by proof in order to sustain an injunction against other manufacturers of similar goods. Wilson Packing Co. *v.* Clapp, 8 *Biss.* 154; 3 *Bann. & A. Pat. Cas.* 243.

263. *Equitable Reasons for Refusing a Preliminary Injunction, on the Merits.*

A circuit court will not enjoin a patentee from manufacturing under his patent, upon allegations that he surreptitiously procured a patent right for an improvement, for which complainant made application for a patent. Until the complainant succeeds in obtaining a patent, he is not in a position to contest the validity of the defendant's patent, by a suit against him for an infringement. Hoeltge *v.* Hoeller, 2 *Bond*, 386.

An injunction ought not to issue to restrain infringement when it does not appear from the record that the defendant has ever made or sold any of the goods in the district. Wilson Packing Co. *v.* Clapp, 8 *Biss.* 154; 3 *Bann. & A. Pat. Cas.* 243. Compare Goodyear *v.* Chaffee, 3 *Blatchf.* 268.

A probability that irreparable injury may be done by granting a preliminary injunction may be reason for refusing it. North *v.* Kershaw, 4 *Blatchf.* 70. But see Sickles *v.* Tileston, 4 *Blatchf.* 109.

Where the defendant is manufacturing under letters-patent, the presumption is that he is not infringing, and unless the court can see, from an inspection alone of the patent, that his article is an infringement, the court will not issue an injunction until after a

full hearing. Sargent Manuf. Co. *v.* Woodruff, 5 *Biss.* 444; 1 *Fish. Pat. Cas.* 277.

A preliminary injunction will not be granted where defendants have manufactured under the sanction of a patent of prior date, which patent of prior date has expired, and no proceedings have, at any time, been instituted by complainants to secure or protect their rights under their patents. Whitney *v.* Rollstone Machine Works, 8 *Pat. Off. Gaz.* 908. See also Sargent *v.* Carter, 21 *L. Rep'r*, 651.

A preliminary injunction will be refused where grave doubt exists, on the evidence, whether there has been any infringement, and there is some doubt as to the validity of the patent. Cross *v.* Livermore, 9 *Fed. Rep'r*, 607.

The existence of a substantial doubt whether a reissued patent is for the same invention as the original, and as to the true construction to be given to the reissued patent, is a proper ground for denying a motion for a provisional injunction to restrain the infringement of the reissued patent. Poppenhusen *v.* Falke, 4 *Blatchf.* 493; 2 *Fish. Pat. Cas.* 181.

Where a reissue is in terms broader than the original, preliminary injunction denied, there being a doubt as to whether the patentee had applied for a reissue within a proper time. Brewster & Co. *v.* Parry, 14 *Fed. Rep'r*, 694.

Where there was no danger of loss to the plaintiff, the defendant being shown to be fully responsible for profits and damages, and great loss will result to the defendant, and where the latter does not make or vend the patented article, it was *held*, that a preliminary injunction should be denied, the title of plaintiff not being fully established. Morris *v.* Lowell Manuf. Co., 3 *Fish. Pat. Cas.* 67; 3 *Wall. Jr.* 310; Potter *v.* Whitney, *Id.* 77.

A preliminary injunction will not be granted where the plaintiff has acquiesced in the infringement, and unreasonably delayed suit against infringers. Green *v.* French, 16 *Pat. Off. Gaz.* 215; Morris *v.* Lowell Manuf. Co., 3 *Fish. Pat. Cas.* 67; 3 *Wall. Jr.* 310.

Two years' use by defendant of complainant's patent with the latter's knowledge, who took no steps to stop it, was *held* sufficient to defeat a motion for a preliminary injunction. Spring *v.* Domestic Sewing Machine Co., 16 *Pat. Off. Gaz.* 721.

264. *Refusal of Preliminary Injunctions, under Special Circumstances.*

The patent having been reissued just after the bringing of the suit; and no exclusive possession of the invention for any considerable time, accompanied by acquiescence by the public, or any verdict, judgment, decree, or judicial order, recognizing the validity of the claim, being shown, nor irreparable injury to the complainant averred, a provisional injunction was refused. Earth Closet Co. *v.* Fenner, 5 *Fish. Pat. Cas.* 15.

Where, on a motion for a provisional injunction, the novelty of the invention was denied, and it was admitted that the plaintiff had sold, before his application for a patent, large quantities of the article in packages marked as "imported from Paris," the injunction was denied until the plaintiff should establish his right by a suit at law. Booth *v.* Garelly, 1 *Blatchf.* 247; 6 *N. Y. Leg. Obs.* 99.

The infringing articles were made and sold in Rhode Island, and the defendant resided there and carried on there the business of making and selling them. It was *held*, that a motion in New York must be denied on the grounds that defendant was beyond the process of injunction, and issuing it would be inoperative and useless; and that the proper place to apply was in Rhode Island. Goodyear *v.* Chaffee, 3 *Blatchf.* 268.

The plaintiff moved for an injunction to restrain the infringement of a patent. It was shown by the defendant that he had used the patented apparatus for nearly three years before any claim was made by the plaintiff. The court refused an injunction until the alleged acquiescence should be explained. Sykes *v.* Manhattan Elevator, &c. Co., 6 *Blatchf.* 496.

Where the alleged infringement consisted in using a stone crusher in repairing roads in a public cemetery, the court denied a preliminary injunction; because the use was for public convenience; and also, defendants had tendered a compensation to abide event of the suit. Blake *v.* Greenwood Cemetery, 14 *Blatchf.* 342; 13 *Pat. Off. Gaz.* 1046; 3 *Bann. & A. Pat. Cas.* 112.

A decree, in a suit founded on a patent, rendered in favor of plaintiff because the defendants abandoned the defense and allowed the decree to be entered without objection and without a hearing, is not sufficient ground upon which to grant a preliminary injune-

tion in a subsequent suit in another district and against other parties, founded on the same patent. Hayes *v.* Leton, 5 *Fed. Rep'r*, 521.

The patent was for an improvement on the horizontal wheel for gaining power to propel boats, but the specifications did not state the nature of the original invention upon which it was an improvement, nor whether it had been patented, nor give any information respecting it. An injunction was refused, on the ground that the nature of the improvement was unintelligible. Isaacs *v.* Cooper, 4 *Wash.* 259.

Special injunction to stop one hundred mills on an alleged infringement of the patent for the Parker water-wheel, was refused; where defendants had had many years' unchallenged possession of the machines, which they purchased from patentees with *prima facie* evidence of title. An injunction is not employed to create, but to prevent mischief. Parker *v.* Sears, 4 *Pa. Law J. Rep.* 443; 1 *Fish. Pat. Cas.* 93.

The plaintiff's patent was for the combination of a flat, horizontal iron plate, in connection with a chamber or recess below the plate. The defendant put horizontal plates into fire-places already provided with recesses which he had no agency in constructing. It was *held*, that the question of infringement was so far doubtful as to forbid the granting of an injunction. Dodge *v.* Card, 1 *Bond*, 393; 2 *Fish. Pat. Cas* 116.

Plaintiff's patent had been upheld in another court, and the first claim declared to have been infringed; but there was no evidence in the present suit to show that defendant's contrivance was the same as the infringing articles in the former suit. Defendant denied infringement, and set up another patent. The moving papers contained no evidence of infringement. Preliminary injunction was denied, but defendant ordered to keep an account. Blake *v.* Boisselier, 5 *Bann. & A. Pat. Cas.* 352.

In a suit brought by a patentee, alleging an infringement and claiming only a royalty or license for the use of the patented device, a motion for a provisional injunction *simpliciter* will not be granted of course, even where the patent alleged to have been infringed has been held valid in other cases; the defendant will be held only to give bond to the plaintiff, to secure him to the full extent of his demand, with costs, &c. McMillan *v.* Conrad, 16 *Fed. Rep'r*, 123; 5 *McCrary*, 140.

A license to use a machine, the patent for which was assigned

by the licensee who invented it, to the licensor, was *held*, independent of a license previously granted by the same licensor to the same licensee, to use a process in which the machine subsequently patented was employed, so that failure to pay royalties under the earlier license did not entitle the licensor to an injunction restraining the use of such machine by the licensee. Washburn, &c. Manuf. Co. *v.* Wilson, 19 *Fed. Rep'r*, 233.

Motion for a preliminary injunction was denied in a case where complainants had known of the manufacture by the defendants of the alleged infringing machines for several years, and had neither warned nor proceeded against them, and some doubt existed as to the infringement. Ballou Shoe Machine Co. *v.* Dizer, 5 *Bann. & A. Pat. Cas.* 540.

Preliminary injunction denied, where the infringing machine was not identical with the one declared in a prior suit to be an infringement; defendant having been granted a patent since then on the present machine; and the patent of complainant never having been upheld on final hearing. Onderdonk *v.* Fanning, 5 *Bann. & A. Pat. Cas.* 562; 2 *Fed. Rep'r*, 568; 9 *Rep'r*, 737.

Preliminary injunction denied, because stopping the use of the invention would greatly embarrass defendant's entire business (the publication of newspapers) and was not necessary to secure justice for plaintiff. Hoe *v.* Boston Daily Advertiser Corp., 14 *Fed. Rep'r*, 914; 23 *Pat. Off. Gaz.* 1124. S. P., Swift *v.* Jenks, 19 *Fed. Rep'r*, 641.

Preliminary injunction refused, on account of delay in suing, coupled with other circumstances indicating that patentee had no important right. Tillinghast *v.* Hicks, 23 *Pat. Off. Gaz.* 739; 13 *Fed. Rep'r*, 388; 14 *Rep'r*, 578.

Equities in favor of an infringer of a patent which may prevent an injunction, see New York Grape Sugar Co. *v.* Buffalo Grape Sugar Co., 18 *Fed. Rep'r*, 638; 25 *Pat. Off' Gaz.* 1076.

Preliminary injunction against alleged infringement denied, where plaintiff had failed to press a pending suit at law for the same infringement against the same defendant, and the latter was pecuniarily responsible. United Nickel Co. *v.* New Home Sewing Machine Co., 17 *Fed. Rep'r*, 528.

Effect of words "to be held to the full end of the term for which said letters patent are or may be granted," when used in the habendum of a deed, reconsidered. Where the assignor from whom complainant derived title had never done anything with the patent

in the State where the suit is pending during its extended term, and defendants bought their machines in ignorance of his rights, and the existence of the machines now set up as prior to the patent was the subject of different issues from those in the former suit on the patent, in which its validity was sustained, it was *held*, that the court would not, upon preliminary motion, enjoin the defendants from using the machines; but that the court would have acted differently if it had appeared that the defendants were not responsible; also, that if the court were sitting in any other state, it would grant an injunction against uses of the machine there, as the assignor's neglect would not affect complainant's rights in a state where complainant's title was not derived through him. Gear *v.* Holmes, 6 *Fish. Pat. Cas.* 595.

A preliminary injunction in a suit by licensor against licensee under a patent, was refused on the ground of fraud by complainant in concealing an arrangement with another licensee for the manufacture of the patented article at royalties less than the rates agreed upon between the parties; it appearing also that complainant had lost control of the market, and left it to be supplied by infringers who paid no royalties. Washburn & Moen Manuf. Co. *v.* Cincinnati Barbed Wire Fence Co., 22 *Fed. Rep'r*, 712. And see Washburn & Moen Manuf. Co. *v.* H. B. Scutt & Co., *Id.* 710.

A preliminary injunction in a suit for infringement of a patent was refused, there being some doubt as to the novelty of the invention; upon defendants giving security for profits and damages for infringement, if the patent should be sustained. New York Belting, &c. Co. *v.* Magowan, 23 *Fed. Rep.* 597.

Preliminary injunction in suit for infringement of a reissued patent was refused, the validity of the reissued patent, in respect of the alleged infringement, being doubtful, and the defect appearing to be, under the circumstances, incurable. Arnheim *v.* Finster, 24 *Fed. Rep'r*, 276; 32 *Pat. Off. Gaz.* 256.

Where the claims of a reissued patent appear to have been made so comprehensive and elastic as to embrace all subsequent inventions which might be made within the same field of improvement, which is more than belongs to the patentee a preliminary injunction will not be granted in suit for infringement, even of a claim held valid against a defendant who has acted on the assumption that such reissued patent could not be sustained. Western Union Tel. Co. *v.* Baltimore, &c. Tel. Co., 25 *Fed. Rep'r*, 30.

Preliminary injunction in suit for infringement of various pat-

ents for dies for forging ox-shoes, and for the process of forging by the use of the dies, was refused until final hearing of doubtful questions of validity of reissues, and of novelty and patentability of devices described. Gunn *v.* Savage, 25 *Fed. Rep'r*, 101.

In a suit for infringement of a patent for the use of chloride of lime as a sizing ingredient in the manufacture of pulp-size paper, it appeared that chloride of lime had long previous to the patent been used in the manufacture for bleaching, and was usually washed out, at least in part, before the sizing materials were applied; but that the defendant had, long before the date of the patent, in manufacturing such paper, allowed the chloride of lime, introduced for bleaching, to remain, which was the method of manufacturing complained of as an infringement. It was *held*, that equity would not interfere to restrain a continuance of the defendant's business or manufacture as pursued anterior to the patent. Dorlan *v.* Guie, 25 *Fed. Rep'r*, 816; 34 *Pat. Off. Gaz.* 702.

Preliminary injunction was refused in a suit for infringement, notwithstanding a decision of the supreme court of the United States sustaining the complainant's patent as valid, where there was doubt as to whether the device alleged to infringe was covered by the patent. Consolidated Safety Valve Co. *v.* Ashton Valve Co., 26 *Fed. Rep'r*, 319.

Preliminary injunction in a suit for infringement of a patent was refused, the averments in the affidavits in support of the motion being insufficient, and the opposing affidavits making the case a doubtful one. International Tooth Crown Co. *v.* Mills, 30 *Pat. Off. Gaz.* 662.

Preliminary injunction in suit for infringement of a patent was refused, where there was doubt as to the title of the complainant, who claimed as an assignee of the patent. Continental Store Service Co. *v.* New York Store Service Co., 31 *Pat. Off. Gaz.* 1561.

265. *Granting or Refusing Injunction, upon Terms as to Security, &c.*

An application for a provisional injunction may be granted or refused unconditionally, or terms may be imposed on either of the parties, as conditions for making or refusing the order. The state of the litigation (where the plaintiff's title is denied), the nature of the improvement, the character and extent of the infringement

complained of, and the comparative inconvenience which will be occasioned to the respective parties, by allowing or disallowing the motion, must all be considered in determining whether the injunction should be allowed or refused; and if allowed, whether absolutely or upon some and what conditions. Forbush *v.* Bradford, 21 *L. Rep'r*, 471; 1 *Fish. Pat. Cas.* 317.

Where the defendants were using but not making, certain looms having a patented improvement, and an injunction would stop their whole business, it was *held*, that they might be allowed to give security to keep and render an account. *Ib.*

If an injunction will lead to serious injury in suspending the works of the defendant, the court may require security of the complainant, to indemnify the defendant for such loss, if the patent is held void. Or it can make an order to expedite a final hearing and decision. Orr *v.* Littlefield, 1 *Woodb. & M.* 13; 8 *L. Rep'r*, 314.

An injunction should not be granted where the plaintiff is made secure of receiving all the profits which may arise from the use of the machine until the final hearing. Foster *v.* Moore, 1 *Curt.* 279.

When the infringement is clear and the patent valid, an injunction will not be refused because the defendant offers to give bond with surety to pay any damages awarded against him. McWilliams Manuf. Co. *v.* Blundell, 11 *Fed. Rep'r*, 419; 22 *Pat. Off. Gaz.* 177. S. P., Gibson *v.* Van Dresar, 1 *Blatchf.* 532; Tracy *v.* Torrey, 2 *Blatchf.* 275.

Where an injunction had been granted against a person for an infringement of a patent, and while such proceedings were being taken, a third party, with full knowledge of all the circumstances connected with such injunction, became the assignee of all the rights and interests of the persons first enjoined, it was *held*, that such assignee stood in the light of the other's substitute, and that he could not be allowed, by giving security and giving an account, to continue the business till final hearing, but an injunction should issue against him. Parkhurst *v.* Kinsman, 2 *Blatchf.* 78.

Injunction to restrain infringement was refused, against a *bona fide* purchaser, upon the defendant's giving bond to account, although the plaintiff's patent had been established in two trials at law in suits between other parties. United States Annunciator, &c. Manuf. Co. *v.* Sanderson, 3 *Blatchf.* 184.

Although the defendant's machine may infringe, yet if it contain other valuable improvements not covered by plaintiff's patent,

an order for account and security may be substituted for an injunction. Stainthorp *v.* Humiston, 2 *Fish. Pat. Cas.* 311.

Upon an application for an injunction, the defendants offered to pay the plaintiff a reasonable sum for the use of the invention. It was *held*, that the defendant ought not to be enjoined, unless he preferred to be enjoined rather than pay the plaintiff a reasonable sum for the use of the invention; such sum not to exceed the license fee usually charged in like cases, and to be ascertained by reference to a master. Hodge *v.* Hudson River R. R. Co., 6 *Blatchf.* 162.

Injunction withheld upon the giving of a bond by defendant, when the prior adjudication upon which the right to a preliminary injunction was based is pending on appeal to the supreme. Wells *v.* Gill, 6 *Fish. Pat. Cas.* 89.

On a motion for a preliminary injunction to restrain the infringement of a patent for a dredging machine, the validity of the patent was denied, on the ground of a prior public use. The patent had never been adjudicated upon, and the general allegation of public acquiescence in the bill, and which was the only proof thereof, was denied. The defendant was constructing, for his own use, a single machine. It was *held*, that the injunction ought not to be granted, provided the defendant should give security sufficient to protect the plaintiff against all loss and damages by reason of the construction and use of the machine, and to pay any sum which might be awarded to the plaintiff in the suit. Morris *v.* Shelbourne, 8 *Blatchf.* 266; 4 *Fish. Pat. Cas.* 377.

The plaintiffs in a suit in the circuit court against T. for manufacturing and selling gas machines, obtained a decree requiring T. to account for his gains and profits from such manufacture and sale, and for all damages sustained by the plaintiffs from such infringement by T. No final decree had been entered. The plaintiffs then brought this suit against B. for infringing the patent by the use of a machine purchased by him from T. and applied for a provisional injunction to restrain the further use of the machine. It was *held*, that B. ought to be allowed to give security for the payment of any decree that might be rendered against him, and that, if he would do so, the injunction ought not to be granted. Gilbert, &c. Manuf. Co. *v.* Bussing, 12 *Blatchf.* 426; 1 *Bann. & A. Pat. Cas.* 621; 8 *Pat. Off. Gaz.* 144.

Where a preliminary injunction against the use of a device claimed to be patented would work great injury to one party with-

out corresponding benefit to the other, it should not issue ; but that a bond to keep and file a verified account and to pay the amount of any decree for damages should be given. Swift *v.* Jenks, 19 *Fed. Rep'r*, 641. S. P., Hoe *v.* Boston Daily Advertiser Corp., 14 *Fed. Rep'r*, 914 ; 23 *Pat. Off. Gaz.* 1134.

Where a party has only some vague and indistinct right, and an order may work an injury to defendant's business, a preliminary injunction will not be granted *simpliciter*, without a bond or security. Blake *v.* Boisselier, 16 *Pat. Off. Gaz.* 854.

Where the judges differed as to the question of infringement, and the jury had failed to agree, the court directed that an injunction already granted should be dissolved, upon the defendant giving proper security to keep an account ; or, if he should fail so to do, then, that it should remain, upon the plaintiff giving proper security. Wilson *v.* Barnum, 1 *Wall. Jr.* 347 ; 2 *Fish. Pat. Cas.* 635 ; 6 *West. L. J.* 464.

If the owner of a patent has never made, used, or sold to others to be used, the invention covered by his patent, an injunction will be denied, in the interlocutory decree, against its use by an infringer, on his giving bond to secure any damages which may be awarded on final hearing. Hoe *v.* Knap, 27 *Fed. Rep'r*, 204.

The fact that defendants are well able to pay ultimate damages is not a sufficient ground for the refusal of a preliminary injunction. American Middlings Purifier Co. *v.* Christian, 3 *Bann. & A. Pat. Cas.* 42.

The validity of the patents having been passed upon in one case, and restraining orders granted upon an *ex parte* application against other defendants, it was *held*, upon application for a preliminary injunction based upon the same proof as to infringement, that a preliminary injunction should be denied, there being a doubt as to infringement, upon condition that a bond be given for any damages that might be awarded, and an account of sales kept. Steam Guage Co. *v.* St. Louis Ry. Supply Co., 25 *Fed. Rep'r*, 494 ; 33 *Pat. Off. Gaz.* 889.

266. *Dissolution or Suspension of Preliminary Injunctions.*

An injunction is not necessarily to be dissolved because the right of the patentee is made to appear doubtful. Orr *v.* Badger, 7 *L. Rep'r*, 465 ; 1 *Brummer Col. Cas.* 537.

An injunction issued on an injunction bill which alleges long possession and sales under the patent, and that the validity of the patent has been supported by several trials, will not be dissolved on an answer of mere general denials of the originality of the patent, and the defendant's use of the invention, unless the denial is justified by the facts, or the claim of defendant is strengthened by some evidence. Orr *v.* Merrill, 1 *Woodb. & M.* 376.

An injunction once granted should not be dissolved for mere doubts; particularly when they relate to form, and the time for a trial on the merits is near. Woodworth *v.* Hall, 1 *Woodb. & M.* 389.

The suspension of an interlocutory decree perpetually enjoining the infringement, until the final decision, upon defendants giving a bond, rests in the sound discretion of the court. Brown *v.* Deere, 6 *Fed. Rep'r*, 487; 19 *Pat. Off. Gaz.* 1217.

If the defendants contest the validity of the plaintiff's invention, the injunction will be granted to continue only until the validity of the patent can be determined by a trial at law; and will be dissolved if such suit is not brought before the next term of the court. Woodworth *v.* Edwards, 3 *Woodb. & M.* 120.

A motion to dissolve an injunction will not be heard on the same evidence on which it was granted, nor upon new evidence which defendant, without good excuse neglected to offer before; though upon new and material evidence it may be. Woodworth *v.* Rogers, 3 *Woodb. & M.* 135. S. P., Union Paper Bag Co. *v.* Newell, 11 *Blatch.* 549; 5 *Pat. Off. Gaz.* 459; 1 *Bann. & A. Pat. Cas.* 113.

Where an answer is filed to a bill, denying the validity of the patent, and evidence supporting the answer, *prima facie*, is offered, the injunction will be dissolved, unless the other side file counter-evidence sustaining the validity of the patent. *Ib.* A common injunction is usually dissolved, as a matter of course, on the coming in of an answer denying merits, or a legal title in the plaintiffs, and without any inquiry into the truth of the allegations; otherwise, of a special injunction. *Ib.*

Unless the proof offered on motion to dissolve an injunction granted on a bill, overcomes the equity of the bill and the evidence supporting it, the motion will be denied. Sparkman *v.* Higgins, 1 *Blatch.* 205; 5 *N. Y. Leg. Obs.* 122; 6 *Pa. L. J.* 344.

Affidavits filed in support of a motion to dissolve an injunction against infringement, showed that the infringing articles made by

defendant were made under license from the patentee; it was *held*, that the injunction must be dissolved. Goodyear *v.* Bourn, 3 *Blatchf.* 266.

Defendant will not be allowed to present, on a motion to dissolve an injunction, facts which he might have presented, but did not, in opposing a motion for a preliminary injunction, and in opposing afterward a motion to punish him for a contempt in violating such injunction. National School Furniture Co. *v.* Paton, 16 *Blatchf.* 563; 4 *Bann. & A. Pat. Cas.* 432.

The mere failure to join a proper party will not be sufficient ground for dissolving an injunction, where the defendant is using the infringing machine for purposes in respect to which the plaintiff has an exclusive right under his patent. Bassett *v.* Malone, 11 *Fed. Rep'r*, 801.

The fact that the complainant, after obtaining an injunction, parted with all his interest in the patent, was *held* not sufficient ground for dissolving the injunction. Thompson *v.* Barry, 2 *Week. N. of Cas.* 100.

After a final decree establishing an exclusive right to the use of a patent and awarding an injunction to protect it, the injunction will not be suspended while the decree stands unreversed, unless some extraordinary cause outside of the interests of the parties is shown. Public necessity may be a cause for such suspension. Munson *v.* New York, 19 *Fed. Rep'r*, 313; 22 *Blatchf.* 45.

Where the bill or affidavits of the complainant did not state with certainty the infringement of the defendant, and the complainant did not swear at the time of the filing of the bill that he believed he was the original and true inventor of the thing patented to him, and the defendant denied on oath the originality, novelty and utility of the invention, the preliminary injunction was dissolved. Wilson *v.* Curtius, 2 *West. L. J.* 511. But in such case the injunction may be revived on further affidavits setting forth the particulars of the infringement complained of, and alleging priority of invention in the patentee. *Ib.*

The suspension of an interlocutory decree, perpetually enjoining the infringement of a patent, until an accounting can be had and a decree entered from which an appeal can be taken, rests in the discretion of the court which granted the decree. Brown *v.* Deere, 6 *Fed. Rep'r*, 487; 2 *McCrary*, 425; 19 *Pat. Off. Gaz.* 1217.

In a suit for infringement of a patent for a machine the complainant obtained a decree for the profits of the manufacture and

sale by the defendant of machines embodying the patented invention, upon which some money was recovered, and real estate was set off, on execution, in satisfaction of the balance. It was *held*, that this was, *prima facie*, a satisfaction of the decree; and that in a subsequent suit by the same complainant for infringement of his patent by the use of machines purchased from the defendant in the former suit, and for the manufacture and sale, for use of which the complainant had recovered therein, a preliminary injunction should not be continued. Steam Stone Cutter Co. *v.* Sheldon, 21 *Blatchf.* 260.

Injunction restraining employes of inventor of undisclosed process of manufacture from divulging the secret, continued until final hearing. Salomon *v.* Hertz, 2 *Cent. Rep'r*, 18[illegible]

267. *Operation and Effect of Injunctions in Patent Cases.*

Purchasers from an infringer who has been enjoined by a circuit court, cannot be permitted to use the machine purchased in another circuit while the injunction remains in full force. Woodworth *v.* Edwards, 3 *Woodb. & M.* 120.

An injunction in a patent case does not extend beyond the right of the plaintiff, as set up in his bill. Byam *v.* Eddy, 2 *Blatchf.* 521; 24 *Vt.* 666; Wire Railing Co. *v.* Walker, 2 *Fish. Pat. Cas.* 179.

To sell parts of a patented device necessary to its operation but not covered by the patent, does not constitute a new infringement, when they have already been charged in the accountings for the sale of the patented portion. Buerk *v.* Imhauser, 11 *Pat. Off. Gaz.* 112.

The words "perpetual injunction," in a decree, mean only for the life-time of the patent; and that must be determined by the statute and the facts of the case, and not merely by the terms of the patent. De Florez *v.* Raynolds, 8 *Fed. Rep'r*, 434; 17 *Blatchf.* 430; 17 *Pat. Off. Gaz.* 503; 5 *Bann. & A. Pat. Cas.* 140.

The sending of circulars by complainants to parties engaged in the trade, notifying them of a preliminary injunction, is improper. Wilson Packing Co. *v.* Clapp, 8 *Biss.* 154; 13 *Pat. Off Gaz.* 368.

A decree for a perpetual injunction is not final where it also

directs a reference to ascertain the damages by reason of the infringement. Barnard *v.* Gibson, 7 *How.* 650.

268. *Violation of Injunctions, in Patent Cases.*

Where a person had been enjoined not to use a machine substantially like the one mentioned in the complainant's bill, it was *held*, that he was chargeable with a contempt, by the purchase and use of a machine which had been enjoined in another circuit as being substantially like the plaintiff's. Woodworth *v.* Rogers, 3 *Woodb. & M.* 135.

To supply an infringing device after service of an injunction is a violation, although done pursuant to a contract made before. Colgate *v.* Gold, &c. Tel. Co., 17 *Pat. Off. Gaz.* 193; 4 *Bann. & A. Pat. Cas.* 559; Colgate *v.* Western Union Tel. Co., 17 *Pat. Off. Gaz.* 195; 4 *Bann. & A. Pat. Cas.* 562.

An injunction founded upon consent, enjoining the use of a patented invention, is not necessarily deprived of vitality by the granting of a conditional license. But an attachment will not be issued for the violation of such injunction while the license itself is in litigation. Pentlarge *v.* Beeston, 1 *Fed. Rep'r*, 862; 18 *Blatchf.* 38; 9 *Rep'r*, 774; 5 *Bann. & A. Pat. Cas.* 326.

One who has been enjoined from infringing a patent and who continues to sell, is equally guilty of a contempt and liable to attachment, whether he sells in his own right or as agent for another. Potter *v.* Muller, 1 *Bond*, 601; 2 *Fish. Pat. Cas.* 631.

It is no excuse for the violation of a preliminary injunction that the patent is invalid. Phillips *v.* Detroit, 16 *Pat. Off. Gaz.* 627.

Where an injunction has been issued restraining a defendant from using patented parts of a machine, he is not at liberty to use his own judgment as to which parts are infringements, and continue the use of the remainder of the machine. Hamilton *v.* Simons, 5 *Biss.* 77.

The fact that several persons are acting in concert in the use of an infringed article as the stockholders, managers and servants of a corporation does not exempt them from the restraints of an injunction. Poppenhusen *v.* Falke, 4 *Blatchf.* 493; 2 *Fish. Pat. Cas.* 181. So of the fact that the person committing the acts of infringement is minor son of defendant. Dunks *v.* Grey, 3 *Fed. Rep'r*, 862; 10 *Rep'r*, 721; 5 *Bann. & A. Pat. Cas.* 634.

A sale of a patent after suit brought, but before injunction issued, is not a contempt. United States *v.* Day, 6 *Am. L. Reg.* 632.

Injunction may be violated by selling outside the territorial jurisdiction, although the goods were not sent to purchasers within the jurisdiction. Macaulay *v.* White Sewing Machine Co., 9 *Fed. Rep'r*, 698 ; 21 *Pat. Off. Gaz.* 496.

Partial use of a thing may be adjudged a contempt of an injunction forbidding use of it. Matthews *v.* Spangenberg, 23 *Pat. Off. Gaz.* 1624 ; 15 *Rep'r*, 813.

The sale and use by defendant of a machine containing a feature not claimed in plaintiff's combination, if not a mere colorable evasion, will not render the defendant liable for violation of an injunction forbidding sale, &c. of that combination ; and the fact that a patent was issued to defendant, subsequent to granting the injunction, affords ground for him to insist that the alteration was not plainly colorable. Onderdonk *v.* Fanning, 2 *Fed. Rep'r*, 568 ; 9 *Rep'r*, 737.

The continued infringement of a patent after an interlocutory decree in a suit between the same parties for infringement, constitutes a new cause of action, notwithstanding such continued infringement is also a violation of an injunction awarded by the decree in the former suit. Roemer *v.* Neumann, 23 *Fed. Rep'r*, 447.

269. *Proceedings to Punish a Violation.*

A motion to punish violation of an injunction for an infringement as a contempt, requires clear proof that the infringement is continued. Smith *v.* Halkyard, 19 *Fed. Rep'r*, 602.

Upon a motion to punish a violation of an injunction against infringement as a contempt, such questions as whether the patentee was original inventor, whether the article as sold was an infringement, whether the patent was correctly construed in issuing the injunction, whether the patent was valid ; do not arise. They are foreclosed by the order of injunction, which must be obeyed if the court had jurisdiction to make it. Whipple *v.* Hutchinson, 4 *Blatchf.* 190 ; Liddle *v.* Cory, 7 *Id.* 1 ; Burnett *v.* Estey, 16 *Id.* 105 ; 4 *Bann. & A. Pat. Cas.* 141 ; Roemer *v.* Newman, 19 *Fed. Rep'r*, 98.

The motion to commit for contempt properly involves the ques-

tion whether what defendant has done since the injunction was issued constitutes a contempt; and the plaintiff is entitled to have this question decided on the proofs; the motion should not be denied merely because the court entertains doubt upon it. Wethcrill *v.* New Jersey Zinc Co., 1 *Bann. & A. Pat. Cas.* 105. Whether to determine the question of infringement by inspection or by testimony of experts, is a question of discretion for the court. Burdett *v.* Estey, 16 *Blatchf.* 105; 4 *Bann. & A. Pat. Cas.* 141. The question whether the machine as made by the defendant since the injunction is the same as that enjoined, is one of fact to be determined on the evidence; models first, and testimony of experts next, being the evidence. Birdsell *v.* Hagerstown Agric. Imp. Manuf. Co., 1 *Hughes*, 59.

Should the proofs show that defendant did not intend disobedience to the order of the court, but acted in good faith, upon the advice of counsel, &c. in the exercise of what he supposed were rights reserved to him under the injunction, the court will not inflict punishment, but will limit its order to payment of plaintiff's actual damages or loss of profits, and costs. Ready Roofing Co. *v.* Taylor, 15 *Blatchf.* 94; 3 *Bann. & A. Pat. Cas.* 368; Matthews *v.* Spangenberg, 15 *Fed. Rep'r*, 813; 23 *Pat. Off. Gaz.* 1624; Carstaedt *v.* United States Corset Co., 13 *Blatchf.* 371; 10 *Pat. Off. Gaz.* 3; 3 *Bann. & A. Pat. Cas.* 331.

Circumstances arising since or independent of the injunction, rendering it inequitable for the complainant to enforce it,—such as conduct or negotiations on his part which should operate as a release or an estoppel,—may be shown in answer to a motion to attach for contempt, and will induce the court to deny such motion. Smith *v.* Patton, 3 *Pa. L. J. Rep.* 508; 6 *Pa. L. J.* 189.

Attachment for contempt in violating an injunction restraining infringements of a patent, was refused; no sufficient service of notice of motion for the attachment upon any person responsible for the acts complained of being shown. Bate Refrigerating Co. *v.* Gilett, 24 *Fed. Rep'r*, 696; 32 *Pat. Off. Gaz.* 1466.

270. *Enjoining Prosecution of Suits for Infringement.*

Resort to injunction in patent matters is not confined to infringements; there are instances of suits brought by alleged infringers seeking to restrain the prosecution of suits against them.

These cases have not, however, according to the reports, been very frequent, or often successful, especially as respects grants of preliminary injunctions.

Patentees of an improvement in fire-engines having brought a suit against the city of Dover for using infringing engines, the city filed a bill seeking to enjoin the prosecution of that suit; alleging as grounds thereof that the invention covered by the patent had been anticipated, that the city had bought its engines in good faith from the prior inventor, and that the patentees were debarred by laches and estopped from prosecuting their suit. The patentees having filed an answer denying both the anticipation and the laches, &c., it was *held* that the prosecution of the suit could not be enjoined. City of Concord *v.* Norton, 16 *Fed. Rep'r*, 477.

The United States cannot be heard to ask an injunction restraining the commencement or prosecution of suits for infringement of a patent for the repeal of which they have begun an action. United States *v.* Colgate, 22 *Blatchf.* 412; 21 *Fed. Rep'r*, 318.

The circuit court for the southern district of New York, in an infringement suit pending in that district, refused to make an order enjoining or restraining the defendant in that suit from prosecuting suits he had begun in other districts against the plaintiff. Rumford Chemical Works *v.* Hecker, 11 *Blatchf.* 552; 5 *Pat. Off. Gaz.* 664; 5 *Fish. Pat. Cas.* 629.

An injunction should not be granted upon application of a senior patentee to restrain the order of a junior patent alleged to conflict with it, from bringing suits for infringement of his patent; at least until the junior patent has been adjudged invalid. Asbestos Felting Co. *v.* United States, &c. Salmander Felting Co., 13 *Blatchf.* 453; 10 *Pat. Off. Gaz.* 828; 2 *Bann. & A. Pat. Cas.* 369.

Where a suit is pending against a defendant who is manufacturing and vending an article claimed to be an infringement, and the defendant is responsible for damages and profits, the court in its discretion may enjoin the complainant from bringing other suits against vendees of the defendant, and this although complainant enjoined may not be within the district at the time of the injunction. Birdsell *v.* Manuf. Co., 1 *Hughes*, 64.

The court, upon a proper showing and in a proper case, in order to avoid a multiplicity of suits, may require the prosecution of suits against mere users and purchasers from the principal infringer to be suspended, and await the determination of the suit pending

between the patentee and the principal infringer; but the proof should be conclusive that the patented article involved in the suit against the users was purchased of the defendant in the principal suit, and that it is identical in character with that involved in the suit against the principal infringer. Allis *v.* Stowell, 11 *Fed. Rep'r*, 783.

XIX. PLEADINGS; AT LAW OR IN EQUITY.

271. *Declaration at Law, for Infringement.*

A declaration in an action for damages for infringement is not necessarily bad because it begins in trespass on the case and ends in debt; nor because it claims for successive, distinct infringements of the same patent; nor because it avers the patent to be in language of the *import* (instead of *tenor*), following, setting it out in words and figures. Wilder *v.* McCormick, 2 *Blatchf.* 31.

If the declaration professes to set forth the specification as a part of the grant, "according to its tenor" the slightest variation, —*e. g.*, using the word "wheel" for "whirl,"—is fatal. Tyron *v.* White, *Pet. C. Ct.* 96.

If the declaration designates the patent by the terms used in the patent, the specification need not be set out in the declaration; it is matter of evidence on the trial. The defendant can have it put on the record by asking oyer of it Gray *v.* James, *Pet. C. Ct.* 476. See Pitts *v.* Whitman, 2 *Story*, 609; Cutting *v.* Myers, 4 *Wash.* 220.

A statement of the plaintiff's patent and a general allegation that the defendant has infringed are sufficient to put the defendant upon answer; and proof of an infringement of one of several claims in the patent, without proving an infringement of all, will sustain the suit. Thatcher Heating Co. *v.* Carbon Stove Co., 15 *Pat. Off. Gaz.* 1051; 7 *Rep'r*, 199; 4 *Bann. & A. Pat. Cas.* 68; 2 *N. J. L. J.* 25.

A declaration in a patent suit which shows that the plaintiff has partial interest, only, in the patent is demurrable. Suydam *v.* Day, 2 *Blatchf.* 20. But where the declaration did not aver that the

plaintiff *had* a patent, but that he *claimed* a patent, and that the defendant enjoyed the right, it was *held*, that, although the objection would have been fatal on general demurrer, yet, after verdict, the court would presume that the facts showing the right were proved at the trial; and it therefore would not arrest judgment. Stanley *v.* Whipple, 2 *McLean*, 35.

The declaration for an infringement of a patent need not aver the specific date of the invention; this is immaterial; it must tender an issue upon the novelty and utility of the discovery patented; but it need not aver the regularity of the preliminary proceedings in the issue of the patent. Wilder *v.* McCormick, 2 *Blatchf.* 31.

Where titles to the original patent and an improvement on it are united in the same person, they constitute an entire right, and must be asserted as such in the declaration in an action for infringement; damages cannot be claimed separately for infringements of them. Case *v.* Redfield, 4 *McLean*, 526.

The declaration for infringement of an improvement must set out in what the improvement consists. Peterson *v.* Wooden, 3 *McLean*, 248.

The declaration need not set out in what or by what means the defendant has infringed; averring that the defendant had made, constructed, used and sold the thing patented is enough. Case *v.* Redfield, 4 *McLean*, 526. So is averring that the defendant has made the thing "in imitation of the plaintiff's patent." Parker *v.* Haworth, 4 *McLean*, 370.

The declaration need not state that the stages preliminary to the issuance of the patent were observed, but it must set up the attestation of the President of the United States, and that the patent was delivered. Cutting *v.* Fulton, 4 *Wash.* 220.

Averment that defendant's acts were done "contrary to the statute," is not necessary in an action for infringement, but only in an action brought on a penal statute. Parker *v.* Haworth, 4 *McLean*, 370. S. P., Tryon *v.* White, *Pet. C. Ct.* 96.

The state of the art and steps which have been taken by the patentee or others are a necessary part of the testimony, and proper averments in a bill, and it is also proper to recite the prior litigation over the same patent. Steam Guage & Lantern Co. *v.* McRoberts, 36 *Pat. Off. Gaz.* 822.

272. *Plea, or Answer, at Law.*

When an abandonment is relied on, it should be not only stated in the plea, but the facts on which the pleader relies as showing an abandonment should be stated. Root *v.* Ball, 4 *McLean*, 177.

A plea of prior use or sale should aver that it took place more than two years before the application for the patent; such at least was the rule under the act of 1839, § 7. Root *v.* Ball, 4 *McLean*, 177.

Where, in an action for infringement, no plea or answer is put in, the charge in the declaration is considered as admitted. Parker *v.* Banker, 6 *McLean*, 631.

A special plea that the selling alleged in the declaration, if any such was done, was made by defendant solely as agent and not for his own profit, was *held* bad on special demurrer, because hypothetical, and because it did not state the name of the person for whom the defendant claimed to have acted as agent. Morse *v.* Davis, 5 *Blatchf.* 40.

In order to rely upon a defect of title as a defense under the New York Code, it must be pleaded. Hobbie *v.* Smith, 27 *Fed. Rep'r*, 656.

By taking issue upon a plea its sufficiency is admitted in point of form and substance, and the truth of the facts therein having been established, defendants are entitled to judgment. Birdseye *v.* Heilner, 26 *Fed. Rep'r*, 147.

The proper mode of pleading special matter in defense to an action for infringement of a patent, is considered with reference to the practice under the Oregon Code, in Cottier *v.* Stimson, 9 *Sawyer*, 435; 10 *Sawyer*, 212; 18 *Fed. Rep'r*, 689; 20 *Fed. Rep'r*, 906

273. *Necessity and Uses of Notice Additional to the General Issue.*

The defenses authorized by section 15 of the act of 1836 to be proved under a notice accompanying a plea of the general issue are not required to be set up in that manner. The defendant may, if he prefers, plead specially, setting up the matters of which he

could give notice. The right to plead the general issue and give notice is an enlargement of the defendant's mode of defense; it does not take away the privilege of a special plea. Wilder *v.* Gayler, 1 *Blatchf.* 597; Day *v.* New England Car Spring Co., 3 *Blatchf.* 179; Read *v.* Miller, 3 *Fish. Pat. Cas.* 310; 2 *Biss.* 12; Phillips *v.* Comstock, 4 *McLean*, 525; Root *v.* Davis, *Id.* 370; Cottier *v.* Stimson, 18 *Fed. Rep'r*, 689.

To entitle a defendant to contest on the trial the novelty of plaintiff's invention under the general issue, he must serve a notice in compliance with the statute. If he fails to do so he cannot introduce evidence to controvert the presumption of novelty deducible from the production of a patent on the part of a plaintiff. Blanchard *v.* Putnam, 8 *Wall.* 420; rev'g 2 *Bond*, 84; 3 *Fish. Pat. Cas.* 186. See Judson *v.* Bradford, 16 *Pat. Off. Gaz.* 171; 3 *Bann. & A. Pat. Cas.* 539; La Baw *v.* Hawkins, 6 *Pat. Off. Gaz.* 724; 1 *Bann. & A. Pat. Cas.* 428; Root *v.* Ball, 4 *McLean*, 177; Westlake *v.* Carter, 4 *Pat. Off. Gaz.* 636; 6 *Fish. Pat. Cas.* 519; Pickering *v.* Phillips, 10 *Pat. Off. Gaz.* 420; 4 *Cliff.* 383; 2 *Bann. & A. Pat. Cas.* 417; Bragg *v.* City of Stockton, 27 *Fed. Rep'r*, 509.

Evidence of what is old and was in general use at the time of an alleged invention is admissible in actions at law under the general issue, and in equity cases, without any particular averment in the answer. Brown *v.* Piper, 91 *U. S.* 37.

Persons sued for infringement may, on complying with the statutory condition as to notice, give the special defenses mentioned in the patent act in evidence under the general issue; or in a suit in equity, such notice may be given in the answer; and if any one of those defenses is proved, the judgment or decree must be in favor of the defending party, with costs. But in a case where the invention consists in a combination of old elements incapable of division or separate use, such defenses must be addressed to the entire invention and not merely to separate parts of the thing patented. Bates *v.* Coe, 98 *U. S.* 31. S. P., somewhat more fully. Parks *v.* Booth, 102 *U. S.* 96; aff'g 1 *Flippin*, 381; 1 *Bann. & A. Pat. Cas.* 225.

Evidence on the part of the defendant as to whether the machine used by him is like the model of plaintiff's machine, produced in court, is proper under the general issue; no notice is necessary. Evans *v.* Hettich, 7 *Wheat.* 453, 469; aff'g 3 *Wash.* 408.

Notice is not necessary to warrant the introduction of evidence of the state of the art to which the plaintiff's invention belongs, at the alleged date of his invention. Vance *v.* Campbell, 1 *Black*, 427; rev'g 1 *Fish. Pat. Cas.* 483. S. P., La Baw *v.* Hawkins, 6 *Pat. Off. Gaz.* 724; 1 *Bann. & A. Pat. Cas.* 428; Westlake *v.* Carter, 4 *Pat. Off. Gaz.* 636; 6 *Fish. Pat. Cas.* 519.

Where no question is made by the pleadings as to the novelty and originality of the invention, and the prior use relied on in defense is a use by the inventor or under his license, notice of the persons using the invention, or of the places where it was used, is not required. American Hide, &c. Dressing Machine Co. *v.* American Tool, &c. Co., 1 *Holmes*, 503; 4 *Fish. Pat. Cas.* 284.

The statute does not enumerate all the defenses of which the defendant may avail himself. Others are allowable; such as a denial of infringement; an averment of a license. Whittemore *v.* Cutter, 1 *Gall.* 429, 435.

Evidence, taken under objection that no notice was given of it in the answer, will not be received because the answer is afterward amended so as to include such a notice. Roberts *v.* Blake, 3 *Pat. Off. Gaz.* 268.

The rule is that if the thing patented is an entirety, the statutory defenses must be addressed to the invention itself, not merely to some one or more of its features. This does not prevent each patent in suit, or each invention contained in it, as set forth in the distinct claims, from being made the subject of separate pleas in defense. Kelleher *v.* Darling, 14 *Pat. Off. Gaz.* 673; 4 *Cliff.* 424. S. P., Parks *v.* Booth, 102 *U. S.* 96; aff'g 1 *Flippin*, 381; 1 *Bann. & A. Pat. Cas.* 225.

All the defenses which the statute authorizes may be made as well in respect to patents granted upon renewed applications under Rev. Stat. § 4897, as in respect to those issued upon original applications. United States Rifle, &c. Co. *v.* Whitney Arms Co., 11 *Pat. Off. Gaz.* 373; 14 *Blatchf.* 94; 2 *Bann. & A. Pat. Cas.* 493.

Where the defense to an action for infringement is, that the plaintiff is not the original inventor, defendant is not forbidden to prove former use by certain persons because he specified other persons in his notice. Evans *v.* Kremer, *Pet. C. Ct.* 215; Treadwell *v.* Bladen, 4 *Wash.* 703.

274. *Requisites and Sufficiency of such Notice.*

No order of court is necessary to entitle a defendant to serve and file the notice of special matter; it may be given after the depositions relied on have been filed in court; and if at first defective, or not sufficiently comprehensive, the defendant may give another. All that is required is a notice in writing, served thirty days before trial. Teese *v.* Huntingdon, 23 *How.* 2.

A mere general reference, in a notice of special matter accompanying the general issue, to an entire and large volume, such as "Ure's Dictionary of Arts, Manufactures, and Mines,"—in which an invention has been described, is not sufficient notice. There must be a more particular reference to the parts relied on, either by pages, titles, or otherwise. Nor can such book, under such a notice, be introduced as "evidence of prior knowledge and use, by said Ure," because the notice does not state at what places the thing was used. Silsby *v.* Foote, 14 *How.* 218; aff'g 1 *Blatchf.* 445

A notice under the act of 1836, § 15, in a suit for infringing a patent for mill-stones, which states the names and residences of the witnesses, is sufficiently particular; the particular mill in which the stones were used need not be designated. Wise *v.* Allis, 9 *Wall.* 737.

The true construction of the act, is that the names of those only who invented or used the anticipating machine or improvement, not the names of those who are to testify as to its invention or use, must be pleaded; this is enough to protect a patentee against surprise. Wilton *v.* Railroads, 1 *Wall. Jr.* 192; Planing Machine Co. *v.* Keith, 101 *U. S.* 479; Judson *v.* Bradford, 16 *Pat. Off. Gaz.* 171; 3 *Bann. & A. Pat. Cas.* 539; Many *v.* Jagger, 1 *Blatchf.* 372. Compare Judson *v.* Cope, 1 *Fish. Pat. Cas.* 616; 1 *Bond*, 327.

Notice specifying certain mining establishments where defendant will show the invention to have been in use is sufficient compliance with the requirement as to specifying places and persons. Smith *v.* Frazer, 2 *Pat. Off. Gaz.* 174; 5 *Fish. Pat. Cas.* 543; 3 *Pittsb* 397.

Where an answer relies on a previous use of the invention, and witnesses are examined to sustain the defense without objection by the complainant, he cannot afterward have their testimony struck out for want of the notice of their residences required by Rev. Stat. § 4920. Lock *v.* Pennsylvania R. R. Co., 1 *N. J. L. J.* 227.

275. *Reception of Evidence under It.*

Under a notice of evidence that the machine had been in use in various places in the United States, evidence cannot be given of a prior use in England. Dixon *v.* Moyer, 4 *Wash.* 68.

The act of 1836 did not make the "public work" mentioned in the notice evidence of any other fact than that such description of the improvement was published; statements in such book, that the machine described was operated successfully in specified years will not authorize the jury to infer that it was in operation during the intermediate time. Seymour *v.* McCormick, 19 *How.* 96; aff'g 3 *Blatchf.* 209.

Where a defendant gives notice of a prior use of the invention in suit by a specified person, he is not obliged to call that person, but may prove the fact by another. Planing Machine Co. *v.* Keith, 101 *U. S.* 479, 492; Many *v.* Jagger, 1 *Blatchf.* 376.

Objection that witnesses produced to show a prior use of the invention were not named in the notice must be made when the testimony is taken, otherwise it will be disregarded. Roemer *v.* Simm, 5 *Pat. Off. Gaz.* 555.

Where no notice of prior use has been given, and it has not been set up in the answer, testimony taken, under objection, before a commissioner, will be rejected by the court. Bragg *v.* City of Stockton, 27 *Fed. Rep'r*, 509.

276. *Bill in Equity for Infringement.*

In a suit for infringement of a patent, an allegation in the complaint, of the residence of the parties, is not necessary to impart jurisdiction. Teese *v.* Phelps, *McAll.* 17.

Where the bill shows that defendant resides in another district, the marshal's return of service must show affirmatively that the subpœna was served within the district in which the suit is brought, to give the court jurisdiction; unless there is a voluntary appearance, which is a submission to the jurisdiction, and will cure the defect. Thayer *v.* Wales, 5 *Fish. Pat. Cas.* 448.

The bill itself, or an affidavit accompanying it on the motion for a preliminary injunction, must contain an averment that the complainant (if the patentee), was the inventor; the usual oath in

making application for the patent, to the originality of the invention will not supply the place. Sullivan *v.* Redfield, 1 *Paine*, 441. To same effect, Rogers *v.* Abbott, 4 *Wash.* 514.

The bill should set forth that, after the issuing of the patent, the complainant had put his invention into use, or had sold the same for a valuable consideration, and is, at the time of the filing of the bill, in the exclusive possession of such patent. Isaacs *v.* Cooper, 4 *Wash.* 259.

Where a patent is void on its face for want of novelty, a bill in a suit for infringement may be dismissed without regard to the answer. Quirolo *v.* Ardito, 1 *Fed. Rep'r*, 610 ; 17 *Blatchf.* 400 ; 5 *Bann. & A. Pat. Cas.* 80.

Allegations, in a bill of equity for infringement of a patent, describing prior patents to the same inventor involving the same principle, upon exceptions to them as immaterial and impertinent, were *held* proper as showing the the history of the invention. Steam-guage & Lantern Co. *v.* McRoberts, 26 *Fed. Rep'r*, 765.

It is not necessary to allege, in a bill for the infringement of a patent for a machine, what articles were made by the use of the machine, in addition to the fact that it was used. Fischer *v.* Hayes, 6 *Fed. Rep'r*, 76 ; 19 *Blatchf.* 26.

The bill need not specify the particulars of the infringement ; a general charge of infringement is all that is necessary to require the defendant to answer the bill. Turrell *v.* Cammerer, 3 *Fish. Pat. Cas.* 462 ; Haven *v.* Brown, 6 *Id.* 413.

Infringement must be shown to have occurred prior to filing the bill therefor. Slessinger *v.* Buckingham, 17 *Fed. Rep'r*, 454 ; 8 *Sawyer*, 469.

The bill need not contain an express prayer for damages ; they are recoverable under the prayer for general relief. Emerson *v.* Simm, 3 *Pat. Off. Gaz.* 293 ; 6 *Fish. Pat. Cas.* 281.

A bill in equity for infringement of a reissued patent need not aver, specifically, the ground on which the original patent was surrendered and the reissue obtained ; nor need it allege facts to show that the commissioner of patents had jurisdiction to entertain the application. Spaeth *v.* Barney, 22 *Fed. Rep'r*, 828 ; 30 *Pat. Off. Gaz.* 997.

An assignee of a patent need not aver in his bill the recording of the instrument, but may treat the defendant as a wrongdoer, and put him to set up in his answer that he is a *bona fide* purchaser for value without notice. Perry *v.* Corning, 7 *Blatchf.* 195.

A bill for infringement filed by the assignee of a patent, set forth the infringement as having occurred while the patent was owned by the assignor, the assignment of "all the right, interest and claim for and to the past use of said invention," and prayed for an injunction and an accounting, and for "such other and further relief as shall be agreeable to equity." This was *held* sufficient to entitle complainant to recover for infringement before as well as after the assignment to him. Campbell *v.* James, 2 *Fed. Rep'r*, 338; 18 *Blatchf.* 92; 18 *Pat. Off. Gaz.* 1111; 10 *Rep'r*, 103; 5 *Bann. & A. Pat. Cas.* 354. See also, 5 *Fed. Rep'r*, 806; 10 *Rep'r*, 686.

It is unnecessary to set up in a bill, the various facts from which complainant's title may be deduced; a simple averment that the title was vested in the plaintiff is sufficient. Nourse *v.* Allen, 4 *Blatchf.* 376; 3 *Fish. Pat. Cas.* 63.

277. *Multifariousness in such Bills.*

A bill is not necessarily obnoxious to the charge of multifariousness because the suit is brought upon more than one patent. Courts encourage this to avoid multiplicity of suits, but in such cases the bill must allege and the proof show that the inventions embraced in several patents are capable of conjoint use and are so used by defendants. Lilliendahl *v.* Detwiller, 18 *Fed. Rep'r*, 176; 16 *Rep'r*, 775.

When a bill in equity alleges infringements of several patents for different inventions, to escape the objection of multifariousness it must aver that the inventions are capable of conjoint use, and that they are in fact so used by the defendant. Barney *v.* Peck, 16 *Fed. Rep'r*, 413; 15 *Rep'r*, 548; 24 *Pat. Off. Gaz.* 101. S. P., Gamewell Fire Alarm Tel. Co. *v.* Chillicothe, 7 *Fed. Rep'r*, 351; Gillespie *v.* Cummings, 3 *Sawyer*, 259; 1 *Bann. & A. Pat. Cas.* 587; Nourse *v.* Allen, 4 *Blatchf.* 376; 3 *Fish. Pat. Cas.* 63; Shickle *v.* South St. Louis Foundry Co., 22 *Fed. Rep'r*, 105; Pope Manuf. Co. *v.* Marqua, 15 *Fed. Rep'r*, 400.

A bill can not be brought for the infringement of distinct patents which are not capable of being used together in making a single structure. Hayes *v.* Dayton, 8 *Fed. Rep'r*, 702; 18 *Blatchf.* 420; 18 *Pat. Off. Gaz.* 1406; 10 *Rep'r*, 802; Hayes *v.* Bickelhaupt, 19 *Pat. Off. Gaz.* 177; Barney *v.* Peck, 24 *Pat. Off. Gaz.* 101; S. C., 16 *Fed. Rep'r*, 413.

Upon the alleged infringement of five distinct patents by the use of one machine, each invention being capable of separate use, it was *held* that the trial of the validity and infringement of each must be upon separate issues, and that a bill uniting the cause was multifarious. Consolidated Electric Light Co. *v.* Brush-Swan Electric Light Co., 20 *Fed. Rep'r*, 502 ; 22 *Blatchf.* 206 ; 28 *Pat. Off. Gaz.* 544.

A bill brought by a patentee to recover profits and damages for an alleged infringement of thirty-eight claims in six different patents, is demurrable on the ground of multifariousness, where there is nothing in the bill to show that any two or more of the patents are in fact, or are capable of being, used in making a single structure, and where the defendant would be prejudiced by being compelled to defend himself in one suit against so many alleged causes of action. Hayes *v.* Dayton, 8 *Fed. Rep'r*, 702 ; 18 *Blatchf.* 420 ; 18 *Pat. Off. Gaz.* 1406 ; 10 *Rep'r*, 802.

Where suit is brought for the infringement of several patents for different improvements not necessarily embodied in the construction and operation of any one machine, the bill must contain an explicit averment that the infringing machines contain all the improvements embraced in the several patents, or it will be bad for multifariousness. Nellis *v.* McLanahan, 6 *Fish. Pat. Cas.* 286.

A bill which, under Rev. Stat. § 4918, prays an adjudication concerning conflicting patents, and also alleges an infringement of the plaintiff's patent by the defendant, and prays an accounting and damages, is not demurrable for misjoinder of causes of action. Leach *v.* Chandler, 18 *Fed. Rep'r*, 262.

Where the right to both patents alleged to be infringed, for the State of California, has been assigned to complainant, the bill is not bad for multifariousness because the assignment of one of the patents also embraces other territory than the State of California. Gillespie *v.* Cummings, 3 *Sawyer*, 259 ; 1 *Bann. & A. Pat. Cas.* 587.

A bill in equity against a corporation and its assignee under a State insolvent law, alleged the making of such assignment infringement of complainant's patent by the corporation, and by the assignee after the assignment to him, and that he was threatening to distribute to the creditors of the corporation the moneys realized by him from its property and assets ; and prayed an injunction, an accounting of profits, damages, &c. It was *held* that the bill was not multifarious ; and that the jurisdiction of the circuit court to

entertain the suit was not affected by the insolvent law of the State. Gordon *v.* St. Paul Harvester Works, 23 *Fed. Rep'r*, 147.

273. *What Faults in such Bills may be Reached by Demurrer.*

As to all merely formal defects in the bill, the objection must be taken by way of demurrer. Pelham *v.* Edelmyer, 25 *Pat. Off. Gaz.* 292 ; 15 *Fed. Rep'r*, 262 ; 21 *Blatchf.* 188.

In a suit for infringement of a patent, a demurrer to the complaint on the ground that it did not state where the complainant, a corporation, was located or did business, was overruled. National Hay-rake Co. *v.* Herbert, 2 *Week. N. of Cas.* 100.

If one who has no interest in the subject-matter of the suit, or in the relief prayed, be joined as a party complainant, the defect may be reached by a general demurrer for want of equity. Hodge *v.* Northern Missouri & Iron Mt. R. R. Co., 1 *Dill.* 104 ; 4 *Fish. Pat. Cas.* 161.

A bill in equity, based on two patents, which alleged that the defendant was using machines containing, in one and the same apparatus, the inventions secured by each of the two patents, was sustained on demurrer. Horman Patent Manuf. Co. *v.* Brooklyn City R. R. Co., 15 *Blatchf.* 444 ; 4 *Bann. & A. Pat. Cas.* 86 ; 7 *Rep'r*, 295.

A bill in equity for the infringement of a patent alleged that the complainant "was the true, original and first inventor of a certain new and useful improved application of steam power to the capstans of vessels, not known or used before," and made profert of his letters-patent and the specifications thereto annexed ; and further alleged "that the defendant is now constructing, using and selling steam power capstans for vessels, in some parts thereof substantially the same in construction and operation as in the said letters-patent mentioned." It was *held*, upon demurrer to the bill, that it sufficiently described the patent and alleged infringement of it. McMillin *v.* St. Louis & Mississippi Valley Transp. Co., 5 *McCrary*, 561 ; 18 *Fed. Rep'r*, 260.

A bill in equity for injunction and an accounting, alleged that one of the defendants made a machine infringing complainant's patent, and sold it to the other defendant, who had ever since used it and still continued to use it ; but it appeared that the machine

was made more than three years before the complaint was filed, and there was no claim of any threat to repeat the wrongful act; and it also appeared that the extent of the injury to complainants from the use of the machine was a suitable license fee. It was *held*, on demurrer, that there was an adequate remedy at law, and no ground of equity jurisdiction. Smith *v.* Sands, 24 *Fed. Rep'r*, 470; 32 *Pat. Off. Gaz.* 1467.

Upon a bill in the usual form for infringement, a demurrer on the sole ground that the complainant is not entitled to equitable relief, should not be sustained, where there is nothing in the bill to indicate laches on the part of the complainant, or that he has granted or intends to grant licenses, or that a money judgment for damages alone will indemnify him, or that ultimately an injunction should not issue for his protection. Brick *v.* Staten Island R. Co., 25 *Fed. Rep'r*, 553.

A bill in equity alleged the invention of a new and original design for a curtain and loop, and that letters patent therefor, of a specified number and date were granted and delivered to the inventor, and contained the usual averments in regard to the execution of the letters patent; but no other description of the invention was given, and no reference was made to the patent for a further description. It was *held*, upon demurrer, that the bill did not sufficiently describe the invention as patented. Post *v.* T. C. Richards Hardware Co., 25 *Fed. Rep'r*, 905.

Where it appears from a bill founded on a reissue patent that the sole object of the reissue was to enlarge and expand the claims of the original patent; and that a delay of more than two or more years took place in applying for the reissue, which is not explained by special circumstances showing it to be reasonable, a general demurrer lies to the bill for want of equity. The decision of the patent-office as to the reasonableness of the delay is not conclusive. And the delay being *prima facie* unlawful, the party seeking to establish the jurisdiction of the patent-office to grant the reissue has the burden of proving the facts on which it rests. Wollensak *v.* Reiher, 22 *Fed. Rep'r*, 651; aff'd, 115 *U. S.* 96.

A bill which, under section 9818 Revised Statutes, upon proper averments prays an adjudication concerning conflicting patents and also alleges infringement by reason of the manufacture and sale by defendant of articles constructed under his patent, and prays an accounting and damages, is not demurrable for misjoinder of causes of action. Leach *v.* Chandler, 18 *Fed. Rep'r*, 262.

In an action for infringement of patent, an assignment of the patent, profert of which is formally made in the complaint, is for all purposes presented to the court as part of the pleading, and a demurrer for a cause arising therefrom may be sustained as if it appeared upon the face of the complaint. Bogart *v.* Hinds, 25 *Fed. Rep'r*, 484.

279. *Plea, or Answer, in Equity.*

A plea filed in answer to a bill against a single defendant for infringement, which alleged that the sales were not made by defendant alone, but were made by him and another person named in the plea, was held bad, because it failed to allege that such other person was yet living within the jurisdiction of the court. Goodyear *v.* Toby, 6 *Blatchf.* 130.

Where, in answer to a bill of complaint for infringement, the defendants filed a plea involving three distinct grounds of defense, such plea was held bad for duplicity. The several matters, although relating in a general way to but a single defense,—viz.: the invalidity of the complainant's patent,—were essentially independent of one another, and by their retention destroyed the very office of the plea, which is to secure singleness in the issue. Reissner *v.* Anness, 12 *Pat. Off. Gaz.* 842; 3 *Bann. & A. Pat. Cas.* 148. The general rule is that a plea must not contain more than one defense. It is not limited to one fact; it may embrace various facts; but they must all conduce to a single point on which the defendant rests his defense. If there is more than one distinct ground of defense to be urged, the defendant should set the matter forth by way of answer and not of plea. *Ib.*

To a bill for infringement, which by sworn allegations fully vested the court with jurisdiction, the defendant filed a sworn plea which admitted the validity and infringement of the patents, but denied the jurisdiction, as it alleged a right to use the patented processes under a contract emanating from the only complainant in interest, and as such complainant was a citizen of the same State with himself, in the absence of further proof,—the plea was *held* insufficient. Lilienthal *v.* Washburn, 8 *Fed. Rep'r*, 707.

Ex parte affidavits introduced without notice to complainant, or without tender of affiant for cross-examination, and writings under private signature unauthenticated, are inadmissible upon the hearing of such plea. *Ib.*

Where parties in their answer, as originally filed, to a bill for infringing a patent, admit that they did manufacture and sell the articles alleged to have been patented, the fact thus admitted in the answer must be accepted as established; but the court will, when justice will be promoted, assume that the smallest number of articles consistent with the circumstances, were made. Jones *v.* Morehead, 1 *Wall.* 155.

Where, in a suit for the infringing of letters patent for a combination of old elements or devices, the parts of which are not susceptible of division or separate use, the answer sets up that the complainant is not the first and original inventor, the defense must apply to the combination as an entirety, and not to a part of it, or to one or more of the claims of the letters, if they do not cover the entire invention. Parks *v.* Booth, 102 *U. S.* 96.

An answer to a bill which avers that the defendant will in future, as he has heretofore done, violate the rights secured by the patent as established on the trial at law, unless restrained by injunction, is not sufficient if defendant merely alleges that what he has done since the trial has not been in violation of the plaintiff's rights; but should state distinctly that the defendant does not intend in future to do the specific things which the court has determined he has no right to do. Poppenhusen *v.* New York Gutta Percha Comb Co., 4 *Blatchf.* 184; 2 *Fish. Pat. Cas.* 74.

The defense that the specification is insufficient is not available unless properly pleaded. Goodyear *v.* Providence Rubber Co., 2 *Cliff.* 351; 2 *Fish. Pat. Cas.* 499.

Persons charged as infringers may set up the defense that the patentee was not the original and first inventor of the alleged improvement; but, if the suit is in equity, they must allege in the answer the names and places of residence of those whom they intend to prove have possessed the prior knowledge of the thing, and where the same has been used. Such notice is required for the benefit of the complainant to prevent surprise; but an answer does not meet that requirement if it furnishes to the complainant no means of knowing the respondent's theory of the construction of the patent. Graham *v.* Mason, 4 *Cliff.* 88; 5 *Fish. Pat. Cas.* 1. S. P., Orr *v.* Merrill, 1 *Woodb. & M.* 376; Teese *v.* Huntington, 23 *How.* 2, 10.

Unless the answer contains notice of prior patents, or persons by whom, and places where, the patented improvement was known or used before the alleged invention of the patentee, copies of the

drawings of prior patents, and testimony respecting them, are not admissible in evidence, against the complainant's objection, to show that the patentee was not the original and first inventor of the patented improvement. Earl *v.* Dexter, 1 *Holmes*, 412; 6 *Pat. Off. Gaz.* 729; 1 *Bann. & A. Pat. Cas.* 400.

In suits for infringement the pleadings should be single, clear, and free from evasion, and the issue tendered clear and unconditional. More than one defense may be presented in an answer, but each should be separately and clearly alleged without condition or qualification. Graham *v.* Mason, 4 *Cliff.* 88; 5 *Fish. Pat. Cas.* 1. To same effect, Jordan *v.* Wallace, 5 *Fish. Pat. Cas.* 185; 8 *Phila.* 165; 1 *Leg. Gaz.* 355.

Defenses not set up in the answer will not be considered by the court in rendering its decision. Howes *v.* Nute, 4 *Cliff.* 173; Wonson *v.* Peterson, 13 *Pat. Off. Gaz.* 548.

Evidence of what is old and in general use at the time of an alleged invention, is admissible in equity cases without any averment in the answer. Brown *v.* Piper, 9 *U. S.* 37. See also, Slawson *v.* Grand St. R'y Co., 107 *U. S.* 649.

An averment, in the answer, that a patent "was obtained upon false and fraudulent representations by the plaintiffs, or some of them, made to the commissioner of patents, and is wholly void in law," is too general to raise any traversable issue. Clark *v.* Scott, 5 *Fish. Pat. Cas.* 245; 9 *Blatchf.* 301; 2 *Pat. Off. Gaz.* 4.

The defense that the patentee had allowed the invention to be in public use or on sale for more than two years before he applied for a patent is distinct from the defense that he had abandoned it to the public, and should not be blended with it in the same pleading. Jones *v.* Sewall, 3 *Cliff.* 563; 3 *Pat. Off. Gaz.* 630; 6 *Fish. Pat. Cas.* 343.

If defendant wishes to claim that the supposed invention is not new, that defense should be set up in the plea or answer; otherwise the evidence in support of the defense is not admissible; but the pleadings need not specify that the subject of the invention is not patentable in its character; this may be shown under the general issue. Guidet *v.* Barber, 5 *Pat. Off. Gaz.* 149.

The defenses of a prior patent or previous description in a printed publication, specified in Rev. Stat. § 4920, subd. 3, must, in a suit in equity, be set up in an answer and not in a technical plea. Carnrick *v.* McKesson, 8 *Fed. Rep'r*, 807; 19 *Blatchf.* 360.

In a suit for infringement, a plea which sets up in general terms

the single defense of non-infringement, without answering, will be stricken out on motion. Sharp *v.* Reissner, 9 *Fed. Rep'r*, 445; 20 *Blatchf.* 10; 20 *Pat. Off. Gaz.* 1161; 12 *Rep'r*, 611.

A licensee under a patent cannot, by a plea in bar, raise such issues as are usually made in answer to a suit for infringement. White *v.* Lee, 4 *Fed. Rep'r*, 916.

In an equity suit against a licensee for an account of profits and damages, and for an injunction for infringement of a patent, it is not inconsistent to allege in an answer that respondent was acting under a license, or that the patent was invalid, where the recital or covenants of the instrument do not forbid the setting up of such a defense. National Manuf. Co. *v.* Myers, 7 *Fed. Rep'r*, 355.

Though an answer denying information as to the infringement of a patent, and denying damages, is insufficient, the orator by replying admits its sufficiency, and assumes the burden of proving the infringement. Wooster *v.* Muser, 20 *Fed. Rep'r*, 162; 28 *Pat. Off. Gaz.* 286.

An answer which only denies that the defendants used the patented invention "with a full knowledge of the premises mentioned in said bill of complaint, and in violation of the complainant's exclusive right secured by the patent of 1864," is an implied admission of its actual use, and complainant is not required to make any further proof of infringement. Jordan *v.* Wallace, 5 *Fish. Pat. Cas.* 185; 8 *Phila.* 165; 1 *Leg. Gaz.* 355.

280. *Amended, Supplemental, or Cross Bill.*

The bill having been brought, answered and tried upon the theory that a recovery upon the assigned claims was sought, the assignee of a patent, in a suit against an alleged infringer, was allowed to amend his bill, before the signing of an interlocutory decree, so as to include assigned claims for damages and profits due to mesne assignors. New York Grape Sugar Co. *v.* Buffalo Grape Sugar Co., 20 *Fed. Rep'r*, 505.

In order to continue an injunction granted on an original patent as to the amended patent, issued upon the surrender of the original patent, a supplemental bill must be filed. Woodworth *v.* Stone, 3 *Story*, 749.

Where a bill in equity was filed in a case of infringement of reissued letters patent, to which answer was made by respondents,

and complainant closed his *prima facie* case by taking proofs, it was *held* that such complainant would be allowed to file a subsequent bill for infringement of the letters-patent after the filing of the first bill of complaint, and that in such proceedings the testimony taken in the first proceeding, so far as relevant, could be used and considered in the subsequent proceedings. Turrell *v.* Spaeth, 9 *Pat. Off. Gaz.* 1163.

Where the question of priority of invention was put in issue in the original suit, evidence of other alleged anticipations than those set up in that suit is merely cumulative, and is not a ground for granting leave to file a supplemental bill. Blandy *v.* Griffith, 6 *Fish. Pat. Cas.* 434.

Leave to file a supplemental bill, in the nature of a bill of review, after dismissal of the original bill in a suit for infringement, for the purpose of introducing new evidence, was refused, where it was not sufficiently shown that the petitioner could not with reasonable diligence, have obtained the new evidence before the hearing on the original bill, and the new matter was itself not material. Spill *v.* Celluloid Manuf. Co., 29 *Pat. Off. Gaz.* 773.

A cross-bill is properly filed to establish an equitable title to letters-patent, the legal title to which is in the plaintiff in the original bill filed for an infringement of such patent. Brandon Manuf. Co. *v.* Prime, 14 *Blatchf.* 371 ; 3 *Bann. & A. Pat. Cas.* 191. Where a cross-bill brought for relief as well as defense shows that persons not parties to the original bill are necessary parties to the cross-bill, they may properly be made such. *Ib.*

In a suit against an interfering patentee, under section 4918 of the Revised Statutes, the defendant is not required to file a cross-bill in order to obtain affirmative relief. Lockwood *v.* Cleaveland, 6 *Fed. Rep'r*, 721.

281. *Amended or Supplemental Answer.*

Where, after setting up the defense of prior knowledge and use, and giving the names and residences of witnesses intended to be called to prove the defense, the answer to a bill for infringement alleges that the names and residences of certain other witnesses are unknown to the defendant, and prays leave to insert and set forth in the answer such names and residences when they shall be discovered, such amendment may be allowed, on subsequent discovery

of the facts; and leave to make it may be granted *nunc pro tunc*. Roemer *v.* Simon, 95 *U. S.* 214.

In view of certain circumstances the court permitted an amendment, at the hearing, of the answer with relation to the notice, *nunc pro tunc* as of the time the answer was filed. Roberts *v.* Ryer, 11 *Blatchf.* 11, 34.

The objection to the omission, in an answer, to set forth the defense of want of novelty with sufficient distinctness ought to be taken by exceptions; as the answer may be amended under special order. Graham *v.* Mason, 4 *Cliff.* 88; 5 *Fish. Pat. Cas.* 1.

Upon a motion to open a decree and amend the answer by setting up the prior issue of a French patent for the same invention, it was *held* that such patent could be admitted only as affecting the question of the duration of the United States patent, and not upon the question of novelty. De Florez *v.* Raynolds, 8 *Fed. Rep'r*, 434; 17 *Blatchf.* 436; 17 *Pat. Off. Gaz.* 503.

A motion will be denied which was made after reference to a master to amend an answer by setting up a new defense denying the manufacture of the articles alleged to be an infringement of plaintiffs' patent, where the omission was not due to inadvertence or mistake. Evory *v.* Candee, 5 *Bann. & A. Pat. Cas.* 67.

A motion will not be granted for an amendment to answer and commission to take testimony in a foreign country to prove who is the original inventor of a patent, when the affidavits filed by plaintiff show that the answer, if amended as proposed, cannot be sustained by proof. Hicks *v.* Otto, 17 *Fed. Rep'r*, 539.

After answering a bill for infringement, setting up that defendants held an assignment from plaintiffs, the defendants discovered reason to believe that the patent was invalid. It was *held* that they might file a supplemental answer denying the validity of the patent. Morehead *v.* Jones, 3 *Wall. Jr.* 306.

XX. EVIDENCE.

282. *Judicial Notice.*

The courts of the United States, in determining a question whether the production of a particular patented article has involved an exercise of the inventive faculties, may take judicial knowledge of matters of common knowledge, and of things in common use. Brown *v.* Piper, 91 *U. S.* 37; Terhune *v.* Phillips, 99 *U. S.* 592; King *v.* Gallun, 109 *U. S.* 99; Dunbar *v.* Myers, 94 *U. S.* 187; Slawson *v.* Railroad Co., 107 *U. S.* 649.

283. *Presumptions.*

As a patent is allowed by law to be issued only upon preliminary proofs to be laid before the commissioner, upon the sufficiency of which he is to decide, the fact that a patent has been granted raises a presumption that sufficient proof of the required facts was duly made, and found satisfactory, and that all proceedings upon which he was required to pass were regularly taken. Philadelphia & Trenton R. R. Co. *v.* Stimpson, 14 *Pet.* 448, 458; Potter *v.* Holland, 1 *Fish. Pat. Cas.* 382; 4 *Blatchf.* 238; Cahoon *v.* Ring, 1 *Fish. Pat. Cas.* 397; Hays *v.* Sulsor, *Id.* 532; 1 *Bond*, 279; Judson *v.* Moore, 1 *Bond*, 285; 1 *Fish. Pat. Cas.* 544; Matthews *v.* Skates, *Id.* 602; Wayne *v.* Holmes, 2 *Fish. Pat. Cas.* 20; 1 *Bond*, 27; Poppenhusen *v.* N. Y. Gutta Percha Comb Co., 2 *Fish. Pat. Cas.* 62; Hussey *v.* Whiteley, *Id.* 120; 1 *Bond.* 407; Cox *v.* Griggs 2 *Fish. Pat. Cas.* 174; 1 *Biss.* 362; Poppenhusen *v.* Falke, 2 *Fish. Pat. Cas.* 181; 5 *Blatchf.* 493; Clarke Patent Steam, &c. Co. *v.* Copeland, 2 *Fish. Pat. Cas.* 221; Union Sugar Refinery Co. *v.* Matthiessen, *Id.* 600; 3 *Cliff.* 639; Giant Powder Co. *v.* Safety Nitro Powder Co., 19 *Fed. Rep'r*, 509.

This is so even though no recital to such effect appears in the patent. Gear *v.* Grosvenor, 3 *Pat. Off. Gaz.* 380; 1 *Holmes*, 215; 6 *Fish. Pat. Cas.* 314.

And the rule applies to the granting of reissues; the presumption of law being, that the commissioner of patents has done his duty in granting a reissue, thoroughly, faithfully and properly, and the question of its propriety is not open for re-examination,

except on the ground of fraud. Miller, &c. Manuf. Co. *v.* Du Brul, 2 *Bann. & A. Pat. Cas.* 618; 12 *Pat. Off. Gaz.* 351. The reissue is presumed right, and the burden of proving the reverse is on the party alleging the invalidity. American Middlings Purifier Co. *v.* Atlantic Milling Co., 3 *Bann. & A. Pat. Cas.* 168; Allen *v.* Blunt, 2 *Woodb. & M.* 121, 138; Stimpson *v.* Westchester R. R. Co., 4 *How.* 380. And where the infringement consists in the defendant's using a machine for which a patent has been issued to him, he should have the benefit of a like presumption in his favor, arising from the official investigation of the originality of his invention, as the plaintiff has by reason of his patent. Corning *v.* Burden, 15 *How.* 252, 271.

But the action of the commissioner in issuing a patent does not preclude one charged with infringing, from impeaching the patent by proof that before it was issued, the patentee had abandoned his invention to the public. Planing Machine Co. *v.* Keith, 101 *U. S.* 479.

Issuing the patent is presumptive evidence of the novelty and utility of the invention, and throws the burden of disproving them upon the defendant. Alden *v.* Dewey, 1 *Story*, 336; 3 *L. Rep'r*, 383. S. P., Needham *v.* Washburn, 4 *Cliff.* 254; 7 *Pat. Off. Gaz.* 649; 1 *Bann. & A. Pat. Cas.* 537; Storrs *v.* Howe, 10 *Pat. Off. Gaz.* 421; 4 *Cliff.* 388; 2 *Bann. & A. Pat. Cas.* 420; Parker *v.* Stiles, 5 *McLean*, 44, 62; 7 *West. L. J.* 168; Teese *v.* Phelps, *McAll.* 48; Corvallis Fruit Co. *v.* Curran, 8 *Fed. Rep'r*, 150; 7 *Sawyer*, 270; 27 *Int. Rev. Rec.* 272. A renewal of the patent strengthens the presumption, though it still may be overthrown. Ransom *v.* New York, 1 *Fish. Pat. Cas.* 252; Smith *v.* Plympton, 4 *West. L. J.* 49.

When the question is as to issuing a preliminary injunction, presumptions of the novelty of a patented invention may arise: 1. From the oath of the patentee that he was the first and original inventor. 2. From the action of the patent-office in granting the patent after full examination. 3. Undisturbed enjoyment of all the benefits of the exclusive rights granted by the patent. 4. Direct adjudications, either at law or in equity, establishing the validity of the patent. 5. Injunctions granted to restrain infringement of the patent. When such grounds exist, courts will not refuse an injunction, or, if granted, will not dissolve it, unless the patent is impeached by the most conclusive evidence. Hussey *v.* Whitely, 1 *Bond*, 407; 2 *Fish. Pat. Cas.* 120.

The issuing of a patent raises a presumption that the patentee, at the time of making his application for a patent, believed himself to be the original inventor or discoverer of the thing patented (Union Sugar Refinery Co. *v.* Mathiessen, 3 *Cliff.* 639 ; 2 *Fish. Pat. Cas.* 600); and this presumption, arising from the oath of the applicant that he believes himself to be the first inventor or discoverer of the thing for which he seeks letters patent, remains until the contrary is proved. Elizabeth *v.* Pavement Co., 97 *U. S.* 126.

The presumption of patentability arising from the grant of a patent, was *held* not repelled, where the device in question, though common, was shown never to have been used for the purpose patented. Patterson *v.* Duff, 20 *Fed. Rep'r*, 641.

The issue, reissue and extension of a patent, and the fact that it has been sustained in previous suits, create a strong presumption against a defense of want of novelty in the invention. Jordan *v.* Dobson, 2 *Abb. U. S.* 398 ; 7 *Phila.* 533. And see Tyler *v.* Crane, 7 *Fed. Rep'r*, 775 ; 19 *Pat. Off. Gaz.* 128

Inasmuch as letters-patent for an invention are issued upon adjudication of public officer, the presumption is that he adjudicated the facts correctly ; if in due form, they raise a presumption that the person named as inventor is the original and first inventor of what is therein described as the improvement ; and the burden of proof to sustain an opposite conclusion is on the party attacking the patent. Sands *v.* Wardwell, 3 *Cliff.* 277 ; Union Sugar Refinery Co. *v.* Mathiessen, 2 *Fish. Pat. Cas.* 600; Hudson *v.* Draper, 4 *Fish. Pat. Cas.* 256 ; 4 *Cliff.* 178 ; Goodyear Dental Vulcanite Co. *v.* Gardner, 3 *Cliff.* 408 ; 5 *Pat. Off. Gaz.* 586 ; 4 *Fish. Pat. Cas.* 224 ; Storrs *v.* Howe, 4 *Cliff.* 388 ; 10 *Pat. Off. Gaz.* 421 ; 2 *Bann. & A. Pat. Cas.* 420 ; Haskell *v.* Shoe Machinery Manuf. Co., 3 *Bann. & A. Pat. Cas.* 553.

A patentee has a right to rest upon his patent for his invention, till its validity is overthrown ; thus, if there is reasonable doubt as to defendant's claim to priority of invention, the patentee is entitled to the benefit of that doubt. Crouch *v.* Spear, 6 *Pat. Off. Gaz.* 187 ; 1 *Bann. & A. Pat. Cas.* 145 ; Washburn *v.* Gould, 3 *Story*, 122, 142 ; 7 *L. Rep'r*, 276 ; 1 *West. L. J.* 465.

Priority in the *construction* of a mechanical appliance is ground for a presumption of priority of *invention.* Atkinson *v.* Boardman, 1 *MacArthur Pat. Cas.* 80 ; Warner *v.* Goodyear, *Id.* 60.

The presumption arising from the letters patent, that the paten-

tee was the original and first inventor, in the absence of the application for the patent, extends back only to the date of the letters patent, and in no case does it extend further back than to the time of the filing of the original application; when a patentee needs to show that his invention was made prior to the date of his application, he must prove the fact by other sufficient evidence. Wing *v.* Richardson, 2 *Fish. Pat. Cas.* 535; 2 *Cliff.* 449. S. P., Jones *v.* Sewall, 6 *Fish. Pat. Cas.* 343; 3 *Cliff.* 563; 3 *Pat. Off. Gaz.* 630; Union Sugar Refinery Co. *v.* Mathiessen, 2 *Fish. Pat. Cas.* 600; 3 *Cliff.* 639.

In order to overcome the presumption raised by a patent that the patentee is the first inventor of the article monopolized, it must be shown that there was a prior knowledge of the invention under such circumstances as to give the public a right to continue the use of it. This presumption prevails over a reasonable doubt existing as to the truth of the evidence adduced to impeach the novelty of invention. Crouch *v.* Speer, 6 *Pat. Off. Gaz.* 187; 1 *Bann. & A. Pat. Cas.* 145. To same effect, Patterson *v.* Duff, 20 *Fed. Rep'r*, 641; Comstock *v.* Sandusky Seat Co., 3 *Cin. L. Bul.* 73.

The issuance of a patent raises a presumption that the patentee was first inventor; in other words, the courts presume the decision of the commissioner in favor of the originality of the patentee to be correct. Donoghe *v.* Hubbard, 27 *Fed. Rep'r*, 742; Pitts *v.* Hall, 2 *Blatchf.* 229; Rogers *v.* Beecher, 3 *Fed. Rep'r*, 639; 5 *Bann. & A. Pat. Cas.* 619; 18 *Pat. Off. Gaz.* 793; Konold *v.* Klein, 5 *Rep'r*, 427; McMillin *v.* Barclay, 4 *Brews.* 275; 3 *Pittsb.* 377; 5 *Fish. Pat. Cas.* 189; Brodie *v.* Ophir Silver Mining Co., 5 *Sawyer*, 608; 4 *Fish. Pat. Cas.* 137.

This presumption of originality of invention is not overcome by evidence introduced to impeach novelty, which does not clearly establish that the alleged anticipating device embodied the same construction and mode of operation. Brady *v.* Atlantic Works, 10 *Pat. Off. Gaz.* 702; 4 *Cliff.* 408; 2 *Bann. & A. Pat. Cas.* 436.

The claim that the patentee was the first inventor of the improvement patented is not defeated by showing the construction of the improvement before the patent issued; there must be proof that the construction preceded the invention of the patentee; that is, before the conception of the improvement was applied in practice. Brodie *v.* Ophir Silver Mining Co., 5 *Sawyer*, 608; 4 *Fish. Pat. Cas.* 137.

Clear and satisfactory proof is required to rebut the presump-

tion of priority of invention arising from the issuing of a patent. Rogers *v.* Beecher, 5 *Bann. & A. Pat. Cas.* 619 ; 3 *Fed. Rep'r*, 630 ; 18 *Pat. Off. Gaz.* 793 ; Konold *v.* Klein, 5 *Rep'r*, 427.

When the invention consists of an improvement on an old machine, it may be taken for granted that a practical mechanic is acquainted with the construction of the machine on which the improvement is made. Ives *v.* Hamilton, 92 *U. S.* 426 ; 6 *Fish. Pat. Cas.* 244 ; 1 *Pat. Off. Gaz.* 336.

There is a presumption that any person who takes out a patent will ascertain, so far as possible, from the public records what patents of the same nature have previously been taken out. Odiorne *v.* Winkley, 2 *Gall.* 51.

The presumption of right in a patentee, because of the acquiescence of the public in his claim, is not changed in consequence of the original patent being surrendered on account of its informality. Orr *v.* Badger, 7 *L. Rep'r*, 465 ; 1 *Brunner Col. Cas.* 537.

A presumption of abandonment cannot arise from the sale or use of an invention with the knowledge and consent of the patentee, intermediate the application for a patent, and the grant. Howe *v.* Newton, 2 *Fish. Pat. Cas.* 531.

The patentee must have had such an exclusive possession, as, with his claim and the acquiescence of the public, lays a reasonable foundation for the presumption of the validity of his patent. An unsuccessful attempt to interrupt a possession strengthens the presumption which arises from it. Sargent *v.* Seagrave, 2 *Curt.* 553.

The plaintiff had a patent for a pavement, and had been employed to lay some fourteen miles of it by the authorities of the cities of New York and Brooklyn, during the past four years. This, standing alone, was *held* not sufficient proof of acquiescence to raise a presumption in favor of the validity of the patent. Guidet *v.* Palmer, 10 *Blatchf.* 217 ; 6 *Fish. Pat. Cas.* 82.

The action of the commissioner of patents usually makes a *prima facie* case for or against an application for an interlocutory injunction. Yuengling *v.* Johnson, 1 *Hughes*, 607 ; 3 *Bann. & A. Pat. Cas.* 99.

It is a presumption of law that all mechanics interested in upholding or defeating a patent were fully acquainted with the state of their art when they took out their patent, or when they built their machine. Crompton *v.* Knowles, 7 *Fed. Rep'r*, 199.

When a party claiming an exclusive right to an invention has used it publicly and notoriously, for any considerable length of

time, the public are presumed to have acquiesced in that claim. American Middlings Purifier Co. *v.* Christian, 3 *Bann. & A. Pat. Cas.* 42.

Knowledge by the public of an invention is presumed where the means of such knowledge have existed. Perkins *v.* Nashua Card, &c. Co., 2 *Fed. Rep'r*, 451 ; 17 *Pat. Off. Gaz.* 1285 ; 10 *Rep'r*, 7 ; 5 *Bann. & A. Pat. Cas.* 395.

There is no obligatory presumption that third persons would have purchased of the patentee what they are shown to have bought of the infringer, in case the latter had not made and sold the thing patented. Seymour *v.* McCormick, 16 *How.* 480 ; rev'g 2 *Blatchf.* 240.

A jury are not authorized in presuming that a machine was in continuous operation for twenty-four years, from the mere facts that it was described in a book in 1829, and was in use in 1853. Seymour *v.* McCormick, 19 *How.* 96.

Patented articles are presumed to be patentably different from those covered by other patents. Buerk *v.* Imhaeuser, 11 *Pat. Off. Gaz.* 112.

Where a joint application is filed for a patent, the presumption is that the invention is joint, and clear and unequivocal evidence will be required to rebut this presumption. Gottfried *v.* Phillip Best Brewing Co., 5 *Bann. & A. Pat. Cas.* 4; 17 *Pat. Off. Gaz.* 675.

The mere deposit in the patent-office of a model does not raise the inference that the application for a patent was completed at that date. Draper *v.* Wattles, 16 *Pat. Off. Gaz.* 629 ; 3 *Bann. & A. Pat. Cas.* 618.

In a suit for infringement, the patentee will be presumed to be still the owner, where no assignment has been alleged or proved. Fischer *v.* Neil, 6 *Fed. Rep'r*, 89 ; 19 *Pat. Off. Gaz.* 603.

The fact of the granting of a patent has no tendency to show that the invention described in it does not infringe a prior patent ; and the decision of the patent-office, on a question of interference between the two, is evidence of such fact on a motion for injunction. Holliday *v.* Pickhardt, 12 *Fed. Rep'r*, 147 ; 22 *Pat. Off. Gaz.* 420.

Where a patentee is in the employ of another, and uses the latter's tools and materials in perfecting his inventions, and such other person uses such inventions for a number of years without payment of royalty, a special license will be presumed. Jencks *v.* Langdon Mills, 27 *Fed. Rep'r*, 622.

284. *Burden of Proof.*

The burden is on the defendant to show that the proper notice has been given under the statute to enable him to examine witnesses to prove that the invention of the plaintiff had been known or used before his invention. Philadelphia & Trenton R. R. Co. *v.* Stimpson, 14 *Pet.* 448 ; *Id.*, Banks' ed. *note.*

In order to avoid liability for profits, made by an infringer who uses an article patented as an entirety or product, the burden is upon him to show that a portion of these profits is the result of some other thing used by him. Elizabeth *v.* Pavement Co., 97 *U. S.* 126. But compare Fitch *v.* Bragg, 16 *Fed. Rep'r*, 243 ; 21 *Blatchf.* 302.

In a suit for infringement of a patent for an improvement and not for an entirely new machine or contrivance, the burden rests upon the patentee to show in what particulars his improvement has added to the usefulness of the machine or contrivance, and he must separate its results distinctly from those of the other parts, so that the benefits derived may be distinctly seen and appreciated. Garretson *v.* Clark, 111 *U. S.* 120 ; aff'g 15 *Blatchf.* 70 ; 14 *Pat. Off. Gaz.* 485.

Upon the question whether what has been done by the defendant amounts to infringement, the complainant universally has the burden of proof ; he must show satisfactorily that his right has been violated. Washburn *v.* Gould, 3 *Story*, 122 ; 7 *L. Rep'r*, 276 ; 1 *West. L. J.* 465 ; Graham *v.* Mason, 4 *Cliff.* 88 ; 5 *Fish. Pat. Cas.* 1 ; Hudson *v.* Draper, 4 *Cliff.* 178 ; 4 *Fish. Pat. Cas.* 256 ; Storrs *v.* Howe, 4 *Cliff.* 388 ; 10 *Pat. Off. Gaz.* 421 ; 2 *Bann. & A. Pat. Cas.* 420 ; American Middlings Purifier Co. *v.* Atlantic Milling Co., 3 *Bann. & A. Pat. Cas.* 168 ; Brooks *v.* Jenkins, 3 *McLean*, 432, 453 ; S. C., *sub nom.* Brooks *v.* Bicknell, 2 *West. L. J.* 11 ; Parker *v.* Stiles, 5 *McLean*, 44.

Section 7 of the act of 1839,—allowing the use and sale of an invention for two years before the application for a patent, —is in the nature of a statute of limitations ; and the defendant setting up a sale more than two years before must establish the fact of such a sale, in a manner that will justify a jury in taking away the property of the plaintiff. Hovey *v.* Henry, 3 *West. L. J.* 153.

In an action for infringement, if the defendant contests the originality of the invention, the burden of proof is upon him to

show that it was known before the invention of plaintiff. Hovey *v.* Henry, 3 *West. L. J.* 153; Winans *v.* New York & Harlem R. R. Co., 31 *Jour. Fr. Inst.* (*3rd S.*) 320; Brooks *v.* Jenkins, 3 *McLean*, 432; S. C., *sub nom.* Brooks *v.* Bicknell, 2 *West L. J.* 11; Parker *v.* Stiles, 5 *McLean*, 44; 7 *West L. J.* 417. To same effect, Doherty *v.* Haynes, 4 *Cliff.* 291; 6 *Pat. Off. Gaz.* 118; 1 *Bann. & A. Pat. Cas.* 289; Hoe *v.* Cottrell, 1 *Fed. Rep'r*, 597; 17 *Blatchf.* 546; 18 *Pat. Off. Gaz.* 59; 5 *Bann. & A. Pat. Cas.* 256; Worswick Manuf. Co. *v.* Buffalo, 20 *Fed. Rep'r*, 126. And see Parker *v.* Remhoff, 17 *Blatchf.* 206; 3 *Bann. & A. Pat. Cas.* 550.

The date of the patent is to be taken, in the absence of other evidence, as the date of invention; and the burden of proof is upon the defendant to show, beyond any fair doubt, prior knowledge and use. Webster Loom Co. *v.* Higgins, 16 *Pat. Off. Gaz.* 675. To same effect, Eagleton Manuf. Co. *v.* West, &c. Manuf. Co., 2 *Fed. Rep'r*, 774; 18 *Blatchf.* 218; 17 *Pat. Off. Gaz.* 1504; 10 *Rep'r*, 297.

Where an equitable title to an interest in a patent is set up against a *bona fide* purchaser and holder of the legal title, the burden of proof lies upon him who impeaches the legal title. Gibson *v.* Cook, 2 *Blatchf.* 144, 151. Compare Calais Steamboat Co. *v.* Scudder, 2 *Black*, 372.

The burden of proof is on the defendant who alleges a prior sale or use. Allen *v.* Blunt, 2 *Woodb. & M.* 121, 145; Hide & Leather Co. *v.* American Tool Co., 1 *Holmes*, 503; 4 *Fish. Pat. Cas.* 284; Roemer *v.* Sinn, 5 *Pat. Off. Gaz.* 555.

Power to grant reissued as well as original patents is vested in the commissioner; and, when lawfully exercised, a patent has been duly granted, whether reissued or original, it is, of itself, if introduced in evidence where a party claims redress for alleged infringement, *prima facie* evidence that the patentee is the original and first inventor. Its effect may, however, be overcome by proof that the improvement was previously made by another in this country, or had previously been described in some printed publication, prior to the supposed invention by the patentee. Judson *v.* Bradford, 16 *Pat. Off. Gaz.* 171; 3 *Bann. & A. Pat. Cas.* 539.

Under the act of 1861, § 13,—requiring the word "patented," with the date when granted, to be affixed to patented articles offered for sale,—the burden of proof is upon the defendant to show that the plaintiff has failed to mark patented, as required, articles made

or sold under a patent, and then the burden is shifted upon the plaintiff to show that defendant had notice that he was infringing. Goodyear *v.* Allyn, 6 *Blatchf.* 33 ; 3 *Fish. Pat. Cas.* 374.

In a case where the application fails to take the date of invention back of the date of the patent, and the defendant shows, beyond a reasonable doubt, knowledge and use before the date of the patent, the burden of proof is shifted on to the plaintiff, to show the date of invention to be prior to the knowledge and use shown by defendant. Eagleton Manuf. Co. *v.* West, &c. Manuf. Co., 2 *Fed. Rep'r*, 774 ; 18 *Blatchf.* 218 ; 17 *Pat. Off. Gaz.* 1504 ; 10 *Rep'r*, 297 ; Thayer *v.* Hart, 20 *Fed. Rep'r*, 693.

Where the bill alleges that defendant's infringement was without the consent of the plaintiff, which was not specifically denied by the answer or any consent or license alleged, the burden of proof does not rest upon the plaintiff to show want of consent, but upon the defendant to prove consent. Fischer *v.* Hayes, 6 *Fed. Rep'r*, 76 ; 4 *Bann. & A. Pat. Cas.* 317.

The burden is on the plaintiff, in an infringement suit, to prove that defendant's article is like plaintiff's. Francis *v.* Mellor, 4 *Am. L. T. U. S. Cts.* 237 ; 1 *Leg. Gaz. Rep.* 291 ; 8 *Phila.* 157.

The burden is upon the defendant to establish the defense that the invention is not so described as to enable a skillful mechanic to construct a machine. Brooks *v.* Jenkins, 3 *McLean*, 432, 445 ; S. C., *sub nom.* Brooks *v.* Bicknell, 2 *West. L. J.* 11.

In a suit for infringement, the allegation of a license is an affirmative defense, and must be made out by the proof. Watson *v.* Smith, 7 *Fed. Rep'r*, 350 ; 20 *Pat. Off. Gaz.* 300.

Where complainant seeks to recover damages on the basis of an established royalty for the use of several claims, only a part of which have been infringed, the burden of proof is upon him to show the relative value of the claims which have been infringed. Willimantic Thread Co. *v.* Clark Thread Co., 27 *Fed. Rep'r*, 865.

In an action for infringement of letters patent, where the defendant sets up want of novelty, the burden is on him to establish this defense, and prove the facts set up by him beyond a reasonable doubt. Cantrell *v.* Wallick, 117 *U. S.* 689.

In a suit for infringement of a patent, the burden is upon the defendants to establish a defense of prior knowledge and use beyond a reasonable doubt. Dreyfus *v.* Schneider, 25 *Fed. Rep'r*, 481.

A party asserting, as a defense to a suit for infringement, that

the device covered by the patent has been in public use, or on sale, for more than two years prior to the application for the patent, assumes the burden of proof, and is bound to sustain this defense by clear and convincing testimony. Proof resting wholly in the recollection of persons who claim to have seen or used such prior devices twenty years before they testified, where none of such devices is produced, and it does not appear that more than one of each kind was ever made, is too unreliable to form a safe basis for judicial action. Adams & Westlake Manuf. Co. *v.* Rathbone, 26 *Fed. Rep'r*, 262.

The decision of the patent-office is not conclusive upon the court where priority of invention between interfering patents is in question, but is of sufficient weight to cast the burden of proof upon the party against whom it was rendered. Wire Book Sewing Machine Co. *v.* Stevenson, 11 *Fed. Rep'r*, 155 ; 13 *Rep'r*, 422.

285. *General Rules of Evidence as to the Construction and Validity of the Patent, and Extent of the Right it Confers.*

Evidence is admissible to show the meaning of terms used in letters patent, as well as the state of the art. Loom Co. *v.* Higgins, 105 *U. S.* 580 ; rev'g 15 *Blatchf.* 446 ; 16 *Pat. Off. Gaz.* 675 ; 4 *Bann. & A. Pat. Cas.* 88.

In determining the question as to whether the patentee believed himself to be the first inventor, it is competent for the defendant to show that the patentee knew of the existence of the invention abroad. But in considering whether the patentee did believe himself to be the first inventor, it is material to determine whether he was the first inventor. Forbush *v.* Cook, 10 *L. Rep'r, N. S.* 664 ; 2 *Fish. Pat. Cas.* 668.

The question of novelty is to be settled by a comparison of prior machines with the machine patented, rather than the form of the machine in use. Blake *v.* Rawson, 3 *Biss.* 77; 3 *Pat. Off. Gaz.* 122 ; 6 *Fish. Pat. Cas.* 74.

In an action at law, where the issue of novelty is raised, it is *not competent to compare prior machines with the one used by* defendant ; the only comparison admissible is with that used by the patentee. Judson *v.* Cope, 1 *Bond*, 327 ; 1 *Fish. Pat. Cas.* 615.

Where a patent is assailed for lack of novelty, sketches and drawings may be consulted to fix the date of inceptive invention, and if there has been no unreasonable delay subsequently in adapting the invention and applying for patent, the protection of the patent will be carried back to the date thus established. Draper *v.* Potomska Mills Corp., 13 *Pat. Off. Gaz.* 276; 3 *Bann. & A. Pat. Cas.* 214; Kneeland *v.* Sheriff, 2 *Fed. Rep'r*, 901; 10 *Rep'r*, 234; 18 *Pat. Off. Gaz.* 242; 5 *Bann. & A. Pat. Cas.* 482.

The patent itself is *prima facie* evidence that the alleged inventor had made the invention at the date the specification was filed. Jones *v.* Sewall, 3 *Cliff.* 563; 3 *Pat. Off. Gaz.* 630; 6 *Fish. Pat. Cas.* 343. S. P., Dane *v.* Chicago Manuf. Co., 3 *Biss.* 380.

Defendants in a suit on a reissue patent, may read the original patent in evidence at the trial, although it may not have been put in evidence before the examiner, in order to show that the reissue is, in fact, for a different invention from the original. Knapp *v.* Shaw, 23 *Pat. Off. Gaz.* 2236; 15 *Fed. Rep'r*, 115. S. P., National Cylinder Co. *v.* Simmons Hardware Co., 18 *Fed. Rep'r*, 324.

Against an allegation that a patentee had abandoned his discovery, the lapse of time from the grant of the patent to the commencement of the action being urged as proof of that fact, he may give evidence of his filing of drawings, or of any other act done by him in assertion of his right. Emerson *v.* Hogg, 2 *Blatchf.* 1.

The fact that a patent has been issued for an invention does not, of itself, prove the introduction of the invention into public and common use. Weston *v.* White, 13 *Blatchf.* 364; 9 *Pat. Off. Gaz.* 1196; 2 *Bann. & A. Pat. Cas.* 321.

In an action for infringement, where there was proof that a machine constructed before the plaintiff's invention, and identical with it, for a person who lived some distance from the place of construction, was taken away by him to be put up; but it was never afterward seen by the witness who assisted in its construction, it was *held*, that the evidence was sufficient to establish the fact of want of novelty in the plaintiff's invention, though there was no proof to show that the prior machine was ever used. Parker *v.* Ferguson, 1 *Blatchf.* 407.

When an alleged invention proves superior to what has been known before, this superiority is evidence in favor of its novelty. Birdsell *v.* McDonald, 6 *Pat. Off. Gaz.* 682; Judson *v.* Cope, 1 *Bond*, 327; 1 *Fish. Pat. Cas.* 615. S. P., Carter *v.* Baker, 4 *Fish. Pat. Cas.* 404; Smith *v.* Woodruff, 1 *MacArthur*, 459; 6 *Fish.*

Pat. Cas. 476. But except to show a difference between the two inventions, evidence that the defendant's is superior to plaintiff's is not admissible. Alden *v.* Dewey, 1 *Story*, 336 ; 3 *L. Rep'r*, 383.

The facts that many persons tried to accomplish the result, and that the patentee alone succeeded, are legitimate evidence that his invention was new and useful. Western Electric Manuf. Co. *v.* Chicago Electric Manuf. Co., 14 *Fed. Rep'r*, 691 ; Ward *v.* Grand Detour Plow Co., 14 *Fed. Rep'r*, 696 ; 11 *Biss.* 427.

Rejected applications for patents are not alone evidence of the existence of perfected inventions at their dates of filing ; there should be proof that, at such dates, machines embodying the inventions were in existence and operation. Howes *v.* McNeal, 15 *Pat. Off. Gaz.* 608 ; 15 *Blatchf.* 103 ; 3 *Bann. & A. Pat. Cas.* 376 ; Lyman Ventilating Co. *v.* Chamberlain, 10 *Pat. Off. Gaz.* 588 ; 2 *Bann. & A. Pat. Cas.* 433.

In connection with evidence of the construction of an operative machine embodying the invention, a rejected application for a patent for it may be received. Northwestern Fire Extinguisher Co. *v.* Philadelphia Fire Extinguisher Co., 6 *Pat. Off. Gaz.* 34 ; 10 *Phila.* 227 ; 1 *Bann. & A. Pat. Cas.* 177.

File wrappers are not competent as evidence, in a suit on a patent, to show the reduction to practice and use of inventions claimed to be prior, so as to invalidate such patent. Howes *v.* McNeal, 4 *Fed. Rep'r*, 151 ; 17 *Blatchf.* 396 ; 17 *Pat. Off. Gaz.* 799 ; 11 *Rep'r*, 362 ; 5 *Bann. & A. Pat. Cas.* 77.

If the signature of a letter acknowledging the receipt of an application for a patent is proved, the letter is competent as an official act and document of a public officer in relation to such a subject, and a part of the transaction ; for, being made at the time, and in relation to the subject-matter, it is competent as a part of the *res gestæ*, and explanatory of what took place. Pike *v.* Potter, 3 *Fish. Pat. Cas.* 55.

A different result is evidence of some new cause or means, although the mechanism may apparently be substantially the same. Hence a greater degree of utility achieved by one machine is evidence of novelty. Eames *v.* Cook, 2 *Fish.* 146.

It is decisive evidence that a new mode of operation has been introduced if the practical effect of the invention is either a new effect or a materially better effect, or as good an effect more economically attained. Furbush *v.* Cook, 2 *Fish. Pat. Cas.* 668.

Public demand for an article when its existence is made known,

is not conclusive evidence of novelty and invention. Hill *v.* Biddle, 27 *Fed. Rep'r*, 560.

The extensive use of a device, however simple, is evidence of its utility, and consequently of its patentable merit. Lorillard *v.* McDowell, 23 *Int. Rev. Rec.* 90 ; 11 *Pat. Off. Gaz.* 640; 2 *Bann. & A. Pat. Cas.* 531 ; 13 *Phila.* 461.

The fact that defendant chose to use the invention patented by complainant, has been *held* sufficient evidence of utility in the invention to sustain it as patentable for the purposes of that suit. Smith *v.* Glendale Elastic Fabric Co., 1 *Holmes*, 340 ; 5 *Pat. Off. Gaz.* 429 ; 1 *Bann. & A. Pat. Cas.* 58 ; Lee *v.* Blandy, 1 *Bond*, 361 ; 2 *Fish. Pat. Cas.* 89. Otherwise, of evidence that strangers to the suit offered to take licenses from the plaintiff. Evans *v.* Hettick, 3 *Wash.* 408 ; aff'd on other points, 7 *Wheat.* 453.

The fact that a mill for grinding bark would grind double the quantity that could be ground by the old mills, is evidence enough of utility to sustain a patent. Wilbur *v.* Beecher, 2 *Blatchf.* 132.

Where the evidence establishes the facts that the patentee was the first to conceive the idea of constructing the device described in his patent, whereby improved results were accomplished, and that the public has attested its superior utility and value by adopting the same, instead of the constructions previously used, there is sufficient proof of patentable merit. Miller *v.* Pickering, 16 *Fed. Rep'r*, 540.

On a motion for a preliminary injunction, the defense of prior public use will be entertained, although unsuccessfully made in former cases, where such defense is much more strongly fortified than before by corroborative evidence, and it is reasonable to believe that a different result would have been reached if the new evidence had been presented. Lockwood *v.* Faber, 27 *Fed. Rep'r*, 63.

Clear proof is required of mistake in drawings on file, after destruction of model. Royer *v.* Russell, 9 *Fed. Rep'r*, 696 ; 20 *Pat. Off. Gaz.* 1819.

The defense of a prior knowledge and use is established when the evidence shows that the invention was complete and capable of working, and had been put in public use, and was known to any considerable number of persons. Judson *v.* Bradford, 16 *Pat. Off. Gaz.* 171 ; 3 *Bann. & A. Pat. Cas.* 539.

Where there has been a public acquiescence in the validity of a

patent, the court will scrutinize evidence of its invalidity with the greatest care. Hobbie *v.* Smith, 27 *Fed. Rep'r*, 656.

A claim to prior use needs to be proved beyond a reasonable doubt. Coffin *v.* Ogden, 18 *Wall.* 120; Troy Iron, &c. Factory *v.* Corning, 1 *Blatchf.* 467; Campbell *v.* James, 17 *Blatchf.* 42; 4 *Bann. & A. Pat. Cas.* 456; 18 *Pat. Off. Gaz.* 979; 8 *Rep'r*, 455; see reversal, 104 *U. S.* 357; Campbell *v.* New York, 9 *Fed. Rep'r*, 500; Troy Iron, &c. Co. *v.* Odiorne, 17 *How.* 72; 20 *Blatchf.* 67; 20 *Pat. Off. Gaz.* 1817; Doubleday *v.* Beatty, 11 *Fed. Rep'r*, 729; 22 *Pat. Off. Gaz.* 859; Hawes *v.* Antisdel, 8 *Pat. Off. Gaz.* 685; Washburn, &c. Manuf. Co. *v.* Haish, 4 *Fed. Rep'r*, 900; 10 *Biss.* 55; 19 *Pat. Off. Gaz.* 173; Everest *v.* Buffalo Lubricating Oil Co., 20 *Fed. Rep'r*, 848; Wetherell *v.* Veith, 27 *Fed. Rep'r*, 364; Hobbie *v.* Smith, *Id.* 656. See also *infra*, p. .

The fact that a manufacturer for a long period does not make use of a means of production important in the business, shows that he did not have the idea. Roots *v.* Hyndman, 4 *Pat. Off. Gaz.* 29; 6 *Fish. Pat. Cas.* 439.

Making and exhibiting a new article is presumptive proof of invention; but if the exhibitor makes no claim at the time to having invented it, this tends to rebut the presumption. Pennock *v.* Dialogue, 4 *Wash.* 538.

Evidence that in operating a prior machine a greater number of persons necessarily have to be employed than are required in the operation of a patented machine, tends to prove that the machines are not alike. Coupe *v.* Weatherhead, 23 *Pat. Off. Gaz.* 1927.

If two devices produce different results, this is some evidence that the devices themselves are different. Waterbury Brass Co. *v.* New York Brass Co., 3 *Fish. Pat. Cas.* 43.

286. *Rules of Evidence as to Matters Connected with Reissues.*

The question of the identity of an invention described in the original and the reissued letters patent is one of law for the court, whenever it can be determined solely from their face by mere comparison of specifications, without the aid of extrinsic evidence. Heald *v.* Rice, 104 *U. S.* 737.

A defective patent was surrendered and a new one taken out. In an action for a violation thereof, in which the infringement was

laid subsequent to the date of the reissue, evidence of a use of a machine prior to the date of the second patent, but subsequent to that of the first, is not admissible in defense. Stimpson *v.* West Chester R. R. Co., 4 *How.* 380.

Where the defendant sets up as a defense in a suit for infringement of reissued letters patent, that they are broader than the original, and therefore invalid, and the plaintiff fails to introduce the original in evidence, the defendant may introduce them, and the question of the validity of the reissued patent may be passed upon by a comparison. National Pump Cylinder Co. *v.* Simmons Hardware Co., 18 *Fed. Repr*, 324. S. P., Knapp *v.* Shaw, 23 *Pat. Off. Gaz.* 2236 ; 15 *Fed. Rep'r*, 115.

287. *Evidence as to Plaintiff's Title to the Patent or to the Damages.*

In a court of equity, an equitable title is sufficient, as against the patentee, and those claiming under him if with notice of the complainant's title, and that notice appears by the records of the complainant's title. Ruggles *v.* Eddy, 10 *Blatchf.* 52 ; 5 *Fish. Pat. Cas.* 581.

A decree obtained for infringement cannot be introduced on the trial of an action against one not a party nor privy to the former suit, for the purpose of proving his acquiescence in the rights of plaintiff under the patent. Such decrees, although admissible upon motions for a provisional injunction, are proceedings *inter alios*, and are not competent evidence on a trial upon the merits. Matthews *v.* Iron Clad Manuf. Co., 19 *Fed. Rep'r*, 321.

A license granted by the patentee of an invention, permitting the invention to be manufactured and used upon certain terms and conditions, cannot be deemed evidence of an acquiescence in infringements of his right ; it is, rather, an assertion of an exclusive right in the invention. Jordan *v.* Dobson, 2 *Abb., U. S.* 398 ; 7 *Phila.* 533.

A patentee who has given another person a writing showing that he has an interest in the patent, may show by parol that the writing does not contain the contract nor express the intention of the parties. Kearney *v.* Lehigh Valley R. Co., 27 *Fed. Rep'r*, 699.

288. *As to the Charge of Infringement.*

Evidence that third persons who, as defendant has shown, have used a machine like plaintiff's, prior to his invention, and paid plaintiff for licenses, is competent, though not important. Evans *v.* Eaton, 3 *Wheat.* 454, 505.

When, upon appeal in an action for an infringement, it appears that the parties have admitted that the defendants have used machinery constructed in conformity with the plaintiff's patent, the admission is sufficient to make a *prima facie* case of infringement. Chaffee *v.* Boston Belting Co., 22 *How*, 217.

The fact that the device defendant manufactures works better than another which is patented, and has driven it out of market, is *prima facie* evidence that the use of it does not violate the patentee's monopoly. Smith *v.* Woodruff, 1 *MacArthur*, 459 ; 6 *Fish. Pat. Cas.* 476.

Where the answer, under oath, is responsive to a bill seeking an injunction against infringement, and denies the infringement, something more than the evidence of a single witness must be produced to overcome it and justify an injunction. Woodworth *v.* Hall, 1 *Woodb. & M.* 248 ; 6 *Pa. L. J.* 178.

Exclusive right in the person under whom the defendants claim a right to use the machine in controversy, cannot be shown by evidence that the defendants have for several years used the machine, with the plaintiff's knowledge, and without any objection on his part. Baldwin *v.* Sibley, 1 *Cliff.* 150.

A failure on the part of a defendant charged with infringement to bring into court the article in question, when it is within his power so to do, will be taken as an admission of infringement. Ely *v.* Monson, &c. Manuf. Co., 4 *Fish. Pat. Cas.* 64.

Parol evidence of a written contract for the use of a patent article, was *held* admissible in a suit for infringement. Andrews *v.* Creegan, 7 *Fed. Rep'r*, 477 ; 19 *Blatchf.* 113 ; 19 *Pat. Off. Gaz.* 1140 ; 11 *Rep'r*, 527.

In defense of a suit for infringement of a prior patent, a licensee may put in evidence the patent of his licensor. Blanchard *v.* Puttman, 3 *Fish. Pat. Cas.* 186 ; 2 *Bond*, 84.

Proof of the charge of infringement must be clear. Racine Seeder Co. *v.* Joliet Wire Check Sower Co., 27 *Fed. Rep'r*, 367.

In a suit for infringement of a patent for improvement in ovens,

evidence that defendant put up the oven constituting the infringement; and controlled and managed it, was *held* sufficient to establish the infringement alleged. Peterson *v.* Simpkins, 25 *Fed. Rep'r*, 486 ; 33 *Pat. Off. Gaz.* 1392.

Where the answer under oath denies infringement, the testimony of one witness is insufficient, unless corroborated by circumstances. Slessinger *v.* Buckingham, 17 *Fed. Rep'r*, 454. See Spring *v.* Domestic Sewing Mach. Co., 21 *Pat. Off. Gaz.* 633 ; Bennett *v.* Fowler, 8 *Wall.* 445.

When the proof showed that defendant's machine did not correspond with the description of the patent, and the functions of plaintiff's devices would not work in defendant's machine, it was held no infringement. Kirby *v.* Dodge & Stevenson Manuf. Co., 10 *Blatchf.* 307.

When the answer does not explicitly deny infringement, the court may infer from the testimony of a witness who saw infringing machines in the possession of the defendants, some of which were in use, that all the machines had been used by all the defendants. Gear *v.* Fitch, 16 *Pat. Off. Gaz.* 1231.

When, from the evidence, it appears that the defendant is simply pursuing the same process of manufacturing, which he followed before the patent in question was issued, the court will not interfere to restrain defendant from continuing its use. Dorlan *v.* Guie, 34 *Pat. Off. Gaz.* 702.

289. *As to Matters of Affirmative Defense.*

Evidence that for a long time after making an invention, and without special cause, the inventor neglected to make and prosecute an application for letters patent, under attendant circumstances evincing an intent to abandon, may suffice to prove abandonment. Planing Machine Co. *v.* Keith, 101 *U. S.* 479. S. P., *Re* Rowley, 2 *Am. L. T. U. S. Cts.* 106.

It is strong evidence for a jury, of an intent to abandon, that a claimant of an invention withdrew it from use, and neglected or discarded it, and did not attempt to resume it until a rival device had been brought forward. Johnson *v.* Root, 2 *Cliff.* 108 ; 2 *Fish. Pat. Cas.* 291 ; Parkhurst *v.* Kinsman, 1 *Blatchf.* 488 ; 8 *N. Y. Leg. Obs.* 146 ; aff'd on other points, 18 *How.* 289.

Evidence of abandonment of a part only, and that not the most

important part of the claim of a patent, does not warrant a general finding of abandonment. New York Grape Sugar Co. *v.* Buffalo Grape Sugar Co., 18 *Fed. Rep'r*, 638 ; 25 *Pat. Off. Gaz.* 1076.

Evidence that a person abandoned the use of a particular machine, is not evidence that the machine itself was a new abandoned experiment. Pickering *v.* McCullogh, 13 *Pat. Off. Gaz.* 818.

Clear proof is necessary to establish the defense of anticipation (Donoghe *v.* Hubbard, 27 *Fed. Rep'r*, 742 ; Gottfried *v.* Phillip Best Brewing Co., 17 *Pat. Off. Gaz.* 675 ; 5 *Bann. & A. Pat. Cas.* 4) ; especially where the allegation is that an invention was long ago anticipated by one which never became generally known. Lane *v.* Peck, 9 *Fed. Rep'r*, 101.

Where the alleged prior inventor was shown to be very near the realization of the invention, but could not, at a period long subsequent, make a practical machine embodying the invention, it was held that his operations were not sufficient to defeat a patent, although witnesses testified that they were successful. American Bell Telephone Co. *v.* People's Telephone Co., 34 *Pat. Off. Gaz.* 561.

290. *As to Amount of Damages and Profits.*

Evidence of amounts received by patentee in settlements for other infringements cannot be received in aid of determining the amount which ought to be paid by defendant for his infringement of the same patent. Westcott *v.* Rude, 19 *Fed. Rep'r*, 830.

A license for future use of a patented invention, given wholly or partly in consideration of a settlement for past infringements, is not admissible, as against a stranger, to establish the amount of a royalty. Gottfried *v.* Crescent Brewing Co., 22 *Fed. Rep'r*, 433 ; 30 *Pat. Off. Gaz.* 892.

Proof of sales of patented machines, and an agreement between patentees for their manufacture and sale was *held* admissible, although not conclusive, in a suit for infringement, as tending to show the value of the invention ; although the sales had not been numerous or uniform enough to establish a license fee. Gottfried *v.* Crescent Brewing Co., *Ib.*

Admissibility, in a suit for infringement of one of several claims in a patent, of evidence of profits derived from the use of the patented invention, as an entirety, considered. Fischer *v.* Hayes, 22 *Fed. Rep'r*, 529.

Evidence for plaintiff in suits for infringement, was *held* inconclusive, and not sufficient, under the circumstances, to sustain the bills. Deplanque *v.* Ripka, 24 *Fed. Rep'r*, 278.

Where complainant's device was but of little value, and the defendant added improvements which rendered the device marketable, it was *held*, that the complainant must show what proportion of profits was due to the original invention ; and failing in that, the complainant is entitled to nominal damages, only. Bostock *v.* Goodrich, 34 *Pat. Off. Gaz.* 1047.

291. *Declarations of Inventor, &c.*

The conversations and declarations of an inventor stating that he had made an invention, and describing its details, and explaining its operations, are properly deemed an assertion of his right, at that time, to the extent of the facts and the circumstances which he then makes known, although not of their existence at any anterior time, and is competent evidence to fix the date of invention as of that time. Philadelphia & Trenton R. R. Co. *v.* Stimpson, 14 *Peters*, 448.

The statements of a person claiming to be an inventor, made *prior* to the proceedings for interference, in which he graphically describes the invention, are admissible as part of the *res gestæ*. Yearsley *v.* Brookfield, 1 *MacArthur Pat. Cas.* 193.

The declarations of an inventor in describing the details of a device and its mode of operation, are admissible in his favor as part of the *res gestæ*, when the priority of invention is in question. Richardson *v.* Hicks, 1 *MacArthur Pat. Cas.* 335 ; Stephens *v.* Salisbury, *Id.* 379.

292. *Testimony of Ordinary Witnesses.*

Since the rules of evidence prescribed by the State are rules of decision for the United States courts, it was *held*, that a plaintiff in an action for infringement was competent as a witness ; it appearing that under the laws of the State where the trial was had, parties to a suit were declared competent witnesses. Vance *v.* Campbell, 1 *Black*, 427 ; rev'g 1 *Fish. Pat. Cas.* 483 ; Haussknecht *v.* Claypool, 1 *Black*, 431.

In considering the question of originality, the oath of the inventor, made prior to the issue of the letters-patent, that he was the first inventor of the thing patented, may be opposed to the oath of a witness offered to show that the invention was not original. Alden *v.* Dewey, 1 *Story*, 336; 3 *L. Rep'r*, 383.

The testimony of a witness who had no knowledge as to how the articles resembling complainant's invention were made, is insufficient to invalidate plaintiff's patent on the ground that he was not the original inventor, or that the same was in use before his invention. Treadwell *v.* Bladen, 4 *Wash.* 703.

The priority of knowledge and use of an invention is a question of fact, which a jury may decide from one witness; the question is on the credibility and not on the number of witnesses. Whitney *v.* Emmett, *Baldw.* 303, 310.

The fact that the maker of the alleged prior machine is not examined, where priority is attempted to be proved, though present, is a circumstance to be considered in weighing other testimony as to the existence and character of the machine. Wood *v.* Cleveland Rolling Mill Co., 4 *Fish. Pat. Cas.* 550.

293. *Experts.*

Where a patent is attempted to be invalidated by a prior patent, it is proper to take the testimony of experts as to the diversity in the inventions, and submit the evidence to the jury with proper instructions, leaving them to determine the question of identity. The court cannot be required to compare the two specifications, and to instruct a jury, as matter of law, whether the inventions are or are not identical. Bischoff *v.* Wethered, 9 *Wall.* 812.

Experts may be examined to explain, if necessary, models and drawings. Winans *v.* New York & Erie R. R. Co., 21 *How.* 88, 100.

The opinions of skillful persons, whether the principles of two machines are the same, are competent evidence to be introduced in a patent cause. Barrett *v.* Hall, 1 *Mas.* 447, 470; Blanchard *v.* Beers, 2 *Blatchf.* 411; Parker *v.* Stiles, 5 *McLean*, 44, 64; 7 *West. L. J.* 168.

The patent law contemplates two classes of persons as appropriate witnesses in patent cases.

1. Artisans, engaged in the trade, employment, or business of

the particular branch of mechanics to which the patent right applies, as to whether the specification sufficiently described the invention so that it could be constructed and used.

2. Persons who, although not practical artisans, are thoroughly conversant with the subject of mechanics as a science, as to the questions of novelty of invention, or identity or diversity of mechanical apparatus, and contrivances, and equivalents. Allen *v.* Blunt, 3 *Story*, 742, 747 ; 8 *L. Rep'r*, 165. S. P., Olcott *v.* Hawkins, 2 *Am. L. J. N. S.* 321.

The testimony of a chemist, who has analyzed the ingredients of a composition of matter, as to the nature of such composition, is not matter of opinion, but evidence of a fact demonstrated. Allen *v.* Hunter, 6 *McLean*, 303.

Where the opinions of experts are expressed in *ex parte* affidavits, and there is no opportunity for the court to ascertain in what sense important words are used, nor what facts they take in view, nor what standards of comparison they assume, the opinions are of very little value. Sargent *v.* Carter, 1 *Fish. Pat. Cas.* 277 ; 11 *L. Rep'r, N. S.* 651.

In a suit for infringement the testimony of a mechanical expert is to be tried by the tests applied to the evidence of other witnesses. May *v.* County of Fond du Lac, 27 *Fed. Rep'r*, 691.

Expert testimony is not essential to prove an alleged infringement of a patent. Hayes *v.* Bickelhoupt, 23 *Fed. Rep'r*, 183 ; 32 *Pat. Off. Gaz.* 133.

Experts assume the duty of the court when they undertake to tell what the patent is for, or what is or is not a violation of the patent. Waterbury Brass Co. *v.* New York & Brooklyn Brass Co., 3 *Fish. Pat. Cas.* 43.

294. *Evidence, with Reference to Particular Pleadings.*

Where, in an action to recover the consideration for an assignment of a patent, the declaration alleged that a certain improvement containing one principal and three minor improvements, all of which were included in a patent, which patent was reissued in four reissues, and that the original described all, and no more than the improvements specified in the four reissues, it was *held* that the reissues related back and were included within the assignment, and that the declaration was sufficient. Read *v.* Bowman, 2 *Wall.* 591.

In a suit for an infringement, letters patent granted earlier than those under which complainant claims, describing the same invention, may be read in evidence to disprove priority of his invention, notwithstanding such letters are not set up in the answer. Atlantic Works *v.* Brady, 107 *U. S.* 92 ; 2 *Sup. Ct. Rep'r*, 225.

Where a bill was filed for an injunction to restrain the running of a machine in violation of the plaintiff's rights, and the defendants justified under a license, which the complainant alleged had been abandoned, and no issue of abandonment was raised by the pleadings, it was *held*, that no evidence of abandonment could be received, and therefore, an injunction could not issue. Wilson *v.* Stolley, 4 *McLean*, 275 ; 4 *West. L. J.* 412.

The plaintiff is confined to giving evidence of infringements during the period which he specifies in his declaration. Eastman *v.* Bodfish, 1 *Story*, 528 ; 2 *Robb*, 72.

In a suit in equity to restrain an infringement, a prior patent not alleged in the answer is admissible as evidence of the state of the art at the date of the complainant's invention, only ; and not to show want of novelty in that invention. American Saddle Co. *v.* Hogg, 1 *Holmes*, 133 ; 6 *Fish. Pat. Cas.* 67.

In a suit for an infringement for a design, testimony as to the prior knowledge and use of the patented design by persons not named in the answer is incompetent. Collender *v.* Griffith, 11 *Blatchf.* 212 ; 3 *Pat. Off. Gaz.* 689.

Testimony offered by the defendants respecting a prior rejected application of a third person, the use of his invention, and his prior knowledge of the thing patented, is not admissible to show that the patentee was not the original inventor, unless these facts are set up in the answer. Union Paper Bag Machine Co. *v.* Pultz, &c. Co., 15 *Blatchf.* 160 ; 15 *Pat. Off. Gaz.* 423 ; 3 *Bann. & A. Pat. Cas.* 403.

Evidence of the manufacture and use of an article similar to that covered by the patent at the time of its issuance, was *held* proper, as tending to show what was in existence at the time, though knowledge had not been pleaded. Zane *v.* Loffe, 2 *Fed. Rep'r*, 229 ; 5 *Bann. & A. Pat. Cas.* 284.

XXI. MATTERS OF PRACTICE INCIDENTAL TO PATENT SUITS.

295. *Abatement of Suit.*

A suit in equity seeking relief against an infringement does not abate by the death of the plaintiff, but may be prosecuted to final judgment by his legal representative. Illinois Central R. R. Co. *v.* Turrill, 110 *U. S.* 301.

A bill in equity for an injunction and account of profits for an infringement does not abate by the death of the defendant, the infringer, but may be revived against his representatives. In the equity suit for an infringement, the complainant is allowed, instead of bringing action at law to recover damages, to sue the infringer as a trustee of the profits realized by him, and to enforce his accountability for them in that character; and this being the basis of the suit, the equitable liability of an infringer is clearly not determined by his death. The fact that the suit cannot be prosecuted against the representatives for the injunction, does not negative the right to revive the suit for the accounting; as the jurisdiction of the circuit courts to enforce an accounting in patent causes is not altogether dependent on the jurisdiction to enjoin. Smith *v.* Baker, 5 *Pat. Off. Gaz.* 496; 19 *Int. Rev. Rec.* 149; 10 *Phila.* 221; 1 *Bann. & A. Pat. Cas.* 117.

296. *Compulsory Disclosure*

It has been ruled that a defendant who both attacks the validity of the patent, and also denies that he is infringing it, cannot be compelled to disclose the name of customers to whom he has sold the articles said to infringe. Roberts *v.* Walley, 14 *Fed. Rep'r*, 167; 29 *Int. Rev. Rec.* 47; 26 *Pat. Off. Gaz.* 107; 15 *Rep'r*, 39.

On hearing of an application for an injunction against an infringement, the court may adjudge the patented article unpatentable and the patent void, from inspection, and without taking evidence. Everett *v.* Thatcher, 16 *Pat. Off. Gaz.* 1046. But it has been *held*, that exhibition of models of the machines of the

respective parties will not suffice to determine such applications; there must be an examination into the detail of the construction, combination and operation of all their parts, by competent mechanics. Cooper *v.* Matthews, 8 *L. Rep'r*, 413.

On a bill for an infringement, if the defendants refuse to allow the plaintiffs to examine the machines used by them, the court may order an inspection; or may order that the defendants run their machines in the presence of some expert, and that the expert may bring into court specimens of the work produced. Sloat *v.* Patten, 24 *Jour. Fr. Inst.* 3*rd S.* 23.

297. *Motions.*

Motion to allow a patent cause to be carried up to the supreme court, notwithstanding the amount of damages in controversy is less than the jurisdictional limit, ought not to be granted except in exercise of a sound discretion, and in cases where questions important and doubtful, and arising on the construction of the patent law itself, are involved. Allen *v.* Blunt, 2 *Woodb. & M.* 121, 155.

Decrees sustaining the validity of the patents involved were entered in certain suits, by consent of parties; but the fact that they were upon consent did not appear in the decrees. A stranger to the suits made a motion for leave to intervene, for the purpose of having these decrees vacated or modified; alleging, as a reason for requesting such relief, that the decrees were being used to support applications for injunctions pending against himself or his agents, in other circuits. It was *held*, that such motion must be denied. Matter of Iowa Barb Steel Wire Co., 5 *Bann. & A. Pat. Cas.* 279.

Application, in a suit for infringement, for leave to amend the answer, and for a rehearing, for the purpose of setting up a new defense of prior use, was denied; because there was nothing to show but that the facts constituting the new defense could have been discovered by the exercise of reasonable diligence before the hearing. Hicks *v.* Otto, 22 *Blatchf.* 122. To nearly the same effect, where the new defense was want of novelty, Lockwood *v.* Cleveland, 20 *Fed. Rep'r*, 164.

A motion to consolidate several bills in equity founded on different patents and pending against different persons, may be granted when all the mechanical devices alleged to be infringed are used

in one machine. Deering *v.* Winona Harvester Works, 24 *Fed. Rep'r*, 90 ; 32 *Pat. Off. Gaz.* 654.

A motion to stay proceedings upon an order for an accounting, will not be granted merely because the patent has, since the order was made, been declared void, by another court, if an appeal has been taken, and the facts in the two cases are not alike. Celluloid Manuf. Co. *v.* Comstock & Cheney Co., 27 *Fed. Rep'r*, 358.

298. *Trial.*

Whether an application for a patent claimed to be new, was really a continuance of a former one ; whether a machine embodied in a patent required or admitted of invention, whether a patent described and claimed a novel device, and whether important parts of defendant's machine are merely equivalents for corresponding parts of the patented one ; are questions of fact for the jury. Bevin *v.* East Hampton Co., 5 *Fish. Pat. Cas.* 23 ; 9 *Blatchf.* 50 ; Poppenhusen *v.* Falk, 5 *Blatchf.* 49 ; Bischoff *v.* Withired, 9 *Wall.* 812 ; May *v.* County of Fond du Lac, 27 *Fed. Rep'r*, 691.

Upon trial of an infringement suit before a jury, if, after the plaintiff's evidence is all in, the court is of opinion that it is insufficient in law to establish the infringement and warrant a judgment on the verdict if one should be rendered for the plaintiff, the court may direct a verdict for the defendant and discharge the jury. (Millner *v.* Schofield, 4 *Hughes*, 258) ; but the defect of evidence must be undoubted. Klein *v.* Russell, 19 *Wall.* 433.

On a motion for a new trial after verdict for plaintiff, in an action for infringement, he may in a proper case have leave to retain his verdict on consenting to a remission of damages. Russell *v.* Place, 9 *Blatchf.* 173 ; Conway *v.* Rumsey, 4 *Fish. Pat. Cas.* 275.

299. *Hearing, and Rehearing.*

If complainant's patent is seen to be void because the device or contrivance described is not patentable, the court at the hearing should dismiss the cause on that ground, whether defendant raises the objection or not. Slawson *v.* Grand St. R. Co., 107 *U. S.* 649.

A decree for an injunction against the infringement of a patent and for an accounting is interlocutory, and a rehearing may be

ordered before the report of the master and final decree thereon. Reeves *v.* Keystone Bridge Co., 2 *Week. N. of Cas.* 523.

Applications for rehearing have been denied, in cases where the reasons assigned were: Newly-discovered evidence to establish anticipation, Kerosene Lamp Co. *v.* Littell, 2 *N. J. L. J.* 150; Newly-discovered evidence to establish prior use, Hicks *v.* Ferdinand, 20 *Fed. Rep'r*, 111; Because defendant did not have proper expert testimony on the original hearing, Hitchcock *v.* Tremaine, 9 *Blatchf.* 550; 4 *Fish. Pat. Cas.* 508.

A petition by the defendant for a rehearing because of newly-discovered evidence in a suit for infringement, should ask leave to file a supplemental bill to bring in the new evidence, and that when the proofs are made thereunder, the cause may be reheard. Hitchcock *v.* Tremaine, *supra.*

Rehearing, in a suit for infringement of patent, was granted to allow further proofs that claims in the patent had been rejected upon a previous application by the same inventor for a patent, and such rejection acquiesced in and right of appeal waived by him. Railway Register Manuf. Co. *v.* Broadway & Seventh Ave. R. R. Co., 32 *Pat. Off. Gaz.* 257.

A motion for a rehearing was granted on the condition, that in case there should be the same decree rendered, the testimony already taken upon an accounting by the master should stand for use in the case as if taken by the parties respectively upon such new accounting. American Diamond Rock Boring Co. *v.* Sheldons, 24 *Fed. Rep'r*, 374; 32 *Pat. Off. Gaz.* 1240. And see S. C., 25 *Fed. Rep'r*, 768; 33 *Pat. Off. Gaz.* 1598.

Application by the defendant for a re-argument of a suit for infringement of a patent, was denied, upon the same evidence,—the only ground stated being that one of the defenses was not fully presented at the argument. Railway Register Manuf. Co. *v.* North Hudson County R. Co., 26 *Fed. Rep'r*, 411.

300. *Jury Trial in Equity.*

Allowance of a jury to settle the question of infringement arising in a suit in equity, is not matter of right, but rests in discretion; it is granted when the equity judge entertains reasonable doubts and wishes the aid of a jury Brooks *v.* Norcross, 2 *Fish. Pat. Cas.* 361.

The differences of witnesses as to the fact of infringement, should be submitted to a jury, either by action at law, or by an issue directed by the court. Brooks *v.* Bicknell, 3 *McLean*, 250; 1 *West. L. J.* 150.

On the trial of a feigned issue the patent is not admissible, if it has no tendency to support the issue. Where the feigned issues presented no issue of fraud or mistake, and the bill of complaint was founded exclusively upon the reissued letters patent, it was *held*, that the original letters patent, if objected to, were not admissible on the trial. Caboon *v.* Ring, 1 *Cliff.* 592.

A court of equity is not bound to try by a jury, the issue, as to whether a reissue is for the same invention as the original, although the fact that there is considerable doubt may be a reason for so doing. Poppenhusen *v.* Falke, 4 *Blatchf.* 493; 2 *Fish. Pat. Cas.* 181.

The act of February 16, 1875, provides:

That said courts, [circuit courts] when sitting in equity for the trial of patent causes, may impanel a jury of not less than five and not more than twelve persons, subject to such general rules in the premises as may, from time to time, be made by the Supreme Court, and submit to them such questions of fact arising in such cause as such circuit court shall deem expedient.

And the verdict of such jury shall be treated and proceeded upon in the same manner and with the same effect as in the case of issues sent from chancery to a court of law and returned with such findings. Act of Feb. 16, 1875, c. 77, § 2; 1 *Supp. to Rev. Stat.* 136.

The above enactment does not affect the established rules of equity practice governing the effect of the verdict on a feigned issue and the mode of seeking a review. Watt *v.* Starke, 101 *U. S.* 247.

301. *Reference to Ascertain Damages or Profits.*

Where infringement to any extent is admitted, and the patent held to be valid, the proper practice is, to enter an interlocutory decree for complainant and send the cause to a master to ascertain the amount the complainant is entitled to recover. Carew *v.* Boston Elastic Fabric Co., 3 *Cliff.* 356; 1 *Pat. Off. Gaz.* 91; 5 *Fish. Pat. Cas.* 90; Jackson *v.* Breck, 11 *Pat. Off. Gaz.* 112.

The defendants, adjudged infringers, must go forward in the accounting ordered, and pay the master's fees. Urner *v.* Kayton, 17 *Fed. Rep'r*, 539; 24 *Pat. Off. Gaz.* 1178; 16 *Rep'r*, 225. To the contrary, as to payment of fees, MacDonald *v.* Shepard, 10 *Fed. Rep'r*, 919.

The amount of profits or damages to be allowed in a suit for infringement is matter of fact calling for proof, and if affirmative proof is not made, a master's report of a substantial sum, founded on conjecture, must be disallowed on proper exceptions filed; and a decree entered for nominal damages only. Ingersoll *v.* Musgrove, 13 *Pat. Off. Gaz.* 966; 14 *Blatchf.* 541; 3 *Bann. & A. Pat. Cas.* 304.

The master should simply examine and decide as to the extent of the infringement as to the particular machine used by the defendants; and should not enter into the general question of infringement, nor consider the general scope and extent of the patent. Turrill *v.* Illinois Central R. R. Co., 5 *Biss.* 344.

The master may take the account down to the time of the hearing before him, if the infringement continues to that period. Tatham *v.* Lowber, 4 *Blatchf.* 86. S. P., Knox *v.* Great Western Quicksilver Min. Co., 14 *Pat. Off. Gaz.* 897; 7 *Rep'r*, 325; 4 *Bann. & A. Pat. Cas.* 25; 6 *Sawyer*, 430.

The defendants, having been adjudged infringers of a patent for a process, claimed on the accounting, to have so altered their apparatus that its use thereafter no longer infringed the patent; and exhibited to the master such portions of it as were not in use, but, though requested, refused to exhibit the portions that were in use. It was *held*, that the master was justified in finding that the defendants still infringed the patent. Piper *v.* Brown, 1 *Holmes*, 196; 6 *Fish. Pat. Cas.* 240.

Masters charged with the duty of computing and reporting the profits of respondents in infringement suits may examine the res-

pondents, and, if necessary, inspect their books; but it is incumbent upon the complainant to furnish whatever additional proof may be necessary to enable the master to make the proper computation. Brady *v.* Atlantic Works, 15 *Pat. Off. Gaz.* 965; 3 *Bann. & A. Pat. Cas.* 577. Compare Fisher *v.* Shaughnessy, 15 *Rep'r*, 613.

A subpœna *duces tecum* may be issued. Its proper form. Turrell *v.* Speath, 8 *Pat. Off. Gaz.* 986; 2 *Bann. & A. Pat. Cas.* 185; Right of defendant to demand production of plaintiff's books, in connection with cross-examining him. Wisner *v.* Dodd, 14 *Fed. Rep'r*, 655.

The evidence adduced upon an accounting for profits made by the use of a patented bond and coupon register was *held* insufficient to sustain the master's report on an arbitrary estimate based on comparison with a different system, and not tending to show the profits actually derived by the defendants from their use of the patented system as they used it. Munson *v.* New York, 21 *Blatchf.* 342.

302. *Costs.*

A verdict for nominal damages only, for infringement, under the act of 1836, carried costs. Merchant *v.* Lewis, 1 *Bond*, 172. Under the Revised Statutes, assessment of costs in such cases depends on the circumstances. Calkins *v.* Bernard, 8 *Fed. Rep'r*, 755; 10 *Biss.* 445.

On the taking of an account of profits, the plaintiff exaggerated his claim, introduced irrelevant evidence, and recovered only a small sum. It was *held*, that neither party should recover, against the other, any costs or expenses that accrued before the master, embracing the fees of witnesses, the taking and printing of the evidence, and all disbursements before him, but each party should bear his own. Troy Iron, &c. Factory *v.* Corning, 6 *Fish. Pat. Cas.* 85; 10 *Blatchf.* 223.

Where the complainants united in their bill two causes of action on different patents, and by the allegation that the defendants infringed both, compelled them to litigate both, and as to one of these causes of action the defendants prevailed, it was *held*, that neither party should recover costs as against the other. Adams *v.* Howard, 19 *Fed. Rep'r*, 317; 22 *Blatchf.* 47; 26 *Pat. Off. Gaz.* 825.

Costs of taking testimony, to be used in two suits between the same parties for infringement, should be equally divided between the suits. Thayer *v.* Hart, 30 *Pat. Off. Gaz.* 776.

In an action for infringement, the expense of obtaining a model of the infringing machine, is not taxable as a disbursement by the plaintiff. Corneldy *v.* Markwald, 24 *Fed. Rep'r*, 187.

Where the defendants have in good faith obtained models of the devices shown in plaintiff's patent, they may be taxed as costs. Woodruff *v.* Barney, 1 *Bond*, 528. So also such models as are copies of models deposited in the patent-office, and procured for use as a part of the evidence, may be taxed. Hussey *v.* Bradley, 5 *Blatchf.* 210. But see Parker *v.* Bigler, 1 *Fish. Pat. Cas.* 285. Where the plaintiff obtains a decree for nominal damages only, but the defendant persistently contests the validity of the patent, and the question of infringement, as well as the amount of damages, the court will award all costs against the defendant. Calkins *v.* Bertrand, 10 *Bissell*, 445.

303. *Costs, as Affected by Disclaimer.*

When judgment or decree is rendered for the plaintiff or complainant, in any suit at law or in equity, for the infringement of a part of a patent, in which it appears that the patentee, in his specification, claimed to be the original and first inventor or discoverer of any material or substantial part of the thing patented, of which he was not the original and first inventor, no costs shall be recovered, unless the proper disclaimer, as provided by the patent laws, has been entered at the patent-office before the suit was brought. *Rev. Stat.* § 973.

Rev. Stat. §§ 4917, 4922, see *ante*, 206, 207, permit the filing of disclaimers; and section 4922, see *infra*, contains the following proviso:

But in every such case in which a judgment or decree shall be rendered for the plaintiff no costs shall be recovered unless the proper disclaimer has been entered at the patent-office before the commencement of the suit.

For the nature and uses of disclaimers, their effect, and the effect of neglect or delay in filing, see *ante*, pp. 207–211.

Under act of 1837, section 9, the fact that after verdict the plaintiff had disclaimed one of several claims in the patent, did not

necessarily deprive him of costs. Peck *v.* Frame, 5 *Fish. Pat. Cas.* 211. But under Rev. Stat. 4922, where a patent containing two claims was, as to one claim, held invalid, and as to the other sustained ; the court *held* that complainant was not entitled to costs Stewart *v.* Mahoney, 5 *Fed. Rep'r*, 360 ; 4 *Bann. & A. Pat. Cas.* 84.

But this provision does not mean that claims not in issue shoul be contested for the mere purpose of settling the costs. American Bell Telephone Co. *v.* Spencer, 8 *Fed. Rep'r*, 509 ; 20 *Pat. Off. Gaz.* 299.

And it applies only to patentees claiming without original right, not to those whose claims have been abandoned by laches in applying for a reissue. Mundy *v.* Lidgerwood Manuf. Co., 20 *Fed. Rep'r*, 191.

Costs should not be allowed to a complainant in a suit for infringement, who prevails only on account of a disclaimer filed after suit brought, and fails as to a large part of his case. Hayes *v.* Bickelhoupt, 23 *Fed. Rep'r*, 183 ; 32 *Pat. Off. Gaz.* 133.

304. *Decrees.*

In a suit for infringement of two patents, after the testimony as to one of them was closed, and the cause set down for hearing, an application for leave to discontinue so much of the bill as related to that patent, was made by the plaintiffs. It was *held* that the decree upon granting such leave should contain the condition that the evidence taken by the defendants in relation to the patent might be stipulated into any future suit upon the same patent by the plaintiffs against the defendants. Brush *v.* Condit, 22 *Blatchf.* 246 ; 20 *Fed. Rep'r*, 826 ; 28 *Pat. Off. Gaz.* 451.

In an interlocutory decree in a suit for infringement of a patent, awarding profits and damages, and directing a reference to a deputy clerk of the court to take an account of profits, and to assess the damages, no special reason for the appointment of such clerk as referee was assigned, as is required by the act of March 3, 1879 (20 Stat. 415.) It was *held* not a ground for setting aside his report, where the appointment was made upon the assent in open court of solicitors for both parties, and they had proceeded before him for several months with knowledge that he was such deputy clerk ; and the decree amended to recite such facts as special reason

for the appointment. Fischer *v.* Hayes, 22 *Blatchf.* 505 ; 22 *Fed. Rep'r*, 92.

The fact, that, upon a decree dismissing, with costs, a bill for infringement of patents, execution for the costs has been issued and returned unsatisfied, is not ground for the appointment of a receiver of the patents as equitable assets, to be disposed of for the satisfying of the decree. Thayer *v.* Hart, 24 *Fed. Rep'r*, 558.

When the decree is interlocutory and not final, the court has power to open the same and allow a new defense, on motion, and without the formality of a bill of review ; but when the application is in fact and substance for a rehearing on newly discovered evidence, it must be supported by the same sort of proof as is required in order to give a party relief upon a bill of review, or a supplemental bill, after a final decree. Application denied as it did not show that the newly discovered evidence could not, with reasonable diligence, have been discovered. Willimantic Linen Co. *v.* Clark Thread Co., 24 *Fed. Rep'r*, 799 ; 32 *Pat. Off. Gaz.* 1356.

An interlocutory decree in a suit for infringement of a patent, entered *pro confesso*, which finds the patent valid, but leaves open the questions of profits, damages and costs, and orders a reference to take an account, is not conclusive upon the defendant as to the validity of the patent in a suit between the same parties for subsequent infringements ; even where an agreement was entered into between them, whereby the complainant waived damages, profits and costs, so that he might have had the interlocutory decree made final. Roemer *v.* Neumann, 26 *Fed. Rep'r*, 332.

XXII. CASES OF SPECIFICATION TOO BROAD; OR PRIOR FOREIGN INVENTION.

305. *Suit for Infringement Where Specification is too Broad.*

Whenever, through inadvertence, accident, or mistake, and without any willful default or intent to defraud or mislead the public, a patentee has, in his specification, claimed

to be the original and first inventor or discoverer of any material or substantial part of the thing patented, of which he was not the original and first inventor or discoverer, every such patentee, his executors, administrators, and assigns, whether of the whole or any sectional interest in the patent, may maintain a suit at law or in equity, for the infringement of any part thereof, which was bona fide his own, if it is a material and substantial part of the thing patented, and definitely distinguishable from the parts claimed without right, notwithstanding the specifications may embrace more than that of which the patentee was the first inventor or discoverer. But in every such case in which a judgment or decree shall be rendered for the plaintiff no costs shall be recovered unless the proper disclaimer has been entered at the patent-office before the commencement of the suit. But no patentee shall be entitled to the benefits of this section if he has unreasonably neglected or delayed to enter a disclaimer. *Rev. Stat.* § 4922

For the nature and uses of disclaimers, their effect, and the consequences of neglect or delay in filing, see *ante*, pp. 207–211. As to costs as affected by disclaimer, see *ante*, p. 478.

306. *Patent not Void on Account of Previous Use in Foreign Country.*

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 or used in a foreign country, before his invention or discovery thereof, if it had not been patented or described in a printed publication. *Rev. Stat.* § 4923.

The use of copies of certified copies of foreign letters-patent is provided for by *Rev. Stat.* § 893, *ante*, p. 27. The subjection of United States patents to foreign patents for the same invention is governed by *Rev. Stat.* § 4887, *ante*, p. 63. In addition to the cases on that subject there cited, the following should be mentioned: Time when a United States patent would expire, as governed by the date of an English patent, in a particular case, determined, see Weston *v.* White, 13 *Blatchf.* 364; 9 *Pat. Off. Gaz.* 1196; 2 *Bann. & A. Pat. Cas.* 321. The life of a foreign patent limits that of an American patent for the same invention, Globe Nail Co. *v.* Superior Nail Co., 27 *Fed. Rep'r*, 450; provided the foreign patent is valid, Bate Refrigerator Co. *v.* Gillett, 20 *Id.* 192.

It is only a patent for an invention which has been *previously* actually patented in a foreign country that is limited by the foreign patent. Holmes Electric Protective Co. *v.* Metropolitan Burglar Alarm Co., 22 *Fed. Rep'r*, 341; 32 *Pat. Off. Gaz.* 384.

As to the question of identity between the invention described in the foreign patent and the U. S. patent, it was *held*, that the inventor was not estopped from showing a lack of identity, by reason of having represented their identity to be a fact in his application for a U. S. patent, when he labored under a mistake as to this point. Commercial Manuf. Co. *v.* Fairbanks Canning Co., 27 *Fed. Rep'r*, 78.

A fair test of identity is to inquire whether the invention described in the U. S. patent will infringe the invention described in the foreign patent. *Ib.*

An error in designating the date from which the patent for an invention which has been patented in a foreign country is to begin to run, may be corrected by a reissue. Buerk *v.* Valentine, 5 *Fish. Pat. Cas.* 366; 9 *Blatchf.* 479; 2 *Pat. Off. Gaz.* 295.

A capacity of being prolonged so as to have a duration of fifteen years is not equivalent to having a term of fifteen years, when the patent is granted for one year, and then prolonged so as to expire at the end of ten years. Gramme Electrical Co. *v.* Hochhausen Electric Co., 17 *Fed. Rep'r*, 838; 25 *Pat. Off. Gaz.* 193. But see Holmes Electrical Protective Co. *v.* Metropolitan Burglar Alarm Co., 28 *Pat. Off. Gaz.* 1189.

Section 4887, is not to be construed as requiring the limitation to be expressed upon the face of the patent, but merely as controlling the effect or duration of the grant. Canan *v.* Pound Manuf. Co., 31 *Pat. Off. Gaz.* 119.

XXIII. EXTENSIONS.

307. *The former Law Granting and Regulating Extensions of Patents.*

The five sections of the Revised Statutes relating to extensions, viz. §§ 4924 to 4928 inclusive, and numerous decisions to which they gave rise, are omitted, for the reason that the authority for granting extensions by the commissioner, has long been abrogated. The commissioner cannot by the existing law entertain an application to extend a patent, and all extensions heretofore granted have expired. See *ante*, p. 4. Congress can, however, grant an extension of a particular patent (see *ante*, p. 2), and may condition such a grant upon the results of an inquiry to be made before the commissioner. The rules of the patent-office prescribe the manner of conducting such an inquiry. See *Rules of Prac.* Nos. 172–186.

XXIV. PATENTS FOR DESIGNS.

308. *Patents for Designs authorized.*

Any person who, by his own industry, genius, efforts, and expense, has invented and produced any new and original design for a manufacture, bust, statue, alto-relievo, or bas-relief; any new and original design for the printing of woolen, silk, cotton, or other fabrics; any new and original impression, ornament, patent, print, or picture to be printed, painted, cast, or otherwise placed on or worked into any article of manufacture; or any new, useful, and original shape or configuration of any article of manufacture, the same not having been known or used by others before his invention or production thereof, or patented or described in any printed publication, may, upon

payment of the fee prescribed, and other due proceedings had the same as in cases of inventions or discoveries, obtain a patent therefor. *Rev. Stat.* § 4929.

309. *Practice in the Patent Office, as to design patents.*

A patent for a design may be granted to any person, whether citizen or alien, in the cases specified in Rule 24, upon payment of the duty required by law, and other proceedings had, as in other cases of inventions or discoveries. *Rules of Prac.* No. 78.

Patents for designs are granted for the term of three and one-half years, or for seven years, or for fourteen years, as the applicant may, in his application, elect. *Id.* 79.

The proceedings in the applications for patents for designs are substantially the same as in applications for other patents. The specification must distinctly point out the characteristic features of the design, and carefully distinguish between what is old and what is believed to be new. The claims also, when the design admits of it, should be as distinct and specific as in the case of other patents. The following order of arrangement should be observed, when convenient, in framing the specification.

1. Preamble showing name and residence of the applicant, title of the design, and the name of the article for which the design has been invented.

2. Detailed description of the design as it appears in the drawing or photograph, letters or figures of reference being used.

3. Claim or claims.

4. Signature of inventor.

5. Signatures of two witnesses.

When the design can be sufficiently represented by drawings or photographs, a model will not be required. *Id.* No. 81.

Whenever a photograph or an engraving is employed to illustrate the design, it must be mounted upon Bristol board, 10 by 15 inches in size, and properly signed and witnessed. The applicant will be required to furnish ten extra copies of such photograph or engraving (not mounted), of a size not exceeding 7½ inches by 11. Negatives are not required. *Id.* No. 82.

Whenever the design is represented by a drawing made to conform to the rules laid down for drawings of mechanical inventions, but one copy need be furnished. Additional copies will be sup-

plied by the photolithographic process at the expense of the patent-office. *Id.* No. 38.

(Forms to be used in applications for design patents, are given in appendix to the Rules, Forms 9 and 15.)

310. *What Designs are Patentable.*

The patent allowed by the law authorizing design patents (formerly act of March 2, 1861, § 11, now *Rev. Stat.* § 4929), is simply for the design itself, not for the means of producing the design. Clark *v.* Bousfield, 10 *Wall.* 133.

The law authorizing patents for designs contemplates its appearance rather than utility; and that, not an abstract impression, or picture, but an aspect given to one of the objects mentioned in the acts. The thing for which a patent is granted is that which gives a peculiar or distinctive appearance to the manufacture, or article to which it may be applied, or to which it gives form; not the mode in which those appearances are produced, but the appearance itself. It is the appearance, no matter how caused, that is the patentable element. Gorham Co. *v.* White, 14 *Wall.* 511.

If a new idea is embodied in the method of arrangement, a design patent is not defeated merely because scrolls and ornamentation similar in effect to the scrolls and ornamentation described in the patent have before been employed. The statute permits a patent for any new, useful, and original shape or configuration of any manufacture; and where these conditions are complied with, the invention is patentable. Simpson *v.* Davis, 12 *Fed. Rep'r*, 144; 20 *Blatchf.* 413.

Design patents stand on as high a plane as utility patents, and require as high a degree of exercise of the inventive or originative faculty; a person cannot be permitted to select an existing form, and to claim a patent merely for putting it to a new use, any more than he can be permitted to patent a double use of a machine; but the selection and adaptation of an existing form may amount to patentable design, just as the adaptation of an existing mechanical device may amount to patentable invention. Western Electric Manuf. Co. *v.* Odell, 18 *Fed. Rep'r*, 321.

Although a drawing or casting or pattern of a letter of the alphabet is not, alone, patentable as a new design, the requisite novelty and usefulness may exist in a combination for some pur-

pose, with something else; as the shape or configuration of the Roman letter G., for a sewing machine, to which configuration the working machinery of the sewing.machine is to be applied. Gibbs *v.* Ellithorp, 1 *MacArthur Pat. Cas.* 702.

To show that a design lacked novelty when patented, it is proper to introduce specimens of it as made before complainant's invention. Theberath *v.* Rubber & Celluloid Harness Trimming Co., 15 *Fed. Rep'r*, 246; 6 *N. J. L. J.* 77; 23 *Pat. Off. Gaz.* 1121.

Mechanical and design patents, distinguished. See Cone *v.* Morgan Envelope Co., 4 *Bann. & A. Pat. Cas.* 107.

A beautiful appearance or color which is the mere result of the common efforts of persons ordinarily skilled in a particular art, such as workers in enamel, is not such a design as may be patented; the law requires that it should be new and original, and the result of invention and genius. Matter of Niedringhaus, 2 *MacArthur*, 149.

The law does not require utility in a design in order to sustain a patent, but it does require that the shape or design shall be the result of industry, effort, genius, or expenditure; the shape or configuration sought to be secured must be new and original, as applied to articles of manufacture. When a well known form was given to a new device, and no advantage whatever was derived from the adoption of such form, except the incidental one of a trade-mark, and the selection was but an arbitrary, chance selection of one of many well known shapes, all equally adapted to the purpose, it was *held*, that the patent could not be sustained. Wooster *v.* Crane, 5 *Blatchf.* 282; 2 *Fish. Pat. Cas.* 583.

A design for a card holding buttons arranged in rows, upon spaces marked on the cards, is not "new and useful" in such sense as to be patentable under the law authorizing design patents; such cards have long been in use. Pratt *v.* Rosenfeld, 3 *Fed. Rep'r*, 335; 18 *Blatchf.* 231; 19 *Rep'r*, 328; 21 *Pat. Off. Gaz.* 866.

An improvement in spelling-blocks, consisting in the placing of two or more letters on each block, is not patentable, although the inventor was the first one to place the letters systematically, with a view to enlarge the usefulness of the blocks. Hill *v.* Houghton, 6 *Pat. Off. Gaz.* 3; 1 *Bann. & A. Pat. Cas.* 291.

Modifying the form of sieves by "flaring," so that a number may be "nested," is not new, and therefore is not patentable, even if the idea were a patentable design. Adams & Westlake Manuf. Co. *v.* St. Louis Wire Goods Co., 3 *Bann. & A. Pat. Cas.* 77.

The mere substitution of one material for another, in the construction or for the purposes of an ornament, the ornament to be "of any approved form," cannot properly be patentable. Thus a design described as "a curtain and loop, consisting of an ornamental metallic chain, in connection with a curtain adapted to be gathered to the side of the window, and be held by said chain;" the claim covering merely the substitution for the old loop, composed of silk or woolen, of one made of metal, no new form or shape being given to the curtain or to the loop, is not patentable as a design, even if such a change can properly be called a design. Post *v.* Richards Hardware Co., 26 *Fed. Rep'r*, 618. See Post *v.* Richards Hardware Co., 25 *Fed. Rep'r*, 905; Theberath *v.* Rubber & Celluloid Harness Trimming Co., 3 *Fed. Rep'r*, 151; 5 *Bann. & A. Pat. Cas.* 584.

311. *Validity of Design Patents.*

The patent is *prima facie* evidence of both the novelty and utility of the design. Lehnbetter *v.* Holthaus, 105 *U. S.* 94; 21 *Pat. Off. Gaz.* 1788.

Where a bill founded on a design patent with a claim for a pattern, and separate claims for each of its parts, is taken as confessed, it alleging infringement of the "invention," the patent will be held valid for the purposes of the suit. Dobson *v.* Hartford Carpet Co., 114 *U. S.* 439.

A claim of "the design for a carpet, substantially as shown," refers to the description and the drawing, and is valid. *Ib.*

A claim to "the configuration of the design," is a claim to the design, figure, or pattern. Dobson *v.* Dorman, 35 *Pat. Off. Gaz.* 750; 6 *Sup. Ct. Rep'r*, 946.

To constitute a valid patent it is not necessary that the "inventor" (of a design) should personally have the manual skill and dexterity to make the drafts; if the ideas are furnished by him, he may avail himself of the mechanical skill of others to carry them out. Sparkman *v.* Higgins, 1 *Blatchf.* 205; 5 *N. Y. Leg. Obs.* 122.

A preliminary injunction may be granted in a proper case, although there has not been a decision at law sustaining the validity of the patent, nor any long continued public acquiescence. *So held*, in a case of a design patent, but on grounds applicable to cases of mechanical patents. Foster *v.* Crossin, 23 *Fed. Rep'r*, 400.

The claim in a patent for a design for figured silk buttons, was

for the radially formed ornaments on the face of the mould of the button, combined with the mode of winding the covering of the same. The specification described the configuration of the mould and the winding it with various colored threads, but did not describe the process of winding the silk. It was *held*, that the claim did not cover that process, but was for the arrangement of the different colored threads in such manner as to produce the ornaments as described. Booth *v.* Garelly, 1 *Blatchf.* 247; 6 *N. Y. Leg. Obs.* 99.

An inventor of a design for buttons manufactured such buttons, and put them upon the market two or three months before he applied for a patent for the design. It was *held*, that the question whether his doing so was an abandonment of his design, was a question of intention, to be determined as a question of fact, on a trial at law; and that a preliminary injunction might well be withheld until such trial should be had. *Ib.*

Billiard tables with beveled ends are old; hence a design for a billiard table, having a greater bevel than has heretofore been used, is void, as not involving any sufficient invention or discovery. Collender *v.* Griffith, 11 *Blatchf.* 212; 3 *Pat. Off. Gaz.* 630. See Collender *v.* Griffith, 18 *Blatchf.* 110.

A combination or aggregation of old designs producing no new appearance, is not patentable; thus a design patent for a rectangular provision-safe, was held invalid, the only originality consisting in the use of two vertical panels in each wall, and a familiar moulding around the top and bottom. Northrup *v.* Adams, 12 *Pat. Off. Gaz.* 430; 2 *Bann. & A. Pat. Cas.* 567.

A design patent is valid when the specification and claim refer for the entire description of the design to a photographic illustration accompanying the specification. Dobson *v.* Dorman, 35 *Pat. Off. Gaz.* 750; 6 *Sup. Ct. Rep'r*, 946.

But where the prominent claim in a design patent is necessarily for figures in relief, a photograph of the design, since it does not show the relief, fails to sufficiently describe the design, in the absence of a minute description in the specification. Untermeyer *v.* Jeannot, 20 *Fed. Rep'r*, 503.

Regulations and provisions applicable to the obtaining or prohibition of patents for inventions or discoveries, not inconsistent with the existing patent act, apply to patents for designs without modification or variation. Miller *v.* Smith, 5 *Fed. Rep'r*, 359; 18 *Pat. Off. Gaz.* 1047.

Design patents, as well as mechanical patents, are avoided by

having been in public use or on sale for more than two years prior to the application. Theberath *v.* Rubber & Celluloid Harness, &c. Co., 6 *N. J. L. J.* 77 ; 15 *Fed. Rep'r*, 246.

312. *Infringement of Design Patents.*

It is not essential to constitute infringement, that the appearance of the imitation should be the same as that of the genuine, to the eye of an expert. The test of a patent for a design is the eye of an ordinary observer. If, to an ordinary observer, giving such attention as a purchaser usually gives, two designs are substantially the same, if the resemblance is such that the imitation would deceive such an observer, inducing him to purchase one supposing it to be the other, the one first patented is infringed by the other. Gorham Manuf. Co. *v.* White, 14 *Wall.* 511 ; reversing 7 *Blatchf.* 513; Miller *v.* Smith, 5 *Fed. Rep'r*, 359 ; 18 *Pat. Off. Gaz.* 1047 ; Dryfoos *v.* Friedman, 18 *Fed. Rep'r*, 824 ; 21 *Blatchf.* 563 ; Jennings *v.* Kibbe, 10 *Fed. Rep'r*, 669 ; 22 *Pat. Off. Gaz.* 331 ; 20 *Blatchf.* 353 ; Wood *v.* Dolby, 7 *Fed. Rep'r*, 475 ; Dreyfus *v.* Schneider, 25 *Fed. Rep'r*, 481. In a proper case the court may determine this question of identity by an inspection of the two designs. Jennings *v.* Kibbe, *supra.*

A patent for a design which covers the ornamentation shown in it, is not infringed by the use of the principal figure without the ornamentation. Collender *v.* Griffith, 11 *Blatchf.* 212 ; 3 *Pat. Off. Gaz.* 689.

It is an infringement where the difference between the two designs is not appreciable by observing their artistic effect, such differences being merely in detail. Wood *v.* Dolby, 7 *Fed. Rep'r*, 475.

It is an infringement to adopt the design so as to produce substantially the same appearance ; adoption of the design in every particular is not necessary. Root *v.* Ball, 4 *McLean*, 177.

Infringement of a design patent may exist notwithstanding the fact that the alleged infringing article is made to carry a distinguishing name or distinguishing marks of other character. Perry *v.* Starrett, 14 *Pat. Off. Gaz.* 599 ; 3 *Bann. & A. Pat. Cas.* 485.

There may be an infringement of a design without taking the whole of it ; but in such cases the part taken must be a part covered by the patent. Dryfoos *v.* Friedman, 18 *Fed. Rep'r*, 824 ; 21 *Blatchf.* 563.

To constitute an infringement of a patent for a design, there is no necessity that the patented design should be copied in every particular. If the infringing design has the same general appearance, if to the eye of an ordinary person the two are substantially similar there is actionable infringement. Tomkinson *v.* Willets Manuf. Co., 23 *Fed. Rep'r*, 895; 31 *Pat. Off. Gaz.* 918.

A patent for a design for a fringed lace fabric, the novelty of which appertains to the fringe alone, is not infringed by articles similar to the body of the fabric, but differing as to the fringe. Jennings *v.* Kibbe, 24 *Fed. Rep'r*, 697; 32 *Pat. Off. Gaz.* 653.

313. *Damages or Profits for Such Infringement.*

To warrant an award of more than nominal damages for an infringement of a design, plaintiff must introduce some evidence either of what sum he lost or defendant realized, by the infringement, or of what value was added to the manufactured article by the design; the award of damages or profits in patent cases is a subject of proof, not of mere inference or conjecture. Dobson *v.* Hartford Carpet Co., 114 *U. S.* 439.

In a suit for infringement of a patent for a design, the remainder of the price realized by defendant from the sale of articles of the patented design, after deducting the cost of making them, and a fair profit for their manufacture, may be presumed to represent the profit realized by the defendant from his adoption of the design; and this presumption is not dispelled by proving that defendant realized the same profit from adopting, in the manufacture of similar articles, a different and unpatented design. Simpson *v.* Davis, 22 *Blatchf.* 113; 22 *Fed. Rep'r*, 444.

Damages for infringement of design patents are to be computed on the same principle as in the case of machine patents; they cannot include the entire profits of the manufacture, but must be confined to the profits which arise from the use of the particular design. Dobson *v.* Dorman, 35 *Pat. Off. Gaz.* 750; 6 *Sup. Ct. Rep'r*, 946; following Dobson *v.* Hartford Carpet Co., *supra.*

In a suit for infringement of a design for carpets, the evidence showed the quantity of complainant's carpet sold during the season of its introduction, its cost, the profit upon it, the quantity of respondent's carpet sold during the next season, and that there was then a decline in complainant's sales. The measure of damages was *held* to be the profits which would have accrued to complain-

ants on the quantity of carpet sold by defendant. Bigelow Carpet Co. *v.* Dobson, 10 *Fed. Rep'r*, 385 ; 13 *Rep'r*, 265.

314. *Additional Provisions as to Design Patents. Models of Designs.*

The commissioner may dispense with models of designs when the design can be sufficiently represented by drawings or photographs. *Rev. Stat.* § 4930

315. *Duration of Patents for Designs.*

Patents for designs may be granted for the term of three years and six months, or for seven years, or for fourteen years, as the applicant may, in his application, elect. *Rev. Stat.* § 4931.

316. *Extension of Patents for Designs*

Patentees of designs issued prior to the second day of March, eighteen hundred and sixty-one, shall be entitled to extension of their respective patents for the term of seven years, in the same manner and under the same restrictions as are provided for the extension of patents for inventions or discoveries, issued prior to the second day of March, eighteen hundred and sixty one. *Rev. Stat.* § 4932.

This section has become obsolete. See notes to *Rev. Stat.* 4924, *ante*, 483.

317. *Patents for Designs Subject to General Rules of Patent Law.*

All the regulations and provisions which apply to obtaining or protecting patents for inventions or discoveries not inconsistent with the provisions of this title, shall apply to patents for designs. *Rev. Stat.* § 4933.

318. *Copyright of Designs.*

Act of June 18, 1874, c. 301, § 1, contains the following provision, relative to copyright of a class of designs.

No person shall maintain an action for the infringement of his copyright, unless he shall give notice thereof by inserting in the several copies of every edition published . . . if a . . . model or design intended to be perfected and completed as a work of the fine arts, by inscribing upon some visible portion thereof, or of the substance on which the same shall be mounted, the following words, viz: "Entered according to act of Congress, in the year ——, by A. B., in the office of the Librarian of Congress, at Washington;" or, at his option, the word "Copyright," together with the year the copyright was entered, and the name of the party by whom it was taken out; thus—"Copyright, 18—, by A. B." 18 *Stat.* p. 78, § 1. 1 *Supp. Rev. Stat.* 40, § 1.

Where a design patent for a billiard table was declared void, and the defendant had a right to make them as he did, it was *held*, that there was no infringement of a copyright, which was a mere copy of the design, in defendant's publishing an engraving of his tables. Collender *v.* Griffith, 11 *Blatchf.* 212; 3 *Pat. Off. Gaz.* 689.

A copyrighted design for playing cards is infringed by cards which, though differing in some respects, exhibit a striking similarity in those distinctive features of the main design, wherein the cards registered differ from other playing cards previously used. Richardson *v.* Miller, 12 *Pat. Off. Gaz.* 3.

319. *Registration of Prints or Labels.*

Act of June 18, 1874, c. 301, § 3, contains the following provision relative to registration, in the patent-office, of prints or labels:

No prints or labels designed to be used for any other articles of manufacture shall be entered under the copyright law, but may be registered in the patent-office. And the commissioner of patents is hereby charged with the supervision and control of the entry or registry of such prints or labels, in conformity with the regulations provided by law as to copyright of prints, except that there shall be paid for recording the title of any print or label not a trade-mark, six dollars, which shall cover the expense of furnishing a copy of the record under the seal of the commissioner of patents, to the party entering the same. 18 *Stat.* p. 79, § 3; 1 *Supp. Rev. Stat.* 41, § 3.

The doctrine that the several acts of Congress relating to the registration of prints designed to be used as labels, allow registration of a label which might also be registered as a trade-mark; and that the question whether the commissioner of patents shall regard an application submitted to him for registration as being a trade-mark or a label, depends wholly upon the will of the proprietor (United States *v.* Marble, 1 *Mackey*, 284; 22 *Pat. Off. Gaz.* 1366); has since been overruled in United States *v.* Butterworth, 30 *Pat. Off. Gaz.* 97.

XXV. FEES AND CHARGES.

320. *Fees in obtaining Patents.*

The following shall be the rates for patent fees.

On filing each original application for a patent, except in design cases, fifteen dollars.

On issuing each original patent, except in design cases, twenty dollars.

In design cases: For three years and six months, ten

dollars ; for seven years, fifteen dollars ; for fourteen years, thirty dollars.

On filing each caveat, ten dollars.

On every application for the reissue of a patent, thirty dollars.

On filing each disclaimer, ten dollars.

On every application for the extension of a patent, fifty dollars.

On the granting of every extension of a patent, fifty dollars.

On an appeal for the first time from the primary examiners to the examiners in chief, ten dollars.

On every appeal from the examiners in chief to the commissioner, twenty dollars.

For certified copies of patents and other papers, including certified printed copies, ten cents per hundred words.

For recording every assignment, agreement, power of attorney, or other paper, of three hundred words or under, one dollar ; of over three hundred and under one thousand words, two dollars ; of over one thousand words, three dollars.

For copies of drawings, the reasonable cost of making them. *Rev. Stat.* § 4934.

The above are the fees prescribed by the *Revised Statutes*. The table given in Rule 209 Rules of Practice in the patent-office, is somewhat more minute ; and covers a number of services as to which the statutes have not made any express provision.

The rules of the patent-office prescribe that :

An order for a copy of an assignment must give the liber and page of the record, as well as the name of the inventor ; otherwise an extra charge will be made for the time consumed in making any search for such assignment (*Rules of Prac. No.* 210); and that :

No person will be allowed to make copies or tracings from the files or records of the office. Such copies will be furnished, when ordered, at the rates already specified. *Id.* 211.

The list of prices of publications may be found in the Rules of Practice, Nos. 217, 218.

321. *The Exemption of Government Officers from Payment of Fees.*

The act of March 3, 1883, c. 143, contains the following provision:

The secretary of the interior and the commissioner of patents are authorized to grant any officer of the Government, except officers and employees of the patent-office, a patent for any invention of the classes mentioned in section forty-eight hundred and eighty-six of the Revised Statutes, when such invention is used or to be used in the public service, without the payment of any fee: *Provided*, That the applicant in his application shall state that the invention described therein, if patented, may be used by the Government, or by any of its officers or employees, in the prosecution of work for the Government, or by any other person in the United States, without the payment to him of any royalty thereon, which stipulation shall be included in the patent. Act of March 3, 1883, 22 Stat. c. 143, p. 625.

322. *Mode of Payment.*

Patent fees may be paid to the commissioner of patents, or to the treasurer, or any of the assistant treasurers of the United States, or to any of the designated depositaries, national banks, or receivers of public money, designated by the secretary of the treasury for that purpose; and such officer shall give the depositor a receipt or certificate of deposit therefor. All money received at the patent-office, for any purpose, or from any source whatever, shall be paid into the treasury as receiver, without any deduction whatever, *Rev. Stat.* § 4935.

The Rules of Practice numbers 208, 212, 213 and 214, also relate to the mode of payment.

323. *Refunding.*

The treasurer of the United States is authorized to pay back any sum or sums of money to any person who has through mistake paid the same into the treasury, or to any receiver or depositary, to the credit of the treasury, as for fees accruing at the patent-office, upon a certificate thereof being made to the treasurer by the commissioner of patents. *Rev. Stat.* § 4936.

See also Rules of Practice No. 215.

FORMS.

[From the Pamphlet: *Rules of Practice in the United States Patent-Office*; ed. 1885.]

PETITIONS.

1. By a sole inventor.

To the Commissioner of Patents:

Your petitioner, A. B., a citizen of the United States residing at S., in the county of M., and State of N. [*or*, subject, &c.], prays that letters patent be granted to him for the improvement in sewing-machines set forth in the annexed specification.

A. B.

2. By joint inventors.

To the Commissioner of Patents:

Your petitioners, A. B. and C. D., citizens of the United States residing respectively at L., in the county of M., and State of N., and at G., in the county of H., and State of I. [*or*, subject, &c.], pray that letters patent may be granted to them, as joint inventors, for the improvement in washing-machines set forth in the annexed specification.

A. B.
C. D.

3. By an inventor for himself and an assignee.

To the Commissioner of Patents:

Your petitioner, A. B., a citizen of the United States residing at L., in the county

of M., and State of N. [*or*, subject, &c.], prays that letters patent may be granted to himself and C. D., a citizen of the United States residing at L., in the county of M., and State of N., as his assignee, for the improvement in printing presses set forth in the annexed specification.

A. B.

4. Petition with power of attorney.

To the Commissioner of Patents:

Your petitioner, A. B., a citizen of the United States residing at L., in the county of M., and State of N. [*or*, subject, &c.], prays that letters patent may be granted to him for the improvement in lamps set forth in the annexed specification; and he hereby appoints C. D.,* of the city of R., State of S., his attorney, with full power of substitution and revocation, to prosecute this application, to make alterations and amendments therein, to receive the patent, and to transact all business in the patent-office connected therewith.

A. B.

5. By an administrator.

To the Commissioner of Patents:

Your petitioner, A. B., a citizen of the United States residing at L., in the county of M., and State of N. [*or*, subject, &c.], administrator of the estate of C. D., late a citizen of S., deceased (as by reference to the duly certified copy of letters of administration, hereto annexed, will more fully appear), prays that letters patent may be granted to him for the invention of the said C. D. (improvement in fire-hose) set forth in the annexed specification.

A. B., *Administrator, &c.*

6. By an executor.

To the Commissioner of Patents:

Your petitioner, A. B., a citizen of the United States residing at L., in the county of M., and State of N. [*or*, subject, &c.], executor of the last will and testament of C. D., late a citizen of S., deceased (as by reference to the duly certified copy of letters testamentary, hereto annexed, will more fully appear), prays that letters patent may be granted to him for the invention of the said C. D. (improvement in churns), set forth in the annexed specification.

A. B., *Executor, &c.*

7. For a reissue (by the inventor).

To the Commissioner of Patents:

Your petitioner, A. B., a citizen of the United States residing at L., in the county of M., and State of N. [*or*, subject, &c.], prays that he may be allowed to surrender the letters patent for an improvement in coal-scuttles, granted to him May 16, 1867, whereof he is now sole owner [*or*, whereof C. D., on whose behalf and with whose assent this application is made, is now sole owner, by assignment], and that letters patent may be reissued to him [*or*, the said C. D.] for the same invention, upon the annexed amended specification. With this petition is filed an abstract of title, duly certified, as required in such cases.

A. B.

* If the power of attorney is to a firm, the name of each member of the firm must be given in full.

ASSENT OF ASSIGNEE TO REISSUE.

The undersigned, assignee of the entire [*or*, of an undivided] interest in the above-mentioned letters patent, hereby assents to the accompanying application.

C. D.

8. FOR A REISSUE (BY ASSIGNEE).

(To be used only when the inventor is dead or the original patent was issued and assigned prior to July 8, 1870.)

To the Commissioner of Patents:

Your petitioners, A. B., a citizen of the United States residing at L., in the county of M., and State of N.[*or*, subject, &c.], and C. D., a citizen of the United States residing at H., in the county of I., and State of K. [*or*, subject, &c.], pray that they may be allowed to surrender the letters patent for an improvement in coal-scuttles, granted May 16, 1867, to E. F., now deceased, whereof they are now owners, by assignment, of the entire interest, and that the letters patent may be reissued to them for the same invention, upon the annexed amended specification. With this petition is filed an abstract of title [*or*, an order for making and filing the same, &c.].

A. B.

9. FOR LETTERS PATENT FOR A DESIGN.

To the Commissioner of Patents:

Your petitioner, A. B., a citizen of the United States residing at L., in the county of M., and State of N. [*or*, subject, &c.], prays that letters patent may be granted to him for the term of three and one-half years [*or*, seven years, *or*, fourteen years]* for the new and original design for carpets set forth in the annexed specification.

A. B.

10. CAVEAT

The petition of A. B., a citizen of the United States residing at L., in the county of M., and State of N. [*or*, subject, &c., see Rule 191], represents:

That he has made certain improvements in cotton-gins, and that he is now engaged in making experiments for the purpose of perfecting the same, preparatory to applying for letters patent therefor. He therefore prays that the subjoined description of his invention may be filed as a caveat in the confidential archives of the patent office.

A. B.

11. FOR THE RENEWAL OF A FORFEITED APPLICATION.

To the Commissioner of Patents:

Your petitioner, A. B., a citizen of the United States residing at L., in the county of M., and State of N. [*or*, subject, &c.], represents that on May 8, 1868, he filed an application for letters patent for an improvement in fences, serial number 885, which application was allowed July 7, 1868, but that he failed to make payment of the final fee within the time allowed by law. He now makes renewed application for letters patent for said invention, and prays that the original specification, oath, drawings, and model may be used as a part of this application.

A. B.

* Section 4931 of the R. S. requires the election to be made in the original application.

SPECIFICATIONS.

12. For an art or process.

To all whom it may concern:

Be it known that I, A. B., a citizen of the United States residing at L., in the county of M., and State of N. [*or*, subject, &c.], have invented certain new and useful improvements in purifying and increasing the illuminating power of gas without appreciable loss of bulk (for which I have received letters patent in England, No. 750, dated July 6, 1878*); and I do hereby declare that the following is a full, clear, and exact description of the invention, which will enable others skilled in the art to which it appertains to make and use the same.

Heretofore gas has been purified by passing it through animal charcoal; but when this is used alone, after a short time it loses its power of absorbing impurities, and must then be washed with steam or water, or have atmospheric air blown through it, or be revivified by heat. Used alone, animal charcoal also reduces the candle-power of the gas passed through it and diminishes its bulk.

The object of my invention is thoroughly to purify illuminating gas, to make the operation continuous, and to purify the gas without detracting from its illuminating power, and without causing any appreciable diminution in bulk; and to this end my invention consists in increasing the power of animal charcoal to eliminate from illuminating gas those substances which are considered impurities, in charging the charcoal with a substance which will prevent it from depriving the gas of illuminants, and in passing the gas to be purified with atmospheric air through the animal charcoal.

To carry my invention into effect, I moisten the charcoal (which may be either new or spent) with coal-tar, or with coal-tar and water, or in some cases with water only, and then charge this mass into one or more vessels, which then constitute the purifiers. I may put the mass into the vessels while still wet, or, unless water alone is used, after it has dried. Through these vessels the gas is to pass; but before it is admitted I introduce into it at the retorts, or at the stand-pipe or mains beyond, in order to insure a thorough admixture, a small quantity of atmospheric air—say, from eight-tenths to two and a half per cent. of the bulk of the gas to be purified. The quantity of air will depend directly upon the impurities of the gas. Any suitable mixing device for thoroughly mixing the admitted air with the gas may be located at any point in the mains between the retorts and the bone-black purifiers, or even at the point of admission to the purifier. For water-gas, the charcoal wet with water alone will suffice, air being introduced into the gas.

The oxygen of the air partly unites with the sulphur to form soluble salts, and the rest combines totally with the hydrogen of the sulphureted and other hydrogen sulphur compounds to form water, and part of the sulphur of the sulphureted hydrogen and other sulphur compounds is precipitated in a free state in the charcoal, while its nitrogen partly goes to form, with part of the remaining hydrogen, ammonia bases. No free oxygen passes off with the purified gas, while if any nitrogen goes over, the quantity is so small that it is not detrimental.

* If no foreign patent has been obtained, the words in parenthesis should be omitted.

By the application of air in this manner the process is rendered continuous as the charcoal is kept constantly active for a great length of time.

When the absorbing power of the charcoal finally becomes exhausted, it may either be sold for the valuable ammoniacal salts it contains, or it may be revivified, or be washed and freed from sulphur by a suitable sulphur solvent for re-use.

By charging the bone-black with coal-tar, I prevent it from taking out of the gas any olefiant gas or other heavy hydrocarbons serving as illuminants.

I may treat the black, either before or after putting it into the vessels, as may be most convenient or suitable, with any substance correlative to the illuminants of the gas—that is, with any substance which will impregnate the black in such a manner that it will not take up such illuminants. I have particularly described coal-tar because that is most readily at hand; but its hydrocarbon distillates or the benzole series will answer.

In the case of coal-gas, not only is the sulphureted hydrogen with which it is contaminated taken up, as just described, but the illuminating power of the gas, which is somewhat reduced if passed through dry animal charcoal or bone-black, is not decreased when air is used and the animal charcoal or bone-black is wet with tar, but is actually improved, inasmuch as it gives a whiter flame, of the same candle power as the gas not passed through animal charcoal or bone-black at all.

By the old method, when purification was effected by the use of lime, the sulphureted hydrogen and carbonic acid were absorbed by the lime, and the result was, of course, a loss of the original bulk of the gas. Now, by my process the sulphur and hydrogen are separated, the sulphur remaining in the charcoal and the hydrogen passing through with the gas while the carbonic acid passes through entire; and although it passes through unchanged, it is sufficiently carbureted not to detract from the illuminating power of the gas. I thus have practically the same bulk of gas after purification as before this operation, and loss is prevented without detriment to the consumer.

A striking advantage of my process is, that it unites the scrubbing and purifying operations, for the gas may be passed directly from the condenser into my purifiers.

To eliminate sulphureted hydrogen, I may also mix with the charcoal a substance which will of itself decompose sulphureted hydrogen contained in gas, such as oxide of iron, tin, manganese ore, &c.

When the gas issues from my purifiers it is entirely free from ammoniacal and sulphur compounds, and is nearly inodorous.

When the charcoal is removed from the purifiers it is also inodorous, and is in no sense offensive and disgusting like gas-lime.

Having fully described my invention, what I desire to claim, and secure by letters patent, is—

1. In the purification of illuminating-gas by means of animal charcoal, the process of preventing absorption of illuminants of the gas by the charcoal, which consists in supplying the charcoal with a suitable correlative to such illuminants, as described.

2. The process of purifying illuminating-gas, which consists in mixing the same with air and then passing it through animal charcoal impregnated with coal-tar, all substantially as described.

A. B.

Witnesses:
P. G.
J. D.

13. For a machine.

To all whom it may concern:

Be it known that I, A. B., a citizen of the United States residing at L., in the county of M., and State of N. [*or*, subject, &c.], have invented a new and useful Meat chopping Machine (for which I have obtained a patent in Great Britain, No. 870, bearing date June 24, 1878), of which the following is a specification:

My invention relates to improvements in meat-chopping machines in which vertically reciprocating knives operate in conjunction with a rotating chopping-block; and the objects of my improvements are, first, to provide a continuously lubricated bearing for the block; second, to afford facilities for the proper adjustment of the knives independently of each other in respect to the face of the block; and third, to reduce the friction of the reciprocating rod which carries the knives.

I attain these objects by the mechanism illustrated in the accompanying drawing, in which*

. . . . . .

A. B.

Witnesses:

C. D.

E. F.

14. For a composition of matter.

To all whom it may concern:

Be it known that I, A. B., a citizen of the United States residing at L., in the county of M., and State of N. [*or*, subject, &c.], have invented a new and useful composition of matter to be used for the removal of hair and grease from hides preparatory to tanning, of which the following is a specification:

My composition consists of the following ingredients, combined in the proportions stated, viz:

Pure water	500 gallons.
Unslacked lime	32 gallons.
Soda-ash	100 pounds.
Saltpetre	20 pounds.
Flowers of Sulphur	10 ponnds.

These ingredients are to be thoroughly mingled by agitation.

In using the above-named composition the hides should first be freed from all salt and impurities, by soaking green hides one day and dry hides eight days, and then placing the hides so cleaned in the said solution, and allowing them to remain in it 48 hours. The hides are then to be removed from the solution and unhaired in the usual way.

By the use of the above composition the hair is speedily and thoroughly loosened and the hides, while retaining all of that portion of the substance which can be converted into leather, are at the same time entirely cleaned from grease and other substances which would prevent them from being tanned quickly.

I am aware that a composition consisting of soda-ash, water, lime, and sulphur has been used for the same purpose, and that a patent therefor was granted to C. D.,

* For the drawing referred to, and the description of the machine see the Rules and directions, p. 58.

July 10, 1875, No. 95,726. I am also aware that saltpetre has been used in depilatory processes; but I am not aware that all of the ingredients of my composition, in the proportion stated, have been used together.

What I claim, and desire to secure by letters patent of the United States, is—

The herein-described composition of matter to be used for depilating hides and preparing them for being tanned, consisting of water, unslacked lime, soda-ash, saltpetre, and flowers of sulphur, in the proportions specified.

A. B.

Witnesses:

C. D.

E. F.

16. FOR A DESIGN.

To all whom it may concern:

Be it known that I, A. B., a citizen of the United States residing at L., in the county of M., and State of N. [*or*, subject, &c.], have invented, and produced a new and original design for watch-cases or lockets, of which the following is a specification, reference being had to the accompanying drawings, forming part thereof.

Figure 1 is a sectional view of my newly-designed case, Fig. 2 a side elevation of same, and Fig. 3 an edge view, these three views being deemed necessary to fully illustrate my design.

Heretofore watch-cases and lockets have been made which presented, when viewed in elevation, as in Fig. 2, a scalloped outline or periphery, some being made to imitate shells. In these the scallops extend entirely across from lid to lid, and in a watch-case the center which holds the movements is also scalloped to correspond.

The leading feature of my design consists in a raised or "struck up" scalloped surface, the outlines of which, when viewed in elevation, as in Fig. 2, will fall entirely within the circular outline or circumference of the center.

A is the center of the case, which is circular in its general contour, and B B are the lids. These are also circular in their outer contour where they join the center, but have scallops C C C formed in some way upon them, substantially as represented in the several figures. The indented outline of the scalloped surface falls within the outer contour line of the case, thus presenting to the eye the combined effect of a smooth circular outline or center and an indented or scalloped outline within it.

I claim—

1. The design for a watch-case or locket herein shown and described, the same consisting of the raised scallops C C C on the lid, forming an indented outline wholly within the circular outline of the edge of the lid and the center A.

2. The design for a watch-case or locket herein shown and described, the same consisting of a circular lid, B, having a connected series of raised scallops, C C C, the contour of the same being entirely within the contour of the lid.

A. B.

Witnesses:

C. D.

E. F.

16. FOR A CAVEAT.

To the Commissioner of Patents:

Be it known that I, A. B., a citizen of the United States residing at L., in the county of M., and State of N. [*or*, subject, &c. *See Rule* 191.], having invented an

improvement in velocipedes, and desiring further to mature the same, file this my caveat therefor, and pray protection of my right until I shall have matured my invention.

The following is a description of my newly-invented velocipede, which is as full, clear, and exact as I am able at this time to give, reference being had to the drawing hereto annexed.

This invention relates to that class of velocipedes in which there are two wheels connected by a beam forming a saddle for the rider, the feet being applied to cranks that revolve the front wheel.

The object of my invention is to render it unnecessary to turn the front wheel so much as heretofore, and at the same time to facilitate the turning of sharp curves. This I accomplish by fitting the front and the hind wheels on vertical pivots, and connecting them by means of a diagonal bar, as shown in the drawing, so that the turning of the front wheel also turns the back wheel with a position at an angle with the beams, thereby enabling it easily to turn a curve.

In the drawing, A is the front wheel, B the hind wheel, and C the standards extending from the axle of the front wheel to the vertical pivot E, in the beam F, and D is the cross-bar upon the end of E, by which the steering is done. The hind wheel B is also fitted with jaws G and a vertical pivot H.

A. B.

Witnesses:

C. D

E. F

OATHS.

17. By an inventor.

(To follow specification.)

State of , *County of* , *ss:*

, the above-named petitioner, citizen of[1] , and resident of in the county of and State of , being duly sworn (or affirmed), depose and say that[2] verily believe[3] to be the original, first, and[4] inventor of the improvement in[5] described and claimed in the foregoing specification; that the same has not been patented to[6] , or to others with[7] knowledge or consent, except in the following countries:[8] ; that the same has not to[9] knowledge been in public use or on sale in the United States, for more than two years prior to this application, and[10] do not know and do not believe that the same was ever known or used prior to[11] invention thereof.

(Inventor's full name):

[1] If the applicant be an alien, he will state of what *foreign* or sovereign state he is a citizen or subject.

[2] "He" or "they."

[3] "Himself" or "themselves."

[4] "Sole" or "joint."

[5] Insert title of invention.

[6] "Himself" or "themselves."

[7] "His" or "their."

[8] Here insert, if previously patented, the country or countries in which it has been so patented, giving the date and number of *each* patent. If not previously patented, erase the words "except in the following countries" and insert the words "in any country."

[9] "His" or "their."

[10] "He" or "they."

[11] "His" or "their."

Sworn to and subscribed before me this day of , 188

[L. S.] (Signature of justice or notary):

(Official character):

[*For officers before whom the oath may be made, see Rule* 46. *If the applicant be an alien, the oath will show of what foreign state or sovereign he is a citizen or subject.*

If the applicants claim to be joint inventors, the oath will show "that they verily believe themselves to be the original, first and joint inventors," &c.

If the inventor be dead, the oath will be made by the administrator or executor, who will declare his belief that the party named as inventor was the original and first inventor.]

19. By an applicant fo.. a reissue (inventor).

State of I., *County of K.*, *ss*:

A. B., the above-named petitioner, being duly sworn [*or*, affirmed], deposes and says that he verily believes that his aforesaid letters patent are inoperative [*or*, invalid, *or*, both] by reason of a defective [*or*, insufficient] specification [or both, or by reason of the patentee claiming as his own invention or discovery more than he had a right to claim as new], and that the error arose by inadvertence [*or* accident *or*, mistake], without any fraudulent or deceptive intent; that he is the sole owner of said letters patent; [*or*, that E. F. is the sole owner of said letters patent, and that this application is made on the behalf and with the consent of said E. F.;] and that he verily believes himself to be the first and original inventor of the improvement set forth and claimed in this amended specification, and does not believe that the same was ever before known or used.

A. B.

Sworn to and subscribed before me this 26th day of July, 1869.

C. D.,

[*Title of office.*]

20. By an applicant for a reissue (assignee).

(To be used only when the inventor is dead or in cases of patents issued and assigned prior to July 8, 1870.)

State of I., *County of K.*, *ss*:

A. B. and C. D., the above-named petitioners, being duly sworn [or affirmed], depose and say that they verily believe that the aforesaid letters patent granted to E. F. are [*here follows form* 19, mutatis mutandis]; that the entire title to said letters-patent is vested in them; and that they verily believe the said E. F. to be the first and original inventor of the invention set forth and claimed in the foregoing amended specification; and that the said E. F. is now deceased.

A. B.

C. D.

Sworn to and subscribed before me this 14th day of November, 1869.

A. B.,

[*Title of Office.*]

21. Supplemental oaths to accompany a new or an enlarged claim.

State of I., *County of K. ss*:

A. B., whose application for letters patent for an improvement in seed-drills (Serial Number 4526, was filed in the United States patent office on or about the 15th day

of March, 1869, being duly sworn [*or*, affirmed], deposes and says that he verily believes himself to be the original and first inventor of the improvement as described and claimed in the foregoing amendment, in addition to that which was embraced in the claims originally made, and that he does not know and does not believe that the same was ever before known or used, and that the matter sought to be inserted formed a part of his original invention at the date of filing said application.

A. B.

Sworn to and subscribed before me this 11th day of July, 1870.

C. D.,
[*Official title.*]

22. Oath as to the loss of letters patent.

State of I., *County of K., ss:*

A. B., of said county, being duly sworn [*or*, affirmed], doth depose and say that the letters patent No. 12,213, granted to him, and bearing date on the 9th day of January, A. D. 1855, have been either lost or destroyed; that he has made diligent search for the said letters patent in all places where the same would probably be found, if existing, and that he has not been able to find them.

A. B.

Subscribed and sworn to before me this 5th day of October, 1868.

C. D.,
[*Official title.*]

23. Oath of administrator as to the loss of letters patent.

State of I., *County of K., ss:*

A. B., of said county, being duly sworn, doth depose and say that he is administrator of the estate of E. F., deceased, late of L., in said county; that the letters patent No. 12,219, granted to said E. F., and bearing date of the 9th day of January, A. D. 1855, have been lost or destroyed, as he verily believes; that he has made diligent search for the said letters patent in all places where the same would probably be found, if existing, and especially among the papers of the decedent, and that he has not been able to find said letters patent.

A. B.,
Administrator, &c.

Subscribed and sworn to before me this 5th day of October, 1868.

C. D.,
[*Official title.*]

24. Power of attorney after application filed.

If the power of attorney be given at any time other than that of making application for letters patent, it will be in substantially the following form:

To the Commissioner of Patents:

The undersigned having, on or about the 20th day of July, 1859, made application for letters patent for an improvement in horse-powers (Serial Number 982), hereby appoints C. D., of L., in the county of M., and State of N., his attorney, with full power of substitution and revocation, to prosecute said application, to make alterations and amendments therein, to receive the patent, and to transact all business in the patent-office connected therewith.

Signed at L., in the county of M., State of N., this 6th day of June, 1879.

A. B.

25. Revocation of power of attorney.

To the Commissioner of Patents:

The undersigned having, on or about the 26th day of December, 1867, appointed C. D., of L., in the county of M., and State of N., his attorney to prosecute an application for letters patent, which application was filed on or about the 1st day of June, 1868, for an improvement in the running gear of wagons (Serial Number 870), hereby revokes the power of attorney then given.

Signed at L., in the county of M., and State of N., this 21st day of July, 1869.

A. B.

26. Amendment.*

To the Commissioner of Patents.:

In the matter of my application for letters patent for an improvement in sewing machines, filed May 1, 1879 (Serial Number 540), I hereby amend my specification as follows:

By striking out all between the 5th and 20th lines, inclusive, of page 3;

By inserting the words *connected with* after the word "and" in the 1st line of the 2d claim; and

By striking out the 3d claim, and substituting therefor the following:

"3. The combination, with the driving shaft, the needle-bar, and mechanism for reciprocating the same, of the shuttle-carrier, the shuttle-lever, and a cam carried by the driving-shaft, whereby the proper reciprocating movement is imparted to the shuttle-carrier, and the needle-bar is caused to operate in unison therewith, substantially as described."

Signed at L., in the county of M., and State of N.

A. B.,
By S. Z.,
His Attorney in Fact.

DISCLAIMERS.

27. Disclaimer after patent.

To the Commissioner of Patents:

Your petitioner, A. B., a citizen of the United States, residing at L., in the county of M., and State of N. [*or*, subject, &c.], represents that in the matter of a certain improvement in printing-presses, for which letters patent of the United States No. 76,000 were granted to C. D., on the 12th day of June, 1879, here is [here state the exact interest of the disclaimant; if assignee, set out liber and page where assignment is recorded], and that he has reason to believe that, through inadvertence [accident or mistake], the specification and claims of said letters patent are too broad, including that of which said patentee was not the first inventor. Your petitioner therefore, hereby enters his disclaimer to that part of the claim in said specification which is in the following words, to wit:

"I also claim the sleeves A B, having each a friction-cam, C, and connected,

* In the preparation of all amendments a separate paragraph should be devoted to each distinct erasure or insertion, in order to aid the office in making the entry of the amendment into the case to which it pertains.

respectively, by means of chains or chords K L and M N, with an oscillatory lever, to operate substantially as herein shown and described."

A. B.

Witness:
C. D.

28. Disclaimer during interference.

Interference.

A. B.
v. } Before the examiner of interferences.
C. D.

Subject-matter: Sewing machines.

To the Commissioner of Patents:

Sir: In the matter of the interference above noted, under the provisions of and for the purpose set forth in Rule 104, I disclaim [set forth the matter as given in declaration of interference], as I am not the first inventor thereof, and I herewith transmit an amendment to my application (Serial Number 1556), for the purpose of having the above disclaimer embodied as part of my specification.

Signed at L., in the county of N, and State of N., this 15th day of June, 1879.

A. B.

Witnesses:
E. F.
G. H.

APPEALS.

29. From a principal examiner to the examiners-in-chief.

To the Commissioner of Patents:

Sir: I hereby appeal to the examiners-in-chief from the decision of the principal examiner in the matter of my application for letters patent for an improvement in wagon-brakes, filed January 10, 1869, which on the 20th day of July, 1869, was rejected the second time. The following are the points of the decision on which the appeal is taken: [*Here follows a statement of the points on which the appeal is taken, as provided in Rule* 128.]

[*Place and date of signing.*]

A. B.

30. From a principal examiner to the commissioner.

To the Commissioner of Patents:

Sir: I hereby appeal to you in person from the decision of the principal examiner, made April 7, 1879, in the case of my application for letters patent for an improvement in harvesters, filed January 10, 1879, wherein he refused to consider the case upon its merits until certain alleged inaccuracies of expression in the specification should be corrected. The following are the points of the decision on which the appeal is taken: [*Here follow points on which appeal is taken.*]

[*Place and date of signing.*]

A. B.

31. From the examiners-in-chief to the commissioner.

To the Commissioner of Patents:

Sir: I hereby appeal to you in person from the decisions of the examiner-in-chief made April 7, 1879, in the interference between my application for letters patent for

improvement in sewing-machines and the letters patent of A. B., in which priority of invention was awarded to said A. B. The following are assigned for reasons of, appeal: [*Here should follow an explicit statement of the alleged errors in the decision of the examiners-in-chief.*]

C. D.

32. FROM THE EXAMINER IN CHARGE OF INTERFERENCES TO THE EXAMINERS-IN-CHIEF.

To the Commissioner of Patents:

SIR: I hereby appeal to the examiners-in-chief from the decision of the examiner of inferences in the matter of the interference between my application for letters patent for improvement in sewing machines and the letters patent of A. B., in which priority of invention was awarded to said A. B. The following are assigned for reasons of appeal: [*Here should follow an explicit statement of the alleged errors in the decision of the examiner of interferences.*]

C. D.

33. FROM THE EXAMINERS-IN-CHIEF TO THE COMMISSIONER.

To the Commissioner of Patents:

SIR: We hereby appeal to the commissioner in person from the decision of the examiners-in-chief in the matter of our application for the reissue of letters patent for an improvement in cotton-presses, granted to A. B., May 18, 1865. The following are assigned for reasons of appeal: [*Here follow the reasons as in Form* 31.]

C. D.
E. F.

34. FROM THE COMMISSIONER TO THE SUPREME COURT OF THE DISTRICT OF COLUMBIA.

WASHINGTON, D. C., *July* 20, 1871.

To the Supreme Court of the District of Columbia, in banc:

The petition of A. B., of L., in the county of M., and State of N., respectfully showeth: That he has heretofore invented a new and useful improvement in velocipedes; that on or about the 1st day of May, 1870, he applied to the patent-office of the United States for a patent for the same [*or, for the reissue of a patent granted therefor under date of June* 10, 1862], and complied with the requirements of the several acts of congress, and with the rules of the patent-office prescribed in such cases; that his said application was rejected by the commissioner of patents, on appeal to him, on or about June 20, 1871; that he has filed in said office due notice to the commissioner of patents of this his appeal, accompanied with the reasons of appeal; and that the commissioner has furnished him with complete copies of all the original papers and evidence in the case, all of which, together with a copy of the reasons of appeal, accompany this petition, and are to be taken as a part hereof.

And the said A. B. prays that his said appeal may be heard and determined by your honorable court at such early time as may be appointed for that purpose; and that the commissioner of patents may be duly notified of the same, and directed in what manner to give notice thereof to the parties interested.

A. B.

To the Commissioner of Patents:

A. B., of L., in the county of M., and State of N., hereby gives notice that he has appealed from your decision, rendered on or about the 20th day of June, 1871, rejecting his application for a patent [*or, for a reissue of a patent granted to him June* 10,

1862], for an improvement in velocipedes; and of this you are respectfully requested to take notice.

And the said A. B. assigns the following reason for appealing from the said decision of the commissioner of patents, viz:

[*Here follow reasons, which should be full and explicit, and constitute a brief of the appellant's argument.*]

A. B.

35. Preliminary statement.

A. B. } Interference in the U. S. patent-office.
vs.
C. D. } Preliminary statement of A. B.

A. B., of L., in the county of M., and State of N., being duly sworn, doth depose and say that he is a party to the interference declared by the commissioner of patents June 3, 1879, between A. B.'s application for letters patent, filed May 6, 1879, and the patent of C. D., granted April 20, 1879, for a twine-machine; that he conceived the invention set forth in the declaration of interference, on or about the 1st of June, 1877; that during the said month he made drawings of the invention and explained it to others; that he made a model showing the invention on or about July 20, 1877; that he embodied it in a full-sized machine, which was completed on or about August 15, 1877; that on the 21st day of the last-named month he successfully operated the said machine at his shop in the town of L., county of M., and State of N., and that he has since continued to use the same machine, and has also manufactured others for use and sale.

A. B.

Subscribed and sworn to before me this 10th day of April, 1879.

E. F.,
[*Official title.*]

36. Rules of the supreme court in appeals from the commissioner of patents, adopted November 30, 1870.

1. The appellant's petition shall be addressed to the court, and shall be substantially as follows:

"*To the Supreme Court of the District of Columbia, in banc,*———— 187–.

"The petition of , a citizen of , in the [*State, Territory district*] of , respectfully shows as follows:

"(1.) About the day of , 18 , I invented [*describe the subject of the desired patent in the identical words of the application to the patent-office.*]

"(5.) On the day of , 18—, in the manner prescribed by law, I presented my application to the patent-office, praying that a patent be issued to me for said invention.

"(3.) Such proceedings were had in said office, upon said application, that on the day of , 18 , it was rejected by the commissioner of patents.

"(4.) I thereupon appealed to this court, and gave notice thereof to the commissioner, and filed in his office the following reasons for said appeal:

"(5.) The commissioner of patents has furnished me a complete copy of all the proceedings in his office upon my said application, which copy has been filed herewith, and is to be taken as part hereof.

"(6.) And thereupon I pray that the court do revise and reverse said decision, to the end that justice may be done in the premises.

"_____."

2. This petition shall be filed in the clerk's office of this court; and as soon as the petitioner has made the deposit required by law at the commencement of suits in this court, or said deposit has been dispensed with, the clerk shall enter the case in a docket to be provided by him for the purpose, and in which a brief of said filing and of all subsequent proceedings in the case shall be entered as and when they successively occur, down to and including the final decision.

3. The clerk shall provide a minute-book of his office, in which he shall record every order, rule, judgment, or decree of the court in each case, in the order of time in which said proceedings occur; and of this book there shall be two alphabetical indexes, one showing the name of the party applying for the patent, and the other designating the invention by its subject-matter or name.

4. The cases in the docket of causes shall be successively numbered from No. 1 onward, and each case shall also be designated by the number assigned to it on the records of the patent-office.

5. This docket shall be called for the trial of the cases thereon on the first day of each session of this court in general term, provided the petition has been filed ten days before the commencement of the term.

6. The opinions of the court, when written, shall be kept by the clerk, in the order of their delivery and in a temporary book-file, indexed; and when so many have been delivered as will make a volume of convenient size, he shall cause them to be bound.

7. The clerk shall furnish to any applicant a copy of any paper in any of said appeals on payment of the lawful fees.

8. Hearings of said appeals shall be subject to the rules of the court provided for other causes therein.

9. When the testimony of the commissioner, or of any examiner, touching the principles of invention in question, shall be deemed necessary, it shall be taken orally in open court, unless otherwise ordered by the court. And, in such case, the court may order it to be reduced to writing, and filed or entered on its minutes, if it think proper.

10. The final judgment or order of the court shall not recite any of the facts made to appear in the case, but shall be to the following effect:

"This appeal having been heard upon the record from the patent office [*add* and upon the testimony of the commissioner of patents [*or*, of one of the examiners] [touching the principles of the invention], and having been argued by [counsel for] the petitioner and [for] the commissioner:

"It is thereupon ordered and adjudged that the [petition be dismissed] [*or*, commissioner do issue to the petitioner a patent] [as prayed], [granting the petitioner (*so and so*)].

"And that the clerk of this court transmit to the commissioner of patents a copy of this decree duly authenticated."

ASSIGNMENTS.

87. OF AN ENTIRE INTEREST IN AN INVENTION BEFORE THE ISSUE OF LETTERS PATENT.

Whereas I, A. B., of L., county of M., State of N., have invented a certain new and useful improvement in harvesters [giving title of the same], for which I am about to make application for letters patent of the United States; and whereas G. D., of R., county of S., State of N., is desirious of acquiring an interest in said invention, and in the letters patent to be obtained therefor:

Now, therefore, to all whom it may concern, be it known that, for and in consideration of the sum of five thousand dollars to me in hand paid, the receipt of which is hereby acknowledged, I, the said A. B., have sold, assigned, and transferred, and by these presents do sell, assign, and transfer unto the said G. D., the full and exclusive right to the said invention, as fully set forth and described in the specification prepared and executed by me on the —— day of ——, 188—, preparatory to obtaining letters patent of the United States therefor; and I do hereby authorize and request the Commissioner of Patents to issue the said letters patent to the said G. D., as the assignee of my entire right, title, and interest in and to the same, for the sole use and behoof of the said G. D. and his legal representatives.

In testimony whereof I have hereunto set my hand and affixed my seal this 4th day of May, A. D. 1879.

A. B. [SEAL.]

In presence of—
O. P.
S. T.

38. OF THE ENTIRE INTEREST IN LETTERS PATENT.

Whereas I, A. B., of L., county of M., State of N., did obtain letters patent of the United States for an improvement in car-wheels, which letters patent are numbered 95,000, and bear date the 5th day of June, in the year one thousand eight hundred and sixty-nine, and whereas I am now the sole owner of said patent and of all rights under the same; and whereas E. F., of R., county of S., State of N., is desirous of acquiring the entire interest in the same:

Now, therefore, to all whom it may concern, be it known that, for and in consideration of the sum of five thousand dollars to me in hand paid, the receipt of which is hereby acknowledged, I, the said C. D., have sold, assigned, and transferred, and by these presents do sell, assign, and transfer unto the said E. F., the whole right, title, and interest in and to the said improvement in car-wheels, and in and to the letters patent therefor aforesaid; the same to be held and enjoyed by the said E. F., for his own use and behoof, and for the use and behoof of his legal representatives, to the full end of the term for which said letters patent are or may be granted [thus including extention], as fully and entirely as the same would have been held and enjoyed by me had this assignment and sale not been made.

In testimony whereof I have hereunto set my hand and affixed my seal at L., in the county of M., and State of N., this 25th day of July, A. D. 1878.

A. B. [SEAL.]

In presence of—
N. P.
O. T.

39. Of an undivided interest in letters patent.

Whereas I, A. B., of L., county of M., State of N., did obtain letters patent of the United States for an improvement in hay-rakes, which letters patent are numbered 89,920, and bear date the 3rd day of August, in the year one thousand eight hundred and sixty; and whereas C. D., of R., county of S., State of N., is desirous of acquiring an interest in the same:

Now, therefore, to all whom it may concern, be it known that, for and in consideration of the sum of five hundred dollars to me in hand paid, the receipt of which is hereby acknowledged, I, the said A. B., have sold, assigned, and transferred, and by these presents do sell, assign, and transfer unto the said D. E., the undivided one-half part of the whole right, title, and interest in and to the said invention, and in and to the letters patent therefor aforesaid; the said undivided one-half part to be held and enjoyed by the said C. D., for his own use and behoof, and for the use and behoof of his legal representatives, to the full end of the term for which said letters patent are or may be granted [thus including extension], as fully and entirely as the same would have been held and enjoyed by me had this assignment and sale not been made.

In testimony whereof I have hereunto set my hand and affixed my seal at L., in the county of M., and State of N., this 7th day of June, A. D. 1862.

A. B. [seal.]

In the presence of—
N. P.
O. T.

40. Territorial interest after grant of patent.

Whereas I, A. B., of L., county of M., State of N., did obtain letters patent of the United States for improvement in grain-binders, which letters patent are numbered 87,564 and bear date the 8th day of June, in the year one thousand eight hundred and sixty; and whereas I am now the sole owner of the said patent and of all rights under the same in the below-recited territory; and whereas C. D., of R., county of S., State of N., is desirous of acquiring an interest in the same:

Now, therefore, to all whom it may concern, be it known that, for and in consideration of the sum of five thousand dollars to me in hand paid, the receipt of which is hereby acknowledged, I, the said A. B., have sold, assigned and transferred, and by these presents do sell, assign, and transfer, unto the said C. D., all the right, title, and interest in and to the said invention, as secured to me by said letters patent, for, to, and in the State of N., and for, to, or in no other place or places; the same to be held and enjoyed by the said C. D. within and throughout the above-specified territory, but not elsewhere, for his own use and behoof, and for the use and behoof of his legal representatives, to the full end of the term for which said letters patent are or may be granted (thus including extension), as fully and entirely as the same would have been held and enjoyed by me had this assignment and sale not been made.

In testimony whereof I have hereunto set my hand and affixed my seal at L., in the county of M., and State of N., this 3rd day of May, A. D. 1861.

A. B. [seal.]

In the presence of—
S. T.
R. D.

41. LICENSE—SHOP-RIGHT.

In consideration of the sum of fifty dollars, to be paid bv the firm of S. J. & Co., of L., in the county of M., State of N., I do hereby license and empower the said S. J. & Co. to manufacture in said L. [or other place agreed upon] the improvement in cotton-seed planters, for which letters patent of the United States No. 71,846 were granted to me, November 13, 1868, and to sell the machines so manufactured throughout the United states, to the full end of the term for which said letters-patent are granted.

Signed at L., in the county of M., and State of N., this 22d day of April, 1869.

A. B.

42. LICENSE—NOT EXCLUSIVE—WITH ROYALTY.

This agreement, made this 12th day of September, 1868, between A. B., of L., in the county of M., and State of N., party of the first part, and C. D. & Co., of O., in the county of R., and State of S., party of the second part, witnesseth, that whereas letters patent of the United States No, 67,540, for an improvement in horse-rakes were granted to the party of the first part, dated October 4, 1867; and whereas the party of the second part is desirous of manufacturing horse-rakes, containing said patented improvement: Now, therefore the have agreed as follows:

I. The party of the first part hereby licenses and empowers the party of the second part to manufacture, subject to the conditions hereinafter named, at their factory in O., and in no other place or places, to the end of the term for which said letters patent were granted, horse-rakes containing the the patented improvements, and to sell the same within the United States.

II. The party of the second part agrees to make full and true returns to the party of the first part, under oath, upon the first days of July and January in each year, of all horse-rakes containing the patented improvements manufactured by them.

III. The party of the second part agrees to pay to the party of the first part five dollars as a license-fee upon every horse-rack manufactured by said party of the second part containing the patented improvements; provided, that if the said fee be paid upon the days provided herein for semi-annual returns, or within ten days thereafter, a discount of fifty per cent. shall be made from said fee for prompt payment.

IV. Upon a failure of the party of the second part to make returns or to make payment of license-fees, as herein provided, for thirty days after the days herein named, the party of the first part may terminate this license by serving a written notice upon the party of the second part; but the party of the second part shall not thereby be discharged from any liability to the party of the first part for any license-fees due at the time of the service of said notice.

In witness whereof the parties above named have hereunto set their hands the day and year first above written, at L., in the county of M., and State of N.

A. B.

C. D. &. CO.

EXTENSIONS.

Forms numbered 43 to 48 inclusive are omitted because they relate to proceedings to obtain extensions, only.

DEPOSITIONS.

49. NOTICE OF TAKING TESTIMONY.

BOSTON, MASS., *March* 29, 1869.

In the matter of the interference between the application of A. B. for a paper-collar machine, and the patent No. 25,038, granted December 15, 1868, to C. D., now pending before the commissioner of patents.

SIR: You are hereby notified that on Wednesday, March 31, 1869, at the office of E. F., esq., No. 30 Court street, Boston, Mass., at nine o'clock in the forenoon, I shall proceed to take the testimony of G. H., J. K., and L. M., all of B., as witnesses in my behalf.

The examination will continue from day to day until completed. You are invited to attend and cross-examine.

A. B.,
By R. S., *his Attorney.*

[Place and date of signing.]

Proof of service.

STATE OF M., *County of N., ss:*

Personally appeared before me, a justice of the peace [or other officer], the above-named A. B., who, being duly sworn, deposes and says that he served the above notice upon O. P., the attorney of the said C. D., at one o'clock p. m. of the 30th day of March, 1869, by leaving a copy at his office in R., in the county of S., and State of N., in charge of his partner, R. S.

A. B.

Sworn to and subscribed before me at L., in the county of M. and State of N., this 31st day of March, 1869.

E. F.,
[*Official title.*]

[*Service may be acknowledged by the party upon whom it is made, as follows:*
Service of the above notice acknowledged this 30th day of March, 1869.

C. D.,
By E. F., *his Attorney.*]

50. FORM OF DEPOSITION.

Before the commissioner of patents, in the matter of the interference between the application of A. B. for a paper-collar machine and letters patent No. 85,038, granted December 15, 1868, to C. D.

Depositions of witnesses examined on behalf of A. B., pursuant to the annexed notice, at the office of E. F., No. 30 Court street, Boston, Mass., on Wednesday, March 31, 1869. Present, S. T., esq., on behalf of A. B., and V. W., esq., on behalf of C. D.

G. H., being duly sworn [*or*, affirmed], doth depose and say, in answer to interrogatories proposed to him by S. T., esq., counsel for A. B., as follows, to wit:

Question 1. What is your name, age, residence, and occupation?

Answer 1. My name is G. H.; I am forty-three years of age; I am a manufacturer of paper collars, and reside at C., in the State of M.

Question 2, &c. . . . . .

And in answer to cross-interrogatories proposed to him by V. W., esq., counsel for C. D., he saith:

Cross-question 1. How long have you known A. B.?

Answer 1. . . . . G. H.

51. CERTIFICATE OF OFFICER.

(To follow deposition.)

STATE OF M., *County of N., ss:*

I, A. B., a notary public within and for the county of M., and State of N. [or other officer, as the case may be], do hereby certify that the foregoing deposition of C. D. was [*or*, depositions of C. D., E. F., &c., were] taken on behalf of G. H., in pursuance of the notice hereto annexed, before me at——, in the city [*or*, town, &c.] of K., in said county, on the——day [*or* days] of August, 1879; that said witness [*or*, each of said witnesses] was by me duly sworn before the commencement of his testimony; that the testimony of said witness [*or*, of each of said witnesses] was written out by myself [*or*, by O. P. in my presence]; that the opposing party, X. Y., was present [*or*, absent] during the taking said testimony; that said testimony was taken at——, and was commenced at 9 o'clock a. m. on the 21st of August, 1879, was continued pursuant to adjournment on the 22d, 23d [&c.], and was concluded on the 28th of said month; that I am not connected by blood or marriage with either of said parties, nor interested directly or indirectly in the matter in controversy.

In testimony whereof I have hereunto set my hand and affixed my seal of office, at ——, in said county, this 1st day of September, 1879.

S. T.,
[*Official title.*]

The magistrate will then append to the deposition the notice under which it was taken, and will seal up the testimony, and direct it to the commissioner of patents, placing upon the envelope a certificate, in substance as follows:

I hereby certify that the within deposition of G. H. [*if the package contains more than one deposition give all the names*], relating to the matter of interference between A. B. and C. D., was taken, sealed up, and addressed to the commissioner of patents by me this 26th day of April, A. D. 1869.

E. F.,
[*Official title.*]

URUGUAY.

Law of Industrial Patents, November 13. 1885.*

CHAPTER I.

General Provisions.

Article 1. Authorizes the Executive Power to issue patents with exclusive rights for inventions, or improvements upon inventions.

Art. 2. It has the same power with respect to the persons who, having taken out a patent in a foreign country, solicit a privilege to carry on the industry in the country, provided the application be made within the first year of the original patent and the applicant be either the inventor himself, his attorney, or lessee of the patent.

Art. 3. New discoveries or inventions of any description entitle the authors thereof to the exclusive right of working the same for the period and under the conditions expressed in this Law.

Art. 4. The following are considered discoveries or new inventions: New products of industry, new methods or means and new application of known methods or means for the attainment of a result or industrial product.

Art. 5. Patent rights will not be granted for financial schemes discoveries or inventions well known in the country or abroad, in written works, or printed periodicals, which are purely theoretic and which do not show practically their proper application, chemical compositions, and such as be contrary to the laws of morality and the republic.

Art. 6. The Government does not guarantee either the merit or the priority of discoveries or inventions.

Art. 7. Patents will be granted for 3, 6 or 9 years according to the request of the applicant.

Art. 8. Upon each patent an annuity of $25 shall be paid whilst the privilege lasts.

Art. 9. The payment of the annuities referred to shall be effected in the Credito Publico office within the first ten days of

* There is a later decree which regulates only the granting of patents, the conduct of the patent-office, &c.

each year, under penalty of loss or cancelment of the privilege, and the letters patent will not be issued until the first of these annuities be paid by the applicant or applicants for the patents.

ART. 10. The term of ten days mentioned in the preceding article having expired without the payment being effected, the Executive Power will entertain, and in such case give preference to applications for privileges of the same nature which may be presented by other interested parties.

ART. 11. In all cases where a privilege is granted the Executive Power, previously informed by the council of public health upon privileges for unhealthy industries, shall designate a reasonable term within which to commence working the industry to which the patent refers.

ART. 12. Upon the commencement of working the industry within the term stipulated by the Executive Power, the patentee in a petition to the patent-office shall give notice of the said working stating the place where the work is carried on, which petition shall be annexed to the despatch and forwarded to the head office of public works and the board of health for their report as to the full observance of the terms of the privilege.

ART. 13. In the case of *force majeure* or difficulties occurring which can possibly justify delay in the establishment of the industry within the term designated by the Executive Power under article 11, the patentee shall be able to petition the Legislative Power for a prolongation of the term to commence working.

This petition for prolongation should be made at least three months before the termination of such term.

CHAPTER II.

PATENT-OFFICE.

ART. 14. The letters patent referred to in the preceding articles shall be inscribed upon the stamped paper designated by the law and by the department of trade and commercial marks, which from the promulgation of this law shall be styled "Office of Patents of Inventions, Trade and Commercial Marks."

The letters patent shall be sealed and signed by the *ministro de gobierno*, whose signature shall be countersigned by the chief of the aboved-named office.

ART. 15. The staff of the office shall be composed of a chief and a secretary with the salaries allowed by the budget.

ART. 16. No employe of this office may have, directly or indirectly, any interest in the privileges he may have to deal with, under penalty of immediate dismissal after the fact be proved.

ART. 17. The chief of the office is responsible to the government for all papers and objects deposited which he shall preserve with the greatest care and order.

ART. 18. This office will be under the direction of the *ministro de gobierno*.

CHAPTER III.

FORMALITIES FOR THE CONCESSION OF PATENTS.

ART. 19. Any person wishing to obtain a patent shall present a petition on paper, bearing a stamp of one dollar on each sheet, addressed to the *ministro de gobierno*, and hand it to the chief of the "patent and marks of fact. ries and commerce office" who will despatch it immediately upon its receipt so that it may be duly dealt with.

On the said petition the last named office must note the day and hour at which it was presented.

ART. 20. A specification in duplicate must be attached to the petition giving a clear and sufficient description of the invention, together with samples, drawings, or models, according to the nature of the case, and also an oath declaring the invention to be the property of the applicant and asking for a patent securing his rights.

The samples, models, etc., presented with and accompanying the petition, must be substantial and well made.

ART. 21. The petition shall simply ask for the privilege (patent) stating the term for which it is desired, and must not contain restrictions, conditions, or reserves; it must indicate the title under which the inventor may designate it and describe the invention precisely, and must be written in Spanish with all corrections or erasures which may appear in the text being duly testified. The drawings accompanying it must be made in ink and according to the metric scale established in the republic.

ART. 22. The patent will be granted in the name of the nation and will be guaranteed by the decree granting it, which will be accompanied by the specifications and drawings.

ART. 23. The grant of the patent will not affect the dispositions of article 35.

ART. 24. Every three months the chief of the patent-office will send to the Government a concise and detailed report upon patents issued, for publication.

ART. 25. He will also send an annual report to the general directory of statistics of the patents granted, the term of their duration and the amount paid by the patentees.

ART. 26. Every two years the patent-office shall publish, in one volume, all the despatches of patents granted with descriptions of same and their respective drawings and models.

CHAPTER IV.

CERTIFICATES OF ADDITION OF IMPROVEMENTS UPON INVENTIONS.

ART. 27. Any one who may improve upon a patented discovery or invention shall have the right to solicit an extra certificate which will in no case be granted for a longer period than the remainder of the term of the original patent.

The extra certificate shall be issued on the stamped paper designated by the law, and be signed and sealed by the *ministro de gobierno* and indorsed by the chief of the patent-office. The stamp on this certificate is $100.

ART. 28. To obtain an extra certificate the same formalities shall be observed as for a patent, excepting the tax, of which only a third part of that corresponding to the patent shall be paid when the applicant be the original patentee and two thirds when he be a third party.

ART. 29. When the extra certificate is obtained by a third party, he shall not enjoy the entire exploration of the invention without paying a share to the original inventor, the amount of which shall be determined by two experts appointed by the interested parties, and a third in case of disagreement, taking into consideration the importance of the improvement and that part still held by the original invention.

ART. 30. The original inventor shall be able to retain the right to the share (or royalty) decided upon in the previous article, or the adoption of the improvement in competition with the inventor of such improvement.

If he decide upon the latter course, an equal extra certificate with the same rights and privileges will be granted to him with the inventor of the improvement.

ART. 31. The inventor of the improvement can in no case acquire the right to carry out the original invention.

Neither can the original inventor make use of the improvement except in the second case provided for in the preceding article.

ART. 32. If two or more persons solicit a patent at the same time for the same industry, or extra certificate for the same improvement, none of the documents will be despatched unless the applicants make an agreement together beforehand.

CHAPTER V.

TRANSFER OF PATENTS.

ART. 33. Any one having obtained a patent, or an extra certificate, shall be able to transfer his rights under the conditions he may think proper, but the transference must be made public and the patent-office be advised previously, without which observance the transference to a third party will be of no value.

ART. 34. Comprised with the patent shall be included all rights conceded to the patentee, and they shall be transferred with it excepting when the deed of transfer contains a special clause to the contrary.

CHAPTER VI.

NULLITY AND LAPSE OF PATENTS.

ART. 35. Patents or certificates acquired in defiance of the prescriptions in article 5 shall be null. Those shall also be null that are obtained by false witness or information, when the drawings or specifications be imperfect and incomplete, and when, being a foreign invention, its origin has been represented as of the country (Uruguay), in which case the defaulter shall be fined $500, or be sentenced to 6 months imprisonment.

ART. 36. Valid patents shall lapse when the working of the patented industry be not commenced within the term fixed and under the conditions expressed in the letters patent; when the time for which it was granted is lapsed; if working be stopped for the space of a year, excepting cases of accident or *force majeure*, which events must be proved by the interested party with sufficient proofs within the term of one month, when, if such be not produced, the chief of the patent-office shall publish in the newspapers the forfeiture of the patent.

ART. 37. If the conditions prescribed by article 12 be not ful-

filled by the patentee, the office of that branch of the service shall çall upon him to appear, by means of advertisements during one month, at the end of which time if he does not present himself, the patent granted shall be declared lapsed, and the fact made public as prescribed in the latter part of the preceding article.

ART. 38. A suit for annulment can only be brought by the interested party before the civil court.

ART. 39. For the patented discovery or invention to become public property, a judicial declaration is not indispensable; it is sufficient that it has become null or forfeited, that all be at liberty to explore the patented industry.

ART. 40. In the event of the proprietor of a patent, which has been forfeited or become void, disputing the free exploration of the invention or industry to which it refers by law, suit or other means, any person can request the civil judge for a declaration proving its forfeiture or invalidity.

ART. 41. The judgment shall be summary, allowing the proofs of right, the patentee not being able to show proofs against the documents issued by the patent-office, in support of his privilege. The term for proof shall not exceed twenty days, and ten days after the term for proof the judge shall pass judgment with costs against the loser of the suit.

From this judgment there shall be an appeal to the Supreme Tribunal of Appeals, which may be sitting, which with previous report from the patent-office, shall definitely decide the question without further proceedings.

ART. 42. A patent, once declared null or forfeited, the judge who passed the sentence shall announce the fact to the chief of the patent-office, who will immediately make it public.

CHAPTER VII.

INFRINGEMENTS, THEIR SUPPRESSION AND FINES.

ART. 43. The infringement of the patent right shall be deemed crime of counterfeiture, and punished with a fine of from $100 to $500, or by imprisonment for from one to six months, the loss of the objects counterfeited and indemnification of damages and losses.

ART. 44. Those who, knowing of the counterfeiture, aid it by any means, shall suffer the same penalties as those laid down in the preceding article.

ART. 45. The penalties imposed previously shall be doubled for him who renews counterfeiture within five years after being first condemned.

ART. 46. Having been a workman or employe of the patentee, or having obtained knowledge of the invention by stealth or bribery, shall be considered aggravating circumstances.

ART. 47. The suit for the application of penalties above-mentioned is private, and shall be heard before the criminal judge in office, and be accompanied by the letters patent, without which judgment will not be passed.

ART. 48. The only opposition to the suit are the proofs of nullity, forfeiture, participation in the patent, or the exclusive possession thereof.

ART. 49. The plaintiff can exact caution money from the defendant so as not to interrupt him in the working of the patent if the latter wishes to continue working.

In default of the caution money, the plaintiff can ask for suspension of the working of the patent and embargo the effects constituting it, and, if required, sufficient caution money.

ART. 50. He shall be considered an infringer and be subject to the penalties established for such, who, not being the patentee, and not enjoying the privileges of same, may raise a suit as if he were being deprived of same.

CHAPTER VIII.

FINAL DISPOSITIONS.

ART. 51. The copies of the despatches of the patent, models, etc., shall be asked for in writing from the patent-office by their owners, or those who represent them, in person or by right, during the term of the privilege, after which any person may apply for them who may require them.

ART. 52. The *ministro de gobierno* will give order that they be delivered on 2nd-class stamped paper, at the cost of the applicant, who must pay in addition, as copy duty, two dollars per folio, and cost of plans, drawings, models, etc., as public works tax at the request of the *ministro de gobierno*.

ART. 53. The amount of the duties and fines imposed by this law shall be applied to general expenses of the nation.

ART. 54. The chief of the patent-office shall present the indis-

pensable and necessary books, all duly signed on each page, to the chief official of the *ministry de gobierno.*

These books shall show respectively : 1. The patents granted, their class, the date and term of the patent, and all other observations which may be judged useful for this branch of the service. 2. The date of entry, name of the applicant, and nature of the privilege asked for in each case.

These notes must be signed in the book by the applicants for the patent.

ART. 55. The law of June 20, 1853, and all other dispositions opposed to the present law, are repealed.

ART. 56. The Executive Power will administer the present law.

Furnished for this work from the collection of Patent Laws, of Mr. W. E. Richards.

VENEZUELA.

Act of May 25, 1882.

The Congress of the United States of Venezuela ordains:

ARTICLE 1. Any one who has invented or discovered any new and useful manufacture, a machine, a process, or a combination of materials, or also any new and useful improvement on the same, can obtain a patent therefor upon payment of the sum fixed by this law, and subject to the other provisions of the said law: Provided: That the invention, discovery, or improvement be not already known to or used by others dwelling in this country, that it has not been either patented or described in a public print published either in the republic or abroad, or that it has neither been in public use nor offered for sale for more than two years preceding the application, or that the discontinuance of same has not been proved.

ART. 2. The patent documents are to be issued by the Executive in the name of the United States of Venezuela, and only countersigned by the minister.

ART. 3. The government guarantees neither the correctness nor the utility nor the priority of the patented invention or discovery.

ART. 4. Any person desirous of obtaining a patent must accompany the application with a description of the invention or discovery, machine, manufactures, composition, or improvement, wherein the nature and object of same are clearly set forth, together with the corresponding drawings or samples.

ART. 5. The applicant must in his application make a declaration under oath that he is the true inventor or discoverer of the art, machine, process, composition, or improvement for which he desires to obtain a patent, and any opposition calling the correctness of this declaration in question must be decided in ordinary course of law by the interested parties before the state courts.

ART. 6. Patents are granted for five, ten, or fifteen years, and become void six months, one year, and two years, respectively, after the grant, unless the invention or discovery to which they relate has been carried into operation within the specified time. The patent will state the duration and time of expiration. Its duration dates from the day of grant.

ART. 7. Applications for patents are to be addressed to the State Executive through the minister of commerce.

ART. 8. If the conditions stipulated by this law have been fulfilled, a patent will be granted to the applicant, which empowers him to make use of his invention, discovery, or improvement in the whole territory of the United States of Venezuela and its territories. The patent will be granted by the State Executive through the minister of commerce in the form prescribed below. It must contain a title or a short description exactly setting forth the nature and object of the invention or discovery, as also the exclusive permission to the patentee, his heirs and assigns to produce, use, or sell the invention or discovery.

"The President of the Republic with the assent of the Federal Council:

Whereas———has appeared before the Federal Executive and has applied for a patent for the purpose of, [here give the nature of the application,] and having complied with the conditions prescribed in the law of May 25, 1882, in accordance with article 8 of the above-cited law, and in the name of the United States of Venezuela, I grant unto him the present patent for the period of———years for the sole use of the above-mentioned industry for his own profit, or the profit of his heirs or assigns, but in such manner that the Executive does not guarantee either the utility, the correctness, or the priority of the patented discovery or invention.

"After———from the present date this patent shall cease and determine, unless the invention has been put into operation in the interim.

"Signed, sealed, and countersigned, in the palace of the federation at Caracas, the———, &c."

ART. 9. Patents are subject to the payment of a tax of 80 francs (Bolivars) annually in the case of an invention or discovery, and of 60 francs (or Bolivars) annually when the subject is an improvement of a known process.

ART. 10. The tax prescribed in the previous article is payable into the national treasury of the public service. Every applicant for a patent who applies to the Executive according to article 7 must accompany the application with a certificate that he has paid the half of the duty corresponding to the period of protection required. If, conformably to the provisions of this law, the patent cannot be granted, the applicant shall lose the sum deposited, which shall be applied for popular education. If the patent be granted,

the amount paid shall be deducted from that which the applicant has to pay for the period of the patent. The Executive shall have power to relieve such patentees of industrial discoveries or products of the taxes due under article 9 of this law as are in their opinion worthy of this favor.

ART. 11. Every person who has obtained a patent may publish the fact in advertisements and in his trade-mark without this publication constituting a guarantee of the government for the quality of the product, or of the priority of the invention or discovery, or becoming of any undue value whatever to the prejudice of the prior rights of a third party.

ART. 12. Every person who has had a patent granted to him for an invention or discovery in a foreign country can also obtain a patent in this: Provided: That it has not already been granted to any one. In such case the patent shall only be granted for a period equal to the unexpired term of the patent in the foreign country.

ART. 13. On the expiration of a patent the description of the discovery or invention shall be published in the Official Gazette, and from this time forward the use of the discovery or invention, together with the manufacture or sale of the industrial product hitherto protected by the patent, shall be open to any one.

ART. 14. The patent shall also be published if the same, according to article 6 of this law, lapse before the invention or discovery has been carried into operation, conformably to article 6 of this law, or when before its expiration or lapse it is declared null and void, except in the case provided for under article 18.

ART. 15. All specifications, drawings, and samples necessary for obtaining a patent are to be deposited with the minister of public affairs.

ART. 16. After an application for a patent has been accepted by the Executive, the same shall be notified in the Official Gazette; but the patent (in the event of its being granted) shall not be issued until the expiration of thirty days after this notification has appeared.

ART. 17. Inventions, improvements, or new manufactures prejudicial to health, public order, morals, or prior rights shall not be patentable. Pharmaceutical preparations and medicines in any shape or form cannot be patented, but remain subject to the special legislation and regulations therefor provided.

ART. 18. Besides the cases provided for under article 6, patents are null and void if the Executive Government decide that the

patent granted is detrimental to the rights of a third person, as well as if the actual working of the patented industry has been discontinued for a whole year, excepting unforseen circumstances or force *majeure*.

ART. 19. Infringements of the rights secured by patent will be adjudicated upon by the federal courts in conformity with the laws.

ART. 20. The patent law made on May 20, 1878, is hereby annulled.

Given in the palace of the Executive Government, at Caracas, May 25, 1882, &c.

From 35 *Pat. Off. Gaz.* 388.

VICTORIA.

An Act to consolidate the Law concerning Letters Patent for Inventions, being Act No. CCXL., of May 9, 1865.

(NOTE*.—The words "registrar-general" in italics are alterations made by the Act, No. 432, 17th Dec., 1872.)

Be it enacted by the Queen's most excellent Majesty, by and with the advice and consent of the Legislative Council and the Legislative Assembly of Victoria, in this present Parliament assembled, and by the authority of the same, as follows:

1. *Title.* This Act shall come into operation on the first day of June, in the year of our Lord one thousand eight hundred and sixty-five, and shall be called and may be cited as "The Patents Statute, 1865." Its sections are divided into parts as follow:

Part I.—Mode of obtaining Letters Patent, §§ 4–19.

Part II.—Disclaimers and Alterations, §§ 20–23.

Part III.—Extension of Term and Confirmation of Invalid Patents, §§ 24–28.

Part IV.—Miscellaneous Provisions, §§ 29–39.

2. *Repeal of Acts.* The Acts mentioned in the first schedule hereto, to the extent to which the same are in and by the said schedule expressed to be repealed, shall be and the same are hereby repealed. Nothing herein contained shall affect any proceedings or things lawfully taken, done, or commenced, or any letters patent granted, or any protection or right conferred, or any rules and regulations, or any register or appointment made, or any notice or particulars given or published, or any warrant issued or caveat entered under the said repealed Acts, or either of them, before the coming into operation of this Act; and all such proceedings and things shall be as valid and may be continued, and all such letters patent, protections, rights, rules, and regulations, registers, appointments, notices, particulars, warrants, and caveats shall have the same force and efficacy as if this Act had not been passed. Letters patent may be granted in respect of applications made before the coming into operation of this Act in like manner as if this Act had

* Notes printed in this form are from Carpmael's edition.

not been passed; and where letters patent have been granted before the commencement of this Act, or shall in respect of any application made before the commencement of this Act be hereafter granted for any invention, such letters patent may be confirmed, or the term thereof extended or new letters patent granted for such invention in like manner as if the original or first letters patent had been granted under this Act.

3. *Interpretation.* In the interpretation of this Act the word "invention" shall mean and include any manner of new manufacture the subject of letters patent and grant of privilege within the meaning of the enactment next hereinafter contained.

Part I.—Mode of obtaining Letters Patent.

4. *Power to grant patents.* It shall be lawful to make and issue, in the manner hereinafter mentioned, letters patent and grants of privilege for any term not exceeding fourteen years from the date thereof of the sole working or making of any manner of new manufactures within Victoria and its dependencies to the true and first inventor of such manufactures, which others at the time of making such letters patent and grants shall not use, so as also they be not contrary to the law nor mischievous to the State by raising prices of commodities, or hurt of trade, or generally inconvenient. And all other monopolies, commissions, grants, licenses charters, and letters patent hereafter to be made or granted to any person of or for the sole buying, selling, making, working, or using of anything within Victoria or its dependencies, or of any other monopolies, or of power, liberty, or faculty to dispense with any others, and all matters and things whatsoever in anywise tending to the instituting, erecting, or countenancing of the same, or any of them, shall be utterly void and of none effect, and in nowise to be put in execution.

5. *Governor in Council to make rules for executing this Act.* It shall be lawful for the Governor in Council, from time to time to make such rules and regulations (not inconsistent with the provisions hereof), as may appear to be necessary and expedient for the purposes of this Act; and all such rules and regulations shall be laid before both Houses of Parliament within fourteen days after the making thereof if Parliament be sitting, and if Parliament be not sitting, then within fourteen days after the next meeting of Parliament.

6. *Inventor to deposit specifications; same may be amended before patent issues.* All applications under this Act for the grant of letters patent for an invention shall be made as follows: (that is to say,) the applicant shall deposit at the office of the *registrar-general* an instrument in writing under his hand and seal, particularly describing and ascertaining the nature of the said invention, and in what manner the same is to be performed, and also a copy of such instrument, and of the drawings accompanying the same (if any); and the day of the deposit of every such specification, shall be recorded at the said office and indorsed on such specification, and a certificate thereof given to such applicant or his agent; and thereupon, subject and without prejudice to the provisions hereinafter contained, the said invention shall be protected under this Act for the term of six months next after the said deposit, and the applicant shall have during such term the like powers, rights, and privileges as might have been conferred upon him by letters patent for such invention issued under this Act, and duly sealed as of the day of such deposit; and during the continuance of such powers rights, and privileges under this provision, such invention may be used and published without prejudice to any letters patent to be granted for the same; and where letters patent are granted in respect of such invention, such letters patent shall be conditioned to become void if such specification does not particularly describe and ascertain the nature of the said invention, and in what manner the same is to be performed: Provided always, that in case the title of the invention or the said specification be too large or insufficient, it shall be lawful for the law officer during the said term of six months, and before the grant of the letters patent, to allow or require such specification to be amended, or another and sufficient specification to be deposited in lieu thereof; and every such amended or new specification shall have the same force, effect, and operation as if it had been originally deposited in its amended or new state.

7. *Form and size of specification and copy.* Every such specification as aforesaid shall be in the form contained in the second schedule to this Act, or to the like effect, and shall be written upon both sides of one or more skin or skins of parchment, and every page thereof shall be of the exact size of twenty inches in length by fifteen inches in breadth, leaving a margin of at least one inch and a half on each side of every such page in order and to the intent that the same may be bound into books for safe custody; but the drawings accompanying such specification (if any) may be made

upon larger sheets of parchment, leaving a margin of the size and for the purpose aforesaid; and every copy of any such specification as aforesaid, and of the drawings accompanying the same (if any), shall in like manner be written upon one or more sheet or sheets of paper of the size and with the margins aforesaid.

8. *Patent of true inventor not to be affected by specification of pretended inventor.* In case of the deposit of any such specification as aforesaid in fraud of the true and first inventor, any letters patent granted to the true and first inventor of such invention shall not be invalidated by reason of such deposit, or of any use or publication of the invention subsequent to such deposit and before the expiration of the said term of protection.

9. *Mode of proceeding after deposit of specification.* The applicant, so soon as he shall think fit after the deposit of such specification as aforesaid, and of the drawings and models accompanying the same (if any), may give notice in writing at the chambers of the law officer of his intention to proceed with his application for letters patent for the said invention, stating in such notice the title of the said invention; and the day on which the specification thereof was deposited at the office of the *registrar-general*, and at the time of giving such notice shall produce the said certificate of deposit; and thereupon the said law officer shall deliver to the applicant or his agent an appointment in the form contained in the third schedule to this Act, or to the like effect; and such applicant or agent, not less than twenty-one clear days prior to the day appointed by the law officer, shall cause the said appointment to be published once in the Government Gazette, once in some newspaper published in the city of Melbourne, and twice in some newspaper published in the town or place at or near to which the applicant uses or exercises the said invention, or (in case he does not use or exercise the same) in or near to which he resides, or if there shall be no newspaper published in such town or place then twice in some newspaper circulating in the neighborhood where he uses or exercises the said invention or (in case he does not use or exercise the same) where he resides; and any person having an interest in opposing the grant of letters patent for the said invention shall be at liberty, not less than three clear days prior to the day so appointed, to leave particulars in writing of his objections to the said application at the chambers of the law officer.

10. *Law officer to hear applications and objections and award costs.* At the place and time named in the said appointment the

applicant shall produce the newspapers containing the same; and the law officer shall thereupon hear and consider the said application and all objections to the same mentioned in the said particulars (if any), and for that purpose shall obtain from the office of the *registrar-general* the said copy of the said specification, and of the drawings and models accompanying the same (if any), and may call to his aid such scientific or other person as he may think fit, and may, by writing under his hand, order to be paid to such persons some remuneration for his attendance; and may also in like manner order that the costs of any hearing upon any objection, or otherwise in relation to the grant of such letters patent, or the protection acquired by the applicant under this Act, shall be paid, and in and by such writing shall fix the amount of such remuneration or costs, and by or to whom the same respectively shall be paid; and every such order shall be in the form contained in the fourth schedule to his Act, or to the like effect, and may be made a rule of the Supreme Court: Provided always, that the applicant, the objectors, and respective witnesses and evidence shall be respectively heard, examined, and considered separately and apart from and in the absence of the other and his witnesses and evidence.

11. *Law officer may issue warrant for letters patent.* The law officer, after such hearing and consideration, may issue a warrant under his hand and seal for the granting of letters patent for the said invention, and by such warrant shall direct the insertion in such letters patent of all such restrictions, conditions, and provisos as he may deem usual and expedient in such grants, or necessary in pursuance of this Act: and the said warrant shall be the warrant for the making and sealing of letters patent under this Act according to the tenor of the said warrant; and every such warrant shall be in the form contained in the fifth schedule to this Act, or to the like effect.

12. *Letters patent may be repealed or withheld, and specification canceled.* The writ of scire facias shall lie for the repeal of any letters patent granted under this Act and may be issued into the circuit district in which the grantee resided when the said letters patent were granted; and in case such grantee does not reside in Victoria, it shall be sufficient to file such writ in the proper office of the Supreme Court, and serve notice thereof in writing at the last known place of residence or business of such grantee; and nothing herein contained shall extend to abridge or affect the prerogative of the Crown in relation to the granting or withholding

the grant of any letters patent; and it shall be lawful for the Governor in Council to order such law officer to withhold such warrant as aforesaid, or that any letters patent for the granting whereof he may have issued a warrant as aforesaid, shall not issue, or to order the insertion in any such letters patent of any restrictions, conditions or provisos, in addition to or in substitution for any restrictions, conditions, or provisos which would otherwise be inserted therein under this Act ; and it shall also be lawful for the Governor in Council to order any specification in respect of the invention described in which no letters patent may have been granted to be canceled, and thereupon the protection obtained by the deposit of such specification shall cease.

13. *Letters patent to be void on non performance of conditions.* All letter patent for inventions granted under this Act shall be in the form contained in the sixth schedule to this Act, or to the like effect, and be made subject to the condition that the same shall be void, and that the powers and privileges thereby granted shall cease and determine, at the expiration of three years and seven years respectively from the date thereof, unless there be paid within the said three and seven years respectively the sum or sums of money in that behalf hereby required to be paid ; and the *registrar-general* shall issue under his hand a certificate of such payment and shall indorse a receipt for the same on the letters patent.

14. *Letters patent to be issued within three months after warrant, and during the protection.* The *registrar-general*, so soon after the receipt by him of the said warrant as required by the applicant, shall cause to be prepared letters patent for the invention according to the tenor of the said warrant ; and it shall be lawful for the Governor in Council to cause such letters patent to be sealed with the seal of the colony ; and such letters patent shall be made applicable to the said colony and its dependencies, and shall be valid and effectual as to the whole of the same respectively ; but except as hereinafter-mentioned, no letters patent shall issue on any warrant granted as aforesaid unless application be made to seal such letters patent within three months after the date of the said warrant, nor unless such letters patent be granted during the continuance of the protection conferred under this Act by reason of such deposit.

15. *Letters patent may issue after that time in certain cases.* Where the application to seal such letters patent has been made during the continuance of such protection as aforesaid, and the seal-

ing of such letters patent has been delayed from accident and not from the neglect or willful default of the applicant, then such letters patent may be sealed at such time not being more than one month after the expiration of such protection as the Governor in Council shall direct; and where the applicant for such letters patent dies during the continuance of such protection aforesaid, such letters patent may be granted to the executors or administrators of such applicant during the continuance of such protection or at any time within three months after the death of such applicant, notwithstanding the expiration of the term of such protection; and the letters patent so granted shall be of the like force and effect as if they had been granted to such applicant during the continuance of such protection; and in case any letters patent shall be destroyed or lost other letters patents of the like tenor and effect, and sealed and dated as of the same day, may (subject to such regulations as the Governor in Council may direct) be issued under the authority of the warrant in pursuance of which the original letters patent were issued.

16. *Letters patent to bear date of the deposit of specification and to be conclusive as to preliminary steps and proceedings.* Notwithstanding any enactment to the contrary, all letters patent to be issued in pursuance of this Act shall be sealed and bear date as of the day of the deposit of such specification as aforesaid, and shall be of the same force and validity as if they had been sealed on the day as of which the same are expressed to be sealed and bear date; and after any letters patent shall have been granted or issued under this Act it shall not be necessary or material to inquire or ascertain whether such appointment as aforesaid has or has not been delivered and published in the manner hereinbefore mentioned and directed.

17. *Letters patent for foreign inventions not to continue after expiration of foreign patent.* Where upon any application made under this Act letters patent are granted for or in respect of any invention first invented in parts out of Victoria and its dependencies, and a patent or like privilege for the monopoly or exclusive use or exercise of such invention in any parts out of Victoria and its dependencies is obtained before the grant of such letters patent in Victoria, all rights and privileges under such letters patent shall (notwithstanding any term in any such letters patent limited) cease and be void immediately upon the expiration or other determination of the term during which the patent or like privilege obtained in such part out of Victoria and its dependencies shall continue in

force, or where more than one such patent or like privilege is obtained abroad, immediately upon the expiration or determination of the term which shall first expire or be determined of such several patents or like privileges: Provided always, that no letters patent for or in respect of any invention (for which any such patent or like privilege as aforesaid shall have been obtained abroad) granted in Victoria after the expiration or determination of the term for which such patent or privilege was granted or was in force shall be of any validity.

18. *Letters patent not to prevent the use of inventions in foreign ships resorting to ports in Victoria.* No letters patent for any invention granted after the coming into operation of this Act shall extend to prevent the use of such invention in any foreign ship or vessel, or for the navigation of any foreign ship or vessel, which may be in any port of Victoria or its dependencies or in any of the waters within the jurisdiction of any of Her Majesty's courts of Victoria, where such invention is not so used for the manufacture of any goods or commodities to be vended within or exported from the same: Provided always, that this enactment shall not extend to the ships or vessels of any foreign State, the laws of which authorize subjects of such foreign State having patents or like privileges for the exclusive use or exercise of inventions within its territories, to prevent or interfere with the use of such inventions in British ships or vessels, or in or about the navigation of British ships or vessels while in the ports of such foreign State, or in the waters within the jurisdiction of its courts, where such inventions are not so used for the manufacture of goods or commodities to be vended within or exported from the territories of such foreign State.

19. *Specification to be filed after issue of patent or expiring of protection.* Every specification deposited at the office of the *registrar general* as aforesaid, and the drawings and models accompanying the same (if any), shall, forthwith after the grant of the letters patent, or if no letters patent be granted then immediately on the expiration of six months from the time of such deposit, be transferred to and kept in such office as the Governor in Council shall from time to time appoint for that purpose.

Part II.—Disclaimers and Alterations.

20. *Notice of application to disclaim or make alterations.* Any person who shall obtain letters patent under this Act, or in case

such person shall part with his whole or any part of his interest by assignment, such person together with the assignee (if part only has been assigned), or the assignee alone (if the whole has been assigned), may apply to the law officer for leave to enter a disclaimer of any part of either the title of the invention or of the specification, or a memorandum of any alteration in the said title or specification, not being such disclaimer or such alteration as shall extend the exclusive right granted by the said letters patent; and thereupon the law officer shall deliver to such patentee and assignee, or either of them, or to their or either of their agents, an appointment in the form contained in the seventh schedule to this Act, or to the like effect; and such patentee or assignee shall thereupon cause such disclaimer (stating the reason for the same), or such memorandum of alteration, to be written at the foot of the said appointment, and shall cause the same respectively to be published in the manner hereinbefore required with respect to the said first mentioned appointment; and any person having an interest in opposing the said application shall be at liberty to leave particulars in writing of his objections to the same at the chambers of the law officer within such time not being less than three clear days prior to the day so appointed: Provided always, that where such application as aforesaid shall be for leave to enter a disclaimer of any part of the title of the said invention, or a memorandum of any alteration in such title, the law officer may dispense with such appointment and publication, and in that case shall certify in the fiat hereinafter mentioned that he has dispensed with the same.

21. *Application for disclaimer to be heard.* At the time and place named in such appointment the said patentee and assignee, or one of them, shall produce the newspapers containing the same and the said disclaimer or memorandum of alteration at the foot thereof; and the law officer shall thereupon hear and consider the said application, and all objections to the same mentioned in the said particulars (if any), and all such power and authority shall and may be exercised upon that occasion by the law officer as by virtue of the provisions hereinbefore contained can and may be exercised in relation to the hearing and considering an application for letters patent and objections to the same, and shall and may be enforced in like manner.

22. *How disclaimer may be entered and alterations made.* After such hearing and consideration, or without such hearing and consideration where the said appointment and publication shall have

been dispensed with as aforesaid, such patentee and assignee, or either of them, may by leave of the law officer (to be certified by a fiat under his hand to be written at the foot of the same parchment with the said disclaimer or memorandum) enter such disclaimer (stating the reason for the same) or such memorandum of alteration, and at the time of entering such disclaimer or memorandum of alteration shall deposit a copy thereof in the office next hereinafter mentioned; and such disclaimer or memorandum of alteration, being filed in such office as the Governor in Council shall from time to time appoint for that purpose, shall be deemed and taken to be part of such letters patent or such specification, and subject to the several incidents thereof, in all courts whatever, and shall be valid and effectual in favor of any person in whom the rights under the said letters patent may then be or thereafter become legally vested; and no objection shall be allowed to be made in any proceeding upon or touching such letters patent, specification, disclaimer or memorandum of alteration, on the ground that the person entering such disclaimer or memorandum of alteration had not sufficient authority in that behalf: Provided always, that no action shall be brought upon any letters patent in which or on the specification of which any disclaimer or memorandum of alteration shall have been filed in respect of any infringement committed prior to the filing of such disclaimer or memorandum of alteration (unless the law officer shall certify in his said fiat that any such action may be brought), notwithstanding the entry or filing of such disclaimer or memorandum of alteration; and no such disclaimer or alteration shall be receivable as evidence in any action or suit (save and except in any proceeding by scire facias) pending at the time when such disclaimer or alteration was filed as aforesaid; but in every such last mentioned action or suit the original title and specification alone shall be given in evidence, and be deemed and taken to be the title and specification of the invention for which the letters patent have been or shall have been granted: Provided also, that when any such fiat shall have been granted or issued under this Act, it shall not be necessary or material to inquire or ascertain whether such appointment as last aforesaid has or has not been delivered and published or dispensed with in accordance with this Act, and such filing of any disclaimer or memorandum of alteration in pursuance of the leave of the law officer certified as aforesaid shall (except in cases of fraud) be conclusive as to the right of the party to enter such disclaimer or memorandum of alteration under this Act.

23. *Copies of specifications, disclaimers, &c., to be open to inspection.* The copies of all specifications and the drawings and models accompanying the same (if any) and of all disclaimers and memoranda of alterations respectively deposited under or in pursuance of this Act shall be open to the inspection of the public at all reasonable times after the grant of letters patent, or if no letters patent be granted then immediately on the expiration of six months from the time of such deposit; but subject to such regulations as the Governor in Council may make in that behalf.

PART III.—EXTENSION OF TERM AND CONFIRMATION OF INVALID PATENTS.

24. *Mode of obtaining extension of the term.* If any person who has obtained letters patent under this Act or any other Act relating to letters patent heretofore in force in Victoria, or (in case such person shall have parted with his whole or any part of his interest by assignment) if such person, together with the assignee where part only has been assigned, or of the assignee alone where the whole has been assigned, shall, six months before the expiration or other determination of such letters patent, present to the Governor in Council a petition for the extension of the term in such letters patent mentioned, and shall set forth in such petition that he or they has or have been unable to obtain a due remuneration for his or their expense and labor in perfecting such invention, and that an exclusive right of using and vending the same for some further period to be named in such petition, in addition to the said term, is necessary for his or their reimbursement and remuneration, it shall be lawful for the Governor in Council to refer the consideration of the said petition to commissioners to be appointed for that purpose in the manner hereinafter mentioned.

25. *Mode of obtaining confirmation of invalid patent.* If in any suit or action it shall be proved or specially found by the verdict of a jury that any person who shall have obtained letters patent for any invention or supposed invention was not the first inventor thereof, or of some part thereof, by reason of some other person having invented or used the same, or some part thereof, before the date of such letters patent, or if such patentee or his assigns shall discover that some other person had, unknown to such patentee, invented or used the same, or some part thereof, before the date of such letters patent, such patentee or his assigns may

petition the Governor to confirm the said letters patent or to grant new letters patent; and it shall be lawful for the Governor in Council to refer the consideration of the said petition to commissioners to be appointed for that purpose in the manner hereinafter mentioned.

26. *Appointment of commissioners.* For the purpose of considering any such petition as aforesaid, it shall be lawful for the Governor in Council (if he shall think fit) to issue and direct in the name of Her Majesty, her heirs or successors, to five or more persons (of whom some of the judges of the Supreme Court shall be two) a commission reciting such petition, and requiring and authorizing such persons, or any three of them, of whom one of the said judges shall be one, to meet at some time (not being less than two months from the publication of the said commission in the Government Gazette) and at some place to be respectively fixed in the said commission, and then and there to consider the said petition, and to report to Her Majesty, her heirs and successors (in case such petitioner shall have prayed for an extension of the term in the letters patent mentioned), whether any and, if any, what further extension of the said term should be granted according to the prayer of the said petition, and upon what, if any, conditions, or (in case such petitioner shall have prayed for a confirmation of the letters patent or for a grant of new letters patent) whether such confirmation or grant should be made.

27. *Notice of commission to be published and caveats entered.* Two months at least before the time named in the said commission for the consideration of any such petition as aforesaid, the petitioner shall cause to be published in the same manner as is hereinbefore required with respect to the said first mentioned appointment an advertisement of the contents of the said commission in the form contained in the eighth schedule to this Act, or to the like effect; and any person having an interest in opposing the said petition shall be at liberty to enter a caveat against the same at the office of the *registrar-general* at any time not being less than one week before the time named in the said commission for the execution thereof.

28. *Commissioners to hear all parties and report.* At the time and place fixed in the said commission for that purpose the commissioners shall meet and proceed to consider such petition; and the petitioner shall be heard by his counsel and witnesses to prove his case as stated in such petition, and the publication of the said

last mentioned advertisement as required by this Act; and the persons entering caveats shall likewise be heard by their counsel and witnesses; and all such witnesses shall be examined upon oath or affirmation (which oath or affirmation such commissioners as aforesaid are hereby authorized and required to administer); and thereupon and upon hearing and inquiry of the whole matter (in case such petitioner shall have prayed for an extension as aforesaid) the said commissioner may report whether any and, if any, what further extension of the said term should be granted; and the Governor in Council is hereby authorized and empowered, if he shall think fit, to grant to the petitioner new letters patent for the said invention for a term not exceeding fourteen years after the expiration of the first term, anything hereinbefore contained to the contrary thereof in anywise notwithstanding; and such new letters patent shall be sealed and bear date as of the day after the expiration of the term of the first letters patent. Or (in case such petitioner shall have prayed for a confirmation or grant as aforesaid, such commissioners, upon examining the said matter and being satisfied that such patentee as aforesaid believed himself to be the first and original inventor, and being satisfied that such invention, or part thereof, had not been publicly and generally used before the date of such first letters patent, may report to Her Majesty, her heirs and successors, their opinion that the prayer of such petition ought to be complied with, whereupon the Governor in Council may, if he shall think fit, grant such prayer; and the said letters patent shall be available at law and in equity to give to such petitioner the sole right of using, making, and vending such invention as against all persons whomsoever, anything hereinbefore contained to the contrary thereof notwithstanding: Provided that any person, party to any former suit or action touching such first letters patent as last aforesaid, shall be entitled to have notice in writing of the time and place fixed as aforesaid for the first meeting of the said commissioners to consider the said petition; and after any such report shall have been made it shall not be material or necessary to inquire or ascertain whether any such advertisement as last aforesaid has or has not been published, or whether any such notice as last aforesaid has or has not been given in the manner hereinbefore directed in that behalf.

Part IV.—Miscellaneous Provisions.

29. *Index to specifications, disclaimers, &c.* The Governor in Council may cause indices to all specifications, disclaimers, and memoranda of alterations heretofore or to be hereafter enrolled or deposited as aforesaid to be prepared in such form as may be thought fit; and such indices shall be open to the inspection of the public, at such places as the Governor in Council shall appoint, and subject to the regulations to be made as hereinbefore provided.

30. *Register of patents to be kept.* There shall be kept at the office to be appointed as aforesaid a book or books, to be called The Register of Patents, wherein shall be entered and recorded in chronological order all letters patent granted under this Act and any other Act relating to letters patent heretofore in force in Victoria, the deposit and filing of specifications, disclaimers, and memoranda of alterations filed in respect of such letters patent, all amendments in such letters patent and specifications, all confirmations and extensions of such letters patent, the expiry, determination, vacating, or canceling such letters patent, with the dates thereof respectively, and all other matters and things affecting the validity of such letters patent as the Governor in Council may direct; and such register, or a copy thereof, shall be open at all convenient times to the inspection of the public, subject to such regulations as the Governor in Council may make in that behalf.

31. *Register of Proprietors to be kept.* There shall be kept at the same office a book or books, entitled The Register of Proprietors, wherein shall be entered, in such manner as the Governor in Council shall direct, the assignment of any letters patent, or of any share or interest therein, any license under letters patent, and the district to which such license relates, with the name or names of any person having any share or interest in such letters patent or license, the date of his or their acquiring such letters patent, share, and interest, and any other matter or thing relating to or affecting the proprietorship in such letters patent or license; and a copy of any entry in such book, certified as hereinafter mentioned, shall be given to any person requiring the same, and shall be *primâ facie* proof of the assignment of such letters patent, or share or interest therein, or of the license or proprietorship, as therein expressed: Provided always, that until such entry shall have been made, the grantee or grantees of the letters patent shall be deemed and taken to be the

sole and exclusive proprietor or proprietors of such letters patent, and of all the licenses and privileges thereby given and granted; and such register or a copy shall be open to public inspection, subject to such regulations as the Governor in Council may make.

32. *Certified copies to be evidence.* The Governor in Council may cause a seal to be made for the purposes hereinafter mentioned; and all courts, judges, and other persons whomsoever shall take notice of such seal, and receive impressions thereof in evidence in like manner as impressions of the seal of the colony are received in evidence; and copies or extracts, certified and sealed with such seal, of letters patent, specifications, disclaimers, memoranda of observations, and all other documents or books recorded, filed, and kept in pursuance of this Act, shall be received in evidence in all proceedings relating to letters patent for inventions in all courts, and by all judges and other persons whomsoever.

33. *Falsification or forgery of entries.* If any person shall willfully make or cause to be made any false entry in any such register, or shall willfully make or forge or cause to be made or forged any writing falsely purporting to be a copy of any entry in the said book, or shall produce or tender or cause or suffer to be produced or tendered in evidence any such writing, knowing the same to be false or forged, he shall be guilty of a misdemeanor, and shall be liable to be imprisoned for any term not exceeding five years.

34. *Entries may be expunged.* If any person shall deem himself aggrieved by any entry made under color of this Act in any such register, it shall be lawful for such person to apply by motion to the Supreme Court in term time, or by summons to a judge of such court in vacation, for an order that such entry may be expunged vacated, or varied; and upon any such application such court or judge may make such order for expunging, vacating, or varying such entry, and as to the costs of such application, as to such court or judge may seem fit; and the officer having the care and custody of such register, on the production to him of any such order, shall expunge, vacate, or vary the said entry according to such order.

35. *Penalty for unauthorized user of the word "patent."* If any person shall write, paint, print, mould, cast, carve, engrave, stamp, or otherwise mark upon anything made, used, or sold by him, for the sole making or selling of which he has not or shall not have obtained letters patent, the name or any imitation of the name of any other person who has or shall have obtained letters patent for the sole making and vending of such thing, without leave in writ-

ing of such patentee or his assigns, or if any person shall upon such thing, not having been purchased from the patentee, or some person who purchased it from or under such patentee, or not having had the license or consent in writing of such patentee or his assigns, write, paint, print, mould, cast, carve, engrave, stamp, or otherwise mark the word "patent," the words "letters patent," or the words "by the Queen's patent," or any words of the like kind, meaning, or import, with a view of imitating or counterfeiting the stamp, mark, or other device of the patentee, he shall for every such offense forfeit and pay the sum of one hundred pounds, one-half to Her Majesty, her heirs and successors, and the other half with full costs of suit to any person who shall sue for the said penalty by action of debt: Provided always, that nothing herein contained shall be construed to extend to subject any person to any penalty in respect of stamping or in any way marking the word "patent" upon anything for the sole making or vending of which letters patent before obtained shall have expired or otherwise determined.

36. *In Actions for infringement, particulars of breaches and objections to be delivered.* In any action for the infringement of letters patent the plaintiff shall deliver with his declaration particulars of the breaches complained of in the said action, and the defendant on pleading thereto shall deliver with his pleas, and the prosecutor in any proceeding by scire facias to repeal letters patent shall deliver with his declaration, particulars of any objections on which he means to rely at the trial in support of the pleas in the said action, or of the suggestions of the said declaration in scire facias respectively; and at the trial of such action or proceeding by scire facias no evidence shall be allowed to be given in support of any alleged infringement or of any objection impeaching the validity of such letters patent which shall not be contained in the particulars delivered as aforesaid: Provided always, that the place or places at or in which and in what manner the invention is alleged to have been used or published prior to the date of the letters patent shall be stated in such particulars: Provided also, that it shall and may be lawful for any judge at chambers to allow such plaintiff or defendant or prosecutor respectively to amend the particulars delivered as aforesaid, upon such terms as to such judge shall seem fit. Provided also, that at the trial of any proceeding by scire facias to repeal letters patent the defendant shall be entitled to begin and to give evidence in support of such letters patent; and in case evidence shall be adduced on the part of the

prosecutor impeaching the validity of such letters patent, the defendant shall be entitled to the reply.

37. *Particulars to be regarded in taxing costs.* In taxing the costs in any action for infringing letters patent regard shall be had to the particulars delivered in such action, and the plaintiff and defendant respectively shall not be allowed any costs in respect of any particular unless certified by the judge before whom the trial was had to have been proved by such plaintiff or defendant respectively, without regard to the general costs of the cause; and it shall be lawful for the judge before whom any such action shall be tried to certify on the record that the validity of letters patent in the declaration mentioned came in question; and the record with such certificate being given in evidence in any suit or action for infringing the said letters patent, or in any proceeding by scire facias to repeal the letters patent, shall entitle the plaintiff in any such suit or action, or the defendant in such proceeding by scire facias, on obtaining a decree, decretal order, or final judgment, to his full costs, charges, and expenses to be taxed as between attorney and client, unless the judge making such decree or order, or the judge trying such action or proceeding, shall certify that the plaintiff or defendant respectively ought not to have such full costs.

38. *Fees on obtaining patents.* There shall be paid in respect of letters patent applied for or issued as herein mentioned, the depositing of specifications, disclaimers, and memoranda of alterations, warrants, certificates, entries, and searches, and other matters and things respectively mentioned in the ninth schedule of this Act, such fees as are enumerated in that schedule; and such of the said fees as are thereby made payable to the law officer shall and may be received and retained by such law officer for his own proper use; and the residue thereof shall form part of the the consolidated revenue of Victoria, and be paid, applied, and disposed of accordingly.

39. *English patents to be subject to this Act.* All letters patent which shall have been or which shall be granted in the United Kingdom of Great Britain and Ireland after the thirty-first day of December in the year of our Lord one thousand eight hundred and fifty-seven, for any invention, shall, so far as the same relate to Victoria and its dependencies, be and be deemed to have been utterly void and of none effect, and in nowise be put in execution; but all such letters patent granted in the said United Kingdom on or before that day, and which would be or would have been valid

in Victoria if this Act or any other Act relating to letters patent heretofore in force in Victoria had not been passed, shall be deemed and taken to have been granted under this Act, and may be dealt with accordingly.

SCHEDULES.

SCHEDULE I.

Section 2.

Date of Act.	Title of Act.	Extent of Repeal.
18 Vict. No. 1 ..	"An Act to protect the rights of inventors " of articles at the Exhibition in Victoria " of one thousand eight hundred and " fifty-four."	The whole.
20 Vict. No. 3 ..	"An Act concerning Letters Patent for In- " ventions."	The whole.

SCHEDULE II.

Section 7.

To all to whom these presents shall come, I [John Doe, of Taradale, in the county of Talbot, engineer,] send greeting:

Whereas I am desirous of obtaining Royal letters patent for securing unto me Her Majesty's special license that I, my executors, administrators, and assigns, and such others as I or they should at any time agree with, and no others, should and lawfully might from time to time, and at all times during the term of fourteen years (to be computed from the day on which this instrument shall be left at the office of the *registrar-general*), make, use, exercise, and vend within the colony of Victoria and its dependencies an invention for [*insert the title of the invention*]; and in order to obtain the said letters patent I must by an instrument in writing under my hand and seal particularly describe and ascertain the nature of the said invention, and in what manner the same is to be performed, and must also enter into the covenant hereinafter contained: Now know ye, that the nature of the said invention, and the manner in which the same is to be performed, is particularly described and ascertained in and by the following statement; (that is to say,) [*describe the invention*]. And I do hereby, for myself, my heirs, executors, and administrators, covenant with Her Majesty, her heirs, and successors, that I believe the said invention to be a new invention as to the public use and exercise thereof, and that I do not know or believe that any other person than myself is the true and first inventor of the said invention, and that I will not deposit these presents at the office of the *registrar-general* with any such knowledge or belief as last aforesaid.

In witness, &c.

SCHEDULE III.

Section 9.

Patent for [*insert the title of the specification*]. This is to notify that *A. B.* of &c., did on the day of instant [*or* last] deposit at the office of the *registrar-general* in Melbourne a specification or instrument in writing under his hand and seal particularly describing and ascertaining the nature of the said invention, and in what manner the same is to be performed, and that by reason of such deposit the said invention is protected and secured to him exclusively for the term of six calendar months thence next ensuing; and I do further notify that the said *A. B.* has given notice in writing at my chambers of his intention to proceed with his application for letters patent for the said invention, and that I have appointed [*Thursday*] the day of next, at o'clock in the noon, at my chambers to hear and consider the said application and all objections thereto; and I do hereby require all persons having an interest in opposing the grant of such letters patent to leave on or before the day of at my chambers in Melbourne particulars in writing of their objections to the said application, otherwise they will be precluded r om urging the same.

Given under my hand this day of 18 .

T. H. F.,
General.

SCHEDULE IV.

Section 10.

Upon hearing the objection of *A. B.* to grant to *C. D.* of letters patent for [*insert the title as in the specification*], I do by this writing under my hand order that the said *A. B.* shall pay to the said *C. D.* the sum of for the costs of such hearing [*or* to *E. F.* the sum of as a remuneration for his attendance at such hearing].

Given under my hand this day of 18 .

G. H.,
General.

SCHEDULE V.

Section 11.

I have heard and considered the application of *A. B.* for letters patent for [*insert the title as in the specification*], and also all objections to the same, and having perused the specification and the usual and necessary advertisements, am of opinion that as it is entirely at the hazard of the said applicant whether the said invention is new and will have the desired success, Her Majesty's Royal letters patent may be issued in the form contained in the sixth schedule to the "Patents Statute, 1865," [with the following additional clauses (that is to say,) *here set them out if any*].

Given under my hand and seal this day of

(L. S.) W. F. S.,
General.

SCHEDULE VI.

Section 13.

ictoria, by the Grace of God, of the United Kingdon of Great Britain and Ireland Qu n, Defender of the Faith, to all to whom these presents shall come, greeting:

Whereas *A. B.* of in the county of , engineer, hath represented that he is desirous of obtaining our Royal letters pateut for securing unto him our special license that he, his executors, administrators, and assigns, and such others as he or they should agree with, aud no others, should and lawfully might make, use, exercise, and vend within our Colony of Victoria and its dependencies an invention for [*insert the title of the invention*]; and by an instrument in writing under his hand and seal, deposited in the office of the *registrar-general*, the said *A. B.* hath particularly described aud ascertained the nature of the said invention, and in what manuer the saue is to be performed; and we, being willing to give encouragement to all arts and inventions which may be for the public good, are graciously pleased to confer upon the said *A. B.* the privileges hereinafter mentioned: Know ye, therefore, that we, of our especial grace, certain knowledge, and mere motion, have given and granted, and by these presents, for us, our heirs, and successors, do give and grant unto the said *A. B.*, his executors, administrators, and assigns, our special license, full power, sole privilege, and authority that he the said *A. B.*, his executors, administrators, and assigns, and every of them, by himself and themselves, or his and their deputy or deputies, servants or agents, or such others as he or they shall at any time agree with, and no others during the term herein expressed, shall and lawfully may make, use, exercise, and vend his said invention within our said colony and its dependencies, in such manner as to him, his executors, administrators, and assigns, or any of them shall seem meet, and that he, his executors, administrators, and assigns, shall and lawfully may have and enjoy the whole profit, benefit, commodity, and advantage, from time to time coming, growing, accruing, and arising by reason of the said invention during the said term; to have, hold, exercise, and enjoy the said licenses, powers, privileges, and advantages unto and by the said *A. B.*, his executors, administrators, and assigns, for and during and unto the full end and term of fourteen years now next ensuing; and to the end that he, his executors, administrators, and assigns, and every of them, may have and enjoy the full benefit and the sole use and exercise of the said invention according to our gracious intention, we do by these presents, for us, our heirs and successors require and strictly command all and every person and persons, bodies politic and corporate and all other our subjects whatsoever, of what estate, quality, degree, name, or condition soever they be, within our said colony and its dependencies, that neither they nor any of them at any time during the said term, either directly or indirectly, do make, use, or put in practice the said invention or any part of the same so attained unto by the said *A. B.* as aforesaid, nor in anywise counterfeit, imitate, or resemble the same, nor shall make or cause to be made any addition thereunto or subtraction from the same whereby to pretend himself or themselves the inventor or inventors, devisor or devisors thereof, without the consent, license, or agreement of the said *A. B.*, his executors, administrators, or assigns, in writing under his or their hands and seals first had and obtained in that behalf, upon such pains and penalties as can or may be justly inflicted on such offenders for their contempt of this our

royal command, and further to be answerable to the said *A. B.*, his executors, administrators, and assigns, according to law for his and their damages thereby occasioned: Provided always, and these letters patents are and shall be upon this condition, that is at any time during the said term hereby granted it shall appear that this our grant if contrary to law or prejudicial or inconvenient to our subjects in general, or that the said invention is not a new invention as to the public use and exercise thereof, or that the said *A. B.* is not the true and first inventor thereof within this colony or its dependencies, these our letters patent shall forthwith cease, determine, and be utterly void to all intents and purposes, anything hereinbefore contained to the contrary thereof, in anywise notwithstanding: Provided also, that these our letters patent, or anything herein contained, shall not extend or be construed to extend to give privilege unto the said *A. B.*, his executors, administrators, or assigns, or any of them, to use or imitate any invention or work whatsoever which hath heretofore been found out or invented by any other of our subjects whatsoever and publicly used or exercised unto whom or like letters patent or privileges have been already granted for the sole use, exercise, and benefit thereof, within our said colony or its dependencies, it being our will and pleasure that the said *A. B.*, his executors, administrators, and assigns, and all and every other person and persons to whom like letters patent or privileges have been already granted as aforesaid, shall distinctly use and practice their several inventions by them invented and found out according to the true intent and meaning of the same respective letters patent and of these presents: Provided likewise nevertheless, and these our letters patent are upon this express condition, that if the said instrument in writing does not particularly describe and ascertain the nature of the said invention, and in what manner the same is to be performed, and also, if the said *A. B.*, his executors, administrators, or assigns, shall not pay at the office of the *registrar-general* of our said colony the sum of fifteen pounds within three years next after the date of these presents, and the sum of twenty pounds within seven years next after such date, and also if the said *A. B.*, his executors, administrators, or assigns, shall not supply or cause to be supplied for our service all such articles of the said invention as he or they shall be required to supply by the persons administering the department of our service for the use of which the same shall be required, in such manner, at such times, and at and upon such reasonable prices and terms as shall be settled for that purpose by the said persons requiring the same, that then and in any of the said cases these our letters patent, and all liberties and advantages whatsoever hereby granted, shall utterly cease, determine, and become void, anything hereinbefore contained to the contrary thereof in anywise notwithstanding: Provided that nothing herein contained shall prevent the granting of licenses in such manner and for such considerations as they may by law be granted. And lastly, we do by these presents, for us, our heirs and successors, grant unto the said *A. B.*, his executors, administrators, and assigns, that these our letters patent shall be in and by all things, good, firm, valid, and sufficient and effectual in the law, according to the true intent and meaning thereof, and shall be taken, construed, and adjudged in the most favorable and beneficial sense, for the best advantage of the said *A. B.*, his executors, administrators, and assigns, as well in all our courts of record as elsewhere, and by all and singular the officers and ministers whatsoever, of us, our heirs and successors, in our said colony and its dependencies, and amongst all and every the subjects of us, our heirs and successors whatsoever and wheresoever, notwithstanding the not full and certain describing the nature or quality of the said invention, or of the materials

thereunto conducing and belonging. In witness whereof we have caused these our letters to be made patent, and to be sealed and bear date as of the day of

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Schedule VII.

Section 20.

Patent for [*insert the title*]. This is to notify to all whom it may concern, that *C. D.*, of &c., has applied to me for leave to enter a disclaimer of part [*or* memorandum of alteration, *as the case may be*] of the said invention, the particulars whereof are stated below; I do therefore appoint [*Thursday*], the day of next, at o'clock in the noon, to hear and consider the said application and all objections to the same; and I do hereby require all persons having an interest in opposing the said application to leave on or before the day of at my chambers in Melbourne particulars in writing of their objections to the same, otherwise they will be precluded from urging such objections.

Given under my hand, this day of .

W. F. S.,
General.

The following is the disclaimer [*or as the case may be*] which I desire to make in, &c. [*The applicant must here set forth what he wishes to enter, and sign it*].

Schedule VIII.

Section 27.

Patent for [*insert the title*]. Notice is hereby given, that I have presented a petition to his Excellency the Governor, praying for the confirmation of [*or* extension of the term in] the said patent, and that a royal commission has issued authorizing and requiring certain commissioners therein named to consider and report upon the subject to Her Majesty, which said commissioners will meet for that purpose on the day of next, at o'clock in the noon, at . All persons objecting to the said confirmation [*or* extension] must enter a caveat against the same, at the office of the *registrar-general* in Melbourne, otherwise they will be precluded from objecting to it.

Dated this day of

A. B.

Schedule IX.

Section 38.

	£	s.	d.
On depositing specification.....	2	10	0
To the law officer for any "appointment".....	2	4	6
On obtaining letters patent.....	2	10	0
At or before the expiration of the third year.....	15	0	0
At or before the expiration of the seventh year.....	20	0	0
To the law officer with particulars of objections.....	2	4	6
On presenting petition for extension or confirmation.....	2	10	0
Every search and inspection.....	0	1	0

Entry of assignment or license.....	0	10	0
Certificate of assignment or license.....	0	10	0
Filing of memorandum of alteration or disclaimer.....	2	10	0
Entering any caveat.....	2	10	0
Copy or extract of any writing per common law folio.....	0	1	0

From *Carpm. Pat. L. of World*, 615.

An act to amend the laws concerning Letters Patent for Inventions. No. DCCCVIII. December 12, 1884.

Be it enacted by the Queen's Most Excellent Majesty, by and with the advice and consent of the Legislative Council and the Legislative Assembly of Victoria in this present Parliament assembled, and by the authority of the same, as follows—that is to say :

1. This Act may for all purposes be cited as "The Patents Act, 1884" and shall be read and construed as one with "The Patent Statute 1865," (hereinafter referred to as the "Principal Act") as amended by the Act No. CCCCXXXII, except so far as such construction would be inconsistent with or repugnant to the provisions of this act.

2. In this Act and the principal Act the word "patentee" shall mean the person for the time being entitled to the benefit of any letters patent in Victoria, and the words "the true and first inventor" shall mean the person who is the actual inventor or his nominee or assignee, and shall not include the unauthorized importer of an invention from elsewhere.

3. The acts specified in the first schedule hereto shall be and the same are hereby repealed to the extent specified in the third column of the said schedule : Nothing herein contained shall affect any proceedings or things lawfully taken, done, or commenced, or any letters patent granted, or any protection or right conferred, or any register or appointment made, or any notice of particulars given or published, or any warrant issued, or caveat entered under any of the repealed portions of the said Acts, before the passing of this Act ; and all such proceedings and things shall be as valid and may be continued, and all such letters patent, protections, rights, registers, appointments, notices, particulars, warrants, and caveats shall have the same force and efficacy as if this Act had not been passed. When letters patent have been granted to any person before the passing of this Act, or shall in respect of any application

made before the passing of this Act be hereafter granted to any person for any invention, such person shall with respect to all matters and things which might lawfully have been done, and with respect to all fees which might lawfully have been paid after the passing of this Act, be entitled to avail himself of the provisions of this Act as if this Act had been passed before the grant of such letters patent.

Mode of Obtaining Letters Patent.

4. In section 6 of the principal Act the words "twelve months shall be substituted for the words "six months," wherever the same occur in the said section.

5. For the purposes of the hearing and consideration of any application in accordance with the provisions of section 10 of the principal Act, the law officer may by summons under his hand require the attendance of all such persons as he thinks fit to call before him for examination, and may under his hand order to be paid by the applicant or objector to such persons such remuneration for their attendance as to him may seem reasonable. In opposed cases where applicants and objectors consent the law officer may hear all the parties in the presence of one another.

6. If any person whose attendance has been so required and on whom any such summons has been served by the delivery thereof to him or by the leaving thereof at his usual place of abode, neglect or fail to appear or refuse to make answer to such questions as are put to him touching such application as aforesaid, such person shall forfeit and pay a penalty not exceeding twenty pounds, to be recovered by any person authorized so to do by the law officer in a summary way before a justice of the peace.

7. If any applicant for a grant of letters patent be dissatisfied with the refusal of the law officer to issue his warrant for the granting of letters patent, such applicant may appeal to the Supreme Court, and the mode of such appeal and all matters relating to pleading, practice, and procedure therein shall be in accordance with rules of court for the time being in force. For the purpose of regulating such appeals the Supreme Court may at any time, with a concurrence of a majority of the judges thereof present at any meeting for that purpose held, make rules of court, and may from time to time annul any such rules and make further or additional rules; and the Supreme Court may direct a warrant for the granting of letters patent, and such warrant shall be to all intents and

puposes as valid and effectual as though it were a warrant for the granting of letters patent for an invention under the hand and seal of the law officer.

8. Notwithstanding anything in any Act of Parliament contained, where any patent or like privilege for the monopoly or exclusive use or exercise in any parts out of Victoria and its dependencies has been obtained for or in respect of any invention first invented in parts out of Victoria and its dependencies, letters patent may be granted for or in respect of such invention at any time within one year from the date of the granting of the first of any such patents or privileges for such monopoly, exclusive use, or exercise as aforesaid, notwithstanding that such invention has been used or published in Victoria within such period of one year, and such letters patent, when granted, shall have the same force and effect as if such prior publication or use had not taken place: Provided, however, That if such use or publication have been made in Victoria with the consent of the inventor, such inventor shall not be entitled to a grant of letters patent under the authority of this section.

9. (1.) If the Governor in Council is pleased to make any arrangement with the government or governments of any Australian colony, or with the government of the colony of New Zealand, or of the colony of Fiji for the mutual protection of inventions, then any person who has applied for the protection of any invention in any such colony shall be entitled to a patent for his invention under this Act in priority to other applicants, and such patent shall have the same date as the date of the protection obtained in such colony: Provided, That his application is made within six months from his applying for protection in the colony with which the arrangement is in force: Provided, That nothing in this section contained shall entitle such person to recover damages for infringements happening prior to the date of the actual acceptance of his complete specification in Victoria.

(2.) The publication in Victoria during the period aforesaid of any description of such invention, or the use therein during such period of invention (whether with or without the consent of such person as aforesaid), shall not invalidate the patent which may be granted for the invention.

(3.) The application for a grant of a patent under this section must be made in the same manner as an ordinary application under this Act.

(4.) The provisions of this section shall apply only to such of the colonies aforesaid with respect to which the Governor shall from time to time by order in Council declare them to be applicable, and so long only in the case of each colony as the order in Council shall continue in force with respect to that State.

10. Where Her Majesty has by order in Council applied the provisions of section 103 of an Act of the Imperial Parliament, called "The Patents, Designs, and Trade-Marks Act, 1883," or any portion thereof, to Victoria, the provisions of the last preceding section may, by order of the Governor in Council, be applied for the protection of inventions patented in the United Kingdom or Isle of Man: Provided, That such order in Council may be at any time revoked.

Extension of Term and Confirmation of Invalid Patents.

11. Where any commissioners have been appointed by the Governor in Council, under Part III. of the principal Act, to consider the petition of any person for the confirmation of letters patent, or for the grant of new letters patent, or for an extension of the term in any letters patent mentioned, such commissioners may, if in their report to Her Majesty, her heirs and successors, they recommend that such confirmation, grant, or extension should not be made, also recommend that all the costs and expenses of or relating to the consideration of such petition by the commissioners, and of and relating to the appearance of the law officers of the Crown and the crown solicitor to oppose the prayer of such petition, shall be borne by such petitioner; and the Governor in Council may thereupon make an order that such costs and expenses, or any part thereof as he thinks fit, shall be borne by such petitioner.

Miscellaneous Provisions.

12. Any person who writes, paints, prints, molds, casts, carves, engraves, stamps, or otherwise marks upon anything made, used or sold by him, and for the sole making or selling of which he has not obtained letters patent, the name or any imitation of the name of any other person who has, as patentee, obtained letters patent for the sole making and selling of such thing, without leave in writing of such patentee or his assigns, or who, upon such thing not having been purchased from the patentee or some person who purchased it

from or under such patentee, or not having had the license or consent in writing of such patentee or his assigns, writes, paints, prints, molds, casts, carves, engraves, stamps, or otherwise marks the word "patent" or "patented," or the words "letters patent," "royal letters patent," or "Queen's patent," or any word or words of like import, with the intent of counterfeiting or imitating the stamp, mark, or device of the patentee, or of deceiving the public and inducing them to believe that the thing in question was made or sold by or with the consent of the patentee, or who puts to sale as patented any article not patented in Victoria, for the purpose of deceiving the public, shall be guilty of a misdemeanor, and on conviction thereof be liable to a fine not exceeding one hundred pounds or imprisonment for a period not exceeding three months.

13. Whenever, through inadvertence, accident, or mistake, and without any willful default or intent to defraud or mislead the public, any person who has, as patentee, obtained letters patent for the sole making and selling of anything, has (in his specification) claimed to be the true and first inventor or discoverer of any material or substantial part of the thing patented of which he was not the true and first inventor as aforesaid, every such patentee, his executors, administrators, and assigns, whether of the whole or any interest in such letters patent, may maintain a suit at law or in equity for the infringement of any part thereof which was *bona fide* his own, provided it be a material and substantial part of the invention in respect of which the letters patent were rightfully granted, and that it be definitely distinguishable from the parts so claimed without right as aforesaid, notwithstanding the specifications may embrace more than that of which such patentee was the true or first inventor or discoverer; but in every such case in which judgment is given or a decree is made for the plaintiff, no costs shall be recovered unless the proper disclaimer has been entered at the chambers of the law officer before the commencement of the action or suit, nor shall he be entitled to the benefit of this section if he have unreasonably neglected or delayed to enter said disclaimer.

14. A patent shall have to all intents the like effect as against her Majesty the Queen, her heirs, and successors, as it has as against a subject, but the minister at the head of any department of the public service may use for the public service any patented article or any patented manufacturing process on such terms as may be agreed on with the patentee of such article or process, or in default of such agreement on such terms as may be settled by arbitration

conducted under regulations to be made by the Governor in Council.

REVOCATION.

15. (1.) The proceeding by scire facias to repeal a patent is hereby abolished.

(2.) Revocation of a patent may be obtained on petition to the Supreme Court.

(3.) Every ground on which a patent might, at the commencement of this act, be repealed by scire facias shall be a ground of revocation.

(4.) A petition for revocation of a patent may be presented by—

(*a.*) The law officer;

(*b.*) Any person authorized by the law officer;

(*c.*) Any person alleging that the patent was obtained in fraud of his rights, or of any person under or through whom he claims;

(*d.*) Any person alleging that he, or that any person under or through whom he claims, was the true inventor of any invention included in the claim of the patentee;

(*e.*) Any person alleging that he, or any person under or through whom he claims an interest in any trade, business, or manufacture, had publicly manufactured, used, or sold, within this realm, before the date of the patent, anything claimed by the patentee as his invention.

(5.) The plaintiff must deliver with his petition particulars of the objections on which he means to rely, and no evidence shall, except by leave of a judge of the court, be admitted in proof of any objection of which particulars are not so delivered.

(6.) Particulars delivered may be from time to time amended by leave of the court in which such action is pending or a judge thereof.

(7.) The defendant shall be entitled to begin, and give evidence in support of the patent, and if the plaintiff gives evidence impeaching the validity of the patent the defendant shall be entitled to reply.

(8.) Where a patent has been revoked on the ground of fraud the law officer may, on the application of the true and first inventor made in accordance with the provisions of this Act, grant to him a patent in lieu of and bearing the same date as the patent so revoked; but the patent so granted shall cease on the expiration of the term for which the revoked patent was granted.

Legal Proceedings.

16. (1.) In an action for infringement of a patent, the judge who is trying the action may, if he thinks fit, and shall on the request of either of the parties to the proceeding, call in the aid of an assessor specially qualified and try and hear the case wholly or partially with his assistance. The action shall be tried without a jury, unless the court shall otherwise direct.

(2.) A judge of any court having jurisdiction to deal with matters and things relating to letters patent may, if he sees fit, in any proceeding before him call in the aid of an assessor as aforesaid.

(3.) The remuneration, if any, to be paid to an assessor under this section shall be determined by the judge or judges who have called such assessor to his or their aid, and be costs in the cause.

17. (1.) In an action for infringement of a patent the plaintiff shall deliver with his statement of claim, or by order of a judge of the court in which such action is brought at any subsequent time, particulars of the breaches complained of.

(2.) The defendant on pleading thereto shall deliver with his statement of defense, or by order of the Supreme Court or a judge thereof at any subsequent time, particulars of any objections on which he relies in support thereof.

(3.) If the defendant disputes the validity of the patent, the particulars delivered by him must state on what grounds he disputes it, and if one of those grounds is want of novelty, must state the time and place of the previous publication or user alleged by him.

(4.) At the hearing no evidence shall, except by leave of the judge, be admitted in proof of any alleged infringement or objection of which particulars are not so delivered.

(5.) Particulars delivered may be from time to time amended by leave of the court in which the action is then pending or a judge thereof.

(6.) On taxation of costs, regard shall be had to the particulars delivered by the plaintiff and by the defendant, and they, respectively, shall not be allowed any costs in respect of any particular delivered by them unless the same is certified by the court in which the action was tried, or a judge thereof, to have been proven, or to have been reasonable and proper, without regard to the general costs of the case.

18. In an action for infringement of a patent, the court in which such action is pending, or a judge thereof, may on the application of either party, make such order for an injunction, inspection, or account, and impose such terms and give such directions respecting the same and the proceedings thereon as the said court or such judge may see fit.

19. In an action for infringement of a patent, the court in which the action was tried, or a judge thereof, may certify that the validity of the patent came in question, and if such court or judge so certifies, then in any subsequent action for infringement the plaintiff in that action, on obtaining a final order or judgment in his favor, shall have his full costs, charges, and expenses, as between solicitor and client, unless such court or judge before whom the action was tried certifies that he ought not to have the same.

20. Every patent may be in the form in the second schedule to this Act, and shall be granted for one invention only, but may contain more than one claim; but it shall not be competent for any person in an action or other proceeding to take any objection to a patent on the ground that it comprises more than one invention.

21. If a person possessed of an invention dies without making application for a patent for the invention, application may be made by and a patent for the invention granted to his legal representative. Every such application must be made within six months of the decease of such person, and must contain a declaration by the legal representative that he believes such person to be the true and first inventor of the invention.

22. The exhibition of an invention at an industrial or international exhibition, or the publication of any description of the invention during the period of the holding of the exhibition, or the use of the invention for the purpose of the exhibition in the place where the exhibition is held, or the use of the invention during the period of the holding of the exhibition by any person elsewhere without the privity or consent of the inventor, shall not prejudice the right of the inventor or his legal personal representative to apply for and obtain provisional protection and a patent in respect of the invention or the validity of any patent granted on the application: Provided, That both the following conditions are complied with, namely;

(*a.*) The exhibitor must, before exhibiting the invention, give the law officer one month's notice of his intention to do so; and,

(*b.*) The application for a patent must be made before or within twelve months from the date of the opening of the exhibition.

23. The Governor in Council may, subject to the provisions of this act, from time to time, make, alter and repeal rules and regulations to regulate the issue of licenses to persons to practice as agents for the procuring and taking out of letters patent for inventions, and fixing the amount or fee to be charged for each such license per annum.

24. The second and third schedules to this Act shall be respectively substituted for the sixth and third schedules to the principal Act.

25. The fees set out in the fourth schedule to this Act shall be payable for and in respect of the matters and things therein mentioned in lieu of the fees prescribed by the ninth schedule to the principal Act, and the said fourth schedule hereto shall be substituted for the said ninth schedule to the principal Act.

Notwithstanding anything in the principal Act contained, a fee due in respect of letters patent for any invention at the expiration of the third or seventh year from the date therefrom, may be paid at any time within six months of such due date on payment of an additional fee by way of penalty of two pounds and ten shillings, and may be paid at any time within twelve months of such due date on payment of an additional fee by way of penalty of ten pounds; and on payment of such fee and penalty the powers and privileges granted by such letters patent shall be as good and effectual to all intents and purposes as though such fee had been paid on such due date as aforesaid.

From 32 *Pat. Off. Gaz.* 774.

VIRGIN ISLANDS.

See LEEWARD ISLANDS.

WALES.

See GREAT BRITAIN AND IRELAND.

WESTERN AUSTRALIA.

An Act to Regulate Grants of Patents for Inventions in the Colony of Western Australia. *No.* 1, *Aug.* 15, 1872.

Whereas it is expedient to make provision for granting patents for inventions in the Colony of Western Australia: Be it therefore enacted by His Excellency the Governor of Western Australia and its dependencies, by and with the advice and consent of the Legislative Council thereof, as follows:—

1. *Holder of letters patent under this Act entitled to same privileges as patentees in England.* From and after the passing of this Act, any person to whom, as the originator or discoverer of any new invention or improvement in the arts or manufactures, His Excellency the Governor shall, according to the provisions hereinafter contained, grant letters patent, or an instrument in the nature of letters patent, shall have within the said Colony of Western Australia, for a term of fourteen years next after the granting of such letters patent or instrument, the exclusive enjoyment and advantage in the said colony of such invention or improvement, and such and the same protection, and such and the same remedies at law and in equity against any person in the colony infringing the said letters patent or instrument, and generally such and the same rights, powers, and privileges throughout the said colony, with respect to the invention for which such letters patent or instrument shall be granted, as any person to whom letters patent for a new invention have been granted under the Great Seal of England has by the law of England in and throughout the realm of England (save so far as such protection, remedies, rights, powers, and privileges may be inconsistent with the provisions of this Act): Provided that so much of the provisions contained in an Act of the United Parliament of Great-Britain and Ireland passed in the session of the fifth and sixth years of the reign of His late Majesty King William the Fourth, entitled "An Act to amend the law touching letters letters patent for inventions," as relates to the confirming of letters patent or granting new letters patent to a patentee acting under an erroneous belief that he was the first and original inventor, and for the prolongation of letters patent, and the several provisions contained in an Act of the United Parliament of

Great Britain and Ireland passed in the session of the fifteenth and sixteenth years of the reign of Her present Majesty, entitled "An Act for amending the law for granting patents for inventions," shall not be deemed applicable to the Colony of Western Australia: Provided further, that any of the penalties recoverable by any person holding letters patent under the Great Seal of England in any court of Great Britain, under the said first-mentioned Act, for any unauthorized person using or imitating the name of any such patentee, or using the word "patent," or the like words, or counterfeiting the mark of any such patentee, may be recoverable and recovered in similar courts in the said colony by any person to whom letters patent, or an instrument in the nature of letters patent, shall be granted under the provisions hereof, or by his assignee, for similar injuries to such last mentioned patentee or his assignee in the said colony.

2. *Mode of application for letters patent.* Any person being the originator or discoverer of any new invention or improvement as aforesaid, for which no patent or instrument in the nature of letters patent has been issued in Western Australia or any other country, and being desirous of obtaining letters patent or an instrument as aforesaid under this act, shall deposit with the colonial treasurer the sum of twenty-five pounds, and leave in the office, or in the custody of such person as the Governor may appoint, a petition addressed to His Excellency, stating clearly and succinctly the ob ject to be attained by his invention or discovery, setting forth that he has deposited the sum of twenty-five pounds as aforesaid, and praying that letters patent, or an instrument as aforesaid, may be granted to him for the exclusive use thereof in the said colony; and every such person shall also send with his said petition a written specification, signed by him, of his invention or discovery, and of the manner and process of making, constructing, using, and compounding the same, in such terms, avoiding unnecessary prolixity, as to enable any person skilled in the art or scheme to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the same; and in case of any machine, a statement of the principle and of the several modes in which he has contemplated the application of that principle or character by which it may be distinguished from other inventions; and shall in the said specification particularly specify and point out the part, improvement, or combination which he claims as his own invention and discovery: he shall also send a drawing and written

references, where the nature of the case admits, of drawings or specimens of ingredients, and of the composition of matter, sufficient in quantity for the purpose of experiment, when the invention or discovery is a composition of matter; and he shall moreover, if required by such person so appointed as aforesaid, furnish with the said petition a model of his invention, in all cases which admit of a representation by model, of a convenient size to exhibit advantageously its several parts; and he shall also send a solemn affirmation or declaration, made before some justice of the peace of the said colony (and which affirmation or declaration such justice is hereby authorized to take), that the petitioner is, as he believes, the first and true originator or discoverer of such new invention or improvement, and shall affirm or declare the object intended to be attained thereby.

3. *Notice of application to be published in Gazette.* The Governor in his discretion may thereupon cause notice of the said application to be inserted in the Government Gazette, and thereby require any person who may conceive that he would be prejudiced by the granting of such letters patent or instrument, to send within two months of the said publication to the office or address of such person so appointed as aforesaid, a statement in writting setting forth the grounds of such objection, subscribed with his proper name and address.

4. *Governor may refer objection to appointees who shall report to him.* It shall be lawful for the Governor, upon receipt within the time aforesaid of such objection, to refer the consideration thereof to one or more competent person or persons to be appointed by the said Governor, and also to direct the applicant for such letters patent or instrument, and the opponent of the grant or issue thereof, to attend before such person or persons so appointed, who shall investigate the said matter, and shall be at liberty to call to his or their aid such scientific or other witnesses as he or they may think fit, and to cause to be paid to such witnesses by the applicant such remuneration as he or they may direct; and such person or persons so appointed shall report to the Governor whether in his or their opinion such letters patent should be issued, and if any such objection shall be sustained, the said specification, drawings, and models shall be returned to the said applicant, and the said sum of twenty-five pounds shall be paid to Her Majesty as hereinafter mentioned.

5. *Costs of inquiry to be given.* It shall be lawful for such

person or persons so appointed, to whom the consideration of any such objection as aforesaid is referred, if he or they see fit, by certificate under his or their hand, to determine the amount of the costs of any hearing or inquiry upon such objection, and to order by and to whom such costs shall be paid; and if any such costs so ordered to be paid be not paid within seven days after the date of such order, every such order may be made a rule of the Supreme Court of such colony.

6. *If no objection, letters patent may be issued.* In case no objection shall be made to the issuing of the said letters patent or instrument within the time aforesaid, or in case such person or persons so appointed shall report that such letters patent or instrument should be issued, the Governor may direct, by writing under his hand, that such letters patent or instrument shall be issued by the colonial secretary or other proper officer, and shall thereupon cause such specifications, drawings, and models so sent as aforesaid, to be deposited with the colonial secretary of the said colony.

7. *Amount to be paid for letters patent.* The person applying for such letters patent or instrument shall, within one month after the issuing of such direction, pay into the office of the colonial treasury of the said colony and obtain a receipt for the sum of twenty-five pounds sterling, which sum and the said sum of twenty-five pounds, and all other moneys received by the colonial treasurer under this Act, shall be paid to Her Majesty, her heirs and successors, for the use of the said colony and in support of the government thereof.

8. *Colonial secretary to issue letters patent.* The colonial secretary or other proper officer, upon such directions as aforesaid, and production to him of the receipts of the colonial treasurer, shall forthwith cause letters patent to be prepared in the form in the schedule hereunto annexed marked A, and the Governor shall sign his name and cause the seal of the said colony to be annexed to such letters patent, and deliver the same to the person to whom the same shall be granted, or to his agent or legal representative.

9. *Letters patent to be delivered to colonial secretary.* The person to whom such letters patent shall be issued shall thereupon deliver or cause to be delivered the said letters patent at the office of the said colonial secretary, and the said letters patent shall be operative from the time of such delivery.

10. *More than ten persons may be interested in letters patent.* It shall be lawful for a larger number than ten persons to have a

legal or beneficial interest in any such letters patent or instrument in the nature of letters patent, issued under the provisions of this Act.

11. *Assignment of a patent and record thereof.* Every patent or instrument in the nature of letters patent granted under this Act shall be assignable in law either as to the whole interest or any undivided part thereof by any instrument in writing, which assignment, and also every grant and conveyance of the exclusive right under any patent to make and use and to grant to others to make and use the thing patented within the said colony, shall be recorded in the office of the colonial secretary within three months from the execution thereof upon payment by the assignee or grantee to the colonial treasurer of the sum of ten pounds.

12. *Injunction may be granted.* In any action in the Supreme Court of the said colony for the infringement of any letters patent, or instrument in the nature of letters patent, issued under the provisions of this Act, it shall be lawful for the court, as well in its common law as equity jurisdiction, or if the court be not sitting, then for a judge of such court, on the application of the plaintiff or defendant respectively, to make such order for an injunction, inspection, or account, and to give such direction respecting such action, injunction, inspection, and account, and the proceedings therein respectively, as to such court or judge shall seem fit.

13. *Letters patent may be repealed by scire facias.* Any letters patent or instrument in the nature of letters patent granted by virtue of this Act shall be liable to be repealed by writ of scire facias for the same causes and in the same manner as any grants of the crown are liable to be repealed.

14. *Letters patent and specifications, &c., to be enrolled.* The said colonial secretary shall cause both the said letters patent and description to be kept in his office, and shall also cause a book to be kept in his office containing an index to all such letters patent, or instruments which may be issued or assigned; the object to be attained by the invention to be protected thereby, the date thereof, the name of the person to whom the same is issued or assigned, and such description of the enrollment thereof as may be necessary to facilitate reference; and all persons whosoever may have access to the said books, and may inspect the same, and may have copies thereof, or of such parts thereof as they may require, certified by the colonial secretary, upon payment of reasonable expenses actually incurred in taking the same, and copies of, or extracts from the

said letters patent, instrument, and specification certified by the said colonial secretary to be true copies or extracts shall be received as evidence of the contents of the said letters patent, instrument, and specification respectively in all proceedings whatsoever.

15. *Specification may be corrected.* Whenever any patent or instrument in the nature of letters patent granted under the authority of this Act shall be inoperative or invalid by reason of defective or insufficient description or specification, or by reason of the patentee claiming, as his own invention, more than he had or shall have a right to claim as new, if the error has or shall have arisen by inadvertency, accident, or mistake, and without any fraudulent or deceptive intention, it shall be lawful for His Excellency the Governor, upon the surrender of such patent or instrument, and the payment to the colonial treasurer of the sum of ten pounds, to cause a new patent or instrument as aforesaid to be issued to the said inventor for the same invention for the residue of the period then unexpired for which the original patent was granted in accordance with the patentee's corrected description and specification, and in case of his death or any assignment by him made of the original patent a similar right shall vest in his executors, administrators, or assigns; and the patent so reissued, together with the corrected description and specification, shall have the same effect and operation in law on the trial of all actions hereinafter commenced for causes subsequently accruing as though the same had been originally filed in such corrected form before the issuing out of the original patent: And whenever the original patentee or his assignee shall be desirous of adding the description and specification of any new improvement of the original invention or discovery which shall have been originated or discovered by him subsequent to the date of his patent, he may, like proceedings being had in all respects as in the case of original applications, and on the further payment of twenty pounds in manner hereinbefore provided, have the same annexed to the original description and specification, and the colonial secretary shall certify on the margin of such annexed description and specification the time of its being annexed and recorded, and the same shall thereafter have the same effect in law to all intents and purposes as though it had been embraced in the original description and specification.

16. *Disclaimer may be entered.* Any person who shall obtain such letters patent or instrument, or his assignee, may, if he think fit, enter with the said colonial secretary (having first obtained the

permission in writing of the Governor) a disclaimer of any part of either the title of the invention or of the specification, stating the reason for such disclaimer, or may, with such permission as aforesaid, enter a memorandum of any alteration in the said title or specification, not being such disclaimer or such alteration as shall extend the exclusive right granted by the said letters patent or instrument, and such disclaimer or memorandum of alteration being deposited with the said colonial secretary shall be deemed and taken as part of such letters patent or instrument, or such specification, and subject to the several incidents thereof, in all courts of justice in the said colony: Provided that no such disclaimer or alteration shall be receivable as evidence in any action or suit (save and except in any proceeding by scire facias) pending at the time when such disclaimer or alteration was enrolled, but in every such action or suit the original title and specification alone shall be deemed and taken to be the title and specification of the invention for which the letters patent have been or shall have been granted.

17. *Punishment for false entries or false affirmations.* If any person shall willfully make or cause to be made any false entry or alteration in any register or assignment of patents or instruments as aforesaid, or in any specification, or shall willfully make or forge, or cause to be made or forged, any false writing purporting to be a copy of an entry in the said book, or of any such patents, instruments, or specifications, or shall produce or tender or cause to be produced or tendered in evidence any such writing, knowing the same to be false or forged, or shall willfully make any false affirmation before any justice of the peace respecting any of the matters concerning which an affirmation is hereby required to be made as aforesaid, he shall be guilty of a misdemeanor, and on conviction thereof shall be punished by fine and imprisonment at the discretion of the court.

18. *Foreign patentees or their assignees may obtain letters of registration.* No person shall receive a patent or an instrument in the nature of letters patent under this Act for an invention or discovery which has been previously patented in Great Britain, or any other country, but it shall be lawful for the Governor, in his discretion, on the application of any person being the holder or assignee of any patent granted or issued in Great Britain, or any other country, for any new discovery or invention, and upon such proof as the Governor may deem sufficient that such person is the *bonâ fide* holder or assignee of the said patent, and that the same

is in full force, and upon payment to the colonial treasurer of the sum of twenty-five pounds, to grant letters of registration under the seal of Western Australia to the holder of such patent as aforesaid, or his assignee, and such letters of registration shall be deposited in the office of the colonial secretary in the manner herein provided, and shall be deemed to be letters patent issued under this Act for such invention or improvement, and shall have the same force and effect as letters patent issued thereunder, and shall, unless repealed by writ of scire facias or otherwise, inure to the benefit of the holder during the continuance of the original patent in the country in which it was issued or granted, and no longer; and all the provisions of this Act shall apply to such letters of registration in the same way *mutatis mutandis* and as fully as to letters patent or an instrument in the nature of letters patent issued under this Act.

19. *Interpretation clause.* In the construction of this Act, the word "person" shall include bodies corporate and companies as well as individuals, unless the context be repugnant thereto.

20. *Royal Prerogative saved.* Nothing in this Act contained shall be deemed to interfere with Her Majesty's Royal Prerogative in granting or issuing or withholding the grant or issue of any letters patent.

From Carpm. Pat. L. of World, 641.

See also AUSTRALASIA.

WURTEMBERG.

A report by Mr. George Petre, of the British Legation, published December 2, 1883, in 4 *Pat. Off. Gaz.* 579, with an appendix, *Id.* 607, gives an extended account of the law and practice relative to patents which prevailed throughout Wurtemberg at the time of his writing; and which, presumably, continued in force until the adoption of the general law of July 1, 1877, for the German Empire, for which, see GERMAN EMPIRE.

INTERNATIONAL CONVENTION FOR THE PROTECTION OF INDUSTRIAL PROPERTY.*

Signed at Paris, March 20, 1883. Ratifications exchanged at Paris, June 6, 1884.

ARTICLE I. The Governments of Belgium, Brazil, Spain, France, Guatemala, Italy, Holland, Portugal, Salvador, Servia, and Switzerland, constitute themselves into a Union for the protection of industrial property.

[NOTE.†—*The following Governments have since adhered to the Convention in accordance with article XVI.:* Great Britain, (Order in Council, under § 103 of the Patents Act, dated June 26, 1884), Ecuador *and* Tunis.]

ART. II. The subjects or citizens of each of the contracting States shall, in all the other States of the Union, in matters concerning patents, industrial designs or models, trade and commercial

* A conference to establish an International Union, like the Postal Union, for the protection of patents, designs, models, trade-marks and trade-names, met in Paris, March 6, 1883, and adjourned after adopting a draft of a convention at a second sitting on March 13th. The main points were settled at the first conference held at Paris two years before. The convention then proposed was communicated by the French Government to the other participating States. Some of the particulars were objected to by several of the States, and it was to harmonize their views on these minor points that the second conference was held. A much larger number of governments was represented. Representatives were present from the United States, France, England, Italy, Spain, Portugal, Russia, Sweden and Norway, Holland, Belgium, Switzerland, Roumania, Servia, Luxemburg, Brazil, the Argentine Republic, Uruguay, Guatemala, and San Salvador. The plan is to have a union sitting at Berne, which will represent the States whose patent laws are sufficiently in harmony, and endeavor to secure greater assimilation, and the enjoyments of the rights possessed by citizens of each, by the citizens of all the others. One of the main points is, that a patentee or proprietor of a trade-mark or design, will have a prior right of registration throughout the Union. This will protect him against being forestalled by dishonest agents. Regulations for the protection of patentable devices, designs and trade-marks, during international exhibitions are recommended. The convention proposes, also, to protect trade-names without registration whether they form part of a trade mark or not. 8 Am. Annual Cyclopædia, 1883, tit. Patents.

† From Carpmaels' edition. Add St. Domingo; Sweden, Norway, Turkey.

marks and trade-names, enjoy the advantages that their respective laws now grant, or shall hereafter grant, to natives.

Consequently, they shall have the same protection as the latter, and the same legal remedy against any infringement of their rights, subject to the fulfillment of the formalities and conditions imposed on natives by the internal legislation of each State.

ART. III. Subjects or citizens of States not forming part of the Union, who are domiciled or have industrial or commercial establishments in the territory of any of the States of the Union, shall be assimilated to the subjects or citizens of the contracting States.

ART. IV. Any person who has duly lodged an application for a patent, an industrial design or model, or trade or commercial mark in one of the contracting States, shall enjoy, for lodging the application in the other States, and reserving the rights of third parties, a right of priority during the terms hereinafter stated.

Consequently, a subsequent application in any of the other States of the Union before the expiration of these periods shall not be invalidated through any acts accomplished in the interval, either, for instance, by another application, by publication of the invention, or by the working of it by a third party, by the sale of copies of the design or model, or by the use of the mark.

The above mentioned terms of priority shall be six months for patents, and three months for industrial designs and models and for trade and commercial marks. The terms will be increased by a month for countries beyond the sea.

ART. V. The introduction by the patentee into the country where the patent has been issued of objects manufactured in any of the States of the Union shall not entail forfeiture.

Nevertheless, the patentee shall remain subject to the obligation to work his patent in conformity with the laws of the country into which he introduces the patented objects.

ART. VI. Every trade or commercial mark duly deposited in the country of its origin shall be admitted for registration, and protected in like manner in all the other countries of the Union.

The country where the applicant has his chief establishment shall be deemed the country of origin.

If this chief establishment is not situated in one of the countries of the Union, the country to which the applicant belongs shall be deemed the country of origin.

The deposit may be refused if the object for which it is solicited is considered contrary to morality or public order.

ART. VII. The nature of the goods on which the trade or commercial mark is used can, in no case, be an obstacle to the registration of the mark.

ART. VIII. A trade-name shall be protected in all the countries of the Union, without the necessity of registration, whether it form part or not of a trade or commercial mark.

ART. IX. All goods illegally bearing a trade or commercial mark or trade-name may be seized on importation into those States of the Union where this mark or trade-name has a right to legal protection.

The seizure shall be effected at the request of either the public prosecutor or of the interested party, pursuant to the internal legislation of each country.

ART. X. The provisions of the preceding article shall apply to all goods falsely bearing the name of any locality as indication of their place of origin, when such indication is associated with a trade-name either fictitious or assumed with fraudulent intent.

Any manufacturer or merchant engaged in the manufacture or sale of such goods, established in the locality falsely designated as the place of origin, shall be deemed an interested party.

ART. XI. The high contracting parties agree to grant temporary protection to patentable inventions, to industrial designs or models, and trade and commercial marks, for articles exhibited at official or officially recognized international exhibitions.

ART. XII. Each of the high contracting parties agrees to establish a special department for industrial property, and a central office for the communication to the public of patents, industrial designs or models, and trade and commercial marks.

ART. XIII. An international office shall be organized under the name of the "Bureau International de l'Union pour la Protection de la Propriété Industrielle."

This office, the expense of which shall be defrayed by the governments of all the contracting States, shall be placed under the high authority of the Central Administration of the Swiss Confederation, and shall work under its supervision. Its functions shall be determined by agreement between the States of the Union.

ART. XIV. The present convention shall be submitted to periodical revisions, with a view to introducing improvements calculated to perfect the system of the Union.

To this end conferences shall be successively held in one of the

contracting States by delegates of the said States. The next meeting shall take place in 1885 at Rome.

ART. XV. It is agreed that the high contracting parties respectively reserve to themselves the right to make separately, between themselves, special arrangements for the protection of industrial property, in so far as such arrangements do not contravene the provisions of the present convention.

ART. XVI. States which have not taken part in the present convention shall be permitted to adhere to it at their request.

Such adhesion shall be notified officially through the diplomatic channel to the Government of the Swiss Confederation, and by the latter to all the others. It shall imply complete accession to all the clauses, and admission to all the advantages stipulated by the present convention.

ART. XVII. The execution of the reciprocal engagements contained in the present convention is subordinated, in so far as necessary, to the observance of the formalities and rules established by the constitutional laws of those of the high contracting parties who are bound to procure the application of the same, which they engage to do with as little delay as possible.

ART. XVIII. The present convention shall come into operation one month after the exchange of ratifications, and shall remain in force for an unlimited time, till the expiration of one year from the date of its denunciation.

This denunciation shall be addressed to the government commissioned to receive adhesions. It shall only affect the denouncing State, the convention remaining in operation as regards the other contracting parties.

ART. XIX. The present convention shall be ratified, and the ratifications exchanged in Paris, within one year at the latest.

ON THE SIGNATURE OF THE CONVENTION THE PLENIPOTENTIARIES AGREED AS FOLLOWS :—

1. The words "industrial property" shall be understood in their broadest sense ; they are not to apply simply to industrial products properly so called, but also to agricultural products (wine, corn, fruits, cattle, &c.), and to mineral products employed in commerce (mineral waters, &c.).

2. Under the word "patents" are comprised the various kinds

of industrial patents recognized by the legislation of each of the contracting States, such as patents of importation, patents of improvement, &c.

3. The last paragraph of article II. of the Convention does not affect the legislation of each of the contracting States as regards the procedure to be followed before the tribunals, and the competence of those tribunals.

4. Paragraph 1 of Article VI. is to be understood as meaning that no trade or commercial mark shall be excluded from protection in any State of the Union, from the fact alone that it does not satisfy, in regard to the signs composing it, the conditions of the legislation of that State ; provided that on this point it comply with the legislation of the country of origin, and that it had been properly registered in the said country. With this exception, which relates only to the form of the mark, and reserving the provisions of the other articles of the convention, the internal legislation of each State remains in force.

To avoid misconstruction, it is agreed that the use of public armorial bearings and decorations may be considered as being contrary to the public order in the sense of the last paragraph of article VI.

5. The organization of the special department for industrial property mentioned in article XII., shall comprise, so far as possible, the publication in each State of a periodical official paper.

6. The common expenses of the international office, instituted by virtue of article XIII., are in no case to exceed each year a total sum representing an average of 2,000 fr. for each contracting State.

[Here follows directions for classifying the States and assessing expenses upon them, proportionately.]

The Swiss government will superintend the expenses of the international office, advance the necessary funds, and render an annual account, which will be communicated to all the other administrations.

The international office will centralize information of every kind relating to the protection of industrial property, and will bring it together in the form of a general statistical statement which will be distributed to all the administrations. It will interest itself in all matters of common utility to the Union, and will edit, with the help of the documents supplied to it by the various administrations, a periodical paper in the French language, dealing with questions regarding the object of the Union.

The numbers of this paper, as well as all the documents published by the international office, will be circulated among the administrations of the States of the Union in the proportion of the number of contributing units as mentioned above. Such further copies as may be desired, either by the said administrations or by societies or private persons, will be paid separately.

The international office shall at all times hold itself at the service of the members of the Union, in order to supply them with any special information they may need on questions relating to the international system of industrial property.

The administration of the country in which the next conference is to be held will make preparation for the transactions of that conference, with the assistance of the international office.

The director of the international office will be present at the meetings of the conferences, and will take part in the discussions but without the privilege of voting.

He will furnish an annual report upon his administration of the office, which shall communicated to all the members of the Union.

The official language of the international office will be French.

7. The present final protocol, which shall be ratified together with the convention concluded this day shall be considered as forming an integral part of, and shall have the same force, validity, and duration as the said convention.

From *Carpm. Pat. L. of World*, 653.

See also GREAT BRITAIN AND IRELAND.

APPENDIX OF RECENT LAWS.

[The following laws have been obtained since the first volume of the work was all in type. They are from the collection of Patent Laws, of W. E. RICHARDS.]

ARGENTINE REPUBLIC.

Provisional Regulations of the Patent-Office.

"Provisional regulations of the patent-office in the Argentine Republic" contain some directions which are of interest to residents of foreign countries, as showing the proper methods of conducting correspondence with the patent-office; *e. g.*:

NUMBER 5 prescribes that all correspondence shall be conducted in the name of the commissioner.

No. 6 provides that the office cannot give information as to applications, etc., but furnishes "only the following documents:" the law of Congress constituting the office, the decree of the National Government establishing it; the quarterly reports or annual volumes; the written descriptions; the designs and specimens or articles for which patents have been granted.

No. 7 provides that "under no circumstances shall an employe or officer become a representative or agent for an applicant for letters patent."

No. 8 regulates the appointment and substitution of agents or attorneys.

No. 9 directs the mode of preparing and sending applications

for letters patent, and the payments to be made, accompanying them.

Other regulations relate to the manner of preparing and transmitting models and specimens, and applications for designs; also the ordinary course of procedure in the office.

ECUADOR.

Law of October 15, 1880.

The Congress of the Republic of Ecuador, after due consideration of the expediency of regulating the patent laws in such a manner as shall facilitate the obtaining of letters patent for useful inventions, and at the same time provide that the privileges granted shall not become a species of monopoly, has passed the following regulations.

ART. 1. The law secures to every inventor the full and entire use of his invention, provided it is not contrary to established laws and good customs.

ART. 2. The methods and instruments which may be invented or discovered for the improvement of a manufacture or industry, are themselves to be considered as inventions.

ART. 3. A contrivance which introduces only a slight modification (in the methods already known and practiced), or merely relates to objects of adornment, shall not be considered as an invention.

ART. 4. The State has right to purchase the secret of whatsoever invention or discovery which it may consider advantageous to the whole community.

ART. 5. To secure to an originator of an invention or an improvement, the exclusive use of his property, a privilege shall be granted to him for a term not under ten years, and not exceeding fifteen years.

ART. 6. Exclusive rights shall not be granted to inventors of secret remedies; it being the duty of the inventor to make them known for a reasonable compensation.

ART. 7. Importers of machines and of new methods and processes in the useful arts which are not already known and practiced in

the republic, shall be entitled to exclusive right, to be obtained conformably to the following rules.

ART. 8. If the introduction of an imported machine or manufacturing process requires a preliminary outlay of 25,000 pesos, the term for the grant shall be three years; if the outlay amounts to 50,000 pesos, the term shall be six years. If the expense reaches 100,000 pesos, the term shall be extended to ten years.

ART. 9. The right granted to importers of machines or new industrial processes which are already known and practiced abroad, shall be limited to the locality where the machine is put in operation, or to a territory or district sufficiently extensive to allow of their adequate carrying on.

REGULATIONS RELATING TO THE GRANTING OF A PATENT RIGHT.

ART. 10. The person who applies for a patent of whatsoever class or description, shall present to the Executive Department of the administration, a specification containing a description of the invention or improvement, reserving for himself the secret of his method, and the constituents, principles and instruments which he makes use of. His application must be accompanied by a specimen of the article or work produced by means of his invention or improvement.

ART. 11. When the privilege applied for relates to an importation, the specification shall be accompanied by drawings or models of the machine which he intends to introduce, and by a detailed account of the principle, methods and manipulations of the industry which he wishes to import into the territory of the republic; he shall also present a sample of the product which he purposes to perfect.

ART. 12. The government shall thereupon appoint a commission of three competent persons to test the matter and to examine into the *modus operandi* or secret which constitutes the invention, improvement or importation.

ART. 13. This commission shall always be superintended by the chief civil officer of the district where the patent right is to be exercised. If the right extends over the whole republic, this commission shall be presided over by the chief civil officer of the district where the application was made, and by the municipal council, who shall examine into the matters set forth in the preceding article.

ART. 14. Before the same presiding officer, two functionaries and the three commissioners appointed by the government, shall take oath not to disclose the secret, and explicitly declare that they shall faithfully perform their duties.

ART. 15. The commission and the two officials shall thereupon examine into the matter, in the absence of the interested party, and draw up an official report of the result, carefully recording any difference of opinion or views that may arise between the individuals of the commission.

ART. 16. The report referred to in the preceding article shall then be remitted to the ministry of the interior, with a notice on the envelope that the enclosed document or communication is of a *reserved* description. The document shall be accompanied by the description of the method, machines, &c., which constitute the invention, improvement or importation.

ART. 17. Within three weeks, at the most, after the receipt of the report of the commission appointed to examine into the invention, improvement or importation of a new manufacturing process, the government shall issue the respective letters patent on stamped paper, and give order for the sealing up and preservation in the ministry of the interior, of the package containing the report mentioned in the 11th article.

ART. 18. To avoid an improper use of the privilege accorded, the government shall expressly state in the letters patent, that it does not in any way guarantee the importance, merit or usefulness of the invention, improvement or importation; the entire accountability remaining solely with the patentee.

ART. 19. The patentee who desires to make a modification in his invention, or in his first application, before he has obtained letters patent, or after such have been granted, must present a written declaration, accompanied by a description of the new method, according to the directions given in the 10th article. A mere modification in the letters patent will not, however, entitle the patentee to a prolongation of the term originally granted.

RIGHTS OF THE PATENTEE.

ART. 20. The patentee has exclusive right to utilize the invention, improvement or importation for which letters patent were granted.

ART. 21. The patentee has right to do business in every part of

the republic, if the grant is not limited to a certain place or district. He can also authorize other persons to apply and utilize the methods with the same right as himself, and to dispose of them as with movable property.

ART. 22. The patentee can also assign his right, in part or in its entirety, by means of a public document which must be duly recorded by the proper authorities, at the risk of forfeiting his privilege.

ART. 23. If doubt or uncertainty should arise, respecting the priority of two applications for letters patent, the matter shall be settled by a certificate from the sub-secretary of the interior who has in charge the recording of the date and hour when similar applications were filed.

TERM OF THE PRIVILEGE.

ART. 24. The term granted for the utilization of an invention, improvement and importation, commences with the date of the letters patent.

ART. 25. The respective privileges granted to the patentee by the government, shall be recorded in a special register at the ministry of the interior. The original application, specification and other documents mentioned in the 10th article, shall also be deposited with the same authority, until the expiration of the term.

ART. 26. The granting of the patent right shall be officially communicated by the ministry of the interior to the provincial governors, and be published in the official journal. The grant shall also be registered in the collection of laws and decrees.

RIGHTS OF THE STATE AT THE EXPIRATION OF THE TERM.

ART. 27. When the term fixed for the working of the invention, improvement or importation expires, the new process or industrial method becomes the property of the community.

ART. 28. At the expiration of the term, the application, the decription and the other documents referred to in the 10th article shall be published and deposited in the public library of the capital of the republic.

ART. 29. If from any of the causes specified by this law, the privilege becomes void or forfeited, a similar publication and deposition shall be made, and with the same effect as stated in the 27th article.

ART. 30. The government shall give orders relating to the printing of the specifications and the making of models and drawings, necessary to explain the processes which may become public property. A sufficient number of copies shall be sent to the provincial governors.

THE PROTECTION GUARANTEED TO THE PATENTEE AGAINST INFRINGEMENTS.

ART. 31. On presenting reliable and sufficient security, the patentee has a right to apply for an interim injunction for the immediate seizure, conformably to the prescribed order of the law, of the machines, instruments and products which are being used in violation of his privilege.

ART. 32. The party who is found guilty of infringement shall be subjected to the confiscation of the sequestered goods, which devolve to the patentee. The guilty party shall, moreover, pay an indemnification for the loss and injury which he has occasioned, proportionate to the extent of the infringement.

ART. 33. If the infringement cannot be proved, the plaintiff shall be sentenced to pay the damages occasioned by the seizure to the defendant, and also to pay a pecuniary penalty equal in amount to that which would have been imposed upon the defendant, if he had been proved guilty of the infringement.

ART. 34. When the patentee is obstructed by any party in the free exercise of his right, he can apply for redress at the ordinary courts of justice. Should any objection or charge be made against (or relating to) the validity or illegality of the privilege, the matter shall be placed before the administrative tribunal in the ministry of the interior.

ART. 35. In case there is an absolute similarity between two inventions, and uncertainty and dispute arise between the patentees relating to their respective rights, the precedence shall be adjudged to the holder of the letters patent earliest granted.

ART. 36. The "posterior" patentee shall in this case be considered as the perfector of the invention.

PROTECTION OF THE STATE AGAINST ABUSES ON THE PART OF PATENTEES.

ART. 37. Patent rights are void, if granted for an invention, improvement or importation which the civil authorities shall con-

sider contrary to the laws of the State or the public safety, and the regulations of the police. The patentee in such contingencies loses also his claims for indemnification.

ART. 38. The privilege granted becomes void and null, not only under the circumstances already specified, but also in the following cases:

1. When it is proved that the inventor has concealed in his description, the actual means of which he makes use in working his process.

2. When it is proved that the inventor has employed secret methods which were not specified either in the description, or in the subsequent declaration (memorandum of alteration) referred to in the 19th article.

3. When it is proved that the inventor (or he who calls himself so) has obtained his privilege for an invention already described and published by the press, within or outside the republic.

4. When the patentee has allowed one year and one day to elapse from the date when the letters patent were granted, without having put his invention into operation, or brought forward any legally valid reasons for his omission.

5. When the inventor or his assignee, under whatsoever pretense, acts contrary to the obligations connected with the use of the privilege.

ART. 39. In all cases of forfeiture and nullification of the privilege, the disposition stated in the 27th article shall be applicable.

ART. 40. It is the duty of the patentee to declare himself willing to obey and submit to the laws of the country under all circumstances. With regard to the privilege conferred upon him, he must explicitly renounce all diplomatic interference or influence.

ART. 41. All persons to whom privileges have been granted in the republic are subject to the provisions of the present law with regard to the expiration of terms and forfeiture of rights.

The Executive Department has in charge to publish this law, and watch over its observance and proper execution.

NATAL.

Proclamation of January 12, 1872.

Whereas, by Law No. 4, 1870, entitled Law "To provide for the granting in this Colony of Patents for Inventions," it is enacted that it shall be lawful for the Lieutenant Governor, with the advice of the Executive Council, to make rules and regulations for carrying out said law:

Now therefore, I do, under and by virtue of the provisions of the said Law No. 4, 1870, and with the advice of the Executive Council aforesaid, proclaim the following rules and regulations thereunder, that is to say:—

1. Every application for letters patent and every title of invention and provisional specification, must be limited to one invention only.

2. The title of the invention must point out distinctly and specifically the nature and object of the invention.

3. Every provisional protection of an invention shall be forthwith advertised by the applicant in the Natal Government Gazette; and the advertisement shall set forth the name and address of the applicant, the title of the invention, and the date and deposit of provisional specification in the attorney-general's office.

4. In each case the notice of the applicant of his intention to proceed for letters patent for his invention shall be left at the office of the attorney-general eight weeks at least before the expiration of the term of provisional protection thereon, and no notice to proceed shall be received unless the same shall have been left in the said office eight weeks at the least before the expiration of such provisional protection: Provided always that the attorney-general may, upon special circumstances, allow a further extension of time on being satisfied that the same has become necessary by accident, and not from the neglect or willful default of the applicant or his agent.

5. No warrant will be issued for the granting of letters patent for two or more distinct substantive inventions combined.

6. The office of the registrar of the Supreme Court has been, and is, appointed the office to which the attorney-general is to transfer specifications, drawings, &c., for safe custody in terms of said law.

7 and 8 make it the duty of the registrar of the Supreme Court to keep the Register of Patents, Register of Proprietors, Indices to Specifications, Disclaimers, and Memoranda of Alterations, open to inspection by the public, subject to payment of fees; and to collect fees for copies of writings before giving out such copies.

Act No. 32, 1884.

Enacted by the Governor, with the advice and consent of the Legislative Council, November 8, 1884.*

1. The thirty-eighth section of Law No. 4, 1870, shall be and the same is hereby repealed; and it is hereby further enacted that from and after the date of the promulgation in this colony of the Order in Council referred to in section 104 of the Patents, Designs, and Trade-Marks Act, 1883, all letters patent granted in the United Kingdom of Great Britain and Ireland shall be deemed and taken to be granted under the provisions of Law No. 4, 1870, and may be dealt with accordingly: Provided that this law shall only apply to patents granted for inventions in the said United Kingdom, and not to designs or trade-marks.

2. This law shall come into operation from and after the date of the promulgation in the Natal Government Gazette of the order in Council referred to in section 1 hereof, and shall be read and construed together with Law No. 4, 1870, as one law.

ORANGE FREE STATE.

Act No. 12, 1884.

The Parliament ot the Orange Free State, considering it necessary to issue general orders whereby sole privileges are granted to inventions, promoting art and industry, has resolved and does hereby resolve:

ARTICLE 1. Sole privileges may be granted, for a certain termination, through the President of State, after consultation with and

* Preambles recite that this act was passed in order to obtain the benefit of section 103 of the British Patents, Designs and Trade-Marks Act of 1883, Stat. 46 and 47 Vict. c. 57; for which see Vol. 1, *ante*, p. 244.

consent of the Executive Council, on any kind of inventions and improvements, useful to art and industry; and this be done by open letters, named *octroys* (patents), after written application for the same has been furnished to the President of State.

ART. 2. These patents shall be given without regard to right or ownership, and shall then be void, whenever it is seen that the object of the invention or improvement has already, before the granting of applicant's patent, been given, planned or carried into effect by an other party within this State.

ART. 3. Patents shall be granted for a period of five, ten or fifteen years, and a tax therefor be paid to the Treasury, in accordance with the termination and the more or less privileges belonging to same, which must never be higher than £750, or amount to less than £150.

These privileges shall be separately fixed for each application by the executive authority.

ART. 4. A patent granted for a period of five or ten years may also by the expiration of such term, be prolonged whenever very important reasons advise the same, on such conditions as herein explained; though never for the duration of more than altogether 15 years.

ART. 5. The granting of patents on first introduction, or of patents on inventions or considerable improvements, worked or being worked out by foreigners, shall, in case they are already protected or patented, be given for no longer period than the duration of the granted exclusive right, and expressly upon condition of the granted exclusive right, and expressly upon condition of the patented object being made use of within this State.

ART. 6. The patents give to the proprietors or their lawful attorneys, the following preferences: *a.* Exclusive right to use and sell during the ordered period the patented invention over the entire State. *b.* The right to prosecute by civil action those infringing that exclusive right; and to proceed against them for the purpose of having declared forfeited all manufactures yet unsold, for the sale price of the patented objects already sold, and for any further damages for loss of profits, and interest, to which he may show himself entitled.

ART. 7. In making application, the applicant shall be obliged to furnish a distinct, specific, sealed description drawn by himself, of the secret connected with the patent: together with the plans, drawings, calculations, etc.; which description, after the expiration

of the original or prolonged termination of patent, or on its expiration within the term from any of the herein mentioned causes, shall be made public, unless important reasons may compel the government to dispense with this publication.

ART. 8. A patent shall be declared void from the following reasons: *a.* Whenever it shall be seen that the patentee in his application has with fraudulent intentions omitted points or falsely explained the same. *b.* Whenever it shall be seen that the matter in reference to which a patent is applied for, has already, before the granting of the same, been published in some printed work. *c.* Whenever the owner within a term of two years from the dating of the patent granted him, has made no use of same; except from important reasons, to be decided by the executive authorities. *d.* Whenever the owner of a patent, on acquiring the same, has already been granted exclusive rights in another country for the same object. *e.* Whenever it shall be seen that the object of a patent, used according to its principles, will oppose the safety of the State or its inhabitants.

ART. 9. The forfeiture of a patent mentioned in the preceding article shall be declared through the president of State and with consent of the executive council, when the patent owner has been informed.

ART. 10. The forfeiture of a patent shall be published at the cost of the owner in the Government Courant and in the different newspapers of the State, by the secretary of the government; which publication in the Government Courant shall form a sufficient proof in court.

ART. 11. A proper register of patents granted shall be sent to the government office through the secretary of the government; and every patent, therein mentioned, shall be signed by the president of State and the government-secretary.

ART. 12. No application for the granting of a patent shall be taken into consideration before at least six weeks have passed after notice of such application has been made public in the Government Courant.

PERU.

Translation of the Patent Laws.

ARTICLE 1. Every discovery or invention, in whatever branch of industry, gives to the inventor the exclusive right to use it to his benefit; under the conditions and for the time determined by this law. This right will be judicially conceded in the deed of patent granted by the Government.

ART. 2. The following will be considered as inventions or discoveries: (1) New industrial products. (2) New methods, or new applications of existing methods, for obtaining an improvement in industrial products.

ART. 3. In the patents granted, the following will be excepted: (1) Pharmaceutical preparations, and remedies of every description. (2) All projects for financial operations. (3) All operations to improve known industries the use of which is free, both in and out of the republic.

ART. 4. In the third clause of the last article, only proposals relating to contracts permitted by law, will be permitted. Said contracts to be adjudged by public auction.

ART. 5. No patent will be granted for a greater term than 10 years; and any one obtaining a patent shall pay one hundred dollars per annum, which sum shall be applied to the Public Works Fund of the province in which the patent may be used.

ART. 6. All persons soliciting patents or the introduction of inventions from other countries shall be required to present themselves to the prefect of the department in which they intend to make use of the invention, or in case of the patent extending over one or more departments, to the prefect of the department in which the petitioner may reside.

ART. 7. The petition shall contain: (1) A description of the invention or improvement proposed. (2) Plans or models descriptive of the same. (3) An inventory and description of the models presented. (4) A clear and correct explanation of the main object of the patent, with all its details and indication of its appliances. (5) The term for which the patent is asked. (6.) The description of security offered for the proper carrying out of the invention.

ART. 8. The petition shall be clearly written in the Spanish lan-

grage, and all numbers, weights and measures to be those in use in the republic. If one of the petitioners shall be a foreigner, the petition must contain a clause expressly renouncing all diplomatic intervention, in the event of there arising any question relative to the patent solicited; and that such question shall be submitted absolutely and exclusively to the laws and courts of the republic. Without this clause no proposal will be entertained.

ART. 9. The prefect and municipal corporation, will consult the fiscal, or agent of the fiscal, and the other functionaries, to which the class of patent may pertain, and will also hear the judgment of the experts, if necessary; after the above formulas, and respective report, the plans, models, etc. will be passed to the ministry at the expense of the supplicant.

ART. 10. The minister to whom this branch of privilege appertains, will consult the fiscal of the Supreme Court and the various offices through which he may deem fit to refer it.

ART. 11. The extension of a privilege or any modification or alteration of the same, can be given, only by a vote of the Legislature, on the solicitation of the interested parties showing good reasons and documents why such should be conceded.

ART. 12. The patentee is the only person allowed to make use of the patent during the time conceded. Any other person using the same will require a deed of transfer or other form expressed by law.

ART. 13. All patents shall be considered null and void: (1.) If the discovery or application is not new. (2.) If they are not comprehended in the provisions of Art. 2. (3.) If based on principles, methods, systems, discoveries, theories, or sciences, whose application to the industries have not been specified. (4.) If the discovery, invention, or application should be contrary to the public order, the public security, or the laws; without prejudice in such case, to the fines against the manufacture or sale of prohibited articles expressed by law. (5.) If any fraud be discovered, on the part of the patentee, to obtain, under his patent, any object distinct from the true invention. (6.) If on putting in practice the invention, it should be found not to conform to the description that accompanied the application for same. (7.) If the patent has been obtained otherwise than in conformity with the above laws. (8.) If on giving the concession of the patent any pecuniary subversion should be conceded, or other special concession contrary to the laws, that is not embraced in the Budget of the republic.

Any grant shall also be declared null and void which refers to changes, improvements, or additions to concessions, that are not expressed in the original application for the patent.

ART. 14. Any discovery, invention, or application, either in Peru or any foreign country, that may exist, anterior to the date of application, and which shall have had sufficient publicity to have been put into use, will not be considered as new.

ART. 15. The patent will forfeit all its rights: (1.) If the yearly tax or amount stated in Art. 5 is not paid. (2.) If the discovery or invention shall not be put into use within the term of two years or in the term expressed in the patent, unless the cause of its detention can be legally justified. (3.) If articles manufactured in foreign countries should be introduced similar to those patented by the patentee, with the exception, only, of models of machinery whose introduction shall be authorized, after formal inspection, by the government.

ART. 16. Any person that by advertisement, prospectus, placard, mark or stamp, claiming to himself the title of patentee, without legally holding a patent, or after the patent has expired, will be fined 50 to 1000 soles without exempting him from the penalties against the crime of fraud.

ART. 17. Any person who may consider himself lawfully interested, has the right to solicit the nullity or cessation of a patent; in which case the fiscal will intervene, and should the patent be declared null and void, whatever may be the cause, he will give due notice through the proper person, to the respective office.

ART. 18. Every infringement on the right of a patent, be it for the manufacture of products, or the employment of means embraced in the patent, constitutes the crime of fraud; and will be prosecuted according to the gravity of the case, with a fine in favor of the party interested, and the confiscation of the industry or manufacture falsified.

ART. 19. Any exclusive concessions or patents that may exist at the present date, and that may have been given in compliance with former laws, will retain their rights for the full term conceded.

TASMANIA.

Law No. 2, of October 20, 1884.

AN ACT to make provision for the mutual protection of patents for inventions and trade-marks granted or registered in Tasmania or the United Kingdom.

Whereas, by section 104 of the act of the Imperial Parliament to amend and consolidate the law relating to patents for inventions, registrations of designs and of trade-marks, known as the "Patents, Designs and Trade-Marks Act, 1883," provision is made whereby it is rendered lawful for her Majesty, where it is made to appear that the legislature of any British possession has made satisfactory provision for the protection of inventions, designs and trade-marks patented or registered in England, by order in Council to apply the provisions of section 103 of said act, with such variations or additions, if any, as to her Majesty in Council may seem fit, to such British possession.

And whereas it is expedient that the legislature of Tasmania should make such provision as aforesaid,

Be it therefore enacted: &c., &c.

1. In this act "the said acts" mean "the patent law act" and "the merchandise marks act, 1864."

2. (1.) Any person who has applied for protection for any invention or trade-mark in the United Kingdom shall be entitled to a patent for his invention, or to registration of his trade-mark, (as the case may be,) under the said acts, in priority to other applicants; and such patent or registration shall have the same date as the date of the protection obtained in the United Kingdom: Provided, That his application is made, in the case of a patent, within seven months, and in the case of a trade-mark within four months, from his applying for protection in the United Kingdom: Provided, That nothing in this section contained shall entitle the patentee or proprietor of a trade-mark to recover damages for infringements happening prior to the date of the actual acceptance of his complete specification or the actual registration of his trade-mark in Tasmania, as the case may be.

(2.) The publication in Tasmania during the respective periods aforesaid of any description of the invention, or the use therein

during such periods of the invention, or the use therein during such periods of the trade-mark, shall not invalidate the patent which may be granted for the invention or the registration of the trade-mark.

(3.) The application for the grant of a patent or the registration of a trade-mark under this act must be made in the same manner as an ordinary application under the said acts, and shall be subject to the payment of the same fees: Provided, That in the case of trade-marks, any trade-mark the registration of which has been duly applied for in the United Kingdom may be registered under the merchandise marks act, 1864.

This act shall not come into operation until her Majesty shall, by order in Council, apply the provisions of section 103 of the patents, designs and trade-marks act, 1863, to Tasmania, with such variations or additions, if any, as to her Majesty in Council may seem fit; but this act shall thereafter come into operation as soon as such order in Council shall have been publicly made known in the colony.

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