A COLLECTION

OF

PATENT CASES.

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A COLLECTION

OF

PATENT CASES

CRITICISED, EXPLAINED, OVERRULED, OR

OTHERWISE LIMITED

BY SUBSEQUENT DECISIONS

OF

THE FEDERAL COURTS

GIVING A SHORT STATEMENT OF THE

POINT CRITICISED.

By SIMON G. CROSWELL.

BOSTON:

LITTLE, BROWN, AND COMPANY.

1888.

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Rec. Jan. 9, 1888

UNIVERSITY PRESS:

JOHN WILSON AND SON, CAMBRIDGE.

PREFACE.

THE object of this book is to present a view of the criticisms or explanations of the various patent decisions which have been made in subsequent decisions by the various judges of the federal courts. In order to do this, the cases criticised or explained have been placed in alphabetical order, as is generally done in collections of cases overruled, criticised, explained, etc., and the names of the parties printed in heavy-faced type. The date of the case, the court in which it was decided, and the judge giving the opinion are added to give a clearer comprehension of the effect of the decision. Following each of these principal cases come in chronological order the decisions in which the principal case has been discussed. In selecting these later decisions, the aim has been to give only those which throw some light on the real effect of the principal decision, and with this view mere citations have been avoided; but every patent case of importance in the federal courts in which the judge has said anything about a previous case, beyond merely citing it, has been, it is believed, included in the collection. The cases thus selected range from the earliest reports of patent causes in the federal

courts down to the 122 United States and the 30 Federal Reporter, inclusive, and have been collected from the United States Supreme Court Reports, the early Circuit Court Reports, the Reports of Patent Cases by Banning & Arden, and by Fisher and the Federal Reporters.

The intention has been to give a statement of the point discussed sufficiently full to enable the reader to understand in what particular the leading case was limited or affirmed or overruled, without referring to the reports. The advantage of this over a mere table of overruled cases is obvious, in that it enables the reader to select the cases criticised on the point he wishes to study, and to avoid the loss of time caused by examining in the reports many cases which do not bear upon his topic. The collection may also prove useful in the argument of a case in court, suggesting authorities to support the position taken by counsel, or showing decisions which weaken the effect of the cases cited by the opposing counsel, or explaining the view of the courts as to the effect of the various decisions.

S. G. C.

BOSTON, November, 1887.

TABLE OF CASES.

A.

Abbett *v.* Zusi 232
Adair *v.* Thayer 25, 47
Adams *v.* Bellaire Stamping Co. 136
v. Bridgewater Iron Co. 116
v. Burke 1, 2, 3, 20, 126
v. Howard 22, 76
v. Joliet Manuf. Co. 3, 160
v. Jones 3
v. Loft 99
v Meyrose 85, 86
Agawam Co. *v.* Jordan 3
Ager *v.* Murray 3, 7, 204
Aiken *v.* Manchester Print Works 20, 225, 228
Albright *v.* Celluloid Harness Trimming Co. 222
v. Teas 85, 227
Alcott *v.* Young 110
Allen *v.* Mayor of New York 4
Allis *v.* Buckstaff 37, 99, 155, 158, 171, 173
v. [illegible] 16, 154
American [illegible] Mal. Co. *v.* Dolbear 4, 34, 42, 138
v. [illegible] Improved Tel. Co. 171
v. People's Telegraph Co. 37
v. Spencer 4
American Cotton Tie Supply Co. *v.* Bullard 87
v. McCready 89, 112
v. Simmons 87
American Diamond Rock Boring Co. *v.* Rutland Marble Co. 4

PAGE

American Diamond Rock Boring Co. *v.* Sheldon 4, 99, 198, 208, 212, 220
American Giant Powder Co. *v.* Hulings 30
American Nicholson Pavement Co. *v.* Elizabeth 139, 177, 187
American Hide, &c. Dressing Co. *v.* American Tool, &c. Co. 5
American Wood Paper Co. *v.* Fibre Disinteg. Co. 5
v. Glenn Falls Paper Co. 24, 177
Andrews *v.* Carman 5, 121, 182
v. Cross 5, 6
v. Hovey 6
v. Wright 6, 109
Anthony *v.* Carroll 6, 38, 39, 150, 151, 168
Arcambal *v.* Wiseman 223
Arkell *v.* Hurd Paper Bag Co. 27, 41, 112, 146
Arnheim *v.* Finster 6, 41, 111, 119, 230
Ashcroft *v.* Boston & Lowell R. R. Co. 6
v. Walworth 7
Asmus *v.* Alden 133
Atkinson *v.* Boardman 7
Atlantic Giant Powder Co. *v.* California Powder Works 109, 189
v. Goodyear 179
v. Hulings 132, 163
Atlantic Works *v.* Brady 7
Attorney-General *v.* Rumford Chemical Works 8, 14, 139, 230

PAGE

Atwater Manuf. Co. *v.* Beecher Manuf. Co. 75, 110, 162
Atwood *v.* Portland Co. 50, 68, 100, 117, 179
Averill Chemical Paint Co. *v.* National Mixed Paint Co. 162
Avery *v.* Anthony 88

B.

Babcock *v.* Judd 68
Badische Anilin & Soda Fabrik *v.* Cochrane 231
v. Hamilton Manuf. Co. 9, 74
Bailey Wringing Machine Co. *v.* Adams 151
Ball *v.* Langles 9, 179, 181, 190
Bantz *v.* Frantz 9, 129
Barker *v.* Stowe 196
Barnard *v.* Gibson 9
Barrett *v.* Hall 10
Barton *v.* Barbour 10
Bate Refrigerating Co. *v.* Eastman 118
v. Gillett 90, 170
Battin *v.* Taggert 11, 79, 192, 205
Bean *v.* Smallwood 12
Beebe *v.* Russell 12
Beecher Manuf. Co. *v.* Atwater Manuf. Co. 12
Beedle *v.* Bennett 5, 176
Bell *v.* Daniels 12
Bennet *v.* Fowler 13
Benton *v.* Woolsey 14
Bevin *v.* East Hampton Bell Co. 3, 14, 70, 75, 125, 157
Birdsall *v.* Coolidge 14
Birdsell *v.* Hagarstown Agricultural Implement Manuf. Co. 16
v. McDonald 16
v. Perego 16
v. Shaliol 17, 83
Bischoff *v.* Wethered 17
Black *v.* Hubbard 20
v. Munson 17
Blackman *v.* Hibbler 92
Blades *v.* Rand 108
Blake *v.* Robertson 18
Blake *v.* San Francisco 153
Blanchard *v.* Sprague 18
Blandy *v.* Griffith 19
Bliss *v.* Brooklyn 19
Bloomer *v.* McQuewan 19, 20, 56
v. Millenger 19, 20
Boland *v.* Thompson 6, 87, 111, 119, 144, 193
Booth *v.* Parks 81
Boston Manuf. Co. *v.* Fiske 223
Bowker *v.* Dows 21, 217
Boyd *v.* McAlpin 21
Boykin *v.* Baker 201
Bradley *v.* Dull 109, 193
Bradley, &c. Manuf. Co. *v.* Charles Parker Co. 7, 156, 196
Brady *v.* Atlantic Works 195, 214
Bragg *v.* Stockton 17, 201, 202
Brett *v.* Quintard 28, 69
Brickill *v.* New York 4, 124
Bridges *v.* Sheldon 21
Broadnax *v.* Central Stock Yard Co. 221
Brooks *v.* Bicknell 21, 218
v. Byam 21
v. Fiske 22
v. Moorhouse 183
v. Stolley 22, 23, 85
Brosnahan, *in re* 152
Brown *v.* Piper 23
Brush *v.* Condit 80
v. Naugatuck R. R. Co. 101, 153
Buchanau *v.* Howland 24
Buerk *v.* Imhaeuser 24, 25, 30, 187, 216
v. Valentine 25
Bullock Printing Press Co. *v.* Jones 63
Burdell *v.* Denig 25, 26
Burden *v.* Corning 26
Burdett *v.* Estey 106, 114, 140, 181
Burns *v.* Meyer 26
Burr *v.* Cowperthwait 27
v. Duryee 27
v. Gregory 28
Butler *v.* Bainbridge 44
v. Ball 105
Butterworth *v.* Hoe 28
Byam *v.* Brooks 29
v. Farr 29

C.

	PAGE
California Artificial Stone Paving Co. *v.* Freeborn	29
v. Molitor	29, 224
v. Perine	29
v. Schalicke	29, 109, 186
Calkins *v.* Bertrand	18, 32, 78, 156
v. Oshkosh Carriage Co.	8, 95, 209
Campbell *v.* James	29, 52, 167
v. New York	53
v. Ward	174
Canan *v.* Pound Manuf. Co.	147, 197
Cantrell *v.* Wallick	213
Carew *v.* Boston Elastic Fabric Co.	30
Carlton *v.* Bokee	31
Carter *v.* Baker	31
Carver *v.* Braintree Manuf. Co.	31
Cary *v.* Lovell Manuf. Co.	173
Case *v.* Brown	27
v. Redfield	31, 32
Cawood Patent Case	32, 211
Celluloid Manuf. Co. *v.* American Zylonite Co.	53, 157
v. Comstock. &c. Co.	58, 95, 125, 128
v. Tower	200
v. Zylonite Brush & Comb Co.	66
Chabot *v.* American Buttonhole Co.	32
Chaffee *v.* Boston Belting Co.	19
Chambers *v.* Smith	32
Chatillon, *ex parte*	33
Child *v.* Adams	33
Christman *v.* Rumsey	91
Clark *v.* Kennedy Manuf. Co.	54
v. Scott	33
v. Wooster	33, 176
Clark Patent Steam &c. Co. *v.* Copeland	34
Clark Pomace Holder *v.* Ferguson	204
Clarke *v.* Johnson	104
Clements *v.* Odorless Excavating Apparatus Co.	34. 103. 130
Clough *v.* Barker	34
Clum *v.* Brewer	35, 63, 89. 158
Coburn *v.* Schroeder	199
Cochrane *v.* Badische Anilin & Soda Fabrik	36
v. Deener	36, 72, 195
Coffin *v.* Ogden	36, 62, 63
Cohn *v.* United States Corset Co.	38
Colgate *v.* Western Union Telegraph Co.	75, 126. 214
Collar Co. *v.* Van Deusen	38, 66
Collins *v.* Peebles	6, 38. 88, 123, 150, 151, 168, 171, 185, 221, 231
Collins Co. *v.* Coes	39, 154
Combined Patents Can Co. *v.* Lloyd	103, 104, 129, 134, 191
Comstock *v.* Sandusky Seat Co.	198
Conover *v.* Roach	39
Consolidated Electric Light Co. *v.* Edison Electric Light Co.	65, 186
Consolidated Fruit Jar Co. *v.* Belaire Stamping Co.	40, 61, 159, 209
v. Whitney	226
v. Wright	39, 40, 157
Consolidated M. Purifier Co. *v.* Wolf	176
Consolidated Safety Valve Co. *v.* Ashton Valve Co.	116, 176
v. Crosby Steam Gauge & Valve Co.	6, 40
Continental Windmill Co. *v.* Empire Windmill Co.	40
Coon *v.* Wilson	41, 104, 118, 131
Cornell *v.* Littlejohn	184
Cornelly *v.* Markwald	100, 231
Corning *v.* Burden	41, 209
Corn-Planter Patent Case	42, 43, 67, 69
Cote *v.* Moffitt	130
Cottier *v.* Stimson	24, 172
Cowell *v.* Sessions	44
Cowing *v.* Rumsey	44
Crandal *v.* Parker Carriage Goods Co.	132
v. Plano Manuf. Co.	175
v. Watters	44
Crane *v.* Price	45, 93
Crompton *v.* Belknap Mills	45
Crouch *v.* Speer	45
Curran *v.* Burdsall	77
v. Craig	10, 86, 146

D.

PAGE

Dalton v. Nelson 92
Davis v. Fredericks 51, 193
v. Smith 175
Day v. Newark India Rubber Co. 46
v. New England Car Spring Co. 46, 55, 79, 223, 224
v. Union India Rubber Co. 19, 123, 225, 227, 228
Dean r. Mason 46, 115
Dederick v. Cassell 18, 69
Derring v. Winona Harvester Works 70, 146
De Florez v. Raynolds 9, 25, 47, 71, 148, 178, 220, 221
Delano v. Scott 47
Dennis v. Cross 47
Detroit Lubricator Manuf. Co. v. Renchard 48
Dibble v. Augur 48
Dobson v. Dornan 48, 115
v. Hartford Carpet Co. 48, 62, 120
v. Lees 111
Dorsey Revolving Harvest Rake Co v. Bradley Manuf. Co. 1, 49
Double Pointed Tack Co. v. Mann 173
Doughty v. West 49
Downton v. Allis 49
v. Yaeger Milling Co. 49, 191
Draper v. Hudson 50, 204
v. Potomska Mills 50
v. Wottles 52
Driven Well Cases 39, 51, 193
Duff v. Sterling Pump Co. 27, 107, 127
Duffy v. Reynolds 124
Dunham v. Indianapolis, &c. R. R. Co. 35, 158

E.

Eachus v. Broomall 163
Eagleton Manuf. Co. v. West, &c. Manuf. Co. 51, 122, 167
Eames v. Andrews 5, 6, 38, 49, 138, 192
v. Godfrey 163
Earle v. Sawyer 223
Eastern Paper Bag Co. v. Standard Paper Bag Co. 104, 120, 134
Edgarton v. Furst & Bradley Manuf. Co. 111, 165
Eddy v. Dennis 229
Egbert v. Lippman 51
Electric Gaslight Co. v. Boston Electric Co. 134
Elizabeth (City of) v. Nicholson Pavement Co. 52, 122, 140
Ellithorp v. Robertson 53
Emerson v. Hogg 10, 21, 55, 136, 217, 233
v. Sinm 54
Emigh v. Baltimore & Ohio R. R. Co. 149
Eppinger v. Richey 54, 198
Estabrook v. Dunbar 54
Eureka Co. v. Bailey Co. 54
Evans v. Eaton 55, 56, 224

F.

Faulks v. Kamp 57
Fay v. Allen 48, 49, 62, 121
v. Cordesman 57
Fire Extinguisher Case 3, 19, 94
Fire Extinguisher Manuf. Co. v. Graham 20, 56, 64 89, 145, 167, 225
Fitch v. Bragg 183
Florence Manuf. Co. v. Boston Diatite Co. 33
Flower v. Detroit 106, 107, 132, 192
v. Rayner 65, 161, 167, 180
Forbush v. Bradford 57
v. Cook 58
Forsyth v. Clapp 58
Foster v. Lindsay 59, 139, 141
v. Moore 59
Fourniquet v. Perkins 59
French v. Rogers 59

G.

Gage v. Herring 60. 129. 218
v. Kellogg 41, 133, 229

PAGE

Gallahue *v.* Butterfield 61
Galley *v.* Colt, &c. Manuf. Co. 196
Gamewell Fire Alarm Tel. Co. *v.* Brooklyn 64, 101, 114
Gandy *v.* Marble 28
Gardner *v.* Herz 61, 118, 209
Garneau *v.* Dozier 9
Garretson *v.* Clark 61, 62, 91, 120
Gaylor *v.* Wilder 62, 63, 64, 160
Giant Powder Co. *v.* California Vigorit Powder Co. 65, 180
v. Safety Nitro Powder Co. 60, 66
Gibson *v.* Van Dresar 66
Gilbert &c. Manuf. Co. *v.* Tirrell 122
Gill *v.* Wells 42, 43, 66, 67, 69, 74, 91
Gillespie *v.* Cummings 69
Godfrey *v.* Eames 14, 70
Goff *v.* Stafford 71
Gold &c. Separating Co. *v.* United States Disintegrating Ore Co. 71
Gold & Stock Telegraph Co. *v.* Commercial Telegraph Co. 59, 148
v. Pearce 222
Goodyear *v.* Bishop 72
v. Day 72, 73
v. Hartford Spring Axle Co. 39, 154, 202
v. New Jersey Cent. R. R. Co. 73
v. Providence Rubber Co. 74
v. Union India Rubber Co. 22, 72, 74, 86, 226, 227, 232
Goodyear Cases, The 160
Goodyear Dental Vulcanite Co. *v.* Davis 68, 74, 75, 77, 198
v. Gardner 75
v. Preterre 68, 74, 77
v. Root 75
v. Smith 70, 75, 97, 188
v. Van Antwerp 54, 72, 187, 194, 201
v. Wetherbee 75
v. Willis 5, 12, 19, 70, 75, 76, 92, 97, 209, 218
Gordon *v.* Anthony 7, 50, 76, 100, 101, 105, 136, 143, 195, 197, 204
Gorham Co. *v.* White 76

PAGE

Gorrell *v.* Dickson 3
Gottfried *v.* Crescent Brewing Co. 12, 172
v. Miller 77
v. Phillip Best Brewing Co. 22, 34, 108, 126, 127, 152, 155, 170, 172, 190, 200, 206
Gould *v.* Ballard 31, 49, 61, 179
v. Rees 74, 77
v. Spicer 78
Gould's Manuf. Co. *v.* Cowing 17, 78, 139, 156
Graham *v.* Geneva, &c. Manuf. Co. 90, 188
v. McCormick 78, 199
Grant *v.* Raymond 79, 80, 116, 193, 223
Gray *v.* James 79
Greeley, *ex parte* 80
Green *v.* French 66, 215
Greenleaf *v.* Yale Lock Manuf. Co. 18, 25
Greenwood *v.* Bracher 80
Grier *v.* Castle 229

H.

Hailes *v.* Albany Stove Co. 80
v. Van Wormer 80, 81, 88, 95, 138, 168
Hall *v.* McNeale 37, 51, 83
v. Stern 25
v. Wiles 83
Hamilton *v.* Rollins 102
Hammacher *v.* Wilson 86
Hammond *v.* Franklin 208
v. Hunt 63, 83, 94, 113, 203
Hancock Inspirator Co. *v.* Jenks 23, 47, 51, 58, 192, 220
Hapgood *v.* Hewitt 40, 84, 125, 223, 224
Hardin *v.* Boyd 84
Harkness *v.* Hyde 84
Hartell *v.* Tilghman 18, 22, 23, 28, 74, 84, 85, 86, 93, 113, 127, 226
Hartshorn *v.* Day 22, 86, 232
v. Eagle Shade Roller Co. 94, 131, 222
Hatch *v.* Adams 2, 87, 126

PAGE

Hatch *v.* Hall 23
Hatchman, *in re* 87
Hathaway *v.* Roach 87
Hawes *v.* Antisdel 45, 150, 185, 230
Hawley *v.* Mitchell 87
Hayden *v.* Oriental Mills 88, 185
v. Suffolk Manuf. Co. 88
Hayes *v.* Dayton 31, 59, 96, 142, 145, 203
v. Seton 128
Hayward *v.* Andrews 88, 174
v. St. Louis 39, 88
Heald *v.* Rice 11, 17, 93, 98, 162, 190, 206
Heaton *v.* Quintard 89
Henderson *v.* Cleveland Co-operative Stove Co. 135, 215
Hendrie *v.* Sayles 35, 63, 89
Hendy *v.* Golden State, &c. Works 191
Henry *v.* Francestown Soapstone Stove Co. 5, 16, 89
v. Providence Tool Co. 40, 90, 170
Herman *v.* Herman 32, 125, 218
Herring *v.* Gage 91
v. Gas Consumers' Association 158
v. Nelson 42, 58. 67. 69, 81, 91, 168, 179, 205, 215
Hicks *v.* Kelsey 45. 92, 97
Hill *v.* Whitcomb 93, 113, 203
Hitchcock *v.* Tremaine 94
Hobbie *v.* Smith 2, 87
Hodge *v.* Hudson River R. R. Co. 31, 35, 155, 157, 195
Hoe *v.* Boston Daily Advertiser Co. 10, 57, 94
v. Kahler 202
v. Knap 119, 133, 230
Hoffman *v.* Young 117
Hogg *v.* Emerson 94, 233
Holliday *v.* Pickhardt 36
Hollister *v.* Benedict &c. Manuf. Co. 95, 103, 128
Holly *v.* Union City 96
v. Vergennes Machine Co. 96, 164
Holmes Electric Protective Co. *v.* Metropolitan Burglar Alarm Co. 96
Hopkins, &c. Manuf. Co. *v.* Corbin 10
Horman Patent Manuf. Co. *v.* Brooklyn City R. R. Co. 96, 142, 145, 190, 214
Hotchkiss *v.* Greenwood 93, 97, 98
Howe *v.* Abbott 99
v. Morton 99
v. Underwood 99
Howe Machine Co. *v.* National Needle Co. 153
Howes *v.* Nute 50, 100
Hubbell *v.* De Land 16, 46, 55, 192, 224
Hubel *v.* Dick 48, 51, 53, 169
v. Tucker 212
Hussey *v.* Bradley 49, 87, 100

I.

Illingworth *v.* Spaulding 105, 106
Imlay *v.* Norwich & W. R. R. Co. 101
Ingalls *v.* Tice 101
Ingels *v.* Mast 115
Ingersoll *v.* Jewett 101
Isaacs *v.* Abrams 102
Ives *v.* Hamilton 102
v. Sargent 41, 119, 130, 230

J.

Jacobs *v.* Hamilton County 102
James *v.* Campbell 28, 88, 102, 104, 128, 162, 233
Jenkins *v.* Greenwald 232
v. Johnson 104
Jennings *v.* Kibbe 76
Johnson *v.* Flushing, &c. R. R. Co. 67, 91
v. Wilcox & Gibbs Sewing Machine Co. 36, 89, 145, 231
Jones *v.* Barker 129
v. Morehead 104, 105
v. Sewell 105
Jordan *v.* Dobson 105
Judson *v.* Bradford 36
v. Cope 105

K.

Kappes *v.* Hartung 95
Kelleher *v.* Darling 106
Keller *v.* Stoltzenbach 26, 144
Kells *v.* McKenzie 11, 106, 107, 110, 111, 163, 181, 191, 199, 208
Kendall *v.* Winsor 107
Kerosene Lamp Heater Co. *v.* Littell 43, 67, 91
Keystone Bridge Co. *v.* Phœnix Iron Co. 107
King *v.* Gallun 199
v. Hammond 108
v. Mandelbaum 108
v. Werner 108
Kirby *v.* Armstrong 53
v. Dodge, &c. Manuf. Co. 222
Kirk *v.* Du Bois 40, 142
Kittle *v.* De Graaf 34
v. Hall 168, 176, 233
Kittridge *v.* Claremont Bank 29
Klein *v.* Russell 108
Kneass *v.* Schuylkill Bank 109
Kneeland *v.* Sheriff 170
Knight *v.* Baltimore & Ohio R. R. Co. 109
Knox *v.* Gt. West. Quicksilver Mining Co. 3, 32, 127, 140, 148
Kuhl *v.* Mueller 29, 47, 109
Kurshcedt *v.* Werner 108

L.

La Baw *v.* Hawkins 94, 165
Langdon *v.* De Groot 110
La Rue *v.* Western, &c. Co. 166, 177, 229, 234
Legal Tender Cases 56
Leggett *v.* Avery 11, 110. 111, 199
Leonard *v.* Lovell 8, 99, 196
Le Roy *v.* Tatham 111
Lightner *v.* Brooks 112
v. Kimball 112
Lilienthal *v.* Washburn 85, 114
Littlefield *v.* Perry 94, 113, 138, 226
Livingston *v.* Jones 115
v. Van Ingen 115
v. Woodworth 46, 115
Lockwood *v.* Cleveland 59, 71, 141, 212
v. Morey 180
Locomotive Engine, &c. Co. *v.* Penn. R. R. Co. 14, 105, 141
Loercher *v.* Crandal 186
Loom Co. *v.* Higgins 79, 173, 223
Lord *v.* Whitehead 116
v. Whitehead, &c. Machine Co. 175
Lorillard *v.* McAlpin 103
Lowell *v.* Lewis 79, 116
Lynch *v.* Dryden 117

M.

Mabie *v.* Haskell 164
MacKay *v.* Jackman 36, 38, 42, 103, 130, 209
Magic Ruffle Co. *v.* Douglass 117
v. Elm City Co. 117
Mahn *v.* Harwood 118, 119, 120, 131. 142
Manning *v.* Cape Ann Isinglass Co. 120
Manufacturing Co. *v.* Cowing 120, 140, 141
Many *v.* Jagger 121
Marsh *v.* Dodge & Stevenson Manuf. Co. 122
v. Seymour 52, 53, 122
Matthews *v.* Chambers 122
v. Machine Co. 129
v. Shoneberger 122
Maxheimer *v.* Mayer 123
May *v.* Fon du Lac County 39, 123
v. Johnson County 123
v. Juneau County 48, 137
v. Logan County 19. 39, 88, 102, 150, 151, 171, 185
v. Mercer County 102, 123
McCarty, &c. Trading Co. *v.* Glaenzer 86
McCloskey *v.* Du Bois 38, 112
McCluny *v.* Silliman 151
McClurg *v.* Kingsland 123, 124
McCormick *v.* Seymour 125
v. Talcott 125
McKay *v.* Dibert 13, 177
v. Wooster 126
McMillin *v.* Barclay 126
v. Rees 147, 206
McMurray *v.* Mallory 165, 207

PAGE

McWilliams Manuf. Co. *v.* Blundell 129
Merrill *v.* Yeomans 74, 126
Merserole *v.* Union Paper Collar Co. 127
Mevs *v.* Conover 127
Meyer *v.* Bailey 160, 211
v. Maxheimer 207
Middletown Tool Co. *v.* Judd 127
Miller *v.* Bridgeport Brass Co. 30, 67, 103, 128, 129, 130, 133, 134, 232, 233
v. Force 154
Milligan & H. Glue Co. *v.* Upton 33, 50, 126
Minneapolis Harvester Works *v.* McCormick Harvesting Machine Co. 80
Mitchell *v.* Hawley 134
v. Tilghman 135
Moffitt *v.* Garr 135
Mouce *v.* Adams 202
Montross *v.* Mabie 2, 84
Moody *v.* Fiske 136
Moore *v.* Marsh 136
Morey *v.* Lockwood 137
Morley Sewing Machine Co. *v.* Lancaster 4, 35, 40, 125, 168
Morris *v.* McMillin 7, 83, 138, 153, 155
Morse *v.* Davis 47, 183, 184
v. O'Reilly 138, 210
Mosler Safe and Lock Co. *v.* Mosler 83, 156, 169
Mowry *v.* Grand Street, &c. R R. Co. 145
v. Whitney 59, 127, 138, 139, 140, 142

N.

National Hat Pouncing Mach. Co. *v.* Hedden 80
National Manuf. Co. *v.* Meyers 16, 23, 55, 117, 118, 178
Nellis *v.* McLanahan 142
v. Pennock Manuf. Co. 191
Nelson *v.* McMann 63, 113, 143, 160
Nevins *v.* Johnson 100, 101, 105, 143, 195, 196

PAGE

New Process Fermentation Co. *v.* Koch 172, 192
v. Maus 36, 42, 124, 135, 142, 147, 210
Newton *v.* Furst, &c. Manuf. Co. 130
New York *v.* Ransom 144, 187
New York Belting & Packing Co. *v.* MaGowan 4, 201
v. Sibley 144
New York Bung and Bushing Co. *v.* Doelger 95, 99, 149
New York, &c. Coffee Polishing Co. *v.* New York Coffee Polishing Co. 8
New York Grape Sugar Co. *v.* Buffalo Grape Sugar Co. 144
v. Peoria Grape Sugar Co. 175
Nichols *v.* Newell 144
Nicodemus *v.* Frazier 8, 196
Nicolson Pavement Co. *v.* Jenkins 145, 166
Niles Tool Works *v.* Betts Machine Co. 154, 201
Northrup *v.* Adams 145
North Western Fire Extinguisher Co. *v.* Philadelphia Fire Extinguisher Co. 12, 63, 151, 172
Nourse *v.* Allen 145
Novelty Paper Box Co. *v.* Stapler 29

O.

Odell *v.* Stout 30, 79, 132, 221, 233
Odiorne *v.* Denney 157
Oliphant *v.* Salem Flouring Mills Co. 144, 214, 216
Oliver *v.* Rumford Chemical Works 146, 211
O'Reilly *v.* Morse 146, 147, 197
Orr *v.* Badger 148
v. Littlefield 148

P.

Packet Co. *v.* Sickles 26, 148, 188
Packing Co. Cases 153
Paillard *v.* Bruno 90, 96, 170
Palmenburg *v.* Buchholz 149

PAGE

Parham *v.* American Buttonhole, &c. Co. 149
Parker *v.* Hall 150
v. Hallock 38, 39, 150
v. Hawk 150, 151
v. Sears 151
v. Stiles 151
Parker, &c. Co. *v.* Yale Lock Co. 163, 234
Parkhurst *v.* Kinsman 151
Parks *v.* Booth 152
Patterson *v.* Kentucky 152
Pearce *v.* Mulford 153
Peard *v.* Johnson 157, 169
Peck *v.* Collins 135, 136
Pennington *v.* Hunt 153
Pennsylvania R. R. Co. *v.* Locomotive Engine Safety Truck Co. 39, 93, 153, 202
Pentlarge *v.* Beeston 84
Perfection Window Cleaner Co. *v.* Bosley 168
Perkins *v.* Nashua, &c. Paper Co. 120, 123
Perrigo *v.* Spaulding 154
Perry *v.* Corning 21, 62, 155, 158
v. Starrett 76
Phelps *v.* Comstock 155
Philadelphia & Trenton R. R. Co. *v.* Stimpson 155
Phillips *v.* Carrol 220
v. Detroit 82, 98, 155, 201
v. Page 155
v. Risser 104, 133
Philp *v.* Nock 156
Pickering *v.* McCullough 82, 156, 169
Pierson *v.* Eagle Screw Co. 123
Pitts *v.* Edmonds 157
v. Hall 157
v. Whitman 158
Planing Machine Co. *v.* Keith 3, 107, 121, 158, 171, 173, 193, 198, 228
Poage *v.* McGowan 222
Pomeroy *v* New York & N. H. R. R. Co. 159
Pope Manuf. Co. *v.* Owsley 133
Potter *v.* Braunsdorf 159
v. Holland 159
v. Schenck 160

PAGE

Powder Co. *v.* Powder Works 27, 67, 72, 103, 161, 189, 231
Pratt *v.* Rosenfeld 110
Prime *v.* Brandon Manuf. Co. 225
Prouty *v.* Ruggles 163, 164
Pulte *v.* Derby 225, 228
Putnam *v.* Hollender 37, 211
v. Hutchinson 43, 128
v. Tinkham 165
v. Yerrington 200

R.

Racine Seeder Co. *v.* Joliet Wire Check Rower Co. 176
Railroad Co. *v.* Dubois 165
v. Harris 166
v. Mellon 26, 107, 166
v. Stimpson 166
v. Trimble 62, 166
Railway Co. *v.* Sayles 140, 167
Railway Register Manuf. Co. *v.* North Hudson C. R. Co. 66, 178, 204
Read *v.* Miller 39, 168
Ready Roofing Co. *v.* Taylor 24
Reay *v.* Berlin, &c. Envelope Co. 33, 84, 210
v. Rau 4
Reckendorfer *v.* Faber 81, 92, 97, 168, 178, 189, 200, 205
Reed *v.* Chase 61
v. Cutter 169
v. Lawrence 48, 62, 120
Reeves *v.* Keystone Bridge Co. 9, 169
Reissner *v.* Anness 150, 189
v. Sharp 90, 170
Rice *v.* Heald 170
Rich *v.* Close 170
v. Ricketts 38, 150, 171
Richardson *v.* Lockwood 158, 171, 173
v. Noyes 171, 217
Robbins *v.* Chicago 171
Roberts *v.* Buck 171, 172
v. Harnden 172
v. Reed Torpedo Co. 172
v. Ryer 172, 200
v. Schreiber 140
v. Walley 211

PAGE

Robinson *v.* Randolph 173
Roemer *v.* Simon 171, 173, 208
Rogers *v.* Riessner 88, 176
v. Sargent 173, 174
Root *v.* Railway Co. 14, 15, 26, 44, 46, 50, 52, 55, 73, 89, 100, 101, 104, 114, 115, 116, 117, 122, 141, 143, 144, 148, 152, 174, 178, 188, 194, 195, 197, 204, 207
Rowell *v.* Lindsay 39, 43, 44, 77, 165, 170, 177, 190
Rubber Co. *v.* Goodyear 177
Rubber Tip Pencil Co. *v.* Howard 178
Ruggles *v.* Eddy 178
Rumford Chemical Works *v.* Hecker 12, 45, 93, 218
Russell *v.* Dodge 92, 108, 137, 138, 179, 180
v. Place 179, 181
Russell, &c. Manuf. Co. *v.* Mallory 80, 181, 184

S.

Sanders *v.* Logan 182
Sargent *v.* Hall Safe & Lock Co. 57, 182
v. Larned 183
v. Seagrave 183
v. Yale Lock Manuf. Co. 183
Sargent Manuf. Co. *v.* Woodruff 184
Sarven *v.* Hall 49, 77, 100, 184
Sawin *v.* Guild 184
Sawyer *v.* Miller 169
Sax *v.* Taylor Iron Works 95
Saxe *v.* Hammond 184, 216
Sayles *v.* Chicago & N. W. R. R. Co. 185
v. Dubuque & Sioux City R. R. Co. 39, 185, 186
v. Lake Shore & Mich. So. R. R. Co. 39, 185, 186
v. Louisville City R. R. Co. 186
v. Oregon Cent. Ry. Co. 185
v. Railway Co. 185
v. Richmond, F. & P. R. R. Co. 25, 44, 116, 185
Schillinger *v.* Greenway Brewing Co. 60, 186
Schneider *v.* Pountney 217

PAGE

Schollenberger, *ex parte* 46, 159, 166, 186, 224
Schuessler *v.* Davis 186
Scott *v.* Evans 98
Scott Manuf. Co. *v.* Sayre 157, 169
Scrivner *v.* Oakland Gas Co. 30, 132, 137, 181
Searls *v.* Bouton 29, 64
v. Worden 76, 106
Selden *v.* Stockwell Gas Burner Co. 186
Sessions *v.* Romadka 13, 44, 56, 95, 123, 136, 233
Sewing Machine Co. *v.* Frame 133
Seymour *v.* McCormick 54, 72, 105, 144, 148, 149, 187, 188, 194, 202
v. Osborne 49, 100, 135, 181, 188, 189, 191
Sharp *v.* Reissner 192
Shaver *v.* Skinner Manuf. Co. 213
Shaw *v.* Cooper 192, 193
Shaw Relief Valve Co. *v.* New Bedford 193
Shepard *v.* Carrigan 57, 182, 193
Sheriff *v.* Fulton 103, 129
Shirley *v.* Mayer 118, 133
Shoup *v.* Henrici 63
Sickels *v.* Borden 194
Sickles *v.* Evans 194
v. Gloucester Manuf. Co. 101, 194
v. Mitchell 195
Siebert Cylinder, &c. Co. *v.* Harper Lubricator Co. 161, 234
Siemens *v.* Sellers 47, 71, 220
Silsby *v.* Foote 146, 152, 195
Simpson *v.* Davis 15
Singer Manuf. Co. *v.* Goodrich 78, 130
Singer Sewing Machine Co. *v.* Union Buttonhole Co. 196
Slawson *v.* Grandstreet, P. P. & F. R. R. Co. 82, 196
Smith *v.* Baker 194, 196
v. Downing 197
v. Ely 147, 197
v. Goodyear Dental Vulcanite Co. 13, 45. 54, 70, 92, 98, 109, 111, 197, 199

	PAGE
Smith *v.* Merriam	11, 65, 180
v. Nichols	200, 201
v. Sands	175, 201
v. Standard Laundry Machine Co.	86, 227
Snyder *v.* Bunnell	185, 217
Spaulding *v.* Page	201
Spill *v.* Celluloid Manuf. Co.	154, 202
Sprague *v.* Adriance	39
Spring *v.* Domestic Sewing Machine Co.	13
Squire, *in re*	7, 80
Stanley Works *v.* Sargent	202
Star Salt Caster Co. *v.* Crossman	94, 203
Steam Gauge & Lantern Co. *v.* Meyrose	181
v. Miller	185
Steam Stone Cutter Co. *v.* Sheldon	203
v. Shortsleeves	203
v. Windsor Manuf. Co.	113, 140, 195
Stearnes *v.* Page	203
Stephenson *v.* Brooklyn & Crosstown R. R. Co.	153, 201, 203, 204
Stevens *v.* Gladding	50, 204
v. Pritchard	194, 205
Stilwell, &c. Manuf. Co. *v.* Cincinnati Gaslight, &c. Co.	16, 81
Stimpson *v.* West Chester R. R. Co.	205
v. Woodman	205
Stow *v.* Chicago	53, 206
Strobridge *v.* Landers	206
v. Lindsay	190, 206, 221
Strong *v.* Noble	206
Stutz *v.* Armstrong	15, 104, 132
Suffolk Manuf. Co. *v.* Hayden	206
Sullivan *v.* Redfield	207
Swaine Turbine Manuf. Co. *v.* Ladd	9, 58, 207
Swift *v.* Jenks	132

T

	PAGE
Tarr *v.* Folsom	208
Teas *v.* Albright	23, 73, 74, 85, 127, 227
Teese *v.* Huntingdon	208
Terhune *v.* Phillips	23
Thatcher Heating Co. *v.* Burtis	12, 61, 83, 88, 95, 138, 154, 209
Thayer *v.* Hart	37, 100, 220, 231
Theberath *v.* Celluloid Manuf. Co.	64
Thomas *v.* Shoe Machine Manuf. Co.	166, 205, 208
Thompson *v.* Boisselier	8, 83, 208, 216
Tilghman *v.* Mitchell	209
v. Proctor	42, 135, 147, 209
v. Werk	209
Tillinghast *v.* Hicks	130
Toppan *v.* National Bank Note Co.	125, 183
Trader *v.* Messmore	197
Travers *v.* Beyer	217
Tremolo Patent	210
Troy Iron & Nail Factory *v.* Corning	210
Tucker *v.* Dana	160
v. Spaulding	17, 211
Turner & Seymour Co. *v.* Dover Stamping Co.	34, 130
Turrell *v.* Bradford	9
v. Spaeth	77, 211, 215, 216, 221
Turrill *v.* Michigan, Southern, &c. R. R. Co.	211
Tyler *v.* Tuel	211

U.

	PAGE
Union Met. Cart. Co. *v.* United States Cart. Co.	110
Union Paper Bag Machine Co. *v.* Crane	212
v. Murphy	212
Union Paper Collar Co. *v.* White	27, 31, 146
United Nickel Co. *v.* Anthes	213
v. Harris	213
v. Keith	213
v. Manhattan Brass Manuf. Co.	214
v. Pendleton	38, 210
v. Worthington	47, 112
United States *v.* American Bell Telephone Co.	84

PAGE

United States *v.* Burns 214
v. Gunning 141
v. Morris 214
United States Rifle, &c. Co. *v.* Whitney Arms Co. 40, 197, 214
United States Stamping Co. *v.* Jewett 64
v. King 93, 198
Urner *v.* Kayton 21

V.

Vance *v.* Campbell 215
Van Hook *v.* Pendleton 215
Vaughan *v.* Central Pacific R. R. Co. 115, 182, 187
v. East Tennessee, &c. R. R. Co. 101, 143, 155, 182, 195
Vermont Farm Machine Co. *v.* Marble 11, 30, 78, 186
Vinton *v.* Hamilton 216

W.

Walker *v.* Hawxhurst 216
Wallace *v.* Holmes 21, 171, 216, 217
Washburn *v.* Gould 217
Washburn &c. Manuf. Co. *v.* Haish 9, 37, 54, 73, 88, 102, 161, 180, 199. 202, 207, 218, 219
Waterman *v.* Wallace 145
Water Meter Co. *v.* Desper 218
Webber *v.* Virginia 152
Webster *v.* New Brunswick Carpet Co. 219
Webster Loom Co. *v.* Higgins 82, 116, 219
Welling *v.* Rubber, &c. Manuf. Co. 73, 219
Wells *v.* Jaques 27, 164
Werner *v.* King 194
Westcott *v.* Rude 15, 149, 188
Western Electric Manuf. Co. *v.* Odell 24, 145
Western Union Telegraph Co. *v.* Baltimore & Ohio Telegraph Co. 41, 118
Weston *v.* White 14, 71, 220
Wetherell *v.* Keith 37, 218
Wetherill *v.* New Jersey Zinc Co. 39, 139, 221
Wheeler *v.* Clipper Mower Co. 221
v. McCormick 221, 231
Whipple *v.* Miner 212
White *v.* Dunbar 134
v. Lee 85
Whiteley *v.* Kirby 222
v. Swayne 222
Whiting *v.* Graves 223
Whittemore *v.* Cutter 79, 211, 223
Whittlesey *v.* Ames 73, 151, 222, 223
Wilder *v.* Gaylor 223, 224
v. Kent 32, 184
Wilkins *v.* Spofford 224
Williams, *ex parte* 224
Williams *v.* Boston & Albany Railroad Co. 224
v. Empire Transportation Co. 46, 159
v. Rome, &c. Railroad Co. 81, 168, 224
Willimantic Linen Co. *v.* Clark Thread Co. 57
Wilson *v.* Barnum 224
v. Coon 9, 11, 27, 43, 69, 162, 180, 190
v. Cubley 78
v. Hunter 166
v. Rousseau 20, 79, 123, 225
v. Sandford 74, 113, 225, 226
v Sherman 227
v. Simpson 227
v. Stolley 228
v. Turner 228
Wilson Packing Co. *v.* Hunter 224
Wilt *v.* Grier 31, 59
Wilton *v.* The Railroads 228
Winans *v.* Denmead 229
Wing *v.* Anthony 102, 163
Wollensak *v.* Reiher 118, 131, 133, 229
Wonson *v.* Peterson 208
Wood, *ex parte* 230
Wood *v.* Cleveland Rolling Mills 39, 230
v. Packer 83
Wood Paper Patent Case 24, 231
Woodbury Patent Planing Co. *v.* Keith 121, 214

	PAGE
Woodruff *v.* Barney	231
Woodworth *v.* Sherman	231
v. Stone	231
v. Weed	232
v. Wilson	232
Wooster *v.* Handy	30, 59, 132, 232
v. Sidenberg	134
Worden *v.* Searls	26, 60, 83
Worley *v.* Tobacco Co.	124
Wortendyke *v.* White	228
Woven Wire Mattress Co. *v.* Simmons	223
Wyeth *v.* Stone	10, 136, 233

Y.

	PAGE
Yale Lock Manuf. Co. *v.* James	30, 132
v. Norwich National Bank	211
v. Sargent	60, 233
v. Scovill Manuf. Co.	161, 167, 234
Yuengling *v.* Johnson	45

Z.

Zane *v.* Peck	62
v. Soffe	219
Zinn *v.* Weiss	234

ABBREVIATIONS.

United States Supreme Court Reports . . .	U. S.
Federal Reporter	F. R.
Banning & Arden's Patent Reports	Ban. & A.
Fisher's Patent Reports	Fisher.
Blatchford's Circuit Court Reports	Blatchf. C. C.
Wallace's Supreme Court Reports	Wall.
Official Gazette of the Patent Office	O. G.
Howard's Supreme Court Reports	How.
Wheaton's Supreme Court Reports	Wheat.
Peters's Supreme Court Reports	Pet.
Gallison's Circuit Court Reports	Gall.
Gilpin's Circuit Court Reports	Gilp.
Woodbury & Minot's Circuit Court Reports .	W. & M.

TABLE OF PATENT STATUTES CITED.

STATUTE	PAGE
1800	193
1819, c. 19	207
1836	52, 137
1836 § 14	64
§ 16	7, 139, 141
§ 17	143, 226
§ 18	20, 116, 225
1839	52
c. 88, § 7	123
1861	71
1870	194, 226
§ 16	220
§ 25	9, 71
§ 35	214
§ 53	136, 189
§ 55	14, 30, 52, 122, 185
1887, c. 373	46, 159, 186
U. S. R. S. § 629	143
§ 711	143
§ 4886	63, 64
§ 4887	90, 170
§ 4895	186
§ 4899	124
§ 4911	214
§ 4916	161, 162
§ 4917	60
§ 4918	59, 71, 212
§ 4919	143
§ 4920	63, 121
§ 4921	143
§ 4922	60

PATENT CASES

CRITICISED AND EXPLAINED

IN SUBSEQUENT CASES

IN THE FEDERAL COURTS.

A.

Adams *v.* **Burke**, 17 Wall. 453, 1873, Supr. Court, Miller, J.

Is cited and explained in *Dorsey Revolv. Harv. Rake Co.* v. *Bradley Manuf. Co.*, 12 Blatchf. C. C. 204, 1874, North. Dist. N. Y., Woodruff, J.; s. c. 1 Ban. & A. 332. This latter case showed a license to build reapers and to make such machines as should be required for use in certain States, and Woodruff, J., held that this license restricted the use of the machines to those States, stating that *Adams* v. *Burke* is not in conflict with this decision, and referring on page 208 to *Adams* v. *Burke* as a cautiously-guarded decision, carefully limited to the precise case under consideration: and he queries whether that case supports the doctrine that when a mere licensee to make and sell within specified limits, sells the patented machine to another, it passes from under the dominion of the patent, and may be used anywhere, even if that be true when the machine

is sold by one who has the right to make, use, and sell the machine. He also states that *Adams* v. *Burke* is a case where no qualification of the right to use the sold machine was expressed or inferable from the nature of the case.

Is cited and quoted in *Hatch* v. *Adams*, 22 F. R. 436, 1884, East. Dist. Penn., McKennan, J., as explaining the scope of decisions on the question how far an unrestricted sale of a patented article carries with it a right to its unlimited use. *Adams* v. *Burke*, as reported in 4 Fisher, 392, is explained in *Hatch* v. *Adams* as involving only the right to use and not to sell patented articles beyond a limited territory.

Is interpreted in *Hobbie* v. *Smith*, 27 F. R. 662, 1886, North. Dist. N. Y., Coxe, J., to have decided that when a patented article is rightfully bought, it can thereafter be used anywhere.

"The right to sell and the right to use are each substantive rights, and may be granted or conferred separately; but in the essential nature of things when the patentee or the person having his rights sells a machine or instrument whose sole value is in its use, he receives the consideration for its use, and he parts with the right to restrict that use." Quoted in *Montross* v. *Mabie*, 30 F. R. 235, 1887, South. Dist. N. Y., Brown, J.

Is considered at length in *Hatch* v. *Hall*, 30 F. R. 614, 1887, South. Dist. N. Y., Wheeler, J., and considered to have held, against a strong dissent, that a purchaser of an article for mere use, from one having a territorial right, did not infringe against the owner of other territory by using it there. The case of *Adams* v. *Burke* was said, in *Hatch* v. *Hall*, to have been carefully limited to what was necessary to be decided, and to fall far short of holding that the purchaser from the owner of the territorial right within the territory could sell outside

without infringing. *Adams* v. *Burke* is admitted to be an authority in *Hatch* v. *Hall* as far as it goes, but is limited so as to leave to the defendant the right to sell within his territory for mere use outside.

Adams *v.* **Joliet Manuf. Co.**, 12 O. G. 93, 1877, North. Dist. Ill., Blodgett, J.

"A change of location of a part in a combination, when there is no new function performed by the changed member in its new location, will not evade a patent." Quoted in *Knox* v. *Gt. West. Quicksilver Mining Co.*, 4 Ban. & A. 32, 1878, Dist. Cal., Sawyer, J.

Adams *v.* **Jones**, 1 Fisher, 527, 1859, West. Dist. Penn., Grier, J.

Is explained in *Bevin* v. *East Hampton Bell Co.*, 9 Blatchf. C. C. 57, 1871, Dist. Conn., Shipman, J., as deciding that an application for an invention is conclusive evidence against an abandonment of an invention only when the application remains on file.

The opinion of Mr. Justice Grier is quoted from in *Planing Machine Co.* v. *Keith*, 101 U. S. 485, 1879, Strong, J., that negligence in prosecuting an inventor's rights forfeits them; but involuntary delay, caused by no fault of the inventor, does not affect his rights.

Agawam Co. *v.* **Jordan**, 7 Wall. 583, 1868, Supr. Court, Clifford, J.

Is said in the *Fire Extinguisher Case*, 21 F. R. 42, 1884, Dist. Md., Morris, J., to have been a case where the Supreme Court sustained an extension of a patent by special act of Congress.

Ager *v.* **Murray**, 105 U. S. 126, 1882, Supr. Court, Gray, J.

Is said in *Gorrell* v. *Dickson*, 26 F. R. 454, 1886, West. Dist. Penn., Acheson, J., to establish the right of a creditor to bring a bill in equity, to subject a patent right to the payment of the plaintiff's judgment debt.

Allen *v.* **Mayor of New York**, 17 Blatchf. C. C. 350, 1879, South. Dist. N. Y., Wheeler, J.

Said in *Brickill* v. *New York*, 5 Ban. & A. 547, 1880, South. Dist. N. Y., Wheeler, J., to decide that a fire department is a mere agency of the city, and makes no such profits for itself as render it accountable for infringement of a patent.

American Bell Tel. Co. *v.* **Dolbear**, 15 F. R. 448, 1883, Dist. Mass., Gray, J.

Is said in *Morley Sewing Machine Co.* v. *Lancaster*, 23 F. R. 346, 1885, Dist. Mass., Colt, J., to decide that the Bell patent embraced a process, and was not limited to any form of apparatus.

American Bell Tel. Co. *v.* **Spencer**, 8 F. R. 509, 1881, Dist. Mass., Lowell, J.

Is stated in *American Bell Tel. Co.* v. *Dolbear*, 15 F. R. 449, 1883, Dist. Mass., Gray, J., to have decided that Bell is the first inventor of a speaking-telephone.

Is said in *American Bell Tel. Co.* v. *Dolbear*, 17 F. R. 605, 1883, Dist. Mass., Lowell, J., to have decided that Reis had not described a telephone which anticipated Bell's invention.

American Diamond Rock Boring Co. *v.* **Rutland Marble Co.**, 2 F. R. 355, 1880, Dist. Vt., Wheeler, J.

Is followed in *Reay* v. *Rau*, 15 F. R. 749, 1883, South. Dist. N. Y., Shipman, J.

Is cited in *New York Belting & Packing Co.* v. *MaGowan*, 27 F. R. 112, 1886, Dist. N. J., Nixon, J., as to the advisability of granting an injunction after the expiration of a patent.

American Diamond Rock Boring Co. *v.* **Sheldon**, 1 F. R. 870, 1880, Dist. Vt., Wheeler, J.

Is distinguished in *Reay* v. *Rau*, 15 F. R. 749, 1883, South. Dist. N. Y., Shipman, J.

American Hide, &c. Dressing Co. *v.* **American Tool, &c. Co.,** 1 Holmes, 503, 1870, Dist. Mass., Shepley, J.

Is cited in *Henry* v. *Francestown Soapstone Stove Co.*, 5 Ban. & A. 110, 1880, Dist. N. H., Lowell, J., as holding that the right of an inventor to a patent is lost by sale of the invented article more than two years previous to the application for a patent, although the thing when sold was not perfect in a mechanical sense, but only in that it embodied a complete invention in a form which would be operative.

American Wood Paper Co. *v.* **Fibre Disinteg. Co.,** 3 Fisher, 363, 1868, East. Dist. N. Y., Benedict, J.

Followed in *Goodyear Dent. Vul. Co.* v. *Willis*, 1 Ban. & A. 571, 1874, East. Dist. Mich., Emmons, J., as to the conclusive effect of a previous decision upon the same points in regard to a patent in another circuit.

Andrews *v.* **Carman,** 13 Blatchf. C. C. 307, 1876, East. Dist. N. Y., Benedict, J.

The construction given to the Green reissued patent *4,372, for boring wells, is examined at length and sustained in *Andrews* v. *Cross*, 8 F. R. 277, 1881, North. Dist. N. Y., Blatchford, J.

The construction given the Driven Wells patent by Benedict, J., is adopted in *Eames* v. *Andrews*, 122 U. S. 53, 1886, Supr. Court, Matthews, J.

Quoted from in *Beedle* v. *Bennett*, 122 U. S. 76, 77, 1886, Supr. Court, Matthews, J.

Andrews *v.* **Cross,** 19 Blatchf. 294, 305, 1881, North. Dist. N. Y., Blatchford, J.

The comments of Mr. Justice Blatchford in this case upon the Driven Wells patent are quoted at length in *Eames* v. *Andrews*, 122 U. S. 55, 1886, Supr. Court, Matthews, J.

Quoted from in *Beedle* v. *Bennett*, 122 U. S. 78, 1886, Supr. Court, Matthews, J.

Andrews *v.* **Hovey**, 5 McCrary, C. C. 195, 1883, South. Dist. Iowa, Shiras, J.

The comments of Shiras, J., upon the Driven Wells patent in this case are given at length and refuted in *Eames* v. *Andrews*, 122 U. S. 56, 1886, Supr. Court, Matthews, J.

Andrews *v.* **Wright**, 13 O. G. 969, 1877, Dist. Minn., Nelson, J.

The construction given to the Green reissued patent, *4,372, for driven wells in the above case, is sustained in *Andrews* v. *Cross*, 8 F. R. 278, 1881, North. Dist. N. Y., Blatchford, J.

Anthony *v.* **Carroll**, 2 Ban. & A. 195, 1875, Dist. Mass., Shepley, J.

See *Collins* v. *Peebles*.

Arnheim *v.* **Finster**, 24 F. R. 276, 1885, South. Dist. N. Y., Wheeler, J.

Is said in *Boland* v. *Thompson*, 26 F. R. 635, 1886, South. Dist. N. Y., Coxe, J., to be authority for the proposition that when a claim has been examined and rejected by the commissioner, the rejection acquiesced in by the patentee or his solicitor, and the patent reissued without the claim, there is no inadvertence, accident, or mistake which will entitle the patentee to a reissue.

Ashcroft *v.* **Boston & Lowell R. R. Co.**, 1 Holmes, 366, 1874, Dist. Mass., Shepley, J.; s. c. 97 U. S. 189, 1877, Supr. Court, Clifford, J.

Is said in *Consolidated Safety Valve Co.* v. *Crosby Steam Gauge Co.*, 7 F. R. 769, 1881, Dist. Mass., Lowell, J., to have upheld the validity of the Richardson valve.

Ashcroft *v.* **Walworth**, 1 Holmes, 152, 1872, Dist. Mass., Shepley, J.

Decides that the title of an insolvent debtor to a patent right does not pass to his assignee in insolvency by an assignment of his property made by a judge under a State insolvent law, because the conveyance is not a written instrument signed by the owner of the patent, as the patent law requires. This decision is approved in *Gordon* v. *Anthony*, 4 Ban. & A. 262, 1879, South. Dist. N. Y., Blatchford, J.

In *Ager* v. *Murray*, 105 U. S. 131, 1881, Supr. Court, Grier, J., calls attention to the fact that Shepley, J., in *Ashcroft* v. *Walworth*, clearly intimated that the debtor might be compelled by the State court to execute a conveyance of the right.

Atkinson *v.* **Boardman.**

A manuscript decision in this case by Nelson, J., was produced in *Re Squire*, 3 Ban. & A. 136, 1877, East. Dist. Mo., Treat, J., to the point that the acts of 1836, § 16, and 1839, § 10, allow one who files a bill in equity to review the decision of the commissioner of patents in a case of anticipation, to introduce testimony additional to that which was taken before the commissioner.

Atlantic Works *v.* **Brady**, 107 U. S. 192, 1883, Supr. Court, Bradley, J.

Cited in *Bradley, &c. Manuf. Co.* v. *Chas. Parker Co.*, 17 F. R. 241, 1883, Dist. Conn., Shipman, J., as being one of the late decisions of the Supreme Court holding that the question of patentability must be examined with great care.

The opinion of Mr. Justice Bradley in this case is said in *Morris* v. *McMillin*, 112 U. S. 248, 1884, Supr. Court, Woods, J., to illustrate the grounds of decision in the latter case to the effect that not every improvement in a machine deserves a patent.

"It is not the object of the patent laws to grant a monopoly for every trifling device which would naturally and spontaneously occur to any skilled mechanic or operator in the ordinary progress of manufactures." Quoted in *Thompson* v. *Boisselier*, 114 U. S. 12, 1884, Supr. Court, Blatchford, J.

Is stated in *Nicodemus* v. *Frazier*, 19 F. R. 261, 1884, Dist. Md., Morris, J., to have declared very plainly that it is not the design of the patent laws to grant a monopoly of the improvements and adaptations which from time to time would occur, as the demand for them arose, to any *skilled mechanic* or *operator*.

Is cited in *Calkins* v. *Oshkosh Carriage Co.*, 27 F. R. 298, 1886, East. Dist. Wis., Dyer, J., to the same effect.

Is said in *Leonard* v. *Lovell*, 29 F. R. 314, 1886, West. Dist. Mich., Severens, J., to be an especially valuable and prominent case, in which Bradley, J., explains in clear and admirable language the intent and purpose of the patent statutes.

Attorney-General *v.* Rumford Chemical Works, 9 O. G. 1062, 1876, Dist. R. I., Shepley, J.

Is cited in *New York, &c. Coffee Polishing Co.* v. *New York Coffee Polishing Co.*, 20 Blatchf. C. C. 174, 1881, East. Dist. N. Y., Benedict, J., on the question whether the Attorney-General has power to institute a proceeding in the name of the United States to annul a patent for want of novelty.

B.

Badische Anilin & Soda Fabrik *v.* **Hamilton Manuf. Co.,** 13 O. G. 273, 1878, Dist. Mass., Shepley, J.

The decision in this case was examined in *De Florez* v. *Raynolds*, 8 F. R. 444, 1880, South. Dist. N. Y., Blatchford, J.; s. c. 5 Ban. & A. 151, and said to be that § 25 of the act of July, 1870 (U. S. R. S. § 4887), which provides that a United States patent shall expire with the shortest foreign prior patent, if any, for the same invention does not apply to a reissue in April, 1871, of a patent originally granted in October, 1869, the foreign patent having been taken in June, 1869.

Ball *v.* **Langles,** 102 U. S. 128, 1880, Supr. Court, Strong, J.

Cited in *Wilson* v. *Coon*, 6 F. R. 621, 1880, South. Dist. N. Y., Blatchford, J., upon the question of the validity of reissues.

Said in *Garneau* v. *Dozier*, 102 U. S. 232, 1880, Supr. Court, Strong, J. (a suit on the same Ball patent), to have decided the invalidity of the reissued Ball patent as embracing more than the original specification and drawing, or model.

Cited in *Washburn, &c. Manuf. Co.* v. *Haish*, 7 F. R. 913, 1881, North. Dist. Ill., Drummond, J., as assisting in interpreting the decision in *Swain Turbine Manuf. Co.* v. *Ladd* (q. v.).

Bantz *v.* **Frantz,** 105 U. S. 160, 1882, Supr. Court, Woods, J.

Followed in the decision of *Turrell* v. *Bradford*, 15 F. R. 810, 1883, South. Dist. N. Y., Shipman, J.

Barnard *v.* **Gibson,** 7 How. 650, 1849, Supr. Court, McLean, J.

Referred to in *Reeves* v. *Keystone Bridge Co.*, 2 Ban. & A. 257, 1876, East. Dist. Penn., McKennan, J.,

as deciding that a decree making an injunction perpetual, and sending the case to a master to ascertain damages, is not final but interlocutory.

Cited in *Hoe* v. *Boston Daily Advertiser Co.*, 14 F. R. 916, 1883, Dist. Mass., Lowell, J., to show that an injunction is not always granted on final hearing, that power being in the discretion of the court.

Barrett *v.* **Hall**, 1 Mason, 447, 1818, Dist. Mass., Story, J.

Is explained in *Wyeth* v. *Stone*, 1 Story, 290, 1840, Dist. Mass., Story, J., as intended to decide that one patent under the general patent act cannot include divers distinct and independent inventions having no common connection with each other, nor any common purpose.

It is said in *Emerson* v. *Hogg*, 2 Blatchf. C. C. 7, 1845, South. Dist. N. Y., Betts, J., that doubts were raised in the former case whether, under the general patent law, improvements on different machines can be comprehended in the same patent, so as to give a right to the exclusive use of the several machines separately as well as in combination.

"Where a combination of machinery already exists up to a certain point, and the patentee makes an addition or improvement to the machinery, he must confine his patent to the improvement. It is impossible that any person can be at the same time the joint and sole inventor of the same invention." Quoted in *Hopkins, &c. Manuf. Co.* v. *Corbin*, 3 Ban. & A. 203, 1878, Dist. Conn., Shipman, J.

Barton *v.* **Barbour**, 104 U. S. 126, 1881, Supr. Court, Woods, J.

Cited in *Curran* v. *Craig*, 22 F. R. 102, 1884, East. Dist. Mo., Treat, J., on the question whether a receiver appointed by the State court may be sued in the federal court.

Battin *v.* Taggert, 17 How. 74, 1854, Supr. Court, McLean, J.

This case is briefly stated, and the subject of the validity of reissues considered, in *Wilson* v. *Coon*, 6 F. R. 618, 1880, South. Dist. N. Y., Blatchford, J.

Notwithstanding what was said in *Battin* v. *Taggert*, *Heald* v. *Rice*, 104 U. S. 749, 1881, Supr. Court, Matthews, J., decides that the question of the validity of a reissue so far as it is a question whether the reissue is for the same invention as the original patent, is to be decided by the court upon inspection of the patents, if this can be done without extrinsic evidence to explain the terms of the art or apply the description to the subject matter. In other words, if the court, looking at the patents, can say that the inventions are not the same, the question of identity is one of pure construction, and is for the court.

Is said in *Smith* v. *Merriam*, 6 F. R. 719, 1881, Dist. Mass., Lowell, J., to be perhaps inconsistent with *Leggett* v. *Avery*, 101 U. S. 256 (*q. v.*) and to be perhaps overruled by that case.

Is said in *Kells* v. *McKenzie*, 9 F. R. 286, 1881, East. Dist. Mich., Brown, J., to have been generally accepted by patentees as authority for the proposition that a patent may be reissued so as to cover everything suggested in the drawings of the original patent, although the claims and the introductory statement of the invention may have had reference solely to another portion of the machine, however misleading this might be to other people as to what the inventor claimed as his invention.

Is said in *Vermont Farm Machine Co.* v. *Marble*, 19 F. R. 307, 1884, Dist. Vt., Wheeler, J., to appear to have expressly adjudged, upon the statute now in force, that an inventor might have a patent for an invention described in a prior patent to himself.

Bean *v.* **Smallwood**, 2 Story, 408, 1843, First Circuit, Story, J.

"Now I take it to be clear that a machine or apparatus, or other mechanical contrivance, in order to give the party a claim to a patent therefor, must in itself be substantially new. If it is old and well known, and applied only to a new purpose, that does not make it patentable." Story, J., quoted in *North Western Fire Extinguisher Co.* v. *Philadelphia Fire Extinguisher Co.*, 1 Ban. & A. 197, 1874, East. Dist. Penn., McKennan, J., to the point that the application of an old mechanism to an old use to which it had not been before applied, is not patentable.

Opinion of Story, J. "The thing itself which is patented must be new, and not the mere application of it to a new purpose or object." Quoted in *Gottfried* v. *Crescent Brewing Co.*, 9 F. R. 766, 1881, Dist. Ind., Gresham, J.

Beebe *v.* **Russell**, 19 How. 285, 1856, Supr. Court, Wayne, J.

Language of Wayne, J., quoted in *Rumford Chemical Works* v. *Hecker*, 2 Ban. & A. 359, 1876, Dist. N. J., Nixon, J., to the effect that a final decree is one that decides the whole merits of a cause, and leaves no further questions or directions for the future judgment of the court.

Beecher Manuf. Co. *v.* **Atwater Manuf. Co.**, 114 U. S. 523, 1885, Supr. Court, Gray, J.

The principle of this case as to the non-patentability of combinations of old elements was followed in *Thatcher Heating Co.* v. *Burtis*, 121 U. S. 295, 1886, Supr. Court, Matthews, J.

Bell *v.* **Daniels**, 1 Fisher, 377, 1858, South. Dist. Ohio, Leavitt, J.

Said in *Goodyear Dental Vulcanite Co.* v. *Willis*, 1 Ban. & A. 582, 1874, East. Dist. Mich., Emmons, J.,

to support the proposition that when successive applications are made in a procurement of a patent, and when there is no proof of actual abandonment, the subsequent application will be decided a continuation of the first.

Cited in *Smith* v. *Goodyear Dental Vulcanite Co.*, 93 U. S. 501, 1876, Supr. Court, Strong, J., as deciding that filing a second petition for a patent, after the first one has been rejected, is not to be regarded as severing the second from the first, or depriving the applicant of any advantage he would have enjoyed, had the patent been granted without a renewal of the application.

Bennet *v.* **Fowler**, 8 Wall. 445, 1869, Supr. Court, Nelson, J.

It is said in *M'Kay* v. *Dibert*, 5 F. R. 590, 1880, Dist. N. J., Nixon, J., that it is a fair inference, from what was decided in the former case, that the courts have no absolute control over the head of the patent office in the exercise of his discretion whether a given invention or improvement shall be embraced in one, two, or more letters patent.

This case is cited in *Spring* v. *Domestic Sewing Machine Co.*, 9 F. R. 509, 1881, Dist. N. J., Nixon, J., as governing the decision of the latter case, upon the point, that slight evidence of infringement is sufficient for the plaintiff, if the defendant offers no proof on this point.

"It is difficult, perhaps impossible, to lay down any general rule by which to determine when a given invention or improvement shall be embraced in one, two, or more patents. Some discretion must necessarily be left on this subject to the head of the patent office. It is often a nice and perplexing question." Quoted in *Sessions* v. *Romadka*, 21 F. R. 131, 1884, East. Dist. Wis., Dyer, J.

Benton *v.* Woolsey, 12 Pet. 27, 1838, Supr. Court, Taney, C. J.

Was a case where information was filed by the district attorney in the behalf of the United States. In absence of objection, the court thought the real party might be considered to be the United States, but this course is rejected in *Attorney-General* v. *Rumford Chemical Works*, 2 Ban. & A. 314, 1876, Dist. R. I., Shepley, J., and the information in the name of G. H. Williams, as he is Attorney-General of the United States, was rejected on demurrer. The information should be in the name and behalf of the United States.

Bevin *v.* East Hampton Bell Co., 9 Blatchf. C. C. 50, 1871, Dist. Conn., Shipman, J.

Cited in *Weston* v. *White*, 2 Ban. & A. 368, 1876, Dist. Conn., Shipman, J., as limiting the decision in Godfrey *v.* Eames, 1 Wall. 317 (*q. v.*), by saying that the Supreme Court had not intended to decide that every subsequent application for a patent should be decreed, in judgment of law, to relate back to the first, whatever the interval of time or the intervening acts of the applicant between them.

Birdsall *v.* Coolidge, 93 U. S. 64, 1876, Supr. Court, Clifford, J.

The court in *Locomotive Engine, &c. Co.* v. *Penn. R. R. Co.*, 5 Ban. & A. 518, 1880, East. Dist. Penn., Strong, J., relies upon the former case as fixing the proper standard for estimating damages, whether in actions at law or in equity, to be a fixed royalty established by the owner of the patent.

Decided after the act of 1870; is quoted from in *Root* v. *Railway Co.*, 105 U. S. 201, 1881, Supr. Court, Matthews, J., to the effect that since that statute, gains and profits are still the proper measure of damages in

equity suits, except in cases where the injury sustained by the infringement is plainly greater than the aggregate of what was made by the infringer; in that case the plaintiff may also have his damages. This case was urged upon the court in *Root* v. *Railway Co.*, as deciding that an infringer is a trustee of profits for the owner of the patent, and that a court of equity will always compel him to account, even after the expiration of the patent; but this view was rejected by the court, explaining that the expressions of Clifford, J., in the former case as to an infringer being a trustee, referred only to the rule as to measure of damages, and not to the jurisdiction of the court in equity.

Is quoted from in *Westcott* v. *Rude*, 19 F. R. 834, 1884, Dist. Ind., Woods, J., to the effect that no rule of damages can be prescribed which can apply to all cases. If the patented machine has been used a short time by the infringer, and only to a limited extent, the jury should find less than the license fee.

Is said in *Simpson* v. *Davis*, 22 F. R. 445, 1884, East. Dist. N. Y., Benedict, J., to hold that when it appears in a case in equity that the defendant's profits, derived from the use of the plaintiff's invention, do not amount to so much as the plaintiff's damages arising from the infringement, the court may add to the amount of the defendant's profits a sum sufficient to make the amount awarded by the decree equal to the plaintiff's damages.

Is said in *Stutz* v. *Armstrong*, 25 F. R. 148, 1885, West. Dist. Penn., Acheson, J., to hold that, although an established royalty is the measure of damages generally in an action at law, yet, where the infringement is a limited use of the patented machine for a brief period, that measure should not be applied arbitrarily and without qualification.

Birdsell v. Hagarstown Agricultural Implement Manuf. Co., 1 Hughes, 59, 1877, Dist. Ind., Bond and Giles, JJ.

Is said in *Allis* v. *Stowell*, 16 F. R. 788, 1883, East. Dist. Wis., Dyer, J., to have decided that a court of equity would enjoin the owner of the patent from prosecuting suits against the vendees of an infringer when he already has suit against the infringer, who is financially capable of satisfying any decree against him for damages and profits.

Birdsell v. **McDonald**, 6 O. G. 682, 1874, North. Dist. N. Y., Swayne, J.

Is cited in *Stilwell, &c. Manuf. Co.* v. *Cincinnati Gaslight, &c. Co.*, 1 Ban. & A. 614, 1875, South. Dist. Ohio, Swing, J., as giving the true rule as to aggregations.

Is said in *Henry* v. *Francestown Soapstone Store Co.*, 5 Ban. & A., 111, 1880, Dist. N. H., Lowell, J., to be a case where the court held that the neglect of the inventor's solicitors to file an application for a patent was not evidence of the inventor's abandonment of his invention.

Birdsell v. **Perego**, 5 Blatchf. C. C. 251, 1865, North. Dist. N. Y., Hall, J.

The court, in *National Manuf. Co.* v. *Meyers*, 7 F. R. 357, 1881, South. Dist. Ohio, Swing, J., examines this case with reference to its citation in Bump on Patent Law, page 140, as authority that the defence of the invalidity of a patent and a license are inconsistent, and explains the case of *Birdsell* v. *Perego* as an action upon a contract for a license, to enforce the provisions of the contract, thereby creating an estoppel. The court says that *Birdsell* v. *Perego* is not an authority that the invalidity of a patent is an inconsistent defence to that of a license.

Is stated at length in *Hubbell* v. *DeLand*, 14 F. R. 472, 1882, East. Dist. Wis., Dyer, J., and held not to be an

authority as to the practice of filing special pleas when the same matter is given in evidence under the general issue, but to decide only that the pleas in that case presented no defence.

Birdsell *v.* **Shaliol**, 112 U. S. 487, 1884, Supr. Court, Gray, J.

"An infringer does not by paying damages for making and using a machine in infringement of a patent, acquire any right himself to the future use of the machine. On the contrary, he may, in addition to the payment of the damages for past infringement, be restrained by injunction from further use, and when the whole machine is an infringement of a patent, be ordered to deliver it up to be destroyed." Quoted in *Bragg* v. *Stockton*, 27 F. R. 510, 1886, Dist. Cal., Sawyer, J.

Bischoff *v.* **Wethered**, 9 Wall. 315, 1869, Supr. Court. Bradley, J.

Is said in *Tucker* v. *Spalding*, 13 Wall. 456, 1871, Supr. Court., Miller, J., fully to consider the question as to the identity of the principle of two interfering patents.

In *Heald* v. *Rice*, 104 U. S. 749, 1881, Supr. Court, Matthews, J., says the decision is consistent with *Bischoff* v. *Wethered*. *Heald* v. *Rice* decides that if the court, looking at a patent and reissue, can say positively, without the aid of extrinsic evidence, that the inventions are not the same, then it is a pure question of construction for the court.

Black *v.* **Munson**, 14 Blatchf. C. C. 265, 1877, North. Dist. N. Y., Hunt, J.

Cited in *Gould's Manuf. Co.* v. *Cowing*, 3 Ban. & A. 76, 1877, North. Dist. N. Y., Johnson, J., as settling the rule of that circuit that the impossibility of producing evidence of damages or profits does not absolve plaintiff from the necessity of proving the same. If he does not prove them, he gets only nominal damages.

Is cited in *Greenleaf* v. *Yale Lock Manuf. Co.*, 4 Ban. & A. 585, 1879, South. Dist. N. Y., Blatchford, J., to the question what evidence is necessary to show that a fixed and established license has been approved by the plaintiff which can properly be taken as a measure for the damages sustained by him.

Blake *v.* **Robertson**, 94 U. S. 728, 1876, Supr. Court. Swayne, J.

"The damages must be proved; they are not to be presumed." Quoted in *Calkins* v. *Bertrand*, 8 F. R. 759, 1881, North. Dist. Ill., Blodgett, J.

Blanchard *v.* **Sprague**, 1 Cliff. C. C. 288, 1859, Dist. Mass., Clifford, J.

Is quoted from in *Hartell* v. *Tilghman*, 99 U. S. 554, 1878, Supr. Court, Miller, J., to the point that if a patent case does not arise under any act of Congress, nor depend in any way upon any law of Congress, in relation to patents, but arises entirely out of an agreement for a license, the rights of the parties depend upon the ordinary rules of law, and a court of the United States has no jurisdiction unless on account of the citizenship of the parties.

Blanchard *v.* **Sprague**, 3 Sumner, 279, 1838, Dist. Mass., Story, J.

This case is said, in *Dederick* v. *Cassell*, 9 F. R. 312, 1881, East. Dist. Penn., Butler, J., to have decided that the words "above described method," in the claim of a patent, require the claim to be read as one for the patentee's methods of operating his machine, as described in the specification.

Blanchard *v.* **Sprague**, 2 Story, 170, 1839, Dist. Mass., Story, J.

Mr. Justice Story is said in this case to have said that he never doubted the statutory authority of Congress to

grant a patent to an inventor whose invention had at the time of the passage of the act gone into public use. Quoted in *Fire Extinguisher Case*, 21 F. R. 43, 1884, Dist. Md., Morris, J.

Blandy *v.* **Griffith**, 3 Fisher, 609, 1869, South. Dist. Ohio, Swayne, J.

Is said in *Goodyear Dental Vulcanite Co.* v. *Willis*, 1 Ban. & A. 583, 1874, East. Dist. Mich., Emmons, J., to support the proposition that when successive applications are made in the procurement of a patent, and there is no proof of actual abandonment, the subsequent applications will be deemed a continuation of the first.

Bliss *v.* **Brooklyn**, 8 Blatchf. C. C. 533, 1871, East. Dist. N. Y., Benedict, J.

Cited in *May* v. *Logan County*, 30 F. R. 260, 1887, North. Dist. Ohio, Jackson, J., as holding a city liable to a patentee for use of his invention in spite of a statute which attempted to exempt the corporation from liability.

Bloomer *v.* **McQuewan**, 14 How. 539, 1852, Supr. Court, Taney, C. J.

Is cited in *Day* v. *Union India Rubber Co.*, 3 Blatchf. C. C. 491, 1856, South. Dist. N. Y., Hall, J., as containing expressions of opinion to the effect that the right of an assignee or grantee of a patent to use the patented thing during an extended term is limited to the use of machines which such assignee or grantee has in operation when the extended term commences.

Is approved and affirmed in *Bloomer* v. *Millenger*, 1 Wall. 351, 1863, Supr. Court, Clifford, J., and it is said that the diversity of opinion among the judges in *Bloomer* v. *McQuewan* is of no weight, since the rule has been affirmed in *Chaffee* v. *Boston Belting Co.*, 22 How. 223.

Is explained in *Aiken* v. *Manchester Print Works*, 2 Cliff. 437, 1865, Dist. N. H., Clifford, J., as deciding that when a patentee sells a patented implement or machine for the purpose of using it in the ordinary pursuits of life, that machine passes outside the monopoly, and may be used till it is worn out, even under an extension of the patent.

It is said in *Adams* v. *Burke*, 17 Wall. 460, 1873, Supr. Court., Miller, J., in the dissenting opinion of Mr. Justice Bradley, that the remark of Taney, C. J., in *Bloomer* v. *McQuewan*, that when a machine passes into the hands of a purchaser it is no longer within the limits of the monopoly, applies only to time, — that is, to the right to use a machine after the original patent has expired, and a renewal granted, — but does not apply to locality.

The opinion of Mr. Chief-Justice Taney in this case is quoted from in *Fire Extinguheisr Manuf. Co.* v. *Graham*, 16 F. R. 551, 1883, West. Dist. Va., Hughes, J., that the purchaser of a patented machine has the right to use the machine during the extension of a patent; the distinction between assignee of a share in the patent and the purchaser of the patented machine which was made in the case of *Wilson* v. *Rousseau*, 4 How. 646 (q. v.), is also approved. *Bloomer* v. *McQuewan* is also said to have legislated judicially to the extent of giving to § 18 of the law of 1836 a meaning beyond its terms, against the remonstrances of McLean and Nelson, JJ.

Bloomer *v.* **Millenger**, 1 Wall. 340, 1863, Supr. Court, Clifford, J.

The opinion of Mr. Justice Clifford is quoted in *Black* v. *Hubbard*, 3 Ban. & A. 39, 1877, North. Dist. N. Y., Wheeler, J., to the point that when a patentee has made and sold a machine, it is out of the patent, and the buyer may use the machine till it is worn out.

Bowker *v.* **Dows**, 15 O. G. 510, 1878, Dist. Mass., Lowell, J. See *Wallace* v. *Holmes*.

Boyd *v.* **McAlpin**, 3 McLean, 427, 1844, Dist. Ohio, McLean, J.

Is said in *Perry* v. *Corning*, 7 Blatchf. C. C. 201, 1870, North. Dist. N. Y., Woodruff, J., to have expressed the opinion that if an assignment is not recorded within three months, an assignment afterwards made would prevail, although received with notice of such prior assignment. In *Perry* v. *Corning* this dictum of *Boyd* v. *McAlpin* is said not to be material to the decision of *Boyd* v. *McAlpin*, and is not in harmony with the other cases.

Bridges *v.* **Sheldon**, Dist. Vt., October Term, 1879.

Is said in *Urner* v. *Kayton*, 17 F. R. 540, 1883, South. Dist. N. Y., Wheeler, J., to decide that the defendants must pay the master's fees for accounting in the first instance, irrespective of the question who will finally have to pay them.

Brooks *v.* **Bicknell**, 3 McLean, 250, 1843, Dist. Ohio, McLean, J.

Is said in *Emerson* v. *Hogg*, 2 Blatchf. C. C. 10, 1845, South. Dist. N. Y., Betts, J., to decide that under the statute, drawings of a patent may be filed with the specification, although not referred to in the specification.

Brooks *v.* **Byam**, 2 Story, 525, 1843, Dist. Mass., Story, J.

The opinion of the court in this case is said in *Perry* v. *Corning*, 7 Blatchf. C. C. 201, 1870, North. Dist. N. Y., Woodruff, J., to hold that although an unrecorded assignment is not void, yet no suit can be maintained against a third person by virtue of it, unless recorded before or pending suit.

Is said in *Adams* v. *Howard*, 22 F. R. 658, 1884, South. Dist. N. Y., Wallace, J., to have decided in effect that the divisibility of a license depends upon its terms, and that no rule can be laid down which can govern all cases.

Brooks *v.* **Fiske**, 15 How. 215, 1853, Supr. Court., Catron, J.

Is quoted from, in *Gottfried* v. *Phillip Best Brewing Co.*, 5 Ban. & A. 35, 1879, East. Dist. Wis., Dyer, J., to the effect that the claim of a patent is to be interpreted by its own language, together with the specifications and drawings.

Brooks *v.* **Stolley**, 3 McLean, 526, 1845, Dist. Ohio, McLean, J.

Is distinguished in *Hartshorn* v. *Day*, 19 How. 222, 1856, Supr. Court, Nelson, J.

Is explained in *Goodyear* v. *Union India Rubber Co.*, 4 Blatchf. C. C. 68, 1857, South. Dist. N. Y., Ingersoll, J., as deciding in favor of the jurisdiction of the federal court in equity, in a patent suit where a license had been given under the patent, but forfeited for non-compliance with its conditions.

Is said in *Hartell* v. *Tilghman*, 99 U. S. 555, 1878, Supr. Court, Miller, J., to be in some respects opposed to the authorities, which hold that when a case does not arise under any act of Congress, or depend in any way upon any law of Congress relating to patents, but involves a license, a court of the United States has no jurisdiction of that case. Miller, J., in *Hartell* v. *Tilghman*, says that in this respect the case of *Brooks* v. *Stolley* stands alone, and is not supported by the better reason.

In the dissenting opinion of Mr. Justice Bradley (Waite, C. J., and Swayne, J., concurring), in *Hartell* v. *Tilghman*, 99 U. S. 559, 1878, Supr. Court, it is said

that the views expressed in *Brooks* v. *Stolley*, supporting the jurisdiction of a federal court in a case which involves the forfeiture of a license for non-payment of royalty, are perfectly sound and just, the bill being brought in the right gained by the assignment of a patent, and alleging that the defendants are infringing that right, and that the license is no defence.

It is said in *National Manuf. Co.* v. *Meyers*, 7 F. R. 358, 1881, South. Dist. Ohio, Swing, J., that the former case may seem to be an authority to the effect that the defence of the invalidity of plaintiff's patent, and a license under that patent, are inconsistent defences; but *Brooks* v. *Stolley* was not followed in the latter case, the court deciding upon principle and the weight of authority that the defences were not inconsistent.

Is said in *Teas* v. *Albright*, 13 F. R. 411, 1882, Dist. N. J., Nixon, J., to be a case where a federal court took jurisdiction of a suit involving a contract of license, the ownership of the patent in that case being retained by the licensor, and the right of the licensee to use the patent being specially conditioned on his performing certain acts or paying certain royalties. It is also said in the latter case that the court in *Hartell* v. *Tilghman*, 99 U. S. 555 (*q. v.*), intimated that McLean, J., went too far, in *Brooks* v. *Stolley*, in maintaining the jurisdiction of the federal court.

Brown *v.* **Piper**, 91 U. S. 37, 1875, Supr. Court, Swayne, J.

Controlled the decision of *Terhune* v. *Phillips*, 99 U. S. 593, 1878, Supr. Court, Swayne, J., the court taking judicial notice that the thing patented — that is, a means for connecting the horizontal and vertical members of a show-case frame, consisting of a metallic corner piece with sockets — was known and in general use long before the issuing of the patent.

Is cited in *Western Electric Manuf. Co.* v. *Odell*, 18 F. R. 323, 1883, North. Dist. Ill., Blodgett, J., upon the subject of judicial notice.

Is said in *Cottier* v. *Stimson*, 20 F. R. 909, 1884, Dist. Or., Deady, J., to hold that a patented apparatus for preserving fish and other articles in a close chamber by a freezing mixture, covered nothing but a double use for the well-known ice-cream freezer.

Buchanan *v.* **Howland**, 2 Fisher, 341, 359, 1863, North. Dist. N. Y., Hall, J.

Is affirmed as to the validity of Mellier patent in *American Wood Paper Co.* v. *Glen Falls Paper Co.*, 8 Blatchf. C. C. 515, 1870, North. Dist. N. Y., Woodruff, J.

Construes the wood paper patent, and holds that the principle of the discovery was that the known effects of a solution of pure caustic soda, which had previously been used for boiling straw and other fibrous materials of a similar character and texture in open vessels in which the heat could be raised only to 212° Fahrenheit, might by the use of a much higher degree of heat, not less than 310°, be advantageously and greatly increased, while at the same time the reduction of the materials to paper pulp would be more economical, inasmuch as it dispensed with the large quantities of alkali which had previously been employed. This was held to be the true construction in the *Wood Paper Patent Case*, 23 Wall. 604, 1874, Supr. Court, Strong, J.

Buerk *v.* **Imhaeuser**, 10 O. G. 907; s. c. 14 Blatchf. C. C. 19, 1876, East. Dist. N. Y., Johnson, J.

Is said in *Ready Roofing Co.* v. *Taylor*, 3 Ban. & A. 371, 1878, South. Dist. N. Y., Wheeler, J., to mention the reasons for departing from the usual course of the administration of justice by opening a cause for new evidence.

Is cited in *DeFlorez* v. *Raynolds*, 4 Ban. & A. 341, 1879, South. Dist. N. Y., Blatchford, J., to the effect that a decree can be reopened for new trial only for the gravest reasons, and the plainest proof of the sufficiency of the newly offered evidence to lead the court to a different result.

Is cited in *Adair* v. *Thayer*, 7 F. R. 920, 1881, South. Dist. N. Y., Wheeler, J., as laying down the rule followed in the latter case.

The remarks of Johnson, J., in this case, upon the quantity of sales of an infringing article, as determined both by price and construction, are quoted in *Hall* v. *Stern*, 20 F. R. 790, 1884, South. Dist. N. Y., Wallace, J.

Buerk *v.* **Valentine**, 9 Blatchf. C. C. 479, 1872, North. Dist. N. Y., Woodruff, J.

Is re-examined and followed in *Buerk* v. *Imhaeuser*, 1 Ban. & A. 338, 1874, South. Dist. N. Y., Woodruff, J.

Burdell *v.* **Denig**, 92 U. S. 716, 1875, Supr. Court, Miller, J.

In *Sayles* v. *Richmond, F. & P. R. R. Co.*, 4 Ban. & A. 244, 1879, East. Dist. Va., Hughes, J., says that the remark of Miller, J., in *Burdell* v. *Denig*, that damages might be recovered at law, but that profits are the measure of damages in equity, on the theory that the infringer might be treated as a trustee, was incidental, the case being an action at law, and the jurisdiction not being in contest, and the court not intimating that equity could take jurisdiction of a bill for profits arising from the use of a patent, solely on the ground of constructive trusteeship.

Cited in *Greenleaf* v. *Yale Lock Co.*, 4 Ban. & A. 584, 1879, South. Dist. N. Y., Blatchford, J. as settling the measure of damages to which the complainant in the latter case was entitled; namely, the license fee which he had fixed in granting licenses.

The opinion of Mr. Justice Miller is quoted in *Root* v. *Railway Co.*, 105 U. S. 199, 1881, Supr. Court, Matthews, J., to the effect that profits are not the true criterion of damages in an action at law for the infringement of a patent, but that rule is applied in equity. In an action at law the sales of licenses of machines, or the royalty established, is the primary and true criterion of damages. *Burdell* v. *Denig* was urged upon the court, in *Root* v. *Railway Co.*, as a case deciding that an infringer was a trustee of the profits for the owner of the patent, and that a court of equity will always compel him to account, even after the expiration of the patent; but this view was rejected by the court. See *Packet Co.* v. *Sickles*.

The principle of this case is adopted in *Keller* v. *Stoltzenbach*, 28 F. R. 82, 1886, West. Dist., Penn., Acheson, J., by decreeing compensation to the plaintiff for an infringement on the basis of his established license fee.

Burden *v.* **Corning**, 2 Fisher, 477, 498, 1864, North. Dist. N. Y., Hall, J.

Is said in *Worden* v. *Searls*, 21 F. R. 408, 1884, Dist. N. J., Nixon, J., to hold that the defence of unreasonable neglect or delay in filing a disclaimer must be set up in the answer before it can be considered by the court.

Burns *v.* **Meyer**, 100 U. S. 671, 1879, Supr. Court., Bradley, J.

The opinion of Mr. Justice Bradley as to the importance of the "claim" in an application for a patent, is quoted from in *Railroad Co.* v. *Mellon*, 104 U. S. 118. 1881, Supr. Court, Woods, J., which case decides that in view of the statute, the practice of the patent office, and the decisions of the Supreme Court, the scope of

letters-patent is limited by the claim, although it may be illustrated but not enlarged by the specification.

Is affirmed in *Duff* v. *Sterling Pump Co.*, 107 U. S. 139, 1882, Supr. Court, Blatchford, J.

Burr *v.* Cowperthwait, 4 Blatchf. C. C. 163, 1858, Dist. Conn., Ingersoll, J.

Is distinguished in *Arkell* v. *Hurd Paper Bag Co.*, 7 Blatchf. C. C. 477, 1870, North. Dist. N. Y., Woodruff, J., from the latter case, the patent being for an improved product and not for a principle.

Burr *v.* Duryee, 1 Wall. 531, 1863, Supr. Court, Grier, J.

Is cited in *Case* v. *Brown*, 2 Wall. 328, 1864, Supr. Court, Grier, J., to the effect that a reissue cannot be converted into a method of expanding patents for machines into patents for a mode of operation, a function, a principle, an effect, or result, so that by an equivocal use of the term "equivalent," a patentee of an improved machine may suppress further improvements.

The effect of this decision upon the patents there involved is considered in *Wells* v. *Jacques*, 1 Ban. & A. 65, 1874, Dist. N. J., Nixon, J.

Decided that a mode of operation, irrespective of the mechanism by which it was effected, would not be patentable. So interpreted in *Union Paper Collar Co.* v. *White*, 2 Ban. & A. 64, 1875, East. Dist. Penn., McKennan, J.

Referred to in *Powder Co.* v. *Powder Works*, 98 U. S. 139, 1878, Supr. Court, Bradley, J., as deciding that a reissue, to be valid, must be for the same invention as the original patent.

The effect of the decision in this case as to the question of the validity of reissues is briefly stated in *Wilson* v. *Coon*, 6 F. R. 618, 1880, South. Dist. N. Y., Blatchford, J.

The opinion of Mr. Justice Grier, "The surrender of valid patents and the granting of reissued patents thereon, with expanded or equivocal claims, when the original was clearly neither 'inoperative' nor 'invalid,' and where the specification is neither 'defective nor insufficient,' is a great abuse of the privilege granted by the statute, and productive of great injury to the public. This privilege was not given to the patentee or his assignee in order that the patent may be rendered more elastic or expansive, and therefore more available for the suppression of all other inventions." In *James* v. *Campbell*, 104 U. S. 370, 1881, Supr. Court, Bradley, J., says it is difficult to express the law on this subject more aptly or forcibly than in the above words.

The state of the art relating to the Wells invention for the manufacture of hat bodies, and different portions of the Gill machine, are said in *Brett* v. *Quintard*, 10 F. R. 742, 1882, Dist. Conn., Shipman, J. to be described in the former case.

Burr *v.* **Gregory**, 2 Paine, C. C. 426, 1828, Thompson, J.

In *Hartell* v. *Tilghman*, 99 U. S. 551, 1878, Supr. Court, Miller, J., this case is said to be one of the earliest cases on the point whether a court of the United States has jurisdiction in equity of a case arising under a contract concerning a patent, when the citizenship of the parties does not give jurisdiction, and to decide that they have not. *Burr* v. *Gregory* is approved, in *Hartell* v. *Tilghman*, as showing the correct rule, although decided before in the act of 1836.

Butterworth *v.* **Hoe**, 112 U. S. 50, 61, 1884, Supr. Court. Matthews, J.

Is said in *Gandy* v. *Marble*, 122 U. S. 439, 1886, Supr. Court, Blatchford, J., to decide that a bill in equity to compel the commissioner of patents to issue

a patent, is not an appeal from the patent office, but is a distinct suit in equity.

Byam *v.* **Brooks**, 1 Story, 296, 1840, Dist. Mass., Story, J.

Referred to in *Kittridge* v. *Claremont Bank*, 3 Story, 610, 1845, Dist. N. H., Story, J.

Byam *v.* **Farr**, 1 Curtis, C. C. 264, 1852, Dist. Mass., Curtis, J.

"Upon the soundest principles a patentee must be held to be estopped from asserting a claim which is expressly waived in the record." Quoted in *Novelty Paper-Box Co.* v. *Stapler*, 5 F. R. 924, 1881, Dist. N. J., Nixon, J.

C.

California Artificial Stone Paving Co. *v.* **Freeborn**, 17 F. R. 735, 1883, Dist. Cal., Sawyer, J.; s. c. 8 Sawy. 443.

Quoted from *Kuhl* v. *Mueller*, 21 F. R. 512, 1884, South. Dist. Ohio, Sage, J.

Is explained in *California Paving Co.* v. *Schalicke*, 119 U. S. 405, 1886, Supr. Court, Blatchford, J.

California Artificial Stone Paving Co. *v.* **Molitor**, 7 Sawy. 190, 1881, Dist. Cal., Sawyer, J.

Is explained in *California Paving Co.* v. *Schalicke*, 119 U. S. 405, 1886, Supr. Court, Blatchford, J.

California Artificial Stone Paving Co. *v.* **Perine**, 8 F. R. 821, 1881, Dist. Cal., Sawyer, J.

Is quoted from in *Kuhl* v. *Mueller*, 21 F. R. 511, 1884, South. Dist. Ohio, Sage, J.

Campbell *v.* **James**, 104 U. S. 356, 1882, Supr. Court, Bradley, J.

Is cited in *Searls* v. *Bouton*, 12 F. R. 874, 1882, South. Dist. N. Y., Wheeler, J.

The statements in this case to the effect that what has been described in a former patent to an inventor cannot afterwards be patented by him, is limited in *Vermont Farm Machine Co.* v. *Marble*, 19 F. R. 307, 1884. Dist. Vt., Wheeler, J., to inventions described and *patented* in a former patent, and not inventions described only.

The principle of this case regarding reissues was applied in *Yale Lock Manuf. Co.* v. *James*, 20 F. R. 905, 1884, South. Dist. N. Y., Shipman, J.

Is said in *Wooster* v. *Handy*, 21 F. R. 53, 1884. South. Dist. N. Y., Blatchford, J., to establish a new doctrine in regard to reissues.

The principles of this case are applied in *American Giant Powder Co.* v. *Hudings*, 21 F. R. 522, 1884. West. Dist. Penn., Acheson, J.

Is said in *Scrivner* v. *Oakland Gas Co.*, 22 F. R. 99, 1884, Dist. Cal., Sawyer, J., to hold that a process is "a very different thing from mechanism by which it is carried out, and it is a distinct patentable invention."

"An inventor cannot take a reissue for anything but the same invention described and claimed in the original patent; but a reissued patent is not void if the claims of the original patent are extended to cover the original invention." Quoted in *Odell* v. *Stout*, 22 F. R. 163, 1884, South. Dist. Ohio, Sage, J. See also *Miller* v. *Brass Co.*

Carew *v.* Boston Elastic F. Co., 3 Cliff. 356, 370, 1871. Dist. Mass., Clifford, J.

Cited in *Buerk* v. *Imhaueser*, 2 Ban. & A. 453, 1876. South. Dist. N. Y., Johnson, J., to the effect that under the statute of 1870, in equity, the complainant may recover his damages as well as profits, but that unless damages are in excess of the profits, the complainant recovers only profits.

Carlton *v.* **Bokee**, 17 Wall. 471, 1872, Supr. Court. Bradley, J.

Opinion of Mr. Justice Bradley: "We think it proper to reiterate our disapprobation of these ingenious attempts to expand a simple invention of a distinct device into an all-embracing claim calculated by its wide generalization and ambiguous language to discourage further invention in the same department of industry, and to cover antecedent inventions." Quoted with approbation in *Union Paper Collar Co.* v. *White*. 2 Ban. & A. 62, 1875, East. Dist. Penn., McKennan, J.

Carter *v.* **Baker**, 4 Fisher, 404, 1871, Dist. Cal., Sawyer, J.

"It is sufficient, to constitute known mechanical substitutes, that when a skilful mechanic sees one device doing a particular thing, he knows that other devices whose uses he is acquainted with will do the same thing." Quoted in *Wilt* v. *Grier*, 5 F. R. 453, 1880, Dist. Del., Bradford, J.

Carver *v.* **Braintree Manuf. Co.**, 2 Story, 432, 1843, Dist. Mass., Story, J.

Is cited in *Gould* v. *Ballard*, 3 Ban. & A. 327, 1878, Dist. N. J., Nixon, J., as deciding that an inventor is always at liberty to omit, in a reissue, a part of his original invention if he deems it expedient, and retain only that part which he deems fit to retain.

Case *v.* **Redfield**, 4 McLean, 526, 1849, Dist. Ind., Huntingdon, J.

Is said in *Hodge* v. *Hudson River R. R. Co.*, 6 Blatchf. C. C. 89, 1868, South Dist. N. Y., Blatchford, J., to decide what language will convey to an assignee an extension of a patent.

Is limited in *Hayes* v. *Dayton*, 8 F. R. 705, 1880, South. Dist. N. Y., Blatchford, J., to a case of an original patent, and of another patent granted in terms as an improvement on the original patent. *Case* v.

Redfield is said in the latter case to be a case difficult to understand, and opposed to the other cases on the subject.

Cawood Patent Case, 94 U. S. 710, 1876, Supr. Court. Strong, J.

In ascertaining the profits of an infringer, it is not material whether the infringer has made profits from the business, but how much cheaper he has been able to conduct the business by using the patented invention. Upon this point the Supreme Court, in the above case, is cited in *Knox* v. *Gt. West. Quicksilver Mining Co.* 4 Ban. & A. 27, 1878, Dist. Cal., Sawyer, J., as saying in substance that it is not the profits of the business as a business which are to be considered, but the advantage derived to the infringer in the diminished cost, &c., of carrying on the business by the use of this invention.

"In settling an account between a patentee and an infringer of a patent, the question is not what profits the latter has made in his business, or from his manner of conducting it, but what advantage he has derived from his use of the patented invention." Quoted and affirmed in *Calkins* v. *Bertrand*, 8 F. R. 758, 1881, North. Dist. Ill., Blodgett, J.

Chabot *v.* **American Buttonhole Co.**, 6 Fisher, 71, 1872, East. Dist. Penn., McKennan, J.

Cited in *Herman* v. *Herman*, 29 F. R. 94, 1886, South. Dist. N. Y., Brown, J., as holding that, under the circumstances of the case, a license or grant to use an invention was to be necessarily inferred from the contract, and from the relation and acts of the party.

Chambers *v.* **Smith**, 5 Fisher, 12, 1870, East. Dist. Penn., McKennan, J.

Is interpreted in *Wilder* v. *Kent*, 15 F. R. 219, 1883, West. Dist. Penn., Acheson, J., as deciding that the

purchaser at a marshal's sale of a patented machine was an infringer in operating it outside of the district to which its use was limited by license granted to the execution defendant.

Chatillon, *Ex Parte*, 2 O. G. 115, 1872, Leggett, Commissioner.

Cited in *Milligan & H. Glue Co.* v. *Upton*, 1 Ban. & A. 510, 1874, Dist. Mass., Clifford, J., as a case where the commissioner of patents rejected an application for a patent, when the alleged invention was only substituting one known device for another.

Child *v.* **Adams,** 1 Fisher, 189, 1854, East. Dist. Penn., Grier, J.

Is explained in *Hancock Inspirator Co.* v. *Jenks*, 21 F. R. 914, 1884, East. Dist. Mich., Brown, J., in that the bill was dismissed because on its own recitals it showed that the commissioner of patents had not jurisdiction to issue the patent upon which suit was brought, the application for a reissue stating that the original patent was granted to the purchaser on his statement that he was a citizen of the United States, when in fact he was a citizen of France, but believed he was a citizen of the United States, owing to his ignorance of the law.

Clark *v.* **Scott,** 2 O. G. 4, 1872, South. Dist. N. Y. Blatchford, J.

Is distinguished in *Florence Manuf. Co.* v. *Boston Diatite Co.*, 1 Ban. & A. 398, 1874, Dist. Mass., Shepley, J.

Clark *v.* **Wooster,** 119 U. S. 322, 1886, Supr. Court, Bradley, J.

Cited in *Reay* v. *Berlin, &c. Envelope Co.*, 30 F. R. 449, 1887, South. Dist. N. Y., Wheeler, J., as upholding the jurisdiction in the latter case.

Is quoted from at length in *Kittle* v. *De Graaf*, 30 F. R. 689, 1887, South. Dist. N. Y., Coxe, J., to the effect that if the patent is in force when the bill in equity is brought, the fact that it expires soon after does not deprive the court of jurisdiction in this case.

Clark Patent Steam, &c., Co. *v.* **Copeland**, 2 Fisher, 221, 1862, South. Dist. N. Y., Shipman, J.

Is cited in *Gottfried* v. *Phillip Best Brewing Co.*, 5 Ban. & A. 22, 1879, East. Dist. Wis., Dyer, J., as deciding that in order to find an invention anticipated in a prior printed publication, the description in the publication must embody substantially the same organized mechanism, operating substantially in the same manner as that described in the patent claimed to have been anticipated, and that old instruments placed in a new and different organization, producing in such new organization different results, or the same results by a new and different mode of operation, do not prevent such newly-organized mechanism from being patentable.

Clement *v.* **Odorless Excav. Apparatus Co.**, 109 U. S. 641, 1883, Supr. Court, Blatchford, J.

Affirmed in *Turner & Seymour Co.* v. *Dover Stamping Co.*, 111 U. S. 327, 1883, Supr. Court, Matthews, J.

Clough *v.* **Barker**, 106 U. S. 166, 1882, Supr. Court, Blatchford, J.

Is said in *American Bell Tel. Co.* v. *Dolbear*, 17 F. R. 605, 1883, Dist. Mass., Lowell, J., to be an exceptional case, and that its doctrine must be applied with much reserve; this doctrine is, that if a certain machine or organization is capable of a certain use, only under unusual and abnormal conditions, so that a person of skill and knowledge of the art to which it relates, or a person using the machine, would only by accident dis-

cover that it was capable of such mode of operation, it shall not be considered an anticipation of a machine or organization which is founded upon such mode of operation.

Is cited in *Morley Sewing Machine Co.* v. *Lancaster*, 23 F. R. 346, 1885, Dist. Mass., Colt, J., upon the question of infringement in regard to a foundation patent.

Clum *v.* **Brewer**, 2 Curtis, C. C. 506, 508, 1855, Dist. Mass., Curtis, J.

Is said in *Hodge* v. *Hudson River R. R. Co.*, 6 Blatchf. C. C. 89, 1868, South. Dist. N. Y., Blatchford, J., to decide what language will convey to an assignee an extension of a patent.

Approved in *Dunham* v. *Indianapolis, &c. R.R. Co.*, 2 Ban. & A. 329, 1876, North. Dist. Ill., Drummond, J., as giving the true rule, that when one of the joint patentees uses or sells the thing patented, or any portion of it, the others cannot sue him for an infringement. This is because one tenant in common of letters-patent has the same rights as the others, to make, use, and sell the thing patented, and a licensee under one tenant in common cannot be enjoined on a bill by another tenant in common.

The decision in this case was that the inchoate right of an inventor to obtain an extension of the term of the patent was a proper subject for purchase and sale. This case is examined in *Hendrie* v. *Sayles*, 98 U. S. 552, 1878, Supr. Court, Clifford, J., and said to be a case of great importance, as establishing the rule that an extended term might pass by assignment, as well as the original term.

The language of Curtis, J., in this case, to the effect that when a conveyance of a patent contains something showing an intention to convey not merely the letters-patent, but the extension thereof, such extension passes

by that conveyance, is cited in *Johnson* v. *Wilcox & Gibbs Sewing Machine Co.*, 27 F. R. 690, 1886, South. Dist. N. Y., Wallace, J.

Cochrane *v.* **Badische Anilin & Soda Fabrik**, 111 U. S. 294, 1883, Supr. Court, Blatchford, J.

"Every patent for a product or composition of matter must identify it, so that it can be recognized aside from the description of the process for making it, or else nothing can be held to infringe the patent which is not made by that process." Quoted in *Holliday* v. *Pickhardt*, 29 F. R. 860, 1887, South. Dist. N. Y., Wallace, J.

Cochrane *v.* **Deener**, 94 U. S. 780, 1876, Supr. Court, Bradley, J.

"A process is a mode of treatment of certain materials to produce a given result. It is an act or a series of acts performed upon the subject-matter to be transformed and reduced to a different state or thing." Quoted in *MacKay* v. *Jackman*, 12 F. R. 618, 1882, South. Dist. N. Y., Wheeler, J.

Is said in *New Process Fermentation Co.* v. *Maus*, 122 U. S. 427, 1886, Supr. Court, Blatchford, J., to establish the rule that a method or art may be patented as a process, irrespective of the apparatus or instrumentality for carrying it out.

Coffin *v.* **Ogden**, 18 Wall. 120, 1873, Supr. Court, Swayne, J.

In *Judson* v. *Bradford*, 3 Ban. & A. 548, 1878, Dist. Mass., Clifford, J., it is said, that since the decision in *Coffin* v. *Ogden* evidence will support the defence of prior knowledge and use, which shows that the invention was complete and capable of working if it had been put in use, and was known to any considerable number of persons.

"The invention or discovery relied upon as a defence must have been complete, and capable of producing the

result sought, and this must be shown by the defendant. The burden of proof rests upon him, and every reasonable doubt should be resolved against him." Quoted in *Washburn, &c. Co.* v. *Haish*, 4 F. R. 904, 1880, North. Dist. Ill., Drummond, J.

The opinion in this case, to the effect that, on the defence of prior invention, the burden of proof is upon the defendant to prove that the invention or discovery, relied upon as a defence, was a complete and practical working machine, and in examining the proof of this the court should resolve every reasonable doubt against the defendant, is quoted in *Putnam* v. *Hollender*, 6 F. R. 893, 1881, South. Dist. N. Y., Blatchford, J.

Relied upon in *Hall* v. *McNeale*, 107 U. S. 97, 1882, Supr. Court, Blatchford, J., that if the article has been used and sold for two years, no patent can be taken on it.

Opinion of Mr. Justice Swayne: "The invention or discovery relied upon as a defence must have been complete, and capable of producing the result sought to be accomplished, and this must be shown by the defendant. The burden of proof rests upon him, and every reasonable doubt should be resolved against him." Quoted in *Allis* v. *Buckstaff*, 13 F. R. 891, 1882, East. Dist. Wis., Dyer, J.

Is quoted from in *Thayer* v. *Hart*, 20 F. R. 694, 1884, South. Dist. N. Y., Coxe, J., to the effect that the burden of proof of a prior invention rests upon the defendant.

The same quotation is made in *American Bell Telephone Co.* v. *People's Telegraph Co.*, 22 F. R. 313, 1884, South. Dist. N. Y., Wallace, J.

Is said in *Wetherell* v. *Keith*, 27 F. R. 366, 1886, North. Dist., Ill., Blodgett, J., to establish the rule that the fact of prior use as a defence in a suit for infringement must be established beyond reasonable doubt.

Cohn *v.* **U. S. Corset Co.**, 93 U. S. 366, 1876, Supr. Court, Strong, J.

Is cited in *United Nickel Co.* v. *Pendleton*, 15 F. R. 747, 1883, South. Dist. N. Y., Blatchford, J., to the effect that a patent for a product, not describing the process of making it, may be defeated by a prior printed and published description of the product.

This rule is qualified by the subsequent statement that unless the prior description is so full and intelligible that persons skilled in the art can understand it and make the product, the subsequent patent is not defeated. Quoted to this effect in *Eames* v. *Andrews*, 122 U. S. 66, 1886, Supr. Court, Matthews, J.

Collar Co. *v.* **Van Deusen**, 23 Wall. 530, 1874, Supr. Court, Clifford, J.

The opinion of Clifford, J., is quoted in *McCloskey* v. *DuBois*, 9 F. R. 39, 1881, South. Dist. N. Y., Wheeler, J., to the effect that new articles of commerce are not patentable as new manufactures unless their production involves the exercise of invention or discovery.

Is also quoted in *MacKay* v. *Jackman*, 12 F. R. 619, 1882, South. Dist. N. Y., Wheeler, J.

Collins *v.* **Peebles**, 2 Fisher, 541, 1865, South. Dist. Ohio, Swayne, J.

Is said in *Rich* v. *Ricketts*, 7 Blatchf. C. C. 231, 1870, North. Dist. N. Y., Hall, J., to follow the decision in *Parker* v. *Hallock*, 2 Fisher, 543 (q. v.), that a State statute of limitations does not apply to a suit in a federal court on a patent.

Is interpreted in *Anthony* v. *Carroll*, 2 Ban. & A. 197, 1875, Dist. Mass., Shepley, J., to decide that State statutes could not limit the time within which actions for the infringement of patents could be brought in the federal courts, and as Congress had not legis-

lated on the subject, there was no limit to the time for bringing actions.

Is cited in *May* v. *Logan County*, 30 F. R. 257, 1887, North. Dist. Ohio, Jackson, J., together with *Parker* v. *Hallock*, 2 Fisher, 543; *Read* v. *Miller*, 2 Biss. 12; *Wetherell* v. *N. J. Zinc Co.*, 1 Ban. & A. 105; *Anthony* v. *Carroll*, 2 Ban. & A. 195; *Sayles* v. *Lakeshore & M. S. R. R. Co.*, 9 F. R. 515; *Sayles* v. *Dubuque & S. C. R. R. Co.*, 9 F. R. 516; *Hayward* v. *St. Louis*, 1 F. R. 427; *Wood* v. *Cleveland Rolling Mills*, 4 Fisher, 550; *May* v. *Fon du Lac County*, 27 F. R. 691, as being cases deciding that a State statute of limitations cannot be interposed as a defence in an action for an infringement of a patent in a suit in the federal court.

Collins Co. *v.* **Coes**, 21 F. R. 38, 1884, Dist. Mass., Gray, J.

Cited in *Goodyear* v. *Hartford Spring Axle Co.*, 23 F. R. 37, 1885, Dist. Conn., Shipman, J. See *Penn. R. R. Co.* v. *Locomotive Engine Safety Truck Co.*

Conover *v.* **Roach**, 4 Fisher, 12, 1857, South. Dist. N. Y., Hall, J.

This case is said, in *Rowell* v. *Lindsay*, 6 F. R. 296, 1881, East. Dist. Wis., Dyer, J., to settle the principle of law that the patentee has a right to invoke the doctrine of equivalents, on a question of infringement, in the case of a combination patent.

Consolidated Fruit Jar Co. *v.* **Wright**, 94 U. S. 92, 1876, Supr. Court, Swayne, J.

The decision of this case upon the doctrine of abandonment, is said in *Sprague* v. *Adriance*, 3 Ban. & A. 125, 1877, South. Dist. N. Y., Wheeler, J., to be, that he who is silent when he should speak, must be silent when he would speak, if he cannot do so without violation of law and injustice to others.

Is quoted from in the *Driven Well Cases*, 16 F. R.

389, 1883, South. Dist. Iowa, Shiras, J., as to abandonment of an invention by the inventor.

Mr. Justice Swayne is cited as saying that a single instance of sale or of use by the patentee before application for a patent may, under the circumstances, be fatal to the patent, in *Henry* v. *Providence Tool Co.*, 3 Ban. & A. 514, 1878, Dist. R. I., Clifford, J.

Is cited in *Consolidated Fruit Jar Co.* v. *Bellaire Stamping Co.*, 27 F. R. 382, 1886, South. Dist. Ohio, Sage, J., upon the question what facts amount to abandonment of an invention after rejected application and before reissued application.

Consolidated Fruit Jar Co. *v.* **Wright,** 12 Blatchf. C. C. 149, 1874, South. Dist. N. Y., Woodruff, J.

Dictum of Woodruff, J., is quoted with approval in *United States Rifle, &c. Co.* v. *Whitney Arms Co.*, 2 Ban. & A. 500, 1877, Dist. Conn., Shipman, J., to the effect that if an inventor allows others to produce his invention and supply it to the public for a long time, he loses his right to a patent.

Consolidated Safety Valve Co. *v.* **Crosby, &c. Valve Co.,** 113 U. S. 159, 1884, Supr. Court, Blatchford, J.

Is cited in *Morley Sewing Machine Co.* v. *Lancaster*, 23 F. R. 346, 1885, Dist. Mass., Colt, J., upon the question of equivalents in construction.

Is cited in *Kirk* v. *Du Bois*, 28 F. R. 461, 1886, West. Dist. Penn., McKennan, J., as a case where two bills, involving two patents, one of which had expired before final decree, being before the court, the Supreme Court granted an injunction in favor of the existing patent, and an account of profits on both.

Continental Windmill Co. *v.* **Empire Windmill Co.,** 8 Blatchf. C. C. 295, 1871, North. Dist. N. Y., Woodruff, J.

Is explained in *Hapgood* v. *Hewitt*, 119 U. S. 233, 1886, Supr. Court, Blatchford, J.

Coon *v.* **Wilson**, 113 U. S. 268, 1884, Supr. Court, Blatchford, J.

The language of the court in this case as to the validity of a reissue claiming a different invention from the original patent is quoted in *Gage* v. *Kellogg*, 23 F. R. 894, 1885, North. Dist. N. Y., Coxe, J.

Is cited in *Arnheim* v. *Finster*, 24 F. R. 276, 1885, South. Dist. N. Y., Wheeler, J., as affirming the recent decisions upon the point of reissued patents.

Is said in *Western Union Telegraph Co.* v. *Baltimore & Ohio Telegraph Co.*, 25 F. R. 34, 1885, South. Dist. N. Y., Wallace, J., to have held that an application for a reissue to enlarge the scope of the original claim was too late three months after date of the original patent, the fact being that the claim in the reissue sought to cover articles made by the defendant subsequently to the date of the original patent, and that the subject-matter of the reissued claim had been industriously excluded from the description in the original.

The language of the court in this case is paraphrased in *Arnheim* v. *Finster*, 26 F. R. 280, 1886, South. Dist. N. Y., Coxe, J., to the effect that where a reissue merely enlarges the claim of the patent by expanding that claim and adding others, twenty-one months' delay invalidates the reissue.

It is said in *Ives* v. *Sargent*, 119 U. S. 663, 1886, Supr. Court, Matthews, J., that the lapse of time and laches was considered immaterial in *Coon* v. *Wilson* as regards the reissue in that case, since the court could decide that the reissue was on its face for a different invention from the original patent, and therefore void.

Corning *v.* **Burden**, 15 How. 252, 1853, Supr. Court, Grier, J.

Is distinguished, in *Arkell* v. *Hurd Paper Bag Co.*, 7 Blatchf. C. C. 477, 1870, North. Dist. N. Y., Wood-

ruff, J., from the latter case; the patent is for an improved product and not for a principle.

The opinion of Mr. Justice Grier in this case as to what constitutes a process under the patent law, and that it is included under the general term "useful art," is quoted at length in *MacKay* v. *Jackman*, 12 F. R. 618, 1882, South. Dist. N. Y., Wheeler, J.

The opinion of Mr. Justice Grier, as to what is meant by a patent for a "process," that term not being used in the patent statute, and holding that a process patent is included under the general term "useful art," is quoted from in *Tilghman* v. *Proctor*, 102 U. S. 722, 1880, Supr. Court, Bradley, J.

Mr. Justice Grier uses the word "method" as equivalent to "process" in this case; so said in *American Bell Telephone Co.* v. *Dolbear*, 15 F. R. 453, 1883, Dist. Mass., Gray, J.

The court in this case is said in *New Process Fermentation Co.* v. *Maus*, 20 F. R. 729, 1884, North. Dist. Ind., Drummond, J., to have defined the term "process" as meaning the means of producing a result, and when it was so used the process was patentable, and would include all methods or means not effected by mechanism. And this rule is affirmed in *New Process Fermentation Co.* v. *Maus*, 122 U. S. 426, 1886, Supr. Court, Blatchford, J.

Corn-Planter Patent Case, 23 Wall. 181, 1874, Supr. Court, Bradley, J.

Is said, in *Herring* v. *Nelson*, 3 Ban. & A. 66, 1877, North. Dist. N. Y., Johnson, J., to affirm the doctrine that a reissue for a combination of old elements which omits one element of the original patent, is void, but that this rule does not apply when, of the old elements, some are single and some are sub-combinations. The case of *Gill* v. *Wells*, 22 Wall. 1 (q. v.) was considered

by the court in the *Corn-Planter Patent Case*, but its rule not adopted.

Is cited in *Kerosene Lamp Heater Co.* v. *Littell*, 3 Ban. & A. 318, 1878, Dist. N. J., Nixon, J., as limiting the effect of *Gill* v. *Wells* (q. v.).

This case sustained the reissued patents on the sole ground that the reissues were for things contained within the machines and apparatus described in the original patents. In this case there is a dissenting opinion by the judge who delivered the opinion of the court in *Gill* v. *Wells*, 22 Wall. 1, and who sought to apply in the *Corn-Planter Patent Case* the views which he had expressed in *Gill* v. *Wells*. It is said in *Wilson* v. *Coon*, 6 F. R. 619, 1880, South. Dist. N. Y., Blatchford, J., that the *Corn-Planter Patent Case* disregards much which was said in the opinion in *Gill* v. *Wells* which was unnecessary to the decision in that case.

"Where an inventor, after describing a machine, claims as his invention a certain combination of elements, or a certain device or part of the machine, this is an implied declaration as conclusive, so far as that patent is concerned, as if it were expressed, that the specific combination or the thing claimed is the only part which the patentee regards as new. He or some other person may have a distinct patent for the portions not covered by this; but that will speak for itself. So far as the patent in question is concerned, the remaining parts are old or common, and public." Quoted in *Rowell* v. *Lindsay*, 6 F. R. 294, 1881, East. Dist. Wis., Dyer, J.

It is said in *Putnam* v. *Hutchinson*, 12 F. R. 129, 1882, North. Dist. Ill., Blodgett, J., that prior to the decision in the former case it was the practice of the patent office to refuse patents when the device was shown in rejected applications on file in the office; but the court held in that case that such rejected applications must be

considered as abandoned experiments, and should not be allowed to defeat a patent.

The opinion of Mr. Justice Bradley in this case is quoted from at length in *Rowell* v. *Lindsay*, 113 U. S. 101, 1884, Supr. Court, Woods, J., to the effect that if an inventor describes a machine and claims a patent only upon a portion of it, the other portions of the machine are open to the public so far as that patent is concerned, although it may be covered by other patents.

Cowell *v.* **Sessions**, 17 F. R. 452, 1883, Dist. Conn., Shipman, J.

The Taylor patent, numbered 123,925, as construed in this case, is adopted in *Sessions* v. *Romadka*, 21 F. R. 126, 1884, East. Dist. Mich., Dyer, J.

Cowing *v.* **Rumsey**, 8 Blatchf. C. C. 38, 1870, North. Dist. N. Y., Woodruff, J.

In *Sayles* v. *Richmond, F. & P. R. R. Co.*, 4 Ban. & A. 244, 1879, East. Dist. Va., Hughes, J., says that the remark of the court in *Cowing* v. *Rumsey*, to the effect that an infringer of a patent might be treated as a trustee in respect to profits derived by him from the use of the patented article, was merely an incidental remark, *passim*, no question of jurisdiction arising, and the case being an action at law, and that this case does not intimate in any way that equity would have jurisdiction of a bill for profits arising from the use of a patented article solely on the ground of constructive trusteeship. See *Root* v. *Railway Co.*

Crandal *v.* **Watters**, 20 Blatchf. C. C. 97, 1881, South. Dist. N. Y., Blatchford, J.

The language of Blatchford, J., as to the question of substitution and inventive skill requisite to secure a patent, is quoted in *Butler* v. *Bainbridge*, 29 F. R. 145, 1886, South. Dist. N. Y., Coxe, J.

Crane *v.* **Price**, Webster Patent Cases, 409.

Decided that the substitution of anthracite for bituminous coal in hot blast in smelting iron ore was patentable as producing a better article of iron at less expense. Cited in *Hicks* v. *Kelsey*, 18 Wall. 674, 1873, Supr. Court, Bradley, J., as being a case of process of manufacture in which one article, replacing another in the combination, often produces different results.

In *Smith* v. *Goodyear Dental Vulcanite Co.*, 93 U. S. 497, 1876, Supr. Court, Strong, J., it is said that *Crane* v. *Price* has been doubted but not overruled, and the doubts have arisen from the uncertainty whether any new result was obtained by the use of authracite.

It is said in *Rumford Chemical Works* v. *Hecker*, 2 Ban. & A. 361, 1876, Dist. N. J., Nixon, J., that since the decision in *Crane* v. *Price*, it has not been considered safe to invoke the ordinary doctrine of equivalents in construing patents for new manufactures, or compositions of matter, and that the authority and principles of that case were recognized in *Hicks* v. *Kelsey*, 18 Wall. 674 (q. v.).

Crompton *v.* **Belknap Mills**, 3 Fisher, 536, 1869, Dist. N. H., Clark, J.

The doctrine of Clifford and Clark, JJ., in this case, that where a patent is for a combination of old devices, the patentee cannot insist on mechanical equivalents, is approved in *Yuengling* v. *Johnson*, 3 Ban. & A. 106, 1877, East. Dist. Va., Hughes, J.

Crouch *v.* **Speer**, 6 O. G. 187, 1874, Dist. N. J., Nixon, J.

Is cited in *Hawes* v. *Antisdel*, 2 Ban. & A. 11, 1875, East. Dist. Mich., Longyear, J., as a case where the evidence of a defendant to show prior use or prior knowledge being inconsistent with itself and frequently contradicted, was insufficient to establish that defence.

D.

Day *v.* Newark India Rubber Co., 1 Blatchf. C. C. 628, 1850, South. Dist. N. Y., Nelson, J.

Is cited in *Williams* v. *Empire Transportation Co.*, 3 Ban. & A. 535, 1878, Dist. N. J., Nixon, J., as deciding that a corporation cannot be found outside the State which creates it, to be served with legal process. In *Day* v. *Newark India Rubber Co.*, Nelson, J., quashed a writ of attachment and summons issued in the Circuit Court of the Southern District of New York against a New Jersey corporation. But see *Schollenberger*, *Ex Parte*, 96 U. S. 377; and see now act of Congress, March 3, 1887, c. 373, that no person can be sued except in the State of which he is an *inhabitant*.

Day *v.* New Engl. Car Spring Co., 3 Blatchf. C. C. 181, 1854, South. Dist. N. Y., Betts, J.

Is said in *Hubbell* v. *De Land*, 14 F. R. 474, 1882, East. Dist. Wis., Dyer, J., to have held that in actions at law on patents the defendant may plead a special plea setting up a license, although he also pleads the general issue without notice of special matter.

Dean *v.* Mason, 20 How. 198, 1857, Supr. Court. McLean, J.

This case is said, in *Root* v. *Railway Co.*, 105 U. S. 195, 1881, Supr. Court, Matthews, J., to have followed the rule as to profits recoverable in a suit for infringement of a patent, laid down in *Livingston* v. *Woodworth*, 15 How. 46 (q. v.), that is, actual profits made by the infringer, not the estimated profits which he might have made by due diligence.

De Florez *v.* **Raynolds**, 16 Blatchf. C. C. 408, 1879, South. Dist. N. Y., Blatchford, J.

Is cited in *Adair* v. *Thayer*, 7 F. R. 920, 1881, South. Dist. N. Y., Wheeler, J., as laying down the rule followed in the latter case.

De Florez *v.* **Raynolds**, 17 Blatchf. C. C. 436, 1880, South. Dist. N. Y., Blatchford, J.; s. c. 8 F. R. 434.

The decision in this case, and the reasoning of the court, was followed in *Siemens* v. *Sellers*, 16 F. R. 861, 1883, East. Dist. Penn., Butler, J.

Delano *v.* **Scott**, Gilp. 489, 1834, East. Dist. Penn., Hopkinson, J.

Is said in *Morse* v. *Davis*, 5 Blatchf. C. C. 44, 1862, North. Dist. N. Y., Hall, J., to lean towards the rule that one who sells a patented article as mere agent or clerk of another would not under the statute be liable to an action for treble damages given in cases of infringement.

Is said in *United Nickel Co.* v. *Worthington*, 13 F. R. 393, 1882, Dist. Mass., Lowell, J., to have decided that a mere workman who makes a patented article is not an infringer, on the ground that the statute does not mean to class mere agents, servants, etc., as makers and vendors of the patented improvement, but the principals for whose account and benefit they act.

Dennis *v.* **Cross**, 6 Fisher, 138, 1872, North. Dist. Ill., Blodgett, J.

Is stated briefly in *Kuhl* v. *Mueller*, 21 F. R. 513, 1884, South. Dist. Ohio, Sage, J.

"There is probably no principle of the patent law better settled than that the patentee is limited by his claim." Quoted in *Hancock Inspirator Co.* v. *Jenks*, 21 F. R. 916, 1884, East. Dist. Mich., Brown, J., but

qualified by saying that the specifications, models, or drawings may be looked at to assist the court in the construction of the claim.

Detroit Lubricator Manuf. Co. *v.* **Renchard**, 9 F. R. 293, 1881, East. Dist. Mich., Matthews, J.

Is distinguished in *Hubel* v. *Dick*, 28 F. R. 139, 1886, South. Dist. N. Y., Shipman, J.

Dibble *v.* **Augur**, 7 Blatchf. C. C. 86, 1869, South. Dist. N. Y., Blatchford, J.

Is cited in *May* v. *Juneau County*, 30 F. R. 245, 1887, West. Dist. Wis., Bunn, J., as holding that an assignment of a patentee's "right, title, interest, claim, or demand, in, to, or under a patent," refers wholly to the future as to infringements, and conveys only the right to claims for infringement which arise after the assignment, and not for infringement prior to the assignment.

Dobson *v.* **Dornan**, 118 U. S. 10, 1885, Supr. Court, Blatchford, J.

Was followed in *Fay* v. *Allen*, 30 F. R. 447, 1887, North. Dist. N. Y., Coxe, J.

Dobson *v.* **Hartford Carpet Co.**, 114 U. S. 439, 1884, Supr. Court, Blatchford, J.

Governed the decision in *Dobson* v. *Dornan*, 118 U. S. 16, 1885, Supr. Court, Blatchford, J., as to the decree for amount of damages, reversing the decree of the circuit court.

Is said in *Reed* v. *Lawrence*, 29 F. R. 920, 1886, West. Dist. Mich., Severens, J., to point out the rule that when a patented feature, which has been infringed by the defendant, is one which was the sole element of value in the thing manufactured, so that but for it the article would not be marketable, because not sufficiently

adapted to the purpose for which it was intended, the defendant is liable for the whole profits of the manufacture.

Governed the decision of *Fay* v. *Allen*, 30 F. R. 447, 1887, North. Dist. N. Y., Coxe, J.

Dorsey Harvester Revolving Rake Co. *v.* **Marsh**, 6 Fisher, 387, 1873, East. Dist. Penn., McKennan, J.

Is cited in *Gould* v. *Ballard*, 3 Ban. & A. 328, 1878, Dist. N. J., Nixon, J., as holding that any feature of an invention which is actually a part of it, and was only suggested or indicated in the specification of the original patent, might be distinctly described and covered by reissue, and also that a part of the original invention might be omitted. "This an inventor may do, because the public may use it, and there is nothing in the policy or terms of the patent act which forbids it."

Doughty *v.* **West**, 2 Fisher, 553, 1869, South. Dist. N. Y., Blatchford, J.

Is distinguished in *Sarven* v. *Hall*, 9 Blatchf. C. C. 526, 1872, Dist. Conn., Woodruff, J., from *Hussey* v. *Bradley*, 2 Fisher, 362.

Downton *v.* **Yaeger Milling Co.**, 9 F. R. 402, 1879, East. Dist. Mo., Dillon, J.

The construction given to the patent in suit in this case is followed in *Downton* v. *Allis*, 9 F. R. 770, 1881, East. Dist. Wis., Dyer, J.

Downton *v.* **Yaeger Milling Co.**, 108 U. S. 466, 471, 1882, Supr. Court, Woods, J.

Is said in *Eames* v. *Andrews*, 122 U. S. 66, 1886, Supr. Court, Matthews, J., to affirm the rule laid down in *Seymour* v. *Osborne* (q. v.), that a prior printed publication, to defeat a patent, must describe the invention so that one skilled in the art could make it.

Draper *v.* Hudson, 3 O. G. 354, 1873, Dist. Mass., Shepley, J.; s. c. 1 Holmes, 208.

Is cited in *Milligan & H. Glue Co.* v. *Upton*, 1 Ban. & A. 511, 1874, Dist. Mass., Clifford, J., that an article of manufacture to be patentable must be new, and not simply manufactured by new machinery.

Is said in *Gordon* v. *Anthony*, 4 Ban. & A. 258, 1879, South. Dist. N. Y., Blatchford, J., to have decided that although jurisdiction of the circuit court in equity in patent causes rests upon statute provisions, it is to be exercised in accordance to the course and principles of courts of equity, and the right to an account of profits is incident to a right to an injunction; and therefore if the right to an injunction fails, the right to an account of profits fails also.

The weight of authority in this country is said in *Gordon* v. *Anthony* to be opposed to the decision in the case of *Draper* v. *Hudson*. See now, however, *Root* v. *Railway Co.* *Draper* v. *Hudson* is said in *Gordon* v. *Anthony* to have been decided upon a mistake of the effect of the decision in *Stevens* v. *Gladding*, 17 How. 455.

Is criticised in *Atwood* v. *Portland Co.*, 5 Ban. & A. 534, 1880, Dist. Maine, Lowell, J., as proceeding upon the supposed authority of *Stevens* v. *Gladding*, 17 How. 455, which when critically examined is found not to decide the point decided in *Draper* v. *Hudson*, namely, that an account could never be ordered except as incident to an injunction. The court in *Draper* v. *Hudson* is said evidently to have overlooked the decision in *Howes* v. *Nute*, 4 Fisher, 463, and the former case is rejected as authority in the case of *Atwood* v. *Portland Co.* See *Root* v. *Railway Co.*

Draper *v.* Potomska Mills, 13 O. G. 276, 1878, Dist. Mass., Shepley, J.

The opinion of Mr. Justice Shepley is quoted in

Hubel v. *Dick*, 28 F. R. 139, 1886, South. Dist. N. Y., Shipman, J., upon the question of diligence in securing a patent for an invention after the date of the inceptive invention.

E.

Eagleton Manuf. Co. *v.* **West, &c. Manuf. Co.**, 2 F. R. 774, 1880, South. Dist. N. Y., Wheeler, J.

Is explained in *Hancock Inspirator Co.* v. *Jenks*, 21 F. R. 915, 1884, East. Dist. Mich., Brown, J., to the effect that the bill was dismissed because upon its face the patent was illegally granted, as it appeared that the application was amended by patentee's attorney after patentee's death, under authority given by him during his life.

Egbert *v.* **Lippman**, 104 U. S. 333, 1881, Supr. Court, Woods, J.

Is relied upon in *Hall* v. *McNeale*, 107 U. S. 97, 1882, Supr. Court, Blatchford, J., as to a sale of an invented article being presumptively not a case of experimental use.

Is said in *Driven Well Cases*, 16 F. R. 393, 405, 1883, South. Dist. Iowa, Shiras, J., to hold that "to constitute the public use of an invention, it is not necessary that more than one of the patented articles should be publicly used," and also that "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." Also cited in the concurring opinion of Love, J., in the same case.

It is stated in *Davis* v. *Fredericks*, 19 F. R. 100, 1884, South. Dist. N. Y., Wheeler, J., that the majority of the court, as well as Miller, J., dissenting, seems to

favor the view that the consent or allowance of the inventor is necessary to invalidate a patent under the acts of 1836 and 1839 by public use and sale, although this point is expressly left open.

Elizabeth (City of) *v.* **Nicholson Pavement Co.**, 97 U. S. 126, 1877, Supr. Court, Bradley, J.

Is cited by Lowell, J., in *Draper* v. *Wattles*, 3 Ban. & A. 620, 1878, Dist. Mass., as deciding that use, prior to application for a patent, if fairly and honestly experimental, may be public without depriving the inventor of his right to a patent if publicity was necessary to the experiment, although the inventor receives payment for the use. Mr. Justice Lowell comments on this, that it is somewhat difficult for a court to qualify, by a supposed intention not declared at the time, the acts of an inventor who sells the patented articles on two occasions apparently in the ordinary course of trade.

Is distinguished in *Campbell* v. *James*, 5 Ban. & A. 358, 1880, South. Dist. N. Y., Wheeler, J. In the former case the city did not make or save anything by the infringement, and was therefore discharged from a suit brought for an account of profits. In the latter case the defendant had made certain profits, but had paid them over to the Government, and was therefore held to an account to the patentee for the profits so made by him, as if he had not paid them to the Government.

Is compared in *Root* v. *Railway Co.*, 105 U. S. 202, 1881, Supr. Court, Matthews, J., with *Marsh* v. *Seymour*, 97 U. S. 348. In *Elizabeth* v. *Pavement Co.*, the bill was filed before the statute of 1870, and it was held that the complainant could not, before that statute, have a decree for both profits and damages, since that right was given by the statute; and as the city had made no profits, the bill was dismissed as to it, it remaining

liable to an action at law for damages. *Marsh* v. *Seymour* arose after that act, and a decree for damages was made, Clifford, J., saying that when the infringer had carried on his business so badly that it did not yield profits, damages of a compensatory character might be recovered.

Is referred to in *Stow* v. *Chicago*, 104 U. S. 551, 1881, Supr. Court, Woods, J., as showing that the filling with sand or gravel of the spaces between the blocks or rows of blocks of a pavement was part of the Nicholson invention.

This case is stated and the decision given in *Kirby* v. *Armstrong*, 5 F. R. 803, 1881, Dist. Ind., Gresham, J., as illustrating the point that if a complainant in a suit for an injunction and profits fails to show that the use of his invention in connection with other machinery of which his invention is an improvement has produced a definite part of the whole profits, the decree for profits must be nominal only.

Is cited in *Campbell* v. *New York*, 9 F. R. 503, 1881, South. Dist. N. Y., Wheeler, J., as a case where the invention, that is, a patent pavement, could not be experimented with and tested in private, and in such cases a public use may still be experimental.

Governs the decision of *Celluloid Manuf. Co.* v. *American Zylonite Co.*, 26 F. R. 698, 1886, South. Dist. N. Y., Shipman, J.

Ellithorp *v.* **Robertson**, 4 Blatchf. C. C. 307, 1859, South. Dist. N. Y., Ingersoll, J.

Ingersoll, J., is quoted in *Hubel* v. *Dick*, 28 F. R. 139, 1886, South. Dist. N. Y., Shipman, J., upon the subject of priority between one who obtains a prior patent and one who invented before him, but was guilty of laches in reducing the invention to practice and in applying for a patent. To defeat a patent, the prior

invention must have been reduced to practice, and embodied in some practical and useful form.

Emerson *v.* **Simm**, 6 Fisher, 281, 1873, Dist. N. J., Nixon, J.

Is said in *Goodyear Dental Vulcanite Co.* v. *Van Antwerp*, 2 Ban. & A. 255, 1876, Dist. N. J., Nixon, J., to adopt the rule of damages laid down in *Seymour* v. *McCormick*, 16 How. 490 (q. v.).

Eppinger *v.* **Richey**, 14 Blatchf. C. C. 307, 1877, South. Dist. N. Y., Shipman, J.

Judge Shipman, in his opinion in this case, gives to the general use of the invention as a test of its patentability the same importance as the Supreme Court did in the case of *Smith* v. *Goodyear Dental Vulcanite Co.*, 93 U. S. 486, and is quoted to this effect in *Washburn, &c. Manuf. Co.* v. *Haish*, 4 F. R. 908, 1880, North. Dist. Ill., Drummond, J.

Estabrook *v.* **Dunbar**, 10 O. G. 909, 1876, Dist. Mass., Shepley, J.

"The general terms, and sometimes special words in the claims, must receive such a construction as may enlarge or contract the scope of the claim, so as to uphold that invention, and only that invention, which the patentee has actually made and described, where such construction is not absolutely inconsistent with the language of the claim." Quoted in *Clark* v. *Kennedy Manuf. Co.*, 2 Ban. & A. 487, 1877, Dist. Conn., Shipman, J.

Eureka Co. *v.* **Bailey Co.**, 11 Wall. 488, 1870, Supr. Court, Miller, J.

Is explained in *Atwood* v. *Portland Co.*, 5 Ban. & A. 534, 1880, Dist. Maine, Lowell, J., as being a case where the jurisdiction in equity was sustained for an account of royalties due by a contract concerning the patent, an injunction being issued as incident to the account, that

is, until the defendant should account. See now *Root* v. *Railway Co.*

Is explained in *Root* v. *Railway Co.*, 105 U. S. 204, 1881, Supr. Court, Matthews, J., as not being a case where the injunction was incidental to the account. In that case the court had jurisdiction on account of the citizenship of the parties, and the bill demanded an injunction to restrain an infringement. The account of the royalty was incidental.

This case is cited in Bump on Patent Law, page 140, as authority that the invalidity of a patent and a license under it are inconsistent defences, but the case is examined in *National Manuf. Co.* v. *Meyers*, 7 F. R. 357, 1881, South. Dist. Ohio, Swing, J., and explained as being an action upon a contract for license to enforce the provisions of the contract, thereby creating an estoppel, and the court held the defences not to be inconsistent.

Evans *v.* Eaton, 3 Wheat. 454, 506, 1818, Supr. Court, Marshall, C. J.

It is said in *Emerson* v. *Hogg*, 2 Blatchf. C. C. 7, 1845, South. Dist. N. Y., Betts, J., that doubts were raised in the former case, whether under the general patent law improvements on different machines can be comprehended in the same patent, so as to give a right to the exclusive use of the several machines separately as well as in combination.

Is cited in *Day* v. *New England Car Spring Co.*, 3 Blatchf. C. C. 181, 1854, South. Dist. N. Y., Betts, J., to the effect that in an action at law for infringement of a patent a defendant may plead special matters which the statute authorizes to be given under the general issue.

Is said in *Hubbell* v. *De Land*, 14 F. R. 473, 1882, East. Dist. Wis., Dyer, J., to establish the rule that in

actions at law for an infringement of patent rights the defendant may file special pleas, although the substance of those might be given in evidence under the general issue under the statute.

The remark of the court in this case, that special patent acts extending or granting patents must be considered as engrafted on the general patent law, is said in *Fire Extinguisher Manuf. Co.* v. *Graham*, 16 F. R. 552, 1883, West. Dist. Va., Hughes, J., to be explained in the dissenting opinion of McLean, J., in *Bloomer* v. *McQuewan*, 14 How. 539, to the effect that that remark applied only to the jurisdiction of the court and other questions as to the validity of the patent, and not as to what rights are acquired by the patent. These must be regulated by the general patent law.

The Supreme Court in this case is said, in *Sessions* v. *Romadka*, 21 F. R. 132, 1884, East. Dist. Wis., Dyer, J., to intimate a doubt whether a patentee could claim, in the same patent, improvements on different mechanisms, so as to give a right to the exclusive use of the several mechanisms separately, as well as a right to the use of these mechanisms jointly.

Evans *v.* **Eaton**, 1 Pet. C. C. 327, 1816, Dist. Penn., Washington, J.

The remarks of Mr. Justice Washington in that case, that nothing in the Constitution prevents Congress from violating the obligation of contracts, are said in *Legal Tender Cases*, 12 Wall. 671, 1870, Supr. Court, dissenting opinion of Field, J., to be without significance against the collective force of various authorities, and are explained by him.

Evans *v.* **Eaton**, 3 Wash. 449, 1818, Dist. Penn., Washington, J.

"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." This language of Mr. Justice Washington is adopted in *Willimantic Linen Co.* v. *Clark Thread Co.*, 4 Ban. & A. 139, 1879, Dist. N. J., Nixon, J.

F.

Faulks *v.* **Kamp**, 3 F. R. 898, 1880, South. Dist. N. Y., Wheeler, J.

Is quoted in *Curran* v. *Burdsall*, 20 F. R. 838, 1883, North. Dist. Ill., Blodgett, J., to the effect that a sale of a patent right creates a warranty of title and draws to it any after acquired right of the vendor by estoppel.

Fay *v.* **Cordesman**, 109 U. S. 408, 420, 1883, Supr. Court, Blatchford, J.

Is quoted from in *Sargent* v. *Hall Safe & Lock Co.*, 114 U. S. 86, 1884, Supr. Court, Blatchford, J., to the effect that if in a patent for a combination the patentee embodies in his invention any element either by directly saying so in the claim, or by so describing it in the specification as to make it part of the invention, he makes that element material in his combination, and a court cannot declare it immaterial. And to same effect in *Shepard* v. *Carrigan*, 116 U. S. 598, 1885, Supr. Court, Woods, J.

Forbush *v.* **Bradford**, 1 Fisher, 317, 1858, Dist. Mass., Curtis, J.

Is cited in *Hoe* v. *Boston Daily Advertiser Co.*, 14 F. R. 916, 1883, Dist. Mass., Lowell, J., as a case where the preliminary injunction was refused, although the plaintiff had previously recovered judgment at law. The judge before whom the case at law was tried, having doubts as to the soundness of his rulings, refused the injunction when the case came before him in equity.

Forbush *v.* **Cook**, 2 Fisher, 668, 1857, Dist. Mass., Curtis, J.

The opinion of Mr. Justice Curtis is quoted in *Herring* v. *Nelson*, 3 Ban. & A. 61, 1877, North. Dist. N. Y., Johnson, J.: "To make a valid claim for a combination, it is not necessary that the several elementary parts of the combination should act simultaneously. If the elementary parts are so arranged that the successive action of each contributes to produce some practical result, which result, when attained, is the product of the simultaneous or successive action of all the elementary parts, viewed as one entire whole, a valid claim for thus combining these elementary parts may be made."

Is quoted from in *Hancock Inspirator Co.* v. *Jenks*, 21 F. R. 916, 1884, East. Dist. Mich., Brown, J., to the effect that it is not requisite to include in the claim for a combination, as elements thereof, all parts of the machine which are necessary to its action, save as they may be understood as entering into the mode of combining and arranging the elements of the combination.

Reference is made in *Celluloid Manuf. Co.* v. *Comstock, &c. Co.*, 27 F. R. 360, 1886, Dist. Conn., Shipman, J., to the well-known charge of Mr. Justice Curtis to the jury in the former case, as to the patentability of an invention.

Forsyth *v.* **Clapp**, 1 Holmes, 283, 1873, Dist. Mass., Shepley, J.

Language of the court is quoted in *Swain Turbine, &c. Co.* v. *Ladd*, 2 Ban. & A. 492, 1876, Dist. Mass., Shepley, J., to the effect that in construing a reissue the court will look into the specifications as well as the claims of the original and reissue, to see what inventions they cover.

Foster *v.* **Lindsay**, 3 Dill. 126, 1874, East. Dist. Mo., Treat, J.

This case is considered in *Lockwood* v. *Cleveland*, 6 F. R. 726, 1881, Dist. N. J., Nixon, J., and it is stated that Treat, J., in the former case, held under § 4918, U. S. R. S., that in a suit involving interfering patents, the court had power to adjudge both, as well as one, of the interfering patents void in whole or in part, and in that case made the decree declaring both the interfering patents to be void for want of novelty, supporting its opinion by the decision in *Mowry* v. *Whitney*, 14 Wall. 440.

Foster *v.* **Moore**, 1 Curtis, C. C. 279, 1852, Dist. Mass., Curtis, J.

Is cited in *Will* v. *Grier*, 5 F. R. 453, 1880, Dist. Del., Bradford, J., as holding that the doctrine of mechanical equivalents is not confined by the patent law to those elements which are directly known as such in the science of mechanics, but embraces those substitutes which, as a matter of judgment in construction, may be employed to accomplish the same end.

Fourniquet *v.* **Perkins**, 16 How. 82, 1853, Supr. Court, Taney, C. J.

Is cited in *Wooster* v. *Handy*, 21 F. R. 53, 1884, South. Dist. N. Y., Blatchford, J., as an authority that the circuit court may, on exceptions to a master's report, reverse an interlocutory decree and dismiss the bill.

French *v.* **Rogers**, 1 Fisher, 133, 1851, East. Dist. Penn., Kane, J.

Is said in *Gold & Stock Telegraph Co.* v. *Commercial Telegraph Co.*, 23 F. R. 343, 1885, South. Dist. N. Y., Shipman, J., to have decided that a United States patent issued after the issue of an English patent for the

same invention, but applied for before the date of the application for the English patent, was not within § 6 of the patent act of 1839, limiting the term of such patent by the term of the foreign patent.

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Gage *v.* **Herring**, 107 U. S. 640, 646, 1883, Supr. Court, Gray, J.

Is said in *Schillinger* v. *Greenway Brewing Co.*, 17 F. R. 248, 1883, North. Dist. N. Y., Blatchford, J., to decide that the invalidity of a claim in a reissue does not impair the validity of a claim in the original patent which is repeated and separately stated in the reissued patent.

Is quoted from in *Giant Powder Co.* v. *Safety Nitro Powder Co.*, 19 F. R. 512, 1884, Dist. Cal., Sawyer, J., to the same effect.

Is said in *Worden* v. *Searls*, 21 F. R. 408, 1884, Dist. N. J., Nixon, J., to be an authority for holding that the invalidity of a new claim in a reissue does not render the patent void or impair the validity of the original claims, and that suits may be maintained on the part which the patentee is entitled to hold, although if such suits are commenced before the disclaimer is entered, no costs can be recovered.

Is interpreted in *Yale Lock Co.* v. *Sargent*, 117 U. S. 553, 1885, Supr. Court, Blatchford, J., as deciding that the invalidity of a new claim in a reissue does not impair the validity of a claim in it which is only a repetition and separate statement of a claim in the original patent. A reissued patent is within §§ 4917 and 4922, U. S. R. S., and if a defendant has infringed such a restated valid claim of a reissue, the plaintiff, by filing a disclaimer of the invalid claims,

may have a decree without costs, if there has been no unreasonable delay in filing his disclaimer.

Is interpreted in *Reed* v. *Chase*, 25 F. R. 95, 1885, West. Dist. Mich., Matthews, J., as deciding that if the claims of a reissue, or one or some of them, are either within the scope of the claim of the original patent, or are legally identical with it, to that extent the reissued patent can and ought to be upheld.

Gallahue *v.* **Butterfield**, 6 Fisher, 203, 214, 1872, South. Dist. N. Y., Woodruff, J.

Is cited in *Gould* v. *Ballard*, 3 Ban. & A. 327, 1878, Dist. N. J., Nixon, J., as deciding that an inventor might always omit in a reissue a part of his original invention, and retain that part only which he deemed fit to retain. In that case the original patent had a weight co-operating with a spring to give greater efficiency to the spring, and in the reissue he claimed the spring alone.

Gardner *v.* **Herz**, 118 U. S. 180, 1885, Supr. Court, Blatchford, J.

Is said in *Consolidated Fruit Jar Co.* v. *Bellaire Stamping Co.*, 28 F. R. 94, 1886, South. Dist. Ohio, Sage, J., to decide that where the mode of construction of the article claimed, the material employed, the form after construction, and the purpose for which it is to be used, have been described in separate earlier patents, although the article itself has never been described in any single patent, and to that extent is novel and is of great utility, it does not require invention to produce it.

The principle of decision of this case was followed in *Thatcher Heating Co.* v. *Burtis*, 121 U. S. 295, 1886, Supr. Court, Matthews, J.

Garretson *v.* **Clark**, 111 U. S. 127, 1883, Supr. Court, Field, J.

"The patentee must in every case give evidence

tending to separate or apportion the defendant's profits and the patentee's damages between the patented and unpatented features, and such evidence must be tangible and reliable, and not conjectural and speculative, or he must show by equally reliable testimony 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 patented feature." Quoted in *Dobson* v. *Hartford Carpet Co.*, 114 U. S. 445, 1884, Supr. Court. Blatchford, J.

This case is stated briefly and the language of Field. J., quoted at length in *Reed* v. *Lawrence*, 29 F. R. 920. 1886, West. Dist. Mich., Severens, J., to the same effect.

Garretson *v.* **Clark**, 15 Blatchf. C. C. 70, 1878, North. Dist. N. Y., Blatchford. J.

Is distinguished in *Zane* v. *Peck*, 13 F. R. 476, 1882. Dist. Conn., Shipman, J. Was followed in *Fay* v. *Allen*. 30 F. R. 447, 1887, North. Dist. N. Y., Coxe, J.

Gaylor *v.* **Wilder**, 10 How. 477, 1850, Supr. Court, Taney. C. J.

Is cited in *Railroad Co.* v. *Trimble*, 10 Wall. 379, 1870, Supr. Court, Swayne, J., to the effect that a contract of assignment, made before the issuing of a patent, and recorded, vests the legal title to the patent in the assignee without further conveyance.

This case is said in *Perry* v. *Corning*, 7 Blatchf. C. C. 201, 203, 1870, North. Dist. N. Y., Woodruff, J., to make the test of the right of an assignee to sue in his own name, the question whether he has the entire monopoly in his locality to the exclusion of the patentee himself.

Is quoted in *Coffin* v. *Ogden*, 18 Wall. 125, 1873. Supr. Court, Swayne, J., as decisive of that case upon the point of what test of efficiency is necessary to show that an anticipating invention is a complete invention.

Is distinguished and explained in *North Western Fire Extinguisher Co.* v. *Philadelphia Fire Extinguisher Co.*, 1 Ban. & A. 190, 1874, East. Dist. Penn., McKennan, J., particularly to the effect that on the question of prior invention in a suit, the fact that the alleged prior inventor has not tested his invention or brought it into public use, and has abandoned it, and is ignorant of its value, does not invalidate the defence if the inventor still has his invention in memory, and it is not wholly and irrecoverably lost to the public

Is quoted to the same effect in *Shoup* v. *Henrici*, 2 Ban. & A. 251, 1876, West. Dist. Penn., McKennan, J., as in *Coffin* v. *Ogden*, *supra*.

It is said in *Hendrie* v. *Sayles*, 98 U. S. 552, 1878, Supr. Court, Clifford, J., that *Clum* v. *Brewer*, 2 Curt. C. C. 520, was decided upon the authority of *Gaylor* v. *Wilder*, to the effect that under the assignment in the case the extended term as well as the original term passed to the assignee.

Mr. Chief-Justice Taney says of §§ 4886, 4920, U. S. R. S., "by knowledge and use, the legislature meant knowledge and use existing in a manner accessible to the public." Applied in *Bullock Printing Press Co.* v. *Jones*, 3 Ban. & A. 197, 1878, South. Dist. N. Y., Wheeler, J.

Is cited in *Hammond* v. *Hunt*, 4 Ban. & A. 113, 1879, Dist. Mass., Lowell, J., as a case where the patentee having excepted out of his grant the right to make the machine within a certain part of the territory granted, the exclusive license would not amount to an assignment. The case of *Gaylor* v. *Wilder* is also said to be the leading case upon the point that when the interest of the exclusive licensee does not amount to an assignment, an action at law must be in the name of the patentee.

Is cited in *Nelson* v. *McMann*, 4 Ban. & A. 210, 1879, South. Dist. N. Y., Blatchford, J., as deciding that

while by § 14 of the patent act of 1836, a patentee might assign his exclusive right within or throughout a specified part of the United States, and the assignee may upon such an assignment sue in his own name for an infringement of his rights; yet, in order to enable him to sue, the assignment must convey the monopoly which the patentee held in the territory specified, excluding the patentee himself as well as others; and any assignment short of this is a mere license.

It is said in *United States Stamping Co.* v. *Jewett*, 7 F. R. 877, 1879, South. Dist. N. Y., Blatchford, J., that the only difference between *Gaylor* v. *Wilder* and the latter case is, that in the former case the assignment by the inventor was recorded in the patent office before the patent was issued; whereas in the latter case the patent had been allowed and ordered to issue before an assignment was made.

Is cited in *Theberath* v. *Celluloid Manuf. Co.*, 5 Ban. & A. 580, 1880, Dist. N. J., Nixon, J., as settling the difference between a license and an assignment. Any assignment short of an entire and unqualified monopoly is a mere license.

Is said in *Searls* v. *Bouton*, 12 F. R. 142, 1882, South. Dist. N. Y., Wheeler, J., to hold that § 4886, U. S. R. S., should be construed, together with the section as to notice of the names and residences of persons alleged to have had prior knowledge of the invention, and that prior knowledge in an invention not accessible to the public would not defeat a patent.

The rule in this case as to what constitutes a licensee was applied in *Gamewell Fire Alarm Telegraph Co.* v. *Brooklyn*, 14 F. R. 256, 1882, East. Dist. N. Y., Wallace, J.; that is, that anything less than a transfer of this entire monopoly for a given locality makes the transferer only a licensee.

Is said in *Fire Extinguisher Manuf. Co.* v. *Graham*,

16 F. R. 553, 1883, West. Dist. Va., Hughes. J., to decide nothing more than that an invention may be assigned before the patent issues; and it does not touch the question whether, when the inventor and his assignee lose all right to a patent, another who obtains the right to it by the special act is bound by the assignment.

Is said in *Consolidated Electric Light* v. *Edison Electric Light Co.*, 25 F. R. 721, 1885, South. Dist. N. Y., Wallace, J., to have decided that the legal title to a patent vests at once upon the issue of the patent in the person who, by the records, is entitled to it.

Giant Powder Co. *v.* **California Vigorit Powder Co.**, 4 F. R. 720, 1880, Dist. Cal., Field, J.

This case is said, in *Flower* v. *Rayner*, 5 F. R. 800, 1881, Dist. N. J., Nixon, J., to hold that the examination of the original and the reissued patents by the court is allowable, to see whether or not they disclose on their face a case in which the commissioner of patents has authority to act, or whether he has exceeded his authority in reissuing letters for an invention different from that described in the patent. If they disclose a case in which the commissioner has no jurisdiction to act, or a case in which by his determination he has exceeded his jurisdiction, the reissued letters must fall.

This case is considered critically by Lowell, J., in *Smith* v. *Merriam*, 6 F. R. 716, 1881, Dist. Mass., as being a case supposed by some members of the bar to declare that if the court can discover upon comparison of the original and the reissue that there was no defective specification to be amended, and that the claim was not broader than the invention, the action by the commissioner of patents in granting a reissue was in excess of his jurisdiction and void; and that if the patentee claims too little instead of too much, the specification is

not defective by reason of that mistake, but all which was not claimed was dedicated to the public. This view of the case is not approved by the court; and the decision of the commissioner upon the defectiveness of the original specification is held to be final and conclusive.

Giant Powder Co. *v.* **Safety Nitro Powder Co.**, 19 F. R. 511, 1884, Dist. Cal., Sawyer, J.

Is said in *Railway Register Manuf. Co.* v. *North Hudson C. R. Co.*, 23 F. R. 595, 1885, Dist. N. J., Nixon, J., to say that the Supreme Court has over and over again affirmed the principle that all questions of fact behind a patent are to be examined, heard, and conclusively determined by the commissioner of patents.

Is said in *Celluloid Manuf. Co.* v. *Zylonite Brush & Comb Co.*, 27 F. R. 295, 1886, South. Dist. N. Y., Wallace, J., to be a decision directly and completely in point against the sufficiency of a plea denying the validity of a reissue which is granted merely to reinstate a patentee to an invention which he has surrendered in order to obtain a wider monopoly than the original patent granted him.

Gibson *v.* **Van Dresar**, 1 Blatchf. C. C. 532, 1850, North. Dist. N. Y., Nelson, J.

Is cited in *Green* v. *French*, 4 Ban. & A. 172, 1879. Dist. N. J., Nixon, J., to the effect that where the validity of a complainant's patent is already established by protracted and expensive litigation, and the proof of the infringement clear, the court has no discretion, but is bound to grant a preliminary injunction.

Gill *v.* **Wells**, 22 Wall. 1, 1874, Supr. Court, Clifford, J.

Showed wide differences between the original patent and the reissue. In *Collar Co.* v. *Van Deusen*, 23 Wall. 558, 1874, Supr. Court, Clifford, J., it was said

that the difference between the original patent and the reissue was wider even than the difference in *Gill* v. *Wells*.

The principles stated in this case are quoted in *Miller* v. *Bridgeport Brass Co.*, 3 Ban. & A. 25, 1877, Dist. Conn., Shipman, J., particularly to the point that if a patent is taken for a combination including all the ingredients of a machine, without indicating or suggesting any other invention, a reissue cannot be granted for a combination of a smaller number of ingredients which may be found to produce a new and useful result.

Is examined at length, and compared with other cases in *Herring* v. *Nelson*, 3 Ban. & A. 65, 1877, North. Dist. N. Y., Johnson, J., and it is said that in *Gill* v. *Wells* the reissues omitted one well-described ingredient of the patented combination, and substituted in its place several other devices not equivalent to the omitted element, nor claimed to be such, and the court held the reissue not to be for the original invention. *Gill* v. *Wells* is said in *Herring* v. *Nelson* not to have been followed in the *Corn-Planter Patent Case*, 23 Wall. 181.

Is referred to in *Powder Co.* v. *Powder Works*, 98 U. S. 139, 1878, Supr. Court, Bradley, J., as deciding that a reissue to be valid must be for the same invention as the original patent.

The decision is limited in *Kerosene Lamp Heater Co.* v. *Littell*, 3 Ban. & A. 318, 1878, Dist. N. J., Nixon, J., who says it will be observed that the court in *Gill* v. *Wells* did not say that where a patent is originally taken out for a single combination, a reissue may not be had in which a separate claim may not be made for subcombinations of a part of the elements joined in one in the original patent. Nixon, J., intimates that it may, and refers to *Corn-Planter Patent Case*, 23 Wall. 181, and *Herring* v. *Nelson*, 12 O. G. 753.

Is explained in *Johnson* v. *Flushing, &c. R. R. Co.*,

3 Ban. & A. 433, 1878, East. Dist. N. Y., Benedict, J., to be a case where there was not only an omission in the reissue of one well-described ingredient of the patented combination, but there was substituted in its place several other devices not equivalent for the omitted element. This invalidates the reissue.

Is cited in *Goodyear Dental Vulcanite Co.* v. *Preterre*, 3 Ban. & A. 477, 1878, South. Dist. N. Y., Wheeler, J., to the effect that inventors of a combination are as much entitled to equivalents as the inventors of other patentable improvements, if the equivalents were known to be such at the date of the *patent*. Compare *Goodyear Dental Vulcanite Co.* v. *Davis*, 12 O. G. 1, in which case the date of the *invention* is said to control.

"By an equivalent it is meant that the ingredient substituted for the one withdrawn performs the same function as the other, and that it was well known at the date of the patent securing the invention as a proper substitute for the one omitted in the patented invention. Hence it follows that a party who merely substitutes another old ingredient for one of the ingredients of a patented combination is an infringer, if the substitute performs the same function as the ingredient for which it was substituted, and was well known at the date of the patent as a proper substitute for the omitted ingredient; but the rule is otherwise if the ingredient substituted was a new one, or performed substantially a different function, or was not well known at the date of the plaintiff's patent as a proper substitute for the one omitted, as in that event he does not infringe."

Quoted in *Babcock* v. *Judd*, 5 Ban. & A. 130, 1880, Dist. Conn., Shipman, J.

Is said in *Atwood* v. *Portland Co.*, 5 Ban. & A. 537, 1880, Dist. Maine, Lowell, J., to decide that a patentee reissuing his patent has no right to omit something which he had before described as essential.

In this case a reissue was held invalid. It is said in *Wilson* v. *Coon*, 6 F. R. 619, 1880, South. Dist. N. Y., Blatchford, J., that much is said in the opinion in *Gill* v. *Wells* that was unnecessary to the decision in that case, and what was so said seemed to have been disregarded by the same court in the subsequent case of the *Corn-Planter Patent*, 23 Wall. 181. In this last case there was a dissenting opinion by the judge who delivered the opinion of the court in *Gill* v. *Wells*, and who sought to apply in the *Corn-Planter Patent Case* the views he had set forth in *Gill* v. *Wells*.

It is said in *Dederick* v. *Cassell*, 9 F. R. 308, 1881, East. Dist. Penn., Butler, J., that language may be found in *Gill* v. *Wells* which, standing alone, might justify the proposition that where a general combination embraces minor subordinate combinations not claimed in the original patent, a subsequent introduction of claims for the latter is invalid, but that this proposition cannot be reconciled with what has been decided elsewhere, both before and since; citing among other cases *Herring* v. *Nelson*, 12 O. G. 753.

Is said in *Brett* v. *Quintard*, 10 F. R. 742, 1882, Dist. Conn., Shipman, J., to describe the diff ent parts and general appearance of the Gill machine for the manufacture of hat bodies and the state of the art at that time.

Gillespie *v.* **Cummings**, 3 Sawy. 259, 1874, Dist. Cal., Sawyer, J.

This case is explained in *Hayes* v. *Dayton*, 8 F. R. 705, 1880, South. Dist. N. Y., Blatchford, J., as deciding that a bill founded on two patents was not bad for multifariousness, since it appeared by the bill that the infringement must necessarily be an infringement of both patents, and therefore the evidence would apply to both cases, there being a common point of litigation.

Is cited in *Deering* v. *Winona Harvester Works*, 24 F. R. 90, 1885, Dist. Minn., Nelson, J., as following *Nourse* v. *Allen*, 3 Fisher, 63 (q. v.), as to joining infringements of the same patents in the same bill.

Godfrey *v.* **Eames**, 1 Wall. 317, 1863, Supr. Court, Swayne, J.

Is cited in *Bevin* v. *East Hampton Bell Co.*, 9 Blatchf. C. C. 60, 1871, Dist. Conn., Shipman, J., upon the question of the effect of a second application after the rejection of the first upon the point of abandonment.

Is cited in *Goodyear Dental Vulcanite Co.* v. *Smith*, 1 Ban. & A. 209, 1874, Dist. Mass., Shepley, J., to the effect that if a party choose to withdraw his application for a patent, intending at the time to file a new petition, and he does so, the two petitions are to be considered as parts of the same transaction, and both as constituting one continuous application within the meaning of the law.

Is said in *Goodyear Dental Vulcanite Co.* v. *Willis*, 1 Ban. & A. 583, 1874, East. Dist. Mich., Emmons, J., to adopt the proposition that when two successive applications are made for the procurement of a patent, and there is no proof of actual abandonment, the subsequent application will be decreed a continuation of the first.

Is cited in *Smith* v. *Goodyear Dental Vulcanite Co.*, 93 U. S. 500, 1876, Supr. Court, Strong, J., to the effect that a withdrawal of an application for a patent, with the intention of filing a new application, and the filing such application, is one continued application, and to be treated as such.

The statement in this case that "if an applicant for a patent chooses to withdraw his application, intending at the time to file a new petition, and he does so, the two petitions are to be considered as parts of one transaction, and both as constituting one continuous appli-

cation," must be understood to mean when the original application is not abandoned. *Weston* v. *White*, 2 Ban. & A. 368, 1876, Dist. Conn., Shipman, J.

Goff *v.* **Stafford**, 14 O. G. 748, 1878, Dist. R. I., Clifford, J.

This case is criticised in *De Florez* v. *Raynolds*, 5 Ban. & A. 152, 1880, South. Dist. N. Y., Blatchford, J., as regards the *dictum* of Mr. Justice Clifford on a point not directly involved in the decision of the case; that is, that a patent granted prior to the act of 1870, but under the act of 1861, for a term of seventeen years, would begin to run and remain in force for the term of seventeen years "from the time it was granted," and not from the prior date of an English patent granted to the inventor for the same invention; and the court in *De Florez* v. *Raynolds* refuses to follow the opinion of Clifford, J., on this point.

Is said in *Siemens* v. *Sellers*, 16 F. R. 861, 1883, East. Dist. Penn., Butler, J., to have decided contrary to the rule adopted in *De Florez* v. *Raynolds*, 17 Blatchf. 436; but the point was not directly involved in the decision of the case. See *De Florez* v. *Raynolds*.

Gold, &c., Separating Co. *v.* **United States Disintegrating Ore Co.**, 6 Blatchf. C. C. 307, 1869, South. Dist. N. Y., Blatchford, J.

This case is stated at some length in *Lockwood* v. *Cleveland*, 6 F. R. 724, 1881, Dist. N. J., Nixon, J., as being a case where it was held under § 4918, U. S. R. S., that in suits in equity involving interfering patents, if proper issues are formed by the pleadings, affirmative relief can be granted to either of the parties by declaring one or the other or all of the patents void or valid, without the necessity of the defendant filing a cross bill for this purpose. The court in *Lockwood* v. *Cleveland* suggests that the best evi-

dence that the mode of procedure in the above case was regular, is found in the fact that neither of the distinguished patent-lawyers who argued the case, suggested a doubt that the court had authority, under the provisions of the statute, to decide such issues upon the bill and answer.

Goodyear *v.* **Bishop**, 2 Fisher, 160, 1861, South. Dist. N. Y., Shipman, J.

Is said in *Goodyear Dental Vulcanite Co.* v. *Van Antwerp*, 2 Ban. & A. 255, 1876, Dist. N. J., Nixon, J., to adopt the rule of damages laid down in *Seymour* v. *McCormick*, 16 How. 490 (q. v.).

Goodyear *v.* **Day**, 1 Blatchf. C. C. 565, 1850, South. Dist. N. Y., Nelson, J.

Is explained in *Goodyear* v. *Union India Rubber Co.*, 4 Blatchf. C. C. 68, 1857, South. Dist. N. Y., Ingersoll, J., as deciding that a federal court had no jurisdiction of a patent suit where the only prayer was that the defendant be enjoined from violating his agreement in a license to pay license fees.

Goodyear *v.* **Day**, 2 Wall. Jr., 283, 296, 1852, Third Circuit, Grier, J.

The opinion of Mr. Justice Grier that the practice of sending parties to law by a court of equity, where the validity of a patent is denied, before granting a final injunction, is a matter of discretion in the court of equity, and a less common practice here than in England, is quoted in *Cochrane* v. *Deener*, 94 U. S. 783, 1876, Supr. Court, Bradley, J., with approval.

Decided that a reissue which divides up into two patents, what was before patented in one patent, that is, a process and a product, the product being the direct result of the process, and constituting a discovery, is valid. In *Powder Co.* v. *Powder Works*, 98 U. S. 137, 1878, Supr. Court, Bradley, J., the case of *Good-*

year v. *Day* is stated, and the opinion of Mr. Justice Grier quoted from to show that a reissue which does not claim more than the original patent is valid.

The opinion of Mr. Justice Grier in this case is quoted in *Washburn, &c., Manuf. Co.* v. *Haish*, 4 F. R. 905, 1880, North. Dist. Ill., Drummond, J., to the effect that when any valuable discovery has been made, the invention is generally the culminating point of many experiments not only of the inventor but of others. If those others are unsuccessful, their experiments give them no right to claim a share of the honor or profit.

The opinion of Mr. Justice Grier (page 299) is quoted from in *Whittlesey* v. *Ames*, 5 Ban. & A. 102, 1880, North. Dist. Ill., Blodgett, J.; s. c., 13 F. R. 898, to the effect that any valuable invention is usually contemporaneous with a great number of unsuccessful experiments in similar devices, but these experiments have no effect upon the right of the inventor to his monopoly.

Is cited in *Root* v. *Railway Co.*, 105 U. S. 205, 1881, Supr. Court, Matthews, J., as settling the practice that a trial of the validity of a patent may be had in a suit in equity as well as at law, in the United States.

Is said in *Teas* v. *Albright*, 13 F. R. 412, 1882, Dist. N. J., Nixon, J., to be the same in principle with the latter case, and not to sustain jurisdiction in a federal court of a suit to enforce the covenants of a license.

Goodyear *v.* New Jersey Central Railroad, 2 Wall. Jr., 356, 1853, Dist. N. J., Grier, J.

Is said in *Welling* v. *Rubber, &c. Manuf. Co.*, 2 Ban. & A. 4, 1875, Dist. N. J., Nixon, J., to decide that one patent may cover both process and product; but in such a case the description in the specification and claim should show the inventor had both in mind.

Goodyear *v.* Providence Rubber Co., 2 Cliff. 351, 371, 1864, Dist. R. I., Clifford, J.; s. c. 2 Fisher, 499.

"No doubt can be entertained that a new product of manufacture, and a new process or method of producing the new article, are proper subjects of separate and distinct claims in an original patent." Quoted in *Merrill* v. *Yeomans*, 1 Ban. & A. 55, 1874, Dist. Mass., Shepley, J.

Is said in *Badische Anilin, &c. Fabrik* v. *Hamilton Manuf. Co.*, 3 Ban. & A. 239, 1878, Dist. Mass., Shepley, J., fully to sustain the right to reissue a patent in two divisions, one for the new process and one for the new product.

Goodyear *v.* Union Rubber Co., 4 Blatchf. C. C. 63, 1857, South. Dist. N. Y., Ingersoll, J.

Stated in *Hartell* v. *Tilghman*, 99 U. S. 554, 1878, Supr. Court, Miller, J., as a case where a court of the United States refused jurisdiction of a case brought to restrain licensees from using an invention until they accounted and paid royalties.

Is said in *Teas* v. *Albright*, 13 F. R. 412, 1882, Dist. N. J., Nixon, J., to be very similar to the latter case in all its facts and aspects, except that the defendants were licensees and not grantees, and jurisdiction in a federal court of a bill to enforce the covenants of a license was not sustained. See *Wilson* v. *Sandford*.

Goodyear Dental Vulcanite Co. *v.* Davis, 12 O. G. 1, 1877, Dist. Mass., Shepley, J.

Mr. Justice Shepley says, that an inventor of a combination is entitled to equivalents, if the equivalents were known to be such at the date of the invention. But compare *Gould* v. *Rees*, 15 Wall. 187, 194; *Gill* v. *Wells*, 22 Wall. 1, where the same statement is made in regard to the date of the patent. In *Goodyear Dental*

Vulcanite Co. v. *Preterre*, 3 Ban. & A. 477, 1878, South. Dist. N. Y., Wheeler, J., it is questioned but not decided which is the controlling date.

Goodyear Dental Vulcanite Co. *v.* **Davis**, 102 U. S. 222, 1880, Supr. Court, Strong, J.

The evidence in *Atwater Manuf. Co.* v. *Beecher Manuf. Co.*, 8 F. R. 609, 1881, Dist. Conn., Shipman, J., is stated to be too scanty to bring the latter case within the doubts expressed by the Supreme Court in the former case as to the validity of a disclaimer.

Goodyear Dental Vulcanite Co. *v.* **Gardner**, 4 Fisher, 226, 1870, Dist. R. I., Clifford, J.

Is explained in *Goodyear Dental Vulcanite Co.* v. *Smith*, 1 Ban. & A. 207, 1874, Dist. Mass., Shepley, J., and the construction contended for by the defendant in the latter case — that is, that the use of the moulds is the process or mode by which the artificial plate for teeth and gums is constructed — is negatived.

Goodyear Dental Vulcanite Co. *v.* **Root**, 6 O. G. 154, 1874, North. Dist. N. Y., Hunt, J.

Hunt, J., considered himself bound by the previous decisions in Massachusetts on the same patent. This course is followed in *Goodyear Dental Vulcanite Co. v. Willis*, 1 Ban. & A. 571, 1874, East. Dist. Mich., Emmons, J.

Goodyear Dental Vulcanite Co. *v.* **Wetherbee**, 2 Cliff. 555, 1866, Dist. Mass., Clifford, J.

Is explained as to the question of the effect of a new application filed after a rejection of the previous one upon the question of abandonment in *Bevin* v. *East Hampton Bell Co.*, 9 Blatchf. C. C. 62, 1871, Dist. Conn., Shipman, J.

Is cited in *Colgate* v. *Western Union Telegraph Co.*, 4 Ban. & A. 64, 1878, South. Dist. N. Y., Blatchford, J.,

to the point that an original application being rejected by the commissioner of patents, and not renewed for eight years, is not proof of intention of abandonment of the invention, there being no proof of withdrawal of the application or of actual abandonment. The fact that the invention had gone into public use to some extent during that time, with the knowledge and consent of the inventor, was not held to change the case.

Goodyear Dental Vulcanite Co. *v.* **Willis**, 1 Flip. 338, 1874, East. Dist. Mich., Emmons, J.

The subject of the operation of a decree in one circuit court upon the decision of a suit on the same patent in another circuit court, is said to have been fully discussed in this case, and authorities collated, and the decision in this case is approved in *Searls* v. *Worden*, 11 F. R. 502, 1882, Dist. Mich., Brown, J.

Gordon *v.* **Anthony**, 16 Blatchf. C. C. 234, 1879, South. Dist. N. Y., Blatchford, J.

The rule in this case, that a receiver cannot convey title unless the legal owner of the title joins, was said in *Adams* v. *Howard*, 22 F. R. 658, 1884, South. Dist. N. Y., Wallace, J., not to apply to the transfer of a mere equitable title.

Gorham Co. *v.* **White**, 14 Wall. 511, 1871, Supr. Court, Strong, J.

Cited in *Perry* v. *Starrett*, 3 Ban. & A. 489, 1878, South. Dist. N. Y., Wheeler, J., as deciding that to constitute infringement of a design patent, the designs must be so similar as to appear to ordinary observers to be the same, and they need not be so near alike as to appear to experts to be the same.

Is said in *Jennings* v. *Kibbe*, 10 F. R. 670, 1882, South. Dist. N. Y., Blatchf., J., to decide that the true test of identity of design is sameness of appear-

auce; in other words, sameness of effect upon the eye, — not necessarily the eye of an expert, but the eye of an ordinary observer of ordinary acuteness.

Gottfried *v.* **Miller**, 104 U. S. 521, 1882, Supr. Court, Woods, J.

Is quoted from in *Curran* v. *Burdsall*, 20 F. R. 838, 1883, North. Dist. Ill., Blodgett, J., to the effect that where one sells a patented machine and subsequently acquires a right in the patent, the sale of the machine estops him from prosecuting his vendee for the infringement of the patent.

Gould *v.* **Rees**, 15 Wall. 187, 1871, Supr. Court, Clifford, J.

Is said in *Sarven* v. *Hall*, 11 Blatchf. C. C. 298, 1873, Dist. Conn., Woodruff, J., not to be in conflict with the decision in the latter case.

Decides that if a defendant omits one element of a patented combination, he does not infringe it although he substitutes a new element, or one which performs a substantially different function, or one which is old but was not known at the time of plaintiff's invention to be a proper substitute for the omitted ingredient. *Turrell* v. *Spaeth*, 2 Ban. & A. 187, 1875, Dist. N. J., Nixon, J.

Mr. Justice Clifford is cited in *Goodyear Dental Vulcanite Co.* v. *Preterre*, 3 Ban. & A. 477, 1878, South. Dist., N. Y., Wheeler, J., to 'the effect that inventors of a combination are as much entitled to equivalents as the inventor of other patentable improvements, if the equivalents were known to be such at the date of the patent. But compare *Goodyear Dental Vulcanite Co.* v. *Davis*, 12 O. G. 1, where it is said to be the date of the invention. It is questioned in *Goodyear Dental Vulcanite Co.* v. *Preterre*, which date controls.

This case is said, in *Rowell* v. *Lindsay*, 6 F. R. 296, 1881, East. Dist. Wis., Dyer, J., to settle the rule of law that *bona fide* inventors of a combination are as

much entitled to equivalents as inventors of other patentable improvements, and the language of the court to this point is quoted at length.

Gould *v.* Spicer, 15 F. R. 344, 1882, Dist. R. I., Gray, J.

Is said in *Singer Manuf. Co.* v. *Goodrich*, 15 F. R. 456, 1883, Dist. Mass., Nelson, J., to decide that if any invention claimed or described in a reissue is identical with either of the claims in the original, it must be protected.

Gould's Manuf. Co. *v.* Cowing, 8 O. G. 278, 1874, North. Dist. N. Y., Hunt, J.

Opinion of Mr. Justice Hunt: "I understood the rule to be settled that when the patent is for an improvement in a machine, the damages for an infringement of such patent are confined to the profits made by the use of the improvement only, and not by the manufacture of the whole instrument." Quoted in *Calkins* v. *Bertrand*, 8 F. R. 758, 1881, North. Dist. Ill., Blodgett, J.

Graham *v.* McCormick, 11 F. R. 859, 1880, North. Dist. Ill., Drummond, J.

Is said in *Vermont Farm Machine Co.* v. *Marble*, 19 F. R. 308, 1884, Dist. Vt., Wheeler, J., to seem to have decided on full consideration and argument, under the statute now in force, that an inventor may have a patent for an invention described in a prior patent to himself.

It is said in *Wilson* v. *Cubley*, 26 F. R. 157, 1886, North. Dist. Ill., Blodgett, J., that under the rule established in *Graham* v. *McCormick*, if a patentee shows in an earlier patent a feature analogous in function and operation to one described as part of the invention in a later patent, the feature so shown in the earlier patent does not prevent him from putting in a claim for this invention in the later patent.

Grant *v.* **Raymond**, 6 Pet. 218, 1832, Supr. Court., Marshall, C. J.

Is explained in *Wilson* v. *Rousseau*, 1 Blatchf. C. C. 100, 1845, North. Dist. N. Y., *per Curiam*, as deciding that where the commissioner of patents has issued a void patent, he may issue a valid patent afterwards for the portion of the term not then expired.

Is said in *Battin* v. *Taggert*, 17 How. 83, 1854, Supr. Court, McLean, J., to have sustained a reissued and corrected patent before any legislation was had upon the subject.

Is cited in *Day* v. *New England Car Spring Co.*, 3 Blatchf. C. C. 181, 1854, South. Dist. N. Y., Betts, J., to the effect that in an action at law for infringement of a patent the defendant may plead special matters which the statute authorizes to be given under the general issue.

Is referred to in *Loom Co.* v. *Higgins*, 105 U. S. 588, 1881, Supr. Court, Bradley, J., as deciding that an insufficient specification in a patent is a defence to a suit on it without an allegation of fraudulent intent, and that such allegation was only necessary if the defendant wished to avoid the patent. *Contra*, the decisions in *Whittemore* v. *Cutter*, 1 Gall. 429; *Lowell* v. *Lewis*, 1 Mas. 182; *Gray* v. *James*, Pet. C. C. 394.

It is said in *Odell* v. *Stout*, 22 F. R. 162, 1884, South. Dist. Ohio, Sage, J., that the earlier cases and some of the later are in harmony with the rule in *Grant* v. *Raymond*, that the correct performance of all the preliminaries to the procuring of an original or reissued patent is always examinable in the court in which a suit for violation of such patent is brought.

Gray *v.* **James**, Pet. C. C. 394, 1817, Dist. Penn., Washington, J.

Is referred to in *Loom Co.* v. *Higgins*, 105 U. S. 588,

1881, Supr. Court, Bradley, J., as deciding that an insufficient specification in a patent, if done with fraudulent intent, is a defence to a suit. The fraudulent intent is not held necessary in *Grant* v. *Raymond*, 6 Pet. 218 (q. v.), unless the defendant wishes to avoid the patent.

Greely, *Ex Parte*, 6 Fisher, 575, 1873, Dist. Mass, Shepley, J.

Is stated briefly in *Re Squire*, 3 Ban. & A. 137, 1877, East. Dist. Mo., Treat, J.

Greenwood *v.* **Bracher**, 1 F. R. 856, 1880, Dist. N. J., Nixon, J.

Is cited and explained in *Minneapolis Harvester Works* v. *McCormick Harvesting Machine Co.*, 28 F. R. 566, 1886, Dist. Minn., Nelson, J.

The practice adopted in that case, of requiring the complainant in a case where there is some doubt on the question of priority of invention to show that the defendants are not pecuniarily responsible, and will not give a bond of security to satisfy the decree of the court as to damages before an injunction could be granted, was followed in *National Hat-Pouncing Machine Co.* v. *Hedden*, 29 F. R. 149, 1886, Dist. N. J., Wales, J.

H.

Hailes *v.* **Albany Stove Co.**, 16 F. R. 240, 1883, North. Dist. N. Y., Wallace, J.

Is said in *Brush* v. *Condit*, 20 F. R. 831, 1884, South. Dist. N. Y., Shipman, J., to state clearly the law upon the subject of disclaimer.

Hailes *v.* **Van Wormer**, 7 Blatchf. C. C. 443, 1870, North. Dist. N. Y., Woodruff, J.

Is affirmed in *Russell &c. Manuf. Co.* v. *Mallory*, 10 Blatchf. C. C. 146, 1872, Dist. Conn., Woodruff, J.,

as distinguishing between a patentable combination and a mere aggregation of elements having no relation to each other, or no reciprocal or co-operative action to produce the result obtained.

Hailes *v.* **Van Wormer**, 20 Wall. 353, 1873, Supr. Court, Strong, J.

The opinion of Mr. Justice Strong is quoted in *Booth* v. *Parks*, 1 Ban. & A. 227, 1874, North. Dist. Ohio, Welker, J., to the effect that a new combination, if it produces new and useful results, is patentable, though all the constituents are well known, if the results are not a mere aggregate of similar results each produced by one element of the combination.

Decides as to the patentability of a combination of known elements. Cited in *Reckendorfer* v. *Faber*, 92 U. S. 353, 1875, Supr. Court, Hunt, J., to show that the question of patentability is open to the court, and not conclusively settled by the granting of a patent.

" Any case where a new result is produced by a combination — a result not previously produced by either of the elements acting separately — is not in the rule as to aggregations laid down in *Hailes* v. *Van Wormer*." Cited to this effect in *Stilwell, &c. Manuf. Co.* v. *Cincinnati Gaslight, &c. Co.*, 1 Ban. & A. 614, 1875, East. Dist. Ohio, Swing, J.

The principle of this decision is approved in *Herring* v. *Nelson*, 3 Ban. & A. 61, 1877, North. Dist. N. Y., Johnson, J.

The doctrine of this case is said in *Williams* v. *Rome &c. R. R. Co.*, 3 Ban. & A. 422, 1878, North. Dist. N. Y., Blatchford, J., to be this; that a new combination, if it produces new and useful results, is patentable, though all the constituents of the combination were well known and in common use before the combination was made; that the results, however, must be a product of the com-

bination, and not a new aggregate of several results, each the complete product of one of the combined elements; that merely bringing old devices into juxtaposition, and there allowing each to work out its own effect, without the production of something novel, is not invention; and that no one by bringing together several old devices, without producing a new and useful result, the joint product of these elements of the combination, and something more than an aggregate of old results, can acquire a right to prevent others from using the same devices, either singly or in other combinations.

Is cited in *Webster Loom Co.* v. *Higgins*, 4 Ban. & A. 97, 1879, South. Dist. N. Y., Wheeler, J., to the point that the mere aggregation of devices, each producing its appropriate effect, unchanged by the others, that effect having no relation to the combination and in no sense being its product, is not patentable combination, and does not show the requisite invention.

Is cited in *Slawson* v. *Grandstreet, P. P. & F. R. R. Co.*, 5 Ban. & A. 213, 1880, East. Dist. N. Y., Benedict, J.; s. c. 4 F. R. 534, and compared with the latter case as being a case where the claim of the patent did not show a patentable invention, but only a combination of old elements, *e. g.*, an illumination window of mica in a stove.

The opinion of Mr. Justice Strong as to the non-patentability of a combination of old elements producing a result which is an aggregate of similar results, each the complete product of one of the combined elements, is quoted from in *Pickering* v. *McCullough*, 104 U. S. 317, 1881, Supr. Court, Matthews, J.

Is cited in *Phillips* v. *Detroit*, 111 U. S. 607, 1883, Supr. Court, Woods, J., as a case where there was no invention, but a combination of old elements.

The opinion of Mr. Justice Strong to the effect that a new combination if it produces new and useful results

is patentable, though all the constituents of the combination were well known and in common use before the combination was made, but that the results must be a product of the combination, and not a mere aggregate of several results, each a complete product of one of the combined elements, is quoted in *Wood* v. *Packer*, 17 F. R. 651, 1883, Dist. N. J., Nixon, J.

Is cited in *Morris* v. *McMillin*, 112 U. S. 249, 1884, Supr. Court, Woods, J., as a case where there was no invention, but a combination of old elements.

The principles of this case were applied in *Mosler Safe & Lock Co.* v. *Mosler*, 22 F. R. 905, 1885, South. Dist. Ohio, Sage, J.; and the rule of decision followed in *Thatcher Heating Co.* v. *Burtis*, 121 U. S. 295, 1886, Supr. Court, Matthews, J.

Hall *v.* MacNeale, 107 U. S. 90, 1883, Supr. Court, Blatchford, J.

Is cited in *Thompson* v. *Boisselier*, 114 U. S. 11, 1884, Supr. Court, Blatchford, J., as a case where the invention described in the patent was held not to be patentable.

Hall *v.* Wiles, 2 Blatchf. C. C. 194, 1851, South. Dist. N. Y., Nelson, J.

Is said in *Worden* v. *Searls*, 21 F. R. 408, 1884, Dist. N. J., Nixon, J., to decide that the part of the thing patented which is claimed without right must be a material and substantial part of the invention in order to render a disclaimer necessary.

Hammond *v.* Hunt, 4 Ban. & A. 111, 1879, Dist. Mass., Lowell, J.

Approved in *Birdsell* v. *Shaliol*, 112 U. S. 487, 1884, Supr. Court, Gray, J., as to the court's ordering the joinder of licensee as plaintiff, on motion of the defendant in suit for an infringement.

Hapgood *v.* **Hewitt**, 119 U. S. 226, 232, 1886, Supr. Court, Blatchford, J.

It is said in *Montross* v. *Mabie*, 30 F. R. 235, 1887, South. Dist. N. Y., Brown, J., that the language of the court in that case that a right to sell, granted to a corporation under the patent, if a mere personal one, is extinguished by the dissolution of the corporation, must be interpreted in reference to new goods made by an independent corporation after the dissolution of the former corporation, and does not mean that a license to sell granted to a firm is ended as soon as the firm dissolves.

Hardin *v.* **Boyd**, 113 U. S. 756, 1884, Supr. Court, Harlan, J.

Cited in *Reay* v. *Berlin, &c. Envelope Co.*, 30 F. R. 449, 1887, South. Dist. N. Y., Wheeler, J., to the effect that a reissue is valid, if it only gives a more correct description of the same invention which is described in the original patent.

Harkness *v.* **Hyde**, 98 U. S. 476, 1878, Supr. Court, Field, J.

Is cited in *United States* v. *American Bell Telephone Co.*, 29 F. R. 28, 1886, South. Dist. Ohio, Jackson, J., as a case in which a motion to dismiss a suit was treated by the court as a motion to set aside the service, and was sustained, the illegality of the service not appearing on the face of the record.

Hartell *v.* **Tilghman**, 99 U. S. 547, 556, 1878, Supr. Court, Miller, J.

It is said in *Pentlarge* v. *Beaton*, 5 Ban. & A. 330, 1880, East. Dist. N. Y., Benedict, J., that the remarks of the Supreme Court in the above case are calculated to render it doubtful whether in the absence of a termination of a license by mutual agreement or final decree a revocation of the license could be effected by notice; but the case went off on another point.

Is said in *White* v. *Lee*, 5 Ban. & A. 574, 1880, Dist. Mass., Lowell, J., to overrule those patent cases which held that a breach of covenant in a license is *per se* a forfeiture of the license. Such a breach is not a forfeiture unless it is stipulated to that effect in the license. The case of *Hartell* v. *Tilghman* is a late and controlling case.

This case is said to be conclusive of the case of *Adams* v. *Meyrose*, 7 F. R. 201, 1881, East. Dist. Mo., Treat, J., where the plaintiff sought to charge the defendants as infringers of the patent despite the contract of license in consequence of non-compliance with its terms. Treat, J., says at first it seemed clear under the contract that the suit was well founded; but as the majority of the United States Supreme Court had taken an adverse view, nothing remained for him but to dismiss the bill in accordance with the decision.

This case is said, in *Lilienthal* v. *Washburn*, 8 F. R. 709, 1881, East. Dist. La., Pardee, J., to have been a case where the want of jurisdiction in the federal court appeared upon the face of the bill as it set forth a contract of license, and the parties being citizens of the same State, it was held, by a divided court, that the federal court had no jurisdiction.

Referred to in *Albright* v. *Teas*, 106 U. S. 619, 1882, Supr. Court, Woods, J.; as deciding against the jurisdiction of a federal court when the case is an agreement respecting a patent, but not involving the construction of any law relating to patents.

It is said in *Teas* v. *Albright*, 13 F. R. 412, 1882, Dist. N. J., Nixon, J., that in the former case the court intimates that McLean, J., went too far in the case of *Brooks* v. *Stolley*, 3 McLean, 523 (q. v.), in maintaining the jurisdiction of the courts of the United States in cases where suit is brought to enforce a license, or where there is shown by the bill to be an existing license.

Is cited in *Adams* v. *Meyrose*, 10 F. R. 673, 1882, East. Dist. Mo., Treat, J., to the point that a suit on a license cannot be maintained in a federal court when the citizenship of the parties does not give jurisdiction.

Is cited in *Smith* v. *Standard Laundry Machine Co.*, 19 F. R. 826, 1882, South. Dist. N. Y., Wheeler, J., and distinguished from the latter case.

It is said in *Curran* v. *Craig*, 22 F. R. 102, 1884, East. Dist. Mo., Treat, J., that the former case decides that where the demand against a receiver does not involve the administration of the trust lawfully committed to him, but alleges that he has taken unlawful possession of property not included in the trust, a suit will lie against him personally as for a trespass.

The federal court in this case is said in *Hammacher* v. *Wilson*, 26 F. R. 240, 1886, Dist. Mass., Carpenter, J., to have found as a fact that there was a subsisting license given by the complainant to the respondent, and therefore refused to take jurisdiction of the case, and left the parties to their remedy in the State court.

The preliminary injunction in *McCarty, &c. Trading Co.* v. *Glaenzer*, 30 F. R. 387, 1887, South. Dist. N. Y., Wallace, J., was denied on the authority of *Hartell* v. *Tilghman*, as a case not involving the validity of a patent, but rights under a license.

Hartshorn *v.* **Day**, 19 How. 211, 1856, Supr. Court, Nelson, J.

Is quoted from in *Goodyear* v. *Union Rubber Co.*, 4 Blatchf. C. C. 69, 1857, South. Dist. N. Y., Ingersoll, J., to the effect that if a failure to pay the license fee does not forfeit and rescind the license, the owner of the patent cannot sustain a bill in equity in a federal court for infringement of the patent.

Hatch *v.* **Adams**, 22 F. R. 434, 1884, East. Dist. Penn., McKennan, J.

Is interpreted in *Hobbie* v. *Smith*, 27 F. R. 662, 1886, North. Dist. N. Y., Coxe, J., as authority only for the proposition that the purchaser of patented articles from the grantee of an exclusive territorial right is not at liberty to bring them into the territory of another grantee and there sell them in the course of trade.

Hatchman, *In Re*, 26 O. G. 738, 1884, Dist. Col., McArthur, J.

Is said in *Boland* v. *Thompson*, 26 F. R. 635, 1886, South. Dist. N. Y., Coxe, J., to be authority for the proposition that when a claim has been examined and rejected by the commissioner, and the rejection acquiesced in by the patentee or his solicitor, and the patent be issued without the claim, there is no inadvertence or mistake which will entitle the patentee to a reissue.

Hathaway *v.* **Roach**, 2 W. & M. 63, 1846, Dist. Mass., Woodbury, J.

Is quoted from in *Hussey* v. *Bradley*, 5 Blatchf. C. C. 213, 1864, North. Dist. N. Y., Hall, J., to the effect that models, procured by the defendant, of machines described in the plaintiff's patent, may be taxed as part of the defendant's costs.

Hawley *v.* **Mitchell**, 1 Holmes, 42, 1871, Dist. Mass., Shepley, J.; s. c. 16 Wall. 544.

Is said in *American Cotton Tie Co.* v. *Simmons*, 3 Ban. & A. 321, 1878, Dist. R. I., Shepley, J., fully to state the law that a patentee has the right, in selling a patented article, to put a restriction on its sale or use, and to convey only a restricted title, or to license only a restricted use; and if he does so, the purchaser can convey to another only what title he gets.

Is said in *American Cotton Tie Supply Co.* v. *Bullard*, 4 Ban. & A. 529, 1879, South. Dist. N. Y.,

Blatchford, J., to state fully the law upon the point that a purchaser of a restricted title to a patent, or a license only to a restricted use, cannot convey a better or clearer title than he has himself.

Hayden *v.* **Oriental Mills**, 15 F. R. 605, 1883, Dist. R. I., Lowell, J.

Is cited in *May* v. *Logan County*, 30 F. R. 257, 1887, North. Dist. Ohio, Jackson, J., as a case holding that a State statute of limitation may be interposed as a defence in a suit in the federal court for infringement of a patent. See *Collins* v. *Peebles*.

Hayden *v.* **Suffolk Manuf. Co.**, 4 Fisher, 103, 1862, Dist. Mass., Sprague, J.

The opinion of Sprague, J., in this case is quoted at length in *Washburn, &c. Manuf. Co.* v. *Haish*, 4 F. R. 205, 1880, North. Dist. Ill., Drummond, J., upon the point that when it is sought to invalidate a useful invention by an old machine made years ago, the burden of satisfying the jury upon the point that the two machines are similar rests upon the defendant.

Hayward *v.* **Andrews**, 106 U. S. 672, 1882, Supr. Court, Matthews, J.

Is distinguished in *Rogers* v. *Riessner*, 30 F. R. 530, 1887, South. Dist. N. Y., Wheeler, J.

Hayward *v.* **St. Louis**, 11 F. R. 427, 1882, East. Dist. Mo., Treat, J. See *Collins* v. *Peebles*.

Heald *v.* **Rice**, 104 U. S. 737, 1882, Supr. Court, Matthews, J.

Is said in *Avery* v. *Anthony*, 106 U. S. 146, 1882, Supr. Court, Woods, J., to be to the same effect as *James* v. *Campbell*, 104 U. S. 356 (q. v.).

The principles of its decision are followed in *Thatcher Heating Co.* v. *Burtis*, 121 U. S. 295, 1886, Supr. Court, Matthews, J. See *Hailes* v. *Van Wormer*.

Heaton *v.* **Quintard**, 7 Blatchf. C. C. 73, 1869, South. Dist. N. Y., Blatchford, J.

Is distinguished in *American Cotton Tie Co.* v. *McCready*, 4 Ban. & A. 599, 1879, South. Dist. N. Y., Blatchford, J.

Hendrie *v.* **Sayles**, 98 U. S. 546, 1878, Supr. Court, Clifford, J.

Is referred to in *Root* v. *Railway Co.*, 105 U. S. 204, 1881, Supr. Court, Matthews, J., as the only case where a suit in equity, brought after the patent had expired, for an account of profits, had come before the courts till the case of *Root* v. *Railway Co.* *Hendrie* v. *Sayles* was decided on demurrer, on a single point, and the question of jurisdiction was not noticed.

Is stated in *Fire Extinguisher Manuf. Co.* v. *Graham*, 16 F. R. 555, 1883, West. Dist. Va., Hughes, J., to have decided that when an assignment of an invention is made before the grant of the patent, a renewal of that patent may be issued to the assignee if the language of the assignment is broad enough to cover the extended term.

Is cited in *Johnson* v. *Wilcox & Gibbs Sewing Machine Co.*, 27 F. R. 690, 1886, South. Dist., N. Y., Wallace, J., explaining that case to have been decided as it was, because the assignment in terms carried extension of the patent to the assignee. The case of *Clum* v. *Brewer*, 2 Curtis, C. C. 520, is cited in the case of *Hendrie* v. *Sayles*, and the language of Curtis, J., quoted at length.

Henry *v.* **Francestown Soapstone Stove Co.**, 17 O. G. 569, 1880, Dist. N. H., Lowell, J.

The opinion of Judge Lowell in the above case, and non-concurrence with Judge Shepley, whose opinion in the same case is reported in 9 O. G. 409, is noticed in

Graham v. *Geneva, &c. Manuf. Co.*, 11 F. R. 142, 1880, East. Dist. Wis., Dyer, J.

Henry *v.* **Providence Tool Co.**, 14 O. G. 855, 1878, Dist. R. I., Clifford, J.

Decides that an exceptional prolongation of a foreign patent by a foreign power beyond its natural term, does not extend the term of the patent in the United States, but the United States patent expires at the expiration of the original term of the foreign patent, which was in force at the time of the granting of the United States patent. *Henry* v. *Providence Tool Co.* is cited at length to this effect in *Reissner* v. *Sharp*, 4 Ban. & A. 377, South. Dist. N. Y., 1879, Blatchford, J.

This case is said in *Bate Refrigerating Co.* v. *Gillett*, 13 F. R. 557, 1882, Dist. N. J., Nixon, J., to have been a case raising the question as to whether a United States patent expires when the original term of a prior foreign patent, in force when the United States patent was granted, expires, or whether a special extension of the foreign patent saves the domestic patent from lapsing when the term ends, which was running at the granting of the domestic patent. Clifford, J., in *Henry* v. *Providence Tool Co.*, is said in *Bate Refrigerating Co.* v. *Gillett*, to have held that the prolongation of the English patent for a further term did not save the domestic patent from lapsing at the end of the term of the English patent running when it was originally granted.

This case is examined in *Paillard* v. *Bruno*, 29 F. R. 865, 1886, South. Dist. N. Y., Wallace, J., and said to decide that in a case where the original term of a foreign patent has been extended subsequently to the grant of the United States patent, this extension of the foreign patent does not prolong the term of the United States patent under § 4887, U. S. R. S., and the United

States patent expires at the end of the original term of the foreign patent.

Herring *v.* **Gage**, 3 Ban. & A. 396, 1878, North. Dist. N. Y., Wallace, J.

Is said in *Garretson* v. *Clark*, 4 Ban. & A. 538, 1879, North. Dist. N. Y., Blatchford, J., to be consistent with the rulings in the latter case, the rule being that a plaintiff in proving the profits of the defendant is required to separate between an unpatented part of what the defendant makes and sells, and the patented part, and not between such patented part and something which the defendant does not embody in his machine.

Herring *v.* **Nelson**, 14 Blatchf. C. C. 293, 1877, North. Dist. N. Y., Johnson, J.; s. c. 12 O. G. 753.

Is referred to in *Kerosene Lamp Heater Co.* v. *Littell*, 3 Ban. & A. 318, 1878, Dist. N. J., Nixon, J., as containing a satisfactory explanation of the law of reissue in the case of a patent for a combination.

Is cited by the plaintiffs in *Johnson* v. *Flushing, &c. R. R. Co.*, 3 Ban. & A. 434, 1878, East. Dist. N. Y., Benedict, J., as being in opposition to *Gill* v. *Wells*, 22 Wall. 24; but the court said, in *Johnson* v. *Flushing, &c. R. R. Co.*, that a reference to the opinion in *Herring* v. *Nelson* shows that the court did not understand it to be in conflict with *Gill* v. *Wells*. In *Herring* v. *Nelson* the specification and drawings of the original patent plainly disclosed, beside the main invention, that is, the cooling grain and saving waste in converting it into flour, a subcombination producing a separate result, that is, the cooling only; and this other result was properly claimed in a separate claim in the reissue.

Is said in *Christman* v. *Rumsey*, 4 Ban. & A. 513, 1879, North. Dist. N. Y., Blatchford, J., to have taken a correct view of the decisions in *Gill* v. *Wells*, 22

Wall. 1, and *Russell* v. *Dodge*, 93 U. S. 360, as to the conclusiveness of the decision of the commissioner of patents upon the validity of a reissue in a suit of infringement.

The reason for sustaining the reissue in this case is said in *Blackman* v. *Hibbler*, 4 Ban. & A. 645, 1879, East. Dist. N. Y., Benedict, J., to have been that all that had been added was the new claim, which embodied in words that which the specifications and drawing of the original patent could not fail to disclose to any intelligent examination.

Hicks *v.* **Kelsey**, 18 Wall. 670, 1873, Supr. Court, Bradley, J.

Is said in *Goodyear Dental Vulcanite Co.* v. *Willis*, 1 Ban. & A. 579, 1874, East. Dist. Mich., Emmons, J., to concede that cases may arise where the degree of superiority arising in a machine by substituting new materials for old may be so great as to amount to a difference in kind of effect produced, and not merely a difference in degree, and constitutes a patentable invention.

Decides as to the patentability of an invention. Cited in *Reckendorfer* v. *Faber*, 92 U. S. 354, 1875, Supr. Court, Hunt, J., to show that the question of patentability is open to the court, and is not conclusively settled by the grant of the patent.

Is quoted from in *Smith* v. *Goodyear Dental Vulcanite Co.*, 93 U. S. 496, 1876, Supr. Court, Strong, J., as intimating that a substitution of one material for another, if it is more than formal, that is, if it effects some new and useful result, as increase of efficiency, or a decided saving in the operation, may be patentable.

The principle of this case, that mere substitution of one material for another is not invention, was applied in *Dalton* v. *Nelson*, 2 Ban. & A. 228, 1876, South. Dist. N. Y., Shipman, J.

Is cited in *Rumford Chemical Works* v. *Hecker*, 2 Ban. & A. 361, 1876, Dist. N. J., Nixon, J., as recognizing the authority and principles of *Crane* v. *Price*, 1 Web. P. C. 409, that in a process of manufacture a substitution of one article for another, *e. g.*, anthracite instead of bituminous coal with the hot blast in smelting iron ore, may be a patentable invention, since it may produce different results.

Is cited in *United States Stamping Co.* v. *King*, 4 Ban. & A. 477, 1879, South. Dist. N. Y., Blatchford, J.; s. c. 7 F. R. 868, as settling the principles which govern the latter case.

Is said in *Heald* v. *Rice*, 104 U. S. 755, 1881, Supr. Court, Matthews, J., to affirm the decision of *Hotchkiss* v. *Greenwood*, 11 How. 248, 266, as to the non-patentability of a mere substitution of one material for another in the constitution of a machine, although it may be cheaper and better.

Is referred to in *Pennsylvania R. R.* v. *Locomotive Truck Co.*, 110 U. S. 495, 1883, Supr. Court, Gray, J., and the opinion of Mr. Justice Bradley quoted from, to the effect that in compositions a change of ingredients may change the composition, whereas in a machine an iron bar instead of a wooden one does not change the machine.

Hill *v.* **Whitcomb**, 1 Holmes, 317, 1874, Dist. Mass., Shepley, J.

Is cited in *Hartell* v. *Tilghman*, 99 U. S. 554, 1878, Supr. Court, Miller, J., to the point that if a case does not arise under any act of Congress, nor depend in any way upon any law of Congress, in relation to patents, but entirely upon a contract relating to a patent, a court of the United States has no jurisdiction of the case.

Decided that a licensee cannot alone maintain a suit in equity for the infringement of a patent. Lowell, J.,

in *Hammond* v. *Hunt*, 4 Ban. & A. 114, 1879, Dist. Mass., followed the authority of this case. Compare *Littlefield* v. *Perry*, 21 Wall. 205; *Star Salt Caster Co.* v. *Crossman*, 3 Ban. & A. 281.

Hitchcock *v.* Tremaine, 9 Blatchf. C. C. 550, 1872, South. Dist. N. Y., Woodruff, J.

In *La Baw* v. *Hawkins*, 1 Ban. & A. 436, 1874, Dist. N. J., Nixon, J., it is said that *Hitchcock* v. *Tremaine* well states the rule that a perfected and patented invention cannot be anticipated by crude and unsuccessful experiments of rival inventors, and the consciences of witnesses strained in their attempts to clothe with living flesh what had always remained an inert and useless skeleton.

Hoe *v.* Boston Daily Advertiser Co., 14 F. R. 914, 1883, Dist. Mass., Lowell, J.

Is stated in *Hartshorn* v. *Eagle Shade Roller Co.*, 18 F. R. 91, 1883, Dist. Mass., Lowell, J., to consider the point fully settled that a mistake in the form of an affidavit in application for a patent does not invalidate the patent.

Hogg *v.* Emerson, 6 How. 457, 483, 1847, Supr. Court, Woodbury, J.

Is said in *Fire Extinguisher Case*, 21 F. R. 44, 1884, Dist. Ind., Morris, J., to have decided that two patents may be united if they relate to a like subject or are in their nature connected together.

Hogg *v.* Emerson, 11 How. 587, 1850, Supr. Court, Woodbury, J.

The court in this case says it is doubtful on principle whether a patent is invalid which is for two or more entirely separate and independent inventions, but it is cer-

tainly good if they are all connected in design and operation. Cited to this effect in *Sessions* v. *Romadka*, 21 F. R. 134, 1884, East. Dist. Wis., Dyer, J.

Hollister *v.* Benedict, &c. Manuf. Co., 113 U. S. 59, 1884, Supr. Court, Matthews, J.

The language of the court as to the exercise of inventive faculty necessary to create a patentable invention, is quoted and adopted in *Kappes* v. *Hartung*, 23 F. R. 189, 1885, South. Dist. N. Y., Coxe, J.

Also in *New York Bung & Bushing Co.* v. *Doelger*, 23 F. R. 193, 1885, South. Dist. N. Y., Coxe, J.

The language of the court in this case is referred to as instructive on the subject of patentability, in *Culkins* v. *Oshkosh Carriage Co.*, 27 F. R. 298, 1886, East. Dist. Wis., Dyer, J.

This decision is said in *Celluloid Manuf. Co.* v. *Comstock & Cheney Co.*, 27 F. R. 360, 1886, Dist. Conn, Shipman, J., to be a very significant decision; prior to that case, utility of invention constituted the main test of the inventive skill which gave the device patentability. The effect of that decision is to make independent evidence of the existence of inventive skill, apart from inferences of such existence which may be drawn from the novelty and utility of the device, to be of greater importance than had been understood before. The principle of decision in this case was followed in *Thatcher Heating Co.* v. *Burtis*, 121 U. S. 295, 1886, Supr. Court, Matthews, J. See *Hailes* v. *Van Wormer*.

Is said in *Sax* v. *Taylor Iron Works*, 30 F. R. 838, 1887, Dist. N. J., Butler, J., to be a striking instance of a case where the machine embraced both great utility and much ingenious novelty, yet the court held that there was no invention, and did not sustain the patent.

Holly *v.* **Union City**, 14 O. G. 5, 1878, Dist. Ind., Drummond, J.

The decision of Drummond and Gresham, JJ., is followed in *Holly* v. *Vergennes Machine Co.*, 4 F. R. 77, 1880, Dist. Vt., Wheeler, J.

Holmes Electric Protective Co. *v.* **Metropolitan Burglar Alarm Co.**, 21 F. R. 458, 1884, South. Dist. N. Y., Wheeler, J.

Is said in *Paillard* v. *Bruno*, 29 F. R. 865, 1886, South. Dist. N. Y., Wallace, J., to decide upon motion for preliminary injunction, that when an English patent is forfeited by failure of the patentee to pay the stamp duty required to be paid as a condition of the continuance of the grant beyond the term of three years from its date, the United States patent granted for the same invention does not expire with the forfeiture of the English patent, but extends until the expiration of the original term of the English patent, under § 4887, U. S. R. S.

Horman Patent Manuf. Co. *v.* **Brooklyn City R. Co.**, 15 Blatchf. C. C. 444, 1879, East. Dist. N. Y., Benedict, J.

Is construed in *Hayes* v. *Dayton*, 8 F. R. 705, 1880, South. Dist. N. Y., Blatchford, J., as deciding that where a bill in equity on two patents alleged that the defendant was using machines containing in one and the same apparatus the inventions secured by each of the two patents, the bill was good; the court holding that in the absence of any other facts the circumstance that the two transactions complained of were the use in a single machine of the two patented devices connected with the mechanism of the machine, warranted the inference that no prejudice would result to the defendant from the joinder of the two transactions.

Hotchkiss *v.* Greenwood, 11 How. 248, 1850, Supr. Court, Nelson, J.

Is cited in *Hicks* v. *Kelsey*, 18 Wall. 674, 1873, Supr. Court, Bradley, J., as deciding that a change of materials in a machine or device is not sufficient change to constitute invention, the purpose being the same, the means of accomplishing it being the same, and the form and mode of operation being the same.

The opinion of Mr. Justice Nelson is quoted in *Goodyear Dental Vulcanite Co.* v. *Smith*, 1 Ban. & A. 212, 1874, Dist. Mass., Shepley, J., and the case thoroughly examined and said to decide only that a machine made in whole or in part of materials better adapted to the purpose for which it is used than the materials of which the old one is constructed, and for that reason better and cheaper, is not a patentable invention.

Is distinguished and explained in *Goodyear Dental Vulcanite Co.* v. *Willis*, 1 Ban. & A. 578, 1874, East. Dist. Mich., Emmons, J., and the explanation of Shepley, J., in *Goodyear Dental Vulcanite Co.* v. *Smith*, 5 O. G. 585, approved; that is, that in *Hotchkiss* v. *Greenwood*, if the knobs of porcelain or clay had been new, or by a new use in an old combination had accomplished new and useful results, differing not merely in degree but in kind from the result of the old combination, the patent would have been valid. The difficulty in *Hotchkiss* v. *Greenwood* was, that there the peculiar effect was not new.

Decides that a new and useful improvement in making door and other knobs, of all kinds of clay used in pottery, and of porcelain, by having the cavity in which the screw is inserted by which they are fastened, largest at the bottom of its depth, in form of a dove-tail, and a screw formed therein by pouring in metal in a fused state, was not a patentable invention, Woodbury, J., dissenting. This case is cited in *Reckendorfer* v. *Faber*,

92 U. S. 352, 1875, Supr. Court, Hunt, J., as showing that the decision of the commissioner of patents is not conclusive as to patentability.

Is said in *Smith* v. *Goodyear Dental Vulcanite Co.*, 93 U. S. 492, 1876, Supr. Court, Strong, J., to decide that if the patented invention is merely the employment of one substance for the same use in substantially the same manner and with the same effect that other substances had been used for in the manufacture of the same articles, then there is no patentable invention, and (page 496) that *Hotchkiss* v. *Greenwood* does not decide that no use of one material in lieu of another in the formation of a manufacture can in any case amount to invention. If such substitution involves a new mode of construction, or develops new uses and properties of the article formed, it may be patentable.

Cited in *Phillips* v. *Detroit*, 4 Ban. & A. 350, 1879, East. Dist. Mich., Brown, J., as establishing the rule followed in the latter case as to a mere change of material not being a patentable invention.

The language of Mr. Justice Nelson as to the non-patentability of a substitution of materials is quoted in *Heald* v. *Rice*, 104 U. S. 755, 1881, Supr. Court, Matthews, J.

Is cited in *Scott* v. *Evans*, 11 F. R. 727, 1882, West. Dist. Penn., Acheson, J., as deciding that the substitution of one well-known material for another in the production of a well-known article is not the subject of a patent.

Is cited in *Phillips* v. *Detroit*, 111 U. S. 607, 1883, Supr. Court, Woods, J., as a case where there was no invention, but a mere substitution of materials.

The language of Mr. Justice Nelson in this case, as to the mere substitution of one known material for another not being a patentable invention, is quoted at length in

New York Bung & Bushing Co. v. *Doelger*, 23 F. R. 194, 1885, South. Dist. N. Y., Coxe, J.

The dissenting opinion of Woodbury, J., in this case, citing the authorities giving a less stringent interpretation to the rule regarding the patentability of inventions, is referred to in *Leonard* v. *Lovell*, 29 F. R. 314, 1886, West. Dist. Mich., Severens, J.; but the court in the latter case feel bound to reject the principles of this opinion on account of the recent and authoritative cases supporting a more stringent interpretation on this subject.

Howe *v.* **Abbott**, 2 Story, 190, 1842, Dist. Mass., Story, J.

Is said in *Adams* v. *Loft*, 4 Ban. & A. 497, 1879, Dist. N. J., Nixon, J., not to be distinguishable from the latter case, both being cases of a double use of an old process. In *Howe* v. *Abbott*, the patent was for curling palm-leaf by a process of machinery which had formerly been used to curl hair. In *Adams* v. *Loft* the patent was for chewing-gum, prepared by washing it to free it from impurities.

Howe *v.* **Morton**, 1 Fisher, 586, 1860, Dist. Mass., Sprague, J.

This case is said, in *American Diamond Rock Boring Co.* v. *Sheldon*, 4 Ban. & A. 605, 1879. Dist. Vt., Wheeler, J., to have decided, in an elaborate opinion, that an invention was not patented abroad until there was a full and perfect patent, as far as relates to the act of 1839, § 6.

Howe *v.* **Underwood**, 1 Fisher, 166, 1854, Dist. Mass. Sprague, J.

The opinion of Sprague, J., in this case, is quoted at length in *Allis* v. *Buckstaff*, 13 F. R. 890, 1882, East. Dist. Wis., Dyer, J., to the effect that a prior machine, in order to anticipate a subsequent one, must be a complete machine, practically useful; and nothing short of

this will destroy the right of the subsequent inventor to his patent.

Is quoted from, in *Thayer* v. *Hart*, 20 F. R. 694, 1884, South. Dist. N. Y., Coxe, J., to the effect that testimony of prior use or invention should be strictly scrutinized.

Howes *v.* **Nute**, 4 Fisher, 263, 1870, Dist. Mass., Clifford, J.

Recognizes the rule as laid down in *Nevins* v. *Johnson*, 3 Blatchf. C. C. 80, to the effect that the federal court has jurisdiction in equity of a patent case irrespective of the rights of the patentee to an injunction, and is cited to that effect in *Gordon* v. *Anthony*, 4 Ban. & A. 258, 1879, South. Dist. N. Y., Blatchford, J.

This case is referred to in *Atwood* v. *Portland Co.*, 5 Ban. & A. 534, 1880, Dist. Maine, Lowell, J., as being a decision that a suit in equity may be sustained for an account, although an injunction will not be granted, the patent having expired before the suit was brought. See *Root* v. *Railway Co.*

Hussey *v.* **Bradley**, 2 Fisher, 362, 371, 1863, North. Dist. N. Y., Hall, J.

Is said in *Sarven* v. *Hall*, 9 Blatchf. C. C. 526, 1872, Dist. Conn., Woodruff, J., to give a broader scope to the right of reissue than *Seymour* v. *Osborne*, 11 Wall. 515.

Hussey *v.* **Bradley**, 5 Blatchf. C. C. 210, 1864, North. Dist. N. Y., Hall, J.

Is cited in *Cornelly* v. *Markwald*, 24 F. R. 187, 1885, South. Dist. N. Y., Wallace, J., as giving the reasons fully why the expense of obtaining a model of the defendant's infringing machine should not be allowed to the plaintiff in his taxable costs.

I.

Imlay *v.* **Norwich & W. R. R. Co.**, 4 Blatchf. C. C. 227, 1858, Dist. Conn., Ingersoll, J.

Follows the rule laid down in *Nevins* v. *Johnson*, 3 Blatchf. C. C. 80, that the federal court has jurisdiction of a patent case in equity, irrespective of the right of a patentee in injunction, and is cited to that effect in *Gordon* v. *Anthony*, 4 Ban. & A. 450, 1879, South. Dist. N. Y., Blatchford, J. See *Root* v. *Railway Co.*

Is cited in *Vaughan* v. *East Tennessee, &c. R. R. Co.*, 2 Ban. & A. 540, 1877, East. Dist. Tenn., Brown, J., as similar to *Sickles* v. *Gloucester Manuf. Co.*, 1 Fisher, 222, and deciding that if an account is prayed for, a federal court has jurisdiction though no injunction is proper, the patent having expired. See *Root* v. *Railway Co.*

Ingalls *v.* **Tice**, 14 F. R. 297, 1882, South. Dist. N. Y., Wallace, J.

Is stated briefly in *Gamewell Fire Alarm Telegraph Co.* v. *Brooklyn*, 14 F. R. 256, 1882, East. Dist. N. Y., Wallace, J., to the effect that the transfer to the complainant being of the sole exclusive right to sell the patented article in certain specified territory, and the right to the patentee to make and use the invention not passing by the transfer, the complainant did not acquire the legal estate, and the patentee not being made a party of the suit, a demurrer for that reason was sustained.

Ingersoll *v.* **Jewett**, 16 Blatchf. C. C. 378, 1879, North. Dist. N. Y., Wallace, J.

Is stated and explained briefly in *Brush* v. *Naugatuck R. Co.*, 24 F. R. 373, 1885, Dist. Conn., Shipman, J.

Isaacs *v.* **Abrams**, 14 O. G. 862, 1878, Dist. Mass., Lowell, J.

"A change in the form of a machine or instrument, though slight, if it works a successful result not before accomplished in a similar way, in the art to which it is applied, or in any other, is patentable." Quoted in *Washburn, &c. Manuf. Co.* v. *Haish*, 4 F. R. 908, 1880, North. Dist. Ill., Drummond, J., upon the question of patentability.

Ives *v.* **Hamilton**, 92 U. S. 426, 1875, Supr. Court, Bradley, J.

Is cited in *Hamilton* v. *Rollins*, 3 Ban. & A. 158, 1877, Dist. Minn., Nelson, J., as containing a description of the invention described in the Hamilton patent, No. 51, 310.

J.

Jacobs *v.* **Hamilton County**, 1 Bond, 500, 1861, South. Dist. Ohio, *per Curiam.*

Is said in *May* v. *Mercer County*, 30 F. R. 249, 1887, Dist. Ky., Barr, J., to be the only case known to him which holds that a county is not liable for infringement of a patent right by its use.

Is cited in *May* v. *Logan County*, 30 F. R. 260, 1887, North. Dist. Ohio, Jackson, J., as holding that a county is not liable for infringement of a patent right; and it is said that the case of *Jacobs* v. *Hamilton County*, has never been recognized or followed, and cannot be sustained upon any sound principle.

James *v.* **Campbell**, 104 U. S. 356, 1882, Supr. Court, Bradley, J.

Is said in *Wing* v. *Anthony*, 106 U. S. 146, 1882, Supr. Court, Woods, J., to decide that letters-patent for a machine cannot be reissued for the process of operating

that class of machines; for if the claim is anything more than for the use of the particular machine, it is for a different invention. See *Powder Co.* v. *Powder Works*, 98 U. S. 126.

"If by actual inadvertence, accident, or mistake innocently committed, the claim does not fully assert or define the patentee's right in the invention specified in the patent, a speedy application for its correction before adverse rights have accrued may be granted, as we have explained in the recent case of *Miller* v. *Brass Co.*" Quoted in *Combined Patents Can Co.* v. *Lloyd*, 11 F. R. 151, 1882, East. Dist. Penn., Butler, J.

Is cited in *Sheriff* v. *Fulton*, 12 F. R. 139, 1882, West. Dist. Penn., Acheson, J., as settling the law that the acquiescence of a patentee for a long period, *e. g.*, nine years, in the terms of the patent as originally granted, estops him from claiming a reissue on the ground of mistake.

This case is stated at length in *MacKay* v. *Jackman*, 12 F. R. 620, 1882, South. Dist. N. Y., Wheeler, J.

In *Lorillard* v. *McAlpin*, 14 F. R. 112, 1882, South. Dist. N. Y., Blatchford, J., the court cited the former case as throwing much doubt upon the validity of the reissue in the latter case, and a motion for preliminary injunction was therefore denied.

Was approved in *Clements* v. *Odorless Apparatus Co.*, 109 U. S. 649, 1883, Supr. Court, Blatchford, J.

Is said in *Hollister* v. *Benedict Manuf. Co.*, 113 U. S. 67, 1884, Matthews, J., to declare authoritatively that the right of a patentee to a monopoly excludes the United States Government as well as all others from the use of the invention, but to query whether a suit could be maintained against public officers for such use, or whether the United States might not be sued on an implied promise in the Court of Claims.

Is cited to the same effect in *Coon* v. *Wilson*, 113 U. S. 277, 1884, Supr. Court, Blatchford, J., as in *Combined Patents Can Co.* v. *Lloyd*, *supra*.

"Of course, if by actual inadvertence, or mistake innocently committed, the claim does not fully assert or define the patentee's right in the invention specified in the patent, a speedy application for its correction before adverse rights have accrued may be granted." Quoted as authorizing a reissue in *Stutz* v. *Armstrong*, 20 F. R. 845, 1884, West. Dist. Penn., Acheson, J., and it is said that the court, in *James* v. *Campbell*, evidently regarded the accrual of adverse rights as of great consequence in determining whether a reissue would be valid.

Governed the decision in the case of *Phillips* v. *Risser*, 26 F. R. 312, 1885, West. Dist. Ill., Blodgett, J.

This case was urged upon the court in *Eastern Paper Bag Co.* v. *Standard Paper Bag Co.*, 30 F. R. 65, 1887, Dist. Mass., Colt, J., as sustaining the proposition that the omission of an inventor to claim his process invention in his machine patent is in law a dedication of process invention to the public, but *James* v. *Campbell* is distinguished by the court as dealing with the subject of reissues, and therefore not an authority in the latter case.

Jenkins *v.* **Johnson**, 9 Blatchf. C. C. 516, 1872, South. Dist. N. Y., Blatchford, J.

The composition in this case is considered and distinguished in *Clarke* v. *Johnson*, 4 F. R. 440, 1880, East. Dist. N. Y., Benedict, J., from the composition in the latter case.

Jones *v.* **Morehead**, 1 Wall. 155, 1863, Supr. Court, Miller, J.

Is stated briefly in *Root* v. *Railway Co.*, 105 U. S. 197, 1881, Supr. Court, Matthews, J., as applying the

rule as to measure of damages laid down in *Seymour* v. *McCormick*, 16 How. 480, 1853; that is, that if the plaintiff does not prove actual damages, he will have nominal damages. *Jones* v. *Morehead* was a bill in equity.

Jones *v.* **Sewell**, 6 Fisher, 343, 1873, Dist. Maine, Clifford, J.

The opinion of Mr. Justice Clifford correctly says that it is a settled law that mere forbearance to apply for a patent during the progress of experiments, and until the party has perfected his invention and tested its value by actual practice, affords no just ground for presuming an abandonment. *Locomotive Engine Safety Truck Co.* v. *Pennsylvania R. R. Co.*, 1 Ban. & A. 483, 1874, East. Dist. Penn., Strong, J.

"Inventions lawfully secured by letters-patent are the property of the inventors, and as such the franchise and the patented product are as much entitled to legal protection as any other species of property real or personal; they are, indeed, property even before they are patented, and continue to be such, without that protection, until the inventor abandons the same to the public." Quoted in *Butler* v. *Ball*, 28 F. R. 754, 1886, North. Dist. Ohio, Welker, J.

Jordan *v.* **Dobson**, 2 Abb. (U. S.) 398, 416, 1870, East. Dist. Penn., Strong, J.

Follows the rule laid down in *Nevins* v. *Johnson*, 3 Blatchf. C. C. 80, that the federal court has jurisdiction in equity of a patent suit, irrespective of the rights of the patentee to an injunction, and is cited to that effect in *Gordon* v. *Anthony*, 4 Ban. & A. 258, 1879, South. Dist. N. Y., Blatchford, J.

Judson *v.* **Cope**, 1 Fisher, 623, 1860, South. Dist. Ohio, Leavitt, J.

Is cited in *Illingworth* v. *Spaulding*, 9 F. R. 613,

1881, Dist. N. J., Nixon, J., as being a case which discusses, but does not decide, the question whether a defence, offering to prove the foreign use of an invention and knowledge of such use by persons residing in this country, as invalidating the complainant's patent, is sufficient defence. The question is said, in *Illingworth* v. *Spaulding*, never to have been decided.

K.

Kelleher *v.* **Darling**, 14 O. G. 673, 678, 1878, Dist. Maine, Clifford, J.

The opinion of Mr. Justice Clifford, to the effect that the question of infringement in the case of machines, manufactures, and products is a question of fact, and ordinarily is determined by the comparison of the exhibit made by the respondent with the mechanism described in the complainant's patent, is quoted in *Burdett* v. *Estey*, 4 Ban. & A. 143, 1879, Dist. Vt., Wheeler, J.

Kells *v.* **McKenzie**, 9 F. R. 284, 1881, East. Dist. Mich., Brown, J.

Is explained in *Searls* v. *Worden*, 11 F. R. 502, 1882, Dist. Mich., Brown, J., to have followed the later and sounder decisions of the Supreme Court, that a reissue of a patent is not valid for everything which might have been claimed in the original, and that its validity does not depend wholly upon the fact that the new features attempted to be secured thereby were suggested in the models, drawings, or specifications of the original patent; and if the original patent covers only a portion of a machine, a reissue which covers a distinct and different portion is not valid.

Is said in *Flower* v. *Detroit*, 22 F. R. 295, 1884, East. Dist. Mich., Brown, J., to have examined all the

cases up to that time, and to conclude that the court is not at liberty to review the action of the commissioner of patents in granting reissues on the ground of accident, inadvertence, or mistake. But in *Flower* v. *Detroit* it is queried whether later decisions of the Supreme Court have not enabled the courts to inquire whether there was such accident, inadvertence, or mistake, as would justify a reissue. The case of *Kells* v. *McKenzie* is also said to follow the tenor of the Supreme Court at that time, limiting reissues to that portion of the machine covered by the claim of the original patent, although the invention covered by the reissue may be described in the original specifications and drawings.

Kendall *v.* **Winsor**, 21 How. 322, 1858, Supr. Court, Daniel, J.

A part of the opinion of the court in this case is quoted in *Planing Machine Co.* v. *Keith*, 101 U. S. 484, 1879, Supr. Court, Strong, J., to the effect that an inventor may abandon his invention to the public either by express dedication or by conduct, such as knowingly acquiescing in the use by others of his invention, or he may forfeit his right by wilful or negligent postponement of his claims. In *Planing Machine Co.* v. *Keith* it is said that such abandonment may be as well after an application, rejected or withdrawn, as before.

Keystone Bridge Co. *v.* **Phœnix Iron Co.**, 95 U. S. 274, 278, 1877, Supr. Court, Bradley, J.

Is referred to in *Railroad Co.* v. *Mellon*, 104 U. S. 118, 1881, Supr. Court, Woods, J., as showing how important is a claim in an application for a patent. *Railroad Co.* v. *Mellon* decides that the claim limits the scope of the patent, although it may be illustrated but not enlarged by the other parts of the specification.

Is affirmed in *Duff* v. *Sterling Pump Co.*, 107 U. S. 639, 1882, Supr. Court, Blatchford, J.

The language of the court in this case to the effect that a patentee is bound by the claim in his patent, when it is clear and distinct, and cannot show that his invention is broader than the terms of his claim, is quoted in *Blades* v. *Rand*, 27 F. R. 97, 1886, North. Dist. Ill., Blodgett, J.

King *v.* **Hammond**, 4 Fisher, 488, 1871, North. Dist. Ohio, Sherman, J.

Is quoted in *Gottfried* v. *Phillip Best Brewing Co.* 5 Ban. & A. 17, 1879, East. Dist. Wis., Dyer, J., to the effect that the patent law protects simplicity and economy of construction as against prior and complex combinations.

King *v.* **Mandelbaum**, 8 Blatchf. C. C. 468, 1871, South. Dist. N. Y., Blatchford, J.

The construction of the King patent, reissue No. 3,000, is quoted and adopted in *Kursheedt* v. *Werner*, 2 Ban. & A. 86, 1875, South. Dist. N. Y., Blatchford, J.

King *v.* **Werner**, 12 Blatchf. C. C. 270, 1874, South. Dist. N. Y., Blatchford, J.

The construction of the King patent, reissue No. 3,000, is commented on in *Kursheedt* v. *Werner*, 2 Ban. & A. 87, 1875, South. Dist. N. Y., Blatchford, J.

Klein *v.* **Russell**, 19 Wall. 433, 1873, Supr. Court, Swayne, J.

Was not a case where the question before the court was whether the reissue was invalid because not for the same invention as the patent, that point not being raised in the lower courts. In *Russell* v. *Dodge*, 93 U. S. 464, 1876, Supr. Court, Field, J., a suit involving the same patent, it is said that what was said in *Klein* v. *Russell* as to the character of the first claim, so far as it conflicts with the construction given that claim in *Russell* v. *Dodge*, does not meet with the approval of

the court, after the extended consideration the subject had since received.

"The court should proceed in a liberal spirit, so as to sustain the patent and the construction claimed by the patentee himself, if this can be done consistently with the language he has employed." Quoted in *Bradley* v. *Dull*, 19 F. R. 915, 1884, West. Dist. Penn., Acheson, J.

Kneass *v.* **Schuylkill Bank**, 4 Wash. 9, 1820, Dist. Penn., Washington, J.

Decides that the use of steel plates instead of copper in engraving is patentable. In *Smith* v. *Goodyear Dental Vulcanite Co.*, 93 U. S. 497, 1876, Supr. Court, Strong, J., it is said that the case depends on the fact that a superior product has been the result of the substitution, a product that has new capabilities and performs new functions.

Is stated briefly in *Andrews* v. *Wright*, 3 Ban. & A. 331, 1878, Dist. Minn., Nelson, J., and the opinion of the court quoted to show that that case held the patent in question to be one for a process, that is, printing with copper-plates on bank-notes, and not a patent for an effect, that is, security against counterfeits.

Knight *v.* **Baltimore & Ohio R. R. Co.**, 3 Fisher, 1, 1840, Dist. Md. Taney, C. J.

Is cited in *Atlantic Giant Powder Co.* v. *California Powder Works*, 2 Ban. & A. 149, 1875, Dist. Cal., Field, J., as controlling the decision in that case to the effect that a second reissue was void, because not for the same invention as contained in the first reissue.

Kuhl *v.* **Mueller**, 21 F. R. 510, 1884, South. Dist. Ohio, Sage, J.

Is explained in *California Paving Co.* v. *Schalicke*, 119 U. S. 406, 1886, Supr. Court, Blatchford, J.

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Langdon *v.* **De Groot**, 1 Paine, 203, 1822, Dist. N. Y., Livingston, J.

Is cited in *Alcott* v. *Young*, 4 Ban. & A. 201, 1879, South. Dist. N. Y., Blatchford, J., as being similar to the latter case, being a case involving an unpatentable invention.

Is cited in *Pratt* v. *Rosenfeld*, 5 Ban. & A. 489, 1880, South. Dist. N. Y., Wheeler, J., on the question what utility in an invention is necessary to entitle the inventor to a patent.

Leggett *v.* **Avery**, 101 U. S. 256, 1879, Supr. Court, Bradley, J.

This case is construed in *Union Met. Cart. Co.* v. *U. S. Cart. Co.*, 7 F. R. 346, 1881, Dist. Mass., Lowell, J., to have decided that if a patentee obtains a patent upon his solemn admission of certain facts, he shall never thereafter be permitted to controvert them. *Leggett* v. *Avery* was urged upon the court in the latter case as converting the disclaimer filed in that case by the plaintiff into an estoppel; but the court considered that it was bound by the prior decision of Judge Shepley, holding that the same patent was valid in spite of the disclaimer, as the disclaimer was merely as to the propriety of inserting a certain clause in the descriptive part of the original.

In *Atwater Manuf. Co.* v. *Beecher Manuf. Co.*, 8 F. R. 609, 1881, Dist. Conn., Shipman, J., the evidence is stated to have been too scanty to bring the latter case within the doubt expressed by the Supreme Court in the former case, as to the validity of a disclaimer.

Is examined in *Kells* v. *McKenzie*, 9 F. R. 291, 1881, East. Dist. Mich., Brown, J., and it is said that

the decision in the former case is not easily reconcilable with that of *Smith* v. *Goodyear Dental Vulcanite Co.*, 93 U. S. 486, and other cases there cited; and the decision in *Leggett* v. *Avery* is not followed in *Kells* v. *McKenzie*, on the point that a reissue which includes a rejected claim of the original application is invalid.

The opinion of the court in this case is quoted from at length by the court in *Edgarton* v. *Furst & Bradley Manuf. Co.*, 9 F. R. 453, 1881, North. Dist. Ill., Blodgett, J., to the effect that in a reissue a rejected claim of an original application cannot be included if the patentee has acquiesced in the rejection.

Is quoted to the point that the rejection of a claim cannot justly be regarded as a matter of inadvertence or mistake; and even though it was, the applicant should seem to be estopped from setting it up on an application for a reissue in *Arnheim* v. *Finster*, 26 F. R. 279, 1886, South. Dist. N. Y., Coxe, J.

Is said in *Boland* v. *Thompson*, 26 F. R. 635, 1886, South. Dist. N. Y., Coxe, J., to be authority for the proposition that when a claim has been examined and rejected by the commissioner, the rejection acquiesced in by the patentee or his solicitor, and the patent reissued without the claim, there is no inadvertence or mistake which will entitle the patentee to a reissue.

The language of Mr. Justice Bradley in this case, upon the subject of limitations imposed upon a patentee by his disclaimer, is quoted at length in *Dobson* v. *Lees*, 30 F. R. 626, 1887, East. Dist. Penn., *per Curiam*.

Le Roy *v.* Tatham, 14 How. 156, 1852, Supr. Court, McLean, J.

Is quoted from in *Le Roy* v. *Tatham*, 22 How. 137, 1859, Supr. Court, McLean, J., to the effect that in

the view taken by the court in the construction of the patent it was not material whether the mere combination of machinery referred to was similar to the combination used by the Hansons, because the originality did not consist in the novelty of the machinery, but in bringing a newly-discovered principle into practical application by which a useful article is produced, and wrought pipe is made, as distinguished from cast pipe.

Is distinguished in *Arkell* v. *Hurd Paper Bag Co.*, 7 Blatchf. C. C. 477, 1870, North. Dist. N. Y., Woodruff, J., from the latter case, as the patent is for an improved product, and not for a principle.

The opinion of Mr. Justice McLean in this case, is quoted in *McCloskey* v. *Du Bois*, 9 F. R. 38, 39, 1881, South. Dist. N. Y., Wheeler, J., to the effect that a patent for an effect is not valid.

Lightner v. Brooks, 2 Cliff. 287, 1864, Dist. Mass., Clifford, J.

It is said in *United Nickel Co.* v. *Worthington*, 13 F. R. 393, 1882, Dist. Mass., Lowell, J., that in the former case it was conceded, but without being decided that a director of a company who has ordered an act which is an infringement of a patent, subjects himself to action; but this proposition is said in the latter case not to be the law.

Lightner v. Kimball, 1 Lowell, 211, 1868, Dist. Mass., Lowell, J.

Is distinguished in *American Cotton Tie Supply Co.* v. *McCready*, 4 Ban. & A. 599, 1879, South. Dist. N. Y., Blatchford, J.

It is said in *United Nickel Co.* v. *Worthington*, 13 F. R. 393, 1882, Dist. Mass., Lowell, J., that the former case decided that the director of a company who has ordered an act done which is an infringement of

a patent, subjects himself to action therefor; but in the latter case Lowell, J., says that upon further examination he thinks the law is not so.

Littlefield *v.* **Perry**, 21 Wall. 205, 1874, Supr. Court, Waite, C. J.

In *Hartell* v. *Tilghman*, 99 U. S. 551, 1878, Supr. Court, Miller, J., *Littlefield* v. *Perry* is said to be in accord with *Wilson* v. *Sandford*, 10 How. 99, which decides that when a case depends on the rights arising under a contract relating to a patent, and does not arise under the patent statutes, nor depend upon the construction of any law in relation to patents, — *e. g.*, a bill in equity to enforce a license, — a court of the United States in equity has no jurisdiction of the case unless the citizenship of the parties gives jurisdiction. *Littlefield* v. *Perry* and *Wilson* v. *Sandford* are said to give the only authoritative construction of the statute on this point, and are followed in *Hartell* v. *Tilghman*.

Is said in *Hammond* v. *Hunt*, 4 Ban. & A. 114, 1879, Dist. Mass., Lowell, J., to decide that a licensee himself may sustain a patent suit against the patentee, and others jointly trespassing with him knowing of the license, although citizens of the same State as the licensee. The decision in *Littlefield* v. *Perry*, overrules the decision in *Hill* v. *Whitcomb*, 1 Holmes, 317, as to the point that the jurisdiction of the circuit court in such a case depends on the suit being maintained under the patent law, and is cited to that effect in *Hammond* v. *Hunt*, *supra*.

"A mere licensee cannot sue strangers who infringe. In such cases redress is obtained through or in the name of the patentee." Quoted in *Nelson* v. *McMann*, 4 Ban. & A. 211, 1879, South. Dist. N. Y., Blatchford, J.

Is cited in *Steam Stone Cutter* v. *Windsor Manuf. Co.*, 4 Ban. & A. 453, 1879, Dist. Vt., Wheeler, J., as

a case in which interest upon profits of an infringement was disallowed, with the remark that profits actually realized were usually, in a case like that, the measure of unliquidated damages; that circumstances might arise which would justify the addition of interest in order to give a complete indemnity for losses sustained by wilful infringement, but that ordinarily interest would not be allowed.

It is said in *Burdett* v. *Estey*, 5 Ban. & A. 313, 1880, Dist. Vt., Wheeler, J., that the former case intimates that interest may be allowed upon profits actually realized by deliberate and intentional infringement of a patent in order to give complete indemnity for the wrong; and the court in *Burdett* v. *Estey* accordingly allowed interest upon profits in that case.

Is explained in *Root* v. *Railway Co.*, 105 U. S. 199, 1881, Supr. Court, Matthews, J., as a case where the measure of damages for infringement of a patent in a suit in equity is the profits received by the infringer. This case does not involve the question of jurisdiction.

This case is stated briefly, in *Lilienthal* v. *Washburn*, 8 F. R. 709, 1881, East. Dist. La., Pardee, J., as sustaining the jurisdiction of a federal court in a suit in equity between the assignor and assignee of a patent, although the validity of the patent is not contested, and all the parties are citizens of the same State. See now *Root* v. *Railway Co.*

"The statutory power of assignment has been so construed by the courts as to confine it to the transfer of an entire patent, an undivided part thereof, or the entire interest of the patentee or the undivided part thereof, throughout a certain portion of the United States." Quoted in *Gamewell Fire Alarm Telegraph Co.* v. *Brooklyn*, 14 F. R. 256, 1882, East. Dist. N. Y., Wallace, J.

Is distinguished in *Dobson* v. *Dornan*, 118 U. S. 16, 1885, Supr. Court, Blatchford, J., from the latter case as to the interlocutory decree for profits and damages.

Livingston *v.* **Jones**, 2 Fisher, 207, 1861, West. Dist. Penn., Grier, J.

Mr. Justice Grier's decision that the court cannot subdivide an improvement in a machine into its elements, and give a complainant only the value of his feature in the improvement, was overruled by Emmons, J., in *Ingels* v. *Mast*, 2 Ban. & A. 1875, East. Dist. Ohio, and the complainant allowed profits only on his addition to the machine.

The opinion of Mr. Justice Grier is quoted, to the effect that if the inventor's profit consists in the general use of his invention by all who pay a license fee, then the license fee is the measure of damages, in *Vaughan* v. *Central Pacific R. R. Co.*, 3 Ban. & A. 31, 1877, Dist. Cal., Sawyer, J.

Livingston *v.* **Van Ingen**, 1 Paine, C. C. 45, 1811, Dist. N. Y., Livingston, J.

Is stated in *Root* v. *Railway Co.*, 105 U. S. 191, 1881, Supr. Court, Matthews, J., as a patent case which was dismissed from the Circuit Court of the United States on the ground that the court had no jurisdiction of the subject-matter, Congress at that time having passed no law conferring jurisdiction in patent cases upon the federal court in pursuance of the power given by the Constitution.

Livingston *v.* **Woodworth**, 15 How. 546, 1853, Supr. Court, Daniel, J.

Is said in *Dean* v. *Mason*, 20 How. 203, 1857, Supr. Court, McLean, J., to state the true rule of damages for the infringement of a patent to be the amount of profits

received by unlawful use of the machines, as this is in general the damage done to the owner of the patent.

Is explained in *Sayles* v. *Richmond, &c. R. R. Co.*, 4 Ban. & A. 244, 1879, East. Dist. Va., Hughes, J., as not deciding that an infringer is a trustee of the profits in such a way as to support the jurisdiction in equity in a federal court when no injunction is asked.

This case is said in *Root* v. *Railway Co.*, 105 U. S. 194, 1881, Supr. Court, Matthews, J., to have raised for the first time, under the act of 1836, the question as to the rule for computing the profits of an infringement of a patent upon a decree for an account. The master allowed not for actual profit, but for such as the infringer might have made by due diligence; the Supreme Court reversed this rule and allowed only for actual profit.

Lord *v.* **Whitehead**, 24 F. R. 801, 1885, Dist. Mass., Colt, J.

Governed the decision in *Consolidated Safety Valve Co.* v. *Ashton Vulve Co.*, 26 F. R. 319, 1886, Dist. Mass., Colt, J.

Also said, in *Adams* v. *Bridgewater Iron Co.*, 26 F. R. 325, 1886, Dist. Mass., Colt, J., to decide that in cases based upon tortious acts, mere intricacy of the account does not furnish ground for equitable interference.

Lowell *v.* **Lewis**, 1 Mas. 182, 1817, Dist. Mass., Story, J.

Is referred to in *Webster Loom Co.* v. *Higgins*, 105 U. S. 588, 1881, Supr. Court, Bradley, J., as deciding that an insufficient specification in a patent, if made with fraudulent intent to deceive the public, is a defence to a suit on the patent. The fraudulent intent is held necessary in this case, although not so in *Grant* v. *Raymond*, 6 Pet. 218 (q. v.).

Lynch *v.* **Dryden**, 3 O. G. 407, 1873, Commissioner's Decision.

The remark of Commissioner Leggett in the above case, to the effect that neither the courts nor the commissioner have attempted to define a patentable combination so exactly as to be suited to universal application, broad enough to include all that is legitimate, and narrow enough to exclude all else, is quoted in *Hoffman* v. *Young*, 5 Ban. & A. 318, 1880, East. Dist. Penn., Butler, J.

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Magic Ruffle Co. *v.* **Douglass**, 2 Fisher, 330, 1863, South. Dist. N. Y., Shipman, J.

Is referred to in *Magic Ruffle Co.* v. *Elm City Co.*, 2 Ban. & A. 160, 1875, Dist. Conn., Shipman, J., as explaining the distinguishing feature in the invention in that suit.

Magic Ruffle Co. *v.* **Elm City Co.**, 13 Blatchf. C. C. 151, 1875, Dist. Conn., Shipman, J.

Explained in *Atwood* v. *Portland Co.*, 5 Ban. & A. 534, 1880, Dist. Maine, Lowell, J., as being a case where the jurisdiction in equity was sustained for an account under a contract relating to a patent, but without injunction, the patent having expired. See now *Root* v. *Railway Co.*

This case is considered in the *National Manuf. Co.* v. *Meyers*, 7 F. R. 357, 1881, South. Dist. Ohio, Swing, J. The former case is cited in Bump on Patent Law, page 140, as an authority that the defence of the invalidity of a patent and a license are inconsistent; but the court in the latter case explains the case of *Magic Ruffle Co.* v. *Elm City Co.* as being an action upon a contract and agreement for a license to enforce the provisions of

the contract, thereby creating an estoppel. The court in *National Manuf. Co.* v. *Meyers* held that the above defences were not inconsistent.

Mahn *v.* **Harwood**, 112 U. S. 354, 1884, Supr. Court, Bradley, J.

A patent "cannot be lawfully reissued for the mere purpose of enlarging the claim, unless there has been a clear mistake inadvertently committed in the wording of the claim, and the application for a reissue is made within a reasonably short period after the original patent was granted." Quoted in *Coon* v. *Wilson*, 113 U. S. 277, 1884, Supr. Court, Blatchford, J.

The opinion of Mr. Justice Bradley is quoted from in *Wollensak* v. *Reiher*, 115 U. S. 100, 1884, Supr. Court, Matthews, J., to the effect that a reissue to correct a mistake must be applied for in a reasonable time; and if not, the commissioner of patents exceeds his authority in granting it, and the reissue is void. The courts are to judge what time is reasonable; and two years was held not to be.

The opinion of the court in this case is quoted in *Gardner* v. *Herz*, 118 U. S. 191, 1885, Supr. Court, Blatchford, J., to the effect that other defences besides those given by statute may arise in a patent case, as, *e. g.*, the patentability of the invention; and this is a question of law upon which the courts are not bound by the decision of the commissioner of patents.

Quoted in *Bate Refrigerating Co.* v. *Eastman*, 24 F. R. 649, 1885, South. Dist. N. Y., Shipman, J.

And in *Shirley* v. *Mayer*, 25 F. R. 40, 1885, East. Dist. N. Y., Benedict, J., to the same effect as in *Coon* v. *Wilson*, *supra*.

Is said in *Western Union Telegraph Co.* v. *Baltimore & Ohio Telegraph Co.*, 25 F. R. 34, 1885, South. Dist. N. Y., Wallace, J., to decide a rule which covers two

propositions: the first, that a patent cannot be lawfully reissued for the mere purpose of enlarging the claim, unless there has been a clear mistake inadvertently committed in the wording of the claim, and the application for a reissue is made within a reasonably short time; second, that the question whether there has been such an inadvertent mistake is in general a matter of fact for the commissioner to decide; but whether the application is made in reasonable time is matter of law which the court may determine by comparing the reissued patents with the original, and, if necessary, with the records in the patent office when presented by the record.

Is quoted from in *Ives* v. *Surgent*, 119 U. S. 661, 1886, Supr. Court, Matthews, J., to the effect that if a patentee has not claimed all he is entitled to, he is bound to do so in a reasonable time; and if a commissioner of patents issues a reissue after that time, he exceeds his authority, and the reissued patent is void.

Is said in *Arnheim* v. *Finster*, 26 F. R. 279, 1886, South. Dist. N. Y., Coxe, J., to have decided that the reissue was invalid, because the mistake, if any, was between the inventor and his solicitor in not taking an appeal, and was not a mistake contemplated by the statute. The language of the court to this effect in *Mahn* v. *Harwood* is quoted at length in *Arnheim* v. *Finster*.

Is said in *Boland* v. *Thompson*, 26 F. R. 635, 1886, South. Dist. N. Y., Coxe, J., to be authority for the proposition that when a claim has been examined and rejected by the commissioner, the rejection acquiesced in by the patentee or his solicitor, and the patent reissued without the claim, there is no inadvertence, accident, or mistake which will entitle the patentee to a reissue.

Governed the decision of *Hoe* v. *Knap*, 27 F. R. 212, 1886, North. Dist. Ill., Blodgett, J.

This case was urged upon the court in *Eastern Paper Bag Co.* v. *Standard Paper Bag Co.*, 30 F. R. 65, 1887, Dist. Mass., Colt, J., as sustaining the proposition that the omission of an inventor to claim his process invention in his machine patent is in law a dedication of the process invention to the public; but *Mahn* v. *Harwood* is distinguished by the court as dealing with the subject of reissues, and therefore not an authority in the latter case.

Manning *v.* Cape Ann Isinglass Co., 4 Ban. & A. 612, 1883, Supr. Court, Woods, J.

Is distinguished in *Perkins* v. *Nashua, &c. Paper Co.*, 5 Ban. & A. 397, 1880, Dist. N. H., Lowell, J., from the latter case, and the law on the point involved in this decision is interpreted as to the question of public use to be, that actual knowledge of the invention need not have been derived by any one interested to practise it; but that it is enough if any one or more persons not under pledge of secrecy saw the invention practised, or even might have seen it if they had used their opportunity, provided it was in fact practised in the ordinary way after being completed.

Manufacturing Co. *v.* Cowing, 105 U. S. 253, 1882, Supr. Court, Waite, C. J.

Is said in *Dobson* v. *Hartford Carpet Co.*, 114 U. S. 445, 1884, Supr. Court, Blatchford, J., to be a case falling within the last clause of the rule in *Garretson* v. *Clark* (q. v.), and to be recognized as an exceptional case, since the whole demand for the patented article (an oil-pump in the oil regions) was confined to a small locality.

Is said in *Reed* v. *Lawrence*, 29 F. R. 918, 1886, West. Dist. Mich, Severens, J., to be an excellent illustration of the rule that when the patented feature which has been infringed by the defendant is one

which was the sole element of value in the thing manufactured, so that but for it the article would not be marketable because not sufficiently useful for the purpose for which it was intended, the defendant is liable for the whole profits of manufacture.

Is said in *Fay* v. *Allen*, 30 F. R. 447, 1887, North. Dist. N. Y., Coxe, J., to be an exceptional case, the patent being a pump for a special purpose in a particular locality, and the marketable value of the machine being solely due to the patented invention.

Many *v.* **Jagger,** 1 Blatchf. C. C. 372, 1848, North. Dist. N. Y., Blatchford, J.

The decision in this case was, that a claim for a manner of constructing a certain kind of wheels, covered all wheels constructed in that manner, of whatever shape. This principle was applied to a claim for the "process of constructing wells," and the patent held to cover all wells constructed in that manner, in *Andrews* v. *Carman*, 2 Ban. & A. 287, 1876, East. Dist. N. Y., Benedict, J.

Is said in *Planing Machine Co.* v. *Keith*, 101 U. S. 493, 1879, Supr. Court, Strong, J., to settle the question that only the names of those using or inventing an anticipating machine need be pleaded, and not those who will prove such prior use under the statute.

Is cited in *Woodbury Patent Planing Co.* v. *Keith*, 4 Ban. & A. 103, 1879, Dist. Mass., Lowell, J., to the point that under the rule in § 4920, U. S. R. S., only those persons who have invented or used the machine or improvement, and not those who are to testify to such invention or use, must be pointed out in the answer, setting up prior use or invention.

The remark of Mr. Justice Nelson in this case, that the description of the invention by the patentee in his own language affords the highest evidence of the thing

or instrument which he claims to have discovered, is quoted in *Eagleton Manuf. Co.* v. *West, &c. Manuf. Co.*, 5 Ban. & A. 479, 1880, South. Dist. N. Y., Wheeler, J.

Marsh *v.* **Dodge & Stevenson Manuf. Co.**, 6 Fisher, 562, 1873, North. Dist. N. Y., Woodruff, J.

In *Gilbert, &c. Manuf. Co.* v. *Tirrell*, 1 Ban. & A. 317, South. Dist. N. Y., Woodruff, J., explains his use of the phrase "mere change of location is not invention," by the subsequent parts of the opinion, to the effect that if the change of location involves the employment of new devices to adapt the apparatus for use in its new position, and a beneficial result is produced, then the location in connection with the new devices is patentable.

Marsh *v.* **Seymour**, 97 U. S. 348, 1877, Supr. Court, Clifford, J.

Is construed in *Root* v. *Railway Co.*, 105 U. S. 202, 1881, Supr. Court, Matthews, J., with *Elizabeth* v. *Pavement Co.*, 97 U. S. 126, 1877, to show that since the act of 1870, in a suit in equity a decree for damages of a compensatory character instead of the ordinary decree for profits may be made, if the business of the infringer was so loosely carried as that no profit was made in it.

Matthews *v.* **Shoneberger**, 4 F. R. 635, 1880, South. Dist. N. Y., Blatchford, J.

The construction of the Albertson patent, No. 2386, in this case is given at length in *Matthews* v. *Chambers*, 6 F. R. 878, 1881, West. Dist. Penn., Acheson, J., and the court held that that construction limited the patent to the exact construction of the device shown, as the only one consistent with its validity.

Maxheimer *v.* Mayer, 9 F. R. 460, 1881, South. Dist. N. Y., Wheeler, J.

Is cited in *Sessions* v. *Romadka*, 21 F. R. 131, 1884, East. Dist. Wis., Dyer, J., as a case where two distinct inventions were held to be rightly joined in one patent, being designed to co-operate together for the same end or purpose.

May *v.* Fon du Lac County, 27 F. R. 695, 1886, East. Dist. Wis., Dyer, J.

Is said in *May* v. *Mercer County*, 30 F. R., 249, 1887, Dist. Ky., Barr, J., to hold a county liable for infringement of a patent. See *Collins* v. *Peebles*.

May *v.* Johnson County, MSS., Ind. 7th Circuit, Davis, J.

Is said in *May* v. *Mercer County*, 30 F. R. 249, 1887, Dist. Ky., Barr, J., to hold a county liable for infringement of a patent.

McClurg *v.* Kingsland, 1 How. 202, 1843, Supr. Court, Baldwin, J.

Is cited in *Pierson* v. *Eagle Screw Co.*, 3 Story, 405, 1844, Dist. R. I., Story, J., upon the construction of the patent act of 1839, ch. 88, § 7.

Is interpreted in *Wilson* v. *Rousseau*, 1 Blatchf. C. C. 38, 1845, North. Dist. N. Y., *per Curiam*, to the same effect as in *Day* v. *Union India Rubber Co.*, *infra*.

Is explained in *Day* v. *Union India Rubber Co.*, 3 Blatchf. C. C. 504, 1856, South. Dist. N. Y., Hall, J., as holding that the defendants who had used an invention before the patent had been applied for, with the inventor's consent, founded upon sufficient consideration, had the right to continue to use the invention after the inventor had obtained a patent and assigned it to the plaintiff.

The remark of Mr. Justice Baldwin, *obiter*, that use in a factory is public use, is quoted in *Perkins* v. *Nashua, &c. Paper Co.*, 5 Ban. & A. 397, 1880, Dist. N. H., Lowell, J.

This case is considered, in reference to the construction it applies to § 7 of the patent act of 1839, providing that every person or corporation may use, and sell to others to be used, any specific machine, manufacture, or composition of matter which they have purchased or constructed prior to the application for a patent, in *Brickill* v. *New York*, 7 F. R. 481, 1880, South. Dist. N. Y., Wheeler, J.; s. c. 5 Ban. & A. 547; and in the latter case it is said not to be probable that *McClurg* v. *Kingsland* would be followed beyond cases of this class on the same statute, and also that the language of that case, although broad enough to cover all patents, is to be understood to be considered with reference to the very case before the court.

The principles of this case are said, in *Worley* v. *Tobacco Co.*, 184 U. S. 344, 1881, Supr. Court, Woods, J., to be, that if a person employed in the factory of another, while receiving wages, makes experiments at the expense and in the factory of his employer, has his wages increased in consequence of the useful results of his 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. This principle is approved in *Worley* v. *Tobacco Co.*

It is said in *New Process Fermentation Co.* v. *Maus*, 20 F. R. 729, 1884, North. Dist. Ind., Drummond, J., that this case sustained a patent for a process for casting iron rolls, although there was not much discussion upon the patentability of the claim.

Is cited in *Duffy* v. *Reynolds*, 24 F. R. 858, 1885, Dist. N. J., Nixon, J., as explaining that § 4899, U. S. R. S. has a twofold object, — to protect a person who has used the thing patented by having purchased or made the machine to which the invention is applied, from any liability to the patentee or his assignee;

second, to protect the rights granted to the patentee against infringement by any other persons.

Is explained in *Hapgood* v. *Hewitt*, 119 U. S. 233, 1886, Supr. Court, Blatchford, J., as deciding only that the facts justified the presumption of a license to the employer to use the invention as a defence by him to a suit for the infringement of a patent taken out by the employee.

Is cited in *Herman* v. *Herman*, 29 F. R. 94, 1886, South. Dist. N. Y., Brown, J., as holding that, under the circumstances of the case, a license or grant to use an invention was to be necessarily inferred from the contract, and from the relation and acts of the parties.

McCormick *v.* **Seymour**, 2 Blatchf. C. C. 254, 1851, North. Dist. N. Y., Nelson, J.

Is explained in *Toppan* v. *National Bank Note Co.*, 4 Blatchf. C. C. 511, 1861, South. Dist. N. Y., Shipman, J., as deciding that if a patentee allows public use of his invention more than two years before he applies for a patent, he forfeits his right to a patent.

Also quoted in *Bevin* v. *East Hampton Bell Co.*, 9 Blatchf. C. C. 62, 1871, Dist. Conn., Shipman, J.

Reference is made in *Celluloid Manuf. Co.* v. *Comstock, &c. Co.*, 27 F. R. 360, 1886, Dist. Conn., Shipman, J., to the well-known charge of Mr. Justice Nelson to the jury in the former case as to the patentability of an invention.

McCormick *v.* **Talcott**, 20 How. 402, 1857, Supr. Court, Grier, J.

Is said in *Morley Sewing Machine Co.* v. *Lancaster*, 23 F. R. 345, 1885, Dist. Mass., Colt, J., to lay down a clear principle that a patent for a primary invention should have a more liberal construction than is usual in the case of secondary invention, and may include all machines which do not have some substan-

tial difference; whereas in the case of an improvement on a known machine slight differences may prevent infringement.

McKay *v.* **Wooster**, 2 Sawyer, 373, 1873, Dist. Cal., Sawyer, J.

Is explained in *Hatch* v. *Adams*, 22 F. R. 438, 1884, East. Dist. Penn., McKennan, J., as having been decided upon an erroneous idea that the case of *Adams* v. *Burke*, 4 Fisher, 392, involved in its decision an extra-territorial sale of a patented article.

McMillin *v.* **Barclay**, 5 Fisher, 189, 1871, West. Dist. Penn., McKennan, J.

Is cited in *Colgate* v. *Western Union Telegraph Co.*, 4 Ban. & A. 65, 1878, South. Dist. N. Y., Blatchford, J., as a case where the lapse of eleven years between the rejection of an application for a patent and a renewed application was held, under the circumstances of the case, not to be evidence of an abandonment expressed or implied, the delay being satisfactorily explained.

Merrill *v.* **Yeomans**, 5 O. G. 267, 1874, Dist. Mass., Shepley, J.

Is cited to the effect that a patentee who has invented a 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, if both are new and useful in the sense of the patent law, in *Milligan & H. Glue Co.* v. *Upton*, 1 Ban. & A. 512, 1874, Dist. Mass., Clifford, J.

Merrill *v.* **Yeomans**, 94 U. S. 568, 1876, Supr. Court, Miller, J.

Is construed in *Gottfried* v. *Phillip Best Brewing Co.*, 5 Ban. & A. 36, 1879, East. Dist. Wis., Dyer, J., as a case in which a claim for a process of manufacture was subjected to rather limited construction. *Merrill*

v. *Yeomans* is accepted in the latter case as authority upon the question involved, but it was held that the same question was not involved in *Gottfried* v. *Phillip Best Brewing Co.*

Is said in *Duff* v. *Sterling Pump Co.*, 107 U. S. 639, 1882, Supr. Court, Blatchford, J., to be in accord with that case.

Merserole *v.* Union Paper Collar Co., 6 Blatchf. C. C. 356. 1869, South. Dist. N. Y., Blatchford, J.

Is cited in *Hartell* v. *Tilghman*, 99 U. S. 554, 1878. Supr. Court, Miller, J., as a case where Blatchford, J., states strongly the doctrine that if a case involves only rights arising under a contract respecting a patent, and not any act of Congress, or the construction of any law in regard to patents, a court of the United States has no jurisdiction unless by citizenship of the parties.

Judge Blatchford in this case is said in *Teas* v. *Albright*, 13 F. R. 414, 1882, Dist. N. J., Nixon, J., to have decided that a State court has jurisdiction to decree a license under a patent to be void; and if, in the investigation, that court is obliged to inquire collaterally into the invalidity or validity of the patent as a consideration for the license, such inquiry would not deprive a State court of jurisdiction, or confer it on a court of the United States.

Mevs *v.* Conover, 11 O. G. 1112, 1876, Supr. Court. Strong, J.

A long quotation from the opinion of the court in this case is made in *Knox* v. *Great Western Quicksilver Mining Co.*, 4 Ban. & A. 28, 1878, Dist. Cal., Sawyer, J., as to the proper rule for estimating profits. citing *Mowry* v. *Whitney*, 14 Wall. 651 (q. v.).

Middletown Tool Co. *v.* Judd, 3 Fisher, 141, 1867, Dist. Conn., Shipman, J.

"Whenever a change or device is new and accom-

plishes beneficial results, courts look with favor upon it; the law in such cases has no nice standard by which to gauge the degree of mental power or inventive genius brought into play in producing the new device." Quoted in *Celluloid Manuf. Co.* v. *Comstock & Cheney Co.*, 27 F. R. 360, 1886, Dist. Conn., Shipman, J., as illustrating the law in regard to inventive skill necessary to render an invention patentable before the decision in *Hollister* v. *Benedict &c. Manuf. Co.*, 113 U. S. 59 (q. v.).

Miller *v.* Bridgeport Brass Co., 12 O. G. 667, 1877, Dist. Conn., Shipman, J.

Following this decision, the court in *Hayes* v. *Seton*, 12 F. R. 123, 1882, East. Dist. N. Y., Benedict, J., held that several claims in a reissue were intended to enlarge the scope of the patent, and that while some of them were described or suggested in the original patent, it was evident on the face of the patent that there was no intention to describe them as part of the invention, or to claim an exclusive right therein, and the right to secure these improvements was lost by delay of nine years from the date of the original patent.

The opinion in this case is quoted from at length in *Putnam* v. *Hutchinson*, 12 F. R. 130, 1882, North. Dist. Ill., Blodgett, J., to the effect that a reissue which enlarges the claims of the original patent is invalid.

Miller *v.* Brass Co., 104 U. S. 350, 1882, Supr. Court, Bradley, J.

Is limited in *James* v. *Campbell*, 104 U. S. 371, 1882, Supr. Court, Bradley, J., as admitting that if by actual inadvertence, accident, or mistake innocently committed, the claim of a patent does not fully assert or define the patentee's right in the invention specified, a speedy ap-

plication for its correction, before adverse rights have accrued, may be successful.

Is affirmed in *Bantz* v. *Frantz*, 105 U. S. 166, 1882, Supr. Court, Woods, J., as deciding that an application for a reissue must be made immediately; unreasonable delay forfeits the right.

In *Mathews* v. *Machine Co.*, 105 U. S. 58, 1881, Supr. Court, Bradley, J., the same is again affirmed.

Is affirmed in *Gage* v. *Herring*, 107 U. S. 645, 1882, Supr. Court, Gray, J., that delay in obtaining a reissue invalidates it.

Is referred to in *Combined Patents Can Co.* v. *Lloyd*, 11 F. R. 150, 1882, East. Dist. Penn., Butler, J., as being one of the late cases in which the subject of reissue was discussed. The opinion in *Miller* v. *Brass Co.* is quoted from to the effect that if there is a *bona fide* mistake by which some part of an invention has been omitted from the original patent, the claim in the reissue may be enlarged so as to include the omitted portion; but also to the effect that if an inventor only patents a portion of his invention, and rests a long time after his patent is granted, he is equitably estopped to reissue his patent so as to cover the unpatented portion of the invention.

The reasoning of the Supreme Court in this case is said, in *McWilliams Manuf. Co.* v. *Blundell*, 11 F. R. 420, 1882, Dist. R. I., Colt, J., to be applicable to cases of the enlargement of a patent in the reissue, and where it is for a different invention, intimating that the application is to be limited to such cases.

The opinion of Mr. Justice Bradley in that case as to the validity of a reissue in case of a real mistake in the original patent, not a mere error of judgment, is quoted in *Jones* v. *Barker*, 11 F. R. 599, 1882, Dist. Maine, Lowell, J.

Is cited in *Sheriff* v. *Fulton*, 12 F. R. 139, 1882,

West. Dist. Penn., Acheson, J., as settling the law that acquiescence by a patentee for a long time in the patent as originally granted estops him from claiming a reissue on the ground of mistake.

Is said in *MacKay* v. *Jackman*, 12 F. R. 619, 1882, South. Dist. N. Y., Wheeler, J., to strongly intimate that whatever the patentee describes in a patent and does not claim is abandoned to the public unless it was omitted to be claimed by inadvertence or mistake, and the correction is sought immediately upon discovery of the omission.

Is cited in *Tillinghast* v. *Hicks*, 13 F. R. 390, 1882, North. Dist. N. Y., Coxe, J., as deciding that a long delay after an original patent is granted, before the reissue is applied for, acts as an estoppel to prevent the granting of a reissue.

Is approved in *Clements* v. *Odorless Apparatus Co.*, 109 U. S. 649, 1883, Supr. Court, Blatchford, J.

Is approved in *Turner & S. Co.* v. *Dover Stamping Co.*, 111 U. S. 327, 1883, Supr. Court, Matthews, J.

Is cited to the same effect as above in *Newton* v. *Furst, &c. Manuf. Co.*, 14 F. R. 470, 1882, North. Dist. Ill., Blodgett, J.

Also *Cote* v. *Moffitt*, 15 F. R. 345, 1883, Dist. Mass, Lowell, J.

Also *Singer Manuf. Co.* v. *Goodrich*, 15 F. R. 456, 1883, Dist. Mass., Nelson, J.

Is stated in *Ives* v. *Sargent*, 17 F. R. 449, 1883, Dist. Conn., Shipman, J., to declare that the right to have a mistake in a patent corrected when the mistake was plain and forthwith discernible, and improperly narrowed the claim, must be speedily exercised, or the right will be necessarily abandoned and lost by unreasonable delay. *Miller* v. *Brass Co.* is said in the latter case to have been favorably referred to by the Supreme Court in at least four cases since its decision.

Is said in *Hartshorn* v. *Eagle Shade Roller Co.*, 18 F. R. 92, 1883, Dist. Mass., Lowell, J., to have given an emphatic and reiterated declaration that a delay of more time than would be reasonably sufficient to read the patent and ascertain its need of amendment should be accounted such laches as will invalidate a reissue in a case where the enlargement of the claim is the only amendment. It is said in *Hartshorn* v. *Eagle Shade Roller Co.*, that this emphatic and reiterated declaration cannot be overlooked.

Reconsidered and affirmed in *Mahn* v. *Harwood*, 112 U. S. 357, 1884, Supr. Court, Bradley, J. (Miller, J., dissenting, is of opinion that as to reissued patents the question of laches or delay should be governed by the same rules as in case of an original patent.)

Is cited to the same general effect as above in *Coon* v. *Wilson*, 113 U. S. 277, 1884, Supr. Court, Blatchford, J.

Is interpreted in *Wollensak* v. *Reiher*, 115 U. S. 99, 1884, Supr. Court, Matthews, J., to have declared that where the mistake suggested as the ground for a reissue is merely that the claim is not so broad as it might have been, as this mistake is necessarily apparent upon the first inspection of the patent, if any correction is desired, it should be applied for immediately, and that the granting a reissue for such a purpose after an unreasonable delay, is clearly an abuse of the powers to grant reissues, and may justly be declared illegal and void; that in reference to reissues made for the purpose of enlarging the scope of the patent, the rule of laches should be strictly applied, and no one should be relieved who has slept on his rights and thus led the public to rely on the implied disclaimer involved in the terms of the original patent; and that where this is apparent on the face of the instrument upon a mere comparison of the old patent and the reissue, it is com-

petent for the court to decide whether the delay was unreasonable, and whether the reissue was therefore void.

Is quoted from in *Swift* v. *Jenks*, 19 F. R. 642, 1884, North. Dist. N. Y., Coxe, J., to the effect that if a patent claims certain specific devices, and does not claim other devices apparent upon the face of the patent, the omitted devices are dedicated to the public.

"If a patentee who has no corrections to suggest in his specification, except to make his claim broader and more comprehensive, uses due diligence in returning to the patent office, and says, 'I omitted this,' or 'my solicitor did not understand that,' his application may be entertained, and on a proper showing correction may be made." Quoted as authorizing a reissue in *Stutz* v. *Armstrong*, 20 F. R. 845, 1884, West. Dist. Penn., Acheson, J.

Is said in *Crandal* v. *Parker Carriage Goods Co.*, 20 F. R. 852, 1884, North. Dist. N. Y., Coxe, J., to have promulgated a new doctrine in regard to reissues.

The principle of this case was also applied in *Yale Lock Manuf. Co.* v. *James*, 20 F. R. 905, 1884, South. Dist. N. Y., Shipman, J.

Is cited in *Wooster* v. *Handy*, 21 F. R. 53, 1884, South. Dist. N. Y., Blatchford, J., in regard to reissues.

The principles of this case applied in *Atlantic Giant Powder Co.* v. *Hulings*, 21 F. R. 522, 1884, West. Dist. Penn., Acheson, J.

Also in *Scrivner* v. *Oakland Gas Co.*, 22 F. R. 99, 1884, Dist. Cal., Sawyer, J.

Does not decide that a reissued patent is always void if the claims of the original patent are extended. *Odell* v. *Stout*, 22 F. R. 163, 1884, South. Dist. Ohio, Sage, J.

Is quoted from in *Flower* v. *Detroit*, 22 F. R. 301, 1884, East. Dist. Mich., Brown, J.

Is cited in *Wollensak* v. *Reiher*, 22 F. R. 653, 1884, North. Dist. Ill., Gresham, J.

It is said in *Gage* v. *Kellogg*, 23 F. R. 894, 1885, North. Dist. N. Y., Coxe, J., that if the decision in *Miller* v. *Brass Co.* had been announced at the time the reissue in *Gage* v. *Kellogg* was applied for, that reissue would not have attempted to cover other machines, as well as the inventors, by an ingenious and clever use of words.

Is explained in *Sewing Machine Co.* v. *Frame*, 24 F. R. 598, 1884, East. Dist. Penn., Butler, J., as carefully excepting from its decision cases where a patent is corrected by means of a reissue, the patent being inoperative for want of a full and clear description of the invention.

Is cited to the same general effect in *Shirley* v. *Mayer*, 25 F. R. 38, 1885, East. Dist. N. Y., Benedict, J.

Governed the case of *Phillips* v. *Risser*, 26 F. R. 312, 1885, North. Dist. Ill., Blodgett, J.

It is said in *Pope Manuf. Co.* v. *Owsley*, 27 F. R. 107, 1886, North. Dist. Ill., Blodgett, J., that the Supreme Court of the United States in *Miller* v. *Brass Co.* took a radical departure from the rule formerly held by that court as to the validity of a reissue; before that time the rule was that a reissue taken at any time for expanded and enlarged claims was valid if a foundation of such claims could be found in the specifications of the original patent, or even the specifications aided by the drawings.

Governed the decision in *Hoe* v. *Knap*, 27 F. R. 212, 1886, North. Dist. Ill., Blodgett, J.

Is said in *Asmus* v. *Alden*, 27 F. R. 688, 1886, East. Dist. Penn., Butler, J., not to have made any change in regard to reissues prohibiting the introduction of new claims under all circumstances. This result could only follow a repeal or disregard of the statute governing this

subject. *Miller* v. *Brass Co.* simply applied the equitable doctrine of estoppel to a patentee who, after inexcusable delay (during which others may be presumed to have acted on the reasonable inference that all not claimed in the patent has been dedicated to the public), sought by means of reissue to enlarge the scope of his patent so as to embrace and prohibit such acts. Reference is made to Judge Butler's understanding of this case in the *Combined Patents Can Co.* v. *Lloyd*, 11 F. R. 149.

Is cited and approved in *White* v. *Dunbar*, 119 U. S. 52, 1886, Supr. Court, Bradley, J.

The principles of this case as to the validity of a reissue applied in *Electric Gaslight Co.* v. *Boston Electric Co.*, 29 F. R. 456, 1886, Dist. Mass., Colt, J.

This case was urged upon the court in *Eastern Paper Bag Co.* v. *Standard Paper Bag Co.*, 30 F. R. 65, 1887, Dist. Mass., Colt, J., as sustaining the proposition that the omission of an inventor to claim his process invention in his machine patent is in law a dedication of process invention to the public, but is distinguished by the court as dealing with the subject of reissues, and therefore not an authority in the latter case.

Mitchell *v.* **Hawley**, 16 Wall. 544, 1873, Supr. Court, Clifford, J.

Is considered at length in *Wooster* v. *Sidenberg*, 2 Ban. & A. 95, 1875, South. Dist. N. Y., Shipman, J., as deciding that when a patentee makes and sells a machine without any restriction on its use, or authorizes another to construct, sell, and deliver it, or to construct and operate it, and the consideration thereupon is paid him, he loses all interest in the machine, which then passes outside the monopoly, and may be used by the owner till worn out.

Mitchell *v.* **Tilghman,** 19 Wall. 287, 1873, Supr. Court, Clifford, J.

Is said in *Henderson* v. *Cleveland Co-operative Stove Co.*, 2 Ban. & A. 608, 1877, North. Dist. Ohio, Brown, J., to have expanded the principle of *Seymour* v. *Osborne* (q. v.), and to lay down the rule that in all cases where the claim of a patent is for the result it must be construed to mean the means by which the result is produced, whether there is any reference to the specifications in the claim or not.

In *Tilghman* v. *Proctor*, 102 U. S. 708, 1880, Supr. Court, Bradley, J., the same patent was under consideration, on substantially the same evidence, with supplementary evidence of the patentee as to the nature of his original experiments, and the practicability of using profitably the coil apparatus described in the patent, and certain exhibits relating to the novelty of the invention. In *Tilghman* v. *Proctor* the court changed its opinion as given in *Mitchell* v. *Tilghman*, and considered the patent should be sustained as a patent for a process, and not for the particular mode of applying and using the process pointed out in the specification.

Is cited in *New Process Fermentation Co.* v. *Maus*, 20 F. R. 728, 1884, North. Dist. Ind., Drummond, J., to the effect that a process may be patented as an art under the statute, though it is often difficult to decide what is a process which may be the subject of a patent.

Moffitt *v.* **Garr,** 1 Black, 273, 1861, Supr. Court, Nelson, J.

In *Peck* v. *Collins*, 103 U. S. 663, 1880, Supr. Court, Bradley, J., *Moffitt* v. *Garr* is stated and quoted from as deciding that a surrender of a patent extinguishes all rights under it, even as to infringement committed prior to the surrender; and this doctrine is extended so that when an application for a reissue is made and rejected, all rights are gone, the original patent being sur-

rendered and the reissue being rejected. The effect of § 53 of the general revision of 1870 is expressly avoided in the opinion of *Peck* v. *Collins*, the facts of that case arising before that change; but it is intimated that if the reissue is rejected on merely formal grounds, it might entitle the applicant to a return of his prior patent.

Moody *v.* **Fiske**, 2 Mas. 112, 119, 1820, Dist. Mass., Story, J.

Is explained in *Wyeth* v. *Stone*, 1 Story, 290, 1840, Dist. Mass., Story, J., as deciding that while several distinct improvements in one machine may be united in one patent, it does not follow that several improvements in different machines having distinct and independent operations can be so included; much less that the same patent may be for combinations of different machines and for different improvements in each.

It is said in *Emerson* v. *Hogg*, 2 Blatchf. C. C. 7, 1845, South. Dist. N. Y., Betts, J., that the *caveat* of Judge Story in the former case, as to including several improvements in separate machines in one specification, is by way of caution only, and to avoid the conclusion that the court was committed upon that specific point.

Is said in *Sessions* v. *Romadka*, 21 F. R. 132, 1884, East. Dist. Wis., Dyer, J., to decide that several improvements in different machines having distinct and independent operations cannot be included in one patent.

Moore *v.* **Marsh**, 7 Wall. 522, 1868, Supr. Court, Clifford, J.

Is said in *Gordon* v. *Anthony*, 4 Ban. & A. 263, 1879, South. Dist. N. Y., Blatchford, J., to decide that the assignment of a patent does not carry with it a transfer of the right to damages for an infringement committed before such an assignment.

Is said in *Adams* v. *Bellaire Stamping Co.*, 25 F. R. 271, 1885, South. Dist. Ohio, Sage, J., to have decided

that in cases where an assignment does not include prior claims for infringement, the holder of the patent at the time of the prior infringement should be joined as a plaintiff, in a suit for infringement, but only for the reason that the assignment of a patent does not carry with it claims for prior infringement.

Is said in *May* v. *Juneau County*, 30 F. R. 245, 1887, West. Dist. Wis., Bunn, J., to decide that the original owner of a patent who has sold his right may recover for an infringement committed during the time he was owner; the court adds: "Undoubtedly the assignee thereof stands in the place of the patentees, both as to the right under the patent and future responsibility; but it is a great mistake to suppose that the assignment of a patent carries with it a transfer of the right to damages for an infringement committed before the assignment."

Morey *v.* **Lockwood**, 8 Wall. 230, 1868, Supr. Court., Nelson, J.

Is cited in *Russell* v. *Dodge*, 93 U. S. 463, 1876, Supr. Court, Field, J., as a case where, under special circumstances, the inventor having been induced to limit his claim by mistake of the commissioner of patents, a reissue was valid which extended beyond the ordinary scope of the statute of 1836. That statute allows a definite specification to be rendered more definite and certain so as to embrace the claim made, or the claim to be so modified as to correspond with the specification, but no more.

Cited upon the question of reissues in *Scrivner* v. *Oakland Gas Co.*, 22 F. R. 99, 1884, Dist. Cal., Sawyer, J., and said to be a case where the original claim in the application of the inventor included the whole invention, but the patent office compelled him to cut off part of his claim.

Is spoken of as a case of special circumstances in *Eames* v. *Andrews*, 122 U. S. 63, 1886, Supr. Court., Matthews, J., and the rule cited in *Russell* v. *Dodge*, *supra*, is affirmed.

Morris *v.* **McMillin**, 112 U. S. 244, 1884, Supr. Court, Woods, J.

The principle of decision of this case in regard to the non-patentability of combinations of old elements was followed in *Thatcher Heating Co.* v. *Burtis*, 121 U. S. 295, 1886, Supr. Court, Matthews, J. See *Hailes* v. *Van Wormer*.

Morse *v.* **O'Reilly**, 15 How. 62, 117, 1847, East. Dist. Penn., Kane, J.

Mr. Chief-Justice Taney uses the word "method" in this case as equivalent to "process;" so said in *American Bell Telephone Co.* v. *Dolbear*, 15 F. R. 453, 1883, Dist. Mass., Gray, J.

Mowry *v.* **Whitney**. 14 Wall. 620, 1872, Supr. Court, Strong, J.

Decides that in accounting before a master for profits, the 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? The fruits of that advantage are his profits. This rule is followed in *Littlefield* v. *Perry*, 21 Wall. 228, 1874, Supr. Court, Waite, C. J., and an order to account for all profits received from the manufacture and sale of articles embracing the improvements covered by any of complainant's patents condemned as too broad. *Mowry* v. *Whitney* also decides that interest on the amount found by the master is not allowable except in special cases, and this rule is followed in *Littlefield* v. *Perry*.

Is said in *Gould's Manuf. Co.* v. *Cowing*, 1 Ban. & A. 382, 1874, North. Dist. N. Y., Hunt, J., to decide the same point as that case, that is, that when the patent sued on is for an improvement in a machine, the profits recoverable are those gained by the improvement, not by the whole machine.

Constrains the court in *American Nicholson Pavement Co.* v. *Elizabeth*, 1 Ban. & A. 462, 1874, Dist. N. J., Nixon, J., to decide against interest on profits, being in reality unliquidated damages, until final decree, unless in cases when particular circumstances make interest proper.

The rule of this case in regard to profits is followed in *Wetherill* v. *New Jersey Zinc Co.*, 1 Ban. & A. 486, 1874, Dist. N. J., McKennan, J.

It is said in *Foster* v. *Lindsay*, 1 Ban. & A. 607, 1874, East. Dist. Mo., Treat, J., that *Mowry* v. *Whitney* holds that no one but the Government, either in its own name or by some of its officers, can vacate or rescind a patent, except as provided by § 16 of the act of July 4, 1836; and under this section the court can only annul or set aside one patent so far as necessary to protect another patent, and the decree does not affect the general public.

Is referred to in *Foster* v. *Lindsay*, 2 Ban. & A. 174, 1875, East. Dist. Mo., Treat, J., as deciding that if a patent is to be annulled *ab initio*, the proceeding must be at the direct motion of the Government; but it does not decide that the question between conflicting patents may not be fully and finally determined as to the parties in a suit between interfering patents.

Is examined at length in *Attorney-General* v. *Rumford Chemical Works*, 2 Ban. & A. 308, 1876, Dist. R. I., Shepley, J., and said to decide and only to decide that an interfering patentee, or individual, could not in his own name, or in his right, maintain a bill in equity

to vacate a patent, upon the ground of false suggestion or fraud in obtaining the patent, and the general public is left to the protection of the Government and its officers in such a case.

Is cited in *Railway Co.* v. *Sayles*, 97 U. S. 556, 1878, Supr. Court, Bradley, J., as deciding the principle upon which a master's accounts of profits should be rendered.

Is also quoted in *Knox* v. *Great Western Mining Co.*, 4 Ban. & A. 26, 1878, Dist. Cal., Sawyer, J., to the same effect as in *Manufacturing Co.* v. *Cowing*, *infra*.

Is cited in *Steam Stone Cutter Co.* v. *Windsor Manuf. Co.*, 4 Ban. & A. 453, 1879, Dist. Vt., Wheeler, J., as a case in which interest upon profits of an infringement was disallowed, with the remark that the profits were really damages unliquidated upon which interest is not generally allowable; but the court would not say that in no possible case would interest be allowed.

The decision in this case is distinguished in *Burdett* v. *Estey*, 5 Ban. & A. 311, 1880, Dist. Vt., Wheeler, J., by the fact that in *Mowry* v. *Whitney* the plaintiffs, in proving profits, were required to distinguish the profits due to the patented process from those received by the defendant from an unpatented process, and that was already done in the latter case. The court also distinguished *Mowry* v. *Whitney* from *Elizabeth* v. *Pavement Co.*, 97 U. S. 126, by saying that in *Mowry* v. *Whitney*, where a process only was infringed, what was made by the process only was made as profits; while in *Elizabeth* v. *Pavement Co.*, where the product was infringed, the profits on the products were allowed.

"It would be most unreasonable to read the directions of the specifications without referring to the object they profess to have in view." Quoted in *Roberts* v. *Schreiber*, 5 Ban. & A. 503, 1880, North. Dist. Penn., Strong, J.

The rule for the measure of profits as distinguished from damages for which an infringer is responsible, laid down in the above case, is approved in *Locomotive, &c. Co.* v. *Pennsylvania R. R. Co.*, 5 Ban. & A. 515, 1880, East. Dist. Penn., Strong, J., as founded upon the soundest reason. This rule is stated in the former case to be, that the measure of the profits as distinguished from damages for which an infringer is responsible is the aggregate of gains or savings which he has made on the use of the patented invention above what he could have made in doing the same work from the use of any other device or process existing at the time, capable of accomplishing the same purpose or attaining the same result, and free or open to public use.

Is quoted from in *Root* v. *Railway Co.*, 105 U. S. 197, 1881, Supr. Court, Matthews, J., as to the rule for measure of damages and denying interest upon profits.

The opinion of Mr. Justice Strong is quoted from, and said to state well the rule applicable to the damages recoverable in a suit for the infringement of a patent, in *Manuf. Co.* v. *Cowing*, 105 U. S. 255, 1881, Supr, Court, Waite, C. J. "The question to be determined 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? The fruits of that advantage are his profits."

The decision in this case, construing the scope and purport of § 16 of the patent act of 1836, is said in *Lockwood* v. *Cleveland*, 6 F. R. 726, 1881, Dist. N. J., Nixon, J., to have been used in *Foster* v. *Lindsay*, 3 Dill. 126, to support the decision in last-named case on the construction of § 4918, U. S. R. S.

Is said in *United States* v. *Gunning*, 18 F. R. 512, 1883, South. Dist. N. Y, Wallace, J., to have assumed without question that 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, and that a bill in equity by the Government was the proper remedy in both cases. Upon this principle *Mowry* v. *Whitney* decided that a patentee could not maintain a bill in equity to vacate an interfering patent which was fraudulently obtained.

Is cited in dissenting opinion of Miller, J., in *Mahn* v. *Harwood*, 112 U. S. 388, 1884, Supr. Court, Bradley, J., as to the conclusiveness of the decision of the commissioner of patents upon the validity of a reissue.

Is said in *New Process Fermentation Co.* v. *Maus*, 20 F. R. 729, 1884, North. Dist. Ind., Drummond, J., to have sustained a patent for a process.

Is cited in *Kirk* v. *Du Bois*, 28 F. R. 462, 1886. West. Dist. Penn., McKennan, J., to the effect that the compensation of a patentee for an infringement which he may obtain by a suit in equity, although called profits, is in reality damages unliquidated until the decree is made.

N.

Nellis *v.* **McLanahan**, 6 Fisher, 286, 1873, West. Dist. Penn., McKennan, J.

Is distinguished, in *Horman Patent Manuf. Co.* v. *Brooklyn City Railroad Co.*, 4 Ban. & A. 87, 1879, East. Dist. N. Y., Benedict, J., from the latter case, for the reason that in the former case the bill would have been held good if it had averred, as the bill in the latter case does, that the machine made and sold by the defendant contained devices covered by each of the two patents set forth in the bill.

Is construed in *Hayes* v. *Dayton*, 8 F. R. 704, 1880, South. Dist. N. Y., Blatchford, J., as deciding that when a suit in equity 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 machine contained all the improvements embraced in the several patents, or it will be held bad for multifariousness on demurrer.

Nelson *v.* **McMann**, 16 Blatchf., C. C., 139, 1879, South. Dist. N. Y., Blatchford, J.

Is cited in *Gordon* v. *Anthony*, 4 Ban. & A. 262, 1879, South. Dist. N. Y., Blatchford, J., as an authority upon a construction of §§ 629, 711, 4919, 4921, U. S. R. S., relating to suits in equity and at law for the infringement of the patent, under which no person can sue on a patent who is not the patentee, or such an assignee or grantee as the statute points out.

Nevins *v.* **Johnson**, 3 Blatchf., C. C. 80, 1853, South. Dist. N. Y., Betts, J.

Is said in *Vaughan* v. *East Tennessee, &c. R. R. Co.*, 2 Ban. & A. 538, 1877, East. Dist. Tenn., Brown, J., to have decided that the federal courts had jurisdiction in a patent case irrespective of a prayer in the bill for an injunction, in a suit brought after the patent had expired. See now *Root* v. *Railway Co.*

Is referred to in *Gordon* v. *Anthony*, 4 Ban. & A. 257, 1879, South. Dist. N. Y., Blatchford, J., as a case where, the bill being filed after the patent had expired, the suit was maintained in equity under the statute of July 4, 1836, 5 U. S. Stat. at L. 124, § 17, irrespective to the right of the patentee to an injunction. See now *Root* v. *Railway Co.*

In *Root* v. *Railway Co.*, 105 U. S. 206, 1881, Supr. Court, Matthews, J., it is said that *Nevins* v. *Johnson* has been alleged to have confused the distinction between the jurisdiction of the federal courts in cases

at law and in equity under the patent act; but Mr. Justice Matthews denies that this is its effect.

New York *v.* **Ransom**, 23 How. 487, 1859, Supr. Court, Grier, J.

Is said in *Root* v. *Railway Co.*, 105 U. S. 197, 1881, Supr. Court, Matthews, J., expressly to approve the rule as to the measure of damages in an action at law laid down in *Seymour* v. *McCormick*, 16 How. 480, and to give the plaintiff, who rested on proof of infringement only, merely nominal damages.

New York Belting & Packing Co. *v.* **Sibley**, 15 F. R. 386, 1883, Dist. Mass., Lowell, J.

Is said in *Boland* v. *Thompson*, 26 F. R. 635, 1886, South. Dist. N. Y., Coxe, J., to be authority for the proposition that when a claim has been examined and rejected by the commissioner, the rejection acquiesced in by the patentee or his solicitor, and the patent reissued without the claim, there is no inadvertence, accident, or mistake which will entitle the patentee to a reissue.

New York Grape Sugar Co. *v.* **Buffalo Grape Sugar Co.**, 24 F. R. 604, 1883, North. Dist. N. Y., Shipman, J.

Is cited in *Keller* v. *Stoltzenbach*, 28 F. R. 82, 1886, West. Dist. Penn., Acheson, J., as applying the doctrine of laches to a patent suit as barring an account of profits, on the ground of the long acquiescence and unreasonable delay of the plaintiff.

Nichols *v.* **Newell**, 1 Fisher, 647, 1853, Dist. Mass., Sprague, J.

The statement of the decision in this case in Brightley's Dig., p. 637, is accepted in *Oliphant* v. *Salem Flouring Mills Co.*, 3 Ban. & A. 259, 1878, Dist. Or., Deady, J.

Nicolson Pavement Co. *v.* **Jenkins**, 14 Wall. 452, 1871, Supr. Court, Davis, J.

Shipman, J., in *Waterman* v. *Wallace*, 2 Ban. & A. 130, 1875, Dist. Conn., says: "I do not understand that the Supreme Court, in *Nicolson Pavement Co.* v. *Jenkins*, intended to assert that an assignment of an invention merely, conveyed the interest of the inventor to an extension; on the other hand, that decision assumes that an assignment of an invention without words importing intention to convey a present and a future interest will not pass the right to an extension. Cf. *Mowry* v. *Grand Street, &c. R. R. Co.*, 10 Blatchf. C. C. 89.

Is stated briefly in *Fire Extinguisher Manuf. Co.* v. *Graham*, 16 F. R. 554, 1883, West. Dist. Va., Hughes, J., and said to decide that the assignment in that case carried the seven years' extension of the original patent obtained by the administrator of the original patentee.

The language of Davis, J., in this case, as to what passes by the assignment of a patent, is quoted at length in *Johnson* v. *Wilcox & Gibbs Sewing Machine Co.*, 27 F. R. 690, 1886, South. Dist. N. Y., Wallace, J.

Northrup *v.* **Adams**, 2 Ban. & A. 567, 1877, Dist. N. J., Brown, J.

Is quoted from in *Western Electric Manuf. Co.* v. *Odell*, 18 F. R. 322, 1883, North. Dist. Ill., Blodgett, J., upon the subject of design patent.

Nourse *v.* **Allen**, 4 Blatchf. C. C. 376, 1859, South. Dist. N. Y., Nelson, J.; s. c. 3 Fisher, 63.

Is cited in *Horman Patent Manuf. Co.* v. *Brooklyn City R. R. Co.*, 4 Ban. & A. 87, 1879, East. Dist. N. Y., Benedict, J., as a case where a bill similar to the one in the latter case was sustained.

This case is cited in *Hayes* v. *Dayton*, 8 F. R. 704, 1880, South. Dist. N. Y., Blatchford, J., as ·ciding

on demurrer that a bill in equity founded on four patents was good, since it alleged that the machine sued contained all the improvements in all the patents, although the defences might be different and unconnected.

Is said in *Deering* v. *Winona Harvester Works*, 24 F. R. 90, 1885, Dist. Minn., Nelson, J., to announce the principles as to joining infringements of different patents in the same bill.

O.

Oliver *v.* **Rumford Chemical Works**, 109 U. S. 75, 1883, Supr. Court, Blatchford, J.

Is said in *Curran* v. *Craig*, 22 F. R. 101, 1884, East. Dist. Mo., Treat, J., apparently to decide that a license is personal to the licensee, whereby an executor, administrator, or assignee, voluntary or involuntary, does not succeed to the privilege of the grant.

O'Reilly *v.* **Morse**, 15 How. 62, 1853, Supr. Court, Taney, C. J.

Is said in *Silsby* v. *Foote*, 20 How. 389, 1857, Supr. Court, in the opinion of Grier, J., dissenting, to have decided that a patent for the application of an element of nature to practical use was too broad, and void.

Is distinguished, in *Arkell* v. *Hurd Paper Bag Co.*, 7 Blatchf. C. C. 477, 1870, North. Dist. N. Y., Woodruff, J., from the latter case; the patent is for an improved product, and not for a principle.

The use of electric magnetism to mark or print characters at a distance is not patentable independently of the means by which the natural agency is utilized. Said to be the effect of this decision in *Union Paper Collar Co.* v. *White*, 2 Ban. & A. 64, 1875, East. Dist. Penn., McKennan, J.

The opinion of Mr. Chief-Justice Taney commenting upon the case of Neilson's patent for a hot blast, Web. P. C. 275, 312, is quoted from in *Tilghman* v. *Proctor*, 102 U. S. 725, 1880, Supr. Court, Bradley, J., as showing that he fully acquiesced in the validity of a patent for a process, although *O'Reilly* v. *Morse* is supposed to be adverse to patents for mere processes. This mistake arises from confounding a patent for a process with a patent for a mere principle. The Morse patent was invalid because it claimed a patent for discovering that a particular power could be employed, not for a particular process or particular machinery to so employ it. The opinion of Mr. Chief Justice Taney is said, in *Tilghman* v. *Proctor*, to be a clear and exact summary of the law on this point.

Cited in *McMillin* v. *Rees*, 5 Ban. & A. 271, 1880, West. Dist. Penn., McKennan, J., to the point that a patent must be limited to the specific invention described in the claim.

It is said in *New Process Fermentation Co.* v. *Maus*, 20 F. R. 730, 1884, North. Dist. Ind., Drummond, J., that the court in the former case refused to sustain the eighth claim of Morse, because he disavowed the specific machinery or means mentioned, but claimed the use of the motive power of the electric current, however developed, thus making an attempt to claim a principle.

Is said in *Canan* v. *Pound Manuf. Co.*, 23 F. R. 186, 1885, North. Dist. N. Y., Wallace, J., to overrule the case of *Smith* v. *Ely*, 5 McLean, 76, holding that United States letters-patent, which do not in terms limit the grant to fourteen years from the date or publication of a foreign patent, if such exist, are void. The letters-patent of the United States may be expressed to run fourteen years from their issue, but the foreign patent will limit the actual term.

Is said in *Gold & Stock Telegraph Co.* v. *Commercial Telegraph Co.*, 23 F. R. 343, 1885, South. Dist. N. Y., Shipman, J. to have left undecided the question whether a United States patent applied for before the date of application for a foreign patent, but issued after the issue of the foreign patent, is affected by § 6 of the patent act of 1839, limiting the term of such patent by the term of the foreign patent. See *De Florez* v. *Raynolds*.

Orr *v.* **Badger**, 7 Law Rep. 465, 1844, Dist. Mass., Sprague, J.

The opinion of Sprague, J., is affirmed in *Orr* v. *Littlefield*, 1 Wood. & M. 16, 1845, Dist. N. H., Woodbury, J.

P.

Packet Company *v.* **Sickles**, 19 Wall. 617, 1873, Supr. Court, Miller, J.

Is quoted in *Knox* v. *Great Western Quicksilver Mining Co.*, 4 Ban. & A. 26, 1878, Dist. Cal., Sawyer, J., to the effect that profits are recovered from an infringer upon the principle of converting him into a trustee of the patentee as regards the profits thus made. See now *Root* v. *Railway Co.*

Is said in *Root* v. *Railway Co.*, 105 U. S. 198, 1881, Supr. Court, Matthews, J., to follow the rule for measure of damages in an action at law for infringement; that is, the patent or license fee, or royalty, laid down in *Seymour* v. *McCormick*, 16 How. 470, and the language of Miller, J., in *Packet Co.* v. *Sickles*, is quoted as saying that the rule of damages in an action at law is different from that in a suit in equity, when the infringer is held a trustee for the patentee of actual profits. In *Root* v. *Railway Co.*, *Packet Co.* v. *Sickles* was urged

upon the court as a case which decided that an infringer is a trustee of the profits, and therefore a court of equity will compel him to account even after the patent has expired, and although no other equitable relief is sought; but this view was rejected by the court, and the expressions as to the infringer being a trustee explained to be only an expression of the measure of damages, not a characterization of the jurisdictional basis of the suit.

The remarks in this case of the Supreme Court, that taking profits as the basis for compensation in courts of equity has produced results creating distrust of its fairness, are quoted in *Emigh* v. *Baltimore & Ohio R. R. Co.*, 6 F. R. 289, 1881, Dist. Md., Morris, J.

Is stated in *Westcott* v. *Rude*, 19 F. R. 833, 1884, Dist. Ind., Woods, J., to affirm the rule laid down in *Seymour* v. *McCormick*, 16 How. 480, that in suits at law for infringement of patents, when the sale of licenses by the patentee has been sufficient to establish a price for such licenses, that price should be taken as the measure of his damages against the infringer.

Palmenburg *v.* **Buchholz**, 21 Blatchf. C. C. 162, 1882, South. Dist. N. Y., Wallace, J.

"Although the device may have been mechanically new, it was not intellectually novel." Quoted in *New York Bung & Bushing Co.* v. *Doelger*, 23 F. R. 194, 1885, South. Dist. N. Y., Coxe, J., in regard to the substitution of *papier maché* for wire in the frame of a lay figure.

Parham *v.* **American Buttonhole, &c. Co.**, 4 Fisher, 468, 482, 1871, East. Dist. Penn., McKennan, J.

Mr. Justice McKennan's opinion is quoted: "The evidence must clearly establish the priority of a completed and useful machine over the complainants, or it is unavailing; and to doubt upon this point is to resolve it

in the negative." *Hawes* v. *Antisdel*, 2 Ban. & A. 11, 1875, East. Dist. Mich., Longyear, J.

Is cited in *Reissner* v. *Anness*, 3 Ban. & A. 178, 1877, Dist. N. J., Nixon, J., to the point that the difference between a patent and a reissue may be determined by reference to the drawings and models filed with the original specifications, as well as by reference to the patents and reissue.

Parker *v.* **Hall**, 2 Fisher, 62, note, 1858, South. Dist. Ohio, McLean, J.

Is said in *Rich* v. *Ricketts*, 7 Blatchf. C. C. 230, 1870, North. Dist. N. Y., Hall, J., to favor a plea in a patent suit in the federal court based upon a State statute of limitation.

Is cited in *May* v. *Logan County*, 30 F. R. 257, 1887, North. Dist. Ohio, Jackson, J., as a case holding that a State statute of limitation may be interposed as a defence in a suit in the federal court for infringement of a patent. See *Collins* v. *Peebles*.

Parker *v.* **Hallock**, 2 Fisher, 543, 1857, South. Dist. Ohio, Grier, J.

It is said in *Rich* v. *Ricketts*, 7 Blatchf. C. C. 231, 1870, North. Dist. N. Y., Hall, J., that Grier, J., held that there was no statute limiting the time within which a suit for the infringement of a patent might be brought, and that a State statute of limitations has no force in such a suit in a federal court.

Is referred to in *Anthony* v. *Carroll*, 2 Ban. & A. 197, 1875, Dist. Mass., Shepley, J., as deciding that no limit exists for the time of bringing suits in the federal courts for the infringement of patents. See *Collins* v. *Peebles*.

Parker *v.* **Hawk**, 2 Fisher, 58, 1857, South. Dist. Ohio, Leavitt, J.

Is said in *Rich* v. *Ricketts*, 7 Blatchf. C. C. 230, 1870, North. Dist. N. Y., Hall, J., to favor a plea in a patent

suit in the federal court based upon a State statute of limitation.

Is criticised in *Anthony* v. *Carroll*, 2 Ban. & A. 197, 1875, Dist. Mass., Shepley, J., who says that *Parker* v. *Hawk* was decided on the authority of *McClung* v. *Silliman*, 3 Pet. 270, but that case was different. *Parker* v. *Hawk* decides that a State statute of limitation applies to an action for infringement of a patent in the federal court, and is contrary to *Collins* v. *Peebles*, 2 Fisher, 541 (q. v.).

Is cited in *May* v. *Logan County*, 30 F. R. 257, 1887, North. Dist. Ohio, Jackson, J., as a case holding that a State statute of limitation may be interposed as defence in a suit in the federal court for infringement of a patent.

Parker *v.* Sears, 1 Fisher, 96, 1850, East. Dist. Penn., Grier, J.

The opinion of Mr. Justice Grier is quoted in *Bailey Wringing Machine Co.* v. *Adams*, 3 Ban. & A. 97, 1877, West. Dist. Penn., McKennan, J., to the effect that a preliminary injunction will only be granted when the complainant's title and the defendant's infringement are admitted, or so clear and palpable that the court can entertain no doubt on the subject; and the courts are not bound to decide difficult and doubtful questions of law, or disputed questions of fact, at this stage of the case.

Parker *v.* Stiles, 5 McLean, 44, 1849, Dist. Ohio, Leavitt, J.

Is cited in *Whittlesey* v. *Ames*, 13 F. R. 898, 1880, North. Dist. Ill., Blodgett, J.; s. c. 5 Ban. & A. 102, to the effect that identity of invention is necessary to constitute an anticipating machine.

Parkhurst *v.* Kinsman, 1 Blatchf. C. C. 488, 1845, South. Dist. N. Y., Nelson, J.

Is explained in *North Western Fire Extinguisher Co.* v. *Philadelphia Fire Extinguisher Co.*, 1 Ban. &

A. 191, 1874, East. Dist. Penn., McKennan, J., as a case where, the defence of prior invention being set up, the proof showed that the invention was incomplete and imperfect, and had been abandoned as a failure.

"Crude and imperfect experiments equivocal in their results, and then given up for years, cannot be permitted to prevail against an original inventor who has perfected his improvement and obtained his patent." Quoted in *Gottfried* v. *Phillip Best Brewing Co.*, 5 Ban. & A. 32, 1879, East. Dist. Wis., Dyer, J.

Parks *v.* **Booth**, 102 U. S. 96, 1880, Supr. Court, Clifford, J.

Is referred to in *Root* v. *Railway Co.*, 105 U. S. 204, 1881, Supr. Court, Matthews, J., as a case under the act of 1870, when both profit and damages were decreed in a suit in equity. Interest on profits was not allowed on the authority of *Silsby* v. *Foote*, 20 How. 378, as profits are in the nature of unliquidated damages. Counsel fees were stricken out, but compensation for complainant's time lost attending the suit was allowed as damages.

Patterson *v.* **Kentucky**, 97 U. S. 501, 1878, Supr. Court, Harlan, J.

Is cited and explained in *Webber* v. *Virginia*, 103 U. S. 348, 1880, Supr. Court, Field, J., as supporting the doctrine that a patent does not prevent a State from passing laws regulating the condition of the manufacture, storage, and sale of the patented article. The passing of such laws does not interfere with the patent right.

Is cited in *Re Brosnahan*, 18 F. R. 65, 1883, West. Dist. Mo., Miller, J., as supporting the propositions announced in that case, — that a patent does not give the patentee the right to sell an article prohibited by the

State laws, *e. g.*, oleomargarine. The effect of the patent is only to secure the patentee against competition.

Pearce *v.* **Mulford**, 102 U. S. 112, 1880, Supr. Court, Strong, J.

"All improvement is not invention, and entitled to protection as such. Thus to entitle it, it ought to be the product of some exercise of the inventive faculties, and it must involve something more than what is obvious to persons skilled in the art." Quoted in *Packing Co. Cases*, 105 U. S. 571, 1881, Supr. Court., Woods, J.

Pennington *v.* **Hunt**, 20 F. R. 195, 1884, Dist. N. J., Nixon, J.

Is stated and explained briefly in *Brush* v. *Naugatuck R. Co.*, 24 F. R. 373, 1885, Dist. Conn., Shipman, J.

Pennsylvania R. R. *v.* **Locomotive Truck Co.**, 110 U. S. 490, 1883, Supr. Court, Gray, J.

The opinion of Mr. Justice Gray to the point of what constitutes invention, is quoted in *Morris* v. *McMillin*, 112 U. S. 249, 1884, Supr. Court, Woods, J.

The opinion of Mr. Justice Gray: "It is settled by many decisions in this court, 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, even if the new form of result has not before been contemplated." Quoted in *Blake* v. *San Francisco*, 113 U. S. 682, 1884, Supr. Court, Woods, J.; also in *Stephenson* v. *Brooklyn & Crosstown R. R. Co.*, 114 U. S. 154, 1884, Supr. Court, Woods, J.

Is quoted to the same effect in *Howe Machine Co.* v. *National Needle Co.*, 21 F. R. 631, 1884, Dist. Mass., Nelson, J., in which case it was held that the

application of old mechanism for wood turning to the turning of machine needles and awls from metal, was not patentable.

Is followed in *Spill* v. *Celluloid Manuf. Co.*, 21 F. R. 632, 639, 1884, South. Dist. N. Y., Blatchford, J., on the same point 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, even if the new form of result has not before been contemplated.

Is quoted to the same effect in *Miller* v. *Foree*, 116 U. S. 26, 1885, Bradley, J.

Is said in *Goodyear* v. *Hartford Spring Axle Co.*, 23 F. R. 37, 1885, Dist. Conn., Shipman, J., to have established a stricter rule in regard to the patentability of inventions than existed before, taken in connection with the decisions in *Collins Co.* v. *Coes*, 21 F. R. 38, and *Spill* v. *Celluloid Manuf. Co.*, 21 F. R. 631.

The principle stated below, in the quotation in *Niles Tool Works* v. *Betts Machine Co.*, is followed in *Thatcher Heating Co.* v. *Burtis*, 121 U. S. 295, 1886, Supr. Court, Matthews, J.

"The application of an old process or machine to similar or analogous subject, with no change in the manner of applying it, and no result substantially different in its nature, will not support a patent, even if the new form of result has not before been contemplated." Quoted in *Niles Tool Works* v. *Betts Machine Co.*, 27 F. R. 305, 1886, Dist. Del., Wales, J.

Perrigo *v.* **Spaulding**, 13 Blatchf. C. C. 391, 392, 1876, North. Dist. N. Y., Johnson, J.

Is said in *Allis* v. *Stowell*, 16 F. R. 786, 1883, East. Dist. Wis., Dyer, J., to state the rule that when a recovery by a patentee against an infringer is had, for full

profits and damages, the infringer has the right to use the patented machine.

Perry *v.* **Corning**, 6 Blatchf. C. C. 134, 1868, North. Dist. N. Y., Hall, J.

Is cited and stated briefly in *Vaughan* v. *East Tennessee, &c. R. R. Co.*, 2 Ban. & A. 541, 1877, East. Dist. Tenn., Brown, J., as an ordinary bill containing the usual prayers for account and answer, but no special allegations showing the necessity of discovery, nor any prayer for injunction or discovery. The court treated it as a bill for account and discovery, to sustain the jurisdiction.

Phelps *v.* **Comstock**, 4 McLean, 353, 1849, Dist. Ind., McLean, J.

Is said in *Hodge* v. *Hudson River R. R. Co.*, 6 Blatchf. C. C. 89, 1868, South. Dist. N. Y., Blatchford, J., to decide that where a license under a patent was "to the full end of the *term or terms* for which letters-patent are or may be granted," that license covers any subsequent extension of the patent.

Philadelphia & Trenton R. R. Co. *v.* **Stimpson**, 14 Pet. 448, 1840, Supr. Court, Story, J.

Is cited in *Allis* v. *Buckstaff*, 13 F. R. 892, 1882, East. Dist. Wis., Dyer, J., upon the competency of evidence as to anticipating inventions.

Phillips *v.* **Detroit**, 111 U. S. 604, 1883, Supr. Court, Woods, J.

Stated briefly in *Morris* v. *McMillin*, 112 U. S. 249, 1884, Supr. Court, Woods, J., as a case deciding that the patent in suit did not disclose a patentable invention.

Phillips *v.* **Page**, 24 How. 164, 1860, Supr. Court, Nelson, J.

Is distinguished in *Gottfried* v. *Phillip Best Brewing Co.*, 5 Ban. & A. 36, 1879, East. Dist. Wis., Dyer,

J., from the latter case, as in the former case the claim of the patent was merely for the organization of an old machine, and it was held that the mere enlargement did not afford ground for a patent.

Philp *v.* **Nock**, 17 Wall. 460, 1873, Supr. Court, Swayne, J.

The opinion of Mr. Justice Swayne is cited in *Gould's Manuf. Co.* v. *Cowing*, 1 Ban. & A. 382, 1874, North. Dist. N. Y., Hunt, J., to the point that where the patent in suit is for an improvement in a machine, the damages recoverable are generally confined to the profits made by the improvement, not by the whole machine.

"The plaintiff must show his damages by evidence. They must not be left to conjecture by the jury. They must be proved, and not jumped at." Quoted in *Calkins* v. *Bertrand*, 8 F. R. 759, 1881, North. Dist. Ill., Blodgett, J.

Pickering *v.* **McCullough**, 104 U. S. 310, 1881, Supr. Court, Matthews, J.

The opinion of Mr. Justice Matthews in the above case is quoted from in *Bradley, &c. Manuf. Co.* v. *Charles Parker Co.*, 17 F. R. 242, 1883, Dist. Conn., Shipman, J., to the same effect as in the quotation given below as to the necessity of the co-operation of old elements, in order to produce a patentable novelty. In the latter case, the combination included a set screw to hold a lamp-shade to the lamp-holder.

The principles of this case were applied in *Mosler Safe & Lock Co.* v. *Mosler*, 22 F. R. 905, 1885, South. Dist. Ohio, Sage, J.

"In a patentable combination of old elements, all the constituents must so enter into it that each qualifies every other; to draw an illustration from another branch of the law, they must be joint tenants of the domain of the invention seized each of every part, — *per my et per*

tout, — and not mere tenants in common, with separate interests and estates. It must form either a new machine of a distinct character and function, or produce a result due to the joint and co-operative action of all the elements, and which is not a mere adding together of separate contributions; otherwise it is only a mechanical juxtaposition, and not a vital union." Quoted in *Peard* v. *Johnson*, 23 F. R. 509, South. Dist. N. Y. 1885, Coxe, J., as describing with remarkable perspicuity the essential requirements of a valid combination.

Quoted in *Scott Manuf. Co.* v. *Sayre*, 26 F. R. 155, 1885, Dist. N. J., Nixon, J., upon the question of patentability of a combination.

Pitts *v.* **Edmonds**, 2 Fisher, 57, 1857, East. Dist. Mich., McLean, J.

The opinion of McLean, J., is quoted in *Odiorne* v. *Denney*, 3 Ban. & A. 290, 1878, Dist. N. J., Nixon, J., to the effect that a patent covers all mechanical equivalents or modes which operate on the same principles.

Pitts *v.* **Hall**, 2 Blatchf. C. C., 229, 1851, North Dist. N. Y., Nelson, J.

Is cited in *Bevin* v. *East Hampton Bell Co.*, 9 Blatchf. C. C. 62, 1871, Dist. Conn., Shipman, J., upon the question of abandonment.

Is quoted as to forfeiture of right to invention by sale or public use by patentee for two years before application for a patent, in *Consolidated Fruit Jar Co.* v. *Wright*, 94 U. S. 94, 1876, Supr. Court, Swayne, J.

Governs the decision of *Celluloid Manuf. Co.* v. *American Zylonite Co.*, 26 F. R. 698, 1886, South. Dist. N. Y., Shipman, J.

Pitts *v.* **Hall**, 3 Blatchf. C. C. 201, 1854, North. Dist. N. Y., Hall, J.

Is said in *Hodge* v. *Hudson River R. R. Co.*, 6 Blatchf. C. C. 89, 1868, South. Dist. N. Y., Blatch-

ford, J., to decide what language will convey an extension of a patent to an assignee.

Interpreted in *Dunham* v. *Indianapolis, &c. R. R. Co.*, 2 Ban. & A. 329, 1876, North. Dist. Ill., Drummond, J., as deciding that if one joint owner of a patent sells or uses his right without the authority of his co-owner, he is liable to an action by such co-owner for an infringement of the patent; and it is said in *Dunham* v. *Indianapolis, &c. R. R. Co.* that perhaps the conclusion might be drawn from the decision, that if the party to whom he sells uses the thing patented, an action could be maintained and an injunction granted against the grantee or licensee of the co-owner; but see *Clum* v. *Brewer*, 2 Curtis, 506.

Is distinguished in case of *Herring* v. *Gas Consumers' Association*, 9 F. R. 557, 1878, East. Dist. Mo., Treat, J.; s. c. 3 Ban. & A. 254, the former case raising the question whether one joint owner of a patent may sue another joint owner for use of the common patent; the latter case deciding that one joint owner may sue another for using an infringing device, and expressing no opinion upon the other question.

Pitts *v.* Whitman, 2 Story, 609, 1843, Dist. Maine, Story, J.

The opinion of the court in this case is said in *Perry* v. *Corning*, 7 Blatchf. C. C. 201, 1870, North. Dist. N. Y., Woodruff, J., to hold, that although an unrecorded assignment is not void, yet no suit can be maintained against a third person by virtue of it unless recorded before or pending suit.

Planing Machine Co. *v.* Keith, 101 U. S. 479, 1879, Supr. Court, Strong, J.

Is said in *Allis* v. *Buckstaff*, 13 F. R. 884, 1882, East. Dist. Wis., Dyer, J., to overrule the case of *Richardson* v. *Lockwood*, 6 Fisher, 454, and to establish the rule that the defendant who sets up in his

defence an alleged prior use or knowledge, need not allege in his answer the names of those by whom he expects to prove prior use, but only of those who had invented or used the anticipating machine.

Is cited in *Consolidated Fruit Jar Co.* v. *Bellaire Stamping Co.*, 27 F. R. 382, 1886, South. Dist. Ohio, Sage, J., upon the question what facts amount to an abandonment of an invention after rejected application and before renewed application.

Pomeroy *v.* **New York & N. H. R. R. Co.**, 4 Blatchf. C. C. 120, 1857, South. Dist. N. Y., Nelson, J.

Cited in *Williams* v. *Empire Transportation Co.*, 3 Ban. & A. 536, 1878, Dist. N. J., Nixon, J., as deciding that a corporation organized in Connecticut cannot be found in New York so as to be served with process in a federal court, although the New York State Legislature, in authorizing the corporation to purchase lands, to enter into contracts and to enter its road into the State, had expressly provided that the company should be liable to be sued by summons in the same manner as corporations created by the law of the State, and that process might be served on an officer or agent of the company. The difficulty was that a State law would not modify the act of Congress. See now Schollenberger *Ex Parte*, 96 U. S. 377, and Stat. 1886–87, c. 373.

Williams v. *Empire Transportation Co.* holds that a corporation which transacts business in a State other than that of its incorporation, upon the condition of rendering itself liable to service upon its agent, waives the question of the legality of the service, and is found in that State for purposes of suit in a federal court.

Potter *v.* **Holland**, 4 Blatchf. C. C. 206, 1858, Dist. Conn., Ingersoll, J.; s. c. 1 Fisher, 333.

Is followed in *Potter* v. *Braunsdorf*, 7 Blatchf. C. C. 109, 1869, South. Dist. N. Y., Blatchford, J., on the

point that it is not in the power of the patentee by surrender to injure the right to third persons holding under him.

"An assignee is one who had transferred to him in writing the whole interest of the original patent or an undivided part of such whole interest in every part of the United States; and no one, unless he has such an interest transferred to him, is an assignee. A grantee is 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." Quoted with approval in *Meyer* v. *Bailey*, 2 Ban. & A. 77, 1875, West. Dist. Penn., McKennan, J.

Cited in *Nelson* v. *McMann*, 4 Ban. & A. 211, 1879, South. Dist. N. Y., Blatchford, J., as agreeing with the principles of *Gaylor* v. *Wilder*, 10 How. 477, as to the point that an assignment, in order to allow the assignee to sue in his own name, must be exclusive within the territory it covers, even of the patentee himself.

Potter *v.* **Schenck**, 1 Biss. 515, 1866, North. Dist. Ill., Drummond, J.

Is quoted from at some length in *Adams* v. *Joliet Manuf. Co.*, 3 Ban. & A. 5, 1877, North. Dist. Ill., Blodgett, J., to the point that a change of location of any part in a combination, when there is no new function performed by this change made in its new location, will not evade a patent.

This case is examined in *Tucker* v. *Dana*, 7 F. R. 214, 1881, Dist. Mass., Lowell, J., and the former case is said to have been carefully distinguished in this decision from *Goodyear Cases*. Lowell, J., says: "I may fail to see the difference between the *Goodyear Cases*, but I must accept the decision that there is a

difference, and must apply the law accordingly as well as I can."

Powder Co. *v.* **Powder Works**, 98 U. S. 126, 1878, Supr. Court, Bradley, J.

"By new matter we suppose to be meant new substantive matter, such as would have the effect of changing the invention, or of introducing what might be the subject of another application for a patent." Quoted in *Siebert Cylinder, &c. Co.* v. *Harper Lubricator Co.*, 4 F. R. 333, 1880, Dist. Conn., Shipman, J., upon the question of what constitutes such new matter as will invalidate a reissue.

"A specification may be amended so as to make it more clear and distinct, a claim may be modified so as to make it more conformable with the exact rights of the patentee, but the invention must be the same. So particular is the law on this subject, that it is declared no new matter shall be introduced into the specification." Quoted in *Washburn, &c. Manuf. Co.* v. *Haish*, 4 F. R. 910, 1880, North. Dist. Ill., Drummond, J.

Is also quoted in *Flower* v. *Rayner*, 5 F. R. 799, 1881, Dist. N. J., Nixon, J.

This case is cited in *Yale Lock Manuf. Co.* v. *Scovill Manuf. Co.*, 5 Ban. & A. 525, 1880, Dist. Conn. Shipman, J., as construing § 4916, U. S. R. S., to decide that a reissue can only be granted for the same invention which formed the subject of the original patent of which it is a reissue. This does not exclude amendments of the specifications to make it more clear and definite, or modifications of the claim to make it more conformable to the exact rights of the patentee, but does exclude amendments covering improvements which have come into use or have been invented by others after the issue of the original patent.

Is cited in *Wilson* v. *Coon*, 6 F. R. 621, 1880, South. Dist. N. Y., Blatchford, J., upon the question of reissues, as deciding that where the original patent is for processes, and the reissue is for compounds which are not the result of the processes, the reissue is invalid.

A patent for a process and a patent for an implement or machine are very different things. Cited to this effect in *James* v. *Campbell*, 104 U. S. 377, 1881, Supr. Court, Bradley, J.

Lays down the rule for deciding whether a reissue describes the same invention as the original patent. It is for the court on inspection of the patents. *Heald* v. *Rice*, 104 U. S. 749, 1881, Supr. Court, Matthews, J.

"The legislature was willing to concede to the patentee the right to amend his specification (in his reissue) so as fully to describe and claim the very invention attempted to be secured by his original patent, and which was not fully secured thereby in consequence of inadvertence, accident, or mistake, but was not willing to give him the right to patch up his patent by the addition of other inventions which, although they might be his, had not been applied for by him, or, if applied for, had been abandoned or waived." Quoted in *Atwater Manuf. Co.* v. *Beecher Manuf. Co.*, 8 F. R. 609, 1881, Dist. Conn., Shipman, J.

Is said in *Averill Chemical Paint Co.* v. *National Mixed Paint Co.*, 9 F. R. 464, 1881, South. Dist. N. Y., Wheeler, J., to have decided that § 4916, U. S. R. S., authorizing amendments of patents upon proof, in the absence of any drawing or model, did not authorize the commissioner to grant a reissue for a different invention, or to determine that one invention was the same as another or a different one, or that two inventions essentially different constituted but one. That

decision left open the question whether that clause related to all patents, or only to patents for machines; but no room was left for adding to the invention by proof.

Is stated at length in *Kells* v. *McKenzie*, 9 F. R. 287, 1881, East. Dist. Mich., Brown, J., as authority strictly limiting the right of reissues to the invention secured by the original patent.

Explained in *Wing* v. *Anthony*, 106 U. S. 146, 1882, Supr. Court, Woods, J., as deciding that when original letters-patent are for a process, the reissue cannot cover a composition, unless it is the result of the process, and the invention of one involved the invention of the other.

Is said in *Parker, &c. Co.* v. *Yale Lock Co.*, 18 F. R. 45, 1883, Dist. Conn., Shipman, J., to have defined the phrase "new matter" as applied to a reissue; and the opinion of the court is quoted to the effect that the reissue cannot contain other inventions not included in the original patent.

This case is construed in *Atlantic Giant Powder Co.* v. *Hulings*, 21 F. R. 521, 1884, West. Dist. Penn., Acheson, J., to have decided that although the claim of the patent in technical form might appear to be for the use of nitro-glycerine as an exploding agent, yet upon the proper construction it was limited to the methods or processes of exploding substances described in the specifications.

Governed the decision in *Eachus* v. *Broomall*, 115 U. S. 438, 1885, Supr. Court, Matthews, J.

Prouty *v.* **Ruggles**, 16 Pet. 341, 1842, Supr. Court, Taney, C. J.

Is explained in *Eames* v. *Godfrey*, 1 Wall. 79, 1863, Supr. Court, Davis, J., to the effect that the patent in that case was for the combination of certain parts of a

plough arranged together so as to produce a certain effect. The suit was for an infringement, and the court below charged the jury that unless the whole combination was substantially used in the defendant's machine, there was no violation of the plaintiff's patent. Taney, C. J., said, in the Supreme Court, "None of the parts referred to are new, and none are claimed as new, nor is any portion of the combination less than the whole claimed as new, or stated to produce any given result. The end in view is proposed to be accomplished by the union of all, arranged and combined together in the manner described. The use of any two of these parts only, or of two combined with a third, which is substantially different in form or in the manner of its arrangement and connection with the others, is not the thing patented. It is not the same combination if it substantially differs from it in any of its parts."

Is said in *Mabie* v. *Haskell*, 2 Cliff. 511, 1865, Dist. Mass., Clifford, J., to decide that where an invention consists merely of a combination of elements all of which are old, a party is not guilty of infringement who uses only a part of those elements.

It is said in *Wells* v. *Jacques*, 1 Ban. & A. 67, 1874, Dist. N. J., Nixon, J., that it is fairly to be inferred from the language of Taney, C. J., in *Prouty* v. *Ruggles*, that the difficulty of the plaintiffs in that case arose from not patenting different parts of the combination of old elements forming the new machine, so as to hold infringers who used only combinations of one or two elements, and not all.

Is said in *Holly* v. *Vergennes Machine Co.*, 4 F. R. 81, 1880, Dist. Vt., Wheeler, J., to hold that a patent for a combination of several parts to accomplish a result is not infringed by a combination of a less number of the same parts alone, or with others substantially different, to produce the same result.

This case is stated, in *Rowell* v. *Lindsay*, 6 F. R. 300, 1881, East. Dist. Wis., Dyer, J., to have considerable similarity as to the application of principles to the latter case, and the language of the court is adopted and quoted at length.

Is cited in *McMurray* v. *Mallory*, 111 U. S. 103, 1883, Supr. Court, Woods, J., to the effect that if a patent is for a combination of three parts, the use of any two, or of two in combination with a different third, is not infringement.

The opinion in this case is quoted from at length in *Rowell* v. *Lindsay*, 113 U. S. 102, 1884, Supr. Court, Woods, J., to the effect that if a patent is for a combination of old materials or devices, a use of a portion of these is not an infringement.

Putnam *v.* **Tinkham**, 4 F. R. 411, 1880, Dist. Conn., Shipman, J.

The opinion of the court in this case is quoted from at length in *Edgarton* v. *Furst & Bradley Manuf. Co.*, 9 F. R. 454, 1881, North. Dist. Ill., Blodgett, J., to the effect that a reissue is void if it is on its face for a different invention from th' which was embraced in the original patent.

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Railroad Co. *v.* **Dubois**, 12 Wall. 47, 1870, Supr. Court, Strong, J.

Is said in *La Baw* v. *Hawkins*, 1 Ban. & A. 432, 1874, Dist. N. J., Nixon, J., to decide that the novelty of a patented invention cannot be assailed by any other evidence than that of which plaintiff has received notice, and that the state of the art at the time of the alleged invention, though proper to be considered by the court

in construing the patent, in the absence of notice has no legitimate bearing upon the question whether the patentee was the first inventor.

Railroad Co. *v.* **Harris**, 12 Wall. 65, 1870, Supr. Court, Swayne, J.

Is cited in *Wilson* v. *Hunter*, 4 Ban. & A. 186, 1879, South. Dist. Ill., Drummond, J., as deciding the latter case, the court holding that the Illinois statute (Revised Statutes, c. 32, § 26) subjecting foreign corporations doing business in that State to restrictions imposed upon corporations of like character of that State, subjects foreign corporations doing business in that State to liability to suit in the courts of the United States in the district where such corporations are doing business, and that they are then found in that district, under act of Congress. But see *Schollenberger, Ex Parte*, 96 U. S. 374.

Railroad Co. *v.* **Mellon**, 104 U. S. 112, 118, 1881, Supr. Court, Woods, J.

Is distinguished in *La Rue* v. *Western, &c. Co.*, 28 F. R. 88, 1886, South. Dist. N. Y., Brown, J., from the latter case.

Railroad Co. *v.* **Stimpson**, 14 Pet. 448, 1840, Supr. Court, Story, J.

Is cited in *Thomas* v. *Shoe Machine Manuf. Co.*, 3 Ban. & A. 559, 1878, Dist. Mass., Clifford, J., as the case which changed the rule as to reissues; the rule now being that the granting a reissued patent closes all inquiry as to inadvertence, accident, or mistake, and leaves only the question of fraud for a jury.

Railroad Co. *v.* **Trimble**, 10 Wall. 367, 1870, Supr. Court, Swayne, J.

Is explained in *Nicolson Pavement Co.* v. *Jenkins*, 14 Wall. 457, 1871, Supr. Court, Davis, J., as being the

same in principle with the latter case, although the language of the court in the former case is somewhat broader as to the effect of an assignment of an invention and patent "to the full end of the term for which said letters-patent are or may be granted," it being held to cover a renewal as well as a reissue.

Is cited in *Campbell* v. *James*, 5 Ban. & A. 366, 1880, South. Dist. N. Y., Wheeler, J., upon the question what words in an assignment are broad enough to convey a patent right.

This case is briefly stated in *Fire Extinguisher Manuf. Co.* v. *Graham*, 16 F. R. 554, 1883, West. Dist. Va., Hughes, J., to the effect that an assignment of a patent carries the extended patent, if proper words to that effect are used.

Railway Co. *v.* **Sayles**, 97 U. S. 554, 1878, Supr. Court, Bradley, J.

The opinion of Mr. Justice Bradley in this case, in regard to the enlargement of an application by a subsequent amended application, is quoted in *Eagleton Manuf. Co.* v. *West, &c. Manuf. Co.*, 5 Ban. & A. 481, 1880, South. Dist. N. Y., Wheeler, J.

Is cited in *Yale Lock Manuf. Co.* v. *Scovill Manuf. Co.*, 5 Ban. & A. 527, 1880, Dist. Conn., Shipman, J., to the effect that courts should regard with jealousy and disfavor any attempt to enlarge the scope of an application once filed or a patent once granted, the effect of which would be to enable the patentee to appropriate other inventions made prior to such alterations.

It is said in *Flower* v. *Rayner*, 5 F. R. 798, 1880, Dist. N. J., Nixon, J., that courts, acting upon the caution of Mr. Justice Bradley in the former case, are more and more inclined to regard with jealousy and disfavor any attempt to enlarge the scope of an application once filed, or of a patent once granted, the effect of

which would be to enable the patentee to appropriate other inventions made prior to such alterations, or to appropriate that which has in the mean time gone into public use.

Is cited in *Morley Sewing Machine Co.* v. *Lancaster*, 23 F. R. 346, 1885, Dist. Mass., Colt, J., to the effect that a primary patent is more liberally construed than a secondary, and puts all subsequent patents under tribute.

The language of Mr. Justice Bradley to the effect that the court will not allow anything new to be incorporated into the original specification by an amended application and model filed several years later, any more than it would permit the enlargement of an original specification by a reissue, is quoted in *Kittle* v. *Hall*, 29 F. R. 511, 1887, South. Dist. N. Y., Coxe, J.

Read *v.* **Miller**, 3 Fisher, 310, 1867, Dist. Ind., McDonald, J.; s. c. 2 Biss. 12.

Is referred to in *Anthony* v. *Carroll*, 2 Ban. & A. 197, 1875, Dist. Mass., Shepley, J., as deciding that no limit existed in the law at that time for bringing suits for the infringement of patents in the federal courts, the State statutes of limitations having no force in federal courts. See *Collins* v. *Peebles*.

Reckendorfer *v.* **Faber**, 92 U. S. 347, 1876, Supr. Court, Hunt, J.

The principle of this case is approved in *Herring* v. *Nelson*, 3 Ban. & A. 61, 1877, North. Dist. N. Y., Johnson, J.

This case is said in *Williams* v. *Rome, &c. R. R. Co.*, 3 Ban. & A. 422, 1878, North. Dist. N. Y., Blatchford, J., to affirm and apply the doctrine of *Hailes* v. *Van Wormer*, 20 Wall. 353 (q. v.).

This case is quoted in *Perfection Window Cleaner Co.* v. *Bosley*, 5 Ban. & A. 451, 1880, North. Dist. Ill., Dyer, J., to the effect that mechanical skill is one thing,

invention is a different thing. Perfection of workmanship, however much it may increase convenience, extend use, or diminish expense, is not patentable.

The language of Mr. Justice Hunt to the effect that a combination to be patentable must produce a different force, effect, or result in the combined process or processes from that given by the separate parts, is quoted with approval in *Pickering* v. *McCullough*, 104 U. S. 318, 1881, Supr. Court, Matthews, J.

Quoted to the same effect in *Sawyer* v. *Miller*, 12 F. R. 727, 1882, South. Dist. Ga., Pardee, J.

The principles of this case were applied in *Mosler Safe & Lock Co.* v. *Mosler*, 22 F. R. 905, 1885, South. Dist. Ohio, Sage, J.

Is cited in *Peard* v. *Johnson*, 23 F. R. 510, 1885, South. Dist. N. Y., Coxe, J., upon the question of what combination of old elements is patentable.

Quoted to the same effect in *Scott Manuf. Co.* v. *Sayre*, 26 F. R. 155, 1885, Dist. N. J., Nixon, J.

Reed *v.* Cutter, 1 Story, 590, 1841, Dist. Mass., Story, J.

"He who invents first shall have the prior right if he is using reasonable diligence in adapting 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." Story, J., in this quotation, is said in *Hubel* v. *Dick*, 28 F. R. 139, 1886, South. Dist. N. Y., Shipman, J., to have announced the fundamental principle in regard to priority as between two independent inventors.

Reeves *v.* Keystone Bridge Co., 1 O. G. 466.

"The patentee whose patent is assailed on the ground of want of novelty may show by sketches and drawings the date of his inceptive invention, and if he has exercised reasonable diligence in perfecting it and adapting it, and in applying for a patent, his protection will be

carried back to such date." Quoted in *Kneeland* v. *Sheriff*, 5 Ban. & A. 483, 1880, West. Dist. Penn., McKennan, J.

Is said in *Paillard* v. *Bruno*, 29 F. R. 865, 1886, South. Dist. N. Y., Wallace, J., to adopt the reasoning in *Henry* v. *Providence Tool Co.*, 3 Ban. & A. 501, and to decide that in a case where the original term of the foreign patent has been extended subsequently to the grant of the United States patent, this extension does not prolong the term of the United States patent; but the latter expires under § 4887, U. S. R. S., at the end of the original term of the foreign patent.

Reissner *v.* **Sharpe**, 16 Blatchf. C. C. 383, 1879, South. Dist. N. Y., Blatchford, J.

Is said in *Bate Refrigerating Co.* v. *Gillett*, 13 F. R. 558, 1882, Dist. N. J., Nixon, J., to have followed the construction of § 4887, U. S. R. S., adopted in *Henry* v. *Providence Tool Co.*, 14 O. G. 855 (q. v.).

Rice *v.* **Heald**, 13 Pacific L. R. 34, 1877, Dist. Cal., Sawyer, J.

Is cited in *Gottfried* v. *Phillip Best Brewing Co.*, 5 Ban. & A. 34, 1879, East. Dist. Wis., Dyer, J., to the effect that a prior machine which will not produce substantially the same results as the subsequent machine, without altering its construction, cannot be an anticipation of the subsequent machine, no matter how strongly the prior machine may resemble the subsequent machine in its construction.

Rich *v.* **Close**, 4 Fisher, 282, 1870, North. Dist. N. Y., Woodruff, J.

The language of Judge Woodruff in this case to the effect that an inventor be limited in the construction of his patent by what he has claimed, is quoted in *Rowell* v. *Lindsay*, 6 F. R. 293, 1881, East. Dist. Wis., Dyer, J.

Rich *v.* **Ricketts**, 7 Blatchf. C. C. 230, 1870, North. Dist. N. Y., Hall, J.

Is cited in *May* v. *Logan County*, 30 F. R. 257, 1887, North. Dist. Ohio, Jackson, J., as a case holding that a State statute of limitation may be interposed as a defence in a suit in the federal court for infringement of a patent. See *Collins* v. *Peebles*.

Richardson *v.* **Lockwood**, 6 Fisher, 454, 1873, Dist. Mass., Lowell, J.

Is said in *Allis* v. *Buckstaff*, 13 F. R. 884, 1882, East. Dist. Wis., Dyer, J., to have intimated that the names of the witnesses by whom the defendants expect to prove prior use as a defence, should be stated in the answer; but that this case is overruled by *Roemer* v. *Simon*, 95 U. S. 219, and *Planing Machine Co.* v. *Keith*, 101 U. S. 479, which hold that only the names of those who invented or used the machine need be stated in the answer, and not the names of the witnesses.

Richardson *v.* **Noyes**, 10 O. G. 507, 1876, Dist. Mass., Lowell, J. See *Wallace* v. *Holmes*.

Robbins *v.* **Chicago**, 4 Wall. 657, 1866, Supr. Court, Clifford, J.

Is quoted in *American Bell Telephone Co.* v. *National Improved Telephone Co.*, 27 F. R. 665, 1886, East. Dist. La., by the court, as to the conclusiveness of the judgment respecting the same cause of action and between the same parties.

Roberts *v.* **Buck**, 6 Fisher, 325, 1873, Dist. Mass., Shepley, J.

Is cited in *Allis* v. *Buckstaff*, 13 F. R. 884, 1882, East. Dist. Wis., Dyer, J., as to the inadmissibility of evidence in defence as to anticipation not set up in the answer, if objected to.

Roberts *v.* **Harnden**, 2 Cliff. 500, 1865, Dist. Mass., Clifford, J.

Was decided in favor of the complainants; but *Roberts* v. *Ryer*, 91 U. S. 159, 1875, Supr. Court, Waite, C. J., a suit on the same patent (to D. W. C. Sanford for an improvement in refrigerators), was decided by the Supreme Court in favor of defendants, affirming the decision of the circuit court of the southern district of New York on the ground of prior invention by another than the patentee.

Roberts v. *Buck*, 91 U. S. 159, note, 1875, Supr. Court, Waite, C. J., also follows *Roberts* v. *Ryer*.

Roberts *v.* **Reed Torpedo Co.**, 3 Fisher, 629, 1869, East. Dist. Penn., Grier, J.

Is explained in *North Western Fire Extinguisher Co.* v. *Philadelphia Fire Extinguisher Co.*, 1 Ban. & A. 191, 1874, East. Dist. Penn., McKennan, J.

Roberts *v.* **Ryer**, 91 U. S. 157, 1875, Supr. Court, Waite, C. J.

"It is no new invention to use an old machine for a new purpose. The inventor of the machine is entitled to the benefit of all the uses to which it can be put, no matter whether he conceived the idea of the use or not." Quoted in *Gottfried* v. *Phillip Best Brewing Co.*, 5 Ban. & A. 33, 1879, East. Dist. Wis., Dyer, J.

Quoted to the same effect in *Gottfried* v. *Crescent Brewing Co.*, 9 F. R. 766, 1881, Dist. Ind., Gresham, J.

Said in *Cottier* v. *Stimson*, 20 F. R. 909, 1884, Dist. Or., Deady, J., to hold that it is no new invention to use an old machine for a new purpose.

Quoted to the same effect in *New Process Fermentation Co.* v. *Koch*, 21 F. R. 582, 1884, East. Dist., Mich. Brown, J.

Robinson *v.* **Randolph**, 4 Ban. & A. 163, 1879, Dist. N. J., Nixon, J.

Is said in *Cary* v. *Lovell Manuf. Co.*, 24 F. R. 143, 1885, West. Dist. Penn., Acheson, J., to be, like the latter case, one in which, on motion, the court declined to listen to affidavits alleging a new defence.

Roemer *v.* **Simon**, 95 U. S. 214, 1877, Supr. Court, Clifford, J.

Is said in *Planing Machine Co.* v. *Keith*, 101 U. S. 493, 1879, Supr. Court, Strong, J., to settle the question that only the names of those who invented or used an anticipating machine need be pleaded under the statute, and not those who will prove such prior use.

Is cited in *Loom Co.* v. *Higgins*, 105 U. S. 596, 1881, Supr. Court, Bradley, J., as deciding that a failure to object, before the final hearing, to the defence of prior invention or use, on account of lack of notice of the names and residences of the prior users or inventors, waives such defect.

Is said in *Allis* v. *Buckstaff*, 13 F. R. 884, 1882, East. Dist. Wis., Dyer, J., to overrule the case of *Richardson* v. *Lockwood*, 6 Fisher, 454, and to establish the rule that when the defendant sets up the defence of prior use or invention, he need not in his answer set forth the names of the witnesses by whom he expects to prove prior use, but only the names of those who had invented or used the anticipating machine.

Rogers *v.* **Sargent**, 7 Blatchf. C. C. 507, 1870, South. Dist. N. Y., Blatchford, J.

This case was urged upon the court in the *Double Pointed Tack Co.* v. *Mann*, 5 Ban. & A. 473, 1880, East. Dist. Wis., Dyer, J., as a case where the invention was merely a corrugated staple, the mere use of a piece of corrugated wire such as every one had seen long before,

but which when bent into a staple produced a particular and novel effect; but the court in the latter case considered the case of *Rogers* v. *Sargent* at length, and held that the patent was sustained, for the reason that the corrugations were, under the patentee's claim, made by the use of dies, thus enabling the article to be constructed by machinery so that it could become a new article of manufacture.

Root *v.* Lake Shore & Michigan Southern Railway Co., 105 U. S. 189, 1881, Supr. Court, Matthews, J.

The rule of that case is relied on in *Hayward* v. *Andrews*, 106 U. S. 675, 1882, Supr. Court, Matthews, J.

"A bill in equity for a naked account of profits and damages against an infringer of a patent cannot be sustained. Such relief, ordinarily, is incidental to some other equity, the right to enforce which secures to the patentee his standing in court. The most general ground for equitable interference is to insure to the patentee the enjoyment of his specific right by an injunction against the continuance of the infringement; but grounds of equitable relief may arise, other than by injunction, as where the title of the complainant is equitable merely, or equitable interposition is necessary on account of the impediments which prevent the resort to remedies purely legal. Such an equity may arise out of and inhere in the nature of the account itself, springing from special and peculiar circumstances, which disable the patentee from recovery at law altogether, or render his remedy in a legal tribunal difficult, inadequate, and incomplete. As such cases cannot be defined more exactly, each must rest upon its own peculiar circumstances as furnishing a clear and satisfactory ground of exception from the general rule." Quoted in *Campbell* v. *Ward*, 12 F. R. 151, 1882, Dist. N. J., Nixon, J.

Is cited in *Davis* v. *Smith*, 19 F. R. 823, 1884, Dist. Mass., Lowell, J., as governing the decision in the latter case.

It is said in *New York Grape Sugar Co.* v. *Peoria Grape Sugar Co.*, 21 F. R. 879, 1884, North. Dist. Ill., Blodgett, J., that since the decision in the former case that equity has no jurisdiction in a suit upon an expired patent, when the only relief sought is accounting for profits and damages, the decisions at the circuit have not been uniform as to such jurisdiction, in cases where a patent expires after the commencement of the suit and before decree.

It is said in *Smith* v. *Sands*, 24 F. R. 472, 1885, West. Dist. Mich., Withey, J., that the former case reviews the patent laws and the decisions under them, showing when the remedy is in equity, and when the sole remedy is in the court of laws, for the infringement of a patent.

Is interpreted in *Crandall* v. *Plano Manuf. Co.*, 24 F. R. 739, 1885, North. Dist. Ill., Blodgett, J., as proceeding upon the ground that patentees have an adequate remedy at law in suits against infringers, except in cases where there is a right to an injunction as part of the relief sought; but that in all cases where the only question is as to the amount of profits and damages, and the complainant is not entitled to an injunction, the remedy is at law.

This case is briefly stated; and the statement that an equity giving a federal court jurisdiction in a patent case may arise out of the nature of the account itself, is said, in *Lord* v. *Whitehead, &c. Machine Co.*, 24 F. R. 803, 1885, Dist. Mass., Colt, J., not to mean that a federal court will take jurisdiction in equity merely because of the intricacy of an account which is designed to embrace compensation for numerous tortious acts.

Is said in *Clark* v. *Wooster*, 119 U. S. 325, 1886, Supr. Court, Bradley, J., to contain nothing contrary to the proposition that where the case made by the bill in a patent cause was for equitable relief when the suit was instituted, the mere fact that the ground for such relief expired by the expiration of the patent would not take away the jurisdiction and preclude the court from proceeding to grant the incidental relief which belongs to that class of cases.

Is said in *Beedle* v. *Bennett*, 122 U. S. 75, 1886, Supr. Court, Matthews, J., not to present any objection to jurisdiction in a case where the patent is in force at the time the bill is filed, and expires before final decree.

Governed the decision in the *Consolidated Safety Valve Co.* v. *Ashton Valve Co.*, 26 F. R. 319, 1886, Dist. Mass., Colt, J.

It is said in *Racine Seeder Co.* v. *Joliet Wire Check Rower Co.*, 27 F. R. 368, 1886, North. Dist. Ill., Blodgett, J., that the decision in *Root* v. *Railway Co.* rendered the jurisdiction of the court, in *Racine Seeder Co.* v. *Joliet Wire Check Rower Co.*, doubtful; the bill in the latter case being filed about two months before the expiration of the patent, the court dismissed the bill without prejudice to a suit at law.

Is said in *Consolidated M. Purifier Co.* v. *Wolf*, 28 F. R. 816, 1886, East. Dist. Penn., Bradley, J., to have decided, after much consideration, that a suit merely for an account of gains, profits, and savings on a license, cannot be maintained in equity; there must be some equitable ground for relief in addition to a mere demand for account.

The principles of this case are applied in *Kittle* v. *Hall*, 29 F. R. 511, 1887, South. Dist. N. Y., Coxe, J.

Is distinguished in *Rogers* v. *Riessner*, 30 F. R. 530, 1887, South. Dist. N. Y., Wheeler, J.

Rowell *v.* **Lindsay**, 113 U. S. 97, 1884, Supr. Court, Woods, J.

Is cited and explained in *La Rue* v. *Western, &c. Co.*, 28 F. R. 90, 1886, South. Dist. N. Y., Brown, J.

Rubber Co. *v.* **Goodyear**, 6 Wall. 153, 1867, Supr. Court, Chase, C. J.

Is said in *American Nicholson Pavement Co.* v. *Elizabeth*, 1 Ban. & A. 468, 1874, Dist. N. J., Nixon, J., not to be an authority for the allowance by the court of a bond given by the defendants on final decree without sureties.

Rubber Co. *v.* **Goodyear**, 9 Wall. 788, 1869, Supr. Court, Swayne, J.

The opinion of the Supreme Court in this case was followed as conclusive, to the effect that the decision of the commissioner of patents as to the validity of an extension is conclusive in a suit for infringement in *American Wood Paper Co.* v. *Glen Falls Paper Co.*, 8 Blatchf. C. C. 515, 1870, North. Dist. N. Y., Woodruff, J.

Was urged by counsel for complainants in *American Nicholson Pavement Co.* v. *Elizabeth*, 1 Ban. & A. 459, 1874, Dist. N. J., Nixon, J., as a case deciding that in estimating profits, nothing should be allowed to the infringers for personal services, but is said by Nixon, J., to decide just the contrary; that is, to allow usual salaries of managing officers, but to disallow extraordinary salaries, which are in reality disguised dividends.

The course pursued in this case, where the inventor first patented the process and afterwards surrendered the letters-patent and took his reissue in two several patents, one for the product and the other for the process of the product, is approved in *McKay* v. *Dibert*, 5 F. R. 590, 1880, Dist. N. J., Nixon, J.

Is stated in *Root* v. *Railway Co.*, 105 U. S. 197, 1881, Supr. Court, Matthews, J., as affirming the rule that an infringer of a patent must account for his actual profits only, not for what he might possibly by diligence have made.

It is cited in *National Manuf. Co.* v. *Meyers*, 7 F. R. 357, 1881, South. Dist. Ohio, Swing, J., as a case where the defence of invalidity of plaintiff's patent and a license under that patent were both set up in the defendant's answer, without objection either in the circuit or Supreme Court, thereby showing that those defences were not regarded by the complainant's counsel as inconsistent.

Is said in *Railway Register Manuf. Co.* v. *North Hudson C. R. Co.*, 23 F. R. 594, 1885, Dist. N. J., Nixon, J., to have held that Congress did not mean a patent to be abrogated collaterally, but left the remedy in such a case to be regulated by principles of general jurisprudence.

Rubber Tip Pencil Co. *v.* **Howard**, 20 Wall. 498, 1872, South. Dist. N. Y., Benedict, J.

Decides whether a new article of manufacture is a patentable invention. Cited in *Reckendorfer* v. *Faber*, 92 U. S. 353, 1875, Supr. Court, Hunt, J., to show that the question of patentability is open to the court, and not conclusively settled by the commissioner of patents.

Ruggles *v.* **Eddy**, 11 Blatchf. C. C. 524, 1874, North. Dist. N. Y., Woodruff, J.

Is said in *De Florez* v. *Raynolds*, 4 Ban. & A. 340, 1879, South. Dist. N. Y., Blatchford, J., to be a case where an application to be allowed to amend an answer on the ground of the incompetency of the defendant's counsel, by whom the answer had been filed, was not allowed.

Russell *v.* **Dodge**, 93 U. S. 460, 1876, Supr. Court, Field, J.

Said to be similar in general principles to *Russell* v. *Place*, 94 U. S. 606, 1876, Supr. Court, Field, J.

Is said in *Herring* v. *Nelson*, 3 Ban. & A. 66, 1877, North. Dist. N. Y., Johnson, J., to decide only the point that the alleged inventions contained in the original and reissued patents were unpatentable for lack of novelty.

The opinion of Mr. Justice Field is quoted in *Atlantic Giant Powder Co.* v. *Goodyear*, 3 Ban. & A. 164, 1877, Dist. Mass., Shepley, J., to the effect that in a reissue a change from the specifications of the original patent, of which change the entire object is not to correct a defect in the original patent, but to change it, and to obtain a patent for a different invention, invalidates the reissued patent.

Is cited in *Gould* v. *Ballard*, 3 Ban. & A. 327, 1878, Dist. N. J., Nixon, J., as a case where the Supreme Court exhibited a disposition to criticise the facility with which reissues were obtained at the patent office. *Russell* v. *Dodge* is distinguished from *Gould* v. *Ballard*; the former being a case when the reissue extended the operation of the original patent, the latter a case where the omission of a part of the elements restricted the original patent in the reissue.

Is cited in *Ball* v. *Langles*, 102 U. S. 130, 1880, Supr. Court, Strong, J., to the point that a reissue embracing new matter, or for anything broader than the invention as originally described in the specification and drawings or models, is void.

Is said in *Atwood* v. *Portland Co.*, 5 Ban. & A. 538, 1880, Dist. Maine, Lowell, J., to decide that a patentee in reissuing his patent has no right to omit something which he had described in the original patent as essential.

"A defective specification could be rendered more definite than certain, so as to embrace the claim made, or the claim could be so modified as to correspond with the specification; but except in special circumstances, such as occurred in the case of *Lockwood* v. *Morey*, 8 Wall. 230, where the inventor was induced to limit his claim by the mistake of the commissioner of patents, this was the extent to which the operation of the original patent could be changed by the reissue. The object of the law was to enable the patentees to remedy accidental mistakes, and the law was perverted when any other end was secured by the reissue." Quoted in *Giant Powder Co.* v. *California Vigorit Co.*, 4 F. R. 725, 1880, Dist. Cal., Field, J.

The opinion of Mr. Justice Field in this case is quoted at some length in *Washburn, &c. Manuf. Co.* v. *Haish*, 4 F. R. 910, 1880, North. Dist. Ill., Drummond, J., to the point that a reissue can only be granted for the same invention originally embraced by the original patent.

This case is briefly stated, and the effect of the decision given as to the validity of the reissue, in *Flower* v. *Rayner*, 5 F. R. 798, 1880, Dist. N. J., Nixon, J.

In *Wilson* v. *Coon*, 6 F. R. 620, 1880, South. Dist. N. Y., Blatchford, J., this case is considered at length, with the comment that the case of *Russell* v. *Dodge* is often cited as authority for the proposition that where the claim of the patent is valid, and the descriptive part of the specification is sufficient to support it, the patent cannot be reissued; but that the case does not lay down the above proposition, nor does any case yet decided by the Supreme Court.

Is said in *Smith* v. *Merriam*, 6 F. R. 719, 1881, Dist. Mass., Lowell, J., to decide merely that a reissue which claims a different invention is void, and that *Russell* v. *Dodge* is considered by Mr. Justice Strong,

in *Ball* v. *Langles*, 18 O. G. 1405, to be consistent with *Seymour* v. *Osborne*, 11 Wall. 516.

Is stated at length in *Kells* v. *McKenzie*, 9 F. R. 286, 1881, East. Dist. Mich., Brown, J., as an authority strictly limiting the right of reissues.

Is stated briefly upon the question of reissues in *Scrivner* v. *Oakland Gas Co.*, 22 F. R. 99, 1884, Dist. Cal., Sawyer, J.

Russell *v.* **Place**, 9 Blatchf. C. C. 173, 1871, North. Dist. N. Y., Woodruff, J.

Mr. Justice Woodruff is said, in *Burdett* v. *Estey*, 5 Ban. & A. 313, 1880, Dist. Vt., Wheeler, J., to have treated as intentional and deliberate an infringement made by persons who knew of the patent in suit, although they supposed that another patent of the plaintiff's, which they owned, protected them in their acts.

Russell *v.* **Place**, 94 U. S., 606, 1876, Supr. Court, Field, J.

Is cited, and the principles applied, in *Steam Gauge & Lantern Co.* v. *Meyrose*, 27 F. R. 213, 1886, East. Dist. Mo., Brewer, J., to the effect that a judgment recovered in an action at law for damages for infringement of a patent does not estop the same defendant in an equity suit for an injunction and an account, if the validity of the patent was not necessarily involved in the prior case, except in respect to the claim which was the basis of the judgment.

Russell & Erwin Manuf. Co. *v.* **Mallory**, 10 Blatchf. C. C. 149, 1872, Dist. Conn., Woodruff, J.

"Lapse of time does not *per se* constitute abandonment. It may be a circumstance to be considered. The circumstances of the case, other than mere lapse of time, almost always give complexion to delay, and either excuse it or give it conclusive effect. The statute has made contemporaneous public use, with the consent and allow-

ance of the inventor, a bar when it exceeds two years. But in the absence of that and of any other colorable circumstances, we know of no mere period of delay which ought *per se* to deprive an inventor of his right." Quoted in *Andrews* v. *Carman*, 2 Ban. & A. 295, 1876, East. Dist. N. Y., Benedict, J.

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Sanders *v.* **Logan**, 2 Fisher, 167, 1861, West. Dist. Penn., Grier, J.

Is cited in *Vaughan* v. *East Tennessee, &c. R. R. Co.*, 2 Ban. & A. 540, 1877, East. Dist. Tenn., Brown, J., as doubting whether a court of equity had jurisdiction when the bill stated a case proper for neither an account nor injunction, but only for a decree for a certain sum of money, with interest, as fixed actual damages. This is construed, in *Vaughan* v. *East Tennessee, &c. R. R. Co.*, as a negative pregnant that if an account is prayed for, the jurisdiction is sustained.

The opinion of Mr. Justice Grier is quoted in *Vaughan* v. *Central P. R. R. Co.*, 3 Ban. & A. 31, 1877, Dist. Cal., Sawyer, J., to the point that in an invention for an improvement in grist-mills, the license fee is the measure of actual damages suffered.

Sargent *v.* **Hall Safe and Lock Co.**, 114 U. S. 63, 1884, Supr. Court, Blatchford, J.

"In patents for combinations of mechanisms, limitations and provisos imposed by the inventor, especially such as were introduced into an application after it had been positively rejected, must be strictly construed against the inventor and in favor of the public, and looked upon as in the nature of disclaimers." Quoted in *Shepard* v. *Carrigan*, 116 U. S. 598, 1885, Supr. Court, Woods, J.

Sargent *v.* Larned, 2 Curtis, C. C. 340, 1855, Dist. Mass., Curtis, J.

Is said in *Morse* v. *Davis*, 5 Blatchf. C. C. 44, 1862, North. Dist. N. Y., Hall, J., not to be a case of much importance upon the question of infringement, and only to decide that a defendant who is merely a workman in the employ of another cannot be required to account for profits of an infringement.

Is cited in *Brooks* v. *Moorhouse*, 3 Ban. & A. 231, 1878, Dist. Mass., Shepley, J., as a case where Curtis, J., enforced by injunction an agreement not to make any articles which infringed plaintiff's patent.

Sargent *v.* Seagrave, 2 Curtis, C. C. 553, 1855, Dist. R. I., Curtis, J.

Is referred to in *Toppan* v. *National Bank Note Co.*, 4 Blatchf. C. C. 512, 1861, South. Dist. N. Y., Shipman, J.

Sargent *v.* Yale Lock Manuf. Co., 17 Blatchf. C. C. 244, 1879, South. Dist. N. Y., Blatchford, J.

The principle of this case is said in *Fitch* v. *Bragg*, 16 F. R. 247, 1883, Dist. Conn., Shipman, J., to be, that when the reduction of prices in the plaintiff's sales is the only element of damages, if the essential feature of the plaintiff's structure and of the infringing structure respectively is the patented device, and the patented device, being only a part of the structure, must necessarily be embodied in the complete structure for sale, and the patentee is enabled by the presence of such patented device to make a profit on the entire structure, and he is deprived by the acts of the defendant in selling at low prices infringing structures containing the patented device, of the profits which he otherwise would have made on the structures containing the patented device which he actually sold, the defendant's infringement must be held to have caused the entire

loss of the plaintiff by the reduction of prices, after allowing a proper sum for any other patented device contained in the defendant's structures.

Sargent Manuf. Co. *v.* **Woodruff**, 5 Biss. 444, 1873, West. Dist. Wis., Hopkins, J.

Is cited in *Cornell* v. *Littlejohn*, 2 Ban. & A. 327, 1876, South. Dist. N. Y., Johnson, J., to the point that a preliminary injunction in a patent suit is not a controlling authority in another circuit.

Sarven *v.* **Hall**, 9 Blatchf. C. C. 524, 1872, Dist. Conn., Woodruff, J.

Is affirmed in *Russell, &c. Manuf. Co.* v. *Mallory*, 10 Blatchf. C. C. 146, 1872, Dist. Conn., Woodruff, J., and distinguishes between a patentable combination and a mere aggregation of elements having no relation to one another, or no reciprocal or co-operative action to produce the result obtained.

Sawin *v.* **Guild**, 1 Gall. 485, 1813, Dist. Mass., Story, J.

Is distinguished in *Morse* v. *Davis*, 5 Blatchf. C. C. 44, 1862, North. Dist. N. Y., Hall, J., from the latter case.

Is cited in *Wilder* v. *Kent*, 15 F. R. 218, 1883, West. Dist. Penn., Acheson, J., as holding that an execution sale by the sheriff of the "materials" of several patented machines was not infringement of the patent right by the officer who made the sale.

Saxe *v.* **Hammond**, 1 Holmes, 456, 1875, Dist. Mass., Shepley, J.

The language of Mr. Justice Shepley in this case to the effect that a mere manufacture of the separate elements of a patented combination by different manufacturers is not an infringement unless such manufacture be proved to have been conducted for the

purpose and with the intent of aiding infringement, is quoted in *Snyder* v. *Bunnell*, 29 F. R. 48, 1886, South. Dist. N. Y., Coxe, J.

Sayles *v.* Chicago & N. W. R. R. Co., 4 Fisher, 584, 1871, North. Dist. Ill., Drummond, J.

Is cited by Longyear, J., in *Hawes* v. *Antisdel*, 2 Ban. & A. 11, 1875, East. Dist. Mich., as a case where the evidence of prior use or knowledge, being nicely balanced, the patent was sustained.

Sayles *v.* Dubuque & S. C. R. R. Co., 9 F. R. 516, 1879, Dist. Iowa, *per Curiam*. See *Collins* v. *Peebles*.

Sayles *v.* Lakeshore & M. S. R. R. Co., 9 F. R. 515, 1879, North. Dist. Ill., Harlan, J. See *Collins* v. *Peebles*.

Sayles *v.* Oregon Central Railway Co., 6 Sawyer, 31, 1879, Dist. Or., Deady, J.

Cited in *May* v. *Logan County*, 30 F. R. 257, 1887, North. Dist. Ohio, Jackson, J., as a case holding that a State statute of limitations may be interposed as a defence in a suit in the federal court for infringement of a patent. See *Collins* v. *Peebles*.

Sayles *v.* Railway Co., 97 U. S. 554, 1878, Supr. Court, Bradley, J.

"If one inventor precedes all the rest and strikes out something which includes and underlies all that they produce, he acquires a monopoly and subjects them to tribute." Quoted in *Steam Gauge &c. Co.* v. *Miller*, 8 F. R. 322, 1881, Dist. Conn., Shipman, J.

Sayles *v.* Richmond, F. & P. R. R. Co., 4 Ban. & A. 241, 1879, East. Dist. Va., Hughes, J.

Is cited in *Hayden* v. *Oriental Mills*, 22 F. R. 104, 1884, Dist. R. I., Colt, J., as deciding that the statute of limitations, act of July 8, 1870, § 55, of six years from the expiration of the patent, for bringing patent

suits for infringements, begins to run at the expiration of the period of twenty-one years as one term. *Contra*, *Sayles* v. *Louisville City R. R. Co.*, 9 F. R. 512; *Sayles* v. *Lakeshore & M. S. R. R. Co.*, 9 F. R. 515; *Sayles* v. *Dubuque & S. C. R. R. Co.*, 9 F. R. 516.

Schillinger *v.* **Greenway Brewing Co.**, 21 Blatchf. C. C. 383, 1883, North. Dist. N. Y., Blatchford, J.

Is explained in *California Pavement Co.* v. *Schalicke*, 119 U. S. 405, 1886, Supr. Court, Blatchford, J.

Schollenberger, *Ex Parte*, 96 U. S. 369.

The opinion of Mr. Chief-Justice Waite is quoted in *Vermont Farm Machine Co.* v. *Marble*, 20 F. R. 118, 1884, Dist. Vt., Wheeler, J., to the effect that the act of Congress prescribing that no person may be sued in a federal court, except in the district of which he is an inhabitant or in which he is found, is in the nature of the personal exemption in favor of a defendant, and one which he may waive. See now act of Congress, 1886–87, March 3, c. 373, that no person can be sued except in the district of which he is an inhabitant.

Schuessler *v.* **Davis**, 13 O. G. 1011, 1878, North. Dist. N. Y., Wallace, J.

Gives a construction of the same reissue on which suit was brought in *Loercher* v. *Crandal*, 11 F. R. 879, 1881, North. Dist. N. Y., Blatchford, J.

Selden *v.* **Stockwell Gas Burner Co.**, 19 Blatchf. C. C. 544, 1881, South. Dist. N. Y., Blatchford, J.

Is said in *Consolidated Electric Light Co.* v. *Edison Electric Light Co.*, 25 F. R. 721, 1885, South. Dist. N. Y., Wallace, J., to decide that under § 4895, U. S. R. S., a patent may be issued to the person who by the records of the office is assignee of the patent, although not technically the assignee of the inventor.

Seymour *v.* **McCormick**, 16 How. 485, 1853, Supr. Court, Grier, J.

Is said in *New York* v. *Ransom*, 23 How. 489, 1859, Supr. Court, Grier, J., to have decided that where the profit of the patentee is derived neither from an exclusive use of the thing patented nor from a monopoly of making it for others to use, the actual damage which he suffers by the use of his improvement without his license is the price of it, with interest, and no more. It is to his advantage that every one should use his invention, provided he pays for a license. The only damage to the patentee is the non-payment of that sum when the infringer commences the use of the invention.

The opinion of Mr. Justice Grier is quoted in *American Nicholson Pavement Co.* v. *Elizabeth*, 1 Ban. & A. 444, 1874, Dist. N. J., Nixon, J., to the point that no rule can be laid down in an action at law which shall settle for all cases what damages are to be allowed the patentee.

Is said in *Goodyear Dental Vulcanite Co.* v. *Van Antwerp*, 2 Ban. & A. 255, 1876, Dist. N. J., Nixon, J., to establish the rule of damages, that if the patentee holds a close monopoly of the patent, damages are the infringer's profits; if the patentee sells licenses to all, the license fee is the proper measure of damages, unless punitive damages are proper.

Is said in *Buerk* v. *Imhaueser*, 2 Ban. & A. 454, 1876, South. Dist. N. Y., Johnson, J., to be quoted from as to the measure of damages in *Goodyear Dental Vulcanite Co.* v. *Van Antwerp*. In *Buerk* v. *Imhaueser* there is also a quotation from *Seymour* v. *McCormick*, to the effect that actual damages must be proved, and are not to be inferred.

The rule as to the measure of damages is again quoted in *Vaughan* v. *Central Pacific R. R. Co.*, 3 Ban. & A. 31, 1877, Dist. Cal., Sawyer, J.

Is stated briefly, and the opinion of Mr. Justice Grier quoted at some length, in *Root* v. *Railway Co.*, 105 U. S. 195, 1881, Supr. Court, Matthews, J. *Seymour* v. *McCormick* decides that in an action at law for an infringement of a patent no rule can be laid down for the measure of damages in every case; but the plaintiff must prove his actual damages, or he will have only nominal damages.

Is cited in *Graham* v. *Geneva, &c. Manuf. Co.*, 24 F. R. 643, 1881, East. Dist. Wis., Dyer, J., on the question of the measure of damages.

The rule in this case, that in suits at law for infringement of patents, when the sale of licenses by the patentee has been sufficient to establish a price for such licenses, the price should be taken as the measure of damages against the infringer, is said in *Westcott* v. *Rude*, 19 F. R. 833, 1884, Dist. Ind., Woods, J., to be reaffirmed in *Packet Co.* v. *Sickles*, 19 Wall. 611.

Seymour *v.* **Osborne**, 11 Wall. 516, 1870, Supr. Court, Clifford, J.

Is cited in *Goodyear Dental Vulcanite Co.* v. *Smith*, 1 Ban. & A. 205, 1874, Dist. Mass., Shepley, J., and said to be an exhaustive and authoritative exposition of the principle that when the commissioner of patents accepts a surrender of an original patent and grants a new patent, his decision as to the validity of the patent is final and conclusive in a suit for infringement, unless it is apparent upon the face of the patent that he has exceeded his authority, and that there is such a repugnancy between the old and new patent that it must be held as a matter of legal construction that the new patent is not for the same invention as is secured by the original patent.

Decides, *inter alia*, that all matters of fact involved in the hearing of an application to reissue a patent and

in granting it, are conclusively settled by the decision of the commissioner granting the application, but that matters of construction arising upon the face of the instrument, *e. g.*, whether the reissue is for the same invention as the original patent, are still open. In *Reckendorfer* v. *Faber*, 92 U. S. 354, 1875, Supr. Court, Hunt, J., it is said that the remarks in *Seymour* v. *Osborne* are chiefly upon the subject of reissues, and are consistent with the principles of *Reckendorfer* v. *Faber*, which are, that the question of utility in an original grant of a patent is not conclusively settled by the commissioner's decision, but is open in a suit on this patent.

Is construed by Sawyer, J., in *Atlantic Giant Powder Co.* v. *California Powder Works*, 2 Ban. & A. 150, 1875, Dist. Cal., Sawyer, J., as laying down the rule that on an application for a reissue of a patent, the commissioner, in looking for the invention intended to be patented, and for which a reissue may be granted, has no authority to look beyond the patent as originally granted, with the specification and drawings annexed, and the models, except in cases specified in 16 Statutes at L. 206, act 1870, § 53, last clause.

In *Reissner* v. *Anness*, 3 Ban. & A. 178, 1877, Dist. N. J., Nixon, J., says that the Supreme Court, in considering the differences between the reissue and the original patent which would make the former invalid, says that the patentee under an application for a reissue cannot make material additions to the invention which were not described, suggested, nor substantially indicated in the original specifications, drawings, or patent-office model.

Is referred to in *Powder Co.* v. *Powder Works*, 98 U. S. 159, 1878, Supr. Court, Bradley, J., as deciding that a reissue, to be valid, must be for the same invention as the original patent.

The opinion of Mr. Justice Clifford in this case is quoted at some length in *Gottfried* v. *Phillip Best Brewing Co.*, 5 Ban. & A. 30, 1879, East. Dist. Wis., Dyer, J., upon the question what sort of prior invention is necessary to deprive a subsequent inventor on the same device to his right to a patent.

Is said in *Horman Patent Manuf. Co.* v. *Brooklyn City Railroad Co.*, 4 Ban. & A. 87, 1879, East. Dist. N. Y., Benedict, J., simply to decide that when a bill sets forth several patents, all pertaining to the same subject, and all required to constitute a complete machine, and all embodied in the machine which the complainants furnish, the bill will be upheld.

Is cited in *Ball* v. *Langles*, 102 U. S. 130, 1880, Supr. Court, Strong, J., to the point that a reissue for anything broader than the invention described in the original specifications or drawings, and models, or embracing new invention, is void.

The powers of the commissioner of patents in regard to a reissue are briefly set forth in this case, and it is cited upon that point in *Wilson* v. *Coon*, 6 F. R. 618, 1880, South. Dist. N. Y., Blatchford, J.

It is said in *Strobridge* v. *Lindsay*, 5 Ban. & A. 414, 1880, West. Dist. Penn., Acheson, J., that this case authoritatively declares utility to exist within the meaning of the patent law "if the combination is new, and the machine capable of being beneficially used for the purpose for which it was designed."

Lays down the rule as to the question of identity between the invention described in a patent and in a reissue. *Heald* v. *Rice*, 104 U. S. 749, 1881, Supr. Court, Matthews, J.

This case is said, in *Rowell* v. *Lindsay*, 6 F. R. 296, 1881, East. Dist. Wis., Dyer, J., to settle the rule of law that a patentee may invoke the doctrine of equivalents on the question of infringement in a case of a

combination patent. The language of the court upon this point is quoted at length.

In *Kells* v. *McKenzie*, 9 F. R. 286, 1881, East. Dist. Mich., Brown, J., it is said that the tendency of later cases in the Supreme Court has been to hold a patentee to a much more rigid rule regarding reissues than is indicated in the former case. *Seymour* v. *Osborne* is also said in *Kells* v. *McKenzie* to have been generally accepted by patentees as authority for the proposition that a patent may be reissued so as to cover everything suggested in the drawings of the original patent, although the claims and introductory statement of the invention may have had reference to another portion of the machine.

Quoted in *Downton* v. *Yeager Milling Co.*, 108 U. S. 471, 1882, Supr. Court, Woods, J., to the point that a foreign published description of an invention to invalidate a United States patent must be in such full, clear, and exact terms that a person skilled in the art would be able to make use of it as if it was described in a prior patent.

The opinion of the court in this case as to the power of the commissioner of patents to allow whatever is suggested or indicated in the specification or drawing of the patent, and which properly belongs to the invention, to be included in the reissue, is quoted in approval in *Combined Patents Can Co.* v. *Lloyd*, 11 F. R. 150, 1882, East. Dist. Penn., Butler, J.

Is cited in *Nellis* v. *Pennock Manuf. Co.*, 13 F. R. 452, 1882, East. Dist. Penn., McKennan, J., to the effect that where all the patents sued have reference to the same general subject, and are all embodied in machines manufactured by the defendant, a demurrer for multifariousness will not lie to the bill.

Is said in *Hendy* v. *Golden State, &c. Works*, 17 F. R. 516, 1883, Dist. Cal., Sawyer, J., to recognize the

right to amend, in a reissue, the specifications of the original patent, by the model as well as by the drawings of the original patent.

Is said in *Ha cock Inspirator Co.* v. *Jenks*, 21 F. R. 914, 1884, East. Dist. Mich., Brown, J., to decide that the recital in a patent that the necessary oaths were taken by the applicant, is conclusive evidence that the necessary oaths were taken.

Is quoted from, in *New Process Fermentation Co.* v. *Koch*, 21 F. R. 586, 1884, East. Dist. Mich., Brown, J., to the effect that to anticipate a subsequent United States patent, a foreign publication must describe the invention clearly, so that any person skilled in the art or science might construct it as they would be able to from the information of a prior patent.

The opinion of Clifford, J., is quoted in *Flower* v. *Detroit*, 22 F. R. 294, 1884, East. Dist. Mich., Brown, J., to the effect that a reissue by the commissioner is not re-examinable in a suit for infringement, unless it is apparent upon the face of the patent that the original patent and the reissue cannot be for the same invention.

The opinion of Mr. Justice Clifford in this case is quoted to the same effect as in *New Process Fermentation Co.* v. *Koch*, *supra*, in *Eames* v. *Andrews*, 122 U. S. 66, 1886, Supr. Court, Matthews, J.

Sharp *v.* **Reissner**, 20 O. G. 1161, 1881, South. Dist. N. Y., Blatchford, J.

Is so limited in *Hubbell* v. *De Land*, 14 F. R. 474, 1882, East. Dist. Wis., Dyer, J., as not to decide that a defendant in a suit in equity cannot file a special plea, but only that the special plea filed in that case (*Sharp* v. *Reissner*) stated matters not proper for a plea.

Shaw *v.* **Cooper**, 7 Pet. 310, 1833, Supr. Court, McLean, J.

Is said in *Battin* v. *Taggert*, 17 How. 83, 1854,

Supr. Court, McLean, J., to have sanctioned the principle expressed in *Grant* v. *Raymond*, 6 Pet. 218; that is, that the patent office had the power to issue a reissued and corrected patent before any legislation was had upon this subject.

Is cited in *Planing Machine Co.* v. *Keith*, 101 U. S. 484, 1879, Supr. Court, Strong, J., as to abandonment or dedication to the public by an inventor.

Is quoted from at length in *Driven Well Cases*, 16 F. R. 389, 1883, South. Dist. Iowa, Shiras, J., as to acquiescence in public use constituting an abandonment of a patent.

Is distinguished in *Davis* v. *Fredericks*, 19 F. R. 99, 1884, South. Dist. N. Y., Wheeler, J., from the latter case, as being a case which arose under the act of 1800, which provided that every patent which should be obtained pursuant to that act for any invention, art, or discovery, which it should afterwards appear had been known or used previous to the application, should be utterly void. *Shaw* v. *Cooper* is therefore not now authority upon that point.

Shaw Relief Valve Co. *v.* **New Bedford**, 19 F. R. 753, 1884, Dist. Mass., Lowell, J.

Is stated in *Bradley* v. *Dull*, 19 F. R. 913, 1884, West. Dist. Penn., Acheson, J., to have decided that the insertion of the word "heirs" in a patent does not secure to the heirs the benefit of the invention of the deceased patentee, in case of intestacy, to the exclusion of the administrator.

Shepard *v.* **Carrigan**, 116 U. S. 598, 1885, Supr. Court, Woods, J.

Is said in *Boland* v. *Thompson*, 26 F. R. 635, 1886, South. Dist. N. Y., Coxe, J., to be authority for the proposition that when a claim has been examined and rejected by the commissioner, the rejection acquiesced

in by the patentee or his solicitor, and the patent reissued without the claim, there is no inadvertence, accident, or mistake which will entitle the patentee to a reissue.

Sickels *v.* Borden, 3 Blatchf. C. C. 535, 1856, South. Dist. N. Y., Nelson, J.

Is said in *Goodyear Dental Vulcanite Co.* v. *Van Antwerp*, 2 Ban. & A. 255, 1876, Dist. N. J., Nixon, J., to adopt the rule of damages laid down in *Seymour* v. *McCormick*, 16 How. 490 (q. v.).

To constitute an infringement, it is not only necessary that the arrangement which is said to infringe should perform the same function or produce the same effect, but, as Mr. Justice Nelson says in the above case, it must do it in substantially the same way. *Werner* v. *King*, 96 U. S. 230, 1877, Supr. Court, Miller, J.

Sickles *v.* Evans, 2 Cliff. 221, 1863, Dist. Mass., Clifford, J.

Is cited in *Stevens* v. *Pritchard*, 2 Ban. & A. 393, 1876, Dist. Mass., Clifford, J., as deciding that when the court, on inspection of a patent and the reissue, decides that the thing patented is not the same invention, the reissue is invalid.

Sickles *v.* Gloucester Manuf. Co., 1 Fisher, 224, 1856, Dist. N. J., Grier, J.

The opinion of Mr. Justice Grier, to the effect that a federal court will take jurisdiction in equity, under the statute of 1870, of a patent case where no injunction can be decreed, if the subject-matter cannot be as well investigated at law, is cited in *Smith* v. *Baker*, 1 Ban. & A. 119, 1874, East. Dist. Penn., McKennan, J. This case was decided before *Root* v. *Railway Co.* (q. v.), and is of course controlled by that decision.

The opinion of Mr. Justice Grier is quoted from, to the point that the courts of the United States have juris-

diction over patent cases by statute, and not as ancillary to a court of law, and therefore do not always require a verdict at law before granting a final injunction, or grant an issue for a jury whenever that is claimed. *Cochrane* v. *Deener*, 94 U. S. 783, 1876, Supr. Court, Bradley, J.

Follows the rule laid down in *Nevins* v. *Johnson*, 3 Blatchf. C. C. 80, that the federal court has jurisdiction in equity of a patent suit irrespective of the right of a patentee to an injunction, and is cited to this effect in *Gordon* v. *Anthony*, 4 Blatchf. 258, 1879, South. Dist. N. Y., Blatchford, J. See *Root* v. *Railway Co.*

Is cited in *Vaughan* v. *East Tennessee, &c. R. R. Co.*, 2 Ban. & A. 540, 1879, East. Dist. Tenn., Brown, J., as deciding that the federal courts have jurisdiction of a patent case where discovery to aid an account is prayed for, although no injunction can be given. See now *Root* v. *Railway Co.*

Sickles *v.* **Mitchell**, 3 Blatchf. C. C. 548, 1857, South. Dist. N. Y., Ingersoll, J.

Is cited in *Hodge* v. *Hudson River Ry. Co.*, 6 Blatchf. C. C. 171, 1868, South. Dist. N. Y., Blatchford, J., upon the question when an injunction shall be ordered.

Silsby *v.* **Foote**, 20 How. 378, 387, 1857, Supr. Court, Nelson, J.

A charge for interest on profits in a master's decree is not ordinarily allowable. The decree of the circuit court allowing it was reversed in the Supreme Court. Cited to this effect in *Brady* v. *Atlantic Works*, 3 Ban. & A. 579, 1878, Dist. Mass., Clifford, J.

Is cited in *Steam Stone Cutter Co.* v. *Windsor Manuf. Co.*, 4 Ban. & A. 453, 1879, Dist. Vt., Wheeler, J., as a case in which the interest upon the profits of an infringement was disallowed.

Is said in *Barker* v. *Stowe*, 11 F. R. 308, 1882, North. Dist. N. Y., Blatchford, J., to decide that the pronouncing of a decision by the circuit court, and its entry in the minutes where the judgment or decree is a simple one, "such as an affirmance or reversal, and the like," constitutes a decree from which an appeal may be taken to the Supreme Court.

Singer Sewing Machine Co. *v.* Union Buttonhole Co., 1 Holmes, 253, 1873, Dist. Mass., Lowell, J.

Is said in *Galley* v. *Colt, &c. Manuf. Co.*, 30 F. R. 121, 1887, Dist. Conn., Shipman, J., to discuss in a very able manner the question whether a court of equity has jurisdiction to grant an injunction to restrain acts which are being done in violation of a contract in regard to personal property where the nature of the contract is such that specific performance cannot be enforced.

Slawson *v.* Grandstreet R. R. Co., 107 U. S. 649, 1883, Supr. Court, Woods, J.

Is cited in *Bradley, &c. Manuf. Co.* v. *Charles Parker Co.*, 17 F. R. 241, 1883, Dist. Conn., Shipman, J., as being one of the late decisions of the Supreme Court holding that the question of patentability is one to be examined with increased care.

Is said, in *Nicodemus* v. *Frazier*, 19 F. R. 262, 1884, Dist. Md., Morris, J., to rule that if upon the face of the bill the invention is clearly unpatentable, the Supreme Court may, of its own motion, dismiss the bill on that ground, without looking into the answer.

Is said in *Leonard* v. *Lovell*, 29 F. R. 314, 1886, West. Dist. Mich., Severens, J., to be a valuable case on the question of the scope and purpose of the patent statutes.

Smith *v.* Baker, 5 O. G. 496, 1874, East. Dist. Penn., McKennan, J.

Follows the rule laid down in *Nevins* v. *Johnson*, 3

Blatchf. C. C. 80, that the federal court has jurisdiction of a patent suit in equity irrespective of the rights of a patentee to an injunction, and is cited to that effect in *Gordon* v. *Anthony*, 4 Ban. & A. 258, 1879, South. Dist. N. Y., Blatchford, J. See now *Root* v. *Railway Co.*

Smith *v.* **Downing**, 1 Fisher, 69, 1850, Dist. Mass., Woodbury, J.

In *Trader* v. *Messmore*, 1 Ban. & A. 640, 1875, South. Dist. Ohio, Swing, J., the language of Woodbury, J., in *Smith* v. *Downing*, is quoted to the effect that the court should not put a broader construction on the language of a patentee in his specification, claims, &c., than the whole subject-matter and description and nature of the case serve to indicate as designed; the construction should be natural, and not forced.

Smith *v.* **Ely**, 5 McLean, 76, 1849, Dist. Ohio, McLean, J.

Is said in *Canan* v. *Pound Manuf. Co.*, 23 F. R. 186, 1885, North. Dist. N. Y., Wallace, J., to have held that the patent of Morse for the electric telegraph was void under § 6 of the patent act of 1839, because, although it had been first patented in France, the United States letters-patent did not upon their face limit the term of the grant to fourteen years from the date or publication of the foreign patent; but this conclusion was overruled in *O'Reilly* v. *Morse*, 15 How. 62; and it was held that the only effect of the French patent was to limit the monopoly to fourteen years from the date of that patent.

Smith *v.* **Goodyear Dental Vulcanite Co.**, 93 U. S. 486, 1876, Supr. Court, Strong, J.

Is distinguished on the facts in *United States Rifle, &c. Co.* v. *Whitney Arms Co.*, 2 Ban. & A. 499, 1876,

Dist. Conn., Shipman, J., from the latter case, as to the effect of a renewed application after a rejection.

Is adopted as settling how much importance the general use of an invention should have as a test of its patentability, in *Eppinger* v. *Richey*, 3 Ban. & A. 74, 1877, South. Dist. N. Y., Shipman, J.

Established the validity of the Goodyear patent and its construction; that is, a product or manufacture made in a defined manner, not the product alone separated from its process, which is as much a part of the invention as the material of which the product is made. *Goodyear Dental Vulcanite Co.* v. *Davis*, 3 Ban. & A. 116, 1877, Dist. Mass., Shepley, J.

In view of this decision the court, in *Comstock* v. *Sandusky Seat Co.*, 3 Ban. & A. 190, 1878, North. Dist. Ohio, Welker, J., overruled the defence of non-patentability, which was set up in the answer, leaving the question to the Supreme Court on appeal.

Is cited and distinguished in *Planing Machine Co.* v. *Keith*, 101 U. S. 488, 1879, Supr. Court, Strong, J., as to loss of rights to an invention by negligence in presenting them.

Is cited in *United States Stamping Co.* v. *King*, 4 Ban. & A. 477, 1879, South. Dist. N. Y., Blatchford, J., as laying down the principles which govern the latter case.

This case is said, in *American Diamond Rock Boring Co.* v. *Sheldon*, 4 Ban. & A. 605, 1879, Dist. Vt., Wheeler, J., to consider the question settled that an invention is not patented abroad until there is a full and perfected patent.

Is referred to in *United States Stamping Co.* v. *King*, 7 F. R. 868, 1879, South. Dist. N. Y., Blatchford, J., as governing the decision in the latter case.

Is cited in *Goodyear Dental Vulcanite Co.* v. *Davis*, 102 U. S. 224, 1880, Supr. Court, Strong, J., as decid-

ing that the Goodyear patent is for a product made in a definite manner, and not for the product alone, separate from the process by which it is created. Both product and process are necessary elements of the invention, and both must be infringed to constitute an infringement of his patent.

Is cited in *Graham* v. *McCormick*, 5 Ban. & A. 248, 1880, North. Dist. Ill., Drummond, J.; s. c. 11 F. R. 862, as deciding that renewed application in 1864 ought to be regarded as one stage in a continuous effort to obtain a patent applied for originally in 1855, and then rejected.

Opinion of Mr. Justice Strong: "Undoubtedly the result or consequences of a process or manufacture may in some cases be regarded as of importance when the inquiry is whether the process or manufacture exhibits invention, thought, or ingenuity." Quoted in *Washburn &c. Co.* v. *Huish*, 4 F. R. 907, 1880, North. Dist. Ill., Drummond, J.

The decision in this case is said, in *Kells* v. *McKenzie*, 9 F. R. 291, 1881, East. Dist. Mich., Brown, J., not to be easily reconcilable with the decision in *Leggett* v. *Avery*, 101 U. S. 256; and the former is preferred to the latter upon the question whether a reissue, including a rejected claim of the original application, is valid.

Is cited in *Coburn* v. *Schroeder*, 11 F. R. 425, 1882, South. Dist. N. Y., Wheeler, J.

The difference between this case and *King* v. *Gallun*, 109 U. S. 102, 1883, Supr. Court, Woods, J., is said in the latter case to be that in *Smith* v. *Goodyear Dental Vulcanite Co.* the invention was the product of a new process applied to old elements; but in *King* v. *Gallun* it is an old process applied to old materials.

"If such a substitution involves a new mode of construction, or develops new uses and properties of the

article formed, it may amount to invention." Quoted in *Celluloid Manuf. Co.* v. *Tower*, 26 F. R. 454, 1885, Dist. Mass., Carpenter, J.

Smith *v.* **Nichols**, 21 Wall. 112, 1874, Supr. Court, Swayne, J.

Decides that the mere carrying forward or 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. In *Roberts* v. *Ryer*, 91 U. S. 159, 1875, Supr. Court, Waite, C. J., this rule is quoted and followed.

Decides as to the patentability of an invention. Cited in *Reckendorfer* v. *Faber*, 92 U. S. 354, 1875, Supr. Court, Hunt, J., to show that the question of the patentability of an invention is open to the court, and not conclusively decided by the commissioner of patents.

In *Putnam* v. *Yerrington*, 2 Ban. & A. 240, 1876, Dist. N. J., Nixon, J., *Smith* v. *Nichols* is approved and quoted from to the point that a mere extending of the original invention to new applications, or substituting equivalent devices for some of its parts, is not invention.

"The mere carrying forward or new or extended application of the original thought, a change only in form, proportions, or degree, a substitution of equivalents, doing 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." Quoted in *Gottfried* v. *Phillip Best Brewing Co.*, 5 Ban. & A. 33, 1879, East. Dist. Wis., Dyer, J.

The language of Judge Lowell in the circuit court, that the application of known means in a known way to produce a known result is not invention, and the

language of the Supreme Court on appeal to the same point, are quoted in *Boykin* v. *Baker*, 9 F. R. 704, 1881, Dist. Md., Morris, J.

Is quoted in *Phillips* v. *Detroit*, 111 U. S. 607, 1883, Supr. Court, Woods, J., to the same effect.

Is quoted from in *Stephenson* v. *Brooklyn Crosstown R. R. Co.*, 114 U. S. 154, 1884, Supr. Court, Woods, J., to the same effect.

Is said in *Niles Tool Works* v. *Betts Machine Co.*, 27 F. R. 304, 1886, Dist. Del., Wales, J., to have held a patent for the manufacture of a textile fabric void because the fabric was superior in degree only, and not differing in kind from fabrics made and known before. The language of Clifford, J., in *Smith* v. *Nichols*, upon the question of what constitutes a patentable invention, is quoted at some length in the latter case.

Is cited in *New York Belting & Packing Co.* v. *MaGowan*, 27 F. R. 362, 1886, Dist. N. J., Nixon, J., to the effect that mechanical skill making a modification of an old idea is not patentable unless some new and useful result is secured.

Smith *v.* **Sands**, 24 F. R. 470, 1885, West. Dist. Mich., Withey, J.

Is cited in *Bragg* v. *Stockton*, 27 F. R. 509, 1886, Dist. Cal., Sawyer, J., as rendering it doubtful whether a bill in equity can be sustained when it does not appear that the defendant has ever made and sold any machine embracing the patented invention, or intends to do so, but has only used three or four machines which other parties made for him, there being no evidence of an intention to use any other machines than those which he now has.

Spaulding *v.* **Page**, 4 Fisher, 641, 1871, Dist. Cal., Sawyer, J.

Is said in *Goodyear Dental Vulcanite Co.* v. *Van*

Antwerp, 2 Ban. & A. 255, 1876, Dist. N. J., Nixon, J., to adopt the rule of damages laid down in *Seymour* v. *McCormick*, 16 How. 490.

Is cited in *Bragg* v. *Stockton*, 27 F. R. 509, 1886, Dist. Cal., Sawyer, J., to the effect that the complainant may waive a license fee and adopt as his remedy an injunction against further or continued use of his patent, and thus maintain a suit in equity, but cannot then claim a royalty, for by so doing the person paying the royalty would be entitled to use the machine till it was worn out.

Spill *v.* Celluloid Manuf. Co., 21 F. R. 631, 1884, South. Dist. N. Y., Blatchford, J.

Is cited in *Goodyear* v. *Hartford Spring Axle Co.*, 23 F. R. 39, 1885, Dist. Conn., Shipman, J. See *Pennsylvania R. R. Co.* v. *Locomotive Engine Safety Truck Co.*

On the point of laches, is cited in *Hoe* v. *Kahler*, 25 F. R. 281, 1885, South. Dist. N. Y., Blatchford, J.

Stanley Works *v.* Sargent, 8 Blatchf. C. C. 344, 1871, Dist. Conn., Shipman, J.

Is quoted from in *Monce* v. *Adams*, 1 Ban. & A. 134, 1874, Dist. Conn., Shipman, J., to the effect that utility is not an infallible test of originality; there must also be original inventive skill, but the effect of a change is one test of the character of the change.

"Utility is not an infallible test of originality. The patent law requires a thing to be new as well as useful in order to entitle it to the protection of the statute. To be new in the sense of the act, it must be the product of original thought or inventive skill, and not a mere formal or mechanical change of what was old; though the effect of a change is often a consideration in determining the character of the change itself." Quoted in *Washburn, &c. Manuf. Co.* v. *Haish*, 4 F. R. 908, 1880, North. Dist. Ill., Drummond, J.

Star Salt Caster Co. *v.* Crossman, 3 Ban. & A. 281, 1878, Dist. Mass., Clifford, J.

Is cited in *Hammond* v. *Hunt*, 4 Ban. & A. 114, 1879, Dist. Mass., Lowell, J., as overruling the case of *Hill* v. *Whitcomb*, 1 Holmes, 317, so far as that case decides that a bill in equity, in a federal court, between citizens of the same State, brought by an exclusive licensee against a patentee and others jointly trespassing with him knowing of the license, cannot be sustained as a patent suit.

Steam Stone Cutter Co. *v.* Sheldon, 10 Blatchf. C. C. 1, 1872, Dist. Vt., Wheeler, J.

This case is briefly stated in *Steam Stone Cutter Co.* v. *Shortsleeves*, 4 Ban. & A. 365, 1879, Dist. Vt., Wheeler, J., as deciding that a grant of "a right to use" patented machines for a specific purpose gives a right to make machines for the use specified, and also the right to procure them made by others, and protects those who so make them.

Stearnes *v.* Page, 1 Story, C. C. 204, 1886, Dist. Maine, Story, J.

It is said in *Hayes* v. *Dayton*, 8 F. R. 706, 1880, South. Dist. N. Y., Blatchford, J., that Rule 37 in equity, providing that no demurrer or plea shall be held bad and overruled because the answer of the defendant may extend to some part of the same matter as may be covered by such demurrer or plea, was made on account of the decision in *Stearnes* v. *Page*, that where a plea states a ground why the defendant should not go into a full defence, and yet the defendant puts in a full defence in his answer, the answer overrules the plea.

Stephenson *v.* Brooklyn Crosstown R. R. Co., 14 F. R. 457, 1881, East. Dist. N. Y., Benedict, J.

"To authorize a patent, the law requires the invention of a new thing. It is not satisfied by inventing a new

place for an old thing without change of result." Quoted in *Clark Pomace Holder Co.* v. *Ferguson*, 17 F. R. 82, 1883, North. Dist. N. Y., Coxe, J.

Stephenson *v.* **Brooklyn Crosstown R. R. Co.**, 114 U. S. 149, 1884, Woods, J.

"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." Quoted in *Railway Register Manuf. Co.* v. *North Hudson C. R. Co.*, 24 F. R. 795, 1885, Dist. N. J., Nixon, J.

Stevens *v.* **Gladding**, 17 How. 455, 1854, Supr. Court, Curtis, J.

The decision in this case is followed in the case of *Draper* v. *Hudson*, 1 Holmes, 208. In *Gordon* v. *Anthony*, 4 Ban. & A. 259, 1879, South. Dist. N. Y., Blatchford, J., the case of *Stevens* v. *Gladding* is distinguished from the case of *Draper* v. *Hudson*, the former being a case where the complainant was entitled to an injunction, and the point considered was whether the complainant could have a decree for an account when he had not prayed for it. In the latter case the bill prayed for an injunction and an account, and the court held that as the right of an injunction had failed, the right of an account as incident to an injunction failed also. *Draper* v. *Hudson* is said to have been decided upon a mistaken construction of the decision in *Stevens* v. *Gladding*. See now *Root* v. *Railway Co.*

The doctrine of Mr. Justice Curtis to the effect that there is much difficulty in holding that a patent right may be seized or sold on execution, is quoted in *Ager* v. *Murray*, 105 U. S. 130, 1881, Supr. Court, Gray, J.

Stevens *v.* **Pritchard**, 4 Cliff. 417, 1876, Dist. Mass., Clifford, J.

The opinion of Mr. Justice Clifford is said, in *Herring* v. *Nelson*, 3 Ban. & A. 63, 1877, North. Dist. N. Y., Johnson, J., to state the doctrine with great clearness and precision, as to the validity of a reissue. "Reissued patents are presumed to be for the same invention as the original, unless the contrary appears. Matters of fact are not open under such an issue in a suit for infringement. The conclusion in such a case must always be in favor of the validity of the reissued patent, unless it appears upon a comparison of the two instruments that the reissue, as a matter of legal construction, is not for the same invention as the original."

Stimpson *v.* **Woodman**, 10 Wall. 117, 1869, Supr. Court, Nelson, J.

Decides that engraving or stamping of the figure upon the surface of a roller for pebbling leather by pressure, where the use previously had been of a smooth roller, was a change involving mere mechanical skill, and not patentable. This case is cited in *Reckendorfer* v. *Faber*, 92 U. S. 353, 1875, Supr. Court, Hunt, J., to show that the question of patentability is not conclusively decided by the commissioner of patents.

Stimpson *v.* **West Chester R. R. Co.**, 4 How. 380, 1845, Supr. Court, McLean, J.

Is said in *Battin* v. *Taggert*, 17 How. 84, 1854, Supr. Court, McLean, J., to have held that where a defective patent has been surrendered and a new one taken out, and the patentee brings an action for a violation of his patent right, laying the infringement at a date subsequent to that of the reissued patent, proof of the use of the thing patented during the interval between the original and renewed patents will not defeat the action.

Is cited in *Thomas* v. *Shoe Machine Co.*, 3 Ban. & A.

559, 1878, Dist. Mass., Clifford, J., as the turning case in the construction of reissues, the rule now being that the granting a reissued patent closes all inquiry as to inadvertence, accident, or mistake.

Stow *v.* **Chicago,** 104 U. S. 547, 1881, Supr. Court, Woods, J.

Is said in *Heald* v. *Rice,* 104 U. S. 755, 1881, Supr. Court, Matthews, J., to apply the principle that a mere substitution of one material for another in the construction of a machine is not patentable.

Strobridge *v.* **Lindsay,** 2 F. R. 692, 1880, West. Dist. Penn., Acheson, J.

Decides the validity of the same reissue which was the subject of an adjudication in *Strobridge* v. *Landers,* 11 F. R. 885, 1881, Dist. Conn., Blatchford, J.

Strong *v.* **Noble,** 3 Fisher, 589, 1869, South. Dist. N. Y., Blatchford, J.

"There is scarcely a patent granted that does not involve the application of an old thing to a new use, and that does not in one sense fail to involve anything more. The merit consists in being the first to make the application, and first to show how it can be made, and first to show that there is utility in making it." Quoted in *Gottfried* v. *Phillip Best Brewing Co.,* 5 Ban. & A. 33, 1879, East. Dist. Wis., Dyer, J.

Suffolk Manuf. Co. *v.* **Hayden,** 3 Wall. 315, 1865, Supr. Court, Nelson, J.

Is stated in *McMillin* v. *Rees,* 5 Ban. & A. 274, 1880, West. Dist. Penn., McKennan, J., to have sustained a patent for an invention which was described but not claimed in a previous patent, upon the ground that the invention, although described, was not covered by the first patent; and that this omission to include it did not operate as an abandonment of the improvement to the public.

"In cases where there is no established patent or license fee, or even an approximation to it, general evidence must be necessarily resorted to," to fix the amount of damages. Quoted in *Root* v. *Railway Co.*, 105 U. S. 198, 1881, Supr. Court, Matthews, J.

Sullivan *v.* **Redfield**, 1 Paine, 441, 1825, Dist. N. Y., Thompson, J.

The opinion of Mr. Justice Thompson as to the nature of the equity jurisdiction conferred upon the federal court in equity in patent cases by the statute of Feb. 5, 1819, c. 19, is quoted from in *Root* v. *Railway Co.*, 105 U. S. 192, 1881, Supr. Court, Matthews, J. Judge Thompson holds that the statute merely gives citizens of the same State a right to avail themselves in the federal court of the equitable remedy which citizens of different States had in that court before the statute.

Swain Turbine &c. Manuf. Co. *v.* **Ladd**, 102 U. S. 408, 1880, Supr. Court, Bradley, J.

The remarks of Mr. Justice Bradley in this case upon the expanded claim sought after by reissues are applied in *McMurry* v. *Mallory*, 5 F. R. 599, 1880, Dist. Md., Morris, J.

Is said in *Washburn, &c. Manuf. Co.* v. *Haish*, 7 F. R. 913, 1881, North. Dist. Ill., Drummond, J., to emphasize the principle frequently decided by the court, that a reissue must be for the same invention as was shown in the original patent, but not to lay down any new rule.

Is said in *Meyer* v. *Maxheimer*, 9 F. R. 100, 1881, South. Dist. N. Y., Wheeler, J., to decide that the statute concerning reissues was never intended to allow a patent to be enlarged except in a clear case of mistake, and that there was no safe or just rule but that which confines a reissue to the same invention which was described or indicated in the original.

The opinion of Mr. Justice Bradley on the evils of expanding claims in reissued patents is quoted in approbation in *Kells* v. *McKenzie*, 9 F. R. 288, 1881, East. Dist. Mich., Brown, J.

It is said in *Hammond* v. *Franklin*, 22 F. R. 836, 1885, South. Dist. N. Y., Wheeler, J., that evidence was offered in the former case to show that the invention upon which a patent was afterwards obtained was the same as that described in the reissue, although different from that described in the original patent; but the evidence was rejected.

T.

Tarr *v.* **Folsom**, 1 Holmes, 312, 1874, Dist. Mass., Shepley, J.

Is followed in *Wonson* v. *Peterson*, 3 Ban. & A. 250, 1878, Dist. Mass., Shepley, J.

Teese *v.* **Huntingdon**, 23 How. 2, 1859, Supr. Court, Clifford, J.

Is quoted from in *Roemer* v. *Simon*, 95 U. S. 219, 1877, Supr. Court, Clifford, J., on the question of the notice required to be given by defendant who intends to set up the defence of prior use.

Thomas *v.* **Shoe Machine Co.**, 16 O. G. 541, 1878, Dist. Mass., Clifford, J.

The rule laid down by Mr. Justice Clifford in this case, to the effect that the decision of the commissioner of patents granting a reissue is final and decisive in a suit for infringement, as to the validity of the reissue, unless it is apparent upon comparison of the original patent and the reissue that they are not for the same invention, is quoted at length in *American Diamond Rock Boring Co.* v. *Sheldon*, 4 Ban. & A. 555, 1879, Dist. Vt., Wheeler, J.

Thompson *v.* Boisselier, 114 U. S. 1, 11, 1884, Supr. Court, Blatchford, J.

Is cited and quoted from in *Gardner* v. *Herz*, 118 U. S. 191, 1885, Supr. Court, Blatchford, J., to the effect that a machine, to be patentable, must contain an invention or discovery.

Is quoted in *Calkins* v. *Oshkosh Co.*, 27 F. R. 298, 1886, East. Dist. Wis., Dyer, J., to the effect that a device, to be patentable, must not only be new and useful, but it must, under the constitution and statute, amount to an invention or discovery.

Is said in *Consolidated Fruit Jar Co.* v. *Bellaire Stamping Co.*, 28 F. R. 94, 1886, South. Dist. Ohio, Sage, J., to decide that a machine, in order to be patentable, must not only be new and useful, but it must, under the constitution and the statute, amount to an invention or discovery.

The principle of decision of this case as to the non-patentability of combinations of old elements is followed in *Thatcher Heating Co.* v. *Burtis*, 121 U. S. 295, 1886, Supr. Court, Matthews, J.

Tilghman *v.* Mitchell, 4 Fisher, 624, 1871, South. Dist. N. Y., Blatchford, J.

The court in this case followed the decision in *Tilghman* v. *Werk*, a previous case on the same patent, and a case substantially the same in a co-ordinate court. This course of decision was applied and followed in *Goodyear Dental Vulcanite Co.* v. *Willis*, 1 Ban. & A. 571, 1874, East. Dist. Mich., Emmons, J.

Tilghman *v.* Proctor, 102 U. S. 707, 1881, Supr. Court, Bradley, J.

It is said that Mr. Justice Bradley, in this case, quotes with approval the language of Grier, J., in *Corning* v. *Burden*, 15 How. 252, as to the definition of a process in the patent-law. So stated in *MacKay* v.

Jackman, 12 F. R. 618, 1882, South. Dist. N. Y., Wheeler, J.

The decision in this case is applied in *United Nickel Co.* v. *Pendleton*, 15 F. R. 746, 1883, South. Dist. N. Y., Blatchford, J. In the former case, Bradley, J., distinguished a patent for a process or a product from a patent for a principle, and comments on *Morse* v. *O'Reilly*, 15 How. 62.

Is referred to in *New Process Fermentation Co.* v. *Maus*, 20 F. R. 728, 1884, North. Dist. Ind., Drummond, J., as a case where a patent for a process was sustained; and it is quoted to the effect that whoever discovers that a certain useful result will be produced in any art by the use of certain means, is entitled to a patent for it, provided he specifies the means, and that it is very certain that the means need not be a machine or an apparatus; it may be a process. "A machine is a thing; a process is an act or a mode of acting."

And this view is affirmed in *New Process Fermentation Co.* v. *Maus*, 122 U. S. 427, 1886, Supr. Court, Blatchford, J.

Tremolo Patent, 23 Wall. 518, 1874, Supr. Court, Strong, J.

Is cited in *Reay* v. *Berlin, &c. Envelope Co.*, 30 F. R. 449, 1887, South. Dist. N. Y., Wheeler, J., to the effect that if the change of statement from an original patent to a reissue is only a more correct statement of the same case, the reissue is valid.

Troy Iron & Nail Factory *v.* **Corning**, 14 How. 193, 216, 1852, Supr. Court, Wayne, J.

"A mere license to a party without having 'his assigns,' or equivalent words to them, showing that it was meant to be assignable, is only a grant of a personal power to the licensee, and is not transferable by him to

another." Quoted in *Putnam* v. *Hollender*, 6 F. R. 892, 1881, South. Dist. N. Y., Blatchford, J.

Is quoted in *Oliver* v. *Rumford Chemical Works*, 109 U. S. 82, 1883, Supr. Court, Blatchford, J., that if a license does not contain words of assignability, it is but a personal power, and not assignable.

Tucker *v.* **Spaulding**, 13 Wall. 453, 1872, Supr. Court, Miller, J.

This case is briefly stated and the decision cited in *Yale Lock Manuf. Co.* v. *Norwich National Bank*, 6 F. R. 385, 1881, Dist. Conn., Shipman, J., upon the point of double use.

Turrell *v.* **Spaeth**, 2 Ban. & A. 185, 1875, Dist. N. J., Nixon, J.

Is cited in *Roberts* v. *Walley*, 14 F. R. 168, 1882, North. Dist. N. Y., Coxe, J., as stating the proper procedure when the plaintiffs seek to compel the defendants as witnesses to disclose their contracts with their customers in order to prove the infringement by them.

Turrill *v.* **Michigan Southern, &c. R. R. Co.**, 1 Wall. 491, 1863, Supr. Court, Clifford, J.

Is explained in the *Cawood Patent Cases*, 94 U. S. 697, 705, 1876, Supr. Court, Strong, J., as to the construction of the patent and the explanation of the patented invention.

Tyler *v.* **Tuel**, 6 Cranch. 324, 1810, Supr. Court, *per Curiam*.

Is referred to in *Meyer* v. *Bailey*, 2 Ban. & A. 76, 1875, West. Dist. Penn., McKennan, J., as with *Whittemore* v. *Cutter*, 1 Gall. 429, settling that only a person who is invested with the entire ownership of a patent or an undivided part of the whole, is to be regarded as an assignee.

U.

Union Paper Bag Machine Co. *v.* **Crane, 1 Holmes, 429, 1874, Dist. Mass., Lowell, J.**

This case is considered in *Lockwood* v. *Cleveland*, 6 F. R. 725, 1881, Dist. N. J., Nixon, J., and it is stated in the latter case that the court in the former case decreed in favor of the defendants, declaring their patent to be good and valid, and against the complainants, declaring their patent to be void, thus administering affirmative relief under § 4918, U. S. R. S., without the necessity of the defendant filing a cross bill for this purpose.

The principle stated in this case, that the decision of the commissioner of patents is not final on the question of priority of invention, even between those who were fully heard in the interference, but that his decision has great weight, is adhered to and approved in *Whipple* v. *Miner*, 15 F. R. 117, 1883, Dist. Mass., Lowell, J.

The language of Lowell, J., as to § 4918, U.S. R. S., is as follows: "It is not ambiguous, but gives the court of equity a right to decide between interfering patents without any exception or limitation." Quoted in *Hubel* v. *Tucker*, 24 F. R. 702, 1885, South. Dist. N. Y., Wallace, J.

Union Paper Bag Machine Co. *v.* **Murphy, 97 U. S. 120, 1877, Supr. Court, Clifford, J.**

The opinion of Mr. Justice Clifford to the effect that a similarity of two machines in outward form and appearance is not at all material in the question of infringement, but their operation and performance alone are important, is quoted at length in *American Dia-*

mond Rock Boring Co. v. *Sheldon*, 4 Ban. & A. 557, 1879, Dist. Vt., Wheeler, J.

The opinion of Mr. Justice Clifford, to the effect that in deciding on a question of infringement the court and jury are to regard not the names of devices, but what function they perform, and that devices are different only when they perform different functions, or in a different way, or produce a substantially different result, is quoted in *Cantrell* v. *Wallick*, 117 U. S. 695, 1885, Supr. Court, Woods, J.

"Nor is it safe to give much heed to the fact that corresponding devices in two machines, organized for accomplishing the same result, are different in shape or form, the one from the other, as it is necessary in every such investigation to look at the mode of operation or the way the device works, and at the result, as well as the means by which the result is obtained." Quoted in *Shaver* v. *Skinner Manuf. Co.*, 30 F. R. 71, 1887, North. Dist. Iowa, Shiras, J.

United Nickel Co. *v.* **Anthes**, 1 Holmes, 155, 1872, Dist. Mass., Shepley, J.

Is said in *United Nickel Co.* v. *Keith*, 1 Ban. & A. 44, 1874, Dist. Mass., Shepley, J., to give the history of the art of electro-plating with nickel before the discoveries of Dr. Adams.

The decision in this case as to the question of novelty in the invention in electro-plating is approved in *United Nickel Co.* v. *Harris*, 3 Ban. & A. 638, 1878, South. Dist. N. Y., Blatchford, J.

United Nickel Co. *v.* **Keith**, 1 Holmes, 328, 1874, Dist. Mass., Shepley, J.

The remarks of Shepley, J., in this case as to the state of the electro-plating art are concurred in by Blatchford, J., in *United Nickel Co.* v. *Harris*, 3 Ban. & A. 639, 1878, South. Dist. N. Y.

United Nickel Co. *v.* Manhattan Brass Manuf. Co., 16 Blatchf. 68, 1879, South. Dist. N. Y., Blatchford, J.

Is cited and distinguished in *Horman Patent Manuf. Co. v. Brooklyn City Railroad Co.*, 4 Ban. & A. 87, 1879, East. Dist. N. Y., Benedict, J.

United States *v.* Burns, 12 Wall. 252, 1870, Supr. Court, Field, J.

Is cited in *Brady* v. *Atlantic Works*, 2 Ban. & A. 441, 1876, Dist. Mass., Clifford, J., as an authority to the point that Government cannot use a patented improvement, any more than any individual, without license by the inventor, or making him compensation, even though an officer of the Government makes the invention.

United States *v.* Morris, 2 Bond, 33, 1866, South. Dist. Ohio, Leavitt, J.

Leavitt, J., said the statute relating to marking articles with the word "patent," to deceive the public (U. S. R. S. § 4911), did not apply to unpatentable articles. In *Oliphant* v. *Salem Flouring Mills Co.*, 3 Ban. & A. 259, 1878, Dist. Or., Deady, J., says this was *obiter*, and without argument, and that the opinion is alone, and that he is unable to concur with its reasoning or conclusions.

United States Rifle Co. *v.* Whitney Arms Co., 14 Blatchf. C. C. 94, 1877, Dist. Conn., Shipman, J.

The facts of this case were briefly stated in *Colgate* v. *Western Union Telegraph Co.*, 4 Ban. & A. 66, 1878, South. Dist. N. Y., Blatchford, J.

Is referred to in *Woodbury Patent Planing Machine Co.* v. *Keith*, 4 Ban. & A. 102, 1879, Dist. Mass., Lowell, J., as giving a construction of § 35 of the patent act of Congress of 1870, to the effect that this statute gives the commissioner in all cases jurisdiction of the question of abandonment, and at the same time makes that fact a defence on a trial of the action.

V.

Vance *v.* **Campbell**, 1 Black, 429, 1861, Supr. Court, Nelson, J.

Language of Mr. Justice Nelson is quoted: "Unless the combination is maintained, the whole of the invention fails. The combination is an entirety; if one of the elements is given up, the thing claimed disappears." *Turrell* v. *Spaeth*, 2 Ban. & A. 187, 1875, Dist. N. J., Nixon, J.

Is construed in *Henderson* v. *Cleveland Co-operative Stove Co.*, 2 Ban. & A. 607, 1877, North. Dist. Ohio, Brown, J., to have decided that if a patentee declares upon a combination of elements which he asserts constitute the novelty of his invention, he cannot abandon part of his combination and maintain his claim to the rest, nor prove any part of his combination immaterial and useless; but when the specification declares on a combination as the thing patented, and says that the use of the improvement requires both elements to be preserved, and then claims the elements separately, the patent covers the elements separately.

Is said in *Herring* v. *Nelson*, 3 Ban. & A. 66, 1877, North. Dist. N. Y., Johnson, J., not to decide as a judgment any doctrine material to the question of reissues, there being no reissue in the case.

Van Hook *v.* **Pendleton**, 1 Blatchf. C. C. 193, 1846, South. Dist. N. Y., Betts, J.

Is said in *Green* v. *French*, 4 Ban. & A. 171, 1879, Dist. N. J., Nixon, J., to decide that the owner of a patent is not to be charged with acquiescence in an infringement because he withholds suit during the pendency of other suits to determine his rights under a patent.

Vinton *v.* **Hamilton**, 104 U. S. 485, 1882, Supr. Court, Woods, J.

Is cited in *Thompson* v. *Boisselier*, 114 U. S. 11, 1884, Supr. Court, Blatchford, J., as a case where an invention was held not to be patentable.

W.

Walker *v.* **Hawxhurst**, 5 Blatchf. C. C. 494, 1867, South. Dist. N. Y., Nelson, J.

The opinion of Mr. Justice Nelson is quoted in *Oliphant* v. *Salem Flouring Mills Co.*, 3 Ban. & A. 259, 1878, Dist. Or., Deady, J.

Wallace *v.* **Holmes**, 9 Blatchf. C. C. 65, 1871, Dist. Conn., Shipman, J.

Is approved as a sound decision, and the decision said, in *Saxe* v. *Hammond*, 1 Ban. & A. 631, 1875, Dist. Mass., Shepley, J., to be that the actual concert of the makers of the different elements of the combination was a certain inference from the facts, in *Wallace* v. *Holmes*; and the distinct efforts of the defendants to bring into use these elements of the combination which comprised the whole invention, although they could not be used without adding one other element, were found to be proved.

Is interpreted in *Turrell* v. *Spaeth*, 2 Ban. & A. 189, 1875, Dist. N. J., Nixon, J., to decide that under a patent for a combination he is an infringer who makes and sells only one or two parts of which the combination is composed, if done with the intent that the purchaser shall unite them with the other parts, procured either from the same or other sources, at the same or different times.

Is construed in *Buerk* v. *Imhaueser*, 2 Ban. & A. 466, 1876, South. Dist. N. Y., Johnson, J., to decide that a

patent for a combination cannot be evaded by different persons selling each a different part of the combination with the view of their being used together by the purchaser.

Is cited in *Schneider* v. *Pountney*, 21 F. R. 403, 1884, Dist. N. J., Nixon, J., as being a leading case upon the point that the defendants cannot protect themselves from the consequences of infringement of a patent for a combination by one making and selling one part, and another, another, with the intention of having them used with each other, but that in such a case all are deemed joint infringers, and all are liable for all the damages.

Is cited in *Travers* v. *Beyer*, 26 F. R. 450, 1886, North. Dist. N. Y., Wallace, J., as establishing a rule that defendants who sell separate parts of the materials of a patented combination, with a knowledge that they are to be used with the other parts of the combination to infringe the patent, are guilty of an infringement. *Wallace* v. *Holmes* is said in *Travers* v. *Beyer* to have been followed in *Richardson* v. *Noyes*, 10 O. G. 501, and in *Bowker* v. *Dowes*, 15 O. G. 510.

Is said in *Snyder* v. *Bunnell*, 29 F. R. 48, 1886, South. Dist. N. Y., Coxe, J., to be a clear illustration of the doctrine of contributory infringement, that being a case where the defendants sold a lamp-burner, for which, in combination with a chimney, the plaintiff had a patent, the defendants knowing that the burner was useless without the chimney, and that the purchaser would undoubtedly use a chimney in combination with the burner.

Washburn *v.* **Gould**, 3 Story, 122, 1844, Dist. Mass., Story, J.

Is said, in *Emerson* v. *Hogg*, 2 Blatchf. C. C. 10, 1845, South. Dist. N. Y., Betts, J., to decide that, under the statute, drawings of a patent may be filed

with the specification, although not referred to in the specification.

Mr. Justice Story says the rule of comity always observed by the justices of the Supreme Court on circuit, in cases which admit of being carried before the whole court, was to conform to the opinions of each other, if any had been given. Quoted in *Goodyear Dental Vulcanite Co.* v. *Willis*, 1 Ban. & A. 571, 1874, East. Dist. Mich., Emmons, J.

Is cited in *Rumford Chemical Works* v. *Hecker*, 2 Ban. & A. 360, 1876, Dist. N. J., Nixon, J., as a case where Judge Story followed the rule of comity by ruling to the same effect as Judge McLean in *Brooks* v. *Bricknell*, 3 McLean, 250, a decision in another circuit on the same point of law, although he, Judge Story, had great difficulty with the point.

Is cited in *Herman* v. *Herman*, 29 F. R. 93, 1886, South. Dist. N. Y., Brown, J., to the effect that where the patentee has given to a licensee the exclusive right to the use of a patented invention, a suit in equity for damages should be brought in the name of the licensee, but at the charge and expense of the patentee, if he has guaranteed to defend the rights secured by the patent.

Washburn & Moen Manuf. Co. *v.* **Haish**, 4 F. R. 900, 1880, North. Dist. Ill., Drummond, J.

Is said in *Wetherell* v. *Keith*, 27 F. R. 366, 1886, North. Dist. Ill., Blodgett, J., to establish the rule that the fact of prior use as a defence in a suit for infringement must be established beyond reasonable doubt.

Water Meter Co. *v.* **Desper**, 101 U. S. 332, 337, 1879, Supr. Court, Bradley, J.

The opinion of Mr. Justice Bradley is quoted from in *Gage* v. *Herring*, 107 U. S. 648, 1882, Supr. Court, Gray, J., to the point that a patentee by his claim in a

combination makes all the parts of the combination stated in the claim material.

Webster *v.* New Brunswick Carpet Co., 5 O. G. 522, 1874, Dist. N. J., Nixon, J.

Is cited in *Welling* v. *Rubber Coated Harness Co.*, 1 Ban. & A. 288, 1874, Dist. N. J., Nixon, J., to the effect that a patent for a combination is infringed by the use of similar combinations, although one of the elements is omitted and another substituted, unless the substituted device is a new one, or performs a function essentially different, or was not known at the date of the patent to be a proper substitute for the one omitted.

Webster *v.* New Brunswick Carpet Co., 9 O. G. 203, 1876, Dist. N. J., Nixon, J.

In *Webster Loom Co.* v. *Higgins*, 4 Ban. & A. 99, 1879, South. Dist. N. Y., Wheeler, J., the authority of the former case, while recognized by the court, was not followed, because the cases were essentially different upon the pleadings and evidence.

Webster Loom Co. *v.* Higgins, 16 O. G. 675, 1879, South. Dist. N. Y., Wheeler, J.

"The burden of proof rests upon the defendant to show beyond a fair doubt the prior knowledge and use set up." Quoted in *Washburn, &c. Co.* v. *Haish*, 4 F. R. 904, 1880, North. Dist. Ill., Drummond, J.

Webster Loom Co. *v.* Higgins, 105 U. S. 580, 1882, Supr. Court, Bradley, J.

Is said in *Zane* v. *Soffe*, 110 U. S. 203, 1883, Supr. Court, Bradley, J., to decide that under a general denial of the patentee's priority of invention, evidence of prior knowledge and use, taken without objection, is competent at final hearing on the question of the validity of the patent.

Is cited in *Thayer* v. *Hart*, 20 F. R. 694, 1884, South. Dist. N. Y., Coxe, J., to the effect that the burden of proof of priority of use or knowledge is upon the defendant.

Is said in *Hancock Inspirator Co.* v. *Jenks*, 21 F. R. 916, 1884, East. Dist. Mich., Brown, J., to hold that if an improvement of a well-known appendage to a machine is fully described in a specification, it is not necessary to show the ordinary modes, to attach the appendage to the machine.

Is cited in *Phillips* v. *Carroll*, 23 F. R. 251, 1885, West. Dist. Penn., Acheson, J., as establishing the general rule of the patentability of an invention.

Weston *v.* **White**, 13 Blatchf. C. C. 364, 1876, Dist. Conn., Shipman, J.

Is cited in *American Diamond Rock Boring Co.* v. *Sheldon*, 4 Ban. & A. 604, 1879, Dist. Vt., Wheeler, J., as deciding that the effect of the act of Congress, March 2, 1861, § 16, was to change the term of fourteen years to seventeen, as well in respect to patents limited by prior foreign patents as in respect to others.

Is stated and considered at some length in *De Florez* v. *Raynolds*, 5 Ban. & A. 151, 1880, South. Dist. N. Y. Blatchford, J.; s. c. 8 F. R. 443, upon the question how long a patent granted in 1867 will run, an English patent for the same invention being previously granted in 1859 for fourteen years. *Weston* v. *White* says, although not directly involved in the decision of the case, a patent issued in 1867 is under the statute of 1861, § 16, and will run for a term of seventeen years, and under § 6 of the act of 1839 it will begin to run from the date of the foreign patent.

Is said in *Siemens* v. *Sellers*, 16 F. R. 861, 1883, East. Dist. Penn., Butler, J., to agree with the decision in *De Florez* v. *Raynolds*, although the point was not

necessary to the decision of the case. See *De Florez* v. *Raynolds*.

Wetherill *v.* **New Jersey Zinc Co.**, 1 Ban. & A. 105, 1874, Dist. N. J., McKennan, J. See *Collins* v. *Peebles*.

Wheeler *v.* **Clipper Mower Co.**, 10 Blatchf. C. C. 181, 1872, South. Dist. N. Y., Woodruff, J.

"If an invention when constructed according to the model and specifications filed will operate as a practical and useful thing, the inventor has satisfied the law and his patent is valid. He is not bound by law to construct it in order to preserve his patent." Quoted in *Broadnax* v. *Central S. Y. &c. Co.*, 5 Ban. & A. 612, 1880, Dist. N. J., Nixon, J.; s.c. 4 F. R. 216.

This case is said, in *Strobridge* v. *Lindsay*, 6 F. R. 512, 1881, West. Dist. Penn., Acheson, J., to be an authority for the proposition that a patent cannot be evaded by dividing the patented device into two parts which when combined produce the same result in substantially the same way, and selling these parts separately.

The doctrine in this case, that there is no rule which forbids an inventor who has omitted to claim separate new devices, or severable and distinct combinations, in the original patent, making a surrender and taking reissues for the distinct combination or separate devices, is quoted in *Odell* v. *Stout*, 22 F. R. 163, 1884, South. Dist. Ohio, Sage, J.

Wheeler *v.* **McCormick**, 8 Blatchf. C. C. 267, 1871, South. Dist. N. Y., Woodruff, J.

Is cited and distinguished in *Turrell* v. *Spaeth*, 2 Ban. & A. 316, 1876, Dist. N. J., Nixon, J. On a motion to compel a plaintiff to elect which of two suits on a patent, in the same district, between the same parties, he will rely upon, the motion was overruled.

Is cited in *Gold & Stock Telegraph Co.* v. *Pearce*, 19 F. R. 419, 1884, South. Dist. N. Y., Wheeler, J., as an authority for the maintenance of several successive suits for successive infringements in different districts.

Whiteley *v.* **Kirby**, 11 Wall. 678, 1868, Supr. Court, Nelson, J.

Is cited in *Kirby* v. *Dodge, &c. Manuf. Co.*, 10 Blatchf. C. C. 313, 1872, North. Dist. N. Y., Woodruff, J., as not conclusive in the latter case, the facts being different.

Whitely *v.* **Swayne**, 4 Fisher, 117, 1865, South. Dist. Ohio, Leavitt, J.

Is said in *Hartshorn* v. *Eagle Shade Roller Co.*, 18 F. R. 91, 1883, Dist. Mass., Lowell, J., to have held that the oath to an application for a reissue should conform to the exact words of the law, or the reissue is invalid. This ruling is criticised in the latter case and not followed, but was followed by Baxter, J., in *Poage* v. *McGowan*, 15 F. R. 398, without considering the point again.

The reissue is not valid when granted because the original patent was not fully valid and available. It must be invalid or inoperative. Cited in *Poage* v. *McGowan*, 15 F. R. 399, 1883, South. Dist. Ohio, Baxter, J.

Whitely *v.* **Swayne**, 7 Wall. 685, 1868, Supr. Court, Nelson, J.

"He is the first inventor and entitled to the patent who, being an original discoverer, has first perfected and adapted the invention to actual use." Quoted in *Albright* v. *Celluloid Harness Trimming Co.*, 2 Ban. & A. 635, 1877, Dist. N. J., Nixon, J.

The opinion of Nelson, J., is quoted from in *Whittlesey* v. *Ames*, 5 Ban. & A. 103, 1880, North. Dist. Ill.,

Blodgett, J.; s. c. 13 F. R. 898, upon the point that prior unsuccessful experiments in the same line of research do not deprive a subsequent inventor of his right to a patent.

Whiting *v.* **Graves,** 3 Ban. & A. 222, 1878, Dist. Mass., Shepley, J.

Is explained in *Hapgood* v. *Hewitt,* 119 U. S. 233, 1886, Supr. Court, Blatchford, J.

Whittemore *v.* **Cutter,** 1 Gall. 479, 1813, Dist. Mass., Story, J.

Is said in *Boston Manuf. Co.* v. *Fiske,* 2 Mason, 120, 1820, Dist. Mass., Story, J., to have been decided on authority in *Arcambal* v. *Wiseman,* 3 Dal. 306.

Is cited and distinguished in *Earle* v. *Sawyer,* 4 Mason, 12, 1827, Dist. Mass., Story, J.

Is referred to in *Loom Co.* v. *Higgins,* 105 U. S. 588, 1881, Supr. Court, Bradley, J., as a case deciding that an answer alleging that the patent has an insufficient specification, with an allegation of fraudulent intent in making the specification so insufficient, is a defence to a suit on a patent. Contrary to the decision in *Grant* v. *Raymond,* 6 Pet. 218, where an allegation of fraudulent intent was not necessary for a defence, but only if the defendant designed to avoid the patent, as was allowed by the law of 1793.

Whittlesey *v.* **Ames,** 18 O. G. 357, 1880, North. Dist. Ill., Blodgett, J.

Is said in *Woven Wire Mattress Co.* v. *Simmons,* 7 F. R. 725, 1881, East. Dist. Wis., Dyer, J., to have sustained the reissued patent for an improvement in bedstead frames.

Wilder *v.* **Gaylor,** 1 Blatchf. C. C. 597, 1850, South. Dist. N. Y., Nelson, J.

Is approved and distinguished in *Day* v. *New Eng-*

land Car Spring Co., 3 Blatchf. C. C. 181, 1854, South. Dist. N. Y., Betts, J., from the latter case.

The decision in this case as to the special pleas is said, in *Hubbell* v. *De Land*, 14 F. R. 473, 1882, East. Dist. Wis., Dyer, J., to be in conflict with the rule laid down by the Supreme Court in *Evans* v. *Eaton*, 3 Wheat. 454. *Wilder* v. *Gaylor* decided that when a defendant pleads the general issue with notice of special matter, and also special pleas setting up the same matter, the pleas should be stricken out.

Wilkens *v.* Spofford, 3 Ban. & A. 274, 1878, Dist. Mass., Shepley, J.

Explained in *Hapgood* v. *Hewitt*, 119 U. S. 234, 1886, Supr. Court, Blatchford, J.

Williams, *Ex Parte*, 3 Ban. & A. 533, 1878, Dist. N. J., Nixon, J.

Is explained in *Wilson Packing Co.* v. *Hunter*, 4 Ban. & A. 185, 1879, South. Dist. Ill., Drummond, J., as being a case where there was an express provision of the statute declaring that process might be served upon a foreign corporation doing business in the State or Territory where the suit was brought. See also *Schollenberger*, *Ex Parte*, 96 U. S. 369.

Williams *v.* Rome, W. & O. R. R. Co., 15 Blatchf. C. C. 200, 1878, North. Dist. N. Y., Blatchford, J.

Is said in *Williams* v. *B. & A. R. R. Co.*, 4 Ban. & A. 442, 1879, North. Dist. N. Y., Wallace, J., to be a controlling authority upon many of the questions presented in the latter case.

Wilson *v.* Barnum, 8 How. 258, 261, 1849, Supr. Court, Taney, C. J.

The opinion of Mr. Chief-Justice Taney is quoted from in *California Paving Co.* v. *Molitor*, 113 U. S. 617, 1884, Supr. Court, Bradley, J., to the effect that the

question of infringement is one of fact, and therefore not such a one as can be certified to the Supreme Court as a question upon which the circuit court is divided.

Wilson *v.* **Rousseau**, 4 How. 646, 1846, Supr. Court, Nelson, J.

Is explained in *Day* v. *Union India Rubber Co.*, 3 Blatchf. C. C. 491, 1856, South. Dist. N. Y., Hall, J., as not deciding that the right of an assignee or grantee of the original term of a patent is limited to the use of machines which such assignee or grantee had in operation when the extended term commenced, but the right includes an extended term.

Cited in *Aiken* v. *Manchester Print Works*, 2 Cliff. 437, 1865, Dist. N. H., Clifford, J., as establishing the distinction between a grant of a right to make and vend, and the grant of the machine with a right to use it. The latter grant includes the right to repair.

Is said in *Prime* v. *Brandon Manuf. Co.*, 4 Ban. & A. 384, 1879, Dist. Vt., Wheeler, J., to place a strict construction upon an assignment of a patent right in respect to extension.

In this case the effect of § 18 of the patent act of 1836, as to the rights of assignees of a patent under an extended term, is said to have undergone careful scrutiny in the Supreme Court, and the distinction was there made between persons engaged in the direct use of the machines and speculators in patents and inventions. The former can use the patented machine under an extension; the latter's rights ordinarily end with the original term. So said in *Fire Extinguisher Manuf. Co.* v. *Graham*, 16 F. R. 551, 1883, West. Dist. Va., Hughes, J.

Wilson *v.* **Sandford**, 10 How. 99, 1850, Supr. Court, Taney, C. J.

Is explained in *Pulte* v. *Derby*, 5 McLean, 336, 1852,

Dist. Ohio, *per Curiam*, as deciding that § 17 of patent act of 1836 does not give a federal court jurisdiction of a bill in equity to set aside an assignment of a patent right on the ground that the assignee has not complied with the terms of the contract.

Is cited and explained in *Goodyear* v. *Union India Rubber Co.*, 4 Blatchf. C. C. 68, 1857, South. Dist. N. Y., Ingersoll, J., to the effect that where a license had been given under a patent, and is still in existence, the owner of the patent cannot sue in a federal court for infringement.

The opinion of Mr. Chief-Justice Taney is quoted at length in *Consolidated Fruit Jar Co.* v. *Whitney*, 2 Ban. & A. 32, 1875, Dist. N. J., Nixon, J., to the point that when the controversy in a case does not turn upon letters-patent, but upon the force and effect of some contract under them or in reference to them, in which the question of their validity is not raised, the federal courts have no jurisdiction.

Is carefully considered in *Hartell* v. *Tilghman*, 99 U. S. 551, 1878, Supr. Court, Miller, J., and said to be the only authoritative construction of the statute of 1870 (except *Littlefield* v. *Perry*, 21 Wall. 205) on the question whether a court of the United States has jurisdiction of a case arising out of a contract relating to a patent where the case does not arise under an act of Congress, or depend in any way upon this construction of any law in relation to patents. *Wilson* v. *Sandford* decides this question in the negative, and it is followed in *Hartell* v. *Tilghman*.

Is examined in the dissenting opinion of Bradley, J. (Waite, C. J., and Swayne, J., concurring), in *Hartell* v. *Tilghman*, 99 U. S. 558, 1878, Supr. Court; and it is said that if the question was a new one, a case where a complainant seeks damages for infringement, and an injunction against an application to avoid an inequitable

license held by the defendant, might properly be brought in a federal court.

Is referred to in *Albright* v. *Teas*, 106 U. S. 618, 1882, Supr. Court, Woods, J., as deciding against the jurisdiction of a case relating to a patent, the case not involving the construction of any law as relating to patents or arising under any law of Congress, and not being between citizens of different States, but being a bill to set aside a contract.

Is said in *Teas* v. *Albright*, 13 F. R. 413, 1882, Dist. N. J., Nixon, J., to have settled the question as to the jurisdiction of the federal court in suits brought to avoid a license, where neither the citizenship of the parties nor the amount involved in the litigation gave the court jurisdiction. The court refused to entertain jurisdiction of such suits on the ground that the suit arose out of the contract or license, and not under any law of the United States granting or confirming to inventors exclusive right in their inventions or discoveries.

Is cited in *Smith* v. *Standard Laundry Machine Co.*, 19 F. R. 826, 1882, South. Dist. N. Y., Wheeler, J., and distinguished by the court from the latter case.

Wilson *v.* Sherman, 1 Blatchf. C. C. 536, 1850, North. Dist. N. Y., Nelson, J.

Is explained in *Goodyear* v. *Union India Rubber Co.*, 4 Blatchf. C. C. 66, 1857, South. Dist. N. Y., Ingersoll, J., as being a case where the jurisdiction of a federal court in equity in a patent suit was sustained, a license having been granted, but forfeited for noncompliance with its conditions.

Wilson *v.* Simpson, 9 How. 109, 1849, Supr. Court, Wayne, J.

Is explained in *Day* v. *Union India Rubber Co.*, 3 Blatchf. C. C. 491, 1856, South. Dist. N. Y., Hall, J., as not deciding that the right of an assignee or grantee

of the original term of a patent does not extend beyond the use of machines which such assignee or grantee had in operation when the extended term commences, though containing expressions favoring that view.

Is said in *Aiken* v. *Manchester Print Works*, 2 Cliff. 439, 1865, Dist. N. H., Clifford, J., to affirm the same rule as to repairing parts of a patented machine by the purchaser as decided in the latter case; that is, he may repair the machine or improve upon it.

Wilson *v.* **Stolley**, 4 McLean, 275, 1847, Dist. Ohio, McLean, J.

Said in *Wortendyke* v. *White*, 2 Ban. & A. 28, 1875, Dist. N. J., Nixon, J., to decide that when a person licensed to run a patented machine sold it to another, the license to run the machine did not necessarily pass to the grantee.

Wilson *v.* **Stolley**, 5 McLean, 1, 1849, Dist. Ohio, *per Curiam*.

Is affirmed in *Pulie* v. *Derby*, 5 McLean, 336, 1852, Dist. Ohio, *per Curiam*, upon the point that where a patent suit is founded upon a contract of license, the circuit court has no jurisdiction.

Wilson *v.* **Turner**, 7 Law Rep. 527, 1845, Dist. Md., Taney, C. J.

The opinion of Mr. Chief-Justice Taney is adopted in *Day* v. *Union India Rubber Co.*, 3 Blatchf. C. C. 491, 1856, South. Dist. N. Y., Hall, J., to the effect that the assignee or grantee of a patent right for the original term takes the same right during the extended term.

Wilton *v.* **The Railroads**, 1 Wall. Jr., 195, 1847, East. Dist. Penn., Grier, J.

Is said in *Planing Machine Co.* v. *Keith*, 101 U. S. 493, 1879, Supr. Court, Strong, J., to settle the ques-

tion that only the names of those who invented or used an anticipating machine, and not the names of the witnesses to prove prior use, need be notified under the act of Congress.

Winans *v.* **Denmead**, 15 How. 344, 1853, Supr. Court, Curtis, J.

Is quoted in *Eddy* v. *Dennis*, 95 U. S. 569, 1877, Supr. Court, Hunt, J., to the point that although a particular geometric form of machine is best, yet, if other forms give substantially the same results, they are infringements.

"It is generally true that when a patentee describes a machine and then claims it as described, he is understood to intend to claim, and does by law actually cover, not only the precise forms he has described, but all other forms which embody his invention; it being a familiar rule that to copy a principle or mode of operation described is an infringement, although such copy should be totally unlike the original in form or proportions." Quoted in *Grier* v. *Castle*, 17 F. R. 524, 1883, West. Dist. Penn., McKennan, J.

The language of the court in this case, to the effect that a patent for a machine covers all forms of machines which embody the invention, although such words as "however its form or proportions may be varied" are not used in the claim of the patent, is quoted in *La Rue* v. *Western &c. Co.*, 28 F. R. 90, 1886, South. Dist. N. Y., Brown, J.

Wollensak *v.* **Reiher**, 115 U. S. 96, 1885, Supr. Court, Matthews, J.

Is cited in *Gage* v. *Kellogg*, 23 F. R. 894, 1885, North. Dist. N. Y., Coxe, J., as affirming the doctrine that a reissue which claims a different invention from the original patent is void.

Is quoted from at length in *Ives* v. *Sargent*, 119 U. S. 661, 1886, Supr. Court, Matthews, J., to the effect that if a patentee understands what he has invented, he will know, on inspection of his patent when first issued, whether it covers his invention, and therefore any delay to have a mistake corrected after that is *laches*.

The language of the court in this case is quoted in *Arnheim* v. *Finster*, 26 F. R. 280, 1886, South. Dist. N. Y., Coxe, J., to the effect that a patent, when issued, immediately notifies the inventor, if he is conscious of the nature and extent of his invention, whether or not the patent covers the area of his invention.

Governed the decision in *Hoe* v. *Knap*, 27 F. R. 212, 1886, North. Dist. Ill., Blodgett, J.

Wood, *Ex Parte*, 9 Wheat. 609, 1824, Supr. Court, Strong, J.

"As patents are not enrolled in the records of any court, but among the rolls of the department of State, it was necessary to give some direction as to the character, time, and manner of instituting proceedings to repeal them." Quoted in *Attorney-General* v. *Rumford Chemical Works*, 2 Ban. & A. 311, 1876, Dist. R. I., Shepley, J.

Wood *v.* **Cleveland Rolling Mill Co.**, 4 Fisher, 550, 560, 1871, North. Dist. Ohio, Swayne, J.

Language of Swayne, J., to the effect that the defence of prior use or previous knowledge must be established by evidence beyond a reasonable doubt, is quoted in *Hawes* v. *Antisdel*, 2 Ban. & A. 11, 1875, East. Dist. Mich., Longyear, J.

Remarks of Swayne, J., as to the credibility of witnesses testifying to a want of novelty in an invention, quoted in *Hawes* v. *Antisdel*, 2 Ban. & A. 22, 1875, East. Dist. Mich., Longyear, J.

Is cited in *Thayer* v. *Hart*, 20 F. R. 694, 1884, South. Dist. N. Y., Coxe, J., to the effect that the defence of prior use should be made out beyond a reasonable doubt on the evidence. See *Collins* v. *Peebles*.

Wood Paper Patent, 23 Wall. 566, 1874, Supr. Court, Strong, J.

Is referred to in *Powder Co.* v. *Powder Works*, 98 U. S. 139, 1878, Supr. Court, Bradley, J., as deciding that a reissue, to be valid, must be for the same invention as the original patent.

Is said in *Badische Anilin, &c. Fabrik* v. *Cochrane*, 4 Ban. & A. 220, 1879, South. Dist. N. Y., Wheeler, J., to decide that the non-patentability of the invention in this case was decided because the paper pulp sought to be covered by the patent was not *made* by the process, but extracted by it merely, and was cellulose before and after the treatment, — an extract, and not a compound.

Woodruff *v.* **Barney**, 1 Bond, 528, 1862, South. Dist. Ohio, Leavitt, J.

Is cited, in *Cornelly* v. *Markwald*, 24 F. R. 187, 1885, South. Dist. N. Y., Wallace, J., as giving the reasons fully why the expense of obtaining a model of the defendant's infringing machine should not be allowed to the plaintiff in his taxable costs.

Woodworth *v.* **Sherman**, 3 Story, 178, 1844, Dist. Mass., Story, J.

The language of Story, J., in this case, is quoted in *Johnson* v. *Wilcox & Gibbs Sewing Machine Co.*, 27 F. R. 690, 1886, South. Dist. N. Y., Wallace, J., to the effect that the language of an assignment cannot be extended beyond its ordinary import.

Woodworth *v.* **Stone**, 3 Story, 749, 1845, Dist. Mass., Story, J.

Is cited in *Wheeler* v. *McCormick*, 8 Blatchf. C. C.

274, 1871, South. Dist. N. Y., Woodruff, J., as deciding that a bill in equity will lie upon well-grounded proof of a defendant's intention to violate a patent right, although no infringement has as yet taken place.

Woodworth *v.* **Weed**, 1 Blatchf. C. C. 165, 1846, North. Dist. N. Y., Nelson, J.

Is distinguished in *Hartshorn* v. *Day*, 19 How. 222, 1856, Supr. Court, Nelson, J.

Is explained in *Goodyear* v. *Union India Rubber Co.*, 4 Blatchf. C. C. 66, 1857, South. Dist. N. Y., Ingersoll, J., as sustaining the jurisdiction of the federal court in a suit in equity on a patent where a license had been given and forfeited for non-payment of the license fee.

Is stated briefly in *Abbett* v. *Zusi*, 5 Ban. & A. 40, 1879, Dist. N. J., Nixon, J., as a case where the license containing a stipulation that if any note given by the licensee in payment of his license fee should become due and unpaid the license should be void, Judge Nelson held that the owner of the patent might apply for an injunction against the licensee the moment that one of said notes became due and unpaid.

Woodworth *v.* **Wilson**, 4 How. 712, 1846, Supr. Court, Nelson, J.

Is cited in *Jenkins* v. *Greenwald*, 1 Bond, 132, 1857, South. Dist. Ohio, *per Curiam*, to the effect that an affidavit of a defendant that he has ceased to use the infringing machine upon service of the injunction, is not sufficient ground for dissolving an injunction and dismissing a bill.

Wooster *v.* **Handy**, 21 F. R. 51, 1884, South. Dist. N. Y., Blatchford, J.

The remarks of Blatchford, J., in this case as to the Supreme Court's decisions in 104 U. S. (*Miller* v. *Brass*

Co. and *James* v. *Campbell*) are quoted in *Odell* v. *Stout*, 22 F. R. 164, 1884, South. Dist. Ohio, Sage, J., to the effect that the rule laid down in those decisions has been repeatedly applied in later cases.

Wyeth *v.* **Stone**, 1 Story, 273, 292, 1840, Dist. Mass., Story, J.

Is said in *Emerson* v. *Hogg*, 2 Blatchf. C. C. 8, 1845, South. Dist. N. Y., Betts, J., to decide that a valid patent may be had for several machines, each being a separate and independent invention, where they all have a common purpose and are auxiliary to each other and to the same common end.

Is said in *Hogg* v. *Emerson*, 11 How. 606, 1850, Supr. Court, Woodbury, J., to have decided that in order to render different letters-patent necessary for different inventions, the inventions must be wholly independent of each other, and distinct inventions for unconnected objects, as one to spin cotton and another to make paper.

Is cited in *Sessions* v. *Romadka*, 21 F. R. 132, 1884, East. Dist. Wis., Dyer, J., to the point that a single patent cannot be taken for two distinct machines, designed for totally different and independent objects.

Y.

Yale Lock Co. *v.* **Sargent**, 117 U. S. 536, 553, 554, 1885, Supr. Court, Blatchford, J.

Is said in *Kittle* v. *Hall*, 30 F. R. 240, 1887, South. Dist. N. Y., Coxe, J., to decide that a patentee who has retained during the term of the reissue an invalid claim, may recover upon the valid claims, though no disclaimer has been filed or is possible when he brings suit.

Yale Lock Co. *v.* Scovill Manuf. Co., 18 Blatchf. C. C. 248, 1880, Dist. Conn., Shipman, J.

Is distinguished, in *Siebert Cylinder, &c. Co.* v. *Harper Lubricator Co.*, 4 F. R. 333, 1880, Dist. Conn., Shipman, J., from the latter case, on the ground that in the former the invention described in the reissue was manifestly the same which formed the subject of the original specification, but was there cramped within too narrow bounds; in the latter case the invention which was described in the two latter claims of the reissue was not the same which was the subject of the original specification, and those claims were therefore void.

The opinion in this case is quoted from in *Parker & Whipple Co.* v. *Yale Lock Manuf. Co.*, 18 F. R. 47, 1883, Dist. Conn., Shipman, J., to the effect that if a patentee has made a palpable mistake and has limited his real invention by a misstatement of principles so as to lose the fruits of his labor, he should be permitted to enlarge his statements in the specification of the reissue so as to cover the invention which was plainly the subject of the original application, although there limited to a narrow patent by the misstatement.

Z.

Zinn *v.* Weiss, 7 F. R. 914, 1881, East. Dist. N. Y., Benedict, J.

Is cited and explained in *La Rue* v. *Western, &c. Co.*, 28 F. R. 90, 1886, South. Dist. N. Y., Brown, J.

INDEX.

A.

ABANDONMENT, what is, 40.
may be presumed from unexplained delay, 3, 105, 107, 126, 181, 182, 193, 198.
in applying for patent, 105.
but not from delay during experiments, 105.
when presumed from delay between rejected and renewed application, 107, 126.
or from acts after rejected application, 159.
application on file rebuts such presumption, when, 3, 19.
renewed application affects it how, 70, 75, 76.
by express dedication, 107.
by public use for two years, 157.
by negligence, 198.
not by solicitor's negligence, when, 16.
of part of machine by claiming only another part, 44.
how far decided conclusively by commissioner, 214.
See NEGLIGENCE; APPLICATION; PATENT.

"ABOVE DESCRIBED METHOD," these words in claim annex the specification, 18.
See PATENT, CONSTRUCTION OF.

ACCOUNT, as basis of equity jurisdiction in federal courts, when sufficient, 50, 54, 55, 89, 100, 101, 116, 117, 143, 149.
See JURISDICTION; FEDERAL COURTS.

ACCOUNTING, master's fees for, to be paid by defendant, 21.

ACQUIESCENCE, in infringement, when delay is not, 215.

ACT OF CONGRESS, relating to patents, is only basis of federal courts' jurisdiction, 18, 22, 23, 72, 73, 74, 85, 86, 93, 113, 114, 127.
See FEDERAL COURTS; JURISDICTION.

ACT OF CONGRESS — *continued.*
specially granting patents, how construed, 56.
effect of, on assignments, 65.
extending patents, 3.
See CONGRESS.
ACTION AT LAW, against vendees of infringer, when enjoined, 16.
See INJUNCTION.
pleading special matter in, 79.
See PLEADING; PRACTICE.
plaintiff in, who may be, 143.
measure of damages, what, 14, 15.
royalty, when proper measure, 15.
See DAMAGES.
ADMINISTRATOR, succeeds to licensee's rights, when, 146.
See LICENSE.
AFFIDAVIT, to application, informality of, does not affect patent, 94.
is conclusively settled, by issuing patent, 192.
AGENT, when not liable for infringement, 47.
AGGREGATION OF OLD ELEMENTS, not patentable, 16, 81, 82, 83.
See COMBINATION; PATENTABILITY.
ALBERTSON PATENT, No. 2,386, construed, 122.
AMBIGUOUS LANGUAGE IN REISSUE, construed strictly, 31.
See REISSUE; PATENT, CONSTRUCTION OF.
AMENDMENT OF APPLICATION FOR PATENT, 167, 168.
See PATENT, APPLICATION.
ANNULLING PATENT, suit to, 8.
must be by Government, 139, 140.
See GOVERNMENT.
ANSWER, does not overrule plea, 203.
ANTICIPATION OF PATENT, by prior machine, must be the same invention, 151.
and an operative machine, 152.
and complete, as to invention, 36, 37, 62, 63, 94, 99, 169, 190.
and must produce same result, 170.
by prior printed publication, what is, 34, 38, 49.

ANTICIPATION OF PATENT—*continued.*
by foreign publication, 191, 192.
by abnormal use of another's machine, when, 34.
effect of, 73.
must be set up in answer, 171.
or evidence of is inadmissible on objection, 173.
burden of proof is on defendant, 37, 88.
must be proved beyond reasonable doubt, 37, 155.
See PRIOR KNOWLEDGE AND USE.
APPLICATION FOR PATENT, if delayed by experiments, not abandoned, 105.
amendment of, 167, 168.
rejected, evidence of abandonment, when, 3, 40, 159, 199.
are abandoned experiments, 43.
renewed after rejection, effect on abandonment, 43, 70, 75, 76.
several successive, when considered one, 13, 14, 19.
affidavit to, effect of informality in, 94.
See ABANDONMENT; PATENT, APPLICATION FOR
ART, may be patented as a process, 36.
ASSIGNEE OF PATENT, who is, 160, 211.
when may sue for infringement in his own name, 62, 63, 64, 101, 160.
of record, patent may issue to, 186.
has right to use machine during extension, when, 19, 20.
succeeds to license rights, when, 146.
in insolvency, has not legal title, 7.
may compel patentee to assign, 7.
has licensee's rights, when, 146.
See PRACTICE; TERM; EXTENSION; ASSIGNMENT.
ASSIGNMENT OF PATENT, what is, 7, 114.
must be in writing signed by owner of patent, 7.
does not carry right to sue for past infringement, 48, 136, 137.
what language in, conveys extension, 31, 35, 63, 89, 145, 155, 167, 225, 228.
effect of, during extension, 225, 228.
gives right to sue in assignee's name, when, 62, 63, 64.
See EXTENSION.
includes renewal, when, 117.
language naturally construed, 231.

ASSIGNMENT OF PATENT—*continued*.
differs from license, 64.
of personal right to sell, 84.
of such right to corporation ends with corporation, 84.
record of before issuing patent vests legal title in assignee, 62, 64, 65, 158.
effect of, after issuing patent, 64.
non-record of, effect on later assignment, 21.
unrecorded, in suit against third person, 21, 158
not void, though unrecorded, 21.
of patent granted by special act of Congress, 65.
ATTORNEY-GENERAL, suit in name of, 8, 14.

B.

BALL REISSUE, invalid, 9.
BELL, first invented speaking-telephone, 4.
patent is for a process, 4.
not anticipated by Reis, 4.
BILL IN EQUITY, by creditor to take patent-right for debt, 3, 204.
for account only, no jurisdiction of, 174, 175, 176, 182, 197.
but for account and answer, treated as bill for discovery, 135.
See JURISDICTION; FEDERAL COURTS.
may contain several patents, when, 69, 96, 142, 143, 145, 146, 191.
or several infringements of one patent, 70.
not dismissed on affidavit that defendant has ceased to use infringing machine, 232.
will lie if intention to infringe is proved, 232.
dismissed if showing void patent, 33, 51.
dismissed by Supreme Court of its own motion, 196.
may be dismissed on exception to master's report, 59.
plaintiff, who may be, 143.
by licensee, when exclusive, 218.
to review commissioner's decision, additional evidence admissible, 7.
is not an appeal from the office, 28, 29.
See EQUITY; PRACTICE; COMMISSIONER.

BOND FOR PAYMENT OF DAMAGES, not without sureties, 177.

BURDEN OF PROOF, of prior use, is on defendant, 38, 88.
not met, if his evidence is conflicting and unsatisfactory, 45.
See ANTICIPATION; PRIOR KNOWLEDGE AND USE.

C.

CAWOOD PATENT, explained, 211.

CITY, liable for use of patented machine, 19.
See INFRINGEMENT.

CLAIM OF PATENT, limits the invention, 26, 27, 47, 170.
governs the construction of patent, 107, 108, 170.
is illustrated by specifications, drawings, and models, 18, 22, 27, 47, 107.
how interpreted, 18.
liberally construed, 109.
to protect the invention shown, 54.
estops patentee to claim more, 121.
waiver of, is estoppel, 29.
rejected cannot be reissued, 194, 199.
is not inadvertence, so as to entitle a reissue, 6.
if one in reissue void, others may be good, 60.
same as in original patent, good, 60, 78.
See REISSUE; PATENT, CONSTRUCTION OF.
for product, must be interpreted with process, 121.
See PROCESS; PRODUCT.

COMBINATION OF OLD ELEMENTS, when patentable, 3, 12, 58, 81, 82, 83, 117, 122, 138, 156, 157, 169, 184, 204, 215.
additions to, when patentable, 10.
change of location of part, when patentable, 3, 122, 160, 203, 204.
of parts of machine, 58.
See PATENTABILITY.
patent for, covers equivalents, 39, 45, 68, 74, 77, 78, 190, 191.
what is infringement of, 77, 164, 165, 215, 218, 219.
See INFRINGEMENT.

COMBINATION OF OLD ELEMENTS—*continued.*
all parts of, are material, 57, 218, 219.
cannot be reissued for smaller number, 42, 67, 68, 69, 91.
subcombinations may be claimed in reissue, 42, 164.
See REISSUE.
COMMISSIONER OF PATENTS may decide whether different inventions may be put in one patent, 13.
had authority to grant reissue before any act of Congress, 193.
may issue valid patent to replace void one, 79.
his mistake allows expansion of claim is reissue, 177, 178.
decision of, granting reissue, how far conclusive, 65, 66, 92, 106, 107, 118, 142, 188.
See REISSUE.
decision of, how far conclusive as to validity of interfering patents, 212.
as to validity of extension, 177.
as to combining inventions in one patent, 13.
as to abandonment, 214.
decision of, reviewed by bill in equity, 7.
See BILL IN EQUITY; EQUITY; DIFFERENT INVENTIONS.
COMPENSATORY DAMAGES, when allowed, 122.
See DAMAGES.
CONGRESS, act of, not necessary to reissues, 193.
special, extending patent, 3.
special, granting patents, construction of, 56.
violation of obligation of contracts by, 56.
authority of, to grant patent after public use, 18, 19.
See ACT OF CONGRESS; FEDERAL COURTS; JURISDICTION.
CONSENT OF INVENTOR to use before patent, effect of, 123, 124.
See PUBLIC USE; PATENT.
CONSTRUCTION OF PATENT, and reissue to decide identity of invention, 11, 17.
See REISSUE.
of primary patent, liberal, 125.
See PATENT.
of patent, limited by claim.
See CLAIM; PATENT, CONSTRUCTION OF.
CONTRACT, violation of, by act of Congress, 56.
See CONGRESS, ACT OF.

CONTRACT — *continued.*
of license, affects jurisdiction, 18, 22, 23, 72, 73, 74, 85, 86, 93, 113, 114, 127.
See FEDERAL COURTS; JURISDICTION; LICENSE.
CORPORATION, must be sued in State of incorporation, 46, 159, 166, 186, 224.
See PRACTICE.
COSTS, how affected by disclaimer, 60, 61.
See DISCLAIMER.
plaintiff's, do not include model of defendant's machine, 100, 231.
defendant's, include models of plaintiff's machine, 87.
See MASTER'S FEES; PRACTICE.
COUNSEL FEES, when allowed as damages, 152.
COUNTY, liable for infringement, 102, 123.
COURT, how far it may review decision of commissioner as to reissue, 107, 118.
See COMMISSIONER; REISSUE.
may inspect patent and reissue, as to identity of invention, 11, 17.
CREDITOR'S BILL, to seize patent-right for debt, 3.

D.

DAMAGES, measure of, no rule covers all cases, 15.
how estimated, 14.
plaintiff must prove, 17, 18, 53, 91, 105, 144, 156, 188.
or he gets only nominal, 17, 18, 105, 144, 156, 188.
not presumed in his favor, 18.
license fee, when measure of, 15, 18, 25, 115, 148, 149. 182, 187, 188.
if none, actual damages, 25, 207.
royalty the measure of, at law, 14, 15, 36, 148, 149.
may waive license fee by asking injunction, 202.
how qualified, 15.
actual damages, when, 15, 187.
what is evidence of license fee, 18.
profits, measure of, in equity, 14, 15, 25, 26, 115, 116, 149, 188.
profits, what are, 32.

DAMAGES — *continued.*
profits and damages both, by statute, 15, 30, 152.
profits must be proved by evidence, 53.
are actual profits, 46, 116, 178.
not what infringer might have made by due diligence, 46.
if patent only on part of machine, profits restricted to that part, 78, 138, 139, 140, 141, 156, 183.
unless that device gives the whole machine its only market value, 48, 183.
plaintiff must separate profits of his device from the rest of the machine, 61, 62, 91.
or show the whole machine gets its value from his device, 62.
if there are no profits, there is no account, 52.
but now, by statute, actual damages may then be given, 52, 53.
interest on, not generally allowed, 114, 139, 140, 141, 152, 195.
only under special circumstances, 114, 139, 140, 141.
as profits are unliquidated damages, 142.
do not include counsel fees, 152.
may include compensation for party's time, 152.
may include rebate for salaries of managing officers, 177.
how affected by laches, 144.
compensation allowed if profits lost by defendant's negligence, 122.
right to past, not carried by assignment, 136, 137.
See ASSIGNMENT.
payment of, no title to machine, 17.
but payment of damages and profits both, gives right to use machine, 155.

DECREE, final, what is, 10, 12, 196.
for injunction and account is not, 10.
in another circuit on same part, effect of, 3, 75, 76.
See JUDGMENT.

DEDICATION TO PUBLIC, as to, 104, 193.
is abandonment, 107.
See ABANDONMENT.
by not claiming process in reissue, 104, 120.
See REISSUE.

DEFENCES, inconsistent, what are, 16.
See PLEADING; PRACTICE.

DELAY, if negligent, forfeits right to patent, 3, 181, 182.
if explained, does not, 3.
in securing reissue, effect of on original patent, 128.
when is not acquiescence in infringement, 215, 216.
See ABANDONMENT; INFRINGEMENT.
DEMURRER, not overruled by answer, 203.
DESIGN PATENT, 145.
what is infringement, 76, 77.
DIFFERENT INVENTIONS, when may be combined in the same patent, 10, 13, 55, 56, 94, 123, 136.
commissioner's decision, how far conclusive, 13.
patents, when may be joined in one bill in equity, 69, 96, 142, 143, 145, 146, 191.
See BILL IN EQUITY; COMMISSIONER; PATENT.
DIRECTOR OF COMPANY, ordering infringement, when personally liable, 112.
See INFRINGEMENT.
DISCLAIMER, validity of, 75.
when necessary, 83.
how far estoppel, 110.
affected by provisos in patent, 182.
when may be filed, 60, 61.
negligence in filing must be set up in answer, 23.
effect of, on costs, 60, 61.
See ESTOPPEL; CLAIM; COSTS.
DIVISIBILITY OF LICENSE, depends on its terms, 22.
See LICENSE.
DOUBLE USE, not patentable, 12, 24, 34, 99, 153, 154, 172.
See PRIOR USE; ANTICIPATION.
DRAWINGS, may be filed with specification, when, 21, 217. 218.
limit claim, 22, 26, 27.
See SPECIFICATION; CLAIM.

E.

ELECTRO PLATING, state of the art in, 213.
ELEMENT, application of, to use, not patentable, 146.
See PATENTABILITY.

EMPLOYEE, forfeits right to patent, when, 124.
presumed license by, to employer, when, 125.
See LICENSE.
liable for infringement, when, 47.
See INFRINGEMENT.

EQUITY IN PATENT SUITS is the same as in any other, 50, 54, 55.
may declare two interfering patents void, 71, 72.
will seize patent right on execution, 3, 204.
will enjoin suit at law, when, 16.
or compel assignment to assignee in insolvency, 7.
has no jurisdiction of bill for account alone, 174, 175, 176, 182, 197.
nor if no injunction is asked, 143, 149.
because patent has expired, 40.
and does not hold infringer trustee, so as to support jurisdiction, 15, 25, 44.
has jurisdiction though patent expires soon after bill filed, 34.
See FEDERAL COURTS; JURISDICTION; ACCOUNT.
but may not grant injunction, 4.
See INJUNCTION.
has no jurisdiction if license exists, 18, 28, 72, 73, 74, 85, 86, 93, 113, 114, 127.
but has if license is forfeited, 22, 23, 85, 86.
See FEDERAL COURTS; JURISDICTION; LICENSE.
has jurisdiction to enjoin violation of contract, 196.
may grant injunction, without trial at law, 72, 73, 195.
may order infringing machine destroyed, 17.
when grants preliminary injunction, 151.
See INJUNCTION.
bill in, on two patents, is good, 69.
See BILL IN EQUITY.
special plea in, when, 192.
See PLEADING.
decree in, for injunction and account, not final, 10, 12.
See DECREE.
measure of damages in, 14.
royalty when, 14, 15.
gains and profits when, 14, 15, 25, 26, 115, 116, 149, 188.
license fee, when, 15.

EQUITY IN PATENT SUITS — *continued.*
profits and damages both, when, 15, 30, 152.
See DAMAGES.
EQUIVALENTS, what are, 31, 40, 59, 68.
are covered by patent, 157.
See PATENT.
apply to combination, 39, 45, 68, 69, 190, 191.
when not to process patents, 45.
See COMBINATION; PROCESS; REISSUE.
ESTOPPEL, how far disclaimer may be, 110.
See DISCLAIMER.
by waiver of claim in record, 29.
by description in claim, 43, 108, 121.
See CLAIM.
by delay, from claiming reissue, 103.
after adverse rights have accrued, 104.
See REISSUE; ABANDONMENT; DELAY.
by silence, 39.
by enforcing contract of license, 16.
by sale of patent right, 57.
by sale of machine, 77.
carries after acquired title, 57.
prevents prosecution for infringement, 77.
See WARRANTY; TITLE.
by previous judgment, 181.
See DECREE; JUDGMENT.
EVIDENCE, of prior knowledge and use, 36, 63.
of prior use, burden is on defendant, 37, 88.
if his is conflicting, is insufficient, 45, 100.
should be strictly scrutinized, 100.
See PRIOR KNOWLEDGE AND USE.
of damages, plaintiff must give, 17, 18.
by proving license fee, when, 18.
See DAMAGES.
of abandonment, solicitor's neglect, when is not, 16.
See ABANDONMENT; DELAY; NEGLIGENCE.
extrinsic, when used to explain patent, 11, 17.
See PATENT, CONSTRUCTION OF.
additional, in review of commissioner's decision, 7.
See COMMISSIONER.
new, opening cause for, after decree, 24, 25.
See PRACTICE.

EXECUTOR, succeeds to license of deceased, when, 146.
See LICENSE.
EXECUTION, levied on patent right, 3, 204.
See BILL IN EQUITY; EQUITY.
EXPERIMENTS, may delay application for patent, 105.
incomplete, cannot anticipate complete invention, 73, 152.
See ANTICIPATION; APPLICATION FOR PATENT; PATENT.
EXPIRATION OF PATENT, how it affects jurisdiction in equity, 34, 143, 149.
See EQUITY; JURISDICTION; FEDERAL COURTS.
how it affects right to injunction, 4.
See INJUNCTION; EQUITY.
how affected by foreign patent, 9, 54, 60, 71, 90, 96, 147, 148, 170, 197, 220.
See FOREIGN PATENT; TERM OF PATENT.
EXTENSION OF PATENT, when passes under assignment, 31, 35, 63, 89, 145, 155, 167, 225, 228.
may be issued to assignee, 89.
inchoate right to, is salable, 35.
rights of assignee under, 19, 20.
by special act of Congress, 3.
See ASSIGNMENT; PATENT.

F.

FACTORY, use in, is public use, 123.
See PUBLIC USE.
workman in, when forfeits right to patent, 124.
See LICENSE.
FEDERAL COURTS, have jurisdiction in patent cases only by act of Congress, 115.
nature of jurisdiction, 207.
in equity, governed by rules of equity, 50.
See EQUITY.
have no jurisdiction in equity after patent expires, 34, 50, 54, 55, 89, 100, 101, 105, 143, 149, 174, 175, 176.
have no jurisdiction of suit based on license, 18, 22, 23, 28, 72, 73, 74, 85, 86, 93, 113, 114, 127, 204, 225, 226, 227.
but have if license is forfeited, 22, 23, 72, 73, 74, 85, 86, 93, 113, 114, 127, 232.
See EQUITY; JURISDICTION; EXPIRATION OF PATENT.

FEDERAL COURTS — *continued*.
not affected by State statute of limitations, 38, 39, 88, 150, 151, 168, 171, 185, 186.
See LIMITATIONS, STATUTE OF.
suit in, against State court receiver, when, 10.
FINAL DECREE, one for injunction and account is not, 10, 196.
See DECREE.
FIRE DEPARTMENT, is agent of city and not accountable for infringement, 4.
See INFRINGEMENT; DAMAGES.
FOREIGN COUNTRY, use of invention in, when a defence, 106.
See PRIOR USE.
FOREIGN PATENT, how it affects term of United States patent, 9, 54, 60, 71, 90, 96, 147, 148, 170, 197, 220.
See EXPIRATION OF PATENT; PATENT; TERM OF PATENT.
when perfected, 99, 198.
FOREIGN PUBLICATION, effect of, on United States patent, 191, 192.
See PRIOR KNOWLEDGE AND USE.
FORFEITURE, of right to patent by delay, 3.
See ABANDONMENT; DELAY; ESTOPPEL.
of license, by breach of covenant, 85, 86.
See LICENSE.
FORMER PATENT, effect of, on later patent for part of same machine, 30.
See CLAIM; ESTOPPEL.

G.

GILL MACHINE, state of art as to, 28.
GOVERNMENT, annulling of patent by, when, 8, 139, 140.
See ANNULLING; PRACTICE.
cannot use patented article without compensation, 103, 214.
See INFRINGEMENT.
GRANTEE, who is, 160.
right to use machine during extended term, 19, 20.
See EXTENSION; PATENT.
GREEN PATENT, construed, 5, 6.

H.

HAMILTON PATENT INVENTION, referred to, 102.
" HEIRS," effect of this word in patent, 193.

I.

IDENTITY of invention, in patent and reissue, decided by the court, 11, 17.
See REISSUE; COURT.
of invention in interference, 17.
what is, 56, 57.
IMPROVEMENTS, when patentable, 7, 8.
on combinations, when patentable, 10.
on different machines, when to be included in same patent, 10, 13, 55, 56, 94, 123, 136.
commissioner decides this, 13.
See COMMISSIONER; DIFFERENT INVENTIONS.
damages for infringement of, are profits, 78.
INADVERTENCE, as ground for reissue, none given by rejected claim, 6, 103, 104.
INFRINGERS, how far joint owners may be, 158.
See JOINT OWNERS; INFRINGEMENT.
not trustee so as to give jurisdiction, 116, 148.
See FEDERAL COURTS; JURISDICTION.
gets right to use machine by paying full damages and profits, 154, 155.
See DAMAGES.
vendees of, when not suable, 16.
See INJUNCTION; EQUITY.
purchaser at marshal's sale, when is, 32, 33.
See INFRINGEMENT.
when joint patentees may be, 35, 158.
when licensee of joint patentees may be, 35.
sheriff by sale of materials is not, 184.
purchaser at marshal's sale, when may be, 33.
county may be, 102, 123.
city may be, 19.
fire department of city, not, 4.

INFRINGERS — *continued.*
director of company is not, 112.
agent is not, when, 47.
workman or employee is not, 47.

INFRINGEMENT, what constitutes, 194.
is a question of fact, 106, 224, 225.
requires identity of machines, 17, 212, 213.
of patent on part of machine, 115, 120, 121.
of combination patent, 77, 164, 165, 215, 218, 219.
by use of equivalents, 39, 45, 74, 190, 191.
of subcombinations, 164.
See COMBINATION.
several, when may support several suits, 222.
several, when may be included in same bill, 70.
right of action for, barred by surrender of patent, 135.
is intentional and deliberate, when, 181.
of design patent, what is, 76, 77.
right of action for past, does not pass by assignment, 48, 136, 137.
damages for, paid, give no title to machine, 17.
machine may be ordered to be destroyed, 17.
damages and profits give license, 154, 155.
by several, making different parts, 184, 185, 216, 217, 221.
by joint patentees, 35.
by sheriff, selling materials at sale, 184.
by purchaser at marshal's sale, 33.
county liable for, 102, 123.
city liable for, 19.
but fire department of city not, 4.
director of company, how far personally liable for, 112.
agent not liable for, when, 47.
workman, or employee, when, 47.
suit for, barred by consent of inventor before patent, 123, 124.
what proof of will not support bill in equity, 201.

INJUNCTION, preliminary, not granted when validity of patent is doubtful, 80, 103, 184.
when granted, 10, 66, 151.
may be granted, though no trial at law, 195.
may be refused, though plaintiff has judgment at law, 57.
as to granting final, after expiration of patent, 4.

INJUNCTION — *continued.*
effect of loss of right to, on jurisdiction, 50, 54, 55, 89, 100, 101.
See FEDERAL COURTS; JURISDICTION.
decree for, not final decree, 10.
See DECREE; EQUITY.
upon suit against vendees of infringer, 16.
See EQUITY.

INSOLVENCY, assignee in insolvency does not get legal title to patent, 7.
See ASSIGNMENT.

INTENTION to infringe, proof of, will support bill in equity, 232.
See BILL IN EQUITY.

INTEREST, not generally allowed on damages, 114, 139, 140, 141, 152, 195.
except when intentional, or under special circumstances, 114, 139, 140, 141.
See DAMAGES.

INTERFERING PATENTS, may both be declared void by court, 59, 71, 72, 212.
See COURT.

INVENTION, necessary to give patentability, 44, 78, 95, 127, 128, 149, 153, 168, 169, 200, 202, 209.
what is, 168, 169.
differs from mechanical skill, 168, 169.
is property before patent, 105.
patentability of, strictly examined, 7, 8, 78, 196, 200.
See PATENTABILITY.
different, when may be included in same patent, 10, 13, 55, 56, 94, 123, 136.
commissioner decides this, 13.
See DIFFERENT INVENTIONS; PATENT; COMMISSIONER.
described and not claimed in previous patent may be patented, 78, 206.
See ESTOPPEL; PATENTABILITY.
priority of, 169.
joint or separate, 10.

J.

JOINT INVENTOR, who is, 10.
JOINT PATENTEES, or owners, not infringers, 35, 158.
JUDGMENT OF CO-ORDINATE COURT, how far followed, 171, 209, 218.
See DECREE.
JUDICIAL NOTICE, of lack of novelty, 23, 24.
JURISDICTION, of federal courts, in equity in patent case, nature of, 207.
given by act of Congress, 115.
depends on right to injunction, 50, 54, 55, 100, 101, 105, 174, 175, 194, 195, 197, 204.
account alone will not support, 50, 54, 55, 89, 100, 101, 174, 175, 176, 182, 195, 197.
does not exist after expiration of patent, 34, 40, 143, 149, 175, 176.
none based upon infringer as trustee, 15, 25, 44, 116.
See BILL IN EQUITY; EQUITY; FEDERAL COURT.
in patent cases, how affected by an existing license, 18, 22, 23, 28, 72, 73, 74, 85, 86, 93, 113, 114, 127, 203, 204, 225, 226, 227.

K.

KING PATENT, reissue, No. 3,000, construed, 108.

L.

LACHES, in claiming reissue, 103, 104.
See ABANDONMENT; DELAY; NEGLIGENCE.
effect of, on account of profits, 144.
See DAMAGES.
LEATHER PEBBLING MACHINE, patent for, 205.
LEGAL TITLE, to patent, cannot be conveyed by receiver, 76.
vests in assignee when patent is issued, 62.
See ASSIGNMENT.
LICENSE, differs from assignment, 64.
how far personal, 84, 146, 210, 211.

LICENSE — *continued.*
must be to assigns, to be assignable, 210, 211.
divisibility of, depends on its terms, 22.
if to corporation and not assignable, ends with dissolution of corporation, 84.
See ASSIGNMENT.
limited as to locality, effect of, 87, 88, 126.
on use of machine, 1, 2, 3.
as to selling old goods, 84.
forfeited by breach of covenant, 85, 86.
revoked by notice, 84.
when inferred from relation of parties, 32.
when presumed, 124.
may be pleaded with general issue, 46, 55, 117.
or denial of validity of patent, 55, 117.
how far is an estoppel, 117.
See PLEADING; PRACTICE; ESTOPPEL.
fee is proper measure of damages, when, 14, 15, 18, 182.
as affecting jurisdiction of Federal Courts, 18, 22, 23, 28, 72, 73, 74, 85, 86, 93, 113, 114, 127, 203, 204, 225, 226, 227.
See FEDERAL COURTS; JURISDICTION.
when suit may be in licensee's own name, 64, 218.
LICENSEE, may sue patentee when, 113, 203.
may sue in his own name when, 64, 218.
may join as plaintiff, 83.
of joint patentee is not infringer, 35.
to use, effect of sale by, 228.
See INFRINGEMENT; PRACTICE; BILL IN EQUITY.
LIMITATIONS, State statute, effect of, on suit in federal courts, 38, 39, 88, 150, 151, 168, 171, 185, 186.
See FEDERAL COURTS.
to application for patent, after two years' sale, 5.
See PRIOR USE.

M.

MACHINE, improvements on, when patentable, 7, 8, 10.
See IMPROVEMENTS.
in interference, identity of, 17, 56, 57.
See PATENT.

MACHINE — *continued.*
mode of operating when part of invention, 18, 27.
See PATENT.
infringing, may be ordered delivered up for destruction, 17.
MANUFACTURE, article of, when patentable, 198, 199, 200.
See PATENTABILITY.
MARSHAL'S SALE, purchaser at, when infringer, 33.
See INFRINGER; INFRINGEMENT.
MASTER'S FEES, for accounting, paid by defendant, 21.
See DAMAGES.
report, on exception to, court may dismiss bill, 59.
See BILL IN EQUITY.
MEASURE OF DAMAGES. See DAMAGES.
METHOD, is equivalent to process, 138.
may be patented as such, 36.
when part of invention, 18, 27.
See PROCESS; PATENT.
MODEL, of infringing machine, not part of plaintiff's costs, 100, 231.
of plaintiff's machine may be part of defendant's costs, 87.
MULTIFARIOUSNESS, when bill in equity is bad for, 191.
See BILL IN EQUITY.

N.

NEGLIGENCE, what is, 51.
of solicitor, when acts as abandonment, 3, 16, 53.
See ABANDONMENT; DELAY; ANTICIPATION.
in filing disclaimer, must be set up in answer, 26.
See DISCLAIMER.
NEW DEFENCE, when cause will be reopened for, 173.
NEW MATTER, what will invalidate reissue, 161.
See REISSUE.
NICHOLSON INVENTION, described, 53.
NITRO-GLYCERINE, patent for construed, 163.
NOMINAL DAMAGES. See DAMAGES.
NOTICE, judicial, taken of ice-cream freezer, 23, 24.
of revocation of license, effect of, 84.
given by record of assignment, 21.
See ASSIGNMENT; LICENSE.

NOVELTY, necessary to patentability, 12, 149, 153, 179.
of elements of combination, 12.
of old elements to new use, 206.
how affected by earlier patents, 61.
want of, must be set up by answer, 165.
See PATENTABILITY; PRIOR KNOWLEDGE AND USE.

O.

OATH, to application, fault in, cured by issuing patent, 192, 222.
See APPLICATION.
OLD ELEMENTS, when patentable in combination, 12.
See COMBINATION.

P.

PATENT FOR INVENTION, similarity to land patent, 141, 142.
may be for process or product, 27, 30, 36, 38, 42, 50, 73, 74, 112, 126, 135, 142, 147, 177, 198, 199, 200, 209, 210, 231.
See PROCESS; PRODUCT; PATENTABILITY.
must describe product if that is claimed, 36.
not for principle, 27, 42, 112, 210.
See PATENTABILITY.
nor for application of element of nature, 146.
nor for mere mode of operation, 27.
See PATENTABILITY.
right to, barred by sale for two years, 5, 40.
or by public use for same time, 37, 40, 51, 52, 53, 125, 205.
but Congress may grant, after two years' use, 19.
See PUBLIC USE; SALE; USE.
application for, amendment of, 167, 168.
right to, forfeited by delay, when, 3, 105.
successive applications, how treated, 13, 14, 19.
See APPLICATION; ABANDONMENT; DELAY; NEGLIGENCE.
may include distinct inventions, when, 10, 13, 55, 56, 94, 123, 136, 233.
See DIFFERENT INVENTIONS; INVENTION; COMMISSIONER.

PATENT FOR INVENTION — *continued.*
construction of, limited by claim, 47, 107, 108, 140.
illustrated by the specification, drawings, and models, 18, 22, 26, 27, 48, 107, 108.
See CLAIM.
also limited by subject-matter, 197.
primary, liberally construed, 109, 118, 125, 168.
covers all forms of same invention, 229.
or equivalents, 157.
for result, includes process, 135.
See EQUIVALENTS; PATENTABILITY; PROCESS.
informality of oath to application for, effect of, 79, 94, 192.
See OATH; APPLICATION FOR PATENT.
may be specially extended by act of Congress, 3.
See ACT OF CONGRESS.
term of, how affected by foreign patent, 9, 59, 60, 71, 90, 96, 147, 148.
See FOREIGN PATENT.
expiration of, affects jurisdiction in equity, 4, 175, 176.
after suit began, does not, 175, 176.
See JURISDICTION; FEDERAL COURTS; EQUITY.
can only be annulled by government, 8, 14, 139, 140, 178.
See GOVERNMENT.
if void, valid may be issued, 79.
void when patentee not citizen, 33.
or application is amended after applicant's death, 51.
does not exempt from State police laws, 152.
government cannot use without compensating, 103.
legal title to, does not pass to assignee in insolvency, by general assignment, 7.
legal title to, cannot be conveyed by receiver, 76.
but equitable may, 76.
See ASSIGNMENT.
may be taken by creditor, by bill in equity, 3.
See BILL IN EQUITY.
when can be sold on execution, 204.
on death of patentee, goes to administrator, 193.
may be issued to assignee of record, 186.
See RECORD.
validity of, may be tried in equity, 72, 73.
as well as at law, 72, 73.
several may be included in same bill, when, 191.

PATENT FOR INVENTION — *continued.*
cannot be expanded by reissue, 11, 17.
See REISSUE.
invalidity of, and license, when consistent defences, 16, 178.
See PLEADING; PRACTICE.
PATENTABILITY, as to, 110, 155, 220.
requires novelty, 12, 179.
is question of law, 118, 119.
not conclusively settled by commissioner, when, 118.
is strictly examined, 7, 8, 196, 200.
when examinable by the court, 178, 196, 200.
cannot be granted for new mode of operation, 27.
nor for a principle, 27, 42, 112, 210.
nor for an application of an element of nature to practice, 146.
may be for a product, when, 27, 38, 42, 50, 73, 74, 112, 126, 198, 199, 200, 210.
or articles of manufacture, 198, 199, 200.
or a process, 30, 36, 42, 73, 74, 126, 135, 142, 147, 177, 209, 210, 231.
or a method or art, as a process, 36.
requires inventive genius, 44, 78, 95, 127, 128, 149, 153, 168, 169, 200, 202, 209.
See INVENTION.
mere utility, how far a test, 54, 95, 110, 190, 198, 202.
mere mechanical skill is not, 200, 201.
of invention described in prior patent to same patentee, 11, 78, 206.
slight change in machine may be patentable, 102.
of combination of old elements, when, 10, 12, 58, 81, 82, 83, 117, 156, 157, 169.
of substitutes in a process or machine, when, 33, 45, 92, 93, 97, 98, 99, 109, 184, 199, 200.
of change in location of a part, 122.
charge of Mr. Justice Nelson, as to, 125.
of double use, 99, 153, 154, 172.
PLEADING, as to special pleas, with general issue, 17, 79, 192, 224.
special pleas of license consistent with denial of validity of patent, when, 16, 17, 46, 55, 117, 178.
bill in equity, when not multifarious, though including several patents, 69, 96, 142, 143, 145, 146, 191.

PLEADING — *continued.*
alleging several infringements, 70.
See BILL IN EQUITY.
plea not overruled by answer, when, 203.
See DEMURRER; EQUITY.
PRACTICE, as to preliminary injunction, 80.
when defendant should give bond, 80, 177.
See INJUNCTION; EQUITY.
as to district in which to sue a corporation, 46, 159, 166, 186, 224.
See CORPORATION; BILL IN EQUITY.
as to filing disclaimer, 61.
neglect to, must be set up in answer, 26.
effect of filing disclaimer, 60.
See DISCLAIMER; CLAIM; COSTS.
as to dismissing bill, 33, 51, 59, 84, 196.
See BILL IN EQUITY; COURT.
as to suit by assignee, when in his own name, 62, 63, 64, 101, 137, 143, 160.
See ASSIGNMENT; ASSIGNEE.
plaintiff must be owner of patent, 101, 137, 143.
when licensee should be joined, 83.
as to suit against State court receiver, 10.
as to compelling plaintiff to elect one of several suits, 221, 222.
as to declaring patents void, 71, 72.
See EQUITY.
master's fees to be paid by defendant, 21.
See MASTER.
as to opening cause for new evidence, 24, 25, 173.
as to new evidence in reviewing commissioner's decision, 7.
See COMMISSIONER.
as to evidence of prior use, 64.
names of witnesses not given, 171.
evidence of prior use admissible under denial of priority of invention, if not objected to, 219.
want of novelty must be notified by defendant, 165.
as to amending answer, 178.
as to final decree, what is, 10, 12.
See DECRÉE; JUDGMENT.
as to effect of decisions of other courts, 4, 5, 75, 76.
See DECREE; JUDGMENT.

PRACTICE — *continued.*
plaintiff must prove damages, 17, 18.
See DAMAGES.
compelling defendant to disclose contracts, 211.
as to granting injunction after expiration of patent, 4.
See EQUITY; JURISDICTION; FEDERAL COURTS.
of suit to annul a patent, 8.
PRELIMINARY INJUNCTION. See INJUNCTION; PRACTICE.
PRESUMPTION, none, of damages, 18.
See DAMAGES.
PRINCIPLE OF NATURE, not patentable, 27, 42, 112, 210.
See PATENTABILITY.
PRIMARY PATENT, liberally construed, 109, 118, 125, 168.
See PATENT.
PRIOR DESCRIPTION, of invention in patent to same inventor, effect of, 11, 78, 206.
See PATENTABILITY.
PRIOR INVENTION, what is necessary to anticipate a patent, 53, 169, 190, 222.
See ANTICIPATION; DELAY; NEGLIGENCE.
PRIOR KNOWLEDGE AND USE, what evidence will prove, 36, 63, 120.
must be notified in answer, 171, 208, 219.
names of witnesses to, need not be given, 62, 121, 158, 159, 171, 173, 229.
burden of proof of, is on defendant, 37, 88, 220.
must be established beyond reasonable doubt, 37, 149, 150, 155, 185, 218, 219, 230, 231.
as to credibility of witnesses, 64, 230.
in foreign country, effect of, 106, 191, 192.
See ANTICIPATION.
PRIOR PUBLICATION, as to anticipation, 34, 38, 49.
See PRIOR KNOWLEDGE AND USE; ANTICIPATION.
PRIOR USE. See PRIOR KNOWLEDGE AND USE.
PROCESS, what is, 36, 42, 209, 210.
is patentable, 30, 36, 42, 135, 142, 147, 177, 209, 210, 231.
is a useful art, 42.
equivalent to method, 42.
substitution in, may be patentable, 45.
patent for, may include product, 73, 74, 126.

PROCESS — *continued.*
but should distinguish it, 73, 74.
cannot be reissued for compound, 104, 120, 162, 163.
See REISSUE.
differs from machine patent, 30, 162.
and product, may be claimed in reissue, 177.
of making artificial teeth, 75.
See PATENTABILITY; PRODUCT; PATENT; PRINCIPLE; REISSUE.
PRODUCT, when patentable, 27, 38, 42, 50, 73, 74, 112, 126, 198, 199, 200, 210.
and process, may both be patented, 126.
patent must describe both distinctly, 36, 73, 74.
See PATENTABILITY; PATENT; PROCESS; PRINCIPLE.
PROFITS, when measure of damages, 14, 15.
must be proved by plaintiff, 17, 18.
if not, he gets only nominal damages, 17.
are not cash balances, 32.
but the advantages gained by using the machine, 32.
do not carry interest, 114.
unless infringement was intentional, 114.
rule as to, 127.
See DAMAGES; INFRINGEMENT; ACCOUNT.
PROPERTY, in invention before patent, 105.
PUBLIC USE, use in a factory is, 123.
See USE.
Congress may grant patent, after two years' use, 18, 19.
See ACT OF CONGRESS.
PUNITIVE DAMAGES, when allowed, 122.
See DAMAGES.
PURCHASER, of patented machine, limited as to sale, when, 87, 88.
See LICENSE.
at marshal's sale, when infringer, 33.
See INFRINGEMENT.

R.

REASONABLE DOUBT, on question of prior use, is against defendant, 37, 45.
See PRIOR KNOWLEDGE AND USE.

RECEIVER, when may be sued, 10, 86.
See FEDERAL COURTS.
cannot convey legal title to patent, 76.
See ASSIGNMENT.

RECORD, of assignment, effect of, 21, 158.
See ASSIGNMENT.

REFRIGERATORS, patent for, held invalid, 172.

REISSUE, was grantable before any act of Congress, 79, 193.
See CONGRESS; ACT OF CONGRESS; PATENT.
as to validity of, 9, 11, 103, 104.
what it may claim, 11, 106.
must be for same invention as described in the original patent, and cannot enlarge it, 11, 17, 27, 28, 30, 31, 41, 49, 84, 109, 133, 134, 161, 162, 163, 165, 179, 180, 181, 189, 190, 194, 207, 208, 210, 229, 231, 234.
except when commissioner's mistake limits it, 137, 138.
but if by mistake or inadvertence the original patent does not describe the invention, a reissue may enlarge it, 118, 119, 128, 129, 132, 133, 234.
delay in claiming is laches, 41, 103, 118, 119, 128, 129, 130, 131, 132, 134, 230.
See ABANDONMENT; DELAY; NEGLIGENCE.
may omit part of invention when, 31, 44, 49, 61, 67, 68, 69.
can never omit anything essential, 179.
effect of inserting rejected claim in, 6, 41, 87, 111, 144, 193, 194, 199.
is presumed to be for same invention as original patent, 205.
how far court may determine this by comparison of original and reissue, 17, 58, 65, 66, 150, 162, 188, 189, 190, 192, 194, 205.
what is new matter in, 161, 162, 163.
rule as to, strictly construed, 191.
not granted for everything suggested in original patent, 191.
as to, in case of combination patent, 42, 67, 68, 69, 91.
how far granting is conclusive of validity, 92, 107, 118, 166, 206, 208, 222.
See COMMISSIONER.
may claim product distinct from process, 162, 163, 177.
See PROCESS; PRODUCT.
if process not claimed, how far abandoned, 104, 120.
See PROCESS; ABANDONMENT.

REISSUE — *continued.*
may be valid as to claim, same as in original patent, though invalid as to others, 60, 61, 73, 78.
how affected by public use, 205, 233.
by foreign patent, 9.
REJECTED CLAIM, when may be included in reissue, 111.
is not inadvertence, or mistake, to justify a reissue, 111, 144.
See REISSUE.
RENEWAL, when passes by assignment, 167.
REPEAL OF PATENT, proceedings for, 230.
See ANNULLING PATENT.
REVOCATION OF LICENSE, by notice, 84.
See LICENSE.
RICHARDSON PATENT, sustained, 6.
RIGHT TO PATENT, lost by sale two years before application, 5.
See SALE; PRIOR USE; PATENT.
ROYALTY, when proper measure of damages, 14, 15.
See DAMAGES.

S.

SALARIES, of managing officers of defendant corporation, 177.
SALE, for two years before application, a bar, 5, 40.
is presumed not to be experimental use, 51, 52, 53.
See USE; PRIOR KNOWLEDGE AND USE; PUBLIC USE; PATENT.
of patented article takes it out of monopoly, 2, 19, 134.
but if locally limited, effect of, 1, 2, 3, 20, 87, 126, 228.
of infringing article, 25.
of machine, though without title, is estoppel against suit for infringement, 77.
and draws after acquired title, 57, 77.
See ESTOPPEL.
SERVICE, insufficient, as ground of dismissing bill, 84.
See BILL IN EQUITY; PRACTICE.
SHERIFF, sale by, of materials of machine, not infringement, 184.
See INFRINGER; INFRINGEMENT.

SILENCE, when is estoppel, 39.
See ESTOPPEL.
SIMPLICITY OF CONSTRUCTION, favored by patent law, 108.
SOLE INVENTOR, who is, 10.
See INVENTOR.
SOLICITOR, mistake of, effect on reissue, 119.
See REISSUE.
negligence of, not abandonment, 16.
See ABANDONMENT; DELAY.
SPECIAL ACTS OF CONGRESS, extending patent, 3.
granting patents, 56.
effect on assignment, 65.
See ACT OF CONGRESS; CONGRESS.
SPECIAL PLEAS, when proper, 17.
See PLEADING.
SPECIFICATION, insufficient, is defence to suit for infringement, 79, 80, 116, 223.
illustrates construction of claim, 18, 22, 26, 27, 48, 107, 108.
See CLAIM; PATENT.
when drawings may accompany, 21.
STAPLE, of corrugated iron, why patentable, 173, 174.
STATE POLICE LAWS, not superseded by patent, 152.
See PATENT.
STATE OF THE ART, as affecting novelty, 165.
See PRIOR KNOWLEDGE AND USE; ANTICIPATION.
STATUTE OF LIMITATIONS, State, effect of, in federal courts, 38, 39, 88, 150, 151, 168, 171, 185, 186.
See FEDERAL COURTS; LIMITATIONS.
STEEL PLATES, substitute for copper in engraving, 109.
SUBCOMBINATIONS, when patentable, 221.
See COMBINATION.
SUBSTITUTION, effect of, on infringement of combination patent, 77.
See COMBINATION.
of new materials in machine, when patentable, 31, 33, 44, 92, 93, 97, 98, 99, 109, 199, 200, 206.
See PATENTABILITY.
in a process, 45.
See PATENTABILITY.

SUCCESSIVE APPLICATIONS, as one continuous one, 13, 14, 19.
See APPLICATION; PATENT; ABANDONMENT; DELAY.
SUIT, by assignee in his own name, when, 62, 63, 64.
See ASSIGNEE; ASSIGNMENT; PRACTICE.
against State court receiver, 10.
See RECEIVER.
against corporation, in what district, 166, 186.
See CORPORATION; PRACTICE.
dependent on license, is not within the jurisdiction of federal courts, 18, 22, 23, 28, 72, 73, 74, 85, 86, 93, 113, 114, 127, 204, 225, 226, 227.
but is if the license is forfeited, 22, 23, 72, 73, 74, 85, 86, 93, 113, 114, 127, 232.
See FEDERAL COURTS; JURISDICTION.
SURETIES, must be, on defendant's bond, 177.
See PRACTICE.
SURRENDER of patent bars right to sue for infringements, 135.
See INFRINGEMENTS.

T.

TAYLOR PATENT, construed, 44.
TERM OF PATENT, how affected by foreign prior patent to same inventor, 9, 59, 60, 71, 90, 96, 147, 148, 170, 197, 220.
See FOREIGN PATENT; PATENT; JURISDICTION.
TERRITORIAL LICENSE, effect of, on purchaser, 87, 88.
See LICENSE; SALE.
TITLE, legal, cannot be conveyed by receiver, 76.
equitable, may, 76.
See RECEIVER.
TRUSTEE, how far infringer is, 15, 25, 44, 116.
See INFRINGER; JURISDICTION; FEDERAL COURTS; EQUITY.
TWO YEARS' USE, bars right to a patent, 37, 125.
but Congress may grant one, 19.
See PUBLIC USE; PRIOR KNOWLEDGE AND USE; SALE; ABANDONMENT; DELAY.

U.

UNITED STATES cannot use patented article without paying for it, 103.
See INFRINGEMENT.
suits in name of, 8, 14.
See PRACTICE; ANNULLING PATENT.

USE, prior to application for two years, bars right to patent, 37, 40, 125.
not if experimental, 51, 52, 53.
sale is not experimental use, 51, 52, 53.
public, effect on patent, 205.
in a factory is public, 123.
See PUBLIC USE; PATENT.
double, not patentable, 24, 99.
right to, includes right to make, 203.
or to repair, 225, 228.
abnormal, as to anticipation, 34.
See ANTICIPATION.
new, is patentable though machine old, when, 12, 206.
See PATENTABILITY.
outside of limited locality, 1, 2, 3.
See LICENSE; SALE.

"USEFUL ART," includes process of manufacture, 42.
See PROCESS.

UTILITY, as test of patentability, 54, 110, 190, 198, 202.
See PATENTABILITY.

V.

VALIDITY OF PATENT. See PATENT.

VENDEES OF INFRINGER, suit as to, 16.
See INFRINGEMENT; EQUITY.

VOID PATENT, may be replaced by valid one, 79.
See REISSUE.

W.

WARRANTY OF TITLE, by sale, 57.
See SALE.
WELLS INVENTION, state of the art as to, 28.
WOOD PAPER PATENT, construed, 24.
WORKMAN, not an infringer, 47, 183.
See INFRINGER.
when forfeits right to patent, 124, 125.
See PATENT; LICENSE.

University Press: John Wilson and Son, Cambridge.