THE

LAW OF PATENTS

AND

PATENT PRACTICE IN THE PATENT OFFICE AND THE FEDERAL COURTS

WITH

RULES AND FORMS

BY

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OF THE

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AUTHOR'S NOTE.

The evolution of invention is a subject whose history will never be written, for its genesis is pre-historic. It may, indeed, antedate man, for in the darkness before his advent his predecessors may have fashioned the first tools of industry and the first weapons of warfare. The first stone-axe surely involved invention, and there was neither judge, lawyer or expert to assert that its production was merely the result of the exercise of mechanical skill.

The invention of the chisel, the spade, the lever, the wheel (doubtless a section of tree-trunk), the wheel-barrow, the hour-glass, the sun-dial, the first harnessing of the draft-animal—what a wonderful history is here, never to be recorded, of matchless brain-feats performed by nameless primeval man.

Necessity was the mother of all these first great inventions; and the inventors were doubtless as well rewarded as some of those of more modern times. For the inventor has ever been the true soldier of fortune, wresting his invention out of the unknown by brain-ordeal, and then getting small, or great, or no reward from society for what he has done; the amount of his reward usually having no relation whatever to the value of his invention.

To revert to those first inventors (and bearing in mind that long centuries were to pass before the word "first" would be incorporated in a patent statute), by imagining their deeds, when there was no prior art, the student may gain at once a comprehension of what effect must be given the prior art in weighing invention.

What of the factor of individuality in invention? Is the inventor nothing more than an incident in the onward progress of society? Is invention something bound

to be accomplished? Are Morse, Whitney, Edison, merely the inventors of that which was bound to be invented, if not by them, by some unnamed and unknown other?

These are questions of rare fascination to the philosophical mind. Ask yourself boldly the question; without Edison, would present-day science be loser? The riddle of the Sphinx, the mystery of the Man with the Iron Mask, are no more difficult of solution.

Yet we find one of the best thinkers of all time answering the question with that promptness and emphasis which predominate his writings.

"It was long disputed whether the honor of inventing the method of Fluxions belonged to Newton or to Leibnitz. It is now generally allowed that these great men made the same discovery at the same time. Mathematical science, indeed, had then reached such a point that, if neither of them had ever existed, the principle must inevitably have occurred to some person within a few years. So in our own time the doctrine of rent, now universally received by political economists, was propounded, almost at the same moment, by two writers unconnected with each other. Preceding speculators had long been blundering round about it; and it could not possibly have been missed much longer by the most heedless inquirer. We are inclined to think that, with respect to every great addition which has been made to the stock of human knowledge, the case has been similar; that without Copernicus we should have been Copernicans,—that without Columbus, America would have been discovered,—that without Locke we should have possessed a just theory of the origin of human ideas. Society indeed has its great men and its little men, as the earth has its mountains and its valleys. But the inequalities of intellect, like the inequalities of the surface of our globe, bear so small a proportion to the mass,

that, in calculating its great revolutions, they may safely be neglected. The sun illuminates the hills, while it is still below the horizon; and truth is discovered by the highest minds a little before it becomes manifest to the multitude. This is the extent of their superiority. They are first to catch and reflect a light, which, without their assistance, must, in a short time, be visible to those who are far behind them."[1]

Whether this philosophical theory be sound or not, it is certainly pernicious. Any philosophy which belittles the importance of the individual, and which holds out to the individual the belief that if he does not contribute to society the best work of which he is capable, it is a matter of indifference, because some one else is certain to do, as well or better, the work that he might have done, is inherently vicious.

In contrast with the fatalistic theory which we have just considered, a typical American thinker has given us the following:

"At the close of the thirteenth century the human intellect awoke from its sleep. The Monk of Pisa who invented spectacles—a most divine invention which gave sight to the blind—may be said, without any exaggeration, to have furnished eyes to the soul as well as the body. Shall we ascribe too much importance to this invention, if we impute to it the effect of drawing men's thoughts from the crudities of the metaphysical dogmas of the schools, to an investigation of the eternal truth of nature? It led the way to the bright career of discovery and invention. The magnetic needle came into common use, and the mariner, trusting to this mysterious guide, boldly crossed the broadest seas; the ships of the enterprising Venetians, passing beyond the utmost boundary of geographical knowledge, brought home the

1. Macaulay; Essay on John Dryden.

strange story of the discovery of Greenland and its desolate inhabitants. The lucubrations of the alchemists, too, were about to develop a capital result, not, indeed, the making of gold, but a result whose effect was to destroy forever the distinction of physical power; the barbarian was no longer to triumph over the civilized man, nor were the works of art or of science ever again to be endangered by an irruption of ignorant barbarians. The power of man, his mere physical power, was indefinitely exalted, and the force which nature had denied him in making him one of the weakest of creatures was compensated by science more than a thousandfold when she gave him gunpowder. To this period, too, we are to refer another invention of vast benefit,—the mode of consuming pit coal,—an invention which has exercised an immense influence over the condition of nations, and to which the country from whence we all draw our descent mainly owes her position in arts and arms.

"Next came the 'Great Epoch.' Gunpowder had given to man a kind of earthly omnipotence; printing was to give his works immortality, to diffuse throughout all the ramifications of society the knowledge that had been hoarded up by a few. No more might the philosopher fear lest his labors, in the conflicting interests of nations or passions of party, should be lost. Civilized man could spread out and perpetuate his intellectual productions. If there be any great landmark in the history of the earth—anything that points out the distinctive character of one age from another, surely it is to be met with in these great discoveries. We are not to suppose that men now possess more ability than at earlier ages. At a remote period, the Chaldeans had discovered the true system of the world and had built up theories which are now being confirmed. They wanted, however, the physical powers to disseminate their knowledge, and to protect themselves from the destruction

that menaced them from more ignorant nations. Before the invention of printing and gunpowder, the world's history was a perpetual squabble of one prince with another, one nation with its rival. With a few exceptions, its philosophy was a vain show, a thing not applicable to the comforts or purposes of life. Notions of military glory made conquest the end of human ambition and of human happiness; and he who had murdered most, and burned most, and ruined most, and pillaged most, was the greatest man; it was a conquest of man over his fellow, a conquest not less disgraceful to the vanquished than to the victor. Instead of subduing nature, and thereby raising the standard of power and wisdom, all the bad passions that can be engendered in the breast of mortals bore sway, and rapine and murder required no apology, provided the scale on which they were carried was sufficiently large. How greatly damaged was the world at the epoch of which I speak; men began to find out that there were ways to be powerful without the destruction of their rivals, and that to conquer nature with her own weapons was the only mode to be truly great. And now for awhile the results of successful experiment followed each other with rapidity, not only in those giant discoveries which have regenerated the world, but also in the arts of peace,—the arts that adorn civilized life. The construction of maps and charts which was introduced tended in no small degree to hasten the discovery of America. Engraving on copper gave a new impulse to painting, and secured faithful representations of natural objects where words and printing might fail to describe them. Navigation felt the great improvement that astronomy, magnetism, geography, and printing had bestowed. Vasco de Gama doubled the Cape of Good Hope and anchored his ships in the Indian seas; and to Castile and Leon, Columbus gave a new world.

"The posterity of men who had thus signalized and adorned their age did them no disgrace. Magellan, a Portuguese aspiring to the fame of Columbus, sailed through the straits that still bear his name! and Europe saw with astonishment ships which had circumnavigated the world. The telescope was produced—watches were first made—the variation of the compass assigned—and improvement extended even to the minor arts; skewers which had been used by ladies were banished, and the common brass pin substituted in their stead. It is true that whatever improvements take place in the condition of men originate with themselves; and all governments have been found either to oppose, or only to yield slowly to them. For teaching the true system of the world —for the discovery of the secondary planets, the moons of Jupiter—for showing spots on the sun, the holy inquisition laid violent hands on Galileo, an immortal man; and the same government that was forced by the times to establish in England by act of Parliament the 'Book of Common Prayer,' caused to be burned by the common hangman the books of astronomy and geography, because they were 'infected with magic.' But the persecutions which were endured by philosophers from the malice of princes could neither rein nor stop the progress of knowledge. Decimal arithmetic with all its advantages was promulgated, and soon after a Scotch baron invented logarithms; the thermometer made its appearance in Holland; and that maritime spirit which had doubled the capes of South Africa and South America already sought a northwest passage to India and projected a visit to the North Pole. Harvey discovered the circulation of the blood,—a discovery that has done more for the advancement of medical science than almost all that preceded it. Toricelli invented the barometer, and proved that air possessed weight; Huygens invented the pendulum clock; Otto Guerick con-

structed the first air pump, and exposed bodies to a vacuum. The current of discovery was now fairly in motion—scientific associations were springing up in every country; and had things still gone on even in their usual channel, the accumulation of knowledge would have been great. But a propitious event occurred—for at the close of 1642 Isaac Newton was born, a man whom God made to comprehend his works."[1]

It is our own conclusion that the history of invention is composed of the history of individual inventions, and the efforts of individual inventors. In it, each inventor has a place, large or small. The whole is the aggregate of the atoms composing it. Many have lived and died in comparative obscurity whose work was indispensable to those who followed them in the arts in which they labored. Witness, what Dolbear did for wireless, and Langley for the aeroplane.

The complexity of modern life goes parallel with the complexity of our inventions, and the complexity of the system of patent laws and their administration. If a legal text-writer can lend any aid to the orderly administration of the patent laws he is a benefactor to the users as well as the originators of inventions. In this spirit this work was undertaken.

The insistence of our English brethren that our Patent System is directly derived from their own, and theirs in turn from the Statute of Monopolies, is plausible, but scarcely convincing in the light of the differences between our systems, and in the light of the abuses which solely gave rise to the Statute of Monopolies, and which it was solely designed to prevent. That statute has been glorified by judicial construction until it is generally recognized as "one of the constitutional landmarks of British liberty, like the Petition of Right, the Habeas

1. Draper; Lecture on "The Development of Civilization in Europe" (delivered at Hampden-Sidney College, Virginia, 1837).

Corpus Act, and other great constitutional Acts of Parliament."[1] The *Case of Monopolies*, 11 Coke, 84 *b*, illuminates it, and there is no under-estimating its value in the upbuilding of the British Constitution. But the suppression of offensive monopolies is a very different thing from laying the foundation of a system for the protection of invention, in the sense in which we use the word "invention." With this distinction, and in the light of what progress Great Britain has made by the embodiment of our ideas in her system of patent laws and administration, we are prone to insist that the United States has led always since 1790, in the legal recognition of the inventor, and in the delicate adjustment of the respective rights of the inventor and the public.

Great Britain was undoubtedly first in recognizing invention as worthy of monopoly, aeons after the Stone Age. Her colonies in America were destined to rebel and grow into the greatest of all republics, the home of the greatest inventors of all time. It is the unfortunate fact that while the colonists were heirs by birth to the great body of the common-law, there was no common-law of letters patent for inventions. It is unfortunate that any department of the law should be based solely upon statute. The constant jeopardy to which any system of law is exposed when it is so founded is a positive calamity whose seriousness is in direct ratio to the importance of its subject matter.

Our brilliant contemporary of the English bar, Augustine Birrell, in his lectures on Copyright, has not minced his words in dealing with those Parliamentary word-jugglings that have so embarrassed the development of the law of Copyright.

1. Butchers' Union Slaughter House, etc. Co. v. Crescent City, etc. Co., 111 U. S. 746, 762, 28 L. Ed. 585, 588.

"In England the question (of perpetual copyright) was complicated, and, indeed, butchered, by an Act of Parliament—the first copyright statute anywhere to be found—the 8th of Good Queen Anne. * * * How annoying, how distressing, to have evolution artificially arrested and so interesting a question stifled by an ignorant Legislature, set in motion not by an irate populace clamouring for cheap books (as a generation later they were to clamour for cheap gin), but by the authors and their proprietors, the booksellers."[1]

Turning to another of Mr. Birrell's writings—his address upon the late Walter Bagehot—we find this epigram which it will richly repay every patent lawyer to think over:

"He had mastered the niceties of Conveyancing in the chambers of Sir Charles Hall, and the mysteries of Special Pleading in those of Mr. Justice Quain; and no sooner had he mastered these niceties and mysteries than they were all abolished by acts of Parliament."[2]

The ability to fairly and uniformly judge the question of invention is possibly the rarest judicial quality. In the United States there are very many Federal judges: of them, a mere handful ever practiced in patent causes before their elevation to the bench. It seems probable that active work at the bar in patent causes is a detriment, rather than an advantage to the individual as regards his ability to weigh fairly, and uniformly, the question of invention. That faculty seems to be inborn, and not susceptible of cultivation save by actual judicial experience, and that experience seems to be worthless when the individual commences his judicial career with what may be termed color-blindness as to invention. This comparison is deliberately made. Just as color-blindness does not imply that the individual who

1. Birrell, Copyright in Books, pp. 19, 22.
2. Birrell, Essays and Addresses, p. 138.

is color-blind is defective in either of his other senses, so we have preserved in the reports the evidence as to many a judge that he was capable in weighing evidence on any subject other than that of invention. Passing from the individual to groups of individuals, we find that the shifting of the personnel of our United States Circuit Courts of Appeals produces remarkable variations in their ability to pass fairly and uniformly upon the question of invention. The fear that it is impossible to adopt a method of designation which will produce a fair patent court of last resort is at the root of the opposition to the creation of such a court. Its opponents argue that it is better to "bear those ills we have than fly to others that we know not of." The answer to this argument is given in the text. We advert to this question here only by way of pointing out that, however complete the general rules of patent law may become, and however firmly its principles may be settled, in its administration, either in the Patent Office or in the courts it is not, and never can become, an exact science. As Herbert Spencer has said, "We find that much of what we call science is not exact, and that some of it, as physiology, can never become exact."[1]

The absence of any definition of invention would seem, as a matter of first impression at least, to be an obstacle in the way of the scientific development of the law of patents. Yet to those who have long considered the question, the absence of definition seems inevitable and final. Mr. Fletcher Moulton, when at the zenith of his leadership of the Patent Bar of England, said "it would seem to be necessary to fix upon some definition of invention, but this has never been done, and in my opinion no definition of invention can be found which is of the slightest assistance to anyone in a case of difficulty. * * *

1. Essay, "The Genesis of Science."

When you approach the dividing line it is so impossible to get a test that it becomes, more or less, a matter of personal opinion."[2] His conclusion is amply sustained by the illustrations of conflicting decisions in the several Federal circuits which are given in the present text. The practical result of this situation is to make the defense of want of invention omnipresent in patent litigation in this country, and it is the writer's experience that the cases are rare in which counsel for the patent or for the defense can advise his client, in advance of the decision of the court of last resort, with any degree of confidence, what the courts will do with that defense. That this fact is a strong deterrent to the proper development of patent property cannot be denied.

The very uncertainty of patent litigation seems to us good reason for that independent examination by courts of concurrent jurisdiction which is always recognized in theory, even though it is shirked in application. In a recent *per curiam opinion,* the Circuit Court of Appeals of the Second Circuit has said:

"Although the parties are entitled to the independent judgment of this court, nevertheless the orderly administration of justice requires that, where a question has been decided after careful and exhaustive examination by the Court of Appeals of one circuit, another court of co-ordinate jurisdiction should not reach a different conclusion unless persuaded that the first decision is clearly wrong. Especially is this true in patent causes, for otherwise, under our present system, a party may be punished for an act which on the other side of a dividing line is perfectly lawful and proper."[3] We would rather have it expressed that particularly in patent causes the

2. Presidential Address before the Junior Institution of Civil Engineers (1904).

3. Calculagraph Co. v. Automatic Time Stamp Co., 187 Fed. Rep. 276, ——— C. C. A. ——.

co-ordinate court should make a diligent independent examination, because of the public interest on the one hand (its right to use what is of common right), and the holding of a solemn government grant of monopoly, made after skilled examination of the art, on the other. If the grant be valid, it should be sustained because of the consideration (by disclosure) passing from the inventor to the public. If the grant be void, the people of the circuit should be protected from paying tribute under it. The ordinary rule of comity certainly ought not to be more rigidly applied in patent cases than in any other, for the questions of government grant and public right impose a peculiar duty upon the court which is not ordinarily present in litigation between private parties.

The future of invention is limitless. The future of the patent law will depend for its stability upon the non-interference of legislation. It is to be hoped that any new enactments will be characterized by the conservatism which has marked the progress of the subject of late years. The judicial development of the subject may be relied upon with confidence. Every decade has added invaluable judicial opinions to the literature of the patent law, until today the problem of selection has become one of embarrassment to the text-writer. Some of the most valuable opinions at our service were written by the *nisi prius* court, and occasionally in cases which were reversed upon the merits.

Whatever range of usefulness this work may occupy, it is hoped that it will meet with the approval of the courts and counsel having to do with patent litigation. None know as well as they the difficulties of the subject; none more keenly appreciate the fact that "the language of an opinion is an uncertain guide when divorced from the facts."[1]

1. Quarles, J., in Jahn v. Champagne Lumber Co., 157 Fed. Rep. 414.

In the English literature of this subject there are frequent references to the dictum of Lord Watson: "There are many things which you cannot say are or are not inventions until you have tried them." The author's experience has been that the same rule might be paraphrased with reference to legal text-books. Whatever the brilliancy of style or clearness of expression, it must respond to the need of the student or it is valueless. High finish and symmetrical lines attract the eye to the edged tool, but the cutting edge must be there. To the test of shop practice these pages are now committed.

JAMES LOVE HOPKINS.

Central National Bank Building,
St. Louis, Missouri,
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CHAPTER I.

INTRODUCTORY AND HISTORICAL.

§ 1. "Letters Patent" defined.

From a practical working standpoint, letters patent for invention may be broadly defined as the indicia of a governmental effort to reward the inventor for the disclosure of his invention by giving him, for a fixed period, the right to exclude others from its practice.

It may be instructive to analyze this definition. The "effort" of the sovereign or legislature may be thwarted by many incidents; for example, an incompetent judiciary; or, such numerous infringements as to render their prosecution by the patentee impossible; or, the fact that the inventor is ahead of his time, and the public, through ignorance, declines to give him tribute.

The reward is for the disclosure—not the making—of the invention. The invention must first be made, but the governmental interest does not attach until it is disclosed.

The only benefit passing to the inventor is the right to exclude. He has, by natural law, the right to practice and the right to assign the privilege of practicing.

Among the judicial definitions of letters patent, the following are notable. Mr. Justice Clifford defines letters patent as "Public franchises granted to the inventors of new and useful improvements for the purpose of securing to them, as such inventors, for the limited term therein mentioned, the exclusive right and liberty to make and use and vend to others to be used their own inventions, as tending to promote the progress of science and the useful arts, and as matter of compensation to the inventors for their labor, toil and expense in making

the inventions, and reducing the same to practice for the public benefit, as contemplated by the Constitution and sanctioned by the laws of Congress."[1]

Judge Sanborn's definition is more concise:

"A patent is a contract by which the government secures to the patentee the exclusive right to vend and use his invention for a few years, in consideration of the fact that he has perfected and described it and has granted its use to the public forever after."[2]

"A patent" in the language of Judge Colt "is an incorporeal property right in an invention, created by statute."[3] As Judge Wheeler has put it, "It is merely an incorporeal right to exclude others from using the invention throughout the United States conferred by the Government upon compliance with certain requirements."[4]

§ 2. Letters Patent for inventions, and the Statute of Monopolies.

This work is not intended to present the history of the patent law, but it will assist in a proper understanding of the modern law to briefly examine its early history.

Letters Patent (*Litterae Patentes*—open letters), were known to feudalism, and are referred to in Domesday Book, as the medium whereby the King, in writ-form, witnessed his grants of lands.[5] They became the usual method by which, in later centuries, the royal grants of rights or privileges were witnessed. They were named in contradistinction to the close writs (*litterae clausae*) which were sealed with the privy seal and recorded in

1. Seymour v. Osborne, 78 U. S. (11 Wall.) 516, 20 L. Ed. 33, 35.

2. National Hollow Brake Beam Co. v. Interchangeable Brake Beam Co., 106 Fed. Rep. 693, 701, 45 C. C. A. 544.

3. Head v. Porter, 70 Fed. Rep. 498, 504.

4. Jewett v. Atwood Suspender Co., 100 Fed. Rep. 647, 648. See 9 U. S. E. 148.

5. Maitland, Domesday Book, p. 264.

the close rolls. The letters patent were, for many centuries, unrecorded, and were sealed with the great seal, for popular recognition.

It has been said that the first patent for an invention of which we have record was issued by Edward III (1327-1377), in favor of an alleged discovery of the philosopher's stone.[6] The history of letters patent for invention has been considerably confused with that of the letters patent for other forms of privileges, which were issued for the sale of goods and the exercise of trades; it was to these latter forms of monopoly, and not to any grants of letters patent for invention, that the complaints of the people during the reign of Elizabeth (1559-1603) were due. Indeed, from the detailed statement of Hume, we gather that the list of patents for monopolies which finally aroused the wrath of Parliament and led the Queen to "acquaint the House (of Commons) that she would immediately cancel the most grievous and oppressive of these patents,"[7] was confined almost if not entirely, to trade monopolies for dealing in oil, sulphur, salt, iron, and the other common necessities of life.

From the reign of the third Edward (1327-1377) to the time of James I, the histories available to the modern reader abound with references to grants of trade-monopolies: but they are silent as to patents for inventions, with a few exceptions, such as the "sieve, or instrument for melting of lead" for which a patent was granted to its alleged inventor, one Humphrey of the Tower.[8]

In this connection it should be remembered that James, upon his accession to the throne, in 1603, procured the enactment by Parliament of a statute against anyone convicted of "witchcraft, sorcery, or enchantment, or

6. Fulton on Patents (London, 1894), p. 2.

7. Hume, Ch. XLIV.

8. Darcy v. Allin, Noy. Rep. 173.

having commerce with the devil."[9] This was hardly a fitting accomplishment in the monarch who, according to some writers of repute, is credited with laying the foundation of the modern patent systems of Great Britain and the United States.

Centuries which produced no scientists, and during which the attention of Christendom was, in the language of Draper, "engrossed by image-worship, transubstantiation, the merits of the saints, miracles, shrine-cures,"[10] could not give birth to our modern patent system, or even dimly foreshadow its coming. England had been buried in a cloud of intellectual darkness; illiteracy was universal. The awakening of literature came, no one knows whence or why, during the reign of Elizabeth. The desire for conquest over-sea came with it. The awakening of science in England was to follow—but not at once. The 21st year of the reign of James the First (1624) preceded it, and brought with it the enactment of the Statute of Monopolies. England had as yet no necessity for a Patent Act. Laws are not called into being save by some necessity, real or fancied, which leads to their enactment. So that the Statute of Monopolies was not intended, and its words show, when viewed in the light of contemporaneous history, that it was not intended, to serve as a basis for the systematic grant of letters patent for invention, as we understand the term. The statute, however, prohibited in terms the grant of letters patent by the crown except for "the sole working or making of any manner of new manufactures, within this realm to the first and true inventor or inventors of such manufactures, which others at the time of the making of such letters patent and grants did not use, so

9. Draper, Intellectual Development of Europe, Vol. 2, p. 118.

10. Draper, Conflict of Religion and Science, p. 159.

they be not contrary to the law or mischievous to the state." These words have become the foundation of the English patent system, merely through construction. They did not contemplate either that patent system or one like our own. "A patent for a useful invention is not, under our law, or the law of England, a grant of a monopoly, in the sense of the old common law."[11] It may be remarked, however, that the Statute of Monopolies foreshadowed the nature of the modern British letters patent, in fact, as remarked by Mr. Justice Gray, "In England the grant of a patent for an invention is considered as simply an exercise of the royal prerogative." And the the learned jurist, proceeding to contrast therewith the *motif* of our patent system, observes that "in this country letters patent for inventions are not granted in the exercise of prerogative, or as a matter of favor, but under article 1, section 8 of the Constitution."[12]

The early history of Letters Patent in America is yet to be written, and is foreign to our present purpose. But it is curious to note something of its beginning.

Twenty-one years after the landing of the Mayflower the records of the General Court of the Massachusetts Bay Colony disclose the granting to one Samuel Winslow of a patent for a process for the manufacture of salt (1641). There were possibly others earlier, and certainly many others before the first Congress passed the Act of 1790.

Charles Pinckney is accredited with inspiring, in the Constitutional Convention, the patent clause of the Constitution.

Less than one year before he signed the first Patent Act (of April 10, 1790), in his first inaugural address

11. Curtis on Patents, XIX.

12. Belknap v. Schild, 161 U. S. 15, 40 L. Ed. 600.

(April 30, 1789), Washington made an appeal for the protection of inventions in these words: "I cannot forbear intimating to you the expediency of giving effectual encouragement, as well to the introduction of new and useful inventions from abroad, as to the exertions of skill and genius in producing them at home."

That the infant States themselves were prompt to recognize inventions is evident from the following provision of the Patent Act of 1793:

"§ 7. And be it further enacted, That where any State, before its adoption of the present form of government, shall have granted an exclusive right to any invention, the party claiming that right shall not be capable of obtaining an exclusive right under this act, but on relinquishing his right under such particular State, and of such relinquishment, his obtaining an exclusive right under this act shall be sufficient evidence."

In 1810 the first patent case was disposed of by the United States Supreme Court,[13] and marked the beginning of the series of opinions which that court continued term by term to contribute to the literature and learning of the patent law, until the establishment of the Circuit Courts of Appeals deprived the Supreme Court of appellate jurisdiction in all patent cases not involving the jurisdiction of the Circuit Court, save such as the Supreme Court itself might see fit to review by granting the writ of certiorari.

§ 3. The constitutional provision.

Among the powers vested in Congress by the Federal Constitution, and enumerated in the eighth section of the first article of that instrument, is that enabling it "to promote the progress of science and the useful arts, by

13. Tyler v. Tuel, 6 Cranch, 324, 3 L. Ed. 237.

securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries."

The policy of the law, Mr. Chief Justice Fuller has said, "is to encourage useful discoveries by securing their fruits to those who make them."[14] The constitutional provision above quoted is the expression of this general policy of our modern law, in concrete form. From it has sprung our system of patent law.

Had the inventor no rights in his invention recognizable by the common law? Mr. Chief Justice Taney said: "The inventor of a new and useful improvement certainly has no exclusive right to it, until he obtains a patent:"[15] and in a later opinion he says that the inventor's rights "are to be regulated and measured by these (the patent) laws, and cannot go beyond them."[16] Mr. Justice Field said: "Until the patent is issued there is no property right in it (the invention), that is, no such right as the inventor can enforce,"[17] and Mr. Justice Gray has said that "the patentee has no exclusive right of property in his invention, except under and by virtue of the statutes securing it to him."[18]

And yet these dicta, and those of the writers who have relied upon them, must be taken with the broad qualification that the inventor always had the right, at common law, to practice his invention privately, and retain it as a secret of his trade. Mr. Justice Gray while

14. Fowle v. Park, 131 U. S. 88, 33 L. Ed. 67.

15. Gayler v. Wilder, 10 Howard 477-493, 13 L. Ed. 504.

"A patent does not confer even the right to use the invention. The inventor had that right before." Wheeler, J., in Jewett v. Atwood Suspender Co., 100 Fed. Rep. 647, 648.

16. Brown v. Duchesne, 19 Howard 183, 15 L. Ed. 595.

17. Marsh v. Nichols, 128 U. S. 605, 32 L. Ed. 538.

18. Dable Grain Shovel Co. v. Flint, 137 U. S. 41, 34 L. Ed. 618. For other pertinent dicta see Rein v. Clayton, 37 Fed. Rep. 354-356.

on the state bench in Massachusetts said "it is settled that a secret art is a legal subject of property."[19]

§ 4. The inchoate right of the inventor before the issuance of Letters Patent.

It has long been recognized that, under the various Patent Acts of the United States, the inventor has an inchoate right in his invention from the time when it is first made.

Mr. Chief Justice Taney recognized this right in 1850, when he said:

"The discoverer of a new and useful improvement is vested by law with an inchoate right to its exclusive use, which he may perfect and make absolute by proceeding in the manner which the law requires."[20]

In the same opinion, he held that this inchoate right may be the subject of a contract of sale; and that doctrine has remained the law ever since.[21]

19. Peabody v. Norfolk, 98 Mass., 452.

Mr. Justice Clifford had the same thought when he said, referring to inventions generally, "They are indeed property, even before they are patented, and continue to be such, even without that protection, until the inventor abandons the same to the public, unless he suffers the patented product to be in public use or on sale, with his consent and allowance, for more than two years before he files his application." Jones v. Sewall, 6 Fisher 343, Fed. Case No. 7495.

So had Mr. Justice Hunt, who said, "So far as the plaintiff's own use or manufacture is concerned, it needs no act of Congress to enable it to make, use and vend the article, and it obtains no such right from Congress. The benefit of the patent law is that the plaintiff may prevent others from making, using, or vending its invention. To itself, to its own right to make use, or vend, no right or authority is added by those statutes." Manufacturing Co. v. Vulcanite Co., 13 Blatchf. 375, 383.

20. Gayler v. Wilder, 10 How. 477-493, 13 L. Ed. 510.

21. Clum v. Brewer, Fed. Case No. 2909, 2 Curt. 506; Newell v. West, Fed. Case No. 10,150; Emmons v. Sladdin, Fed. Case No. 4470; Hendrie v. Sayles, 98 U. S. 552; Rein v. Clayton, 37 Fed. Rep. 354.

It is this inchoate right under which the statute permits the inventor to practice his invention publicly during any period less than two years, provided that he so claims his inchoate right as not to abandon the invention to the public.[22]

And it is this same inchoate right whose life is prolonged during the pendency of the application for letters patent; during that period, the right is of course, still assignable, although the inventor cannot recover for the use of his invention by another, prior to the date of the issuance of letters patent.[23]

§ 5. The nature of Letters Patent as property.

Much has been said in the past about the distinction between the monopoly of the common law, and the monopoly of United States letters patent, issued under the constitutional provision. In his treatment of this question, Mr. Curtis said:

> "The patent of the United States, having grown up under a positive grant of authority in the Federal Constitution, is to be considered, in respect to the subjects of the exclusive privilege, with reference to that grant, and to the legislation which has been under it. In England, the corresponding system has rested upon a proviso in the Statute of Monopolies, which excepted from the prohibitions of that act letters patent granted by the crown for 'the sole working or making of any manner of new *manufactures*, within this realm, to the first and true inventor or inventors of such manufactures, which others at the

22. Sargent v. Seagrave, Fed. Ed. 538-541; Brown v. Duchesne, Case No. 12,365, 2 Curt. 553.

23. Kirk v. United States, 163 U. S. 49, 41 L. Ed. 66; Marsh v. Nichols, 128 U. S. 605-612, 32 L. 19 How. 183-195, 15 L. Ed. 595-599; Gayler v. Wilder, 10 How. 477-493, 13 L. Ed., 504-511.

time of the making of such letters patent and grants did not use, so they be not contrary to the law, nor mischievous to the state.' "

"The distinction thus established between those exclusive privileges which the crown may and those which it may not grant proceeds upon the principle, that a monopoly, in the prohibited sense, is a grant which restrains others from the exercise of a right or liberty which they had before the grant was made; whereas the exclusive privilege intended to be secured by letters patent for an invention contemplates something in which other persons than the inventor had not, before his invention, a right to deal, or which they had not a right to use, because it did not exist. Other persons than the first inventor of a thing had the same right to invent it that he had; but as he has been the first to invent it, the patent system—proceeding upon the policy of encouraging the exercise of inventive talent by securing to the inventor an original property, which, without protection, would have rested only upon a principle of natural justice—takes notice of the exclusive right of that first inventor, and makes it effectual by assuming that he who has first exercised the right of invention has bestowed something upon society which ought to procure for him thereafter, at least for a time, the exclusive right to make or use that thing." [24]

Whatever the nature and reason for the adoption of the word "monopoly" into the nomenclature of our American law of patents, the word has become indispensable through long use, and in a department of the Science of Law in which words are of prime importance, probably

24. Curtis on Patents, §§ 1, 2.

no other word exists which could take its place. It is used in no offensive or condemnatory sense as applied to the right co-existent with, and embodied in, the grant of letters patent. It is indicative of that right to exclude all others for a limited time, with which the constitutional provision and the Federal Statutes enacted under its beneficient inspiration and authority, have rewarded the inventor's contribution to the store of common knowledge of the public.

The acquisition of the patent rights finds its prototype in that reduction to possession which is at the very basis of all the forms of ownership which the law can recognize.

In Mr. Taylor's treatise upon the Science of Jurisprudence we find this excellent consideration of ownership by reduction to possession:

> "From the consideration of rights that relate to no tangible external object we must pass to those proprietary rights that represent the extension of the power of an individual over portions of the physical world. When the state is organized the strong hand of law gives to the mere fact of possession that protection which the savage, who has hidden the game he has killed in his cave, can hope for only so long as it is undiscovered, or 'so long as he watches to defend it, or is stronger than his rivals.'[25] In all law systems the fact of being the first finder, discoverer, or possessor of a thing has invariably enforced in favor of such a person the claim to actual proprietorship. Neither the Roman nor the common law, however, given to the pursuer of wild animals the rights of possession until escape has been made impossible by some means. Until then another

25. Bentham, Principes du Code Civil, par Dumont, ch. IX.

may step in and kill or catch and carry off the game if he can.[26] According to Justinian a wild beast so badly wounded that it might easily be taken must be actually taken before it belongs to its captor.[27] And an English court has held that when fish were nearly surrounded by a seine, with an opening of seven fathoms between the ends, at which boats were stationed to frighten them from escaping, they were not reduced to possession as against a stranger who rowed in through the opening and helped himself.[28] On the other hand, Judge Lowell has upheld a custom of the American whalemen in the Arctic Ocean which gives the whale to the vessel whose iron first remains in it, provided claim be made before cutting in.[29] In Roman law the possessory Interdicts of the praetor had the greatest possible validity for the purposes of guarding even the most casual and transitory claims of an actual possessor, and, under certain circumstances, of enabling such claims to mature into substantial rights of ownership. The classical jurists recognized two degrees of control over an object, the lower of which is known to modern civilians as *detentio*, the higher as *possessio*, properly so called. 'Possession is the occupation of anything with the intention of exercising the rights of ownership in respect of it.'[30] It has been well said that possession stands in a position intermediate between simple detention and absolute ownership, and that it implies two elements, a physical and a mental one,—physical detention and mental in-

26. Dig. 41, 1, 5, 2 Kent's Comm. 349, citing Pierson v. Post, 3 Caines (N. Y.) 175; Buster v. Newkirk, 20 Johnson (N. Y.) 75.

27. Inst. 2, 1, 13.

28. Young v. Hichens, 6 Q. B. 606.

29. Swift v. Gifford, 2 Lowell 110. Cf. Holmes, The Common Law, p. 218.

30. Hunter, Roman Law, 209.

tention to hold the thing possessed as one's own. * * * Leaving out of view such things as are incapable of appropriation, such as air, and in most cases water, and such things as are set apart for the general purposes of the state, ownership may extend to things movable and immovable, *res fungibiles* and *non-fungibiles*, things corporeal and incorporeal, *singulae res* and *universitas rerum*, and things divisible and indivisible, principal and accessory, existing and about to exist. Acquisition, original or derivative, may take place through occupancy, specification, accession, invention, prescription, alienation in life, alienation on death, adjudication, and forfeiture. Apart from dominion or absolute ownership, in which the mode of user, duration of the right, and facilities of alienation are unlimited or indefinite, there are lesser rights of ownership including emphyteusis, and usufructuary estates generally, servitudes or easements, and generally all *jura in re* according to the largest intent of the classical jurists, including the rights of carriers, of depositaries, or pledgees, and of the merest possessors; and estates for life, for years, or upon condition, copyhold estates, and estates in tail in English law. Rights of ownership less than the most unrestricted ones are strictly limited on many sides; and their classification may rest upon the differences in the mode of the user allowed, in the duration of the right, or the faculties for its transmission from hand to hand."[31]

The foundation of any worth-while study of the cases relating to letters patent must be premised upon two elementary and vital rules:

31. Taylor, The Science of Jurisprudence, 543, 549.

First: There must be explicit authority in the constitutional provision or the Federal Statutes for the granting of every patent.

Second: That in every litigation upon a patent the rights of the public are of precisely the same importance as those of the nominal litigants.

These rules are not only the basis of the law of patents, but every opinion in the books is determined by the application of one or the other of them.

The inventor is a medium who materializes out of the limitless domain of abstract thought a tangible invention. The inventive act is two-part,—conception, plus reduction to practice. Having conceived, he may never reduce to practice, and so will never acquire a patent right. By actual reduction to practice, plus public use of his invention for two years, he gives his invention to the public. But actual reduction plus application for a patent, or constructive reduction by the filing of the application, will ripen into a patent right. If that patent does not find its support in an actual novel contribution to the knowledge of the public, its effect is to take away from the public, and to give to the individual, that which is of common right, and of which the possession cannot be taken from the public.

That, in its last analysis, is the law of property in patents.

§ 6. The rights of the owner of an unpatented invention.

In considering the nature of letters patent, we have touched upon the subject of those inventions that may be secretly practiced. The subject is rendered difficult by its inherent nature, and its necessarily slow development through adjudication. It is settled that "a secret in

trade is fully recognized as property in equity, the disclosure of which will be restrained by injunction."[32]

But the foundation of the right rests upon the condition that what is claimed as a secret is really a secret. It need not be new—the fact of its secrecy makes its life, as a secret, indeterminate. Must it be "useful," as that term is applied to patented inventions? Can it be recognized and protected in equity if it should be acquired by two or more persons or groups of persons who have obtained their knowledge by independent experiments, or whose assignors have independently acquired the knowledge? Must it rise to the dignity of invention, by having the attributes required of patentable inventions? Will the doctrine "*de minimis non curat lex*" apply, if the alleged secret is of trifling value? These are a few of the unanswered questions which are suggested by the reported cases, and we cannot venture upon their discussion. The nature of the subject is such that there probably never will be a definition of "secrets" formulated which will be of general application. The following is an abstract of some phases of the subject that have been adjudicated:

In a case involving "a secret process of manufacture of cloth," relief by injunction was granted against the plaintiff's ex-employee, and those associated with him,[33] and similar relief against persons similarly situated was granted where the "secrets" involved were "secret receipts for veterinary medicines,"[34] "a secret mode of dyeing,"[35] "a secret medical recipe."[36]

32. Smith, J., in Champlin v. Stoddart, 30 Hun. 300, 302.

33. Peabody v. Norfolk, 98 Mass. 452.

34. Yovatt v. Winyard, 1 Jac. & W. 394.

35. Bryson v. Whitehead, 1 S. & S. 74.

36. Morison v. Moat, 9 Hare, 241; Weston v. Heurmons, 2 Vict. L. R. Eq. 121.

It must be borne in mind that in the class of cases referred to, relief has usually been granted upon the theory of breach of trust, arising out of a confidential relationship between employer and employee. The subject-matter of the secret process is seldom discussed, and one case goes so far as to sustain, as against a suit for rescission of a contract for sale of corporate stock, a "secret" process upon which an application for patent was finally rejected upon a long expired patent, the court observing "many an invention and many an idea of value are doubtless to be found in the records of the patent office, but, so far as public actual knowledge thereof is concerned, they might as well be non-existent. * * * Upon the issue whether the process was in fact a new and secret one, the burden is upon the complainant to establish the fact that it was not, and I do not think the evidence clearly shows such to be the case. It does not appear that any metal treated by this process was in the market, or was in use by any one except the few who procured it from the Hawkeye Metal Company and those connected therewith. The Burt patent issued in December, 1869, expired in 1886, and it would not prevent the use of the process."[37] This was not a suit to secure the protection of an alleged secret process, but the language of the very able jurist who wrote the opinion shows that he regarded patentable novelty as an utterly immaterial consideration in determining whether a trade secret existed or not. His views in this regard do not appear to be logically sound, and we do not quote them as authoritative, but to show the great difficulty surrounding the question of what is really such a trade secret as the courts well recognize. Congress has exempted

37. Shiras, J., in Benton v. Ward, 59 Fed. Rep. 411, 413.

from punishment for contempt a witness who refuses "to disclose any secret invention or discovery made or owned by himself." § 4908, R. S. U. S.

The recognition and protection extended by the common law to trade secrets is, indeed, generally understood.[38] Many, if not a majority, of chemical processes in use in the United States to-day are secret and unpatented. Instances may be readily imagined of machines whose construction might be indefinitely preserved as a secret,[39] while their product was being publicly used or sold. The advantage of retaining such machines and processes secret and unpatented is manifest, for the monopoly, so long as the secrecy is preserved, is complete and of unlimited duration. This monopoly, however, may at any time be wholly lost from either of two causes, namely, an independent discovery of the same invention by another, or the discovery from the inventor or his assigns of the secret, provided such discovery is not effected by fraudulent means. In exchange for this hazardous monopoly, which may be of infinite duration, the constitutional provision offers a secure and exclusive right to practice the invention, for a limited term, in consideration of a full disclosure of the invention, to inure to the benefit of the public upon the expiration of the patent. And it offers the same protection to that larger class of inventions that cannot be profitably practiced in secret.

§ 7. "Discoveries" defined.

The language of the constitutional provision, with reference to the patent law, is clear. The word "discov-

38. Hopkins on Trademarks (2d. Ed.) Sections 90, 91, 92. Secret inventions or discoveries are expressly recognized by sec. 4908, R. S. U. S. See Dornan v. Keefer, 49 Fed. Rep. 462.

39. Dobson v. Graham, 49 Fed. Rep. 17.

eries" is the only word contained in it concerning which doubt has arisen. It is sufficient to say that it is used either as a synonym for "inventions," or for "disclosures," in which latter event it refers to the disclosure by the inventor which is the consideration for the issuance of the patent.[40]

40. "Every invention may, in a certain sense, embrace more or less of discovery, for it must always include something that is new; but it by no means follows that every discovery is an invention. It may be the soul of an invention, but it cannot be the subject of the exclusive control of the patentee, or the patent law, until it inhabits a body, no more than can a disembodied spirit be subjected to the control of human laws." Shipman J., in Morton v. New York Eye Infirmary, Fed. Case No. 9865, 2 Fisher 320, 5 Blatchf. 116.

"Much of the confusion of ideas upon this subject has arisen from the ambiguity of the words 'discover' and 'discovery' used in the Constitution and the patent law of the United States. In their primary and common meaning they are not synonymous with 'invent' and 'invention.' Webster in the last 8 vo. edition of his dictionary, under the word 'discover,' says 'discover' differs from 'invent.' 'We discover what before existed. We invent what did not before exist.' And under the article 'invention' he says: 'invention differs from discovery. Invention is applied to the contrivance and production of something that did not before exist. Discovery brings to light that which existed before, but which was not known. A discovery, in this sense, is not the subject of a patent; and it will be found, by a careful perusal of the Constitution and laws of the United States upon the subject of patents for useful arts, etc., that it is not used in this sense, but always as synonymous with invention. Thus (in the constitutional provision it is evident that the 'discoveries' the use of which is to be secured, are the discoveries of inventors only. The applicant must invent, contrive, or produce something that did not exist before. A man may discover (i. e., may disclose) his invention; and for that discovery or disclosure he will be entitled to the exclusive use of his invention for a limited time." Cranch, J., in Re Kemper, Fed. Case No. 7687; 1 McArthur 1-4; Cranch, 89.

§ 8. The constitutional power domestic in character.

Of this provision of the Constitution, Mr. Chief Justice Taney said "the power thus granted is domestic in its character, and necessarily confined within the limits of the United States. It confers no power on Congress to regulate commerce, or the vehicles of commerce, which belong to a foreign nation, and occasionally visit our ports in their commercial pursuits." He accordingly held that an improvement placed on a foreign vessel in a foreign port, and not in violation of the laws of the country to which the vessel belonged, was not an infringement of the rights of a holder of a patent of the United States, nor could the patentee complain of the use of such improvement on the vessel while entering or leaving a port of the United States.[41]

Inasmuch as the constitutional provision gives Congress the power to make all laws necessary and proper for carrying the expressed power into execution, "it follows that Congress may provide such instrumentalities in respect of securing to inventors the exclusive right to their discoveries as in its judgment will be best calculated to effect that object."[42]

§ 9. Congress given power to fix term.

As to the term for which letters patent are to be granted, Mr. Justice Story said, referring to the Constitutional provision, "It contemplates that this exclusive right shall exist but for a limited period, and that the period shall be subject to the discretion of Congress."[43]

41. Brown v. Duchesne, 19 Howard, 183, 15 L. Ed. 595.

42. Mr. Chief Justice Fuller in United States v. Duell, 172 U. S. 576, 583, 43 L. Ed. 560.

43. Pennock v. Dialogue, 2 Peters 1, 16, 7 L. Ed. 327.

§ 10. Rights granted subject to police regulations of the States.

Mr. Justice Harlan has said, "it is true that letters patent, pursuing the words of the statute, do, in terms grant to the inventor, his heirs and assigns, the exclusive right to make, use and vend to others his invention or discovery, throughout the United States and the Territories thereof. But, obviously, this right is not granted or secured without reference to the general powers which the several states of the Union unquestionably possess in reference to their purely domestic affairs, whether of internal commerce or of police."[44] The states may prohibit the sale of patented articles, therefore, in the exercise of the police power, and they may exact a license tax for the sale of articles covered by letters patent, provided that the tax so exacted does not discriminate against interstate commerce.[45]

§ 11. The various Patent Acts.

The first patent act was passed by Congress April tenth, 1790. Other writers have treated exhaustively of the original and other acts now obsolete. We will not concern ourselves with any but the laws now in force, and will pass directly to a consideration of the tests by which the validity of letters patent for inventions is to be determined.

Disregarding, for the present, reissued patents, which we will deal with specially, it may be stated that a patent may be invalid because of (a) defective execution, or (b) want of proper subject-matter.

Treating these subjects in their natural order, it first becomes necessary to examine the formal parts of which letters patent consist.

44. Patterson v. Kentucky, 97 U. S. 501, 24 L. Ed. 1115.

45. Webber v. Virginia, 13 Otto 344, 26 L. Ed. 565. See Post, §§ 312, 313.

CHAPTER II.

THE GRANT AND ITS ATTENDANT PRESUMPTIONS.

§ 12. The grant.

In all letters patent of the United States the copy of the drawings and specifications is preceded by the grant. Section 4884, R. S. U. S., provides that this grant "shall contain a short title or description [1] of the invention or discovery, correctly indicating its nature and design, and a grant to the patentee, his heirs or assigns, for the term of seventeen years, of the exclusive right to make, use, and vend the invention or discovery throughout the United States, and the territories thereof, referring to the specification for the particulars thereof."

Under section 4883, R. S. U. S., the grant was issued in the name of the United States of America, under the seal of the Patent Office, and was signed by the Secretary

1. Pursuant to this provision, the title must be consistent with the specification. Hogg v. Emerson, 6 Howard 437, 12 L. Ed. 505. "The title or description given to the invention in the grant is never expected to be specific, but only to indicate the nature and design of the invention. The specification, as its name indicates, must be searched for the exact description of what the patentee claims." Sickles v. Gloucester Mfg. Co., 1 Fisher 222-229, Fed. Case No. 12,841.

"This description ought not to be repugnant to the specification; but, provided it honestly sets forth, in few words, the 'nature and design' of the patent, it is sufficient." Goodyear v. Central R. of New Jersey, 1 Fisher 626-635, Fed. Case No. 5563.

"Every patent, whatever may be the general heading or title by which the invention is designated, refers to the specification annexed for a more particular description." Dissent of Mr. Justice Nelson in LeRoy v. Tatham, 14 Howard 156-179, 14 L. Ed. 367.

The title being merely a brief description "cannot limit the claim of the patentee to narrower bounds than those described in his specification." Goodyear v. Central R. of New Jersey, 1 Fisher 626-636, Fed. Case No. 5563.

of the Interior and countersigned by the Commissioner of Patents. It was provided by another act (25 Stat. at Large, ch. 15, p. 40) that the signature of one of the assistant Secretaries of the Interior instead of that of the Secretary, would suffice. On April 11, 1902, section 4883 was amended, so that the signature of the Commissioner of Patents alone is necessary.[2]

§ 13. The nature of the right conveyed by the grant.

By the grant, three distinct substantive rights are conveyed to the patentee, "the right to make, the right to sell, and the right to use the patented article."[3]

The monopoly conveyed by the grant is absolute for the term of the letters patent; that is to say, the patentee is under no obligation to practice, or to permit others to practice, his invention.

It is true that in one case it was said by Judge Blodgett that "under a patent which gives a patentee a monopoly, he is bound either to use the patent himself or allow others to use it on reasonable or equitable terms;"[4] but in several later cases, this dictum has been expressly criticised and controverted,[5] and the contrary doctrine is now established.[6]

2. 32 St. at L., pt. 1, ch. 417, p. 95.

3. Coxe, J., in Tuttle v. Matthews, 28 Fed. Rep. 98.

4. Hoe v. Knap, 27 Fed. Rep. 204-212. To the same effect see Judge Grosscup's dissenting opinion in Fuller v. Berger, 120 Fed. Rep. 274, 281, 56 C. C. A. 588.

5. Consolidated Roller Mill Co. v. Coombs, 39 Fed. Rep. 803-805; Campbell Printing Press Mfg. Co. v. Manhattan R. Co., 49 Fed. Rep. 930-934; Fuller v. Berger, 120 Fed. Rep. 274-277, 56 C. C. A. 588, 65 L. R. A. 381; E. Bement & Sons v. National Harrow Co., 186 U. S. 70, 90, 46 L. Ed. 1058, 1068.

6. Edison Electric Light Co. v. Mt. Morris Electric Light Co., 7 C. C. A. 375, 58 Fed. Rep. 572; Heaton Peninsular Button Fastener Co. v. Eureka Specialty Co., 35 L. R. A. 728, 25 C. C. A. 267, 77 Fed. Rep. 294; Crown Cork & Seal Co. v. Aluminum Stoppper Co., 48 C. C. A. 72, 108 Fed. Rep. 845, 868; Fuller v. Berger, 65 L. R. A. 381, 56 C. C. A. 588, 120 Fed Rep. 274, 277; Lamson

The monopoly conveyed by the grant "is one entire thing and cannot be divided into parts," except as provided by the patent statutes.[7] In the language of Mr. Justice Gray "the patentee or his assigns may, by instrument in writing, assign, grant and convey, either (1st) the whole patent, comprising the exclusive right to make, use and vend the invention throughout the United States; or (2d) an undivided part or share of that exclusive right; or (3d) the exclusive right under the patent within and throughout a specified part of the United States. U. S. R. S., sec. 4898. A transfer of either of

Consol. Store Service Co. v. Hillman, 59 C. C. A. 510, 123 Fed. Rep. 416, 422; Victor Talking Machine Co. v. The Fair, 61 C. C. A. 58, 123 Fed. Rep. 425; United States Consol. Seeded Raisin Co. v. Griffin & S. Co., 61 C. C. A. 334, 126 Fed. Rep. 364, 368; Rupp & W. Co. v. Elliott, 65 C. C. A. 544, 131 Fed. Rep. 730; Railway Appliance Co. v. Munroe, 77 C. C. A. 383, 147 Fed. Rep. 241; O. H. Jewel Filter Co. v. Jackson, 72 C. C. A. 304, 140 Fed. Rep. 340, 343; United States Fastener Co. v. Bradley, 79 C. C. A. 180, 149 Fed. Rep. 222; Rubber Tire Wheel Co. v. Milwaukee Rubber Works Co., 83 C. C. A. 336, 154 Fed. Rep. 358, 361; Indiana Mfg. Co. v. J. I. Case Threshing Mach. Co., 83 C. C. A. 343, 154 Fed. Rep. 365; Carr v. Rice, 1 Fisher 198, 200 Fed. Cas. No. 2440; Wintermute v. Redington, 1 Fisher 243, Fed. Cas. 17,896; Ransom v. New York, 1 Fisher 255, Fed. Cas. 11, 573; Pitts v. Wemple, 1 Biss. 87, 2 Fisher 15, Fed. Cas. 11,194; Whitney v. Emmett, Bald. 304, Fed. Case 17,585; Broadnax v. Central Stock Yard & Transit Co., 6 Bann. & Ard. 609, 4 Fed. Rep. 214, 216; Re Brosnahan, 4 McCrary 1, 18 Fed. Rep. 62; Consolidated Roller Mill Co. v. Coombs, 39 Fed. Rep. 803; Wirt v. Hicks, 46 Fed. Rep. 71; Campbell Printing-Press & Manufacturing Co. v. Manhattan R. Co., 49 Fed. Rep. 930; Edison Electric Light Co. v. Mt. Morris Electric Light Co., 57 Fed. Rep. 642, 644; Masseth v. Reiber, 59 Fed. Rep. 614; Masseth v. Johnston, 59 Fed. Rep. 613; Bonsack Mach. Co. v. Smith, 70 Fed. Rep. 383; Columbia Wire Co. v. Freeman Wire Co., 71 Fed. Rep. 302, 306; Wyckoff v. Wagner Typewriter Co., 88 Fed. Rep. 515; White v. Peerless Rubber Mfg. Co., 111 Fed. Rep. 190; Broderick Copygraph Co. v. Mayhew, 131 Fed. Rep. 92; National Automatic Weighing Mach. Co. v. Daab, 136 Fed. Rep. 891, 895; Hoe v. Miehle Printing Press & Mfg. Co., 141 Fed. Rep. 115; Hartman v. John D. Park & Sons Co., 145 Fed. Rep. 358; Continental Paper Bag Co. v. Eastern Paper Bag Co., 210 U. S. 404, 426, 52 L. Ed. 1122.

7. Waterman v. Mackenzie, 138 U. S. 252, 34 L. Ed. 923.

these three kinds of interests is an assignment, properly speaking, and vests in the assignee a title in so much of the patent itself, with a right to sue infringers; in the second case, jointly with the assignor; in the first and third cases, in the name of the assignee alone. Any assignment or transfer, short of one of these, is a mere license, giving the licensee no title in the patent, and no right to sue at law in his own name for an infringement."[8]

§ 14. Effect of the word "heirs" in the grant.

Under section 4884, R. S. U. S., the grant runs to the patentee, his heirs or assigns. This language has been construed to read in the alternative, as a grant to the patentee, or his heirs, or assigns; so that a patent whose terms follow the wording of the act in this respect, issued to an applicant who dies before it issues, is not void.[9]

§ 15. Misnomer of grantee.

"A grant is not necessarily void by reason of an error in the Christian name of the grantee, and where it contains any other matter descriptive of the person for whom it was intended, extrinsic proof of so much matter is admissible to identify the grantee, and, if he is thus identified, effect will be given to the grant accordingly."[10]

8. Ibid.

9. De La Vergne Refrigerating Machine Co. v. Featherstone, 147 U. S. 209-230, 37 L. Ed. 138.

10. McKennan, J., in Northwestern Fire Extinguisher Co. v. Philadelphia Fire Extinguisher Co., 1 Ban. & Ard. 177-181, Fed. Case 10,337, reviewing the authorities.

§ 16. Co-partners as grantees.

A grant to individuals described as being of a certain partnership, vests the title jointly in the individuals and not in the firm.[11]

§ 17. By whom signed.

The courts "take judicial notice of the persons who from time to time preside over the Patent Office, whether permanently or transiently, and the production of their commission is not nececssary to support their official acts."[12] Consequently, it is no objection to the validity of a patent that it is signed by "an acting Commissioner of Patents," and that the record contains no averment or proof of his title to the office.[13] The act formerly imperatively prescribed the signatures of both the Secretary of the Interior and the Commissioner of Patents, or that of some other acting official of each department named. "The omission of one signature is not more permissible than the omission of all."[14] The omission of either signature, however, as the result of accident or inadvertence, might be subsequently remedied, but by the action of existing officers of the department furnishing the missing signature, and not by former officers, who had gone out of office.[15] When the missing signature is supplied, the date of such signing should be indicated, as from that time only can the instrument operate as a patent for the invention claimed.[16]

11. Levy v. Dattlebaum, 63 Fed. Rep. 992.

12. Mr. Justice Campbell in York and Maryland R. Co. v. Winans, 17 Howard 30-41, 15 L. Ed. 350.

13. Ibid; and Dorsey Rake Co. v. Marsh, 7 Fed. Cas. 942.

14. Mr. Justice Field in Marsh v. Nichols, 128 U. S. 605-612, 32 L. Ed. 538.

15. Ibid, at pp. 614-615.

16. Marsh v. Nichols, 128 U. S. 605-612, 32 L. Ed. 538.

§ 18. Presumptions arising from the grant.

There are certain presumptions attendant upon the grant of letters patent. The first is the broad presumption that the patent is valid.[17] The second, that the device described and claimed is patentable generally.[18] This latter presumption includes the co-ordinate presumption that the patentee was the original and first inventor of what is described and claimed;[19] this presumption is strengthened when the application has been in interference, and the examiner of interferences, board of examiners, and commissioner have concurred on the question of priority;[20] that its disclosure is full and clear;[21] that its subject-matter is operative,[22] that it is not void for double patenting,[23] and possesses utility,[24] and embodies invention.[25] The date of the issuance of the patent is presumptively the date of invention.[26]

There are also analogous presumptions arising from the contents of the grant. Thus, the grant of a patent

17. Wilkins Shoe-Button Fastener Co. v. Webb, 89 Fed. Rep. 982, 996, Hunt Bros. Packing Co. v. Cassidy, 3 C. C. A. 525, 53 Fed. Rep. 257; "It is a solemn grant issued by competent authority under the sanction of law. It is a muniment of title. He who would overcome it must do so by clear and convincing evidence." Baker, J., in Holloway v. Dow, 54 Fed. Rep. 511-514.

18. Mesker v. Thuener, 42 Fed. Rep. 329; Lehnbeuter v. Holthaus, 105 U. S. 94, 26 L. Ed. 939; Thomas Roberts Stevenson Co. v. McFassell, 90 Fed. Rep. 707; Fay v. Mason, 120 Fed. Rep. 506, 512.

19. Carnegie Steel Co. v. Cambria Iron Co., 89 Fed. Rep. 721-727; Patterson v. Duff, 20 Fed. Rep. 641; Ross v. Montana Union Ry. Co., 45 Fed. Rep. 424.

20. Stonemetz Mach. Co. v. Brown Mach. Co., 57 Fed. Rep. 601-604.

21. Fay v. Mason, 120 Fed. Rep. 506, 512.

22. Dashiel v. Grosvenor, 162 U. S. 425, 40 L. Ed. 1025, 75 O. G. 507.

23. Ryan v. Newark Mattress Co., 96 Fed. Rep. 100, 103.

24. Patent Button Co. v. Scovill Mfg. Co., 92 Fed. Rep. 151-154.

25. Hoffman v. Young, 2 Fed. Rep. 74; Marsh v. Seymour, 97 U. S. 348, 24 L. Ed. 963, 13 O. G. 723, 12 Brodix 53.

26. Fay v. Mason, 120 Fed. Rep. 506, 511.

to an assignee of the inventor is presumptive evidence that the assignment has been regularly made and recorded,[27] and a grant to joint patentees creates the presumption that the invention was joint.[28]

Where the grant has been antedated the presumption is that it was so done properly,[29] and the grant of a reissue raises the presumption that it was proper to grant it,[30] and that the prerequisites to the granting of a reissue have been complied with,[31] though, of course, that presumption is not conclusive.

As to the weight to be attached to the presumptions of novelty, utility and patentable invention which arise from the grant, "the presumption which this rule affords is sometimes slight, and sometimes renders but little assistance."[33]

The grant of a reissued patent creates the presumption that the original patent was inoperative or imperfect on account of a defective or insufficient specification.[34] The presumptions relating to the validity of the patent are based upon the presumed expertness of the examination in the Patent Office. In the language of Judge Wallace, "the trained experts of the Patent Office have decided that what was done by the patentee arose to the dignity of an invention."[35] Judge Putnam has said that "in

27. Whitcomb v. Spring Valley Coal Co., 47 Fed. Rep. 652.

28. Priestley v. Montague, 47 Fed. Rep. 650; Page Woven Wire Fence Co. v. Land, 43 Fed. Rep. 936.

29. Tilghman v. Proctor, 102 U. S. 707, 22 L. Ed. 279, 19 O. G. 859, 13 Brodix 29.

30. Klein v. Russell, 19 Wall. 433, 22 L. Ed. 116; Fay v. Mason, 120 Fed. Rep. 506, 510.

31. Philadelphia & Trenton R. R. Co. v. Stimpson, 14 Pet. 448, 10 L. Ed. 536, 4 Brodix 398.

32. Peoria Target Co. v. Cleveland Target Co., 47 Fed. Rep. 728.

33. Putnam, J., in Burnham & Duggan Ry. Appliance Co. v. Naumkeag St. Ry. Co., 57 Fed. Rep. 651-653.

34. Fay v. Mason, 120 Fed. Rep. 506, 510.

35. Beer v. Walbridge, 100 Fed. Rep. 465, 466, 40 C. C. A. 496.

many cases the presumption which it (the grant) affords is very slight and purely technical,"[36] and again that "the presumption which this rule affords is sometimes slight and sometimes renders but little assistance;"[37] and Judge Jenkins has said: "The presumption referred to is sometimes defined to mean that the patent itself is prima facie evidence of novelty and of invention, but that presumption is probably a mere rule of evidence, which casts the burden of proof upon the alleged infringer. This presumption cannot usurp the province of the court to declare what constitutes novelty. The court should give due consideration to the action of the Patent Office, but should not permit that action to control its deliberate judgment when it is manifest that there is no invention."[38]

Where the history of the application for the patent shows that the Patent Office did not refer to and consider the references which are urged against the validity of the patent in litigation, the court must determine the weight and effect to be given such references, as a matter of first impression, and the failure of the Patent Office to cite such references may wipe out the ordinary presumption of validity attendant upon the grant. Thus, Judge Gray has said: "We do not agree with the contention, that the fact that the file wrapper discloses the patent to have been granted as first applied for, without any references, adds any force to the presumption of novelty arising from the grant. On the contrary, we think the force of that presumption is much diminished, if not destroyed, by the lack of any reference by the

36. Chase v. Fillebrown, 58 Fed. Rep. 374, 376.

37. Burnham & Duggan Ry. Appliance Co. v. Naumkeag St. Ry. Co., 57 Fed. Rep. 651, 653.

38. J. J. Warren Co. v. Rosenblatt, 80 Fed. Rep. 540, 543, 25 C. C. A. 625; citing Hollister v. Benedict Mfg. Co., 113 U. S. 59, 71, 28 L. Ed. 901, 905.

Examiner to, or consideration of, the 'Clark' patents. It does not seem likely that an expert examiner would pass them by, without notice or consideration, if they had been called to his attention."[39]

§ 19. Does the grant create a presumption that the thing patented does not infringe prior patents?

This question has given rise to a controversy that is one of the most notable incidents in the growth of our patent law. In 1853 Mr. Justice Grier said:

"By the Patent Act of 1793, any person desirous of obtaining a patent for an alleged invention, made application to the Secretary of State, and received his patent on payment of the fees, and on a certificate of the Attorney General that his application 'was conformable to the Act.' No examination was made by persons qualified to judge whether the alleged invention was new or useful, or had been patented before. That rested wholly on the oath of the applicant. The Patent Act of 1790 had made a patent prima facie evidence; but this Act was repealed by that of 1793, and this provision was not re-enacted in it. Hence a patent was not received in courts of justice as even prima facie evidence that the invention patented was new or useful, and the plaintiff was bound to prove these facts in order to make out his case. But the Act of 4th of July, 1836, introduced a new system, and an entire change in the mode of granting patents. It provided for a new officer, styled the Commissioner of Patents, to 'superintend, execute and perform all acts and things touching and respecting the granting and issuing of patents, etc.' The commissioner was authorized

39. American Soda Fountain Co. v. Sample, 130 Fed. Rep. 145, 149, 64 C. C. A. 497.

to appoint a chief clerk, and three examining clerks, a machinist and other officers."

"On the filing of an application the commissioner is required to make, or cause to be made, an examination of the alleged invention, in order to ascertain whether the same had been invented or discovered by any other person in this country, prior to the application; or whether it had been patented in this or any foreign country, or had been on public use or sale, with the applicant's consent, prior to his application; and if the commissioner shall find that the invention is new and useful or important, he is authorized to grant a patent for the same. In case the decision of the commissioner and his examiner is against the applicant, and he shall persist in his claim, he may have an appeal to a board of examiners, to consist of three persons, appointed for that purpose by the Secretary of State, who, after a hearing, may reverse the decision of the commissioner in whole or in part. By the Act of 1839, the Chief Justice of the District of Columbia was substituted in place of the board of examiners."

"It is evident that a patent, thus issued after an inquisition or examination, made by skillful and sworn public officers, appointed for the purpose of protecting the public against false claims or useless inventions, is entitled to much more respect, as evidence of novelty and utility, than those formerly issued without any such investigation. Consequently such a patent may be, and generally is, received as prima facie evidence of the truth of the facts asserted in it. And in cases where the evidence is nicely balanced, it may have weight with a jury in making up their decision as to the plaintiff's right; and if so, it is not easy to perceive why the defendant who uses a patented machine should not have the benefit of a like presumption in his favor, arising from a like investiga-

tion of the originality of his invention, and the judgment of the public officers, that his machine is new, *and not an infringement of the patent previously granted to the plaintiff*. It shows, at least, that the defendant has acted in good faith, and is not a wanton infringer of the plaintiff's rights, and ought not, therefore, to be subjected to the same stringent and harsh rule of damages which might be justly inflicted on a mere pirate. It is true the mere question of originality or infringement generally turns on the testimony of the witnesses produced on the trial; but if the plaintiff's patent in a doubtful case may have some weight in turning the scale in his favor, it is but just that the defendant should have the same benefit from his; *valeat quantum valeat*. The parties should contend on an equal field, and be allowed to use the same weapons."[40]

In the later case of Blanchard v. Putnam, however, the Supreme Court held that it is no answer to the charge of infringement to plead or prove that the defendant is the licensee of the owner of another patent, and that his machine is constructed in accordance with that patent.[41] Thus the doctrine of Corning v. Burden was overruled in so far as it relates to the presumption of non-infringement, as has been held on circuit by Judge (now Mr. Justice) McKenna.[42]

But it has since been held by the Circuit Court of Appeals for the Ninth Circuit that Blanchard v. Putnam has in turn been overruled by Miller v. Mfg. Co. (151 U. S. 208) and Boyd v. Tool Co. (158 U. S. 260).[43] That the accuracy of this conclusion is not beyond cavil is sug-

40. Corning v. Burden, 15 Howard, 252, 14 L. Ed. 683.

41. Blanchard v. Putnam, 75 U. S. (8 Wall.) 420-426, 19 L. Ed. 433.

42. Norton v. Eagle Automatic Can Co., 59 Fed. Rep. 137-139.

43. Ransome v. Hyatt, 69 Fed. Rep. 148, 16 C. C. A. 185.

gested by examining the language of the later cases referred to. In the Miller case the court says "the issuance of the patents to Gardiner & Downey, Berlew & Kissell, and Elder creates a *prima facie presumption* of *patentable difference* from that of the Wright patent of 1879."[44] To this point Corning v. Burden is cited. This is the whole conclusion of the opinion as to the presumption arising from the defendant's patent, and fails to bear out the contention of the Circuit Court of Appeals that it reverses the Blanchard case, because in this respect Blanchard v. Putnam is consistent with Corning v. Burden.

Turning to the Boyd case, we find that the defendant attempted to justify under a patent granted upon an application that was pending in the Patent Office at the same time with that of the patent in suit. In the opinion written by Mr. Justice Shiras, we find the following language:

"As both applications were pending in the Patent Office at the same time, and as the respective letters were granted, it is obvious that it must have been the judgment of the officials that there was no occasion for an interference and that there were features which distinguished one invention from the other. In American Nicholson Pavement Co. v. Elizabeth, 4 Fisher's Pat. Cas. 189, Mr. Justice Strong said: 'The grant of the letters patent was virtually a decision of the Patent Office that there is a substantial difference between the inventions. It raises the presumption that, according to the claims of the latter patentees, this invention is not an infringement of the earlier patent.' It would also seem to be evident that, as the purpose of the invention was the same, and as the principal parts of the respective ma-

44. Miller v. Eagle Mfg. Co., 151 U. S. 204-208, 38 L. Ed. 121.

chines described were substantially similar, it was also the judgment of the office that the distinguishing features were to be found in some of the smaller and, perhaps, less important devices described and claimed."[45]

There are two points decided here. First, that the grant raises a presumption of the existence of features distinguishing one patented device from another; second, that where the principal parts of the patented devices are the same, there is a presumption that the distinguishing features reside in the minor details, which is a self-evident proposition. The dictum of Mr. Justice Strong is quoted from without comment either of assent or dissent, it is wholly irrelevant to the context, and the writer is satisfied that its presence in the opinion is through clerical error, or want of proper revision.

The Pavement Company case quoted from was appealed to the Supreme Court and we there find that the doctrine laid down by the Circuit Court was not referred to. The question of infringement is discussed and disposed of without reference to any presumption created by the grant of letters patent.[46]

It is upon this slender foundation that the Ninth Circuit Court of Appeals has held that Blanchard v. Putnam has been overruled. It is impossible for us to follow the Court of Appeals in this conclusion.

The Miller and Boyd cases both relate to the presumption of patentable difference rather than to that of non-infringement.

45. Boyd v. Janesville Hay Tool Co., 158 U. S. 260-263, 39 L. Ed. 973.

46. Elizabeth v. American Nicholson Pavement Co., 97 U. S. 126, 24 L. Ed. 1000.

Inasmuch as a patent may improve upon and yet infringe a prior patent,[47] it is the writer's conclusion that while it is always competent to show that the defendant is operating under a junior patent for the purpose of showing a patentable difference between his device and that of the patent in suit; the fact that he is operating under such a patent does not create even a *prima facie* defense to the charge of infringement. And this conclusion is not in conflict with the rule that the issuance of the defendant's patent creates a presumption of patentable difference between the patent and all those which precede it;[48] indeed, it is in perfect harmony with that rule, for as long as the Patent Office is bound to issue patents for patentable improvements even though they infringe it is *reductio ad absurdum* to say that the grant raises a presumption of non-infringement.

§ 20. The terms for which Letters Patent are granted.

Section 4884, R. S. U. S., provides that the grant of "every" patent shall be for a term of seventeen years. This does not embrace design patents, which § 4931, R. S. U. S., provides "may be granted for the term of three years and six months, or for seven years, or for fourteen years, as the applicant may, in his application elect."

Notwithstanding the language of the grants issued under § 4884 for the term of seventeen years, § 4887, R. S. U. S., formerly contained the provision that "every patent granted for an invention which has been previously patented in a foreign country shall be so limited

47. Woodward v. Boston Lasting Mach. Co., 60 Fed. Rep. 283, 285; Rodenhausen v. Keystone Wagon Co., 51 Fed. Rep. 220, 223; McCormick v. Talcott, 61 U. S. (20 How.) 405, 15 L. Ed. 930; Clough v. Gilbert Mfg. Co., 106 U. S. 166, 178, 27 L. Ed. 138.

48. St. Louis Car Coupler Co. v. National Malleable Castings Co., 87 Fed. Rep. 885-897, 31 C. C A. 265.

as to expire at the same time with the foreign patent, or, if there be more than one, at the same time with the one having the shortest term, and in no case shall it be in force more than seventeen years'' (Act of July 8, 1870, ch. 230, 16 Stat. at L., 201).

This provision was eliminated from § 4887 by the Act of March 3, 1897, ch. 391, § 3, 29 Stat. at L. 693; and the section has since been amended by Act of March 3, 1903, ch. 1019, § 1, 32 Stat. at L. 1226, without the restoration of the provision above set forth.

The length of time which has elapsed since this term-limiting law became obsolete, has almost rendered consideration of this peculiar subject unnecessary and superfluous in a work of this character. While the provision was in effect it led to many hard fought litigations, whose records now are useless, though entertaining to the reader. It will be seen that the first question to be raised under the provision was that of the identity or non-identity of subject-matter existing between the domestic and foreign patents, and it was held that a construction of non-identity should be favored, where the court was convinced that the inventor did not intend patenting the same invention abroad, in order that the domestic patent might live.[49]

It is obvious, however, that the determination of the question of identity was a matter of some difficulty. The test usually, though not necessarily, applied was that of submitting the disclosure of the foreign patent to the rules governing infringement cases; if the disclosure fell within the claims of the domestic patent, the latter would be brought within the statute.[50] The addition to the

49. Brush Electric Co. v. Electrical Accumulator Co., 47 Fed. Rep. 48.

50. Siemens v. Sellers, 123 U. S. 276, 31 L. Ed. 153; Commercial Mfg. Co. v. Fairbank Canning Co., 135 U. S. 176, 34 L. Ed. 88.

domestic application of improvements not present in the foreign patent, the widening or narrowing of the domestic claims, could not protect the latter from the operation of the statute, and the claims of the domestic patent were treated as an entirety; it was impracticable to declare a patent expired as to certain claims but living as to others.[51]

Conversely, the narrowing of the scope of the American patent, or its restriction to a single claim, did not absolve it from limitation in duration by a foreign patent for the same invention,[52] nor did the fact that there existed between the two slight differences in minor details[53] or even in principle.[54] The rule was stated in one case that, to prevent the operation of the statute, the devices of the foreign and the domestic patent should be so different that both might be patented in this country;[55] but it is believed that the statement, while illuminative of the argument as to similarity in the case at bar to which it was applied, was not of general application. The question of similarity between domestic and foreign patents was naturally complicated by the different languages employed in other than English-speaking countries, and Judge Coxe very properly held that mere changes of phraseology made by the translators and Patent Office officials, "did not and could not operate to change the invention."[56] It was his deduction from the Supreme Court cases that the question of identity under § 4887 was to be tested by these questions:

51. Clark v. Wilson, 28 Fed. Rep. 95; Holmes Electric Protective Co. v. Metropolitan Burglar Alarm Co., 33 Fed. Rep. 254.

52. Accumulator Co. v. Julien Electric Co., 57 Fed. Rep. 605.

53. J. L. Mott Iron Works v. Henry McShane Mfg. Co., 80 Fed. Rep. 516; Siemens v. Sellers, 123 U. S. 276, 31 L. Ed. 153.

54. Clark v. Wilson, 28 Fed. Rep. 95.

55. Accumulator Co. v. Julien Electric Co., 57 Fed. Rep. 605, 614.

56. Accumulator Co. v. Julien Electric Co., 57 Fed. Rep. 605, 616.

"Is the principal invention of the domestic patent found in the foreign patent? Is the subject-matter of the one the same in all essential particulars as that of the other? In other words, will a structure made pursuant to the foreign patent infringe the domestic patent? Could both the patents have been granted in this country?"[57]

It was held that the Commissioner of Patents should limit the term of the domestic patent, upon the face of the grant and in accordance with the facts, where a prior foreign patent for the same subject-matter had been issued;[58] but his failure so to do did not affect the validity of the United States patent.[59]

Where the foreign patent relied upon to curtail the life of a domestic patent was adjudged void *ab initio*, its grant did not in anywise affect that of the United States patent, but it was treated as if it had never existed.[60]

The filing date of the application for United States letters patent was never a material matter in determining the application of this provision; it was a matter of indifference whether the foreign grant was before or after the filing date at home, provided it preceded the issuance of the domestic patent.[61] Similarly, the effect of the foreign patent was governed by the actual date of

57. Ibid; citing Siemens v. Sellers, 123 U. S. 276, 31 L. Ed. 153; Commercial Mfg. Co. v. Fairbank Canning Co., 135 U. S. 176, 34 L. Ed. 88.

58. Bate Refrigerating Co. v. Gillett, 13 Fed. Rep. 553.

59. Canan v. Pound Mfg. Co., 23 Fed. Rep. 185; Bate Refrigerating Co. v. Hammond, 129 U. S. 151, 32 L. Ed. 645.

60. Bate Refrigerating Co. v. Gillett, 20 Fed. Rep. 192.

61. Edison Electric Light Co. v. U. S. Electric Lighting Co., 35 Fed. Rep. 134; Seibert Cylinder Oil Co. v. William Powell Co., 35 Fed. Rep. 591; American Bell Telephone Co. v. Cushman, 57 Fed. Rep. 842; Bate Refrigerating Co. v. Sulzberger, 157 U. S. 1, 39 L. Ed. 601.

its issuance,[62] and that date governed its status under this section, even though the foreign patent was antedated.[63]

Further difficulty attended this subject by reason of the questions arising under foreign patent laws as to the length of the term of the foreign patent. The life of the domestic patent, it was held, depended upon the actual duration of the foreign patent, and would be contracted or expanded by the conditions which operated under the foreign law to curtail or extend the life of the foreign patent;[64] so that an extension of the foreign patent as a matter of right inherent in the patent, would prolong the life of the domestic patent to the date of expiration of the extended term.[65] But this result did not attach to an extension of the foreign patent not through a right inherent in the patent when issued; an extension of the foreign patent as a matter of royal favor or special legislative enactment did not operate to extend the life of the domestic patent beyond the end of the term for which the foreign patent was originally granted.[66] Where the foreign patent was extensible as a matter of right, but for different extension periods, the domestic patent expired at the end of that

62. Emerson v. Lippert, 31 Fed. Rep. 911; Seibert Cylinder Oil Co. v. William Powell Co., 35 Fed. Rep. 591; Edison Electric Light Co. v. Waring Electric Co., 59 Fed. Rep. 358; Smith v. Goodyear Dental Vulcanite Co., 93 U. S. 486, 23 L. Ed. 952.

63. Gold & Stock Telegraph Co. v. Commercial Telegram Co., 23 Fed. Rep. 340.

64. Huber v. N. O. Nelson Mfg. Co., 38 Fed. Rep. 830; Bate Refrigerating Co. v. Hammond, 129 U. S. 151, 32 L. Ed. 645.

65. Edison Electric Light Co. v. Perkins Electric Lamp Co., 42 Fed. Rep. 327; Consolidated Roller Mill Co. v. Walker, 43 Fed. Rep. 575; Edison Electric Light Co. v. U. S. Electric Lighting Co., 52 Fed. Rep. 300, 3 C. C. A. 83; Bate Refrigerating Co. v. Hammond, 129 U. S. 151, 32 L. Ed. 645.

66. Henry v. Providence Tool Co., 3 Bann. & Ard. 501, Fed. Case 6384.

extension period when the foreign patent terminated in fact.[67]

This section did not contemplate that the term of a domestic patent should be abbreviated by a foreign patent issued on the application of another who did not act in the interest or with the acquiescence or consent of the domestic applicant.[68]

Extensions. The subject of extensions of letters patent is now merely of historical interest, so far as actual practice is concerned. Congress now has the power, as it had even before the Act of July, 1832, 4 Stat. at L. 577, to prolong the life of letters patent beyond the terms for which they are granted, by private acts upon individual applications.[69]

Since 1861 no extensions except as to patents granted before that time have been within the jurisdiction of the Patent Office (see §§ 4924 to 4928, R. S. U. S., both inclusive) and Congress has not exercised its power by private acts. The various statutes relating to extensions, from the years 1832 to 1861 are collected in the Appendix of this book, and the older text-writers have dealt with the subject exhaustively.[70]

67. Bonsack Mach. Co. v. Smith, 70 Fed. Rep. 383.

68. Wilcox & Gibbs Sewing Mach. Co. v. Industrial Mfg. Co., 110 Fed. Rep. 210; Hobbs v. Beach, 180 U. S. 384, 45 L. Ed. 586.

69. Wilson v. Rousseau, 4 How. 646, 687, 11 L. Ed. 1141.

70. See 9 U. S. E. 245.

CHAPTER III.

PATENTABLE SUBJECT-MATTER, AND APPLICATIONS FOR PATENTS.

§ 21. The drawings.

It is provided by § 4889, R. S. U. S., that "when the nature of the case admits of drawings,[1] the applicant shall furnish one copy, signed by the inventor or his attorney in fact, and attested by two witnesses, which shall be filed in the Patent Office and a copy of the drawings, to be furnished by the Patent Office, shall be attached to the patent as a part of the specification."[2] From time to time the Patent Office has prescribed rules relating to the drawing, which must be given due regard by the solicitor.

§ 22. Drawings supplementary to the specification.

The purpose of the drawing is to enable one skilled in the art to which the patent relates, who has also the description and claims before him, to practice the invention. The drawing, therefore, is sufficient, if, with the assistance of the specification, it effects this result;[3]

1. Ex parte Chase, 16 O. G. 809. In a patent for a machine a drawing is necessary. Burrall v. Jewett, 2 Paige (N. Y.) 134; also in a patent for an article of manufacture. Ex parte Chase, 16 O. G. 809.

2. Hoe v. Cottrell, 1 Fed. Rep. 597; Wilcox & Gibbs S. M. Co. v. Industrial Mfg. Co., 161 Fed. Rep. 743, 746.

3. Emerson Co. v. Nimocks, 40 C. C. A. 87, 99 Fed. Rep. 737, 738; Pullman Palace Car Co. v. Wagner Palace Car Co., 38 Fed. Rep. 416, 424; Ives v. Hamilton, 92 U. S. 426, 432, 23 L. Ed. 494, 10 O. G. 336, 10 Brodix 405; Singer v. Braunsdorf, 7 Blatchf. 501, Fed. Case 12,897.

and an error in either part of the patent may thus be corrected by the aid of the other.[4] The specification governs, while the drawing merely illustrates.[5] It is not essential to the validity of the patent, however, that the drawing be mentioned or referred to in the description or the claims.[6] "The drawings are usually looked at only for the purpose of better understanding the meaning of the claim, and certainly not for the purpose of changing it and making it different from what it is."[7] Omissions or inconsistencies in the drawing may be overcome by an adequate description.[8] When the description is defective, the drawings alone may have to be looked to in order to ascertain the form, proportion and position of the parts of a patented machine;[9] though a claim, otherwise void in view of the prior state of the art, cannot be sustained by reference to the particular angle at which the drawing shows one part of the mechanism to be held by another part,[10] and a broad description and claim will not be restricted to the device of the drawing.[11] A part shown in the drawings but not described or claimed is not covered by the patent.[12] The draw-

4. Hogg v. Emerson, 11 How. 587-606, 13 L. Ed. 824, 5 Brodix 279; Consolidated Brake Shoe Co. v. Detroit Steel & Spring Co., 59 Fed. Rep. 902; Banker v. Bostwick, 18 O. G. 61.

5. Hamilton v. Ives, 6 Fisher 244, Fed. Case 5, 982.

6. Emerson v. Hogg, 2 Blatchf. 1, Fed. Case 4, 440.

7. Mr. Chief Justice Fuller in Howe Machine Co. v. National Needle Co., 134 U. S. 388, 33 L. Ed. 963, 51 O. G. 475, 20 Brodix 199; followed in Wheaton v. Norton, 70 Fed. Rep. 833-842.

8. Western Telephone Mfg. Co. v. American Electric Telephone Co., 65 C. C. A. 313, 131 Fed. Rep. 75.

9. Schneider v. Lovell, 10 Fed. Rep. 666-668; Banker v. Bostwick, 3 Fed. Rep. 517.

10. Caverly v. Deere, 13 C. C. A. 452, 66 Fed. Rep. 305.

11. Consolidated Bunging App. Co. v. Metropolitan Brewing Co., 60 Fed. Rep. 93-95.

12. Couse v. Johnson, 16 O. G. 719.

ings may be amended to conform to the description,[13] and will be referred to in construing an ambiguous claim.[14]

§ 23. Defective drawing as ground for reissue.

Where a defect exists in the drawing which would render it impossible to construct an operative machine according to the drawing, the fact justifies the issuance of a reissue.[15] But a part of a device referred to in the specification as an incidental detail of the mechanism, with no suggestion that it formed a part of the combination which was new, and not included in the drawings of the original, cannot be made a feature of a reissue by embracing it in the new drawings and specifying it as an essential feature of the invention, where adverse equities have arisen.[16]

§ 24. Working drawings unnecessary.

It is not necessary that the drawings be detailed working drawings.[17] Indeed, a drawing is not to be regarded as a working plan, unless it is so stated in the specification.[18]

§ 25. Drawings may show alternative constructions.

While it is very doubtful whether the showing of alternative constructions has ever benefited a patent, such

13. Consolidated Brake Shoe Co. v. Detroit Steel & Spring Co., 59 Fed. Rep. 902.

14. Koerner v. Deuther, 143 Fed. Rep. 544, 545.

15. Beach v. American Box Mach. Co., 63 Fed. Rep. 597-603.

16. Carpenter Straw Sewing Machine Co. v. Searle, 60 Fed. Rep. 83.

17. American Hide & Leather Splitting and Dressing Mach. Co. v. American Tool Mach. Co., 4 Fisher, 284, Fed. Case 302; Royer v. Coupe, 29 Fed. Rep. 358.

18. Elgin Co-operative Butter-Tub Co. v. Creamery Package M. Co., 80 Fed. Rep. 294, 25 C. C. A. 426; Caverly's Admr. v. Deere & Co., 13 C. C. A. 452, 66 Fed. Rep. 305.

showing is permissible and where the alternative forms are within the same claims, the difference in their disclosures is immaterial.[19]

§ 26. Proceedings to obtain the grant of Letters Patent.

It is not contemplated to include in this book a comprehensive treatment of Patent Office practice. But the intimate connection existing between the Patent Office proceedings and the issued patent require a general summary of the subject in this place.

§ 27. The Patent Office—how constituted.

The Patent Office of the United States is a part of the Department of the Interior;[20] its administration being entrusted to a commissioner, assistant commissioners and three Examiners-in-chief appointed by the President, the remainder of the staff being appointed by the Secretary of the Interior upon the nomination of the Commissioner of Patents.[21] The Secretary of the Interior must approve all orders of disbarment made by the Commissioner of Patents (under § 487, R. S. U. S.), and the regulations which, from time to time, the Commissioner may establish for the conduct of proceedings in the Patent Office (under § 483, R. S. U. S.). But though he is charged in § 441, R. S. U. S., "with supervising all public business relating to * * * patents for inventions," the Secretary of the Interior has no authority to reverse the action of the Commissioner of Patents in granting or withholding a patent.[22]

19. Schreiber v. Grimm, 19 C. C. A. 67, 72 Fed. Rep. 671.
20. Sec. 475, R. S. U. S.
21. Sec. 476, R. S. U. S.
22. Butterworth v. United States, 112 U. S. 50, 28 L. Ed. 656.

§ 28. The Patent Office bar.

Attorneys at law, and persons not attorneys at law who furnish evidence of their competence in assisting applicants before the Patent Office, may be registered for the purpose of practicing in the Patent Office. Subject to the accused having opportunity to be heard, and subject to the approval of the Secretary of the Interior, practitioners may be disbarred for unprofessional conduct by the Commissioner, and his order is not appealable.[23]

§ 29. Statutory prerequisites to filing application.

The statutes[24] particularly enumerate the matter to be embodied in the description, claims and oath, and provide that the applicant may be required to furnish a model, or, in the case of compositions of matter, specimens, of his invention.

The authority to grant a patent depends on an application made and pending for that purpose.[25]

§ 30. The classes of patentable subject-matter.

There are five classes of inventions enumerated in the patent statutes—under the titles of art, machine, manufacture, composition of matter and designs. Whether designs were ever properly classed as inventions is a mooted question. The first four are the fundamental groups of which Commissioner Butterworth said, "It is evident that the words 'art,' 'machine,' 'manufacture,' and 'composition of matter,' were carefully chosen to cover what were regarded as four great and distinct classes of inventions. It is undoubtedly the in-

23. Wedderburn v. Bliss, 83 Off. Gaz. 296, 12 App. D. C. 485.

24. §§ 4888-4892, inclusive, R. S. U. S.

25. Railway Register Mfg. Co. v. Broadway & Seventh Ave. Ry. Co., 26 Fed. Rep. 522, 525.

tention of the law to distinguish as separate inventions 'a new art,' 'a new machine,' 'a new manufacture,' 'a new composition of matter,' 'an improved art,' 'an improved machine,' 'an improved manufacture,' 'an improved composition of matter,'—eight in all. These may be called the 'statutory classes of inventions,' between which the lines of division are sharply drawn."[26]

The subject-matter of each of these four divisions requires distinct consideration. The solicitor must determine in which division the invention belongs before he can draft his specification, and the lawyer must prepare his offensive or defensive case from the same starting point.

§ 31. Process.

The word "Art" as used in the patent statutes is the synonym of "process."

> "A process, *eo nomine*, is not made the subject of a patent in our act of Congress. It is included under the general term 'useful art.' An art may require one or more processes or machines in order to produce a certain result or manufacture. The term machine includes every mechanical device or combination of mechanical powers and devices to perform some function and produce a certain effect or result. But where the result or effect is produced by chemical action, by the operation or application of some element or power of nature, or of one substance to another, such modes, methods, or operations, are called processes. A new process is usually the result of discovery; a machine, of invention. The art of tanning, dyeing, making water-

26. In Ex parte Blythe, 30 Off Gaz. 1321, 1322.

proof cloth, vulcanizing India rubber, smelting ores, and numerous others, are usually carried on by processes, as distinguished from machines. One may discover a new and useful improvement in the process of tanning, dyeing, etc., irrespective of any particular form of machinery or mechanical device. And another may invent a labor-saving machine by which this operation or process may be performed, and each may be entitled to his patent. * * * It is when the term process is used to represent the means or method of producing a result that it is patentable, and it will include all methods or means which are not effected by mechanism or mechanical combinations.'"[27]

Of the four primary divisions into which patentable inventions fall (disregarding designs), all must originate as mental concepts, or abstract thought; as the Supreme Court has pointed out, the process alone remains invisible to the eye, a conception of the mind, known only by its results, while the machine, the manufacture and the composition of matter develop into tangible and visible substance.[28]

Processes fall naturally into two groups; those in which chemical action alone is employed, and those in which the operation of the process is effected by mechanical means. Of the first class there was never any question that they were the proper subjects of patents. As to the second class, it has always been held that if the process consisted of the mere function or principle of a particular mechanism, it was not patentable; but whether, if the method could be practiced by several me-

27. Grier, J., in Corning v. Burden, 15 How. 252, 267, 14 L. Ed. 683. To the same effect, see New Process Fermentation Co. v. Maus, 20 Fed. Rep. 725.

28. Cochrane v. Deener, 94 U. S. 780, 24 L. Ed. 139.

chanical instrumentalities, so that it existed, as an invention, independently from any particular machinery used in its performance, it was patentable, grave doubt was long entertained by the courts.[29]

This doubt has been settled (finally, it is to be hoped) by an opinion so comprehensive as to be worthy of extended quotation:

> "It is lastly contended, and this is perhaps the most important question in the case, that in view of the former declaration and opinions of this court, what is termed a process patent relates only to such as are produced by chemical action, or by the operation or application of some similar elemental action, and that such processes do not include methods or means which are effected by mere mechanical combinations, and a part of the language used in Corning v. Burden, 15 How. 252, 14 L. Ed. 683, and Risdon Iron & Locomotive Works v. Medart, 158 U. S. 68, 39 L. Ed. 899, is seized upon in support of this contention. We have no disposition to question the decision in those cases.
>
> "An examination of the extent of the right to process patents requires consideration of the object and purposes of the Congress in exercising the constitutional power to protect, for a limited period, meritorious inventions or discoveries. Section 4886, R. S. S. U., provides: 'Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvement thereof * * * may * * * obtain a patent therefor.'

29. Appleton Mfg. Co. v. Star Mfg. Co., 60 Fed. Rep. 411, 9 C. C. A. 42; Wells Glass Co. v. Henderson, 67 Fed. Rep. 930, 15 C. C. A. 84.

"This is the statute which secures to inventors the right of protection; and it is not the province of the courts to so limit the statute as to deprive meritorious inventors of its benefits. The word 'process' is not used in the statute. The inventor of a new and useful art is distinctly entitled to the benefit of the statute as well as he who invents a machine, manufacture, or composition of matter. The word 'process' has been brought into the decisions because it is supposedly an equivalent form of expression, or included in the statutory designation of a new and useful art.

"What, then, is the statutory right to a patent for a 'process' when the term is properly considered? Curtis, in his work on the Law of Patents, says: 'A process may be altogether new, whether the machinery by which it is carried on be new or old. A new process may be invented or discovered, which may require the use of a newly-invented machine. In such a case, if both the process and the machine were invented by the same person, he could take separate patents for them. A new process may be carried on by the use of an old machine in a mode in which it was never used before. * * * In such a case, the patentability of the process in no degree depends upon the characteristic principle of the machine, although machinery is essential to the process, and although a particular machine may be required.' Curtis, Patents, 4th Ed., § 14, note.

"In Robinson on Patents, vol. 1, § 167, it is said: 'While an art cannot be practiced except by means of physical agents, through which the force is brought in contact with or is directed toward its object, the existence of the art is not dependent on any of the special instruments employed. It is a

legal, practical invention in itself. Its essence remains unchanged, whatever variation takes place in its instruments, as long as the acts of which it is composed are properly performed.'

"And Walker on Patents, 4th Ed., § 3, states that valid process patents may be granted for 'operations which consist entirely of mechanical transactions, but which may be performed by hand or by any of several different mechanisms or machines.'

"It is undoubtedly true, and all the cases agree, that the mere function or effect of the operation of a machine cannot be the subject-matter of a lawful patent. But it does not follow that a method of doing a thing, so clearly indicated that those skilled in the art can avail themselves of mechanism to carry it into operation, is not the subject-matter of a valid patent. The contrary has been declared in decisions of this court. A leading case is Cochrane v. Deener, 94 U. S. 780, 24 L. Ed. 139, in which this court sustained a process patent involving mechanical operations, and in which the subject was discussed by Mr. Justice Bradley, speaking for the court. On page 787 that learned justice said: 'That a process may be patentable, irrespective of the particular form of the instrumentalities used, cannot be disputed. * * * Either may be pointed out; but, if the patent is not confined to that particular tool or machine, the use of the others would be an infringement, the general process being the same. 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 of thing. If new and useful, it is just as patentable as is a piece of machinery. In the language of the

patent law, it is an art. The machinery pointed out as suitable to perform the process may or may not be new or patentable, whilst the process itself may be altogether new, and produce an entirely new result. The process requires that certain things should be done with certain substances and in a certain order; but the tools to be used in doing this may be of secondary consequence.'

"This clear and succinct statement of the rule was recognized and applied (Mr. Justice Bradley again speaking for the court) in the case of Tilghman v. Proctor, 102 U. S. 707, 26 L. Ed. 279. In the course of the opinion the learned justice tersely says: 'A machine is a thing. A process is an act, a mode of acting. The one is visible to the eye,—an object of perpetual observation. The other is a conception of the mind,—seen only by its effects when being executed or performed. Either may be the means of producing a useful result.'

"That this court did not intend to limit process patents to those showing chemical action or similar elemental changes is shown by subsequent cases in this court.

In Westinghouse v. Boyden Power Brake Co., 170 U. S. 537, 42 L. Ed. 1136, the opinion was written by the same eminent justice who wrote the opinion in Risdon Iron & Locomotive Works v. Medart, 158 U. S. supra, and, delivering the opinion of the court, he said:

'These cases (158 U. S. 68, and Wicke v. Ostrum, 103 U. S. 461, 26 L. Ed. 409) assume, although they do not expressly decide, that a process, to be patentable, must involve a chemical or other similar elemental action; and it may be still regarded as an open question whether the patentability of pro-

cesses extends beyond this class of inventions.' And added these significant words:

'Where the process is simply the function or operative effect of a machine, the above cases are conclusive against its patentability; but where it is one which, though ordinarily and most successfully performed by machinery, may also be performed by simple manipulation, such, for instance, as the folding of paper in a peculiar way for the manufacture of paper bags, or a new method of weaving a hammock, there are cases to the effect that such a process is patentable, though none of the powers of nature be invoked to aid in producing the result. Eastern Paper Bag Co. v. Standard Paper Bag Co., 30 Fed. Rep. 63; Union Paper Bag Mach. Co. v. Waterbury, 39 Fed. Rep. 389; Travers v. American Cordage Co., 64 Fed. Rep. 771. This case, however, does not call for an expression of our opinion upon this point, nor even upon the question whether the function of admitting air directly from the train pipe to the brake cylinder be patentable or not, since there is no claim made for an independent process in this patent, and the whole theory of the specification and claims is based upon the novelty of the mechanism.'

"And the same learned justice wrote the opinion of the court in Carnegie Steel Co. v. Cambria Iron Co., 185 U. S. 403, 46 L. Ed. 968, and sustained a process patent. If, by any construction, that process could be said to involve a 'chemical or other similar elemental action,' no stress was laid upon that fact. This court, speaking through Mr. Chief Justice Waite, sustained a patent in the Telephone Cases, 126 U. S. 1, 31 L. Ed. 863, for a method of transmitting electrical undulations similar in form

to the vibrations of the air accompanying vocal sounds, and at the same time the patent for the apparatus by which the method was operated was sustained.

"In Leeds & C. Co. v. Victor Talking Mach. Co., decided at this term, 213 U. S. 301, 318, 53 L. Ed. 495, 500, this court said: 'A process and an apparatus by which it is performed are distinct things. They may be found in one patent; they may be made the subject of different patents.'

"We therefore reach the conclusion that an invention or discovery of a process or method involving mechanical operations, and producing a new and useful result, may be within the protection of the Federal statute, and entitle the inventor to a patent for his discovery.

"We are of opinion that Golding's method was a substantial improvement of this character, independently of particular mechanisms for performing it, and the patent in suit is valid as exhibiting a process of a new and useful kind."[30]

§ 32. Machine.

The second division of subject-matter enumerated in § 4886, R. S. U. S., is "machines." There has been some discussion by text writers as to whether the word "machine" includes tools.[31] While this question is largely academic, it is a legitimate inquiry, suggested by two apparently conflicting dicta of the Supreme Court. In Corning v. Burden, 15 How. 252, 14 L. Ed. 683, it was said "The term "machine" includes every mechanical device or combination of mechanical powers and devices

30. Mr. Justice Day, in Expanded Metal Co. v. Bradford, 214 U. S. 366, 381, 53 L. Ed. 1034, 1039.

31. Macomber, Fixed Law of Patents, § 768; Robinson on Patents, § 175.

to produce some function and to produce a certain effect or result;"[32] while in Burr v. Duryee, 68 U. S. 531, 17 L. Ed. 750, it is said, "A machine is a concrete thing, consisting of parts, or of certain devices. The principle of a machine is properly defined to be 'its mode of operation' or the peculiar combination of devices which distinguishes it from other machines." This doctrine of Burr v. Duryee has been repeated and amplified in so many of the later cases that the student can readily understand that the text writer would prefer to exclude tools from classification as machines if he could do so legitimately. Indeed Professor Robinson has taken his stand upon the score of expediency, rather than authority, when he says, "In spite of some doubts on the part of judges and law writers as to the existence of such a distinction as is here indicated between machines and other instruments, it is nevertheless certain that the harmony of the law and the proper application of the decisions of the courts to their subject-matter require it to be drawn. The whole doctrine of '*modus operandi*,' as the distinguishing element of a machine, is involved in it and inexplicable without it; and it has been sufficiently recognized to place it among the established features of our patent system."[33]

So able a patent judge as Judge Lowell apparently classified tools as machines. He said, "The argument that a machine must be automatic in order to be patentable is not sound. A piano is not automatic, nor is any tool or implement intended for use by hand, but improvements in any such tool used in an art or industry are patentable."[34]

32. Followed in Chicago Sugar Refining Co. v. Pope Glucose Co., 84 Fed. Rep. 981.

33. Robinson on Patents, § 175, note 1.

34. Coupe v. Weatherhead, 16 Fed. Rep. 673, 675. To the same effect see Oliver v. White, 18 So. Car. 241.

To exclude tools from classification as machines is to simplify the application of the rule that the function or result or principle of a machine is not patentable.[35] With this explanation, the definition of Corning v. Burden is sufficient for the purposes of our present inquiry.

Inventions relating to Machines have been judicially classified as follows:[36] First, inventions embracing the entire (new) machine. Second, those embracing one or more of the elements of the machine, but not the entire machine. Third, those embracing a new element and a new combination of old elements. Fourth, those where all the elements of the machine are old and the invention resides merely in a new combination of those elements.

§ 33. Manufacture.

This is the title given by § 4886, R. S. U. S., to the third division of patentable subjects. It has been defined by Judge Acheson thus: "The term 'manufacture,' as used in the patent law, has a very comprehensive sense, embracing whatever is made by the art or industry of man, not being a machine, a composition of matter, or a design."[37]

In Merrill v. Yeomans, 94 U. S. 568, 24 L. Ed. 635, the Supreme Court in construing a patent which recited "In carrying on my new manufacture of deodorizing heavy oils with this apparatus," said that the word "manufacture" was here used in the sense of the word "process," a word which could be substituted for it, without a shade of change in the meaning. The Supreme Court certainly did not intend to rule that "manufacture" and "process" are synonymous. Probably the

35. See Expanded Metal Co. v. Bradford, 214 U. S. 366, 53 L. Ed. 1034.

36. This classification is that of Clifford, J., in Union Sugar Refinery v. Mathiesson, Fed. Case 14,399, 3 Clifford 639.

37. Johnson v. Johnston, 60 Fed. Rep. 618, 620.

best definition that can be gathered from the cases is that the word "manufacture" includes every mechanical or chemical product which is new and useful and embodies the exercise of invention, which is neither a "machine" or "a composition of matter." For the purposes of this definition, tools may be classified indifferently as "machines" or "manufactures."

It is obvious that, to be patentable, a manufacture must be dependent upon its own novel and useful and patentable characteristics, independent of the agency by which it is made, and of the ingredients of which it is composed. A new manufacture may be produced by an old machine and from old ingredients. The novelty of the machine has no bearing upon the patentability of the manufacture, and if it depends for novelty upon its ingredients, it will be patentable, usually, as a composition of matter.

"Articles of manufacture may be new in the commercial sense when they are not new in the sense of the patent law. New articles of commerce are not patentable as new manufactures, unless it appears in the given case, that the production of the new article involved the exercise of invention or discovery beyond what was necessary to construct the apparatus for its manufacture or production."[38]

"Nothing short of invention or discovery will support a patent for a manufacture any more than for an art, machine or composition of matter, for which proposition there is abundant authority in the decisions of this court."[39]

"It is quite obvious that a manufacture, or a product of a process, may be no novelty, while, at the same

38. Glue Co. v. Upton, 6 Off. Gaz. 840.

39. Mr. Justice Clifford, in Union Paper Collar Co. v. Van Deusen, 90 U. S. 530-566, 23 L. Ed. 128, 133.

time, the process or agency by which it is produced may be both new and useful—a great improvement on any previously known process, and therefore patentable as such. And it is equally clear, in cases of chemical inventions, that when, as in the present case, the manufacture claimed as novel is not a new composition of matter, but an extract, obtained by the decomposition or disintegration of material substances, it cannot be of importance from what it has been extracted. There are many things, well known and valuable in medicine, or in the arts, which may be extracted from divers substances. But the extract is the same, no matter from what it has been taken. A process to obtain it from a subject from which it has never been taken may be the creature of invention, but the thing itself, when obtained, cannot be called a new manufacture. It may have been in existence and in common use before the new means of obtaining it was invented, and possibly before it was known that it could be extracted from the subject to which the new process is applied. Thus, if one should discover a mode, or contrive a process, by which prussic acid could be obtained from a subject in which it is not now known to exist, he might have a patent for his process."[40]

§ 34. Composition of matter.

By "Composition of Matter" is meant a mixture or chemical combination of materials.[41] "The product must have some distinctly new property, or be applicable to some new use."[42]

40. Strong, J., in 'The Wood-Paper Patent, 23 Wall. 566, 23 L. Ed. 31.

41. Bouvier Dict., title "Composition of Matter."

42. Morris, J., in Van Camp v. Maryland Pavement Co., 34 Fed. Rep. 740-743, 43 Off. Gaz. 884.

A specification of a new composition of matter giving only the names of the substances which are to be mixed together, without stating the relative proportions, or stating the proportions ambiguously or vaguely, is void.[43]

"A discovery of a new substance by means of chemical combinations of known materials is empirical, and discovered by experiment. Where patent is claimed for such a discovery, it should state the component parts of the new manufacture claimed with clearness and precision, and not leave the person attempting to use the discovery to find it out 'by experiment.'"[44]

§ 35. Composition of matter; construction and infringement.

This is the fourth subdivision of patentable subject-matter described in § 4886, R. S. U. S. The term "composition of matter" is the equivalent in meaning of "compound," and has thus been defined judicially, "A patentable compound or composition of matter is one that is produced by the intermixture of two or more specific ingredients, and possesses properties pertaining to none of those ingredients separately, thereby accomplishing a new and useful result."[45]

It is clear that a substance patentable as a composition of matter, might also be patentable as a manufacture. In such a case if the patent claimed only the article of manufacture, although it described the ingredients of a new composition of matter, the failure to claim the composition would result in its dedication to the public.[46]

43. Wood v. Underhill, 46 U. S., 5 How. 1, 12 L. Ed. 23.

44. Mr. Justice Grier in Tyler v. Boston, 74 U. S., 7 Wallace 327 19 L. Ed. 93.

45. Lane v. Levi, 21 App. D. C. 168, 104 Off. Gaz. 1898.

46. Underwood v. Gerber, 149 U. S. 224, 37 L. Ed. 710.

Speaking further of patents for compositions of matter, Mr. Justice Shepard has said, "The patentee who seeks protection for such a composition must describe with clearness and precision the component parts thereof, the process of their intermixture, and the result.[47]

"The identity of a composition depends, in general, upon the identity of its ingredients and of their co-operative law, as well as upon the identity of the properties and effect of the composition as a whole.[48]

"The addition, however, of substances that do not, by their interaction, change the properties, effect, or usefulness of the composition, does not destroy its identity. The composition is the same if its properties substantially remain.[49]

"Nor is a patent for a compound any less infringed through the substitution of one of its ingredients by another substance well known in the arts at the date of the patent, as endowed with the same capacity, and which, therefore, does not change its properties and effect.[50]

"On the other hand, it is an undoubted principle of the patent law that the omission of one of a combination of old parts distinctly claimed in the patent is not an infringement."[51]

Almost every rule affecting the validity of patents for compositions of matter can be applied in the same terms to patents for new articles of manufacture. The

47. Citing Tyler v. Boston, 74 U. S., 7 Wallace 327, 330, 19 L. Ed. 93; 1 Robinson Patents, § 192; 2 Idem, §§ 500 and 532.

48. Citing, 1 Robinson Patents, § 300.

49. Citing, 1 Robinson Patents, § 195; Klein v. Russell, 19 Wall. 433, 22 L. Ed. 116.

50. Citing 1 Robinson Patents, § 247; Fuller v. Yentzer, 94 U. S. 288, 297, 24 L. Ed. 103; Rowell v. Lindsay, 113 U. S. 97, 102, 28 L. Ed. 906; Fay v. Cordesman, 109 U. S. 408, 420, 27 L. Ed. 979; Hubbell v. U. S., 179 U. S. 77, 82, 45 L. Ed. 95.

51. Lane v. Levi, 21 App. D. C. 168, 104 Off. Gaz. 1898.

following illustrative paragraph is from the pen of Judge Coxe, whose opinions in patent cases are notable: "If one discovers a new and useful product he is entitled to the full benefit thereof no matter how it may be produced. Merrill v. Yeomans, 94 U. S. 568, 24 L. Ed. 235. A patent for a product must produce, by the process it describes, that article and no other. If the article be old it cannot be the subject of a patent even though made artificially for the first time. '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.' Cochrane v. Badische Anilin & Soda Fabrik, 111 U. S. 293, 310, 28 L. Ed. 433. A product is not patentable upon the ground that an already known article is made more perfectly by the new process or machine than it was before. If this rule were otherwise the product of each successive machine would be patentable. Improvements in degree of quality are not the subject of a patent. Wooster v. Calhoun, 11 Blatchf. 215, Fed. Case 18,035. 'A new process is usually the result of discovery, a machine of invention.' Corning v. Burden, 15 How. 252, 14 L. Ed. 503. 'A distinction must be observed between a new article of commerce and a new article which, as such, is patentable. Any change in form from a previous condition may render the article new in commerce. * * * When certain properties are known to belong generally to classes of articles, there can be no invention in putting a new species of the class in a condition for the development of its properties similar to that in which other species of the same class have been placed for similar development.' Milligan & Higgins Glue Co. v. Upton, 97 U. S.

3, 24 L. Ed. 985. The claims in question cover a new article of manufacture—a product as distinguished from a process."[52]

§ 36. Non-patentability of business systems.

In considering the question indicated in the above title, the student finds that the Patent Office has persistently granted patents for the class of alleged inventions which, for want of a better terminology, may be called "business systems."

The Maybaum Patent Number 465,485, for "means for securing against excessive losses by bad debts," contained claims of which the following is typical:

"(1) The means for securing merchants and others from excessive losses by bad debts, which consist of a sheet provided with separate spaces and suitable headings, substantially as described, for the name of the assurer, the name of the assured, the percentage or amount beyond which assurance is given, the class or classes of persons, as to rating, capital, or otherwise, in respect to whom said losses are guaranteed against, and the percentage of said capital or the amount which said losses must not exceed."

Judge Blodgett sustained a demurrer to a bill charging infringement of this patent, saying "I do not intend to decide that a man may not have a patent for a mode of keeping accounts, or for a form of tabulating amounts or statistics; but am clearly of opinion that his patent cannot be construed to cover a business principle such as a law of averages, which seems to have been the purpose of the specifications in his patent."[53] Judge

52. Badische Anilin & Soda Fabrik v. Kalle, 94 Fed. Rep. 163, 171.

53. United States Credit System Co. v. American Indemnity Co., 51 Fed. Rep. 721, 754.

Wheeler in another case reached the same conclusion, saying "this (patent) is for a method of transacting common business, which does not seem to be patentable as an art."[54] In affirming Judge Wheeler, Judge Lacombe said, "The holder of this patent has not, by it, secured any monopoly of the 'transactions' to be recorded; and such transactions having their origin and completion independent of this patent, there is not patentable novelty in the use of sheets for the purpose of recording them."[55]

A similar patent for "means for securing railroads and shippers against loss of freight," met with the same adjudication, the opinion of the Appellate Court saying "All this evidences good judgment upon the part of one who is experienced in the particular business, but it does not rise to the level of invention."[56]

Another patent of the same general class was for a "method of and means for cash-registering and account-checking." The Appellate Court said "It is manifest that the subject-matter of the claims is not a machine, manufacture or composition of matter. If within the language of the statute at all, it must be as a 'new and useful art.' * * * In the sense of the patent law, an art is not a mere abstraction. A system of transacting business disconnected from the means for carrying out the system is not, within the most liberal interpretation of the term, an art. Advice is not patentable."[57]

The case last referred to appears to place patents relating to systems of doing business, employing only

54. United States Credit System Co. v. American Credit Indemnity Co., 53 Fed. Rep. 818, 819.

55. United States Credit System Co. v. American Credit Indemnity Co., 59 Fed. Rep. 139, 143, 8 C. C. A. 49.

56. Wallace, J., in Hocke v. N. Y. Central & H. R. R. Co., 122 Fed. Rep. 467, 469, 58 C. C. A. 627.

57. Coxe, J., in Hotel Security Checking Co. v. Lorraine Co., 160 Fed. Rep. 467, 469, 87 C. C. A. 451.

ruled sheets or strips of paper, and having no mechanical elements, among the things that are not patentable, upon the proper ground. They are not within the classes of patentable subject-matter specified in § 4536, R. S. U. S., and that objection is quite sufficient.

§ 37. Function.

The question of function enters into the law of patents both as a determining factor in determining the validity of combination claims, and as one of the comparative tests of identity in determining the question of infringement. The importance of the word is the result of the judicial interpretation of the patent statutes; it is not named therein. All that the statute (§ 4886, R. S. U. S.) exacts of a patent for a machine is that it shall be new, useful, and embody invention.

Every patentable and operative combination of mechanical elements has as its primary origin the conception of a need to be filled, and an idea of means to accomplish the satisfaction of that need. These are purely mental operations, which manifestly fall short of possible monopolization by patent. The idea of means, by embodiment in written words and accompanied by such pictorial explanation as the law requires and the necessities of the case demand, when lodged in the Patent Office acquires constructive reduction to practice, and may ripen into a patent. But to justify the contractual relationship thus entered into between the patentee and that public which (at least in theory) is the party of the first part, the patentee must have disclosed, as a consideration for his patent franchise, and his claim must embrace, a means for accomplishing a defined result. He must present a map of the road to the desired destination. If he merely points out the destination, and points out no path of travel to that destination, his claim is merely a wall built to encircle the desired point, and a demand of tribute from all who would travel that way.

This comparison is presented in the effort to distinguish between "function" and "result." A truly functional claim is an attempt to build a wall between the result and those who seek that result. Function and result are not identical. Function and principle are not identical, nor are function and mode of operation the same. The inventor must not claim "any road to Rome," or "all roads to Rome," but the road to Rome which he has discovered, and which he surveys and stakes for the guidance of those who would follow him.

In meeting these requirements the inventor is directed by the statutory mandate; "in the case of a machine, he shall explain the principle thereof, and the best mode in which he has contemplated applying that principle, so as to distinguish it from other inventions; and he shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery" (§ 4888, R. S. U. S).

With these introductory cautions, we are prepared to approach the analysis of the cases in order to get a working idea of what "function" is, and why claims have been held to be void because they were functional, and to learn, if we may, why the ablest patent lawyers have differed as to whether given claims were functional or not.

We will premise our clinical investigation with a very recent statement of a rule of law which has been established for more than half a century. "A valid patent cannot be secured for a function, a mode of operation, or a result, separate from the means or mechanical devices by which the result is accomplished."[58]

58. E. B. Adams, J., in Union Match Co. v. Diamond Match Co., 162 Fed. Rep. 148, 151, 89 C. C. A. 172. To the same effect see Matthews v. Shoneberger, 4 Fed. Rep. 635, 18 Off. Gaz. 1464; Lull v. Clark, 13 Fed. Rep. 456; Hatch v. Moffitt, 15 Fed. Rep. 252; Lawther v. Hamilton, 21 Fed. Rep. 811; Royer v. Schultz Belting Co.,

As this statement is not tautological, we see at once that "function" is not synonymous with either "mode of operation" or "result."

There is an auxiliary rule which carries us a step further in our investigation. "Since a function is not patentable, a combination of functions is not; nor is a combination of mechanical devices or elements and one of the functions of that combination."[59]

We turn to the case in which the last-quoted announcement was made, for an illustrative application of the doctrine of function. There were in suit two patents granted to one Hien. The first Hien patent contained this claim:

"The combination, in a brake beam, of a hollow beam, a strut, end plugs or caps, 8, and a truss rod, 3, which extends through the caps, 8, and is provided with nuts, substantially as and for the purposes specified." [60]

The second Hien patent embodied these claims:

"A metallic brake beam, consisting of a compression member, a tension member, and an interposed strut; the compression member having a camber, and the beam

28 Fed. Rep. 850; Goshen Sweeper Co. v. Bissell Carpet Sweeper Co., 72 Fed. Rep. 67, 19 C. C. A. 13; Stearns v. Russell, 85 Fed. Rep. 218, 29 C. C. A. 121; Palmer Pneumatic Tire Co. v. Lozier, 90 Fed. Rep. 732, 33 C. C. A. 255; Cary Mfg. Co. v. Neal, 90 Fed. Rep. 725; National Hollow Brake Beam Co. v. Interchangeable Brake Beam Co., 106 Fed. Rep. 693, 45 C. C. A. 544; O'Reilly v. Morse, 15 How. 62, 14 L. Ed. 601; Corning v. Burden, 15 How. 252, 14 L. Ed. 683; Corn Planter Patent, 23 Wall. 181, 23 L. Ed. 161; Roberts v. Ryer, 91 U. S. 150, 23 L. Ed. 267; Fuller v. Yentzer, 94 U. S. 288, 24 L. Ed. 103; Crescent Brewing Co. v. Gottfried, 128 U. S. 158, 32 L. Ed. 390; Miller v. Eagle Mfg. Co., 151 U. S. 186, 38 L. Ed. 121; Westinghouse v. Boyden Power Brake Co., 170 U. S. 537, 556, 42 L. Ed. 1136.

59. Sanborn, J., in National Hollow Brake Beam Co. v. Interchangeable Brake Beam Co., 106 Fed. Rep. 693, 709, 45 C. C. A. 544.

60. National Hollow Brake Beam Co. v. Interchangeable Brake Beam Co., 106 Fed. Rep. 693, 699, 45 C. C. A. 544.

structure containing means of adjustment whereby the camber of the compression member is produced and the resiliency of the beam made available.

"A metallic brake beam, consisting of a hollow compression member, a tension member, and an interposed strut; the compression member having a camber, and the beam structure containing means of adjustment whereby the camber of the compression member is produced and the resiliency of the beam made available.

"In a trussed brake beam, the combination of a tension member having threaded ends and nuts therefor, a strut, and a cambered compression member, which maintains the tension of the parts and prevents the rotation of the nuts, substantially as specified."[61]

The functional issue is stated and the rule applied by the court, thus: "Turning to the first, second, and seventh claims of the second patent of Hien, we are met by the contention of counsel for the appellee that they are anticipated by the combination of his first patent, because the camber or resilience in the beam, which is the only new factor in these claims, may be produced, maintained, and adjusted by simply turning the nuts of the former device. In opposition to this view counsel for the appellants argued that this camber in the beam or the cambered beam of the second patent is a new element, not described or claimed, and not found, in the combination of the first patent, and that its addition to that combination constitutes a new and patentable invention. The argument is ingenious and persuasive, but it is certainly fallacious. The camber or resilience in the beam is one of the products or functions of the brake beam of the first patent; not, indeed, the ultimate function which that beam was created to perform, the

61. National Hollow Brake Beam Co. v. Interchangeable Brake Beam Co., 106 Fed. Rep. 693, 700, 45 C. C. A. 544.

function of stopping cars, but nevertheless a function of that device, because it may be produced by the use of that combination by simply turning the nuts upon the ends of its tension rod. Now, the function or result of the operation of a machine or combination is not patentable under our laws, and therefore the camber in the beam could not be monopolized by means of a patent. The means, the mechanical device, by which that camber was produced and that alone, was capable of protection by such a franchise.'' [62]

A pointed illustration of the difficulty attendant upon the application of the doctrine under consideration involved the following claim of the Westinghouse, Jr., Patent No. 360,072:

"In a brake mechanism the combination of a main air pipe, an auxiliary reservoir, a brake cylinder, and a triple valve having a piston whose preliminary traverse admits air from the auxiliary reservoir to the brake cylinder, and which by further traverse admits air directly from the main air pipe to the brake cylinder, substantially as set forth.'' [63]

The Supreme Court in the majority opinion by Mr. Justice Brown, said:

"In the construction of this claim, the district judge was of opinion that it was broad enough to cover other devices in which air was admitted directly from the train pipe to the brake cylinder by the further traverse of the piston actuating a valve admitting such air, and that the defendants could not exculpate themselves from the charge of infringement by the fact that in their device the

62. National Hollow Brake Beam Co. v. Interchangeable Brake Beam Co., 106 Fed. Rep. 693, 708, 45 C. C. A. 544.

63. Westinghouse v. Boyden Power Brake Co., 170 U. S. 537, 543, 24 L. Ed. 1136, 1139.

train-pipe air was admitted through the triple-valve chamber, and not through a by-passage, nor by the fact that in their device the further traverse of the piston opens the main valve in a special manner, which produces the same result, but does not make use of a separate auxiliary valve.

"Upon the other hand, the Circuit Court of Appeals held that 'the transmission of train-pipe air and auxiliary reservoir air simultaneously to the brake cylinder is a result of (or) function, and is not patentable;' that 'the means by which this or any other result or function is accomplished may be many and various, and if these several means are not mechanical equivalents, each of them is patentable.' It was of opinion that when the second claim, 'in its language describing the action of that device, failed to describe any means by which the extreme traverse of the piston produced it, declaring merely that the piston, 'by a further traverse, admits air directly from the main air pipe to the brake cylinder,' it was fatally defective, claiming only a result, which is public property, and not identifying the specific means (his own property) by which the result is achieved.'

"It is true, as observed by the Court of Appeals, that the further traverse of the piston for use in cases of emergency had been shown in prior patents, but it had never been employed for the purpose of admitting air directly from the main air pipe to the brake cylinder until the patent in suit was taken out.

"The claim in question is, to a certain extent, for a function, *viz.*, the admission of air directly from the train pipe to the brake cylinder, and is only limited to such function when performed by the

further traverse of the piston of the triple valve. This limitation, however, does not obviate the objection that the means are not fully and specifically set forth for the performance of the function in question.

"The difficulty we have found with this claim is this: That, if it be interpreted simply as a claim for the function of admitting air to the brake cylinder directly from the train pipe, it is open to the objection, held in several cases to be fatal, that the mere function of a machine cannot be patented.

"This rule was clearly laid down in the leading case of Corning v. Burden, 56 U. S. (15 How.) 252, 14 L. Ed. 683, in which Mr. Justice Grier, delivering the opinion of the court, drew the distinction between such processes as were the result or effect of 'chemical action, by the operation or application of some element or power of nature, or of one substance to another,' and the mere result of the operation of a machine, with regard to which he says: 'It is for the discovery or invention of some practical method or means of producing a beneficial result or effect, that a patent is granted, and not for the result or effect itself. It is when the term 'process' is used to represent the means or method of producing a result that it is patentable, and it will include all methods or means which are not affected by mechanism or mechanical combination.

"'But the term process is often used in a more vague sense, in which it cannot be the subject of a patent. Thus we say that a board is undergoing the process of being planed, grained or being ground, iron of being hammered or rolled. Here the term is used subjectively or passively as applied to the material operated on, and not to the method or mode

of producing that operation, which is by mechanical means, or the use of a machine, as distinguished from a process.'

"'In this use of the term it represents the function of a machine, or the effect produced by it on the material subjected to the action of the machine. But it is well settled that a man cannot have a patent for the function or abstract effect of a machine, but only for the machine which produces it.'

"In the subsequent case of Burr v. Duryee, 68 U. S. (1 Wall.) 531, 570, 17 L. Ed. 650, 658, Mr. Justice Grier laid down the same principle as follows: 'The Patent Act grants a monopoly "to anyone who may have discovered or invented any new and useful art, machine, or composition of matter." * * * That law requires that the specification "should set forth the principle and the several modes in which he has contemplated the application of that principle, or character by which it may be distinguished from other inventions, and shall particularly point out the part, improvement, or combination which he claims as his own invention or discovery." We find here no authority to grant a patent for a principle or a mode of operation, or an *idea*, or any other abstraction. A machine is a concrete thing, consisting of parts, or of certain devices and combination of devices. The principle of a machine is properly defined to be "its mode of operation," or that peculiar combination of devices which distinguish it from other machines. A machine is not a principle or an idea. The use of ill-defined abstract phraseology is the frequent source of error. It requires no great ingenuity to mystify a subject by the use of abstract terms of indefinite or equivocal meaning. Because the law requires a

patentee to explain the mode of operation of his peculiar machine, which distinguishes it from others, it does not authorize a patent for a "mode of operation as exhibited in a machine." Much less can any inference be drawn from the statute, that an inventor who has made an improvement in a machine, and thus effects the desired result in a better or cheaper manner than before, can include all previous inventions, and have a claim to the whole art, discovery, or machine which he has improved. All others have an equal right to make improved machines, provided they do not embody the same, or substantially the same, devices, or combination of devices, which constitute the peculiar characteristic of the previous invention.'

"So, also, in Fuller v. Yentzer, 94 U. S. 288, 24 L. Ed. 103, this court, speaking through Mr. Justice Clifford, also said: 'Patents for a machine will not be sustained if the claim is for a result, the established rule being that the invention, if any, within the meaning of the patent act, consists in the means or apparatus by which the result is obtained, and not merely in the mode of operation, independent of the mechanical devices employed; nor will a patent be held valid for a principle or for an idea, or any other mere abstraction.'

"Most of the prior authorities upon this subject are reviewed in the recent case of Risdon Iron & Locomotive Works v. Medart, 158 U. S. 68, 39 L. Ed. 899, in which it was also held that a valid patent could not be obtained for a process which involved nothing more than the operation of a piece of mechanism, or the function of a machine. See, also, to the same effect, Wicks v. Ostrum, 103 U. S. 461, 469, 26 L. Ed. 409, 410. These cases assume, although

they do not expressly decide, that a process to be patentable must involve a chemical or other similar elemental action, and it may be still regarded as an open question whether the patentability of processes extends beyond this class of inventions. Where the process is simply the function or operative effect of a machine, the above cases are conclusive against its patentability; but where it is one which, though ordinarily and most successfully performed by machinery, may also be performed by simple manipulation, such, for instance, as the folding of a paper in a peculiar way for the manufacture of paper bags, or a new method of weaving a hammock, there are cases to the effect that such a process is patentable, though none of the powers of nature be invoked to aid in producing the result. Eastern Paper Bag Co. v. Standard Paper Bag Co., 30 Fed. Rep. 63; Union Paper Bag Machine Co. v. Waterbury, 39 Fed. Rep. 389; Travers v. American Cordage Co., 64 Fed. Rep. 771. This case, however, does not call for an expression of our opinion upon this point, nor even upon the question whether the function of admitting air directly from the train pipe to the brake cylinder be patentable or not, since there is no claim made for an independent process in this patent, and the whole theory of the specification and claims is based upon the novelty of the mechanism.

"But if the second claim be not susceptible of the interpretation that it is simply for a function, then the performance of that function must be limited to the particular means described in the specification for the admission of air from the train pipe to the brake cylinder."[64]

64. Westinghouse v. Boyden Power Brake Co., 170 U. S. 537, 553, 42 L. Ed. 1136, 1142.

Mr. Justice Shiras' dissenting opinion, concurred in by Mr. Justice Brewer (Mr. Justice Gray and Mr. Justice McKenna also dissenting) says of this claim:

"The second claim of the patent is before us for construction on its own terms, and, to avoid protracting this discussion, the opinion of Judge Morris in the Circuit Court is referred to and adopted as a sound construction of that claim. 66 Fed. Rep. 997. This claim is not, as I read it, open to the objection that it aims to patent a principle. It sets forth the discovery that by a co-operation of the air from the auxiliary reservoir and that from the main air pipe, the action of the brakes is quickened and the air vented from the main air pipe directly to the brake cylinder.

"But even if the second claim must, as argued in the opinion of the court, be read, by reason of the letter of the claimant's attorney, as if it called for the auxiliary valve described in the first and fourth claims, and even if, when not so read, it can be regarded as void because simply for a function or principle, nevertheless the invention, as described in the other claims and specifications, is clearly set forth, and, under the evidence as to the state of the art, is entitled to be regarded as a pioneer. Regarding the second claim as a mere statement of the idea or invention and the other claims as describing a form or combination of mechanism which embodies the invention and renders it operative, all the requisites of the law are sufficiently complied with."[65]

In adopting the opinion of the Circuit Court respecting claim 2, Mr. Justice Shiras sends us to the opinion of Judge Morris, from which we quote:

"The first three elements of this claim are the usual mechanism of an automatic air brake. The remaining

65. Westinghouse v. Boyden Power Brake Co., 170 U. S. 537, 583, 42 L Ed. 1136, 1152.

element, which was the only novel one at the date of the patent, is a triple valve having a piston which, by two distinct movements, performs two distinct functions,—the first, its preliminary traverse, by which it admits air from the auxiliary reservoir to the brake cylinder, which is the ordinary effect of the usual movement of the triple-valve piston; and the second, its further traverse, which is a new and distinct use, admitting air directly from the main air pipe to the brake cylinder, resulting in venting the main pipe and in producing the quick action. Now this, as I understand it, was the invention which Westinghouse brought to light. He discovered, and by experiment demonstrated, that, by a further traverse of the triple piston, train-pipe air could be vented from the train pipe, and that it would give two very important results, namely: First, quickening of the action of the brakes from the forward to the rear cars, so that the application of the brakes became almost instantaneous on all cars; and, second, utilizing the vented air for direct action in the brake cylinder.

"Now, although quick-action emergency brakes were being sought for, no one before Westinghouse had accomplished this result, and the means by which he accomplished it were entirely novel. Indeed, upon first impression, it is paradoxical and startling to find that, when a sudden, quick, and powerful application of brakes is needed in the face of impending danger, it is to be obtained by a sudden large release of the pressure in the train pipe, to the extent of 15 or 20 pounds below that in the auxiliary reservoir, and that by using this low-pressure air to operate the brake cylinder, instead of the air under greater pressure stored in the auxiliary reservoir, this remarkably effective application of the brakes is obtained. In the domain of quick-action brakes, this device would seem to belong to that class of pioneer

inventions, the patents for which are to be construed so as to be co-extensive with the real invention, if the language of the claim will permit it.

"It is shown that Westinghouse was the first who used a further traverse of the triple-valve piston to perform the operation required to vent the train pipe into the brake cylinder to effect quick action. The result was new, and the means were new. His claim 2 is broad enough in language to cover every device in which that is done by the further traverse, admitting air directly from the train pipe to the brake cylinder, substantially by the means described in the specifications; that is, by the further traverse actuating a valve which so admits the train-pipe air. * * * In his specifications of patent No. 481,135, Boyden alleges that his device differs essentially from Westinghouse's patent No. 360,070, and involves a new mode of operation. The question whether it does or does not was the very question then pending in this suit, and, so far as the examiner passed upon it in allowing the specification to stand, he did so upon the ex parte application of Boyden, and unassisted by testimony as to the state of the art at the date of the Westinghouse patent, and without testimony as to the scope of the Westinghouse quick-action invention, and its great importance and merit; and therefore without the opportunity of judging whether or not it was a pioneer invention of a fundamental character, entitled to a construction co-extensive with the invention, or was simply a patent for an improvement in a known art, to be restricted to the form of the device shown in the model and illustrations. The determination of that question is the starting point in the consideration of the controversy, and, in my judgment, the fact that Westinghouse was the first discoverer of the vital underlying invention should turn the scale in his favor. The complainants

are entitled to a decree for an injunction and account, with reference to a master in the usual form."[66]

The opinion of the Circuit Court of Appeals[67] need not be referred to, except as to that part which illustrates the views of that court upon the theory of function, as we have presented it in the introductory portion of this title: "We think that when claim 2 of 360,070, in its language describing the action of that device, failed to describe the means by which the extreme traverse of the piston produced it, declaring merely that the piston, 'by a further traverse, admits air directly from the main air pipe to the brake cylinder,' it was fatally defective, claiming only a result, which is public property, and not identifying the specific means (his own property) by which the result is achieved. That this invention of Westinghouse, thus undefined, is one of the highest value to the public, and that it is a pioneer one in the art of quick-action air brakes, is not denied, and is conceded. It is conspicuously one of those pioneer inventions which entitle the proprietor to a liberal protection from the courts in construing the claim. But there is a limit to the judicial liberality in this direction. If an inventor is ambiguous, or obscure, or halt, or limp in his language of description, the courts will help him out, and so construe the claim as to give distinct identity to his device. If there be a doubt in the mind of the court or of a jury on the issue of mechanical equivalency, the court will give, and instruct the jury to give, the benefit of the doubt to the pioneer inventor. But where the inventor falls so far short in his description as to claim only the result which his machine accomplishes, and omits an explicit definition of the means

66. Morris, J., in Westinghouse v. Boyden Power Brake Co., 66 Fed. Rep. 997, 1001-1007.

67. Boyden Power Brake Co. v. Westinghouse Air Brake Co., 70 Fed. Rep. 816, 17 C. C. A. 430.

by which he does it, as in the case at bar, the courts have another duty to perform, one which they owe to the public and to the worthy fraternity of inventors, and must decline to give him general rights where he is entitled only to special rights."[68]

The Westinghouse case to which we have given such extended consideration is the most notable case in the courts of the United States bearing upon the knotty problem of function. Argued October 22 and 23, 1896, re-argued March 1 and 2, 1897, again re-argued March 10 and 11, 1898, and decided by a bare majority of five to four on May 9, 1898, it left the problem of function exactly where it found it—so interwoven with other considerations that always arise when the functional question is raised, that to separate those portions of an opinion dealing with the charge that the claim is functional, from those that deal with the standing of the claim in its art, and from those that deal with what the defendant has done by way of infringement, is nearly always difficult, and at times well-nigh impossible.

Judge Morris and the four dissenting justices in the Westinghouse case were apparently swayed throughout their entire reasoning by their conviction that the patent in suit was "for a pioneer invention of a fundamental character." (Judge Morris, 66 Fed. Rep. at page 1007); while the bare majority of the Supreme Court said explicitly: "We are inclined to look with more favor upon this (the defendant's) device, not only because it is a novel one and a departure from the Westinghouse patent but because it solved at once in the simplest manner the problem of quick action, whereas the Westinghouse patent did not prove to be a success until certain

68. Boyden Power Brake Co. v. Westinghouse Air Brake Co., 70 Fed. Rep. 816, 17 C. C. A. 430.

additional members had been incorporated into it."[69]

Theoretically, the question of function should be determined as a matter of pure examination of the claim and description; practically, it is not. The counsel for the patent can best entrench themselves upon the lines indicated by the opinions of Judge Morris and Mr. Justice Shiras; counsel against the patent usually raise the defense of function as the next to last resort, the defense of aggregation being entitled to the honor of last place.

§ 38. Mode of operation.

The term "mode of operation" is self-defining. It applies to instrumentalities which have a self-contained law of operation. The writer finds no authority in the cases for the doctrine that the term can ever be applied to articles of manufacture, which have no "*modus operandi.*"[70] The relationship of the mode of operation to the machine was thus stated by Mr. Justice Grier:

> "A machine is a concrete thing, consisting of parts, or of certain devices and combinations of devices. The principle of a machine is properly defined to be its 'mode of operation,' or that peculiar combination of devices which distinguish it from other machines. We find here no authority to grant a patent for a 'principle' or a 'mode of operation' or an *idea* or any other abstraction. * * * A machine is not a principle or an idea. The use of ill-defined abstract phraseology is the frequent source of error. It requires no great ingenuity to mystify a subject by the use of abstract terms of

69. Mr. Justice Brown, in 170 U. S. at page 572.

70. See Walker on Patents, § 37. Compare Robinson on Patents, § 175.

indefinite or equivocal meaning. Because the law requires a patentee to explain the mode of operation of his peculiar machine, which distinguishes it from others, it does not authorize a patent for a 'mode of operation as exhibited in a machine.'"[71]

That the mode of operation of a machine is an integral part of the invention embodied in the machine has been recognized by the Supreme Court. "We are entitled to look at the practical operation of the machine. * * * If the device of the respondent shows a substantially different mode of operation, even though the result of the operation of the machine remains the same, infringement is avoided."[72]

The analysis of the mode of operation of a combination claim will frequently determine the question whether the claim is a true combination or merely an aggregation "of several results, each the complete result of one of the combined elements."[73] This may be termed the first application of the "mode of operation" as a test for the claim. Although the doctrine of aggregation applies to articles of manufacture as well as to machines,[74] and articles of manufacture have no "mode of operation," the primary test of a machine combination is to determine whether the disclosed mode of operation discloses a unitary result, which may be either a new result, or an old result attained in a better or cheaper manner.[75]

71. Burr v. Duryee, 1 Wall. 531, 17 L. Ed. 650.

72. Cimiotti Unhairing Co. v. American Fur. Ref. Co., 198 U. S. 399, 413, 49 L. Ed. 1100, 1107.

73. National Cash Register Co. v. American Cash Register Co., 53 Fed. Rep. 367, 3 C. C. A. 559.

74. Antisdel v. Chicago Hotel Cabinet Co., 89 Fed. Rep. 308, 32 C. C. A. 216.

75. Bowers v. Von Schmidt, 63 Fed. Rep. 572.

When the next test is applied to the machine combination claim, of fixing its status in the art by its comparison with the prior art, the mode of operation is still of paramount importance, because want of novelty in the mode of operation will negative invention.[76] The exploration of the art may disclose that the mode of operation of the claim being tested is merely the combined operation of two old combinations, as where two old machines are so connected as to subject the product of one machine to the operation of the other. This is merely an aggregation of the prior separate mechanisms, with their inherent individual modes of operation, and therefore is unpatentable.[77]

On the other hand, its mode of operation may be invoked to save the claim, inasmuch as no former device can anticipate it unless it has the same mode of operation.[78] The case of a corn-sheller patent, in which the same parts existed in the same combination in the prior art, but the patent was saved by a finding of a new mode of operation resulting from a reversal of motion of one of the parts, is typically illustrative.[79]

We finally find the mode of operation to be possibly the most important of the tests of infringement. It is usually stated that substantial identity between the two machines must be found, both as to function, mode of operation, and result; but the question of result is so frequently complicated with the question of double use, and the question of function is attended with such uncertainty in its application, that the first step in establishing identity to hold an alleged infringer, after a formal showing

76. Burt v. Evory, 133 U. S. 110 Fed. Rep. 765, 49 C. C. A. 163. 349, 33 L. Ed. 647.

77. Goss Printing Press Co. v. Scott, 108 Fed. Rep. 253, 47 C. C. A. 302; and to the same effect see Burnham v. Union Mfg. Co.,

78. Haines v. McLaughlin, 135 U. S. 584, 22 L. Ed. 241.

79. Keystone Mfg. Co. v. Adams, 151 U. S. 139, 38 L. Ed. 103.

of identity of elements or their equivalents, is the establishment of identity in mode of operation of the defendant's machine with that of the patent—to show that "in substantially the same way," as well as "by substantially the same means," it accomplishes substantially "the same end."[80] The substantial identity of result will not establish the infringement unless that result is reached in substantially the same way,[81] but where the mode of operation of the patent is adopted, infringement is not averted by non-essential changes of form or structure.[82]

§ 39. Result.

Inasmuch as § 4886, R. S. U. S., has named manufactures and compositions of matter as two of the four classes of patentable subject-matter defined by it, it follows that wherever the courts have said (as they often, and properly have) that a result is not patentable, they had no reference to either of the classes named, both of which are the result or product of methods or unpatentable operations. The Supreme Court has quite adequately settled the rule that a result, or effect, is not patentable.

> "Patents for a machine will not be sustained if the claim is for a result, the established rule being that the invention, if any, within the meaning of the patent act, consists in the means or apparatus by which the result is obtained."[83]

80. Scott v. Hoe, 70 Fed. Rep. 781, 17 C. C. A. 410.

81. Werner v. King, 96 U. S. 218, 24 L. Ed. 96; Engle Sanitary & Cremation Co. v. City of Elwood, 73 Fed. Rep. 484.

82. Hutter v. De Q. Bottle Stopper Co., 128 Fed. Rep. 283, 62 C. C. A. 652; O. H. Jewell Filter Co. v. Jackson, 140 Fed. Rep. 340, 72 C. C. A. 304.

83. Clifford, J., in Fuller v. Yentzer, 94 U. S. 288, 24 L. Ed. 103.

"It is for the discovery or invention of some practicable method or means of producing a beneficial result or effect, that a patent is granted, and not for the result or effect itself."[84]

"A patent is not good for an effect, or the result of a certain process, as that would prohibit all other persons from making the same thing by any means whatsoever."[85]

The question of identity of result is an important factor in the determination of questions of infringement.[86] But as results are not patentable, there may be identity of result without the existence of infringement, as identity of result is no evidence of infringement unless substantially the same means, operating in substantially the same way, have been employed.[87]

On the other hand, non-identity of result is by no means conclusive that infringement does not exist. This is the necessary sequence of the rule that the inventor is entitled to all of the uses of which his invention is capable.[88]

It is by their results that the utility of methods or machines is judged. A patent that is inoperative[89] as well as one whose only use is injurious or in violation of good morals or police regulations[90] is invalidated by its result.

84. Grier, J., in Corning v. Burden, 15 How. 252, 14 L. Ed. 683.

85. McLean, J., in LeRoy v. Tatham, 14 How. 156, 14 L. Ed. 367.

86. Electric Railroad Signal Co. v. Hall Railroad Co., 114 U. S. 87, 29 L. Ed. 96.

87. See ante, title "Mode of Operation," § 38, p. 77.

88. Roberts v. Ryer, 91 U. S. 150, 23 L. Ed. 267; Western Electric Co. v. La Rue, 139 U. S. 601, 35 L. Ed. 294; Potts v. Creager, 155 U. S. 597, 39 L. Ed. 275.

89. Bliss v. Brooklyn, 10 Blatchf. 521, Fed. Case 1, 546.

90. National Automatic Device Co. v. Lloyd, 40 Fed. Rep. 89.

§ 40. Trademarks applied to patented articles.

It is foreign to the scope of this treatise to dwell at any great length upon the subject of trademarks, in their relationship to patented articles. But any intelligent reading of the numerous cases in which the trademarks applied to patented articles are concerned must be premised upon an understanding of the fundamental difference between trademarks and patents (even design patents).

§ 41. Trademark defined.

A trademark is a distinctive name, word, mark, emblem, design, symbol or device, used in lawful commerce to indicate or authenticate the source from which has come, or through which has passed, the chattel upon or to which it is applied or affixed.[91]

This definition of trademark is believed to be sufficiently accurate and comprehensive for workable use.

The difference between trademarks and patents has been thus treated of by Mr. Justice Miller in Trademark Cases;[92] "the ordinary trademark has no necessary relation to invention or discovery. The trademark recognized by the common law is generally the growth of a considerable period of use, rather than a sudden invention. It is often the result of accident rather than design, and when under the act of Congress it is sought

91. Hopkins on Trademarks, § 2

92. 100 U. S. 82, 94, 25 L. Ed. 550, 552. See, also, Taylor v. Carpenter, 2 Sandf., Ch. 603, 11 Paige 292; Cox Manual, Case No. 84; Levy v. Waitt, 21 U. S. App. 394, 61 Fed. Rep. 1008, 10 C. C. A. 227; Hoyt v. Hoyt, 143 Pa. St. 623, 24 Am. St. Rep. 575; Sarrazin v. W. R. Irby Cigar Co., 93 Fed. Rep. 624, 626, 35 C. C. A. 496. A trademark "may be, and usually is, wholly destitute of originality." Mr. Justice Brown in Duer v. Corbin Cabinet Lock Co., 149 U. S. 216, 223, 37 L. Ed. 707. To the same effect, see Wm. J. Moxley Co. v. Braun & Fitts Co., 93 Ill. App. 183.

to establish it by registration, neither originality, invention, discovery, science or art is in any way essential to the right conferred by that act. If we should endeavor to classify it under the head of writings of authors, the objections are equally strong. In this, as in regard to inventions, originality is required. And while the word *writings* may be liberally construed, as it has been, to include original designs for engravings, prints, etc., it is only such as are *original,* and are founded in the creative powers of the mind." And in the House of Lords, in 1882, Lord Blackburn said,[93] "trademarks have sometimes been likened to letters patent and sometimes to copyrights, from both of which they differ in many respects. And I think to borrow a phrase used by Lord Ellenborough in Waring v. Cox,[94] with reference to a different branch of the law 'much confusion has arisen from similitudinary reasoning on the subject.'"

This distinction is further borne out by a case in which it was sought to sustain a design patent for a horseshoe calk by the argument that the design served to distinguish the complainant's goods from those of other makers. The *per curiam* opinion of the Circuit Court of Appeals of the second circuit says "the designers of articles of manufacture not otherwise entitled to receive design patents cannot justify the issuance of such patents on any theory that the design is a trademark."[95]

The incidental use of a trademark upon a patented article creates a peculiar termination of the life of that trademark, but does not otherwise alter its characteristics. In his treatise on the law of trademarks the writer has presented a monograph upon this topic from which the following is taken:

93. Johnston v. Orr Ewing, 7 App. Cas. 219, 228

94. 1 Camp. 369.

95. Rowe v. Blodgett & Clapp Co., 112 Fed. Rep. 61, 50 C. C. A. 120.

Names of patented articles. The general rule as to the name applied to a patented article during the life of the patent, is that upon the expiration of the patent, the public acquires the right to make, use, and sell the patented article, and to distinguish it by the name which it bore during the life of the patent.[96]

In the leading case upon this subject, Mr. Justice White, speaking for the United States Supreme Court, explained the reason of the rule as follows: "It is self-

96. Fairbanks v. Jacobus, Fed. Case No. 4608, 14 Blatchf. 337; Singer Mfg. Co. v. Stanage, 6 Fed. Rep. 279; Adee v. Peck Bros. & Co., 39 Fed. Rep. 209; Singer Mfg. Co. v. June, 163 U. S. 169 (reversing Singer Mfg. Co. v. June, 41 Fed. Rep. 208); Wilcox & Gibbs S. M. Co. v. The Gibbens Frame, 17 Fed. Rep. 623; Singer Mfg. Co. v. Bent, 163 U. S. 205 (reversing Singer Mfg. Co. v. Bent, 41 Fed. Rep. 214); Centaur Co. v. Killenberger, 87 Fed. Rep. 725; Singer Mfg. Co. v. Larsen, 8 Biss. 151, Fed. Case 12, 902; Burton v. Stratton, 12 Fed. Rep. 696-700; Goodyear Rubber Co. v. Day, 22 Fed. Rep. 44; Singer Mfg. Co. v. Riley, 11 Fed. Rep. 706; Wheeler & Wilson Mfg. Co. v. Shakespear, 39 L. J. Ch. 36; Tucker Mfg. Co. v. Boyington, Fed. Cas. 14,229; 9 Off. Gaz. 455; Filley v. Child, 16 Blatchf. 376; Fed. Cas. 4787; Ralph v. Taylor, L. R. 25 Ch. D. 194; Linoleum Mfg. Co. v. Nairn, 7 Ch. D. 834; Young v. Macrae, 9 Jur. N. S. 322; Re Palmer's Trademark, 24 Ch. D, 504; Re Leonard & Ellis Trademark, 26 Ch. D. 288; Brill v. Singer Mfg. Co., 41 Ohio St. 127, 52 Am. Rep. 74; Hiram Holt Co. v. Wadsworth, 41 Fed Rep. 34; Coats v. Merrick Thread Co., 36 Fed. Rep. 324; Centaur Co. v. Heinsfurter, 84 Fed. Rep. 955, 28 C. C. A. 581; Lorillard v. Pride, 28 Fed. Rep. 434; Gally v. Colt's Patent Fire Arms Mfg. Co., 30 Fed. Rep. 118; Dover Stamping Co. v. Fellows, 163 Mass. 191, 47 Am. St. Rep. 448; Centaur Co. v. Robinson, 91 Fed. Rep. 889; Centaur Co. v. Neathery, 91 Fed. Rep. 891, 34 C. C. A. 118; followed in Centaur Co. v. Reinecke, 34 C. C. A. 684, 91 Fed. Rep. 1001; Centaur Co. v. Hughes Bros. Mfg. Co., 91 Fed. Rep. 901, 34 C. C. A. 127; Centaur Co. v. Marshall, 97 Fed. Rep. 785, 38 C. C. A. 413, affirming Centaur Co. v. Marshall, 92 Fed. Rep. 605; Warren Featherbone Co. v. American Featherbone Co., 72 C. C. A. 571, 141 Fed. Rep. 513; B. B. Hill Co. v. Sawyer-Boss Mfg. Co., 112 Fed. Rep. 144.

evident that on the expiration of a patent the monopoly created by it ceases to exist, and the right to make the thing formerly covered by the patent becomes public property. It is upon this condition that the patent is granted. It follows, as a matter of course, that on the termination of the patent there passes to the public the right to make the machine in the form in which it was constructed during the patent. We may therefore dismiss without further comment the complaint, as to the form in which the defendant made his machines. It equally follows from the cessation of the monopoly and the falling of the patented device into the domain of things public, that along with the public ownership of the device there must also necessarily pass to the public the generic designation of the thing which has arisen during the monopoly, in consequence of the designation having been acquiesced in by the owner, either tacitly, by accepting the benefits of the monopoly, or expressly, by his having so connected the name with the machine as to lend countenance to the resulting dedication. To say otherwise would be to hold that, although the public had acquired the device held by the patent, yet the owner or the manufacturer of the patented thing had retained the designated name which was essentially necessary to vest the public with the full enjoyment of that which has become theirs by the disappearance of the monopoly. In other words, that the patentee or manufacturer could take the benefit and advantage of the patent upon the condition that at its termination the monopoly should cease, and yet when the end was reached disregard the public dedication and practically perpetuate indefinitely an exclusive right.

"The public having the right on the expiration of the patent to make the patented article and to use its generic name, to restrict this use, either by preventing its

being placed upon the articles when manufactured, or by using it in advertisements or circulars, would be to admit the right and at the same time destroy it. It follows, then, that the right to use the name in every form passes to the public with the dedication resulting from the expiration of the patent.

"Nor is this right governed by different principles where the name, which has become generic, instead of being an arbitrary one, is the surname of the patentee or original manufacturer."[97]

There appears to be an exception to this general rule where the use of the name antedates the existence of the patent, and where it further appears that the name and not the patent gave its value to the article.[98]

In accordance with the general rule, the Patent Office has declined to register a trademark which is the name of a patented article,[99] even in association with an arbitrary symbol.[100]

It is by no means clear what trademarks applied to patented articles, other than mere names or words descriptive of the thing patented, will become *publici juris* upon the expiration of the patent. Thus the Supreme Court of Massachusetts has held that where a special word, device or symbol is added to the general descriptive name of the article of the patent, it is possible that the trademark right may exist in the combination of the word and the device or symbol, notwithstanding the expiration of the patent.[101]

97. Singer Mfg. Co. v. June Mfg. Co., 163 U. S. 169, 185, 41 L. Ed. 118, 124.

98. Batcheller v. Thomson, 35 C. C. A. 532, 93 Fed. Rep. 660, 665.

99. Ex p. Velvril Co., Ltd., 84 Off. Gaz. 807.

100. Holophane Glass Co., 100 Off. Gaz. 450; Ex p. Farnum & Co., 18 Off. Gaz. 412.

101. Dover Stamping Co. v. Fellows, 163 Mass. 191, 47 Am. St. Rep. 448.

In this connection, Lindley, L. J., says: "I do not mean to say that a manufacturer of a patented article cannot have a trademark not descriptive of the patented article, so as to be entitled to the exclusive use of that mark after the patent has expired, for instance, if he impressed upon the patented articles a griffin, or some other device; but, if his only trademark is a word or set of words descriptive of the patented article of which he is the only maker, it appears to me to be impossible for him ever to make out, as a matter of fact, that his mark denotes him as the maker, as distinguished from other makers."[102]

In every case of the kind under consideration, however, others will be enjoined from using the mark in such a way as to deceive the public into the false belief that they are getting the goods of the original owner of the mark.[103]

Thus in the leading case, the court found that the Singer Sewing Machine sold by the defendant after the expiration of the Singer patent, embodied features not a part of the patented article, and which had been used by the complainant to indicate itself as the manufacturer of the machine; and Mr. Justice White in reversing and remanding the case directed a decree of injunction in favor of the complainant, "perpetually enjoining the defendant, its agents, servants, and representatives, first, from using the word 'Singer' or any equivalent thereto, in advertisements in relation to sewing machines, without clearly and unmistakably stating in all said advertisements that the machines are made by the defendant, as distinguished from the sewing machines made by the Singer Manufacturing Company; second, also perpet-

102. Re Palmer's Trademark, L. R. 24 Ch. D. 504-521.

103. Singer Mfg. Co. v. Charlebois, 16 Rap. Jud. Q. C. S. 167; Centaur Co. v. Link, 62 N. J. Eq. 147, 49 Atl. Rep. 828.

ually enjoining the defendant from marking upon sewing machines or upon any plate or device connected therewith or attached thereto the words 'Singer,' or words or letters equivalent thereto, without clearly and unmistakably specifying in connection therewith that such machines are the product of the defendant or other manufacturers, and therefore not the product of the Singer Manufacturing Company."[104]

It is manifest, however, that to create this right in the public, two conditions of facts are prerequisite; first, there must have been a patent, second, the patent must have expired.

Where the owner of the trademark had made an unsuccessful application for a patent upon the article to which the trademark was applied, Bradley, J., held that he had a valid subsisting right to the trademark upon the rejection of his application, and said "His failure to establish his patent (which would have covered all his rights) ought not to preclude him from falling back on his right to the trademark."[105]

In a case where the patent had not expired, Judge Vann, speaking for the Court of Appeals of New York, said: "Assuming that upon the expiration of the patent any one may use the name, until that time arrives, why should the inventor be deprived of a right which, without question, would be his if he had not taken out a patent for his invention."[106]

Where a name indicating a patented article exists, an exclusive licensee for the sale of the patented articles under a license to which the defendant is not a party can-

104. Singer Mfg. Co. v. Bent, 163 U. S. 205, 41 L. Ed. 118, 131.

105. Sawyer v. Kellogg, 7 Fed. Rep. 720, 723.

106. Waterman v. Shipman, 130 N. Y. 301, reversing s. c., 8 N. Y. Supp. 814.

not enjoin him from conducting an unfair competition by means of the name; the licensor not being a party to the action, and no infringement of the patent being charged, and the defendant having the right to deal in the articles known by the name.[107] If the patent is reissued the trademark will be valid during the life of the reissued patent.[108]

§ 42. The name given an unpatented invention by the inventor.

Such names clearly should, if otherwise unobjectionable, be treated as valid trademarks in the hands of the inventor or his assigns. Under the rule discussed in the next section, if the inventor patents his invention, he cannot lengthen his monopoly's duration by applying a trademark to the patented article; his right to the trademark expires with the life of the letters patent. Where he elects to dedicate his invention to the public, his right to adopt a trademark for such specimens as he himself may manufacture, is obvious. But the name by which he distinguishes his invention, being the necessary name of the article, cannot be used by another, holding no assignment from the inventor.[109]

§ 43. Necessary name of a product.

The necessary name of a product, natural or manufactured, cannot be a trademark, for the reasons we have discussed. This is true of goods manufactured under a patent. The descriptive name by which they are known during the life of the letters patent becomes their popular name in the trade—the name by which they are necessarily known and distinguished. When, therefore, the

107. Johnson v. Seaman, 108 Fed. Rep. 951, 48 C. C. A. 158; reversing Seaman v. Johnson, 106 Fed. Rep. 915.

108. Hiram Holt Co. v. Wadsworth, 41 Fed. Rep. 34.

109. H. B. Chaffee Mfg. Co. v. Selchow, 131 Fed. Rep. 543.

protection of the patent has expired the name is *publici juris*, and the manufacturer under the letters patent can claim no trademark in it.[110]

Thus, the word "Linoleum" as applied to a kind of floor covering,[111] "Singer" applied to sewing machines,[112] and "Lanoline" applied to a wool-fat preparation,[113] were held to be *publici juris* upon the expiration of the letters covering the articles to which they were applied.

Analogous to this class of cases is that where new combinations of old elements are found, and it is sought to distinguish such a new compound or combination by joining the descriptive names of its constituent elements. This is best illustrated by a case where the words claimed as trademark were "Ferro-phosphorated Elixir of Calisaya Bark," which claim was distinctly negatived by the New York Court of Appeals, Folger, J., saying: "They may not be appropriated by one to mark an article of his manufacture, when they may be used truthfully by another to inform the public of the ingredients which make up an article made by him."[114] For this reason the name "Acid Phosphate" applied to a medicinal preparation,[115] and "Indurated Fibre" applied to wares made of wood-pulp,[116] are not valid trademarks; and the word "Bromo-Quinine" was refused registration

110. Centaur Co. v. Robinson, 91 Fed. Rep. 889; Same v. Neathery, 91 Fed. Rep. 891; Same v. Hughes Bros. Mfg. Co., 91 Fed. Rep. 901.

111. Linoleum Mfg. Co. v. Nairn, L. R. 7 Ch. D. 834, 47 L. J. Ch. 430, 38 L. T. N. S. 448, 26 W. R. 463, Seb. 536

112. Singer Mfg. Co. v. Bent, 163 U. S. 205; Singer Mfg. Co. v. June, 163 U. S. 169.

113. Jaffe v. Evans & Sons, Ltd., 75 N. Y. Supp. 257.

114. Caswell v. Davis, 58 N. Y. 223-233.

115. Rumford Chemical Works v. Muth, 35 Fed. Rep. 524.

116. Indurated Fibre Co. v. Amoskeag Fibre Co., 37 Fed. Rep. 695.

as a trademark for medicines,[117] as was also the word "Ferro-Manganese" as a mark for mineral waters,[118] and the word "Bromo-Celery" for a medicinal preparation.[119]

There are cases, however, where such words or combinations of words have been held not to be descriptive. Thus the word "Cocoaine" as applied to a hair wash compounded from cocoanut oil and other ingredients,[120] and "Magnetic Balm" as applied to a medicinal compound,[121] have been upheld as valid trademarks. The word "Electro-Silicon" applied to a polishing compound has also been upheld,[122] and it appears very clear that the words "Magnetic" or "Electric" as used in the two cases last referred to are purely arbitrary and fanciful.

We have noted that the Patent Office has refused registration to an applicant offering the word "Bromo-Quinine" as the name of a medicinal preparation. This decision is in hopeless conflict with some of the adjudicated cases. The word "Bromodia," as a trademark for a chemical combination of chloral hydrate, bromide of potassium and other substances, was admitted to registration and subsequently upheld as valid, the court upon final hearing saying that the word "has no meaning whatever except as connected with complainants' business, and as associated with and indicative of a soothing or soporific mixture prepared and sold by them."[123] The word "Bromo-Caffeine" was admitted to regis-

117. Re Grove, Newton, Dig. 192; s. c., Ibid. 191, 67 Off. Gaz. 1447.

118. Re Excelsior Springs Co., Newton Dig. 153.

119. Re Bromo-Celery Co., Newton Dig. 1453.

120. Burnett v. Phalon, 3 Keyes 594.

121. Smith v. Sixbury, 25 Hun. 232.

122. Electro-Silicon Co. v. Trask, 59 How. Pr. 189; Electro-Silicon Co. v. Hazard, 29 Hun. 369.

123. Battle & Co. v. Finlay (preliminary hearing), 45 Fed. Rep. 796; (final hearing), 50 Fed. Rep. 106.

tration, and upheld judicially, the Court of Appeals of New York saying, per Peckham, J.: "We think there is a distinction between the facts in this case and that of Caswell v. Davis.[124] In this case the term perhaps suggests that some one among the hundreds of substances that bromine may combine with has been used in such combination together with caffeine. There are, however, some seven different ingredients in the plaintiff's preparation, and there is no free bromine among them, and there is no evidence as to what the substance is which the bromine (if any) had combined with before being used in the preparation, and so it is plain that the words 'Bromo-Caffeine' do not in fact describe the ingredients or even give any clear general idea as to what they are."[125] It is the general rule that "when an article is made that was theretofore unknown, it must be christened with a name by which it can be recognized and dealt in, and the name thus given to it becomes public property, and all who deal in the article have the right to designate it by the name by which alone it is recognizable."[126]

Under peculiar circumstances a mark, otherwise a valid trademark, will become the common property of two or more merchants, each of whom may have a right to its use, provided he so uses it as not to pass off his goods as those of one of the others entitled to use the mark. Thus a plaintiff was refused an injunction restraining the use of the mark "Aramingo Check" to designate printed cloth made at the Aramingo Mills, where the defendant showed that the cloth sold by him under the mark was the product of the same mills, and

124. 58 N. Y. 223, cited supra.

125. Keasbey v. Brooklyn Chemical Works, 142 N. Y. 467, 476.

126. Wallace, J., in Leclanche Battery Co. v. Western Elec. Co., 23 Fed. Rep. 276.

the labels used by the respective parties differed in size and color so that confusion would not result from their use.[127]

§ 44. The inventor's use of his name as against assignees of his patents.

The use of proper names in connection with patented articles is governed in general by the same rules as trade-marks so used. It is obvious that the bare assignment of a patent does not divest the assignor of the right to use his own name in connection with articles made under his earlier or later patents, or from truthfully describing himself as the inventor of the subject-matter of the assigned patent. In such a case Judge Noyes has said: "Dr. Reed had no right to sell his improved shoe as the original shoe, but to prevent him in connection with the sale of the later shoe from describing himself as the inventor of the earlier one would be to give the complainant that which it neither bought or paid for."[128]

Where a patentee causes a corporation to be organized as licensee, with his name embodied in the corporate name, there is grave doubt whether he can compel the discontinuance of that use of his name upon the termination of the license. But such a licensee may then be enjoined from using his name upon its goods in such a way as to lead the public to believe they are still made under the patent.[129]

§ 45. Statutory authority of Commissioner.

The Commissioner of Patents is empowered by statute[130] to establish regulations, not inconsistent with law,

127. Colloday v. Baird, 4 Phila. 139; Cox' American Trademark Cases, 257.

128. Dr. A. Reed Cushion Shoe Co. v. Frew, 162 Fed. Rep. 887, 889, 89 C. C. A. 577.

129. Stimpson Computing Scale Co. v. W. F. Stimpson Co., 104 Fed. Rep. 893, 44 C. C. A. 241.

130. Sec. 483, R. S. U. S.

for the conduct of proceedings in the Patent Office, subject to the approval of the Secretary of the Interior. These rules, in so far as they are consistent with law, are as authoritative as the statutes. "If there is inconsistency between the rules and statute, the latter must prevail."[131]

§ 46. The petition.

As a matter of Patent Office procedure under rule, a petition is required to accompany the description and claims. The petition is addressed to the Commissioner of Patents and contains a recital of the name, nationality, residence and postoffice address of the applicant, and prays that a patent be granted upon the invention, which is therein named, referring to the specifications for its full disclosure.

While a petition has always been required to be presented by an applicant for letters patent, it is a very unimportant form, and seldom contains any reference to the invention except by its mere title, and a reference to the specifications.[132]

§ 47. The effect of the filing of an application upon the question of date of invention.

A rejected application is not sufficient to establish priority of invention under the statutes;[133] but "the courts have uniformly held that an application which eventuates in a patent, and which sufficiently describes the invention, is conclusive evidence that the invention

131. United States ex rel. v. Allen, 192 U. S. 543-565, 48 L. Ed. 555.

132. Hogg v. Emerson, 6 How. 437, 480, 12 L. Ed. 505, 523.

133. Automatic Weighing Machine Co. v. Pneumatic Scale Corp., 166 Fed. Rep. 288, 297, 92 C. C. A. 206.

was made at the time the application was filed."[134] So the Patent Office has always adhered to the rule that the filing of an allowable application for patent is a constructive reduction to practice.[135] These rules are founded upon the fact that the statutes define the necessary procedure to obtain a patent. "It is enough," says an oft-quoted opinion, "that the inventor has perfected his invention, and is able to furnish to the Patent Office such specifications (and model) as the law requires. Having done this, the patent, in so far as prerequisites to its validity, either by way of experiment or use, are material, is valid."[136]

§ 48. The description.

By the terms of § 4888 the description must be "in such full, clear, concise and exact terms as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected" to practice the invention. The degree of skill of the persons referred to has been commented upon by Judge Green thus: "Persons skilled in the art to which the specification is addressed are in fact those of ordinary and fair information * * * not those having very great technical knowledge relating to the subject-matter of the invention."[137] The necessity of this provision is self-evident. A full and accurate description is necessary to enable the Patent Office to judge correctly upon the questions of operativeness, utility, novelty, aggre-

134. Colt, J., in Automatic Weighing Machine Co. v. Pneumatic Scale Corp., 166 Fed. Rep. 288, 297, 92 C. C. A. 206.

135. Croskey v. Atterbury, 9 App. D. C. 207, 76 Off. Gaz. 163; Christensen v. Noyes, 15 App. D. C. 94, 90 Off. Gaz. 223; Silverman v. Hendrickson, 19 App. D. C. 381, 99 Off. Gaz. 1171; Davis v. Garrett, 28 App. D. C. 9, 123 Off. Gaz. 1991; Duryea v. Rice, 28 App. D. C. 423, 126 Off. Gaz. 1357.

136. Woodruff, J., in Wheeler v. Clipper Mower Co., 10 Blatchf. 181, Fed. Case 17, 493.

137. Tannage Patent Co. v. Zahn, 66 Fed. Rep. 986-989.

gation, and the like; to enable the government to know what is granted and what will become open to the public when the patent expires; to advise the public to what the monopoly of the patent extends; to let other inventors know what has been accomplished (at least on paper) in the art; to instruct assignees or licensees how to practice the invention; and to inform the courts in litigation in which the patent is used in evidence.[138] Viewing the patent as the analogue of a contract, the description (not the claim) is the inventor's contribution to scientific knowledge; hence it will vitiate the resulting patent if, by negligence or design, it fails to be so full, clear, concise and exact, as to enable the public to practice the invention, and such failure will be treated as is failure of consideration in the case of the contract.

§ 49. Description only a part of the specification.

The description is merely a part of the specification, of which the claims form the remainder.[139] This is made clear by a reading of the various sections of the Patent Act: In §§ 4888 and 4916 the words "specification and claim" are employed; in § 4902 the words "description" and "specification" are introduced; "but it is clear that the word 'specification,' when used without the word 'claim,' means description and claim."[140] The word "specification" is used with that comprehensive meaning in §§ 4884, 4895, 4902, 4903, 4917, 4920 and 4922.

138. Hogg v. Emerson, 6 How. 437, 12 L. Ed. 505, 5 Brodix 1; Bates v. Coe, 98 U. S. 31, 25 L. Ed. 68, 15 O. G. 337, 12 Brodix 150.

139. Badische Anilin & Soda Fabrik v. Higgin, 15 Blatchf. 290, Fed. Case No. 722.

140. Mr. Justice Blatchford, in Wilson v. Coon, 6 Fed. Rep. 611, 615.

These considerations lead us to the understanding of the rule of construction which is the subject of the next paragraph.

§ 50. The claims may be referred to in construing the description.

This rule rests upon the analogy of letters patent to contracts. Like contracts, the specification must be read as a whole, or from the four corners of the instrument, in weighing the intent of its contents, and ascertaining the metes and bounds of the invention; subject to the other rule, to be considered later, that while a claim may be limited, it can never be expanded, by reference to the description.[141]

"If a claim, uncertain when considered apart from the description, can by reference to the latter be rendered so clear as to satisfy the requirement of the statute, that the inventor 'shall particularly point out and distinctly claim' his invention, by parity of reasoning a doubtful point in the description, when considered apart from the claims, can by reference to the latter, when in themselves unambiguous, be rendered so clear as to satisfy the other requirement of the statute that the inventor shall fully and clearly set forth his invention in the description. That under such circumstances a description uncertain or indefinite when considered alone, but not inconsistent with the claims, may be rendered certain and sufficient to meet the requirements of the statute by reading the whole specification together has

141. McClain v. Ortmayer, 141 U. S. 419, 35 L. Ed. 800; Lehigh Valley Railroad Co. v. Mellon, 104 U. S. 112, 26 L. Ed. 639.

frequently been recognized and is, we think, a sound rule of law.'' [142]

§ 51. Distinguishing the invention.

The language of § 4888 is keenly specific; "and he shall particularly point out * * * the part, improvement, or combination which he claims as his invention or discovery."

"It is not enough to give such a description of the machine patented as to show, by comparing it with other machines, what part has been invented. * * * Where an improvement on a machine referred to the previous patent of the machine, as showing the part invented, it was held sufficient. It is not enough that the thing designed to be embraced by the patent should be made apparent on the trial, by a comparison of the new with the old machine. The specifications must be complete." [143]
"A description of the machine which mixes up the new and old, but does not describe what the invention is, cannot be sustained." [144]

§ 52. How drawings may aid description.

We have considered the function of the drawings as a part of the application. It is sufficient at this point to note the general rule as stated by Judge Wheeler: "The

142. Bradford, J., in Electric Smelting and Aluminum Co. v. Carborundum Co., 102 Fed. Rep. 618, 629, 42 C. C. A. 537; citing Battin v. Taggert, 17 How. 74, 85, 15 L. Ed. 37; The Corn-Planter Patent, 23 Wall. 181, 224, 23 L. Ed. 161; Carver v. Manufacturing Co., 2 Story 430, 466; Howes v. Nutes, 4 Cliff. 173, 174, Fed. Case 6,790; Ryan v. Goodwin, 3 Sumn. 514, 520, Fed. Case 12,186; Meyers v. Frame, 8 Blatchf. 446, 457, Fed. Case 9, 991; Parker v. Stiles, 5 McLean 44, 56 Fed. Case 10,749; Lowell v. Lewis, 1 Mason 182, 188, Fed. Case 8, 568.

143. Mr. Justice McLean, in Brooks v. Jenkins, 3 McLean 432, Fed Case 1, 953.

144. Mr. Justice Story, in Evans v. Eaton, 7 Wheat. 356, 5 L. Ed. 472.

drawing could and should be looked at, if necessary, in order to explain an ambiguous or doubtful specification, and to make the invention capable of being understood and used. But it cannot supply an entire want of any part of a specification or claim in a suit upon a patent, although it might afford ground for a reissue covering the part shown by it. U. S. R. S., § 4916.'"[145]

Where the court was conscious that the specification was "ambiguous and uncertain," on final hearing leave was granted to put proof in the record as to the true reading of the drawings, the court finding that the defendant infringed the claim.[146] The drawing alone, in the absence of any descriptive matter, in the original specification, cannot support a reissue.[147] The drawing will be examined to ascertain the true meaning of the terms used in describing the invention.[148]

§ 53. The importance of describing what is old.

The direction of § 4888, R. S. U. S., to the applicant, to "particularly point out * * * his invention or discovery" finds its reflection in the necessity for pointing out where the invention begins, and on what foundation in the prior art it is built.

"When a man supposes he has made an invention or discovery useful in the arts and, therefore, the proper subject of a patent, it is, nine times out of ten, an improvement on some existing article, process or machine, and is only useful in connection with it. It is necessary, therefore, for him, in his application to the Patent Of-

145. Wheeler, J., in Tinker v. ville Iron Works, 22 Fed. Rep. Wilber Eureka Mower & Reaper Mfg. Co., 1 Fed. Rep. 138, 139; followed in Gunn v. Savage, 30 Fed. Rep. 366, 369.

146. Frazier v. Gates & Sco- 439, 443.

147. Ives v. Sargent, 119 U. S. 652, 30 L. Ed. 544.

148. Steiner & Voegtly Hdw. Co. v. Tabor Sash Co., 178 Fed. Rep. 831, 836.

fice, to describe that upon which he engrafts his invention, as well as the invention itself; and, in cases where the invention is a new combination of old devices, he is bound to describe with particularity all these old devices, and then the new mode of combining them, for which he desires a patent. It thus occurs that, in every application for a patent, the descriptive part is necessarily largely occupied with what is not new, in order to an understanding of what is new."[140]

The description, in the language of Judge Grosscup, must "clearly distinguish the old from the new, so that the novelty claimed is obvious."[150]

The reference to that structure in the prior art to which the improvement relates is judged by the sufficiency of the description, as a guide to those skilled in the art, in practicing the later invention.

The invention may relate to an improvement upon something that has been patented, or something that has never been patented. This does not affect the question of sufficiency of description, except that a reference to the patent, expired or subsisting, upon which the improvement is based, is sufficient to guide the intending user of the improvement with economy of words.

"As to the supposed distinction between an improvement on a machine patented and one not so, there is nothing in it. In both cases the improvement must be described, but with this difference, that in the former case it may be sufficient to refer to the patent and specification for a description of the original machine, and then to state in what the improvements on such original machine consist; whereas in the latter case it would be

149. Mr. Justice Miller, in Merrill v. Yeomans, 94 U. S. 568, 24 L. Ed. 235.

150. Cerealine Mfg. Co. v. Bates, 101 Fed. Rep. 272, 280, 41 C. C. A. 341.

necessary to describe the original machine and also the improvement. The reason for this distinction is too obvious to require explanation." [151]

Again, the sufficiency of the description must be governed by the essential characteristics of the invention. A new machine, performing a new function; a new device or element, which is to be claimed both alone and in a combination of old elements; and a new combination of old elements, all call for individual treatment, according to their needs, and the Supreme Court so holds.

"Inventors of machines are required, before they secure a patent, to deliver a written description of the improvement and of the manner and process of making, constructing and using the same, in such full, clear and exact terms as to enable one skilled in the art or science to make, construct and use the invention. Drawings are also required in certain cases, and if the invention is such that it may be represented by a model, the applicant for a patent is required to furnish a model of the improvement. Requirements of the kind, in cases where they apply, may be regarded as conditions precedent to the right of the commissioner to grant such an application; but cases often arise where they or some of them do not apply.

"An applicant for a patent, 'in case of a machine,' is required to explain the principle thereof, the best mode of applying the same, and to point out and distinctly claim the part, improvement or combination which he claims as his invention; and the respondents contend that the patent of the complainant is invalid because the specification does not comply with that requirement. R. S. U. S., § 4888.

151. Mr. Justice Washington, in Evans v. Eaton, 3 Wash. 443, 1 Robb 193, Fed. Case 4,560.

"Inventions sometimes embrace an entire machine, and in such cases it is sufficient if it appears that the claim is co-extensive with the patented improvement. Other inventions embrace only one or more parts of a machine, and in such cases the part or parts claimed must be specified and pointed out, so that constructors, other inventors, and the public may know what the invention is and what is withdrawn from general use.

"Patented inventions are also made which embrace both a new device or element and a new combination of old devices embodied in the same apparatus or machine. Particular description of the improvement is required in such a case, as the property of the patentee in such a case consists not only in the new device, but also in the new combination.

"Modern inventions very often consist merely of a new combination of old elements or devices, where nothing is or can be claimed except the new combination. Such a combination is sufficiently described, to constitute a compliance with the letter and spirit of the Act of Congress, if the devices of which it is composed are specifically named, their mode of operation given, and the new and useful result to be accomplished is pointed out, so that those skilled in the art and the public may know the extent and nature of the claim and what the parts are which co-operate to do the work claimed for the invention."[152]

§ 54. Description must obviate experimentation in practicing the invention.

Section 4888, R. S. U. S., is keenly explicit in calling for a description in "full, clear, concise, and exact terms," and Mr. Justice Brown has said "the object of

152. Mr. Justice Clifford, in Parks v. Booth, 102 U. S. 96-107, 26 L. Ed. 55, 56.

this is to apprise the public of what the patentee claims as his own, the courts of what they are called upon to construe, and competing manufacturers and dealers of exactly what they are bound to avoid. If the description be so vague and uncertain that no one can tell, except by independent experiments, how to construct the patented device, the patent is void." [153]

This rule applies to patents for processes, machines, manufactures and compositions of matter.

§ 55. Composition of matter.

"Inasmuch as the discovery of a new substance by means of chemical combination is empirical, and results from experiment, the law requires that the description in a patent for such discovery should be specially clear and distinct. 'When the specification of a new composition of matter gives only the names of the substances which are to be mixed together, without stating any relative proportion, undoubtedly it would be the duty of the court to declare the patent void; and the same rule would prevail when it was apparent that the proportions were stated ambiguously or vaguely, for in such cases it would be evident on the face of the specification that no one could use the invention without first ascertaining by ex-

153. The Incandescent Lamp Patent, 159 U. S. 465, 474, 40 L. Ed. 221, 224. To the same effect see Grant v. Raymond, 6 Peters 218, 247, 8 L. Ed. 376, 386; Wood v. Underhill, 46 U. S. (5 Howard) 1, 5, 12 L. Ed. 23, 24; Tyler v. Boston, 74 U. S. (7 Wall.) 327, 19 L. Ed. 93; Bene v. Jeantet, 129 U. S. 683, 32 L. Ed. 803; Howard v. Detroit Stove Works, 150 U. S. 164, 167, 37 L. Ed. 1039, 1040; Schneider v. Lovell, 10 Fed. Rep. 666; Welling v. Crane, 14 Fed. Rep. 571; Lockwood v. Faber, 27 Fed. Rep. 63; Chemical Rubber Co. v. Raymond Rubber Co., 71 Fed. Rep. 179, 18 C. C. A. 31; Badische Anilin & Soda Fabrik v. Kalle, 94 Fed. Rep. 163, 167; DeLamar v. DeLamar Mining Co., 110 Fed. Rep. 538; DeLamar v. DeLamar Mining Co., 117 Fed. Rep. 240, 247, 54 C. C. A. 272; Panzl v. Battle Island Paper Co., 138 F. R. 48, 53, 70 C. C. A. 474.

periment the exact proportion of the different ingredients required to produce the result intended to be obtained. The specification must be in such full, clear, and exact terms as to enable any one skilled in the art to which it appertains to compound and use the invention; that is to say, to compound and use it without any experiments of his own.' An inventor cannot 'speculate on the equivalents of his claimed invention, and thereby oblige the public to resort to experiments in order to determine the scope of the claims of his patent.'" [154]

"It was said by Mr. Chief Justice Taney in Wood v. Underhill, 46 U. S. (5 How.) 1, 5, 12 L. Ed. 23, 24, with respect to a patented compound for the purpose of making brick or tile, which did not give the relative proportions of the different ingredients: 'But when the specification of a new composition of matter gives only the names of the substances which are to be mixed together, without stating any relative proportion, undoubtedly it would be the duty of the court to declare the patent void. And the same rule would prevail where it was apparent that the proportions were stated ambiguously and vaguely. For in such cases it would be evident on the face of the specification, that no one would use the invention without first ascertaining, by experiment, the exact proportion of the different ingredients required to produce the result intended to be obtained. * * * And if, from the nature and character of the ingredients to be used, they are not susceptible of such exact description, the inventor is not entitled to a patent.'

"So, in Tyler v. Boston, 74 U. S. (7 Wall.) 327, 19 L. Ed. 93, wherein the plaintiff professed to have discovered a combination of fusel oil with the mineral and earthy oils, constituting a burning fluid, the patentee stated that

154. Townsend, J., in Panzl v. Battle Island Paper Co., 138 Fed Rep. 49, 53.

the exact quantity of fusel oil which is necessary to produce the most desirable compound must be determined by experiment. And the court observed: 'Where a patent is claimed for such a discovery it should state the component parts of the new manufacture claimed with clearness and precision, and not leave a person attempting to use the discovery to find it out by experiment.' "[155]

§ 56. Process.

"The law does not require that a discoverer or inventor, in order to get a patent for a process, must have succeeded in bringing his art to the highest degree of perfection. It is enough if he describes his method with sufficient clearness and precision to enable those skilled in the matter to understand what the process is, and if he points out some practicable way of putting it into operation."[156]

Where temperatures are employed, they may be given with latitude, as between maximum and minimum stated temperatures, leaving the degree between those temperatures to the operator, where, within those limits, the process may be applied without injury.[157]

As to the recitation of the steps of a process, the decisions are harmonious in requiring a high degree of definiteness.

"The statement of a process upon the part of a patentee, to be sustainable, must not only clearly distinguish the old from the new, so that the novelty claimed is obvious, but must point out the new steps so definitely,

155. Mr. Justice Brown, in The Incandescent Lamp Patent, 159 U. S. 465-474, 40 L. Ed. 221-224.

156. Mr. Chief Justice Waite, in Telephone Cases, 126 U. S. 1, 31 L. Ed. 863.

157. Mowry v. Whitney, 81 U. S. (14 Wall.) 620, 20 L. Ed. 860, 864.

that one wishing to use that process for the production of the desired product, will have a clear chart before his eye. In this essential the Gent process utterly fails. An inspection of the description discloses its progressive steps—hulling and clipping; steaming and moistening; compression through warm rollers—but as we have shown, none of these are new. What degree of steaming or moistening is not made apparent; what should be the warmth of the rolls does not appear. The user would be obliged, with this chart before him, to experiment, just as Gent doubtless experimented, before he obtained a hard, dry flake. The patent would be no guide; it would not even facilitate the production of the hard, dry flake. It leaves the world, as would-be manufacturers, just where it found Gent—with valuable general information on the subject, but with no definite formula. As a process patent, therefore, the Gent claim fails." [158]

§ 57. Manufactures.

In considering the sufficiency of the description of an alleged new article of manufacture, it is important to bear in mind the distinctions which make a new article of manufacture patentable. This subject has been clarified by the following judicial consideration:

"Is the hard, dry flake a new article of manufacture within the meaning of the patent law? New articles of manufacture must not be confounded with a new article of commerce. The latter may be novel and highly useful, even to the displacement in commerce of its predecessors, but is not, on that account, patentable. Powdered sugar succeeded to loaf sugar; ground coffee to coffee in the berry, and as articles of commerce largely supplanted sugar and coffee in their previous forms, but no one

158. Grosscup, J., in Cerealine Mfg. Co. v. Bates, 101 Fed. Rep. 272, 280, 41 C. C. A. 341.

claims that, within the meaning of the patent law, such change, though new and useful, constituted a new article of manufacture.

"Steel, on the other hand, when first made, as the result of the combination of carbon and iron, was an essentially new manufacture. It introduced a practically new metal into the uses of mankind. It differed so essentially from its ingredients in their former state, that the change was not a mere modification, but was a creation. No one would classify steel with iron; it is a distinct species.

"Is this true of the hard, dry flake of the Gent patent? The whole emphasis of appellant's contention is placed upon the fact that, unlike flour, the flake is not laminated, but through the presence of soluble starch and dextrine the granules cohere, and a flake results. The development of dextrine is urged as the efficacious novelty giving to this product its merit. But dextrine is inherent in every cereal containing starch which has been subjected to a certain degree of heating. It is found in breads that have been twice baked in a high degree of heat; it is the well known result of heat applied to soluble starch; it is doubtless present in the wheat and barley flake of previous cereal foods.

"The Gent product may be brighter in color, more desirable in commerce, and more useful, than its predecessors, but is composed of no ingredients previously unknown, and is the result of no essentially new combination of old ingredients; nor is it, so far as we can see, the result of any new mechanical or chemical process. At most, it is an advance only upon the old art in the direction of perfection—a step merely in the mechanical evolution of cereal foods and general flour-making.

"There is no clear line of demarcation between what may be called new articles of commerce, not patentable

though useful, and new articles of manufacture patentable as such. Each instance brought to the attention of the court must be determined more or less upon the situation peculiar to itself. We think it sufficient to say that no result of a machine or process is patentable independently, where it is apparent that such result is a degree only in advance, in the evolution of an art that is as wide as is the manufacture of cereal foods and flour."[159]

The nature of the subject-matter which is patentable as an article of manufacture being thus defined, the description will be weighed by its sufficiency of definition of the article itself, and not of the method of its production. This rule has been thus applied by the Supreme Court: "It is quite immaterial (even if it be a fact) that the Johnson specification is insufficient to teach a manufacturer how to make the patented corset. It is enough if it sufficiently describes the corset itself. Neither it nor the plaintiff's specification exhibits the process of making. Neither of them set up a claim for a process."[160]

The same court has thus amplified the rule: "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."[161]

§ 58. Designs.

The protection of designs by Letters Patent is of very doubtful propriety. The characteristics of a patentable

159. Grosscup, J., in Cerealine Mfg. Co. v. Bates, 101 Fed. Rep. 278, 280, 41 C. C. A. 341.

160. Mr. Justice Strong, in Cohn v. United States Corset Co., 93 U. S. 366, 23 L. Ed. 907.

161. Mr. Justice Blatchford, in Cochrane v. Badische Anilin & Soda Fabrik, 111 U. S. 293, 28 L. Ed. 433.

design always bring it, or should bring it, within the scope of the copyright act. No design can be properly regarded as an invention. If any design could be truthfully characterized as an invention, all drawings, paintings, photographs and sculpture should be equally within the terms of the Patent Act.

The original design Patent Statute reads as follows:

"Section 4929, R. S. U. S.—Any person who, by his own industry, genius, efforts, and expense, has invented and produced any new and original design for a manufacture, bust, statue, alto-relievo, or bas-relief; any new and original design for the printing of woolen, silk, cotton, or other fabrics; any new and original impression, ornament, patent, print, or picture to be printed, painted, cast, or otherwise placed on or worked into any article of manufacture; or any new, useful, and original shape or configuration of any article of manufacture, the same not having been known or used by others before his invention or production thereof, or patented or described in any printed publication, may, upon payment of the fee prescribed, and other due proceedings had the same as in cases of inventions or discoveries, obtain a patent therefor." (Act of July 8, 1870, ch. 230, 16 Stat. at L. 209.)

The present act is as follows:

"Section 4929, R. S. U. S.—Any person who has invented any new, original, and ornamental design for an article of manufacture, not known or used by others in this country before his invention thereof, and not patented or described in any printed publication in this or any foreign country before his invention thereof, or more than two years prior to his application, and not in public use or on sale in this country for more than two years prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law and other due proceedings had, the same

as in cases of inventions or discoveries covered by section forty-eight hundred and eighty-six, obtain a patent therefor."

The British Patents, Designs, and Trademarks Act, 1883, provides for the registration of designs as follows:

Part III, § 47. (1) "The comptroller may, on application by or on behalf of any person claiming to be the proprietor of any new or original design not previously published in the United Kingdom, register the design under this part of this Act."

Section 50. (1) "When a design is registered, the registered proprietor of the design shall, subject to the provisions of this Act, have copyright in the design during five years from the date of registration."

Under the British Act it has been held that the design, to be registrable, "must be new or original with reference to the kind of article for which it is registered, meaning by kind of article not the class of article mentioned in the schedule to the rules, but the kind of article having regard to its general character and use. A design may be new for a coal-scuttle but not for a bonnet. On the other hand, a design for a shade of a gas lamp can hardly be new if it was old for an oil lamp."[162]

The British idea of copyright resultant from registration of the design is far more rational than the present American system, and it is believed that little loss would result from the repeal of the design patent act of the United States, and the leaving of the owners of designs to the provisions of the copyright act for their protection.

162. Lindley, L. J., in Clarke's Design (1896), 2 Ch. 38, 45.

Judge Taft, speaking of design patents, said:

"The whole purpose of Congress, as pointed out by Mr. Justice Strong, speaking for the Supreme Court, in the case of Gorham Co. v. White (14 Wall. 511), was to give encouragement to the decorative arts. It contemplated not so much utility as appearance. 'The law manifestly contemplates that giving certain new and original appearances to a manufactured article may enhance its salable value, may enlarge the demand for it, and be a meritorious service to the public. * * * It is the appearance itself which attracts attention and calls our favor or dislike. It is the appearance itself, therefore, no matter by what agency caused, that constitutes mainly, if not entirely, the contribution to the public which the law deems worthy of recompense.'" [163]

§ 59. The relation of invention to designs.

The statute premises that the design must have been "invented," and thus the quality of invention, of a peculiar kind, is necessary to the validity of the design patent. It has been said that "the statute which protects inventors requires the production of a new and pleasing design. The invention demanded consists in the conception and production of a design which can be so characterized." [164]

"It has been clearly stated that, to entitle an inventor to the benefit of the section in regard to design patents, 'there must be originality, and the exercise of the inventive faculty.' 'Mere mechanical skill is insufficient. There must be something akin to genius—an effort of the brain, as well as the hand.'" [165]

163. Westinghouse Electric & Mfg. Co. v. Triumph Electric Co., 97 Fed. Rep. 99-101, 38 C. C. A. 65.

164. Green, J., in Caldwell v. Powell, 73 Fed. Rep. 488, 19 C. C. A. 592, 77 Off. Gaz. 1272.

165. Shipman, J., in Cary Mfg. Co. v. Neal, 98 Fed. Rep. 617, 618; citing Smith v. Whitman Saddle Co., 148 U. S. 674, 679, 37 L. Ed. 606.

"It seems perfectly fair to argue from these cases that if the industry and efforts expended in the production of a design need not be the personal industry or the personal efforts of the patentee, then the expense alluded to need not be a personal expense of the inventor. It is the conception of a design as the result of inventive genius which characterizes the inventor. The realization of that conception may be brought about by any means which the inventor may fairly control or obtain."[166]

"The invention in a majority of patented designs is very small and of a very low order. All the statute as commonly interpreted requires is the production of a new and pleasing design, which may add value to the object for which it is intended."[167]

"In order to support a patent for a design * * * there must be some invention, and not a mere application to a new material of something already known. The design must be new and original, and not a copy or an imitation. This is required by the clear words of the section, and has been constantly recognized in the judicial decisions under it."[168]

The study of the cases is difficult because so many of the patents issued and adjudicated as design patents have not been for designs at all, but merely for the physical distortion of particular parts of articles of manufacture, such as parallel corrugations upon the surface

166. Green, J., in Matthews & Willard Mfg. Co. v. Trenton Lamp Co., 73 Fed. Rep. 212, 217.

167. Butler, J., in Smith v. Stewart, 55 Fed. Rep. 481, 483.

168. Mr. Justice Gray, in Foster v. Crossin, 44 Fed. Rep. 62; citing Clark v. Bousfield, 10 Wall. 133, 139; Gorham Co. v. White, 14 Wall. 511, 524; Wooster v. Crane, 5 Blatchf. 282. The English statute and cases are similar. Mulloney v. Stevens, 10 L. T. N. S. 190; Lazarus v. Charles, L. R. 16 Eq. 117.

of a rubber mat,[169] or a perforated sheet of veneer applied to the front face of the back of a bow-backed chair.[170] These illustrations might be multiplied indefinitely. This unwarrantable abuse of a statute which itself was enacted through a curious misconception of what constitutes invention, reached its climax in the issuance of a patent for a design for a horse-shoe calk,[171] and a patent for a design for "a washer for thill-couplings,[172] both of which articles had their designs concealed from the human eye the moment they were placed in use. In the case last referred to, the court said "it is another instance of the 'liberal,' if not lax, practice, in issuing design patents. * * * The washer, like the horse-shoe calk, is not intended for display, but for an obscure use. There is no evidence that its form appeals in any way to the eye, or serves to commend it to purchasers and users as a thing of beauty. There is not a scintilla of evidence that the sale of a single washer was ever induced by reason of any attractiveness in its appearance. Functional utility entitled the patentee to the mechanical patent * * *, but mere functional utility did not entitle him to a design patent for the same article."

Judge Archbald has written the following resume of the cases bearing upon the character of invention which the design patent statute is intended to comprehend:

"It was never the intention of Congress, in allowing patents for designs, to duplicate the existing law, so that an inventor, at his option, could cover that which had nothing but a practical value either with a design or a mechanical patent, or, as is now claimed, with both. A

169. New York Belting & Packing Co. v. New Jersey Car Spring Co., 137 U. S. 445, 34 L. Ed. 741.

170. Paine v. Snowden, 50 Fed. Rep. 776.

171. Rowe v. Blodgett, 112 Fed. Rep. 61, 50 C. C. A. 120.

172. Bradley v. Eccles, 126 Fed. Rep. 945, 949, 61 C. C. A. 669.

distinct class of inventions, having characteristics and features of its own, was intended to be reached by the statute, and to this it is to be confined. It is, indeed, a perversion to attempt to extend it to anything else. Weisgerber v. Clowney, 131 Fed. Rep. 477. It has been accordingly expressly decided that a horse-shoe calk, such as we have here, was not patentable as a design (Rowe v. Blodgett, 103 Fed. Rep. 873, 112 Fed. Rep. 61, 50 C. C. A. 120); nor a syringe (Marvel v. Pearl, 114 Fed. Rep. 946); nor plates to hold together the ends of machine belting (Eaton v. Lewis, 115 Fed. Rep. 635); nor a thill-coupling and washer for carriages (Bradley v. Eccles, 126 Fed. Rep. 945, 61 C. C. A. 669). In each of these instances it is manifest that artistic configuration, addressed to the eye, practically counted for nothing, the whole value of the device being found in the uses to which it could be put, to which the mind of the inventor was naturally addressed. To say that the form into which such articles are cast adds to their attractiveness to a purchaser, and thus enhances their salable value, enlarging the demand, merely obscures the issue. It is true that this is recognized in Gorham Co. v. White, 14 Wall. 511, 20 L. Ed. 731, as one of the objects, in providing for design patents; but that it thereby made the law applicable to anything and everything, without regard to its character, or whether it was otherwise within the purview of the statute, by no means follows, Neither is anything to the contrary to be made out of the word 'useful,' to be found in the statute. The utility intended by this is artistic, and not practical, as is implied from the context. The design, with respect to the article of manufacture for which it is devised, must contribute something which is artistically worth the while,

and which is not hurtful or frivolous.[173] This is not to say that that which is covered by a design may not also have useful features (Fiecla Foundry Co. v. Ealker, L. R. 14 App. Cas. 550); but only that, where the article to which it is applied has nothing but that which is useful or functional to commend it, a mechanical, and not a design, patent is the proper one to take out. In the present instance, conceding that there may be artistic lines in the configuration of the complainant's calks, these add nothing to it, and amount to nothing, except as they make for its greater usefulness. In that lies its real value, and it is that which the inventor has contributed to the world, if he has contributed anything. As applied to a horse-shoe calk, which is made for use in ice, snow, and grime, art is wasted, and display so inappropriate as to be frivolous, and so not useful, within the meaning of the law."[174]

§ 60. Novelty as applied to design patents.

This question is one that presents, upon investigation, a curious diversity of opinion, which tends to embarrass any effort to analyze the cases.

Judge Green has said, upon this issue: "To obtain a grant of letters patent for a design, the applicant must show the presence in his design of originality, in some degree at least. In other words, appropriation of the invention of another, though the design may disclose alteration, does not justify, nor is it to be rewarded by, the issuance of letters patent creating a monopoly. Thus

173. Westinghouse Mfg. Co. v. Triumph Electric Co., 97 Fed. Rep. 99, 38 C. C. A. 65; Rowe v. Blodgett, 103 Fed. Rep. 873; Marvel v. Pearl, 114 Fed. Rep. 946. In re Seaman, 4 O. G. 691; Ex parte Norton, 22 O. G. 1205; Ex parte Schulze-Berge, 42 O. G. 293.

174. Williams Calk Co. v. Neverslip Mfg. Co., 136 Fed. Rep. 210, 215; affirmed in Williams Calk Co. v. Kemmerer, 145 Fed. Rep. 929, 76 C. C. A. 466. To the same effect, see, Weisgerber v. Clowney, 131 Fed. Rep. 477.

in Theberath v. Trimming Co., 15 Fed. Rep. 246, in speaking of patents for designs, Judge Nixon in this court said:

'Patents for designs differ from patents for inventions or discoveries in this respect: that they have reference to appearance rather than utility. Their object is to encourage the arts of decoration more than the invention of useful products. A picture or design that merely pleases the eye is a proper subject for such a patent, without regard to the question of utility, which is always an essential ingredient in an invention or discovery patent. But, notwithstanding these differences, all regulations and provisions that are applicable to the obtaining or protecting of patents of the latter kind are by § 4933 of the Revised Statutes, made applicable also to design patents.'

"I think it may be taken as settled that, to sustain a design patent, there must be exhibited in the production of the design an exercise of the inventive or original faculty as clear and of as high degree as is called for in patents for inventions or discoveries. In the latter class there must be novelty and utility; in the former, beauty and originality. In both, the final production must have been engendered by the exercise of brain power, and to such an extent that it may be said to be born of genius. If this be correct, it follows, necessarily, that the adaptation of old devices, or of old forms or designs, though never so beautiful, to new purposes or ornamentations, however exquisite the result, is not invention. It is not begotten of originality. And so it is forbidden for one to choose an existing design, simply to devote it to a new use, and, because of such new use, successfully to claim the benefits of the patent laws." [175]

175. Cahoone Barnett Mfg. Co. v. Rubber & Celluloid Harness Co., 45 Fed. Rep. 582, 585.

Judge Coxe has said "in each case there must be novelty. * * * It is impossible to read the literature upon this subject without being convinced that the courts, though applying the same rules, have looked with greater leniency upon design patents than patents for other inventions. From the nature of things, this must be so. A design patent must relate to subject-matter comparatively trivial. The object of the law is to encourage those who have industry and genius sufficient to originate objects which give pleasure through the sense of sight."[176]

Novelty is negatived by sale or public use more than two years prior to the filing of the application.[177] But a design patent cannot be anticipated by showing that the features of the design are found separately in prior designs, if they are nowhere so combined as to produce the same effect as a whole.[178]

It has been held that the amount of novelty is immaterial, if the design of the patent impresses the eye differently from anything preceding it.[179]

Judge Sage has said that the degree of novelty "may be small, but the effect of the ornament must, to some extent at least be new."[180]

§ 61. Infringement of design patents.

"The test of infringement of a design patent appears to be the existence of such similarities as will lead ordinary persons to think the articles in question are the same."[181]

176. Untermeyer v. Freund, 37 Fed. Rep. 342.

177. Anderson v. Eller, 46 Fed. Rep. 777; Anderson v. Saint, 46 Fed. Rep. 760, 762.

178. Kraus v. Fitzpatrick, 34 Fed. Rep. 39.

179. Redway v. Ohio Stove Co., 38 Fed. Rep. 582; Britton v. White Mfg. Co., 61 Fed. Rep. 93; Braddock Glass Co. v. Macbeth, 64 Fed. Rep. 12., 12 C. C. A. 70.

180. Redway v. Ohio Stove Co., 38 Fed. Rep. 583.

181. Wheeler, J., in Kraus v. Fitzpatrick, 34 Fed. Rep. 39.

"In design patents the test of identity, on questions of anticipation and infringement, is the eye of the observer. And in determining this question the court may avail itself of such common knowledge as is possessed by the general public. The fundamental question is whether the inventive faculty has been exercised to produce anything which is original and pleasing to the eye." [182]

The statutory penalty for the infringement of design patents is fixed as follows:

"That hereafter, during the term of letters patent for a design, it shall be unlawful for any person other than the owner of said letters patent, without the license of such owner, to apply the design secured by such letters patent, or any colorable imitation thereof, to any article of manufacture for the purpose of sale, or to sell or expose for sale any article of manufacture to which such design or colorable imitation shall, without the license of the owner, have been applied, knowing that the same has been so applied. Any person violating the provisions, or either of them, of this section, shall be liable in the amount of two hundred and fifty dollars; and in case the total profit made by him from the manufacture or sale, as aforesaid, of the article or articles to which the design, or colorable imitation thereof, has been applied, exceeds the sum of two hundred and fifty dollars, he shall be further liable for the excess of such profit over and above the sum of two hundred and fifty dollars And the full amount of such liability may be recovered by the owner of the letters patent, to his own use, in any Circuit Court of the United States having

182. Townsend, J., in Bevin Bros. Mfg Co. v. Starr Bros. Bell Co., 114 Fed. Rep. 362. To the same effect, see, Jennings v. Kibbe, 10 Fed. Rep. 669; Ripley v. Elson Glass Co., 49 Fed. Rep. 927; Redway v. Ohio Stove Co., 38 Fed. Rep. 582; Gorham Mfg. Co. v. White, 81 U. S. 511 (14 Wall.) 20 L. Ed. 731; Smith v. Whitman Saddle Co., 148 U. S. 674, 37 L. Ed. 606.

jurisdiction of the parties, either by action at law or upon a bill in equity for an injunction to restrain such infringement.'' (Act of February 4, 1887, ch. 105, 24 Stat. at L. 387, § 1).

This Act has been held constitutional.[183] Although it had been held on circuit that knowledge of the patent was immaterial in a suit for the recovery of the statutory penalty,[184] the Supreme Court has held that the defendant must be proven to have knowledge of the patent.[185]

No damages can be recovered under this section where the plaintiff has failed to mark the articles bearing the design ''patented'' in accordance with § 4900 R. S. U. S.[186]

The penalty of this section is not given in addition to the actual profits.[187] A single order and sale can only be punished by the infliction of one penalty.[188]

§ 62. The claims.

As the claims are the measure of the monopoly created by the patent, they are the most vital part of the specification. The statute[189] prescribes that the applicant ''shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention.''

As elsewhere stated, each claim in reality is a patent

183. Untermeyer v. Freund, 58 Fed. Rep. 205, 7 C. C. A. 183.

184. Pirkl v. Smith, 42 Fed. Rep. 410.

185. Dunlap v. Schofield, 152 U. S. 244, 38 L. Ed. 426.

186. Monroe v. Anderson, 58 Fed. Rep. 398; Lowell Mfg. Co. v. Hogg, 70 Fed. Rep. 787; Dunlap v. Schofield, 152 U. S. 244, 38 L. Ed. 426.

187. Pirkl v. Smith, 42 Fed. Rep. 410.

188. Gimbel v. Hogg, 97 Fed. Rep. 791, 38 C. C. A. 419; reversing Hogg v. Gimbel, 94 Fed. Rep. 518.

189. § 4888, R. S. U. S.

in itself.[100] For this reason, although courts may criticise the multiplication of claims,[101] it is the duty of the solicitor to secure as many claims, non-identical in form, as can be drawn to the invention. For "one void claim * * * does not vitiate the entire patent, if made by mistake or inadvertence and without any wilful default or intent to defraud or mislead the public."[102]

The claim, in the language of Mr. Justice Bradley, "is a statutory requirement for the purpose of making the patentee (applicant) define precisely what his invention is;"[103] and Judge Wallace has added the words "so distinctly and exactly as to apprise other inventors and the public, what is withdrawn from general use."[104] Judge Gilbert has stated the same idea in these words: "The object of a claim in a patent is to publish to the world the precise nature of the invention which the patentee seeks to protect."[105]

The claim may therefore be defined as the inventor's definition of his invention.

Inasmuch, therefore, as the claim defines the metes and bounds of the inventor's accomplishment, its formulation is the most difficult task of the solicitor. In this undertaking he is between the Scylla of narrowness, and the Charybdis of excessive breadth. Under the rule that "that which infringes if later would anticipate if

190. Pope Mfg. Co. v. Gormully & Jeffrey Mfg. Co., 34 Fed. Rep. 893.

191. Westinghouse Air Brake Co. v. New York Air Brake Co., 112 Fed. Rep. 424.

192. Mr. Justice Bradley, in Carlton v. Bokee, 84 U. S. (17 Wall.) 463, 21 L. Ed. 517.

193. White v. Dunbar, 119 U. S. 47, 30 L. Ed. 303.

194. Thomson-Houston Elec. Co. v. Elmira & H. Ry. Co., 71 Fed. Rep. 396, 404, 18 C. C. A. 145.

195. Santa Clara Valley Mill & Lumber Co. v. Prescott, 42 C. C. A. 477, 102 Fed. Rep. 501, 505.

earlier," the broad claim which the inventor desires as a trap for the infringer has often proved its own destroyer, by being met in the prior art.

The number of claims contained in a patent depends upon many things, the merit of the invention (though the least meritorious frequently present a bewildering labyrinth of claims), the complexity or simplicity of the invention, the taste and skill of the solicitor, and the strictness or laxity of the examination in the Patent Office.

Each claim must speak for itself, when read in the light of the description and drawings; for "each claim of the patent standing by itself, is a separate patent for the device covered by the claim."[196]

The following discussion of the nature of combination claims is worth presentation in full:

"A combination is a union of elements, which may be partly old and partly new, or wholly old or wholly new. But, whether new or old, the combination is a means—an invention—distinct from them. They, if new, may be inventions and the proper subjects of patents, or they may be covered by claims in the same patent with the combination.

"But whether put in the same patent with the combination or made the subjects of separate patents, they are not identical with the combination. To become that they must be united under the same co-operative law. Certainly, one element is not the combination, nor, in any

196. Blodgett, J., in Pope Mfg. Co. v. Gormully & Jeffrey Mfg. Co., 34 Fed. Rep. 893. To the same effect, see, United Nickel Co. v. California Elec. Works, 25 Fed. Rep. 475, 479; Celluloid Mfg. Co. v. Zylonite Brush & Comb Co., 27 Fed. Rep. 291, 294, 35 Off. Gaz. 1223.

proper sense, can it be regarded as a substantive part of the invention represented by the combination, and it can make no difference whether the element was always free or becomes free by the expiration of a prior patent, foreign or domestic. In making a combination, an inventor has the whole field of mechanics to draw from."[197]

§ 63. Elements.

In a combination claim, as a matter of law every element is conclusively presumed to be old, whether or not it is old in fact. As Mr. Justice Brown has said "the failure to claim either one of the elements separately raises a presumption that no one of them is novel."[198]

§ 64. "Element" defined.

The term "Element" applies to the one or more integers comprised in a claim. It indicates each of the two or more factors selected by the inventor and embodied in one claim as comprising a combination. It does not follow that it must be expressly enumerated in the claim. "If the patentee specifies any element as entering into the combination, either directly by the language of the claim, or by such a reference to the descriptive part of the specification as carries such element into the claim, he makes such element material to the combination."[199]

It is the rule of the Patent Office to deny patentability where the applicant has merely improved one element of an old combination.[200]

197. Mr. Justice McKenna, in Leeds & Catlin Co. v. Victor Talking Machine Co., 213 U. S. 301, 318, 53 L. Ed. 805, 813.

198. Richards v. Chase Elevator Co., 159 U. S. 477, 486, 40 L. Ed. 225, 228.

199. Mr. Justice Blatchford, in Fay v. Cordesman, 109 U. S. 408, 420, 27 L. Ed. 979, 981.

200. In re McNeill, 20 App. D. C. 294, 100 Off. Gaz. 2178; In re Ratican, 162 Off. Gaz. 540.

An illustrative case is one in which a mathematical formula, not referred to in the claim, was read into it to give it validity, and hold an infringer.[201]

On the other hand, when the position of a patent in its art is strong, even the express introduction of an element to its claim by a reference letter or figure does not limit that element to the specific form shown in the drawing. "A reference in a claim to a letter or figure used in the drawing and in the specification to describe a device or an element of a combination does not limit the claim to the specific form of that element there shown unless that particular form was essential, or embodied the principle of, the improvement claimed."[202]

At times the courts have, in the case of reference letters or numerals which apparently imported a distinct element into the claim, disregarded such element altogether. Illustrative cases are those involving this combination:

"The combination, in a candy-machine, of a rotative, perforated vessel, A, A′, A″, C, C′, and a heating attachment, or burner, m, substantially as shown and for the purpose set forth."

Of this claim, one court has said, "The patent has been adjudged in another jurisdiction to be a pioneer patent, and the testimony of the complainant's expert points in the same direction. There is consequently no apparent

201. Westinghouse Electric & Mfg. Co. v. Saranac Lake Elec. Light Co., 113 Fed. Rep. 884, 887, 51 C. C. A. 514.

202. Sanborn, J., in National Hollow Brake-Beam Co. v. Interchangeable Brake-Beam Co., 106 Fed. Rep. 693, 715, 45 C. C. A. 544; citing, Reed v. Chase, 25 Fed. Rep. 94, 100; Delemater v. Heath, 58 Fed. Rep. 414, 424, 7 C. C. A. 279, 284; Muller v. Tool Co., 77 Fed. Rep. 621, 23 C. C. A. 357; McCormick Harvesting Mach. Co. v. Aultman, Miller & Co., 69 Fed. Rep. 371, 393, 16 C. C. A. 259, 281; Bonnette Arc Lawn Sprinkler Co. v. Koehler, 82 Fed. Rep. 428, 431, 27 C. C. A. 200, 203.

reason why any restrictive force should be given to the letters of reference. There is no reason why the letter A'' should be held to constitute an element or an essential part of an element of the claim in suit. Any argument in that direction would make each of the other lettered parts also distinctive and essential elements incapable of the slightest variation. As already indicated, the letters of reference simply point out the 'rotative vessel,' and do not restrict the claim to the particular form of construction shown in the drawings.''[203]

§ 65. The oath.

The oath accompanying an original application has been held to be "but a prerequisite to the granting of the patent, and in no degree essential to its validity."[204] And it has been held that the existence of the oath will not be inquired into collaterally in an infringement suit.[205] The Supreme Court has held that the recital in letters patent that the required oath was taken before the patent was granted is, in the absence of fraud, conclusive that the oath was so taken.[206]

Section 558 of the Code of Law of the District of Columbia provides in part: "No notary public shall be authorized to take acknowledgments, administer oaths, certify papers, or perform any official acts in connection with matters in which he is employed as counsel, attorney, or agent or in which he may be in any way interested before any of the departments aforesaid."

203. Cross, J., in Electric Candy Mach. Co. v. Empire Cream Separator Co., 161 Fed. Rep. 552, 556; the former adjudication referred to being Electric Candy Mach. Co. v. Morris, 156 Fed. Rep. 972.

204. Story, J., in Whittemore v. Cutter, 1 Robb. 28, Fed. Case 17. 600.

205. Holmes Burglar Alarm Telegraph Co. v. Domestic Tel. and Tel. Co., 42 Fed. Rep. 220.

206. Seymour v. Osborne, 78 U. S. (11 Wall) 516, 20 L. Ed. 33.

Of this section the Court of Appeals of the District of Columbia has said: "It clearly appears from the record that A. F. Herbsleb was the attorney for the appellant for the preparation and prosecution of the opposition, and that as a notary public in and for Hamilton County, Ohio, where the appellant resided, he certified to the oath made by its treasurer, Hall. We agree with the commissioner that the proviso of section 558 is not confined in its application to notaries public of the District of Columbia. Its language is that "no notary" shall be authorized to take acknowledgments, administer oaths, certify papers, or perform any official acts in connection with matters in which he is employed as counsel, attorney, or agent, or in which he may be in any way interested before any of the departments of the United States Government."[207]

Accordingly it has been held that if the oath is executed before an officer who is also an attorney for the applicant, the oath is void, a new oath will be required, and if all the other essential parts of the application are on file, the application will be dated as of the date when the new oath is received in the Patent Office.[208]

The statute imperatively requires that no one but the inventor can make the oath in his life-time, or his executor or administrator after his death. A patent issued upon a false oath of inventorship is void, and a bill to compel its assignment will be dismissed upon that ground.[209]

§ 66. Supplemental oaths.

The nature of the supplemental oath, and its requisites are defined by Rule 48 of the Patent Office as follows:

207. Hall's Safe Co. v. Herring-Hall-Marvin Safe Co., 31 App. D. C. 498, 135 Off. Gaz., 1804.

208. Riegger v. Beierl, 150 Off. Gaz. 826.

209. Kennedy v. Hazleton, 128 U. S. 667, 672, 32 L. Ed. 576.

"When an applicant presents a claim for matter originally shown or described but not substantially embraced in the statement of invention or claim originally presented, he will file a supplemental oath to the effect that the subject-matter of the proposed amendment was part of his invention, was invented before he filed his original application, was not known or used before his invention, was not patented or described in a printed publication in any country more than two years before his application, was not patented to himself or to others with his knowledge or consent in this or any foreign country on an application filed more than twelve months prior to his application, was not in public use or on sale in this country for more than two years before the date of his application, and has not been abandoned. Such supplemental oath must be attached to and properly identify the proposed amendment."

This requirement applies to divisional applications.[210] It is employed in the introduction of process claims, where the process was described, but not claimed, in the application as filed.[211] The question of requiring a supplemental oath from one of the parties to an interference is *ex parte* and not subject to argument by the opposing party.[212] The supplemental oath is not of itself conclusive evidence that the matter to which it relates was a part of the original invention, and that fact should be determined by an examination of the specification and drawing as originally filed.[213] It is not the function of the supplemental oath to introduce any new matter not substantially described or disclosed originally.[214]

210. Forbes v. Thomson, 53 Off. Gaz. 2042.

211. Ex parte Perkins, 55 Off. Gaz. 139.

212. Rennyson v. Merritt, 58 Off. Gaz. 1415.

213. Ex parte Regan, 45 Off. Gaz. 589.

214. Steward v. Ellis v. Lee v. Howe, 49 Off. Gaz. 1983; Ex parte Lillie, 53 Off. Gaz. 2041.

§ 67. New oaths.

Where the date of the oath is more than thirty days prior to the date of the filing of the application, a new oath is usually required.[215] When a new oath is required it must be made by the inventor if he is alive, and an oath or affirmation by his assignee will not suffice.[216] The object in requiring an oath of a date recent to the filing date of the application relates to the contents of the oath with reference to prior public use or sale; the action of the primary examiner in requiring a new oath may be reviewed by the Commissioner upon petition.[217]

§ 68. Patentable subject-matter.

In section 4886 of the Revised Statutes of the United States, the benefits of the patent statutes are extended to any new and useful

1. Art (see *ante*, § 31).
2. Machine (see *ante*, § 32).
3. Manufacture (see *ante*, § 33).
4. Composition of Matter (see *ante*, § 34).

All subject-matter not included in the enumeration named is excluded from the benefits of the Patent Act.

§ 69. Patent Office classification.

It is provided by rule 63 of the Patent Office that applications are classified "according to the various arts." As to the application of this rule, Hall, Commissioner, said: "The classification in the Patent Office is not founded upon names and titles, but upon the actual subjects of art. The nomenclature given to the classes constitutes but the guide by which the separate subjects may be found in their appropriate places in the reposi-

215. Ex parte Wilson, 63 Off. Gaz. 465.

216. Ex parte Stevens, 59 Off. Gaz. 299; Ex parte McCoy, 80 Off. Gaz. 2037.

217. Ex parte Hoschke, 122 Off. Gaz. 1045.

tories of human knowledge and experience. When found, each subject must disclose and define itself, its structure, use, and function. Classification is the great *Aula Regis* which contains the state of art; and every new invention, like a newly arrived alien, must come before this august assembly of classification and submit to the test of naturalization by a sort of comparative anatomy —by a comparison of construction, function, and utility with all the subjects before it. Classification determines what is or is not a machine, a tool, or implement; whether it is generally new and original, or is composite, made of two recognized old machines, tools, or implements, or whether it presents mere additions to or improvements upon what already exists and is known. When, therefore, the applicant asserts that his invention is a 'machine,' he at once brings himself within the province of the statute, which expressly specifies a machine as one of the subjects of invention, and an applicant is entitled to demand protection by a single patent for everything which constitutes his new machine."[218] The fact that the various claims of an application cover specific devices which are separately classified in the Patent Office, is ground for requiring division of the application.[219] Whatever its classification, or whether it embraces more than one invention, the application must sufficiently describe its invention or inventions to obviate experimentation in practice, whether it relates to a machine,[220] a process,[221] a manufacture,[222] or a composition of matter.[223]

218. Ex parte Willcox & Borton, 45 Off. Gaz. 455, 457.

219. Ex parte Ramsey, 146 Off. Gaz. 721.

220. Parks v. Booth, 102 U. S. 96, 101, 26 L. Ed. 54.

221. Western Elec. Mfg. Co. v. Ansonia Brass & Copper Co., 114 U. S. 447, 452, 29 L. Ed. 210.

222. Tyler v. Boston, 74 U. S. (7 Wall.) 327, 19 L. Ed. 93.

223. Wood v. Underhill, 46 U. S. (5 How.) 1, 5, 12 L. Ed. 23, 24

PATENT OFFICE PROCEDURE UNDER THE APPLICATION.

§ 70. Filing.

Having thus considered the various subject-matter upon which patent applications may be predicated, the essential steps toward the obtaining of the patent may be considered in their order. The date of filing in the Patent Office fixes the time from which the statutory two years' public use and sale are to be reckoned; the date of the execution of the application by the inventor is immaterial.[224] The filing fee of $15 must accompany the application; if the application is filed before the payment of the filing fee, the date of the application is that of the payment of the fee. When any material part of the application is missing or defective, no filing date is assigned until the application is completely filed as to all of its parts.[225]

Accordingly, when the nature of the case requires a drawing, the application is not "filed" until the drawing is filed.[226] Where the drawing, filing fee, and an unsigned specification are filed, no filing date will be given until a properly executed specification is supplied.[227] But in a process application, where the specification sufficiently discloses the process to admit of examination on the merits, the filing is complete when the specification and filing fee are received by the Patent Office, even though a drawing is subsequently required to show a means for practicing the process.[228]

224. Henry v. Francestown Soap Stone Co., 2 Fed. Rep. 78, 81; Graham v. McCormick, 11 Fed. Rep., 859, 862.

225. Ex parte Russell, 84 Off. Gaz. 2021.

226. Palmer v. Bailey, 83 Off. Gaz. 1207.

227. Ex parte Hallberg, 83 Off. Gaz. 1208.

228. Ex parte Russell, 84 Off. Gaz. 2021.

Where a specification is informal for other reasons than want of signature, such as the omission of the place of residence of the applicant, filing is not accomplished until such defects are cured.[229]

Until the application is filed complete in all its parts, and the filing fee has been paid, it will neither be subjected to examination or placed in interference.[230] When the filing has been properly accomplished, a formal receipt is issued by the Patent Office, reciting the filing date, the serial number assigned to the application, and the short title of the alleged invention which is the subject of the application; and by that date, serial number, short title and the name of the applicant, the application is referred to in all further proceedings in the Patent Office, unless and until a patent is issued, when a number is assigned to the patent.

§ 71. Effect of filing.

The immediate effect of the filing of the application is to submit it to the examination and action of the Patent Office. The effect of the filing as a constructive reduction to practice we have elsewhere examined. The pending application is kept secret.[231] The application once filed cannot be withdrawn for any purpose.[232]

Being filed, the application is assigned to the division of the Patent Office in which it may most appropriately be examined. The determination as to where it shall be assigned is usually, but not invariably, determined by the short title of the application. By this means the solicitor is enabled at times to divert to the division which he prefers an application which might properly

229. Ex parte Brand, 82 Off. Gaz. 893.

230. Palmer v. Bailey, 83 Off. Gaz. 1207.

231. Ex parte Neale, 15 Off. Gaz. 511.

232. Ex parte Van Etten, 80 Off. Gaz. 1760.

be dealt with in either of several divisions. But the original assignment of the application for examination is not final, as the division first receiving it may determine that it properly belongs in another division; and being transferred to such second destination it may again be transferred. Thus, a mechanism in which a new hinge or a new valve is an element of novelty, may find proper lodgment in any one of several divisions, and its division is determined not only by the short title of the application but measurably by the drawing, and largely by the description, and to a degree by the language of the claims. This question is necessarily one which involves not only the skill of the specification writer, but that knowledge of the personnel of the Patent Office which can come only by actual experience, and a resultant personal knowledge of that complex bureau.

This subject is on the psychological side of the law of patents, and for that reason has been avoided in the past by text-w iters. But it is of vital importance in actual practice. Not only individuals, but groups of men, even scientifically educated men, have strong mental bias. In the examining corps of the Patent Office, as on the Federal bench, there are men of good education and high attainments, who cannot recognize invention. The history of the patent law of the United States may some time be written which will review the records of our Federal judges in tabulation of their attitudes towards patents. If and when such a history is compiled, there will be found judges who have extinguished patent litigation in the districts in which they sat by their uniform hostility to all patents.

From the best figures obtainable there is at least one Federal Judicial Circuit in which the Court of Appeals has for years reversed over sixty per cent of all patent cases in which the Circuit Court decreed relief for the

patent owner. These reversals may not indicate hostility to patent interests, but the figures certainly justify very definite advice to intending litigants.

This reasoning extends to the Patent Office, as every experienced practitioner is aware. Hence the importance of the solicitor entrusted with an important invention knowing in advance of preparing the application, if possible, in which division it is to be examned.

These suggestions may serve their purpose if they put some young solicitor or lawyer upon inquiry before filing an application or suit. They are not intended to reflect upon the integrity of those gentlemen who, in the Patent Office or on the Federal bench, are inclined against claims to invention. When no one can define invention, it is no aspersion on any one's integrity that he cannot see invention in anything. It may, indeed, indicate a superior judicial mind, to find that in a career of a score of years, a certain judge has found, in every patent cause tried before him, either that the patent in suit was anticipated, void for want of invention, or not infringed. But, none the less, it would be the duty of the lawyer knowing of such a record, to warn the owner of an infringed patent contemplating suit in the district in which that judge sits, to try to have his rights under the patent adjudicated elsewhere.

The short title above referred to must satisfy the requirements of § 4884, R. S. U. S., and whether it does so is for the Patent Office to determine.[233] With this restriction, the applicant is allowed to select such title as he wishes.[234]

§ 72. Examination.

The position of the examiner is judicial. He is not to pass on the merits until defects of form has been cor-

233. Ex parte Nickola, 57 Off. Gaz. 1425.

234. Ex parte Becker, 64 Off. Gaz. 559.

rected,[235] and as to such defects it is his duty to point them out to the applicant specifically, and indicate how they may be remedied.[236]

Formal defects being eliminated, the examination on the merits is made, and while it has been held that it is the duty of the examiner to aid the applicant in securing adequate claims,[237] it is his primary duty to see that nothing is patented which is already open to the public, or patented to others.

If he finds the claims as presented to be patentable, the application will be allowed if no corrections as to form are needed. Very few applications result in allowance on the first Patent Office action, however, and when such allowance is made, it is almost invariably looked upon with suspicion, as indicating negligence on the part of the examiner.[238]

§ 73. Rejection.

If the examiner finds that either or all of the claims presented are, in his judgment, unpatentable, he will reject the objectionable claims in such terms as to advise the applicant fully and specifically of the grounds of rejection. If the rejection is upon the ground of want of novelty the examiner should cite the patents or other publications upon which his rejection is based,[239] or if he cannot cite a reference should support his denial of the applicant's priority by an affidavit.[240] His rejection

235. Ex parte Sillman, 34 Off. Gaz. 1389; Ex parte Mill, 40 Off. 918.

236. Ex parte Wilkins, 24 Off. Gaz. 1270.

237. Ex parte Donovan, 44 Off. Gaz. 698.

238. American Soda Fountain Co. v. Sample, 130 Fed. Rep. 145, 64 C. C. A. 497.

239. Ex parte Fairbanks, 3 Off. Gaz. 65.

240. Ex parte Hill, 16 Off. Gaz. 765.

cannot, however, be based upon an abandoned,[241] or a rejected[242] application. He should cite none but pertinent references,[243] and should cite the best references first.[244]

In his citation of references he may cite a drawing unaccompanied by descriptive matter,[245] and identity of material, form, shape or use is not required to make the reference pertinent,[246] and it has been held that the device of the reference may be valueless.[247]

In his action the Examiner will not interfere with the applicant's use of terms of reference, provided that their use does not produce ambiguity, uncertainty or confusion.[248]

Upon examination, the examiner may determine that certain sheets, or other parts, of the drawings are superfluous, and may direct them to be cancelled.[249]

§ 74. Amendment of application.

In response to an action the applicant must amend within one year (formerly, two years). The applicant may resubmit the rejected claims without amendment, and if a second rejection results, his remedy is by appeal to the Board of Examiners-in-Chief.[250] In a re-

241. Ex parte Borden, 26 Off. Gaz. 439; Webster v. Sanford, 44 Off. Gaz. 567; Corn Planter Patent, 90 U. S. (23 Wall.) 181, 23 L. Ed. 161.

242. Northwestern Fire Extinguisher Co. v. Philadelphia Fire Extinguisher Co., Fed. Case 10, 337; Webster v. Sanford, 44 Off. Gaz. 567; Blades v. Rand, McNally & Co., 27 Fed. Rep. 93.

243. Ex parte Brownlie, 3 Off. Gaz. 212.

244. Ex parte Sanders, 13 Off. Gaz. 818.

245. Ex parte Borden, 26 Off. Gaz. 439.

246. Ex parte Chatillon, 2 Off. Gaz. 115.

247. Sargent v. Burge, 11 Off. Gaz. 1055.

248. Ex parte Averell, 56 MS. Dec. 442; Ex parte Hollis, 86 Off. Gaz. 489.

249. Ex parte Krause, 56 Off. Gaz. 1708; Ex parte Griffin, 85 Off. Gaz. 454.

250. Ex parte Edward, 9 Off. Gaz. 794.

quest for reconsideration, it is the duty of the applicant to distinctly and specifically point out the alleged errors in the examiner's action.[251]

Discourteous language in an argument filed in the prosecution of an application will render the document containing it subject to be refused admission to the files, and to be returned to the applicant,[252] and, of course, the examiner is under a reciprocal duty of courtesy to applicants and their attorneys.[253]

The right of amendment seems to depend upon the phraseology of § 4888, R. S. U. S., which reads: "*Before* any inventor or discoverer shall receive a patent for his invention or discovery," etc. The disclosure and claim demanded by this section relate to the perfected application, with the alterations and amendments in which the Patent Office and the applicant have jointly assisted to contribute to compliance with the statute. "Requirements of the kind," Mr. Justice Clifford has said, "may be regarded as conditions precedent to the right of the Commissioner to grant such an application."[254]

The object of amending, therefore, is to fully supply these conditions; but the inherent nature of the application for patent is such that the range which amendment can properly take is limited, and has been often treated judicially.

The rule of the earlier cases appears to be accurately given by Judge Blatchford, thus: "The specification is always open to amendment of its description and claims, and to the addition of new matters of description and new claims, where the drawings and model exhibit the

251. Ex parte Appel, 84 Off. Gaz. 1145.

252. Ex parte McQueen, 85 Off. Gaz. 609.

253. Ex parte Horstick, 84 Off. Gaz. 981.

254. Parks v. Booth, 102 U. S. 96, 26 L. Ed. 54.

matters involved in the amendments and additions; and this privilege continues until the matter of the application is finally disposed of, by the granting of a patent, or otherwise."[255]

Under this doctrine the latitude of amendments was anywhere up to the limit of the disclosure of the drawings and model. That latitude has been greatly contracted by judicial rulings, as will be seen from the later cases to which we will refer.

In alluding to these cases it is well to note at the beginning that "the grant of the patent is prima facie evidence that the necessary conditions precedent were complied with."[256] Therefore the presumption is in favor of the patent as issued being sustained by the application as filed.

The modern doctrine has been thus announced by Mr. Justice Bradley in the leading case.

"It will be observed that we have given particular attention to the original application, drawings and models filed in the Patent Office by Thompson and Bachelder. We have deemed it proper to do this, because, if the amended application and model, filed by Tanner five years later, embodied any material addition to or variance from the original—anything new that was not comprised in that—such addition or variance cannot be sustained on the original application. The law does not permit such enlargements of an original specification, which would interfere with other inventors who have entered the field meantime, any more than it does in the case of reissues of patents previously granted. Courts

255. Singer v. Braunsdorf, 7 Blatchf. 521, Fed. Case 12,897.

256. Coxe, J., in Beach v. American Box Machine Co., 63 Fed. Rep. 597, 604; citing Crompton v. Belknap Mills, 3 Fisher 536, Fed. Case 3 406; Whittemore v. Cutter, 1 Gall. 429, Fed. Case 17, 600; Hartshorn v. Eagle Shade Roller Co., 18 Fed. Rep. 90.

should regard with jealousy and disfavor any attempts 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 alteration, or to appropriate that which has, in the meantime, gone into general use."[257]

There is no doubt that this excerpt exactly states the rule; the chief difficulty in its application is as to the facts in the particular case.[258]

There is another rule which adds to the difficulty of applying, or even understanding, the rule thus stated. It is based upon the Patent Office practice of permitting new matter to be introduced in the description (without change in the drawings), by amendment, subject, merely to requiring of the applicant a new oath. In recognizing this rule Judge Coxe has said, "A new oath was not necessary because the amendments introduced no new invention."[259]

It has even been held permissible to amend the drawing by adding to it the essential feature of the invention, where the amendment could be made in the light of the description, and the material has been omitted by accident.[260]

But the troublesome and principal thought inspired by the cases is that they apparently recognize the doctrine of the leading case, by frequent references to that case, and still insist that a new oath is all that is necessary

257. Chicago & N. W. R. Co. v. Sayles, 97 U. S. 554, 24 L. Ed. 1053. For application of the rule see Eagleton Mfg. Co. v. West, Bradley & Cary Mfg. Co., 111 U. S. 490, 28 L. Ed. 493.

258. Beach v. American Box Machine Co., 63 Fed. Rep. 597, 604.

259. Beach v. American Box Machine Co., 63 Fed. Rep. 597, 604. See, to the same effect, American Lava Co. v. Steward, 155 Fed. Rep. 731, 84 C. C. A. 157.

260. Consolidated Brake Shoe Co. v. Detroit Steel & Spring Co., 59 Fed. Rep. 902.

to validate a departure from the original application. We will briefly refer to a few of the cases which display this peculiar feature.

In a late case Judge Severens said: "If the application as amended were to be construed as embodying such an invention as is now claimed, it was another and different from that for which the patent was originally sought, and, if an amendment having that consequence was permissible, it should have been verified by the oath of the inventor."[261]

It will be observed that the learned judge is very cautious in this announcement, because he merely says that an amendment should receive a new oath when embodying and presenting another and different invention from that for which the patent was originally sought, *if* an amendment of that kind is permissible at all. Therefore, he does not bind himself to the doctrine that a case may be so varied by amendment as to present another invention. But immediately following the portion of his opinion just quoted we find this: "The case of Eagleton Mfg. Co. v. West, etc., Mfg. Co., supra (111 U. S. 490, 28 L. Ed. 493) was strikingly like the case at bar in all material facts which were made the basis of decision. Eagleton, the patentee, died soon after making his application. It was prosecuted by his administrators, by their attorneys. The amendment was made by them, but was not sworn to. The invention and application were assigned by the administrators to the Eagleton

261. American Lava Co. v. Steward, 155 Fed. Rep. 731, 737, 84 C. C. A. 157; citing, Chicago & N. W. R. Co. v. Sayles, 97 U. S. 554, 24 L. Ed. 1053; Eagleton Mfg. Co. v. West, Bradley & Carey Mfg. Co., 111 U. S. 490, 28 L. Ed. 493; Kennedy v. Hazelton, 128 U. S. 667, 32 L. Ed. 576; Michigan Central R. Co. v. Consolidated Car Heating Co., 67 Fed. Rep. 121, 14 C. C. A. 232; Cleveland Foundry Co. v. Detroit Vapor Stove Co., 131 Fed. Rep. 853, 68 C. C. A. 233.

Company and the patent issued to it. In the present case Dolan sixteen days after making his application assigned his entire interest to one Napheys, and it went through two more assignments before the amendment was filed. It is true that in the Eagleton case the application had been a long time pending when the amendment was made, but that fact was not made the basis of the decision."[262]

This paragraph is quoted because it seems to represent a misunderstanding of what was decided in the Eagleton case. The central idea of that case appears to us to have been that where, by amendment, any invention is sought to be patented which was not sought to be patented in the application as originally filed, such an amendment is in violation of the patent law, and the resulting patent is void. In the Eagleton case Mr. Justice Blatchford said: "In view of the entire change in the specification, as to the invention described, the patent, to be valid, should have been granted on *an application* made and sworn to be the administratrix."[263] There is no suggestion that the mere affidavit of the administratrix could have made the amendment good.

The Dolan patent, which was the subject-matter of American Lava Co. v. Steward, 155 Fed. Rep. 731, 84 C. C. A. 157, was previously sustained in a decision of the Circuit Court of Appeals of the Second Circuit, as against the same defense of departure, by amendment, from the application as originally filed. The latter court based its decision upon the following grounds: "The original drawings and specifications sufficiently show and suggest the claims finally made, or at least are not

262. American Lava Co. v. Steward, 155 Fed. Rep. 731, 737, 84 C. C. A. 157.

263. Eagleton Mfg. Co. v. West, Bradley & Cary Mfg. Co., 111 U. S. 490. 498, 28 L. Ed. 493, 496.

inconsistent therewith.[264] Subject to the foregoing rules, an inventor may amend his specification so as to include therein all the advantages within the scope of his invention.[265]

"It was unnecessary, in the original application, where only the tip was sought to be patented, to set forth the steps in the process by which the desired result was accomplished. But when the applicant sought to cover both process and product, he explains that the process by which he secures perfect combustion consists in first surrounding the gas with an envelope of air sufficient to cause complete combustion, and in subsequently supplying such additional air as is sufficient for that purpose. The original specification and drawings disclose the envelope construction of air-passages surrounding the jet of gas. In these circumstances, we conclude that there is no substantial conflict between the statements in the original and amended specifications; that the original specification sufficiently disclosed the nature of the invention claimed in the patent, and sufficiently suggested the process involved therein; and that, as the invention or discovery of the process involved the invention of the product, and the product was the result of the process, the claims for the process were properly included in the patent in suit."[266]

To summarize; the fact that the Patent Office has required the applicant to furnish a new oath in support of an amendment containing a departure from the invention sought to be patented by the application as originally filed, seems to indicate that it is possible to

264. Citing Hobbs v. Beach, 180 U. S. 383, 45 L. Ed. 586.

265. Citing Singer Mfg. Co. v. Cramer, 109 Fed. Rep. 652, 48 C. C. A. 588.

266. Townsend, J., in Kirchberger v. American Acetylene Burner Co., 128 Fed. Rep. 599, 606, 64 C. C. A. 107; citing, Giant Powder Co. v. California Works, 98 U. S. 126, 25 L. Ed. 77; Wing v. Anthony, 106 U. S. 142, 27 L. Ed. 110.

defend upon the ground that the departure invalidated the patent. The degree of permissible enlargement of, or departure from, the originally filed specification is not determined by any existing rule, and the applicant makes such enlargement or departure at his peril.

§ 75. Delay in amending.

Section 4894, R. S. U. S., provides as follows:

"All applications for patent shall be completed and prepared for examination within one year after the filing of the application, and in default thereof, or upon failure of the applicant to prosecute the same within one year after any action therein, of which notice shall have been given to the applicant, they shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner of Patents that such delay was unavoidable."

One year is thus provided for the filing of amendments in response to the actions of the Patent Office. The time was reduced from two years to one year by the Act of March 3, 1897, ch. 391, sec. 4, 29 Stat. at L. 629.

Under the statute as it existed prior to its amendment Judge Brawley said: "The inventor does not determine the measure of his rights or of his obligations. The law determines that for him, and, if the government thinks that more speed is desirable in the interest of the public, it should change the law; the courts cannot do so. Nor can they exact of inventors any degree of diligence other than compliance with the statutory provisions, official regulations, departmental requirements, and formal demands which are prescribed by and for the officials and others charged with duties under the patent laws. Certain fixed periods are provided in sections 4894 and 4904, R. S. U. S., for securing progress in applications for patents. If the inventor is allowed two years after

a judgment against him within which to take appeal, he may wait until the last day of the two years. If Congress thinks this is too long a time, it should fix another limitation, but courts cannot deny the benefits which the statute gives."[267]

§ 76. Divisional applications.

The present rule of the Patent Office governing the division of applications is as follows:

"If several inventions, claimed in a single application, be of such a nature that a single patent may not be issued to cover them, the inventor will be required to limit the description, drawing, and claim of the pending application to whichever invention he may elect. The other inventions may be made the subjects of separate applications, which must conform to the rules applicable to original applications. If the independence of the inventions be clear, such limitation will be made before any action upon the merits; otherwise it may be made at any time before final action thereon, in the discretion of the Examiner." (Rule 42.)

The rule formerly provided as follows:

"Claims for a machine and its product must be presented in separate applications.

"Claims for a machine and the process in the performance of which the machine is used must be presented in separate applications.

"Claims for a process and its product may be presented in the same application."

This rule was held to be invalid, Mr. Justice McKenna observing: "The Patent Office has not been consistent in its views in regard to the division of inventions. At

267. Crown Cork & Seal Co. v. Aluminum Stopper Co., 108 Fed. Rep. 845, 851, 48 C. C. A. 72. To the same effect, see, American Bell Tel. Co. v. United States, 68 Fed. Rep. 542, 15 C. C. A. 569.

times convenience of administration has seemed to be of greatest concern; at other times more anxiety has been shown for the rights of the inventors. The policy of the office has been denominated that of 'battledore and shuttlecock,' and rule 41 as it now exists was enacted to give simplicity and uniformity to the practice of the office. Its enactment was attempted to be justified by the assumption that the patent laws gave to the office a discretion to permit or deny a joinder of inventions. But, as we have already said, to establish a rule applicable to all cases is not to exercise discretion. Such a rule ignores the differences which invoke discretion, and which can alone justify its exercise, and we are of opinion therefore that rule 41 is an invalid regulation."[268]

The question of enforcing the division of applications is without any statutory authority. The rule is well settled that one cannot divide an integral invention, or have two patents for the same thing.[269]

So far as the reports disclose no United States patent has ever been held invalid as embracing more than one invention. While it is manifestly improper to include two separate and distinct inventions, which have no co-relation, in a single patent, wherever co-relation exists, and the two inventions have such inherent capacity for mutual or common employment as to constitute, for example, a single operative machine, there is no danger of invalidity, resulting from the rule which we have elsewhere discussed, that in letters patent each claim is a patent of itself.

268. United States ex rel. Steinmetz v. Allen, 192 U. S. 543, 563, 48 L. Ed. 563.

269. Western Electric Co. v. Williams-Abbott Electric Co., 108 Fed. Rep. 952, 955, 48 C. C. A. 159; Miller v. Eagle Mfg. Co., 151 U. S. 186, 38 L. Ed. 121; Pneumatic Tire Co. v. Lozier, 90 Fed. Rep. 732, 33 C. C. A. 255; Fassett v. Ewart Mfg. Co., 62 Fed. Rep. 404, 10 C. C. A. 441.

How unfortunately division has resulted for applicants in the past is illustrated a number of times in the reports.[270]

In one case where the Patent Office had forced a division where there was but a single invention, two patents based upon a single original application, and issued on the same day, were treated as a single patent.[271]

Where division is required the patent issued upon the divisional application, so far as regards a defense of two years' public use, relates back to the first application and will receive the credit of the filing date of that application.[272]

The exercise of the power to require a division ought to be expressly conferred upon the Commissioner of Patents by statute. Even then, the difficulty of determining whether the division should be required will frequently render a decision difficult. Where doubt exists as to the propriety of requiring a division, that doubt ought to be resolved in favor of retaining the subject-matter in a single application.

Under the old rule as to division, quoted above, no appeal was permitted from the decision of the Primary Examiner requiring division. That practice was corrected by the Supreme Court, by the issuance of the writ of mandamus, compelling the Commissioner of Patents to require the Primary Examiner to forward an appeal to the Board of Examiners-in-Chief.[273]

270. H. W. Johns Mfg. Co. v. Robertson, 89 Fed. Rep. 504; Benjamin v. Bale, 158 Fed. Rep. 617, 85 C. C. A. 439; Underwood v. Gerber, 149 U. S. 224, 37 L. Ed. 710.

271. Benjamin v. Bale, 158 Fed. Rep. 617, 85 C. C. A. 439; Underwood v. Gerber, 149 U. S. 224, 37 L. Ed. 710.

272. Stirling Co. v. St. Louis Brewing Assn., 79 Fed. Rep. 80.

273. United States ex rel. Steinmetz v. Allen, 192 U. S. 543-563, 48 L. Ed. 563.

§ 77. Abandonment.

Abandonment enters the law of patents in various forms, namely, in abandoned experiments, abandonment of an invention to the public, abandonment of an application for letters patent.

These various forms of abandonment are measurably co-related, and will be here dealt with in the order named.

§ 78. Abandoned experiments are experiments which have not only been abandoned, but have been unsuccessful.[274]

Such experiments do not affect the validity of a subsequent patent[275] even though an unsuccessful application for a patent was made upon them.[276]

Speaking of abandoned experiments, Mr. Justice Swayne said: "The invention or discovery relied upon as a defense, must have been complete, and capable of producing the result sought to be accomplished. If the thing were embryotic or inchoate; if it rested in specula-

274. Coffin v. Ogden, 18 Wallace 120, 124, 31 L. Ed. 821, 823.

275. Albright v. Celluloid Harness Trimming Co., 1 Fed. Cas. No. 147, 2 Ban & A. 629, 12 Gaz. 227; Whittlesey v. Ames, 13 Fed. 893, 9 Biss. 225; Phillips v. Carroll, 23 Fed. 249; Fay v. Allen, 24 Fed. 804; American Bell Tel. Co. v. People's Tel. Co., 25 Fed. 725 (affirmed in 126 U. S. 1, 31 L. Ed. 863); Hoyt v. Slocum, 26 Fed. 329; Hutchinson v. Everett, 26 Fed. 531; International Tooth Crown Co. v. Richmond, 30 Fed. 775; American Bell Tel. Co. v. American Cushman Tel. Co., 35 Fed. 731, 1 L. R. A. 60; Gamewell Fire-Alarm Tel. Co. v. Municipal Signal Co., 61 Fed. 948, 10 C. C. A. 184; Standard Cartridge Co. v. Peters Cartridge Co., 77 Fed. 630, 23 C. C. A. 367; Westinghouse Electric Co. v. Beacon Lamp Co., 95 Fed. 462-464; R. Thomas, etc., Co. v. Electric Porcelain, etc., Co., 111 Fed. 923; General Electric Co. v. Wise, 119 Fed. 922; Arrott v. Standard Sanitary Mfg. Co., 131 Fed. 457 (affirmed in 135 Fed. 750, 68 C. C. A. 388); United Shoe Mach. Co. v. Greenman, 153 Fed. 283, 82 C. C. A. 581 (affirming 145 Fed. 538); Whitely v. Swayne, 7 Wall. 685, 19 L. Ed. 199; Keystone Mfg. Co. v. Adams, 151 U. S. 139, 38 L. Ed. 103; Deering v. Winona Harvesting Works, 155 U. S. 286, 302, 39 L. Ed. 153.

276. Brown v. Guild, 90 U. S. 181, 211, 23 L. Ed. 161.

tion or experiment; if the process pursued for its development had failed to reach the point of consummation, it cannot avail to defeat a patent founded upon a discovery or invention which was completed; while in the other case there was only progress, however near that progress may have approximated to the end in view. The law requires not conjecture but certainty."[277]

It does not follow, however, that because a prior device was abandoned it was an abandoned experiment within the meaning of the rule. On the contrary, it may anticipate, despite its abandonment.[278] Such prior device may constitute an anticipation even though unsuccessful and abandoned, if its failure was merely due to defective details or construction which could be overcome by mere mechanical skill.[279]

Where a machine has been made to work successfully, and was abandoned only because its owner had no further use for it, it cannot be regarded as an abandoned experiment;[280] and, as a general deduction from the cases, any device used sufficiently to demonstrate its operativeness, will not be regarded as an abandoned experiment.[281]

The mere abandonment of experiments on an incomplete invention, made with the expectation of resuming them, is not an abandonment of the invention.[282]

277. Coffin v. Ogden, 18 Wall. 120, 124, 21 L. Ed. 821, 823.

278. Bromley Bros. Carpet Co. v. Stewart, 51 Fed. Rep. 912, 915.

279. Pickering v. McCullough, 104 U. S 310, 319, 26 L. Ed. 749, 752.

280. Bromley Bros. Carpet Co. v. Stewart, 51 Fed. Rep. 912, 915.

281. Stephenson v. Brooklyn Cross-town Ry. Co., 14 Fed. Rep. 457, 459; Electric Accumulator Co. v. Julien Electric Co., 38 Fed. Rep. 131; American Roll Paper Co. v. Weston, 51 Fed. Rep. 240.

282. Crown Cork & Seal Co. v. Aluminum Stopper Co., 108 Fed. Rep. 845, 48 C. C. A. 72.

§ 79. Abandoned inventions are public property.

The inventor may, if he chooses, willfully abandon his invention, or he may by his extraneous acts preclude himself from subsequently claiming any exclusive right in his invention.

Wherever abandonment occurs, it is absolute and cannot be recalled.[283] The issue of abandonment is between the inventor on the one hand and the whole public on the other: "An abandonment cannot be in favor of one person, but to the public, giving everyone the right to use and manufacture the invention."[284]

It is obvious that the question of abandonment is practically raised in the defense of actions brought upon the patent, and to the end that the patent may be invalidated by the defense so interposed. There is no presumption in favor of abandonment; it is a defense which must be interposed by answer,[285] and the absence of an allegation negativing abandonment does not make a bill of complaint demurrable.[286]

"The defense of abandonment is separate and distinct from that of having been in public use or on sale for a period exceeding two years."[287] While, of course, a single sale of the thing patented more than two years

283. Pennock v. Dialogue, 2 Peters 1, 7 L. Ed. 327; Kendall v. Windsor, 62 U. S. (21 Howard) 322, 328, 16 L. Ed. 165; Consolidated Fruit Jar Co. v. Wright, 94 U. S. 92, 96, 24 L. Ed. 68; Woodbury Patent Planing Machine Co. v. Keith, 101 U. S. 479, 484, 25 L. Ed. 939; Western Electric Co. v. Sperry Electric Co., 58 Fed Rep. 186, 191.

284. Knowles, J., in Ross v. Montana Union Ry. Co., 45 Fed. Rep. 424.

285. Kendall v. Winsor, 21 Howard 322, 7 L. Ed. 327; Consolidated Fruit Jar Co. v. Wright, 94 U. S. 92, 24 L. Ed. 68; United States Electric Lighting Co. v. Consolidated Electric Light Co., 33 Fed. Rep. 869; Warren Featherbone Co. v. Warner Bros. Co., 92 Fed. Rep. 990.

286. Warren Featherbone Co. v. Warner Bros. Co., 92 Fed. Rep. 990.

287. Shiras, J., in Mast, Foos & Co. v. Dempster Mill Mfg. Co., 71 Fed. Rep. 701.

prior to the application for patent, will defeat the patent,[288] that state of facts technically falls within the latter class of defenses. "An abandonment of an invention to the public may be evinced by the conduct of the inventor at any time, even within the two years named in the law."[289]

With this premise as to the defense of abandonment, we will deal with the acts which have been held to evidence, or not to evidence, abandonment. In reading the decisions it is important to note that, before abandonment can be found, it must be clearly proven that the inventor intended to dedicate his invention to the public.[290] All reasonable doubts in this regard are to be resolved in favor of the patent.[291]

Abandonment of an invention is either direct or inferred from circumstances.[292] An express abandonment occurs when the inventor expressly declares that he abandons his invention to the public;[293] as where, in a published article, he states that the invention "is open to anybody."[294]

Abandonment may occur, in point of time, at any time prior to the application for patent, or thereafter and before the issuance of letters patent.[295]

288. Henry v. Francestown Soap Stone Co., 2 Fed. Rep. 78.

289. Mr. Justice Bradley, in Elizabeth v. Pavement Co., 97 U. S. 126, 134, 24 L. Ed. 1000; quoted and followed in Anderson v. Eiler, 46 Fed. Rep. 777.

290. Ide v. Trorlicht, Duncker & Renard Carpet Co., 115 Fed. Rep. 137, 53 C. C. A. 341.

291. Crown Cork & Seal Co. v. Aluminum Stopper Co., 108 Fed. Rep. 845, 48 C. C. A 72.

292. Crown Cork & Seal Co. v. Aluminum Stopper Co., 108 Fed. Rep. 845, 48 C. C. A. 72.

293. Kendall v. Winsor, 21 Howard, 322, 328, 16 L. Ed. 165; United States Rifle & Cartridge Co. v. Whitney Arms Co., 118 U. S. 22, 24, 30 L. Ed. 53.

294. Westinghouse Elec. & Mfg. Co. v. Saranac Lake Elec. Light Co., 108 Fed. Rep. 221, 224; affirmed on Appeal, 113 Fed. Rep. 884, 51 C. C. A. 514.

295. Crown Cork & Seal Co. v. Aluminum Stopper Co., 108 Fed. Rep. 845, 48 C. C. A. 72.

Delays in the Patent Office due to the applicant exhausting as nearly as possible the statutory limitation as to time, do not evidence abandonment; the courts not requiring any degree of diligence beyond that required by the statute.[296]

The fact that one abandons his experiments relating to his incomplete invention, intending to resume them, is not an abandonment of the invention.[297]

The abandonment of an application which is one of two co-pending applications for the same invention is not an abandonment of the invention.[298]

Delay in filing an application for letters patent in the United States, until after the expiration of a foreign patent for the same invention, works the abandonment of the invention in the United States.[299]

§ 80. Abandonment by failure to claim.

The claim being the limitation of the monopoly created by the grant of letters patent, the patentee dedicates to the public everything shown and described in the drawings and description, not embodied in the claims.[300] But this rule does not apply to the disclosure of a distinct and separable invention which could not be claimed in the same application.[301]

296. Ibid.

297. Ibid.

298. Edison v. American Mutoscope Co., 110 Fed. Rep. 660.

299. Huber v. N. O. Nelson Mfg. Co., 148 U. S. 270, 37 L. Ed. 447.

300. Kinloch Telephone Co. v. Western Elec. Co., 113 Fed. Rep. 652, 51 C. C. A. 362; Ide v. Trorlicht, Duncker & Renard Carpet Co., 115 Fed. Rep. 137, 53 C. C. A. 341.

301. Suffolk Co. v. Hayden, 3 Wall. 315, 18 L. Ed. 76; McMillan v. Rees, 1 Fed. Rep. 722; Collender v. Griffith, 2 Fed. Rep. 206; Graham v. Geneva Lake Crawford Mfg. Co., 11 Fed. Rep. 138; Graham v. McCormick, 11 Fed. Rep. 859; Vermont Farm Mach. Co. v. Marble, 19 Fed. Rep. 307; Hatch v. Moffitt, 15 Fed. Rep. 252; Brush Electric Co. v. Julien Electric Co., 41 Fed. Rep. 679.

§ 81. Continuing applications.

As we have seen, abandonment of the invention is by no means inferred from the abandonment of an application for a patent embracing that invention. When the question of bar by reason of public use and sale arises, the patent so attacked is frequently sought to be carried back through the application upon which it was issued, to an antecedent application, in order that it may receive the benefits attaching to the filing date of the earlier application, as against the said defense. Again, the earlier filing date may be sought in order that it may be employed as the date of the constructive reduction of the invention to practice. Because of the fact that an abandonment of the antecedent application is final and cannot be recalled, the first inquiry in cases of this character under discussion is whether or not the continuity of the application was broken by abandonment.

The following summary of the cases is in the language of Judge Sanborn: "There is a wide difference between the abandonment of an invention and the abandonment of an application for it. An abandonment of an application is not necessarily an abandonment of the invention, and, after the application has been abandoned, a valid patent for the invention may nevertheless be secured upon a new application, provided the invention has not gone into public use or been upon sale for more than two years prior to the filing of the latter. In cases in which the first application has not been abandoned, subsequent applications and amendments constitute a continuance of the original proceeding, and the two years' public use or sale which may avoid the patent must

be reckoned from the presentation of the first application, and not from the filing of subsequent applications or amendments.[302]

"But the abandonment of an application destroys the continuity of the solicitation of the patent. After abandonment a subsequent application institutes a new and independent proceeding, and the two years' public use or sale which may invalidate the patent issued upon it must be counted from the filing of the later application."[303]

§ 82. Forfeiture for non-payment of final fee, and renewed applications.

It is provided by § 4885, R. S. U. S., that the final fee (of $20.00) shall be paid not later than six months from the time at which the application was passed and allowed and notice thereof was sent to the applicant or his agent; and if the final fee is not paid within that period the patent shall be withheld.

The effect of non-payment of the final fee within the

302. Citing U. S. v. American Bell Telephone Co., 167 U. S. 224, 42 L. Ed. 144; Colgate v. Western Union Tel. Co., Fed. Case 2995; Miehle v. Read, 96 O. G. 426; Thomson-Houston Electric Co. v. Winchester Avenue R. Co., 71 Fed. Rep. 192, 73 O. G. 2155; Godfrey v. Eames, 1 Wall. 317, 17 L. Ed. 684; Smith v. Goodyear Dental Vulcanite Co., 93 U. S. 486, 23 L. Ed. 952; Cain v. Park, 14 App. D. C. 42, 86 O. G. 797, 798; Ex parte Stewart, 4 O. G. 665; Stirling Co. v. St. Louis Brewing Ass'n, 79 Fed. Rep. 80; Dederick v. Fox, 56 Fed. Rep. 714, 717; Ligowski Clay-Pigeon Co. v. American Clay-Bird Co., 34 Fed. Rep. 328, 333.

303. Sanborn, J., in Hayes-Young Tie Plate Co. v. St. Louis Transit Co., 137 Fed. Rep. 81, 82, 70 C. C. A. 1, citing Bevin v. East Hamilton Bell Co., Fed. Case 1379; Lindsay v. Stein, 10 Fed. Rep. 907; Lay v. Indianapolis Brush & Broom Mfg. Co., 120 Fed. Rep. 831, 835, 57 C. C. A. 313, 317; Mowry v. Barber, Fed. Case 9892; Marsh v. Sayles, Fed. Case 9119; Ex parte Simpson, Fed. Case 12,878; Carty v. Kellogg, 73 O. G. 285; Cain v. Park, 86 O. G. 797, 798.

time limited, and the time within which a renewal application may be filed are thus covered by statute.

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

The provision in this section that abandonment "shall be considered as a question of fact," renders the decision of the Commissioner reviewable in a suit upon the patent.[304] Of this section Commissioner Marble has said:

"From the first the office has accepted the payment of a new fee and a request that the patent issued upon the old papers was a sufficient new filing or efiling within the spirit of the law. This is in effect a revival of the old application or a refiling upon payment of a new fee. For it cannot be supposed that the oath of invention attached to one application can support a patent granted upon another. (James Heginbotham, 8 O. G. 237.) A similar practice, I am informed, was permitted in refiling

304. United States Rifle & Cartridge Co. v. Whitney Arms Co., 118 U. S. 22, 30 L. Ed. 53.

'withdrawn' applications renewed under the provisions of section 35, second proviso, law of 1870. Aside from the significance of this practice as a contemporaneous construction of the law by those who participated in framing it, the practice is the only one by which effect can be given to the words of the statute which extend to assignees the privilege of filing new applications within two years. In continuation of the spirit of the act of 1864, which enabled an assignee to perfect the application by payment of the final fee, the assignee is now permitted to make payment of a new fee in aid, and continuation of an application already filed. In this way alone can any special meaning be attached to this provision additional to and not inconsistent with other equally binding provisions of the law.

"If the views now expressed as to the status of the second application called for by section 4897 are correct, it is clear that the section declares in effect that a 'withheld' application is *sui generis*, having neither the incidents of a rejected or abandoned application, but that it is an application held in abeyance and liable to be revived upon the payment of a new fee, and that such applications will only become abandoned after the expiration of two years, reckoning from the date of allowance. Like section 4894, it limits the life of the application to two years after the last action of the office, but operates upon a different class of applications, and introduces the new principle that after a certain period of neglect an additional tax will be imposed upon the inventor."[305]

It was formerly the rule of the Patent Office that the renewal application must be signed by the applicant, but the rulings to that effect were overruled by Commissioner Allen in an opinion in which he said:

305. Ex parte Livingston, 20 Off. Gaz. 1747, 1749.

"Assuming, then, that an attorney with proper authorization from his principal may sign and file a petition for renewal, the question next arises whether the power of attorney ordinarily given in an original application contains such an authorization. These powers usually delegate, among other things, the right 'to transact all business in the Patent Office in connection with the application.'

"It has been the custom of the office before and since the decision in *ex parte Thomas* (92 Off. Gaz. 1035) to allow an attorney to prosecute the renewal of the application by virtue of the power given him in the original case. This is believed to be the right practice, since an applicant appoints an attorney with the idea of getting him a patent on his invention, and the prosecution of the renewal is so closely allied with the prosecution of the original that the acquiescence of the applicant in the acts of the attorney in prosecuting the renewal should be presumed in the absence of any protest or revocation of the power on the part of the applicant.

"The power of attorney given by the applicant in the present application contains the clause referred to above, delegating to his attorney the right to transact all business in this office in connection with the application.

"As the applicant has elected to use all the parts of his old application in his renewal, it is held, in view of the established practice of permitting an attorney to prosecute a renewal by virtue of his original power, that the signing of a petition for a renewal is such an act in connection with the application as is authorized to be done by his attorney in the power of attorney which has been given him."[306]

306. Ex parte Agee, 101 Off. Gaz. 1609.

The period of six months referred to in this section has been construed to mean six calendar months.[307]

There is nothing in this section to prevent the issuance of valid claims on the renewal application which were not embodied in the original application as allowed.[308]

§ 83. Public use proceedings.

Public use proceedings are brought by a private party, who has in some way become aware of the pendency of a patent application in the Patent Office, for the purpose of defeating the allowance of the application by a showing that the subject-matter is not patentable because of prior public use. Such proceedings are sometimes referred to as "protests," but that term more properly describes the statement filed by the party who seeks to have the proceedings instituted, and who is called the "protestant."[309] "Such proceedings are not to be regarded as a contest between the protestant and the applicant, but as an investigation on behalf of the public by the Patent Office.[310] The parties in interest are the applicant on the one hand and the public on the other. The protestant does not represent the public. * * * This office alone represents the public."[311]

The practice in such proceedings has been thus outlined:

> "This is deemed to be a suitable occasion to indicate the practice to be followed when it appears from an ex parte affidavit that the invention claimed

307. Economy Feed Water Heater Co. v. Lamphrey Boiler Furnace-Mouth Protector Co., 65 Fed. Rep. 1000, 13 C. C. A. 271.

308. Bowers v. San Francisco Bridge Co., 69 Fed. Rep. 640.

309. In re National Phonograph Co., 89 Off. Gaz. 1669.

310. United States ex rel. National Phonograph Co. v. Allen, 101 Off. Gaz. 1133.

311. Ex parte Kephart, 103 Off. Gaz. 1914.

has been in public use for more than two years prior to the date of the filing of the application. When such an affidavit is filed with the Examiner, he should examine it and determine whether it makes out a prima facie case of public use. If in his opinion such a case is made out, he should call the Commissioner's attention to the fact and transmit the papers in the case for the Commissioner's consideration. If the Commissioner holds that the affidavit warrants an investigation of the question of public use, he will call upon the applicant to show cause why public use proceedings should not be instituted and give the protestant or affiant an opportunity to be heard at this preliminary hearing before the Commissioner. If after this hearing the Commissioner decides to investigate the question, he will issue an order setting a time for taking testimony to prove the facts set up in the affidavit. At this hearing, of course, the affiant will have a right to be heard and at the taking of testimony to cross-examine witnesses and also to rebut their testimony by witnesses of his own. After the testimony has been closed it will be filed in the office, where it will be considered, and not until it has been determined affirmatively that the testimony discloses that the invention has been in public use for more than two years prior to the date of the filing of the application will the claims be rejected."[312]

Under the practice thus stated, the protest should, if based upon the existence of unpatented devices urged as a bar, be supported by affidavit, and the protestant will then be permitted to offer proofs, taken under condi-

312. Chamberlin, Assistant Commissioner, in Ex parte Van Ausdal, 91 Off. Gaz. 1617.

tions permitting the applicant to cross-examine the witnesses.[313] If the application against which a protest is filed is involved in an interference, the other parties to the interference will be permitted to become parties to the public use proceedings, if they so request, and will be permitted to cross-examine the protestant's witnesses.[314]

The questions of priority and public use have been held to be closely related, and where the evidence as to prior public use was developed as against an applicant, who was in interference with a patentee it was held that the interference should be dissolved, and that the defeated party would not be granted an ex parte rehearing as to public use, on petition.[315]

In a case similar to the one just referred to, the patentee filed his petition requesting suspension of proceedings in the interference, and the institution of public use proceedings. The petition was denied upon the following reasons: "Bloomberg is a patentee. In his preliminary statement he alleges public use of the invention more than two years prior to the filing date of Siebert's application. The petition is supported by the affidavit of Bloomberg and two others.

"The affidavits fail to make out a *prima facie* case of public use of the invention in interference more than two years prior to Siebert's filing date. They state the conclusions of the witnesses largely to the exclusion of the facts upon which such conclusions are based. Where facts are given, they are not recited with sufficient particularity and certainty. A portion of the showing is also objectionable as mere hearsay. This office should

313. In re National Phonograph Co., 89 Off. Gaz. 1669.

314. In re National Phonograph Co., 89 Off. Gaz. 1669.

315. Mills v. Torrance, 110 Off. Gaz. 857.

not institute a proceeding which may uselessly consume the time and labor of all parties upon such a showing.

"Moreover, it does not appear that copies of the petition and affidavits have been served upon the applicant, nor is any offer found to produce the witnesses and bear the expenses of the office in conducting the investigation. The lack of service is alone sufficient reason for denying the petition, and public-use proceedings are not ordinarily instituted except upon an offer of the character mentioned."[316]

When an order to show cause why public use proceedings should not be instituted was made against an applicant, and, in return, the applicant showed that an interference was in progress involving the same subject-matter, it was ruled that the public-use proceedings should be instituted, and carried on simultaneously with the interference.[317]

Where the protest rested upon a single affidavit that the machine alleged to have been in public use corresponded to one claim of a pending application, the affidavit containing no description of that machine, the protest was dismissed, Commissioner Allen observing: "Corroborating affidavits should also be filed if other witnesses are to be relied upon. Altogether, the protestants should present their *prima facie* case as well as may be done by affidavits so as to give the applicant opportunity to intelligently oppose the institution of the proceedings and the consequent delay in the prosecution of his application."[318]

As to the review, on petition, of a decision of the primary examiner adverse to a protestant, Commissioner

316. Siebert v. Bloomberg, 124 Off. Gaz. 628.

317. In re Setter, 126 Off. Gaz. 3421.

318. In re Booth Bros., 128 Off. Gaz. 1291.

Moore has observed: "Public-use proceedings are *ex parte* in their nature, the sole question being whether the applicant is barred from obtaining a patent on the invention claimed by reason of the public use or sale of devices embodying the invention claimed.

"While it is the practice to permit one of the general public to file a protest and to take testimony in behalf of the Patent Office upon this question, such party has no right in the controversy other than those authorized by the Commissioner. When the evidence presented has been submitted to the Primary Examiner for consideration and in his opinion this testimony does not establish a statutory bar of public use, there is no greater warrant for a review of his decision upon this question than from a decision by the Examiner that references in his possession, whether obtained by search or upon motion for dissolution in an interference, do not anticipate the claims of an application. The action of the Examiner holding that testimony in public-use proceedings is insufficient to warrant the rejection of the applicant's claims will be reviewed only where such obvious error appears as will warrant the supervisory action of the Commissioner. In the present case no such error is found."[319]

At the hearing upon public-use proceedings it is customary to set a time within which briefs may be filed by the applicant, but oral argument is not permitted.[320]

An experimental use will not suffice to sustain public-use proceedings. Where the machine alleged to have been in prior public use was a cigar-making machine, and the use was in a machine shop, and not in a cigar factory, only employees being admitted, and the testimony showing that the machine was operated for the primary pur-

319. Ex parte Hartley, 136 Off. Gaz 1767.

320. In re Henry, Jr., 140 Off. Gaz. 508.

pose of developing imperfections, and that many minor changes were made, as a result of such tests, it was held that a case of public use was not made out, though incidentally merchantable cigars were made and marketed.[321]

One who files a protest based upon prior public use will be bound by that protest in litigation upon a patent of his own for the same subject-matter, and if his protest showed that subject-matter to have been in public use at a time sufficiently anterior to his own application to anticipate his patent, it will have that effect in subsequent litigation.[322] Similarly, an unsuccessful patentee-protestant may be estopped by his efforts to thwart a reissue, from denying infringement when sued upon the reissued patent. In such a case Judge Brawley has said: "We are clearly of opinion that the Hall patent is an infringement. None of the defendants' experts have disputed it, and the protest filed by Hall in the Patent Office against the reissue, and the long contest made by him and his attorneys against it, are in the nature of a confession, for, had he not apprehended that the invention was the same, it would be difficult to understand why so much effort and money should have been expended to prevent the reissue."[323]

321. Lacroix v. Tyberg, 148 Off. Gaz. 831, 833; following Burson v. Vogel, 29 App. D. C. 388, 131 Off. Gaz. 942.

322. Dodge Needle Co. v. Jones, 159 Fed. Rep. 715, 725, 86 C. C. A. 628.

323. Crown Cork & Seal Co. v. Aluminum Stopper Co., 108 Fed. Rep. 845, 861, 48 C. C. A. 72.

CHAPTER IV.

APPEALS IN PATENT OFFICE PROCEDURE.

§ 84. Patent Office appeals, generally.

The rule is well settled that no review by the appellate tribunals of the Patent Office can be had, either on petition or by appeal, unless the Examiner has either twice acted or twice refused to act upon the issue involved.[1] An appeal from the Examiner cannot be taken until a final (second) rejection has been made upon all his grounds for refusing a patent.[2]

§ 85. Where appeals originate.

Appeals may be taken from a second rejection of any claim by the Examiner, or from his second refusal to act thereon;[3] from the decision of the Examiner of interferences upon the merits in interference cases,[4] and in public use proceedings.[5]

§ 86. What reviewable by petition.

The Commissioner of Patents is peculiarly the responsible head of the Patent Office. Though that office is a bureau of the Interior Department, the Secretary of the Interior has no direction of or supervision over

1. Ex parte Bishop, 63 Off. Gaz. 153; Ex parte Schulze, 84 Off. Gaz. 931.
2. Ex parte Donovan, 52 Off. Gaz. 309.
3. Ex parte Schulze, 84 Off. Gaz. 981.
4. Trevette v. Dexter, 84 Off. Gaz. 1283.
5. Ex parte Finch, 40 Off. Gaz. 1027.

the Commissioner in his exercise of judicial functions.[6] In the exercise of his plenary power to regulate the procedure of the office, a petition will lie to him to review any question, not affecting the merits, arising in the proceedings of the office.[7] The questions reviewable by the Commissioner upon petition are obviously of every conceivable character, and it would be a vain task to here undertake a summary of the decisions. A few cases will be adverted to in illustration of the purposes of the petition.

Before a petition will be entertained it must appear that the petitioner has fully presented to the Examiner his reasons for the object sought to be attained;[8] the Examiner must have twice acted, or twice refused to act, in the matter complained of.[9]

Petitions have been entertained to review an Examiner's ruling that a claim was indefinite;[10] a ruling excluding as new matter an addition to a description or drawing not extending to or affecting the claim;[11] a ruling that certain claims in the same application are substantially identical;[12] a requirement that the original drawing, structure or model, referred to in an affidavit filed before the Examiner be produced;[13] a ruling that an alleged divisional application covers subject-matter which could not be legitimately divided out of the early application of which it is alleged to be a division;[14] a

6. Butterworth v. United States, 112 U. S. 50, 28 L. Ed. 656.

7. Ex parte Cousens, 84 Off. Gaz. 1433.

8. Ex parte Maynard, 84 Off. Gaz. 1433.

9. Ex parte Bishop, 63 Off. Gaz. 153; Ex parte Shulze, 84 Off. Gaz. 981.

10. Ex parte Eastman, 56 Off. Gaz. 410.

11. Ex parte Suter, 59 Off. Gaz. 1431.

12. Ex parte Eastman, 56 Off. Gaz. 410.

13. Ex parte Johnson, 89 Off. Gaz. 1341.

14. Ex parte Fuller, 57 Off. Gaz. 1883; Ex parte Freeman, 58 Off. Gaz. 522.

ruling requiring an applicant to file the affidavits of third parties in addition to his own;[15] the failure of an Examiner to respect and apply a decision of the Commissioner;[16] a ruling of the Primary Examiner requiring a new oath.[17]

The Commissioner has reviewed upon petition decisions of the Examiner of interferences denying leave to take additional testimony;[18] refusing, in advance of final hearing, to consider and rule on a motion to strike out the testimony of the wife of a party.[19]

On the other hand, a petition cannot properly be invoked to secure a review upon the merits. Review on petition has been denied where matter involving the merits of the claims was held to constitute a departure from the applicant's original disclosure;[20] where the ruling sought to be reviewed was a rejection of certain claims upon the claims of an allowed application of the same applicant;[21] or a rejection upon a prior patent of the same applicant;[22] where the ruling was the rejection of a mechanical application, upon a design patent reference;[23] where the claims were rejected under the doctrine of aggregation.[24]

The formal requisites of the petition for the purposes of review by the Commissioner are provided in the rules

15. Ex parte Johnson, 89 Off. Gaz. 1341.

16. Ex parte Ryley, 67 Ms. Dec. 495.

17. Ex parte Hoschke, 122 Off. Gaz. 1045.

18. Guerrant v. Cable, 59 Off. Gaz. 629.

19. Crawford v. Lichtenstein, 61 Off. Gaz. 1480.

20. Ex parte Welch, 93 Off. Gaz. 2105.

21. Ex parte Davidson, 93 Off. Gaz. 191.

22. Ex parte Wellman, 86 Off. Gaz. 1986.

23. Ex parte McQueen, 85 Off. Gaz. 609.

24. Ex parte Griffith, 86 Off. Gaz. 936; Ex parte Baker, 49 Off. Gaz. 1363.

of the Patent Office, and they are insisted upon in practice, being treated as requirements of pleading.[25]

From what has been said it will be seen that a question to be reviewed by the Commissioner upon petition must relate to matters of form and practice only, and cannot involve the merits; all questions as to the merits, the applicant's right to the patent sought, or to a particular claim refused by the inferior tribunals of the Patent Office, must reach the Commissioner by the route of appeal through the Board of Examiners-in-Chief. The Commissioner's decision upon a question presented by petition is final, so far as the Patent Office is concerned,[26] and can only be reached by mandamus.[27]

No fee is required upon the filing of a petition to the Commissioner.[28] Upon the petition being lodged, the Examiner whose ruling is sought to be reviewed is required to file a statement of the reasons for his decision.[29]

§ 87. Appeals to the Examiners-in-Chief.

The duties of the Examiners-in-Chief are defined by statute as follows:

§ 482, R. S. U. S.—The Examiners-in-Chief shall be persons of competent legal knowledge and scientific ability, whose duty it shall be, on the written petition of the appellant, to revise and determine upon the validity of the adverse decisions of Examiners upon applications for patents, and for reissues of patents, and in interference cases.

25. Ex parte Grant, 93 Off. Ed. 555.

26. Ex parte Kitson, 20 Off. Gaz. 1750.

27. United States ex rel. Steinmetz v. Allen, 192 U. S. 543, 48 L. Gaz. 2532.

28. Ex parte Carter, 46 Off. Gaz. 1391.

29. Ex parte Jove, 17 Off. Gaz. 801.

This appellate board was established by the Act of 1861, ch. 88, 12 Stat. at L. 246, "for the purpose of securing greater uniformity of action in the grant and refusal of letters patent."[30]

Mr. Justice Matthews thus described the course of appeals through the Patent Office:

"The claim is examined in the first instance by a Primary Examiner assigned to the class to which it belongs; if twice rejected by him, the applicant is entitled (§ 4909, R. S. U. S.) to appeal from his decision to that of the Board of Examiners-in-Chief, constituted a tribunal for that purpose; and from their decision, if adverse, he may appeal to the Commissioner in person (§ 4910, R. S. U. S.)."[31]

No appeal can be taken to the board on the rejection of an application until a final rejection has been had upon all the grounds held adversely by the Examiner.[32] The appeal can be taken at any time before the application becomes abandoned under the statute (one year after final rejection).[33] In contested cases, a limit of appeal is fixed by the Examiner of interferences or other Examiner making the ruling and may be extended by the Commissioner for cause shown.[34] An appeal fee of $10 must be paid upon taking an appeal to the board; but if the same question is twice appealed by the same party a single fee suffices.[35]

The appellant must specify the part or portion of the decision from which the appeal is taken.[36] The appeal

30. Butterworth v. United States, 112 U. S. 50, 28 L. Ed. 656.

31. Butterworth v. United States, 112 U. S. 50, 28 L. Ed. 656.

32. Ex parte Donovan, 52 Off. Gaz. 309.

33. Ex parte Hodgins, 62 Ms. Dec. Aug. 1897.

34. Guerrant & Cable v. Coffee, 61 Off. Gaz. 285.

35. Ex parte Thomson, 56 Off. Gaz. 1203.

36. Ex parte Callahan, 50 Off. Gaz. 990.

is answered by the Examiner from whose action it was taken, by a statement of his reasons for his decision.[37]

At the time of taking the appeal, if the appellant wishes the appeal to be argued orally he should so request in writing. Otherwise the appeal will be taken as submitted on the date assigned to it before the board, upon such brief as may have been filed by the appellant.

Upon the hearing of interference appeals the board tries the whole case *de novo*. Such appeals should be accompanied by a brief statement of reasons, but a defective statement, or the failure to provide any statement will not render the appeal void.[38] But in *ex parte* appeals the board must affirm or reverse the Examiner on the points raised by the appeal;[39] they may make recommendations for the benefit of the Examiner, which he may accept or reject. Should he reject recommendations favorable to the applicant, the applicant can usually acquire their benefit by a second appeal, if they involve matter which he can incorporate in his application by amendment.[40]

The Board of Examiners-in-Chief consists of three members, any two of whom can act in the absence of the third.[41]

Where the right of appeal to the board is denied in the Patent Office, it can be enforced in a proper case by the writ of mandamus.[42]

37. Ex parte Bullard, 45 Off. Gaz. 1569; United States ex rel. Steinmetz v. Allen, 192 U. S. 543, 48 L. Ed. 555.

38. Pitney v. Smith & Egge, 49 Off. Gaz. 129.

39. Ex parte Smoot, 11 Off. Gaz. 1010.

40. Ex parte Holt, 38 Off. Gaz. 229.

41. Ex parte Smith & Drum, 68 Ms. Dec. 429.

42. United States ex rel. Steinmetz v. Allen, 192 U. S. 543, 48 L. Ed. 555.

§ 88. Appeals to the Commissioner of Patents.

An appeal may be taken from the adverse decision of the board to the Commissioner, unless the applicant, in an *ex parte* case, acquiesces in the decision of the board upon the resumption of jurisdiction by the Primary Examiner. The rendition of its decision by the board reinvests the Primary Examiner with jurisdiction forthwith in *ex parte* cases,[43] and if the applicant proceeds to eliminate the rejected claim or claims, or amend them in scope, he is held to have elected to abide by the decision of the board and to have abandoned all right of appeal.[44]

The Commissioner may assign cases appealed from the board to either of the Assistant Commissioners, and mandamus will not lie to compel him to hear and decide such appeals in person.[45]

It is the settled rule that where an application has been finally rejected by the Commissioner in an *ex parte* proceeding, that adjudication may be relied on by him as a conclusive bar to a second application for the same invention;[46] but he may entertain and allow the second application if he deems proper.[47]

The jurisdiction of the Commissioner in interference cases is very comprehensive, and necessarily so for the prevention of injustice, not only to the parties but to the public. The inferior tribunals of the office having to deal only with the question of priority, patents would

43. Ex parte Pearson, 40 Off. Gaz. 244.

44. Ex parte Williams & Raidabaugh, 40 Off. Gaz. 1337.

45. Stapleton v. Duell, 17 App. D. C. 575, 95 Off. Gaz. 1049.

46. In re Barratt's Appeal, 14 App. D. C. 255-261, 87 Off. Gaz. 1075; In re Fay, 15 App. D. C. 517, 90 Off. Gaz. 1157; In re Edison, 30 App. D. C. 321, 323, 133 Off. Gaz. 1190; Gold v. Gold, 150 Off. Gaz. 570.

47. In re Barratt's Appeal, 14 App. D. C. 255, 87 Off. Gaz. 1075; Gold v. Gold, 150 Off. Gaz. 570.

frequently issue in derogation of the rights of the public if the Commissioner had not, at all times the right to examine questions other than priority.

Mr. Chief Justice Shepard has thus touched upon the appellate and supervisory jurisdiction of the Commissioner in interference cases: "The doctrine of *res adjudicata* necessarily applies in favor of the successful party to an interference to whom an award of priority has been made, against his opponent's attempt to renew the interference upon a new application with claims for the same invention although in different or broader form.[48]

"While the question of the patentability of the issue will not be entertained on appeal from an award of priority, the right of one of the parties to make the claims under the disclosures of his application will be entertained as an ancillary question for the reason that

> 'if it be incorrectly held that such party has the right to make the claim, priority may be awarded to him, and his adversary deprived of a substantial right, in that he is not given a claim where he necessarily is the prior inventor, his adversary never having made the invention.'[49]

"As a consequence of the doctrine established by that case, it has been held that where an interference has been dissolved on that ground, without appeal from the decision, this right to make the claim, must be considered *res adjudicata* in a later interference between the parties on the same application.[50] * * * The question of the right of one of the parties to make claims, is inseparably connected with that of priority. When adjudged

48. Citing Blackford v. Wilder, 28 App. D. C. 535-545; Horine v. Wende, 29 App. D. C. 415-428; Carroll v. Hallwood, 31 App. D. C. 165-172.

49. Podlesak v. McInnerney, 26 App. D. C. 399-405.

50. U. S. ex rel. Newcomb Motor Co. v. Moore, 30 App. D. C. 464-476.

that one of the parties had no right to make the claims, in other words, that his description fails to show a conception of the invention of the issue, the other, who thereby appeared to be the sole inventor, was necessarily entitled to the award and to his patent. The effect of the decision is to establish his right of property in the invention, and he is entitled to the benefit without further impeachment of that right by his adversary in renewed litigation in the Patent Office. If the losing party can go back to the Examiner, and proceeding *ex parte*, secure an allowance of his right to make the claims and then renew the litigation with his adversary, there might be no end to it. It is to meet conditions of this kind that the statutory doctrine in respect to the conclusiveness of former judgments has been applied in proceedings in the Patent Office. On the other hand the patentability of a described invention is a question that arises on each application when presented, and is necessarily determined *ex parte*. It is only when patentability has been allowed in the *ex parte* proceeding that an interference with a like application of another can be declared. This allowance is not appealable. It is true that the patentability of the claims of an issue in interference may be questioned in a motion to dissolve. (Patent Office Rule 122.) Why this is permitted by the rule we do not understand, unless it is to enable the Commissioner to re-examine the question in the light of argument and put an end to useless litigation if he find that an allowance of patentability ought not to have been made in the first instance. So finding he acts for the protection of the public from an unauthorized monopoly and dissolves the interference so that each application may be rejected. The decision determines no right between the two opponents but one between them both, on one side, and the public on the other. If either desire to appeal from the final order

of rejection, he must do so, *ex parte* in regular course of procedure.[51] That the question is to be considered as one between the public and the parties, and not between the latter, is also evidenced by the provisions of Rule 126 which authorizes the Examiner of Interferences, and the Examiner-in-Chief to direct the attention of the Commissioner to matters not relating to priority. Moreover the Commissioner may, with or without such direction or attention, raise the question of patentability of his own motion, and send the application back for rejection without deciding the question of priority, or he may, after the question of priority has been determined, reject the application of the successful interferant, and put him upon an *ex parte* appeal.[52] We must hold that the question of patentability was not concluded by the decision of the original motion to dissolve the interference on that ground."[53]

§ 89. Patent Office appeals to the Court of Appeals of the District of Columbia.

The Act of February 9, 1893, ch. 74, 27 Stat. at L. 436, provides, in part as follows:

"§ 9. That the determination of appeals from the decision of the Commissioner of Patents, now vested in the general term of the Supreme Court of the District of Columbia, in pursuance of the provisions of section seven hundred and eighty of the Revised Statutes of the United States, relating to the District of Columbia, shall hereafter be and the same is hereby vested in the court of appeals created by this act; and in addition, any party

51. Citing In re Fullagar, 32 App. D. C. 222-229; Sobey v. Holsclaw, 28 App. D. C. 65-82.

52. Citing Sobey v. Holsclaw, 28 App. D. C. 65-82; Seymour v. Brodie, 10 App. D. C. 507.

53. Gold v. Gold, 150 Off. Gaz. 570.

aggrieved by a decision of the Commissioner of Patents in any interference case may appeal therefrom to said court of appeals."

This Act has been held to be constitutional by the United States Supreme Court.[54] The jurisdiction of the Court of Appeals of the District of Columbia in relation to appeals from the Patent Office is of a peculiarly limited character. "The purpose of the appeal is simply to have a review of the decision of the Commissioner of Patents on the identical record before the latter officer. It is in no just sense a substitute for the trial provided for by a bill in equity in the Circuit Court. The decision on the appeal in no respect changes the character of the proceeding. All that the Appellate Court can do is to affirm or reverse the decision of the Commissioner of Patents. If a reversal occurs, the Appellate Court awards a mandate directing what decision shall be entered by the Commissioner of Patents. But it is the decision of the Commissioner of Patents, and not that of the Appellate Court, by virtue of which the patent must finally be granted. The office of an appellate tribunal is to direct an inferior court or officer, from whom an appeal is taken, what decision or judgment must at last be entered by the inferior court or officer, and not the decision or judgment of the appellate tribunal. The order of the appellate tribunal operates upon the court or officer below, by directing what such officer or court shall do; but it is the order of the latter which must dispose of the matter in controversy."[55]

Of the character of the judgment rendered upon such appeals Mr. Chief Justice Alvey has said: "There is no final judgment of this court rendered in such cases, nor is there any such judgment required or authorized

54. United States v. Duell, 172 U. S. 576, 43 L. Ed. 559.

55. Baker, J., in Bernardin v. Northall, 77 Fed. Rep. 849, 852.

to be rendered, not even for costs of the appeal. This court is simply required in such cases, after hearing and deciding the points as presented, instead of entering judgment here, to return to the Commissioner of Patents a certificate of the proceedings and decision of this court, to be entered of record in the Patent Office, to govern the further proceedings in the case. But it is declared by the statute that no opinion of this court in any such case shall preclude any person interested from the right to contest the validity of any patent that may be granted by the Commissioner of Patents. D. C. Rev. Stat., § 780; U. S. R. S., § 4914.

"There is no provision of any statute, within our knowledge, that authorizes a writ of error or an appeal to the Supreme Court of the United States in such case as the present. It would seem clear that the case is not within the purview of § 8 of the Act of Congress of February 9, 1893, providing for the establishment of this court. That section only applies to cases where final judgments by this court have been entered, and not to decisions to be made and certified to the Patent Office, under the special directions of the statute."[56]

"Its adjudication," said Mr. Justice Matthews, "though not binding upon any who choose, by litigation in courts of general jurisdiction, to question the validity of any patent thus awarded, is nevertheless conclusive upon the Patent Office itself; for, as the statute declares (§ 4914, R. S. U. S.), it 'shall govern the further proceedings in the case.'"[57]

Accordingly, the decisions of the court cannot be reviewed by the United States Supreme Court on appeal or writ of error.[58]

56. Rousseau v. Brown, 21 App. D. C. 73, 80.

57. Butterworth v. United States, 112 U. S. 60, 28 L. Ed. 659.

58. Frasch v. Moore, 211 U. S. 1, 53 L. Ed. 65.

§ 90. Time for taking appeal.

Rule 21 provides, as to all appeals from the Commissioner of Patents, that they should be taken within forty days, exclusive of Sundays and legal holidays, from the date of the ruling or order appealed from, and not afterwards. It has been held by the United States Supreme Court that this rule was within the authority of the Court of Appeals of the District of Columbia,[59] and the rule is strictly enforced.[60]

Under this rule time is reckoned from the date of the decision and not from the time that notice of the decision is sent to, or received by, the party against whom it is made.[61] The running of the time for appeals is not arrested by filing a motion for rehearing in the Patent Office,[62] and as under § 1389 of the Code of the District of Columbia every Saturday, after 12 o'clock noon, is a half holiday in the District of Columbia, one-half of each Saturday, as well as Sundays and legal holidays, will be excluded in computing the time limit for appeal.[63]

§ 91. Perfecting the appeal.

Rule 21 of the Court of Appeals of the District of Columbia provides in part as follows: "If the petition for an appeal and the certified copies of papers and evidence on appeal mentioned in this and the preceding section of this rule shall not be filed and the case duly docketed in this Court within forty days (exclusive of Sundays and legal holidays) from the day upon which notice of appeal is given to the Commissioner of Patents,

59. In re Hien, 166 U. S. 432, 41 L. Ed. 1066.

60. Burton v. Bentley, 14 App. D. C. 471, 87 Off. Gaz. 2326; Ross v. Loewer, 9 App. D. C. 563, 77 Off. Gaz. 2141.

61. Burton v. Bentley, 14 App. D. C. 471, 87 Off. Gaz. 2326.

62. Ross v. Loewer, 9 App. D. C. 563, 77 Off. Gaz. 2141.

63. Ocumpaugh v. Norton, 24 App. D. C. 296.

the Commissioner, upon such facts being brought to his attention by motion of the appellee, duly served upon the appellant or his attorney, may take such further proceedings in the case as may be necessary to dispose of the same, as though no notice of appeal had ever been given."

This rule is strictly enforced.[64]

§ 92. What matters appealable.

No appeal lies from the Commissioner of Patents except in the case of a final order.[65] His decision dissolving an interference is not appealable,[66] nor is a requirement for division.[67]

As a general rule the Court of Appeals will not review the discretionary orders of the Patent Office, such as its rulings upon motions to reopen a case for the introduction of alleged newly discovered evidence,[68] or upon motions for leave to amend a preliminary statement.[69] Even his ruling upon the question of striking an application from the files of the Patent Office will not be disturbed unless there is a palpable abuse of his discretion,[70] and so of his ruling upon the question whether a design application contains a proper description.[71]

A decision denying the right of a party to make a claim is appealable as an ancillary question in an interference case.[72]

64. In re McCreery, 12 App. D. C. 517, 79 Off. Gaz. 1684.

65. Hulett v. Long, 15 App. D. C. 284, 89 Off. Gaz. 1141; Union Distilling Co. v. Schneider, 29 App. D. C. 1,129 Off. Gaz. 2503.

66. Mell v. Midgley, 31 App. D. C. 534, 136 Off. Gaz. 1534.

67. In re Frasch, 20 App. D. C. 298, 100 Off. Gaz. 1977.

68. Richards v. Meissner, 24 App. D. C. 305, 114 Off. Gaz. 1831; Dunbar v. Schellenger, 29 App. D. C. 129, 128 Off. Gaz. 2837.

69. Hammond v. Basch, 24 App. D. C. 469, 115 Off. Gaz. 804; Neth v. Ohmer, 27 App. D. C. 319, 123 Off. Gaz. 998.

70. Davis v. Garrett, 28 App. D. C. 9, 123 Off. Gaz. 1991.

71. In re Mygatt, 26 App. D. C. 366, 121 Off. Gaz. 1676.

72. United States v. Moore, 30 App. D. C. 464, 133 Off. Gaz. 1680.

In one of its opinions the Court of Appeals of the District of Columbia has said: "The jurisdiction of this court to entertain appeals from the Commissioner of Patents is limited to two classes of decisions, namely, a final rejection of an application for a patent, and a final award of priority to one of the parties in an interference case.[73] It has been settled also that the question of the right of a party in an interference to make the claims of the issue is one that may be raised, decided, and brought up as an ancillary question necessarily involved in that of priority.[74] The order dissolving the interference on that ground is, itself interlocutory, and cannot be appealed from independently of a final decision putting an end to the litigation through an award of priority to the rival applicant. When that final award has been made the interlocutory order may be reviewed in an appeal therefrom, but not otherwise."[75]

§ 93. The scope of the appellate review.

In its consideration of interference cases the Court of Appeals will not pass upon the patentability of the alleged invention, but will regard that question as concluded by the decision of the Commissioner of Patents, and will confine its examination of the record to the question of priority.[76] It will decline jurisdiction of the question of priority when the Patent Office has expressly reserved for determination at some future time the question of the patentability of the invention.[77] The question of interference in fact is presumed to have been finally

73. In re Fullagar, 32 App. D. C. 222-228.

74. Podlesak v. McInnerney, 26 App. D. C. 399-405.

75. Cosper v. Gold & Gold, 151 Off. Gaz. 195; citing, Podlesak v. McInnerney, 26 App. D. C. 399-405; In re Fullagar, 32 App. D. C. 222-229.

76. Schupphaus v. Stevens, 17 App. D. C. 548, 95 Off. Gaz. 1452.

77. Oliver v. Felhel, 20 App. D. C. 255, 100 Off. Gaz. 2384.

determined in the Patent Office and will not be reviewed on appeal except in very rare and exceptional cases.[78] An order of the Commissioner dissolving the interference as to certain counts will not be reviewed,[79] nor will a recommendation of the Examiners-in-Chief that has not been adopted by the Commissioner.[80] Similarly the court will not consider the question as to the operativeness of the disclosure of one of the parties,[81] or the question of the sufficiency of the disclosure of an application involved in an interference.[82]

§ 94. The weight given the Patent Office decisions on appeal.

Where the three tribunals of the Patent Office have been in accord in their opinions the appellant must show plain error in order to reverse the decision of the Commissioner.[83]

This rule applies with peculiar force to an *ex parte* appeal where all of the tribunals of the Patent Office have denied the existence of patentable novelty in the

78. Swihart v. Mauldin, 19 App. D. C. 570, 99 Off. Gaz. 2322; Luger v. Browning, 21 App. D. C. 201, 104 Off. Gaz. 1123.

79. Hillard v. Brooks, 23 App. D. C. 526, 111 Off. Gaz. 302.

80. Hillard v. Brooks, 23 App. D. C. 526, 111 Off. Gaz. 302.

81. Lotterhand v. Hanson, 23 App. D. C. 372, 110 Off. Gaz. 861; Duryea v. Rice, 28 App. D. C. 423, 126 Off. Gaz. 1357.

82. Stone v. Pupin, 19 App. D. C. 396, 100 Off. Gaz. 1113; Kilburn v. Hirner, 29 App. D. C. 54, 128 Off. Gaz. 1689.

83. In re Barratt, 11 App. D. C. 177, 79 Off. Gaz. 2020; Glenn v. Adams, 12 App. D. C. 175, 83 Off. Gaz. 158; Howard v. Hey, 18 App. D. C. 142, 95 Off. Gaz. 1647; Flora v. Powrie, 23 App. D. C. 195, 109 Off. Gaz. 2443; Murphy v. Meissner, 24 App. D. C. 305, 114 Off. Gaz. 1830; Orcutt v. McDonald, 27 App. D. C. 228, 123 Off. Gaz. 1287; Bourne v. Hill, 27 App. D. C. 291; 123 Off. Gaz. 1284; In re Clunies, 28 App. D. C. 18, 123 Off. Gaz. 263; Parkes v. Lewis, 28 App. D. C., 123 Off. Gaz. 2313; Ries v. Kirkegaard, 30 App. D. C. 199, 132 Off. Gaz. 845; Onderdonk v. Parkes, 31 App. D. C. 214, 135 Off. Gaz. 665.

application.[84] Where the question of priority is doubtful, the decision of the Commissioner is usually persuasive.[85]

§ 95. Mandamus to compel action in public use proceedings.

The writ of mandamus has been so often invoked to direct the action of the Commissioner of Patents in proceedings in the Patent Office that it is appropriate to note the statement which the Court of Appeals of the District of Columbia has formulated as to the purpose of the writ.

"The function of the writ of mandamus in the law is well settled. It lies simply for the enforcement of the performance of some act or duty required by law to be performed in the performance of which the applicant for the writ is interested or by the non-performance of which he is aggrieved or injured, and when there is no other specific legal remedy."[86]

It seems, within the doctrine thus expressed, that the protestant in a public use proceeding has no "legal interest" which will give him the right to apply for mandamus to review any action of the Commissioner relative to the public use proceeding.

In the case from which this conclusion is drawn the protest was filed, the public use proceedings were instituted, and the order directing the investigation of the question of public use was subsequently set aside. The protestant applied to the Supreme Court of the District

84. Beswick v. Duell, 16 App. D. C. 345, 91 Off. Gaz. 1436.

85. Latham v. Armat, 17 App. D. C. 345, 95 Off. Gaz. 232.

86. Morris, J., in Seymour v. United States ex rel. Brodie, 10 App. D. C. 567, 79 Off. Gaz. 509; citing Legg v. Mayor of Annapolis, 42 Md. 203; Knox County v. Aspinwall, 24 How. 376, 16 L. Ed. 735; United States v. Boutwell, 17 Wall. 604, 21 L. Ed. 721; Brownsville Taxing District v. League, 129 U. S. 493, 32 L. Ed. 780; Ex parte Pennsylvania Company, 137 U. S. 451, 34 L. Ed. 738.

of Columbia for a writ of mandamus to compel the Commissioner to reinstate the public use proceedings, and to recognize the petitioner as a party in interest in the proceedings when reinstated; the writ being sought, in the latter regard, because the Commissioner had refused the request of the protestant to be furnished with a copy of the application involved. In refusing the writ, the court said:

"In order to maintain an application for a mandamus upon a public officer as to his duty, I think the authorities are very clear that he (the protestant) must have a legal interest in the matter. It must be something more than a mere commercial interest, an interest such as he avers he has, that is, that he has built some factories and invested money in machinery and buildings for the purpose of manufacturing this article, and his business would be injured by the issuance of a patent to the present applicant. He claims that although such a patent might really be worthless, and he might be entitled to show it if the patentee should ever sue him for an infringement of it, yet he would be injured, inasmuch as the issuing of the patent would cast a cloud upon his right to manufacture, and would enable the patentee to disturb and annoy him, and prevent his enjoying the profits from the manufacture of the article which he now enjoys, and which he says he is entitled to enjoy as matters now are.

"That, I am inclined to think, is not such an interest as would enable him practically to ask for an injunction, although that is not the form in which the matter stands at this time; but that is what it amounts to. He calls upon this court to command the Commissioner of Patents to assume a certain position with reference to the consideration of the matter of granting a patent to Macdonald, which practically amounts to an injunction

by this court upon the Commissioner enjoining him from proceeding in the regular consideration of the application of Macdonald for a patent. * * * The interest of the relator, such as it is, is commercial. It is not a legal interest. If the proceeding is not allowed, and if the patent should be issued, the only way in which he could be disturbed would be by a suit for infringement upon the patent; and that he has expressly, by act of Congress, the right to defend, and to interpose the matter which he now sets up as the reason for the issuing of the writ of mandamus. He would have the right to set that up as a complete defense to any action which the patentee might bring for infringement of that patent.

"That, it seems to me, gives to the relator all the remedy to which, in law, he is entitled. If he has placed himself in a position where he is liable to have some litigation, it is not a matter which, under the circumstances stated in this petition of the relator, would entitle him to the benefit and to the relief which he claims by way of mandamus."[87]

CHAPTER VI.

CONSTRUCTION OF LETTERS PATENT.

§ 96. Letters Patent are contracts.

The construction of letters patent for invention involves, in the first instance, a clear comprehension of their intrinsic character. But two of their characteristics need be alluded to by way of introduction. The right created by their issuance is a public franchise,[88] of which the letters patent are the grant.[89] Quoting from one of the leading opinions of Mr. Chief Justice Marshall, "a contract executed is one in which the object of contract is performed; and this, says Blackstone,

87. National Phonograph Co. v. Allen, Commissioner of Patents, 101 Off. Gaz. 1133, 1134.

88. Seymour v. Osborne, 78 U. S. (11 Wall.) 516, 20 L. Ed. 33.

89. Seymour v. Osborne, 78 U. S. (11 Wall.) 516, 20 L. Ed. 33.

differs in nothing from a grant."[90] Judge Sanborn has said that "A patent is a contract by which the government secures to the patentee the exclusive right to vend and use his invention for a few years, in consideration of the fact that he has perfected and described it and has granted its use to the public forever after."[91] "Letters patent may well be regarded in the light of a *quasi* contract, without disturbance of their character and object, a contract between the government and the patentee. The object of the patentee is to secure to himself complete control, the monopoly of his invention, and the use of it as a certain source of income. The object sought by the government is to obtain from the inventor a clear, definite, precise description of the invention for the public good. These constitute mutual considerations for the proposed contract evidenced in the letters patent. Therefore, the letters patent should embrace both of these objects. If either be omitted, or be so disguised in language as to be wanting in preciseness, a practical fraud is committed by the one or the other party to the contract, inasmuch as the end sought is not attained. Thus it is just and proper for the protection of the patentee, and as well for the protection of the public, that in construing the terms of the specification and claims of letters patent there would be no departure from well-established rules. Any other method would but carry with it confusion and uncertainty."[92]

§ 97. Construction of Letters Patent a question of law.

In considering the construction of letters patent the elementary rule is that their construction is for the court

90. Fletcher v. Peck, 6 Cranch 87, 136, 3 L. Ed. 328.

91. National Hollow Brake-Beam Co. v. Interchangeable Brake-Beam Co., 106 Fed. Rep. 693-701, 45 C. C. A. 544.

92. Green, J., in Celluloid Mfg. Co. v. Arlington Mfg. Co., 44 Fed. Rep. 81-84.

as a question of law.[93] The testimony of experts as to the construction of letters patent is therefore inadmissible,[94] though they may explain terms of art employed therein[95] and they may testify to facts[96] which are of controlling influence in their construction. Questions of identity are questions of fact, and the proper subject of expert testimony.[97]

§ 98. Construction not permissible when construction is not needed.

Judge Coxe has stated this doctrine in the terms of its last analysis, as follows: "Construction may be resorted to when there is something to construe; when, however, the language used can have but one meaning that meaning must be adopted no matter what the consequences may be."[98]

And speaking for the Circuit Court of Appeals of the Third Circuit, Judge Acheson has said "This is a claim for a combination. Its terms are explicit and clear. It needs no interpretation. It speaks for itself. The Court must take the claim as it finds it."[99]

§ 99. Rules of Construction.

It is a matter of great delicacy, if not of impossibility, to arrange in the order of their relative importance the canons of construction applied by the courts in the interpretation of letters patent. As in all other bodies of

93. Winans v. Denmead, 15 Howard, 330, 14 L. Ed. 717; Coupe v. Royer, 155 U. S. 565, 39 L. Ed. 263.

94. Corning v. Burden, 15 Howard, 252, 14 L. Ed. 683; Waterbury Brass Co. v. New York Brass Co., Fed. Case, No. 17,256, 3 Fisher 43.

95. Loom Co. v. Higgins, 105 U. S. 580, 26 L. Ed. 1177.

96. Marsh v. Stove Co., 51 Fed. Rep. 203.

97. Tyler v. Boston, 74 U. S. (7 Wallace) 327, 19 L. Ed. 93.

98. Safety Oiler Co. v. Scovill Mfg. Co., 110 Fed. Rep. 203-204.

99. Pittsburg Meter Co. v. Pittsburg Supply Co., 109 Fed. Rep. 644, 652, 48 C. C. A. 580.

legal rules, we find them to have great interdependence, but, in their entirety to present a symmetrical whole. It is manifest, however, that the first test to be applied to a given patent to determine its scope, is that of determining whether the inventor has contributed anything to the knowledge of mankind; whether his invention is a generous contribution to a broad and important art, a mere step forward in such an art, a substantial advance in an art of limited boundaries, or but a limited advance therein. We may therefore formulate this group of rules.

GROUP 1. *The Patent in its relation to the prior Art.*

§ 100. Rule 1. Letters patent are always construed in the light of the prior art.

According to the place they occupy in the arts to which they appertain, patents are said to be primary (or pioneer), or secondary. It is manifest that a great invention such as that of wireless telegraphy, is primary in its character. But for the purposes of construction a patent may be far from being great or of material advancement to science, and yet be "a pioneer in its limited field."[100]

The prior art to be considered includes prior inventions of the same inventor,[101] and prior foreign patents to the same inventor.[102]

It has been said by the Circuit Court of Appeals for the Eighth Circuit that "the question of infringement or non-infringement must be determined by the limitations placed upon (the) patent by the state of the art when it was issued;"[103] and, in a later case, "the claims

100. Hobbs v. Beach, 180 U. S. 383-399, 45 L. Ed. 586.

101. Celluloid Mfg. Co. v. Celonite Mfg. Co., 42 Fed. Rep. 906.

102. Durfee v. Bawo, 118 Fed. Rep. 853.

103. Sanborn, J., in Griswold v. Harker, 62 Fed. Rep. 389, 391, 10 C. C. A. 435.

and specifications of every patent must be read and construed in the light of a knowledge of the state of the art when it was issued. * * * The question of infringement or non-infringement in this case, as in every case, must be determined under this rule by the limitations placed upon the patent by the state of the art when it was issued, and by the specification and claims of the inventor."[104] In the case first quoted from, the learned court cites McCormick v. Talcott,[105] in support of the doctrine. McCormick v. Talcott has no such statement of law, and contains no facts which could support such a statement. The case involved the McCormick Reaper patents of 1845 and 1853, the latter being the reissue of an original dated 1847. The patents referred to by the Supreme Court as exhibiting the state of the art were Dobbs, English, of 1814; McCormick of 1834 and Phillips of 1841. Consequently this doctrine of the Eighth Circuit is equally without support in precedent or reason. For why should the inventor suffer by what has intervened between the filing of his application and the issuance of his patent?

On the contrary, the holdings cited are directly opposed to the established doctrine that the state of the art is to be shown as of the date of the invention.

"Evidence of the state of the art is admissible in actions at law under the general issue without a special notice, and in equity cases, without any averment in the answer touching the subject. It consists of proof of what was old and in general use at the time of the alleged invention. It is received for three purposes and none other—to show what was then old, to distinguish what

104. P. H. Murphy Mfg. Co. v. Excelsior Car Roof Co., 76 Fed. Rep. 965, 972, 22 C. C. A. 658.

105. McCormick v. Talcott, 61 U. S. (20 Howard) 402, 405, 15 L. Ed. 930.

was new, and to aid the Court in the construction of the patent."[106]

§ 101. The interpretation of patents according to their position in the arts.

There is no hard and fast classification of letters patent based upon the value of their contributions to public knowledge. The fundamental rule is that pioneer patents are liberally construed; and what is meant by "pioneer" is thus defined by Judge Colt: "Where a patent represents a marked advance in the art (for example, where an inventor for the first time accomplishes a certain result by organizing several groups of instrumentalities into a single automatic machine, as in the Morley patent for sewing shank buttons to a fabric, or in the Reece patent for a buttonhole sewing machine), such a patent is called a 'pioneer;' and the courts, in its construction, have adopted a liberal rule with respect to equivalents."[107]

As to patents whose contribution to science is the minimum that will support a patent as valid, Judge Sanborn has said, "one who merely makes and secures a patent for a slight improvement on an old device or combination, which performs the same function before as after the improvement, is protected against those only who use the very device or improvement he describes and claims, or mere colorable evasions of it."[108]

106. Mr. Justice Swayne in Brown v. Piper, 91 U. S. 37, 23 L. Ed. 200.

107. Ford v. Bancroft, 39 C. C. A. 91, 98 Fed. Rep. 309, 312; the illustrations refer to Morley Machine Co. v. Lancaster, 129 U. S. 263, 32 L. Ed. 715; Reece Buttonhole Machine Co. v. Globe Buttonhole Mach. Co., 61 Fed. Rep. 958, 10 C. C. A. 194.

108. Brammer v. Schroeder, 46 C. C. A. 41, 106 Fed. Rep. 918, 920; citing Adams Electric Ry. Co. v. Lindell Ry. Co., 77 Fed. Rep. 432, 440, 23 C. C. A. 223, 231; Stirrat v. Excelsior Mfg. Co., 61 Fed. Rep. 980, 981, 10 C. C. A. 216, 217; McCormick v. Talcott, 20 How. 402, 405, 15 L. Ed. 930; Chicago & N. W. Ry. Co. v. Sayles, 97 U. S. 554, 556, 24 L. Ed. 1053.

But what of those patents that are within neither of these classes? There are necessarily many which are of considerable, many of very substantial, advancement to their arts which are entitled to an expanding range of equivalency according to their standing in those arts. This is the established rule. In speaking of a sewing-machine patent, Judge Van Devanter has said, "we regard it as neither primary nor a slight improvement on the prior art, but as possessing enough of patentable novelty to command a reasonable range of equivalents."[109] The Supreme Court has also recognized the rule as to classifying patents for the purpose of determining the range of equivalency to which they are entitled. Mr. Justice Jackson said, "the range of equivalents depends upon the extent and nature of the invention."[110]

§ 102. Rule II. The patentee is bound by a statement as to the prior art in his specification.

"The patent is, as is well said by counsel for defendant in their brief, the title deed through which the complainant must derive all his rights. It is the grant of a monopoly, and, with rare exceptions, every statement of the prior state of the art therein contained bears upon the construction, and is a limitation of the grant. The description in the specification of the existing art, and of the applicant's improvements, form the representations upon which he obtains the grant. Having done so, he is estopped to say that his representations were incorrect. If the recitals of the state of the art do

109. Lewis Blind Stitch Mach. Co. v. Premium Mfg. Co., 90 C. C. A. 310, 163 Fed. Rep. 950, 954. To the same effect, see, St. Louis Car Coupler Co. v. National Malleable Castings Co., 87 Fed. Rep. 885, 901, 31 C. C. A. 265.

110. Miller v. Eagle Mfg. Co., 151 U. S. 186, 207, 38 L. Ed. 121, 131.

not tend to limit, explain, or nullify the grant, they are of no possible pertinence, even if the same facts were fully proved *aliunde*. If, on the other hand, they do have such tendency, the patentee is bound thereby, and the patent must be construed in the light of the facts so recited."[111]

§ 103. Rule III. Patents of a primary character are liberally construed.

"Where an invention is one of a primary character and the mechanical functions performed by the machine are, as a whole, entirely new, all subsequent machines which employ substantially the same means to accomplish the same result are infringements, although the subsequent machine may contain improvements in the separate mechanisms which go to make up the machine."[112] "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."[113]

"The more meritorious the invention, the greater the step in the art, the less the suggestion of the improvement in the prior art, the more liberal are the courts in applying in favor of the patentee the doctrine of equivalents. The narrower the line between the faculty exercised in inventing a device and mechanical skill, the stricter are the courts in rejecting the claim of equivalents by the patentee in respect of alleged infringements."[114]

111. Sage, J., in Heaton Penin-sular Button Fastener Co. v. Schlochtmeyer, 69 F. R. 592, 596.

112. Morley Sewing Machine Co. v. Lancaster, 129 U. S. 263-273, 32 L. Ed. 715; Hobbs v. Beach, 180 U. S. 383-401, 45 L. Ed. 587.

113. Chicago & N. W. Railway Co. v. Sayles, 97 U. S. 554-556, 24 L. Ed. 1053.

114. Taft, J., in Penfield v. Chambers Bros. Co., 92 Fed. Rep. 630-649, 34 C. C. A. 579.

§ 104. Rule IV. Patents of a secondary character receive a close construction.

"If the advance toward the thing desired is gradual, and proceeds step by step, so that no one can claim the complete whole, then each (inventor) is entitled only to the specific form of device which he produces, and every other inventor is entitled to his own specific form, so long as it differs from those of his competitors, and does not include theirs."[115]

This rule might be termed one of necessity. With the progress of the arts the patent field becomes so thoroughly tilled that its rewards must become steadily less to the inventor. Yet the language quoted is not strictly adhered to. Even among patents which are not basic or pioneer in character there are enormous differences of scope and contribution to the arts in which they lie. The range of equivalency must be adjusted to respond to the merit of the patent in its art.

GROUP 2. *The patent in the light of other extrinsic limitations of its scope.*

§ 105. Rule V. The law in force when the patent is granted is the law by which its validity must be tested.[116]

Special statutory grants of patents must be construed in the light of the general patent statutes.[117]

In the case of a reissue, "the second patent being a continuation of the first one, the rights of the plaintiff must be ascertained by the law under which the original application was made."[118]

115. Chicago & N. W. Railway Co. v. Sayles, 97 U. S. 554-557, 24 L. Ed. 1053.

116. McClurg v. Kingsland, 1 Howard 202-206, 11 L. Ed. 102.

117. Evans v. Eaton, 3 Wheaton 454, 5 L. Ed. 472; Bloomer v. McQuewan, 14 Howard 539, 14 L. Ed. 532.

118. Mr. Justice McLean, in Shaw v. Cooper, 7 Peters 292, 315, 8 L. Ed. 689.

§ 106. Rule VI. Self-imposed limitations contained in the claims cannot be disregarded.

This rule would seem to be self-evident. The claim being the measure of the rights of the patentee, its limitations are the limitations of his rights. As stated by Judge Townsend, "No principle has been more firmly established and consistently applied, in the Federal courts of last resort, than that the patent must be construed in conformity with the self-imposed limitations contained in the claims. The application of this principle of construction may be invoked in support of the validity of the patent as well as in denial of infringement."[119]

The rule as announced by the Supreme Court is, that "if the language of the specification and claim shows clearly what he (the patentee) desired to secure as a monopoly, nothing can be held to be an infringement which does not fall within the terms the patentee has himself chosen to express his invention."[120]

This rule should not be disregarded, even in the case of a primary or pioneer invention.[121]

§ 107. Rule VII. The patent must be construed in the light of the limitations imposed by the patent office as a condition of the grant.[122]

"If a patentee acquiesces in the rejection of his claim on references cited in the Patent Office, and accepts a patent on an amended claim, he is thereby estopped from

119. Matheson v. Campbell, 69 Fed. Rep. 597, 607; citing Groth v. International Postal Supply Co., 61 Fed. Rep. 284, 9 C. C. A. 507; McClain v. Ortmayer, 141 U. S. 419, 35 L. Ed. 800; Philadelphia Novelty Mfg. Co. v. Weeks, 61 Fed. Rep. 405, 9 C. C. A. 555.

120. Mr. Justice Brown, in McClain v. Ortmayer, 141 U. S. 419, 35 L. Ed. 800.

121. Groth v. International Postal Supply Co., 61 Fed. Rep. 284, 287, 9 C. C. A. 507.

122. Shaw Stocking Co. v. Pearson, 48 Fed. Rep. 234-236.

maintaining that the amended claim covers the combinations shown in the references, and from claiming that it has the breadth of the claim that was rejected." [123] When the practice of the Patent Office was to make references to and deny patents on rejected applications, a patentee who amended his claim upon reference to a device contained in such a rejected application was held estopped to claim the device in question to be an infringement of his amended claim, even though the citation was erroneously made by the Patent Office.[124]

But the estoppel is limited to the devices shown in the references, and covered by the claim before amendment. "One who acquiesces in the rejection of his claim because it is said to be anticipated by other patents or references is not thereby estopped from claiming and securing by an amended claim every known and useful improvement which he has invented that is not disclosed by those references." [125]

"In patents for combinations of mechanism, limitations and provisos, imposed by the inventor, especially such as were introduced into an application after it had been persistently rejected, must be strictly construed against the inventor and in favor of the public, and looked upon in the nature of disclaimers." [126] A claim

123. National Hollow Brake-Beam Co. v. Interchangeable Brake-Beam Co., 106 Fed. Rep. 693-714, 45 C. C. A. 544. To the same effect, see Crawford v. Heysinger, 123 U. S. 589, 31 L. Ed. 269; Roemer v. Peddie, 132 U. S. 313, 317, 33 L. Ed. 382; Knapp v. Morss, 150 U. S. 221, 37 L. Ed. 1059; Morgan Envelope Co. v. Albany Perforated Wrapping Paper Co., 152 U. S. 425-429, 38 L. Ed. 500; Lehigh Valley Railroad Co. v. Kearney, 158 U. S. 461, 469, 39 L. Ed. 1055; Hubbell v. United States, 179 U. S. 77-83, 45 L. Ed. 95.

124. Lapham Dodge Co. v. Severin, 40 Fed. Rep. 762-764.

125. National Hollow Brake-Beam Co. v. Interchangeable Brake-Beam Co., 106 Fed. Rep. 693-714, 45 C. C. A. 544.

126. Sargeant v. Hall Safe Lock Co., 114 U. S. 63, 29 L. Ed. 67; Hubbell v. United States, 179 U. S. 77-82, 45 L. Ed. 95.

so modified cannot be construed to be as broad as before its enforced modification;[127] and this rule obtains though the applicant made the amendment under protest, undertaking to seek such broadened construction after issue.[128]

§ 108. Rule VIII. Amendments made to meet the objections of the patent examiner are not to be construed to disclaim the patentee's actual invention, if such construction can be avoided without doing violence to the obvious meaning of the language employed.[129]

The mere statement of the patentee's solicitor of reasons why two claims should be included in one patent does not estop the patentee from claiming what was clearly granted in the patent,[130] and, generally speaking, language of the applicant's solicitor in addressing the Patent Office, which does not lead to change in the wording of the application, will not prevail to alter or modify the unambiguous language of the patent.[131]

This rule is substantially a limitation upon the rule next preceding. The principal rule is an application of the broad doctrine of estoppel; the limitation arises from the equitable doctrine that "an estoppel is not to be implied from circumstances of doubtful import."[132]

127. Phoenix Castor Co. v. Spiegel, 133 U. S. 360, 33 L. Ed. 663; Williams v. Goodyear Metallic Rubber Shoe Co., 49 Fed. Rep. 245.

128. Thomas v. Rocker Spring Co., 77 Fed. Rep. 420, 23 C. C. A. 211.

129. Westinghouse v. Boyden Power-Brake Co., 66 Fed. Rep. 997-1006.

130. Britton v. White Mfg. Co., 61 Fed. Rep. 93-95.

131. Wirt v. Brown, 32 Fed. Rep. 283-286.

132. Acheson, J., in Societe Anonyme Usine J. Cleret v. Rehfuss, 75 Fed. Rep. 657-661; quoted and followed in Diamond Drill & Machine Co. v. Kelly Bros. 120 Fed. Rep. 282-286.

GROUP 3. *Letters patent construed according to their terms.*

§ 109. Rule IX. A patent is to be interpreted by its own terms.[133]

Inasmuch as the inventor is bound by his claims, and matter described but not claimed is presumed to be *publici juris*,[134] the construction of letters patent depends upon the construction of their claims.[135] "If a claim is not properly described in a patent, the claim is of no validity." [136]

"The terms employed to describe an invention are to be interpreted with reference to the art to which it relates, and what a mechanic skilled in the art would be able to do with it." [137]

§ 110. Rule X. Patents are to receive a liberal construction, and under the fair application of the rule, ut res magis valeat quam pereat,[138] are, if practicable, to be so interpreted as to uphold and not to destroy the patent.[139]

Accordingly, "limitations in the terms of the claim do not import any limitation in the construction of the claim, in cases where such limitation is not imposed by

133. Goodyear Dental Vulcanite Co. v. Davis, 102 U. S. 222-227, 26 L. Ed. 149.

134. Blades v. Rand McNally & Co., 37 Fed. Rep. 93; Roemer v. Peddle, 27 Fed. Rep. 702; Allison v. Brooklyn Bridge, 29 Fed. Rep. 517; McBride v. Grand Plow Co., 44 Fed. Rep. 74; Maddock v. Coxon, 45 Fed. Rep. 578; Thomson-Houston Elec. Co. v. Elmira Ry. Co., 71 Fed. Rep. 404; Monroe v. McGreer, 81 Fed. Rep. 956; Lehigh Valley R. R. Co. v. Mellon, 104 U. S. 112, 26 L. Ed. 639.

135. Maddock v. Coxon, 45 Fed. Rep. 578.

136. Knowles, J., in Pacific Cable Ry. Co. v. Butte City St. Ry. Co., 58 Fed. Rep. 420-424.

137. Archbald, J., in Daylight Prism Co. v. Marcus Prism Co., 110 Fed. Rep. 980-984.

138. "That the thing may rather have effect than to be destroyed." Bouvier Dict. Title "Maxims."

139. Turrill v. Railroad Co., 1 Wall. 491-510, 17 L. Ed. 668; Ballard v. McCluskey, 58 Fed. Rep. 880-883.

the state of the art."[140] "This principle is not to be carried so far as to exclude what is in it (the patent), or to interpolate anything which it does not contain. But liberality, rather than strictness, should prevail where the fate of the patent is involved, and the question to be decided is whether the inventor shall hold or lose the fruits of his genius and his labors."[141]

"It is manifest that where two interpretations are possible, that one should be chosen which upholds the patent."[142]

"The duty of the court is to so construe claims as, without doing violence to the language used, to give the patentee what he has actually invented. In other words, 'to make the claim commensurate with the invention.' "[143]

The rule here under consideration is what has been styled by the English Courts and text writers as the doctrine of "Benevolent Interpretation." It has been the subject of frequent consideration in the English Courts. The late Sir George Jessel said of this doctrine:

> "I am anxious, as I believe every judge is who knows anything of patent law, to support honest *bona fide* inventors who have actually invented something novel and useful, and to prevent their patents being overturned on mere technical objections or on mere cavillings with the language of their specifications, so as to deprive the inventor of the benefit of his invention; that is sometimes called a benevolent

140. Carpenter, J., in Sacks v. Brooks, 74 Fed. Rep. 935.

141. Woolson, J., in McBride v. Kingman, 72 Fed. Rep. 908, 911; following Rubber Co. v. Goodyear, 76 U. S. (9 Wall.) 788, 19 L. Ed. 566.

142. Coxe, J., in Consolidated Fastener Co. v. Columbian Fastener Co., 79 Fed. Rep. 797.

143. Kirkpatrick, J., in Huntington Dry Pulverizer Co. v. Whittaker Cement Co., 89 Fed. Rep. 323, 326; citing, Ransom v. New York, 1 Fisher 252, Fed. Cas. No. 11,573.

mode of construction; perhaps that is not the best term to use, but it may be described as construing the language of the specification fairly, with a judicial anxiety to support a really useful invention, if it can be supported by a reasonable construction of a patent; beyond that the benevolent mode of construction does not go." [144]

The expression was criticised by Lindley, L. J., as follows:

"I do not like the expression 'benevolent interpretation.' I do not believe in it. The question is whether a given construction is the true construction; but, of course, if any patent is capable of more constructions than one, the general rule would be applied that you would put upon it that construction which makes it a valid patent rather than a construction which renders it invalid." [145]

Lord Esher referred to the rule in explicit terms as follows:

"I am clearly of opinion that, whether the patent be a pioneer patent, or a master patent, or a patent of the first invention, or whether it be a valuable patent or a patent for the smallest thing, or whether it be a patent for an improvement, or whatever the patent may be, the canons of construction of the patent are precisely the same. What is more, I am further of opinion that the canons of construction of a patent are the same canons of construction that are to be applied to *every written instrument* which has to be construed by the Court." [146]

144. Hinks v. The Safety Lighting Co., 1876, L. R. 4 C. D. 612.

145. Needham v. Johnson, 1884, 1 P. O. R. 58.

146. Nobel's Explosive Co. v. Anderson, 1894, 11 P. O. R. 523.

§ 111. Rule XI. The whole instrument is to be construed together,[147] for the purpose of ascertaining the meaning of the whole and of every part.[148]

In reference to the application of this rule, an examination of the cases discloses that there are two classes of defective claims.

First, claims which are so deficient in themselves that they cannot be made good from other parts of the patent.

"A claim clearly deficient of itself cannot be made good from other parts of the patent."[149]

A claim "ought not to be enlarged beyond the fair interpretation of its terms."[150]

"We may go to the description to amplify a claim, but we cannot, out of the mere descriptive portion of the patent, wholly create a claim."[151]

Second, claims in which a defect evidently exists, but where it is plain that the claim assumes the existence of the missing elements, and recourse may be had to the descriptive portion of the specification to cure the defect.

Judge Putnam has referred to claims of this character as "that class where reference may be made to the specifications to supply in a claim what it is plain to every one the claim assumes as existing."[152]

147. Brooks v. Fiske, 15 Howard, 212-215, 14 L. Ed. 665.

148. Holly v. Vergennes Machine Co., 4 Fed. Rep. 74-77.

149. Putnam, J., in Burnham & Duggan Railway Appliance Co. v. Naumkeag St. Ry. Co., 57 Fed. Rep. 651.

150. Mr. Chief Justice Fuller, in Day v. Fair Haven & Westville R. Co., 132 U. S. 98, 102, 33 L. Ed., 265, 267.

151. Grosscup, J., in General Fire Extinguisher Co. v. Mallers, 110 Fed. Rep. 529, 537, 49 C. C. A. 138.

152. Burnham & Duggan Railway Appliance Co. v. Naumkeag St. Ry. Co., 57 Fed. Rep. 651.

This has been styled by Judge Severens "the beneficent rule of construction—that the claims should be construed by the specifications, and that if, looking at both, the Court is able to understand the meaning of the patentee in the language of his claims, and, as so understood, the combination is a practicable one, it will give effect to them according to the apparent purpose."[153]

§ 112. Rule XII. Devices expressly disclaimed in the specification limit the construction of the patent, and are considered part of the prior art.[154]

This rule, however, is not inexorable. The more liberal application of it has been thus stated. "Everything in the specifications which must be resorted to by the court in construing the claims might be considered as part of the complainant's pleadings. But all portions which merely set out the state of the art, like recitals of facts in contracts or other instruments, are more or less conclusive on the party who sets them up, yet in the eyes of the law explainable, and not absolutely presumed to have been so alleged as to become the subject of demurrer. Especially must this be so with specifications in patents, in which many statements are necessarily complex, relate to unfamiliar topics, and are not easily understood without extrinsic evidence. It is true that, so far as the specifications contain any misrepresentations which, if erroneous, may be presumed to have mis-

153. Soehner v. Favorite Stove & Range Co., 28 C. C. A. 317, 84 Fed. Rep. 182, 185; citing Blanchard v. Sprague, 3 Sumn. 534, Fed. Cas. 1518; Ryan v. Goodwin, 3 Sumn. 514, Fed. Cas. 12,186; Blandy v. Griffith, 3 Fish. Pat. Cas. 609, Fed. Cas. 1529; Roller-Mill Co. v. Coombs, 39 Fed. Rep. 25; Turrill v. Railroad, 1 Wall. 491, 17 L. Ed. 668; Klein v. Russell, 19 Wall. 433, 466, 22 L. Ed. 116.

154. Lyons v. Drucker, 106 Fed. Rep. 416-418; Heaton Peninsular Button-Fastener Co. v. Schlochtermeyer, 69 Fed. Rep. 592-596; affirmed, 72 Fed. Rep. 520, 18 C. C. A. 674.

led the Patent Office to the detriment of the public, the patentee may be estopped. On the other hand, I do not understand the law has gone so far as to forfeit a valuable patent because the patentee has inaptly, or somewhat inaccurately, described the state of the art, or that it conclusively prohibits him from showing such inaptitude or inaccuracy, if it also appears that the public has not been prejudiced thereby."[155]

§ 113. **Rule XIII. "Nothing described in letters patent is secured to the patentee unless there be in the letters a valid claim covering it."[156]**

"Hence the proper and legal construction of letters patent depends, necessarily, upon the construction of the claims made in them. And it follows that the claim thus becomes the sole criterion, so far as the rights of the patentee are concerned, and by it must be tested the extent and scope of the grant which the letters evidence."[157]

The function of the claim has been discussed elsewhere. The claim has been tersely and accurately defined by Judge Woolson to be "the measure of plaintiff's rights under his letters,"[158] and the Supreme Court has held that the claim is prescribed by the statute "for the very purpose of making the patentee define precisely what his invention is."[159]

Conversely, if the invention is broader than the claim, the patentee is "held to have surrendered the surplus to the public."[160] Thus a patent may describe both a

155. Putnam, J., in Indurated Fibre Industries Co. v. Grace, 52 Fed. Rep. 124, 128.

156. Green, J., in Maddock v. Coxon, 45 Fed. Rep. 578-579.

157. Ibid.

158. Monroe v. McGreer, 81 Fed. Rep. 954, 956.

159. Mr. Justice Bradley, in White v. Dunbar, 119 U. S. 47, 30 L. Ed. 303. Quoted and followed in Stirling Co. v. Pierpoint Boiler Co., 72 Fed. Rep. 780, 788.

160. Mr. Justice Bradley, in Keystone Bridge Co. v. Phoenix Iron Co., 95 U. S. 274, 278, 24 L.

new article of manufacture and a new composition of matter. If the article of manufacture only is claimed, the composition of matter is dedicated to the public.[161]

§ 114. Rule XIV. "If a claim is not properly described in a patent, the claim is of no validity." [162]

The meaning of this rule is that an entire absence of description will invalidate the claim. As Judge Shipman has said: "There must be a written description of the invention. A description, which is said to be vague and uncertain, may be made clear by the drawings, which are a part of the specification. An imperfect written description will be aided by corrrect drawings, but when the written description is not only silent in regard to a feature of the invention, but places the novelty upon a different and described feature, the drawings will not help an entire omission, because the necessity of a written description is made absolute by the statute." [163]

§ 115. Rule XV. A claim may be limited [164] **but can never be enlarged, by reference to the description** [165] **or drawings.**[166]

Ed. 344, 346, and this doctrine has been affirmed in Norton v. Haight, 22 Fed. Rep. 787; National Progress Bunching-Machine Co. v. John R. Williams Co., 44 Fed. Rep. 190, 194, 12 L. R. A. 107; McCormick v. Talcott, 20 How. 402, 15 L. Ed. 930; Seymour v. Osborne, 11 Wall. 546, 20 L. Ed. 33; The Corn-Planter Patent, 23 Wall. 181, 23 L. Ed. 161; Fay v. Cordesman, 109 U. S. 408, 27 L. Ed. 979; Shepard v. Carrigan, 116 U. S. 593, 29 L. Ed. 723; White v. Dunbar, 119 U. S. 47, 30 L. Ed. 303; Sutter v. Robinson, 119 U. S. 530, 30 L. Ed. 492; Snow v. Lake Shore & M. S. R. Co., 121 U. S. 617, 30 L. Ed. 1004.

161. Underwood v. Gerber, 149 U. S. 224, 37 L. Ed. 710.

162. Knowles, J., in Pacific Cable Ry. Co. v. Butte City St. Ry. Co., 58 Fed. Rep. 420-424.

163. Gunn v. Savage, 30 Fed. Rep. 366, 369.

164. McClain v. Ortmayer, 141 U. S. 419, 35 L. Ed. 800.

165. Lehigh Valley Railroad Co. v. Mellon, 104 U. S. 112, 26 L. Ed. 639; McClain v. Ortmayer, 141 U. S. 419, 35 L. Ed. 800.

166. Howe Machine Co. v. National Needle Co., 134 U. S. 388, 33 L. Ed. 963.

In the language of Mr. Justice Brown: "The object of the patent law in requiring the patentee to 'particularly point out and distinctly claim the part, improvement or combination which he claims as his invention or discovery,' is not only to secure to him all to which he is entitled, but to apprise the public of what is still open to them. The claim is the measure of his right to relief, and while the specification may be referred to to limit the claim, it can never be made available to expand it." [167]

§ 116. Rule XVI. Construction cannot be employed to relieve the patentee from the consequences of self-imposed limitations.[168]

But "limitations in the terms of the claim do not import any limitation in the construction of the claim, in cases where such limitation is not imposed by the state of the art." [169]

§ 117. Rule XVII. A construction which would make two distinct claims of a patent identical, will be avoided if possible.[170]

"The effort should be, in the construction of the letters, to ascribe a purpose to each claim, and to avoid a construction that would deprive a claim of a distinct purpose." [171]

167. McClain v. Ortmayer, supra. To the same effect, see, Keystone Bridge Co. v. Phoenix Iron Co., 95 U. S. 274, 24 L. Ed. 344; Corrington v. Westinghouse Air Brake Co., 173 Fed. Rep. 69, 77.

168. Lewis v. Pennsylvania Steel Co., 59 Fed. Rep. 129-131; Merrill v. Yeomans, 94 U. S. 568, 24 L. Ed. 235; Lehigh Valley Railroad Co. v. Mellon, 104 U. S. 117, 35 L. Ed. 800; Smead Warming & Ventilating Co. v. Fuller & Warren Co., 57 Fed. Rep. 626-630.

169. Carpenter, J., in Sacks v. Brooks, 74 Fed. Rep. 935, 936.

170. Tondeur v. Stewart, 28 Fed. Rep. 561; Page Woven Wire Fence Co. v. Land, 49 Fed. Rep. 936-942.

171. Thomas, J., in Thomson-Houston Electric Co. v. Nassau Electric R Co., 110 Fed. Rep. 647, 648.

§ 118. Rule XVIII. Reference letters and numerals employed in the claim do not restrict the inventor beyond the limitations imposed by the state of the art.[172]

As to this principle, Judge Carpenter has said: "Inasmuch as the claim is not limited by the prior state of the art, I do not think it should be limited by the fact of references by letters to the specific mechanism shown in the patent. A limitation is not to be inferred from any words in the patent in cases where, from a consideration of the whole patent, taken in connection with the state of the art, the actual invention appears to transcend such limitation."[173]

Where, however, the state of the art is such that the claim, if sustained, must be limited to the precise construction shown, it will be restricted to the specific parts shown in the drawings and imparted to the claim by the reference numerals or letters.[174]

172. Reed v. Chase, 25 Fed. Rep. 94; Delamater v. Heath, 58 Fed. Rep. 414, 7 C. C. A. 279; Campbell Printing Press & Mfg. Co. v. Marden, 64 Fed. Rep. 782; McCormick Harvesting Machine Co. v. Aultman, 69 Fed. Rep. 371, 393, 16 C. C. A. 259; Muller v. Tool Co., 77 Fed. Rep. 621, 23 C. C. A. 357; Sprinkler Co. v. Koehler, 82 Fed. Rep. 428-431, 27 C. C. A. 200; Ross Mfg. Co. v Randall, 104 Fed. Rep. 355, 43 C. C. A. 578; National Brake-Beam Co. v. Interchangeable Brake-Beam Co., 106 Fed. Rep. 715, 45 C. C. A. 544; Weir v. Morden, 125 U. S. 98, 31 L. Ed. 645; Hendy v. Miners' Iron Works, 127 U. S. 370, 32 L. Ed. 207; Lehigh Valley R. R. v. Kearney, 158 U. S. 461, 469, 39 L. Ed. 1055. "It was substantially held in that (the last named) case that, if a patentee acquiesces in the limitations suggested by the Patent Office and the essential elements of the claim are alluded to by reference letters indicating that the Patent Office intended to restrict the claim to the particular device described, a claim to a broader scope cannot be maintained." Hazel, J., in Good Form Mfg. Co. v. White, 153 Fed. Rep. 759, 761.

173. Campbell Printing Press & Mfg. Co. v. Marden, 64 Fed. Rep. 782-785.

174. Knapp v. Morss, 150 U. S. 221-228, 37 L. Ed. 1059-1062.

Judge Archbald, speaking of this rule, has said:

"But the use of a reference letter in this way does not necessarily limit the inventor to the exact form or configuration of parts which is thus portrayed and described, without regard to possible equivalents thereto. It may or may not, according to circumstances, as the authorities abundantly show. * * * It is after all a matter of construction, in which, while a reference by letters to the drawings and specifications may be regarded, as a rule, as involving a greater particularity of description, than without, the real scope of the invention is nevertheless to be considered and given due weight. No doubt there are cases where, by reason of the limitations imposed by the prior art, it is necessary in order to distinguish and save the invention, to confine it to a certain form or arrangement of parts, which the use of reference letters may effectively serve to do. But where no such necessity exists, a patent is to be taken as a whole and effect given to the invention as it is there disclosed and claimed, in which the reference to the drawings merely goes in with the rest." [175]

§ 119. Rule XIX. Each claim is a patent of itself.

"Each claim of the patent standing by itself, is a separate patent for the device covered by the claim." [176]

175. Archbald, J., in Kelsey Heating Co. v. James Spear Stove & H. Co., 155 Fed. Rep. 976-980.

176. Blodgett, J., in Pope Mfg. Co. v. Gormully & Jeffrey Mfg. Co., 34 Fed. Rep. 893-894. To the same effect, see, United Nickel Co. v. California Elec. Works, 25 Fed. Rep. 475, 479; 11 Sawyer 250, Celluloid Mfg. Co. v. Zylonite Brush & Comb Co., 27 Fed. Rep. 291, 294, 35 Off. Gaz. 1228.

Accordingly, a right to use one claim of a patent containing a plurality of claims, is no defense to a charge of infringement based upon other claims of the same patent.[177]

This rule has seemed to the author a sufficient answer to many of the requirements for division of applications made by the Patent Office (*ante*, § 76).

Under the operation of this rule, the invalidity of one claim of a patent having more than one, does not affect the other claims nor impair the validity of the patent.[178]

§ 120. **Rule XX.** **"Where a claim is fairly susceptible of two constructions, that one will be adopted which will preserve to the patentee his actual invention."**[179]

This rule is a necessary incident of the doctrine of benevolent interpretation, considered under Rule X, *ante*.[180] It is only to be invoked where there is an actual ambiguity, and cannot be applied where the language of the patent is clear in its terms. In announcing the rule, Mr. Justice Brown said that "if the language of the specification and claims show clearly what he (the inventor) desired to secure as a monopoly, nothing can be held to be an infringement which does not fall within the terms the patentee has himself chosen to express his invention."[181]

177. United Nickel Co. v. California Elec. Works, 25 Fed. Rep. 475, 479.

178. Carlton v. Bokee, 17 Wall. 463, 21 L. Ed. 517.

179. Mr. Justice Brown, in McClain v. Ortmayer, 141 U. S. 419, 425, 35 L. Ed. 800, 802.

And, see, Mesick v. Moore, 100 Fed. Rep. 845, 846, where the rule of McClain v. Ortmayer is distinguished from cases where the claim is clearly restricted by the language employed.

180. § 110.

181. McClain v. Ortmayer, supra.

§ 121. **Rule XXI. A missing element may be read into a claim from the description and drawings for the purpose of showing the connection in which the device of the claim is used, and proving that it is an operative device.**[182]

"We may go to the description to amplify a claim, but we cannot, out of the mere descriptive portion of the patent, wholly create a claim."[183]

§ 122. **Rule XXII. A missing element cannot be read into a claim from the description and drawings for the purpose of limiting its scope, so that it may be accorded novelty,**[184] **or to subject another to the charge of infringement.**[185]

"It is enough that the patentee did not so word the claim and it is beyond the province of the court to rewrite it."[186] "They (the patentees) cannot expect the courts to wade through the history of the art, and spell out what they might have claimed, but have not claimed. * * * But the courts have no right to enlarge a patent beyond the scope of its claim as allowed by the Patent Office. * * * As patents are procured *ex parte*, the public is not bound by them, but the patentees are. And the latter cannot show that their invention is broader than the terms of their claim, or, if broader, they must be held to have surrendered the surplus to the public."[187] In these terms, and for these reasons, the doc-

182. McCarty v. Lehigh Valley R. Co., 160 U. S. 110-116, 40 L. Ed. 358-361.

183. Grosscup, J., in General Fire Extinguisher Co. v. Mallers, 110 Fed. Rep. 529-537, 49 C. C. A. 138.

184. Frederick R. Stearns & Co. v. Russell, 29 C. C. A. 121, 85 Fed. Rep. 218-224.

185. Metallic Extraction Co. v. Brown, 49 C. C. A. 147, 110 Fed. Rep. 665-668; Wilson v. McCormick Harvesting Machine Co., 34 C. C. A. 280, 92 Fed. Rep. 167-174; McCarty v. Lehigh Valley R. Co., 160 U. S. 110-116, 40 L. Ed. 358-361.

186. Universal Brush Co. v. Sonn, 83 C. C. A. 422, 154 Fed. Rep. 665, 669.

187. Mr. Justice Bradley, in Keystone Bridge Co. v. Phoenix Iron Co., 95 U. S. 274, 278, 24 L. Ed. 344, 346.

trine of the rule under consideration has been definitely established.

§ 123. Rule XXIII. "Where a specification by ambiguity and a needless multiplication of nebulous claims is calculated to deceive and mislead the public, the patent is void."[188]

This rule was voiced by Mr. Justice Bradley at the conclusion of a vigorous condemnation "of these ingenious attempts to expand a simple invention of a distinct device into an all-embracing claim, calculated by its wide generalizations and ambiguous language to discourage further invention in the same department of industry and to cover antecedent inventions."[189]

In the same opinion it is announced that "one void claim * * * does not vitiate the entire patent, if made by mistake or inadvertence and without any willful default or intent to defraud or mislead the public."[190]

In its practical application, this rule—itself somewhat ambiguous and nebulous—appears merely to condemn claims of excessive breadth, embodying what Judge Brown has termed "a vague generality which makes them a constant menace to all inventors who may seek to improve the art."[191] In his own condemnation of claims of this character, Judge Brown says: "It is a familiar rule that a generalization or definition that is too broad cannot be made good by making an arbitrary

188. Mr. Justice Bradley, in Carlton v. Bokee, 17 Wall. 463, 21 Law Ed. 517, 2 Whit. 456, 6 Fish. 40, 2 O. G. 520; 9 Brodix 91.

189. Ibid.

190. Ibid. To the same effect see, Smith v. Merriam, 6 Fed. Rep. 718; Wood v. Packer, 17 Fed. Rep. 651.

191. American Bell Tel. Co. v. National Tel. Mfg. Co., 109 Fed. Rep. 976, 996. To the same effect, see, Matheson v. Campbell, 78 Fed. Rep. 910, 24 C. C. A. 284.

exception of each case that comes within its terms, but which should not have been included. A single contrary example destroys the generalization.'' [192]

§ 124. Rule XXIV. Letters patent must be construed according to their terms even though such construction renders them valueless.

"In short, I am convinced that any man, however skilled, who should undertake to practice the patented process, would necessarily be led, by its terms, to take the view of it which was urged upon the patent office by the solicitor of the patentee, viz., that it 'involves the subjection of the rubber waste to boiling in a strong un- diluted commercial acid;' and that, therefore, the use of acid and water would be a material departure from it. It is objected to this construction of the patents that it renders them valueless, and the invention as claimed, impracticable; but as no other construction can, in my opinion, be reasonably put upon them, any consequence which results, however serious, must be regarded as unavoidable. As 'the language of the specification and claim shows clearly what he desired to secure as a monopoly, nothing can be held to be an infringement which does not fall within the terms the patentee has himself chosen to express his invention.' '' [193]

192. American Bell Tel. Co. v. National Tel. Mfg. Co., supra, at p. 994. To the same effect, see, Electric Smelting & Aluminum Co. v. Pittsburg Reduction Co., 111 Fed. Rep. 742, 759.

193. Dallas, J., in Chemical Rubber Co. v. Raymond Rubber Co., 68 Fed. Rep. 570, 574; citing McClain v. Ortmayer, 141 U. S. 419, 425, 35 L. Ed. 800.

§ 125. **Rule XXV. "Form, location and sequence of elements are all immaterial, unless form or location or sequence is essential to the result, or indispensable, by reason of the state of the art, to the novelty of the claim."** [194]

This rule is so intimately connected with the others under consideration that its reasoning is apparent. The reversal of parts, the transposition of parts, or in process cases the reversal or transposition of the steps of the process, are the common artifices of the infringer. Where this displacement of parts or steps, or any other change, does not accomplish a new result, or the old result in a more advantageous way, the doctrine of the rule is applicable.

§ 126. **Rule XXVI. An element will not be imported from one claim into another claim, merely for the purpose of sustaining the latter claim, and subjecting another to the charge of infringement.**

"In the absence of words which do clearly indicate such a purpose, we are not disposed to import into the claim a feature of construction already protected by another claim, merely for the purpose of sustaining the claim, and subjecting another to the charge of infringement. Such a method of construing the claims of a patent has often been condemned." [195]

194. Baker, J., in Adam v. Folger, 120 Fed. Rep. 260, 263, 56 C. C. A. 540; citing Winans v. Denmead, 15 How. 330, 14 L. Ed. 717; Reece Buttonhole Mach. Co. v. Globe Buttonhole Mach. Co., 10 C. C. A. 194, 61 Fed. 958; Bundy Mfg. Co. v. Detroit Time Register Co., 36 C. C. A. 375, 94 Fed. 524; Metallic Extraction Co. v. Brown, 43 C. C. A. 568, 104 Fed. 345; Norton v. Jensen, 1 C. C. A. 452, 49 Fed. 859; Consolidated Safety-Valve Co. v. Crosby Steam-Gauge & Valve Co., 113 U. S. 157, 5 Sup. Ct. 513, 28 L. Ed. 939; Hoyt v. Horne, 145 U. S. 302, 12 Sup. Ct. 922, 36 L. Ed. 713. See, also, to the same effect, Indiana Mfg. Co. v. J. I. Case Threshing Mach. Co., 154 Fed. Rep. 365, 369, 83 C. C. A. 343.

195. Thayer, J., in Metallic Extraction Co. v. Brown, 49 C. C. A. 147, 110 Fed. Rep. 665-668.

"We know of no principle of law which would authorize us to read into a claim an element which is not present, for the purpose of making out a case of novelty or infringement. The difficulty is that if we once begin to include elements not mentioned in the claim in order to limit such claim and avoid a defense of anticipation, we should never know where to stop."[106]

"To imply as elements of a claim parts not named therein for the purpose of limiting its scope, so that it may be accorded novelty, is contrary to a well-settled rule of the patent law."[107]

§ 127. Rule XXVII. Where possible, the construction given to claims by the Courts, will follow the construction given to them in the Patent Office.

"It is the settled rule in patent law that claims must stand or fall as made; but it is equally well settled that the claims of a patent are to be construed by reference to the specifications (of which the drawings form a part), and that such reference may be had, not for the purpose of expanding the claim, but for the purpose of defining it and limiting it to the description of the invention. And within certain limits the courts are inclined to

196. Mr. Justice Brown, in McCarty v. Lehigh Valley R. Co., 160 U. S. 110-116, 40 L. Ed. 358; followed in Wilson v. McCormick Harvesting Co., 34 C. C. A. 280, 92 Fed. Rep. 167, 174; Westinghouse Air-Brake Co. v. New York Air-Brake Co., 56 C. C. A. 404, 119 Fed. Rep. 874, 884; Diamond Drill Machine Co. v. Kelly Bros, 120 Fed. Rep. 289, 293; Canda Bros. v. Michigan Malleable Iron Co., 123 Fed. Rep. 95, 99; Canda v. Michigan Malleable Iron Co., 61 C. C. A. 194, 124 Fed. Rep. 486, 490; Penfield v. C. & A. Potts & Co., 61 C. C. A. 371, 126 Fed. Rep. 475, 484; General Electric Co. v. International Specialty Co., 61 C. C. A. 329, 126 Fed. Rep. 755, 759; B. F. Avery & Sons v. J. I. Case Plow Works, 139 Fed. Rep. 878, 883.

197. Taft, J., in Frederick R. Stearns & Co. v. Russell, 29 C. C. A. 121, 85 Fed. Rep. 218, 224.

adopt this mode of construction when it is necessary, as in the present case, to save the patent from the objection that the claims are too broad. And this would seem to be all the more safe and permissible where the construction adopted plainly appears to have been the one accepted by the patent office." [108]

§ 128. Rule XXVIII. A claim will not be limited merely because language cannot be found to accurately describe the invention.

"While, in some cases, the voluntary choice of a name may well be regarded as imposing a limitation upon the thing or function which the patentee desires to cover, and an acknowledgment that the standard meaning of a word is an appropriate description and limitation of the thing claimed, such a doctrine is frequently abused and misapplied for the creation of verbal and meritless issues. When it appears that an art is advanced by a novel structure, which in some features resembles old and well-known things, and in other features differs from them, or which is intermediate of things respectively bearing different names, we should be slow to allow debatable implications, arising merely from the choice of a name, to overrule plain text and plain descriptions of things and functions. An inventor makes a thing which is new. He must name it, and, as he cannot usually coin a new word, he must take an old one which fits it approximately. He may, like this inventor, find two old words about equally applicable, but neither of which is exactly descriptive of the invention. He chooses one. He might as well or better have chosen the other. His rights in a patent cause should not turn upon an assump-

198. Severens, J., in Lamb Knit Goods Co. v. Lamb Glove & Mitten Co., 56 C. C. A. 547, 120 Fed. Rep. 267, 269.

tion that he has thrown away all of what he describes except that which, in our opinion, is appropriately described by the general name he has chosen."[199]

§ 129. Rule XXIX. The drawing may be referred to in construing an ambiguous claim.

"Whenever a correct drawing of the specific device is attached to the specification, the claims should in all fairness be construed in connection therewith unless they are free from ambiguity or indefiniteness of expression."[200]

This rule is an outgrowth of the importance which the drawing has in the patent. Its purpose is to illustrate, and its illustration may always be invoked as an aid to the intelligent understanding and construction of the claim.

§ 130. Rule XXX. A claim for a function is void.

Any bare statement of this rule, which is in terms well established, must carry with it an appreciation of the difficulty appendant upon the interpretation of the word "function."[201] The rule is usually expressed in terms similar to the following:

"A valid patent cannot be secured for a function, a mode of operation, or a result, separate from the means or mechanical devices by which the result is accomplished."[202]

199. Brown, J., in Stetson v. Herreshoff Mfg. Co., 113 Fed. Rep. 952-954.

200. Hazel, J., in Koerner v. Deuther, 143 Fed. Rep. 544, 545. To the same effect, see, Robins v. Aurora Watch Co., 43 Fed. Rep. 521, 526.

201. General Electric Co. v. Yost Electric Co., 139 Fed. Rep. 568, 570.

202. Adams, J., in Union Match Co. v. Diamond Match Co., 162 Fed. Rep. 148, 151, 89 C. C. A. 172; citing, Fuller v. Yentzer, 94 U. S. 288, 24 L. Ed. 103; Westinghouse v. Boyden Power-Brake Co., 170 U. S. 537, 556, 42 L. Ed. 1136.

It has been elaborated as follows: "The function * * * of a machine or combination is not patentable under our laws. The means, the mechanical device, * * * and that alone, was capable of protection by such a franchise."[203]

§ 131. **Rule XXXI. A claim functional in terms will be so construed as to restrict it to means, in order to preserve it, where possible. "In this way the court may sustain the validity of the claims, as it is its duty to do when possible."[204]**

"A valid patent cannot be secured for a function, a mode of operation, or a result, separate from the means or mechanical devices by which the result is accomplished."[205]

"Function" is impatentable. But what is "function?" Judge Townsend has said: "It is not always clear what is meant by the use of this elastic and indefinite word 'function.' But it is thought that the assertion of a new function or effect should only be sustained upon proof of novel or unexpected properties or uses capable of producing novel results. We are not aware of any case where a claim for a new function has been sustained in the absence of such element of novelty or unexpectedness."[206]

203. National Hollow Brake-Beam Co. v. Interchangeable Brake-Beam Co., 106 Fed. Rep. 693, 45 C. C. A. 544.

204. Taft, J., in Columbus Watch Co. v. Robbins, 64 Fed. Rep. 384, 395, 12 C. C. A. 174.

205. E. B. Adams, J., in Union Match Co. v. Diamond Match Co., 89 C. C. A. 172, 162 Fed. Rep. 148, 151; citing Fuller v. Yentzer, 94 U. S. 288, 24 L. Ed. 103; Westinghouse v. Boyden Power Brake Co., 170 U. S. 537, 556, 42 L. Ed. 1136.

206. General Electric Co. v. Yost Electric Co., 71 C. C. A. 552, 139 Fed. Rep. 568, 570.

§ 132. Rule XXXII. It is not essential to the validity of a claim that it contain all the elements necessary to an operative machine.

"The law is well settled that a valid combination claim may be taken for a less number of parts than are required for the complete operation of a machine."[207]

The reason for the rule is thus stated by Judge Wallace: "Many subcombinations, although new, are not useful, except to perform their appropriate functions in the machine of which they are a part. The description in the patent of the whole machine, and of the means or mode by which the subcombination is brought into co-operative relation with the other parts, usually indicates how the subcombination may effect a useful result. When this is so, the combination need not be operative alone."[208]

§ 133. Rule XXXIII. To make a thing in one piece which was formerly made in two or more pieces is not invention.[209]

"Nor would the mere fact that the one-piece device was cheaper or more durable constitute invention when

207. Allen, J., in Chambers-Bering-Quinlan Co. v. Faries, 64 Fed. Rep. 587, 588, citing Forbush v. Cook, Fed. Cas. No. 4931, 2 Fisher, 668; Hancock Inspirator Co. v. Jenks, 21 Fed. Rep. 911; Jenkins v. Gurney, 23 Fed. Rep. 898; McDonald v. Whitney, .. Fed. Rep. 600. To the same effect, see, Taylor v. Sawyer Spindle Co., 75 Fed. Rep. 301, 309, 22 C. C. A. 203; Thomson-Houston Electric Co. v. Elmira Railway Co., 71 Fed. Rep. 396, 405, 18 C. C. A. 145, 154; Thomson-Houston Elec. Co. v. Black River Traction Co., 135 Fed. Rep. 759, 763, 68 C. C. A. 461; Loom Co. v. Higgins, 105 U. S. 585, 586, 26 L. Ed. 1177.

208. Thomson-Houston Electric Co. v. Black River Traction Co., 135 Fed. Rep. 759, 763, 68 C. C. A. 461.

209. Standard Caster & Wheel Co. v. Caster Socket Co., 113 Fed. Rep. 162, 166, 51 C. C. A. 109; General Electric Co. v. Yost Electric Mfg. Co., 139 Fed. Rep. 568, 570, 71 C. C. A. 552; Howard v. Detroit Stove Works, 150 U. S. 164, 37 L. Ed. 1039.

such results were merely such ordinary consequences of * * * dispensing with joints as would naturally be anticipated by the workman."[210]

"There are cases in which, under very special circumstances, such an improvement may show (be) patentable invention."[211]

§ 134. Rule XXXIV. The claims of the patent as issued must be read and interpreted with reference to the claims rejected and abandoned in the Patent Office, and cannot be so construed as to be co-extensive with such rejected and abandoned claims.

The reason for this rule has been clearly stated by Mr. Justice Shiras: "An examination of the history of the appellant's claim, as disclosed in the file wrapper and contents, shows that, in order to get his patent, he was compelled to accept one with a narrower claim than that contained in his original application; and it is well settled that the claim as allowed must be read and interpreted with reference to the rejected claim and to the prior state of the art, and cannot be so construed as to cover either what was rejected by the Patent Office or disclosed by prior devices."

"It is quite true that, where the differences between the claim as made and as allowed consist of mere changes of expression, having substantially the same meaning, such changes, made to meet the views of the examiners, ought not to be permitted to defeat a meritorious claim-

210. Townsend, J., in General Electric Co. v. Yost Electric Mfg. Co., 139 Fed. Rep. 568, 570, 71 C. A. 552.

211. Lurton, J., in Standard Caster & Wheel Co. v. Caster Socket Co., 113 Fed. Rep. 162, 165, 51 C. C. A. 109, referring to Krementz v. S. Cottle Co., 1[illegible] U. S. 556, 37 L. Ed. 558, as an illustration of the exception to the rule—a collar button made of a single piece of sheet metal, such buttons having theretofore been made of two or more pieces soldered together.

ant. While not allowed to revive a rejected claim by a broad construction of the claim allowed, yet the patentee is entitled to a fair construction of the terms of his claim as actually granted."[212]

§ 135. Rule XXXV. The words "substantially as described," "substantially as set forth," or the like, are of no force in the claim.

This rule has been often repeated, and its expression has been occasioned by the frequency with which the expressions referred to are used as a termination for the claim. They are superfluous, because, if they are not expressed they are implied, when that implication is necessary to sustain the claim as against a charge of excessive breadth, or a charge that is for a function, a principle, or a mode of operation.

Turning to the illustrative cases, we find the following:

"Where the claim immediately follows the description of the invention, it may be construed in connection with the explanation contained in the specifications, and when it contains words referring back to the specifications it cannot be properly construed in any other way."[213]

"The claims are broadly for 'means' and 'mechanism' to do certain things, perform certain functions, and obtain certain results. In claim 1 the claim is for 'apparatus' on an engine and 'apparatus' on a car capable of operation by a reduction of pressure 'to apply brakes' and 'means' for, etc. That such expressions are too in-

212. Hubbell v. United States, 179 U. S. 77, 80, 45 L. Ed. 95, 98. To the same effect, see, Williams Patent Crusher & Pul. Co. v. Pennsylvania Crusher Co., 176 Fed. Rep. 576, 578; Leggett v. Avery, 101 U. S. 256, 25 L. Ed. 865; Shepard v. Carrigan, 116 U. S. 593, 29 L. Ed. 723; Knapp v. Morss, 150 U. S. 227, 37 L. Ed. 1061.

213. Seymour v. Osborne, 11 Wall. 516, 547, 20 L. Ed. 33.

definite, see Ex parte Holt,[214] Ex parte Wilkin,[215] and Ex parte Demming,[216] unless used to denote appliances which are no part of the invention. Ex parte Stoughton;[217] Ex parte Stanbridge.[218] But later cases seem to settle the law differently. These claims are not for functions, or principles, or modes of operation, but for 'apparatus' and 'mechanism' and 'means' fully described in the specifications which immediately precede the claims. I think words in the claim referring to the specifications are entirely unnecessary. It is understood that the one refers to the other. Words of reference to the specifications, 'if not expressed in the claim, must be implied, else the patent in many cases would be invalid as covering a mere function, principle, or result, which is obviously forbidden by the patent law, as it would close the door to all subsequent improvements.' Mitchell v. Tilghman,[219] cited and approved in Hobbs v. Beach.[220] Within the authorities, I think claims 1 and 2 sufficient and valid, read in connection with the specifications, as they must be, and that they are not for functions or results."[221]

It is curious to note, in these cases, the reference to the description preceding the claims. As the description always precedes the claim, the expression referred to is mere surplusage.

214. 29 O. G. 171.
215. 29 O. G. 950.
216. 26 O. G. 1207.
217. 43 O. G. 1345.
218. 43 O. G. 1345.
219. 19 Wall. 287, 91, 22 L. Ed. 125.
219. 19 Wall. 287, 291, 22 L. Ed. 586.
221. Ray, J., in Corrington v. Westinghouse Air-Brake Co., 173 Fed. Rep. 69, 77; citing, Brush Electric Co. v. Electric Imp. Co., 52 Fed. Rep. 965, 974-976; Telephone Cases, 126 U. S. 1, 31 L. Ed. 863; Hobbs v. Beach, 180 U. S. 383, 400, 45 L. Ed. 586; Tilghman v. Proctor, 102 U. S. 707, 709, 26 L. Ed. 279.

§ 136. Rule XXXVI. The drawings will be referred to for definition of the terms used in the description.

"The drawings accompanying the specification and referred to in the descriptive parts thereof will be examined to ascertain the true meaning of the terms used in describing the invention. Section 4889, R. S. U. S. (U. S. Comp. St. 1901, p. 3382.)"[222]

Letters patent have the great advantage of being interpreted by the aid of their self-contained drawings. This rule is merely illustrative of one of the uses of the drawings. The rule also indicates the wide latitude allowed to inapt phraseology in patent soliciting. Even the best available dictionaries are not reliable guides in technical terminology, as every experienced patent lawyer or solicitor knows. The question in interpretation is, What did the applicant mean by this word? not, Did he use the correct word.

§ 137. Rule XXXVII. In a combination claim each element is conclusively presumed as a matter of law to be old, whether old in fact or not.

The foundation of this rule is, that if, among the elements, there is one which is itself patentably new, it must be separately claimed, or it is dedicated to the public by its inventor's failure to claim it.

Thus Judge Baker has said: "The failure to claim either one of the elements separately raises the presumption that no one of them is novel."[223] And Judge

222. Rellstab, J., in Steiner & Voegtly Hdw. Co. v. Tabor Sash Co., 178 Fed. Rep. 831, 836; citing, Bates v. Coe, 98 U. S. 31, 38, 25 L. Ed. 68; Card v. Colby, 64 Fed. Rep. 594, 12 C. C. A. 319; Brammer v. Schroeder, 106 Fed. Rep. 918, 46 C. C. A. 41; Lamb Knit Goods Co. v. Lamb Glove & Mitten Co., 120 Fed. Rep. 267, 56 C. C. A. 547; Mossberg v. Nutter, 135 Fed. Rep. 95, 68 C. C. A. 257; Robins Conveying Belt Co. v. American Road Mach. Co., 145 Fed. Rep. 923, 76 C. C. A. 461.

223. Campbell v. Conde Implement Co., 74 Fed. Rep. 745.

Woods has said: "When a combination is claimed, there arises an implied concession that the elements are old, and not separately patentable."[224]

A combination claim is an entity; each element is merely an integer. It is not correct to say of any claim that some specified element is its "distinguishing element." As the omission of any element will destroy the claim, they should all be treated as co-ordinate for the purposes of interpretation and of determining infringement.

§ 138. Rule XXXVIII. A claim that is too broad is void.

This rule relates to claims that in terms extend beyond the real invention of the patent of which they are part. Its most frequent application occurs in cases where the prior art deprives the claim of novelty. As we have seen, the claim must be read in the light of the prior art, and when so read it will be given a sufficiently narrow construction to sustain it if possible.[225] On the other hand, excessive breadth of the claim may be determined not from the prior art, but from the disclosure of the description. It has been expressly held that an inventor cannot "speculate on the equivalents of his claimed invention, and thereby oblige the public to resort to experiments in order to determine the scope of the claims of his patent."[226] And the courts have uniformly condemned claims embracing all means, however differing in principle or mode of operation from the means described in the patent.[227]

224. Hay v. Heath Cycle Co., 71 Fed. Rep. 411-413, 18 C. C. A. 157.

225. Pope Mfg. Co. v. Gormully & Jeffery Mfg. Co., 144 U. S. 238, 36 L. Ed. 420.

226. Matheson v. Campbell, 78 Fed. Rep. 910, 24 C. C. A. 284.

227. Celluloid Mfg. Co. v. Arlington Mfg. Co., 52 Fed. Rep. 740, 3 C. C. A. 269.

§ 139. Rule XXXIX. Immaterial omissions will not invalidate a claim.

The omissions indicated by this rule are omissions of those matters which are of common knowledge or are necessarily implied by the description and can be readily supplied by those skilled in the art to which the invention relates. In announcing this rule Mr. Justice Brown said: "Admitting that additional elements are necessary to render the device operative, it does not necessarily follow that the omission of these elements invalidates the claim, or that the precise elements described in the patent as rendering it operative must be read into the claim. If Steward were in fact the first to invent the pivotal extension to a butt-adjuster, he is entitled to a patent therefor, though the infringer may make use of other means than those employed by him to operate it. In such case any appropriate means for making it operative will be understood. Otherwise the infringer might take the most important part of a new invention and, by changing the method of adapting it to the machine to which it is an improvement, avoid the charge of infringement. The invention of a needle with the eye near the point is the basis of all the sewing machines used; but the methods of operating such a needle are many, and if Howe had been obliged to make his own method a part of every claim in which the needle was an element, his patent would have been practically worthless."[228]

Of this doctrine, Judge Wales has said: "The law on this subject is too well settled to be open for discussion. A patentee is not required to claim the entire machine in each claim. Each of the claims at issue is for a complete combination of the spindle and its supporting tube

228. Deering v. Winona Harvester Works, 155 U. S. 286-302, 39 L. Ed. 153.

and devices, and there was no necessity for expressing in terms the devices for revolving the spindle. Any appropriate means for operating it will be understood. The omission of the sleeve whirl does not affect the validity of either one of the claims, which belong to that class where reference may be made to the specifications to supply in a claim what it is plain, to any one skilled in the art, is a necessary incident."[229]

§ 210. Rule XL. A claim for an abstract principle or law of nature is void.

This rule has been recognized throughout the history of the American Patent System. Mr. Justice Gray, on Circuit, said: "The discoverer of a natural force or a scientific fact cannot have a patent for that."[230]

Judge McCrary elaborated the same idea as follows: "There can be no patent upon an abstract philosophical principle. Laws of matter and properties of matter are presumed to be known to and subject to be utilized by all alike. But application of any one or more of these laws or principles to a practical object, and so as to secure a useful result not previously obtained, is patentable."[231]

Where it was argued in the defense of a charge of infringement of a process patent that the patent did not disclose the scientific principle of the process, Judge Morris showed the connection between the rule under consideration and the familiar rule that the inventor need not describe the principle of his invention by saying: "He describes the process, the mode of operation and the result, and the means for obtaining it. The scientific principle is not part of the process, is not patentable, and need not be set forth."[232]

229. Taylor v. Sawyer Spindle Co., 75 Fed. Rep. 301, 309, 22 C. C. A. 203.

230. American Bell Tel. Co. v. Dolbear; 15 Fed. Rep. 448.

231. Boyd v. Cherry, 50 Fed. Rep. 279, 282.

232. Emmerson Company v. Nimocks, 99 Fed. Rep. 737, 740.

§ 141. Rule XLI. A new result is not necessary to the validity of a patent.

Novelty of result is strong evidence of patentability. The cases abound with variations of the phrase, "If a new combination and arrangement of known elements produce a new and beneficial result, never attained before, it is evidence of invention."[233]

But it by no means follows that a new result is an indispensable requisite of a valid patent. If an inventor "has greatly increased the effectiveness of the mechanism he claims, his patent may be sustained, although his elements are old and no original result is accomplished."[234]

CHAPTER VII.

WHAT CONSTITUTES INVENTION.

§ 142. The question broadly unanswerable.

What constitutes invention within the meaning of the patent act, is the unanswerable question of patent law. It involves the mental conception of one (the court) concerning the transpired mental processes of another (the alleged inventor). It involves the mental conception by a court of the state of the art into which the alleged inventor has entered, and the weighing of his accomplishment in the light of the state of the art to determine whether his contribution to its advancement was within the Domain of Mechanical Skill, or crossed the boundaries of that domain and entered the Realm of Invention. That the subject-matter of a valid patent must not only be new and useful, but the product of the exercise of the inventive faculty, is manifest from the lan-

233. Webster Loom Co. v. Higgins, 105 U. S. 580, 591, 26 L. Ed. 1177.

234. Lurton, J., in Muller v. Lodge & Davis Machine Tool Co., 77 Fed. Rep. 621, 629, 23 C. C. A. 357; citing the Barbed Wire Patent, 143 U. S. 275, 36 L. Ed. 154; Topliff v. Topliff, 145 U. S. 156, 36 L. Ed. 658.

guage both of the constitutional provision and of the patent act. In this regard Mr. Justice Blatchford has said:

"The provision of the Constitution (art. 1, § 8, subd. 8) is, that the Congress shall have power 'to promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries.' The beneficiary must be an inventor and he must have made a discovery. The statute has always carried out this idea. Under the Act of July 4, 1836, 5 Stat. at L., 119, § 6, in force when these patents were granted, the patentee was required to be a person who had 'discovered or invented, a 'new and useful art, machine, manufacture or composition of matter,' or a 'new and useful improvement in any art, machine, manufacture or composition of matter.' In the Act of July 8, 1870, 16 Stat. at L., 201, § 24, the patentee was required to be a person who had 'invented or discovered any new and useful art, machine, manufacture or composition of matter, or any new and useful improvement thereof;' and the language is reproduced in section 4886 of the Revised Statutes. So, it is not enough that a thing shall be new, in the sense that in the shape or form in which it is produced it shall not have been before known, and that it shall be useful, but it must, under the Constitution and the statute, amount to an invention or discovery."[235]

The rule thus laid down has been repeatedly re-affirmed.[236]

235. Thompson v. Boisselier, 114 U. S. 1-11, 29 L. Ed. 76.

236. "The rule declared in Thomson v. Boisselier . . . often reaffirmed by federal and state authorities." Morrow, J., in Johnston v. Woodbury, 96 Fed. Rep. 421, 434.

The conclusion that no rule of general application exists whereby the existence of invention can be affirmed or negatived in a particular case, is substantiated by Mr. Justice Brown in the following language:

"What shall be construed as invention within the meaning of the patent laws has been made the subject of a great amount of discussion in the authorities, and a large number of cases, particularly in the more recent volumes of reports, turn solely upon the question of novelty. By some, invention is described as the contriving or constructing of that which had not before existed; and by another, giving a construction to the patent law, as 'the finding out, contriving, devising, or creating something new and useful, which did not exist before, by an operation of the intellect.' To say that the act of invention is the production of something new and useful does not solve the difficulty of giving an accurate definition, since the question of what is new as distinguished from that which is a colorable variation of what is old, is usually the very question in issue. To say that it involves an operation of the intellect, is a product of intuition, or of something akin to genius, as distinguished from mere mechanical skill, draws one somewhat nearer to an appreciation of the true distinction, but it does not adequately express the idea. The truth is the word cannot be defined in such manner as to afford any substantial aid in determining whether a particular device involves an exercise of the inventive faculty or not. In a given case we may be able to say that there is present invention of a very high order. In another we can see that there is lacking that impalpable something which distinguishes invention from simple mechanical skill. Courts, adopting fixed principles as a guide, have by a process of exclusion de-

termined that certain variations in old devices do or do not involve invention; but whether the variation relied upon in a particular case is anything more than ordinary mechanical skill is a question which cannot be answered by applying the test of any general definition."[237]

The necessary result of this absence of definite test of invention has been to produce great uncertainty of the outcome of any issue involving the question of invention. Co-ordinate courts of great and equal ability have at times decided the issue involving the same device with opposite results.

Of this difficulty, Judge McPherson has said: "It is often very difficult to draw the line between invention and skill, and different minds may draw it at different points."[238]

In the language of Judge Taft: "The line between mechanical ingenuity and invention is sometimes very hard to draw. It is a question of fact, and one upon which the opinions of men differ."[239]

Mr. Justice Brown has said "the line between invention and mechanical skill is often an exceedingly difficult one to draw."[240]

The effort of the student to ascertain from the authorities the nature of the inventive act, is often hampered by the want of familiarity of the courts with even the nomenclature of the patent law. Thus we find the

237. McClain v. Ortmayer, 141 U. S. 419-427, 35 L. Ed. 800. "This question of patentability is often one of very great embarrassment. The patent law requires the presence of what is called invention, as contra distinguished from constructive ability; but it furnishes no test, for all cases, by which they can be discriminated." Lowell, J., in Dunbar v. Albert Field Tack Co., 4 Fed. Rep. 543-544.

238. McPherson, J., in Tesla Electric Co. v. Scott, 97 Fed. Rep. 588, 598.

239. Taft, J., in Kissinger Iron Co. v. Bradford Belting Co., 97 Fed. Rep. 502, 508, 38 C. C. A. 300.

240. Mast, Foos & Co. v. Stover Mfg. Co., 177 U. S. 485, 493, 44 L. Ed. 856, 860.

Court of Appeals of the Sixth Circuit, in the course of an otherwise well considered opinion, using the following expression: "While it may not always be helpful in determining whether a given act or result involves the exercise of constructive faculty rather than mechanical skill," etc.[241] This language is employed in the course of a discussion of the question of invention, and the only possible meaning of the terms quoted indicates that "constructive faculty" is used as being synonymous with "Invention." Thus the misuse of words has rendered obscure an opinion which otherwise might have been illuminative.

Judge Grosscup has formulated a very useful definition of invention, as the term relates to improvements. "Invention, in the nature of improvements, is the double mental act of discerning, in existing machines or processes or articles, some deficiency, and pointing out the means of overcoming it,"[242] which is a neat paraphrase of the adage, "necessity is the mother of invention."

§ 143. The rules for testing invention.

It is, perhaps, an embarrassment to a scientific determination of the existence or non-existence of invention that the rules laid down by the decisions are for the most part negative in character. The courts have proceeded upon the theory that, granted that invention is impossible of positive definition, the nearest approximation of accuracy in determining its existence would be attained by enumerating the things that do not constitute invention and whose presence affirm the absence of invention, upon the principle *enumeratio unius est exclusio alterius.* We will now consider these rules and their exceptions.

241. Morgan Engineering Co. v. Alliance Machine Co., —— C. C. A. ——, 176 Fed. Rep. 100, 157 Off. Gaz. 1244.

242. General Electric Co. v. Sangamo Electric Co., 174 Fed. Rep. 246, 251, —— C. C. A. ——.

§ 144. Rule I. Valid Letters Patent must be based upon an invention.

"If it is a useful article, and is new, it is the proper subject of a patent, provided it involved invention to produce it."[243]

"To produce that which is new and useful, even though it requires ability of a high order, will not constitute invention if inventive genius is not involved."[244]

All of which resolves itself into the doctrine that novelty in fact is not identical with patentable novelty.

§ 145. Rule II. Letters Patent are void, even if the thing patented is new and useful, if it does not embody invention.

"It is not enough that a thing shall be new, in the sense that, in the shape or form in which it is produced, it shall not have been before known, and that it shall be useful, but it must, under the Constitution and the statutes, amount to an invention or discovery."[245]

This rule is a paraphrase of Rule I, § 144.

§ 146. Rule III. Rules I and II, §§ 144, 145, apply to patents for designs as well as to other classes of patents.

"The law applicable to this class of patents does not materially differ from that in cases of mechanical patents, and 'all the regulations and provisions which apply to the obtaining and protecting of patents for inventions or discoveries—shall apply to patents for designs.' Section 4933, R. S. U. S. The same general principles of construction extend to both. To entitle a party to the

243. Severens, J., in Lamb Knitgoods Co. v. Lamb Glove & Mitten Co., 56 C. C. A. 547, 120 Fed. Rep. 267, 272.

244. Coxe, J., in Fowler v. New York, 58 C. C. A. 113, 121 Fed. Rep. 747, 749.

245. Mr. Justice Blatchford, in Thompson v. Boisselier, 114 U. S. 1, 11, 29 L. Ed. 76, 79. Quoted and followed in Gardner v. Herz, 118 U. S. 180, 30 L. Ed. 158, 163.

benefit of the act, in either case, there must be originality and exercise of the inventive faculty."[246]

For the discussion of designs as the proper subjects of letters patent, see *ante*, § 58.

§ 147. Rule IV. The presence or absence of invention must be determined by the facts in each particular case.

The reason for this rule resides in the fact that "invention" is incapable of definition. "The truth is the word cannot be defined in such manner as to afford any substantial aid in determining whether a particular device involves an exercise of the inventive faculty or not. In a given case we may be able to say that there is present invention of a very high order. In another we can see that there is lacking that impalpable something which distinguishes invention from simple mechanical skill. Courts, adopting fixed principles as a guide, have by a process of exclusion determined that certain variations in old devices do or do not involve invention; but whether the variation relied upon in a particular case is anything more than ordinary mechanical skill is a question which cannot be answered by applying the test of any general definition."[247]

§ 148. Rule V. Letters Patent are void for want of invention only where the absence of invention is clear.

"Unless there is clearly no invention in what is claimed to be such, the patent should be sustained."[248]

This rule is a necessary supplement to the general rule that the patent itself is *prima facie* evidence "as to every

246. Mr. Justice Brown, J., in Northrup v. Adams, Fed. Case No. 10,328, 12 Off. Gaz. 430. Quoted and followed in Smith v. Whitman Saddle Co., 148 U. S. 674, 679, 37 L. Ed. 606, 609.

247. Mr. Justice Brown, in McClain v. Ortmayer, 141 U. S. 419, 427, 35 L. Ed. 800.

248. Mr. Justice Bradley, in Reiter v. Jones & Laughlin, Ltd., 35 Fed. 421, 423.

point touching the validity of a claim."[249] But it is settled that "the presumption which this rule affords is sometimes slight and sometimes renders but little assistance."[250] It has been said that "the court should give due consideration to the action of the patent office, but should not permit that action to control its deliberate judgment when it is manifest that there is no invention."[251]

§ 149. Rule VI. The length of time required in evolving the thing patented does not determine the question of invention.

"Just where the line of invention lies in an accomplished result is frequently difficult for the courts to determine. That it must extend beyond the merely novel and useful, and into the domain of original thought has been determined. The extent of the mental process, however, is immaterial. The result may come out of long consideration, or in may be the revelation of a flash of thought."[252]

§ 150. Rule VII. The existence or non-existence of invention "does not necessarily depend upon the amount of thought, or even of experiment, which may have been had in reaching the results."[253]

The rule applies even where the result was attained by accident,[254] or from suggestions from ordinary and familiar objects in nature or in art.[255]

249. Putnam, J., in Chase v. Fillebrown, 58 Fed. Rep. 374, 376.

250. Putnam, J., in Burnham & Duggan Ry. Appliance Co. v. Naumkeag St. R. Co., 57 Fed. Rep. 651, 653.

251. Jenkins, J., in J. J. Warren Co. v. Rosenblatt, 80 Fed. Rep. 540, 543, 25 C. C. A. 625.

252. Bradley, J., in Snyder v. Fisher, 78 Off. Gaz. 485, 486.

253. Lowell, J., in Dunbar v. Elbert Field Tack Co., 4 Fed. Rep. 543, 544. To the same effect, see, Blake v. Stafford, Fed. Case No. 1504, 6 Blatch 195, 3 Fish. 294; Middletown Tool Co. v. Judd, Fed. Case No. 9536, 3 Fish. 141; Magic Ruffle Co. v. Douglas, Fed. Case No. 8948, 2 Fish. 330.

254. Bowman v. De Grauw, 60 Fed. Rep. 907, 910.

255. Anthony v. Gennert, 99 Fed. Rep. 95, 96.

Notwithstanding this rule, it is often important to show to court or jury the course by which the invention was evolved. The long and weary search of the inventor, particularly when he is one skilled in the art, is very persuasive at times, and is a fact which should always be developed in the evidence, when it exists.

§ 151. Rule VIII. That the subject matter of the patent was produced accidentally does not negative the presence of invention.

"An invention is not like a will, depending upon the intention. It is a fact, and if the fact exists, it does not appear to be material whether it came by design or accidentally without being bidden."[256]

§ 152. Rule IX. The mere exercise of mechanical skill is no invention.[257]

256. Wheeler, J., in Badische Anilin & Soda Fabrik v. Cochrane, Fed. Case No. 719, 16 Blatchf. 155.

257. Belt v. Crittenden, 2 Fed. 82, 1 McCrary 209; Perfection Window Cleaner Co. v. Bosley, 2 Fed. 574, 9 Biss. 385; Yale Lock Mfg. Co. v. Norwich Nat. Bank, 6 Fed. 377, 19 Blatchf. 123; Facer v. Midvale Steel-Work Co., 38 Fed. 231; Davis v. Parkman, 45 Fed. 693 (affirmed in 71 Fed. 961, 18 C. C. A. 398); Northrop v. Keighley, 48 Fed. 455; Merritt v. Middleton, 61 Fed. 680, 10 C. C. A. 10; Johnson Co. v. Pennsylvania Steel Co., 62 Fed. 156; Westinghouse v. Edison Electric Light Co., 63 Fed. 588, 11 C. C. A. 342; Smith v. Macbeth, 67 Fed. 137, 14 C. C. A. 241; Union Paper-bag Machine Co. v. Waterbury, 70 Fed. 240, 17 C. C. A. 84; Schreiber, etc., Co. v. Grimm, 72 Fed. 671, 19 C. C. A. 67; Clune v. Madden, 77 Fed. 205; National Folding-Box, etc., Co. v. Stecher Lith. Co., 77 Fed. 828; Buck v. Timothy, 78 Fed. 487; National Harrow Co. v. Wescott, 84 Fed. 671; Gormully, etc., Mfg. Co. v. Western Wheel Works, 84 Fed. 968, 28 C. C. A. 586; Tiemann v. Kraatz, 85 Fed. 437, 29 C. C. A. 257; Thomson-Houston Electric Co. v. Union R. Co., 87 Fed. 879; Ingraham Co. v. E. N. Welch Mfg. Co., 92 Fed. 1019, 35 C. C. A. 163; Davey Pegging-Mach. Co. v. Prouty, 96 Fed. 336; Yale, etc., Mfg. Co. v. Sargent, 97 Fed. 106; National Hollow Brake-Beam Co. v. Interchangeable Brake-Beam Co., 99 Fed. 758; Stanley Rule, etc., Co. v. Ohio Tool Co., 115 Fed. 813 (affirmed in 125 Fed. 947, 60

"A device which displays only the expected skill of the maker's calling, and involves only the exercise of ordinary faculties of reasoning upon materials supplied by special knowledge, and facility of manipulation resulting from habitual, intelligent practice, is in no sense a creative work of the inventive faculty, such as the Constitution and patent laws aim to encourage and reward."[258]

"Long practice and observation naturally lead those familiar with the arts to the perception of new adaptations. Mechanical education and skill, fostered and promoted by the public, are rapidly advancing in every direction, and there is a constant and universal endeavor in handicraft to utilize that which is known, and press it into service in the practical arts. But the steps of this normal progress and improvement are not invention, nor the subject of monopoly to one who, in the exercise of

C. C. A. 185); U. S. Peg-Wood, etc., Co. v. B. F. Sturtevant Co., 125 Fed. 378, 60 C. C. A. 244; Calhoun v. Southern Cotton Oil Co., 120 Fed. Rep. 513, 515; Felt, etc., Mfg. Co. v. Mechanical Account-ant Co., 129 Fed. 386; Gates Iron Works v. Overland Gold Min. Co., 147 Fed. 700, 78 C. C. A. 88; Smyth Mfg. Co. v. Sheridan, 149 Fed. 208, 79 C. C. A. 166; Dunbar v. Meyers, 94 U. S. 187, 24 L. Ed. 34; Atlantic Works v. Brady, 107 U. S. 192, 27 L. Ed. 438; Slawson v. Grand St., etc., R. Co., 107 U. S. 649, 27 L. Ed. 576; Phillips v. Detroit, 111 U. S. 604, 28 L. Ed. 532; Morris v. McMillin, 112 U. S. 244, 28 L. Ed. 702; Hollister v. Benedict, etc., Mfg. Co., 113 U. S. 59, 28 L. Ed. 901; Yale Lock Mfg. Co. v. Greenleaf, 117 U. S. 554, 29 L. Ed. 952; Clark Pomace-Holder Co. v. Ferguson, 119 U. S. 335, 30 L. Ed. 406; Aron v. Manhattan R. Co., 132 U. S. 84, 33 L. Ed. 272; Royer v. Roth, 132 U. S. 201, 33 L. Ed. 322; Shenfield v. Nashawannuck Mfg. Co., 137 U. S. 56, 34 L. Ed. 573; French v. Carter, 137 U. S. 239, 34 L. Ed. 664; Knapp v. Morss, 150 U. S. 221, 37 L. Ed. 1059; Giles v. Heysinger, 150 U. S. 627, 37 L. Ed. 1204; Black Diamond Coal-Min. Co. v. Excelsior Coal Co., 156 U. S. 611, 39 L. Ed. 553.

258. Wales, J., in Williams Mfg. Co. v. Franklin, 41 Fed. Rep. 393-395. Following, Hollister v. Mfg. Co., 113 U. S. 59, 28 L. Ed. 301; Thompson v. Boisselier, 114 U. S. 1, 29 L. Ed. 76; Atlantic Works v. Brady, 107 U. S. 200, 27 L. Ed. 438.

the 'skill of his calling,' has put an old thing to a new use."[259]

In contrasting invention and mechanical skill Judge Nixon has said, "Invention indicates genius and the production of a new idea. Mechanical skill is applied to an old idea and suggests how it may be modified and made more practical."[260]

"Mere mechanical skill can never rise to the sphere of invention. The latter involves higher thought, and brings into activity a different faculty. Their domains are distinct. The line which separates them is sometimes difficult to trace; nevertheless, in the eye of the law it always subsists. The mechanic may greatly aid the inventor, but he cannot usurp his place."[261]

§ 153. Rule X. The result of study, effort and experiment may not amount to invention.[262]

The primary reason underlying this rule is, that letters patent are addressed to those who are skilled in the arts to which they relate.[263] Consequently, a display of ability which may, in the language of Judge Dallas "astonish the unskilled,"[264] may not involve invention, but be strictly within the domain of mechanical skill.

What has been said in connection with Rule VII, *ante*, § 150, should be considered with this rule.

259. Severens, J., in Capital Sheet-Metal Co. v. Kinnear & Gager Co., 87 Fed. Rep. 333, 336, 31 C. C. A. 3.

260. New York Belting & Packing Co. v. Magowan, 27 Fed. Rep. 362, 364.

261. Swayne, J., in Blandy v. Griffith, Fed. Case No. 1528, 3 Fisher 609.

262. Butler v. Steckel, 27 Fed. Rep. 219, 220.

263. E. L. Watrous Mfg. Co. v. American Hardware Mfg. Co., 161 Fed. Rep. 362, 364.

264. National Co. v. Belcher, 68 Fed. Rep. 665, 668.

§ 154. Rule XI. The simplicity or obviousness of the thing evolved does not negative the presence of invention.

"We cannot yield our assent to the argument, that the combination of the different parts or elements for attaining the object in view was so obvious as to merit no title to invention. Now that it has succeeded, it may seem very plain to any one that he could have done it as well. This is often the case with inventions of the greatest merit."[265]

The application of this rule is one of the most difficult tasks involved in the presentation or decision of the question of invention. While the rule has been laid down by the Supreme Court in the language above quoted, patents have been repeatedly overthrown and held void for want of invention because the subject-matter was held to be so simple and obvious in the art to which it relates, that it would spontaneously have occurred to any mechanic skilled in the art. The rule, therefore, must be read with this limitation: That the simplicity or obviousness of the device must not be of such degree as will leave the accomplishment within the domain of mechanical skill and deprive it of the dignity of invention. The illustrative cases are numerous.[266]

§ 155. Rule XII. To apply an old process to old material is not invention, nor is the resulting product an invention.[267]

This rule is but an application of the doctrine of analogous use. See § 164.

265. Mr. Justice Bradley, in Webster Loom Co. v. Higgins, 105 U. S. 580, 26 L. Ed. 1177, 1181.

266. Yale Lock Mfg. Co. v. Greenleaf, 117 U. S. 554, 29 L. Ed. 952.

267. King v. Gallun, 109 U. S. 99, 27 L. Ed. 870.

§ 156. Rule XIII. The mere change of form is not invention.[268]

"Under our law a patent cannot be granted merely for a change of form. The Act of February 21, 1793, § 2, so declared in express terms; and though this declaratory law was not re-enacted in the Patent Act of 1836, it is a principle which necessarily makes part of every system of law granting patents for new inventions. Merely to change the form of a machine is the work of a constructor, not of an inventor; such a change cannot be deemed an invention."[269]

It is to be noted that the rule is limited to a *mere* change of form, that is to say, such change of form as occurs where the same idea of means, mode of operation and result are to be found in both the original and the changed form.

In the language of Mr. Justice Curtis: "To change the form of an existing machine and by means of such change to introduce and employ other mechanical principles or natural powers, or, as it is termed, a new mode of operation, and thus attain a new and useful result, is the subject of a patent."[270]

§ 157. Rule XIV. Mere change of size [271], weight [272] or rigidity [273], is not invention.

In the leading case under this rule, Mr. Justice Nelson said: "Nor does the enlargement of the organization of the machine compared with the old one, * * * afford any ground, in the sense of the patent law, for a

268. Winans v. Denmead, 15 How. 330, 14 L. Ed. 717.

269. Ibid.

270. Ibid.

271. Phillips v. Page, 24 Howard 164, 16 L. Ed. 639, 7 Brodix, 97.

272. American Road Machine Co. v. Pennock & Sharp Co., 164 U. S. 26, 41, 41 L. Ed. 337, 343.

273. Crouch v. Roemer, 103 U. S. 797, 26 L. Ed. 426.

patent. This is done every day by the ordinary mechanic in making a working machine from the patent model."[274]

"The substitution of the heavier wheel was not the product of a creative mental conception, but merely the result of the exercise of the ordinary faculties of reasoning upon the materials supplied by a special knowledge, and the facility of manipulation which results from its habitual and intelligent practice."[275]

§ 158. Rule XV. "It is not invention to so enlarge and strengthen a machine that it will operate on larger materials than before."[276]

This rule is an application of the general doctrine that the mere exercise of mechanical skill is not invention. See *ante*, § 152.

§ 159. Rule XVI. It is not invention to merely change the direction of motion of a machine.[277]

"Nor is it an invention to apply to vertical uses a device which has previously been used in other connections to accomplish horizontal movement."[278]

This, again, is but one way of applying the rule as to mere mechanical skill. See *ante*, § 152.

§ 160. Rule XVII. In determining the question of invention it is presumed that the patentee was fully informed of everything which preceded him.

"In determining the question of invention, we must presume the patentee was fully informed of everything

274. Phillips v. Page, 24 Howard 164, 16 L. Ed. 639, 7 Brodix 97.

275. Mr. Chief Justice Fuller, in American Road Machine Co. v. Pennock & Sharp Co., 164 U. S. 26, 41, 41 L. Ed. 337, 343.

276. Kohlsaat, J., in American Well Works v. F. C. Austin Mfg. Co., 98 Fed. Rep. 992, 993. To the same effect, see, Woodbury v. Keith, 101 U. S. 479, 25 L. Ed. 939.

277. Royer v. Roth, 132 U. S. 201, 33 L. Ed. 322.

278. Kohlsaat, J., in American Well Works v. F. C. Austin Mfg. Co., 98 Fed. Rep. 992, 993.

which preceded him, whether such were the actual fact or not. There is no doubt the patent laws sometimes fail to do justice to an individual who may, with the light he had before him, have exhibited an inventive talent of a high order, and yet be denied a patent by reason of antecedent devices which actually existed, but not to his knowledge, and are only revealed after a careful search in the Patent Office. But the statute (§ 4886, R. S. U. S.) is inexorable. It denies the patent, if the device were known or used by others in this country before his invention. Congress having created the monopoly, may put such limitations upon it as it pleases."[279]

This rule is one of public necessity. The things which are of common right to use cannot be monopolized under the patent law, because there is a complete failure of consideration for the grant.

§ 161. Rule XVIII. The substitution of equivalents is not invention.

Equivalency may be invoked, under this rule, as a test of invention, although the question of equivalency usually arises as an incident to the issue of infringement. In the language of Mr. Justice Swayne, "the substitution of equivalents is not such invention as will sustain a patent."[280] The application of this rule depends so much upon the state of the art involved that its application is necessarily attended with uncertainty.

An equivalent may be broadly defined as a device having substantially the same function, mode of operation and result as another which has preceded it in point of time. The determination of the question of equivalency

279. Mr. Justice Brown, in Mast, Foos & Co. v. Stover Mfg. Co., 177 U. S. 485, 494, 44 L. Ed. 856, 860.

280. Smith v. Nichols, 21 Wall. 112, 119, 22 L. Ed. 566.

depends upon the advancement of the art at the time the question is raised, and is, therefore largely dependent upon the state of the art.[281]

Is not the application of this rule, however, addressed to the question of novelty, rather than invention? It is, within the true meaning of the term "novelty" in the patent law. It serves to illustrate the distinction between mere novelty and patentable novelty. In a young art, a degree of novelty may be patentable which in an older art would not. This is merely the reverse of the axiom that a pioneer patent is entitled to a broader range of equivalency than one which is secondary in character.

§ 162. Rule XIX. Mere omission of parts with corresponding loss of function, is not invention.

"A reconstruction of the machine so that a less number of parts will perform all the functions of the greater may be invention of a high order, but the omission of a part, with a corresponding omission in function, so that the retained parts do just what they did before in the combination, cannot be other than a mere matter of judgment, depending upon whether it is desirable to have the machine do all or less than it did before."[282] In affirming the case from the opinion in which this statement of the rule is quoted, Mr. Justice Brown said: "We are satisfied that a mere severance of the double spring does not involve invention, at least in the absence of conclusive evidence that the single spring performs some new and important function not performed by it in the prior patent."[283]

281. Crouch v. Roemer, 103 U. S. 797, 26 L. Ed. 426, 13 Brodix 165; Perry v. Co-operative Foundry Co., 12 Fed. Rep. 436, 438.

282. Blodgett, J., in McClain v. Ortmayer, 33 Fed. Rep. 284, 287, following, Stow v. Chicago, 8 Biss. 47, 3 B. & A. 91, Fed. Case No. 13,512.

283. McClain v. Ortmayer, 141 U. S. 419, 425, 35 L. Ed. 800, 804.

§ 163. Rule XX. The new combination of old devices without a resulting new mode of operation is not invention.

"Neither is it invention to combine old devices into a new article without producing any new mode of operation."[284]

This rule appears to be based upon the theory that absence of novelty in the mode of operation negatives the presence of novelty in function or result.

§ 164. Rule XXI. To use an old composition of matter,[285] design,[286] machine,[287] manufacture,[288] or process,[289] for a new but analogous purpose (double use) is not invention.

284. Burt v. Evory, 133 U. S. 349, 356, 33 L. Ed. 647, 20 Brodix 133, 146, 50 O. G. 1294.

285. Hoskins v. Matthews, 108 Fed. Rep. 404, 47 C. C. A. 434.

286. Smith v. Whitman Saddle Co., 148 U. S. 674, 37 L. Ed. 606; Untermeyer v. Freund, 58 Fed. Rep. 205, 7 C. C. A. 183; Bevin Bros. Mfg. Co. v. Starr Bros. Bell Co., 114 Fed. Rep. 362, 363; Cahoone-Barnett Mfg. Co. v. Rubber & Celluloid Harness Co., 45 Fed. Rep. 582.

287. Pennsylvania R. R. Co. v. Locomotive Truck Co., 110 U. S. 480, 28 L. Ed. 222; Blake v. San Francisco, 113 U. S. 679, 28 L. Ed. 1070; Hendy v. Golden State Iron Works, 127 U. S. 370, 32 L. Ed. 207; Aron v. Manhattan Ry. Co., 132 U. S. 84, 33 L. Ed. 272; Howe Mach. Co. v. National Needle Co., 134 U. S. 388, 33 L. Ed. 963; Fond de Lac Co. v. May, 137 U. S. 395, 34 L. Ed. 714; Bussell Trimmer Co. v. Stevens, 137 U. S. 423, 34 L. Ed. 719; Wollensak v. Sargent, 151 U. S. 221, 38 L. Ed. 137; Gates Iron Works v. Fraser, 153 U. S. 332, 38 L. Ed. 734; Mast, Foos & Co. v. Stover Mfg. Co., 177 U. S. 485, 44 L. Ed. 856; Seiler v. Fuller, 121 Fed. Rep. 85, 57 C. C. A. 339.

288. Peters v. Active Mfg. Co., 129 U. S. 530, 32 L. Ed. 738; Peters v. Hanson, 129 U. S. 541, 32 L. Ed. 742; St. Germain v. Brunswick, 135 U. S. 227, 34 L. Ed. 122; Patent Clothing Co. v. Glover, 141 U. S. 560, 35 L. Ed. 858; Ansonia Co. v. Electrical Supply Co., 144 U. S. 11, 18, 36 L. Ed. 327; Browning v. Colorado Telephone Co., 61 Fed. Rep. 845, 10 C. C. A. 112.

289. King v. Gallun, 109 U. S. 99, 27 L. Ed. 870; Miller v. Foree, 116 U. S. 22, 29 L. Ed. 552; Dreyfus v. Searle, 124 U. S. 60, 31 L. Ed. 352; Crescent Brewery Co. v. Gottfried, 128 U. S. 158, 32 L. Ed. 390; Marchand v. Emken, 132 U. S. 195, 33 L. Ed. 332; Lovell Mfg. Co. v. Cary, 147 U. S. 623, 37 L. Ed. 307; DeLamar v. DeLamar 117 Fed. Rep. 240, 54 C. C. A. 272; Baker v. Duncombe, 146 Fed. Rep. 744, 77 C. C. A. 234.

"The mere mechanical adaptation of an old device to an analogous use is not invention, while a new application in a different art, whereby a new and distinct result is produced, will be."[200]

It is no objection, however, to the validity of a patent for a new article of manufacture that it is the result of an operation of an old machine, where it is not the only thing that can be made on the machine, and the instruction of the patent is necessary to enable the workman to produce it.[201]

To give to an old combination a new mode of operation may be invention,[202] even if the function of the combination is old.[203]

The rule as to double use is sometimes stated as "the mere transfer of a device from one field to an analogous use, without change of function."[204]

§ 165. Non-analogous uses.

The rule as to double use turns entirely upon the analogy between the uses. If the new use is remote from, and non-analogous to the old, the new use may create a patentable entity, if, in the opinion of the court, it has been developed by the exercise of the inventive faculty.[205]

290. Archbald, J., in Diamond Drill & Machine Co. v. Kelly Bros., 120 Fed. Rep. 289, 292.

291. Lamb Knit Goods Co. v. Lamb Glove & Mitten Co., 56 C. C. A. 547, 120 Fed. Rep. 267, 272.

292. Keystone Mfg. Co. v. Adams, 151 U. S. 139, 142, 38 L. Ed. 103.

293. Deere & Co. v. Rock Island Plow Co., 84 Fed. Rep. 171, 176, 28 C. C. A. 308.

294. Putnam, J., in Cushman v. Goddard, 95 Fed. Rep. 665, 37 C. C. A. 221.

295. Bussell v. Stevens, 137 U. S. 423, 34 L. Ed. 719; Potts v. Creager, 155 U. S. 597, 39 L. Ed.

The questions for determination are; first, are the arts or uses closely allied, remotely allied, or wholly unallied, and, second, did the application to the new use involve invention.[296] The question of the analogy of the uses will turn on the peculiar facts of each case.[297]

§ 166. Rule XXII. Mere mechanical excellence is not invention.

"A patent only for superior workmanship—within all the authorities is invalid."[298] In other words, this rule applies to devices which are new merely in their mechanical perfection; or, in the language of Judge Wallace, "if it is new only in the sense that it embodies and represents superior workmanship, or is an improvement upon an old article in (degree and) excellence, within all authorities the claim is invalid."[299]

This rule is a paraphrase of the rule of § 152, which should be read with it. This rule looks to the result, the former, to the means whereby that result is attained.

§ 167. Rule XXIII. Mere substitution of materials is not invention.

In the leading case under this rule, Mr. Justice Nelson said: "No one will pretend 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, can be distinguished from the old one; or,

275; National Cash Register Co. v. Boston Cash Indicator & Recorder Co., 156 U. S. 502, 515, 39 L. Ed. 511, 516.

296. Tannage Patent Co. v. Zahn, 70 Fed. Rep. 1003, 17 C. C. A. 552.

297. Briggs v. Duell, 93 Fed. Rep. 972, 36 C. C. A. 38.

298. Mr. Justice Brown in Risdon Iron & Locomotive Works v. Medart, 158 U. S. 68-81, 39 L. Ed. 899, 904.

299. Edison v. American Mutoscope Co., 114 Fed. Rep. 926, 935, 52 C. C. A. 546.

in the sense of the patent law, can entitle the manufacturer to a patent. The difference is formal, and destitute of ingenuity of invention. It may afford evidence of judgment and skill in the selection and adaptation of the materials in the manufacture of the instrument for the purpose intended, but nothing more."[300]

§ 168. Rule XXIV. To merely make a machine portable is not invention.

"Merely putting rollers under an article, so as to make it movable, when, without the rollers, it would not be movable, does not involve the inventive faculty, and is not patentable."[301]

The rule applies even where "the fact that the machine is portable undoubtedly adds to its usefulness."[302]

This rule is akin to those of §§ 152, 166.

§ 169. Rule XXV. Mere improvement in degree is not invention.

In speaking of a patent involving stone blocks having sides with rough surfaces, Mr. Chief Justice Waite said: "The change was only in degree and, consequently, not patentable."[303]

300. Hotchkiss v. Greenwood, 11 Howard 248, 266, 13 L. Ed. 683, 690. To the same effect, see, Hicks v. Kelsey, 18 Wall. 670, 21 L. Ed. 852; Dunbar v. Meyers, 94 U. S. 187, 24 L. Ed. 34, 11 Brodix 59, 11 O. G. 35.

301. Mr. Justice Blatchford, in Hendy v. Golden State and Miners' Iron Works, 127 U. S. 370, 32 L. Ed. 207, 18 Brodix 588, 43 O. G. 1117. To the same effect, see, Atlantic Works v. Brady, 107 U. S. 192, 27 L. Ed. 438, 14 Brodix 830, 23 O. G. 1330; Thompson v. Boisselier, 114 U. S. 1, 29 L. Ed. 76, 31 O. G. 377, 15 Brodix 549; Yale Lock Mfg. Co. v. Greenleaf, 117 U. S. 554, 29 L. Ed. 952, 35 O. G. 386, 16 Brodix 303; Pomace Holder Co. v. Ferguson, 119 U. S. 335, 30 L. Ed. 406, 37 O. G. 1479, 16 Brodix 441.

302. Mr. Justice Brown, in Black Diamond Coal Mining Co. v. Excelsior Coal Co., 156 U. S. 611, 617, 39 L. Ed. 553, 70 O. G. 1797.

303. Guidet v. Brooklyn, 105 U. S. 550, 26 L. Ed. 1106, 14 Brodix 38, 21 O. G. 1692. Mere changes in "degree, proportion or symmetry" are not invention. Torrey v. Hancock (C. C. A.), 184 Fed. Rep. 61, 70.

In the language of Mr. Justice Lamar, "a mere carrying forward or more extended application of an original idea—a mere improvement in degree—is not invention."[304]

This rule is based upon the theory that all improvements in degree must necessarily fall within the domain of mere mechanical skill. Yet improvement in degree may mean the last step, or the difference between success and failure, in which case it is certainly invention, and may be invention of the highest order.[305]

§ 170. Rule XXVI. Mere aggregation is not invention.[306]

304. Burt v. Evory, 133 U. S. 349, 358, 33 L. Ed. 647, 20 Brodix 133, 146, 50 O. G. 1294; see 9 U. S. E. 169.

305. The Barbed Wire Patent, 143 U. S. 275, 36 L. Ed. 154.

306. Double-Pointed Tack Co. v. Two Rivers Mfg. Co., 3 Fed. 26, 9 Biss. 258; Moffitt v. Rogers, 9 Fed. 147 (affirmed in 106 U. S. 423, 27 L. Ed. 76); Doubleday v. Roess, 11 Fed. 737; Tower v. Bemis, etc., Hardware, etc., Co., 19 Fed. 498; Schmid v. Scovill Mfg. Co., 37 Fed. 345; Jones v. Clow, 39 Fed. 785; Richards v. Michigan Cent. R. Co., 40 Fed. 165; Rapid Service Store R. Co. v. Taylor, 43 Fed. 249; Young v. Jackson, 43 Fed. 387; National Progress Bunching Machine Co. v. John R. Williams Co., 44 Fed. 190, 12 L. R. A. 107; Campbell v. Bailey, 45 Fed. 564 (affirmed in 63 Fed. 463, 11 C. C. A. 284); Mott Iron Works Co. v. Standard Mfg. Co., 53 Fed. 819, 4 C. C. A. 28; Deere v. J. I. Case Plow Works, 56 Fed. 841, 6 C. C. A. 157; Office Specialty Mfg. Co. v. Globe Co., 65 Fed. 599 (affirmed in 77 Fed. 465, 23 C. C. A. 242); Osgood Dredge Co. v. Metropolitan Dredging Co., 75 Fed. 670, 21 C. C. A. 491; Clisby v. Reese, 88 Fed. 645, 32 C. C. A. 80; Smith v. Maxwell, 93 Fed. 466; Campbell Printing-Press, etc., Co. v. Duplex Printing-Press Co., 101 Fed. 282, 41 C. C. A. 351; Gast v. New York Asbestos Mfg. Co., 105 Fed. 68; Wellman v. Midland Steel Co., 106 Fed. 221; West Coast Safety Faucet Co. v. Jackson Brewing Co., 117 Fed. 295, 54 C. C. A. 533; Rich v. Baldwin, 133 Fed. 920, 66 C. C. A. 464; Cameron Septic Tank Co. v. Saratoga Springs, 151 Fed. 242 (reversed on other grounds in 159 Fed. 453); Hailes v. Van Wormer, 20 Wall. (87 U. S.) 353, 22 L. Ed. 241; Reckendorfer v. Faber, 92 U. S. 347, 23 L. Ed. 719; Rubber-Coated Harness Trimming Co. v. Welling, 97 U. S. 7, 24 L. Ed. 942; Pickering v. McCullough, 104 U. S. 310, 26 L. Ed. 749; Bussey v. Excelsior Mfg. Co., 110 U. S. 131, 28 L. Ed. 95; Beecher Mfg. Co. v. Atwater Mfg. Co., 114 U. S. 523, 29 L. Ed. 232; Thatcher Heat-

This rule relates only to combination claims, and the full doctrine is thus stated by Mr. Justice Hunt: "The combination, to be patentable, must produce a different force or effect, or result in the combined forces or processes, from that given by their separate parts. There must be a new result produced by their union; if not so, it is only an aggregation of separate elements."[307]

The distinction between an aggregation and a patentable combination of elements may be better understood by reference to the language of two of the ruling cases.

"All the devices of which the alleged combination is made are confessedly old. No claim is made for any one of them singly, as an independent invention. It may be conceded 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 the results must be a product of the combination, and not a mere *aggregate* of several results, each the complete product of one of the combined elements. Combined results are not necessarily a novel result, nor are they an old result obtained in a new and improved manner. Merely bring-

ing Co. v. Burtis, 121 U. S. 286, 30 L. Ed. 942; Hendy v. Golden State, etc., Iron Works, 127 U. S. 370, 32 L. Ed. 207; Burt v. Evory, 133 U. S. 349, 33 L. Ed. 647; Fond du Lac County v. May, 137 U. S. 395, 34 L. Ed. 714; Bussel Trimmer Co. v. Stevens, 137 U. S. 423, 34 L. Ed. 719; Union Edge-Setter Co. v. Keith, 139 U. S. 530, 35 L. Ed. 261; Cluett v. Claflin, 140 U. S. 180, 35 L. Ed. 385; Adams v. Bellaire Stamping Co., 141 U. S. 539, 35 L. Ed. 849; Patent Clothing Co. v. Glover, 141 U. S. 560, 35 L. Ed. 858; Derby v. Thompson, 146 U. S. 476, 36 L. Ed. 1051; Brinkerhoff v. Aloe, 146 U. S. 515, 36 L. Ed. 1068; Ide v. Ball Engine Co., 149 U. S. 550, 37 L. Ed. 843; Giles v. Heysinger, 150 U. S. 627, 37 L. Ed. 1204; Wright v. Yuengling, 155 U. S. 47, 39 L. Ed. 64; Palmer v. Corning, 156 U. S. 342, 39 L. Ed. 445; Richards v. Chase Elevator Co., 158 U. S. 299, 39 L. Ed. 991; Richards v. Chase Elevator Co., 159 U. S. 477, 40 L. Ed. 225.

307. Reckendorfer v. Faber, 92 U. S. 347-357, 23 L. Ed. 719, 10 Brodix 373, 398.

ing old devices into juxtaposition, and then allowing each to work out its own effect, without the production of something novel, is not invention."[308]

"A combination of well known separate elements, each of which, when combined, operates separately and in its old way, and in which no new result is produced which cannot be assigned to the independent action of one or the other of the separate elements, is an aggregation of parts merely, and is not patentable; but if to adapt the several elements to each other, in order to effect their co-operation in one organization, demands the use of means without the range of ordinary mechanical skill, then the invention of such means to effect the mutual arrangement of the parts would be patentable. The parts need not act simultaneously, if they act unitedly to produce a common result. It is sufficient if all the devices co-operate with respect to the work to be done and in furtherance thereof, although each device may perform its own particular function only."[309]

As to the method of determining whether a given group of elements are a valid combination or an aggregation, Judge Archbald has said: "The test is whether there is a new unitary result, to the production of which the different elements co-act."[310] This may be a test of aggregation; it is certainly an exacting test. But it is far from being the only test. And it is not vital that there should be a new result—it is enough that an old result is produced with a new economy of time, power, or other elements of cost.

308. Strong, J., in Hailes v. Van Wormer, 20 Wall. (U. S.) 353, 22 L. Ed. 241.

309. Morrow, J., in Standard Oil Co. v. Southern Pacific Co., 54 Fed. Rep. 521, 4 C. C. A. 393.

310. Novelty Glass Co. v. Brookfield, 170 Fed. Rep. 946, 954, 95 C. C. A. 516.

§ 171. Rule XXVII. Mere duplication of parts is not invention.[311]

The application of this rule is limited to instances where the duplication of parts does not produce a new mode of operation.[312]

§ 172. Rule XXVIII. Difference of form and arrangement which produces nothing new in function, result, or mode of operation, is not invention.[313]

The selection and rearrangement of old elements to produce a machine new in form but old in function, is not invention.[314]

"Neither is it invention to combine old devices into a new article without producing any new mode of operation."[315]

"In a patentable combination of old elements, all the constituents must so enter into it as that each qualifies every other. * * * It must form either a new machine of a distinct character and function, or produce a result due to the joint and co-operating action of all the elements, and which is not the mere adding together of separate contributions. Otherwise, it is only a mechanical juxtaposition, and not a vital union."[316]

§ 173. Rule XXIX. To change the sequence of operations in a mechanical method without accomplishing a new result is not invention.

In the leading case upon this question, the method of the patent in suit differed from one of the methods of

311. Dunbar v. Myers, 94 U. S. 187, 24 L. Ed. 34.

312. Parker v. Hulme, 1 Fisher 44, Fed. Case No. 10,740.

313. Interior Lumber Co. v. Perkins, 80 Fed. Rep. 528, 531, 25 C. C. A. 613.

314. Greist Mfg. Co. v. Parsons, 60 C. C. A 34, 125 Fed. Rep. 116, 119.

315. Mr. Justice Lamar, in Burt v. Evory, 133 U. S. 349, 33 L. Ed. 647.

316. Mr. Justice Matthews, in Pickering v. McCullough, 104 U. S. 310, 318, 26 L. Ed. 749, 751, 13 Brodix 238, 267.

the prior art relating to the manufacture of paper bags, in that the material of the bellows fold was bent inward as soon as the tube was distended. Although there was a resulting economy in material, the court held that the change did not embody invention.[317]

§ 174. Rule XXX. "Invention is not disclosed by merely making in a single piece a device or connection which previously had been made of separate parts."[318]

This rule is merely a concrete application of the general rule that invention must embody something more than mere mechanical skill. "Nor would the mere fact that the one-piece device was cheaper or more durable constitute invention when such results were merely such ordinary consequences of dispensing with joints as would naturally be anticipated by the workman."[319]

§ 175. Rule XXXI. Where the prior art discloses the two elements of the alleged invention in combination, one fixed and the other movable, to make the first movable and the second stationary is not invention.

An illustration is the printing-press patent which made the type bed stationary under traveling cylinders, instead of having the type bed movable beneath a stationary cylinder.[320]

317. Union Paper Bag Machine Co. v. Waterbury, 17 C. C. A. 84, 70 Fed. Rep. 240, 241.

318. Hazel, J., in Keepers v. American Electric Fuse Co., 177 Fed. Rep. 442; citing and following, General Electric Co. v. Yost Electric Co., 131 Fed. Rep. 874; affirmed in General Electric Co. v. Yost Electric Co., 139 Fed. Rep. 568, 71 C. C. A. 552. To the same effect, see Howard v. Detroit Stove Works, 150 U. S. 164, 32 L. Ed. 1039; Standard Caster & Wheel Co. v. Caster Socket Co., 113 Fed. Rep. 162, 51 C. C. A. 109.

319. Townsend, J., in General Electric Co. v. Yost Electric Co., 139 Fed. Rep. 568, 570; citing Consolidated Electric Mfg. Co. v. Holtzer, 67 Fed. Rep. 907, 15 C. C. A. 63.

320. Campbell Printing Press Co. v. Duplex Printing Press Co., 101 Fed. Rep. 282, 293, 41 C. C. A. 351.

The reason of the rule is obvious. The change is one which under any state of facts so far presented to the courts is a mere mechanical expedient, and while circumstances might arise in which the change would amount to invention, the rule is well established in the cases.[321]

§ 176. Rule XXXII. The use of old elements does not negative invention.

This rule is a necessary sequence of the rule that as to a combination claim the elements comprised in that claim are conclusively presumed, as a matter of law, to be old, whether they are old in fact or not; thus Judge Baker has said: "The failure to claim either one of the elements separately raises the presumption that no one of them is novel,"[322] and Judge Woods has said: "When a combination is claimed, there arises an implied concession that the elements are old, and not separately patentable."[323]

In support of the main rule, as stated above, Judge Rellstab has said: "The use of the old elements does not prevent the possibility of invention. It is perfectly well settled that a new combination of elements old in themselves, but which produces a new and useful result, entitles the inventor to the protection of a patent."[324]

321. Sargent v. Larned, 2 Curtis 340, Fed. Case 12,364; Abbott Machine Co. v. Bonn, 51 Fed. Rep. 223; Devlin v. Paynter, 64 Fed. Rep. 398, 12 C. C. A. 188; Duner Co. v. Grand Rapids R. Co., 171 Fed. 863, 96 C. C. A. 531; Union Paper Bag Mach. Co. v. Murphy, 97 U. S. 120, 24 L. Ed. 935.

322. Campbell v. Conde Implement Co., 74 Fed. Rep. 745.

323. Hay v. Heath Cycle Co., 71 Fed. Rep. 411-413, 18 C. C. A. 157.

324. Steiner & Voegtly Hdw. Co. v. Tabor Sash Co., 178 Fed. Rep. 839; citing Webster Loom Co. v. Higgins, 105 U. S. 580, 26 L. Ed. 1177; Expanded Metal Co. v. Bradford, 214 U. S. 366, 53 L. Ed. 1034.

§ 177. Rules in affirmance of invention.

In the consideration of the foregoing rules, which have been evolved by the development of patent litigation, we find them to be destructive in character. That is to say, beginning with the general premise before referred to, that "invention" cannot be defined, the preceding group of rules have all related to the negation of the existence of invention.

But just as invention is constructive, and not destructive, we find that the courts have established a correlative set of rules which are affirmative in character, and relate to those conditions surrounding an art which tend to establish the existence of invention in a new creation in that art.

§ 178. Rule I. Proof of the existence of a need in the art, and that it was supplied by the device of the patent, is evidence of invention.[325]

This rule lies at the foundation of the consideration of the presence or absence of invention. It is the purpose of the patent laws to encourage the progress of the arts. It seldom falls to the lot of the inventor to create a new need. The telephone and telegraph did not create the need of quick means of conveying messages. The need was co-existent with the beginning of the human race. Every system of transmitting thought to a distance from the foot messenger to wireless telegraphy was but an answer to that need. The extent to which the novel creation responds to the need is important, but not vital, under the other rules of the series we are now considering.

325. The Barbed Wire Patent, 143 U. S. 275, 283, 36 L. Ed. 154.

§ 179. Rule II. Proof of the fact that others have made unsuccessful attempts to fill a need in the art is evidence of invention on the part of the creator of the means of satisfying that need.[326]

This is a wholesome rule. The ineffectual efforts of others to accomplish the result are certainly material upon the question of invention. The ability of the unsuccessful ones must be considered. Where they were skilled in the art, it is hard to reach the conclusion that the ultimate production of the needed thing merely involved the exercise of mechanical skill.

§ 180. Rule III. Proof of extensive sales [327] and "public approbation" [328] of the new creation is usually evidence of the existence of invention.

326. Terry Clock Co. v. New Haven Clock Co., Fed. Case No. 13,840, 4 Bann. & Ard. 121; Wallace v. Noyes, 13 Fed. Rep. 172; Ward v. Plow Co., 14 Fed. Rep. 696; Davis v. Fredericks, 19 Fed. Rep. 99; Patterson v. Duff, 20 Fed. Rep. 641; Brown Mfg. Co. v. Deere, 21 Fed. Rep. 709; McFarland v. Spencer, 23 Fed. Rep. 150; Celluloid Mfg. Co. v. Chrolithion Collar & Cuff Co., 23 Fed. Rep. 397; Sewing Machine Co. v. Frame, 24 Fed. Rep. 596; Asmus v. Alden, 27 Fed. Rep. 684; Adee v. Peck, 42 Fed. Rep. 497; American Cable Ry. Co. v. New York, 56 Fed. Rep. 149; Stohlmann v. Parker, 53 Fed. Rep. 925; Westinghouse v. Air-Brake Co., 59 Fed. Rep. 581; Electric Railway Co. v. Jamaica R. R. Co., 61 Fed. Rep. 655.

327. Smith v. Goodyear Dental Vulcanite Co., 93 U. S. 486, 23 L. Ed. 952; Hollister v. Benedict Mfg. Co., 113 U. S. 59, 28 L. Ed. 901; Adams v. Bellaire Stamping Co., 141 U. S. 539, 35 L. Ed. 849; Magowan v. New York Belting Co., 141 U. S. 332, 35 L. Ed. 781; Gandy v. Main Belting Co., 143 U. S. 587, 36 L. Ed. 272; Barb Wire Patent, 143 U. S. 275, 36 L. Ed. 154; Sessions v. Romadka, 145 U. S. 29, 36 L. Ed. 609; Topliff v. Topliff, 145 U. S. 156, 36 L. Ed. 658; National Hat Pouncing Machine Co. v. Hedden, 148 U. S. 432, 37 L. Ed. 529; Krementz v. S. Cottle Co., 148 U. S. 556, 37 L. Ed. 558; Duer v. Corbin Cabinet Lock Co., 149 U. S. 216, 37 L. Ed. 707; Keystone Mfg. Co. v. Adams, 151 U. S. 139, 38 L. Ed. 103; Olin v. Timken, 155 U. S. 141, 39 L. Ed. 100; Potts v. Creager, 155 U. S. 597, 39 L. Ed. 275.

328. Johnson v. Johnston, 60 Fed. Rep. 618, 621.

This is so, because the fact of large sales is some evidence that the need existed, and that the matter of the patent served for the first time to satisfy that need, or at least to fill it in an adequate manner.

But the effect of evidence of this kind may be destroyed by showing that the sales were due not to the superior merits of the thing sold, but to skillful advertising and the like,[329] or by proof that the patented article was manufactured with a peculiarly attractive finish, or sold under an "alluring trademark."[330]

In applying this rule, the qualification must be borne in mind, that (in the language of Judge Ray) "the test of invention is mental conception, not large sales, or improved results, or benefits conferred upon mankind."[331]

329. McClain v. Ortmayer, 141 U. S. 419, 35 L. Ed. 800; Fox v. Perkins, 52 Fed. Rep. 205; Billings & Spencer Co. v. Van Wagoner & Williams Hardware Co., 98 Fed. Rep. 732; Duer v. Lock Co., 149 U. S. 216; Saunders v. Allen, 60 Fed. Rep. 610-612, 9 C. C. A. 157.

330. Stahl v. Williams, 64 Fed. Rep. 121, 123; Richardson v. American Pin Co., 73 Fed. Rep. 476, 480.

331. American Laundry Mach. Co. v. Adams Laundry Mach. Co., 161 Fed. Rep. 556, 563.

CHAPTER VII.

NOVELTY.

§ 181. Introducing the Rules as to Novelty.

Letters patent depend for their validity (apart from the question of invention) upon the novelty and utility of the thing patented. As to novelty, the patent may be anticipated, and if not anticipated, it may yet be void for want of patentable novelty. The following groups of rules therefore, relate respectively to novelty, anticipation and utility.

Section 4886, R. S. U. S., provides that "Any person who has invented or discovered any new and useful art, machine, manufacture or composition of matter, or any new and useful improvement thereof, not known or used by others in this country, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof, and not in public use or on sale for more than two years prior to his application, unless the same is proved to be abandoned, may * * * obtain a patent therefor." The twice-used expression "new and useful," relates to the broad questions of novelty and utility, which we have elsewhere considered. The thing of the patent may, as we have seen, be new in a commercial sense, while entirely lacking in novelty in the patentable sense.

Anticipation is almost as impossible of definition as is "invention."

RULES RELATING TO ANTICIPATION.

§ 182. Rule I. The defense of anticipation "must be established as of a date anterior to the patentee's invention or discovery; not merely prior to his application for, or the date of his patent,"[1] under the provisions of sections 4886 and 4920 of the Revised Statutes.

There are many reasons why the law should, as it does, allow the inventor to publicly practice his invention provided he applies for a patent before the subject-matter has been in public use or on sale for more than two years. The reasons for the rule of this section are equally cogent.

§ 183. Rule II. The grant of Letters Patent creates a prima facie presumption of patentable novelty.

"The presumption of novelty arising from the patent must be overcome."[2]

This has been considered in connection with the other presumptions arising from the grant, *ante*, § 18.

§ 184. Rule III. The test of novelty is the same in the case of an article of manufacture as it is in that of a machine.[3]

This rule appears self-evident. The statute makes no distinction, as to the requirement of novelty, between the several classes of patentable subject-matter.

1. Morrow, J., in Von Schmidt v. Bowers, 80 Fed. Rep. 140; citing Plow Works v. Starling, 140 U. S. 198, 11 Sup. Ct. 803; Clark Thread Co. v. Willimantic Linen Co., 140 U. S. 492, 11 Sup. Ct. 846; Loom Co. v. Higgins, 105 U. S. 592; Kneeland v. Sheriff, 2 Fed. 901; Woodman v. Stimpson, 3 Fish. Pat. Cas. 105, Fed. Case No. 17,979.

2. Coxe, J., in Michael & Wildman Mfg. Co. v. Stafford, 105 Fed. Rep. 380, 382; and to the same effect, see Johnson v. Johnston, 60 Fed. Rep. 618, 621.

3. Campbell v. Bayley, 11 C. C. A. 284, 63 Fed. Rep. 463, 465.

§ 185. Rule IV. That every element of a combination is old is not conclusive against the novelty of the combination;[4] for each element is conclusively presumed to be old.

"When a combination is claimed, there arises an implied concession that the elements are old, and not separately patentable."[5]

That the use of old elements does not negative invention, see *ante*, § 176.

§ 186. Rule V. A combination may be void for want of novelty, even though the same elements cannot be shown to have been used before in the same relation to each other.[6]

§ 187. Rule VI. It is necessary to the validity of a patent that its subject-matter must neither be an obvious or natural suggestion of what preceded in the art, nor fairly or logically deducible from any or all of the prior forms of construction.[7]

§ 188. Rule VII. A great public demand for the patented article is highly persuasive evidence of patentable novelty and is generally controlling.[8]

This rule should be read in connection with that of § 307, *post*, for an understanding of the close inter-relation of novelty and utility.

§ 189. Rule VIII. A patent may be held invalid for want of novelty though that defense is not set up in the answer.[9]

The reason for this rule is clear. In every determination of the validity or scope of letters patent the rights of the public are paramount to the rights of the parties

4. Allen v. Grimes, 89 Fed. Rep. 869.

5. Woods, J., in Hay v. S. F. Heath Cycle Co., 71 Fed. Rep. 411, 413, 18 C. C. A. 157.

6. Kelly v. Clow, 32 C. C. A. 205, 89 Fed. Rep. 297, 303.

7. Williams v. American String Wrapper Co., 30 C. C. A. 318, 86 Fed. Rep. 641; Antisdel v. Chicago Hotel Cabinet Co., 32 C. C. A. 216, 89 Fed. Rep. 308, 313.

8. Hill v. Biddle, 27 Fed. Rep. 560; Johnson v. Johnston, 60 Fed. Rep. 618, 621.

9. Richards v. Chase Elevator Co., 159 U. S. 471, 40 L. Ed. 225.

litigant. If the court becomes satisfied that the alleged invention was of common right at the time of the application for Letters Patent, its duty to the public is clear. There has been a failure of consideration and the resulting grant is invalid.

§ 190. Rule IX. A defendant who has offered a large sum of money for the patent cannot consistently raise the defense of want of novelty.[10]

This rule savors of estoppel by conduct.

§ 191. Rule X. Patentable novelty must be distinguished from commercial novelty.

"A distinction must be observed between a new article of commerce and a new article which, as such, is patentable. Any change in form from a previous condition may render the article new in commerce; as powdered sugar is a different article in commerce from loaf sugar, and ground coffee is a different article in commerce from coffee in the berry. But to render the article new in the sense of the patent law, it must be more or less efficacious, or possess new properties by a combination with other ingredients; not from a mere change of form produced by a mechanical division. It is only where one of these results follows that the product of the compound can be treated as the result of invention or discovery, and be regarded as a new and useful article."[11]

§ 192. Rule XI. The question of novelty relates back to the date of invention and is not fixed by the date of the application.[12]

This rule is based upon the same reasoning as the time rule concerning anticipation, *ante*, § 182.

10. Bostock v. Goodrich, 21 Fed. Rep. 316.

11. Mr. Justice Field in Milligan and Higgins Glue Co. v. Upton, 97 U. S. 3, 6, 24 L. Ed. 985, 988.

12. Klein v. Russell, 19 Wall. 433, 22 L. Ed. 116.

§ 193. Rule XII. A device which is a lost art will not negative novelty.[13]

This doctrine, manifestly, can seldom be invoked. When it is, it is based upon the fact that it was not at hand for the public to do what the inventor has done, that he has not patented that which was of common right, and that by disclosing to the public knowledge of a lost thing, his service is as worthy of reward as if that thing had never before been known.

The age of the alleged anticipating device as an impairment of its anticipatory value.

There are in the cases some dicta which hold that the age of the prior device urged as an anticipation is to be considered as diminishing its effect. Thus, Judge Buffington has said "under ordinary circumstances, a patent which caused no advance in its art should have small effect upon a successful patent of twenty years later;"[13a] and Judge Sanborn, of the Seventh Circuit, has said "like gravitation, it (the anticipatory effect of the alleged anticipation) decreases according to the square of the distance. Certainly a patent which caused no advance in the art should have but little effect on a successful one of fifty years later."[13b] These dicta do not seem to accord with the spirit of the patent statutes, or with the great weight of the authorities. For example, see the case in which the United States patent Number 705,715 of July 29, 1902 was held anticipated by the British patent Number 10,938 of 1845;[13c] the case in which the United States patent Number 256,504 of 1882 was held

13. Gayler v. Wilder, 10 How. 477, 13 L. Ed. 504.

13a. Daylight Glass Mfg. Co. v. American Prismatic Light Co., 142 Fed. Rep. 454, 459, 73 C. C. A. 570.

13b. Toledo Computing Scale Co. v. Moneyweight Scale Co., 178 Fed. Rep. 557, 564.

13c. Stuart v. Auger & Simon Silk Dyeing Co., 149 Fed. Rep. 748, 79 C. C. A. 60.

anticipated by Geiger's Handbuch der Pharmacie, published in the year 1830 at Stuttgart, Germany;[13d] and the illustrations might be multiplied indefinitely. The fact that the patent set up as anticipatory "caused no advance in its art" may with propriety be considered in weighing its effect. Its early date would seem to be no detriment to its evidentiary value.

§ 194. Rule XIII. The question of novelty is one of fact for the jury.[14]

This matter is considered at length, *post*, § 333.

§ 195. Rule XIV. The burden of proof is upon the defendant alleging anticipation to establish both priority of conception and reduction to practice.

"When the defense of anticipation is set up, it is unquestionable that the defendant is charged, not only with the burden of proof upon that issue, but priority of conception and reduction to practice must be clearly made out, by well-authenticated evidence to defeat the patent."[15]

§ 196. Rule XV. "It is not sufficient to constitute anticipation, that the device relied on might, by modification, be made to accomplish the functions performed by the patent (in suit), if it were not designed by its maker, nor adapted, nor actually used, for the performance of such functions."[16]

13d. Rosenwasser v. Berry, 22 Fed. Rep. 841; Affirmed, in Rosenwasser v. Berry, 129 U. S. 47, 32 L. Ed. 628.

14. American Sales Book Co. v. Bullivant, 54 C. C. A. 287, 117 Fed. Rep. 255.

15. Seaman, J., in Consolidated Ry. Co. v. Adams & Westlake Co., 161 Fed. Rep. 343, 349, 88 C. C. A. 355.

16. Mr. Justice Brown, in Topliff v. Topliff, 145 U. S. 156, 36 L. Ed. 658.

§ 197. **Rule XVI. Prior use will not anticipate where it is "mere accidental use of some of the features of an invention, without recognition of its benefits."** [17]

§ 198. **Rule XVII. A prior patent does not anticipate if more than mere mechanical skill is necessary to be applied to it to produce the device of the patent in suit.**

The usual defense of want of invention here runs into the defense of anticipation. The defense of want of invention is almost always predicated upon the general disclosure of the prior art. The rule here stated applies when, singling out a patent of the prior art, it is attempted to build or produce the subject-matter of the patent in suit.

"The mechanical skill which may be invoked to exclude the idea of invention must be mechanical skill applied in accordance with the direction of the alleged anticipating patent; not the skill which, taught by the invention in suit, seeks to reform and reorganize the former patent, so disguising it under a cloud of subtlety of argument and suggestion as to transform it." [18]

§ 199. **Rule XVIII. If a prior patent has claims co-extensive with those of the patent in suit the latter is void.**

Double patenting, defined. The rule as to double patenting is simply that if two patents for the same invention are issued to the same, or different, patentees, the later patent is void.[19] This rule would seem self-explanatory.

17. Buffington, J., in Taylor Burner Co. v. Diamond, 72 Fed. Rep. 182, 185; to the same effect, see Ryan v. Newark Spring Mattress Co., 96 Fed. Rep. 100, 104.

18. Ideal Stopper Co. v. Crown Cork & Seal Co., 131 Fed. Rep. 244, 255, 65 C. C. A. 436.

19. Suffolk v. Hayden, 70 U. S. 315, 18 L. Ed. 76; James v. Campbell, 104 U. S. 356, 382, 26 L. Ed. 786; McCreary v. Pennsylvania Canal Co., 141 U. S. 459, 35 L. Ed. 817.

Only one grant of monopoly can be made for the same invention. When the term of the patent monopoly ceases, the right to make, use and sell the invention passes to the public. The grant of another and later patent for the same invention defeats the object of the patent statute by extending (or destroying, if the grant be to another patentee) the monopoly of the first patent. "Such an extension of the exclusive privileges would be a sheer abuse of the patent laws."[20] If more than two patents are issued for the same invention it follows that only the first is valid.[21]

How the question of identity is determined. The question of identity is necessarily a question of fact, and not of law. And it is by no means clear that identity is determined only by comparison of the claims of the earlier and later patents. Logically, it would seem that the claims should form the only basis of such a test, but to be interpreted, the claim must be analyzed in the light of the prior art, and the court is at liberty to avail itself of any testimony which may aid it in determining what the scope of the claim actually is. This is what is meant by the statement "no patent can rightfully issue for an invention actually covered by a former patent * * * although the terms of the claims may differ,"[22] and a clear illustration of proper judicial methods in determining the question of double patenting is found in a case where the court observes "the claims are certainly not expressly alike, * * * the testimony is in conflict," proceeds to recite his examina-

20. Acheson, J., in Reynolds v. Standard Paint Co., 68 Fed. Rep. 483, 487, 15 C. C. A. 516.

21. Suffolk v. Hayden, 3 Wall. (70 U. S.) 315, 18 L. Ed. 76; Miller v. Eagle, 151 U. S. 186, 197, 38 L. Ed. 121.

22. Acheson, J., in Reynolds v. Standard Paint Co., 68 Fed. Rep. 483, 485, 15 C. C. A. 516.

tion of the evidence, and his conclusion that double patenting was not present.[23]

In subjecting patents to the test under consideration "it will be presumed that the Patent Office acted understandingly."[24]

§ 200. Exact anticipation.

Anticipation is the disclosure in the prior art of a thing which is identical with, or equivalent to the device against which it is cited. It is doubtful, however, whether the definition should include equivalents. Probably anticipation only exists where the alleged anticipatory matter is identical with the thing against which it is urged. Thus, where the anticipatory thing is not identical with the subject of the subsequent patent, the patent is usually held to be void for want of patentable novelty, if the suggestions of the anticipatory matter are such as to enable one skilled in the art to produce the thing patented. If a patent is void for want of novelty, using novelty in its colloquial sense, it is because it is anticipated. If the patent is held void for "want of novelty," as that expression is commonly used in the decisions, it is generally because, though not anticipated, the degree of commercial novelty which it possesses is not a sufficient departure from the prior art to be patented. Thus we see that "want of patentable novelty" and "want of invention" are overlapping, if not identical, in meaning. The use of the word "anticipation" in the decisions, as will be indicated by the rules which we are about to examine, has a varying significance ranging all the way from literal and absolute anticipation to a point somewhere within the domain of the defense of "want of patentable novelty."

23. Tesla Electric Co. v. Scott, 97 Fed. Rep. 588, 598.

24. Kirkpatrick, J., in Ryan v. Newark Spring Mattress Co., 96 Fed. Rep. 100, 103.

It is obvious that the grant of a patent cannot deprive the public of the right to make and use and sell anything which is already public property. To permit a monopoly in such a matter to be subsequently acquired, would be at variance with the entire policy of our patent law.

It is equally obvious that to serve as an anticipation it is not necessary that the anticipatory thing should actually have been used by the public. It is sufficient that it was of common right to use it, or that it existed in the form of a publication so generally accessible as to be fairly a part of the common knowledge of the public.

§ 201. Rule XIX. Anticipation must be established as of a date prior to the patentee's invention, and not merely prior to the date of his application for patent.

"So far as the defense of anticipation is concerned, it must be established as of a date anterior to the patentee's invention or discovery; not merely prior to the application for, or the date of, his patent."[25]

This rule is merely a corollary to the rule that the inventor is entitled to his actual date of invention, if he has not abandoned his invention.

§ 202. Rule XX. That which infringes if later, would anticipate if earlier.

"The rule is now well established that 'that which infringes if later would anticipate if earlier.'"[26]

25. Morrow, J., in Von Schmidt v. Bowers, 80 Fed. Rep. 140; citing R. S. U. S., secs. 4886, 4920; Plow Works v. Starling, 140 U. S. 198, 11 Sup. Ct. 803; Clark Thread Co. v. Willimantic Linen Co., 140 U. S. 492, 11 Sup. Ct. 846; Loom Co. v. Higgins, 105 U. S. 592; Kneeland v. Sheriff, 2 Fed. Rep. 901; Woodman v. Stimpson, 3 Fish. Pat. Cas. 105, Fed. Cas. No. 17,979.

26. Judge Goff in Amer. Tobacco Co. v. Streat, 83 Fed. Rep 706; citing Heating Co. v. Burtis, 121 U. S. 286, 295, 7 Sup. Ct. 1034; Grant v. Walter, 148 U. S. 547. 544, 13 Sup. Ct. 699; Gordon v Warder, 150 U. S. 47, 14 Sup. Ct. 32.

This rule relates back to the question discussed in § 200. It is sound if "want of novelty" and "want of invention" are equivalent terms. Supposing the earlier device to have been mechanically and commercially unsuccessful, it would not anticipate. But as against a patent covering a successful machine or method, no defendant would dare to argue that he did not infringe because his machine or method was a failure. So we conclude that this rule must be read in the light of the general doctrines relating to infringement, or it will be misunderstood, and therefore dangerous.

§ 203. Rule XXI. To serve as an anticipation, the anticipatory matter must have been designed or adapted or actually used to perform the same functions as the subject-matter of the patent.

"It must be remembered, too, that an invention whether original or an improvement, is not anticipated by a thing which was, in its original form and use, neither designed, adapted nor actually used, to perform the same function as the thing covered by the patent does; and novelty is not negatived or overcome by any such consideration, nor by showing prior construction, or a similar thing for a wholly different and foreign use to which the patent is being applied."[27]

"It is not sufficient," said the court in Topliff v. Topliff, 145 U. S. 156, 12 Sup. Ct. 825, "to constitute anticipation, that the device relied on might, by modification, be made to accomplish the functions performed 'by that invention,' if it were not designed by its maker, nor adapted, nor actually used, for the performance of such functions." Following this guide, the Circuit Court for

27. Judge Clark in Kinnear & Gager v. Capital Sheet-Metal Co., 81 Fed. Rep. 492; citing Topliff v. Topliff, 145 U. S. 156, 12 Sup. Ct. 825.

the Western District of Pennsylvania held that "a mere accidental use of the features of an invention, without recognition of its benefits, does not anticipate a patent."[28]

§ 204. Rule XXII. An accidental result not contemplated by a former inventor cannot serve as an anticipation.

"An accidental result not contemplated by a former inventor cannot anticipate a later patent."[29]

"It may well have been that, before Stockheim was explained, some one may have filtered highly-charged beer under pressure successfully; the filter having been kept full of beer the while. But, so far as the evidence discloses, no one recognized that as the essential condition of a successful operation, or explained its function as a step in the process. One who accomplishes a result by a process which is only partially or not at all understood by him has invented nothing, and cannot deprive another, who afterwards discovers and proclaims the true principle of the operation, of the rights of an inventor."[30]

"If by chance any manufacturer of lace paper had accomplished the result in the way described in Karfiol's patent, it would seem to have been done inadvertently, and even at the present time not to have been appreciated as being a departure from the original and old methods of manufacture. This would not interfere with the patentability of Karfiol's idea, nor the validity of his patent."[31]

28. Kirkpatrick, J., in Ryan v. Newark Spring Mattress Co., 96 Fed. Rep. 100, 103, 104.

29. Colt, J., in Tannage Patent Co. v. Donallan, 93 Fed. Rep. 811, 821.

30. Gray, J., in German American Filter Co. v. Erdrich, 98 Fed. Rep. 300, 307.

31. Chatfield, J., in Karfiol v. Rothner, 165 Fed. Rep. 923, 926, following Tilghman v. Proctor, 102 U. S. 707, 26 L. Ed. 279.

§ 205. **Rule XXIII. The anticipating device should usually be found in the same art.**

"Anticipation ought not to be found in prior devices in the art to which a patent belongs unless they are of such a character as to have furnished clear, if not unmistakable, suggestion of the improvement in question; and if the anticipatory suggestion comes from another art it should, of course, have less significance, proportioned inversely to the distance from which it is brought."[32]

"A machine or combination which is not designed by its maker, nor actually used nor apparently adapted to perform the function of a patented machine or combination, but which is discovered in a remote art and was used under radically different conditions to perform another function, neither anticipates nor limits the scope of the patent."[33]

§ 206. **Rule XXIV. The mere secret practice of a process cannot serve as an anticipation.**

"It seems clear that Congress intended to benefit the American public by a grant of a patent to the individual who, believing himself to be the first inventor, was the first in fact to disclose such invention in this country. This is shown by a comparison of section 4923 with section 4886, of the Revised Statutes. I therefore understand the law on this subject to be that the mere secret practice of a process or the physical presence of a product or manufacture in this country is insufficient as an

32. Woods, J., in Williams v. American String-Wrapper Co., 86 Fed. Rep. 642.

33. Sanborn, J., in National Hollow B. B. Co. v. Interchangeable B. B. Co. (1901), 106 Fed. Rep. 693, 702, 45 C. C. A. 544; citing Ansonia Brass & Copper Co. v. Electrical S. Co., 144 U. S. 11, 18, 12 Sup. Ct. 601, 36 L. Ed. 327; Topliff v. Topliff, 145 U. S. 156, 161, 12 Sup. Ct. 825, 36 L. Ed. 658; Potts v. Creager, 155 U. S. 597, 608, 15 Sup. Ct. 194, 39 L. Ed. 275; Westinghause v. Air-Brake Co. (C. C.), 59 Fed. Rep. 581, 590.

anticipation unless and until the public acquires or has opportunity to acquire, therefrom, such knowledge as would enable one skilled in the art to practice the invention. Such alleged anticipation, whether by foreign printed publication or physical presence in this country, must so embody the complete patented article, or be so substantially like it, that a specification could be based thereon."[34]

But the mere fact that the anticipating device was so located as to be concealed from view does not make it a secret device, outside the law of public use.[35]

§ 207. Rule XXV. Lost arts, abandoned experiments and secret processes are non-anticipatory for a common reason.

The reason for this rule is exemplified by the following dicta:

"The consideration received from the disclosure of the discovery to the public is the foundation of the right to the monopoly of the patent. As against an original discoverer, the law recognizes no distinction between the lost art, the abandoned experiment, and the secret process. Whether the conception slumbers buried in the ashes of the past, lies inchoate in the brain of the would-be inventor, or is locked in the breast of its creator, it cannot afterwards be dug up, developed, or set free, to question the title of the complete creation first brought forth into the world of knowledge, and thus, as the first born, the rightful heir to the patent estate. As against an original inventor, anticipation is not shown by prior use of the invention under conditions which fail to dis-

34. Townsend, J., in Acme Flexible Clasp Co. v. Vary Mfg. Co., 96 Fed. Rep. 344, 347, affirmed, 101 Fed. Rep. 269, 41 C. C. A. 338; citing Draper v. Wattles, Fed. Case No. 4073; Hays v. Sulsor, Fed. Case No. 6271; Whitney v. Emmett, Fed. Case 17,585.

35. Brush v. Condit, 132 U. S. 39, 33 L. Ed. 252, 19 Brodix 582, 49 Off. Gaz. 1211.

close its composition or operation. Such knowledge of the invention should be accessible to the public."[36]

"In the sense of the patent statute, he is the first inventor who, by his own thought, makes an article or material and first perfects and adapts his discovery to actual use, although some one may have previously made a similar article without putting it to practical use or giving his discovery to the public in any way."[37]

§ 208. **Rule XXVI. To serve as an anticipation, there must be a disclosure in such full and clear terms as to enable one skilled in the art to practice the invention without the necessity of making experiments.**

"It is strongly urged that the English patent of Boggett & Pettit (No. 14,333), of 1852, anticipates Ballard. To do so, it must disclose a substantial representation of Ballard's device, in such full and clear terms as would enable one skilled iu the art to practice his invention without the necessity of experimenting."[38]

"The authorities leave no doubt as to the character of the disclosures necessary in a prior patent or publication to avoid a subsequent one, to-wit, the information

36. Townsend, J., in Matheson v. Campbell, 69 Fed. Rep. 597, 604.

37. Lurton, J., in Warren Bros. Co. v. City of Owosso, 166 Fed. Rep. 309, 315, 92 C. C. A. 227; citing Gayler v. Wilder, 10 How. 477, 496, 13 L. Ed. 504; Seymour v. Osborne, 11 Wall. 517, 552, 20 L. Ed. 33; Albright v. Celluloid Co., 2 B. & A. 629, Fed. Case 147; Bullock Printing Press Co. v. Jones, 3 B. & A. 195, 13 O. G. 124, Fed. Cas. 2132; Agawam Co. v. Jordan, 7 Wall. 583, 602, 19 L. Ed. 177; Whiteley v. Swayne, 7 Wall. 685, 687, 19 L. Ed. 199; Deering v. Winona Harvester Works, 155 U. S. 286, 301, 15 Sup. Ct. 118, 39 L. Ed. 153; The Corn Planter Patent, 23 Wall. 181, 211, 23 L. Ed. 161; Smith v. Goodyear Dental Vulcanite Co., 93 U. S. 486, 498, 23 L. Ed. 952; Gamewell Fire Alarm Tel. Co. v. Municipal Signal Co., 61 Fed. Rep. 948, 951, 10 C. C. A. 184.

38. Buffington, J., in Dixon-Woods Co. v. Reineke, 102 Fed. Rep. 348; citing Seymour v. Osborne, 11 Wall. 516, 20 L. Ed. 33; Hanifen v. E. H. Godshalk Co., 28 C. C. A. 507, 84 Fed. Rep 649.

therein given must be so full, clear, and precise that one skilled in the art, and acting in the then state of knowledge, can, from such a patent or publication, perform the process or make the thing covered by the patent sought to be anticipated."[39]

"A court is not justified in finding anticipation in an old and discarded device, the meaning of which is obscure and puzzles experts."[40]

§ 209. **Rule XXVII. That the same result was accomplished by the alleged anticipatory matter does not render it an anticipation, unless the result was accomplished by substantially the same means, in substantially the same way.**

"The accomplishment of the same result is not an anticipation, unless it is done by the same means in substantially the same way."[41]

This rule must be read in the light of the rule as to infringement discussed in § 273; "identity or difference of result is no test of infringement." It is obvious that where the idea of means and mode of operation are various in the two patents, the attainment of a common result is no criterion of their identity.

§ 210. **Rule XXVIII. It is immaterial whether the alleged anticipating device originated by design or accident.**

"To constitute anticipation of a later patent it is enough that such a (prior) construction had been in well-established use, whether it originated in design or by accident."[42]

39. Buffington, J., in Carnegie Steel Co. v. Cambria Iron Co., 89 Fed. Rep. 721, 737; citing Roberts v. Dickey, 4 Fisher 552, Fed. Case 11,889; Seymour v. Osborne, 11 Wallace 555; Eames v. Andrews, 122 U. S. 55; Downton v. Milling Co., 108 U. S. 470, Cawood Patent, 94 U. S. 704.

40. Ray, J., in Underwood Typewriter Co. v. Elliott-Fisher Co., 165 Fed. Rep. 927, 930.

41. Wheeler, J., in Hall v. Stern, 15 Fed. Rep. 463.

42. Woods, J., in National Harrow Co. v. Quick, 74 Fed. Rep. 236, 240, 20 C. C. A. 410.

§ 211. **Rule XXIX. That the alleged anticipatory matter has never gone into practical use may be considered in determining the question of anticipation.**

Thus, Judge Putnam has said: "Anticipatory matter which has never gone into practical use is to be narrowly construed,"[43] and Judge Buffington has said: "In determining a question of this character it is a pertinent and reasonable inquiry, if it be true that the disclosure of an earlier patent was substantially that of Jones, why during a period of many years, was it not practically applied to the same use?"[44] Judge Colt has said: "If the question of identity of method and result is doubtful, the doubt must be resolved in favor of the successful patentee, who has in a practical way materially advanced the art."[45]

On the other hand, in applying this rule, the limitation must be observed that the failure of the matter urged as anticipatory to go into public use may have been occasioned by extraneous circumstances rather than any want of merit. Thus, Judge Blatchford, in a case involving this question, has said: "The plaintiff contends, and very forcibly, that from the history of the success of the plaintiff's structure any device made by Anden like No. 3 would have at once attracted the attention of the trade and have gone into use. This is often a controlling circumstance in a case of doubt. But it often happens that, from various fortuitous circumstances, a complete invention in a branch of business,

43. Simonds Rolling Mach. Co. v. Hathorn Mfg. Co., 90 Fed. Rep. 201, 208.

44. Carnegie Steel Co. v. Cambria Iron Co., 89 Fed. Rep. 721, 738; citing Regulator Co. v. Copeland, 2 Fisher 221, Fed. Cas. No. 2866.

45. Simonds Rolling Mach. Co. v. Hathorn Mfg. Co., 93 Fed. Rep. 958, 961; citing Washburn v. Gould, 3 Story 122, 144, Fed. Case No. 17,214.

where much depends on energy and facilities and capital, fails to attract that attention which, under different and better auspices, it receives when independently produced at a later day."[46]

§ 212. Rule XXX. The effect of a prior patent as an anticipation is not destroyed by defects in minor details of construction, where it discloses the principle involved in the later patent.

"The fact that the patents were issued raises a presumption in favor of their operativeness and utility; and, when the defects are merely in minor details of construction, such defects will not defeat the efficiency of such patents as anticipations, provided they sufficiently disclose the principle of the alleged invention."[47]

§ 213. Rule XXXI. It does not constitute anticipation of a combination to find each of its elements in some structure of the prior art.

"It is probably very true that, by selecting from the various prior machines in this particular art, all the elements of the device in suit could be brought together. But to hold that this fact always defeats novelty would be to shut out every combination of old elements from the protection of the patent laws."[48]

A combination "can only be anticipated by a prior device having identically the same elements, or the me-

46. Crandall v. Richardson, 8 Fed. Rep. 808, 816.

47. Townsend, J., in Patent Button Co. v. Scovill Mfg. Co., 92 Fed. Rep. 151, 155; citing Dashiell v. Gosvenor, 162 U. S. 425, 16 Sup. Ct. 805, 40 L. Ed. 1025; Pickering v. McCullough, 104 U. S. 310, 26 L. Ed. 749; Electric Ry. Co. v. Jamaica & B. R. Co., 61 Fed. Rep. 655.

48. Putnam, J., in Heap v. Tremont and Suffolk Mills, 27 C. C. A. 316, 82 Fed. Rep. 449, 453; citing Packard v. Lacing Stud Co., 16 C. C. A. 639, 70 Fed. Rep. 66, 68; Boston & R. Elec. St. Ry. Co. v. Bemis Car-Box Co., 25 C. C. A. 420, 80 Fed. 287, 289.

chanical equivalents of those that are not used. It will not do to find in older devices a portion of these elements in one machine, another portion in a second machine, another in a third, and so on, and then say that this device is anticipated."[49]

§ 214. Rule XXXII. It is immaterial that the alleged anticipating device was not designed for the particular use to which the device of the patent is peculiarly adapted.

The rule necessarily results from the doctrine laid down by the Supreme Court, and recognized in all of the cases that "a patentee is entitled to every use of which his invention is susceptible, whether such use be known or unknown to him."[50] In following the rule as above stated, Judge Aldrich has said: "Under the doctrine which gives to the patentee all the uses to which his invention is susceptible, whether known or unknown, it is difficult to see why the public should not be entitled to all the uses to which the means involved in devices covered by lapsed patents are susceptible, or why a patentee who employs the old means with improvements adapting the use to a new or non-analogous industry should not be limited to a monopoly of the combination or improved machine. To say that one who discovers that old means will do a new work without any change may thereby monopolize the old means as applied to such new work, or, in other words, to say that because of such discovery others engaged in the wire-cloth industry shall not, in weaving, run a wire thread through the

49. Welker, J., in Worswick v. American Street Flushing Mfg. Co. v. Steiger, 17 Fed. Rep. 250, 252. To the same effect, see, Milwaukee Carving Co. v. Brunswick-Balke Collender Co., 126 Fed. Rep. 171, 61 C. C. A. 175; St. Louis Street Flushing Mach. Co. Mach. Co., 156 Fed. Rep. 574, 84 C C. A. 340.

50. Mr. Justice Brown, in Potts v. Creager, 155 U. S. 597, 606, 39 L. Ed. 275, 278.

means used in the older industry, would be carrying the discovery doctrine altogether too far."[51]

In a similar case, Judge Aldrich has said: "The claim of the complainant that the old atomizers were not designed for the particular use to which their device is peculiarly adapted is no answer to the fact that the older device would perform the same functions."[52]

§ 215. **Rule XXXIII. Mere oral testimony in support of the existence of an anticipating device is insufficient, unless it establishes the existence of the anticipating device beyond a reasonable doubt.**

The reason for this rule is clear, and has nowhere been better expressed than by Judge Sanborn, who has said: "The memory of men is too brief and fleeting, too easily swayed by chance and by interest, to permit the recollection of one or two witnesses, prompted by presently prepared pictures of the proof desired, to condition the validity of valuable patents that have stood unchallenged for years. Unsupported oral testimony of a prior use is always open to suspicion, and it cannot prevail over the legal presumption of validity which accompanies the patent, unless it is sufficient to establish such a use beyond a reasonable doubt. The testimony relative to the use of this Wabash beam is not of that character, and it will not be further considered."[53] And, in applying this rule, Judge Adams has said: "Neither the defendant nor any of his witnesses produce any specimen

51. Wright & Colton Wire Cloth Co. v. Clinton Wire Cloth Co., 67 Fed. Rep. 792, 14 C. C. A. 646.

52. Codman v. Amia, 70 Fed. Rep. 710.

53. National Hollow B. B. Co. v. Interchangeable B. B. Co., 106 Fed. Rep. 693, 703, 45 C. C. A. 544; citing Mast, Foos & Co. v. Dempster Mill Mfg. Co., 82 Fed. Rep. 327, 332, 27 C. C. A. 191, 195, 49 U. S. App. 508, 516; In re Barbed Wire Patent, 143 U. S. 275, 12 Sup. Ct. 443, 450, 36 L. Ed. 154; Deering v. Harvester Works, 155 U. S. 286, 300, 15 Sup. Ct. 118, 39 L. Ed. 153; Miller v. Handley, 61 Fed. Rep. 100, 102.

of the case proved to have been constructed by Stiefel prior to complainant's invention. If their evidence is true, it would seem that some one of such cases properly identified as in existence before 1887, the date of complainant's invention, could readily have been produced. The evidence of the witnesses, such as it is, uncorroborated by the production of any specimen of the alleged anticipating device antedating the complainant's invention is not sufficient to overcome the *prima facie* evidence found in the letters patent, of their own validity."[54]

§ 216. Rule XXXIV. "A process patent can only be anticipated by showing an earlier similar process."[56]

It is not enough to show an earlier apparatus which might have been used in practicing the process, unless the character of the structure is such as to plainly indicate to one called upon to operate it that its intended mode of operation involved a process similar to that sought to be anticipated.[57]

§ 217. Rule XXXV. A mere paper patent may anticipate.

While this is a generally accepted rule, it must be understood that the term "paper patent" is sometimes used, not in its ordinary sense as a patent which has not been practiced, but as a patent whose disclosures "do not appear to have been capable of successful practical operation."[58]

54. Kraatz v. Tieman, 79 Fed. Rep. 323; citing Haughey v. Meyer, 48 Fed. Rep. 679; Roll Paper Co. v. Weston, 8 C. C. A. 56, 59 Fed. Rep. 147.

56. Lurton, J., in Loew Filter Co. v. German-American Filter Co., 164 Fed. Rep. 855, 857, 90 C. C. A. 637; and to the same effect, see, Johnson v. Foos, 141 Fed. Rep. 73, 72 C. C. A. 105; Carnegie Steel Co. v. Cambria Iron Co., 185 U. S. 403, 46 L. Ed. 969.

57. Carnegie Steel Co. v. Cambria Iron Co., 185 U. S. 403, 424, 46 L. Ed. 969; New Process Fermentation Co. v. Maus, 122 U. S. 413, 428, 30 L. Ed. 1193.

58. Townsend, J., in Thomson-Huston Elec. Co. v. Winchester

In this sense, a paper patent will not serve to invalidate a later patent.[59] § 4920, R. S. U. S., puts a prior patent, a prior publication and a prior use on exactly equal footings as defenses, hence this rule, which has been distinctly stated, with its supporting logic, by Judge Townsend, as follows:

"The grant of a patent raises a presumption of operativeness, and of some utility, and, if prior, even though it be a mere paper patent, it may anticipate, provided it sufficiently discloses the principle of the alleged invention."[60]

Judge Lacombe has illuminated this rule, as follows:

"The statutes authorize the granting of patents only for such inventions as have not been patented or described in any printed publication in this or any foreign country before the applicant's embodiment of his own conception. It may be a hardship to meritorious inventors, who, at the expenditure of much time and thought, have hit upon some ingenious combination of mechanical devices, which, for ought they know, is entirely novel, to find that, in some remote time and place, some one else, of whom they never heard, has published to the world, in a patent or a printed publication a full description of the very combination over which they have been puzzling; but in such cases the act, none the less, refuses them a patent."[61]

Ave. R. Co., 71 Fed. Rep. 192, 194. See the equivalent language of Mr. Justice Matthews in Pickering v. McCullough, 104 U. S. 310, 26 L. Ed. 749.

59. Thomson-Huston Elec. Co. v. Winchester Ave. R. Co., 71 Fed. Rep. 192, 196.

60. Universal Winding Co. v. Willimantic Linen Co., 82 Fed. Rep. 228, 233, 80 Off. Gaz. 1273; affirmed in Universal Winding Co. v. Willimantic Linen Co., 92 Fed. Rep. 391, 34 C. C. A. 415.

61. New Departure Bell Co. v. Bevin Bros. Mfg. Co., 73 Fed. Rep. 469, 476, 19 C. C. A. 534.

Of the burden of proof concerning patents relied upon as anticipations, and charged to have inoperative disclosures, Judge Townsend has said:

"I do not understand that the law necessarily imposes upon a defendant who relies upon the prior art to limit the scope of a patent the burden of proving that prior patents were useful, operative or commercially successful or that they stated all the undeveloped possibilities of the invention therein disclosed. * * * It is well settled that mere paper patents may negative patentable novelty, provided they sufficiently disclose the principles of the alleged invention, or provided the alleged objections could be obviated by mere mechanical skill. * * * When, therefore, a prior patent appears upon its face to be relevant to the consideration of the prior art, I think the later inventor should show either that such device was not useful, or that it did not so disclose the principle of the later patent as to deprive it of its claim of patentable novelty."[62]

§ 218. Rule XXXVI. A prior patent may anticipate although it fails to claim.

When a patentee fails to claim any portion of his disclosure, even though novel, the failure to claim may indicate that the applicant thought it was old, or that he intended to dedicate it to the public.[63]

It was held in one case by Judge Wheeler that an inventor was not barred from claiming in a later application matter which he had described but had not claimed, in an issued patent. The decision was in an *ex parte* case, which is the only excuse that can be offered for it.

62. Edward Miller & Co. v. Meriden Bronze Co., (C. C., Dist. Conn.), 79 Off. Gaz. 1520, 1521.

63. In re Millett, 18 App. D. C. 186, 96 Off. Gaz. 1241.

It is unsupported by either reason, statute, or other authority.[64]

"The claim actually made operates in law as a disclaimer of what is not claimed," and hence does not affect the scope of the patent as an anticipation.[65]

§ 219. Rule XXXVII. Drawings alone, unaccompanied by description, will anticipate a design patent,[66] but not those of any other class.[67]

This subject is fully discussed elsewhere, in connection with the statutory defenses.

64. Vermont Farm Machine Co. v. Marble, 19 Fed. Rep. 307.

65. Mahn v. Harwood, 112 U. S. 354, 28 L. Ed. 665.

66. Ex Parte Crouch, 57 Off. Gaz. 845; Dobson v. Dornan, 118 U. S. 10, 30 L. Ed. 63; Britton v. White Mfg. Co., 61 Fed. Rep. 93, 96.

67. New Process Fermentation Co. v. Koch, 21 Fed. Rep. 580, 587; Uhlmann v. Bartholomae & Leicht Brewing Co., 41 Fed. Rep. 132, 138.

CHAPTER VIII.

CAVEATS; REISSUES.

§ 220. Caveats.

While the caveat was abolished by the repeal of § 4902, R. S. U. S., and the amendment of § 4934, R. S. U. S., under the Act of June 25, 1910, 36 Stat. at L., ch. 414, there are many letters patent now outstanding, issued upon applications that were preceded by the filing of caveats.

Former § 4902, R. S. U. S., was as follows:

"Any person who makes any new invention or discovery and desires further time to mature the same may, on payment of the fees required by law, file in the Patent Office, a caveat setting forth the design thereof and its distinguishing characteristics and praying protection of his right until he shall have matured his invention. Such caveat shall be filed in the confidential archives of the office and preserved in secrecy, and shall be operative for the term of one year from the filing thereof; and if application is made within the year by any other person for a patent with which such caveat would in any manner interfere the Commissioner shall deposit the description, specification, drawings, and model of such application in like manner in the confidential archives of the office and give notice thereof by mail to the person by whom the caveat was filed. If such person desires to avail himself of his caveat, he shall file his description specification, drawings, and model within three months from the time of placing the notice in the postoffice in Washington, with the usual time required for transmitting it to the caveator added thereto, which time shall be indorsed on the notice."

It will be seen that the purpose of the section was "to secure an opportunity to have questions of priority between rival inventors determined before the issue of a patent,"[1] and the language of the statute limited the operation of the notice which it provides, to applications "made within the year," and so did not entitle the caveator to notice of applications filed before the caveat, or after the expiration of the one year period.[2]

In view of the language of this section, some of the decisions regarding caveats are curious; notably a ruling that the filing of the caveat was not an admission that the invention was not perfected,[3] and another ruling to the effect that a caveat filed by an individual as a sole inventor, and supported by his affidavit as such could be used in litigation upon a patent issued upon the application of the caveator and another to carry back the date of invention of the joint invention.[4]

The inadvertent issuance of a patent for the same invention while a caveat was pending did not authorize the granting of a patent to the caveator, and the pendency of the caveat did not affect the validity of the issued patent.[5]

Of the requirements of the caveat as to sufficiency Judge Townsend said: "The same particularity of description is not required as in an application for a patent, but it must be as complete and exact as the inventor is able to give, and sufficiently precise to enable the examiners to determine whether an invention described in a subsequent application is probably the same." And

1. Townsend, J., in Electric R. Co. v. Jamaica & B. R. Co., 61 Fed. Rep. 655, 671. To the same effect, see, Allen v. Hunter, 6 McLean 303, Fed. Cas. 225.

2. Allen v. Hunter, 6 McLean 303, Fed. Case 225; Bell v. Daniels, 1 Bond 212, Fed. Case 1247; Johnson v. Onion, 4 Fisher 170, Fed. Case 7140.

3. Johnson v. Root, 1 Fisher 351, Fed. Case 7411.

4. Hoe v. Kahler, 12 Fed. Rep. 111, 116.

5. Cochrane v. Waterman, 1 McArthur 52, Fed. Case 2929.

he therefore ruled that a caveat must adequately describe the invention of the subsequent patent, or it could not be used in carrying back the date of the invention.[6]

The pendency of the caveat is immaterial upon the question of public use,[7] nor were caveats ever considered as having any effect, positive or negative,[8] upon a subsequent patent for the same invention, issued on the application of the caveator, except as an aid in carrying back the date of his invention, when accompanied by a showing of due diligence in his reduction to practice.[9]

REISSUES.

§ 221. The foundation of the right to reissue.

Prior to the enactment of any statutes authorizing the reissue of letters patent, the Secretary of State had reissued patents, where the original patent was defective, and the courts had sustained such reissued patents. In the leading case, decided in 1832, Mr. Chief Justice Marshall said: "It had been said that this permission to issue a new patent on a reformed specification, when the first was defective through the mistake of the patentee, would change the whole character of the act of Congress. We are not convinced of this. The great object and intention of the act is to secure to the public the advantages to be derived from the discoveries of individuals, and the means it employs are the compensation made to those individuals for the time and labor devoted to these discoveries, by the exclusive right to make, use and sell, the things discovered for a limited time. That which gives complete effect to this object

6. Electric Ry. Co. v. Jamaica & B. R. Co., 61 Fed. Rep. 655, 671.

7. Bell v. Daniels, 1 Bond 212, Fed. Case 1247.

8. Heath v. Hildreth, 1 McArthur 12, Fed. Case 6309.

9. Johnson v. Root, 1 Fisher 351, Fed. Case 7410.

and intention, by employing the same means for the correction of inadvertent error which are directed in the first instance, cannot, we think be a departure from the spirit and character of the act.'' [10]

§ 222. The present statute.

Shortly after the decision quoted from in the preceding section, the first statute providing for reissues was enacted.[11] The present statute (sec. 4916, R. S. U. S.) is as follows:

(Reissue of defective patents.) "Whenever any patent is inoperative or invalid, by reason of a defective or insufficient specification, or by reason of the patentee claiming as his own invention or discovery more than he had a right to claim as new, if the error has arisen by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, the Commissioner shall on the surrender of such patent and the payment of the duty required by law, cause a new patent for the same invention, and in accordance with the corrected specification, to be issued to the patentee, or in the case of his death or of an assignment of the whole or any undivided part of the original patent, then to his executors, administrators, or assigns, for the unexpired part of the term of the original patent. Such surrender shall take effect upon the issue of the amended patent. The Commissioner may in his discretion, cause several patents to be issued for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for a reissue for each of such reissued letters patent. The specifications and claim in every such case shall be subject to revision and

10. Grant v. Raymond, 6 Peters 218, 243. For the further history of the early law of reissues, see Shaw v. Cooper, 7 Peters 292; Wilson v. Rousseau, 4 Howard 646, 685.

11. 4 Statutes at Large, ch. 162, section 3, p. 559.

restriction in the same manner as original applications are. Every patent so reissued, together with the corrected specification, shall have the same effect and operation in law, on the trial of all actions for causes thereafter arising, as if the same had been originally filed in such corrected form; but no new matter shall be introduced into the specification, nor in case of a machine-patent shall the model or drawing be amended, except each by the other; but when there is neither model nor drawing, amendments may be made upon proof satisfactory to the Commissioner that such new matter or amendment was a part of the original invention, and was omitted from the specification by inadvertence, accident, or mistake, as aforesaid."

§ 223. The purpose of the statute.

The purpose of the statute has been thus defined by Mr. Justice Brown: "The plain purpose of this section is to give the patentee an opportunity to make valid and operative that which was before invalid and inoperative; invalid, because it claimed as new that which had been previously invented or used by the public; inoperative, because the specification was defective or insufficient. New matter cannot be introduced, nor can the scope of the invention be enlarged. All that the applicant can do is to so amend his patent as to enable him to receive some practical and beneficial result from his actual invention, of which he has been deprived by defects or omissions in the original patent. The object of a patentee applying for a reissue is not to reopen the question of the validity of the original patent, but to rectify any error which may have been found to have arisen from his inadvertence or mistake."[12]

12. McCormick Harvesting Machine Co. v. C. Aultman Co., 169 U. S. 606, 610, 42 L. Ed. 875.

As Mr. Justice Blatchford has said, "in all these statutes on the subject of reissues, the only authority granted to the Commissioner is one to issue a new patent 'for the same invention.'"[13]

Under a former statute (of 1836), Mr. Justice Grier said: "The surrender of valid patents, and the granting of reissued patents thereon, with expanded or equivocal claims, where the original was clearly neither 'inoperative nor invalid,' and whose specification is neither 'defective or 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."[14]

The general rules concerning reissues have been thus expressed by Judge Archbald: "To warrant a reissue, inadvertence, accident, or mistake must be shown, and there must be no unreasonable delay in applying for it. The claims may be narrowed or enlarged, but in either case they must be within the terms of the invention as it is specified and described in the original patent; the invention, although differently stated, remaining the same."[15]

The surrender of a patent for reissue under the statute does not necessarily imply that the original patent is void, notwithstanding the express language of the act, whose first phrase is "whenever any patent is inoperative or invalid, by reason of a defective or insufficient description." In the language of Judge Severens, "we

13. Parker & Whipple Co. v. Yale Clock Co., 123 U. S. 87, 31 L. Ed. 100.

14. Burr v. Duryee, 68 U. S. 531, 877, 17 L. Ed. 650, 660.

15. Bertels v. Trethaway, 175 Fed. Rep. 971, 974.

have * * * assumed that a patent, although the specifications be defective or insufficient, might still not be utterly void. It seems necessary to assume this because of the importance which the Supreme Court has attached to the right of the patentee to recall his patent if a reissue is not allowed. Allen v. Culp, 166 U. S. 501, 41 L. Ed. 1093; McCormick Harvesting Mach. Co. v. Aultman, 169 U. S. 606, 42 L. Ed. 875. It is possible, however, that this right to recall the patent was regarded as a privilege, to which he (the patentee) was entitled, to have the validity of his patent determined by a judicial decree. We need not speculate, however, upon this subject, which is involved in some intricacy, for the general proposition that the surrender of the patent upon a reissue involves the cessation of all rights acquired under it has been long stated."[16]

Mr. Justice Brown said "to justify a reissue it is not necessary that the patent should be wholly inoperative or invalid. It is sufficient if it fail to secure to the patentee all of that which he has invented and claimed."[17]

As we have seen (§ 106, *ante*) the patentee is bound by self-imposed limitations contained in the claims. The reissue statute, as has been pointed out by Judge Ray, affords the patentee relief in cases within its scope, where the courts cannot give him relief through construction. "The plain and clear meaning of the terms employed cannot be varied by construction, which must be in conformity to the self-imposed limitations contained in the claims, if any. The remedy for mistaken limitations in the claims of a patent (is) by reissue and not by construction."[18]

16. Comeld v. Fletcher Mfg. Co., 167 Fed. Rep. 321, 323, 93 C. C. A. 25.

17. Hobbs v. Beach, 180 U. S. 383, 394, 45 L. Ed. 586, 593.

18. Dey Time-Register Co. v. W. H. Bundy Recording Co., 169 Fed. Rep. 807, 813. Citing, Keystone Bridge Co. v. Phoenix Iron Co., 95 U. S. 274, 278, 24 L. Ed. 344.

Defective Description as Ground for Reissue. The great majority of reissues are sought solely to obtain new claims. But the amendment of the description, when defective, is one of the purposes of the statute. In an illustrative case Judge Lowell said: "The reissue was granted to correct the error of a single word in the specification (by changing 'hole' to 'slot'), * * *. The error was caused by oversight, and was unconnected with the gist of the invention, though its adoption rendered the machine inoperative. No change was made or needed in the claim. If the patentee made a meritorious invention, he ought not to lose the benefit of it by reason of a defect so narrow and technical."[19] "If it should be conceded that the changes in the description of the reissue are of no materiality * * * the circumstance would not impeach (the validity of the reissue). * * * A patentee who reissues his patent for the purpose of correcting a clerical error or improving the phraseology of his description may do what is unnecessary, but the public are not injured. Although the commissioner exceeds his statutory authority by granting a reissue for an invention which was not described or intended to be claimed in the original patent, he does not do so by permitting a change in the phraseology for the purpose of defining more perfectly what was described and claimed in the original. * * * If the claims in a reissue are valid which were contained in the original, notwithstanding its new claims are invalid, it would seem to follow that, where there are no new claims in the reissue all the claims should be valid, although in attempting to correct a mistake the commissioner has done nothing more than to introduce unimportant changes into the description."[20]

19. Hart & Hegeman Mfg. Co. v. Anchor Elec. Co., 92 Fed. Rep. 657, 658, 34 C. C. A. 606.

20. Thomson-Houston Elec. Co. v. Black River Traction Co., 135 Fed. Rep. 759, 68 C. C. A. 461.

Defective drawing as ground for reissue. It has been repeatedly ruled that a defective drawing may be the only, and a sufficient, ground for surrender and reissue. In the leading case Mr. Justice Brown said: "The reissue was applied for * * * merely to correct, as it would seem, an obvious error in one of the drawings. Possibly the error was such as would not have impaired the patentee's rights under his original designs; but he was entitled to the full scope of his invention, and if he were dissatisfied with the drawings as they stood, and the error was purely an inadvertent one, we think it was within the jurisdiction of the commissioner of patents to order the patent to be reissued."[21]

Mistake of the solicitor as ground for reissue. One of the cogent grounds for reissue is a mistake on the part of the solicitor leading to the improper cancellation or limitation of claims. Thus where the claims had been cancelled because of a mistaken belief that another party to an interference was the prior inventor, the cancelled claims were held properly obtained by reissue.[22]

Mistake of the Patent Office as ground for reissue. Errors of the Patent Office are recognized grounds for reissue. So where that office has rejected claims in the original application under an erroneous reference,[23] or has improperly suggested a singular term, where it should have been plural.[24] Where the applicant's name is misspelled in the specification and grant through the mistake of the Patent Office, a reissue will be made for the correction of the specific error, without charge of

21. Hobbs v. Beach, 180 U. S. 383, 394, 45 L. Ed. 586, 593. The same ruling, in Hart & Hegeman Mfg. Co. v. Anchor Elec. Co., 92 Fed. Rep. 657, 658, 34 C. C. A. 606.

22. Dunbar v. Eastern Elevator Co., 75 Fed. Rep. 567, 570.

23. Morey v. Lockwood, 75 U. S. (8 Wall.) 230, 19 L. Ed. 339.

24. Yale Lock Mfg. Co. v. New Haven Sav. Bank, 32 Fed. Rep. 167, 171.

office fees, at the request of the patentee, under Rule 170 of the Patent Office.[25] But failure of the office to issue the patent to the assignee of the application does not come within the scope of that rule.[26]

§ 224. Who may obtain reissue.

Where the patent has never been assigned, no one but the patentee, or, in the event of his death, his legal representatives, may apply for a reissue.[27] The guardian of an insane person may apply for and receive a valid reissue of a patent belonging to his ward.[28] The assignee of a patent may secure a reissue thereof,[29] and the assignee of an undivided interest must be joined in an application for reissue.[30] Where an assignment has not been recorded, the assignee need not join in the application for reissue,[31] nor need a mere licensee be joined in such an application.[32] The word "assigns" as used in this statute means the ultimate assignee, regardless of the number of mesne conveyances that may intervene.[33]

§ 225. The original patent must be surrendered.

Upon application for a reissue the original letters patent must be tendered for surrender,[34] although the statute since 1870 has provided that the surrender "shall

25. Ex parte Verge, 97 Off. Gaz. 2305.
26. Ex parte Fish, 114 Off. Gaz. 2091.
27. Whitcomb v. Spring Valley Coal Co., 47 Fed. Rep. 652, 657.
28. Whitcomb v. Spring Valley Coal Co., 47 Fed. Rep. 652, 657.
29. Selden v. Stockwell Self Lighting Gas Burner Co., 9 Fed. Rep. 390, 396.
30. Potter v. Holland, Fed. Case No. 11,329.
31. Ex parte Gold, 106 Off. Gaz. 998.
32. Smith v. Mercer, Fed. Case No. 13,078.
33. Selden v. Stockwell Self Lighting Gas Burner Co., 9 Fed. Rep. 390, 396.
34. Dental Vulcanite Co. v. Wetherbee, Fed. Case No. 3810, 3 Fish. 87.

take effect upon the reissue of the amended patent."[35] Mr. Justice Brown, referring to the use of these words in the statute has said:

"These words were obviously inserted for the purpose of preventing the surrender taking immediate effect, and to postpone its legal operation until the patent should be reissued. When a patent is thus surrendered, there can be no doubt that it continues to be a valid patent until it is reissued, when it becomes inoperative; but if a reissue be refused, it is entirely clear that the surrender never takes effect, and the patent stands as if no application had ever been made for a reissue."[36]

§ 226. The validity of claims obtained for the first time by reissue, as affecting the validity of claims imported from the original patent.

"In many cases where the new claims in a reissue have been held invalid, the claims repeated from the original have been sustained."[37] In a leading case the Supreme Court held that "the patent must be regarded as void so far as the new and expanded claims are concerned."[38]

The Circuit Court of Appeals for the Seventh Circuit has adopted a doctrine at variance with the rule of the cases just cited. The reasoning of that court is as follows: "Without the existence of one or the other of two conditions precedent, the Commissioner of Patents is not authorized to grant a reissue. Either the original speci-

35. § 4916, R. S. U. S.

36. Allen v. Culp, 166 U. S. 501-505, 41 L. Ed. 1093.

37. Wallace, J., in Thompson Houston Electric Co. v. Black River Traction Co., 135 Fed. Rep. 759, 766, 68 C. C. A. 461; citing, as illustrations Gage v. Herring, 107 U. S. 640, 27 L. Ed. 601; Mahn v. Harwood, 112 U. S. 354, 28 L. Ed. 665.

38. Mahn v. Harwood, 112 U. S. 354, 28 L. Ed. 665.

fication must be defective or insufficient, or the original claims must embrace more than the patentee had a right to claim as new. But neither condition is available unless the error arose from inadvertence, accident or mistake, and without any fraudulent or deceptive intention. * * * The attempted enlargement of the monopoly clearly applies to claims 10, 11, 12 and 13. To what extent, if at all, claims 1, 2, and 5 (same as in the original patent) are affected by the changes in the specification, or whether those claims are unavailable to appellant by reason of additional defenses interposed by appellee, are questions which we will not consider. The bill was based upon the reissue. And inasmuch as there existed none of the conditions precedent to the right of the commissioner to grant a reissue, the grant is utterly void."[39] This conclusion has cited in its support an opinion of Judge Hough, in which he says: "Upon the construction of the reissue above made, it appears clear that the Blackmore reissue not only enlarged the claims of the original patent, but sought to cover and does purport to cover an entirely different invention, and is therefore void."[40] The latter case is based upon the reissue being for a different invention; the former, upon the ground that the "original specification neither contained erroneous statements of fact nor failed to give a description in such full and clear terms as would enable any person skilled in the art to construct and use the device." Here is a clear line of distinction, and Judge Hough's opinion is no authority for the later holding, which is not in accord with the settled rule.[41] The Supreme Court has never abandoned the doctrine that "the invalidity of the new claim in the reissue does not in-

39. General Elec. Co. v. Richmond Street & I. R. Co., 178 Fed. Rep. 84, —— C. C. A. ——.

40. General Chemical Co. v. Blackmore, 156 Fed. Rep. 968.

41. Coon v. Wilson, 113 U. S. 268, 28 L. Ed. 963.

deed impair the validity of the original claim which is repeated and separately stated in the reissued patent."[42] And the reasoning of the Circuit Court of Appeals of the Seventh Circuit would be more convincing were it not for the fact that the statute concerning disclaimers has been held by the Supreme Court to apply to reissued as well as to original Letters Patent. In the opinion just quoted from, Mr. Justice Gray, after reciting the provisions of §§ 4917 and 4922, R. S. U. S., says, "a reissued patent is within the letter and the spirit of these provisions."[43]

§ 227. Time within which reissue may be applied for.

So far as the statute is concerned, an application for reissue may be made at any time before the original or former reissued patent expires.[44] A reissued patent may be again reissued,[45] and the second reissue may be valid though identical in terms with the original.[46] Of course no reissue could be had after the expiration of the original patent,[47] or an expiration thereof, when the law permitted extensions.[48]

The limit of time within which a reissue must be applied for has never been limited by statute, but the courts have arbitrarily fixed the term of two years as the limit, save under special circumstances, within which a reissue which seeks to expand the claim may be applied for. "The settled rule of decision is, that if it appears, in cases where the claim is merely expanded, that

42. Gage v. Herring, 107 U. S. 640, 27 L. Ed. 601.

43. Ibid.

44. Wilson v. Rousseau, 4 How. 646, 11 L. Ed. 1140.

45. Topliff v. Topliff, 145 U. S. 156, 36 L. Ed. 658; Selden v. Stockwell Self Lighting Gas Burner Co., 9 Fed. Rep. 390, 397.

46. Giant Powder Co. v. Safety Nitro Powder Co., 19 Fed. Rep. 509, 511; followed in Celluloid Mfg. Co. v. Zylonite Brush & Comb Co., 27 Fed. Rep. 291, 295.

47. Ex parte Siemens, 11 Off. Gaz. 1107.

48. Wilson v. Rousseau, 4 How. 646, 11 L. Ed. 1140.

the delay has been for two years, or more, it is adjudged to invalidate the reissue, unless the delay is accounted for and excused by special circumstances, which show it to have been not unreasonable."[49]

"Due diligence must be exercised in discovering the mistake in the original patent, and, if it be sought for the purpose of enlarging the claim, the lapse of two years will ordinarily, though not always, be treated as evidence of an abandonment of the new matter to the public to the same extent that a failure by the inventor to apply for a patent within two years from the public use or sale of his invention is regarded by the statute as conclusive evidence of an abandonment of the patent to the public."[50]

49. Mr. Justice Matthews, in Wollensak v. Reiher, 115 U. S. 96, 29 L. Ed. 350.

50. Mr. Justice Brown, in Topliff v. Topliff, 145 U. S. 156, 36 L. Ed. 658.

CHAPTER IX.

DISCLAIMERS.

§ 228. Disclaimer defined.

The word "disclaimer" is indifferently applied to those limitations imposed upon claims by representations made during the pendency of the application in the Patent Office and those limitations which are imposed subsequent to the issuance of the patent, in the formal manner prescribed by the statute. The disclaimer is a renunciation by the owner of the patent of a construction which, if placed upon the verbiage employed in the patent, would render it so broad as to invalidate it.

That the limitations embodied in the patent before its issuance are construed and denominated as the disclaimer appears from the following language of Judge Lacombe:

> "When a patentee has practically disclaimed other devices by stating in his specifications that they existed before his own was contrived, such other devices may fairly be considered to be part of the prior art when he brings suit upon the patent issued to him upon the representations made in such specifications." [1]

In another case the same judge has said:

> "Whatever may have been the transactions between the applicant and the Patent Office, and whatever light may be thrown upon obscurities in the patent by the file wrapper and contents, it is the patent as issued by which the patentee's right to a monopoly must be tested. When it expressly de-

1. Lacombe, J., in Lyons v. Drucker, 106 Fed. Rep. 416, 419.

clares that there is some other process to which it does not apply, and in plain and unambiguous language gives the earmarks by which that other process is to be distinguished from the process of the patent, the public has the right to insist that the patentee shall abide by the disclaimer he has made and proclaimed."[2]

§ 2. The statutory provision.

Section 4917, R. S. U. S., is as follows:

"Whenever, through inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, a patentee has claimed more than that of which he was the original or first inventor or discoverer, his patent shall be valid for all that part which is truly and justly his own, provided the same is a material or substantial part of the thing patented; and any such patentee, his heirs or assigns, whether of the whole or any sectional interest therein, may, on payment of the fee required by law, make disclaimer of such parts of the thing patented as he shall not choose to claim or to hold by virtue of the patent or assignment, stating therein the extent of his interest in such patent. Such disclaimer shall be in writing, attested by one or more witnesses, and recorded in the Patent Office; and it shall thereafter be considered as part of the original specification to the extent of the interest possessed by the claimant and by those claiming under him after the record thereof. But no such disclaimer shall affect any action pending at the time of its being filed, except so far as may relate to the question of unreasonable neglect or delay in filing it."

2. Lacombe, J., in Jackson v. Birmingham Brass Co., 25 C. C. A. 196, 79 Fed. Rep. 806-807.

§ 229. Disclaimer—how construed.

The effect of the disclaimer upon the subsequent construction of the patent has been thus treated by Mr. Justice Clifford:

"Authority to make such a disclaimer is beyond question, if it be made in writing and is duly attested and recorded in the Patent Office. When so made, attested and recorded, it becomes a part of the original specification to the extent of the interest of those who make it; but the provision is that it shall not affect any action pending at the time of its being filed, except so far as may relate to the question of unreasonable neglect or delay in filing it.

"Pending suits may proceed, but the disclaimer, when recorded, becomes a part of the original specification, and must be taken into account in construing the patent, and in ascertaining the rights of the parties to the suit, unless it appears that the effect of the disclaimer is to enlarge the nature of the invention, and prejudice the rights of the respondents.[3] Where the effect of the disclaimer is to diminish the claims of the patent without prejudicing the rights of the respondent, the suit may proceed, notwithstanding the disclaimer; it being held that the disclaimer, under such circumstances, does not affect the pending suit, except to limit and qualify the claims of the patent, and in respect to the question of unreasonable neglect or delay in filing the same. Unreasonable delay not having been suggested, the only effect of the disclaimer in such a case is to limit the nature of the invention secured by the patent, and to diminish the claims of the patent as set forth in the specification.

"Matters properly disclaimed cease to be a part of the invention; and it follows that the construction of the

3. Perry v. Skinner, 1 Web. Pat. Cas. 253; Smith v. Nichols, 88 U. S. (21 Wall.) 117, 22 L. Ed. 567.

patent must be the same as it would be if such matters had never been included in the description of the invention or the claims of the specification."[4]

We find in the Second Circuit a case in which a disclaimer, pleaded upon by an amended bill, resulted in the invalidation of the patent in suit after it had been found valid by the Circuit Court of Appeals in the same case.[5]

Supplementing the doctrine above quoted from Dunbar v. Meyers, Judge DeHaven has said: "In considering the scope and effect to be given a disclaimer, the same rules are to be observed as in construing any other written instrument, and so as to carry out the intention of the person executing it, as indicated by its language when construed with reference to the proceedings of which it forms a part. It cannot be read independently of its relation to the original specifications, of which it becomes a part when recorded." [6]

It is obvious that there is no occasion for the defendant to prove the facts that are admitted by the disclaimer. Judge Wallace has said: "We are aware of no principle which will permit a patent to be defeated for want of novelty in respect to the subject-matter which has been eliminated from it by a disclaimer. The office of a disclaimer is to enable the patentee to save himself from the peril of such a defense. Matters which have been properly disclaimed cease to be a part of the invention."[7]

It is equally obvious that a disclaimer cannot be so interpreted as to make a claim read for an invention different from that described and claimed in the patent before the disclaimer was filed. Criticising a disclaimer

4. Dunbar v. Meyers, 94 U. S. (4 Otto) 187, 24 L. Ed. 34.

5. Brunswick Balke Collender Co. v. Klumpp, 131 Fed. Rep. 255, 65 C. C. A. 447.

6. Graham v. Earl, 92 Fed. Rep. 155, 159, 34 C. C. A. 267.

7. Schwarzwalder v. New York Filter Co., 66 Fed. Rep. 152, 157, 13 C. C. A. 380.

of this character, Judge Lacombe has said: "The difficulty with this contention is that it substitutes a different invention from that described and claimed in the patent. It is not a narrower claim, but a different one. It is, as defendants suggest, 'an attempt to incorporate into a claim for a combination a feature which had not been claimed in connection with that combination before, and thereby make a new combination.' If one particular branch of the art of working in wood—cabinet making, for example—had never used circular saws, because they were supposed to be impracticable or useless or not economical, although such saws were used in other branches of the art, it might be invention to introduce them in cabinet making; and the individual who showed that they were useful, practicable, and economical in that branch of the art might be entitled to a patent for a circular saw in combination with the other parts of an old machine. But his specification and claim would be expected to indicate just what it was he had invented and what he claimed. An individual who had invented some specific improvement in circular saws generally—something novel and useful and applicable to those tools in every branch of the wood-working art—might also obtain a patent, with a claim covering all circular saws, which would be good to restrain infringement of his particular improvement. But it would be a startling proposition that he could, thirteen years afterwards, file a disclaimer of any combination containing circular saws, except such as might be used in cabinet-making machinery, and then insists that he was entitled to sustain his claim to cover all circular saws so used (with his improvement or without), on the theory that no one had used them in that branch of the art before."[8]

8. Albany Steam Trap Co. v. Worthington, 79 Fed. Rep. 966, 969, 25 C. C. A. 258.

After the disclaimer is made, the patentee will not be heard to contend that a concession contained in the disclaimer was made through inadvertence on the part of himself or his attorney.[9]

§ 230. What may be disclaimed.

As noted by Mr. Justice Blatchford, "the statute expressly limits a disclaimer to a rejection of something before claimed as new."[10] So when the attempted disclaimer does not comply with the statutory requirement that the patentee shall give up some material or substantial part of the thing patented of which he was not the original inventor, and relates solely to matters that do not modify or change the construction of the claim as originally granted, it is ineffective as a disclaimer.[11] While this statement appears to be sound as thus formulated, the Supreme Court, in reversing the case just cited, said:

"We think there is no force in the criticism that a disclaimer may not extend to a part of the specification, as well as to a distinct claim.[12] Had the purpose of the disclaimer been to reform or alter the description of the invention, or convert the claim from one thing into something else, it might have been objectionable, as patents can only be amended for mistakes of this kind by a reissue. But the disclaimer in this case appears to have been made to obviate an ambiguity in the specification, and with no idea of obtaining the benefit of a reissue.

9. Hillborn v. Hale & Kilburn Mfg. Co., 69 Fed. Rep. 958, 962, 16 C. C. A. 569.

10. Union Metallic Cartridge Co. v. United States Cartridge Co., 112 U. S. 624, 28 L. Ed. 828.

11. Cambria Iron Co. v. Carnegie Steel Co., 96 Fed. Rep. 850, 852, 37 C. C. A. 593.

12. Citing, Hurlbut v. Schillinger, 130 U. S. 456, 32 L. Ed. 1011; Schillinger v. Gunther, 17 Blatchf. 66, Fed. Case 12,458; Schwartzwalder v. New York Filter Co., 66 Fed. Rep. 152, 13 C. C. A. 380.

If the clauses had the effect of broadening the patent the disclaimer removes the objection. If they did not, the disclaimer could do no harm, and cannot be made the subject of criticism."[13]

Where a disclaimer has been properly filed, that is, where the statutory reason for filing a disclaimer existed, the patent must be construed in the light of the disclaimer.[14]

It is clear that the office of a disclaimer does not extend to changing the invention from that described in the specification. Mr. Justice Bradley has said: "A disclaimer is usually and properly employed for the surrender of a separate claim in a patent, or some other distinct and separable matter, which can be exscinded without mutilating or changing what is left standing. Perhaps it may be used to limit a claim to a particular class of objects, or even to change the form of a claim which is too broad in its terms; but certainly it cannot be used to change the character of the invention. And if it requires an amended specification or supplemental description to make an altered claim intelligible or relevant, whilst it may possibly present a case for a surrender and reissue, it is clearly not adapted to a disclaimer. A man cannot, by merely filing a paper drawn up by his solicitor, make to himself a new patent, or one for a different invention from that which he has described in his specification."[15]

§ 231. When disclaimer may be filed.

The time when a disclaimer must be filed depends upon the circumstances of each case. The fact that the ob-

13. Mr. Justice Brown, in Carnegie Steel Co. v. Cambria Iron Co., 185 U. S. 403, 436, 46 L. Ed. 985.

14. Ashcroft v. Boston & Lowell R. R. Co., 97 U. S. 189, 24 L. Ed. 982.

15. Hailes v. Albany Stove Co., 123 U. S. 582, 31 L. Ed. 284, 286; quoted and followed in Collins Co. v. Coes, 130 U. S. 56, 32 L. Ed. 858.

jectionable claim was sanctioned by the Patent Office and held valid by the Circuit Court gives the right to the patentee to disclaim within a reasonable time after the Appellate Court has rendered a judgment adverse to the claim.[16] In such a case a disclaimer filed within two months after the decision of a Circuit Court of Appeals has been held to be reasonably prompt.[17] And it is no objection that the disclaimer relates to a reissued patent.[18]

It is within the discretion of the trial court to permit a disclaimer to be made and used upon a rehearing; but the discretion of the court in such a matter will not be reviewed on appeal. In the leading case, after the bill had been dismissed, the complainant filed a disclaimer in the Patent Office, and in order to avail himself of the disclaimer filed a motion for rehearing which was informal. He then filed a formal petition for rehearing which the court granted upon condition that he pay to the defendant the costs accrued up to the time of filing the petition for rehearing. The costs were taxed, the plaintiff stated in open court that he was unable to comply with the condition, a final decree of dismissal was entered, and the complainant appealed. Mr. Justice Gray said:

"After the case had been heard and decided upon its merits, the plaintiff could not file a disclaimer in court. or introduce new evidence upon that or any other subject, except at a rehearing granted by the court, upon such terms as it thought fit to impose. The granting or refusal, absolute or conditional, of a rehearing in equity, as of a new trial at law, rests in the discretion of the court in which the case has been heard or tried, and is

16. Gage v. Herring, 107 U. S. 640, 27 L. Ed. 601.

17. Thompson v. Bushnell, 96 Fed. Rep. 238, 37 C. C. A. 456.

18. Gage v. Herring, 107 U. S. 640, 27 L. Ed. 601.

not a subject of appeal. The terms imposed as a condition precedent to a rehearing not having been complied with, the disclaimer was not in the case."[19]

19. Roemer v. Neumann, 132 U. S. 103, 33 L. Ed. 277; to the same effect, see, National Folding Box & Paper Co. v. Stecher Lithographic Co., 81 Fed. 395, 399, 26 C. C. A. 448; and 9 U. S. E. 245.

CHAPTER X.

LICENSOR AND LICENSEE.

§ 232. License distinguished from assignment.

It is necessary to a proper understanding of the rights and liabilities arising from the relationship of licensor and licensee that the distinction between licenses and assignments be clearly understood. This distinction has been drawn by the United States Supreme Court, in these terms: "Every patent issued under the laws of the United States for an invention or discovery contains 'a grant to the patentee, his heirs and assigns, for the term of seventeen years, of the exclusive right to make, use and vend the invention or discovery throughout the United States and the Territories thereof.' R. S. U. S., § 4884. The monopoly thus granted is one entire thing, and cannot be divided into parts, except as authorized by those laws. The patentee or his assigns may, by instrument in writing, assign, grant and convey, either (1st) the whole patent, comprising the exclusive right to make, use and vend the invention throughout the United States; or (2d) an undivided part or share of that exclusive right; or (3d) the exclusive right under the patent within and throughout a specified part of the United States. Rev. Stat., § 4898. A transfer of either of these three kinds of interests is an assignment. * * * Any assignment or transfer, short of one of these, is a mere license."[1]

1. Waterman v. Mackenzie, 138 U. S. 252, 34 L. Ed. 923.

§ 233. How and when licenses granted.

Licenses may be granted orally[2] as well as in writing, and they need not be recorded.[3] They may be granted before the issuance of the patent.[4]

§ 234. Licensing agreements—how construed.

The infinite variety of conditions to be met in licensing agreements, as well as the triplex nature of the patent franchise, and the fact that the license may be granted as to either, any two, or all, of the rights to make, use and sell, make it important to note the doctrine that such contracts have nought to do with the patent statute, that they are merely contracts, in writing or by parol, and are to be governed by the same rules of interpretation, with the same *lex loci* and *lex fori*, as other contracts, written or oral.

"There is nothing in the nature of a license in writing to place it outside the well-known rules of construction which are applicable to other contracts in writing. The writing itself is considered the ample and conclusive evidence of the final agreement of the parties thereto, and parol testimony to vary its terms is rigidly excluded. It is not the province of the court to make new contracts for parties, at the whim of one or the other. Rather it is the duty of the court to enforce literally the contract as it appears, unless indeed its unconscionable character or conditions, or its fraudulent inception,

2. Jones v. Berger, 58 Fed. Rep. 1006; Dalzell v. Dueber Watch Case Mfg. Co., 148 U. S. 315, 37 L. Ed. 749; Cook v. Sterling Electric Co., 150 Fed. Rep. 766, 80 C. C. A. 502.

3. Jones v. Berger, 58 Fed. Rep. 1006; Baldwin v. Sibley, 1 Cliff. 150, Fed. Case 805; Nilsson v. De Haven, 168 N. Y. 656, 61 N. E. Rep. 1131.

4. Brush Elec. Co. v. California Elec. Light Co., 52 Fed. Rep. 945, 963, 3 C. C. A. 368; Burton v. Burton Stock Car Co., 171 Mass. 437; Hargraves v. A. B. Pitkin Mach. Co., 19 R. I. 426.

or its evidence of the mutual mistake of the contracting parties, is so clear as to justify an appeal to the conscience of a court of equity. * * * It will not do to ask the court to so construe a writing that doubt may thereby be incorporated between its lines. Words are to be taken in their usual sense and significance."[5]

A license to "use" implies the right to make for use, where otherwise the license would not benefit the licensee.[6]

Where the licensing agreement is in writing, and imperfectly expresses the agreement of the parties, it is the duty of the one who first discovers the mistake in the language of the agreement to apply promptly to the other party for correction, or to a court of equity for reformation. Where he takes the former course, and the other party promptly offers to execute a corrected instrument, he must accept the offer, or will not be heard thereafter to complain of the imperfections of the contract.[7]

§ 235. Particular classes of licenses.

A conveyance of particular claims of a patent has been held to be a license and not an assignment. The reason for this holding is as follows:

> "While it is sometimes said that each claim of a patent is a separate patent, it is true only to a limited extent. Doubtless separate defenses may be interposed to different claims, and some may be held to be good and others bad, but it might lead to very great confusion to permit a patentee to split up his title within the same territory into as many different

5. Green, J., in Illingworth v. Spaulding, 43 Fed. Rep. 827, 829.

6. Illingworth v. Spaulding, 43 Fed. Rep. 827, 829; Edison Elec. Light Co. v. Peninsular Light, Power & Heat Co., 95 Fed. Rep. 669.

7. Laver v. Dennett, 109 U. S. 90, 27 L. Ed. 867.

parts as there are claims. If he could do this, his assignees would have the same right they now have to assign the title to certain territory, and the legal title to the patent might thus be distributed among a hundred persons at the same time. Such a division of the legal title would also be provocative of litigation among the assignees themselves as to the exact boundaries of their respective titles."[8]

A conveyance of a right to practice the invention of a patent "so far as the same relates to and is used upon" specific articles, is a license and not an assignment;[9] as has also been held of a conveyance of the exclusive right to make, use and vend the patented invention "for the following purposes and no others," which purposes are recited in the conveyance.[10]

A conveyance of the exclusive right to use and sell the invention of the patent within certain designated states, the right to make not being conveyed, is merely a license.[11]

A conveyance of the right "to use and manufacture and sell rights to use" in specific territory is not a territorial assignment but a license only.[12]

A conveyance of the right to manufacture and sell even if accompanied by an assignment of all claims for damages arising from the past infringement of the letters patent is merely a license and not an assignment.[13]

8. Pope Mfg. Co. v. Gormully & Jeffery Mfg. Co., 144 U. S. 248, 254, 36 L. Ed. 423.

9. Jaros Hygienic Underwear Co. v. Fleece Hygienic Underwear Co., 60 Fed. Rep. 602.

10. Gamewell Fire Alarm Telegraph Co. v. Brooklyn, 14 Fed. Rep. 255.

11. Brush Electric Co. v. California Electric Light Co., 52 Fed. Rep. 945-959, 3 C. C. A. 368; Hamilton v. Kingsbury, 17 Blatchf. 264, Fed. Case No. 5985.

12. Rice v. Boss, 46 Fed. Rep. 195.

13. Hayward v. Andrews, 106 U. S. (16 Otto) 672, 27 L. Ed. 271.

A conveyance reserving the right to license one other party and binding the patentee to prosecute infringers is merely a license.[14]

§ 236. Who may grant licenses.

They may be granted by either of several owners in common with the same force and effect as if all joined in the license.[15]

§ 237. License before issue of patent.

A license may be granted before the patent is issued;[16] it seems probable, however, that in such a case the licensee may repudiate and surrender the license upon the issuance of the patent, if he was theretofore in ignorance of its claims.[17]

§ 238. Express and implied licenses.

An express license may be defined as one whose terms are formulated by the verbal or written agreement of the parties; for it may be created by parol.[18] A parol license, of course, must not be repugnant to the statute of frauds, and cannot embody covenants not to be performed within one year.[19]

§ 239. License restrictions in sales of patented articles.

Where a patented article is once sold without restriction, it is forever freed from the monopoly of the pat-

14, Shepherd v. Deitsch, 138 Fed. Rep. 83.

15. Dunham v. Indianapolis & St. L. R. Co., Fed. Case No. 4151, 7 Biss. 223, 2 Bann. & Ard. 327.

16. Brush Electric Co. v. California Electric Light Co., 52 Fed. Rep. 945; Adam v. Folger, 56 C. C. A. 540, 120 Fed. Rep. 260.

17. Adam v. Folger, 120 Fed. Rep. 260, 262, 56 C. C. A. 540.

18. Jones v. Berger, 58 Fed. Rep. 1006; Union Switch & Signal Co. v. Johnson R. R. Signal Co., 61 Fed. Rep. 940-944; Potter v. Holland, Fed. Cas. No. 11,329, 4 Blatchf. 206; Baldwin v. Sibley, Fed. Case No. 805, 1 Blatchf. 150.

19. Sharples v. Moseley & Stoddard Mfg. Co., 75 Fed. Rep 595.

ent.[20] Express restrictions may accompany the sale of that article, and will be enforced both as against the original purchaser[21] and subsequent purchasers having actual notice of the restriction.[22]

Such restrictions have been enforced in the following illustrative instances; restrictions as to

a. Territory.[23]
b. Method of use.[24]
c. Purpose of use.[25]
d. Place of use.[26]
e. Price at which the patented article may be leased[27] or resold.[28]
f. Duration.[29]

20. Bloomer v. McQuewan, 55 U. S. (14 How.) 539, 14 L. Ed. 532; Chaffee v. Boston Belting Co., 63 U. S. (22 How.) 217, 223, 16 L. Ed. 240-242; Adams v. Burks, 84 U. S. (17 Wall.) 453, 21 L. Ed. 700; Hobbie v. Jennison, 149 U. S. 355, 37 L. Ed. 766.

21. Victor Talking Machine Co. v. The Fair, 123 Fed. Rep. 424-426, 61 C. C. A. 58; Edison Phonograph Co. v. Pike, 116 Fed. Rep. 863; Edison v. Kaufmann, 105 Fed. Rep. 960; Heaton-Peninsular Button Fastener Co. v. Eureka Specialty Co., 77 Fed. Rep. 288, 25 C. C. A. 267; Steam Cutter Co. v. Sheldon, Fed. Case No. 13,331, 5 Fish. 477-487; Rubber Co. v. Goodyear, 76 U. S. (9 Wall.) 788-790, 19 L. Ed. 566; Pope Mfg. Co. v. Owsley, 27 Fed. Rep. 100-104.

22. Edison Electric Light Co. v. Goelet, 65 Fed. Rep. 613, 615.

23. Steam Cutter Co. v. Sheldon, Fed. Case No. 13,331; Oliver v. Rumford Chemical Works, 109 U. S. 75, 25 Off. Gaz. 784, 27 L. Ed. 862.

24. Heaton-Peninsular Button Fastener Co. v. Eureka Specialty Co., 77 Fed. Rep. 288, 25 C. C. A. 267.

25. Rubber Co. v. Goodyear, 76 U. S. (9 Wall.) 788-790, 19 L. Ed. 566; Bogart v. Hinds, 25 Fed. Rep. 484, 33 Off. Gaz. 1268.

26. Rubber Co. v. Goodyear, 76 U. S. (9 Wall) 788-790, 19 L. Ed. 566.

27. New York Phonograph Co. v. Edison, 136 Fed. Rep. 600; affirmed, New York Phonograph Co. v. National Phonograph Co., 75 C. C. A. 382, 144 Fed. Rep. 404.

28. Victor Talking Mach. Co. v. The Fair, 123 Fed. Rep. 424-426, 61 C. C. A. 58; Edison Phonograph Co. v. Pike, 116 Fed. Rep. 863; Edison v. Kaufmann, 105 Fed. Rep. 960.

29. Moore Mfg. & Foundry Co. v. Cronk Hanger Co., 69 Fed. Rep. 998.

g. Character of materials to be operated on.[30]
h. Class of structures in which the patent is to be used.[31]
i. Size and description of machines to be made under the patent.[32]

§ 240. Rights and liabilities between licensor and licensee.

The validity of a patent cannot be determined in a suit against a licensee for royalties.[33] This is because of the estoppel of the licensee to deny the validity of the patent under which he is licensed.[34] The licensee is likewise estopped to deny that he is a licensee,[35] and to deny the right of the licensor to unpaid royalty under the license.[36] But this estoppel does not extend to purchasers who have merely bought from the licensee articles made under the license;[37] and where the licensor elects to treat the license as void, and sue for infringement, the licensee is released from the estoppel.[38]

It is, of course, competent for the parties to contract that the licensor will sue infringers during the life of the license.[39] In a licensing agreement it was stipulated

30. Heaton-Peninsular Button Fastener Co. v. Eureka Specialty Co., 77 Fed. Rep. 288, 25 C. C. A. 267; Tubular Rivet & Stud Co. v. O'Brien, 93 Fed. Rep. 200.

31. Nellis v. Pennock Mfg. Co., 13 Fed. Rep. 451, 22 O. G. 1131.

32. Pope Mfg. Co. v. Owsley, 27 Fed. Rep. 100-104.

33. Moore v. National Water Tube Boiler Co., 84 Fed. Rep. 346, 347.

34. Moore v. National Water Tube Boiler Co., 84 Fed. Rep. 346, 347; Illinois Watch Case Co. v. Ecaubert, 177 Ill. 587; Platt v. Fire Extinguisher Mfg. Co., 59 Fed. Rep. 897, 8 C. C. A. 357; Slemmer's Appeal, 58 Pa. St. 155, 98 Am. Dec. 248.

35. Illinois Watch Case Co. v. Ecaubert, 177 Ill. 587.

36. Baylis v. Bullock Elec. Mfg. Co., 32 Misc. Rep. (N. Y) 218.

37. Baltimore Car Wheel Co. v. North Baltimore Passenger Ry. Co., 21 Fed. Rep. 47.

38. Baltimore Car Wheel Co. v. North Baltimore Passenger Ry. Co., 21 Fed. Rep. 47; Burr v. Duryee, 2 Fisher, 275, 283, Fed. Case 2190.

39. Foster v. Goldschmidt, 21 Fed. Rep. 70, 71.

that the licensor should "use reasonable diligence in prosecuting or causing the prosecution of unlicensed persons who shall sell imitations of the gloves hereby licensed." The licensee breached the contract by non-payment of royalties, continued to manufacture, and was treated and sued as an infringer by the licensor. The answer alleged complainant's failure to prosecute infringers reported by the licensee. The proof showed the filing of several such suits and injunctions obtained in four, and there was no showing that the other infringers continued their infringements after the suits were filed. It was held that "if the action of the complainant was such that it resulted practically in stopping infringement, he fulfilled the spirit and the meaning of his obligation to the defendant to use reasonable diligence in prosecuting unlicensed sellers."[40]

§ 241. Termination.

The presumption is, when the terms of the license are silent, that the royalties are not payable upon articles manufactured and sold after the expiration of the life of the patent.[41] The licensing agreement may expressly provide for the method of its termination by notice.[42] "A license not expressly limited in duration continues until the patent expires or the license is forfeited, if not terminated by mutual consent."[43]

40. Foster v. Goldschmidt, 21 Fed. Rep. 70, 71.

41. Sproul v. Pratt & Whitney Co., 108 Fed. Rep. 963, 965, 48 C. C. A. 167, affirming Sproull v. Pratt & Whitney Co., 101 Fed. Rep. 265.

42. Stimpson Computing Scale Co. v. W. F. Stimpson Co., 104 Fed. Rep. 893, 895, 44 C. C. A. 241.

43. Ray, J., in American Street Car Adv. Co. v. Jones, 122 Fed. Rep. 803, 808; citing, St. Paul Plow Works v. Starling, 140 U. S. 196, 35 L. Ed. 404; Hartell v. Tilghman, 99 U. S. 556, 25 L. Ed. 357.

The license is not terminated by a failure to pay royalties.[44] Nor does such failure to pay royalties entitle the licensor to a decree of annulment of the license.[45]

"The failure to pay the royalties, upon which the claim of forfeiture is grounded, is a breach of contract, cognizable in a court of common law. That and the cancellation of the contract of license, or other equitable remedy in that regard, are all matters justiciable in a state court, but in the absence of diverse citizenship, are clearly outside the jurisdiction of a Federal court. It will not do to say that a forfeiture has taken place, *ipso facto*, by the non-payment of the stipulated royalties, and that, therefore, all handling of the patented articles by defendant since then has been an infringement. The law does not arm one party to a contract with the power to determine in his own favor a condition of this kind, and thus produce for the other party to the contract all the disabilities and consequences that would follow a forfeiture legally ascertained and declared. Even where the contract provides that the failure to pay shall render it null and void, the defendant has a right to be heard as to the facts upon which such annulment is made to depend. Forfeitures are not favored in equity, and the best-considered 'decisions hold that even licenses containing express stipulations for their forfeiture are not, *ipso facto*, forfeited upon condition broken, but remain operative and pleadable until rescinded by a court of equity.' "[46]

44. White v. Lee, 3 Fed. Rep. 222; American Street Car Adv. Co. v. Jones, 122 Fed. Rep. 803, 808. Contra, see Brooks v. Stolley, 3 McLean 523, Fed. Case No. 1962.

45. Wagner Typewriter Co. v. Watkins, 84 Fed. Rep. 57, 62.

46. Mr. Justice Gray in Standard Dental Mfg. Co. v. National Tooth Co., 95 Fed. Rep. 291, 294; citing, White v. Lee, 3 Fed. Rep. 222; Adams v. Meyrose, 7 Fed. Rep. 208; Baker Mfg. Co. v Washburn & Moen Mfg. Co., 18 Fed. Rep. 172; Consolidated Middlings Co. v. Wolf, 28 Fed. Rep. 814.

Unless the license is in terms expressly made assignable, it terminates automatically upon the death of the sole licensee,[47] or upon the dissolution of a corporate licensee.[48]

§ 242. Revocation by licensor.

Licensing agreements usually provide for the method of their revocation for non-compliance of the licensee with his covenants. Frequently this is effected by a provision that if the licensee fails to perform his engagements the license may be revoked by a written notice served upon him. Such provisions are favored and uniformerly sustained by the courts,[49] and the general rule is that any method of terminating the agreement which is incorporated in the licensing agreement must, to be availed of, be followed according to its terms, and when such method is invoked will terminate the agreement.[50]

Where written notice of revocation is called for a verbal notice will not suffice.[51]

An adjudication of annulment based on notice of cancellation for breach of condition by the licensee will not be made except where the evidence of the licensee's default is clear.[52]

47. Oliver v. Rumford Chem. Works, 109 U. S. 75, 27 L. Ed. 862.

48. Hapgood v. Hewitt, 119 U. S. 226, 30 L. Ed. 369.

49. White v. Lee, 3 Fed. Rep. 222; Hammacher v. Wilson, 26 Fed. Rep. 239, 241.

50. Stimpson Computing Scale Co. v. W. F. Stimpson Co., 104 Fed. Rep. 893, 895, 44 C. C. A. 241.

51. White v. Lee, 3 Fed. Rep. 222; Rogers v. Reissner, 30 Fed. Rep. 525; Hurd v. Gere, 27 N. Y. App. Div. 625, 10 N. Y. Supp. 235.

52. Sullivan v. Compressed Air Renovator & Sweeper Mfg. Co., 131 Wis. 134, 111 N. W. Rep. 73; Jones & Dommersnas Co. v. Crary, 234 Ill. 26, 83 N. E. Rep. 651, affirming, Crary v. Jones & Dommersnas Co., 138 Ill. App. 225.

§ 243. Waiver.

Where the licensing agreement provides for forfeiture upon breach of its conditions as to reports and payment of royalty, it is competent for the licensor to waive the forfeiture.[53] Where in such case he sues in equity for specific performance of the agreement by the licensee, and an accounting of the royalties, he is held to have waived his right to forfeiture, will be remitted to his action at law, and a demurrer to the bill will be sustained.[54]

§ 244. Licensor; election of remedies for breach.

Where the licensee is guilty of breach of the licensing agreement, and continues to make, use or sell, the licensor may have his election between standing on the contract and suing for its breach, or suing for the tort. "The remedy of complainant may be a double one; for liability may rest either upon the broken contract, or for the tortious use of the invention."[55]

§ 245. Revocation by licensee.

The general principles just considered apply with equal force to the licensee. Under them the licensee must comply with the terms of the covenant for termination. Aside from this, the licensee may always rescind the contract upon the ground that it was obtained by fraudulent representations on the part of the licensor; but he must not be guilty of laches, and where he is, and has granted sub-licenses, relief will not be granted him.[56]

53. Rogers v. Riessner, 30 Fed. Rep. 525, 529.

54. Washburn & Moen Mfg. Co. v. Cincinnati Barbed Wire Fence Co., 42 Fed. Rep. 675.

55. Lurton, J., in Heaton-Peninsular Button Fastener Co. v. Eureka Specialty Co., 77 Fed. Rep. 288, 291, 25 C. C. A. 267, 35 L. R. A. 728. To the same effect, see, St. Louis Street Flushing Mach. Co. v. Sanitary Street Flushing Mach. Co., 161 Fed. Rep. 725, 727, 88 C. C. A. 585.

56. Landon v. Tucker, 130 Mo. App. 704, 107 S. W. Rep. 1037.

§ 246. Injunction in aid of suit to terminate license.

The jurisdiction of equity to preserve the *status quo* pending litigation may be invoked contemporaneously with a suit to cancel a license, and in a proper case an injunction will be granted to restrain making or selling under a patent, *pendente lite*, or until the licensing agreement has been decreed annulled.[57]

57. Schalkenback v. National Ventilating Co., 113 N. Y. Supp. 352, 129 App. Div. 389.

CHAPTER XI.

ESTATES IN LETTERS PATENT; OTHER CHARACTERISTICS.

§ 247. Of the various kinds of estates.

The title to letters patent for inventions may be either

1. Legal, or
2. Equitable.

Such titles are acquired or lost in various ways, which, for convenience, may be treated under the following heads:

1. Title by original acquisition (the inventive act).
2. Title by grant.
3. Title by assignment.
4. Title by creditors' bill.
5. Title by proceedings in bankruptcy.
6. Title by bequest or intestacy.

And, finally, the title may be vested in one or more persons or corporations.

§ 248. The inventive act as a source of title.

It is obvious that the title created by occupancy depends upon three facts; first, that the person or persons upon whose application the patent has issued were the first to make the alleged invention; second, that he, or they were really sole or joint inventors, as alleged in the application; third, that the production of the thing patented embodied invention. In other words, the application must be for an invention, and the applicants must truthfully state their relationship to that invention. What constitutes invention is considered elsewhere in this book.

§ 249. Discrepancies between the patent and the facts as to sole or joint inventorship.

If the thing patented was invented solely by one of several joint applicants, the patent is void;[1] conversely, if the invention is that of several joint inventors, a patent issued to one or more of them, less than the total number of joint inventors, is void;[2] it is because such discrepancies lie at the very inception of title to the patent that they render the patent issued upon such a wrongful application void. And this is so of course, even where the patent is assigned to an innocent purchaser for value. Judge Kohlsaat, referring to this rule, has said: "This rule is well established, although the courts, on account of the hardship involved, have held the defense to be a technical one, and have required clear proof thereof."[3]

What is true of the patent, as a whole, under the rule we are considering, is true of each of its claims; because, as we have seen in considering the claim and its properties, each claim is practically a patent of itself, so that one claim may be infringed without infringing others in the same patent, and one may be valid while the others are invalid.

Therefore, where one of the several joint applicants is the sole inventor of the subject-matter of one claim, that claim is void.[4]

§ 250. Title by grant.

The title arising from the fact of invention, and which we have just considered, is a title to the invention, rather than a title to the patent. When the inventor applies

1. Welsbach Light Co. v. Cosmopolitan Gaslight Co., 100 Fed. Rep. 648; Heulings v. Reid, 58 Fed. Rep. 868.

2. American Electrical Novelty Co. v. Newgold, 108 Fed. Rep. 957.

3. Welsbach Light Co. v. Cosmopolitan Gaslight Co., 100 Fed. Rep. 648-650.

4. Welsbach Light Co. v. Cosmopolitan Light Co., 104 Fed. Rep. 88, 85, 43 C. C. A. 418.

for a patent upon his invention, and the Letters Patent issue to him, the grant of such patent is another, or confirmatory title. But an unpatented invention can be assigned, before or after a patent is applied for, and where it has been so assigned, and the assignment is (as is usual) accompanied by a request that the Letters Patent when issued be issued to the assignee, such assignee, and not the inventor, is the grantee under the grant of the patent. By common usage, any title by assignment is called a title by grant. Therefore, except as to the title created by the original grant, and which is considered in connection with the general subject of the grant, the titles usually treated under this head are properly dealt with as titles by assignment.

§ 251. Title by assignment.

The monopoly granted by Letters Patent for inventions is one entire thing, and cannot be divided into parts, except as authorized by the patent statutes.[5]

§ 252. Assignment defined.

Probably the most comprehensive definition is that given judicially by Mr. Justice Gray, in the following language:

"The patentee or his assigns may, by instrument in writing, assign, grant, and convey, either (1st) the whole patent, comprising the exclusive right to make, use and vend the invention throughout the United States; or, (2nd) an undivided part or share of that exclusive right; or, (3rd) the exclusive right under the patent within and throughout a specified part of the United States. A transfer of either of these three kinds of interests is an assignment properly speaking, and vests in the assignee a title in so much of the patent itself."[6]

5. Waterman v. Mackenzie, 138 U. S. 252, 34 L. Ed. 923.

6. Waterman v. Mackenzie, 138 U. S. 252-254, 34 L. Ed. 923.

§ 253. Requisites.

a. *As to description.* It is sufficient that the patent conveyed be described with sufficient particularity to identify it.[7]

b. *As to the grantor.* The statute merely requires the assignment to be in writing; it therefore need not be executed under seal.[8]

An assignment by a corporation need not bear the corporate seal. It is only necessary "that the agent (or officer) should, in the body of the contract, name the corporation as the contracting party and sign as its agent or officer."[9]

An infant, or other person, under guardianship may execute an assignment by guardian, the guardian being appointed under the laws of the State.[10]

An assignment made by an attorney in fact must be signed with the assignor's name. When merely signed with the name of the attorney, the assignment is inoperative.[11]

c. *As to the grantee.* A grant to a copartnership, in which only the firm name of the grantee is given, is valid.[12]

A married woman, an infant, or a person under guardianship, may be a grantee.[13]

d. *As to the consideration.* Where there is a total failure of consideration, it has been held that the failure

7. American Tobacco Co v. Ascot Tobacco Works, 165 Fed. Rep. 207.

8. Machesney v. Brown, 29 Fed. Rep. 145, 146; Gottfried v. Miller, 104 U. S. 521, 527, 26 L. Ed. 851.

9. Mr. Justice Woods, in Gottfried v. Miller, 104 U. S. 521, 527, 26 L. Ed. 851.

10. Fetter v. Newhall, 17 Fed. Rep. 842, 843.

11. Machesney v. Brown, 29 Fed. Rep. 239.

12. Fresno Home Packing Co. v. Fruit Cleaning Co., 101 Fed. Rep. 826, 829, 42 C. C. A. 43.

13. Fetter v. Newhall, 17 Fed. Rep. 841, 843.

to pay the consideration does not invalidate the assignment as to persons dealing in good faith with the assignee,[14] although the general rule is "that when a party has agreed to pay a certain price for a patent, if he does not pay the price he does not get the patent."[15]

§ 254. Title by creditors' bill.

By reason of their peculiar nature as embodying incorporeal rights, which do not exist in any particular state or district, but are co-extensive with the United States, it was said, in a dictum of Mr. Justice Curtis in a copyright case, that "there would certainly be great difficulty in assenting to the proposition that patents and copyrights, held under the laws of the United States, are subject to seizure and sale on execution."[16] The remedy whereby letters patent may be reached and subjected to the payment of the claims of creditors is by a bill in equity.[17] A license under letters patent may be similarly subjected to sale.[18] Such a suit, however, is not a suit on a patent, and jurisdiction over it does not exist in the Federal courts in the absence of diversity of citizenship, and a sufficient amount in controversy.[19] Patents belonging to the plaintiff in an equity suit, who has been decreed to pay costs, may be reached by a petition in the original suit, or an original bill may be filed in the same court and treated as a dependent or ancillary proceeding, without subpoena, and although the plaintiff is not an inhabitant of the district.[20]

14. Piaget Novelty Co. v. Headley, 107 Fed. Rep. 134, 135; affirmed, 108 Fed. Rep. 870, 871, 48 C. C. A. 116.

15. Coxe, J., in Buck v. Timoney, 78 Fed. Rep. 487, 488.

16. Stevens v. Gladding, 58 U. S. (17 How.) 447, 15 L. Ed. 155.

17. Ager v. Murray, 105 U. S. 126, 26 L. Ed. 942; Newton v. Buck, 77 Fed. Rep. 614, 23 C. C. A. 355; Jewett v. Atwood Suspender Co., 100 Fed. Rep. 647, 648.

18. Matthews v. Green, 19 Fed. Rep. 649.

19. Ryan v. Lee, 10 Fed. Rep. 917, 918.

20. Maitland v. Gibson, 79 Fed. Rep. 136.

§ 255. Title through proceedings in receivership or bankruptcy.

Patents can be reached under the bankruptcy law, "because they are wholly subject to the laws of the United States."[21] By section 70 of the National Bankruptcy Act of July 1, 1898,[22] title to existing patents of the bankrupt passes to the trustee by operation of law.[23] The language of the Act is "interests in patents and patent rights;" and, interpreting that language, it has been held to be limited to interests in or under patents in existence and in force on the day of the adjudication in bankruptcy, and not to extend to interests in applications for patent then pending.[24]

A receiver of an insolvent corporation may maintain a bill in equity to compel the holder of the legal title to a patent, whereof the corporation was the equitable owner, to convey the title to the receiver.[25]

Under the former National Bankruptcy Act where an assignee in bankruptcy did nothing regarding the patent and was discharged, and the bankrupt thereafter assigned the patent, the title thus acquired was held to be good.[26]

§ 256. Title through bequest or intestacy.

As to the unpatented inventions of a deceased person, the Federal Statute is as follows:

"When any person, having made any new invention or discovery for which a patent might have been granted, dies, before a patent is granted, the right of applying

21. Wheeler, J., in Jewett v. Atwood Suspender Co., 100 Fed. Rep. 647, 648.

22. Ch. 541, 30 Stat. at L. 544, 566; 1 Ann. Stat. 698.

23. In re McDonnell, 101 Fed. Rep. 239.

24. In re McDonnell, 101 Fed. Rep. 239; In re Dann, 129 Fed. Rep. 495, 498.

25. McCullough v. Association Horlogere Suisse, 45 Fed. Rep. 479.

26. Sessions v. Romadka, 145 U. S. 29, 39, 36 L. Ed. 609.

for and obtaining the patent shall devolve on his executor or administrator, in trust for the heirs at law of the deceased, in case he shall have died intestate; or if he shall have left a will disposing of the same, then in trust for his devisees, in as full manner and on the same terms and conditions as the same might have been claimed or enjoyed by him in his lifetime; and when the application is made by such legal representatives, the oath or affirmation required to be made shall be so varied in form that it can be made by them. The executor or administrator duly authorized under the law of any foreign country to administer upon the estate of the deceased inventor shall, in case the said inventor was not domiciled in the United States at the time of his death, have the right to apply for and obtain the patent. The authority of such foreign executor or administrator shall be proved by certificate of a diplomatic or consular officer of the United States."[27]

As to patents issued prior to the death of the inventor, "the obvious intent of the law is, to vest in the legal representatives of a patentee, upon his death, the same rights he would have enjoyed if he had lived."[28]

The words "heirs at law" in this section have been construed to mean "next of kin;" while the word "devisees" has been construed to mean "legatees."[29]

The grant of letters patent, running, according to the provisions of § 4884, R. S. U. S., to the patentee, "his heirs or assigns," the fact that the patentee dies after the application is made and before the patent issues, does not render the patent void; it takes effect as a valid

27. § 4896 as amended March 3, 1903, 10 Fed. Stat. Ann. 252, 32 Stat. at L. 1226, 3 Comp. Stat. 3385.

28. Wallace, J., in Newell v. West, 13 Blatchf. 114, Fed. Case No. 10,150.

29. Shaw Relief Valve Co. v. New Bedford, 19 Fed. Rep. 753, 754; Bradley v. Dull, 19 Fed. Rep. 913.

grant to the heirs, executors, administrators or assigns.[30]

Where a patent issues to the administrator of a deceased inventor, the administrator, of course, takes only such title as the deceased had at his death, and where the deceased had parted with the equitable title, that title will be unaffected by the death of the inventor.[31] Where the patent is issued to the executor or administrator, the grant need not contain any recital that it is in trust for the heirs or devisees, as this is implied by law.[32]

The death of an applicant for patent terminates the authority of his attorneys, and an amendment made after his death amounting to more than a mere amplification of what had been in the application, and unsupported by the oath of his administrator, has been held to avoid the patent.[33] Where the owner of an undivided interest in the patent died intestate and the administratrix was appointed, qualified, administered the estate and was discharged, the title of the intestate was held to vest by operation of law in the next of kin.[34]

§ 257. Co-ownership of letters patent, how created.

The title to Letters Patent may be held in undivided interests by two or more persons, as a result of the conveyance of one or more undivided interests by the sole patentee, or joint patentees, or as the result of the grant of the patent being to two or more persons who were joint applicants, or one or more of whom acquired his or

30. De La Vergne Refrigerating Mach. Co. v. Featherstone, 147 U. S. 209, 37 L. Ed. 138, reversing 49 Fed. Rep. 916.

31. Northwestern Fire Extinguisher Co. v. Philadelphia Fire Extinguisher Co., 1 B. & A. 177, Fed. Case No. 10,337.

32. Stimpson v. Rogers, 4 Blatchf. 333, Fed. Case No. 13,457.

33. Eagleton v. West, Bradley & Cary Mfg. Co., 2 Fed. Rep. 774; affirmed, 111 U. S. 490, 28 L. Ed. 493.

34. Winkler v. Studebaker Bros. Mfg. Co., 105 Fed. Rep. 190.

their interest by assignment prior to the issuance of the patent. There has been some discussion as to the exact nature of the individual estates thus created, and whether the several owners of the Letters Patent hold as joint tenants, or as tenants in common. We will limit our attention to the rights and liabilities of these owners of undivided interest as among themselves.

§ 258. Rights and liabilities created by co-ownership.

"The owner of an undivided part of all the rights secured by a patent may, without the consent of his co-owners, grant a valid license to use the monopoly it protects."[35] Taking this as our fundamental rule, we find the general subject thus ably discussed by Judge Wales: "The rights and liabilities of the co-owners of a patent, when not modified by contract or agreement among themselves, in respect to royalties received by them, in the light of all the authorities on the subject, may be stated thus: Where a patent belongs to several persons in common, each co-owner can assign his share, and sue for an infringement, and can also work the patent himself, give license to work it, and sue for royalties payable to him for its use, and is entitled to retain, for his own benefit, whatever profit he may derive from the working, although he may be liable to account for what he receives in respect of the licenses."[36]

"In Dunham v. Railroad Co., 2 Ban. & A. 327, 7 Biss. 223, Fed. Cas. No. 4151, it was said by Judge Drummond

35. Sanborn, J., in Paulus v. M. M. Buck Mfg. Co., 129 Fed. Rep. 594, 595, 64 C. C. A. 162. Following Bloomer v. McQuewan, 14 How. 539, 14 L. Ed. 532; Blackledge v. Weir & Craig Mfg. Co., 108 Fed. Rep. 71, 47 C. C. A. 212.

36. Citing 1 Lindl. Partn. 62; Sheehan v. Railroad Co., 16 Ch. Div. 59; Mathers v. Green, L. R. 1 Ch. App. 29; Clum v. Brewer, 2 Curt. 506, Fed. Case No. 2909; Curran v. Burdsall, 20 Fed. 837; Manufacturing Co. v. Gill, 32 Fed. 697; DeWitt v. Manufacturing Co., 66 N. Y. 462; Gates v. Fraser, 9 Ill. App. 628; Hall Pat. Est. 75.

that, where a party owning less than the whole of the thing patented makes a grant or license under the patent, it would seem the better rule to hold, if there is any liability at all, that he shall be answerable to the others, rather than the other patentees shall look to the grantee or licensee. In Curran v. Burdsall, 20 Fed. Rep. 837, the court held that, if one of several joint patentees assigns to a third party, the estoppel upon the assignor must work a license to the assignee to use the patent, and the joint owner of the patent must look to the one who assigns, for an accounting. The rule deducible from the authorities would seem to be that the license of one or more of several owners in common of a patent confers a right as against all, and that the remedy of the other tenants in common, if they have any, is by a suit for an account for whatever may have been received by them. In other words, the licensee of a patent held by two or more co-owners is liable to his licensor only, and not to the other co-owners, for license fees or royalties, unless it is otherwise stipulated in the license."[37]

§ 259. Letters Patent as payment for stock subscriptions.

It is the general rule that Letters Patent, or licenses thereunder, may, to the extent of their reasonable value, be accepted and given in payment of subscriptions to the capital stock of corporations. The difficulty of determining the value of the patent franchise, which is very great at all times, and particularly in the case of a newly issued patent, or one which has never been adjudicated, is no obstacle to such a transaction. "In the absence of fraud, an agreement may ordinarily be made by which stockholders can be allowed to pay for their shares in

37. Wales, J., in Pusey & Jones Co. v. Miller, 61 Fed. Rep. 401, 404.

patents, mines, or other property, to which it is not easy to assign a determinate value."[38]

Under the well-known principles of corporation law, however, unduly inflated values placed upon patent rights, will result, upon the complaint of creditors, in holding the subscribers personally liable for their subscriptions, as stated by Mr. Justice Brown:

"It is the settled doctrine of this court that the trust arising in favor of creditors by subscriptions to the stock of a corporation cannot be defeated by a simulated payment short of an actual payment in good faith. And while any settlement or satisfaction of such subscription may be good as between the corporation and the stockholders, it is unavailing as against the claims of the creditors."[39]

The same rule obtains in England. Lord Justice Gifford said: "If a man contracts to take shares he must pay for them, to use a homely phrase, in meal or in malt; he must either pay in money or money's worth; if he pays in one or the other that will be a satisfaction."[40]

The language of the Missouri Supreme Court has been often referred to: "The authorities are not in entire accord as to whether the payment of a stock subscription can be made in anything else than money, some holding one way and some the other. But the class of authorities which declare that a subscription may be paid otherwise than in money, we regard as asserting a more reasonable doctrine, a doctrine better adapted to the practical affairs of business life. Regarding the matter then in this light, we shall rule that payment of stock subscriptions

38. New Haven Horse Nail Co. v. Linden Spring Co., 142 Mass. 349.

39. Camden v. Stuart, 144 U. S. 104, 36 L. Ed. 366.

40. Drummond's Case, L. R., 4 Ch. App. 772.

need not be in cash, but may be in whatever, considering the situation of the corporation, represents to that corporation a fair, just, lawful and needed equivalent for the money subscribed. Any other doctrine than this would, as it seems to us, place a corporation at a disadvantage, under a disability not contemplated by the law and under which a natural person does not labor. Besides, a corporation, unless prohibited by statutory provisions, has a general capacity of contracting which the common law concedes to every one ordinarily competent to enter into binding engagements."[41]

The danger inherent in the organization of a corporation whose stock is issued wholly or in part for patent rights, is greatest in those jurisdictions in which the rule obtains which is followed in Missouri: "That it is the duty of the stockholder, and not of the creditor, to see that it is so paid; hence, the inquiry in a case between the creditor and a stockholder when property has been paid in for the capital stock of a corporation; is not whether the stockholder believed or had reason to believe that the property was equal in value to the par value of the capital stock; but whether, in point of fact, it was such equivalent."[42]

The rule that letters patent, or interests therein can be taken in payment of stock subscriptions is general in the United States; the difficulty lies in the remedy, or in the burden of proof that is imposed upon the creditor seeking to establish the personal liability of the subscribers to the stock. The Illinois Supreme Court has referred to this variance in the adjective law in the several jurisdictions as follows: "Some of the cases hold that over-valuation will not render the stockholder lia-

41. Sherwood, J., in Liebke v. Knapp, 79 Mo. 22, 24, 49 Am. Rep. 212.

42. Brace, J., in Van Cleve v. Berkey, 143 Mo. 109, 136.

ble for the difference between the actual and accepted values, unless there is affirmative proof of fraud *aliunde;* but other cases hold what we regard as the better view, namely, that where property whose value is well known or can be easily learned is taken at an exaggerated estimate, a strong presumption is raised that the valuation is not in good faith and is made for a fraudulent purpose. This presumption will be conclusive unless rebutted by satisfactory evidence explanatory of the apparent fraud. Where the over-valuation is so great that the fraudulent intent appears on its face and is not explained, the court will hold it to be fraudulent as matter of law * * *. If there is a fraudulent over-valuation of the property taken by the corporation for the stock, the stockholder is liable for the difference between the actual value and the accepted value of such property and consequently his stock is regarded as unpaid stock to the extent of that difference. Hence, proof of fraudulent over-valuation is proof that the stock is unpaid. Under the allegation that the stock is unpaid, any proof that it is unpaid, even though it be proof of the unpaid difference referred to as growing out of a fraudulent over-valuation, may be legitimately introduced."[43]

The doctrine followed by the Federal Courts in these cases is thus formulated by Mr. Justice Field:

"A gross and obvious over-valuation of property would be strong evidence of fraud.[44] But the allegation of intentional and fraudulent under-valuation (over-val-

43. Magruder, J., in Coleman v. Howe, 154 Ill. 458; for former decisions in that State see, Alling v. Wenzell, 27 Ill. App. 511; Howe v. Illinois Agricultural Works, 46 Ill. App. 85; National Bank of America v. Pacific Ry. Co., 66 Ill. App. 320; Union Ins. Co. v. Frear Stone Mfg. Co., 97 Ill. 537. The rule is the same in Missouri; see Van Cleave v. Berkey, 143 Mo. 109 121.

44. Citing, Boynton v. Hatch, 47 N. Y. 255; Van Cott v. Van Brunt, 82 N. Y. 535; Carr v. LeFevre, 27 Pa. 413.

uation) of the property is not sustained by the evidence. The patent and the machinery had been used by the corporation in their business which was continued under the charter. They were immediately serviceable, and therefore had to the company a present value. The corporators may have placed too high an estimate upon the property, but the court below finds that its valuation was honestly and fairly made; and there is only one item, the value of the chartered privilege, which is at all liable to any legal objection. But if that were deducted, the remaining amount would be so near to the aggregate capital that no implication could be raised against the entire good faith of the parties to the transaction."[45]

The remedy of the creditor seeking to charge stock subscribers with liability in cases of the kind under consideration is, in some jurisdictions, by a motion for judgment in the suit in which judgment has been obtained against the corporation, and the execution returned unsatisfied in whole or in part. In the absence of such statutory provisions the remedy is by bill in equity, which may be brought in any jurisdiction where the stockholder may be lawfully served with process.[46]

"The judgment ascertains the amount due, and apportions it between the * * * defendants in proportion to their respective holdings, and provides that, if satisfaction cannot he had against either, the other shall make up his deficiency. This is in accordance with the principle on which courts of equity proceed in such cases;

45. Colt v. North Carolina Gold Amalgamating Co., 119 U. S. 343, 30 L. Ed. 420. To the same effect, see, Fogg v. Blair, 139 U. S. 118, 35 L. Ed. 104; Clark v. Bever, 139 U. S. 96, 35 L. Ed. 88; Handley v. Stutz, 139 U. S. 417, 35 L. Ed. 227; Kelley v. Fletcher, 94 Tenn. 1; Gilke & Anson Co. v. Dawson Town & Gas Co., 46 Neb. 333; Lake Superior Iron Co. v. Drexel, 90 N. Y. 87; Bickley v. Schlag, 46 N. J. Eq. 533; opposed, see Henderson v. Turngren, 9 Utah 432; Chisholm Bros. v. Forny, 65 Iowa 333.

46. Leucke v. Tredway, 45 Mo. App. 507.

the shareholders are assessed to make up the sum required to be raised, but with the proviso that the shareholders who are solvent must, to the extent of their liability, make up the deficiencies caused by the failure of the insolvents to respond."[47]

From the foregoing, it is obvious that counsel must have careful recourse, when advising in the organization of corporations, to the enabling acts and the decisions of the state of the incorporation. Where it is possible, it is advisable to safeguard the subscriber by an appraisement or other ascertainment of the value of the patent, or license, sought to be used in payment for the stock subscription. Some of the states have provisions by statute for such appraisement. The importance of securing some kind of valuation of the patent franchise is emphasized by the criticisms which the courts have made of various schemes of incorporation of this kind, such as the following:

"As the result shows, the whole matter was a mere speculation, and while the individual defendants doubtless were deceived by Braun, and gulled into the belief that they would become millionaires by investing two hundred dollars apiece in this enterprise, the court cannot regard such a transaction as amounting to a payment of the shares of stock which they respectively received in this corporation."[48] In a New York case we read: "The transfer of a patent which had no ascertained value, which, in the language of the witness, 'as it turned out was worth nothing,' cannot be regarded as 'money,' or its equivalent, because those engaged in

47. Thompson, J., in Leucke v. Tredway, 45 Mo. App. 507, 519, citing, Erickson v. Nesmith, 46 N. H. 371; Hodges v. Mining Co., 9 Or. 200; Perkins v. Sanders, 56 Miss. 733; Munger v. Jacobson, 99 Ill. 349; Godfrey v. Terry, 97 U. S. 171, 176, 177, 24 L. Ed. 944, 945, 946.

48. Van Cleave v. Berkey, 143 Mo. 109, 117.

the management of the company believe at the time it is valuable, and receive it after organization, upon some fixed estimate of its value, between them and the subscribers, as so much money. Before a thing can be regarded as money or its equivalent, it must be an actual, positive, and ascertained value—a value so thoroughly ascertained and fixed at the time, that it can at once be changed into money, of which it is regarded as the equivalent."[49]

§ 260. Taxation of Letters Patent.

The power of Congress to impose a tax on letters patent cannot be doubted. But the question of the right of the several states to levy taxes upon patents or patent rights is one which is as yet undecided by the United States Supreme Court.[50]

In a suit in equity to enjoin the collection of taxes levied under a statute of Indiana, upon the capital stock of a corporation representing, in part, the value of certain letters patent, the Circuit Court for the District of Indiana granted an injunction restraining the collection of the taxes so levied "or any other amount (of taxes) which may be claimed to be due on account of the value of any patent rights or letters patent owned or held by complainants."[51]

The Court of Appeals held that the suit was not one arising under the patent laws of the United States; that it, consequently, was without jurisdiction to entertain the appeal, and that the appeal should be taken to the United States Supreme Court.[52]

49. Tasker v. Wallace, 6 Daly (N. Y.) 364.

50. See Notes, 29 L. R. A. 792, 58 L. R. A. 564.

51. Holt v. Indiana Mfg. Co., 80 Fed. Rep. 1, 2, 25 C. C. A. 301.

52. Holt v. Indiana Mfg. Co., 80 Fed. Rep. 1, 2, 25 C. C. A. 301.

That court, upon an appeal being taken to it, reversed the decree upon the sole ground that the Circuit Court had no jurisdiction.[53]

However, the absence of an express adjudication by the Supreme Court upon the question of the taxing power of the states in this regard, does not leave the question in any serious doubt, in view of the finality and comprehensiveness with which the Supreme Court has defined the word "franchise" and laid down the rule that no franchise granted by Congress can be subjected to taxation by a State without the consent of Congress.

The definition and the rule are thus expressed by Mr. Justice Bradley:

"Assuming, then, that the Central Pacific Railroad Company has received the important franchises referred to by grant of the United States, the question arises whether they are legitimate subjects of taxation by the State. They were granted to the company for national purposes and to subserve national ends. It seems very clear that the State of California can neither take them away, nor destroy nor abridge them, nor cripple them by onerous burdens. Can it tax them? It may undoubtedly tax outside visible property of the company situated within the State. That is a different thing. But may it tax franchises which are the grant of the United States? In our judgment it cannot. What is a franchise? Under the English law Blackstone defines it as 'a royal privilege, or branch of the king's prerogative, subsisting in the hands of a subject.' 2 Com. 37. Generalized, and divested of the special form which it assumes under a monarchical government based on feudal traditions, a franchise is a right, privilege or power, of public concern, which ought not to be exercised by private individuals at their mere will and pleasure, but should

53. Holt v. Indiana Mfg. Co., 176 U. S. 68, 73, 44 L. Ed. 374, 377.

be reserved for public control and administration, either by the government directly, or by public agents acting under such conditions and regulations as the government may impose in the public interest and for the public security. Such rights and powers must exist under every form of society. They are always educed by the laws and customs of the community. Under our system, their existence and disposal are under the control of the legislative department of the government, and they cannot be assumed or exercised without legislative authority. No private person can establish a public highway, or a public ferry or railroad, or charge tolls for the use of the same, without authority from the Legislature, direct or derived. These are franchises. No private person can take another's property, even for a public use, without such authority; which is the same as to say that the right of eminent domain can only be exercised by virtue of a legislative grant. This is a franchise. No persons can make themselves a body corporate and politic without legislative authority. Corporate capacity is a franchise. The list might be continued indefinitely.

"In view of this description of the nature of a franchise, how can it be possible that a franchise granted by Congress can be subject to taxation by a State without the consent of Congress? Taxation is a burden, and may be laid so heavily as to destroy the thing taxed, or render it valueless. As Chief Justice Marshall said in McCulloch v. Maryland, 17 U. S. (4 Wheat.) 316, 4 L. Ed. 579, 'the power to tax involves the power to destroy.' Recollecting the fundamental principle that the Constitution, laws and treaties of the United States are the supreme law of the land, it seems to us almost absurd to contend that a power given to a person or corporation by the United States may be subjected to taxation by a State. The power conferred emanates from,

and is a portion of, the power of the government that confers it. To tax it is not only derogatory to the dignity, but subversive of the powers, of the government, and repugnant to its paramount sovereignty. It is unnecessary to cite cases on this subject."[54]

Judge Barr, on circuit, has dealt directly with the subject, as follows:

"The patent right * * * which is a grant by the United States, cannot be taxed by a State. If the authority to tax such a right of exclusion exists at all, the limitation upon its exercise must depend alone upon the Constitution and laws of the several states, and such an authority is utterly inconsistent with the grant of the patent right which is by the Constitution of the United States given exclusively to Congress."[55]

There is a distinction to be drawn between taxation of a patent right taxation of articles made under a patent, and taxation based, as in the New York statute, upon a "corporate business or franchise."

In the last named class of cases, the fact that part of the capital stock is invested in United States bonds, over which the State has no taxing power, does not invalidate a general assessment of the corporation's "business or franchise." In so holding,[56] Mr. Justice Field said: "We hold * * * that the tax for which the suit is brought is not a tax on the capital stock or property of the company, but upon its corporate franchise, and is not therefore subject to the objection stated by

54. California v. Central Pacific R. Co., 127 U. S. 1, 32 L. Ed. 150.

55. In re Sheffield, 64 Fed. Rep. 833, 836.

56. Home Ins. Co. v. New York, 134 U. S. 594, 33 L. Ed. 1025; a decision on rehearing; the decision of the Court of Appeals of New York (92 N. Y. 328) was affirmed by a divided court in Home Ind. Co. v. New York, 119 U. S. 129, 30 L. Ed. 350, and a rehearing ordered in Home Ins. Co. v. New York, 122 U. S. 636, 30 L. Ed. 1241.

counsel. because a portion of its capital stock is invested in securities of the United States."

Coming to the decisions of the State courts we find that the New York court has held that the investment of the capital of a corporation in patents does not exempt any part of its "corporate business or franchise" from taxation,[57] while holding in another case that patent rights are exempt from taxation by the State,[58] and, again, that in assessing a tax upon the personal property of a corporation, the amount invested by it in patent rights must be exempted.[59]

In Pennsylvania, capital stock issued for patent rights is held exempt from taxation;[60] the same rule applies to the capital of the corporation invested in patent rights, and it is immaterial whether the patent issues to the corporation as patentee, or the corporation's rights thereunder are acquired after the issuance of the patent.[61]

But the rule is different where the corporate stock is issued for the use of patented appliances, which stock is, like the appliances themselves, property subject to taxation.[62]

57. People ex rel. Edison Elec. Light Co. v. Campbell, 138 N. Y. 542, 20 L. R. A. 453, 34 N. E. Rep. 370; People ex rel. Edison Elec. Light Co. v. Wemple, 61 Hun. 53, 15 N. Y. Supp. 711, reversed on other grounds in 129 N. Y. 664, 29 N. E. Rep. 812. To the same effect, see, Marsden Co. v. Board of Assessors, 61 N. J. Law 461.

58. People ex rel. Edison Elec. Illuminating Co. v. Brooklyn, 156 N. Y. 417, 42 L. R. A. 290, 51 N. E. Rep. 269.

59. New York & N. J. Telephone Co. v. Neff, 15 App. Div. 8, 44 N. Y. Supp. 46.

60. Com. v. Philadelphia Co., 157 Pa. 527, 27 Atl. Rep. 378; Com. v. Edison Elec. Light Co., 157 Pa. 529, 27 Atl. 379.

61. Com. v. Westinghouse Elec. & Mfg. Co., 151 Pa. 265, 24 Atl. Rep. 1107; Com. v. Westinghouse Air Brake Co., 151 Pa. 276, 24 Atl. Rep. 1111.

62. Com. v. Central Dist. & Printing Teleg. Co., 145 Pa. 121, 22 Atl. Rep. 841; Com. v. Philadelphia Co., 145 Pa. 142, 22 Atl. Rep. 843; Com. v. Brush Elec. Light Co., 145 Pa. 147, 22 Atl. Rep. 844; Com. v. Edison Elec. Light Co., 145 Pa. 131, 22 Atl. Rep. 841; Com. v. Chester Elec. Light & P. Co., 145 Pa. 139, 22 Atl. Rep. 846.

CHAPTER XII.

INFRINGEMENT.

§ 261. Infringement defined.

As we have seen elsewhere, the right vested in a patentee by the grant of the patent is exclusive or monopolistic in character, for a term of years named, in a territory named, and embraces three distinct substantive rights, namely, the right to make, the right to use and the right to sell. An invasion of either of these rights by another, during the life of the patent and within the territory named in the patent, is called an infringement; and the device or art thus wrongfully made or practiced is also called an infringement; but whether the act or the instrumentality is meant can always be gathered from the context of the opinions. Thus we find in one paragraph by a very able judge, the word "infringement" aptly used in both of its meanings. "An infringement is a copy made after and agreeing substantially and in principle with the article described in the Letters Patent. The act of Congress confers upon the patentee and his assigns the exclusive right to make, to use, or to sell to others to be used, the article patented. It is, therefore, an infringement to make or manufacture a patented article though it is never used by the maker. It is likewise an infringement to use a patented article though made by another. It is also an infringement to sell to others the article when it is manufactured by another. The law vests the exclusive right to do all these three things in the patentee, and hence for another to do one or all of them is an infringement."[1]

1. Sherman, J., in Haselden v. Ogden, 3 Fisher 378, Fed. Case No. 6190.

An English text-writer gives this terse definition, "the infringement of a patent is the doing that which the patent prohibits from being done."[2]

§ 262. Contributory infringement defined.

"Contributory infringement has been well defined as 'the intentional aiding of one person by another in the unlawful making or selling or using of the patented invention.'"[3]

"It is well settled that where one makes and sells one element of a combination covered by a patent with the intention and for the purpose of bringing about its use in such a combination he is guilty of contributory infringement and is equally liable to the patentee with him who in fact organizes the complete combination. The leading case on the subject is Wallace v. Holmes (9 Blatchf. 65, Fed. Case 17,100). It was cited with approval in American Cotton Tie Co. v. Simmons, 106 U. S. 89, 27 L. Ed. 79, and the same doctrine was applied and extended by this court in Heaton-Peninsular Button Fastener Co. v. Eureka Specialty Co., 77 Fed. Rep. 288, 25 C. C. A. 267, to a case where the article sold was not even an element of the patented combination, but was an article the use of which in connection with (the) patented combination was a violation of the conditions of a license, and destroyed the protection the license would otherwise have afforded."[4]

2. Terrell on Patents, 4th Ed. (London, 1906), p. 274.

3. Townsend, J., in Thomson-Houston Elec. Co. v. Kelsey Elec. Ry. Specialty Co., 72 Fed. Rep. 1016 (reversed upon other grounds in Thomson-Houston Elec. Co. v. Kelsey Elec. Ry. Specialty Co., 75 Fed. Rep. 1005, 22 C. C. A. 1), adopting the definition of Howson, Contributory Infringement, p. 1.

4. Taft, J., in Thomson-Houston Elec. Co. v. Ohio Brass Co., 80 Fed. Rep. 712, 721, 26 C. C. A. 107; citing, Travers v. Beyer, 26 Fed. Rep. 450; Willis v. McCullen, 29 Fed. Rep. 641; Alabastine Co. v. Payne, 27 Fed. Rep. 559; Celluloid Mfg. Co. v. American Zylonite Co., 30 Fed. Rep. 437.

§ 263. Intent—The necessity of establishing and how proven.

As will be seen from the foregoing paragraph, the intent to aid in the infringement is essential in fixing the liability of the contributory infringer;—he may well be termed a fractional infringer, contributing his proportion to the entity which is the whole, and ultimate, infringement.

There are, however, two classes into which all cases arising in this corner of the domain of patent law may be divided; one, in which the article furnished by the defendant to the real infringer is useful in other ways than in the infringing act or thing, in which class the intent of the defendant must be established by proof *aliunde;* the other in which the article furnished is so peculiarly adapted to the infringing use, that its sale carries with it the presumption of the defendant's wrongful intent. Examining into these divisions, the illustrative cases disclose the following:

A. *Cases involving an ordinary article of commerce.*

The following statements of the doctrine are comprehensive:

> "The doctrine of contributory infringement has never been applied to a case where the thing alleged to be contributed is one of general use, suitable to a great variety of other methods of use, and especially where there is no agreement or definite purpose that the thing sold shall be employed with other things so as to infringe a patent right. The cases which are cited (Thomson-Houston Electric Co. v. Kelsey Electric Ry. Specialty Co., 72 Fed. Rep. 1016; Heaton-Peninsular Button-Fastener Co. v. Eureka Specialty Co., 77 Fed. Rep. 297, 25 C. C. A. 267, 35 L. R. A. 728), do not support the position taken; for in those cases not only was the thing furnished peculiarly adapted to the infringing use, but

the court found as a matter of fact that there was a wrongful purpose on the part of the contributing defendant that the article supplied should be so used. These are the characteristics of a case for making one liable as a contributory infringer."[5]

"The intent and purpose that the element made and sold shall be used in a way that shall infringe the combination in which it is an element constitutes the necessary concert of action between him who furnishes the single part and he who actually does the injury by the assembling and using of all the parts in such a way as to be an infringement."[6]

It is instructive to compare the opinions in two cases involving the sale of acid phosphate as contributing to the infringement of Letters Patent 474,811, of May 17, 1892, to Catlin for improvements in baking preparations. One of its claims, was:

(1) A baking preparation containing phosphoric acid or its compounds in granular condition essentially free from pulverulent phosphatic material, substantially as described.

The patent had been sustained.[7]

Subsequently two suits were brought against dealers in granular acid phosphate, in one of which the charge of contributory infringement was found in the negative by the Circuit Court, in whose opinion we read:

"The specific sale sought to be proven by the above testimony was of a barrel of acid phosphate, a constituent element in the manufacture of baking powder, and the claim is made that it was knowingly sold for the purpose of being used in the manufacture of baking powder,

5. Edison Electric Light Co. v. Peninsular Light, Power & Heat Co., 95 Fed. Rep. 669 at page 673.

6. Bullock Electric & Mfg. Co. v. Westinghouse Electric Mfg. Co., 129 Fed. Rep. 105, 111, 63 C. C. A. 607.

7. Rumford Chemical Works v. New York Baking Powder Co., 134 Fed. Rep. 385, 67 C. C. A. 367.

that it was designed and intended for that use solely, and that consequently the defendant by the sale became guilty of contributory infringement. Assuming that the article in question was sold by the defendant to Clotworthy or others, there is no evidence showing for what purpose it was sold or used, or that it was only useful when combined in the manner provided in the patent in suit. On the contrary, there is evidence that it was an article of commerce in general and common use for a number of specific purposes. It is true it could be combined and used as claimed in the patent, but it could likewise be used, and was sold and used for a variety of other purposes, and I find no evidence in the case to show that there was any agreement, knowledge, or understanding that any acid phosphate sold by the defendant was to be combined with other articles to infringe the complainant's patent. The complainant made Heller his own witness, and his testimony, corroborated by Wadman to some extent as to the variety of uses for which acid phosphate is manufactured, adapted, and sold, is uncontradicted. In order to establish contributory infringement, it should be convincingly shown that a granular acid phosphate manufactured by the defendant went into a baking powder, which infringed the patent in suit, and that the defendant manufactured and sold said phosphate knowing, or having reasonable cause to know, that it was to be used in an infringing baking powder."[8]

In the Second Circuit, the Court of Appeals held the opposite upon the same facts, saying:

"The Catlin patent was upheld because the inventor had succeeded in getting rid of the fine powder which

8. Rumford Chemical Works v. Hygienic Chemical Co., 148 Fed. Rep. 862, 866.

was supposed to be indispensable to success, and used a powder in a uniformly granulated condition. It is, therefore, the use of such powder which constitutes infringement and when a manufacturer of acid phosphates sells a manufacturer of baking powder a barrel of granular acid phosphate the presumption is not unfair that he expects it to be used for baking powder. There is testimony tending to show that 'special' phosphate is specially adapted for use in making baking powder."[9]

We thus see that the intent may be inferred from the peculiar circumstances attending the sale of an ordinary, staple, article of commerce.

B. Where the element sold by the alleged contributory infringer is useful, peculiarly or solely, as and for the performance of a function in the infringing combination, the intent is presumed. In some of the cases we read:

"Defendants cannot escape liability for infringement. They are making, and putting upon the market, an article, which, of necessity, to their knowledge, is to be used for the purpose of infringing the complainant's patent. They thereby concert with those to whom they sell the blocks to invade the complainant's rights. They are intentional promoters of the ultimate act of infringement."[10]

"This knuckle is not an ordinary tool or piece of mechanism, which can be procured at any general hardware store, but is unique, and can be used only in connection with the balance of complainants device. There can be no doubt, therefore, that the defendant intended to manufacture and sell the knuckle to be used in, and as forming an important and essential part of, the com-

9. Rumford Chemical Works v. Hygienic Chemical Co., 159 Fed. Rep. 436, 438, 86 C. C. A. 416.

10. Wallace, J., in Travers v. Beyer, 26 Fed. Rep. 450.

plainant's patented device. If the defendant can do this with impunity, it, or any other person, can certainly manufacture and sell the other less important parts, and thereby the value of complainant's monopoly will be limited to the first sales made by it. This cannot be the law."[11]

"Defendants further suggest that their trolley stand is capable of a lawful as well as an unlawful use, by way of reparation or restoration of a patented device, and that the presumption must be that this is the purpose for which it is to be used. As already shown, it does not appear, by advertisements or sales, that its use is to be confined to such purpose. Inasmuch as the defendants make and thus sell stands which are useful only for the purpose of performing functions involved in the operation of the patent, it raises a presumption that they intend their stands should be so used. A suit for infringement cannot be defeated by merely showing that such devices could be used for some other purposes."[12]

§ 264. Contributory infringement by the sale of machinery or materials for use in infringement.

Where apparatus is sold with the intent that it shall be used in practicing the invention of a process patent, contributory infringement exists; and intent is presumed or must be proven, under the rule just considered. Thus where the defendant sold filters adapted and intended solely to filter beer in accordance with complainant's patented process.[13]

11. St. Louis Car Coupler Co. v. Shickle, Harrison & Howard Iron Co., 70 Fed. Rep. 783.

12. Townsend, J., in Thomson-Houston Elec. Co. v. Kelsey Elec. Ry. Specialty Co., 72 Fed. Rep. 1016, 1018.

13. Loew Filter Co. v. German-American Filter Co., 107 Fed. Rep. 949, 47 C. C. A. 94.

Similarly, where plaintiff's process was for water filtration and defendant sold filters, tanks, and a series of pipes "unnecessary and worthless" except to infringe plaintiff's process patent.[14]

And where plaintiff's patent was for "an improvement in obtaining cream from milk," and defendant sold milk cans "accompanied by directions to purchasers as to the mode of using them, which directions require the adoption and use of the (plaintiff's) process," he was subjected to an injunction and an accounting.[15]

§ 265. Materials.

A licensee under a process patent knowingly selling materials used in the process to unlicensed persons for use in infringing, is a contributory infringer.[16] And so of one who sells a compound with directions to so make a liquid from it as to infringe a patent for a composition of matter.[17]

§ 266. Infringement resulting from wear or adjustment.

In the early case of Page v. Ferry[18] a jury found for the plaintiff in a case in which they were instructed that a machine so constructed and intended that by the wear of the metal in use its shaft would acquire the "end-play" of the patent in suit, through the wearing of the metal in use, would be an infringement. On the other hand, a machine that only comes within the claim of the patent in suit by misuse, or through accident or the negligence of the user, does not render its maker liable for infringement.[19]

14. New York Filter Mfg. Co. v. Jackson, 91 Fed. Rep. 422, 425.

15. Boyd v. Cherry, 50 Fed. Rep. 279.

16. Willis v. McCullen, 29 Fed. Rep. 641.

17. Alabastine Co. v. Payne, 27 Fed. Rep. 559.

18. 1 Fisher 298, Fed. Case 10,662.

19. Brown v. Traver, 70 Fed. Rep. 810, 815.

"If the machine, as made by the defendant, was not an infraction of the plaintiff's patent, the alteration of it, by a third person, will not make the defendant liable for an infraction to which he was not a party. But if the machine, as made by him, was intended by him to operate in such a way as to violate the patent, and has, in part, so operated, he was a party to the infraction, notwithstanding the ingenuity with which he may have sought to disguise his wrong;" (when he sent the machine out with journals separated, while in use they would be adjusted to contact).[20]

§ 267. Replacement and repair of patented devices.

In an early case Mr. Chief Justice Taney said "when the (patented) machine passes to the hands of the purchaser, it is no longer within the limits of the monopoly. It passes outside of it."[21] We have elsewhere considered those restrictions upon the use or sale of patented articles which may be created by the agreement of the original vendor and vendee. We will here examine the limits within which the patented device may be lawfully altered, or its integrity departed from by replacement or repair in the hands of the original or a subsequent vendee.

The leading case will first be drawn upon as a foundation for our analysis of the later adjudications.

"The proof in this case is, that one of Woodworth's machines, properly made, will last in use for several years, but that its cutting knives will wear out and must be replaced at least every sixty or ninety days.

"The right to replace them was a part of the invention transferred to the assignee at the time that he bought it, without which his purchase would have been

20. Kane, J., in Knight v. Gavit, Fed. Case 7884.

21. Bloomer v. McQuewan, 14 How. 539, 549, 14 L. Ed. 532, 537.

useless to him, except for sixty or ninety days after a machine had been put in use. It has not been contended, nor can it be, that such can be a limitation of the assignee's right in the use of the invention.

"If, then, the use of the machine depends upon the replacement of the knives, and the assignee could replace them from time to time, as they were needed, during the first term of the patent, though they are essential and distinct constituents of the principle or combination of the invention, frequently replacing them, according to the intention of the inventor, is not a reconstruction of the invention, but the use of so much of it as is absolutely necessary to identify the machine with what it was in the beginning of its use, or before that part of it had been worn out.

"The right of the assignee to replace the cutter knives is not because they are of perishable materials, but because the inventor of the machine has so arranged them as a part of its combination, that the machine could not be continued in use without a succession of knives at short intervals. Unless they were replaced, the invention would have been but of little use to the inventor or to others. The other constituent parts of his invention, though liable to be worn out, are not made with reference to any use of them which will require them to be replaced. These, without having a definite duration, are contemplated by the inventor to last so long as the materials of which they are formed can hold together in use in such a combination. No replacement of them at intermediate intervals is meant or is necessary. They may be repaired as the use may require. With such intentions, they are put into the structure. So it is understood by a purchaser, and beyond the duration of them a purchaser of the machine has not a longer use. But if another constituent part of the combination is meant

to be only temporary in the use of the whole, and to be frequently replaced, because it will not last as long as the other parts of the combination, its inventor cannot complain, if he sells the use of his machine, that the purchaser uses it in the way the inventor meant it to be used, and in the only way in which the machine can be used.

"Such a replacement of temporary parts does not alter the identity of the machine, but preserves it, though there may not be in it every part of its original material."[22]

It will be observed that the rule of this case must be limited to the facts, and that the cutters and knives were themselves not the subjects of a patent. In the case of a knitting machine, where the vendor had separate patents upon the machine and the needles used in it, the fact that the needles wore out and became useless gave the vendee no right to make new needles for use in his machine.[23]

By analogy to the leading case, the purchaser of a patented toilet paper fixture does not violate the rights of his vendor by supplying the fixture with roll toilet paper from another source. "The replacement is of a product which it is the object of the mechanism to deliver."[24]

From this foundation, we reach the general rule that the test of the limit to which the owner of a patented machine may go, by way of replacement, repair or improvement, is that of the identity of the machine as altered with the machine as it left the hands of the original vendor.

22. Mr. Justice Nelson, in Wilson v. Simpson, 50 U. S. (9 How.) 109, 125, 13 L. Ed. 66.

23. Aiken v. Manchester Print Works, 2 Cliff 435, Fed. Case 113.

24. Morgan Envelope Co. v. Albany Perforated Wrapper Paper Co., 152 U. S. 425, 434, 38 L. Ed. 500, 504.

"A purchaser, then, may repair, but not reconstruct or reproduce, the patented device or machine. Repair is 'restoration to a sound, good, or complete state after decay, injury, dilapidation, or partial destruction.' Reconstruction is the 'act of constructing again.' Reproduction is a 'repetition,' or 'the act of reproducing.' These definitions are instructive in bringing home to the mind that repair carries with it the idea of restoration after decay, injury, or partial destruction and that reconstruction or reproduction carries with it the idea of a complete construction or reproduction over again.

"But the difficult question still remains, what is legitimate repair, and what is reconstruction or reproduction as applied to a particular patented device or machine? When does repair destroy the identity of such device or machine and encroach upon invention? At what point does the legitimate repair of such device or machine end, and illegitimate reconstruction begin?

"It is impracticable, as well as unwise, to attempt to lay down any rule on this subject, owing to the number and infinite variety of patented inventions. Each case, as it arises, must be decided in the light of all the facts and circumstances presented, and with an intelligent comprehension of the scope, nature, and purpose of the patented invention, and the fair and reasonable intention of the parties. Having clearly in mind the specification and claims of the patent together with the condition of decay or destruction of the patented device or machine, the question whether its restoration to a sound state was legitimate repair, or a substantial reconstruction or reproduction of the patented invention, should be determined less by definitions or technical rules than by the exercise of sound sense and an intelligent judgment."[25]

25. Colt, J., in Goodyear Shoe Machinery Co. v. Jackson, 112 Fed. Rep. 146, 150, 50 C. C. A. 159, 55 L. R. A. 692.

§ 268. Defenses to the charge of infringement.

The statutory provision is as follows:

§ 4920. "In any action for infringement the defendant may plead the general issue, and, having given notice in writing to the plaintiff or his attorney thirty days before, may prove on trial one or more of the following special matters:

First. That for the purpose of deceiving the public the description and specification filed by the patentee in the Patent Office was made to contain less than the whole truth relative to his invention or discovery, or more than is necessary to produce the desired effect; or,

Second. That he had surreptitiously or unjustly obtained the patent for that which was in fact invented by another, who was using reasonable diligence in adapting and perfecting the same; or,

Third. That it has been patented or described in some printed publication prior to his application for a patent therefor; or,

Fourth. That he was not the original and first inventor or discoverer of any material and substantial part of the thing patented; or,

Fifth. That it had been in public use or on sale in this country for more than two years before his application for a patent, or had been abandoned to the public."

These defenses may be set up either at law or in equity,[26] and the section applies to patents for designs as well as to the other classes of patents.[27]

As to these defenses, the law has resolved itself into a series of well defined rules; and they will be found treated in connection with those rules, which are here appended.

26. Bates v. Coe, 91 U. S. 31, 25 L. Ed. 68.

27. Anderson v. Eller, 46 Fed. Rep. 777.

§ 269. Rule I. Two separate elements may be made integral or one element divided and infringement exist.

"One may not escape infringement by the mere joinder of two elements into one integral part. If the united part effects the same result in substantially the same way as the separate parts before the union, the change is colorable."[28]

Nor the charge of infringement averted by the division of one element into two, if the two resulting parts jointly act to produce the unitary result of the single element.[29] "It is well settled that the mere doubling of parts to produce the same result does not prevent infringement, even though it may involve tributary invention."[30]

§ 270. Rule II. "Non-interchangeability of parts tends strongly to negative infringement."[31]

This rule has been illuminated by Judge Seaman, as follows: "Interchangeability is referred to in Miller v. Eagle Mfg. Co. (151 U. S. 186, 38 L. Ed. 121), and other cases cited in the argument on behalf of the appellee, as

28. Lurton, J., in Bundy Mfg. Co. v. Detroit Time Register Co., 94 Fed. Rep. 524, 538, 36 C. C. A. 375. To the same effect, see, National Car Brake Shoe Co. v. Terre Haute Car & Mfg. Co., 19 Fed. Rep. 514, 516; McDonald v. Whitney, 24 Fed. Rep. 600; Ballard v. McCluskey, 58 Fed. Rep. 880; Oval Wood Dish Co. v. Sandy Creek Mfg. Co., 60 Fed. Rep. 285.

29. Westinghouse v. New York Air Brake Co., 59 Fed. Rep. 581; Strobridge v. Lindsey, 6 Fed. Rep. 510, 513; Wheeler v. Clipper Mower Co., 6 Fisher 2, Fed. Case No. 17,493.

30. Taft, J., in Bonnette Arc Lawn Sprinkler Co. v. Koehler, 82 Fed. Rep. 428, 431, 27 C. C. A. 200, 203.

31. Acheson, J., in Pittsburg Meter Co. v. Pittsburg Supply Co., 48 C. C. A. 589, 109 Fed. Rep. 644, 649, following Miller v. Eagle Manufacturing Co., 151 U. S. 186, 208, 38 L. Ed. 121. To the same effect, see, American Pneumatic Tool Co. v. Philadelphia Pneumatic Tool Co., 123 Fed. Rep. 891, 896; Prouty v. Ruggles, 41 U. S. (16 Peters) 336, 10 L. Ed. 985; Brooks v. Fiske, 56 U. S. (15 How.) 212, 14 L. Ed. 665; Eames v. Godfrey, 68 U. S. (1 Wall.) 78, 17 L. Ed. 547.

an 'important test in determining the question of infringement,' and it is contended that the interchangeability of parts and functions thus conceded does not meet the requirements for such test, upon the assumption that the interchange involves substantial reorganization of one and the other structure. This contention is without force, under our conclusion that these deviations are plain equivalents within the scope of the patent, and do not depart substantially from the invention. If the test is applicable to such cases of recombination, the corresponding arrangement of means is essential for its application, and in that view interchangeability appears for any value it may have in solving the issue."[32]

§ 271. Rule III. Any one who has made a separate profit from the sale of an infringing article is liable.[33]

"Any person who has made a separate profit to himself out of the sale of infringing goods, and even a servant who has derived a distinct and independent benefit from invasions of the patent, incurs a distinct separate liability."[34]

§ 272. Rule IV. To infringe, substantially similar means must be employed.

"To be an infringement, 'the alleged infringer must have done something more than reach it by substantially the same or similar means, or the rule that the function

32. Columbia Wire Co. v. Kokomo Steel & Wire Co., 143 Fed. Rep. 116, 122, 74 C. C. A. 310.

33. Vaughn v. E. T. & Ga. Ry. Co., Fed. Case No. 16,898, 11 Off. Gaz. 789, 2 B. & A. 537; Maltby v. Bobo, Fed. Case No. 8998, 14 Blatch. 53; Steiger v. Heidelberger, 4 Fed. Rep. 455, 18 Blatch. 426; Estes v. Worthington, 30 Fed. Rep. 465; Featherstone v. Cycle Co., 53 Fed. Rep. 110; Armstrong v. Savannah Soap Works, 53 Fed. Rep. 125; Fishel v. Lueckel, 53 Fed. Rep. 499; Cramer v. Fry, 68 Fed. Rep. 201, 207; Graham v. Earl, 27 C. C. A. 377, 82 Fed. Rep. 737, 742.

34. Townsend, J., in Palmer v. Landphere, 99 Fed. Rep. 568, 569.

of a machine cannot be patented is of no practical value.' "[35]

"The question of infringement involves considerations of practical utility and of substantial identity, and therefore must be quantitative as well as qualitative."[36]

"Infringement should not be determined by a mere decision that the terms of the claim of a valid patent are applicable to the defendant's device. Two things are not precisely similar because the same words are applicable to each."[37]

The idea of means is of the very essence of the invention. He who has no idea of means has made no invention.

§ 273. Rule V. Identity or difference of result is no test of infringement.

To be an infringement the alleged infringer must have done something more than reach the same result.[38]

This rule must be read and considered in the light of the rule as to anticipation discussed *ante*, § 209.

§ 274. Rule VI. The knowledge or intent of the infringer is immaterial.

Thus the fact that the alleged infringer had no knowledge of the existence of the patent at the time of the

35. Lurton, J., in Bundy Mfg. Co. v. Detroit Time-Register Co., 94 Fed. Rep. 524, 540, quoting from Westinghouse v. Boyden Power Brake Co., 170 U. S. 569.

36. Brown, J., in Goodyear Shoe Mach. Co. v. Spalding, 101 Fed. Rep. 990, 994.

37. Brown, J., in Goodyear Shoe Mach. Co. v. Spalding, 101 Fed. Rep. 990, 994. Followed in Edison v. American Mutoscope & Biograph Co., 151 Fed. Rep. 767, 773, 81 C. C. A. 391.

38. Westinghouse v. Boyden Power Brake Co., 170 U. S. 569; Bundy Mfg. Co. v. Detroit Time-Register Co., 94 Fed. Rep. 524, 540; Westinghouse Air Brake Co. v. New York Air Brake Co., 119 Fed. Rep. 874, 56 C. C. A. 404; Water-Meter Co. v. Despar, 101 U. S. 332, 25 L. Ed. 1024. Pittsburg Meter Co. v. Pittsburg Supply Co., 109 Fed. Rep. 644, 651, 48 C. C. A. 580.

alleged infringing acts, is no defense to the charge of infringement.[39] The reason for this rule is stated by Mr. Justice Brewer to be that such a person "would be in the attitude of a subsequent inventor, and the prior inventor is the one who, under the statutes, is entitled to the monopoly."[40]

Under this rule, it is no defense to the charge of infringement that the defendant has submitted the alleged infringing device to experts and been advised that it did not infringe.[41]

§ 275. **Rule VII. "A combination is not infringed unless all its elements as they are claimed are used, whether they are essential or not."[42]**

39. Matthews v. Skates, Fed. Case No. 9291, 1 Fisher 602; Parker v. Haworth, Fed. Case No. 10,738, 4 McLean 370; National Car-Brake Shoe Co. v. Terre Haute Car & Mfg. Co., 19 Fed. Rep. 514, 520; Royer v. Coupe, 29 Fed. Rep. 358, 361; Bate Refrigerating Co. v. Gillett, 31 Fed. Rep. 809, 816.

40. United States v. Berdan, Firearms Mfg. Co., 156 U. S. 552, 566, 39 L. Ed. 530, 534.

41. Norton v. Eagle Automatic Can Co., 57 Fed. Rep. 929, 933.

42. Sanborn, J., in Portland Gold Mining Co. v. Hermann, 160 Fed. Rep. 91, 99, 87 C. C. A. 247; to the same effect, see, Fourot v. Hawes, 3 Fed. 456; Rowell v. Lindsay, 6 Fed. 290, 10 Biss. 217; (affirmed in 113 U. S. 97, 28 L. Ed. 906); Matteson v. Caine, 17 Fed. 525, 8 Sawy. 498; Howe v. Neemes, 18 Fed. 40; Gould v. Spicers, 20 Fed. 317; Saladee v. Racine Wagon, etc., Co., 20 Fed. 686; Blades v. Rand, 27 Fed. 93 (affirmed in 136 U. S. 631, 34 L. Ed. 553); Thoens v. Israel, 31 Fed. 556; Ott v. Barth, 32 Fed. 89; Tatum v. Gregory, 41 Fed. 142; Innis v. Oil City Boiler Works, 41 Fed. 788; Ross v. Montana Union R. Co., 45 Fed. 424; Ashton Valve Co. v. Coale Muffler, v. Safety Valve Co., 50 Fed. Rep. 100 (affirmed in 52 Fed. 314, 3 C. C. A. 98); Brown v. Stillwell & Bierce Mfg. Co., 57 Fed. 731-741, 6 C. C. A. 528; Engle Sanitary, etc., Co. v. Elwood, 73 Fed. 484; P. H. Murphy Mfg. Co. v. Excelsior Car-Roof Co., 76 Fed. 965, 22 C. C. A. 658; Adams Electric R. Co. v. Lindell R. Co., 77 Fed. 432, 23 C. C. A. 223 (affirming, 63 Fed. 986); Muller v. Lodge, etc., Mach. Tool Co., 77 Fed. 621, 23 C. C. A. 357; Carter Mach. Co. v. Hanes, 78 Fed. 346, 24 C. C. A. 128; Kansas City Hay-Press Co. v. Devol, 81 Fed. 726, 26 C. C. A. 578; Campbell Printing-Press & Mfg. Co. v. Duplex Printing-Press & Mfg. Co., 86 Fed. 315; Thompson v. Second Ave. Traction Co., 89 Fed. 321; Norton v.

"A claim for a combination is not infringed if any one of the described and specified elements is omitted, without the substitution of anything equivalent thereto."[43]

"If a patentee claims eight elements to produce a certain result, when seven will do it, anybody may use the seven without infringing the claim; and the patentee has practically lost his invention by declaring the materiality of an element that was in fact immaterial."[44]

This rule is psychologically akin to what logicians term "the law of parsimony." The simple, as opposed to the complex, is the common ideal of logic and of invention.

Wheaton, 97 Fed. 636; Starrett v. J. Stevens Arms & Tool Co., 100 Fed. 93, 40 C. C. A. 289; Wellman v. Midland Steel Co., 106 Fed. 221; Pittsburg Meter Co. v. Pittsburg Supply Co., 109 Fed. 644, 48 C. C. A. 580; Cimiotti Unhairing Co. v. Derbohlaw, 115 Fed. 510, 53 C. C. A. 164; American Fur Refining Co. v. Cimiotti Unhairing Mach. Co., 123 Fed. 869, 59 C. C. A. 357 (affirmed in, 198 U. S. 399, 49 L. Ed. 1100); Levy v. Harris, 130 Fed. 711, 65 C. C. A. 113; American Can Co. v. Hickmott Asparagus Canning Co., 137 Fed. 86; O. H. Jewell Filter Co. v. Jackson, 140 Fed. 340, 72 C. C. A. 304; American Chocolate Mach. Co. v. Helmstetter, 142 Fed. 978, 74 C. C. A. 240; H. F. Brammer Mfg. Co. v. Witte Hardware Co., 159 Fed. 726; Ajax Forge Co. v. Morden Frog, etc., Works, 156 Fed. 591; Consolidated Engine Stop Co. v. Landers, 160 Fed. 79; Stimpson v. Baltimore, etc., R. Co., 10 How. 329, 13 L. Ed. 441; Mowry v. Whitney, 14 Wall. 620, 20 L. Ed. 860; Rees v. Gould, 15 Wall. 187, 21 L. Ed. 39; Fuller v. Yentzer, 94 U. S. 288, 24 L. Ed. 103; McMurray v. Mallory, 111 U. S. 97, 28 L. Ed. 365 (affirming, 5 Fed. 593, 4 Hughes 265); Rowell v. Lindsay, 113 U. S. 97, 28 L. Ed. 906 (affirming, 6 Fed. 290, 10 Biss. 217); Electric R. Signal Co. v. Hall R. Signal Co., 114 U. S. 87, 29 L. Ed. 96; Garrett v. Seibert, 131 U. S. appendix cxv, 21 L. Ed. 96; Knapp v. Morss, 150 U. S. 221, 37 L. Ed. 1059; and, see, 9 U. S. E. 283.

43. Acheson, J., in Pittsburg Meter Co. v. Pittsburg Supply Co., 109 Fed. Rep. 644, 651, 48 C. C. A. 580; citing, Water-Meter Co. v. Despar, 101 U. S. 332, 25 L. Ed. 1024; Weatherhead v. Coupe, 147 U. S. 322, 37 L. Ed. 188; Wright v. Yuengling, 155 U. S. 47, 39 L. Ed. 64.

44. Baker, J., in Adam v. Folger, 120 Fed. Rep. 260, 263, 56 C. C. A. 540.

§ 276. Rule VIII. The question of infringement is determined by the substantial identity of the thing patented and the thing made, or used, or sold by the defendant.

Under the rule the alleged infringing device may come within the language of the claim, yet not infringe, and a device not within the language of the claim may infringe.

In the language of Mr. Justice Brown:

"We have repeatedly held that a charge of infringement is sometimes made out, though the letter of the claims be avoided. Machine Co. v. Murphy, 97 U. S. 120 (24 L. Ed. 9351); Ives v. Hamilton, 92 U. S. 426, 431 (23 L. Ed. 494); Morey v. Lockwood, 8 Wall. 230 (19 L. Ed. 339; Elizabeth v. Pavement Company, 97 U. S. 126, 137 (24 L. Ed. 1000); Sessions v. Romadka, 145 U. S. 29 (12 Sup. Ct. 799, 36 L. Ed. 609); Hoyt v. Horne, 145 U. S. 302 (12 Sup. Ct. 322, 36 L. Ed. 713). The converse is equally true. The patentee may bring the defendant within the letter of the claims, but if the latter has so far changed the principle of the device that the claims of the patent, literally construed, have ceased to represent his actual invention, he is as little subject to be adjudged an infringer as one who has violated the letter of a statute has to be convicted,when he has done nothing in conflict with its spirit and intent. 'An infringement,' says Mr. Justice Grier in Burr v. Duryee, 1 Wall. 531, 572 (17 L. Ed. 650, 660, 661), 'involves substantial identity, whether that identity be described by the terms "same principle," "modus operandi," or any other * * *. The argument used to show infringement assumes that every combination of devices is a machine which used to produce the same effect is necessarily

an equivalent for any other combination used for the same purpose. This is a flagrant abuse of the term 'equivalent.'"[45]

§ 277. Rule IX. Mere change of form,[46] or transposition of parts,[47] will not avert the charge of infringement.

This rule is based upon the same logic as the rule (X) relating to equivalency, which follows, § 278.

§ 278. Rule X. The substitution of an equivalent for an element named in a claim does not avert the charge of infringement.[48]

45. Westinghouse v. Boyden Power Brake Co., 170 U. S. 537, 568, 42 L. Ed. 1136. Cited and followed in Standard Computing Scale Company v. Computing Scale Co., 126 Fed. Rep. 639, 649.

46. Morrison v. Sonn, 111 Fed. Rep. 172, 175.

47. Devlin v. Paynter, 64 Fed. Rep. 398, 400, 12 C. C. A. 188.

48. Singer Mfg. Co. v. Henry Stewart Mfg. Co., 8 Fed. 920; Dederick v. Cassell, 9 Fed. 306; Putnam v. Hutchinson, 12 Fed. 131, 11 Biss. 240; Cohansey Glass Mfg. Co. v. Wharton, 28 Fed. 189; Hoe v. Cranston, 42 Fed. 837; Cutcheon v. Herrick, 52 Fed. 147 (modified in 60 Fed. 80); Standard Folding Bed Co. v. Osgood, 58 Fed. 583, 7 C. C. A. 382; Oval Wood Dish Co. v. Sandy Creek, New York Wood Mfg. Co., 60 Fed. 285; McCormick Harvesting Mach. Co. v. Aultman, 69 Fed. 371, 16 C. C. A. 259; Tripp Giant Leveler Co. v. Bresnahan, 70 Fed. 982 (affirmed in 72 Fed. 920, 19 C. C. A. 237; Boston & M. Electric St. R. Co. v. Bemis Car-Box Co., 80 Fed. 287, 25 C. C. A. 420; Salomon v. Garvin Mach. Co., 84 Fed. 195; Huntington Dry-Pulverizer Co. v. Whittaker Cement Co., 89 Fed. 323; Hart & Hegeman Mfg. Co. v. Anchor Electric Co., 92 Fed. 657, 34 C. C. A. 606; Thompson v. Second Ave. Traction Co., 93 Fed. 824, 35 C. C. A. 620; Bundy Mfg. Co. v. Detroit Time-Register Co., 94 Fed. 524, 36 C. C. A. 375; Fruit-Cleaning Co. v. Fresno Home-Packing Co., 94 Fed. 845; Lepper v. Randall, 113 Fed. 627, 51 C. C. A. 337; Kinloch Telephone Co. v. Western Electric Co., 113 Fed. 652, 51 C. C. A. 369; Benbow-Brammer Mfg. Co. v. Simpson Mfg. Co., 132 Fed. 614; Dey Time Register Co. v. Syracuse Time Recorder Co., 152 Fed. 440; Westinghouse Electric Co. v. Condit Electrical Mfg. Co., 159 Fed. 154; O'Reilly v. Morse, 15 How. 62, 14 L. Ed. 494; Ives v. Hamilton, 92 U. S. 426, 23 L. Ed. 494; Union Water Meter Co. v. Despar, 101 U. S. 332, 25 L. Ed. 1024; and, see, 9 U. S. E. 285.

"Equivalent" defined.—"An equivalent is a device which performs the same function as another, and in substantially the same way as by the thing of which it is alleged to be an equivalent."[49] Another definition, now obsolete, insisted that the substituted element, to be an equivalent "must have been known in the arts, at the fate of the patent, as endowed with this capability."[50]

A fuller definition is:

"As a general definition, a mechanical equivalent that may be properly substituted for an omitted mechanical element, device, or agency in a patented machine is one that performs the same function by applying the same force to the same object, through the same mode and means of application. In a combination patent for improvement, only, in the arrangement and application of old ingredients, the patentee is not entitled to invoke broadly the doctrine of mechanical equivalents, so as to cover a device not specifically included in his claim and specifications. The term 'equivalent,' as applied to a combination of old elements, is special in its signification, and materially different from what is meant when the term is applied to an invention consisting of a new device or an entirely new machine. The assignee of the patentee, in this case, cannot be allowed to invoke the broad doctrine of equivalents liberally extended to useful primary inventions, so as to include all forms of devices and adjustments which operate to perform the same functions and accomplish the same result."[51]

49. Knowles, J., in Pacific Cable Ry. Co. v. Butte City St. Ry. Co., 58 Fed. Rep. 420, 421.

50. Duff Mfg. Co. v. Forgie, 59 Fed. Rep. 772, 775, 8 C. C. A. 261.

51. Dick, J., in Carter Mach. Co. v. Hanes, 70 Fed. Rep. 859, 865.

§ 279. Rule XI. Where the mode of operation of the alleged infringement is substantially different from that of the patent in suit, infringement does not exist.[52]

This rule is closely akin to those considered *ante*, §§ 209, 273. The mode of operation of two machines may be strikingly similar, without the idea of means being quite or nearly identical in each. Where there is a substantial difference as to mode of operation, the ideas of means must be so far divergent from each other that the substantial identity necessary to establish infringement cannot exist.

§ 280. Rule XII. Identity in mode of operation is not conclusive upon the question of infringement.

In Winans v. Denmead[53] the Supreme Court by Mr. Justice Curtis announced it as a familiar rule, "that to copy the principle or mode of operation described, is an infringement." The rule thus expressed was finally negatived in Burr v. Duryee[54] in which case the court holds that "the principle of a machine is properly defined to be its mode of operation." That a patent cannot be granted upon a principle or mode of operation. That, therefore, identity in mode of operation is inconclusive as to the question of infringement.

This rule must be read in conjunction with that of § 279, *ante*.

§ 281. Rule XIII. Mere experimental use does not constitute infringement.[55]

Accordingly, the exhibition of a machine so made, merely as an illustration of its workings, is not an in-

52. Field v. DeComeau, 116 U. S. 187, 29 L. Ed. 596; Yale Lock Mfg. Co. v. Sargent, 117 U. S. 373, 29 L. Ed. 950.

53. 15 Howard, 330-342, 14 L. Ed. 722.

54. 1 Wallace 531, 17 L. Ed. 650.

55. Bonsack Mach. Co. v. Underwood, 73 Fed. Rep. 206, 211.

fringement;[56] and to constitute an infringement, its making must be with the intent to use it for profit.[57] But where a machine is used for purposes of demonstration in connection with the sale of a patent, the reason of the rule, which is only for the advancement of invention, fails, and the rule does not apply.[58]

§ 282. Rule XIV. A device may be within the literal terms of a claim yet not infringe.

"Even if it be conceded that the Boyden device corresponds with the letter of the Westinghouse claims, that does not settle conclusively the question of infringement. We have repeatedly held that a charge of infringement is sometimes made out, though the letter of (the claim) be avoided."[59]

"The mere fact that the defendant's device may be within the letter of the claim sued on is not conclusive proof of infringement."[60]

§ 283. Rule XV. A charge of infringement may be made out though the letter of the claims be avoided.

"The patentee may bring the defendant within the letter of his claims, but, if the latter has so far changed the principle of the device that the claims of the patent,

56. Standard Measuring Mach. Co. v. Teague, 15 Fed. Rep. 390, 392.

57. Sawin v. Guild, Fed. Case No. 12,391, 1 Robb. 47.

58. Bonsack Mach. Co. v. Underwood, 73 Fed. Rep. 206, 211.

59. Mr. Justice Brown, in Westinghouse v. Boyden Power Brake Co., 170 U. S. 537, 568, 42 L. Ed. 1136, 1147; citing, Union Paper Bag Machine Co. v. Murphy, 97 U. S. 120, 24 L. Ed. 935; Ives v. Hamilton, 92 U. S. 426, 431, 23 L. Ed. 494; Morey v. Lockwood, 8 Wall. 230, 19 L. Ed. 339; Elizabeth v. Pavement Co., 97 U. S. 126, 137, 24 L. Ed. 1000; Sessions v. Romadka, 145 U. S. 29, 36 L. Ed. 609; Hoyt v. Horne, 145 U. S. 302, 36 L. Ed. 713.

60. Lanning, J., in General Electric Co. v. Allis-Chalmers Co., 178 Fed. Rep. 273, 276, —— C. C. A. ——; affirming, General Electric Co. v. Allis-Chalmers Co., 171 Fed. Rep. 666.

literally construed, have ceased to represent his actual invention, he is as little subject to be adjudged an infringer as one who has violated the letter of a statute has to be convicted, when he has done nothing in conflict with its spirit and intent. 'An infringement,' says Mr. Justice Grier in Burr v. Duryee, 1 Wall. 531, 572, 'involves substantial identity, whether that identity be described by the terms 'same principle,' same 'modus operandi,' or any other. * * * The argument used to show infringement assumes that every combination of devices in a machine which is used to produce the same effect is necessarily an equivalent for any other combination used for the same purpose. This is a flagrant abuse of the term 'equivalent.' We have no desire to qualify the repeated expressions of this court to the effect that, where the invention is functional, and the defendant's device differs from that of the patentee only in form, or in a rearrangement of the same elements of a combination, he would be adjudged an infringer, even if, in certain particulars, his device be an improvement upon that of the patentee. But, after all, even if the patent for a machine be a pioneer, the alleged infringer must have done something more than reach the same result. He must have reached it by substantially the same or similar means, or the rule that the function of a machine cannot be patented is of no practical value. To say that the patentee of a pioneer invention for a new mechanism is entitled to every mechanical device which produces the same result is to hold, in other language, that he is entitled to patent his function. Mere variations of form may be disregarded, but the substance of the invention must be there."[61]

61. Mr. Justice Brown, in Westinghouse v. Boyden Power Brake Co., 170 U. S. 537, 568, 42 L. Ed. 1136, 1147; to the effect, see, Norton v. Wheaton, 97 Fed. Rep. 636, 641; Standard Comput-

§ 284. Rule XVI. Identity of function is not conclusive of the question of infringement.

As Judge Munger has said: "While it is necessary to constitute infringement that each should perform the same function, performance of the same function does not alone constitute infringement."[62]

The reason of this rule is, that, to establish infringement, there must be substantial identity of the trinity of components, function, mode of operation, and result.

§ 285. Rule XVII. If the patented invention is not operative, it cannot be infringed by one that is.

In applying this rule Judge Ray has said:

"Two or more persons may use the same material, existing in precisely or substantially the same form, experimenting and making combinations, and having in mind the construction of a new and a useful invention that will produce a given result. The one or ones who fail invent nothing, but the one who succeeds may have invented a patentable thing; and, if a patent is granted, he is entitled to its protection and benefits. Those who failed, or others, cannot, by taking the same materials and making substantially the same combinations, varying the form or arrangement, or both, in nonessentials, but aiming at and producing the same results, claim either priority of invention, prior use, or new invention. Such facts will not defend the charge of infringement. And even if in such experimentation certain imperfect results were obtained, that fact does not estab-

ing Scale Co. v. Computing Scale Co., 126 Fed. Rep. 639, 649, 61 C. C. A. 541; General Electric Co. v. Allis-Chalmers Co., 171 Fed. Rep. 666, 669.

62. Johnson Furnace & Engineering Co. v. Western Furnace Co., 178 Fed. Rep. 819, 825, —— C. C. A. ——; Citing Eames v. Godfrey, 1 Wall. 78, 17 L. Ed. 547; Burr v. Duryee, 1 Wall. 531-573, 17 L. Ed. 650; Westinghouse v. Boyden Power Brake Co., supra, 170 U. S. 568-569, 42 L. Ed. 1136.

lish priority of invention. 'If the patented invention is not operative, it cannot be infringed by one that is.'[63] It would seem to follow that however close the resemblance between some prior alleged invention, even when put in actual use, and the patented invention, if such alleged prior invention was not operative, and failed to produce the beneficial results sought and produced by the patent, it could not constitute prior invention. In such case the patented invention cannot be regarded as old."[64]

§ 286. Rule XVIII. To reverse or transpose the steps by which a process is carried out does not avoid infringement.

This rule is a deduction from the doctrine of equivalency. The accomplishment of the product by the use of the steps of a process claim, though those steps be transposed or reversed, is to do the same thing, in substantially the same way, and by substantially the same means. Identity of function, mode of operation and result, are all present.

The rule is frequently set out in the cases.[65]

§ 287. Rule XIX. The identity of two products does not establish the identity of the processes by which they are made.

This rule is manifestly sound. To imagine any exception to it would require the existence of a product which could only be produced by one process. The rule has been announced explicitly by Mr. Justice Matthews thus: "Whatever likeness may appear between the

63. Royer v. Coupe, 29 Fed. Rep. 358, 39 O. G. 239.

64. General Electric Co. v. Wise, 119 Fed. Rep. 926.

65. Devlin v. Paynter, 64 Fed. Rep. 399, 12 C. C. A. 188; General Electric Co. v. Campbell, 137 Fed. Rep. 600; Malignani v. Germania Electric Lamp Co., 169 Fed. Rep. 299; Malignani v. Hill-Wright Electric Co., 177 Fed. Rep. 430, —— C. C. A. ——; Carnegie Steel Co. v. Cambria Iron Co., 185 U. S. 403, 46 L. Ed. 968.

product of the process described in the patent and the article made by the defendants, their identity is not established unless it is shown that they are made by the same process."[66]

This rule is merely a paraphrase of Rule V, § 273, *ante*.

§ 288. Rule XX. A process patent is not infringed by selling the product.

"If it was a patent for a process, it would not be infringed by selling the product, and no conditions should have been annexed to the exercise of the vendor's rights. The broad proposition that the vendor of a product which has been made in infringement of a patented process is an infringer, or liable to any extent to the patentee, is untenable and does not require discussion. The patentee's remedy is against the manufacturer."[67]

This rule is a necessary sequence of Rule XIX, § 287, *ante*.

§ 289. Rule XXI. The omission of any step of a process averts the charge of infringement.

In the leading case Mr. Justice Strong said: "It may be conceded the patentee is protected against equivalents for any part of his invention. He would be, whether he had claimed them or not. But when a product arrived at by certain defined stages or processes is patented, only those things can be considered equivalents for the elements of the manufacture which perform the same function in substantially the same way. The same result may be reached by different processes, each

66. Plummer v. Sargent, 120 U. S. 442, 30 L. Ed. 737.

67. Wallace and Shipman, J. J., in Welsbach Light Co. v. Union Incandescent Light Co., 101 Fed. Rep. 131, 41 C. C. A. 255, following Merrill v. Yeomans, 94 U. S. 568, 24 L. Ed. 235; National Phonograph Co. v. Lambert Co., 125 Fed. Rep. 388.

of them patentable, and one process is not infringed by the use of any number of its stages less than all of them."[68]

This rule is merely the application of Rule VII, § 275, *ante*, to process patents.

§ 290. Rule XXII. To infringe a process claim exact identity is not necessary.

In applying this rule, Judge Severens has said:

"Complete identity is not necessary. As was stated by Mr. Justice Curtis in Winans v. Denmead, 56 U. S. 330 (15 How.), 14 L. Ed. 717:

'If the machine complained of were a copy, in form, of the machine described in the specification, of course, it would be at once seen to be an infringement. It could be nothing else. It is only ingenious diversities of form and proportion, presenting the appearance of something unlike the thing patented, which give rise to questions; and the property of inventors would be valueless, if it were enough for the defendant to say: "Your improvement consists in a change of form; you describe and claim but one form; I have not taken that and so have not infringed."' "

This was said in a case where the original patent was for a cylindrical ore body in a railroad car, where the structure held to infringe was hexagonal. But it is equally applicable to inventions for processes. The patentee is entitled to claim, not only that which he precisely claims, but, where he claims a combination or process embodying the use of certain elements, his claims

68. Goodyear Dental Vulcanite Co. v. Davis, 102 U. S. 222, 26 L. Ed. 149. To the same effect, see, United States Glass Co. v. Atlas Glass Co., 90 Fed. Rep. 724, 33 C. C. A. 254; Royer v. Coupe, 146 U. S. 524, 36 L. Ed. 1073.

will include such combinations and processes as adopt substantially the same means; where the variation is only such as common intelligence in that art would suggest. Incidental appliances in operating the substantial means invented would not prevent a second patented invention from infringement upon the first."[69]

§ 291. Rule XXIII. The addition of a step or steps to a process does not avert the charge of infringement.

This rule has been established by abundant authority, and is analogous to the rule applicable to mechanical combination claims. We quote from the leading case as follows:

"It is probably true, as contended for by the defendants, that by the use of a small portion of lime, the process can be performed with less heat than if none is used. It may be an improvement to use the lime for that purpose; but the process remains substantially the same. The patent cannot be evaded in that way. The matter may be stated thus: Tilghman discovers a process of decomposing fats by mixing them with water, and heating the mixture to a high temperature under a pressure that prevents the formation of steam. It is a new process, never known before. The defendants seeing the utility of the process, and believing that they can use a method somewhat similar without infringing Tilghman's patent, put a little lime into the mixture, and find that it helps the operation, and that they do not have to use so high a degree of heat as would otherwise be necessary. Still, the degree of heat required is very high, at least a hundred degrees above the boiling point; and a strong boiler or vessel is used in order to restrain

69. Cowles Electric Smelting & Aluminum Co. v. Lowery, 79 Fed. Rep. 331, 352, 24 C. C. A. 616.

the water from rising into steam. Can a balder case be conceived of an attempted evasion and a real infringement of a patent."[70]

In another illustrative case we find the following:

"The process used by the defendant is the same as that described in the patent, with one step added which is not described. After the vessel to be enameled has been dipped in the glaze the operator shakes it, and by this means produces the desired result quicker than when the shaking is omitted. That the process can be practiced without this additional step is sufficiently demonstrated. It is a well-known fact among enamelers that this manipulation would save time, and it is thought that one who applies it to the process in question does not thereby escape infringement. He does not use the process any the less because he uses something in addition to the process. Even if he assumed that the defendant has introduced an improvement, it is an improvement upon the Kegreisz process, and so long as the defendant uses that process it must be treated as an infringer."[71]

Where the addition to the process does not affect the result attained, that fact will also be considered in determining the question of infringement.[72]

70. Mr. Justice Bradley, in Tilghman v. Proctor, 102 U. S. 707, 730, 26 L. Ed. 279, 289.

71. Coxe, J., in Lalance & Grosjean Mfg. Co. v. Habermann Mfg. Co., 53 Fed. Rep. 375, 380. To the same effect, see, Clerk v. Tannage Patent Co., 84 Fed. Rep. 643, 644, 28 C. C. A. 501.

72. Ford Morocco Co. v. Tannage Co., 84 Fed. Rep. 644, 646, 28 C. C. A. 503.

CHAPTER XIII.

OF UTILITY.

§ 292. Rule I. Utility is indispensable to a valid patent.

This is established by the language of the patent act (sec. 4886, R. S. U. S.), expressly limiting its benefits to arts, machines, etc., which are both new and useful. Novelty and utility, both, must concurrently exist or the grant of the patent is a nullity. While the word "useful" is largely employed in its colloquial sense, there have been engrafted upon it by judicial interpretation certain unusual shades of meaning hereinafter considered in detail. Suffice it to add at this point, therefore, that the language of the constitutional provision (paragraph 8, of section VIII, article I), "to promote the progress of science *and* useful arts" did not of itself limit the power of Congress to the enactment of a patent act expressly limited to inventions not only new but useful; certain inventions made in the progress of science are not "useful" in the sense of the language of the Patent Act. Thus a dangerous invention is of course new and may be a necessary incident to the progress of science, and yet, because of its dangerous qualities, it is not "useful" and is therefore unpatentable.[1]

Consequently the word "useful" as it is employed in sections 4886, R. S. U. S. ("Any person who has invented or discovered any new and useful," etc.) and 4893, R. S. U. S. ("If * * * it shall appear * * * that the same is sufficiently useful and important, the Commissioner shall issue a patent therefor"), in the Re-

1. Mitchell v. Tilghman, 19 Wallace 287, 22 L. Ed. 125, 9 Brodix 174.

vised Statutes, has the same judicial definition as in its occurrence in the constitutional provision, and as established by the cases we are about to consider.

§ 293. **Rule II. The patent is prima facie evidence of the utility of the thing patented.**[2]

While this presumption is rebuttable[3] and has been said to be in some cases slight and purely technical,[4] it is sufficient until rebutted.[5] "Utility in most cases is a question of fact, as it usually depends upon the evidence resulting from an actual experiment."[6]

§ 294. **Rule III. Utility alone does not establish patentability.**[7]

This is the rule generally recognized, although superior utility is always a circumstance entitled to weight in considering the question of novelty.[8]

"Mere utility does not establish patentability. It is not every slight improvement in a mechanism that is the result of the exercise of the inventive faculty. In the exercise of the arts, such improvements are constantly developing themselves, almost, but are at any rate clearly the result of obvious mechanical suggestion. As has been said by the Supreme Court more than once, to grant

2. Reckendorfer v. Faber, 92 U. S. 347, 23 L. Ed. 812, 10 Brodix 373; Dashiell v. Grosvenor, 162 U. S. 425, 40 L. Ed. 1025; Vance v. Campbell, 1 Fisher 483, Fed. Case No. 16, 837; Hoffman v. Young, 2 Fed. Rep. 74; Mesker v. Thuener, 42 Fed. Rep. 329; E. M. Miller Co. v. Meriden Brouze Co., 80 Fed. Rep. 525; Patent Button Co. v. Scovill Mfg. Co., 92 Fed. Rep. 151, 154; Crown Cork & Seal Co. v. Aluminum Stopper Co., 108 Fed. Rep. 845, 48 C. C. A. 72.

3. Reckendorfer v. Faber, 92 U. S. 347, 23 L. Ed. 812, 10 Brodix 373.

4. Burnham & Duggan Ry. Appliance Co. v. Naumkeag St. Ry. Co., 57 Fed. Rep. 651, 653; Chase v. Fillebrown, 58 Fed. Rep. 374, 376.

5. Kirk v. Du Bois, 33 Fed. Rep. 252.

6. Mr. Justice Clifford, in Mitchell v. Tilghman, 86 U. S. 287, 22 L. Ed. 125.

7. Thompson v. Boisselier, 114 U. S. 1, 29 L. Ed. 76, 15 Brodix 549.

8. Allen v. Grimes, 89 Fed. Rep. 869.

patent monopolies for such improvements would not be to encourage invention, but would impose upon mechanics and the public generally burdens for which there would be no adequate compensation."[9]

§ 295. Rule IV. Utility may exist in a manufacture though its only function is decoration,[10] and necessarily a design's utility resides in its being ornamental.[11]

The word "useful" in § 4929, R. S. U. S., relating to design patents means a utility which "is artistic, and not practical."[12] The propriety of having a design patent law has been discussed elsewhere.[13]

§ 296. Rule V. Utility may be considered in the light of the state of the art at the time the patent was applied for;[14] if useful then, the fact that it is subsequently superseded is immaterial.[15]

§ 297. Rule VI. An invention injurious to the morals, health, or good order of society is not patentable because it is not "useful."[16]

This rule is founded upon an interpretation of the word "useful" as employed in the patent act, which is based upon public policy.[17]

Thus a patent for a process of spotting tobacco leaves, without improving the quality of the tobacco, so as to

9. Gray, J., in Shoe v. Gimbel, 96 Fed. Rep. 96, 99.

10. Magic Ruffle Co. v. Douglas, 2 Fisher 330, Fed. Case No. 8, 948.

11. Ex parte Norton, 22 Off. Gaz. 1205.

12. Archbald, J., in Williams Calk Co. v. Neverslip Mfg. Co., 136 Fed. Rep. 210, 215.

13. Ante, § 58.

14. Poppenhausen N. Y. Gutta Percha Comb Co., 2 Fisher 62, Fed, Case No. 11,283; Westinghouse Electric & Mfg. Co. v. Beacon Lamp Co., 95 Fed. Rep. 462, 464.

15. Poppenhausen v. N. Y. Gutta Percha Comb Co., 2 Fisher 62, Fed. Case No. 11,283.

16. Bedford v. Hunt, 1 Mason 302, Fed. Case No. 1217; National Automatic Device Co. v. Lloyd, 40 Fed. Rep. 89; Reliance Novelty Co. v. Dworzek, 80 Fed. Rep. 903; Schultze v. Holz, 82 Fed. Rep. 448.

17. Reliance Novelty Co. v. Dworzek, 80 Fed. Rep. 903.

simulate the naturally spotted leaf, was held void for want of utility. Judge Wallace observing that "in authorizing patents to the authors of new and useful discoveries and inventions, Congress did not intend to extend protection to those which confer no other benefit upon the public than the opportunity of profiting by deception and fraud. To warrant a patent, the invention must be useful; that is, capable of some beneficial use as distinguished from a pernicious use."[18]

§ 298. Rule VII. A patent is void for want of utility if its disclosure is inadequate to successful reduction to practice.

This rule is indeed obvious. Where the description is insufficient to tell those skilled in the art how to reduce the invention to actual practice without experimentation, its "disclosures * * * are not of the practical and useful character the law makes the consideration for the grant of a patent monopoly."[19]

§ 299. The effect of mis-user of the patent.

It has been frequently urged against a patent that its owner should be disentitled to relief in equity because of the patent being capable only of fraudulent or other noxious use or because the owner had subjected it only to such uses.

1. Where the sole use of which an invention is capable is fraudulent,[20] or immoral,[21] that fact avoids the patent. Thus a coin-controlled apparatus used as a gambling device and incapable of any other use, has been held to be void,[22] and so of a process for spotting to-

18. Rickard v. Du Bon, 103 Fed. Rep. 868, 873, 43 C. C. A. 360.

19. Buffington, J., in Donner v. American Sheet & Tin Plate Co., 165 Fed. Rep. 199, 91 C. C. A. 233.

20. Klein v. Russell, 19 Wallace 433, 22 L. Ed. 116.

21. Lowell v. Lewis, 1 Robb. 131, Fed. Case 8,568.

22. Schultze v. Holtz, 82 Fed. Rep. 448.

bacco leaves,[23] and a patent for a so-called chemical instrument for the treatment of diseases upon a theory at variance with accepted scientific principles.[24]

2. Where a device is capable of legitimate use, the fact that it has been used exclusively for gambling purposes has been held to disentitle the plaintiff to relief in equity against an infringer;[25] and the same doctrine has been applied to a design patent embodying a design for a case of a gambling device.[26]

But the force of these cases has been impaired by a later and carefully considered decision of the Circuit Court of Appeals for the Seventh Circuit which holds that in this defense (want of utility) "the true inquiry is, was the government improvident in making the grant? That the actual use to which the invention has been put by its owner is immaterial; and if the defendant proves that the only uses to which the patented device has been put were vicious the patent should not be held void for want of utility, if the court for itself should see, or be convinced by experts, that the instrument was susceptible of good uses, though in fact never put to such before the suit was begun."[27]

§ 300. **Rule VIII. An invention which is extremely dangerous to the operator,[28] or injurious to the substance operated on[29] or to the operation of other parts of a thing of which it is a part,[30] is not "useful."**

23. Rickard v. Du Bon, 43 C. C. A. 360, 103 Fed. Rep. 868.

24. Mahler v. Animarium Co., 111 Fed. Rep. 530, 49 C. C. A. 431.

25. National Automatic Device Co. v. Lloyd, 40 Fed. Rep. 89, 5 L. R. A. 784.

26. Reliance Novelty Co. v. Dworzek, 80 Fed. Rep. 902.

27. Fuller v. Berger, 56 C. C. A. 588, 120 Fed. Rep. 274-276.

28. Mitchell v. Tilghman, 19 Wallace 287, 22 L. Ed. 125, 9 Brodix 174.

29. Klein v. Russell, 19 Wallace 433, 22 L. Ed. 116, 9 Brodix 244.

30. Wilton v. Railroad Co., Fed. Case No. 17,856.

Of the first proposition embodied in the rule Mr. Justice Clifford said "it cannot be held that the invention is useful if it appears that the operator, in using the described means, is constantly exposed to imminent danger, either from the explosive tendency of the substance to be used, or from the liability of the vessel to burst which is required to be employed as a means of accomplishing the patented result."[31] It must be remembered that Mr. Justice Clifford wrote at a time when the art of high explosives was in its infancy. The operator of the aeroplane "is constantly exposed to imminent danger," yet that defense could not be successfully interposed against an aeroplane patent. It seems to the writer that this part of the rule, while warranted by the decisions, is now obsolescent, if not obsolete.

§ 301. **Rule IX. Utility does not exist where the invention is incapable of performing any useful function.[32] But the utility exists if the invention is available for one purpose indicated in the patent, though it is incapable of accomplishing other purposes named therein.[33]**

The doctrine as stated by the Supreme Court is: "A patented machine that will not do what it is intended to do could not sustain an action against one who was shown to use a successful and operative machine."[34] No more inapt use of terms could be imagined. The defendant, in a law action, had given "evidence tending to show that a machine made in conformity with the plaintiffs' specifications and claims would not operate as a successful machine, to which the plaintiffs replied by evidence tend-

31. Mitchell v. Tilghman, 19 Wallace 287, 22 L. Ed. 125, 9 Brodix 174.

32. Coupe v. Royer, 15b U. S. 565, 574, 39 L. Ed. 263; Bliss v. Brooklyn, 10 Blatchf. 521, 6 Fisher 289, Fed. Case 1546, 3 O. G. 269; Carter Machine Co. v. Hanes, 70 Fed. Rep. 859.

33. Phillips v. Risser, 26 Fed. Rep. 308.

34. Mr. Justice Shiras, in Coupe v. Royer, supra, at p. 574.

ing to show that a machine made after the description contained in the patent would and did operate successfully."[35] What are we to understand by the words "what it is intended to do?"

The rule was stated explicitly by Judge Benedict, thus: "The law upon the subject of utility is not in doubt. No particular amount of utility is required to render an invention patentable, but there must be some; when the invention is shown to be worthless, the patent must fail."[36]

In applying the rule under consideration, the fact that the machine of the patent has been abandoned may have great weight in proving that the absence of utility exists.[37]

§ 302. **Rule X. The degree of utility possessed by the patented article is immaterial to its patentability. It is sufficient if it serves any useful purpose,[38] "no matter how infinitesimal."[39]**

However, upon the question of novelty, evidence of the comparative utility of the thing patented and of alleged anticipating devices will be considered in determining their identity or diversity.[40]

Consequently, it is not a matter of defense to say that the patented device is susceptible of improvement, or that there are other inventions in the field which are superior to it;[41] that the subject-matter of the patent must

35. Coupe v. Royer, supra, p. 569.

36. Bliss v. Brooklyn, Fed. Case 1546.

37. Carter Machine Co. v. Hanes, 70 Fed. Rep. 859, 869.

38. Bedford v. Hunt, Fed. Case No. 1217, 1 Robb. 148; Lamb Knitgoods Co. v. Lamb Glove & Mitten Co., 56 C. C. A. 547, 120 Fed. Rep. 267, 272.

39. Coxe, J., in Gibbs v. Hoefner, 19 Fed. Rep. 323, 324.

40. American Sales Book Co. v. Bullivant, 54 C. C. A. 287, 117 Fed. Rep. 255.

41. Crown Cork & Seal Co. v. Aluminum Stopper Co., 48 C. C. A. 72, 108 Fed. Rep. 845.

be used in connection with other devices or instrumentalities to produce any result whatever;[42] or that the device does not accomplish all that its inventor claimed it would,[43] or that its period of usefulness is short-lived.[44]

§ 303. Rule XI. The fact of infringement is evidence of utility as against the infringer.

This is the rule alike in cases at law,[45] and in cases in equity.[46] The rule does not go to the extent of creating an estoppel against the infringer to deny the patent ability of the claim,[47] but it has been applied by Judge Coxe as follows: "That which is used is useful. A thing to be useless can have no utility whatever. A patent is never declared invalid upon this ground, at the instance of one who is deriving benefit by infringing upon its claims."[48]

§ 304. Rule XII. Great increase of speed without loss of efficiency is evidence of utility.

"When the increase of speed is so great as it appears to be in this instance, and that, too, in an art where increase of speed (efficiency being preserved) is of such practical importance, we are disposed to consider the changes in parts and arrangement of parts as showing meritorious invention."[49]

42. Wheeler v. Clipper Mower Co., Fed. Case No. 17,493, 10 Blatchf. 181, 6 Fisher 1.

43. Eames v. Cook, Fed. Case No. 4239, 2 Fisher 146.

44. International Tooth Crown Co. v. Hanks Dental Assn., 111 Fed. Rep. 916, 920.

45. International Tooth Crown Co. v. Hanks Dental Assn., 111 Fed. Rep. 916.

46. Goss Printing Press Co. v. Scott, 47 C. C. A. 302, 108 Fed. Rep. 253.

47. Simmonds v. Morrison, 44 Fed. Rep. 757, 761.

48. La Rue v. Western Electric Co., 31 Fed. Rep. 80, 82; affirmed in Western Electric Co. v. La Rue, 139 U. S. 601, 35 L. Ed. 294.

49. Lacombe, J., in Wilicox & Gibbs Sewing Machine Co. v. Merrow Machine Co., 93 Fed. Rep. 206, 209.

§ 305. **Rule XIII. The fact that an invention has not been used is evidence of lack of utility.**

"While the failure to put an invention to use may not be conclusive of its utility, still it is a circumstance to be considered, as against the practical utility of the machine."[50]

Of course there have been many inventions that were ahead of their time. A need must be felt before money will be spent to gratify it.

§ 306. **Rule XIV. The question of utility must be determined with reference to the state of the art at the date when the application for patent was made.**

"Utility must be gauged by the state of the art at the time the patent was applied for."[51]

It may be doubted whether this rule will stand the test of time. The public's realization of needs changes vastly in seventeen years. That period has seen the telephone, the phonograph and wireless telegraphy emerge from scientific toys to public necessities. Is it possible that the utility of patents in those arts must be tested by this rule?

§ 307. **Rule XV. Where the question of invention is in doubt, evidence of the utility of the thing patented as shown in its success is admissible.**[52]

In the language of Mr. Justice Strong: "We do not say, the single fact that a device has gone into general use and has displaced other devices which had previously been employed for analogous uses, establishes in all cases

50. Morrow, J., in Bowers v. San Francisco Bridge Co., 91 Fed. Rep. 381, 416.

51. Kirkpatrick, J., in Westinghouse Electric & Mfg. Co. v. Beacon Lamp Co., 95 Fed. Rep. 462, 464.

52. Smith v. Goodyear Dental Vulcanite Co., 93 U. S. 486, 23 L. Ed. 952; Washington & Moen Mfg. Co. v. Haish, 4 Fed. Rep. 900, 915; Hill v. Biddle, 27 Fed. Rep. 560.

that the later device involves a patentable invention. It may, however, always be considered; and when the other facts in the case leave the question in doubt, it is sufficient to turn the scale."[53]

But evidence admitted under this rule must be received with great caution. Modern business systems and enterprise can sell many classes of articles regardless of merits. Worthless, and even noxious things are sold by energetic salesmen and under fanciful and attractive advertising, trademarks, tradenames and dress. On the other hand, certain machines are of necessity sold on their intrinsic merits. Thus Judge Townsend has said "the class of persons who use incubators are not likely to be induced to buy by reason of an alluring trademark, attractive finish, or the energy of the traveling salesman."[54] Mr. Justice Brown has pointed out the danger of relying on proof of popularity and large sales as a test of patentability, remarking that "a man may, by the aid of an alluring trademark, succeed in catching the eye of the people, and palming off upon them wares of no greater intrinsic value than those of his rivals. * * * The same result may follow from the more attractive appearance or the more perfect finish of the article, from more extensive advertising, larger discounts in price, or greater energy in pushing sales."[55]

§ 308. Rule XVI. Where infringement exists, the use of the infringing device is strong evidence of utility.[56]

53. Smith v. Goodyear Dental Vulcanite Co., 93 U. S. 486, 23 L. Ed. 952.

54. Stahl v. Williams, 64 Fed. Rep. 121, 123.

55. Duer v. Corbin Cabinet Lock Co., 149 U. S. 216, 223, 37 L. Ed. 707.

56. Tyler v. Crane, 7 Fed. 775; Foyer v. Nichols, 13 Fed. 125, 8 Sawy. 201; Hancock Inspirator Co. v. Jenks, 21 Fed. 911; Niles Tool Works v. Betts Mach. Co., 27 Fed. 301; Goss Printing-Press Co. v. Scott, 108 Fed. 253; International Tooth Crown Co. v. Hanks' Dental Assoc., 111 Fed. 916 (affirmed in 122 Fed. 74, 58 C. C. A. 180).

As put by Judge Lacombe, "the mere circumstance that the defendant chooses to use it seems to indicate that, from his point of view at least, it was a patentable invention."[57]

In some of the earlier cases it was held that a defendant who infringed a patent was "estopped from denying its utility."[58] The propriety of the use of the term "estoppel" in this connection may be doubted. The rule is applied in the later cases with reasoning like this: "It is improbable that men will render themselves liable to actions for infringement unless infringement be useful. And the fact that a patent has been infringed by a defendant is, as against such infringer, sufficient to establish its utility."[59]

This doctrine is of the nature of an estoppel by conduct.

§ 309. The relation of utility to invention.

Utility and invention are two subjects intrinsically so little related that their joint consideration at first glance seems illogical. Indeed, long and exhaustive study of the cases leads the author to believe that the treatment of the two by the courts as cognate subjects arose in this wise. It is a matter of extreme difficulty to judge of invention after the fact. What was, perhaps, a most ingenious product of invention appears after its production self-evident, the natural outgrowth of an art's development, or the fruit of mere mechanical skill. Viewed in the light of the prior art, the accomplishment of the

57. International Tooth Crown Co. v. Hanks' Dental Assn., 111 Fed. Rep. 916, 920.

58. Leavitt, J., in Hays v. Sulsor, Fed. Case No. 6271, 1 Fisher 532; and in Vance v. Campbell, Fed. Case No. 16,837.

59. Buffington, J., in Goss Printing-Press Co. v. Scott, 108 Fed. Rep. 253, 258, 47 C. C. A. 302; citing, Lehnbeuter v. Holthaus, 105 U. S. 96, 26 L. Ed. 939.

inventor appears to be within the class of things condemned by the Supreme Court as "trifling devices" or "shadows of a shade of an idea."[60] But what appears to the defendant's expert as the mere product of mechanical skill may have been something for which an art was, and had long been, anxiously waiting. Others may have strived in vain to produce it. Its production may have met with immediate and great public approval. Its inventor may have met with immediate commercial success. Is the court to close its ears to such evidence of the merit of the thing patented? Has such evidence a bearing upon the question of invention so remote as to exclude it from judicial consideration?

These questions have both been answered in the negative. Yet the admission of such evidence is hedged about by keenly defined limitations which must be considered with the same care as the rule itself.

Indeed, whenever extensive sales are shown to be due to extensive advertising, changes in fashion of dress, or the like, the extent of sales is entitled to little if any weight in determining the presence or absence of invention in the thing patented.[61] Where the thing whose extensive sale is proven or offered to be proved, contains other elements than those involved in the claims of the patent in suit, the sales may have been due to those foreign elements, and the testimony will have little or no weight accorded to it.[62]

"Mere utility does not establish patentability. It is not every slight improvement in a mechanism that is the

60. Atlantic Works v. Brady, 107 U. S. 192, 27 L. Ed. 438.

61. Saunders v. Allen, 60 Fed. Rep. 610, 612, 9 C. C. A. 157; Ypsilanti Dress-Stay Mfg. Co. v. Van Valkenburg, 72 Fed. Rep. 277, 281; Richard v. American Pin Co., 73 Fed. Rep. 476, 480.

62. Nutter v. Brown, 98 Fed. Rep. 892, 894, 39 C. C. A. 332; Christy v. Hygeia Pneumatic Bicycle Saddle Co., 93 Fed. Rep. 965.

result of the exercise of the inventive faculty. In the progress of the arts, such improvements are constantly developing themselves, almost, but are at any rate clearly the result of obvious mechanical suggestion. As has been said by the Supreme Court more than once, to grant patent monopolies for such improvements would not be to encourage invention, but would impose upon mechanics and the public generally burdens for which there would be no adequate compensation."[63]

§ 310. **Rule XVII. Evidence that others vainly attempted to produce the same result is admissible to show invention.**[64]

In a ruling case under this rule, Judge Shipman said: "The plaintiff says an attractive, cheap, and durable silver-plated steel spoon was a thing practically unknown in the art. It was wanted. When produced the manufacturers knew that it would fill an empty space in the market. They desired to produce it and the skillful and prosperous mechanics of the neighborhood set themselves with more or less energy to accomplish this result. Nobody but the plaintiff succeeded. He produced a new thing * * *. The only fair conclusion is that there must have been patentable novelty in the process."[65]

63. Gray, J., in Shoe v. Gimbel, 96 Fed. Rep. 96, 99.

64. Wallace v. Noyes, 13 Fed. Rep. 172; Horn v. Bergner, 68 Fed. Rep. 428, 431.

65. Wallace v. Noyes, 13 Fed. Rep. 172, 180.

CHAPTER XIV.

REGULATION OF TRANSACTIONS RELATING TO PATENT RIGHTS AND PATENTED ARTICLES.

§ 311. By the United States.

So far as purchase and sale of Letters Patent or rights thereunder are concerned, the United States Statutes thus far contain but a single section which provides as follows:

> "Every patent or any interest therein shall be assignable in law by an instrument in writing, and the patentee or his assigns or legal representatives may in like manner grant and convey an exclusive right under his patent to the whole or any specified part of the United States. An assignment, grant, or conveyance shall be void as against any subsequent purchaser or mortgagee for a valuable consideration, without notice, unless it is recorded in the Patent Office within three months from the date thereof. If any such assignment, grant or conveyance of any patent shall be acknowledged before any notary public of the several States or Territories or the District of Columbia, or any commissioner of the United States Circuit Court, or before any secretary of legation or consular officer authorized to administer oaths or perform notarial acts, under section seventeen hundred and fifty of the Revised Statutes, the certificate of such acknowledgment, under the hand and official seal of such notary or other officer, shall be prima facie evidence of the execution of such assignment, grant or conveyance."[1]

1. Sec. 4898, R. S. U. S., 3 Comp. Stat. 3387, 5 Fed. Stat. Ann. 531.

This section has been construed as being "confined to assignments, grants and conveyances of interests in patents after they are issued."[2]

There is no statutory provision requiring an assignment to be recorded in the Patent Office. Section 4898 of the Revised Statutes permits this to be done for the protection of the assignee against the subsequent bona fide purchaser or mortgagee.[3]

It was held in some of the earlier cases that a certified copy of the Patent Office record of an assignment of a patent was prima facie evidence of the genuineness of the instrument.[4] The contrary doctrine is now established.[5]

§ 312. By the States.

A. RESTRAINTS UPON ALIENATION OF PATENT RIGHTS.

I. *By the imposition of a license tax.* A Kentucky statute imposing a license tax upon peddlers (the statute defining the word "peddlers" as including "all itinerant persons vending * * * patent rights") was held void upon the ground that such a tax was a tax upon the patent right which "cannot be taxed by a state."[6]

II. *By conditions imposed on particular transactions.* With respect to the validity of state laws requiring spe-

2. Blatchford, C. J., in Wright, Jr. v. Randel, 8 Fed. 591-599.

3. Wallace, J., in Mayor of New York v. American Cable Ry. Co., 60 Fed. Rep. 1016, 9 C. C. A. 336.

4. Lee v. Blandy, Fed. Case No. 8182, 1 Bond. 361; Dederick v. Agricultural Co., 26 Fed. 763; National Folding Box & Paper Co. v. American Paper Pail & Box Co., 55 Fed. 488.

5. Paine v. Trask, 56 Fed. 233, 5 C. C. A. 397; Mayor of New York v. American Cable Ry. Co., 60 Fed. 1016, 9 C. C. A. 336; Standard Elevator Co. v. Crane Elevator Co., 76 Fed. 767, 22 C. C. A. 549; International Tooth Crown Co. v. Bennett, 72 Fed. Rep. 169-170; National Cash Register Co. v. Navy Cash-Register Co., 99 Fed. 89.

6. Barr, J., In re Sheffield, 64 Fed. Rep. 833, 836.

cific formalities to attend the sale and conveyance of patent rights (such as the provision of the Laws of Kansas, 1889, chapter 182, compelling one selling a patent right in any county in the state to file with the clerk of such county an authenticated copy of the letters patent together with an affidavit of the genuineness of the letters patent,[7] or imposing recitals in promissory notes given in payment for an assignment of rights under a patent (as the Arkansas Statute, Kirby's Dig., § 513),[8] such laws are held by the United States Supreme Court, and the courts of several of the States to be a valid exercise of the police power;[9] the reasoning of the United States Supreme Court being:

"We think the State has the power (certainly until Congress legislates upon the subject) with regard to the provision which shall accompany the sale or assignment of rights arising under a patent, to make reasonable regulations concerning the subject, calculated to protect its citizens from fraud. And we think Congress

7. Allen v. Riley, 203 U. S. 347, 51 L. Ed. 216.

8. John Woods & Sons v. Carl, 203 U. S. 358, 51 L. Ed. 219.

9. John Woods & Sons v. Carl, 203 U. S. 358, 51 L. Ed. 219, affirming, 75 Ark. 328, 87 S. W. 621; Wyatt v. Wallace, 67 Ark. 575, 55 S. W. 1105; Tilson v. Gattling, 60 Ark. 114, 29 S. W. 35; Sandage v. Studabaker Bros. Mfg. Co., 142 Ind. 148, 41 N. E. 380, 51 Am. St. Rep. 165, 34 L. R. A. 363; Mayfield v. Sears, 133 Ind. 86, 32 N. E. 816; Hankey v. Downey, 116 Ind. 118, 18 N. E. 271, 1 L. R. A. 447; New v. Walker, 108 Ind. 365, 9 N. E. 386, 58 Am. Rep. 40; Brechbill v. Randall, 102 Ind. 528, 1 N. E. 362, 52 Am. Rep. 695 (overruling Grover, etc., Sewing Mach. Co. v. Butler, 53 Ind. 454, 21 Am. Rep. 200); Mason v. McLeod, 57 Kan. 105, 45 Pac. 76, 57 Am. St. Rep. 327, 41 L. R. A. 548; Allen v. Riley, 71 Kan. 378, 80 Pac. 952, 114 Am. St. Rep. 481 (affirmed in, 203 U. S. 347, 51 L. Ed. 216); Nuhart v. Kubach, 76 Kan. 154, 90 Pac. 796; Pinney v. First National Bank, 68 Kan. 223, 75 Pac. 119; Herdic v. Roessler, 109 N. Y. 127, 16 N. E. 198; Tod v. Wick, 36 Ohio St. 370; Graham's Estate, 14 Phila. 280; Haskell v. Jones, 86 Pa. 173; Reeves v. Corning, 51 Fed. 774.

has not so legislated by the provisions regarding an assignment contained in the act referred to."[10]

The courts of other States have held such State legislation to be invalid.[11]

B. RESTRAINTS UPON THE SALE OF PATENTED ARTICLES.

The fact that an article is manufactured under a patent does not exclude it from the taxing or licensing law of a State,[12] nor permit to be so sold within the State as against police statutes; such as a statute fixing the standard for illuminating oils.[13]

A statute of Arkansas (Act April 23, 1891, Sand. & H. Dig., §§ 493-496) providing that every negotiable instrument taken in payment for any patented machine, implement, substance, or instrument shall be executed upon a printed form showing upon its face that it was so taken, that no person shall be considered an innocent purchaser thereof though he may have given value for the same before maturity, the maker may interpose defense to the collection of the same in the hands of any holder, and that all such negotiable instruments not showing on their face for what they were given shall be absolutely void, and making the violation of the statute punishable by a fine has been adjudged to be void, the court observing:

10. Peckham, J., in Allen v. Riley, 203 U. S. 347, 355, 51 L. Ed. 216.

11. Hollida v. Hunt, 70 Ill. 109, 22 Am. Rep. 63; People v. Russell, 49 Mich. 617, 14 N. W. 568, 43 Am. Rep. 478, 25 Off. Gaz. 504; Cansen v. Smith, 37 Mich. 309, 26 Am. Rep. 514; Crittenden v. White, 23 Minn. 24, 23 Am. Rep. 676; Wilch v. Phelps, 14 Neb. 134, 15 N. W. 361; State v. Lockwood, 43 Wis. 403.

12. Webber v. Virginia, 103 U. S. 344, 26 L. Ed. 565. Contra, State v. Butler, 3 Lea (Tenn.) 222; People v. Russell, 49 Mich. 617, 14 N. W. 568, 43 Am. Rep. 478, 25 Off. Gaz. 504.

13. Patterson v. Kentucky, 97 U. S. 501, 24 L. Ed. 1115, affirming, Patterson v. Com., 11 Bush. (Ky.) 311, 21 Am. Rep. 220.

"In the manufacture and sale of articles of commerce, the right to extend credit and to take negotiable paper which may readily be discounted and the proceeds turned back into the channels of the business, that its volume may be increased, is a valuable one, and is extensively and beneficially employed. That this right may, under an assumed exercise of the police power of a state, be denied those engaged in the manufacture and sale of articles covered by letters patent of the United States, and merely because of such fact, while its free exercise is permitted to all others, is inadmissible. With equal reason a state may destroy the negotiability of all notes taken by national banks, by other corporations organized under the laws of the United States, by citizens of other states, and in interstate commercial transactions, and may place all such notes in a special and discredited class for the better protection of its own citizens who may be the makers thereof. It is obvious that this cannot be done."[14] This ruling has been rendered obsolete by the later cases of the next section.

§ 313. The power of the State to regulate the sale of patent rights.

This topic was the subject of conflicting decisions from 1870[15] to 1906[16] when it was settled by the Supreme Court. The cause in which the two determining opinions were rendered originated in Kansas (71 Kan. 378, 80 Pac. Rep. 952) and Arkansas (75 Ark. 328, 875 S. W. Rep. 621) respectively. The Kansas Statute, §§ 4356, 4357 and 4358, Kansas General Statutes 1901, provided as follows:

14. Hook, J., in Ozan Lumber Co. v. Union County National Bank, 145 Fed. 344, 348, 76 C. C. A. 218.

15. Ex parte Robinson, 4 Fisher 186, Fed. Case 11,932.

16. Allen v. Riley, 203 U. S. 347, 51 L. Ed. 216; and John Woods & Sons v. Carl, 203 U. S. 358, 51 L. Ed. 219. See the note to Com. v. Petty, 96 Ky. 452, 29 L. R. A. 786.

"§ 1. It shall be unlawful for any person to sell or barter, or offer to sell or barter, any patent right, or any right which such person shall allege to be a patent right, in any county within this state, without first filing with the clerk of the district court of such county copies of the letters patent, duly authenticated, and at the same time swearing or affirming to an affidavit before such clerk that such letters patent are genuine, and have not been revoked or annulled, and that he has full authority to sell or barter the right so patented; which affidavit shall also set forth his name, age, occupation, and residence; and if an agent, the name, occupation, and residence of his principal. A copy of this affidavit shall be filed in the office of said clerk, and said clerk shall give a copy of said affidavit to the applicant, who shall exhibit the same to any person on demand.

"§ 2. Any person who may take any obligation in writing for which any patent right, or right claimed by him or her to be a patent right, shall form a whole or any part of the consideration, shall, before it is signed by the maker or makers, insert in the body of said written obligation, above the signature of said maker, or makers, in legible writing or print, the words, 'Given for a patent right.'

"§ 3. Any person who shall sell or barter, or offer to sell or barter, within this State, or shall take any obligation or promise in writing for a patent right, or for what he may call a patent right, without complying with the requirements of this act, or shall refuse to exhibit the certificate when demanded, shall be deemed guilty of a misdemeanor, and on conviction thereof before any court of competent jurisdiction shall be fined in any sum not exceeding $1000, or be imprisoned in the jail of the proper county not more than six months, at the discretion of the court or jury trying the same, and

shall be liable to the party injured in a civil action for any damages sustained."[17]

The court gives a review of the decisions of the State Courts of Kansas, Indiana, Ohio, Pennsylvania, Arkansas, Tennessee, Illinois, Michigan, Nebraska and Wisconsin, and concludes (Mr. Justice White and Mr. Justice Day dissenting):

"If there is a special evil, unusually frequent and easily perpetrated when parties are dealing in the sale of rights existing or claimed to exist under a patent, we do not see why a State may not, in the bona fide exercise of its powers, enact some special statutory provision which may tend to arrest such evil, and may omit to enact the same provision concerning the disposal of other property. There is no discrimination which can be properly so called against property in patent rights, exercised in such legislation. It is simply an attempt to protect the citizen against frauds and impositions which can be more readily perpetrated in such cases than in cases of the sale or assignment of ordinary property.

"The act must be a reasonable and fair exercise of the power of the State for the purpose of checking a well-known evil, and to prevent, so far as possible, fraud and imposition in regard to the sale of rights under patents. Possibly Congress might enact a statute which would take away from the states any power to legislate upon the subject, but it has not as yet done so. It has simply provided that every patent, or interest therein, shall be assignable in writing, leaving to the various states the power to provide for the safeguarding of the interests of those dealing with the assumed owner of a patent, or his assignee. To deal with that subject has been the

17. Allen v. Riley, 203 U. S. 347, 51 L. Ed. 216, 217.

purpose of the acts passed by the various states, among them that of the State of Kansas, and we think that it was within the power of the State to enact such statute. The expense of filing copies of the patent and the making of affidavits in the various counties of the State in which the owner of the rights desired to deal with them is not so great, in our judgment, as to be regarded as oppressive or unreasonable, and we fail to find any other part of the act which may be so regarded. Some fair latitude must be allowed the States in the exercise of their powers on this subject. It will not do to tie them up so carefully that they cannot move, unless the idea is that the states have positively no power whatever on the subject. This we do not believe; at any rate, in the absence of congressional legislation. The mere provision in the Federal statute for an assignment and its record as against subsequent purchasers, etc., is not such legislation as takes away the rights of the states to legislate on the subject themselves in a manner neither inconsistent with, nor opposed to, the Federal statute." [18]

In the second case the statute was the Kansas Act of April 23, 1891, Kirby's Dig., § 513. It is as follows:

"§ 513. Any vendor of any patented machine, implement, substance, or instrument of any kind or character whatsoever, when the said vendor of the same effects the sale of the same to any citizen of the State on a credit, and takes any character of negotiable instrument in payment of the same, the said negotiable instrument shall be executed on a printed form, and show upon its face that it was executed in consideration of a patented machine, implement, substance, or instrument, as the case may be, and no person shall be considered an innocent holder of the same, though he may have given

18. Mr. Justice Peckham, in Allen v. Riley, 203 U. S. 347, 356, 51 L. Ed. 216, 219.

value for the same before maturity, and the maker thereof may make defense to the collection of the same in the hands of any holder of said negotiable instrument, and all such notes not showing on their face for what they were given shall be absolutely void."[19]

The judgment of the Supreme Court in this case was unanimous save for the dissent of Mr. Justice Day. It said:

"The sole question involved is the validity of the statute. * * * This case is governed by the immediately preceding one (just cited), although the statute of Arkansas renders the note void if given for a patent right if the note does not show on its face for what it was given. The difference is not so material as to call for a different decision."[20]

§ 314. Restrictions imposed upon the sale of patented articles.

1. *The nature of the right to impose restrictions.* In Wilson v. Rousseau[21] the distinction was drawn "between the grant of the right to make and vend the machine, and the grant of the right to use it."[22] Following that decision, the Supreme Court pointed out that the purchaser of the right to make or vend "buys a portion of the franchise which the patent confers. He obtains a share in the monopoly, and that monopoly is derived from, and exercised under, the protection of the United States. * * * But the purchase of the implement or machine for the purpose of using it in the ordinary pursuits of life, stands on different ground. In using it, he exercises no rights created by the Act of Congress, nor does he derive title to it by virtue of the

19. John Woods & Sons v. Carl, 203 U. S. 358, 359, 51 L. Ed. 219, 220.

20. Mr. Justice Peckham, in John Woods & Sons v. Carl, 203 U S. 358, 359, 51 L. Ed. 219, 220.

21. 4 How. 688.

22. Mr. Chief Justice Taney, in Bloomer v. McQuewan, 14 How. 539, 549, 14 L. Ed. 532, 537.

franchise or exclusive privilege granted to the patentee. The inventor might lawfully sell it to him, whether he had a patent or not, if no other patentee stood in his way. And when the machine passes to the hands of the purchaser, it is no longer within the limits of the monopoly. It passes outside of it, and is no longer under the protection of the Act of Congress."[23]

But to pass out of "the limits of the monopoly" the conveyance must have been unconditional and unrestricted, (a) as to the use to which the patented article may be put by the vendee, (b) as to the question of resale by the vendee. It is obvious that such a conveyance may be voluntary or involuntary. A conveyance of the former class is effected whenever the patented article is sold unaccompanied by any stipulation limiting its use or resale. A conveyance of the latter class exists wherever title is passed by process of law, free from such stipulation; as where a patented device is sold under execution.[24]

But where the conveyance is not unconditional, the subject of the sale does not pass out of the scope of the rights created by the grant of the patent; and the restriction will attend the subject-matter so long as the restriction is not withdrawn by the act of the vendor, or the expiration of the patent. The rule is admirably expressed by Judge Acheson as follows: "The lawful sale of a patented machine takes it out of the monopoly, either altogether or *pro tanto*, according to the nature of the contract."[25]

23. Ibid. at p. 549.
24. Wilder v. Kent, 15 Fed. Rep. 217.
25. Wilder v. Kent, 15 Fed. Rep. 217, 219.

§ 315. Restrictions as to resale.

The owner of a patent has the right to sell the articles made under the patent with the restriction and upon the condition that they shall only be resold at a certain price.[26] Dealers buying the articles from the original purchaser with notice of such restrictions and conditions are bound thereby, and render themselves liable as infringers.[27]

For a time, this question was in doubt. The United States Supreme Court has said: "Whether a patentee may protect himself and his assignees by special contracts brought home to the purchasers is not a question before us, and upon which we express no opinion. It is, however, obvious that such a question would arise as a question of contract, and not as one under the inherent meaning and effect of the patent laws."[28]

The last sentence in the foregoing paragraph is couched in general terms, but has been clearly interpreted by Judge Lowell as follows: "If the last sentence means that the special contracts alluded to can be enforced only like any other contract, viz., by an action at law for a breach, or by a bill in equity for specific performance, the dictum disposes of the case at bar. But it is not clear that the Supreme Court meant to exclude the possibility of a contract so drawn that by virtue of a special stipulation therein contained a breach of the contract should, in and of itself, make the wrongdoer an infringer, who could be proceeded against under the patent laws."[29]

An opinion of Judge Baker has given additional aid in fixing the relative status of the contract and the tort in cases of the class under discussion.

26. Edison Phonograph Co v. Kaufmann, 105 Fed. Rep. 960.

27. Edison Phonograph Co. v. Kaufmann, 105 Fed. Rep. 960.

28. Keeler v. Folding Bed Co., 157 U. S. 666, 39 L. Ed. 848.

29. Edison Phonograph Co. v. Pike, 116 Fed. Rep. 863, 865.

"When a contract is made respecting a right under a patent, and the parties get into a litigation, confusion has sometimes arisen over the question whether the cause of action originates in the contract or in the patent laws. The test is this: If the plaintiff is seeking a judgment for debt or damages, or a decree for cancellation or specific performance, on account of the defendant's breach of his covenants, the cause of action arises out of the contract; and, though the determination of the issue of breach or no breach may involve the interpretation of the patent and of the prior art, the insistence of the defendant that his device, according to the true construction of the patent and of the prior art, is not within the patent right granted him in the contract, cannot change the nature of the action. On the other hand, if the plaintiff is seeking a judgment for damages, or a decree for an injunction and an accounting, on account of the defendant's unauthorized use of the patent right in making or using or selling the device without license, the cause of action arises out of the patent laws; and, though the determination of the issue of infringement or no infringement may involve the interpretation of the contract, the insistence of the defendant that his act was within his rights under the contract, if properly construed, cannot change the nature of the action."[30]

In conformity with the principles thus established it has been held that a dealer may be enjoined as an infringer, where, in violation of a contract with the patentee, he sells to other dealers who have not signed an agreement to maintain prices.[31]

30. Victor Talking Machine Co. v. The Fair, 123 Fed. Rep. 424, 425, 61 C. C. A. 58.

31. National Phonograph Co. v. Schlegel, 128 Fed. Rep. 733, 736, 64 C. C. A. 594, reversing, 117 Fed. Rep. 624.

§ 316. Who may impose the restriction as to resale.

It has been held that the right to attach price conditions as to resale to the patented article exists solely in the owner of the patent. "The right of the licensee to restrict the future selling price must find its warrant, if any exists, in a grant of authority by the owner of the patent, and, if no such grant has been proved, the licensee's right to restrict cannot be implied."[32] Accordingly such a restriction cannot be imposed by one who has merely an exclusive license to sell.

§ 317. Who liable for infringement by breach of restriction as to price upon resale.

The immediate purchaser is liable as an infringer when guilty of a sale outside the price restriction;[33] the vendee of the immediate purchaser is an infringer if he buys with notice of the restriction;[34] when such infringement "is brought about by concert of action between a defendant and complainant's licensee, all engaged directly and intentionally become joint infringers."[35]

§ 318. Restrictions of the selling price of patented articles in their relation to the Sherman Act.

The "Act to Protect Trade and Commerce against Unlawful Restraints and Monopolies" (26 Stat. at L. 209), commonly known as the Sherman Anti-Trust Act, has been invoked as a defense to an action founded upon a contract fixing the price at which a patented article was

32. Robert H. Ingersoll & Bro. Co. v. The Fair, 123 Fed. Rep. 424, 61 C. C. A. 58.

33. New Jersey Patent Co. v. Schaeffer, 159 Fed. Rep. 171, 173; National Phonograph Co. v. Schlegel, 128 Fed. Rep. 733, 64 C. C. A. 594; Victor Talking Machine v. Snellenberg, 147 Fed. Rep. 522.

34. Edison Phonograph Co. v. Kaufmann, 105 Fed. Rep. 960.

35. Holland, J., in New Jersey Patent Co. v. Schaeffer, 159 Fed. Rep. 171, 173.

to be sold, and it was held that, generally, "any one sued upon a contract may set up as a defense that it is a violation of the Act of Congress, and, if found to be so, that fact will constitute a good defense to the action."[36] In the principal case upon this defense, Mr. Justice Peckham said, "that statute clearly does not refer to that kind of a restraint of interstate commerce which may arise from reasonable and legal conditions imposed upon the assignee or licensee of a patent by the owner thereof, restricting the terms upon which the article may be used and the price to be demanded therefor. Such a construction of the Act, we have no doubt, was never contemplated by its framers."[37] But the opinion in which this dictum occurs expressly refrains from discussing whether "a combination of most, if not all, of the persons or corporations engaged in the business" (in common parlance, the modern trust combination), formed upon a basis of such contracts, might come within the condemnation of the Sherman Act;[38] As the Circuit Court of Appeals of the Seventh Circuit has said, "the question was expressly excepted from the decision,"[39] and to that question the latter court has contributed a keenly reasoned opinion. The majority opinion says: "The Sherman law contains no reference to the patent law. Each was passed under a separate and distinct constitutional grant of power; each was passed professedly to advantage the public; the necessary implication is not that one iota was taken away from the patent law; the necessary implication is that patented

36. E. Bement & Sons v. National Harrow Co., 186 U. S. 70, 88, 46 L. Ed. 1058.

37. E. Bement & Sons v. National Harrow Co., 186 U. S. 70, 92, 46 L. Ed. 1058, 1069.

38. E. Bement & Sons v. National Harrow Co., 186 U. S. 70, 94, 95, 46 L. Ed. 1058, 1070.

39. Baker, J., in Rubber Tire Wheel Co. v. Milwaukee Rubber Works Co., 154 Fed. Rep. 358, 362, 83 C. C. A. 336.

articles, unless or until they are released by the owner of the patent from the dominion of his monopoly, are not articles of trade or commerce among the several states. The evils to be remedied by the Sherman law are well understood. Articles in which the people are entitled to freedom of trade were being taken as the subjects of monopoly; instrumentalities of commerce between which the people are entitled to free competition were being combined. The means of effecting and the form of the combination are immaterial; the result is the criterion. The true test of violation of the Sherman law is whether the people are injured, whether they are deprived of something to which they have a right."[40]

Judge Grosscup's dissent from these views was predicated upon the fact that he was "not prepared to hold that patented articles are never, under any circumstances, articles of trade or commerce among the several states within the meaning of the Sherman Act."[41] A petition for *certiorari*, to review the decision just referred to, was granted by the Supreme Court.[42] Thereafter the cause was dismissed in that court on stipulation.[43] This dismissal would seem to be indicative of the gravity, importance and doubt attending the question under discussion. In the writer's mind there is no doubt that restrictions as to price, if entered into with patents of a scope adequate to cover the whole structure produced and dealt in, are a legitimate and necessary outgrowth of our patent laws and modern industrial conditions. The reasoning of the majority opinion of the Seventh Circuit Court of Appeals is in harmony with the

40. Rubber Tire Wheel Co. v. Milwaukee Rubber Works Co., 154 Fed. Rep. 358, 362, 83 C. C. A. 336.

41. Ibid, 154 Fed. Rep. at p. 364.

42. Milwaukee Rubber Works Co. v. Rubber Tire Wheel Co., 207 U. S. 589, 52 L. Ed. 354.

43. Milwaukee Rubber Works Co. v. Rubber Tire Wheel Co., 210 U. S. 439, 52 L. Ed. 1138.

well-settled theory of the patent franchise. Whether the franchise be called a "monopoly" or "merely the right to exclude others from making, using and vending," the absolute right of the patentee and his assigns to enjoy that franchise by refusing to exercise it at all during the life of the patent must continue to be recognized, if our patent system is to be maintained. Any departure from this fundamental principle would be subversive of that system.[44] Granted this premise, does it not follow that the patentee and his assigns or licensees have the absolute right to fix upon any price they choose, reasonable or unreasonable, for the patented article? If the invention is of enough importance to cover an entire industry, the profit that can be made from it is the consideration which the inventor has received from the public for the disclosure made in his application. The public is to secure its reward for all time, after the patent expires. In the meanwhile, the franchise ought to be held sacredly inviolate. If it may be held and enjoyed in absolute non-user, what possible theory can justify a judicial examination of the number of licensees, the places where they are domiciled, and whether their traffic is interstate or intrastate, or whether the price at which they offer specimens of the thing patented be reasonable or unreasonable? These thoughts are suggested by the language of that part of Judge Grosscup's concurring opinion which says "so long * * * as the patentee is not exacting, as the value of his invention, an *unreasonable* sum * * * it is within his own right to say whether the price exacted should be retained by himself, or shall be distributed among the people manufacturing for him."[45] Under our patent system the in-

44. Continental Paper Bag Co. v. Eastern Paper Bag Co., 210 U. S. 405, 429, 52 L. Ed. 1122, 1132.

45. Rubber Tire Wheel Co. v. Milwaukee Rubber Works Co., 154 Fed. Rep. 358, 365, 83 C. C. A. 336.

ventor is entitled to ask his own price and the suggestion of the possibility of subjecting that price to judicial review is deemed worthy of special mention. The objectionable word occurs in a mere dictum.

§ 319. Can the price restriction extend to the purchasing public?

In the concluding sentence of one of the opinions we have referred to, Judge Baker says: "It is perhaps needless to observe that what the rights of the public who purchase (talking machines) at $25 may be with respect to reselling is a question not involved."[46]

The reported cases have all had to do with the regulation of prices among dealers. What of the consumer, who purchases for his own use and subsequently desires to sell? What of involuntary sales, under execution or in bankruptcy? These are problems to be answered in the future, and they suggest situations hard to pass upon. There will have to be relaxation from the restricted price, for example, when the deterioration of the article from age or wear render a sale at the restricted price impossible. The reasonableness of enforcing the price restriction under such circumstances, will have to be subjected to judicial review. A sale in assignment proceedings or in bankruptcy might be impossible if the purchasers would be liable as infringers if they resold at a price below the one restricted.

§ 320. Restrictions as to the materials to be used with the patented machine.

These restrictions, as in the case of restrictions as to price, seem to be validated by the dictum of the Supreme Court announcing that "any conditions which are not

46. Victor Talking Machine Co. v. The Fair, 123 Fed. Rep. 424. 427, 61 C. C. A. 58.

in their very nature illegal with regard to this kind of property, imposed by the patentee and agreed to by the licensee for the right to manufacture or use or sell the article, will be upheld by the courts."[47]

The right of the authorized manufacturer of the patented article to impress upon the article, by contract; or by notice affixed to the machine, a restriction that it shall be used only with material furnished by the manufacturer, has been affirmed repeatedly, in cases where the defendant offers the material to the user of the article, with knowledge of the restriction, and is held liable as a contributory infringer.[48]

Therefore a quasi-public corporation, cannot exclude persons from its service upon the ground that it is operating under a patent as a licensee, and the terms of the license prohibit it from furnishing the service to specific persons or classes of persons. This has been held in the case of public telephone companies, where the license prohibited them from serving any telegraph company. They were compelled, by mandamus, to extend their service to any one within the district served by them, on request and the payment of their established

47. Bement & Sons v. National Harrow Co., 186 U. S. 70, 46 L. Ed. 1068, quoted with approval in Cortelyou v. Johnson, 207 U. S. 196, 199.

48. Heaton-Peninsular Button Fastener Co. v. Eureka Specialty Co., 77 Fed. Rep. 288, 25 C. C. A. 267, 35 L. R. A. 728; reversing 65 Fed. Rep. 619; Tubular Rivet & Stud Co. v. O'Brien, 93 Fed. Rep. 200; Cortelyou v. Lowe, 111 Fed. Rep. 1005, 49 C. C. A. 671; Cortelyou v. Lowe, 114 Fed. Rep. 1021; Cortelyou v. Carter's Ink Co., 118 Fed. Rep. 1022; Brodrick Copygraph Co. v. Roper, 124 Fed. Rep. 1019; Rupp & Wittgenfeld Co. v. Elliott, 131 Fed. Rep. 730, 65 C. C. A. 544; Brodrick Copygraph Co. v. Mayhew, 131 Fed. Rep. 92, affirmed in, Mayhew v. Brodrick Copygraph Co., 137 Fed. Rep. 596, 70 C. C. A. 557; Cortelyou v. Johnson, 138 Fed. Rep. 110, reversed on ground that notice of restriction not proven, in Cortelyou v. Johnson, 145 Fed. Rep. 933, 76 C. C. A. 455, the later decision affirmed in, Cortelyou v. Johnson, 207 U. S. 196, 52 L. Ed. 167.

charges.[49] Of these cases Judge Lurton has said: "The conclusion to be drawn from these telephone cases is this: That when a patentee authorizes the use of his invention by one charged with public duties; and subject to regulation by law, it is not competent, by a restriction on the use, to deprive the licensee of the power of rendering an equal service to all who apply and tender the compensation fixed by law or regulation for the same service to others. The patentees were under no obligation to license the use of their inventions by any public telephone company. Having done so, however, they were not at liberty to place restraints upon such a public corporation which would disable it from the discharge of all the duties imposed upon companies engaged in the discharge of duties subject to regulation by law. It could not be a public telephone company, and could not exercise the franchise of a common carrier of messages, with such exceptions in the grant; the exception being repugnant to the grant, was void; and the rights acquired under the grant were enforced against the grantor, without regard to the exception or condition. Neither the patentee, nor the machine involving his invention, nor a license for use, can be exempted from the liabilities and regulations which, in the public interest, attach to all persons and property under the general law of the land."[50]

These cases of restriction must be carefully distinguished from cases of outright sale. In the latter class of cases the article passes out from the monopoly of the patent, even though there is an "understanding" that an

49. State ex rel. Missouri v. Bell Tel. Co., 23 Fed. Rep. 539; State ex rel. Delaware v. Delaware & A. Tel. Co., 47 Fed. Rep. 633.

50. Heaton-Peninsular Button Fastener Co. v. Eureka Specialty Co., 77 Fed. Rep. 288, 293, 25 C. C. A. 267.

article is made an element of the patent, which it is the object of the machine to deliver and destroy in delivering, as the instance of a fixture for toilet paper.[51]

§ 321. Restrictions as to use may be void as against public policy.

As stated by Judge Lurton: "We are not at all prepared to say that there are no limitations upon a patentee's power of contract with reference to the use of his invention by others. The property right of a patentee is, after all, but a property right, and subject, as is all other property, to the general law of the land. We may also concede that contracts respecting the use of inventions and discoveries are, like all other contracts, subject to the limitations imposed by definite principles of public policy."[52]

§ 322. Restrictions as to place of use.

Restrictions as to the place in which the patented article is to be used have been uniformly held valid. "Limitations in respect to territorial limits, extent of use, and the like, may be, and in general are, provided by express terms or stipulations."[53] As to the breach of such a restriction the general rule applies that the licensee exceeding his license may be sued in contract, for breach of the licensing agreement, or in tort, as an infringer.[54]

51. Morgan Envelope Co. v. Albany Perforated Wrapping Paper Co., 152 U. S. 425, 38 L. Ed. 500; Thomson-Houston Electric Co. v. Ohio Brass Co., 80 Fed. Rep. 712, 26 C. C. A. 107; Rupp & Wittgenfeld Co. v. Elliott, 131 Fed. Rep. 730, 732, 65 C. C. A. 544.

52. Heaton-Peninsular Button Fastener Co. v. Eureka Specialty Co., 77 Fed. Rep. 288, 292, 25 C. C. A. 267.

53. Steam Cutter Co. v. Sheldon, 5 Fisher 477, 484, Fed. Case No. 13,331.

54. Pope Mfg. Co. v. Owsley, 27 Fed. Rep. 100, 37 Off. Gaz. 781.

CHAPTER XV.

REMEDIES AND PRACTICE.

§ 323. State and Federal jurisdiction.

In this branch of our subject we will, for convenience, follow the order in which the questions discussed arise in office or court practice. The owner of a patent, or some right under a patent, having discovered what he regards as a breach of his rights, the first question to be determined is the form in which to proceed. Without entering upon a consideration of the general subject of the jurisdiction of the Federal courts, it is first to be noted that by § 629, R. S. U. S., the Circuit Courts were given original jurisdiction of all suits at law or in equity arising under the patent laws of the United States, and § 711, R. S. U. S., gives the courts of the United States jurisdiction, exclusive of the courts of the several states, in all cases arising under the patent laws of the United States. The jurisdiction formerly vested in the Circuit Courts has been transferred to the District Courts by the Act of March 3, 1911,[1] called The Judicial Code.

This jurisdiction obtains regardless of the citizenship of the parties,[2] or the amount in controversy;[3] and the same jurisdiction is vested in the District Courts of the Territories of the United States,[4] and in the Supreme Court of the District of Columbia.[5]

1. See Appendix.

2. Campbell v. James, 2 Fed. Rep. 338; Fischer v. Neil, 6 Fed. Rep. 89; Duke v. Graham, 19 Fed. Rep. 647.

3. St. Paul Plow Works v. Starling, 127 U. S. 376, 32 L. Ed. 251.

4. §§ 1910, 1911, R. S. U. S.

5. §§ 760 and 764, Revised Statutes relating to the District of Columbia. See, also, § 699, R. S. U. S., and Cochrane v. Deener, 94 U. S. 780, 24 L. Ed. 139.

§ 324. What are "Cases arising under the Patent Laws?"

This question may as well be approached from the negative side. A bill to subject Letters Patent to an execution is not a case arising under the patent laws,[6] and the same ruling has been made in the following cases: A suit to enforce or rescind a licensing contract,[7] for breach of contract between assignor and assignee;[8] for royalties;[9] to cancel an alleged fraudulent or forged assignment of a patent;[10] to set aside a contract licensing the use of a patented machine;[11] for the specific performance or rescission of a contract for the use or sale of a patent.[12]

Yet many cases where the interpretation of a contract was involved have been held to be cases arising under the patent laws, and the distinction has been thus pointed out:

"When a contract is made respecting a right under a patent, and the parties get into litigation, confusion has sometimes arisen over the question whether the cause of action originates in the contract or in the patent laws. The test is this: If the plaintiff is seeking a judgment for debt or damages, or a decree for cancellation or specific performance, on account of the defendant's breach of his covenants, the cause of action arises out of the contract; and, though the determination of the issue of breach or no breach may involve the interpretation of

6. Ryan v. Lee, 10 Fed. Rep. 917.

7. Hartell v. Tilghman, 99 U. S. 547, 25 L. Ed. 357; Dale Tile Mfg. Co. v. Hyatt, 125 U. S. 46, 31 L. Ed. 683; Hammacher v. Wilson, 26 Fed. Rep. 239.

8. Williams v. Star Sand Co., 85 Fed. Rep. 369.

9. Albright v. Teas, 106 U. S. 613, 27 L. Ed. 295.

10. Kurtz v. Strauss, 106 Fed. Rep. 414, 45 C. C. A. 366.

11. Wilson v. Sanford, 10 How. 99, 13 L. Ed. 344.

12. St. Louis Street Flushing Mach. Co. v. Sanitary Street Flushing Mach. Co., 161 Fed. Rep. 725, 88 C. C. A. 585.

the patent and of the prior art, the insistence of the defendant that his device is not within the patent right granted him in the contract, cannot change the nature of the action. On the other hand, if the plaintiff is seeking a judgment for damages, or a decree for an injunction and an accounting, on account of the defendant's unauthorized use of the patent right in making or using or selling the device without license, the cause of action arises out of the patent laws; and, though the determination of the issue of infringement or no infringement may involve the interpretation of the contract, the insistence of the defendant that his act was within his rights under the contract, if properly construed, cannot change the nature of the action. We think the rule as stated is clearly deducible from the authorities." [13]

The place of bringing suit, and the manner of service, in suits for patent infringement, is provided by the Act of March 3, 1897, 29 Stat. at L. 695, now the Judicial Code, ch. 4, § 48, as follows: "That in suits brought for the infringement of letters patent the Circuit (now the District) Courts of the United States shall have jurisdiction, in law or in equity, in the district of which the defendant is an inhabitant, or in any district in which the defendant, whether a person, partnership, or corporation, shall have committed acts of infringement and have a regular and established place of business. If such suit is brought in a district of which the defendant is not an inhabitant, but in which such defendant has a regular and established place of business, service of process, summons, or subpoena upon the defendant may be made by service upon the agent or agents engaged

13. Baker, J., in Victor Talking Mach. Co. v. The Fair, 123 Fed. Rep. 424, 425, 61 C. C. A. 58.

in conducting such business in the district in which suit is brought."

The benefit of these provisions may be waived by the defendant. The District Courts of the United States have full jurisdiction over patent cases, as to subject-matter. "The limitation as to the district of residence of the defendant, or of place of business and acts of infringement, relates merely to the place of suit, and may be waived."[14] The privilege conferred by this act is personal, and is waived by a general appearance, or by failure to urge it on first appearing.[15]

The agency which will justify service must be in connection with the "regular and established place of business" specified by the act. So where a state statute (as the Pennsylvania statute of April 22, 1874) requires the foreign corporation to designate an agent within the State, service upon the agent so designated is unavailing, and will be set aside upon motion, where the corporation has no such place of business within the district.[16]

Where the defendant has an established and regular place of business within the district, the act of infringement must be shown to have occurred there. In the case of an inhabitant of the district, it is sometimes sufficient to show threats of infringement, or a state of facts indicating that unless the defendant is enjoined the infringement will be committed; but not so as to the foreign corporation, even though its place of business within the district is "regular and established." Unless the making, use, or sale is done within the district, service cannot be had. Its representatives may enter into negotiations within the district for the sale of infringing de-

14. Wheeler, J., in General Seeding & Packing Co., 124 Fed. Elec. Co. v. Wagner Elec. Mfg. Rep. 234.
Co., 123 Fed. Rep. 101, 103.

15. United States Cons. Seeded Raisin Co. v. Phoenix Raisin

16. United States Gramophone Co. v. Columbia Phonograph Co., 106 Fed. Rep. 220.

vices, but if they merely forward offers to the office of the corporation outside the district, which offers are there accepted and delivery made, that is not a sale within the district, and the court is without jurisdiction.[17] Not so when the sale is consummated within the district, by contract executed by the agent, even though the shipment is made from an office of the corporation outside the district.[18]

There is a "regular and established" place of business established by a contract between a foreign corporation defendant and its co-defendant, an inhabitant of the district, where such co-defendant has the exclusive territorial right of sale on a basis of discount from the lowest catalogue selling price, with the privilege of returning unsold merchandise.[19]

But service cannot be sustained where made on the alleged agent of a foreign corporation which has abandoned its place of business in the district before the service is made, although the infringement was committed in the district, and it had such place of business there at the time of the commission of the infringement.[20]

A regular and established place of business within the district does not suffice, alone, to give jurisdiction, nor does the fact of infringement, alone; both must concur.[21]

17. Westinghouse Elec. & Mfg. Co. v. Stanley Elec. Mfg. Co., 116 Fed. Rep. 641.

18. Chicago Pneumatic Tool Co. v. Philadelphia Pneumatic Tool Co., 118 Fed. Rep. 852.

19. Thomson-Houston Elec. Co. v. Bullock Elec. Co., 101 Fed. Rep. 588.

20. Feder v. A. B. Fiedler & Sons Co., 116 Fed. Rep. 378.

21. Bowers v. Atlantic, Gulf & Pacific Co., 104 Fed. Rep. 887; Shaw v. American Tobacco Co., 108 Fed. Rep. 842, 48 C. C. A. 68; Forrest v. Pittsburgh Bridge Co., 116 Fed. Rep. 357; Feder v. A. B. Fiedler & Sons, 116 Fed. Rep. 378, 379; Underwood Typewriter Co. v. Fox Typewriter Co., 158 Fed. Rep. 476.

The question of the sufficiency of service under this act may be raised either by motion to set aside the service,[22] or where proof is necessary to establish the facts, by plea to the jurisdiction;[23] or by special answer.[24] It cannot be raised by demurrer,[25] and can only be raised by entering a special appearance, as general appearance is a waiver of the point.[26]

§ 325. The action at law.

The action on the case is prescribed as the form of action at law for the recovery of damages for patent infringement.

"§ 4919, R. S. U. S. Damages for the infringement of any patent may be recovered by action on the case, in the name of the party interested, either as patentee, assignee, or grantee. And whenever in any such action a verdict is rendered for the plaintiff, the court may enter judgment thereon for any sum above the amount found by the verdict as the actual damage sustained, according to the circumstances of the case, not exceeding three times the amount of such verdict, together with the costs."

The action at law has its advantages from the plaintiff's standpoint, chief of which is the conclusiveness of the verdict, and not the least of which is its great economy of cost as compared with suits in equity. As a suit

22. United States Gramophone Co. v. Columbia Phonograph Co., 106 Fed. Rep. 220; Feder v. A. B. Fiedler & Sons, 116 Fed. Rep. 378.

23. Feder v. A. B. Fiedler & Sons, 116 Fed. Rep. 378; Westinghouse Air Brake Co. v. Christensen Engineering Co., 126 Fed. Rep. 764.

24. Westinghouse Air Brake Co. v. Christensen Engineering Co., 126 Fed. Rep. 764.

25. Westinghouse Air Brake Co. v. Christensen Engineering Co., 126 Fed. Rep. 764.

26. United States Gramophone Co. v. Columbia Phonograph Co., 106 Fed. Rep. 220.

in equity cannot be brought upon an expired patent, the action at law is the only action which will lie after the expiration of the patent, for the recovery of damages for infringement.

§ 326. Who may sue.

The suit must be brought by the party in interest in his own name,[27] but it suffices if the plaintiff was sufficiently interested at the time of the commission of the infringement.[28] A married woman may sue for patent infringement without joining her husband.[29] The holder of the legal title may sue, notwithstanding he has executed an agreement to assign.[30]

§ 327. Defendants in the action at law.

There are created by the grant the several rights of making, using and vending, and an action at law will lie for the damages occasioned by the invasion of either of these rights.[31] The injury thus actionable is a tort,[32] and the general rules as to the joinder of parties defendant obtain that are established as to joint tortfeasors generally.

The plaintiff, under these general rules, has it within his election to proceed against either or all of the joint tortfeasors, collectively or in several suits. Their status is determined by their participation in the infringing acts, and they are still joint tortfeasors though some of them have merely used or sold, while others of them

27. Goldsmith v. American Paper Collar Co., 2 Fed. Rep. 239; Lorillard v. Standard Oil Co., 2 Fed. Rep. 902.

28. Moore v. Marsh, 74 U. S. (7 Wall.) 515, 19 L. Ed. 37; Spring v. Domestic Sewing Co., 13 Fed. Rep. 446.

29. Lorillard v. Standard Oil Co., 2 Fed. Rep. 902.

30. Park v. Little, 3 Wash. 196, Fed. Case No. 10,715; Graham v. McCormick, 11 Fed. Rep. 859.

31. Haselden v. Ogden, 3 Fisher 378, Fed. Case 6190.

32. Jennings v. Dolan, 29 Fed. Rep. 861, 862.

have manufactured, the infringing subject-matter. "Such torts are both joint and several, and those who commit them are liable jointly or severally. There may be several judgments, but only one satisfaction."[33]

The suit for the recovery of damages may be maintained by a plaintiff who has conveyed his interest in the patent before the suit is filed.[34] The right to the recovery of past damages is not conveyed by an assignment of the Letters Patent; it must be expressly conveyed either by express words in the assignment, or by a separate conveyance. In the absence of such an explicit transfer, the holder of the legal title to the patent cannot recover damages for past infringement.[35]

A licensee cannot maintain an action for infringement,[36] and a conveyance of but one of several claims of a patent (probably, of any number of claims less than the whole) is merely a license and not an assignment which will enable the grantee to sue for infringement.[37]

§ 328. Liability of officers, directors and stockholders of corporations for infringement by the corporation.

From an early day, the decisions as to the liability of officers, directors and stockholders of corporations for infringements committed by the corporation was involv-

33. Wheeler, J., in Jennings v. Dolan, 29 Fed. Rep. 861, 862, following Lovejoy v. Murray, 3 Wall. 1, 18 L. Ed. 129; Birdsell v. Shaliol, 112 U. S. 485, 28 L. Ed. 768.

34. Spring v. Domestic Sewing Machine Co., 13 Fed. Rep. 446.

35. Emerson v. Hubbard, 34 Fed. Rep. 327; Jones v. Berger, 58 Fed. Rep. 1006; Matheson v. Campbell, 69 Fed. Rep. 597; Gordon v. Anthony, 16 Blatchf. 234, Fed. Case No. 5605.

36. Gayler v. Wilder, 51 U. S. (10 How.) 477, 494, 13 L. Ed. 504, 511; Waterman v. Mackenzie, 138 U. S. 252, 34 L. Ed. 923.

37. Pope Mfg. Co. v. Gormully & Jeffrey Mfg. Co., 144 U. S. 248. 36 L. Ed. 423.

ed in doubt and conflict.[38] As Judge Lowell has pointed out, "most of the decisions rendered are doubtless correct, but the language of the opinions is sometimes irreconcilable, and often goes further than was required by the facts under consideration."[39]

In the study of the cases bearing upon this subject, it has seemed to the writer that the courts have either disregarded, or taken too narrow a view of those cases, other than patent cases, in which officers or directors of corporations have been held personally liable for any tort of the corporation which inured directly to their personal advantage.[40] By way of illustration, an instructive opinion of Mr. Justice Blatchford contains the following reasons for affirming a decree as against the president of a corporation: "The effect of the fraud committed by Tyler inured directly to his personal advantage. Not only was he, as a large stockholder and salaried officer, benefited by the plaintiff's payment into the treasury of the company of the $10,000, but, as already shown, $6,200 of that sum went directly to his benefit, and the remainder, he testifies, went to the payment of material and ordinary expenses of the company. The latter amount enabled the company to continue paying to Tyler his salary for some time longer."[41]

Where the infringement is that of a corporation of the class colloquially termed a "one man corporation," the individual defendant who owns all but a nominal amount of the stock, and controls and directs the acts of the corporation is clearly liable to joinder with the corporation for its acts of infringement.[42]

38. Compare United Nickel Co. v. Worthington, 13 Fed. Rep. 392, and Graham v. Earl, 92 Fed. Rep. 155, 160, 34 C. C. A. 267.

39. National Cash Register Co. v. Leland, 94 Fed. Rep. 502, 510.

40. See editorial notes, 28 L. R. A. 421; 55 L. R. A. 751.

41. Tyler v. Savage, 143 U. S. 79, 36 L. Ed. 82.

42. Chicago Ry. Equipment Co. v. Perry Side Bearing Co., 170

Where the corporation is merely a cloak for individual misconduct, the incorporators should be held personally for the infringement of the corporation, particularly where it appears that they have incorporated with small capital for the purpose of engaging in the infringing business. In such a case, Judge Chatfield has said: "As to the individual defendants, the testimony shows that they are engaged in the cork business, and formed the defendant corporation for the purpose of manufacturing and supplying caps of the nature described, in which they have made use of the cork disk. * * * The testimony as to the amount of capital stock paid in, the persons interested in the formation and conduct of the business, and all of the circumstances connected therewith, indicate that the three individual defendants organized the corporation for the sole purpose of enabling them as individuals to carry on, in corporate form, a side line or business, in which they could as individuals have the entire management and direction, but in which they would not be responsible beyond the small amount of investment shown in the present case. The property of the corporation has been shown to have been largely destroyed by fire, and yet the individual defendants have proceeded to carry on the activities of the business, and the personal element of the three individual defendants has been present in all acts of the corporation set forth in the testimony. Upon these facts * * * it must be held that the individuals were properly joined as defendants, that they should be united with the corporation in any decree that may be made, and that they should personally be held responsible for the expenses of the litigation in case the corporation is unable to answer therefor."[43]

Fed. Rep. 968, 981; Smith v. Standard Laundry Mach. Co., 19 Fed. Rep. 826.

43. Crown Cork & Seal Co. v. Brooklyn Bottle Stopper Co., 172 Fed. Rep. 225, 233.

The conflict of the cases, prior to 1895, elicited from Judge Townsend the grouping of the cases given in the note.[44]

The conflict in the cases is more than a mere matter of words. Those cases which broadly assert the liability of officers and directors for infringement are in harmony with the doctrine that "the executive officers of a corporation, who necessarily inspire all of its acts, cannot

44. In Mergenthaler Linotype Co. v. Ridder, 65 Fed. Rep. 853, Judge Townsend said "the decisions as to the individual liability of the officers and directors of corporations for infringing acts, are somewhat conflicting. The liability, at least to be enjoined, has been asserted in Goodyear v. Phelps, 3 Blatchf. 91, Fed. Case 5581; Poppenhusen v. Falke, 4 Blatchf. 493, Fed. Cas. 11,279; Bliss v. Haight, 7 Blatchf. 7, Fed. Case 1548; Maltby v. Bobo, 14 Blatchf. 53, Fed. Case 8998; Supply Co. v. McCready, 17 Blatchf. 291, Fed. Case 295; Stamping Co. v. Quinby, 5 Ban. & A. 275, Fed. Case 12240a; National Car Brake Shoe Co. v. Terre Haute Car & Mfg. Co., 19 Fed. Rep. 514; Iowa Barb Steel Wire Co. v. Southern Barbed Wire Co., 30 Fed. Rep. 123; Cleveland Forge & Bolt Co. v. United States Rolling Stock Co., 41 Fed. Rep. 476; Armstrong v. Soap Works, 53 Fed. Rep. 124; Fishel v. Lueckel, Id. 499; Cahoone Barnet Mfg. Co. v. Rubber & Celluloid Harness Co., 45 Fed. Rep. 58-, Edison Electric Light Co. v. Packard Electric Co., 61 Fed. Rep. 1002. That officers of a corporation, are such, are either not liable for damages for infringement in an action at law, or will not be enjoined or ordered to account in equity has been held in Jones v. Osgood, 6 Blatchf. 435, Fed. Case 7487; Nickel Co. v. Worthington, 13 Fed. Rep. 392; Howard v. Plow Works, 35 Fed. Rep. 743; Boston Woven Hose Co. v. Star Rubber Co., 40 Fed. 167.

"An examination of all the cases cited by counsel shows that in none of those cited by complainant was the defendant held liable to render an accounting. In Poppenhusen v. Falke, supra; Bliss v. Haight, supra; Maltby v. Bobo, supra; Supply Co. v. McCready, supra; Iowa Barb Steel Wire Co. v. Southern Barbed Wire Co., supra; Estes v. Worthington, 30 Fed. Rep. 465; Featherstone v. Cycle Co., 53 Fed. Rep. 110; Fishel v. Lueckel, supra—the defendants had personally infringed, and were joint tortfeasors. In Consolidated Safety-Valve Co. v. Ashton Valve Co., 26 Fed. Rep. 319; Cleveland Forge & Bolt Co. v. U. S. Rolling Stock Co., supra; and Armstrong v. Soap Works, supra—the question of liability was raised by a demurrer, when it should have been presented by a plea."

shield themselves behind an artificial, and sometimes irresponsible, creation, from the consequences of their own acts, even though performed in the name of the artificial body."[45] Or, as it is differently stated, "the law is well settled that a party cannot escape liability for his infringement by attempting to shield himself behind a corporation. An officer or director of a corporation cannot avoid liability for his infringement by setting up that his acts of infringement were performed in his capacity as a director or officer. In so deciding we are merely stating obvious and well-known principles of agency; and the law of agency is the basis of almost all corporation law."[46]

Thus, in a bill where two individuals were impleaded with a corporation defendant, by a recital naming each "individually and as president (or treasurer) of said corporation," their individual pleas setting up that the infringement was committed, if at all, by the corporation, and that the acts of the individuals were done solely in their official capacity, were overruled;[47] and the decision was rendered in the First Circuit, where the liability of officers and directors seemed to be affirmatively settled in this class of cases.[48] In the Second Circuit the contrary rule obtains, thus condensed by Judge Hazel:

"It appears that the infringement complained of is that of the defendant corporation. The individual defendants are officers thereof, and as such participated

45. E. B. Adams, J., in Peters v. Union Biscuit Co., 120 Fed. Rep. 679, 686. Reversed on other grounds in Union Biscuit Co. v. Peters, 125 Fed. Rep. 601, 60 C. C. A. 337.

46. Hale, J.. in Calculagraph Co. v. Wilson, 132 Fed. Rep. 20, 30, reversed on other grounds, Wilson v. Calculagraph Co., 144 Fed. Rep. 91, 75 C. C. A. 249.

47. Fauber v. Springfield Drop Forging Co., 98 Fed. Rep. 119.

48. National Cash Register Co. v. Leland, 94 Fed. Rep. 502, 37 C. C. A. 37.

in the acts of infringement. In the absence of some special reason for joining the officers of the alleged infringing corporation as defendants, such as insolvency of the company, or the use of the name of the corporation to conceal a fraud or conspiracy, or as a protection against liability of others, I am not inclined to hold differently," from two earlier decisions in his circuit, named in the note.[49]

In the Fourth Circuit Judge Parnell has followed the rulings of the Second Circuit, saying "if it was intended in the bill to charge a conspiracy * * * the remedy would be at law, and not in equity."[50]

Without further detailed examination of the cases, the present aspect of this phase of the liability of officers and directors seems to be this:

1. Where there is no connection proven, between the individual and the tort, the bill must be dismissed as to him.[51]

2. That he participated in the infringement in his official capacity, seems sufficient in the First Circuit and possibly in the Eighth, to warrant joining him as defendant, even where the corporation is solvent.[52]

3. That where the incorporation is a subterfuge, organized to enable one or more persons to engage in infringement with nominally limited liability, there is a

49. Loomis-Manning Filter Co. v. Manhattan Filter Co., 117 Fed. Rep. 325; following, Mergenthaler Linotype Co. v. Ridder, 65 Fed. Rep. 853, and Bowers v. Atlantic, G. & P. Co. 104 Fed. Rep. 892; see, also, Greene v. Buckley, 120 Fed. Rep. 955.

50. Farmers' Mfg. Co. v. Sprinks Mfg. Co., 119 Fed. Rep. 594.

51. Consolidated Fastener Co. v. Columbia Fastener Co., 79 Fed. Rep. 795, 801.

52. First Circuit, National Cash Register Co. v. Leland, 94 Fed. Rep. 502, 37 C. C. A. 37; Eighth Circuit, Peters v. Union Biscuit Co., 120 Fed. Rep. 679, 686; Iowa Barb Steel Wire Co. v. Southern Barbed Wire Co., 30 Fed. Rep. 123.

conspiracy, corporation and organizers are joint tort-feasors, and all should be joined in any decree entered.

4. Where a separate profit is realized from the infringement by an officer or director, he should be joined with the corporation.

5. Where the corporation derives all the profits in the first instance, the extent to which the managing officers profit in dividends or salaries ought to be a factor in fixing their liability;[53] if the corporation is insolvent, the managing officers may be more properly held personally liable than if it were solvent.

6. The question of the proportionate amount of stock of the corporation owned by the officer or officers whom it is sought to hold personally liable, is frequently a determining factor.

ACTIONS AT LAW.

§ 329. The declaration.

Section 4919, R. S. U. S., provides that "damages for the infringement of any patent may be recovered by action on the case;" while § 914 provides that, in other than equity and admiralty cases, the practice, pleadings, and forms and mode of proceeding in civil causes in the Circuit and District Courts shall conform, as near as may be, to those of the courts of the State in which they sit. Judge Lacombe has held that "by the operation of § 914 an action on the case in the Federal Courts is assimilated to the State model, except so far as it is modified by express enactment of Congress, as by § 4920."[54] It has been held that a declaration to be sufficient should contain all the essential averments pre-

53. Iowa Barb Steel Wire Co. v. Southern Barbed Wire Co., 30 Fed. Rep. 123.

54. Celluloid Mfg. Co. v. American Zylonite Co., 34 Fed. Rep. 744, 745.

scribed for a declaration in an action on the case under the common law form of pleading.[55] In Oregon, Judge Deady held that the pleadings in a law action for patent infringement should be verified in conformity to a provision of the Oregon Code of Civil Procedure,[56] and the scarcity of decisions touching upon the requirements of the pleadings of either party in actions at law indicates that the subject is one of very minor importance in view of the liberality with which the pleadings may be amended when necessary.

The action on the case affords as to its opening pleading the nearest point of approximation to the modern code pleading of any of the common law actions. Its orderly parts are:

(1) the title and the date—the court, term, year and number of the case;

(2) the venue—state and county;

(3) the commencement—A B, by his attorney or in person, complains of C D, for that, heretofore, etc.;

(4) the body—which consists of; (a) the inducement—introductory matter; (b) the averments—allegations of performance of precedents by the plaintiff, in the acquisition of his patent rights, as inventor or assignee; (c) statements of infringement by the defendant;

(5) the conclusion—"to the damage of plaintiff ————dollars; wherefore he brings suit.[57]

The declaration must be explicit as to all the facts showing title,[58] and relating to the disclaimer, when there

55. Myers v. Cunningham, 44 Fed. Rep. 346, 349; May v. Mercer County, 30 Fed. Rep. 246.

56. Cottier v. Stimson, 18 Fed. Rep. 689.

57. Anderson, Dict., p. 321, title "Declaration."

58. Gray v. James, Peters C. C. 478, Fed. Case 5719.

is one;[59] but it is sufficient to aver that title is vested in the plaintiff without reciting the mesne conveyances.[60]

The patent may be referred to by its short title, and by reference to the Letters Patent "for further and fuller description of the invention" the contents of the patent are imported into the declaration.[61]

An averment that sums paid or received in other cases establish a fair measure of damages is pleading, evidence, and demurrable.[62]

§ 330. Forms of pleading in actions at law.

1. *The declaration.* Whether the initial pleading in the action at law should be the common-law declaration, employed in the action on the case, as is held in some jurisdictions,[63] or may be the petition or complaint of the codes, as indicated in other cases,[64] there can be no danger in filing a preliminary pleading that contains "all the essential averments that are presented for a declaration in an action on the case under the common law form of pleading."[65]

The jurisdiction of the Federal Courts in this class of cases being determined by the nature of the controversy, a recital of the citizenship of the parties is surplusage,[66] as would be the recital of the amount in controversy.

The statement of the cause of action must allege the invention of the subject-matter of the patent in suit by

59. Van Hook v. Wood, Fed. Case 16,854.

60. Meerse v Allen, Fed. Case 9393a.

61. Graham v. Earl, 92 Fed. Rep. 155, 34 C. C. A. 267.

62. Ewart Mfg. Co. v. Baldwin Cycle Chain Co., 91 Fed. Rep. 262.

63. Myers v. Cunningham, 44 Fed. Rep. 846, 349.

64. May v. Mercer Co., 30 Fed. Rep. 246.

65. Ricks, J., in Myers v. Cunningham, 44 Fed. Rep. 346, 349.

66. Fischer v. Neil, 6 Fed. Rep. 89.

the patentee or his assignor, and that such subject-matter was not in public use or on sale in this country more than two years before the application upon which the patent in suit was issued,[67] though aside from alleging the invention to have been made before the application was filed no allegation as to the date of the invention is necessary.[68]

It is desirable, possibly essential to allege that no foreign application was made more than twelve months prior to the filing of the application in this country.[69]

The general nature of the invention should be stated, usually by the short title contained in the patent,[70] and profert of the letters patent should be made, which makes it a part of the declaration and obviates the necessity of a recital of the grant, description or claims.[71]

The patent, if a reissue, should be traced through its original and any intermediate reissues,[72] and the patent in suit finally identified by date and number.

It is also expedient to allege that the patent was attested by the proper officer, and that it was delivered to the assignee.[73]

The declaration must show with certainty the title in the plaintiff.[74] With what degree of particularity assignments must be pleaded, is difficult to determine. An allegation that the then pending application was assign-

67. Gay v. James, 1 Robb 140, Fed. Case 5719; Wilder v. McCormick, 2 Blatchf. 31, Fed. Case 17,650; Gandy v. Belting Co., 143 U. S. 5.

68. Wilder v. McCormick, 2 Blatchf. 31, Fed. Case 17,650.

69. Victor Talking Machine Co. v. Leeds & Catlin Co., 165 Fed. Rep. 931, 934.

70. Peterson v. Wooden, 3 McLean 248, Fed. Case 11,038.

71. Pitts v. Whitman, 2 Storey 609, Fed. Case 11,196; Graham v. Earl, 82 Fed. Rep. 737, 27 C. C. A. 377.

72. Spaeth v. Barney, 22 Fed. Rep. 828.

73. Cutting v. Myers, 4 Wash. 220, Fed. Case 3520.

74. Gray v. James, 1 Robb. 140, Fed. Case 5719.

ed to the plaintiff before the patent in suit issued has been held sufficient,[75] and it has been held that assignments subsequent to the grant should be specifically pleaded, and that their recordation should be alleged.[76]

The declaration must specifically allege that the articles made under the patent have been marked with the word "patented" with the day and year the patent was granted, or that such imprint was affixed to the packages containing the patented article, or that the defendant was duly notified of the infringement, and continued after such notice to infringe; all as required by § 4900, R. S. U. S.[77] The rule as to marking does not apply where the patent has lain dormant.[78]

The allegation as to the character of the infringement may charge either making, using or selling, or any two, or all, of them, in accordance with the facts. The law is settled "that the recovery of damages from a defendant, for manufacturing and selling, will not prevent the recovery of other substantial damages from the defendant's vendees, for their profits upon reselling the patented articles. * * * A patentee has three distinctive rights (making, selling, and using), and whoever invades any one of these rights is an infringer, and liable for damages."[79]

As to the time of the alleged infringement, it should be specified as of any date not earlier than the issuance of the patent, and within the six years' limitation (29

75. Rathbone v. Orr, 5 McLean 131, Fed. Case 11,585.

76. Dobson v. Campbell, 1 Robb. 681, Fed. Case 3945.

77. Dunlap v. Schofield, 152 U. S. 244, 248, 38 L. Ed. 426, 427; Coupe v. Royer, 155 U. S. 565, 584, 39 L. Ed. 263; Sprague v. Bramhall-Deane Co., 133 Fed. Rep. 738.

78. Ewart Mfg. Co. v. Baldwin Cycle-Chain Co., 91 Fed. Rep. 262.

79. Wales, J., in Philadelphia Trust, etc., Co. v. Edison Elec. Light Co., 65 Fed. Rep. 551, 554, 13 C. C. A. 43; and to the same effect, see, Birdsall v. Shallol, 112 U. S. 485, 28 L. Ed. 768; Tilghman v. Proctor, 125 U. S. 149, 31 L. Ed. 668; Callaghan v. Myers, 128 U. S. 665, 32 L. Ed. 562.

Stat. at L., p. 694, ch. 391, § 6) prescribed by statute, and prior to the filing of the declaration.[80]

Any number of acts of infringement may be sued and recovered upon in the same suit; but an averment that "since the 1st day of November, 1888," the defendant did the acts complained of was held to admit proof of only one sale. In the light of this declaration, the recital should include the *continuando* as to the infringeing acts, that the defendant did them on a day certain, "and thence continuously, from day to day, unto the day of the filing of this declaration."[81]

The declaration may charge generally that the claims of the patent, if there are more than one, have been infringed. The better practice is to allege the infringement of the specific claims, if less than all, charged to be infringed, indicating them by number.

It has been held that allegations as to payment of established royalties by others, or sums received from others in compromise of claims for infringement of the patent in suit, are improper to be pleaded in the declaration, and render it demurrable.[82]

Where a disclaimer exists, its execution and recordation should be alleged in the declaration.[83]

Where the code of civil procedure of the State in which the action is brought provides for the verification of pleadings, it has been held that the declaration should be verified.[84]

80. When there was no Federal statute of limitations applicable to patent infringement, the state statutes governed. Campbell v. City of Haverhill, 155 U. S. 610, 39 L. Ed. 280; Campbell v. Mayor of New York, 81 Fed. Rep. 182, 183.

81. Le Page Co. v. Russia Cement Co., 51 Fed. Rep. 941, 949, 2 C. C. A. 555.

82. Ewart Mfg. Co. v. Baldwin Cycle-Chain Co., 91 Fed. Rep. 262, 265.

83. Van Hook v. Wood, Fed. Case No. 16,854.

84. Cottier v. Stimson, 18 Fed. Rep. 689.

§ 331. Demurrer to the declaration.

The sufficiency of the declaration may be tested by demurrer, but as a general demurrer will be overruled wherever there is enough in the declaration to make out a cause of action, the demurrer should be specific.[85]

If the initial pleading contains the averments necessary to a common-law declaration, it is not demurrable because it has been entitled "petition," instead of "declaration."[86]

Where the declaration recites settlements and compromises with others of claims for infringement of the patent in suit, such allegations are improper and may be reached by special demurrer.[87] It would appear that failure to allege "patent" marking by the plaintiff, or the alternative notice to the defendant, would render the declaration demurrable.[88] The failure to allege that no foreign patent has been applied for, more than twelve months before the application for the United States patent, will render the declaration demurrable under some authorities,[89] though the contrary is asserted in other cases, Judge Kohlsaat saying "the provisions of that section (§ 4887, R. S. U. S.) constitute matters of defense and must be set up in the answer."[90]

The declaration must aver that the invention of the patent in suit was not in public use or on sale in this country for more than two years prior to the application,

85. Ewart Mfg. Co. v. Baldwin Cycle Chain Co., 91 Fed. Rep. 262.

86. May v. Mercer County, 30 Fed. Rep. 246.

87. Ewart Mfg. Co. v. Baldwin Cycle-Chain Co., 91 Fed. Rep. 262, 265.

88. Dunlap v. Schofield, 152 U. S. 244, 248, 38 L. Ed. 426, 427.

89. Victor Talking Machine Co. v. Leeds & Catlin Co., 165 Fed. Rep. 931, 934; Elliott & Hatch Book-Typewriter Co. v. Fisher Typewriter Co., 109 Fed. Rep. 330.

90. American Cereal Co. v. Oriental Food Co., 145 Fed. Rep. 649.

or it will be held bad on demurrer,[91] as will a declaration that fails to negative description in a printed publication.[92]

These averments must be stated positively, as facts; if alleged as on information or belief they are demurrable.[93] The omission of the words "in this country," from the allegation respecting prior knowledge or use by others, is immaterial, and will not render the declaration demurrable.[94]

A declaration which joins two or more defendants, but fails to allege that they are joint infringers, will be held bad on demurrer,[95] as will one that fails to allege delivery of the patent to the patentee.[96]

But the usual employment of demurrer to the declaration is for the purpose of raising the question of the validity of the letters patent in suit. The question as thus raised is addressed solely to, and must be answered by, the patent itself, read in the light of common knowledge. As stated by Judge Blodgett, "the books abound in cases where the court has of its common knowledge *sua sponte* held patents void for want of patentable novelty."[97]

91. Blessing v. John Trageser, Steam Copper Works, 34 Fed. Rep. 753, 754; Consolidated Brake Shoe Co. *v.* Detroit Steel & Spring Co., 47 Fed. Rep. 894, 895; Coop v. Dr. Savage Physical Development System, 47 Fed. Rep. 899; Elliott & Hatch Book Typewriter Co. v. Fisher Typewriter Co., 109 Fed. Rep. 330,

92. Coop v. Dr. Savage Physical Development Institute, 47 Fed. Rep. 899, 901; Overman Wheel Co. v. Elliott Hickory Cycle Co., 49 Fed. Rep. 859; Goebel v. American Railway Supply Co., 55 Fed. Rep. 825, 827; Hanlon v. Primrose, 56 Fed. Rep. 600, 601; Hutton v. Star Slide Seat Co., 60 Fed. Rep. 747; Diamond Match Co. v. Ohio Match Co., 80 Fed. Rep. 117.

93. Rubber Tire Wheel Co. v. Davie, 100 Fed. Rep. 85, 86.

94. Rubber Tire Wheel Co. v. Davie, 100 Fed. Rep. 85, 87.

95. Diamond Match Co. v. Ohio Match Co., 80 Fed. Rep. 117.

96. Wilder v. McCormick, 2 Blatchf. 31, Fed. Case 17,650.

97. West v. Rae, 33 Fed. Rep. 45, 47.

The court, upon such an inquiry, may resort to dictionaries, encyclopedias, or any other source of common information accessible to the general public.[98]

The boundary line between the special, and the general knowledge, which the court should recognize, was thus illuminated by Judge Blodgett:

> "In West v. Rae, 33 Fed. Rep. 45, this court sustained a demurrer to a bill charging infringement of a patent on a device for protecting woolen blankets from insects by incasing them in paper bags, on the ground that within the common knowledge it was old to wrap or incase woolens in paper to protect them from dust or insects. At the time I announced the decision in that case I stated that its effect might be to encourage counsel to demur to bills for infringement of patents in cases where they, from their special knowledge of the art, might be of opinion that the device covered by the patent was old. And my anticipations in that respect have been fully realized, as that decision has already produced in this court quite a bountiful crop of demurrers in this class of cases. But the court must meet each case as it arises, and, in sustaining demurrers like this, keep strictly within the field of common knowledge. The practical difficulty and danger is in defining where special knowledge leaves off and common knowledge begins. The judge must always be careful to distinguish between his own special knowledge, and what he considers to be the knowledge of others, in the field or sphere where the device in question is used. But when the judge before whom rights are claimed by virtue of a patent can say from his own observation and experience that

98. Brown v. Piper, 91 U. S. 44, 23 L. Ed. 200.

the patented device is in principle and mode of operation only an old and well-known device in common use, he may act upon such knowledge. The case must, however, be so plain as to leave no room for doubt; otherwise injustice may be done, and the right granted by the patent defeated, without a hearing upon the proofs. The judge must on all such questions vigilantly guard against acting upon expert or special knowledge of his own, instead of keeping strictly within the field of general or popular knowledge. While I do not intend to lay down a rule, I am free to say that I should not feel justified in holding a patent void for want of novelty on common knowledge, unless I could cite instances of common use which would, at once, on the suggestion being made, strike persons of usual intelligence as a complete answer to the claim of such patent."[99]

§ 332. Answer and notice of special matter.

The answer in law actions, by reason of the provisions of § 4920, R. S. U. S., is usually the general issue, accompanied by notice of the special matter enumerated in that section; but the defendant may plead either of the defenses specially in conjunction with the general issue.[100]

The purpose of the notice is to prevent the plaintiff being surprised upon the trial. Inasmuch as he is entitled to rely upon the presumption of novelty attending the grant of the patent, in the absence of notice of alleged anticipating matter, he would be unprepared to

99. Blodgett, J., in Eclipse Mfg. Co. v. Adkins, 36 Fed. Rep. 555, 556.

100. Cottier v. Stimson, 18 Fed. Rep. 689.

rebut an attack upon the novelty of his patent.[101] Section 4920 requires the notice to be written, and the anticipatory matter relied on to be given with a degree of particularity which the decisions have approved.[102]

§ 333. The questions for the court and jury.

In the action at law it is for the court to instruct the jury as to questions of law,[103] and the province of the jury to find the facts and apply the law to those facts.[104]

It is the duty of the court to define to the jury the patented invention as the same is expressed in the language of the claim;[105] it is for the court to construe the claims of the patent,[106] and in so doing he may express his opinion upon any fact in the case which is clear.[107]

Questions of identity, generally, are for the jury. So it is for the jury to determine the question of identity of the defendant's device with the claim in suit, upon the question of infringement,[108] and the question of the identity of the original and reissued patents, when a reissued patent is in suit and its validity challenged upon the ground of want of identity with the original.[109]

Where the defendant's alleged infringing acts are done under a later patent, he is entitled to have the jury in-

101. Blanchard v. Putnam, 8 Wall. 420, 428, 19 L. Ed. 433; Teese v. Huntingdon, 23 How. 2, 16 L. Ed. 479; Roemer v. Simon, 95 U. S. 214, 219, 24 L. Ed. 384.

102. Seymour v. Osborne, 11 Wall. 516, 20 L. Ed. 33; Roemer v. Simon, 95 U. S. 214, 24 L. Ed. 384.

103. National Car Brake Shoe Co. v. Terre Haute Car & Mfg. Co., 19 Fed. Rep. 514.

104. Battin v. Taggart, 58 U. S. 74, 15 L. Ed. 37.

105. Holmes v. Truman, 67 Fed. Rep. 542, 545, 14 C. C. A. 517.

106. Marsh v. Quick-Meal Stove Co., 51 Fed. Rep. 203.

107. Bollmans v. Parry, Fed. Cas. 1612.

108. Coupe v. Royer, 155 U. S. 565, 39 L. Ed. 263.

109. Battin v. Taggart, 58 U. S. 77, 15 L. Ed. 37.

structed that the issuance of the later patent creates a presumption of a patentable difference between its disclosure and that of the patent in suit.[110]

Where the question of invention is in doubt, i. e., where the absence of invention is not so clear that it becomes the court's duty to direct a verdict for the defendant, that question should go to the jury,[111] and so should the question of equivalency between the device of the patent, and that of the defendant,[112] and likewise the issues of want of novelty,[113] and anticipation.[114]

Mr. Justice Story, on circuit, held that the question whether the invention was specifically described with reasonable certainty, was one of law for the court; while the question whether the specification was so full, clear and exact as not only to distinguish it from the prior art, but to enable one skilled in the art to practice it, was left to the jury.[115]

§ 334. Directed verdicts.

Where the plaintiff fails to show that the defendant has made, used or sold (in accordance with the charge of the declaration) a specimen of the infringing device, it is the duty of the court to direct a verdict for the defendant at the close of the plaintiff's *prima facie* testimony.[116] And where the court becomes satisfied at any stage of the proceedings, that the patent is void, for any

110. Ransome v. Hyatt, 69 Fed. Rep. 148, 16 C. C. A. 185.

111. San Francisco Bridge Co. v. Keating, 68 Fed. Rep. 351, 354, 15 C. C. A. 476; Hunt Bros. Fruit Packing Co. v. Cassidy, 53 Fed. Rep. 257, 3 C. C. A. 525.

112. Hunt Bros. Fruit Packing Co. v. Cassidy, 53 Fed. Rep. 257, 3 C. C. A. 525.

113. Graham v. Earl, 82 Fed. Rep. 737, 739 (C. C. A.).

114. Keyes v. Grant, 118 U. S. 25, 30 L. Ed. 54.

115. Lowell v. Lewis, 1 Robb. 131, Fed. Case 8568.

116. Marsh v. Quick-Meal Stove Co., 51 Fed. Rep. 203.

reason that would compel him to set aside a verdict for the plaintiff, it is his duty to direct the verdict accordingly.[117]

§ 335. The statutory defenses.

The defenses provided for by statute are embodied in the following section:

Section 4920, R. S. U. S. In any action for infringement the defendant may plead the general issue, and, having given notice in writing to the plaintiff or his attorney thirty days before, may prove on the trial any one or more of the following special matters:

First. That for the purpose of deceiving the public the description and specification filed by the patentee in the Patent Office was made to contain less than the whole truth relative to his invention or discovery, or more than is necessary to produce the desired effect; or,

Second. That he had surreptitiously or unjustly obtained the patent for that which was in fact invented by another, who was using reasonable diligence in adapting and perfecting the same; or,

Third. That it has been patented or described in some printed publication prior to his supposed invention or discovery thereof, or more than two years prior to his application for a patent therefor; or,

Fourth. That he was not the original and first inventor or discoverer of any material and substantial part of the thing patented; or,

Fifth. That it had been in public use, or on sale in this country for more than two years before his application for a patent, or had been abandoned to the public.

117. Plastic Fire Proof Construction Co. v. San Francisco, 97 Fed. Rep. 620; Market Street R. Co. v. Rowley, 155 U. S. 621, 39 L. Ed. 284

The provisions of this section apply as fully to design as to other patents.[118]

The defenses enumerated in this section apply as well in proceedings in equity as in actions at law.[119] As to this section, Mr. Justice Clifford has said, "each of these defenses * * * goes to the entire invention, and not to separate parts of the thing patented."[120] This section does not attempt to enumerate all of the possible defenses. For example, it does not refer to the defense of non-infringement, or the defense that the defendant's acts complained of were done under license or by authority.[121]

§ 336. The specific defenses.

We will examine in detail the defenses that may be pleaded either at law or in equity.

All of these defenses are founded either on equitable doctrines or on the patent statutes. Their numbering and arrangement are purely arbitrary.

"In equity, a defendant has the right to set up as many defenses as he may have, providing they are not inconsistent."[122]

The discussion of the several defenses will disclose the extent to which they may be availed of in the action at law.

§ 337. First defense—Want of invention.

This defense is almost universally interposed in patent cases, even where the patent in suit has been sus-

118. Anderson v. Eiler, 46 Fed. Rep. 777, 778.

119. Bates v. Coe, 98 U. S. 31, 25 L. Ed. 68.

120. Bates v. Coe, 98 U. S. 31, 25 L. Ed. 68.

121. Whittemore v. Cutter, 1 Robb. 28, Fed. Case No. 17,600.

122. Swing, J., in National Mfg. Co. v. Meyers, 7 Fed. Rep. 355, 357.

tained in former litigation. Invention being incapable of definition, and some courts being apparently incapable of seeing invention in anything, it is usually the first defense considered by counsel for both parties in the preparation of the case.

Even if not pleaded, the court will *sua sponte* dismiss the suit or direct a verdict for the defendant whenever it is satisfied that the patent in suit is void.[123]

This, too, when the court arrives at its conclusion that invention does not exist after the prior state of the art has been shown upon the trial.[124] But this action by the court implies that if the case had gone to the jury and the verdict had been for the plaintiff, it would have been the duty of the court to set it aside as not supported by the evidence. Where there is sufficient doubt to justify the question being submitted to the jury, a peremptory instruction withdrawing the case from the jury is error, and the case will be reversed and remanded.[125]

The question of invention is a question of fact, of which the jury are the proper triers, and the judicial withdrawal of this question from the jury's determination should occur only in an extreme case. But the presumption of validity created by the grant of the patent does not necessarily require the submission of the question of invention to the jury.[126]

"The want of invention in a patent is a matter of defense unless the thing for which a patent is claimed shows on its face that it is without invention."[127]

123. Slawson v. Grand St. R. R. Co., 107 U. S. 649, 27 L. Ed. 576; May v. Juneau, 137 U. S. 408, 34 L. Ed. 729.

124. Market Street Ry. Co. v. Rowley, 155 U. S. 621, 39 L. Ed. 284.

125. Keyes v. Grant, 118 U. S. 25, 30 L. Ed. 54.

126. Look v. Smith., 148 Fed. Rep. 12, 78 C. C. A. 180.

127. Knowles, J., in Hunt Bros. Packing Co. v. Cassidy, 53 Fed. Rep. 257, 260, 3 C. C. A. 52[illegible].

Defense of want of invention—how pleaded.

"Want of invention appearing on the face of the patent may be taken advantage of under the general issue without notice, or under any other plea, or without any plea."[128] "The question as to whether, considering the previous state of the art, no invention was made by the patentee, may be raised without notice. * * * The question of anticipation cannot be raised without notice specifying the anticipating invention."[129]

§ 338. Second defense—That the patent in suit is void as claiming a principle.

In the leading case the 8th claim of the reissued patent of June 13, 1848, to Samuel F. B. Morse read as follows:

> "I do not propose to limit myself to the specific machinery or parts of machinery described in the foregoing specification and claims; the essence of my invention being the use of the motive power of the electric or galvanic current, which I call electromagnetism, however developed, for marking or printing intelligible characters, signs or letters, at any distance, being a new application of that power of which I claim to be the first inventor or discoverer."

Of this claim, Mr. Chief Justice Taney wrote as follows:

> "It is impossible to misunderstand the extent of this claim. He claims the exclusive right to every improvement where the motive power is the electric

128. Townsend, J., in Brickill v. City of Hartford, 57 Fed. Rep. 216, 217; citing, Hendy v. Golden State & Miners' Iron Works, 127 U. S. 370, 32 L. Ed. 207; Dunbar v. Myers, 94 U. S. 187, 24 L. Ed. 34; Brown v. Piper, 91 U. S. 37, 23 L. Ed. 200; Slawson v. Grand Street, etc., R. R. Co., 107 U. S. 649, 27 L. Ed. 576.

129. Knowles, J., in Hunt Bros. Packing Co. v. Cassidy, 53 Fed. Rep. 257, 259, 3 C. C. A. 252.

or galvanic current, and the result is the marking or printing intelligible characters, signs or letters at a distance.

"If this claim can be maintained, it matters not by what process of machinery the result is accomplished. For aught that we now know some future inventor, in the onward march of science, may discover a mode of writing or printing at a distance by means of the electric or galvanic current, without using any part of the process or combination set forth in the plaintiff's specification. His invention may be less complicated—less liable to get out of order—less expensive in construction, and in its operation. But yet if it is covered by this patent the inventor could not use it, nor the public have the benefit of it without the permission of this patentee.

"Nor is this all; while he shuts the door against the inventions of other persons, the patentee would be able to avail himself of new discoveries in the properties and powers of electro-magnetism which scientific men might bring to light. For he says he does not confine his claim to the machinery or parts of machinery, which he specifies; but claims for himself a monopoly in its use, however developed, for the purpose of printing at a distance. New discoveries in physical science may enable him to combine it with new agents and new elements, and by that means attain the object in a manner superior to the present process and altogether different from it. And if he can secure the exclusive use by his present patent he may vary it with every new discovery and development of the science, and need place no description of the new manner, process or machinery, upon the records of the Patent Office.

And when his patent expires, the public must apply to him to learn what it is. In fine, he claims an exclusive right to use a manner and process which he has not described and indeed had not invented, and therefore could not describe when he obtained his patent. The court is of opinion that the claim is too broad, and not warranted by law."[130]

This defense can be raised at any stage of the case without being pleaded.

§ 339. Third defense—That the patent in suit is void because claiming a function.

This defense is founded upon the settled rule that "the mere function of a machine is not patentable as a process at all."[131]

This defense need not be specially pleaded.

§ 340. Fourth defense—That the alleged inventor of the patent in suit was not the original and first inventor.

This defense has no relation to the first defense. It concedes that the applicant for the patent in suit may have independently made the invention. But it merely negatives that he was the original and first inventor. It has no relation to the defense specified in the second class of defenses provided by § 4920, R. S. U. S., that the patentee "surreptitiously" obtained the patent. There is no burden upon the complainant in an action at law to prove priority unless the defendant gives notice under § 4920, R. S. U. S.[132]

130. O'Reilly v. Morse, 15 Howard 62, 112, 14 L. Ed. 601, 623. To the same effect, see, Morton v. New York Eye Infirmary, 5 Blatchf. 116, Fed. Case No. 9865.

131. Mr. Justice Brown, in Carnegie Steel Co. v. Cambria Iron Co., 185 U. S. 403, 425, 46 L. Ed. 968, 981. To the same effect, see, Corning v. Burden, 15 Howard 252, 14 L. Ed. 683; Risdon Iron & Locomotive Works v. Medart, 158 U. S. 68, 39 L. Ed. 683.

132. Fay v. Mason, 120 Fed. Rep. 506.

The patent in suit being *prima facie* evidence that the applicant for that patent was the first inventor, the burden of proof under this defense lies with a degree of weight upon the defendant.[133]

This defense must be pleaded, or set up by notice.

Priority as between patentees of the same invention.

The question of priority of invention by another patentee may be raised as a defense in actions at law or in equity. Where the defense of prior patenting by another is proffered, "the decision in interference proceedings is not conclusive on the question of priority of invention." [134]

In determining the defense under consideration, the evidence to be considered has been thus classified by Judge Colt:

"In patented inventions there are several distinct stages of the invention. Some patented inventions comprise only three stages, namely, conception (evidenced by drawings, disclosure, or models), application, patent; while other patented inventions comprise four stages, namely, conception, reduction to practice, application, patent."

"The date of the first class of patented inventions must be either (1), the date of the patent, or (2) the date of the application, or (3) the date of the conception; while the date of the second class must be either (1), the date of the patent, or (2) the date of the application, or (3) the date of the reduction to practice, or (4) the date of the conception."

133. Smith v. Goodyear Dental Vulcanite Co., 93 U. S. 486, 23 L. Ed. 952; Cammeyer v. Newton, 94 U. S. 225, 24 L. Ed. 72.

134. Colt, J., in Automatic Weighing Mach. Co. v. Pneumatic Scale Corp., 166 Fed. Rep. 288, 291, 92 C. C. A. 206.

"Where two patents for the same invention have been issued to independent inventors, we understand the rule to be that the dates of their respective inventions are, first, the dates of the patents; second, the dates of the applications, provided the application sufficiently describes the invention; third, the dates of actual reduction to practice; fourth, the dates of conception; with this qualification, that, if either patentee seeks to carry the date of his invention back to the date of his conception, he must show reasonable diligence in adapting and perfecting his invention, either by actual reduction to practice or by filing his application."[135]

§ 341. Fifth defense—Want of novelty, because of prior public use.

The issuance of the patent in suit is *prima facie* evidence that its claimed subject-matter was not in public use or on sale for more than two years prior to the filing of the application on which it was issued.[136]

It has been held that mere knowledge of the alleged anticipating device will not suffice to establish this defense, but there must be both knowledge and use.[137]

A single sale is sufficient evidence of prior public use,[138] and prior use of articles as samples will also suffice to establish this defense.[139]

135. Automatic Weighing Mach. Co. v. Pneumatic Scale Corp., 166 Fed. Rep. 288, 291, 92 C. C. A. 206.

136. Mast, Foos & Co. v. Dempster Mill Mfg. Co., 82 Fed. Rep. 327, 27 C. C. A. 191.

137. Tatum v. Eby, 60 Fed. Rep. 408, 409.

138. Consolidated Fruit Jar Co. v. Wright, 94 U. S. 92, 24 L. Ed. 68; Egbert v. Lippmann, 104 U. S. 333, 26 L. Ed. 755; Hall v. MacNeale, 107 U. S. 90, 27 L. Ed. 367; Smith & Griggs Mfg. Co. v. Sprague, 123 U. S. 249, 31 L. Ed. 141; Delemater v. Heath, 58 Fed. Rep. 414, 7 C. C. A. 279; National Cash Register Co. v. American Cash Register Co. (C. C. A.), 178 Fed. Rep. 79, 82.

139. Dalby v. Lynes, 64 Fed. Rep. 376.

This defense must be established by proof beyond a reasonable doubt.[140] But the character of the proof will largely depend upon the nature of the thing sought to be anticipated. "It requires less testimony to establish a fact which was very likely to have occurred, than to establish an improbable theory."[141]

The establishment by oral testimony of devices in the prior art must usually, to be effective, be accompanied by the production of the structure sought to be proven. Unless so accompanied, it has been characterized as being "always open to suspicion,"[142] and it has been said that such oral testimony "called either for corroboration or for some reason why corroboration was impossible."[143]

But there is no hard and fast rule against the establishment of a prior use by oral testimony alone, and "in this, as in other cases, the weight and effect of testimony must be passed upon, and a conclusion as to the existence of an alleged prior use will be reached if the evidence thereof is clear and satisfactory to the judicial mind."[144] So that a prior use may be established by the oral testimony of unimpeached and disinterested witnesses, though the device itself has passed out of existence,[145] and in rare circumstances, by the unsupported testimony of one witness alone.[146]

140. Barbed Wire Patent, 143 U. S. 284, 36 L. Ed. 154.

141. Shipman, J., in Lee v. Upson & Hart Co., 43 Fed. Rep. 670, 671.

142. National Hollow Brake-Beam Co. v. Interchangeable Brake-Beam Co., 106 Fed. Rep. 693, 45 C. C. A. 544; Mast, Foos & Co. v. Dempster, 82 Fed. Rep. 327, 27 C. C. A. 191.

143. Westinghouse Elec. & Mfg. Co. v. Catskill Illuminating & Power Co., 121 Fed. Rep. 831, 833, 58 C. C. A. 167.

144. Sipp Elec. Mach. Co. v. Atwood-Morrison Co., 142 Fed. Rep. 149, 154, 73 C. C. A. 367.

145. American Roll Paper Co. v. Weston, 59 Fed. Rep. 147, 150, 8 C. C. A. 56.

146. National Casket Co. v. Stolts, 157 Fed. Rep. 392, 393, 85 C. C. A. 300.

It is obvious, however, that to prove by oral testimony the existence of a certain machine or process, manufacture or design is one thing, and to prove what its precise structure was, is quite another and a much more difficult undertaking, whose difficulty increases in proportion to the complexity and intricacy of the nature of the thing sought to be proven. Judge Coxe recognized this condition when, in considering with such testimony, he said, "if we were dealing with a complicated machine or an abstruse and difficult process there would be reason to say that persons unskilled in the art might easily be mistaken in describing minute details."[147]

We may here consider the importance of the notice in connection with this defense. If not set up by pleading or notice, testimony of witnesses to prior use is inadmissible.[148] The notice must give the name and place of residence of the person alleged to have had prior knowledge and use, and the place where the use occurred.[149] The street address of the person should be given if he has one.[150] The notice must be served thirty days before the hearing.[151] The notice need not recite the names of the witnesses called to testify that the person named in the notice had such prior knowledge or use.[152] The notice of prior knowledge or use must allege that such prior knowledge or use was of a date more than two years prior to the application.[153]

147. Rochester Coach Lace Co. v. Schaefer, 46 Fed. Rep. 190, 193.

148. Philadelphia & T. Railroad v. Stimpson, 14 Peters 448, 10 L. Ed. 535; O'Reilly v. Morse, 15 How. 62, 14 L. Ed. 601.

149. Silsby v. Foote, 14 How. 218, 14 L. Ed. 394.

150. Wise v. Allis, 76 U. S. 737, 19 L. Ed. 784.

151. Seymour v. Osborne, 78 U. S. 516, 20 L. Ed. 33.

152. Roemer v. Simon, 95 U. S. 214, 24 L. Ed. 384; Woodbury Patent Planing Mach. Co. v. Keith, 101 U. S. 479, 25 L. Ed. 939.

153. Agawam Woolen Co. v. Jordan, 7 Wall. 583, 19 L. Ed. 177; Bates v. Coe, 98 U. S. 31, 25 L. Ed. 68.

§ 342. Sixth defense—Want of novelty because of prior patenting.

This defense is substantiated by the introduction of properly authenticated copies of the patents alleged to anticipate the patent in suit; the defense must be pleaded specifically, by the dates and numbers of the patents relied upon, otherwise prior patents will only be admitted and considered to establish the state of the art, and to construe or limit the claims involved.[154]

It is proper to here note that the distinction between "anticipation," and "want of invention in view of the prior art" is exceedingly microscopic. What practical difference is there between introducing a prior patent, under pleading or notice, as anticipatory, and introducing the same patent, without notice,[155] to show the state of the art? If, in fact, the patent so offered does anticipate, the court will hold the patent in suit void for want of invention. The practical benefit to be drawn from this observation is, that in the trial of actions at law, the astute practitioner frequently may withhold his closest anticipating patent from his notice or pleading, offer it on the trial to "show the state of the art" without having given the plaintiff opportunity to prepare an attack upon it, or the plaintiff's expert opportunity to study it in advance of the trial. Under the decisions this course is entirely warranted and has often proved effective.

It is usually stipulated in the course of actions for infringement that printed uncertified copies of patents may be used instead of the originals or certified copies.

154. Brown v. Piper, 91 U. S. 41, 23 L. Ed. 200; Grier v. Wilt, 120 U. S. 412, 30 L. Ed. 712; Jones v. Cyphers, 115 Fed. Rep. 324.

155. Notice is unnecessary where patents are offered to show the state of the art. Brown v. Piper, 91 U. S. 37, 23 L. Ed. 200; Dunbar v. Myers, 94 U. S. 187, 24 L. Ed. 34.

Section 892, R. S. U. S., provides for the issuance of certified copies of papers, records, books, or drawings by the Patent Office. Section 894, R. S. U. S., provides for the introduction in evidence of the printed copies of specifications and drawings of patents which are gratuitously issued and deposited in the capitols of the States and Territories and with the clerks of the District Courts. Copies certified by the Acting Commissioner are sufficiently authenticated.[156]

Foreign Letters Patent may be proven by certified copies attested by the authorities of the Patent Office of the country from which the patent issued, under § 893, R. S. U. S.[157]

§ 343. Seventh defense—Want of novelty because of prior publication.

This defense must be pleaded, by notice or otherwise.

It has been held that a circular to the trade is not a printed publication within the meaning of the patent law.[158]

The proper method of introducing a publication is to introduce the entire volume. An extract from a book, certified by the Commissioner of Patents to be a true copy from a book in the library of the Patent Office, received on a certain day, is admissible in evidence.[159] Where the entire publication is introduced, bearing a date imprint, and purporting to be printed

156. Woodworth v. Hall, 1 Woodb. & M. 248, Fed. Case No. 18,016.

157. Schoerken v. Swift & Courtney & Beecher Co., 7 Fed. Rep. 469, 471.

158. Parsons v. Colgate, 16 Fed. Rep. 600, 602; In re Attebury, 9 Off. Gaz. 640; Judson v. Cope, 16 Fisher 615, Fed. Case No. 7565; Reeves v. Keystone Bridge Co., 5 Fisher 456, Fed. Case No. 11,660; New Process Fermentation Co. v. Koch, 21 Fed. Rep. 580, 587; Seymour v. Osborne, 78 U. S. 516, 20 L. Ed. 33; Britton v. White Mfg. Co., 61 Fed. Rep. 93, 95.

159. Travers v. American Cordage Co., 64 Fed. Rep. 771, 773.

for general circulation, the date so imprinted is *prima facie* evidence of the date of the publication, and the publication is admissible.[160]

The general rule seems to be that the publication must have been actually published, or intended, for general use, or accessible to the public.[161]

In the case of a large book, exact reference to it should be made, in the notice or answer, by page, chapter, or section reference.[162]

The effect of drawings or sketches alone, unaccompanied by written description.

As early as 1860, in the trial of an action at law for patent infringement, Judge Leavitt refused to receive in evidence plates or drawings without any printed description, saying "I should hesitate very much to accept a mere drawing, unaccompanied by any description whatever."[163]

Other rulings are as follows:

"It has been frequently held that drawings alone, unaccompanied by letter-press description, will never invalidate a patent."[164]

"A rude pencil sketch of an apparatus, never made and carried into practical use, is not sufficient to defeat the complainant's patent."[165]

"The defendants exhibit a drawing made by J. D. Renchard which bears date August 10, 1876, and which, it is testified by him, was made on that day, and by

160. Britton v. White Mfg. Co., 61 Fed. Rep. 93, 95.

161. Britton v. White Mfg. Co., 61 Fed. Rep. 93, 95.

162. Silsby v. Foote, 14 How. 218, 219, 14 L. Ed. 394.

163. Judson v. Cope, Fed. Case No. 7565. 1 Fisher 615.

164. Brown, J., in New Process Fermentation Co. v. Koch, 21 Fed. Rep. 580, 587.

165. Gresham, J., in Uhlmann v. Bartholomae & Leicht Brewing Co., 41 Fed. Rep. 132, 138.

others, that he showed it to them about that time. This antedates Parshall's application, but it fails to supersede his patent for the reason that it seems well-established in evidence that Renchard did not at that time prosecute the matter beyond the mere drawing. The drawing seems to exhibit a perfect machine in all its parts, * * *. Nevertheless, it is clearly proven that the defendant did not, in fact, construct an indicator in this form, and reduce it to actual use, until after it had been successfully accomplished by Parshall, nor until after the date of his patent. This mere drawing, therefore, cannot be allowed to have the effect of depriving Parshall of his title of being the first and original inventor." [166]

"To constitute such a prior invention as will avoid a patent that has been granted, it must be made to appear that some one before the patentee, not only conceived the idea of doing what the patentee has done, but also reduced his idea to practice, and embodied it in some practical and useful form. The idea must have been carried into practical operation. The making of drawings of conceived ideas is not such an embodiment of such conceived ideas in a practical and useful form, as will defeat a patent which has been granted." [167]

"It has been held in many cases that drawings, much more complete than the one here testified to, are not reductions to practice, as against a subsequent conceiver who first made an actual, operative machine." [168]

166. Mr. Justice Matthews on Circuit, in Detroit Lubricator Mfg. Co. v. Renchard, 9 Fed. Rep. 293, 297.

167. Ingersoll, J., in Ellithorp v. Robertson, Fed. Case No. 4408, 4 Blatchf. 307.

168. Taft, J., in Christie v. Seybold, 55 Fed. Rep. 69, 77, 5 C. C. A. 33; to the same effect, see, Pennsylvania Diamond Drill Co. v. Simpson, 29 Fed. Rep. 288, 290; Odell v. Stout, 22 Fed. Rep. 159, 165.

In the case of a design patent the foregoing reasons do not apply, and the anticipation may be effected by drawings alone.[169]

§ 344. Eighth defense—That the combination claims sued upon are void because they are mere aggregations.

We have considered the doctrine of aggregation elsewhere. It is one by which the validity of any combination may be tested. Briefly, this defense may be raised in cases involving articles of manufacture,[170] machines,[171] or processes,[172] although the defense, *eo nomine*, is seldom made in process cases. It need not be pleaded.

The difficulty inherent in this defense is that, like invention, aggregation cannot be tested by any exact rule. When the case is the simple one of a combination tool, like the rubber-tipped pencil of Reckendorfer v. Faber (92 U. S. 347, 23 L. Ed 719), where there is no pretense or possibility of any two of its elements operating simultaneously, or in any way affecting the operation of each other, the defense is clearly maintainable. But few cases possess such simplicity, and the complicated mechanical combinations of modern automatic machinery are invariably attacked by this defense, but seldom successfully. The earlier cases developed a degree of obscurity of language which did much to involve the question of aggregation in mystery; a typical example of this verbal befogging being to the credit of Mr. Justice Matthews.

169. Untermeyer v. Freund, 58 Fed. Rep. 205, 7 C. C. A. 183; Britton v. White Mfg. Co., 61 Fed. Rep. 93, 96.

170. Hill v. Wooster, 132 U. S. 693, 33 L. Ed. 502; Campbell v. Bayley, 63 Fed. Rep. 463, 11 C. C. A. 284; Antisdel v. Chicago Hotel Cabinet Co., 89 Fed. Rep. 308, 312, 32 C. C. A. 216.

171. Overweight Counterbalance Elevator Co. v. Henry Vogt Mach. Co., 102 Fed. Rep. 957, 43 C. C. A. 80.

172. In re Mond, 16 App. D. C. 351, 91 Off. Gaz. 1437; Reckendorfer v. Faber, 92 U. S. 347, 23 L. Ed. 719.

His dictum was: "In a patentable combination of old elements, all the constituents must so enter into it as that each qualifies every other; to draw an illustration from another branch of the law, they must be joint tenants of the domain of 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-operating action of all the elements, and which is not the mere adding together of separate contributions."[173]

This paragraph has been interpreted by Judge Dallas as follows: "Some of the language used by Mr. Justice Matthews in delivering the opinion of the Supreme Court in Pickering v. McCullough, 104 U. S. 310, has been pressed upon our attention, as indicating, it is claimed, that in a patentable combination of old elements all the constituents must so enter into it that each changes the mode of action of every other, and that each element must not merely perform its own part in the combination, but must also, in some way, be directly and immediately concerned in the performance of their respective parts by every other of the elements. No such doctrine as is thus claimed to be deducible from the opinion in Pickering v. McCullough appears to have been essential to the judgment in that case, nor do we think it necessary to attribute to the particular language referred to (104 U. S. 318) the meaning ascribed to it by counsel. If, instead of an extract, the whole opinion be read, in connection with the authorities which are cited in it, it may be readily perceived that the substance of the doctrine intended to be affirmed is that a combination, to be patentable, must produce a new and useful result, as the

173. Pickering v. McCullough, 104 U. S. 310, 26 L. Ed. 749.

product of the combination, and not a mere aggregate of several results, each the complete result of one of the combined elements. There must be a new result produced by their union. That Campbell's invention was of a combination, as thus defined, we entertain no doubt; and that Mr. Justice Matthews should be understood as holding that no combination is patentable which does not fulfill the requirement which appellee's counsel insists is requisite, we cannot suppose. If it were essential to a valid patent for any combination whatever that the mode of action of every element included in the combination should be changed by each of the others, it would have been impossible to sustain several combination patents which have in fact been upheld, as, indeed, it would be difficult to conceive of any mechanical combination which would be both possible and patentable."[174]

Yet, after consideration of all that has been quoted, it is very clear that in the best of combinations the result attained is merely "the adding together of the separate contributions" of the individual elements, and Mr. Justice (then Judge) McKenna pointed out this fact. The Supreme Court had adopted as an illustration in Reckendorfer v. Faber (92 U. S. 347, 23 L. Ed. 719) a sawmill, having a frame which advances the log to meet the saw, in combination with the saw. Judge McKenna said, "the moving frame performed, of itself, no other office than moving frames do. The saw performed no other office than saws do; but, each performing its particular function, they together 'sawed through the log.'"[175]

In this he is supported by the language of Judge Acheson, who said, "it is sufficient if all the devices co-

174. National Cash Register Co. v. American Cash Register Co., 53 Fed. Rep. 367, 371, 3 C. C. A. 559.

175. Bowers v. Von Schmidt, 63 Fed. Rep. 572, 583.

operate with respect to the work to be done, and in furtherance thereof, although each device may perform its particular function only."[176]

§ 345. Ninth defense—That the invention of the patent in suit was the joint invention of the sole applicant with another, or the sole invention of one of the joint applicants.

The defense cannot be raised by the general issue, but must be specially pleaded.[177]

A joint patent cannot be sustained where the subject-matter was the sole invention of one of its patentees,[178] but it must be made clearly to appear that the patentees are not joint inventors before a court is justified in annulling a patent on that ground.[179]

"The defense that complainants are not joint inventors is so purely formal in character that it cannot be regarded with favor, unless it be shown that the action of the patentees in this regard was disingenuous, or calculated to mislead the defendants."[180]

The courts have defined the act of joint invention as follows:

"When a claim covers a series of steps or a number of elements in a combination, the invention may well be joint, though some of the steps or some of the elements may have come as the thought of but one."[181] "If the circumstances are such as to show that two persons both contributed to an improvement, and such improvement

176. Stutz v. Armstrong, 20 Fed Rep. 847.

177. Butler v. Bainbridge, 29 Fed. Rep. 142, 143. "Improper joinder (of applicants for patent) is a purely technical defense, and should not be favored, especially after the patent is assigned." Sanborn, J., in Sieber & Trussell Mfg. Co. v. Chicago Binder & File Co., 177 Fed. Rep. 439.

178. Henlings v. Reid, 58 Fed. Rep. 868; Welsbach Light Co. v. Columbia Incandescent Gaslight Co., 100 Fed. Rep. 648, 650.

179. Worden v. Fisher, 11 Fed. Rep. 505.

180. Coxe, J., in Butler v. Bainbridge, 29 Fed. Rep. 142, 143.

181. Lurton, J., in Quincy Mining Co. v. Krause, 151 Fed. Rep. 1014, 1017.

is the result of mutual contributions of the two, they are to be treated as joint inventors and a joint patent should be taken out."[182]

§ 346. Tenth defense—That for the purpose of deceiving the public the description and specification filed by the patentee in the Patent Office was made to contain less than the whole truth relative to his invention or discovery, or more than is necessary to produce the desired effect.

This defense may be made by special plea, or by notice under the general issue.

"According to the well-known rules of equity pleading, when it is intended to set up fraud or subterfuge, the allegations must point out specifically the details thereof."[183]

"It is seldom that a patent has been overthrown under this provision (of § 4920, R. S. U. S.). It is not sufficient that the specification contains less than the whole truth, but the omission must have been made with intent to deceive the public."[184]

But where the patentee admits, or it is proven, that he had knowledge of elements that were necessary to the practical operation of his invention, which he omitted from his specification, this defense will prevail.[185]

The application of this rule may result, if a celebrated dictum of Mr. Justice Bradley is literally interpreted and applied, in destroying an entire patent, if it can be

182. Brown, J., in Worden v. Fisher, 11 Fed. Rep. 505.

183. Putnam, J., in American Sulphite Pulp Co. v. Howland Falls Pulp Co., 70 Fed. Rep. 986, 992.

184. Coxe, J., in Celluloid Mfg. Co. v. Russell, 37 Fed. Rep. 676, 679.

185. Electric Boot & Shoe Fishing Co. v. Little, 75 Fed. Rep. 276.

established that but one of the claims falls within the condemnation of the rule. He said "one void claim * * * does not vitiate the entire patent, if made by mistake or inadvertence and without any wilful default or intent to defraud or mislead the public." [186]

In accordance with the doctrine that actual intent must be shown, the unauthorized acts of a solicitor cannot vitiate the patent, under this defense. The following apt illustration is worth consideration:

"It appears that the specification as originally filed called for 'nitrite' of sodium, and not 'nitrate', and gave specific directions in paragraph four to diazotize a second time. Defendant contends that the variance of these respects between the specification as filed and as finally amended cannot be claimed to be inadvertence, but, on the contrary, was a distinct and intentional change, and that the court should find that the patentee, for the purpose of deceiving the public, caused his specification to contain less than the whole truth relative to his invention or discovery, and should therefore hold the patent absolutely and *ab initio* void. Simpson v. Holliday, 13 Wkly. Rep. 577. The applicants for this patent were in Europe and their solicitor here evidently knew little, if anything, about the chemistry of azo products; and there is nothing in the record to suggest that the changes which the solicitor made were due to anything except his own ignorance, or that he had any intent to mislead or to conceal. It is not doubted that an applicant is bound by the acts of his solicitor, but this contention seems to go beyond this wholesome rule when it seeks to void a patent, upon the theory of a fraudulent concealment or fraudulent misrepresentation, because, through the solicitor's ignorance, the specifications, when describing the

186. Carlton v. Bokee, 84 U. S. (17 Wall.) 463, 21 L. Ed. 517.

process of manufacture, contain some immaterial error or omission, which could not mislead a person skilled in the art."[187]

§ 347. Eleventh defense—That the patent in suit is void because of the abandonment of the invention to the public by the applicant prior to the filing of his application.

This defense may be raised by notice under the general issue, or under a special plea; in some cases it may be availed of without being pleaded.[188]

This defense has no relation to the limitation of two years' public use named in the statute.

"An abandonment of an invention to the public may be evinced by the conduct of the inventor at any time, even within the two years named in the law. The effect of the law is that no such consequence will necessarily follow from the invention being in public use or on sale, with the inventor's consent and allowance, at any time within two years before his application; but that, if the invention is in public use or on sale prior to that time, it will be conclusive evidence of abandonment, and the patent will be void."[189]

"There may be an abandonment of an invention to the public, as well after an application has been rejected or withdrawn, as before any application is made. Such abandonment may be proven, either by express declarations of an intention to abandon, or by conduct inconsistent with any other conclusion. An inventor whose application for a patent has been rejected, and who, with-

187. Lacombe, J., in Matheson v. Campbell, 78 Fed. Rep. 910, 913, 24 C. C. A. 284.

188. Curtain Supply Co. v. National Lock Washer Co., 174 Fed. Rep. 45, 49.

189. Mr. Justice Bradley, in Elizabeth v. Nicholson Pavement Co., 97 U. S. 126, 134, 24 L. Ed. 1000, 1004; to the same effect, see, also, Andrews v. Hovey, 123 U. S. 267, 31 L. Ed. 160.

out substantial reason or excuse, omits for many years to take any step to reinstate or renew it, must be held to have acquiesced in its rejection, and to have abandoned any intention of further prosecuting his claim."[190]

The proviso of § 4886, R. S. U. S., that a patent may, on the conditions named, be obtained for an invention, "unless the same is proved to have been abandoned," relates both to actual and to constructive abandonment. This proviso applies to designs as well as other classes of inventions.[191]

Actual abandonment occurs when it is the result of intention.[192] It has been said repeatedly that clear evidence of an intention to dedicate an improvement to the public is indispensable to establish abandonment.[193] This dictum would be true if there were no constructive abandonment of inventions recognized by the law. It must be understood as relating only to attempts to prove actual abandonment by the inventor.

Perhaps no other branch of the law of patents has suffered more from the careless and inaccurate use of language than the subject of abandonment. For example, one very able judge has written: "If it appears that the inventor, after perfecting his invention and applying for a patent, and thereby irretrievably committing himself to the proposition that his invention is ripe for introduction to the public, accepts the decision rejecting his application, and cast aside his invention as of no longer any value to him, he thereby makes it forever

190. Mr. Justice Gray, in United States Rifle & Cartridge Co. v. Whitney Arms Co., 118 U. S. 22, 30 L. Ed. 53.

191. Anderson v. Eiler, 46 Fed. Rep. 777.

192. Mast, Foos & Co. v. Dempster Mill Mfg. Co., 82 Fed. Rep. 327, 27 C. C. A. 191.

193. Ide v. Trorlicht, Duncker & Renard Carpet Co., 115 Fed. Rep. 137, 53 C. C. A. 341.

public property, and it is not in his power to take it back and make it again his own."[194]

What the learned court meant by the words "and cast aside his invention as of no longer any value to him," is incomprehensible. If it means an independent act of actual abandonment, then the abandonment of the application has no bearing on the case. If it means that the applicant "cast aside his invention" by accepting the decision of the Patent Office, it is an absolute misstatement of the law. It has long been settled that the abandonment of the application is not sufficient to constitute proof of abandonment of the invention.[195] It is equally well settled that "after the application has been abandoned, a valid patent for the invention may nevertheless be secured upon a new application, provided the invention has not gone into public use or been upon sale for more than two years prior to the filing of the latter (application)."[196]

§ 348. Twelfth defense—That the claim or claims in suit are void as claiming subject-matter not disclosed in the description.

This defense must be specially pleaded, and the presumption is in favor of the plaintiff. "In the absence of other evidence, the invention of the patent is presumed to be identical with that disclosed by the application."[197]

194. Sage, J., in Consolidated Fruit Jar Co. v. Bellaire Stamping Co., 27 Fed. Rep. 377, 381.

195. Clark v. Scott, 9 Blatchf. 301, Fed. Case No. 2833; Dederick v. Fox, 56 Fed. Rep. 714; Hayes-Young Tie Plate Co. v. St. Louis Transit Co., 137 Fed. Rep. 80, 70 C. C. A. 1.

196. Hayes-Young Tie Plate Co. v. St. Louis Transit Co., 137 Fed. Rep. 80, 82, 70 C. C. A. 1.

197. Lurton, J., in Drewson v. Hartje Paper Mfg. Co., 131 Fed. Rep. 734, 739, 65 C. C. A. 548; citing, Webster Loom Co. v. Higgins, 105 U. S. 580, 26 L. Ed. 1177.

During the pendency of an application, the description may be amended so as to serve as the foundation of claims which would not be sustained by the description as originally filed in the Patent Office. Such new matter must not involve a departure from the original invention, as shown in the drawing (Patent Office Rule 70). But claims not supported by the description and drawing are void.[198]

§ 349. Thirteenth defense—That the description of the patent in suit is not so full, clear, concise and exact as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound or use the same.

This rule is founded on § 4888, R. S. U. S. The question of the sufficiency of the description has been considered fully, elsewhere. The degree of definiteness and fullness required by the statute has been illustrated by many cases.[199] This defense must be pleaded.

The statute provides for the test of sufficiency, that the invention may be constructed and practiced by those skilled in the same or analogous arts, from the disclosure of the patent,[200] hence this defense is one which, while it could technically be raised by demurrer as based on a defect inherent in the patent, in practice must be pleaded, and determined upon the evidence of those skilled in the art or science to which the patent appertains, or with which it is most nearly connected.

What are analogous arts? It is obvious that this question is frequently one of great difficulty. But in this

198. General Electric Co. v. candescent Lamp Patent, 159 U. S. 465, 40 L. Ed. 221. Sangamo Electric Co., 174 Fed. Rep. 246, 251, —— C. C. A. ——.

199. Grant v. Raymond, 31 U. S. (6 Peters) 218, 8 L. Ed. 94; Mitchell v. Tilghman, 86 U. S. (19 Wall.) 287, 22 L. Ed. 125; Howard v. Detroit Stove Works, 150 U. S. 164, 37 L. Ed. 1039; In-

200. Shive v. Keystone Watch Co., 41 Fed. Rep. 434; Webster Loom Co. v. Higgins, 105 U. S. 580, 26 L. Ed. 1177; Lawther v. Hamilton, 124 U. S. 1, 31 L. Ed. 325; Seabury & Johnson v. Am Ende, 152 U. S. 561, 38 L. Ed. 556.

connection it is of small consequence except as it bears upon the qualifications of the expert witnesses called to testify concerning the sufficiency of the disclosure. The object of the statute is clearly to obviate any requirement that the description must be addressed to or understood by the general public. The range of the arts and sciences is too great to make such descriptive writing possible, even if it were desirable.

Who are persons skilled in the arts? What constitutes the "skill" called for by the statute, is a question concerning which the opinion of Sir George Jessel has been quoted by Professor Robinson.[201] It is as follows: "Now what is the meaning of it being a sufficient specification? Upon that there has been a great deal of authority. Judges have stated it in different ways, no doubt, but I do not think there is much difference in substance. In the first place, it is plain that the specification of a patent is not addressed to people who are ignorant of the subject-matter. It is addressed to people who know something about it. If it is a mechanical invention, as this is, you have, first of all, scientific mechanicians of the first class—eminent engineers; then you have scientific mechanicians of the second class—managers of great manufactories, great employers of labor, persons who have studied mechanics—not to the same extent as the first class, the scientific engineers, but still to a great extent—for the purpose of conducting manufactories of complicated and unusual machines, and who therefore must have made the subject a matter of very considerable study; and in this class I should include foremen, being men of superior intelligence, who like their masters would be capable of invention, and like the scientific engineers would be able to find out what was meant even from slight hints, and still more from imperfect descriptions, and would be able to supplement,

201. Robinson, Patents, § 488.

so as to succeed even from a defective description, and even more than that, would be able to correct an erroneous description. That is what I would say of the two first classes, which I will call the scientific classes. The other class consists of the ordinary workman, using that amount of skill and intelligence which is fairly to be expected from him—not a careless man, but a careful man, though not possessing the great scientific knowledge or power of invention which would enable him by himself, unaided, to supplement a defective description or correct an erroneous description. Now, as I understand, to be a good specification it must be intelligible to the third class I have mentioned, and that is the result of the law. It will be a bad specification if the first two classes only understand it, and if the third class do not. I do not think, when the cases come to be examined, there is really any difference between the judges on this point. Their language differs, but I do not think the cases differ."[202]

This distinction between good and bad specifications is purely British. It does not obtain in the American cases. In this country the distinction is merely between "skilled" and "unskilled."[203] In one case it was said that the description "should be so plain under the statute as that an ordinary manufacturer of aniline colors, having such ordinary knowledge as would exist in this country at the date of the patent, should be enabled by the instructions of that patent to carry out successfully its processes."[204]

202. Plimpton v. Malcolmson (1876), L. R. 3, Ch. D. 531, 568.

203. Emerson Co. v. Nimocks, 99 Fed. Rep. 737, 40 C. C. A. 87; Mowry v. Whitney, 14 Wall. 620, 644, 20 L. Ed. 860; Ives v. Hamilton, 92 U. S. 426, 23 L. Ed. 494; Webster Loom Co. v. Higgins, 105 U. S. 580, 26 L. Ed. 1177; Seabury v. Am Ende, 152 U. S. 561, 567, 38 L. Ed. 553; Carnegie Steel Co. v. Cambria Iron Co., 185 U. S. 403. 437, 46 L. Ed. 968.

204. Matheson v. Campbell, 78 Fed. Rep. 910, 914, 24 C. C. A. 284.

Error as to scientific principle immaterial. The erroneous statement of the principle of the subject-matter of the patent will not bring the description within the condemnation of the rule. As stated by Judge Morris, "the scientific principle is not part of the process, is not patentable, and need not be set forth."[205]

Description to be read in the light of knowledge at the date of the patent.

The description's test is as of the date of the patent,[206] and justly so, because the shifting meaning of terms of art and trade terms might otherwise invalidate patents whose descriptions were clear, full and unambiguous when the patent issued. A curious case in point was thus disposed of by Judge Shipman:

"The defendants also make the point that the character of the kind of sheets of celluloid is not sufficiently disclosed by the patent. As there was but one kind of celluloid sheets which could, at the date of the patent, be used for the purpose, and the mechanic had no need of definite instruction, because the 'cut' sheets were obviously the only ones which were, at the time, available, the objection seems to be theoretical rather than real."[207]

Expert testimony in support of this defense.

Where the invention of the patent in suit is actually being practiced, expert testimony as to insufficient description is not favored by the courts.

205. Emerson Co. v. Nimocks, 99 Fed. Rep. 737, 740, 40 C. C. A. 87. To the same effect, see, Eames v. Andrews, 122 U. S. 40, 55, 30 L. Ed. 1064.

206. Matheson v. Campbell, 78 Fed. Rep. 910, 914, 24 C. C. A. 284.

207. Celluloid Mfg. Co. v. American Zylonite Co., 30 Fed. Rep. 437, 440.

"A great deal of testimony was introduced by the defendants, to show that the patentee had failed to describe his invention in such full, clear and exact terms as to enable persons skilled in the art to construct and use it. It seems to us that the attempt has failed. When the question is, whether a thing can be done or not, it is always easy to find persons ready to show how not to do it. But it stands confessed that the thing has been done; that is to say, the contrivance which Webster claims in his patent has been applied and very successfully so, to pile fabric looms and, as the appellants' counsel well remarks, no one except Webster has ever appeared to claim a patent for doing it. If the thing could not be understood without the exercise of inventive power, it is a little strange that it should have been so easily adapted to the looms on which it has been used and produced such striking results."[208]

§ 350. Fourteenth defense—That the claims are not distinct.

This defense is founded on the requirement of § 4888, R. S. U. S., that the inventor "shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery." It need not be pleaded.

In the leading case, Mr. Justice Bradley said: "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 generalizations and ambiguous language to discourage further invention in the same department of industry and to cover antecedent inventions. Without deciding that a repetition of substantially the same claim in different words will vitiate a patent, we hold that

208. Mr. Justice Bradley, in Webster Loom Co. v. Higgins, 105 U. S. 580, 26 L. Ed. 1177-1180.

where a specification by ambiguity and a needless multiplication of nebulous claims is calculated to deceive and mislead the public, the patent is void."[209]

§ 351. Fifteenth defense—That the patentee unreasonably neglected or delayed to enter a disclaimer.

That this defense goes only to the question of costs, and does not affect the merits is well settled.

"The only difficulty connected with the question of the disclaimer in this case arises from the final sentence of section 4917, 'that no such disclaimer shall affect any action pending at the time of its being filed, except so far as may relate to the question of unreasonable neglect or delay in filing it.' There is an unfortunate choice of language here which has rendered this sentence very ambiguous and difficult of construction. It was held by Mr. Justice Story in Read v. Cutter,[210] that if the disclaimer were filed during the pendency of the suit, the plaintiff would not be entitled to the benefit thereof in that suit—a ruling which had also been made in Wyeth v. Stone.[211] It was held in Tuck v. Bramhill,[212] that the provision meant that a suit pending when a disclaimer is filed is not to be affected by such filing, so as to prevent the plaintiff from recovering in it, unless it appears that the plaintiff unreasonably neglected or delayed to file the disclaimer. And such was also the ruling of Mr. Justice Nelson in Guyon v. Serrell;[213] and in Hall v. Wiles.[214] We think that section 4917 ought to be read in connection with section 4922, provided that the patentee may maintain a suit at law or in equity for the infringement of any part of the thing patented, notwith-

209. Carlton v. Bokee, 84 U. S. 463, 473, 21 L. Ed. 519.
210. 1 Story, 590, 600.
211. 1 Story, 273, 294.
212. 6 Blatchf. 95.
213. 1 Blatchf. 244.
214. 2 Blatchf. 194, 198.

standing the specifications may embrace more than that of which the patentee was the first inventor or discoverer; but in every such case in which a judgment or decree shall be rendered for the plaintiff, no costs shall be recovered, unless the proper disclaimer has been entered at the Patent Office before the commencement of the suit. This was practically the construction given to corresponding sections of the Act of 1837 by this court in Smith v. Nichols;[215] and of the Revised Statutes in Dunbar v. Myers.[216] Under section 4922 the effect of delaying a disclaimer until after the commencement of the suit goes only to the recovery of costs. We adhere to that construction. Congress having in the Revised Statutes adopted the language used in the Act of 1837, must be considered to have adopted also the construction given by this court to this sentence, and made it a part of the enactment."[217]

§ 352. Sixteenth defense—That the patent in suit has been repealed.

The subject of repeal is interesting though unimportant. The leading case, Mowry v. Whitney, points out that the method of repealing patents at common law was by *scire facias*, and that this was done in three classes of cases.

"1. When the King by his Letters Patent has by different patents granted the same thing to several persons, the first patentee shall have a *scire facias* to repeal the second.

"2. When the King has granted a thing by false suggestion, he may by *scire facias* repeal his own grant.

215. 88 U. S. (21 Wall.) 112, 22 L. Ed. 566.

216. 94 U. S. 187, 193, 24 L. Ed. 34, 37.

217. Mr. Justice Brown, in Sessions v. Romadka, 145 U. S. 29, 52, 36 L. Ed. 614.

"3. When he has granted that which by law he cannot grant, he *jure regis*, and for the advancement of justice and right, may have a *scire facias* to repeal his own letters patent.

"And the proceeding was usually brought in chancery, in the jurisdiction where the record of the instrument was found."[218]

The same case points out that only the King or his Attorney-General could sue out the writ, except in cases where two patents for the same subject-matter had been issued to different individuals, and that a statutory remedy had been provided in the latter class of cases by the Act of July 4, 1836, § 16. Wherefore it concluded that the proceeding, except in that class of cases, should be brought by the United States, and in its name, or by the authority or permission of the Attorney-General, under such conditions as would enable the Attorney-General to retain "such control of the matter as would enable him to prevent oppression and abuse in the exercise of the right to prosecute such a suit."

While, theoretically, a bill for the repeal of a patent obtained by fraud may be brought in the name of the United States, the practical value of that doctrine has been rendered a minus quantity by one of the Telephone cases.

"Suits may be maintained by the government in its own courts to set aside one of its patents not only when it has a proprietary and pecuniary interest in the result, but also when it is necessary in order to enable it to discharge its obligations to the public, and, sometimes, when the purpose and effect are simply to enforce the rights of an individual. In the former cases it has all the privileges and rights of a sovereign. The statutes

218. Mowry v. Whitney, 81 U. S. (14 Wall.) 434, 20 L. Ed. 858. Cited in Knapp v. Thomas, 39 Ohio St. 386, 45 Am. Rep. 462.

of limitations do not run against it. The laches of its own officials does not debar its right.[219] But when it has no proprietary or pecuniary result in the setting aside of the patent; is not seeking to discharge its obligations to the public; when it has brought the suit simply to help an individual; making itself, as it were, the instrument by which the right of that individual against the patentee can be established, then it becomes subject to the rules governing like suits between private litigants. As said in United States v. Beebe:[220]

"'We are of the opinion that when the government is a mere formal complainant in a suit, not for the purpose of asserting any public right or protecting any public interest, title, or property, but merely to form a conduit through which one private person can conduct litigation against another private person, a court of equity will not be restrained from administering the equities existing between the real parties by any exemption of the government designed for the protection of the rights of the United States alone. The mere use of its name in a suit for the benefit of a private suitor cannot extend its immunity as a sovereign government to said private suitor, whereby he can avoid and escape the scrutiny of a court of equity into the matters pleaded against him by the other party, nor stop the court from examining into and deciding the case according to the principles governing courts of equity in like cases between private litigants.' See, also, United States v. Des Moines Nav. & R. Co.;[221] Curtner v. United States.[222]

219. Citing Van Brocklin v. Tennessee, 117 U. S. 151, 29 L. Ed. 845; United States v. Nashville, C. & St. L. R. Co., 118 U. S. 120, 30 L. Ed. 81; United States v. Ingley, 130 U. S. 263, 32 L. Ed. 968.

220. 127 U. S. 338, 347, 32 L. Ed. 121, 125.

221. 142 U. S. 510, 35 L. Ed. 1099.

222. 149 U. S. 662, 37 L. Ed. 890.

"Now in the case at bar, the United States has no proprietary or pecuniary interest. The result, if favorable, to it, would put no money in its treasury or property in its possession. It has a standing in court either in the discharge of its obligation to protect the public against the monopoly it has wrongfully created, or simply because it owes a duty to other patentees to secure to them the full enjoyment of the rights which it has conferred by its patents to them. Perhaps both of these objects are in view. In so far as the latter was and is the purpose of this suit it brings it within the rule laid down in United States v. Beebe, supra. Doubtless the removal from the public of the burden of a monopoly charged to have been wrongfully created was also one of the objects, and perhaps the principal object. United States v. American Bell Telephone Co.[223] To what extent this may relieve the government as suitor from all the rules governing the suits of private individuals need not be specifically determined here.

"One of the familiar rules of equity, reinforced by statute (U. S. Rev. Stat., § 723) is that 'suits in equity shall not be sustained in either of the courts of the United States in any case where a plain, adequate, and complete remedy may be had at law.' The objection to the validity of this patent on the ground that it was already covered by the patent of 1880 is a defense which, under the statutes (U. S. Rev. Stat., § 4920), is open to every individual charged by the patentee with infringement, whether the proceeding against him be an action at law or a suit in equity. The government, therefore, if seeking simply to protect the right of an individual, ought not to be permitted to maintain a suit in equity to cancel that against which the individual has a perfect

223. 159 U. S. 548, 40 L. Ed. 255.

legal defense available in any action brought by or against him. The query is pressed whether the same rule would not also apply where the government is not only seeking to protect the public at large, for the public is but the aggregation of all individuals, and if each of them has a perfect defense to the patent, so all together have. Again, and as an illustration perhaps of the extent of the rule referred to, it has often been held that while one having the title to and possession of a tract of land can maintain a suit in equity to cancel a deed or other instrument which is a cloud upon the title, such suit cannot be sustained if the deed or instrument is void upon its face, its invalidity resting upon matters of record, and not affected by any lapse of time or statute of limitations. In other words, the deed or instrument is not considered a cloud if it can never be used to destroy his title or disturb his possession. The objection to this patent on the ground stated is an objection resting upon matters of record—of record in the Patent Office; not dependent on oral testimony nor subject to change, and in no way affected by lapse of time. Within the scope of this specific application of the general rule it would seem that equity has no jurisdiction, either at the suit of the government or of an individual, to formally cancel that which by record and unfailing evidence is, as claimed, absolutely void.

"But, further, Congress has established the Patent Office, and thereby created a tribunal to pass upon all questions of novelty and utility. It has given to that office exclusive jurisdiction in the first instance, and has specifically provided under what circumstances its decisions may be reviewed, either collaterally or by appeal. As said in Butterworth v. United States:[224] 'That it

224. 112 U. S. 50, 67, 28 L. Ed. 656, 662.

was intended that the Commissioner of Patents, in issuing or withholding patents, in reissues, interferences and extensions, should exercise quasi-judicial functions, is apparent from the nature of the examinations and decisions he is required to make, and the modes provided by law, according to which, exclusively, they may be reviewed.'

"U. S. Rev. Stat., §§ 4911, 4914 grant appeals in certain cases to the Supreme Court of the District of Columbia. It is true those sections do not authorize appeals on behalf of the government, but the failure so to do may be evidence that Congress thought the government ought not to interfere, and because it believed it had made ample provision for securing the rights of all without the intervention of the government. U. S. Rev. Stat., § 4915, authorized a suit in equity on behalf of an applicant for a patent whose application has been refused. Morgan v. Daniels,[225] presented a controversy under that section, and in the opinion on page 124, we said: 'It is a controversy between two individuals over a question of fact which has once been settled by a special tribunal, intrusted with full power in the premises. As such it might be well argued, were it not for the terms of this statute, that the decision of the Patent Office was a finality upon every matter of fact.'

"It is true that all these sections refer to proceedings between individuals, but the government is as much bound by the laws of Congress as an individual, and when Congress has created a tribunal to which it has given exclusive determination in the first instance of certain questions of fact and has specifically provided under what circumstances that determination may be reviewed by the courts, the argument is a forcible one that such

225. 153 U. S. 120, 38 L. Ed. 657.

determination should be held conclusive upon the government, subject to the same limitations as apply in suits between individuals.

"There is nothing in United States v. American Bell Telephone Co.,[226] and United States v. American Bell Telephone Co.,[227] to conflict with the views above expressed. In the former case the question presented was whether the government could maintain a bill to set aside a patent for an invention on the ground of fraud in its issue, and among the objections urged was the fact that Congress has, in U. S. Rev. Stat., § 4920, made specific provision for certain defenses in suits by an infringer. It was held that the government could maintain such a bill, and that these special statutory provisions did not defeat its right, the court summing up the discussion in these words (p. 373): 'The argument need not be further extended. There is nothing in these provisions expressing an intention of limiting the power of the government of the United States to get rid of a patent obtained from it by fraud and deceit. And although the Legislature may have given to private individuals a more limited form of relief, by way of defense to an action of the patentee, we think the argument that this was intended to supersede the affirmative relief to which the United States is entitled, to obtain a cancellation or vacation of an instrument obtained from it by fraud, an instrument which affects the whole public whose protection from such a fraud is eminently the duty of the United States, is not sound.'

"In the latter case which is the one now before us, there was decided a motion to dismiss for want of jurisdiction in this court of an appeal from the decision of the court of appeals, and it was adjudged that this court

226. 128 U. S. 315, 32 L. Ed. 450.

227. 159 U. S. 548, 40 L. Ed. 255.

had jurisdiction. It is true, at the close of the opinion is found this general statement as to the power to maintain such a suit (p. 555): 'In United States v. American Bell Telephone Co., supra, it was decided that where a patent for a grant of any kind issued by the United States has been obtained by fraud, by mistake, or by accident, a suit by the United States against the patentee is the proper remedy for relief, and that in this country, where there is no kingly prerogative, but where patents for lands and inventions are issued by the authority of the government, and by officers appointed for that purpose, who may have been imposed upon by fraud or deceit, or may have erred as to their power, or made mistakes in the instrument itself, the appropriate remedy is by proceedings by the United States against the patentee.'

"But while there was thus rightfully affirmed the power of the government to proceed by suit in equity against one who had wrongfully obtained a patent for land or for an invention, there was no attempt to define the character of the fraud, or deceit, or mistake, or the extent of the error as to power which must be established before a decree could be entered canceling the patent. It was not affirmed that the proof of any fraud, or deceit, or the existence of any error on the part of the officers as to the extent of their power, or that any mistake in the instrument was sufficient to justify a decree of cancellation. Least of all was it intended to be affirmed that the courts of the United States, sitting as courts of equity, could entertain jurisdiction of a suit by the United States to set aside a patent for an invention on the mere ground of error of judgment on the part of the patent officials. That would be an attempt on the part of the courts in collateral attack to exercise an appellate jurisdiction over the decisions of the Patent Office, although no appellate jurisdiction has been by the

statutes conferred. We are of opinion, therefore, that the question, as stated, is not open for consideration in this case."[228]

It is settled that a patent, once issued, has passed beyond the control and jurisdiction of the Patent Office, and is not subject to be revoked or cancelled by the President or any other officer of the government.[229]

§ 353. Seventeenth defense—That the patent in suit has expired.

This defense applies to cases where the patent in suit has expired either by the terms of its grant, or, when it was so provided by statute, where its life has been terminated by the expiration of a foreign patent for the same invention. The decisions relating to the effect of the expiration of such foreign patents have been reviewed elsewhere in this book. Where the defense was based upon the expiration of the foreign patent, the term indicated in the grant of such foreign patent was held to establish its duration, in the absence of proof that it had been extended.[230] Expert testimony might be introduced upon the question of identity between the foreign and domestic patents,[231] but in the absence of such testimony identity was determinable upon an inspection and comparison of the patents by the court.[232] When the defense is based upon this ground it must be raised by plea or answer.

Where the patent in suit has expired according to its own terms, that fact is no bar to the bringing of an ac-

228. Mr. Justice Brewer, in United States v. American Bell Telephone Co., 167 U. S. 224-264, 42 L. Ed. 144, 163.

229. McCormick Harvesting Mach. Co. v. C. Aultman Co., 169 U. S. 606, 608, 42 L. Ed. 875, 876; United States ex rel. McBride v. Schurz, 102 U. S. 378, 25 L. Ed. 167.

230. Edison Electric Light Co. v. Electric Engineering & Supply Co., 60 Fed. Rep. 401; Bonsack Mach. Co. v. Smith, 70 Fed. Rep. 383.

231. Bischoff v. Wethered, 76 U. S. (9 Wall.) 812, 19 L. Ed. 829.

232. De Florez v. Raynolds, 8 Fed. Rep. 434.

tion at law, if brought within six years of the expiration of the patent and of the commission of the act of infringement. But a suit in equity will not ordinarily lie for the infringement of an expired patent, as the relief by way of accounting is merely ancillary to the administration of other relief.[233]

The jurisdiction over the suit in equity is fixed when the bill is filed during the life of the patent, and the expiration of the patent after the filing of the bill will not terminate its jurisdiction.[234] But where the bill in equity is filed a short time before the expiration of the patent the courts are inclined to hold that the remedy at law is sufficient and that the bill should be dismissed without prejudice to the right of the complainant to bring an action at law for damages.[235] It has been held under such circumstances that the bill is demurrable,[236] and a bill in equity filed after the expiration of the patent, and not brought in aid of a suit at law is demurrable.[237]

Where the court of equity retains jurisdiction of the suit for infringement after the expiration of the patent in suit it does so for the purpose of administering incidental relief by way of damages, profits or otherwise.[238] Where a complainant's patent is sustained on final hear-

233. Root v. Lake Shore and M. S. R. Co., 105 U. S. 189, 26 L. Ed. 975.

234. Brooks v. Miller, 28 Fed. Rep. 615; Clark v. Wooster, 119 U. S. 322, 30 L. Ed. 392; Beedle v. Bennett, 122 U. S. 71, 30 L. Ed. 1074.

235. Racine Seeder Co. v. Joliet Wire Check Rower Co., 27 Fed. Rep. 367.

236. American Cable Ry. Co. v. Chicago City Ry. Co., 41 Fed. Rep. 522; Bragg Mfg. Co. v. City of Hartford, 56 Fed. Rep. 292.

237. Consolidated Safety Valve Co. v. Ashton Valve Co., 26 Fed. Rep. 319.

238. Ross v. City of Ft. Wayne, 63 Fed. Rep. 466, 11 C. C. A. 288; Clark v. Wooster, 119 U. S. 322, 30 L. Ed. 392; Beedle v. Bennett, 122 U. S. 71, 30 L. Ed. 1074.

ing, after it has expired pending suit, the defendant's appeal will be dismissed without examination of the merits if it involves only costs, and not an order to account.[239]

§ 354. Eighteenth defense—That the patentee failed to mark articles made and sold by him under the patent in suit with the statutory marking, and failed to give the defendant the alternative statutory notice.

This defense is based upon section 4900, R. S. U. S.

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

The want of notice or marking merely affects the question of the recovery of a money judgment; it does not affect the right to an injunction.[240] Where the failure to mark was urged in opposition to a motion for preliminary injunction, the patent in suit never having been sustained by a court, the defense was disposed of upon the ground that, while the patentee had failed to mark a

239. Elastic Fabrics Co. v. Smith, 100 U. S. 110, 25 L. Ed. 547.

40. Anderson v. Monroe, 55 Fed. Rep. 398, 404; Horn v. Bergner, 68 Fed. Rep. 428, 432.

large number of the patented articles, "a sufficiently large number of them were so marked to give general notice that the ring was patented."[241]

This section applies to design patents.[242]

"The clear meaning of this section is that the patentee or his assignee, if he makes or sells the article patented, cannot recover damages against infringers of the patent, unless he has given notice of his right, either to the whole public by marking his article 'patented,' or to the particular defendants by informing them of his patent and of their infringement of it.

"One of these two things, marking the articles, or notice to the infringer, is made by the statute a prerequisite to the patentee's right to recover damages against them. Each is an affirmative fact, and is something to be done by him. Whether his patented articles have been duly marked or not is a matter peculiarly within his own knowledge; and if they are not duly marked, the statute expressly puts upon him the burden of proving the notice to the infringers, before he can charge them in damages. By the elementary principles of pleading, therefore, the duty of alleging, and the burden of proving, either of these facts is upon the plaintiff."[243]

The rule formerly was that the failure to mark, or give notice, was an affirmative defense which must be set up in the answer, and established by proof.[244] Where the bill failed to allege marking, and the answer was silent concerning it, it has been held that it was open to

241. Acheson, J., in McDowell v. Kurtz, 77 Fed. Rep. 206, 208, 23 C. C. A. 119.

242. Dunlap v. Schofield, 152 U. S. 244, 247, 38 L. Ed. 426, 427.

243. Mr. Justice Gray, in Dunlap v. Schofield, 152 U. S. 244, 247, 38 L. Ed. 426, 427. To the same effect, see, 9 U. S. E. 299.

244. Goodyear v. Allyn, 6 Blatchf. 38, Fed. Case 5555; United States Printing Co. v. American Playing Card Co., 70 Fed. Rep. 50, 53.

the defendant to make this defense as against an attempt to assess damages and profits.[245]

Clearly, the statute has no application to cases where the patentee and his assigns have never made or sold any specimens of the thing patented,[246] and it cannot apply to process patents.[247]

The statute is not complied with unless all of the articles made and sold by the patentee, or his assigns, are marked; it is not sufficient to show that they were so marked "as a rule."[248]

When the marking has been effected as required by the statute, it is immaterial that the infringer had no actual knowledge of the existence of the patent in suit;[249] his knowledge of the patent will be conclusively presumed, unless it is shown that he has failed to mark as required by the statute.[250]

The requirement of this section as to marking cannot be avoided by proof that the marking would so increase the cost that the patentee could make no profit; "the character of the article" is the only exception specified by the statute.[251]

While, in the case of small articles, whose size makes the marking difficult, something must be left to the judgment of the patentee as to whether the mark will be placed on the article, or on the containers in which the article is packed for shipment and sale,[252] the patentee

245. Lowell Mfg. Co. v. Hogg, 70 Fed. Rep. 787.

246. Goodyear v. Allyn, 6 Blatchf. 38, Fed. Case 5555; Ewart v. Baldwin Cycle Chain Co., 91 Fed. Rep. 262.

247. United States Mitis Co. v. Carnegie Steel Co., 89 Fed. Rep. 206; United States Mitis Co. v. Midvale Steel Co., 135 Fed. Rep. 103.

248. Matthews & Willard Mfg. Co. v. National Brass & Iron Works, 71 Fed. Rep. 518.

249. Hogg v. Gimbel, 94 Fed. Rep. 518.

250. Smith v. Stewart, 55 Fed. Rep. 481.

251. Smith v. Walton, 56 Fed. Rep. 499. That the marking may be done on a part of the device not covered by patent, see Dade v. Boorum & Pease Co., 121 Fed. Rep. 135.

252. Sessions v. Romadka, 145 U. S. 29, 36 L. Ed. 609.

exercises that discretion at his peril. Where the patent was on a wooden dish and the marking was done only on the crate containing the dishes, a demurrer to the declaration was sustained because the marking was not so accomplished as to reach the consumer.[253]

It should be remarked that the notice given as the alternative of marking by this section, need not be in writing. A verbal notice given the infringer, a copy of the letters patent being exhibited to him at the same time, has been held to constitute a full compliance with the statute.[254]

§ 355. Nineteenth defense—That the complainant's title is insufficient to enable him to maintain the suit.

This defense merely goes to the failure of the plaintiff or complainant to establish his title. It is incumbent upon him to prove his title unless it is conceded by admissions in the answer. We have discussed elsewhere the various kinds of estates in letters patent. The statutory regulation of assignments of interests in letters patent is as follows:

Section 4898. Every patent or any interest therein shall be assignable in law by an instrument in writing, and the patentee or his assigns or legal representatives may in like manner grant and convey an exclusive right under his patent to the whole or any specified part of the United States. An assignment, grant, or conveyance shall be void as against any subsequent purchaser or mortgagee for a valuable consideration, without notice, unless it is recorded in the Patent Office within three months from the date thereof. If any such assignment, grant, or conveyance of any patent shall be acknowledged before any notary public of the several States or Territories of the District of Columbia, or any Commis-

253. Smith v. Walton, 51 Fed. Rep. 17.

254. New York Pharmical Assn. v. Tilden, 14 Fed. Rep. 740.

sioner of the United States Circuit Court, or before any secretary of legation or consular officer authorized to administer oaths or perform notarial acts under section seventeen hundred and fifty of the Revised Statutes, the certificate of such acknowledgment, under the hand and official seal of such notary or other officer, shall be *prima facie* evidence of the execution of such assignment, grant, or conveyance."

Under this section an assignment need not be under seal.[255] This section does not prohibit the acquisition of an equitable title or interest in a patent by parol.[256] The acknowledgment of an assignment before the notary or other officer designated in the section obviates the necessity of proving the signature.[257]

The section does not prevent an unrecorded assignment from being valid as between the parties.[258]

The question of the ability or disability of the assignor to make the assignment depends upon the laws of the State where it is executed.[259] The operation of this section is confined to patents; the record of an assignment of an unpatented invention does not operate as constructive notice to a purchaser.[260]

§ 356. Twentieth defense—That the alleged infringing acts were done under a license.

A license is always an adequate defense to the charge of infringement, to the extent to which it goes.[261] But

255. Gottfried v. Miller, 104 U. S. 521, 26 L. Ed. 851.

256. Burr v. La Vergne, 102 N. Y. 415.

257. New York Pharmical Assn. v. Tilden, 14 Fed. Rep. 740.

258. Cook v. Sterling Elec. Co., 118 Fed. Rep. 45; Spears v. Willis, 151 N. Y. 443.

259. Fetter v. Newhall, 17 Fed. Rep. 841.

260. Wright v. Randel, 8 Fed. Rep. 591.

261. Aspinwall Mfg. Co. v. Gill, 32 Fed. Rep. 702.

after the rights created by the license have been exhausted, if the defendant continues to make, use or sell, he stands upon the same footing as any other infringer.[262]

Where suit is brought for infringement and the defense of license is interposed, and the existence of the license is denied by the complainant, it is for the court to determine whether, at the time of the acts complained of there was a subsisting license between the parties. If that fact is found in the affirmative, the bill will be dismissed;[263] because "it is undoubtedly the rule that where there appears to be a subsisting license between the complainant and the defendant, the jurisdiction of the court, under the patent law, will not be extended to cover a suit to enforce the terms of the license, or to forfeit the license, on the ground that the terms thereof have been violated."[264]

When it becomes necessary for the court to construe a contract offered in support of the defense of license, that construction will be adopted which gives effect to all its parts and is alike just to both the parties.[265]

A license will never be implied from a settlement for past damages by an infringer. "In case of a license or a sale by the patentee, the rights of the licensee or the vendee arise out of contract with him. In the case of infringement, the liability of infringers arises out of their own wrongful invasion of his rights. The recovery and satisfaction of a judgment for damages against one

262. Aspinwall Mfg. Co. v. Gill, 32 Fed. Rep. 702.

263. White v. Lee, 3 Fed. Rep. 222; Kelly v. Porter, 17 Fed. Rep. 519; Hammacher v. Wilson, 26 Fed. Rep. 239, 240.

264. Carpenter, J., in Hammacher v. Wilson, 26 Fed. Rep. 239, 240; following Hartell v. Tilghman, 99 U. S. 547, 25 L. Ed. 357.

265. Hanifen v. Lupton, 101 Fed. Rep. 462, 465, 41 C. C. A. 462.

wrongdoer do not ordinarily confer, upon him or upon others, the right to continue or repeat the wrong."[266]

A defendant may properly join as defenses averments of invalidity and of license, as he "has the right to set up as many defenses as he may have, providing they are not inconsistent."[267]

§ 357. Twenty-first defense—That the defendant has discharged his liability for the infringement.

This defense may go to the extent of the entire infringement, or only to the extent of a portion of the infringement. If the former, it would seem that it should be specially pleaded; if the latter, it may be shown under the general issue.[268]

Where the release pleaded was made by the complainant, or his predecessor in title, this defense is not attended with difficulty, but where the release has been given by one of the joint owners of the patent its effect is as yet unsettled. In holding that a release from such a source is not a bar to a suit by the other co-owners Judge Lacombe has said: "It is not thought that the execution of an assignment and a release by one of the joint owners destroys the co-owner's right to recover his damages from the defendant. To so hold would be to push the supposed analogy to the law of real property altogether too far. The kind of property which is represented by Letters Patent is peculiar—indeed, *sui generis;* and to apply to it all the rules of the common law as to ownership of land would sometimes lead to ab-

266. Mr. Justice Gray, in Birdsell v. Shallol, 112 U. S. 485, 28 L. Ed. 768; and to the same effect, see, Blake v. Greenwood Cemetery, 16 Fed. Rep. 676; United States Printing Co. v. American Playing Card Co., 70 Fed. Rep. 50; Electric Gas Lighting Co. v. Wollensak, 70 Fed. Rep. 790.

267. Swing, J., in National Mfg. Co. v. Meyers, 7 Fed. Rep. 355, 357.

268. Burdell v. Denig, 92 U. S. (2 Otto) 716, 23 L. Ed. 764.

surdities. Unqualified assent has by no means been given to Judge Curtis' reasoning in Clum v. Brewer,[269] and the scrupulous care with which the Supreme Court has restricted its decisions in Gottfried v. Miller,[270] and the Paper Bag Cases,[271] leaves the question still open, although, in this circuit, where Pitts v. Hall,[272] has laid down a different rule from that adopted by Judge Curtis, the principle of *stare decisis* would seem to require a denial of defendant's motion to dismiss. An interesting discussion of this important and unsettled question will be found in chapter 6 of Hall's Patent Estate, where the arguments on either side, and the entire body of Federal decisions down to 1888, are most tersely and admirably set forth. Upon the precise question now presented, viz., the power of one co-owner to destroy the other's accrued right to damages, the opinion of Romilly, M. R., cited on complainants' brief (In re Horsley & Knighton's Patent, L. R. 8 Eq. 475), seems to characterize the proposition quite correctly as 'a violation of the fundamental principles of law, and contrary to natural justice.' "[273]

§ 358. Twenty-second defense—Non-infringement.

Where the validity of the patent in suit is admitted or proven, the remaining defense, in the majority of cases, is that of non-infringement. Infringement being a part of the plaintiff's case, the burden is upon him to prove it, and he generally establishes a *prima facie* case by a comparison of the defendant's device or method, with the terms of the claims of the patent in suit. But in-

269. 2 Curt, 506 Fed. Case 2909.

270. 104 U. S. 521, 26 L. Ed. 851.

271. 105 U. S. 766, 26 L. Ed. 959.

272. 3 Blatchf. 201, Fed. Case 11,193.

273. LaLance & Grosjean Mfg. Co. v. Haberman Mfg. Co., 93 Fed. Rep. 197, 198.

fringement depends both upon the construction of the claims, and the practice of the defendant, as to devices or methods. It is therefore usual for the defendant to introduce the file wrapper and contents giving the history of the application which resulted in the patent in suit, and also such prior structures, publications or patents as anticipate or tend to limit the scope of the claims of the patent in suit. All of this material may be offered under a simple denial of the charge of infringement embraced in the bill. These matters of evidence are fully discussed elsewhere, under their respective titles.

§ 359. Twenty-third defense—Estoppel of the complainant to assert any demand under the patent in suit against the defendant.

Estoppel may arise in various ways.

Where the defendant is a former owner of the patent he may be estopped by matter of deed, from contesting the validity of the patent,[274] even as against a reissue

274. "As to the rest of the world, the patent may be void, but the assignor is estopped from urging that defense against his assignee." Lacombe, J., in Adee v. Thomas, 41 Fed. Rep. 342, 343. "The foundation of the estoppel against a vendor patentee is the fact that he has received and retained a valuable thing in consideration of the statements contained in the application for, or specification of, the patent. It is therefore unnecessary that the vendee should prove other representations." Townsend, J., in National Conduit Mfg. Co. v. Connecticut Pipe Mfg. Co., 73 Fed. Rep. 491, 493; citing Babcock v. Clarkson, 63 Fed. Rep. 607, 11 C. C. A. 351. "He (the assignor) cannot say that the patent has been anticipated by prior structures, or that it is void for want of novelty or utility." Colt, J., in Martin & Hill Cash Carrier Co. v. Martin, 67 Fed. Rep. 786, 787, 14 C. C. A. 643.

For other illustrative cases, see, Faulks v. Kamp, 3 Fed. Rep. 898; Onderdonk v. Fanning, 4 Fed. Rep. 148; Consolidated Middlings Purifier Co. v. Guilder, 9 Fed. Rep. 155, 156; Curran v. Burdsall, 20 Fed. Rep. 835; Underwood v. Warren, 21 Fed. Rep. 573; Parker v. McKee, 24 Fed. Rep. 808; Corbin Cabinet Lock Co. v. Yale & Towne Mfg. Co., 58 Fed. Rep. 563, 565; Ball & Socket Fastener Co.

obtained after the assignment,[275] and he is estopped from denying the plaintiff's title.[276] But he is not estopped from showing how the claims of the patent assigned should be construed.[277]

But a defendant-assignor when sued for infringement will not be permitted to attack the validity of the patent under the guise of displaying the prior state of the art to aid the court in construing it.[278]

The estoppel may arise as the result of a contract not to contest the validity of the patent, and it has been repeatedly and uniformly held that such contracts are not void as against public policy.[279]

In the absence of contract, the estoppel extends to a defendant corporation, where, prior to its incorporation all of the parties to the incorporation had concurred in the sale of the patent in suit to the complainant, and had participated in the consideration paid for the patent.[280]

v. Ball Glove Fastening Co., 58 Fed. Rep. 818, 7 C. C. A. 498; Daniel v. Miller, 81 Fed. Rep. 1000; Griffith v. Shaw, 89 Fed. Rep. 313; Smith v. Ridgely, 103 Fed. Rep. 875, 877, 43 C. C. A. 365; Force v. Sawyer-Boss Mfg. Co., 111 Fed. Rep. 902, 903; Consolidated Rubber Tire Co. v. Finley Rubber Tire Co., 116 Fed. Rep. 629, 638; Siemens-Halske Electric Co. v. Duncan Electric Mfg. Co., 142 Fed. Rep. 157, 159, 73 C. C. A. 375.

275. Burdsall v. Curran, 31 Fed. 918, 919.

276. "The assignor is estopped from denying . . . his own title to the interest transferred . . . When sued for infringement, he is not permitted to set up in his defense . . . his own inability to convey it." Colt, J., in Woodward v. Boston Lasting Mach. Co., 60 Fed. Rep. 283, 284, 8 C. C. A. 622.

277. The assignor-defendant "is still left at liberty to show that, assuming the patent to be valid, it is nevertheless subject to the limitations imposed thereon by the prior art." Severens, J., in Smith v. Ridgely, 103 Fed. Rep. 875, 877, 43 C. C. A. 365.

278. Alvin Mfg. Co. v. Schwarling, 100 Fed. Rep. 87, 90.

279. Dunham v. Bent, 72 Fed. Rep. 60; Philadelphia Creamery Supply Co. v. Davis & Rankin Bldg. & Mfg. Co., 77 Fed. Rep. 879; Consolidated Rubber Tire Co. v. Finley Rubber Tire Co., 116 Fed. Rep. 629, 638.

280. Underwood v. Warren, 21 Fed. Rep. 573; Woodward v. Boston Lasting Mach. Co., 60 Fed.

And as a general rule, all persons interested in the sale and in privity with the assignor are estopped, as against the assignee.[281]

Where an estoppel appears in the evidence, the court will give it effect even though the parties do not wish to raise the question. This forms an exception to the almost universal rule that an estoppel must be pleaded, and the reason for this exception to the rule has been thus stated: "The estoppel would properly arise as a matter of rebuttal by complainant, on the proofs, and not on the pleadings. The complainant might have anticipated the defense of invalidity by inserting, in its bill, charges and an avoidance; but it was at its option to do so, and it loss no rights by not availing itself of this option. In Underwood v. Warren,[282] the question of estoppel was raised by exceptions to the answer; but this was irregular, and was apparently permitted because no one objected to this method of proceeding. An answer is clearly not insufficient merely because it sets up a defense which may be rebutted, and parties cannot be compelled to try on exceptions an issue of this kind."[283]

The estoppel does not extend to one who executes the conveyance of a patent as attorney-in-fact for another.[284]

Where the defendant has sustained other intimate relations to the patent than that of ownership, an estoppel may result therefrom; as, where he had been an employee of the complainant, and during that employment gave expert testimony in support of the validity of the patent.[285]

Rep. 283, 8 C. C. A. 622; Force v Sawyer-Boss Mfg. Co., 111 Fed. Rep. 902, 903.

281. Parker v. McKee, 24 Fed. Rep. 808; Daniel v. Miller, 81 Fed. Rep. 1000.

282. 21 Fed. Rep. 573.

283. Per Curiam, Woodward v. Boston Lasting Mach. Co., 63 Fed. Rep. 609, 11 C. C. A. 353.

284. H. Tibbe & Son Mfg. Co. v. Heineken, 37 Fed. Rep. 686.

285. Cleveland Target Co. v. United States Pigeon Co., 52 Fed. Rep. 385.

A bankrupt whose patent has been sold by his assignee in bankruptcy is not subject to the estoppel which would arise had he made the conveyance himself, and it would seem, on principle, that this rule would apply in all cases of involuntary alienation.[286]

The estoppel is not created by the relationship of licensee, in the absence, of course, of any recital as to the validity of the patent in the licensing agreement. When the licensee repudiates and abandons the license he may, in defense of a suit for royalties alleged to have accrued subsequent to the repudiation, set up the invalidity of the patent for want of invention and want of novelty.[287] The same course is open to him when sued for infringement. Judge Taft has said: "The fact that for a time the defendant was a licensee of the Colby patent cannot, of course, estop the defendant from disputing its validity in a suit for infringements charged to have taken place after the license was withdrawn. Such a fact, in a doubtful case, might have considerable evidential force as an admission of the validity of the patent by the licensee."[288]

As to the defense of a suit for royalties, however, the licensee cannot set up the invalidity of the patent unless he has abandoned the license and so notified his licensor.[289]

An estoppel is not created by mere dealings in the articles made by the complainant, or by affirmative recognition of the validity of the patent. A court decision or other circumstance which puts such a dealer for the

286. Babcock v. Clarkson, 63 Fed. Rep. 607, 11 C. C. A. 351.

287. Mudgett v. Thomas, 55 Fed. Rep. 645; White v. Lee, 3 Fed. Rep. 224; Brown v. Lapham, 27 Fed. Rep. 77; Sherman v. Transportation Co., 31 Vermont 162.

288. Dueber Watch Case Mfg. Co. v. Robbins, 75 Fed. Rep. 26.

289. Mudgett v. Thomas, 55 Fed. Rep. 645, 648: Marston v. Swett, 82 N. Y. 526, 533.

first time upon his inquiry as to the validity of the patent will wipe out the effect of such dealings and they will offer no obstacle to his defense of a suit for infringement upon the ground of the invalidity of the patent in suit.[290] Nor is a defendant estopped from making such a defense by the fact that he has offered to take a license under the patent,[291] or by the fact that he is a stockholder in the complainant corporation.[292] Similarly, even though he has exactly copied and appropriated the disclosure of the patent in suit, he is estopped to deny the utility of the thing patented,[293] but is not estopped to defend upon the other grounds attacking its patentability.[294] Nor is such an estoppel created by the fact that the defendant has applied for a patent upon the same thing. "Whether or not there is any inconsistency in trying, at one time, to get a patent for a supposed invention, and in afterwards alleging, as against a rival successful in obtaining a patent, that there is no novelty in the invention, it certainly cannot be said to constitute an estoppel. Besides, the defense of want of patentable invention in a patent operates not merely to exonerate the defendant, but to relieve the public from an asserted monopoly, and the court cannot be prevented from so declaring by the fact that the defendant had ineffectually sought to secure the monopoly for himself."[295]

Where the complainant has never made or sold the patented device, and hence the provisions of § 4900, R. S.

290. Wollensak v. Sargent, 33 Fed. Rep. 840, 843.

291. Evans v. Eaton, Fed. Case 4559; Baldwin v. Bernard, 9 Blatchf. 509, Fed. Case 797.

292. Antisdel v. Chicago Hotel Cabinet Co., 89 Fed. Rep. 308, 32 C. C. A. 216.

293. Mergenthaler Linotype Co. v. Press Pub. Co., 57 Fed. Rep. 502; Gandy v. Main Belting Co., 143 U. S. 587, 36 L. Ed. 272; DuBois v. Kirk, 158 U. S. 58, 39 L. Ed. 895.

294. Simmonds v. Morrison, 44 Fed. Rep. 757, 761.

295. Mr. Justice Shiras, in Haughey v. Lee, 151 U. S. 282, 285, 38 L. Ed. 162, 164.

U. S., as to marking have no application, a notice to the defendant warning it of the complainant's rights under the patent does not serve to debar the complainant from recovering for infringements committed prior to the notice.[296]

No estoppel is created by the discontinuance of an action for infringement against a later suit for the same infringement.[297]

Where, in an attempt to secure a reissue, the patentee avers and proves the disclosure of his original patent to be inoperative, he is estopped to assert that it is operative in subsequent litigation upon the original patent.[298]

§ 360. Twenty-fourth defense—The statute of limitations.

Section 4921, as amended by the Act of March 3, 1897, ch. 391, § 6, 29 Stat. at L. 694, reads in part as follows:

"In any suit or action brought for the infringement of any patent there shall be no recovery of profits or damages for any infringement committed more than six years before the filing of the bill of complaint or the issuing of the writ in such suit or action, and this provision shall apply to existing causes of action."

Under this section a bill will be dismissed where the acts of infringement were committed more than six years before the filing of the bill.[299]

The defense is properly interposed by plea,[300] except when the fact as to the date of the infringement appears on the face of the bill, when it may be raised by demurrer.[301]

296. Campbell v. Mayor of New York, 81 Fed. Rep. 182, 184.

297. Thompson v. Jewett, Fed. Case 13,961.

298. Coffield v. Fletcher, 167 Fed. Rep. 321, —— C. C. A. ——.

299. American Pneumatic Tool Co. v. Pratt & Whitney Co., 106 Fed. Rep. 229.

300. American Pneumatic Tool Co. v. Pratt & Whitney Co., 106 Fed. Rep. 229.

301. Brickill v. City of Hartford, 49 Fed. Rep. 372, 374; Fichtel v. Barthel, 173 Fed. Rep. 489, 491.

Since the enactment of the above-quoted clause, the cases discussing the applicability of State statutes of limitation have become obsolete; some of them are collected in the note.[302]

As a defense, the statute of limitations must be pleaded.[303]

§ 361. Twenty-fifth defense—Former adjudication.

The defense of former adjudication may be interposed in a suit for patent infringement, as in any other, and the same rules govern its efficacy and the method of its presentation as obtain in other cases.

The rule as to *res adjudicata* has been thus summarized:

"In considering the operation of this judgment, it should be borne in mind, as stated by counsel, that there is a difference between the effect of a judgment as a bar or estoppel against the prosecution of a second action upon the same claim or demand, and its effect as an estoppel in another action between the same parties upon a different claim or cause of action. In the former case, the judgment, if rendered upon the merits, constitutes an absolute bar to a subsequent action. It is a finality as to the claim or demand in controversy, concluding parties and those in privity with them, not only as to every matter which was offered and received to sustain or defeat the claim or demand, but as to any other admissible matter which might have been offered for that purpose. Thus, for example; a judgment rendered upon a promissory note is conclusive as to the validity of the instrument and the amount due upon it, although

302. Hayden v. Oriental Mills, 22 Fed. Rep. 103; May v. County of Logan, 30 Fed. Rep. 250; Campbell v. Haverhill, 155 U. S. 610, 39 L. Ed. 280.

303. Fichtel v. Barthel, 173 Fed. Rep. 489, 491.

it be subsequently alleged that perfect defenses actually existed, of which no proof was offered, such as forgery, want of consideration, or payment. If such defenses were not presented in the action, and established by competent evidence, the subsequent allegation of their existence is of no legal consequence. The judgment is as conclusive, so far as future proceedings at law are concerned, as though the defenses never existed. The language, therefore, which is so often used, that a judgment estops not only as to every ground of recovery or defense actually presented in the action, but also as to every ground which might have been presented, is strictly accurate, when applied to the demand or claim in controversy. Such demand or claim, having passed into judgment, cannot again be brought into litigation between the parties in proceedings at law, upon any ground whatever.

"But where the second action between the same parties is upon a different claim or demand, the judgment in the prior action operates as an estoppel only as to those matters in issue or points controverted, upon the determination of which the finding or verdict was rendered. In all cases, therefore, where it is sought to apply the estoppel of a judgment rendered upon one cause of action to matters arising in a suit upon a different cause of action, the inquiry must always be as to the point or question actually litigated and determined in the original action; not what might have been thus litigated and determined. Only upon such matters is the judgment conclusive in another action."[304]

To operate as *res adjudicata* in a suit for patent infringement there must be the same patent in suit, the

304. Mr. Justice Field, in Cromwell v. Sac County, 94 U. S. 351-371, 24 L. Ed. 195, 197.

same device and acts alleged as infringement thereof, and identity of parties.[305]

The former adjudication must have been upon the same, and not merely a co-related, patent.[306]

The Supreme Court has held that a decree in favor of a defendant manufacturer, under the defense of non-infringement, conclusively decrees his right to make and sell the article charged to infringe free from all interference from the complainant, under the patent in suit; and that the manufacturer may enjoin the former plaintiff from instituting or prosecuting further suits upon the patent against the manufacturer's vendees. Thus, indirectly, a decree of non-infringement against a manufacturer is made a bar to further suits under the same patent against the manufacturer's vendees.[307]

But the court expressly declined to express an opinion whether the adjudication could be pleaded in bar in its suit against the vendee, and Judge Lacombe has said: "It would seem that inferior courts should be cautious about extending the principle enunciated in that case beyond the limits within which it was there applied."[308]

The following summary of the effect of interlocutory decrees, *pro confesso* or on hearing, is presented by Judge Ray.[309]

"A decree awarding a perpetual injunction in a patent suit, but with an order of reference to a master to ascertain the damages suffered by the infringement, is an

305. Robinson v. American Car & Foundry Co., 159 Fed. Rep. 131, 132, 86 C. C. A. 321; Hubbell v. United States, 171 U. S. 203, 43 L. Ed. 136.

306. Boyden Power Brake Co. v. Westinghouse Air Brake Co., 70 Fed. Rep. 816, 17 C. C. A. 430.

307. Kessler v. Eldred, 206 U. S. 285, 51 L. Ed. 1065.

308. Consolidated Rubber Tire Co. v. Diamond Rubber Co., 157 Fed. Rep. 677, 680, 85 C. C. A. 349.

309. Australian Knitting Co. v. Gormly, 138 Fed. Rep. 92, 100.

interlocutory, and not a final, decree, and therefore does not operate as an estoppel in a subsequent suit." [3.10]

It will be noted, Judge Ray proceeds, that in that case there had been no appeal to the Circuit Court of Appeals.

In Harmon v. Struthers, 48 Fed. Rep. 260, it was held:

"In a suit for infringement of Letters Patent there was a decree for plaintiffs, awarding an injunction, and for an account, and a reference to a master. The defendants quit using the device so held to infringe, substituting a different device, which was openly used by other persons, and as to which there had been no adjudication. Then, pending the reference before the master, the plaintiff brought a new suit in the same court against the same defendants. The answer therein not only denied infringement, but alleged that one G., and not the patentee, was the original and first inventor of the patented device, which defense was not set up in the first suit. *Held,* that the decree was interlocutory, and did not in the second suit, preclude inquiry into the validity of the patent."

In Roemer v. Neumann, 26 Fed. Rep. 332, it was held:

"An interlocutory decree, entered *pro confesso,* finding the patent valid, awarding an injunction, and referring the case to a master to take an account of profits and damages, is not definitive. No appeal lies from it, and it is still in the control of the court.

"In a prior suit between the same parties, an interlocutory decree, *pro confesso,* awarding an injunction and a reference to a master, had been entered, and a release of profits and damages signed. In a subsequent suit between the same parties, exceptions setting up this decree as an estoppel were overruled, in the absence of

310. Brush Electric Co. v. Western Electric Co., 76 Fed. Rep. 761, 22 C. C. A. 543.

an express authority on the question; and held that, where there is a doubt in such a case, it ought to be resolved against the party urging the estoppel."

In neither of these cases was an appeal taken from the interlocutory judgment of the Circuit Court to the Circuit Court of Appeals.

In Bissel Carpet Sweeper Co. v. Goshen Sweeper Co., 72 Fed. Rep. 545, 19 C. C. A. 25 (Sixth Circuit), the Circuit Court of Appeals held and decided:

"The decree and mandates of the Circuit Courts of Appeals have precisely the same finality as the decree and mandates of the Supreme Court. Whatever is before the court by virtue of the appeal, and is disposed of by it, is finally settled, and becomes the law of the case, so that the court below must carry it into execution according to the mandate, without power to modify, reverse, enlarge, or suspend it.

"Where, on appeal, from an interlocutory decree granting a perpetual injunction, the court necessarily examines and determines the entire merits of the cause, its power to decree is not limited to the matter of the injunction alone, but extends to the whole merits, and its decision is final and conclusive on every point actually decided. Consequently the court below has no power to modify in any respect a decree which is thus affirmed, but must give it full effect in the very terms of the decree of the appellate court. Richmond v. Atwood, 52 Fed. Rep. 10, 2 C. C. A. 596, 17 L. R. A. 615, and Marden v. Manufacturing Co., 67 Fed. Rep. 809, 15 C. C. A. 26, followed. Watch Co. v. Robbins, 52 Fed. Rep. 337, 3 C. C. A. 103, overruled."

In the opinion of the court at pages 554 and 555 of 72 Fed. Rep., pages 34 and 35 of 19 C. C. A., it is said:

"It is equally clear that, by allowing an appeal from an interlocutory decree, Congress intended to allow an appeal from a perpetual injunction ordered and allowed

upon a final hearing of the merits, where the same decree refers the cause to a master for an accounting. This construction of the act has been, so far as we know, universally accepted by the Circuit Courts of the United States and by the Circuit Courts of Appeals. * * * When the appeal is from a decree determining the merits, awarding a perpetual injunction and referring the cause to a master for the simple purpose of reporting damages for infringement, there can be no proper review or re-examination of so much of the decree as awards the injunction that does not include the basis upon which it was granted. Thus, though the 'injunction is the backbone of the jurisdiction,' as pithily observed by Judge Putnam in Marden v. Manufacturing Co., supra, yet the appeal necessarily brings up the full record, and places us in full possession of the entire case, so far, at least, as a remedy by injunction was the foundation of the jurisdiction below. It follows, therefore, that if the court finds it essential to pass upon the merits of the case in order to determine the propriety of the injunction, and and in no way reserves to the lower court a right to review or re-examine the grounds upon which it had originally proceeded, the decision of this court becomes the law of the case. If that decision was an affirmance of the decree below, that decree becomes the decree of this court, and is no longer open to review, rehearing or modification, for it has become the settled law of the case. A second appeal can only involve matters subsequent to the decree, for this court, after term passed, has no power to review, rehear, or re-examine its own decrees. This rule of practice and procedure is in accord with the usages and practice of appellate courts obtaining jurisdiction through appeals from decrees, interlocutory in character, which determine the rights of the party appealing."

And at page 560 of 72 Fed. Rep., page 40 of 19 C. C. A., the court further says:

"The conclusion we have reached is in the line of the relief intended by Congress to be afforded suitors whose rights are affected by temporary submission to an interlocutory decree. The right to appeal at this stage of the cause is optional. If one affected by the action of the court in allowing, dissolving, or continuing an injunction, see fit, he may await a final decree, and then appeal. But if he elects to appeal, with the result that another inconclusive decree, is rendered, his last estate is no better than his first, for he must proceed with the cause, and submit until he can again appeal. The statutory purpose was to save the litigants from being obliged to submit to the injury incident to an inconclusive decree, and to all the expense of an accounting. But if, after an appeal, resulting in an inconclusive affirmance, he must still proceed with an accounting, which, after all, may prove unnecessary, the statute will have amounted to little. The doctrine of *res adjudicata* rests upon the maxim that there should be an end to litigation. No doctrine rests upon sounder principles of public policy, or is more entitled to a wide application. If, under an appeal from a decree awarding an injunction, this court obtains such a record as to enable it, with justice to the parties to the appeal, to hear and consider the merits of the cause, it would be most anomalous if we have not the power to decide. The judicial function of considering involves the function of determining. The decision of an appellate court is final, and no second appeal is maintainable, except as to matters reserved or proceedings subsequent to the first appeal."

Former adjudication—Persons concluded.

While the subject of former adjudication is entirely too compendious for detailed consideration in a treatise

of this character, some of the general principles announced in patent causes are deserving of reference.

There is probably no case in the books which goes to the length of saying that one who merely contributes to the defense of a case is bound by its result. As Judge Cross has pertinently said, "such a contribution might well be made from charitable or other good and sufficient reasons."[311]

The basic rule has been thus stated by Judge (now Mr. Justice) Lurton: "The doctrine is well settled that one who for his own interest joins in the defense of a suit to which he is not a party of record is as much concluded by the judgment as if he had been a party thereto, provided his conduct in that respect was open and avowed or otherwise well known to the opposite party. * * * An estoppel by decree exists, although the demand in the two cases is not the same, whenever the question upon which the recovery in the second case depends has been before decided, between the same parties or those in priority with them."[312]

So a defendant is estopped by an earlier suit in which he was the real defendant, and the nominal defendant his agent.[313]

So also a manufacturer who employs counsel, pays counsel fees, costs and other expenses and conducts the defense in behalf of his branch house or customer.[314]

"The law is well settled that parties and privies include all who are directly interested in the subject-matter, and who had the right to make defense, control the

311. Rumford Chem. Works v. Hygienic Chem. Co., 148 Fed. Rep. 862, 864.

312. Penfield v. C. & A. Potts & Co., 126 Fed. Rep. 475, 480, 61 C. C. A. 371.

313. Morss v. Knapp, 37 Fed. Rep. 351.

314. David Bradley Mfg. Co. v. Eagle Mfg. Co., 57 Fed. Rep. 980, 6 C. C. A. 661.

proceedings, examine and cross-examine witnesses, and appeal from the judgment.''[315]

§ 362. Twenty-sixth defense—Laches.

Laches is an affirmative defense, although a bill is demurrable if it shows laches upon its face,[316] and it may serve as a defense, though not pleaded.[317]

In an illustrative case Judge Ward has said:

"The defendants next object that, the bill alleging infringement since the date of the patent, April 18, 1895, and prior to the filing of the complaint, May 4, 1909, a period of fourteen years, there is nothing to show either that the infringement was not continuous, or that it did not all occur more than six years before the filing of the bill. It is argued that on the former hypothesis the complainants are not entitled to an injunction because of laches, and on the latter that they are not entitled to an accounting. Laches is a matter of defense, and a bill is not demurrable unless it clearly shows, which it does not, that the complainants have been guilty of laches.''[318]

This defense is one that lies between the statute of limitations on the one hand, and estoppel upon the other. In law actions, the statute fixes the time limit within which the action must be brought, or it cannot be maintained.

Laches is to the suit in equity what the statute of limitations is to the action at law, but laches is elastic,

315. Hawley, J., in Theller v. Hershey, 89 Fed. Rep. 575. To the same effect, see, Brooklyn City & N. R. Co. v. National Bank of the Republic of New York, 102 U. S. 21, 26 L. Ed. 61; Green v. Bogue, 158 U. S. 503, 39 L. Ed. 1061; Litchfield v. Goodnow, 123 U. S. 550, 31 L. Ed. 199.

316. McLaughlin v. People's Railway Co., 21 Fed. Rep. 574.

317. Curtain Supply Co. v. National Lock Washer Co., 174 Fed. Rep. 45, 49.

318. Fichtel v. Barthel, 173 Fed. Rep. 489, 491.

while the statute is inflexible. Laches, when coupled with knowledge, the duty to act, or circumstances tending to mislead the infringer into a sense of security, merges into acquiescence, and finally into an estoppel. In its earlier and simpler forms, it is a defense merely to the application for preliminary injunction; only when, aggravated by time and other circumstances rendering the patentee's position as a complainant clearly inequitable, it has developed into an estoppel, does it debar the patentee from any relief in equity upon final hearing.

There are no hard and fast lines of demarcation between excusable laches, inexcusable laches, acquiescence and estoppel. A proper regard for the questions arising in the future forbids the fixing of such boundaries by courts of equity.

These general considerations may be clarified by referring to the following explanation of Mr. Justice Brewer:

"The cases are many in which this defense has been invoked and considered. It is true, that by reason of their differences of fact no one case becomes an exact precedent for another, yet a uniform principle pervades them all. They proceed on the assumption that the party to whom laches is imputed has knowledge of his rights, and an ample opportunity to establish them in the proper forum; that by reason of his delay the adverse party has good reason to believe that the alleged rights are worthless, or have been abandoned; and that because of the change in condition or relations during this period of delay, it would be an injustice to the latter to permit him to now assert them. * * * But it is unnecessary to multiply cases. They all proceed upon the theory that laches is not like limitation, a mere matter of time; but principally a question of the inequity of permitting the claim to be enforced—an inequity founded upon some

change in the condition or relations of the property or the parties."[319]

Two opinions in patent cases are especially worthy of consideration here. The first is that of Judge Dallas:

"I do not feel called upon to vindicate the action of the court in granting the preliminary injunction, but may abridge discussion by saying that, if the delay then set up to defeat the motion had not been satisfactorily explained, that motion might have been, upon that ground, refused; but, upon final hearing, laches, in the sense of mere delay in bringing suit against the defendants, cannot deprive the plaintiffs of their right to protection against a continuance of the unlawful use of their patented invention, and consequent injury to their business. It is only by words, acts, or omissions which give rise to estoppel that this right, if and when established by the proofs, can be forfeited. This distinction is clear and well recognized, and cannot be obliterated by a vague use of the word 'laches.' As I have said, mere delay in bringing suit may, under some circumstances, impel the court to withhold its hand during the course of litigation; and as was remarked in New York Grape Sugar Co. v. Buffalo Grape Sugar Co., infra, even on final hearing, 'cases may arise where a court of equity would refuse an injunction against an innocent infringer, by reason of the protracted course of conduct of a previous owner of the patent, who knew of the infringement, and silently and knowingly permitted the expenditure of substantial sums of money by the infringer.' To such cases the doctrine of estoppel may be pertinent, but the present case is not such an one. I have attentively read the very thorough brief of the learned counsel of the defendants, but without finding any fact re-

319. Galliher v. Cadwell, 145 U. S. 368, 36 L. Ed. 738.

ferred to other than that, as claimed, the plaintiffs long knew of the violation of their rights before proceeding to maintain them; and I am constrained to the conclusion that his contention is met by the rule, as I have already indicated it, that mere delay in seeking relief will not, where there is no estoppel, prevent the granting of a final injunction. New York Grape Sugar Co. v. Buffalo Grape Sugar Co.,[320] Brush Electric Co. v. Electric Imp. Co.;[321] Price v. Steel Co.,[322] McLean v. Fleming.[323] In Waite v. Chair Co.,[324] it would seem, if the syllabus in the report could be relied on, that the question was considered as arising upon a motion for preliminary injunction; but, apart from this, the learned judge certainly does appear to have held that long-continued knowledge of infringement, without objection, might, in the discretion of the court, be accepted as a reason for postponing 'the question of granting an injunction * * * until the coming in of the master's report.' This was held, however, wholly upon the supposed authority of Kittle v. Hall,[325] but in that case Judge Coxe, after saying that the proposition, as presented to him, was a most perplexing one, proceeded to consider it upon the peculiar facts before him, and which in his opinion, were of such character that, as he said, 'the public had a right to assume, from this profound silence and supineness, that the patentee and his successors had relinquished any claim which they might possess.' In other words, there was in that case not merely a delay, but silence and supineness, under circumstances which called for protest and activity, and which therefore worked an estoppel, and warranted the assumption of an abandonment. In this lies the distinction between

320. 18 Fed. Rep. 638.
321. 45 Fed. Rep. 241.
322. 46 Fed. Rep. 107.
323. 96 U. S. 245-253.
324. 45 Fed. Rep. 258.
325. 29 Fed. Rep. 508.

that case and the one now under consideration; for, as I said upon the motion for a preliminary injunction, 'there is nothing in this case to show a waiver by the complainants of the right which they now assert, or which would preclude them from the allowance of the special equitable remedy which they invoke. They proceeded against these defendants with what, under the circumstances, was due diligence, and have done nothing to justify the imputation that supineness or apparent acquiescence upon their part induced or invited the infringement of which they now complain.' "[326]

A kindred opinion of Judge (now Mr. Justice) Lurton is noteworthy here: "The ground upon which a court of equity will take cognizance of a suit for an infringement of a patent is the relief through an injunction. There is nothing so peculiar to a suit for damages and profits for infringement of a patent as will, independently of some recognized ground of equitable jurisdiction, justify a court of chancery in assuming jurisdiction. It must appear that the legal remedy at law is inadequate, and if the case is one in which equitable relief by injunction is inappropriate, as where the patent has expired, or where the circumstances are such as to justify a court in refusing equitable relief, the suit will not be entertained for the mere purpose of an account of past damages and profits.[327]

"Aside from the fact that no preliminary injunction was applied for or allowed, and that when the final hearing was had plaintiff Anderson's patent had expired, we think that the conduct of complainant, and those to whose rights it has succeeded, has been such as to re-

326. Sawyer Spindle Co. v. Taylor, 69 Fed. Rep. 837, 838.

327. Citing Root v. Lake Shore & M. S. Railway Co., 105 U. S. 189, 26 L. Ed. 975; McLaughlin v. People's Railway Co., 21 Fed. Rep. 574; Clark v. Wooster, 119 U. S. 325, 30 L. Ed. 392.

quire a court of equity to refuse it any relief whatever. Reasonable diligence as well as good faith are necessary to call into operation the powers of a court of equity.[328] One who invokes the protection of equity must be 'prompt, eager, and ready' in the enforcement of his rights. Equity will not encourage a suitor who has long slept over his rights. It was well observed by Judge Coxe, in Kittle v. Hall,[329] that 'time passes, memory fails, witnesses die, proof is lost, and the right of individuals and of the public intervene. Long acquiescence and laches can only be excused by proof showing excusable ignorance, or positive inability to proceed on the part of the complainant, or that he is the victim of fraud or concealment on the part of others.' He adds 'that the court will not entertain a case when it appears that the complainant, or those to whose rights he has succeeded have acquiesced for a long term of years in the infringement of the exclusive right conferred by the patent, or have delayed, without legal excuse, the prosecution of those who have openly violated it.' These general principles find ample support in many cases, only a few of which need be cited.[330] That this doctrine of courts of equity requiring reasonable diligence as a condition precedent to the exercise of its discretionary powers is applicable in patent cases is manifest from a consideration of the nature of the relief sought against an infringer. Equity will not entertain a suit merely involving an ascertainment of damages and profits. This question was elaborately considered and expressly decided in Root v. Railway Co., heretofore cited. Equitable jurisdiction in pat-

328. Citing Maxwell v. Kennedy, 8 How. 210, 222, 12 L. Ed. 1051.

329. 29 Fed. Rep. 511.

330. Piatt v. Vattier, 9 Pet. 416; Maxwell v. Kennedy, 8 How. 221, 222; Leggett v. Standard Oil Co., 149 U. S. 287-294, 37 L. Ed. 740; McLaughlin v. Railway Co., 21 Fed. Rep. 574; Speidell v. Henrici, 15 Fed. Rep. 753; The Walter M. Fleming, 9 Fed. Rep. 474; Lewis v. Chapman, 3 Beav. 133.

ent cases is therefore subject to the general principles of equity jurisprudence, and the power to grant injunctions in such cases, according to the provisions of § 4921, Rev. St., must be 'according to the course and principles of courts of equity, to prevent the violations of any rights secured by a patent, upon such terms as the court may deem reasonable.' That inexcusable laches of the complainant is a sound reason for noninterference on the part of the court of equity was expressly decided in McLaughlin v. Railway Co., heretofore cited; the opinion being by Circuit Judge Brewer, now Justice Brewer. In that case a delay of thirteen years was held ground for dismissing the bill upon a demurrer. In Lane & Bodley Co. v. Locke,[331] the Supreme Court held that a delay of twelve years was a bar to any relief in equity against an infringer, Mr. Justice Shiras, who delivered the opinion of the court, saying:

"'Courts of equity, it has often been said, will not assist one who has slept on his rights, and shows no excuse for his laches in asserting them.'

"In the very late case of Keyes v. Mining Co.,[332] the doctrine of McLaughlin v. Railway Co., and Lane & Bodley Co. v. Locke, was followed, and a complainant who had delayed for nearly seventeen years was repelled from court as guilty of inexcusable laches. Neither is it important that the defense of laches was not formally set up in the answer. Laches is a defense which may be made by demurrer, or by plea, or by answer, or presented by argument, either upon a preliminary or final hearing."[333]

331. 150 U. S. 193, 37 L. Ed. 1049.

332. 158 U. S. 150, 39 L. Ed. 929, affirming 45 Fed. Rep. 199.

333. Woodmanse & Hewitt Mfg. Co. v. Williams, 68 Fed. Rep. 489, 492, 15 C. C. A. 520; citing Maxwell v. Kennedy, 8 How. 222, 12 L. Ed. 1051; McLaughlin v. Railway Co., 21 Fed. Rep. 574.

"No one," Judge Green has said, "can have relief if his own conduct has led to that state of affairs which occasions the application."[334]

§ 363. Twenty-seventh defense—That the reissued patent in suit was obtained without statutory grounds.

The statute (§ 4916, R. S. U. S) specifies the requisites to the lawful granting of a reissue. The original must not only be "inoperative or invalid," but this condition must arise from "a defective or insufficient specification," and then the defect must have "arisen by inadvertence, accident or mistake," and "without any fraudulent or deceptive intention." But in the judicial review of reissued patents the action of the Commissioner of Patents upon the issues of inadvertence, accident or mistake is usually regarded as final. The Supreme Court of the United States has said, "this court will not review the decision of the Commissioner upon the question of inadvertence, accident, or mistake, unless the matter is manifest from the record."[335]

And in a later case that court has construed the words "inoperative or invalid" with great liberality. "The reissue was applied for * * * merely to correct, as it would seem, an obvious error in one of the drawings. Possibly the error was such as would not have impaired the patentee's rights under his original designs; but he was entitled to the full scope of his invention, and if he were dissatisfied with the drawings as they stood, and the error was purely an inadvertent one, we think it was within the jurisdiction of the Commissioner of Patents to order the patent to be reissued. * * * To justify a reissue it is not necessary that the patent should be

334. Brush Elec. Co. v. Electric Storage Battery Co., 64 Fed. Rep. 775, 777.

335. Topliff v. Topliff, 145 U. S. 156, 171, 36 L. Ed. 658, 664.

wholly inoperative or invalid. It is sufficient if it fail to secure to the patentee all of that which he has invented and claimed. * * * The only alternative of a reissue was a suit upon the original patent, in which the patentee would be compelled to take his chances of success, notwithstanding the error in his drawing, when in case of defeat the time in which to obtain a reissue might have expired. We do not think he should be driven to this expedient."[336]

Notwithstanding the liberality of these views, the statutory requirements must exist as a condition precedent to a valid reissue; and when there is "no claim of a defective or insufficient specification; * * * none of inadvertence, accident or mistake," the reissue cannot be sustained,[337] and in such a case it is exceedingly doubtful whether the Commissioner has any jurisdiction to act.[338]

Where this defense is successful, the complainant is without further right under either his original or reissued letters patent. Since the decision of Moffitt v. Garr, 66 U. S. (1 Black) 273, 17 L. Ed. 207, "it has been uniformly held that if a reissue is granted, the patentee has no rights except such as grow out of the reissued patent. He has none under the original. That is extinguished. * * * No damages can be recovered for any acts of infringement committed prior to the reissue. * * * It seems to us equally clear, that as the law stood when that decision was made * * * a patent surrendered for reissue was cancelled in law as well when the application was rejected as when it was granted. The patentee was in the same situation as he would have been if his original application for a patent had been rejected. * * * Surrender of the patent was an abandon-

336. Mr. Justice Brown, in Hobbs v. Beach, 180 U. S. 385, 394, 395, 45 L. Ed. 586, 593.

337. Eby v. King, 158 U. S. 366, 373, 39 L. Ed. 1018, 1021.

338. Eby v. King, 158 U. S. 366, 373, 39 L. Ed. 1018, 1021.

ment of it, and the applicant for reissue took upon himself the risk of getting a reissue or of losing all. A failure upon the merits, in a contest with other claimants, only gave additional force to the legal effect of the surrender."[339] These views, however, have been partially reversed, a later ruling being that if the reissue application is rejected, the original patent stands precisely as though a reissue had never been applied for, unless the reissue be refused upon some ground equally affecting the original patent.[340] Following this, however, the Supreme Court held that the original patent must be returned to the unsuccessful applicant for a reissue, upon the abandonment of the reissue application, and that the Patent Office is without jurisdiction to cancel the entire original patent or either of its claims.[341]

§ 364. Twenty-eighth defense—That the reissued patent in suit is for a different invention from that disclosed in the original patent.

This defense, like the twenty-seventh defense, is rooted in § 4916, R. S. U. S., which provides that the reissue shall be "a new patent for the same invention." It necessarily follows that "an expansion of the claims in order to embrace an invention not specified in the original patent" will render the claims so characterized void.[342]

"Reissued letters patent must be for the same invention as that secured in the original patent; and if it ap-

339. Mr. Justice Bradley, in Peck v. Collins, 103 U. S. 660 26 L. Ed. 512; and to the same effect, see, Eby v. King, 158 U. S. 366, 373, 39 L. Ed. 1018, 1021.

340. Allen v. Culp, 166 U. S. 501, 41 L. Ed. 1093.

341. McCormick v. Aultman, 169 U. S. 606, 42 L. Ed. 875.

342. Leggett v. Standard Oil Co., 149 U. S. 287, 292, 37 L. Ed. 737, 741; Miller v. Bridgeport Brass Co., 104 U. S. 350, 26 L. Ed. 783; Mahn v. Harwood, 112 U. S. 354, 28 L. Ed. 665; Wollensak v. Reiher, 115 U. S. 96, 29 L. Ed. 350.

peared that such a patent is for a different invention, it is clear that it is void, as no such power is vested in the Commissioner. * * * Persons seeking redress for the infringement of a reissued patent are not obliged to introduce the original patent; and if the old patent is not given in evidence by the party sued, he cannot have the benefit of such a defense."[343]

"Same invention"—how interpreted.

In the leading case of Giant Powder Co. v. California Powder Works, the original patent was for processes and appliances for producing the explosion of nitro-glycerine, while the reissues were for compositions of matter (nitro-glycerine with various other substances). Upon this state of facts the court said "it is impossible not to say that they (the reissues) are for an entirely different invention from that secured or attempted to be secured by the original patent;" but indicated that if the original patent had been for a process of compounding the nitro-glycerine with the other substances the reissues might have been sustained.[344] In later cases it has been held that an original process patent would not sustain a reissue claiming a machine;[345] that an original machine patent would not serve as an antecedent for a process patent;[346] that the original patent of Charles Goodyear for "rubber fabrics" was a sufficient foundation for a reissue claiming the process for making those articles of manufacture.[347] Following the Goodyear

343. Mr. Justice Clifford, in Bates v. Coe, 98 U. S. 31, 25 L. Ed. 68; following Seymour v. Osborne, 78 U. S. (11 Wall.) 546, 20 L. Ed. 39.

344. Giant Powder Co. v. California Powder Works, 98 U. S. 126, 131, 25 L. Ed. 77, 81.

345. Heald v. Rice, 104 U. S. 737, 26 L. Ed. 910.

346. Eachus v. Broomall, 115 U. S. 429, 29 L. Ed. 419.

347. Providence Rubber Co. v. Goodyear, 76 U. S. (9 Wall.) 788, 19 L. Ed. 566; Goodyear v. Day, 2 Wall. Jr. 283, Fed. Case No.

cases, reissues claiming a new bronze and the method of its making, were held valid under an original which claimed the method only,[348] but the Supreme Court held the patent for the article of manufacture limited to the bronze produced by the process, Mr. Justice Matthews observing "although there are two patents, one for a process and the other for a product, there is in fact but one invention; and it may be assumed that the new article of manufacture called Tucker bronze is a product which results from the use of the process described in the patent, and not one which may be produced in any other way."[349]

§ 365. Twenty-ninth defense—That the claims of the reissued patent in suit are broader than those in the original patent, and the reissue was applied for too long after the issuance of the original patent.

The peculiar phraseology of this statement of the defense to be considered, is due to the manner in which the broadened character of the claim has been pretty uniformly coupled with delay in the reissue application. It is obvious that a reissue statute which would place a positive inhibition upon any enlargement of the claim would work great hardship. It is equally clear that as a patent dedicates to the public that which it describes but does not claim, the public is at liberty—by sheer appropriation and use of what is disclosed but not claimed, as well as by independent invention—to utilize the suggestions of a patent, outside its claims. Yet it is not the spirit of the reissue statute to foreclose the inventor who is suffering from the inadvertence or mis-

5569; Goodyear v. Central Railroad Co. of New Jersey, 1 Fisher 626, Fed. Case 5563.

348. Tucker v. Dane, 7 Fed. Rep. 213, 214; Tucker v. Tucker Mfg. Co., 4 Cliff. 397, Fed. Case 14,227; Tucker v. Burditt, 5 Fed. Rep. 808.

349. Plummer v. Sargent, 120 U. S. 442, 30 L. Ed. 737.

take or accident which has limited him to less than his whole true invention; and hence the arbitrary two years' rule, treated elsewhere in this book, has been judicially established. Mr. Justice Brown has dealt with this subject so thoroughly that we are justified in submitting his treatment of it in full.

"It is a mistake to suppose that the case (Miller v. Bridgeport Brass Co., 104 U. S. 350, 26 L. Ed. 783), was intended to settle the principle that, under no circumstances, would a reissue containing a broader claim than the original be supported. We have no desire to modify in any respect the views expressed in that and subsequent cases with regard to the validity of reissues. There is no doubt, as was said by this court in Giant Powder Co. v. California Powder Works, 98 U. S. 126, 127, 25 L. Ed. 77, 81, 82, that a reissue can only be granted for the same invention which formed the subject for the original patent, of which it is a reissue, since, as was said by the court in that case, the express words of the Act are 'a new patent for the same invention.' The specification may be amended so as to make it more clear and distinct; the claim may be modified so as to make it more conformable to the exact rights of the patentee; but the invention must be the same.

" * * * This prohibition is general, relating to all patents; and 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. The danger to be provided against was the temptation to amend a patent, so as to cover improvements which might have come into use, or might have been invented by others, after its issue.

"In the case of Miller v. Bridgeport Brass Co., 104 U. S. 350, 26 L. Ed. 783, a reissue with expanded claims was applied for *fifteen years* after the original patent

was granted. It was held to be manifest upon the face of the patent that the suggestion of inadvertence and mistake was a mere pretense, or, if not a pretense, that the mistake was so obvious as to be instantly discernible on the opening of the patent, and the right to have it corrected was abandoned and lost by unreasonable delay. 'The only mistake suggested,' said Mr. Justice Bradley, 'is, that the claim was not as broad as it might have been. This mistake, if it was a mistake, was apparent upon the first inspection of the patent, and if any correction was desired, it should have been applied for immediately.' It was intimated in that case, p. 352, although the facts did not call for an adjudication upon the point, that 'if two years' public enjoyment of an invention with the consent and allowance of the inventor is evidence of abandonment and a bar to an application for a patent, a public disclaimer in the patent itself should be construed equally favorable to the public. Nothing but a clear mistake or inadvertence, and a speedy application for its correction, is admissible when it is sought merely to enlarge the claim.' It was further said that the section of the Revised Statutes does not in terms authorize a reissue to enable a patentee to expand his claim, and that it was natural to conclude that the reissue of a patent for such purpose was not in the mind of Congress when it passed the laws in question. 'At all events,' said the court, p. 354, 'we think it clear that it was not the special purpose of the legislation on this subject to authorize the surrender of patents for the purpose of reissuing them with broader and more comprehensive claims, although, under the general terms of the law, such a reissue may be made when it clearly appears that an actual mistake has inadvertently been made.

" * * * Now, whilst, as before stated, we do not deny that a claim may be enlarged in a reissued patent, we are of the opinion that this can only be done when an actual

mistake has occurred; not from a mere error of judgment (for that may be rectified by appeal), but by a real bona fide mistake, inadvertently committed; such as a court of chancery, in cases within its ordinary jurisdiction, would correct. * * * The granting of a reissue, for such a purpose, after an unreasonable delay, is clearly an abuse of the power to grant reissues, and may justly be declared illegal and void.

"So, in the case of Johnson v. Flushing & N. S. R. Co., 105 U. S. 539, 26 L. Ed. 1162, the patent was issued in 1857, and at the expiration of the original term of fourteen years an extension of seven years was granted, and a reissue was applied for after a lapse of fifteen years, and it was held, upon the authority of Miller v. Bridgeport Brass Co., that if the patentee had the right to a reissue if applied for in reasonable time, he had lost it by unreasonable delay. Said the court, speaking by Mr. Justice Woods: 'He has rested supinely until the use of the fish-plate joint has become universal, and then, after a lapse of fifteen years, has attempted by a reissue to extend his patent to cover it. We think it is perfectly clear that the original patent could not be fairly construed to embrace the device used by the appellee, which appellants insist is covered by their issue. If the reissued patent covers it, it is broader than the original, and is, therefore, void.'

"In the case of Mahn v. Harwood, 112 U. S. 354, 28 L. Ed. 665, a patent reissued nearly four years after the date of the original patent was held to be invalid as to the new claims, upon the ground of unreasonable delay in applying for it, the only object of the reissue being to enlarge the claims. Nothing was changed, but to multiply the claims and make them broader, and this was done, not for the benefit of the original patentee, but for that of his assignee. 'It is not intended then,' said Mr. Justice Bradley, referring to Miller v. Bridgeport Brass

Co., 'and is not now, to question the conclusiveness, in suits for infringements of patents, of the decisions of the commissioner on questions of fact necessary to be decided before issuing such patents, except as the statute gives specific defenses in that regard.'

"He repeated substantially what has been said in Miller v. Bridgeport Brass Co., that 'a patent for an invention cannot lawfully be 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 reasonable short period after the original patent was granted. The granting of such reissues after the lapse of long periods of time is an abuse of power, and is founded on a total misconception of the law.' It was held that while lapses of time might be of small consequence where the original claim was too broad, and the patentee sought to restrict it, there were substantial reasons why the claim could not be enlarged unless the patentee used due diligence to ascertain his mistake. 'The rights of the public here intervene, which are totally inconsistent with such tardy reissue; and the great opportunity and temptation to commit fraud after any considerable lapse of time, when the circumstances of the original application have passed out of mind, and the monopoly has proved to be of great value, make it imperative on the courts, as a dictate of justice and public policy, to hold the patentees strictly to the rule of reasonable diligence in making application for this kind of reissues.' It was further held that while it was for the Commissioner of Patents to determine the question of inadvertence, accident or mistake, the question of reasonable time was one which the court could determine as one of law, by comparing the patent itself with the original patent, and, if necessary, with the record of its inception.

"In speaking of the case of Miller v. Bridgeport Brass Co., Mr. Justice Bradley observed: We suggested that a delay of two years in applying for such correction should be construed equally favorable to the public. But this was a mere suggestion by the way, and was not intended to lay down any general rule. Nevertheless, the analogy is an apposite one, and we think that excuse for any longer delay than that should be made manifest by the special circumstances of the case.

"In the large number of cases which have come up to this court since that of Mahn v. Harwood was decided, in which reissues have been held to be invalid, it will be found that the opinion of the court was put upon the ground, either that the patentee had been guilty of inexcusable laches, usually of from four to sixteen years, or that circumstances had occurred since the granting of the original patent which made the reissue operate harshly or unjustly to the defendant in the case.

"Thus, in Matthews v. Boston Machine Co., 105 U. S. 54, 26 L. Ed. 1022, there was a delay of fourteen years; in Bantz v. Frantz, 105 U. S. 160, 26 L. Ed. 1013, a delay of fourteen years and six months; in Wing v. Anthony, 106 U. S. 142, 27 L. Ed. 110, of over five years; in Moffitt v. Rogers, 106 U. S. 423, 27 L. Ed. 76, of two years and seven months; in Gage v. Herring, 107 U. S. 640, 27 L. Ed. 601, of fourteen years; in Clements v. Odorless E. A. Co., 109 U. S. 641, 27 L. Ed. 1060, of nearly five years; in McMurray v. Mallory, 111 U. S. 97, 28 L. Ed. 365, of nine years; in White v. Dunbar, 119 U. S. 47, 30 L. Ed. 303, of five years. In Parker & W. Co. v. Yale Clock Co., 123 U. S. 87, 31 L. Ed. 100, there was a delay of one year and eight months, but it appeared that the improvement not covered by the original patent had been brought into use by others than the patentee before the reissue was applied for. In Coon v. Wilson, 113 U. S. 268, 28 L. Ed. 963, a reissue was ap-

plied for only a little over three months after the original patent was granted; but the patentee waited until the defendants produced their device and then applied for such enlarged claims as to embrace this device, which was not covered by the claim of the original patent, and it was apparent from a comparison of the two patents that the application for a reissue was made merely to enlarge the scope of the original. In Wollensak v. Reiher, 115 U. S. 96, 29 L. Ed. 350, there was a delay of more than five years, Mr. Justice Matthews observing that 'the settled rule of decision is, that if it appears, in cases where the claim is merely expanded, that the delay has been for two years, or more, it is adjudged to invalidate the reissue, unless the delay is accounted for and excused by special circumstances, which show it to have been not unreasonable.' In the very latest case decided by this court, viz., Electric-Gas Lighting Co. v. Boston Electric Co., 139 U. S. 481, 35 L. Ed. 250, there was a delay of eight and one-half years, and the sole object of the reissue was to expand the claims. In Newton v. Furst & C. Co., 119 U. S. 373, 30 L. Ed. 442, there was a delay of more than thirteen years, and the defendant had begun in the meantime to make machines of the pattern complained of. In Ives v. Sargent, 119 U. S. 652, 30 L. Ed. 544, there was a delay of three years, and in the meantime the patent was infringed by a construction manufactured and sold without infringing the patent as originally granted. In Worden v. Searls, 121 U. S. 14, 30 L. Ed. 853, there was a delay of six years; and in Matthews v. Iron Clad Mfg. Co., 124 U. S. 347, 31 L. Ed. 477, one of seven years.

"From this summary of the authorities it may be regarded as the settled rule of this court that the power to reissue may be exercised when the patent is inoperative by reason of the fact that the specification as originally drawn was defective or insufficient, or the claims

were narrower than the actual invention of the patentee, provided the error has arisen from inadvertence or mistake, and the patentee is guilty of no fraud or deception; but that such reissues are subject to the following qualifications:

"First. That it shall be for the same invention as the original patent, as such invention appears from the specification and claims of such original.

"Second. That due diligence must be exercised in discovering the mistake in the original patent, and, if it be sought for the purpose of enlarging the claim, the lapse of two years will ordinarily, though not always, be treated as evidence of an abandonment of the new matter to the public to the same extent that a failure by the inventor to apply for a patent within two years from the public use or sale of his invention is regarded by the statute as conclusive evidence of an abandonment of the patent to the public.

"Third. That this court will not review the decision of the Commissioner upon the question of inadvertence, accident, or mistake, unless the matter is manifest from the record; but that the question whether the application was made within a reasonable time is, in most, if not in all such cases, a question of law for the court.

"To hold that a patent can never be reissued for an enlarged claim would be not only to override the obvious intent of the statute, but would operate in many cases with great hardship upon the patentee. The specification and claims of a patent, particularly if the invention be at all complicated, constitute one of the most difficult legal instruments to draw with accuracy, and in view of the fact that valuable inventions are often placed in the hands of inexperienced persons to prepare such specifications and claims, it is no matter of surprise that the latter frequently fail to describe with requisite certainty the exact invention of the patentee, and err either in

claiming that which the patentee had not in fact invented, or in omitting some element which was a valuable or essential part of his actual invention. Under such circumstances, it would be manifestly unjust to deny him the benefit of a reissue to secure to him his actual invention, provided it is evident that there has been a mistake and he has been guilty of no want of reasonable diligence in discovering it, and no third persons have in the meantime acquired the right to manufacture or sell what he had failed to claim. The object of the patent law is to secure to inventors a monopoly of what they have actually invented or discovered, and it ought not to be defeated by a too strict and technical adherence to the letter of the statute, or by the application of artificial rules of interpretation."[350]

§ 366. Damages, defined.

The Supreme Court has defined damages to be compensation for the pecuniary injury suffered by the plaintiff in an action at law by reason of the defendant's infringement, without regard to the question whether the defendant has gained or lost by reason of his unlawful acts.[351]

Speaking generally of damages, Mr. Justice Miller has said:

> "'Damages,' says Mr. Greenleaf, 'are given as a compensation, recompense or satisfaction to the plaintiff for any injury actually received by him from the defendant. They should be precisely commensurate with the injury, neither more nor less, and this whether it be to his person or estate.' 2 Greenl. Ev., § 253. And without entering into the question whether this rule excludes what are called exem-

350. Mr. Justice Brown, in Topliff v. Topliff, 145 U. S. 156, 36 L. Ed. 658, 662.

351. Mr. Justice Clifford, in Birdsall v. Coolidge, 93 U. S. 64-68, 23 L. Ed. 802.

plary damages, which are not claimed here, we think this definition of the principle on which damages are awarded in actions at law a sound one."[352]

§ 367. Damages distinguished from profits.

Judge Coxe has thus differentiated between damages and profits. "In patent nomenclature what the infringer makes is 'profits,' what the owner of the patent loses by such infringement is 'damages.'"[353]

§ 368. Statutory damages.

1. *In actions at law.*

Section 4919 provides:

"Damages for the infringement of any patent may be recovered by action on the case, in the name of the party interested, either as patentee, assignee, or grantee. And whenever in any such action a verdict is rendered for the plaintiff, the court may enter judgment thereon for any sum above the amount found by the verdict as the actual damages sustained, according to the circumstances of the case, not exceeding three times the amount of such verdict, together with the costs."

2. *In suits in equity.*

Section 4921 provides:

"The several courts vested with jurisdiction of cases arising under the patent laws shall have power to grant injunctions according to the course and principles of courts of equity, to prevent the violation of any right secured by patent, on such terms as the court may deem reasonable; and upon a decree being rendered in any such case for an infringement the complainant shall be

352. Mr. Justice Miller, in Dow v. Humbert, 91 U. S. 294-303, 23 L. Ed. 368.

353. Diamond Stone Sawing Machine Co. v. Brown, 166 Fed. Rep. 306, 92 C. C. A. 224.

entitled to recover, in addition to the profits to be accounted for by the defendant, the damages the complainant has sustained thereby; and the court shall assess the same or cause the same to be assessed under its direction. And the court shall have the same power to increase such damages, in its discretion, as is given to increase the damages found by verdicts in actions in the nature of actions of trespass upon the case. But in any suit or action brought for the infringement of any patent there shall be no recovery of profits or damages for any infringement committed more than six years before the filing of the bill of complaint or the issuing of the writ in such suit or action, and this provision shall apply to existing causes of action."

From an examination and comparison of the terms of these sections we find that the pecuniary recovery of the owner of an infringed patent may be embraced in

1. Damages recoverable in an action at law.
2. Damages recoverable in a suit in equity.
3. Profits recoverable in a suit in equity.

These three matters will accordingly be treated in the order named.

§ 369. Damages in actions at law — The theory on which awarded.

In actions at law damages are awarded for the infringement of the right to make, the right to use, or the right to sell, upon the theory of compensating the holder of the patent for the injury he has suffered. Whether the infringer has profited by his infringing acts, is immaterial; if the defendant's profits are smaller than the damage sustained by the plaintiff, that fact does not diminish plaintiff's recovery,[354] nor will his recovery be

354. Emerson v. Simm, Fed. Case No. 4443, 6 Fisher 281; Goodyear Dental Vulcanite Co. v. Van Antwerp, Fed. Case No. 5600, 2 Bann. & Ard. 255.

enhanced by showing that the infringer's profits have exceeded his pecuniary loss.[355]

It is obvious that the proof of such loss is at times a matter of exceeding difficulty, owing to the various ways in which the owner of the patent may enjoy the benefits of the monopoly embodied in its grant. It is equally obvious that where his benefits have been derived through his licensing others to practice the invention of the patent, a rational measure of damage exists which, by reason of its facility and fairness, the courts are bound to follow.[356]

On the other hand, fairness to the infringer demands that the royalty be one that has been fairly established, under conditions which insure its reasonableness; and to this end we will inquire.

§ 370. What is an established royalty?

The general rule is that the royalty must have been fixed, that is, paid or secured, before the defendant's infringement occurred.[357]

To serve as a basis of recovery, a royalty must comply with the following further requirements:

355. Seymour v. McCormick, 57 U. S. (16 How.) 480, 14 L. Ed. 1024; New York City v. Ransom 64 U. S. (23 How.) 487, 16 L. Ed. 515; Packet Co. v. Sickles, 86 U. S. (19 Wall.) 611, 617, 22 L. Ed. 203.

356. This rule was established in Seymour v. McCormick, 57 U. S. (16 How.) 480, 14 L. Ed. 1024. It has been followed ever since. New York City v. Ransom, 64 U. S. (23 How.) 487, 16 L. Ed. 515; Packet Co. v. Sickles, 86 U. S. (19 Wall.) 611, 617, 22 L. Ed. 203; Birdsall v. Coolidge, 93 U. S. 64, 23 L. Ed. 802; Root v. R. Co., 105 U. S. 189, 197, 26 L. Ed. 975-978; Rude v. Westcott, 130 U. S. 152, 32 L. Ed. 888.

357. Rude v. Westcott, 130 U. S. 152, 32 L. Ed. 888; Adams v. Bellaire Stamping Co., 28 Fed. Rep. 360, 366; Houston, E. & W. T. Ry. Co. v. Stern, 20 C. C. A. 568, 74 Fed. Rep. 636, 640.

1. It must be uniform;[358] various licenses at varying rates cannot serve as a measure of damages.[359]

2. It must not have been paid in settlement of a past infringement.[360]

3. It must not have been reserved as part of the consideration for the sale of the patent.[361]

4. It must have related to the same right alleged to be invaded by the infringer; a royalty for the privilege of making and selling is therefore no measure of recovery where the defendant has merely made and used the infringing article; and if offered where the defendant has made and sold, it must have related to making and selling.[362]

§ 371. The measure of damages where no established royalty exists.

In the absence of an established royalty or license fee, the plaintiff in an action at law may show either of the following states of fact as a basis of recovery:

1. That plaintiff was able to supply the demand for the patented article, and that his trade therein was impaired by the infringer, either by a resulting diminution of sales which the plaintiff would otherwise have made, or by his being forced to lower his selling price by the unfair competition of the defendant.[363] Where there is but one infringer, or but one infringer in a particular

358. Rude v. Westcott, 130 U. S. 152, 32 L. Ed. 888; Westcott v. Rude, 19 Fed. Rep. 830, 833.

359. Black v. Munson, Fed. Case No. 1463, 14 Blatchf. 265; United Nickel Co. v. Central Pac. R. Co., 36 Fed. Rep. 186, 190.

360. Rude v. Westcott, 130 U. S. 152, 32 L. Ed. 888; Cornely v. Marckwald, 131 U. S. 159, 33 L. Ed. 117; United Nickel Co. v. Central Pac. R. Co., 36 Fed. Rep. 186, 190.

361. La Baw v. Hawkins, Fed. Case No. 7961; 2 Bann. & Ard. 561.

362. Colgate v. Western Elec. Mfg. Co., 28 Fed. Rep. 146-148.

363. Yale Lock Co. v. Sargent, 117 U. S. 536, 29 L. Ed. 954; Boesch v. Graff, 133 U. S. 697, 33 L. Ed. 787.

territory, the application of this rule is simple; otherwise, manifestly, it presents great practical difficulty.

2. That the defendant's purchasers would have bought from the plaintiff but for the defendant's infringing sales.[364]

3. That the defendant (where defendant merely used or sold) would have been supplied by plaintiff, had defendant not purchased the infringing article from another.[365]

4. That defendant's infringing competition compelled plaintiff to reduce his selling price,[366] and the extent to which it was reduced.[367]

§ 372. Damages based upon value of the invention at the time of the infringement.

In an action at law for damages for patent infringement, the value of the invention must be fixed as of the date of the alleged infringement. The reason for this doctrine has been thus developed by Judge Woods: "The plaintiff's counsel insists that no comparison shall be made with any implement that had not been in use, or been invented—if it was a patented implement—before the patent sued upon was issued. I am not able to agree fully with that position. The action being for damages (not profits), I suppose the defendants are liable—if they are liable for anything—for the value of the invention at the time they appropriated it. A patent issued on a particular day for a particular contrivance, might, with reference to the business of the community,

364. Dobson v. Dornan, 118 U. S. 10, 30 L. Ed. 63.

365. Rose v. Hirsch, 94 Fed. Rep. 177, 36 C. C. A. 132.

366. Holmes v. Truman, 67 Fed. Rep. 542, 545; 14 C. C. A. 517; Fitch v. Bragg, 16 Fed. Rep. 243; Yale Lock Manufacturing Co. v. Sargent, 117 U. S. 536, 29 L. Ed. 954.

367. Cornely v. Marckwald, 131 U. S. 159, 33 L. Ed. 117; Boesch v. Graff, 133 U. S. 697, 33 L. Ed. 787.

and the uses to which it could be put, be worth a given sum on that day and at that time. If it was the only contrivance that could be used to accomplish the purpose for which it was adapted, it would of course constitute a monopoly, and would command the market for whatever price should be fixed upon it. If shortly after it was invented and put into use some new contrivance, entirely different, and not infringing it in any respect, but useful for accomplishing the same purpose, should be invented and brought into use, it is evident that competition would arise, and the first patent, instead of then being the sole occupant of the field, would have to meet the competition of the new, and might not be worth so much as when it was first produced. I think the jury have the right to look to the facts as they existed at the time of the infringement. If the patent was useful when invented, and was an improvement of actual value over what then existed, the fact that something else was invented afterwards that was better than it, would not take away its entire value, so that the one who should prefer to use it or manufacture it could say, 'I shall pay nothing for that because I might have taken something better.' "[368]

§ 373. The effect of competing co-existing devices upon the measure of damages.

The existence of other means for accomplishing the same result may be considered in fixing the damages. It is obvious, however, that if such other machines or processes are covered by existing patents other than the one in suit, they should have negligible bearing as to a defendant who has merely elected to infringe the one in

368. National Car Brake Shoe Co. v. Terre Haute Car & Mfg. Co., 19 Fed. Rep. 514, 518.

suit. The rule is thus announced by Judge Woods: "A man who has a patent owns it as property, and if anybody sees fit to infringe he is bound to pay for its fair value; and the fact that there may be something else just as good as that or better does not destroy its value, but it may effect your judgment of what the actual value is. The fact that this company chose to make this implement, with the combined parts—that is, if you find those combined parts are an infringement of this patent—is conclusive upon the company that they regarded it as a valuable instrument, thus combined, and its actual value in use, under the circumstances existing at the time, the value of that combination, which constitutes the patent, should be awarded to the plaintiff in damages; but the existence of these other implements, patented or unpatented, is a matter that you have a right to consider in arriving at what your judgment of its actual value shall be. Of course, if the rival implements are patented, the existence of them could have no effect, or but little effect, upon the value of the invention in suit, except as they furnished competition in the market. If there existed some contrivance that was not patented at all, or that was free to everybody, which subserved substantially the same purpose, that might still further in your minds depreciate the value of this; but the mere fact that such a thing did exist would not destroy entirely, and could only be treated as modifying, the value of this at the time."[369]

§ 374. When proof of infringer's profits may be resorted to as a basis of assessing damages.

It is possible that where the facts of a case do not afford any other basis of assessing damages in an action

369. National Car Brake Shoe Co. v. Terre Haute Car & Mfg. Co., 19 Fed. Rep. 514, 519.

at law for patent infringement, the defendant's profits may be shown, and used as a basis for a judgment. The Supreme Court has stated this doctrine as follows: "Profits are not the primary or true criterion of damages for infringement in an action at law. That rule applies eminently and mainly to cases in equity, and is based upon the idea that the infringer shall be converted into a trustee, as to those profits, for the owner of the patent which he infringes; a principle which is very difficult to apply in a trial before a jury, but quite appropriate on a reference to a master, who can examine defendant's books and papers, and examine him on oath, as well as all his clerks and employees.

"On the other hand, we have repeatedly held that sales of licenses of machines, or of a royalty established, constitute the primary and true criterion of damages in the action at law.

"No doubt, in the absence of satisfactory evidence of either class in the forum to which it is most appropriate, the other may be resorted to as one of the elements on which the damages or the compensation may be ascertained; but it cannot be admitted, as the prayer which was refused implies, that in an action at law the profits which the other party might have made is the primary or controlling measure of damages."[370]

The rule thus announced should be considered in connection with the rule stated by the Supreme Court in another case, that "in cases where there is no established patent or license fee in the case, or even an approximation to it, general evidence must necessarily be resorted to."[371]

370. Mr. Justice Miller, in Burdell v. Denig, 92 U. S. 716-723, 23 L. Ed. 765, 766.

371. Suffolk Co. v. Hayden, 70 U. S. (3 Wall.) 315, 18 L. Ed. 76; quoted and followed in Washington Steam Packet Co. v. Sickles, 86 U. S. (19 Wall.) 611, 22 L. Ed. 203.

Both of the foregoing expressions amount to holding that an action for damages will not be rendered fruitless by the fact that the patent in suit has never acquired a fixed rate of royalty or license fee.

§ 375. The proceeding in equity—The basis of equitable jurisdiction.

The suit in equity for patent infringement is instituted by the filing of a bill of complaint, usually referred to tersely as a bill, in the office of the clerk of the District Court of the United States for the proper Federal Judicial District, and in the proper division of that district, if the district is divided.

The remedy at law, as we have seen, exists both by virtue of common-law and statutory authority. The remedy in equity is not limited, as is the remedy at law, to the recovery of damages for past infringements. It is based upon the broader grounds of avoiding a multiplicity of suits and vexatious litigation, of preventing threatened future injury, and the power inherent in courts of equity to compel discovery of the extent and manner of the alleged infringement, and the past gains and profits realized by the infringer.

There are two cogent reasons why a treatise of this specialized character should not enter upon a detailed consideration of the history, development and scope of the principles involved, in equitable suits for infringement; the first, that the ablest text-writers of Great Britain and America have exhaustively explored and developed the subject; the second, that the remedy in patent cases in the United States finds its express foundation in the statute. "Section 4921, R. S. U. S. The several courts vested with jurisdiction of cases under the patent laws shall have power to grant injunctions according to the course and principles of courts of equity, to prevent the violation of any right secured by patent,

on such terms as the court may deem reasonable; and upon a decree being rendered in any such case for an infringement the complainant shall be entitled to recover, in addition to the profits to be accounted for by the defendant, the damages the complainant has sustained thereby; and the court shall assess the same or cause the same to be assessed under its direction."

§ 376. The parties to the bill.

The parties plaintiff are the person or persons interested, whether as patentees, assignees or grantees of the exclusive right for a particular district.

If an assignee has the whole interest for a certain territory he may sue alone;[372] if less than the whole interest (a licensee) he must join the patentee, which he may do, whether the patentee is willing or unwilling.[373] The assignee having such whole interest, when suing jointly with the patentee, cannot have the benefit of a disclaimer filed by the patentee alone.[374] A mere licensee, though exclusive, must join the owner of the legal title,[375] a trustee must join his *cestui que trust*.[376] An executor or administrator must join the heirs or equitable owners of the patent.[377] The defendants in equity are substantially the same as in actions at law. Persons who have committed independent infringements cannot be joined as co-defendants.[378]

372. Waterman v. Mackenzie, 138 U. S. 252, 34 L. Ed. 923.

373. Excelsior Wooden Pipe Co. v. City of Seattle, 117 Fed. Rep. 140, 143, 55 C. C. A. 156.

374. Wyeth v. Stone, 1 Story 273, Fed. Case No. 18,107.

375. Nelson v. McMany, Fed. Case 10,109; Bowers Hydraulic Dredging Co. v. Vare, 112 Fed. Rep. 63, 64.

376. Dibble v. Augur, Fed. Case 3879.

377. Northwestern Fire Extinguisher Co. v. Philadelphia Fire Extinguisher Co., Fed. Case 10,337.

378. Woodworth v. Wilson, 4 How. 712, 11 L. Ed. 1171.

§ 377. The bill.

The bill should be addressed to the judges of the court in which it is filed, as provided by Equity Rule 20,[379] should recite the names of the parties (whose citizenship and residence are usually given, but are immaterial), should set out the fact of invention[380] prior to the application, the filing of that application, the fact that no application for foreign patent had been filed by the applicant or one in privity with him more than twelve months prior to the said application,[381] and that the subject-matter of the application had not been in public use or on sale for more than two years prior to said application,[382] and that it had not been previously patented or described in any printed publication in this or any foreign country.[383] It is unnecessary to allege that it had not been abandoned.[384]

Then follow recitals that the applicant complied with all the prerequisites imposed upon him by law, that the Letters Patent were issued in due form, attested by the proper officer,[385] on a given date, entitled by their short

379. As to the district, see The Judicial Code, ch. 5 and § 48; also ante, § 324.

380. The bill must recite that the applicant named was the original and first inventor. Tucker v. Tucker Mfg. Co., Fed. Case No. 14,227.

381. Victor Talking Machine Co. v. Leeds & Catlin Co., 165 Fed. Rep. 931, 934; contra, see American Cereal Co. v. Oriental Food Co., 145 Fed. Rep. 649. See § 4887, R. S. U. S.

382. Hayes-Young Tie Plate Co. v. St. Louis Transit Co., 137 Fed. Rep. 80, 81, 70 C. C. A. 1; Krick v. Jansen, 52 Fed. Rep. 823, 824; Nathan Mfg. Co. v. Craig, 47 Fed. Rep. 522, 524; Blessing v. John Trageser Steam Copper Works, 34 Fed. Rep. 753.

383. Diamond Match Co. v. Ohio Match Co., 80 Fed. Rep. 117; American Cable Ry. Co. v. City of New York, 42 Fed. Rep. 60; Overman Wheel Co. v. Elliott Hickory Cycle Co., 49 Fed. Rep. 859.

384. Warren Featherbone Co. v. Warner Bros. Co., 92 Fed. Rep. 990; Fichtel v. Barthel, 173 Fed. Rep. 489, 490.

385. Profert of the original patent obviates this requirement. Fichtel v. Barthel, 173 Fed. Rep. 489.

title (given verbatim), bearing a certain number, and that they were delivered to the patentee.

Beyond this it is unnecessary to set forth or quote from the contents of the patent, but profert of the original or a duly certified copy should be made,[386] and it is customary to attach to and file with the bill a printed, uncertified, Patent Office copy.

If the device of the patent has gone into considerable use, that fact and the extent of use may be recited. If the patent has been sustained in prior litigation, either at law or in equity, such prior judgment or decree may be pleaded.[387] Where the subject-matter of the patent in suit has been patented in foreign countries, whose patent departments make examinations as to novelty, the fact is sometimes recited in the bill as being confirmatory of the action of the United States Patent Office, and tending to fortify the *prima facies* of the patent in suit.

The bill should recite the present ownership of the patent rights necessary to maintain the bill by the complainant; it need not recite the chain of title.[388]

Any facts intimately relating to the patent in suit, such as a disclaimer, or its history prior to the reissue application, if it be a reissued patent, should be set out. Unless the patent in suit be for a process, or the bill shows that nothing has been made, used or sold under the authority of the patent, the marking or notice to the defendant, required by the statute (§ 4900, R. S. U. S.), should be pleaded.

The bill should then aptly charge the infringement.[389] If more than one patent is in suit the bill should aver

386. La Republique Francaise v. Schultz, 57 Fed. Rep. 37; Enterprise Mfg. Co. v. Snow, 67 Fed. Rep. 235.

387. Allis v. Stowell, 15 Fed. Rep. 242; Steam Gauge & Lantern Co. v. McRoberts, 26 Fed. Rep. 765.

388. Nourse v. Allen, Fed. Case No. 10367.

389. Infringement must be directly averred. A statement on

the subject-matter of the patents in suit to be capable of conjoint use in a single structure, and that the infringement embodies the claims of both, jointly infringed in and by a single structure.[390] The infringement should be specifically charged as to having been committed, being threatened, or both. If more than one defendant, the manner of participation of the defendants in the infringing acts (by making, using or selling), should be charged.[391] The inadequacy of the remedy at law should be alleged.[392]

The continuing nature of the infringement is usually alleged.

The prayer of the bill is for a discovery and answer (an answer under oath being usually expressly waived, as otherwise the cause may, at the defendant's election, be set down for hearing on bill and answer) to the bill, as well as to any interrogatories that may be set forth, numbered and signed by counsel; for a decree of injunction against the further continuance of the alleged infringement, for the impounding and destruction of the infringing articles,[393] for a reference to a master for accounting of profits and damages, and for a *subpoena ad respondendum* directed to the defendants.

information and belief is insufficient. Wyckoff v. Wagner Typewriter Co., 88 Fed. Rep. 515. But a statement that complainant is informed and believes, and therefore avers the fact to be, etc., or its equivalent, is sufficient. Fichtel v. Barthel, 173 Fed. Rep. 489, 491.

390. Kaiser v. Bortel, 162 Fed. Rep. 902, 907.

391. "Whoever invades any one of these rights is an infringer." Philadelphia Trust, etc., Co. v. Edison Elec. Light Co., 65 Fed. Rep. 551, 554, 13 C. C. A. 43.

392. Perry v. Corning, Fed. Case 11,004. The Judicial Code provides (§ 267) that "suits in equity shall not be sustained in any court of the United States in any case where a plain, adequate, and complete remedy may be had at law."

393. This practice is authorized, "when the whole machine is an infringement of the patent," by Birdsell v. Shaliol, 112 U. S. 485, 28 L. Ed. 768. To the same effect, see, American Bell Tel. Co. v. Kitsell, 35 Fed. Rep. 521, 523.

Every bill must have the signature of counsel annexed to it, "which shall be considered as an affirmation on his part that, upon the instructions given to him and the case laid before him, there is good ground for the suit in the manner in which it is framed" (Equity Rule 24).

If a preliminary injunction is sought, the prayer of the bill should so state, and the bill should be sworn to or supported by affidavit. Otherwise the affidavit is unnecessary.[394] A single bill may charge patent infringement and unfair competition without being multifarious.[395] But the defendant sued for patent infringement cannot have relief for unfair competition,[396] and a bill is multifarious that combines a charge of patent infringement with a charge of unfair competition which relates to acts done before the issuance of the patent.[397]

A bill is demurrable for multifariousness in which joint owners of one patent, one of whom is sole owner of another patent, charge the infringement of both patents. This is probably correct doctrine. In the single case in which it has been ruled, the bill alleged that both patents were capable of conjoint use in a single structure.[398]

Where one complainant was the sole owner of one patent in suit, and joint owner with his co-complainant of the other patent in suit, said co-complainant being an exclusive oral licensee under the former patent, and the

394. Shiras' Equity Practice, § 40; United States Mitis Co. v. Detroit Steel & Spring Co., 122 Fed. Rep. 863, 59 C. C. A. 589; Fichtel v. Barthel, 173 Fed. Rep. 489, 491.

395. Jaros Hygienic Underwear Co. v. Fleece Hygienic Underwear Co., 60 Fed. Rep. 622; Weed v. Gay, 160 Fed. Rep. 695.

396. George Frost Co. v. Kora Co., 140 Fed. Rep. 987, 71 C. C. A. 19.

397. Ball & Socket Fastener Co. v. Cohn, 90 Fed. Rep. 664, 665.

398. Kaiser v. Bortel, 162 Fed Rep. 902, 906.

defendant being found to infringe both patents in a single machine, the bill was held good on final hearing, the court remarking that "the entire right to both patents is in the plaintiffs, between them, without any outstanding interest to menace the defendant in any other suit."[399]

A bill is not multifarious which, in addition to the charge of patent infringement, sets out a contract between the complainant and one defendants whereby the defendants bound themselves not to contest the validity of the patent in suit.[400] The history of the invention, the prior history of the art, and its development through the inventions of the inventor of the patent in suit or others may all be properly averred in the bill.[401]

While a bill is not demurrable which charges the defendant with infringing "the claims" of a patent containing a plurality of claims, the court may, on motion, require the complainant to specify which claims he will attempt to prove to have been infringed.[402] A reference to the patent in suit by its date and its short title only, is insufficient and renders the bill defective; and that defect is not cured by the fact that the Letters Patent were filed on motion for preliminary injunction, as such filing does not make the Letters Patent part of the record.[403]

It has been held that the bill should, where the patent in suit has many claims, specify the claims alleged to be

399. Wheeler, J., in Sharples v. Moseley & Stoddard Mfg. Co., 75 Fed. Rep. 595.

400. Dunham v. Bent, 72 Fed. Rep. 60.

401. Steam Gauge & Lantern Co. v. McRoberts, 26 Fed. Rep. 765.

402. Russell v. Winchester Repeating Arms Co., 97 Fed. Rep. 634.

403. Electrolibration Co. v. Jackson, 52 Fed. Rep. 773.

infringed;[404] but that practice has been condemned in some jurisdictions as being improper save in exceptional cases.[405]

§ 378. Amendments to the bill and amended bills.

The equity rules relating to amendment of the bill are as follows:

28. The plaintiff shall be at liberty, as a matter of course, and without payment of costs, to amend his bill, in any matters whatsoever, before any copy has been taken out of the clerk's office, and in any small matters afterwards, such as filling blanks, correcting errors of dates, misnomer of parties, misdescription of premises, clerical errors and generally in matters of form. But if he amend in a material point (as he may do, of course) after a copy has been so taken, before any answer or plea or demurrer to the bill, he shall pay to the defendant the costs occasioned thereby, and shall, without delay, furnish him a fair copy thereof, free of expense, with suitable references to the places where the same are to be inserted. And if the amendments are numerous, he shall furnish, in like manner, to the defendant, a copy of the whole bill as amended; and if there be more than one defendant a copy shall be furnished to each defendant affected thereby.

29. After an answer, or plea, or demurrer is put in, and before replication, the plaintiff may, upon motion or petition, without notice, obtain an order from any judge of the court to amend his bill on or before the next succeeding rule day, upon payment of costs or without payment of costs, as the court or judge thereof may in his discretion direct. But after replication filed, the plain-

404. Russell v. Winchester Repeating Arms Co., 97 Fed. Rep. 634.

405. Johnson v. Columbia Phonograph Co., 106 Fed. Rep. 319.

tiff shall not be permitted to withdraw it and to amend his bill, except upon a special order of a judge of the court, upon motion or petition, after due notice to the other party, and upon proof by affidavit that the same is not made for the purpose of vexation or delay, or that the matter of the proposed amendment is material and could not with reasonable diligence have been sooner introduced into the bill, and upon the plaintiff's submitting to such other terms as may be imposed by the judge for speeding the cause.

The subject of amendment of equity pleadings is one concerning which rules are of small moment, as the principles upon which amendments are allowed were well settled in chancery practice long before the promulgation of our equity rules, and those principles, like the rules above quoted, left the matter to the discretion of the chancellor, with but small restriction. The foregoing rules relate solely, as their terms indicate, to amendments made before the hearing of the cause. Amendments may be made at any stage of equitable procedure, before or after the decree. "Allowing amendments is incidental to the exercise of all judicial power, and is indispensable to the ends of justice. Usually, to permit or refuse rests in the discretion of the court; and the result in either case is not assignable for error."[406]

In view of the limitless latitude assumed by applications for leave to amend, the courts have been cautious to confine their observations, in ruling upon applications for leave to amend, to the particular case at bar, realizing the inherent danger of generalizations. Mr. Justice Harlan is the author of the following brief epitome of the subject:

406. Mr. Justice Swayne, in Tilton v. Cofield, 93 U. S. (3 Otto) 163, 23 L. Ed. 858.

"In reference to amendments of equity pleadings, the courts have found it impracticable to lay down a rule that would govern all cases. Their allowance must, at every stage of the cause, rest in the discretion of the court; and that discretion must depend largely on the special circumstances of each case. It may be said, generally, that in passing upon applications to amend, the ends of justice should never be sacrificed to mere form, or by too rigid an adherence to technical rules of practice. Undoubtedly, great caution should be exercised where the application comes after the litigation has continued for some time, or when the granting of it would cause serious inconvenience or expense to the opposite side. And an amendment should rarely, if ever, be permitted where it would materially change the very substance of the case made by the bill, and to which the parties have directed their proofs."[407]

As an illustration of liberality in allowing amendments in patent cases, a bill charging infringement of an original patent, and filed after that original patent had been surrendered for reissue, and the reissue granted, was permitted to be amended to charge infringement of the reissue.[408]

After final hearing, where the complainant was defeated because he had declared only on his composition of matter patent, instead of joining a charge of infringement of the process patent, which covered the method of producing the composition of matter, he was permitted to amend to bring in the charge of infringement of the process patent, on terms of his obligation to pay all the costs of the further testimony for both parties.[409]

407. Hardin v. Boyd, 113 U. S. 756, 28 L. Ed. 1141.

408. Reay v. Raynor, 19 Fed. Rep. 308.

409. Underwood v. Gerber, 37 Fed. Rep. 796; a noteworthy case. See Underwood v. Gerber, 37 Fed. Rep. 682.

Under Equity Rule 28, an amendment of the bill before answer, plea or demurrer filed is a matter of course, and the amendment requires no supporting affidavit.[410]

The latitude to be allowed in amending the bill is not enlarged by the fact that the defendant has appeared to the action. In a case where two defendants, one a resident individual, and the other a non-resident corporation, were charged by the bill with having conspired and confederated together to infringe the patents in suit within the district by using and causing to be used structures furnished by the corporation to the individual, we find exhibited a proper restriction of the right to amend. The defendant corporation having appeared to the action, and having filed, with its co-defendant, a joint and several answer, the complainant moved for leave to amend, first, by dismissing the bill as to the individual defendant; and, second, by substituting for the original charge of conspiracy to infringe by use, a charge that the defendant corporation had infringed in the district and elsewhere in the United States, by making, using, and selling. In denying the motion, Judge Chatfield said: "The purpose of the amendment asked here is not merely to substitute a different cause of action, with additional parties. It is an attempt to bring in alleged causes of action which could not have been brought for lack of jurisdiction in the district where this suit was begun. The sole ground for this attempt to try other suits than the one stated is the argument that the defendant in the particular action has waived his right to object to the jurisdiction of that action by general appearance. The effect of granting the present motion would be to remove the defendant Gahagan from the ac-

410. Chase Electric Const. Co. v. Columbia Const. Co., 136 Fed. Rep. 699.

tion, and to allow every infringement by the defendant company of the two patents claimed by the complainant to be tried in this district and in this suit."[411]

§ 379. The distinction between an amended bill and amendments to the bill.

As to the distinction between an amended bill and amendments to the bill, amendments to the original bill become incorporated in that bill, and take effect as of the date of its filing; while an amended bill supersedes the original bill, and its averments speak as of the later date, of its own filing.[412]

§ 380. Has the defendant the right to compel the complainant to amend his bill?

While there are open to the defendant the methods of attacking the bill by demurrer and exceptions, it seems to be settled that the defendant has no right by motion to compel the complainant to amend his bill. Judge Sanborn has said that "in a suit in equity the defendant has no right to have plaintiff amend his bill, nor is it required of him so to do, nor to expose defects or supposed defects in his case."[413]

This doctrine is frequently invoked in patent causes in response to the defendant's motion to compel the complainant to specify which of the several claims of the patent in suit are charged to be infringed. It is not necessary that the bill should so state, in order to be good against demurrer.[414] It follows, under the equity plead-

411. Western Wheeled Scraper Co. v. Gahagan, 152 Fed. Rep. 648, 651.

412. Columbia Valley R. Co. v. Portland & S. Ry. Co., 162 Fed. Rep. 603, 609, 89 C. C. A. 361.

413. North Chicago Street R. Co. v. Chicago Union Traction Co., 150 Fed. Rep. 612, 634; to the same effect, see, Phelps v. Elliott, 26 Fed. Rep. 881, 883.

414. American Bell Tel. Co. v. Southern Tel. Co., 34 Fed. Rep. 803; Morton Trust Co. v. American Car & Foundry Co., 121 Fed. Rep. 132.

ing above stated that the defendant cannot compel the complainant to amend his bill in this respect.[415] The case of Russell v. Winchester Repeating Arms Co. (97 Fed. Rep. 634) sometimes cited in support of such motions is not authoritative, as its syllabus is not sustained by the text of the opinion; the court ordered the complainant to so amend his bill in response to a stipulation of the parties.

§ 381. Amendment of the bill in response to the answer.

The abolition of special replications by Rule 45 has led to wide latitude for the purpose of introducing response to the matter in the bill, which formerly could be pleaded in the replication. The rule reads:

"45. No special replication to any answer shall be filed. But if any matter alleged in the answer shall make it necessary for the plaintiff to amend his bill, he may have leave to amend the same, with or without the payment of costs, as the court, or a judge thereof, may in his discretion direct."

Under this rule the complainant should petition for leave to file the amended bill, but if no objection is made in the trial court to the filing of the amended bill without leave, the objection is waived and cannot be taken upon appeal.[416] The rule probably contemplates amendment of the bill, rather than the filing of an amended bill.[417]

415. Thatcher Heating Co. v. Carbon Stove Co., 4 B. & A. 68, Fed. Case 13,864; Morton Trust Co. v. American Car & Foundry Co., 129 Fed. Rep. 916, 64 C. C. A. 367; Johnson v. Columbia Phonograph Co., 106 Fed. Rep. 319.

416. Clements v. Nicholson, 73 U. S. (6 Wall.) 299, 18 L. Ed. 786.

417. Wilson v. Stolly, 4 McLean 275, Fed. Case 1963; Coleman v. Martin, 6 Blatchf. 291, Fed. Case 2986.

§ 382. Supplemental bills.

Of the function and nature of the supplemental bill, Mr. Justice McLean has said "a supplemental bill is filed on leave, and for matter happening after the filing of the bill, and is designed to supply some defect in the structure of the original bill."[418] Bouvier defines it as "a bill brought as an addition to an original bill to supply some defect in its original-frame or structure which cannot be supplied by amendment."[419] Judge Hazel has said: "It is elementary that any matter which has happened since the filing of the bill may be brought in by supplemental bill. It has been held in this circuit (the Second) that facts accruing after the filing of the original bill, showing, for instance, infringement, of a patented device by the subsequently modified structure, where there was infringement before suit was brought, did not warrant filing a supplemental bill.[420] In such cases the scope of the original bill is deemed broad enough to include later charges of infringement, and, if the evidence under the original bill establishes the wrongful acts, the new infringing acts are provable upon the accounting, and proper relief may be afforded. * * * The law abhors a multiplicity of suits; and when the parties are the same, and the subject-matter is of the same general character, courts will be slow to refuse leave to aver in an amended or supplemental bill additional actionable facts which will assist in a final disposition of the grievances which are the subject of the litigation. Although the allegations of later infringements are separate and distinct from earlier assertions of infringement, yet they are not so inseparable, when al-

418. Kennedy v. Bank of Georgia, 8 How. 586, 610, 12 L. Ed. 1209, 1218.

419. Bouvier, Dict. 1071, Title "Supplemental Bills."

420. Westinghouse Air Brake Co. v. Christensen Engineering Co., 121 Fed. Rep. 558.

leged in a supplemental bill, as to entirely preclude a determination in the pending action."[421]

Judge Shelby has dealt with the subject lucidly, as follows: "If he (the complainant) had no cause of action (at the time of the filing of the original bill), he cannot, by amendment or supplemental bill, introduce a cause of action that accrued thereafter, even though it arose out of the same transaction that was the subject of the original bill.[422] But where a cause of action exists at the filing of the bill which is defectively presented by the bill, the defects may be remedied by amendment (Equity Rules 28, 29), and matters occurring after the filing of the bill may be presented by supplemental bill.[423] Where material facts have occurred subsequent to the beginning of the suit, the court may give the plaintiff leave to file a supplemental bill, and where such leave is given the court will permit other matters to be introduced into the supplemental bill which might have been incorporated in the original bill by way of amendment.[424] But in cases where the plaintiff had no cause of action when the bill was filed, neither amendment nor supplemental bill presenting occurrences subsequent to the filing of the bill can prevent its dismissal."[425]

A supplemental bill cannot properly be employed to bring into a pending case the reissue of the original patent in suit, but the irregularity may be waived by the respondent, by pleading to the supplemental bill.[426]

421. Banks Law Pub. Co. v. Lawyers' Co-operative Pub. Co., 139 Fed. Rep. 701.

422. Citing, Straughan v. Hallwood, 30 W. Va. 274, 4 S. E. Rep. 394, 8 Am. St. Rep. 29; Hill v. Hill, 10 Ala. 527.

423. Citing, Hoxie v. Carr, 1 Sumn. 173, Fed. Case 6802; Jenkins v. International Bank of Chicago, 127 U. S. 484, 32 L. Ed. 189.

424. Stafford v. Howlett, 1 Paige, Ch. 200.

425. Mellor v. Smither, 114 Fed. Rep. 116, 120, 52 C. C. A. 64.

426. Kennedy v. Scott, 90 U. S. (23 Wall.) 352, 23 L. Ed. 109.

The 57th Equity Rule provides as follows:

Whenever any suit in equity shall become defective from any event happening after the filing of the bill (as, for example, by change of interest in the parties), or for any other reason, a supplemental bill, or a bill in the nature of a supplemental bill, may be necessary to be filed in the cause, leave to file the same may be granted by any judge of the court on any rule day, upon proper cause shown and due notice to the other party. And if leave is granted to file such supplemental bill, the defendant shall demur, plead, or answer thereto on the next succeeding rule day after the supplemental bill is filed in the clerk's office, unless some other time shall be assigned by a judge of the court.

Of this rule Judge Hammond has said: "Considering the time of the promulgation of that rule, and its place in the code of rules designed to regulate our practice, I am led to believe that it relates as well to defects arising from the voluntary alienation of interests by the deed or contract of the parties, as to those defects arising from the devolution of any interest by operation of law. The language of the rule is broad enough to cover all such defects, and, being a rule of practice, it is best to so liberally construe it as to include all."[427]

The granting of leave to file a supplemental bill is discretionary with the trial court.[428] The application for leave to file it should be made as soon as the new matter sought to be pleaded by it is discovered, and if it relates to facts which were in existence and known to the complainant at the time of the filing of the original bill, the application should be denied.[429] The application

427. Hazleton Tripod Boiler Co. v. Citizens' St. R. Co., 72 Fed. Rep. 325, 327.

428. Sheffield & B. Coal I. & R. Co. v. Newman, 77 Fed. Rep. 787.

429. City of Omaha v. Redick, 63 Fed. Rep. 1, 5, 11 C. C. A. 1.

should be made by petition, which should state the grounds for the application.[430]

It is provided by the 58th Equity Rule that, "it shall not be necessary in any * * * supplemental bill to set forth any of the statements in the original suit, unless the special circumstances of the case may require it." Speaking of a supplemental bill that embraced 178 pages of typewritten matter Judge Hawley said:

"A supplemental bill should state the original bill and the proceedings thereon, and, if it is occasioned by any event subsequent to the original complaint, it must state that event, and the consequent alteration with respect to the parties. There was no necessity to copy the original or amended complaint or answer in the supplemental bill; nor was it absolutely essential that the agreements, contracts, deeds, leases, and other documents should be copied in *haec verba* in the bill. A plain, clear and concise statement of the facts as to the existence, character, and substance of these documents would have been sufficient. By a strict observance of this rule, it is safe to say that all the necessary and essential facts could easily have been stated with legal accuracy in less than one-half the space covered by the present bill. But the fact that they are set out in *haec verba* furnishes no substantial reason for expunging them from the record. They do not contain any irrelevant matter. They are all pertinent to the issues raised. Equity Rule 58 was adopted in order to relieve the pleader from copying the formal pleadings *in haec verba*."[431]

Under the general rule above considered, that the supplemental bill cannot make good a case which was bad in its inception, Judge Acheson has said "a plaintiff can-

430. Parkhurst v. Kinsman, 2 Blatchf. 72, Fed. Case 10,758.

431. Nevada Nickel Syndicate v. National Nickel Co., 86 Fed. Rep. 486, 487.

not support a bad title by acquiring another after the filing of the original bill, and bringing it in by supplemental bill."[432]

§ 383. Original bills in the nature of supplemental bills.

Bills of this character have been aptly distinguished from supplemental bills by Judge Woods: "The right to introduce new parties, or to substitute one party for another, in equity, when there has been a change of interest pending the suit, is so well recognized that the books treat not so much of the right as of the method of accomplishing the substitution. It is done either by a supplemental bill, or by an original bill in the nature of a supplemental bill—the former being applicable properly to those cases where the same parties or the same interests remain before the court, while the latter is properly applicable when new parties, with new interests arising from events since the institution of the suit, are brought before the court. If a complainant, suing in his own right, parts with less than his entire interest, or if he is deprived of his entire interest but he is not the sole complainant, the defect in either case may be supplied by means of a supplemental bill. But if a sole complainant suing in his own right is deprived of his whole interest, as in the case of bankruptcy, or if he assigns his whole interest to another, he is no longer able to prosecute the suit, for want of interest, and the assignee may be made complainant in his stead; but, as the title of the latter may be litigated, the substitution must be accomplished by means of an original bill in the nature of a supplemental bill."[433]

Accordingly, where it appears upon appeal that the patent in suit has been assigned pending the suit, and

432. Emerson v. Hubbard, 34 Fed. Rep. 327.

433. Ross v. City of Ft. Wayne, 63 Fed. Rep. 466, 470, 11 C. C. A. 288.

the assignee has not become a party, the appellate court may by mandate instruct the Circuit Court to permit the assignee to file an original bill in the nature of a supplemental bill within a designated time, and, if the assertion of title so made be not successfully attacked, to enter a decree in favor of the assignee.[434]

It is no objection to a bill of this character that it is filed by a corporation, as assignee of the patent in suit, where the assignment shows grantees other than the original complainants; as, if the complainants were not the sole owners of the patent at the time of the filing of the bill, that defense could be availed of as fully as it could against the original bill.[435]

§ 384. Supplemental bills in the nature of bills of review.

A supplemental bill in the nature of a bill of review may be employed after an interlocutory decree, to bring newly discovered evidence before the court; it differs from a bill of review in that the latter cannot be filed until after a final decree.[436] If such a bill is sought to be filed after an appeal has been heard and decided, affirming the interlocutory decree, the application for leave to present the petition to the Circuit Court should be made to the appellate court, even after the issuance of the mandate, and after the expiration of the term at which the judgment was rendered.[437]

In the Sixth Circuit it has been held that a petition for a rehearing is the proper method of broaching the introduction of newly discovered evidence, after the interlocutory, and before the final, decree.[438]

434. Ecaubert v. Appleton, 67 Fed. Rep. 917, 924, 15 C. C. A. 73.

435. Haarmann-De Laire-Schaffer Co. v. Leuders, 135 Fed. Rep. 120.

436. In re Gamewell Fire Alarm Tel. Co., 73 Fed. Rep. 908, 912, 20 C. C. A. 111.

437. In re Gamewell Fire Alarm Tel. Co., 73 Fed. Rep. 908, 20 C. C. A. 111; Municipal Signal Co. v. Gamewell Fire Alarm Tel. Co., 77 Fed. Rep. 452.

438. C. & A. Potts & Co. v. Creager, 71 Fed. Rep. 574.

§ 385. Bills of revivor.

A bill of revivor is the pleading employed in equity to advise the court of the abatement of the cause by the marriage, death or dissolution of a party to the cause, and to secure the continuation of the cause in the names of those succeeding in interest to the party whose death or change of status has caused the abatement.

"The death of either party pending the suit does not, where the cause of action survives, amount to a determination of the suit. It might in suits at common law, upon the mere principles of that law, have produced an abatement of the suit, which would have destroyed it. But in courts of equity, an abatement of the suit by the death of a party has always been held to have a different effect; for such abatement amounts to a mere suspension, and not to a determination of the suit. It may again be put in motion by a bill of revivor, and the proceedings being revived, the cause proceeds to its regular determination as an original bill. The bill of revivor is not the commencement of a new suit, but is the mere continuation of the old suit. It is upon a ground somewhat analogous that the Circuit Courts are held to have jurisdiction in cases of cross bills and injunction bills, touching suits and judgments already in those courts; for such bills are treated not strictly as original bills, but as supplementary or dependent bills, and so properly within the reach of the court; although the defendant (who was plaintiff in the original suit) lives out of the jurisdiction."[439] The practice as to bills of revivor in the Federal courts is regulated by the provisions of Equity Rule 56, which is as follows:

439. Mr. Justice Story, in Clarke v. Mathewson, 12 Peters 164, 171, 9 L. Ed. 1041, 1044. To the same effect, see, Hone v. Dillon, 29 Fed. Rep. 465, 468; Brooks v. Laurent, 98 Fed. Rep. 647, 652, 39 C. C. A. 201.

"56. Whenever a suit in equity shall become abated by the death of either party, or by any other event, the same may be revived by a bill of revivor, or a bill in the nature of a bill of revivor, as the circumstances of the case may require, filed by the proper parties entitled to revive the same, which bill may be filed in the clerk's office at any time; and upon suggestion of the facts, the proper process of subpoena shall, as of course, be issued by the clerk, requiring the proper representatives of the other party to appear and show cause, if any they have, why the cause should not be revived. And if no cause shall be shown at the next rule day which shall occur after fourteen days from the time of the service of the same process, the suit shall stand revived, as of course."

Suits for patent infringement are not terminated by the death of the plaintiff [440] or the defendant.[441]

Upon the death of the plaintiff the cause may be prosecuted to final judgment or decree by his personal representatives,[442] while the estate of a deceased defendant is liable for the profits and damages which would have been recoverable against him, and the estate is reached by the continued prosecution of the suit against his personal representatives.[443]

So when a defendant corporation is dissolved pending the suit for infringement, the suit does not abate, and will proceed by the bringing in, by a bill of revivor, or a supplemental bill in the nature of a bill of revivor, the statutory assignee [444] or receiver [445] of the corporation.

440. Illinois Cent. R. Co. v. Turrill, 110 U. S. 301, 28 L. Ed. 154; May v. Logan Co., 30 Fed. Rep. 250.

441. Kirk v. Dubois, 28 Fed. Rep. 460; Hohorst v. Howard, 37 Fed. Rep. 97; Head v. Porter, 70 Fed. Rep. 498.

442. Illinois Cent. R. Co. v. Turrill, 110 U. S. 301, 28 L. Ed. 154.

443. Head v. Porter, 70 Fed. Rep. 498.

444. Chester v. Life Assn. of America, 4 Fed. Rep. 487.

445. Griswold v. Hilton, 87 Fed. Rep. 256.

The court has no power to compel a plaintiff to revive a suit interrupted by the death or dissolution of a defendant; he may revive the suit or not, as he chooses.[446] But if he elects to revive the suit he is entitled to do so as a matter of right.[447]

Where the patent in suit is assigned pending the suit, the assignee properly succeeds the original complainant by an original bill in the nature of a supplemental bill.[448] Equity Rule 58 provides that "it shall not be necessary in any bill of revivor * * * to set forth any of the statements in the original suit, unless the special circumstances of the case may require it."

§ 386. Restraining orders.

Upon the filing of the bill, if the exigencies of the case are sufficiently urgent, the complainant will present the bill and supporting affidavits to the court, and move for a temporary restraining order, without notice, under the provisions of § 718, R. S. U. S.

§ 718. Whenever notice is given of a motion for an injunction out of a circuit or district court, the court or judge thereof may, if there appears to be danger of irreparable injury from delay, grant an order restraining the act sought to be enjoined until the decision upon the motion; and such order may be granted with or without security, in the discretion of the court or judge.

This section unqualifiedly gives to the District Court the power to grant restraining orders without notice in any urgent case. But even in the absence of this section there is no doubt of the power conferred by § 4921, R. S U. S., to grant such orders in patent cases without previous notice.[449]

446. Chester v. Life Assn. of America, 4 Fed. Rep. 487, 489.

447. Fitzpatrick v. Domingo, 14 Fed. Rep. 216, 217.

448. Haarmann-DeLaire-Schaffer Co. v. Leuders, 135 Fed. Rep. 120.

449. Yuengling v. Johnson. 1 Hughes 607, Fed. Case 18,195.

As used in this section, the word "whenever" means "at" whatever time the notice is given, and does not mean "after" that time. The restraining order may be, therefore, and in practice usually is, granted and issued simultaneously with the rule upon the defendant directing him to show cause why a preliminary injunction should not issue.[450] This is properly done wherever the very act of giving notice to the defendant of the complainant's intention to make the motion for preliminary injunction might itself precipitate the mischief whose commission is sought to be restrained.[451]

A district judge is powerless to entertain such an application save in his own district, or a district in the same circuit to which he is assigned by the circuit judge or circuit justice, or the Chief Justice of the United States (§§ 591, 592, 593, R. S. U. S.).

When sitting in his own district or one to which he has been properly assigned his authority in holding circuit court is coextensive with that of a circuit judge or circuit justice.

The purpose of the restraining order contemplated by § 718, R. S. U. S., is to prevent threatened injury until the motion for preliminary injunction can be heard. "A restraining order is substantially the same thing as a preliminary injunction, and its essential characteristic is that it is granted until notice can be given."[452]

The restraining order is limited in its duration to the time during which the motion for preliminary injunction is pending. If that motion is granted, the preliminary injunction takes the place of the restraining order; if de-

450. Yuengling v. Johnson, 1 Hughes 607, Fed. Case 18,195.

451. United States v. Coal Dealer's Assn., 85 Fed. Rep. 252.

452. Elliott, General Practice, § 390.

nied, the restraining order is usually vacated and set aside in express terms.

"The function of a restraining order is to protect the plaintiff, without unnecessarily oppressing or annoying the defendant. * * * Hence, the form of the order varies with the circumstances."[453]

§ 327. The application for preliminary injunction.

The moving papers upon an application for preliminary injunction comprise the bill of complaint (which should preferably be verified),[454] affidavits upon the merits, and a motion which usually recites the reasons for the application with greater fullness and detail than the allegations of the bill.

Upon the presentation of these documents, and any accompanying exhibits, to the court, or a single judge thereof in vacation, an order is issued addressed to the parties defendant directing them at a time and place therein named to show cause why a preliminary injunction should not issue as moved. All of these documents, including the order to show cause, are then served upon the parties defendant, such service being usually made by the marshal. If the case is of such urgency that a restraining order has been issued, that order will usually be served at the same time.

While affidavits upon the facts are necessary, they cannot so amplify the allegations of the bill as to sustain an application for preliminary injunction if the bill's averments are too indefinite.[455]

The affidavits used upon the application must be entitled in the cause, as otherwise they are mere extra-

453. Treat, J., in Kirby Bung Mfg. Co. v. White, 1 Fed. Rep. 604, 605.

454. The affidavit may take the place of a verification. Smith v. Schwed, 6 Fed. Rep. 455.

455. Leo v. Union Pac. Ry. Co., 17 Fed. Rep. 273.

judicial oaths upon which perjury cannot be assigned.[456] It cannot be properly entitled in the cause until the bill is filed.[457] Consequently affidavits made prior to the filing of the bill are not competent. They are frequently used without objection, but will always be excluded if timely objection is interposed.

The defense may respond to the order to show cause by plea, answer, demurrer to the bill or counter-affidavits. If such affidavits introduce new matter in avoidance of the complainant's allegations, leave to file rebuttal affidavits may be given; affidavits in sur-rebuttal are not usually permitted.[458] The summary nature of the proceedings are such as to require strict enforcement of the time limits assigned for the filing of affidavits; when filed out of time, without a stipulation or an order of the court permitting it, they will not be considered.[459]

§ 388. Preliminary injunctions.

The granting or withholding of interim relief by way of preliminary injunction in patent cases does not differ in the least from the administration of such relief in other cases.

The broad principle is that "the right must be clear, the injury impending and threatened, so as to be averted only by the protecting preventive process of injunction."[460]

Applying these requirements to the showing made of infringement of a patent, on motion for preliminary

456. Buerk v. Imhaeuser, Fed. Case 2107a; Goldstein v. Whelan, 62 Fed. Rep. 124.

457. Baldwin v. Bernard, Fed. Case 797.

458. Day v. New England Car Co., 3 Blatchf. 154, Fed. Case 3686; Benbow-Brammer Co. v. Simpson Mfg. Co., 132 Fed. Rep. 614.

459. American Paper Barrel Co. v. Laraway, 28 Fed. Rep. 141.

460. Mr. Justice Grier, in Truly v. Wanzer, 5 Howard 141, 142, 12 L. Ed. 88, quoting from Baldwin's Rep. 218.

injunction, the following conclusions are justified. The right must be clear. Before the right can be clear it must be shown that the complainant's legal or equitable title to the patent is unclouded.[461]

The next consideration is more difficult; namely, what evidence of the validity of the patent is required to make the complainant's right clear in that respect?

The fact that a patent has not been adjudicated "is not sufficient ground for refusing preliminary injunction, unless there is some substantial question as to validity."[462] "When the specification shows that, assuming facts of common knowledge, it will probably need some affirmative evidence to indicate the presence of invention, or when some testimony put in by defendant as to prior state of the art, slight though it be, indicates that there may be some arguable question as to validity, or as to a construction of the claims broad enough to cover the device complained of, then preliminary injunction on affidavits is refused. But where the patent appears to be novel, useful, and ingenious, and there is no evidence at all assailing its validity, the presumption arising from issue of letters patent will be sufficient to warrant injunctive relief. The same rule should apply where the sole evidence as to prior art is wholly unpersuasive."[463]

"It cannot be denied that a preliminary injunction may properly issue in a patent suit, where the validity of the patent is clear, although it has not been sustained by a prior adjudication or public acquiescence."[464]

461. Nilsson v. Jefferson, 78 Fed. Rep. 366.

462. Lacombe, J., in Lambert Snyder Vibrator Co. v. Marvel Vibrator Co, 138 Fed. Rep. 82.

463. Lacombe, J., in Fuller v. Gilmore, 121 Fed. Rep. 129, 130.

464. Putnam, J., in Wilson v. Consolidated Store Service Co., 88 Fed. Rep. 286, 287, 31 C. C. A. 533.

In the cases last quoted from, the patents in suit were of recent date, and this fact is noted by the court in connection with the quoted dicta. But the dicta as they stand above are undoubtedly sound, even though they may not be in accord with the bulk of the modern decisions. The argument that a preliminary injunction should never be granted upon a patent unless it has been adjudicated, though often made, and often effective, disregards the *prima facies* which attend the grant of a patent. The courts in denying the motion have often said in substance that the motion must be denied in the absence of former adjudication "or unless it be shown by clear and satisfactory evidence that the patent is valid."[465] To formal statements of this kind no technical objection can be made. They state the rule correctly. But what of the *prima facies* of the patent? True, the presumptions raised by the grant are slight, but they are entitled to consideration for what they are worth.

A decision in an interference is a sufficient adjudication to serve as the foundation of a motion for preliminary injunction by the successful against the losing parties,[466] though it cannot be so used in a suit against one who was a stranger to the interference.[467]

A judgment or decree sustaining a patent, from which an appeal has been taken, loses its weight as a former adjudication, pending the determination of the appeal.[468]

On a motion for preliminary injunction a prior adjudication sustaining the patent in suit is conclusive as to its validity unless a new defense is interposed by

465. Bowers Dredging Co. v. New York Dredging Co., 77 Fed. Rep. 980, 984.

466. Celluloid Mfg. Co. v. Chrolithian Collar & Cuff Co., 24 Fed. Rep. 275.

467. Wilson v. Consolidated Store Service Co., 88 Fed. Rep. 286, 31 C. C. A. 536.

468. Bowers Dredging Co. v. New York Dredging Co., 77 Fed. Rep. 980, 984.

evidence persuasive that, if employed in the former case, it would have changed the result.[469]

In the absence of former adjudication, long recognition by a trade or industry of the utility and value of the patent, or the continued acquiescence of the public may be deemed the equivalent of such an adjudication for the purpose of the motion for preliminary injunction.[470] It will be noticed that this recognition or acquiescence is somewhat hazy and nebulous. Read with close scrutiny it is dangerously near a judicial proclamation of one law for the poor, another for the rich patentee. The one of limited means and local business has but small chance of proving public acquiescence or recognition, while the large producer, engaged in interstate business and employing national advertising, so strong financially that his competitor is afraid to risk infringing his patents, falls automatically within the purview of the rule.

"The special presumption of the validity of the patent arising from public acquiescence is not indulged, unless such acquiescence exists when it would not be for the interest of manufacturers and users that it should be yielded, and so exhibiting a genuine conviction of the validity of the patent based upon investigation, and

469. Doig v. Morgan Mach. Co., 91 Fed. Rep. 1001, 33 C. C. A. 683; Bresnahan v. Tripp Giant Leveler Co., 72 Fed. Rep. 920, 19 C. C. A. 237.

470. Edward Barr Co. v. New York & N. H. Automatic Sprinkler Co., 32 Fed. Rep. 79; Hat Sweat Mfg. Co. v. Davis Sewing Mach. Co., 32 Fed. Rep. 401; Raymond v. Boston Woven Hose Co., 39 Fed. Rep. 365; National Cash Register Co. v. Boston Cash Indicator & Recorder Co., 41 Fed. Rep. 144; Standard Elevator Co. v. Crane Elevator Co., 56 Fed. Rep. 718, 6 C. C. A. 100; Williams v. Breitling Metal Ware Mfg. Co., 77 Fed. Rep. 285, 23 C. C. A. 171; St. Louis Street Flushing Mach. Co. v. Sanitary Street Flushing Mach. Co., 161 Fed. Rep. 725, 88 C. C. A. 585.

continuing for such length of time, that it may be said the conviction was generally entertained."[471]

Proof of acquiescence must be convincing as to the nature and extent of the acquiescence. "While acquiescence, even of a qualified or doubtful nature, may give aid to a patent on a final hearing, yet, when relied on to support a temporary injunction it must be clear in its character and extent."[472]

To give the complainant the right to the preliminary injunction there must be no doubt as to the existence, past, present or threatened, of the infringement. "It is not essential that there shall have been any actual infringement, in order to entitle a complainant to an injunction. The selling and offering for sale (of parts or elements) with the intent and purpose to bring about an infringement are enough to entitle complainant to an injunction to prevent the threatened injury."[473] It is no defense to the motion that the defendant, who has manufactured the infringing article for sale, and advertised it for sale, has not used or sold any of them,[474] nor is it a defense that the extent of the infringement is small,[475] or that the defendant does not intend to make further use of the infringing machine still in his possession.[476]

471. Jenkins, J., in George Ertel Co. v. Stahl, 65 Fed. Rep. 519, 521, 13 C. C. A. 33.

472. Putnam, J., in Wilson v. Consolidated Store Service Co., 88 Fed. Rep. 286, 290, 31 C. C. A. 533.

473. Lurton, J., in Rupp & Wittgenfeld Co. v. Elliott, 131 Fed. Rep. 730, 733, 65 C. C. A. 544; citing and following, Thomson-Houston Electric Co. v. Kelsey Electric Ry. Co., 75 Fed. Rep. 1005, 1008, 22 C. C. A. 1; Thomson-Houston Electric Co. v. Ohio Brass Co., 80 Fed. Rep. 712, 722, 26 C. C. A. 107; Wallace v. Holmes, Fed. Case 17,100.

474. Butz Thermo-Electric Regulator Co. v. Jacobs Electric Co., 36 Fed. Rep. 191.

475. Carter & Co. v. Wollschlaeger, 53 Fed. Rep. 573.

476. Sawyer Spindle Co. v. Turner, 55 Fed. Rep. 979; Celluloid Mfg. Co. v. Arlington Mfg. Co., 34 Fed. Rep. 324; New York Filter Mfg. Co. v. Chemical Bldg. Co., 93 Fed. Rep. 827.

On the motion for preliminary injunction the former adjudication will not avail the complainant if the issues as to infringement are not identical with those in the former litigation;[477] and the motion will be denied when the proof of infringement is not clear and convincing.[478]

A decree by consent is not the equivalent of an adjudication resulting from a bona fide contest, so as to serve as the foundation for obtaining a preliminary injunction.[479]

Wherever the right to a preliminary injunction is not clear, under the rules we have considered, the motion for injunction should be denied. There must be, in the language of Judge (now Mr. Justice) McKenna, "a clear title and a clear detriment. An injunction certainly interrupts action. It may interrupt rights, and therefore do, instead of preventing, an irreparable injury, unless great care be used."[480]

Some of the elements which have led courts to refuse preliminary injunctions in patent cases may profitably be considered. Irreparable damage being an indispensable element in an application for provisional injunction,[481] the application, in any but a perfectly clear case, will be denied where the defendant is financially responsible, and the complainant is sure of adequate compensation should he prevail on final hearing of the case.[482] Especially does the consideration of the financial responsi-

477. Hatch Storage Battery Co. v. Electric Storage Battery Co., 100 Fed. Rep. 975, 41 C. C. A 133.

478. Whippany Mfg. Co. v. United Indurated Fibre Co., 87 Fed. Rep. 215, 30 C. C. A. 615, reversing, United Indurated Fibre Co. v. Whippany, 83 Fed. Rep. 485.

479. De Ver Warner v. Bassett, 7 Fed. Rep. 468.

480. Nilsson v. Jefferson, 78 Fed. Rep. 366.

481. Pullman v. B. & O. R. Co., 5 Fed. Rep. 72; New York Grape Sugar Co. v. American Grape Sugar Co., 10 Fed. Rep. 835; Zinsser v. Cooledge, 17 Fed. Rep. 538; Smith v. Sands, 24 Fed Rep. 470; Keyes v. Pueblo Smelting & Refining Co., 31 Fed. Rep. 560.

482. Pullman v. B. & O. R. Co., 5 Fed. Rep. 72; Whitcomb v. Girard Coal Co., 47 Fed. Rep. 315, 318; Williams v. McNeely, 56 Fed.

bility of the defendant have weight where he is merely a user, and not the manufacturer of the alleged infringing thing.[483]

Laches on the part of the complainant is a weighty consideration against granting the injunction,[484] especially where the defendant has used the alleged infringing device for a number of years.[485]

Application for preliminary injunctions against public or quasi-public corporations are to be dealt with according to the peculiar equities of each case. Where the officers of a municipal corporation purchased electric fixtures with full knowledge that litigation might ensue, and took an indemnity bond from the dealer, and other fixtures were capable of being substituted with little delay, the Circuit Court of Appeals for the 2nd Circuit said "we perceive no equity in favor of the city," and directed a preliminary injunction to issue.[486] But while cities are liable in their corporate capacity for patent infringement,[487] even where the infringing acts are done by a separately incorported fire department,[488] the rule, in applications of the character under consideration is that wherever the safety or convenience of the public would suffer by the abrupt discontinuance of the infringing device the application will be denied.[489]

Rep. 265; Rogers Typographic Co. v. Mergenthaler Linotype Co., 58 Fed. Rep. 693, 694; George Ertel Co. v. Stahl, 65 Fed. Rep. 517, 13 C. C. A. 29; Nilsson v. Jefferson, 78 Fed. Rep. 366; Overweight Counterbalance Elevator Co. v. Cahill & Hall Elevator Co., 86 Fed. Rep. 338, 339; Scoville Mfg. Co. v. Patent Button Co., 99 Fed. Rep. 743, 744.

483. Williams v. McNeely, 56 Fed. Rep. 265.

484. Keyes v. Eureka Consolidated Mining Co., 158 U. S. 150, 39 L. Ed. 929.

485. Keyes v. Pueblo Smelting & Refining Co., 31 Fed. Rep. 560, 561.

486. Pelzer v. Binghamton, 95 Fed. Rep. 823, 37 C. C. A. 288.

487. Munson v. New York, 3 Fed. Rep. 338.

488. Brickill v. New York, 7 Fed. Rep. 479.

489. Southwestern Brush Elec. L. & P. Co. v. Louisiana Elec. L. Co., 45 Fed. Rep. 893; Consoli-

The same rule applies to a private corporation engaged under contract in furnishing alleged infringing guns to the government of the United States.[490]

The argument of public inconvenience, however, especially when invoked by a quasi-public corporation (as, a corporation engaged in operating stock cars), has well defined limitations. Judge Putnam has said, "so far as public inconvenience is concerned, while that may, under some conditions, be taken into account, yet it should not be under such circumstances as to deprive a patentee of his property without just compensation, or to put him in a position where there is substantial danger of that result."[491] That danger may be avoided by suspending the operation of the preliminary injunction for a sufficient time to enable the defendant to substitute non-infringing equipment.[492]

Where possible, in the case of a device essential to public safety (as, a hose-coupling used by a fire department), the court, even on a final hearing, will endeavor to secure compensation for the complainant without granting an injunction.[493] So an injunction was denied on final hearing where the defendant municipality was found to have infringed a wooden pavement patent.[494]

§ 389. The motion to dissolve.

A motion to dissolve and vacate an order granting a preliminary injunction may be made at any time after

dated Roller-Mill Co. v. Coombs, 39 Fed. Rep. 803, 804; McElroy v. Kansas City, 21 Fed. Rep. 257.

490. American Ordnance Co. v. Driggs-Seabury Co., 87 Fed. Rep. 947.

491. Westinghouse Air Brake Co. v. Burton Stock Car Co., 70 Fed. Rep. 619, 620.

492. Thomson-Houston Elec. Co. v. Union Ry. Co., 78 Fed. Rep. 365.

493. Bliss v. Brooklyn, 4 Fish. 596, Fed. Case No. 1544.

494. Ballard v. Pittsburg, 12 Fed. Rep. 783.

the entry of the order sought to be dissolved,[495] upon reasonable notice to the complainant,[496] which may be given by setting down in the order book.[497] The motion may be addressed to vacating the order in whole or in part.[498]

As a general rule the motion to dissolve an ex parte injunction order may be made before answer,[499] though in some jurisdictions it has been held that unless the equities of the bill have been fully traversed by answer, a motion to dissolve must be overruled.[500]

If the injunction order is framed in the usual way, to remain in force and effect during the pendency of the suit, and the patent should expire during the pendency of the suit, a motion to dissolve will be sustained under the general rule of equity practice that an injunction will be dissolved whenever it has ceased to subserve any useful purpose;[501] but a motion to dissolve based upon any other ground than the expiration of the patent should be filed promptly, or the laches of the moving party will weigh heavily against the motion.[502] Unless in the presence of such urgency as to require immediate action, a motion to dissolve or modify will only be entertained by the judge who made the order against which the motion is addressed;[503] and in the event of the death

495. Westerly Waterworks v. Town of Westerly, 77 Fed. Rep. 783.

496. Caldwell v. Waters, 4 Cranch 577, Fed. Case 2305; Buford v. Ringgold, 1 Cranch 253, Fed. Case 2152; Stoddert v. Waters, Fed. Case 13,472.

497. Wilkins v. Jordan, 3 Wash. 226, Fed. Case 17,665.

498. Wilkins v. Jordan, 3 Wash. 226, Fed. Case 17,665.

499. Metropolitan Grain & Stock Exchange v. Chicago Board of Trade, 15 Fed. Rep. 847; Fenwick Hall Co. v. Town of Old Saybrook, 66 Fed. Rep. 389.

500. Northern Pacific R. Co. v. Barnesville & M. R. Co., 4 Fed. Rep. 298.

501. In re Jackson, 9 Fed. Rep. 493.

502. Holmes Electric Protective Co. v. Metropolitan Burglar Alarm Co., 31 Fed. Rep. 562.

503. Klein v. Fleetford, 35 Fed. Rep. 98; Ide v. Crosby, 104 Fed. Rep. 582.

of that judge having intervened, it has been held advisable that two judges should sit to hear the motion.[504] The power to vacate, suspend or modify a preliminary injunction remains in the court which granted it, even after an affirmance of the order on appeal.[505] The motion may be presented in vacation.[506]

§ 390. Enlarging or extending the injunction.

Where, after the granting of a preliminary injunction, a supplemental bill is filed charging the defendant with acts of the same general character as those charged in the bill, the injunction may be enlarged and extended in terms commensurate with the allegations of the supplemental bill.[507]

§ 391. The moving papers on the motion to dissolve.

The motion may be based solely upon alleged error of law in granting the injunctive order, or upon questions of fact which were not presented at the hearing of the application for injunction. As usual in all motions in Federal practice, courtesy demands, and the court generally insists upon, the service of a copy of the motion and copies of all the accompanying moving papers upon opposing counsel in advance of the hearing.[508] If the motion is based upon matters of fact which have not become matters of record in the cause, they will usually be presented by affidavit, and the affidavits must be entitled in the cause or they cannot be considered.[509]

504. Westerly Waterworks v. Town of Westerly, 77 Fed. Rep. 783.

505. Edison Electric Light Co. v. United States Electric Lighting Co., 59 Fed. Rep. 501, 8 C. C. A. 200.

506. Adams v. Douglass County, Fed. Case 52.

507. Parkhurst v. Kinsman, 2 Blatchf. 78, Fed. Case 10,760.

508. Hardt v. Liberty Hill Consol Mining & Water Co., 27 Fed. Rep. 788.

509. Buerk v. Imhaeuser, 10 Off. Gaz. 907, Fed. Case 2107a; Goldstein v. Whelan, 62 Fed. Rep. 124.

§ 392. Grounds of dissolution.

As a basic rule, lack of jurisdiction is always ground for vacating an injunctive order.[510] As already indicated, the expiration of the patent in suit will be ground for dissolving the injunction, which can thereafter subserve no useful purpose.[511] If the bill is dismissed, the dismissal should vacate the preliminary injunction.[512] The assignment of the patent in suit by the complainant is ground for dissolution.[513] The motion may be granted because of the intentional delay of the complainant in the prosecution of his case.[514] Where it is made to appear that the suit is defective for want of an indispensable party, a preliminary injunction will be dissolved.[515] Any evidence which would have sufficed to prevent the issuance, will be sufficient for the dissolution, of the injunction.[516] Consequently, a showing by affidavit of alleged prior use which is sufficient to raise a serious doubt as to the novelty of the subject-matter of the patent in suit, will be sufficient to justify vacation of the injunction.[517]

A showing that the court erred in a matter of law in granting the injunction may be presented by the motion for dissolution.[518]

510. Adams v. Douglas Co., Fed. Case 52.

511. In re Jackson, 9 Fed. Rep. 493; Bate Refrigerating Co. v. Gillett, 31 Fed. Rep. 809.

512. Coleman v. Hudson River Bridge Co., 5 Blatchf. 56, Fed. Case 2983.

513. Parkhurst v. Kinsman, 1 Blatchf. 488, Fed. Case 10,757; Edison Electric Light Co. v. Buckeye Electric Co., 59 Fed. Rep. 691.

514. Read v. Consequa, 4 Wash. 174, Fed. Case 11,606; Robinson v. Randolph, 4 Ban. & A. 317, Fed. Case 11,963.

515. Eldred v. American Palace Car Co. of New Jersey, 105 Fed. Rep. 457, 44 C. C. A. 554.

516. Cary v. Domestic Spring Bed Co., 26 Fed. Rep. 38.

517. Cary v. Domestic Spring Bed Co., 26 Fed. Rep. 38.

518. Steam Gauge & Lantern Co. v. Miller, 11 Fed. Rep. 718.

Of course the burden is upon the moving party to show reason for granting the motion, and if he fails to meet this burden the motion will be denied.[519]

Where a motion for dissolution is based upon a newly discovered reference, if it appears probable that the patent in suit can be made to stand as against that reference by a disclaimer, the motion will be denied.[520]

§ 393. Security in lien of preliminary injunction.

In the wide latitude of discretion vested in courts of equity, there are numerous instances in which a preliminary injunction has been refused upon condition that, pending the cause, a bond be given by the defendant to answer to and pay any sum awarded against him as money judgment, on final decree.

The order usually runs, that should the defendant fail to file such bond, with sureties acceptable to the complainant or approved by the court, within a time limited by the order, the injunction may issue.[521]

Such an order may be made even where the patent in suit has been held valid in former litigation.[522]

Some of the reasons for orders of this class are; that the defendant is using the alleged infringing device as a minor part of complicated brake mechanism upon stock cars, in use all over the country, which would have to be recalled to a common point for removal, in event of injunction, to the expense and inconvenience of the pub-

519. Perry v. Littlefield, 2 Fed. Rep. 264.

520. Huntington v. Hartford Heel Plate Co., 33 Fed. Rep. 838.

521. As illustrations, see, Westinghouse Air Brake Co. v. Burton Stock Car Co., 77 Fed. Rep. 301, 23 C. C. A. 174; Edison Elec. Light Co. v. Columbia Incandescent Lamp Co., 56 Fed. Rep. 496; Geo. A. Macbeth Co. v. Lippencott Glass Co., 54 Fed. Rep. 167.

522. McMillan v. Conrad, 16 Fed. Rep. 128; Westinghouse Air Brake Co. v. Burton Stock Car Co., 77 Fed. Rep. 301, 23 C. C. A. 174; Edison Elec. Light Co. v. Columbia Incandescent Lamp Co., 56 Fed. Rep. 496.

lic; [523] that the complainant is not operating under his patent;[524] that the defendant urges, as against the adjudicated patent in suit, a prior use which was not presented in the former litigation;[525] that, similarly to the case last referred to, the novelty of the patent in suit is in doubt;[526] that the file-wrapper of the patent in suit renders the construction and scope of its claims uncertain;[527] that the defendant's expert affidavits present the question of aggregation, as a possibly successful defense;[528] that the design patent in suit appears to relate to a mechanical structure, not bought by consumers because of its artistic beauty, but because it is mechanically useful.[529]

Orders of this character are extraordinary, and are not apt to be made in accordance with sound doctrine. A preliminary injunction should never be granted except in a clear case; where a clear case is not presented—i. e., where validity is not clearly established, or infringement is doubtful—the motion should invariably be denied. Some of the cases show that the order for security was made largely because of the defendant's lack of financial responsibility;[530] and in a case where the complainant shows that the defendant corporation has been formed with a small capital for the purpose of limiting its lia-

523. Westinghouse Air Brake Co. v. Burton Stock Car Co., 77 Fed. Rep. 301, 23 C. C. A. 174.

524. Duplex Printing Press Co. v. Campbell Printing Press & Mfg. Co., 69 Fed. Rep. 250, 16 C. C. A. 220; Hoe v. Knap, 27 Fed. Rep. 204.

525. Edison Elec. Light Co. v. Columbia Incandescent Lamp Co., 56 Fed. Rep. 496.

526. Greenwood v. Bracher, 1 Fed. Rep. 856; New York Belting & Packing Co. v. Magowan, 23 Fed. Rep. 596.

527. National Enameling Co. v. New England Enameling Co., 123 Fed. Rep. 436, 438.

528. Consolidated Rubber Tire Co. v. Finley Rubber Tire Co., 106 Fed. Rep. 175, 178.

529. Marvel Co. v. Pearl, 114 Fed. Rep. 946.

530. Duplex Printing Press Co. v. Campbell Printing Press & Mfg. Co., 69 Fed. Rep. 250, 16 C. C. A. 220.

bility for infringement, this fact may properly call for security, where the application would otherwise be refused upon its merits.[531]

But where the patent is shown to be valid, and infringement is clear, security should not be substituted for the injunction,[532] even if the patent in suit has nearly expired,[533] except where the injunction would injure the general public.[534] Judge Coxe has expressed the reason for the general rule thus forcibly: "The case is not one for a bond. The defendant is not a manufacturer, but a user. Neither is the suggestion tenable that the injunction should be withheld because the infringement is so small that it does not seriously imperil the complainant's business. A sufficient answer is that it will not seriously imperil the defendant's business to stop infringing, and as the complainant is in the right and the defendant is in the wrong, the latter should give way."[535] The knowledge by the defendant of the complainant's patent, prior to engaging in the infringement, is at times a cogent factor in determining the court's action upon the motion for preliminary injunction. In a case where the defendants bought the infringing machine with full knowledge, Judge Kirkpatrick, in enjoining them, said "they will not be subjected to any inconvenience which they might not have anticipated."[536]

531. Edison Elec. Light Co. v. Columbia Incandescent Lamp Co., 56 Fed. Rep. 496.

532. McWilliams Mfg. Co. v. Blundell, 11 Fed. Rep. 419, 422.

533. American Bell Tel. Co. v. Western Tel. Const. Co., 58 Fed. Rep. 410.

534. As, in Westinghouse Air Brake Co. v. Burton Stock Car Co., 77 Fed. Rep. 301, 23 C. C. A. 174.

535. Carter & Co., Ltd. v. Wollschlaeger, 53 Fed. Rep. 573, 576.

536. Campbell Printing Press Co. v. Prieth, 77 Fed. Rep. 976, 978.

§ 394. Proceedings after the filing of the bill.

Proceedings immediately following the filing of the bill are governed by the Equity Rules, as follows:

RULE 11.

Subpoena, when to issue.—No process of subpoena shall issue from the clerk's office in any suit in equity until the bill is filed in the office.

RULE 12.

When returnable.—Whenever a bill is filed the clerk shall issue the process of subpoena thereon, as of course, upon the application of the plaintiff, which shall be returnable into the clerk's office the next rule day, or the next rule day but one, at the election of the plaintiff, occurring after twenty days from the time of the issuing thereof. At the bottom of the subpoena shall be placed a memorandum that the defendant is to enter his appearance in the suit in the clerk's office on or before the day at which the writ is returnable; otherwise the bill may be taken *pro confesso*. Where there are more than one defendant a writ of subpoena may, at the election of the plaintiff, be sued out separately for each defendant, except in the case of husband and wife defendants, or a joint subpoena against all the defendants.

RULE 13.

Service, how made.—The service of all subpoenas shall be by a delivery of a copy thereof by the officer serving the same, to the defendant personally, or by leaving a copy thereof at the dwelling-house or usual place of abode of each defendant, with some adult person who is a member or resident in the family.

RULE 14.

Alias subpoena.—Whenever any subpoena shall be returned not executed as to any defendant, the plaintiff shall be entitled to another subpoena, *toties quoties* against such defendant, if he shall require it, until due service is made.

RULE 15.

Who to make service.—The service of all process, mesne and final, shall be by the marshal of the district, or his deputy, or by some other person specially appointed by the court for that purpose, and not otherwise. In the latter case, the person serving the process shall make affidavit thereof.

RULE 16.

Entry on docket on return.—Upon the return of the subpoena as served and executed upon any defendant, the clerk shall enter the suit upon his docket as pending in the court, and shall state the time of the entry.

§ 395. Appearance.

The Equity Rules provide as follows:

RULE 17.

Day of.—The appearance day of the defendant shall be the rule day to which the subpoena is made returnable, provided he has been served with the process twenty days before that day; otherwise his appearance day shall be the next rule day succeeding the rule day when the process is returnable.

§ 396. Decrees pro confesso.

The Equity Rules are as follows:

RULE 18.

Default.—It shall be the duty of the defendant, unless the time shall be otherwise enlarged, for cause shown, by a judge of the court upon motion for that purpose, to file his plea, demurrer, or answer to the bill in the clerk's office, on the rule day next succeeding that of entering his appearance. In default thereof the plaintiff may, at his election, enter an order (as of course) in the order book that the bill be taken *pro confesso;* and thereupon the cause shall be proceeded in *ex parte,* and the matter of the bill may be decreed by the court at any time after the expiration of thirty days from and after the entry of said order, if the same can be done without an answer, and is proper to be decreed; or the plaintiff, if he requires any discovery or answer to enable him to obtain a proper decree, shall be entitled to process of attachment against the defendant, to compel an answer, and the defendant shall not, when arrested upon such process, be discharged therefrom, unless upon filing his answer, or otherwise complying with such order as the court or judge thereof may direct, as to pleading to or fully answering the bill, within a period to be fixed by the court or judge, and undertaking to speed the cause.

RULE 19.

Decree on default.—When the bill is taken *pro confesso* the court may proceed to a decree at any time after the expiration of thirty days from and after the entry of the order to take the bill *pro confesso,* and such decree rendered shall be deemed absolute, unless the court shall at the same term set aside the same, or enlarge the time for filing the answer, upon cause shown upon motion and affidavit of the defendant. And no such motion shall be granted, unless upon the payment of the costs of the plaintiff in the court up to that time, or such part thereof

as the court shall deem reasonable, and unless the defendant shall undertake to file his answer within such time as the court shall direct, and submit to such other terms as the court shall direct, for the purpose of speeding the cause.

The procedure is elaborately treated in the several works on practice in the Federal courts. But for the convenience of the patent practitioner the following holdings regarding decrees *pro confesso* may be noted:

"Rule Day" is defined by Bouvier as being "the regularly appointed day on which to make orders to show cause returnable" (Bouvier, Dict., title "Rule Day").

In Federal practise it is the first Monday of each month, and is designated by Equity Rule 2. By the provisions of Rule 12, the bill may be taken *pro confesso* where the defendant fails to enter his appearance on or before the Rule Day to which the subpoena is returnable.

Rule 17 provides for the keeping of an "order book" by the clerk. This rule is not always complied with, and several clerks' offices have no order book. In any event the safest course is for counsel to sign a memorandum of appearance and file the same in the cause. As in all procedure looking to the taking of a judgment or decree by default, the courts are liberal in setting aside orders *pro confesso*, and as a rule, this will be done if the defendant appears and tenders his answer after the order has been entered and before the decree is entered upon the order.[537] A decree *pro confesso* should not be entered, and will be vacated, where the record fails to show jurisdiction over and proper service upon the defendant.[538]

Where the bill does not make out a case of which the court has jurisdiction, and an amendment is made

537. Halderman v. Halderman, Fed. Case 5908.

538. Non-Magnetic Watch Co. v. Association Horlogere Suisse, 45 Fed. Rep. 210.

alleging facts which give the court jurisdiction, the defendant is entitled to have a reasonable time to answer the bill as amended; the court has no discretion to deny the defendant this right, and a decree *pro confesso* entered under the original bill cannot stand.[539] But where an amended bill is withdrawn, which has been filed after the default in the defendant's appearance, the amended bill not having been served upon or a copy given to the defendant, the complainant's right to a decree *pro confesso* remains unaffected by the filing of the amended bill.[540] A part of the bill may be taken as confessed.[541]

Where the bill upon its face shows that the defendant is under disability (a minor, insane or *feme covert*) the court cannot proceed to a decree without the appointment of a guardian *ad litem*.[542]

The order taking the bill *pro confesso* need not be served.[543]

The decree *pro confesso* is not to be entered arbitrarily in accordance with prayer of the bill; the bill is taken to be true as to all matters alleged with sufficient certainty and the decree will be framed by the court upon an examination of the allegations.[544] A decree *pro confesso* may be entered upon a crossbill, but it will not be entered while there is pending, undetermined, a motion to dismiss the suit for want of jurisdiction.[545] After the entry of the order, a defendant who has appeared but failed to plead is entitled to a notice of the applica-

539. Nelson v. Eaton, 66 Fed. Rep. 376, 378, 13 C. C. A. 523.

540. Sheffield Furnace Co. v. Witherow, 149 U. S. 574, 576, 37 L. Ed. 853.

541. Hale v. Continental Life Ins. Co., 20 Fed. Rep. 344.

542. O'Hara v. McConnell, 93 U. S. 150, 23 L. Ed. 840.

543. Bank of United States v. White, 8 Peters 262, 8 L. Ed. 938.

544. Andrews v. Cole, 20 Fed. Rep. 410; Thomson v. Wooster, 114 U. S. 104, 113, 29 L. Ed. 105.

545. Blythe v. Hinckley, 84 Fed. Rep. 228.

tion for entry of the decree, to the end that he may be heard upon the question of the scope of the decree.[546]

A motion to vacate the decree should be made as soon as possible,[547] and will not usually be entertained after the term at which the decree was entered.[548]

In patent cases the entry of a decree *pro confesso* brings the cause within the proviso of Rule 18 that "the cause shall be proceeded in *ex parte;*" the cause is usually referred for an accounting, and in the subsequent proceedings in the same suit the defendant will not be heard to defend upon the ground that the patent is void upon its face.[549] The defendant is entitled to have notice and to appear before the master.[550]

§ 397. Demurrers in equity.

"A demurrer is an answer in law to the bill, though not in technical sense, an answer according to the common language of practice," is the expression of Mr. Chief Justice Marshall, in construing the filing of a demurrer to be a compliance with an order to appear and answer by a date certain.[551] Mr. Justice Wayne, a little later, wrote this definition: "A demurrer is an objection made by one party to his opponent's pleading, alleging that he ought not to answer it, for some defect in law in the pleading. It admits the facts, and refers the law arising thereon to the court. The opposite party (may demur) when his opponent's pleading is defective in substance or form, but there can be no demurrer for a

546. Southern Pacific R. Co. v. Temple, 59 Fed. Rep. 17.

547. Comly v. Buchanan, 81 Fed. Rep. 58.

548. Stuart v. City of St. Paul, 63 Fed. Rep. 644.

549. Dobson v. Hartford Carpet Co., 114 U. S. 439, 29 L. Ed. 177.

550. Austin v. Riley, 55 Fed. Rep. 833; Southern Pacific R. Co. v. Temple, 59 Fed. Rep. 17; Davis v. Garrett, 152 Fed. Rep. 723.

551. New Jersey v. New York, 6 Peters 323, 8 L. Ed. 414.

defect not apparent in the pleadings. * * * A general demurrer lies only for defects in substance, and excepts to the sufficiency of the pleading in general terms, without showing specially the nature of the objection. A special demurrer is only for defects in form, and adds to the terms of a general demurrer a specification of the particular ground of exception." [552]

The practice in patent causes differs from the general equity practice as to demurrers, in that the question of the validity of the patent in suit can be raised by demurrer. A patent of which *profert* is made in the bill is part of the bill and will be examined as such upon demurrer.[553]

This rule does not extend to prior patents to the same patentee referred to, without profert, in the bill.[554] A demurrer may raise the question of want of identity between the reissued patent in suit and the original upon which it is founded; and in such a case, the bill making profert of the reissue, but not of the original, the original will nevertheless be considered and compared with the reissue on demurrer.[555]

The broad principle is everywhere recognized that the want of validity of the patent in suit, for any reason apparent upon its face, may be determined upon demurrer. In the leading case Mr. Justice Brown said: "While patent cases are usually disposed of upon bill, answer and proof, there is no objection, if the patent be manifestly invalid upon its face, to the point being raised on demurrer, and the case being determined upon the issue so formed." [556] In the case cited, the Supreme Court held the patent void for aggregation.

552. Tyler v. Hand, 7 Howard 573, 581, 12 L. Ed. 824, 827.

553. Fowler v. New York, 121 Fed. Rep. 747, 58 C. C. A. 113.

554. Bowers v. Bucyrus Co., 132 Fed. Rep. 39.

555. Edison v. American Mutoscope & Biograph Co., 127 Fed. Rep. 361.

556. Richards v. Chase Elevator Co., 158 U. S. 299, 301, 39 L. Ed. 991, 992.

Judge Severens has given this compact summary of the doctrine under consideration, and its underlying reason:

"It is no longer open to question that where the case as presented is clear, and the court finds no difficulty in understanding the character and scope of the invention from the patent itself when tested by the common knowledge pertaining to it, and thereupon discerns that the patent is not sustainable, the proper and expedient course is to dispose of the case on demurrer, and thus put an end to useless litigation."[557]

Upon the consideration of the question of novelty upon demurrer, the extent to which the court will take judicial notice of pre-existing matters in the art to which the patent in suit relates, is involved in obscurity. Probably the narrowest view is that thus expressed by the Supreme Court: "Whether or not the design is new is a question of fact, which, whatever our impressions may be, we do not think it proper to determine by taking judicial notice of the various designs which may have come under our observation. It is a question which may and should be raised by answer and settled by proper proofs."[558] In this connection Judge Townsend has said that the court "will only take judicial notice of matters within the field of common knowledge."[559]

557. Strom Mfg. Co. v. Weir Frog Co., 83 Fed. Rep. 170, 172, 27 C. C. A. 502; citing, Risdon Iron & Locomotive Works v. Medart, 158 U. S. 68, 39 L. Ed. 899; American Fibre Chamois Co. v. Buckskin Fibre Co., 72 Fed. Rep. 508, 18 C. C. A. 662.

558. Mr. Justice Bradley, in New York Belting & Packing Co. v. New Jersey Car Spring Co., 137 U. S. 445, 34 L. Ed. 741, 743.

559. Hanlon v. Primrose, 56 Fed. 600, 601; to the same effect, see, Kaolatype Eng. Co. v. Hoke, 30 Fed. Rep. 444; Eclipse Mfg. Co. v. Adkins, 36 Fed. Rep. 554; Root v. Sontag, 47 Fed. Rep. 309; Heaton Penninsular Button-Fastener Co. v. Schlochtmeyer, 67 Fed. Rep. 592.

The doctrine just stated, however, must be supplemented by an understanding of those avenues of general information which may be explored in order to ascertain what facts exist of which the court should take judicial notice. We are indebted to Mr. Justice Swayne for the following general statement:

"Of private and special facts, in trials in equity and at law, the court or jury, as the case may be, is bound carefully to exclude the influence of all previous knowledge. But there are many things of which judicial cognizance may be taken. 'To require proof of every fact, as that Calais is beyond the jurisdiction of the court, would be utterly and absolutely absurd.' Facts of universal notoriety need not be proved. Among the things of which judicial notice is taken, are: the law of nations; the general customs and usages of merchants; the notary's seal; things which must happen according to the laws of nature; the coincidences of the days of the week with those of the month; the meaning of words in the vernacular language; the customary abbreviations of Christian names; the accession of the Chief Magistrate to office and his leaving it. In this country, such notice is taken of the appointment of members of the cabinet, the election and resignations of senators and of the appointment of marshals and sheriffs, but not of their deputies. The courts of the United States take judicial notice of the ports and waters of the United States where the tide ebbs and flows, of the boundaries of the several states and judicial districts, and of the laws and jurisprudence of the several states in which they exercise jurisdiction. Courts will take notice of whatever is generally known within the limits of their jurisdiction; and, if the judge's memory is at fault, he may refresh it by resorting to any means for that purpose which he may deem safe and proper. This extends to

such matters of science as are involved in the cases brought before him."[560]

Judge Putnam has, in considering a paper box machine patent, treated of the power and the duty of the court to take judicial notice of its own records, as follows:

"For the purpose of ascertaining the state of the art, when it concerns a matter of general interest, as it does in the determination of the construction of this class of letters patent, we are certainly authorized to take notice of our own records, and perhaps we may always do so.[561] As the question of the construction of the patent in issue concerns, not only the parties in this case, but also the public, so that, as is well settled, we have a certain duty to take notice of matters bearing upon questions of the existence and extent of patentability, we would not be justified in ignoring what our own records show us in Beach v. Hobbs on this point, in view of the fact that they are of so late a date that they cannot be presumed to have escaped our attention." [562]

In a later case the same learned judge has said: "It is plain that the state of the art of which the court may take judicial notice, and as to which it can be assisted by the statements of the parties or their counsel, without proofs furnished in accordance with the rules of law, is a matter of general knowledge, and such judicial notice cannot extend to a single patent, relating to a particular fact in a limited art."[563] It is the general rule that the courts will not take judicial notice of the

560. Brown v. Piper, 91 U. S. 37, 23 L. Ed. 200, 201.

561. Citing Butler v. Eaton, 141 U. S. 240, 243, 35 L. Ed. 713; Aspen Smelting Co. v. Billings, 150 U. S. 31, 37 L. Ed. 986; Creamer v. Washington, 168 U. S. 129, 42 L. Ed. 407.

562. Cushman Paper Box Mach. Co. v. Goddard, 95 Fed. Rep. 664, 666, 37 C. C. A. 221.

563. Parsons v. Seelye, 100 Fed. Rep. 452, 454, 40 C. C. A. 484.

contents of letters patent,[564] nor of structures exhibited upon the argument of a demurrer unless there is absolute certainty that the devices shown antedated the patent.[565]

Illustrative cases worthy of reference in this connection show the application of judicial notice, as follows: that metallic corner sockets for show cases were old;[566] so of straps used to open and close the rear door of an omnibus from its front, devices for opening or closing steam and hydraulic valves at a distance, and devices used at railway switches for opening and closing the rails;[567] so of hydraulic devices for removing sandy obstructions;[568] so of a spring latch;[569] so of two parallel co-operating cylinders;[570] so of the compression of small packages for enclosure in a single large container;[571] so of methods of suspending lamps in railroad cars and in hand lanterns;[572] so of book cases used in banks and recording offices;[573] so of the effect of pointing a round wire by pressure upon two of its sides.[574]

§ 398. Pleas in equity.

The proper office of a plea in equity "is to present some distinct fact, which of itself creates a bar to the

564. Bottle Seal Co. v. De La Vergne Bottle & Seal Co., 47 Fed. Rep. 59, 63.

565. Lalance & Grosjean Mfg. Co. v. Mosheim, 48 Fed. Rep. 452.

566. Terhune v. Phillips, 99 U. S. 592, 25 L. Ed. 293.

567. Aron v. Manhattan Ry. Co., 26 Fed. Rep. 314, 316; affirmed, in Aron v. Manhattan Ry. Co., 132 U. S. 84, 33 L. Ed. 272.

568. Knapp v. Benedict, 26 Fed. Rep. 627.

569. Ligowski Clay-Pigeon Co. v. American Clay-Pigeon Co., 34 Fed. Rep. 328-332.

570. C. & A. Potts & Co. v. Creager, 155 U. S. 597, 39 L. Ed. 275.

571. King v. Gallun, 109 U. S. 99, 27 L. Ed. 870.

572. Lamson Consolidated Service Co. v. Siegel-Cooper Co., 106 Fed. Rep. 734.

573. Specialty Mfg. Co. v. Fenton Mfg. Co., 174 U. S. 492, 497, 43 L. Ed. 1058.

574. Heaton Peninsular Button-Fastener Co v. Schlochtmeyer, 69 Fed. Rep. 592-597.

suit, or to the part (of the bill) to which the plea applies, and thus avoid the necessity of making the discovery asked for, and the expense of going into the evidence at large."[575]

In particular application to suits for patent infringement we find the following rulings as to the functions of pleas:

1. When the statute required the patent to bear date not more than six months later than the date of the notice of allowance, the defense that the date of the patent in suit was not within that limit was properly presented by plea.[576]

2. Laches not apparent on the face of the bill may be charged by plea;[577] if it is apparent on the face of the bill, the question should be raised by demurrer.[578]

3. A plea setting up cessation of infringement before the filing of the bill will usually be held insufficient, upon the ground that the complainant is entitled to better protection against the recurrence of the infringement than the mere statement of the defendant;[579] and such a plea may be stricken out when contradicted by evidence in the record.[580]

4. The defense of prior patenting or prior publication cannot be raised by plea.[581]

575. Mr. Justice Gray, in Farley v. Kittson, 120 U. S. 303, 30 L. Ed. 684.

576. Western Electric Co. v. North Electric Co., 135 Fed. Rep. 79, 67 C. C. A. 553.

577. Woodmanse & Hewitt Mfg. Co. v. Williams, 68 Fed. Rep. 489, 494, 15 C. C. A. 520.

578. McLaughlin v. People's Railway Co., 21 Fed. Rep. 574; Woodmanse & Hewitt Mfg. Co. v. Williams, 68 Fed. Rep. 489, 493, 15 C. C. A. 520; Huntington Dry Pulverizer Co. v. Virginia-Carolina Chemical Co., 130 Fed. Rep. 558.

579. General Electric Co. v. Bullock Electric Mfg. Co., 138 Fed. Rep. 412.

580. Silver & Co. v. J. P. Eustis Mfg. Co., 130 Fed. Rep. 348.

581. Carnrick v. McKesson, 8 Fed. Rep. 807.

5. The defense of non-infringement cannot be raised by plea,[582] and such a plea will be stricken out on motion.[583]

6. The defense that the reissued patent in suit is void because it is for a different invention from the original may be presented by plea.[584]

7. In a suit upon two or more patents, the defense that the subject-matter is not conjointly used in a single structure by the defendant cannot be presented by plea.[585]

8. Where the infringement complained of has been committed by persons other than the defendant, that issue may be tendered by plea,[586] and this doctrine applies where the individual defendant acted solely, as to the infringement, in his official capacity as the officer or agent of a corporation.[587]

§ 399. Requisites of the plea.

Equity Rule 31 requires the plea to be accompanied by the "certificate of counsel that in his opinion it is well founded in point of law." That rule also requires "the affidavit of the defendant" that the plea "is not interposed for delay," and, "is true in point of fact." The omission of these formal requirements entitles the complainant to disregard the plea,[588] but he may waive

582. Korn v. Wiebusch, 33 Fed. Rep. 50; Leatherbee v. Brown, 69 Fed. Rep. 590; Knox Rock Blasting Co. v. Rairdon Stone Co., 87 Fed. Rep. 969.

583. Sharp v. Reissner, 9 Fed. Rep. 445.

584. Hubbell v. DeLand, 14 Fed. Rep. 471.

585. Union Switch & Signal Co. v. Phila. & R. R. Co., 69 Fed. Rep. 833.

586. Boston Woven Hose Co. v. Star Rubber Co., 40 Fed. Rep. 167; Leatherbee v. Brown, 69 Fed. Rep. 590, 592.

587. Mergenthaler Linotype Co. v. Ridder, 65 Fed. Rep. 853, 856; Leatherbee v. Brown, 69 Fed. Rep. 590, 592.

588. Secor v. Singleton, 9 Fed. Rep. 809; Filer v. Levy, 17 Fed. Rep. 610; Preston v. Finley, 72 Fed. Rep. 850; Sheffield Furnace Co. v. Witherow, 149 U. S. 574, 37 L. Ed. 853.

the point by setting the plea down for argument.[589] The fundamental rule is that a plea must present but a single issue.[590] The plea may make profert of, or have attached and filed with it, documentary exhibits, which will be treated as a part of the plea in its interpretation.[591]

§ 400. Proceedings under the plea, and their effect.

Mr. Justice Gray has treated the procedure under the plea elaborately in the opinion from which the following is taken:

"The plaintiff may either set down the plea for argument, or file a replication to it. If he sets down the plea for argument, he thereby admits the truth of all the facts stated in the plea, and merely denies their sufficiency in point of law to prevent his recovery. If, on the other hand, he replies to the plea, joining upon the facts averred in it, and so puts the defendant to the trouble and expense of proving his plea, he thereby, according to the English chancery practice, admits that if the particular facts stated in the plea are true, they are sufficient in law to bar his recovery; and if they are proved to be true, the bill must be dismissed, without reference to the equity arising from any other facts stated in the bill. That practice in this particular has been twice recognized by this court. Hughes v. Blake, 19 U. S. (6 Wheat.) 453, 472, 5 L. Ed. 303, 308; Rhode Island v. Mass., 39 U. S. (14 Pet.) 210, 257, 10 L. Ed. 423, 445. But the case of Rhode Island v. Massachusetts, arose within its original jurisdiction in equity, for outlines of the practice in which the court has always looked

589. Goodyear v. Toby, 6 Blatchf. 130, Fed. Case 5585.

590. Giant Powder Co. v. Safety Nitro-Powder Co., 19 Fed. Rep. 509.

591. Wheeler v. McCormick, 4 Fisher 433, Fed. Case 17,498.

to the practice of the court of chancery in England. Rule 7 of 1791, 1 Cranch 17, and 1 How. 24; Rule 3 of 1858 and 1884, 21 How. 5, and 108 U. S. 574. And the case of Hughes v. Blake, which began in the Circuit Court, was decided here in 1821, before this court, under the authority conferred upon it by Congress, had established the Rules of Practice in Equity in the Courts of the United States, one of which provides that 'If upon an issue the facts stated in the plea be determined for the defendant, they shall avail him as far as in law and equity they ought to avail him.' The effect of this rule of court when the issue of fact joined on a plea is determined in the defendant's favor need not, however, be considered in this case, because it is quite clear that at a hearing upon plea, replication and proofs, no fact is in issue between the parties but the truth of the matter pleaded.

"In a case so heard, decided by this court in 1808, Chief Justice Marshall said: 'In this case the merits of the claim cannot be examined. The only questions before this court are upon the sufficiency of the plea to bar the action, and the sufficiency of the testimony to support the plea as pleaded.' Stead v. Course, 8 U. S. (4 Cranch) 403, 413, 2 L. Ed. 660, 663. In a case before the House of Lords a year afterwards, Lord Redesdale 'observed that a plea was a special answer to a bill, differing in this from an answer in the common form, as it demanded the judgment of the court, in the first instance, whether the special matter urged by it did not debar the plaintiff from his title to that answer which the bill required. If a plea were allowed, nothing remained in issue between the parties, so far as the plea extended, but the truth of the matter pleaded.' 'Upon a plea allowed, nothing is in issue between the parties but the matter pleaded, and the averments added to support the plea.' 'Upon argument of a plea, every fact stated in the bill, and not

denied by answer in support of the plea, must be taken for true.' Roche v. Morgell., 2 Sch. & Lef. 721, 725, 727.

"The distinction between a demurrer and a plea dates as far back as the time of Lord Bacon, by the 58th of whose Ordinances for the Administration of Justice in Chancery, 'a demurrer is properly upon matter defective contained in the bill itself, and no foreign matter; but a plea is of foreign matter to discharge or stay the suit, as that the cause hath been formerly dismissed, or that the plaintiff is outlawed or excommunicated, or there is another bill depending for the same cause, or the like.' Lord Redesdale, in his Treatise on Pleadings, says: 'A plea must aver facts to which the plaintiff may reply, and not in the nature of a demurrer, rest on facts in the bill.' And Mr. Jeremy, in a note to this passage, commenting on the ordinance of Lord Bacon, observes: 'The prominent distinction between a plea and a demurrer, here noticed, is strictly true, even of that description of plea which is termed negative, for it is the affirmative of the proposition which is stated in the bill:' in other words, a plea which avers that a certain fact is not as the bill affirms it to be sets up matter not contained in the bill. That an objection to the equity of the plaintiff's claim, as stated in the bill, must be taken by demurrer and not by plea is so well established that it has been constantly assumed and therefore seldom stated in judicial opinions; yet there are instances in which it has been explicitly recognized by other courts of chancery, as well as by this court."[592]

§ 401. Answer.

If the defendant wishes to avail himself of more than one matter of defense, he should do so by answer, for

592. Farley v. Kittson, 120 U. S. 303, 30 L. Ed. 684.

the general rule is that a plea must not contain more defenses than one.[593]

What the defenses are which may be interposed by the answer, we have heretofore examined with some particularity. Our present inquiry will be limited to those general rules affecting the answer as to its form and substance, which should be considered by the pleader in conjunction with the former consideration of the defenses.

The fundamental rule as to the sufficiency of the answer was thus stated by Mr. Chief Justice Waite: "An answer, to be good, must overcome the case made out by the complainant. If the facts well pleaded in the complaint are admitted, * * * it must state other facts sufficient if true to defeat the action in whole or in part, or it will not avail as a defense."[594]

An answer in the form of a general denial, or admitting certain allegations of the bill and then denying every allegation of the bill not expressly admitted to be true, is improper. "In equity pleading, designed to search out the conscience of the party, and to put him to the very truth of the matter, all semblance of double and evasive pleading should be avoided, so as not to leave the adversary to seek out through the whole body of the pleading, and determine at his peril, precisely what is intended to be admitted and what controverted. Specific and direct denials or admissions not only tend to define and sharpen the issues, but better enable the parties to prepare for trial, and save costs and trouble in taking testimony on matters not in good faith controverted."[595]

It is no ground of exception to an answer that it is not properly entitled, but such a defect may be ground for

593. Reissner v. Anness, 3 B. & A. 148, Fed. Case 11,686.

594. Gillette v. Bullard, 87 U. S. (20 Wall.) 571, 22 L. Ed. 387.

595. Philips, J., in Holton v Guinn, 65 Fed. Rep. 450, 451.

a motion to strike the answer from the files.[596] "There is no equity rule requiring a certificate of counsel to an answer to the merits of the bill."[597] Under Equity Rule 39 the defendant may properly join all matters of defense in his answer, whether in bar or to the merits of the bill.[598]

The rule for testing the pertinency of the answer, as adopted from the language of the State court of New Jersey by Judge Morrow, is:

"That all substantial doubts, whether the matters objected to are pertinent or not, are to be resolved in favor of their pertinency, and that nothing should be expunged from the answer which the defendant has a right to prove, and which, if proved, can have any influence on the judgment of the court, either in deciding whether or not the complainant is entitled to any relief whatever, or the nature, character, or extent of the relief to which he may be entitled, even down to the question whether he shall have relief with or without costs."[599]

As to the defense of want of novelty, the answer must conform to the requirement of the statute (§ 4920, R. S. U. S.), that "as to proof of previous invention, knowledge, or use of the thing patented, the defendant shall state the names of the patentees, and the dates of their patents, and when granted, and the names and residences of the persons alleged to have invented or to have had prior knowledge of the thing patented, and where and by whom it had been used." The word "dates" in the statute appears to the writer to be a clerical error for

596. Osgood v. A. S. Aloe Instrument Co., 69 Fed. Rep. 291, 292.

597. Gilbert, J., in McGorray v. O'Connor, 87 Fed. Rep. 586, 588, 31 C. C. A. 114.

598. Holton v. Guinn, 65 Fed. Rep. 450.

599. Leslie v. Leslie, 50 N. J. Eq. 155, 24 Atl. Rep. 1029; quoted and followed in Von Schroder v. Brittan, 98 Fed. Rep. 169, 171.

"numbers," because the succeeding words call for the dates "when granted."

The "notice" named in this section, by its language applies only to actions at law, and the thirty days' time of service before the trial is also applicable only to law actions; for the last sentence in the section provides that "the like defenses may be *pleaded* in any suit in equity," and a notice is not a pleading. Judge Shipman said, "in all cases the issue raised in suits of this character must be raised by the allegations in the bill and answer, and whenever either the bill or answer is defective, the defect must be cured by amendment, and cannot be cured by filing special notices."[600]

The usual practice in framing the answer as to the defenses of § 4920 is to plead those prior patents or uses and witnesses known to the pleader, and then pray leave to name other patents, uses or witnesses by amendment.[601] Thus, Mr. Justice Clifford has said "notices of the kind, when the suit is in equity, may be given in the answer or amended answer."[602]

These defenses must be pleaded in strict accordance with the statutory requirements. The place of residence of the witness must be given by definite street location, if he resides in a large city; if his residence is in a small town, the name of the town will suffice.[603] If a printed publication of considerable size is pleaded, it should be with page reference.[604]

It is not necessary to state the time when the person named made the use alleged, or had knowledge of the

600. Doughty v. West, 2 Fisher 553, Fed. Case 4029.

601. Roemer v. Simon, 95 U. S. 214, 24 L. Ed. 384.

602. Bates v. Coe, 98 U. S. (8 Otto) 31, 25 L. Ed. 68.

603. Phillips v. Page, 65 U. S. (24 How.) 164, 16 L. Ed. 639; Latta v. Shawk, 1 Bond 259, Fed. Case 8116; Lock v. Pennsylvania R. Co., 1 N. J. L. J. 227, Fed. Case 8438.

604. Silsby v. Foote, 14 How. 218, 14 L. Ed. 394.

use,[605] but an averment of public use or sale must fix the time of such use or sale as being more than two years before the application was filed on which the patent in suit issued;[606] if the patent in suit is a reissue, the allegation should relate to the application for the original patent.[607] The answer need not recite that the prior public use or sale was with the consent or allowance of the patentee; that averment was necessary under the Act of 1836, but is now obsolete.[608] An allegation that an alleged anticipating device was built by certain persons named, is not an allegation of use by them.[609] Where abandonment of the invention is relied upon it should be pleaded definitely and specifically, though an objection to an indefinite allegation is too late when presented for the first time upon appeal.[610]

§ 402. Cross-bills defined.

Bouvier defines the cross-bill as "one which is brought by a defendant in a suit against a plaintiff in or against other defendants in the same suit, or against both, touching the matters in question in the original bill."[611] The employment of cross-bills in patent causes is somewhat rare, but their efficacy and appropriateness in proper cases warrants a presentation in this work of their functions and requisites.

605. Phillips v. Page, 65 U. S. (24 How.) 164, 16 L. Ed. 639.

606. Agawam Woolen Co. v. Jordan, 74 U. S. (7 Wall.) 583, 19 L. Ed. 177.

607. Agawam Woolen Co. v. Jordan, 74 U. S. (7 Wall.) 583, 19 L. Ed. 177.

608. Campbell v. New York, 35 Fed. Rep. 504, 505; Andrews v. Hovey, 123 U. S. 267, 31 L. Ed. 160.

609. Tatum v. Eby, 60 Fed. Rep. 408.

610. Western Elec. Co. v. Sperry Elec. Co., 58 Fed. Rep. 186, 192, 7 C. C. A. 164.

611. Bouvier, Dict. (Rawle Rev.), title "Cross-bill."

§ 403. Function of the cross-bill.

We are indebted to Judge Sanborn for this summary of the functions of the cross-bill:

"The office of a cross-bill is either to warrant the grant of affirmative relief to the defendant in the original suit, to obtain a discovery in aid of the defense in that suit, to enable the defendant to interpose a more complete defense than that which he could present by answer, or to obtain full relief to all parties, and a complete determination of all controversies which arise out of the matters charged in the original bill. The fact that the cross-bill fairly tends to accomplish either of these purposes is generally a sufficient ground for its interposition. It must seek equitable relief, but, subject to this qualification, a complainant who has brought a defendant into a court of equity in order to subject him to an adjudication of his rights in a certain subject-matter, cannot be heard to say that there is no equity in a cross-bill which seeks an adjudication of all the rights of the parties to the original suit in the same subject-matter. The issues raised by the cross-bill must be so closely connected with the cause of action in the original suit that the cross suit is a mere auxiliary or dependency upon the original suit, but, subject to this qualification, new facts and new issues may properly be presented by a cross-bill."[612] Within the limitation that its subject-matter must relate, or be germane, to that of the original bill, it is no objection to the cross-bill that it may contain additional facts.[613]

By means of a cross-bill, a defendant manufacturer may secure an injunction restraining the complainant,

612. Springfield Milling Co. v. Barnard & Leas Mfg. Co., 81 Fed. Rep. 261, 263, 26 C. C. A. 389; citing, Meissner v. Buek, 28 Fed. Rep. 161-163; Chicago, Milwaukee & St. P. Ry. Co. v. Third Nat. Bank, 134 U. S. 276, 33 L. Ed. 900.

613. Kingsbury v. Buckner, 134 U. S. 650, 33 L. Ed. 1047.

pending the suit, from prosecuting suits for infringement against the defendant's customers, wherever located.[614]

§ 404. Complainant's election of procedure after answer filed.

Of the several courses, leading to settlement of the issues after the answer is filed, which may be followed by the complainant, Mr. Justice Gray has said:

"Upon the coming in of defendant's answer, several courses are open to the plaintiff:

"First. The plaintiff may, upon motion, without notice to the defendant, have leave to amend his bill, with or without the payment of costs, as the court may direct. Equity Rules 29, 45.

"Second. The plaintiff may file exceptions to the answer for insufficiency. Equity Rule 61. If the defendant does not submit to the exception, and file an amended answer, the plaintiff may set down the exceptions for hearing. Equity Rule 63. If the exceptions are thereupon allowed by the court, the defendant must put in a full and complete answer; otherwise, the plaintiff may take the bill, so far as the matter of exceptions is concerned, as confessed. Equity Rule 64.

"Third. If the answer is not excepted to, or if it is adjudged or deemed sufficient, the plaintiff may file a general replication; whereupon the cause is to be deemed, to all intents and purposes, at issue, without further pleading on either side. Equity Rule 66.

"Fourth. A demurrer to the answer is unknown in equity practice. But the plaintiff may set down the case for hearing upon bill and answer; whereupon all the facts alleged in the bill and not denied in the answer.

614. Consolidated Rubber Tire Co. v. Finley Rubber Tire Co., 106 Fed. Rep. 175.

as well as all new facts alleged in the answer, are deemed admitted, as upon a demurrer to an answer in an action at law. Equity Rule 41, as amended at December term, 1871, 80 U. S. (13 Wall.), 11, 20 L. Ed. 914; Equity Rule 60; Leeds v. Marine Ins. Co., 15 U. S. (2 Wheat.) 380, 4 L. Ed. 266; Reynolds v. First Nat. Bank, 112 U. S. 405, 409, 28 L. Ed. 733, 735; Banks v. Manchester, 128 U. S. 244, 250, 251, 32 L. Ed. 425, 428.

"For the purpose of the hearing upon exceptions to an answer, the facts alleged in the bill and in the answer must indeed be considered as admitted, and only matter of law is presented for decision, as in a case set down for hearing upon bill and answer. But the difference between the two cases is this: When a case in equity is set down for hearing on bill and answer, the whole case is presented for final decree in favor of either party. But when the matter set down for hearing is the plaintiff's exceptions to the answer, the case is not ripe for a final decree; the only question to be decided is the sufficiency of the answer; and no final decree can be entered against either party, unless it declines or omits to plead further."[615]

§ 405. Replication.

Equity Rule 66 provides that "whenever the answer of the defendant shall not be excepted to, or shall be adjudged or deemed sufficient, the plaintiff shall file the general replication thereto on or before the next succeeding rule day thereafter; and in all cases where the general replication is filed, the cause shall be deemed, to all intents and purposes, at issue, without any rejoinder or other pleading on either side." By this rule,

615. Re Sanford Fork & Tool Co., 160 U. S. 247, 256, 40 L. Ed. 416, 417.

the special replication of the ancient practice, introducing new matter in avoidance of the allegations of the answer, has been abolished, and the practice of amending the bill has taken its place. It has been held that after an answer is filed on any rule day, if the complainant files no exceptions, he has until the second rule day thereafter to file the general replication.[616]

"The purpose of the general replication is to put in issue any new matter set forth in the answer. It does not nullify the effect of an admission in the answer of an allegation of the bill."[617] In affirming the case just quoted from, the Supreme Court said: "Courts of equity are frequently required to act on the admissions of the answer without other proof. Thus, when a cause is heard upon bill and answer, the decree is based entirely on the admissions of the answer without other testimony."[618]

A replication filed out of time and without leave of court may be permitted to stand, in the discretion of the court,[619] or, on application, it may be permitted to be filed, *nunc pro tunc*, as of a date within time, after the cause has been set down for hearing upon the proofs,[620] or referred for hearing on bill and answer.[621]

"A general replication admits the sufficiency of the answer as a discovery, and is a waiver of any objection to the form in which its defenses are presented."[622]

616. Hendrickson v. Bradley, 85 Fed. Rep. 508, 29 C. C. A. 303.

617. McCrary, J., in Cavendar v. Cavender, 8 Fed. Rep. 641, 642.

618. Cavendar v. Cavender, 114 U. S. 464, 29 L. Ed. 212.

619. Fischer v. Hayes, 6 Fed. Rep. 76.

620. Jones v. Brittan, 1 Woods 667, Fed. Case 7455.

621. Pierce v. West, Peters C. C. 351, Fed. Case 10,909.

622. Sanborn, J., in People's United States Bank v. Gilson, 161 Fed. Rep. 286, 294, 88 C. C. A. 332; citing, McGorray v. O'Connor, 87 Fed. Rep. 586, 588, 31 C. C. A. 114, 116.

§ 406. Testimony in equity cases.

The taking of testimony in equity is provided for by the Equity Rules as follows:

67.

"After the cause is at issue, commissions to take testimony may be taken out in vacation as well as in term, jointly by both parties, or severally by either party, upon interrogatories filed by the party taking out the same in the clerk's office, ten days' notice thereof being given to the adverse party to file cross-interrogatories before the issuing of the commission; and if no cross-interrogatories are filed at the expiration of the time the commission may issue *ex parte*. In all cases the commissioner or commissioners may be named by the court or by a judge thereof; and the presiding judge of the court exercising jurisdiction may, either in term time or in vacation, vest in the clerk of the court general power to name commissioners to take testimony.

"Either party may give notice to the other that he desires the evidence to be adduced in the cause to be taken orally, and thereupon all the witnesses to be examined shall be examined before one of the examiners of the court, or before an examiner to be specially appointed by the court. The examiner, if he so request, shall be furnished with a copy of the pleadings.

"Such examination shall take place in the presence of the parties or their agents, by their counsel or solicitors, and the witnesses shall be subject to cross-examination and re-examination, all of which shall be conducted as near as may be in the mode now used in common law courts.

"The depositions taken upon such oral examination shall be reduced to writing by the examiner, in the form of question put and answer given; provided, that, by

consent of parties, the examiner may take down the testimony of any witness in the form of narrative.

"At the request of either party, with reasonable notice, the deposition of any witness shall, under the direction of the Examiner, be taken down either by a skillful stenographer or by a skillful typewriter, as the Examiner may elect, and when taken stenographically shall be put into typewriting or other writing; provided, that such stenographer or typewriter has been appointed by the court, or is approved by both parties.

"The testimony of each witness, after such reduction to writing, shall be read over to him and signed by him in the presence of the examiner and of such of the parties or counsel as may attend; provided, that if the witness shall refuse to sign his deposition so taken, then the examiner shall sign the same, stating upon the record the reasons, if any, assigned by the witness for such refusal.

"The examiner may, upon all examinations, state any special matters to the court as he shall think fit, and any question or questions which may be objected to shall be noted by the examiner upon the deposition, but he shall not have power to decide on the competency, materiality, or relevancy of the questions; and the court shall have power to deal with the costs of incompetent, immaterial, or irrelevant depositions, or parts of them, as may be just.

"In case of refusal of witnesses to attend, to be sworn, or to answer any question put by the examiner, or by counsel or solicitor, the same practice shall be adopted as is now practiced with respect to witnesses to be produced on examination before an examiner of said court on written interrogatories.

"Notice shall be given by the respective counsel or solicitors to the opposite counsel or solicitors, or parties,

of the time and place of the examination, for such reasonable time as the examiner may fix by order in each cause.

"When the examination of witnesses before the examiner is concluded, the original depositions, authenticated by the signature of the examiner, shall be transmitted by him to the clerk of the court, to be there filed of record, in the same mode as prescribed in Section 865 of the Revised Statutes.

"Testimony may be taken on commission in the usual way, by written interrogatories and cross-interrogatories, on motion to the court in term time, or to a judge in vacation, for special reasons, satisfactory to the court or judge.

"Where the evidence to be adduced in a cause is to be taken orally, as before provided, the court may, on motion of either party, assign a time within which the complainant shall take his evidence in support of the bill, and a time thereafter within which the defendant shall take his evidence in defense, and a time thereafter within which the complainant shall take his evidence in reply; and no further evidence shall be taken in the cause unless by agreement of the parties or by leave of court first obtained on motion for cause shown.

"The expense of the taking down of depositions by a stenographer and of putting them into typewriting or other writing, shall be paid in the first instance by the party calling the witness and shall be imposed by the court, as part of the costs, upon such party as the court shall adjudge should ultimately bear them.

"Upon due notice given, as prescribed by previous order, the court may, at its discretion, permit the whole or any specific part of the evidence to be adduced orally in open court upon final hearing."

68.

"Testimony may also be taken in the cause after it is at issue, by deposition, according to the act of Congress. But in such case, if no notice is given to the adverse party of the time and place of taking the deposition, he shall, upon motion and affidavit of the fact, be entitled to a cross-examination of the witness either under a commission or by a new deposition taken under the acts of Congress if a court or judge thereof shall, under all the circumstances, deem it reasonable."

69.

"Three months and no more, shall be allowed for the taking of testimony after the cause is at issue, unless the court, or a judge thereof shall, upon special cause shown by either party, enlarge the time; and no testimony taken after such period shall be allowed to be read in evidence at the hearing. Immediately upon the return of the commissions and depositions containing the testimony into the clerk's office, publication thereof may be ordered in the clerk's office by any judge of the court upon due notice to the parties, or it may be enlarged, as he may deem reasonable, under all the circumstances; but, by consent of the parties, publication of the testimony may at any time pass into the clerk's office, such consent being in writing and a copy thereof entered into the order books or indorsed upon the deposition or testimony."

TESTIMONY DE BENE ESSE.

70.

"After any bill filed and before the defendant hath answered the same, upon affidavit made that any of the plaintiff's witnesses are aged and infirm, or going out of the country, or that any one of them is a single wit-

ness to a material fact, the clerk of the court shall, as of course, upon the application of the plaintiff, issue a commission to such commissioner or commissioners as a judge of the court may direct, to take the examination of such witness or witnesses *de bene esse* upon giving due notice to the adverse party of the time and place of taking his testimony."

FORM OF THE LAST INTERROGATION.

71.

"The last interrogatory in the written interrogatories to take testimony now commonly in use shall in the future be altered and stated in substance thus: 'Do you know, or can you set forth any other matter or thing which may be a benefit or advantage to the parties at issue in this cause, or either of them, or that may be material to the subject of this your examination, or the matters in question in this cause? If yea, set forth the same fully and at large in your answer.' "

§ 407. The method of taking testimony.

As indicated by the rule (67) the testimony may be taken in open court,[623] or by commission.[624] In practice the testimony is usually taken before a notary public, the clerk of a court of the United States, or an United States Commissioner, under stipulation that he may act as a special examiner by consent of the parties.

Examiners may be appointed to take testimony outside of the territorial jurisdiction of the court.[625]

The Examiner will note all objections, and will note the exceptions taken, but cannot decide upon their validity. He must take down the entire examination in

623. In re Clarke, 9 Blatchf. 372, Fed. Case 2801.

624. Bischoffscheim v. Baltzen, 10 Fed. Rep. 1.

625. White v. Toledo, St. L. & K. C. R. Co., 79 Fed. Rep. 133, 24 C. C. A. 467.

writing and send it to the court with the objections noted. The same method is followed regardless of whether the testimony is taken under the Equity Rule, or under the acts of Congress, or otherwise. After the deposition is filed further exceptions may be taken before the court.[626]

The matter to which objections are directed must be pointed out, and specific grounds of objection stated.[627]

§ 408. The scope of examination of witnesses.

A very wide latitude of examination in equity causes was established by the Supreme Court in the leading case of Blease v. Garlington,[628] of which it has been said: "The Supreme Court ruled that in suits in equity all the evidence sought by either party, whether it was received or rejected by the trial court, should be elicited, and in case of an appeal, presented to the Supreme Court, to the end that, if that court were of the opinion that the evidence rejected below should have been received, it might consider it and render a final decree without remanding the suit to procure the rejected evidence."[629] It has also been said of Blease v. Garlington: "The rationale of that decision is to prevent new trials in equity causes, and to that end to give the court of last resort a complete record, upon which it can finally dispose of the cause. For this reason, the objections for irrelevancy and immateriality are not to be considered. The only limitation upon the extent of the examination is apparently that it should be confined to the issues and shall not violate the personal privileges of witnesses."[630]

626. Appleton v. Ecaubert, 45 Fed. Rep. 281, 282.

627. Persons v. Bealing, 116 Fed. Rep. 877.

628. 92 U. S. 1, 23 L. Ed. 521.

629. Dowagiac Mfg. Co. v. Lochren, 143 Fed. Rep. 211, 213, 74 C. C. A. 341.

630. Continental Securities Co. v. Interborough Rapid Transit Co., 183 Fed. Rep. 132.

The proper method of raising the question of the privilege of the witness or the evidence sought to be adduced is for the witness to refuse to answer the question, which refusal is usually done under the advice of counsel noted in the Examiner's record,[631] and thereupon an application is made by counsel seeking to elicit testimony, to the proper Federal Judge in the district where the testimony is being taken.[632]

When such an application is made, if the court applied to directs the witness to answer, he may still decline to answer, and be committed for contempt; the order committing him for contempt is a final order and is reviewable on writ of error by the Circuit Court of Appeals.[633] If the lower court refuses to direct the witness to testify, a writ of mandamus may be sought by petition in the Circuit Court of Appeals to review the judgment of the lower court upon the question.[634] Where there is doubt as to the relevancy of the question the witness will be directed to answer.[635]

The Act of March 9, 1892, ch. 14, 27 Stat. at L. 7, provides: "That in addition to the mode of taking the depositions of witnesses in causes pending at law or equity in the district and circuit courts of the United States, it shall be lawful to take the depositions or testimony of witnesses in the mode prescribed by the laws of the State in which the courts are held."

This Act, so far as equity cases are concerned, has not enlarged or altered the rights of the party desiring to take testimony; the Act being intended only to simplify

631. Independent Baking Powder Co. v. Boorman, 137 Fed. Rep. 995.

632. Independent Baking Powder Co. v. Boorman, 137 Fed. Rep. 995.

633. Butler v. Fayerweather, 91 Fed. Rep. 458, 33 C. C. A. 625.

634. Dowagiac Mfg. Co. v. Lochren, 143 Fed. Rep. 211, 213, 74 C. C. A. 341.

635. Perry v. Rubber Tire Wheel Co., 138 Fed. Rep. 836.

the practice of taking depositions by providing that the mode of taking in instances authorized by the Federal laws might conform to the mode prescribed by the laws of the State in which Federal courts were held, and not to authorize the taking of depositions in instances not heretofore authorized by the Federal statutes, or to confer additional rights to obtain proofs by interrogatories addressed to the adverse party in actions at law.[636]

§ 409. Subpoenas duces tecum.

The subpoena *duces tecum* is employed to compel the production of documents in the possession of one who is not a party to the suit. It has been held that it may issue from the clerk's office, in the district in which the testimony is being taken, without application to the court.[637] It may be used to compel the production of drawings,[638] but cannot be used to reach models, or patterns.[639] The subpoena *duces tecum* may be employed to compel the production by a party of copies of his correspondence with the Patent Office.[640]

The better rule appears to be that subpoenas *duces tecum* will issue only upon a formal application reciting the specific documents desired, and their materiality.[641] Where the subpoena *duces tecum* calls for a large number of books and papers, many of which apparently are immaterial, the party disobeying it may not be punished

636. National Cash Register Co. v. Leland, 94 Fed. Rep. 502, 505, 37 C. C. A. 388.

637. Johnson Steel Street Rail Co. v. North Branch Steel Co., 48 Fed. Rep. 191.

638. Johnson Steel Street Rail Co. v. North Branch Steel Co., 48 Fed. Rep. 191.

639. In re Shephard, 3 Fed. Rep. 12; Johnson Steel Street Rail Co. v. North Branch Steel Co., 48 Fed. Rep. 191.

640. Edison Elec. Light Co. v. U. S. Electric Light Co., 44 Fed. Rep. 294.

641. Dancel v. Goodyear Shoe Mach. Co., 128 Fed. Rep. 753.

for contempt, and the moving party may be required to take out separate subpoenas, each to be considered upon its merits.[642]

§ 410. The master's appointment and proceedings before him—For what purposes appointed.

The master in chancery has been defined by Mr. Justice Field to be "an officer appointed by the court to assist it in various proceedings incidental to the progress of a cause before it, and is usually employed to take and state accounts, to take and report testimony, and to perform such duties as require computation of interest, the value of annuities, the amount of damages in particular cases, the auditing and ascertaining of liens upon property involved, and similar services. * * * It is not within the general province of a master to pass upon all the issues in an equity case, nor is it competent for the court to refer the entire decision of a case to him without the consent of the parties. It cannot, of its own motion, or upon the request of one party, abdicate its duty to determine by its own judgment the controversy presented, and devolve that duty upon any of its officers. But when the parties consent to the reference of a case to a master or other officer to hear and decide all the issues therein, and report his findings, both of fact and of law, and such reference is entered as a rule of the court, the master is clothed with very different powers from those which he exercises upon ordinary references, without such consent; and his determinations are not subject to be set aside and disregarded at the mere discretion of the court. A reference, by consent of parties, of an entire case for the determination of all its issues, though not

642. Miller v. Mutual Reserve Fund Life Assn., 139 Fed. Rep. 864.

strictly a submission of the controversy to arbitration—a proceeding which is governed by special rules—is a submission of the controversy to a tribunal of the parties' own selection, to be governed in its conduct by the ordinary rules applicable to the administration of justice in tribunals established by law. Its findings, like those of an independent tribunal, are to be taken as presumptively correct, subject, indeed, to be reviewed under the reservation contained in the consent and order of the court, where there has been manifest error in the consideration given to the evidence, or in the application of the law, but not otherwise.

"The reference of a whole case to a master, as here, has become in late years a matter of more common occurrence than formerly, though it has always been within the power of a court of chancery, with the consent of parties, to order such a reference. The power is incident to all courts of superior jurisdiction.[643] By statute, in nearly every State, provision has been made for such references of controversies at law. And there is nothing in the nature of the proceeding, or in the organization of a court of equity, which should preclude a resort to it in controversies involving equitable considerations."[644]

Where a court refers all the issues to a master without the consent of the parties, "his report is not clothed with that presumption in its favor which attends reports made on reference by consent;"[645] but such an order of reference is not treated as reversible error where the record shows that the trial court heard the case *de novo*

643. Citing Newcomb v. Wood, 97 U. S. 581, 583, 24 L. Ed. 1085, 1086.

644. Kimberly v. Arms, 129 U. S. 512, 32 L. Ed. 764, 769.

645. Adams, J., in Mastin v. Noble, 157 Fed. Rep. 506, 508, 85 C. C. A. 98.

on exceptions to the report, and reached an independent judgment on the proof.[646]

Where the entire case has been referred to the master in disregard of the protest of either party the appellate court will not give to his findings of fact or conclusions of law the weight to which they would have been entitled had he been appointed by consent, and will independently examine and pass upon the record.[647]

Where a record is silent as to whether such a reference was by consent, the appellate court will presume that the order of reference was consented to.[648]

"The master is a judicial officer, acting as the representative and substitute of the court which appointed him."[649]

In view of the authorities above referred to a reference of the whole case is seldom made in patent causes. When it is, as indicated by Mr. Justice Field, the proceedings will be governed by the ordinary rules applicable to such procedure in equity causes generally.

Usually, the master is appointed in patent causes as an incident to the entry of an interlocutory decree finding the patent or patents in suit to be valid and infringed, the general rule being that where the patent is sustained and infringement is admitted or proven, the complainant is entitled to a reference for an accounting as a matter of right.[650]

But this rule is not inexorable. A court is without power to order an accounting as to a patent that had

646. Mastin v. Noble, 157 Fed. Rep. 506, 508, 85 C. C. A. 98; Babcock v. De Mott, 160 Fed. Rep. 882, 887, 88 C. C. A. 64.

647. Garinger v. Palmer, 126 Fed. Rep. 906, 910, 61 C. C. A. 436.

648. Haight & Freese Co. v. Weiss, 156 Fed. Rep. 328, 334, 84 C. C. A. 224.

649. Wales, J., in Bate Refrigerating Co. v. Gillette, 28 Fed. Rep. 673, 674.

650. Campbell Printing Press Co. v. Manhattan R. Co., 49 Fed. Rep. 930, 932; Keystone Mfg. Co. v. Adams, 151 U. S. 139, 38 L. Ed. 103-105.

expired before the bill was filed; this being ruled in a case involving two patents, one of which had expired before the bill was filed.[651]

An accounting has been denied upon the ground that the complainant's device was too costly to have any commercial value.[652]

The Circuit Court of Appeals of the Fifth Circuit has said:

"A reference will not be made to state an account without some evidence to show the necessity for the accounting. An order for an accounting is not made to enable the complainant to make out his case before the master. There must be, at least, sufficient evidence to show the right to demand the accounting."[653]

In patent causes, as in any other class of litigation, a court of equity may always refer pleadings to a master, and it is its duty so to do where the pleadings do not conform to the rules. In a case involving an ancillary bill, Judge Putnam said: "Some of these matters (vague and otherwise improper allegations) are mere surplusage, and some are of a character, which are available only on special demurrer, but would unnecessarily open out a field without limits or bounds, as we have said, if allowed to remain in the bill. Therefore, before proceeding with such a bill the Circuit Court should send it to a master to be purged of everything which is found not to conform to the standard rules of equity pleading. Equity Rule 27 may not be sufficiently broad to reach this case; but, so long as any bill fails to comply with the standard maxims of pleading to which we have referred, and especially fails to comply with Equity Rule 26, it is within

651. Creamer v. Bowers, 30 Fed. Rep. 185, 187.

652. Bradford v. Belknap Motor Co., 105 Fed. Rep. 63, 65.

653. Per Curiam, in Columbia Equipment Co. v. Mercantile Trust & Deposit Co., 113 Fed. Rep. 23, 25, 51 C. C. A. 33; citing, Railroad Co. v. Williams, 94 Va. 422, 26 S. E. 841.

the general powers of the court, when it becomes necessary for its own protection so to do, to proceed of its own motion in the way we have pointed out."[654]

It would seem that a court of equity under our Federal practice may invoke the assistance of the master in the course of its labors, to any extent short of referring all of the issues raised by the pleadings, without the consent of the parties. Thus, an application being made during the taking of proof to compel the respondent to repeat certain experiments in the presence of complainant's witnesses, Judge Putnam said:

"The complainant represents that the respondent was invited to witness its experiments, but that the respondent's experiments were made aside from the complainant; and the practical object of the motion is to compel the respondent to repeat its experiments in the presence of the complainant's witnesses. The experiments on either side were not conducted by persons of merely ordinary skill in the art, but by experts. The complainant produces to the court no precedent sustaining its motion, the authorities cited by it going only to the matter of inspection, which is a well-known branch of incidental equitable proceedings. It is not, however, safe to undertake to set a limit to what can be worked out by the equity courts in the direction of just and proper investigation with reference to any topics concerned in legal or equitable proceedings; but it is entirely clear that such extraordinary relief as the complainant asks should not be granted except when it is plainly necessary. As is usual with motions of an interlocutory character touching the progress of a complicated suit in equity in advance of a final hearing, it is impracticable for the court, without

654. Hobbs Mfg. Co. v. Gooding, 176 Fed. Rep. 259, 263, —— C. C. A. ——; citing, Kelley v. Boettcher, 85 Fed. Rep. 55, 61, 29 C. C. A. 14.

very elaborate investigation, to understand clearly the current condition of the litigation, so as to be reasonably certain that it can adjudicate correctly. It appears to us that the probable results of the experiments which the complainant desires the court to order would not be of such a character as to justify unusual, and perhaps unprecedented, proceedings. Moreover, it may well be doubted whether the issue to which the motion relates is a relevant one, and whether, in accordance with the general rule that the law applicable to patents is practical in its nature, the questions of anticipation developed by the uses to which prior inventions may be applied extend to all which can be worked out by the ingenuity of experts, and are not limited to uses apparent to persons of ordinary skill in the art. To make these matters certain would require an examination of the pleadings and proofs in the case, which cannot be expected of the court on an interlocutory matter of this nature.

"Under the circumstances of this application, the complainant cannot be charged with laches in the matter; so that if, on opening the record on final hearing on bill, answer, and proofs, it should appear that the court needs the assistance of such experiments as are now desired by the complainant, the court has no doubt that it can do complete justice by sending to a master so much of the case as is now brought to its attention, to report on the issue underlying the present motion, and for that purpose to make experiments under proper directions. While it is well settled in the Federal practice that the chancellor cannot abnegate his duty to hear the fundamental issue in a cause without the same being clouded or prejudiced by a master's report (Kimberly v. Arms, 129 U. S. 512, 524, 32 L. Ed. 764, 769; Davis v. Schwartz, 155 U. S. 631, 637, 39 L. Ed. 289), yet it is a common practice to permit inquiries by a master incidental to the

principal labor which rests on the court (Field v. Holland, 6 Cranch 8, 22, 3 L. Ed. 303; Lawrence v. Dana, 4 Cliff. 1, Fed. Case 8136). Indeed, on bills for specific performance it has been the settled course in England to direct a preliminary inquiry as to title by a master. Having no doubt of our power to obviate in this way the difficulty which the complainant thinks now meets it, if it becomes necessary to do so, we deny complainant's motions, without prejudice to its right to apply for a master, as we have indicated, in connection with the final hearing."[655]

§ 411. The appointment of the master.

Equity Rule 82 provides, in part, that:

"The Circuit Courts may appoint standing masters in chancery in their respective districts (a majority of all the judges thereof, including the justice of the Supreme Court, the Circuit Judges, and the District Judge for the district concurring in the appointment) and they may also appoint a master *pro hac vice* (for the occasion), in any particular case."

The statutory provisions concerning the persons who may be appointed as master are as follows:

"No clerk of the District or Circuit Courts of the United States or their deputies shall be appointed a receiver or a master in any case except where the judge of said court shall determine that special reasons exist therefor to be assigned in the order of appointment." (20 Stat. at L. 415, 4 Fed. Stat. Ann. 81). See § 68, The Judicial Code.

"That no person related to any justice or judge of any court of the United States by affinity or consanguinity within the degree of first cousin shall hereafter be

655. Simonds Rolling Mach. Co. v. Hathorn Mfg. Co., 83 Fed. Rep. 490, 491.

appointed by such court or judge to, or employed by such court or judge in, any office or duty in any court of which such justice or judge may be a member." (25 Stat. at L. 437, 4 Fed. Stat. Ann. 69). See § 67, The Judicial Code.

Where a clerk or deputy clerk is appointed master, without a special reason being assigned in the order, his acts have been upheld as valid, so far as the public and third persons are concerned, as those of a *de facto* officer.[656] Where the parties consent to the appointment of the clerk or deputy clerk as the master, their consent is a special reason and should be assigned in the order of appointment. A failure under such circumstances to state the special reason in the decree may be cured after the coming in of the master's report, by an amendment, *nunc pro tunc*, as of the date of the original order.[657] If the court in fact has determined that a special reason exists justifying such an appointment of a clerk or deputy clerk, the omission of the special reason from the order will not be treated as reversible error on appeal, where the opinion of the court below recites the reason.[658]

§ 412. The procedure before the master.

Judge Lowell outlined the course of procedure before the master as follows:

"The practice which we approve is this: The master appoints a day for proceeding with the reference, and gives notice, by mail or otherwise, to the parties or their solicitors. We think the solicitor should be notified,

656. Northwestern Mutual L. Ins. Co. v. Seaman, 80 Fed. Rep. 357; Seaman v. Northwestern Mutual L. Ins. Co., 86 Fed. Rep. 493, 30 C. C. A. 212; Elgutter v. Northwestern L. Ins. Co., 86 Fed. Rep. 500, 30 C. C. A. 218.

657. Fischer v. Hayes, 22 Fed. Rep. 92, 93.

658. Briggs v. Neal, 120 Fed. Rep. 224, 56 C. C. A. 572.

whether the party is or not; though, probably, under Rule 75, notice to the party is a good notice. If the defendant does not appear, the master proceeds, *ex parte*, and makes out the profits and damages, if he can, from the evidence produced by the plaintiff. If it appears that an account of profits is necessary to a just decision of the cause, and is desired by the plaintiff, he makes an order that the defendant furnish an account by a certain day, and adjourns the hearing to that day. The defendant should be served personally with a notice of this adjournment, and of the order to produce his account, if it is intended to move for an attachment in case he fails to appear. The service may be made by any disinterested person, and need not be by the marshal. If the defendant then fails to appear and account, he will be in contempt.

"The mode of proceeding which we do not approve, is for the plaintiff to take out a notice, in the first instance, before any hearing has been or can lawfully be had, requiring the defendant to furnish an account by a certain day on pain of punishment for contempt. We doubt the power of the master to make such an order upon a mere inspection of the record, and we consider the practice inexpedient if it is lawful."[659]

The Equity Rules relating to references, provide as follows:

"74. Whenever any reference of any matter is made to a master to examine and report thereon, the party at whose instance and for whose benefit the reference is made shall cause the same to be presented to the master for a hearing on or before the next rule day succeeding the time when the reference was made; if he shall omit to do so, the adverse party shall be at liberty forthwith

659. Kerosene Lamp Heater Co. v. Fisher, 1 Fed. Rep. 91, 92.

to cause proceedings to be had before the master, at the cost of the party securing the reference."

"75. Upon every such reference it shall be the duty of the master, as soon as he reasonably can, after the same is brought before him, to assign a time and place for proceedings in the same, and to give due notice thereof to each of the parties or their solicitors; and if either party shall fail to appear at the time and place appointed, the master shall be at liberty to proceed *ex parte*, or, in his discretion, to adjourn the examination and proceedings to a future day, giving notice to the absent party or his solicitor of such adjournment; and it shall be the duty of the master to proceed with all reasonable diligence in every such reference, and with the least practicable delay, and either party shall be at liberty to apply to the court, or a judge thereof, for an order to the master to speed the proceedings and to make his report, and to certify to the court or judge the reasons for any delay."

"77. The master shall regulate all the proceedings in every hearing before him, upon every such reference; and he shall have full authority to examine the parties in the cause, upon oath, touching all matters contained in the reference; and also to require the production of all books, papers, writings, vouchers, and other documents applicable thereto; and also to examine on oath, *viva voce*, all witnesses produced by the parties before him, and to order the examination of other witnesses to be taken, under a commission to be issued upon his certificate from the clerk's office, or by deposition, according to the act of Congress, or otherwise, as hereinafter provided; and also to direct the mode in which the matters requiring evidence shall be proved before him; and generally to do all other acts and direct all other inquiries and proceedings in the matters before him, which he may

deem necessary and proper to the justice and merits thereof and the rights of the parties."

"79. All parties accounting before a master shall bring in their respective accounts in the form of debtor and creditor; and any of the other parties who shall not be satisfied with the accounts so brought in shall be at liberty to examine the accounting party, *viva voce*, or upon interrogatories in the master's office, or by deposition, as the master shall direct."

"80. All affidavits, depositions, and documents which have been previously made, read or used in the court, upon any proceeding in any cause or matter, may be used before the master."

Where a defendant has produced the contracts under which infringing machines were sold, the master may properly require him to produce before him the correspondence relating to said contracts, under the provisions of the 77th Rule.[660]

While the master may at all times apply to the court for directions, he must, at least in the first instance, rule upon the order of proof, such as the admission, in rebuttal, of testimony not rebuttal in character.[661]

Judge Wheeler has interpreted Rule 80 to mean that any part of the antecedent record in the case may be brought before the master without being retaken, by calling his attention to the desired part so that it may be answered or explained on the other side; but that it will not suffice to merely refer to such former testimony in argument and requests for findings; so that an exception to the master's report based upon his failure to make findings in accordance with a record not offered before him, must be overruled.[662]

660. Goss Printing Press Co. v. Scott, 119 Fed. Rep. 941.

661. Wooster v. Gumbirnner, 20 Fed. Rep. 167.

662. Bell v. United States Stamping Co., 32 Fed. Rep. 549, 550.

§ 413. Master's duties in assessing profits and damages.

The courts have realized the difficulty, in equity, "of making sufficient proof to satisfy the law under either head,"[663] consequently where a master's report showed that while he believed the proof sufficient to make out a case for damages, he also reported his conclusions as to the evidence supporting the complainant's claim for profits, the Court of Appeals for the Sixth Circuit endorsed this method of formulating his report as being "well advised, as conducive to a proper result."[664]

The master should include in the accounting all of the infringing acts, down to the time of filing his report. If the defendant has made machines of changed construction, he should report as to them.[665] If there is any dispute between the parties as to infringement which has not been concluded by the decree, it is open to be passed upon by the master.[666]

"There may be cases where the differences are so great and the question of infringement in such doubt that neither the master nor the court will feel justified in going into them, and where the complainant may properly be put to at least a supplemental, if not a new, bill."[667]

The modern practice is for the master to refuse to admit testimony he deems irrelevant, permitting the

663. Severens, J., in P. P. Mast Co. v. Superior Drill Co., 154 Fed. Rep. 45, 51, 83 C. C. A. 157.

664 P. P. Mast Co. v. Superior Drill Co., 154 Fed. Rep. 45, 51, 83 C. C. A. 157.

665. Hoe v. Scott, 87 Fed. Rep. 220.

666. Wooster v. Thornton, 26 Fed. Rep. 274; Thomas v. Electric Porcelain Co., 114 Fed. Rep. 407; Hanifen v. Armitage, 117 Fed. Rep. 845, 851; Westinghouse Mfg. Co. v. Sangamo Elec. Co., 128 Fed. Rep. 747.

667. Archbald, J., in Walker Patent Pivoted Bin Co. v. Miller, 146 Fed. Rep. 249, 252; citing, California Artificial Stone Paving Co. v. Molitor, 113 U. S. 609, 28 L. Ed. 1106; Westinghouse Air Brake Co. v. Christensen Enginering Co., 126 Fed. Rep. 764; Chicago Grain Door Co. v. Chicago, B. & Q. R. R., 137 Fed. Rep. 101.

party ruled against to bring the question at once to the court for review and instructions.[668]

§ 414. The master's report.

At the conclusion of the testimony the master's next duty is the preparation of his report. Equity Rules 83 and 84 provide:

"83. The master, as soon as his report is ready, shall return the same into the clerk's office, and the day of the return shall be entered by the clerk in the order book. The parties shall have one month from the time of filing the report to file exceptions thereto; and if no exceptions are within that period filed by either party, the report shall stand confirmed on the next rule day after the month is expired. If exceptions are filed they shall stand for hearing before the court, if the court is then in session; or, if not, then at the next sitting of the court which shall be held thereafter by adjournment or otherwise."

"84. And in order to prevent exceptions to reports from being filed for frivolous causes, or for mere delay, the party whose exceptions are overruled shall, for every exception overruled, pay costs to the other party, and for every exception allowed shall be entitled to costs, the costs to be fixed in each case by the court by a standing rule of the circuit court."

It is the practice in some circuits for the master to prepare a draft or tentative report and submit it to the parties for their suggestions and objections; their objections should be reduced to writing and filed with the master,[669] and it is certainly the better practice to decline

668. Walker Patent Pivoted Bin Co. v. Miller, 146 Fed. Rep. 249, 252; Coddington v. Propfe, 112 Fed. Rep. 1016. To the same effect, see, Murray v. Orr & Lockett Hdw. Co., 153 Fed. Rep. 369, 82 C. C. A. 445.

669. Gaines v. New Orleans, 1 Woods 104, Fed. Case 5177; Troy v. Corning, 6 Blatchf. 328, Fed.

to entertain any exceptions to the report as to matters which the master did not have called to his attention.[670]

A loose practice as to the master's report obtains in some jurisdictions, rendering the draft report unnecessary, the reasons in support of which were fully discussed by Judge Gresham.[671] Judge Wallace has held that, even under the practice requiring a draft report and exceptions thereto before the master, no exceptions are necessary as to the ultimate question of fact decided by the master, nor does the failure to except before the master preclude the parties from being heard as to the correctness of his legal conclusions.[672]

In the absence of a requirement in the order of reference, the master need not annex to his report all the testimony taken before him;[673] and the 76th Equity Rule governs the making up of his report, as follows:

"76. In the reports made by the master to the court, no part of any state of facts, charge, affidavit, deposition, examination, or answer brought in or used before them shall be stated or recited. But such state of facts, charge, affidavit, deposition, examination, or answer shall be identified, specified, and referred to, so as to inform the court what state of facts, charge, affidavit, deposition, examination or answer were so brought in or used."

The procedure upon the filing of the report is fixed by Equity Rule 83:

Case 14,196; Fischer v. Hayes, 16 Fed. Rep. 469; McNamara v. Home Land & Cattle Co., 105 Fed. Rep. 202, 204; Celluloid Mfg. Co. v. Cellonite Mfg. Co., 40 Fed. Rep. 476.

670. Gay Mfg. Co. v. Camp, 68 Fed. Rep. 66, 68, 15 C. C. A. 226.

671. Hatch v. Indianapolis & S. R. Co., 9 Fed. Rep. 856; Jennings v. Dolan, 29 Fed. Rep. 861; Celluloid Mfg. Co. v. Cellonite Mfg. Co., 40 Fed. Rep. 476, 477.

672. Celluloid Mfg. Co. v. Cellonite Mfg. Co., 40 Fed. Rep. 476, 477.

673. Sheffield & B. Co. v. Gordon, 151 U. S. 285, 293, 38 L. Ed. 164; Weiss v. Haight & Freese Co., 148 Fed. Rep. 399.

"83. The master, as soon as his report is ready, shall return the same into the clerk's office, and the day of the return shall be entered by the clerk in the order book. The parties shall have one month from the time of filing the report to file exceptions thereto; and if no exceptions are within that period filed by either party, the report shall stand confirmed on the next rule day after the month is expired. If exceptions are filed they shall stand for hearing before the court, if the court is then in session; or, if not, then at the next sitting of the court which shall be held thereafter by adjournment or otherwise."

The term of "one month" in this rule means a calendar month.[674] Exceptions may be filed at any time within a month, under this rule,[675] but if filed out of time will be overruled.[676]

§ 415. Exceptions, requirements of.

"Exceptions to the report of a master should be set out specifically."[677] They need not be as full and specific as a special demurrer,[678] and they need not be artistically drawn.[679] An exception to a finding as not being "supported by the proofs" is not sufficiently specific to enable the court to review it.[680]

674. Gasquet v. Crescent City Brewing Co., 49 Fed. Rep. 496.

675. Fidelity Ins. & Safe Dep. Co. v. Shenandoah Iron Co., 42 Fed. Rep. 872.

676. Syz v. Redfield, 11 Fed. Rep. 799.

677. Sheffield & B. R. Co. v. Gordon, 151 U. S. 285, 38 L. Ed. 164; to the same effect, see, Neal v. Briggs, 110 Fed. Rep. 473, 478.

678. Foster v. Goddard, 66 U. S. (1 Black) 506, 17 L. Ed. 228.

679. Story v. Livingston, 38 U. S. (13 Peters) 359, 10 L. Ed. 200; Central Trust Co. v. Wabash, St. L. & P. R. Co., 57 Fed. Rep. 441.

680. Haller v. Clark, 21 App. D. C. 128.

§ 416. Effect of master's report.

"The findings of fact by a master are supported by a strong presumption of correctness, and will not be set aside or modified in the absence of mistake or error."[681]

Immaterial mistake or error, not affecting the result, is not ground for recommitting or of setting aside the report.[682]

A re-reference is not necessary where errors in the report can readily be corrected by the court.[683] Where the evidence is substantially conflicting the report will be sustained.[684]

Parts of the report not specifically excepted to are taken as admitted.[685]

§ 417. Damages in equity—When established license fee the basis of recovery in equity.

Where there is an established license fee it is the measure of the damages to be recovered for an infringement;[686] although it "constitutes no element affecting the profits derived by the defendant."[687]

Proof of an established license fee, therefore, in equity as at law, bears only upon damages and is irrelevant upon the subject of the complainant's recovery of profits.

Prior to the Act of 1870, profits and damages were not recoverable in a single suit, profits only being assessable

681. Lurton, J., in Columbus, S. & H. R. Co. Appeals, 109 Fed. Rep. 177, 218, 48 C. C. A. 275; citing, Camden v. Stuart, 144 U. S. 104, 36 L. Ed. 363; Lake Erie & W. R. Co. v. City of Fremont, 92 Fed. Rep. 721, 34 C. C. A. 625; Girard Life Ins. Co. v. Cooper, 162 U. S. 529, 40 L. Ed. 1062.

682. Gottfried v. Crescent Brewing Co., 22 Fed. Rep. 433.

683. Witters v. Sowles, 43 Fed. Rep. 405.

684. Jaffrey v. Brown, 29 Fed. Rep. 476; Huttig Sash & Door Co. v. Fuelle, 143 Fed. Rep. 363.

685. General Fire Extinguisher Co. v. Lamar, 141 Fed. Rep. 353, 72 C. C. A. 501.

686. Suffolk Co. v. Hayden, 3 Wall. 315, 18 L. Ed. 76.

687. Sawyer, J., in Knox v. Great Western Quicksilver Mining Co., 6 Sawyer 430, 4 Bann. & Ard. 25, 14 Off. Gaz. 897, Fed. Case, No. 7907.

in equity, and damages only being imposed as the remedy at law.[688] Section 55 of that act gave to courts of equity the power to award or multiply damages, in addition to the accounting of profits.[689] The legislative purpose in this enactment was to provide for a complete and adequate remedy in equity, in those cases where the defendant could not be shown to have made any profit,[690] and in the cases where the defendant's proven profits were manifestly inadequate compensation to the complainant.[691]

§ 418. Damages in equity—How proven.

The general rule is that damages in equity may be proven just as in actions at law. They may be awarded even in the absence of any proof as to the defendant's profits.[692] An established royalty is a proper standard by which to measure the damages,[693] and it may be proven by licensing contracts made during the pendency of the case.[694]

The complainant may invoke his own profits on the patented article as a basis for the assessment of damages. He "is not required to show by direct evidence that he would have made all or some part of the sales which were made by his competitor, and, indeed, it would generally be impossible to do so; but he must prove facts and circumstances which legitimately create the pre-

688. Willimantic Thread Co. v. Clark Thread Co., 27 Fed. Rep. 865.

689. Root v. Lake Shore & M. S. R. R. Co., 105 U. S. 189, 26 L. Ed. 975.

690. Marsh v. Seymour, 97 U. S 348, 24 L. Ed. 963; Yale Lock Co. v. Sargent, 117 U. S. 536, 29 L. Ed. 954; Burdett v. Estey, 3 Fed. Rep. 566.

691. Simpson v. Davis, 22 Fed. Rep. 444.

692. Locomotive Safety Truck Co. v. Pennsylvania R. R. Co., 2 Fed. Rep. 671, 681.

693. Locomotive Safety Truck Co. v. Pennsylvania R. R. Co., 2 Fed. Rep. 671, 682.

694. P. P. Mast & Co. v. Superior Drill Co., 154 Fed. Rep 45, 51.

sumption that he would have made the sales himself had it not been for the sales of the infringer."[695] But there is no presumption that the complainant would have made such sales, and where the master estimated damages on the basis of such a presumption the cause was referred back to him with leave to the complainant to introduce further testimony.[696]

Where the proper foundation has been laid, the profits which the complainant might have made on sales to the extent of the defendant's sales may be awarded to him as damages, though in excess of the defendant's profits, but it is not proper to add his losses to the defendant's profits.[697]

The complainant must show that he was able to supply the demand supplied by the defendant, in order to recover damages upon the basis of what his profits would have been had he sold the number of devices sold by the defendant.[698]

§ 419. Profits—Difficulty of proving.

In approaching the question of profits in equity, we find that the burden of proof placed upon the complainant renders the recovery of substantial profits a matter of the utmost difficulty. The defendant was not held accountable for either substantial profits or substantial damages in any appreciable number of the reported cases. The general rule was thus expressed by the Supreme Court:

"The patentee must in every case give evidence tending to separate or apportion the defendant's profits and

695. Wallace, J., in Covert v. Sargent, 38 Fed. Rep. 237. To the same effect, see, Kinner v. Shepard, 107 Fed. Rep. 952.

696. Jennings v. Rogers Silver Plate Co., 105 Fed. Rep. 967.

697. Westinghouse v. New York Air Brake Co., 131 Fed. Rep. 607.

698. McSherry Mfg. Co. v. Dowagiac Mfg. Co., 160 Fed. Rep. 948.

the patentee's damages between the patented features and the unpatented features, and such evidence must be reliable and tangible, and not conjectural and speculative; or he must show by equally reliable and satisfactory evidence that the profits and damages are to be calculated on the whole machine, for the reason that the entire value of the whole machine as a marketable article is properly and legally attributable to the patented feature."[699]

The problem of separating the patented from the unpatented features has proved a bulwark of safety for the infringer in numerous cases. The Circuit Court of Appeals for the Second Circuit has conceded that "in many cases, where it is obvious that the patented invention has contributed a great part of the profits realized from selling the infringing article or apparatus embodying unpatented features, it is practically impossible for the complainant to establish affirmatively the proportionate part."[700] It has been argued that the infringer is in the position of a trustee *ex maleficio*, and should be subjected to the ordinary rule that a trustee who has commingled trust funds with his own, so that they cannot be segregated, must account for the whole. Of this argument, the Court of Appeals last quoted from has said, "such a rule would work unjustly in many cases, as where the patented feature is of an insignificant part of a machine or article; and it is probably because of its manifest inequity in such cases that the courts have placed upon the complainant the burden of proof."[701]

699. Garretson v. Clark, 111 U. S. 120, 28 L. Ed. 311, quoting the language of Mr. Justice Blatchford in the circuit court in Garretson v. Clark, 15 Blatchf. 70, Fed. Case 5248.

700. Wales v. Waterbury Mfg. Co., 101 Fed. Rep. 126, 41 C. C. A. 250.

701. Wales v. Waterbury Mfg. Co., 101 Fed. Rep. 126, 41 C. C. A. 250; quoted and followed, in Westinghouse v. New York Air Brake Co., 140 Fed. Rep. 545, 549, 72 C. C. A. 61.

The practical application of the rule of Garretson v. Clark has been to greatly impair the value of patent property, by giving to infringer the benefit of a rule with which the plaintiff can rarely comply. It is entirely probable that the Supreme Court may modify or qualify that rule in the future, and mitigate the evils which have arisen under it. In Great Britain we find high authority saying that "the fact that only part of the machine is an infringement is immaterial, since each thing produced by the assistance of such part is itself an infringement of the plaintiff's patent, and to that extent occasions damage by interfering with the plaintiff's trade."[702] And we find their courts averse to the practice of setting aside judgments for damages for infringement because of the difficulties attending the proof; saying, for example, "no one can doubt that in this case there was substantial damage, and the difficulty and impossibility of stating the precise ground for assessing it at any particular figure does not seem to be a sufficient reason for giving only a nominal sum."[703]

§ 420. Some suggestions preliminary to analysis of the cases bearing on profits.

In endeavoring to summarize the chaotic decisions relating to the recovery of profits in equity, these general suggestions may aid in laying a general foundation. *Imprimis*, it was never the intent of Congress to place upon the patentee or his assigns the burden and difficulty which now make the complainant in an accounting wander through an endless labyrinth. The tortuous course of the account is a monument to judicial obstructions cast in the way of a statutory remedy.

702. Terrell on Patents (Fourth Edition, 1906), p. 331.

703. Wright, J., in Ungar v. Sugg, 8 P. O. R. 388.

The patent act provides for treble damages; the Equity Rules direct the accounting party to bring in his account in the form of debtor and creditor (Rule 79); the first remedy shows the solicitude of Congress that the inventor should be made whole by the tortfeasor, the second, that the Supreme Court in establishing the Equity Rules intended that the procedure on accounting should be speedy and simple, and that the burden of proof should be upon the defendant on accounting, and not on the complainant.

As to the burden of proof the inequity of shifting it from the one who has done the wrong to the one who has suffered the injury, is a strange perversion of the status of the parties. To extend that doctrine to the length of compelling the complainant to segregate what part of the total profits realized by the defendant was due to the infringement, from that which was not, fits strangely with the definitions of equity. Are these strange doctrines founded on statute? If not, where do they find their counterpart or analogy in the general principles of equity?

The question of the burden of proof lies very near the inception of the tangled and confusing judge-made doctrines affecting, and well-nigh prohibiting, the recovery of money judgments for patent infringement in equity. But the question of the burden of proof should be considered apart from, and not inextricably interwoven with, the established doctrines which may be thus tabulated:

1. That the right of the owner of a patent to recover profits in equity depends upon the status of the patent in its art, no matter how exact the infringement may be.

2. That the extent of the recovery of profits in equity depends upon the extent to which the infringement makes the article containing the infringement salable, no matter how exact the infringement may be.

3. That the extent of the recovery of profits in equity is controlled by the fact that there was open to the infringer some unpatented machine or method by which he could have accomplished the same, or a similar result, no matter how exact the infringement may be.

§ 421. The fundamental rule as to profits.

A proper understanding of the law governing the assessment of profits for patent infringement must begin with the basic rule which was expressed by Mr. Justice Gray, as follows:

"Upon a bill in equity by the owner against infringers of a patent, the plaintiff is entitled to recover the amount of gains and profits that the defendants have made by the use of his invention.

"This rule was established by a series of decisions under the Patent Act of 1836, which simply conferred upon the courts of the United States general equity jurisdiction, with the power to grant injunctions, in cases arising under the patent laws."[704]

The foregoing extract is of value because it clearly sets forth the elementary rule concerning the assessment of profits, and because it shows that the rule was judi-

704. Mr. Justice Gray, in Tilghman v. Proctor, 125 U. S. 136, 161, 31 L. Ed. 664, 666; citing Livingston v. Woodworth, 56 U. S. (15 How.) 546, 14 L. Ed. 809; Dean v. Mason, 61 U. S. (20 How.) 198, 15 L. Ed. 876; Providence Rubber Co. v. Goodyear, 76 U. S. (9 Wall.), 788, 19 L. Ed. 566; Mowry v. Whitney, 81 U. S. (14 Wall.) 620, 20 L. Ed. 860; Littlefield v. Perry, 88 U. S. (21 Wall.) 205, 229, 22 L. Ed. 577, 581; Mason v. Graham, 90 U. S. (23 Wall.), 261, 23 L. Ed. 86; Tremolo Patent, 90 U. S. (23 Wall.) 518, 23 L. Ed. 97; Cawood Patent, 94 U. S. 695, 24 L. Ed. 238; Mevs v. Conover, 131 U. S. cxlii, 11 Off. Gaz. 1111, 23 L. Ed. 1008; Elizabeth v. American Nicholson Pavement Co., 97 U. S. 126, 24 L. Ed. 1000; Root v. Lake Shore & M. S. R. Co., 105 U. S. 189, 26 L. Ed. 975.

cially developed in the absence of any statutory provision concerning profits. Reading further from the same opinion we find the following:

"The reasons that have led to the adoption of this rule are that it comes nearer than any other to doing complete justice between the parties; that in equity the profits made by the infringer of a patent belong to the patentee and not the infringer; and that it is inconsistent with the ordinary principles and practice of courts of chancery, either on the one hand, to permit the wrongdoer to profit by his own wrong, or, on the other hand, to make no allowance for the cost and expense of conducting his business, or to undertake to punish him by obliging him to pay more than fair compensation to the person wronged.

"The infringer is liable for actual, not for possible gains. The profits, therefore, which he must account for, are not those which he might reasonably have made, but those which he did make, by the use of the plaintiff's invention; or, in other words, the fruits of the advantage which he derived from the use of that invention, over what he would have had in using other means then open to the public and adequate to enable him to obtain an equally beneficial result. If there was no such advantage in his use of the plaintiff's invention, there can be no decree for profits, and the plaintiff's only remedy is by an action at law for damages.

"But if the defendant gained an advantage by using the plaintiff's invention, that advantage is the measure of the profits to be accounted for, even if from other causes the business in which that invention was employed by the defendant did not result in profits. If, for example, the unauthorized use by the defendant of a patented process produced a definite saving in the cost of manufac-

ture, he must account to the patentee for the amount so saved. This application or corollary of the general rule is as well established as the rule itself."[705]

§ 422. The subordinate rules.

The cases relating to the measure of profits recoverable for patent infringement appear to fall within three groups. These groups, and the rule of profit attaching to each are as follows:[706]

A. This rule we have before referred to as the rule of Garretson v. Clark.[707] It may best be stated in the language of the court:

"When a patent is for an improvement and not for an entirely new machine or contrivance, the patentee must show in what particulars his improvement has added to the usefulness of the machine or contrivance. He must separate its results distinctly from those of the other parts, so that the benefits derived from it may be distinctly seen and appreciated."[708]

This rule applies only where the patent in suit relates to an improvement upon a pre-existing and operative machine adapted to accomplish the same result, as Judge Sanborn has pointed out.[709]

This rule may be best understood by reference to the facts in some of the cases in which it has been applied. In the leading case of Garretson v. Clark[710] the improve-

705. Mr. Justice Gray, in Tilghman v. Proctor, 125 U. S. 136, 161, 31 L. Ed. 664, 667.

706. This division is suggested by Judge Sanborn's remarks, in his dissenting opinion, in, Westinghouse Elec. & Mfg. Co. v. Wagner Elec. & Mfg. Co., 173 Fed. Rep. 361, 375, 97 C. C. A. 621.

707. 111 U. S. 120, 28 L. Ed. 371.

708. Mr. Justice Field, in Garretson v. Clark, 111 U. S. 120, 28 L. Ed. 371.

709. Westinghouse Elec. & Mfg. Co. v. Wagner Elec. & Mfg. Co., 173 Fed. Rep. 361, 375, 97 C. C. A. 621.

710. 111 U. S. 120, 28 L. Ed. 371.

ment of the patent was a slight change in the jaw of the pre-existing and operative mop head.

Some of the other cases are as follows:

Where the improvement of the patent was a driver's seat used upon a pre-existing and successfully operative harvesting machine.[711] Where the improvement of the patent provided a coupling for canal boats combined with steering apparatus so as to enable both boats to be steered by means of one mechanism, the coupling of the boats and their separate steering means being old;[712] where the improvement of the patent was a revolving winged shaft attached to a pre-existing and operative corn sheller, the improvement being adapted to facilitate the movement of the corn into the sheller.[713]

B. Where the invention of the patent in suit relates to but one part of a structure, which structure embodies the invention of other subsisting patents. As stated in the leading case, in applying this rule, "inventions covered by other patents were embraced in those machines. It was not shown how much of the profit was due to those other patents, nor how much of it was manufacturer's profit. The complainant was, therefore, entitled only to nominal damages."[714]

On principle, this class of cases cannot be distinguished from those just referred to, where the prior machine or structure is unaffected by existing patents. So far as the rights of the parties to the litigation are concerned, it is immaterial whether the part of the defendant's structure embracing things foreign to the invention of the patent in suit, is made in infringement of

711. Seymour v. McCormick, 57 U. S. (16 How.) 480, 14 L. Ed. 1024.

712. McCreary v. Pennsylvania Coal Co., 141 U. S. 459, 35 L. Ed. 817.

713. Keystone Mfg. Co. v. Adams, 151 U. S. 139, 38 L. Ed. 103.

714. Mr. Justice Swayne, in Robertson v. Blake, 94 U. S. 728, 24 L. Ed. 245.

other patents, is made under license under other patents, or is not patented at all.

C. The third group of cases, embraces those cases where the entire profits derived by the defendant from the use or sale of the infringing structure as a whole are recoverable. There is great difficulty in determining whether a case falls within this class. To make this difficulty clear, we will advert to a few of the principal cases, and note the language employed by the courts in distinguishing patents within this class.

"We see no reason, in the record, for disturbing the conclusions of the master and the Circuit Court, that the entire commercial value of the valves made and sold by the defendant was due to the improvement covered by the patent of 1866, and that the plaintiff's valves of commerce all of them contain the improvements covered by the patent of 1866. Moreover, the master reports profits only, and finds that the plaintiff has suffered no damages in addition to the profits to be assessed against the defendant. If there had been an award of damages, and the loss of trade by the plaintiff, in consequence of the competition of the defendant, had been an element entering into those damages, it would have been a material fact to be shown by the plaintiff that it was putting on the market goods embodying the Richardson invention; but, as the plaintiff recovers only the profits made by the defendant in using in its business the Richardson invention, it is immaterial whether or not the plaintiff itself employed that invention. The profits made by the defendant cannot be increased or diminished by any act on the part of the plaintiff; and the amount of them is not affected by the question whether during the same time the plaintiff did or did not use the patented invention.

"In regard to the holding by the master and the court that all the profits of the defendant from the valves it

made and sold were to be attributed to the employment by it of the improvement covered by the patent of 1866, we hold that, in view of what was determined in the former opinion of this court, and on the whole case, the safety valves known to the art and open to be used by the defendant would not do the same work as the Richardson invention covered by the patent of 1866, or have any commercial value; and that, within the case of Garretson v. Clark,[715] it appears, by reliable and satisfactory evidence, that the profits made by the defendant are to be calculated in reference to the entire valve made and sold by it, for the reason that the entire value of the valve, as a marketable article, is properly and legally attributable to the patented feature of the patent of 1866."[716]

Where the patent was for an improved process of manufacturing car wheels, the Supreme Court said: "The question to be determined * * * is, what advantage did the defendant derive from using the complainant's invention over what he had in using the other processes then open to the public, and adequate to enable him to obtain an equally beneficial result. The fruits of the advantage are his profits."[717]

This phase of the subject has been admirably supplemented by Mr. Chief Justice Waite, as follows:

"It does not necessarily follow from this that where the patent is for one of the constituent parts and not for the whole of a machine, the profits are to be confined to what can be made by the manufacture and sale of the patented part separately. If, without the improvement, a machine adapted to the same use, can be made, which

715. 111 U. S. 120, 28 L. Ed. 371.

716. Mr. Justice Blatchford, in Crosby Steam Gage & Valve Co. v. Consolidated Safety Valve Co., 141 U. S. 441, 458, 35 L. Ed. 809, 814.

717. Mr. Justice Strong, in Mowry v. Whitney, 14 Wall. 620, 20 L. Ed. 860.

will be valuable in the market and saleable, then, as was further said in Mowry v. Whitney,[718] the inquiry is 'What was the advantage in cost, in skill required, in convenience of operation or marketability' gained by the use of the patented improvement? If the improvement is required to adapt the machine to a particlar use, and there is no other way open to the public of supplying the demand for that use, then it is clear the infringer has by his infringement secured the advantage of a market he would not otherwise have had, and that the fruits of this advantage are the entire profits he has made in that market. Such, we think, is this case. Pumps for all ordinary and many extraordinary uses, were very old, but in the new developments of business something was wanted to take the gas from the casing of an oil well and conduct it safely to the furnace of the engine. 'With that special purpose in view,' this inventor took the well known parts of an ordinary double-action pump, changed some of them slightly in form, added a new device, and produced something which would do what was wanted. While nominally he only made an improvement in pumps, he actually made an improved pump. For ordinary uses the improvement added nothing to the value of the old pump, but for the new and special purpose in view, the old pump was useless without the improvement. The testimony shows that there was no market for pumps adapted to this particular use, except in the oil producing regions of Pennsylvania and Canada. The demand was limited as well as local. Less than a thousand pumps actually supplied all who wanted them. But for that particular use no other pump could at the time be sold. If the appellant kept the control of its monopoly under the patent, it alone had the advantage of this market.

718. 81 U. S. (14 Wall.) 620, 651, 20 L. Ed. 860.

Unless the appellees got the improved pump, they could not become competitors in that field, and just to the extent they got into the field they drove the appellant out. Through their infringement they got the advantage of selling the pumps that had upon them the patented improvement. Without it no such sales would have been effected. The fruits of the advantage they gained by their infringement were, therefore, necessarily the profits they made on the entire sale.

"This is an exceptional case. A limited locality required a particular kind of pump, to be used only in that locality for a special purpose. The market was not only limited to a particular locality, but it was unusually limited in demand. A single manufacturer, possessing the facilities the appellant had, could easily and with reasonable promptness fill every order that was made. There was no other pump that could successfully compete with that controlled by the patent. Under these circumstances, it is easy to see that what has been the appellees' gain in this business must necessarily have been the appellant's loss and, consequently, the appellant's damages are to be measured by the appellees' profits derived from their business in that special and limited market. This, as it seems to us, is the logical result of the rule which has been stated. By infringing on the appellant's rights, the appellees obtained the advantage of the increased marketability of their pumps. The action of the court below, therefore, limiting the field of inquiry as to damages, cannot be sustained."[719]

In another case the Supreme Court has said: "Where the patented invention is for a new article of manufacture, which is sold separately, the patentee is entitled to

719. Mr. Chief Justice Waite, in Goulds Mfg. Co. v. Cowing, 105 U. S. 253, 26 L. Ed. 987.

damages arising from the manufacture and sale of the entire article." And in the same opinion the court throws an important sidelight upon the subject by saying: "It is further claimed that the master ought to have reported nominal damages only, because there was evidence before him to the effect that the defendants, at the time they made and sold the complainant's grate, likewise made and sold another kind of a grate, called the Hathaway grate, and that the same price was received for both kinds. From this it is said to follow that there was no advantage derived by the defendants from the manufacture and sale of the complainant's grate, above that which they would have received had they made and sold the Hathaway grate only. We do not think that the consequence suggested necessarily follows as matter of fact, nor that it has any relevancy as matter of law."[720]

In another case before the Supreme Court the claims were:

"1. A concrete pavement laid in detached blocks or sections, substantially in the manner shown and described.

"2. The arrangement of tar-paper or its equivalent between adjoining blocks of concrete, substantially as and for the purpose set forth."

The position of the patent in its art is thus described: "The invention of Schillinger was a very valuable one. The evidence is that it entirely superseded the prior practice of laying concrete pavements in a continuous, adhering mass."

The Supreme Court sustained the award of the entire profits, saying:

720. Mr. Justice Shiras, in Warren v. Keep, 155 U. S. 265, 268, 39 L. Ed. 144, 145.

"As to the amount of the decree, we think the court properly awarded the sum of four cents per square foot as the profits of the defendant, and that it was right to give to the plaintiff the entire profits made by the defendant by the laying by him of his concrete flagging, in view of the testimony in the case. It clearly appears that the defendant's concrete flagging derived its entire value from the use of the plaintiff's invention, and that if it had not been laid in that way it would not have been laid at all."[721]

This rule as to profits has been recognized upon facts coming within the scope of the leading cases from which we have quoted, in many cases on circuit and in the Circuit Court of Appeals, some of which are collected in the footnote.[722]

A noteworthy feature of the rules which we have been considering is, that it is apparent that there are gradations which the courts cannot deal with properly by forcing patents into either one or the other of the classes which we have indicated as A. B and C. And it is curious that this whole subject of the measure of profits appears to be hopelessly mixed up with the question of the burden of proof.

It is manifest that the extent to which the infringing structure owes its saleability to the infringement ought to be the basis of the complainant's recovery.

It is manifest that in any event short of an absolute copy of the patented device, with nothing added, it is impossible for any court to exactly determine to what de-

721. Mr. Justice Blatchford, in Hurlbut v. Schillinger, 130 U. S. 456, 32 L. Ed. 1011.

722. Zane v. Peck, 13 Fed. Rep. 475; Fifield v. Whittemore, 33 Fed. Rep. 835; Creamer v. Bowers, 35 Fed. Rep. 206; Brennan & Co. v. Dowagiac Mfg. Co., 162 Fed. Rep. 472, 475, 89 C. C. A. 392, 395; Dowagiac Mfg. Co. v. Superior Drill Co., 162 Fed. Rep. 479, 481, 89 C. C. A. 399; Orr & Lockett Hdw. Co. v. Murray, 163 Fed. Rep. 54, 56, 89 C. C. A. 492.

gree the salability of the structure depends upon the infringement. It is like the error which we have noted, of forcing all patents into one of two classes, pioneer or secondary. It is a convenient way of disposing of troublesome questions of fact, but expediency is one thing, and the equitable award of profits is quite another.

It is worth noting, also, in this connection, that on the question of the salability of the infringing device the physical structure of the device apparently is the only thing that has been considered.

In the earlier stages of the same litigation the question of extensive sales as proof of the presence of invention is frequently met with evidence that the sales were due to extensive advertising, rather than to the merits of the invention.

Why is it not equally competent to make such proof upon the accounting, to demonstrate that the profits were due, to a greater or less extent, to advertising? In the case of small articles, such as hand-tools and toys, the finish, color, or method of packing may have quite as much to do with inducing extensive sales as a minor part of the structure, which infringes the patent in suit. The writer believes that all of these facts, and any others which actually bear upon the salability of the defendant's structure, should equitably be considered in fixing that portion of his profits for which the defendant should account where the salability of the structure is not entirely due to the infringement.

§ 423. The complainant's burden of proof as to profits.

What the infringer makes is "profits;" what the owner of the patent loses by the infringement is "damages."[723] The burden rests upon the complainant to

723. Diamond Stone Sawing Mach. Co. v. Brown, 166 Fed. Rep. 306, 92 C. C. A. 224.

establish, in every suit for patent infringement the validity of his patent (save where the respondent is estopped to deny it), and its infringement by the respondent; the right to an accounting is incidental to the right of injunction,[724] unless it appears from the record that the respondent has realized no profits, or that the complainant has failed either to mark or give notice under § 4900, R. S. U. S.[725]

When the accounting is entered upon, therefore, there is against the respondent the finding that he has infringed, and, as the accounting party, he may properly be directed by the master to bring in his account in the form of debtor and creditor, under Equity Rule 79.

Where the infringing structure merely embodies the infringement, the recovery of the entire profits is merely a matter of debit and credit, under rules set out elsewhere in this book, all of which rest upon comparatively well-settled doctrine. But where the structure containing the infringement also embodies other matter, patented or unpatented, which is a factor in the profits realized by its use or sale, the burden of proof, as the decisions now stand, is upon the complainant to segregate the part of the profits arising from the infringement from the general profits accrued from the infringement.[726] This principle, Judge Severens has said, "is well settled; but, before it can be applied, it is incumbent on the defendant to prove that the peculiar characteristic features or some substantial part of such peculiarities of the former patents (or other matter foreign to the infringed claim) were embodied in the patented articles sold, and that

724. Stevens v. Gladding, 58 U. S. 447, 15 L. Ed. 155.

725. Standard Elevator Co. v. Crane Elevator Co., 76 Fed. Rep. 767, 22 C. C. A. 549.

726. Garretson v. Clark, 111 U. S. 120, 28 L. Ed. 371; Canda Bros. v. Michigan Malleable Iron Co., 152 Fed. Rep. 178, 81 C. C. A. 420.

they were of such a character that they probably contributed to the profits.[727] On this being shown, the burden of proof is devolved on the party seeking to recover the profits to prove what part of the entire profits are due to the use of his own invention. He must make the separation of values and show to the court how much is his rightful proportion.[728] Here is the rock on which many patent causes have been stranded at the end of their course, for, though it can sometimes be done, it is generally next to impossible to distinguish the profit due to one rather than another of the characteristics of the article sold, or manufactured to be sold. The price is single, and it would rarely happen that either the buyer or the seller would contemplate the price as made up of components grounded on such a distinction. The facts are similar to those which in other cases would condemn the guilty party to suffer the consequences of his mingling indistinguishably the property of an innocent party with his own or that of another. Counsel for defendant has argued this question upon the theory that the rule laid down in the case of Elizabeth v. Pavement Co. was an exception merely to that stated in Garretson v. Clark, and seems to suppose that, in every case where some element or elements of a combination found in a former patent is found also in the infringing article, the burden is cast upon the plaintiff to prove either that it did not affect the selling price of the article, or, if it did, to show what part of the price was due to his own invention. But such a rule would be inconsistent with the decision in Elizabeth v. Pavement Co. We think the two cases above mentioned are not inconsistent, and that they are easily reconciled upon the assumption that the rule

727. Elizabeth v. Nicholson Pavement Co., 97 U. S. 126, 24 L. Ed. 1000.

728. Garretson v. Clark, 111 U. S. 120, 28 L. Ed. 371.

of the first case is applicable to the question of the burden of proof of showing the presence of the extraneous element and the probability that it has affected the price, and that the rule in the second case relates to the burden of proof after those facts are established. Thus, in the later case of Keystone Mfg. Co. v. Adams,[729] in summing up the conclusions reached thereon, one was stated to be 'that where the infringed device was a portion only of defendant's machine, which embraced inventions covered by patents other than that for the infringement of which the suit was brought, in the absence of proof to show how much of that profit was due to such other patents, and how much was a manufacturer's profit, the complainant is entitled to nominal damages only,' from which it seems that the conditions stated must have been made to appear before the rule stated could be applied.

"Where the extraneous matter is another invention which is the subject of a monopoly in some other person, the reasons for the rule requiring a distinguishing of profits becomes clearer because of the necessity of preventing a double liability on the part of the defendant; but the reasons for its application to any other case are vague, and the practice difficult. In the present cause the court below held that it was not proven that the inventions of the Cushing and Thornburgh patents, or either of them, were embodied in the casings on which the profits were calculated, or contributed thereto, and in this we entirely agree. An examination of the testimony in the record shows that some of the forms or parts of the combinations of those patents are to be found in the Canda patent, but nothing which represents any patented device of Cushing or of Thornburgh. Nor do we find any substantial thing deserving of being reckoned as a

729. 151 U. S. 145, 148, 38 L. Ed. 103.

factor to which a portion of the price was due. It was settled as between these parties by the former decree that there was nothing in the prior art which anticipated the invention of the patent in suit, and that conclusion cannot now be disputed. The unpatented elements of the Cushing and Thornburgh patents (and they were all singly unpatented) were common property. Any other inventor might take them, if he did not take an entire combination, and use them as parts of his own structure, and, if they were a fit embodiment of his own ideas, they, in his combination, represented parts of his invention, and the invention pervaded the whole structure. We therefore conclude that there was no error in disallowing this exception."[730]

The foregoing application of the doctrine to concrete facts, as well as the incidental elucidation of the general doctrine, are well worthy of careful consideration.

This doctrine is generally known as the rule of Garretson v. Clark,[731] and its application in the several circuits has made the recovery of more than nominal amounts a rare occurrence in patent cases. From the notable cases in which it is presented we extract the following.

Judge Townsend, in a case involving a numbering stamp, has said:

"These facts indicate that the device covered by the claim of the patent in suit were mere improvements, and, as stated by complainant's own officers, were in the line of simplicity of construction and consequent saving in cost of manufacture. There is no satisfactory evidence that the machine was more saleable by reason of these improvements; the testimony of defendants, re-

730. Canda Bros. v. Michigan Malleable Iron Co., 152 Fed. Rep. 178, 181, 81 C. C. A. 420.

731. 111 U. S. 120, 28 L. Ed. 371.

ferred to above, tends to show that their sales were unaffected by the presence or absence of said devices. There is no evidence that the improvements introduced any new function or result, nor any satisfactory proof that the machines were by reason thereof more convenient or practical for the user, or more commercially successful. In short, there is no evidence that the patented improvements were a dominant feature of the machine, or contributed to its sale, or created a new article, or obviated prior objections in practical operation, or which shows that the sales may not have depended upon advertising, changed discounts, and other mere business methods. Furthermore, there is evidence that other machines, not containing these patented improvements, were on the market, and were salable. In these circumstances, the defendant is only liable for profits realized from the use of that part of the patented invention which is new, and which he has wrongfully appropriated, and the complainant must furnish evidence from which the profits may be thus apportioned, or he cannot recover."[732]

One of the ablest commentaries upon the rule of Garretson v. Clark is that of Judge Severens, from which we quote:

"Counsel relies upon the case of Garretson v. Clark (111 U. S. 120, 28 L. Ed. 371), to support the conclusion which he states as follows:

> "'The action of the court in rendering judgment against defendant for any amount whatever, in the total absence of any evidence even tending to show that the defendant has made any profits growing out

732. Force v. Sawyer-Boss Mfg. Co., 143 Fed. Rep. 894, 897, 75 C. C. A. 102; citing, Ingels v. Mast, 6 Fish. Pat. Cas. 415, Fed. Case 7033; McCreary v. Pennsylvania Canal Co., 141 U. S. 459, 35 L. Ed. 817; Brickill v. Mayor of New York, 112 Fed. Rep. 65, 50 C. C. A. 1.

of his use of the patented invention, as distinguished from that part of the device which belonged to the public, was clearly erroneous and should be reversed.'

"The unanimity with which infringers seek the shelter of that case is something remarkable. But it is a misconception to suppose that it has any application to a case like this, as must be seen upon a due consideration of it. It was a case founded on patents for improvements 'in the method of moving and securing in place the movable jaw or clamp of a mop-head,' as Mr. Justice Field puts it. To be more precise, it was for the provision of a nut to be connected with the collar of the movable clamp and adapted to move up or down on the threaded shank of the handle. And, as the learned justice says, 'with the exception of this mode of clamping, mop-heads like the plaintiff's had been in use time out of mind.' Then he proceeds to state the rule so often cited:

> "'When a patent is for an improvement, and not for an entirely new machine or contrivance, the patentee must show in what particulars his improvement has added to the usefulness of the machine or contrivance. He must separate its results distinctly from those of the other parts, so that the benefits derived from it may be distinctly seen and appreciated. The rule on this head is aptly stated by Mr. Justice Blatchford in the court below: "The patentee," he says, "must in every case give evidence tending to separate or apportion the defendant's profits and the patentee's damages between the patented feature and the unpatented features, and such evidence must be reliable and tangible, and not conjectural or speculative; or he must show, by equally reliable and satisfactory evidence, that the profits

and damages are to be calculated on the whole machine, for the reason that the entire value of the whole machine, as a marketable article, is properly and legally attributable to the patented feature.'' '

"Thus it is seen that what he is speaking of is a patent for an improvement, and not of an entirely new machine or contrivance, and its application to the latter is further excluded when he speaks of the apportionment 'between the patented feature and the unpatented features.' Now when we remember that there are two classes of patents, one for simple elements, and another for combinations of elements, and the distinguishing characteristics of the two classes, it is readily seen how impossible it is to apply this language to the other class of patents than those of the class specified. In a combination patent there are no unpatented features in the sense that they are separable from patented ones, and no one of the elements is patented. They may all be old and not patentable at all unless there is some new combination of them. The point to be emphasized is that the law looks not at the elements or factors of an invented combination as a subject for a patent, but only to the combination itself as a unit distinct from its parts, and in such case there could be no comparison of patented and unpatented parts.

"On the other hand, an improvement presupposes something already existing and which would remain if the improvement were to be taken off. In such a case there would be little difficulty in finding the value of the former structure, if it had any, and comparing it with the improvement added; and of course the difference would be the value of the improvement. Such a case was Garreston v. Clark. Another good illustration is the case of the harvester improved by the driver's seat, in Seymour v. McCormick (16 How. 480, 14 L. Ed. 1024), to

which we referred in a former discussion of this subject. By parity of reasoning, if the combination were in itself but part of the structure in which it is located, the question would be upon a comparison of the value of the other parts without the patented combination and the value of all the parts assembled in a structure. This distinction was referred to by us in the case of Brennan & Co. v. Dowagiac Mfg. Co. (162 Fed. Rep. 475, 89 C. C. A. 392). But it was not new. It was distinctly implied, if not expressed in Garretson v. Clark. It has been made the basis of decision by Judge Wheeler in Ruggles v. Eddy (2 Ban. & A. 627, Fed. Case 12116); by Judge Shipman in Zane v. Peck (13 Fed. Rep. 475), distinguishing Garretson v. Clark; by Judge Colt in Fifield v. Whittemore (33 Fed. Rep. 835), and by Judge Wales in Creamer v. Bowers (35 Fed. Rep. 206). It seems to us that this distinction would, if attended to, go far toward relieving the embarrassment which has sometimes been encountered from the assumption that the rule laid down in Garretson v. Clark applies to the infringement of patents of all descriptions.'"[733]

§ 424. The liability of the user for profits.

The liability of one who infringes by use alone, is settled by the Supreme Court as follows:

"On the second hearing before the master, it was shown and he so found and reported, that there were methods and furnaces, other than those of the plaintiff's and other than those burning dry fuel alone, which would produce the same results in generating heat, for the purposes for which the defendants used the heat, and which methods and furnaces they had a right to use, and that

733. Yesbera v. Hardesty Mfg. Co., 166 Fed. Rep. 120-124, 92 C. C. A. 46.

the saving to them of profits made by them, by use of the plaintiff's inventions, over the other furnaces, was not proved. Such being the case, the report could not have been otherwise than as it was.

"It does not always follow that because a party may have made an improvement in a machine and obtained a patent for it, another using the improvement and infringing upon the patentee's rights will be mulcted in more than nominal damages for the infringement. If other methods in common use produce the same results, with equal facility and cost, the use of the patented invention cannot add to the gains of the infringer, or impair the just rewards of the inventor. The inventor may indeed prohibit the use, or exact a license fee for it, and if such license fee has been generally paid, its amount may be taken as the criterion of damage to him when his rights are infringed. In the absence of such criterion, the damages must necessarily be nominal."[734]

The curious suggestion of the foregoing quotation is that there may be a valid patent for a new machine which produces the same results, with the same facility and at the same cost as the machines of the prior art. But from another view point it would seem that these expressions were employed to show that unless the complainant shows a saving, in time, money or otherwise by the use of his invention, or that it accomplishes a new result, it cannot be presumed that the defendant user has profited by the use of the invention; if no such saving or advantage in the use of the patent exists, it can hardly possess the essential requirements of a valid patent, and it is, indeed, difficult to see why an accounting should be ordered, as against one who infringes by use alone.

734. Mr Justice Field, in Black v. Thorne, 111 U. S. 122, 28 L. Ed. 372.

§ 425. Defendant's credits upon the accourting.

The extent of the defendant's sales, and the gross amount received therefrom, are matters of simple calculation where the books of account are available. The credits which the defendant may claim as lessening his profit are the subject of numerous reported cases.

a. As to the allowance of interest on the capital invested, if the plant is wholly devoted to the manufacture of the infringing article, probably the allowance should be made;[735] but where other articles are manufactured in the same plant, no allowance can be made unless the evidence shows clearly what the proper apportionment of interest between the various kinds of business should be.[736]

b. The cost of material is allowable.[737]

c. Salaries of managing officers will be allowed, except where they are excessive, and really a division of profits under the guise of salaries, when only so much will be allowed as appears reasonable.[738]

d. Salaries and wages of salesmen and workmen are allowable,[739] but these must be reasonable, and connected directly with the infringing work, and where defendant's daily production was only one-half the capacity of his machine, his allowance was made on the basis of one-half the pay given the operatives of the machine.[740]

e. Taxes are not allowable.[741]

735. Goulds Mfg. Co. v. Cowing, 105 U. S. 257, 26 L. Ed. 988.

736. Seabury & Johnson v. Am Ende, 152 U. S. 561, 38 L. Ed. 553.

737. National Folding Box & Paper Co. v. Dayton Paper Novelty Co., 95 Fed. Rep. 991, 992.

738. Callaghan v. Myers, 128 U. S. 663, 664, 32 L. Ed. 547; Winchester Repeating Arms Co. v. American Buckle & Cartridge Co., 62 Fed. Rep. 279, 280.

739. National Folding Box & Paper Co. v. Dayton Paper Novelty Co., 95 Fed. Rep. 991, 993.

740. Kinner v. Shepard, 117 Fed. Rep. 48.

741. Winchester Repeating Arms Co. v. American Buckle & Cartridge Co., 62 Fed. Rep. 278, 281.

f. Premiums for fire [742] and employer's liability [743] insurance are not allowable.

g. No allowance will be made for the use of real estate owned by the infringer.[744]

h. Attorney's fees are not allowable.[745]

i. No allowance will be made for a physician's charge for attending an injured employee.[746]

j. Sums paid a reporting agency for credit information will be allowed.[747]

k. Advertising expenditures will be allowed.[748]

l. Commissions paid on sales are allowable.[749]

m. Rental paid for office and factory premises is allowable.[750]

n. Court costs, record printing and the like, expended in other litigation, are not allowable.[751]

§ 426. Increasing damages by the court.

Under § 4921, R. S. U. S., damages may be increased by the court, in equity as well as at law.[752]

742. Winchester Repeating Arms Co. v. American Buckle & Cartridge Co., 62 Fed. Rep. 278, 281.

743. National Folding Box & Paper Co. v. Dayton Paper Novelty Co., 95 Fed. Rep. 991, 992.

744. Winchester Repeating Arms Co. v. American Buckle & Cartridge Co., 62 Fed. Rep. 278, 281.

745. Winchester Repeating Arms Co. v. American Buckle & Cartridge Co., 62 Fed. Rep. 278, 281; Piaget Novelty Co. v. Headley, 123 Fed. Rep. 896.

746. Winchester Repeating Arms Co. v. American Buckle & Cartridge Co., 62 Fed. Rep. 278, 281.

747. Winchester Repeating Arms Co. v. American Buckle & Cartridge Co., 62 Fed. Rep. 278, 281.

748. Goulds Mfg. Co. v. Cowing, 105 U. S. 257, 26 L. Ed. 988.

749. Kissinger-Ison Co. v. Bradford Belting Co., 123 Fed. Rep. 91, 94, 59 C. C. A. 221.

750. Piaget Novelty Co. v. Headley, 123 Fed. Rep. 897, 898.

751. Piaget Novelty Co. v. Headley, 123 Fed. Rep. 897, 898.

752. Carew v. Boston Elastic Fabric Co., 5 Fisher 90, Fed. Case No. 2397.

They may be increased wherever the infringement was flagrant,[753] or because it was continued after the institution of the suit,[754] where the defendant has destroyed its books of account relating to the infringement,[755] or gave an indemnity bond and cut his price to get the business of a licensee of the plaintiff.[756]

Where the damages are increased by the court, its action will not be reviewed upon appeal unless it amounts to an abuse of discretion.[757]

§ 427. Interest.

Interest may be allowed on damages from the date of the interlocutory decree.[758]

"By a uniform current of decisions of this court, beginning thirty years ago, the profits allowed in equity, for the injury that a patentee has sustained by the infringement of his patent, have been considered as a measure of unliquidated damages which, as a general rule, and in the absence of special circumstances, do not bear interest until after their amount has been judicially ascertained; and the provision introduced in the Patent Act of 1870, regulating the subject of profits and damages, made no mention of interest, and has not been understood to affect the rule as previously announced."[759]

753. Lyon v. Donaldson, 34 Fed. Rep. 789.

754. Fox v. Knickerbocker Engraving Co., 165 Fed. Rep. 442, 91 C. C. A. 386.

755. Fox v. Knickerbocker Engraving Co., 165 Fed. Rep. 442, 91 C. C. A. 386.

756. Fox v. Knickerbocker Engraving Co., 165 Fed. Rep. 442, 91 C. C. C. A. 386.

757. Topliff v. Topliff, 145 U. S. 156, 12 Sup. Ct. 825, 36 L. Ed. 658; Day v. Woodworth, 13 How. 363, 372, 14 L. Ed. 181; Weston v. Empire Co., 155 Fed. Rep. 301; Folding Box Co. v. Elsas, 81 Fed. Rep. 197, affirmed, 86 Fed. Rep. 917, 30 C. C. A. 487; Lyon v. Donaldson, 34 Fed. Rep. 789, 793; Fox v. Knickerbocker Engraving Co., 165 Fed. Rep. 442, 91 C. C. A. 386.

758. Graham v. Geneva Lake Crawford Mfg. Co., 24 Fed. Rep. 642.

759. Mr. Justice Gray, in Tilghman v. Proctor, 125 U. S. 136, 31 L. Ed. 664; citing, Silsby v. Foote,

§ 428. Costs, in actions at law.

At common law costs were not awarded, as costs, to either party, until the Statute of Gloucester (6 Edw. I, c. 1) was enacted, giving costs in cases where the plaintiff recovered damages;[760] "in various actions this statute gave to a successful plaintiff damages which were to cover 'the costs of his writ purchased.'"[761] But in Federal practice, at least, costs follow the result as a matter of right,[762] except that they may be refused because of delay in filing a disclaimer.[763]

§ 429. In equity.

Costs generally, in proceedings in equity, are subject to the discretion of the court.[764] In the institution of suits in equity in the Federal courts, there is no uniformity of rule as to the requirement for a cost deposit, or bond for security for costs. In certain districts a cost bond is required when the bill is filed, and in all districts some deposit of money is required at that time,

61 U. S., (20 How.) 378, 387, 15 L. Ed. 953, 956; Mowry v. Whitney, 81 U. S. (14 Wall.) 620, 621, 20 L. Ed. 860, 866; Littlefield v. Perry, 88 U. S. (21 Wall.) 205, 229, 22 L. Ed. 577, 581; Parks v. Booth, 102 U. S. 96,106, 26 L. Ed. 54, 58; Root v. Lake Shore & M. S. R. Co., 105 U. S. 189, 198, 200, 204, 26 L. Ed. 975, 978-980; Illinois Cent. R. R. v. Turrill, 110 U. S. 301, 303, 28 L. Ed. 154, 155. To the same effect, see, National Folding Box Co. v. Dayton Paper Novelty Co., 97 Fed. Rep. 331; Campbell v. New York, 105 Fed. Rep. 631; Yale Lock Mfg. Co. v. Sargent, 117 U. S. 536, 29 L. Ed. 954; Crosby Steam Gage & V. Co. v. Consolidated Safety Valve Co., 141 U. S. 441, 35 L. Ed. 809.

760. Day v. Woodworth, 54 U. S. (13 How.) 363, 372, 14 L. Ed. 181, 185.

761. Pollock & Maitland, History of English Law, Vol. II, p. 597.

762. Coburn v. Schroeder, 8 Fed. Rep. 519, 522.

763. Dunbar v Meyers, 94 U. S. 187, 24 L. Ed. 34; Sessions v. Romadka, 145 U. S. 799, 36 L. Ed. 609.

764. Wiegand v. Copeland, 14 Fed. Rep. 118, 122.

ranging from ten to fifty dollars. Additional deposits, or a bond, are usually required as the cause progresses.[765]

In the taking of testimony in equity causes, each party primarily pays the costs incurred by it.

Upon the interlocutory decree being entered, if adverse to the complainant, the costs are assessed against him. If an interlocutory decree is entered without an order for accounting, the decree will embrace costs, usually against the respondent. If the order of reference for accounting is made, the court may award the accrued costs, or the interlocutory decree may be silent as to costs, and their award be left until the entry of the final decree upon the report of the master.[766]

Generally, the successful complainant will be awarded costs, as they are the result of the defendant's wrongful acts;[767] but where the defendant has been successful as to one or more of several claims or patents charged to be infringed, it is the usual practice to apportion the costs, in proportion to the relative success of the parties.[768] But in one case where the complainant prevailed as to two of the patents in suit, but failed to prove infringement as to the third, he was awarded all the costs,[769] and the Sixth Circuit Court of Appeals has said, "in equity causes this court directs the imposition of costs according to the circumstances, and apportions them or denies cost altogether by no iron-clad rule. In-

765. Deprez v. Thomson-Houston Elec. Co., 66 Fed. Rep. 22.

766. Avery v. Wilson, 20 Fed Rep. 856.

767. Urner v. Kayton, 17 Fed. Rep. 845.

768. Stewart v. Mahoney, 5 Fed. Rep. 302; Albany Steam Trap Co. v. Felthousen, 20 Fed. Rep. 633; Hayes v. Bickelhoupt, 21 Fed. Rep. 567; Marks Adjustable Folding Chair Co. v. Wilson, 43 Fed. Rep. 302; Green v. Lynn, 81 Fed. Rep. 387; Ide v. Trorlicht, Duncker & Renard Carpet Co., 115 Fed. Rep. 137, 53 C. C. A. 341; St. Louis Street Flushing Mach. Co. v. Sanitary Street Flushing Mach. Co., 161 Fed. Rep. 725, 88 C. C. A. 585; Metallic Extraction Co. v. Brown, 110 Fed. Rep. 665, 49 C. C. A. 147.

769. Green v. Lynn, 81 Fed Rep. 387.

deed, such a rule could not be well prepared, and would more often than otherwise lead to injustice."[770]

Incidental costs may be specially taxed during the progress of the cause which will not be subject to reclamation in the final decree; such as costs imposed on a defendant as a penalty for filing an insufficient demurrer,[771] the notarial fees paid by a defendant for affidavits used in successfully resisting an application for preliminary injunction,[772] or the costs of an incidental contempt proceeding.[773]

When, before any proofs are taken, the defendant offers to submit to a decree as prayed in the bill of complaint, if the complainant proceeds with the proofs the entire costs of the proofs will be assessed against complainant.[774]

§ 430. Costs on accounting.

The usual course followed as to the costs pending the reference to the master on accounting is to require each party to pay one-half the current allowances to the master, or to pay his own costs as the accounting progresses, subject to the entry of the award of costs on final decree,[775] though in some instances the complainant has been required to pay the master's compensation in the first instance,[776] and in others the defendant has been required to advance all the costs of the accounting.[777]

770. Lurton, J., in Johnson v. Foos Mfg. Co., 141 Fed. Rep. 73, 90, 72 C. C. A. 105; citing, Northern Trust Co. v. Snyder, 77 Fed. Rep. 818, 23 C. C. A. 480.

771. New York Belting & Packing Co. v. New Jersey Car Spring & Rubber Co., 32 Fed. Rep. 755.

772. Atwood v. Jacques, 63 Fed. Rep. 561.

773. Spill v. Celluloid Mfg. Co., 28 Fed. Rep. 870.

774. Brunswick-Balke-Collender Co. v. Klump, 131 Fed. Rep. 92.

775. United States Printing Co. v. American Playing Card Co., 81 Fed. Rep. 506.

776. Macdonald v. Shepard, 10 Fed. Rep. 919.

777. Urner v. Kayton, 17 Fed. Rep. 539.

§ 431. What taxable as costs.

Neither party is entitled to an allowance for any expenses beyond the taxable costs enumerated in the statutes.[778] The cost of brief printing is not taxable,[779] nor are premiums paid a surety company for appeal or supersedeas bonds in the cause,[780] and in the absence of a rule of the Circuit Court on the subject, the expense of printing pleadings and evidence for use in that court has been refused taxation, even though stipulated for by counsel, as not being embraced in the costs made taxable by § 823, R. S. U. S.[781] It may be observed, however, that in many districts the rules of the Circuit Court require the printing of the testimony in patent causes for use on the hearing in that court; where such rules obtain, the cost of such printing is, of course, taxable.[782]

The recent act of February 13, 1911, (see Appendix) has for the first time established the uniform rule that the record must be printed in the lower court.

Traveling expenses of counsel incurred in taking testimony are not taxable as costs.[783]

The docket fee of $20 provided to be taxed in favor of the successful party by § 824, R. S. U. S., has been the subject of many controversies. It has been held that when a demurrer to a bill in equity is sustained, the docket fee is taxable in favor of the defendant,[784] but it cannot be taxed when the demurrer is overruled with

778. Parks v. Booth, 102 U. S. 96. 26 L. Ed. 54.

779. Kursheedt Mfg. Co. v. Naday, 108 Fed. Rep. 918, 48 C. C. A. 140; Lee Injector Mfg. Co. v. Penberthy Injector Co., 109 Fed. Rep. 964, 48 C. C. A. 760.

780. Lee Injector Mfg. Co. v. Penberthy Injector Co., 117 Fed. Rep. 192, 48 C. C. A. 760; Edison v. American Mutoscope Co., 117 Fed. Rep. 192.

781. Lee v. Simpson, 42 Fed. Rep. 434.

782. Hake v. Brown, 44 Fed. Rep. 734.

783. Hamilton v. The William Branfoot, 48 Fed. Rep. 914; affirmed, The William Branfoot v. Hamilton, 52 Fed. Rep. 390, 3 C. C. A. 155.

784. Price v. Coleman, 22 Fed. Rep. 694; Greener v. Steinway, 48 Fed. Rep. 708.

leave to the defendant to answer.[785] It is not allowable when the suit is voluntarily dismissed by the complainant before any hearing, interlocutory or final,[786] though one court, reasoning by the analogy of law actions, allowed a docket fee of $5.[787]

The prevailing view would seem to be that the docket fee is taxable but once, and then upon that hearing of the law or facts that results in a final decree;[788] though an additional docket fee has been allowed the party prevailing in a successful motion for rehearing,[789] and where the cause has been heard and reheard upon the merits two docket fees have been allowed the party prevailing on both hearings.[790]

The docket fee is not taxable in favor of a defendant when the complainant dismisses as to one of several patents charged in the bill to be infringed.[791]

The cost of carbon copies of testimony for the use of a party or his counsel is not taxable,[792] unless the rules of the court require the record to be printed, and the copies are secured for that purpose.[793]

Section 983, R. S. U. S., provides for the taxation as costs of "lawful fees for exemplifications and copies and papers necessarily obtained for use on trials." This section extends to copies of models in the Patent Office.[794]

785. McLean v. Clark, 23 Fed. Rep. 861.

786. Consolidated Bunging Apparatus Co. v. American Process Fermentation Co., 24 Fed. Rep. 658.

787. Kaempfer v. Taylor, 78 Fed. Rep. 795.

788. Cleaver v. Traders' Ins. Co., 40 Fed. Rep. 863.

789. Peck, Stow & Wilcox Co. v. Fray, 92 Fed. Rep. 947.

790. American Diamond Rock Boring Co. v. Sheldon, 28 Fed. Rep. 217.

791. Luxfer Prism Patents Co. v. Elkins, 99 Fed. Rep. 29.

792. Atwood v. Jacques, 63 Fed. Rep. 561; Roundtree v. Rembert, 71 Fed. Rep. 255.

793. Brewster v. Shuler, 38 Fed. Rep. 549.

794. Wooster v. Handy, 23 Fed. Rep. 49.

§ 432. How affected by disclaimer.

Section 4922, R. S. U. S., relating to disclaimers, provides in part as follows: "But in every such case in which a judgment or decree shall be rendered for the plaintiff no costs shall be recovered unless the proper disclaimer has been entered at the Patent Office before the commencement of the suit."

This section does not permit a defendant to attack the validity of claims of the patent in suit which he is not charged to have infringed, for the mere purpose of settling the costs.[795] Where the answer averred in general terms that a disclaimer was necessary, the patent in suit having several claims, and the complainant, on taking testimony, having limited the issues to one claim, as to which it succeeded on final hearing, the court declined to withhold an award of costs to the complainant, on the defendant's suggestion that the other claims required a disclaimer.[796] The section very clearly limits the effect of delaying the filing of disclaimers, to the recovery of costs.[797]

§ 433. Costs must be included in decree.

Costs "are to be awarded as a part of the decree or they cannot be recovered, although they may be, and generally are, taxed after the decree."[798] This is usually accomplished by a recital in the decree to the effect that it is decreed that the party shall have and recover from his opponent "his costs herein, to be taxed by the clerk under the direction of the court."

795. American Bell Telephone Co. v. Spencer, 8 Fed. Rep. 509.

796. Gamewell Fire-Alarm Telegraph Co. v. Municipal Signal Co., 77 Fed. Rep. 490, 492, 23 C. C. A. 250.

797. Sessions v. Romadka, 145 U. S. 29, 36 L. Ed. 609.

798. Wheeler, J., in Coburn v. Schroeder, 8 Fed. Rep. 521, 522; citing and following Sizer v. Many, 57 U. S. (16 How.) 98, 14 L. Ed. 861.

§ 434. Appellate review of orders as to costs.

No appeal lies from a mere decree respecting costs and expenses.[799] This rule applies wherever no substantial question save that of costs is presented by an appeal.[800]

On appeal from a final decree, however, the appellate court has entire control of the question of costs as well as the merits.[801] But, upon appellate review, where there is an affirmance on the merits, an apportionment of the costs by the court below will not be disturbed unless there has been an abuse of its discretion.[802]

The general doctrine as to appellate review does not apply to costs awarded as between solicitor and client, nor to allowances made out of a trust fund, such questions being reviewable upon appeal, without regard to the merits.[803] While this exception to the rule has not arisen in cases involving patents, it is obvious that it might arise.

An appellate court will revise an erroneous interpretation of its own decree apportioning costs.[804]

§ 435. Expert and opinion evidence in patent causes—The Patent Office Examiner as an expert.

At least theoretically, the examining corps of the Patent Office is a staff of experts, dealing with those questions of the arts and sciences to which their respective official duties relate. Their opinions, as embodied in the file of the proceedings resulting in the patent, are always

799. Canter v. American Ins. Co., 3 Peters 307, 7 L. Ed. 427.

800. Glendale Elastic Fabric Co. v. Smith, 100 U. S. 110, 25 L. Ed. 547; Stuart v. Boulmare, 133 U. S. 78, 33 L. Ed. 568.

801. Trustees of Florida Int. Imp. Fund v. Greenough, 105 U. S. 527, 26 L. Ed. 1157.

802. Burns v. Rosenstein, 135 U. S. 449, 34 L. Ed. 193.

803. Trustees of Florida Int. Imp. Fund Co. v. Greenough, 105 U. S. 527, 26 L. Ed. 1157.

804. Kell v. Trenchard, 146 Fed. Rep. 245, 76 C. C. A. 611.

admissible, and are at times of considerable weight, in litigation arising under the patent, in which the validity or scope of its claims is to be determined. "That office employs the best experts in mechanics which it can secure in this and other countries. Its examinations are, indeed ex parte in form, but they are, nevertheless, conducted under hot and skilled contestation in every case of importance; and its decisions, though not conclusive, are entitled to great respect. * * * That ruling takes rank here as the testimony of experts of the highest experience, skill, and knowledge in mechanics."[805]

§ 436. The qualifications of an expert witness.

Robinson, concurring with Curtis (Curtis on Patents, §§ 479-481) says: "Patent experts are of two classes—scientific experts and mechanical experts. A scientific expert is a witness who has made himself familiar, by study or experiments, with the principles of any science, and has thereby become qualified to understand, distinguish, and explain the properties of the objects to which such science appertains. A mechanical expert is a witness who, by practical training in an art, has acquired a degree of skill in its rules and manipulations which enables him to comprehend and apply its various instruments and methods. The spheres of these two classes of experts are entirely distinct." (3 Robinson on Patents, § 1013.) While this distinction is interesting, it cannot be said to be supported by the cases. The writer is inclined to prefer the simple definition of the Supreme Court of Indiana: "from the Latin, *experti*, which signifies instructed by experience. Persons who are selected

805. Boyden Power-Brake Co. v. Westinghouse Air-Brake Co., 70 Fed. Rep. 816, 827, 17 C. C. A. 430; to the same effect, see Ideal Stopper Co. v. Crown Cork & Seal Co., 131 Fed. Rep. 244, 248, 65 C. C. A. 436.

by the courts or the parties in a cause, on account of their knowledge or skill, to examine, estimate and ascertain things, and make a report of their opinion."[806]

§ 437. How qualifications of expert may be proven.

It is customary to prove the qualifications of the expert witness by his own testimony, and McKelvey has stated that they must be established in that manner (McKelvey, Evidence, p. 182). But that his qualifications may be established by the testimony of other witnesses has been shown in Elliott on Evidence (§ 1034) on the authority of numerous cases.[807]

The qualification of the expert witness is a question for the trial court. "Whether a witness called to testify to any matter of opinion has such qualifications and knowledge as to make his testimony admissible is a preliminary question for the judge presiding at the trial; and his decision of it is conclusive, unless clearly shown to be erroneous in matter of law."[808] "It is difficult to lay down any exact rule in respect to the amount of knowledge a witness must possess; and the determination of this matter rests largely in the discretion of the trial judge."[809]

§ 438. The weight to be given expert testimony.

A general statement embodied by Judge Woodruff in a charge to a jury is commendable as indicating the respective values of the fact and the opinion evidence of

806. Nelson v. Johnson, 18 Ind. 329, 334.

807. State v. McMaynes, 61 Iowa 119, 15 N. W. Rep. 864; Mason v. Phelps, 48 Mich. 126; Wright v. Schnaier, 70 N. Y. S. 128; Laros v. Commonwealth, 84 Pa. St. 200.

808. Mr. Justice Gray, in Stillwell & Bierce Mfg. Co. v. Phelps, 130 U. S. 520, 32 L. Ed. 1035.

809. Mr. Justice Brewer, in Montana Railway Co. v. Warren, 137 U. S. 348, 34 L. Ed. 681.

the expert witness, as well as the importance attaching not only to his skill but his integrity. "The value of the opinions of experts differs largely in degree, in different cases. It is of first importance that the facts upon which they are founded be satisfactorily established. It is, next, of importance, that the integrity and skill of the witness be known. Where the expert states precise facts in science as ascertained and settled, or states the necessary and invariable conclusion which results from the facts stated, his opinion is entitled to great weight, Where he gives only the probable inference from the facts stated, his opinion is of less importance, because it states only a probability. Where the opinion is speculative, theoretical, and states only the belief of the witness, while yet some other opinion is consistent with the facts stated, it is entitled to but little weight."[810]

§ 439. What may be shown by expert testimony.

The field of the expert witness in patent litigation has been thus defined by Lord Justice Lindley: "It is necessary to examine the patent, and to ascertain first what the patented invention really is; and secondly, whether the defendants have used that invention. In this, as in all cases, the nature of the invention must be ascertained from the specification, the interpretation of which is for the judge and not for any expert. The judge may, and indeed generally must, be assisted by expert evidence to explain technical terms, to show the practical working of machinery described or drawn, and to point out what is old and what is new in the specification. Expert evidence is also admissible and is often required to show the particulars in which an alleged invention has been

810. Gay v. Union Mutual Ins. Co., 9 Blatchford 142, Fed. Case No. 5282.

used by an alleged infringer, and the real importance of whatever difference there may be between the plaintiff's invention and whatever is done by the defendant. But, after all, the nature of the invention for which a patent is granted must be ascertained from the specification, and has to be determined by the judge and not by the jury, nor by any expert or other witness. This is familiar law, although apparently often disregarded when witnesses are being examined."[811]

There are to be found in the reported cases, illustrations of many of the uses of expert testimony. The following is an attempt to enumerate the most usual and important subjects upon which expert testimony has been employed in patent litigation.

1. As to the meaning of terms and expressions used in the arts.[812]

2. To explain drawings, models and machines, their operation, purpose and effect, and the differences existing in the various devices involved in their construction.[813]

3. To state an opinion on the question of equivalency.[814]

4. To show the inoperativeness of an alleged anticipating patent, or of the patent in suit.[815] Of course expert testimony on this point is of inferior value to fact testimony that the device was actually worked.[816] "The alleged inoperative character of the invention in suit is also dwelt upon by the defendant. It is true that the

811. Brookes v. Steele & Currie, 1897, 14 P. O. R. 73.

812. Corning v. Burden, 15 Howard 252, 14 L. Ed. 683; Winans v. N. Y. & Erie Railroad, 21 Howard 88, 16 L. Ed. 68; Panzl v. Battle Island Paper Co., 138 Fed. Rep. 48, 70 C. C. A. 474.

813. Norton v. Jensen, 49 Fed. Rep. 859, 1 C. C. A. 452; Winans v. N. Y. & Erie Railroad, 21 Howard 88, 16 L. Ed. 68.

814. Foss v. Herbert, 2 Fisher 31, Fed. Case 4957.

815. Seymour v. Marsh, 6 Fisher 115, Fed. Case No. 12,687.

816. Tannage Patent Co. v. Zahn, 66 Fed. Rep. 986, 992.

drawings in the specification were diagrammatic, were not working drawings, and that, after the principle of the invention was shown, subsequent mechanics could develop it in a better form or more perfect details than were used by the inventor before the test of actual and practical use had been applied to it; but in this case, as in many others, it is vain for a subsequent inventor, after having taken the new principle of a prior invention and having worked improved details into his mode of operation, to decry the original invention as inoperative and crude. The original invention was workable, and, while it has been improved, it has been used abundantly."[817]

§ 440. Criticism of expert testimony.

The reported cases abound in criticism of expert witnesses, as a class. They have been characterized as "auxiliary counselors;"[818] and as being "necessarily partisans of the side calling them, and essentially advocates;"[819] but it is believed that these strictures are unwarranted. In the argument of technical cases before courts having, at the best, limited knowledge of the arts, the expert testimony in the record is seldom useless, almost invariably of considerable value, and often controlling as to the result. Indeed, the Supreme Court has said: "As it cannot be expected that the court will possess the requisite knowledge for this purpose (i. e., the interpretation of a technical specification), it becomes necessary that it should avail itself of the light furnished by the evidence to enable it to understand the terms used in the patent and the devices and operations described or

817. Shipman, J., in Thomson-Houston Electric Co. v. Lorain Steel Co., 103 Fed. Rep. 641, 644.

818. Steam Gauge & Lantern Co. v. Ham Mfg. Co., 28 Fed. Rep. 618.

819. Ideal Stopper Co. v. Crown Cork & Seal Co., 131 Fed. Rep. 244, 248, 65 C. C. A. 436.

alluded to therein."[820] In another case, the Circuit Court of Appeals for the Second Circuit criticized a defendant for failing to offer expert testimony as to alleged anticipating patents, saying: "In the absence of any expert testimony to explain these patents, or indicate what they contain tending to negative the novelty of the complainant's patent, we do not feel called upon to examine them."[821]

§ 441. Expert opinion testimony is not binding upon the court.

It follows from the very nature of expert testimony, that the court is at liberty to disregard it entirely.

"A judge may obtain information from them (expert witnesses), if he desire it, on matters which he does not clearly comprehend, but cannot be compelled to receive their opinions as matter of evidence."[822] And opinion testimony of an expert will almost invariably be disregarded when he gives no reason for his conclusions, unless they are clearly apparent to the court.[823]

§ 442. Of decrees in equity, generally.

The judgments of courts of equity are designated as decrees. Their drafting is left to counsel, usually, in the first instance, to counsel for the prevailing party.[824] In practice, counsel usually agree upon the form of the decree, or, failing so to do, single out those parts concerning which they fail to agree, and submit them to the

820. Mr. Justice Bradley, in Webster Loom Co. v. Higgins, 105 U. S. 580, 26 L. Ed. 1177.

821. Waterman v. Shipman, 55 Fed. Rep. 982, 5 C. C. A. 371; to the same effect, see Greene v. Buckley, 135 Fed. Rep. 520, 68 C. C. A. 70; Fay v. Mason, 127 Fed. Rep. 325, 62 C. C. A. 159.

822. Mr. Justice Grier, in Winans v. N. Y. & Erie Railroad, 21 Howard 88, 16 L. Ed. 68.

823. Hanifen v. E. H. Godshalk Co., 84 Fed. Rep. 649, 28 C. C. A. 507.

824. Shute v. Morley Sewing Mach. Co., 64 Fed. Rep. 368, 12 C. C. A. 356.

court for settlement. It is not the duty of the court or the clerk to draft a decree, consequently, where an opinion was on file, containing the court's conclusion that the bill should be dismissed with costs, but no decree had ever been filed in pursuance of the opinion, the court held that the opinion should be treated as an informal decree, in which the complainant must be held, by years of inaction, to have acquiesced, and a bill of revivor filed twelve years after the opinion was stricken from the record.[825]

All decrees in equity are either final or interlocutory, of which classification Judge Aldrich has said: "This single division of decrees into two classes, and two only, interlocutory and final, has been generally accepted by lawyers and judges in this country and England. * * * It will be observed, from an examination of the cases in the Supreme Court of the United States, that a decree in patent cases, declaring the patent in question valid, and that it has been infringed, and for an injunction and an accounting, has uniformly been referred to as an interlocutory decree, and the cases are numerous, * * * where, upon an appeal from a decree determining the general property right, granting an injunction and an order for an accounting before a master, it has been held that the decree was not final or appealable."[826]

Usually, the determination whether a decree is interlocutory or final in character, is of importance only in relation to the question of the right to appeal. But the fact that the injunction granted by the decree is perpetual in terms, if the decree is otherwise interlocutory in character, does not make it a final decree.[827]

825. Hubbell v. Lankenau, 63 Fed. Rep. 881.

826. Richmond v. Atwood, 52 Fed. Rep. 10, 21, 2 C. C. A. 596.

827. Dudley E. Jones Co. v. Munger Improved Cotton Mach. Mfg. Co., 50 Fed. Rep. 785, 1 C. C. A. 668.

"The decree rests upon the pleadings, and must follow them. This is the well-settled rule in equity pleading and practice."[828] As the Court of Appeals of the Second Circuit has said: "Considering the uses to which decrees and decretal orders in patent cases are applied, and the frequent inability of the great public with which they are used to ascertain the circumstances under which they issue, we have several times cautioned parties complainant that they must be careful to limit their decrees and decretal orders to precisely what was determined by the court."[829]

§ 443. Interlocutory decrees.

The interlocutory decree "has been repeatedly defined as any decree made before final decision, and for the purpose of ascertaining matter of law or fact preparatory to a final decree."[830]

As Judge Pardee has pointed out, referring to Daniell's Chancery Practice (5th Ed.), 986, "the courts have not laid down any satisfactory definition of what is an 'interlocutory decree.' It is said that the difficulty is in the subject itself, for, by various gradations the interlocutory decree may be made to approach the final decree until the line of discrimination becomes too fine to be readily perceived. It is further said that the difficulty has been increased by the fact that the definition of a final decree has often been made to turn, not upon the nature of the determination, but upon the construction of the statutes regulating appeals."[831]

828. Severens, J., in Edison Elec. Light Co. v. Peninsular Light, Power & Heat Co., 95 Fed. Rep. 669, 676.

829. Putnam, J., in Hatch Storage Battery Co. v. Electric Storage Battery Co., 100 Fed. Rep. 975, 983, 41 C. C. A. 133.

830. Aldrich, J., in Richmond v. Atwood, 52 Fed. Rep. 10, 20, 2 C. C. A. 596.

831. Dudley E. Jones Co. v. Munger Improved Cotton Mach. Mfg. Co., 50 Fed. Rep. 785, 1 C. C. A. 668.

The United States Supreme Court has expressly held that a decree in equity "establishing the validity of a patent, and referring the case to a master to compute and report the damages, is interlocutory merely."[832]

"An interlocutory decree directing an accounting of 'the gains, profits, savings and advantages of the infringement,' instead of profits merely, is proper."[833]

One distinguishing feature of the interlocutory decree is that it remains under the control of the court and subject to its revision until the entry of the final decree.[834]

§ 444. Final decrees.

A final decree is one which finally disposes of a cause, so that nothing further is left for the court to adjudicate.[835]

The United States Supreme Court has recognized the difficulty which frequently attends the ascertainment of the character of a decree in equity. "Probably no question of equity practice has been the subject of more frequent discussion in this court than the finality of decrees. It has usually arisen upon appeals taken from decrees claimed to be interlocutory, but it has occasionally happened that the power of the court to set aside such a decree at a subsequent term has been the subject of dispute. The cases, it must be conceded, are not altogether harmonious. * * * It may be said in general that if the court make a decree fixing the rights and liabilities of the parties, and thereupon refer the case to him (the master) as a subordinate court, and for a judi-

832. McGourkey v. Toledo & Ohio Railway, 146 U. S. 545, 36 L. Ed. 1079. To the same effect, see, Smith v. Vulcan Iron Works, 165 U. S. 524, 41 L. Ed. 810; Australian Knitting Co. v. Gormly, 138 Fed. Rep. 92, 103.

833. Coburn v. Schroeder, 8 Fed. Rep. 521.

834. Wooster v. Handy, 23 Fed. Rep. 51, 53; Perkins v. Fourniquet, 6 Howard 206, 209, 12 L. Ed. 406.

835. Bouvier Dict. (Rawle's Rev.), Vol. 1, 521, title "Decree."

cial purpose, as to state an account between the parties upon which a further decree is to be entered, the decree is not final. * * * But even if an account be ordered taken, if such accounting be not asked for in the bill, and be ordered simply in execution of the decree, and such decree be final as to all matters within the pleadings, it will be regarded as final."[836]

Judge Showalter has pointed out that "one portion of a given decree may be final, and for that reason reviewable on appeal, while the remainder may be interlocutory, and for that reason not appealable."[837]

To be final, the decree must terminate the suit as to all the parties. Where the decree appealed from was against but one of several parties defendant, the Supreme Court has held that as the suit was still pending against the other defendants; the decree was not final and consequently was not appealable.[838]

"A decree may be none the less final because it is incomplete in failing to provide for its own execution, and to so end the litigation. If no reservation be made in such decree, the power of the court over it ceases with the term at which it was recorded, and a new bill must be filed, if need be, in order to carry into execution the adjudications in such final decree."[839]

§ 445. The order in which the issues should be determined by the decree.

The hearing of the issues in a patent case in equity upon all the proofs, is called the final hearing. If that

836. Mr. Justice Brown, in McGourkey v. Toledo & O. C. Ry. Co., 146 U. S. 536, 36 L. Ed. 1079.

837. Standard Elevator Co. v. Crane Elevator Co., 57 Fed. Rep. 773, 6 C. C. A. 100.

838. Hohorst v. Hamburg-American Packet Co., 148 U. S. 262, 37 L. Ed. 443.

839. Showalter, J., in Standard Elevator Co. v. Crane Elevator Co., 76 Fed. Rep. 767, 771, 22 C. C. A. 549. To the same effect, see Harmon v. Struthers, 48 Fed. Rep. 260.

hearing results in the dismissal of the bill of complaint upon any ground, the decree will be final. A final decree likewise results when a demurrer to the bill is sustained upon any ground (such as the invalidity of the patent upon its face) which cannot be cured by amendment.

There are certain established rules as to the order in which the issues should be disposed of, which are sometimes disregarded, but which may properly be noticed here. Where the jurisdiction of the court is questioned, either by the parties or by the court of its own motion, the jurisdictional question should first be disposed of, before the consideration of any other issue.[840]

Where the testimony warrants a dismissal of the bill upon both the grounds of invalidity of the patent or non-infringement by the defendant, the dismissal ought to be based upon the latter ground, "it being well recognized that courts are reluctant to decree patents invalid when a decree can be based on non-infringement;"[841] and this rule is effective both in directing courts in their disposition of patent cases,[842] and also in the interpretation of decrees of dismissal which are general in terms. In construing such decrees, the court will presume that the dismissal was predicated upon non-infringement.[843]

§ 446. Correction of decree.

In patent litigation in courts of equity the decree, especially when too broad, is peculiarly subject to rectification by the court, in view of the incidental interest of the public in the subject-matter. A decree should

840. Standard Elevator Co. v. Crane Elevator Co., 76 Fed. Rep. 767, 770, 22 C. C. A. 549.

841. Buffington, J., in Wilcox & Gibbs Sewing Machine Co. v. Sherborne, 123 Fed. Rep. 875, 877, 59 C. C. A. 363.

842. McMichael & Wildman Mfg. Co. v. Ruth, 123 Fed. Rep. 888, 890.

843. Wilcox & Gibbs Sewing Machine Co. v. Sherborne, 123 Fed. Rep. 875, 877, 59 C. C. A. 363.

never be permitted to stand when it is broader than the findings of the court. Where the decree is open to this objection it is the duty of the court to corrrect it of its own motion. In so correcting a decree, the Circuit Court of Appeals for the First Circuit declined to award costs of appeal to either party, finding that the counsel of both parties had been at fault, the solicitor for the complainant having failed to perform his duty of drawing out a proper decree, and the appellant having failed to assign the breadth of the decree as error.[844]

§ 447. Aids to the interpretation of the decree.

It is frequently necessary to go beyond the bare terms of a decree, both to ascertain the reasons for the decree, as well as to determine what has been decreed. The drafting of the decree is at times a matter of great difficulty, and a decree which is both adequate in expressing within itself what has been determined, and free from ambiguity, requires at times the highest exercise of care and skill on the part of the pleader. For these reasons resort may be had to the opinion of the court in which the decree was entered, as an aid in the interpretation of the decree.[845] This rule is entirely consistent with the rule that "an assignment of error which is predicated upon the opinion of the court, or upon a reason given by the court for its ruling or decree, is not available."[846]

In determining the scope of a decision as a precedent,

844. Shute v. Morley Sewing Machine Co., 64 Fed. Rep. 368, 12 C. C. A. 356.

845. Carson v. Three States Lumber Co., 149 Fed. Rep. 377, 382, 79 C. C. A. 197.

846. Woods, J., in Evans v. Suess Ornamental Glass Co., 83 Fed. Rep. 706, 709, 28 C. C. A. 24, citing, Caverly's Adm'r v. Deere & Co., 66 Fed. Rep. 305, 13 C. C. A. 452; Russell v. Kern, 69 Fed. Rep. 94, 16 C. C. A. 154; Clark v. Deere & Mansur Co., 80 Fed. Rep. 534, 25 C. C. A. 619.

the court may look into, and it is proper to offer in evidence, the entire record in the case in which the decision was rendered.[847]

§ 448. Supersedeas.

Applications for supersedeas are commonly made by a defendant enjoined by interlocutory decree, to the end of staying the operation of the injunction pending the appeal. Mr. Justice Lurton, when circuit judge, wrote the following:

"When an appeal was allowed from the decree granting the perpetual injunction, the Circuit Court, as it was authorized to do under section 7 of the Courts of Appeals Act, granted an appeal with supersedeas, on a bond conditioned that the defendant should prosecute the said appeal to effect and pay all costs and damages if it failed to make said appeal good, 'as well as all damages and profits resulting from its manufacture and sale of the infringing sweepers after the date of the said decree.' This only operated to stay or suspend the injunction pending the appeal. It had no effect or operation as a license to defendant. The status of the defendant was simply that of persons engaged in infringing, and not restrained by operation of the injunction. But, however this may be, so soon as the appeal had been determined adversely to the appellant, the injunction was instantly reinstated, the supersedeas having expired by its own limitation. The clear effect of the decree now complained of was to dissolve this injunction *pro tanto*. More

847. American Bell Tel. Co. v. Wallace Electric Co., 37 Fed. Rep. 672; Adams v. Tannage Patent Co., 81 Fed. Rep. 179, 26 C. C. A. 326; Rose v. Fretz, 98 Fed. Rep. 112; Liebig's Extract of Meat Co. v. Libby, 103 Fed. Rep. 87, 89; N. Y. Filter Mfg. Co. v. Jackson, 112 Fed. Rep. 678, 680; Liebig Extract of Meat Co. v. Walker, 115 Fed. Rep. 822, 825.

than this, the decree seems to have gone so far as in terms to grant a license to the defendant to continue its infringement, by authorizing it to complete the manufacture of structures begun, and to sell others, to be sold or used—sweepers already complete, as well as those to be finished under the order. Before the provision for an appeal from an interlocutory order or decree granting an injunction, it was not unusual or improper to suspend the operation of an injunction awarded by a decree determining the merits, and referring the case to a master for accounting. The propriety of such a suspension was due to the fact that, while the injunction might be awarded upon a decree which was final to the merits, yet it was not final under the rulings of the Supreme Court as to what constituted an appealable decree, within the terms of section 692, R. S. U. S. Very great hardships frequently resulted from the operation of such an injunction, due to the fact that very often a long and expensive accounting intervened between the allowance of the injunction and the rendition of the final decree from which an appeal would lie. To prevent as much as possible the severe consequence incident to the practical enforcement of interlocutory decrees affecting the merits of the controversy, though not appealable, the Supreme Court, at an early day, admonished trial judges as to their duty to alleviate as far as possible all such consequences, by saying:

"'It is exceedingly important, therefore, that the Circuit Courts of the United States, in framing their interlocutory orders, and in carrying them into execution, should keep in view the difference between the right of appeal as practiced in the English chancery jurisdiction and as restricted by the act of Congress, and abstain from changing unnecessarily the possession of property

or compelling the payment of money by an interlocutory order.'[848]

"An application to suspend the operation of such an injunction came on to be heard before Justice Swayne, when holding a Circuit Court, who took occasion, in granting the application, to say:

"'An application is made that this final decree shall be suspended, as it regards the injunction, until the account shall be determined upon, and the decree shall be finally made upon that account, and when the defendant, for the first time, will have the right to appeal. He cannot appeal from the decree as it at present stands, because, although the decision is final as to the merits of the case, it is in form an interlocutory decree only, and the rule established by the Supreme Court is that an appeal can be taken only from a final decree. It has been held, in this class of cases, that a decree is not to be considered final for the purposes of an appeal until after the coming in of the master's report. I have no doubt of the power of the court to sustain this motion. Such power is incidental, in my judgment, to equity proceedings. There is no question, in my judgment, of the power of the court to stay a judgment at law. And it is a constant practice of the State Courts and the Circuit Courts of the United States, where the equities between the parties require it, to make such an order. If I had any doubt of it, the authority of Barnard v. Gibson, 48 U. S. (7 How.) 650, 12 L. Ed. 857, is conclusive.'[849]

"If an appeal be allowed from an interlocutory order or decree granting an injunction, the injunction will continue in force pending the appeal, unless stayed by order of the court granting the appeal. The granting of a

848. Forgay v. Conrad, 47 U. S. (6 How.) 201, 205, 12 L. Ed. 653.

849. Potter v. Mack, 3 Fisher 428, Fed. Case 11,331.

supersedeas rests in the judicial discretion of the court, and its discretion to grant or refuse a supersedeas will not be controlled by mandamus."[850]

§ 449. Bills of review.

The bill of review is defined by Bouvier as "One which is brought to have a decree of the court reviewed, altered, or reversed."[851] The bill of review is employed for three purposes; to correct errors of law appearing upon the record or in the decree,[852] or because of newly discovered evidence,[853] or because of fraud in obtaining the decree.[854]

"A court of law is powerless to change or modify, in substantial respects, its judgments after the rising of the court for the term in which the judgment was rendered. But a court of equity may, by bill of review, filed after the term, modify or vacate its decrees. If the bill of review is based upon errors appearing upon the record, it must be filed within the time in which an appeal could have been taken. If, however, the bill of review is based upon fraud in obtaining the decree, or for newly discovered evidence, the time within which it should be filed is governed by the general equitable rules of laches. Bill of review has always been recognized as the proper remedy in case of newly discovered evidence.* * * A bill of review should state when the fraud or new evidence was discovered, so that the court may see that the party has not been guilty of laches, and, like other bills

850. Bissell Carpet Sweeper Co. v. Goshen Sweeper Co., 72 Fed. Rep. 545, 546, 19 C. C. A. 25; citing, In re Haberman Mfg. Co., 147 U. S. 525, 37 L. Ed. 266.

851. Bouvier, Dict. (Rawle's Rev.), Vol. 1, p. 244, title "Bill of Review."

852. Whiting v. Bank of the United States, 13 Peters 6, 14, 10 L. Ed. 33, 37.

853. Taylor v. Easton, 180 Fed. Rep. 363, 368, —— C. C. A. ——.

854. Terry v. Commercial Bank of Alabama, 92 U. S. 454, 456, 23 L. Ed. 620.

in equity, should contain a prayer for subpoena or process."[855]

Proper notice of the application for leave to file the bill of review should be given to the opposing party.[856] The hearing upon such an application is governed as to its scope by the discretion of the court, and counter affidavits may be admitted upon the hearing.[857] The application is not granted as a matter of right, but purely in the exercise of the court's discretion.[858]

Leave to file the bill of review having been granted, and the bill filed, the opposing party may plead or answer to the bill, joining the issues as to the facts pleaded.[859] Should the opposing party fail to plead or answer the bill may be taken *pro confesso*.[860]

The bill of review may be demurred to, although a general demurrer must be overruled if the bill makes out a case for equitable relief against the decree.[861] If the bill recites the evidence upon which the decree was founded, a special demurrer upon this ground will be sustained.[862] Upon the hearing of the demurrer all facts recited in the bill which are inconsistent with the decree are taken as true.[863]

The award of costs, upon a bill of review being sustained, is purely discretionary both as to the costs of the original proceedings and those accruing after the filing of the bill of review.[864] A bill of review may be filed

855. Munger, W. H., J., in Taylor v. Easton, 180 Fed. Rep. 363, 368, —— C. C. A. ——.

856. Wallamet Iron Bridge Co. v. Hatch, 19 Fed. Rep. 347.

857. Blandy v. Griffith, 6 Fisher 434, Fed. Case 1530.

858. Ricker v. Powell, 100 U. S. 104, 25 L. Ed. 527.

859. Dexter v. Arnold, 5 Mason 303, Fed. Case 3856.

860. United States v. Samteryac, 1 Hempst. 118, Fed. Case 16,216a.

861. Buffington v. Harvey, 95 U. S. 99, 24 L. Ed. 381.

862. Buffington v. Harvey. 95 U. S. 99, 24 L. Ed. 381.

863. Shelton v. VanKleeck, 106 U. S. 532, 27 L. Ed. 269.

864. Miller v. Clark, 52 Fed. Rep. 900.

without leave of court where it seeks to correct error apparent upon the face of the record or decree,[865] provided that it is filed within the time within which an appeal may be taken.[866]

Where the bill of review sought to be filed is based upon newly discovered evidence, or fraud in obtaining the decree, it can only be filed by leave of court.[867] If the application for leave to file such a bill is made after an appellate court has obtained jurisdiction of the case, the application must be made to the appellate court to file the bill of review in the lower court, and where the appellate court denies such a motion, the filing of the bill of review will not be permitted by the lower court.[868] The application for leave to file the bill of review should be made by petition, describing the new evidence specifically, setting forth its relevancy to the decree, and when it was discovered.[869] It should be supported by an affidavit covering these points and stating why the new matter could not be availed of prior to the decree.[870]

The following summary of the functions of the bill of review, by Judge Sanborn, is supplementary to what has just been presented:

"The purpose of a bill of review is to obtain a reversal or modification of a final decree. There are but three grounds upon which such a bill can be sustained. They are (1) error of law apparent on the face of the

865. Ross v. Prentiss, 4 McLean 106, Fed. Case 12,078; Copeland v. Bruning, 104 Fed. Rep. 169.

866. M'Donald v. Whitney, 39 Fed. Rep. 466.

867. Ross v. Prentiss, 4 McLean 106, Fed. Case 12,078.

868. McClintock v. City of Pawtucket, 180 Fed. Rep. 320: Southard v. Russell, 57 U. S. (16 How.) 547, 570, 14 L. Ed. 1052; Kingsbury v. Buckner, 134 U. S. 650, 670, 672, 33 L. Ed. 1047; In re Potts, 166 U. S. 263, 41 L. Ed. 994.

869. Dexter v. Arnold, 5 Mason 303, Fed. Case 3856.

870. Ricker v. Powell, 100 U. S. 104, 25 L. Ed. 527; Barton v. Barbour, 104 U. S. 126, 26 L. Ed. 672.

decree and the pleadings and proceedings upon which it is based, exclusive of the evidence; (2) new matter which has arisen since the decree; and (3) newly-discovered evidence, which could not have been found and produced, by the use of reasonable diligence, before the decree was rendered. No departure has ever been made from the rules applicable to such a bill, which were declared by Lord Chancellor Bacon, in the first of his ordinances in chancery, in these words:

"'No decree shall be reversed, altered, or explained, being once under the great seal, but upon bill of review. And no bill of review shall be admitted, except it contain either error in law, appearing in the body of the decree, without further examination of matters in fact, or some new matter, which hath arisen in time after the decree, and not any new proof, which might have been used, when the decree was made. Nevertheless, upon new proof, that is come to life after the decree was made, which could not possibly have been used at the time when the decree passed, a bill of review may be grounded by the special license of the court, and not otherwise.' (Beames, Orders Ch. 1.)

"The error in law which will maintain a bill of review must consist of the violation of some statutory enactment, or of some recognized or established principle or rule of law or equity, or of the settled practice of the court. Error in matter of form or in the propriety of a decree, which is not contrary to any statute, rule of law, or to the settled practice of the court, is not sufficient to maintain a suit to review a final decree.[871] Resort cannot be had to the evidence to discover this error of law. It must be apparent from the pleadings, proceedings, and decree, without a reference to the evidence, or

871. Citing Freeman v. Clay, 52 Fed. Rep. 1, 7, 2 C. C. A. 587, 593; Hoffman v. Pearson, 50 Fed. Rep. 484, 490, 1 C. C. A. 535, 541.

it will not avail to sustain a bill of review.[872] The new matter which will authorize a review of a final decree must have arisen after its rendition. The newly-discovered evidence which may form the basis of such a review must be, not only evidence which was not known, but also such as could not, with reasonable diligence, have been found before the decree was made."[873]

§ 450. Threats (trade slander and libel relating to patents).

It is the well-settled rule in England that "the court will interfere by injunction where statements are made with reference to the infringement of a patent, or the invasion of a trademark and the like, if it is proved to the satisfaction of the court that these statements are untrue."[874]

Judge Wheeler was one of the first American judges, if not the first, to formulate a rule in accordance with that which had been established by the courts of Great Britain. He said: "Courts of equity have no jurisdiction of libel or slander affecting title to property or property rights, or any other slander or libel, unless threatened or apprehended repetition makes preventive relief proper and necessary. The remedy for past injuries of that nature is understood to be wholly at law."[875]

So in a case involving an application to enjoin the circulation of letters charging certain articles to be infringements of the writer's patent, and threatening suits for infringement, where the only proof adduced related to the sending of but one letter of this character, Judge

872. Citing Whiting v. Bank, 38 U. S. (13 Pet.) 5, 14, 10 L. Ed. 33; Kennedy v. Bank, 49 U. S. 586, 609, 12 L. Ed. 1209; Putnam v. Day, 89 U. S. (22 Wall.) 60, 66, 22 L. Ed. 764; Buffington v. Harvey, 95 U. S. 99, 24 L. Ed. 381.

873. Hill v. Phelps, 101 Fed. Rep. 650, 651, 41 C. C. A. 569.

874. Chitty, J., in Anderson v. Liebig's Extract of Meat Co., 45 L. T. N. S. 757, 758.

875. Palmer v. Travers, 20 Fed. Rep. 501.

Coxe said: "I have been referred to no case, and know of none, where a single letter of this kind has been held sufficient to warrant the issuing of a preliminary injunction."[876]

In the asperity always aroused to a greater or less degree by patent litigation, or keen competition where one or both competitors are operating under patents, the cases have in several instances dealt with threats of the character under consideration, and as the decisions are somewhat confused, we have thought it best to begin their consideration with the principles above set forth. Summarized, we start with the knowledge,

1. That a single threat will not of itself suffice as a basis for equitable relief, at least *in limine*,

2. That the representation sought to be enjoined must be untrue,

3. That equitable relief cannot be had, in any event, except as to threatened or apprehended repetition in the future.

In the first reported case in this country of injunction sought to restrain the defendant's use of threatening circulars, the court found that the defendants had not made false or fraudulent statements. "They have freely expressed their opinion, and this opinion may be an erroneous one; but nothing beyond this is shown." Suit for infringement was pending—the defendant in the later suit being plaintiff in the prior suit—and the circulars merely warned the trade that the suit had been brought, and if successful, all infringers would be prosecuted.[877]

In the next case of this character the injunction was sought by an unsuccessful defendant manufacturer, as against the successful complainant, while the suit was pending on accounting, to restrain the plaintiff from col-

876. George Frost Co. v. Kora Co., 136 Fed. Rep. 487, 489.

877. Chase v. Tuttle, 27 Fed. Rep. 110.

lecting royalties from the users of the infringing machines made by the defendant. There was here no element of libel or slander. The plaintiff was acting strictly within its rights, and the injunction was refused on that ground.[878] There was another reason why the relief could not be granted; the same judge (Coxe) later stated it thus: "The defendant in an infringement suit cannot convert the action into one for affirmative relief upon an entirely separate and distinct cause of action."[879]

So far, there is no difficulty in reconciling the facts in the reported cases with the law as it is today. In Baltimore Car Wheel Co. v. Bemis,[880] the recital of facts in the opinion is too meager to render the case intelligible.

A little later Judge Blodgett was called upon to pass on an application for injunction against threats of the kind under consideration. The recital of facts in his opinion is too lengthy to be even digested here. The application was resisted upon the authority of Kidd v. Horry,[881] and the court, properly distinguishing the case at bar upon the facts said:

"Kidd v. Horry was an application for an injunction restraining the defendant from publishing certain circular letters alleged to be injurious to the patent rights and business of the complainant, and from making and uttering libelous and slanderous statements, written or oral, concerning the business of complainants, or concerning the validity of their Letters Patent, or of their title thereto, pending the trial and adjudication of a suit which had been brought to restrain the infringement of said patents; and Mr. Justice Bradley in deciding the case said:

878. Tuttle v. Matthews, 28 Fed. Rep. 98.

879. George Frost Co. v. Kora Co., 136 Fed. Rep. 487, 489.

880. 29 Fed. Rep. 95.

881. 28 Fed. Rep. 773.

" 'The application seems to be altogether a novel one, and is urged principally upon a line of recent English authorities, such as Dixon v. Holden, L. R., 7 Eq. 488; Food Co. v. Massam, 14 Ch. Div. 763; Thomas v. Williams, Id. 864; and Loag v. Bean, 26 Ch. Div. 306. An examination of these and other cases relied on convinces us that they depend on certain acts of the Parliament of Great Britain, and not on the general principles of equity jurisprudence. * * * But neither the statute law of this country, nor any well-considered judgment of a court, has introduced this new branch of equity into our jurisprudence. There may be a case or two looking that way, but none that we deem of sufficient authority to justify us in assuming the jurisdiction. * * * We do not think that the existence of malice in publishing a libel, or uttering slanderous words, can make any difference in the jurisdiction of the court. Malice is charged in almost every case of libel; and no cases or authority can be found, we think, independent of statute, in which the power to issue an injunction to restrain a libel or slanderous words has ever been maintained, whether malice was charged or not.'

"The principle of this case, concisely stated, is that a court of equity has no jurisdiction to restrain the publication of a libel or slander. But it seems to me the case now under consideration is fairly different and distinguishable from the case relied upon by the defendant in what seems to me a material and vital feature. In Kidd v. Horry the owner of a patent sought the interference of a court of equity to restrain the defendants from publishing and putting in circulation statements challenging the validity of his patent, and of his title thereto, on the ground that such publications were libelous attacks upon his property. Here the complainant seeks to restrain

the defendants from making threats intended to intimidate the complainant's customers under the pretext that complainant's goods infringe a patent owned or controlled by defendants, and threats that if such customers deal in complainant's goods they will subject themselves to suit for such infringement; the bill charging, and the proof showing, that these charges of infringement are not made in good faith, but with a malicious intent to injure and destroy the complainant's business. While it may be that the owner of a patent cannot invoke the aid of the court of equity to prevent another person from publishing statements denying the validity of such patent by circulars to the trade, or otherwise, yet, if the owner of a patent, instead of resorting to the courts to obtain redress for alleged infringements of his patent, threatens all who deal in the goods of a competitor with suits for infringement, thereby intimidating such customers from dealing with such competitor, and destroying his competitor's business, it would seem to make a widely different case from Kidd v. Horry, and that such acts of intimidation should fall within the preventive reach of a court of equity. It may be libelous for the owner of a patent to charge that an article made by another manufacturer infringes his patent; and notice of an alleged infringement may, if given in good faith, be a considerate and kind act on the part of the owner of the patent; but the *gravamen* of this case is the attempted intimidation by defendants of complainant's customers by threatening them with suits which defendants did not intend to prosecute; and this feature was not involved in Kidd v. Horry. I cannot believe that a man is remediless against persistent and continued attacks upon his business, and property rights in his business, such as have been perpetrated by these defendants against the complainant, as shown by the proofs in this case. It shocks my sense of justice to say that a

court of equity cannot restrain systematic and methodical outrages like this, by one man upon another's property rights. If a court of equity cannot restrain an attack like this upon a man's business, then the party is certainly remediless, because an action at law in most cases would do no good, and ruin would be accomplished before an adjudication would be reached. True, it may be said that the injured party has a remedy at law, but that might imply a multiplicity of suits which equity often interposes to relieve from; but the still more cogent reason seems to be that a court of equity can, by its writ of injunction, restrain a wrongdoer, and thus prevent injuries which could not be fully redressed by a verdict and judgment for damages at law. Redress for a mere personal slander or libel may perhaps properly be left to the courts of law, because no falsehood, however gross and malicious, can wholly destroy a man's reputation with those who know him; but statements and charges intended to frighten away a man's customers, and intimidate them from dealing with him, may wholly break up and ruin him financially, with no adequate remedy if a court of equity cannot afford protection by its restraining writ."[882]

There is little doubt that Mr. Justice Bradley in Kidd v. Horry has correctly attributed the development in England of the use of the writ of injunction against trade libel and slander to the common-law procedure act of 1854 (17 & 18 Vict. c. 125, §§ 79, 81, 82). But his argument that because the development of this branch of equity jurisprudence in England was fostered and facilitated by an Act of Parliament, the Federal equity procedure of this country must stand still, has met with but small favor.

882. Blodgett, J., in Emack v. Kane, 34 Fed. Rep. 46, 49, 51.

The law as it stands today indicates that our courts of equity have, without any legislative enlargement of the remedy by writ of injunction, overtaken and are keeping pace with those of Great Britain in the suppression of threats made in bad faith.[883]

Judge Dallas has accurately stated the present rule as follows:

"Where notices are given or circulars distributed in good faith to warn against infringement, no wrong whatever is committed; but where, as is here averred, they are not made or issued with such intent, but in bad faith, and solely for the purpose of destroying the business of another, a very different case is presented. In such a case property rights are fraudulently assailed, and a court of chancery, whose interposition is invoked for their protection, should not refuse to accord it."[884]

Judge Wallace, in speaking of this doctrine, has said:

"Undoubtedly the owner of a patent is acting within his rights in notifying infringers of his claims, and threatening them with litigation if they continue to disregard them; nor does he transcend his rights when, the infringer being a manufacturer, he sends such notices to the manufacturer's customers, if he does so in good faith, believing his claims to be valid, and in an honest effort to protect them from invasion. The question whether the patent owner is acting in good faith in advertising

883. Hopkins on Trademarks (2d Edition), § 20.

884. A. B. Farquhar Co. v. National Harrow Co., 102 Fed. Rep. 714, 715, 42 C. C. A. 600, 49 L. R. A. 755; citing, Emack v. Kane, 34 Fed. Rep. 46; Kelley v. Manufacturing Co., 44 Fed. Rep. 23, 10 L. R. A. 686; Casey v. Union, 45 Fed. Rep. 135, 12 L. R. A. 193; Toledo, A. A. & N. M. Ry. Co. v. Pennsylvania Co., 54 Fed. Rep. 730, 19 L. R. A. 387; Computing Scale Co. v. National Computing Scale Co., 79 Fed. Rep. 962; Lewin v. Light Co., 81 Fed. Rep. 904; Railway Co. v. McConnell, 82 Fed. Rep. 65; Adriance, Platt & Co. v. National Harrow Co., 98 Fed. Rep. 118; In re Debs, 158 U. S. 564, 39 L. Ed. 1092.

his claims to the manufacturer's customers by circulars or letters can seldom be determined from the contents of the communication alone, and, like all questions of intent, must generally be determined by the extrinsic facts. It is always easy to frame such circulars in guarded terms, which will not commit the sender to any definite libelous charges, omitting specific statements of fact, and substituting statements of opinion; and when they are sent for an illegitimate purpose they are likely to be so framed. * * * When the manufacturer is financially responsible, is accessible, and his infringements readily provable, and when the patent owner is financially able, and is one who makes it his sole business to grant licenses, and is under a duty to his licensees to prosecute extensive infringers, the sending of such letters to customers would seem to be merely a preliminary or cumulative measure, and the bringing of an infringement action the paramount and imperative proceeding. As, ordinarily, the patent owner would be prompt and zealous to assert his claims, if he halts and purposely procrastinates, and attempts to effect by threats and manifestoes that which he can compel by the strong hand of the law, a strong inference arises that he has not any real confidence in his pretensions. This inference becomes irresistible if he refuses to bring suit during a considerable period of time when the alleged infringement is open, notorious, and defiant, and so extensive as to threaten destruction to his alleged exclusive rights."[885]

From which we see the damaging effect of laches, in the prosecution of the alleged infringement, after threats made.

885. Adriance, Platt & Co. v. National Harrow Co., 121 Fed. Rep. 827, 829, 30 C. C. A. 94; reversing, Adriance, Platt & Co. v. National Harrow Co., 111 Fed. Rep. 637.

§ 451. Interferences—The statute.

Section 4904, R. S. U. S. "Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be, and shall direct the Primary Examiner to proceed to determine the question of priority of invention. And the Commissioner may issue a patent to the party who is adjudged the prior inventor, unless the adverse party appeals from the decision of the Primary Examiner, or of the Board of Examiners-in-Chief, as the case may be, within such time, not less than twenty days, as the Commissioner shall prescribe."

§ 452. "Interference" defined.

"Interference means a dispute on the question of priority of invention."[886] It is purely a statutory proceeding, arising solely under the authority of § 4904, and is a contest between rival applicants for a patent, or a contest between one or more applicants for patent, and the owner of one or more outstanding letters patent.[887]

§ 453. How created.

Interferences are created by the Patent Office by an action which is termed a "declaration of interference." Prior to such declaration being made, the claims involved must be determined by the Patent Office to be patentable generally.[888] The failure of the Patent Office to declare an interference between a pending original application and a reissue application is not to be construed as a

886. Blatchford, C. J., in U. S. & Foreign Salamander Felting Co. v. Asbestos Felting Co., 4 Fed. Rep. 813, 815.

887. Western Electric Mfg. Co. v. Chicago Electric Mfg. Co., 14 Fed. Rep. 691.

888. American Bell Telephone Co. v. U. S., 68 Fed. Rep. 542, 15 C. C. A. 569.

decision that the claims of the respective applications are for different inventions.[889]

Judge Sanborn has given this interesting summary of the Patent Office Interference procedure: "When an application for a patent is filed, an officer known as the 'Primary Examiner' decides whether the application on its face shows patentable invention. Rules 95, 96. No appeal lies from his decision. Rule 124. Patentability being affirmed, it may occur that the application discloses the same invention as another application on file or as a patent already issued. If so, an 'interference' exists, and the patent officers are then required, according to the practice and rules of the office, to set on foot an interference proceeding, in order to determine which of the hostile claimants first discovered the invention. This proceeding is carried on before the Examiner of Interferences, and is a proceeding *inter partes*, and results either in a decision awarding priority to one, and denying it to the other, or for some particular reason denying priority to either.

"This question of priority of invention, meaning priority in time, has become the important and almost sole question for consideration in the interference proceeding. Other questions may arise in the Patent Office, such as whether one or both parties has the right to make claim, whether he has really disclosed in his drawings the invention claimed, whether he is the real inventor, whether he is guilty of laches or estoppel to claim priority, whether his device is operative, whether both claim the same invention so as to actually show interference. By the course of practice in the Patent Office, however, the interference proceeding is confined to the question of priority in time, other questions being raised by mo-

889. Hicks v. Shaver, Fed. Case No. 6462.

tion before the Primary Examiner. The Examiner of Interferences may also call the attention of the Commissioner to facts showing that no interference exists, or that the declaration of interference was irregular, and the Commissioner may then suspend the interference proceedings, and remand the case to the Primary Examiner for consideration of the questions so raised. Rule 126. It may also appear in the interference proceedings that while both applications disclose patentability and interference, and one is clearly prior in time, yet that neither party is entitled to a judgment of priority against the other, because it would operate inequitably against the other. This happened in Bechman v. Wood, 15 App. D. C. 484, where Wood first discovered a broad invention, but made only a narrow claim, and the junior applicant, Bechman, claimed a specific device in the same field, and also claimed the broad invention. Wood was adjudged not entitled to the broad claim because this would defeat Bechman's specific apparatus, and Bechman was not entitled to it because he was not the first inventor. But in the ordinary case an award of priority follows as a matter of course.

"While the question whether the interference was properly declared, or any interference in fact exists, cannot be directly raised in the interference proceeding, it may be by a motion to dissolve the interference. It is the practice to present to the Examiner of Interferences a motion to transmit the motion to dissolve to the Primary Examiner, together with the motion to dissolve. If the latter motion is in proper form he transmits it to the Primary Examiner, and he may at the same time proceed with the interference. Rule 123. When the Primary Examiner has decided the motion, an appeal may be taken to the Commissioner, but no further appeal is permitted, the motion being regarded as an interlocutory proceeding. U. S. ex rel. Lowry v. Allen, 203 U. S.

476, 27 Sup. Ct. 141, 51 L. Ed. 281. If the motion to dissolve is denied, the Examiner of Interferences, in the usual case, renders judgment awarding priority of invention to one of the contestants, and also fixes the limit of appeal from such judgment. If no appeal be taken letters patent are issued to the successful party, and the Primary Examiner notifies the other party that his claims stand finally rejected. (§ 4904, Rev. St. U. S. Comp. St. 1901, p. 3389.) Rule 132. If the defeated party desires to appeal he may do so within the time limited. The appeal first goes to the Examiners-in-Chief (§ 4909, U. S. Comp. St. 1901, p. 3390), then to the Commissioner in person (§ 4910, U. S. Comp. St. 1901, p. 3391), and from his decision to the Court of Appeals of the District of Columbia (Act Feb. 9, 1893, c. 74, 27 Stat. 436, § 9, U. S. Comp. St. 1901, p. 3391)."[890]

§ 454. What issues formed, and how.

The issues in interferences are established by the incorporation in the conflicting applications, or conflicting patent (or patents) and applications, of claims identical in terms. "The question of interference is determined by the claims, not by the general appearance and functions of the machine, shown but not claimed."[891] "Patents interfere only when they claim the same invention, in whole or in part. * * * It has been held that an interference does not exist, within the meaning of the statute, between a patent having a dominant broad claim and a junior patent having a subordinate specific claim."[892] The issue in interference is limited to the

890. Westinghouse v. Hien, 159 Fed. Rep. 936, 939, 87 C. C. A. 142.

891. Buffington, J., in Dedrick v. Fox, 56 Fed. Rep. 714, 718.

892. Acheson, J., in Stonemetz Printers' Mach. Co. v. Brown Folding Mach. Co., 57 Fed. Rep. 601, 605; citing, Morris v. Kempshall Mfg. Co., 20 Fed. Rep. 121; Pentlarge v. N. Y. Bung & Bushing Co., 20 Fed. Rep. 314.

claims actually interfering,[893] and is strictly limited to the question of priority of invention.[894]

Upon the issues of the interference being fixed, the parties are required to file preliminary statements, within a time fixed by the Patent Office, setting forth the dates claimed for conception, disclosure to others, the first drawings or sketches, models, and actual reduction to practice. The parties are held to these dates with a strictness which obtains in no other branch of civil law practice of which we have knowledge.[895] The "utmost care and diligence" are required of the parties in preparing the preliminary statements.[896] In no other procedure known to us is it so difficult to obtain leave to amend. A delay of four months and a half has been held sufficient to justify the refusal of leave to amend,[897] and the motion for leave to amend is considered not only upon the supporting affidavits which must accompany it, but upon the entire record.[898]

"As a theoretical problem, or a question of first impression, it would appear to be clear that the interference proceeding logically involves the fundamental question whether there is, in fact, any interference, whether one or both claims be patentable, and whether either party has the right to make the claim. A judgment of priority would seem to have no force if the rival claims do not conflict, or if the junior claim be not patentable, or either party be not the real inventor. Likewise, it would seem that an appeal from the judgment of prior-

893. Porter v. Louden, 7 App. D. C. 64; Rosell v. Allen, 16 App. D. C. 559.

894. Ironclad Mfg. Co. v. Jacob J. Vollrath Mfg. Co., 52 Fed. Rep. 143, 145.

895. Stevens v. Seher, 81 Off. Gaz. 1932.

896. Henderson v. Noakes, 59 Off. Gaz. 1762.

897. Gornall v. Lovejoy, 56 Off. Gaz. 927.

898. Foster v. Bent, 77 Off. Gaz. 1781.

ity should raise these fundamental questions, and the result on appeal dispose of the whole case, and all these questions. But such has not been the rule of the Patent Office, nor of the Court of Appeals.

"By the rule actually in force in the Patent Office the term 'priority of invention' is used in the narrow sense of first in time, and not as involving interference in fact or the right to make claim. And this limited meaning is also given it by Mr. Justice McKenna in U. S. ex rel. Lowry v. Allen, 203 U. S. 476, 51 L. Ed. 281. This use of the term seems to have resulted from the practice of trying the questions of interference in fact and right to claim by motion before the Primary Examiner, and thus treating these as interlocutory questions. Since priority means only first in time, a judgment awarding priority is deemed to establish only that the successful party was the first inventor of the device or article claimed by him, without involving the question whether he had the right to claim it, or whether the other party claimed in substance the same invention. This conclusion has been reached many times in the decisions of the Patent Office and Court of Appeals. The judgment of priority is not a direct decision that the defeated party is not entitled to a patent, and he may appeal, *ex parte*, from the final rejection of his application. Ex parte Schupphaus, 100 Off. Gaz. 2775, 1902 C. D. 339; Ex parte Guilbert, 85 Off. Gaz. 454, 1898 C. D. 225. The right to make the claim does not relate to priority of invention, but should be presented on a motion to dissolve. Woods v. Waddell, 106 Off. Gaz. 2017, 1903 C. D. 393. The question of interference in fact will not be considered on appeal from a judgment awarding priority. Schupphaus v. Stevens, 95 Off. Gaz. 1452, 1901 C. D. 369, citing many cases in the Court of Appeals; Ex parte Lyon, 124 O. G. 2905.

"It is true that the Court of Appeals has held that it will, in extreme cases, on appeal from a judgment awarding priority, review the decision of the Commissioner declaring the interference, or refusing to dissolve it. This was held in Seeberger v. Dodge, 24 App. D. C. 476 (1905); and the same conclusion is stated, though not actually applied, in Podlesak v. McInnerney, 26 App. D. C. 399, 120 Off. Gaz. 2127 (1906). But this is quite a different thing from holding that in all cases, including this, a judgment establishing priority in time settles the question of interference in fact, and precludes the defeated party from ever raising that question, by further proceedings in the Patent Office. The Podlesak Case, supra, is relied on by appellants as conclusive. But the Court of Appeals in that case, as appellants admit and expressly state, refused to reverse on the ground that there was no interference in fact, but remanded the case to the Commissioner for further consideration as to the identity of invention, with the statement that, if the Commissioner should adhere to the opinion that there was interference in fact, the court would further consider the case. This falls far short of a decision that a judgment of priority necessarily involves the question of identity or interference." [899]

§ 455. Procedure.

The statutory provision for the taking of testimony in interference cases is as follows:

Section 4905, R. S. U. S. "The Commissioner of Patents may establish rules for taking affidavits and depositions required in cases pending in the Patent Office, and such affidavits and depositions may be taken before any

899. Sanborn, J., in Westinghouse v. Hien, 159 Fed. Rep. 936, 940, 87 C. C. A. 142.

officer authorized by law to take depositions to be used in the courts of the United States, or of the State where the officer resides."

In interference cases "the ordinary rules of evidence, and those decisions of the courts in which the same questions are discussed, are followed."[900] Judicial notice is taken of matters of public notoriety.[901] Judicial notice is taken by the Patent Office of decisions of the Court of Appeals of the District of Columbia,[902] and of its own official entries.[903] "The process of taking judicial notice does not necessarily imply that the judge at the moment actually knows and feels sure of the truth of the matter submitted; it merely relieves the party from offering evidence because the matter is one which the judge either knows or can easily discover."[904]

The order of proof in interference cases is somewhat rigidly insisted upon, and testimony taken improperly as rebuttal will not be considered; the Court of Appeals of the District of Columbia suggesting, in such case, that the offending party might have obtained leave to reopen his case-in-chief.[905]

Section 4908, R. S. U. S., which protects witnesses against disclosure of a secret discovery, or invention, does not protect a witness who is a party to an interference.[906]

The doctrine of equitable estoppel applies to interference cases.[907] Due weight is given any estoppel created by the act of a party either before or after the issuance

900. Duell, Commissioner, in Berry v. Stockwell, 9 Off. Gaz. 404, 405.

901. Anson v. Woodbury, 12 Off. Gaz. 1.

902. Ex parte Tournier, 108 Off. Gaz. 798.

903. Cain v. Park, 86 Off. Gaz. 797, 14 App. D. C. 42.

904. McComas, J., in Ball v. Flora, 121 Off. Gaz. 2668, 26 App. D. C. 394.

905. Woodbridge v. Winship, 145 Off. Gaz. 1250, 1252.

906. Dornan v. Keefer, 49 Fed. Rep. 462.

907. In re Mower, 88 Off. Gaz. 191, 15 App. D. C. 144.

of his patent, which prevents him claiming his alleged invention in its entirety.[908] An applicant is estopped from urging the non-patentability of his claim after it has been put in interference.[909]

As to appeals in interference cases, §§ 4909, 4910, R. S. U. S., provide for successive appeals, from the Examiner of Interferences to the Board of Examiners-in-Chief, and from that Board to the Commissioner; and from his decision § 4912, read in connection with the act establishing the Court of Appeals for the District of Columbia, gives the right of appeal to that court. Patent Office Rule 147 provides that "Appeals in interference cases must be accompanied by brief statements of the reasons therefor." But such statement has been held not to be of the substance of the appeal, and not a condition precedent to the validity of the appeal.[910]

Rule 123 provides that the filing of a motion for rehearing does not operate to stay the running of the limit of appeal.[911] There is no appeal from a decision denying a motion for rehearing.[912]

Rule 109 provides for the addition of counts after the interference is declared. Proceedings under this Rule follow the procedure on motions to dissolve,[913] and from a decision granting the motion to add counts no appeal lies, as the opposing party may contest the right of his opponent to make the claims upon final hearing, under the provisions of Rule 130.[914]

908. Computing Scale Co. v. Automatic Scale Co., 119 Off. Gaz. 1586, 26 App. D. C. 238.

909. Sauche v. Electrolibration Co., 4 App. D. C. 453.

910. Pitney v. Smith & Egge, 49 Off. Gaz. 129; Holmes & Holmes v. Coler, 51 Off. Gaz. 1622.

911. Naulty v. Cutler, 126 Off. Gaz. 389; Felsing v. Nelson, 122 Off. Gaz. 1722; Carmichael v. Fox, 104 Off. Gaz. 1656.

912. Naulty v. Cutler, 126 Off. Gaz. 389.

913. Joslyn v. Hulse, 132 Off. Gaz. 844.

914. Leonard v. Pardee, 164 Off. Gaz. 249.

§ 456. Evidence—The burden of proof.

The burden of proof is determined by the order of seniority of the parties, and this order, in time, is determined by the filing dates of the respective applications.[915] Therefore, the party who was the last to file his application in the Patent Office, and who is called the junior party, has the burden of proof as against the party or parties whose filing dates are earlier, even though his application has resulted in the issuance of a patent.[916] The issuance of a patent under such circumstances (i. e., during the pendency of prior applications embodying interfering subject-matter), is necessarily the result of inadvertence on the part of the Patent Office, and it would be manifestly unfair to shift the burden of proof by giving the usual *prima facie* value to the grant of the patent;[917] the junior party in such a case need only establish his priority by a preponderance of evidence.[918]

§ 457. The measure of proof.

As between pending applications, the burden of proof being upon the junior party, in the event of no proofs, the senior party would prevail, the application being *prima facie* evidence of the right of the senior party to prevail in the interference.[919] Evidence being taken, the burden is upon the junior party to establish his superior right by a preponderance of the weight of testimony.[920]

915. Hunter v. Stikeman, 85 Off. Gaz. 610, 13 App. D. C. 214; Smith v. Smith, 136 Off. Gaz. 850, 31 App. D. C. 518.

916. Hunt v. McCaslin, 79 Off. Gaz. 861, 10 App. D. C. 527.

917. Shaffer v. Dolan, 108 Off. Gaz 2146, 23 App. D. C. 79; Cutler v. Leonard, 136 Off. Gaz. 438, 31 App. D. C. 297.

918. Andrews v. Nilson, 123 Off. Gaz. 1667, 27 App. D. C. 451.

919. Funk v. Haines, 100 Off. Gaz. 1764, 20 App. D. C. 285.

920. Huebel v. Bernard, 90 Off. Gaz. 751, 15 App. D. C. 510; Estey v Newton, 86 Off. Gaz. 799, 14 App. D. C. 50.

This burden upon the junior party is increased in weight by the concurring decisions of the several tribunals of the Patent Office (the Examiner of Interferences, Board of Examiners-in-Chief, and Commissioner),[921] and where all of these tribunals have concurred, their unanimity of decision places a very heavy burden (though probably not amounting to proof beyond a reasonable doubt) upon the appellant, when the cause is appealed to the Court of Appeals of the District of Columbia.[922]

Where the junior party is an applicant and the senior a patentee, the burden is upon the junior party to prove his case beyond a reasonable doubt,[923] and this degree of proof rests very heavily upon an applicant as against a patentee, when the applicant's filing date is later than the date of the grant of the patent;[924] especially so, when the applicant testifies that he was induced to file his application by reading the patent.[925]

§ 458. What the judgment determines.

If the interference is between two applicants for patent the decision in favor of one determines the questions of priority of invention, novelty, utility, and patentability in his favor and against the unsuccessful party.[926]

"If the interference is between a patentee and an applicant, a decision in favor of the applicant determines all these points in his favor; but a decision against the

921. Turnbull v. Curtis, 123 Off. Gaz. 2312, 27 App. D. C. 241.

922. Talbot v. Monell, 109 Off. Gaz. 280, 23 App. D. C. 108; In re Adams, 114 Off. Gaz. 2093, 24 App. D. C. 275.

923. Gedge v. Cromwell, 98 Off. Gaz. 1486, 19 App. D. C. 192; Dashiell v. Tasker, 103 Off. Gaz. 2174, 21 App. D. C. 64; Sendelbach v. Gillette, 109 Off. Gaz. 276, 22 App. D. C. 168; Meyer v. Serfert, 102 Off. Gaz. 1555, 21 App. D. C. 26.

924. Gallagher v. Hastings, 103 Off. Gaz. 1165, 21 App. D. C. 88.

925. Kelley v. Flynn, 92 Off. Gaz. 1237, 16 App. D. C. 573.

926. Dickerson v. De La Vergne Refrigerating Mach. Co., 35 Fed. Rep. 143, 146.

applicant does not necessarily determine all these points the other way. Thus, although satisfied that the applicant was in reality the prior inventor, the commissioner may refuse to issue the patent to him, because since the first patent was issued the Patent Office may have become convinced that the subject-matter was not patentable or novel. The statute, which has given him no power to recall an issued patent, has provided for no official action by which he can pronounce it valid or invalid, except that by granting a patent for the same invention to an interfering applicant he decides the invention to be meritorious, but the first patentee not entitled to it."[927]

The doctrine of *res adjudicata* applies generally to decisions of the Patent Office.[928] The declaration of the interference renders all questions *res adjudicata* except that of priority of invention, to the extent that no other question can be considered on an appeal.[929] When a second interference is declared between the same applications on an issue relating to the same subject-matter, the final decision in the first interference renders the question of priority *res adjudicata* unless it appears that the second case raises a question that neither was or could have been raised and determined in the first case;[930] and it is the duty of the tribunal trying the second case to raise the question of *res adjudicata* of its own motion, if it is not raised by a party.[931]

The rulings as to *res adjudicata* just considered have been those of the Patent Office and the Court of Appeals of the District of Columbia.

927. Lacombe, J., in Dickerson v. De La Vergne Refrigerating Mach. Co., 35 Fed. Rep. 143, 146.

928. Blackford v Wilder, 127 Off. Gaz. 1255, 28 App. D. C. 535.

929. Herman v. Fullman, 109 Off. Gaz. 1888, 23 App. D. C. 259.

930. Blackford v. Wilder, 127 Off. Gaz. 1235, 28 App. D. C. 535.

931. Carroll v. Hallwood, 135 Off. Gaz. 896, 31 App. D. C. 165.

Whether the decision of the Patent Office or of that Court of Appeals renders the question of priority *res adjudicata* as between the parties does not appear to be settled. It has been held that the decision of the Commissioner, unappealed from, must be accepted in further litigation between the parties as controlling, in the absence of evidence carrying thorough conviction to the contrary; this rule being announced both in cases under § 4915, R. S. U. S., to compel the grant of a patent,[932] and in suits for infringement brought by the party succeeding in the interference.[933] An admission of priority, consisting in withdrawing from an interference and taking a license from the opposing party, is binding as an estoppel in subsequent litigation.[934]

§ 459. The application of the doctrine of res adjudicata to patent causes.

The splitting up of appellate jurisdiction into nine appellate tribunals has led to much confusion and uncertainty in the adjudication of rights under letters patent. The enormous property values represented by important patents, as well as the natural and proper desire of competent judges to do justice in each particular case, has led the several circuit courts of appeals to give no undue weight to the decisions of each other, while recognizing the propriety of the circuit court following the decision of the court of appeals of another circuit. Thus, in many instances, we find expressions such as the following, which was employed by Judge Coxe in speaking for the Circuit Court of Appeals of the Second Circuit: "The

932. Morgan v. Daniels, 153 U. S. 120, 124, 38 L. Ed. 657; Standard Cartridge Co. v. Peters Cartridge Co., 77 Fed. Rep. 630, 632, 23 C. C. A. 367.

933. R. Thomas & Sons Co. v. Electric Porcelain & Mfg. Co., 111 Fed. Rep. 923, 929.

934. Shoemaker v. Merrow, 61 Fed. Rep. 945, 10 C. C. A. 181.

judge of the Circuit Court naturally and properly followed the decisions of the Circuit Court of Appeals for the seventh Circuit. That decision is entitled to the greatest respect, but we are reluctantly constrained to a different conclusion."[935]

It is only when the former adjudication has the force of an estoppel that the doctrine of *res adjudicata* applies; and the doctrine can never be extended beyond the bounds which have been limited as follows:

"It is well settled that in order to render a matter *res adjudicata*, there must be a concurrence of the four conditions, viz.: (1) identity in the thing sued for; (2) identity of the cause of action; (3) identity of persons and parties to the action; and (4) identity of the quality in the persons for or against whom the claim is made."[936]

Where all of these elements or conditions are found to exist, it makes no difference whether the former decree was by default.[937]

In order to prevent a decree of dismissal from operating as a bar to a subsequent suit upon the same patent between the same parties (assuming that the infringement alleged is identical in both cases), it should contain the recital that the dismissal was without prejudice. "Where words of qualification, such as 'without prejudice,' or other terms indicating a right or privilege to take further legal proceedings on the subject, do not accompany the decree, it is presumed to be rendered on the merits."[938]

935. Eldred v. Kirkland, 130 Fed. Rep. 342, 347, 64 C. C. A. 588; referring to Eldred v. Kessler, 106 Fed. Rep. 509, 45 C. C. A. 454.

936. Lyon v. Perin & Gaff Mfg. Co., 125 U. S. 698, 31 L. Ed. 839.

937. Lyon v. Perin & Gaff Mfg. Co., 125 U. S. 698, 31 L. Ed. 839.

938. Durant v. Essex Co., 74 U. S. (7 Wall.) 107, 109, 19 L. Ed. 154, 156; Lyon v. Perin & Gaff Mfg. Co., 125 U. S. 698, 31 L. Ed. 839.

§ 460. Identity of the issues—How pleaded and proven.

Each of the conditions or elements enumerated in the rule of *res adjudicata* must be separately considered upon its facts and the law applicable to them.

A plea based upon a former decree of dismissal for want of equity is not sufficient as a bar to a later action upon the same patent against the same defendant.

"For the want of equity may have come from a finding that the patent was void, or from a finding that the patent was valid, but not infringed, or from findings of both invalidity and non-infringement. An adjudication that the patent was void would protect defendant against a new attack by plaintiff on the same patent. But an adjudication that defendant was doing something that did not infringe a valid patent would not justify defendant in doing something else that does infringe."[939]

The plea of *res adjudicata* should state with particularity the issues raised, heard, and decided in the former suit, and specify their identity with the subject-matter of the later suit, as to the patent and the acts or devices alleged to infringe it.[940]

Where a complainant in the former case has elected to charge infringement of certain claims, less than all, it would appear proper to treat a judgment or decree against him as a bar to a later suit on other claims of the same patent, against the same defendant, and the same alleged infringing acts or devices, under the general rule that the former adjudication concludes not only what was heard and decided, but all that might have been so disposed of. In speaking of a former adjudication the Supreme Court has said: "It is a finality as to the claim or demand in con-

939. Baker, J., in Robinson v. American Car & Foundry Co., 150 Fed. Rep. 331, 80 C. C. A. 127.

940. Robinson v. American Car & Foundry Co., 159 Fed. Rep. 131, 86 C. C. A. 321.

troversy, concluding parties and those in privity with them, not only as to every matter which was offered and received to sustain or defeat the claim or demand, but as to any other admissible matter which might have been offered for that purpose."[941]

The precise point has not been found to be adjudicated, but under the general rule, the failure of the complainant to assert infringement of any particular claim ought not to subject the defendant to a subsequent suit for infringement of that claim, the alleged infringing matter being identical in both suits.

A general verdict of damages for infringement of a patent containing two claims has been held not conclusive in a subsequent suit between the same parties upon one of those claims. This, upon the general requirement of certainty in an estoppel. Mr. Justice Field said:

"It is undoubtedly settled law that a judgment of a court of competent jurisdiction, upon a question directly involved in one suit, is conclusive as to that question in another suit between the same parties. But to this operation of the judgment it must appear, either upon the face of the record or be shown by extrinsic evidence, that the precise question was raised and determined in the former suit. If there be any uncertainty on this head in the record—as, for example; if it appear that several distinct matters may have been litigated, upon one or more of which the judgment may have passed, without indicating which of them was thus litigated, and upon which the judgment was rendered—the whole subject-matter of the action will be at large, and open to a new contention, unless this uncertainty be removed by extrinsic evidence showing the precise point involved and determined. To

941. Cromwell v. County of Sac, 94 U. S. 351, 352, 24 L. Ed. 195.

apply the judgment, and give effect to the adjudication actually made, when the record leaves the matter in doubt, such evidence is admissible.

"Thus, in the case of the Wash., Alex. & Georgetown Steam Packet Co. v. Sickles, reported in the 24th of Howard, 65 U. S. 333, 16 L. Ed. 650, verdict and judgment for the plaintiff in a prior action against the same defendant on a declaration, containing a special count upon a contract, and the common counts, was held by this court not to be conclusive of the existence and validity of the contract set forth in the special count, because the verdict might have been rendered without reference to that count, and only upon the common counts. Extrinsic evidence showing the fact to have been otherwise was necessary to render the judgment an estoppel upon those points.

"When the same case was before this court the second time, Wash., Alex. & Georgetown Packet Co. v. Sickles (5 Wall.), 72 U. S. 580, 18 L. Ed. 550, the general rule with respect to the conclusiveness of a verdict and judgment in a former suit between the same parties, when the judgment is used in pleading as an estoppel, or is relied upon as evidence, was stated to be substantially this; that, to render the judgment conclusive, it must appear by the record of the prior suit that the particular matter sought to be concluded was necessarily tried or determined; that is. that the verdict in the suit could not have been rendered without deciding that matter, or it must be shown by extrinsic evidence, consistent with the record, that the verdict and judgment necessarily involved the consideration and determination of the matter.

"Tested by these views, the question presented by the plaintiff in this case, upon the effect as evidence of the verdict and judgment in the action at law, is of easy solution. The record of that action does not disclose the nature of the infringement for which damages were re-

covered. The declaration only avers that the plaintiff was the original and first inventor of a new and useful improvement in the preparation of leather, and that he obtained a patent for the same and, on its surrender, a new patent, with an amended specification, without describing with other particularity the nature and operation of the invention; and alleges, as the infringement complained of, that the defendants have made and used the invention, and have caused others to make and use it. The patent contains two claims; one for the use of fat liquor generally in the treatment of leather, and the other for a process of treating bark-tanned lamb or sheep-skin by means of a compound composed and applied in a particular manner. Whether the infringement for which the verdict and judgment passed consisted in the simple use of fat liquor in the treatment of leather, or in the use of the process specified, does not appear from the record. A recovery for an infringement of one claim of the patent is not of itself conclusive of an infringement of the other claim, and there was no extrinsic evidence offered to remove the uncertainty upon the record; it is left to conjecture what was in fact litigated and determined. The verdict may have been for an infringement of the first claim; it may have been for an infringement of the second; it may have been for an infringement of both. The validity of the patent was not necessarily involved, except with respect to the claim which was the basis of the recovery. A patent may be valid as to a single claim and not valid as to the others. The record wants, therefore, that certainty which is essential to its operation as an estoppel, and does not conclude the defendants from contesting the infringement or the validity of the patent in this suit.

"According to Coke an estoppel must 'be certain to every intent;' and if upon the face of a record anything is

left to conjecture as to what was necessarily involved and decided, there is no estoppel in it when pleaded, and nothing conclusive in it when offered as evidence."[942]

§ 461. Interfering patents—The statute.

The statute: § 4918, R. S. U. S. "Whenever there are interfering patents, any person interested in any one of them, or in the working of the invention claimed under either of them, may have relief against the interfering patentee, and all parties interested under him, by suit in equity against the owners of the interfering patent; and the court, on notice to adverse parties, and other due proceedings had according to the course of equity, may adjudge and declare either of the patents void in whole or in part, or inoperative, or invalid in any particular part of the United States, according to the interest of the parties in the patent or the invention patented. But no such judgment or adjudication shall affect the right of any person except the parties to the suit and those deriving title under them subsequent to the rendition of such judgment."

§ 462. The nature of the action.

The procedure indicated by § 4918, R. S. U. S., may be invoked whenever interfering subject-matter exists in two contemporaneous patents. As the action is absolutely dependent upon the existence of the interference, the proceedings will be dismissed whenever it is established that interference in fact is not present.[943]

942. Russell v. Place, 94 U. S. 606-610, 24 L. Ed. 214-215.

943. Putnam v. Hutchinson, 12 Fed. Rep. 131; Morris v. Kempshall Mfg Co., 20 Fed. Rep. 121, 122; Electrical Accumulator Co. v. Brush Electric Co., 44 Fed. Rep. 602, 605; Nathan Mfg. Co. v. Craig, 49 Fed. Rep. 370; Lowry v. Cowles Electric Smelting Co., 56 Fed. Rep. 488; Dederick v. Fox, 56 Fed. Rep. 714; Stonemetz

"It has become well-settled law, that two patents interfere, within the meaning of this section, only when they claim, in whole or in part, the same invention."[944] It is essential that there should be two alleged interfering patents in existence. The action will not lie at the suit of one who is merely an applicant for a patent.[945] A dictum in a Supreme Court opinion, where the answer did not deny, but impliedly admitted, interference in fact, says, "In view of such pleadings, it is hardly necessary to inquire whether there is an interference."[946] This statement is unsound. The point being jurisdictional, it is always the duty of the court to make the inquiry *sua sponte;* the consent of the parties cannot confer jurisdiction. But in another case, it was expressly held that because interference was not denied in the answer, it would not be considered on the hearing;[947] so that if the defendant does not admit, he should expressly deny the allegation of the bill as to interference in fact. This question may be raised by demurrer to the bill; but the demurrer should not be sustained unless the court is satisfied from an inspection of the patents, that it is impossible to sustain the allegation of interference by any evidence possible to be adduced.[948] The bill is demurrable if it fails to allege ownership of the alleged interfering patent by the defendant.[949]

Printers' Mach. Co. v. Brown Mach. Co., 57 Fed. Rep. 601; Norton v. Jensen, 90 Fed. Rep. 415, 33 C. C. A. 141; Mowry v. Whitney, 81 U. S. 434, 440, 20 L. Ed. 858.

944. Colt, J., in Nathan Mfg. Co. v. Craig, 49 Fed. Rep. 370.

945. Hoeltge v. Hoeller, 2 Bond. 386, Fed. Case No. 6574.

946. Garratt v. Seibert, 98 U. S. 75, 25 L. Ed. 84.

947. Gold & Silver Ore Separating Co. v. U. S. Disintegrating Ore Co., 6 Blatchf. 307, Fed. Case No. 5508.

948. Simplex Railway Appliance Co. v. Wands, 115 Fed. Rep. 517, 523, 53 C. C. A. 171.

949. Nathan Mfg. Co. v. Craig, 47 Fed. Rep. 522.

§ 463. What issues may be considered.

The scope of the inquiry in cases brought under § 4918 has led to wide divergence of opinion; some cases holding that interference and priority of invention are the only issues that can be raised or considered in such an action, and that the question of the general patentability of the issue was immaterial and could not be litigated in the proceeding.[950]

This theory was based upon the idea that under § 4918 the court may declare either patent void, but cannot do so as to both.[951] But the better reasoning appears to be to the contrary, and that the court may declare "one or the other, or all, of the patents void or valid,"[952] and the argument of Judge Severens in support of this conclusion is as follows:

"It is agreed by counsel on both sides that the only question which the court has authority to consider and determine is that of the relative priority of the dates of the invention by Palmer and Huss, respectively, although much of the argument of the counsel relates to wider questions. It is said that § 4918, above quoted, was intended to subserve the single purpose of enabling parties to obtain an adjudication of priority of invention covered by interfering patents, with the consequent authority to declare the patent of the later inventor void. Consequently, it is urged, the court has no authority to inquire whether the supposed invention which is the sub-

950. Pentlarge v. Pentlarge, 19 Fed. Rep. 817; Lockwood v. Cleveland, 20 Fed. Rep. 164; Sawyer v. Massey, 25 Fed. Rep. 144; American Clay-Bird Co. v. Ligowski Clay-Pigeon Co., 31 Fed. Rep. 466; Electric Accumulator Co. v. Brush Electric Co., 44 Fed. Rep. 602.

951. American Clay-Bird Co. v. Ligowski Clay Pigeon Co., 31 Fed. Rep. 466.

952. Nixon, J., in Lockwood v. Cleveland, 6 Fed. Rep. 721, 724. To the same effect, see, Foster v. Lindsay, 3 Dillon 126, Fed. Case No. 4976; Palmer Pneumatic Tire Co. v. Lozier, 90 Fed. Rep. 732, 735, 33 C. C. A. 255.

ject of the controversy is patentable or not. It appears from the opinion of the learned judge who decided this in the court below, found in the record, that this construction of the statute was there accepted upon the authority of certain cases cited in the opinion, without any original consideration of the question by him; but we are unable to agree that the court is so rigidly tied down as such a construction of the statute would imply. On the contrary, we think the court is bound to determine whether, upon identifying the subject-matter of the interfering patents, the invention therein stated is patentable. If it is not, and the court should go on and pronounce a decree of nullity against one of the patents, it would do so at the instance of one who has no right to protect, and consequently no standing on which to assail his adversary. The parties would not stand on equal ground in such a litigation, and the power of the court would be perverted to the determination of an unprofitable inquest as to who was the first discoverer of a nullity. The outcome would be that, while one pretender would be dislodged, the other would occupy the field unscathed. We think that if, upon inspection of the patents, or in the course of the investigation it must make in order to determine the nature of the alleged invention, the court should see that the patents are void for lack of patentable subject-matter, it ought not to proceed to an inquiry as to who first discovered the thing which the court finds to be null, and the decree thereon, but should dismiss the bill. Manifestly, it is necessary that the court should know what the invention is which supports the patents, not generally, what the patents are about, but what is the particular discovery for which each of the patents was granted."[953]

953. Palmer Pneumatic Tire Co. v. ›zier, 90 Fed. Rep. 732, 735, 33 C. C. A. 255.

§ 464. The pleadings.

The proceeding, although the creature of § 4918, is strictly equitable and instituted by bill in equity; but the nature of the action makes it an exception to the general rule that the defendant cannot be granted affirmative relief except by cross-bill,[954] although the usual practice is to file a cross-bill praying the cancellation of the patent on which the bill is based.[955] As we have seen, the question of interference in fact may be raised by demurrer,[956] and a failure to plead that the defendant owns the alleged interfering patent may be reached by special demurrer.[957] Objections to allegations in the bill as to an interference between the complainant's assignor and a stranger to the bill, should be raised by exception, and not by demurrer.[958] Where a bill under § 4918 was brought against a defendant who had pending a suit at law against the complainant's licensee, a prayer for preliminary injunction to restrain the prosecution of the law action was denied; but the court based its action upon the fact that both cases were pending in the same court and under its control, and granted an injunction restraining the defendant from prosecuting any other or further suits against "any of the users or dealers with the complainant."[959] Disclaimers filed in the Patent Office by the complainant after the filing of the bill, may be set

954. Lockwood v. Cleveland, 6 Fed. Rep. 721, 724; Electrical Accumulator Co. v. Brush Electric Co., 44 Fed. Rep. 602; Union Paper Bag Mach. Co. v. Crane, 6 Off. Gaz. 801, Fed. Case No. 14,388.

955. Ecaubert v. Appleton, 67 Fed. Rep. 917, 918, 15 C. C. A. 73.

956. Simplex Railway Appliance Co. v. Wauds, 115 Fed. Rep. 517, 523, 53 C. C. A. 171.

957. Nathan Mfg. Co. v. Craig, 47 Fed. Rep. 522.

958. Stonemetz Printers' Mach. Co. v. Brown Folding Mach. Co., 46 Fed. Rep. 72, 73.

959. Palmer Pneumatic Tire Co. v. Lozier, 69 Fed. Rep. 346, 350.

up by supplemental bill,[960] and the assignee *pendente lite* of the patent upon which the bill is based, may be made a party to the suit by an original bill in the nature of a supplemental bill.[961]

As is the rule in suits in equity generally, where the defendant seeks affirmative relief, either by answer alleging the invalidity of the complainant's patent, or by a cross-bill, the complainant will not be permitted to dismiss his bill.[962]

A bill brought under § 4918 may have incorporated therein allegations of infringement and a prayer for injunctive relief. The joinder of causes of action is proper and demurrer will not lie.[963]

§ 465. Relief.

As we have seen, either or all of the patents involved may be held void,[964] and where the pleadings and facts warrant, full injunctive relief will be granted either party to protect the subject-matter of the suit, and to preserve the *status quo* pending the litigation.[965] If the court finds either of the patents involved void, it should decree the annulment of the patent and not merely dismiss the

960. Electrical Accumulator Co. v. Brush Electric Co., 44 Fed. Rep. 602.

961. Ecaubert v. Appleton, 67 Fed. Rep. 917, 15 C. C. A. 73.

962. Electrical Accumulator Co. v. Brush Electric Co., 44 Fed. Rep. 602.

963. Ayling v. Hull, 2 Cliff. 494, Fed. Case No. 686; Leach v. Chandler, 18 Fed. Rep. 262; Swift v. Jenks, 19 Fed. Rep. 642; Holliday v. Pickhardt, 29 Fed. Rep. 853; American Roll Paper Co. v. Knopp, 44 Fed. Rep. 611; Stonemetz Printers' Mach. Co. v. Brown Folding Mach. Co., 46 Fed. Rep. 72.

964. Palmer Pneumatic Tire Co. v. Lozier, 90 Fed. Rep. 732, 33 C. C. A. 255.

965. Potter v. Dixon, 5 Blatchf. 160, Fed. Case No. 11,325; Palmer Pneumatic Tire Co. v. Lozier, 69 Fed. Rep. 346, 350.

bill or enter a judgment against the defendant; and the decree may be for annulment, in part only, of either patent.[966]

§ 466. The proceeding in equity to compel the grant of a patent.

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

"These provisions, while they do not in express terms confer upon the courts of equity of the United States the power to annul or vacate a patent, show very clearly the sense of Congress that if such power is to be exercised anywhere it should be in the equity jurisdiction of those courts. The only authority competent to set a patent aside, or to annul it, or to correct it, for any rea-

966. Foster v. Lindsay, 8 Off. Gaz. 1032, 3 Dill. 126, Fed. Case No. 4976.

son whatever, is vested in the Judicial Department of the Government, and this can only be effected by proper proceedings taken in the Courts of the United States."[967]

This section was not repealed by the Act creating the Court of Appeals of the District of Columbia.[968] This section applies to applications for a reissue as well as to original applications.[969]

§ 467. Nature of the proceeding.

The proceeding under this section is virtually an appeal.[970] "The statute applies primarily to ordinary cases which are heard *ex parte* in the Patent Office, and though the language is broad enough to include a case where there has been a contest, yet it is plainly, an independent, original jurisdiction which is given to the courts."[971] "A bill in equity in a court of the United States, under § 4915, by a party against whom an interference has been decided by the Commissioner of Patents, is a suit within the ordinary jurisdiction in equity of the courts of the United States; the court itself gives notice to adverse parties; the statute contains no provision requiring the case to be heard upon the evidence produced before the Commissioner, or restricting the effect of the decree; and, as has been held in this and other circuits, the court may receive new evidence, and has the same powers as in other cases in equity."[972] "The bill in equity provided for by § 4915 is

967. Mr. Justice Miller, in United States v. American Bell Telephone Co., 128 U. S. 315, 32 L. Ed. 450.

968. Bernardin v. Northall, 77 Fed. Rep. 840.

969. Ingersoll v. Holt, 104 Fed. Rep. 682.

970. Dover v. Greenwood, 177 Fed. Rep. 946, 947; Dover v. Greenwood, 143 Fed. Rep. 136, 138; Bernardin v. Northall, 77 Fed. Rep. 840.

971. Lowell, J., in Whipple v. Miner, 15 Fed. Rep. 117.

972. Mr. Justice Gray, in Butler v. Shaw, 21 Fed. Rep. 321, 326.

wholly different from the proceeding by appeal from the decision of the Commissioner under consideration in this case. The one is in the exercise of original, the other, of appellate, jurisdiction."[973]

Where the Secretary of the Interior, without authority, undertook to reverse the Commissioner of Patents in an interference case, and the defeated party brought mandamus proceedings, in reversing a judgment of the supreme Court of the District of Columbia granting the writ of mandamus, the United States Supreme Court said: "The remedy by bill in equity under § 4915 is not appropriate, because it applies only when the Commissioner decides to reject an application for a patent, on the ground that the applicant is not, on the merits, entitled to it. So that if, in such a case, a decree for a patent could be considered, *ex proprio vigore*, as equivalent to a patent or could be enforced by direct process in execution of it, nevertheless, the present is not a case where such a bill would lie."[974]

When § 4894 provided two years as the limit for amendments after action of the Patent Office "unless it be shown to the satisfaction of the Commissioner of Patents that such delay was unavoidable," it was held by the Supreme Court of the United States that a proceeding by bill in equity under § 4915 was a part of the application for the patent, in which the court would pass upon the question whether the delay was unavoidable, under an allegation to that effect in the bill.[975]

In holding that the decision of the Court of Appeals of the District of Columbia in an interference case did not render the issues *res adjudicata*, Judge Baker said:

973. Mr. Chief Justice Fuller, in re Hien, 166 U. S. 432, 439, 41 L. Ed. 1066.

974. Mr. Justice Matthews, in Butterworth v. United States, 112 U. S. 50, 28 L. Ed. 656.

975. Gandy v. Marble, 122 U. S. 432, 30 L. Ed. 1223.

"The Appellate Court hears and decides an executive or administrative question in aid of the Patent Office on the record made up in that office, while the Circuit Court hears the case upon a bill in equity in due course of judicial procedure, not only on the evidence heard by the Commissioner of Patents and the Court of Appeals, but upon such additional evidence as either party to the suit may choose to present. The trial before the Court of Appeals is restricted, and is in aid of an executive duty, rather than a judicial hearing. The trial in the Circuit Court is in the strictest sense a judicial hearing by original bill, with all the powers of a court of equity at the service of the parties to the suit. The salutary principle that an inventor shall have his day in court, and a right to a judicial hearing, before being finally barred of his right to a patent, secured by § 4915 of the Revised Statutes, in my opinion, remains unaffected by the act to establish the Court of Appeals of the District of Columbia."[976]

Under this section the court has no authority to enjoin the Commissioner of Patents from issuing letters patent to one whom he has adjudged to be entitled thereto; "the prayer of a bill of complaint exhibited to the court under and by virtue of this section would be for a decree that the complainant has established his right to have letters patent issued to him. So far may the decree of this court go, but no further."[977]

§ 468. Pleading.

The bill of complaint will be held good on demurrer unless, for want of proper allegations, it is "an absolutely certain and clear proposition that the bill would be

976. Baker, J., in Bernardin v. Northall, 77 Fed. Rep. 849, 852.

977. Green, J., in Illingworth v. Atha, 42 Fed. Rep. 141, 144.

dismissed at the hearing on the merits.[978] When the bill alleges an invention, it covers the fact of reduction to practice without specific allegation thereof.[979] If it charges falsehood and perjury in the interference record, it should specify the matters to which those charges are addressed.[980] As the inquiry extends to the invention as an entirety sought by the plaintiff to be secured by letters patent, "the bill should fully disclose the facts upon which the invention is claimed, and the particulars of the application for patent."[981] A cross-bill may be filed under this section by the defendant in an interference which resulted in the issuance of the patent in suit.[982] Where, in a suit under this section, the two contending interests unite, the suit is not thereby abated, the Commissioner of Patents being a party.[983]

§ 469. Parties to the bill of complaint.

Where a defendant patentee has assigned his patent, the assignee is a necessary party defendant,[984] and an assignee of an application for patent may bring the bill in his own name,[985] and it is no objection to the bill that the assignment was made after the rejection of the application.[986]

A bill brought by a complainant who had assigned his application for patent, his assignee not joining, will be

978. Prindle v. Brown, 155 Fed. Rep. 531, 533, 84 C. C. A. 45, reversing 136 Fed. Rep. 616.

979. Prindle v. Brown, 155 Fed. Rep. 531, 533, 84 C. C. A. 45, reversing 136 Fed. Rep. 616.

980. Illingsworth v. Atha, 42 Fed. Rep. 141, 143.

981. Morrow, J., in Ingersoll v. Holt, 104 Fed. Rep. 682, 684.

982. Schmertz Wire Glass Co. v. Pittsburg Plate Glass Co., 168 Fed. Rep. 73, 87; Appert v. Brownsville Plate Glass Co., 144 Fed. Rep. 115.

983. Schmertz Wire Glass Co. v. Pittsburg Plate Glass Co., 168 Fed. Rep. 73, 87.

984. Graham v. Teter, 25 Fed. Rep. 555.

985. Gay v. Cornell, 1 Blatchf. 506, Fed. Case No. 5280.

986. Gay v. Cornell, 1 Blatchf. 506, Fed. Case No. 5280.

dismissed on demurrer.[987] The Secretary of the Interior is not a proper party to the bill.[988] The Commissioner of Patents is not a necessary party to the bill if there is an opposing party.[989]

§ 470. Evidence.

The evidence in suits under this section is taken as in other suits in equity. The record of the testimony in the interference case (if there has been an interference) is not admissible without proof that the witnesses are dead or unavoidably absent.[990]

Where an interference has involved the question of the laches of the defeated party, the issue will be disposed of *de novo* in a suit under this section; and where the process and apparatus had been invented, but the inventor delayed applying for patents while making persistent efforts to overcome difficulties, not due to defects in his inventions, but to the material used in their practice, the court held his delay excused, and directed the granting of patents, under his cross-bill.[991]

Upon the death of a party to a suit under this section, the suit may be revived by the suggestion of his death, and the substitution of his executor or administrator as a party; such a revivor is not a new suit, is merely a continuation of the original suit, and is a matter of right.[992]

987. Smith v. Thompson, 177 Fed. Rep. 721.

988. Kirk v. Commissioner of Patents, 37 Off. Gaz. 451.

989. Graham v. Teter, 25 Fed. Rep. 555.

990. Clow v. Baker, 36 Fed. Rep. 692; Stonemetz Printers' Mach. Co. v. Brown Folding Mach. Co., 57 Fed. Rep. 601, 604; Ecaubert v. Appleton, 67 Fed. Rep. 917, 15 C. C. A. 73; Dover v. Greenwood, 177 Fed. Rep. 946.

991. Appert v. Brownsville Plate Glass Co., 144 Fed. Rep. 115, 120.

992. Schmertz Wire-Glass Co. v. Pittsburg Plate Glass Co., 168 Fed. Rep. 73, 87.

Where a bill is brought under this section to obtain the grant of the patent after the application has been abandoned by failure to prosecute the application within the time limited, it must recite that the delay was unavoidable.[993]

§ 471. Costs.

"The last clause of § 4915 of the Revised Statutes, requiring the applicant to pay all the expenses of the proceeding whether the final decision is in his favor or not, is, in manifest intention, if not by unavoidable construction, limited to cases in which there is no opposing party other than the Commissioner of Patents, and in which, therefore, the costs, if not paid by the applicant, would fall upon the Commissioner, and upon the government whose officer he is. Whenever there are opposing parties, as in a contested case of interference, the ordinary rule should be followed, and costs be awarded to the party prevailing."[994]

§ 472. Qui tam actions—Defined.

By *qui tam* actions, those forms of actions at law are meant which are brought under statutes imposing penalties for doing or failing to do a certain act; the name being derived from the Latin "*qui tam*" (who as well), which words were the emphatic words in the Latin form of declaration in an act by an informer for a penalty.

The classification, therefore, relates to actions for the recovery of penalties under statutes which award a part of the penalty to the informer and the other part to the United States, the State, or to some public or charitable fund.[995]

993. Gandy v. Marble, 122 U. S. 432, 30 L. Ed. 1223.

994. Mr. Justice Gray, in Butler v. Shaw, 21 Fed. Rep. 321, 328. To the same effect, see Standard Cartridge Co. v. Peters Cartridge Co., 69 Fed. Rep. 408, 412

995. Anderson Law Dict. p. 27; Bouvier Dict. (Rawle Ed.), Vol. 2, p. 807.

§ 473. The general characteristics of qui tam actions.

Mr. Justice Brewer, on Circuit, has said, referring to an action of this character: "This action is what is known as a *qui tam* action; it is civil in form, but is to recover a penalty imposed by a penal statute, and is therefore, partially at least, criminal in its nature."[996]

Consequently, the Federal Statutes which we are about to consider, and which provide for *qui tam* actions growing out of the false marking of articles as patented, come within the general rules of construction applicable to penal statutes.

"Such penal statutes," in the language of Judge Brown, "are always construed strictly; that is, they are not to be extended to acts which do not clearly come within the plain meaning and ordinary acceptation of the words used. The offense, being created by statute, does not extend, and cannot in such cases be construed by the courts as extending, beyond the fair meaning of the language employed in designating the offense."[997]

And in the language of Judge Betts:

"The language of the statute is to be particularly adhered to in the construction of penal laws, and, when it has a natural and plain meaning, an artificial or forced one is not to be adopted. 1 Bl. Comm. 88; Dwar. St. 707, 711; Van Valkenburgh v. Torrey, 7 Cow. 252. Courts will not give an equitable construction to a penal law, even for the purpose of embracing cases clearly within the mischief intended to be remedied. U. S. v. Sheldon, 2 Wheat. (15 U. S.) 119; Myers v. Foster, 6 Cow. 567; Daggert v. State, 4 Conn. 61. They sedulously limit the action of penal statutes to the precise

996. State ex rel. Barton County v. Kansas City, Ft. S. & G. R. Co., 32 Fed. Rep. 722, 726.

997. Brown, J., in Pentlarge v. Kirby, 19 Fed. Rep. 501, 503.

cases described in them, and reject an interpretation tending to comprehend matters not named by the Legislature, although analogous."[998]

§ 474. The terms of the statute.

The section of the Revised Statutes of the United States which serves as a foundation for *qui tam* actions in relation to a patented article for the use of words in relation to unpatented articles importing that they are patented, forbids three classes of acts.

"§ 4901. (*Penalty for falsely marking or labeling articles as patented.*)

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

"Who, in any manner, marks upon or affixes to any such patented article the word 'patent' or 'patentee,' or the words 'letters-patent,' or any words of like import, with intent to imitate or counterfeit the mark or device of the patentee, without having the license or consent of such patentee or his assigns or legal representatives; or

"Who, in any manner, marks upon or affixes to any unpatented article the word 'patent,' or any word importing that the same is patented, for the purpose of deceiving the public, shall be liable, for every such offense, to a penalty of not less than one hundred dollars, with costs; one-half of said penalty to the person who shall sue for the same, and the other

998. Betts, J., in Ferrett v. Atwill, Fed. Case 4747, 1 Blatchf. 151.

to the use of the United States, to be recovered by suit in any district court of the United States within whose jurisdiction such offense may have been committed."

§ 475. The purpose of the act.

While the section quoted embraces three distinct classes of offenses, they are all of the same kind. It is obviously in accord with the spirit of our patent laws that the public, from whom, in the aggregate, the patent monopoly has been granted to the patentee, shall be advised by an appropriate marking upon the articles made under the patent, that a patent exists and when it will expire. These provisions are embodied in § 4900, R. S. U. S., which is considered elsewhere in this book; and that section itself penalizes the person failing to mark his article patented, to the extent of depriving him from the recovery of damages, except on proof that the defendant received actual notice that he was infringing and continued his infringement after such notice.

The first paragraph of § 4901 is addressed to the protection of the patentee against the use by another of the name of the patentee upon an infringing article. This paragraph refers only to the unlawful use in such connection of the name, or an imitation of the name, of such patentee.

The second paragraph of § 4901 relates to the use of the words "patent" or "patentee" or "Letters Patent" upon an article which is an infringement of a patent owned by another.

The limitation in this paragraph contained in the words "with the intent to imitate or counterfeit the mark or device of the patentee" would appear to be surplusage, unless the words "mark or device of the patentee" be construed to mean the marking required to be made by the patentee under § 4900.

The third paragraph defines the offenses which it prohibits of marking or affixing the word "patented" or word of like meaning, to any unpatented article for the purpose of deceiving the public.

Judge Deady said of this section: "The first two clauses of this section are evidently intended to protect the patentee of a patented article against the fraudulent use of his name or device upon a spurious article, and it is equally manifest that the third clause is intended to protect the public against the fraudulent use of the word 'patent.'"[999]

The purposes of this act have been judicially stated in a number of cases. It has been said that "The statute is made for the protection of the public, and is intended to prevent unscrupulous persons from imposing upon the community by the unauthorized and false use of the word patent."[1]

"To guard the public right to use such articles as have not been patented—to prevent deception on the public, by assertions that articles, not entitled to this privilege, have been patented."[2]

The statute applies to all articles, whether patentable or not. In an early case the opinion was expressed that the statute did not apply to non-patentable articles.[3]

In a later case, Judge Deady criticised the former opinion, stating that the expression was mere obiter and that he was unable to concur with the reasoning or conclusions.[4]

999. Deady, J., in Oliphant v. Salem Flouring Mills Co., Fed. Cas. 10,486, 5 Sawy. 128.

1. Deady, J., in Oliphant v. Salem Flouring Mills Co., Fed. Cas. 10,486, 5 Sawy. 128.

2. Sprague, J., in Nichols v. Newell, Fed Cas. 10,245, 1 Fish. 647.

3. United States v. Morris, Fed. Cas. No. 15,814. 3 Fish. 72.

4. Deady, J., in Oliphant v. Salem Flouring Mills Co., Fed. Cas. 10,486, 5 Sawy. 128.

§ 476. Corporations as parties.

In an early case it was held that neither the United States nor any corporation could be an informer under this statute.[5] But a corporation may be held as a defendant in the proceedings under this statute where the wrongful acts were committed by its superintendent.[6]

§ 477. Contempts—Contempts generally.

The power to preserve its dignity and authority by punishing interference with its proceedings or violation of its orders, is inherent in every court.[7] The power of the Federal courts to punish for contempt was defined in § 725, R. S. U. S.,[8] now repealed, and re-enacted as § 268 of the Judicial Code, chapter 11.

The enforcement of the decree of injunction by punishment for its violation is the form of contempt proceedings with which we are concerned. We will treat the branches of this subject in the orderly manner in which they are encountered in practice.

"The purpose of contempt proceedings is to uphold the power of the court, and also to secure to suitors therein the rights by it awarded."[9]

This distinction divides contempt proceedings into two classes. In the first, the government, the courts and the people are interested; in the second, the party in whose

5. United States v. Morris, Fed. Cas. No. 15,814, 3 Fish. 72.

6. Tomkins v. Butterfield, 25 Fed. Rep. 556.

7. "The power to punish for contempt is inherent in all courts. Its existence is essential to the preservation of order in judicial proceedings, and consequently to the due administration of justice. The moment the courts of the United States were called into existence and vested with jurisdiction over any subject, they become possessed of this power." Ex parte Robinson, 19 Wall. 512, 22 L. Ed. 208.

8. In re Perkins, 100 Fed. Rep. 950, 952.

9. Mr. Chief Justice Fuller, in Bessette v. W. B. Conkey Co., 194 U. S. 324, 327, 43 L. Ed. 997, 1001.

favor the judgment or decree alleged to be violated runs, is the real party in interest.[10]

Contempt proceedings are not the proper method of trying out a new question of infringement. "It is a question which the Circuit (District) Court must decide for itself in the ordinary way. If the judges disagree there can be no judgment of contempt, and the defendant must be discharged. The complainant may then either seek a review of that decision in this (Supreme) Court, or bring a new suit against the defendant for the alleged infringement. The latter method is by far the most appropriate one where it is really a doubtful question whether the new process adopted is an infringement or not. Process of contempt is a severe remedy and should not be resorted to where there is fair ground of doubt as to the wrongfulness of the defendant's conduct."[11]

§ 478. Procedure.

Proceedings to punish a contempt are usually instituted by filing a petition reciting the facts alleged to constitute the contempt, and moving for an attachment for the contemnors. The courts having inherent power to punish in such cases, they have been reluctant to prescribe fixed methods of procedure. But the foregoing is a proper method.[12]

Where the showing thus made is sufficient, a rule to show cause why attachment should not issue is made; this rule must be personally served upon each of the contemnors;[13] where personal service is not had the party will not be committed for contempt.[14]

10. Re Nevitt, 117 Fed. Rep. 448, 458, 54 C. C. A. 622, 632.

11. Mr. Justice Bradley, in California Artificial Stone Paving Co. v. Molitor, 113 U. S 609, 618, 28 L. Ed. 1106, 1109.

12. American Construction Co. v. Jacksonville, T. & K. W. Ry. Co., 52 Fed. Rep. 937, 938.

13. American Construction Co. v. Jacksonville, T. & K. W. Ry. Co., 52 Fed. Rep. 937, 938.

14. Lefavour v. Whitman Shoe Co., 65 Fed. Rep. 785.

§ 479. Who may institute contempt proceedings.

"No one can complain of a violation (of the injunction), unless it be some one who has a present interest in maintaining the injunction, nor unless he was a party to the suit in which the order was obtained, or for some reason stands in privity with one who was a party to the litigation."[15]

§ 480. Against whom contempt proceedings may be instituted.

One not a party to the suit, but who becomes interested in the business of the defendants and bears the expense of the litigation may be punished for contempt in violating an injunctive order entered in the cause.[16] But an injunction running against the defendant, a dealer, and his "manufacturer" (i. e., the maker of the infringing article), is not violated when the same manufacturer sells the same article through other dealers, for he is not then the defendant's manufacturer.[17]

Defendants who, while the case is pending, organize a corporation to carry on the infringing business, are individually liable for contempt in violating the decree,[18] and the corporation itself may be punished for contempt, though not a party to the suit.[19]

§ 481. Defenses.

It may be doubted whether contempt proceedings ought ever to be allowed to dispose of a new question of infringement, not raised in the original case. Naturally, it is difficult to say when the alleged contemnor is attempting to respect, and when he is trying to thwart, the de-

15. Thayer, J., in Secor v. Singleton, 35 Fed. Rep. 376, 378.

16. Stahl v. Ertel, 62 Fed. Rep. 920, 922.

17. United States Playing Card Co. v. Spalding, 92 Fed. Rep. 368.

18. American Graphophone Co. v. Walcutt, 86 Fed. Rep. 468.

19. Bernard v. Frank, 179 Fed. Rep. 516, —— C. C. A. ——.

cree of injunction. He proceeds at his peril, and probably the majority of the courts dealing with patent infringements would entertain an application from a defendant under injunction for advice whether his changed device would escape the charge of contempt.

Where one who was a former employee of an enjoined corporation, and left its employ during the pendency of the suit, and before the injunction, but was served with the injunction, is on his own account practicing a process, as he claims, under a patent of his own, but claimed by the moving affidavits to be within the scope of the decree, the court will decline to dispose of the issue of identity of the processes in a proceeding for contempt.[20]

§ 482. How triable.

Contempt proceedings are *sui generis*. It has been held that the issue presented is exclusively one of law and not of fact, wherefore it is not triable by jury,[21] and that the summary trial of that issue by the court, without the intervention of a jury, is due process of law within the Fourteenth Amendment of the Constitution.[22]

§ 483. Punishment.

Proof that the alleged contemnor acted unintentionally or under the advice of counsel will not be considered in determining whether his acts constitute a contempt, but will be considered as an extenuating circumstance in fixing the punishment.[23]

20. Donaldson v. Roksament Stone Co., 178 Fed. Rep. 103.

21. Interstate Commerce Commission v. Brimson, 154 U. S. 447, 38 L. Ed. 1047.

22. Eilenbecker v. Plymouth County Court, 134 U. S. 31, 33 L. Ed. 801.

23. Atlantic Giant Powder Co. v. Dittmar Powder Mfg. Co., 9 Fed. Rep. 316; Bate Refrigerating Co. v. Gillett, 30 Fed. Rep. 683; Pokegama Sugar Pine Lumber Co. v. Klamath River Lumber Co., 86 Fed. Rep. 316; Queen & Co. v. Green, 170 Fed. Rep. 611.

Where the defendant has changed the form of his machine in an honest belief that he could in that way most expeditiously determine whether the changed machine was within the scope of the decree of injunction, the defendant has been fined a nominal amount,[24] as is usually done when it appears that the contemnor has not acted willfully,[25] but has acted within what he supposed was his right.[26]

A decree entered by consent is of the same force and effect in proceedings for contempt for its alleged violation, as if it were entered in due course after a *bona fide* contest.[27]

It has been held that under § 725, R. S. U. S. (now the Judicial Code, § 268), the court has no power to assess any fine by way of damages or compensation to the plaintiff in the original action.[28] But this ruling appears to be unsupported by any authority. It has been uniformly held that the fine imposed upon the contemnor should be largely measured by the outlay and damage occasioned to the complainant, and should, when collected be paid over to him;[29] and this, even when the act of contempt does not appear to have been willful or defiant.[30] There appears to be no doubt of the absolute discretion of the court, however, to direct the fine, when collected, to be paid to the complainant, or to the United States, or to be divided between them.[31]

24. Westinghouse Electric Mfg. Co. v. Conduit Electrical Co., 173 Fed. Rep. 82.

25. Morss v. Domestic Sewing Machine Co., 38 Fed. Rep. 482.

26. Matthews v. Spangenberg, 15 Fed. Rep. 813.

27. Encyclopedia Brittanica Co. v. Werner Co., 172 Fed. Rep. 1012, 1015.

28. United States v. Atchison, T. & S. F. Ry. Co., 16 Fed. Rep. 853.

29. Wells, Fargo & Co. v. Oregon Ry. & Nav. Co., 19 Fed. Rep. 20; In re North Bloomfield Gravel Min. Co., 27 Fed. Rep. 795.

30. Matthews v. Spangenberg, 15 Fed. Rep. 813.

31. Westinghouse Electric Mfg. Co. v. Conduit Electrical Co., 173 Fed. Rep. 82.

§ 484. Appellate review of contempt proceedings.

It would appear, save for the sporadic holding to the contrary to which we will refer, that there can be no review in the Supreme Court, by appeal or writ of error, of convictions in contempt proceedings. It was specifically held in one case by the Supreme Court that "contempt of court is a specific criminal offense. The imposition of the fine was a judgment in a criminal case. That part of the decree is as distinct from the residue as if it were a judgment upon an indictment for perjury committed in a deposition had at the hearing." Hence that court refused to review the order imposing a fine for contempt committed during the pendency of the case in the court below, upon an appeal from the final decree.[32]

And the Supreme Court has repeatedly said that "judgments in proceedings in contempt are not reviewable here on appeal or error."[33] Such, save for the case to which we will now advert, is the settled law. Worden v. Searls was a suit in equity for patent infringement. There was a preliminary injunction issued by the Circuit Court July 19, 1880, and a perpetual injunction on February 24, 1882. On March 6, 1882, the defendants were fined $250 for a violation of the preliminary injunction. This order was opened for further hearing on April 29, 1882, and October 9, 1882, a fine of $1182 was imposed for the violation of the preliminary injunction, to be paid to the clerk, "And by him to be paid over to the plaintiff for damages and costs, the defendants to

32. New Orleans v. New York Mail Steamship Co., 87 U. S. 387, 22 L. Ed. 354.

33. Mr. Chief Justice Fuller, in Ex parte Chetwood, 165 U. S. 443, 462, 41 L. Ed. 782, 788; citing, Hayes v. Fischer, 102 U. S. 212, 26 L. Ed. 95; Re Debs, 158 U. S. 573, 39 L. Ed. 1095. To the same effect, see, Ex parte Fisk, 113 U. S. 713, 718, 28 L. Ed. 1117, 1119.

stand committed until the same should be paid." (13 Fed. Rep. 716.) The defendants were allowed an appeal from this order, and proceedings to collect the fine were stayed until the further order of the court. The cause went through an accounting, a final decree entered on the master's report, and an appeal from that final decree brought the cause to the Supreme Court, where the case was reversed upon the merits, and the Circuit Court directed to dismiss the bill. As to the fines imposed for contempt, the orders of March 6, 1882 and October 9, 1882, were reversed, and all these orders were "without prejudice to the power and right of the Circuit Court to punish the contempt referred to in those orders, by a proper proceeding."

The Supreme Court distinguishes this case, and takes it out of the general rule, by saying "though the proceedings were nominally those of contempt, they were really proceedings to award damages to the plaintiff, and to reimburse to him his expenses."[34] We confess that this appears to be a distinction without much difference. The Circuit Court had it in its discretion to assess the sum it did assess, as a fine. The amount of the fine could not alter that legal rule. It had it within its discretion to direct the fines to be paid the plaintiff; the Supreme Court's opinion says, "we say nothing as to the lawfulness or propriety of this direction." But, the Supreme Court points out, the fines "were measured by the damages the plaintiff had sustained and the expenses he had incurred;" and it is upon this point that both contempt orders were reversed, although the order of March 6, 1882, made no reference to the plaintiff's expenses or damages, and so far as the Supreme Court's reversal of the facts disclosed, was assessed purely as a

34. Worden v. Searls, 121 U. S. 14, 30 L. Ed. 853.

fine, and without reference to or any testimony about the plaintiff's expenses or damages. It appears from the opinion that the order of March 6, 1882, was not superseded by the order of October 9, 1882, and they were separately and specifically reversed by the Supreme Court's order.

This extended consideration has been given Worden v. Searls because it is believed to be at variance with a settled line of decisions beginning long before it and extending down to the present time, and because, by the unwarranted consideration and reversal of the order of March 6, 1882, it has self-contained evidence that it was not produced with that deliberation and care which ought to characterize the opinions of Supreme Court.

We conclude, that Worden v. Searls is not in harmony with the Debs case and the long line of cases of which it is typical; and that our view of the doctrine of those cases is that the language of an order imposing a fine for contempt ought not to render that order reviewable by the Supreme Court on appeal or error. As Mr. Chief Justice Fuller has pointed out, judgments in contempt proceedings "may be reached for review by the Supreme Court by *certiorari* in the absence of any other adequate remedy,"[35] and they may be reached by *habeas corpus*.[36]

But while we conclude that the right of review of contempt proceedings in the Supreme Court by appeal or error, never existed,[37] the establishment of the Circuit Courts of Appeals by the Act of March 3, 1891 (26 Stat. at L. 826, chap. 517, U. S. Comp. Stat. 1901, p. 547), now the Judicial Code, chapter 6, by giving those courts final jurisdiction "in all cases arising * * * under the crimi-

35. Ex parte Chetwood, 165 U. S. 443, 462, 41 L. Ed. 782, 788.

36. Re Watts, 190 U. S. 1, 47 L. Ed. 933.

37. Bessette v. W. B. Conkey Co., 194 U. S. 324, 335, 48 L. Ed. 997, 1005.

nal laws'' (§ 6) conferred upon them appellate jurisdiction by writ of error in all criminal cases, including cases of contempt; although the decision of the Supreme Court so holding, is expressly limited to ''cases in which the proceedings are against one not a party to the suit, and cannot be regarded as interlocutory.'' Of course on review by writ of error only matters of law can be considered, and the decision of the court below as to the facts is conclusive.[38]

§ 485. Assignment of errors.

Rule 11 of each of the Circuit Courts of Appeal provides:

''The plaintiff in error or appellant shall file with the clerk of the court below, with his petition for the writ of error or appeal, an assignment of errors, which shall set out separately and particularly each error asserted and intended to be urged. No writ of error or appeal shall be allowed until such assignment of errors shall have been filed. When the error alleged is to the admission or to the rejection of evidence, the assignment of errors shall quote the full substance of the evidence admitted or rejected. When the error alleged is to the charge of the court, the assignment of errors shall set out the part referred to *totidem verbis*, whether it be in instructions given or in instructions refused. Such assignment of errors shall form part of the transcript of the record and be printed with it. When this is not done, counsel will not be heard, except at the request of the court; and errors not assigned according to this rule will be disregarded, but the court, at its option, may notice a plain error not assigned.''

38. Bessette v. W. B. Conkey Co., 194 U. S. 324, 338, 48 L. Ed. 997, 1006.

The asignment of errors must neither be vague nor indefinite, and it must be specific. Thus, the assignment as error that "the court erred in sustaining the Master's report to any extent, and in not overruling it altogether," is too indefinite and will not be considered on appeal. "This rule was prescribed as well for the benefit of the adverse party in preparing his case for hearing as for the convenience of the court in its examination of the record and disposition of the questions presented."[39]

An assignment of error "founded upon an expression in the opinion of the judge, and not upon anything contained in the decree," is not proper and will not be considered on appeal.[40]

§ 486. Appellate jurisdiction of the United States Circuit Courts of Appeals.

It was provided by § 6 of the Act of March 3, 1891, 26 Stat. at L. 828: "That the Circuit Courts of Appeals established by this act shall exercise appellate jurisdiction to review by appeal or by writ of error final decision in the district court and in the existing Circuit Courts in all cases other than those provided for in the preceding section of this act (Clause 1 of § 5 providing for appeals or writs of error direct to the Supreme Court "In any case in which the jurisdiction of the court is in issue; in such cases the question of jurisdiction alone shall be certified to the Supreme Court from the court be-

39. P. P. Mast & Co. v. Superior Drill Co., 154 Fed. Rep. 45, 50, 83 C. C. A. 157. To the same effect, see, Deering Harvester Co. v. Kelly, 103 Fed. Rep. 261, 43 C. C. A. 225; Rhode Island Locomotive Works v. Continental Trust Co., 108 Fed. Rep. 5, 9, 47 C. C. A. 147; Chandler v. Pomeroy, 96 Fed. Rep. 156, 37 C. C. A. 430; McFarlane v. Golling, 76 Fed. Rep. 23, 22 C. C. A. 23; Smith v. Hopkins, 120 Fed. Rep. 921, 57 C. C. A. 193; United States v. Lee Yen Tai, 113 Fed. Rep. 465, 51 C. C. A. 299.

40. P. P. Mast & Co. v. Superior Drill Co., 154 Fed. Rep. 45, 50, 83 C. C. A. 157.

low for decision"), unless otherwise provided by law, and the judgments or decrees of the Circuit Courts of Appeals shall be final in all cases in which the jurisdiction is dependent entirely upon the opposite parties to the suit or controversy, being aliens and citizens of the United States or citizens of different States; also in all cases arising under the patent laws, under the revenue laws, and under the criminal laws and in admiralty cases, excepting that in every such subject within its appellate jurisdiction the Circuit Court of Appeals at any time may certify to the Supreme Court of the United States any questions or propositions of law concerning which it desires the instruction of that court for its proper decision. And thereupon the Supreme Court may either give its instruction on the questions and propositions certified to it, which shall be binding upon the Circuit Courts of Appeals in such case, or it may require that the whole record and cause may be sent up to it for its consideration, and thereupon shall decide the whole matter in controversy in the same manner as if it had been brought there for review by writ of error or appeal.

"And excepting also that in any such case as is hereinbefore made final in the Circuit Court of Appeals it shall be competent for the Supreme Court to require, by *certiorari*, or otherwise, any such case to be certified to the Supreme Court for its review and determination with the same power and authority in the case as if it had been carried by appeal or writ of error to the Supreme Court.

"In all cases not hereinbefore, in this section, made final there shall be of right an appeal or writ of error or review of the case by the Supreme Court of the United States where the matter in controversy shall exceed one thousand dollars beside costs. But no such appeal shall be taken or writ of error sued out unless within one year after the entry of the order, judgment, or decree sought to be reviewed." So far as patent causes are concerned,

these provisions are preserved in the Judicial Code. §§ 128, 238, 239, 240, 241.

The history of the reasons why appeal does not lie except from a final decree, by analogy to the practice under writs of error, is given by Judge Putnam in a well-considered opinion.[41] In fixing the finality of the decree appealed from, it has been determined that a complainant has no right of appeal from a decree dismissing the bill with reference to certain claims of the patent or patents in suit, when other claims were found valid and infringed, and a reference ordered as to them. In such a case, Judge Severens said: "It is further contended that, as the decree finally disposes of the first claim of the patent, an appeal would lie independently of the statute. But as that part of the decree did not finally dispose of the whole case, which was retained for the purpose of an accounting upon the claims held valid, the right to appeal from the dismissal of the bill as to the first claim would be suspended until the final decree, when that action and any other which might be prejudicial could be brought up on one appeal. The other course would sanction the bringing up of a case 'piecemeal.' In thus holding we are in agreement with the opinion of the Circuit Court of Appeals for the First Circuit in Marden v. Campbell Printing Press Co., 67 Fed. Rep. 809, 15 C. C. A. 26."[42]

The same character of appeal lies to the Court of Appeals of the District of Columbia from the final decrees of the Supreme Court of the District of Columbia.[43]

41. Marden v. Campbell Printing Press & Mfg. Co, 67 Fed. Rep. 809, 15 C. C. A. 26. For an exhaustive discussion of the finality of decrees, examine the majority and dissenting opinions in Standard Elevator Co. v. Crane Elevator Co., 76 Fed. Rep. 767, 793, 22 C. C. A. 549.

42. Western Electric Co. v. Williams-Abbott Electric Co., 108 Fed. Rep. 952, 957, 48 C. C. A. 159.

43. Whitson v. Columbia Phonograph Co., 18 App. D. C. 565, 98 Off. Gaz. 418.

§ 487. Appeals from interlocutory orders granting, refusing or dissolving injunctions.

Section 7 of the Act of March 3, 1891, 30 Stat. at L. 660, provided (the section being a substitute for § 7 as originally enacted): "That where, upon a hearing in equity in a District Court or in a Circuit Court, or by a judge thereof in vacation, an injunction shall be granted or continued or a receiver appointed, by an interlocutory order or decree, in a cause in which an appeal from a final decree may be taken under the provisions of this Act to the Circuit Court of Appeals, an appeal may be taken from such interlocutory order or decree granting or continuing such injunction or appointing such receiver to the Circuit Court of Appeals: *Provided,* That the appeal must be taken within thirty days from the entry of such order or decree, and it shall take precedence in the Appellate Court; and the proceedings in other respects in the court below shall not be stayed unless otherwise ordered by that court, or by the Appellate Court or a judge thereof, during the pendency of such appeal: *Provided further,* That the court below may in its discretion require as a condition of the appeal an additional bond."

As to appeals under this section the Supreme Court has ruled as follows: "The provision of § 7 of the Act of 1891, that where 'upon a hearing in equity' in a Circuit Court 'an injunction shall be granted or continued by an interlocutory order or decree,' in a cause in which an appeal from a final decree might be taken to the Circuit Court of Appeals, 'an appeal may be taken from such interlocutory order or decree granting or continuing such injunction' to that court, authorizes, according to its grammatical construction and actual meaning, an appeal to be taken from the whole of such interlocutory order or decree, and not from that part of it only which grants or

continues an injunction. The manifest intent of this provision read in the light of the previous practice in the courts of the United States, contrasted with the practice in courts of equity of the highest authority elsewhere, appears to this court to have been not only to permit the defendant to obtain immediate relief from an injunction, the continuance of which throughout the progress of the cause might seriously affect his interests, but also to save both parties from the expense of further litigation, should the Appellate Court be of opinion that the plaintiff was not entitled to an injunction because his bill had no equity to support it.

"The power of the Appellate Court over the cause, of which it has acquired jurisdiction by the appeal from the interlocutory decree, is not affected by the authority of the court appealed from, recognized in the last clause of the section, and often exercised by other courts of chancery, to take further proceedings in the cause, unless in its discretion it orders them to be stayed pending the appeal."[44]

The right of appeal has been extended to orders refusing or dissolving an injunction by The Judicial Code as follows:

Sec. 129. "Where upon a hearing in equity in a district court, or by a judge thereof in vacation, an injunction shall be granted, continued, refused, or dissolved by an interlocutory order or decree, or an application to dissolve an injunction shall be refused, or an interlocutory order or decree shall be made appointing a receiver, an appeal may be taken from such interlocutory order or decree granting, continuing, refusing, dissolving, or refusing to dissolve, an injunction, or appointing a re-

44. Mr. Justice Gray, in Smith v. Vulcan Iron Works, 165 U. S. 518, 525, 41 L. Ed. 810, 812.

ceiver, to the Circuit Court of Appeals, notwithstanding an appeal in such case might, upon final decree under the statutes regulating the same, be taken directly to the Supreme Court: *Provided,* That the appeal must be taken within thirty days from the entry of such order or decree, and it shall take precedence in the Appellate Court; and the proceedings in other respects in the court below shall not be stayed unless otherwise ordered by that court, or the Appellate Court, or a judge thereof, during the pendency of such appeal: *Provided, however,* That the court below may, in its discretion, require as a condition of the appeal an additional bond."

§ 488. Appellate jurisdiction of the Supreme Court.

Prior to the creation of the Circuit Courts of Appeals (Act of March 3, 1891, c. 517, 26 Stat. at L. 826), appeals in patent causes were taken directly to the Supreme Court from the Circuit and District Courts of the United States, under § 690, R. S. U. S.

By § 6 of the Circuit Court of Appeals Act it was provided that "the judgments or decrees of the Circuit Courts of Appeals shall be final * * * in all cases arising under the patent laws." U. S. Comp. Stat., p. 550. The provision now exists as § 128 of the Judicial Code.

The appellate jurisdiction of the Supreme Court being thus terminated, as to patent cases, there were left but two sources of jurisdiction in patent causes in that court, which are expressed in the exceptions named in § 6 of the Circuit Court of Appeals Act, as follows:

"Excepting that in every such subject within its appellate jurisdiction the Circuit Court of Appeals at any time may certify to the Supreme Court of the United States any questions or propositions of law concerning which it desires the instruction of that court for its proper decision. And thereupon the Supreme Court may either give its instruction on the questions and propositions certified to it, which shall be binding upon the Cir-

cuit Courts of Appeals, in such case, or it may require that the whole record and cause may be sent up to it for its consideration, and thereupon shall decide the whole matter in controversy in the same manner as if it had been brought there for review by writ of error or appeal. And excepting also that in any such case as is herein-before made final in the Circuit Court of Appeals it shall be competent for the Supreme Court to require, by *certiorari* or otherwise, any such case to be certified to the Supreme Court for its review and determination with the same power and authority in the case as if it had been carried by appeal or writ of error to the Supreme Court."

These provisions have been preserved in The Judicial Code, § 239.

Where an appeal in any case, however, brings the jurisdiction of the *nisi prius* court directly in question, the Circuit Court of Appeals is without jurisdiction to entertain the appeal, which lies directly to the Supreme Court. Thus Judge Bradford has said: "From a final decree of a Circuit or District Court on a question of jurisdiction, whether of the cause or of the person, the appeal lies directly to the Supreme Court, and this court is without jurisdiction to entertain it."[45]

Appeals from judgments at law.

The fundamental rule governing appellate review of actions at law is that only questions of law may be examined; the questions of fact being concluded by the verdict and judgment of the lower court.[46] But in patent cases, where the appellate court determines that it is

45. L. E. Waterman Co. v. Parker Pen Co., 107 Fed. Rep. 141, 143, 46 C. C. A. 203; citing, Shepard v. Adams, 168 U. S. 618, 42 L. Ed. 602.

46. Hecker v. Fowler, 69 U. S. (2 Wall.) 123, 17 L. Ed. 759.

apparent from the face of the patent that extrinsic evidence is not needed to explain the terms of art employed in the specification, and that it is able, from mere comparison, to determine whether the defendant's acts amount to infringement, "the question of infringement or no infringement is one of law" and subject to appellate review.[47]

The only court from which a judgment at law could heretofore be taken to the United States Supreme Court for review on writ of error was the Court of Appeals of the District of Columbia,[48] but this law was repealed by § 250 of The Judicial Code. Actions at law are finally determinable by that court and the Circuit Courts of Appeals,[49] subject to the right of those courts to certify questions of law to the Supreme Court, and subject to the power of the Supreme Court to issue the writ of *certiorari*.[50] But where the writ of *certiorari* issues, it seems to be styled by the Supreme Court itself a "writ of error."[51]

§ 489. Certiorari.

The writ of *certiorari*, at least as applied to patent causes, is granted very seldom by the Supreme Court; the percentage of applications granted is small, and fluctuates but slightly from term to term. Whether such applications are, in theory or practice, assigned to the several Justices of that court, or considered only by the

47. Heald v. Rice, 104 U. S. 737, 26 L. Ed. 910; Market Street Cable R. Co. v. Rowley, 155 U. S. 621, 625, 39 L. Ed. 284, 287; Singer Mfg. Co. v. Cramer, 192 U. S. 265, 275, 48 L. Ed. 437, 444.

48. 27 Stat. at L., ch. 74, § 8, p. 436.

49. 26 Stat. at L., ch. 517, § 6.

50. 26 Stat. at L., ch. 517, § 6.

51. Note the language of the opinion of Mr. Justice White, in Singer Mfg. Co. v. Cramer, 192 U. S. 265, at page 275, 48 L. Ed. 437, 444. To the same effect, see, Harris v. Barber, 129 U. S. 366, 32 L. Ed. 697.

Chief Justice, is a question that has been frequently raised but never answered. The peculiar administration of the writ is one of the anomalies of the law. Its issuance is presumably determined by the general rules to which we are about to refer, but in practice it is refused or granted without apparent regard to any rules. Its issuance being entirely discretionary, and each writ issued being a direct addition to the labors of a court which is already overburdened with the most difficult and important judicial labors, it cannot be wondered at that the writ is granted sparingly.

The writ of *certiorari*, then, is not a writ of right, but is discretionary with the court.[52] It is in the nature of a writ of error,[53] and is referred to by the Supreme Court, in cases brought before it by *certiorari*, as a "writ of error."[54]

The general rule is that the writ of *certiorari* cannot be employed when there is any other equally adequate remedy.[55]

That the final judgments or decrees of the Circuit Court of Appeals may be reviewed on *certiorari* by the Supreme Court was expressly provided by the Judiciary Act of March 3, 1891 (26 Stat. at L. 826, c. 517), and has been expressly ruled by the higher court;[56] the provision is now to be found as § 240 of The Judicial Code, § 251 making similar provisions as to the final judgments and decrees of the Court of Appeals of the District of Columbia.

52. Re Hitz, 111 U. S. 766, 28 L. Ed. 592.

53. Harris v. Barber, 129 U. S. 366, 32 L. Ed. 697. See editorial note, "Certiorari in United States Courts," 17 L. Ed. 69.

54. Singer Mfg. Co. v. Cramer, 192 U. S. 265, 275, 48 L. Ed. 437, 444.

55. Re Tampa Suburban R. Co., 168 U. S. 583, 42 L. Ed. 589.

56. Mueller v. Nugent, 184 U. S. 1, 46 L. Ed. 405; Louisville Trust Co. v. Cominger, 184 U. S. 18, 46 L. Ed. 413.

The writ is properly employed by the Supreme Court to review judgments in contempt proceedings where no other adequate remedy exists.[57] Aside from this, that court has said that its power to issue the writ will be exercised but sparingly, and then only where its issuance is demanded by the importance of the question involved, the necessity of avoiding conflict between two or more Courts of Appeals, or between Courts of Appeals and the courts of a State, or some matter affecting the interest of the nation in its internal or external relations.[58] It can only be employed to review a final judgment, as to the Circuit Courts of Appeals,[59] and cannot properly be issued to review a decree of that court upon an appeal from an interlocutory decree, unless under unusual circumstances, and to prevent extraordinary embarrassment and inconvenience in the conduct of the cause.[60]

Certiorari is the proper method for the review of a decision of the Circuit Court of Appeals dismissing for want of jurisdiction an appeal in a case within the classes of cases in which that court is given final jurisdiction by the Judiciary Act of March 3, 1891.[61]

Under extraordinary circumstances the writ will be issued in advance of the final decree of the Circuit Court of Appeals.[62]

There is no rule or statute governing the time, after the final decree of the Circuit Court of Appeals, within which the writ must be applied for. It should be sought

57. Re Chetwood, 165 U. S. 443, 41 L. Ed. 782.

58. Forsythe v. Hammond, 166 U. S. 506, 41 L. Ed. 1095; Parsons v. Chicago & N. W. R. Co., 167 U. S. 454, 42 L. Ed. 234.

59. Chicago & N. W. R. Co. v. Osborne, 146 U. S. 354, 36 L. Ed. 1002.

60. American Constr. Co. v. Jacksonville, T. & K. W. R. Co., 148 U. S. 372, 37 L. Ed. 486.

61. Kingman & Co. v. Western Mfg. Co., 170 U. S. 675, 42 L. Ed. 1192.

62. Forsythe v. Hammond, 166 U. S. 506, 41 L. Ed. 1095; Harriman v. Northern Securities Co., 197 U. S. 244, 49 L. Ed. 739.

with reasonable diligence, and a petition filed within one year has been held to be timely.[63]

As to the practice in applications for *certiorari*, the clerk of the Supreme Court has issued the following circular letter of instructions:

INSTRUCTIONS AS TO APPLICATIONS FOR WRITS OF CERTIORARI UNDER ACT OF MARCH 3, 1891.

The following are the requirements on applications for writs of *certiorari* under the act of March 3, 1891:

Petitions are docketed in this court as

————————, Petitioner, *vs.* ————————, Respondent.

Before the petition will be docketed there must be furnished this office:

1. An original petition, with written signature of counsel.

2. A certified copy of the transcript of the record, including all proceedings in the Circuit Court of Appeals.

3. An appearance of counsel for petitioner, signed by a member of the bar of this court.

4. A deposit of $25 on account of costs.

Before submission of the petition there must be furnished:

1. Proof of service of notice of date fixed for submission and of copies of petition and brief upon counsel for the respondent. About two weeks' notice should be given.

2. Twenty-five printed copies of the petition.

3. Twenty-five printed copies of brief in support of petition, if any such brief is to be filed.

4. At least nine uncertified copies of record, which must contain all the proceedings in the Circuit Court of

63. The Conqueror, 166 U. S. 110, 41 L. Ed. 937.

Appeals. These copies may be made up by using copies of the record as printed for the Circuit Court of Appeals and adding thereto printed copies of the proceedings in that court. If a sufficient number of records thus made up cannot be obtained, making it necessary to reprint the record for use on the hearing of the petition, fifty copies must be printed under my supervision, in order that, should the petition be granted, there may be a sufficient number for use on the final hearing.

Monday being motion day, some Monday must be fixed upon for the submission of the petition. No oral argument is permitted on such petitions, but they must be called up and submitted in open court by counsel for petitioner, or by some attorney in his behalf.

All papers in the case must be filed not later than the Saturday preceding the Monday fixed for the submission of the petition.

JAMES H. MCKENNEY,
Clerk of the Supreme Court of United States.

§ 490. Certification of questions to the Supreme Court.

§ 6 of the Judiciary Act of March 3, 1891 (26 Stat. at L. 826, Ch. 517) provides in part that "the judgments or decrees of the Circuit Courts of Appeals shall be final in all cases in which the jurisdiction is dependent entirely upon the opposite parties to the suit or controversy being aliens and citizens of the United States or citizens of different States; also in all cases arising under the patent laws, under the revenue laws, and under the criminal laws, and in admiralty cases, excepting that in every such subject within its appellate jurisdiction the Circuit Court of Appeals at any time may certify to the Supreme Court of the United States any questions or propositions of law concerning which it desires the instruction of that court for its proper decision. And thereupon the Supreme Court may either give its instruction on the ques-

tions and propositions certified to it, which shall be binding upon the Circuit Courts of Appeals in such case, or it may require that the whole record and cause may be sent up to it for its consideration, and thereupon shall decide the whole matter in controversy in the same manner as if it had been brought there for review by writ of error or appeal.

Under this provision the Supreme Court has adopted the following rule:

"37. CASES FROM CIRCUIT COURTS OF APPEALS.

"1. Where, under section 6 of the said act, a Circuit Court of Appeals shall certify to this court a question or proposition of law, concerning which it desires the instruction of this court for its proper decision, the certificate shall contain a proper statement of the facts on which such question or proposition of law arises.

"2. If application is thereupon made to this court that the whole record and cause may be sent up to it for its consideration, the party making such application shall, as a part thereof, furnish this court with a certified copy of the whole of said record.

"3. Where application is made to this court under section 6 of the said act to require a case to be certified to it for its review and determination, a certified copy of the entire record of the case in the Circuit Court of Appeals shall be furnished to this court by the applicant, as a part of the application."

Questions certified under this provision must present a distinct point or proposition of law, and must not require the Supreme Court to practically determine whether the judgment or decree of the trial court should be affirmed or reversed, and should not involve an examination of the entire record.[64]

64. Felsenheld v. United States, 186 U. S. 126, 46 L. Ed. 1085; Graver v. Faurot, 162 U. S. 435, 40 L. Ed. 1030.

The Circuit Court of Appeals may certify the question of the jurisdiction of the trial court, even when that question was not raised or placed in issue in the trial court.[65]

Where the questions of law certified involve separate and distinct propositions of law in their determination, and which are not referred to in the certificate, the certificate will be dismissed.[66]

Such a certificate is irregular and will not be considered when a quorum does not sit in the case in the Circuit Court of Appeals. This rule being made when it appeared that of three judges sitting, one was unwilling, and another disqualified, to sit upon the final hearing and determination of the appeal.[67]

The certificate must contain a statement of the facts upon which the questions certified arise,[68] and the certificate must show that the instruction of the Supreme Court is desired upon the questions certified.[69]

§ 491. The mandate—Definition and function.

Upon the entry of the decree of the Circuit Court of Appeals, and the disposition of the motion for rehearing, if there is one, or the lapsing of the time within which a petition for rehearing may be filed, the mandate of that court issues automatically, addressed to the court below and directing the affirmance, reversal, or modification of its judgment or decree. Sometimes, but rarely, the issuance of the mandate will be stayed upon the application of the defeated party, accompanied by the declaration

65. United States v. Jahn, 155 U. S. 109, 39 L. Ed. 87.

66. Cross v. Evans, 167 U. S. 60, 64, 42 L. Ed. 77, 78.

67. Cincinnati, Hamilton & D. R. Co. v. McKeen, 149 U. S. 259, 37 L. Ed. 725.

68. Cincinnati, Hamilton & D. R. Co. v. McKeen, 149 U. S. 259, 37 L. Ed. 725; Emsheimer v. New Orleans, 186 U. S. 33, 46 L. Ed. 1042.

69. Columbus Watch Co. v. Robbins, 148 U. S. 266, 37 L. Ed. 445.

of the intention of that party to present an application for *certiorari* to the Supreme Court. When an order staying the issuance of the mandate is made, it is usually conditioned upon the moving party presenting his petition for *certiorari* to the Supreme Court within a time fixed in the order.[70]

The mandates of the Supreme Court issue as of course after the expiration of thirty days from the day the judgment or decree is entered, unless the time is enlarged by order of the court, or of a justice thereof when the court is not in session, but during the term. (Rule 39.)

§ 492. To what court addressed.

The mandate of the Supreme Court, in a case brought from the Circuit Court of Appeals, will go to the *nisi prius* court; it is immaterial that the Circuit Court of Appeals had issued a prior mandate to the lower court.[71] In cases from the State courts, the mandate may go either to the appellate court of that State, or the inferior court (of record) in which is the judgment affected by the mandate.[72]

§ 493. Scope.

The scope of the mandate is practically unlimited. It has been used to permit the parties to amend their pleadings generally,[73] to amend the pleadings to show diverse citizenship,[74] to bring in new parties,[75] to reverse an un-

70. Means v. Dowd, 128 U. S. 583, 32 L. Ed. 578.

71. Louisville & N. R. Co. v. Behlmer, 169 U. S. 644, 42 L. Ed. 889.

72. Williams v. Bruffy, 102 U. S. 248, 26 L. Ed. 135.

73. Goodman v. Niblack, 102 U. S. 556, 26 L. Ed. 229.

74. Stuart v. Easton, 156 U. S. 46, 39 L. Ed. 341.

75. Lewis v. Darling, 16 Howard 1, 14 L. Ed. 819.

qualified decree of dismissal for want of jurisdiction and direct the entry of a decree of dismissal without prejudice.[76]

§ 494. Form.

"It is unnecessary in the mandate to make recitation of every step in the various stages of the cause."[77] On appeal from an interlocutory decree granting an injunction and directing an account to be taken, the mandate, on affirmance, "will simply recite that the court finds no error in the decree awarding an injunction."[78]

But under this form of mandate, the Circuit Court has no power to dissolve, modify or suspend the injunction.[79]

§ 495. The construction and effect of the mandate.

In a comprehensive opinion upon the interpretation of the mandate, and its effect in the court below, Mr. Justice Gray has said:

"When a case has been once decided by this court on appeal and remanded to the Circuit Court, whatever was before this court, and disposed of by its decree, is considered as finally settled. The Circuit Court is bound by the decree as the law of the case; and must carry it into execution, according to the mandate. That court cannot vary it or examine it for any other purpose than execution; or give any other or further relief; or review it, even for apparent error, upon any matter decided on

76. Plant Invest. Co. v. Jacksonville T. & K. W. R. Co., 152 U. S. 71, 38 L. Ed. 358.

77. Per Curiam, Andrews v. Thum, 72 Fed. Rep. 290, 293, 18 C. C. A. 556.

78. Lurton, J., in Goshen Sweeper Co. v. Bissell Carpet Sweeper Co., 72 Fed. Rep. 67, 73, 19 C. C. A. 13.

79. Bissell Carpet Sweeper Co. v. Goshen Sweeper Co., 72 Fed. Rep. 545, 560, 19 C. C. A. 25

appeal; or intermeddle with it, further than to settle so much as has been remanded.[80] If the Circuit Court mistakes or misconstrues the decree of this court, and does not give full effect to the mandate, its action may be controlled, either upon a new appeal (if involving a sufficient amount) or by a writ of mandamus to execute the mandate of this court.[81] But the Circuit Court may consider and decide any matters left open by the mandate of this court; and its decision of such matters can be reviewed by a new appeal only.[82] The opinion delivered by this court at the time of rendering its decree may be consulted to ascertain what was intended by its mandate; and either upon an application for a writ of mandamus, or upon a new appeal, it is for this court to construe its own mandate, and to act accordingly."[83]

A decree entered under a mandate which does not fully comply therewith, is not final, and may be modified at a subsequent term.[84]

§ 496. Recall or modification of the mandate.

The mandate may be recalled and corrected, at the same term where cause is shown. Where the Supreme Court discovered that before its decision the parties had

80. Sibbald v. United States, 37 U. S. (12 Pet.) 488, 492, 9 L. Ed. 1167, 1169; Texas & P. R. Co. v. Anderson, 149 U. S. 237, 37 L. Ed. 717.

81. Perkins v. Fourniquet, 55 U. S. (14 How.) 313, 330, 14 L. Ed. 435, 442; Re Washington & G. R. Co., 140 U. S. 91, 35 L. Ed. 339; City Nat. Bank v. Hunter, 152 U. S. 512, 38 L. Ed. 534, 153 U. S. 246, 38 L. Ed. 705.

82. Hinckley v. Morton, 103 U. S. 764, 26 L. Ed. 458; Mason v. Pewabic Min. Co., 153 U. S. 361, 38 L. Ed. 745; Nashua & L. R. Corp. v. Boston & L. R. Corp., 51 Fed. Rep. 929.

83. Sibbald v. United States, 37 U. S. (12 Pet.) 488, 493, 9 L. Ed. 1167, 1169; West v. Brashear, 39 U. S. (14 Pet.) 51, 10 L. Ed. 350; Wayne County Suprs. v. Kennicott, 94 U. S. 498, 24 L. Ed. 260; Gaines v. Caldwell ("Gaines v. Rugg,") 148 U. S. 228, 238, 244, 37 L. Ed. 432, 434, 437.

84. Moran v. Hagerman, 64 Fed. Rep. 499, 12 C. C. A. 239.

compromised, with the understanding that the cause should go on to final hearing and determination as if still an actual contest, one party paying the fees of counsel on both sides, the decree was vacated, the mandate recalled and the appeal dismissed.[85] Similarly, when it is discovered that it has no jurisdiction, though that question was not raised upon the hearing.[86]

A mere clerical omission, such as failure to include interest in the mandate, has been cured by amendment at a subsequent term, when the mandate, though issued, had not been presented to the court below,[87] and Mr. Justice Bradley said: "We have no doubt of our power at any time to amend a decree which has by inadvertence or mistake been entered in a different form from that in which we intended it."[88]

§ 497. Infringement by the government.

"It was at one time somewhat doubted whether the Government might not be entitled to the use and benefit of every patented invention, by analogy to the English law which reserves this right to the Crown. But that notion no longer exists."[89]

The rights to make, use and sell conveyed by the grant of letters patent exclude the Government of the United States.[90] Consequently, its liability for its tort, when a patent is infringed through any of its various agencies,

85. Gardner v. Goodyear Dental Vulcanite Co., 131 U. S. cili (Appendix), 21 L. Ed. 141.

86. Cannon v. United States, 116 U. S. 55, 29 L. Ed. 561.

87. Bank of Kentucky v. Wistar, 3 Peters 431, 7 L. Ed. 731.

88. Elizabeth v. American Nicholson Pavement Co., 131 U. S. cxlviii (Appendix), 24 L. Ed. 1059.

89. Mr. Justice Bradley, in United States v. Palmer, 128 U. S. 262, 32 L. Ed. 442.

90. U. S. v. Burns, 12 Wall. 246, 20 L. Ed. 388; Cammeyer v. Newton, 94 U. S. 235, 24 L. Ed. 75; Solomons v. U. S., 137 U. S. 342, 34 L. Ed. 667; Belknap v. Schild, 161 U. S. 10, 40 L. Ed. 599.

has long been settled.[91] But while the theoretical liability of the government has been thus announced, the practical question of reaching a recovery for the act of infringement has been enveloped in much difficulty.

The elemental proposition that the government cannot be sued, save by its consent,[92] and the further corollary that no implied agreement for the payment of a royalty grows out of an infringement by an agent of the government, practising the infringement at the cost of the government and in its service,[93] have measurably embarrassed the assertion of the patentee's rights.

The law of the subject, as it stood prior to the recent amendment of § 4919, R. S. U. S., has been thus summarized by the Supreme Court:[94]

"The United States, by successive acts of Congress, have consented to be sued upon their contracts, either in the Court of Claims, or in a Circuit or District Court of the United States.[95] The United States may accordingly be sued by a patentee for their use of his invention under a contract made with him by the United States or by their authorized officers.[96]

91. James v. Campbell, 104 U. S. 356, 26 L. Ed. 786; U. S. v. Palmer, 128 U. S. 252, 32 L. Ed. 442; International Postal Supply Co. v. Bruce, 114 Fed. Rep. 509, affirmed, 132 Fed. Rep. 1006, 65 C. C. A. 130; affirmed, 194 U. S. 601, 48 L. Ed. 1134.

92. Schillinger v. U. S., 155 U. S. 162, 39 L. Ed. 103; Belknap v. Schild, 161 U. S. 10, 40 L. Ed. 599.

93. Solomons v. United States, 22 Ct. of Claims 335, affirmed, 137 U. S. 342, 34 L. Ed. 667; Davis v. U. S., 23 Ct. of Claims 334.

94. Mr. Justice Gray, in Belknap v. Schild, 161 U. S. 10-17, 40 L. Ed. 599.

95. Acts of February 24, 1855 (10 Stat. at L., 765, ch. 122, § 1, 1 Comp. Stat. 729); March 3, 1863 (12 Stat. at L., 765, ch. 92, § 2; Rev. Stat., § 1059, 1 Comp. Stat., p. 734); Act of March 3, 1887 (24 Stat. at L., 505, ch. 359, §§ 1, 2, 1 Comp. Stat. 752-753).

96. United States v. Burns, 79 U. S. (12 Wall.) 246, 20 L. Ed. 388; United States v. Palmer, 128 U. S. 262; United States v. Berdan Firearms Mfg. Co., 156 U. S. 552, 39 L. Ed. 530.

But the United States have not consented to be liable to suits, founded in tort, for wrongs done by their officers, though in the discharge of their official duties.[97] The United States, therefore, are not liable to a suit for an infringement of a patent, that being an action sounding in tort."[98]

§ 498. Patent actions in the Court of Claims.

By a recent amendment of § 4919, R. S. U. S., the following provision has been incorporated in the statute;

"And whenever an invention described in and covered by a patent of the United States shall hereafter be used by the United States, without license or authority of the owner thereof, such owner may recover reasonable compensation for such use by suit in the Court of Claims: *Provided, however,* That in any such suit the United States may avail itself of any and all defenses, general or special, which might be pleaded by a defendant in an action for infringement as set forth in title sixty of the revised statutes, or otherwise."

This provision was enacted as the result of the labors of the American Bar Association. The argument which led to its enactment is ably presented in a report of the Committee on Patent, Trademark and Copyright Law of that Association, from which we quote:

"The matter is one of greater and wider interest than might be supposed. The government is not only an enormous consumer, but likewise a very large manufacturer of patented articles. The status of a patent as pri-

97. Gibbons v. United States, 75 U. S., 8 Wall. 269; Morgan v. United States, 81 U. S., 14 Wall. 531, 534; Langford v. United States, 101 U. S. 341; United States v. Jones, 131 U. S. 1, 16, 18; German Bank of Memphis v. United States, 148 U. S. 573, 579, 580; Hill v. United States, 149 U. S. 593, 37 L. Ed. 862.

98. Schillinger v. United States, 155 U. S. 163; United States v. Berdan Firearms Mfg. Co., 156 U. S. 552, 39 L. Ed. 530.

vate property, which even the government is prohibited from taking for public use, without compensation (amendment to the Constitution, article V), has been declared and redeclared in many opinions by the Supreme Court of the United States (McKeever vs. United States, 14 Ct. Cls. 396; affirmed S. C., 18 Ct. Cls. 757; James vs. Campbell, 104 U. S. 356; Hollister vs. Benedict & Burnham Mfg. Co., 113 U. S. 59; United States vs. Palmer, 128 U. S. 262; Solomons vs. United States, 137 U. S. 346; Belknap vs. Schild, 161 U. S. 10, and numerous other cases.) But it has been held, also, that in the absence of an express contract between the owner and the government or of transactions between them from which an agreement by the government to pay reasonable royalty must be implied, the patentee has no remedy at law or by executive action and must obtain relief, if at all, by appeal to Congress (Schillinger vs. United States, 155 U. S. 163; Russell vs. United States, 182 U. S. 516; Bigby vs. United States, 188 U. S. 400; McKeever vs. United States, 14 Ct. Cls. 396; Butler vs. United States, 23 Ct. Cls. 335; Eager vs. United States, 35 Ct. Cls. 556.) With respect to tangible property, such as real estate, the courts have implied an agreement by the government to make reasonable compensation for property taken from the mere act of appropriation. In United States vs. Lunah, 188 U. S. 445, it appeared that certain lands were overflowed in consequence of improvements made by the government in a navigable river. The court held that this was a taking of private property for public use and that the owner was entitled to recover compensation for it in an action brought in the Court of Claims under the Act of March 3, 1887, known as the "Tucker Act." But the courts have assumed a very different attitude toward patents, holding that one claiming royalty must show: (1) his ownership of the patent; (2) the beneficial use by the government, of the patented

invention, and (3) that the taking and use of his invention occurred, with the patentee's consent, by order of a responsible official of the government, and with the distinct understanding that reasonable royalty should be paid for such use of the invention as the government might see fit to make (see authorities cited). The policy of the government throughout its several departments, when procuring materials or articles of any kind, by contract, is to require the contractor to furnish bond to indemnify the government against claims of patentees for the use of inventions embodied in such materials or articles. This, however, is not designed to and does not afford protection to patentees, who derive no remedy against the contractor on the bond for the use which the government makes of infringing articles and have no remedy against the government."[99]

§ 499. Jurisdiction of the Court of Claims.

The Court of Claims was originally established by the Act of February 24, 1855, 10 Stat. at L. 612. It is provided by § 136, The Judicial Code, that the court shall consist of a Chief Justice and four judges, who shall be appointed by the President, by and with the advice and consent of the Senate, and hold their offices during good behavior.

Any three judges constitute a quorum, but the concurrence of three judges is necessary to the decision of any case (18 Stat. at L. 252, § 138, The Judicial Code).

§ 144, The Judicial Code, provides that members of either House of Congress shall not practice in the Court of Claims. Rule 8 of the court provides that: "Any person of good moral character, who has been admitted to practice in the Supreme Court of the United States,

99. Reports, American Bar Assn., Vol. XXXIV, (1909) 548.

or in the highest court of the District of Columbia, or in the highest court of any State or Territory, may be admitted, on motion in open court, to practice as an attorney and counselor of this court. He may also be admitted by an order at chambers, on its being shown by affidavit or otherwise that he is qualified as above provided."

The jurisdiction of the Court of Claims is primarily defined by § 148, The Judicial Code, reenacting § 1059, R. S. U. S., which provides in part that that jurisdiction shall extend to "all claims founded upon any law of Congress, or upon any regulation of an Executive Department, or upon any contract, expressed or implied, with the Government of the United States, and all claims which may be referred to it by either House of Congress."

Of its jurisdiction, Mr. Justice Shiras has said:

"The jurisdiction of that court extends throughout the United States. It issues writs to every part of the United States, and is specially authorized to enforce them."[100]

The statutory provisions above referred to have been supplemented by § 1070, R. S. U. S., re-enacted as § 157, The Judicial Code, providing that "The said court shall have power to establish rules for its government and for the regulation of practice therein, and it may punish for contempt in the manner prescribed by the common law, may appoint Commissioners, and may exercise such powers as are necessary to carry into effect the powers granted to it by law."

§ 500. Practice and procedure.

The form of petition to be used by the claimant has been fixed by statute, as follows:

100. United States v. Borcherling, 185 U. S. 223, 234, 46 L. Ed. 884, 889.

"The claimant shall, in all cases, fully set forth in his petition the claim, the action thereon in Congress, or by any of the departments, if such action has been had; what persons are owners thereof or interested therein, when and upon what consideration such persons became so interested; that no assignment or transfer of said claim, or of any part thereof or interest therein, has been made, except as stated in the petition; that said claimant is justly entitled to the amount therein claimed from the United States, after allowing all just credits and offsets; that the claimant, and, where the claim has been assigned, the original and every prior owner, thereof, if a citizen, has at all times borne true allegiance to the Government of the United States, and whether a citizen or not, has not in any way voluntarily aided, abetted, or given encouragement to rebellion against the said Government, and that he believes the facts as stated in the said petition to be true. And the said petition shall be verified by the affidavit of the claimant, his agent, or attorney."

(§ 1072, R. S. U. S., reenacted as § 159, The Judicial Code.)

The averment of allegiance required by this statute was rendered unnecessary by the Proclamation of Amnesty of December 25, 1868, 15 Stat. at L. 711.[101]

The rules of the court with reference to the petition provide:

"16. Suits shall be commenced by petition, verified in the manner provided by law, and filed in the office of the clerk, with one extra copy in print or typewriting. The clerk will note thereon the filing day, and will cause a copy to be forwarded to the Attorney-General. Within

101. Armstrong v. United States, 80 U. S. (13 Wall.) 154, 20 L. Ed. 614; Pargoud v. United States, 80 U. S. (13 Wall.) 156, 20 L. Ed. 646.

twenty days thereafter the claimant shall have printed twenty-five copies of such petition, retaining ten copies for the trial record and filing the remaining copies in the clerk's office, unless the court, on motion, for good and sufficient causes, waives the printing of the petition.

Five of said copies shall be for the Attorney-General.

The petition must comply with § 1072, R. S. U. S. (now § 159, The Judicial Code), respecting what action has been had thereon before Congress or any of the departments, the ownership of the claim, and what transfer, or assignments, if any, have been made, and must also set forth:

(1) The title of the action, with the full Christian and surnames of all the claimants.

(2) A plain, concise statement of the facts, giving venue and date, free from argumentative, irrelevant, and impertinent matter.

(3) In every case transmitted by the head of a Department, by Congress, or a committee thereof, a copy of the order of transmission shall be set out or annexed, as provided by par. 5, Rule 27.

(4) The claimant must state distinctly the amount for which he demands judgment, or the relief for which he prays."

"17. If the claim be founded upon an act of Congress, or upon a regulation of an Executive Department, the act and the section thereof upon which the claimant relies must be specified, and the particular regulation of the department must be stated in terms."

"18. If the claim be founded upon express contract with the United States, the substance of such contract must be set forth in the petition and, if it be in writing, the original or a copy must be annexed thereto. If it be founded upon an implied contract, the facts upon which the claimant relies to prove a contract must be specified.

If it consists of several matters or items, each must be separately stated."

The taking of testimony is governed explicitly by statute.

"When it appears to the court in any case that the facts set forth in the petition of the claimant do not furnish any ground for relief, it shall not authorize the taking of any testimony therein." (See former § 1077, R. S. U. S.) The Judicial Code, ch. 7, § 165.

"The court may, at the instance of the attorney or solicitor appearing in behalf of the United States, make an order in any case pending therein, directing any claimant in such case to appear, upon reasonable notice, before any Commissioner of the court, and be examined on oath touching any or all matters pertaining to said claim. Such examination shall be reduced to writing by the said Commissioner, and be returned to and filed in the court, and may, at the discretion of the attorney or solicitor of the United States appearing in the case, be read and used as evidence on the trial thereof. And if any claimant, after such order is made, and due and reasonable notice thereof is given to him, fails to appear, or refuses to testify or answer fully as to all matters within his knowledge material to the issue, the court may, in its discretion, order that the said cause shall not be brought forward for trial until he shall have fully complied with the order of the court in the premises." (§ 1080, R. S. U. S.) The Judicial Code, § 166.

"The testimony in cases pending before the Court of Claims shall be taken in the county where the witness resides, when the same can be conveniently done." (§ 1081, R. S. U. S.) The Judicial Code, § 167.

"The Court of Claims may issue subpoenas to require the attendance of witnesses in order to be examined before any person commissioned to take testimony therein, and such subpoenas shall have the same force as if

issued from a district court, and compliance therewith shall be compelled under such rules and orders as the court shall establish." (§ 1082, R. S. U. S.) The Judicial Code, § 168.

"In taking testimony to be used in support of any claim, opportunity shall be given to the United States to file interrogatories, or by attorney to examine witnesses, under such regulations as said court shall prescribe; and like opportunity shall be afforded the claimant, in cases where testimony is taken on behalf of the United States, under like regulations." (§ 1083, R. S. U. S.) The Judicial Code, § 169.

"The Commissioner taking testimony to be used in the Court of Claims shall administer an oath or affirmation to the witnesses brought before him for examination." (§ 1084, R. S. U. S.) The Judicial Code, § 170.

"When testimony is taken for the complainant, the fees of the Commissioner before whom it is taken, and the cost of the commission and notice, shall be paid by such claimant; and when it is taken at the instance of the Government, such fees, together with all postage incurred by the Assistant Attorney-General, shall be paid out of the contingent fund provided for the Court of Claims, or other appropriation made by Congress for that purpose." (§ 1085, R. S. U. S.) The Judicial Code, § 171.

§ 501. Limitation of actions.

"Every claim against the United States, cognizable by the Court of Claims, shall be forever barred unless the petition setting forth a statement thereof is filed in the court, or transmitted to it by the Secretary of the Senate or the Clerk of the House of Representatives as provided by law, within six years after the claim first accrues: *Provided*, That the claims of married women first accrued during marriage, of persons under the age of twenty-one years first accrued during minority, and of idiots, lunatics, insane persons, and persons beyond the

seas at the time the claim accrued, entitled to the claim, shall not be barred if the petition be filed in the court or transmitted, as aforesaid, within three years after the disability has ceased; but no other disability than those enumerated shall prevent any claim from being barred, nor shall any of the said disabilities operate cumulatively." (See § 1069, R. S. U. S.) The Judicial Code, ch. 7, § 156.

The limitation of this section need not be pleaded; it goes to the jurisdiction of the court, and cannot be waived on behalf of the government. "A judgment in the Court of Claims for the amount of a claim which the record or evidence shows to be barred by the statute would be erroneous." [102]

§ 502. New trials.

The statutory provisions as to the granting of new trials are as follows:

"When judgment is rendered against any claimant, the court may grant a new trial for any reason which, by the rules of common law or chancery in suits between individuals, would furnish sufficient ground for granting a new trial." (See § 1087, R. S. U. S.) The Judicial Code, ch. 7, § 174.

"The Court of Claims, at any time while any claim is pending before it, or on appeal from it, or within two years next after the final disposition of such claim, may, on motion on behalf of the United States, grant a new trial and stay the payment of any judgment therein, upon such evidence, cumulative or otherwise, as shall satisfy the court that any fraud, wrong, or injustice in the premises has been done to the United States; but until an order is made staying the payment of a judgment,

102. Finn v. United States, 123 U. S. 227, 31 L. Ed. 128. To the same effect, see, United States v. Wardwell, 172 U. S. 48, 43 L. Ed. 360.

the same shall be payable and paid as now provided by law." (See § 1088, R. S. U. S.) The Judicial Code, ch. 7, § 175.

§ 503. Foreign patents under the international convention.

China has no patent law. In all of the other civilized countries of the world inventions may be patented to citizens of the United States.[103]

The International Convention for the protection of "Industrial Property," by which term Patents and trade-marks are especially indicated,[104] is built up of a series of conventions or treaties, of which the first was signed at Paris, on March 20, 1883, and ratified by the United States on March 29, 1887; a subsequent treaty was signed at Madrid April 15, 1891; a later treaty was signed at Brussels on December 14, 1900, and proclaimed by the President of the United States on August 25, 1902, 32 Stat. at L. 1936. By the agreement of the ratifying governments this treaty went into effect September 14, 1902. This treaty has been held to be properly interpreted by the act of March 3, 1903, 32 Stat. at L. 1225, c. 1019, which was re-enacted as § 4887, R. S. U. S. It was therefore held that patents issued prior to the act of March 3, 1903, were controlled by § 4887, R. S. U. S., as it then stood, and when limited by the then terms of § 4887, R. S. U. S., to expire with the expiration of a foreign patent, they were not revitalized by the act of March 3, 1903.[105]

This convention is now adhered to by the following Governments: Austria, Belgium, Brazil, Cuba, Denmark with the Faroe Islands, France with Algeria and colonies,

103. Holland's first Patent Law goes into effect about January 1, 1912.

104. United Shoe Machinery Co. v. Duplessis Shoe Mach Co., 155 Fed. Rep. 842, 843, 84 C. C. A. 76.

105. United Shoe Machinery Co. v. Duplessis Shoe Mach. Co., 155 Fed. Rep. 842, 849, 84 C. C. A. 76.

Germany, Great Britain with Australia, Ceylon, New Zealand, and Trinidad and Tobago, Hungary, Italy, Japan, Mexico, Netherlands with the Dutch East Indies, Surinam, and Curacoa, Norway, Portugal with the Azores and Madeira, Santo Domingo, Servia, Spain, Sweden, Switzerland, Tunis, United States of America.

The object of this convention as expressed in Article IV is to give to the person who has applied for a patent, industrial design, or model, or trademark in one of the contracting States a period of time after the issuance of his patent or registration first applied for, within which to lodge his application in such other countries, parties to the convention, as he may desire, the period fixed with respect to inventions being twelve months.

It has been held in Great Britain that a patent can only be granted under the International Convention to the person who has made the former application in a foreign country;[106] so an application by a director of a foreign corporation, requesting that letters patent issue to the agent of the corporation in England,[107] as well as an application by the agent of an assignee of the foreign patents,[108] have been refused.

By Article III, *bis.*, patents obtained under the convention are not liable to forfeiture on account of failure to utilize the invention until after the expiration of at least three years from the date of the deposit of the application in the country concerned, and then only provided the patentee cannot show reasonable cause for his inaction.

106. Shallenberger's Application, 6 R. P. C. 550.

107. Carez's Application, 6 R. P. C. 552.

108. Shallenberger's Application, 6 R. P. C. 550.

The British Patent Office has recently promulgated the following order in relation to patent applications under the International Convention.

"Difficulties have arisen with regard to the documents which an applicant for a patent under the Convention should furnish to this Office. The matter is being considered in connection with the practice of Foreign Patent Offices in similar cases, with a view to the establishment, if possible, of an international practice. In the meantime the following general practice will be adopted in this Office, and so far as it alters the existing practice will apply to all applications filed on or after the 1st of May, 1911.

"(1) The certified copy of the foreign specification furnished under Rule 16 should be a copy of the specification as originally filed in the foreign country or British Possession. In the case of countries where no search for novelty is made and alterations are not probable a copy of the foreign specification as finally allowed or accepted will be taken as sufficient, but in other cases it will only be admitted on a Certificate by the Foreign Patent Office, that no substantial addition has in fact been made to the specification since it was originally filed.

"(2) Where the Convention application is based upon a foreign application which has been filed in the Foreign Patent Office on a certain date but an earlier date is claimed as the date of the foreign application on the ground that the subject-matter was included in a specification of an earlier foreign application and has been divided out therefrom, and the applicant desires the date so claimed should be given to the patent to be granted in this country, then a certified copy of the foreign specification of the date claimed from which the subject-matter of the application has been so divided out or of that

part of the foreign specification describing the invention it is now desired to protect should be furnished under Rule 16, together with the specification filed with the actual application made at the later date in the Foreign Office.

"In such cases the date when the application in the foreign country in regard to the subject-matter so divided out was actually filed in the Foreign Patent Office will not be given to the patent to be granted in this country, unless the Comptroller is satisfied that the earlier date cannot properly be regarded as the date of the application in the foreign country.

"In the latter case it will be sufficient to furnish a certified copy of the specification lodged in the Foreign Patent Office with the application when filed.

"(3) A convention application in respect of a 'renewed' application in the United States should be accompanied by a certified copy of the specification filed in the United States with such 'renewal' application and the patent to be sealed in this country would be dated as of the date of filing such 'renewed' application in the United States.

"(4) A Convention application in respect of a United States 'reissue' application should be made in regard only to the new matter claimed for the first time in the 'reissue' specification a certified copy of which specification should be furnished under Rule 16, and the patent to be sealed in this country would be dated as of the date of filing such 'reissue' application in the United States.

"31st March, 1911.

"W. TEMPLE FRANKS,
"Comptroller-General."

§ 504. Stipulations.

In proceedings in the Patent Office and in the courts, stipulations are frequently made by the parties as to matters of time for filing pleadings or taking proofs, or as to matters of fact involved in the issues, to the end of serving the convenience of parties or counsel, or simplifying the issues, or curtailing the record. In general, a stipulation may be defined to be any agreement between counsel respecting business before a court.[109] But no stipulation by counsel as to the law is binding on the court, and of course such a stipulation is improper.[110]

Stipulations bind only the parties making them.[111] "A stipulation made by an attorney in one action will not bind his client in another, unless the latter expressly acquiesces in it in the second suit; much less will it estop his assignee."[112]

It is the general rule as to stipulations for postponement or extensions of time for taking testimony that they do not become effective until approved by the Patent Office or the court,[113] and in interference cases the Patent Office requires a showing of cause for the delay, in its attitude of representing the public.[114]

The extent to which stipulations may govern the disposition of a cause is only limited by the issues, for a decree may be reversed on stipulation.[115] As a general rule it would seem impossible to confer upon a court by

109. Anderson, Dict., title "Stipulation."

110. Breeze v. Haley, 11 Colo. 351, 18 Pac. Rep. 551.

111. Kneeland v. Luce, 141 U. S. 437, 35 L. Ed. 808.

112. Sanborn, J., in Board of Commissioners v. Sutliff, 97 Fed. Rep. 270, 282, 38 C. C. A. 167.

113. Wooster v. Clark, 9 Fed. Rep. 854; Sponsel v. Darling, 105 Off. Gaz. 498.

114. Sponsel v. Darling, 105 Off. Gaz. 498.

115. Arbuckle v. Quigley, 131 U. S. 428, 33 L. Ed. 213.

stipulation jurisdiction which it does not possess,[116] but where a stipulation was filed admitting the commission of infringing acts within the district, which appears to have been the only jurisdictional fact, as to the territorial jurisdiction of the court, in the case, the court refused to permit the defendant to withdraw from the stipulation without the consent of the other party, Judge Wheeler observing "the Circuit (now District) Courts of the United States have full jurisdiction of patent cases. The limitation as to the district of residence of the defendant, or of place of business and acts of infringement, relates merely to the place of suit, and may be waived. As this case proceeded beyond the pleadings into the taking of testimony, which was like going to trial in an action at law, without any point as to its place being made, that objection would seem to have gone by."[117]

The general rule is that a party's rights will not be foreclosed by any stipulation as to facts entered into inadvertently and under a misapprehension of those facts;[118] as put by Mr. Justice Brown, regarding a stipulation at variance with the facts disclosed by the testimony, "while the stipulation is undoubtedly admissible in evidence it ought not to be used as a pitfall, and where the facts subsequently developed show, with respect to a particular matter, that it was inadvertently signed, we think that, upon giving notice in sufficient time to prevent prejudice to the opposite party, counsel may repudiate any fact inadvertently incorporated therein."[119]

The Federal Judicial Code provides for the transfer of cases by stipulation from one division to another in the same district, as follows:

116. Bingham v. Winona County, 6 Minn. 136.

117. General Electric Co. v. Wagner Elec. Mfg. Co., 123 Fed. Rep. 101, 103.

118. Scott v. Lazell, 160 Fed. Rep. 472, 474, 87 C. C. A. 456.

119. Carnegie Steel Co. v. Cambria Iron Co., 185 U. S. 403, 444, 46 L. Ed. 968. 989.

"Section 58. Any civil cause, at law or in equity, may, on written stipulation of the parties or of their attorneys of record signed and filed with the papers in the case, in vacation or in term, and on the written order of the judge signed and filed in the case in vacation or on the order of the court duly entered of record in term, be transferred to the court of any other division of the same district, without regard to the residence of the defendants, for trial. When a cause shall be ordered to be transferred to a court in any other division, it shall be the duty of the clerk of the court from which the transfer is made to carefully transmit to the clerk of the court to which the transfer is made the entire file of papers in the cause and all documents and deposits in his court pertaining thereto, together with a certified transcript of the records of all orders, interlocutory decrees, or other entries in the cause; and he shall certify, under the seal of the court, that the papers sent are all which are on file in said court belonging to the cause; for the performance of which duties said clerk so transmitting and certifying shall receive the same fees as are now allowed by law for similar services, to be taxed in the bill of costs, and regularly collected with the other costs in the cause; and such transcript, when so certified and received, shall henceforth constitute a part of the record of the cause in the court to which the transfer shall be made. The clerk receiving such transcript and original papers shall file the same and the case shall then proceed to final disposition as other cases of a like nature."

§ 505. Contracts for the assignment of future inventions.

The only limitations upon the right of the individual to contract for the assignment of inventions which he may make in the future, are those imposed by public policy. Of the restrictions imposed by public policy

upon the right of the individual to make private contracts, Mr. Justice Shiras has said: "It must not be forgotten that the right of private contract is no small part of the liberty of the citizen, and that the usual and most important function of courts of justice is rather to maintain and enforce contracts, than to enable parties thereto to escape from their obligation on the pretext of public policy, unless it clearly appear that they contravene public right or the public welfare."[120] A court of equity may always refuse to grant relief under a contract between private parties upon the ground that the contract is in contravention of public policy, and it is the duty of the court to raise this question in a proper case whether it is pleaded or not. As Mr. Justice Holmes has said, "the very meaning of public policy is the interest of others than the parties, and that interest is not to be at the mercy of the defendant alone."[121] It is obvious that the work of the inventor is a matter which is peculiarly of public interest, and that no contract tending to stifle or suppress invention should be upheld in equity, in view of the fact that the disclosure of the invention is the moving consideration for the grant of letters patent, because of the fact that that disclosure will become the common right of the public upon the expiration of the patent.

§ 506. Such contracts not within the statute of frauds.

In the consideration of this subject it should first be noted that it is immaterial to the validity of the contract whether it is oral or in writing. "An oral agreement for the sale and assignment of the right to obtain a patent for an invention is not within the statute of

120. Baltimore & O. S. W. R. Co. v. Voigt, 179 U. S. 498, 505, 44 L. Ed. 560.

121. Beasley v. Texas & P. R. Co., 191 U. S. 492, 498, 48 L. Ed. 274, 276.

frauds, nor within § 4898, R. S. U. S., requiring assignments of patents to be in writing; and may be specifically enforced in equity, upon sufficient proof thereof." [122]

§ 507. Such contracts never implied.

Contracts for the conveyance of future inventions are usually presented to the court through the medium of suits for specific performance. Aside from this, their essential nature is such as of itself to require clearness, precision, and freedom from ambiguity. In applying this requirement to contracts of this class Mr. Justice Gray has said: "From the time of Lord Hardwick, it has been the established rule that a court of chancery will not decree specific performance, unless the agreement is 'certain, fair, and just in all its parts.' And the rule has been repeatedly affirmed and acted on by this court. In Colson v. Thompson, Mr. Justice Washington, speaking for the court, said: 'The contract which is sought to be specifically executed ought not only to be proved, but the terms of it should be so precise as that neither party could reasonably misunderstand them. If the contract be vague or uncertain, or the evidence to establish it be insufficient, a court of equity will not exercise its extraordinary jurisdiction to enforce it, but will leave the party to his legal remedy.' 15 U. S. (2 Wheat. 336, 341, 4 L. Ed. 253, 255). So this court has said that chancery will not decree specific performance, 'if it be doubtful whether an agreement has been concluded, or is a mere negotiation,' nor 'unless the proof is clear and

122. Mr. Justice Gray, in Dalzell v. Dueber Watch Case Mfg. Co., 149 U. S. 315, 320, 37 L. Ed. 749, 753. Citing Somerby v. Buntin, 118 Mass. 279, 19 Am. Rep. 459; Gould v. Banks, 8 Wend. 562; Burr v. De la Vergne, 102 N. Y. 415; Blakeney v. Goode, 30 Ohio St. 350. To the same effect, see, Pressed Steel Car Co. v. Hansen, 137 Fed. Rep. 403, 71 C. C. A. 207.

satisfactory, both as to the existence of the agreement, and as to its terms.' " [123]

It is now clearly established that a contract to convey future inventions, even as between master and servant, must be express, and cannot be implied from the mere relationship of master and servant. In an exhaustive opinion Judge Gray has said: "We do not think that the complainant here, in the absence of express contract to that effect, from the mere relation of employer and employee, in connection with the facts and circumstances disclosed by this record, is entitled, in equity and good conscience, to an assignment from the defendant of his whole right, title, and property in the inventions in question. If entitled to anything, complainant is only entitled to a shop right or license that would enable it to use these inventions without paying a royalty therefor, a right which does not strip defendant of his entire property right in the product of his own inventive faculty. It is by distinguishing between claims for mere shop rights or license, and claims for the entire and exclusive property right in the inventions of the employee, that the cases cited are to be profitably read. This distinction has been observed in many cases, both Federal and State.[124] * * * We have been referred to no case, nor have we been able to discover one in which, apart

123. Dalzell v. Dueber Watch Case Mfg. Co., 149 U. S. 315, 320, 37 L. Ed. 749, 753. Citing Carr v. Duval, 39 U. S. (14 Pet.) 79, 83, 10 L. Ed. 362, 364; Nickerson v. Nickerson, 127 U. S. 668, 676, 32 L. Ed. 314, 319; Hennessey v. Woolworth, 128 U. S. 438, 442, 32 L. Ed. 500, 501.

124. Citing McClurg v. Kingsland, 1 How. 202, 11 L Ed. 102; Dalzell v. Dueber Watch Case Mfg. Co., 149 U. S. 315, 37 L. Ed. 749; Lane & Bodley Co. v. Locke, 150 U. S. 193, 37 L. Ed. 1049; Bensley v. N. W. Horsenail Co., 26 Fed. Rep. 250; Herman v. Herman, 29 Fed. Rep. 92; Boston v. Allen, 91 Fed. Rep. 248, 33 C. C. A. 485; Joliet Mfg. Co. v. Dice, 105 Ill. 649; Fuller & Johnson Mfg. Co. v. Bartlett, 68 Wis. 73, 31 N. W. 747, 60 Am. Rep. 838.

from express contract or agreement, and upon the mere general relation of employer and employee and of the facts and circumstances attending it, the employer has been vested with the entire property right in the invention and patent monopoly of the employee, or with anything other than a shop right, or irrevocable license, to use the patented invention. Such a right in the employer, the employee may be estopped to deny, by the fact of his employment and his conduct in relation to the use of his inventions by his employer, and to that extent and no further have the cases gone."[125]

§ 508. Contracts for services as inventor.

Mr. Justice Bradley, on circuit, said: "A naked assignment or agreement to assign, in gross, a man's future labors as an author or inventor—in other words, a mortgage on a man's brain, to bind all its future products—does not address itself favorably to our consideration. It is something like engagements of an expectant heir, binding the property which he may afterwards inherit, which are always looked upon with disfavor by the law."[126] The rule thus expressed seems to be based upon sound principles of public policy. But it must not be extended beyond the facts embraced in its terms. Speaking generally, where a contract for the conveyance of future inventions is coupled with a contract of employment, looking to the production of inventions, it will be sustained if based upon a valuable consideration.

Illustrative contracts. The following are specimens of contracts of the kind under consideration, which have been sustained judicially:

125. Pressed Steel Car Co. v. Hansen, 137 Fed. Rep. 403, 410, 415, 71 C. C. A. 207.

126. Aspinwall Mfg. Co. v. Gill, 32 Fed. Rep. 697, 700; quoted with approval in Eastern Dynamite Co. v. Keystone Powder Mfg. Co., 164 Fed. Rep. 47, 50.

"Whereas, Herbert L. Hildreth, of Boston, candy manufacturer, is desirous of having perfected and manufactured a certain machine or machines for use in the manufacture of candy, and especially for sizing, shaping, cutting, wrapping, and packing; also the pulling of molasses candy; and whereas, I, Charles Thibodeau, being a skilled mechanic, and desirous of entering the employ of said Hildreth for the purpose of constructing, improving, and perfecting such machinery; Now, therefore, in consideration of such employment, and of the payment of wages to me at the rate of ($3.25) three dollars and twenty-five cents per day, I hereby agree with said Hildreth to enter his employ, and that I will give him my best services, and also the full benefit and employment of any and all inventions or improvements which I have made or may hereafter make relating to machines or devices pertaining to said Hildreth's business. I also further agree that, should said Hildreth not desire to patent any of said inventions or improvements, but to keep the same secret, I will do all in my power to assist him in this, and will not disclose any information as to the same or any of them, except at the request of the said Hildreth.

"Signed at Boston, Mass., this 29th of May, 1897.

CHARLES THIBODEAU." [127]

The essential paragraphs of a similar contract were as follows:

"First. The employer is engaged in the manufacture of glass, glassware, and mechanical devices

127. Thibodeau v. Hildreth, 124 Fed. Rep. 892, 60 C. C. A. 78, 63 L. R. A. 480; affirming Hildreth v. Thibodeau, 117 Fed. Rep. 146.

in connection therewith, and that such manufacture is carried on by means of certain secret formulas, methods, processes, tools, machinery, patterns, and appliances, and the same are the property of the employer, and intended to be kept and guarded by the employer as secrets; and that all knowledge and information which the employee now possesses, or shall hereafter acquire, respecting such secrets, and all inventions and discoveries made by said employee during the term of his employment, shall at all times, and for all purposes, be regarded as acquired, and held by the employee in a fiduciary capacity, and solely for the benefit of the employer."

"Fourth. That the employee will, when required, make and execute any and all assignments in writing which may be deemed by the employer proper and necessary to transfer and vest in the employer the entire right, title, and interest in all inventions and discoveries made by the employee during the term of his employment." [128]

Of the former contract, Judge Lowell said: "This contract is neither unconscionable nor against public policy. Such an agreement is not uncommonly made by an employee with his employer, and it may be necessary for the reasonable protection of the employer's business." [129] Of the latter contract, Judge Acheson said: "The hiring, the engagement to pay wages, and the introduction of the defendant into the complainant's establishment and to its methods and processes, consti-

128. Mississippi Glass Co. v. Franzen, 143 Fed. Rep. 501, 502, 74 C. C. A. 135, reversing Mississippi Glass Co. v. Franzen, 138 Fed. Rep. 924.

129. Thibodeau v. Hildreth, 124 Fed. Rep. 892, 893, 60 C. C. A. 78, 63 L. R. A. 480.

tuted a valid consideration for his agreement to assign his inventions made during his term of employment."[130]

It will be noted that both of these contracts went beyond the mere employment to make inventions, and entered the domain of trade secrets. This was an additional and a cogent ground for sustaining the contracts, as has been repeatedly ruled in cases where the employee was enjoined from using or divulging the secrets of his employer after the termination of the employment.[131]

Such contracts not void as against public policy. Contracts of the character under consideration are clearly not antagonistic to public policy. In considering that defense, Judge Simonton said: "Is the contract void as against public policy? Does it injure the public? Here we have the case of an ingenious man, without opportunity of developing his talent, and struggling under difficulties, enabled by this contract to secure employment in a large and prosperous corporation, where he could give his inventive faculties full play. He in this way was afforded every opportunity of discovering and removing defects in cigarette machines. He secured this employment by signing this contract. He could not have obtained it if it had been understood that this contract had no validity. Then, in all human probability, the public would have lost the benefit of his discovery. In this point of view, a contract of this character cannot be said to be against public policy. Sir George

130. Mississippi Glass Co. v. Franzen, 143 Fed. Rep. 501, 506, 74 C. C. A. 135.

131. Hopkins on Trademarks (2d. Edition) § 92; Simmons Med. Co. v. Simmons, 81 Fed. Rep. 163; Stewart v. Hook, 118 Ga. 445, 45 S. E. Rep. 369, 63 L. R. A. 255; Stone v. Goss, 65 N. J. Eq. 756, 55 Atl. Rep. 736, 63 L. R. A. 344; Eastman Co. v. Reichenbach, 20 N. Y. Super. 110, 116; Tabor v. Hoffmann, 118 N. Y. 30, 23 N. E. Rep. 12, 16 Am. St. Rep. 740; Westervelt v. National Paper Co., 154 Ind. 673, 57 N. E. Rep. 552.

Jessel, in discussing the subject, holds that not only is there no rule of public policy against such a contract as this before us, but that public policy is with it."[132]

Such contracts not in restraint of trade. Courts of equity now recognize and enforce contracts of many kinds which formerly would have been held to be void as being in restraint of trade. The relaxation of the rule has been recognized by the Supreme Court.

"The decision in Mitchel v. Reynolds, 1 P. Wms. 181, is the foundation of the rule in relation to the validity of contracts in restraint of trade; but, as it was made under a condition of things and a state of society different from those which now prevail, the rule laid down is not regarded as inflexible, and has been considerably modified. Public welfare is first considered, and if it be not involved, and the restraint upon one party is not greater than the protection to the other requires, the contract may be sustained. The question is whether, under the particular circumstances of the case, and the nature of the particular contract, as involved in it, the contract is or is not unreasonable."[133] The evolution of this doctrine has been described by Mr. Chief Justice White as follows:

"To define * * * the words 'in restraint of trade' as embracing every contract which in any degree produced that effect would be violative of reason, because it would include all those contracts which are the very essence of trade, and would be equivalent to saying

132. Hulse v. Bonsack Mach. Co., 65 Fed. Rep. 864, 868, 13 C. C. A. 180. Citing Registering Co. v. Sampson, L. R. 19 Eq. 466.

133. Gibbs v. Consolidated Gas Co., 130 U. S. 396, 32 L. Ed. 979. Citing Rousillon v. Rousillon, L. R. 14 Ch. Div. 351; Leather Cloth Co. v. Lorsont, L. R. 9 Eq. 345.

that there should be no trade, and therefore nothing to restrain. * * * It is perhaps true that the principle by which contracts in restraint of the freedom of the subject or of trade were held to be illegal was first understood to embrace all contracts which in any degree accomplished these results. But as trade developed it came to be understood that if contracts which only partially restrained the freedom of the subject or of trade were embraced in the rule forbidding contracts in restraint of trade, both the freedom of contract and trade itself would be destroyed. Hence, from the reason of things, arose the distinction that where contracts operated only a partial restraint of the freedom of contract or of trade they were not in contemplation of law contracts in restraint of trade. And it was this conception also which, in its final aspect, led to the knowledge that reason was to be the criterion by which it was to be determined whether a contract which, in some measure, restrained the freedom of contract and of trade, was in reality, when considered in all its aspects, a contract of that character, or one which was necessary to the freedom of contract and of trade."[134]

The development of this doctrine bears an important relation to those contracts, constantly increasing in number, by which inventors bind themselves to the inventive development of the machines, other products, or processes, of the great industrial enterprises of the country. In a consideration of a contract employing an inventor in making inventions Judge Simonton said: "It has been urged with learning and ability that this contract is void as against public policy, because in restraint of trade. It would extend this opinion to an

134. United States v. Trans-Missisippi Freight Assn., 166 U. S. 290, 351, 41 L. Ed. 1007, 1032.

unreasonable length if we attempted to follow the long line of authorities on this subject found in the English Reports from the Year Books to the present time. The true test is that made by Tindal, C. J., in Horner v. Graves, 7 Bing. 735: 'Is the restraint such only as to afford a fair protection to the interest of the party in favor of whom it is given, and not so large as to interfere with the interests of the public?' Or, to put it as it is put in Ammunition Co. v. Nordenfelt (1893), 1 Ch. 630, and in Match Co. v. Roeber, 106 N. Y. 473, 13 N. E. 419: Is it, in view of all the circumstances of the case, reasonable? We have seen the reason for the adoption of this form of contract by the company. It was to protect it from improvements discovered by its own servants, under its pay, in cigarette machines. The company let them into an intimate knowledge of its cigarette machines, affords them the opportunity of discovering any needed improvements in them, gives them at hand the means of testing any improvements which may suggest themselves. Naturally it seeks to protect itself from an abuse of these results. The protection sought is a fair one for the interests of the company. Does this protection interfere with the interests of the public? 'Sales of secret processes are not within the principle or the mischief of restraints of trade at all. By the very transaction in such cases, the public gains on the one side what is lost on the other, and, unless such a bargain was treated as outside the doctrine of general restraint of trade, there could be no sale of secret processes of manufacture.' Bowen, L. J., in Ammunition Co. v. Nordenfelt, supra. In Morse, etc., Co. v. Morse, 103 Mass. 73, the court refuses to extend the doctrine of restraint of trade to a covenant in an assignment of a patent by an inventor 'to use his best efforts to invent improvements in the process, and to

transfer them to the buyer; to do no act which may injure the buyer or the business; and at no time to aid, assist, or encourage in any manner any competition against the same.' Speaking of this doctrine, the court says: 'It has never been extended to a business protected by a patent. Nor does it extend to a business which is a secret, and not known to the public, because the public has no right in the secret.' This is not literally an agreement in restraint of trade. It is simply a contract, which, by analogy, can be likened to one and the analogy should not be pushed beyond the reason for it. There is no presumption that such a contract is void. The presumption is in favor of the competency of the parties to make the contract, and the burden is upon the party who alleges that it is unreasonable or against public policy. In the most recent cases the validity of the contracts in partial restraint of trade is tested, not by any inflexible rule, but by their reasonableness when considered in connection with the protection necessary for the particular business and the modern methods of conducting the enterprise. The contract in this case has reference, not to all inventions which Hulse might discover, but only to improvements in cigarette machines; and the question is not whether a court of equity would compel specific performance if Hulse had conceived the invention after he had severed his relations with the company, and at a time when it did not result directly from the opportunity of his employment, but whether the court should do so in this case, where the invention was conceived while he was in the company's service, and perfected with its direct assistance, and in a case where Wright, the other party interested with him, was an agent and business manager of a department of the

company's business. The case presents circumstances and elements calling for the exercise of this equitable remedy."[135]

§ 509. Relationship of master and servant as affecting question of inventorship.

While the relationship between the employer and employee of itself cannot alter or vary the fact as to who accomplishes the inventive act,[136], many inventions cannot be perfected or reduced to practice by the inventor without the assistance of others. Where the employee is employed for the purpose of assisting the employer in embodying in physical form the invention of the employer, claims of independent inventorship made by the employee, based upon what he has done during the term of his employment, are not favored by the courts. We find the statement in the leading case that where "a person has discovered an improved principle in a machine, manufacture, or composition of matter, and employs other persons to assist him in carrying out that principle, and they, in the course of experiments arising from that employment, make valuable discoveries, ancillary to the plan and preconceived design of the employer, such suggested improvements are in general to be regarded as the property of the party who discovered the original improved principle, and may be embodied in his patent as a part of his invention. Common justice would forbid that any partial aid rendered upon such circumstances, during the progress of experiments in perfecting the improvements, should enable the person rendering the aid to appropriate to himself the entire result of the ingenuity and toil of the originator, or

135. Hulse v. Bonsack Mach. Co., 65 Fed. Rep. 864, 869, 13 C. C. A. 180.

136. Eastern Dynamite Co. v. Keystone Powder Mfg. Co., 164 Fed. Rep. 47, 55.

put in the power of any subsequent infringer to defeat the patent, under the plea that the invention was made by the assistant and not the originator of the plan."[137]

The question in each case, as to who was the inventor, must be determined by the facts. If the employer merely suggests what he desires to have accomplished, and leaves "the accomplishment of the desired end" to the employed, the relationship of master and servant is a negligible quantity.[138] Indeed, in every case, the question of actual inventorship, whether sole or joint, must be governed by the facts. No contract of employment can justify either master or servant in making a false oath to an application for letters patent.[139]

§ 510. The implied license of the master to use the inventions of the servant.

We have seen (*ante*, § 507) the distinction that must be drawn between that relationship of employer and employee which gives the employer a claim of title to the employee's inventions, and that relationship which confers upon the employer a mere license to use the inventions of the employee made in the course of his employment. We read in the leading case upon the latter relationship, the following: "When one is in the employ of another in a certain line of work, and devises an improved method or instrument for doing that work, and uses the property of his employer and the services of other employees to develop and put in practicable form his invention, and explicitly assents to the use by his employer of such invention, a jury or a court trying the facts is warranted in finding that he has so far recognized the obligations of service flowing from his em-

137. Agawam Co. v. Jordan, 7 Wall. 583, 602, 604, 19 L. Ed. 177.

138. Pardy v. J. D. Hooker Co., 148 Fed. Rep. 631, 78 C. C. A. 403.

139. Ibid.

ployment, and the benefits resulting from his use of the property, and the assistance of the coemployees of his employer, as to have given to such employer an irrevocable license to use such invention."[140]

The assignability of the license. Licenses of the kind under consideration usually are merely personal to the employer, and do not extend to an executor, administrator, or assignee, voluntary or involuntary.[141] But "the non-assignability of a license may be waived if the patentee ratifies the transfer of the license by otherwise treating the assignee as the licensee was then entitled to be treated."[142]

To what the implied license extends. The authorities are clear that in the case of a process invented by the employee under circumstances giving the employer a license to use it, "the employer may continue to practice the process for the whole term of the patent."[143] But notwithstanding the language of Solomons v. United States, 137 U. S. 342, 34 L. Ed. 667, which says that the license extends to the "invention," referring to either "an improved method or instrument," it has been held by some courts that "if the invention pertains to a machine, it is understood that only the specific machine or machines which have been so made are licensed."[144]

140. Solomons v. United States, 137 U. S. 342, 348, 34 L. Ed. 667.

141. Troy Iron & Nail Factory v. Corning, 55 U. S. (14 How.) 193, 14 L. Ed. 383; Oliver v. Rumford Chem. Works, 109 U. S. 75, 27 L. Ed. 862; Hapgood v. Hewitt, 119 U. S. 226, 30 L. Ed. 369.

142. Mr. Justice Shiras, in Lane & Bodley Co. v. Locke, 150 U. S. 193, 196, 37 L. Ed. 1049, 1050; citing Hammond v. Mason & H. Organ Co., 92 U. S. 724, 23 L. Ed. 767.

143. Lowell, J., in Wade v. Metcalf, 16 Fed. Rep. 130, 132; citing McClurg v. Kingsland, 1 How. 202, 11 L. Ed. 102; Chabot v. American Buttonhole Co., 6 Fish. 71, Fed. Case 2,567.

144. Lowell, J., in Wade v. Metcalf, 16 Fed. Rep. 130, 132; citing Pierson v. Eagle Screw Co., 3 Story 402, Fed. Cas. 11,156; Brickill v. Mayor of New York, 7 Fed. Rep. 479.

Mr. Justice Lurton, when circuit judge, dealt with this subject very clearly, in an opinion from which we draw the following: "There was some evidence tending to show that the original patterns made by Kinney (the employee) were destroyed by fire before the machines sold appellant (the employer's vendee) were made, and it has been insisted that the scope of the license should be limited by the life of the identical patterns made by Kinney. The duration and scope of a license must depend upon the nature of the invention and the circumstances out of which an implied license is presumed, and both must at last depend upon the intention of the parties. * * * The object of Babcock in employing Kinney, so far as that employment had relation to patterns for a power press, was to obtain patterns and drawings by which he, as a manufacturer of presses for the trade, might make and supply the trade with presses built on the new design and from the new patterns. This fact was well known to Kinney, and when he accepted employment and produced an improvement it must be presumed that he intended that his employer would use that improvement in such new machines as he should make while engaged in the business of supplying such machines to the trade. We cannot reasonably liken this case to the building of a machine for use. In such a case the license might well be limited to the use of the machine so long as its identity was preserved. But here Kinney was to make drawings at the expense of Babcock, and then patterns by which a working press might be made for sale and not for shop use. In McClurg v. Kingsland, 1 How. 202, 11 L. Ed. 102, the invention was for an improved mode of casting chilled rollers. The nature of the invention was such as to imply a license for the continued use of the mode during the life of the patent by the licensee. In Solomons v. United

States, 137 U. S. 342, 348, 34 L. Ed. 667, the invention was for a self-canceling stamp, which stamps were made by the government for the use of revenue agents. The license implied was not limited to the stamps made while Clark, the inventor, continued in the government service, but was held to be a broad license to make and use the stamps."[145]

§ 511. Recordation in the patent office of instruments affecting title.

What may be recorded. The statutory provision is as follows:

"Every patent or any interest therein shall be assignable in law by an instrument in writing, and the patentee or his assigns or legal representatives may in like manner grant and convey an exclusive right under his patent to the whole or any specified part of the United States. An assignment, grant, or conveyance shall be void as against any subsequent purchaser or mortgagee for a valuable consideration, without notice, unless it is recorded in the Patent Office, within three months from the date thereof. If any assignment, grant, or conveyance of any patent shall be acknowledged before any notary public of the several States or Territories or the District of Columbia, or any commissioner of the United States Circuit Court, or before any secretary of legation or consular officer authorized to administer oaths or perform notarial acts under § 1750, R. S. U. S., the certificate of such acknowledgment, under the hand and official seal of such notary or other officer, shall be prima facie evidence of the execution of

145. Withington-Cooley Mfg. Co. v. Kinney, 68 Fed. Rep. 500, 506, 507, 15 C. C. A. 531.

such assignment, grant or conveyance." (§ 4898, R. S. U. S.)

This section is confined, in the class of instruments which it admits to record, "to assignments, grants, and conveyances of interests in patents after they are issued. * * * No assignment of an unpatented invention is required by § 4895, R. S. U. S., to be recorded, unless it is an assignment on which a patent is to be issued to the assignee; and, in such case, the invention must be so identified in the assignment—by a reference to a specification, or an application, or otherwise—that there can be no mistake as to what particular invention is intended."[146] Accordingly an agreement to convey future inventions, not so identified, cannot be recorded within the scope of the statute.[147]

Effect of recordation. "The record of an instrument is not constructive notice to a subsequent purchaser unless the statute requires the instrument to be recorded."[148] The record of the Patent Office affords constructive notice; but, according to some of the cases it cannot be relied upon to make out title,[149], while according to other cases the record of the Patent Office, or certified copies of instruments recorded in the Patent

146. Blatchford, J., in Wright v. Randel, 8 Fed. Rep. 591, 599.

147. Eastern Dynamite Co. v. Keystone Powder Mfg. Co., 164 Fed. Rep. 47, 50.

148. Wright v. Randel, 8 Fed. Rep. 591, 599; New York Paper Bag Co. v. Union Paper Bag Co., 32 Fed. Rep. 783, 788; Regan Vapor Engine Co. v. Pacific Gas Engine Co., 49 Fed. Rep. 68, 1 C. C. A. 169; Eastern Dynamite Co. v. Keystone Powder Mfg. Co., 164 Fed. Rep. 47, 50.

149. Paine v. Trask, 56 Fed. Rep. 233, 5 C. C. A. 497; Mayor v. American Cable R. R., 60 Fed. Rep. 1016, 9 C. C. A. 336; Eastern Dynamite Co. v. Keystone Powder Mfg. Co., 164 Fed. Rep. 47.

Office, are evidence of title without further proof.[150] The latter line of cases are based upon the provision of § 892, R. S. U. S., that "Written or printed copies of any records, papers or drawings, belonging to the patent office * * * authenticated by the seal, and certified by the commissioner or acting commissioner, shall be evidence in all cases wherein the originals could be evidence." It is argued in the former line of cases that this section "merely dispenses with the production of the record, a certified copy from it being made the equivalent. It does not establish the due execution of genuineness of a paper which happens to be found there, which must still be proved in the usual way."[151]

§ 512. Mortgages.

The only statutory reference to mortgages on patents is contained in § 4898, R. S. U. S., in the words "an assignment, grant, or conveyance shall be void as against any subsequent purchaser or *mortgagee*, etc." Mortgages upon letters patent are subject to the usual rules concerning chattel mortgages. The Supreme Court has held that the recording of a mortgage in the Patent Office is equivalent to the delivery of possession by the patentee to the mortgagee, makes the title of the mortgagee complete against all other persons including the mortgagor, and that the mortgagee may maintain an action at law for damages for infringement, or a suit in equity for an injunction and an accounting; the court saying "Whether, in a suit brought by the mortgagee, the

150. Brooks v. Jenkins, Fed. Case 1,953; Parker v. Haworth, Fed. Case 10,738; Lee v. Blandy, Fed. Case 8,182; Dedrick v. Agricultural Co., 26 Fed. Rep. 763; Natl. Folding Box Co. v. American Paper Pail Co., 55 Fed. Rep. 488; Standard Elevator Co. v. Crane Elevator Co., 76 Fed. Rep. 767, 22 C. C. A. 549.

151. Eastern Dynamite Co. v. Keystone Mfg. Co., 164 Fed. Rep. 47, 49.

court, at the suggestion of the mortgagor, or of the mortgagee, or of the defendants, might in its discretion, and for the purpose of preventing multiplicity of suits or miscarriage of justice, permit or order the mortgagor to be joined, either as a plaintiff or as a defendant, need not be considered, because no such question is presented by this record."[152] A mortgage upon a patent is subject to a license previously granted by the mortgagor, and a recital of the existence of the license in the mortgage is sufficient notice to the mortgagee of the terms and conditions of the license.[153]

§ 513. The need of a single appellate tribunal for patent causes.

There has for many years been a persistent effort on the part of the patent bar of the United States to secure the establishment of a single court of appeals for patent causes. That special courts have been established for customs and commerce causes during the pendency of the movement for a Patent Court of Appeals is an illustration of the eccentricity of congressional legislation. The reasons for the creation of the proposed patent court have been ably briefed by a committee of the American Bar Association as follows:

"We cannot expect Congress to entertain a proposition to create a new court unless the necessity for it clearly appears. This we propose to show.

"At the end of a hundred years of existence the Supreme Court of the United States had become greatly overloaded with work. It was several years in arrears and falling further and further behind with every passing term. Patent suits were tried in the first instance

152. Waterman v. Mackenzie, 138 U. S. 252, 34 L. Ed. 923, affirming Waterman v. Mackenzie, 29 Fed. Rep. 316.

153 Waterman v. Shipman, 55 Fed. Rep. 982, 5 C. C. A. 371.

in the United States Circuit Courts and appealed from them to the Supreme Court. Those cases had multiplied until they contributed more than any other single class of litigations to produce the blockade in the Supreme Court Docket. Some enlargement of our Federal judicial force had become necessary. For ten years the subject was one of earnest consideration by lawyers and statesmen, in Congress and outside. In these discussions the American Bar Association took an influential part. The outcome was that by the Act of March 3, 1891, there were created the United States Circuit Courts of Appeals to which was assigned the greater part of the business in number of cases which had previously been appealed from the United States Circuit Courts to the Supreme Court, including patent causes. It was provided that appeals from Circuit Courts in patent cases should go to the Circuit Courts of Appeals and that the decisions of those cases there should be final except that power was reserved in the Supreme Court to direct any case to be sent to it by special order. But, of course, the Supreme Court could exercise this power only rarely, and does exercise it in extremely few cases. The result is that in a practical sense the decisions of the Circuit Courts of Appeals in patent causes are final. Those courts are independent tribunals, and are under no legal obligation to follow one another in their decisions. Their relations are very much like those of the Supreme Courts of the different states. Each treats the decisions of the others with respect as precedents, but no one is bound by the decision of any other. The result is that in patent causes we have, in effect, nine independent Supreme Courts—one for each judicial circuit. This is, on the face of it, a grave defect in our judicial system as respects the administration of the patent law. A patent is a sort of property created by

the statute with a short life of seventeen years. The right which it confers is coextensive with the United States. It is essential to justice to the patentee that if valid it shall be upheld, construed and enforced alike in all parts of the country; and it is equally essential to justice toward the public that, if it is invalid, it shall be so adjudged alike for all parts of the United States, so that the public can freely enjoy the advantages of which the owner of an invalid patent would unjustly deprive them.

"There is no other department of the law in which so many nicely balanced questions have to be decided as in the trial of patent causes, and no other in which disagreements among judges are so unavoidable. We have come now to a condition which was inevitable from the time the Circuit Courts of Appeals were created. It is impossible for those courts, by reason of their conflicting decisions, to give us that consistency and uniformity in the law which is indispensible to justice.

"It really needs no proof to make these facts apparent to a reflecting man. They are the inevitable result of the division of final jurisdiction over patent questions among so many independent courts. Let anyone consider for a moment what the situation would be if the enforcement of the patent laws were committed to the state courts. Each State Supreme Court would take its own view of the questions as they arose and would build up a system of patent law of its own, just as it has done in other departments of the law. It is to be remembered—and the point is highly important, that the practical administration of the patent law rests mainly on precedents. The statute furnishes the framework; the remainder rests on the decisions of the courts. In that way that large division of the law which may be called the common law of patents in this country has

been developed. But its growth has not ended. In the nature of things it will go on and on. And that its development may be symmetrical and wise and just it should be under the guiding control of a single court in touch with all parts of the country alike and with common jurisdiction over all the cases in their final determination.

"The most palpable proof of the evils which we are suffering under the present system would be a showing of instances. To go into that field fully would occupy more time and space than is permissible here. But a few illustrations may be stated.

"One great question relating to the effect and operation of the patent law which is open today is whether the owners of or licensees under different patents controlling patented articles of similar use which would compete in the market, if such competition were unhindered—like sewing machines, or typewriters, or automobiles, can lawfully form a combination under the protection of their patents to uphold their prices. On this subject the Circuit Court of Appeals for the Third Circuit in the case of Nat. Harrow Co. v. Hench, 83 Fed. 36 (affirming 76 Fed. 667), decided that they could not; that each patentee has his own monopoly of his own invention; but that two or more patentees cannot unite to form a new monopoly; that the public is entitled to the benefit of competition between articles covered by different patents as well as between different unpatented articles. On the other hand, the Circuit Court of Appeals for the Seventh Circuit has held in the later cases of Rubber Tire Wheel Co. v. Mil. Rub. Wks. Co., 154 Fed. 358 (reversing 142 Fed. 531) and Ind. Mfg. Co. v. J. I. Case T. M. Co., 154 Fed. 365 (reversing 148 Fed. 21), that the anti-trust statute does not apply to patented articles, and that patentees or licensees under different

patents relating to the same thing have lawful right to combine to maintain prices as a result of the monopoly conferred by the statute.

"There is thus one rule of law binding upon the citizens of the Third Circuit, comprising the States of New Jersey, Pennsylvania and Delaware, and another rule of law binding upon the citizens of Indiana, Illinois and Wisconsin of the Seventh Circuit. What the law is in the other states of the Union no one knows.

"An interesting group of cases of this sort is found in the following:

Eldred vs. Kessler, 106 Fed. 509 (C. C. A., 7th Cir., 1900).
Eldred vs. Kirkland, 130 Fed. 342 (C. C. A., 2d Cir., 1904).
Eldred vs. Breitwieser, 132 Fed. 251 (C. C. W. D. N. Y., 1904).
Kessler vs. Eldred, 206 U. S. 285, 1907.

"All this litigation was about a patent for an electric cigar lighter. Eldred sued Kessler for infringement of a patent covering that important convenience of civilized life. The defendant prevailed in the Circuit Court of Appeals for the Seventh Circuit on an issue of non-infringement covering all the claims. The court held that the patent was one of narrow scope and that, being so construed, it was not infringed by the Kessler lighter. This decision was in 1900. Eldred then brought suit on the same patent in the Second Circuit against the user of a cigar lighter similar to the Kessler lighter, but made by another manufacturer. The Circuit Court of Appeals in that circuit construed the patent broadly enough to find infringement. This involved a square conflict between the Circuit Courts of Appeals of the Second and Seventh Circuits.

"Eldred then began suit on the same patent against Breitwieser who was a user of a Kessler lighter in the Western District of New York, got a preliminary injunction against him and sent out threats of suit against Kessler's customers elsewhere. Kessler then filed a bill against Eldred in the district of his residence to enjoin him from bringing or prosecuting suits against his (Kessler's) customers anywhere on account of the use of cigar lighters covered by the decree in the original suit on the ground that as between them the question of infringement of the Eldred patent by the Kessler lighter was *res adjudicata* under the decision of the Circuit Court of Appeals for the Seventh Circuit. That case went to the Supreme Court of the United States, which held that Kessler was entitled to the injunction.

"An exactly similar situation arose in what are known as the Grant Tire Cases. A patent to one Grant for a rubber tire was held invalid by the Circuit Court of Appeals for the Sixth Circuit in Goodyear Tire & Rubber Co. vs. Rubber Tire Wheel Co., 116 Fed. 363. It was subsequently held valid by the Circuit Court of Appeals for the Second Circuit in Consol. Rub. Tire Co. vs. Firestone Tire & Rub. Co., 151 Fed. 237. A petition for a *certiorari* in the Goodyear case was denied by the Supreme Court in 187 U. S. 641.

"In obedience to the principle laid down by the Supreme Court in Kessler vs. Eldred it thus became the duty of the courts in all the circuits to treat the patent as invalid as against customers of the Ohio manufacturer, although they might (except in the Sixth) hold it valid as against users of tires made by anyone except that particular Ohio manufacturer. In the circuit in which the patent had been held valid the courts were bound to enforce it against users of tires made in that circuit and refuse to enforce it against users of the Ohio tires. Ex

actly this thing was done in the Consolidated Rubber Tire case referred to, in which an injunction was granted against the defendant *with an exception as to rubber tires and rims manufactured by the Goodyear Tire & Rubber Co.* A case of confusion worse confounded could hardly be imagined.

"An interesting sequel to the rubber tire case just cited appears in the recent case of Goodyear Rubber Co. vs. Rubber Tire Wheel Co., 164 Fed. 869. The rubber tire patentee undertook to enforce his patent against users of the Ohio manufacturer's tires in Cuba. The Ohio company applied to Judge Lurton for an injunction under the authority of the Kessler case. A restraining order was issued, but upon the hearing of the motion after notice Judge Lurton held that, while the Kessler case applied, and he had power to enjoin the patentee *in personam* against pursuing the Ohio manufacturer's customers in Cuba, it must appear in order to authorize such an injunction that the grant under which the patentee was proceeding in Cuba was the same grant which was adjudicated in the prior judgment in Ohio, and that that fact was so far in doubt that a preliminary injunction could not be allowed.

"These are illustrations of the direct results of disagreements among United States Circuit Courts of Appeals. But the indirect results of these inevitable conflicts are even more serious. A lesson on this subject may be learned from the litigation over the patent to Schroeder, No. 535,465, for an improvement in washing machines. This patent was first held valid in the first suit brought upon it by the U. S. Circuit Court of Appeals for the Eighth Circuit. It was a highly useful invention and the defendants in that case, accepting the decision as establishing the validity of the patent, bought it from the patentee. But manufacturers in other parts of the country

were so attracted by the utility of the device and so encouraged by the uncertainty of the finality of the decree in the Eighth Circuit, that they took the chances of infringement. The purchaser of the patent happened to have the money and determination to stand up for his rights and brought suit against infringers in five different States, as follows: two in Illinois; one in Wisconsin; two in New York; one in Missouri, and one in Indiana. In five of these cases appeals were taken to Circuit Courts of Appeals. The litigation began October 18, 1898, and ended with the decision of the Court of Appeals for the Seventh Circuit on March 18, 1909. In these various proceedings the time of twenty-one Federal judges was occupied in sixteen contested hearings. The printed records and briefs contained in all 10,850 pages, and the total cost amounted to over $65,000. The decisions which were reported (there were several that were not reported) will be found in the following volumes of the reports:

Schroeder vs. Brammer, 98 Fed. 880.
Benbow-Brammer Mfg. Co. vs. Simpson Mfg. Co., 132 Fed. 614.
Benbow-Brammer Mfg. Co. vs. Hefron-Tanner Co., 144 Fed. 429.
Benbow-Brammer Mfg. Co. vs. Richmond Cedar Wks., 149 Fed. 430.
Benbow-Brammer Mfg. Co. vs. Wayne Mfg. Co., 157 Fed. 559.
Benbow-Brammer Mfg. Co. vs. Straus, 158 Fed. 627.
Benbow-Brammer Mfg. Co. vs. Richmond Cedar Wks., 159 Fed. 161.
Benbow-Brammer Mfg. Co. vs. Straus et al., 166 Fed. 114.

Wayne Mfg. Co. vs. Benbow-Brammer Mfg. Co., 168 Fed. 271.
Benbow-Brammer Mfg. Co. vs. Richmond Cedar Wks., 170 Fed. 965.
Kapp vs. Benbow-Brammer Mfg. Co., 170 Fed. 967.

"All this to settle the rights of the patentee under a patent covering so little a thing as a part of a washing machine. And they have not been settled yet except that infringers appear to have given up from mere discouragement. There is good reason to believe that if the appeal in the first suit had been to such a court as is proposed in this bill, having jurisdiction coextensive with the Union, its decision would have been acquiesced in everywhere without further contention.

"The truth is that the worst effect of the existing situation is that it undermines confidence. It demoralizes the bar. A lawyer does not know how to advise his clients. It tempts both attorney and client to take chances. The law-abiding citizens who want to obey the law, who want to respect valid patents, but do not want to be terrorized into acquiescence in invalid patents, do not know what to do and cannot find out. There is but one remedy and it is in a single court of last resort in patent causes."

Perhaps the illustration afforded by the Martin windmill patent is as forcible as any of those cited in the brief just quoted from. Held valid and infringed by the Circuit Court of Appeals for the Eighth Circuit in Mast, Foos & Co. v. Dempster Mill Mfg. Co., 82 Fed. Rep. 327, 27 C. C. A. 191, an application for preliminary injunction was granted against the Stover Manufacturing Company in the Seventh Circuit, in Mast, Foos & Co. v. Stover Mfg. Co., 85 Fed. Rep. 782. Upon an appeal from the order of injunction, the Circuit Court of Appeals for the Seventh Circuit not only reversed the order but dismissed

the bill. (Mast, Foos & Co. v. Stover Mfg. Co., 89 Fed. Rep. 333, 32 C. C. A. 231.)

Upon this direct conflict between the Appellate Courts, the writ of *certiorari* was granted to review the last-named case, and in affirming the interpretation given the patent by the appellate court of the Seventh Circuit Mr. Justice Brown said:

"Plaintiff complains of the action of the Circuit Court of Appeals in refusing to follow the opinion of the Circuit Court of Appeals for the Eighth Circuit in a case of this same plaintiff against the Dempster Mill Manufacturing Company, 49 U. S. App. 508, 82 Fed. Rep. 327, 27 C. C. A. 191, and in reversing the order of the Circuit Court, which, upon the ground of comity, followed the judgment of that court with respect to the validity and scope of the patent. Its contention is, practically, that the Circuit Court of Appeals should have been governed by the prior adjudication of that court, and, so far, at least, as concerned the interlocutory motion, should have accorded it the same force and dignity as is accorded to judgments of this court. Premising that these considerations can have no application in this court—whose duty it is to review the judgments of all inferior courts, and in case of conflict to decide between them—we think the plaintiff overstates somewhat the claims of comity.

"Comity is not a rule of law, but one of practice, convenience, and expediency. It is something more than mere courtesy which implies only deference to the opinion of others, since it has a substantial value in securing uniformity of decision, and discouraging repeated litigation of the same question. But its obligation is not imperative. If it were, the indiscreet action of one court might become a precedent, increasing in weight with each successive adjudication, until the whole country was tied down to an unsound principle. Comity persuades; but

it does not command. It declares, not how a case shall be decided, but how it may with propriety be decided. It recognizes the fact that the primary duty of every court is to dispose of cases according to the law and the facts; in a word, to decide them right. In doing so, the judge is bound to determine them according to his own convictions. If he be clear in those convictions, he should follow them. It is only in cases where, in his own mind, there may be a doubt as to the soundness of his views that comity comes in play and suggests a uniformity of ruling to avoid confusion, until a higher court has settled the law. It demands of no one that he shall abdicate his individual judgment, but only that deference shall be paid to the judgments of other co-ordinate tribunals. Clearly it applies only to questions which have been actually decided, and which arose under the same facts.

"The obligation to follow the decisions of other courts in patent cases of course increases in proportion to the number of courts which have passed upon the question, and the concordance of opinion may have been so general as to become a controlling authority. So, too, if a prior adjudication has followed a final hearing upon pleadings and proofs, especially after a protracted litigation, greater weight should be given to it than if it were made upon a motion for a preliminary injunction. These are substantially the views embodied in a number of well-considered cases in the Circuit Courts and Circuit Courts of Appeals. Macbeth v. Gillinder, 54 Fed. Rep. 169; Electric Mfg. Co. v. Edison Electric Light Co., 18 U. S. App. 637, 61 Fed. Rep. 834, 10 C. C. A. 106; Edison Electric Light Co. v. Beacon Vacuum Pump & Electrical Co., 54 Fed. Rep. 678, and cases cited; Beach v. Hobbs, 82 Fed. Rep. 916, 63 U. S. App. 626, 92 Fed. Rep. 146, 34 C. C. A. 248; see, also, Newall v. Wilson, 2 De G. M. & G. 282.

"Comity, however, has no application to questions not considered by the prior court, or, in patent cases, to al-

leged anticipating devices which were not laid before that court. As to such the action of the court is purely original, though the fact that such anticipating devices were not called to the attention of the prior court is likely to open them to suspicion. It is scarcely necessary to say, however, that when the case reaches this court we should not reverse the action of the court below if we thought it correct upon the merits, though we were of the opinion it had not given sufficient weight to the doctrine of comity." [154]

What apology can there be offered for the maladministration of justice under this patent as against the Dempster Manufacturing Company, under the ban of an injunction in the Eighth Circuit? What opportunity did that company have to secure the relief from that injunction to which the event shows it was entitled? Suppose Mast, Foos & Co. had succeeded in establishing the patent in successive litigation in all the circuits save one, and by the time the adverse decision of that circuit was rendered the patent had expired; what recourse would the mulcted defendants, as in the Eighth Circuit, have had? Singly, they might have filed petitions for *certiorari*. The reports show the infinitesimal chance of such petitions being granted.

The situation is illogical, and every dictate of justice and reason demands that it be cured.

§ 514. The effect of the judicial code upon actions involving patents.

The Act of Congress of March 3, 1911, has direct relations to actions for patent infringement, in that, by its § 289 it abolishes the Circuit Courts, which have here-

154. Mast, Foos & Co. v. Stover Mfg. Co., 177 U. S. 485, 488, 44 L. Ed. 856, 858.

tofore been the courts of first instance in actions for patent infringement. See § 629, R. S. U. S., par. 9. *Qui tam* actions under § 4901, R. S. U. S., have always been within the jurisdiction of the district court, by virtue of their nature, being "suits for penalties and forfeitures incurred," under a statute of the United States. See § 563, R. S. U. S., par. 3. The Judicial Code goes into effect January 1, 1912 (see § 301, The Judicial Code), on which date its abolition of the Circuit Courts takes effect.[155]

§ 515. The jurisdiction of State Courts in actions involving patent rights.

It is provided by § 256 of the Judicial Code that "the jurisdiction vested in the courts of the United States in the cases and proceedings hereinafter mentioned, shall be exclusive of the courts of the several States; * * * Fifth. Of all cases arising under the patent-right * * * laws of the United States."[156] The exclusiveness of the Federal jurisdiction in cases involving the "infringement of a patent for an invention" is well settled.[157] A suit involving questions as to the validity and infringement of United States letters patent is one under the Federal laws, which the State courts have no jurisdiction to determine.[158] By § 24 of The Judicial Code the district courts of the United States

155. As to the constitutionality of the Act of March 3, 1911, see Hopkins, The Judicial Code, p. 1; as to the former jurisdiction of the circuit courts see Ibid. p. 7; as to the former jurisdiction of the district courts, see Ibid. p. 11.

156. A re-enactment of § 711, R. S. U. S. See Hopkins' Judicial Code, p. 213.

157. Re Hohorst, 150 U. S. 653, 661, 37 L. Ed. 1211, 1214; White v. Rankin, 144 U. S. 628, 36 L. Ed. 569; Elgin Wind Power & Pump Co. v. Nichols, 65 Fed. Rep. 215, 45 C. C. A. 49.

158. Hupfeld v. Automaton Plano Co., 66 Fed. Rep. 788, 789; Continental Store Service Co. v. Clark, 100 N. Y. 370, 3 N. E. Rep. 335.

are vested with original jurisdiction "of all suits at law or in equity arising under the patent * * * laws."[159]

The practical difficulty attendant upon the question of jurisdiction is that of determining what is a "case arising under the patent-right laws of the United States." Mr. Justice Brown has said, "to constitute such a cause the plaintiff must set up some right, title, or interest under the patent laws, or at least make it appear that some right or privilege will be defeated by one construction, or sustained by the opposite construction, of these laws."[160] Yet, notwithstanding this definition, Judge Gray has aptly said that "cases are not infrequent where, upon the facts, it is somewhat difficult to draw the jurisdictional line that distinguishes between suits arising under the patent laws and those arising under a contract, of which, however, a patent right is the subject-matter."[161]

The question is, of course, of consequence only where the plaintiff is invoking Federal jurisdiction solely by reason of the subject-matter; if the amount in controversy is sufficient (in excess of $3,000, exclusive of interest and costs; see § 24, The Judicial Code), and the necessary diversity of citizenship exists, the question is immaterial.[162]

The jurisdiction fixed by the plaintiff's pleadings, and not by those of the defendant.

In Hartell v. Tilghman, 99 U. S. (9 Otto) 547, 25 L.

159. See § 711, R. S. U. S., 1 Comp. Stat. p. 577, 4 Fed. Stat. Ann. p. 493, Pierce, Code, § 7347; Hopkins, The Judicial Code, pp. 31, 32, 49.

160. Pratt v. Paris Gaslight & Coke Co., 168 U. S. 255, 259, 42 L. Ed. 458, 460; citing Starin v. New York, 115 U. S. 248, 29 L. Ed. 388; Germania Ins. Co. v. Wisconsin, 119 U. S. 473, 30 L. Ed. 461. To the same effect, see St. Louis Street Flushing Mach. Co. v. Sanitary Street Flushing Mach. Co., 161 Fed. Rep. 725, 727, 88 C. C. A. 585.

161. Kurtz v. Straus, 106 Fed. Rep. 414, 415, 45 C. C. A. 366.

162. St. Louis Street Flushing Mach. Co. v. Sanitary Street Flushing Mach. Co., 161 Fed. Rep. 725, 727, 88 C. C. A. 585; Hopkins, The Judicial Code, pp. 31, 40.

Ed. 357, the pleadings are thus summarized by the Supreme Court.

"His bill begins by a statement that he is the original inventor and patentee of a process for cutting and engraving stone, glass, metal and other hard substances. It is the one known as the sand-blast process.

"He then sets out what we understand to be a contract with defendants for the use by the latter of his invention. He declares that defendants paid him a considerable sum for the machines necessary in the use of the invention, and also paid him the royalty which he asked, for several months, for the use of the process, which he claims to be the thing secured to him by patent. He alleges that after this defendants refused to do certain other things which he charges to have been a part of the contract, and thereupon he forbade them further to use his patent process, and now charges them as infringers.

"The defendants admit the validity of plaintiff's patent. They admit the use of it and their liability to him for its use under the contract. They set up in a plea the contract as they understand it, and the tender of all that is due to plaintiff under it, and their readiness to perform it."

The conclusion of the Supreme Court was:

"Complainant assumes that he has, under the condition of things as proved, the right in himself to abandon the contract, to treat it as a nullity, and to charge the defendants as infringers, liable as trespassers under the Act of Congress to pay both profits and damages * * * Such a case is not cognizable in a court of the United States by reason of its subject-matter, and as the parties could not sustain such a suit in the circuit court by reason of citizenship, this bill should have been dismissed.

"The decree of that court is, therefore, reversed, with directions to dismiss the bill without prejudice."

By way of criticism of the logic of that opinion the reader is referred to the dissenting opinion of Mr. Justice Bradley, concurred in by the Chief Justice and Mr. Justice Swayne. The case was decided by a bare majority of four to three, Justices Strong and Hunt not sitting. The majority opinion is merely a legal curiosity. In a case in which its doctrine was invoked, Judge Woods said:

"The bill in this case is in the customary form for infringement of letters patent, and the proposition contended for necessarily implies that the jurisdiction invoked by the filing of such a bill—of which, it is to be observed, no court except a Federal court can take cognizance—may be defeated by a plea of license which admits the use and validity of the patent sued on. If the decision in Hartell v. Tilghman ever meant that much it has been explained and limited by later decisions, which leave no doubt of the Federal jurisdiction in cases like the present." [163]

The established doctrine has been briefly stated by Judge Gray as follows:

"The complainant in this case has stated in its bill that it is the owner of the patent in suit, and derives title through an assignment from the patentee. An averment of title in the complainant must necessarily be made, and is the necessary foundation for all rights asserted or litigated by the complainant. It is an averment without which complainant has no proper standing in court. It matters not whether the title be that of the patentee, derived directly from the grant made by the government, or that of an assignee of the patentee or the assignee of an assignee. In either case it is the state-

163. Elgin Wind Power & Pump Co. v. Nichols, 65 Fed. Rep. 215, 217, 45 C. C. A. 49; citing White v. Rankin, 144 U. S. 628, 36 L. Ed. 569; Dale Tile Manufacturing Co. v. Hyatt, 125 U. S. 46, 31 L. Ed. 683; Marsh v. Nichols, Shepard & Co., 140 U. S. 344, 35 L. Ed. 413.

ment of a prima facie qualification to institute the suit, and such title, whether direct to the patentee, or derivative from him by assignment or assignments, is the creature of the patent law, and not of the common law; and, whether admitted or attacked by the opposing party, the questions raised are raised under the patent laws, and are, therefore, within the meaning of the Revised Statutes of the United States, justiceable in the circuit (now district) court."[164]

The rule is thus stated by Judge Baker:

"When a contract is made respecting a right under a patent, and the parties get into litigation, confusion has sometimes arisen over the question whether the cause of action originates in the contract or in the patent laws. The test is this: If the plaintiff is seeking a judgment for debt or damages, or a decree for cancellation or specific performance, on account of the defendant's breach of his covenants, the cause of action arises out of the contract; and, though the determination of the issue of breach or no breach may involve the interpretation of the patent and of the prior art, the insistence of the defendant that his device, according to the true construction of the patent and of the prior art, is not within the patent right granted him in the contract, cannot change the nature of the action."[165]

That the plaintiff may have an additional remedy for breach of contract does not defeat the jurisdiction of the Federal Courts.

Where the plaintiff brings suit for infringement in the Federal courts, it is immaterial that the pleadings or proofs disclose the fact that there has been a breach of

164. Atherton Mach. Co. v. Atwood-Morrison Co., 102 Fed. Rep. 949, 956, 43 C. C. A. 72. Applied in Kurtz v. Straus, 106 Fed. Rep. 414, 415, 45 C. C. A. 366.

165. Victor Talking Mach. Co. v. The Fair, 123 Fed. Rep. 424, 425, 61 C. C. A. 58.

contract on the part of the defendant, in addition to his act of infringement. "The remedy of the complainant may be a double one; for liability may rest either upon the broken contract, or for the tortious use of the invention."[166] The court of appeals of the Eighth Circuit has thus expressed this principle, "It is, we think, the general rule in patent cases that a limited license conveys only the rights defined therein, and that if the licensee makes any other or different use, either as to time or place, than that authorized by the license, he becomes an infringer, and his limited license is no justification."[167]

§ 516. The relationship of receivers to patent rights.

Upon the appointment of a receiver for a partnership or corporation, the assignable patent rights of the partnership or corporation do not become vested in the receiver,[168] unless so decreed by an order under a creditors' bill.[169] In the case of bankruptcy under the present Bankruptcy Act the trustee in bankruptcy is vested with the title of the bankrupt to all interests in patents or patent rights, as of the date of the adjudication in bankruptcy (Act of July 1, 1898, c. 541, § 70, 30 Stat. at L. 565, 3 Comp. Stat., p. 3451).[169a] But as to receiver-

166. Lurton, J., in Heaton-Peninsular Button-Fastener Co. v. Eureka Specialty Co., 77 Fed. Rep. 288, 291, 25 C. C. A. 267, 35 L. R. A. 728.

167. St. Louis Street Flushing Mach. Co. v. Sanitary Street Flushing Mach. Co., 178 Fed. Rep. 923, 927, —— C. C. A. ——.

168. Newton v. Buck, 72 Fed. Rep. 777, 779. Contra, see Douglass v. Campbell, 24 Ohio Cir. Ct. 241; Matter of Woven Tape Skirt Co., 12 Hun. 111.

169. Gordon v. Anthony, 16 Blatchf. 234, 248, Fed. Case 5605; Ager v. Murray, 105 U. S. 126, 26 L. Ed. 942; Jewett v. Atwood Suspender Co., 100 Fed. Rep. 647.

169a. Under this section, it has been held in one case that where the bankrupt has made an invention, but has not applied for a patent, the bankruptcy court may compel him to make such application and assign it to the trustee in bankruptcy. Fisher v. Cushman, 103 Fed. Rep. 860, 43 C. C. A. 381, 51 L. R. A. 292. Following this decision it has been held that an application for patent is "property" which passes

ships, title does not vest in the receiver save when it is so specifically decreed, and he consequently cannot convey title to a purchaser.[170] Though, as Judge Wallace has said, "the rule that a receiver cannot convey title to a patent unless the owner of the legal title joins, does not apply to the transfer of a mere equitable title."[171]

Inasmuch as a license is personal to the licensee, and not assignable unless made so in express terms,[172] "an executor, administrator, or assignee, voluntary or involuntary, does not succeed to the privilege of the grant."[173]

Receivers as defendants.

As a general rule, no action can be brought against a receiver without the leave of the court under which he holds his appointment.[174] But he may be sued for patent infringement, when acting as receiver under the appointment of a state court, without the leave of that court. In an early case Judge Treat based his

to the trustee in bankruptcy under this section, even where the invention has been made by the president and manager of a bankrupt corporation, under circumstances indicating that the invention lawfully belongs to the corporation. In re Cantelo Mfg. Co., 185 Fed. Rep. 276. This decision is opposed by cases which hold that the section refers only to letters patent actually issued at the date of the adjudication in bankruptcy, although the application was made before bankruptcy, and was pending at the time of the adjudication. In re McDonnell, 101 Fed. Rep. 239; In re Dann, 129 Fed. Rep. 495.

170. Gordon v. Anthony, 16 Blatchf. 234, 248; Newton v. Buck, 72 Fed. Rep. 777, 779.

171. Adams v. Howard, 22 Fed. Rep. 656, 658.

172. Hapgood v. Hewitt, 119 U. S. 226, 30 L. Ed. 369; Adams v. Howard, 22 Fed. Rep. 656; Waterman v. Shipman, 55 Fed. Rep. 983, 5 C. C. A. 371.

173. Treat, J., in Curran v. Craig, 22 Fed. Rep. 101; citing Oliver v. Rumford Chem. Works, 109 U. S. 75, 27 L. Ed. 862. To the same effect, see Waterman v. Shipman, 55 Fed. Rep. 983, 5 C. C. A. 371.

174. Barton v. Barbour, 104 U. S. 126, 26 L. Ed. 672; American L. & T. Co. v. Central Vermont R. Co., 84 Fed. Rep. 917.

ruling upon the ground that the receiver had taken possession of the alleged infringing property without authority, and was "personally liable for the trespass committed."[175] In a later case, Judge Lacombe held the same way, but put his ruling upon broader grounds.

"The defendant De Frece was appointed receiver of the defendant corporation by the chancery court of New Jersey, and subsequently was appointed ancillary receiver by the Supreme Court of this State. Motion to dismiss as to him is made upon the ground that complainant has not obtained leave to sue him from either of the courts appointing him. Leave was obtained from the New York court, but the order giving it has since been vacated. The general rule undoubtedly is that a court will not entertain jurisdiction of a suit against a receiver appointed by another court until the appointing court has given its consent that he be sued. This rule rests on principles of comity, and is considered for the protection of the receiver as an officer of the court appointing him against unnecessary and expensive litigation touching controversies wherein it may often be within the power of the appointing court to give ample relief to any person aggrieved. But the rule has its qualifications, and the case at bar does not fall within it. This suit is one under the Federal laws, involving questions as to the validity and infringement of United States letters patent, which the state courts have no jurisdiction to determine[176] The Federal courts cannot assent to the proposition that they have no jurisdiction, without leave of the State courts first obtained, to enjoin individuals, even though they be officers of State courts, from infringing upon the rights of the owner of a patent. To

175. Curran v. Craig, 22 Fed. Rep. 101.

176. Citing Continental Store Service Co. v. Clark, 100 N. Y. 370, 3 N. E. 335.

do so would be to abdicate functions which, under the Federal Constitution, are confided to them, and to them exclusively, by the Federal laws. Such a refusal would leave it within the power of the State courts to exclude the holder of rights granted to him by the United States from the only tribunals which have jurisdiction to vindicate those rights. The reasoning in Barron v. Burnside, 121 U. S. 186, 30 L. Ed. 915, and other similar authorities applies to such a case as this."[177]

A receiver of a licensee is not liable as an infringer for selling goods made under a license from the plaintiff, which license was terminated because of the receivership proceeding.[178]

Receivers in patent causes.

While the practice has been rarely resorted to, there can be no doubt of the propriety of appointing a receiver for an insolvent defendant's business pending a suit for patent infringement, where the case does not warrant preliminary injunction. In making such an order, Judge Betts said: "A proper case is established against * * * defendants for the appointment of a receiver. It is shown that both of them have debts outstanding to a very large amount, for machines sold by them * * *. The plaintiff, if his right is finally established, will be entitled to a large part of these moneys, and both defendants are proved to be irresponsible in their circumstances. The peril of a fund in litigation is cause for the interference of the court to secure and protect it by the appointment of a receiver."[179]

§ 517. The liability of States and counties for patent infringement.

A State government is not liable for patent infringement.[180] That such actions arise solely under the patent

177. Hupfeld v. Automaton Piano Co., 66 Fed. Rep. 788, 789.

178. Montross v. Mable, 30 Fed. Rep. 234; Emigh v. Chamberlain, 2 Fisher 192, Fed. Case 4447.

179. Parkhurst v. Kinsman, 1 Fish. 180, 2 Blatchf. 78, Fed. Case 10,760.

180. Standard Fireproofing Co. v. Toole, 122 Fed. Rep. 649, 652.

laws of the United States is immaterial. The Supreme Court has said "that a State cannot be sued by a citizen of another State, or of a foreign state, on the mere ground that the case is one arising under the Constitution or laws of the United States, is clearly established by the decisions of this court."[181] In so holding, the court was merely applying the Eleventh Amendment of the Constitution, which provides that "the judicial power of the United States shall not be construed to extend to any suit in law or equity, commenced or prosecuted against one of the United States by citizens of another State, or by citizens or subjects of any foreign State."

In the early case of Jacobs v. Hamilton County, 1 Bond 500, Fed. Case 7, 161, it was held upon the authority of Hamilton County v. Mighels, 7 Ohio St. 110, that a county was not liable for the infringement of a patent.[182] In the later cases this ruling has been disapproved, Judge Jackson saying "the State could not, by either direct or indirect legislation, exempt its counties from liability for the infringement of patents."[183]

§ 518. Liability of public officers for patent infringement.

Where suit for patent infringement is brought against an officer of a State who has performed the alleged infringing acts in the course of his official duties, the suit is virtually against the State itself, and cannot be maintained.[184]

181. Mr. Justice Bradley, in Hans v. Louisiana, 134 U. S. 1, 33 L. Ed. 842; citing Louisiana v. Jumel, 107 U. S. 711, 27 L. Ed. 448; Hagood v. Southern, 117 U. S. 52, 29 L. Ed. 805; Ex parte Ayers, 123 U. S. 443, 31 L. Ed. 216.

182. To the same effect, see May v. County of Juneau, 30 Fed. Rep. 241.

183. May v. Logan County, 30 Fed. Rep. 250, 260. To the same effect, see May v. County of Fon du Lac, 27 Fed. Rep. 695; May v. Mercer County, 30 Fed. Rep. 246; May v. County of Ralls, 31 Fed. Rep. 473.

184. Hans v. Louisiana, 134 U. S. 1, 33 L. Ed. 842; Standard Fireproofing Co. v Toole, 122 Fed. Rep. 649, 652.

So where the defendant is an officer of the United States, who has acted only for and on behalf of the government, suit for patent infringement against him "is substantially a suit against the United States itself, which cannot be maintained under the guise of a suit against its officers and agents, except in the manner provided by law."[185]

Belknap v. Schild, 161 U. S. 10, 40 L. Ed. 599, was, however, the first case in which the jurisdiction of the United States Courts in cases of this kind was squarely denied. In James v. Campbell (104 U. S. 356, 26 L. Ed. 786) and Hollister v. Benedict Mfg. Co. (113 U. S. 59, 28 L. Ed. 901) that court entertained jurisdiction and dismissed the bills upon the merits. And even after Belknap v. Schild, the Supreme Court again assumed the jurisdiction, and dismissed the bill upon its merits, in Dashiell v. Grosvenor (162 U. S. 425, 40 L. Ed. 1025). This remarkable situation continued to perplex the bench and bar,[186] until Congress, by the Act of June 25, 1910,[187] cut the Gordian knot by giving a remedy against the government for patent infringement.

Of course the fact that a contractor infringes a patent in the course of executing a contract with a State or with the United States does not exempt him from liability for the infringement.[188]

§ 519. Reduction to Practice.

The question of reduction to practice is attended with some difficulty, much of which is due to the oft-quoted dictum of Mr. Justice Clifford: "He is the first inventor,

185. James v. Campbell, 104 U. S. 359, 26 L. Ed. 786.

186. International Postal Supply Co. v. Bruce, 114 Fed. Rep. 509.

187. Hopkins, The Judicial Code, p. 153.

188. Brady v. Atlantic Works, 4 Cliff. 408, Fed. Case 1794; reversed on other grounds in Atlantic Works v. Brady, 107 U. S. 192, 27 L. Ed. 438.

in the sense of the patent law, and entitled to a patent for his invention, who first perfected and adapted the same to use, and it is well settled that until the invention is so perfected and adapted to use it is not patentable under the patent laws."[188] The dictum of the latter part of this sentence is not supported by either of the two cases cited in support of it, if it is to be construed literally. If it means actual practice, as distinguished from the capacity for being practiced, it is not sound; and it should be read in the latter sense. Much of the confusion in the cases would have been avoided had it always been kept in mind that the invention is perfected when it is ready for the use of those skilled in the art. Reduction to practice means this and nothing more. Of course, the right of the first producer of the completed invention is another matter. He may abandon the invention or he may forfeit his right to a patent by two years' public use, or he may sleep upon his rights while another independent inventor conceives, reduces to practice, and applies for a patent with diligence.

The application as constructive reduction to practice.

The filing of the application for patent is a constructive reduction to practice,[189] and its weight and benefit as such is not affected by the fact that it subsequently requires and receives amendment.[190]

The benefit of the filing date, as concerns reduction to practice, is extended to divisional applications[191] even though the divisional application was filed after the time limit for amendment had expired.[192] So in interference

188. Seymour v. Osborne, 78 U. S. (11 Wall.) 516, 20 L. Ed. 33. Citing Washburn v. Gould, 3 Story 122, Fed. Case 17, 214; Cahoon v. Ring, 1 Cliff. 612, Fed. Case 2, 292.

189. Lotz v. Kenny, 31 App. D. C. 205, 135 Off. Gaz. 1801.

190. Hulett v. Long, 15 App. D. C. 284, 89 Off. Gaz. 1141.

191. Lotz v. Kenny, 31 App. D. C. 205, 135 Off. Gaz. 1801.

192. Duryea v. Rice, 28 App. D. C. 423, 126 Off. Gaz. 1357.

proceedings each of the parties is entitled to his filing date as the date of his invention [193] and he may carry back his date of actual invention as far prior to that filing date as the facts justify;[194] as can the plaintiff in infringement litigation,[195] provided neither has been guilty of laches [196] or concealment,[197] after his conception of the invention.

What constitutes reduction to practice.

It is not necessary to constitute reduction to practice, in the case of a machine, as a general rule, that it has actually performed work, provided that it was capable of doing the work for which it was designed.[198] But the application of this rule depends upon the character of the machine involved. Thus in the case of a tobacco-stemming machine "which did fairly good work, but occasionally permitted some of the tobacco leaves to pass the blades without having the stems properly removed," it was held that "this inaccuracy, or this imperfection, as we may call it, would not necessarily have prevented the machine from coming into universal use, even though it had never been perfected so as to permit no leaf to pass unstemmed. The escaping leaves might well be gathered and thrown back; and the machine might have been found remarkably useful, notwithstanding the imperfection." And in this connection the general rule has been expressed to be that "when a machine accomplishes its purpose in a manner reasonably satisfactory to practical men and fairly promising good results, although not then

193. Christie v. Seybold, 54 Off. Gaz. 957.

194. Consolidated Ry. Co. v. Adams & Westlake Co., 161 Fed. Rep. 343, 88 C. C. A. 351.

195. Locke v. Boch, 17 App. D. C. 75, 93 Off. Gaz. 1722.

196. Christie v. Seybold, 55 Fed. Rep. 69, 76, 5 C. C. A. 33.

197. Thomson v. Weston, 19 App. D. C. 373, 99 Off. Gaz. 864.

198. Troy Iron & Nail Factory v. Odiorne, 17 How. 73, 15 L. Ed. 37.

constructed with thorough mechanical skill in all its parts, it may be regarded as a successful reduction to practice."[199] So it is no objection to the efficiency of a device claimed to be a reduction to practice, that it was half the size of the commercially practicable machine.[200] Whether, when the nature of the machine requires actual working to complete its reduction to practice, its working must be made under the conditions of the service for which it is intended, again depends upn the nature of the function which it is intended to perform. Judge Shepard has thus summarized the cases. "Just what does amount to reduction to practice of a machine, as contra-distinguished from unsatisfactory and abandoned experiments, presents a question of constant difficulty in this class of cases, and depends, chiefly, upon the special circumstances of each case in which it is sought to be established. A rule cannot be laid down in one case to govern all others. At one time it may be held reduction to practice, where the machine, though defective in mechanical construction and working crudely in practical, public trials, nevertheless demonstrates its practical efficacy and utility, and the subsequent failure to perfect by the application of the necessary mechanical skill, has been satisfactorily accounted for, as in cases like that of Coffee v. Guerrant (68 O. G. 279; 3 App. D. C. 497). Again it may be held as falling short of reduction to practice, where a machine, though skillfully constructed, at great expense, has only been tested by the inventor once in the presence of a witness, and then all testimony fails in respect of its subsequent use for the only purpose of its alleged invention, as in cases like that of Reichenbach v. Kelley (94 Off. Gaz. 1185) and others therein

199. Morris, J., in McKenzie v. Cummings, 112 Off. Gaz. 1481, 24 App. D. C. 137, interpreting Coffee v. Guerrant, 68 Off. Gaz. 279, 3 App. D. C. 497.

200. Gallagher v. Hein, 25 App. D. C. 77, 115 Off. Gaz. 1330.

cited."[201] Thus where the novelty resides in the specific details of a new device of an old type, actual use may be dispensed with altogether; but if the device is of a new type, whose value in practice is not obvious, practical operation is necessary to complete its reduction to practice.[202] The simplicity of the device, as well as its purpose and efficiency, may be so obvious that an illustrative model, without actual use or test, may be quite as efficacious as a perfected device subjected to actual test.[203] The environment of the inventor may be considered in determining what constitutes reduction to practice. Where the inventor was a machinery manufacturer, and not engaged in manufacturing matches, the fact that he tested the match machine of his invention with uncoated splints, or dummies, instead of matches, was held to be no objection to the sufficiency of his reduction to practice.[204] On the other hand, a preliminary test of a gun by government officers, not made under the conditions of actual service, even though it resulted in an order sending the gun to the proving-grounds for a complete test, was held not to be a reduction to practice.[205]

"No patentee is held, in reducing his patent to application, to strictly and entirely follow the mere mechanical device shown in his drawings of the patent. He may deviate, so long as he does not violate the principle involved."[206]

As to a process, its reduction to practice consists in its actual performance; wherefore the construction of a device for practicing the invention is not a reduction to

201. Latham v. Armat, 17 App. D. C. 345, 95 Off. Gaz. 232.

202. Paul v. Hess, 24 App. D. C. 562, 115 Off. Gaz. 251.

203. Loomis v. Hauser, 19 App. D. C. 401, 99 Off. Gaz. 1172.

204. Wyman v. Donnelly, 21 App. D. C. 81, 104 Off. Gaz. 310.

205. Dashiell v. Tasker, 21 App. D. C. 64, 103 Off. Gaz. 2174.

206. Blodgett, J., in Weir v. North Chicago Rolling Mill Co., 14 Fed. Rep. 42.

practice.[207] As to designs, their reduction to practice is effected by the application of the design to any material; and no practical use in a mechanical sense is necessary.[208]

Diligence in reduction to practice.

The general doctrine as to diligence has been thus comprehensively treated by Judge Morris. "If there is any provision of our Federal Constitution which more than any other is intended to give practical effect to that portion of the preamble to that instrument which recites that one of its six avowed purposes is to promote the general welfare, it is that clause which vests in the Congress of the Federal Union the power:

> "'To promote the progress of science and useful arts, by securing for limited times, to authors and inventors the exclusive right to their respective writings and discoveries.'

"The provision, it will be noticed, is not to benefit the inventor primarily, but the public. The purpose is:

> 'to promote the progress of science and useful arts,'

which are necessarily for the people at large, and this result is to be reached in the shape of a bounty to inventors by the offer to them of a monopoly for a limited time. The interests of the public are therefore the primary consideration, and to these the privileges granted to inventors are secondary and subordinate. The consideration of the exclusive right secured to the inventor is the present and prospective benefit to accrue to the public from the use of the invention, and when that consideration fails or when the purpose is thwarted by the in-

207. Croskey v. Atterbury, 9 App. D. C. 207, 76 Off. Gaz. 163.

208. Tyler v. St. Amand, 17 App. D. C. 464, 94 Off. Gaz. 1969.

ventor the exclusive right ceases and is determined. When the inventor in any manner or for any reason refuses to give to the public the benefit of his invention, the public are entitled to withdraw from him the special protection accorded to him for his discovery. On this principle the inventor is required to be diligent in reducing his conception or invention to practice, and it is usually the first who reduces to practice and not the first who conceives that is entitled in law to be regarded as the inventor. On this principle all our laws on the subject are based. By them a premium is placed upon diligence, and delay requires to be excused, and a delay of two years is in many cases regarded as an abandonment to the public. Even a much shorter delay without sufficient explanation or excuse is often regarded as evidence of laches, such as should preclude one guilty of it from advantage or benefit under the law. Can one who has made an invention and who has locked it up in the secrets of his own exclusive knowledge and who produces it only when some rival inventor has entered the field be held to have acted in accordance with the policy of the law or with the spirit and purpose of the constitutional provision? Such action, or inaction, as we might more properly term it, not only contravenes the interests of the public, but also operates to injure the rival inventor who in the meantime enters the field of invention upon the faith of the conditions as they appear to exist and upon which he is entitled to rely. Such rival inventor expends his time, his efforts, and his money in the elaboration of his conception in ignorance of the fact that any one else has been in the same field before him, and he goes into the Patent Office only to be confronted after several months of effort there with the claim of some one else, who then comes forward for the first time and alleges that he had the same invention long before. Probably such claimant is not barred by any statute from

making his claim, and if he sufficiently proves it he and not his competitor will be entitled to the patent, for it is to the first inventor, the first to conceive and to reduce into practice, that the law awards priority. But such conditions make it imperative upon him that he should prove his claim beyond all reasonable doubt, and the Patent Office and the court are justified in presuming in such cases that what is claimed to be reduction to practice is no more than mere experiment until the contrary is clearly shown."[200]

Upon the question of diligence, President Taft, when Circuit Judge, reviewed the reasoning of the authorities as follows: "It is obvious * * * that the man who first reduces an invention to practice is prima facie the first and true inventor, but that the man who first conceives, and, in a mental sense, first invents, a machine, art, or composition of matter, may date his patentable invention back to the time of its conception, if he connects the conception with its reduction to practice by reasonable diligence on his part, so that they are substantially one continuous act. The burden is on the second reducer to practice to show the prior conception, and to establish the connection between that conception and his reduction to practice by proof of due diligence. It has sometimes been held, in the decisions in the Patent Office, that the necessity for diligence on the part of the first conceiver does not arise until the date of the second conception; but this, we think, cannot be supported on principle. The diligence of the first reducer to practice is necessarily immaterial. It is not a race of diligence between the two inventors in the sense that the right to the patent is to be determined by comparing the diligence of the two, be-

209. Warner v. Smith, 13 App. D. C. 111; 84 Off. Gaz. 311.

cause the first reducer to practice, no matter what his diligence or want of it, is prior in right unless the first conceiver was using reasonable diligence at the time of the second conception and the first reduction to practice. The language of the statute (section 4920) in the use of the imperfect tense, 'was using reasonable diligence,' shows the legislative intent to confer a prior right on a first conceiver in a case where, after his mental act of invention, and pending his diligent reduction to practice, another inventor enters the field and perfects the invention before his rival. The reasonable diligence of the first conceiver must be pending at the time of the second conception, and must therefore be prior to it. Reasonable diligence by the first conceiver, beginning when his rival enters the field, could only carry his invention back to the date of the second conception, and in the race from that time the second conceiver must win because of his first reduction to practice. Milward v. Barnes, 11 O. G. 1060. The elaborate opinion of the commissioner of patents, Mr. Mitchell, in the interference proceeding between Christie and Seybold, reported in 54 O. G. 957, cites all the authorities, and is quite convincing on this point. We fully concur therein. As Christie reduced the invention to practice nearly a year before Seybold's press was made, the burden is on Seybold to show that from the time of his original conception, which antedated that of Christie, he was using reasonable diligence in adapting and perfecting his idea to practical use. Has he sustained that burden? It is quite clear to us that he has not. The question of reasonable diligence in any case depends, of course, upon all the circumstances. A complicated invention, requiring many experiments and much study to give it practical form, would reasonably delay a reduction to practice after the first conception for a greater length of time than where the idea and the machine embodying it were of a simple character. Then,

too, the sickness of the inventor, his property, and his engagement in other inventions of a similar kind are all circumstances, which may affect the question of reasonable diligence."[210]

The burden of proof as to reduction to practice.

The burden of proof as to reduction to practice in interference proceedings is initially fixed by the respective filing dates upon the junior party. The degree of proof varies with the circumstances. Where the junior party files his application after the issuance of the patent of the other party, the burden is upon him to establish his case by proof beyond a reasonable doubt.[211] As between employer and employee, where the employee claims an improvement to have been devised by him while working upon the general conception of the employer, the burden is usually upon him to show that the invention is his own, regardless of the question of priority in filing dates.[212]

In infringement litigation, the question of reduction to practice arises as follows. The plaintiff relies upon the prima facies of his patent. The initial burden of establishing the existence of an anticipating device is on the defendant. When the defendant has established the prior existence of the anticipating device, as of a date prior to the application for the patent in suit, the burden shifts to the plaintiff to carry his date of invention back to antedate the alleged anticipation.

The cases have been thus summarized by Judge Seaman:

"With the above-mentioned facts of complete anticipation in construction and use—known to the patentee several months prior to his application for a pat-

210. Christie v. Seybold, 55 Fed. Rep. 69, 76, 5 C. C. A. 33.

211. Cherney v. Clauss, 25 App. D. C. 15, 116 Off. Gaz. 597.

212. Robinson v. McCormick, 29 App. D. C. 98, 128 Off. Gaz. 3289.

ent—settled by the evidence, we are of opinion that the presumption of invention by the patentee, which arises from the patent application, and grant, is overcome, prima facie, by such anticipation in Sherbondy's prima facie conception reduced to practice, so that the burden of proof is transferred to the patentee to establish priority in fact.[213] This view of shifting the burden of proof in such event is upheld in well-considered opinions at the circuit.[214] In Clark Thread Co. v. Willimantic Linen Co., 140 U. S. 481, 492, 35 L. Ed. 521, however, the opinion by Mr. Justice Bradley states the rule in like case, in qualified form, as requiring 'the plaintiffs in rebuttal, to show, if not with equal certainty, yet to the satisfaction of the court, that the invention' claimed in the patent preceded the date thus shown with certainty, in respect of a device which anticipated the patent dates."[215]

§ 520. The dissolution of the preliminary injunction because of complainant's inequitable conduct.

The conduct of a complainant who has been granted a preliminary injunction may be ground for dissolving the injunction. Just as laches in making the motion to dissolve is ground for overruling that motion,[216] so the failure of the plaintiff to prosecute the cause with due diligence is ground for dissolving the temporary injunction which is protecting him during his delay.[217]

213. Citing Westinghouse Electric & Mfg. Co. v. Catskill Illuminating & Power Co., 121 Fed. Rep. 831, 834, 58 C. C. A. 167.

214. Citing Webster Loom Co. v. Higgins, 15 Blatchf. 446, Fed. Case 17, 342; Thayer v. Hart, Jr., 20 Fed. Rep. 693; Westinghouse Elec. & Mfg. Co. v. Saranac Lake Elec. L. Co., 108 Fed. Rep. 221, 222; Westinghouse, etc., v. Mutual Life Ins. Co., 129 Fed. Rep. 213, 216.

215. Consolidated Ry. Elec. Lighting & Equipment Co. v. Adams & Westlake Co., 161 Fed. Rep. 343, 350, 88 C. C. A. 355

216. Read v. Consequa, 4 Wash. C. C. 174, Fed. Case 11,606.

217. Read v. Consequa, 4 Wash. C. C. 174, Fed. Case 11, 606; Bradley v. Reed, Fed. Case 1,785.

Again, the use made of the preliminary order by the complainant, by way of threats against others than the defendant, may serve to dissolve the injunction. In such a case Judge Blodgett said:

"It appears that immediately on the entry of the order in this case, circulars and notices were sent outside this district to parties engaged in the trade, dealing with the complainants' competitors, intended to alarm such persons and injure the trade of competing manufacturers. This strikes me as hardly justifiable under the circumstances. I think complainants, if they have faith in their patents, should make their attack directly on such competitors as they claim are infringing their patents, and contest the question squarely with them. This class of goods has now, according to the proofs, gone into very general use as an article of food, and can be found for sale in most family groceries; and it seems to me not the right course to attack these dealers, and annoy and intimidate them by threats of patent suits. The course taken by complainants suggests the charge that they intended to obtain many of the advantages of an injunction by harassing and interfering with the business of a rival without taking the risk of a direct suit with that rival, when they would be responsible for the consequence of their act. Such may not have been their purpose, but it is liable to such construction. The injunction is dissolved."[218]

Certainly, when the complainant sees fit to misrepresent the scope of the injunctive order, or to use it as the basis of mere intimidating threats, the injunction should be dissolved, even though entered by consent.[219]

218. Wilson Packing Co. v. Clap, 13 Off. Gaz. 368, Fed. Case 17, 850.

219. Meyers v. Skinner, 186 Fed. Rep. 347.

In sustaining a motion to dissolve an injunction *pendente lite* entered by consent, Judge Chatfield has said:

"The complainant has apparently used the injunction *pendente lite*, obtained by consent upon the claims referred to, for the purpose of advertising, and for the legitimate purpose of warning the trade generally, as well as individual customers of the defendants, that he will protect his rights under the patent against infringers, but has intimated that he will seek to establish rights against so-called contributory infringers. He has thus warned customers of the defendant, MacFarland, that the complainant will seek to prosecute and punish any purchaser or user of a product of any machine which infringes the patent in suit, even though the product be not covered by the patent.

"Not only would it seem with reference to such a patent, that there is no basis upon the record as it stands for a warning against becoming contributory infringers, so far as parties are concerned, who do not knowingly assist or participate in or encourage the infringing use of the patent itself, but the general condition of the testimony, and the relation which the defendant MacFarland seems to have had with the acts claimed to be infringements by the complainant, do not seem to justify the use which has been made of the injunction obtained by consent.

"Although the defendant MacFarland did, however, consent to the issuance of this injunction, upon claim by him that he had no intention of infringing in any way, and as the consent was given after the court had refused to grant such an injunction upon an unadjudicated patent, if diligent action was taken toward final hearing, it seems to the court that he (defendant MacFarland) is justified in asking that, so far as he is concerned, the injunction *pendente lite* be vacated, upon condition that the

case be promptly completed. The complainant may have the right to ask for immediate restoration of the injunction, if any action occur on the part of McFarland which would indicate an attempt on his part to make use of any device that can legitimately be held to infringe the claims in question, or to improperly advertise this opinion and decision, beyond making it known that the injunction *pendente lite* has been vacated as to MacFarland, unless he be guilty of evident infringement, assuming that the complainant's rights will be fully established, both as to validity or prior infringement."[220]

§ 521. Segregation of the invention from its environment for purposes of construction.

As is well known to those familiar with inventions, the addition of insignificant improvements to complex mechanisms frequently serves as the basis of stock-selling fraud, and imposition upon purchasers of the machine; the relevancy of the small patented feature to the unpatented (or infringing) entire machine being unknown to the victim. There is also the danger, in construing the patent relating to the minor patented detail, of confusing it with the entire mechanism of which it is a part. This danger has been pointed out and illustrated by Judge Coxe in two of his admirable opinions, delivered over twenty years apart (1888-1911), from which we extract the following:

"The patentee appears to employ a wire signal-bell to summon a servant in a railway car; but can it be that it required an exercise of the inventive faculties to do this, in view of the fact that the identical apparatus had previously been used for the identical purpose in dwelling-houses, hotels, and steamboats? The additional fact

220. Meyers v. Skinner, 186 Fed. Rep. 348.

should also be remembered that similar signaling appliances had been used in horse cars and in railway cars. The only novel feature that can by the most liberal construction be discovered, is the location of the apparatus in railway cars. The operation is the same; the result is the same. If it be invention to place a jingle bell in a passenger car, then each successive applicant who finds a new situation for such a bell is entitled to the rewards of an inventor. If this claim is held to be valid, with what consistency could a patent be refused to a person who, for the first time, should connect in a similar manner a row of bath-houses at the sea-side, or the boxes in a theatre, or the tables in a restaurant? To remove a bell from the state-room of a passenger steamer, and place it in the state-room of a passenger car, requires no more of the inventive faculty than to take a steam whistle from a tug-boat and place it on a woolen mill—no more than to place a doctor's speaking-tube at the front door of a lawyer. The supreme court has over and over again decided that it was not invention to find a new place for an old device without change in the result, or in the manner of operation."[221]

"In approaching this subject it is wise to disabuse the mind of the notion that an exceptionally high order of intellect is required because the improvements relate to type-writers. The Remington machines in evidence have a notice prominently printed thereon stating that 'This machine is protected by sixty-seven American and foreign patents.' There is danger that the court in contemplating a machine so complicated and delicately organized may become imbued with the idea that no changes or additions can be made unless the party making them

221. Mann's Boudoir Car Co. v. Monarch Parlor Sleeping Car Co., 34 Fed. Rep. 132.

is possessed of an extraordinary degree of ingenuity. Mechanical skill is not converted into invention because it is applied to a structure showing the highest degree of inventive genius. If the problem be to construct a key for a lock, it can make no difference whether the lock be attached to a typewriter or an ice box.'' [222]

In the views thus expressed, the learned court is amply supported by authority.[223]

§ 522. Is the repairer an infringer?

We have heretofore considered,[224] the extent to which the purchaser of a patented mechanism may replace or repair its worn parts. The liability of the person who merely makes repairs under contract with the owner of the device is a different matter, concerning which there is much less authority in the cases, and which is attended with a degree of difficulty in its determination.

In a case in which the defendant was an engineering works which repaired boilers, made under complainant's patent, by installing new tubes, in one case supplying "4 out of 19 tiers," Judge Thomas, after analyzing the cases relating to replacement and repair by the owner, deduces the general doctrine that "a part of a combination may not be replaced by the purchaser when it is the vital element of the combination, in fact, and in regard to patentability, especially when it is not intended to be of short life by the action of external forces thereon. The generalization," he continues, "is probably imperfect, but it is considered that the spirit of the law, as expressed in the decisions, is at least that a part that gives sole patentability to the combination may not be

222. Hillard v. Remington Typewriter Co., 186 Fed. Rep. 337, — C. C. A. —.

223. Aron v. Manhattan R. Co., 132 U. S. 84, 33 L. Ed. 272; Stephenson v. Brooklyn R. R. Co., 114 U. S. 149, 29 L. Ed. 58.

224. *Ante*, p. 334.

replaced by a purchaser without the patentee's consent."[225] From this premise he argues that the repairer's "attitude is that of a trespasser," under the facts of the case at bar. "It is not as if a tube or a few tubes had been broken, and in an exigency the purchaser applied to a local mechanic to supply them. What would be equitable in such an instance need not be determined, for here the defendant has entered the business for the general purpose of supplying tubes, few or many, and should be enjoined from such general business."[226]

Judge Archbald has carried the doctrine a little further.

"No doubt, within certain bounds," is his opinion, "a patented article may be repaired without making the repairer an infringer, but not where it is done for one who is. It is only where the device in patented form has come lawfully into the hands of the person for or by whom it is repaired that this is the case. In other words, if one without right constructs or disposes of an infringing machine, it affords no protection to another to have merely repaired it; the repairer, by supplying an essential part of the patented combination, contributing by so much to the perpetuation of the infringement."[227] With which doctrine we agree, with this important proviso; that the repairer, to be held as a contributory infringer, must be shown to have that intent which is a vital element in contributory infringement, under the rules heretofore discussed.[228]

§ 523. Sales to complainant's agent as evidence of infringement.

Mr. Justice Curtis, in an action at law for damages for patent infringement, where the evidence (on an

225. Morrin v. Robert White Engineering Works, 138 Fed. Rep. 68-81.

226. Ibid, at page 82.

227. Union Special Mach. Co. v. Maimin, 161 Fed. Rep. 748, 750.

228. *Ante*, pp. 328, 331.

agreed statement) showed a single sale of matches "of the value of six cents" to an agent of the plaintiff, held that a sale to the agent was a sale to the plaintiff; that the common law rule of "*volenti non fit injuria*" applied, and that such a sale is not an infringement, and that judgment should go for the defendant.[229]

This doctrine may be sound, but if it is it must be limited to the action at law. Where the thing made in infringement of the plaintiff's patent is on hand for sale by the defendant, it is certainly a mere quibble that it was sold to the complainant's agent, instead of some other purchaser, so far as the transaction furnishes evidence upon which an injunction should be based. In such a case Judge Lacombe has said "there is no force in the suggestion that the sale was made to a purchaser who bought in the interest of complainants, in order to secure proof of infringement. We are not now dealing with any question of damages, but with the mere fact of sale in conformity to the patent. The sale of such a device is an act of infringement, although it may be made under such circumstances that complainants cannot recover damages for it."[230]

§ 524. A single sale as basis for injunction.

A single sale, as Judge Lacombe has said, "may, in connection with other proof, be persuasive evidence of other sales, and convincing proof of an intention to sell whenever the opportunity of doing so without detection is presented."[231] This doctrine is sound. A single sale of a machine or article of manufacture or composition of matter will always suffice as the basis of injunction,

229. Byam v. Bullard, 1 Curtis 100, Fed. Case 2, 262.

230. Chicago Pneumatic Tool Co. v. Phila. Pneumatic Tool Co., 118 Fed. Rep. 852.

231. Lever Bros., Ltd., v. Passfield, 88 Fed. Rep. 484.

assuming that it was not prepared at the instance of the complainant. There are many instances of injunction being awarded upon proof of a single sale.[232] In what has been said it should be understood that we are considering only the question of injunction, preliminary or on final hearing, and without regard to the question of the right to an accounting. In fact, the rule has been properly limited by Judge Coxe, who says "a single sale made in circumstances which indicate a readiness to make other similar sales upon application is sufficient to make out a prima facie case."[233] It must be borne in mind that unless the prima facie case indicates that a substantial recovery of profits may be had, the court may refuse to order an accounting;[234] notwithstanding the general rule that the right to an account of profits is incidental to the right to an injunction.[235]

What has been said is entirely consistent with Judge Lurton's doctrine, "that a single infringement by making and selling a single infringing machine would not justify the interposition of a court of equity for the purpose of restraining further infringement by the making and sale of other infringing machines, if it appeared clearly that there was no reason to apprehend any further infringement "[236] The cases in which the sale of a single machine made by the defendant would not give reason to apprehend further infringement are, of course, rare and extraordinary.

232. Chicago Pneumatic Tool Co .v. Phila. Pneumatic Tool Co., 118 Fed. Rep. 852; Wooster v. Clark, 9 Fed. Rep. 854.

233. Hutter v. De Q. Bottle Stopper Co., 128 Fed. Rep. 283, 63 C. C. A. 652.

234. Ludington v. Leonard, 127 Fed. Rep. 155, 62 C. C. A. 269.

235. Stevens v. Gladding, 58 U. S. 447, 15 L. Ed. 155.

236. Johnson v. Foos Mfg. Co., 141 Fed. Rep. 73, 72 C. C. A. 123.

§ 525. Single violation of injunction.

In contempt proceedings, while the number of instances of violation of the injunction has no bearing upon the question of the technical guilt or innocence of the defendant, a single violation, in the absence of evidence that it was but one of a contemplated series of violations of the order, will never be punished as severely as will the commission of a series of such acts. The courts are inclined, in the case of a single violation of the injunction to consider favorably the defence that it was inadvertent, or accidental; while these defenses will be usually disregarded when the offense is repeated.[237] Thus, in a case where the defendant was charged with a single violation of an injunctive order, Judge Lacombe said "the court is not disposed to discredit the affidavits submitted by defendants, which show that the occurrence was a sporadic one, not likely to occur again, and not planned by defendants as a cover for deliberate, or even careless, infringement. Of course, if the same thing should happen again, that circumstance might indicate design."[238] In a case where the violations of the order were repeated, Judge Reed said "the evidence leaves no room to doubt that the defendant himself sold a number of these phonograph records, and received the pay therefor after the preliminary injunction was served upon him. The violation of the writ was deliberate and intentional, and cannot be overlooked. Parties must know that writs of injunction are not issued by the courts as a mere pastime and for their own pleasure, to be observed or not as those against whom they are issued may elect, but are issued to protect and preserve the property rights of parties

237. Christensen Engineering Co. v. Westinghouse Air Brake Company, 135 Fed. Rep. 774, 780, 68 C. C. A. 476.

238. Motion Picture Patents Co. v. Laemmle, 189 Fed. Rep. 641.

pending litigation between them; and those against whom they are issued and upon whom they are served must be given to understand that any intentional violation of them will not be tolerated, but will be punished, and by imprisonment if necessary, to vindicate the authority of the court and protect the rights of parties involved in the controversy in which they are issued."[239]

§ 526. Testimony taken out of time.

The time fixed by the Sixty-ninth Rule in Equity for the taking of testimony is three months; the rule reading, "Three months and no more shall be allowed for the taking of testimony after the cause is at issue, unless the court or a judge thereof shall, upon special cause shown by either party, enlarge the time; and no testimony taken after such period shall be allowed to be read in evidence at the hearing. Immediately upon the return of the commissions and depositions containing the testimony into the clerk's office, publication thereof may be ordered in the clerk's office, by any judge of the court upon due notice to the parties, or it may be enlarged, as he may deem reasonable under all the circumstances. But by consent of the parties publication of the testimony may at any time pass in the clerk's office, such consent being in writing, and a copy thereof entered in the order book or indorsed upon the deposition or testimony."

The three months' period allowed by this rule is for the taking of the testimony of all of the parties.[240] Mr. Justice Blatchford in an early case said, "Rule 69 is imperative, that no testimony taken after time shall be al-

239. New Jersey Patent Co. v. Martin, 186 Fed. Rep. 513, 517.

240. Ingle v. Jones, 9 Wall. 486, 19 L. Ed. 621.

lowed to be read at the hearing."[241] A little later it was held by Judge Wheeler that testimony taken and filed out of time, in the absence of a motion to suppress, would be considered upon the hearing, notwithstanding the objection of the opposing party to its consideration.[242]

The failure of a complainant to take any proof for a long time after the filing of the bill has always been ground for a motion to dismiss,[243] but the practice generally is that of accommodation between counsel, under their agreement to extend the time for taking testimony, and is for the most part by verbal stipulation, and without procuring any order of extension from the court. This is undeniably loose practice, but it has obtained to such an extent as to be recognized by the courts. Thus, Judge Lacombe has said, "Whatever may be the condition elsewhere, it became apparent long since that in this district it is very rarely that either side desires or expects to complete its proofs within ninety days. Very often it is not physically possible for them to do so. Of course, the court has always been willing to entertain a motion to enlarge the time, and to grant it, if both sides agree, or if good cause be shown.

"In order to avoid a multiplicity of such motions, it gradually became the settled practice here to assume that both sides had agreed to an enlargement when, during the ninety days, neither completed their proof, but testimony was taken without objection after the ninety days expired, or when neither side put in any evidence at all within the time limited, and neither side had moved to apportion the time, and defendant had not moved either to set the cause down for final hearing on bill and answer

241. Wooster v. Clark, 9 Fed. Rep. 854.

242. Matthews v. Spangenberg, 19 Fed. Rep. 823.

243. Mackaye v. Mallory, 80 Fed. Rep. 256.

or to dismiss it for failure to prosecute. This ruling has been made many times, but apparently the brief memoranda have not got into the reports, since defendant says he has not found any such statement of the practice."[244]

§ 527. Letters patent as the subject of eminent domain.

The right of eminent domain extends both to real property and personal property. It has been referred to by the United States Supreme Court as "the power of appropriating private property to public uses vested in the General Government—its right of eminent domain, which Vattel defines to be the right of disposing, in case of necessity and for the public safety, of all the wealth of the country."[245]

Does this right of eminent domain extend to letters patent for invention? If it does, it is solely the right of the United States, and cannot be transferred to a State.[246]

From the inception of the British patent system until 1883, the Crown might make whatever use it pleased of any inventions without any recognition of any right in the inventor or the patentee.[247] But by the Act of 1883, § 27, it was provided,

1. "A patent shall have to all intents the like effects as against her Majesty the Queen, her heirs and successors, as it has against a subject.

2. "But the officers or authorities administering any department of the service of the Crown may, by themselves, their agents, contractors,[248] or others, at any time after the application, use the invention for the services of the Crown on terms to be before or after the use there-

244. Jackson v. Wolverine Copper Mining Co., 186 Fed. Rep. 643.

245. United States v. Jones, 109 U. S. 513, 27 L. Ed. 1015.

246. Ibid.

247. Feather v. Rex, 6 B. & S. 257.

248. Dixon v. The London Small Arms Co., 1875, L. R. 10 Q. B. 130; L. R. 1 App. Cas. 641.

of agreed on, with the approval of the Treasury, between those officers or authorities and the patentee, or, in default of such agreement, on such terms as may be settled by the Treasury after hearing all parties interested."

The obligation of Sovereignty to make compensation for the use of an invention without the consent of the inventor or patentee, does not contravene the right of eminent domain, or negative its existence. The United States Supreme Court has held that "the provision found in the Fifth Amendment to the Federal Constitution, and in the Constitutions of the several States, for just compensation for the property taken, is merely a limitation upon the use of the power (of eminent domain). It is no part of the power itself, but a condition upon which the power may be exercised."[249]

The Act of June 25, 1910, 36 Stat. at L., p. 851, provides:

"That whenever an invention described in and covered by a patent of the United States shall hereafter be used by the United States without license of the owner thereof or lawful right to use the same, such owner may recover reasonable compensation for such use by suit in the Court of Claims: *Provided, however,* That said Court of Claims shall not entertain a suit or award compensation under the provisions of this Act where the claim for compensation is based on the use by the United States of any article heretofore owned, leased, used by, or in the possession of the United States; *Provided further,* That in any such suit the United States may avail itself of any and all defenses, general or special, which might be pleaded by a defendant in an action for infringement, as set forth in Title Sixty of the Revised Statutes, or otherwise: *And provided further,* that the benefits

249. United States v. Jones, 109 U. S. 513, 27 L. Ed. 1015.

of this Act shall not inure to any patentee, who, when he makes such claim is in the employment or service of the Government of the United States; or the assignee of any such patentee; nor shall this Act apply to any device discovered or invented by such employee during the time of his employment or service."

Under the doctrine just alluded to, this Act is entirely in harmony with the theory of the right of the Government of the United States to exercise the power of eminent domain over letters patent "in case of necessity and for the public safety." The existence of this right has been judicially affirmed by the Circuit Court of Appeals for the Fourth Circuit in a notable opinion from which we take the following:

"We think that the consent of the owner of a patented device, while it is desirable, and should be obtained, if it conveniently and reasonably can, is not positively necessary in order to enable the United States to use the invention described in the letters patent, particularly in cases where it relates to the mode of construction of implements of warfare required by the government, and indispensable to the armament of its vessels of war. Such right to take and use the property of the citizen for government purposes is indisputable, an inborn element of sovereign power essential to the independence and perpetuity of the nation. * * * The fifth amendment to the Constitution of the United States contains the provision that private property shall not be taken for public use without just compensation, and this we must consider as an implied assertion that on making such compensation it may be so taken. It will be noted that this is not a restriction of the power to take private property for public use, but that it is a requirement that when such property is so taken just compensation shall be made therefor to the owner. That incident of sovereignty—

the right to take—belonging to every independent government is not disturbed, nor is the manner in which such right is to be exercised, or the mode by which the proper compensation is to be ascertained and paid, set forth. And because Congress has provided by statutes a procedure for the condemnation of private property required for public purposes in certain instances, and not in others, we are not therefore to infer that the power to take does not exist as to the other matters; nor should we construe such legislation as a limitation of that power relative to other cases of like character not embraced in such enactments. In other words, the nonuser of a power is not to be used to disprove its existence.

"The title the individual citizen has to his property is good as against all other citizens, but it must yield to the necessity of the government, and submit to the social requirements and rights of the general public; and this right of the government to protect itself and defend its own is not to be controlled by any other power, nor is it to depend on the consent of any person, company, or corporation. The only restriction, as we have already remarked, is the constitutional requirement that just compensation shall be made to the owner for property so taken. The proper mode of proceeding in order to secure compensation for private property taken for public use without the consent of the owner, and in the absence of legal action for condemnation, has received judicial consideration, the Supreme Court of the United States having at different times plainly indicated the same, particularly in cases where the government has used an invention without the permission of the owner of the letters patent protecting the same."[250]

250. Goff, J., in Dashiell v. Grosvenor, 66 Fed. Rep. 334, 337, 338, 13 C. C. A. 593, 27 L. R. A. 67; affirmed, 162 U. S. 425, 40 L. Ed. 1025. Citing Kohl v. U. S., 91 U. S. 367, 374, 23 L. Ed. 449; James v. Campbell, 104 U. S. 356, 26 L. Ed. 786; U. S. v. Great Falls

§ 528. The effect upon letters patent of the co-pendency of the applications on which they were issued.

In considering the effect, in the construction and comparison of two or more letters patent, of the fact that the applications upon which they were issued were contemporaneously pending in the Patent Office, we must base our examination of the law upon the elementary proposition that each of the issued patents is attended by the presumption that it was providently issued. In the language of Judge Putnam, "The law is settled that, as to every point touching the validity of a claim, the patent itself is prima facie evidence, although in many cases the presumption which it affords is very slight and purely technical."[251]

As between any two patents, the fact that both were issued is "virtually a decision by the Patent Office that there was a substantial difference between the two inventions,"[252] and that the difference between them is patentable;[253] and these presumptions attach to them even though the applications upon which they are based were not pending at the same time in the Patent Office.[254]

Where patents result from co-pending applications, without an interference having been instituted between them, "it is obvious that it must have been the judgment

Mfg. Co., 112 U. S. 645, 656, 28 L. Ed. 846; Hollister v. Benedict & B. Mfg. Co., 113 U. S. 59, 28 L. Ed. 901; U. S. v. Palmer, 128 U. S. 262, 32 L. Ed. 442; also, the following cases in the court of claims: Schillinger's Case, 24 Ct. Cl. 278, 298; Gill's Case, 25 Ct. Cl. 415; Berdan's Case, 26 Ct. Cl. 48.

251. Chase v. Fillebrown, 58 Fed. Rep. 374, 376.

252. Ricks, J., in Keuffel v. Lufkin Rule Co., 74 Fed. Rep. 553, 555.

253. Miller v. Eagle Mfg. Co., 151 U. S. 186, 38 L. Ed. 121; Ransome v. Hyatt, 69 Fed. Rep. 148, 16 C. C. A. 185.

254. Ney v. Ney Mfg. Co., 69 Fed. Rep. 405, 16 C. C. A. 293.

of the officials (of the Patent Office) that there was no occasion for an interference."[255]

In the case of co-pending applications, where the purpose of the invention was the same in each application, and where the principal parts of the respective machines described were substantially similar, the Supreme Court has held that it was evidently "the judgment of the Office that the distinguishing features were to be found in some of the smaller and, perhaps, less important devices described and claimed."[256]

But despite the technical presumptions to which we have adverted, where the court concludes that both patents "are for the same thing, so far as any inventive quality is concerned, and that only one of them can stand," it becomes necessary for the court to determine the question of priority of invention between the patents, in order to determine which of them is valid.[257]

As between the co-pending applications of the same inventor, the law is well settled that his omission to claim what he describes in one application will not operate as a disclaimer or an abandonment of the matter not claimed provided that the matter in question is properly and adequately claimed in his other co-pending application.[258]

A companion rule to the one just stated is that under such circumstances neither of the inventor's patents can be used to anticipate the other. "Even where each of

255. Boyd v. Janesville Hay Tool Co., 158 U. S. 260, 261, 39 L. Ed. 973, 975.

256. Boyd v. Janesville Hay Tool Co., 158 U. S. 260, 261, 39 L. Ed. 973, 975. Following Burns v. Meyer, 100 U. S. 671, 25 L. Ed. 738.

257. Brooks v. Sacks, 81 Fed. Rep. 403, 405, 26 C. C. A. 456.

258. Thomson-Houston Elec. Co. v. Elmira R. Co., 71 Fed. Rep. 396; Kinnear Mfg. Co. v. Wilson, 142 Fed. Rep. 970, 74 C. C. A. 232; Suffolk Co. v. Hayden, 3 Wall. 315, 18 L. Ed. 76; Barbed Wire Case, 143 U. S. 275, 36 L. Ed. 154.

several applications which subsequently ripen into patents to the same inventor discloses all the inventions claimed in all the applications, and they are all pending at the same time, no one of the applications or patents can be used to anticipate any of the claims of the others which it does not itself claim and secure."[259]

Where one of a series of co-pending applications of the same inventor is attacked by the defense of prior public use, that defense may be met, and the patent saved, by showing that the invention was described in another of the co-pending applications, which was filed at a time when the bar of public use had not been created.[260]

The defense of double patenting does not apply to either of a series of patents issued upon co-pending applications, where each has claims distinct from those of the others; and in this regard, it is immaterial whether the broader patent issues before or after the others. "When the patent first granted is distinctly and only for an improvement on another invention which is already the subject of a prior application then pending, and on which a later patent is granted, the patent for the improvement in no wise interferes with the other application or the patent issued thereon, for the reason that the patents are for separate and distinct inventions. In just such a case as this we held that the later patent, being one for the generic invention, was not invalidated by reason of the issue of a previous patent in which improvements upon the other only had been patented. We had already so held in Thompson-Houston Electric Co. v.

259. Sanborn, J., in Anderson v. Collins, 122 Fed. Rep. 451, 458, 58 C. C. A. 669. Following Graham v. Geneva Lake Crawford Mfg. Co., 11 Fed. Rep. 138; Graham v. McCormick, 11 Fed. Rep. 859; Westinghouse Elec. & Mfg. Co. v. Dayton Fan & Motor Co., 106 Fed. Rep. 724; Ide v. Trorlicht, Duncker & Rennard Carpet Co., 115 Fed. Rep. 137, 53 C. C. A. 341.

260. Victor Talking Machine Co. v. American Graphophone Co., 145 Fed. Rep. 350, 76 C. C. A. 180.

Ohio Brass Co., 80 Fed. Rep. 712, 26 C. C. A. 107. It is true that in the applications for these patents for improvements there was no express disclaimer or renunciation of the matter of the former application. But that was unnecessary. The application was pending and being prosecuted in the Patent Office, and the fact that the applicant for the improvement patents did not intend to release his former invention to the public was as well understood as if he had in express terms said so. In order to explain the basis of the improvement patents, it was necessary to state what the improvement was upon, and how it fitted it. Having done this, he claimed what was new, and thereby distinguished what his patent was intended to include."[261]

§ 529. Limitation of actions to compel the grant of letters patent.

We have heretofore considered the pleading and practice in proceedings under § 4915, R. S. U. S., to compel the grant of letters patent. That section provides no limitation of time within which the action must be brought. The Supreme Court, however, has by construction provided a limitation, in the following way. It has construed the proceeding under § 4915, R. S. U. S., to be a part of the application. "Although, as was said by this court in Butterworth v. U. S., 112 U. S. 50, 61, 28 L. Ed. 656, 659,[262] the proceeding by bill in equity, under section 4915, on the refusal to grant an application for a patent, intends a suit according to the ordinary course of equity practice and procedure, and is not a technical appeal from the Patent Office, nor confined to the case as made

261. Severens, J., in Cleveland Foundry Co. v. Detroit Vapor Stove Co., 131 Fed. Rep. 853, 858, 68 C. C. A. 233.

262. Citing Whipple v. Miner, 15 Fed. Rep. 117; Ex parte Squire, 3 Ban. & Ard. 133, Fed. Case 13269; Butler v. Shaw, 21 Fed. Rep. 321.

in the record of that office, but is prepared and heard upon all competent evidence adduced and upon the whole merits, yet the proceeding is, in fact and necessity, a part of the application for the patent."[263]

Being a part of the application, it follows that the statutory limitation as to amendments applies to the time for filing the suit; and the limitation is as follows:

Section 4894, R. S. U. S. "All applications for patents shall be completed and prepared for examination within one year after the filing of the application, and in default thereof, or upon failure of the applicant to prosecute the same within one year after any action therein, of which notice shall have been given to the applicant, they shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner of Patents that such delay was unavoidable."

Prior to its amendment, § 4894, R. S. U. S., provided a two years' period for amendment; and under the section as it then stood the Supreme Court held, "The presumption of abandonment, under section 4894, unless it is shown that the delay in prosecuting the application for two years and more after the last prior action, of which notice was given to the applicant, was unavoidable, exists as fully in regard to that branch of the application involved in the remedy by bill in equity as in regard to any other part of the application, whether so much of it as is strictly within the Patent Office, or so much of it as consists of an appeal to the Supreme Court under section 4911. The decision of the court on a bill in equity becomes, equally with the judgment of the Supreme Court of the District of Columbia on a direct appeal under section 4911, the decision of the Patent Office and is to gov-

263. Blatchford, J., in Gandy v. Marble, 122 U. S. 432, 30 L. Ed. 1223.

ern the action of the commissioner. It is, therefore, clearly a branch of the application for the patent, and to be governed by the rule as to laches and delay declared by section 4894 to be attendant upon the application."[264]

The same application has been made of the section as amended, in an opinion in which Judge Rellstab says of the question of delay, "'unavoidable,' as defined by the lexicographers, means inevitable; a condition of affairs impossible to avert. Perhaps the word as here used is not to be given such a strict meaning; but certainly it was intended to penalize a year's delay due simply to negligence. The legislative purpose was to spur the litigants to activity. To delay without cause, or, when the cause is completely within the control of the party charged with the duty to act, the failure to act, is neglect, and negligence is antithetical to unavoidableness. * * * Failure to prosecute within the year because of clerical error in noting the dates, mistaking the remedy to obtain a new hearing, sickness for only a part of the limited period, mislaying the papers, as well as neglect of the attorney to prosecute, contrary to desire of applicant, have been held by the Patent Office tribunals as not unavoidable."[265]

§ 530. The complainant's liability to the defendant on the dissolution of a preliminary injunction.

We have heretofore referred to the practice of exacting security from the defendant in lieu of a preliminary

264. Blatchford, J., in Gandy v. Marble, 122 U. S. 432, 30 L. Ed. 1223.

265. Westinghouse Elec. & Mfg. Co. v. Ohio Brass Co., 186 Fed. Rep. 518, 520. Following Ex parte Warren, 96 Off. Gaz. 2410; Ex parte Collins, 97 Off. Gaz. 1372; Ex parte Bohlecke, 97 Off. Gaz. 2743; Ex parte Fritts, 101 Off. Gaz. 1131; Ex parte Beecher, 101 Off. Gaz. 1132; Ex parte McElroy, 101 Off. Gaz. 2823; Ex parte Miller, 105 Off. Gaz. 2057; Ex parte Marconi, 108 Off. Gaz. 796; Ex parte Clausen, 118 Off. Gaz. 838; Ex parte Block, 119 Off. Gaz. 963; Ex parte Hess, 126 Off. Gaz. 3041.

injunction.[266] In this section we will deal with the liability of the complainant upon the dissolution of the preliminary injunction, whether or not a bond has been exacted of the complainant.

As to the execution of such bonds, Mr. Justice Bradley has said:

"It is a settled rule of the court of chancery, in acting on applications for injunctions, to regard the comparative injury which would be sustained by the defendant, if an injunction were granted, and by the complainant, if it were refused. And if the legal right is doubtful, either in point of law or of fact, the court is always reluctant to take a course which may result in material injury to either party; for the damage arising from the act of the court itself is *dammum absque injuria*, for which there is no redress except a decree for the costs of the suit, or, in a proper case, an action for malicious prosecution. To remedy this difficulty, the court, in the exercise of its discretion, frequently resorts to the expedient of imposing terms and conditions upon the party at whose instance it proposes to act. The power to impose such conditions is founded upon and arises from the discretion which the court has in such cases, to grant or not to grant the injunction applied for. It is a power inherent in the court, as a court of equity, and has been exercised from time immemorial. The older authorities refer to numerous instances in which it has been exercised."[267]

The liability where bond is given.

In the case from which we have just quoted, Mr. Justice Bradley says "where no bond or undertaking has been required, it is clear that the court has no power to award damages sustained by either party in conse-

266. *Ante*, p. 538.

267. Russell v. Farley, 105 U. S. 433, 26 L. Ed. 1062.

quence of the litigation, except by making such a decree in reference to the cost of the suit as may be equitable and just."[268] In another case the same learned judge said:

"By the law of Louisiana damages may be recovered for suing out an injunction without just cause, independently of a bond. Florance v. Nixon, 3 La. 291. But this cannot be done in the United States Courts. Without a bond no damages can be recovered at all. Without a bond for the payment of damages or other obligation of like effect, a party against whom an injunction wrongfully issues can recover nothing but costs, unless he can make out a case of malicious prosecution. It is only by reason of the bond and upon the bond, that he can recover anything."[269]

Judge Blodgett, however, has pointed out that the absence of a bond does not always preclude a recovery of damages by the defendant upon a dissolution of a preliminary injunction.

"The power of court of equity, on application for a preliminary injunction *pendente lite* to require from the complainant a bond to indemnify the defendant sought to be enjoined, as a condition on which such an injunction is granted, is too well established to be subject to question at this day. Probably the better authority is that if a preliminary injunction is granted after notice and hearing, without the requirement of a bond, the defendant is remediless, except in cases where the defendant is able to show that the complainant had no probable cause for the writ, and obtained it by imposition upon the court."[270]

268. Ibid.

269. Meyers v Block, 120 U. S. 206, 30 L. Ed. 642.

270. Tobey Furniture Company v. Colby, 35 Fed. Rep. 532. Citing Gorton v. Brown, 27 Ill. 489, 81 Am. Dec. 245; Sturgis v. Knapp, 33 Vt. 486; Cox v. Taylor's Adm's, 10 B. Mon. (Ky.) 17. To the same effect see Scheck v. Kelly, 95 Fed.

The rule thus expressed relates to cases involving an order granting a preliminary injunction, without more. But liability to respond to damages in the event of the ultimate dissolution of the preliminary injunction may be imposed upon the complainant by the language of the court's order. Thus Judge Drummond has said, "The court orders the injunction, prescribes the terms upon which it shall be issued, and may require a bond, stipulation, or undertaking as a condition upon which it shall be issued or not according to its own view of the circumstances of the case."[271]

An illustrative order ran as follows: "It is ordered that the order for preliminary injunction, entered herein on the 17th instant, be, and the same is, hereby modified by adding the following, to-wit: It is further ordered that the complainant pay the defendant such resulting damages as it may sustain in case it be finally decided that said injunction ought not to have been granted."

Upon a final decree dissolving the injunction and dismissing the bill of complaint whereon it was issued for want of equity, in the case in which said order was made, Judge Kohlsaat added the following clause to the order of dismissal; "said cause coming on to be heard upon the motion of defendant to cause an accounting to be had to ascertain what, if any, damages defendant has sustained by reason of the wrongful issuance of said injunction, it is ordered that said application for damages be referred to a master in chancery of this court to ascertain the same, and report to the court his finding in the premises."[272]

Rep. 941; City of St. Louis v. St. Louis Gas Light Co., 82 Mo. 354; National Phonograph Co. v. American Graphophone Co., 136 Fed. Rep. 231.

271. Lea v. Deakin, 13 Fed. Rep. 514.

272. Mica Insulator Co. v. Commercial Mica Co., 157 Fed. Rep. 92, 96.

Where there is a bond.

Where a bond is given as a condition of granting a preliminary injunction, such a bond creates no liability upon the part of the surety for damages occasioned to a person who is a stranger to the suit, by the injunction.[273] When the injunction is dissolved, the damages will be assessed by the court in the same proceeding.[274] Judge Taft said of the procedure to assess damages upon the injunction bond, "in such a proceeding, at least when the amount of recovery is uncertain, the sureties must have notice and their day in court before the amount of damages is fixed against them."[275]

In the same case he held that where the jurisdictional amount was sufficient, the Federal Court had jurisdiction in an action for damages upon the bond "on the ground that the plaintiff is enforcing rights secured to him under the Constitution and the laws of the United States."[276]

The Federal courts have held uniformly that an injunction bond, in the absence of a specific covenant to that effect, is not liable for the payment of counsel fees of the successful defendant.[277] This rule is at variance with that of the State courts of many of the states; and for

273. Hays v. Fidelity & Deposit Co., 112 Fed. Rep. 872, 50 C. C. A. 569.

274. Deakin v. Stanton, 3 Fed. Rep. 435; Lea v. Deakin, 13 Fed. Rep. 514; Coosaw Mining Co. v. Farmers' Mining Co., 51 Fed. Rep. 107; Lamb v. Ewing, 54 Fed. Rep. 269, 4 C. C. A. 320; West v. East Coast Cedar Co., 113 Fed. Rep. 742, 51 C. C. A. 416. The early rule was otherwise. Bein v. Heath, 12 How. 168, 13 L. Ed. 939. That the court has power to assess the damages, but may refuse to do so, and may leave the injured party to his remedy at law, see Russell v. Farley, 105 U. S. 433, 26 L. Ed. 1060.

275. Leslie v. Brown, 90 Fed. Rep. 171, 174, 32 C. C. A. 556.

276. Ibid.

277. Bein v. Heath, 12 How. 168, 13 L. Ed. 939; Oelrichs v. Spain, 15 Wall. 211, 21 L. Ed. 43; Browning v. Porter, 12 Fed. Rep. 460; The Alice, 12 Fed. Rep. 502; Jacobus v. Monongahela State Bank, 35 Fed. Rep. 396; Fidelity Ins. T. & S. D. Co. v. Roanoke Iron Co., 91 Fed. Rep. 21.

that reason cases are found in the books where the suit to enforce the obligation of an injunction bond given in a Federal court was brought in a State court, for the evident purpose of obtaining the benefit of a rule of damages which would enable the plaintiff to collect his counsel fees. Upon one of such cases being taken by writ of error to the Supreme Court of the United States from the Supreme Court of Kansas, Mr. Justice (now Chief Justice) White said:

"It is strenuously urged * * * that although the rule against allowing attorneys' fees in actions on injunction bonds was * * * settled by this court adversely to the right to recover such fees, as the local law was to the contrary, the injunction bond given in the Federal court must be enforced, not by the law of the forum in which it was given, but according to the rule of the local law. This proposition again, however, but embodies the contention that the question of the allowance of attorneys' fees involved no Federal question. * * * For if it be true, and it undoubtedly is, that the giving of such a bond was an act done pursuant to an authority exercised under the Constitution and laws of the United States, it must follow that the bond so taken is to be interpreted with reference to the authority under which it was given, and the principles of jurisprudence controlling such authority, and not by the local law. * * * Now it is at once conceded that the decision by a State court of a question of local or of general law involving no Federal element does not as a matter of course present a Federal question. But where, on the contrary, a Federal element is specially averred and essentially involved, the duty of this court to apply to such Federal questior

its own conceptions of the general law we think is incontrovertible."[278]

In view of the rule thus laid down, the successful defendant in the injunction proceeding cannot evade the Federal rule by bringing action upon the bond in the State court, and it would therefore be of no pertinence to here enumerate the decisions of the State courts which permit counsel fees to be awarded as part of the damages.

In advance of the liability against the bond becoming finally established, the surety cannot maintain a bill in equity in the nature of a bill *quia timet* to procure a decree against his principal upon the bond to indemnify the surety against apprehended danger of loss. This rule obtains even where there exists the usual indemnity agreement exacted by a surety company, "to indemnify and keep indemnified the said company from and against any and all loss, costs, charges, suits, damages, counsel fees, and expenses of whatever kind or nature which said company shall or may, for any cause at any time, sustain or incur, or be put to, for or by reason or in consequence of said company having entered into or executed said bond;" the common law rule being that "whenever a surety signs an obligation with a principal, the law raises an implied agreement to indemnify the surety against all loss and damage by reason of his suretyship."[279]

§ 531. The comparative effect of laches on motions for preliminary injunction and on final hearing.

There seems to be a rather hopeless conflict between

278. Tullock v. Mulvane, 184 U. S. 497, 512, 46 L. Ed. 657, 666. Followed in Missouri, K. & T. R. Co. v. Elliott, 184 U. S. 530, 46 L. Ed. 673.

279. American Bonding & T. Co. v. Logansport & W. V. Gas Co., 95 Fed. Rep. 49.

the cases which hold long-continued laches to be an absolute bar to relief in equity, and those cases which hold that a degree of laches which will preclude the granting of a preliminary injunction will not be a bar to the granting of injunctive relief upon final hearing. Yet the confusion is more apparent than real.

Judge Sawyer said "this doctrine of laches, as I understand it, is, generally, applicable to preliminary injunction, only. When, upon a final hearing, a party, clearly, appears to be entitled to an injunction, unless he has been guilty of laches, I apprehend that, as a general rule, the injunction, as a part of his complete remedy, would not, ordinarily, be denied on the ground of laches alone. It is quite possible that a case may arise where laches, surrounded and attended by other qualifying circumstances, may render it inequitable to grant an injunction, as a part of the relief afforded at the final hearing."[280]

In another case the defense of laches was denied because the defendants had been defiant in their infringement, having been former licensees, and hence had not been misled by the inaction of the complainant.[281]

The distinguishing rule, as stated by Judge Wales, is that "knowledge of and long continued acquiescence by a complainant in an infringement may, in special cases, be fatal on a motion for a preliminary injunction, but will not, on a final hearing, prevent the court from granting such relief as may be just and equitable."[282]

This expression of the rule leaves little, if anything, to be desired. It is neither just or equitable to enjoin

280. Brush Elec. Co. v. Electric Imp. Co., 45 Fed. Rep. 241.

281. Kittle v. Hall, 29 Fed. Rep. 508, 512.

282. Taylor v. Sawyer Spindle Co., 75 Fed. Rep. 301, 303, 22 C. C. A. 203; followed in Empire Cream Separator Co. v. Sears, Roebuck & Co., 157 Fed. Rep. 238, 240 (C. C. A.).

a defendant who has been led into the building up of an infringing business by the neglect of the patent owner, with knowledge of the facts, to sue him, under the rule which we have elsewhere discussed.[283] Where the element of deceit, and the inactive waiting for profits to accrue, on the part of the patent owner, do not exist, mere delay may well justify the chancellor in denying preliminary relief, to deserve which the patent owner must be diligent in asserting his rights; although the delay in the latter case may clearly not be of such character, or such long duration, as to justify the refusal of injunctive relief on final hearing. So we see that there are two general kinds or degrees of laches. The first, where it will merely defeat an application for interim relief. The second, of such duration, and attended by such misleading or deceitful conduct toward the defendant as to debar the plaintiff from relief by injunction on final hearing. Beyond this rough division we may not go, for each case must be governed by its peculiar facts.

§ 532. The effect of the pendency of other litigation upon the defense of laches.

Equity never requires the doing of the useless or the impossible. Upon the advent of an invention whose value offers temptation to the infringer, infringements may spring up in all of the circuits, and to a number that would render the expense of simultaneous suits against all of the infringers impossible to any individual manufacturer or other patent owner. Hence the rule that if the patent owner is prompt in bringing a test case, and prompt in suing the other infringers, in rotation, if not simultaneously, he is not guilty of laches in the latest suit brought. The courts have frequently said that the patent owner is under no obligation to sue all of the in-

283. Ante, pp. 475, 552.

fringers of his patent at the same time.[284] "Other infringers cannot complain because only one test suit was brought."[285]

The fact that equity may prevent a multiplicity of suits is ample foundation for the principle which Judge Richards announced—"pending litigation involving the validity and construction of the patent was sufficient reason for not bringing other suits for infringement until the patent should be finally adjudicated."[286]

While, ordinarily, the laches of the agent is that of his principal, under peculiar circumstances the inaction or delay of the attorney in bringing an action may serve as a defense to the charge of laches. Thus the fact that an attorney had been employed to prosecute the charge of infringment for a contingent fee, delayed doing so for a considerable time, and died without bringing the suit, was considered by the Court of Appeals for the Ninth Circuit as meeting the defense of laches interposed to the suit brought later by other counsel.[287]

The natural result of the rule of this section is that the complainant will choose the forum where the conditions are most propitious for the sustaining of his patent. His right, under the Constitution and laws of the United States to elect the forum, has been judicially recognized.[288]

284. American Graphophone Co. v. National Graphophone Co., 90 Fed. Rep. 824; Timolat v. Franklin Boiler Works Co., 122 Fed. Rep. 69, 58 C. C. A. 405.

285. Edison Elec. Light Co. v. Mt. Morris Elec. Light Co., 57 Fed. Rep. 642, 645.

286. United States Mitis Co. v. Detroit Steel & Spring Co., 122 Fed. Rep. 863, 59 C. C. A. 589. Following Edison Elec. Light Co. v. Sawyer, 53 Fed. Rep. 592, 3 C. C. A. 605; Taylor v. Sawyer Spindle Co., 75 Fed. Rep. 301, 22 C. C. A. 203; New York Filter Mfg. Co. v. Loomis-Manning Filter Co., 91 Fed. Rep. 421.

287. Los Alamitos Sugar Co. v. Carroll, 173 Fed. Rep. 280, 287, 97 C. C. A. 446.

288. Warren Bros. Co. v. City of Montgomery, 172 Fed. Rep. 414, 423.

§ 533. The pendency of litigation as an excuse for delay in applying for a reissue.

When the defectiveness or insufficiency of the original patent has been developed in the course of litigation, the pendency of that litigation prevents the bar of laches arising against a reissue application. But upon the final adjudication against the patent owner in the court of last resort, it was held that any delay is "at the complainant's peril. A just regard for the rights of the public demanded, if the patent was to be resuscitated in the form of a reissue, that it should be done immediately; and especially so when the reissue claims were to sweep under the monopoly devices not covered by the claims of the original."[289]

§ 534. Abatement of actions.

a. By the plaintiff's assignment of the patent pending the suit. The effect of such an assignment has been thus succinctly stated. "If a sole plaintiff, suing in his own right, assigns his whole interest to another, he is no longer able to prosecute the suit because he is without interest in the litigation. * * * The suit is completely suspended and cannot be proceeded in till it is revived, and all orders and proceedings pending such amendment will be considered nugatory. After such an abatement, i. e., one caused by assignment of plaintiff's whole interest, the successor in interest, claiming by a title which may be litigated, may revive the suit by an original bill in the nature of a supplemental bill."[290] Thus the effect of such an assignment upon the pending suit in equity is distinguishable from the abatement of

289. Coxe, J., in Thomson-Houston Elec. Co. v. Western Elec. Co., 158 Fed. Rep. 813, 816, 86 C. C A. 73.

290. Automatic Switch Co. v. Cutler-Hammer Mfg. Co., 147 Fed. Rep. 250, 251, 77 C. C. A. 176.

an action at law, "where a judgment *quod cassetur* is entered. It is merely an interruption to the suit, suspending its progress until the new parties are brought before the court, and if this is not done at a proper time the court will dismiss the suit."[201]

b. By the defendant's assignment of his interest in the litigation pending the suit. Where the defendant is not under preliminary injunction, and the infringement is continuing pending the suit, his assignment of his infringing business pending the suit is subject to the general rule, thus expressed by Mr. Chief Justice Waite. "It is well settled that an assignment by a defendant, of his interest in a litigation, does not necessarily defeat a suit. His assignee taking *pendente lite* is bound by what is done against him. The assignee may, at his own election, come in by an appropriate application, and make himself a party, so as to assume the burden of the litigation in his own name, or he may act in the name of his assignor."[202]

c. By the expiration of the patent pending the suit. When the patent expires pending the suit, so far as the possibility of injunctive relief against further making by the defendant is concerned, the suit is abated.[203] As to the further use and sale of infringing articles made by the defendant prior to the expiration of the patent, the right to enjoin such using and selling has been affirmed

291. Ecaubert v. Appleton, 67 Fed. Rep. 917, 924, quoting from Story, Equity Pleading, § 348. As to bills of revivor and their attendant practice, see *ante*, p. 522. That the assignee may be substituted as complainant although the patent has expired, see Ross v. City of Ft. Wayne, 63 Fed. Rep. 466, 11 C. C. A. 288; George W. Jackson, Inc. v. Friestedt Interlocking Channel Bar Co., 159 Fed. Rep. 496.

292. Ex parte South & North Alabama R. Co., 95 U. S. (5 Otto), 221, 24 L. Ed. 355.

293. New York Belting & Packing Co. v. Magowan, 27 Fed. Rep. 111.

in some cases [294] and denied in others.[295] It is not apparent, however, why the successful complainant should be remitted to his action at law for damages, which is the effect of the refusal of the injunction against use and sale of the articles made prior to the expiration of the patent. Judge Wheeler's argument is as follows: "The grant to the patentee was of the exclusive right to make, use, and sell to others to be used, the invention during the term. The right to exclude others from making, using and selling was the essential thing, and really all that was granted. * * * Any making for use during the term was taking from him what belonged to him. To permit any others to make such machines during the term, and hold them till the expiration, and then use them freely as if made after, would be to permit them to make off with so much of his (the patentee's) property that the law had granted to him."[296] But this reasoning was not intended to extend, and cannot be extended, to preparations to infringe, made in anticipation of the expiration of the patent. The separate elements may be made or collected for the purpose and with the intent of assembling them, or otherwise producing the article of the patent, and if that work of preparation falls short of the actual production of the completed thing of the patent, equity is powerless to intervene; for the reason, as Judge Wheeler has said, "that what is being done and so intended will never be an infringement. Till completed, these things would not infringe, and when completed the patent will not be in force to be infringed."[297]

294. Reay v. Raynor, 19 Fed. Rep. 308.

295. Westinghouse v. Carpenter, 43 Fed. Rep. 894.

296. American Diamond Rock Boring Co. v. Rutland Marble Co., 2 Fed. Rep. 356.

297. White v. Walbridge, 46 Fed. Rep. 526.

d. By the death of either party. We have heretofore considered the effect of the death of a party upon the pending suit.[298]

e. By the dissolution of an incorporated party to the suit. The consolidation and merger of several corporations under an enabling act of the New York legislature (Laws N. Y. 1884, c. 367, § 6) have been held not to work the abatement of a patent suit pending in the name of one of the corporations at the time of the consolidation.[299] At common law a right of action for tort did not survive the dissolution of the corporation defendant; "for there is no pretense to say that a *scire facias* can be maintained and a judgment had thereon against a dead corporation any more than against a dead man."[300] But under statutes providing that the dissolution of the corporation shall not impair any remedy against it for liabilities previously incurred, its dissolution will not work the abatement of a pending action for tort.[301]

f. By the pendency of another suit. The pendency of a suit in another jurisdiction between the same parties upon the same patent cannot work an abatement of a suit in equity for infringement. In an opinion in such a case, Judge Thomas G. Jones has said: "True, this may finally lead to conflicting judgments in the two courts as to the validity of this patent. Such results cannot be avoided under our present system, where no particular court has exclusive jurisdiction, and the validity of a patent may be tested in different courts of co-ordinate jurisdiction at the same time, and even by the same parties, when nothing has been decided in the litigation be-

298. *Ante*, pp. 522, 680.

299. Edison Elec. Light Co. v. U. S. Elec. Lighting Co., 52 Fed. Rep. 300, 313, 3 C. C. A. 83.

300. Mr. Justice Story, in Mumma v. Potomac Co., 8 Peters 281, 286, 8 L. Ed. 945, 948.

301. Marstaller v. Mills, 143 N. Y. 398.

tween them estopping either of them from setting up new evidence on points which may finally overthrow the patent. Comity cannot prevent such results; but neither of the courts so circumstanced ought to go any further than the necessities of the particular case in its own jurisdiction absolutely require. Neither should attempt to decide upon an infringement committed in the jurisdiction of the other, nor should either court require an accounting between the parties as to an infringement committed in the jurisdiction of the other.[302]

§ 535. Estoppel by implied license—the extension of the license to include other patents of the licensor, by implication.

Some of the adjudicated cases have dealt with this state of facts. In a suit for infringement of one patent, the defendant pleads a license from the plaintiff under another patent, so corelated to the one in suit that its use is necessary to the enjoyment of the license.

Judge (now Mr. Justice) Lurton has announced the resulting doctrine of license by implication as follows:

"That there may be circumstances under which the sale by a patentee of one patented article will carry with it the right to use another in cooperation with the first, although the thing be covered by a second patent. Thus, if the article sold be of such peculiar construction as that it is of no practical use unless it be used in combination with some subordinate part covered by another patent of the vendor, the right to use the latter in cooperation with the former might be implied from circumstances. It is a general principle of law that a grant necessarily carries with it that without which the thing granted cannot be enjoyed. The limitation upon this is that the

302. Warren Bros. Co. v. City of Montgomery, 172 Fed. Rep. 414, 423.

things which pass by implication only must be incident to the grant, and directly necessary to the enjoyment of the thing granted. The foundation of the maxim lies in the presumption that the grantor intended to make his grant enjoyable. This presumption has been employed in the construction of licenses granted by patentees, as well as in other branches of the law. Thus, in Cutter Co. v. Sheldon, 10 Blatchf. 1, Fed. Case 13,331, Woodruff, Circuit Judge, said:

> 'If a party engaged exclusively in the construction of machines of various kinds for sale to others, were to receive a license to manufacture a patented machine, for a consideration presently paid to the patentee, a construction which would deny him all opportunity to make the privilege of any value, forbidding his sale of the machines when manufactured, should be very clearly imported by the license, or the court would hold that the parties meant that he should derive some benefit from the license, and not be left thereafter wholly dependent on the will of the patentee.'

"It is evident that the extent of an implied license must depend upon the peculiar facts of each case. The question in each case is whether or not the circumstances are such as to estop the vendor from asserting infringement. The cases of Roosevelt v. Electric Co., 20 Fed. Rep. 724; United Nickel Co. v. California Electrical Co., 25 Fed. Rep. 475, 479; American Graphophone Co. v. Amet, 74 Fed. Rep. 789,—are instances in which the court held that no license was implied under the facts. Stonecutter Co. v. Shortsleeves, 16 Blatchf. 381, Fed. Case 13,334, and Illingsworth v. Spaulding, 43 Fed. Rep. 831, are illustrations of the application of the presumption arising upon the particular facts of those cases. The

general principle is well stated by Judge Wallace in Roosevelt v. Electric Co., cited above."[303]

This doctrine has since been applied to a similar state of facts by the Court of Appeals of the Seventh Circuit.[304]

§ 536. Drafting the decree to exclude defendant's improvements.

It is obvious that so long as every new and useful improvement whose production involves invention is patentable, regardless of its infringement of a pre-existing patent, a defendant who has produced an attachment for, or improvement upon, the plaintiff's patented machine should not be enjoined from the manufacture, use or sale of his improvement or attachment. And this is so, whether or not his attachment or improvement is patented, or patentable if not patented. In a case where the defendant had infringed the plaintiff's patent for "a travelling contact for electric railways," but was making and selling an attachment which was an addition to the patented device, Judge Taylor said:

"I see no reason why the injunction which ought to be allowed in this case, should not be so qualified as to permit the defendants to sell the portion of their trolley-base which, attached to the complainant's trolley-base, may make freer the lateral movement of the trolley-arm; and this, notwithstanding the fact that the addition of such a member to the complainant's device may exhibit a superiority, for the purpose designed, over that portion of the complainant's device which is designed to permit the trolley-pole to freely move in a lateral direction.

303. Edison Elec. Light Co. v. Peninsular Light, Power & H. Co., 101 Fed. Rep. 831, 836, 43 C. C. A. 479; affirming Edison Elec. Light Co. v. Peninsular Light, Power & H. Co., 95 Fed. Rep. 669.

304. Thomson-Houston Elec Co. v. Illinois Telephone Construction Co., 152 Fed. Rep. 631, 81 C. C. A. 473. Affirming Thomson-Houston Elec. Co. v. Illinois Telephone Construction Co., 143 Fed. Rep. 534.

"Its use requires the use of complainant's device; and the complainant is not therefore prejudiced, if the purchaser of its device obtains another device which he may think adds to the efficiency of the original purchase. One might as well say that the user of complainant's trolley-base could not lubricate the vertical pivot in order to increase the freedom of movement upon it."[305]

§ 537. Intervention in suits in equity.

It is a rare practice in equity cases to permit the intervention by persons, other than the original parties to the suit, whose rights may be affected by the ultimate disposition of the cause. Judge Pardee has said, "if their rights are to be affected they are necessary parties."[306] But as against the objection of the original parties defendant, leave to intervene will ordinarily be denied. Judge Lurton has said "that a stranger to a suit will not be permitted, on his own application, and over the objection of the defendant, to become a defendant, is a well-established general rule, to which there are but few exceptions. * * * In the exceptional cases a defendant can only be added to those named as such in the bill by consent of the complainant, or upon order of the court requiring the bill to be so amended on penalty of dismissal for want of proper parties."[307] In the same case he held that the application for leave to intervene should be accompanied by a full copy of the proposed pleadings of the party seeking to intervene; but he permitted the petition for leave to intervene to stand as an answer.[308]

305. Thomson-Houston Elec. v. Holland, 143 Fed. Rep. 903, 907.

306. Carter v. City of New Orleans, 19 Fed. Rep. 659.

307. Toler v. East. Tenn., V. & G. R. Co., 67 Fed. Rep. 168, 170.

308. Ibid.

Where the application for leave to intervene was filed in the Circuit Court of Appeals, the petitioner having declined an opportunity to intervene in the lower court, and the petition being based upon alleged collusion between the original parties, the court denied the petition after an examination of the record failed to find support for the charge of collusion, but gave the petitioner leave to file a brief upon the merits.[309]

309. Thomson-Houston Elec. Co. v. Western Elec. Co., 158 Fed. Rep. 813, 86 C. C. A. 73.

APPENDIX

THE PATENT STATUTES

ACT OF 1790, CHAPTER 7.

1 STATUTES AT LARGE, 109.

An Act to promote the progress of useful Arts.

SECTION 1. *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,* That upon the petition of any person or persons to the Secretary of State, the Secretary for the Department of War, and the Attorney-General of the United States, setting forth that he, she, or they hath or have invented or discovered any useful art, manufacture, engine, machine, or device, or any improvement therein not before known or used, and praying that a patent may be granted therefor, it shall and may be lawful to and for the said Secretary of State, the Secretary for the Department of War, and the Attorney-General, or any two of them, if they shall deem the invention or discovery sufficiently useful and important, to cause letters-patent to be made out in the name of the United States, to bear teste by the President of the United States, reciting the allegations and suggestions of the said petition, and describing the said invention or discovery, clearly, truly, and fully, and thereupon granting to such petitioner or petitioners, his, her, or their heirs, administrators, or assigns, for any term not exceeding fourteen years, the sole and exclusive right and liberty of making, constructing, using, and vending to others to be used, the said invention or discovery; which letters-patent shall be delivered to the Attorney-General of the United States to be examined, who shall, within fifteen days next after the delivery to him, if he shall find the same conformable to this act, certify it to be so at the foot thereof, and present the letters patent so certified to the President, who shall cause the seal of the United States to be thereto

affixed, and the same shall be good and available to the grantee or grantees by force of this act, to all and every intent and purpose herein contained, and shall be recorded in a book to be kept for that purpose in the office of the Secretary of State, and delivered to the patentee or his agent, and the delivery thereof shall be entered on the record and indorsed on the patent of the said Secretary at the time of granting the same.

SECTION 2. *And be it further enacted*, That the grantee or grantees of each patent shall, at the time of granting the same, deliver to the Secretary of State a specification in writing, containing a description, accompanied with drafts or models, and explanations and models (if the nature of the invention or discovery will admit of a model), of the thing or things by him or them invented or discovered, and described as aforesaid, in the said patents; which specification shall be so particular, and said models so exact, as not only to distinguish the invention or discovery from other things before known and used, but also to enable a workman or other person skilled in the art of manufacture, whereof it is a branch, or wherewith it may be nearest connected, to make, construct, or use the same, to the end that the public may have full benefit thereof, after the expiration of the patent term; which specifications shall be filed in the office of the said Secretary, and certified copies thereof shall be competent evidence in all courts and before all jurisdictions, where any matter or thing, touching or concerning such patent, right, or privilege shall come in question.

SECTION 3. *And be it further enacted*, That upon the application of any person to the Secretary of State, for a copy of any such specification, and for permission to have similar model or models made, it shall be the duty of the Secretary to give such a copy, and to permit the

person so applying for a similar model or models, to take, or make, or cause the same to be taken or made, at the expense of such applicant.

SECTION 4. *And be it further enacted,* That if any person or persons shall devise, make, construct, use, employ, or vend, within these United States, any art, manufacture, engine, machine, or device, or any invention or improvement upon, or in any art, manufacture, engine, machine, or device the sole and exclusive right of which shall be so as aforesaid granted by patent to any person or persons, by virtue and in pursuance of this act, without the consent of the patentee or patentees, their executors, administrators, or assigns, first had and obtained in writing, every person so offending shall forfeit and pay to the said patentee or patentees, his, her, or their executors, administrators, or assigns, such damages as shall be assessed by a jury, and moreover shall forfeit to the person aggrieved, the thing or things so devised, made, constructed, used, employed, or vended, contrary to the true intent of this act, which may be recovered in an action on the case founded on this act.

SECTION 5. *And be it further enacted,* That upon oath or affirmation made before the judge of the district court where the defendant resides, that any patent which shall be issued in pursuance of this act, was obtained surreptitiously by, or upon false suggestion, and motion made to the said court, within one year after issuing the said patent, but not afterwards, it shall and may be lawful to and for the judge of the said district court, if the matter alleged shall appear to him to be sufficient, to grant a rule that the patentee or patentees, his, her, or their executors, administrators, or assigns, show cause why process should not issue against him, her, or them, to repeal such patents; and if sufficient cause shall not be shown to the

contrary, the rule shall be made absolute, and thereupon the said judge shall order process to be issued as aforesaid, against such patentee or patentees, his, her, or their executors, administrators, or assigns. And in case no sufficient cause shall be shown to the contrary, or if it shall appear that the patentee was not the first and true inventor or discoverer, judgment shall be rendered by such court for the repeal of such patent or patents; and if the party at whose complaint the process issued shall have judgment given against him, he shall pay all such costs as the defendant shall be put to in defending the suit, to be taxed by the court, and recovered in such manner as costs expended by defendants shall be recovered in due course of law.

SECTION 6. *And be it further enacted*, That in all actions to be brought by such patentee or patentees, his, her, or their executors, administrators, or assigns, for any penalty incurred by virtue of this act, the said patents or specifications shall be *prima facie* evidence that the said patentee or patentees was or were the first and true inventor or inventors, discoverer or discoverers, of the things so specified, and that the same is truly specified; but that nevertheless the defendant or defendants may plead the general issue, and give this act, and any special matter whereof notice in writing shall have been given to the plaintiff, or his attorney, thirty days before the trial, in evidence tending to prove that the specification filed by the plaintiff does not contain the whole of the truth concerning his invention or discovery; or that it contains more than is necessary to produce the effect described; and if the concealment of part, or the addition of more than is necessary, shall appear to have been intended to mislead, or shall actually mislead the public, so as the effect described cannot be produced by the means specified, then, and in such cases, the verdict and judgment shall be for the defendant.

SECTION 7. *And be it further enacted,* That such patentee as aforesaid shall, before he receives his patent, pay the following fees to the several officers employed in making out and perfecting the same, to-wit: For receiving and filing the petition, fifty cents; for filing specifications, per copy-sheet containing one hundred words, ten cents; for making out patent, two dollars; for affixing great seal, one dollar; for indorsing the day of delivering the same to the patentee, including all intermediate services, twenty cents.

APPROVED April 10, 1790.

Repealed February 21, 1793. 1 Statutes at Large, Chap. 11, Section 12, p. 323.

ACT OF 1793, CHAPTER 11.

1 STATUTES AT LARGE, 318.

An Act to promote the progress of useful Arts; and to repeal the act heretofore made for that purpose.

SECTION 1. *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,* That when any person or persons, being a citizen or citizens of the United States, shall allege that he or they have invented any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvement on any art, machine, manufacture, or composition of matter, not known or used before the application, and shall present a petition to the Secretary of State, signifying a desire of obtaining an exclusive property in the same, and praying that a patent may be granted therefor, it shall and may be lawful for the said Secretary of State to cause letters-patent to be made out in the name of the United States, bearing teste by the President of the United States, reciting the alle-

gations and suggestions of the said petition, and giving a short description of the said invention or discovery, and thereupon granting to such petitioner or petitioners, his, her, or their heirs, administrators, or assigns, for a term not exceeding fourteen years, the full and exclusive right and liberty of making, constructing, using, and vending to others to be used, the said invention or discovery, which letters-patent shall be delivered to the Attorney-General of the United States, to be examined; who, within fifteen days after such delivery, if he finds the same conformable to this act, shall certify accordingly, at the foot thereof, and return the same to the Secretary of State, who shall present the letters-patent, thus certified, to be signed, and shall cause the seal of the United States to be thereto affixed; and the same shall be good and available to the grantee or grantees, by force of this act, and shall be recorded in a book, to be kept for that purpose, in the office of the Secretary of State, and delivered to the patentee or his order.

SECTION 2. *Provided always, and be it further enacted,* That any person who shall have discovered an improvement in the principle of any machine, or in the process of any composition of matter, which shall have been patented, and shall have obtained a patent for such improvement, he shall not be at liberty to make, use, or vend the original discovery, nor shall the first inventor be at liberty to use the improvement: And it is hereby enacted and declared, that simply changing the form or the proportions of any machine, or composition of matter, in any degree, shall not be deemed a discovery.

SECTION 3. *And be it further enacted,* That every inventor, before he can receive a patent, shall swear or affirm, that he does verily believe that he is the true inventor or discoverer of the art, machine, or improvement

for which he solicits a patent, which oath or affirmation may be made before any person authorized to administer oaths, and shall deliver a written description of his invention, and of the manner of using, or process of compounding the same, in such full, clear, and exact terms, as to distinguish the same from all other things before known, and to enable any person skilled in the art or science of which it is a branch, or with which it is most nearly connected, to make, compound, and use the same. And in the case of any machine, he shall fully explain the principle, and the several modes in which he has contemplated the application of that principle or character, by which it may be distinguished from other inventions; and he shall accompany the whole with drawings and written references, where the nature of the case admits of drawings, or with specimens of the ingredients, and of the composition of matter, sufficient in quantity for the purpose of experiment, where the invention is of a composition of matter; which description, signed by himself, and attested by two witnesses, shall be filed in the office of the Secretary of State, and certified copies thereof shall be competent evidence in all courts, where any matter or thing, touching such patent right shall come in question. And such inventor shall, moreover, deliver a model of his machine, provided the Secretary shall deem such model to be necessary.

SECTION 4. *And be it further enacted,* That it shall be lawful for any inventor, his executor or administrator, to assign the title and interest in the said invention, at any time, and the assignee, having recorded the said assignment in the office of the Secretary of State, shall thereafter stand in the place of the original inventor, both as to right and responsibility, and so the assignees of assigns, to any degree.

SECTION 5. *And be it further enacted,* That if any person shall make, devise, and use, or sell the thing so invented, the exclusive right of which shall, as aforesaid, have been secured to any person by patent, without the consent of the patentee, his executors, administrators, or assigns, first obtained in writing, every person so offending shall forfeit and pay to the patentee a sum that shall be at least equal to three times the price for which the patentee has usually sold or licensed, to other persons the use of the said invention, which may be recovered in an action on the case founded on this act, in the circuit court of the United States, or any other court having competent jurisdiction.

SECTION 6. *Provided always, and be it further enacted,* That the defendant in such action shall be permitted to plead the general issue, and give this act, and any special matter, of which notice in writing may have been given to the plaintiff or his attorney, thirty days before trial, in evidence, tending to prove that the specification filed by the plaintiff does not contain the whole truth relative to his discovery, or that it contains more than is necessary to produce the described effect, which concealment or addition shall fully appear to have been made for the purpose of deceiving the public, or that the thing thus secured by patent was not originally discovered by the patentee, but had been in use, or had been described in some public work anterior to the supposed discovery of the patentee, or that he had surreptitiously obtained a patent for the discovery of another person; in either of which cases judgment shall be rendered for the defendant, with costs, and the patent shall be declared void.

SECTION 7. *And be it further enacted,* That where any State, before its adoption of the present form of government, shall have granted an exclusive right to any in-

vention, the party claiming that right shall not be capable of obtaining an exclusive right under this act, but on relinquishing his right under such particular State, and of such relinquishment, his obtaining an exclusive right under this act shall be sufficient evidence.

SECTION 8. *And be it further enacted,* That the persons whose applications for patents were, at the time of passing this act, depending before the Secretary of State, Secretary of War, and Attorney-General, according to the act passed the second session of the first Congress, entitled "An act to promote the progress of useful arts," on complying with the conditions of this act, and paying the fees herein required, may pursue their respective claims to a patent under the same.

SECTION 9. *And be it further enacted,* That in case of interfering applications, the same shall be submitted to the arbitration of three persons, one of whom shall be chosen by each of the applicants, and the third person shall be appointed by the Secretary of State; and the decision or award of such arbitrators, delivered to the Secretary of State in writing, and subscribed by them, or any two of them, shall be final, as far as respects the granting of the patent. And if either of the applicants shall refuse or fail to chuse an arbitrator, the patent shall issue to the opposite party. And where there shall be more than two interfering applications, and the parties applying shall not all unite in appointing three arbitrators, it shall be in the power of the Secretary of State to appoint three arbitrators for the purpose.

SECTION 10. *And be it further enacted,* That upon oath or affirmation being made before the judge of the district court where the patentee, his executors, administrators, or assigns, reside, that any patent, which shall be issued in pursuance of this act, was obtained surreptitiously, or

upon false suggestion, and motion made to the said court, within three years after issuing the said patent, but not afterward, it shall and may be lawful for the judge of the said district court, if the matter alleged shall appear to him to be sufficient, to grant a rule, that the patentee, or his executor, administrator, or assign show cause why process should not issue against him to repeal such patent. And if sufficient cause shall not be shown to the contrary, the rule shall be made absolute, and thereupon the said judge shall order process to be issued against such patentee, or his executors, administrators, or assigns, with costs of suit. And in case no sufficient cause shall be shown to the contrary, or if it shall appear that the patentee was not the true inventor or discoverer. judgment shall be rendered by such court for the repeal of such patent; and if the party at whose complaint the process issued, shall have judgment given against him, he shall pay all such costs as the defendant shall be put to in defending the suit, to be taxed by the court, and recovered in due course of law.

SECTION 11. *And be it further enacted,* That every inventor, before he presents his petition to the Secretary of State, signifying his desire of obtaining a patent, shall pay into the treasury thirty dollars, for which he shall take duplicate receipts; one of which receipts he shall deliver to the Secretary of State, when he presents his petition; and the money thus paid shall be in full for the sundry services to be performed in the office of the Secretary of State, consequent on such petition, and shall pass to the account of clerk-hire in that office: *Provided nevertheless,* That for every copy, which may be required at the said office, of any paper respecting any patent that has been granted, the person obtaining such copy shall pay, at the rate of twenty cents, for every copy-sheet of one hundred words, and for every copy of a drawing, the

party obtaining the same, shall pay two dollars, of which payments an account shall be rendered, annually, to the treasury of the United States, and they shall also pass to the account of clerk-hire in the office of the Secretary of State.

SECTION 12. *And be it further enacted,* That the act passed the tenth day of April, in the year one thousand seven hundred and ninety, "intituled" "An act to promote the progress of useful arts," be, and the same is hereby repealed: *Provided always,* That nothing contained in this act shall be construed to invalidate any patent that may have been granted under the authority of the said act, and all patentees under the said act, their executors, administrators, and assigns, shall be considered within the purview of this act, in respect to the violation of their rights; provded such violations shall be committed after the passing of this act.

APPROVED February 21, 1793.

Repealed July 4, 1836. 5 Statutes at Large, Chap. 357, Section 21, p. 125.

Act OF 1794, CHAPTER 58.

1 STATUTES AT LARGE, 393.

An Act supplementary to the act "intituled" "An Act to promote the progress of Useful Arts."

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That all suits, actions, process and proceedings, heretofore had in any District Court of the United States, under an act passed the tenth day of April, in the year one thousand seven hundred and ninety, intituled "An act

to promote the progress of useful arts," which may have been set aside, suspended or abated, by reason of the repeal of the said act, may be restored, at the instance of the plaintiff or defendant, within one year from and after the passing of this act, in the said court, to the same situation, in which they may have been when they were so set aside, suspended, or abated; and that the parties to the said suits, actions, process or proceedings be, and are hereby, entitled to proceed in such cases, as if no such repeal of the act aforesaid had taken place: *Provided always*, That before any order or proceeding other than that for continuing the same suits, after the reinstating thereof, shall be entered or had, the defendant or plaintiff, as the case may be, against whom the same may have been reinstated, shall be brought into court by summons, attachment, or such other proceedings as is used in other cases for compelling the appearance of a party.

APPROVED June 7, 1794.

Repealed July 4, 1836. 5 Statutes at Large, Chap. 357, Section 21, p. 125.

ACT OF 1800, CHAPTER 25.

2 STATUTES AT LARGE, 37.

An Act to extend the privilege of obtaining patents for useful discoveries and inventions, to certain persons therein mentioned, and to enlarge and define the penalties for violating the rights of patentees.

SECTION 1. *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled*, That all and singular the rights and privileges given, intended or provided to citizens of the

United States, respecting patents for new inventions, discoveries, and improvements by the act entitled "An Act to promote the progress of useful arts, and to repeal the act heretofore made for that purpose," shall be, and hereby are, extended and given to all aliens who at the time of petitioning in the manner prescribed by the said act, shall have resided for two years within the United States, which privileges shall be obtained, used, and enjoyed by such persons, in as full and ample manner, and under the same conditions, limitations, and restrictions, as by the said act is provided and directed in the case of citizens of the United States: *Provided always*, That every person petitioning for a patent for any invention, art, or discovery, pursuant to this act, shall make oath or affirmation before some person duly authorized to administer oaths before such patent shall be granted, that such invention, art, or discovery hath not, to the best of his or her knowledge or belief, been known or used either in this or any foreign country, and that every patent which shall be obtained pursuant to this act, for any invention, art, or discovery, which it shall afterwards appear had been known or used previous to such application for a patent, shall be utterly void.

SECTION 2. *And be it further enacted*, That where any person hath made, or shall have made, any new invention, discovery, or improvement, on account of which a patent might, by virtue of this or the above-mentioned act, be granted to such person, and shall die before any patent shall be granted therefor, the right of applying for and obtaining such patent, shall devolve on the legal representatives of such person in trust for the heirs at law of the deceased, in case he shall have died intestate; but if otherwise, then in trust for his devisees, in as full and ample manner, and under the same conditions, limi-

tations, and restrictions as the same was held, or might have been claimed or enjoyed by such person, in his or her lifetime; and when application for a patent shall be made by such legal representatives, the oath or affirmation, provided in the third section of the before-mentioned act, shall be so varied as to be applicable to them.

SECTION 3. *And be it further enacted,* That where any patent shall be or shall have been granted pursuant to this or the above-mentioned act, and any person without the consent of the patentee, his or her executors, administrators, or assigns, first obtained in writing, shall make, devise, use, or sell the thing whereof the exclusive right is secured to the said patentee by such patent, such person so offending shall forfeit and pay to the said patentee, his executors, administrators, or assigns, a sum equal to three times the actual damage sustained by such patentee, his executors, administrators, or assigns, from or by reason of such offense, which sum shall and may be recovered by action on the case founded on this and the above-mentioned act, in the circuit court of the United States, having jurisdiction thereon.

SECTION 4. *And be it further enacted,* That the fifth section of the above-mentioned act, intituled "An act to promote the progress of useful arts, and to repeal the act heretofore made for that purpose," shall be and hereby is, repealed.

APPROVED April 17, 1800.

Repealed July 4, 1836. 5 Statutes at Large, Chap. 357, Section 21, p. 125.

ACT OF 1819, CHAPTER 19.

3 STATUTES AT LARGE. 481.

An Act to extend the jurisdiction of the circuit courts of the United States to cases arising under the law relating to patents.

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That the circuit courts of the United States shall have original cognizance, as well in equity as at law, of all actions, suits, controversies, and cases arising under any law of the United States, granting or confirming to authors or inventors the exclusive right to their respective writings, inventions, and discoveries; and upon any bill in equity, filed by any party aggrieved in any such cases, shall have authority to grant injunctions, according to the course and principles of courts of equity, to prevent the violation of the rights of any authors or inventors, secured to them by any laws of the United States, on such terms and conditions as the said courts may deem fit and reasonable: *Provided however,* That from all judgments and decrees of any circuit courts rendered in the premises, a writ of error or appeal, as the case may require, shall lie to the Supreme Court of the United States, in the same manner, and under the same circumstances, as is now provided by law in other judgments and decrees of such circuit courts.

APPROVED February 15, 1819.

Repealed July 4, 1836. 5 Statutes at Large, Chap. 357, Section 21, p. 125.

ACT OF JULY 3, 1832, CHAPTER 162.

4 STATUTES AT LARGE, 559.

An Act concerning patents for useful inventions.

SECTION 1. *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,* That it shall be the duty of the Secretary of State, annually, in the month of January, to report to Congress, and to publish in two of the newspapers printed in the city of Washington, a list of all the patents for discoveries, inventions, and improvements, which shall have expired within the year immediately preceding, with the names of the patentees, alphabetically arranged.

SECTION 2. *And be it further enacted,* That application to Congress to prolong or renew the term of a patent shall be made before its expiration, and shall be notified at least once a month, for three months before its presentation, in two newspapers printed in the City of Washington, and in one of the newspapers in which the laws of the United States shall be published in the State or Territory in which the patentee shall reside. The petition shall set forth particularly the grounds of the application. It shall be verified by oath; the evidence in its support may be taken before any judge or justice of the peace; it shall be accompanied by a statement of the ascertained value of the discovery, invention, or improvement, and of the receipts and expenditures of the patentee, so as to exhibit the profit or loss arising therefrom.

SECTION 3. *And be it further enacted,* That wherever any patent which has been heretofore, or shall be hereafter, granted to any inventor in pursuance of the act of Congress, entitled "An act to promote the progress

of useful arts, and to repeal the act heretofore made for that purpose," passed on the twenty-first day of February, in the year of our Lord, one thousand seven hundred and ninety-three, or of any of the acts supplementary thereto, shall be invalid or inoperative, by reason that any of the terms or conditions prescribed in the third section of the said first-mentioned act, have not, by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, been complied with on the part of the said inventor, it shall be lawful for the Secretary of State, upon the surrender to him of such patent, to cause a new patent to be granted to the said inventor for the same invention for the residue of the period then unexpired, for which the original patent was granted, upon his compliance with the terms and conditions prescribed in the said third section of the said act. And, in case of his death, or any assignment by him made of the same patent, the like right shall vest in his executors and administrators, or assignee or assignees: *Provided however*, That such new patent so granted shall, in all respects, be liable to the same matters of objection and defense as any original patent granted under the said first-mentioned act. But no public use or privilege of the invention so patented, derived from or after the grant of the original patent, either under any special license of the inventor, or without the consent of the patentee that there shall be a free public use thereof, shall, in any manner, prejudice his right of recovery for any use or violation of his invention after the grant of such new patent as aforesaid.

APPROVED July 3, 1832.

Repealed July 4, 1836. 5 Statutes at Large, Chap. 357, Section 21, p. 125.

ACT OF JULY 13, 1832, CHAPTER 203.

4 STATUTES AT LARGE, 577.

An Act concerning the issuing of patents to aliens, for useful discoveries and inventions.

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That the privileges granted to the aliens described in the first section of the act, to extend the privilege of obtaining patents for useful discoveries and inventions to certain persons therein mentioned, and to enlarge and define the penalties for violating the rights of patentees, approved April seventeenth, eighteen hundred, be extended in like manner to every alien who, at the time of petitioning for a patent, shall be resident in the United States, and shall have declared his intention, according to law, to become a citizen thereof: *Provided,* That every patent granted by virtue of this act and the privileges thereto appertaining, shall cease and determine and become absolutely void without resort to any legal process to annul or cancel the same in case of a failure on the part of any patentee, for the space of one year from the issuing thereof, to introduce into public use in the United States the invention or improvement for which the patent shall be issued; or in case the same for any period of six months after such introduction shall not continue to be publicly used and applied in the United States, or in case of failure to become a citizen of the United States, agreeably to notice given at the earliest period within which he shall be entitled to become a citizen of the United States.

APPROVED July 13, 1832.

Repealed July 4, 1836. 5 Statutes at Large, Chap. 357, Section 21, p. 125.

ACT OF 1836, CHAPTER 357.

5 STATUTES AT LARGE, 117.

An Act to promote the progress of the useful arts, and to repeal all acts and parts of acts heretofore made for that purpose.

SECTION 1. *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,* That there shall be established and attached to the Department of State an office to be denominated the Patent Office; the chief officer of which shall be called the Commissioner of Patents, to be appointed by the President, by and with the advice and consent of the Senate, whose duty it shall be, under the direction of the Secretary of State, to superintend, execute, and perform all such acts and things touching and respecting the granting and issuing of patents for new and useful discoveries, inventions, and improvements, as are herein provided for, or shall hereafter be, by law, directed to be done and performed, and shall have the charge and custody of all the books, records, papers, models, machines, and all other things belonging to said office. And said Commissioner shall receive the same compensation as is allowed by law to the Commissioner of the Indian Department, and shall be entitled to send and receive letters and packages by mail, relating to the business of the office, free of postage.

SECTION 2. *And be it further enacted,* That there shall be in said office an inferior officer, to be appointed by the said principal officer, with the approval of the Secretary of State, to receive an annual salary of seventeen hundred dollars, and to be called the Chief Clerk of the Patent Office; who in all cases during the necessary absence of the Commissioner, or when then said principal

office shall become vacant, shall have the charge and custody of the seal, and of the records, books, papers, machines, models, and all other things belonging to the said office, and shall perform the duties of Commissioner during such vacancy. And the said Commissioner may also, with like approval, appoint an examining clerk, at an annual salary of fifteen hundred dollars; two other clerks at twelve hundred dollars each, one of whom shall be a competent draughtsman; one other clerk at one thousand dollars; a machinist at twelve hundred and fifty dollars; and a messenger at seven hundred dollars. And said Commissioner, clerks, and every other person appointed and employed in said office, shall be disqualified and interdicted from acquiring or taking, except by inheritance, during the period for which they shall hold their appointments, respectively, any right or interest, directly or indirectly, in any patent for an invention or discovery which has been, or may hereafter be granted.

SECTION 3. *And be it further enacted*, That the said principal officer, and every other person to be appointed in the said office, shall, before he enters upon the duties of his office or appointment, make oath or affirmation truly and faithfully to execute the trust committed to him. And the said Commissioner and the chief clerk shall also, before entering upon their duties, severally give bonds, with sureties, to the Treasurer of the United States, the former in the sum of ten thousand dollars, and the latter in the sum of five thousand dollars, with condition to render a true and faithful account to him or his successor in office, quarterly, of all moneys which shall be by them respectively received for duties on patents, and for copies of records and drawings, and all other moneys received by virtue of said office.

SECTION 4. *And be it further enacted,* That the said Commissioner shall cause a seal to be made and provided for the said office, with such device as the President of the United States shall approve; and copies of any records, books, papers, or drawings belonging to the said office, under the signature of the said Commissioner, or, when the office shall be vacant under the signature of the chief clerk, with the said seal affixed, shall be competent evidence in all cases in which the original records, books, papers, or drawings could be evidence. And any person making application therefor may have certified copies of the records, drawings, and other papers deposited in said office, on paying for the written copies the sum of ten cents for every page of one hundred words; and for copies of drawings the reasonable expense of making the same.

SECTION 5. *And be it further enacted,* That all patents issued from said office shall be issued in the name of the United States, and under the seal of said office, and be signed by the Secretary of State, and countersigned by the Commissioner of the said office, and shall be recorded, together with the descriptions, specifications, and drawings, in the said office, in books to be kept for that purpose. Every such patent shall contain a short description or title of the invention or discovery, correctly indicating its nature and design, and in its terms grant to the applicant or applicants, his or their heirs, administrators, executors, or assigns, for a term not exceeding fourteen years, the full and exclusive right and liberty of making, using, and vending to others to be used, the said invention or discovery, referring to the specifications for the particulars thereof, a copy of which shall be annexed to the patent, specifying what the patentee claims as his invention or discovery.

SECTION 6. *And be it further enacted,* That any person or persons, having discovered or invented any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvement on any art, machine, manufacture, or composition of matter, not known or used by others before his or their discovery or invention thereof, and not, at the time of his application for a patent, in public use or on sale, with his consent or allowance, as the inventor or discoverer; and shall desire to obtain an exclusive property therein, may make application, in writing, to the Commissioner of Patents, expressing such desire, and the Commissioner, on due proceedings had, may grant a patent therefor. But before any inventor shall receive a patent for any such new invention or discovery, he shall deliver a written description of his invention or discovery, and of the manner and process of making, constructing, using, and compounding the same, in such full, clear, and exact terms, avoiding unnecessary prolixity, as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the same; in the case of any machine, he shall fully explain the principle, and the several modes in which he has contemplated the application of that principle or character by which it may be distinguished from other inventions; and shall particularly specify and point out the part, improvement, or combination, which he claims as his own invention or discovery. He shall, furthermore, accompany the whole with a drawing or drawings, and written references, where the nature of the case admits of drawings, or with specimens of ingredients, and of the composition of matter, sufficient in quantity for the purpose of experiment, where the invention or discovery is of a composition of matter; which descriptions and drawings, signed by the

inventor and attested by two witnesses, shall be filed in the Patent Office; and he shall moreover furnish a model of his invention, in all cases which admit of a representation by model, of a convenient size to exhibit advantageously its several parts. The applicant shall also make oath or affirmation that he does verily believe that he is the original and first inventor or discoverer of the art, machine, composition, or improvement, for which he solicits a patent, and that he does not know or believe that the same was ever before known or used; and also of what country he is a citizen; which oath or affirmation may be made before any person authorized by law to administer oaths.

SECTION 7. *And be it further enacted,* That on the filing of any such application, description, and specification, and the payment of the duty hereinafter provided, the Commissioner shall make, or cause to be made, an examination of the alleged new invention or discovery; and if, on any such examination, it shall not appear to the Commissioner that the same had been invented or discovered by any other person in this country prior to the alleged invention or discovery thereof by the applicant, or that it had been patented or described in any printed publication in this or any foreign country, or had been in public use or on sale with the applicant's consent or allowance prior to the application, if the Commissioner shall deem it to be sufficiently useful and important, it shall be his duty to issue a patent therefor. But whenever, on such examination, it shall appear to the Commissioner that the applicant was not the original and first inventor, or discoverer thereof, or that any part of that which is claimed as new had before been invented or discovered, or patented, or described in any printed publication in this or any foreign country, as aforesaid, or that the description is defective and insuffi-

cient, he shall notify the applicant thereof, giving him, briefly, such information and references as may be useful in judging of the propriety of renewing his application, or of altering his specification, to embrace only that part of the invention or discovery which is new. In every such case, if the applicant shall elect to withdraw his application, relinquishing his claim to the model, he shall be entitled to receive back twenty dollars, part of the duty required by this act, on filing a notice in writing of such election in the Patent Office, a copy of which, certified by the Commissioner, shall be a sufficient warrant to the treasurer for paying back to the said applicant the said sum of twenty dollars. But if the applicant in such case shall persist in his claims for a patent, with or without any alteration in his specification, he shall be required to make oath or affirmation anew, in manner as aforesaid. And if the specification and claim shall not have been so modified as, in the opinion of the Commissioner, shall entitle the applicant to a patent, he may, on appeal, and upon request in writing, have the decision of a board of examiners, to be composed of three disinterested persons, who shall be appointed for that purpose by the Secretary of State, one of whom at least, to be selected, if practicable and convenient, for his knowledge and skill in the particular art, manufacture, or branch of science to which the alleged invention appertains; who shall be under oath or affirmation for the faithful and impartial performance of the duty imposed upon them by said appointment. Said board shall be furnished with a certificate in writing of the opinion and decision of the Commissioner, stating the particular grounds of his objection, and the part or parts of the invention which he considers as not entitled to be patented. And the said board shall give reasonable notice to the applicant, as well as to the Commissioner, of the time

and place of their meeting, that they may have an opportunity of furnishing them with such facts and evidence as they may deem necessary to a just decision; and it shall be the duty of the Commissioner to furnish to the board of examiners such information as he may possess relative to the matter under their consideration. And on an examination and consideration of the matter by such board, it shall be in their power, or of a majority of them, to reverse the decision of the Commissioner, either in whole or in part, and their opinion being certified to the Commissioner, he shall be governed thereby in the further proceedings to be had on such application: *Provided however*, That before a board shall be instituted in any such case, the applicant shall pay to the credit of the treasury, as provided in the ninth section of this act, the sum of twenty-five dollars, and each of said persons so appointed shall be entitled to receive for his services in each case a sum not exceeding ten dollars, to be determined and paid by the Commissioner out of any moneys in his hands, which shall be in full compensation to the persons who may be so appointed, for their examination and certificate as aforesaid.

SECTION 8. *And be it further enacted*, That whenever an application shall be made for a patent which, in the opinion of the Commissioner, would interfere with any other patent for which an application may be pending, or with any unexpired patent which shall have been granted, it shall be the duty of the Commissioner to give notice thereof to such applicants, or patentees, as the case may be; and if either shall be dissatisfied with the decision of the Commissioner on the question of priority of right or invention, on a hearing thereof, he may appeal from such decision, on the like terms and conditions as are provided in the preceding section of this act; and the like proceedings shall be had, to determine which

or whether either of the applicants is entitled to receive a patent as prayed for. But nothing in this act contained shall be construed to deprive an original and true inventor of the right to a patent for his invention, by reason of his having previously taken out letters-patent therefor in a foreign country, and the same having been published, at any time within six months next preceding the filing of his specification and drawings. And whenever the applicant shall request it, the patent shall take date from the time of the filing of the specification and drawings, not however exceeding six months prior to the actual issuing of the patent; and on like request, and the payment of the duty herein required, by any applicant, his specification and drawings shall be filed in the secret archives of the office until he shall furnish the model and the patent to be issued, not exceeding the term of one year, the applicant being entitled to notice of interfering applications.

SECTION 9. *And be it further enacted*, That before any application for a patent shall be considered by the Commissioner as aforesaid, the applicant shall pay into the treasury of the United States, or into the Patent Office, or into any of the deposit banks, to the credit of the treasury, if he be a citizen of the United States, or an alien, and shall have been resident in the United States for one year next preceding, and shall have made oath of his intention to become a citizen thereof, the sum of thirty dollars; if a subject of the King of Great Britain, the sum of five hundred dollars; and all other persons the sum of three hundred dollars; for which payment duplicate receipts shall be taken, one of which to be filed in the office of the Treasurer. And the moneys received into the treasury under this act shall constitute a fund for the payment of the salaries of the officers and clerks herein provided for, and all other expenses of the Patent Office, and to be called the patent fund.

SECTION 10. *And be it further enacted*, That where any person hath made, or shall have made, any new invention, discovery, or improvement, on account of which a patent might by virtue of this act be granted, and such person shall die before any patent shall be granted therefor, the right of applying for and obtaining such patent shall devolve on the executor or administrator of such person, in trust for the heirs at law of the deceased, in case he shall have died intestate; but if otherwise, then in trust for his devisees, in as full and ample manner, and under the same conditions, limitations, and restrictions as the same was held, or might have been claimed or enjoyed by such person in his or her lifetime; and when application for a patent shall be made by such legal representatives, the oath or affirmation provided in the sixth section of this act shall be so varied as to be applicable to them.

SECTION 11. *And be it further enacted*, That every patent shall be assignable in law, either as to the whole interest, or any undivided part thereof, by any instrument in writing; which assignment, and also every grant and conveyance of the exclusive right, under any patent, to make and use, and to grant to others to make and use the thing patented within and throughout any specified part or portion of the United States, shall be recorded in the Patent Office within three months from the execution thereof, for which the assignee or grantee shall pay to the Commissioner the sum of three dollars.

SECTION 12. *And be it further enacted*, That any citizen of the United States, or alien, who shall have been a resident of the United States one year next preceding, and shall have made oath of his intention to become a citizen thereof, who shall have invented any new art, machine, or improvement thereof, and shall desire fur-

ther time to make the same, may, on paying to the credit of the treasury, in manner as provided in the ninth section of this act, the sum of twenty dollars, file in the Patent Office a caveat, setting forth the design and purpose thereof, and its principal and distinguishing characteristics, and praying protection of his right till he shall have matured his invention; which sum of twenty dollars, in case the person filing such caveat shall afterwards take out a patent for the invention therein mentioned, shall be considered a part of the sum herein required for the same. And such caveat shall be filed in the confidential archives of the office, and preserved in secrecy. And if application shall be made by any other person within one year from the time of filing such caveat, for a patent of any invention with which it may in any respect interfere, it shall be the duty of the Commissioner to deposit the description, specifications, drawings, and model, in the confidential archives of the office, and to give notice, by mail, to the person filing the caveat, of such application, who shall, within three months after receiving the notice, if he would avail himself of the benefit of his caveat, file his description, specifications, drawings, and model; and if, in the opinion of the Commissioner, the specifications of claim interfere with each other, like proceedings may be had in all respects as are in this act provided in the case of interfering applications: *Provided however*, That no opinion or decision of any board of examiners, under the provisions of this act, shall preclude any person, interested in favor of or against the validity of any patent which has been or may hereafter be granted, from the right to contest the same in any judicial court in any action in which its validity may come in question.

SECTION 13. *And be it further enacted*, That whenever any patent which has heretofore been granted, or

which shall hereafter be granted, shall be inoperative, or invalid, by reason of a defective or insufficient description or specification, or by reason of the patentee claiming in his specification as his own invention more than he had or shall have a right to claim as new; if the error has or shall have arisen by inadvertency, accident, or mistake, and without any fraudulent or deceptive intention, it shall be lawful for the Commissioner, upon the surrender to him of such patent, and the payment of the further duty of fifteen dollars, to cause a new patent to be issued to the said inventor, for the same invention, for the residue of the period then unexpired for which the original patent was granted, in accordance with the patentee's corrected description and specification. And in case of his death, or any assignment by him made of the original patent, a similar right shall vest in his executors, administrators, or assignees. And the patent, so reissued, together with the corrected description and specification, shall have the same effect and operation in law, on the trial of all actions hereafter commenced for causes subsequently accruing, as though the same had been originally filed in such corrected form, before the issuing out of the original patent. And whenever the original patentee shall be desirous of adding the description and specification of any new improvement of the original invention or discovery which shall have been invented or discovered by him subsequent to the date of his patent, he may, like proceedings being had in all respects as in the case of original applications, and on the payment of fifteen dollars as hereinbefore provided, have the same annexed to the original description and specification; and the Commissioner shall certify, on the margin of such annexed description and specification, the time of its being annexed and recorded; and the same shall thereafter have the same effect in law, to

all intents and purposes, as though it had been embraced in the original description and specification.

SECTION 14. *And be it further enacted,* That whenever, in any action for damages for making, using, or selling the thing whereof the exclusive right is secured by any patent heretofore granted, or by any patent which may hereafter be granted, a verdict shall be rendered for the plaintiff in such action, it shall be in the power of the court to render judgment for any sum above the amount found by such verdict as the actual damages sustained by the plaintiff, not exceeding three times the amount thereof, according to the circumstances of the case, with costs; and such damages may be recovered by action on the case, in any court of competent jurisdiction, to be brought in the name or names of the person or persons interested, whether as patentees, assignees, or as grantees of the exclusive right within and throughout a specified part of the United States.

SECTION 15. *And be it further enacted,* That the defendant in any such action shall be permitted to plead the general issue, and to give this act and any special matter in evidence, of which notice in writing may have been given to the plaintiff or his attorney, thirty days before trial, tending to prove that the description and specification filed by the plaintiff does not contain the whole truth relative to his invention or discovery, or that it contains more than is necessary to produce the described effect; which concealment or addition shall fully appear to have been made for the purpose of deceiving the public, or that the patentee was not the original and first inventor or discoverer of the thing patented, or of a substantial and material part thereof claimed as new, or that it had been described in some public work anterior to the supposed discovery thereof by the

patentee, or had been in public use or on sale with the consent and allowance of the patentee before his application for a patent, or that he had surreptitiously or unjustly obtained the patent for that which was in fact invented or discovered by another, who was using reasonable diligence in adapting and perfecting the same; or that the patentee, if an alien at the time the patent was granted, had failed and neglected, for the space of eighteen months from the date of the patent, to put and continue on sale to the public, on reasonable terms, the invention or discovery for which the patent issued; in either of which cases judgment shall be rendered for the defendant with costs. And whenever the defendant relies in his defense on the fact of a previous invention, knowledge, or use of the thing patented, he shall state, in his notice of special matter, the names and places of residence of those whom he intends to prove to have possessed a prior knowledge of the thing, and where the same had been used: *Provided however*, That whenever it shall satisfactorily appear that the patentee, at the time of making his application for the patent, believed himself to be the first inventor or discoverer of the thing patented, the same shall not be held to be void on account of the invention or discovery or any part thereof having been before known or used in any foreign country, it not appearing that the same or any substantial part thereof had before been patented or described in any printed publication. *And provided also*, That whenever the plaintiff shall fail to sustain his action on the ground that in his specification of claim is embraced more than that of which he was the first inventor, if it shall appear that the defendant had used or violated any part of the invention justly and truly specified and claimed as new, it shall be in the power of the court to adjudge and award as to costs, as may appear to be just and equitable.

SECTION 16. *And be it further enacted,* That whenever there shall be two interfering patents, or whenever a patent on application shall have been refused on an adverse decision of a board of examiners, on the ground that the patent applied for would interfere with an unexpired patent previously granted, any person interested in any such patent, either by assignment or otherwise, in the one case, and any such applicant in the other case, may have remedy by bill in equity; and the court having cognizance thereof, on notice to adverse parties, and other due proceedings had, may adjudge and declare either the patents void in the whole or in part, or inoperative or invalid in any particular part or portion of the United States, according to the interest which the parties to such suit may possess in the patent or the inventions patented, and may also adjudge that such applicant is entitled, according to the principles and provisions of this act, to have and receive a patent for his invention, as specified in his claim, or for any part thereof, as the fact of priority of right or invention shall in any such case be made to appear. And such adjudication, if it be in favor of the right of such applicant, shall authorize the Commissioner to issue such patent, on his filing a copy of the adjudication, and otherwise complying with the requisitions of this act. *Provided however,* That no such judgment or adjudication shall affect the rights of any person except the parties to the action and those deriving title from or under them subsequent to the rendition of such judgment.

SECTION 17. *And be it further enacted,* That all actions, suits, controversies, and cases arising under any law of the United States, granting or confirming to inventors the exclusive right to their inventions or discoveries, shall be originally cognizable, as well in equity as at law, by the circuit courts of the United States, or any

district court having the power and jurisdiction of a circuit court; which courts shall have power, upon a bill in equity filed by any party aggrieved, in any such case, to grant injunctions, according to the course and principles of courts of equity, to prevent the violation of the rights of any inventor as secured to him by any law of the United States, on such terms and conditions as said courts may deem reasonable: *Provided however*, That from all judgments and decrees from any such court rendered in the premises, a writ of error or appeal, as the case may require, shall lie to the Supreme Court of the United States, in the same manner and under the same circumstances as is now provided by law in other judgments and decrees of circuit courts, and in all other cases in which the court shall deem it reasonable to allow the same.

SECTION 18. *And be it further enacted*, That whenever any patentee of an invention or discovery shall desire an extension of his patent beyond the term of its limitation, he may make application therefor, in writing, to the Commissioner of the Patent Office, setting forth the grounds thereof; and the Commissioner shall, on the applicant's paying the sum of forty dollars to the credit of the treasury, as in the case of an original application for a patent, cause to be published in one or more of the principal newspapers in the city of Washington, and in such other paper or papers as he may deem proper, published in the section of country most interested adversely to the extension of the patent, a notice of such application and of the time and place when and where the same will be considered, that any person may appear and show cause why the extension should not be granted. And the Secretary of State, the Commissioner of the Patent Office, and the Solicitor of the Treasury shall constitute a board to hear and decide upon the evidence

produced before them both for and against the extension, and shall sit for that purpose at the time and place designated in the published notice thereof. The patentee shall furnish to said board a statement, in writing, under oath, of the ascertained value of the invention, and of his receipts and expenditures, sufficiently in detail to exhibit a true and faithful account of loss and profit in any manner accruing to him from and by reason of said invention. And if, upon a hearing of the matter, it shall appear to the full and entire satisfaction of said board, having due regard to the public interest therein, that it is just and proper that the term of the patent should be extended, by reason of the patentee, without neglect or fault on his part, having failed to obtain, from the use and sale of his invention, a reasonable remuneration for the time, ingenuity, and expense bestowed upon the same, and the introduction thereof into use, it shall be the duty of the Commissioner to renew and extend the patent, by making a certificate thereon of such extension, for the term of seven years from and after the expiration of the first term; which certificate, with a certificate of said board of their judgment and opinion as aforesaid, shall be entered on record in the Patent Office; and thereupon the said patent shall have the same effect in law as though it had been originally granted for the term of twenty-one years. And the benefit of such renewal shall extend to assignees and grantees of the right to use the thing patented, to the extent of their respective interests therein: *Provided however*, That no extension of a patent shall be granted after the expiration of the term for which it was originally issued.

SECTION 19. *And be it further enacted*, That there shall be provided for the use of said office, a library of scientific works and periodical publications, both foreign and American, calculated to facilitate the discharge of

the duties hereby required of the chief officers therein, to be purchased under the direction of the Committee of the Library of Congress. And the sum of fifteen hundred dollars is hereby appropriated for that purpose, to be paid out of the patent fund.

SECTION 20. *And be it further enacted,* That it shall be the duty of the Commissioner to cause to be classified and arranged, in such rooms or galleries as may be provided for that purpose, in suitable cases, when necessary for their preservation, and in such manner as shall be conducive to a beneficial and favorable display thereof, the models and specimens of compositions and of fabrics and other manufactures and works of art, patented or unpatented, which have been, or shall hereafter be, deposited in said office. And said rooms or galleries shall be kept open during suitable hours for public inspection.

SECTION 21. *And be it further enacted,* That all acts and parts of acts heretofore passed on this subject be, and the same are hereby repealed: *Provided however,* That all actions and processes in law or equity sued out prior to the passage of this act may be prosecuted to final judgment and execution, in the same manner as though this act had not been passed, excepting and saving the application to any such action of the provisions of the fourteenth and fifteenth sections of this act, so far as they may be applicable thereto: *And provided also,* That all applications or petitions for patents, pending at the time of the passage of this act, in cases where the duty has been paid, shall be proceeded with and acted on in the same manner as though filed after the passage hereof.

APPROVED July 4, 1836.

Repealed July 8, 1870. 16 Statutes at Large, Chap. 230, Section 111, p. 216.

ACT OF 1837, CHAPTER 45.

5 STATUTES AT LARGE, 191.

An Act in addition to the act to promote the progress of science and useful arts.

SECTION 1. *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,* That any person who may be in possession of, or in any way interested in, any patent for an invention, discovery, or improvement, issued prior to the fifteenth day of December, in the year of our Lord one thousand eight hundred and thirty-six, or in an assignment of any patent, or interest therein, executed and recorded prior to the said fifteenth day of December, may, without charge, on presentation or transmission thereof to the Commissioner of Patents, have the same recorded anew in the Patent Office, together with the descriptions, specifications of claim and drawings annexed or belonging to the same; and it shall be the duty of the Commissioner to cause the same, or any authenticated copy of the original record, specification, or drawing which he may obtain, to be transcribed and copied into books of record to be kept for that purpose; and wherever a drawing was not originally annexed to the patent and referred to in the specification, any drawing produced as a delineation of the invention, being verified by oath in such manner as the Commissioner shall require, may be transmitted and placed on file, or copied as aforesaid, together with certificate of the oath; or such drawings may be made in the office, under the direction of the Commissioner, in conformity with the specification. And it shall be the duty of the Commissioner to take such measures as may be advised and determined by the Board of Commissioners provided for

in the fourth section of this act, to obtain the patents, specifications, and copies aforesaid, for the purpose of being so transcribed and recorded. And it shall be the duty of each of the several clerks of the judicial courts of the United States, to transmit as soon as may be, to the Commissioner of the Patent Office, a statement of all the authenticated copies of patents, descriptions, specifications, and drawings of inventions and discoveries made and executed prior to the aforesaid fifteenth day of December, which may be found on the files of his office; and also to make out and transmit to said Commissioner, for record as aforesaid, a certified copy of every such patent, description, specification, or drawing, which shall be specially required by said Commissioner.

SECTION 2. *And be it further enacted*, That copies of such record and drawings, certified by the Commissioner, or, in his absence, by the chief clerk, shall be *prima facie* evidence of the particulars of the invention and of the patent granted therefor in any judicial court of the United States, in all cases where copies of the original record or specification and drawings would be evidence, without proof of the loss of such originals; and no patent issued prior to the aforesaid fifteenth day of December shall, after the first day of June next, be received in evidence in any of the said courts in behalf of the patentee or other person who shall be in possession of the same, unless it shall have been so recorded anew, and a drawing of the invention, if separate from the patent, verified as aforesaid, deposited in the Patent Office; nor shall any written assignment of any such patent, executed and recorded prior to the said fifteenth day of December, be received in evidence in any of the said courts in behalf of the assignee or other person in possession thereof, until it shall have been so recorded anew.

SECTION 3. *And be it further enacted*, That whenever it shall appear to the Commissioner that any patent was destroyed by the burning of the Patent Office building on the aforesaid fifteenth day of December, or was otherwise lost prior thereto, it shall be his duty, on application therefor by the patentee or other person interested therein, to issue a new patent for the same invention or discovery, bearing the date of the original patent, with his certificate thereon that it was made and issued pursuant to the provisions of the third section of this act, and shall enter the same of record: *Provided however*, That before such patent shall be issued the applicant therefor shall deposit in the Patent Office a duplicate, as near as may be, of the original model, drawings, and description, with specification of the invention or discovery, verified by oath, as shall be required by the Commissioner; and such patent, and copies of such drawings and descriptions, duly certified, shall be admissible as evidence in any judicial court of the United States, and shall protect the rights of the patentee, his administrators, heirs, and assigns, to the extent only in which they would have been protected by the original patent and specification.

SECTION 4. *And be it further enacted*, That it shall be the duty of the Commissioner to procure a duplicate of such of the models, destroyed by fire on the aforesaid fifteenth day of December, as were most valuable and interesting, and whose preservation would be important to the public; and such as would be necessary to facilitate the just discharge of the duties imposed by law on the Commissioner in issuing patents, and to protect the rights of the public and of patentees in patented inventions and improvements: *Provided*, That a duplicate of such models may be obtained at a reasonable expense: *And provided also*, That the whole amount of expenditure

for this purpose shall not exceed the sum of one hundred thousand dollars. And there shall be a temporary board of Commissioners, to be composed of the Commissioner of the Patent Office and two other persons to be appointed by the President, whose duty it shall be to consider and determine upon the best and most judicious mode of obtaining models of suitable construction; and also to consider and determine what models may be procured in pursuance of, and in accordance with, the provisions and limitations in this section contained. And said commissioners may make and establish all such regulations, terms, and conditions, not inconsistent with law, as in their opinion may be proper and necessary to carry the provisions of this section into effect, according to its true intent.

SECTION 5. *And be it further enacted,* That, whenever a patent shall be returned for correction and reissue under the thirteenth section of the act to which this is additional, and the patentee shall desire several patents to be issued for distinct and separate parts of the thing patented, he shall first pay, in manner and in addition to the sum provided by that act, the sum of thirty dollars for each additional patent so to be issued: *Provided however,* That no patent made prior to the aforesaid fifteenth day of December shall be corrected and reissued until a duplicate of the model and drawing of the thing as originally invented, verified by oath as shall be required by the Commissioner, shall be deposited in the Patent Office.

Nor shall any addition of an improvement be made to any patent heretofore granted, nor any new patent be issued for an improvement made in any machine, manufacture, or process, to the original inventor, assignee, or possessor of a patent therefor, nor any disclaimer be admitted to record, until a duplicate model and drawing of

the thing originally intended, verified as aforesaid, shall have been deposited in the Patent Office, if the Commissioner shall require the same; nor shall any patent be granted for an invention, improvement, or discovery, the model or drawing of which shall have been lost, until another model and drawing, if required by the Commissioner, shall, in like manner, be deposited in the Patent Office.

And in all such cases, as well as in those which may arise under the third section of this act, the question of compensation for such models and drawings shall be subject to the judgment and decision of the Commissioners, provided for in the fourth section, under the same limitations and restrictions as are therein prescribed.

SECTION 6. *And be it further enacted,* That any patent hereafter to be issued may be made and issued to the assignee or assignees of the inventor or discoverer, the assignment thereof being first entered of record, and the application therefor being duly made, and the specification duly sworn to by the inventor. And in all cases hereafter, the applicant for a patent shall be held to furnish duplicate drawings, whenever the case admits of drawings, one of which to be deposited in the office, and the other to be annexed to the patent, and considered a part of the specification.

SECTION 7. *And be it further enacted,* That, whenever any patentee shall have, through inadvertence, accident, or mistake, made his specification of claim too broad, claiming more than that of which he was the original or first inventor, some material or substantial part of the thing patented being truly and justly his own, any such patentee, his administrators, executors, and assigns, whether of the whole or of a sectional interest therein, may make disclaimer of such parts of the thing patented

as the disclaimant shall not claim to hold by virtue of the patent or assignment, stating therein the extent of his interest in such patent; which disclaimer shall be in writing, attested by one or more witnesses, and recorded in the Patent Office, on payment by the person disclaiming in manner as other patent duties are required by law to be paid, of the sum of ten dollars. And such disclaimer shall thereafter be taken and considered as part of the original specification, to the extent of the interest which shall be posssesed in the patent or right secured thereby, by the disclaimant, and by those claiming by or under him subsequent to the record thereof. But no such disclaimer shall affect any action pending at the time of its being filed, except so far as may relate to the question of unreasonable neglect or delay in filing the same.

SECTION 8. *And be it further enacted*, That, whenever application shall be made to the Commissioner for any addition of a newly discovered improvement to be made to an existing patent, or whenever a patent shall be returned for correction and reissue, the specification of claim annexed to every such patent shall be subject to revision and restriction, in the same manner as are original applications for patents; the Commissioner shall not add any such improvement to the patent in the one case, nor grant the reissue in the other case, until the applicant shall have entered a disclaimer, or altered his specification of claim in accordance with the decision of the Commissioner; and in all such cases, the applicant, if dissatisfied with such decision, shall have the same remedy, and be entitled to the benefit of the same privileges and proceedings as are provided by law in the case of original applications for patents.

SECTION 9. *And be it further enacted*, any thing in the fifteenth section of the act to which this is additional to

the contrary notwithstanding, That, whenever by mistake, accident, or inadvertence, and without any wilful default or intent to defraud or mislead the public, any patentee shall have in his specification claimed to be the original and first inventor or discoverer of any material or substantial part of the thing patented, of which he was not the first and original inventor, and shall have no legal or just right to claim the same, in every such case the patent shall be deemed good and valid for so much of the invention or discovery as shall be truly and *bona fide* his own; *Provided,* It shall be a material and substantial part of the thing patented, and be definitely distinguishable from the other parts so claimed without right as aforesaid. And every such patentee, his executors, administrators, and assigns, whether of the whole, or of a sectional interest therein, shall be entitled to maintain a suit at law or in equity on such patent for any infringement of such part of the invention or discovery as shall be *bona fide* his own as aforesaid, notwithstanding the specification may embrace more than he shall have any legal right to claim. But, in every such case in which a judgment or verdict shall be rendered for the plaintiff, he shall not be entitled to recover costs against the defendant, unless he shall have entered at the Patent Office, prior to the commencement of the suit, a disclaimer of all that part of the thing patented which was so claimed without right. *Provided however,* That no person bringing any such suit shall be entitled to the benefits of the provisions contained in this section, who shall have unreasonably neglected or delayed to enter at the Patent Office a disclaimer as aforesaid.

SECTION 10. *And be it further enacted,* That the Commissioner is hereby authorized and empowered to appoint agents, in not exceeding twenty of the principal cities or towns in the United States as may best accom-

modate the different sections of the country, for the purpose of receiving and forwarding to the Patent Office all such models, specimens of ingredients and manufactures, as shall be intended to be patented or deposited therein, the transportation of the same to be chargeable to the patent fund.

SECTION 11. *And be it further enacted,* That, instead of one examining clerk, as provided by the second section of the act to which this is additional, there shall be appointed, in manner therein provided, two examining clerks, each to receive an annual salary of fifteen hundred dollars; and also, an additional copying clerk, at an annual salary of eight hundred dollars. And the Commissioner is also authorized to employ, from time to time, as many temporary clerks as may be necessary to execute the copying and draughting required by the first section of this act, and to examine and compare the records with the originals, who shall receive not exceeding seven cents for every page of one hundred words, and for drawings and comparison of records with originals, such reasonable compensation as shall be agreed upon or prescribed by the Commissioner.

SECTION 12. *And be it further enacted,* That, wherever the application of any foreigner for a patent shall be rejected and withdrawn for want of novelty in the invention, pursuant to the seventh section of the act to which this is additional, the certificate thereof of the Commissioner shall be a sufficient warrant to the treasurer to pay back to such applicant two-thirds of the duty he shall have paid into the treasury on account of such application.

SECTION 13. *And be it further enacted,* That in all cases in which an oath is required by this act, or by the act to which this is additional, if the person of whom it

is required shall be conscientiously scrupulous of taking an oath, affirmation may be substituted therefor.

SECTION 14. *And be it further enacted*, That all moneys paid into the treasury of the United States for patents and for fees for copies furnished by the Superintendent of the Patent Office prior to the passage of the act to which this is additional, shall be carried to the credit of the patent fund created by said act; and the moneys constituting said fund shall be, and the same are hereby, appropriated for the payment of the salaries of the officers and clerks provided for by said act, and all other expenses of the Patent Office, including all the expenditures provided for by this act; and also for such other purposes as are or may be hereafter specially provided for by law. And the Commissioner is hereby authorized to draw upon said fund, from time to time, for such sums as shall be necessary to carry into effect the provisions of this act, governed, however, by the several limitations herein contained. And it shall be his duty to lay before Congress, in the month of January, annually, a detailed statement of the expenditures and payments by him made from said fund; And it shall also be his duty to lay before Congress, in the month of January, annually, a list of all patents which shall have been granted during the preceding year, designating, under proper heads, the subjects of such patents, and furnishing an alphabetical list of the patentees, with their places of residence; and he shall also furnish a list of all patents which shall have become public property during the same period; together with such other information of the state and condition of the Patent Office as may be useful to Congress or the public.

APPROVED March 3, 1837.

Repealed July 8, 1870. 16 Statutes at Large, Chap 230, Section 111, p. 216.

ACT OF 1839, CHAPTER 88.

5 STATUTES AT LARGE, 353.

An Act in addition to "An act to promote the progress of the useful arts."

SECTION 1. *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,* That there shall be appointed, in manner provided in the second section of the act to which this is additional, two assistant examiners, each to receive an annual salary of twelve hundred and fifty dollars.

SECTION 2. *And be it further enacted,* That the Commissioner be authorized to employ temporary clerks to do any necessary transcribing, whenever the current business of the office requires it; *Provided however,* That instead of salary, a compensation shall be allowed, at a rate not greater than is charged for copies now furnished by the office.

SECTION 3. *And be it further enacted,* That the Commissioner is hereby authorized to publish a classified and alphabetical list of all patents granted by the Patent Office previous to said publication, and retain one hundred copies for the Patent Office and nine hundred copies to be deposited in the library of Congress, for such distribution as may be hereafter directed; and that one thousand dollars, if necessary, be appropriated, out of the patent fund, to defray the expense of the same.

SECTION 4. *And be it further enacted,* That the sum of three thousand six hundred and fifty-nine dollars and twenty-two cents be, and is hereby, appropriated from the patent fund, to pay for the use and occupation of rooms in the City Hall by the Patent Office.

SECTION 5. *And be it further enacted*, That the sum of one thousand dollars be appropriated from the patent fund, to be expended under the direction of the Commissioner, for the purchase of necessary books for the library of the Patent Office.

SECTION 6. *And be it further enacted*, That no person shall be debarred from receiving a patent for any invention or discovery, as provided in the act approved on the fourth day of July, one thousand eight hundred and thirty-six, to which this is additional, by reason of the same having been patented in a foreign country more than six months prior to his application: *Provided*, That the same shall not have been introduced into public and common use in the United States, prior to the application for such patent: *And provided also*, That in all cases every such patent shall be limited to the term of fourteen years from the date of publication of such foreign letters-patent.

SECTION 7. *And be it further enacted*, That every person or corporation who has, or shall have, purchased or constructed and newly invented machine, manufacture, or composition of matter, prior to the application by the inventor or discoverer for a patent, shall be held to possess the right to use, and vend to others to be used, the specific machine, manufacture, or composition of matter so made or purchased, without liability therefor to the inventor, or any other person interested in such invention; and no patent shall be held to be invalid, by reason of such purchase, sale, or use prior to the application for a patent as aforesaid, except on proof of abandonment of such invention to the public; or that such purchase, sale, or prior use has been for more than two years prior to such application for a patent.

SECTION 8. *And be it further enacted*, That so much of the eleventh section of the above recited act as requires the payment of three dollars to the Commissioner of Patents for recording any assignment, grant, or conveyance of the whole or any part of the interest or right under any patent, be, and the same is hereby, repealed; and all such assignments, grants, and conveyances shall, in future, be recorded, without any charge whatever.

SECTION 10. *And be it further enacted*, That the provisions of the sixteenth section of the before-recited act shall extend to all cases where patents are refused for any reason whatever either by the Commissioner of Patents or by the Chief Justice of the District of Columbia, upon appeals from the decision of said Commissioner, as well as where the same shall have been refused on account of, or by reason of, interference with a previously existing patent; and in all cases where there is no opposing party, a copy of the bill shall be served upon the Commissioner of Patents, when the whole of the expenses of the proceeding shall be paid by the applicant, whether the final decision shall be in his favor or otherwise.

SECTION 11. *And be it further enacted*, That in all cases where an appeal is now allowed by law from the decision of the Commissioner of Patents to a board of examiners, provided for in the seventh section of the act to which this is additional, the party, instead thereof, shall have a right to appeal to the Chief Justice of the district court of the United States for the District of Columbia, by giving notice thereof to the Commissioner, and filing in the Patent Office, within such time as the Commissioner shall appoint, his reasons of appeal specifically set forth in writing, and also paying into the Patent Office, to the credit of the patent fund, the sum of twenty-five dollars. And it shall be the duty of said Chief Justice, on petition,

to hear and determine all such appeals, and to revise such decisions in a summary way, on the evidence produced before the Commissioner, at such early and convenient time as he may appoint, first notifying the Commissioner of the time and place of hearing whose duty it shall be to give notice thereof to all parties who appear to be interested therein, in such manner as said judge shall prescribe. The Commissioner shall also lay before the said judge all the original papers and evidence in the case, together with the grounds of his decision, fully set forth in writing, touching all the points involved by the reasons of appeal, to which the revision shall be confined. And at the request of any party interested, or at the desire of the judge, the Commissioner and the examiners in the Patent Office may be examined under oath, in explanation of the principles of the machine or other thing for which a patent, in such case is prayed for. And it shall be the duty of said judge, after a hearing of any such case, to return all the papers to the Commissioner, with a certificate of his proceedings and decision, which shall be entered of record in the Patent Office; and such decision, so certified, shall govern the further proceedings of the Commissioner in such case: *Provided however*, That no opinion or decision of the judge in any such case shall preclude any person interested in favor or against the validity of any patent which has been or may, hereafter be granted from the right to contest the same in any judicial court, in any action in which its validity may come in question.

SECTION 12. *And be it further enacted*, That the Commissioner of Patents shall have power to make all such regulations, in respect to the taking of evidence to be used in contested cases before him, as may be just and reasonable. And so much of the act to which this is ad-

ditional, as provides for a board of examiners, is hereby repealed.

SECTION 13. *And be it further enacted*, That there be paid annually, out of the patent fund, to the said Chief Justice, in consideration of the duties herein imposed, the sum of one hundred dollars.

APPROVED March 3, 1839.

Repealed July 8, 1870. 16 Statutes at Large, Chap. 230, Section 111, p. 216.

ACT OF 1842, CHAPTER 263.

5 STATUTES AT LARGE, 543.

An Act in addition to an act to promote the progress of the useful arts, and to repeal all acts and parts of acts heretofore made for that purpose.

SECTION 1. *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled*, That the Treasurer of the United States be, and he hereby is, authorized to pay back, out of the patent fund, any sum or sums of money, to any person who shall have paid the same into the Treasury, or to any receiver or depositary to the credit of the Treasurer, as for fees accruing at the Patent Office through mistake, and which are not provided to be paid by existing laws, certificate thereof being made to the said Treasurer by the Commissioner of Patents.

SECTION 2. *And be it further enacted*, That the third section of the act of March, eighteen hundred and thirty-seven, which authorizes the renewing of patents lost prior to the fifteenth of December, eighteen hundred and thir-

ty-six, is extended to patents granted prior to said fifteenth day of December, though they may have been lost subsequently: *Provided however,* The same shall not have been recorded anew under the provisions of said act.

SECTION 3. *And be it further enacted,* That any citizen or citizens, or alien or aliens, having resided one year in the United States, and taken the oath of his or their intention to become a citizen or citizens, who by his, her, or their own industry, genius, efforts, and expense, may have invented or produced any new and original design for a manufacture, whether of metal or other material or materials, or any new and original design for the printing of woolen, silk, cotton, or other fabrics, or any new and original design for a bust, statue, or bas-relief or composition in alto or basso relievo, or any new and original impression or ornament, or to be placed on any article of manufacture, the same being formed in marble or other material, or any new and useful pattern, or print, or picture, to be either worked into or worked, on, or printed or painted or cast or otherwise fixed on, any article of manufacture, or any new and original shape or configuration of any article of manufacture not known or used by others before his, her, or their invention or production thereof, and prior to the time of his, her, or their application for a patent therefor, and who shall desire to obtain an exclusive property or right therein to make, use, and sell and vend the same, or copies of the same, to others, by them to be made, used, and sold, may make application in writing to the Commissioner of Patents expressing such desire, and the Commissioner, on due proceedings had, may grant a patent therefor, as in the case now of application for a patent: *Provided,* That the fee in such cases, which by the now existing laws would be required of the particular

applicant, shall be one half the sum, and that the duration of said patent shall be seven years, and that all the regulations and provisions which now apply to the obtaining or protection of patents not inconsistent with the provisions of this act shall apply to applications under this section.

SECTION 4. *And be it further enacted,* That the oath required for applicants for patents may be taken, when the applicant is not, for the time being, residing in the United States, before any minister, plenipotentiary, *charge d'affaires,* consul, or commercial agent holding commission under the government of the United States, or before any notary public of the foreign country in which such applicant may be.

SECTION 5. *And be it further enacted,* That if any person or persons shall paint or print or mould, cast, carve, or engrave, or stamp, upon anything made, used, or sold, by him, for the sole making or selling which he hath not or shall not have obtained letters-patent, the name or any imitation of the name of any other person who hath or shall have obtained letters-patent for the sole making and vending of such thing, without consent of such patentee, or his assigns or legal representatives; or if any person, upon any such thing not having been purchased from the patentee, or some person who purchased it from or under such patentee, or not having the license or consent of such patentee, or his assigns, or legal representatives, shall write, paint, print, mould, cast, carve, engrave, stamp, or otherwise make or affix the words "patent," or the words "letters-patent," or the word "patentee," or any word or words of like kind, meaning, or import, with the view or intent of imitating or counterfeiting the stamp, mark or other device, of the patentee, or shall affix the same, or any word, stamp, or device,

of like import, on any unpatented article, for the purpose of deceiving the public, he, she, or they, so offending, shall be liable for such offence to a penalty of not less than one hundred dollars, with costs, to be recovered by action in any of the circuit courts of the United States, or in any of the district courts of the United States having the powers and jurisdiction of a circuit court; one half of which penalty, as recovered, shall be paid to the patent fund, and the other half to any person or persons who shall sue for the same.

SECTION 6. *And be it further enacted*, That all patentees and assignees of patents hereafter granted are hereby required to stamp, engrave, or cause to be stamped or engraved, on each article vended, or offered for sale, the date of the patent; and if any person or persons, patentees, or assignees, shall neglect to do so, he, she, or they shall be liable to the same penalty, to be recovered and disposed of in the manner specified in the foregoing fifth section of this act.

APPROVED August 29, 1842.

Repealed July 8, 1870. 16 Statutes at Large, Chap. 230, Section 111, p. 216.

ACT OF 1848, CHAPTER 47.

9 STATUTES AT LARGE, 231.

An Act to provide additional Examiners in the Patent Office, and for other Purposes.

SECTION 1. *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled*, That there shall be appointed, in the manner provided in the second section of the act entitled

"An Act to promote the progress of useful arts, and to repeal all acts and parts of acts heretofore made for that purpose," approved July fourth, eighteen hundred and thirty-six, two principal examiners, and two assistant examiners, in addition to the number of examiners now employed in the Patent Office; and that hereafter each of the principal examiners employed in the Patent Office shall receive an annual salary of twenty-five hundred dollars, and each of the assistant examiners an annual salary of fifteen hundred dollars: *Provided*, That the power to extend patents, now vested in the board composed of the Secretary of State, Commissioner of Patents, and Solicitor of the Treasury, by the eighteenth section of the act approved July fourth, eighteen hundred and thirty-six, respecting the Patent Office, shall hereafter be vested solely in the Commissioner of Patents; and when an application is made to him for the extension of a patent according to said eighteenth section, and sixty days' notice given thereof, he shall refer the case to the principal examiner having charge of the class of inventions to which said case belongs, who shall make full report to said Commissioner of the said case, and particularly whether the invention or improvement secured in the patent was new and patentable when patented; and thereupon the said Commissioner shall grant or refuse the extension of said patent, upon the same principles and rules that have governed said board; but no patent shall be extended for a longer term than seven years.

SECTION 2. *And be it further enacted*, That hereafter the Commissioner of Patents shall require a fee of one dollar for recording any assignment, grant, or conveyance of the whole or any part of the interest in letters-patent, or power of attorney, or license to make or use the thing patented, when such instrument shall not ex

ceed three hundred words; the sum of two dollars when it shall exceed three hundred and shall not exceed one thousand words; and the sum of three dollars when it shall exceed one thousand words; which fees shall in all cases be paid in advance.

SECTION 3. *And be it further enacted,* That there shall be appointed in manner aforesaid, two clerks, to be employed in copying and recording and in other services in the Patent Office, who shall each be paid a salary of one thousand two hundred dollars per annum.

SECTION 4. *And be it further enacted,* That the Commissioner of Patents is hereby authorized to send by mail, free of postage, the annual reports of the Patent Office, in the same manner in which he is empowered to send letters and packages relating to the business of the Patent Office.

APPROVED May 27, 1848.

Repealed July 8, 1870. 16 Statutes at Large, Chap. 230, Section 111, p. 216.

ACT OF 1849, CHAPTER 108.

9 STATUTES AT LARGE, 395.

Section 2 of the Act entitled "An Act to establish the Home Department, and to provide for the Treasury Department an Assistant Secretary of the Treasury and a Commissioner of the Customs."

SECTION 2. *And be it further enacted,* That the Secretary of the Interior shall exercise and perform all the acts of supervision and appeal in regard to the office of Commissioner of Patents, now exercised by the Secretary

of State; and the said Secretary of the Interior shall sign all requisitions for the advance or payment of money out of the Treasury on estimates or accounts, subject to the same adjustment or control now exercised on similar estimates or accounts by the First or Fifth Auditor and First Comptroller of the Treasury.

APPROVED March 3, 1849.

Repealed July 8, 1870. 16 Statutes at Large, Chap. 230, Section 111, p. 216.

ACT OF 1852, CHAPTER 107.

10 STATUTES AT LARGE, 75.

An Act in addition to "An Act to Promote the Progress of the Useful Arts."

SECTION 1. *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,* That appeals provided for in the eleventh section of the act entitled An Act in addition to an act to promote the progress of the useful arts, approved March the third, eighteen hundred and thirty-nine, may also be made to either of the assistant judges of the Circuit Court of the District of Columbia, and all the powers, duties, and responsibilities imposed by the aforesaid act, and conferred upon the chief judge, are hereby imposed and conferred upon each of the said assistant judges.

SECTION 2. *And be it further enacted,* That in case appeals shall be made to the said chief judge, or to either of the said assistant judges, the Commissioner of Patents shall pay to such chief judge or assistant judge the sum of twenty-five dollars, required to be paid by the ap-

pellant into the Patent Office by the eleventh section of said act, on said appeal.

SECTION 3. *And be it further enacted,* That section thirteen of the aforesaid act, approved March the third, eighteen hundred and thirty-nine, is hereby repealed.

APPROVED August 30, 1852.

Repealed July 8, 1870. 16 Statutes at Large, Chap. 230, Section 111, p. 216.

ACT OF FEBRUARY 18, 1861, CHAPTER 37.

12 STATUTES AT LARGE, 130.

An Act to extend the right of appeal from the decisions of Circuit Courts to the Supreme Court of the United States.

SECTION 1. *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,* That from all judgments and decrees of any Circuit Court rendered in any action, suit, controversy, or case, at law or in equity, arising under any law of the United States granting or confirming to authors the exclusive right to their respective writings, or to inventors the exclusive right to their inventions or discoveries, a writ of error or appeal, as the case may require, shall lie, at the instance of either party, to the Supreme Court of the United States, in the same manner and under the same circumstances as is now provided by law in other judgments and decrees of such circuit courts, without regard to the sum or value in controversy in the action.

APPROVED February 18, 1861.

Repealed July 8, 1870. 16 Statutes at Large, Chap. 230, Section 111, p. 216.

ACT OF MARCH 2, 1861, CHAPTER 88.

12 STATUTES AT LARGE, 246.

An Act in Addition to "An Act to promote the Progress of the useful Arts."

SECTION 1. *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,* That the Commissioner of Patents may establish rules for taking affidavits and depositions required in cases pending in the Patent Office, and such affidavits and depositions may be taken before any justice of the peace, or other officer authorized by law to take depositions to be used in the courts of the United States, or in the State courts of any State where such officer shall reside; and in any contested case pending in the Patent Office it shall be lawful for the clerk of any court of the United States for any district or Territory, and he is hereby required, upon the application of any party to such contested case, or the agent or attorney of such party, to issue subpoenas for any witnesses residing or being within the said district or Territory, commanding such witnesses to appear and testify before any justice of the peace, or other officer as aforesaid, residing within the said district or Territory, at any time and place in the subpoena to be stated; and if any witness, after being duly served with such subpoena, shall refuse or neglect to appear, or, after appearing, shall refuse to testify (not being privileged from giving testimony) such refusal or neglect being proved to the satisfaction of any judge of the court whose clerk shall have issued such subpoena, said judge may thereupon proceed to enforce obedience to the process, or to punish the disobedience in like manner as any court of the United States may do in case of disobedience to process of subpoena ad

testificandum issued by such court; and witnesses in such cases shall be allowed the same compensation as is allowed to witnesses attending the courts of the United States: *Provided*, That no witness shall be required to attend at any place more than forty miles from the place where the subpoena shall be served upon him to give a deposition under this law: *Provided also*, That no witness shall be deemed guilty of contempt for refusing to disclose any secret invention made or owned by him: *And provided further*, That no witness shall be deemed guilty of contempt for disobeying any subpoena directed to him by virtue of this act, unless his fees for going to, returning from, and one day's attendance at the place of examination, shall be paid or tendered to him at the time of the service of the subpoena.

SECTION 2. *And be it further enacted*, That for the purposes of securing greater uniformity of action in the grant and refusal of letters-patent, there shall be appointed by the President, by and with the advice and consent of the Senate, three examiners in chief at an annual salary of three thousand dollars each, to be composed of persons of competent legal knowledge and scientific ability, whose duty it shall be, on the written petition of the applicant for that purpose being filed, to revise and determine upon the validity of decisions made by examiners when adverse to the grant of letters-patent; and also to revise and determine in like manner upon the validity of the decisions of examiners in interference cases, and when required by the Commissioner in applications for the extension of patents, and to perform such other duties as may be assigned to them by the Commissioner; that from their decisions appeals may be taken to the Commissioner of Patents in person, upon payment of the fee hereinafter prescribed; that the said examiners-in-chief shall

be governed in their action by the rules to be prescribed by the Commissioner of Patents.

SECTION 3. *And be it further enacted,* That no appeal shall be allowed to the examiners in chief from the decisions of the primary examiners, except in interference cases, until after the application shall have been twice rejected; and the second examination of the application by the primary examiner shall not be had until the applicant, in view of the references given on the first rejection, shall have renewed the oath of invention, as provided for in the seventh section of the act entitled "An act to promote the progress of the useful arts, and to repeal all acts and parts of acts heretofore made for that purpose," approved July fourth, eighteen hundred and thirty-six.

SECTION 4. *And be it further enacted,* That the salary of the Commissioner of Patents, from and after the passage of this act, shall be four thousand five hundred dollars per annum, and the salary of the chief clerk of the Patent Office shall be two thousand five hundred dollars, and the salary of the librarian of the Patent Office shall be eighteen hundred dollars.

SECTION 5. *And be it further enacted,* That the Commissioner of Patents is authorized to restore to the respective applicants, or when not removed by them, to otherwise dispose of such of the models belonging to rejected applications as he shall not think necessary to be preserved. The same authority is also given in relation to all models accompanying applications for designs. He is further authorized to dispense in future with models of designs when the design can be sufficiently represented by a drawing.

SECTION 6. *And be it further enacted*, That the tenth section of the act approved the third of March, eighteen hundred and thirty-seven, authorizing the appointment of agents for the transportation of models and specimens to the Patent Office, is hereby repealed.

SECTION 7. *And be it further enacted*, That the Commissioner is further authorized, from time to time, to appoint, in the manner already provided for by law, such an additional number of principal examiners, first assistant examiners, and second assistant examiners as may be required to transact the current business of the office with despatch, provided the whole number of additional examiners shall not exceed four of each class, and that the total annual expenses of the Patent Office shall not exceed the annual receipts.

SECTION 8. *And be it further enacted*, That the Commissioner may require all papers filed in the Patent Office, if not correctly, legibly, and clearly written, to be printed at the cost of the parties filing such papers; and for gross misconduct he may refuse to recognize any person as a patent agent, either generally or in any particular case; but the reasons of the Commissioner for such refusal shall be duly recorded, and be subject to the approval of the President of the United States.

SECTION 9. *And be it further enacted*, That no money paid as a fee, on any application for a patent after the passage of this act, shall be withdrawn or refunded, nor shall the fee paid on filing a caveat be considered as part of the sum required to be paid on filing a subsequent application for a patent for the same invention. That the three months' notice given to any caveator, in pursuance of the requirements of the twelfth section of the act of July fourth, eighteen hundred and thirty-six, shall be computed from the day on which such notice is depos-

ited in the post-office at Washington, with the regular time for the transmission of the same added thereto, which time shall be indorsed on the notice; and that so much of the thirteenth section of the act of Congress, approved July fourth, eighteen hundred and thirty-six, as authorizes the annexing to letters-patent of the description and specification of additional improvements is hereby repealed, and in all cases where additional improvements would now be admissible, independent patents must be applied for.

SECTION 10. *And be it further enacted*, That all laws now in force fixing the rates of the Patent Office fees to be paid, and discriminating between the inhabitants of the United States and those of other countries, which shall not discriminate against the inhabitants of the United States, are hereby repealed, and in their stead the following rates are established:

On filing each caveat, ten dollars.

On filing each original application for a patent, except for a design, fifteen dollars.

On issuing each original patent, twenty dollars.

On every appeal from the examiner-in-chief to the Commissioner, twenty dollars.

On every application for the reissue of a patent, thirty dollars.

On every application for the extension of a patent, fifty dollars; and fifty dollars in addition, on the granting of every extension.

On filing each disclaimer, ten dollars.

For certified copies of patents and other papers, ten cents per hundred words.

For recording every assignment, agreement, power of attorney, and other papers, of three hundred words or under, one dollar.

For recording every assignment, and other papers, over three hundred and under one thousand words, two dollars.

For recording every assignment or other writing, if over one thousand words, three dollars.

For copies of drawings, the reasonable cost of making the same.

SECTION 11. *And be it further enacted*, That any citizen or citizens, or alien or aliens, having resided one year in the United States, and taken the oath of his or their intention to become a citizen or citizens, who, by his, her, or their own industry, genius, efforts, and expense may have invented or produced any new and original design, or a manufacture, whether of metal or other material or materials, and original design for a bust, statue, or bas-relief, or composition in alto or basso relievo, or any new and original impression or ornament or to be placed on any article of manufacture, the same being formed in marble or other material, or any new and useful pattern, or print, or picture, to be either worked into or worked on, or printed, or painted, or cast, or otherwise fixed on any article of manufacture, or any new and original shape or configuration of any article of manufacture, not known or used by others before his, her, or their invention or production thereof, and prior to the time of his, her, or their application for a patent therefor, and who shall desire to obtain an exclusive property or right therein to make, use, and sell, and vend the same, or copies of the same, to others, by them to be made, used, and sold, may make application, in writing, to the Commissioner of Patents expressing such desire; and the Commissioner, on due proceedings had, may grant a patent therefor, as in the case now of application for a patent, for the term of three and one half years, or for the term of seven years, or for the term of fourteen years, as the said applicant

may elect in his application: *Provided*, That the fee to be paid in such application shall be for the term of three years and six months, ten dollars, for seven years, fifteen dollars, and for fourteen years, thirty dollars: *And provided*, That the patentees of designs under this act shall be entitled to the extension of their respective patents for the term of seven years, from the day on which said patent shall expire, upon the same terms and restrictions as are now provided for the extension of letters patent.

SECTION 12. *And be it further enacted*, That all applications for patents shall be completed and prepared for examination within two years after the filing of the petition, and in default thereof they shall be regarded as abandoned by the parties thereto; unless it be shown to the satisfaction of the Commissioner of Patents that such delay was unavoidable; and all applications now pending shall be treated as if filed after the passage of this act, and all applications for the extension of patents shall be filed at least ninety days before the expiration thereof; and notice of the day set for the hearing of the case shall be published, as now required by law, for at least sixty days.

SECTION 13. *And be it further enacted*, That in all cases where an article is made or vended by any person under the protection of letters-patent, it shall be the duty of such person to give sufficient notice to the public that said article is so patented, either by fixing thereon the word "patented," together with the day and year the patent was granted; or when, from the character of the article patented, that may be impracticable, by enveloping one or more of the said articles, and affixing a label to the package, or otherwise attaching thereto a label on which the notice, with the date, is printed; on failure of which, in any suit for the infringement of letters-pat-

ent by the party failing so to mark the article the right to which is infringed upon, no damage shall be recovered by the plaintiff, except on proof that the defendant was duly notified of the infringement, and continued after such notice to make or vend the article patented. And the sixth section of the act entitled "An act in addition to an act to promote the progress of the useful arts," and so forth, approved the twenty-ninth day of August, eighteen hundred and forty-two, be, and the same is hereby, repealed.

SECTION 14. *And be it further enacted,* That the Commissioner of Patents be, and he is hereby, authorized to print, or in his discretion to cause to be printed, ten copies of the description and claims of all patents which may hereafter be granted, and ten copies of the drawings of the same, when drawings shall accompany the patents: *Provided,* The cost of printing the text of said descriptions and claims shall not exceed, exclusive of stationery, the sum of two cents per hundred words for each of said copies, and the cost of the drawing shall not exceed fifty cents per copy; one copy of the above number shall be printed on parchment to be affixed to the letters-patent; the work shall be under the direction, and subject to the approval, of the Commissioner of Patents, and the expense of the said copies shall be paid for out of the patent fund.

SECTION 15. *And be it further enacted,* That printed copies of the letters-patent of the United States, with the seal of the Patent Office affixed thereto and certified and signed by the Commissioner of Patents, shall be legal evidence of the contents of said letters-patent in all cases.

SECTION 16. *And be it further enacted,* That all patents hereafter granted shall remain in force for the term

of seventeen years from the date of issue; and all extension of such patents is hereby prohibited.

SECTION 17. *And be it further enacted,* That all acts and parts of acts heretofore passed, which are inconsistent with the provisions of this act, be, and the same are hereby, repealed.

APPROVED March 2, 1861.

Repealed July 8, 1870. 16 Statutes at Large, Chap. 230, Section 111, p. 216.

ACT OF 1862, CHAPTER 182.

12 STATUTES AT LARGE, 583.

Section 4 of an Act making supplemental appropriations for sundry civil expenses, &c.

SECTION 4. For the fund of the Patent Office, fifty thousand eight hundred and fifty-five dollars and forty-nine cents, to supply a deficiency existing under the act of March second, eighteen hundred and sixty-one, entitled "An act in addition to an act to promote the progress of the useful arts:" *Provided,* That the fourteenth section of said act be, and the same is hereby, repealed.

APPROVED July 16, 1862.

ACT OF 1863, CHAPTER 102.

12 STATUTES AT LARGE, 796.

An Act to amend an Act entitled "An Act to promote the Progress of the useful Arts."

SECTION 1. *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,* That so much of section seven of the act entitled "An act to promote the progress of the useful arts," approved July fourth, eighteen hundred and thirty-six, as requires a renewal of the oath, be, and the same is hereby, repealed.

SECTION 2. *And be it further enacted,* That, whereas the falling off of the revenue of the Patent Office required a reduction of the compensation of the examiners and clerks, or other employees in the office, after the thirty-first day of August, eighteen hundred and sixty-one, that the Commissioner of Patents be, and he is hereby, authorized, whenever the revenue of the office will justify him in so doing, to pay them such sums, in addition to what they shall already have received, as will make their compensation the same as it was at that time.

SECTION 3. *And be it further enacted,* That every patent shall be dated as of a day not later than six months after the time at which it was passed and allowed, and notice thereof sent to the applicant or his agent. And if the final fee for such patent be not paid within the said six months, the patent shall be withheld, and the invention therein described shall become public property as against the applicant therefor: *Provided,* That in all cases where patents have been allowed previous to the

passage of this act, the said six months shall be reckoned from the date of such passage.

APPROVED March 3, 1863.

Repealed July 8, 1870. 16 Statutes at Large, Chap. 230, Section 111, p. 216.

ACT OF 1864, CHAPTER 159.

13 STATUTES AT LARGE, 194.

An Act amendatory of an Act to amend an Act entitled "An Act to promote the Progress of the Useful Arts," approved March three, eighteen hundred and sixty-three.

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That any person having an interest in an invention, whether as the inventor or assignee, for which a patent was ordered to issue upon the payment of the final fee, as provided in section three of an act approved March three, eighteen hundred and sixty-three, but who has failed to make payment of the final fee, as provided by said act, shall have the right to make the payment of such fee, and receive the patent withheld on account of the non-payment of said fee, provided such payment be made within six months from the date of the passage of this act: *Provded,* That nothing herein shall be so construed as to hold responsible in damages any persons who have manufactured or used any article or thing for which a patent, as aforesaid, was ordered to be issued.

APPROVED June 25, 1864.

Repealed July 8, 1870. 16 Statutes at Large, Chap. 230, Section 111, p. 216.

ACT OF 1865, CHAPTER 112.

13 STATUTES AT LARGE, 533.

An Act amendatory of "An Act to amend an Act entitled 'An Act to promote the Progress of the useful Arts,' approved March three, eighteen hundred and sixty-three."

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That any persons having an interest in an invention, whether as inventor or assignee, for which a patent was ordered to issue upon the payment of the final fee, as provided in section three of an act approved March three, eighteen hundred and sixty-three, but who has failed to make payment of the final fee as provided in said act, shall have the right to make an application for a patent for his invention, the same as in the case of an original application, provided such application be made within two years after the date of the allowance of the original application: *Provided,* That nothing herein shall be so construed as to hold responsible in damages any persons who have manufactured or used any article or thing for which a patent aforesaid was ordered to issue. This act shall apply to all cases now in the Patent Office, and also to such as shall hereafter be filed. And all acts or parts of acts inconsistent with this act are hereby repealed.

APPROVED March 3, 1865.

Repealed July 8, 1870. 16 Statutes at Large, Chap. 230, Section 111, p. 216.

ACT OF 1866.

14 STATUTES AT LARGE, 76.

An Act in Amendment of an Act to promote the Progress of the Useful Arts, and the Acts in Amendment of an Addition thereto.

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That upon appealing for the first time from the decision of the primary examiner to the examiners-in-chief in the Patent Office, the appellant shall pay a fee of ten dollars into the Patent Office, to the credit of the patent fund: and no appeal from the primary examiner to the examiners-in-chief shall hereafter be allowed until the appellant shall pay said fee.

APPROVED June 27, 1866.

Repealed July 8, 1870. 16 Statutes at Large, Chap. 230, Section 111, p. 216.

ACT OF 1870, CHAPTER 230.

16 STATUTES AT LARGE, 198.

An Act to revise, consolidate, and amend the Statutes, relating to Patents and Copyrights.

SECTION 1. *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,* That there shall be attached to the Department of the Interior the office, heretofore established, known as the Patent Office, wherein all records, books, models, drawings, specifications, and other papers and

things pertaining to patents shall be safely kept and preserved. [See Revised Statutes, Section 475.]

SECTION 2. *And be it further enacted*, That the officers and employees of said office shall continue to be: one commissioner of patents, one assistant commissioner, and three examiners-in-chief, to be appointed by the President, by and with the advice and consent of the Senate; one chief clerk, one examiner in charge of interferences, twenty-two principal examiners, twenty-two first assistant examiners, twenty-two second assistant examiners, one librarian, one machinist, five clerks of class four, six clerks of class three, fifty clerks of class two, forty-five clerks of class one, and one messenger and purchasing clerk, all of whom shall be appointed by the Secretary of the Interior, upon nomination of the Commissioner of Patents. [See Revised Statutes, Section 476.]

SECTION 3. *And be it further enacted*, That the Secretary of the Interior may also appoint, upon like nomination, such additional clerks of classes two and one, and of lower grades, copyists of drawings, female copyists, skilled laborers, laborers and watchmen, as may be from time to time appropriated for by Congress. [See Revised Statutes, Section 169.]

SECTION 4. *And be it further enacted*, That the annual salaries of the officers and employees of the Patent Office shall be as follows:

Of the commissioner of patents, four thousand five hundred dollars.

Of the assistant commissioner, three thousand dollars.

Of the examiners-in-chief, three thousand dollars each.

Of the chief clerk, two thousand five hundred dollars.

Of the examiner in charge of interferences, two thousand five hundred dollars.

Of the principal examiners, two thousand five hundred dollars each.

Of the first assistant examiners, one thousand eight hundred dollars each.

Of the second assistant examiners, one thousand six hundred dollars each.

Of the librarian, one thousand eight hundred dollars.

Of the machinist, one thousand six hundred dollars.

Of the clerks of class four, one thousand eight hundred dollars each.

Of the clerks of class three, one thousand six hundred dollars each.

Of the clerks of class two, one thousand four hundred dollars each.

Of the clerks of class one, one thousand two hundred dollars each.

Of the messenger and purchasing clerk, one thousand dollars.

Of laborers and watchmen, seven hundred and twenty dollars each.

Of the additional clerks, copyists of drawings, female copyists, and skilled laborers, such rates as may be fixed by the acts making appropriations for them. [See Revised Statutes, Sections 477, 440, and 167.]

SECTION 5. *And be it further enacted*, That all officers and employees of the Patent Office shall, before entering upon their duties, make oath or affirmation truly and faithfully to execute the trusts committed to them. [See Revised Statutes, Sections 1756 and 1757.]

SECTION 6. *And be it further enacted*, That the commissioner and chief clerk, before entering upon their duties, shall severally give bond, with sureties, to the Treasurer of the United States, the former in the sum of ten thousand dollars, and the latter in the sum of

five thousand dollars, conditioned for the faithful discharge of their duties, and that they will render to the proper officers of the treasury a true account of all money received by virtue of their office. [See Revised Statutes, Section 479.]

SECTION 7. *And be it further enacted,* That it shall be the duty of the commissioner, under the direction of the Secretary of the Interior, to superintend or perform all the duties respecting the granting and issuing of patents which herein are, or may hereafter be, by law directed to be done; and he shall have charge of all books, records, papers, models, machines, and other things belonging to said office. [See Revised Statutes, Section 481.]

SECTION 8. *And be it further enacted,* That the commissioner may send and receive by mail, free of postage, letters, printed matter, and packages relating to the business of his office, including Patent Office reports. [See 19 Statutes at Large, Chap. 103, Section 5, p. 335; and 20 Statutes at Large, Chap. 180, Section 29, p. 362.]

SECTION 9. *And be it further enacted,* That the commissioner shall lay before Congress, in the month of January, annually, a report, giving a detailed statement of all moneys received for patents, for copies of records or drawings, or from any other source whatever; a detailed statement of all expenditures for contingent and miscellaneous expenses; a list of all patents which were granted during the preceding year, designating under proper heads the subjects of such patents; an alphabetical list of the patentees, with their places of residence; a list of all patents which have been extended during the year; and such other information of the condition of the Patent Office as may be useful to Congress or the public. [See Revised Statutes, Section 494.]

SECTION 10. *And be it further enacted*, That the examiners-in-chief shall be persons of competent legal knowledge and scientific ability, whose duty it shall be, on the written petition of the appellant, to revise and determine upon the validity of the adverse decisions of examiners upon applications for patents, and for reissues of patents, and in interference cases; and when required by the commissioner, they shall hear and report upon claims for extensions, and perform such other like duties as he may assign them. [See Revised Statutes, Section 482.]

SECTION 11. *And be it further enacted*, That in case of the death, resignation, absence, or sickness of the commissioner, his duties shall devolve upon the assistant commissioner until a successor shall be appointed, or such absence or sickness shall cease. [See Revised Statutes, Sections 177, 178, and 179.]

SECTION 12. *And be it further enacted*, That the commissioner shall cause a seal to be provided for said office, with such device as the President may approve, with which all records or papers issued from said office, to be used in evidence, shall be authenticated. [See Revised Statutes, Section 478.]

SECTION 13. *And be it further enacted*, That the commissioner shall cause to be classified and arranged in suitable cases, in the rooms and galleries provided for that purpose, the models, specimens of composition, fabrics, manufactures, works of art, and designs, which have been or shall be deposited in said office; and said rooms and galleries shall be kept open during suitable hours for public inspection. [See Revised Statutes, Section 484.]

SECTION 14. *And be it further enacted*, That the commissioner may restore to the respective applicants such

of the models belonging to rejected applications as he shall not think necessary to be preserved, or he may sell or otherwise dispose of them after the application has been finally rejected for one year, paying the proceeds into the treasury, as other patent moneys are directed to be paid. [See Revised Statutes, Section 485.]

SECTION 15. *And be it further enacted,* That there shall be purchased, for the use of said office, a library of such scientific works and periodicals, both foreign and American, as may aid the officers in the discharge of their duties, not exceeding the amount annually appropriated by Congress for that purpose. [See Revised Statutes, Section 486.]

SECTION 16. *And be it further enacted,* That all officers and employees of the Patent Office shall be incapable, during the period for which they shall hold their appointments, to acquire or take, directly or indirectly, except by inheritance or bequest, any right or interest in any patent issued by said office. [See Revised Statutes, Section 480.]

SECTION 17. *And be it further enacted,* That for gross misconduct the commissioner may refuse to recognize any person as a patent agent, either generally or in any particular case; but the reasons for such refusal shall be duly recorded, and be subject to the approval of the Secretary of the Interior. [See Revised Statutes, Section 487.]

SECTION 18. *And be it further enacted,* That the commissioner may require all papers filed in the Patent Office, if not correctly, legibly and clearly written, to be printed at the cost of the party filing them. [See Revised Statutes, Section 488.]

SECTION 19. *And be it further enacted*, That the commissioner, subject to the approval of the Secretary of the Interior, may from time to time establish rules and regulations, not inconsistent with law, for the conduct of proceedings in the Patent Office. [See Revised Statutes, Section 483.]

SECTION 20. *And be it further enacted*, That the commissioner may print or cause to be printed copies of the specifications of all letters patent and of the drawings of the same, and copies of the claims of current issues, and copies of such laws, decisions, rules, regulations, and circulars as may be necessary for the information of the public. [See Revised Statutes, Sections 489, 490, and 491.]

SECTION 21. *And be it further enacted*, That all patents shall be issued in the name of the United States of America, under the seal of the Patent Office, and shall be signed by the Secretary of the Interior and countersigned by the commissioner, and they shall be recorded, together with the specification, in said office, in books to be kept for that purpose. [See Revised Statutes, Section 4883.]

SECTION 22. *And be it further enacted*, That every patent shall contain a short title or description of the invention or discovery, correctly indicating its nature and design, and a grant to the patentee, his heirs or assigns, for the term of seventeen years, of the exclusive right to make, use, and vend the said invention or discovery throughout the United States and the Territories thereof, referring to the specification for the particulars thereof; and a copy of said specifications and of the drawings shall be annexed to the patent and be a part thereof. [See Revised Statutes, Section 4884.]

SECTION 23. *And be it further enacted,* That every patent shall date as of a day not later than six months from the time at which it was passed and allowed, and notice thereof was sent to the applicant or his agent; and if the final fee shall not be paid within that period, the patent shall be withheld. [See Revised Statutes, Section 4885.]

SECTION 24. *And be it further enacted,* That any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvement thereof, not known or used by others in this country, and not patented, or described in any printed publication in this or any foreign country, before his invention or discovery thereof, and not in public use or on sale for more than two years prior to his application, unless the same is proved to have been abandoned, may, upon payment of the duty required by law, and other due proceedings had, obtain a patent therefor. [See Revised Statutes, Section 4886.]

SECTION 25. *And be it further enacted,* That no person shall be debarred from receiving a patent for his invention or discovery, nor shall any patent be declared invalid, by reason of its having been first patented or caused to be patented in a foreign country: *Provided,* The same shall not have been introduced into public use in the United States for more than two years prior to the application, and that the patent shall expire at the same time with the foreign patent, or, if there be more than one, at the same time with the one having the shortest term; but in no case shall it be in force more than seventeen years. [See Revised Statutes, Section 4887.]

SECTION 26. *And be it further enacted,* That before any inventor or discoverer shall receive a patent for his invention or discovery, he shall make application there-

for, in writing, to the commissioner, and shall file in the Patent Office a written description of the same, and of the manner and process of making, constructing, compounding, and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the same; and in case of a machine, he shall explain the principle thereof, and the best mode in which he has contemplated applying that principle so as to distinguish it from other inventions; and he shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery; and said specification and claim shall be signed by the inventor and attested by two witnesses. [See Revised Statutes, Section 4888.]

SECTION 27. *And be it further enacted,* That when the nature of the case admits of drawings, the applicant shall furnish one copy signed by the inventor or his attorney in fact, and attested by two witnesses, which shall be filed in the Patent Office; and a copy of said drawings, to be furnished by the Patent Office, shall be attached to the patent as part of the specification. [See Revised Statutes, Section 4889.]

SECTION 28. *And be it further enacted,* That when the invention or discovery is of a composition of matter, the applicant, if required by the commissioner, shall furnish specimens of ingredients and of the composition, sufficient in quantity for the purpose of experiment. [See Revised Statutes, Section 4890.]

SECTION 29. *And be it further enacted,* That in all cases which admit of representation by model, the applicant, if required by the commissioner, shall furnish one of convenient size to exhibit advantageously the several

parts of his invention or discovery. [See Revised Statutes, Section 4891.]

SECTION 30. *And be it further enacted,* That the applicant shall make oath or affirmation that he does verily believe himself to be the original and first inventor or discoverer of the art, machine, manufacture, composition, or improvement for which he solicits a patent; that he does not know and does not believe that the same was ever before known or used; and shall state of what country he is a citizen. And said oath or affirmation may be made before any person within the United States authorized by law to administer oaths, or, when the applicant resides in a foreign country, before any minister, *charge d' affaires,* consul, or commercial agent, holding commission under the government of the United States, or before any notary public of the foreign country in which the applicant may be. [See Revised Statutes, Section 4892.]

SECTION 31. *And be it further enacted,* That on the filing of any such application and the payment of the duty required by law, the commissioner shall cause an examination to be made of the alleged new invention or discovery; and if on such examination it shall appear that the claimant is justly entitled to a patent under the law, and that the same is sufficiently useful and important, the commissioner shall issue a patent therefor. [See Revised Statutes, Section 4893.]

SECTION 32. *And be it further enacted,* That all applications for patents shall be completed and prepared for examination within two years after the filing of the petition, and in default thereof, or upon failure of the applicant to prosecute the same within two years after any action therein, of which notice shall have been given to the applicant, they shall be regarded as abandoned by

the parties thereto, unless it be shown to the satisfaction of the commissioner that such delay was unavoidable. [See Revised Statutes, Section 4894.]

SECTION 33. *And be it further enacted,* That patents may be granted and issued or reissued to the assignee of the inventor or discoverer, the assignment thereof being first entered of record in the Patent Office; but in such case the application for the patent shall be made and the specifications sworn to by the inventor or discoverer; and also, if he be living, in case of an application for reissue. [See Revised Statutes, Section 4895.]

SECTION 34. *And be it further enacted,* That when any person, having made any new invention or discovery for which a patent might have been granted, dies before a patent is granted, the right of applying for and obtaining the patent shall devolve on his executor or administrator, in trust for the heirs at law of the deceased, in case he shall have died intestate; or if he shall have left a will, disposing of the same, then in trust for his devisees, in as full manner and on the same terms and conditions as the same might have been claimed or enjoyed by him in his lifetime; and when the application shall be made by such legal representatives, the oath or affirmation required to be made shall be so varied in form that it can be made by them. [See Revised Statutes, Section 4896.]

SECTION 35. *And be it further enacted,* That any person who has an interest in an invention or discovery, whether as inventor, discoverer, or assignee, for which a patent was ordered to issue upon the payment of the final fee, but who has failed to make payment thereof within six months from the time at which it was passed and allowed, and notice thereof was sent to the applicant or his agent, shall have a right to make an application

for a patent for such invention or discovery the same as in the case of an original application: *Provided*, That the second application be made within two years after the allowance of the original application. But no person shall be held responsible in damages for the manufacture or use of any article or thing for which a patent, as aforesaid, was ordered to issue, prior to the issue thereof: *And provided further*, That when an application for a patent has been rejected or withdrawn, prior to the passage of this act, the applicant shall have six months from the date of such passage to renew his application, or to file a new one; and if he omit to do either, his application shall be held to have been abandoned. Upon the hearing of such renewed applications abandonment shall be considered as a question of fact. [See Revised Statutes, Section 4897.]

SECTION 36. *And be it further enacted*, That every patent or any interest therein shall be assignable in law, by an instrument in writing; and the patentee or his assigns or legal representatives may, in like manner, grant and convey an exclusive right under his patent to the whole or any specified part of the United States; and said assignment, grant, or conveyance shall be void as against any subsequent purchaser or mortgagee for a valuable consideration, without notice, unless it is recorded in the Patent Office within three months from the date thereof. [See Revised Statutes, Section 4898.]

SECTION 37. *And be it further enacted*, That every person who may have purchased of the inventor, or with his knowledge and consent may have constructed any newly invented or discovered machine, or other patentable article, prior to the application by the inventor or discoverer for a patent, or sold or used one so constructed, shall have the right to use, and vend to others to be used,

the specific thing so made or purchased, without liability therefor. [See Revised Statutes, Section 4899.]

SECTION 38. *And be it further enacted,* That it shall be the duty of all patentees, and their assigns and legal representatives, and of all persons making or vending any patented article for or under them, to give sufficient notice to the public that the same is patented, either by fixing thereon the word "patented," together with the day and year the patent was granted; or when, from the character of the article, this cannot be done, by fixing to it or to the package wherein one or more of them is enclosed, a label containing the like notice; and in any suit for infringement, by the party failing so to mark, no damages shall be recovered by the plaintiff, except on proof that the defendant was duly notified of the infringement, and continued, after such notice, to make, use, or vend the article so patented. [See Revised Statutes, Section 4900.]

SECTION 39. *And be it further enacted,* That if any person shall, in any manner, mark upon any thing made, used, or sold by him for which he has not obtained a patent, the name or any imitation of the name of any person who has obtained a patent therefor, without the consent of such patentee, or his assigns or legal representatives; or shall in any manner mark upon or affix to any such patented article the word "patent" or "patentee," or the words "letters-patent," or any word of like import, with intent to imitate or counterfeit the mark or device of the patentee, without having the license or consent of such patentee or his assigns or legal representatives; or shall in any manner mark upon or affix to any unpatented article the word "patent," or any word importing that the same is patented, for the purpose of deceiving the public, he shall be liable for every such of-

fense to a penalty of not less than one hundred dollars, with costs; one moiety of said penalty to the person who shall sue for the same, and the other to the use of the United States, to be recovered by suit in any district court of the United States within whose jurisdiction such offense may have been committed. [See Revised Statutes, Section 4901.]

SECTION 40. *And be it further enacted*, That any citizen of the United States, who shall have made any new invention or discovery, and shall desire further time to mature the same, may, on payment of the duty required by law, file in the Patent Office a caveat setting forth the design thereof, and of its distinguishing characteristics, and praying protection of his right until he shall have matured his invention; and such caveat shall be filed in the confidential archives of the office and preserved in secrecy, and shall be operative for the term of one year from the filing thereof; and if application shall be made within the year by any other person for a patent with which such caveat would in any manner interfere, the commissioner shall deposit the description, specification, drawings, and model of such application in like manner in the confidential archives of the office, and give notice thereof, by mail, to the person filing the caveat, who, if he would avail himself of his caveat, shall file his description, specification, drawings, and model within three months from the time of placing said notice in the post-office in Washington, with the usual time required for transmitting it to the caveator added thereto, which time shall be indorsed on the notice. And an alien shall have the privilege herein granted, if he shall have resided in the United States one year next preceding the filing of his caveat, and made oath of his intention to become a citizen. [See Revised Statutes, Section 4902.]

SECTION 41. *And be it further enacted,* That whenever, on examination, any claim for a patent is rejected for any reason whatever, the commissioner shall notify the applicant thereof, giving him briefly the reasons for such rejection, together with such information and references as may be useful in judging of the propriety of renewing his application or of altering his specification; and if, after receiving such notice, the applicant shall persist in his claim for a patent, with or without altering his specifications, the commissioner shall order a re-examination of the case. [See Revised Statutes, Section 4903.]

SECTION 42. *And be it further enacted,* That whenever an application is made for a patent which, in the opinion of the commissioner, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be, and shall direct the primary examiner to proceed to determine the question of priority of invention. And the commissioner may issue a patent to the party who shall be adjudged the prior inventor, unless the adverse party shall appeal from the decision of the primary examiner, or of the board of examiners-in-chief, as the case may be, within such time, not less than twenty days, as the commissioner shall prescribe. [See Revised Statutes, Section 4904.]

SECTION 43. *And be it further enacted,* That the commissioner may establish rules for taking affidavits and depositions required in cases pending in the Patent Office, and such affidavits and depositions may be taken before any officer authorized by law to take depositions to be used in the courts of the United States, or of the State where the officer resides. [See Revised Statutes, Section 4905.]

SECTION 44. *And be it further enacted*, That the clerk of any court of the United States, for any district or territory wherein testimony is to be taken for use in any contested case pending in the Patent Office, shall, upon the application of any party thereto, or his agent or attorney, issue [a] subpoena for any witness residing or being within said district or territory, commanding him to appear and testify before any officer in said district or territory authorized to take depositions and affidavits, at any time and place in the subpoena; and if any witness, after being duly served with such subpoena, shall neglect or refuse to appear, or after appearing shall refuse to testify, the judge of the court whose clerk issued the subpoena, may, on proof of such neglect or refusal, enforce obedience to the process, or punish the disobedience as in other like cases. [See Revised Statutes, Sections 4906 and 4908.]

SECTION 45. *And be it further enacted*, That every witness duly subpoenaed and in attendance shall be allowed the same fees as are allowed to witnesses attending the courts of the United States, but no witness shall be required to attend at any place more than forty miles from the place where the subpoena is served upon him, nor be deemed guilty of contempt for disobeying such subpoena, unless his fees and traveling expenses in going to, returning from, and one day's attendance at the place of examination, are paid or tendered him at the time of the service of the subpoena; nor for refusing to disclose any secret invention or discovery made or owned by himself. [See Revised Statutes, Sections 4906, 4907, and 4908.]

SECTION 46. *And be it further enacted*, That every applicant for a patent or the reissue of a patent, any of the claims of which have been twice rejected, and every

party to an interference, may appeal from the decision of the primary examiner, or of the examiner in charge of interference[s], in such case to the board of examiners-in-chief, having once paid the fee for such appeal provided by law. [See Revised Statutes, Section 4909.]

SECTION 47, *And be it further enacted,* That if such party is dissatisfied with the decision of the examiners-in-chief, he may, on payment of the duty required by law, appeal to the commissioner in person. [See Revised Statutes, Section 4910.]

SECTION 48. *And be it further enacted,* That if such party, except a party to an interference, is dissatisfied with the decision of the commissioner, he may appeal to the Supreme Court of the District of Columbia, sitting in banc. [See Revised Statutes, Section 4911.]

SECTION 49. *And be it further enacted,* That when an appeal is taken to the Supreme Court of the District of Columbia, the appellant shall give notice thereof to the commissioner, and file in the Patent Office, within such time as the commissioner shall appoint, his reasons of appeal, specifically set forth in writing. [See Revised Statutes, Section 4912.]

SECTION 50. *And be it further enacted,* That it shall be the duty of said court, on petition, to hear and determine such appeal, and to revise the decision appealed from in a summary way, on the evidence produced before the commissioner, at such early and convenient time as the court may appoint, notifying the commissioner of the time and place of hearing; and the revision shall be confined to the points set forth in the reasons of appeal. And after hearing the case, the court shall return to the commissioner a certificate of its proceedings and decision, which shall be entered of record in the Pat-

ent Office, and govern the further proceedings in the case. But no opinion or decision of the court in any such case shall preclude any person interested from the right to contest the validity of such patent in any court wherein the same may be called in question. [See Revised Statutes, Section 4914.]

SECTION 51. *And be it further enacted*, That on receiving notice of the time and place of hearing such appeal, the commissioner shall notify all parties who appear to be interested therein in such manner as the court may prescribe. The party appealing shall lay before the court certified copies of all the original papers and evidence in the case, and the commissioner shall furnish it with the grounds of his decision, fully set forth in writing, touching all the points involved by the reasons of appeal. And at the request of any party interested, or of the court, the commissioner and the examiners may be examined under oath, in explanation of the principles of the machine or other thing for which a patent is demanded. [See Revised Statutes, Section 4913.]

SECTION 52. *And be it further enacted*, That whenever a patent on application is refused, for any reason whatever, either by the commissioner or by the Supreme Court of the District of Columbia upon appeal from the commissioner, the applicant may have remedy by bill in equity; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim, or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent, on the applicant filing in the Patent Office a copy of the adjudication, and

otherwise complying with the requisitions of law. And in all cases where there is no opposing party a copy of the bill shall be served on the commissioner, and all the expenses of the proceeding shall be paid by the applicant, whether the final decision is in his favor or not. [See Revised Statutes, Section 4915.]

SECTION 53. *And be it further enacted*, That whenever any patent is inoperative or invalid, by reason of a defective or insufficient specification, or by reason of the patentee claiming as his own invention or discovery more than he had a right to claim as new, if the error has arisen by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, the commissioner shall, on the surrender of such a patent and the payment of the duty required by law, cause a new patent for the same invention, and in accordance with the corrected specification, to be issued to the patentee, or, in the case of his death or assignment of the whole or any undivided part of the original patent, to his executors, administrators, or assigns, for the unexpired part of the term of the original patent, the surrender of which shall take effect upon the issue of the amended patent; and the commissioner may, in his discretion, cause several patents to be issued for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for a reissue for each of such reissued letters patent. And the specifications and claim in every such case shall be subject to revision and restriction in the same manner as original applications are. And the patent so reissued, together with the corrected specification, shall have the effect and operation in law, on the trial of all actions for causes thereafter arising, as though the same had been originally filed in such corrected form; but no new matter shall be introduced into the specification, nor in case of a machine patent shall

the model or drawings be amended, except each by the other; but when there is neither model nor drawing, amendments may be made upon proof satisfactory to the commissioner that such new matter or amendment was a part of the original invention, and was omitted from the specification by inadvertence, accident, or mistake, as aforesaid. [See Section 4916, R. S. U. S.]

SECTION 54. *And be it further enacted*, That whenever, through inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, a patentee has claimed more than that of which he was the original or first inventor or discoverer, his patent shall be valid for all that part which is truly and justly his own, provided the same is a material or substantial part of the thing patented; and any such patentee, his heirs or assigns, whether of the whole or any sectional interest therein, may, on payment of the duty required by law, make disclaimer of such parts of the thing patented as he shall not choose to claim or to hold by virtue of the patent or assignment, stating therein the extent of his interest in such patent; said disclaimer shall be in writing, attested by one or more witnesses, and recorded in the Patent Office, and it shall thereafter be considered as part of the original specification to the extent of the interest possessed by the claimant and by those claiming under him after the record thereof. But no such disclaimer shall affect any action pending at the time of its being filed, except so far as may relate to the question of unreasonable neglect or delay in filing it. [See Section 4917, R. S. U. S.]

SECTION 55. *And be it futher enacted*, That all actions, suits, controversies, and cases arising under the patent laws of the United States shall be originally cognizable, as well in equity as at law, by the circuit courts of the

United States, or any district court having the powers and jurisdiction of a circuit court, or by the Supreme Court of the District of Columbia, or of any territory; and the court shall have power, upon bill in equity filed by any party aggrieved, to grant injunctions according to the course and principles of courts of equity, to prevent the violation of any right secured by patent, on such terms as the court may deem reasonable; and upon a decree being rendered in any such case for an infringement, the *claimant* [complainant] shall be entitled to recover, in addition to the profits to be accounted for by the defendant, the damages the complainant has sustained thereby, and the court shall assess the same or cause the same to be assessed under its direction, and the court shall have the same powers to increase the same in its discretion that are given by this act to increase the damages found by verdicts in actions upon the case; but all actions shall be brought during the term for which the letters-patent shall be granted or extended, or within six years after the expiration thereof. [See Sections 629, and 4921, R. S. U. S.]

SECTION 56. *And be it further enacted*, That a writ of error or appeal to the Supreme Court of the United States shall lie from all judgments and decrees of any circuit court, or of any district court exercising the jurisdiction of a circuit court, or of the Supreme Court of the District of Columbia, or of any Territory, in any action, suit, controversy, or case, at law or in equity, touching patent rights, in the same manner and under the same circumstances as in other judgments and decrees of such circuit courts, without regard to the sum or value in controversy. [See Section 699, R. S. U. S.]

SECTION 57. *And be it further enacted*, That written or printed copies of any records, books, papers, or draw-

ings belonging to the Patent Office, and of letters patent under the signature of the commissioner or acting commissioner, with the seal of office affixed, shall be competent evidence in all cases wherein the originals could be evidence, and any person making application therefor, and paying the fee required by law, shall have certified copies thereof. And copies of the specifications and drawings of foreign letters patent, certified in like manner, shall be prima facie evidence of the fact of the granting of such foreign letters patent, and of the date and contents thereof. [See Revised Statutes, Sections 892 and 893.]

SECTION 58. *And be it further enacted*, That whenever there shall be interfering patents, any person interested in any one of such interfering patents, or in the working of the invention claimed under either of such patents, may have relief against the interfering patentee, and all parties interested under him, by suit in equity against the owners of the interfering patent; and the court having cognizance thereof, as hereinbefore provided, on notice to adverse parties, and other due proceedings had according to the course of equity, may adjudge and declare either of the patents void in whole or in part, or inoperative, or invalid in any particular part of the United States, according to the interest of the parties in the patent or the invention patented. But no such judgment or adjudication shall affect the rights of any person except the parties to the suit and those deriving title under them subsequent to the rendition of such judgment. [See Revised Statutes, Section 4918.]

SECTION 59. *And be it further enacted*, That damages for the infringement of any patent may be recovered by action on the case in any circuit court of the United States, or district court exercising the jurisdiction of a

circuit court, or in the Supreme Court of the District of Columbia, or of any Territory, in the name of the party interested, either as patentee, assignee, or grantee. And whenever in any such action a verdict shall be rendered for the plaintiff, the court may enter judgment thereon for any sum above the amount found by the verdict as the actual damages sustained, according to the circumstances of the case, not exceeding three times the amount of such verdict, together with the costs. [See Revised Statutes, Section 629, ¶ 9, and Section 4919.]

SECTION 60. *And be it further enacted*, That whenever, through inadvertence, accident, or mistake, and without any wil[l]ful default or intent to defraud or mislead the public, a patentee shall have (in his specification) claimed to be the original and first inventor or discoverer of any material or substantial part of the thing patented, of which he was not the original and first inventor or discoverer as aforesaid, every such patentee, his executors, administrators, and assigns, whether of the whole or any sectional interest in the patent, may maintain a suit at law or in equity, for the infringement of any part thereof, which was bona fide his own, provided it shall be a material and substantial part of the thing patented, and be definitely distinguishable from the parts so claimed, without right as aforesaid, notwithstanding the specifications may embrace more than that of which the patentee was the original or first inventor or discoverer. But in every such case in which a judgment or decree shall be rendered for the plaintiff, no costs shall be recovered unless the proper disclaimer has been entered at the Patent Office before the commencement of the suit; nor shall he be entitled to the benefits of this section if he shall have unreasonably neglected or delayed to enter said disclaimer. [See Revised Statutes, Section 4922.]

SECTION 61. *And be it further enacted*, That in any action for infringement the defendant may plead the general issue, and having given notice in writing to the plaintiff or his attorney, thirty days before, may prove on trial any one or more of the following special matters:

First. That for the purpose of deceiving the public the description and specification filed by the patentee in the Patent Office was made to contain less than the whole truth relative to his invention or discovery, or more than is necessary to produce the desired effect; or,

Second. That he had surreptitiously or unjustly obtained the patent for that which was in fact invented by another, who was using reasonable diligence in adapting and perfecting the same; or,

Third. That it had been patented or described in some printed publication prior to his supposed invention or discovery thereof; or,

Fourth. That he was not the original and first inventor or discoverer of any material and substantial part of the thing patented; or,

Fifth. That it had been in public use or on sale in this country, for more than two years before his application for a patent, or had been abandoned to the public.

And in notices as to proof of previous invention, knowledge, or use of the thing patented, the defendant shall state the names of patentees and the dates of their patents, and when granted, and the names and residences of the persons alleged to have invented, or to have had the prior knowledge of the thing patented, and where and by whom it had been used; and if any one or more of the special matters alleged shall be found for the defendant, judgment shall be rendered for him with costs. And the like defenses may be pleaded in any suit in equity for relief against an alleged infringement; and proofs of the same may be given upon like notice in the

answer of the defendant, and with the like effect. [See Revised Statutes, Section 4920.]

SECTION 62. *And be it further enacted,* That whenever it shall appear that the patentee, at the time of making his application for the patent, believed himself to be the original and first inventor or discoverer of the thing patented, the same shall not be held to be void on account of the invention or discovery, or any part thereof, having been known or used in a foreign country, before his invention or discovery thereof, if it had not been patented or described in a printed publication. [See Revised Statutes, Section 4923.]

SECTION 63. *And be it further enacted,* That where the patentee of any invention or discovery, the patent for which was granted prior to the second day of March, eighteen hundred and sixty-one, shall desire an extension of his patent beyond the original term of its limitation, he shall make application therefor, in writing, to the commissioner, setting forth the reasons why such extension should be granted; and he shall also furnish a written statement under oath of the ascertained value of the invention or discovery, and of his receipts and expenditures on account thereof, sufficiently in detail to exhibit a true and faithful account of the loss and profit in any manner accruing to him by reason of said invention or discovery. And said application shall be filed not more than six months nor less than ninety days before the expiration of the original term of the patent; and no extension shall be granted after the expiration of said original term. [See Revised Statutes, Section 4924.]

SECTION 64. *And be it further enacted,* That upon the receipt of such application, and the payment of the duty required by law, the commissioner shall cause to be published in one newspaper in the city of Washington, and

in such other papers published in the section of the country most interested adversely to the extension of the patent as he may deem proper, for at least sixty days prior to the day set for hearing the case, a notice of such application, and of the time and place when and where the same will be considered, that any person may appear and show cause why the extension should not be granted. [See Revised Statutes, Section 4925.]

SECTION 65. *And be it further enacted*, That on the publication of such notice, the commissioner shall refer the case to the principal examiner having charge of the class of inventions to which it belongs, who shall make to said commissioner a full report of the case, and particularly whether the invention or discovery was new and patentable when the original patent was granted. [See Revised Statutes, Section 4926.]

SECTION 66. *And be it further enacted*, That the commissioner shall, at the time and place designated in the published notice, hear and decide upon the evidence produced, both for and against the extension; and if it shall appear to his satisfaction that the patentee, without neglect or fault on his part, has failed to obtain from the use and sale of his invention or discovery, a reasonable remuneration for the time, ingenuity, and expense bestowed upon it, and the introduction of it into use, and that it is just and proper, having due regard to the public interest, that the term of the patent should be extended, the said commissioner shall make a certificate thereon, renewing and extending the said patent for the term of seven years from the expiration of the first term, which certificate shall be recorded in the Patent Office, and thereupon the said patent shall have the same effect in law as though it had been originally granted for twenty-one years. [See Revised Statutes, Section 4927.]

SECTION 67. *And be it further enacted*, That the benefit of the extension of a patent shall extend to the assignees and grantees of the right to use the thing patented, to the extent of their interest therein. [See Rvised Statutes, Section 4928.]

SECTION 68. *And be it further enacted*, That the following shall be the rates for patent fees:—

On filing each original application for a patent, fifteen dollars.

On issuing each original patent, twenty dollars.

On filing each caveat, ten dollars.

On every application for the reissue of a patent, thirty dollars.

On filing each disclaimer, ten dollars.

On every application for the extension of a patent, fifty dollars.

On the granting of every extension of a patent, fifty dollars.

On an appeal for the first time from primary examiners to the examiners-in-chief, ten dollars.

On every appeal from the examiners-in-chief to the commissioner, twenty dollars.

For certified copies of patents and other papers, ten cents per hundred words.

For recording every assignment, agreement, power of attorney, or other paper, of three hundred words or under, one dollar; of over three hundred and under one thousand words, two dollars; of over one thousand words, three dollars.

For copies of drawings, the reasonable cost of making them. [See Revised Statutes, Section 4934.]

SECTION 69. *And be it further enacted*, That patent fees may be paid to the commissioner, or to the treasurer or any of the assistant treasurers of the United

States, or to any of the designated depositaries, national banks, or receivers of public money, designated by the Secretary of the Treasury for that purpose, who shall give the depositor a receipt or certificate of deposit therefor. And all money received at the Patent Office, for any purpose, or from any source whatever, shall be paid into the treasury as received, without any deduction whatever; and all disbursements for said office shall be made by the disbursing clerk of the Interior Department. [See Revised Statutes, Section 496 and 4935.]

SECTION 70. *And be it further enacted,* That the Treasurer of the United States is authorized to pay back any sum or sums of money to any person who shall have paid the same into the treasury, or to any receiver or depositary, to the credit of the treasurer, as for fees accruing at the Patent Office through mistake, certificate thereof being made to said treasurer by the Commissioner of Patents. [See Revised Statutes, Section 4936.]

SECTION 71. *And be it further enacted,* That any person who, by his own industry, genius, efforts, and expense, has invented or produced any new and original design for a manufacture, bust, statue, alto-relievo, or bas-relief; any new and original design for the printing of wool[l]en, silk, cotton, or other fabrics; any new and original impression, ornament, pattern, print, or picture, to be printed, painted, cast, or otherwise placed on or worked into any article of manufacture; or any new, useful, and original shape or configuration of any article of manufacture, the same not having been known or used by others before his invention or production thereof, or patented or described in any printed publication, may, upon payment of the duty required by law, and other due proceedings had the same as in cases of inventions or discoveries, obtain a patent therefor. [See Revised Statutes, Section 4929.]

SECTION 72. *And be it further enacted,* That the commissioner may dispense with models of designs when the design can be sufficiently represented by drawings or photographs. [See Revised Statutes, Section 4930.]

SECTION 73. *And be it further enacted,* That patents for designs may be granted for the term of three years and six months, or for seven years, or for fourteen years, as the applicant may, in his application, elect. [See Revised Statutes, Section 4931.]

SECTION 74. *And be it further enacted,* That patentees of designs issued prior to March two, eight hundred and sixty-one, shall be entitled to extension of their respective patents for the term of seven years, in the same manner and under the same restrictions as are provided for the extension of patents for inventions or discoveries issued prior to the second day of March, eighteen hundred and sixty-one. [See Revised Statutes, Section 4932.]

SECTION 75. *And be it further enacted,* That the following shall be the rates of fees in design cases:

For three years and six months, ten dollars.

For seven years, fifteen dollars.

For fourteen years, thirty dollars.

For all other cases in which fees are required, the same rates as in cases of inventions or discoveries. [See Revised Statutes, Section 4934.]

SECTION 76. *And be it further enacted,* That all the regulations and provisions which apply to the obtaining or protection of patents for inventions or discoveries, not inconsistent with the provisions of this act, shall apply to patents for designs. [See Revised Statutes, Section 4933.]

[Sections 77 to 110, inclusive, apply to trade-marks and copyrights, and not to patents.]

SECTION 111. *And be it further enacted*, That the acts and parts of acts set forth in the schedule of acts cited, hereto annexed, are hereby repealed, without reviving any acts or parts of acts repealed by any of said acts, or by any clause or provisions therein: *Provided, however*, That the repeal hereby enacted shall not affect, impair, or take away any right existing under any of said laws; but all actions and causes of action, both in law or in equity, which have arisen under any of said laws, may be commenced and prosecuted, and if already commenced may be prosecuted to final judgment and execution, in the same manner as though this act had not been passed, excepting that the remedial provisions of this act shall be applicable to all suits and proceedings hereafter commenced: *And provided also*, That all applications for patents pending at the time of the passage of this act, in cases where the duty has been paid, shall be proceeded with and acted on in the same manner as though filed after the passage thereof: *And provided further*, That all offences which are defined and punishable under any of said acts, and all penalties and forfeitures created thereby and incurred before this act takes effect, may be prosecuted, sued for, and recovered, and such offences punished according to the provision of said acts, which are continued in force for such purpose.

APPROVED July 8, 1870.

Repealed June 22, 1874. Revised Statutes, Title LXXIV.

ACT OF MARCH 3, 1871.

16 STATUTES AT LARGE, 583.

An Act to amend an Act to revise, consolidate, and amend the Statutes relating to Patents and Copyrights.

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That that part of section thirty-three of an act entitled "An act to revise, consolidate, and amend the statutes relating to patents and copyrights," approved July eighth, eighteen hundred and seventy, which requires that, in case of application by assignee or assignees for reissue of letters patent, the application shall be made and the specification sworn to by the inventor or discoverer, if living, shall not be construed to apply to patents issued and assigned prior to July eighth, eighteen hundred and seventy.

APPROVED March 3, 1871.

Repealed June 22, 1874. Revised Statutes, Title LXXIV.

ACT OF MARCH 24, 1871.

17 STATUTES AT LARGE, 2.

An Act to further regulate the publication of the Specifications and Drawings of the Patent Office.

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That if, in the judgment of the joint committee on printing, the provisions of the joint resolution providing for publishing specifications and drawings of the

Patent Office, approved January eleventh, eighteen hundred and seventy-one, can be performed under the direction of the Commissioner of Patents more advantageously than in the manner provided in said joint resolution, it shall be so done, under such limitations and conditions as the joint committee on printing may from time to time prescribe.

SECTION 2. That the price of the printed copies of specifications and drawings of patents, when uncertified, shall be determined by the Commissioner of Patents, ten cents being hereby fixed as the minimum, and fifty cents as the maximum price of the same; certified copies to be sold at the price fixed by the patent act of eighteen hundred and seventy.

APPROVED March 24, 1871.

Repealed June 22, 1874. Revised Statutes, Title LXXIV.

SECTIONS OF THE REVISED STATUTES OF THE UNITED STATES.

RELATING TO PATENTS.

SECTION 440. There shall also be in the Department of the Interior:

* * * * * * * *

In the Patent Office:

One chief clerk, at a salary of two thousand five hundred dollars a year.

One examiner in charge of interferences, at a salary of two thousand five hundred dollars a year.

One examiner in charge of trade-marks, at a salary of two thousand five hundred dollars a year.

Twenty-four principal examiners, at a salary of two thousand five hundred dollars a year each.

Twenty-four first assistant examiners, at a salary of one thousand eight hundred dollars a year each.

Twenty-four second assistant examiners (two of whom may be women), at a salary of one thousand six hundred dollars a year each.

Twenty-four third assistant examiners, at a salary of one thousand four hundred dollars a year each.

One librarian, at a salary of two thousand dollars a year.

One machinist, at a salary of one thousand six hundred dollars a year.

Three skilled draughtsmen, at a salary of one thousand two hundred dollars a year each.

Thirty-five copyists of drawings, at a salary of one thousand dollars a year each.

One messenger and purchasing clerk, at a salary of one thousand dollars a year.

One skilled laborer, at a salary of one thousand two hundred dollars a year.

Eight attendants in the model-room, at a salary of one thousand dollars a year each.

Eight attendants in the model-room, at a salary of nine hundred dollars a year each. [See former Acts: Sections 2 and 3, 1870; Sections 4 and 7, 1861; Sections 1 and 3. 1848; Section 10, 1837; Section 2, 1836.]

SECTION 441. The Secretary of the Interior is charged with supervising all public business relating to * * *

Fifth. Patents for inventions. [See former Acts; Section 1, Act of 1870; Section 2, Act of 1849.]

SECTION 475. There shall be in the Department of the Interior an office known as the Patent Office, where all records, books, models, drawings, specifications, and other papers and things pertaining to patents shall be safely kept and preserved. [See former Acts: Section 1, Act of 1870; Section 1, Act of 1836.]

SECTION 476. There shall be in the Patent Office a Commissioner of Patents, one Assistant Commissioner, and three examiners-in-chief, who shall be appointed by the President, by and with the advice and consent of the Senate. All other officers, clerks, and employees authorized by law for the Office shall be appointed by the Secretary of the Interior, upon the nomination of the Commissioner of Patents. [See former Acts: Section 2, Act of 1870; Section 2, Act of 1861; Section 1, Act of 1836.]

SECTION 477. The salaries of the officers mentioned in the preceding section shall be as follows:

The Commissioner of Patents, four thousand five hundred dollars a year.

The Assistant Commissioner of Patents, three thousand dollars a year.

Three examiners-in-chief, three thousand dollars a year each. [See former Acts: Section 4, 1870; Sections 2 and 4, Act of 1861; Section 11, Act of 1837; Section 1, Act of 1836.]

SECTION 478. The seal heretofore provided for the Patent Office shall be the seal of the Office, with which letters patent and papers issued from the Office shall be authenticated. [See former Acts: Section 12, Act of 1870; Section 4, Act of 1836.]

APPROPRIATION ACT OF MARCH 4, 1909.

Patent Office: For the Commissioner of Patents, five thousand dollars; first assistant commissioner, who shall perform such duties pertaining to the office of commissioner as may be assigned to him by the commissioner, four thousand five hundred dollars; assistant commissioner, who shall perform such duties pertaining to the

office of commissioner as may be assigned to him by the commissioner, three thousand five hundred dollars; chief clerk, who shall be qualified to act as a principal examiner, three thousand dollars; two law examiners, at two thousand seven hundred and fifty dollars each; three examiners in chief, at three thousand five hundred dollars each; examiners of interferences, two thousand seven hundred dollars; examiner of trade-marks and designs, two thousand seven hundred dollars; examiner of classification, three thousand six hundred dollars; forty-two principal examiners, at two thousand seven hundred dollars each; fifty-eight first assistant examiners, at two thousand four hundred dollars each; sixty-eight second assistant examiners, at two thousand one hundred dollars each; seventy-eight third assistant examiners, at one thousand eight hundred dollars each; one hundred and ten fourth assistant examiners, at one thousand five hundred dollars each; financial clerk who shall give bonds in such amount as the Secretary of the Interior may determine, two thousand two hundred and fifty dollars; librarian, two thousand dollars; six chiefs of division, at two thousand dollars each; three assistant chiefs of division, at one thousand eight hundred dollars each; translator of languages, one thousand eight hundred dollars; nine clerks of class four; nine clerks of class three; seventeen clerks of class two; ninety-five clerks of class one; skilled laborer, one thousand two hundred dollars; three skilled draftsmen, at one thousand two hundred dollars each; four draftsmen, at one thousand dollars each; ninety clerks, at one thousand dollars each; messenger and property clerk, one thousand dollars; ninety copyists; eighty-five copyists, at seven hundred and twenty dollars each; four messengers; twenty-five assistant messengers; fourteen laborers, at six hundred dollars each; forty-two laborers, at four hundred and eighty dollars each; forty

messenger boys, at three hundred and sixty dollars each; in all, one million two hundred and thirty-nine thousand nine hundred and seventy dollars.

For purchase of professional and scientific books and expense of transporting publications of patents issued by the Patent Office to foreign governments, two thousand five hundred dollars.

For purchase of law books, five hundred dollars.

For producing copies of the weekly issue of patents, designs, and trade-marks; for the reproduction of copies of drawings and specifications of exhausted patents and other papers; one hundred and forty thousand dollars.

For investigating the question of the public use or sale of inventions for two years or more prior to filing applications for patents, and for expense attending defense of suits instituted against the Commissioner of Patents, two hundred and fifty dollars.

For the share of the United States in the expense of conducting the International Bureau at Berne, Switzerland, seven hundred and fifty dollars.

SECTION 479. The Commissioner of Patents and the chief clerk, before entering upon their duties, shall severally give bond, with sureties, to the Treasurer of the United States, the former in the sum of ten thousand dollars, and the latter in the sum of five thousand dollars, conditioned for the faithful discharge of their respective duties, and that they shall render to the proper officers of the Treasury a true account of all money received by virtue of their offices. [See former Act: Section 6, Act of 1870; Section 3, Act of 1836.]

SECTION 480. All officers and employees of the Patent Office shall be incapable, during the period for which they hold their appointments, to acquire or take, directly or indirectly, except by inheritance or bequest, any right or

interest in any patent issued by the Office. [See former Act: Section 16, 1870.]

SECTION 481. The Commissioner of Patents, under the direction of the Secretary of the Interior, shall superintend or perform all duties respecting the granting and issuing of patents directed by law; and he shall have charge of all books, records, papers, models, machines, and other things belonging to the Patent Office. [See former Act: Section 7, 1870; Section 1, 1836.]

SECTION 482. The examiners-in-chief shall be persons of competent legal knowledge and scientific ability, whose duty it shall be, on the written petition of the appellant, to revise and determine upon the validity of the adverse decisions of examiners upon applications for patents, and for re-issues of patents, and in interference cases; and, when required by the Commissioner, they shall hear and report upon claims for extensions, and perform such other like duties as he may assign them. [See former Act: Section 10, 1870; Section 2, 1861.]

SECTION 483. The Commissioner of Patents, subject to the approval of the Secretary of the Interior, may from time to time establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent Office. [See former Act: Section 19, 1870.]

SECTION 484. The Commissioner of Patents shall cause to be classified and arranged in suitable cases, in the rooms and galleries provided for that purpose, the models, specimens of composition, fabrics, manufactures, works of art, and designs, which have been or shall be deposited in the Patent Office; and the rooms and galleries shall be kept open during suitable hours for public inspection. [See former Act: Section 13, 1870; Section 20, 1836.]

SECTION 485. The Commissioner of Patents may restore to the respective applicants such of the models belonging to rejected applications as he shall not think necessary to be preserved, or he may sell or otherwise dispose of them after the application has been finally rejected for one year, paying the proceeds into the Treasury, as other patent moneys are directed to be paid. [See former Acts: Section 14, 1870; Section 5, 1861.]

SECTION 486. There shall be purchased for the use of the Patent Office a library of such scientific works and periodicals, both foreign and American, as may aid the officers in the discharge of their duties, not exceeding the amount annually appropriated for that purpose. [See former Act: Section 15, 1870.]

SECTION 487. For gross misconduct the Commissioner of Patents may refuse to recognize any person as a patent agent, either generally or in any particular case; but the reasons for such refusal shall be duly recorded, and be subject to the approval of the Secretary of the Interior. [See former Act: Section 17, 1870.]

SECTION 488. The Commissioner of Patents may require all papers filed in the Patent Office, if not correctly, legibly, and clearly written, to be printed at the cost of the party filing them. [See former Acts: Section 18, 1870; Section 8, 1861.]

SECTION 489. The Commissioner of Patents may print, or cause to be printed, copies of the claims of current issues, and copies of such laws, decisions, regulations, and circulars as may be necessary for the information of the public. [See former Act: Section 20, 1870.]

SECTION 490. The Commissioner of Patents is authorized to have printed, from time to time, for gratuitous

distribution, not to exceed one hundred and fifty copies of the complete specifications and drawings of each patent hereafter issued, together with suitable indexes, one copy to be placed for free public inspection in each capitol of every State and Territory, one for the like purpose in the clerk's office of the district court of each judicial district of the United States, except when such offices are located in State or territorial capitols, and one in the Library of Congress, which copies shall be certified under the hand of the Commissioner and seal of the Patent Office, and shall not be taken from the depositories for any other purpose than to be used as evidence. [See Section 894, R. S. U. S.]

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

SECTION 492. The lithographing and engraving required by the two preceding sections shall be awarded to the lowest and best bidders for the interests of the Government, due regard being paid to the execution of the work, after due advertising by the Congressional Printer, under the direction of the Joint Committee on Printing; but the Joint Committee on Printing may em-

power the Congressional Printer to make immediate contracts for engraving, whenever, in their opinion, the exigencies of the public service will not justify waiting for advertisement and award; or if, in the judgment of the Joint Committee on Printing, the work can be performed under the direction of the Commissioner of Patents more advantageously than in the manner above prescribed, it shall be so done, under such limitations and conditions as the Joint Committee on Printing may from time to time prescribe. [See Joint Resolution No. 5, January 11, 1871, 16 Statutes at Large, 590, and Section 1 of Patent Act of March 24, 1871.]

ACT OF MARCH 3, 1875.

SECTION 12. That it shall be the duty of the Commissioner of Patents to furnish, free of cost, one copy of the bound volumes of specifications and drawings of patents published by the Patent Office to each of the Executive Departments of the Government, upon the request of the head thereof.

ACT OF JANUARY 12, 1895.

28 STATUTES AT LARGE, 619.

The Commissioner of Patents, upon the requisition of the Secretary of the Interior, is authorized to continue the printing of the following:

First. The patents for inventions and designs issued by the Patent Office, including grants, specifications, and drawings, together with copies of the same, and of patents already issued, in such number as may be needed for the business of the Office.

Second. The certificates of trade-marks and labels registered in the Patent Office, including descriptions and drawings, together with copies of the same, and of trade-marks and labels heretofore registered, in such numbers as may be needed for the business of the Office.

Third. The Official Gazette of the United States Patent Office in numbers sufficient to supply all who shall subscribe therefor at five dollars per annum; also to exchange for other scientific publications desirable for the use of the Patent Office; also to supply one copy to each Senator, Representative, and Delegate in Congress; also to supply one copy to eight such public libraries having over one thousand volumes, exclusive of Government publications, as shall be designated by each Senator, Representative, and Delegate in Congress, with one hundred additional copies, together with bimonthly and annual indexes for all the same; of the Official Gazette the "usual number" shall not be printed.

Fourth. The report of the Commissioner of Patents for the fiscal year, not exceeding five hundred in number, for distribution by him; the Annual Report of the Commissioner of Patents to Congress, without the list of patents, not exceeding one thousand five hundred in number for distribution by him; and of the Annual Report of the Commissioner of Patents to Congress, with the list of patents, five hundred copies for sale by him, if needed, and in addition thereto the "usual number" only shall be printed.

Fifth. Copies of the specifications and drawings of each patent issued, bound in monthly volumes, one copy for each of the Executive Departments of the Government, one copy to be placed for free public inspection in each capitol of every State and Territory, one for the like purpose in the clerk's office of the district court of each judicial district of the United States, except when such offices are located in State or Territorial capitols, and

one in the library of Congress, which copies shall be certified under the hand of the Commissioner and seal of the Patent Office, and shall not be taken from the depositories for any other purpose than to be used as evidence; also one hundred additional copies of the same, for sale by him at a price to be fixed by the Secretary of the Interior. The "usual number" shall not be printed.

Sixth. Pamphlet copies of the rules of practice, pamphlet copies of the patent laws, and pamphlet copies of the laws and rules relating to trade-marks and labels, and circulars relating to the business of the Office, all in such numbers as may be needed for the business of the Office. The "usual number" shall not be printed.

Seventh. Annual volumes of the decisions of the Commissioner of Patents and of the United States courts in patent cases, not exceeding one thousand five hundred in number, of which the "usual number" shall be printed, and for this purpose a copy of each shall be transmitted to Congress promptly when prepared.

Eighth. Indexes to patents relating to electricity, and indexes to foreign patents, in such numbers as may be needed for the business of Office. The "usual number" shall not be printed.

All printing for the Patent Office making use of lithography or photolithography, together with the plates for the same, shall be contracted for and performed under the direction of the Commissioners of Patents, under such limitations and conditions as the Joint Committee on Printing may from time to time prescribe, and all other printing for the Patent Office shall be done by the Public Printer under such limitations and conditions as the Joint Committee on Printing may from time to time prescribe: *Provided*, That the entire work may be done at the Government Printing Office whenever in the judg-

ment of the Joint Committee on Printing the same would be to the interest of the Government.

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SECTION 493. The price to be paid for uncertified printed copies of specifications and drawings of patents shall be determined by the Commissioner of Patents: *Provided*, That the maximum cost of a copy shall be ten cents.

SECTION 494. The Commissioner of Patents shall lay before Congress, in the month of January, annually, a report, giving a detailed statement of all moneys, received for patents, for copies of records or drawings, or from any other source whatever; a detailed statement of all expenditures for contingent and miscellaneous expenses; a list of all patents which were granted during the preceding year; designating under proper heads the subjects of such patents; an alphabetical list of all the patentees, with their places of residence; a list of all patents which have been extended during the year; and such other information of the condition of the Patent Office as may be useful to Congress or the public. [See Sections 195, 196.]

SECTION 496. All disbursements for the Patent Office shall be made by the disbursing clerk of the Interior Department.

ACT OF JULY 8, 1870.

16 STATUTES AT LARGE, 209.

SECTION 7. That in every case where the head of any Department of the Government shall request the Commissioner of Patents to expedite the consideration of an application for a patent it shall be the duty of such head of a Department to be represented before the Commissioner in order to prevent the improper issue of a patent.

SECTION 629. The circuit courts shall have original jurisdiction, as follows: * * *

Ninth. Of all suits at law or in equity arising under the patent or copyright laws of the United States. [See former Acts: Section 55, 1870; Section 14, 1836; Section 1, 1819. Repealed by Section 289, The Judicial Code.]

ACT OF MARCH 3, 1897.

SECTION 699. A writ of error may be allowed to review any final judgment at law, and an appeal shall be allowed from any final decree in equity hereinafter mentioned, without regard to the sum or value in dispute:

First. Any final judgment at law or final decree in equity of any circuit court, or of any district court acting as a circuit court, or of the Supreme Court of the District of Columbia, or of any Territory, in any case touching patent rights or copyrights. [See former Acts: Section 56, 1870; Section 1, February 18, 1861; Section 16, 1836; Section 1, 1819. Repealed by Section 289, The Judicial Code.]

SECTION 718. Whenever notice is given of a motion for an injunction out of a circuit or district court, the court or judge thereof may, if there appears to be danger or

irreparable injury from delay, grant an order restraining the act sought to be enjoined until the decision upon the motion; and such order may be granted with or without security, in the discretion of the court or judge. (Act of June 1, 1872, ch. 255, 17 Stat. at L. 197. Repealed and re-enacted as Section 263, The Judicial Code.)

SECTION 725. The said courts shall have power to impose and administer all necessary oaths, and to punish, by fine or imprisonment, at the discretion of the court, contempts of their authority: *Provided,* That such power to punish contempts shall not be construed to extend to any cases except the misbehavior of any person in their presence, or so near thereto as to obstruct the administration of justice, the misbehavior of any of the officers of said courts in their official transactions, and the disobedience or resistance by any such officer, or by any party, juror, witness, or other person, to any lawful writ, process, order, rule, decree, or command of the said courts. (Re-enacted as Section 268, The Judicial Code.)

SECTION 892. Written or printed copies of any records, books, papers, or drawings belonging to the Patent Office, and of letters patent authenticated by the seal and certified by the Commissioner or Acting Commissioner thereof, shall be evidence in all cases wherein the originals could be evidence; and any person making application therefor, and paying the fee required by law, shall have certified copies thereof. [See former Acts: Section 57, 1870; Section 15, March 2, 1861; Section 2, 1837; Section 4, 1836; Sections 3, 6, 1790.]

SECTION 893. Copies of the specifications and drawings of foreign letters patent, certified as provided in the preceding section, shall be prima facie evidence of the fact of the granting of such letters patent, and of the

date and contents thereof. [See former Act: Section 57, 1870.]

SECTION 894. The printed copies of specifications and drawings of patents, which the Commissioner of Patents is authorized to print for gratuitous distribution, and to deposit in the capitols of the States and Territories, and in the clerk's offices of the district courts, shall, when certified by him and authenticated by the seal of his office, be received in all courts as evidence of all matters therein contained.

SECTION 973. When judgment or decree is rendered for the plantiff or complainant, in any suit at law or in equity, for the infringement of a part of a patent, in which it appears that the patentee, in his specification, claimed to be the original and first inventor or discoverer of any material or substantial part of the thing patented, of which he was not the original and first inventor, no costs shall be recovered, unless the proper disclaimer, as provided by the patent laws, has been entered at the Patent Office before the suit was brought. [See Section 4922, R. S. U. S.; and former Acts: Section 60, 1870; Section 9, 1837; Section 15, 1836.]

SECTION 1537. No patented article connected with marine engines shall hereafter be purchased or used in connection with any steam vessels of war until the same shall have been submitted to a competent board of naval engineers, and recommended by such board, in writing, for purchase and use.

SECTION 1673. No royalty shall be paid by the United States to any one of its officers or employees for the use of any patent for the system, or any part thereof, mentioned in the preceding section, nor for any such patent in which said officers or employees may be directly or indirectly interested.

SECTION 4883. All patents shall be issued in the name of the United States of America, under the seal of the Patent Office, and shall be signed by the Secretary of the Interior and countersigned by the Commissioner of Patents, and they shall be recorded, together with the specifications, in the Patent Office, in books to be kept for that purpose. [See former Acts: Section 21, Act of 1870; Section 5, Act of 1836; Section 1, Act of 1793; Section 1, Act of 1790.]

SECTION 4884. Every patent shall contain a short title or description of the invention or discovery, correctly indicating its nature and design, and a grant to the patentee, his heirs or assigns, for the term of seventeen years, of the exclusive right to make, use, and vend the invention or discovery throughout the United States, and the Territories thereof, referring to the specification for the particulars thereof. A copy of the specification and drawings shall be annexed to the patent and be a part thereof. [See former Acts: Section 22, 1870; Section 16, 1861; Section 5, 1836; Section 1, 1793; Section 1, 1790.]

SECTION 4885. Every patent shall issue within a period of three months from the date of the payment of the final fee, which fee shall be paid not later than six months from the time at which the application was passed and allowed and notice thereof was sent to the applicant or his agent; and if the final fee is not paid within that period the patent shall be withheld.

SECTION 4886. Any person who has invented or discovered any new and useful art, machine, manufacture or composition of matter, or any new and useful improvement thereof, not known or used by others in this country, and not patented or described in any printed publication in this or any foreign country, before his invention

or discovery thereof, and not in public use or on sale for more than two years prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law, and other due proceedings had, obtain a patent therefor. [See former Acts: Section 24, 1870; Sections 6 and 7, 1836; Section 1, 1800; Section 1, 1793.]

ACT OF MARCH 3, 1883.

CHAPTER 143, 22 STATUTES AT LARGE, 625.

The Secretary of the Interior and the Commissioner of Patents are authorized to grant any officer of the Government, except officers and employees of the Patent Office, a patent for any invention of the classes mentioned in section forty-eight hundred and eighty-six of the Revised Statutes when such invention is used or to be used in the public service, without the payment of any fee: *Provided*, That the applicant in his application shall state that the invention described therein, if patented, may be used by the Government or any of its officers or employees in prosecution of work for the Government, or by any other person in the United States, without the payment to him of any royalty thereon, which stipulation shall be included in the patent.

SECTION 4887. No person otherwise entitled thereto shall be debarred from receiving a patent for his invention or discovery, nor shall any patent be declared invalid by reason of its having been first patented or caused to be patented by the inventor or his legal representatives or assigns in a foreign country, unless the application for said foreign patent was filed more than twelve months, in cases within the provisions of section forty-eight hundred and eighty-six of the Revised Statutes, and

four months in cases of designs, prior to the filing of the application in this country, in which case no patent shall be granted in this country.

An application for patent for an invention or discovery or for a design filed in this country by any person who has previously regularly filed an application for a patent for the same invention, discovery, or design in a foreign country which, by treaty, convention, or law, affords similar privileges to citizens of the United States shall have the same force and effect as the same application would have if filed in this country on the date on which the application for patent for the same invention, discovery, or design was first filed in such foreign country, provided the application in this country is filed within twelve months in cases within the provisions of section forty-eight hundred and eighty-six of the Revised Statutes, and within four months in cases of designs, from the earliest date on which any such foreign application was filed. But no patent shall be granted on an application for patent for an invention or discovery or a design which had been patented or described in a printed publication in this or any foreign country more than two years before the date of the actual filing of the application in this country, or which had been in public use or on sale in this country for more than two years prior to such filing. [As amended, Act March 3, 1903, c. 1019; compare former sections, Section 25, Act of 1870; Section 6, Act of 1839; Section 8, Act of 1836.]

SECTION 4888. Before any inventor or discoverer shall receive a patent for his invention or discovery, he shall make application therefor, in writing, to the Commissioner of Patents, and shall file in the Patent Office a written description of the same, and of the manner and process of making, constructing, compounding, and using it, in such full, clear, concise, and exact terms as to enable

any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound and use the same; and in case of a machine, he shall explain the principle thereof, and the best mode in which he has contemplated applying that principle, so as to distinguish it from other inventions; and he shall particularly point out and distinctly claim, the part, improvement, or combination which he claims as his invention or discovery. The specification and claim shall be signed by the inventor and attested by two witnesses. [See former Acts: Section 26, 1870; Section 6, 1836; Section 1, 1793; Section 2, 1790.]

SECTION 4889. When the nature of the case admits of drawings, the applicant shall furnish one copy, signed by the inventor or his attorney in fact, and attested by two witnesses, which shall be filed in the Patent Office, and a copy of the drawing, to be furnished by the Patent Office, shall be attached to the patent as a part of the specification. [See former Acts: Section 27, 1870; Section 6, 1837; Section 6, 1836; Section 3, 1793.]

SECTION 4890. When the invention or discovery is of a composition of matter, the applicant, if required by the Commissioner, shall furnish specimens of ingredients and of the composition, sufficient in quantity for the purpose of experiment. [See former Acts: Section 28, 1870; Section 6, 1836; Section 3, 1793.]

SECTION 4891. In all cases which admit of representation by model, the applicant, if required by the Commissioner, shall furnish a model of convenient size to exhibit advantageously the several parts of his invention or discovery. [See former Acts: Section 29, 1870; Section 6, 1836; Section 3, 1793; Section 2, 1790.]

SECTION 4892. The applicant shall make oath that he does verily believe himself to be the original and first inventor or discoverer of the art, machine, manufacture, composition, or improvement for which he solicits a patent; that he does not know and does not believe that the same was ever before known or used; and shall state of what country he is a citizen. Such oath may be made before any person within the United States authorized by law to administer oaths, or when the applicant resides in a foreign country, before any minister, *charge de'affaires,* consul, or commercial agent, holding commission under the Government of the United States, or before any notary public of the foreign country in which the applicant may be. [See former Acts: Section 30, 1870; Section 4, 1842; Section 6, 1836; Section 3, 1793.]

SECTION 4893. On the filing of any such application and the payment of fees required by law, the Commissioner of Patents shall cause an examination to be made of the alleged new invention or discovery; and if on such examination it shall appear that the claimant is justly entitled to a patent under the law, and that the same is sufficiently useful and important, the Commissioner shall issue a patent therefor. [See former Acts: Section 31, 1870; Section 7, 1836; Section 1, 1790.]

SECTION 4894. All applications for patents shall be completed and prepared for examination within two years after the filing of the application, and in default thereof, or upon failure of the applicant to prosecute the same within two years after any action therein, of which notice shall have been given to the applicant, they shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner of Patents that such delay was unavoidable. [See former Acts: Section 32, 1870; Section 12, 1861.]

SECTION 4895. Patents may be granted and issued or reissued to the assignee of the inventor or discoverer; but the assignment must first be entered of record in the Patent Office. And in all cases of an application by an assignee for the issue of a patent, the application shall be made and the specification sworn to by the inventor or discoverer; and in all cases of an application for a reissue of any patent, the application must be made and the corrected specification signed by the inventor or discoverer, if he is living, unless the patent was issued and the assignment made before the eighth day of July, eighteen hundred and seventy. [See former Acts: Section 33, 1870; Section 6, 1837.]

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

country to administer upon the estate of the deceased inventor shall, in case the said inventor was not domiciled in the United States at the time of his death, have the right to apply for and obtain the patent. The authority of such foreign executor or administrator shall be proved by certificate of a diplomatic or consular official of the United States.

SECTION 4897. Any person who has an interest in an invention or discovery, whether as inventor, discoverer, or assignee, for which a patent was ordered to issue upon the payment of the final fee, but who fails to make payment thereof within six months from the time at which it was passed and allowed, and notice thereof was sent to the applicant or his agent, shall have a right to make an application for a patent for such invention or discovery the same as in the case of an original application. But such second application must be made within two years after the allowance of the original application. But no person shall be held responsible in damages for the manufacture or use of any article or thing for which a patent was ordered to issue under such renewed application prior to the issue of the patent. And upon the hearing of renewed applications preferred under this section, abandonment shall be considered as a question of fact. [See former Acts: Section 35, 1870; Section 1, 1865; Section 1, 1864.]

In the case of a renewal application under this section additional claims may be secured. Bowers v. San Francisco Bridge Co., 69 Fed. Rep. 640. For many years it was the practice of the Patent Office to permit any number of renewal applications to be made, within the two years limit of this statute. This practice was changed to permit but one renewal, in 1894: Ex parte Weil, 122 Off. Gaz. 352. In 1908 the ancient practice was restored and more than one renewal of a forfeited application is now permitted, provided it is made within the two years following the date of the original application. In re Lambert, 135 Off. Gaz. 1584; Ex parte Lambert, 135 Off. Gaz. 1581.

SECTION 4898. Every patent or any interest therein shall be assignable in law, by an instrument in writing; and the patentee or his assigns or legal representatives may, in like manner, grant and convey an exclusive right under his patent to the whole or any specified part of the United States. An assignment, grant, or conveyance shall be void as against any subsequent purchaser or mortgagee for a valuable consideration, without notice, unless it is recorded in the Patent Office within three months from the date thereof. [See former Acts: Section 36, 1870; Section 11, 1836; Section 4, 1793.]

SECTION 4899. Every person who purchases of the inventor or discoverer, or with his knowledge and consent constructs any newly invented or discovered machine, or other patentable article, prior to the application by the inventor or discoverer for a patent, or who sells or uses one so constructed, shall have the right to use, and vend to others to be used, the specific thing so made or purchased, without liability therefor. [See former Acts: Section 37, 1870; Section 7, 1839.]

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

so patented. [See former Acts: Section 38, 1870; Section 13, 1861; Section 6, 1842.]

SECTION 4901. Every person who, in any manner, marks upon anything made, used, or sold by him for which he has not obtained a patent, the name or any imitation of the name of any person who has obtained a patent therefor without the consent of such patentee, or his assigns or legal representatives; or

Who, in any manner, marks upon or affixes to any such patented article the word "patent" or "patentee," or the words "letters patent," or any word of like import, with intent to imitate or counterfeit the mark or device of the patentee, without having the license or consent of such patentee or his assigns or legal representatives; or

Who, in any manner, marks upon or affixes to any unpatented article the word "patent," or any word importing that the same is patented, for the purpose of deceiving the public, shall be liable, for every such offense, to a penalty of not less than one hundred dollars, with costs; one half of said penalty to the person who shall sue for the same, and the other to the use of the United States, to be recovered by suit in any district court of the United States, within whose jurisdiction such offense may have been committed. [See former Acts: Section 39, 1870; Section 5, 1824.]

SECTION 4902. [Repealed, June 25, 1910, 36 Statutes at Large, ch. 414.] Any citizen of the United States who makes any new invention or discovery, and desires further time to mature the same, may, on payment of the fees required by law, file in the Patent Office a caveat setting forth the design thereof, and of his distinguishing characteristics, and praying protection of his right until he shall have matured his invention. Such caveat shall be filed in the confidential archives of the office and pre-

served in secrecy, and shall be operative for the term of one year from the filing thereof; and if application is made within the year by any other person for a patent with which such caveat would in any manner interfere, the Commissioner shall deposit the description, specification, drawings, and model of such application in like manner in the confidential archives of the office, and give notice thereof, by mail, to the person by whom the caveat was filed. If such person desires to avail himself of his caveat, he shall file his description, specifications, drawings, and model within three months from the time of placing the notice in the post-office in Washington, with the usual time required for transmitting it to the caveator added thereto; which time shall be indorsed on the notice. An alien shall have the privilege herein granted, if he has resided in the United States one year next preceding the filing of his caveat, and has made oath of his intention to become a citizen. [See former Acts: Section 40, 1870; Section 9, 1861; Section 12, 1836.]

SECTION 4903. Whenever, on examination, any claim for a patent is rejected, the Commissioner shall notify the applicant thereof, giving him briefly the reasons for such rejection, together with such information and references as may be useful in judging of the propriety of renewing his application or of altering his specification; and if, after receiving such notice, the applicant persists in his claim for a patent, with or without altering his specifications, the Commissioner shall order a re-examination of the case. [See former Acts: Section 41, 1870; Section 7, 1836.]

SECTION 4904. Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the

applicants, or applicant and patentee, as the case may be, and shall direct the primary examiner to proceed to determine the question of priority of invention. And the Commissioner may issue a patent to the party who is adjudged the prior inventor, unless the adverse party appeals from the decision of the primary examiner, or of the board of examiners-in-chief, as the case may be, within such time, not less than twenty days, as the Commissioner shall prescribe. [See former Acts: Section 42. 1870; Section 8, 1836; Section 9, 1793.]

SECTION 4905. The Commissioner of Patents may establish rules for taking affidavits and depositions required in cases pending in the Patent Office, and such affidavits and depositions may be taken before any officer authorized by law to take depositions to be used in the courts of the United States, or of the State where the officer resides. [See former Acts: Section 43, 1870; Section 1, March 3, 1861; Section 12, 1839.]

SECTION 4906. The clerk of any court of the United States, for any district or Territory wherein testimony is to be taken for use in any contested case pending in the Patent Office, shall, upon the application of any party thereto, or of his agent or attorney, issue a subpoena for any witness residing or being within such district or Territory, commanding him to appear and testify before any officer in such district or Territory authorized to take depositions and affidavits, at any time and place in the subpoena stated. But no witness shall be required to attend at any place more than forty miles from the place where the subpoena is served upon him. [See former Acts: Section 44, 1870; Section 1, 1861.]

SECTION 4907. Every witness duly subpoenaed and in attendance shall be allowed the same fees as are allowed

to witnesses attending the courts of the United States. [See former Acts: Section 45, 1870; Section 1, 1861.]

SECTION 4908. Whenever any witness, after being duly served with such subpoena, neglects or refuses to appear, or after appearing refuses to testify, the judge of the court whose clerk issued the subpoena may, on proof of such neglect or refusal, enforce obedience to the process, or punish the disobedience, as in other like cases. But no witness shall be deemed guilty of contempt for disobeying such subpoena, unless his fees and traveling expenses in going to, returning from, and one day's attendance at the place of examination, are paid or tendered him at the time of the service of the subpoena; nor for refusing to disclose any secret invention or discovery made or owned by himself. [See former Acts: Sections 44 and 45, 1870; Section 1, 1861.]

SECTION 4909. Every applicant for a patent or for the reissue of a patent, any of the claims of which have been twice rejected, and every party to an interference, may appeal from the decision of the primary examiner, or of the examiner in charge of interferences in such case, to the board of examiners-in-chief; having once paid the fee for such appeal. [See former Acts: Section 46, 1870; Section 1, 1866.]

SECTION 4910. If such party is dissatisfied with the decision of the examiners-in-chief, he may, on payment of the fee prescribed, appeal to the Commissioner in person. [See former Acts: Section 47, 1870; Section 2, 1861.]

SECTION 4911. If such party, except a party to an interference, is dissatisfied with the decision of the Commissioner, he may appeal to the Supreme Court of the

District of Columbia, sitting in banc. [See former Acts: Section 48, 1870; Section 1, 1852; Section 11, 1839.]

SECTION 4912. When an appeal is taken to the Supreme Court of the District of Columbia, the appellant shall give notice thereof to the Commissioner, and file in the Patent Office, within such time as the Commissioner shall appoint, his reasons of appeal, specifically set forth in writing. [See former Act: Section 49, 1870.]

SECTION 4913. The court shall, before hearing such appeal, give notice to the Commissioner of the time and place of the hearing, and on receiving such notice the Commissioner shall give notice of such time and place in such manner as the court may prescribe, to all parties who appear to be interested therein. The party appealing shall lay before the court certified copies of all the original papers and evidence in the case, and the Commissioner shall furnish the court with the grounds of his decision, fully set forth in writing, touching all the points involved by the reasons of appeal. And at the request of any party interested, or of the court, the Commissioner and the examiners may be examined under oath, in explanation of the principles of the thing for which a patent is demanded. [See former Acts: Section 51, 1870.]

SECTION 4914. The court, on petition, shall hear and determine such appeal, and revise the decision appealed from in a summary way, on the evidence produced before the Commissioner, at such early and convenient time as the court may appoint; and the revision shall be confined to the points set forth in the reasons of appeal. After hearing the case the court shall return to the Commissioner a certificate of its proceedings and decision, which shall be entered of record in the Patent Office, and shall govern the further proceedings in the case. But

no opinion or decision of the court in any such case shall preclude any person interested from the right to contest the validity of such patent in any court wherein the same may be called in question. [See former Acts: Section 50, 1870.]

SECTION 4915. Whenever a patent on application is refused, either by the Commissioner of Patents or by the Supreme Court of the District of Columbia upon appeal from the Commissioner, the applicant may have remedy by bill in equity; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim, or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the Commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication, and otherwise complying with the requirements of law. In all cases, where there is no opposing party, a copy of the bill shall be served on the Commissioner; and all the expenses of the proceeding shall be paid by the applicant, whether the final decision is in his favor or not. [See former Acts: Section 52, 1870; Section 10, 1839.]

SECTION 4916. Whenever any patent is inoperative or invalid, by reason of a defective or insufficient specification, or by reason of the patentee claiming as his own invention or discovery more than he had a right to claim as new, if the error has arisen by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, the Commissioner shall, on the surrender of such patent and the payment of the duty required by law, cause a new patent for the same invention, and in accordance with the corrected specification, to be issued

to the patentee, or, in the case of his death or of an assignment of the whole or any undivided part of the original patent, then to his executors, administrators, or assigns, for the unexpired part of the term of the original patent. Such surrender shall take effect upon the issue of the amended patent. The Commissioner may, in his discretion, cause several patents to be issued for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for a reissue for each of such reissued letters patent. The specifications and claim in every such case shall be subject to revision and restriction in the same manner as original applications are. Every patent so reissued, together with the corrected specification, shall have the same effect and operation in law, on the trial of all actions for causes thereafter arising, as if the same had been originally filed in such corrected form; but no new matter shall be introduced into the specification, nor in case of a machine patent shall the model or drawings be amended, except each by the other; but when there is neither model nor drawing, amendments may be made upon proof satisfactory to the Commissioner that such new matter or amendment was a part of the original invention, and was omitted from the specification by inadvertence, accident, or mistake, as aforesaid. [See former Acts: Section 53, 1870; Sections 5 and 8, 1837; Section 13. 1836; Section 3, 1832.]

SECTION 4917. Whenever, through inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, a patentee has claimed more than that of which he was the original or first inventor or discoverer, his patent shall be valid for all that part which is truly and justly his own, provided the same is a material or substantial part of the thing patented; and any such patentee, his heirs or assigns, whether of the whole or

any sectional interest therein, may, on payment of the fee required by law, make disclaimer of such parts of the thing patented as he shall not choose to claim or to hold by virtue of the patent or assignment, stating therein the extent of his interest in such patent. Such disclaimer shall be in writing, attested by one or more witnesses, and recorded in the Patent Office; and it shall thereafter be considered as part of the original specification to the extent of the interest possessed by the claimant and by those claiming under him after the record thereof. But no such disclaimer shall affect any action pending at the time of its being filed, except so far as may relate to the question of unreasonable neglect or delay in filing it. [See former Acts: Section 54, 1870; Section 7, 1837.]

SECTION 4918. Whenever there are interfering patents, any person interested in any one of them, or in the working of the invention claimed under either of them, may have relief against the interfering patentee, and all parties interested under him, by suit in equity against the owners of the interfering patent; and the court, on notice to adverse parties, and other due proceedings had according to the course of equity, may adjudge and declare either of the patents void in whole or in part, or inoperative, or invalid in any particular part of the United States, according to the interest of the parties in the patent or the invention patented. But no such judgment or adjudication shall affect the right of any person except the parties to the suit and those deriving title under them subsequent to the rendition of such judgment. [See former Acts: Section 58, 1870; Section 16, 1836.]

SECTION 4919. Damages for the infringement of any patent may be recovered by action on the case, in the

name of the party interested, either as patentee, assignee, or grantee. And whenever in any such action a verdict is rendered for the plaintiff, the court may enter judgment thereon for any sum above the amount found by the verdict as the actual damages sustained, according to the circumstances of the case, not exceeding three times the amount of such verdict, together with the costs. [See former Acts: Section 55, 1870; Section 14, 1836; Section 3, 1800; Section 5, 1793; Section 4, 1790.]

ACT OF JUNE 25, 1910.

36 STATUTES AT LARGE, ch. 423, p. 851.

[PUBLIC—No. 305.]

[H. R. 24649.]

An Act to provide additional protection for owners of patents of the United States, and for other purposes.

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That whenever an invention described in and covered by a patent of the United States shall hereafter be used by the United States without license of the owner thereof or lawful right to use the same, such owner may recover reasonable conpensation for such use by suit in the Court of Claims: *Provided, however*, That said Court of Claims shall not entertain a suit or reward compensation under the provisions of this Act where the claim for compensation is based on the use by the United States of any article heretofore owned, leased, used by, or in the possession of the United States: *Provided further*, That in any such suit the United States may avail itself of any and all defenses, general or special, which might be pleaded by a defendant in an action for in-

fringement, as set forth in Title Sixty of the Revised Statutes, or otherwise: *And provided further*, That the benefits of this Act shall not inure to any patentee, who, when he makes such claim is in the employment or service of the Government of the United States; or the assignee of any such patentee; nor shall this Act apply to any device discovered or invented by such employee during the time of his employment or service.

SECTION 4920. In any action for infringement the defendant may plead the general issue, and having given notice in writing to the plaintiff or his attorney, thirty days before, may prove on trial any one or more of the following special matters:

First. That for the purpose of deceiving the public the description and specification filed by the patentee in the Patent Office was made to contain less than the whole truth relative to his invention or discovery, or more than is necessary to produce the desired effect; or,

Second. That he had surreptitiously or unjustly obtained the patent for that which was in fact invented by another, who was using reasonable diligence in adapting and perfecting the same; or,

Third. That it had been patented or described in some printed publication prior to his supposed invention or discovery thereof; or,

Fourth. That he was not the original and first inventor or discoverer of any material and substantial part of the thing patented; or,

Fifth. That it had been in public use or on sale in this country for more than two years before his application for a patent, or had been abandoned to the public.

And in notices as to proof of previous invention, knowledge, or use of the thing patented, the defendant shall state the names of patentees and the dates of their patents, and when granted, and the names and resi-

dences of the persons alleged to have invented, or to have had the prior knowledge of the thing patented, and where and by whom it had been used; and if any one or more of the special matters alleged shall be found for the defendant, judgment shall be rendered for him with costs. And the like defenses may be pleaded in any suit in equity for relief against an alleged infringement; and proofs of the same may be given upon like notice in the answer of the defendant, and with the like effect. [See former Acts: Section 61, 1870; Section 15, 1836; Section 6, 1793; Section 6, 1790.]

SECTION 4921. The several courts vested with jurisdiction of cases arising under the patent laws shall have power to grant injunctions according to the course and principles of courts of equity, to prevent the violation of any right secured by patent, on such terms as the court may deem reasonable; and upon a decree being rendered in any such case for an infringement, the complainant shall be entitled to recover, in addition to the profits to be accounted for by the defendant, the damages the complainant has sustained thereby; and the court shall assess the same or cause the same to be assessed under its direction. And the court shall have the same power to increase such damages, in its discretion, as is given to increase the damages found by verdicts in actions in the nature of actions of trespass upon the case.

But in any suit or action brought for the infringement of any patent there shall be no recovery of profits or damages for any infringement committed more than six years before the filing of the bill of complaint or the issuing of the writ in such suit or action, and this provision shall apply to existing causes of action.

SECTION 4922. Whenever, through inadvertence, accident, or mistake, and without any willful default or in-

tent to defraud or mislead the public, a patentee has, in his specification, claimed to be the original and first inventor or discoverer of any material or substantial part of the thing patented, of which he was not the original and first inventor or discoverer, every such patentee, his executors, administrators, and assigns, whether of the whole or any sectional interest in the patent, may maintain a suit at law or in equity, for the infringement of any part thereof, which was bona fide his own, if it is a material and substantial part of the thing patented, and definitely distinguishable from the parts claimed without right, notwithstanding the specifications may embrace more than that of which the patentee was the first inventor or discoverer. But in every such case in which a judgment or decree shall be rendered for the plaintiff, no costs shall be recovered unless the proper disclaimer has been entered at the Patent Office before the commencement of the suit. But no patentee shall be entitled to the benefits of this section if he has unreasonably neglected or delayed to enter a disclaimer. [See Sections 973, 4917.]

SECTION 4923. Whenever it appears that a patentee, at the time of making his application for the patent, believed himself to be the original and first inventor or discoverer of the thing patented, the same shall not be held to be void on account of the invention or discovery, or any part thereof, having been known or used in a foreign country, before his invention or discovery thereof, if it had not been patented or described in a printed publication. [See former Acts: Section 62, Act of 1870; Section 15, Act of 1836.]

SECTION 4924. Where the patentee of any invention or discovery, the patent for which was granted prior to the second day of March, eighteen hundred and sixty-one,

shall desire an extension of this patent beyond the original term of its limitation, he shall make application therefor, in writing, to the Commissioner of Patents, setting forth the reasons why such extension should be granted; and he shall also furnish a written statement under oath of the ascertained value of the invention or discovery, and of his receipts and expenditures on account thereof, sufficiently in detail to exhibit a true and faithful account of the loss and profit in any manner accruing to him by reason of the invention or discovery. Such application shall be filed not more than six months nor less than ninety days before the expiration of the original term of the patent; and no extension shall be granted after the expiration of the original term. [See former Acts: Section 63, 1870; Section 1, 1848; Section 18, 1836; Section 2, July 3, 1832.]

SECTION 4925. Upon the receipt of such application, and the payment of the fees required by law, the Commissioner shall cause to be published in one newspaper in the city of Washington, and in such other papers published in the section of the country most interested adversely to the extension of the patent as he may deem proper, for at least sixty days prior to the day set for hearing the case, a notice of such application, and of the time and place when and where the same will be considered, that any person may appear and show cause why the extension should not be granted. [See former Acts: Section 64, 1870; Section 18, 1836.]

SECTION 4926. Upon the publication of the notice of an application for an extension, the Commissioner shall refer the case to the principal examiner having charge of the class of inventions to which it belongs, who shall make the Commissioner a full report of the case, stating particularly whether the invention or discovery was new

and patentable when the original patent was granted. [See former Acts: Section 65, 1870; Section 1, 1848; Section 18, 1836.]

SECTION 4927. The Commissioner shall, at the time and place designated in the published notice, hear and decide upon the evidence produced, both for and against the extension; and if it shall appear to the satisfaction of the Commissioner that the patentee, without neglect or fault on his part, has failed to obtain from the use and sale of his invention or discovery a reasonable remuneration for the time, ingenuity, and expense bestowed upon it, and the introduction of it into use, and that it is just and proper, having due regard to the public interest, that the term of the patent should be extended, the Commissioner shall make a certificate thereon, renewing and extending the patent for the term of seven years from the expiration of the first term. Such certificate shall be recorded in the Patent Office; and thereupon such patent shall have the same effect in law as though it had been originally granted for twenty-one years. [See former Acts: Section 66, 1870; Section 18, 1836.]

SECTION 4928. The benefit of the extension of a patent shall extend to the assignees and grantees of the right to use the thing patented, to the extent of their interest therein. [See former Acts: Section 67, 1870; Section 18, 1836.]

SECTION 4929. Any person who, by his own industry, genius, efforts, and expense, has invented and produced any new and original design for a manufacture, bust, statue, alto-relievo, or bas-relief; any new and original design for the printing of woolen, silk, cotton, or other fabrics; any new and original impression, ornament, patent, print, or picture to be printed, painted, cast, or

otherwise placed on or worked into any article of manufacture; or any new, useful, and original shape or configuration of any article of manufacture, the same not having been known or used by others before his invention or production thereof, or patented or described in any printed publication, may, upon payment of the fee prescribed, and other due proceedings had the same as in cases of inventions or discoveries, obtain a patent therefor. [See former Acts: Section 71, 1870; Section 11, March 2, 1861; Section 3, 1842.]

SECTION 4930. The Commissioner may dispense with models of designs when the design can be sufficiently represented by drawings or photographs. [See former Acts: Section 72, 1870.]

SECTION 4931. Patents for designs may be granted for the term of three years and six months, or for seven years, or for fourteen years, as the applicant may, in his application, elect. [See prior Acts: Section 73, 1870; Section 11, 1861; Section 3, 1842.]

SECTION 4932. Patentees of designs issued prior to the second day of March, eighteen hundred and sixty-one, shall be entitled to extension of their respective patents for the term of seven years, in the same manner and under the same restrictions as are provided for the extension of patents for inventions or discoveries, issued prior to the second day of March, eighteen hundred and sixty-one. [See former Acts: Section 74, 1870; Section 11, March 2, 1861.]

SECTION 4933. All the regulations and provisions which apply to obtaining or protecting patents for inventions or discoveries not inconsistent with the provisions of this Title, shall apply to patents for designs. [See prior Act: Section 76, 1870.]

ACT OF FEBRUARY 4, 1887, ch. 105.

24 STATUTES AT LARGE, 387.

Be it enacted, etc., That hereafter, during the term of letters patent for a design, it shall be unlawful for any person other than the owner of said letters patent, without the license of such owner, to apply the design secured by such letters patent, or any colorable imitation thereof, to any article of manufacture for the purpose of sale, or to sell or expose for sale any article of manufacture to which such design or colorable imitation shall, without the license of the owner, have been applied, knowing that the same has been so applied. Any person violating the provisions, or either of them, of this section, shall be liable in the amount of two hundred and fifty dollars; and in case the total profit made by him from the manufacture or sale, as aforesaid, of the article or articles to which the design, or colorable imitation thereof, has been applied, exceeds the sum of two hundred and fifty dollars, he shall be further liable for the excess of such profit over and above the sum of two hundred and fifty dollars; and the full amount of such liability may be recovered by the owner of the letters patent, to his own use, in any circuit court of the United States having jurisdiction of the parties, either by action at law or upon a bill in equity for an injunction to restrain such infringement.

SECTION 2. That nothing in this act contained shall prevent, lessen, impeach, or avoid any remedy at law or in equity which any owner of letters patent for a design, aggrieved by the infringement of the same, might have had if this act had not been passed; but such owner shall not twice recover the profit made from the infringement.

SECTION 4934. The following shall be the rates for patent fees:

On filing each original application for a patent, except in design cases, fifteen dollars.

On issuing each original patent, except in design cases, twenty dollars.

In design cases: For three years and six months, ten dollars; for seven years, fifteen dollars; for fourteen years, thirty dollars.

On filing each caveat, ten dollars. [Repealed June 25, 1910, 36 Statutes at Large, ch. 414.]

On every application for the reissue of a patent, thirty dollars.

On filing each disclaimer, ten dollars.

* * * * * * * *

On an appeal for the first time from the primary examiners to the examiners-in-chief, ten dollars.

On every appeal from the examiners-in-chief to the Commissioner, twenty dollars.

For certified copies of patents and other papers, including certified printed copies, ten cents per hundred words.

For recording every assignment, power of attorney, or other paper, of three hundred words or under, one dollar; of over three hundred and under one thousand words, two dollars; and for each additional thousand words or fraction thereof, one dollar.

Certified copies of such drawings and specifications may be furnished by the Commissioner of Patents to persons applying therefor upon payment of the present rates for uncertified copies, and twenty-five cents additional for each certification.

For copies of drawings, the reasonable cost of making them.

SECTION 4935. Patent fees may be paid to the Commissioner of Patents, or to the Treasurer or any of the assistant treasurers of the United States, or to any of the designated depositaries, national banks, or receivers of public money, designated by the Secretary of the Treasury for that purpose; and such officer shall give the depositor a receipt or certificate of deposit therefor. All money received at the Patent Office, for any purpose, or from any source whatever, shall be paid into the Treasury as received, without any deduction whatever. [See prior Acts: Section 69, 1870; Section 14, 1837.]

SECTION 4936. The Treasurer of the United States is authorized to pay back any sum or sums of money to any person who has through mistake paid the same into the Treasury, or to any receiver or depositary, to the credit of the Treasury, as for fees accruing at the Patent Office, upon a certificate thereof being made to the Treasurer by the Commissioner of Patents. [See prior Acts: Section 69, 1870; Section 1, 1842.]

SECTION 5046. All property conveyed by the bankrupt in fraud of his creditors; all rights in equity, choses in action, patent rights, and copyrights; all debts due him, or any person for his use, and all liens and securities therefor; and all his rights of action for property or estate, real or personal, and for any cause of action which he had against any person arising from contract or from the unlawful taking or detention, or injury to the property of the bankrupt; and all his rights of redeeming such property or estate; together with the like right, title, power, and authority to sell, manage, dispose of, sue for, and recover or defend the same, as the bankrupt might have had if no assignment had been made, shall, in virtue of the adjudication of bankruptcy and the appointment of his assignee, but subject to the exceptions

stated in the preceding section, be at once vested is [in] such assignee.

SECTION 70. Title to Property. The trustee of the estate of a bankrupt, upon his appointment and qualification, and his successor or successors, if he shall have one or more, upon his or their appointment and qualification, shall in turn be vested by operation of law with the title of the bankrupt, as of the date he was adjudged a bankrupt, except in so far as it is to property which is exempt, to all (1) documents relating to his property; (2) interests in patents, patent rights, copyrights, and trademarks.

ACT OF FEBRUARY 13, 1911.

An Act to diminish the expense of proceedings on appeal and writ of error or of certiorari.

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That in any cause or proceeding wherein the final judgment or decree is sought to be reviewed on appeal to, or by writ of error from, a United States circuit court of appeals, the appellant or plaintiff in error shall cause to be printed under such rules as the lower court shall prescribe, and shall file in the office of the clerk of such circuit court of appeals at least twenty days before the case is called for argument therein, at least twenty-five printed transcripts of the record of the lower court, and of such part or abstract of the proofs as the rules of such circuit court of appeals may require, and in such form as the Supreme Court of the United States shall by rule prescribe, one of which printed transcripts shall be certified under the hand of the clerk of the lower court and under the seal thereof, and shall furnish three

copies of such printed transcript to the adverse party at least twenty days before such argument: *Provided*, That either the court below or the circuit court of appeals may order any original document or other evidence to be sent up in addition to the printed copies of the record or in lieu of printed copies of a part thereof; and no written or typewritten transcript of the record shall be required.

SECTION 2. That in any cause or proceeding wherein the final judgment or decree is sought to be reviewed on appeal to or by writ of error or of certiorari from the Supreme Court of the United States, in which the record has been printed and used upon the hearing in the court below and which substantially conforms to the printed record in said Supreme Court, if there have been at the time of filing the record in the court below twenty-five copies of said printed record, in addition to those provided in the preceding section, lodged with the clerk of the court below, one copy thereof shall be used by the clerk of the court below in the preparation and as a part of the transcript of the record of the court below; and no fee shall be allowed the clerk of the court below in the preparation of the transcript for such part thereof as is included in said printed record so lodged with him. And the clerk of the court below in transmitting the transcript of record to the Supreme Court of the United States for review shall at the same time transmit the remaining uncertified copies of the printed record so lodged with him, which shall be used in the preparation and as a part of the printed record in the Supreme Court of the United States, and the clerk's fee for preparing the record for the printer, indexing the same, supervising the printing and binding and distributing the copies shall be at such rate per folio thereof, exclusive of the printed record so furnished by the clerk of the court

below, as the Supreme Court of the United States may from time to time by rule prescribe; and no written or typewritten transcript of so much of the record as shall have been printed as herein provided shall be required.

Passed the Senate June 23 (calendar day, June 24), 1910.

ATTEST: CHARLES G. BENNETT,
Secretary.