

THE
P A T E N T L A W S

OF

ALL NATIONS:

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COMPILED AND ANNOTATED

BY

BENJAMIN VAUGHAN ABBOTT.

VOL. I.

ALGERIA—TURKEY.

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PREFACE.

THE usefulness of works like this is well understood. They enable a solicitor of patents to inform an inventor in what countries and at what cost he can patent his invention. They assist counsel to advise the owner of a patent what rights and protection it gives him, what will constitute an infringement, and what, in various countries, are his remedies. These being their uses, they must be published often, in order that changes in the various laws may be promptly chronicled, and that statutes newly enacted may be early substituted for any repealed.

This volume presents the Patent Laws of All Nations, so far as I have been able to find them in English dress. Little has been done in revising the translations; those given are such as have been found in trustworthy works, and appear correct. Each law is followed by a reference to the source whence it was derived; and in instances where materially differing translations have been found both are given, or that preferred is copied, adding a reference to the other, to aid comparison. The explanations of points in civil and political geography which abound, though brief, have been prepared with care, on

the basis of a wide search among the cyclopedias and geographic works in use in this country; and will be useful in showing the territorial authority of the various acts.

More of the within laws have been taken from a compilation by Messrs CARPMAEL, published in England about two years ago, than from any other one source; the United States Patent-office Gazette coming next. It was prepared with ability and skill, and at the time of its appearance was satisfactory. But since that time eight or ten new laws have been promulgated which are here collected; and there are as many more of which I have thought best to give versions different from those presented by the English work. For example, I have enlarged the quotations from the acts of the British Parliament; have added one or two Canadian acts (being indebted for them to a digest in pamphlet form by Mr. RICHARDS of New York City); have taken the Patent provisions of the French Code of Commerce from M. GOIRAND'S translation, adding extensive notes of French decisions, founded on his commentary; and under several other countries have made considerable additions. The reader will also notice that my presentation of the laws of the United States is brought down to date, is accompanied by extensive notes (in which the more important of the cases collected in ABBOTT'S NATIONAL DIGEST are rearranged, and those published since that work are added), and is followed by the official forms.

BENJ. VAUGHAN ABBOTT.

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PATENT LAWS OF ALL NATIONS.

VOL. I.

ALGERIA-TURKEY.

ALGERIA.

IN the encyclopedias and geographical works most in use throughout the United States at the present time, "Algeria" is the name of the largest and most important of the colonial possessions of France; "Algiers" being its capital city. In general, the patent law of France extends over her colonies (see FRANCE); but according to M. Leopold Goirand, there is a decree on the subject of patents, dated June 5, 1850, "specially relating to Algiers." *Goirand's French Code of Commerce* (1880), 454, art. 15.

ANTIGUA.

See LEEWARD ISLANDS.

ANTILLES.

See SPAIN.

ARGENTINE REPUBLIC.*Law of October 11, 1864.***TITLE I.****GENERAL PROVISIONS.**

ARTICLE 1. All new discoveries or inventions in any branch of industry confer on their originators the exclusive right of working the same during a fixed term and under certain conditions, conformably to article 17 of the constitution, upon the said right being established by a document called a *Patent of Invention*, to be delivered in the form prescribed by the present law.

ART. 2. The preceding paragraph applies not only to inventions and discoveries made in this country but also to those patented in foreign countries, provided the applicant be the inventor or his assignee, and provided also the conditions and formalities mentioned hereafter be duly observed.

ART. 3. The following shall be considered as new discoveries or inventions, viz., all new products of industry ; new means, and the new application of known means, for obtaining an industrial result or product.

ART. 4. The following are not patentable ; viz., pharmaceutical compositions ; financial schemes ; such discoveries or inventions as have, previous to the application, received a sufficient publicity in works, pamphlets, or periodicals, in this country or abroad, for being worked ; those of a mere theoretical nature, without any indication of their practical use in industry ; and finally, inventions contrary to morals or to the laws of the republic.

ART. 5. Patents shall be granted for the term of five, ten, or fifteen years, according to the merit of the invention and the wish of the applicant ; the re-issue (confirmation) of foreign patents shall be limited to ten years, and in no case shall the term exceed that of the original patent, at the expiration of which they shall lapse.

ART. 6. A new patent has to be paid for at the rate of 80, 200, or 350 piasters (*pesos fuertes*), according to its being taken for the term of five, ten, or fifteen years. The re-issue of foreign patents is subject to the payment of a sum proportional to the term for which it is granted according to the same scale of fees.

ART. 7. The payment of the fees shall be made, one half at the

time of application, and the other half by successive yearly payments.

ART. 8. The executive government shall regulate by a special decree the mode in which the patent-office has to pay over the said fees to the public treasury.

TITLE II.

PATENT-OFFICE.

ART. 9. The before mentioned patents are to be delivered by a special office established for that purpose.

ART. 10. The official staff of the patent-office is to be composed of a commissioner, at a salary of 1,200 piasters per annum ; of four sub-commissioners, at a salary of 800 piasters per annum ; of a secretary, at a salary of 600 piasters per annum ; and a porter, at a salary of 240 piasters. The five former are to be appointed by the president of the republic direct, and the two latter on the recommendation of the commissioner.

ART. 11. No officer of the patent-office is allowed to hold an interest, directly or indirectly, in patents which come under his control, under pain of dismissal, and a fine of from 100 to 1,000 piasters, if convicted.

ART. 12. The commissioner is chief of the office, and responsible to the government for all the documents and objects deposited, which must be carefully kept and registered.

ART. 13. The sub-commissioners must possess a special knowledge of the applied sciences relating to industry, to enable them to examine, under the direction of the commissioner, all inventions or discoveries sought to be patented, the grant of the patent depending on said examination.

ART. 14. The patent-office shall form a department of the ministry of the interior.

TITLE III.

PROCEEDINGS FOR GRANTING LETTERS PATENT.

FIRST SECTION. APPLICATIONS.

ART. 15. All applications for letters patent must be made by petition addressed to the commissioner of patents. This petition, with a 25 cent stamp affixed, has to be delivered at the patent-office in the capital, or at one of the chief post-offices in the provinces, and must be accompanied by a description, with proper drawings and patterns (all in duplicate), and a list of the objects presented.

ART. 16. In cases where the application is made through the post-office, applicants may deliver the descriptions, patterns, and drawings in a sealed packet, and require the same to be safely forwarded, at their own cost, to the patent-office.

ART. 17. The commissioner of patents shall provide the postmasters mentioned in article 15 with a ledger, duly paged and headed, in which the petitions shall be entered in order of their presentation, with the date and time. A similar book shall be kept as a register at the patent-office. This register is to state in a few words the subject of the application, and has to be signed by the commissioner, the secretary, and the applicant, or his attorney. At the request of the applicant, a certificate of deposit may be delivered to him at the mere cost of a fourth-class paper stamp.

ART. 18. No petition shall be delivered without at the same time depositing one-half of the fees mentioned before, such payment being authenticated by the certificate mentioned in the previous paragraph. The officer neglecting to see this payment made at the time of the application shall be made liable to a fine of double the amount. The same fine shall be imposed upon postmasters who neglect to forward applications to the commissioner of patents by the earliest mail, which is to be proved by the certificate of deposit and a certificate of the postmaster-general, unless such delay is caused by want of time, accidents, or circumstances beyond control.

ART. 19. Applications are to refer to a single chief object, with its accessories and applications; they must mention the term for which the patent is sought, without containing any restrictions, conditions, or reservations whatever; they must indicate a short and precise title of the invention; they must be written in the Spanish language; the omissions or additions must be duly mentioned, and the drawings accompanying the same are to be made in ink, and according to a metrical scale.

SECOND SECTION. ISSUE.

ART. 20. As soon as the application is in the hands of the commissioner, and when it appears that the object applied for is within the limits of article 2, and does not come under the limitation of article 4, the patent is granted, provided the term applied for does not exceed ten years; if it exceeds that time, the application is referred to the minister of the interior for ulterior decision, from which decision there lies no appeal.

ART. 21. All patents shall be issued in the name of the nation, by

authority of the government, and shall bear the signature of the commissioner and secretary, with the official seal, and shall consist of the decree granting the same, accompanied by the duplicate of the description and drawings.

ART. 22. Immediately after the issue of the patent it shall be delivered to the applicant or his attorney. However, if the application has been made through the post-office, the patent shall be forwarded by the same channel, the respective postmasters having to acknowledge the receipt as soon as possible. All subsequent certificates applied for shall be delivered at the rate of 5 piasters each.

ART. 23. The grant of a patent does not obviate the exceptions mentioned in article 46.

ART. 24. Applicants not complying with the provisions of article 15, shall have their patent refused, in which case one half of the sum deposited is returned to them, the other half being forfeited.

ART. 25. On the refusal of a patent an appeal may be made within ten days to the minister of the interior, who, after proper investigation, shall confirm or annul the refusal; in the former case the whole sum deposited is to be forfeited.

ART. 26. A quarterly list of all patents delivered and refused, with their respective dates, has to be forwarded by the commissioner to the government for publication.

THIRD SECTION. CERTIFICATES OF ADDITION OR IMPROVEMENT.

ART. 27. Improvements in patented discoveries or inventions entitle the originators to apply for a certificate of addition, which cannot be granted for a longer period than the original patent has yet to run, provided it does not exceed ten years, except when half that time has expired, or when the improvement lessens by half at least the cost of production, time, risk, or danger, or for other similar reasons, in which case the commissioner has to fix the proper term for which such a patent may be granted.

ART. 28. Certificates of addition are subject to the same formalities as patents, with the exception of the fees, the original patentee having only to pay one-fourth, and others than the patentee one-half of the said fees.

ART. 29. When such certificates of addition have been obtained by others than the original patentee, they do not confer on their owners the exclusive right of working their invention, except under the condition of paying a premium to the original inventor, the

amount thereof having to be fixed by the commissioner by taking into account the importance of the improvement and of the part used of the original invention.

ART. 30. The original inventor has the option between availing himself of the provision contained in the preceding paragraph and of working the improvement jointly with the improver; if he chooses the latter, a patent of addition shall be delivered to him on the same terms as that to the improver.

ART. 31. In no case shall improvers acquire the right of solely working the original invention, and the original inventor may only work the improvement under the second provision of the previous paragraph.

ART. 32. If two or more parties should apply at the same time for a certificate of addition for the same improvement, and if they should not come to some arrangement between themselves, no patent shall be issued to either. The same provision applies also to letters patent.

FOURTH SECTION. PROVISIONAL PATENTS.

ART. 33. Inventors or improvers may obtain a provisional patent, for the term of one year, and renewable at the expiration of each year.

ART. 34. Such a patent shall be obtained, on the payment of 50 piasters, by petition drawn up according to the provisions contained in Art. 15, pointing out the object of the invention and the means of carrying it out.

ART. 35. On the receipt of this petition the commissioner shall deliver the provisional patent, entering the same in a special book, to be kept in his custody in the secret archives, together with all the documents relating thereto.

ART. 36. No provisional patent shall be granted for inventions prohibited by article 4.

ART. 37. The effect of provisional patents is to defer, whilst they are in force, all grants of patents relating to the same invention or improvement until previous notice thereof is given to the original patentee at his own domicile.

ART. 38. The owner of a provisional patent may oppose an intended patent for an invention similar to his own, within three months. At the expiration of that term, or if he has not given due notice of his change of domicile, he shall forfeit his right.

ART. 39. In case of an opposition by the owner of a provisional

patent, the commissioners shall give a separate hearing to both applicants ; and if the inventions should be identical, neither shall obtain a patent, unless both parties come to an arrangement. Should such inventions be different, the patent applied for shall be granted.

ART. 40. The fees paid for a provisional patent shall be deducted from the sum to be paid for letters patent, or for a certificate of addition obtained previous to the expiration of the former.

TITLE IV.

FIRST SECTION. ASSIGNMENT OF PATENTS.

ART. 41. Owners of patents or certificates may assign their rights on their own terms ; such assignments, however, must be made by a notarial act, and after the payment of the entire fees mentioned in article 6. In order to give such assignments legal force with respect to third parties, they must be registered either at the patent-office in the capital, or at the before-mentioned post-offices in the provinces ; and, to have this registration performed, it is necessary to produce the notarial act of assignment. Within five days of this registration, or by the earliest mail if in the provinces, a certificate of the register and the assignment shall be forwarded to the patent-office. The mutations that have taken place shall be entered in a special book, the entries to be published quarterly.

ART. 42. Assignments transfer all the rights of the original patentee, except in cases of special reservations by the latter.

SECOND SECTION. COMMUNICATION AND PUBLICATION OF PATENTS.

ART. 43. On the issue of a patent or certificate the commissioner shall publish it in the newspapers by inserting the name of the patentee, the duration of the patent, and a summary of the invention or discovery.

ART. 44. All descriptions, drawings, patterns, and models of the patents granted, not coming under the provision of article 33, shall be kept at the patent-office for public information. They shall be open to inspection without charge by any person applying for the same ; and copies of the written documents shall be delivered without any other charge than the paper stamp duty of the fourth class.

ART. 45. At the beginning of each year the commissioner of patents shall publish in a volume the list of patents granted during

the preceding year, together with the descriptions and drawings required for the comprehension of the patented inventions or discoveries. A copy of the said publication is to be deposited at the patent-office and at the post-offices mentioned in article 15, for free public inspection.

TITLE V.

NULLITY AND INVALIDITY OF PATENTS.

ART. 46. All patents or certificates obtained contrary to article 4 are null and void, as likewise all those that have been obtained under a fraudulent title, not corresponding to the invention ; whenever the drawings or descriptions are incorrect or incomplete ; whenever, in the case of certificates, they refer to a patent not actually obtained ; or, whenever, in case of a foreign invention, the foreign patent confirmed by the republic has expired ; or, whenever, at the date of the patent the discovery or invention was already in operation in the republic.

ART. 47. All patents duly issued become void whenever the invention has not been worked within two years of the issue of the patent ; whenever the working has been interrupted for a similar period, except by circumstances beyond control, or accident, duly certified by the office ; or, finally, at the expiration of the term for which the patent has been granted.

ART. 48. Actions for the nullity or avoiding a patent can only be instituted by interested parties before the sectional tribunals.

ART. 49. No special judicial decree of nullity or lapse is required for causing the patent discovery or invention to become public property ; the mere fact of nullity or lapse suffices for authorizing every one to work freely the patent articles.

ART. 50. In case the owner of a void or invalid patent should dispute the free working of the invention or discovery to which it relates, either by complaint or otherwise, the official declaration of the invalidity or nullity of the patent may be obtained from the same sectional tribunals.

ART. 51. All decisions are summary ; all proper proofs of title shall be admitted ; but patentees cannot produce any evidence contrary to what is established by the documents of the patent-office, in proof of their privileges. The term for showing cause is to be fixed prudentially by the judge ; however, it can never exceed six months, and that term is only granted in exceptional cases referring to matters lying beyond the sea, and on giving sufficient security in

favor of the claimant. Within ten days of the expiration of the term allowed for evidence, the judge shall deliver judgment and award costs. From this judgment there lies an appeal to the Supreme Court, which must be entered within three days. This court, after previously consulting the patent-office, shall deliver a final judgment.

ART. 52. The nullity or invalidity of a patent being established by judgment, and the judgment having become final, the tribunal shall inform the commissioner of patents thereof, that he may publish it in the prescribed form.

TITLE VI.

INFRINGEMENTS, LEGAL PROCEEDINGS, AND PENALTIES.

ART. 53. Infringements of patent-rights shall be considered as forgeries, and punished by a fine of from 50 to 500 piasters, or by imprisonment of from one to six months, and the forfeiture of the infringing articles, all without prejudice to any indemnity for losses and damages.

ART. 54. The same penalty shall be applied to those who knowingly participate in the infringement by selling, exhibiting, importing, or communicating the infringing articles.

ART. 55. In case of a second offense within five years the before mentioned penalty shall be doubled.

ART. 56. The fact of having been in the employ of the patentee, or having acquired surreptitious information of the invention, shall be considered as an aggravating circumstance.

ART. 57. All actions for the recovery of the above mentioned penalty are private, and are to be pleaded before the same sectional tribunals on the production of the patent, without which the complaint cannot be entered into; the defendant can only plead by way of answer the annulment or invalidity of the patent, his co-interest in the same, or his exclusive right of property.

ART. 58. The claimant has a right to demand security from the defendant for any loss which may be occasioned by his continuing to work the invention pending the trial, and, in default thereof, he may claim the suspension of the working and the seizure of the objects in dispute upon giving in his turn, to the defendant, if required, sufficient security. The seizure is to be effected with the usual legal forms.

ART. 59. All those who call themselves patentees without really

having patents shall be considered as forgers, and are liable to the penalties inflicted on forgers, with the exception of the loss of the infringing articles.

ART. 60. All fines imposed by this law shall be divided equally between the treasury and the informers.

TITLE VII.

RE-ISSUE OF PROVINCIAL PATENTS.

ART. 61. Owners of the provincial patents which are in force at the promulgation of the present law may obtain a re-issue within the six months following, by accompanying the patent with a petition according to the form prescribed by article 15.

ART. 62. Provincial patents not re-issued within said term shall have no effect whatever before the tribunals of the republic.

ART. 63. The re-issue may take place in two ways ; either for the same province in which the patent right was exercised, or for the whole republic. In the former case the patent shall be granted free of expense and without any previous examination ; in the latter case the proceedings shall be the same as for a new patent, and the portion of the fees corresponding to the term allowed must be paid in the usual way.

ART. 64. Re-issues of patents granted for the same province shall only be valid for the remainder of the term of the patent, and the patent rights conferred shall relate to the said province only. When granted for the whole republic, such re-issues may extend to ten years, the time they have already run being deducted.

ART. 65. There shall be kept a special register of these re-issues.

ART. 66. From the promulgation of the present law, all contrary provisions shall be abrogated.

ART. 67. The executive government shall be informed thereof.

From Carpmael's Patent Laws of the World, 1.

See APPENDIX OF RECENT LAWS, near end of vol. II.

AUSTRALASIA.

*An Act to constitute a Federal Council of Australasia.**
August 14, 1885, 48 & 49 Vict. c. 60.

Whereas it is expedient to constitute a Federal Council of Australasia, for the purpose of dealing with such matters of common Australasian interest, in respect to which united action is desirable, as can be dealt with without unduly interfering with the management of the internal affairs of the several colonies by their respective legislatures :

Be it enacted, &c. :

1. *Definitions.* In this Act, unless the context otherwise require, the following terms shall bear the meanings set opposite to them respectively :

“Colonies.” The colonies (including their respective dependencies) of Fiji, New Zealand, New South Wales, Queensland, Tasmania, Victoria and Western Australia, and the province of South Australia, and any other colonies that may hereafter be created in Australasia, or those of the said colonies in respect to which this Act is in operation :

“Crown Colony.” Any colony in which the control of public officers is retained by Her Majesty’s imperial government :

“Her Majesty’s possessions in Australasia.” The colonies and such other territories as Her Majesty may from time to time declare by order in council to be within the operation of this Act :

“Council.” The Federal Council as hereby constituted :

* The names Australia and Australasia are used in somewhat different senses in modern times ; but, with reference to the operation of the Act given in the text, Australia is the immense island of that name lying between the Indian and the South Pacific oceans, considered alone, that is, without including the smaller, though settled and important islands of Tasmania, immediately south of Australia (of Victoria), New Zealand, lying south-east, and the Feejee (or Fiji) islands, to the east. New South Wales,

Queensland, Victoria, Western Australia, and South Australia, are divisions of the island Australia, but do not form the whole of it ; the island contains, also, two large regions or divisions, known on the maps as North Australia and Alexandra Land, respectively. Thus the Act given in the text brings under the limited legislative power of a “Federal council of Australasia,” the greater part, but as yet not the whole of Australia, and the most important, but not all of the other islands within Australasia.

“Governor.” The Governor, lieutenant governor, or other officer administering the government of the colony referred to, with the advice of his executive council, except in the case of a Crown Colony, in which case the word shall mean the Governor, lieutenant governor, or such other officer alone.

2. *Institution of Federal Council.* There shall be in and for Her Majesty’s possessions in Australasia a Federal Council, constituted as hereinafter provided, and called the Federal Council of Australasia, which shall have the functions, powers, and authority hereinafter defined.

3. *Power to make laws.* Within such possessions Her Majesty shall have power, by and with the advice and consent of the council, to make laws for the purposes hereinafter specified, subject to the provisions herein contained respecting the operation of this Act.

15. *Matters subject to legislative authority of Council.* Saving Her Majesty’s prerogative, and subject to the provisions herein contained with respect to the operation of this Act, the council shall have legislative authority in respect to the several matters following.

(i.) Such of the following matters as may be referred to the Council by the legislatures of any two or more colonies, that is to say, . . . patents of invention and discovery, copyright, . . . and any other matter of general Australasian interest with respect to which the legislatures of the several colonies can legislate within their own limits, and as to which it is deemed desirable that there should be a law of general application ; provided that in such cases the Acts of the Council shall extend only to the colonies by whose legislatures the matter shall have been so referred to it, and such colonies as may afterwards adopt the same.

17. *Royal assent to bills passed by Council.* Every bill passed by the Council shall be presented, for Her Majesty’s assent, to the Governor of the colony in which the Council shall be sitting, who shall declare, according to his discretion, but subject to the provisions of this Act and to Her Majesty’s instructions, either that he assents thereto in Her Majesty’s name, or that he withholds such assent, or that he reserves the bill for the signification of Her Majesty’s pleasure, or that he will be prepared to assent thereto, subject to certain amendments to be specified by him.

18. *Power to Her Majesty to disallow Acts.* When the Governor

assents to a bill in Her Majesty's name, he shall, by the first convenient opportunity, send an authentic copy of the Act to one of Her Majesty's principal secretaries of state, and if Her Majesty, within one year after receipt thereof by the secretary of state, thinks fit to disallow the Act, such disallowance (with a certificate of the secretary of state of the day on which the Act was received by him) being signified by such Governor by message to the Council, or by proclamation in the Government Gazette of all the colonies affected thereby, shall annul the Act from and after the day of such signification.

19. *Bill reserved for signification of Her Majesty's pleasure.* A bill reserved for the signification of Her Majesty's pleasure shall not have any force unless and until within one year from the day on which it was presented to the Governor for Her Majesty's assent, such Governor signifies, by message to the Council, or by proclamation published as last aforesaid, that it has received the assent of Her Majesty.

20. *Acts of Council, when assented to, laws.* All Acts of the Council, on being assented to in manner hereinbefore provided, shall have the force of law in all Her Majesty's possessions in Australasia in respect to which this Act is in operation, or in the several colonies to which they shall extend, as the case may be, and on board all British ships, other than Her Majesty's ships of war, whose last port of clearance or port of destination is in any such possession or colony.

21. *Publication of Acts.* Every Act assented to in the first instance shall be proclaimed in the Government Gazette of the colony in which the session of the Council at which it was passed was held, and shall also be transmitted by the Governor assenting thereto to the Governors of the several colonies affected thereby, and shall be proclaimed by them within the respective colonies of which they are Governors.

22. *Acts of Council to supersede colonial enactments.* If in any case the provisions of any Act of the Council shall be repugnant to, or inconsistent with, the law of any colony affected thereby, the former shall prevail, and the latter shall, so far as such repugnance or inconsistency extends, have no operation.

28. *Evidence of proceedings.* Whenever it shall be necessary to prove the proceedings of the Council in any court of justice, or otherwise, a certified copy of such proceedings, under the hand of

the clerk or other officer appointed in that behalf by the Council, shall be conclusive evidence of the proceedings appearing by such copy to have been had or taken.

30. *Commencement of Act in respect of any colony.* This Act shall not come into operation in respect of any colony until the legislature of such colony shall have passed an Act or ordinance, declaring that the same shall be in force therein, and appointing a day on and from which such operation shall take effect, nor until four colonies at the least shall have passed such Act or ordinance.

31. *Power to determine operation of Act in any colony.* This Act shall cease to be in operation in respect to any colony the legislature of which shall have passed an Act or ordinance declaring that the same shall cease to be in force therein: provided, nevertheless, that all Acts of the council passed while this Act was in operation in such colony, shall continue to be in force therein, unless altered or repealed by the Council.

32. *Short title.* This Act shall be styled and may be cited as the Federal Council of Australasia Act, 1885.

From 125 *Publ. Gen. Stat.* 324.

See also: NEW SOUTH WALES; NEW ZEALAND; QUEENSLAND; SOUTH AUSTRALIA; TASMANIA; VICTORIA; WESTERN AUSTRALIA.

AUSTRALIA.

See NEW SOUTH WALES; QUEENSLAND; SOUTH AUSTRALIA; VICTORIA; WESTERN AUSTRALIA.

AUSTRIA-HUNGARY.

Law of August 15, 1852.

WE, FRANCIS JOSEPH the First, by the grace of God Emperor of Austria, King of Hungary and Bohemia, King of Lombardy and Venice, of Dalmatia, &c., &c.,

Being desirous of granting proper protection to the inventive genius even in those provinces of our empire which hitherto have been deprived of patent laws, and considering that the experience earned since the promulgation of the law of March 31, 1832, has shown that many reforms and enlargements are necessary, at the advice of our ministers and of our Imperial Council we have decreed the following rules for the whole extent of our empire:—

SECTION I.

OF THE SUBJECT OF AN EXCLUSIVE PRIVILEGE.

§ 1. Exclusive privileges may be granted under the restrictions stated in §§ 2, 3, 4 and 5, for every new discovery, invention, or improvement having for its object—

- a. A new product of industry; or,
- b. A new means of production; or,
- c. A new method of production;

whether such privileges be demanded by an Austrian subject or by a foreigner, unless the invention be not patentable according to §§ 2-5.

The term *discovery* is applied to the finding out an industrial process that may have been used in former times, but which has since been lost sight of or remained unknown in the empire.

The term *invention* is applied to the producing a new object by new means, or a new object by means known before, or a known object by means different from those used hitherto for the same object.

The term *improvement* or *alteration* is applied to every apparatus, arrangement, or process added to an object known or patented before, by means of which, in the object in view or in the means of arriving at it, a better result or greater economy is attained.

The term *new* is applied to any discovery, invention, or improvement that, up to the time of the application for a privilege,

has neither been worked nor become known through publications in the empire.

§ 2. No privileges can be granted for preparations of food, beverages, and medicines, nor for discoveries, inventions, or improvements which cannot be worked for reasons of public health, morals, or safety, or as being contrary to the general interest of the state, according to the existing regulations.

§ 3. A new discovery, invention, or improvement which is to be imported into the Austrian empire from abroad can only be patented during the currency of the foreign patent; nor can such a grant be made except to the foreign patentee or his assign. Under these restrictions a privilege can be granted for a discovery, invention, or improvement made abroad, provided it has not yet been published in the empire.

§ 4. Improvements of inventions that were known or patented before can only be patented with the restrictive clause that such a privilege does not refer to the whole article, but only to the improved part.

§ 5. Scientific principles, or purely scientific theorems, cannot be patented, even if the principle or theorem admit of a direct application to industrial objects. However, patents may be granted for every new application of such principles or theorems as lead to the creation of a new industrial product, a new means, or a new method of production.

§ 6. Two or several discoveries, inventions, or improvements that are different from each other may only be united into one patent if those discoveries, inventions, or improvements relate to one and the same object, as component parts or operative means.

SECTION II.

OF THE CONDITIONS FOR OBTAINING AN EXCLUSIVE PRIVILEGE, AND THE FORMALITIES TO BE FULFILLED.

§ 7. Applicants for an exclusive privilege for a new discovery, invention, or improvement must fulfill the conditions prescribed in the present law.

Those conditions are:—

a. Applying to the competent authorities by means of a petition in due form, accompanied by the prescribed documents.

b. Payment of a fixed tax.

c. Fulfilling the obligation of describing the new discovery,

invention, or improvement clearly and completely; and, if required for the sake of clearness, of illustrating it by drawings or models, so as to enable every competent man to execute the same after its publication at the expiration of the patent.

§ 8. Petitions for exclusive privileges may be lodged with the stadtholder, or with the judges of districts (judges, delegates, county magistrates), to be forwarded by them.

§ 9. Those petitions must be arranged according to the Form A. They may be delivered by the applicant himself or his attorney. Such petitions must contain—

a. The christian and family name, profession, and residence of the applicant; and, in case of his not being settled in the empire, also the name, profession, and residence of an attorney domiciled in the empire. Applicants must state their christian and family name, profession, &c., even if the privilege is to be worked under a firm bearing a different name from that of the patentee. In such cases the name of the firm chosen must be stated. The said firm, however, must not correspond with an existing firm unless the consent of its proprietor be obtained.

b. The name (title) of the discovery, invention, or improvement; giving the essence of it.

c. The number of years for which the patent is demanded. That number of years cannot exceed fifteen, except by a special grant of the Emperor; and those inventions patented already abroad, and which are to be imported by their proprietors or their assigns, can only be patented for the unexpired term of the foreign patent.

d. The statement whether the discovery, invention, or improvement is to be kept secret or not.

§ 10. Petitions for patents must be accompanied by—

a. The due tax, or the receipt for the same, given by a public treasurer to whom the said tax had been paid. Except that tax, no other fees are to be demanded for a patent, even in the case of a previous examination on public grounds.

b. The power of attorney in case the applicant delivers his petition through an agent (§ 9).

c. In cases of discoveries, inventions, or improvements to be imported from abroad, the foreign letters patent in the original, or in an authenticated copy.

d. The above-mentioned (§ 7 *c*) description of the invention under sealed cover, on which is written the essence of the discovery.

invention, or improvement, corresponding with the statement made in the petition, and the address of the applicant or his attorney.

§ 11. The patent tax is in proportion to the duration of the privilege, and is the same for discoveries, inventions, improvements; for foreigners, or natives. It amounts to 100 florins for the first five years, 200 florins for the following five years, and 400 florins for the last five years; the annual ratio being 20 florins for the first five years, and that of the subsequent years as follows:— 6th year, 30 fl.; 7th year, 35 fl.; 8th year, 40 fl.; 9th year, 45 fl.; 10th year, 50 fl.; 11th year, 60 fl.; 12th year, 70 fl.; 13th year, 80 fl.; 14th year, 90 fl.; 15th year, 100 fl., amounting to 700 fl. for fifteen years, the longest period allowed.

The tax due for the whole number of years which the privilege has been applied for must be paid down at once, or a receipt for the amount has to be produced, to avoid the petition being rejected.

The said tax can only be repaid in case of the privilege being annulled on public grounds, and such repayments shall be in proportion to the unexpired term.

§ 12. The specification (§ 10), which is considered as an essential condition for obtaining an exclusive privilege, must answer the following requirements:—

a. It must be written in German, or in the usual language of the province where the application is made, and be signed by the applicant, or the attorney named in the petition.

b. It must contain the detailed description of the discovery, invention, or improvement, the essence of which was indicated in the petition.

c. It must be drawn out in such a manner as to enable all competent men to manufacture the article according to this description, without the addition of new inventions, additions or improvements.

d. What is new and also what constitutes the object of the privilege must be clearly described and pointed out in the specification.

e. The discovery, invention, or improvement must be set forth in a clear and plain manner, and contain no ambiguities that might lead astray, contrary to the provisions contained in *c.*

f. It must not keep secret anything relating either to the means or mode of working; therefore it is neither permissible to indicate means that are more expensive or do not produce the same effect, nor to conceal devices that relate to the success of the operation.

g. Should drawings, patterns, or models be required for better

understanding the specification, the former must be annexed in lasting colors ; besides which (in as far as it may add to clearness according to *c*), any other print or writing may be added which the applicant shall think fit.

§ 13. The authority to whom a petition is presented is to examine in the presence of the applicant,—

- a.* Whether the petition is in due form, and has been signed;
- b.* Whether the required documents are annexed ;
- c.* Whether the prescribed tax, or a receipt for the same is inclosed.

If the authority finds the petition in good order in this respect, he inscribes, in the presence of the applicant, on the cover of the specification, the day and hour of its presentation, and the amount paid, and hands to the applicant or his attorney a certificate containing the name and residence of the applicant or his attorney, the day and hour of presentation, the payment of the tax, and the title and essence of the discovery, invention, or improvement as set forth in the petition.

From that day and hour, the priority of the discovery, invention, or improvement disclosed, is reckoned, that is, every opposition on the ground of a similar discovery, invention, or improvement made or practiced after that time is considered ineffectual, and cannot refute and annul the novelty of the discovery, invention, or improvement which has been disclosed and described in due order by the applicant.

If an omission or other defect is found out on examination of the petition, the latter is returned to the applicant that he may amend the same.

§ 14. All petitions approved of, together with their annexed documents, are transmitted to the governors of the respective province within three days at the latest, if not addressed to them directly.

§ 15. The governors examine such petitions—

a. As to whether the object of the petition is not evidently unfit for a privilege.

b. As to whether the annexed documents fulfill the prescribed conditions, and particularly as to whether the description of the object of the patent inscribed on the cover of the specification corresponds with the indication made in the petition, and whether the latter is duly signed.

Should a governor think the article to be patented absolutely unfit for a privilege according to § 2-6, he is to inform the petitioner

thereof, requiring him to withdraw and give a receipt for the sealed specification, as well as to receive back the tax paid up, or otherwise to appeal to the ministry of commerce and trades within the term assigned in the regulation of trades.

Should it appear that the annexed documents do not answer the requirements, or that the object of the privilege, as indicated on the cover of the sealed description, does not correspond with the contents of the petition, the governor is to keep back the petition, and to assign a proper term for the amendment of the defect. Should that term not be observed, the petition is to be returned.

All petitions in due form, and not unfit for privilege, as well as those that have been amended within the prescribed term, shall be submitted by the governors, together with the sealed specifications, and all other documents, to the minister of commerce and trades.

§ 16. The minister of commerce and trades is to re-examine whether all the formalities have been fulfilled, and he has the exclusive authority to open the sealed specification and see—

a. Whether the specification is written in a current language (§ 12), and whether it is duly signed.

b. Whether the object for which a patent is desired does not comprehend two or more different objects (§ 6) and requires to be divided.

c. Whether the title of the invention is the same in the petition as on the cover of the annexed specification, and as in the specification itself; moreover, whether the specification possesses that degree of clearness and distinctness required by § 12, particularly whether the required drawings, patterns, and models are present, and whether all formal requirements about the same have been observed.

d. Whether the object to be patented as indicated in its essential features in the petition and on the cover of the specification is not contrary to sanitary laws, or to other public regulations, whereby it becomes entirely unfit for a privilege, or fit only under certain conditions and restrictions. Besides, special care is to be taken for the required secrecy being observed, and due precautions against any possible violation of the secret are to be adopted.

§ 17. No examination ever takes place as to the novelty or utility of the discovery, invention, or improvement before the granting of the privilege; on the other hand, no guarantee is given by the government, which grants the patent in this respect at the mere risk, peril and cost of the patentee.

§ 18. In all those cases, where the checking and examination

according to § 16 disclose no obstacle, the privilege is granted by the minister of commerce and trades by a separate document, otherwise all petitions deemed unfit for acceptance are rejected, the motive for so doing being mentioned, and the tax being ordered to be repaid. However, where there exist defects that may be amended, such rejections take place only after the applicant has failed to amend such defects within the proper term assigned to him for that purpose.

§ 19. The grant of a privilege releases a patentee in no case from the laws, regulations, and prescriptions that exist, or may be promulgated in the interest of public health, safety, morals, or in the interest of the State; the working of the patent is therefore subordinate to such regulations and prescriptions as may limit or defend it without the patentee being allowed to invoke an exceptional rule.

§ 20. The inclosed specifications belonging to the privileges, together with the annexed documents (§ 16), are delivered to the custody and the ulterior use of the central record office for patents, as will be explained in section V. of the present law.

SECTION III.

OF THE ADVANTAGES AND LIBERTIES INCIDENT TO EXCLUSIVE PRIVILEGES.

§ 21. An exclusive privilege secures to the patentee the exclusive use of his discovery, invention, or improvement, as laid down in his specification, for the number of years mentioned in his privilege.

§ 22. The patentee is authorized to establish those workshops and to engage those workmen which are required for the complete working of the subject of the patent to any extent; they may thus form everywhere in the whole empire establishments and depots for the manufacture and sale of the subject of their privilege, and authorize others to work their discovery, invention, or improvement, under the protection of their privilege; they may form partnerships, and work their patent to any extent, dispose of their patent, bequeath it, sell it, give licenses, or otherwise part with it, and obtain patents abroad for the same object.

However, those rights are strictly limited to the proper object of the patented discovery, invention, or improvement, and therefore must not be extended to similar objects, nor be used contrary to existing laws or other privileges.

§ 23. If the privilege relates to an improvement or an alteration

of a patented object it is merely limited to the individual improvement or alteration itself, and it gives to the privileged improver and alterer no right to the rest of the object that has already been patented, or of a process that is already known. On the other hand, the patentee of an object improved or altered by another patentee is not allowed to use the said improvement or alteration without his consent.

SECTION IV.

OF THE EXTENT AND DURATION OF EXCLUSIVE PRIVILEGES, AND THEIR PUBLICATION.

§ 24. The legal effect of exclusive privileges shall be co-extensive with the Austrian territory.

§ 25. The longest duration of privileges is fixed at fifteen years. We reserve to ourselves the right of extending that term, yet such a prolongation shall be demanded by the public authorities only for highly meritorious cases.

§ 26. Every exclusive privilege begins from the day of the delivery of the patent. The publication of the grant of the privilege shall be made in the same manner and within the same time as is provided for laws.

§ 27. Every patentee whose privilege has been granted for a shorter period than the longest (§ 9 c) may claim its prolongation for one or more years within the fixed longest period, provided they demand such a prolongation before the privilege has become extinct (§ 29—2 a, b). To obtain such a prolongation a petition for the same must be delivered in due time, together with the original patent, and the tax in full for the required term of prolongation (§ 11), or the receipt for the same from a public treasurer.

The prolongation is granted by the minister of commerce and trades, and is officially confirmed on the letters patent.

§ 28. Every privilege granted or prolonged by the minister of commerce and trades, as well as every cession of a privilege and its extinction, is published according to § 26.

§ 29. Privileges lose their force—

1. By nullity or by termination (recall, surrender or decree):

a. Such an annulment may take place if it is shown that the legal requirements for an exclusive privilege do not exist, particularly

aa. If it is shown that the description of the privilege is deficient, and particularly if it is not in accordance with § 12, *c—f*, and therefore insufficient.

bb. If any one proves legally that the patented discovery, invention, and improvement, before the day and hour of the official certificate, had already no longer the character of novelty in the empire, according to the provisions of § 1, or that the patented discovery, invention, or improvement had been imported from abroad, and that the privilege in the Austrian States has not been granted to the original proprietor of the foreign patent, or his legitimate assignees (§ 3) ;

cc. If the proprietor of a valid privilege proves that the discovery, invention or improvement patented at a later period is identical with his own discovery, invention, or improvement, as previously laid down according to prescriptions ;

b. If an obligation constituting the validity of the privilege is not fulfilled :

c. If the privilege is contrary to public law (§ 19).

2. By extinction, which takes place,—

a. If within one year at the latest from the date of the patent the patentee has not begun to work his discovery, invention, or improvement in the empire, or whenever he has interrupted his works for two complete years ;

b. If the original or prolonged term of the patent has expired ;

c. If the privilege is surrendered voluntarily.

It is well understood that those reasons, whereby the validity of a privilege ceases or becomes extinct, apply to purchasers of a privilege as well as to the original patentee.

§ 30. As soon as a privilege is invalidated, the use of the respective discovery, invention, or improvement is open to all under the observance of the existing laws regulating trades, and regulations relating thereto.

SECTION V.

OF THE REGISTRATION OF PRIVILEGES AND RECORDING OF SPECIFICATIONS.

§ 31. All privileges as soon as granted are inscribed in a register at the ministry of commerce and trades.

If the privilege is worked under a chosen firm that differs from the true name of the patentee, that firm must also be entered in the register.

The descriptions, drawings, models, &c., belonging thereto are kept in a special record office at the ministry. Every alteration in a privilege is noted in the above register.

§ 32. Any person is at liberty to obtain verbal or written information respecting granted privileges at the patent-office, and for this purpose to inspect the register for himself. The specifications kept at the same place, together with the annexes about which secrecy has not been demanded or belonging to extinct patents, are likewise open to the public ; finally, copies may be taken of single parts of such privileges from the register, or from the privileges that are not to be kept secret. On such occasions those provisions in the present law (§ 44) that relate to infringements are expressly to be pointed out to the applicants.

§ 33. The record office of patents shall submit every month to the minister of commerce and trades a synopsis of the alterations made in privileges during that period by new grants, prolongations, transfers, and extinctions. A copy of that synopsis is forwarded to the governors of provinces and chambers of commerce and trades in the different provinces for the establishment of a register for giving information about patent matters, which information is to be given on demand in the proper way. At the expiration of each year a similar annual synoptical table is published.

§ 34. The specifications of patents expired are printed yearly according to their apparent utility, and circulated in a proper manner.

SECTION VI.

OF THE TRANSFERS OF PRIVILEGES.

§ 35. All exclusive privileges may be transferred entirely or partially to others, during lifetime, as well as by bequest.

§ 36. All assignments, together with the patent, must be submitted to the minister of commerce and trades, directly, or through the governor of the province where the transfer took place, or where the petitioner resides, and for this purpose they must be duly legalized, unless they are issued by a public authority.

If the evidence of the assignment is found by the government or ministry to be defective, it shall be returned for correction.

All proper assignments are to be inserted in the special register (§ 31), and that insertion is to be confirmed on the patents themselves, and in case of a mere partial transfer a special certificate is to be delivered.

§ 37. All registered transfers of privileges are to be published immediately. After such publication no one is allowed to plead ignorance about the transfer.

SECTION VII.

OF INFRINGEMENTS AND THE PROCEEDINGS IN LITIGATION.

§ 38. The following are to be considered as infringements, or as an injury to the holder of a patent. When any one without the consent of the patentee:—

a. Counterfeits or imitates the object of the patent in the manner described in the enclosed specification, even in the case where the counterfeiting or imitating takes place in consequence of the grant of a later patent which is entirely or partially identical.

b. Counterfeits or imitates the object of a patent by importing or bringing such articles from abroad for sale, or for storing and exhibiting for sale; or, finally,

c. Undertaking the sale, or even the storing or exhibiting of such articles for sale.

§ 39. If the specification of a privilege is inserted in the open registers, the very first infringement comes under the law; but if the specification has been kept secret, the repetition only of the infringement is considered as contrary to law, both being punishable, at the request of the injured party with the confiscation of the existing counterfeit goods, and a fine of from 25 fl. to 1000 fl. In case of insolvency of the guilty party, the fine is to be discharged by imprisonment at the rate of one day for 5 fl. As for the tools and means exclusively used for such counterfeitings, they are to be destroyed, transformed, or made useless, according to their nature, unless a special agreement be made between the parties.

The fine is to be paid into the poor-box of the place where the infringement took place. The confiscated objects are to be destroyed, unless the plaintiff agrees to take them in payment of damages given to him.

If the defendant has taken advantage of any knowledge of the discovery, invention, or improvement acquired in the service or by the trust of the plaintiff, such a circumstance must be considered as aggravating the guilt.

§ 40. Should the injured person not proceed criminally, or in cases of a first infringement of a privilege of which the specification is kept secret, the injured person is only authorized to demand the discontinuance of counterfeiting and selling counterfeit goods, and a security against the use or sale, during the term of the patent, of the counterfeit goods found at the infringer's establishment, pro-

vided they were manufactured in the empire, and for their re-exportation in case they were imported from abroad for sale.

§ 41. In all litigation relating to patents the discovery, invention, or improvement is only to be judged according to the specification annexed to the petition; that specification must therefore be taken as a basis in all cases where the decision depends on the contents of the specification, without regard to its being kept secret, and no additional alteration or framing whatever of the patent article can be taken into consideration at those proceedings.

§ 42. The ministry of commerce and trades alone decides the question, whether a patent, from any legal cause whatever, is to be considered as null and void, or as extinct (§ 29). It therefore especially decides the question of the novelty of a discovery, invention or improvement; moreover, the question as to whether it had only been imported from abroad, and was not appropriate for a privilege; finally, in contestations arising between two patentees, the ministry decides the question of the total or partial identity of their privileges.

§ 43. The examination and punishment of the infringements mentioned in §§ 38 and 39 belongs, except so far as other regulations be published in future, to the tribunal of the district in which they took place, according to the laws concerning trades. An appeal to the higher tribunal of the respective province is open for parties who feel themselves injured by such decisions, and in case of the first decision being modified before that tribunal, also to the ministry of commerce and trades; however, such appeals must in all cases be made within fourteen days at the latest of the signification of the judgment.

In cases of appeals the execution of the judgment is to be postponed till the confirmatory decision has been made. If, during the inquiry, the decision is found to depend upon a preliminary question belonging to the jurisdiction of civil tribunals, the parties are referred by the criminal court to the competent civil court, and in such cases the former can only give its own decision according to the legal decision of the latter. Moreover, the final decision of the criminal court by which any one has been found guilty of infringement and fined, may be invoked by the injured party before civil courts for claiming damages, as the case may be.

§ 44. The criminal court may, if sufficient reasons exist, order an inspection or inquiry to be made by an expert, and if by these or other means the case of an infringement is clearly made out, the

court may, at the request of the injured party, order the immediate confiscation or other effective keeping of the counterfeit articles, and the tools and means exclusively used thereto.

However, due care must be taken not to do, without a stringent necessity, any irreparable injury to the defendant, and therefore to demand, if required, security from the plaintiff for any injury and damages that may occur.

§ 45. If during the inquiry the decision is found to depend on preliminary questions determinable by the ministry of commerce and trades (§ 42), such a decision must be sought for officially, and the criminal proceedings are to be suspended till it is obtained:

However, any confiscations that may already have taken place, or any other provisional measures, may be maintained till the question is decided as to whether the proceedings are to be continued.

§ 46. In cases of infringements where no penalty is required, but where merely the discontinuance (§ 40) of the infringement is demanded, or in cases of decisions about privileges as to the priority of the discovery, invention or improvement, or as to private rights or in cases of private claims of the injured party that have been referred by the criminal court to the usual course of justice, the civil tribunals are called upon to give judgment according to the existing regulations respecting summary proceedings in civil matters, wherever such proceedings have been introduced.

§ 47. The civil tribunal likewise may, if the infringement is clearly made out or proved, by an inspection or an expert, order, at the request of the plaintiff, the immediate confiscation or other effective keeping of the counterfeit articles, either unconditionally or against proper security for damages (§ 40), and under the provisions of § 44.

Such measures, however, must be justified, like a prohibition, within eight days after the entry of the order, by a complaint, otherwise they will be rescinded immediately at the request of the opponent, and a claim may be made for damages for the outrage.

§ 48. If the decision of a complaint within the jurisdiction of a civil tribunal depends on preliminary questions that are to be decided by the minister of commerce and trades (§ 42), the parties are required to obtain his decision, and to produce it in the course of the proceedings.

§ 49. Infringements of the rights of third parties, which patentees commit in working their patent by exceeding the limits of their rights founded thereon, are to be punished by those authorities to

whose competency it belongs to decide on infringements of the regulations on trades, according to the special prescriptions on that subject. The circumstance of their having used the privilege for spoiling trades must be considered as aggravating the guilt.

§ 50. The question about the frauds or culpable actions committed by parties appropriating illicitly to themselves the original discovery, invention or improvement of others, in order to obtain a privilege thereon by themselves or other parties, is to be decided according to the penal laws.

SECTION VIII. [*Omitted* because relating to patents delivered before the promulgation of this law.]

FORM A.

Petition for a Privilege.

[*Insert address of the authorities of the respective district or province.*]

I [we] N. N. [*insert christian and family name, profession and domicile of the petitioner or petitioners*] beg to state that I [we] have made a new discovery [*invention, improvement*] consisting essentially in [*insert the comprehensive title*].

The complete specification drawn up according to the provisions of § 12 of the patent-law of _____ is subjoined in the appendix.

[*Insert whether the Specification is to be kept secret, and state the exact number of the drawings, models, patterns, etc., if any.*]

For this discovery [*invention, improvement,*] announced and duly specified, which I [we] the undersigned petitioner, believe to the best of my knowledge to be patentable and new according to the provisions of the said Patent Law, and legal for obtaining an exclusive privilege at my [our] own risk and responsibility, I [we] solicit such a privilege for the stated discovery [*invention, improvement*] in the manner as represented in the annexed sealed specification, under the legal clauses and conditions for the term of _____ years, for which purpose I [we] pay the entire patent tax of _____ florins, due according to § 11 of the said patent law, and request the delivery of an official certificate for securing my [our] prior claims.

[*Address and date.*]

Signature[s].

From *Carpin. Pat. L. of World*, 14.

Extracts from a Digest of the patent law of Austria-Hungary, by Mr. A. H. Mounsey, of the British Legation at Vienna, published 1873.*

On the establishment of the dual system of government in Austria-Hungary, it was decided by a special agreement between the ministers of Hungary and Cisleithania that the Imperial Decree of August 15, 1852, in which the law and practice with regard to inventions are fully explained, should remain in force throughout the whole Empire.

In accordance with the terms of this agreement, the Cisleithanian and Hungarian ministers of commerce submit to mutual approval the inventions for which they intend granting patents, and subsequently to such approval each minister issues patents, bearing identical dates, for its respective division of the Empire.

Thus an inventor, desirous of securing an exclusive right to his invention in Austria-Hungary, must provide himself with two patents. These are, however, granted on a single application, addressed, at the choice of the applicant, either to the Cisleithanian or Hungarian ministry of commerce, and on one payment of the fees.

The patents thus issued are likewise valid in the principality of Lichtenstein.

The taxes on patents, for natives and foreigners indiscriminately, are as follows:

	Fl.	kr.	
For the first five years.....	100	10	= \$48 72
For the second five years.....	200	20	= 97 44
For the third five years.....	400	40	= 194 88
			<hr/>
For fifteen years.....	700	70	= 341 04

These taxes must be paid or deposited in the hands of the government officials previous to the issue of the patent. They are only returned in cases where patents are canceled on public grounds.

From 4 *Pat. Off. Gaz.* 207.

* The omitted portions of Mr. Mounsey's paper are occupied with a concise statement of the substance of the law given in full in the text above.

Law of June 27, 1878.

NOTE.*—This law empowers the ministry of the kingdoms and countries represented in the house of parliament, to establish a commercial and tariff union with the ministry of the countries of the Hungarian Crown. The following article relates to patents for inventions.]

ARTICLE XVI. Patents legally obtained are valid in both countries. For this purpose the conditions of the grant of such patents will be decreed on the same principles by the legislatures of both countries by mutual understanding, and shall, when necessary, be altered in the same way.

Until this takes place the rules relating thereto which are actually existent in both countries, and which do not materially differ from each other remain in force.

As regards proceedings in granting patents, the petition for a patent must be deposited at the ministry of that country in which the inventor has his domicile. Foreigners may present their petitions for the grant of patents at the ministry of one or the other of the two countries.

The ministry where the petition for a patent has been filed shall send the petition, after due examination, officially, to the ministry of the other country, in order to obtain the approbation of the latter.

The letters patent will be issued separately by each ministry for the country under its government, but both deeds must bear the same date, and will be delivered together to the petitioner through the ministry at which he filed the petition.

The prolongation or annulment of patents for inventions shall also be effected by mutual understanding.

The tax for the patent shall be paid in that country where the grant of the patent is petitioned for. For the grant of the patent in the other country a registration fee amounting to 25 per cent. of the patent tax shall be paid.

The registration fee must be paid at the same time as the patent tax, and will be remitted to the ministry of the other country.

From *Carpin. Pat. L. of World*, 32.

* Notes printed in this manner are from Carpmiels' edition.

Law of December 20, 1879.

[NOTE.—This law relates to the creation of a mutual union of tariffs with Bosnia and Herzegovina. The following clause refers to patents for inventions.]

SECTION 9. Patents which have been acquired in accordance with Article XVI. of the Tariff and Commercial Union of June 27, 1878, shall be valid also for Bosnia and Herzegovina according to the laws and regulations existing in both countries of the Austro-Hungarian monarchy.

Patents cannot be acquired by Bosnian and Herzegovinian subjects, except according to the said laws and regulations.

Detailed rules for the execution of these principles shall be issued by the administrations.

From Carpm. Pat. L. of World, 33.

Extract from a Decision of the Minister of Commerce, July 27, 1882, relative to the term of an Austrian patent:

Imp. Roy. Ministry of Commerce, No. 19, 328.

It is herewith affirmed that, according to the provisions of the Patent-Law of August 15, 1852, (Reichs-Gesetzblatt, No. 184) each extension of a patent has solely to be considered as an officially authenticated acknowledgment of the fact that the patentee really avails himself of the right to maintain his patent further in vigor, this right being conferred on him for the lawful term of fifteen years by the original granting of the letters patent, although this latter may not purport to be a fifteen years' one; that for this reason no Austro-Hungarian patent expires in consequence of its original term having elapsed, if the extension of the patent has been applied for in due time, and all the other lawful requirements have been fulfilled in the same time.

VIENNA, July 27, 1882.

By proxy of the minister of commerce,

PROFF, M. P.

From 23 Pat. Off. Gaz. 273.

BADEN.

Baden, also Bavaria, Prussia, Saxony and Württemberg, while independent, had patent laws of their own. Translations of them or statements of their substance may be consulted as follows: Baden, 4 *Pat. Off. Gaz.* 235; Bavaria, *Id.* 237; Prussia, *Id.* 395; *post*, 442; Saxony, *Id.* 473; Württemberg, *Id.* 579, 607.

In 1871 these sovereignties became merged in the German Empire under a constitution, which confided the subject of patent legislation, among others, to the imperial legislature. Some time was, of course, required before this constitutional provision could be carried into full effect, but in 1877 a general patent law for the empire was enacted, which superseded the separate laws above mentioned.

BALIZE: BELIZE.

These names were formerly applied to the region of country now more commonly known as BRITISH HONDURAS (which see); also to its capital city, by which they are retained.

BARBADOES.

An Act to amend the law relating to the granting of Exclusive Privileges to the Inventors of new and useful Inventions. December 12, 1883.

Preamble. Whereas it is deemed expedient to amend the law relating to the granting of exclusive privileges to the inventors of new and useful inventions ; Be it therefore enacted by the Governor, Council and Assembly of this island, and by the authority of the same as follows :

I. *Title of act.* This Act may be cited for all purposes as "The Patent Act, 1883."

II. *Specification to be filed in the colonial secretary's office.* Every person who desires to obtain in this island such exclusive privileges in respect of any invention as are hereinafter in this Act mentioned, shall file in the colonial secretary's office of this island a complete specification of the invention, with a copy of the same, particularly describing and ascertaining the nature of the invention, and in what manner the same is to be performed.

III. *Fee for filing specification.* Every person who files in the colonial secretary's office a specification of an invention shall pay to the colonial secretary for the benefit of the general revenue a fee of three pounds six shillings and eight pence.

IV. *Patentee to have exclusive right for seven years.* Every person who complies with the two last preceding sections of this Act, his executors, administrators and assigns, and every of them by himself and themselves or by his and their deputy or deputies, servants or agents, or such others as he, his executors, administrators and assigns shall at any time agree with and no others from time to time, and at all times during the term of seven years from the date of the filing of the specification as aforesaid, shall and lawfully may make, use, exercise and vend within this island the invention described in the specification so filed as aforesaid in such manner as to him, his executors, administrators and assigns, or any of them shall in his or their discretion seem meet, and he, his executors, administrators, and assigns shall and lawfully may have and enjoy the whole profit, benefit, commodity and advantage from time to time coming, grow-

ing, accruing, and arising by reason of the said invention for and during the term of years hereinbefore mentioned.

V. *Protection to Patentees.* It shall not be lawful for any person or persons, body or bodies politic or corporate, or any of them at any time during the continuance of the term hereinbefore mentioned, either directly or indirectly, to make, use, or put in practice the invention described in any specification so filed as aforesaid, or any part of the same, or in anywise counterfeit, imitate or resemble the same, or to make or cause to be made any addition thereto, or subtraction from the same, whereby to pretend himself or themselves the inventor or inventors thereof, without the consent, permission, license or agreement of the person who filed the specification thereof, his executors, administrators or assigns in writing, under his or their hand or hands, and seal or seals, first had and obtained in that behalf.

VI. *Remedy for infringement of patent.* If any person or persons whomsoever, body or bodies politic or corporate, shall during the continuance of the term hereinbefore mentioned at any time, either directly or indirectly make, use, exercise, put in practice or vend the invention described in any specification so filed as aforesaid or any part thereof within this island without a consent, permission, license or agreement in writing first had and obtained from the person who filed the specification thereof, his attorneys, executors, administrators or assigns under his or their hand or hands, and seal or seals, the person who filed the specification thereof, his executors, administrators and assigns, shall have and be entitled to such and the like remedies both at law and in equity in the courts of this island against every such person or persons, body or bodies politic or corporate, for every such infringement or violation of the rights and privileges to which he and they is and are under this Act entitled, or against the person or persons for whose benefit the said invention or any part thereof shall have been so made, used, exercised, put in practice or vended without such consent, permission, license or agreement as aforesaid as the grantee of any letters patent for any invention would be entitled to in the like case by the law of England but to none other remedies; and in any action, suit or other proceeding which may be brought, instituted or taken against any such person or persons, body or bodies politic or corporate, it shall be lawful for the defendant to plead any such matter in defense as may be pleaded by any defendant in any action brought in any division of Her Majesty's High Court of Justice in England for the

infringement of any patent granted by Her Most Gracious Majesty the Queen.

VII. *No benefit unless invention a new one, or if person applying is not the true inventor, &c.* Nothing in this Act contained shall be deemed to confer on any person who files in the colonial secretary's office a complete specification of an invention the exclusive privileges mentioned in sections four, five, and six of this Act, if the invention described in such specification is not at the time when such specification is filed a new invention as to the public use and exercise thereof within this island, or if such person is not the true and first inventor within this island of the invention described in such specification, or if such invention was at the time when such specification was filed an invention well known elsewhere and also known to some person or persons in this island other than the person filing such specification.

VIII. *Not to give privilege to use the invention of any other person.* Nothing in this Act contained shall extend or be construed to extend to give to any person who files in the colonial secretary's office a complete specification of an invention, or to his executors, administrators or assigns or any of them, privilege to use or imitate any invention or work whatever which has prior to the filing of such specification been found out or invented by any other person whomsoever and publicly used or exercised within this island, and for the sole use, exercise and benefit whereof within this island the exclusive privileges mentioned in sections four, five and six of this Act or similar privileges have, prior to the filing of such specifications, been obtained; but the person filing such specification, his executors, administrators and assigns, and all and every other person and persons who have as aforesaid previously obtained like privileges, shall distinctly use and practice their several inventions by them invented and found out.

IX. *Rights to cease if invention not brought into operation within three years.* When the invention described in a specification filed under this Act is not brought into operation within a period of three years after the filing of the specification, the exclusive right hereby granted or intended to be granted shall be forfeited and shall cease to exist.

X. *Specifications to be numbered.* All specifications filed under this Act in the colonial secretary's office shall be numbered in that office consecutively from Number 1 upwards in the order of the dates on which they are filed.

XI. *Form of certificate.* Whenever a specification is filed under this Act, a certificate of the following form shall be filled up and signed by the colonial secretary, and given to the person filing such specification.

No.

Name of inventor filing specification.

Address.

Date of filing specification.

Title of invention.

I hereby certify that the facts above stated are true, and that the inventor whose name and address are given above is in respect of the invention herein referred to entitled to the several privileges specified in "The Patent Act, 1883," subject to the limitations and conditions therein mentioned.

(Sgd.)

Colonial Secretary,

Barbadoes.

XII. *Numbers of certificate and specification to be the same.* The number of each certificate given in compliance with the last preceding section of this Act shall be the same as that of the specification to which such certificate relates.

XIII. *Power of renewal.* Every person who at the date of the passing of this Act, or at any time hereafter, is, in respect of any invention, entitled under this or any other Act of the legislature to the exclusive privileges mentioned in this Act, or to similar privileges, may on or before, but not after the expiration of such privileges obtain a renewal thereof, for a second or further period of seven years, and may, on or before, but not after the expiration of such further period again obtain a renewal thereof for a third period of seven years; provided always that no person shall enjoy the exclusive privileges mentioned in this Act or similar privileges for more than twenty-one years.

XIV. *Fees to be paid on renewal.* Every person who desires to obtain a renewal of the exclusive privileges to which he is, in respect of any invention, entitled for a second or further period of seven years, shall pay to the colonial secretary for the benefit of the general revenue the sum of ten pounds, and shall thereupon become entitled to such exclusive privileges during such second or further period; and every person who desires to obtain a renewal of such exclusive privileges for a third period of seven years shall pay to the colonial secretary for the benefit of the general revenue the sum of twenty pounds, and shall thereupon become entitled to such exclusive privileges during such third period.

XV. *Renewal certificate.—Form.* The colonial secretary shall, on receipt of any fee under the last preceding section of this Act, fill up and give to the person by or on whose behalf the same is paid a certificate having on it the number of the specification of the invention to which it relates, and of the following form:

Specification No. .

I hereby certify that the exclusive privileges enjoyed by
in respect of the invention described in the specification above referred to have been
this day renewed for a period of seven years.

(Sgd.)
Colonial Secretary, Barbadoes.

Dated,

And the Colonial Secretary shall cause a copy of the same to be published three times in the Official Gazette.

XVI. *Copy certificate to be published in Official Gazette.* Whenever a specification is filed under this Act, the Colonial Secretary shall cause a copy of the certificate given to the person filing the same to be published three times in the Official Gazette.

XVII. *Repeal clause.* The Act of this island of the twenty-sixth day of August, one thousand eight hundred and fifty-two, entitled, "An Act relating to the Law of Patents," is hereby repealed.

From *Carp. Pat. L. World*, 34.

BAVARIA.

See GERMAN EMPIRE.

BELGIUM.

Extracts from a Report of the patent-law of Belgium, by Mr. J. G. Kennedy of the British Legation, published, 1873.

Patents for invention are delivered in Belgium by virtue of the law of May 24, 1854. This law and the royal decree of the same date, determine the rights and the obligations of inventors. The said law has remained unchanged since the date of the publication, with the exception of two slight and unimportant modifications, both favorable to inventors, introduced in 1857, in articles VII. and XXII., and, taken as a patent law, it appears to have given general satisfaction on most points.

By the provisions of the law of 1854, patents for inventions are granted without previous examination either of the novelty or of the merit of the invention, and at the risk and peril of the inventor. It is the substitution of the repressive system for the preventive which formed the basis of the old law of January 25, 1817. The law of 1854 has also introduced special modifications with respect to the taxation of patents. By the law of 1817, the tax, which varied from \$60.25 to \$285.00 and upwards, had to be paid at once on delivery of the patent. The general effect of this condition was the exclusion of all poor inventors. Now that patents cost only \$1.90 for the first year, \$3.80 for the second, with a yearly increase of \$1.90, and that the previous examination is suppressed, the number of inventors has greatly increased.

In granting patents the duty of the government is simply to ascertain that the formalities prescribed by the law and the royal decree have been fulfilled. In this case, provided the invention is a licit one, the patent is granted at the risk and peril of the patentee. In the contrary case, the patent is refused.

The government also interferes in questions of annulment of patent, first, for default of payment of the annuity tax within the time prescribed; and, secondly, in the event of the invention not being worked ("*exploitée*"). Excepting in the above two cases, all disputes concerning the exclusive rights of inventors must be decided by the ordinary civil tribunals.

The chief cause of the annulment, or rather of the lapse of pat-

ents, is default of payment of the annuity within the time prescribed. More than ninety-five one-hundredths of the patents become public property in this way.

The action of government with regard to the concession of patents is very simple. In the case of the canceling of a patent for default in payment, the Finance Department transmits to the Home Department a statement of non-payment drawn up by the tax-receiver ("*receveur*") of the Finance Department, and thereupon the annulment of the patent is pronounced and published by royal decree.

It remains to investigate some of the clauses of the Belgian law of 1854, in order to illustrate the practical working of the different sections, and the nature of the privileges conferred on and obligations incurred by patentees in Belgium.

Article I. enacts that three kinds of patents may be granted—a patent of invention, of importation, and of improvement. A patent of invention is granted to the inventor who takes out his Belgian patent before obtaining letters patent in any other country. In that case, he is entitled to protection for twenty years. A patent of importation is granted to an inventor who, previously to lodging his demand in Belgium, has applied for letters patent in any other country. The patent of importation is limited to the term for which the previous foreign patent is granted, and expires with it. Thus a Belgian patent of importation for an invention already protected in Great Britain would be granted for fourteen years, and if the invention were patented in France the Belgian patent would be for fifteen years.

Belgian patents of importation may be taken out in the name of the inventor or his assign duly appointed. It has been decided by the courts in 1858-59, that a simple power from the inventor authorizing a party to take out a Belgian patent in his own name suffices for the purpose, said power being stamped and registered.

A patent of improvement may be obtained by a patentee for an improvement on or addition to his previous invention. The patent of improvement must be for improvement of the same nature as the original invention, otherwise it would not be held to be legally valid. No tax is required for a patent of improvement, which forms part of the original patent, and expires with it.

In article second the government declines all responsibility as to the value of the patent or of the invention. In case of legal proceedings the patentee may be obliged to lodge a certain sum previ-

ously to the case being brought before the courts. When the patentee is a foreigner he is always obliged to make a deposit, but said deposit rarely exceeds \$95.00.

Under article XVII., in applying for a Belgian patent the inventor or his attorney, having paid the first year's tax, presents himself at the office of the provisional government or "*Commissariat d'Arrondissement*," where he lodges a receipt for the tax and a petition to the minister of the interior, praying that letters patent may be granted to him, and also a sealed packet containing two copies of the specifications and drawings illustrating the invention. The specification may be in any form, and written either in French or Flemish ; the drawings may be made on paper of any size. The patent clerk registers the hour and date of the demand in a book kept for the purpose, and signed by the inventor or his attorney and by the head of the office.

Article XXI. treats of transfers. All transfers of patents are subject to a registration tax, fixed by the law at \$1.90, but, in practice, a few francs more are charged for additional ; and the deed of transfer has to be stamped according to the size of the paper upon which the deed is drawn up. The transfer is then notified to the minister of the interior, who has it recorded in the patent-office and published summarily in the "*Recueil des Brevets d'Invention*."

Article XXII. of the law of 1854 prescribed that a patent should be null and void in case the annual tax should not be paid within a month of its becoming due. In 1857 this article was modified, and a delay of six months was allowed to pay the tax, with an additional fee of \$1.90 ; and the government is now obliged to call the attention of the inventor to the fact that the tax is due, by a registered letter to that effect. This duty devolves on the delegates ("*receveurs*") of the ministry of finance.

Article XXIII. enacts that all patentees shall work their invention, or cause it to be worked, within a year of its having been worked in any other country. The question whether this manufacture or construction of the article must take place in Belgium has been answered in various ways. The law has, however, left this matter entirely to the discretion of the government, which alone has power to decide what is to be understood by the working of an invention, and to judge in each case whether the requirements of the law have been complied with. The courts decline all competency in this matter, and assume that a patent has been worked according to law until it has been annulled by the government.

The views of the government in respect of working an invention may be inferred from divers cases in which patents have been annulled. It would appear that it is not considered sufficient to import the patented articles from abroad and put them on sale in one or more shops or warehouses, even if large numbers were sold in the country by this means. It is not even considered sufficient to have a certain number of the patented articles made and sold in Belgium, the same articles being imported also from abroad and sold in Belgium. The mere fact of importing the patented articles into Belgium, excepting a very limited number to serve as models seems to be considered as quite contrary to the spirit of the law, while a patentee having his invention manufactured in Belgium, and so badly made, owing to the lack of skill or tools, or means of the workmen he employed, that no purchaser could be found to buy it, would, in all probability, be held to have complied with the law, from his having manufactured in the country, and thus favored the "national industry."

The government seldom or never interferes as regards the working of a patented invention, unless called upon to do so by any party having an interest to overthrow the patent. The head of the department there states the case to the patentee or his agent, and requests him to say when and where the patent has been worked. Every facility is afforded him to explain his case and prove that he has complied with the law; and it is only if he fail to do so to the satisfaction of the department that his patent is annulled.

By Article XXIII. (a.) The courts may annul a patent if the invention has been worked commercially in the kingdom by a third party before the demand of the patent.

This alludes to the working commercially by a third party; but if the real and true inventor shall have commercially worked his invention before applying for a patent, such commercial working has no influence on the validity of his patent.

(b.) The intentional omission of part of the inventor's secret, or an erroneous specification given in intentionally, also invalidates a patent.

(c.) If the complete specification and exact drawings should have been printed and published previously to the demand of the Belgian patent, unless such publication should have been prescribed by law—thus, for the publication of an invention to invalidate a subsequent Belgian patent the complete specification and exact drawings must be published—an abridged specification would have

no influence on the Belgian patent. And, as regards patents of importation, an especial exception is made for such publications as the Blue Book printed specifications of English patents, by order of the commissioner of patents.

It may be interesting to mention a further peculiarity connected with Belgian patents of importation, showing what importance is attached by the Belgian law to the patentee being the first and real inventor.

A foreign patentee, though his foreign patent may be several years old, may, should his invention not come under any of the stipulations of article XXIV., take out a valid Belgian patent, and his Belgian patent will have priority over any patents for the same invention taken out by others between the date of his foreign patent and that of his Belgian patent of importation.

From 4 *Pat. Off. Gaz.* 263.

*Law of May 24, 1854.**

ARTICLE I. Exclusive and temporary rights shall be granted under the name of patents of invention, of improvement, or of importation, for all discoveries or all improvements capable of being employed as articles of industry or of commerce.

ART. II. Patents shall be granted without previous examination at the risk and peril of the demander, without guarantee as to the reality, or the novelty, or merit of the invention, or to the accuracy of the specification, and without prejudice to the rights of other parties.

ART. III. The duration of patents is fixed at twenty years, save the case provided for in article fourteen, and shall take effect from the date on which the *procès verbal* shall have been made, as mentioned in article eighteen.

For each patent yearly and progressive dues shall be paid, as follows, viz :

First year, \$1.00 ; second year, \$3.80 ; third year, \$5.70 ; and so on to the twentieth year, for which the tax shall be \$38.00.†

* Another translation of the law of 1854, differing very slightly from that in the text, is given in Carpmiels' edition.

† There shall be paid for every patent an annual and progressive tax, as follows :

1st year 10 francs, 2nd year 20 francs, 3rd year 30 francs, and so on till the 20th year, for which the tax shall be 200 francs. *Carp. Pat. L. of World*, 40.

These dues shall be paid in advance, and shall not in any case be reimbursed.

No payment of dues shall be required for patents of improvement when granted to the proprietor of the original patent.

ART. IV. The patents guarantee to their possessors or assigns the exclusive right—

(a.) To make and sell to their profit the patented article, or cause or license it to be made or sold by other parties.

(b.) To sue in the courts of law such persons who may infringe on their rights, either by making the patented article, or by employing the means comprised in the patent, or retaining, selling, or exposing for sale, or introducing into the Belgian Territory one or more counterfeited articles of the same.

ART. V. If the persons sued in virtue of article IV. (b) shall have knowingly infringed (the patent right,) the courts of law shall pronounce, to the profit of the patentee or of his assigns, confiscation of the articles made in contravention of the patent, or the instruments, tools, or utensils especially destined for executing the same, or award the payment of a sum equal to the price of the articles which may have been already sold.

If the persons sued are of good faith, the court shall prohibit them, under penalty as above stated, from commercially making use of the machines or apparatus of production proved as counterfeits, or to make use of, with the same intent, tools and utensils for making the patented articles.

In either case, damages and interest may be awarded to the patentee or his assigns.

ART. VI. Possessors of patents or their assigns may obtain, by request, authorization from the president of the tribunal of the first instance, to name one or several persons as experts, in order to inspect and make an inventory of the machines, apparatus, or articles supposed to be counterfeited.

The president may by the same ordinance forbid the holders to part with the said articles, and permit the patentee to appoint a guardian, or even to place the articles under seal.

The ordinance of the president shall be communicated by a bailiff *ad hoc*.

ART. VII. The patent shall be joined to the request, which shall contain the address where the inventory is to be made. The examiners named by the president of the court shall be sworn by him,

or by a magistrate specially authorized by him prior to the proceedings.*

ART. VIII. The president may bind the patentee to deposit a sum as caution money.

In this case his ordinance shall not be delivered unless proof be given that the caution money has been deposited. The caution money shall always be required from foreigners.

ART. IX. The plaintiff may be present at the inventory if he should be specially authorized by the president of the court.

ART. X. If the doors shall be closed, or access refused, proceedings shall be adopted conformably to article 587 of the Code of Civil Procedure.

ART. XI. A copy of the *procès verbal* of the inventory made by the examiners shall be left by the detainer of the articles prescribed.

ART. XII. If in eight days the inventory is not followed by a summons before the tribunal of the district where the inventory was made, the ordinance delivered conformably to article six will lose its effect, and the detainer of the articles described may reclaim the original *procès verbal*, and prevent the patentee from making use of its contents, and render public the same, without prejudice to all damages and interest.

ART. XIII. The courts shall consider patent affairs to be summary and urgent.

ART. XIV. The author of an invention already patented in a foreign country, or his assigns, may obtain a patent of importation in Belgium. The duration of such patent shall not exceed the term of the patent previously granted in another country for the longest term, and in no case exceed the limit fixed by article III.

ART. XV. In case of modification of an invention a patent of improvement may be obtained, the term of which shall end at the expiration of the original patent.

If, nevertheless, the possessor of the new patent is not the principal patentee, he shall not, without the consent of the latter, make use of the original invention, and reciprocally the principal patentee shall not make use of the improvement without the consent of the holder of the new patent.

* As modified by the law of March 27, 1857, enabling the president to depute a magistrate to swear the examiners.

ART. XVI. Patents of importation and of improvement confer the same rights as patents of invention.

ART. XVII. Any person desirous of obtaining a patent shall be bound to deposit, under seal, in duplicate at the *greffe* (office) of one of the provisional Governors of the Kingdom, or at the office of a *Commissariat d'Arrondissement*, observing the formalities which shall be determined by a royal decree, an exact and complete specification, in one of the languages used in Belgium, and an exact drawing made to a metrical scale of the invented article.

No deposit shall be received without the production of a receipt showing that the first annuity tax shall have been paid.

A *procès verbal*, drawn up free of cost by the provisional *greffier*, or by the district commissary, in a special register, and signed by the demander, shall authenticate each deposit and express the day and hour of the delivery of the document.

ART. XVIII. The legal date of the invention is established by the *procès verbal*, which shall be drawn up when the demand of the patent is deposited.

A duplicate of this *procès verbal* shall be given to the depositor free of expense.

ART. XIX. A decree of the minister of the interior, proving that the described formalities have been accomplished, shall be delivered forthwith to the depositor, and shall constitute his patent. An extract of this decree shall be published in the *Moniteur*.

ART. XX. The specifications of patents granted shall be published *verbatim*, or in substance, under the care of the administration, in a special collection, three months after the grant of the patent. When a patentee shall require a complete publication or extract furnished by himself, such publication shall be effected at his expense.

After the same term the public shall be admitted to inspect the specifications, and copies of them may be obtained on payment of the expenses.

ART. XXI. All legal transfers of patents between persons, or by will, shall be recorded on payment of a fixed fee of ten francs (\$1.90).

ART. XXII. If the tax fixed by article III. of the law of May 24, 1854, shall not have been paid in the month when due, the patentee, after previous notice, must pay before the expiration of six months, under penalty of forfeiture of his rights, a sum of ten francs, (\$1.90,) besides the usual annuity.

Holders of patents granted since the enforcement of the above law who may not have paid within the legal delay the annuity tax, conformably to article III., will be relieved of the forfeiture incurred by payment, within three months of the publication of the present law, of the sum of ten francs, (\$1.90,) besides the annuities due.

The forfeiture of patents shall be published in the *Moniteur*. The same shall happen in case the patentee shall have been, at his own request, relieved of the forfeiture.

ART. XXIII. The proprietor of a patent must work, or cause to be worked, in Belgium, the patented article within a year from the date of its having been worked or used in a foreign country.

The government may, however, by an explanatory decree, inserted in the *Moniteur* before the expiration of this term, grant a prolongation of one year, at most.

At the expiration of the first year, or of the delay which shall have been granted, the patent shall be annulled by a royal decree.

Annulment shall also be pronounced when the patented article, made use of in a foreign country, shall have ceased to be worked in Belgium during one year, unless the possessor of the patent shall be able to justify the motives of his inaction.

ART. XXIV. Patents shall be declared null and void by the courts for the following causes :

(a.) When it shall be proved that the patented object has been worked or made use of for commercial purposes by other parties prior to the legal date of its invention, or importation, or improvement.

(b.) When the patentee shall have intentionally omitted to explain in the specification joined to his demand any part of his secret, or shall have inaccurately specified the same.

(c.) When it shall be proved that the complete specification and accurate drawings of the patented object have been published in a printed work prior to the date of the deposit, unless, as regards patents of importation, this publication should be a case for legal prescription.

ART. XXV. A patent of invention shall be declared null by the courts if the object for which it was granted shall have been previously patented in Belgium or in a foreign country.

Nevertheless, if the demand has the quality required by article fourteen, the patent may be maintained as a patent of importation on the terms of the said article.

These dispositions shall be applicable, should the case arise, to patents of improvements.

ART. XXVI. When forfeiture or extinction of a patent shall have been pronounced, according to articles XXIV. and XXV. by judgment or decree, having acquired the force of a case judged, the annulment of the patent shall be proclaimed by a royal decree.

ART. XXVII. [Omitted because relating only to patents existing when the law took effect.]

From 4 *Pat. Off. Gaz.* 265.

Royal Decree for the Execution of the Foregoing Law.

ARTICLE I. Any person desirous of obtaining a patent of invention, of improvement, or of importation, must deposit a demand to this effect in the office (*greffe*) of one of the provincial governments of the kingdom, or in the office of one of the *Commissariats d'Arrondissements* situate out of the chief town of the province.

To this demand must be joined, under sealed cover—

1. The specification of the article invented ;
 2. The drawings, models, or patterns which may be necessary for the comprehension of the specifications ;
 3. A duplicate certified copy of the specification and drawings ;
- and
4. A list of the documents and objects deposited.

ART. II. The deposit of the documents mentioned at article I. shall not be received without the production of a receipt showing the payment of 10 francs, (\$1.90,) forming the first annuity of the tax.

This receipt shall be joined to the other papers.

ART. III. The demand must be written on stamped paper, and indicate the name, surname, occupation, (*possession*,) and the real or elected abode of the inventor in the kingdom. It must express a title, including a summary and precise designation of the object of the invention. Each demand shall comprise only one sole principal object, with the details and applications relating thereto.

When a patent of importation shall be demanded the petition shall make known the date and duration of the original patent, and the country where it has been granted. If the petitioner is not the owner of the foreign patent, but his attorney, (*ayant cause*,) he must justify his title by means of an act in due form.

ART. IV. The specification must be written in the French, or German, or Flemish language.

The specification must be written without alterations or interlineations; the words erased as null shall be counted and verified; the pages and references must be initialed, (*paraphés.*)

The specification shall explain the invention in a clear and complete manner, and conclude with a clear enunciation of its component parts.

ART. V. The drawings shall be traced in ink, and to a metrical scale; they must represent as near as possible the article to be invented, by plans, and sections, and elevations, and those parts of the drawings which specially characterize the invention must have a different tint from the other parts.

ART. VI. All the documents must be dated and signed by the inventor or his attorney, whose power, duly legalized, shall remain annexed to the demand.

ART. VII. A *procès-verbal* drawn up by the *greffier* of the provincial government, or by the district commissary, shall be evidence of each deposit, stating the day and hour of the said deposit.

The invention shall be designated by the summary and truthful title which the demander shall have indicated.

This *procès-verbal* shall contain the name, surname, quality, and residence of the demander or his attorney, (“*mandataire.*”) It shall also indicate, when a patent of importation is asked for, the date and duration of the original patent, and the name of the patentee. It must make mention of the payment of the first annuity.

This *procès-verbal* shall be signed by the depositor and by the writer of the same, and shall be affixed on the cover of the package containing the documents relative to the demand of the patent.

A copy of the *procès-verbal* shall be delivered free of cost to the depositor.

ART. VIII. The legal date of the invention is confirmed by the said *procès-verbal*.

ART. IX. The officers of the provincial *Greffiers* and those of the *Commissaires d'Arrondissement* shall be open for the demand of patents every day from 10 A. M. to 2 P. M., excepting Sundays and fête days.

ART. X. All the documents relating to demands of patents shall be transmitted within five days to the department of the interior.

ART. XI. On the arrival of these documents at the above depart-

ment the demands shall be enrolled, in the order of their date of admission, in a special register, which the public may inspect any day, excepting Sundays and fête days from 10 A. M. to 2 P. M.

ART. XII. In case of omission or irregularity of form the demander shall be required ("*invités*") to make the necessary rectifications.

A note of these rectifications shall be made in the special register mentioned in the preceding article.

ART. XIII. Patents demanded in a regular manner shall be delivered without delay.

A decree of the minister of the interior, stating the accomplishment of the prescribed formalities, shall be delivered to the demander, and shall constitute his patent.

ART. XIV. The patent shall expressly state that the grant of the same is made without previous examination, at the risk and peril of the demander, and without guarantee as to the reality or the novelty, or the merit of the invention, or to the accuracy of the specification, and without prejudice to the rights of other parties.

ART. XV. The first delivery of patents shall be made free of expense, but all future deliveries demanded by the patentee or his assigns shall be subject to the reimbursement of the expenses.

ART. XVI. The specifications of patents shall be published verbatim or in substance, under the care of the administration, in a special collection three months after the grant of the patent.

When the patentee shall require a complete publication of his specification, or of an extract of the same furnished by himself, he must inform the administration of his desire one month at least before the expiration of the term fixed by the preceding paragraph, and consign the amount requisite to cover the cost of this publication.

ART. XVII. After the said term of three months the public shall be admitted to examine the specifications, and may obtain copies thereof on reimbursement of the expenses.

ART. XVIII. The patentee who may desire to obtain a prolongation of the delay, as provided for by article XXIII. of the law, for putting into activity the patented article, must address his demand to the minister of the interior two months at least before the expiration of the delay fixed by the said article.

This demand must contain sufficient motives and indicate within the legal limit the term necessary for putting into activity the invention.

ART. XIX. All cessions or mutations, total or partial, of a patent shall be notified to the department of the interior.

The notification of the cession or any other act involving mutation must be accompanied by an authentic extract of the act of cession or of mutation.

ART. XX. Proprietors of patents not expired or annulled at the time of the publication of the law of the 24th May, 1854, may have their rights placed under the administration of this law on forming their demand before the 25th May, 1855.

A patentee who shall not have paid, when the benefit of his disposition shall be demanded, a sum equal to the amount of the annuities due according to article III. of the law, shall be bound to effectuate this payment and justify the same by a receipt joined to their demand ; otherwise the demand shall be of no avail.

A declaration stating that the patent is placed under the administration of the new law shall be sent to the interested party.

ART. XXI. The grants of patents, the acts of cession or of mutation, as also the declarations mentioned in the preceding article, shall be published in a special collection of patents. The decrees pronouncing annulment of patents, or their having been given up to the public, shall likewise be inserted in the same collection.

ART. XXII. At the expiration of patents the original drawings and specifications shall be deposited in the Museum of Industry.

ART. XXIII. The minister of the interior is charged with the execution of the present decree.

From 4 *Pat. Off. Gaz.* 267.

BOSNIA.

See AUSTRIA-HUNGARY.

BRAZIL.

*Law of October 14, 1882.**

ARTICLE I.

By the grant of a patent to the author of any invention or discovery the law guarantees his right to the property and exclusive use of the invention.

SECTION 1. According to this law the following shall constitute an invention or discovery.

1. The invention of new industrial products.

2. The invention of new processes or the new application of known processes for obtaining an industrial product or result.

3. The improvement of an invention already patented if it facilitates the manufacture of the product or the use of the patented invention, or if it increases its utility.

Those industrial products, processes, applications, and improvements shall be considered new which, up to the application for a patent, have never been employed or used within or without the empire, nor have been described or published so that they could be employed or used.

SEC. 2. The following inventions cannot be the subjects of patents:—

1. Those contrary to law or morality.

2. Those dangerous to public security.

3. Those hurtful to public health.

4. Those which do not offer practical industrial results.

SEC. 3. The patent will be granted by the executive power after the fulfillment of the formalities prescribed in this law and in its regulations.

SEC. 4. The exclusive privilege for a principal invention will only be valid for fifteen years, and that for an improvement to the

* The substance of the former law, which was promulgated August 28, 1830, is given in a report by Mr. Phipps of the British Legation, published Sept. 16, 1873, 4 *Pat. Off. Gaz.* 289, together with accounts of the practice and formalities in granting patents in Brazil, and of the

project then pending for a more complete and comprehensive legislation on the subject. A translation of the Law of 1852, differing very slightly from that presented in the text, may be found in 23 *Pat. Off. Gaz.* 193.

invention granted to the inventor will terminate at the same time as the original patent.

If public necessity or utility require the free use (*vulgarisaçãõ*) of an invention or its exclusive use by the State during the privilege for it, the patent can be disappropriated in conformity with the legal formalities.

SEC. 5. The patent is transmissible by any of the modes of cession or transfer recognized by law.

ARTICLE II.

Inventors receiving privileges in other countries can obtain confirmation of their rights in the empire, provided they fulfill the formalities and conditions of this law and observe the further provisions in force applicable to the case. The confirmation will give the same rights as a patent granted in the empire.

SEC. 1. The priority of right of property of an inventor who, having solicited a patent in a foreign country, shall make a similar petition to the imperial government within seven months, will not be invalidated by facts which may occur during this period—such as another similar petition, the publication of the invention, and its use or employment.

SEC. 2. To the inventor who, before obtaining a patent, desires to experiment in public with his inventions, or wishes to exhibit them in an official or officially recognized exhibition, will be given a document provisionally guaranteeing to him his right of property for a specified time and with the formalities required.

SEC. 3. During the first year of the patent only the inventor himself or his legal successors can obtain a patent for improvements on the invention. Third parties will be permitted, however, to present their petitions within the said period in order to establish their rights.

The inventor of an improvement cannot make use of the improved article while the patent for the principal invention lasts without an authorization from its inventor. Nor can the latter employ the improvement without agreement with the former.

SEC. 4. If two or more persons petition for patents at the same time for an identical invention, the government, except in the hypothesis of section 1 of this article, will require that they previously determine the priority either by means of agreement or in a competent court.

ARTICLE III.

The inventor who seeks a patent shall deposit in duplicate in the department which the government shall designate, in a closed and sealed envelope, a specification in Portuguese, describing the invention with accuracy and clearness, its purpose and the method of using it, with the plans, designs, models, and samples which may contribute to an exact understanding of the invention and the elucidation of the specification, so that any person competent in the matter can obtain or apply the result, means, or product of which it treats. The specification shall clearly set forth the characteristic features of the invention. The rights under the patent will be limited to the said features, mention of this being made in the patent.

SEC. 1. With the documents deposited shall be presented the petition, which should be limited to one single invention, specifying its nature and its purposes or applications in accordance with the specification and the documents deposited.

SEC. 2. If it shall appear that the subject of the invention involves an infraction of section 2, article I., or has for its object alimentary, chemical, or pharmaceutical products, the government will order a previous secret examination of one of the samples deposited, in conformity with the regulations to be issued, and in accordance with the result it will or will not concede a patent. From an adverse decision there will be an appeal to the Council of State.

SEC. 3. With the sole exception of the cases mentioned in the preceding paragraph, the patent will be issued without previous examination. The patent will always designate the object of the privilege in a concise manner, saving the rights of third parties and without guarantee of the government, as to the originality or utility of the invention.

In the patent of an inventor privileged outside of the empire it will be declared that it is valid so long as the foreign patent is in force, never exceeding the specified period of section 4, article I.

SEC. 4. Besides the expenses and fees incurred, patentees shall pay a tax of twenty dollars for the first year, thirty dollars for the second, forty dollars for the third, the annuity for each year of the privilege being ten dollars more than the preceding annuity. In no case will the annuities be refunded.

SEC. 5. To the privileged inventor who improves his own inven-

tion will be given a certificate of improvement, which will be appended to the original patent. For this certificate the inventor will pay, once for all, an amount corresponding to the annuity about to become due.

SEC. 6. The transfer or cession of a patent or certificate will not come into effect until it has been registered in the bureau of agriculture, commerce, and public works.

ARTICLE IV.

The patent having been issued, within a period of thirty days the opening of the deposited envelopes shall take place with the formalities which the regulations shall specify. The specification shall be immediately published in the *Diario Oficial*, and one of the copies of the designs, plans, models, or samples will be open to the inspection of the public and the study of parties interested, copies being allowed to be taken.

SEC. 1. In case the previous examination mentioned in section 2, article III., has not taken place, the government, having published the report, will order the verification of the requisites and conditions required by law for the validity of the privilege by means of experiments according to the procedure established for such examination.

ARTICLE V.

A patent shall be of no effect in case of nullity or lapsing.

SEC. 1. The patent shall be null—

1. If in its granting any one of the requirements of sections 1 and 2 of article I. has been violated.

2. If the patentee did not have priority.

3. If the patentee has falsified the truth or concealed essential matter in the specification describing the invention, whether in its object or in the manner of using it.

4. If the title of the invention is, with fraudulent purpose, diverse from its real object.

5. If an improvement has not an indispensable relation with the principal invention, but can constitute a separate industry, or if there shall have been the state of priority referred to in article II., section 3.

SEC. 2. The patent shall lapse—

1. If the patentee does not make effective use of the invention within three years, counting from the date of patent.

2. If the patentee suspends the effective use of the invention for

more than one year, except by reason of *force majeure* admitted by the government after consulting the Council of State. By use is understood, in these two cases, the effective exercise of the patented industry, and the supply of the products in proportion to their employment or consumption. On proof that the supply of the products is evidently insufficient for the needs of employment or consumption, the privilege can be restricted to a zone determined by a decree of the government with the approval of the legislative power.

3. If the patentee does not pay the annuities within the terms of the law.

4. If a patentee residing out of the empire does not appoint an accredited agent to represent him before the government or in court.

5. If the patent is expressly renounced.

6. If the patent or foreign privilege for an invention also patented in the empire ceases from any cause.

7. When the term of the privilege has expired.

SEC. 3. The nullity of a patent or of a certificate of improvement shall be declared by a decision of the commercial court (*jurzo commercial*) of the capital of the empire by means of the summary process of the decree No. 737 of November 25, 1850.

The following are competent to promote an action for nullity:—the solicitor of the treasury (*procurador dos feitos da fazenda*) and his assistants, to whom will be forwarded the documents and proofs corroborative of the infraction, and any interested party, with the assistance of that official and his assistants.

An action for nullity in the cases of article I., section 2, Nos. 1, 2, and 3, having been begun, the effect of the patent and the use or employment of the invention will be suspended until the final decision. If the patent is not annulled, the patentee will be reinvested in its enjoyment for the whole term of the privilege.

SEC. 4. The lapse of patents shall be declared by the minister and secretary of state for affairs of agriculture, commerce, and public works, with an appeal to the Council of State.

ARTICLE VI.

The following will be considered infringers of the patent:—

1. Those who, without license from the patentee, manufacture the products or employ the processes or make the applications which are the subject of the patent.

2. Those who import, sell, or expose for sale, conceal, or receive for the purpose of sale products which are infringements of the privileged industry, knowing them to be such.

SEC. 1. The infringers of a patent will be punished, for the benefit of the treasury, with a fine from five hundred dollars to five thousand dollars, and for the benefit of the patentee, with from ten to fifty per cent. of the damage caused or which may be caused.

SEC. 2. The following will be considered as aggravating circumstances:—

1. The infringer being, or having been, an employe or workman in the establishment of the patentee.

2. The infringer having associated with an employe or workman of the patentee for acquiring knowledge of the practical method of obtaining or employing the invention.

SEC. 3. The cognizance of infringements of a privilege belongs to the *juizes de direito* (district judges) of the *comarcas* (districts) where they occur, who will issue, on the petition of the patentee or his legal representative, warrants of search, apprehension, and deposit, and will prescribe the preparatory or preliminary proceeding of the process. The sentence shall be governed by law No. 562 of July 2, 1850, and by decree No. 707 of October 9th of the same year, so far as they apply to the case. The products of which Nos. 1 and 2 of this article treat, and the respective instruments and apparatus, will be adjudged to the patentee by the same sentence which condemns the authors of the infringements.

SEC. 4. The process will not hinder an action by the patentee to secure indemnification for damage caused or which may be caused.

SEC. 5. Commercial jurisdiction is competent for all cases relative to industrial privileges in conformity with this law.

SEC. 6. The following will be punished with a fine of from one hundred dollars to five hundred dollars for the benefit of the treasury :—

1. Those who announce themselves as possessors of a patent, by using emblems, marks, placards, or labels upon products or articles prepared for commerce or exposed for sale, as if they had been patented.

2. Inventors who continue to exercise an industry as patented when the patent has been suspended, annulled, or has lapsed.

3. Privileged inventors who in prospectuses, advertisements, placards, or by any mode of public notice shall mention patents without designating the special object for which they were obtained.

4. Professional men or experts who being employed under section 2, of article III. cause the general diffusion of the secret of the invention; without prejudice in this case to such criminal or civil actions as the laws permit.

SEC. 7. The offenses of which the preceding paragraph treats shall be prosecuted and judged as simple police offenses, in conformity with the legislation in force.

ARTICLE VII.

When a patent has been conceded to two or more co-inventors, or when it becomes common property by deed of gift or succession, each one of the co-proprietors may use it freely.

ARTICLE VIII.

If a patent shall be given or left in usufruct, the usufructuary will be obliged, when his rights cease through the extinction of the usufruct or termination of the term of privilege, to give to the owner of the property the value at which it shall be estimated, calculated with relation to the time which the usufruct has lasted.

ARTICLE IX.

Patents of inventions already granted will continue to be governed by the law of October 26, 1830, the provisions of article V. section 2, Nos. 1 and 2, and of article VI. of this present law, with the exception of pending processes or actions, being applicable to them.

ARTICLE X.

All enactments contrary to the present law are hereby repealed.

From Carpm. Pat. L. of World, 46.

See also INTERNATIONAL CONVENTION.

BRITISH COLUMBIA

See CANADA.

BRITISH GUIANA.

Ordinance No. 13, of (July 12), 1861, to regulate the granting of Patents.

Preamble.

Whereas it is expedient to regulate the granting of patents for inventions in this colony: Be it therefore enacted by His Excellency the Lieutenant-Governor of British Guiana, with the advice and consent of the court of policy thereof, as follows:—

1. *Petition for patent to be accompanied by affidavit and provisional specification.* From and after the taking effect of this ordinance, every inventor desirous of obtaining protection for his invention within this colony shall petition the Governor to grant to him, his heirs, executors, administrators, and assigns, letters patent for his invention, in the name of Her Majesty, under the public seal of this colony, and every petition for letters patent as aforesaid, shall be lodged at the office of the government secretary, accompanied by an affidavit, signed by the petitioner, that he is the true and first inventor, and that the invention is not in use by any other person or persons within the colony, to the best of his knowledge and belief, and also by a statement in writing, hereinafter called the provisional specification, signed by or on behalf of the petitioner, describing the nature of the invention; and all such petitions, affidavits, and provisional specifications shall be preserved in, and a registry thereof kept at, the said office.

2. *Petition and affidavit of absent inventor to be legalized.—Also complete specification.* In the event of any such inventor being resident out of the colony, the petition, affidavit, and provisional specification may be lodged by any person acting as his agent in the colony, provided that the petition and affidavit of such inventor (or his declaration in places where a declaration is allowed by law instead of an oath) be certified and transmitted under the signature and seal of any mayor, notary public, or justice of the peace, or of any British consul, or vice-consul, or of any other officer authorized to administer oaths or receive declarations; and in like manner the complete specification referred to in the 4th and 12th sections may be deposited by the agent of any such absent inventor, provided the same be legalized as aforesaid.

3. *Applications to be referred to attorney-general for examination.* Every application for letters patent under this ordinance, together with all documents connected therewith, shall be referred for examination, and report to the attorney-general, who shall be at liberty in examining the provisional specification to call to his aid such scientific or other person as he may think fit, and to cause to be paid to such person by the petitioner such remuneration as the attorney-general shall appoint; and if the attorney-general be satisfied that the provisional specification describes the nature of the invention, he shall allow the same, and give a certificate of his allowance, and such certificate shall be filed in the office of the government secretary, and thereupon the invention therein referred to may, during the term of twelve months from the date of the application for letters patent for the said invention, be used and published without prejudice to any letters patent to be granted for the same, and such protection from the consequences of use and publication is hereinafter referred to as provisional protection: Provided always, that in case the title of the invention or the provisional specification be too large or insufficient, it shall be lawful for the attorney-general to allow or require the same to be amended; it being, nevertheless, in every case, entirely at the hazard of the petitioner whether the invention is new or will have the desired effect.

4. *Inventors may deposit a complete specification; to confer rights for 12 months.* The applicant for letters patent for an invention, instead of leaving with the petition and affidavit a provisional specification as aforesaid, may, if he think fit, deposit in the registrar's office for the counties of Demerara and Essequibo an instrument in writing under his hand (hereinafter called a complete specification), particularly describing and ascertaining the nature of the said invention, and in what manner the same is to be performed, of which specification an authentic copy shall be filed with the petition and affidavit, and the day of the delivery of every such petition, affidavit, and complete specification shall be recorded at the office of the government secretary, and a certificate thereof given to such applicant or his agent, and thereupon, subject and without prejudice to the provisions hereinafter contained, the invention shall be protected under this ordinance for the term of twelve months from the date of the application, and the applicant shall have during such term of twelve months, the like powers, rights and privileges as might have been conferred upon him by

letters patent for such invention issued under this ordinance and duly sealed as of the day of the date of such application ; and during the continuance of such powers, rights, and privileges under this section, such invention may be used and published without prejudice to any letters patent to be granted for the same ; and where letters patent are granted in respect of such invention, then in lieu of a condition for making void such letters patent in case such invention be not described and ascertained by a subsequent specification, such letters patent shall be conditioned to become void if such complete specification deposited as aforesaid does not particularly describe and ascertain the nature of the said invention, and in what manner the same is to be performed ; and every such complete specification shall be open to the inspection of the public as hereinafter provided, from the time of depositing the same.

5. *Patent not invalidated by protection obtained in fraud.* In case of any application for letters patent for any invention, and the obtaining upon such application of provisional protection for such invention or of protection for the same, by reason of the deposit of a complete specification as aforesaid in fraud of the true and first inventor, any letters patent granted to the true and first inventor of such invention shall not be invalidated by reason of such application or of such provisional or other protection as aforesaid, or of any use or publication of the invention subsequent to such application, and before the expiration of the term of such provisional or other protection.

6. *Protections to be advertised and provisional specifications deposited.* Where any invention is provisionally protected under this ordinance, or protected by reason of the deposit of such complete specification as aforesaid, the government secretary shall cause public notice of such provisional protection or other protection as aforesaid to be given in the Official Gazette, and the government secretary shall cause to be delivered to the registrar for the counties of Demerara and Essequibo every provisional specification after the term of the provisional protection of the invention has expired, to be by him entered free of charge in the "Register of Patents" hereinafter mentioned.

7. *Application to be advertised, and oppositions may be entered.* The applicant for letters patent, so soon as he may think fit after the invention shall have been provisionally protected under this ordinance, or where a complete specification has been deposited at the time of filing his petition and affidavit, then so soon as he may

think fit after such deposit, may give notice at the office of the government secretary of his intention of proceeding with his application for letters patent for the said invention, and thereupon the government secretary shall cause his said application to be advertised in the Official Gazette in such manner as he may see fit; and any person having an interest in opposing the grant of such letters patent for the said invention shall be at liberty to file particulars in writing of their objections to the said application in the office of the government secretary within one month from the date of the notice, and all such objections shall be referred to the attorney-general.

8. *Patent to issue on report of attorney-general.—Appeal.* When the time allowed for filing objections as aforesaid shall have expired, the attorney-general shall report in writing to the Governor upon each application for letters patent as aforesaid, and also upon any opposition that may be entered thereto, and public notice of all such reports having been submitted to the governor shall be given in the Official Gazette for two successive weeks, at the expiration of which time, if the attorney-general shall have reported that there is no valid legal objection to letters patent being granted, the governor may direct letters patent to issue, as hereinafter provided: Provided always, that within the said period of two weeks any party interested who may consider himself aggrieved by any such report of the attorney-general shall be at liberty to apply by petition to the Supreme Court of Civil Justice of the colony, or chief justice during non-session of said court, for their or his judgment upon the question at issue; and the court or chief justice, after hearing the parties interested if they or any of them shall think proper to appear, shall give judgment accordingly, and all costs shall be in the discretion of such court or chief justice; and the attorney-general shall alter or amend his report according to such judgment if necessary.

9. *Duration and effect of patent.* All letters patent for inventions under this ordinance shall be granted by the governor, in the name of Her Majesty, under the public seal of the colony, and the same shall extend to whole of the colony, and shall continue in force within this colony for the term of fourteen years from the date of the original application, and during such term the patentee, his heirs, executors, administrators, and assigns, shall have full power, sole privilege, and authority, by himself and themselves, and by his and their deputy or deputies, servants or agents, or such others as he,

the said patentee, his heirs, executors, administrators, or assigns, shall at any time agree with, and no others, from time to time, and at all times during the said term of fourteen years, lawfully to make, use, exercise, and vend the invention mentioned in such letters patent within this colony, in such manner as to him, the said patentee, his heirs, executors, administrators, and assigns, or any of them, shall, in his or their discretion, seem meet; and he, the said patentee, his heirs, executors, administrators, and assigns, shall and lawfully may have and enjoy the whole profit, benefit, commodity, and advantage from time to time coming, growing, accruing, and arising by reason of such invention for and during such term of fourteen years; but all such letters patent shall be subject to the conditions hereinafter mentioned.

10. *No person to use or imitate the invention without consent.* During the continuance of the said term it shall not be lawful for any person whomsoever at any time, either directly or indirectly, to make, use, or put in practice within this colony the said invention or any part of the same, nor in any wise to counterfeit, imitate, or resemble the same, nor to make or cause to be made any addition thereunto, or subtraction from the same, whereby to pretend himself the inventor or devisor thereof, without the consent, license, or agreement of the said patentee, his heirs, executors, administrators, or assigns, in writing under his or their hands, first had and obtained in that behalf; and if any person shall, at any time during the continuance of the said term, either directly or indirectly, make, use, or put in practice within this colony the said invention or any part of the same, or shall in any wise counterfeit, imitate, or resemble the same, or make or cause to be made any addition thereto, or subtraction therefrom, whereby to pretend himself the inventor or devisor thereof, without such consent, license, or agreement as aforesaid, every such person shall be liable to such pains and penalties as can or may be inflicted upon any person for any such breach or violation of this ordinance, and shall further be answerable to the said patentee, his heirs, executors, administrators, and assigns, according to law, for his and their damages thereby occasioned.

11. *Patent to be avoidable on non-fulfillment of certain conditions.* All letters patent for inventions under this ordinance shall be made and shall be subject to the conditions that the same shall be void, and that the powers and privileges thereby granted shall cease and determine, if any person shall, during the continuance of the said term of fourteen years, successfully establish and prove

before the Honorable the Supreme Court of Civil Justice of this colony that the grant of such letters is contrary to law, or prejudicial or inconvenient to Her Majesty's subjects in general, or that the invention mentioned in such letters patent is not a new invention as to the public use and exercise thereof, or that the grantee of such letters patent is not the true and first inventor within this colony : And such letters patent, or anything therein contained, shall not extend or be construed to extend to give privilege unto the grantee thereof, his heirs, executors, administrators, or assigns, or any of them, to use or imitate any invention or work whatever theretofore found out or invented by any other of Her Majesty's subjects whatsoever, and publicly used or exercised in this colony, unto whom like letters patent or privileges shall have already been granted in this colony for the sole use, exercise, and benefit thereof.

12. *Patent to be avoidable on non-fulfilment of further conditions.* All letters patent for inventions under this ordinance shall also be made and shall be subject to the further conditions that the same shall be void, and that the powers and privileges thereby granted shall cease and determine, if the patentee shall fail or neglect to record the said letters patent in the registrar's office for the counties of Demerara and Essequibo within ten days from the date thereof, and also if the patentee shall fail or neglect to deposit in the said registrar's office, within six months from the date of the said letters patent, save (and except as provided in the 4th section of this ordinance) a clear and copious statement in writing, herein called the complete specification, under his hand, particularly describing and ascertaining the nature of his invention, and in what manner the same is to be performed, and also if the said instrument in writing deposited as aforesaid does not particularly describe and ascertain the nature of the said invention, and in what manner the same is to be performed, and also if the said patentee, his heirs, executors, administrators or assigns, shall not supply or cause to be supplied for Her Majesty's service in this colony all such articles of the said invention as he or they shall be required to supply by the officers administering the department of Her Majesty's service in this colony for the use of which the same shall be required, in such manner, at such times, and at and upon such reasonable prices and terms, as shall be settled for that purpose by the governor; and further that the said letters patent shall be void, and that the powers and privileges thereby granted shall cease and determine, at the expiration of seven years from the date thereof, unless

there be paid before the expiration of the said seven years the stamp duty in the schedule A to this ordinance annexed; and such letters patent, or a duplicate thereof shall, on such payment, be stamped with a proper stamp, showing the payment of such duty, and notice of such payment shall be given by the government secretary in the Official Gazette.

13. *No patents to be issued after three months.* No letters patent for inventions under this ordinance shall be issued or be of any force or effect unless the same shall be applied for, and the stamp duty then payable in respect thereof tendered, within the period of three months from the date of the attorney-general's report; and no letters patent shall be issued or be of any force or effect unless the same be granted during the continuance of the provisional protection under this ordinance, or unless a complete specification has been deposited under this ordinance, or then unless such letters patent be granted during the continuance of the protection conferred under this ordinance by reason of such deposit; save that where the application to seal such letters patent has been made during the continuance of such provisional or other protection as aforesaid, and the sealing of such letters patent has been delayed by reason of a caveat, or an application to the Supreme Court or chief justice against or in relation to such letters patent, then such letters patent may be sealed within such extended time as the court or chief justice shall be pleased to grant for enabling the applicant to apply to the Governor to order such letters patent to be sealed.

14. *Patent may be granted to heirs, &c., of applicant.* Where the applicant for such letters patent dies during the continuance of the provisional protection, or the protection by reason of the deposit of a complete specification (as the case may be), such letters patent may be granted to the heirs, executors or administrators of such applicant during the continuance of such provisional or other protection, or at any time within three months after the death of such applicant notwithstanding the expiration of the term of such provisional or other protection, and the letters patent so granted shall be of the like force and effect as if they had been granted to such applicant during the continuance of such provisional or other protection.

15. *Patent may be dated as of the day of application.* It shall be lawful to cause any letters patent to be issued in pursuance of this ordinance to be sealed and bear date as of the day of the application for the same, or where the governor thinks fit and

directs any such letters patent as aforesaid may be sealed and may bear date as of the day of the sealing of such letters patent, or of any other day between the day of such application and the day of such sealing.

16. *Patent antedated to be valid.* Any letters patent issued under this ordinance, sealed and bearing date as of any day prior to the day of the actual sealing thereof, shall be of the same force and validity as if they had been sealed on the day as of which the same are expressed to be sealed and bear date: Provided always, that, save where such letters patent are granted for any invention in respect whereof a complete specification has been deposited upon the application for the same under this ordinance, no legal proceeding shall be had upon such letters patent in respect of any infringement committed before the same were actually granted.

17. *Patent obtained in the colony for patented extra-colonial inventions.* Where upon any application made after the taking effect of this ordinance for or in respect of any invention first invented in the United Kingdom, or in any foreign country, and a patent or like privilege for the monopoly or exclusive use or exercise of such invention in the United Kingdom, or in any foreign country is there obtained before the grant of such letters patent in this colony, all rights and privileges under such letters patent shall (notwithstanding any term in the letters patent limited) cease and be void immediately upon the expiration or other determination of the term during which the patent or other like privilege obtained in the United Kingdom or in such foreign country shall continue in force, or where more than one such patent or like privilege is obtained abroad, immediately upon the expiration or determination of the term which shall first expire or be determined of such several patents or like privileges: Provided always that no letters patent for or in respect of any invention for which any such patent or like privilege as aforesaid shall have been obtained in the United Kingdom or in any foreign country, and which shall be granted in this colony after the expiration of the term for which such patent or privilege was granted or was in force, shall be of any validity.

18. *Patent not to prevent the use of invention in foreign ships.* No letters patent for any invention (granted after the taking effect of this ordinance) shall extend to prevent the use of such invention in any foreign ship or vessel, or for the navigation of of any foreign ship or vessel which may be in any port in this colony or in any of the waters within the jurisdiction of any of

Her Majesty's courts in this colony, where such invention is not used for the manufacture of any goods or commodities to be vended within or exported from this colony : Provided always, that this enactment shall not extend to the ships or vessels of any foreign State, of which the laws authorize subjects of such foreign State having patents or like privileges for the exclusive use or exercise of inventions within its territories to prevent or interfere with the use of such inventions in British ships or vessels, or in or about the navigation of British ships or vessels while in the ports of such foreign State, or in the waters within the jurisdiction of its courts, where such inventions are not so used for the manufacture of goods or commodities to be vended within or exported from the territories of such foreign State.

19. *Patents heretofore granted in the United Kingdom.* Nothing herein contained shall extend to prejudice or affect any letters patent heretofore granted in the United Kingdom, and made applicable by the tenor thereof to this colony, and such letters patent shall be in every respect as valid and effectual as if this ordinance had not been passed : and printed or manuscript copies or extracts, certified and sealed with the seal of the commissioners of patents, of every such letters patent, and of the specification thereto relating, and of any disclaimer or memorandum of alteration in respect thereof, shall be deposited or recorded in the registrar's office, and notice thereof given in the Official Gazette.

20. *Disclaimer and memorandum of alteration—notice and appeal.* Any person who, as grantee, assignee, or otherwise, shall obtain letters patent under this ordinance, may, if he think fit, enter at the said registrar's office, having first obtained the leave of the attorney-general, certified by his fiat and signature, a disclaimer of any part of either the title of the invention or of the complete specification, stating the reason for such disclaimer, or may, with such leave as aforesaid, enter a memorandum of any alteration in the said title or specification, not being such disclaimer or such alteration as shall extend the exclusive right granted by the said letters patent ; and such disclaimer or memorandum of alteration, being entered at the said office and notified by the registrar in the Official Gazette, shall be deemed and taken to be part of such letters patent, or such complete specification, in all courts whatever in this colony : Provided always, that any person desirous of entering any such disclaimer or alteration shall be bound to give three weeks previous notice in the Official Gazette of his intention to enter the

same: And provided further, that any party aggrieved by any decision of the attorney-general under this section may, within two weeks from the date of such decision apply by petition to the Supreme Court or chief justice to alter or amend the same; and the court or chief justice, after hearing the parties interested, if they or any of them shall think proper to appear, shall give judgment accordingly, and all costs shall be in the discretion of such court or chief justice; and the attorney-general shall alter or amend his decision, according to such judgment, if necessary.

21. *Caveats may be entered.* Any person may enter a caveat against such disclaimer or alteration at the said registrar's office within the said period of three weeks, which caveat, being so entered, shall be referred to and heard and determined by the attorney-general, subject to an appeal to the court or chief justice in like manner as is provided in the last preceding section: Provided always, that no disclaimer or alteration shall be receivable in evidence in any action or suit pending at the time when such disclaimer or alteration was entered, but in every such action or suit the original title and complete specification alone shall be given in evidence and deemed and taken to be the title and complete specification of the invention for which the letters patent shall have been granted: And provided further, that such entry and notification in the Official Gazette of any disclaimer or memorandum of alteration in pursuance of the leave of the attorney-general, shall, except in cases of fraud, and subject to the aforesaid appeal, be conclusive as to the right of the party to enter such disclaimer or alteration; and no objection shall be allowed to be made in any proceeding in this colony upon or touching such letters patent, specification, disclaimer, or alteration, on the ground that the party entering such disclaimer or memorandum of alteration had not sufficient authority in that behalf.

22. *Mode of proceeding for confirmation of the letters patent.* If in any action or suit in this colony it shall be specially found by the court or jury that any person who shall have obtained letters patent in this colony for any invention, or supposed invention, was not the first inventor thereof, or of some part thereof, by reason of some other person or persons having invented or used the same or some part thereof in this colony before the date of such letters patent, or if such patentee or his assigns shall discover that some other person had unknown to such patentee invented or used the same or some part thereof in this colony before the date of such letters

patent, it shall be lawful for such patentee or his assigns to petition the governor, with the advice and consent of the Court of Policy, to confirm the said letters patent, or to grant new letters patent, the matter of which petition shall be referred to and heard before the Court of Policy, and such court, upon examining the said matter, and being satisfied that such patentee believed himself to be the first and original inventor, and further, that such invention or part thereof had not been publicly and generally used in this colony before the date of such letters patent, may state by resolution their opinion that the prayer of such petition ought to be complied with, whereupon the governor may, if he think fit, grant such prayer; and the said letters patent shall in such case be available in law to give such petitioner the sole right of using, making, and vending in this colony the said invention as against all persons whatever, any laws, usage, or custom to the contrary notwithstanding: Provided, that any person opposing such petition shall be entitled to be heard before the said Court of Policy, and that any person party to any former suit or action touching such first letters patent shall be entitled to have notice of such petition before presenting the same.

23. *Application for the prolongation of the term of the patent.* If any person who shall obtain any letters patent under this ordinance, or any assignee of such patentee, shall advertise for one month in the Official Gazette that he intends to apply to the Governor to grant to him, with the advice and consent of the Court of Policy, a prolongation of his term of sole using and vending his invention within this colony, and shall petition the Governor to that effect, it shall be lawful for any person to enter a caveat at the office of the government secretary; and the matter being referred to the consideration of the Court of Policy, the petitioner and the parties entering caveats and their respective witnesses shall be heard, whereupon, and upon hearing and inquiring of the whole matter, the Court of Policy may state by resolution their opinion that a further extension of the term in the said letters patent should be granted, not exceeding seven years; and the Governor may, if he think fit, thereupon grant new letters patent for the said invention for a further term not exceeding seven years after the expiration of the first term, any law, usage, or custom to the contrary notwithstanding; provided always, that no such extension shall be granted unless the petition shall be presented six months at least before the expiration of the term originally granted in such letters patent, and

shall be thereafter prosecuted by the petitioner with due diligence, to the satisfaction of the Governor and Court of Policy.

24. *Witnesses may be summoned in proceeding under this ordinance.* It shall be lawful for the Governor and Court of Policy to order any person to be summoned to appear before them to give evidence in any proceeding before them under this ordinance; and if any person being served with any such order or summons of the Governor and Court of Policy, shall refuse or neglect to appear at the time and place mentioned in such order or summons, such person shall be subject to a fine by the Governor and Court of Policy, not exceeding two hundred and forty dollars, to be recovered at the instance of the attorney-general by summary execution.

25. *Evidence to be given upon oath.* It shall be lawful for the Governor and Court of Policy to administer to any person who shall appear as a witness in any such proceeding, any oath or affirmation that may lawfully be administered in any court of justice, and every witness who shall willfully give a false answer to any question that may be put to him or her, or shall swear falsely on any oath, or shall falsely affirm any matter or thing, shall be deemed guilty of perjury, and on conviction thereof before the Supreme Court of Criminal Justice shall be subjected to the pains and penalties imposed on persons guilty of willful and corrupt perjury.

26. *Summonses to be served by the provost-marshal.* All summonses and orders of the Governor and Court of Policy, granted in any of such proceedings as aforesaid, shall be served and executed by provost-marshal of the colony, or his lawful deputy, and for the making and serving of each copy of any such summons or order the provost-marshal shall be allowed to charge the sum of fifty cents, and no more, and for traveling expenses or distance money the fees chargeable by the marshal under ordinance No. 27 of the year 1855, and the costs of procuring the attendance of every such witness shall be borne by the party requiring him to be summoned, unless the Governor and Court of Policy shall otherwise direct.

27. *Register of patents to be kept.* There shall be kept at the Registrar's office aforesaid, a book or books, to be called the "Register of Patents," which shall be kept alphabetically indexed, and wherein shall be entered and recorded in chronological order all letters patent granted or filed under this ordinance (and nothing contained in section 24 of ordinance No. 3 of 1860, shall extend or

apply to any such letters patent), all provisional specifications after the term of the provisional protection of the invention has expired, all complete specifications, disclaimers and memoranda of alterations entered in respect of such letters patent, all amendments in such letters patent and specifications, all assignments of such letters patent, or of any share or interest therein, all confirmations and extensions of such letters patent, the expiry, vacating or cancelling of such letters patent, with the dates thereof, respectively, and all other matters and things affecting the validity of such letters patent as the government secretary may direct: and such register, on payment of the fee hereinafter provided, shall be open at all convenient times to the inspection of the public, subject to such regulations as the Supreme Court may make.

28. *In suits for infringement, particulars to be delivered.* In any suit for the infringement of letters patent the plaintiff shall deliver, with his claim and demand, particulars of the breaches complained of in the said suit, and the defendant, on pleading thereto, shall deliver with his pleading, and the plaintiff, in any proceedings to have declared void letters patent granted under this ordinance, shall deliver with his claim and demand, particulars of any objections on which he means to rely at the trial in support of the defense in the said suit or of the averments in the said claim and demand in the proceedings to have declared void such letters patent respectively; and at the trial of such suit or proceeding no evidence shall be allowed to be given in support of any alleged infringement, or of any objection impeaching the validity of such letters patent, which shall not be contained in the particulars delivered as aforesaid: Provided always, that the place or places at or in which, and in what manner, the invention is alleged to have been used or published prior to the date of the letters patent shall be stated in such particulars; provided also that it shall and may be lawful for any judge of the Supreme Court to allow such plaintiff or defendant, respectively, to amend the particulars delivered as aforesaid upon such terms as to such judge shall seem fit; provided also, that at the trial of any proceeding to have letters patent declared void the defendant shall be entitled to begin and to give evidence in support of such letters patent, and in case evidence shall be adduced on the part of the plaintiff impeaching the validity of such letters patent, the defendant shall be entitled to the reply.

29. *Supreme Court or chief justice may grant an interdict.* In any suit for the infringement of letters patent, it shall be lawful

for the Supreme Court or chief justice in non-session, on the application of the plaintiff or defendant, respectively, to make such order for an interdict, inspection, or account, and to give such directions respecting such suit, interdict, inspection, and account, and the proceedings therein respectively, as to such court or chief justice may seem fit.

30. *Particulars to be regarded in taxation.* In taxing the costs in any suit, after the taking effect of this ordinance, for infringing letters patent, regard shall be had to the particulars delivered in such suit, and the plaintiff and defendant, respectively, shall not be allowed any costs in respect of any particular, unless certified by the court or judge before whom the trial was had to have been proved by such plaintiff or defendant, respectively, without regard to the general costs of the cause : and it shall be lawful for the court or judge before whom any such suit shall be tried to certify on the record that the validity of the letters patent in the claim and demand mentioned came in question, and the record with such certificate being given in evidence in any suit or action for infringing the said letters patent, or in any proceeding to have the letters patent declared void, shall entitle the plaintiff in any such suit or action, or the defendant in such proceeding, on obtaining a final sentence, to his full costs, charges, and expenses, taxed as between attorney and client, unless the court or judge trying such action or proceeding shall certify that the plaintiff or defendant, respectively, ought not to have such full costs.

31. *Copies of Official Gazette, and certified copies of letters patent, &c., to be evidence.* Copies of the Official Gazette containing all notices and other matters required by this ordinance to be inserted therein, and copies certified and signed by the registrar of all letters patent granted under this ordinance, and of all specifications, disclaimers, memoranda of alterations, and all other documents recorded, deposited, or entered in his office under this ordinance, shall be received in evidence in all proceedings relating to letters patent for inventions in all courts whatsoever within this colony without further proof or production of the originals.

32, 33. [Omitted because relating only to patents existing when the law took effect.]

34. *Solicitor-general to act in case of absence or inability of attorney-general.* In case of the absence or inability to act of the attorney-general, the duties of his office may, for all the purposes

of this ordinance, be discharged, and the fees in respect thereof received by the solicitor-general.

35. Fees and stamp duties on patent to be as in schedule A. There shall be paid in respect of letters patent applied for or issued as herein mentioned, the filing of complete specifications and disclaimers, reports, certificates, entries, inspections, and searches, and other matters and things mentioned in the schedule A to this ordinance, such fees and stamp duties as are mentioned in the said schedule and no other; and all fees and stamp duties by such schedule made payable at the office of the government secretary shall accrue due, and be paid to Her Majesty for the use of the colony and in support of the government thereof.

36. Nothing to affect prerogative of Crown. Nothing herein contained shall extend to abridge or affect the prerogative of the crown in relation to the granting or withholding the grant of any letters patent whatever, or the terms, restrictions, conditions, or provisos thereof.

37. Forms in schedule B may be used. The several forms in the schedule B. to this ordinance annexed may be used for and in respect of the several matters therein mentioned, and the Governor may, with the approval of the Court of Policy, cause to be varied such forms as occasion may require.

38. Interpretation clause. In the construction of this ordinance, the following expressions shall have the meanings hereby assigned to them, unless such meanings be repugnant to or inconsistent with the context (that is to say):

The expression "United Kingdom" shall mean the United Kingdom of Great Britain and Ireland;

The expression "invention" shall mean any manner of new manufacture, the subject of letters patent, and grant of privilege within the meaning of the Act of Parliament of the twenty-first year of the reign of King James the First, chapter three:

The expressions "petition," "affidavit," "provisional specification," "letters patent" and "complete specification" respectively shall mean instruments in form and to the effect in the schedule B hereto annexed, subject to such alterations as may from time to time be made therein under the powers and provisions of this ordinance.

39. Short title. In citing this ordinance in other ordinances, instruments, and proceedings, it shall be sufficient to use the expression "The Patent Law Ordinance, 1861."

40. Commencement of ordinance. This ordinance shall come into operation and take effect on the publication thereof.

And that no ignorance may be pretended of this our ordinance, these presents shall be printed and published in the customary manner.

SCHEDULE A.

Fees to be paid at the attorney-general's office.

On examining provisional specification, to be paid on filing petition.....	\$25	0
On reporting on application for letters patent after notice to proceed.....	25	0
On giving notice of disclaimer or alteration	25	0
On entering caveat.....	25	0

Stamp duties to be paid at the government secretary's office.

On notice to proceed.....	5	0
On the sealing of letters patent.....	20	0
On the letters patent or a duplicate thereof before the expiration of the seventh year.....	100	0
On petition for confirmation or prolongation of patent.....	50	0
On the sealing of grant confirming or prolonging letters patent.....	100	0

Fees to be paid at the registrar's office.

On recording letters patent.....	5	0
On depositing complete specification, including copy	15	0
On entering disclaimer or alteration, including copy and notification in the Official Gazette.....	10	0
On entering caveat, including copy and notification in the Official Gazette	10	0
For copy of any of the before-mentioned documents, or of any provisional specification deposited, per page.....	0	25
On inspecting register of patents, for each patent, and all documents connected therewith.....	0	48

N. B.—For copies of drawing attached to specifications, the registrar to be allowed to charge extra, subject to the approval of the chief justice.

SCHEDULE B.

FORMS.

Petition.

To His Excellency [*here insert the name of the Governor*] Governor and Commander-in-Chief, in and over the colony of British Guiana, Vice-Admiral and Ordinary of the same, &c., &c., &c.

The humble petition of [*name of the petitioner*] respectfully sheweth,—

That your petitioner is in possession of an invention for [*the title of the invention*], which invention he believes will be of great public utility; that he is the true and

first inventor thereof ; and that the same is not in use by any other person or persons in this colony, to the best of his knowledge and belief.

Your petitioner, therefore, humbly prays,—

That your Excellency will be pleased to grant unto him, his heirs, executors, administrators, and assigns, letters patent, in the name of Her Majesty, for the sole use, benefit and advantage of his said invention, within the colony of British Guiana, for the term of fourteen years, pursuant to the ordinance in that case made and provided.

And your petitioner will ever pray, &c.

Affidavit.

I , of , having been duly sworn, make oath and say, that I am in possession of an invention for [*the title as in petition*], which invention I believe will be of great public utility ; that I am the true and first inventor thereof ; and that the same is not in use by any other person or persons in this colony, to the best of my knowledge and belief. A. B.

Sworn this day of , A. D. , before me, .
A commissioner for administering
oaths to affidavits, &c.

Provisional Specification.

I do hereby declare the nature of the said invention [*the title of the invention*] to be as follows : [*here insert description*].

Dated this day of A. D. .
(*To be signed by petitioner or his agent.*)

Letters Patent.

By His Excellency [*name of Governor*], Governor and Commander-in-Chief [L. S.] in and over the colony of British Guiana, Vice-Admiral and Ordinary of the same, &c., &c., &c.

To all to whom these presents shall come, greeting :

Whereas hath, by his petition, humbly represented unto me that he is in possession of an invention for which the petitioner conceives will be of great public utility ; that he is the true and first inventor thereof ; and that the same is not in use by any other person or persons in this colony, to the best of his knowledge and belief ; the petitioner therefore most humbly prayed that I would be pleased to grant unto him, his heirs, executors, administrators and assigns, letters patent in the name of Her Majesty, for the sole use, benefit, and advantage of his said invention, within the colony of British Guiana, for the term of fourteen years, pursuant to the ordinance in such case made and provided ; Know ye, therefore, that I, in the name and on the behalf of Her most Gracious Majesty the Queen, and being thereto duly authorized by the ordinance in such case made and provided, do by these presents, give and grant unto the said , his heirs, executors, administrators, and assigns, my special license, full power, sole privilege and authority that he, the said , his heirs, executors, administrators, and assigns, and every of them, by himself and themselves, or by his and their deputy or deputies, servants, or agents, or such others as he, the said , his heirs,

executors, administrators, or assigns, shall at any time agree with, and no others, from time to time, and at all times hereafter during the term of years herein expressed, shall and lawfully may make, use, exercise, and vend his said invention within the colony of British Guiana, in such manner as to him the said , his heirs, executors, administrators, and assigns, or any of them, shall in his or their discretion, seem meet ; and that he, the said , his heirs, executors, administrators, and assigns, shall and lawfully may have and enjoy the whole profit, benefit, commodity, and advantage from time to time coming, growing, accruing and arising, by reason of the said invention for and during the term of years herein mentioned ; to have, hold, exercise, and enjoy the said licenses, powers, privileges, and advantages hereinbefore granted or mentioned to be granted, unto the said , his heirs, executors, administrators, and assigns, for and during, and unto the full end and term of fourteen years from the day of in the year of our Lord one thousand eight hundred and next and immediately ensuing, according to the ordinance in such case made and provided ; and to the end that he, the said , his heirs, executors, administrators, and assigns, and every of them, may have and enjoy the full benefit and the sole use and exercise of the said invention, I do, by these presents, require and strictly command all and every person and persons, bodies politic and corporate, and all others, of what estate, quality, degree, name, or condition soever they be, within this colony, that neither they, nor any of them, at any time during the continuance of the said term of fourteen years hereby granted, either directly or indirectly, do make, use, or put in practice the said invention, or any part of the same, nor in any wise counterfeit, imitate, or resemble the same, nor shall make or cause to be made any addition thereunto, or subtraction from the same, whereby to pretend himself or themselves the inventor or inventors, deviser or devisors thereof, without the consent, license, or agreement of the said , his heirs, executors, administrators, or assigns, in writing under his or their hands first had and obtained in that behalf, upon such pains and penalties as can or may be justly inflicted on such offenders for their contempt, and further not be answerable to the said , his heirs, executors, administrators, and assigns, according to law, for his and their damages thereby occasioned : Provided always, and these letters patent are and shall be upon this condition, that if at any time during the said term hereby granted, it shall be made to appear to the Honorable the Supreme Court of Civil Justice of this colony, that this grant is contrary to law, or prejudicial or inconvenient to Her Majesty's subjects in general, or that the said invention is not a new invention as to the public use and exercise thereof, or that the said is not the true and first inventor thereof within this colony as aforesaid, these letters patent shall forthwith cease, determine, and be utterly void to all intents and purposes, anything herein contained to the contrary thereof in anywise notwithstanding : Provided also, that these letters patent, or anything hereinbefore contained, shall not extend or be construed to extend to give privilege unto the said , his heirs, administrators or assigns, or any of them, to use or imitate any invention or work whatsoever, which hath heretofore been found out or invented by any other of Her Majesty's subjects whatsoever, and publicly used or exercised in this colony, unto whom like letters patent or privileges have been already granted in this colony for the sole use, exercise, and benefit thereof, it being my will and pleasure that the said , his heirs, executors, administrators and assigns, and all and every other person and persons to whom like letters patent or privileges have been already granted as aforesaid, shall distinctly

use and practice their several inventions by them invented and found out, according to the true intent and meaning of the same respective letters patent, and of these presents: Provided likewise nevertheless, and these letters patent are upon this express condition, that if the said shall not record these letters patent in the registrar's office for the counties of Demerara and Essequibo within ten days from the date of these presents, and also if the said shall not particularly describe and ascertain the nature of his said invention, and in what manner the same is to be performed, by an instrument in writing under his hand, and cause the same to be deposited in the office of the said registrar within six calendar months next and immediately after the date of these letters patent, and also if the said instrument in writing, deposited as aforesaid, does not particularly describe and ascertain the nature of the said invention, and in what manner the same is to be performed, and also if the said , his heirs, executors, administrators, or assigns, shall not supply or cause to be supplied for Her Majesty's service in this colony, all such articles of the said invention as he or they shall be required to supply by the officers administering the department of Her Majesty's service in this colony, for the use of which the same shall be required, in such manner, at such times, and at and upon such reasonable prices and terms as shall be settled for that purpose by the Governor of this colony, and also if the said , his heirs, executors, administrators, or assigns, shall not pay or cause to be paid at the office of the government secretary, the sum of one hundred dollars stamp duty, on or before the day of , A. D., that then and in any of the said cases, these letters patent, and all liberties and advantages whatsoever hereby granted, shall utterly cease, determine and become void, anything hereinbefore contained to the contrary thereof in anywise notwithstanding: provided that nothing herein contained shall prevent the granting of licenses in such manner and for such considerations as they may by law be granted: And lastly, I do by these presents, in the name and on the behalf of Her Majesty, grant unto the said , his heirs, executors, administrators, and assigns, that these letters patent, or the filing thereof, shall be in and by all things good, firm, valid, sufficient, and effectual in the law, according to the true intent and meaning thereof, and shall be taken, construed, and adjudged in the most favorable and beneficial sense for the best advantage of the said , his heirs, executors, administrators, and assigns, in all courts of record as well as elsewhere in this colony, and by all and singular the officers and ministers whatsoever of Her Majesty, and amongst all and every the subjects of Her Majesty in this colony, notwithstanding the not full and certain describing the nature or quality of the said invention, or of the materials thereunto conducing and belonging.

In witness whereof I have caused these letters to be made patent this
 day of A. D. and to be sealed and bear date as of the said
 day of A. D., in the year of Her Majesty's reign.

Specification.

To all to whom these presents shall come, I , of , send greeting.

Whereas His Excellency [*Governor's name*], Governor and Commander-in-Chief in and over the colony of British Guiana, &c., &c., &c., by letters patent, bearing date the day of , in the year of our Lord one thousand eight hundred and

, in the year of Her Majesty's reign, did, in the name of Her Majesty, pursuant to the ordinance in such case made and provided, give and grant unto me, the said , his special license, that I, the said , my heirs, executors, administrators, and assigns, or such others as I, the said , my heirs, executors, administrators and assigns, should at any time agree with, and no others, from time to time, and at all times thereafter, during the term therein expressed, should, and lawfully might make, use, exercise, and vend within the colony of British Guiana, an invention for [*insert title as in letters patent*] upon the condition (amongst others) that I, the said , by an instrument in writing under my hand, should particularly describe and ascertain the nature of the said invention, and in what manner the same was to be performed, and cause the same to be deposited in the registrar's office for the counties of Demerara and Essequibo, within six calendar months next and immediately after the date of the said letters patent: Now know ye, that I, the said , do hereby declare the nature of my said invention, and in what manner the same is to be performed, to be particularly described and ascertained in and by the following statement; (that is to say) [*describe the invention*].

In witness whereof I, the said , have hereto set my hand, this day
of A. D. , in the presence of the subscribing witnesses.

From Carpm. Pat. L. of World, 55.

BRITISH HONDURAS.

An Act for amending the Law for granting Patents for Inventions. September 10, 1862; 26^o Victoriæ, Sessio 1^a, cap. II.

WHEREAS it is expedient to amend the law concerning Letters Patent for inventions: Be it enacted by the Lieutenant Governor, by and with the advice and consent of the Legislative Assembly, as follows:

I. *Commissioners of patents.* The Lieutenant Governor and the members of the Executive Council for the time being respectively, together with such other person or persons as may be from time to time appointed by the Lieutenant Governor as hereinafter mentioned, shall be commissioners of patents for inventions; and it shall be lawful for the Lieutenant Governor from time to time, by warrant under his hand and seal, to appoint such other person or persons as he may think fit to be a commissioner or commissioners as aforesaid; and every person so appointed shall be a commissioner during Her Majesty's pleasure; and all the powers hereby vested in the commissioners may be exercised by any three or more of them, two members of the Executive Council being two of them.

II. *Authentication of documents and copies.* Three or more of such commissioners, of whom two shall be members of the Executive Council, shall subscribe their names to all warrants for letters patent under this Act, and all instruments proceeding from the office of the commissioners; and all copies or extracts from documents deposited in the commissioners' office shall be certified by the clerk of the commissioners, and all courts, judges, and other persons in this colony shall take notice of and receive the signatures of such commissioners in evidence, and shall also take notice of and receive in evidence, without further proof or production of the originals, all copies or extracts, certified under the hand of the said commissioners' clerk, of or from documents deposited in such office.

III. *Power of commissioners to make rules and regulations.* It shall be lawful for the commissioners from time to time to make such rules and regulations (not inconsistent with the provisions of this Act), respecting the business of their office, and all matters and things which under the provisions herein contained are to be under

their control and direction, as may appear to them necessary and expedient for the purposes of this Act ; and all such rules shall be laid before the Legislative Assembly within fourteen days after the making thereof, if the General Assembly be sitting in annual session, and if it be not sitting in annual session, then within fourteen days after the next meeting of the General Assembly in annual session ; and in the meantime, and until the commissioners shall make such rules and regulations, those contained in the schedule annexed to this Act shall be observed.

IV. *Colonial secretary's office to be the office of the commissioners, and he their clerk.* The office the colonial secretary shall be the office of the commissioners for the filing of specifications, and the office of the colonial secretary and the office of clerk of the commissioners shall be combined ; and the colonial secretary for the time being shall be the clerk of the commissioners for the purposes of this Act.

V. *Petition and declaration, specification.* Every petition for the grant of letters patent for an invention, and the declaration required to accompany such petition, shall be left at the office of the colonial secretary, and there shall be left therewith a statement in writing, hereinafter called the provisional specification, signed by or on behalf of the applicant for letters patent, describing the nature of such invention ; and the day of the delivery of every such petition, declaration, and provisional specification, shall be recorded at the said office, and indorsed on such petition, declaration, and provisional specification, and a certificate thereof given to such applicant or his agent ; and all such petitions, declarations, and provisional specifications shall be preserved in such manner as the commissioners may direct, and a registry thereof, and of all proceedings thereon, kept at the office of the colonial secretary.

VI. *Applications to be referred to attorney-general.* Every application for letters patent made under this Act shall be referred by the commissioners, according to such regulations as they may think fit to make, to Her Majesty's attorney-general for this colony.

VII. *Provisional specifications to be referred to attorney-general, who may give certificate.* The provisional specification shall be referred to the attorney-general, who shall be at liberty to call to his aid such scientific or other person as he may think fit, and cause to be paid to such person by the applicant such remuneration as the attorney-general shall appoint ; and if the attorney-general be satisfied that the provisional specification describes the nature of

the invention, he shall allow the same, and give a certificate of his allowance, and such certificate shall be filed in the office of the colonial secretary, and thereupon the invention therein referred to may, during the term of six months from the date of the application for letters patent for the said invention, be used and published without prejudice to any letters patent to be granted for the same, and such protection from the consequences of use and publication is hereinafter referred to as a provisional protection: Provided always, that in case the title of the invention or the provisional specification be too large or insufficient, it shall be lawful for the attorney-general to allow or require the same to be amended.

VIII. *Inventor may deposit a complete specification to confer rights.* The applicant for letters patent for an invention, instead of leaving with the petition and declaration a provisional specification as aforesaid, may, if he thinks fit, file with the said petition and declaration an instrument in writing under his hand and seal (hereinafter called a complete specification), particularly describing and ascertaining the nature of the said invention, and in what manner the same is to be performed, which complete specification shall be mentioned in such declaration, and the day of the delivery of every such petition, declaration, and complete specification, shall be recorded at the office of the colonial secretary, and indorsed on such petition, declaration, and specification, and a certificate thereof given to such applicant or his agent, and thereupon, subject and without prejudice to the provisions hereinafter contained, the invention shall be protected under this Act for the term of six months from the date of the application, and the applicant shall have during such term of six months the like powers, rights, and privileges as might have been conferred upon him by letters patent for such invention, issued under this Act and duly sealed as of the day of the date of such application; and during the continuance of such powers, rights, and privileges under this provision, such invention may be used and published without prejudice to any letters patent to be granted for the same; and where letters patent are granted in respect of such invention, then in lieu of a condition for making void such letters patent in case such invention be not described and ascertained by a subsequent specification, such letters patent shall be conditioned to become void if such complete specification, filed as aforesaid, does not particularly describe and ascertain the nature of the said invention, and in what manner the same is to be performed; and a copy of every such complete specification shall be open to the

inspection of the public, as hereinafter provided, from the time of depositing the same, subject to such regulations as the commissioners may make.

IX. Patent not to be invalidated by protection in fraud. In case of any application for letters patent for any invention, and the obtaining upon such application of provisional protection for such invention, or of protection for the same by reason of the deposit of a complete specification as aforesaid, in fraud of the true and first inventor, any letters patent granted to the true and first inventor of such invention shall not be invalidated by reason of such application, or of such provisional or other protection as aforesaid, or of any use or publication of the invention subsequent to such application, and before the expiration of the term of such provisional or other protection.

X. Commissioners to cause protections to be advertised. Where any invention is provisionally protected under this Act, or protected by reason of the deposit of such complete specification as aforesaid, the commissioners shall cause such provisional protection or such other protection as aforesaid to be advertised in such manner as they may see fit.

XI. Application to be advertised, particulars of opposition. The applicant for letters patent, so soon as he may think fit after the invention shall have been provisionally protected under this Act, or where a complete specification has been deposited with his petition and declaration, then so soon as he may think fit after such deposit, may give notice at the office of the colonial secretary of his intention of proceeding with his application for letters patent for the said invention, and thereupon the said commissioners shall cause his said application to be advertised in such manner as they may see fit ; and any persons having an interest in opposing the grant of letters patent for the said invention shall be at liberty to leave particulars in writing of their objections to the said application at such place, and within such time, and subject to such regulations as the commissioners may direct.

XII. Specification and objections to be referred to attorney-general. So soon as the time for the delivery of such objections shall have expired, the provisional specification, or the complete specification (as the case may be) and particulars of objection (if any) shall be referred to the attorney-general.

XIII. Power of attorney-general to order costs. It shall be lawful for the attorney-general, if he see fit, by certificate under his

hand, to order by or to whom the costs of any hearing or inquiry upon any objection, or otherwise in relation to the grant of such letters patent, or in relation to the provisional (or other) protection acquired by the applicant under this Act shall be paid, and in what manner and by whom such costs are to be ascertained; and if any costs so ordered to be paid be not paid within fourteen days after the amount shall be so ascertained, it shall be lawful for the attorney-general to make an order for the payment of the same, and any such order may be made a rule of the Supreme Court to the effect that execution may pass thereupon in common form.

XIV. *Power of attorney-general to warrant sealing patent.—Lieutenant governor to have discretion granting.—Scire facias.* It shall be lawful for the attorney-general, after such hearing (if any) as he may think fit, to cause a warrant to be made for the sealing of letters patent for the said invention, and such warrant shall be signed by three of the said commissioners, of whom two shall be members of the Executive Council, and shall set forth the tenor and effect of the letters patent thereby recommended to be granted, and shall direct the insertion in such letters patent of all restrictions, conditions, and provisos as he may deem usual and expedient in such grants, or necessary in pursuance of the provisions of this Act; and the said warrant shall be the warrant for the making and sealing of letters patent under this Act, granting to the applicant, his executors, administrators, and assigns, for a term not exceeding fourteen years, the sole right and liberty of making, using, exercising, and vending the said invention according to the tenor of the said warrant: Provided always, that the Lieutenant Governor shall and may have and exercise a discretion in respect of the said warrant, and any letters patent thereby proposed to be made under this Act; and the writ of scire facias shall lie for the repeal of any letters patent issued under this Act in the like cases as the same would lie in England for the repeal of letters patent issued under the Great Seal of the United Kingdom of Great Britain and Ireland.

XV. *Patent to be avoidable on non-payment of certain sums.* All letters patent for inventions granted under the provisions hereinbefore contained, shall be made subject to the condition that the same shall be void, and that the powers and privileges thereby granted shall cease and determine at the expiration of three years and seven years respectively from the date thereof, unless there be paid before the expiration of the said three and seven years respec-

tively the sum or sums of money in the schedule to this Act annexed; and the payment of the said sums of money shall be indorsed on the warrant for the said letters patent, and the colonial secretary shall issue under his hand a certificate of such payment, and shall indorse a receipt for the same on any letters patent issued on such warrant, and such certificate or payment shall be evidence of the payment of the several sums respectively.

XVI. *Patent under public seal to be valid in the colony.* The commissioners, so soon after the signing of the said warrant as required by the applicant for the letters patent, shall cause to be prepared letters patent for the invention according to the tenor of the said warrant, and it shall be lawful for the lieutenant governor to cause such letters patent to be sealed with the public seal of the colony, and such letters patent so sealed shall extend to the whole of the Colony of British Honduras.

XVII. *No patent to be issued after three months from date of warrant.* Provided always, that no letters patent, save as hereinafter mentioned in the case of letters patent destroyed or lost, shall issue on any warrant granted as aforesaid, unless application be made for the issue of such letters patent within three months after the date of the said warrant.

XVIII. *No patent to be issued after expiration of protection given by this Act.* Provided also, that no letters patent (save letters patent issued in lieu of others destroyed or lost) shall be issued or be of any force or effect unless the same be granted during the continuance of the provisional protection under this Act, or where a complete specification has been deposited under this Act, then unless such letters patent be granted during the continuance of the protection conferred under this Act by reason of such deposit, save that where the application to seal such letters patent has been made during the continuance of such provisional or other protection as aforesaid, and the sealing of such letters patent has been delayed by reason of any caveat or on application to the lieutenant governor against or in relation to the sealing of such letters patent, then such letters patent may be sealed at such time as the lieutenant governor shall direct.

XIX. *Patent may be granted to personal representative.* Provided also, that where the applicant for such letters patent dies during the continuance of the provisional protection, or the protection by reason of the deposit of a complete specification (as the case may be), such letters patent may be granted to the executors or admin-

istrators of such applicant during the continuance of such provisional or other protection, or at any time within three months after the death of such applicant, notwithstanding the expiration of the term of such provisional or other protection, and the letters patent so granted shall be of the like force and effect as if they had been granted to such applicant during the continuance of such provisional or other protection.

XX. *If patent destroyed or lost, other may be issued.* Provided also, that in case any such letters patent shall be destroyed or lost, other letters patent of the like tenor and effect, and sealed and dated as of the same day, may, subject to such regulations as the commissioners may direct, be issued under the authority of the warrant in pursuance of which the original letters patent were issued.

XXI. *Patent may be dated as of the day of application.* It shall be lawful to cause any letters patent to be issued in pursuance of this Act to be sealed and bear date as of the the day of the application for the same.

XXII. *Patent ante-dated.* Any letters patent issued under this Act, sealed and bearing date as of any day prior to the day of the actual sealing thereof, shall be of the same force and validity as if they had been sealed on the day as of which the same are expressed to be sealed and bear date: Provided always that, save where such letters patent are granted for any invention in respect whereof a complete specification has been deposited upon the application for the same under this Act, no proceeding at law or in equity shall be had upon such letters patent in respect of any infringement committed before the same were actually granted.

XXIII. *Patent for patented foreign inventions.* Where upon any application made after the passing of this act, letters patent are granted in this colony for or in respect of any invention first invented in the United Kingdom of Great Britain and Ireland, or in any foreign country, or in any other British colony, or by the subject of any foreign power or state, and a patent or like privilege for the monopoly or exclusive use or exercise of such invention in the United Kingdom of Great Britian and Ireland, or in any foreign country, or in any other British colony is there obtained, before the grant of such letters patent in this colony, all rights and privileges under such letters patent shall (notwithstanding any term in such letters patent limited) cease and be void immediately upon the expiration or other determination of the term during which the patent or like privilege obtained in the United Kingdom, such foreign

country, or other British colony (as the case may be) shall continue in force, or where more than one such patent or like privilege is obtained abroad, immediately upon the expiration or determination of the term which shall first expire or be determined of such several patents or like privileges: Provided always, that no letters patent for or in respect of any invention for which any such patent or like privilege as aforesaid shall have been obtained in the United Kingdom of Great Britain and Ireland, in any foreign country, or in any other British colony, and which shall be granted in this colony after the expiration of the term for which such patent or privilege was granted or was in force, shall be of any validity.

XXIV. *Patent not to prevent use of inventions on board ships.* No letters patent for any invention shall extend to prevent the use of such invention in any ship or vessel not registered in British Honduras, or for the navigation of any ship or vessel not registered in British Honduras which may be in any port of this colony, or any of the waters within the jurisdiction of the courts of this colony, where such invention is not so used for the manufacture of any goods or commodities to be vended within or exported from the colony: Provided always, that this enactment shall not extend to the ships or vessels of any foreign state of which the laws authorize the subjects of such foreign state, having patents or like privileges for the exclusive use or exercise of inventions within its territories, to prevent or interfere with the use of such inventions in British ships or vessels while in the ports of such foreign state, or in the waters within the jurisdiction of its courts, where such inventions are not so used for the manufacture of goods and commodities to be vended within or exported from the territories of such foreign state.

XXV. *Specifications to be filed—Enrollment not necessary.* All letters patent to be granted under this Act (save only letters patent granted after the filing of a complete specification) shall require the specification thereunder to be filed in the colonial secretary's office, instead of requiring the same to be enrolled, and no enrollment shall be requisite.

XXVI. *Specification to be preserved in Secretary's office.* Every specification to be filed in pursuance of the condition of any letters patent shall be filed in the colonial secretary's office, and every provisional specification and complete specification left at the office of the colonial secretary, on the application for any letters patent, shall forthwith after the grant of the letters patent, or if no letters patent be granted, then immediately after the expiration of

six months from the time of such application, be filed and preserved in the said office ; and in case reference is made to drawings in any specification deposited or filed under this Act, an extra copy of such drawings shall be left with such specification.

XXVII. *Copies of specifications to be open to inspection.* The commissioners shall cause true copies of all specifications (other than provisional specifications), disclaimers, and memoranda of alterations filed under or in pursuance of this Act, and of all provisional specifications after the term of the provisional protection of the invention has expired, to be open to the inspection of the public at the office of the colonial secretary at all reasonable times, subject to such regulations as the commissioners may direct.

XXVIII. *Register of patents to be kept.* There shall be kept at the colonial secretary's office a book or books to be called the Register of Patents, wherein shall be entered and recorded, in chronological order, all letters patent granted under this Act, the deposit or filing of specifications, disclaimers, and memoranda of alterations filed in respect of such letters patent, all amendments in such letters patent and specifications, all confirmations and extensions of such letters patent, the expiry, vacating, or canceling of such letters patent, with the dates thereof respectively, and all other matters and things affecting the validity of such letters patent as the commissioners may direct ; and such register, or a copy thereof, shall be open at all convenient times to the inspection of the public, subject to such regulations as the commissioners may make.

XXIX. *Register of proprietors to be kept.* There shall be kept at the colonial secretary's office a book or books entitled the Register of Proprietors, wherein shall be entered, in such manner as the commissioner shall direct, the assignment of any letters patent, or of any share or interest therein, and any license under letters patent, with the name or names of any person or persons having any share or interest in such letters patent or license, the date of his or their acquiring such letters patent, share and interest, and any other matter or thing relating to or affecting the proprietorship in such letters patent or license ; and a copy of any entry in such book, certified under the hand of the colonial secretary, shall be given to any person requiring the same, on payment of the fees hereinafter provided ; and such copies, so certified, shall be received in evidence in all courts and in all proceedings, and shall be *prima facie* proof of the assignment of such letters patent, or share and interest therein, or of the license or proprietorship as therein expressed : Provided

always, that until such entry shall have been made, the grantee or grantees of the letters patent shall be deemed and taken to be the sole and exclusive proprietor or proprietors of such letters patent of all the licenses and privileges thereby given and granted; and any writ of scire facias to repeal such letters patent may be issued to the provost marshal in case of the grantee or grantees residing in this colony, and in case such grantee or grantees do not reside in the colony, it shall be sufficient to file such writ in the clerk of the court's office, and serve notice in writing thereof at the last known residence or place of business of such grantee or grantees; and such register, or a copy, shall be open to the inspection of the public at the colonial secretary's office, subject to such regulations as the commissioners may make.

XXX. *Falsification or forgery of entries in Registers.* If any person shall willfully make or cause to be made any false entry in the said register of proprietors, or shall willfully make or forge, or cause to be made or forged, any writing falsely purporting to be a copy of any entry in the said book, or shall produce or tender, or cause to be produced or tendered, in evidence any such writing knowing the same to be false or forged, he shall be guilty of a misdemeanor, and shall be punished by fine and imprisonment accordingly.

XXXI. *Entries may be expunged or varied.* If any person shall deem himself aggrieved by any entry made under color of this Act in the said register of proprietors, it shall be lawful for such person to apply by motion to the Supreme Court, or by a summons to the chief justice in chambers, for an order that such entry may be expunged, vacated, or varied; and upon any such application the said court or chief justice respectively may make such order for expunging, vacating, or varying such entry and as to the costs of such application, as to the said court or chief justice may seem fit; and the colonial secretary, on the production to him of any such order for expunging, vacating, or varying any such entry, shall expunge, vacate, or vary the same according to the requisitions of such order.

XXXII. *Disclaimers, and memoranda of alterations.* Any person who, as grantee, assignee, or otherwise, shall obtain letters patent for the sole making, exercising, vending, or using of any invention, and in case the original patentee or patentees hath or have departed with his or their whole or any part of his or their interest by assignment to any other person or persons, such patentee, together with such assignee or assignees, if part only hath been

assigned, and the assignee or assignees, if the whole hath been assigned, may, if he or they think fit, lodge with the colonial secretary an application for leave to enter a disclaimer of any part of either the title of the invention or of the specification, stating the reason of such disclaimer, or to enter a memorandum of any alteration in the said title or specification, not being such disclaimer or such alteration as shall extend the exclusive right granted by the said letters patent ; and all such applications shall be referred by the commissioners to the attorney-general ; and every such disclaimer or memorandum of alteration, when approved by the attorney-general, certified by his fiat and signature, and being filed in the colonial secretary's office with the specification to which the same relates, shall be deemed and taken to be part of such letters patent or such specification in all courts whatever : Provided always, that any person may lodge with the said colonial secretary a caveat against such disclaimer or alteration, and every such caveat shall be referred by the commissioners to the attorney-general ; and such caveat, being so entered, shall give the party entering the same a right to have notice of the application being heard by the attorney-general : Provided also, that no such disclaimer or alteration shall be receivable in evidence in any action or suit (save and except by any proceeding by scire facias) pending at the time when such disclaimer or alteration was filed ; but in every such action or suit the original title and specification alone shall be given in evidence and deemed and taken to be the title and specification of the invention for which the letters patent shall have been granted : Provided also, that it shall be lawful for the attorney-general, before granting such fiat, to require the party applying for the same to advertise his disclaimer or alteration, in such manner as to the attorney-general shall seem right, and shall, if he so require such advertisement, certify in his fiat that the same has been duly made : Provided also, that such filing of any disclaimer or memorandum of alteration in pursuance of the leave of the attorney-general, certified as aforesaid, shall, except in cases of fraud, be conclusive of the right of the party to enter such disclaimer or memorandum of alteration ; and no objection shall be allowed to be made in any proceeding upon or touching such letters patent, specification, disclaimer, or memorandum of alteration, on the ground that the party entering such disclaimer or memorandum of alteration had not sufficient authority in that behalf : Provided also, that no action shall be brought upon any letters patent in which, or in the specification

of which, any disclaimer or memorandum of alteration shall have been filed, in respect of any infringement committed prior to the filing of such disclaimer or memorandum of alteration, unless the attorney-general shall certify in his fiat that any such action may be brought notwithstanding the entry or filing of such disclaimer or memorandum of alteration.

XXXIII. *Prolongation of term of patent.* If the grantee of any letters patent as aforesaid shall advertise, in such manner as the commissioners may direct, that he intends to apply to the commissioners for a prolongation of his term of sole using and vending his invention, and shall enter with the colonial secretary a petition addressed to the lieutenant governor to that effect, it shall be lawful for any person to enter a caveat against the same with the colonial secretary; and, notice being first given, to any person or persons who shall have entered such caveats, the petitioner shall be heard in person, or by his counsel or agent and witnesses, to prove his case, and the persons entering caveats shall likewise be heard in person, or by their counsel or agents and witnesses, whereupon, and upon hearing and inquiring of the whole matter, the commissioners are hereby authorized and empowered, if they shall think fit, to authorize to issue their warrant for the grant of new letters patent for the said invention for a term not exceeding seven years or any shorter period than that prayed, after the expiration of the first term: Provided always, that no such extension shall be granted if a petition for the same shall not have been presented before the expiration of the term sought to be extended.

XXXIV. *Commissioners may warrant extensions.* If in any petition for the extension of the term for which the letters patent as aforesaid have been granted, presented before the expiration thereof, it be set forth that the grantee thereof has been unable to obtain a due remuneration for his expense and labor in perfecting such invention, and that an exclusive right of using and vending the same for the further period of seven years in addition to the term in such patent mentioned will not suffice for his reimbursement and remuneration, then upon consideration of the same in manner aforesaid the commissioners may, if they think fit, grant their warrant for the extension thereof for a term not exceeding fourteen years, or any shorter period than that prayed, after the expiration of such first term.

XXXV. *Grant of new letters patent, extending period.* It shall be lawful to grant any such extension either to an assignee or

assignees, or to the original patentee or patentees or to an assignee or assignees and original patentee or patentees conjointly.

XXXVI. *Warrant and sealing such letters patent.* In the granting of any new letters patent, extending the term for which the original letters patent were granted, the warrant of the commissioners shall be a sufficient authority for the sealing of any new letters patent, and for the insertion in such new letters patent of any restrictions, conditions, and provisions in the said warrant mentioned; and the lieutenant governor shall thereupon cause letters patent, according to the tenor and effect of such warrant, to be made and sealed in the manner herein directed for letters patent issued under the certificate of the attorney-general and the commissioners' warrant thereupon: Provided always, that such new letters patent shall be sealed and bear date as of the day after the expiration of the term of the original letters patent, which may first expire.

XXXVII. *In action for infringement, particulars to be delivered.* In any action in the Supreme Court for the infringement of letters patent the plaintiff shall, two weeks at least previously to the entering of his complaint, deliver or cause to be delivered to the person against whom such action is intended to be brought, particulars of the breaches intended to be complained of in such action, and the defendant, on pleading or filing any notice of defense thereto, shall deliver with his pleas or notice, and the prosecutor in any proceedings by scire facias to repeal letters patent shall deliver with his declaration, particulars of any objections on which he means to rely at the trial in support of the pleas in said action, or of the suggestions of the said declaration in the proceedings by scire facias respectively; and at the trial of such action or proceeding by scire facias no evidence shall be allowed to be given in support of any alleged infringement, or of any objection impeaching the validity of such letters patent, which shall not be contained in the particulars delivered as aforesaid: Provided always, that the place or places at or in which and in what manner the invention is alleged to have been used or published prior to the date of the letters patent shall be stated in such particulars: Provided also, that it shall and may be lawful for the chief justice at chambers to allow such plaintiff or defendant or prosecutor respectively to amend the particulars delivered as aforesaid, upon such terms as to such judge as shall seem fit: Provided also, that at the trial of any proceeding by scire facias to repeal letters patent the defendant shall be entitled to begin and to give evidence in support of such letters patent, and in

case evidence shall be adduced on the part of the prosecutor impeaching the validity of such letters patent, the defendant shall be entitled to the reply.

XXXVIII. *Supreme Court may grant injunctions.* In any action in the supreme court for the infringement of letters patent, it shall be lawful for the court if then sitting, or if the court be not sitting then for the chief justice, on the application of the plaintiff or defendant respectively, to make such order for an injunction and inspection or account, and to give such directions respecting such injunction, inspection, and account, and the proceedings therein, respectively, as to such court, or chief justice may seem fit.

XXXIX. *Particulars to be regarded in taxation of costs.* In taxing the costs in any action in the Supreme Court regard shall be had to the particulars delivered in such action, and the plaintiff and defendant respectively shall not be allowed any costs in respect of any particular unless certified by the chief justice to have been proved by such plaintiff or defendant respectively, without regard to the general costs of the cause; and it shall be lawful for the chief justice to certify on the record that the validity of the letters patent in the declaration mentioned came in question; and the record with such certificate being given in evidence in any suit or action for infringing the said letters patent, or in any proceeding by scire facias to repeal the letters patent, shall entitle the plaintiff in any such suit or action, or the defendant in such proceeding by scire facias, on obtaining a decree, decretal order, or final judgment, to his full costs, charges, and expenses, taxed as between attorney and client, unless the chief justice shall certify that the plaintiff or defendant respectively ought not to have such full costs.

XL. *Fees and payments in letters patent to be as in schedule.* There shall be paid in respect of letters patent applied for or issued as herein mentioned, the filing of specifications and disclaimers, certificates, entries, and searches, and other matters and things mentioned in the schedule to this Act, such fees as are mentioned in the said schedule; and there shall be made unto and for the use of Her Majesty, her heirs and successors, to be applied to the purposes of the government of this colony, for or in respect of the warrants and certificates mentioned in the said schedule, or the paper on which the same respectively are written, the payments mentioned in the said schedule; and no other fees shall be levied, or payments, except as hereinafter mentioned, taken in respect to

such letters patent and specifications, and the matters and things in such schedule mentioned.

XLI. *Payment of fees to attorney-general and colonial secretary.* Provided always, that nothing herein contained shall prevent the payment to the attorney-general on the investigation of each application, caveat, disclaimer, and memorandum of alterations, including certificate or report, or certificate and report, and in cases of opposition to the granting of letters patent, and to the colonial secretary for office or other copies of documents in his office, and in respect of the additional duties imposed on him by this Act, of the fees fixed in the schedule hereunto annexed.

XLII. *Defrayment of expenses incurred under Act.* It shall be lawful for the Lieutenant Governor and Council to allow from time to time the necessary sums for the defraying the current and incidental expenses by virtue of this Act, and the sums to be so allowed shall be paid out of such moneys as may be provided by the General Assembly for that purpose, or if no moneys be specially provided for them, from any unappropriated moneys in the public treasury.

XLIII. *Forms in schedule may be used.* The several forms in the schedule to this Act may be used for and in respect of the several matters therein mentioned, and the commissioners may, when they think fit, vary such forms where occasion may require, and cause to be printed and circulated such other forms as they may think fit to be used for the purposes of this Act.

XLIV. *Patent granted out of colony.* No letters patent hereafter to be obtained in Great Britain or elsewhere, for the exclusive privilege of any trade or manufacture, or any invention in connection therewith, shall be of any validity or effect in this colony, unless letters patent for the privilege of invention in respect of which such foreign letters patent may have been obtained, shall be granted and issued in pursuance of this Act, nor until all the provisions and requirements of this Act shall have been complied with in respect to letters patent.

XLV. *Interpretation of terms.* In the construction of this Act the following expressions shall have the meanings hereby assigned to them, unless such meanings be repugnant to or inconsistent with the context :

The expression the "commissioners" shall mean the commissioners for the time being acting in the execution of this Act :

The expression "chief justice" shall include any person

appointed to act as chief justice during a vacancy in the office, and any senior or other puisne judge of the Supreme Court acting in the place of the chief justice during his absence or incapacity, and also any person appointed acting chief justice during such absence or incapacity :

The expression "colonial secretary" shall include any person who shall be appointed to act as colonial secretary during any vacancy in the office, and any person appointed to act or acting for such officer during the absence on leave or incapacity of the colonial secretary :

The expression "the attorney-general" shall include any person who shall be appointed to act as attorney-general during any vacancy in the office of attorney-general, and any person appointed to act for the attorney-general during his absence or incapacity :

The expression "invention" shall mean any manner of new manufacture, the subject of letters patent and grant of privilege within the meaning of the Act of the Imperial Parliament passed in the twenty-first year of the reign of King James the First, chapter three, entitled An act concerning monopolies, and dispensations with penal laws and the forfeitures thereof :

The expressions "petition," "declaration," "provisional specification," "warrant," and "letters patent" respectively shall mean instruments in the form and to the effect in the schedule hereto annexed, subject to such alterations as may from time to time be made therein under the powers and provisions of this Act.

XLVI. *Short title.* In citing this Act in other Acts of the Legislature, instruments, and proceedings, it shall be sufficient to use the expression "The Patent Law Amendment Act, 1862."

XLVII. *Operation suspended until confirmation of Act, &c.* This Act shall not come into operation until Her Majesty's gracious allowance and confirmation thereof shall have been communicated to the Legislative Assembly, or made public by proclamation by His Excellency the Lieutenant Governor.

FOREIGN LAWS.

The SCHEDULE to which this Act refers.

FEES to be paid.

1. *To Colonial Secretary.*

	\$	Rls.
On leaving petition for grant of letters patent.....	0	4
On notice of intention to proceed with application.....	0	2
On sealing of letters patent or duplicate.....	5	0
On filing specification.....	0	4
On certificate of payment at or before the expiration of the third year.....	2	0
On certificate of payment at or before the expiration of the seventh year.....	3	0
On leaving notice of objections.....	0	2
Every search or inspection, per hour or less.....	0	2
Entry of assignment or license.....	1	0
Certificate of assignment or license.....	1	0
Filing application for disclaimer.....	0	4
Caveat against disclaimer.....	0	4
Copies of documents, per folio of 90 words.....	0	2
On each certificate on copy.....	0	3
For preparing each advertisement.....	1	0

2. *To the Attorney-General.*

By the person opposing a grant of letters patent, including summons.....	16	0
By the petitioner on hearing the case of opposition, including summons....	16	0
By the petitioner for the hearing previous to the fiat of the Attorney-General allowing a disclaimer or memorandum of alteration in letters patent and specification.....	14	0
By the person opposing the allowance of such disclaimer or memorandum of alteration, on the hearing of the case of opposition.....	14	0
By the petitioner for the fiat of the Attorney-General allowing a disclaimer or memorandum of alteration on letters patent and specification.....	16	0
On investigation of each application, and certificate and report thereon.....	10	0

PAYMENTS to be made to the Colonial Secretary and accounted for to the Public Treasurer.

On sealing letters patent.....	25	0
On every assignment or license.....	5	0
At or before the expiration of the third year.....	50	0
At or before the expiration of the seventh year.....	100	0
On duplicate of letters patent lost or destroyed.....	5	0

FORMS.

No.

Petition.

To His Excellency the Lieutenant Governor of the Colony of British Honduras,
The humble petition of [*here insert the name and address of the petitioner*]

Showeth,

That your petitioner is in possession of an invention for
[*the title of the invention*]

which invention he believes will be of great public utility ; that he is the true and first inventor thereof ; and that the same is not in use by any other person or persons, to the best of his knowledge and belief.

Your petitioner therefore humbly prays that your Excellency will be pleased to grant unto him, his executors, administrators, and assigns, letters patent for the colony of British Honduras, for the term of fourteen years, pursuant to the statutes in that case made and provided.

And your petitioner will ever pray.

No. *Declaration.*

I , of , in the colony of British Honduras , do solemnly and sincerely declare that I am in possession of an invention for, &c.

[*the title as in petition*]

which invention I believe will be of great public utility ; that I am the true and first inventor thereof ; and that the same is not in use by any other person or persons, to the best of my knowledge and belief ; [*where a complete specification is to be filed with the petition and declaration, insert these words :—*“ and that the instrument in writing under my hand and seal hereunto annexed, particularly describes and ascertains the nature of the said invention, and the manner in which the same is to be performed ;”] And I make this declaration, conscientiously believing the same to be true, and by virtue of the provisions of an Act made and passed in the session of parliament held in the fifth and sixth years of the reign of His late Majesty King William the Fourth, intituled “ An Act to repeal an Act of the present session of Parliament, intituled, “ An Act for the more effectual abolition of oaths and affirmations taken : and made “ in various departments of the state, and to substitute declarations in lieu thereof “ and for the more entire suppression of voluntary and extra judicial oaths and “ affidavits, and to make other provisions for the abolition of unnecessary oaths.”

Declared at in British Honduras, this day of A. D. before me,

C. D., Judge of Supreme Court.

or
Justice of the Peace.

No. *Provisional Specification.*

I do hereby declare the nature of the said invention for
[*insert title as in petition*]
to be as follows :

[*here insert description*]

Dated this day of A. D.
(*To be signed by the applicant or his agent.*)

Reference.

[*To be indorsed on the petition.*]

The commissioners of patents for inventions refer this petition to the attorney-general, to consider what may properly be done therein.

A. B., Member of Council	} Three of the commissioners of patents.
C. D., Member of Council	
E. F.	

Certificate of the Attorney-General, and Warrant thereon of the Commissioners.

In obedience to the order of the commissioners of patents referring to me the petition of _____, of _____, to consider what may be properly done thereon, I do hereby certify as follows: That the said petition sets forth that the petitioner

[*allegations of the petition*]:

And the petitioner humbly prays,

[*prayer of the petition*]:

That in support of the allegations contained in the said petition, the declaration of the petitioner has been laid before me, whereby he solemnly declares that

[*allegations of the declaration*]:

That there has also been laid before me [a provisional specification signed and also a certificate _____,] or [a complete specification, and a certificate of the filing thereof], whereby it appears that the said invention was provisionally protected [or protected] from the _____ day of _____, A. D. _____, in pursuance of the statute:

That it appears the said application was duly advertised:

Upon consideration of all the matters aforesaid, and as it is entirely at the hazard of the said petitioner whether the said invention is new or will have the desired success, and as it may be reasonable to encourage all arts and inventions which may be for the public good, I am of opinion that letters patent may be granted unto the petitioner, his executors, administrators, and assigns, for his said invention within the Colony of British Honduras, for the term of fourteen years, according to the statute in that case made and provided, if the Lieutenant Governor shall be graciously pleased so to do according to the tenor and effect following:—

[*See next Form.*]

Given under my hand this _____ day of _____ A. D. _____

G. H., Attorney-General.

We, the undersigned, commissioners of patents for inventions in British Honduras, do warrant hereby the issue of letters patent, according to the tenor and effect above set forth.

A. B. } C. D. } E. F. }	Members of the Executive Council	} Three of the commissioners of patents.
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Letters Patent.

BRITISH HONDURAS SS.

VICTORIA, by the Grace of God, of the United Kingdom of Great Britain and Ireland Queen, Defender of the Faith.

To all to whom these presents shall come, greeting

Whereas _____ hath by his petition humbly represented unto the Lieutenant Governor of our Colony of British Honduras, that he is in possession of an invention for _____, which the petitioner conceives will be of great public utility; that he is the true and first inventor thereof, and that the same is not in use by any other person or persons, to the best of his knowledge and belief; the petitioner therefore most humbly prayed that we would be most graciously pleased to grant unto him, his executors, administrators, and assigns, our letters patent for the sole use, benefit, and advantage of his said invention within our said Colony of British Honduras, for the term of fourteen years, pursuant to the statutes in that case made and provided:

[And whereas the said hath particularly described and ascertained the nature of the said invention, and in what manner the same is to be performed, by an instrument in writing under his hand and seal, and has caused the same to be duly filed in the office of the colonial secretary :]

And we, being willing to give encouragement to all arts and inventions which may be for the public good, are graciously pleased to condescend to the petitioners' request: Know ye therefore, that we of our especial grace, certain knowledge, and mere motion, have given and granted, and by these presents for us, our heirs and successors, do give and grant unto the said , his executors, administrators, and assigns, our especial license, full power, sole privilege and authority, that he, the said , his executors, administrators, and assigns, and every of them, by himself and themselves, or by his and their deputy or deputies, servants or agents, or such others as he the said , his executors, administrators, or assigns shall at any time agree with, and no others, from time to time and at all times hereafter, during the term of years herein expressed, shall and lawfully may make, use, exercise, and vend his said invention within our said colony of British Honduras, in such manner as to him the said , his executors, administrators, and assigns, or any of them, shall in his or their discretion seem meet; and that he the said , his executors, administrators and assigns shall and lawfully may have and enjoy the whole profit, benefit, commodity, and advantage from time to time coming, growing, accruing, and arising by reason of the said invention for and during the term of years herein mentioned; to have, hold, exercise, and enjoy the said licenses, powers, privileges, and advantages hereinbefore granted, or mentioned to be granted unto the said , his executors, administrators, and assigns for and during and unto the full end and term of fourteen years from the day of A. D. next and immediately ensuing, according to the statute in such case made and provided; and to the end that he the said , his executors, administrators, and assigns, and every of them, may have and enjoy the full benefit and the sole use and exercise of the said invention according to our gracious intention hereinbefore declared, we do by these presents for us, our heirs and successors, require and strictly command all and every person and persons, bodies politic and corporate, and all others our subjects whatsoever, of what estate, quality, degree, name, or condition soever they be, within our said colony of British Honduras, that neither they nor any of them, at any time during the continuance of the said term of fourteen years hereby granted, either directly or indirectly, do make, use, or put in practice the said invention, or any part of the same so attained unto by the said as aforesaid, nor in any wise counterfeit, imitate, or resemble the same, nor shall make or cause to be made any addition thereunto or subtraction from the same, whereby to pretend himself or themselves the inventor or inventors, deviser or devisors thereof, without the consent, license, or agreement of the said , his executors, administrators, or assigns, in writing under his or their hands and seals first had and obtained in that behalf, upon such pains and penalties as can and may be justly inflicted on such offenders for their contempt of this our royal command, and further to be answerable to the said , his executors, administrators, and assigns according to law for his and their damages thereby occasioned; and, moreover, we do by these presents for us, our heirs and successors, will and command all and singular the justices of the peace, provost-marshal, alcaldes, constables, and all other officers and ministers whatsoever of us, our heirs and successors, for the time being, that they or any of them do not nor shall at any time during the

said term hereby granted, in any wise molest, trouble, or hinder the said _____, his executors, administrators, or assigns, or any of them, or his or their deputies, servants, or agents in or about the due and lawful use or exercise of the aforesaid invention, or anything relating thereto: Provided always, and these our letters patent are and shall be upon this condition, that if at any time during the said term hereby granted it shall be made appear to us, our heirs or successors, or to the commissioners of patents in our said colony of British Honduras, that this our grant is contrary to law, or prejudicial or inconvenient to our subjects in general, or that the said invention is not a new invention as to the public use and exercise thereof, or that the said _____ is not the true and first inventor thereof within this our colony of British Honduras as aforesaid, these our letters patent shall forthwith cease, determine, and be utterly void to all intents and purposes, anything herein-before contained to the contrary thereof in anywise notwithstanding: Provided also, that these our letters patent, or anything herein contained, shall not extend or be construed to extend to give privilege unto the said _____, his executors, administrators, or assigns, or any of them, to use or imitate any invention or work whatsoever which hath heretofore been found out or invented by any other of our subjects whatsoever, and publicly used or exercised, unto whom our like letters patent or privileges have been already granted for the sole use, exercise, and benefit thereof, it being our will and pleasure that the said _____, his executors, administrators, and assigns, and all and every other person and persons to whom like letters patent or privileges have been already granted as aforesaid, shall distinctly use and practice their several inventions by them invented and found out according to the true intent and meaning of the same respective letters patent and of these presents: Provided likewise, nevertheless, and these our letters patent are upon this express condition [that if the said _____ shall not particularly describe and ascertain the nature of his said invention and in what manner the same is to be performed, by an instrument in writing under his hand and seal, and cause the same to be filed in the colonial secretary's office within six calendar months next and immediately after the date of these our letters patent;] [and also if the said instrument in writing filed as aforesaid does not describe and ascertain the nature of the said invention, and in what manner the same is to be performed;] and also if the said _____, his executors, administrators, or assigns, shall not pay or cause to be paid at the office of the colonial secretary the sums following; that is to say, the sum of fifty dollars on or before the _____ day of _____ A. D. _____, and the sum of one hundred dollars on or before the _____ day of _____ A. D. _____; and also if the said _____, his executors, administrators, or assigns, shall not supply or cause to be supplied for our service all such articles of the said invention as he or they shall be required to supply by the officers or commissioners administering the department of our service for the use of which the same shall be required, in such manner, at such times, and at and upon such reasonable prices and terms as shall be settled for that purpose by the said officers or commissioners requiring the same, that then and in any of the said cases these our letters patent, and all liberties and advantages whatsoever hereby granted, shall utterly cease, determine, and become void, anything herein-before contained to the contrary thereof in anywise notwithstanding: Provided that nothing herein contained shall prevent the granting of licenses in such manner and for such considerations as they may by law be granted; and lastly, we do by these presents, for us, our heirs and successors, grant unto the said _____, his executors, administrators, and assigns, that these our letters patent, or the filing thereof, shall be in and by all

things good, firm, valid, sufficient, and effectual in the law according to the true intent and meaning thereof, and shall be taken, construed, and adjudged in the most favorable and beneficial sense for the best advantage of the said , his executors, administrators, and assigns, as well in all our courts of record as elsewhere, and by all and singular the officers and ministers whatsoever of us, our heirs and successors, in our said colony of British Honduras; and amongst all and every the subjects of us, our heirs and successors, whatsoever and wheresoever, notwithstanding the not full and certain describing the nature or quality of the said invention or of the materials thereunto conducing and belonging. In witness whereof we have caused these our letters to be made patent.

Witness His Excellency , Lieutenant-Governor of our said colony of British Honduras, at Government House, Belize, the day of A. D. , in the year of our reign.

—
Specification.

To all to whom these presents shall come:

I , of , send greeting:

Whereas Her most Excellent Majesty Queen Victoria, by her letters patent bearing date the day of , A. D. , in the year of her reign, did for herself, her heirs and successors, give and grant unto the said her special license that I, the said , my executors, administrators, and assigns, or such others as I, the said , my executors, administrators, and assigns, should at any time agree with, and no others, from time to time, and at all times thereafter during the time therein expressed, should and lawfully might make, use, exercise, and vend within the colony of British Honduras an invention for [*insert title as in letters patent*] upon the condition (amongst others) that I the said by an instrument in writing under my hand and seal should particularly describe and ascertain the nature of, the said invention, and in what manner the same was to be performed, and cause the same to be filed in the office of the colonial secretary within six calendar months next and immediately after the date of the said letters patent: Now know ye, that I, the said , do hereby declare the nature of my said invention, and in what manner the same is to be performed, to be particularly described and ascertained in and by the following statement; (that is to say), [*describe the invention*].

In witness whereof I, the said , have hereunto set my hand and seal, this day of A. D. .

A. B. (Seal.)

From *Carp. Pat. L. of World*, 78.

CAMBODIA.

See FRANCE.

YALE LAW LIBRARY.

CANADA.

*An Act respecting Patents of Invention. June 14, 1872, 35 Vict. c. 26 ; as amended or modified by later laws.**

Preamble. Her Majesty, by and with the advice and consent of the Senate and House of Commons of Canada, enacts as follows :—

PATENT-OFFICE CONSTITUTED.

1. *Minister of agriculture to be commissioner of patents.* There shall be attached to the department of agriculture, as a branch thereof, an office to be called the patent-office ; and the minister of agriculture for the time being shall be the commissioner of patents; and it shall be the duty of the said commissioner to receive all applications, fees, papers, documents, and models for patents, and to perform all acts and things requisite to the granting and issuing of patents of inventions; and he shall have the charge and custody of the books, records, papers, models, machines, and other things belonging to the said office.

2. *Seal to be made, and impressions thereof to be received in evidence.* The commissioner shall cause a seal to be made for the purposes of this Act, and may cause to be sealed therewith patents and other instruments and copies proceeding from the patent-office; and all courts, judges, and other persons whomsoever shall take notice of such seal, and receive impressions thereof in evidence, in like manner as impressions of the Great Seal are received in evidence,

* At the larger law libraries throughout the United States one may consult the Canadian patent laws in the Statutes of Canada themselves; where they may be found as follows :

Act of June 14, 1872, Stat. 35 Vict. c. 26, Can. Stat. 97.

Act of May 23, 1873, 36 Vict. c. 44, Can. Stat. 129.

Act of May 26, 1874, 37 Vict. c. 44, Can. Stat. 190.

Act of April 8, 1875, 38 Vict. c. 14, Can. Stat. 91.

Act of May 25, 1883, 46 Vict. c. 19, Can. Stat. 331.

These enactments may be found sep-

arately in 20 Pat. Off. Gaz. 960, and 23 Id. 2241. Carpmaels' Pat. L. of World gives them consolidated, placing the amendments taken from later laws in their connection with the sections of the law of 1872 amended. Richards' Digest of Patent Laws, &c. of Canada does the same; he however adds :

Act of May 17, 1882; and

Act of April 19, 1884.

The version given in the text is that of Messrs. Carpmaels collated with that of Mr. Richards (the two do not materially differ) with the addition of the Acts of 1882 and 1884 quoted from Mr. Richards' reprint.

and shall also take notice of and receive in evidence, without further proof and without production of the originals, copies, or extracts certified under the seal of the said office to be copies of or extracts from documents deposited in such office.

3. *Commissioner to make rules.—Publication and effect.* The commissioner may, from time to time, subject to the approval of the Governor in Council, make such rules and regulations, and prescribe such forms, as may appear to him necessary and expedient for the purposes of this Act, and notice thereof shall be given in the Canada Gazette; and all documents, executed in conformity with the same and accepted by the commissioner, shall be held valid so far as relating to proceedings in the patent-office.

4. *Deputy commissioner and clerks.—Employes in patent-office not to be concerned in patents.—Exception.* The deputy of the minister of agriculture shall be the deputy commissioner of patents of invention; and the Governor in Council may, from time to time, appoint such clerks and officers under him as may be necessary for the purposes of this Act, and such clerks and officers shall hold office during pleasure. No officer or employe of the patent-office shall buy, sell, or acquire, or traffic in an invention or patent, or rights to patents therefor; and every such purchase and sale, and every assignment or transfer thereof; by or to any officer or employe as aforesaid, shall be utterly null and void. But this shall not apply to any original inventor, or to the acquisition by bequest.

5.* *Annual report and list of patents.—Publications of specifications.* The commissioner shall cause a report to be prepared annually and laid before Parliament of the proceedings under this Act, and shall, from time to time, and at least once in each year, publish a list of patents granted, and may, with the approval of the Governor in Council, cause such specifications and drawings as may be deemed of interest, or essential parts thereof, to be printed from time to time for distribution or sale.

WHO MAY OBTAIN PATENTS.

6. *Any person may obtain a patent for his invention, it not having been then in public use in Canada for more than one year.—Form of patent.—Proviso: what shall not be patentable.* Any person having invented any new and useful art, machine, manufacture,

*According to Richards' edition of the patent law of Canada, the text is Section 5 "as amended by Act of May 23, 1873;"

Carpmaels' edition does not mention the fact of amendment, but gives the section in the same language.

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 invention thereof, and not being in public use or on sale for more than one year previous to his application in Canada, with the consent or allowance of the inventor thereof, may, on a petition to that effect presented to the commissioner, and on compliance with the other requirements of this Act, obtain a patent granting to such person an exclusive property therein ; and the said patent shall be under the seal of the patent-office and the signature of the commissioner, or the signature of another member of the Privy Council, and shall be good and avail to the grantee, his executors, administrators, or assigns, for the period mentioned in such patent ; but no patent shall issue for an invention having an illicit object in view, nor for any mere scientific principle or abstract theorem.

7. *As to inventions for which foreign patents have been taken out.* But an inventor shall not be entitled to a patent for his invention, if a patent therefor in any other country shall have been in existence in such country more than twelve months prior to the application for such patent in Canada ; and if during such twelve months any person shall have commenced to manufacture in Canada the article for which such patent is afterwards obtained, such person shall continue to have the right to manufacture and sell such article, notwithstanding such patent ; and under any circumstances, where a foreign patent exists, the Canadian patent shall expire at the earliest date at which any foreign patent for the same invention expires.

8. *Representatives of inventor may obtain the patent.* The patent may be granted to any person to whom the inventor entitled under the sixth section to obtain a patent has assigned or bequeathed the right of obtaining the same, or in default of such assignment or bequest, to the executors or administrators or *other legal representatives* of the deceased inventor.

[NOTE.*—The words in italics were added by 36 Vict. cap. 44.]

9. *As to patents for improvements on patented inventions.—*
Proviso. Any person who has invented any improvement on any patented invention may obtain a patent for such improvement, but shall not thereby obtain the right of vending or using the original invention, nor shall the patent for the original invention confer the right of vending or using the patented improvement.

* Notes printed in this form are from Carpmaels' edition.

10. *As to joint application for patent.* In cases of joint applications, the patent shall be granted in the names of all the applicants; and in such cases any assignment from one of the said applicants or patentees to the other, or to any person, shall be registered in like manner as other assignments.

CONDITIONS AND FORMALITIES.

11. *Declaration to be made by application for a patent.—Before whom.—Applicant to elect a domicile in Canada.* Every inventor, before a patent can be obtained, shall make oath, or, when entitled by law to make an affirmation instead of an oath, shall make an affirmation, that he verily believes that he is, or, in the case of the inventor being deceased, the applicant shall make oath or affirm that the person whose assignee or representative he is, was the inventor of the invention for which the patent is solicited, and that the several allegations in the petition contained are respectively true and correct. Such oath or affirmation may be made before any justice of the peace in Canada; but if the inventor or the applicant is not at the time in Canada the oath or affirmation may be made before any minister plenipotentiary, chargé d' affaires, consul, vice-consul, or consular agent, holding commission under the government of the United Kingdom, or any Judge of a court of record or a public notary, or the mayor or other chief magistrate of any city, borough, or town corporate in the country in which the applicant happens at the time to be.

[NOTE.*—The words in italics were added by 36 Vict. cap. 44.]

12. *Particulars required in application.* The petitioner for a patent shall for all the purposes of this Act elect his domicile at some known and specified place in Canada, and mention the same in his petition for a patent.

13. *Specification and drawing, form of, and what to show.* The applicant shall, in his petition for a patent, insert the title or name of the invention, and shall, with the petition, send in a specification, in duplicate.

14. *Commissioner may require further drawings.—Drawings, how disposed of.* The specification shall correctly and fully describe the mode or modes of operating contemplated by the inventor; and shall state clearly and distinctly the contrivances and things which he claims as new; and for the use of which he

* Notes printed in this form are from Carpmals' edition.

claims an exclusive property and privilege ; it shall bear the name of the place where it is made, the date, and be signed by the inventor; if he be alive (and if not, by the applicant) and two witnesses ; in the case of a machine the specification shall fully explain the principle and the several modes in which it is intended to apply and work out the same ; in the case of a machine, or in any other case where the invention admits of illustration by means of drawings, the applicant shall also, with his application, send in drawings in duplicate showing clearly all parts of the invention ; and each drawing shall bear the signature of the applicant or of his attorney, and shall have written references corresponding with the specification, but the commissioner may require further drawings or dispense with any of them, as he may see fit ; one duplicate of the specification and of the drawings, if there are drawings, shall be annexed to the patent of which it forms an essential part, and the other duplicate shall remain deposited in the patent office. *But the said commissioner may, in his discretion, dispense with the said duplicate specification and drawing, and in lieu thereof cause copies of the specification and drawing, in print or otherwise, to be attached to the patent of which they shall form an essential part.

[NOTE.—The words following the asterisk were added by 36 Vict. cap. 44.]

15. *Working model to be delivered to the commissioner.—*
Or specimens of ingredients.—Exception as to explosive materials.
 The applicant shall also deliver to the commissioner, unless specially dispensed from so doing for some good reason, a neat working model of his invention on a convenient scale, exhibiting its several parts in due proportion, whenever the invention admits of such model ; and shall deliver to the commissioner specimens of the ingredients, and of the composition of matter sufficient in quantity for the purpose of experiment, whenever the invention is a composition of matter ; provided such ingredients and composition are not of an explosive character or otherwise dangerous, in which case they are to be furnished only when specially required by the commissioner, and then with such precautions as shall be prescribed in the said requisition.

CONTENTS, DURATION, SURRENDER, RE-ISSUE OF PATENTS, AND DISCLAIMERS.

16. *Contents of patents.—Conditions.* Every patent granted under this Act shall contain the title or name of the invention, with a reference to the specification,—and shall grant to the patentee,

his executors, administrators, *legal representatives*, and assigns, for the period therein mentioned for the granting of the same, the exclusive right, privilege, and liberty of making, constructing, and using, and vending to others to be used, the said invention, subject, nevertheless, to adjudication before any court of competent jurisdiction.

[NOTE.—The words in italics were added by 26 Viet. cap. 44.]

17. *Duration of patents and periodical extension—not exceeding fifteen years in all.—Form of extension.* The term limited for the duration of every patent of invention issued by the patent-office shall be fifteen years; but at the time of the application therefor it shall be at the option of the applicant to pay the full fee required for the term of fifteen years, or the partial fee required for the term of five years, or the partial fee required for the term of ten years. In case a partial fee only is paid the proportion of the fee paid shall be stated in the patent, and the patent shall, notwithstanding anything therein or in this Act contained, cease at the end of the term for which the partial fee has been paid, unless at or before the expiration of the said term the holder of the patent pays the fee required for the further term of five or ten years, and takes out from the patent-office a certificate of such payment (in the form which may be from time to time adopted) to be attached to and to refer to the patent, and under the signature of the commissioner, or, in case of his absence, another member of the Privy Council; and in case such second payment, together with the first payment, makes up only the fee required for ten years, then the patent shall, notwithstanding anything therein or in this Act contained, cease at the end of the term of ten years, unless at or before the expiration of such term the holder thereof pays the further fee required for the remaining five years, making up the full term of fifteen years, and takes out a like certificate in respect thereof. Every patent heretofore issued by the patent-office in respect of which the fee required for the whole or for any unexpired portion of the term of fifteen years, has been duly paid according to the provisions of the now existing law in that behalf, has been and shall be deemed to have been issued for the term of fifteen years, subject, in case a partial fee only has been paid, to cease on the same conditions on which patents hereafter issued are to cease under the operation of this section.

[NOTE.—The original clause 17 was repealed and the above substituted by 46 Vict. cap. 19.]

18. *Patents or extension to be examined by minister of justice before granted.* Every patent and instrument for the extension of time as aforesaid shall, before it is signed by the commissioner or any other member of the Privy Council, and before the seal hereinbefore mentioned is affixed to it, be examined by the minister of justice, who, if he finds it conformable to law, shall certify accordingly, and such patent or instrument may then be signed and the seal affixed thereto, and being duly reistered, shall avail to the grantee thereof.

19. *In certain cases of error, &c., the commissioner may cause a new patent to issue, on amended specification.—Effect of new patent and specification.* Whenever any patent shall be deemed defective or inoperative by reason of insufficient description or specification, or by reason of the patentee claiming more than he had a right to claim as new, but at the same time it appears that the error arose from inadvertence, accident, or mistake, without any fraudulent or deceptive intention, the commissioner may, upon the surrender of such patent, and the payment of the further fee hereinafter provided, cause a new patent, in accordance with an amended description and specification to be made by such patentee, to be issued to him for the same invention for any part or the whole of the then unexpired residue of the period for which the original patent was or might have been, as hereinbefore directed, granted;—in case of the death of the original patentee or of his having assigned the patent, a like right shall vest in his assignee or legal representative: The new patent, and the amended description and specification, shall have the same effect in law, on the trial of any action thereafter commenced for any cause subsequently accruing, as if the same had been originally filed in such corrected form before the issue of the original patent, *and the commissioner may entertain separate applications and cause patents to be issued for distinct and separate parts of the thing patented, upon payment of the fee for a re-issue for each of such re-issue patents.*

[NOTE.—The words in italics were added by 38 Vict. cap. 14.]

20. *Patentee may disclaim anything included in patent by mistake.—Form.—Disclaimer not to effect pending suits.—In case of death of patentee.—Effect of disclaimer.* Similarly, whenever by any mistake, accident, or inadvertence, and without any willful intent to defraud or mislead the public, a patentee has made his specification too broad, claiming more than that of which he or the party through whom he claims was the first inventor, or has in the

specification claimed that he or the party through whom he claims was the first inventor of any material or substantial part of the invention patented, of which he was not the first inventor, and to which he had no legal right ;—the patentee may, on payment of the fee hereinafter provided, make disclaimer of such parts as he does not claim to hold by virtue of the patent or the assignment thereof:—such disclaimer shall be in writing, and in duplicate, and attested in the manner hereinbefore prescribed for a patent, one copy to be filed and recorded in the office of the commissioner, the other copy to be attached to the patent and made a part thereof by reference, and such disclaimer shall thereafter be taken and considered as part of the original specification. Such disclaimer shall not affect any action pending at the time of its being made, except in so far as may relate to the question of unreasonable neglect or delay in making it. In case of the death of the original patentee or of his having assigned the patent, a like right shall vest in his assigns or legal representatives respectively, any of whom may make disclaimer. The patent shall thereafter be deemed good and valid for so much of the invention as is truly the disclaimant's own, and not disclaimed, provided it be a material and substantial part of the invention, and definitely distinguished from other parts claimed without right ; and the disclaimant shall be entitled to maintain a suit for such part accordingly.

ASSIGNMENT AND INFRINGEMENT OF PATENTS.

21. *Government may use patented invention.* The government of Canada may always use any patented invention, paying to the patentee such sum as the commissioner may report to be a reasonable compensation for the use thereof.

22. *Patents to be assignable.—To be registered on pain of nullity.* Every patent for an invention whensoever issued shall be assignable in law either as to the whole interest or as to any part thereof, by any instrument in writing ; but such assignment, and also every grant and conveyance of any exclusive right to make and use and to grant to others the right to make and use the invention patented, within and throughout Canada or any part thereof, shall be registered in the office of the commissioner, in the manner from time to time adopted by the commissioner of patents for such registration ; and every assignment affecting a patent for invention shall be deemed null and void against any subsequent assignee unless such instrument is registered as hereinbefore prescribed, before the regis-

tering of the instrument under which such subsequent assignee may claim.

23. Remedy for infringement of patent. Every person who, without the consent in writing of the patentee, makes, constructs, or puts in practice any invention for which a patent has been obtained under this Act, or any previous Act, or procures such invention from any person not authorized to make or use it by the patentee, and uses it, shall be liable to the patentee in an action of damages for so doing ;—and the judgment shall be enforced, and the damages and costs that may be adjudged shall be recovered in like manner as in other cases in the court in which the action is brought.

24. Action for infringement of patent.—Injunction may issue.—Appeal allowed. An action for the infringement of a patent may be brought before any court of record having jurisdiction to the amount of damages asked for, and having its sittings within the province in which the infringement is said to have taken place, and being, at the same time, of the courts of such jurisdiction within such province, the one of which the place of holding is nearest to the place of residence or of business of the defendant ; and such court shall decide the case and determine as to costs. In any action for the infringement of a patent, the court, if sitting, or any judge thereof in chambers if the court be not sitting, may, on the application of the plaintiff or defendant respectively, make such order for an injunction, restraining the opposite party from further use, manufacture, or sale of the subject matter of the patent, and for his punishment, in the event of disobedience to such order, or for inspection or account, and respecting the same and the proceedings in the action, as the court or judge may see fit ;—But from such order an appeal shall lie under the same circumstances and to the same court, as from other judgments or orders of the court in which the order was made.

25. Court may discriminate in certain cases. Whenever the plaintiff fails to sustain his action, because his specification and claim embrace more than that of which he was the first inventor, and it appears that the defendant used or infringed any part of the invention, justly and truly specified and claimed as new, the court may discriminate, and the judgment may be rendered accordingly.

26. Defense in actions for infringement. The defendant, in any such action, may specially plead as matter of defense, any fact or default which by this Act, or by law, would render the patent void ; and the court shall take cognizance of that special pleading and of

the facts connected therewith, and shall decide the case accordingly.

NULLITY, IMPEACHMENT, AND AVOIDANCE OF PATENTS.

27. *Patents may be declared void in certain cases, or valid only for part.—Copy of judgment to be sent to patent-office.* A patent shall be void if any material allegation in the petition or declaration of the applicant be untrue, or if the specification and drawings contain more or less than is necessary for obtaining the end for which they purport to be made, such omission or addition being willfully made for the purpose of misleading; but if it shall appear to the court that such omission or addition is simply an involuntary error, and it is proved that the patentee is entitled to the remainder of his patent *pro tanto*, the court shall render a judgment in accordance with the facts, and determine as to costs, and the patent shall be held valid for such part of the invention described; and two office copies of such judgment shall be furnished to the patent-office by the patentee, one to be registered and to remain of record in the office, and the other to be attached to the patent, and made a part of it by a reference.

28. *Patents to be conditioned for the manufacture in Canada of the thing patented:—and of the patentee's not importing it into Canada.—Proviso.—Commissioner may extend the term for manufacture in Canada.* Every patent granted under this Act shall be subject and expressed to be subject to the condition that such patent and all the rights and privileges thereby granted shall cease and determine, and the patent shall be null and void at the end of two years from the date thereof, unless the patentee, or his assignee or assignees, shall within that period have commenced, and shall, after such commencement, continuously carry on in Canada the construction or manufacture of the invention or discovery patented, in such manner that any person desiring to use it may obtain it or cause it to be made for him at a reasonable price, at some manufactory or establishment for making or constructing it, in Canada, and that such patent shall be void if, after the expiration of twelve months from the granting thereof, the patentee, or his assignee or assignees, for the whole or a part of his interest in the patent, imports or causes to be imported into Canada, the invention for which the patent is granted; and provided always, that in case disputes should arise as to whether a patent has or has not become null and void under the provisions of this section, such disputes shall be settled

by the minister of agriculture, or his deputy, whose decision shall be final.

(a) Whenever a patentee has been unable to carry on the construction or manufacture of his invention within the two years hereinbefore mentioned, the commissioner may at any time not more than three months before the expiration of that period grant to the patentee a further delay on his adducing proof to the satisfaction of the commissioner that he was for reasons beyond his control prevented from complying with the above mentioned condition.*

[NOTE.—The words to which (a) is prefixed were substituted by 38 Vict. c. 14.]

29. *Proceedings for impeachment of patent.*—*Scire facias may issue.* Any person desiring to impeach any patent issued under this Act, may obtain a sealed and certified copy of the patent and of the petition, affidavit, specification, and drawings thereunto relating, and may have the same filed in the office of the prothonotary or clerk of the Superior Court for the province of Quebec, or of the Court of Queen's Bench or Common Pleas for the province of Ontario, or of the Supreme Court in the province of Nova Scotia, or of the *Supreme Court* in the province of New Brunswick, according to the domicile elected by the patentee as aforesaid, or in the court of highest jurisdiction in the province of Manitoba or British Columbia, which courts shall adjudicate on the matter, and decide as to costs. The patent and documents aforesaid shall then be held as of record in such court, so that a writ of scire facias under the seal of the court grounded upon such record, may issue for the repeal of the patent, for cause as aforesaid, if upon proceedings had upon the writ in accordance with the meaning of this Act, the patent be adjudged to be void.

[NOTE.—The words in italics were substituted by 37 Vict. c. 44.]

30. *Judgment voiding patent to be filed in patent-office.* A cer-

* According to Richards' edition of the Patent Laws of Canada the following "sub-section 3" was inserted in section 28, by Act, May 17, 1882.

3. *Further provision as to extension of patent.* The commissioner may grant to the patentee or his assignee or assignees for the whole or any part of the patent, an extension for a further period of time, not exceeding one year beyond the twelve months limited by the first paragraph of this section, during which he

may import or cause to be imported into Canada the invention for which the patent is granted: Provided, that the patentee or his assignee or assignees for the whole or any part of the patent, shall show cause satisfactory to the commissioner to warrant the granting of such extension; but no extension shall be granted unless application be made to the commissioner at some time within three months before the expiry of the twelve months aforesaid or any extension thereof.

tificate of the judgment voiding any patent shall, at the request of any person or party filing it, to be of record in the patent-office, be entered on the margin of the enrollment of the patent in the office of the commissioner, and the patent shall thereupon be and be held to have been void and of no effect, unless and until the judgment be reversed on appeal, as hereinafter provided.

31. *To be subject to appeal.* The judgment declaring any patent void, shall be subject to appeal to any court of appeal having appellate jurisdiction in other cases over the court by which the same was rendered.

PATENTS ISSUED UNDER FOREIGN LAWS.

32. *Existing provincial and dominion patents to remain in force.—Extension of provincial patents to other provinces, on certain conditions.* All patents issued under any Act of the Legislature of the late province of Canada, or of Nova Scotia, or of New Brunswick, or of British Columbia, and all patents issued for the provinces of Ontario and Quebec, under any Act of the late province of Canada, and all patents issued under the Patent Act of 1869, to the date of the coming into operation of the present Act, shall remain in force for the same term and for the same extent of territory, as if the Act under which they were issued had not been repealed, but subject to the provisions of this Act in so far as applicable to them.

2. And it shall be lawful for the commissioners upon the application of the patentee named in any such patent, being the inventor of the subject matter of the patent, if the subject matter of the patent has not been known or used, nor with the consent of the patentee on sale in any of the other provinces of the Dominion, to issue on payment of the proper fees in that behalf a patent under this Act extending such provincial patent over the whole of the Dominion, for the remainder of the term mentioned in the provincial patent.

33. *Records of provincial patent-offices to be handed over to the commissioner.* All the records of the patent-offices of the late province of Canada, and of the provinces of Ontario and Quebec, of Nova Scotia and New Brunswick, and British Columbia, shall be handed over by the officers in charge of them to the commissioner of patents of invention, to form part of the records of the patent-office for the purposes of this Act.

TARIFF OF FEES.

34. *Tariff of fees.* The following fees shall be payable to the commissioner, before an application for any of the purposes hereinafter mentioned shall be entertained, that is to say :—

	\$
On petition for a patent for 5 years.....	20 00
On petition for a patent for 10 years.	40 00
On petition for a patent for 15 years.....	60 00
On petition for extension from 5 to 10 years.....	20 00
On petition for extension from 10 to 15 years.....	20 00
On petition for extension from 5 to 15 years.....	40 00
On lodging a caveat.....	5 00
On asking to register a judgment <i>pro tanto</i>	4 00
On asking to register an assignment.....	2 00
On asking to attach a disclaimer to a patent.....	2 00
On asking for a copy of patent with specification.....	4 00
On petition to re-issue a patent after surrender; and on petition to extend a former patent to the dominion, for every unexpired year of the duration of sub-patent, the fee shall be at the rate of.....	4 00

On office copies of documents, not above mentioned, the following charges shall be made :—

	\$
For every single or first folio of certified copy.....	0 50
For every subsequent hundred words (fractions from and under fifty being not counted, and over fifty being counted for one hundred.).....	0 25

35. *For copies of drawings.* For every copy of drawings, the party applying shall pay such sum as the commissioner considers a fair remuneration for time and labor expended thereon by any officer of the department or person employed to perform such service.

36. *Fees to be in full of all services.* The said fees shall be in full of all services performed under this Act, in any such case, by the commissioner or any person employed in the patent-office.

37. *Fees to form part of consolidated revenue fund.—Exception.* All fees received under this Act shall be paid over to the receiver-general and form part of the consolidated revenue fund of Canada, except such sums as may be paid for copies of drawings when made by persons not receiving salaries in the patent-office.

38. *Return of fees in certain cases only.—Case of withdrawal.* No fee shall be made the subject of exemption in favor of any person; and no fee once paid, shall be returned to the person who paid it, except :

1. When the invention is not susceptible of being patented ;
2. When the petition for a patent is withdrawn ;

And in every such case the commissioner may return one half of the fee paid ;

And in the case of withdrawal, a fresh application is necessary to revive the claim, as if no proceeding had taken place in the matter.

MISCELLANEOUS PROVISIONS.

39. *Intending applicant for a patent may file a caveat.—Effect of caveat.—Proviso: duration of caveat.* An intending applicant for a patent who has not yet perfected his invention, and is in fear of being despoiled of his idea, may file in the patent-office a description of his invention so far, with or without plans, at his own will ; and the commissioner, on reception of the fee hereinbefore prescribed, shall cause the said document to be preserved in secrecy, with the exception of delivering copies of the same whenever required by the said party or by any judicial tribunal—the secrecy of the document to cease when he obtains a patent for his invention ; and such document shall be called a caveat : Provided always, that if application shall be made by any other person for a patent for any invention with which such caveat may in any respect interfere, it shall be the duty of the commissioner forthwith to give notice by mail to the person who has filed such caveat, and such person shall within three months after the date of mailing the notice, if he would avail himself of the caveat, file his petition and take the other steps necessary on an application for patent, and if, in the opinion of the commissioner, the applications are interfering, like proceedings may be had in all respects as are by this Act provided in the case of interfering applications : Provided further, that unless the person filing any caveat shall within one year from the filing thereof have made application for a patent, the commissioner of patents shall be relieved from the obligation of giving notice, the caveat then remaining as a simple matter of proof as to novelty or priority of invention if needed.

40. *Commissioner may object to grant a patent in certain cases.* The commissioner may object to grant a patent in the following cases :

1. When is he of opinion that the alleged invention is not patentable in law ;
2. When it appears to him that the invention is already in the

possession of the public with the consent or allowance of the inventor ;

3. When it appears to him that there is no novelty in the invention ;

4. When it appears that the invention has been described in a book or other printed publication before the date of the application, or is otherwise in the possession of the public ;

5. When it appears that the invention has already been patented in Canada (or elsewhere, when the case is one within the seventh section of this Act), except, however, when the case is one in which the commissioner has doubts as to whether the patentee or the applicant is the first inventor.

41. Commissioner to notify ground of objection to applicant. Whenever the commissioner objects to grant a patent as aforesaid, he shall notify the applicant to that effect, and shall state the ground or reason therefor with sufficient detail to enable the applicant to answer, if he can, the objection of the commissioner.

42. Appeal by applicant to Governor in Council. Every applicant who has failed to obtain a patent by reason of the objection of the commissioner as aforesaid, may at any time within six months after notice thereof has been addressed to him or his agent, appeal from the decision of the commissioner to the Governor in Council.

43. Arbitration in case of interfering applications.—The same: Appointment of arbitrators.—Their oath of office.—Powers of arbitrators to summon and swear witnesses.—Willful false evidence to be perjury.—As to fees to arbitrators, and by whom paid. In case of interfering applications for any patent, the same shall be submitted to the arbitration of three skilled persons, one of whom shall be chosen by each of the applicants, and the third person shall be chosen by the commissioner or by his deputy or the person appointed to perform the duty of that office ;—And the decision or award of such arbitrators, or any two of them, delivered to the commissioner in writing, and subscribed by them or any two of them, shall be final as far as respects the granting of the patent:

2. If either of the applicants refuses or fails to choose an arbitrator, when required so to do by the commissioner, the patent shall issue to the opposite party ;—And when there are more than two interfering applicants, and the parties applying do not all unite in appointing three arbitrators, the commissioner or his deputy or person appointed to perform the duty of that officer, may appoint the three arbitrators for the purposes aforesaid :

3. The arbitrators so named shall, before a judge of any court in any of the provinces of Canada, subscribe to the following oath :

“ I, the undersigned (A. B.), being duly appointed an arbitrator under the authority of the forty-third section of the Patent Act of 1872, do hereby solemnly swear (or affirm, as the case may be), that I will well and truly perform the duty of such arbitrator on the the interfering applications of (C. D. and E. F.) submitted to me :”

4. The arbitrators, or any one of them, after having been so sworn, shall have the power of summoning before them any party or witness, and of requiring him to give evidence on oath, orally, or in writing (or on solemn affirmation, if the person be entitled to affirm in civil matters), and to produce such documents and things as such arbitrators deem requisite to the full investigation of the matters into which they are appointed to examine, and shall then have the same power to enforce the attendance of such witnesses, and to compel them to give evidence, as is vested in any court of law in civil cases, in the province in which the arbitration is to be had; and any willfully false statement made by any such witness on oath or solemn affirmation, shall be deemed to be willful and corrupt perjury ; but no such party or witness shall be compelled to answer any question, by his answer to which he might render himself liable to a criminal prosecution:

5. The fees for the services of arbitrators shall be a matter of agreement between the said arbitrators and the parties, and shall be paid by the parties naming them, respectively, except those of the arbitrator or arbitrators when named by the Commissioner of Patents, which shall be paid by the applicants jointly.

44. *Documents to be open to inspection.* All specifications, drawings, models, disclaimers, judgments, and other papers, except *caveats*, shall be open to the inspection of the public at the patent-office, under such regulations as may be adopted in that behalf.

45. *As to clerical errors.* Clerical errors happening in the framing or copying of any instrument of the patent-office, shall not be construed as invalidating the same, but when discovered they may be corrected under the authority of the Commissioner.

46. *Destroyed patent may be replaced.* In case any patent be destroyed or lost, others of the like tenor, date, and effect may be issued in lieu thereof, on the party paying the fees hereinbefore prescribed for office copies of documents.

47. *As to use of patented invention in foreign vessels.* No patent shall extend to prevent the use of any invention in any foreign

ship or vessel, where such invention is not so used for the manufacture of any goods to be vended within or exported from Canada.

48. *Patent not to affect a previous purchaser of the invention.—*
Proviso: As to other persons. Every person who before the issuing of a patent has purchased, constructed or acquired any invention for which a patent has been obtained under this Act, shall have the right of using and vending to others, the specific article, machine, manufacture, or composition of matter patented, so purchased, constructed, or acquired before the issue of the patent therefor, without being liable to the patentee or his representatives for so doing; but the patent shall not be held invalid as regards other persons by reason of such purchase, construction, or acquisition, or use of the invention by the person first aforesaid, or by those to whom he may have sold the same, unless the same was purchased, constructed, or acquired or used for a longer period than one year before the application for a patent therefor, which circumstance would then have the effect of making the invention one having become public and in public use.

49. *Patented articles to be marked as such.—Penalty for default.* Every patentee under this Act shall stamp or engrave on each patented article sold or offered for sale by him the year of the date of patent applying to such article thus: "Patented 1872," or as the case may be; or when from the nature of the article this cannot be done by fixing to it or to every package wherein one or more of such articles is or are enclosed a label marked with a like notice; and any such patentee selling or offering for sale any such patented article not so marked or not enclosed in a package so marked shall be liable to the punishment of a fine not to exceed one hundred dollars, and in default of the payment of such fine, to imprisonment not to exceed two months.

[NOTE. The original clause 49 was repealed and the above substituted by 38 Vict. c. 14.]

50. *Falsely marking anything as patented to be a misdemeanor.—Punishment.* Whosoever writes, paints, prints, moulds, casts, carves, engraves, stamps, or otherwise marks upon anything made or sold by him, and for the sole making or selling of which he is not the patentee, the name or any imitation of the name of any patentee for the sole making or selling of such thing without the consent of such patentee—or without the consent of the patentee, writes, paints, prints, moulds, casts, carves, engraves, stamps, or otherwise marks upon anything not purchased from the patentee, the words

“Patent,” “Letters Patent,” “Queen’s Patent,” “Patented,” or any word or words of like import, with the intent of counterfeiting or imitating the stamp, mark, or device of the patentee, or of deceiving the public and inducing them to believe that the thing in question was made or sold by or with the consent of the patentee, or whosoever puts to sale as patented, any article not patented in Canada, for the purpose of deceiving the public,—shall be deemed guilty of misdemeanor, and shall on conviction be punished therefor by fine, or by imprisonment, or both, in the discretion of the court before which the conviction shall be had; but the fine shall not exceed two hundred dollars, nor shall the imprisonment exceed three months.

51. *Making false entry or copy in matters subject to this Act to be a misdemeanor.* Any person willfully making or causing to be made any false entry in any register or book, or any false or altered copy of any document relating to the purposes of this Act, or who shall produce or tender any such false or altered document, knowing the same to be such, shall be guilty of a misdemeanor, and shall be punished by fine and imprisonment accordingly.

52. *Inconsistent enactments repealed.—Exception.* Chapter thirty-four of the Consolidated Statutes of the late Province of Canada, respecting Patents for Inventions,—Chapter one hundred and seventeen of the Revised Statutes of Nova Scotia (third series),—Chapter one hundred and eighteen of the Revised Statutes of New Brunswick, and the Patents Ordinance, 1867, of British Columbia, the Patent Act of 1869,—and any Act amending any of the said Acts or laws, or any other Act relating to patents, are hereby repealed, in so far as they or any of them may be inconsistent with this Act, or make any provision in any matter provided for by this Act, except only as respects all rights acquired and penalties or liabilities incurred under the said laws or any of them, before the coming into force of this Act, as to which they shall remain in force, and nothing in this Act contained shall affect any suit pending in any court of law or equity at the time of the coming into force of this Act.

53. *Short title.* In citing this Act it shall be sufficient to call it “The Patent Act of 1872.”

54. *Commencement of Act.* This Act shall commence and take effect on the first day of September, 1872.

From *Carpenter’s Patent Law of the World*, 105.

Provisions of Act of April 8, 1875, Stat. 38 Vict. c. 14, extending the foregoing law to Prince Edward Island.

4. *Provisions of 35 V., c. 27, and its amending Acts and patents issued under them, extended to Prince Edward Island.* From and after the passing of this Act all and every the provisions of The Patent Act of 1872, as amended by this Act, and of the Acts amending the same, shall have the same force and effect in Prince Edward Island as the same then respectively have in the other provinces forming this Dominion; and every patent theretofore issued under the said Acts or any of them shall extend over the said province for the remainder of the term mentioned therein.

5. *Inconsistent enactments of acts of General Assembly of Prince Edward Island repealed.* The following Acts of the General Assembly of Prince Edward Island are hereby repealed, that is to say—The Act passed in the seventh year of the reign of his late Majesty King William IV., chapter twenty-one, entitled An Act for granting Patents for useful Inventions; the Act passed in the thirty-second year of Her Majesty's reign, chapter twenty, entitled An Act to add to and amend the Act relating to Patents for useful Inventions; and the Act passed in the thirty-third year of her Majesty's reign, chapter nineteen, entitled An Act to amend the Act relating to Patents for useful inventions,—but in so far only as such Acts, or any of them, may be inconsistent with this Act or make any provision in any matter provided for by this Act—except only as respects all rights acquired and penalties or liabilities incurred under the said Acts, or any of them, before the coming into force of this Act, as to which the said Acts shall remain in force; and nothing in this Act contained shall affect any suit pending in any court of law or equity at the time of the coming into force of this Act.

From *Richards' Digest of Patent-Laws (of Canada)*, 12.

PATENTS ISSUED UNDER FORMER LAWS.

6. *Existing provincial patents to remain in force.* All patents issued under the said Acts of the General Assembly of Prince Edward Island, or any of them, to the date of the passing of this Act shall remain in force in the said province for the same term as if the Act or Acts under which such patent respectively were issued had not been repealed, but subject to all the provisions of this Act,

in so far as such provisions, or any of them, may be applicable to such patents respectively.

2. *Extension of provincial patent provided for.* And it shall be lawful for the commissioner, upon the application of the patentee named in any such patent, being the inventor of the subject-matter of the patent, if the subject-matter of the patent has not been known or used nor with the consent of the patentee on sale, in any of the other provinces of the dominion, to issue, on payment of the proper fees in that behalf, a patent under this Act extending such provincial patent over the whole of the dominion, for the remainder of the term mentioned in the provincial patent.

7. *Records of patent office of Prince Edward Island to be handed over to commissioner.* All the records of the Province of Prince Edward Island shall be handed over by the officers in charge of them to the commissioner of patents of invention, to form part of the records of the patent-office for the purposes of the Act hereby amended and of the Acts amending the same and of this Act.

8. *Proceedings for impeachment of patents.* Any person desiring to impeach any patent issued under The Patent Act of 1872, as amended by subsequent Acts and by this Act, the petitioner for which has elected his domicile at any place in Prince Edward Island, may obtain a sealed and certified copy of the patent and of the petition, affidavit, specification and drawings thereunto relating, and may have the same filed in the office of the clerk of the Supreme Court of Judicature in that province,—which court shall adjudicate on the matter and decide as to costs. The patent and documents aforesaid shall then be held as of record in such court, so that a writ of scire facias under the seal of the court grounded upon such record may issue for the repeal of the patent, for cause as aforesaid, if upon proceeding had upon the writ in accordance with the meaning of this Act, the patent be adjudged to be void.

9. *Act to be one with former Acts.—Short title.* This Act shall be read and construed as one Act with the Act hereby amended, and the two Acts amending the same; and the said four Acts may be cited together as The Patent Acts, 1872 to 1875.

From Richards' Digest of Patent Laws, &c. (of Canada), 24.

Act of April 19, 1884, Stat. 47 Vict. c. 38.

1. *A bill or note given for a patent right or interest therein, to have certain words on its face.* A bill of exchange or promissory note, the consideration of which consists in whole or in part of the purchase money of a patent right, or of a partial interest (limited geographically or otherwise) in a patent right, shall have written or printed prominently and legibly across the face thereof, before the same is issued, the words "given for a patent right."

2. *Purchaser or holder of such instrument to take it subject to certain rights of defense.* The indorsee or other transferee of any such instrument having the words aforesaid so printed or written thereon shall take the same subject to any defense or set-off in respect of the whole or any part thereof, which would have existed between the original parties.

3. *Punishment for inducing any one to make, take, &c. such bill or note without certain words to it.* Any one who issues, sells or transfers by indorsement or delivery any such instrument not having the words "given for a patent right" printed or written in manner aforesaid across the face thereof, knowing the consideration of such instrument to have consisted in whole or in part of the purchase money of a patent right, or of a partial interest (limited geographically or otherwise) in a patent right, shall be guilty of a misdemeanor, and shall be liable to be imprisoned in any jail or other place of confinement for any term not more than once year, or to such fine as the judge may think fit, not exceeding two hundred dollars.

From Richards' Digest of Patent Laws, &c. (of Canada).

CAPE COLONY : CAPE OF GOOD HOPE.

*Act to provide for the granting, in this Colony, of Patents for Inventions. No. 17 of 1860.**

Preamble. Whereas it is expedient that the making of new and useful inventions should be encouraged by securing to their inventors, for a limited time, the exclusive enjoyment thereof: Be it enacted by the Governor of the Cape of Good Hope, with the advice and consent of the Legislative Council and House of Assembly thereof, as follows :

I. *Interpretation of terms.* In the interpretation of this Act the term "invention" shall bear and have the same meaning as the term "invention" bears and has in the Act of the Imperial Parliament, the 15th and 16th of Her Majesty, chapter 83, and the term "letters patent" shall mean authorizations granted by the governor under the public seal of the colony, and the term "proceeding in the nature of a scire facias" shall mean as much as may be what the same term would mean if used in an Act of the Imperial Parliament.

II. *Power to grant patents.* It shall be lawful to make and issue in the manner hereinafter mentioned, letters patent granting to the true and first inventor of any invention the privilege of the sole and exclusive working, making, and enjoyment of such invention, within this colony, for any term not exceeding fourteen years from the date of such letters patent.

III. *Governor to make rules for executing this Act.* It shall be lawful for the governor, with the advice of the Executive Council, from time to time to make such rules and regulations, not inconsistent with the provisions hereof, as may appear to be necessary and expedient for the purposes of this Act, and all such rules and regulations shall be laid before both Houses of Parliament within fourteen days after the making thereof, if Parliament be sitting, and if Parliament be not sitting, then within fourteen days after the next meeting in Parliament.

IV. *Applicants to deposit specifications.—They may be amended.*

* A translation of this law differing very slightly from that presented in the text, and without the schedules, except

the schedule of fees, may be found in 20 *Pat. Off. Gaz.* 1167.

All applications under this Act for the grant of letters patent for an invention shall be made as follows, that is to say, the applicant shall deposit at the office of the colonial secretary an instrument in writing under his hand, particularly describing and ascertaining the nature of the said invention, and in what manner the same is to be performed, and also a copy of such instrument, and of the drawings accompanying the same, if any; and the day of the deposit of every such specification shall be recorded at the said office, and indorsed upon such specification, and a certificate thereof given to such applicant or his agent; and thereupon, subject and without prejudice to the provisions hereinafter contained, the said invention shall be protected under this Act, for the term of six months next after the said deposit, and the applicant shall have during such term the like powers, rights, and privileges as might have been conferred on him by letters patent for such invention issued under this Act, and duly sealed, as of the day of such deposit, and during the continuance of such powers, rights, and privileges under this provision, such invention may be used and published without prejudice to any letters patent to be granted for the same; and where letters patent are granted in respect of such invention, such letters patent shall be conditioned to become void if such specification does not particularly describe and ascertain the nature of the said invention, and in what manner the same is to be performed: Provided always, that in the case the title of the invention or the said specification be too large or insufficient, it shall be lawful for the attorney-general hereinafter mentioned, during the said term of six months, and before the grant of the letters patent, to allow or require such specification to be amended, or another and sufficient specification to be deposited in lieu thereof; and every such amended or new specification shall have the force, effect, and operation as if it had been originally deposited in its amended state.

V. *Patent not affected by specification of pretended inventor.* In case of the deposit of any such specification as aforesaid, in fraud of the true and first inventor, any letters patent granted to the true and first inventor of any such invention shall not be invalidated by reason of such deposit, or of any use or publication of the invention subsequent to such deposit, and before the expiration of the said term of protection.

VI. *Mode of proceeding after deposit of specification.* The applicant so soon as he shall think fit after the deposit of such specification as aforesaid, and of the drawings and models accom-

panying the same, if any, may give notice in writing at the office of the attorney-general of his intention to proceed with his application for letters patent for the said invention, stating in such notice the title of the said invention, and the day on which the specification thereof was deposited at the office of the colonial secretary, and at the time of giving such notice shall produce the said certificate of deposit; and thereupon the said attorney-general shall deliver to the applicant or his agent an appointment in the form contained in the second schedule to this Act, or to the like effect; and such applicant or agent shall cause the said appointment to be published once in the Government Gazette, once in some newspaper published in the city of Cape Town, and twice in some newspaper published in the town or place at or near to which the applicant uses or exercises the said invention, or (in case he does not use or exercise the same) in or near to which he resides, or if there shall be no newspaper published in such town or place, then twice in some newspaper circulating in the neighborhood where he uses or exercises the said invention, or (in case he does not use or exercise the same) where he resides; and any persons having an interest in opposing the grant of letters patent for the said invention shall be at liberty to leave particulars in writing of their objections to the said application at the office of the attorney-general within such time, not being less than one month, as the said attorney-general by such appointment may direct.

VII. *Attorney-general to hear applications and objections, and award costs.* At the time and place named in the said appointment the applicant shall produce the newspapers containing the same, and the attorney-general shall thereupon hear and consider the said application and all objections to the same mentioned in the said particulars, if any, and for that purpose shall obtain from the office of the colonial secretary the copy of the said specification, and of the drawings and models accompanying the same, if any, and may call to his aid such scientific or other person or persons as he may think fit, and may, by writing under his hand, order to be paid to such person or persons some remuneration for his or their attendance, and may also in like manner order that the costs of any hearing, upon any objection or otherwise, in relation to the grant of such letters patent or the protection acquired by the applicant under this Act, shall be paid, and in and by such writing shall fix the amount of such remuneration or costs, and by or to whom the same respectively shall be paid; and every such order shall be in

the form contained in the third schedule to this Act or to the like effect, and may be made a rule of the Supreme Court: Provided always, that the applicant, the objectors, and their respective witnesses and evidence, shall be respectively heard, examined, and considered separately, and apart from and in the absence of the other and his witnesses and evidence.

VIII. *Attorney-general may issue grant for patent.* The attorney-general after such hearing and consideration may issue a warrant under his hand for the granting of letters patent for the said invention, and by such warrant shall direct the insertion in such letters patent of all such restrictions, conditions, and provisos as he may deem usual and expedient in such grants, or necessary in pursuance of this Act, and the said warrant shall be the warrant for the making and sealing of letters patent under this Act, according to the tenor of the said warrant; and every such warrant shall be in the form contained in the fourth schedule to this Act, or to the like effect.

IX. *Patent may be repealed or withheld, and specifications canceled.* A writ of the Supreme Court, in the nature of a writ of scire facias in England, shall lie for the repeal of any letters patent granted under this Act, and it shall be lawful for the Governor, with the advice aforesaid, to order such attorney-general to withhold such warrant as aforesaid, or that any letters patent, for the granting whereof he has issued a warrant, shall not issue, or to order the insertion in any such letters patent of any restrictions, conditions, and provisos, in addition to or in substitution for any restrictions, conditions, or provisos which would otherwise be inserted therein under this Act; and it shall also be lawful for the Governor, with the advice and consent aforesaid, to order any specification in respect of the invention described in which no letters patent may have been granted, to be canceled, and thereupon the protection obtained by the deposit of such specification shall cease.

X. *Patent void on non-performance of conditions.* All letters patent for inventions granted under this Act shall be in the form contained in the fifth schedule to this Act, or to the like effect, and be made subject to the condition that the same shall be void, and that the powers and privileges thereby granted shall cease and determine at the expiration of three years and seven years respectively from the date thereof, unless there be paid within the said three and seven years respectively the sum or sums of money in that behalf hereby required to be paid, and the colonial secretary

shall issue under his hand a certificate of such payment, and shall indorse a receipt for the same on the letters patent.

XI. *Patent to be issued within three months.* The colonial secretary, so soon after the receipt by him of the warrant aforesaid as required by the applicant, shall cause to be prepared letters patent for the invention according to the tenor of the said warrant; and it shall be lawful for the Governor, with the advice of the Executive Council, to cause letters patent to be sealed with the public seal of the colony, and such letters patent shall be made applicable to the said colony, and shall be valid and effectual as to the whole of the same; but, except as hereinafter mentioned, no letters patent shall issue on any warrant granted as aforesaid, unless application be made to seal such letters patent within three months after the date of the said warrant, nor unless such letters patent be granted during the continuance of the protection conferred under this Act by reason of such deposit as aforesaid.

XII. *Patent may issue after that time, in certain cases.* Where the application to seal such letters patent has been made during the continuance of such protection as aforesaid, and the sealing of such letters patent has been delayed from accident, and not from the neglect or willful default of the applicant, then such letters patent may be sealed at such time, not being more than one month after the expiration of such protection as the Governor, with the advice aforesaid, shall direct; and where the applicant for such letters patent dies during the continuance of such protection as aforesaid, such letters patent may be granted to the executors, testamentary or dative, of such applicant during the continuance of such protection, or at any time within three months after the death of such applicant, notwithstanding the expiration of the term of such protection; and the letters patent so granted shall be of the like force and effect as if they had been granted to such applicant during the continuance of such protection; and in case any letters patent shall be destroyed or lost, other letters patent of the like tenor and effect, and sealed and dated as of the same day, may, subject to such regulations as the Governor, with the advice aforesaid, may direct, be issued under the authority of the warrant in pursuance of which the original letters patent were issued.

XIII. *Patent to bear date of deposit of specification.* All letters patent to be issued in pursuance of this Act shall be sealed and bear date as of the day of the deposit of such specification as aforesaid, and shall be of the same force and validity as if they had been

sealed on the day as of which the same are expressed to be sealed and bear date ; and after any letters patent shall have been granted or issued under this Act it shall not be necessary or admissible to inquire or ascertain whether such appointment as aforesaid has or has not been delivered and published in the manner hereinbefore mentioned and directed.

XIV. *Patent for foreign invention ends with foreign patent.* Where, upon any application made under this Act, letters patent are granted for or in respect of any invention, first invented in parts out of the Colony of the Cape of Good Hope, and a patent or like privilege for the monopoly or exclusive use or exercise of such invention in any parts out of the Cape of Good Hope is obtained before the grant of such letters patent in the Cape of Good Hope, all rights and privileges under such letters patent shall, notwithstanding any term in such letters patent limited, cease and be void immediately upon the expiration or other determination of the term during which the patent or like privilege obtained in such part out of the Cape of Good Hope shall continue in force, or, where more than one such patent or like privilege is obtained abroad, immediately upon the expiration or determination of the term which shall first expire or be determined of such several patents or like privileges : Provided always, that no letters patent for or in respect of any invention for which any such patent or like privilege as aforesaid shall have been obtained abroad, granted in the Cape of Good Hope after the expiration or determination of the term for which such patent or privilege was granted or was in force, shall be of any validity.

XV. *Patent not to prevent use of inventions in foreign ships.* No letters patent for any invention, granted after the passing of this Act, shall extend to prevent the use of such invention in any foreign ship or vessel, or for the navigation of any foreign ship or vessel which may be in any port of the Cape of Good Hope, in case such invention is not so used for the manufacture of any goods or commodities to be vended within or exported from the same.

XVI. *Specification to be filed after issue of patent, &c.* Every specification deposited at the office of the colonial secretary as aforesaid, and the drawings and models accompanying the same, if any, shall forthwith, after the grant of the letters patent, or if no letters patent be granted, then immediately on the expiration of six months from the time of such deposit, be transferred to and kept in

such office as the governor, with the advice aforesaid, shall from time to time appoint for that purpose.

XVII. *Notice of application to disclaim or make alterations.* Any person who shall obtain letters patent under this Act, or in case such person shall depart with the whole or any part of his interest by assignment, such person, together with the assignee (if part only has been assigned), or the assignee alone (if the whole hath been assigned), may apply to the attorney-general for leave to enter a disclaimer of any part of either the title of the invention or of the specification, or a memorandum of any alteration in the said title or specification, not being such disclaimer or such alteration, as shall extend the exclusive right granted by the said letters patent; and thereupon the attorney-general shall deliver to such patentee and assignee, or either of them, or to their or either of their agents, an appointment in the form contained in the sixth schedule to this Act, or to the like effect, and such patentee or assignee shall thereupon cause such disclaimer (stating the reason for the same) or such memorandum of alteration to be written at the foot of such appointment, and shall cause the same respectively to be published in the manner hereinbefore required, with respect to the said first-mentioned appointment, and any person having an interest in opposing the said application shall be at liberty to leave particulars, in writing, of their objections to the same, at the office of the attorney-general, within such time, not being less than one month, as the said attorney-general by such appointment may direct: Provided always, that where such application as aforesaid shall be for leave to enter a disclaimer of any part of the title of the said invention, or a memorandum of any alteration in such title, the attorney-general may dispense with such appointment and publication, and in that case shall certify in the fiat hereinafter mentioned, that he has dispensed with the same.

XVIII. *Application for disclaimer to be heard.* At the time and place named in such appointment, the said patentee and assignee, or one of them, shall produce the newspapers containing the same, and the said disclaimer or memorandum of alteration at the foot thereof; and the attorney-general shall thereupon hear and consider the said application, and all objections to the same mentioned in the said particulars, if any, and all such power and authority shall and may be exercised on such occasion by the attorney-general, as by virtue of the provisions hereinbefore contained can and may be exercised in relation to the hearing and considering an application

for letters patent, and objections to the same, and shall and may be enforced in the same manner.

XIX. *How disclaimer may be entered, and alterations made.* After such hearing and consideration, or without such hearing and consideration where the said appointment and publication shall have been dispensed with, as aforesaid, such patentee and assignee, or either of them, may, by leave of the attorney-general, to be certified by a fiat under his hand (to be written at the foot of the same parchment with the said disclaimer or memorandum), enter such disclaimer, stating the reason for the same, or such memorandum of alteration; and at the time of entering such disclaimer or memorandum of alteration shall deposit a copy thereof in the office next hereinafter mentioned, and such disclaimer or memorandum of alteration being filed in such office as the Governor, with the advice aforesaid, shall from time to time appoint for that purpose, shall be deemed and taken to be part of such letters patent or such specification, and subject to the several incidents thereof in all colonial courts, and shall be valid and effectual in favor of any person in whom the rights under the said letters patent may then be, or hereafter become, legally vested; and no objection shall be allowed to be made in any proceeding upon, or touching such letters patent, specification, disclaimer, or memorandum of alteration, on the ground that the person entering such disclaimer or memorandum of alteration had not sufficient authority in that behalf: Provided always, that no action shall be brought upon any letters patent in which, or on the specification of which, any disclaimer or memorandum of alteration shall have been filed in respect of any infringement committed prior to the filing of such disclaimer or memorandum of alteration (unless the attorney-general shall certify in his said fiat that any such action may be brought, notwithstanding the entry or filing of such disclaimer or memorandum of alteration); and no such disclaimer or alteration shall be receivable as evidence in any action or suit (save and except in any proceeding, as aforesaid, in the nature of a scire facias) pending at the time when such disclaimer or alteration was filed as aforesaid; but in every such last mentioned action or suit the original title and specification alone shall be given in evidence, and be deemed and taken to be the title and specification of the invention for which the letters patent have been or shall have been granted: Provided also, that when any such fiat shall have been granted or issued under this Act, it shall not be necessary or material to inquire or ascertain

whether such appointment as last aforesaid has or has not been delivered and published or dispensed with in accordance with this Act; and such filing of any disclaimer or memorandum of alteration, in pursuance of the leave of the attorney-general certified as aforesaid, shall, except in cases of fraud, be conclusive as to the right of the party to enter such disclaimer or memorandum of alteration under this Act.

XX. *Copies of specification, disclaimers, &c., open for inspection.* The copies of all specifications, and the drawings and models accompanying the same, if any, and of all disclaimers and memoranda of alterations respectively deposited under or in pursuance of this Act, shall be open to the inspection of the public at all reasonable times after the grant of letters patent, or if no letters patent be granted, then immediately on the expiration of six months from the time of such deposit, but subject to such regulations as the Governor, with the advice aforesaid, may make in that behalf.

XXI. *Mode of obtaining extension of the term.* If any person having obtained letters patent under this Act, or in case such person shall have departed with his whole, or any part of his interest by assignment, if such person, together with the assignee (where part only hath been assigned) or if the assignee alone (where the whole hath been assigned), shall, six months before the expiration or other termination of such letters patent, present to the Governor a petition for the extension of the term in such letters patent mentioned, and shall set forth in such petition that he or they has or have been unable to obtain a due remuneration for his or their expense or labor in perfecting such invention, and that an exclusive right of using and vending the same for some further period, to be named in such petition, in addition to the said term, is necessary for his or their reimbursement and remuneration, it shall be lawful for the Governor, with the advice aforesaid, to refer the consideration of the said petition to commissioners to be appointed for that purpose in the manner hereinafter mentioned.

XXII. *Mode of obtaining confirmation of invalid patent.* If in any suit or action it shall be proved or specially found by the verdict of a jury that any person who shall have obtained letters patent for any invention or supposed invention was not the first inventor thereof, or of some part thereof, by reason of some other person having invented or used the same or some part thereof, before the date of such letters patent, or if such patentee or his assigns shall discover that some other person had, unknown to such patentee,

invented or used the same or some part thereof before the date of such letters patent, such patentee or his assigns may petition the Governor to confirm the said letters patent, or to grant new letters patent, and it shall be lawful for the Governor, with the advice aforesaid, to refer the consideration of the said petition to commissioners to be appointed for that purpose in the manner hereinafter mentioned.

XXIII. *Governor to appoint commissioners.* For the purpose of considering any such petition as aforesaid, it shall be lawful for the Governor, if, with the advice aforesaid, he shall think fit, to issue and direct in the name of Her Majesty, her heirs or her successors, to five or more persons, of whom some of the judges of the Supreme Court shall be two, a commission reciting such petition, and requiring and authorizing such persons or any three of them, of whom one of the said judges shall be one, to meet at some time, not being less than two months from the publication of the said commission in the Government Gazette, and at some place to be respectively fixed in the said commission, and then and there to consider the said petition and to report to the Governor, in case such petitioner shall have prayed for an extension of the term in the letters patent mentioned, whether any and, if any, what further extension of the said term should be granted, according to the prayer of the said petition, and upon what, if any, conditions, or, in case such petitioner shall have prayed for a confirmation of the letters patent, or for a grant of new letters patent, whether such confirmation or grant should be made.

XXIV. *Notice of commission to be published, and caveats entered.* Two months at least before the time named in the said commission for the consideration of any such petition as aforesaid, the petitioner shall cause to be published in the same manner as is hereinbefore required with respect to the said first-mentioned appointment, an advertisement of the contents of the said commission in the form contained in the seventh schedule to this Act, or to the like effect; and any person having an interest in opposing the said petition shall be at liberty to enter a caveat against the same at the office of the colonial secretary at any time, not being less than one week before the time named in the said commission for the execution thereof.

XXXV. *Commissioners to hear all parties, and report.* At the time and place fixed in the said commission for that purpose, the commissioners shall meet and proceed to consider such petition, and

the petitioner shall be heard by his counsel and witnesses, to prove his case as stated in such petition, and the publication of the said last-mentioned advertisement as required by this Act ; and the persons entering caveats shall likewise be heard by their counsel and witnesses ; and all such witnesses shall be examined upon oath or affirmation, which oath or affirmation such commissioners as aforesaid are hereby authorized and required to administer, and thereupon, and upon hearing and inquiry of the whole matter, in case such petitioner shall have prayed for an extension as aforesaid, the said commissioners may report whether any, and, if any, what further extension of the said term should be granted ; and the Governor is hereby authorized and empowered, if he, with the advice aforesaid, shall think fit, to grant to the petitioner new letters patent for the said invention, for a term not exceeding fourteen years after the expiration of the first term, anything hereinbefore contained to the contrary thereof in anywise notwithstanding ; and such new letters patent shall be sealed and bear date as of the day after the expiration of the term of the first letters patent ; or, in case such petitioner shall have prayed for a confirmation or grant as aforesaid, such commissioners, upon examining the said matter, and being satisfied that such patentee, as aforesaid, believed himself to be the first and original inventor, and being satisfied that such invention, or part thereof, had not been publicly and generally used before the date of such first letters patent, may report to the Governor their opinion that the prayer of such petition ought to be complied with, whereupon the Governor may, if he, with the advice aforesaid, shall think fit, grant such prayer ; and the said letters patent shall be available at law and in equity to give to such petitioner the sole right of using, making and vending such invention, as against all persons whatsoever, anything hereinbefore contained to the contrary thereof notwithstanding: Provided that any person, party to any former action or suit touching such first letters patent as last aforesaid, shall be entitled to have notice in writing of the time and place fixed, as aforesaid, for the first meeting of the said commissioners to consider the said petition, and after any such report shall have been made, it shall not be material to inquire or ascertain whether any such advertisement as last aforesaid has or has not been published, or whether any such notice as last aforesaid has or has not been given in the manner hereinbefore directed in that behalf.

XXVI. *Indexes to specifications, disclaimers, &c.* The governor,

with the advice aforesaid, may cause indexes to all specifications, disclaimers, and memoranda of alterations heretofore or to be hereafter enrolled or deposited as aforesaid, to be prepared in such form as may be thought fit, and such indexes shall be open to the inspection of the public at such places as the governor, with the advice aforesaid, shall appoint, and subject to the regulations to be made as hereinbefore provided.

XXVII. *Register of patents to be kept.* There shall be kept at the office to be appointed as aforesaid, a book or books to be called the "Register of Patents," wherein shall be entered and recorded in chronological order all letters patent granted under this Act, the deposit and filing of specifications, disclaimers, and memoranda of alterations filed in respect of such letters patent, all amendments in such letters patent and specifications, all confirmations and extensions of such letters patent, the expiry, determination, vacating, or canceling such letters patent, with the dates thereof respectively, and all other matters and things affecting the validity of such letters patent as the Governor, with the advice aforesaid, may direct; and such register or a copy thereof shall be open at all convenient times to the inspection of the public, subject to such regulations as the governor, with the advice aforesaid, may make in that behalf.

XXVIII. *Register of proprietors to be kept.* There shall be kept at the same office a book or books entitled "The Register of Proprietors," wherein shall be entered, in such manner as the governor, with the advice aforesaid, shall direct, the assignment of any letters patent, or of any share or interest therein, any license under letters patent, and the district to which such license relates, with the name or names of any person having any share or interest in such letters patent or license, the date of his or their acquiring such letters patent, share, and interest, and any other matter or thing relating to or affecting the proprietorship in such letters patent, or license; and a copy of any entry in such book, certified as hereinafter mentioned, shall be given to any person requiring the same, and shall be *prima facie* proof of the assignment of such letters patent, or share, or interest therein, or of the license or proprietorship as therein expressed: Provided always, that until such entry shall have been made, the grantee or grantees of the letters patent shall be deemed and taken to be the sole and exclusive proprietor or proprietors of such letters patent, and of all the licenses and privileges thereby given and granted, and such register,

or a copy, shall be open to public inspection subject to such regulations as the governor, with the advice aforesaid, may make.

XXIX. *Falsification or forgery of entries.* If any person shall willfully make, or cause to be made, any false entry in the said registry, or shall willfully make or forge, or cause to be made or forged, any writing falsely purporting to be a copy of any entry in the said book, or shall produce or tender, or cause or suffer to be produced or tendered in evidence, any such writing, knowing the same to be false or forged, he shall be guilty of the crime of contravening this section of this Act, and shall upon conviction be liable to imprisonment with or without hard labor for any period not exceeding five years.

XXX. *Entry may be expunged, or varied, by order of Supreme Court.* If any person shall deem himself aggrieved by any entry made under color of this Act in the said register, it shall be lawful for such person to apply by motion to the Supreme Court for an order that such entry may be expunged, vacated, or varied; and upon any such application, such court may make such order for expunging, vacating, or varying such entry, and as to the costs of such application as to such court may seem fit; and the officer having the care and custody of such registry, on the production to him of any such order, shall expunge, vacate, or vary the said entry according to such order.

XXXI. *Penalty for unauthorized user of word "Patent."* If any person shall write, paint, print, mould, cast, carve, engrave, stamp, or otherwise mark upon anything made, used, or sold by him, for the sole making or selling of which he 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 or vending of such thing, without leave in writing of such patentee or his assigns: or if any person, shall, upon such thing not having been purchased from the patentee, or some person who purchased it from or under such patentee, or not having had the license or consent in writing of such patentee or his assigns, write, paint, print, mould, cast, carve, engrave, stamp, or otherwise mark the word "Patent," the words "Letters Patent," or the words "By the Queen's Patent," or any words of the like kind, meaning, or import, with a view of imitating or counterfeiting the stamp, mark, or other device of the patentee, he shall for every such offense forfeit and pay the sum of one hundred pounds, one half to Her Majesty, Her heirs and successors, and the other half, with full

costs of suit, to any person who shall sue for the said penalty by action of debt: Provided always, that nothing herein contained shall be construed to extend to subject any person to any penalty in respect of stamping, or in any way marking the word "Patent," upon anything for the sole making or vending of which letters patent before obtained shall have expired or otherwise determined.

XXXII. *In actions for infringement, particulars of breaches and objections to be delivered.* In any action for the infringement of letters patent the plaintiff shall deliver with his declaration particulars of the breaches complained of in the said action, and the defendant on pleading thereto shall deliver with his pleas, and the prosecutor in any proceedings in the nature of scire facias to repeal letters patent, shall deliver with his declaration particulars of any objections on which he means to rely at the trial in support of the pleas in the said action, or of the suggestions of the said declaration respectively; and at the trial of such action or proceedings, no evidence shall be allowed to be given in support of any alleged infringement, or of any objection impeaching the validity of such letters patent, which shall not be contained in the particulars delivered as aforesaid: Provided always, that the place or places at or in which and in what manner the invention is alleged to have been used or published prior to the date of the letters patent, shall be stated in such particulars: Provided also, that it shall and may be lawful for any judge at chambers to allow such plaintiff, or defendant, or prosecutor respectively, to amend the particulars delivered as aforesaid, upon such terms as to such judge may seem fit: Provided also, that at the trial of any proceeding to repeal letters patent, the defendant shall be entitled to begin and give evidence in support of such letters patent, and in case evidence shall be adduced on the part of the prosecutor impeaching the validity of such letters patent, the defendant shall be entitled to the reply.

XXXIII. *Particulars to be regarded in taxing costs.* In taxing the costs in any action for infringing letters patent, regard shall be had to the particulars delivered in such action; and the plaintiff and defendant respectively shall not be allowed any costs in respect of any particular, unless certified by the court before which the trial was had, to have been proved by such plaintiff or defendant respectively; and it shall be lawful for the court before which any such action shall be tried, to certify on the record that the validity of the letters patent in the declaration mentioned came in question, and the record with such certificate being given in evidence in any suit or

action for infringing the said letters patent, or in any proceeding in the nature of a scire facias to repeal the letters patent, shall entitle the plaintiff in any such suit or action, or the defendant in any such proceeding, on obtaining a decree or judgment, to his full costs, charges, and expenses, to be taxed as between attorney and client, unless the court making such judgment, decree, or order shall certify that the plaintiff or defendant respectively ought not to have such full costs.

XXXIV. Fees on obtaining patents. There shall be paid in respect of letters patent applied for or issued as herein mentioned, the depositing of specifications, disclaimers, and memoranda of alterations, warrants, certificates, entries, and searches, and other matters and things respectively mentioned in the last schedule to this Act, such fees as are enumerated in that schedule; and such of the said fees as are thereby made payable to the attorney-general, as well as the residue thereof, shall form part of the colonial revenue.

XXXV. English patents subject to this Act. All letters patent which shall be granted in the United Kingdom of Great Britain and Ireland after the first day of July, in the year of Our Lord one thousand eight hundred and sixty, for any invention, shall, so far as the same relate to this said colony, be utterly void and of none effect, and in nowise be put in execution: But all such letters patent granted in the said United Kingdom on or before that day, and which, if this Act had not been passed, would have been valid in this colony, shall be deemed and taken to have been granted under this Act and may be dealt with accordingly.

SCHEDULES.

THE FIRST SCHEDULE.

To all to whom these presents shall come, I, John Doe, of Cape Town, engineer, send greeting: Whereas I am desirous of obtaining letters patent for securing unto me Her Majesty's special license that I, my executors and assigns, and such others as I or they should at any time agree with, and no others, should and lawfully might, from time to time and at all times during the term of fourteen years (to be computed from the day on which this instrument shall be left at the office of the colonial secretary), make, use, exercise, and vend within the colony of the Cape of Good Hope, an invention for [*insert the title of the invention*]; and in order to obtain the said letters patent, I must, by an instrument in writing under my hand, particularly describe and

ascertain the nature of the said invention, and in what manner the same is to be performed and must also enter into the covenant herein-after contained ; Now know ye that the nature of the said invention and the manner in which the same is to be performed, are particularly described and ascertained in and by the following statement, that is to say [*describe the invention*]. And I do hereby, for myself, my heirs and executors, covenant with Her Majesty, her heirs and successors, that I believe the said invention to be a new invention as to the public use and exercise thereof, and that I do not know or believe that any person other than myself is the true and first inventor of the said invention, and that I will not deposit these presents at the office of the colonial secretary with any such knowledge or belief as last aforesaid. In witness whereof I have hereunto set my hand at Cape Town this day of
186 .

SECOND SCHEDULE.

Patent for [*insert the title as in the specification*].

This is to notify that John Doe, of, &c., did, on the day of instant (or last) deposit at the office of the colonial secretary in Cape Town, a specification or instrument in writing under his hand, particularly describing and ascertaining the nature of the said invention, and in what manner the same is to be performed, and that by reason of such deposit the said invention is protected and secured to him exclusively for the term of six calendar months thence next ensuing. And I do further notify that the said John Doe has given notice in writing at my office, of his intention to proceed with his application for letters patent for the said invention, and that I have appointed [*Thursday*] the day of next, at o'clock in the noon, at my office, to hear and consider the said application and all objections thereto ; and I do hereby require all persons having an interest in opposing the grant of such letters patent to leave, before that day, at my office in Cape Town, particulars in writing of their objections to the said application, otherwise they will be precluded from urging the same.

Given under my hand, this day of , 186 .

W. P., Attorney General.

THIRD SCHEDULE.

Upon hearing the objection of A. B., to the grant to John Doe, of letters patent for [*insert the title as in the specification*], I do by this writing under my hand, order that the said A. B. shall pay to the said John Doe the sum of for the costs of such hearing [or to E. F. the sum of as a remuneration for his attendance at such hearing].

Given under my hand, this day of 186 .

W. P., Attorney General.

FOURTH SCHEDULE.

I have heard and considered the application of John Doe for letters patent for [*insert the title as in the specification*], and also all objections to the same, and having perused the specification and the usual and necessary advertisements, am of opinion that as it is entirely at the hazard of the said applicant whether the said invention is new and will have the desired success, Her Majesty's royal letters patent may be issued in the form contained in the fifth schedule to the Act [*with the following additional clauses, that is to say : here set them out, if any*].

Given under my hand, this day of 186 .

W. P., Attorney General.

FIFTH SCHEDULE.

VICTORIA, by the grace of God, of the United Kingdom of Great Britain and Ireland, Queen, Defender of the Faith, to all to whom these presents shall come, greeting: Whereas John Doe, of in the division of , engineer, hath represented that he is desirous of obtaining our royal letters patent for securing unto him our special license that he, his executors and assigns, and such others as he or they should agree with, and no others, should and lawfully might make, use, vend, and exercise within our colony of the Cape of Good Hope, an invention for [*insert the title of the invention*], and by an instrument in writing under his hand deposited in the office of the colonial secretary, the said John Doe hath particularly described and ascertained the nature of the said invention, and in what manner the same is to be performed: And we, being willing to give encouragement to all arts and inventions which may be for the public good, are graciously pleased to confer upon the said John Doe the privileges herein-after mentioned. Know ye, therefore, that we of our especial grace, certain knowledge, and mere motion have given and granted, and by these presents, for us, our heirs and successors, do give and grant unto the said John Doe, his executors and assigns, our especial license, full power, sole privilege, and authority, that he, the said John Doe, his executors, administrators, and assigns, and every of them, by himself and themselves, or his and their deputy or deputies, servants or agents, or such others as he or they shall at any time agree with, and no others, during the term herein expressed, shall and lawfully may make, use, exercise, and vend his said invention within our said colony, in such manner as to him, his executors and assigns, or any of them, shall seem meet; and that he, his executors and assigns, shall and lawfully may have and enjoy the whole profit, benefit, commodity and advantage, from time to time coming, growing, accruing, and arising by reason of the said invention, during the said term: to have, hold, exercise, and enjoy the said licenses, powers, privileges, and advantages unto and by the said John Doe, his executors and assigns, for and during and unto the full end and term of years now next ensuing. And to the end that he, his executors and assigns, and every of them, may have and enjoy the full benefit and the sole use and exercise of the said invention, according to our gracious intention, we do by these presents, for us, our heirs and successors, require and strictly command all and every person and persons, whatsoever, of what estate, quality, degree, name, or condition soever they be within our said colony, that neither they, nor any of them, at any time during the said term, either directly or indirectly, do make, use, or put in practice the said invention, or any part of the same, so attained unto by the said John Doe as aforesaid, nor in any wise counterfeit, imitate, or resemble the same, nor shall make or cause to be made any addition thereunto, or subtraction from the same, whereby to pretend himself or themselves the inventor or inventors, deviser or devisors thereof, without the consent, license, or agreement of the said John Doe, his executors or assigns, in writing under his or their hands first had and obtained in that behalf, upon such pains and penalties as can or may be justly inflicted on such offenders for their contempt of this our royal command; and further to be answerable to the said John Doe, his executors and assigns, according to law, for his and their damage thereby occasioned: Provided always, and these our letters patent are and shall be upon this condition, that if at any time during the said term hereby granted, it shall appear that this our grant is contrary to law, or prejudicial or inconvenient to our subjects in general, or that the said invention is not a new invention as to the public use and

exercise thereof, or that the said John Doe is not the first and true inventor thereof within this colony, these our letters patent shall forthwith cease, determine, and be utterly void to all intents any purposes, anything herein-before contained to the contrary thereof in anywise notwithstanding; Provided also, that these our letters patent, or anything herein contained, shall not extend, or be construed to extend, to give privilege unto the said John Doe, his executors and assigns, or any of them, to use or imitate any invention or work whatsoever which hath heretofore been found out or invented by any other of our subjects whatsoever, and publicly used or exercised, unto whom our like letters patent or privileges have been already granted for the sole use and exercise and benefit thereof, within our said colony; it being our will and pleasure that the said John Doe, his executors and assigns, and all and every person and persons to whom like letters patent or privileges have been already granted as aforesaid, shall distinctly use and practice their several inventions by them invented and found out, according to the true intent and meaning of the same respective letters patent and of these presents: Provided likewise nevertheless, and these our letters patent are upon this express condition, that if the said instrument in writing does not particularly describe and ascertain the nature of the said invention, and in what manner the same is to be performed, and also, if the said John Doe, his executors or assigns, shall not pay at the office of the colonial secretary of our said colony the sum of pounds within three years next after the date of these presents, and the sum of pounds within seven years next after such date, that then, and in any of the said cases, these our letters patent and all liberties and advantages whatsoever hereby granted shall utterly cease, determine, and become void, anything herein-before contained to the contrary hereof in anywise notwithstanding; provided that nothing herein contained shall prevent the granting of licenses in such manner and for such considerations as they may by law be granted: And, lastly, we do by these presents, for us, our heirs and successors, grant unto the said John Doe, his executors and assigns, that these our letters patents shall be in and by all things good, firm, valid, sufficient, and effectual in the law, according to the true intent and meaning thereof, and shall be taken, construed, and adjudged in the most favorable and beneficial sense for the best advantage of the said John Doe, his executors and assigns.

In witness whereof we have caused these our letters to be made patent, and to be sealed and bear date as of the day of .

THE SIXTH SCHEDULE.

Patent for [insert the title].

This is to notify to all whom it may concern, that John Doe, of, &c., has applied to me for leave to enter a disclaimer of part [or memorandum of alteration, as the case may be] of the said invention, the particulars whereof are stated below; I do therefore appoint [Thursday] the day of next, at o'clock in the noon, to hear and consider the said application, and all objections to the same. And I do hereby require all persons having an interest in opposing the said application to leave, before that day, at my office in Cape Town, particulars in writing of their objection to the same, otherwise they will be precluded from urging such objections.

Given under my hand this day of .

W. P., Attorney-General.

The following is the disclaimer [or as the case may be] which I desire to make in, &c. [the applicant must here set forth what he wishes to enter, and sign it].

THE SEVENTH SCHEDULE.

Patent for [insert the title].

Notice is hereby given that I have presented a petition to His Excellency the Governor, praying for the confirmation of [*or extension of the term in*] the said patent, and that a commission has issued authorizing and requiring certain commissioners therein named to consider and report upon the subject to the said Governor, which said commissioners will meet for that purpose on the day of next, at o'clock in the noon, at . All persons objecting to the said confirmation [*or extension*] must enter a caveat against the same at the office of the colonial secretary in Cape Town, otherwise they will be precluded from objecting to it.

Dated this day of

JOHN DOE.

THE LAST SCHEDULE.

	£	s.	d.
On depositing specification.....	2	10	0
To the attorney-general for any "appointment".....	2	4	6
On obtaining letters patent.....	2	10	0
At or before the expiration of the third year.....	10	0	0
At or before the expiration of the seventh year.....	20	0	0
To the attorney-general with particulars of objections.....	2	4	6
On presenting petition for extension or confirmation.....	2	10	0
Every search and inspection.....	0	1	0
Entry of assignment or license.....	0	10	0
Certificate of assignment or license.....	0	10	0
Filing memorandum of alteration or disclaimer.....	2	10	0
Entering any caveat.....	2	10	0
Copy or extract of any writing per common law folio.....	0	1	0

From *Carp. Pat. L. of World*, 127.

CENTRAL AMERICA.

See COSTA RICA, GUATEMALA, NICARAGUA, SALVADOR.

CEYLON.

An Ordinance for granting exclusive Privileges to Inventors ; No. 6 (of November 2), 1859.

Preamble. Whereas it is expedient for the encouragement of inventors of new manufactures, that certain exclusive privileges in their inventions should be granted to them in Ceylon, it is enacted by the Governor of Ceylon, with the advice and consent of the Legislative Council thereof, as follows :—

1. *Short title of ordinance.* This ordinance may be cited for all purposes as the “Inventions Ordinance, 1859.”

2. *Commencement of ordinance.* This ordinance shall come into operation on the day of passing the same.

3. *Inventor may petition to file specification.—Form, &c., of petition.* The inventor of any new manufacture may petition the Governor for leave to file a specification thereof. Every such petition shall be in writing, in the form or to the effect mentioned in the schedule hereunto annexed, and shall be signed by the petitioner, or, in case the petitioner shall be absent from Ceylon, by an authorized agent, and shall state the name, condition, and place of residence of the petitioner, and the nature of the invention.

4. *Order to file specification.* An *alien ami*, whether resident in Ceylon or not, may petition for leave to file a specification under this ordinance.

5. *Power to refer petition for inquiry and report.* Upon such petition, the Governor may, with the advice of the Executive Council, make an order authorizing the petitioner to file a specification of the invention : Provided always, that before making such order, the governor shall refer the petition to any person or persons for inquiry and report, and such person or persons shall be entitled to a reasonable fee for such inquiry and report, to be paid by the petitioner ; the amount of fee, in case of dispute, to be settled by the district court of Colombo in a summary manner.

6. *Exclusive privilege for fourteen years.—Extension.* If within the space of six months from the date of such order, the petitioner cause a specification of his invention to be filed, in manner hereinafter mentioned, the Governor, with the advice and consent of the Executive Council, may, in the Form D. in the schedule to this ordinance appended, under the public seal of the Island of

Ceylon, grant to the petitioner, his heirs, executors, administrators, and assigns, the sole and exclusive privilege of making, selling, and using the said invention in Ceylon, and authorizing others so to do, for the term of fourteen years from the time of filing such specification ; and for such further term, if any, not exceeding fourteen years from the expiration of the first fourteen years, as the Governor, with the advice of the Executive Council, may think fit to direct, upon petition to be presented by such inventor, at any period, not more than one year, and not less than six months, before the expiration of the exclusive privilege hereby granted.

7. *Order to file specification may be subject to conditions.* An order, authorizing the filing of a specification, or for extending the term of such exclusive privilege as aforesaid, may be made subject to such conditions and restrictions as the Governor, with the advice of the Executive Council, may think expedient.

8. *Specification to be in writing, and to describe invention.* Every specification of an invention filed under this ordinance shall be in writing, and shall be signed by the petitioner, and shall particularly describe and define the nature of the said invention, and in what manner the same is to be carried out.

9. *Petition and specification to be left with colonial secretary ; accompanied by declaration.* Every petition for leave to file a specification, and every specification filed under this ordinance, shall be left with the colonial secretary, and shall be accompanied by a declaration in writing, signed by the petitioner, in the form or to the effect mentioned in the schedule hereunto annexed, marked A. and B. respectively ; and if the inventor be absent from Ceylon, the petition and specification shall also be accompanied by a declaration, signed by the agent who shall present or file the same, to the effect that he verily believes that the declaration purporting to be the declaration of the inventor was signed by him, and that the contents thereof are true ; which declaration shall be in the form hereunto annexed, marked C. The date of the delivery of every such petition and specification shall be indorsed on the same respectively, and shall be also recorded at the office of the colonial secretary.

10. *False statement in declaration punishable as perjury.* Any person who shall willfully and corruptly make any false statement in any declaration required by this ordinance shall be liable to the pains and penalties of perjury.

11. *Payment of fees.* No specification shall be filed until the petitioner shall have paid all fees payable under this ordinance.

12. To be open to inspection. The specification, or a copy thereof, shall be open at all reasonable times, at the office of the colonial secretary, to public inspection, upon payment of a fee of five shillings.

13. Book for the registry of petitions, specifications, &c. A book shall be kept in the office of the colonial secretary, wherein shall be entered every such petition and specification, and every order made upon such petition, or relating to the invention therein mentioned, and every grant of exclusive privilege. Every specification and every such grant as aforesaid shall be numbered according to the order in which it is entered in such book; and a reference shall be made in such book, in the margin of the entry of each specification, to every order relating to the invention.

14. Inspection of registry book.—Certified copy of entry. Such book, or copy thereof, shall be open at all convenient times for the inspection of any person, upon payment of a fee of five shillings; and the said colonial secretary shall cause a copy of any entry therein, certified under his hand, to be given to any person requiring the same, on payment of the expense of copying.

15. Certified copy to be primâ facie evidence. Every such certified copy shall be primâ facie evidence of the document of which it purports to be a copy.

16. When exclusive privilege does not attach. No person shall be entitled to any exclusive privilege under the provisions of this ordinance,

If the invention, at the time of presenting the petition for leave to file the specification, was not a new invention in Ceylon, or

If the petitioner is not the inventor or importer thereof into Ceylon, or

If the specification filed does not particularly describe the nature of the invention, and in what manner the same is to be carried out.

17. New invention.—Knowledge of invention fraudulently acquired.—Public use by actual inventor. An invention shall be deemed a new invention within the meaning of this ordinance, if it shall not, before the time of applying for leave to file the specification have been publicly used in Ceylon. The public use of an invention, prior to the application for leave to file a specification shall not be deemed a public use within the meaning of this section, if the knowledge thereof shall have been obtained surreptitiously, or in fraud of the inventor, or shall have been communicated to the public in fraud of the inventor, or in breach of confidence. Provided

the inventor shall, within six months after the commencement of such public use, apply for leave to file a specification, and shall not previously have acquiesced in such public use. Provided also, that the use of an invention in public by the inventor thereof, or by his servants or agents, or by any other person by his license in writing, shall not be deemed a public use thereof, within the meaning of this ordinance.

18. *Inventor having patent in England may petition.* If an inventor who, prior to the time of applying for leave to file a specification of an invention under this ordinance, shall have obtained Her Majesty's letters patent for the exclusive use of such invention in any part the United Kingdom, but not extending to this island, shall petition the Governor for leave to file a specification of such invention, it shall be competent to the Governor, with the advice of the Executive Council, to make an order authorizing the petitioner to file a specification of the invention and exemplification of the letters patent granted to him. On this being done, the petitioner shall be entitled to the sole and exclusive privilege of making, using and selling the said invention in Ceylon for the term or terms mentioned in the 6th section. Provided the petition for leave to file the specification shall state that such letters patent have been granted, and shall also state the date thereof, and the term during which the same are to continue in force.

19. *Exclusive jurisdiction in the district court of Colombo.* And whereas it is expedient that sole jurisdiction over all actions, suits, and proceedings arising in respect of this ordinance should be vested in the district court of Colombo, to the exclusion of other courts having jurisdiction under the 24th and 29th sections of the Letters Patent of his late Majesty King William the Fourth, bearing date the 18th day of February, 1830; And whereas by Letters Patent of her present Majesty, bearing date the 28th day of January, 1843, it is declared that it shall be competent to the Governor, by any law or ordinance to be by him from time to time made, with the advice and consent of the Legislative Council, to make provision for the better administration of justice within this island, anything in the said Letters Patent of King William the Fourth to the contrary notwithstanding: It is therefore enacted that the said district court of Colombo shall have sole and exclusive jurisdiction over all such actions, suits, and proceedings as aforesaid, wheresoever the same may arise, and to the exclusion of all other district courts in the island, subject, however, to appeal, as hereinafter provided.

20. Particulars to be delivered. In any suit for the infringement of such exclusive privilege the plaintiff shall deliver with his libel particulars of the breaches complained of in said suit, and the defendant, in pleading thereto, shall deliver, with his answer, particulars of the grounds (if any) upon which he means to contend that the plaintiff is not entitled to an exclusive privilege in the invention. In like manner, upon any application to the said district court under the 22nd, 23rd, and 24th sections of this ordinance, the applicant shall deliver particulars of the objections on which he means to rely. At the trial of any such suit or issue, no evidence shall be allowed to be given in support of any alleged infringement or of any objection impeaching the validity of such exclusive privilege, which shall not be contained in the particulars delivered as aforesaid. If it be alleged that the invention was publicly known or used prior to the date of the petition for leave to file such specification, the places where and the manner in which the invention was so publicly known or used, shall be stated in such particulars. Provided always, that it shall be lawful for the court in which the suit or proceeding is pending, or in which the issue is tried, to allow the plaintiff or defendant respectively to amend the particulars delivered as aforesaid, upon any such terms as shall seem fit.

21. Defect in specification or petition, or want of novelty in invention, &c., no defense.—Actual use a defense. No such suit shall be defended upon the ground of any defect or insufficiency of the specification of the invention, nor shall any such suit be defended upon the ground of a misdescription of the invention in the petition; unless the defendant shall show that he is the actual inventor or derives title from him.

22. Application to declare exclusive privilege not acquired. It shall be lawful for any person to apply by motion to the district court of Colombo for a rule to show cause why the court should not declare that an exclusive privilege in respect of an invention has not been acquired under the provisions of this ordinance, by reason of all or any of the objections following, (to be specified in the rule,) that is to say :—

Invention not new. That the said invention was not, at the time of presenting the petition for leave to file the specification, a new invention; or

Petitioner not the inventor, &c. That the petitioner was not the inventor thereof, and in addition thereto, either that the appli-

cant was the inventor, or that the inventor has dedicated or made known the invention to the public, or has acquiesced in the public use thereof ; or

Invention not described in specification. That the specification filed does not particularly describe and define the nature of the invention, or in what manner the same is to be carried out ; or

Fraud in petition or specification. That the petitioner has fraudulently inserted in the petition or specification, as part of his invention, something which was not new or whereof he was not the inventor ; or

False statement in petition. That the petitioner has willfully made a false statement in his petition ; or

Fraudulent misdescription of part of invention in specification. That some part of the invention, or the manner in which that part is to be carried out as described in the said specification, is not thereby sufficiently described and defined, and that such defect or insufficiency was fraudulent, and is injurious to the public.

23. *Like application as to part of an invention.* Any person may in like manner apply to the said district court for a rule to show cause why that court should not declare that an exclusive privilege has not been acquired under the provisions of this ordinance, in any part of the invention to be specified in the rule, by reason of all or any of the objections following (to be specified in the rule), that is to say :—

That such part of the invention was not new at the date of the petition for leave to file the specification ; or

That the petitioner was not the inventor of that part of the invention, and, in addition thereto, either that the applicant was the inventor of that part, or that the inventor has dedicated or made known the same to the public, or has acquiesced in the public use thereof ; or

That that part of the invention, and the manner in which it is to be carried out, is not sufficiently described and defined in the specification, and that such defect or insufficiency is injurious to the public.

24. *Application by Queen's advocate on breach of special condition.* It shall be lawful for the Queen's advocate or any deputy Queen's advocate to apply to the said district court for a rule calling upon the petitioner, his executors, administrators, or assigns, to show cause why the question of the breach of any special condition upon which the leave to file a specification has

been granted, or any other question of fact on which the revocation of the exclusive privilege by the Governor under the power hereinafter reserved may, in the judgment of the said Governor, depend, should not be tried in the form of an issue directed by the said court; and if the rule be made absolute, the court, unless the breach or other matter of fact be admitted, may thereupon direct such issue to be tried, and certify the result of such trial to the Governor. The costs of such trial, and also the costs of such proceedings, shall be in the discretion of the said court.

25. *When exclusive privilege shall cease.* Every exclusive privilege under this ordinance shall cease if the governor, with the advice of the Executive Council, shall declare by notification in the Government Gazette that the same, or the mode in which it is exercised, is mischievous to the State, or generally prejudicial to the public; or if a breach of any special condition on which the petitioner shall have been authorized to file a specification, or upon which the term of the exclusive privilege shall have been extended, shall be proved to the satisfaction of the aforesaid district court, and if the governor, with the advice of the Executive Council, shall thereupon declare that such exclusive privilege shall cease.

26. *District court may direct issue for trial.* The said district court may, if it think fit, direct an issue for trial before the same court of any question of fact arising upon an application under sections 22, 23, 24 of this ordinance, and such issue shall be tried accordingly, in a summary manner.

27. *Judgment.* If it shall appear to the said district court at the hearing of any application under the provisions of sections 22 and 23 of this ordinance that, by reason of any of the objections therein mentioned, the said exclusive privilege in the invention or in any part thereof has not been acquired, the court shall give judgment accordingly, and shall make such order as to the costs of and consequent upon the application as it may think just; and thereupon the petitioner, his heirs, executors, administrators, and assigns, shall, so long as the judgment continues in force, cease to be entitled to such exclusive privilege.

28. *Amendment of specification.* If the court, at the hearing of any such application as last aforesaid, shall think that the petitioner has, in the description of his invention in the petition or specification, included something which at the date of the petition was not new, or whereof he was not the inventor, or that the specification is in any particular defective or insufficient, but that the

error, defect, or insufficiency was not fraudulently intended, the said court may adjudge the said exclusive privilege to have been acquired and to be valid save as to the part thereof affected by such error, defect, or insufficiency; or if the court shall think that the error, defect, or insufficiency can be amended without injury to the public, it may adjudge the exclusive privilege in the whole of the invention to be valid, and may, upon such terms as shall appear reasonable, order the specification to be amended in any of the said particulars; and thereupon the petitioner, his heirs, executors, administrators, or assigns, shall, within the time limited by the court for the purpose, file a specification amended according to such order.

29. *Misdescription in petition, not to defeat privilege.* An exclusive privilege shall not be defeated upon the ground that there is any misdescription of the invention in the petition, unless such description was fraudulent.

30. *Entry in Registry Book of judgment, &c.* Whenever it shall be adjudged by the said district court that an exclusive privilege as to the whole or any part of an invention has not been acquired, the colonial secretary shall, upon the production of the judgment or order, cause an entry thereof to be made in the said book hereinbefore directed to be kept, and shall cause a reference to such entry to be made in the margin of the entry of the specification contained in such book.

31. *Actual inventor entitled to assignment of privilege fraudulently obtained.* If upon proceedings instituted within two years from the date of a petition to file a specification the inventor shall prove to the satisfaction of the said district court that the petitioner was not the inventor, and that at the time of the petition he knew, or had good reason to believe, that the knowledge of the invention was obtained by himself, or by some other person surreptitiously or in fraud of the inventor, or by means of a communication made in confidence by the actual inventor, to him or to any person through whom he derived such knowledge, the court may compel the petitioner to assign to the inventor any exclusive privilege obtained under this ordinance, and to account for and pay over the profits thereof.

32. *Service of proceeding.* A book shall be kept in the office of the colonial secretary, (such book to be open to inspection without fee), wherein every person filing a specification under this ordinance shall cause to be stated, under a number corresponding with the

number of the specification, some place in Ceylon where service of any rules or proceedings, for the purpose of canceling or revoking his exclusive privilege, may be made. Any person, partnership, or company, from time to time being proprietors of, or having shares or interest in such exclusive privilege, shall cause to be entered in such book, under such number as aforesaid, their names, together with the name of some place for the service of such proceedings as aforesaid. All such rules and proceedings shall be deemed sufficiently served on any such person, partnership, or company, if a copy thereof be left at the place entered in such book, or (if any other place be substituted for the same, by entry in the said book) at the place last substituted, by delivering the same to any person resident at or in charge of such place, or if there be no person resident at or in charge of such place, or if such place be not within the local limits of the jurisdiction of the court, by causing such rule or proceeding to be sent by post, by a registered letter directed to such person, partnership, or company, at such place; and if any such person, partnership, or company shall neglect to make or cause to be made such entry, then service of such rule or proceeding may be effected by affixing a copy thereof to some conspicuous part of the court-house, or in such other manner as the court may direct, provided that notice of any rule obtained or proceeding taken under either of the sections 22, 23, and 24, shall be served on all persons appearing to be proprietors, or to have shares or interests in the exclusive privilege under the provisions of this section, and it shall not be necessary to serve such notice on any other person.

33. *Prerogative in respect to letters patent saved.* Nothing in this ordinance contained shall abridge or affect the prerogative of the crown in relation to the granting or withholding the grant of any letters patent for inventions, or otherwise, or affect or interfere with any letters patent for an invention heretofore granted or hereafter to be granted by the crown.

34. *Right of appeal saved.* All decisions and orders of the district court of Colombo, made under the authority of this ordinance, shall be subject to an appeal to the Supreme Court, and every such appeal shall be brought on and prosecuted in such manner and shall be subject to such regulations as now exist or shall be hereafter made by law; and subject to the rules and limitations contained in the 52nd clause of the charter, any party or parties to any suit or proceeding under this ordinance may appeal to her

Majesty, her heirs and successors, in her, his, or their Privy Council, from any final judgment, decree, or sentence of the Supreme Court, or against any rule or order made by such Supreme Court, and having the effect of a final or definitive sentence.

35. *Stamp of petition.* Every petition for leave to file a specification under the provisions of this ordinance, or for the extension of the term of an exclusive privilege, shall be written or printed on a stamped paper of the value of ten pounds.

36. *Interpretation.* In the construction of this ordinance, the following words and expressions shall have the meanings hereby assigned to them, unless there be something in the subject or context repugnant to such constructions :—

The word “invention” shall include an improvement. The word “manufacture” shall be deemed to include any art, process, or manner of producing, preparing, or making an article, and also any article prepared or produced by manufacture. The word “inventor” when not used in conjunction with the word “actual” shall include the importer of an invention not publicly known or used in Ceylon. The words “inventor” and “actual inventor” shall include the heirs, executors, administrators, or assigns of an inventor or actual inventor, as the case may be. The word “assigns” shall include grantees of the sole use or benefit in Ceylon, of an invention, or of the sole use of an exclusive privilege, for a limited time. The words “colonial secretary” shall include any person acting as or for the colonial secretary. The words “Queen’s advocate” shall include any person acting as or for the Queen’s advocate.

SCHEDULE.

FORM OF PETITION.

To the Governor of Ceylon.

The petition of [*here insert name, addition, and place of residence*] for leave to file a specification under the Inventions Ordinance, 1859.—Showeth,

That your petitioner is in possession of an invention for [*state the title of the invention*], which invention he believes will be of public utility; that he is the inventor or owner of the said invention [*or, as the case may be, the assignee, or the executor, or administrator, or heir of the inventor or owner of the said invention*]; and that the same is not publicly known or used in Ceylon, to the best of his knowledge and belief [*or, as the case may be, that he is the first importer into Ceylon of the said invention, and that the same is not publicly known or used in Ceylon*].

If letters patent have been obtained for the invention, state according to the requirements of section 18.

The following is a description of the invention [*here describe it*].

Your petitioner therefore prays leave to file a specification of the said invention, pursuant to the provisions of the Inventions Ordinance, 1859.

And your petitioner, &c.

(Signed)

The day of

FORMS OF DECLARATION.

A.

I [*here insert name, addition, and place of residence*] do solemnly and sincerely declare, that I am in possession of an invention for [*state the title of the invention as in the petition*]; that I believe the said invention will be of public utility; that I am the inventor or owner of the said invention [*or, as the case may be, the assignee, or executor, or administrator, or heir of the inventor or owner of the said invention; or, that I am the first importer of the said invention into Ceylon*]; and that the same is not publicly known or used in Ceylon, to the best of my knowledge and belief; and that, to the best of my knowledge and belief, my said invention is truly described in my petition for leave to file a specification thereof.

(Signed)

The day of

B.

I [*here insert name, addition, and place of residence*] do solemnly and sincerely declare that I am in possession of an invention for [*state the title of the invention*], which invention I believe will be of public utility; that I am the inventor or owner of the said invention [*or, as the case may be, the assignee, or executor, or administrator, or heir of the inventor or owner of the said invention; or, that I am the first importer of the said invention into Ceylon*], and that the same is not publicly known or used, in Ceylon, to the best of my knowledge and belief; and that, to the best of my belief the instrument in writing under my hand hereunto annexed particularly describes and defines the nature of the said invention, and in what manner the same is to be carried out.

(Signed)

The day of

C.

I of , do solemnly and sincerely declare, that I have been appointed by the said , his agent for the purpose of , and I verily believe that the declaration purporting to be the declaration of the said marked () was signed by him, and that the contents thereof are true.

(Signed)

The day of

FORM OF GRANT.

D.

VICTORIA, by the grace of God, of the United Kingdom of Great Britain and Ireland, Queen, Defender of the Faith, &c.

To all to whom these presents shall come, greeting.

Whereas A. B. of C. D. has presented to us [*insert name of Governor*] Governor

of Ceylon, a petition (numbered in the book of petitions for exclusive privilege in inventions in the colonial office), praying for leave to file a specification of a certain invention, intituled [*here insert title of invention*], and we have, with the advice and consent of the Executive Council, made an order, dated the day of 18 , authorizing the said A. B. to file a specification of the said invention; and whereas the said A. B. did on the day of 18 , file a specification in accordance with the said order, and the same is entered in the Book of Specifications in the colonial office, and bears the number therein; and whereas the said Governor and the Executive Council are agreed that the said A. B. hath done all things to entitle him to exclusive privilege in the invention in the said petition and specification instituted, mentioned, and described, for the term of years; Now know ye that we, with the advice and consent of the Executive Council, do grant to the said A. B. his heirs, executors, administrators and assigns, the exclusive privilege of making, selling, and using (as the case may be) the said invention in the said specification described in Ceylon for the term of years, in terms of and subject to the provisions of the Inventions Ordinance, 1859 (*here insert any condition under which the grant is made*).

(Signed) (*Signature of Governor*).

From Carpm. Pat. L. of World, 149.

CHANNEL ISLANDS.

See GREAT BRITAIN AND IRELAND.

CHILI.

Law of September 9, 1840.

ARTICLE 1. The author or inventor of an art, manufacture, machine or instrument, preparation of materials or any improvement thereof, who seeks to obtain the exclusive right to it assured by Article 152 of the Constitution, * shall present at the ministry of the interior a faithful, clear, and succinct account of the work or invention, declaring that the discovery is original and unknown in the country, accompanying it with samples, drawings, or models, as the circumstances of the case may require, and soliciting a patent which may establish his property therein.

ART. 2. The minister of the interior shall name a commissioner of one or more experts to examine the work or invention, and inform him as to its originality; they, in presence of the applicant, making oath to the faithful discharge of their duty, and also to religiously guard during the whole time prescribed by the law the secret which may be communicated.

ART. 3. After due investigation, the President of the Republic shall grant the exclusive privilege for a term not exceeding ten years, and shall order the issue of the necessary patent, which shall be authenticated by his signature, and sealed with the seal of the Republic.

ART. 4. This patent shall be registered in full in a book kept in the office of the ministry of interior.

ART. 5. Before delivery of the letters of patent to the applicant, he shall show by the exhibition of the proper receipt that he has paid into the public treasury the sum of \$50† and that he has deposited in the National Museum drawings, samples or models, and a specification in full, to the satisfaction of the inspecting commission, and bearing the signature of each of its members, which shall

* Article 152 of the Chilian constitution, dated May, 1833, accords to every author or inventor the exclusive proprietorship of his discovery or invention for the time which the law may cede to him, and further authorizes the payment of a proper indemnity should it be found nec-

essary to publish the invention. Report of Mr. J. De V. Drummond-Hay, of the British Legation, 4 Pat. Off. Gaz. 317.

† Mr. J. De V. Drummond-Hay states the fee as the "sum of £10 (about \$50)." 4 Pat. Off. Gaz. 318.

contain a complete, minute, and specific description distinguishing the invention or discovery from other matters previously known and employed, and defining the method or principles adopted, in order to enable any other competent person to use the same for the public benefit at the expiration of the term of the patent. This written specification shall be closed in presence of the commission, the title or subject of the patent being written on the envelope, and the proprietor shall declare that he has faithfully fulfilled the conditions here imposed, and the commission shall certify thereto. The proprietor during the term of his privilege may examine the envelope as often as he pleases, in order to see if it remains sealed and closed as when he handed it over.

ART. 6. In the National Museum a room shall be set apart for the reception of the plans, samples or models, and a secure chest for the safe keeping of the closed packets above mentioned, which shall not be opened or published before the expiration of the patent, except in cases of articles 11, 12, 15.

ART. 7. The \$50 above mentioned shall go toward the maintenance, &c., of the room in the Museum.

ART. 8. * [Omitted because repealed by law of July 25, 1872.]

ART. 9. Property in a patent is transferable like anything else, but in such cases the minister of the interior must first be informed, reasons being given. If these are found to be good, the transfer shall be noted in the transfer book, and if not, the provisions of article 11 shall come into play.

ART. 10. Any person constructing protected articles by the same method shall pay a fine of from \$100 to \$1000, the articles so constructed, and the machines, implements, &c., made use of being confiscated, and the value thereof being divided between the Gov-

*ART. 8 permitted "introducers of arts, industries or machines invented elsewhere and entirely unknown or not established nor employed in Chili" to obtain exclusive privileges on same conditions as prescribed for new inventions, except that the term was limited to eight years. By a law of August 16, 1856, the restriction was imposed upon any petitioner for the introduction of inventions already known in other countries, that the privileges solicited should be published in the Official Journal for thirty days, in order that parties who might have already brought

into the country, or established such conventions or industries, or have taken steps for their introduction or establishment, and thereby incurred expense previous to the petition for such exclusive privilege, should have a right to oppose the cession of the monopoly desired. By the law of July 25, 1872, the provision of ART. 8 of the law of 1840 allowing introducers to obtain patents was repealed. See report of Mr. J. De V. Drummond-Hay, 4 Pat. Off. Gaz. 318; Carpm. Pat. L. of World, 165.

ernment and the patentee, and in addition losses and damages may be recovered.

ART. 11. Patentees whose patents have been surreptitiously obtained, that is to say, by false testimony or under a false name, or for industries already established in the country, shall immediately in the same manner be fined, besides which they shall be condemned in costs, and shall incur imprisonment of from three to twelve months.

ART. 12. In case of dispute between rival inventors, arbitration shall be employed, one arbitrator being named by each party, and a third by the minister of the interior.

ART. 13. Patents conceded may be general, that is for the whole Republic, or particular, that is for a department or portion thereof.

ART. 14. For each patent a proportionate term shall be fixed for the establishment of the machinery, plant or manufactures, on the conclusion of which the term of the patent shall commence to run.

ART. 15. If, at the expiration of this term of establishment, the invention has not come into work, the privilege shall lapse, as shall it also do if after establishment it shall be abandoned for more than one year, or if the products are adulterated, becoming inferior to the samples, specimens, or models exhibited.

ART. 16. Renewal of patents can only be granted when accidents or unforeseen circumstances render the patentees really deserving of it, and it shall be sought at least six months before the expiration of the actual patent.

ART. 17. The present law shall not invalidate the mining *ordenanza* with respect to patents in that branch, nor what is established in the law of 24th July, 1834, with reference to literature and the fine arts.

From *Carpin. Pat. L. of World*, 164.

Decree of August 1, 1851.

Having noticed in several reports of the experts nominated for the concession of special privileges, that the necessary demonstration of the specialty of that to which the privilege relates has not been submitted to the government, and it being indispensable to correct this abuse in order to the due fulfillment of the law,

I have granted and decreed that those persons who, as experts, are nominated agreeably to article 2 of the law of 9th September, 1840, shall not only report as to the usefulness or introduction of the invention, but also to the injury which might result to industry or commerce, also as to the difficulties and expenses incurred by the petitioners, in order to regulate the period for which the privilege should be granted, and the time within which the said industry shall be established.

They shall also show whether it relates to a new invention, or only to one newly introduced into the country, and specify what particulars should be required for the clear recognition of the invention, introduction, or industry, which by granting of the above privilege shall be otherwise prohibited.

Signed, &c.

From Carpm. Pat. L. of World, 167.

CISLEITHANIA: AUSTRIA.

See AUSTRIA-HUNGARY

COCHIN CHINA.

See FRANCE.

COLOMBIA.

*Law No. 35 of (May 13,) 1869.**

ART. 1. All new discoveries or inventions, in whatever kind of industry, give the inventor under the conditions and for the time mentioned in this law a right to the exclusive benefit of his invention or discovery. This right is secured by grants issued by the Executive Power of the Union, called Patents of Invention.

ART. 2. Any Colombian or foreigner who shall invent or improve any machine, mechanical contrivance, combination of materials, or process, useful to industry, arts or sciences, or any manufacture or industry, may obtain a patent from the Executive Power, securing to him or to his lawful representatives, for a term of from five to twenty years, the exclusive right to make, sell, or use his discovery or invention.

ART. 3. No privileges shall be granted for the importation of natural or manufactured productions from foreign countries.

ART. 4. Persons applying for a patent in Colombia for inventions which have already been patented in a foreign country may obtain the said patent, provided the invention in question has not been already introduced into public use. A patent granted in Colombia for an invention which has already been patented in a foreign country, shall expire at the same time as the foreign patent.

ART. 5. In order to obtain a patent of invention or improvement, the person interested shall apply either personally or through his attorney to the Executive Power, specifying his invention or improvement, explaining it with clearness, and asking for the patent to be granted to him; and if the said patent be granted, he is required before he receives it to furnish within forty days an exact drawing or model of the machine or mechanical contrivance he shall have invented, or a full and detailed description of the new method or process, or a specimen of the manufacture, if the nature of the case should admit, in order that the same may be deposited in the

* A statement of the patent law of Colombia, by Mr. Charles O'Leary, of the British Legation, founded on the same law as is given in the text, but differently expressed, was published September 23, 1873, in 4 Pat. Off. Gaz. 318.

corresponding department of state, to be there at hand should any questions arise touching the patent.

ART. 6. Every patent shall contain a copy of the present law, as also of the executive decree granting the privilege, and specifying the invention, improvement, or new industry, and the term of its duration, and shall declare the patentee to be in possession of said privilege, and it shall be published twice at least in the National Official Gazette.

ART. 7. A patent of invention or improvement shall be granted without previous inquiry as to the usefulness of the article, or as to whether it be really an invention or improvement. The government does not declare, on issuing a patent, that the invention or improvement is genuine or useful, or that the patentee is the actual inventor, or the article is a new one, or that the descriptions or models are exact; as those who are interested in the matter are at liberty to prove the contrary before the law courts.

The Executive Power shall give notice through the National Gazette thirty days before issuing the grant of any applications that may be made for patents.

ART. 8. No patent shall be issued unless all the formalities laid down in this law are fulfilled, or in case the invention, improvement, or new industry, should endanger public health or security, or if it should be opposed to morality or to existing rights.

ART. 9. When the term for which a patent is granted expires, the manufacture, sale, or use of the patented invention or improvement shall become free; the descriptions furnished by the inventor shall be published, and copies of the respective drawings or models may be had on application at the expense of the person asking for them. This will likewise take place when, before the expiration of the term, the patent is declared null and void.

ART. 10. All attempts to imitate or counterfeit patented articles or industries, shall be prosecuted in accordance with the penal laws of the Union.

ART. 11. Besides the case mentioned in article 4, patents become void when they have been granted to the prejudice of a third party, which shall be decided by the tribunals of the States.

ART. 12. A patent for a new industry will also be void when said industry is not practiced during a whole year, unless unavoidable circumstances should have intervened.

ART. 13. On receiving the patent the patentee shall pay into the national treasury a fee of from five to ten dollars (\$5 to \$10) for

every year of the privilege. The person who applies for a patent shall fix a term for its duration within the maximum fixed, and shall deposit at the treasury the sum of ten dollars (\$10) which he shall forfeit if the patent be refused, and which shall be taken in part payment of the patent fee should the patent be granted.*

ART. 14. The law of May 15, 1848, respecting Patents of Invention or Improvement of Machines and Industrial Apparatus is hereby repealed.

From *Carpn. Pat. L. of World*, 169.

COSTA RICA.

According to a memorandum published October 7, 1873, in 4 *Gaz.* 373 (under the title San José), the constitution states that it belongs to the constitutional Congress to promote the progress of the arts and sciences, and to secure, for a limited time, to authors or inventors the exclusive right of their writings or discoveries; and every one who believes himself to have a right to a patent of invention must solicit it from Congress.

CUBA.

See SPAIN.

* The fee is thus stated by Mr. Charles O'Leary. To secure a privilege a fee of from \$5 to \$10 (£1 to £2) for every year of its duration must be paid to the government, the entire sum being levied when the patent is granted. In soliciting a patent, the number of years for which

it is desired to take it out is mentioned in the petition, but no petition is entertained unless preceded by a payment into the treasury of \$10 (£2), which the petitioner forfeits if the application is refused, or if granted is computed as part payment of the fee.

DENMARK.

Report by Mr. Strachey, of the British Legation, published 1873.

1. No laws have been passed in Denmark on the subject of protection to inventions.

Inventors are protected by royal letters patent granted through the ministry of the interior, in accordance with rules prescribed by the traditional practice of that department.

2. A person who wishes his invention to enjoy *gueret*, or monopoly, must address the ministry of the interior, accompanying his demand by detailed specifications and drawings.

3. The ministry forwards these papers to the Polytechnic School, with a request that the director will report on the applicant's scheme. The director, after consulting, if necessary, the professors of the institute, reports to the ministry whether the alleged invention is new and deserving of protection. He also states the period for which, in his opinion, the *gueret* or patent should be granted.

4. The ministry always adopts the director's conclusion. It is understood that a patent will be allowed whenever the alleged invention really contains something novel in principle or practice. Generally speaking, the applicant's request is granted.

5. The patents usually run for three, four, or five years. Important inventions are protected for ten years, and in special cases for fifteen years. Patents granted to foreigners never run for more than five years.

6. The fee charged at the ministry of interior for the whole transaction is £1 17s. 6d. (\$9.) The time occupied in the correspondence is about two months.

7. The patent is forfeited (1) if it is shown that a similar invention has been used in Denmark before ; or (2) if the patentee does not carry out his invention within the year, and continue to employ it.

COPENHAGEN, *December 24, 1872.*

From 4 *Pat. Off. Gaz.* 319.

DOMINICA.

See LEEWARD ISLANDS.

EAST INDIES (French).

See FRANCE.

ECUADOR.

See INTERNATIONAL CONVENTION.

See also APPENDIX OF RECENT LAWS, near end of Vol. II.

ENGLAND.

See GREAT BRITAIN AND IRELAND.

FIJI: FEEJEE ISLANDS.

Ordinance No. III. 1879.—To repeal Ordinance No. XXIV. of 1877, and to make other provisions in lieu thereof for the issue of Letters Patent.

I. *Privileges.* Every inventor shall be entitled, under the conditions and restrictions hereinafter enacted, to the sole exclusive right of and in his invention.

II. *Interpretation clause.* In the interpretation of this ordinance the word "invention" shall mean and include any manner of new manufacture, also every new process of manufacture, and every new method of application of known processes, and improvements in any known process.

The word "inventor" shall include the heirs, executors, administrators or assigns of an inventor.

III. *Form of letters patent and privileges conferred.* The right and privilege granted to inventors shall be conferred by letters patent under the seal of the colony in form contained in schedule A hereto, whereby the inventor shall be entitled to the sole and exclusive privilege of using, selling, or making his said invention in the colony, and of authorizing others so to do, for the term of fourteen years from the date of the letters patent.

IV. *Letters patent not to be granted in certain cases.* No person shall be entitled to letters patent—

a. If the invention is of no utility.

b. If the invention at the time of presenting the petition was not a new invention.

c. If the petitioner is not the true and first inventor thereof.

d. If the petition or any specification contain a willfully false statement.

And the attorney-general may make an application to the Supreme Court on any such grounds for the cancellation or revocation of any letters patent.

V. *Proceeding in application for letters patent.* Every person desirous of obtaining letters patent under this ordinance shall file in the office of the colonial secretary a petition in the form contained in schedule B signed by him or his agent or attorney, setting forth the residence of the inventor and the title of the invention. To the

petition shall be annexed a specification (or instrument in writing), particularly describing and ascertaining the nature of the said invention and the manner in which the same is to be produced or performed, and with such specification or instrument in writing shall be filed the drawings necessary to elucidate the same, and such petition, and all documents and drawings accompanying the same, shall be in duplicate.

VI. *Petition to be accompanied by declaration.* Every petition and specification particularly describing the nature of an invention shall be accompanied by a declaration in writing, signed by the petitioner, or his agent or attorney for him, in the form contained in schedule C, hereto.

VII. *Petition, specification, &c., to be recorded.* The colonial secretary shall cause to be filed every petition and specification, with accompanying drawings, if any, explaining the nature of any invention; and also any certificate granted by the attorney-general, and every letters patent issued, and a memorandum of any order relating thereto.

VIII. *Records may be inspected.* Such records shall be open to the inspection of all persons, at any reasonable hour, upon the payment of a fee of four shillings, and any person may have a copy of any document recorded on payment for the same at the rate of eight-pence for every folio of seventy-two words.

IX. *Certified copies to be received as evidence.* Copies of any documents so recorded, certified as correct by the colonial secretary, shall be received in evidence in any court of law in the colony.

X. *Specification may be amended.* A specification may be amended on application to the attorney-general, provided that if the attorney-general shall refuse to allow such specification to be amended the same may be amended by leave of the Governor in Council, and when so amended shall, except as to suits and proceedings relative to the exclusive privilege claimed by any inventor pending at the time, have the same effect as if no amendment had been made, and no extension or enlargement of any exclusive privilege before acquired should be effected thereby.

XI. *Provisional certificate.* When any applicant has filed his petition for letters patent, the Governor shall direct the same to be referred by the colonial secretary to the attorney-general, with one of the duplicates of such petition and the specification, and all other accompanying documents and drawings, and a certificate of the filing of the petition; and the attorney general shall, if he deem the

invention as *primâ facie* entitled to protection, issue a certificate to that effect, as in form contained in schedule D, and the inventor shall, subject to the provisions of this ordinance, be protected for a period of six months in like manner as by letters patent ; Provided nevertheless, that it shall be competent to the attorney-general to extend the period of such protection pending the decision as to any opposition made to the granting of any letters patent as to him shall seem necessary.

XII. *Where certificate is refused, appeal may be made.* If in any case the attorney-general shall refuse to issue such certificate as hereinbefore provided, an appeal shall lie from the decision of the attorney-general so refusing such certificate to the Governor in Council, who may direct the same to be issued by the clerk of the council in such manner and subject to such conditions and restrictions as shall seem fit, provided that such application shall be made to the Governor in Council within one month from the time of the decision of the attorney-general refusing a certificate being made known to the applicant for letters patent, or to his agent or attorney : provided also that any certificate to be issued by direction of the Governor in Council shall be issued within three months from the date of such appeal, and upon the issue of such certificate like proceedings shall be had and taken as if such certificate had been issued by the attorney-general.

XIII. *Procedure where no opposition is made to application.* Within two months of the issue of the certificate of the attorney-general, or, where the attorney-general has refused to issue such certificate, from the date of the issue of the same by the clerk of the council, as provided in the next preceding section, the applicant for letters patent shall give notice in the form contained in schedule E, hereto, twice in the Royal Gazette, and one other paper published in Fiji ; and if no notice of opposition to the application for letters patent be sent to the attorney-general within three months of the date of publication of the first of such notices, the attorney-general shall report such fact to the Governor in Council, and the Governor in Council shall, within three months from the date of such report, cause letters patent to be issued with such reservations, provisos, and conditions as may be deemed fit.

XIV. *Where application is opposed, holder of certificate may appeal.* Any person desiring to oppose such application shall, within the time last mentioned in the next preceding section, give notice in writing of his opposition to such application and of the grounds

thereof to the attorney-general, who shall, after hearing the parties to and against such application, and such witnesses as he may deem necessary, decide the same and intimate his decision to the Governor in Council, and the Governor in Council shall, within three months from the date of such intimation, if the same be favorable to the person holding a provisional certificate, direct the issue of letters patent to such person with such reservations, provisos, and conditions as may be meet. And in case the decision be adverse to the party holding the provisional certificate, he may appeal against such decision to the Governor in Council; and the Governor in Council shall, within three months from the date of such appeal, either direct the issue of letters patent to the appellant, subject to such reservations, provisos, and conditions as he may deem fit, or make such other order as may be meet.

XV. *Where letters patent have been granted for inventions already patented beyond the colony.—Proviso.* Where upon application made under this ordinance for letters patent in respect of any invention first invented in parts out of the colony, and letters patent for the exclusive use of such invention has been granted in such parts before the grant of such letters patent in this colony, all rights and privileges under such letters patent last mentioned shall (notwithstanding any term in such letters patent limited) cease and be void immediately upon the revocation, cancellation, or other determination of such letters patent obtained in parts beyond the colony; or where more than one such patent is obtained, then upon the revocation, cancellation, or other determination of the first of such letters patent: Provided that no letters patent shall be granted in respect of any invention for which letters patent have been granted in parts beyond the colony and have expired, or if letters patent shall be granted in respect thereof the same shall not be of any validity.

XVI. *Patents for inventions protected by imperial patent.* Any person holding Her Majesty's letters patent for any invention may obtain letters patent for the same in this colony on satisfactory proof of the issue of such letters patent, provided the patent obtained in this colony shall be subject to the provisions relating to patents obtained in places beyond the colony contained in the next preceding section.

XVII. *Letters patent to be registered.* All letters patent and assignments of letters patent shall be registered in the office of the

registrar-general on the payment of fees in respect thereof, as specified in schedule F.

XVIII. *Governor in Council may annul letters patent.* Letters patent may be annulled by the Governor in Council if the same be proved to be prejudicial to the public interests, or if the special conditions on which the same have been granted are not observed. Notice of any letters patent being annulled, and the cause thereof, shall be inserted in the Royal Gazette. On the issue of any letters patent any petition, specification, and other documents and drawings referring thereto, shall be transferred from the office of the colonial secretary to the registrar-general, and shall be filed by him forthwith.

XIX. *Letters patent to be for one invention only.* No letters patent will be allowed to include several distinct and separate inventions ; but where one invention is applicable to the improvement of several manufactures, or where several inventions are applicable to the improvement of one and the same manufacture, the whole may be included in the same letters patent.

XX. *Notice of proceeding under section IV. to be published.* The attorney-general shall give at least one month's notice of his intention to proceed under section IV., by notice in the Royal Gazette, and such notice shall be published in not less than three issues of the Royal Gazette, and the period of one month before mentioned shall commence from the date of the publication of the last of such notices, and such publication shall be in lieu of service of any writ or process required by the rules of the Supreme Court.

XXI. *Where letters patent may be canceled or revoked by order of Supreme Court.* If upon any of the grounds set out in section IV. of this ordinance, the Supreme Court or a ~~judge thereof~~ shall order any letters patent to be canceled or revoked, a copy of such order shall be forthwith forwarded by the registrar of the court to the registrar-general, who shall record the same, and all right under any letters patent so canceled or revoked shall cease.

XXII. *Supreme Court may order amendments.* The court may order any specification or petition to be amended, and may reserve its decision for a time sufficient to allow of such amendment to be effected, and thereafter give judgment on such terms as to costs and otherwise as may seem fit.

XXIII. *Penalty for making false declaration.* Any person making a false declaration under this ordinance shall be deemed guilty of perjury, and upon conviction be liable to imprisonment

not exceeding two years, without prejudice to any action which any injured parties may bring against him.

XXIV. Fees. The fees specified in schedule F of this ordinance shall be paid to the colonial treasurer for the several matters referred to therein. Provided that the Governor in Council may make additions, alterations, and amendments in the said schedule, and such additions, alterations, and amendments so made and published in the Royal Gazette shall have the full force and effect of law.

XXV. Ordinance No. XXIV. of 1877 repealed. From and after the passing hereof, Ordinance No. XXIV. of 1877 shall be, and the same is, hereby repealed: provided that nothing herein contained shall affect or prejudice any proceedings or thing lawfully done or taken, or any letters patent granted or protection issued by virtue of the said ordinance.

XXVI. Short title. This ordinance may be cited as "The Patents Ordinance, 1879."

Passed in Council this thirteenth day of January, in the year of our Lord One thousand eight hundred and seventy-nine.

SCHEDULE A.

VICTORIA, by the grace of God, of the United Kingdom of Great Britain and Ireland Queen, Defender of the Faith, to all to whom these presents shall come, greeting:

Whereas A. B., of in the colony of Fiji hath represented that he is desirous of obtaining our royal letters patent for securing unto him our special license, that he, his executors, administrators and assigns, and such others as he or they should agree with, and no others, should and lawfully might make, use, exercise and vend within our colony of Fiji and its dependencies, an invention for [*insert the title of the invention*], and by an instrument in writing under his hand and seal deposited in the office of the colonial secretary, the said A. B. hath particularly described and ascertained the nature of the said invention, and in what manner the same is to be performed. And we, being willing to give encouragement to all arts and inventions which may be for the public good, are graciously pleased to confer upon the said A. B. the privileges hereinafter mentioned. Know ye therefore that we, of our special grace, certain knowledge and mere motion, have given and granted, and by these presents, for us, our heirs and successors, do give and grant unto the said A. B., his executors, administrators and assigns, our special license, full power, sole privilege and authority, that he the said A. B., his executors, administrators and assigns, and every of them, by himself and themselves, or his and their deputy or deputies, servants or agents, or such others as he or they shall at any time agree with, and no others, during the term herein expressed, shall, and lawfully may, make

use, exercise and vend his said invention within our said colony and its dependencies, in such a manner as to him, his executors, administrators and assigns, or any of them shall seem meet, and that he, his executors, administrators and assigns shall, and lawfully may, have and enjoy the whole profit, benefit, commodity and advantage from time to time coming, growing, accruing and arising by reason of the said invention during the said term. To have, hold, exercise and enjoy the said licenses, powers, privileges and advantages unto and by the said A. B., his executors, administrators and assigns, for and during, and unto the full end and term of fourteen years now next ensuing. And to the end that he, his executors, administrators and assigns, and every of them, may have and enjoy the full benefit and the sole use and exercise of the said invention according to our gracious intention. We do by these presents, for us, our heirs and successors, require and strictly command all and every person and persons, bodies politic, corporate, and all other our subjects whatsoever, of what estate, quality, degree, name or condition soever, may be within our said colony and its dependencies, that neither they nor any of them at any time during the said term, either directly or indirectly, do make, use or put in practice the said invention, or any part of the same so attained unto by the said A. B. as aforesaid, nor in anywise counterfeit, imitate or resemble the same, nor shall make or cause to be made any addition thereunto or subtraction from the same, whereby to pretend himself or themselves the inventor or inventors, deviser or devisors thereof, without the consent, license or agreement of the said A. B., his executors, administrators or assigns, in writing under his or their hands and seals first had and obtained in that behalf, upon such pains and penalties as can or may be justly inflicted on such offenders, on their contempt of this our royal command, and further to be answerable to the said A. B., his executors, administrators and assigns, according to law, for his and their damages thereby occasioned. Provided always, and these our letters patent are and shall be upon this condition, that if at any time during the said term hereby granted it shall appear that this our grant is contrary to law or prejudicial or inconvenient to our subjects in general, or that the said invention is not a new invention as to the public use and exercise thereof, or that the said A. B. is not the true and first inventor thereof within this colony or its dependencies, these our letters patent shall forthwith cease, determine and be utterly void to all intents and purposes, anything hereinbefore contained to the contrary thereof in anywise notwithstanding. Provided also that these our letters patent, or anything herein contained, shall not extend or be construed to extend to give privilege unto the said A. B., his executors, administrators or assigns, or any of them, to use or imitate any invention or work whatsoever which hath heretofore been found out or invented by any of our subjects whatsoever, and publicly used or exercised, or unto whom our like letters patent or privileges have been already granted for the sole use, exercise and benefit thereof within our said colony or its dependencies, it being our will and pleasure that the said A. B., his executors, administrators and assigns, and all and every other person and persons to whom like letters patent or privileges have been already granted as aforesaid, shall distinctly use and practice their several inventions by them invented and found out, according to the true intent and meaning of the said respective letters patent, and of these presents. Provided likewise nevertheless, and these our letters patent are upon this express condition, that if the said instrument in writing does not particularly describe and ascertain the nature of the said invention, and in what manner the same is to be performed, and also if the said A. B., his executors, administrators or

assigns shall not supply or cause to be supplied for our service all such articles of the said invention as he or they shall be required to supply by the persons administering the department of our service, for the use of which the same shall be required in such manner, at such times and at and upon such reasonable prices and terms as shall be settled for that purpose by the said persons requiring the same, that then and in any of the said cases, these our letters patent, and all liberties and advantages whatsoever hereby granted, shall utterly cease, determine and become void, anything hereinbefore contained to the contrary thereof in anywise notwithstanding. Provided that nothing herein contained shall prevent the granting of licenses in such manner and for such considerations as they may by law be granted. And lastly, we do by these presents for us, our heirs and successors, grant unto the said A. B., his executors, administrators and assigns, that these our letters patent shall be in all things good, firm, valid and sufficient, and effectual in law, according to the true intent and meaning thereof, and shall be taken, construed and adjudged in the most favorable and beneficial sense for the best advantage of the said A. B., his executors, administrators and assigns, as well in all our courts of record as elsewhere, and by all and singular the officers and ministers whatsoever of us, our heirs and successors in our said colony and its dependencies, and amongst all and every the subjects of us, our heirs and successors whatsoever and wheresoever, notwithstanding the not full and certain describing the nature or quality of the said invention, or of the materials thereunto conducing and belonging. In witness whereof we have caused these our letters to be made patent.

Witness our trusted and well beloved Governor and Commander-in-Chief, &c., &c., of our said colony, at _____ on the _____ day of _____ 18 .

SCHEDULE B.

Petition.

I _____ of _____ do hereby humbly petition his Excellency the Governor for letters patent in respect of an invention [*state title of invention*].

I have furnished with this petition the necessary specifications or instruments particularly describing the nature of the said invention, and a solemn declaration that I am the true and first inventor thereof, in accordance with law.

Signed _____

Petitioner

or agent or attorney for petitioner.

SCHEDULE C.

I _____ of _____ do solemnly and sincerely declare that I am in possession of an invention for, &c. [*the title as in petition*], which I believe will be of great public utility, that I am the true and first inventor thereof, and that the same is not in use by any other person or persons, to the best of my knowledge and belief, and that the instrument in writing under my hand hereunto annexed particularly describes and ascertains the nature of the said invention, and the manner in which the same is to be performed.

SCHEDULE D.

In obedience to his Excellency's commands, referring to me the petition of _____ of _____, to consider what may be properly done therein, I do certify as follows:—

That the said petition sets forth that the petitioner [*state briefly the allegations of the petition*].

That in support of the allegations contained in the said petition, the declaration of the petitioner has been laid before me, whereby he solemnly declares that [*state briefly the allegations of declaration*].

That there has also been laid before me a specification, or instrument in writing, particularly describing the nature of the said invention, and a certificate of the filing of the said petition, declaration and specification.

Having duly and carefully considered the same, I hereby certify that the petitioner is entitled, *prima facie*, to protection on account of his said invention, provided the said application for letters patent be duly advertised according to Ordinance No. III. of 1879, and that the petitioner do otherwise comply with the enactments of the said ordinance.

Given under my hand, this day of A. D.

SCHEDULE E.

In the matter of the application of of , for letters patent for

Notice is hereby given, that an application has been made for the issue of letters patent herein under the provisions of the "Patents Ordinance of 1879." And any person desirous of opposing such application is required to give notice of such opposition, and of the grounds thereof to the attorney-general, within three months from the date of the publication hereof.

A. B., Applicant.

SCHEDULE F.

	£	s.	d.
On depositing petition and specification	5	5	0
For provisional certificate of protection.....	3	3	0
For obtaining letters patent	10	10	0
On lodging particulars of objections	2	10	0
Every search and inspection.....	0	4	0
Registration of letters patent.....	0	5	0
Filing memorandum of alteration or amendment of specification.....	1	1	0
Registration and assignment of letters patent.....	0	10	0
Copy or extract of any writing, per folio of 72 words	0	0	8

From *Carpin. Pat. L. of World*, 174.

FINLAND.*Supreme Decree of March 30, 1876.*

We, Alexander the Second, by the grace of God, Emperor and Autocrat of all the Russias, Czar of Poland, Grand Duke of Finland, &c., &c., hereby make known: that upon the representation of the finance department of our Senate for Finland, and upon the recommendation of the Governor-General for this territory, we have thought fit with regard to the mode and conditions for granting patents or privileges for the utilization and profitable working (to the exclusion of all other persons during a given period) of new inventions relating to handicraft industry and art, and also for improvements upon inventions already made—to decree as follows:—

CHAPTER I.

Of the rights to be conferred by a patent, and also the duration of time for which a patent will be granted.

SECTION 1. A patent entitles the owner of the invention to make, exercise and vend, alone or through others, everywhere in Finland, the invention to which it relates, to the exclusion of all others, during the time specified by the letters patent. It is incumbent upon the owner that he should strictly conform to whatever is prescribed by the existing laws with regard to the manufacture and the sale of wares, without being obliged in order to enjoy the advantages of the said right, to acquire the dignity of a master craftsman or the freedom of a citizen.

The patent right is to be considered as the personal property of the owner, and may in consequence be devised by will, and also, in accordance with the ordinary legal practice, be assigned to other persons, together with the rights acquired by the letters patent, but subject to the observance of what is hereinafter prescribed in sec. 2 of the succeeding chapter.

SEC. 2. A patent may be granted: (1) For new inventions relating to handicraft, industry or art.

(2) For improvements upon earlier inventions of the same kind, but without prejudice to any such previously granted patent right.

A patent cannot be granted for the preparation of medicines nor

for any invention which is of such a nature that the employment of the same would be contrary to the existing laws, to the public safety or to good morals.

Nor can any one by a patent acquire the exclusive right to make use of a new principle, but only to use the manner, method, and means for the employment of an invention which are mentioned and described in the petition for the patent.

SEC. 3. A patent will be granted for the period of at least three years, and at the utmost twelve years, according to the nature and importance of the invention.

If any person has obtained a patent in a foreign country, and has thereby been compelled to publish a description of the manner in which the invention is to be applied, a patent may nevertheless be granted to him for a given time in Finland also, but not for a longer period than that within which the patent granted in the foreign country will expire.

SEC. 4. The inventor only is entitled to the patent.

CHAPTER II.

On the manner in which patents will be granted.

SEC. 5. If an inventor wishes to obtain a patent he must present his petition to the finance department of the Senate, and the said petition must contain, together with a declaration of the object of the patent, the following particulars :—

A precise specification as to how far the invention for which the patent is desired is new, or whether it is an improvement upon an invention already in use ; the novelty of the invention or of the eventual improvement is specially to be cited ;

A declaration of the period of time for which the petitioner desires to obtain the patent right ;

A declaration whether the invention has previously been patented in any foreign country or not, and in the first case attested information is to be produced when such a privilege was granted, and for how long a time ;

A full and accurate description of the invention and of the method of using the same, and accurate drawings or models are also to be annexed to the petition in cases where such drawings or models are considered necessary ;

If the petitioner is not in a position at once to send in a full description, such fact must be mentioned in the petition, and he is

then bound within one month after the presentation of the petition to send in a description ; during this period the examination of the petition remains in abeyance. If the petitioner does not send in his description within the term named, his application will be refused. The petitioner is however, not precluded from sending in a fresh petition, together with a full description with reference to the same object.

Petitions referred to in this section are in case the petitioner has not his residence in Finland, to be presented through some person domiciled therein. The name and residence of such person are to be set out in the power of attorney to be executed in his favor by the petitioner, empowering such attorney to act for and represent him in all matters relating to the patent. This power of attorney is to accompany the petition and the documents relating to the same.

SEC. 6. After the petition, together with the supplemental documents, has been sent in to the finance department of the Senate, and after subsequent examination and approval by the said department, a patent will be issued for the invention.

In the patent are to be set out the principle contents of the petition of the applicant:—

The period for the duration of which the patent is granted ;

The privileges which are to be conferred by the patent ;

And the obligations which the holder of the patent must fulfill in order to enjoy the privileges of the patent right.

The patent must further contain expressly a declaration, in terms which cannot be mistaken, of that for which he requires protection, that the invention is new, and that it can be used with advantage.

SEC. 7. The *Manufactures-Direction* is to be informed of all petitions for patents granted by the Senate, and the whole of the collective documents belonging to the matters connected with the patent are to be made over to them.

The *Manufactures-Direction* is bound to include these documents together in a catalogue and arrange them in accordance with their nature, in such a manner as that every person who may desire to do so may be afforded an inspection of the same.

SEC. 8. If two or more persons present themselves desiring to obtain a patent for inventions of a like nature, it shall be decided upon examination whether the one of them who has first sent in the completed documents before the others shall receive the patent, or whether all the petitions are to be refused.

SEC. 9. In addition to the customary dues which are payable to the Senate for the issue of a patent, an impost duty of twenty marks per annum is to be paid into the state treasury of Finland for every year for which the patent right is granted.

CHAPTER III.

Of the obligations and rights of the owners of patents.

SEC. 10. Whoever has received a patent is obliged:—

1. To bring the patent right to public notice by means of the publication of the patent and the description three times in the official Swedish and Finnish newspapers of the country. The description must be in the same terms as that included in the petition for the patent. Such publication is to be effected within two months, to be reckoned from the day of the issuing of the patent.

2. Within two years from the last-mentioned day, to send in evidence to the *Manufactures-Direction* that he is in full working of the patented invention; the said term may be limited by the finance department of the Senate at the granting of the patent to one year, and also extended, upon petition for that purpose, to at the utmost four years, as the scope and nature of the invention merit.

3. Afterwards, in every year during the whole duration of the patent, to give evidence to the *Manufactures-Direction* that the invention is being continuously worked.

SEC. 11. If the holder of a patent wishes to assign the same to any other person, or if it comes by inheritance into the possession of another person, such fact must be notified to the *Manufactures-Direction*, whereupon the matter is to be referred by a memorandum to the finance department of the Senate. The new patent holder will have brought to his notice by the medium of the memorandum, the obligations which are to be fulfilled by him during the continuance of the patent.

If a transfer should be effected to any person not domiciled in Finland, he is obliged, in accordance with the provisions contained in the last clause of section 5, to appoint an attorney to act for him.

SEC. 12. The patent right ceases and becomes forfeited:

When the holder of a patent shall have omitted the observance of any of the provisions contained in section 10;

When, in consequence of any of the causes of complaint mentioned in section 14, the tribunal declares the patent to be annulled.

SEC. 13. When a patent has become forfeited, and also when the time for which the patent was originally granted has expired, it is incumbent upon the *Manufactures-Direction* to publish in the official Swedish and Finnish newspapers of the country the fact that the patent has become canceled.

CHAPTER IV.

Of the judicial conduct of actions relating to a patent.

SEC. 14. If a patent is granted for an invention similar to one previously patented, or which has already been discovered by some other person in Finland or elsewhere, or if the owner of the patent has falsely declared himself to be the inventor, or if it is proved that the patented invention is dangerous to the public safety or to the public health, or may lead to immorality, any person who believes his right to be prejudiced by the patent may, within one year after the patent resolution has been published for the third time in the newspapers named in section 10, and also the state attorney, so soon as the protection of the commonwealth requires it, may bring an action against the owner of the patent, before the tribunal of the place wherein the owner—or, in case of his residing out of the country, his legally appointed representative—is domiciled. The tribunal shall, in case any of the above enumerated events have happened, declare that the patent is to be revoked, in which case a copy of the judgment of the tribunal is to be forwarded to the *Manufactures-Direction* without delay. This latter shall proceed to act in the matter, after the judgment has become legally valid, in the manner prescribed in section 13.

SEC. 15. If the owner of a patent believes that after the granting of the patent another person works the patented invention illegally, he may bring his action against him by means of a citation before the public tribunal to which the person informed against belongs. If the owner of the patent is able to give proof that his rights are being infringed upon in the matter mentioned the accused person shall be subject to a fine for the first time of from one hundred to three hundred Finnish marks, and in the case of repeated infringements of from three hundred to six hundred marks, and

also be condemned each time to payment of compensation for the full amount of damages. Of the money fine, one half of the amount is to go to the owner of the patent, who alone can bring such action before the tribunal, and the other half to the poor and work-house fund of the country. If the condemned person is not in a position to pay the fine, the same shall be, in accordance with the prescriptions now in force with regard to pecuniary amercement, exchanged for imprisonment.

SEC. 16. Should it appear upon the trial of an action for the infringement of a patent right that the invention to which the patent relates has been known or used in the country or elsewhere before the petition for the patent was presented to the finance department, or that the holder of the patent has given an incorrect or incomplete description of the method and the means to be employed for working the invention, and that a trustworthy basis for forming a judgment as to the peculiar characteristics of the invention has not thereby been obtained; or if the owner of the patent has falsely held himself out as the inventor, the defendant is not answerable.

CHAPTER V.

General provisions.

SEC. 17. Whenever in this decree "months" are spoken of within which particular obligations are to be fulfilled, in the application of this term each month is to be reckoned as 30 days.

SEC. 18. This decree comes into force on the 1st June, 1876, without prejudice, however, to the legal validity of patents previously granted.

And hereto every person to whom the same relates must hereafter conform.

From *Carp. Pat. L. of World*, 185.

FRANCE.

Law of July 5, 1844 ; with Notes Founded on the Commentary of M. Leopold Goirand.

TITLE I.

GENERAL PROVISIONS.

ARTICLE 1. Every new discovery or invention, in all kinds of industry, confers upon its author, subject to the conditions and for the periods hereafter determined, the exclusive right to work for his benefit the said discovery or invention. This right is evidenced by documents delivered by the government, under the name *brevets d' invention* (letters patent).

NOTE, founded on the commentary of M. Leopold Goirand.—A patent of invention in France consists of an official declaration, delivered by the government to any individual who claims to be an inventor, to the effect that on a given day, such individual deposited with the minister of agriculture and commerce, a demand, accompanied by certain documents in which he claims the invention of which he declares himself to be the author. This official declaration does no more than state a fact ; it has but one object, and that is, to indicate the period from which the right of the party applying for the patent is to run, in France. The government does not at this stage examine the claim, and does not, therefore, guarantee the genuineness thereof. The formula which the law requires to be placed upon all patented articles is accordingly worded : “ *Breveté sans garantie du gouvernement* (patented without government guaranty) ;” which in practice is abbreviated : *S. G. D. G.*

There is only one kind of patent, but it may be taken out under three different circumstances : 1. For an invention, properly so-called. 2. For an improvement or change in or an addition to an invention. A patent of this kind is called in practice a “ *brevet de perfectionnement* (patent for improvement).” 3. For an invention which has been already patented abroad, and is now sought to be introduced into France. This is called a “ *brevet d' importation* (patent for importation).”

ART. 2. The following are considered as inventions or new discoveries :

The invention of new industrial products.

The invention of new means, or a new application of known means for obtaining a result or an industrial product.

This enumeration must not be construed too strictly ; practically it has been extended to comprise all possible inventions. The courts have gone so far as to decide that not only new applications of known means, but also the merely new combination

of known means to obtain a product or a commercial result, is an invention, within the meaning of the law. There are inventions, however, which, although new, are not patentable. Such are those belonging to pure science, and not capable of being applied to industry. Thus the discovery of a natural law, or a natural phenomenon, etc., cannot be patented. It is proper to distinguish between the simple observation of a scientific phenomenon, and the practical, commercial application to which such observation can be put. The former is not, and the latter is, patentable. (Court of Cassation, December 20, 1851, and February 9, 1853.) As a rule, every invention which has a commercial value is capable of being patented.

An "industrial product," as that term is used in Article 2, is a well defined body or material object which has a form and specific characteristics that distinguish it from all other objects. Thus, a new tissue of known materials can be patented as a new product, if the same materials have never before been combined to make a product having the same characteristics. (Court of Paris, November 19, 1857; December 6, 1859.) It is necessary to distinguish between the product and the *process*; a new result, even if the process is not new, may be patented. A distinction must also be made between a new product, and a new *result*. The latter is never a material object, but simply a new effect, or the better use of known means; as such, it is not patentable in itself; that which is patentable is the process by which the new effect is produced. The Court of Cassation has decided that an industrial result cannot be patented independently of the means employed to obtain it; also, that the object which an inventor has in view when inventing a product or process, cannot be the subject of a patent, but that invention consists only in the means by which the difficulty is overcome and the object realized. (Court of Cassation, April 17, 1870.)

"Means," in the phrase "the invention of new means," in article 2, signifies the processes employed by the inventor to obtain a product or result. They are of three sorts: 1, chemical agents; 2, mechanical forces; 3, processes, which depend on both. The novelty of the means is evidently a simple question of fact; and in France, if the process is new, the law does not go into that question with respect to the product.

The new application of known means to obtain a result or product of commercial value. The greater number of patents belong to this category of inventions: and when such patents are submitted to the courts, they must, in order to form a due estimate of them, consider, not each method or process separately, but all such methods or processes taken together. The expression "new application," &c., employed by the law, is very broad; it comprises any new combination of known means, any new combination of known substances, and all new arrangements of known forces, whether chemical or mechanical, or both. (Court of Cassation, January 17, 1852; December 2, 1859; February 12, 1854; Court of Rouen, March 1, 1860). In short, "to apply known means in a new manner" is purely and simply to employ means that are known, just as they are known, without changing them in any respect, but with a view to obtain a different result from any hitherto produced. Thus it has been decided that: "Though the mode of making boxes by a single roll of card-board is not a new invention, it is certain that such mode had never before been applied to boxes destined for lucifer matches; that by means of this system, by which many slides are manufactured simultaneously, a great saving has been effected in the manufacture of match-boxes, and moreover, that upon this point the application is new; and the patent taken is therefore valid." It has also been decided that the manufacture of a compound by the aid of known ingredients is patentable, from the fact that such elements had not before

been combined to produce the same result. (Court of Cassation, April 7, 1869.) Also, that a machine which has become public property can become once more the subject of a patent when, by new combinations, it is applied to a class of industry different from that to which it had been formerly applied; or more generally, when it is applied in a manner unknown up to the date of application (Court of Rouen, March 4, 1841; Court of Cassation, November 25, 1856; Court of Paris, July 1, 1870); also that the application of water-meters to gas, is, if new, patentable. (Court of Paris, August 1, 1861.) Evidently, when an inventor has obtained a patent for the new application of known means to produce a compound already known, any other individual who can obtain the same result or the same product, by the use of different means, can obtain a valid patent therefor. (Court of Dijon, February 9, 1876.)

The "new application of known means" must not be confounded with the employment of known means for a different purpose. The law does not protect new employment; therefore, if an apparatus, formerly applied to a certain substance, is afterwards applied to another substance, to which it renders exactly the same service, no modification of the apparatus being necessary for such new employment, the second employment will not be patentable. It is upon this ground that the Court of Appeal of Paris refused to sanction an invention to apply rollers to a kitchen range, as rollers had already been applied to stoves; neither would it sanction a patent for closing rings which had already been adapted to the closing of bracelets. (February 28, 1855.) Again, the Criminal Court of the Seine refused to uphold a patent taken for adapting to pianos the same screws which had been formerly adapted to piano stools (December 7, 1858); nor would it uphold one taken for reproducing musical works by photography, which was formerly used for the reproduction of drawings. (February 28, 1865.) So also, mere changes of form and dimensions are not patentable, at least, unless they produce a new result or a new product; in such a case they can be patented.

ART. 3. The following are not capable of being patented;—

1. Medical compositions and medicines of every kind. These remain subject to special laws and regulations, and especially to the decree of August 18, 1810, relating to secret remedies.

2. Plans and combinations of credit or finance.

ART. 4. Patents shall be valid for five, ten, or fifteen years. The following fees shall be paid for every patent taken.

For a patent of five years, 500 francs.

For a patent of ten years, 1000 francs.

For a patent of fifteen years, 1500 francs.

This fee shall be payable in annual sums of 100 francs. The patent shall be forfeited if the patentee allows a term to pass without payment thereof.

Fifteen years is the maximum duration of a patent; but a special act of the Legislature can, on exceptional grounds, prolong such duration for another fifteen years.

A patent taken out for improvement, runs also from the day on which the deposit of the papers for the improvement was made.

At the expiration of the period prescribed for patents, they fall into the public

domain or become public property. Any person can then manufacture or make use of the article patented, but the name of the inventor, if he has given his name to the object of the invention, does not fall into the public domain, and other manufacturers must respect his name, and are not allowed, under penalty of prosecution, to use the name of the inventor, except in connection with the following formula; "*Fabriqué suivant le système de A. B. .*" (Court of Paris, November 24, 1865.)

TITLE II.

FORMALITIES ATTENDING THE TAKING OF PATENTS.

SECTION I.

THE APPLICATION.

ART. 5. In order to obtain a patent, the applicant must deposit, under seal, at the office of the secretary of the *prefecture* in the department in which he is domiciled, or in any other department, after having elected domicile therein, the following, viz.:

1. His petition to the minister of agriculture and commerce.
2. A description of the discovery, invention or application that forms the object of the patent. .
3. Drawings or samples necessary for the elucidation of the description.
4. A schedule of the documents deposited.

Minors, married women, and persons under legal disability can, nevertheless, become patentees. The heirs of an inventor can take out a patent, either in his name or in their own, for inventions discovered by their ancestor. Foreigners, also, can obtain patents in France.

Nothing prevents a firm or company from taking out a patent, and creditors can take out a patent on behalf of a deceased inventor, upon condition that before his death, the inventor has, by initiating the necessary steps, manifested the intention of having it patented.

When one individual is employed upon wages by another, and such employe discovers an invention, does the invention belong to him or to his master, if no agreement exists between them? This question has been submitted upon various occasions to the French courts. The civil tribunal of the Seine has decided (November 21, 1873), that if workmen or agents, either of the government or of a private undertaking, can be deprived of the right of patenting inventions which they have made, it is only in cases in which such inventions are the result of works executed by them in their relation as employes, under the orders and superintendence of their master or *chef*, and especially when they have received special instructions to examine and apply the improvements in dispute. The Court of Paris (July 21, 1874), has confirmed the above decision.

An inventor who is abroad, and desires to take out a patent in France, without coming into France, can make such deposit of documents as is provided by article 5, by handing them to a French diplomatic representative, who will transmit the same to France.

ART. 6. The application must be limited to a single principal object, the details constituting the same, and the application thereof which may have been indicated. It shall mention the terms that the petitioners have asked for, within the limits prescribed by article 4, and shall contain no conditions, restrictions or reserves.

It shall designate a title, consisting of a summary and precise description of the object of the invention. Such description must not be written in a foreign language, and must not contain alterations or additions. Words struck out must be counted and stated, and the pages and marginal notes initialed.

Such document must not contain any other denomination of weights and measures than those specified in the tables annexed to the law of July 4, 1837.

Drawings must be traced in ink according to the metrical scale.

Duplicates of the description and of the drawings must be joined to the petition.

All the documents must be signed by the petitioner or by his attorney in fact, whose power must be annexed to the petition.

As the specification may include the details which constitute the invention claimed, and the application of the invention claimed by the inventor, it has been decided that the patentee of a patent for purifying gas by soda and alum can obtain by the same patent the right to obtain soda and alum by processes which are to be specially employed in purifying gas. (Court of Cassation, May 4, 1865.) But it is not necessary that all the applications of an object should be enumerated by the inventor. An application not enumerated is protected by the principal patent if it arises naturally from the invention. (Court of Cassation, December 17, 1837.)

The specification should also give a title to the patent, which should designate plainly the invention claimed. Patents are classed in alphabetical order at the offices of the ministry of agriculture and commerce, in order that the public may be able easily to see, on inspection, if a patent has been taken for such and such an invention or in relation to such and such a matter.

The object of the patent should also be described. The metric system alone must be used to designate weights and measures. The description is of great importance. It must be at least sufficiently detailed to enable the article invented to be manufactured therefrom; that is to say, it should indicate in a complete and straightforward manner, the various means employed by the inventor.

In default of these conditions being complied with, the patent is void and of no effect. The law does not require that the description should enumerate all the points appertaining to the invention; but the patentee acquires the exclusive property in what he describes. A drawing or sample cannot replace a description.

Finally, the drawings and samples necessary for the explanation of the description must be joined to the petition.

ART. 7. No deposit shall be received, unless accompanied by a

receipt acknowledging payment of the sum of 100 francs, on account of the whole fee due for the patent.

A certificate drawn up free of expense by the secretary-general of the *prefecture*, upon a register for that purpose, and signed by the petitioner, shall be evidence of every deposit, and shall state the day and hour of the same. A copy of such certificate shall be handed to the depositor upon payment of the stamp duty.

ART. 8. The patent shall begin to run from the day of the deposit prescribed by article 5.

SECTION II.

ON THE DELIVERY OF PATENTS.

ART. 9. Upon the deposit of the application, and five days from the date of the deposit, the *prefect* shall forward the papers, under the seal of the inventor, to the minister of agriculture and commerce, and join thereto a certified copy of the certificate of registration, the receipt proving the payment of the tax, and, if there be one, the power of attorney mentioned in article 6.

ART. 10. Upon the arrival of the papers at the ministry of agriculture and commerce, they shall be opened and the demand shall be registered; and the patent shall be issued in the order of the receipt of the petitions.

ART. 11. Patents, the petitions for which have been properly made, shall be delivered, without previous examination, at the risk and peril of the petitioner, and without guarantee either of the existence, novelty or merit of the invention, or of the fidelity or exactness of the description.

A decree of the minister, proving the regularity of the demand, shall be delivered to the petitioner, and shall constitute his patent.

To such decree shall be annexed a certified duplicate of the description, and of the drawings mentioned in article 6, after they have been compared with the originals and declared to be in conformity therewith.

The first copy of patents shall be delivered without cost. For any further copy required by the patentee or his representative, a fee of 25 francs is chargeable. Drawings shall be at the expense of the applicant.

ART. 12. All petitions in which the formalities prescribed by Nos. 2 and 3, of article 5, and by article 6, have not been observed shall be rejected. Half the amount paid shall remain the property of the treasury, but the petitioner may receive back the whole of

the amount, if he repeats his demand for a patent within three months from the day upon which he received notice of the rejection of his prior petition.

ART. 13. In cases where, by the application of article 3, patents cannot be granted, the tax can be returned.

ART. 14. An ordinance in the *Bulletin des Lois* shall publish every three months all the patents delivered within that time.

ART. 15. The term of a patent can only be extended by special law.

SECTION III.

ON CERTIFICATES OF ADDITION.

ART. 16. The patentee or his representatives have the right, during the whole term of the patent, to register changes, improvements or additions thereto, upon fulfilling the formalities prescribed by articles 5, 6 and 7 as regards registration.

Such changes, improvements or additions shall be evidenced by certificates, delivered in the same form as the principal patent, and shall have, from the respective dates of petition and delivery, the same effects as the principal patent, to which they pertain.

A fee of 20 francs shall be paid for every petition for a certificate of addition.

Certificates of addition taken out by one of several parties who have an interest in the patent, shall benefit the remainder.

ART. 17. Any patentee, who, for a change, improvement or addition, desires to take out a principal patent of five, ten, or fifteen years, instead of a certificate of addition which expires with the original patent, must fulfill the formalities prescribed by articles 5, 6 and 7, and pay the tax mentioned in article 4.

The law affords two means of improving the original invention. The patentee can either take out a new patent which is called a "*brevet de perfectionnement*" (patent for improvement), or he can obtain a "*certificat d' addition*" (certificate of addition). If he takes out a patent for improvement, he must proceed in exactly the same way as when taking out the first patent. He must pay an annual tax of 100 f. and carry out all the formalities prescribed for the principal patent. By this course he will actually have a further patent, which will be absolutely independent of the prior one, and will extend to five, ten or fifteen years, according to the period fixed in the petition. As the patent for improvement is a distinct patent altogether from the principal patent, it follows that in the case of the transfer of the principal patent, the transferee, unless a contrary stipulation be made, acquires no right whatever over the patent for improvements.

It may be that the patentee, if the modification is insignificant, is unwilling to take out a new patent, which would necessitate the carrying out on his part of many form-

alities, and the payment of an annual tax of 100 francs. In this case, the law leaves him the resource of taking out a certificate of addition. Such certificate is applied for in the same way as a patent, but it has the advantage of requiring the payment of 20 francs only for the whole of its duration; but in contradistinction to the patent for improvement, the certificate of addition is absolutely dependent upon that of the principal patent. It lasts for the same period, and is liable to extinction at any time that the original patent expires, or becomes canceled for any reason whatever. (Court of Cassation, June 1, 1865, and December 14, 1868.) The same rule holds, though the certificate of addition contains, in fact, a new invention. (Court of Appeal, July 7, 1854.)

A certificate of addition depends upon the prior patent. It follows that all the parties can avail themselves of it, and that all the representatives of the inventor can profit by it. Thus, in the case of a transfer of the original patent, unless a contrary stipulation be inserted, the transferee acquires all the certificates of addition which have been taken out in relation thereto. In short, the certificate of addition is an economical way of taking out a patent for improvements; but it has also its inconveniences, the greatest of which is, that it stands or falls with the principal patent, when the latter expires or becomes annulled or canceled by law. A certificate of addition is also liable to be canceled upon the ground that it has no relation to the principal patent.

ART. 18. No person other than the patentee or his representatives acting as above mentioned can, during the space of one year, legally take out a patent for a change, improvement, or addition to the invention constituting the object of the prior patent. Nevertheless any person who desires to take out a patent for a change, addition, or improvement to a discovery already patented, can, during the said year, send in a petition, which shall be transmitted to, and shall remain deposited under seal with the minister of agriculture and commerce. When the year has expired, the seals shall be broken, and the patent delivered. Nevertheless, the principal patentee shall have a preference as to the changes, improvements and additions, for which he may himself, during the year, have demanded a certificate of addition or a patent.

A change, an improvement or an addition to a patent may be discovered by a third party. The law, however, is less favorable as regards improvements than as regards inventions. The inventor has two means of protecting his improvements, viz.: *brevet de perfectionnement* and *certificat d' addition*. A party other than the original inventor has only one means of protecting his invention, viz.: he must take out a *brevet de perfectionnement*.

Again, in order to prevent competition, which necessarily would be advantageous to the party taking out the patent for improvement, the latter cannot work such patent until after the expiration of the principal patent. This provision is a favor which the law grants to the original patentee. Another favor granted to him is, that if, within the year immediately following, he discovers any improvement on his invention, he has a priority over all others, who may, during the same year, discover the same

improvement. Thus during the year following the taking out of the patent, an immense advantage is secured to the inventor ; but this does not absolutely close the door to other parties, for they can always, during such period, present petitions for patents for improvements invented by themselves, subject to the condition that if the original patentee also invents the same improvement, the preference is granted to him.

In order, however, to conciliate all interests, those of third parties as well as those of the inventor, the law requires that all demands by third parties for patents for improvements, must be deposited under seal, and such applications are not opened until the expiration of one year after the original patent was delivered. This period of one year runs from the day of the deposit of his claim. Certain authorities, however, have decided that the period runs from the date of the delivery of the patent. (Tribunal of Epernay, October 4, 1860.)

ART. 19. No person who has taken out a patent for a discovery, invention, or application attaching to the object of another patent, shall have any right to work the invention already patented ; and reciprocally, the proprietor of the original patent may not work the invention which is the object of such subsequent patent.

SECTION IV.

OF THE ASSIGNMENT OF PATENTS.

ART. 20. A patentee may assign the whole or a part of his patent.

The total or partial assignment of a patent, whether gratuitous or for a valuable consideration, must be by notarial deed, and upon payment of the entire amount of the tax prescribed by article 4.

No assignment shall be legal as regards third parties, until it has been registered at the secretary's office of the *préfecture* of the department in which the deed of assignment shall have been executed.

Assignments, and all other deeds relating to the same, shall be registered upon the filing of an authenticated copy of the assignments. A copy of all certificates of registration involved, together with a copy of the assignment above mentioned, shall be forwarded by the *préfets* (prefects) to the minister of agriculture and commerce, within five days from the date of the registration.

ART. 21. A register shall be provided at the ministry of agriculture and commerce, upon which shall be inscribed every assignment of every patent ; and every three months, an ordinance shall publish in the form provided by article 14, the assignments that have been registered during the previous quarter.

A patent is personal property ; it can therefore be pledged in the same way as all other personal property, and the ordinary rules of law must be observed by relation

thereto. It can also be sold by the creditors of the inventor in the same way as other personalty. Such sale must be effected through a notary. A patent can be transferred wholly or in part gratuitously, or for a valuable consideration, or for the whole of its duration or for a part.

The patentee can, while preserving the property in his patent, and without transferring any part of it, grant to third parties the right of working his invention, in totality or in part. Such a concession is called in French "*tolérance*" (license). No special form is required. A license may be granted by a simple letter.

As in regard to other contracts, a deed of transfer of a patent is, in case of ambiguity, more strictly interpreted against the transferer than against the transferee.

In practice, the *préfets* do not comply as regards this registration with the provisions of article 20. They follow those of the *Instruction Ministérielle* of October 31, 1844, which are as follows:

No deed of transfer can be registered, except upon the production and the deposit of the following, viz.:

1. Of the receipt proving the payment of the last installment at the proper period ;
2. Of the receipt of the *Receveur Général* in the departments, and of the *Receveur Central* in Paris, proving the payment of the whole of the taxes relating to the patent ;
3. Of an authenticated extract of the notarial deed executed before a notary of the department, and proving the total or partial transfer of the patent, either gratuitously or for a valuable consideration. If the patent, however, had been previously transferred, a certificate of the registration of the said transfer, and an authentic extract of the notarial deed above mentioned would suffice for the registration. Only this document need be annexed to the *procès verbal*.

The law has not indicated a fixed period within which registers of transfers of patents must be filed, but non-compliance with the formalities of registration renders the transfer void as regards third parties. Such nullity, however, concerns third parties alone; the transfer is, nevertheless, binding between the parties themselves. (Court of Paris, March 19, 1861.) But the courts do not consider infringers as third parties. The latter cannot, therefore, plead the irregularity of the transfer. (Court of Paris, March 2, 1849.) The same may be said in regard to the necessity of a notarial deed to make a transfer of a patent. The above two propositions have been decided by the Court of Appeal of Paris, February 19, 1876.

The doctrine above stated applies to transfers for valuable consideration. As regards gratuitous transfer, it is necessary, besides the above mentioned formalities, that the special provisions of the French law relating to deeds executed gratuitously or without valuable consideration, should be observed. Again, what has been said applies to transfers made in France. It is clear that a French patentee can there make an effective transfer according to the formalities of the country in which he is residing; but as soon as he re-enters France, he should, without delay, have the deed registered at the secretary's office of the *préfecture* of one of the districts in France. Lastly, what has been said applies solely to French patents, as transfers of foreign patents can be carried into effect in the form used for the transfer of any other kind of personal property.

When a transfer of personal property takes place, the transferer guarantees to the transferee the existence of the object transferred. This general principle of law applies to transfers of patents, and that if at a future time the patent becomes void or

fails, the transfer has been made without consideration, and consequently becomes void. In order to avoid this guarantee, the transferer should insert special stipulations to this effect in the deed of transfer. Again, notwithstanding all such stipulations, it is clear that he remains responsible, if the invention be not in reality applicable, and if it cannot give the results which constituted the object of the patent. Again, although a transferer may have stipulated that he shall not be liable in the event of the patent being declared void, such a clause cannot protect him in such a case, on account of an act for which he is personally responsible. The transfer of a patent which is declared to be void on the ground of insufficiency, is of no effect.

It has been decided that although the transfer of a patent is, in a certain sense, a contract of chance, yet the transfer is, notwithstanding, a contract, and that it must be regarded as being without consideration, and consequently void, when the invention is not capable of an industrial application. (Cassation, August 22, 1861.) But if the transferee contracted with full knowledge of the facts, and if he profited by the working of the patent until the date when it was declared void, the deed of transfer will hold good. (Paris, August 6, 1855.)

When once the contract of transfer is canceled, what is the situation of the parties? Must the transferer refund the consideration to his transferee?

It has been decided that in the case of a patent being declared void, the transferer is not obliged to reimburse the transferee the installments received by him in payments except after deducting profits derived from the invention up to the date of the declaration of nullity by the transferee. (Court of Cassation, May 25, 1869.)

The fact of the inventor having granted licenses to various parties does not prevent him selling his patent to other parties, but the transferees must respect all licenses granted prior to such transfer. A licensee cannot bring an action for infringement of a patent. A patentee cannot grant power to a licensee to bring such action in his name, as in France no party can plead in the name of a third person. (Cassation, March 8, 1852; April 27, 1869.) A licensee is entitled to be secured, by his grantor, in the peaceable working and quiet enjoyment of the invention: but as long as no one disturbs his enjoyment, he has no claim against the inventor. If, however, an infringer damages his license, his right to security immediately arises.

Besides voluntary transfers of patents, there are other modes of transfer. A patent can be transmitted by succession, gift, transfer to a company, and partition, as in the case when co-proprietors cannot work a patent together. In other cases in which such voluntary transfers take place, the deed must be registered. Again, a patent can be sold by forced sale. An unpaid creditor has the right to seize and sell the patent of his debtor. The seizure of a patent is effected by means of an *opposition* lodged with the minister of agriculture and commerce. Such *opposition* must be preceded by what is called a *commandement* (summons) and can only be made pursuant to a *titre exécutoire*.

ART. 22. The assignee of a patent, and those who may have acquired from a patentee or his representatives the right to work a discovery or invention, are entitled to the benefit of all certificates of addition which may be subsequently delivered to the patentee or his representatives. Reciprocally, the patentee or his representatives shall benefit by the certificates of addition which may be subsequently delivered to assignees.

All parties who have a right to certificates of addition, may obtain delivery of a copy thereof at the ministry of agriculture and commerce, upon payment of the sum of 20 francs.

The patentee can always prevent the transferee being enriched by an important addition. He has only to take out a patent for improvement himself. In this case, he will retain, individually, his improvement, unless it be stipulated in the deed of transfer that all subsequent patents for improvements shall belong to the transferee.

SECTION V.

OF THE COMMUNICATIONS AND PUBLICATIONS OF DESCRIPTIONS AND DRAWINGS OF PATENTS.

ART. 23. Descriptions and drawings, samples and models of patents delivered, shall, until the expiration of such patents, remain deposited with the Ministère of agriculture and commerce, where they may be referred to by the public, free of charge.

Any person may obtain, at his expense, a copy of such descriptions and drawings upon compliance with the formalities prescribed in the *règlement* made as provided by article 50.

ART. 24. After the payment of the second annuity, the descriptions and drawings shall be published in full or in part.

At the commencement of each year a catalogue, containing the titles of patents delivered during the preceding year, shall also be published.

ART. 25. The collection of descriptions and drawings, and the catalogue published pursuant to the preceding article, shall be deposited with the Minister of agriculture and commerce, and with the secretary of the *préfecture* of each department, where they can be consulted free of expense.

ART. 26. At the expiration of the patents, the original descriptions and drawings shall be deposited with the *Conservatoire des Arts et Métiers*.

TITLE III.

OF THE RIGHTS OF FOREIGNERS.

ART. 27. Foreigners may obtain patents of inventions in France.

ART. 28. The formalities and conditions prescribed by the present law shall be applicable to patents demanded or delivered in execution of the preceding article.

ART. 29. The author of an invention or discovery already patented abroad, may obtain a patent in France, but the duration

of such latter patent cannot exceed that of the patent delivered abroad.

TITLE IV.

OF ANNULMENT AND FORFEITURE; AND OF ACTIONS RELATING THERETO.

SECTION I.

OF REPEAL AND FORFEITURE.

ART. 30. Patents delivered in the following cases are void and of no effect:

1. If the discovery, invention or application is not new ;
2. If, pursuant to the terms of article 3, the discovery, invention or application is not susceptible of being patented ;
3. If the patents relate to principles, methods, systems, discoveries, or theoretical or purely scientific conceptions, the commercial applications of which are not described therein ;
4. If the discovery, invention or application is considered contrary to public policy and good manners, and to existing laws,—without prejudice in such case, and in that provided in the preceding paragraph, to the penalties which may be incurred for the manufacture or the sale of prohibited objects ;
5. If the title under which the patent has been demanded fraudulently indicates an object other than the true object of the invention ;
6. If the description joined to the patent is not sufficient for the carrying out of the invention, or if it does not indicate in an explicit and complete manner the true means employed by the inventor ;
7. If the patent has been obtained contrary to the provisions of article 18.

Certificates of changes, improvements, or additions which do not relate to the principal patent, shall also be void and of no effect.

There is a great difference between the *annulment* (repeal) and the *dechéance* (forfeiture) of a patent. Annulment renders the patent void, as well for the past as for the future. Forfeiture renders it void for the future only. There is another distinction between them. Annulment may be pronounced only for a part of a patent, leaving the rest valid, whereas forfeiture affects the entire patent. Actions for either can be instituted against the inventor by individuals or by the *ministère public* (public minister). In the first case, they are valid as between the parties only ; as in France, judgments, affect only the parties thereto. In the second case, they are valid as to all

parties; the public minister represents the public. The same proceeding applies to certificates of addition. Judgments affecting the original patent affect equally all the certificates of addition pertaining thereto, because the existence of the latter depends upon the former; but the converse is not true. The civil tribunals have sole jurisdiction in both cases.

There is valid ground for annulment when the discovery, the invention, or the application is not new. If it were permitted to obtain a patent for an old invention, this would damage the interests of third parties having already taken out patents, and would also prejudice the public who have already acquired a right in such old patents. However, it is not necessary that the invention should be new as regards all its parts; an invention which comprises an assemblage of various elements is patentable, if some of such elements are new. (Court of Appeal of Paris, March 21, 1860.) When the invention patented is composite, the courts can cancel it as regards those parts that are not new, and maintain it as regards those that are new. An invention is not reputed to be new, when an anterior invention, or the fact that it has been previously divulged, can be proven.

Subdivision 7 of article 30 provides, that certificates of addition are also void that have no connection with or reference to the principal patent. It is the intention of the law to prevent the payment of a simple sum of 20 francs, instead of 5, 10, or 15 annuities of 100 francs each, under pretense of taking out a certificate of addition, and thus obtaining an actual patent for quite another invention. The question as to whether a certificate of addition is connected or not with the principal patent is a question of fact. The Court of Appeal of Paris, on July 20, 1875, confirmed a judgment of February 3, 1874, and thereby annulled the certificate of addition taken for fastening cravats without a band round the neck, when the original patent was taken for a system of fastening cravats with a band round the neck; but a sufficient relation exists between the certificate and the patent, although the certificate is only connected as an accessory to the principal operation patented, provided its object is to facilitate and complete the execution of such principal operation. (Court of Lille, July 17, 1874; Court of Douai, March 15, 1875.)

ART. 31. Any discovery, invention or application, which in France or abroad, and previously to the date of the deposit of the demand, has received sufficient publicity to enable it to be worked, shall not be reputed to be new.

In order to constitute a publicity sufficient to annul a patent, it must have been such as to render the execution thereof possible. Simple indiscretions of newspapers or general descriptions without details of special apparatus, do not constitute prior publication. (Court of Appeal of Colmar, December 7, 1864.) Also a statement in a scientific work, unaccompanied by working explanations will not be considered as a previous publication. (Court of Paris, April 16, 1866.) The fact of having divulged one's intention to a third party, does not cause it to fall into the public domain, if the third party does not reveal the secret which has been confided to him. (Court of Appeal of Paris, April 16, 1866.) Again, a communication made to a learned society does not operate as divulcation, if it is made confidentially and privately. Consequently, a confidential communication made to a jury of an exhibition, before a patent is taken out, does not constitute publication. (Court of Appeal of Paris, March 8, 1859.) As regards trials made by an inventor before taking out his patent, it has

been decided, that simple experiments, without results, do not constitute a prior working, especially when the patentee has since modified his invention in important details. There are certain inventions which can only be tried in public, such as fire-engines, guns, cannon, lifts, &c. As regards these inventions, if the trial is made in public, in the absence of any precautions to keep them secret, the inference to be drawn is, that the inventor desired to abandon his invention to the public. Such an act constitutes a divulcation. It will be otherwise, however, if a simple view of the experiment would be insufficient to reveal its nature. These principles relating to trials and public experiments have been affirmed by the Court of Appeal of Paris.

ART. 32. The following shall be deprived of all their rights:—

1. The patentee who has not paid his annual payment before the commencement of each of the years of the duration of his patent.

2. The patentee who has not worked his discovery or invention, in France within a period of two years, dating from the day of the signature of the patent ; or who has ceased during the space of two consecutive years to work the patent—unless in either case he can justify his inaction.

3. The patentee who has introduced into France, objects manufactured abroad, and similar to those protected by his patent. * Nevertheless, the minister of agriculture and commerce and of public works, can authorize the introduction of the following:—1. Models of machines. 2. Objects manufactured abroad destined for public exhibitions or for trials to be made with the consent of the government.

FIRST CAUSE OF FORFEITURE. Each installment must be paid before the commencement of each year of the duration of the payment. The period within which such payment must take place, is reckoned day by day. If the year commences on the 1st of May, it terminates on the 1st of May of the following year. The day on which the patent commences is not reckoned. (Court of Cassation, January 20, 1863.) Thus a patentee who has sent in his demand for a patent on May 1, 1860, can pay his annuity up to midnight of May 1, 1861.

This rule is peremptory, and cannot be transgressed by a single hour ; therefore if the date of the expiration fall on a public holiday, the patentee must pay the installment on the day preceding. (Court of Paris, July 27, 1865.)

“*Force majeure*” alone can release the patentee from a forfeiture of his patent. (Court of Cassation, March 16, 1864.) The illness of the patentee, his madness, or even his death, does not constitute a case of *force majeure*. (Court of Appeal of Paris, May 24, 1859.)

Forfeiture arises by effect of law, and the judge limits himself to giving effect to it ; an ulterior payment cannot revive the patent. (Court of Paris, July 10, 1861.)

SECOND CAUSE. The reason of this forfeiture is, that the fact of the inventor not working his invention renders it useless to trade, and it even becomes hurtful to

* As modified by the law of May 31, 1856, by adding the words which follow the asterisk.

commerce and prevents commerce. The law requires that a patent should be really worked in a practical manner; a single act of working is not sufficient. (Court of Paris, March 23, 1870.) If a patent contain several modes of procedure, it suffices to comply with the law, that the inventor should have worked one of them. (Court of Paris, February 7, 1859.) If the object manufactured differ only slightly from the object for which the inventor takes out the patent, there is no ground for forfeiture. (Court of Cassation, May 23, 1859.) An inventor is allowed to explain the causes of his inaction. The court has wide power of discretion in these cases; thus it has been decided that the absence of pecuniary resources can be held to justify the default of working. (Court of Paris, January 11, 1859.) The inventor who has caused his invention to be admitted to a public exhibition, and who has sold it to a third party, has sufficiently worked it thereby to avoid forfeiture.

The provisions relating to forfeiture apply equally to the certificate of addition; but it is clear that if the certificate of addition be declared void, the original patent continues to exist. It follows that the patentee can avoid (*déchéance*) forfeiture either by working the patent himself, or by allowing it to be worked by a third party.

THIRD CAUSE. This is a clause in favor of French industry. The object of the law is to favor the national trade; therefore, if the introduction has not a commercial object in view, it cannot injure French industry, and does not, therefore, form a ground for forfeiture. And forfeiture does not follow the simple fact of the introduction in France of the manufacture abroad, of objects similar to those of the patent. It is necessary, besides, that the intention of the patentee to withdraw from the undertaking given by him to permit France to benefit solely by the manufacture and the working of his invention, should be proved. (Court of Paris, June 12, 1869.)

Evidently, no forfeiture will exist if the introduction do not take place by the act of the patentee; thus, in the case of the act of a third party, purchaser, co-proprietor, transferee, etc. In France, acts of default, together with the penalties appertaining thereto, are reputed to be personal. (Court of Paris, April 24, 1855).

The law of May 30, 1856, has modified the severities of article 32 of the former patent law, as regards introduction. This law was necessary; without it, the greater part of the patents of importation would be void.

ART. 33. Any person who, in advertisements, prospectuses, signs, publications, marks or stamps, describes himself as a patentee, without possessing a patent delivered pursuant to law, or after the expiration of a prior patent; or who, being a patentee, makes mention of his titles, without adding the words, "*Sans garantie du Gouvernement,*" shall incur a penalty of from 50 francs to 1,000 francs, and in case of repetition the penalty may be doubled.

It has been decided that the use of the abbreviation *S. G. D. G.*, alone, is not a compliance with the law; to inscribe the words in full is necessary. (Court of Nancy, February 7, 1851.) But in practice the letters *S. G. D. G.* alone are employed, and after the expiration of the patent the owner often continues to use the word "*breveté.*" Either of these acts is a misdemeanor, but the government does not interfere, unless at the instance of a party claiming to have suffered damage therefrom.

SECTION II.

OF ACTIONS FOR ANNULMENT OR FORFEITURE.

ART. 34. All parties interested can institute proceedings for the annulment or forfeiture of a patent. Such actions, as well as all contests relative to property in patents, must be brought before the civil court of first resort.

The persons having interest in the patent in question, must have a *bond fide* interest which can be recognized by the court. It has been decided that a person believing himself to be threatened with an action for infringement by a patentee, has a sufficient interest to entitle him to commence a suit for the annulment of a patent. It results in general that an action for annulment or forfeiture against a patent which has expired cannot be brought. Actions for annulment or forfeiture can be brought either as principal demands or claimed by way of set-off. This latter case arises when a person sued for infringement pleads the nullity or defect of the patent by reason of which it is proceeded against.

A person criminally prosecuted for infringement of patent can plead in the *tribunal correctionnel* that the patent is void. In this case, if he proves the nullity or the defect, he would be acquitted; but that is all the court can do; it cannot annul or forfeit the patent itself, it can only condemn or acquit the defendant. (Court of Cassation, April 1, 1870.)

ART. 35. If the action is brought simultaneously against the proprietor of the patent and against one or several assignees, such action must be brought in the court of the domicile of the owner of the patent.

When the patentee has not been summoned, and a transferee has been sued, the former can intervene in the action in order to defend his patent.

ART. 36. The proceedings must be commenced and carried through in the form prescribed for summary matters by article 405 and the Code of Civil Procedure. Notice thereof shall be given to the *procureur* of the republic.

In the event of two demands being entered with regard to the same patent before two different tribunals, the rules of the Code of Procedure relating to such cases are applied. (Code Civ. Pro. art. 171.)

In the same manner, if criminal proceedings for infringement are taken at the same time as civil proceedings for cancellation of a patent, the criminal proceedings are adjourned until the question of the nullity of the patent has been decided. (Court of Cassation, February 14, 1855.)

ART. 37. In all proceedings to obtain the repeal or forfeiture of a patent, the public minister may intervene and demand that a judgment for the same be rendered. He may even proceed immediately in a special action to obtain a judgment for the repeal of a patent in the cases provided by Nos. 2, 4 and 5 of article 30.

Judgments pronounced for the annulment or forfeiture of patents, have only a relative value (Civil Code, art. 1351); that is to say, the benefit of such annulment or forfeiture can only be invoked by the parties to the action; the patent remains good as regards persons who have taken no part in the proceedings.

It has been decided that a judgment rendered by a foreign court upon the question of the invalidity of a patent taken abroad, cannot be invoked as final in case the question is raised before a French court by the same parties, or in relation to a patent taken in France arising out of the same invention. (Court of Paris, December 13, 1860.)

ART. 38. In the cases provided by article 37, all parties interested in the patent, whose muniments of title have been registered at the ministry of agriculture and commerce, pursuant to article 21, must be cited.

ART. 39. When a final judgment for the absolute repeal or forfeiture of a patent has been rendered, notice thereof shall be given to the minister of agriculture and commerce, and the repeal or the forfeiture shall be published in the form prescribed by article 14, relating to the obtaining of patents.

The public minister cannot intervene before the *tribunal correctionnel*, as such court cannot annul or forfeit a patent (Court of Amiens, December 28, 1850); nor in the action which article 34 provides for a further action against a patentee, viz.: an action relating to the property itself of the patent. The ownership of a patent can be contested; but the public minister cannot in such cases intervene.

TITLE V.

OF INFRINGEMENT.—PROCEEDINGS AND PENALTIES RELATING THERETO.

ART. 40. Any violation of the rights of the patentee, either by the manufacture of articles, or by the employment of means patented, constitutes the misdemeanor of infringement. Such offense is punished by a fine of from 100 francs to 2,000 francs.

WHAT CONSTITUTES INFRINGEMENT IN GENERAL. It is not necessary, in order to constitute an infringement of the rights of the patentee, that the manufacture or the employment as above should cause him prejudice. (Court of Cassation, March 20, 1857.) It matters not whether the invention be important or otherwise, or whether the infringement be total or partial, or whether it be made for the sake of gain or simply for the personal use of the infringer. (Court of Paris, February 25, 1851.)

MANUFACTURE OF PATENTED OBJECTS. As regards the manufacture of an isolated piece of a machine, it is certain that if such portion is the essential contrivance or one of the essential contrivances of the machine, the fabrication thereof will constitute infringement. There may be infringement when all the portions manufactured are individually public property, only, however, when the intention exists of uniting them, later, to construct the object patented in its entirety. (Court of Cassation, July 26, 1851; Court of Paris, February 15, 1867.)

Upon the question whether a manufacturer who repairs portions of a patented object is guilty of infringement as against the patentee, the law was for a long time unsettled. A judgment of the *Tribunal Civil* of the Seine, confirmed by a judgment of the Court of Appeal of Paris, February 15, 1867, established it as follows: "Repairs do not amount to infringement, when the effect thereof does not amount to the construction of an entirely new article."

The great principle by which the judges are guided is, that in order to decide whether there has been infringement, we must examine the resemblances and not the points of difference between the product or means patented and the product or means asserted to be infringements. (Tribunal Correctionnel of Paris, January 11, 1876; Court of Appeal of Paris, February 25, 1876; Court of Cassation, June 23, 1876.) From this principle it follows that the infringer cannot, to excuse himself, contend that he has perfected the invention, because to improve, in such a case, is to infringe. (Tribunal Civil of the Seine, January 14, 1870; Court of Appeal of Paris, July 2, 1878; Court of Cassation, March 4, 1876.) To adjudicate upon questions of infringement, the judges should compare the object claimed to be infringed with the object described in the patent, and not that manufactured by the patentee. (Court of Cassation, December 30, 1843.) This is natural, as the object manufactured by the patentee does not deserve the protection of the law, unless it be covered by the patent itself.

As the law punishes the infringing manufacturer of a patented article, the person ordering such article must be placed upon the same footing; his culpability is equally great, if not greater than that of the manufacturer (Paris, February 10, 1859); but the law does not treat in the capacity of manufacturer, the workman, or even the foreman, who is only working under orders.

EMPLOYMENT OF PATENTED MEANS. The employment itself is punished, whether the infringer have acted *bona fide* or not. (Court of Cassation, December 3, 1841.) The rule is severe, but it follows from the text of the law. (Compare article 40 with article 41.) The word "knowingly," which is contained in article 41, which permits the infringer to be acquitted if he has not acted "knowingly," and if he has acted in good faith, does not exist in article 40, therefore the *bona fides* mentioned in article 40, can be taken in consideration of extenuating circumstances, but not as an excuse giving a right to acquittal. Evidently, the employment or use punished by law, must be a commercial user; a user purely personal does not constitute infringement. Thus a person who purchases an infringed object thoughtlessly or without an intention of commercial speculation, but for his personal use, does not commit the offense of infringement. (Court of Cassation, February 27, 1858.)

ART. 41. Parties who have knowingly concealed, sold, or exposed for sale, or introduced upon French territory one or more infringed articles, incur the same penalties as infringers.

COMPLICITY IN INFRINGEMENT. The four acts defined by above law to be separate offenses, are in reality rather acts of complicity, included by the law with cases of infringement specially punished by article 40, viz., manufacture and employment. Such acts are the sole acts of complicity punished by the law of 1844. The agent of an infringer is not his accomplice, even should he act knowingly. Thus, he cannot be prosecuted for any act of concealment, sale, or exposure for sale, or introduction. (Court of Cassation, July 26, 1850.)

A person guilty of one of the four offenses mentioned in article 41, can plead his

good faith. This arises from the word "knowingly" inserted in the text. Thus, a retailer or introducer can plead good faith. His best means of proving such good faith is to disclose the name of the manufacturer of the articles infringed, in order that the infringed articles may be seized upon his premises.

A single act of sale suffices to bring an offender within the law. Article 41 enacts a certain punishment, and must be as strictly construed as other penal enactments. Thus, the gift or exchange of a patented object cannot be punished. Again, the purchase of an infringed object is not a misdemeanor; but the possession of such object by the purchaser can be construed into an act of user or an act of sale, according to the good faith of the holder, or the contrary. As regards exposure for sale, such exposure must be made by the trader with the evident intention of sale. The placing of goods in the Universal Exhibition of 1867, did not constitute an exposure for sale within the law. (Paris, January 9, 1868.)

The introduction of counterfeit articles into France, in transit only, does not constitute a misdemeanor. (Paris, July 23, 1860.) It is otherwise if the goods are found in the custom-house or bonded warehouses, as such goods are not necessarily destined for re-exportation. (Court of Paris, May 30, 1861.)

Such are the four offenses to which the law of 1844 extends the penalties for infringement by manufacture or user, but the law makes this difference, viz., that the bona fides admitted simply as extenuating circumstances with respect to the offenses comprised in article 40 constitutes, on the contrary, an entire defense, with right of acquittal, with respect to offenses contained in article 41. With the sole exception of this difference, these two categories of offenses are subject to the same principles. The penalty is the same, viz., 100 francs to 2,000 francs. In case of repetition, the increase of the punishment is the same; one month to two months' imprisonment.

ART. 42. The penalties provided by the present law cannot be cumulated.

The heaviest penalty alone may be imposed for all acts anterior to the commencement of proceedings

ART. 43. In case the offense is repeated, a penalty of imprisonment for a term of from one to six months shall be pronounced over and above the fine provided by articles 40 and 41.

An offense is deemed to have been repeated when the defendant has been convicted of the same offense within the previous five years.

Imprisonment for from one to six months may also be inflicted, if the infringer be a workman or an employe who has worked in the factory, or in the establishment of the patentee, or if the infringer has associated himself with such workman or employe of the patentee, or acquired knowledge from the latter of the details comprised in the patent. In the latter case, the workman or employe can be prosecuted as an accomplice.

"Associated," in the third paragraph means that an agreement or fraudulent conspiracy has been formed. In order to punish the former workman and the new

employer, proof that an agreement of partnership existed between them is not required.

ART. 44. Article 463 of the Penal Code * may be applied in the cases covered by the preceding provisions.

ART. 45. Proceedings in the *tribunal correctionnel* to obtain the application of the penalties above mentioned, cannot be instituted by the public minister except upon complaint of the injured party.

PARTIES who may sue for infringement. They are: 1. The owner of the patent. He may institute proceedings, whether he be a simple individual or a company. The heirs and legatees of the patentee and the transferees of the patent can also sue. Those who have the uses of the patent can proceed, but naked ownership does not justify an action, as infringement must injure the exercise of the right to work the patent, not the mere title to it.

2. The public prosecutor, in the *tribunal correctionnel*. But although infringement constitutes a misdemeanor, the public prosecutor cannot act of his own accord. He can only act upon a complaint made by the injured party. Yet, the offense is a misdemeanor, the withdrawal of the injured party does not necessarily put an end to the proceedings of the public prosecutor.

If the proprietor of the patent be under legal incapacity, such as a minor, an interdicted person, or an individual provided with a *conseil judiciaire*, or a married woman, he or she cannot proceed without the aid of parties legally capable of representing him or her, such as guardians or the *conseil judiciaire*, the husband, or the permission of a court of justice. But a bankrupt can sue for infringement without the consent of his assignee.

TIME WITHIN WHICH SUIT MAY BE BROUGHT. The duration of the right to sue dates from the day of the demand of the patent, pursuant to article 5. If the patent by virtue of which the suit is brought has expired, the action can still be brought upon two conditions: 1. That the acts of the plaintiff all took place previous to the expiration of the patent;

2. That they were not barred by lapse of time at the period of the commencement of the proceedings.

Moreover, actions for infringement are regulated by articles 637 and 638 of the Criminal Code, and are barred after three years. Acts of manufacture and of sale, although continuous, do not constitute successive offenses. It follows, therefore, that infringements by manufacture and by sale constitute a series of distinct misdemeanors, each of which can be prosecuted, and the limitation of action of three years runs, in relation to each, from the date upon which the offense was committed. (Court of Cassation, August 8, 1857.)

WHO MAY OR SHOULD BE SUED. The parties to be prosecuted are: The infringer and those included with him by law. (Articles 40 and 41.) If the infringer is in bankruptcy, the *syndic* must be sued, even if the cause be tried before a criminal court, on account of the pecuniary penalties demanded by the plaintiff. If a company is the infringer, each of the members must be proceeded against in the criminal court, as misdemeanors are personal. If a company is in liquidation, the liquidator must be sued, as above, on account of the pecuniary penalties which the plaintiff demands.

* This article authorizes the admission of "extenuating circumstances."

ART. 46. The *tribunal correctionnel*, if it has once obtained jurisdiction of an action for infringement, may decide upon the defenses put forward by the defendant, either as regards the repeal or forfeiture of the patent, or upon questions relating to property in the said patent.

ART. 47. The owners of the patent can by virtue of an order of the court of first resort, proceed by *huissier* to designate and describe in detail, with or without seizure, the objects which they assert are infringed. The order may be made upon a simple petition, or upon the production of the patent. It shall name, if necessary, an expert to assist the *huissier* in his description.

If an application is made for an order of seizure, the said order may require the plaintiff to furnish security, and to pay the money into the *Caisse de Consignations*, before proceeding further.

A foreign patentee who has recourse to seizure must always furnish security.

A copy of the articles described or seized, and of the deed proving the deposit of security when such security is required, shall be served upon the defendant, or the proceedings shall be void, and the *huissier* responsible for the damages.

EVIDENCE. In order to be successful in his suit, the plaintiff must prove the infringement. It is therefore important that he should produce evidence of its existence from the period when the infringement came to his knowledge. To this effect, the patentee has several means open to him.

He can lodge a complaint with the *procureur* of the republic. In this case, the infringement would be governed by the rules of criminal procedure, and adjudicated upon by *juges correctionnels*. Or, he can purchase of the infringer an object infringed, and obtain an invoice, indicating the source from which the retailer obtains his goods, and with such evidence he can proceed with his action; or if the infringer does not contest the evidence, he can content himself with his declaration before the judges. But in practice, as it is important that the counterfeit article should be preserved, the proceeding called "seizure with description" is employed, or the mode of "simple description by *constat d'huissier*." The patentee can supplement either of these modes by any other documentary evidence in his possession. (Court of Amiens, 1850; Court of Paris, February 2, 1856; and August 13, 1873.)

PROCESS OF DESCRIPTION WITH SEIZURE. In order to seize an object which he alleges to be infringed, the patentee must fulfill a preliminary indispensable formality,—he must present a petition to the president of the tribunal for permission to seize. This petition must be accompanied by the patent, as the patentee must prove his right. If the patent has expired, the petition can, nevertheless, be presented, but upon condition, that the facts alleged against the infringer have taken place prior to the expiration of the patent. The president is free to refuse to make the order upon the petition, as his power is discretionary. (Court of Cassation, June 15, 1866.) No appeal can be made from his decision granting or refusing the petition.

The order when made may appoint an expert to assist the *huissier* in his description. This expert is a person possessing special knowledge of the product or apparatus alleged to be infringed. The patentee himself can attend the seizure, as he is more competent than any one else to draw up a description of the infringement. The order requires in all cases the presence of the *commissaire de police*. This is indispensable, for if by chance the infringer refuse to open his premises, or if he be absent, or if no infringements be discovered upon the premises, the presence of the *commissaire de police* will prevent the alleged infringer from proceeding against the patentee for violation of his domicile. By law the president can grant a general order, viz., he can authorize the patentee to seize in all places at once, in which he believes infringements to exist, such as exhibitions, custom-houses, bonded warehouses, etc., and upon the premises of all the persons possessing infringed objects, without its being necessary for the patentee to specify in his petition the names of such persons or their addresses. (Court of Cassation, June 15, 1866.) A patentee can, by virtue of one order, issue several seizures upon the premises of the same individual. (Tribunal of St. Etienne, November 4, 1859.) The president can order that the books, correspondence and papers of the infringer be impounded, initialed or examined. He can also order that those containing proofs of the infringement be seized on the spot. (Court of Lyons, November 30, December 5, and 26, 1865, January 8, 1866; Court of Cassation, June 15, 1866.)

When the president grants the order for seizure, he can, if he thinks expedient, require the plaintiff to furnish security. In this case, such security must be deposited before the seizure takes place. Such security, demand for which is discretionary with the president, is always obligatory in the case of foreigners suing for infringement, except such as are authorized to exercise their civil rights in France, and except those belonging to States between which and France diplomatic treaties exist, dispensing French subjects abroad from furnishing security in similar cases. This security is quite distinct from security for costs, which a French defendant can require a foreign plaintiff to furnish at the commencement of legal proceedings. (Paris, November 14, 1860.)

Article 47 requires that a copy of the following should be left with the infringer of the objects described or seized: 1. Of the order of the president. 2. Of the document proving the deposit of the caution money in cases where such security has been ordered. Should default be made in compliance with the above enactment, the proceedings are void, and the *huissier* is liable for damages.

USUAL PROCEDURE ON THE PART OF PATENTEE. The above is the process of "description with seizure." The other remedy open to the patentee to prove infringement is the "simple description" of the object; otherwise called description without seizure. In practice, the two modes of procedure are jointly adopted: 1. Seizure is made of a sample or of articles strictly necessary to prove the infringement. 2. A description is made of the other articles which are left in the possession of the infringer.

WRIT. A writ must be issued, whether the plaintiff take proceedings in the civil court or the *Tribunaux Correctionnels*. The writ must be issued within eight days after the report of the seizure or of the simple description.

ART. 48. In case the complainant fails to prosecute, either in the civil courts, or in the *tribunal correctionnel*, within eight days from

the seizure—allowing one day for every three *myriamètres* of distance between the place in which the articles seized or described are situated and the domicile of the defendant—whether for infringing or for concealing, introducing or selling the infringing articles, such seizure or description shall be void by law, without prejudice to the damages which may be claimed in the manner prescribed by article 36.

The day of the date of the writ is not included in the eight days.

The period is increased according to distance, in the proportion of one day for each five *myriamètres* between the place in which the objects were seized or described, and the domicile of the infringer. If the seizure lasts for several days, the delay for appearance is calculated from the last day of the seizure. If the patentee proceeds against several infringers, and if he makes several seizures or descriptions, each infringer must be served within the prescribed period respectively, under penalty of the seizure being declared void. If the seizure should be declared void, it does not necessarily follow that the plaintiff's demand is canceled. This is natural, as the patentee can dispense with making a seizure, if he possesses other proofs. (Cassation, March 27, 1835; Court of Amiens, December 28, 1850.) However, when the seizure is declared void, the patentee cannot invoke it as a means of proof; therefore, if the patentee possesses other evidence he incurs no danger; but if otherwise, he loses his case by his own default. When the patentee has allowed the time for suing to pass without issuing his writ, he can make a second seizure, or a second description, by virtue of the same judge's order, as the nullity of the seizure does not affect the order of the president, nor the right of action of the patentee. (Court of Amiens, December 28, 1850.) But it is evidently necessary, in order that such second seizure should avail the plaintiff, that he should issue his fresh writ within a legally described period dated from such second seizure. It would be imprudent to rely upon the second seizure, as the nullity of the prior seizure would free the objects attached thereby, and the patentee on making a further seizure would find nothing.

CHOICE OF JURISDICTIONS AND TRIBUNALS. The injured party can proceed either in the civil courts, or in the *tribunal correctionnel*. If he elects to proceed in the *tribunal correctionnel*, he can act either by direct citation or by lodging a complaint with the *procureur of the republic*. In the two cases he can only claim one thing from the tribunal, viz., the condemnation of the infringer to pay damages in reparation of the injury caused to him. As regards the sentence of imprisonment or fine, such cannot be claimed, except by the public prosecutor, who alone has a right to demand it. Advantages and disadvantages are attached to both the above modes of procedure. Advantages of the criminal proceeding are that the expenses are less heavy, and the procedure is more expeditious. The plaintiff can avail himself of witnesses to complete his documentary evidence. The disadvantages are as follows: The defendant can also call witnesses to justify his acts, which privilege he would not possess in a civil action. He can also plead good faith, which can be accepted as extenuating circumstances in the case of principal infringers; and still more so in the case of parties whom the law treats as in complicity with the infringers; such are retailers, and parties introducing the infringed objects. Such plea of good faith can, even in such latter cases, entitle the defendants to acquittal. (Article 41.) In the event of the plaintiff failing in his prosecution, he is exposed to an action for

damages, which are far heavier in relation to proceedings in the criminal courts than in a civil case. Lastly, the decision in a criminal case has far less effect than in a civil case. Thus, a criminal decision does not prevent the plaintiff, in the event of the prosecution failing, from instituting fresh proceedings against the same defendant in the event of his committing the same offense after the date of the first proceedings; on the contrary, when a decision has been rendered in a civil case in the defendant's favor, the question cannot be raised again between the same parties in relation to the same object or proceeding. In the event of such further proceedings being instituted, the defendant would simply have to plead the previous judgment in his favor.

With respect to *what tribunals* have jurisdiction in civil cases, article 59 of the Code of Civil Procedure provides as follows:—The patentee can proceed against infringers in the civil tribunal of the domicile of either of them, at his choice, in the case in which several joint defendants exist who are not strangers to each other. And in the case of several joint defendants and the institution of criminal proceedings, article 63 of the Code of Criminal Instruction applies. Thus, the patentee can proceed either in the tribunal of the domicile or residence of the infringer, or, if there are several infringers who have participated in the same act of infringement, before the court of the domicile of either of them, either in the court of the place in which the defendant resides, or in the court of the place in which the act of infringement was perpetrated.

A defendant cited criminally, can be represented by an *avoué* in the cases in which the penalty relating to the misdemeanor for which he is prosecuted does not amount to imprisonment.

Lastly, in prosecutions for infringements, as well as those relating to all other misdemeanors, the public minister must always be heard.

PROCEEDINGS AGAINST FOREIGNERS. Inasmuch as the French tribunals are incompetent to adjudicate upon misdemeanors committed out of France by foreigners, if the offense of infringement be committed abroad, the patentee cannot proceed in France; but the rule is otherwise if the offense be committed in France by a foreigner. For instance, if after having manufactured goods abroad, he enter France to dispose of them, he can be prosecuted or proceeded against in the French courts.

OBSTACLES AND DEFENSES. Apart from security for costs, limitation of actions and special pleas in bar, the defendant in civil and criminal cases can plead various defenses. For instance, he can plead that he was authorized by transfer or otherwise to act as he did; or that the infringement in question was not committed by him; or that the patent has become void; or that, assuming the patent to be valid, the object manufactured by him is not an imitation of the object patented.

When prosecuted in the *tribunal correctionnel*, the defendant, if proceedings have been commenced in the civil courts to have the patent of the plaintiff declared void, can require the criminal proceedings to be adjourned until judgment has been given in the civil courts. This proceeding is called a *sursis*. The judges of the *tribunal correctionnel* are at liberty to grant or refuse the application. (Court of Cassation, June 15, 1866.) In the civil courts, a defendant cannot demand an adjournment until the *tribunal correctionnel* has adjudicated in the same matter.

A defendant in proceedings before a *tribunal correctionnel* cannot compel a party who has sold the infringed object to him, to intervene in the proceedings to guarantee him in respect of the consequences, as misdemeanors are personal offenses. (Court of Cassation, March 5, 1872.) In the civil courts, on the contrary, a defendant can

call upon another party to pay the amount of pecuniary damages in which he may be condemned.

Whether proceedings are instituted in the civil courts or *tribunal correctionnel*, the defendant can put in a counter-claim for damages for the prejudice which such proceedings may have caused him, morally and actually.

ART. 49. A judgment for the confiscation of articles admitted to be infringements, and, if there be any, of instruments or utensils destined specially to the manufacture thereof, shall, even in the case of acquittal, be rendered against the defendant, whether for infringement, or for concealing, introducing or selling the infringing articles. The articles confiscated shall be handed to the proprietor of the patent, without prejudice to an action for further damages, and to the publication of the judgment, when so ordered.

CONFISCATION is not discretionary with the court, but obligatory. (Court of Cassation, December, 9, 1848.) It must always be pronounced as regards the object infringed, even when the defendant is acquitted upon proving his good faith. Confiscation can be ordered not only in respect of the object seized, but in respect of objects simply as described. (Court of Cassation, August 26, 1851.) Confiscation pronounced in cases of infringement is not a penalty; thus civil courts as well as *tribunaux correctionnels* can pronounce it. (Court of Cassation, May 9, 1859.)

Damages can be granted both in civil courts and in the *tribunaux correctionnels*. There are two sorts of procedure adopted by the judges in relation to damages. The amount can be decided forthwith, or it can be ordered to be calculated pursuant to a statement to be drawn up relating to the damage. The parties then come before the court again, and a further decision is rendered, which definitively fixes the amount thereof.

DAMAGES granted to a patentee should represent two kinds of prejudice caused to him, viz. : material and moral injury. Material damage represents all profits lost to the inventor by the infringements. In calculating the same, the profits realized by the infringer must not be considered alone, as such profits may have been less than those which the real inventor would have realized, but the profits which the patentee has lost through the fraudulent sales made by the infringer, calculated at the price realized by the patentee for the same goods in the ordinary course of his business. Moral prejudice consist in the fact that the rights of the patentee have been contested by the infringer, and that such rights, notwithstanding the gaining of the suit, may nevertheless have been damaged. Again, the infringer, in order to sell at a cheaper rate, may have manufactured the goods in an inferior manner, and thus brought discredit upon the invention.

ARREST has been abolished in civil cases by the law of July 22, 1867, but can still be pronounced by the *tribunaux correctionnels* in connection with damages. A civil tribunal can also pronounce it in the following case, viz. : when the patentee has contented himself with requiring the *tribunal correctionnel* simply to punish the infringer by fines or imprisonment, and when he has afterward commenced an action in the civil tribunal, to have the amount of damage ascertained and adjudged. This is the only case in which a civil tribunal can sentence to a term of imprisonment.

COSTS. The infringer can be condemned to pay the costs on one or several publi-

cations and insertions of the judgment in the newspapers. The above measure, designed to advertise legal decisions, does not constitute a penalty, but a simple reparation for the prejudice caused to the patentee; therefore civil tribunals as well as *tribunaux correctionnels* can pronounce it.

TITLE VI.

SPECIAL AND PROVISIONAL MEASURES.

ART. 50. Royal ordinances, having the effect of *Règlements d'Administration Publique*, shall provide the necessary measures for the execution of the present law.

This law shall not take effect until three months after its promulgation.

ART. 51. Ordinances rendered in the same form shall control the application of the present law in the colonies, with the modifications that may be considered necessary.

ART. 52. The following laws shall be repealed from the date upon which the present law becomes executory, viz.:

The laws of the 7th of January and 25th of May, 1791; that of the 20th of September, 1792; the *arrêté* of the 17 *vendémiaire*, year 7; the *arrêté* of the 5th *vendémiaire*, year 9; the *Décrets* of the 25th November, 1806, and 25th January, 1807, and all provisions previous to the present law relating to patents of invention, of importation, and of improvements.

[Articles 53 and 54 omitted, because relating only to patents existing and proceedings pending when the law took effect.]

From *Goirand's French Code of Commerce*, pp. 765 and 441.

*Decree of October 21, 1848, Regulating the Application of the Patent Law of July 5, 1844, to the French Colonies.**

ART. 1. The patent law of the 5th July, 1844, shall be applicable in the colonies from the date of the publication of the present decree.

* A French patent extends to the colonies. *Ency. Brit.* 9 ed. tit. Patent.

Royal ordinances, &c. shall control the application of the present law in the colonies, with the modifications that may be considered necessary. Law of July 5, 1844, § 51.

A royal ordinance regulates the application of the law of 1844 to the colonies. The formalities requisite for obtaining patents are the same as in France, except that the documents must be deposited in triplicate instead of in duplicate. The procedure in cases of infringement is

ART. 2. Applicants for patents of invention in the colonies must deliver three copies of the documents prescribed by article 5 of the above law, at the office of the director of the interior.

The entry establishing the said delivery shall be made in a special register to be signed by the said officer and the applicant, agreeably to article 7 of the said law.

ART. 3. Before making the said entry, the director of the interior shall require the production of :

1. The receipt of the colonial treasury for the payment of 100 francs due for the first installment of the annual patent fees.

2. Three copies of each of the documents mentioned in paragraphs 1, 2, 3, and 4 of article 5 of the patent law of the 5th July, 1844.

One copy of each of these documents shall be kept under a sealed cover at the offices of the directors, to be consulted when required. The other two copies shall be enclosed in a single envelope sealed up by the applicant.

ART. 4. The governor of each colony shall with the least possible delay, after due registration of the applications, forward to the minister of agriculture and commerce, through the minister of the navy and colonies, the sealed envelope containing the two respective copies, annexing thereto a certified copy of the entry, the receipt for the payment of the first installment of the annual patent fees, and, if there be one, the power of attorney of the applicant.

ART. 5. Patents shall be forwarded with the least possible delay to their owners, through the minister of the navy and colonies.

ART. 6. The registration of assignments of patents mentioned in article 20 of the patent law of the 5th July, 1844, shall take place at the offices of the directors of the interior.

Copies of the entries of registration, accompanied with authentic abstracts of the assignments and the receipts for the payment of the total amount of the patent fees, shall be forwarded to the minister of agriculture and commerce, conformably to article 4 of the present decree.

identical. Goirand's French Code of Commerce (1880), p. 500.

The encyclopedias and geographic works in use in this country vary somewhat in the enumeration they give of the colonies of France, but the following are

usually included : Cambodia, Cochin China, French Guiana, Guadeloupe, Loyalty Islands, Marquesas Islands, Martinique, Micquelon, New Caledonia, Senegambia, St. Pierre, Tahiti.

ART. 7. All patent fees prescribed by articles 4, 7, 11 and 22 of the patent law of the 5th July, shall be paid to the treasurer of each colony, who is to deposit them at the public treasury, and shall at the same time forward to the minister of agriculture and commerce, through the same channel, the returns of the payment of patent fees.

ART. 8. All actions for infringements shall be tried before the court of appeal, in the colonies.

The delay allowed with respect to distances as fixed by article 48 of said law, shall be modified conformably to the ordinances which, in the colonies, regulate proceedings in civil actions.

ART. 9. The minister of agriculture and commerce, and the minister of the navy and colonies, are respectively commissioned with the execution of the present decree.

From *Carp. Pat. L. of World*, 205.

FRENCH GUIANA.

See FRANCE, *ante* p. 203, foot-note.

GERMAN EMPIRE.

Law of July 1, 1877.

FIRST SECTION.

PATENT RIGHTS.

§ 1. Patents are granted for new inventions which can be turned to account in trade.

The following are excepted:—

1. Inventions the use of which would be incompatible with the laws or public morals.

2. Inventions of articles of food (for nourishment or luxuries), of medicines and of substances produced by chemical process, so far as the invention does not relate to a definite method of producing such articles.

§ 2. An invention is not regarded as new, if it has already been described in any printed publication, or publicly used in Germany at the time of application for a patent in accordance with this law, in such a manner that its employment appears possible by other persons skilled in the particular trade to which it relates.

§ 3. Whosoever first applies for a patent of invention according to the provisions of this law, is entitled to the grant of the same.

The claim of the petitioner to the grant of a patent will not be allowed, if the essential contents of his application have without permission been taken from the descriptions, drawings, models, implements or contrivances of another person, or from a method of manufacture used by the latter, if such person raises opposition on that account.

§ 4. The patent has the effect that nobody is allowed without the permission of the patentee to manufacture, trade in, or offer for sale, the article to which the invention relates.

If the invention relates to a process, to a machine or other mechanical contrivance, to a tool or other implement, the patent has moreover the effect of prohibiting any one from applying such method or of using the article to which the invention relates without permission of the inventor.

§ 5. The patent has no effect against a person who, at the time

the patentee made his application, had already been using the invention in Germany, or who had made the necessary preparations for using the same.

The patent, moreover, has no effect when the invention is to be used by order of the Imperial Chancellor for the army or navy, or in the interest of public welfare. Yet the patentee has in such case the right to claim proper compensation from the Empire or the State in whose special interest a limitation of the effect of the patent has been applied for. The amount of such compensation shall be fixed by a court of law in case an agreement cannot be arrived at.

Patents do not affect arrangements in means of conveyance, which come but temporarily within the boundaries of the empire.

§ 6. The claim to the grant of a patent and the patent rights themselves pass to the heirs. The claim and the patent right may be transferred, wholly or partially, to others by agreement or in consequence of death.

§ 7. The duration of a patent is 15 years: the term commences with the day following the day of application. If an invention is an improvement upon another invention patented in favor of the applicant, the latter may apply for a patent of addition, which terminates with the patent for the original invention.

§ 8. For every patent a fee of 30 marks (£1 10s.) is to be paid on the issue of it.

Except in the case of patents of addition (§ 7), a further fee must be paid for each patent at the commencement of the second and every subsequent year, amounting the first time to 50 marks (£2 10s.), and increasing by 50 marks each succeeding year.

A patentee who proves his poverty, may delay the payment of the fees for the first and second year until the third year; and if the patent lapses in the third year, they are entirely remitted.

§ 9. A patent lapses if the patentee renounces the same, or if he fails to pay the fees within 3 months at the latest after they have become due.

§ 10. A patent will be declared void if it turns out:—

1. That the invention was not patentable according to §§ 1 and 2;

2. That the essential contents of the application were taken from descriptions, tools, contrivances, drawings, or models, of another, or from some means of working used by such other, without his consent.

§ 11. A patent can be declared void after the expiration of three years :

1. If the patentee fails to work his invention in Germany to an adequate extent, or at least to do everything that is necessary to insure its being worked ;

2. Whenever the grant of license to others to use the invention appears to be demanded in the public interest, and the patentee nevertheless refuses to grant such license upon adequate compensation and good security.

§ 12. Persons not residing in the empire can only apply for a patent and claim the rights resulting therefrom by appointing a representative resident in Germany. The latter is authorized to act in all proceedings prescribed by this law, as well as in civil law-suits concerning the patent. Actions against a patentee must be brought before the tribunal of the district in which the representative resides, but if there be no representative, the court of the district in which the patent-office has its seat is competent for jurisdiction.

SECOND SECTION.

PATENT-OFFICE.

§ 13. The granting, the annulment, and the revocation of patents is performed by the patent-office.

The patent-office has its seat at Berlin. It consists of at least three permanent members, including the president, and of non-permanent members. The members are appointed by the Emperor ; the other officials by the Imperial Chancellor. The appointment of the permanent members is made on the nomination of the Federal Council, and last, if they hold an office of the Empire or of a State, during the term of such office, in other cases for life. The appointment of the non-permanent members will be for five years. Of the permanent members at least three must be qualified for a judgeship, or for the higher government service ; the non-permanent members must be expert in some branch of technical science. The regulations in § 16 of the law of May 31, 1873, concerning the legal position of Imperial officials do not apply to non-permanent members.

§ 14. The patent-office consists of several divisions. These are formed in advance for at least one year. A member may belong to several divisions.

The quorum of any division, when dealing with the grant of a

patent, must not be less than three, among whom there must be two non-permanent members.

For decisions relating to the nullity and the revocation of patents, a special division shall be formed. For decisions of this division, a quorum is required of two members, including the president, who are qualified for a judgeship, or for the higher government service, and of three other members.

The provisions of the code of civil law with regard to challenge or refusal of members of the court are applicable.

Experts who are not members, may be summoned to attend the deliberations, but they are not permitted to take any part in the voting.

§ 15. The resolutions and decisions of the divisions are issued in the name of the patent-office ; the grounds of them must be stated; and office copies must be delivered to each of the interested parties.

Notices by which special terms are fixed, will be sent by post in registered letters against receipt. If a notice cannot be delivered within the country, it will be forwarded by the proper official of the patent-office by post, in accordance with the provisions of §§ 161 and 175 of the civil code.

An appeal lies from the decisions of the patent-office.

§ 16. If the decision of a division of the patent-office is the subject of appeal, such appeal shall be heard before another division or several divisions sitting together.

In such appeal no member must take part who voted in the decision which is the subject of appeal.

§ 17. The formation of the divisions, the fixing their duties, the forms of procedure and the order of business of the patent-office, so far as these points are not regulated by the present law, will be prescribed by the Emperor, with the consent of the Federal Council.

§ 18. The patent-office is bound, on the request of the law courts, to give opinion in all questions concerning patents. In other cases it is not authorized, without special leave of the Imperial Chancellor, to pass resolutions or give opinions outside its official sphere.

§ 19. A register will be kept at the patent-office, in which the subject and duration of patents granted will be entered, together with the name and address of the patentees and of the representatives, if any, appointed by them at the time of application. The commencement, the termination, the expiration, the decree of annulment, and the revocation of patents, are to be entered in this

register, and simultaneously published in the *Reichsanzeiger* (Gazette).

Should a change take place in the person owning the patent or his representative, such fact will likewise be entered in the register and publicly notified by the *Reichsanzeiger*, when brought to the knowledge of the patent-office in due form. As long as this is omitted, the former patentee and his former representative continue to be entitled to the benefits and subject to the provisions of this law.

The inspection of the register, and of specifications, drawings, models and specimens on the basis of which patents have been granted, is open to everybody, unless the patent has been taken out in the name of the Imperial Administration for purposes of the army or navy.

The patent-office will publish the essential parts of specifications and drawings, so far as their inspection is permitted to the public, in an official paper. In the same paper will also appear all notices which must be published by the *Reichsanzeiger* in accordance with this law.

THIRD SECTION.

PROCEEDINGS IN PATENT-MATTERS.

§ 20. The application for the grant of a patent for an invention must be made in writing to the patent-office. For each invention a separate application is required. The application must contain the petition for the grant of a patent, and must point out with precision the object sought to be patented. In a separate document the invention must be described in such a manner that its practicability plainly appears to skilled persons. The necessary drawings, figures, representations, models and samples must be supplied at the same time.

The patent-office will issue regulations respecting the other requisites of the application.

Up to the time of publication of the application, alterations in the descriptions are permitted. With the application a fee of 20 marks (£1) must be paid for the costs of the proceeding.

§ 21. If an application does not fulfill all the prescribed requirements, the patent-office will point out to the applicant the defects, and demand of him the amendment within a specified time. Should this demand not be complied with within the time, the application will be rejected.

§ 22. If the patent-office finds the application in due form, and that there is no objection to the granting of a patent, it will order the application to be published. From the date of publication, the subject of the application will provisionally have the protection of a patent in favor of the petitioner (§§ 4 and 5).

If the patent-office is of opinion that, according to §§ 1 and 2, the invention is not patentable, the application will be rejected.

§ 23. The publication of the application is made by the name of the applicant and the chief points of his application being advertised once in the *Reichsanzeiger*. At the same time the application and accompanying papers will be laid open at the patent-office for public inspection, and a notice inserted to the effect that the subject of the application is provisionally protected against unauthorized use.

If the matter relates to a patent applied for in the name of the Imperial Government, the publication of the application and accompanying papers is omitted.

§ 24. After expiration of eight weeks from the day of publication (§ 23) the patent-office will decide as to the granting of the patent. Until that date objections against the granting can be lodged with the patent-office. They must be made in writing, giving the grounds, which can only be the assertion that the invention is not new, or that it comes under § 3, part 2.

Before deciding, the patent-office may summon and hear the interested parties; it may also cause the grounds of objection to be examined by persons skilled in any branch of technical science, and otherwise take steps for elucidating the matter.

§ 25. From a decision by which an application is rejected, the applicant—and from a decision relating to the granting of the patent, the petitioner or the opponent—may lodge an appeal within four weeks. On lodging the appeal, 20 marks (£1) must be paid for the cost of the proceeding; should this payment not be made, the appeal will be treated as void.

In the proceedings, § 24, part 2, applies.

§ 26. If the grant of the patent is decided upon, the patent-office will cause a notice to that effect to be published in the *Reichsanzeiger*, and issue a document to the patentee.

If the patent is refused, this will also be publicly notified. Upon the refusal, the provisional protection will be held void.

§ 27. The commencement of proceedings relating to the annulment, or the revocation of a patent is by motion. In cases provided

for by § 10, part 2, only the injured party is entitled to make the motion. The motion must be addressed to the patent-office, and must set out the facts upon which it is based.

§ 28. After the institution of proceedings, the patent-office, in communicating to the patentee that such motion has been made, will invite him to answer the same within four weeks.

If the patentee does not answer within this term, a decision may follow immediately, according to the motion, without summons or hearing, and for such decision all the facts asserted by the person making the motion will be treated as proved.

§ 29. If the patentee answers in due time, or if, in the case of § 28, part 2, the motion is not decided upon immediately, the patent-office will issue the necessary orders for investigating the matter, and moreover, in the first case, communicate the answer to the person making the motion. It may also cause witnesses and experts to be examined. In this respect the regulations of the civil code will apply. The depositions must be taken down in writing by a sworn reporter.

The decision will be given after the parties interested have been summoned and heard.

If the motion made for the revocation of the patent is based on § 11, part 2, the determination of the motion must be preceded by a warning of cancellation, giving the reasons for it, and allowing a suitable delay.

§ 30. In the decision (§§ 28 and 29) the patent-office has full power to determine in what proportions the costs of the proceedings shall be borne by the parties.

§ 31. The law courts are bound to render legal assistance to the patent-office. The imposition of fines on witnesses and experts who have failed to appear, or who decline to give evidence, or to confirm it on oath, and also the attendance of witnesses who have failed to appear, will be ordered, on application by the courts.

§ 32. An appeal is allowed against the decisions of the patent-office (§§ 28 and 29). The appeal is to the Imperial Supreme Court of Commerce. It must within six weeks after the giving of the decision be presented in writing to the patent-office, with a statement of the grounds.

The costs of the proceedings will also be determined by the court in accordance with § 30.

In other respects the proceedings in court will be determined by

a regulation which will be drawn up by the court and established by Imperial ordinance with the assent of the Federal Council.

§ 33. Regarding the official language of the patent-office, the provisions of the law concerning the organization of the courts, and the language to be used before them, are to be observed. Applications which are not made in the German language will not be considered.

FOURTH SECTION.

FINES AND INDEMNITIES.

§ 34. Whoever knowingly makes use of an invention contrary to the provisions of §§ 4 and 5, will be punished by fine up to 5,000 marks (£250), or by imprisonment not exceeding one year, and is bound to indemnify the person injured.

Prosecutions are only instituted on motion made to that effect.

§ 35. If judgment is passed in criminal proceedings, the injured party is entitled to publish the sentence at the cost of the defendant. The manner and time of publication is to be fixed in the sentence.

§ 36. Instead of an indemnity as provided by this law, the injured party may, in addition to the fine, demand an amercement not exceeding 10,000 marks (£500). For this amercement all the persons condemned are liable jointly and severally.

If such amercement is ordered, all further claims for damages are excluded.

§ 37. The competency of the Imperial Supreme Court of Commerce, as determined by paragraph 12 of the law of June 12th, 1869, concerning the establishment of a supreme court of commercial affairs, is extended to all civil cases in which a claim is advanced on the basis of the provisions of this law.

§ 38. Actions for infringement of patent right are barred with regard to each single case at the expiration of three years.

§ 39. Whether damage has been caused, and to what amount, will be decided by the court according to its conviction after due consideration of all circumstances.

§ 40. Fines not exceeding 150 marks (£7 10s.) or a term of imprisonment will be imposed:—

1. On any person placing on articles, or their packing, any mark calculated to cause the erroneous belief that such articles are protected by a patent in accordance with this law.

2. On any person who in public advertisements, on sign-boards,

on business cards, or in similar notifications, employs any mark calculated to cause the erroneous belief that the articles mentioned thereon are protected by a patent in accordance with this law.

FIFTH SECTION

TRANSITORY PROVISIONS.

§ 41. All patents in force by virtue of State laws* shall until their expiration remain valid according to such laws, but a prolongation of the term is inadmissible.

§ 42. The owner of an existing patent (§ 41) may, in respect of the invention protected by it apply for the grant of a patent according to the provisions of this law. The examination of the invention in such case is subject to the forms prescribed by this law. The patent shall be refused, if the holder of another patent in force for the same invention (§ 41) claims the grant of a patent or opposes the grant before such grant has been decided upon. For want of novelty, the grant of the patent will only be refused if the invention was not new in the sense of § 2 at the time when first patented in the country.

With the grant of a patent in accordance with this law all patents in force for the same invention (§ 41) shall become void if they are in possession of the holder of the new patent. So far as this is not the case, the legal operation of the new patent will first take effect in the district in which the existing patent is valid, on the expiration of the latter.

§ 43. From the duration of a patent granted according to § 42 will be deducted the time during which the patent has been protected in the country by the oldest of the existing patents. The owner of the patent for the remainder of the duration of the patent is bound to pay the legal fees. (§ 8.) The date of payment and

* The Kingdoms or States which, in 1871, united in forming the German Empire, had, previously to that time, patent laws of their own; but the new constitution confided patents to the general legislature of the empire. In 1877, the law given in the text was enacted as a uniform law for the nationalities com-

posing the empire. See BADEN for some further details.

For an account of the judicial system introduced under the constitution of 1871, see *Constitution of Courts in the German Empire*, 21 Alb. L. J. 66; Id. 167.

annual amount of the fees shall be fixed according to the time when the invention was first protected in the country.

§ 44. By the grant of a patent according to the provisions of § 42, persons who had been using the invention without infringement of a patent right at the time a patent for the same was applied for, or who made the necessary preparations for using the same, shall not be restrained from such use.

§ 45. This law shall come into force on the 1st of July, 1877.

From Carpm. Pat. L. of World, 208.

GREAT BRITAIN AND IRELAND.

An act concerning monopolies, &c. 21 Jac. 1, c. 3, 1623.*

Forasmuch as your most excellent Majesty, in your royal judgment, and of your blessed disposition to the weal and quiet of your

* This act, which is fundamental to the English and American law of patents, was passed in pursuance of the decision of the great case of monopolies: *Darcy v. Allen, Moore, 671; Noy., 179; 11 Co. 86.* The origin of the act, briefly stated, is, that in early times, in England, exclusive rights to manufacture or trade were freely granted by the crown as a mere means of raising a revenue from the license fees exacted. The exercise of this power was at first believed to be beneficial, because ingenious foreign workmen were from time to time drawn to England by the expectation of substantial commercial advantages being secured to them by royal letters patent (these being, really, grants of monopoly); and enterprising Englishmen were also induced by the like expectation to travel abroad, and acquire a practical knowledge of trades and arts. But the crown experiencing in those days the evils of no regular taxation,—the chief of which was a perpetually recurring want of money to conduct the affairs of government,—the prerogative was exposed to, and its exercise soon became affected with, many abuses, principally of this nature, that the monopoly was sold at a ruinous price, usually to the highest bidder, whether or not he was the true and first inventor of the process of manufacture, and latterly, without any regard at all to his capacity or ability as an inventor or manufacturer,

and frequently, indeed, to courtiers, who made it a means of gain exclusively, and did not assist the national industry at all. But oppressive as it became, the prerogative was freely exercised down to the accession of the Stuarts, and was carried to a very oppressive and injurious extent during the reign of Elizabeth. The validity of the grants was at length contested in the courts, which adjudged them to be mischievous to the public for three reasons: 1. The raising of the price; 2. The commodity will not be so good; 3. The impoverishing of poor artificers. This was the gist of the decision in *Darcy v. Allen, supra*; rendered in the 44th year of Elizabeth, Tr. term; 1602. The abrogation of the practice of making these grants was, from about the same time, agitated in parliament; and at length, in 1623, the statute 21 Jac. 1, c. 3, the portions of which material to the law of patents are reprinted in the text, was enacted. As will be seen at a glance, it declares that all monopolies, grants, letters patent for sole buying, selling, and making of goods and manufactures, shall be null and void; but it excepts future patents for fourteen years, for the sole working or making of any new manufactures within the realm, to the true and first inventors of such manufactures, not contrary to law, nor mischievous to the state.

For recent and instructive discussions

subjects, did, in the year of our Lord God one thousand six hundred and ten, publish in print to the whole realm, and to all posterity, That all grants and monopolies, and of the benefit of any penal laws, or of power to dispense with the law, or to compound for the forfeiture, are contrary to your Majesty's laws, which your Majesty's declaration is truly consonant and agreeable to the ancient and fundamental laws of this your realm : (2) And whereas your Majesty was further graciously pleased expressly to command, that no suitor should presume to move your Majesty for matters of that nature : (3) Yet nevertheless, upon misinformations and untrue pretences of publick good, many such grants have been unduly obtained, and unlawfully put into execution, to the great grievance and inconvenience of your Majesty's subjects, contrary to the laws of this your realm, and contrary to your Majesty's most royal and blessed intention so published as aforesaid : (4) For avoiding whereof, and preventing of the like in time to come, may it please your excellent Majesty, at the humble suit of the Lords spiritual and temporal, and the commons, in this present parliament assembled, That it may be declared and enacted : (5) And be it declared and enacted by authority of this present parliament, That all monopolies, and all commissions, grants, licences, charters and letters patent heretofore made or granted, or hereafter to be made or granted, to any person or persons, bodies politick or corporate, whatsoever, or for the sole buying, selling, making, working or using of any thing within this realm or the dominion of Wales, (6) or of any other monopolies, or of power, liberty or faculty, to dispense with any others, or to give license or toleration to do, use or exercise anything against the tenor or purport of any law or

on the influence of the act on the English and American law of patents, see Curtis Pat. §§ 1-4 ; McKeever v. United States, 14 Ct. of Cl. 396 ; Op. Bradley, J., 111 U. S. 761.

Patent laws in the British Colonies. Prior to 1852, British letters patent extended to all Her Majesty's colonies ; but the act of 1852 restricted the rights obtainable under it to Great Britain and Ireland, the Channel Islands, and the Isle of Man ; soon after which the colonies began to enact patent laws of their own.

(See their names, throughout this work.)

As a rule, the application in a colony must be by petition, accompanied by a specification and drawings ; and must be made by the inventor, his assignee or attorney. Patents are, in all cases, assignable, and the deeds of assignment must be registered in the respective colonies. The patents are usually granted for a term of fourteen years, and the inventions must not have been used in the colony previous to the date of application. Ency Brit. 9 ed. art. Patents.

statute ; (7) or to give or make any warrant for any such dispensation, licence or toleration to be had or made ; or to agree or compound with any others for any penalty or forfeitures limited by any statute ; or of any grant or promise of the benefit, profit or commodity of any forfeiture, penalty or sum of money, that is or shall be due by any statute, before judgment thereupon had ; (8) and all proclamations, inhibitions, restraints, warrants of assistance, and all other matters and things whatsoever, any way tending to the instituting, erecting, strengthening, furthering or countenancing of the same or any of them ; (9) are altogether contrary to the laws of this realm, and so are and shall be utterly void, and of none effect, and in no wise to be put in use or execution.

II. And be it further declared and enacted by the authority aforesaid, that all monopolies, and all such commissions, grants, licences, charters, letters patents, proclamations, inhibitions, restraints, warrants of assistance, and all other matters and things tending as aforesaid, and the force and validity of them and of every of them, ought to be, and shall be, for ever hereafter examined, heard, tried and determined by and according to the common laws of this realm, and not otherwise.

V. Provided, nevertheless, and be it declared and enacted, that any declaration before mentioned, shall not extend to any letters patents and grants of privilege for the term of one and twenty years or under, heretofore made of the sole working or making of any manner of new manufacture 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 patents and grants did not use, so they be not contrary to the law, nor mischievous to the state, by raising of the prices of commodities at home, or hurt of trade, or generally inconvenient, but that the same shall be of such force as they were or should be, if this act had not been made, and of none other : (2) And if the same were made for more than one and twenty years, That then the same for the term of one and twenty years only, to be accounted from the date of the first letters patents and grants thereof made, shall be of such force as they were or should have been, if the same had been made but for term of one and twenty years only, and as if this act had never been had or made, and of none other.

VI. Provided, also, and be it declared and enacted, that any declaration before mentioned, shall not extend to any letters pat-

ents and grants of privilege for the term of fourteen years or under, hereafter to be made of the sole working or making of any manner of new manufactures within this realm, to the true and first inventor and inventors of such manufactures, which others, at the time of making such letters patents and grants, shall not use, so as they be not contrary to law, nor mischievous to the State, by raising prices of commodities at home, or hurt of trade, or generally inconvenient; the said fourteen years to be accounted from the date of the first letters patents, or grant of such privilege hereafter to be made, but that the same shall be of such force, as they should be if this act had never been made, and of none other.

From 7 *Stat. at L., Pick.*, 255.

*An Act to amend and consolidate the Law relating to Patents for Inventions, Registration of Designs, and of Trade Marks.** 1 *Stat.* 46 and 47 *Vict.*, c. 57. August 25, 1883.

Be it enacted, &c. . . .

PART I.

PRELIMINARY.

1. *Short title.* This Act may be cited as the Patents, Designs, and Trade Marks Act, 1883.

2. *Division of Act into parts.* This act is divided into parts, as follows :—

Part I.—PRELIMINARY.

Part II.—PATENTS.

Part III.—DESIGNS.

Part IV.—TRADE MARKS.

Part V.—GENERAL.

3. *Commencement of Act.* This act, except where it is otherwise expressed, shall commence from and immediately after the thirty-first day of December, one thousand eight hundred and eighty-three.

* Those provisions only of the act are given, which relate to patents for inventions or designs. With it should be compared the Patents, Designs and Trade

Marks Amendments Act, 1885, post, p. 254, which is amendatory of several of the provisions of 1883.

PART II.

PATENTS.

APPLICATION FOR AND GRANT OF PATENT.

4. *Persons entitled to apply for patent.* (1) Any person, whether a British subject or not, may make an application for a patent.

(2) Two or more persons may make a joint application for a patent, and a patent may be granted to them jointly.

5. *Application and specification.* (1) An application for a patent must be made in the form set forth in the first schedule to this Act, or in such other form as may be from time to time prescribed; and must be left at, or sent by post to, the patent-office in the prescribed manner.

(2) An application must contain a declaration to the effect that the applicant is in possession of an invention, whereof he, or in the case of a joint application, one or more of the applicants, claims or claim to be the true and first inventor or inventors, and for which he or they desires or desire to obtain a patent; and must be accompanied by either a provisional or complete specification.

(3) A provisional specification must describe the nature of the invention, and be accompanied by drawings, if required.

(4) A complete specification, whether left on application or subsequently, must particularly describe and ascertain the nature of the invention, and in what manner it is to be performed, and must be accompanied by drawings, if required.

(5) A specification, whether provisional or complete, must commence with the title, and, in the case of a complete specification must end with a distinct statement of the invention claimed.

6. *Reference of application to examiner.* The comptroller shall refer every application to an examiner, who shall ascertain and report to the comptroller whether the nature of the invention has been fairly described, and the application, specification and drawings (if any) have been prepared in the prescribed manner, and the title sufficiently indicates the subject matter of the invention.

7. *Power for comptroller to refuse application or require amendment.* (1) If the examiner reports that the nature of the invention is not fairly described, or that the application, specification, or drawings has not or have not been prepared in the prescribed manner, or that the title does not sufficiently indicate

the subject matter of the invention, the comptroller may require that the application, specification or drawings be amended before he proceeds with the application.

(2) Where the comptroller requires an amendment, the applicant may appeal from his decision to the law officer.

(3) The law officer shall, if required, hear the applicant and the comptroller, and may make an order determining whether, and subject to what conditions, if any, the application shall be accepted.

(4) The comptroller shall, when an application has been accepted, give notice thereof to the applicant.

(5) If, after an application has been made, but before a patent has been sealed, an application is made, accompanied by a specification bearing the same or a similar title, it shall be the duty of the examiner to report to the comptroller whether the specification appears to him to comprise the same invention ; and, if he reports in the affirmative, the comptroller shall give notice to the applicants that he has so reported.

(6) Where the examiner reports in the affirmative, the comptroller may determine, subject to an appeal to the law officer, whether the invention comprised in both applications is the same, and if so, he may refuse to seal a patent on the application of the second applicant.

8. *Time for leaving complete specification.* (1) If the applicant does not leave a complete specification with his application, he may leave it at any subsequent time within nine months from the date of application.

(2) Unless a complete specification is left within that time, the application shall be deemed to be abandoned.

9. *Comparison of provisional and complete specification.* (1) Where a complete specification is left after a provisional specification, the comptroller shall refer both specifications to an examiner for the purpose of ascertaining whether the complete specification has been prepared in the prescribed manner, and whether the invention particularly described in the complete specification is substantially the same as that which is described in the provisional specification.

(2) If the examiner reports that the conditions herein-before contained have not been complied with, the comptroller may refuse to accept the complete specification unless and until the same shall have been amended to his satisfaction ; but any such refusal shall be subject to appeal to the law officer.

(3) The law officer shall, if required, hear the applicant and the comptroller, and may make an order determining whether and subject to what conditions, if any, the complete specification shall be accepted.

(4) Unless a complete specification is accepted within twelve months from the date of application, then (save in the case of an appeal having been lodged against the refusal to accept) the application shall, at the expiration of those twelve months, become void.

(5) Reports of examiners shall not in any case be published or be open to public inspection, and shall not be liable to production or inspection in any legal proceeding, other than an appeal to the law officer under this Act, unless the court or officer having power to order discovery in such legal proceeding shall certify that such production or inspection is desirable in the interests of justice, and ought to be allowed.

10. *Advertisement on acceptance of complete specification.* On the acceptance of the complete specification the comptroller shall advertise the acceptance; and the application and specification, or specifications with the drawings (if any) shall be open to public inspection.

11. *Opposition to grant of patent.* (1) Any person may at any time within two months from the date of the advertisement of the acceptance of a complete specification give notice at the patent office of opposition to the grant of the patent, on the ground of the applicant having obtained the invention from him, or from a person of whom he is the legal representative; or on the ground that the invention has been patented in this country on an application of prior date; or on the ground of an examiner having reported to the comptroller that the specification appears to him to comprise the same invention as is comprised in a specification bearing the same or a similar title, and accompanying a previous application, but on no other ground.

(2) Where such notice is given, the comptroller shall give notice of the opposition to the applicant, and shall, on the expiration of those two months, after hearing the applicant and the person so giving notice, if desirous of being heard, decide on the case, but subject to appeal to the law officer.

(3) The law officer shall, if required, hear the applicant and any person so giving notice and being, in the opinion of the law officer, entitled to be heard in opposition to the grant, and shall determine whether the grant ought or ought not to be made.

(4) The law officer may, if he thinks fit, obtain the assistance of an expert, who shall be paid such remuneration as the law officer, with the consent of the treasury, shall appoint.

12. Sealing of patent. (1) If there is no opposition, or, in case of opposition, if the determination is in favor of the grant of a patent, the comptroller shall cause a patent to be sealed with the seal of the patent-office.

(2) A patent so sealed shall have the same effect as if it were sealed with the great seal of the United Kingdom.

(3) A patent shall be sealed as soon as may be, and not after the expiration of fifteen months from the date of application, except in the cases hereinafter mentioned, that is to say—

(a) Where the sealing is delayed by an appeal to the law officer, or by opposition to the grant of the patent, the patent may be sealed at such time as the law officer may direct.

(b) If the person making the application dies before the expiration of the fifteen months aforesaid, the patent may be granted to his legal representative and sealed at any time within twelve months after the death of the applicant.

13. Date of patent. Every patent shall be dated and sealed as of the day of the application: Provided that no proceedings shall be taken in respect of an infringement committed before the publication of the complete specification: Provided also, that in case of more than one application for a patent for the same invention, the sealing of a patent on one of those applications shall not prevent the sealing of a patent on an earlier application.

14. Provisional protection. Where an application for a patent in respect of an invention has been accepted, the invention may during the period between the date of the application and the date of sealing such patent be used and published without prejudice to the patent to be granted for the same; and such protection from the consequences of use and publication is in this Act referred to as provisional protection.

15. Protection by complete specification. Effect of acceptance of complete specification. After the acceptance of a complete specification and until the date of sealing a patent in respect thereof, or the expiration of the time for sealing, the applicant shall have the like privileges and rights as if a patent for the invention had been sealed on the date of the acceptance of the complete specification: Provided that an applicant shall not be

entitled to institute any proceeding for infringement, unless and until a patent for the invention has been granted to him.

16. *Extent of patent.* Every patent when sealed shall have effect throughout the United Kingdom and the Isle of Man.

17. *Term of patent.* (1) The term limited in every patent for the duration thereof shall be fourteen years from its date.

(2) But every patent shall, notwithstanding anything therein or in this Act, cease if the patentee fails to make the prescribed payments within the prescribed times.

(3) If, nevertheless, in any case, by accident, mistake, or inadvertence, a patentee fails to make any prescribed payment within the prescribed time, he may apply to the comptroller for an enlargement of the time for making that payment.

(4) Thereupon the comptroller shall, if satisfied that the failure has arisen from any of the above-mentioned causes, on receipt of the prescribed fee for enlargement, not exceeding ten pounds, enlarge the time accordingly, subject to the following conditions :

(a) The time for making any payment shall not in any case be enlarged for more than three months.

(b) If any proceeding shall be taken in respect of an infringement of the patent committed after a failure to make any payment within the prescribed time, and before the enlargement thereof, the court before which the proceeding is proposed to be taken may, if it shall think fit, refuse to award or give any damages in respect of such infringement.

18. *Amendment of specification.* (1) An applicant or a patentee may, from time to time, by request in writing left at the patent-office, seek leave to amend his specification, including drawings forming part thereof, by way of disclaimer, correction, or explanation, stating the nature of such amendment and his reasons for the same.

(2) The request and the nature of such proposed amendment shall be advertised in the prescribed manner, and at any time within one month from its first advertisement any person may give notice at the patent-office of opposition to the amendment.

(3) Where such notice is given the comptroller shall give notice of the opposition to the person making the request, and shall hear and decide the case subject to an appeal to the law officer.

(4) The law officer shall, if required, hear the person making the request and the person so giving notice, and being in the opinion of the law officer entitled to be heard in opposition to the request,

and shall determine whether and subject to what conditions, if any, the amendment ought to be allowed.

(5) Where no notice of opposition is given, or the person so giving notice does not appear, the comptroller shall determine whether and subject to what conditions, if any, the amendment ought to be allowed.

(6) When leave to amend is refused by the comptroller, the person making the request may appeal from his decision to the law-officer.

(7) The law-officer shall, if required, hear the person making the request and the comptroller, and may make an order determining whether, and subject to what conditions, if any, the amendment ought to be allowed.

(8) No amendment shall be allowed that would make the specification, as amended, claim an invention substantially larger than or substantially different from the invention claimed by the specification as it stood before amendment.

(9) Leave to amend shall be conclusive as to the right of the party to make the amendment allowed, except in case of fraud; and the amendment shall in all courts and for all purposes be deemed to form part of the specification.

(10) The foregoing provisions of this section do not apply when and so long as any action for infringement or other legal proceeding in relation to a patent is pending.

19. *Power to disclaim part of invention during action, &c.*
(1) In an action for infringement of a patent, and in a proceeding for revocation of a patent, the court or a judge may at any time order that the patentee shall, subject to such terms as to costs and otherwise as the court or a judge may impose, be at liberty to apply at the patent-office for leave to amend his specification by way of disclaimer, and may direct that in the meantime the trial or hearing of the action shall be postponed.

20. *Restriction on recovery of damages.* Where an amendment by way of disclaimer, correction or explanation, has been allowed under this Act, no damages shall be given in any action in respect of the use of the invention before the disclaimer, correction or explanation, unless the patentee establishes to the satisfaction of the court that his original claim was framed in good faith and with reasonable skill and knowledge.

21. *Advertisement of amendment.* Every amendment of a specification shall be advertised in the prescribed manner.

22. *Compulsory licenses.* If on the petition of any person interested it is proved to the Board of Trade that by reason of the default of a patentee to grant licenses on reasonable terms—

(a) The patent is not being worked in the United Kingdom ; or

(b) The reasonable requirements of the public with respect to the invention cannot be supplied ; or

(c) Any person is prevented from working or using to the best advantage an invention of which he is possessed, the board may order the patentee to grant licenses on such terms as to the amount of royalties, security for payment, or otherwise, as the board, having regard to the nature of the invention and the circumstances of the case, may deem just, and any such order may be enforced by mandamus.

23. *Register of patents.* (1) There shall be kept at the patent office a book called the Register of Patents, wherein shall be entered the names and addresses of grantees of patents, notifications of assignments and of transmissions of patents, of licenses under patents, and of amendments, extensions, and revocations of patents and such other matters affecting the validity or proprietorship of patents as may from time to time be prescribed.

(2) The Register of Patents shall be *prima facie* evidence of any matters by this Act directed or authorized to be inserted therein.

(3) Copies of deeds, licenses, and any other documents affecting the proprietorship of any letters patent, or in any license thereunder, must be supplied to the comptroller in the prescribed manner for filing in the patent-office.

24. *Fees in schedule.* (1) There shall be paid in respect of the several instruments described in the second schedule to this Act, the fees in that schedule mentioned, and there shall likewise be paid, in respect of other matters under this part of the Act, such fees as may be from time to time, with the sanction of the treasury, prescribed by the Board of Trade ; and such fees shall be levied and paid to the account of Her Majesty's Exchequer in such manner as the treasury may from time to time direct.

(2) The Board of Trade may from time to time, if they think fit, with the consent of the treasury, reduce any of those fees.

25. *Extension of term of patent on petition to Queen in council.* (1) A patentee may, after advertising in manner directed by any rules made under this section, his intention to do so, present a petition to Her Majesty in Council, praying that his patent may be extended for a further term ; but such petition must be pre-

sented at least six months before the time limited for the expiration of the patent.

(2) Any person may enter a caveat, addressed to the registrar of the council at the council office, against the extension.

(3) If Her Majesty shall be pleased to refer any such petition to the Judicial Committee of the Privy Council, the said committee shall proceed to consider the same, and the petitioner, and any person who has entered a caveat, shall be entitled to be heard by himself, or by counsel on the petition.

(4) The judicial committee shall, in considering their decision, have regard to the nature and merits of the invention in relation to the public, to the profits made by the patentee as such, and to all the circumstances of the case.

(5) If the judicial committee report that the patentee has been inadequately remunerated by his patent, it shall be lawful for Her Majesty in Council to extend the term of the patent for a further term not exceeding seven, or, in exceptional cases, fourteen years; or to order the grant of a new patent for the term therein mentioned, and containing any restrictions, conditions, and provisions that the judicial committee may think fit.

(6) It shall be lawful for Her Majesty in Council to make, from time to time, rules of procedure and practice for regulating proceedings on such petitions, and subject thereto such proceedings shall be regulated according to the existing procedure and practice in patent matters of the judicial committee.

(7) The costs of all parties of and incident to such proceedings shall be in the discretion of the judicial committee; and the orders of the committee respecting costs shall be enforceable as if they were orders of a division of the High Court of Justice.

26. *Revocation of patent.* (1) The proceeding by *scire facias*, to repeal a patent, is hereby abolished.

(2) Revocation of a patent may be obtained on petition to the Court.

(3) Every ground on which a patent might, at the commencement of this Act, be repealed by *scire facias*, shall be available by way of defense to an action of infringement, and shall also be a ground of revocation.

(4) A petition for revocation of a patent may be presented by—

(a) The attorney-general in England or Ireland, or the lord advocate in Scotland:

(b) Any person authorized by the attorney-general in England or Ireland, or the Lord Advocate in Scotland :

(c) Any person alleging that the patent was obtained in fraud of his rights, or of the rights of any person under or through whom he claims :

(d) Any person alleging that he, or any person under or through whom he claims, was the true inventor of any invention included in the claim of the patentee :

(e) Any person alleging that he, or any person under or through whom he claims an interest in any trade, business, or manufacture, had publicly manufactured, used, or sold, within this realm, before the date of the patent, anything claimed by the patentee as his invention.

(5) The plaintiff must deliver with his petition particulars of the objections on which he means to rely, and no evidence shall, except by leave of the court or a judge, be admitted in proof of any objection of which particulars are not so delivered.

(6) Particulars delivered may be from time to time amended, by leave of the court or a judge.

(7) The defendant shall be entitled to begin, and give evidence in support of the patent, and if the plaintiff gives evidence impeaching the validity of the patent, the defendant shall be entitled to reply.

(8) Where a patent has been revoked on the ground of fraud, the comptroller may, on the application of the true inventor made in accordance with the provisions of this Act, grant to him a patent in lieu of, and bearing the same date as the date of revocation of the patent so revoked, but the patent so granted shall cease on the expiration of the term for which the revoked patent was granted.

27. Patent to bind Crown. (1) A patent shall have to all intents the like effect 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, 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 thereof 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.

LEGAL PROCEEDINGS.

28. *Hearing with Assessor.* (1) In an action or proceeding for infringement or revocation of a patent, the court may, if it thinks fit, and shall on the request of either of the parties to the proceeding, call in the aid of an assessor specially qualified, and try and hear the case wholly or partially with his assistance ; the action shall be tried without a jury unless the court shall otherwise direct.

(2) The Court of Appeal or the judicial committee of the Privy Council may, if they see fit, in any proceeding before them respectively, call in the aid of an assessor as aforesaid.

(3) The remuneration, if any, to be paid to an assessor under this section shall be determined by the court or the Court of Appeal or judicial committee, as the case may be, and be paid in the same manner as the other expenses of the execution of this act.

29. *Delivery of particulars.* (1) In an action for infringement of a patent, the plaintiff must deliver with his statement of claim, or by order of the court or the judge, at any subsequent time, particulars of the breaches complained of.

(2) The defendant must deliver with his statement of defense, or, by order of the court or a judge, at any subsequent time, particulars of any objections on which he relies in support thereof.

(3) If the defendant disputes the validity of the patent, the particulars delivered by him must state on what grounds he disputes it, and if one of those grounds is want of novelty, must state the time and place of the previous publication or user alleged by him.

(4) At the hearing no evidence shall, except by leave of the court or a judge, be admitted in proof of any alleged infringement or objection of which particulars are not so delivered.

(5) Particulars delivered may be from time to time amended, by leave of the court or a judge.

(6) On taxation of costs regard shall be had to the particulars delivered by the plaintiff and by the defendant ; and they respectively shall not be allowed any costs in respect of any particular delivered by them unless the same is certified by the court or a judge to have been proven or to have been reasonable and proper, without regard to the general costs of the case.

30. *Order for inspection, &c., in action.* In an action for infringement of a patent, the court or a judge may, on the appli-

cation of either party, make such order for an injunction, inspection or account, and impose such terms and give such directions respecting the same, and the proceedings thereon as the court or a judge may see fit.

31. *Certificate of validity questioned and costs thereon.* In an action for infringement of a patent, the court or a judge may certify that the validity of the patent came in question; and if the court or a judge so certifies, then in any subsequent action for infringement, the plaintiff in that action on obtaining a final order or judgment in his favor shall have his full costs, charges and expenses as between solicitor and client, unless the court or judge trying the action certifies that he ought not to have the same.

32. *Remedy in case of groundless threats of legal proceedings.* Where any person claiming to be the patentee of an invention, by circulars, advertisements or otherwise threatens any other person with any legal proceedings or liability in respect of any alleged manufacture, use, sale or purchase of the invention, any person or persons aggrieved thereby may bring an action against him, and may obtain an injunction against the continuance of such threats, and may recover such damage (if any) as may have been sustained thereby, if the alleged manufacture, use, sale or purchase to which the threats related was not in fact an infringement of any legal rights of the person making such threats: Provided that this section shall not apply if the person making such threats with due diligence commences and prosecutes an action for infringement of his patent.

MISCELLANEOUS.

33. *Patent for one invention only.* Every patent may be in the form in the first schedule to this act, and shall be granted for one invention only, but may contain more than one claim; but it shall not be competent for any person in an action or other proceeding to take any objection to a patent on the ground that it comprises more than one invention.

34. *Patent on application of representative of deceased inventor.* (1) If a person possessed of an invention dies without making application for a patent for the invention, application may be made by, and a patent for the invention granted to, his legal representative.

(2) Every such application must be made within six months of the decease of such person, and must contain a declaration by the

legal representative that he believes such person to be the true and first inventor of the invention.

35. *Patent to first inventor not invalidated by application in fraud of him.* A patent granted to the true and first inventor shall not be invalidated by an application in fraud of him, or by provisional protection obtained thereon, or by any use or publication of the invention subsequent to that fraudulent application during the period of provisional protection.

36. *Assignment for particular places.* A patentee may assign his patent for any place in or part of the United Kingdom, or Isle of Man, as effectually as if the patent were originally granted to extend to that place or part only.

37. *Loss or destruction of patent.* If a patent is lost or destroyed, or its non-production is accounted for to the satisfaction of the comptroller, the comptroller may at any time cause a duplicate thereof to be sealed.

38. *Proceedings and costs before law officer.* The law officers may examine witnesses on oath and administer oaths for that purpose under this part of this act, and may from time to time make, alter, and rescind rules regulating references and appeals to the law officers and the practice and procedure before them under this part of this act; and in any proceeding before either of the law officers under this part of this act, the law officer may order costs to be paid by either party, and any such order may be made a rule of the court.

39. *Exhibition at industrial or international exhibition not to prejudice patent rights.* The exhibition of an invention at an industrial or international exhibition, certified as such by the board of trade, or the publication of any description of the invention during the period of the holding of the exhibition, or the use of the invention for the purpose of the exhibition in the place where the exhibition is held, or the use of the invention during the period of the holding of the exhibition by any person elsewhere, without the privity or consent of the inventor, shall not prejudice the right of the inventor or his legal personal representative to apply for and obtain provisional protection and a patent in respect of the invention or the validity of any patent granted on the application, provided that both the following conditions are complied with, namely,—

(a.) The exhibitor must, before exhibiting the invention, give the comptroller the prescribed notice of his intention to do so; and

(b.) The application for a patent must be made before, or within six months from the date of the opening of the exhibition.

40. *Publication of illustrated journal, indexes, &c.* (1) The comptroller shall cause to be issued periodically an illustrated journal of patented inventions, as well as reports of patent cases decided by courts of law, and any other information that the comptroller may deem generally useful or important.

(2) Provision shall be made by the comptroller for keeping on sale copies of such journal, and also of all complete specifications of patents for the time being in force, with their accompanying drawings, if any.

(3) The comptroller shall continue, in such form as he may deem expedient, the indexes and abridgments of specifications hitherto published, and shall from time to time prepare and publish such other indexes, abridgments of specifications, catalogues, and other works relating to inventions, as he may see fit.

41. *Patent Museum.* The control and management of the existing patent museum and its contents shall, from and after the commencement of this Act, be transferred to and vested in the department of science and art, subject to such directions as Her Majesty in Council may see fit to give.

42. *Power to require models on payment.* The department of science and art may at any time require a patentee to furnish them with a model of his invention on payment to the patentee of the cost of the manufacture of the model; the amount to be settled, in case of dispute, by the board of trade.

40. *Foreign vessels in British waters.* (1) A patent shall not prevent the use of an invention for the purposes of the navigation of a foreign vessel within the jurisdiction of any of Her Majesty's courts in the United Kingdom or Isle of Man, or the use of an invention in a foreign vessel within that jurisdiction, provided it is not used therein for or in connection with the manufacture or preparation of anything intended to be sold in or exported from the United Kingdom or Isle of Man.

(2) But this section shall not extend to vessels of any foreign state of which the laws authorize subjects of such foreign state, having patents or like privileges for the exclusive use or exercise of inventions within its territories, to prevent or interfere with the use of such inventions in British vessels while in the ports of such foreign state, or in the waters within the jurisdiction of its courts, where such inventions are not so used for the manufacture or prep-

aration of anything intended to be sold in or exported from the territories of such foreign state.

44. *Assignment to secretary for war of certain inventions.* (1) The inventor of any improvement in instruments or munitions of war, his executors, administrators, or assigns (who are in this section comprised in the expression "the inventor") may (either for or without valuable consideration) assign to Her Majesty's principal secretary of state for the war department (hereinafter referred to as the secretary of state), on behalf of Her Majesty, all the benefit of the invention, and of any patent obtained or to be obtained for the same; and the secretary of state may be a party to the assignment.

(2) The assignment shall effectually vest the benefit of the invention and patent in the secretary of state for the time being on behalf of Her Majesty, and all covenants and agreements therein contained for keeping the invention secret and otherwise shall be valid and effectual (notwithstanding any want of valuable consideration), and may be enforced accordingly by the secretary of state for the time being.

(3) Where any such assignment has been made to the secretary of state, he may at any time before the application for a patent for the invention, or before publication of the specification or specifications, certify to the comptroller his opinion that, in the interest of the public service, the particulars of the invention and of the manner in which it is to be performed should be kept secret.

(4) If the secretary of state so certifies, the application and specification or specifications, with the drawings (if any), and any amendment of the specification or specifications, and any copies of such documents and drawings, shall, instead of being left in the ordinary manner at the patent-office, be delivered to the comptroller in a packet sealed by authority of the secretary of state.

(5) Such packet shall, until the expiration of the term or extended term during which a patent for the invention may be in force, be kept sealed by the comptroller, and shall not be opened save under the authority of an order of the secretary of state, or of the law officers.

(6) Such sealed packet shall be delivered at any time during the continuance of the patent to any person authorized by writing under the hand of the secretary of state to receive the same, and shall if returned to the comptroller be again kept sealed by him.

(7) On the expiration of the term or extended term of the

patent, such sealed packet shall be delivered to any person authorized by writing under the hand of the secretary of state to receive it.

(8) Where the secretary of state certifies as aforesaid, after an application for a patent has been left at the patent-office, but before the publication of the specification or specifications, the application, specification or specifications, with the drawings (if any), shall be forthwith placed in a packet, sealed by authority of the comptroller, and such packet shall be subject to the foregoing provisions respecting a packet sealed by authority of the secretary of state.

(9) No proceeding by petition or otherwise shall lie for revocation of a patent granted for an invention in relation to which the secretary of state has certified as aforesaid.

(10) No copy of any specification or other document or drawing, by this section required to be placed in a sealed packet, shall in any manner whatever be published or open to the inspection of the public, but, save as in this section otherwise directed, the provisions of this part of this Act shall apply in respect of any such invention and patent as aforesaid.

(11) The secretary of state may at any time, by writing under his hand, waive the benefit of this section with respect to any particular invention, and the specifications, documents and drawings shall be thenceforth kept and dealt with in the ordinary way.

(12) The communication of any invention for any improvement in instruments or munitions of war to the secretary of state, or to any person or persons authorized by him to investigate the same or the merits thereof, shall not, nor shall anything done for the purposes of the investigation, be deemed use or publication of such invention so as to prejudice the grant or validity of any patent for the same.

EXISTING PATENTS.

45. (1) The provisions of this Act relating to applications for patents and proceedings thereon shall have effect in respect only of applications made after the commencement of this Act.

(2) Every patent granted before the commencement of this Act, or on an application then pending, shall remain unaffected by the provisions of this Act relating to patents binding the Crown, and to compulsory licenses.

(3) In all other respects (including the amount and time of payment of fees) this Act shall extend to all patents granted before

the commencement of this Act, or on applications then pending, in substitution for such enactments as would have applied thereto if this Act had not been passed.

(4) All instruments relating to patents granted before the commencement of this Act required to be left or filed in the great seal patent-office shall be deemed to be so left or filed if left or filed before or after the commencement of this Act in the patent-office.

DEFINITIONS.

46. In and for the purposes of this Act—

“Patent” means letters patent for an invention :

“Patentee” means the person for the time being entitled to the benefit of a patent :

“Invention” means any manner of new manufacture the subject of letters patent and grant of privilege within section six of the Statute of Monopolies (that is, the Act of the twenty-first year of the reign of King James the First, chapter three, intituled “An Act concerning Monopolies and dispensations with penal laws and the forfeiture thereof” [*see ante*, p. 3]), and includes an alleged invention.

In Scotland “injunction” means “interdict.”

PART III.

DESIGNS.

REGISTRATION OF DESIGNS.

47. *Application for registration.* (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.

(2) The application must be made in the form set forth in the first schedule to this act, or in such other form as may be from time to time prescribed, and must be left at, or sent by post to, the patent-office in the prescribed manner.

(3) The application must contain a statement of the nature of the design, and the class or classes of goods in which the applicant desires that the design be registered.

(4) The same design may be registered in more than one class.

(5) In case of doubt as to the class in which a design ought to be registered, the comptroller may decide the question.

(6) The comptroller may, if he thinks fit, refuse to register any design presented to him for registration, but any person aggrieved by any such refusal may appeal therefrom to the board of trade.

(7) The board of trade shall, if required, hear the applicant and the comptroller, and may make an order determining whether, and subject to what conditions, if any, registration is to be permitted.

48. Drawings, &c., to be furnished on application. (1) On application for registration of a design the applicant shall furnish to the comptroller the prescribed number of copies of drawings, photographs or tracings of the design sufficient, in the opinion of the comptroller, for enabling him to identify the design; or the applicant may, instead of such copies, furnish exact representations or specimens of the design.

(2) The comptroller may, if he thinks fit, refuse any drawing, photograph, tracing, representation or specimen which is not, in his opinion, suitable for the official records.

49. Certificate of registration. (1) The comptroller shall grant a certificate of registration to the proprietor of the design when registered.

(2) The comptroller may, in case of loss of the original certificate, or in any other case in which he deems it expedient, grant a copy or copies of the certificate.

COPYRIGHT IN REGISTERED DESIGNS.

50. Copyright on registration. (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.

(2) Before delivery on sale of any articles to which a registered design has been applied, the proprietor must (if exact representations or specimens were not furnished on the application for registration), furnish to the comptroller the prescribed number of exact representations or specimens of the design; and if he fails to do so, the comptroller may erase his name from the register, and thereupon his copyright in the design shall cease.

51. Marking registered designs. Before delivery on sale of any articles to which a registered design has been applied, the proprietor of the design shall cause each such article to be marked with the prescribed mark, or with the prescribed word or words or figures,

denoting that the design is registered ; and if he fails to do so, the copyright in the design shall cease, unless the proprietor shows that he took all proper steps to ensure the markings of the article.

52. *Inspection of registered designs.* (1) During the existence of copyright in a design, the design shall not be open to inspection except by the proprietor, or a person authorized in writing by the proprietor, or a person authorized by the comptroller or by the court, and furnishing such information as may enable the comptroller to identify the design, nor except in the presence of the comptroller, or an officer acting under him, nor except on payment of the prescribed fee ; and the person making the inspection shall not be entitled to take any copy of the design, or of any part thereof.

(2) When the copyright in a design has ceased the design shall be open to inspection, and copies thereof may be taken by any person on payment of the prescribed fee.

53. *Information as to existence of copyright.*—On the request of any person producing a particular design, together with its mark of registration, or producing only its mark of registration, or furnishing such information as may enable the comptroller to identify the design, and on payment of the prescribed fee, it shall be the duty of the comptroller to inform such person whether the registration still exists in respect of such design, and if so, in respect of what class or classes of goods, and stating also the date of registration, and the name and address of the registered proprietor.

54. *Cesser of copyright in certain events.*—If a registered design is used in manufacture in any foreign country and is not used in this country within six months of its registration in this country, the copyright in the design shall cease.

REGISTER OF DESIGNS.

55. *Register to be kept.* (1) There shall be kept at the patent-office a book called the Register of Designs, wherein shall be entered the names and addresses of proprietors of registered designs, notifications of assignments and of transmissions of registered designs, and such other matters as may from time to time be prescribed.

(2) The register of designs shall be *prima facie* evidence of any matters by this act directed or authorized to be entered therein.

FEEES.

56. There shall be paid in respect of applications and registration and other matters under this part of this Act such fees as may

be from time to time, with the sanction of the treasury, prescribed by the board of trade; and such fees shall be levied and paid to the account of Her Majesty's Exchequer in such manner as the treasury shall from time to time direct.

INDUSTRIAL AND INTERNATIONAL EXHIBITIONS.

57. *Exhibition at them not to prevent or invalidate registration.* The exhibition at an industrial or international exhibition, certified as such by the Board of Trade, or the exhibition elsewhere during the period of the holding of the exhibition, without the privity or consent of the proprietor, of a design, or of any article to which a design is applied, or the publication, during the holding of any such exhibition, of a description of a design, shall not prevent the design from being registered, or invalidate the registration thereof, provided that both the following conditions are complied with: namely,—

(a) The exhibitor must, before exhibiting the design or publishing a description, give the comptroller the prescribed notice of his intention to do so; and

(b) The application for registration must be made before or within six months from the date of the opening of the exhibition.

LEGAL PROCEEDINGS.

58. *Penalty on Piracy of registered design.* During the existence of copyright in any design—

(a) It shall not be lawful for any person without the license or written consent of the registered proprietor to apply such design or any fraudulent or obvious imitation thereof, in the class or classes of goods in which such design is registered, for purposes of sale to any article of manufacture or to any substance, artificial or natural or partly artificial and partly natural; and

(b) It shall not be lawful for any person to publish or expose for sale any article of manufacture or any substance to which such design or any fraudulent or obvious imitation thereof shall have been so applied, knowing that the same has been so applied without the consent of the registered proprietor.

Any person who acts in contravention of this section shall be liable for every offense to forfeit a sum not exceeding fifty pounds to the registered proprietor of the design, who may recover such sum as a simple contract debt by an action in any court of competent jurisdiction.

59. *Action for damages.* Notwithstanding the remedy given by this Act for the recovery of such penalty as aforesaid, the registered proprietor of any design may (if he elects to do so) bring an action for the recovery of any damages arising from the application of any such design, or of any fraudulent or obvious imitation thereof for the purpose of sale, to any article of manufacture or substance, or from the publication, sale or exposure for sale by any person of any article or substance to which such design or any fraudulent or obvious imitation thereof shall have been so applied, such person knowing that the proprietor had not given his consent to such application.

DEFINITIONS.

60. "*Design.*" In and for the purposes of this Act—

"Design" means any design applicable to any article of manufacture, or to any substance, artificial or natural, or partly artificial and partly natural, whether the design is applicable for the pattern, or for the shape or configuration, or for the ornament thereof, or for any two or more of such purposes, and by whatever means it is applicable, whether by printing, painting, embroidering, weaving, sewing, modelling, casting, embossing, engraving, staining, or any other means whatever, manual, mechanical, or chemical, separate or combined, not being a design for a sculpture, or other thing within the protection of the Sculpture Copyright Act of 1814 (fifty-fourth George the Third, chapter fifty-six).

"*Copyright*" means the exclusive right to apply a design to any article of manufacture or to any such substance as aforesaid in the class or classes in which the design is registered.

61. "*Proprietor.*" The author of any new and original design shall be considered the proprietor thereof, unless he executed the work on behalf of another person for a good or valuable consideration, in which case such person shall be considered the proprietor, and every person acquiring for a good or valuable consideration a new and original design, or the right to apply the same to any such article or substance as aforesaid, either exclusively of any other person, or otherwise, and also every person on whom the property in such design or such right to the application shall devolve, shall be considered the proprietor of the design in the respect in which the same may have been so acquired, and to that extent, but not otherwise.

PART V.*

GENERAL.

PATENT-OFFICE AND PROCEEDINGS THEREAT.

82. Patent-office. (1) The treasury may provide for the purposes of this Act an office with all requisite buildings and conveniences, which shall be called, and in this Act is referred to as, the patent-office.

(2) Until a new patent-office is provided, the offices of the commissioners of patents for inventions and for the registration of designs and trade-marks existing at the commencement of this act shall be the patent-office within the meaning of this Act.

(3) The patent-office shall be under the immediate control of an officer called the comptroller-general of patents, designs, and trade-marks, who shall act under the superintendence and direction of the board of trade.

(4) Any act or thing directed to be done by or to the comptroller may, in his absence, be done by or to any officer for the time being in that behalf authorized by the board of trade.

83. Officers and clerks. (1) The board of trade may at any time after the passing of this act, and from time to time, subject to the approval of the treasury, appoint the comptroller-general of patents, designs, and trade-marks, and so many examiners and other officers and clerks, with such designations and duties as the board of trade think fit, and may from time to time remove any of those officers and clerks.

(2) The salaries of those officers and clerks shall be appointed by the board of trade, with the concurrence of the treasury, and the same and the other expenses of the execution of this Act shall be paid out of money provided by parliament.

84. Seal of patent-office. There shall be a seal for the patent-office, and impressions thereof shall be judicially noticed and admitted in evidence.

85. Trusts not to be entered in registers. There shall not be entered in any register kept under this Act, or be receivable by the

* Part IV. is omitted because relating to designs and trade-marks, which are to trade-marks only. Sections 87, 91, 92, omitted; but are in general germane to 101, in Part V. contain clauses relating the provisions relative to patents.

comptroller, any notice of any trust expressed, implied or constructive.

86. *Refusal to grant patent in certain cases.* The comptroller may refuse to grant a patent for an invention, design, &c., of which the use would, in his opinion, be contrary to law or morality.

87. *Entry of assignments and transmissions, in registers.* Where a person becomes entitled by assignment, transmission, or other operation of law to a patent, the comptroller shall on request, and on proof of title to his satisfaction, cause the name of such person to be entered as proprietor of the patent, in the register of patents. The person for the time being entered in the register of patents as proprietor of a patent shall, subject to any rights appearing from such register to be vested in any other person, have power absolutely to assign, grant licenses as to, or otherwise deal with the same, and to give effectual receipts for any consideration for such assignment, license, or dealing: Provided that any equities in respect of such patent may be enforced in like manner as in respect of any other personal property. [The like as to designs, &c.]

88. *Inspection of and extracts from registers.* Every register kept under this Act shall at all convenient times be open to the inspection of the public, subject to such regulations as may be prescribed, and certified copies, sealed with the seal of the patent-office, of any entry in any such register shall be given to any person requiring the same on payment of the prescribed fee.

89. *Sealed copies to be received in evidence.* Printed or written copies or extracts, purporting to be certified by the comptroller and sealed with the seal of the patent-office, of or from patents, specifications, disclaimers and other documents in the patent-office, and of or from registers and other books kept there, shall be admitted in evidence in all courts in Her Majesty's dominions, and in all proceedings, without further proof or production of the originals.

90. *Rectification of registers by court.* (1) The court may, on the application of any person aggrieved by the omission without sufficient cause of the name of any person from any register kept under this Act, or by any entry made without sufficient cause in any such register, make such order for making, expunging or varying the entry as the court thinks fit; or the court may refuse the application; and in either case may make such order with respect to the costs of the proceedings as the court thinks fit.

(2) The court may in any proceeding under this section decide any question that it may be necessary or expedient to decide for

the rectification of a register, and may direct an issue to be tried for the decision of any question of fact, and may award damages to the party aggrieved.

(3) Any order of the court rectifying a register shall direct that due notice of the rectification be given to the comptroller.

91. *Power for comptroller to correct clerical errors.* The comptroller may, on request in writing accompanied by the prescribed fee,—

(a.) Correct any clerical error in or in connection with an application for a patent ; or

(b.) Correct any clerical error in the name, style, or address of the registered proprietor of a patent.

93. *Falsification of entries in registers.* If any person makes or causes to be made a false entry in any register kept under this Act, or a writing falsely purporting to be a copy of an entry in any such register, or produces or tenders, or causes to be produced or tendered in evidence any such writing, knowing the entry or writing to be false, he shall be guilty of a misdemeanor.

94. *Exercise of discretionary power by comptroller.* Where any discretionary power is by this Act given to the comptroller, he shall not exercise that power adversely to the applicant for a patent, or for amendment of a specification, without (if so required within the prescribed time by the applicant) giving the applicant an opportunity of being heard personally or by his agent.

95. *Power of comptroller to take directions of law officers.* The comptroller may, in any case of doubt or difficulty arising in the administration of any of the provisions of this Act, apply to either of the law officers for directions in the matter.

96. *Certificate of comptroller to be evidence.* A certificate purporting to be under the hand of the comptroller as to any entry, matter, or thing which he is authorized by this Act, or any general rules made thereunder, to make or do, shall be *prima facie* evidence of the entry having been made, and of the contents thereof, and of the matter or thing having been done or left undone.

97. (1) *Applications and notices by post.* Any application, notice, or other document authorized or required to be left, made or given at the patent-office or to the comptroller, or to any other person under this Act, may be sent by a prepaid letter through the post ; and if so sent shall be deemed to have been left, made, or

given respectively at the time when the letter containing the same would be delivered in the ordinary course of post.

(2) In proving such service or sending, it shall be sufficient to prove that the letter was properly addressed and put into the post.

98. *Provision as to days for leaving documents at office.* Whenever the last day fixed by this Act, or by any rule for the time being in force, for leaving any document or paying any fee at the patent-office shall fall on Christmas Day, Good Friday, or on a Saturday or Sunday, or any day observed as a holiday at the Bank of England, or any day observed as a day of public fast or thanksgiving, herein referred to as excluded days, it shall be lawful to leave such document or to pay such fee on the day next following such excluded day, or days if two or more of them occur consecutively.

99. *Declaration by infant, lunatic, &c.* If any person is, by reason of infancy, lunacy, or other inability, incapable of making any declaration or doing anything required or permitted by this Act, or by any rules made under the authority of this Act, then the guardian or committee (if any) of such incapable person, or if there be none, any person appointed by any court or judge possessing jurisdiction in respect of the property of incapable persons, upon the petition of any person on behalf of such incapable person, or of any other person interested in the making such declaration or doing such thing, may make such declaration or a declaration as nearly corresponding thereto as circumstances permit, and do such thing in the name and on behalf of such incapable person, and all acts done by such substitute shall for the purposes of this Act be as effectual as if done by the person for whom he is substituted.

100. *Transmission of certified printed copies of specifications, &c.* Copies of all specifications, drawings and amendments left at the patent-office after the commencement of the Act, printed for and sealed with the seal of the patent-office, shall be transmitted to the Edinburgh Museum of Science and Art, and to the enrollments office of the chancery division in Ireland, and to the rolls office in the Isle of Man, within twenty-one days after the same shall respectively have been accepted or allowed at the patent-office ; and certified copies of or extracts from any such documents shall be given to any person requiring the same on payment of the prescribed fee ; and any such copy or extract shall be admitted in evidence in all courts in Scotland and Ireland, and in the Isle of Man without further proof or production of the originals.

101. *Power for board of trade to make general rules for regulating business of patent-office.* (1) The board of trade may, from time to time, make such general rules and do such things as they think expedient, subject to the provisions of this Act—

(c) For making or requiring duplicates of specifications, amendment, drawings, and other documents :

(d) For securing and regulating the publishing and selling of copies, at such prices and in such manner as the board of trade think fit, of specifications, drawings, amendments, and other documents.

(e) For securing and regulating the making, printing, publishing, and selling of indexes to, and abridgments of, specifications and other documents in the patent-office ; and providing for the inspection of indexes and abridgments and other documents :

(f) For regulating (with the approval of the treasury) the presentation of copies of patent-office publications to patentees and to public authorities, bodies and institutions at home and abroad :

(g) Generally for regulating the business of the patent-office, and all things by this Act placed under the direction or control of the comptroller, or of the board of trade.

(2) Any of the forms in the first schedule to this Act may be altered or amended by rules made by the board as aforesaid.

(3) General rules may be made under this section at any time after the passing of this Act, but not so as to take effect before the commencement of this Act, and shall (subject as hereinafter mentioned) be of the same effect as if they were contained in this Act, and shall be judicially noticed.

(4) Any rules made in pursuance of this section shall be laid before both houses of Parliament, if Parliament be in session at the time of making thereof, or, if not, then as soon as practicable after the beginning of the next session of Parliament, and they shall also be advertised twice in the official journal to be issued by the comptroller.

(5) If either house of Parliament, within the next forty days after any rules have been so laid before such house, resolve that such rules, or any of them, ought to be annulled, the same shall after the date of such resolution be of no effect, without prejudice to the validity of anything done in the meantime under such rules or rule or to the making of any new rules or rule.

102. *Annual reports of comptroller.* The comptroller shall before the first day of June in every year, cause a report respecting

the execution by or under him of this Act to be laid before both houses of Parliament, and therein shall include for the year to which each report relates all general rules made in that year under or for the purposes of this Act, and an account of all fees, salaries, and allowances, and other money received and paid under this act.

INTERNATIONAL AND COLONIAL ARRANGEMENTS.

103. *For protection of inventions, &c.* (1) If Her Majesty is pleased to make any arrangement with the government or governments of any foreign State or States for mutual protection of inventions, designs, and trade-marks, or any of them, then any person who has applied for protection for any invention, design or trade-mark, in any such State, shall be entitled to a patent for his invention or to registration of his design or trade-mark (as the case may be) under this Act, in priority to other applicants; and such patent or registration shall have the same date as the date of the protection obtained in such foreign State.

Provided that his application is made in the case of a patent within seven months and in the case of a design or trade-mark within four months, from his applying for protection in the foreign State with which the arrangement is in force.

Provided that nothing in this section contained shall entitle the patentee or proprietor of the design or trade-mark to recover damages for infringements happening prior to the date of the actual acceptance of his complete specification, or the actual registration of his design or trade-mark in this country, as the case may be.

(2) The publication in the United Kingdom, or the Isle of Man during the respective periods aforesaid of any description of the invention, or the use therein, during such periods, of the invention or the exhibition or use therein, during such periods, of the design, or the publication therein during such periods of a description or representation of the design or the use therein during such periods, of the trade-mark, shall not invalidate the patent which may be granted for the invention, or the registration of the design or trade-mark.

(3) The application for the grant of a patent or the registration of a design or the registration of a trade-mark under this section, must be made in the same manner as an ordinary application under this act. [Proviso as to trade-marks.]

(4) The provisions of this section shall apply only in the case of those foreign States with respect to which Her Majesty shall from time to time by order in council declare them to be applicable, and so long only in the case of each State as the order in council shall continue in force with respect to that State.

104. *Provision for colonies and India.* (1) Where it is made to appear to Her Majesty that the legislature of any British possession has made satisfactory provision for the protection of inventions designs and trade-marks patented or registered in this country, it shall be lawful for Her Majesty from time to time, by order in council, to apply the provisions of the last preceding section, with such variations or additions, if any, as to Her Majesty in council may seem fit, to such British possession.

(2) An order in council under this Act shall, from a date to be mentioned for the purpose in the order, take effect as if its provisions had been contained in this act; but it shall be lawful for Her Majesty in Council to revoke any order in council made under this Act.

OFFENSES.

105. *Penalty on falsely representing articles to be patented.*

(1) Any person who represents that any article sold by him is a patented article, when no patent has been granted for the same, or describes any design or trade-mark applied to any article sold by him as registered which is not so, shall be liable for every offense on summary conviction to a fine not exceeding five pounds.

(2) A person shall be deemed, for the purposes of this enactment, to represent that an article is patented or a design or a trade-mark is registered, if he sells the article with the word "patent," "patented," "registered," or any word or words expressing or implying that a patent or registration has been obtained for the article stamped, engraved, or impressed on, or otherwise applied to, the article.

106. *Penalty on unauthorized assumption of royal arms.* Any person who, without the authority of Her Majesty, or any of the royal family, or of any government department, assumes or uses in connection with any trade, business, calling, or profession, the royal arms, or arms so nearly resembling the same as to be calculated to deceive, in such a manner as to be calculated to lead other persons to believe that he is carrying on his trade, business, calling, or profession by or under such authority as aforesaid, shall be

liable on summary conviction to a fine not exceeding twenty pounds.

SCOTLAND, IRELAND, ETC.

107. *Saving for courts in Scotland.* In any action for infringement of a patent in Scotland the provisions of this Act, with respect to calling in the aid of an assessor, shall apply, and the action shall be tried without a jury, unless the court shall otherwise direct, but otherwise nothing shall affect the jurisdiction and forms of process of the courts in Scotland in such an action or in any action or proceeding respecting a patent hitherto competent to those courts.

For the purposes of this section "court of appeal" shall mean any court to which such action is appealed.

108. *Summary proceedings in Scotland.* In Scotland any offense under this Act declared to be punishable on summary conviction may be prosecuted in the sheriff court.

109. *Proceedings for revocation of patent in Scotland.* (1) Proceedings in Scotland for revocation of a patent shall be in the form of an action of reduction at the instance of the Lord Advocate, or at the instance of a party having interest with his concurrence, which concurrence may be given on just cause shown only.

(2) Service of all writs and summonses in that action shall be made according to the forms and practice existing at the commencement of this Act.

110. *Reservation of remedies in Ireland.* All parties shall, notwithstanding anything in this Act, have in Ireland their remedies under or in respect of a patent as if the same had been granted to extend to Ireland only.

111. *General saving for jurisdiction of courts.* (1) The provisions of this Act conferring a special jurisdiction on the court as defined by this Act, shall not, except so far as the jurisdiction extends, affect the jurisdiction of any court in Scotland or Ireland in any proceedings relating to patents or to designs or trade-marks; and with reference to any such proceedings in Scotland, the term "the court" shall mean any Lord Ordinary of the Court of Session, and the term "Court of Appeal" shall mean either division of the said court; and with reference to any such proceedings in Ireland, the terms "the court" and "The court of Appeal" respectively mean the High Court of Justice in Ireland and Her Majesty's Court of Appeal in Ireland.

(2) If any rectification of a register under this Act is required in pursuance of any proceeding in a court in Scotland or Ireland, a copy of the order, decree, or other authority for the rectification, shall be served on the comptroller, and he shall rectify the register accordingly.

112. *Isle of Man.* This Act shall extend to the Isle of Man, and—

(1) Nothing in this Act shall affect the jurisdiction of the courts in the Isle of Man, in proceedings for infringement or in any action or proceeding respecting a patent design or trade-mark competent to those courts ;

[(2) (3) The punishment for offenses under this Act committed in the Isle of Man, prescribed.]

REPEAL; TRANSITIONAL PROVISIONS; SAVINGS.

113. *Repeal, and saving for past operation of repealed enactments, &c.* The enactments described in the third schedule to this act are hereby repealed. But this repeal of enactments shall not—

(a) Affect the past operation of any of those enactments, or any patent, &c., granted or acquired, or application pending, or appointment made, or compensation granted, or order or direction made or given, or right, privilege, obligation, or liability acquired, accrued, or incurred, or anything duly done or suffered under or by any of those enactments before or at the commencement of this Act ; or

(b) Interfere with the institution or prosecution of any action or proceeding, civil or criminal, in respect thereof, and any such proceeding may be carried on as if this Act had not been passed ; or

(c) Take away or abridge any protection or benefit in relation to any such action or proceeding.

114. *Former registers to be deemed continued.* (1) The registers of patents and of proprietors kept under any enactment repealed by this Act shall respectively be deemed parts of the same book as the register of patents kept under this Act. (2) [The like as to designs, &c.]

115. *Saving for existing rules.* All general rules made by the Lord Chancellor or by any other authority under any enactment repealed by this Act, and in force at the commencement of this Act, may at any time after the passing of this Act be repealed, altered or amended by the board of trade, as if they had been made by the board under this Act, but so that no such repeal,

alteration or amendment shall take effect before the commencement of this Act ; and subject as aforesaid, such general rules shall, so far as they are consistent with and are not superseded by this Act, continue in force as if they had been made by the board of trade under this Act.

116. *Saving for prerogative.* Nothing in this Act shall take away, abridge, or prejudicially affect the prerogative of the Crown in relation to the granting of any letters patent or to the withholding of a grant thereof.

GENERAL DEFINITIONS.

117. (1) In and for the purposes of this Act, unless the context otherwise requires,—

“ Person ” includes a body corporate ;

“ The court ” means (subject to the provisions for Scotland, Ireland, and the Isle of Man) Her Majesty’s High Court of Justice in England ;

“ Law officer ” means Her Majesty’s attorney-general or solicitor-General for England ;

“ The Treasury ” means the commissioner of Her Majesty’s treasury.

“ Comptroller ” means the comptroller general of patents, designs, and trade-marks ;

“ Prescribed ” means prescribed by any of the Schedules to this Act, or by general rules under or within the meaning of this Act ;

“ British possession ” means any territory or place situate within Her Majesty’s dominions, and not being or forming part of the United Kingdom, or of the Channel Islands, or of the Isle of Man ; and all territories and places under one legislature, as hereinafter defined, are deemed to be one British possession for the purposes of this Act ;

“ Legislature ” includes any person or persons who exercise legislative authority in the British possession ; and where there are local legislatures as well as a central legislature, means the central legislature only.

In the application of this Act to Ireland, “ summary conviction ” means a conviction under the summary Jurisdiction Acts, &c.

THE FIRST SCHEDULE.

FORMS OF APPLICATION, &c.

FORM A.

[£1 Stamp.]

Form of Application for Patent.

I [*here insert name, address, and calling of inventor*], do solemnly and sincerely declare that I am in possession of an invention for [*here insert title of invention*]; that I am the true and first inventor thereof; and that the same is not in use by any other person or persons to the best of my knowledge and belief; and I humbly pray that a patent may be granted to me for the said invention.

And I make the above solemn declaration, conscientiously believing the same to be true, and by virtue of the provisions of the Statutory Declarations Act, 1835.

Declared at _____, in the County of _____, this _____ day of _____, 18 ____.

[Signature of inventor.]

Before me,

[Signature and title of the officer before whom
the Declaration is made.]

NOTE.—Where the above declaration is made out of the United Kingdom, the words “and by virtue of the Statutory Declarations Act, 1835,” must be omitted; and the declaration must be made before a British consular officer, or where it is not reasonably practicable to make it before such officer, then before a public officer duly authorized in that behalf.

[NOTE.—The following Form A 1 was added by the rules.]

FORM A 1.

[£1 Stamp.]

Application for Patent for Inventions communicated from abroad.

I [*here insert name, full address, and calling of applicant*], do solemnly and sincerely declare that I am in possession of an invention for [*here insert title of invention*], which invention has been communicated to me from abroad by [*here insert name, address, and calling of communicant*]; that I claim to be the true and first inventor thereof; and that the same is not in use within this realm by any other person or persons to the best of my knowledge and belief; and I humbly pray that a patent may be granted to me for the said invention.

And I make the above solemn declaration, conscientiously believing the same to be true, and by virtue of the provisions of the Statutory Declarations Act, 1835.

Declared at _____, in the County of _____, this _____ day of _____, 18 ____.

[Signature of applicant.]

Before me,

[Signature and title of the officer before whom
the declaration is made.]

NOTE.—Where the above declaration is made out of the United Kingdom, the words, “and by virtue of the Statutory Declarations Act, 1835,” must be omitted, and the declaration must be made before a British consular officer, or, where it is not reasonably practicable to make it before such officer, then before a public officer duly authorized in that behalf.

FORM B.

Form of Provisional Specification.

[Here insert title as in declaration.]

I [here insert name, address, and calling of inventor as in declaration], do hereby declare the nature of my invention for [here insert title as in declaration] to be as follows:—[here insert short description of invention.]

Dated this day of , 18 .

[Signature of inventor.]

NOTE.—No stamp is required on this document.

[£3 Stamp.]

FORM C.

Form of Complete Specification.

[Here insert title as in declaration.]

I [here insert name, address, and calling of inventor as in declaration], do hereby declare the nature of my invention for [here insert title as in declaration], and in what manner the same is to be performed, to be particularly described and ascertained in and by the following statement:—[here insert full description of invention.]

Having now particularly described and ascertained the nature of my said invention, and in what manner the same is to be performed, I declare that what I claim is:—

1. [Here state distinctly the features of novelty claimed.]
- 2.
3. &c.

Dated this day of , 18 .

[Signature of inventor.]

FORM D.

Form of Patent.

VICTORIA, by the grace of God, of the United Kingdom of Great Britain and Ireland, Queen, Defender of the Faith: To all to whom these presents shall come, greeting:

Whereas , hath, by his solemn declaration, represented unto us that he is in possession of an invention for ; that he is the true and first inventor thereof; and that the same is not in use by any other person, to the best of his knowledge and belief:

And whereas the said inventor hath humbly prayed that we would be graciously pleased to grant unto him (herein-after together with his executors, administrators, and assigns, or any of them, referred to as the said patentee), our royal letters patent for the sole use and advantage of his said invention:

And whereas the said inventor hath, by and in his complete specification, particularly described the nature of his invention:

And whereas we being willing to encourage all inventions which may be for the public good, are graciously pleased to condescend to his request:

Know ye, therefore, that we, of our especial grace, certain knowledge, and mere motion, do by these presents, for us, our heirs and successors, give and grant unto the said patentee our especial license, full power, sole privilege and authority, that the said patentee by himself, his agents, or licensees, and no others, may at all times

THE SECOND SCHEDULE.

*Fees on Instruments for Obtaining Patents and Renewal.**(a) Up to sealing.*

	£	s.	d.	£	s.	d.
On application for provisional protection.	1	0	0			
On filing complete specification.	3	0	0			
	—————			4	0	0
<i>or</i>						
On filing complete specification with first application.				4	0	0

(b) Further before end of four years from date of patent.

On certificate of renewal.	50	0	0
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(c) Further before end of seven years, or in the case of patents granted after the commencement of this Act, before the end of eight years from date of patent.

On certificate	100	0	0
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Or in lieu of and £100 the following annual fees:—

Befo: th	of the fourth year from the date of the patent.	10	0	0
"	“ fifth “ “	10	0	0
"	“ sixth “ “	10	0	0
"	“ seventh “ “	10	0	0
"	“ eighth “ “	15	0	0
"	“ ninth “ “	15	0	0
"	“ tenth “ “	20	0	0
"	“ eleventh “ “	20	0	0
"	“ twelfth “ “	20	0	0
"	“ thirteenth “ “	20	0	0

THE THIRD SCHEDULE.

Enactments repealed [omitting trade-marks laws].

21 James I. c. 3. [1623.]	The Statute of Monopolies. In part; namely,— Sections ten, eleven, and twelve.
5 & 6 Will. 4. c. 62. [1835.] In part.	The Statutory Declarations Act, 1835. In part; namely,— Section eleven.
5 & 6 Will. 4. c. 83. [1835]	An Act to amend the law touching letters-patent for inventions.
2 & 3 Vict. c. 67. [1839.]	An Act to amend an Act of the fifth and sixth years of the reign of King William the Fourth, intituled “An Act to amend the law touching letters-patent for inventions.”

<p>5 & 6 Vict. c. 100. [1842.]</p>	<p>An Act to consolidate and amend the laws relating to the copyright of designs for ornamenting articles of manufacture.</p>
<p>6 & 7 Vict. c. 65. [1843.]</p>	<p>An Act to amend the laws relating to the copyright of designs.</p>
<p>7 & 8 Vict. c. 69. [1844.] In part.</p>	<p>An Act for amending an Act passed in the fourth year of the reign of His late Majesty, intituled: "An Act for the better administration of justice in His Majesty's Privy Council, and to extend its jurisdiction and powers." In part; namely,— Sections two to five, both included. NOTE.—Sections six and seven of this Act are repealed by the Statute Law Revision (No. 2) Act, 1874.</p>
<p>13 & 14 Vict. c. 104. [1850.]</p>	<p>An Act to extend and amend the Acts relating to the copyright of designs.</p>
<p>15 & 16 Vict. c. 83. [1852.]</p>	<p>The Patent Law Amendment Act, 1852.</p>
<p>16 & 17 Vict. c. 5. [1853.]</p>	<p>An Act to substitute stamp duties for fees on passing letters-patent for inventions, and to provide for the purchase for the public use of certain indexes of specifications.</p>
<p>16 & 17 Vict. c. 115. [1853.]</p>	<p>An Act to amend certain provisions of the Patent Law Amendment Act, 1852, in respect of the transmission of certified copies of letters patent and specifications to certain offices in Edinburgh and Dublin, and otherwise to amend the said Act.</p>
<p>21 & 22 Vict. c. 70. [1858.]</p>	<p>An Act to amend the Act of the fifth and sixth years of Her present Majesty, to consolidate and amend the laws relating to the copyright of designs for ornamenting articles of manufacture.</p>
<p>22 Vict. c. 13. [1859.]</p>	<p>An Act to amend the law concerning patents for inventions with respect to inventions for improvements in instruments and munitions of war.</p>
<p>24 & 25 Vict. c. 73. [1861.]</p>	<p>An Act to amend the law relating to the copyright of designs.</p>
<p>28 & 29 Vict. c. 3. [1865.]</p>	<p>The Industrial Exhibitions Act, 1865.</p>
<p>33 & 34 Vict. c. 27. [1870.]</p>	<p>The Protection of Inventions Act, 1870.</p>
<p>33 & 34 Vict. c. 97. [1870.]</p>	<p>The Stamp Act, 1870,— In part; namely,— Section sixty-five, and in the schedule the words and figures: "Certificate of the registration of a design.....£5 0 0 And see section 65."</p>

88 & 39 Vict. c. 93. [1875.]	The Copyright of Designs Act, 1875.
43 & 44 Vict. c. 10. [1880.]	The Great Seal Act, 1880. In part; namely, Section five.

From 123 *Pub. Gen. Stat.* 370.

*An Act to amend the Patents, Designs, and Trade-Marks Act, 1883. August 14, 1885, Stat. 48 and 49 Vict. c. 63.**

Be it enacted, &c.

1. This Act shall be construed as one with the Patents, Designs, and Trade-Marks Act, 1883, (in this Act referred to as the principal Act.)

This Act may be cited as the "Patents, Designs, and Trade-Marks (Amendment) Act, 1885," and this Act and the principal Act may be cited together as the "Patents, Designs and Trade-Marks Acts, 1883 and 1885."

2. Whereas, subsection 2 of section 5 of the principal Act requires a declaration to be made by an applicant for a patent to the effect in that subsection mentioned, and doubts have arisen as to the nature of that declaration, and it is expedient to remove such doubts: Be it therefore enacted that the declaration mentioned in subsection 2 of section 5 of the principal Act may be either a statutory declaration under the Statutory Declarations Act, 1835, or not, as may be from time to time prescribed.

3. Whereas, under the principal Act a complete specification is required (by section 8) to be left within nine months, and (by section 9) to be accepted within twelve months from the date of appli-

* Territorial application of the Acts of Parliament of the United Kingdom. The Act of 1883 is, by its terms, extended and made applicable to the Isle of Man; and the Act of 1885, of course, has the same operation. It is understood that the Act of 1883 was not applicable to the Channel Islands nor to the "British possessions," (meaning places within Her Majesty's dominions, but not within the United

Kingdom, the Isle of Man, and the Channel Islands). Most of the colonies have patent-laws of their own, which are given in this work, under their several names. Arrangements for extending the Act to the Channel Islands are said to have been under consideration during 1884, but no final agreement was reached. 2nd Rep. of Compt. Gen. of Pat., in Off. J. Pat. Off. No. 160, July, 1885.

cation, and a patent is required by section 12 to be sealed within fifteen months from the date of application, and it is expedient to empower the comptroller to extend in certain cases the said times : Be it therefore enacted as follows :

A complete specification may be left and accepted within such extended times, not exceeding one month and three months, respectively, after the said nine and twelve months, respectively, as the comptroller may on payment of the prescribed fee allow, and where such extension of time has been allowed a further extension of four months after the said fifteen months shall be allowed for the sealing of the patent ; and the principal Act shall have effect as if any time so allowed were added to the said periods specified in the principal Act.

4. Where an application for a patent has been abandoned, or become void, the specification or specifications and drawings (if any) accompanying or left in connection with such application shall not at any time be open to public inspection or be published by the comptroller.

5. Whereas, doubts have arisen whether under the principal Act a patent may lawfully be granted to several persons jointly, some or one of whom only are or is the true and first inventors or inventor : Be it therefore enacted and declared that it has been and is lawful under the principal Act to grant such a patent.

6. In subsection 1 of section 103 of the principal Act the words "date of the application" shall be substituted for the words "date of the protection obtained."

From 125 *Pub. Gen. Stat.* 334.

GREECE.

According to a report by Mr. William A. C. Barrington, of the British Legation, published October 7, 1873, 4 *Pat. Off. Gaz.* 371, there was not, at the time of his writing, any special law in Greece affecting patents for inventions. He states that "the practice of the country places all inventors on the same footing as a person seeking a monopoly ; and in either case a special Act is required to secure the individual in the possession of the rights which he claims. A bill for the purpose may be introduced in the chamber by any deputy, and is treated like any other bill ; and, if it passes, it defines, according to the circumstances of the case, the limits both as to time and place within which exclusive privileges are accorded to the party on whose behalf the motion is made."

GUADELOUPE.

See FRANCE.

GUATEMALA.

Decree No. 148 of (May 21), 1886.

The Legislative Assembly of the Republic of Guatemala having considered the necessity of developing the interests of the country in an efficient manner and in harmony with the liberal principles laid down in the twentieth section of the constitution, which, in one of its clauses, secures the full rights to an author or inventor, and at the same time to regulate and define in a clear and precise manner the power, functions and extent of authority which the said section concedes to the executive, do hereby decree, as follows :

SEC. 1. Any discovery or invention in whatsoever branch of industry gives its originator an exclusive right to avail himself of his invention or improvement for the term and under the conditions established by this law.

SEC. 2. Every citizen of Guatemala, or foreigner domiciliated in Guatemala, who invents or improves some machine, instrument or mechanical apparatus, manufacture of whatsoever description, or process of useful application in the arts and sciences, may obtain from the Executive power a "patent for invention," or a "patent for improvement," which secures to him, for a term of from five to fifteen years, the right to his invention or improvement.

SEC. 3. To obtain a patent the interested party shall apply in his own name, or through his representative at the ministry of the interior, setting forth with precision the character of his invention, and soliciting the privilege.

SEC. 4. If the patent is granted, the favored party shall be under the obligation to present within a term of forty days an exact design of the respective machine, mechanical apparatus, or a detailed description of the new process, to which should be added if practicable, a specimen of the manufacture or product, which, if it can be preserved, shall be deposited in the bureau of the legislative chamber, under the responsibility of the officer who has charge of it, for the purpose of serving as evidence in case any controversy should arise respecting the privilege.

SEC. 5. Letters patent can be obtained for an invention that has been patented abroad, when it does not already appear to be a public property, and if there subsists an agreement between the gov-

ernment of the nation from which it proceeds, and the government of Guatemala.

Patents of this character expire at the date indicated in the foreign letters patent. Should however, the term extend beyond fifteen years, the concession granted shall not exceed this period of time.

SEC. 6. The privilege granted shall be recorded in a special book kept in the bureau of the secretary.

SEC. 7. In the letters patent granted shall be inserted the decision relating to the concession, with references to the present law, the nature or character of the invention or improvement, the term of the patent, and the declaration of the right to the privilege. The letters patent shall be stamped with the seal of the ministry of the interior.

SEC. 8. The executive, in granting a patent, shall not declare either that the discovery or invention is the property of the person who appears as the inventor or author; or that it is of any utility, or founded on fact. An interested party is at liberty to prove before the law, the contrary.

SEC. 9. All applications for patents shall be published four times in the course of one month in the official journal; and the patents granted shall be published at the least twice in the same periodical.

SEC. 10. Besides the case referred to in section 4, patents become void under the following circumstances, viz.:

1. When patents have been issued to the prejudice of the rights of a third party (*tercero*), in accordance with the decision of a competent court of justice.

2. When the patentee has allowed one year to elapse without having put into practice the industry or improvement for which the concession was made.

3. When the patentee, after he has brought the industry or improvement into practice, abandons it for more than a year.

4. When the products manufactured are inferior to the specimens presented, in consequence of adulteration or admixture of baser materials.

SEC. 11. Patents shall not be granted in the following cases, viz.:

1. When the invention or improvement is contrary to prior rights, to public health and safety, and to good customs.

2. When the conditions established by this law have not been properly complied with.

SEC. 12. The privilege granted applies only to the *modus operandi* or means of execution and of procedure, and not to products which can be manufactured by another method, and therefore may be freely elaborated and brought upon the market.

SEC. 13. Any person has right to improve the invention of another, but not to make use of the principal invention, without the permission of the inventor; the inventor in his turn can as little avail himself of the improvements made by another person without his consent.

SEC. 14. For each patent granted a duty or tax varying from five to fifty pesos shall be paid annually in advance by the patentee to the national treasury during the term for which the privilege has been granted.

SEC. 15. When the term for a patent expires, the descriptions of the author or inventor shall be published, and copies of the drawings or models may be furnished to persons who apply for them, at their own cost. From that time forward the respective process or method shall be considered as public property.

SEC. 16. Violation of the privileges of the patentee through falsification, imitation, etc., of the articles patented, shall be punished in conformity with the directions contained in the Penal Code.

SEC. 17. The executive has right to make concessions in favor of undertakings (*empresas*) of a useful public character, or of such undertakings as have for object the introduction of new industries or improvements in those which are already practiced.

SEC. 18. These concessions can be of the following description: Exemption from, or reduction in, payment of duty for the introduction of machinery or material; free use of buildings or public land during the term of the concession; exemption from the military service for operatives engaged in industries to which the concession refers; subventions and bounties in money, when the circumstances of the treasury may permit.

In case of immunity from or reduction in the duties, the directors or managers of the favored undertaking, in order to obtain the despatch of the commodities, shall present an application to the respective custom-house containing the following points of facts:

1. That the undertaking belongs to the distinct class for which concessions have been made.

2. That the articles for the despatch of which application is made, do not exceed in quantity the requirements or conditions of the undertaking itself.

3. To state the name of the vessel that carries the commodities, and to indicate the marks and number of the packages.

4. To present a list of the merchandise laid up in their magazines, stating also what has been previously introduced and deposited.

[The residue of section 18 and the whole of section 19 prescribe the methods and proceedings by which such concessions as are mentioned in sections 17 and 18 may be obtained ; but do not affect the law of patents.]

SEC. 20. Special concessions cannot be granted for the introduction of machines for domestic use (*uso domestico*), and other common commercial articles.

SEC. 21. The concession granted in favor of a certain undertaking shall be annulled if it becomes known that commerce is carried on with the raw material introduced.

SEC. 22. In the case provided against in the preceding section the interested party, besides the loss of the concession, shall pay the duty corresponding to all the commodities imported and 40 per cent. on the total amount.

SEC. 23. Concessions become also void in the following cases :

1. When the term has expired within which the directors of the undertaking had bound themselves to establish the proposed industry or improvement and to put it in operation.

2. When, after having been established, an undertaking is abandoned for more than a year.

SEC. 24. Sections 436 and 437 of the chapter 2, title X, of the Fiscal Code, book 1 are abolished.

This law shall be transmitted to the executive for publication and execution.

Done in the Chamber of the Legislative Assembly at Guatemala, May 21, 1886.

Furnished for this work from the collection of Patent Laws, of Mr. W. E. Richards.

HAWAIIAN KINGDOM.

*Civil Code.**

SECTION 255. The minister of the interior may, with the approval of the King, issue a patent to the inventor or improver of any machine, manufacture, or other work of art calculated to promote the interests of science, agriculture, or manufactures, and may therein grant to such inventor or improver the exclusive use and benefit of his invention or improvement for any term of years, not exceeding ten, that may be specified in such patent.

SEC. 256. Every such inventor or improver shall, before receiving a patent, deliver to the minister of the interior a full and clear description in writing of his invention or improvement, together with the mode of using or applying the same to the purpose for which it is intended, and the manner and process of making, constructing, or compounding the same, and in case of any machine he shall also furnish, in addition to the written description, accurate drawings and a complete model thereof.

Act to regulate the Issuing of Patents. August 29, 1884.

Be it enacted by the King and the Legislative Assembly of the Hawaiian Islands, in the Legislature of the Kingdom assembled :

SECTION 1. All patents shall be issued in the name of his Majesty the King, under the seal of the interior department, and shall be signed by the minister of the interior and countersigned by the commissioner of patents, and they shall be recorded, together with the specifications, in the office of the interior department in books kept for that purpose.

SEC. 2. 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

* The exhibit of the Hawaiian Patent Laws given in Carpmaels' Patent Laws of the World, presents only sections 255, 256, and 256a, of the Civil Code, as amended (or added), by subsequent legislation. But section 9 of the act of 1884, given in the text, as will be seen, repeals

the amendatory legislation; the effect of which repeal obviously is, to restore sections 255 and 256 in their original form, so that these sections, with the act of 1884, constituted, after the passage of the latter act, the patent law of the kingdom.

term of ten years, of the exclusive right to make, use, and vend the invention or discovery throughout the Hawaiian Islands, referring to the specification for particulars thereof. A copy of the specifications and drawings shall be annexed to the patent and be a part thereof.

SEC. 3. Any person who has invented or discovered any new and useful art, machine, manufacture, process, 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, may, upon payment of the fees required by law and other due proceedings had, obtain a patent therefor: Provided, however, That any person who has invented or discovered any new and useful art, machine, manufacture, process, or composition of matter, or any new and useful improvement thereof, and has received a patent or patents therefor from any foreign government, may also obtain a patent therefor in this country as provided above, unless the thing patented has been introduced into public use in the Hawaiian Islands for more than one year prior to the application for a patent. But every patent granted for an invention which has been previously patented in a foreign country shall be so limited that it shall not continue longer than the time of the expiration of such foreign patent, or if there are several foreign patents it shall not continue longer than the time of the expiration of the one with the shortest unexpired term, and in no case shall it be in force more than ten years.

SEC. 4. Before any inventor or discoverer shall receive a patent for his invention or discovery he shall apply therefor in writing to the minister of the interior, and shall file in the office of the interior department a written description of the same and of the manner and process of making, compounding, and using it, in clear, concise, and exact terms, and in case of a machine he shall explain the principle thereof and of the manner in which he has applied 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. When the nature of the case admits of drawings, the applicant shall furnish them, as set forth in section 2. When the invention or discovery is of composition of matter, the applicant shall furnish a specimen of ingredients and of the composition, sufficient in quantity for the purpose of experiment. In all cases which admit of

representation by model the applicant shall, if required, furnish a model of convenient size to exhibit advantageously the several parts of his invention.

SEC. 5. The applicant shall make oath that he believes himself to be the original and first inventor or discoverer of the art, machine, manufacture, 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 shall state of what country he is a citizen.

SEC. 6. On filing of any such application and the payment of the fees required by law, the commissioner of patents shall examine the alleged new invention or discovery, and if upon 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, he shall report accordingly to the minister of the interior, who shall cause a patent to be issued therefor.

SEC. 7. Any person who makes any new invention or discovery and desires further time to mature the same, may on payment of the fee required by law file in the interior department a caveat setting forth the design thereof and its distinguishing characteristics, and praying protection of his right until he shall have matured the invention. Such caveat shall be preserved in secrecy and shall be operative for the term of one year from the filing thereof.

SEC. 8. The commissioner of patents shall be appointed by the minister of the interior, and shall examine and report on all applications for patents, and shall receive for such services a fee of twenty dollars for each application examined and reported by him, which fee shall be paid by the applicant in advance. In addition to this fee the following fees shall be charged all applicants for patents; upon filing each original application for a patent, five dollars; and upon issuing a patent, five dollars; and five dollars shall be charged for the filing of a caveat.

SEC. 9. This Act shall take effect and become a law from and after its publication, and "An Act to amend sections 255 and 256 of the Civil Code, and add a new section to the Civil Code to be numbered Section 256 A," approved the 22d day of June, A. D. 1868, is hereby repealed.

Approved this 29th day of August, A. D. 1884.

KALAKAUA REX.

From 32 *Pat. Off. Gaz.* 771.

HAYTI.

According to a report of Mr. St. John, of the British Legation, published October 7, 1873, in 4 *Pat. Off. Gaz.* 373, the Republic of Hayti had not, at the time of his writing, any law or practice in regard to granting patents for inventions.

HERZEGOVINA.

See AUSTRIA-HUNGARY.

HOLLAND.

See NETHERLANDS.

HONGKONG.

Ordinance No. 14 of 1862.

Title. An ordinance for granting patents for inventions within this colony.

Preamble. Whereas patents for inventions granted in England are not usually extended to the colonies, and it is expedient that power should be vested in his Excellency the Governor, with the advice of the Executive Council to grant letters patent for the exclusive use of inventions within this colony, for which letters patent have already been granted in England. Be it therefore enacted by his Excellency the Governor of Hongkong, with the advice of the Legislative Council thereof, as follows :—

I. *Authority to owners of inventions to petition for letters patent.* It shall be lawful for the inventor, or for the owner by assignment or otherwise, from any inventor of any invention or of the exclusive right thereto within this colony, to petition His Excellency the Governor for letters patent for any invention for which letters patent have already been granted in England; and such petition may be in the form set forth in schedule A, hereto. Every such petition shall be accompanied by a specification of the said invention, identical as far as practicable with the specification filed on the petition for letters patent for the said invention in England, and by a declaration which may be in the form set forth in schedule B, or in such other form not being less specific as to the governor shall appear proper.

II. *Petition, specification and declaration to be filed in office of colonial secretary, and to be advertised.* Such petition, specification and declaration shall be filed in the office of the colonial secretary, and notice thereof, and of any intention to apply for such letters patent, and of the time of the sitting of the Executive Council before which the matter of the petition will come for decision, together with such other particulars as the governor shall require, shall be inserted twice in the Hongkong Government Gazette, and shall be otherwise advertised as the governor shall direct.

III. *Governor in council to grant letters patent.* His Excellency the Governor, with the advice of the said Executive Council,

shall, at the sitting to be so appointed for deciding on such petition for letters patent as aforesaid, or at any adjournment thereof, determine on such application for letters patent, and grant or refuse the prayer of the said petition as shall appear expedient, and for such time or times not exceeding the then duration of the letters patent for the said invention, or for any less period, and subject to such conditions in all respects as to His Excellency the Governor, with the advice of the said Executive Council shall seem fit. The said letters patent may be in such form as is prescribed by the Patent Law Amendment Act, 1852, of the Imperial Parliament, or as near thereto as circumstances will permit.

IV. *Effect of such grant.* Letters patent to be granted under this ordinance shall confer all the rights and privileges, and shall subject the grantees thereof to all the provisions affecting letters patent in England, as fully as if the same had been granted with an extension thereof to this colony by Her Majesty, under the provisions of the statutes now in force in England, or as near thereto as the circumstances of this colony will admit of.

V. *When and how letters patent may be granted for an extended period.* In case Her Majesty shall, by the advice of the judicial committee of Her Majesty's Privy Council, extend the privileges of any letters patent in England for any invention for any period, it shall be lawful for His Excellency the Governor, with the advice of the Executive Council, to extend in like manner such letters patent, if already granted for this colony, or otherwise to grant original letters patent for a like extended period for the same invention.

SCHEDULE A.

FORM OF PETITION.

The humble petition of A. B. [*or, as the case may be, of C. D., as agent for A. B.*], &c.

That your petitioner [*or, as the case may be, that A. B., of whom your petitioner is the agent, assignee, executor or administrator*], has obtained Her Majesty's letters patent, dated the day of , 18 , for [*state the title of the invention as granted*], and that such letters patent are to continue in force for years from the day of , 18 .

That your petitioner believes that the said invention is not now, and has not hitherto been publicly used in this colony.

That the following is the description of the said invention [*here state the particu-*

ars shortly in accordance with the specification on which the letters patent in England were granted.]

Your petitioner therefore prays for leave to file a specification of the said invention pursuant to the provisions of Ordinance No. 14 of 1862.

And your petitioner will ever pray, &c.

SCHEDULE B.

I [*here insert name, condition, and place of residence*] do solemnly and sincerely declare that I am [*or if made by an agent, that A. B., of is*] in possession absolutely [*or if made in respect of a locally confined interest, then within the colony of Hongkong, or according to fact*] of an invention for [*state the nature of the invention in terms of the English patent*], and which invention I believe will, in all probability, be of great public utility within Hongkong; and that the same is not publicly used within the said colony; and that to the best of my knowledge and belief, the instrument in writing under my hand hereunto annexed, particularly describes and ascertains the nature of the said invention, and in what manner the same is to be performed.

Dated the day of , 18 .

(Signed)

From *Carp. Pat. L. of World*, p. 264.

HUNGARY.

See AUSTRIA-HUNGARY.

INDIA.

Act No. 15 of (May 17,) 1859.

It is enacted, &c.

I. Inventor may petition for leave to file specification. Form, &c., of petition. The inventor of any new manufacture may petition the Governor General of India in council, for leave to file a specification thereof. Every such petition shall be in writing in the form or to the effect mentioned in the schedule hereunto annexed, and shall be signed by the petitioner or (in case the petitioner shall be absent from India), by an authorized agent, and shall state the name, addition, and place of residence of the petitioner, and the nature of the invention.

1a. For the purposes of this act, a new manufacture shall be deemed to include any new and original pattern or design, or application of such pattern or design to any substance or article of manufacture.

[NOTE.*—This clause was introduced by Act No. 13 of 1872.]

II. Order to file specification. Upon such petition the Governor General of India in council may make an order authorizing the petitioner to file a specification of the invention.

III. Power to refer petition for inquiry and report. Before making such order, the Governor General of India in council, may refer the petition to any person or persons for inquiry and report, and such person or persons shall be entitled to a reasonable fee for such inquiry and report, to be paid by the petitioner, the amount of such fee, in case of dispute, to be settled by a judge of one of Her Majesty's courts of judicature in a summary manner.

IV. Petitioner entitled to exclusive privilege for fourteen years from filing specification.—Extension of term. If, within the space of six calendar months from the date of such order the petitioner cause a specification of his invention to be filed in manner hereinafter mentioned, the petitioner, his executors, administrators, or assigns, shall be entitled to the sole and exclusive privilege of making, selling, and using the said invention in India, and of authorizing others so to do, for the term of fourteen years from the time of filing such specification, and for such further term (if any)

* The notes thus printed are from Carpmaels' edition.

not exceeding fourteen years from the expiration of the first fourteen years, as the Governor General of India in Council may think fit to direct, upon petition to be presented by such inventor, at any period not more than one year, and not less than six calendar months, before the expiration of the exclusive privilege hereby granted.

4a. Provided that in the case of patterns and designs, or the application thereof to any substances or articles of manufacture, such privilege shall be granted for the term of three years and no more.

[NOTE.—This clause was introduced by Act No. 13 of 1872.]

V. Order to file specification may be conditional. An order authorizing the filing of a specification, or for extending the term of such exclusive privilege as aforesaid, may be made subject to any such conditions and restrictions as the Governor General of India in council may think expedient.

VI. Specification to be in writing and to describe the intention. Every specification of an invention filed under this Act shall be in writing, and shall be signed by the petitioner, and shall particularly describe and ascertain the nature of the said invention, and in what manner the same is to be performed.

VII. Petition and specification to be left with secretary.—To be accompanied by declaration.—Date of delivery to be indorsed. Every petition for leave to file a specification and every specification filed under this act shall be left with the secretary to the government of India in the home department, and every petition and specification shall be accompanied by a declaration in writing, signed by the petitioner, in the form or to the effect mentioned in the schedule hereunto annexed, marked A and B respectively; and if the inventor be absent from India, the petition and specification shall also be accompanied by a declaration signed by the agent who shall present or file the same, to the effect that he verily believes that the declaration, purporting to be the declaration of the inventor, was signed by him, and that the contents thereof are true, which declaration shall be in the form, or to the effect mentioned in the said schedule. The date of the delivery of every such petition and specification shall be indorsed on the same respectively, and shall also be recorded at the office of the said secretary.

VIII. False statement in declaration, punishable as perjury. If any person who shall make a declaration under this act shall willfully and corruptly make any false statement therein, he shall be

deemed guilty of perjury, and shall be proceeded against, and upon conviction punished accordingly.

IX. *Specification not to be filed before payment of fees.* No specification shall be filed until the petitioner shall have paid all fees payable under this Act, including the fees (if any) of the person or persons to whom the petition shall have been referred for inquiry and report.

X. *Copies of specification to be delivered and distributed.—To be open to inspection.* At the time of delivering the specification for the purpose of being filed, the petitioner shall cause to be delivered to the said secretary five copies thereof, of which,—

One shall be sent to and filed by one of the secretaries to the government of Bengal;

One shall be sent to and filed by one of the secretaries to the government of Fort St. George;

One shall be sent to and filed by one of the secretaries to the government of Bombay; and

One shall be sent to and filed by one of the secretaries to the government of the North-Western Provinces.

A copy of such specification shall be open at all reasonable times at the office of each of the said secretaries to public inspection upon payment of a fee of one rupee.

XI. *Book for the registry of petitions, specifications, &c.* A book shall be kept in the office of the said secretary to the government of India, wherein shall be entered and recorded every such petition and specification, and every order made upon such petition or relating to the invention therein mentioned. Every specification shall be numbered according to the order in which it is entered in such book; and a reference shall be made in such book, in the margin of the entry of each specification, to every order relating to the invention, and to every petition, memorandum, or amended specification, which shall be filed under the provisions of section 14.

XII. *Inspection of registry book.—Certified copy of entry to be given.* Such book, or a copy thereof, shall be open at all convenient times for the inspection of any person upon payment of one rupee; and the said secretary shall cause a copy of any entry therein, certified under his hand, to be given to any person requiring the same on payment of the expense of copying.

XIII. [*Repealed by Act No. 12 of 1876.*]

XIV. *In what cases petitioner may apply to file amended specifications.—Effect.* If after the filing of the specification the

petitioner shall have reason to believe that, through mistake or inadvertence he has erroneously made any mis-statement in his petition or specification, or included therein something which at the date of his petition was not new or whereof he was not the inventor, or that such specification is in any particular defective or insufficient he may petition the Governor General in Council for leave to file a memorandum, pointing out such error, defect, or insufficiency, and disclaiming any part of the alleged invention, or in case of any defect or insufficiency of the specification for leave to file an amended specification. The petition shall state how the error, defect or insufficiency occurred, and that it was not fraudulently intended, and shall be accompanied by a declaration in writing signed by the petitioner, and if he be absent from India, by his agent, stating that the contents of such petition are true, to the best of his knowledge and belief. Upon such petition the Governor General in Council may make an order allowing such memorandum or amended specification to be filed. All the provisions of sections X., XI., XII., and XIII., applicable to the specifications, shall be applicable to the petitions, orders, and memoranda or amended specifications referred to in this section. An amended specification filed under the provisions of this Act shall, except as to suits or proceedings relating to the exclusive privilege which shall be pending at the time of the filing of such amended specification, have the same effect as if it had been the specification first filed; provided that nothing contained in an amended specification shall extend or enlarge any exclusive privilege before acquired.

XV. *No person entitled to exclusive privilege, when.*—No person shall be entitled to any exclusive privilege under the provisions of this Act—

If the invention is of no utility, or

If the invention, at the time of presenting the petition for leave to file the specification, was not a new invention, or within the meaning of this Act, or

If the petitioner is not the inventor thereof, or

If the specification filed or the amended specification (if any) does not particularly describe and ascertain the nature of the invention, and in what manner the same is to be performed, or

If the original or any subsequent petition relating to the invention or the original or any amended specification contain a willful or fraudulent mis-statement.

XVI. *Exclusive privilege to cease if government declare that it is*

mischievous, &c., or (upon breach of condition) that it shall cease. Every exclusive privilege under this Act shall cease if the Governor General of India in Council shall declare that the same, or the mode in which it is exercised, is mischievous to the State, or generally prejudicial to the public; or if a breach of any special condition on which the petitioner shall be authorized to file a specification, or upon which the term of the exclusive privilege shall be extended, shall be proved to the satisfaction of any of Her Majesty's courts of judicature, and if the Governor General of India in Council shall thereupon declare that such exclusive privilege shall cease.

XVII. *Importer not inventor.* The importer into India of a new invention shall not be deemed an inventor within the meaning of this Act, unless he be the actual inventor.

XVIII. *Foreign inventor.* A foreigner, whether resident abroad or not, may petition for leave to file a specification under this Act.

XIX. *An invention not publicly used or known deemed a new invention.—Knowledge of invention fraudulently acquired.—Proviso.—Public use by actual inventor.* An invention shall be deemed a new invention within the meaning of this Act, if it shall not, before the time of applying for leave to file the specification, have been publicly used in India or in any part of the United Kingdom of Great Britain and Ireland, or been made publicly known in any part of India or of the United Kingdom by means of a publication, either printed or written, or partly printed and partly written. The public use or knowledge of an invention, prior to the application for leave to file a specification, shall not be deemed a public use or knowledge within the meaning of this section, if the knowledge shall have been obtained surreptitiously or in fraud of the inventor, or shall have been communicated to the public in fraud of the inventor or in breach of confidence: provided the inventor shall within six calendar months after the commencement of such public use, apply for leave to file his specification, and shall not previously have acquiesced in such public use; provided also, that the use of an invention in public by the inventor thereof, or by his servants or agents, or by any other person by his license in writing, for a period not exceeding one year prior to the date of his petition, shall not be deemed a public use thereof within the meaning of this Act.

XX. *Inventor having obtained English letters patent to petition within twelve months.—Invention, not publicly known, or used to be deemed new.—What to be stated in such petition.—Duration of exclusive privilege.* If an inventor who, prior to the time of

applying for leave to file a specification of an invention under this Act, shall have obtained Her Majesty's letters patent for the exclusive use of such invention in the United Kingdom, or any part thereof, shall, within twelve calendar months from the passing of this Act, or within twelve calendar months from the date of such letters patent, petition the Governor General of India in Council for leave to file specification of such invention (which petition shall be in writing, in the form or to the effect mentioned in the schedule), the invention shall be deemed a new invention within the meaning of this Act, if it was not publicly known or used in India at or before the date of the petition for such letters patent, notwithstanding it may have been publicly known or used in some part of the United Kingdom or in India before the time of his petitioning, under this Act, for leave to file the specification: Provided the petition for leave to file the specification shall state that such letters patent have been granted, and shall also state the date thereof and the term during which the same are to continue in force: Provided also, that an exclusive privilege obtained under the provisions of this Act by an inventor who has obtained Her Majesty's letters patent for the exclusive use of such invention, shall cease to have effect, if such letters patent be revoked or canceled; and that no such exclusive privilege shall extend beyond the term granted by such letters patent unless the same shall be renewed, in which case the exclusive privilege may be renewed under this Act for the extended term or any part thereof.

XXI. *Saving of rights, before 1855.* No exclusive privilege obtained under this Act shall entitle the owner of such privilege to exclude any person from using the invention, who, prior to the 7th day of July, 1855, used the same in India.

XXII. *Action for infringement.* An action may be maintained by an inventor against any person who, during the continuance of an exclusive privilege granted by this Act, shall, without the license of the said inventor, make, use, sell, or put in practice the said invention, or who shall counterfeit or imitate the same. Provided that no such action shall be maintained in any court other than the principal court of original jurisdiction in civil cases within the local limits of whose jurisdiction the cause of action shall accrue or the defendant shall reside as a fixed inhabitant.

XXIII. *Defect in specification or petition, or want of novelty in invention, &c., no defense to action for infringement.—Actual use of before petition, a defense.* No such action shall be defended

upon the ground of any defect or insufficiency of the specification of the invention, nor upon the ground that the original or any subsequent petition relating to the invention, or the original or any amended specification, contains a willful or fraudulent mis-statement; nor upon the ground that the invention is not useful; nor shall any such action be defended upon the ground that the plaintiff was not the inventor, unless the defendant shall show that he is the actual inventor, or has obtained a right from him to use the invention either wholly or in part. Any such action may be defended upon the ground that the invention was not new if the person making the defense, or some person through whom he claims shall before the date of the petition for leave to file the specification, have publicly or actually used in India or in some part of the United Kingdom, the invention, or that part of it of which the infringement shall be proved, but not otherwise.

XXIV. *Application to courts to annul exclusive privilege because invention of no utility; or not new; or petitioner not the inventor; or invention not described in specification; or fraud, &c., in petition or specification; or insufficient description of part of invention in specification.* It shall be lawful for any person to apply by motion to any of Her Majesty's courts of judicature for a rule to show cause why the court should not declare that an exclusive privilege in respect of an invention has not been acquired under the provisions of this Act by reason of all or any of the objections following (to be specified in the rule); that is to say:—

That the said invention is of no utility, or,

That the said invention was not, at the time of presenting the petition for leave to file the specification a new invention within the meaning of this Act, or,

That the petitioner was not the inventor thereof, or,

That the specification filed, or the amended specification (if any) does not particularly describe and ascertain the nature of the invention, or in what manner the same is to be performed, or,

That the petitioner has knowingly or fraudulently included in the petition or specification, or amended specification, as part of his invention, something which was not new or whereof he was not the inventor, or,

That the original or any subsequent petition relating to the invention, or the original or any amended specification, contains a willful or fraudulent mis-statement, or,

That some part of the invention, or the manner in which that part is to be performed, as described in the specification filed, or the amended specification, is not thereby sufficiently described and ascertained, and that such defect or insufficiency was fraudulent and is injurious to the public.

XXV. *Like application as to part of an invention.* Any person may, in like manner, apply to any of Her Majesty's courts of judicature for a rule to show cause why the court should not declare that an exclusive privilege has not been acquired under the provisions of this Act in respect of any part of the invention to be specified in the rule by reason of all or any of the objections following (to be specified in the rule), that is to say,—

That such part of the invention is wholly distinct from the other part thereof, and is of no utility, or

That such part of the invention was not, at the date of the petition for leave to file the specification, a new invention within the meaning of this act, or

That the petitioner was not the inventor of that part of the invention, or

That that part of the invention, and the manner in which it is to be performed, is not sufficiently described and ascertained in the specification filed or the amended specification, and that such defect or insufficiency is injurious to the public.

XXVI. *Application by advocate general on breach of special condition.* It shall be lawful for the advocate general at any of the Presidencies of Fort William in Bengal, Fort St. George, and Bombay, or any other person, by order of the Governor General in council, to apply to any of the said courts of judicature for a rule calling upon the petitioner, his executors, administrators, or assigns, to show cause why the question of the breach of any special condition upon which the leave to file a specification has been granted, or any other question of fact on which the revocation of the exclusive privilege by the Governor General in council under the power hereinbefore reserved may, in the judgment of the said Governor General in council, depend, should not be tried in the form of an issue directed by the said court; and if the rule be made absolute, the court, unless the breach or other matter of fact be admitted, may thereupon direct such issue to be tried, and certify the result of such trial to the Governor General in council; the costs of such trial, and also the costs of any proceedings in any of the said courts of judicature

under the provisions of this Act, shall be in the discretion of the court.

XXVII. *Service of proceedings on all persons interested.* Notice of any rule obtained or proceeding taken under either of the last three preceding sections shall be served on all persons appearing to be proprietors or to have shares or interests in the exclusive privilege under the provisions of section XXXV. of this act, and it shall not be necessary to serve such notice on any other persons.

XXVIII. *Supreme court may direct issue for trial to other courts.—New trial.* Any of the said courts of judicature, if it think fit, may direct an issue for the trial, before the same court or any other court of judicature, or any principal court of original jurisdiction in civil cases of any question of fact arising upon an application under sections XXIV., XXV., or XXVI., of this act, and such issue shall be tried accordingly in a summary manner, and if the issue be directed to another court, the finding shall be certified by the court before which the same was tried, to the court directing the issue. If the issue be directed to any courts of judicature, the court by which the issue is tried may, before the finding is certified, direct a new trial of such issue according to the usual course and practice of such court. If the issue be directed to any court other than a court of judicature, the finding shall not be subject to appeal, but the evidence taken upon the trial shall be recorded, and a copy thereof, certified by the judge, shall be transmitted, together with any remarks he may think fit to make thereon, to the court by which the issue was directed; and such court may either act upon the decision of the court which tried the issue, or direct a new trial if it should appear necessary.

XXIX. *Judgment.—Costs.* If it shall appear to any of the said courts of judicature at the hearing of any application under the provisions of sections XXIV. or XXV. of this act that, by reason of any of the objections therein mentioned, the said exclusive privilege in the invention or in any part thereof has not been acquired, the court shall give judgment accordingly, and shall make such order as to the costs of and consequent upon the application as it may think just; and thereupon the petitioner, his executors, administrators, and assigns shall, so long as the judgment continues in force, cease to be entitled to such exclusive privilege.

XXX. *Amendment of specification by court.—Proviso.* If the court, at the hearing of any such application as last aforesaid, shall think that the petitioner has, in the description of his invention in

the petition or specification, or amended specification (if any) included something which at the date of the petition was not new or whereof he was not the inventor, or that the specification is in any particular defective or insufficient, but that the error, defect, or insufficiency was not fraudulently intended, the court may adjudge the said exclusive privilege to have been acquired and to be valid, save as to part thereof affected by such error, defect or insufficiency, or if the court shall think that the error, defect, or insufficiency can be amended without injury to the public, they may adjudge the exclusive privilege in the whole of the invention to be valid, and may, upon such terms as shall appear reasonable, order the specification to be amended in any of the said particulars; and thereupon the petitioner, his executors, administrators, or assigns, shall, within the time limited by the said court for the purpose, file a specification amended according to such order: Provided that no such amended specification shall have the effect of extending or enlarging the exclusive privilege before acquired.

XXXI. *Mis-statement in the petition, if not fraudulent, not to defeat the privilege.* An exclusive privilege shall not be defeated upon the ground that the petition contains a mis-statement, unless such mis-statement was willful or fraudulent.

XXXII. *Entry in Registry Book, of judgment, &c., declaring privilege not to have been acquired.* Whenever it shall be adjudged by any of the said courts or judicature that an exclusive privilege as to the whole or any part of an invention has not been acquired, the said secretary to the government of India shall, upon the production of the judgment or order, cause an entry thereof to be made in the said book hereinbefore directed to be kept, and shall cause a reference to such entry to be made in the margin of the entry of the specification contained in such book.

XXXIII. *In what case actual inventor entitled to assignment of an exclusive privilege fraudulently obtained.* If, upon proceedings instituted within two years from the date of a petition to file a specification the actual inventor shall prove to the satisfaction of the principal court having jurisdiction in civil cases, within the local limits of whose jurisdiction the defendant shall reside as a fixed inhabitant, that the petitioner was not the actual inventor, and that at the time of the petition he knew or had good reason to believe that the knowledge of the invention was obtained by himself or by some other person, surreptitiously or in fraud of the actual inventor, or by means of a communication made in confidence by the actual inven-

tor to him, or to any person through whom he derived such knowledge, the court may compel the petitioner to assign to the actual inventor any exclusive privilege obtained under this Act, and to account for and pay over the profits thereof.

XXXIV. Particulars to be delivered. In any action for the infringement of such exclusive privilege the plaintiff shall deliver with his plaint particulars of the breaches complained of in the said action; and the defendant shall deliver a written statement of the particulars of the grounds (if any) upon which he means to contend that the plaintiff is not entitled to an exclusive privilege in the invention. In like manner, upon any application to any of the said courts of judicature under sections XXIV., XXV., or XXVI. of this Act, the applicant shall deliver particulars of the objections on which he means to rely. At the trial of any such action or issue, no evidence shall be allowed to be given in support of any alleged infringement, or of any objection impeaching the validity of such exclusive privilege which shall not be contained in the particulars delivered as aforesaid. If it be alleged that the invention was publicly known or used prior to the date of the petition for leave to file such specification, the places where and the manner in which the invention was so publicly known or used shall be stated in such particulars. Provided always that it shall be lawful for any court in which the action or proceeding is pending or in which the issue is tried to allow the plaintiff or defendant respectively to amend the particulars delivered as aforesaid upon such terms as shall seem fit.

XXXV. Service of proceedings. A book shall be kept in the office of the secretary to the government of India in the home department (such book to be open to inspection without fee) wherein every person filing a specification under this Act, or any person to whom the exclusive privilege may be assigned, shall cause to be stated some place in India where service of any rule or proceedings for the purpose of cancelling or revoking his exclusive privilege may be made, and shall cause a reference to such entry to be made in the margin of the entry of the specification; and may from time to time cause any other place in India to be substituted by similar entry and reference. All such rules and proceedings as aforesaid shall be deemed sufficiently served if a copy thereof be left at the place entered in such book or (if any other place be substituted for the same by entry in the said book) at the place last substituted, by delivering the same to any person resident at, or in charge of, such place: or, if there be no person resident at, or in

charge of, such place, or if such place be not within the local limits of the jurisdiction of the court, by causing such rule or proceeding to be sent by post, by a registered letter, directed to such person, at such place; and if any such person shall neglect to make or cause to be made such entry, then service of such rule or proceeding may be affected by affixing a copy thereof to some conspicuous part of the court house, or in such other manner as the court may direct.

XXXVI. *What effect Act VI. of 1856 to have.* Act VI. of 1856 shall be of the same force and effect in respect to every petition and specification filed under the provisions thereof before the Act was repealed, and in regard to all proceedings consequent thereon or in relation thereto, and for the purpose of everything done under that Act while it continued in force, as if previously to the passing of the said Act the sanction of Her Majesty to the passing thereof had been obtained and signified in pursuance of the statute passed in the seventeenth year of the reign of Her Majesty, entitled "An Act to provide for the Government of India," and as if the said Act had not been repealed, and the term of every exclusive privilege obtained under the said Act is hereby extended, and shall continue until the expiration of fourteen years from the time of the passing of this Act. No exclusive privilege obtained under the said Act by an importer, not being the actual inventor, shall cease to have effect by virtue of the provisions of section XVI. of the said Act, if the invention be put in practice in India within the period of two years from the time of the passing of this Act.

XXXVII. *Stamp on petition.* Every petition for leave to file a specification under the provisions of this Act, or for the extension of the term of an exclusive privilege, shall be written or printed on stamped paper of the value of one hundred rupees.

37a. *Whenever by any law for the time being in force in the United Kingdom, any person shall be entitled in the United Kingdom to an exclusive right in any pattern or design or the application of such pattern or design to any substance or article of manufacture, such person shall be entitled in British India to the sole and exclusive right in such pattern or design or in such application thereof, and shall be entitled in British India to the same civil remedies in respect of infringement thereof in British India as those to which he would be entitled in the United Kingdom in respect of the infringement thereof in the United Kingdom.*

[NOTE.—This clause was introduced by Act No. 13 of 1872.]

XXXVIII. *Interpretation.* In the construction of this Act,

the following words and expressions shall have the meanings hereby assigned to them, unless there be something in the subject or context repugnant to such construction. *Number.* Words importing the singular number shall include the plural number, and words importing the plural number shall include the singular number. *Gender.* Words importing the masculine gender shall include females. "*Invention.*" The word "invention" shall include an improvement. "*Manufacture.*" The word "manufacture" shall be deemed to include any art, process, or manner of producing, preparing, or making an article, and also any article prepared or produced by manufacture. "*Printed.*" The word "printed" shall include "lithographed." "*Inventor*" and "*Actual inventor.*" The words "inventor" and "actual inventor" shall include the executors, administrators, or assigns of an inventor or actual inventor, as the case may be. "*Assigns.*" The word "assigns" shall include grantees of the sole use or benefit in India of an invention, or of the sole use of an exclusive privilege for a limited time. "*India.*" The word "India" shall mean the territories which are or may become vested in Her Majesty by the statute 21 and 22 Vict. c. 106, entitled "An Act for the better Government of India." "*Governor General in Council.*" The words "Governor General in Council" shall include the "President in Council." "*Secretary to the Government of India.*" The words "Secretary to the Government of India" shall include any under-secretary to the said Government. "*Her Majesty's Courts of Judicature.*" "*Courts of Judicature.*" The expressions "Her Majesty's Courts of Judicature" and "Courts of Judicature" shall mean the courts established by Royal Charter.

SCHEDULE OF FORMS.

FORM OF PETITION.

(See Section 1.)

To the Governor General of India in Council.

The petition of [*here insert name, addition, and place of residence*] for leave to file a specification under Act No.

Sheweth,

That your petitioner is in possession of an invention for [*state the title of the invention*], which invention he believes will be of public utility; that he is the inventor thereof [*or, as the case may be, the assignee or executor or administrator of the*

inventor]; and that the same is not publicly known or used in India or in any part of the United Kingdom of Great Britain and Ireland, to the best of his knowledge and belief.

The following is a description of the invention [*here describe it*].

Your petitioner therefore prays for leave to file a specification of the said invention pursuant to the provisions of Act No.

And your petitioner, &c.

The day of

(Signed)

FORM OF DECLARATION TO ACCOMPANY PETITION.

(See Section 7.)

I [*here insert name, addition, and place of residence*] do solemnly and sincerely declare that I am in possession of an invention for [*state the title of the invention as in the petition*]; that I believe the said invention will be of public utility; that I am the inventor thereof [*or, as the case may be, the assignee or executor or administrator of the inventor*]; and that the same is not publicly known or used in India or in any part of the United Kingdom of Great Britain and Ireland to the best of my knowledge and belief; and that, to the best of my knowledge and belief, my said invention is truly described in my petition for leave to file a specification thereof.

The day of

(Signed)

FORM OF DECLARATION TO ACCOMPANY SPECIFICATION.

(See Section 7.)

I [*here insert name, addition, and place of residence*] do solemnly and sincerely declare that I am in possession of an invention for [*state the nature of the invention*], which invention I believe will be of public utility; that I am the inventor thereof [*or, as the case may be, the assignee or executor or administrator of the inventor*]; and that the same is not publicly known or used in India or in any part of the United Kingdom of Great Britain and Ireland, to the best of my knowledge and belief; and that, to the best of my belief, the instrument in writing under my hand hereunto annexed particularly describes and ascertains the nature of the said invention and in what manner the same is to be performed.

The day of

(Signed)

FORM OF DECLARATION BY AGENT, WHERE AN INVENTOR IS ABSENT FROM INDIA.

(See Section 7.)

I , of , do solemnly and sincerely declare that I have been appointed by the said , his agent for the purpose of ; and I verily believe that the declaration purporting to be the declaration of the said , marked (), was signed by him, and that the contents thereof are true.

The day of

(Signed)

FORM OF PETITION.

(See Section 20.)

That your petitioner [*or, as the case may be, that A. B., of whom your petitioner is the assignee or executor or administrator*] has obtained Her Majesty's letters patent dated the day of , for [*state the title of the invention*], and that such letters patent are to continue in force for years, that your petitioner believes that the said invention is not now and has not hitherto been publicly known or used in India.

The following is a description of the invention [*here describe it*].

Your petitioner therefore prays for leave to file a specification of the said invention, pursuant to the provisions of Act No.

And your petitioner, &c.

The day of

(Signed)

From *Carpm. Pat. L. of World*, 267.

INTERNATIONAL CONVENTION.

See close of Vol. II.

IRELAND.

See GREAT BRITAIN AND IRELAND.

ISLE OF MAN.

See GREAT BRITAIN AND IRELAND.

ITALY.

[NOTE.*—*The Italian Law and Regulations of the 31st of January, 1864, extended the Sardinian Law of the 30th October, 1859, to the whole Kingdom of Italy. Certain sections were repealed, and all matters concerning patents were placed under the direction of the minister of agriculture, industry and commerce. The following is the law thus amended, transitory provisions being omitted.*]

PART I.

RIGHTS DERIVED FROM INVENTIONS OR INDUSTRIAL DISCOVERIES,
AND TITLE THERETO.

CHAPTER I.

Rights of Inventors.

ART. 1. The author of a new invention or discovery in industry has the exclusive right of working the same for his own profit during the time, within the limits, and under the condition, prescribed by the present decree.

This exclusive right constitutes a patent privilege.

ART. 2. An invention or discovery is said to belong to industry whenever the immediate object is,—

1. A product or result relating to industrial pursuits;
2. An instrument, machine, tool, engine, or any mechanical arrangement;
3. A process or method of manufacture;
4. A motor, or the application of any known power to industrial purposes;
5. Finally, the technical application of a scientific principle, provided immediate results in industry are obtained thereby.

In the latter case the patent is limited solely to those results which are expressly pointed out by the inventor.

ART. 3. An invention or discovery in industry shall be considered as new when not before known; or even when a general notion of it existed, without the particulars necessary for putting it into practice.

* Notes thus printed are from Carpmacel's edition.

ART. 4. A new invention or discovery in industry already patented abroad, although it may have been published pursuant to the provisions of foreign legislation, confers on its author, or on his assigns, the right of obtaining a patent in the kingdom, provided such patent be applied for before the expiration of the term of the foreign patent, and before other parties have freely imported and worked the same invention or discovery in the kingdom.

ART. 5. Any modification of a patented invention or discovery gives the right to a further patent, but without prejudice to the patent which already exists for the original invention.

ART. 6. The following are not patentable:—

1. Inventions or discoveries relating to trades which are contrary to law, morals, or public safety;
2. Inventions or discoveries not relating to the manufacture of material objects;
3. Inventions or discoveries of a mere theoretical nature;
4. All kinds of medicines.

CHAPTER II.

Patents, their Force and Duration, and the Fees to be paid.

ART. 7. The legal title to the exclusive use of an invention is contained in a certificate [patent] delivered by the government.

The patent does not guarantee the utility or reality of the invention or discovery as claimed by the petitioner, nor does it prove the existence of those properties which, according to law, an invention or discovery must possess in order to render the patent valid.

ART. 8. Patents granted for new articles comprise the exclusive right of manufacturing and selling such articles.

Patents obtained for the application to any branch of industry of a chemical agent, process, method, instrument, machine, tool, apparatus, or mechanical arrangement of any kind which has been invented or discovered, confer on their holders the right of preventing others from making a like application.

But whenever the patentee himself has supplied to others the preparations or mechanical means whose exclusive use forms the subject of his patent, it is to be presumed that he has at the same time given to them the permission to use them, provided there exists no agreement to the contrary.

ART. 9. The patentee, and those interested through him, may

obtain a certificate of addition for any modification made by them in the original discovery or invention. Such certificate extends the effect of the patent to the modification for the whole term of the patent.

ART. 10. Patents take effect with respect to third parties from the date and in the order of application.

The duration of a patent can never exceed fifteen years, nor be less than one year, always reckoning from the last day of one of the months of March, June, September, or December, whichever next follows the day whereon the application is made, no account being taken of any fraction of a year.

ART. 11. The duration of a patent for an invention or discovery already patented abroad shall not exceed that of the foreign patent having the longest term, nor in any case shall the duration exceed fifteen years.

ART. 12. Patents granted for less than fifteen years may be prolonged for one or more years; the duration, however, of the prolongation added to the duration of the original patent shall in no case exceed fifteen years.

ART. 13. The prolongation of a patent includes the certificates of addition.

ART. 14. Patents granted in respect of applications made after the publication of the present decree, shall take effect in the whole territory of the kingdom, and be subject to a proportional tax, payable at the time of the application, and to an annual tax.

The proportional tax shall consist of as many times ten lire as there are years in the duration of the patent applied for.

The annual tax shall be 40 lire for the first three years, 65 lire for the following three years, 90 lire for the seventh, eighth, and ninth years, 115 lire for the tenth, eleventh, and twelfth years, and 140 lire for the remaining three years.

ART. 15. The first annuity and the proportional tax are to be paid at the time of the application for a patent.

The other annuities are to be paid in advance on the first day of each year of the duration of the patent, and shall likewise be subject to the triennial increase in the case of a prolongation of the patent.

ART. 16. The delivery of a certificate of addition shall be subject only to the payment in advance of twenty lire.

ART. 17. Certificates of prolongation shall be subject to the payment of 40 lire, besides the proportional tax and annuities. The

annuity corresponding to the first year of the prolongation shall be paid at the time of application, and the subsequent annuities shall be paid in advance, conformably to article 15.

ART. 18. In cases of patents of importation, whose term ends with that of the foreign patent, every fraction of a year is to be considered as an entire year with respect to the payment of the tax.

PART II.

CONDITIONS AND FORMALITIES ATTENDANT ON APPLICATIONS FOR PATENTS.

CHAPTER I.

The Application and its Conditions.

ART. 19. All matters concerning patents are placed under the direction of the minister of agriculture, industry and commerce.

ART. 20. All applications for patents must be made to the minister of agriculture, industry and commerce, through the local prefecture or subprefecture.

The application must be made by the inventor or his attorney, and must contain,—

1. The name and christian name, as well as the birth-place and residence of the applicant, and of his attorney, if there be one ;

2. A statement of the discovery or invention in the form of a title which expresses shortly, but with precision, its characteristics and scope.

3. A statement of the duration which the applicant desires to be assigned to his patent within the limits fixed by law.

An application must be limited to one patent, and to one invention or discovery.

ART. 21. Every application must be accompanied by,—

1. The description of the invention or discovery ;

2. The drawings, if any can be made, as well as the models, which the inventor may deem useful for the comprehension of his invention or discovery ;

3. The receipt for the payment into the public treasury of the fees due for the required patent ;

4. In cases of patents of importation, the original foreign patent, or a legalized copy of the same ;

5. If there be an attorney, the power in public or private form; provided that in the latter case the signature of the principal is certified by a public notary, or by the syndic of his place of residence;

6. A memorandum of the documents and objects delivered.

ART. 22. The description mentioned in the foregoing article is to be written in the Italian or French language, and must contain a clear and complete account of the details necessary for enabling a competent person to put the invention or discovery into operation.

The application must be accompanied by three copies of the description and drawings, the applicant alone being responsible for the conformity of these copies.

Whenever the description is accompanied by a model, the applicant is not exempt from annexing to the application, a drawing, or drawings, in duplicate of the entire model, or at least of those parts which constitute the invention.

ART. 23. During the first six months of the duration of a patent, reckoning from the last day of the March, June, September, or December next after the date of application, proprietors of patents may require the same to be reduced to part of the invention forming the subject of the description annexed to the original application, distinctly pointing out those parts they intend to disclaim.

The parts disclaimed shall be considered as having never been comprehended in the patent.

ART. 24. Applications for disclaimers must be accompanied by—

1. The receipt for the payment of 40 lire;

The description in triplicate to be substituted for that previously filed;

3. The drawings in triplicate which it may be necessary to substitute for those previously filed.

ART. 25. The certificate delivered on such applications shall be called certificates of reduction [disclaimers], and their duration shall be that of the original patent.

ART. 26. During the six months mentioned in article 23, a patent for a modification shall only be granted to the author of the patented invention or discovery, or to those interested through him. The applications of other persons for such certificates and the accompanying documents are to be delivered under sealed covers, and deposited as hereinafter stated.

At the expiration of the six months the seal shall be broken, and the patent shall be delivered, unless the interested party notifies his intention to withdraw the application, in which case the fees paid shall be returned to him.

The patent thus granted shall take effect relatively to patents of addition, from the day after the expiration of the six months; but with respect to persons not interested in the original patent and applications founded thereon they shall take effect from the date of application.

ART. 27. An application for a certificate of addition shall not mention any term for its duration.

In other respects the provisions of the twentieth and following articles shall be observed.

ART. 28. Applications for prolongations must be accompanied by—

1. The deed proving the ownership of the patent sought to be prolonged;

2. The receipt for the payment of the fees mentioned in article 17.

3. The power of attorney and memorandum mentioned in paragraphs 5 and 6 of article 21.

CHAPTER II.

Delivery of the Application and accompanying Documents.

ART. 29. Applications of all sorts, with the documents and objects which may or ought to accompany the same, must be delivered, in Turin, at the office appointed by the minister, elsewhere at the prefecture.

ART. 30. The public officer appointed to receive the application shall draw up a report, stating the day and hour of the delivery, and the object of the application.

The official report must show the real or elected domicile of the applicant or his attorney in the town where the delivery takes place, otherwise the municipality shall be legally considered as the elected domicile.

ART. 31. With regard to the applications mentioned in article 26, the official report must contain the statement of the applicant, that he wishes to obtain in due time a patent for a modification in an original invention or discovery, as described in the specification

under sealed cover, the title of which original invention shall be mentioned in the official report.

ART. 32. Each such official report shall be recorded in a special register and be signed by the applicant or his attorney.

A copy of such official report shall be delivered to the applicant without charge, except for the stamp on the paper on which it is written.

ART. 33. Within the five days following, the documents and objects left at the provincial offices, shall be transmitted to the ministry of agriculture, industry and commerce, at the same time there shall be sent an unstamped copy of the official report.

ART. 34. All official reports from the provinces shall be copied into the registers of the Ministry.

ART. 35. If the legal formalities have been fulfilled, the applications shall be registered with the date of presentation, and the patents shall be granted.

ART. 36. Each patent shall be recorded in the register and signed by the chief of the office.

A copy, signed as aforesaid, shall be delivered to the interested party, together with one of the originals of the drawings, description and memorandum, initialled on each sheet by the said officer. This first copy of the patent shall be delivered free of cost; all other copies shall bear the consecutive number of the delivery, and for each 15 lire shall be paid.

ART. 37. With regard to inventions and discoveries relating to all kinds of beverages or eatables, the said office shall transmit the description and other related documents to the superior board of health, to obtain its advice before delivering a patent.

ART. 38. If the board of health advise that the invention or discovery is injurious to health, or if there be the least doubt about it, the application for a patent shall be rejected.

If the advice be favorable, the following clause shall be inserted in the patent: "The superior board of health having been consulted."

Such patents do not exempt their holders who but practice the invention from fulfilling all other provisions of the sanitary laws.

ART. 39. Patents shall be refused:—

1. If the invention or discovery belong to one of the four classes mentioned in article 6;

2. If there is no written application, or if, in the application, the title of the invention or discovery is wanting;

3. If there be no description ;

4. If a single patent is demanded for different inventions or discoveries, or if several patents of the same nature or of different kinds are demanded in the same application ;

5. If the fees paid do not correspond with the kind of patent applied for.

ART. 40. The grant of the patent shall be suspended in default of the fulfillment of any of the other conditions prescribed by the present decree, or when the description does not present the required features.

ART. 41. The refusal or suspension, and the reasons which have determined the same, shall be communicated to the applicant or his attorney, through one of the government officers, and by a notice left at his elected or real domicile, mentioned in the official report of the deposit.

ART. 42. Within fifteen days after such notice, the applicant or his attorney, may supply the deficiencies or appeal against the refusal or suspension.

The documents intended to supply such deficiencies, or the notices of appeal, shall be left at the provincial, or chief office. An official report of the same shall be drawn up, and a stamped copy thereof be delivered to the interested party without any other charge than the stamp duty.

If within this term of fifteen days no documents have been deposited, and no appeal been lodged, the application shall be considered as not having taken place, the inventor preserving the right to renew his application.

ART. 43. The minister shall submit these appeals to a commission composed of fifteen members, three of whom shall be magistrates for life, or members of the faculty of law at the Royal University of Turin, and the remaining twelve chosen from:—

1. The members of the section of physical and mathematical sciences at the Royal Academy of Sciences ;

2. The professors and doctors of the faculty of said sciences at the Royal University ;

3. The professors at the Polytechnic schools.

The members of the said commission shall be nominated every year by the minister.

The commission shall be divided into three sections (mechanics, physics, and chemistry), each of which sections shall be composed of one legal member and four technical members.

Each appeal shall be heard by that section which corresponds with the nature of the patent applied for.

If the verdict of the section is not obtained unanimously, it shall be revised by the whole commission.

If it relates to an invention deemed contrary to law, morals or public safety, the public prosecutor shall be consulted, and his opinion shall be submitted to the commission which hears the appeal.

ART. 44. Appeals shall be considered as null and void unless they be accompanied by the deposit of 50 lire.

ART. 45. If the verdict mentioned in article 43 is in favor of the applicant, the appointed officer shall deliver the patent and return the deposit mentioned in the foregoing article.

In the contrary case the patent shall be positively refused, and the deposit shall be paid into the treasury.

PART III.

ASSIGNMENTS OF PATENTS.

ART. 46. Assignments of patents must be registered at the ministry, and published in the Official Gazette of the kingdom at the expense of the applicant.

Assignments take effect with respect to third parties only from the date of registration.

To effect this registration, the person in whose favor the assignment has been made must produce the deed and two memoranda on stamped paper, containing—

1. The name, christian name, and domicile of both the assignor and assignee;
2. The date and nature of the deed presented, and the name of the notary who received it, in case of its being a public act;
3. The date of registry, if any;
4. An exact statement of the rights assigned;
5. The date of delivery of these notes, which shall be that of the registration.

ART. 48. Such deliveries may be made either at a provincial office or at the chief office.

In either case the deed shall be returned to its owner after having been *visé* for registration and signed by the secretary or head of the office.

At the provincial office, where delivery takes place, there shall

be transcribed in a special register, the contents of the memoranda mentioned in the preceding article and one memorandum shall be returned and the other shall be transmitted immediately to the chief office.

At the latter office all these memoranda, whether received directly or transmitted from the provinces, shall be recorded and kept.

ART. 49. The total assignment of patent rights to a single person obliges the latter to pay the fees; if the assignment is made to several persons collectively, they are conjointly bound to make that payment. In case of a partial assignment to several distinct persons, or a partial alienation of the rights, the deed relating thereto cannot be registered unless it be accompanied by a receipt, proving the payment of the annuities due for the whole duration of the patent.

PART IV.

PRESERVATION AND PUBLICATION OF DOCUMENTS RELATING TO PATENTS.

ART. 50. The registers for recording patents, their progressive stages, annulments, disclaimers, forfeitures, and expirations; and the registers in which are inscribed assignments of patent rights, are public registers.

ART. 51. Whoever requires extracts therefrom must make an application on stamped paper; and the extracts shall be written on stamped paper at the expense of the applicant.

ART. 52. A copy of the specification and drawings shall be deposited at the chief office, but no person shall be allowed to inspect the same before the expiration of three months from the delivery of the patent.

Any person may, after the lapse of three months, inspect the description, drawings, and models, and make, at his own expense, one or several copies, in the manner and under the conditions determined by regulations.

ART. 53. Every three months a list of the patents delivered during the preceding quarter shall be published in the Official Gazette.

ART. 54. Every six months the specifications and drawings

relating to inventions and discoveries patented during the preceding half-year shall be published in full.

The head of the office may, nevertheless, order that certain specifications shall be published only in the form of extracts, examined and deemed sufficient by him for the comprehension of the invention to which they relate. The drawings, likewise, may be reduced to their essential parts.

ART. 55. A copy of the subject-matter, indexes, descriptions and drawings published, shall be transmitted to each provincial office and chamber of commerce for public inspection.

PART V.

NULLITY AND ANNULMENT OF PATENTS.

CHAPTER I.

Causes of Nullity and Annulment.

ART. 56. The preliminary examination and adjudication does not guarantee validity.

ART. 57. Patents are null and void,—

1. If they refer to inventions or discoveries mentioned in article 6.

2. If they relate to one of the inventions or discoveries mentioned in article 37, and the patent has by mistake been delivered against the advice of the sanitary authority. If granted in error without consulting the aforesaid authority, the patent will become void when the advice on being taken is adverse.

3. If by the fraud of the applicant the title of the invention or discovery indicates other than its real object.

4. If the description annexed to the application is insufficient, or conceals some of the means necessary for working the patent invention or discovery.

5. If the invention or discovery is not new, or does not relate to industrial pursuits.

6. If a patent is granted to a third party for a modification in an invention within the six months allowed to the original inventor, and persons interested through him.

7. A certificate of addition is also null and void whenever the modification is not connected with the original invention.

8. A prolongation is likewise null and void whenever it has been

applied for after the expiration of the patent, or after its absolute annulment has been pronounced.

ART. 58. A patent ceases to be valid,—

1. If in a single instance the annual tax is not paid within the term of three months from the date of expiration.

2. If in the case of a patent granted for five years or less, the invention or discovery has not been worked within the first year of the grant, or has ceased to be worked during a whole year.

3. If in the case of a patent granted for more than five years, it has not been worked before the expiration of the second year, or if the working has been discontinued for two years.

In either case the patentee shall not forfeit his rights if his inaction arose from causes beyond his control. The want of pecuniary means is not included in these causes.

CHAPTER II.

Actions for Nullity and Annulment.

ART. 59. The action to obtain a declaration of nullity or to annul a patent is brought before the provincial tribunal.

The cause is to be proceeded with and decided by summary process.

The documents are to be communicated to the public prosecutor.

ART. 60. If at the instance of interested parties the partial nullity or annulment of a patent has been twice pronounced, the public prosecutor of the place, or one of the places where the invention or discovery is worked, may demand, *ex officio*, the absolute and peremptory annulment of the patent.

The same power belongs to him without any civil action having been brought in all cases coming under the provisions of paragraphs 1, 2, 3, and 8 of articles 57 and 58.

In the two annulments mentioned in the first paragraph of the present article there shall not be reckoned any that apply to those parts of the invention or discovery which have been cut out by disclaimer within the term of six months accorded by the present law.

ART. 61. In each of the two cases mentioned all persons are to be summoned who have a legal interest in the patent, and who are entered in the register of the chief office.

ART. 62. Except the case mentioned in paragraph 8 of article

57, the court, before pronouncing the annulment, must, on the demand of one of the parties, take the advice of three experts; and in case of appeal, the revision of such an opinion must be ordered whenever one of the parties demands it.

In all cases however the tribunal or court of appeal may order *ex officio* an examination, or the revision of an examination.

ART. 63. The public prosecutor is to transmit to the minister of agriculture, industry, and commerce, through the minister of justice, an extract on unstamped paper of judgments declaring nullity or pronouncing absolute annulment. The operative part of these judgments shall be entered in a special register, and be published in the Official Gazette.

PART VI.

Infringement of Patent Rights and Actions relating thereto.

ART. 64. Whoever fraudulently and in contravention to a patent right, manufactures products, uses a machine or any other industrial means, trades in, sells, exposes for sale, or imports into the kingdom infringing articles, commits an offense, which offense shall be punished with a fine not exceeding 500 lire.

ART. 65. Besides in cases where a civil action is carried on conjointly with a penal action, or where it is carried on separately, all machines and other industrial objects used contrary to the patent right, all infringing objects, and the instruments for producing them, shall be seized, to the loss of the infringing party, and given over to the patentee.

The same shall take place with respect to dealers, traders, sellers or importers of infringing articles.

ART. 66. The injured party shall, besides, be entitled to claim damages.

If the owner of the objects mentioned in the preceding article acted with honesty of purpose, he shall only be subject to the loss of these objects to the profit of the injured party.

ART. 67. Civil action shall be carried on in the form prescribed for summary process.

Correctional actions against the offenders mentioned in article 64 can only be carried on at the complaint of the injured party.

ART. 68. The president of the provincial tribunal may, on the demand of the patentee, order the seizure or inventory of the

objects supposed to be infringements, or used contrary to the patent right, provided they be not destined for mere personal use.

By the same order the president shall delegate an officer to execute it, and, if required, can nominate one or more experts to assist the officers in drawing up the inventory.

He, moreover, shall cause the plaintiff to give security before proceeding to seizure.

ART. 69. The plaintiff may, if authorized by the president of tribunal, be present at the seizure or at the drawing up of the inventory. In all cases he may convert the seizure into the taking of an inventory, on condition that he expresses his wish to that effect, either in the official report of the seizure, or in a separate document, notified through a public officer both to the adverse party, and to the executive officer.

ART. 70. A copy of the order of the president, of the deed proving the deposit of the security and of the official report of the seizure or inventory, shall be left with the holder of the objects seized or inventoried.

ART. 71. In default of the plaintiff pursuing his action within a week the seizure or inventory shall be null and void, and the party against whom the proceeding was brought shall be entitled to damages.

From *Carp. Pat. L. of World*, 286.

See also INTERNATIONAL CONVENTION.

JAMAICA.

An Act for amending the Law for granting Patents for Inventions. 1857. Stat. 21 Vict. c. xxx.

Preamble. Whereas it is expedient to amend the law concerning letters patent for inventions :

Be it enacted by the Governor, Legislative Council and Assembly of this Island, &c.

I.—AS TO THE MANNER OF APPLYING FOR AND OBTAINING LETTERS PATENT.

First. Patents for invention may be granted by the Governor on Petition.—Proviso. From and after the publication of this Act, whenever any person whosoever shall, by himself, or if he be an absentee, by his attorney, apply to the Governor, by way of petition, to be lodged at the office of the Executive Committee, and alleging that he hath invented or discovered some new and useful art, machine, manufacture, or composition of matter, not theretofore known or used within this island, or some improvement in any such invention or discovery, and praying to obtain an exclusive property in such new invention and discovery or improvement, and that letters patent be granted for the same, it shall be lawful for the Governor, in the name, and on behalf, of Her Majesty, her heirs and successors, by and with the advice and consent of the Executive Committee, to direct letters patent, under the broad seal of this island, to be issued, which letters patent shall recite the allegations and suggestions of the said petition, so to be referred as aforesaid, and shall therein give a short description of the said invention or discovery or improvement, and thereupon shall grant to such person so applying for the same, his executors, administrators or assigns, for a term not exceeding fourteen years, the full and exclusive right and liberty of making, constructing and using, and vending to others to be used, the said new invention or discovery or improvement; and such letters patent shall be signed by the Governor, and shall be good and available to the grantee therein named by force of this Act ; provided that it shall be lawful for the Governor in Executive Committee, if they should deem it expedient,

to insert in any such letters patent a provision extending the operation thereof for a further term of seven years.

Second. *Petition to be first referred to the Attorney-General, who shall grant his fiat, or certify his refusal.* Before any letters patent shall be signed and issued, the petition, specification, and declaration delivered therewith shall be referred to Her Majesty's attorney-general of this Island, who shall examine the same, and shall be at liberty to call to his aid such scientific or other person as he may think fit, and to cause to be paid to such person, by the applicant, such remuneration as the attorney-general shall appoint, not exceeding five pounds; and if the attorney-general shall be satisfied that the application is such as may properly be granted under the provisions of this Act, and that the specification describes the nature of the invention, discovery, or improvement, he shall allow the same, and give a certificate of his allowance, and return the same petition, specification, and declaration, together with his certificate, into the office of the Executive Committee; and if the attorney-general shall not allow such application, he shall certify to the Governor his reasons for not so doing.

Third. *Petitioner to make declaration that he is the true inventor, &c.* Before any person shall obtain or receive any letters patent under this Act, such person, or if he be an absentee, his attorney, shall make solemn declaration, in writing, before a justice of the peace in this island, that he doth verily believe that he is the true inventor or discoverer of the art, machine, composition of matter, or improvement for which he solicits letters patent, and that such invention or discovery, or improvement hath not, to the best of his knowledge or belief, been known or used in this island, which declaration shall be delivered, together with the petition for such letters patent.

Fourth. *And deliver specification of invention, &c.—Proviso.* Before any person shall receive or obtain any letters patent as aforesaid, such person, or his attorney, shall also deliver, together with such petition and declaration as aforesaid, a written description or specification of his invention, and of the manner of using, or process, or compounding the same, in such full, clear, and exact terms as to distinguish the same from all other things before known or used in this island, 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 case of any machine shall deliver a model thereof, and shall explain the prin-

ciple and the several modes in which such person hath contemplated the application of that principle, or character, by which it may be distinguished from other inventions, and 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 or specification shall be signed by such person, or his attorney, as aforesaid, so applying for such letters patent, and attested by two witnesses: Provided that, where from the complicated nature of any machinery the cost of a model thereof may be so great as to prevent any ingenious but poor persons from obtaining patents for their useful inventions, it shall and may be lawful for the Governor, by and with the advice and consent of the Executive Committee, if they shall see fit and proper under all the circumstances so to do, to dispense with the delivery of such model previous to the granting any such patent; and in such case, the requisitions of this Act being in all other respects complied with, the person applying for any patent shall be entitled thereto in the same manner as if such model had been so lodged as aforesaid.

Fifth. *Five pounds to be deposited by petitioner.* That together with the said petition, the applicant for such letters patent shall pay and deposit a sum of five pounds, to be paid by way of fee to the attorney-general, on such reference of such petition as aforesaid.

Sixth. *Notice to be given of application, in Gazette.* No letters patent shall be granted under or by virtue of this Act until notice shall be published in the Jamaica Gazette by authority, and one other of the newspapers of this colony, for at least four weeks, of the intention of the applicant to apply for such letters patent; and such notice shall contain, in general terms, the description of invention or improvement for which such letters patent shall be desired.

II. LIMITATION OF TIME FOR BRINGING LETTERS PATENT INTO OPERATION.

Seventh.—*Patent must be brought into operation within two years.* If any letters patent, which may be taken out under or by virtue of this Act, shall not have been brought into operation within two years next ensuing from and after the date thereof, such

letters patent shall, at the expiration of the said period of two years, be deemed to be forfeited, and shall thence be and become void and of no effect.

III. AS TO THE SEALING, DATE, TIME OF ISSUE, AND RENEWAL OF LETTERS PATENT.

Eighth. *Patents to be sealed and dated as of the day of application.* It shall be lawful to cause any letters patent to be issued, under this Act, to be sealed, and bear date, as of the day of the application for the same, or where the attorney-general, or the governor in executive committee may think fit, any such letters patent as aforesaid may be sealed and bear date as of the day of the sealing thereof, or of any other day, between the day of such application and the day of such sealing.

Ninth. *And be of legal force.* Any letters patent issued under this Act, sealed and bearing date as of any day prior to the day of the actual sealing thereof, shall be of the same force and validity as if they had been sealed on the day as of which the same are expressed to be sealed and bear date.

Tenth. *They must be applied for within three months after filing of petition.* Provided that no letters patent, save in the case of letters patent destroyed or lost, shall issue, unless the same shall be applied for within three months after the date of the filing of the applicant's petition.

Eleventh. *And in case of death of applicant, within three months after his death.* Provided that, where the applicant for letters patent dies during the pendency of his application, such letters patent may be granted to the executors or administrators of such applicant at any time within three months after his death, and the letters patent so granted shall be of the like force and effect as if they had been granted to such applicant during his life-time.

Twelfth. *Patents lost or mislaid may be renewed.* Provided that in case any letters patent to be issued under this Act shall be destroyed or lost, other letters patent, of the like tenor and effect, and sealed and dated as of the same day, may, subject to such regulations as the governor in executive committee may direct to be issued, under the authority of the grant in pursuance of which the original letters patent were issued.

Thirteenth. *Patents obtained by fraud not to invalidate that of true inventor.* In case of any letters patent for any invention being

obtained in fraud of the true and first inventor, any letters patent granted to the true and first inventor of such invention shall not be invalidated by reason of such other letters patent as aforesaid, or of any use or publication of the invention, subsequent to the granting of such other letters patent as last mentioned.

IV. MUTUAL RIGHTS IN INVENTION, AND IN ANY IMPROVEMENT THEREIN.

Fourteenth. *Patents granted for improvements; how mutual rights to be regulated.* Where any letters patent shall be obtained by any person under this Act for any new and useful invention or discovery in any art, machine, or composition of matter, and thereafter any other person shall discover or make any improvement in the principle or process of any such art, machine, or composition of matter for which such patent hath been granted, and shall make application for and obtain letters patent under this Act for the exclusive right of such improvement, it shall not be lawful for the person who shall obtain and procure letters patent for any such improvement to make, use, or vend the original invention or discovery, nor for the person who shall have procured letters patent for the original invention or discovery to make, use, or vend any such improvement; provided that simply changing the form or the proportions of any machine or composition of matter, in any degree, shall not be deemed a discovery or improvement within the meaning of this Act.

V. RIGHT OF PATENTEE ELSEWHERE TO PROCEED UNDER THIS ACT FOR LETTERS PATENT.

Fifteenth. *Applicant may receive a patent in this island although he may possess a patent elsewhere.—Proviso.* No applicant shall be deprived of his right to a patent in this colony, upon the like proceedings being had in all respects as in case of an original application for his invention, by reason of his having previously taken out letters patent therefor in any other country: Provided that such invention shall not have been introduced into public and common use in this colony prior to the application for a patent therein, and that the patent granted in this colony shall not continue in force after the expiration of the patent granted elsewhere, and that where more than one such patent or like privilege is obtained abroad, then,

immediately upon the expiration or determination of the term which shall first expire or be determined of such several patents or like privileges, the patents granted in this colony shall cease to be in force: Provided further, that no letters patent for or in any respect of any invention for which any such patent or like privilege as aforesaid shall have been obtained elsewhere, and which shall be granted in this colony after the expiration of the term for which such patent or privilege was granted, or was in force, shall be of any validity.

VI. POWER OF ASSIGNMENT.

Sixteenth. *Patentees may assign their rights.* Any patentee under letters patent issued under this Act, his executors, administrators, or assigns, may assign and transfer [the whole or] any part of his right, title and interest in the said invention and discovery in the letters patent to him granted, to any person whomsoever, and the assignee thereof, having recorded the said assignment in the office of the island secretary, shall thereafter stand in the place and stead of the original patentee, as well as to all or the part assigned of the right, privilege, and advantage, as also in respect of all or proportionate liability or responsibility as to the said letters patent, and the invention and discovery thereby secured; and in like manner shall the assignees of any such assignee stand, and be considered to be in the place and stead of the original patentee or inventor.

VII. RIGHT OF ASSIGNEE OF PATENTEE ELSEWHERE TO APPLY UNDER THIS ACT FOR LETTERS PATENT.

Seventeenth. *Rights of assignees.—Proviso.* Letters patent may, upon the like proceedings being had in all respects as in the case of an original application, be issued by the Governor in Executive Committee to the assignee of any person who may have taken out letters patent for his invention or discovery in any other country, but not for any invention or discovery made abroad for which no letters patent have been there obtained: Provided, that the invention or discovery so assigned shall not have been introduced into public and common use into this colony prior to the application for a patent; and that the assignee of such foreign patent shall file with his application the assignment duly proved, under which he claims a patent in this colony, and an affidavit setting forth the date of the

patent abroad, that the article thereby patented has not been in public and common use in this colony, and that he is the assignee for a good consideration.

VIII. AS TO CLAIM FOR LARGER INVENTION THAN ACTUALLY INVENTED, OR DEFECTIVE OR INSUFFICIENT SPECIFICATION.

Eighteenth. *Patents to be valid in law only for so much as shall be proved to be of new invention.* If in any suit or action it shall be proved, or specially found by the verdict of a jury, that by mistake, accident, or inadvertence, and without any willful default or intent to defraud or mislead the public, a patentee under this Act shall in his specification have claimed to be the original and first inventor or discoverer of any material or substantial part of the thing patented, but of which part he was not the original or first inventor, and shall have no just or legal right to claim the same, his patent in such case shall be deemed good and valid for so much of the invention or discovery or improvement as shall be actually his own, provided it is a material and substantial part of the thing patented, and be plainly distinguishable from other parts patented without right; and every such patentee, and his legal representatives or assignees, whether holding the whole or a particular interest in the patent, may maintain suits at law or in equity for any infringement of such part of the same as is actually the invention or discovery of such patentee, although his specification may embrace more than he has a legal right to claim; but if in such case the plaintiff shall obtain a verdict or judgment, he shall not be entitled to costs, unless before the commencement of the suit he shall have filed in the office of the island secretary a disclaimer, attested by one or more than one witness, of that part of the thing patented which was claimed without right: Provided, that no person bringing a suit shall be entitled to the benefits of this section, if he shall, in the opinion of the court before which any such matter shall be tried, have unreasonably neglected or delayed to record his disclaimer.

Nineteenth. *Patents void by defective description, arising from error, may be renewed.* If any patent shall become 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 a right to claim; and the error has arisen from inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, it shall be lawful for the

Governor in Executive Committee, upon the surrender of such patent, and upon petition therefor, cause a new patent to be issued to the patentee for the residue of the term mentioned in the first patent, in accordance with the patentee's amended description and specification; in case of his death, or the assignment by him of the original patent, or any fractional interest therein, the right shall vest in his legal representatives to the extent of their respective interests in such patent; and the patent so reissued, together with the amended description and specification, shall have the same effect and operation in law as though the same had been originally filed in such amended form before the the issuing of the original patent.

IX. AS TO MODE OF ENTERING DISCLAIMERS AND ALTERATIONS OR ADDING TO SPECIFICATIONS.

Twentieth. *Disclaimers of any part of patents may be recorded.*—*Proviso.* Every patentee under this Act, or his legal representative or assignee, whether holding the whole or any particular interest, may conjointly or separately, as the case may require, enter and record at the island secretary's office, having first obtained the leave of Her Majesty's attorney's general, certified by his fiat and signature, a disclaimer of any part of either the title of the invention or improvement, or of the specification, stating the reason for such disclaimer, or may, with such leave as aforesaid, enter and record at the said office a memorandum of any alteration in the said title or specification, not being such disclaimer or such alteration as shall extend the exclusive right granted by the said letters patent; and such disclaimer or memorandum of alteration being recorded by the said island secretary, shall be deemed and taken to be part of such letters patent or such specification in all courts whatever: Provided, that any person may enter a caveat at the said office of the island secretary against such disclaimer or alteration, which caveat being so entered, and a copy thereof being left with the attorney-general, shall give the party entering the same right to have notice of the application being heard by the attorney-general: Provided also, that no such disclaimer or alteration shall be receivable in evidence in any action or suit (save and except in any proceeding by scire facias) pending at the time when such disclaimer or alteration was entered; but in every such action or suit the original title and specification alone shall be given in evidence, and deemed and taken to be the title and specification of

the invention for which the letters patent have been or shall have been granted: Provided also that it shall be lawful for the attorney-general, before granting such fiat, to require the party applying for the same to advertise his disclaimer or alteration in such manner as to such attorney-general shall seem right, and shall, if he so require such advertisement, certify in his fiat that the same has been duly made.

Twenty-first. *How costs on alteration or disclaimer to be paid.* It shall be lawful for the attorney-general, if he see fit, by certificate under his hand, to order by or to whom the costs of any hearing or inquiry for any such alteration or disclaimer shall be paid, and in what manner and by whom such costs are to be ascertained; and if any costs so ordered to be paid, be not paid within four days after the amount thereof shall be so ascertained, it shall be lawful for the attorney-general to make an order for the payment of the same, and every such order may be made a rule of the supreme court of this island.

Twenty-second. *Additions may be made to specification.* If an original patentee shall be desirous of adding a description and specification of an improvement upon his original invention or discovery, made or discovered by him subsequent to the date of his patent, he may upon the like proceedings being had in all respects [as] in the case of an original application, have the same annexed to his original description and specification; and the island secretary shall certify, upon such annexed description and specification, the time of its being annexed and recorded, and thereafter it shall have the same effect in law as if it had been embraced in the original description and specification, and had been recorded therewith.

X. AS TO FILING AND RECORDING PROCEEDINGS, OFFICE COPIES, DRAWINGS, &c.

Twenty-third. *How petitions, to be presented and filed.--Proceedings thereon to be recorded.* Every petition for the grant of letters patent under this Act, and the declaration and specification required to accompany such petition, and every certificate or warrant thereon, shall be left at the office of the Executive Committee, and the day of the delivery of every such petition, declaration, and specification, certificate, or warrant, and the date of every reference,

shall be indorsed or written thereon respectively by the secretary of the Executive Committee, and an acknowledgment of receipt therefor, either separately or together, as the same may be delivered, shall be given to the petitioner or person delivering the same respectively, or his agent ; and all such petitions, declarations, and specifications, references, certificates, or warrants, when letters patent shall be granted, and all letters patent, disclaimer, and memoranda of alteration and assignments, shall be lodged, filed, and preserved in the office of the secretary of this island, and shall be there recorded in or in continuation of the books of records of patents hitherto kept at such office, and a receipt therefor shall be given by the island secretary, and a registry of such petitions, declarations, specifications, references, certificates, warrants, letters patent, disclaimers, and memoranda of alteration, and of all proceedings thereon, shall be kept at such office ; and for recording every such petition, declaration, specification, reference, certificate, or warrant, letters patent, disclaimer, and memorandum of alteration, and for every receipt granted therefor, as aforesaid, there shall be paid to the island secretary, by the person lodging the same, the like respective fee, or at the like rate, as is payable in the case of every deed recorded in the said office, and as is payable for every receipt granted by the island secretary for every deed there recorded.

Twenty-fourth. *Office copies may be obtained from island secretary.* It shall and may be lawful for any person to obtain and receive from the office of the island secretary, any copy or copies, certified by him, of any such letters patent, or of the petition, declaration, specification, reference, certificate, or warrant, wherever the same were granted or issued, or of any disclaimer, memorandum, document, or paper connected therewith, or any drawing relating to the same, on payment for such copy or copies of the like fees as are now payable at the office of the island secretary for copies of other documents, and every such certified copy shall be evidence in all courts.

Twenty-fifth. *Drawings connected with specifications to be furnished and bound up.* In case reference is made to drawings in any specification deposited or filed under this Act, an extra copy of such drawings shall be left with such specification, and the same shall be bound up in a suitable book, to be kept for such purpose, and plain, accurate, and sufficient notes of reference to the specification wherewith such drawing shall have been deposited shall be made on or annexed to such drawings, and bound up with the

same, in such manner as that such reference may be easily seen and understood.

Twenty-sixth. *Island secretary to supply indexes to the records of patents, &c.* The island secretary shall cause indexes to all petitions, declarations, specifications, letters patent, disclaimers, and memoranda of alterations enrolled or recorded as aforesaid, to be prepared in the form of the indexes now used in the said office; and such indexes and the books of record of such documents respectively shall be open to the inspection of the public at the usual times, and on payment of the usual fees, in cases of searches or reference to other records at the said island secretary's office.

XI. AS TO PLEADINGS AND COSTS IN ACTIONS.

Twenty-seventh. *In action for infringement, particulars of breaches to be delivered.—Particulars of objections on scire facias to repeal.—Proviso.* In any action for the infringement of letters patent, the plaintiff shall deliver with his declaration, concise particulars of the breaches complained of in the said action, and the defendant on pleading thereto shall deliver with his plea, and the prosecutor in any proceedings by scire facias to repeal letters patent, shall deliver with his declaration, concise particulars of any objections on which he means to rely at the trial in support of the pleas in the said action, or of the suggestions of the said declaration in the proceedings by scire facias, and at the trial of such action or proceeding by scire facias, no evidence shall be allowed to be given in support of any alleged infringement, or of any objection impeaching the validity of such letters patent, which shall not be contained in the particulars delivered as aforesaid: Provided that the place or places at or in which and in what manner the invention is alleged to have been used or published prior to the date of the letters patent shall be stated in such particulars: Provided also, that it shall and may be lawful for any judge at chambers to allow such plaintiff, or defendant, or prosecutor respectively to amend the particulars delivered as aforesaid upon such terms as to such judge shall seem fit; Provided also, that at the trial of any proceeding by scire facias to repeal letters patent, the defendant shall be entitled to begin and to give evidence in support of such letters patent; and in case evidence shall be adduced on the part of the prosecutor, impeaching the validity of such letters patent, the defendant shall be entitled to the reply.

Twenty-eighth. *General issue to be pleaded.—Proviso.* In any action for the infringement of letters patent, the defendant shall not plead any other plea than the general issue, which shall put the plaintiff to such proof in support of his action, and let in such evidence for the defendant, as in any action under such plea the defendant may, or the plaintiff at present is required to adduce; nevertheless the defendant shall be at liberty, along with such plea, to give notice by indorsement thereon or annexed to such plea of any special defense which he might by the present practice offer under a special plea, and for which he would be required to plead specially: Provided, that the defendant shall at the trial be bound by such notice, and not be at liberty to go into evidence of any other defense which by the present rules of pleading he would be restricted from giving, except under some plea for that purpose specially pleaded; and if the plaintiff would under the present rules of pleading be entitled to set up one of two answers to such special defense, he shall be required to indorse upon his similitur to the defendant's plea the nature of such answer, and shall at the trial be precluded from entering into evidence in support of any other answer: Provided further, that nothing herein contained shall be construed to prevent any party to an action or suit from filing a general or a special demurrer.

Twenty-ninth. *The court or a judge in chambers may grant injunctions, &c.* In any action in any of Her Majesty's courts of record in this island for the infringement of letters patent, it shall be lawful for the court in which such action is pending, if the court be then sitting, or if the court be not sitting, then for a judge of such court, on the application of the plaintiff or defendant respectively to make such order for an injunction, inspection, or account, and to give such direction respecting such action, injunction, inspection, and account, and the proceedings therein respectively, as to such court or judge may seem fit.

Thirtieth. *As to costs in actions for infringement of patent rights.* In taxing the costs in any action, in any of Her Majesty's courts of record in this island, commenced after the passing of this Act, for infringing letters patent, regard shall be had to the particulars delivered in such action, and the plaintiff and defendant respectively shall not be allowed any costs in respect of any particulars, unless certified by the judge before whom the trial was had, to have been proved by such plaintiff or defendant respectively without regard to the general costs of the cause; and it shall be

lawful for the judge before whom any such action shall be tried, to certify on the record that the validity of the letters patent in the declaration mentioned came in question, and the record with such certificate being given in evidence in any suit or action for infringing the said letters patent, or in any proceeding by scire facias to repeal the letters patent, shall entitle the plaintiff in any such suit or action, or the defendant in such proceeding by scire facias, on obtaining a decree, decretal order, or final judgment, to his full costs, charges and expenses, taxed as between attorney and client, unless the judge, making such decree or order, or the judge trying such action or proceeding, shall certify that the plaintiff or defendant respectively ought not to have such full costs.

XII. PENALTY FOR USER OR FOR IMITATION OR COUNTERFEIT WITHOUT CONSENT.

Thirty-first. *Treble damages to be paid to patentee for the unlawful use of his patented invention.* Whenever in any case any letters patent shall be, or shall or may have been granted to any person under and by virtue of this Act, and any person without the consent of the patentee, his executors, administrators, or assigns, first had and obtained in writing, shall make, devise, use, or sell the thing, invention, or discovery whereof the exclusive right is secured to the said patentee by such letters patent, such persons 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 recoverable, together with costs of suit, by action on the case founded on this Act in the Supreme Court of this island.

Thirty-second. *Using the name of a patentee for the sale of an unpatented invention, declared subject to a penalty.* If any person shall write, paint, or print, or mould, cast, or carve, or engrave or stamp upon any thing made, used, or sold by him, for the sole making or selling of 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 leave in writing of such patentee, or his assigns; or if any person shall, upon such thing not having been purchased from the patentee, or some person who pur-

chased it from or under such patentee, or not having had the license or consent in writing of such patentee, or his assigns, write, paint, print, mould, cast, carve, engrave, stamp or otherwise mark the words "patent," the words "Letters Patent," or the words "By the Queen's Patent," or any words of the like kind, meaning, or import, with a view of imitating or counterfeiting the stamp, mark, or other device of the patentee or shall in any other manner imitate or counterfeit the stamp, or mark, or other device of the patentee, he shall for every such offense be liable to a penalty of fifty pounds, to be recovered by action of debt, bill, plaint, process or information in Her Majesty's Supreme Court of this island, one half to Her Majesty, her heirs and successors, and the other to any person who shall sue for the same ; provided that nothing herein contained shall be construed to extend to subject any person to any penalty in respect of stamping, or in any way marking, the words "Patent" upon any thing made for the sole making or vending of which a patent before obtained shall have expired.

XIII. AS TO FORMS AND STAMPS.

Thirty-third. The forms of this Act may be varied. The several forms in the schedule to this Act may be used for and in respect of the several matters therein mentioned, and the same may be varied as occasion may require.

Thirty-fourth. Stamps stated in schedule to be impressed. The respective stamp duties set forth in the schedule hereunto annexed, shall be charged on letters patent, and the other instruments therein stated under this Act respectively, and no other stamp duties shall be chargeable thereon respectively.

XIV. AS TO THE WRIT OF SCIRE FACIAS.

Thirty-fifth. *Scire facias for the repeal of patents.* Provided that the writ of 'scire facias shall lie for the repeal of any letters patent issued under this Act, in the like cases as the same would lie for the repeal of letters patent which may now be issued under the Great Seal in England.

XV. CONSTRUCTION OF ACT.

Thirty-sixth. *Doubts as to construction to be construed by analogy.* If any doubt should arise in the construction of this Act, the same may be construed by analogy to the laws now or hereafter to be in force in England relating to the granting of letters patent for inventions, so far as the provisions of such laws shall be applicable

XVI. COMMISSIONERS TO BE ASSOCIATED.

Thirty-seventh. *The governor to appoint commissioners under this Act.* It shall be lawful for the Governor from time to time, by warrant under his sign manual, which shall be free from stamp duty, to appoint such persons as he may think fit to be commissioners under this Act; and every person so appointed shall continue such commissioner during the Governor's pleasure, and may be summoned to attend any meeting, and take part in any proceedings of the Governor in executive committee in any matter or proceeding arising under this Act.

XVII. MISCELLANEOUS CLAUSES.

Thirty-eighth. *Interpretation of words.* In the construction of this Act the following expressions shall have the meanings hereby assigned to them, unless such meanings be repugnant to or inconsistent with the context; that is to say, "the expression, invention, discovery, and improvement" respectively, shall mean any manner of new manufacture or new mode of manufacture, the subject of letters patent and grant of privilege within the meaning of the Act of the twenty-first year of the reign of King James the First, chapter three; the expressions "petition," "declaration," "reference," "certificate," or "warrant," and "letters patent" respectively, shall mean instruments in the form and to the effect in the schedule hereto annexed, subject to such alterations as may from time to time be made therein, under the powers and provisions of this Act.

Thirty-ninth. *Short title of Act.* In citing this Act in other Acts, instruments, and proceedings, it shall be sufficient to use the expressions "The Patent Law Amendment Act, 1857."

Fortieth. *16th Viet. cap. 12, repealed.* A certain Act of the

legislature of this island, made and passed in the sixteenth year of the reign of Her present Majesty, for ascertaining and declaring the law with regard to patents, of exclusive privileges in trade, manufacture, and inventions in connection therewith, is hereby repealed.

Forty-first. *Patents granted in Great Britain to trade in this Island, unless granted in pursuance of this Act.* No letters patent heretofore obtained, or hereafter to be obtained, in Great Britain, or elsewhere, for the exclusive privilege of trade or manufacture, or any invention in connection therewith, shall be of any validity or effect in this island, unless letters patent for the privilege or invention, in respect of which such foreign letters patent may have been obtained, shall be granted and issued in pursuance of this Act, nor until all the provisions and requirements of this Act shall have been complied with in respect to letters patent.

SCHEDULE OF STAMP DUTIES.

	£	s.	d.
Letters patent.....	5	0	0
Petition.....	0	1	6
Declaration.....	0	1	6
Specification.....	0	5	0
Reference.....	0	0	0
Certificate or warrant of attorney-general.....	0	0	0
Disclaimer or memorandum of alteration.....	0	1	6
Assignment.....	0	10	0

FORMS.

Petition.

To his Excellency, &c., &c. [*here insert name and title of Governor.*]

The humble petition of [*here insert name and address of petitioner*], for, &c.

Showeth,

That your petitioner is in possession of an invention for [*the title of the invention*], which invention he believes will be of great public utility; that he is the true and first inventor thereof; and that the same is not in use by any other person or persons to the best of his knowledge and belief.

Your petitioner, therefore, humbly prays that your Excellency will be pleased, in the name and on behalf of Her Majesty the Queen, to grant unto him, his executors, administrators, and assigns, Her Majesty's letters patent for this island, for the term of fourteen years, pursuant to the statute in that case made and provided.

And your petitioner will ever pray, &c.

Declaration.

I , of , in the county of , do solemnly and sincerely declare that I am in possession of an invention for, &c., &c. [*the title as in petition*], which invention I believe will be of great public utility; that I am the true and first inventor thereof; and that the same is not in use by any other person or persons to the best of my knowledge and belief; and that the instrument in writing, under my hand and seal, hereunto annexed, particularly describes and ascertains the nature of the said invention and the manner in which the same is to be performed; and I make this declaration, conscientiously believing the same to be true, and by virtue of the provisions of an act made and passed.

A. B.

Declared at , this day of , A. D., before me, ,
Justice of the Peace.

Specification.

To all to whom these presents shall come, I , of , send greeting:—
Know ye, that I, the said , do hereby declare the nature of my invention for [*insert title as in petition*], and in what manner the same is to be performed, to be particularly described and ascertained in and by the following statement; (that is to say)—

[*Here describe the invention.*]

In witness whereof I, the said A. B., have hereunto set my hand this day
, A. D. .

We attest:—

C. D., of , &c.

E. F., of , &c.

Reference.

(To be indorsed on the petition.)

His Excellency is pleased to refer this petition to Her Majesty's Attorney-General, to consider what may be properly done therein.

Secretary to the Executive Committee.

Warrant.

In obedience to his Excellency's command, referring to me the petition of , of , to consider what may be properly done therein, I do hereby certify as follows, that the said petition sets forth that the petitioner,

[*Allegations of the petition.*]

And the petitioner most humbly prays

[*Prayer of the petition.*]

That in support of the allegations contained in the said petition, the declaration of the petitioner has been laid before me, whereby he solemnly declares that,

[*Allegations of the declaration.*]

That there has also been laid before me a specification signed , and attested by two witnesses, and also a certificate of the filing thereof.

That it appears that the said application was duly advertised. Upon consideration of all the matters aforesaid, and as it is entirely at the hazard of the said petitioner whether the said invention is new, or will have the desired success, and as it may be reasonable for his Excellency to encourage all arts and inventions which may be for the public good, I am of opinion that his Excellency may grant letters patent

unto the petitioner, his executors, administrators, and assigns, for his said invention within this island, for the term of fourteen years, according to the statute in that case made and provided, if his Excellency shall be graciously pleased so to do, to the tenor and effect following :—

(See Forms, Letters Patent.)

Given under my hand this Jay of , A. D.

Attorney-General, Jamaica.

Letters Patent.

VICTORIA, by the grace of God, of the United Kingdom of Great Britain and Ireland, Queen, and of Jamaica, Lady, Defender of the Faith : to all to whom these presents shall come, greeting :—

Whereas hath, by his petition, humbly represented unto Our Captain-General and Governor-in-Chief of our Island of Jamaica that he is in possession of an invention for [*insert title of invention*], which the petitioner conceives will be of great public utility ; that he is the true and first inventor thereof ; and that the same is not in use by any other person or persons to the best of his knowledge and belief. The petitioner, therefore, most humbly prayed that We would be graciously pleased to grant unto him, his executors, administrators, and assigns, Our Royal letters patent for the sole use, benefit, and advantage of his said invention within Our said Island of Jamaica for the term of fourteen years, pursuant to the statute in that case made and provided :

And whereas the said hath particularly described and ascertained the nature of the said invention, and in what manner the same is to be performed, by an instrument in writing under his hand, and has caused the same to be duly filed in the office of the Island secretary :

And We, being willing to give encouragement to all arts and inventions which may be for the public good, are graciously pleased to condescend to the request :

Know ye, therefore, that We, of Our special grace, certain knowledge, and mere motion, have given and granted, and by these presents, for Us, Our heirs and successors, do give and grant unto the said , his executors, administrators, and assigns, Our especial license, full power, sole privilege, and authority that he, the said , his executors, administrators, and assigns, and every of them, by himself and themselves, or by his and their deputy or deputies, servants or agents, or such others as he, the said , his executors, administrators, and assigns, shall at any time agree with, and no others, from time to time and at all times hereafter during the term of years herein expressed, shall and lawfully may make, use, exercise, and vend his said invention within Our said island of Jamaica, in such manner as to him, the said , his executors, administrators, and assigns, or any of them, shall in his or their discretion seem meet, and that he, the said , his executors, administrators, and assigns, shall and lawfully may have and enjoy the whole profit, benefit, commodity, and advantage, and enjoy from time to time coming, growing, accruing, and arising by reason of the said invention, for and during the term of years herein mentioned, to have, hold, exercise, and enjoy the said licenses, powers, privileges, and advantages herein-before granted or mentioned to be granted unto the said , his executors, administrators, and assigns, for and during and unto the full end and term of fourteen years from the day of , A. D. next and immediately ensuing, and according to the statute in such case made and provided, and to the end that he, the said , his executors, administrators and assigns, and every of

them, may have and enjoy the full benefit, and the sole use and exercise of the said invention, according to our gracious intention herein-before declared, We do by these presents, for Us, Our heirs and successors require and strictly command all and every person and persons, bodies politic and corporate, and all other Our subjects whatsoever, of what estate, quality, degree, name, or condition soever they be, within Our said island of Jamaica, that neither they nor any of them, at any time during the continuance of the said term of fourteen years hereby granted, either directly or indirectly, do make, use, or put in practice the said invention, or any part of the same, so attained unto by the said _____, as aforesaid, nor in anywise counterfeit, imitate, or resemble the same, nor shall make or cause to be made any addition thereto or subtraction from the same, whereby to pretend himself or themselves the inventor or inventors, deviser or devisors thereof, without the consent, license, or agreement of the said _____, his executors, administrators, or assigns, in writing under his or their hands and seals, first had and obtained in that behalf, upon such pains and penalties as can or may be justly inflicted on such offenders for their contempt of this Our Royal command; and further, to be answerable to the said _____, his executors, administrators, and assigns, according to law, for his and their damages thereby occasioned; and moreover, we do by these presents, for Us, Our heirs and successors, will and command all and singular the justices of the peace, constables, and all other officers and ministers whatsoever, Our heirs and successors for the the time being, that they, or any of them, do not nor shall at any time during the said term hereby granted, in anywise molest, trouble, or hinder the said _____, his executors, administrators, or assigns, or any of them, or his or their deputies, servants, or agents, in or about the due and lawful use or exercise of the aforesaid invention, or anything relating thereto: Provided always, and these Our letters patent are, and shall be upon this condition, that if, at any time during the said term hereby granted, it shall be made appear to Us, Our heirs or successors, or any six or more of Our, or their, Privy Council of Our said island of Jamaica, that this Our grant is contrary to law, or prejudicial or inconvenient to Our subjects in general, or that the said invention is not a new invention as to the public use and exercise thereof, or that the said _____ is not the true and first inventor thereof within this island as aforesaid, these Our letters patent shall forthwith cease, determine, and be utterly void, to all intents and purposes, anything hereinbefore contained to the contrary thereof in anywise notwithstanding: Provided also, that these Our letters patent, or anything herein contained, shall not extend, or be construed to extend, to give privilege unto the said _____, his executors, administrators, and assigns, or any of them, to use or imitate any invention or work whatsoever which hath heretofore been found out or invented by any other of Our subjects whatsoever, and publicly used or exercised, unto whom Our letters patent or privileges have been already granted for the sole use, exercise, and benefit thereof; it being Our will and pleasure that the said _____, his executors, administrators, and assigns, and all and every other person and persons to whom like letters patent or privileges have been already granted as aforesaid, shall distinctly use and practice their several inventions by them invented and found out, according to the true intent and meaning of the same respective letters patent, and of these presents: Provided likewise, nevertheless, and these Our letters patent are upon this express condition, that if the said instrument in writing, filed as aforesaid, does not particularly describe and ascertain the nature of the said invention, and in what manner the same is to be performed, and also, if the said _____, his executors, administrators, or assigns, shall not supply, or cause to be supplied, for Our

service, all such articles of the said invention as he or they shall be required to supply by the officers or commissioners administering the department of Our service for the use of which the same shall be required, in such manner, at such times, and at and upon such reasonable prices and terms as shall be settled for that purpose by the said officers or commissioners requiring the same, that then, and in any of the said cases, these Our letters patent, and all liberties and advantages hereby granted, shall utterly cease, determine, and become void, anything hereinbefore contained to the contrary thereof in anywise notwithstanding: Provided that nothing herein contained shall prevent the granting of licenses in such manner and for such considerations as they may by law be granted; and lastly, We do, by these presents, for Us, Our heirs and successors, grant unto the said _____, his executors, administrators, and assigns, that these Our letters patent, on the filing thereof, shall be, in and by all things good, firm, valid, sufficient, and effectual in the law according to the true intent and meaning thereof, and shall be taken, construed, and adjudged in the most favorable and beneficial sense for the best advantage of the said _____, his executors, administrators, and assigns, as well as in all Our courts of record as elsewhere, and by all and singular the officers and ministers whatsoever of Us, Our heirs and successors, in Our said island of Jamaica, and amongst all and every the subjects of Us, Our heirs and successors, within Our said island of Jamaica, notwithstanding the not full and certain describing the nature and quality of the said invention, or of the materials thereunto conducing and belonging: Provided further, that if the said _____, his heirs, administrators, or assigns, shall, upon petition, presented to Our Captain-General and Governor-in-Chief, or officer administering the government of Our said island, before the expiration of the term of years hereby granted, show that he or they has or hath been unable to obtain a due remuneration for his or their expense or labor in perfecting the aforesaid invention, and Our Captain-General and Governor-in-Chief, or officer administering the government as aforesaid, in Executive Committee, shall be of opinion that an extension of the term of years aforesaid should be granted, it shall be lawful for Our Captain-General and Governor-in-chief, or officer administering the government as aforesaid, to extend the term of years aforesaid for any further period not exceeding seven years, and to sign and issue in the name and on the behalf of Us, Our heirs or successors, new letters patent, in the form or of the tenor or effect aforesaid, unto the said _____, his executors, administrators, or assigns, for the aforesaid invention for any such further period not exceeding seven years as aforesaid accordingly; and to the end aforesaid, We have caused these, Our letters patent to be sealed with the broad seal of Our said island of Jamaica.

(Seal.) Witness, his Excellency, &c., &c., &c., Captain-General and Governor-in-Chief [*or administering the government*] of Our said island of Jamaica, and the territories thereon depending, Chancellor and Vice-Admiral of the same, at Saint Jago de la Vega, this _____ day of _____ annoque domini, and in the _____ year of Our reign.

From *Carp. Pat. L. of World*, 304.

JAPAN.

Imperial Proclamation No. 7 of (April 18,) 1884; and Appendix.

It is hereby notified that the following regulations as to patents have been published and will be enforced on and after July 1, 1885.

N. B.—The rules respecting patents published on April 7, 1871, and Imperial Proclamation No. 105, published in March, 1872, have been repealed.

By order of H. I. M. the MIKADO.

Prince SANJO SANEYOSHI,

Prime Minister of State.

Count MATSUKATA MASAYOSHI,

Minister of Agriculture and Commerce.

April 18, 1885.

ARTICLE 1. Inventors of useful articles desirous of having the exclusive sale of the same shall apply to the minister of agriculture and commerce, and obtain his special permission. The minister of agriculture and commerce shall, if advisable, deliver certificates of special permission for their exclusive sale.

ART. 2. In applying for a patent a detailed statement of the invention and the necessary diagrams will be affixed to the written application. The invented article or a specimen, shall, if necessary, be ordered to be submitted.

ART. 3. The terms of a patent right may not exceed fifteen years, reckoning from the date of its certificate.

ART. 4. Patents cannot be applied for in the case of articles of the nature specified below:

(1.) Articles that have previously been invented by others.

N. B.—This provision does not extend to patents that have been transferred by their owners.

(2.) Articles that have been publicly used or known before the patents have been applied for.

(3.) Articles that tend to disturb social tranquillity or demoralize customs and fashions, or are injurious to health.

(4.) Medicines.

ART. 5. For inventions deemed necessary for war purposes or those the general use of which is deemed important, the minister of

agriculture and commerce will not grant patents, and in the case of those for which patents have previously been granted he may cancel the same. In the case of inventions described above, the minister of agriculture and commerce will grant appropriate sums of money to the inventors by way of compensation.

ART. 6. Privileges by securing patents, as well as the patents, may be hereditary. When a successor has inherited a patent he shall report the fact to the minister of agriculture and commerce within three months.

ART. 7. Persons desirous of transferring to or acquiring from another person, patents, must apply for the permission of the minister of agriculture and commerce.

ART. 8. When a patentee effects improvements upon his invention he may apply for a fresh patent.

N. B.—The effect of additional patents may not exceed that of the original patents.

ART. 9. Persons desirous of obtaining patents for articles that are improvements upon other patented inventions must secure the consent of the original patentees. If the original patentee should refuse his consent and the minister of agriculture and commerce deem the refusal obstructive to the improvement of the invention, he may grant the improver special permission to use the original invention together with the improved part. In such cases as have been mentioned above the minister of agriculture and commerce shall cause the improvers to give appropriate sums of money to the original inventors by way of compensation.

ART. 10. Patentees must indicate on their inventions the date and term of the patents. In the case of articles, the nature of which precludes such indication, the date and term must be marked on the cover or otherwise.

ART. 11. The register of patentees, with other details, shall be submitted for public inspection by the minister of agriculture and commerce.

ART. 12. When patentees change the places of their registration or their residences or names, they must report the fact to the department of agriculture and commerce within three months.

ART. 13. When certificates of patents have been lost or damaged, the patentees must apply to the minister of agriculture and commerce for the delivery of fresh certificates.

ART. 14. In cases mentioned below, patents shall be declared void and the return of the certificates of the patents shall be ordered:

(1.) When any contravention of the provisions of article 4 has been discovered.

(2.) When any misrepresentation of facts has been discovered in the written applications and details of the inventions.

ART. 15. Patents will become void in the following cases :

(1.) When the inventions have not been practically publicly applied within two years after the date of the certificates of the patents, or when their execution has been suspended for two years without any representation of the circumstances of the case to the authorities.

(2.) When patented inventions have been imported from abroad and sold.

ART. 16. When certificates of patents are granted or canceled, or when any loss of patent right has occurred, the department of agriculture and commerce will publicly notify the fact.

ART. 17. Persons applying for patents shall pay the undermentioned fees.

N. B.—Should the written applications be dismissed, the fees shall be returned.

(1.) For persons applying for patents lasting for five years, 10 yen.

(2.) For persons applying for patents lasting for ten years, 15 yen.

(3.) For persons applying for patents lasting for fifteen years, 20 yen.

(4.) For persons applying for the transfer of patents, 5 yen.

(5.) For persons applying for additional patents, 5 yen.

(6.) For persons applying for fresh certificates of patents, 1 yen.

ART. 18. Officials concerned in the granting of patents may not apply for patents.

ART. 19. If the marks described in article 10 are not made, no appeal for any claim of damage may be made.

ART. 20. Persons who have counterfeited patented inventions, or imported them from abroad, or clandestinely used any patent, shall be liable to imprisonment with labor for a period not less than one month and not exceeding one year and a fine of not less than 4 yen and not exceeding 40 yen.

ART. 21. Persons who have applied to articles of the same kind as others manufactured under patents, marks that bear a close resemblance to those used by the owners of such patents, shall be liable to imprisonment with labor for a period of not less than fifteen days

and not exceeding six months, and a fine not less than 2 yen and not exceeding 20 yen.

ART. 22. Persons who have sold articles in contravention of articles 20 and 21, with previous knowledge of the fact, shall be liable to a fine not less than 4 yen and not exceeding 40 yen.

ART. 23. In the cases mentioned in articles 20, 21 and 22, the infringing articles and the apparatus used for the perpetration of the offenses shall be confiscated and handed over to the patentees, and in the case of articles previously sold, their price shall be exacted from the offender and also given to the patentees.

ART. 24. Persons who have obtained rights by fraudulent means or sham patents shall be liable to imprisonment for a period not less than fifteen days and not exceeding six months, and a penalty of not less than 2 yen and not exceeding 20 yen.

ART. 25. Persons who have failed to make the reports mentioned in the second clause of article 6 and article 12 within the prescribed periods shall be liable to a penalty of not less than 1 yen and not exceeding 1.95 yen.

ART. 26. To contraventions of these regulations the provisions in the criminal code for the simultaneous commission of several crimes shall not be applied.

ART. 27. The offenses mentioned in articles 20, 21, and 22 shall be dealt with at the instance of the patentees.

ART. 28. When patentees have made appeals, judges may temporarily suspend the sale of the articles to which such appeals relate.

Appendix.

Persons desirous of obtaining the exclusive sale of articles invented after the publication of the patent rules of April 7, 1871, and before the publication of these regulations, and which were reported to the authorities according to the additional provisions of notification No. 105, published in March, 1872, may apply to the minister of agriculture and commerce for their patents within six months after the date of the enforcement of these regulations, even though they be such as are generally used or known.

Persons who have made use of the inventions described above before the publication of these regulations may apply to the minister of agriculture and commerce for special permission for their use within one year after the date of the enforcement of these regula-

tions. In such cases they shall pay fees to the same amount as those for the granting of patents mentioned in article 17.

From 31 *Pat. Off. Gaz.* 1445.

Notification No. 5 Council of State.

It is hereby notified, that, the Patent Regulations having been published, the following Regulations are issued as to the mode of procedure to obtain patents.

Prince SANJO SANEYOSHI,

Prime Minister.

Count MATSUKATA MASAYOSHI,

Acting Minister of the Agricultural and Commercial Department.

April 18, 1885.

ARTICLE 1. Applications and reports in connection with patents shall be sent to the agricultural and commercial department through the prefectural authorities.

ART. 2. When application is made for a patent, there must be two letters of application and three statements of details and diagrams sent in, together with the patent fee. When more than one person is connected with the invention, they shall all sign the documents sent to the department.

ART. 3. Written statements, details, and diagrams are to be sent to the prefectural authorities in a sealed form, and in that form they will be forwarded to the minister of the agricultural and commercial department.

ART. 4. The following must be stated in all applications for patents:

- (1.) The name of the invention.
- (2.) The duration of the patent applied for.
- (3.) A declaration that it is not contravening the regulations.
- (4.) A declaration that there are no misrepresentations of facts made in the written application and statement.

ART. 5. In the details the following must appear:

- (1.) The object of the invention and explanation of its nature.
- (2.) An explanation of the diagrams, when such are submitted.
- (3.) A detailed description of the manufacture, structure, composition and the way of employing the invention.
- (4.) The uses to which the invention may be applied.
- (5.) The social rank, name and address of the inventor.

ART. 6. The diagram must be numbered, and their respective

parts shall be marked with letters or numerical figures to correspond with the explanations.

ART. 7. Any one applying for the transfer of the whole or part of the patent, in accordance with the 7th article of the regulations, must send in two letters of application, a copy of the agreement between the parties, and the certificate of patent, together with the fee.

ART. 8. Any person applying for additional patent rights should do so as provided in articles 2 and 3.

ART. 9. Any person desirous of obtaining the special permission stated in the second part of article 9 of the regulations, shall send in two applications, stating the circumstances of the case.

ART. 10. When it is reported, as stated in articles 6 and 12 of the regulations, that the name of the patentee is altered, the minister of the agricultural and commercial department shall indorse the fact on the certificate of patent.

ART. 11. When any one applies for a fresh certificate, a detailed account of the circumstances of the case must be sent in.

ART. 12. In a case where a patentee has discovered omissions or mis-statements in the letters of applications and diagrams, he shall send in two applications with a detailed account of the circumstances of the case. But when by addition to or alteration of some important part the invention is completely changed, no application will be received.

ART. 13. When patentees allow others by mutual consent to use the invention, the fact should be reported and the document signed by both parties.

ART. 14. When, after a patent has been declared void through a contravention of the provisions of the first part of article 4 of the regulations, and the original inventor applies again for the patent, its term shall not exceed that granted to the original patent.

ART. 15. Any person who desires to obtain permission to use articles, as provided for in the second clause of the regulations, shall send in two applications containing a detailed account of their previous employment.

From 31 *Pat. Off. Gaz.* 1445.

LEEWARD ISLANDS.

An Act for amending the Law for granting Patents for Inventions. No. 12 of 1876.

Whereas it is expedient to amend the law concerning letters patent for inventions,

Be it enacted by the Governor and General Legislative Council of the Leeward Islands, as follows :

[*Section 1, relating to commissioners of patents, has been repealed. See, sections 1 & 5 of Act No. 16, 1878, post.*]

2. Seal of the commissioners. It shall be lawful for the commissioners to cause a seal to be made for the purposes of this Act, and from time to time to vary such seal, and to cause to be sealed therewith all the warrants for letters patent under this Act, and all instruments and copies proceeding from the office of the commissioners, and all courts, judges and other persons whomsoever, shall take notice of such seal, and receive impressions thereof in evidence, in like manner as impressions of the Great Seal of the Colony are received in evidence, and shall also take notice of and receive in evidence, without further proof or production of the originals, all copies or extracts certified under the seal of the said office, of or from documents deposited in such office.

3. Power of commissioners to make rules and regulations to be approved by governor in council. It shall be lawful for the commissioners from time to time to make such rules and regulations (not inconsistent with the provisions of this Act) respecting the business of their office, and all matters and things which under the provisions herein contained are to be under their control and direction, as may appear to them necessary and expedient for the purposes of this Act, and all such rules when approved by the Governor in Council shall have the force and effect of law.

4. Office of the commissioners. It shall be lawful for the Governor to provide and appoint from time to time a proper place for an office for the purposes of this Act.

5. Commissioners, with consent of Governor, to appoint clerk. It shall be lawful for the commissioners, with the consent and approval of the Governor, from time to time to appoint a clerk for the purposes of this Act, and it shall be lawful for the commission-

ers from time to time, with the approval of the Governor, to remove such clerk so appointed.

6. *Petition, &c. to be accompanied by a provisional specification.* Every petition for the grant of letters patent for an invention, and the declaration required to accompany such petition, shall be left at the office of the commissioners; and there shall be left there, with it, a statement in writing, hereinafter called the provisional specification, signed by or on behalf of the applicant for letters patent, describing the nature of the said invention; and the day of the delivery of every such petition, declaration, and provisional specification shall be recorded at the said office, and indorsed on such petition, declaration, and provisional specification, and a certificate thereof given to such applicant or his agent; and all such petitions, declarations, and provisional specifications shall be preserved in such manner as the commissioners may direct, and a registry thereof, and of all proceedings thereon, kept at the office of the commissioners.

7. *Every application to be referred to attorney-general.* Every applicant for letters patent made under this Act shall be referred by the commissioners according to such regulations as they may think fit to make, to the attorney-general.

8. *Provisional specification to be referred to attorney-general, who may give certificate of allowance.* The provisional specification shall be referred to the attorney-general, who shall be at liberty to call to his aid such scientific, or other person as he may think fit, and to cause to be paid to such person by the applicant, such remuneration as the attorney-general shall appoint; and if the attorney-general be satisfied that the provisional specification describes the nature of the invention, he shall allow the same, and give a certificate of his allowance, and such certificate shall be filed in the office of the commissioners, and thereupon the invention therein referred to may, during the term of six months from the date of the application for letters patent for the said invention be used and published without prejudice to any letters patent to be granted for the same, and such protection from the consequences of use and publication is hereinafter referred to as provisional protection. Provided always that in case the title of the invention or the provisional specification be too large or insufficient, it shall be lawful for the attorney-general to allow or require the same to be amended.

9. *Inventor may deposit a complete specification, to confer for a limited time the like rights as letters patent.* The applicant for letters patent for an invention instead of leaving with the petition

and declaration a provisional specification as aforesaid, may, if he think fit, file with the said petition and declaration an instrument in writing under his hand and seal (hereinafter called a complete specification) particularly describing and ascertaining the nature of the said invention, and in what manner the same is to be performed, which complete specification shall be mentioned in such declaration, and the day of the delivery of every such petition, declaration and complete specification shall be recorded at the office of the commissioners, and indorsed on such petition, declaration, and specification, and a certificate thereof given to such applicant or his agent, and thereupon subject and without prejudice to the provisions hereinafter contained, the invention shall be protected under this Act for the term of six months from the date of the application, and the applicant shall have during such term of six months the like powers, rights, and privileges, as might have been conferred upon him by letters patent for such invention issued under this Act, and duly sealed as of the day of the date of such application, and during the continuance of such powers, rights, and privileges under this provision, such invention may be used and published without prejudice to any letters patent to be granted for the same; and where letters patent are granted in respect of such invention, then in lieu of a condition for making void such letters patent in case such invention be not described and ascertained by a subsequent specification, such letters patent shall be conditioned to become void, if such complete specification filed as aforesaid, does not particularly describe and ascertain the nature of the said invention, and in what manner the same is to be performed; and a copy of every such complete specification shall be open to the inspection of the public as hereinafter provided, from the time of depositing the same, subject to such regulations as the commissioners may make.

10. *Letters patent granted to first inventor not invalidated by protection obtained in fraud.* In case of any application for letters patent for any invention, and the obtaining upon such application of provisional protection for such invention, or of protection for the same, by reason of the deposit of a complete specification, as aforesaid, in fraud of the true and first inventor, any letters patent granted to the true and first inventor of such invention shall not be invalidated by reason of such application or of such provisional or other protection as aforesaid, or of any use or publication of the invention, subsequent to such application, and before the expiration of the term of such provisional or other protection.

11. *Commissioners to cause protection to be advertised.* Where any invention is provisionally protected under this Act, or protected by reason of the deposit of such complete specification as aforesaid, the commissioners shall cause such provisional protection, or such other protection, as aforesaid, to be advertised in such manner as they may see fit.

12. *Application for letters patent to be advertised ; also oppositions.* The applicant for letters patent, so soon as he may think fit after the invention shall have been provisionally protected under this Act, or where a complete specification has been deposited with his petition and declaration, then so soon as he may think fit after such deposit, may give notice at the office of the commissioners of his intention of proceeding with his application for letters patent for the said invention, and thereupon the said commissioners shall cause his said application to be advertised in such manner as they may see fit, and any person having an interest in opposing the grant of letters patent for the said invention, shall be at liberty to leave particulars in writing of their objections to the said application at such place, and within such time, and subject to such regulations as the commissioners may direct.

13. *Specification and objections to be referred to attorney-general.* So soon as the time for the delivery of such objections shall have expired, the provisional specification or complete specification (as the case may be), and particulars of objection (if any) shall be referred to the attorney-general.

14. *Power to attorney-general to order costs paid.* It shall be lawful for the attorney-general, if he see fit, by certificate under his hand, to order by or to whom the cost of any hearing or inquiry upon any objection or otherwise, in relation to the grant of such letters patent, or in relation to provisional (or other) protection acquired by the applicant under this Act shall be paid, and in what manner, and by whom such costs are to be ascertained, and if any costs so ordered to be paid be not paid within four days after the amount thereof shall be so ascertained, it shall be lawful for the attorney-general to make an order for the payment of the same, and every such order may be made a rule of the supreme court to the effect that execution may pass thereupon in common form.

15. *Attorney-general to cause warrant for sealing letters patent.* It shall be lawful for the attorney-general after such hearing, if any, as he may think fit, to cause a warrant to be made for the sealing of letters patent for the said invention, and such warrant

shall be sealed with the seal of the commissioners, and shall set forth the tenor and effect of the letters patent thereby authorized to be granted, and the attorney-general shall direct the insertion in such letters patent of all such restrictions, conditions, and provisos as he may deem usual and expedient in such grants, or necessary in pursuance of the provisions of this Act ; and the said warrant shall be the warrant for making and sealing of letters patent under this Act according to the tenor of said warrant.

16. *Nothing to affect the prerogative of the Crown.* Provided always that nothing herein contained shall extend to abridge or affect the prerogative of the Crown in relation to the granting or withholding the grant of any letters patent, and it shall be lawful for the Governor by warrant under his hand, to direct the attorney-general to withhold such warrant as aforesaid, or that any letters patent for the issuing whereof he may have issued a warrant as aforesaid shall not issue, or to direct the insertion in any letters patent to be issued in manner herein provided of any restrictions, conditions, or provisos, which he may think fit, in addition to, or in substitution for, any restrictions, conditions or provisos which would otherwise be inserted therein under this Act, and it shall also be lawful for the Governor by like warrant to direct any complete specification, which may have been filed under the provision hereinbefore contained, and in respect of the invention described, in which no letters patent may have been granted, to be canceled, and thereupon the protection obtained by the filing of such complete specification shall cease.

17. *Letters patent to be for 14 years, subject to conditions.* All letters patent for inventions granted under the provisions hereinbefore contained shall be for fourteen years, and shall be made subject to the condition, that the same shall be void, and that the powers and privileges thereby granted shall cease and determine at the expiration of three years and seven years respectively from the date thereof, unless there be paid before the expiration of the said three and seven years respectively, the sum or sums of money in the schedule to this Act annexed; and the payment of the said sums of money shall be indorsed on the warrant for the said letters patent, and the clerks of the commissioners shall issue under the seal of the commissioners a certificate of such payment, and shall indorse a receipt for the same on any letters patent issued under the authority of the said warrant; and such certificate duly stamped, shall be evidence of the payment of the several sums respectively.

18. *Letters patent to be sealed with the Great Seal of the Colony.* The commissioners so soon after the sealing of the said warrant as required by the applicant for the letters patent, shall cause to be prepared letters patent for the invention according to the tenor of the said warrant, and it shall be lawful for the Governor to cause such letters patent to be sealed with the Great Seal of the Colony.

19. *No letters after three months from warrant.* Provided always that no letters patent, save as hereinafter mentioned in the case of letters patent destroyed or lost, shall issue on any warrant granted as aforesaid, unless application be made to seal such letters patent within three months after the date of the said warrant.

20. *No letters (except, &c.,) to be issued after expiration of protection.* Provided also that no letters patent (save letters patent issued in lieu of others destroyed or lost) shall be issued or be of any force or effect, unless the same be granted during the continuance of the provisional protection under this Act, or where a complete specification has been deposited under this Act, nor then unless such letters patent be granted during the continuance of the protection conferred under this Act by reason of such deposit; save that where the application to seal such letters patent has been made during the continuance of such provisional or other protection as aforesaid, and the sealing of such letters patent has been delayed by reason of a caveat or an application to the Governor against or in relation to the sealing of such letters patent, then such letters patent may be sealed at such time as the Governor shall direct.

21. *Letters patent may be granted to personal representatives.* Provided also that where the applicant for such letters patent dies during the continuance of the provisional protection, or the protection by reason of the deposit of a complete specification (as the case may be), such letters patent may be granted to the executors or administrators of such applicant during the continuance of such provisional or other protection, or at any time within three months after the death of such applicant, notwithstanding the expiration of the term of such provisional or other protection, and the letters patent so granted shall be of the like force and effect as if they had been granted to such applicant during the continuance of such provisional or other protection.

22. *If letters be destroyed or lost, others may be issued.* Provided also that in case any such letters patent shall be destroyed

or lost, other letters patent of the like tenor and effect, and sealed and dated as of the same day, may, subject to such regulations as the commissioners may direct, be issued under the authority of the warrant in pursuance of which the original letters patent were issued.

23. *Letters patent may be dated as of the day of the application.* It shall be lawful to cause any letters patent to be issued in pursuance of this Act to be sealed and bear date as of the day of the application for the same, or where the attorney-general or the Governor thinks fit and directs, any such letters patent as aforesaid may be sealed and bear date as of the day of the sealing of such letters patent or of any other day between the day of such application for provisional registration and the day of such sealing.

24. *Letters patent antedated to be of the same validity.* Any letters patent issued under this Act, sealed and bearing date as of any day prior to the day of the actual sealing thereof shall be of the same force and validity as if they had been sealed on the day as of which the same are expressed to be sealed and bear date. Provided always that save where such letters patent are granted for any invention in respect whereof a complete specification has been deposited upon the application for the same under this Act, no proceeding at law or in equity shall be had upon such letters patent in respect of any infringement committed before the same were actually granted.

25. *Letters for foreign inventions not in force after expiration of foreign patent.* Where upon any application made after the passing of this Act, letters patent are granted in this colony for or in respect of any invention first invented in any foreign country, or by the subject of any foreign power or State, and a patent or like privilege for the monopoly or exclusive use or exercise of such invention in any foreign country is there obtained before the grant of such letters patent in this colony, all rights and privileges under such letters patent shall (notwithstanding any term in such letters patent limited) cease and be void immediately upon the expiration or other determination of the term during which the patent or like privilege obtained in such foreign country shall continue in force, or where more than one such patent or like privilege is obtained abroad immediately upon the expiration or other determination of the term which shall first expire or be determined of such several patents or like privileges, provided always that no letters patent for or in respect of any invention for which any such patent or like privilege as aforesaid shall have been obtained in any

foreign country, and which shall be granted in this colony after the expiration of the term for which such patent or privilege was granted or was in force, shall be of any validity.

26. *Use of inventions in foreign ships, &c.* No letters patent for any invention (granted after the passing of this Act) shall extend to prevent the use of such invention in any foreign ship or vessel, or for the navigation of any foreign ship or vessel, which may be in any port of this colony, where such invention is not so used for the manufacture of any goods or commodities to be vended within or exported from this colony, provided always that this enactment shall not extend to the ships or vessels of any foreign State of which the laws authorize subjects of such foreign State, having patents or like privileges for the exclusive use or exercise of inventions within its territories to prevent or interfere with the use of such inventions in British ships or vessels while in the ports of such foreign State or in the waters within the jurisdiction of its courts, where such inventions are not so used for the manufacture of goods or commodities to be vended within or exported from the territories of such foreign State.

27. *Requirement that specifications be filed.* All letters patent to be granted under this Act (save only letters patent granted after the filing of a complete specification) shall require the specification thereunder to be filed in the office of the commissioners.

28. *Filing.* Every specification to be filed in pursuance of the condition of any letters patent shall be filed in the office of the commissioners.

29. *Copies of specifications to be open to inspection.* The commissioners shall cause true copies of all specifications (other than provisional specifications), disclaimers and memoranda of alterations filed under or in pursuance of this Act, and all provisional specifications after the term of the provisional protection of the invention has expired, to be open to the inspection of the public at the office of the commissioners at all reasonable times, subject to such regulations as the commissioners may direct.

30. *Specification and other documents to be printed, &c.* The commissioners shall cause to be printed, published, and sold at such prices and in such manner as they may think fit, all specifications, disclaimers and memoranda of alterations deposited or filed under this Act, and such specifications (not being provisional specifications), disclaimers and memoranda respectively shall be so printed and published as soon as conveniently may be after the filing thereof

respectively, and all such provisional specifications shall be so printed and published as soon as conveniently may be after the expiration of the provisional protection obtained in respect thereof, and it shall be lawful for the commissioners to present copies of all such publications to such public libraries and museums as they may think fit, and to allow the person depositing or filing any such specification, disclaimer or memoranda of alteration to have such number, not exceeding twenty-five, of the copies thereof so printed and published, without any payment for the same, as they may think fit.

31. *Copies of specifications, &c., to be evidence.* Printed copies, certified by the commissioners or one of them, of specifications, disclaimers, and memoranda of alterations shall be admissible in evidence and deemed and taken to be *prima facie* evidence of the existence and contents of the documents to which they purport to relate, in all courts and in all proceedings relating to letters patent.

32. *Register of patents to be kept.* There shall be kept at the office of the commissioners under this Act a book or books to be called "The Register of Patents," wherein shall be entered and recorded in chronological order all letters patent granted under this Act, the deposit of filing of specifications, disclaimers and memoranda of alterations, filed in respect of such letters patent, all amendments in such letters patent and specifications, all confirmations and extensions of such letters patent, the expiry, vacating, or canceling such letters patent, with the dates thereof respectively, and all other matters and things affecting the validity of such letters patent, as the commissioners may direct, and such register or a copy thereof shall be open at all convenient times to the inspection of the public, subject to such regulations as the commissioners may make.

33. *Registers of proprietors to be kept.* There shall be kept at the office of the commissioners a book or books entitled "The Register of Proprietors," wherein shall be entered in such manner as the commissioners shall direct the assignment of any letters patent, or of any share or interest therein, any license under letters patent, and the district to which such license relates, with the name or names of any person having any share or interest in such letters patent or license, the date of his or their acquiring such letters patent, share and interest, and any other matter or thing relating to or affecting the proprietorship in such letters patent or license, and a copy of any entry in such book, certified under the seal of the commissioners, shall be given to any person requiring the same on pay-

ment of the fees hereinafter provided, and such copies so certified shall be received in evidence in all courts and in all proceedings, and shall be *prima facie* proof of the assignment of such letters patent or share or interest therein or of the license of the proprietorship, as therein expressed, provided always that until such entry shall have been made the grantee or grantees of the letters patent shall be deemed and taken to be the sole and exclusive proprietor or proprietors of such letters patent and of all the licenses and privileges thereby given and granted, and any writ of scire facias to repeal such letters patent may be issued to the provost marshal of the presidency in which the grantee or grantees resided at the time when the said letters patent were granted, and in case such grantee or grantees do not reside in the Leeward Islands, it shall be sufficient to file such writ in the usual manner in which writs are filed, and serve notice thereof in writing at the last known residence or place of business of such grantee or grantees, and such register or a copy shall be open to the inspection of the public at the office of the commissioners, subject to such regulations as the commissioners may make.

34. *Falsification or forgery of entries a misdemeanor.* If any person shall willfully make or cause to be made any false entry in the said Register of Proprietors, or shall willfully make or forge or cause to be made or forged any writing falsely purporting to be a copy of any entry in the said book, or shall produce or tender or cause to be produced or tendered in evidence any such writing knowing the same to be false or forged, he shall be guilty of misdemeanor, and shall be punished by fine and imprisonment accordingly.

35. *Entries may be expunged.* If any person shall deem himself aggrieved by any entry made under color of this Act in the said Register of Proprietors, it shall be lawful for such person to apply by motion to the Supreme Court or any judge thereof for an order that such entry may be expunged, vacated or varied, and upon any such application the said court or judge may make such order for expunging, vacating or varying such entry, and as to the costs of such application as to the said court or judge may seem fit, and the officer having the care and custody of such register, on the production to him of any such order for expunging, vacating or varying any such entry, shall expunge, vacate or vary the same, according to the requisitions of such order.

36. *Provisions of 5 & 6 W. 4, c. 83, and of 7 & 8 Vict. c. 69,*

as to disclaimers and memoranda of alterations, to apply.—*Application for disclaimers and caveats.* All the provisions of the Imperial Acts of the session holden in the fifth and sixth years of King William the Fourth, chapter eighty-three, and of the session holden in the seventh and eighth years of Her Majesty, chapter sixty-nine, respectively relating to disclaimers and memoranda of alterations in letters patent and specifications, except as hereinafter provided, shall be applicable and apply to any letters patent granted and to any specification filed under the provisions of this Act, provided always that all applications for leave to enter a disclaimer or memorandum of alteration shall be made, and all caveats relating thereto, shall be lodged at the office of the commissioners, and shall be referred to the attorney-general, provided that every such disclaimer or memorandum of alteration shall be filed in the office of the commissioners with the specifications to which the same relates, provided also that such filing of any disclaimer or memorandum of alteration in pursuance of the leave of the law officer in the first recited Act mentioned certified as therein mentioned shall, except in cases of fraud, be conclusive as to the right of the party to enter such disclaimer or memorandum of alteration under the Acts aforesaid and this Act, and no objection shall be allowed to be made in any proceeding upon or touching such letters patent, specification, disclaimer or memorandum of alteration, on the ground that the party entering such disclaimer or memorandum of alteration had not sufficient authority in that behalf, provided also that no action shall be brought upon any letters patent in which or on the specification of which any disclaimer or memorandum of alteration shall have been filed in respect of any infringement committed prior to the filing of such disclaimer or memorandum of alteration, unless the attorney-general shall certify in his fiat that any such action may be brought, notwithstanding the entry or filing of such disclaimer or memorandum of alteration.

37. *Provisions of 5 & 6 W. 4, c. 83, 2 & 3 Vict. c. 67, and 7 & 8 Vict. c. 69, as to confirmation and prolongation, to apply.* All the provisions of the said Act of the fifth and sixth years of King William the Fourth for the confirmation of any letters patent and the grant of new letters patent, and all the provisions of the said Act, and of the Acts of the session holden in the second and third years of Her Majesty, chapter sixty-seven, and of the session holden in the seventh and eighth years of Her Majesty, chapter sixty-nine, respectively relating to the prolongation of the term of

letters patent and to the grant of new letters patent for a further term, shall extend and apply to any letters patent granted under the provisions of this Act, and it shall be lawful to grant new letters patent as in the said Acts mentioned, provided always that such new letters patent shall be sealed and bear date as of the day after the expiration of the term of the original letters patent which may first expire.

38. *Actions for infringement to be regulated by "Code of Civil Procedure."* All actions for the infringement of letters patent granted under the authority of this Act shall be regulated by the provisions of "The Code of Civil Procedure."

39. *Supreme Court may grant injunctions, &c.* In any action in the Supreme Court for the infringement of letters patent, it shall be lawful for the court if it be then sitting, or, if the court be not sitting, for a judge of such court, on the application of the plaintiff or defendant respectively, to make such order for an injunction, inspection or account, and to give such direction respecting such action, injunction, inspection, and account, and the proceedings therein respectively, as to such court or judge may seem fit.

40. *Fees on letters patent to be as in schedule.* There shall be paid to the clerk of the commissioners in respect of letters patent applied for or issued, as herein mentioned, the filing of specifications and disclaimers, certificates, entries and searches, and all other matters and things mentioned in the schedule to this Act, such fees as are mentioned in the said schedule, and such fees shall be payable into the public treasury of the presidency where such letters patent shall be applied for or issued, save and except such portions thereof as may be allotted under section 42 of this Act.

41. *Fees to attorney-general, in cases of opposition, &c.* In cases of opposition to the granting of letters patent, and in case of disclaimers and memoranda of alterations, such fees shall be paid to the attorney-general as may be appointed by the commissioners as the fee to be paid on the hearing of such oppositions, and in the case of disclaimers and memoranda of alterations respectively, and such reasonable sums for office or other copies of documents in the office of the commissioners, as the commissioners may from time to time appoint to be paid for such copies, and the commissioners are hereby authorized and empowered to appoint the fees to be so paid in respect of such oppositions, disclaimers and memoranda of alterations respectively, and for such office and other copies.

42. *Fees of clerk.* It shall be lawful for the commissioners to

allot to the clerk such portions of the fees received by them as they may deem right.

43. *Forms in schedule may be used.* The several forms in the schedule to this Act may be used for and in respect of the several matters therein mentioned, and the commissioners may where they think fit vary such forms as occasion may require, and cause to be printed and circulated such other forms as they may think fit to be used for the purposes of this Act.

44. *Interpretation of terms.* In the construction of this Act the following expressions shall have the meanings hereby assigned to them, unless such meanings be repugnant to or inconsistent with the context. That is to say:—The expression “Governor” shall mean the officer administering the general government of the colony; the expression “the commissioners” shall mean the commissioners for the time being acting in execution of this Act; the expression “invention” shall mean any manner of new manufacture, the subject of letters patent and grant of privilege within the meaning of the existing law of England governing this subject; the expressions “petition,” “declaration,” “provisional specification,” “warrant,” and “letters patent,” respectively, shall mean instruments in the form and to the effect in the schedule hereto annexed, subject to such alterations as may from time to time be made therein under the powers and provisions of this Act.

45. *Short title.* This Act may be cited as the “Patent Law Act, 1876.”

46. *Commencement of Act.* This Act shall commence and take effect on such day as shall hereafter be fixed by proclamation under the hand of the Governor, to be published in the Gazette.

THE SCHEDULE TO WHICH THIS ACT REFERS.

	<i>Fees to be paid.</i>		
	£	s.	d.
On leaving petition for grant of letters patent.	2	10	0
On notice of intention to proceed with the application.	2	10	0
On sealing of letters patent.	5	0	0
On filing specification.	5	0	0
At or before the expiration of the third year.	10	0	0
At or before the expiration of the seventh year.	20	0	0

	£	s.	d.
On leaving notice of objections.	2	0	0
Every search and inspection.	0	1	0
Entry of assignment or license.	0	5	0
Certificate of assignment or license	0	5	0
Filing application for disclaimer.	3	0	0
Caveat against disclaimer.	1	0	0
The following fees shall be paid to the attorney-general:—			
On every application for letters patent referred to attorney-general under section 7.	3	0	0
Examining provisional specification under section 8.	5	0	0
“ amended “ “	1	0	0
“ complete specification under sections 9 and 13.	5	0	0
Perusing particulars of objections under section 13.	2	0	0
Certificate of allowance.	3	0	0
Every certificate under section 14.	1	0	0
“ order for costs “	1	0	0
“ warrant for the sealing of letters patent under section 15.	5	0	0
Considering application for disclaimer or memorandum of alteration under section 36.	2	0	0
Every certificate or fiat that action may be brought under section 36.	3	0	0



FORMS.

Petition.

No. .

To

The humble petition of [*here insert name and address of petitioner*] for, &c.

SHOWETH,

That your petitioner is in possession of an invention for [*title of the invention*], which invention he believes will be of great public utility; that he is the true and first inventor thereof, and that the same is not in use by any other person or persons, to the best of his knowledge and belief.

Your petitioner therefore humbly prays that will be pleased to grant unto him, his executors, administrators, and assigns, letters patent for the Leeward Islands for the term of fourteen years, pursuant to the statute in that case made and provided.

And your petitioner will ever pray, &c.

Declaration.

No.

I of , do solemnly and sincerely declare that I am in possession of an invention for, &c. [*the title as in petition*] which invention I believe will be of great public utility; that I am the true and first inventor thereof; and that the same is not in use by any other person or persons, to the best of my knowledge and belief [*where a complete specification is to be filed with the petition and declaration, insert these words: “and that the instrument in writing under my hand and seal hereunto annexed, par-*

particularly describes and ascertains the nature of the said invention, and the manner in which the same is to be performed"], and I make this declaration, conscientiously believing the same to be true.

Declared at this day of A. D. before me, A. B.

Provisional specification.

No.

I do hereby declare the nature of the said invention for [*insert title as in petition*] to be as follows [*here insert description*].

Dated this day of A. D.

[To be signed by applicant or his agent.]

Reference.

(*To be indorsed on the petition.*)

The governor is pleased to refer this petition to the attorney-general, to consider what may be properly done therein.

Clerk of the commissioners.

Warrant.

In humble obedience to command referring to me the petition of of , to consider what may be properly done therein; I do hereby certify as follows: that the said petition sets forth that the petitioner [*allegations of the petition*] And the petitioner most humbly prays [*prayer of the petition*].

That in support of the allegations contained in the said petition, the declaration of the petitioner has been laid before me, whereby he solemnly declares, that [*allegations of the declaration*].

That there has also been laid before me [*a provisional specification signed and also a certificate*] or [*a complete specification, and a certificate of the filing thereof*] whereby it appears that the said invention was provisionally protected [*or protected*] from the day of A. D. in pursuance of the statute.

That it appears that the said application was duly advertised:

Upon consideration of all the matters aforesaid, and as it is entirely at the hazard of the said petitioner whether the said invention is new, or will have the desired success, and as it may be reasonable for Her Majesty to encourage all arts and inventions which may be for the public good, I am of opinion that the Governor may grant letters patent unto the petitioner, his executors, administrators and assigns, for his said invention within the Leeward Islands, for the term of fourteen years, according to the statute in that case made and provided, if his Excellency shall be graciously pleased so to do, to the tenor and effect following [*see next form*].

Given under my hand and seal this day of A. D.

[Seal of the commissioners.]

Letters patent.

VICTORIA, by the grace of God, of the United Kingdom of Great Britain and Ireland, Queen, Defender of the Faith;

To all to whom these presents shall come, greeting:

Whereas hatin, by his petition, humbly represented to Us that he is in possession of an invention for

which the petitioner conceives will be of great public utility ; that he is the true and first inventor thereof ; and that the same is not in use by any other person or persons, to the best of his knowledge and belief ; the petitioner therefore most humbly prayed that We would be graciously pleased to grant unto him, his executors, administrators, and assigns, Our royal letters patent for the sole use, benefit, and advantage of his said invention within Our Leeward Islands, for the term of fourteen years, pursuant to the statutes in that case made and provided :

[*And whereas the said hath particularly described and ascertained the nature of the said invention, and in what manner the same is to be performed, by an instrument in writing under his hand and seal, and has caused the same to be duly filed in*].

And We, being willing to give encouragement to all arts and inventions which may be for the public good, are graciously pleased to condescend to the petitioner's request : Know ye, therefore, that We, of Our especial grace, certain knowledge, and mere motion, have given and granted and by these presents, for Us, Our heirs and successors, do give and grant unto the said his executors, administrators, and assigns, Our especial license, full power, sole privilege and authority, that he, the said his executors, administrators, and assigns, and every of them by himself and themselves, or by his and their deputy or deputies, servants or agents, or such others as he the said his executors, administrators, or assigns, shall at any time agree with and no others from time to time, and at all times hereafter during the term of years herein expressed, shall and lawfully may, make, use, exercise, and vend, his said invention within Our said Leeward Islands, in such manner as to him the said his executors, administrators, and assigns, or any of them, shall in his or their discretion seem meet, and that he the said his executors, administrators, and assigns, shall and lawfully may have and enjoy the whole profit, benefit, commodity and advantage from time to time coming, growing, accruing, and arising, by reason of the said invention for and during the term of years herein mentioned ; to have, hold, exercise, and enjoy the said licenses, powers, privileges and advantages hereinbefore granted or mentioned to be granted unto the said his executors, administrators, and assigns, for and during, and unto the full end and term of fourteen years from the day of A. D. next, and immediately ensuing according to the statute in such case made and provided ; and to the end, that he the said his executors, administrators, and assigns, and every of them, may have and enjoy the full benefit and the sole use and exercise of the said invention according to Our gracious intention hereinbefore declared. We do by these presents, for Us, Our heirs and successors, require and strictly command all and every person and persons, bodies politic and corporate, and all other Our subjects whatsoever, of what estate, quality, degree, name, or condition soever they be, within Our said Leeward Islands, that neither they nor any of them, at any time during the continuance of the said term of fourteen years hereby granted, either directly or indirectly to make, use, or put in practice the said invention, or any part of the same so attained unto by the said as aforesaid, nor in anywise counterfeit, imitate, or resemble the same, nor shall make or cause to be made any addition thereunto or subtraction from the same, whereby to pretend himself or themselves the inventor or inventors, deviser or devisors thereof, without the consent, license, or agreement of the said his executors, administrators, or assigns, in writing under his or their hands and seals first had and obtained in that behalf, upon such pains and penalties as can or may be

justly inflicted on such offenders, for their contempt of this Our Royal command, and further to be answerable to the said his executors, administrators and assigns, according to law for his and their damages thereby occasioned: and, moreover, We do by these presents for Us, Our heirs and successors, will and command all and singular the magistrates, justices of the peace, and all other officers and ministers whatsoever of Us, Our heirs, and successors, for the time being, that they or any of them do not nor shall at any time during the said term hereby granted, in anywise molest, trouble, or hinder the said his executors, administrators, or assigns, or any of them, or his or their deputies, servants, or agents, in or about the due and lawful use or exercise of the aforesaid invention, or anything relating thereto: Provided always and these Our letters patent are and shall be upon this condition, that if at any time during the said term hereby granted, it shall be made to appear to Our governor of Our said Leeward Islands in council that this our grant is contrary to law, or prejudicial or inconvenient to our subjects in general, or that the said invention is not a new invention as to the public use and exercise thereof, or that the said is not the true and first inventor thereof within the Leeward Islands as aforesaid, these Our letters patent shall forthwith cease, determine, and be utterly void to all intents and purposes, anything herein contained to the contrary thereof in anywise notwithstanding; Provided also that these our letters patent, or anything herein contained, shall not extend, or be construed to extend, to give privilege unto the said his executors, administrators, or assigns, or any of them, to use or imitate any invention or work whatsoever which hath heretofore been found out or invented by any other of Our subjects whatsoever and publicly used or exercised unto whom Our like letters patent or privileges have been already granted for the sole use, exercise and benefit thereof: It being Our will and pleasure that the said his executors, administrators, and assigns, and all and every other person and persons to whom the like letters patent and privileges have been already granted as aforesaid, shall distinctly use and practice their several inventions, by them invented and found out, according to the true intent and meaning of the same respective letters patent, and of these presents, provided likewise nevertheless, and these our letters patent are upon this express condition, that if the said shall not particularly describe and ascertain the nature of his said invention, and in what manner the same is to be performed by an instrument in writing under his hand and seal, and cause the same to be filed in within calendar months next and immediately after the date of these Our letters patent [*and also of the said instrument in writing filed as aforesaid does not particularly describe and ascertain the nature of the said invention and in what manner the same is to be performed*], and also if the said his executors, administrators, or assigns, shall not pay, or cause to be paid, at the office of Our commissioners of patents for inventions the sums following, that is to say, the sum of pounds on or before the day of A. D. , and the sum of pounds on or before the day of A. D. ; and also if the said his executors, administrators, or assigns, shall not supply, or cause to be supplied for Our service, all such articles of the said invention as he or they shall be required to supply by the officers or commissioners administering the department of Our service for the use of which the same shall be required in such manner, at such times, and at and upon such reasonable prices and terms as shall be settled for that purpose by the said officers or commissioners requiring the same; that then and in any of the said cases these Our letters patent and all liberties and advantages whatsoever

hereby granted shall utterly cease, determine, and become void, anything hereinbefore contained to the contrary thereof notwithstanding, Provided that nothing herein contained shall prevent the granting of licenses in such manner and for all such considerations as they may by law be granted; and lastly, We do by these presents for Us, Our heirs and successors, grant unto the said his executors, administrators, and assigns, that these Our letters patent on the filing thereof shall be in and by all things good, firm, valid, sufficient, and effectual in the law according to the true intent and meaning thereof; and shall be taken, construed, and adjudged in the most favorable and beneficial sense for the best advantage of the said his executors, administrators, and assigns, as well in all Our courts of record as elsewhere, and by all and singular the officers and ministers whatsoever of Us, Our heirs and successors in Our said Leeward Islands, and amongst all and every the subjects of Us, Our heirs and successors whatsoever and wheresoever, notwithstanding, the not full and certain describing the nature or quality of the said invention, or of the materials thereunto conducing and belonging.

In witness whereof We have caused these Our letters to be made patent this
 day of A. D. , and to be sealed and bear date as of the said
 day of A. D. in the year of Our reign.

—

Specification.

To all to whom these presents shall come, I , of , send greeting.

Whereas His Excellency , Governor of the Leeward Islands, by letters patent bearing date the day of A. D. in the year of Her Majesty's reign, did for Her Majesty, her heirs and successors, give and grant unto me, the said , his special license that I the said my executors, administrators, and assigns, or such others as I the said my executors, administrators, and assigns, should at any time agree with and no others, from time to time, and at all times thereafter during the term therein expressed, should, and lawfully might make, use, exercise and vend, within the colony of the Leeward Islands, an invention for [*insert title as in letters patent*] upon the condition (amongst others) that I the said by an instrument in writing under my hand and seal, should particularly describe and ascertain the nature of the said invention, and in what manner the same was to be performed, and cause the same to be filed in within calendar months next, and immediately after the date of the said letters patent: Now know ye that I, the said , do hereby declare the nature of my said invention, and in what manner the same is to be performed, to be particularly described and ascertained in and by the following statement (that is to say) [*describe the invention*].

In witness whereof I, the said *A. B.*, have hereto set my hand and seal this
 day of A. D. *A. B.*

From *Carp. Pat. L. of World*, 330; condensing some lengthy section captions.

An Act to amend the Act No. 12 of 1876, entitled "An Act for Amending the Law for Granting Patents for Inventions." No. 16 of 1878.

Whereas it is expedient to amend the law concerning letters patent for inventions.

Be it enacted by the Governor and General Legislative Council of the Colony of the Leeward Islands as follows:—

1. *Certain persons constituted commissioners of patents for inventions, three of whom may act, the attorney-general being one.* Her Majesty's attorney-general, the auditor-general, and the treasurer of the presidency of Antigua for the time being respectively, together with such other person or persons as may be from time to time appointed by the Governor, shall be commissioners of patents for inventions, and every person so appointed shall continue to hold office during Her Majesty's pleasure; and all the powers vested in the commissioners by the Act No. 12 of 1876 may be executed by any three or more of them, of whom the attorney-general shall be one.

2. *Applications for letters patent, &c., to be advertised.* Every provisional protection, every protection on deposit of a complete specification, and every application for letters patent, shall be advertised in the Royal Gazette and in one of the public newspapers in each presidency of the Colony, or where there shall be no such newspaper, then by being attached to the door of the court-house in the principal town of the presidency.

3. *Copies of specifications, &c., to be enrolled in each presidency.* In addition to the copies prescribed by the above recited Act to be kept at the office of the commissioners, true copies of all specifications (other than provisional specifications), disclaimers, and memoranda of alterations filed in pursuance of the said Act, and of all provisional specifications after the expiration of the term of protection, shall be enrolled in the registrar's office in every presidency of the Colony (Antigua excepted), and shall be open to the inspection of the public at all reasonable times, subject to such regulations as the commissioners may think necessary.

4. *Registers of patents and proprietors to be kept in each presidency.* A true copy of the "Register of Patents" and of the "Register of Proprietors" prescribed by sections 32 and 33 of the above recited Act, shall be kept at the registrar's office in each

presidency of the Colony, and shall be open to the inspection of the public at all reasonable times, subject to such regulations as the commissioners may think necessary.

5. *Section 1 of Act 12, 1876, repealed.* The first section of the Act No. 12 of 1876 is hereby repealed.

From *Carpmaels' Pat. L. of World*, 351.

The act for the federation and general Government of the Leeward Islands, 21 August, 1871, Stat. 34 & 35 Vict. c. 107, recites that the several legislative bodies of these islands have, by certain resolutions, signified their desire for a union of the islands under one Government; and it enacts that they shall form one colony consisting of six presidencies, namely: the several islands of Antigua, Montserrat, Saint Christopher, Nevis and

Dominica, with their respective dependencies, and the Virgin Islands. The Act authorizes the Governor, with the consent of the General Legislative Council (subject to provisions making the Royal assent necessary to the validity of such laws), to make laws for the Leeward Islands or any part thereof, upon many subjects specified, among which are: "16. Copyrights and Patents."

LIBERIA.

An Act to Promote the Progress of the Arts, Manufactures, Agriculture, and Commerce, December 23, 1864.

It is enacted by the Senate and House of Representatives of the Republic of Liberia in Legislature assembled :

SECTION 1. That there shall be established an office to be termed the patent-office, which shall be under the control of the secretary of state, whose duty it shall be to superintend, execute, and perform all such acts and things touching and respecting the granting and issuing of letters patent for new and useful discoveries, inventions, and improvements, as are hereby provided for, or shall hereafter be by law directed to be done and performed, and shall have charge and authority of all books, records, papers, and all other things belonging to the said office.

SEC. 2. It is further enacted that all patents, issuing from the said office shall be issued in the name and under the seal of the Republic of Liberia, and be signed by the President of the Republic, and countersigned by the secretary of state, and shall be recorded, together with descriptions, specifications, and drawings in the said office, in books to be kept for that purpose. Every such patent shall contain a short title of the invention or discovery, correctly indicating its nature and design, and its terms, grant to the applicant or applicants, his or their heirs, administrators, executors, or assigns, for a term not exceeding twenty 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 specifications with the illustrative drawings shall be annexed to the patent specifying what the patentee claims as his invention or discovery.

SEC. 3. It is further enacted that any citizen or citizens having discovered or invented any new and useful art, machine, manufacture, process, composition of matter, or any new and useful improvement in any art, machine, manufacture, process or composition of matter, or having invented or discovered a new and useful application of any known substance or matter, or composition of matter, or any new and useful application of any known article of manufacture, device, or apparatus, to any art, manufacture

machine, process, or composition of matter, such invention or discovery, or such application not being known or used by others within the limits of this republic, and not being described in any book or other publication in this country, before his or their discovery thereof, may make application in writing to the secretary of state, expressing such desire, and the secretary of state may on due proceedings had, grant a patent therefor; but before any inventor shall receive a patent for any such invention, discovery or new application, he shall deliver a written description thereof, and of the manner and process of making, constructing, using, applying, and compounding the same, in such full, clear, 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, apply, compound, and use the same, 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. The applicant shall furthermore make oath or affirmation that he does verily believe that he is the original and first inventor or discoverer of the art, machine, composition, application, or improvement for which he solicits a patent, and that the same was not known or used within the limits of the Republic of Liberia prior to his said invention, and that he is a citizen of this republic, the said oath or affirmation to be taken before any person authorized by law to administer oaths.

SEC. 4. It is further enacted that on filing such application, description, and specifications, and the payment of the fees hereinafter provided, the secretary of state shall make or cause to be made an examination of the alleged new invention or discovery, and if it should appear to the secretary of state that the same had not been invented or discovered, or known by any other person in this country, and had not been described in any book or other publication in this country prior to the discovery thereof of the applicant, then it shall be the duty of the secretary of state to issue a patent therefor; but whenever it shall appear to the secretary of state that the applicant was not the first inventor or discoverer thereof, or that what is claimed as new had been known to others in this country, or had been described in some publication in this country prior to the time of the alleged invention or discovery of

the applicant, then it shall be the duty of the secretary of state to refuse the grant of letters patent to the applicant therefor.

SEC. 5. It is further enacted that if any alien or aliens shall have invented or discovered any new art, machine, manufacture, process, or composition of matter, or any new and useful improvement of any art, machine, manufacture, process, or composition of matter, or has invented or discovered a new and useful application of any known substance or machine or composition of matter, or any new and useful application of any known article of manufacture, device, or apparatus to any art, manufacture, machine, process, or composition of matter, such invention or discovery, or such application, not having been known or used by others within the limits of this republic, or if any alien or aliens shall be the legal owner or owners of such invention or discovery, on application, and shall express a desire to introduce the same and put it into active operation in this country, then it shall be the duty of the secretary of state, on due proceedings held, as provided for in third section of this act, to issue letters patent therefor ; but before letters patent can be granted to such applicant he shall deliver, with the description of the invention or discovery claimed, a certificate signed and sealed by the mayor or governor of the city or state in which he resides, or by a duly authorized notary public, which certificate shall set forth that the applicant is the original and first discoverer of the thing claimed, or that he has purchased the right, title, and interest in this country to the said invention or discovery.

SEC. 6. It is further enacted that when any alien or aliens shall have obtained letters patent for any invention or discovery it shall be his or their duty to put the same in active operation in this republic within three years from the date of the said patent, and any refusal or neglect on the part of the patentee to do this shall be considered as an abandonment by him of his patent to the public.

SEC. 7. It is further enacted that before any application for a patent shall be considered by the secretary of state, the applicant shall pay into the treasury or into the office of the secretary of state, to the credit of the treasury, if he be a citizen of this republic, the sum of twenty-five dollars ; if he be an alien, the sum of fifty dollars ; and the moneys received under this act shall constitute a fund for the payment of salaries of such assistants as the

secretary of state may deem necessary for carrying this act into effect.

SEC. 8. It is further enacted that every patent shall be assignable in law, either as to the whole interest or any individual part thereof, by any instrument of 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 the whole or any specified portion of the Republic of Liberia, shall be recorded in the office of the secretary of state within one year from the execution thereof.

SEC. 9. It is further enacted that all actions for damages for infringement, using, or selling the thing whereof the exclusive right is granted by any patent, and all suits, controversies, and cases arising under this act shall be cognizable, as well in equity as at law, by the Supreme Court of the Republic of Liberia.

SEC. 10. It is further enacted that it shall be the duty of the secretary of state to make, or cause to be made, exact copies of all patents issued, and also of all drawings appertaining to the said patents, which copies shall be properly classified and shall be retained as permanent records in the office of the secretary of state, and the said copies shall be open for inspection at reasonable hours to all who may desire to peruse the same. And it shall furthermore be the duty of the secretary of state to furnish, on reasonable terms, certified copies of any patents or documents relating thereto.

From 31 *Pat. Off. Gaz.* 1446.

LICHTENSTEIN.

See AUSTRIA-HUNGARY.

LOYALTY ISLANDS.

See FRANCE.

LUXEMBURG.

*Law of June 30, 1881.**

We, William the 3d, by the grace of God, King of the Low Countries, Prince of Orange, Nassau, Grand Duke of Luxemburg, &c.

Our Council of State heard, &c., &c., have ordered and do order :

CHAPTER I.

GENERAL DISPOSITIONS.

ARTICLE 1. Patents for new inventions susceptible of being worked industrially shall be granted, with the following exceptions: First. Inventions the working of which would be contrary to the law or good morals. Second. Those inventions which have for their object food or other objects of consumption, pharmaceutical products, or substances obtained by chemical means. Nevertheless this exception does not apply to any special process for manufacturing these objects.

ART. 2. An invention is not considered new when at the moment the declaration is made under the present law (date of application for a patent) it is found to be already so clearly described in any printed matter open to the public, or so openly worked in either the Grand Duchy or any of the States of the German custom-house union, as to render it possible for execution by other persons expert in the trade to which it refers.

ART. 3. The right of obtaining a patent appertains to the one who first declares to the invention in accordance with the present law, subject, however, to what is enacted herein, article 16, No. 2.

ART. 4. The effect of a patent shall be that without the authority of the patentee or owner no one shall be allowed industrially to make, put into commerce, or expose for sale the object of the invention. If the object of the invention be a process, a machine, or any industrial engine, a tool or other instrument of labor, the effect of the patent will be, further, that without authorization of the patentee

* A slightly differing translation of the same law may be found in *Carp. Pat. L. of World*, 341.

or owner no one can industrially apply the process or make use of the object of the invention.

ART. 5. The effect of the patent does not apply to any one who at the moment when the applicant made his declaration had already worked the invention in the Grand Duchy, or who had already made the necessary arrangements to this end. The effect of the patent does not extend to locomotive rolling-stock which only enter to pass through the Grand Duchy. A patent will cease to be effective as soon as a royal Grand Ducal decree, upon the advice of the Council of State, shall have declared that it is to the public interest that the patent shall be worked. In this case the patentee has a right, at the expense of the state, to an indemnity which, in default of agreement, shall be fixed judicially.

ART. 6. The right of obtaining a patent like the rights to the patent itself, shall extend to the heirs or legal representatives of the person having such right. These rights can be transferred in whole or in part by deed or by will. The act of transmission by will is free of all duty. Deeds of assignment are registered at a fixed tax of 1 franc 70 centimes.

ART. 7. The duration of the patent is fifteen years. This period runs from the morrow of the day on which the invention has been declared, conformably to article 10 of the present law. If the invention consists in an improvement on another invention, for which latter the applicant has already protection in the Grand Duchy, he can apply for the grant of a certificate of addition which expires with the principal patent. The certificates of addition taken by one of the persons interested in the principal patent profit all the others.* It will be open to the patentee to take a principal patent for the changes or improvements in his invention. The third party who shall have taken a principal patent for an invention or an application relating to the object of another patent, shall not have the right to exploit the invention already patented; and, on the other hand, the patentee or owner of the primary patent shall not work the invention, the object of the new patent, except by their mutual consent.

ART. 8. An annual and progressive tax, as follows, shall be paid for each patent: First year, 10 francs; second year, 20 francs; third year, 30 francs; and so on till the fifteenth year, for which the

* This has been held to mean that all those interested in the principal patent have an exactly corresponding interest in the patent of improvement.

tax will be 150 francs. The tax will be paid in advance to the receiver at the registry. It will not in any case be reimbursed.* For certificates of addition one tax only of 10 francs will be required.

ART. 9. No one can obtain a patent or exercise the rights of the patent if he have not chosen a domicile in the Grand Duchy. If he be a foreigner, he must choose as his domicile the house of a proxy, who will represent him, and to whom all communications will legally be made. Whatever domicile be chosen will be subject to jurisdiction, and will be a valid one as long as it is not replaced by a new election of domicile, according to article 13.

CHAPTER II.

ON THE DELIVERY OF PATENTS.

ART. 10. Whoever would secure a patent must file his declaration in writing with the functionary, who will be appointed for this purpose by the government. A special declaration is required for each invention. The declaration must contain the full name, address, calling, and chosen domicile of the declarant, and also of his representative, if the case requires such. It must give a title containing a summary and precise description of the object of the invention. The declaration must be accompanied by, first, a description, in the French or German language, of the object invented; second, drawings, models, or samples that may be necessary for the comprehension of the description. The description and the drawings must be in duplicate. The description should be written without alteration or addition; words struck out or erased must be counted and certified, the pages and the references initialed. It should describe the invention in a clear and complete manner, and end with a precise statement of its characteristics. The drawings must be traced with ink to a metrical scale. All the papers must be signed by the declarant, or by his representative, whose power of attorney must be annexed to the declaration.

ART. 11. An application will only be received on the production of the receipt of the payment of the first annual tax. An official statement made without charge, on a register for this purpose, and signed by the declarant, shall authenticate the application while stating the day and the hour of filing of the papers. A

* In the case of two owners of one patent each paying the tax, both payments are retained.

duplicate of the official statement will be transmitted without charge to the deponent.

ART. 12. The patents whose application shall have been in regular form will be delivered, without preliminary examination, at the risk and peril of the applicants, and without guarantee either of the reality of the novelty, or of the meritoriousness of the invention, or of the fidelity or exactness of the description. A certificate of the government official who has charge of the department of commerce and industry certifying the regularity of the application will be delivered without charge to the applicant, and will constitute the patent of invention. To this notice will be added the certified duplicate of the description and of the drawings mentioned in article 10. The same certificate will be inserted in abstract form in the memorial. The refusal of the government to deliver a patent may be appealed against to the litigation committee of the State Council, who will decide on the matter.

ART. 13. Any changes that occur in the ownership of the patent or in the representative or chosen domicile of the patentee, as well as any partial assignment of the patent, should be brought in an authentic form to the notice of the government official who has charge of the department of commerce and of industry, and will be published in the memorial. As long as these formalities are not fulfilled, the person who has been previously designated as the patentee or his representative remains invested with the rights and subservient to the obligations of the present law, and all notifications and announcements will be validly sent to the previously-chosen domicile.

ART. 14. The public will be allowed to inspect in the government bureaus descriptions of granted patents, and copies may be obtained on payment of fees.

CHAPTER III.

EXPIRATION OF PATENTS, NULLITY, AND FORFEITURE.

ART. 15. The patent becomes extinct, first, by the expiration of the time for which it has been allowed; second, by the renunciation of the titular owner; third, by a single failure of payment of the annual tax within the three months from when it becomes due; fourth, if a patent for the same object be not applied for within the space of three months after the application in Luxemburg in the States with which the Grand Duchy may be allied by a custom-house

union, or if, being applied for within this space, the patent be refused, or if, having been allowed, it be revoked, annulled or becomes extinct in any other manner. Nevertheless, in the case where the forfeiture of the patent may be decreed in a country in this union by reason of the patent not being worked, it will be lawful for the government to maintain the patent in the Grand Duchy.

ART. 16. The patent will be null and of no effect if it be proved, first, that according to the terms of articles 1 and 2 the invention was not susceptible of being patented; second, that the essential contents of the declaration were derived from the descriptions, designs, models, instruments, tools, or processes of another party without his consent; third, if the title under which the patent is applied for indicates fraudulently an object other than the veritable object of the invention; fourth, if the description annexed to the patent be not sufficient for the carrying out of the invention, or if it does not show in a loyal and complete manner the true means employed by the inventor.

ART. 17. An action for annulment may be instituted by any interested person. This action, as well as all litigations relative to the property of the patent, will be heard before the civil tribunal of the arrondissement. If the action be directed simultaneously against the titular owner of the patent and against one or more partial assignees, it will be heard before the tribunal for the domicile chosen by the titular owner of the patent. Patent cases will be heard and judged in accordance with the form prescribed for summary proceedings by the article 405 *et seq.* of the Code of Civil Procedure. Notice of the case is to be given to the public minister. The public minister can interfere in the action and take steps to effect a complete declaration of nullity of the patent. He himself may for the same purposes institute an action. In the cases provided for by the two preceding paragraphs all those having a pecuniary interest in the patent whose titles have been registered at the government in conformity with article 13 should be sued. The charges for the interference of the public minister and the proceedings of the office will be taxed, discharged, and collected as in the case of fines. When the absolute nullity of a patent shall have been pronounced by a judicial decree or sentence, notice thereof shall be given to the government, in view of the publication prescribed by article 19.

ART. 18. The patent can be revoked after three years by a royal Grand Ducal decree, subject to an appeal to the litigation commit-

tee of the Council of State, if the patentee neglect to put his invention into operation in the Grand Duchy to a suitable extent, or at least to do everything necessary to insure this working. Likewise, after three years a royal Grand Ducal decree may declare, on the advice of the Council of State, that the public interest requires that the right to work a patented invention may also be conceded to one or several others who have made application therefor. In this case the indemnity and the guarantees due to the patentee by the new claimants will be, in case of non-accord, settled by judicial decision.

ART. 19. The expiration of patents, their annulments, or revocation will be brought to the knowledge of the public by an insertion in the Memorial.

CHAPTER IV.

INFRINGEMENT, PROSECUTION, AND PENALTIES.

ART. 20. Whosoever shall have knowingly made use of an invention contrary to the provisions of the articles 4 and 5 shall be punished by a fine of one hundred francs to two thousand francs without prejudice to the damages that may be obtainable by a civil action. In the case of the repetition of the offense an imprisonment, in addition to the fine, of one month to six months shall be pronounced. A repetition of the offense exists when a first condemnation for the same offense has been given within the five previous years against the defendant. The prosecution shall only be entered on the plaint of the injured party. The tribunal can order the publication of the judgment at the cost of the condemned. The judgment shall direct the mode and the length of time of the publication. The sentence can direct either the destruction or the confiscation, for the profit of the State or for the profit of the injured party, on assessment of damages, of the objects which have been used in, or were destined for, the committal of the offense, and objects which have been produced thereby.

ART. 21. The court for the trial of misdemeanors, before which the action is brought, shall refer the parties to the proper civil judge to decide upon the pleas that shall be advanced by the defendant, either concerning the expiration, the nullity, or the forfeiture of the patent, or concerning any questions relative to the ownership of the patent.

ART. 22. Any person, without having a valid patent, who shall have applied to objects or their packing a notification to the pur-

port that these objects have been patented in conformance with the present law, or who shall have made use of a similar notification in announcements, placards, advertisements, prospectus or signs shall be punished with a fine of from twenty-six francs to two hundred francs.

ART. 23. The penalties established by the present law shall not be cumulative. The highest penalty will only be pronounced for the entire set of infringements made prior to the action.

ART. 24. The provisions in vigor relative to extenuating circumstances can be applied to offenses coming within the preceding provisions.

ART. 25. Civil actions on account of the violation of the patent rights must be commenced within three years from the date of the infringements on which the actions are founded.

CHAPTER. V.

TRANSITORY PROVISIONS.

ART. 26. The law of January 25, 1817, and all provisions anterior to the present law relative to patents of invention, of importation, and of improvements are abrogated. Nevertheless, the patents actually in force will continue to be governed by the provisions in vigor at the moment of their delivery, unless their holders conform to the provisions that follow.

ART. 27. The holders of patents actually in force shall be allowed to convert them into patents governed by the present law, if they, within three months from the publication of the present law, make their declaration to this effect in conformance with what is prescribed by article 10, saving that it will suffice for them to join thereto the original patent and its annexes. The term of fifteen years, fixed by article 7, shall run from the date of the original patent. The annual taxes will be counted as due on the same date, on which date also the annual expirations (in default of payment) will be regulated. The tax paid for the original patent shall be placed to the account of the annuities already due or to become due. If it be not sufficient to cover the annuities already due, the difference must be paid before the deposit of the declaration.

ART. 28. The applications for patents filed previous to the present law, and about which we have not yet decided, must be changed by their inventors within three months from the publication of the present law into applications, according to the provisions of the

foregoing chapter II., under pain of forfeiture of the original application. The patents whose delivery is to take place shall be governed by the present law, still the time elapsed since the original application will be deducted from the term of fifteen years fixed by article 7.

ARR. 29. The publication of descriptions and the open working mentioned in article 2 can only be urged against those to whom patents have been delivered in accordance with the preceding articles 27 and 28, if the publication of such descriptions or such working was anterior to the date of the original patent, and if at the date of the deposit of the (renewed) application the matter had not previously been adjudicated upon.

ART. 30. A Royal Grand Ducal decree, issued in due order by the administration, will fix the provisions that the execution of the present law will render necessary.

Commanded and ordained that the present law be inserted in the "Memorial," to enable it to be carried out and observed by all those whom it may concern.

Signed at Loo, June 30, 1881.*

WILLIAM.

F. DE BLOCHAUSEN,

The Minister of State, President of the Government.

PAUL EYSCHEN,

The Director-General of Justice.

From 34 *Pat. Off. Gaz.* 341.

MANITOBA.

See CANADA.

MARQUESAS ISLAND.

See FRANCE.

MARTINIQUE.

See FRANCE.

* Messrs. Carpmael give the date of this law as June 30, 1880.

MAURITIUS.

Ordinance No. 16 of 1875.

Whereas it is expedient that certain privileges be granted to inventors, and that the same be regulated and protected: Be it enacted by his Excellency the Governor [of Mauritius and its Dependencies] with the advice and consent of the Council of Government, as follows:

1. *Privilege granted to inventors.* Every inventor of any manufacture shall be entitled, under the conditions and restrictions hereinafter enacted, to the sole exclusive right of and in such new invention.

2. *Definitions of words.* Within the meaning of the word "invention" are included discoveries, and also the invention of new chemical products; also every new mode of application of known processes or forces whereby a new product or preparation is obtained or made; and also every new process or force whereby an old product or preparation is obtained or made.

Improvements are also included within the word "invention."

The word "manufacture" shall be deemed to include any art, process, or manner of producing, preparing, or making an article; and also any article prepared or produced by manufacture.

The words "inventor" and "actual inventor" shall include the heirs, executors, administrators, or assigns of an inventor or actual inventor, as the case may be.

The word "assigns" shall include grantees of the sole use or benefit in Mauritius of an invention, or of the sole use of an exclusive privilege for a limited period.

3. *Financial schemes not entitled to privileges.* Financial schemes and operations of credit, whether commercial or industrial, shall not entitle the inventors or promoters thereof, or parties interested therein, to obtain any exclusive right or privilege.

4. *Patents may be granted, and extended, when.* The right and privilege granted to inventors shall be conferred by a patent under the seal of the colony, whereby the inventor shall be entitled to the sole and exclusive privilege of making, selling, and using his said invention in the Colony of Mauritius, and of authorizing others so to do, for the term of fourteen years from the date of the patent,

and for such further term, if any, not exceeding fourteen years from the expiration of the first fourteen years, as the Governor in Executive Council may think fit to direct, upon petition to be presented by such inventor, at any period not more than one year and not less than six calendar months before the expiration of the exclusive privilege first granted.

5. *Petition and specification to be filed.* Every inventor desirous of obtaining a patent as aforesaid shall file in the office of the colonial secretary a petition signed by him, or, if he be absent from this Colony, by an authorized agent; such petition shall state the names, additions, place of abode of the petitioner, and the nature of the invention. To the petition shall be annexed a specification in writing; such specification shall be signed by the petitioner or authorized agent as aforesaid, and shall particularly describe and ascertain the nature of the said invention, and in what manner the same is to be performed. With the specification shall be filed all diagrams, plans, and drawings whereby the nature of and the mode of working the invention can be best described and ascertained.

6. *Declaration to accompany petition.* Every petition or specification shall be accompanied by a declaration in writing, signed by the petitioner or authorized agent as aforesaid, in the form and to the effect mentioned in schedule A. hereunto annexed.

7. *Consequences of willfully false statements.* If any person who shall make a declaration under this ordinance shall willfully and corruptly make any false statement, he shall be deemed guilty of perjury, and upon conviction be liable to imprisonment not exceeding two years, without prejudice to any action or suit which the injured party or parties may bring against him.

8. *Procureur general's certificate and interim protection.* When any applicant has filed his petition and specification with the view of obtaining a patent, the same shall be referred to the procureur general, and if he approve of them as *primâ facie* entitled to protection, he shall issue his certificate to that effect, and the inventor shall be provisionally protected.

Provided that, should the procureur general refuse to issue his certificate, the party aggrieved may apply to the Governor in Executive Council, who shall have the power to decree that the certificate do issue; and it shall then be issued by the secretary of the Executive Council.

It shall then be the duty of the applicant to cause, within two months of the certificate, the application to be advertised in the

government Gazette, with a view of giving persons who have an opposite interest the opportunity of objecting to the patent being granted. If no opposition be made within one calendar month of the advertisement, the patent shall issue; if there be opposition made, the matter will be referred to the procureur general, who, if the applicant and opposing party or parties are satisfied that his decision shall guide them, shall decide finally; but who shall otherwise refer the matter to the Supreme Court for decision.

The Supreme Court may hear and determine the case upon a motion to show cause why the patent applied for should not issue.

Upon the fiat of the procureur general, or, as the case may be, the rule of the Supreme Court, the patent shall issue, or the interim protection cease and determine.

9. *Opposition how lodged; grounds of objection.* Any party or parties intending to oppose the issuing of the patent shall be bound within the above mentioned delay to notify his or their opposition to the colonial secretary. The opposition shall contain the grounds of objection, and no other objections than those specified in the opposition shall be taken notice of either by the procureur general or the Supreme Court, as the case may be.

10. *Form and cost of certificate.* The certificate of the procureur general to entitle the applicant to interim protection shall be in the form in schedule B. hereunto annexed. When from any cause prevented from acting, the procureur general may delegate the substitute procureur general to act in his stead.

Every certificate shall issue upon payment of a fee of ten pounds sterling to be paid to the receiver general.

11. *Government gives no warranty; seal.* Every patent shall as heretofore be granted without any warranty of any kind or nature whatsoever on the part of the government; and every person entitled to a patent shall, before his patent is sealed, pay the sum of two pounds sterling to the receiver general.

12. *Printed copies to be filed, and a book to be kept.* Before the patent is sealed, the person entitled to the patent shall deposit in the office of the colonial secretary a printed copy of every such petition and specification.

A book shall also be kept in the office of the said colonial secretary wherein shall be filed and recorded every such original petition and specification, and every order made upon such petition or relating to the invention therein related. Every specification shall be numbered according to the order in which it is entered in such

book, and a reference shall be made in such book, in the margin of the entry of such specification, to every order relating to the invention, and to every petition, memorandum, or amended specification which shall be filed under the provisions of article 15.

13. *Book open to all persons.* Such book or printed copy as aforesaid shall be open at all convenient times for the inspection of any person, upon payment of a fee of four shillings, and the said colonial secretary shall cause a copy of any entry therein, certified under his hand, or the hand of the assistant colonial secretary, to be an examined copy, to be given to any person requiring the same, on payment of the expense of copying, at the rate of fourpence sterling per folio of ninety words.

14. *Copies to be evidence.* Printed or manuscript copies, certified to be examined copies by the colonial secretary or assistant colonial secretary, of letters patent, specifications, disclaimers, *memoranda* of alterations, and all other documents filed in the colonial secretary's office, shall be received in evidence, in all proceedings relating to letters patent, in all courts whatever in the colony of Mauritius, without further proof or production of the originals.

15. *Amended specification to be filed, when and how.* If after the filing of the specification the petitioner shall have reason to believe that through mistake or inadvertence he has erroneously made any mis-statement in his petition or specification, or included therein something which at the date of his petition was not new or whereof he was not the inventor, or that such specification is in any particular defective or insufficient, he may petition the Governor in Executive Council for leave to file a memorandum pointing out such error, defect or insufficiency, or disclaiming any part of the alleged invention ; or, in case of any defect or insufficiency in the specification, for leave to file an amended specification. The petition shall state how the error, defect, or insufficiency occurred, and that it was not fraudulently intended, and shall be accompanied by a declaration in writing, signed by the petitioner or authorized agent as aforesaid, stating that the contents of such petition are true to the best of his knowledge and belief. Upon such petition the Governor in Executive Council may make an order allowing such memorandum or amended specification to be filed. All the provisions of article 7, 8, 12, 13, and 14, shall be applicable to petitions, memoranda, amended specifications, or orders referred to in this article. An amended specification under the provisions of this

ordinance shall, except as to suits and proceedings relative to the exclusive privilege which shall be pending at the time of such amended specification, have the same effect as if it had been the specification first filed ; provided that nothing in an amended specification shall extend or enlarge any exclusive privilege before acquired.

16. *Patents not to be granted, in what cases.* No person shall be entitled to a patent under this ordinance,—

(a) If the invention is of no utility ;

(b) If the invention at the time of presenting the petition was not a new invention within the meaning of this ordinance ;

(c) If the petitioner is not the inventor thereof ;

(d) If the specification filed, or the amended specification if any, does not particularly describe and ascertain the nature of the invention, and in what manner the same is to be performed ;

(e) If the original or any subsequent petition relating to the invention, or the original or amended specification, contain a willfully fraudulent statement.

17. *Patents, if prejudicial to the public, to be withdrawn.* Every patent for an exclusive privilege under this ordinance shall be invalid and of no effect if it be proved to the satisfaction of the Governor in Executive Council that the same or the mode in which it is exercised is mischievous to the Colony or generally prejudicial to the public ; or if the patentee shall to the satisfaction of the Governor in Executive Council be proved guilty of the breach of any special condition under which the patent originally issued or was extended. Notice of the withdrawal of the patent, and the cause thereof, shall be inserted in the government Gazette.

18. *No patent when foreign patent has expired.* No patent shall be granted for an invention in respect whereof a patent has been granted out of this Colony and has expired.

19. *Assignments to be registered and transcribed.* No patent shall be held as to third parties to have been duly assigned unless the assignment be registered and transcribed at the mortgage office.

20. *Patents in joint names of several inventors.* When more persons than one have been concerned in making an invention the patent must be taken out in their joint names.

21. *Patents, what they may include.* No patent will be allowed to include several distinct and separate inventions, but where one invention is applicable to the improvement of several manufactures, or where several inventions are applicable to the improvement of

one and the same manufacture, the whole may be included in one patent.

22. *No patent except to actual inventor for imported inventions.* The importer into Mauritius of a new invention shall not be deemed an inventor within the meaning of this ordinance, unless he be the actual inventor.

23. *Foreigners entitled to patents.* A foreigner, whether resident abroad or not, may obtain a patent under this ordinance, provided he comply with the provisions of this ordinance.

24. *Inventions deemed new inventions, when.* An invention shall be deemed a new invention within the meaning of this ordinance, if it shall not, before the time of filing the petition as aforesaid, have been publicly used in Mauritius or in any part of the United Kingdom of Great Britain and Ireland, or been made publicly known in Mauritius or the United Kingdom by means of a publication either printed or written, or partly printed and partly written.

The public use or knowledge of an invention prior to the filing of the petition as aforesaid shall not be deemed a public use or knowledge within the meaning of this article if the knowledge shall have been obtained surreptitiously or in fraud of the inventor, or shall have been communicated to the public in fraud of the inventor, or in breach of confidence; provided the inventor shall, within six calendar months after the commencement of such public use, file his petition for a patent, and shall not previously have acquiesced in such public use.

Provided also, that the use of an invention in public by the inventor thereof, or by his servants or agents, or by any other person with his license in writing, for a period not exceeding one year prior to the date of the petition, shall not be deemed a public use thereof within the meaning of this ordinance.

25. *Holder of letters patent to take a patent, when and how.* If an inventor has obtained Her Majesty's letters patent for the exclusive use of an invention in the United Kingdom, he may obtain a patent in Mauritius under this ordinance for such invention, provided the application be made within twelve calendar months from the passing of this ordinance, or within twelve calendar months from the date of the letters patent, although previous to the time of his petitioning, such invention may have been publicly known or used in Mauritius; provided such invention was not publicly known or used in Mauritius before the date of the letters

patent, and provided the patent obtained in Mauritius shall cease to have effect if the letters patent are revoked or canceled, and provided the privilege obtained in Mauritius shall not extend beyond the period assigned to the letters patent in the United Kingdom.

26. *Who can use the invention nevertheless.* No privilege obtained under this ordinance shall entitle the owner of such privilege to exclude any person from using the invention who prior to the passing of this ordinance used the same in this Colony.

27. *Actions for infringement ; writ of injunction.* An action may be maintained by an inventor against any person who, during the continuance of any exclusive privilege granted under this ordinance, shall without the license of such inventor, make, use, sell, or put in practice the said invention, or who shall counterfeit or imitate the same ; provided such action be brought before the Supreme Court, and provided the said Supreme Court or a judge in chambers shall have the right, before action brought or pending the action, to issue a writ of injunction restraining the defendant from making use of, selling or putting in practice, the said invention, for such time and under such conditions as to the said court or judge shall seem fit.

28. *Actions ; how they may not be defended.* No such action shall be defended upon the ground of any defect or insufficiency of the invention ; nor upon the ground that the original petition, or any subsequent petition relating to the invention, or the original or any amended specification, contains willful mis-statements ; nor upon the ground that the invention is not useful ; nor shall any such action be defended upon the ground that the plaintiff was not the inventor, unless the defendant shall show that he is the actual inventor, or has obtained the right from him to use the said invention wholly or in part.

But any such action may be defended upon the ground that the invention was not new.

29. *Motion to be made before infringement to cancel patent.* It shall, however, be lawful for any person to apply by motion to the Supreme Court for a rule to show cause why the court should not declare that an exclusive privilege in respect to an invention shall be canceled or revoked under the provisions of this article, by reason of all or any of the objections following, to be specified in the rule ; that is to say,

1. That the said invention is of no utility ;

(2.) That the said invention was not, at the time of filing the petition, a new invention within the meaning of this ordinance ;

(3.) That the patentee was not the inventor thereof ;

(4.) That the patentee did not, in his petition and specification, particularly describe and ascertain the nature of the invention, or in what manner the same is to be performed ;

(5.) That the petitioner has in the petition or specification or amended specification made willful or fraudulent mis-statements ;

(6.) That some part of the invention, or the manner in which that part is to be performed, as described in the specification filed or the amended specification, is not thereby sufficiently described or ascertained, and that such defect or insufficiency was fraudulent or is injurious to the public ;

(7.) That some part of the invention is wholly distinct from the other part, and is of no utility or is not new as aforesaid, or that the petitioner was not the inventor of such part.

30. *Procureur-general may move.* It shall be lawful for the procureur-general to make or direct to be made the application in article 29 mentioned, whenever he shall think it necessary on behalf of the public.

31. *Notice, how served.* Notice of any rule obtained or proceeding taken under articles 29 and 30 shall be served on the patentee ; or, if the patent have been assigned, upon all persons appearing to be proprietors or to have shares or interests in the exclusive privilege conferred by the patent ; and it shall not be necessary to serve such notice on any other person.

32. *What the Supreme Court may not take cognizance of.* It shall not be lawful for the Supreme Court to take cognizance, either in actions for infringement or in motions made to cancel and revoke a patent, of any breaches or grounds of defense but those specified in the declaration and plea, or of any objections but those specified in the rule to show cause.

33. *Supreme Court to hear and determine.* If it shall appear to the Supreme Court that by any of the objections in article 29 mentioned the said exclusive privilege in the invention, or any part thereof, ought to be canceled, the court shall make the rule absolute, with such order as to costs of and consequent upon the application as it may think just ; and thereupon the patentee, his heirs, executors, administrators, or assigns, shall, so long as the judgment continues in force, cease to be entitled to the said exclusive privilege. A copy of the rule certified by the registrar of the Supreme Court

shall be forwarded to the colonial secretary, and annexed to the original petition and specification.

34. *Supreme Court may allow amendments, when and how.* It shall be lawful for the court to adjudge that the exclusive privilege shall not be canceled, save as to the part thereof affected by error, defect, or insufficiency; and also if satisfied that no fraudulent practices were intended, and that the error, defect, or insufficiency can be amended without injury to the public, to order, upon such terms as to the court may appear reasonable, the specification or amended specification to be amended in any particular; and the patentee, his heirs, executors, administrators, or assigns, shall, within the time limited by the said court for the purpose, file a specification amended according to such order; provided that no such amended specification shall have the effect of extending or enlarging the exclusive privilege before acquired.

35. *Short title.* This ordinance may be cited as "the Patents Ordinance."

36. *Repeal clause.* Ordinance No. 11 of 1835 is hereby repealed.

SCHEDULE A.

I of in the district of do solemnly and sincerely declare that I am in possession of an invention for, &c. [*the title as in petition*], which invention I believe will be of great public utility; that I am true and first inventor thereof; and that the same is not in use by any other person or persons, to the best of my knowledge and belief [*where a complete specification is to be filed with the petition and declaration, insert these words: "and that the instrument in writing under my hand, hereunto annexed, particularly describes and ascertains the nature of the said invention and the manner in which the same is to be performed."*]

SCHEDULE B.

In humble obedience to his Excellency's commands referring to me the petition of of , to consider what may be properly done therein, I do hereby certify as follows: That the said petition sets forth that the petitioner [*state briefly the allegations of the petition*].

And the petitioner most humbly prays [*state briefly the prayer of the petition*]. That in support of the allegations contained in the said petition the declaration of the petitioner has been laid before me, whereby he solemnly declares that [*state briefly the allegations of the declaration*].

That there has also been laid before me (a provisional specification signed and also a certificate), or (a complete specification, and a certificate of the filing thereof), whereby it appears that the said invention may be provisionally pro-

tected (*or* protected) from the day of A. D. in pursuance of
the ordinance:

I hereby certify that the petitioner is entitled to interim protection on account of his said invention, provided the said application for letters patent be duly advertized according to the ordinance, and that the petitioner do otherwise comply with the enactments of ordinance No. 18 of 1875.

Given under my hand, this day of A. D. .

From *Carpn. Pat. L. of World*, 364.

MEXICO.

Law of May 7, 1832.

ARTICLE 1. To protect the right of property of inventors or improvers of any branch of industry, an exclusive right shall be given them, to use the invention or improvement in all the states of the federation for the time and under the conditions that are expressed in this law.

ART. 2. The inventor or improver of any industry in the Mexican Republic who wishes the government to secure to him the possession thereof, shall present to it or to the city council of the place in which he desires to establish his project, or to that of his residence, or to the governor of the state or territory, to which that place pertains, an exact description,* accompanied by drawings, models, and as much more as is judged necessary for the explanation of the proposed object, and the above named authorities shall give him a legal instrument according to form number one.

ART. 3. The local authority, in case the applicant does not present himself directly to the governor of the state, shall remit to the latter the papers in the case with all the documents, and the governor shall decide; and in case the applicant has not done so himself, shall forward the application by the first regular mail to the minister of the interior.

ART. 4. The government, on receiving a petition to obtain a patent, shall publish it three times in the newspapers, and a term of two months (counting from the day of publication) shall be allowed for opposition to be entered by any who claim priority.

ART. 5. The government, through the secretary of the interior, shall issue to the improver or inventor a patent according to form number two.

ART. 6. In granting the patent mentioned in the previous article, the government is not to examine whether or not the inventions or improvements are useful, but only if they are contrary to public safety or health, to good morals, or to law, or to the orders and regulations, and if it is not so, they cannot refuse the protection solicited.

* The documents must be in Spanish. Pat. Off. Gaz. April 10, 1883, p. 1448.

ART. 7. Patents of invention shall remain in force for ten years, and those of improvement for six, counting from the date when the privileged project is established in the Republic.

ART. 8. A project of invention or improvement is understood to be established from the day the patent is issued.

ART. 9. When an inventor or improver desires that his privilege should be limited to one State only, he must apply for the concession to the authorities of that State.

ART. 10. When any one has obtained a privilege for an invention or improvement already established without patent by another, the privilege shall be void, even if it be not claimed by that party as his invention or improvement.

ART. 11. When the invention or improvement is of such nature that it may be worked in secret, and the inventor or improver obtains a patent, when the term of the patent has expired, he must make the invention or improvement public.

ART. 12. A patent having been issued for an invention, if a privilege for an improvement is solicited, the privilege granted to the improver shall not affect the rights of the original inventor.

ART. 13. When the inventor or improver desires the privilege for a longer time than that expressed in article 7, he must apply to the government, which shall report to Congress.

ART. 14. An inventor or improver shall not use his industry as patented until he has obtained from the government the patent which establishes his title.

ART. 15. In case of dispute as to the possession of an invention or improvement, it shall be decided by the common laws.

ART. 16. When it is proved that a privilege has been obtained by fraud, the applicant representing as an invention or improvement that which is no more than an introduction, the patent which has been obtained shall be void.

ART. 17. The government shall publish in the Gazette the grant of each patent immediately it is issued, and shall designate a convenient place where the designs, plans, and models named in article 2 may be open to public inspection.

ART. 18. When the invention or improvement is to remain secret, the designs, plans, &c., shall not be published until the expiration of the term of privilege.

ART. 19. The fees for a patent will be from 10 to 300 dollars (*pesos*).

ART. 20. At least one half of the persons employed in mechani-

cal labor by the workers of a patent, must if possible be actually natives of the United Mexican States.

ART. 21. The introducer of any branch of industry that in the judgment of the government is of great importance, may obtain an exclusive privilege by applying through the government to the General Congress.

FORM No. I.

Certificate delivered by the Local Authority or Governor of a Province.

I, N., mayor or governor of _____, certify herewith that this day, month, and year, N. N. has [or have] delivered to me a closed and sealed packet, which he [or they] declare to contain all the descriptive documents [*insert the precise object in view*], and for that purpose the packet has been labeled with the number of the inventor or improver, and the day and hour of its delivery. Having declared that he [or they] is [or are] the inventor [or inventors], improver [or improvers], he has [or they have] signed the present in duplicate with me, keeping one for himself [or themselves], and leaving the other at this office.

[Certificates may also be delivered by the secretaries of governors, if the latter should find it convenient.]

FORM No. II.

Letters Patent.

The President of the United States of Mexico informs all those present that having found N. [or N. N.] to be an inventor [or inventors], or an improver [or improvers], according to the documents, plans, drawings, descriptions, or models delivered, he by these presents secures his [or their] right of property of his [or their] invention [or improvement], according to the terms and for the time prescribed by law, the present decree establishing his [or their] title.

Dated

From *Carp. Pat. L. of World*, 375.

Decree of September 28, 1843.

In every patent which is issued, a prudent term shall be fixed, within which the use of the privileged object shall be commenced, and if not accomplished in said time, the privilege will be held to have expired, and free action granted to any other individual to apply for it again.

From *Carp. Pat. L. of World*, 380.

*Regulation of July 12, 1852, for the Better Observance of
the Law of May 7, 1832.*

ARTICLE 1. The inventor or perfecter of any industry, to make use of the right given by article 2 of the law of May 7, 1832, shall present to any of the authorities named by the said article his petition (*solicitul*), accompanied by duplicates of his designs (or models), and what is judged necessary for explanation of what is proposed.

ART. 2. Every petition made according to the previous article shall pass immediately after its first publication for the information of the directing committee of industry, which shall extend that which it may deem proper within the term specified by article 4 of said law.

ART. 3. The directory shall give information upon those points which are comprehended under article 6 of said law.

ART. 4. If before the term specified in article 4 of said law expires there shall be any opposition, the directing committee shall hear verbally the interested parties, and consult with experts on doubtful points according to right, and shall obtain an agreement between the parties, provided that it does not prejudice the public interests nor conflict with the laws. If the parties should agree, an act shall be made, signed by the president and secretary of the committee, showing the agreement made. The directive committee shall send it to the government with the proper information.

ART. 5. If no agreement be arrived at, the directive committee shall send the papers in the case to the government, giving its opinion upon the controverted point.

ART. 6. Providing that the opposer shall found his objection upon an alleged better right to the privilege which is asked, because personally it may have been conceded to him and guaranteed by the issue of the respective patent, the government shall examine the opposition, and within thirty days grant or deny the patent which is solicited, the rights of the party who considers himself injured remaining in full force in order that he may use them before the competent federal courts, according to law.

ART. 7. Should the dispute turn upon the possession or ownership of the privilege, or this should be impugned for the reasons expressed in the 16th article of said law, the judicial notice shall be

passed to the competent federal tribunal in order that, the parties being heard according to law, it may decide the contest. The party gaining the case shall present testimony of the sentence given, that it may, passing to the directing committee of industry, inform it with reference to the concession of the decision, if the judicial decision shall have been favorable to him who asks it.

ART. 8. If the opposition should be founded in that the privilege cannot be conceded according to what is provided in article 6, or that the innovation or perfection is not a matter of privilege on account of being comprehended in article 10 of said law, the government shall decide upon the concession, and from the decision made there shall be no opportunity for judicial recourse, provided that the opposition is founded upon the mentioned article 6; but if it should turn upon the application of article 10, and the government decision should concede the patent, there will remain in force the judicial recourse to him who may consider himself prejudiced.

ART. 9. The competent federal tribunals, upon the petition of the attorney-general, in default of a party who should make the decision, shall declare the nullity of the privileges comprehended in articles 10 and 16 of the Law of May 7, 1832. The attorney-general cannot take this public action unless directed by the government.

ART. 10. The government, upon issuing the patent mentioned in article 5 of said law, shall return one exemplar of the designs, models, and descriptions, which, according to article 1 of this law, must accompany the petition in duplicate. This exemplar, if it be design or description, will go signed by the chief clerk of the ministry of relations. If it be a model which cannot be written upon, there shall be placed a suitable mark or sign, making written note of this fact on the patent, as also of the return of the duplicates. In the cases comprehended in the article 18 of the law of May 7, 1832, the signatures and signs shall be placed on the cover of the box that contains the designs, plans, &c.

ART. 11. The patent of which the previous article of the said law speaks forms the title of privilege, and, when produced to establish or define a right, there shall be exhibited therewith the designs, descriptions, or models authorized in the form provided in the preceding article.

ART. 12. The concession of a patent does not guarantee the

utility of the invention or perfection nor prejudice (*prejuzga*) the questions relating to it which may arise.

ART. 13. A copy of this law shall accompany every patent issued hereafter, under seal of the ministry of relations stamped over wafer.

From 23 *Pat. Off. Gaz.* 1447

MICQUELON.

See FRANCE.

MONTSERRAT.

See LEEWARD ISLANDS.

NATAL.

An Act "to provide for the granting in this Colony, of Patents for Inventions." No. 4 of 1870.

Preamble. Whereas it is expedient that the making of new and useful inventions should be encouraged by securing to their inventors, for a limited time, the exclusive enjoyment thereof :

Be it therefore enacted, by the Lieutenant Governor of Natal, with the advice and consent of the Legislative Council thereof, as follows :

1. *Interpretation clause.* In the interpretation of this law the term "invention" shall bear and have the same meaning as the term "invention" bears and has in the Act of the Imperial Parliament, the 15th and 16th of Her Majesty, c. 83, entitled "An Act for Amending the Law for Granting Patents for Inventions;" and the term "letters patent" shall mean authorizations granted by the Lieutenant Governor, under the public seal of the colony; and the term "proceedings in the nature of a *scire facias*," shall mean and have a like signification with, or as nearly as may be, what the same term would mean if used in an Act of the Imperial Parliament.

2. *Issue of letters patent authorized.* It shall be lawful for the Lieutenant Governor, to make and issue, in manner hereinafter mentioned, letters patent, granting to the true and first inventor of any invention the privilege of the sole and exclusive working, making, and enjoyment of such invention within this colony, for any term not exceeding fourteen years from the date of such letters patent.

3. *Rules and regulations for carrying out this law.* It shall be lawful for the Lieutenant Governor, with the advice of his Executive Council, from time to time, to make such rules and regulations, not inconsistent with the provisions hereof, as may appear to be necessary and expedient for the purposes of this law; and all such rules and regulations shall be laid before the Legislative Council within fourteen days after the making thereof, if the Legislative Council be sitting, and if the Legislative Council be not sitting, then within fourteen days after the next meeting thereof.

4. *Application; deposit of provisional specification; fee; term of protection; amendment.* All applications under this law, for the grant of letters patent, shall be made, as near as may be, as

follows, that is to say : The applicant shall deposit in the office of the attorney-general, an instrument in writing, under his signature, describing the nature of his invention ; and the day of the deposit of every such specification shall be recorded at the said office, and indorsed upon such specification, and a certificate thereof given to such applicant or his agent, who shall thereupon deposit and pay a fee as per schedule 8 hereunto annexed ; and thereupon, subject and without prejudice to the provisions hereinafter contained, the said invention shall be protected under this law for the term of six months next after the said deposit ; and the applicant shall have, during such term, the like powers, rights, and privileges as might have been conferred upon him by letters patent issued under this law, and duly sealed as of the day of the date of such deposit ; and during the continuance of such powers, rights, and privileges, such invention may be used and published, without prejudice to any letters patent to be granted for the same ; and the contents of such specifications shall not be inspected by any person but the attorney-general, or such person as he may appoint in that behalf, and its contents shall not be published until after the expiration of the said six months: Provided that in case the title of the invention or the said specification be too large or insufficient, it shall be lawful for the attorney-general, during the said term, and before the grant of letters patent, to allow or require such specification to be amended. Such amended specification shall be considered a complete specification, and shall be liable to the conditions imposed upon complete specification by this law.

5. *Complete specification ; fee ; protection ; insufficient description.* The applicant for an invention, instead of depositing a "provisional specification," as aforesaid, may, if he think fit, deposit an instrument in writing under his hand and seal (hereinafter called a complete specification), particularly describing and ascertaining the nature of the said invention, in what manner the same is to be performed, and also such drawings as may be required to explain the same, and the day of the deposit of every such specification shall be recorded at the aforesaid office and indorsed upon such specification, and a certificate thereof given to such applicant, or his agent, who shall thereupon deposit and pay a fee as provided in schedule 8 of this law ; and thereupon, subject and without prejudice to the provisions hereinafter contained, the said invention shall be protected under this law for the term of six months next after the said deposit, and the applicant shall have during such term the

like powers, rights, and privileges ; such invention may be used and published without prejudice to any letters patent to be granted for the same, and where letters patent are granted in respect of such invention, such letters shall be conditioned to become void if such specification does not sufficiently describe and ascertain the nature of the said invention and in what manner the same is to be performed, and in case the invention is an improvement on any existing invention, if such specification does not sufficiently show in what the improvement consists.

6. *Deposit of specification in fraud of true inventor, not to invalidate.* In case of the depositing of any such specification as aforesaid, in fraud of the true and first inventor, any letters patent granted to the true and first inventor of any such invention shall not be invalidated by reason of such deposit, or of any use or publication of the invention subsequent to such deposit, and before the expiration of the said term of protection.

7. *Mode of proceeding ; notice to attorney-general ; appointment ; publication ; filing objections.* The applicant, as soon as he shall think fit after the deposit of such specification as aforesaid, and of the drawings accompanying the same, if any, may give notice in writing, at the office of the attorney-general, of his intention to proceed with his application for letters patent for the said invention, stating in such notice the title of the said invention, and the day on which the specification thereof was deposited at the office of the attorney-general, and at the time of giving such notice shall produce the said certificate of deposit and receipt for the said fee or fees, and thereupon the said attorney-general, shall deliver to the applicant, or his agent, an appointment in the form contained in the second schedule to this law, or to the like effect ; and such applicant or agent shall cause the said appointment to be published once in the Government Gazette, once in some newspaper published in the city of Pietermaritzburg, and twice in some newspaper published in the town or place at or near which the applicant uses or exercises the said invention, or (in case he does not use or exercise the same) in or near to which he resides ; or if there shall be no newspaper published in such town or place, then twice in some newspaper circulating in the neighborhood where he uses or exercises the said invention, or (in case he does not exercise or use the same) where he resides ; and any person having an interest in opposing the grant of letters patent for the said invention, shall be at liberty, upon payment therefor of a fee as provided by schedule

8, to leave particulars in writing of the objections to the said application at the office of the attorney-general within such time, not less than one month, as the attorney-general by such appointment may direct.

8. *Hearing of application and objections ; costs.* At the time and place named in the said appointment, the applicant shall produce the newspapers containing the same, and the attorney-general shall thereupon hear and consider the said application, and all objections to the same mentioned in the said particulars, if any, and may call to his aid scientific or other person or persons, as he may think fit, and the Lieutenant Governor therefor appoint, and may, by writing, under his hand, order to be paid to such person or persons, by the said applicant or objector, some remuneration for his or their attendance, and may also in like manner order that the costs of any hearing upon any objection or otherwise in relation to the grant of such letters patent, or the protection acquired by the applicant under this law, shall be paid, and in and by such writing shall fix the amount of such remuneration or costs, and by or to whom the same respectively shall be paid ; and every such order shall be in the form contained in the third schedule to this law, or to the like effect, and may be made a rule of the Supreme Court ; provided that the applicant, the objectors, and their respective witnesses and evidence, shall be respectively heard, examined, and considered separately and apart from, and in the absence of, the other, and his witnesses and evidence.

9. *Issue of warrant for granting letters patent.* The attorney-general, if no objections have been made, or after such hearing and consideration as the case may be, may issue a warrant under his hand for the granting of letters patent for the said invention, and by such warrant shall direct the insertion in such letters patent of all such restrictions, conditions, and provisos as he may deem usual and expedient in such grants, or necessary in pursuance of this law, and the said warrant shall be the warrant for the making and sealing of letters patent under this law, according to the tenor of the said warrant, and every such warrant shall be in the form contained in the fourth schedule to this law, or to the like effect, and for the granting thereof the applicant shall pay to the colonial treasurer, and produce his receipt therefor, a fee as in schedule No. 8 hereto annexed.

10. *Scire facias for repeal of patent ; Governor may order to withhold warrant.* A writ of the Supreme Court of the nature of

a writ of scire facias in England shall lie for the repeal of any letters patent granted under this law, and it shall be lawful for the Lieutenant Governor, with the advice aforesaid, to order such attorney-general to withhold such warrant as aforesaid, or that any letters patent, for the granting whereof he has issued a warrant, shall not issue ; or to order the insertion in any such letters patent of any restrictions, conditions, and provisos in addition to, or in substitution for, any restrictions, conditions, or provisos which would otherwise be inserted therein under this law ; and it shall also be lawful for the Lieutenant Governor, with the advice aforesaid, to order any specification in respect of the invention described, in which no letters patent may have been granted, to be canceled, and thereupon the protection obtained by the deposit of such specification shall cease.

11. *Form and condition of letters patent.* All letters patent granted under this law shall be in the form contained in the fifth schedule to this law, or to the like effect, and be made subject to the condition that the same shall be void, and that the powers and privileges thereby granted shall cease and determine at the expiration of three years and seven years respectively from the date thereof, unless there be paid to the colonial treasurer within the said three and seven years respectively, the sum or sums of money in that behalf hereby required to be paid, and the colonial treasurer shall issue under his hand a certificate of such payment, and shall indorse a receipt for the same on the letters patent.

12. *Preparation of letters patent ; sealing same.* The attorney-general, so soon after the issue by him of the warrant aforesaid as required by the applicant, shall cause to be prepared letters patent of the invention, according to the tenor of the said warrant ; and it shall be lawful for the Lieutenant Governor, with the advice of the Executive Council, to cause letters patent to be sealed with the public seal of the colony, and such letters patent shall be made applicable to the said colony, and shall be valid and effectual as to the whole of the same ; but, except as hereinafter mentioned, no letters patent shall issue on any warrant granted as aforesaid, unless application be made to seal such letters patent within three months after the date of the said warrant, nor unless such letters patent be granted during the continuance of the protection conferred under this law by reason of such deposit as aforesaid.

13. *Delay in sealing ; death of applicant ; destruction or loss of patent.* Where the application to seal such letters patent has been

made during the continuance of such protection as aforesaid, and the sealing of such letters patent has been delayed from accident, and not from the neglect or willful default of the applicant, then such letters patent may be sealed at such time, not being more than one month after the expiration of such protection as the Lieutenant Governor, with the advice aforesaid, shall direct; and where the applicant for such letters patent dies during the continuance of such protection as aforesaid, such letters patent may be granted to the executors testamentary or dative of such applicant during the continuance of such protection, or at any time within three months after the death of such applicant, notwithstanding the expiration of the term of such protection; and the letters patent so granted shall be of the like force and effect as if they had been granted to such applicant during the continuance of such protection; and in case any letters patent shall be destroyed or lost, other letters patent, of the like tenor and effect, and sealed and dated as of the same day, may, subject to such regulations as the Lieutenant Governor, with the advice aforesaid, may direct, be issued under the authority of the warrant in pursuance of which the original letters patent were issued.

14. *Date of patent; after issue appointment not to be questioned.* All letters patent to be issued in pursuance of this law, shall be sealed and bear date as of the day of the deposit of any such specification as aforesaid, and shall be of the same force and validity as if they had been sealed on the day as of which the same are expressed to be sealed and bear date; and after any letters patent shall have been granted or issued under this law, it shall not be necessary or admissible to inquire or ascertain whether such appointment as aforesaid has or has not been delivered and published in the manner hereinbefore mentioned and directed.

15. *Extension to colony of patent granted elsewhere.* Where, upon any application made under this law, letters patent are granted for or in respect of any invention, first invented in parts out of this colony, and a patent or like privilege for the monopoly or exclusive use or exercise of such invention in any parts out of this colony is obtained before the grant of such letters patent in this colony, all rights and privileges under such letters patent shall, notwithstanding any term in such letters patent limited, cease and be void immediately upon the expiration or other determination of the term during which the patent or like privilege obtained in such part out of such colony shall continue in force, or where more than one such

patent or like privilege is obtained abroad, immediately upon the expiration or determination of the term which shall first expire or be determined of such several patents or like privileges: Provided always, that no letters patent for or in respect of any invention, for which any such patent or like privilege as aforesaid shall have been obtained abroad, granted in this colony after the expiration or determination of the term for which such patent or privilege was granted or was in force, shall be of any validity.

16. *Patent not to apply to foreign ships.* No letters patent for any invention, granted after the passing of this law, shall extend to prevent the use of such invention in any foreign ship or vessel,* or for the navigation of any foreign ship or vessel which may be in any port of Natal, in case such invention is not so used for the manufacture of any goods or commodities to be vended within or exported from the same.

17. *Specifications and drawings, where to be kept.* Every specification deposited at the office of the attorney general, as aforesaid, and the drawings accompanying the same, if any, shall forthwith, after the grant of the letters patent, or if no letters patent be granted, then immediately on the expiration of six months from the time of such deposit, be transferred to and kept in such office as the Lieutenant Governor with the advice aforesaid, shall from time to time appoint for that purpose.

18. *Disclaimer.—Appointment; publication; objections.* Any person who shall obtain letters patent under this law, or in case such person shall part with the whole or any part of his interest by assignment, such person, together with the assignee (if part only hath been assigned), or the assignee alone (if the whole hath been assigned), may apply to the attorney-general for leave to enter a disclaimer of any part of either the title of the invention or of the specification, or a memorandum of any alteration in the said title or specification, not being such disclaimer or such alteration, as shall extend to the exclusive right granted by the said letters patent; and thereupon the attorney-general shall deliver to such patentee and assignee, or either of them, or to their or either of their agents, an appointment in the form contained in the sixth schedule to this law, or to the like effect, and such patentee or assignee shall thereupon

* By Law No. 5 of 1871, Carpm. Pat. L. of World, 404, the terms "foreign ship or vessel" in section 16 in the text are declared to "include all ships and vessels

used in navigation not propelled by oars, not being registered in or hailing from this Colony."

cause such disclaimer (stating the reason for the same), or such memorandum or alteration to be written at the foot of such appointment, and shall cause the same respectively to be published in the manner hereinbefore required, with respect to the said first mentioned appointment, and any person having an interest in opposing the said application shall be at liberty to leave particulars, in writing, of their objections to the same, at the office of the attorney-general, within such time, not being less than one month, as the said attorney-general by such appointment may direct: Provided that where such application as aforesaid shall be for leave to enter a disclaimer of any part of the title of the said invention, or a memorandum of any alteration in such title, the attorney-general may dispense with such appointment and publication, and in that case shall certify, in the fiat hereinafter mentioned, that he has dispensed with the same.

19. *Hearing application and objections.* At the time and place named in such appointment, the said patentee and assignee, or one of them, shall produce the newspapers containing the same, and the said disclaimer or memorandum of alteration at the foot thereof; and the attorney-general shall thereupon hear and consider the said application, and all objections to the same, mentioned in the said particulars, if any, and all such power and authority shall and may be exercised on such occasion by the attorney-general, as by virtue of the provisions hereinbefore contained, can and may be exercised in relation to the hearing and considering any application for letters patent, and objections to the same, and shall and may be enforced in the same manner.

20. *Entry of disclaimer; attorney-general's fiat.* After such hearing and consideration, or without such hearing and consideration, where the said appointment and publication shall have been dispensed with, as aforesaid, such patentee and assignee, or either of them, may, by leave of the attorney-general, to be certified by a fiat under his hand (to be written at the foot of the same parchment with the said disclaimer or memorandum), enter such disclaimer, stating the reason for the same, or such memorandum of alteration; and at the time of entering such disclaimer or memorandum of alteration, shall deposit a copy thereof in the office next hereinbefore mentioned; and such disclaimer or memorandum of alteration being filed in such office as the Lieutenant Governor, with the advice aforesaid, shall from time to time appoint for that purpose, shall be deemed and taken to be part of such letters patent, or such

specification, and subject to the several incidents thereof in all courts of this Colony, and shall be valid and effectual in favor of any person in whom the rights under the said letters patent may then be, or hereafter become legally vested ; and no objection shall be allowed to be made in any proceeding upon, or touching such letters patent, specification, disclaimer, or memorandum of alteration, on the ground that the person entering such disclaimer or memorandum of alteration had not sufficient authority in that behalf : Provided always, that no action shall be brought upon any letters patent in which, or on the specification of which, any disclaimer or memorandum of alteration shall have been filed in respect of any infringement committed prior to the filing of such disclaimer or memorandum of alteration (unless the attorney-general shall certify in his said fiat that any such action may be brought), notwithstanding the entry or filing of such disclaimer or memorandum of alteration ; and no such disclaimer or alteration shall be receivable as evidence in any action or suit (save and except in any proceeding as aforesaid, in the nature of a scire facias), pending at the time when such disclaimer or alteration was filed as aforesaid, but in every such last mentioned action or suit the original title and specification alone shall be given in evidence, and be deemed and taken to be the title and specification of the invention for which the letters patent have been or shall have been granted : Provided also, that when any such fiat shall have been granted or issued under this law, it shall not be necessary or material to inquire or ascertain whether such appointment as last aforesaid has or has not been delivered and published or dispensed with in accordance with this law : and such filing of any disclaimer or memorandum of alteration, in pursuance of the leave of the attorney-general, certified as aforesaid, shall, except in cases of fraud, be conclusive as to the right of the party to enter such disclaimer or memorandum of alteration under this law.

21. *Specifications, drawings, &c.; public after issue of patent.* The copies of all specifications, and the drawings accompanying the same, if any, and of all disclaimers and memoranda of alterations, respectively deposited under or in pursuance of this law, shall be open to the inspection of the public at all reasonable times after the grant of letters patent, or if no letters patent be granted, then immediately on the expiration of six months from the time of such deposit, but subject to such regulations as the Lieutenant Governor, with the advice aforesaid, may make in that behalf.

22. *Petition to Governor for extension of patent.* If any person having obtained letters patent under this law, or in case such person shall have parted with his whole or any part of his interest by assignment, if such person, together with the assignee (where part only hath been assigned), or if the assignee alone (where the whole hath been assigned), shall, six months before the expiration or other termination of such letters patent, present to the Lieutenant Governor a petition for the extension of the term in such letters patent mentioned, and shall set forth in such petition that he or they has or have been unable to obtain a due remuneration for his or their expense or labor in perfecting such invention, and that an exclusive right of using and vending the same for some further period to be named in such petition, in addition to the said term, is necessary for his or their reimbursement and remuneration, it shall be lawful for the Lieutenant Governor, with the advice aforesaid, to refer the consideration of the said petition to the Supreme Court.

23. *Petition for confirmation or renewal of patent.* If in any suit or action it shall be proved or specially found by the verdict of a jury or by the court, that any person who shall have obtained letters patent for any invention or supposed invention was not the first inventor thereof, or of some part thereof, by reason of some other person having invented or used the same, or some part thereof, before the date of such letters patent, or if such patentee or his assigns shall discover that some other person had, unknown to such patentee, invented or used the same or some part thereof before the date of such letters patent, such patentee or his assigns may petition the Lieutenant Governor to confirm the said letters patent, or to grant new letters patent, and it shall be lawful for the Lieutenant Governor, with the advice aforesaid, to refer the consideration of the said petition to the Supreme Court.

24. *Petition to be advertised; entering caveat.* Two months at least before the time named for the consideration of any such petition as aforesaid, the petitioner shall cause to be published, in the same manner as is hereinbefore required with respect to the first-mentioned appointment, an advertisement of the contents of the said petition in the form contained in the seventh schedule to this law, or to the like effect; and any person having an interest in opposing the said petition shall be at liberty to enter a caveat against the same at the office of the attorney-general, at any time, not being less than one week before the time named for the consideration of the said petition.

25. *Hearing petition ; court to report to Lieutenant Governor on prayer for extension ; on prayer for confirmation or renewal, to decide.* The petitioner shall be heard by his counsel and witnesses, to prove his case as stated in such petition, and the publication of the said last-mentioned advertisement as required by this law ; and the persons entering caveats shall likewise be heard by their counsel and witnesses ; and all such witnesses shall be examined upon oath or affirmation, and thereupon, and upon hearing and inquiry of the whole matter, in case such petitioner shall have prayed for an extension as aforesaid, the said court may report whether any, and, if any, what further extension of the said term should be granted ; and the Lieutenant Governor is hereby authorized and empowered, if he, with the advice aforesaid, shall think fit, to grant to the petitioner new letters patent for the said invention, for a term not exceeding fourteen years after the expiration of the first term, anything hereinbefore contained to the contrary thereof notwithstanding ; and such new letters patent shall be sealed and bear date as of the day after the expiration of the term of the first letters patent ; or, in case such petitioner shall have prayed for a confirmation or grant as aforesaid, the court, upon examining the said matter, and being satisfied that such patentee, as aforesaid, believed himself to be the first and original inventor, and being satisfied that such invention, or part thereof, had not been publicly and generally used before the date of such first letters patent, shall decide whether the prayer of such petition ought to be complied with, whereupon the Lieutenant Governor may, if he, with the advice aforesaid, shall think fit, grant such prayer ; and the said letters patent shall be available at law and in equity to give such petitioner the sole right of using, making, and vending such invention, as against all persons whatsoever, anything hereinbefore contained to the contrary thereof notwithstanding : Provided that any person, party to any former action or suit touching such first letters patent as last aforesaid, shall be entitled to have notice in writing from the petitioner or his attorney of the time and place fixed for the hearing of the said petition ; and after any such decision and order shall have been made, it shall not be material to inquire or ascertain whether any such advertisement as last aforesaid has or has not been published, or whether any such notice as last aforesaid has or has not been given in the manner hereinbefore directed in that behalf. The expenses of such hearing and all costs connected therewith, shall be paid as the court may direct.

26. *Indices of specifications, &c.* The Lieutenant Governor, with the advice aforesaid, may cause indices to all specifications, disclaimers and memoranda of alterations heretofore or to be hereafter enrolled or deposited as aforesaid, to be prepared in any such form as may be thought fit, and such indices shall be open to the inspection of the public at such places as the Lieutenant Governor with the advice aforesaid, shall appoint, and subject to the regulations to be made as hereinbefore provided.

27. *The Register of Patents.* There shall be kept at the office to be appointed, as aforesaid, a book or books to be called The Register of Patents, wherein shall be entered and recorded in chronological order all letters patent granted under this law, the deposit and filing of specifications, disclaimers and memoranda of alterations filed in respect of such letters patent, all amendments in such letters patent and specifications, all confirmations and extensions of such letters patent, the expiry, determination, vacating, or canceling such letters patent, with the dates thereof respectively, and all other matters and things affecting the validity of such letters patent as the Lieutenant Governor, with the advice aforesaid, may direct, and such register, or a copy thereof, shall be open at all convenient times to the inspection of the public, subject to such regulations as the Lieutenant Governor, with the advice aforesaid, may make in that behalf.

28. *Register of Proprietors.* There shall be kept at the same office a book or books entitled the Register of Proprietors, wherein shall be entered, in such manner as the Lieutenant Governor, with the advice aforesaid, shall direct, the assignment of any letters patent, or of any share or interest therein, any license under letters patent, and the district to which such license relates, with the name or names of any person having any share or interest in such letters patent or license, the date of his or their acquiring such letters patent, share and interest, and any other matter or thing relating to or affecting the proprietorship in such letters patent or license, and a copy of any entry in such book, certified as hereinafter mentioned, shall be given to any person requiring the same on payment of the fee provided in schedule 8, and shall be *prima facie* proof of the assignment of such letters patent or share or interest therein, or of the license or proprietorship as therein expressed, provided always that, until such entry shall have been made, the grantee or grantees of the letters patent shall be deemed and taken to be the sole and exclusive proprietor or proprietors of such letters

patent, and of all the licenses and privileges thereby given and granted, and such register or a copy shall be open to public inspection, subject to such regulations as the Lieutenant Governor, with the advice aforesaid, may make.

29. *Punishment for making false or forged entries.* If any person shall willfully make, or cause to be made, any false entry in the said register, or shall willfully make or forge, or cause to be made or forged, any writing falsely purporting to be a copy of any entry in the said book, or shall produce or tender, or cause or suffer to be produced or tendered, in evidence, any such writing, knowing the same to be false or forged, he shall be guilty of the crime of contravening this section of this law, and shall upon conviction be liable to imprisonment, with or without hard labor, for any period not exceeding five years.

30. *Entries in registers—how expunged, vacated or varied.* If any person shall deem himself aggrieved by any entry made under color of this law in the said register, it shall be lawful for such person to apply by motion to the Supreme Court for an order that such entry may be expunged, vacated, or varied, and upon any such application such court may make such order for expunging, vacating or varying such entry, and as to the costs of such application as to such court may seem fit, and the officer having the care and custody of such register, on the production to him of any such order, shall expunge, vacate or vary the said entry according to such order.

31. *Punishment for imitating a patentee's marks or device.* If any person shall write, paint, print, mould, cast, carve, engrave, stamp, or otherwise mark, upon anything made, used, or sold by him, for the sole making or selling of which he 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 or vending of such thing, without leave in writing of such patentee or his heirs or assigns, or if any person shall, upon such thing not having been purchased from the patentee or some person who purchased it from or under such patentee, or not having had the license or consent in writing of such patentee or his assigns, write, paint, print, mould, cast, carve, engrave, stamp, or otherwise mark the word "Patent," the words "Letters Patent," or the words "By the Queen's Patent," or any words of the like kind, meaning, or import, with a view of imitating or counterfeiting the stamp, mark, or other device of the patentee, he shall for

every such offense forfeit and pay the sum of fifty pounds, one half to the colonial government, and the other half, with full costs of suit, to any person who shall sue for the said penalty by action of debt.

32. *Inventor's action for infringement of patent.* An action may be maintained in the Supreme Court by an inventor against any person who, during the continuance of the letters patent granted under this law, shall, without the license of said inventor, make, use, sell, or put in practice the said invention, or who shall counterfeit or imitate the same.

33. *Grounds of defense to any such action.* No such action shall be defended upon the ground of any defect or insufficiency of the specification of the invention, nor shall any such action be defended upon the ground of a misdescription of the invention in the petition, nor upon the ground that the plaintiff was not the inventor, unless the defendant shall show that he is the actual inventor or derives title from him. Any such action may be defended upon the ground that the invention was not new, if the person making the defense, or some person through whom he claims, shall, before the date of the petition for leave to file any such specification, have publicly or actually used in Natal the invention or that part of it, of which the infringement shall be proved, but not otherwise.

34. *Court may allow amendment of specification.* If the court at the hearing of the cause shall think the patentee has in the description of his invention in the petition or specifications included something which at the date of the petition was not new, or whereof he was not the inventor, or that the complete specification is in any particular defective or insufficient, but that the error, defect, or insufficiency was not fraudulently intended, the court may adjudge the said exclusive privilege to have been acquired and the letters patent to be valid, save as to the part thereof affected by such error, defect, or insufficiency, or if the court shall think that the error, defect, or insufficiency can be amended without injury to the public, they may adjudge the exclusive privilege and letters patent in the whole of the invention to be valid, and may, upon such terms as shall appear reasonable, order the specification to be amended in any of the said particulars, and adjudge and make such further order as to costs or otherwise as may be necessary and expedient, and thereupon the patentee, his executors, administrators, or assigns, shall, within the time limited by said

court for the purpose, file a specification amended according to such order.

35. *Action for infringement; pleadings; proceedings for repeal.* In any action for the infringement of letters patent, the plaintiff shall deliver with his declaration particulars of the breaches complained of in the said action, and the defendant on pleading thereto, shall deliver with his pleas, and the prosecutor in any proceedings in the nature of scire facias to repeal letters patent, shall deliver with his declaration particulars of any objections on which he means to rely at the trial in support of the pleas in the said action, or of the suggestions of the said declaration respectively, and at the trial of such action or proceedings no evidence shall be allowed to be given in support of any alleged infringement, or of any objection impeaching the validity of such letters patent which shall not be contained in the particulars delivered as aforesaid, provided always that the place or places at, or in which, and in what manner, the invention is alleged to have been used or published prior to the date of the letters patent, shall be stated in such particulars, provided also that it shall and may be lawful for any judge at chambers to allow such plaintiff or defendant, or prosecutor respectively, to amend the particulars delivered as aforesaid, upon such terms as to such judge may seem fit, provided also that at the trial of any proceeding to repeal letters patent, the defendant shall be entitled to begin and give evidence in support of such letters patent, and in case evidence shall be adduced on the part of the prosecutor, impeaching the validity of such letters patent, the defendant shall be entitled to the reply.

36. *Costs in such action or proceedings.* In taxing the costs in any action for infringing letters patent, regard shall be had to the particulars delivered in such action, and the plaintiff and defendant respectively shall not be allowed any costs in respect of any particular unless certified by the court before which the trial was had to have been proved by such plaintiff or defendant respectively, and it shall be lawful for the court before which any such action shall be tried to certify on the record that the validity of the letters patent in the declaration mentioned came in question, and the record with such certificate being given in evidence in any suit or action for infringing the said letters patent, or in any proceeding in the nature of scire facias, to repeal the letters patent, shall entitle the plaintiff in any such suit or action, or the defendant in any such proceeding, on obtaining a decree or judgment, to his full costs

charges and expenses, to be taxed as between attorney and client, unless the court making such judgment, decree or order, shall certify that the plaintiff or defendant respectively ought not to have such full costs.

37. *Payment of fees specified in schedule.* There shall be paid in respect of letters patent applied for or issued as herein mentioned, the depositing of specifications, disclaimers and memoranda of alterations, warrants, certificates, entries, searches, and other matters and things respectively mentioned in the eighth schedule to this law, such fees as are enumerated in such schedule, and such of the said fees as are thereby made payable shall be payable to the persons and in the manner provided in such schedule, and shall form part of the colonial revenue.

38. *Patent granted in United Kingdom after 1870, not to extend to Natal.* All letters patent which shall be granted in the United Kingdom of Great Britain and Ireland, after the first day of January, in the year of our Lord one thousand eight hundred and seventy-one, for any invention shall, so far as the same relate to this colony, be utterly void and of none effect, and in no wise be put in execution, but all such letters patent granted in the said United Kingdom on or before that day, and which, if this law had not been passed, would have been valid in this colony, shall be deemed and taken to have been granted under this law, and may be dealt with accordingly.

39. *Effect from promulgation.* This law shall take effect from the promulgation thereof in the Government Gazette.

SCHEDULE 1.

To all to whom these presents shall come, I, _____ of _____ [*engineer, &c., as the case may be*], send greeting: Whereas I am desirous of obtaining letters patent for securing unto me Her Majesty's special license that I, my executors, and assigns, and such others as I or they should at any time agree with, and no others, should and lawfully might, from time to time, and at all times during the term of fourteen years (to be computed from the day on which this instrument shall be left at the office of the attorney-general), make, use, exercise, and vend, within the colony of Natal, an invention for [*insert the title of the invention*]; and in order to obtain the said letters patent, I must, by an instrument in writing under my hand, particularly describe and ascertain the nature of the said invention, and in what manner the same is to be performed, and must also enter into the covenant hereinafter contained: Now know ye, that the nature of the said invention, and the manner in which the same is to be per-

formed, are particularly described and ascertained in and by the following statement, that is to say [*describe the invention*]. And I do hereby, for myself, my heirs and executors, covenant with Her Majesty, her heirs and successors, that I believe the said invention to be a new invention as to the public use and exercise thereof, and that I do not know or believe that any person other than myself is the true and first inventor of the said invention, and that I will not deposit these presents at the office of the attorney-general with any such knowledge or belief as last aforesaid.

In witness whereof, I have hereunto set my hand at _____, this _____ day of
18 .

SCHEDULE 2.

Patent for [*insert the title as in the specification*].

This is to notify that _____, of &c., did, on the _____ day of _____ instant [*or last*], deposit at the office of the attorney-general, Pietermaritzburg, a specification or instrument in writing under his hand, particularly describing and ascertaining the nature of the said invention, and in what manner the same is to be performed, and that by reason of such deposit the said invention is protected and secured to him exclusively for the term of six months thence next ensuing. And I do further notify that the said _____ has given notice in writing, at my office, of his intention to proceed with his application for letters patent for the said invention, and that I have appointed _____ day the _____ day of _____ next, at _____ o'clock in the _____ noon, at my office, to hear and consider the said application, and all objections thereto: and I do hereby require all persons having an interest in opposing the grant of such letters patent, to leave before that day, at my office in Pietermaritzburg, particulars in writing of their objections to the said application, otherwise they will be precluded from urging the same.

Given under my hand, this _____ day of _____ 18 .
Attorney-General.

SCHEDULE 3.

Upon hearing the objection of A. B. to the grant to _____, of letters patent for [*insert the title as in the specification*], I do by this writing under my hand, order that the said A. B. shall pay to the said _____, the sum of _____ for the costs of such hearing [*or to E. F. the sum of _____ as a remuneration for his attendance at such hearing*].

Given under my hand, this _____ day of _____ 18 .
Attorney-General.

SCHEDULE 4.

I have heard and considered the application of _____, for letters patent for [*insert the title as in the specification*]; and also all objections to the same, and, having perused the specification and the usual and necessary advertisements, am of opinion that, as it is entirely at the hazard of the said applicant whether the said invention is new and will have the desired success, Her Majesty's royal letters patent may be

issued in the form contained in the fifth schedule of the patent law, with the following additional clauses, that is to say [*here set them out, if any*].

Given under my hand, this day of 18 .

Attorney-General.

SCHEDULE 5.

VICTORIA, by the grace of God, of the United Kingdom of Great Britain and Ireland, Queen, Defender of the Faith, to all to whom these presents shall come, greeting: Whereas , of , in the county of [engineer, &c., as the case may be], hath represented that he is desirous of obtaining our royal letters patents, for securing unto him our special license that he, his executors and assigns, and such others as he or they should agree with, and no others, should and lawfully might, make, use, vend, and exercise within our Colony of Natal, an invention for [*insert the title of the invention*], and by an instrument in writing under his hand, deposited in the office of the attorney-general, the said hath particularly described and ascertained the nature of the said invention, and in what manner the same is to be performed: And we, being willing to give encouragement to all arts and inventions which may be for the public good, are graciously pleased to confer upon the said the privileges hereinafter mentioned; Know ye, therefore, that we of our especial grace, certain knowledge, and mere motion, have given and granted, and by these presents, for us our heirs and successors, do give and grant unto the said , his executors, and assigns, our especial license, full power, sole privilege and authority, that he, the said , his executors, administrators, and assigns, and every of them, by himself and themselves, or his and their deputy or deputies, servants or agents, or such others as he or they shall at any time agree with, and no others, during the term herein expressed, shall and lawfully may make use of, exercise, and vend his said invention within our said colony, in such manner as to him, his executors and assigns, or any of them, shall seem meet; and that he, his executors and assigns, shall and lawfully may have and enjoy the whole profit, benefit, commodity, and advantage, from time to time coming, growing, accruing, and arising by reason of the said invention, during the said term; to have, hold, exercise, and enjoy the said licenses, powers, privileges, and advantages, unto and by the said , his executors and assigns, for and during, and unto the full end and term of years, now next ensuing. And to the end that he, his executors and assigns, and every of them, may have and enjoy the full benefit and the sole use and exercise of the said invention, according to our gracious intention, we do by these presents, for us, our heirs and successors, require und strictly command all and every person and persons whatsoever, of what estate, quality, degree, name, or condition soever they be, within our said colony, that neither they, nor any of them, at any time during the said term, either directly or indirectly, do make, use, or put in practice the said invention, or any part of the same, so attained unto by the said as aforesaid, nor in anywise counterfeit, imitate, or resemble the same, nor shall make or cause to be made any addition thereunto, or subtraction from the same, whereby to pretend himself or themselves the inventor or inventors, deviser or devisors thereof, without the consent, license, or agreement of the said , his executors or assigns, in writing under his or their hands first had and obtained in that behalf, upon such pains and penalties as can or may be justly inflicted on such offenders for their contempt of this

our royal command ; and further, to be answerable to the said , his executors and assigns, according to law, for his and their damage thereby occasioned ; provided always, and these our letters patent are and shall be upon this condition, that if at any time during the said term hereby granted, it shall appear that this our grant is contrary to law, or prejudicial or inconvenient to our subjects in general, or that the said invention is not a new invention as to the public use and exercise thereof, or that the said is not the first and true inventor thereof within this colony, these our letters patent shall forthwith cease, determine, and be utterly void to all intents and purposes, anything hereinbefore contained to the contrary thereof in anywise notwithstanding ; provided also, that these our letters patent or anything herein contained, shall not extend, or be construed to extend, to give privilege unto the said , his executors and assigns, or any of them, to use or imitate any invention or work whatsoever which hath heretofore been found out or invented by any other of our subjects whatsoever, and publicly used or exercised, unto whom our like letters patent or privileges have been already granted for the sole use and exercise and benefit thereof within our said colony ; it being our will and pleasure that the said , his executors and assigns, and all and every person and persons to whom like letters patent or privileges have been already granted as aforesaid, shall distinctly use and practice their several inventions by them invented and found out, according to the true intent and meaning of the same respective letters patent, and of these presents ; provided likewise, nevertheless, and these our letters patent are upon this express condition, that if the said instrument in writing does not particularly describe and ascertain the nature of the said invention, and in what manner the same is to be performed, and also if the said , his executors or assigns, shall not pay at the office of the colonial treasurer of our said colony the sum of pounds within three years next after the date of these presents, and the sum of pounds within seven years next after such date, then, and in any of the said cases, these our letters patent, and all liberties and advantages whatsoever hereby granted, shall utterly cease, determine, and become void, anything hereinbefore contained to the contrary thereof in anywise notwithstanding : provided that nothing herein contained shall prevent the granting of licenses in such manner and for such considerations as may by law be granted : And, lastly, we do by these presents, for us, our heirs and successors, grant unto the said , his executors and assigns, that these our letters patent shall be in and by all things good, firm, valid, sufficient, and effectual in the law, according to the true intent and meaning thereof, and shall be taken, construed, and adjudged in the most favorable and beneficial sense, for the best advantage of the said , his executors and assigns.

In witness whereof we have caused these our letters to be made patent, and to be sealed and bear date as of the day of 18 .

SCHEDULE 6.

Patent for [here insert the title].

This is to notify to all whom it may concern, that of, &c., has applied to me for leave to enter a disclaimer of part [or memorandum of alteration, as the case may be] of the said invention, the particulars whereof are stated below ; I do therefore

appoint day the day of next, at o'clock in the noon,
to hear and consider the said application and all objections to the same. And I do hereby require all persons having an interest in opposing the said application, to leave, before that day, at my office in Pietermaritzburg, particulars in writing of their objection to the same, otherwise they will be precluded from urging such objections.

Given under my hand this day of 18 .

Attorney-General.

The following is the disclaimer [*or as the case may be*] which I desire to make in, &c. [*The applicant must here set forth what he wishes to enter, and sign it.*]

SCHEDULE 7.

Patent for [insert the title].

Notice is hereby given that I have presented a petition to his Excellency the Lieutenant Governor, praying for the confirmation of [*or extension of the term in*] the said patent, and that the said petition has been referred to the supreme court for consideration and decision; and that on the day of next, at o'clock in the noon, or so soon thereafter as counsel can be heard, the said court will be moved thereon. All persons objecting to the said confirmation [*or extension*] must enter a caveat against the same at the office of the attorney-general in Pietermaritzburg, otherwise they will be precluded from objecting to it.

Dated this day of 18 .

SCHEDULE 8.

Fees to be paid to Treasurer on account of general revenue.

	£	s.	d.
On depositing provisional specification.....	1	1	0
Notice to proceed.....	0	5	0
Alteration of specification.....	0	10	6
For any appointment.....	1	1	0
Fee for warrant (in terms of clause 9).....	1	1	0
Complete specification.....	1	1	0
Particulars of objection.....	1	1	0
On presenting petition for extension of confirmation.....	1	1	0
Every search and inspection.....	0	1	0
Entry of assignment or license.....	0	5	0
Certificate of assignment or license.....	0	5	0
Filing memorandum of alteration or disclaimer.....	1	1	0
Entering caveat.....	1	1	0
Copy, or extract of any writing, per common law folio.....	0	1	0

	£	s.	d.
Sealing letters patent.....	1	10	0
At or before the expiration of three years.....	5	0	0
At or before the expiration of seven years.....	10	0	0

From *Carp. Pat. L. of World*, 381; shortening some lengthy section captions.

See APPENDIX OF RECENT LAWS, near end of Vol. II.

NETHERLANDS.

According to a report by Mr. J. Walsham, of the British Legation, published October 7, 1873, 4 *Pat. Off. Gaz.* 373, the law of January 25, 1817,—which allowed issue of patents for terms not exceeding fifteen years,—was repealed by a law taking effect July 18, 1869, which prohibited issue of patents except upon applications made prior to that date. He also says : “It may be as well to correct a somewhat prevalent idea that the Crown, notwithstanding the law for the abolition of patents, has still the power in special cases of conferring exclusive rights upon inventors. No such royal prerogative, however, exists ; and no exceptions whatever are or can be made, beyond those specified in the abolition law.” [Referring to provisions allowing patents granted under the former law for five or ten years to be extended not exceeding fifteen years in all, and allowing applications made before the abolition to be granted.] It follows that no patents for the Netherlands are obtainable, and none are existing. Mr. Walsham’s report explains the effect of this legislation ; and publishes the Act of January 25, 1817, and the regulations for carrying it out. 4 *Pat. Off. Gaz.* 374, 375.

NEVIS.

See LEEWARD ISLANDS.

NEW BRUNSWICK.

See CANADA.

NEW CALEDONIA.

See FRANCE.

NEWFOUNDLAND.

The Consolidated Statutes, Title XV., Ch. 54, Sec. 1, entitled "of Patents."

I. *Patents to be granted in certain cases.* Whenever any person shall apply to the Governor, alleging that he hath invented and discovered any new and useful art, machine, manufacture, or composition of matter not theretofore known or used, and shall, by petition to the Governor, signify his desire to obtain an exclusive property in such new invention and discovery, and shall pray that a patent be granted for the same, the Governor in Council may direct letters patent, under the Great Seal of this Island, to be issued, which letters patent shall recite the allegations and suggestions of the said petition and shall therein give a short description of the said invention and discovery, and thereupon shall grant to such person, his executors, administrators, or assigns, for a term not exceeding fourteen years, the full and exclusive right and liberty of making, constructing, and using, and vending to others to be used, the said new invention or discovery ; which letters patent shall be good and available to the grantee therein named, by force of this chapter, and shall be recorded in the office of the colonial secretary in a book to be kept for that purpose, and shall be delivered to the patentee : and the Governor in Council may insert in any such letters patent a provision extending the operation thereof for a further term of seven years. Before the Great Seal of this Island shall be affixed to any such letters patent, or the same shall be issued and signed as aforesaid, such letters patent shall be delivered to Her Majesty's attorney-general, who shall examine the same, and shall, if he finds the same conformable to this chapter, certify accordingly, and return the same within fifteen days into the office of the colonial secretary, to be issued and signed.

II. *Improvement on patented invention.* Where any such letters patent shall be obtained by any person, and thereafter any other person shall discover or make any improvement in the principle or process of any such art, machine, or composition of matter, for which such patent hath been granted, and shall make application for and obtain letters patent under this chapter for the exclusive right of such improvement, the person who shall obtain and

procure letters patent for any such improvement, shall not make use, or vend the original invention or discovery, nor shall the person who shall have procured letters patent for the original invention or discovery, make, use, or vend any such improvement: Provided, that simply changing the form or the proportions of any machine or composition of matter, in any degree, shall not be deemed a discovery or improvement within the meaning of this chapter.

III. *Right to copies.* Any person may obtain from the office of the colonial secretary a copy of any such letters patent, or of the petition whereon the same were issued, or of any paper connected therewith, or any drawing relating to the same, on payment, for such copy, of such fees as are now payable at the office of the colonial secretary for copies of other documents.

IV. *Oath required.* Before any person shall receive any letters patent under this chapter, such person shall make oath, in writing, before one of the justices of Supreme Court, a stipendiary magistrate, or commissioner of affidavits, that he doth verily believe that he is the inventor or discoverer of the art, machine, composition of matter, or improvement for which he solicits letters patent, and that such invention or discovery hath not, to the best of his knowledge or belief, been known or used in this island or in any other country, which oath shall be delivered with the petition for such letters patent.

V. *Description, model, and drawing to be filed.* Together with such petition and oath, before any person shall obtain any letters patent as aforesaid, such person shall also deliver into the office of the colonial secretary 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 case of any machine, shall deliver a model thereof into the office of the colonial secretary, and shall explain the principle and the several modes in which such person hath contemplated the application of that principle or character by which it may be distinguished from other inventions, and 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 such person, and attested by two witnesses, shall be filed in the office of the colonial secretary, and copies thereof, certified under his hand, shall be evidence in all courts where any matter or thing, touching or concerning the said letters patent, shall come into question : Provided, that where, from the complicated nature of any machinery, the cost of a model thereof may be so great as to prevent any ingenious but poor person from obtaining patents for his useful inventions, the Governor in Council may dispense with the delivery of such model into the office of the colonial secretary previous to the granting of any such patent ; and the requisitions of this chapter being in all other respects complied with, such person shall be entitled to such patent as if such model had been so lodged.

VI. *Patentee may assign.* Any patentee, his executors or administrators, may assign all his right, title, and interest in the said invention and discovery in the letters patent to him granted, to any person ; and the assignee thereof, having recorded the said assignment in the office of the colonial secretary, shall thereafter stand in the place and stead of the original patentee, as well as to all right, privilege, and advantage, as also in respect of all liability and responsibility as to the said letters patent, and the invention and discovery thereby secured ; and in like manner shall the assignees of any such assignee stand in the place and stead of the original patentee or inventor.

VII. *Forfeiture in case of infringement.* Whenever, in any case, any letters patent, shall be, or shall or may have been, granted to any person under and by virtue of this chapter, and any person, without the consent of the patentee, his executors, administrators, or assigns, first had and obtained in writing, shall make, devise, use, or sell the thing, invention, or discovery, whereof the exclusive right is secured to the said patentee by such letters 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 may be recovered, together with costs, by action on the case, founded on this chapter, in the Supreme Court.

VIII. *Pleading.* The defendant in such action may plead the general issue, and give this chapter, and any special matter in evidence, tending to prove that the specification filed by the plaintiff does not contain the whole truth relative to the invention or discov-

ery therein alleged to have been made by the said plaintiff, 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, invention, or discovery, thus secured by letters patent, as aforesaid, was not originally discovered by the patentee, but had been in use, or had been described in some public work, anterior to the supposed invention or discovery of the said patentee, or that he had surreptitiously obtained letters patent as aforesaid, for the invention or discovery of some other person ; in either of which cases, upon proof thereof, a verdict shall be returned and a judgment shall be entered for the said defendant with costs, and the said letters patent shall thereupon be and shall by the said court be adjudged void.

IX. *Applicant not deprived of right by having obtained patent elsewhere.* No applicant shall be deprived of his right to a patent in this colony for his invention, by reason of his having previously taken out letters patent therefor in any other country : Provided, that such invention shall not have been introduced into public and common use in this colony prior to the application for a patent therein, and the patent granted in this colony shall not continue in force after the expiration of the patent granted elsewhere, and where more than one such patent or like privilege is obtained abroad, then immediately upon the expiration or determination of the term which shall first expire or be determined of such several patents or like privileges, the patent granted in this colony shall cease to be in force : and no letters patent for or in respect of any invention for which any such patent or like privilege as aforesaid shall have been obtained elsewhere, and which shall be granted in this colony, after the expiration of the term for which such patent or privilege was granted or was in force, shall be of any validity.

X. *Letters issuable to assignee.* Letters patent may be issued by the Governor in Council to the assignee of any person who may have taken out letters patent for his invention or discovery in any other country, but not for any invention or discovery made abroad for which no letters patent have been there obtained : Provided, that the invention or discovery so assigned shall not have been introduced into public and common use in this colony prior to the application for a patent ; and that the assignee of such foreign patent shall file, with his application, the assignment duly proved under which he claims a patent in this colony, and an affidavit, setting forth the date of the patent abroad, that the article thereby

patented has not been in public and common use in this colony, and that he is the assignee for a good consideration.

XI. *Forfeiture for failure to operate.* Any letters patent which may be taken out under or by virtue of this chapter, and which shall not have been brought into operation within two years next ensuing from and after the date thereof, such letters patent shall, at the expiration of the said period of two years, be void.

XII. *Notices.* No letters patent shall be granted under or by virtue of this chapter until notice shall have been published in the Royal Gazette and one other of the newspapers of this colony, for at least four weeks, of the intention of the applicant to apply for such letters patent ; and such notice shall contain, in general terms, the description of invention for which such letters patent shall be desired.

XIII. *Remedy where patentee takes larger interest than entitled to.* If by mistake, accident, or inadvertence, and without any willful default, or intent to defraud or mislead the public, a patentee shall in his specification have claimed to be the original and first inventor or discoverer of any material or substantial part of the thing patented, but of which he was not the original or first inventor, and shall have no just or legal right to claim the same, his patent in such case shall be valid for so much of the invention or discovery as shall be actually his own, provided it is a material and substantial part of the thing patented, and be plainly distinguishable from other parts patented without right ; and every such patentee and his legal representatives, whether holding the whole or a particular interest in the patent, may maintain suits at law or in equity, for any infringement of such part of the same as is actually the invention or discovery of the patentee, although his specification may embrace more than he has a legal right to claim ; but if in such case the plaintiff shall obtain a verdict or judgment, he shall not be entitled to costs, unless before the commencement of the suit he shall have filed in the office of the colonial secretary a disclaimer, attested by a witness, of that part of the thing patented which was claimed without right ; and no person bringing a suit shall be entitled to the benefits of this section, if he shall have unreasonably neglected or delayed to record his disclaimer.

XIV. *Disclaimer of surplus when specification too broad.* If through inadvertence, accident, or mistake, a patentee shall have made his specification too broad by claiming more than that of which he was the original or first inventor (some material and sub-

stantial part of the thing patented being justly and truly his own), the disclaimer shall be in writing, and shall state the extent of interest in the patent held by the party making the same ; it shall be attested by a witness, and be recorded in the office of the colonial secretary ; thereafter, such disclaimer shall be considered as part of the original specification, to the extent of the interest possessed by the party making the same, or by those claiming under him ; but no such disclaimer shall affect any action or suit pending at the time of its being recorded, except so far as may relate to the question of unreasonable neglect or delay in recording the same.

XV. *Reissue for want in the description, &c.* If any patent shall become 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 a right to claim, and the error has arisen from inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, the Governor in Council, upon the surrender of such patent, and upon petition therefor, may cause a new patent to be issued to the patentee, for the residue of the term mentioned in the first patent in accordance with the patentee's amended description and specification : in case of his death, or the assignment by him of the original patent or any fractional interest therein, the right shall vest in his legal representatives to the extent of their respective interests in such patent ; and the patent so re-issued, together with the amended description and specification, shall have the same effect and operation in law as though the same had been originally filed in such amended form before the issuing of the original patent.

XVI. *Right of patentee to patent improvements.* If an original patentee shall be desirous of adding a description and specification of an improvement upon his original invention or discovery, made or discovered by him subsequent to the date of his patent, he may, upon the like proceedings being had in all respects as in the case of an original application, have the same annexed to his original description and specification ; and the colonial secretary shall certify upon such annexed description and specification the time of its being annexed and recorded, and thereafter it shall have the same effect in law as if it had been embraced in the original description and specification, and had been recorded therewith.

XVII. *No patent granted elsewhere, valid in Newfoundland until, &c.* No patent for any invention or discovery, granted in England or elsewhere out of the colony, and extending to the col-

onies, shall be of force and effect in this colony, until copies of the original specification and drawings filed, or duplicates of the models lodged, in England or elsewhere out of the colony, upon which such patent was there obtained, shall be filed or lodged in the office of the colonial secretary, who shall grant a certificate of the lodging or filing of the same.

XVIII. *Affirmations and oaths.* All oaths required by this chapter, unless otherwise directed, may be taken in this colony before a judge of the Supreme Court, or a commissioner for taking affidavits in the same; or in Great Britain or Ireland, before the mayor of a city or borough, and shall be certified under the corporate seal; or, in a foreign country, before a British consul or vice-consul, and shall be certified under his seal of office.

XIX. *Patentee to pay fees of office and twenty-five dollars.* Any person who may take out letters patent under this chapter shall pay for the same such fees as are charged on documents issued under the Great Seal of this Island, and shall, in addition, deposit with the colonial secretary the sum of twenty-five dollars, to be by him paid to the receiver-general for the use of the colony.

From *Carp. Pat. L. of World*, 405.

NEW SOUTH WALES.

An Act to authorize the Governor General, with the advice of the Executive Council, to grant letters of registration for all Inventions and Improvements in the Arts or Manufactures, to have the same effect as Letters Patent in England, so far as regards this Colony. No. XXIV., December 6, 1852.

Preamble. Whereas it is expedient that the exclusive benefit of inventions and improvements in the arts or manufactures should be secured for limited periods to the author or authors, or designer or designers thereof, or to his or their agents or assignees: And whereas it is doubtful whether the laws of the United Kingdom respecting patents extend to or have effect in the Colony of New South Wales: Be it therefore enacted by His Excellency the Governor of New South Wales, with the advice and consent of the Legislative Council thereof, as follows:—

I. *Governor may grant letters of registration for improvements in arts or manufactures.* From and after the passing of this Act it shall and may be lawful for His Excellency the Governor of the said colony, with the advice of his Executive Council, to grant letters of registration under his sign manual and the seal of the colony for the exclusive enjoyment and advantage, for a period of not less than seven nor more than fourteen years, for all inventions or improvements in the arts or manufactures, to the author or authors, or designer or designers thereof, or to his or their agents or assignees, as soon as such proceedings shall have been taken by such author or authors, or designer or designers respectively as are in that behalf hereinafter mentioned.

II. *Deposit to be paid to colonial treasurer.* Every person who upon claiming to be the author or designer, by his agent or assignee, of any invention in or improvement to the arts or manufactures shall be desirous of obtaining such a letter of registration as is hereinbefore mentioned shall deposit with the colonial treasurer the sum of twenty pounds sterling, and shall, after such deposit, present a petition to His Excellency the Governor, setting forth that he is the author or designer, or the agent or assignee of such author or designer, as the case may be, of a certain invention in or improvement to the arts or manufactures, and specifying the particulars of such invention or improvement, and that he has

deposited with the colonial treasurer the sum of twenty pounds for defraying the expense of granting the letters of registration required by this Act, it shall be lawful for the said Governor for the time being to refer the said petition to one or more competent person or persons, to be appointed by the said Governor, to examine and consider the matters stated in such petition, and to report thereon for the information of his Excellency ; and if the report of the person or persons to whom the said petition shall have been referred by the Governor shall be favorable to its prayer, it shall be lawful for his Excellency with the advice of his Executive Council, to grant the letters of registration hereinbefore mentioned, and such letters of registration shall, within three days after the granting thereof, be registered in the proper office in the Supreme Court, otherwise such letter of registration shall be void and of no effect.

III. *Grantee of any such letter may assign the same.* Every grantee of such letter of registration shall be at liberty to assign the same, and all the benefits and advantages derivable therefrom, to any person or persons, by an instrument in writing under his hand and seal, to be registered in the Supreme Court in the same manner and within the same period after the execution thereof as the original letters of registration are hereinbefore directed to be registered.

IV. *Limit as to grantee's liability.* No grantee of any such letter of registration shall be liable in respect thereof for any higher charge than the said sum of twenty pounds, except for such costs and charges as he shall voluntarily incur, after the deposit of the said sum of twenty pounds with the colonial treasurer, as hereinbefore mentioned.

V. *Any such letter may be repealed for certain causes.* Any letter of registration granted by virtue of this Act shall be liable to be repealed by writ of scire facias for the same causes and in the same manner as other grants of the Crown are liable to be repealed.

VI. *Commencement of Act.* That this Act shall come into operation so soon as and not until the same shall have received the royal approbation, and the notification of such approbation shall have been made by order of His Excellency the Governor General in the New South Wales Government Gazette, and that such notification shall be sufficient evidence of such approbation.

From *Carpin. Pat. L. of World*, 413.

See also, AUSTRALASIA.

NEW ZEALAND.

Act to consolidate the Law relating to Letters Patent for Inventions. September 8, 1883.

1. *Short title.* The short title of this Act is "The Patents Act, 1883."

It shall come into operation on the first day of January, one thousand eight hundred and eighty-four.

2. *Division of Act.* This Act is divided into Parts as follows:—

Part I.—Mode of obtaining Letters Patent.

Part II.—Disclaimers and Alterations.

Part III.—Extension of Term and Confirmation of Invalid Patents.

Part IV.—Miscellaneous Provisions.

3. *Interpretation.* In this Act—

"Invention" means and includes any manner of new manufacture the subject of letters patent and grants of privilege within the meaning of the fourth section hereof.

"Patent-Office" means the patent-office appointed under this Act, but does not include any local patent-office;

"Patent-Officer" means the person appointed to be patent-officer under this Act;

"Regulations" means regulations made under this Act.

PART I.

MODE OF OBTAINING LETTERS PATENT.

1.—FOR WHAT, PATENT MAY ISSUE.

4. *Power to grant patents. Monopolies forbidden.* It shall be lawful to make and issue, in the manner hereinafter mentioned, letters patent and grants of privilege, for any term not exceeding fourteen years from the date thereof, of the sole working or making of any manner of new manufactures within New Zealand, to the true and first inventor of such manufactures, which others, at the time of making such letters patent and grants, shall not use, so as

also they be not contrary to the law nor mischievous to the State, by raising prices of commodities or hurt of trade, or generally inconvenient.

And all other monopolies, commissions, grants, licenses, charters, and letters patent hereafter to be made or granted to any person or for the sole buying, selling, making, working, or using of anything within New Zealand or of any other monopolies or of power, liberty or faculty to dispense with any others, and all matters and things whatsoever in anywise tending to the instituting, erecting or countenancing of the same or any of them, shall be utterly void and of none effect, and in no wise to be put in execution.

2.—REGULATIONS.

5. *Governor in Council to make regulations.* The Governor in Council from time to time may make such regulations not inconsistent with the provisions hereof, as may appear to be necessary and expedient for the purposes of this Act, and all such regulations shall be gazetted.

All regulations in force under any Act hereby repealed shall remain in force as if made under this Act until other regulations are made as hereinbefore provided.

6. *Patent-officer ; patent-office.* The Governor may from time to time appoint such person as he thinks fit to be patent-officer, and in like manner may appoint a place to be the "patent-office."

The person who, at the commencement of this Act, holds the office of patent-officer under the Acts hereby repealed, shall be the patent-officer under this Act, without any further appointment.

The place at the commencement of this Act used as the patent-office shall be deemed to have been appointed under this Act.

7. *Deputy patent-officer.* The Governor at any time may appoint a fit and proper person to be deputy patent-officer, to act in case of the death, illness, or unavoidable absence of the patent-officer, and such deputy shall, during the time he shall so act, have all the powers and privileges, and shall perform all the duties, and be subject to the responsibilities of the patent-officer.

Whenever the patent-officer shall die, the deputy patent-officer shall act as such from the day of such death, and, in the case of illness or absence, shall act as such from such day as the patent officer shall certify under his hand to the deputy patent-officer that he is ill and unable to perform his duties, or that he is about to be absent ; and such deputy patent-officer shall cease to act as such on

the day on which he shall receive from the patent-officer a certificate under his hand to the effect that he has resumed his duties.

3.—PROCEDURE TO OBTAIN PATENT.

8. *Appointment of local offices and officers ; saving of existing appointments.* The Governor may, for all such purposes as he may deem necessary for the public convenience, appoint local patent-offices, and patent-office agents in the various centers of population throughout the colony, and from time to time alter or revoke the appointment of such offices and agents respectively.

The local patent-offices and the patent-office agents appointed under "The Patents Act Amendment Act, 1882," shall be deemed to have been appointed under this Act without further appointment.

Such agents shall not demand or receive from the applicant, or any one on his behalf, any fees or charges whatever other than such as are payable under this Act.

9. *Mode of application; first schedule; receipt.* Every application under this Act for the grant of letters patent for an invention shall be made as follows, that is to say :

(1.) The applicant shall deposit at the patent-office, or at any local patent-office, a specification, written in a plain legible hand or printed in fair legible type upon parchment or paper, and under his hand and seal, in the form or to the effect in the first schedule hereto, particularly describing and ascertaining the nature and details of the said invention with precision, and in what manner the same is to be performed, and containing a distinct claim for the especial novelty thereof, and accompanied by drawings, if necessary, for the full description and understanding of the said invention, and also a copy of such specification and drawings.

(2.) The title of the invention must state distinctly and specifically the nature and object of the invention, and every specification must be limited to one invention.

(3.) If such deposit be made at any local office the patent-office agent shall give the applicant or his agent a receipt therefor in the form contained in the second schedule hereto, or to the like effect, and shall forthwith transmit the documents and a copy of his receipt to the patent-officer.

10. *Protection of invention; third schedule.* (1.) The exact time of the deposit of every specification which, upon examination by the patent-officer, is found to be in accordance with this Act and the

regulations shall be recorded at the patent-office, and indorsed upon such specification, and a certificate thereof, under the hand of the patent-officer and in the form contained in the third schedule hereto, shall be given or transmitted to such applicant or his agent.

(2.) And thereupon, subject and without prejudice to the provisions hereinafter contained, the said invention shall be protected under this Act for the term of twelve months next after the said deposit, and the applicant shall have during such term the like powers, rights and privileges as might have been conferred upon him by letters patent for such invention issued under this Act and duly sealed as of the day of such deposit.

(3.) During the continuance of such powers, rights and privileges under this provision, such invention may be used and published without prejudice to any letters patent to be granted for the same.

11. *Patent not affected by specification of pretended inventor.* In case of the deposit of any such specification as aforesaid in fraud of the true and first inventor, any letters patent granted to the true and first inventor of such invention shall not be invalidated by reason of such deposit, or of any use or publication of the invention subsequent to such deposit and before the expiration of the said term of protection.

12. *Hearing of application; fourth schedule; objections.* The patent-officer shall make an appointment for the hearing of every application, in the form contained in the fourth schedule to this Act or to the like effect; and shall publish a notification of the said appointment once in the Gazette, not less than sixty clear days prior to the day appointed.

Any person having an interest in opposing the grant of letters patent shall be at liberty, not less than fourteen clear days before the day so appointed, to leave particulars in writing of his objections to the said application at the patent-office.

13. *Patent officer to hear applications and objections.* At the place and time named in the said appointment the patent-officer shall hear and consider the said application, and all objections to the same, if any, mentioned in the said particulars, and may call to his aid such scientific or other person as he may think fit.

The applicant, the objectors, and their respective witnesses and evidence shall be respectively heard, examined and considered separately and apart from and in the absence of the other, his witnesses and evidence.

The patent-officer shall have full power to examine applicant, objectors, and witnesses upon oath, and to administer an oath to any or all of them.

14. *Hearing may be adjourned.* The patent-officer may adjourn from time to time the hearing of any application for letters patent.

15. *Award of expenses and costs ; fifth schedule.* The patent-officer may require that the applicant and the objector shall deposit such sums as the patent-officer may think fit to meet any costs of or incident to the hearing, and may, by writing under his hand, order to be paid to any person he may call to his aid as aforesaid, some remuneration for his attendance, and may also, in like manner, order that the costs of any hearing upon any objections, or otherwise in relation to the grant of such letters patent, or the protection acquired by the applicant under this Act, shall be paid ; and, in and by such writing, shall fix the amount of such remuneration or costs, and by or to whom the same respectively shall be paid.

Every such order shall be in the form contained in the fifth schedule, or to the like effect, and may be made a rule of the Supreme Court.

16. *Patent-officer may issue warrant for letters patent ; sixth schedule.* If there shall be no objection to the grant of letters patent and he is satisfied that this Act and the regulations have been complied with, the patent-officer may, on the day appointed, or as soon thereafter, and, when there are objections, after such hearing and consideration, issue a warrant under his hand for the granting of letters patent for the said invention ; and, by such warrant, shall direct the insertion in such letters patent of all such restrictions, conditions, and provisos, as he may deem usual and expedient in such grants, or necessary in pursuance of this Act.

Such warrant shall be the authority for the making and sealing of letters patent under this Act, according to the tenor of the said warrant.

Every such warrant shall be in the form set forth in the sixth schedule or to the like effect.

17. *Amendments.* In case the title of the invention or the specification be too large or insufficient, or clerical errors exist therein, the patent-officer, on the hearing of the application for the grant of the letters patent, may allow or require such specification to be amended, or another and sufficient specification to be deposited in lieu thereof, and every such amended, or new

specification shall have the same force, effect, and operation as if it had been originally deposited in its amended or new state.

When an applicant desires to amend his specification or drawings, or to substitute an amended specification, he must deposit particulars of such amendment or such amended specification at the patent-office at least fifteen days before the day of hearing.

18. *Letters patent to be issued on application and during the protection.* (1.) The patent-officer, after the issue by him of the said warrant, and on application in writing by the applicant or his agent, with payment of the fee thereon, shall cause to be prepared letters patent for the invention according to the tenor of the said warrant, and the Governor may cause such letters patent to be sealed with the public seal of the colony.

(2.) Such letters patent shall be made applicable to the colony and its dependencies, and shall be valid and effectual as to the whole of the same respectively; but, except as hereinafter mentioned, no letters patent shall issue on any warrant granted as aforesaid, unless application be made to seal such letters patent during the continuance of the protection conferred under this Act, by reason of such deposit as aforesaid.

19. *Letters patent may issue after that time in certain cases.* (1.) When the application to seal such letters patent has been made during the continuance of such protection as aforesaid, and the sealing of such letters patent has been delayed from accident, and not from the willful default of the applicant, then such letters patent may be sealed at such time after the expiration of such protection as the Governor may direct.

(2.) Where the applicant for such letters patent dies during the continuance of such protection as aforesaid, such letters patent may be granted to the executors or administrators of such applicant during the continuance of such protection or at any time within three months after the death of such applicant, notwithstanding the expiration of the term of such protection; and the letters patent so granted shall be of the like force and effect as if they had been granted to such applicant during the term of such protection.

20. *Duplicate letters patent may be issued.* In case any letters patent shall be lost or destroyed, duplicate letters patent of the like tenor and effect, and sealed and dated as of the same day as such lost or destroyed letters patent, may be issued upon evidence of such loss or destruction being produced to the satisfaction of the patent-officer.

21. *Letters patent to bear date of deposit of specification, and to be conclusive as to preliminary steps.* Notwithstanding any enactment to the contrary, all letters patent to be issued in pursuance of this Act shall be sealed and bear date as of the day of the deposit of such specification as aforesaid, and shall be of the same force and validity as if they had been sealed on the day as of which they are expressed to be sealed and bear date.

After any letters patent shall have been issued in pursuance of this Act, it shall not be necessary or material to inquire whether such appointment as aforesaid has or has not been delivered and published in the manner hereinbefore mentioned and directed.

4.—FORM AND CONDITIONS OF PATENT.

22. *Conditions for granting letters patent ; seventh schedule.* All letters patent for inventions granted under this Act shall be in the form contained in the seventh schedule, or to the like effect, and shall be made subject to the provisions of this Act, and to the conditions and restrictions that may be inserted in such patent by virtue thereof, or that are imposed by this Act, that is to say :—

(1.) That the powers and privileges thereby granted shall cease and determine at the expiration of five years from the date thereof, unless there be paid within such five years the sum or sums of money required to be paid under this Act, and the patent-officer shall indorse a receipt for the same on the letters patent.

(2.) No letters patent shall extend to entitle the patentee to use or imitate any invention or work which, before the date of such patent, had been found out or invented by any other person, and publicly used or exercised, or to whom like letters patent or privileges have been already granted for the sole use, exercise and benefit thereof within the colony.

(3.) The patentee, and all and every other person and persons to whom letters patent or privileges have been granted shall distinctly use and practice their several inventions by them invented and found out according to the true intent and meaning of the same respective letters patent.

(4.) Nothing contained in any letters patent shall prevent the patentee from granting licenses in such manner and for such considerations as they may by law be granted.

23. *Matters rendering letters patent void.* All letters patent and all privileges and advantages whatsoever thereby granted shall utterly cease and become void—

(1.) If the specification does not particularly describe and ascertain the nature of the invention, and in what manner the same is to be performed.

(2.) If at any time during the term for which such letters patent are granted it appears that the grant is contrary to law or prejudicial or inconvenient to the public good, or that the invention therein mentioned is not a new invention, or that the patentee is not the true and first inventor thereof within this colony.

(3.) If the patentee shall not supply or cause to be supplied for the government of the colony all such articles of the said invention as he is required to supply by the persons administering the department of the public service for the use of which the same are required, in such manner, at such times, and at and upon such reasonable prices and terms as shall be settled for that purpose by the said persons requiring the same.

24. *Invention to be brought into actual and public use.* Every invention protected by letters patent issued under this Act shall be brought into actual and public use within the colony within the space of two years from the date of such letters patent, or in default thereof such letters patent shall at the expiration of such period of two years cease and be of no effect.

5.—REPEAL OF PATENT.

25. *Letters patent may be repealed, &c., or specification may be canceled.* (1.) An action shall lie for the repeal of any letters patent granted under this Act, and may be commenced in any district of the Supreme Court, in such form as may be authorized by its rules in substitution for the process by writ of scire facias; and in case the grantee does not reside in New Zealand, it shall be sufficient to file the writ in the Supreme Court, and to serve notice of such action in writing at the last known place of residence or business of such grantee.

(2.) The Governor in Council, upon the issue of the writ in such action, may order such patent-officer to withhold such warrant as aforesaid, or that any letters patent, for the granting whereof he may have issued a warrant as aforesaid, shall not issue; or may order the insertion, in any such letters patent, of any restrictions, conditions or provisos in addition to or in substitution for any restrictions, conditions or provisos which would otherwise be inserted therein under this Act.

(3.) The Governor in Council may also order any specification

in respect of the invention described, in which no letters patent may have been granted, to be canceled, and thereupon the protection obtained by the deposit of such specification shall cease.

26. *Patent not to prevent use of invention in foreign ships.* No letters patent granted for any invention shall extend to prevent the use of any such invention in any foreign ship or vessel, or for the navigation of any foreign ship or vessel which may be in any port of New Zealand, or in any of the waters within the jurisdiction of any of Her Majesty's courts in New Zealand, where such invention is not so used for the manufacture of any goods or commodities to be vended within or exported from the same.

But this enactment shall not extend to the ships of vessels of any foreign state the laws of which authorize subjects of such foreign state, having patents or like privileges for the exclusive use or exercise of inventions within its territories, to prevent or interfere with the use of such inventions in British ships or vessels or in or about the navigation of British ships or vessels while in the ports of such foreign state, or in the waters within the jurisdiction of its courts, where such inventions are not so used for the manufacture of goods or commodities to be vended within or exported from such foreign state.

6.—LETTERS OF REGISTRATION.

27. *Registration for foreign patents; tenth schedule.* The Governor in his discretion, on the application of any person being the holder or assignee of any letters patent or like protection issued in Great Britain or any other country or colony for an invention or discovery, and upon such proof as the Governor may by regulations require that such person is the *bonâ fide* holder or assignee thereof, and that the same are or is in full force, and upon payment of the sum of ten pounds, may grant letters of registration to such applicant.

(2.) Such letters of registration shall be in the form contained in the tenth schedule or to the like effect, and shall have the same force and effect as letters patent granted under this Act, and shall inure to the benefit of the grantee thereof, his executors, administrators, and assigns, during the continuance of the original letters patent or other protection in the country or colony where the same was or were granted, and no longer; and all the provisions of this Act shall apply to such letters of registration in the same way, *mutatis mutandis*, and as fully as to letters patent granted under this Act.

(3.) A copy of all such letters of registration shall be filed in the patent-office.

PART II.

DISCLAIMERS AND ALTERATIONS.

28. *Notice to disclaim; alter; procedure; eighth schedule; opposition.* (1.) Any person who shall obtain letters patent under this Act, his executors or administrators, or, in case he or they shall part with the whole or any part of his or their interest by assignment, he or they together with the assignee if part only has been assigned, or the assignee alone if the whole has been assigned, may apply to the patent-officer for leave to enter a disclaimer of any part of either the title to the invention, or the specification, or a memorandum of any alterations in the said title or specification, not being such disclaimer as shall extend the exclusive right granted by the said letters patent.

(2.) Thereupon the patent officer shall deliver to the person or persons applying, or to their agent, or to one of them, or the agent of one of them, an appointment in the form contained in the eighth schedule or to the like effect, and the person or persons so applying shall cause such disclaimer (stating the reason for the same), or such memorandum of alteration, to be written at the foot of the said appointment, and shall cause the same respectively to be published forthwith in the Gazette.

(3.) Any person having an interest in opposing the said application, shall be at liberty to leave particulars, in writing, of his objections to the same at the patent-office within such time not less than fourteen clear days prior to the day so appointed.

(4.) Where such application shall be for leave to enter a disclaimer of any part of the title of the said invention, or a memorandum of any alteration in such title, the patent-officer may dispense with such appointment and publication, and in that case shall certify in the fiat hereinafter mentioned that he has dispensed with the same.

29. *Application for disclaimer to be heard.* At the time and place named in such appointment the patent-officer shall hear and consider the said application, and all objections to the same mentioned in the said particulars, if any, and all such powers and authority shall and may be exercised upon that occasion by the patent-officer

as, by virtue of the provisions herein contained, can and may be exercised in relation to the hearing and considering an application for letters patent and objections to the same, and shall and may be enforced in like manner.

30. *How disclaimer entered and alterations ; effect.* (1.) After such hearing and consideration, or without such hearing or consideration, where the said appointment and publication shall have been dispensed with as aforesaid, the person or persons applying, or one of them, may by leave of the patent-officer, to be certified by a fiat under his hand, to be written at the foot of the same paper or parchment with the said disclaimer or memorandum, enter such disclaimer (stating the reason for the same), or such memorandum of alteration, and at the time of entering such disclaimer or memorandum of alteration, shall deposit a copy thereof in the office next hereinafter mentioned.

(2.) Such disclaimer or memorandum of alteration, being filed in the patent-office, shall be deemed and taken to be part of such letters patent or such specification, and subject to the several incidents thereof, in all courts whatever, and shall be valid and effectual in favor of any person in whom the rights under the said letters patent may then be, or thereafter become, legally vested.

31. *Actions not brought, when ; proceedings conclusive.* (1.) No action shall be brought upon any letters patent in respect of which, or the specification of which, any disclaimer or memorandum of alteration shall have been filed, in respect of any infringement committed prior to the filing of such disclaimer or memorandum of alteration (unless the patent-officer shall certify, in his said fiat, that any such action may be brought, notwithstanding the entry or filing of such disclaimer or memorandum of alteration), and no such disclaimer or alteration shall be receivable as evidence in any action or suit (save any proceedings for the repeal of letters patent) pending at the time when such disclaimer or alteration was filed as aforesaid ; but in every such action or suit the original title and specification alone shall be given in evidence, and be deemed and taken to be the title and specification of the invention for which the letters patent have been or shall have been granted.

(2.) When any such fiat shall have been granted under this Act, it shall not be necessary or material to inquire or ascertain whether such appointment as last aforesaid has or has not been delivered and published or dispensed with in accordance with this Act, and such filing of any disclaimer or memorandum of alteration, in pur-

suance of the leave of the patent-officer, certified as aforesaid, shall (except in cases of fraud) be conclusive as to the right of the party to enter such disclaimer or memorandum of alteration under this Act.

PART III.

EXTENSION OF TERM.

32. *Mode of obtaining extension; petition.* (1.) Any person who has obtained letters patent under this Act or any other Act relating to letters patent heretofore in force in New Zealand, or the executors or administrators of such person, or (in case such person shall have parted with the whole or any part of his interest in such patent by assignment) he or they together with the assignee when part only has been assigned, or the assignee alone when the whole has been assigned, may, six months before the expiration or other determination of such letters patent, present to the Governor a petition for the extension of the term in such letters patent mentioned.

(2.) Such petition shall set forth that the petitioner has been unable to obtain a due remuneration for his expense and labor bestowed in perfecting such invention, and that an exclusive right of using and vending the same for some further period, to be named in such petition, in addition to the said term, is necessary for his reimbursement and remuneration, and the Governor may refer the consideration of the said petition to one or more commissioners to be appointed for that purpose in the manner hereinafter mentioned.

33. *Appointment of commissioners.* For the purpose of considering any such petition, the Governor, if he shall think fit, may issue and direct, in the name of Her Majesty, to one or more persons a commission reciting such petition, and requiring and authorizing such person, or some stated number of such persons, to meet at some time, not being less than two months from the publication of such commission in the Gazette, and at some place to be respectively fixed in the said commission, and then and there to consider the said petition, and to report to the Governor (in case such petitioner shall have prayed for an extension of the term in the letters patent mentioned) whether any, and if any, what further extension of the said term should be granted, according to the prayer of the said petition.

34. *Notice of commission; ninth schedule; caveat.* (1.) Two

months at least before the time fixed in the said commission for the consideration of any such petition as aforesaid, the petitioner shall cause to be published, in the same manner as is hereinbefore required with respect to the first mentioned appointment, an advertisement of the contents of the said commission in the form contained in the ninth schedule, or to the like effect.

(2.) Any person having an interest in opposing the said petition shall be at liberty to enter a caveat against the same at the patent-office, at any time not less than one week before the time named in the said commission for the consideration thereof.

35. *Commissioners to hear all parties, and report.* (1.) At the time and place fixed in the said commission the commissioners, or some of them not less than the said stated number, shall proceed to consider such petition, and the petitioner shall be heard by his counsel and witnesses, to prove his case as stated in such petition, and the publication of the said last mentioned advertisement as required by this Act, and the persons entering caveats shall likewise be heard by their counsel and witnesses, and all such witnesses shall be examined upon oath, which oaths such commissioners are hereby authorized to administer.

(2.) Thereupon, and on hearing and inquiry of the whole matter (in case such petitioner shall have prayed for an extension as aforesaid), the said commissioners may report whether any, and, if any, what, further extension of the said term shall be granted, and the Governor is hereby authorized and empowered, if he shall think fit, to grant to the petitioner new letters patent for the said invention, not exceeding three years after the expiration of the first term, anything herein contained to the contrary notwithstanding.

Such new letters patent shall be sealed and bear date as of the day after the expiration of the term of the first letters patent.

PART IV.

MISCELLANEOUS PROVISIONS.

1.—RECORDS OF OFFICE.

36. *Specification, &c., of invention to be open to inspection.* Every specification deposited at the patent-office, and the drawings and models accompanying the same, if any, and all other documents so deposited, shall be kept in the patent office, and shall be open to the inspection of the public at all reasonable times, as well

before as after the grant of letters patent, and whether such letters patent be granted or not, but subject to regulations.

37. *Indices to specifications, disclaimers, &c.* Indices to all specifications, disclaimers and memoranda of alterations, heretofore or to be hereafter enrolled or deposited as aforesaid, shall be prepared and shall be open to the inspection of the public at the patent-office, subject to regulations.

38. *Register of patents to be kept.* There shall be kept at the patent-office a book, to be called The Register of Patents, wherein shall be entered and recorded in chronological order—

All letters patent and letters of registration granted under this Act or the Patents Act, 1870.

The deposit and filing of specifications, disclaimers and memoranda of alterations, filed in respect of such letters patent.

All amendments in such letters patent and specifications.

All confirmations and extensions of such letters patent.

The expiry, determination, vacating, or canceling of such letters patent, with the dates thereof respectively ; and

All other matters and things affecting the validity of such letters patent as the Governor may direct.

Such register or a copy thereof shall be open at all convenient times to the inspection of the public, subject to such regulations as the Governor may make in that behalf.

39. *Register of proprietors, and of assignments and licenses.* There shall be kept at the patent-office a book entitled The Register of Proprietors, wherein shall be entered—

The assignment of any letters patent or letters of registration, or of any share or interest therein.

Any license under letters patent or letters of registration, and the district to which such license relates, with the name of any person having any share or interest in such letters patent or letters of registration or license.

The date of his acquiring such letters patent or letters of registration, share or interest ; and

Any other matter or thing relating to or affecting the proprietorship in such letters patent or letters of registration, or license.

2.—ASSIGNMENTS.

40. *Conditions for registering assignment.* Before any assignment or license shall be registered, the assignee or licensee shall furnish—

(1.) A statutory declaration by one of the attesting witnesses to the said assignment or license of the due execution of the said assignment or license :

Provided that, if it be proved to the satisfaction of the said patent-officer that the attesting witness to any such assignment or license is dead or cannot be found, the execution of the said assignment or license may be proved by a statutory declaration of any other person capable of declaring to the same :

(2.) A certified copy or copies of the assignment or license, and other instruments or documents of title.

41. *Assignment or license to be made by separate deed.* No assignment or license of two or more letters patent or letters of registration included in one deed or instrument shall be registered, and no certificate of assignment or license shall be granted, unless a fee for such registration or certificate be paid in respect of each such letters patent or letters of registration in respect of which such registration or certificate is desired.

42. *Register of proprietors to be open to inspection ; copies.*
 (1.) A copy of any entry in such book, certified as hereinafter mentioned, shall be given to any person requiring the same, and shall be *prima facie* proof of the assignment of such letters patent or letters of registration, or share or interest therein, or of the license or proprietorship as therein expressed.

(2.) Until such entry shall have been made, the grantee of the letters patent or letters of registration shall be deemed to be the sole and exclusive proprietor thereof, and of all the licenses and privileges thereby given.

(3.) Such register, or a copy, shall be open to public inspection subject to regulations.

3.—SEAL.

43. *Seal to be noticed judicially ; certified copies, evidence.*
 (1.) The Governor may cause a seal to be made for the purposes hereinafter mentioned, and all courts, judges, and other persons whosoever shall take notice of such seal, and receive impressions thereof in evidence, in like manner as impressions of the seal of the Supreme Court are received in evidence.

(2.) All copies or extracts, certified by the patent-officer and sealed with such seal, of letters patent, letters of registration, specifications, disclaimers, memoranda of alterations, and all other documents or books recorded, filed, and kept in pursuance of this

Act, shall be received in evidence in all proceedings relating to letters patent for inventions and letters of registration in all courts and by all judges and other persons whomsoever.

4.—OFFENSES.

44. *Falsification or forgery of entries.* If any person shall willfully make or cause to be made any false entry in any such register, or shall willfully make or forge, or cause to be made or forged, any writing falsely purporting to be a copy of any entry therein, or shall produce or tender, or cause or suffer to be produced or tendered, any such writing, knowing the same to be false, he shall be guilty of a misdemeanor, and shall be liable, on conviction, to be kept in penal servitude for any term not exceeding five years, or to be imprisoned and kept to hard labor for any term not exceeding two years.

45. *Entries may be expunged.* If any person shall deem himself aggrieved by any entry made under color of this Act in any such register, such person may apply by motion to the Supreme Court, or by summons to a judge of such court, for an order that such entry may be expunged, vacated, or varied; and upon any such application such court or judge may make such order for expunging, vacating, or varying such entry, and as to the costs of such application, as to such court or judge may seem fit; and the patent officer, on the production to him of any such order, shall expunge, vacate, or vary the said entry according to such order.

46. *Penalty for unauthorized use of the word "patent."*

(1.) If any person:—

Shall write, paint, print, mould, cast, carve, engrave, stamp, or otherwise mark upon anything made, used, or sold by him, for the sole making or selling of which he has not or shall not have obtained letters patent, the name or any imitation of the name of any other person who has or shall have obtained letters patent for the sole making and vending of such thing, without leave in writing of such patentee or his assigns; or

Shall 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 had the license or consent in writing of such patentee or his assigns, write, paint, print, mould, cast, carve, engrave, stamp, or otherwise mark the word "patent," the words "letters patent," or the words "by the Queen's patent," or any words of the like kind, meaning, or import, with a view of imita-

ting or counterfeiting the stamp, mark, or other device of the patentee, he shall for every such offense forfeit and pay the sum of one hundred pounds, one half to Her Majesty, and the other half, with full costs of suit, to any person who shall sue for the said penalty.

(2.) If any person shall upon any such thing for which no letters patent or like protection shall have been obtained, write, paint, print, mould, cast, carve, engrave, stamp, or otherwise mark the word "patent," the words "letters patent," or the words "by the Queen's letters patent," or any words of the like kind, meaning, or import, or by advertisement, or in any other way imply or give reasonable cause to believe that letters patent or like protection have been granted for such thing, he shall, for every such offense, be liable to a penalty not exceeding fifty pounds, one half of which shall be paid to any person who shall sue for the said penalty.

(3) But nothing herein contained shall be construed to extend to subject any person to any penalty in respect of stamping or in any way marking the word "patent" upon anything for the sole making or vending of which letters patent before obtained shall have expired or otherwise determined.

5.—PROCEDURE IN ACTIONS FOR INFRINGEMENT.

47. *Actions for infringement, particulars of breaches and objections.* (1) In any action for the infringement of letters patent, the plaintiff shall deliver with his statement of claim particulars of the breaches complained of in the said action, and the defendant, on pleading thereto, shall deliver with his statement of defense, and the prosecutor in any proceedings by action to repeal letters patent shall deliver with his statement of claim, particulars of any objections on which he means to rely at the trial in support of the said action, or of the suggestions of the statement last mentioned respectively. At the trial of any such action no evidence shall be allowed to be given in support of any alleged infringement, or of any objection impeaching the validity of such letters patent, which shall not be contained in the particulars delivered as aforesaid.

(2.) The place or places at or in which and in what manner the invention is alleged to have been used or published prior to the date of the letters patent shall be stated in such particulars, and any judge at chambers may allow such plaintiff or defendant or prosecutor respectively to amend the particulars delivered as aforesaid upon such terms as to such judge shall seem fit.

(3.) At the trial of any proceeding to repeal letters patent, the

defendant shall be entitled to begin and to give evidence in support of such letters patent ; and in case evidence shall be adduced on the part of the prosecutor impeaching the validity of such letters patent, the defendant shall be entitled to the reply.

48. *Taxing costs ; effect of record and certificate.* (1.) In taxing the costs in any action for infringing letters patent regard shall be had to the particulars delivered in such action, and the plaintiff and defendant respectively shall not be allowed any costs in respect of any particulars, unless certified by the judge, before whom the trial was had, to have been proved by such plaintiff or defendant respectively without regard to the general costs of the cause ; and the judge before whom any such action shall be tried may certify on the record that the validity of letters patent in the statement mentioned came in question.

(2.) The record, with such certificate, being given in evidence in any action for infringing the said letters patent, or in any proceeding in an action to repeal the letters patent, shall entitle the plaintiff in any such action, or the defendant in such proceeding, on obtaining a decree, order, or final judgment, to his full costs, charges, and expenses, to be taxed as between solicitor and client, unless the judge making such decree or order, or the judge trying such action or proceeding, shall certify that the plaintiff or defendant respectively ought not to have such full costs.

6.—FEES.

49. *Eleventh schedule ; Governor may reduce fees.* There shall be paid, in respect of the several matters and things respectively mentioned in the eleventh schedule, such fees as are therein enumerated, and all such fees shall be paid into the public account and form part of the consolidated fund.

The Governor may reduce any of such fees respectively from time to time by notification in the Gazette.

7.—REPEALS.

50. *Repeal ; twelfth schedule ; saving.* (1.) The Acts enumerated in the twelfth schedule are hereby repealed.

(2.) But such repeal shall not affect any proceedings or things lawfully taken or commenced, or any letters patent, or letters of registration granted, or any protection or right conferred under the said repealed Acts before the commencement of this Act ; and all

such proceedings and things shall be as valid, and all such letters patent, letters of registration, protections, and rights shall have the same force and efficacy as if this Act had not passed.

SCHEDULES.

FIRST SCHEDULE.

Specification for Patent.

Whereas I, _____, of _____, in the [Engineer] am desirous of obtaining letters patent for securing unto me Her Majesty's special license that I and such others as I should at any time agree with, should, from time to time during the term of fourteen years (to be computed from the day on which this instrument shall be left at the patent-office) make, use, and vend within the Colony of New Zealand and its dependencies an invention for [insert the title of the specification], and in order to obtain the said letters patent, I must by an instrument in writing under my hand and seal particularly describe the nature of the said invention, and in what manner the same is to be performed, and make a distinct claim for the especial novelty thereof; Now therefore, the nature and details of the said invention, and the manner in which the same is to be performed, are particularly described in the following statement [describe the invention and the especial novelty thereof, either in instrument or in attached schedule]. And I do hereby for myself, my heirs, executors, and administrators, covenant with Her Majesty, her heirs and successors, that I believe the said invention to be a new invention as to the public use and exercise thereof, that I do not know or believe that any other person than myself is the true and first inventor of the said invention, that I will not deposit these presents at the patent office with any such knowledge or belief as last aforesaid.

In witness whereof, I have hereunto set my hand and seal this _____ day of 18 .

Witness to signature.

SECOND SCHEDULE.

Receipt for Specification.

Received from A. B., specification for an invention for [insert the title] for transmission to the patent-office, Wellington, at the hour of [insert the time] on this day of 18 .

Local Patent Office.

O. A., Patent-Office Agent.

THIRD SCHEDULE.

Deposit of Specification.

No.

I hereby certify that _____, being the applicant _____ for the grant to _____ of letters patent for an invention the name whereof is _____, ha _____ this day, under the provis-

ions in that behalf contained in the Patents Act, 1883, deposited at this office an instrument in writing under hand and seal, particularly describing and ascertaining the nature of the said invention, and in what manner the same is to be performed; and also a copy of such instrument, and of the drawings accompanying the same, and the day of the deposit of such specification has been recorded in this office, and indorsed on such specification.

Dated this day of 18

Patent-Office, Wellington,
New Zealand.

P. O., Patent-Officer.

FOURTH SCHEDULE.

Hearing Application.

Patent-Office, Wellington, 18 .

Patent for [*insert title of specification*] A. B., of , has deposited at this office a specification of the said invention, and I have appointed the day of next at o'clock in the forenoon, at this office, to hear the said application and all objections thereto; and I require all persons having an interest in opposing the grant of such letters patent to leave on or before the day of next, at this office, particulars in writing of their objections to the said application; otherwise they will be precluded from urging the same.

P. O., Patent-Officer.

FIFTH SCHEDULE.

Order for Expenses.

Upon hearing the objection of A. B. to the grant to C. D. of letters patent for [*insert the title as in the specification*], I do by this writing under my hand, order that the said A. B. shall pay to the said C. D. the sum of for the costs of such hearing [or to E. F. the sum of as a remuneration for his attendance at such hearing].

Given under my hand this day of 18 .

P. O., Patent-Officer.

SIXTH SCHEDULE.

Warrant for grant of Letters Patent.

I have [*heard and*] considered the application of A. B. for letters patent for [*insert the title as in the specification*] [and also all objections to the same], and, having perused the specification, am of opinion that, as it is entirely at the hazard of the said applicant whether the said invention is new and will have the desired success, Her Majesty's royal letters patent may be issued in the form contained in the seventh schedule to the Patents Act, 1883] with the following additional clauses, that is to say (*here set them out, if any*).

Given under my hand this day of 18 .

P. O., Patent-Officer.

SEVENTH SCHEDULE.

Form of Letters Patent.

VICTORIA, by the grace of God, of the United Kingdom of Great Britain and Ireland Queen, Defender of the Faith.

To all to whom these presents shall come, greeting :

Whereas A. B. of in the of [*Engineer*] (who, with his executors, administrators, and assigns, is and are hereinafter included in the term "Patentee"), hath represented that he is desirous of obtaining letters patent for securing unto him our special license for an invention for [*insert the title of the invention*], and by an instrument in writing under his hand and seal deposited in the office of the patent-officer under the provisions of the Patents Act, 1883, the patentee hath particularly described and ascertained the nature of the said invention, and in what manner the same is to be performed ; Now, therefore, know ye that we have given and granted, and by these presents for us, our heirs and successors, do give and grant unto the patentee our special license and authority that the patentee by himself or his servants or agents, or such others as he shall at any time agree with during the term herein expressed, shall and lawfully may make, use, and vend, his said invention within our said colony and its dependencies, in such manner as to him shall seem meet ; To have, hold, and enjoy the said license, privilege, and advantage, unto and by the patentee, for and during the term of fourteen years now next ensuing ; and that he shall and lawfully may have and enjoy the whole profit, benefit, and advantage from time to time coming, accruing, and arising by reason of the said invention during the said term : subject, however, in all things to the provisions of the Patents Act, 1883, and to the conditions and restrictions thereby imposed [*and inserted herein, if any*].

In witness whereof we have caused these our letters to be made patent, and to be sealed and bear date as of the day of one thousand eight hundred and .

EIGHTH SCHEDULE.

Disclaimer.

Patent for [*insert the title*]. This is to notify to all whom it may concern that C. D. of, &c. has applied to me for leave to enter a disclaimer of part [*or, memorandum of alteration, as the case may be*] of the said invention, the particulars whereof are stated below. I do therefore appoint day the day of next at o'clock in the noon, to hear and consider the said application, and all objections to the same. And I do hereby require all persons having an interest in opposing the said application, to leave on or before the day of at my office in particulars in writing of their objections to the same ; otherwise they will be precluded from urging such objections.

Given under my hand this day of 18 .

P. O., Patent-Officer.

The following is the disclaimer [*or, as the case may be*] which I desire to make in, &c. [*The applicant must here set forth what he wishes to enter, and sign it.*]

NINTH SCHEDULE.

Extension of Patent.

Patent for [*insert the title*]. Notice is hereby given that I have presented a petition to His Excellency the Governor, praying for the confirmation of [*or, extension of the term in*] the said patent, and that a Royal Commission has issued authorizing and requiring certain commissioners therein named to consider and report upon the subject to Her Majesty, which said commissioners will meet for that purpose on the day of next at o'clock in the noon at . All persons objecting to the said confirmation [*or extension*] must enter a caveat against the same at the office of the patent-officer in Wellington, otherwise they will be precluded from objecting to it.

Dated this day of 18 .

A. B.

TENTH SCHEDULE.

Form of Letters of Registration

Know all men by these presents that :

Whereas by an Act of the General Assembly of New Zealand, entitled "The Patents Act, 1883," it is enacted that the Governor in his discretion, on the application of any person being the holder or assignee of any letters patent or like protection, and upon such proof as the Governor may by regulations require that such person is the *bona fide* holder or assignee thereof, and that the same are or is in full force, may grant letters of registration to such applicant; and that such letters of registration shall have the same force and effect as letters patent granted under the said Act, and shall inure to the benefit of the grantee thereof, his executors, administrators, and assigns, during the continuance of the original letters patent or other protection in the country or colony where the same was, or were, granted, and no longer; and all the provisions of the said Act shall apply to such letters of registration in the same way, *mutatis mutandis*, and as fully as to letters patent granted under this Act; And whereas A. B. has represented to me the Governor of the colony of New Zealand, that letters sealed and dated as of the day of one thousand eight hundred and have been issued in the to for an invention or discovery for And whereas the said A. B. has applied to me, the Governor, as aforesaid, for the grant to him of letters of registration of the said invention or discovery in pursuance of the said recited power, and has proved to my satisfaction that he the said A. B., is the *bona fide* holder (or assignee) of the said letters and that the same are in full force in the said Now know ye that I, the Governor as aforesaid of the said colony of New Zealand, in pursuance of the said recited power and authority conferred upon me by the said "Patents Act, 1883," do hereby grant unto the said A. B., his executors, administrators, and assigns, letters of registration of the said letters with all the rights, powers, and privileges thereto belonging.

Given under my hand at the at and issued under the seal of the said colony this day of in the year of our Lord one thousand eight hundred and .

Governor of New Zealand.

ELEVENTH SCHEDULE.

<i>Fees.</i>	£	s.	d.
On depositing specification.....	0	10	0
On depositing amended specification, or application for amendment to specification.....	0	10	0
On obtaining letters patent, or any duplicate thereof.....	2	0	0
At or before the expiration of the fifth year.....	7	0	0
On lodging particulars of objections.....	2	0	0
On presenting petition for extension.....	2	0	0
Search and inspection. For each book or specification.....	0	1	0
Entry of assignment or license.....	0	10	0
Certificate of assignment or license.....	0	10	0
Filing of memorandum of alteration or disclaimer.....	2	10	0
Entering any caveat.....	2	10	0
Copy or extract of any writing per common law folio.....	0	0	6
On obtaining letters of registration.....	10	0	0

TWELFTH SCHEDULE.

Acts repealed.

- 1870.—No. 89. The Patents Act, 1870.
 1881.—No. 22. The Patents Act Amendment Act, 1881.
 1882.—No. 18. The Patents Act Amendment Act, 1882.

From *Carpin. Pat. L. of World*, 416.

NICARAGUA.

*Report by Mr. Corbett, of the British Legation, published
1873.*

Translation.

The Spanish Cortes, whose resolutions obtained until the 15th of September, 1821, and as far as they are not in opposition to those of these countries, have been declared in force in this republic, assure and regulate the right of property of inventors, establishing also the term of its duration.

Decree 43 declares, as to this right—to consider as proprietor of his work him who should invent, import, or introduce.

The government, by means of the proper minister, will issue to the said proprietor a certificate, in which will appear his name as inventor, improver, or introducer of the work, a description of it (the invention), and the duration of the exclusive right. This certificate will serve as a sufficient title; but in order to obtain it, it is necessary that the petitioner should address himself to the prefect of the department or to the municipality, giving an account of his work, describing it with the greatest exactness possible in conformity with the model, which the same law establishes.

The said authorities in their turn, shall be obliged to give to the petitioner testimony of everything which may serve for the information of the minister of the department.

The inventor shall have ten years of exclusive property, the improver seven, and the introducer five. These terms may be extended by the sovereign power, on the proposition of the government, to fifteen, ten and seven years, respectively.

The inventor, improver, and introducer, apart from the aforesaid terms, will cease to be considered as sole proprietors, first, if they cede their right for the public good; secondly, if they let six months pass without taking up the certificate; thirdly, if they let two years pass without putting in execution their invention, perfection, or improvement.

This is, in substance, that which is decreed by the Spanish Cortes.

In this republic nothing new has been arranged with respect to this matter.

The state of continual agitation, in which this country has been involved since its political emancipation, has not permitted the complete reform of its codes.

But our Constitution has given to Congress the faculty of promising rewards and privileges to the inventors and managers of useful works, as will be seen by its article XLII., division twenty-two ; and, in practice, the rules of the decree cited above are not followed.

He who wishes for a reward or privilege seeks it from Congress, which concedes it, if it sees fit to do so.

From 4 *Pat. Off. Gaz.* 373.

NORWAY.

Law of June 16, 1885.

We, OSCAR, by the Grace of God, King of Norway and Sweden, the Goths, and the Vends, make known that there has been laid before us the resolution of the now assembled honorable Storting, on the 8th of June, this year, as follows:

1. Patents shall be granted for new inventions which are useful in industry, excepting, however, (a) inventions which, if brought out, would be contrary to the law, morality, or public order; (b) inventions the subject-matter of which is a beverage, food, or medicine. Nevertheless in relation to these, patents will be granted for processes or apparatus specially described for their manufacture.

2. An invention shall not be considered new if it have already been so known before the application for the patent was handed in that it could by other conversant persons be brought into practice. However, publication by printing or by an ordinary exhibition shall not prevent a grant of letters patent applied for within the next ensuing six months after such publication.

3. The right to obtain patent is available, subject to a conformity with section 4, to the first inventor only, or to a person having the legal power to act for him. In cases where it cannot be clearly ascertained who, among several applicants for a patent for a given invention, is the first inventor, the patent will be granted to the first one that handed in an application.

4. When a patent is granted for an invention here in the kingdom, the inventor shall, in the course of two years, counted from the time when the application for patent was handed in, have the exclusive privilege of obtaining a patent for improvements on or addition to the former patented invention. In consequence of this every application for such patent that might come in from third parties shall remain in abeyance under seal in the patent office and shall be decided upon after the first mentioned interval is expired, unless the older patentee has made use of his right of preference.

5. Patents shall be granted for a period of fifteen years, counted from the time of the handing in of the application. If anybody having obtained a patent for an invention shall wish to take out a patent for an addition to or improvements on the same, he shall

have the option of taking out a special patent or only a supplementary patent which shall expire the same time as the original patent.

6. At the handing in of every application for a patent thirty kroner shall be paid as a fee for the consideration of the matter. For granting patents, with exception of supplement patents, a yearly payment shall also be demanded, which begins with ten kroner for the second year of the patent and increasing five kroner each year for every following year,—that is, fifteen kroner the third year, twenty the fourth. This fee shall be paid before the beginning of the patent year for which it is due. However, it may be paid within the period of three months afterward, but in such a case with an increase of one-fifth part.

7. The patent confers the privilege that nobody can without the consent of the patentee, excepting for his own use, manufacture or import from abroad the patented article, neither keeping nor selling the same. If the patented matter be a process, an apparatus, a machine, a tool, or other implement, the patent also confers the privilege that nobody can without the consent of the patentee make use of the patented matter in his business. However, ship-fittings can be used without hindrance from the patent upon ships engaged in foreign navigation while staying in Norwegian ports or in Norwegian waters.

8. The patent shall have no effect against any one who already had made use of the invention within the kingdom before the handing in of the application or made the necessary arrangements for the same. If the patentee have in an earlier stage published the invention in the manner as described in the latter section of section 2, the power of the patent does then extend back to the publication, provided he at the same time and in conjunction therewith (in case of exhibition by notification on the object exhibited) has published that a patent will be applied for, and besides has beforehand handed in a preliminary notice to the patent commissioners.

9. Without the consent of the patentee the patented invention can be used by the public authority, if the King so decides. Likewise can the patented invention that is of particular importance for one or another trade by similar provision be adopted for private use. In both cases compensation shall be due to the patentee, which amount and mode of computation, in default of amicable agreement, shall be settled by judgment of impartial men (arbitration). Compensation is procured in the first case from the public

authority—in the latter case from the person or persons who take the invention into use. If the compensation be settled as a lump sum once for all, the same shall be paid before the invention is taken into use. If it be settled as a royalty, the arbitration shall, at the request of the patentee, also settle by what installments this shall be paid, and also shall fix the amount of the security which ought to be given for the correct payment of the royalty. The royalty fixed by the arbitration can be levied by distraint.

10. The investigation and decision upon applications for patents shall rest in a patent commission that shall have its sitting in Christiania, and which shall consist of a juridically educated chairman and at least five technical skilled members, who shall be appointed by the King for a period of five years. For the technical skilled members deputies shall also be appointed. No decision by which an application for a patent is to be decided shall take place unless at least four, or—in case of difference of opinion—at least five, members of the commission shall be present, including always the chairman and such members as have previously dealt with the matter. If the votes be equal, the decision shall rest with the chairman. Every such decision shall be accompanied by reasons, and complete written copy handed to the applicant, the patentee, or his deputy.

11. None of the members of the patent commission shall have personally or through others a grant of a patent for any invention, or shall act as deputy for others (patent-agent) in patent matters. They shall resign if they are in such a manner connected with an applicant for a patent that they as judges should give up their seat.

12. Anybody who desires to obtain patent on an invention shall hand in to the patent commission (1) an application for the patent addressed to the commission; (2) a specification of the invention, in duplicate; (3) the drawings necessary for the understanding of the specification, also in duplicate, also, according to circumstances, models, samples, &c.; (4) a list of all the documents, &c., which are handed in.

13. If the applicant is not a resident in Norway, he must name in his application a deputy residing within the kingdom, who shall represent him in all matters connected with the patent, and who can be summoned on his account. A ratified copy of the document appointing such deputy with full powers and accepted by said deputy shall accompany the application. Likewise always

shall the application, if not signed by the applicant himself, be accompanied by the necessary full powers to the person who signs it.

14. The application, which must only relate to one principal invention (with the details belonging to the same,) shall give the applicant's name, occupation, and residence, as well as a short description of the invention, such as it is wished should be stated in the patent. If the invention have not been made by the applicant himself, the necessary proofs shall be attached that it has been lawfully intrusted to him by the inventor. The specification shall be so explicit and complete that others conversant with the trade to which it relates shall be able to carry out and apply the invention. It shall finish with a specific declaration as to what the applicant considers as his invention and desires to protect by patent. The application, as well as the specification, is to be written in the Norwegian language.

15. If the patent commission find that a deposited application is not fulfilling the terms of sections 12, 13, and 14, it shall as soon as possible give a written communication about it to the applicant or his deputy, in which shall be given a reasonable time during which the defects shall be remedied. If during this period, or any extension thereof that may be granted according to circumstances, the necessary corrections be not made, the application will be laid aside.

16. If the invention treated in the application be evidently not new, or there be other reason which would prevent the legally granting of a patent for the same, the application can be refused at once.

17. On the other hand, if the application, with its accompanying documents, &c., be in proper form, and, as far as can be judged, there be no defect present, as mentioned in section 16, the commission shall draw up as soon as possible, and at latest within four weeks, a public notification about the application, stating the principal contents of the same and the name of the applicant. At the same time the application, with the document and other vouchers belonging to it, shall be laid open for public examination in the patent-office.

18. If the inventor in his application shall desire and at the same time pay down an additional sum of twenty kroner, the enjoined publication and laying out for examination, as stated in the preceding section, shall be deferred until four months after the inventor

or his deputy has received information that the patent commission from the previous examination finds no hindrance for a grant of patent. For the preliminary examination the commission has in this case an extension of time of eight weeks, during which it is entitled to obtain statements of men conversant in the matter, as stated in section 20.

19. During the period of eight weeks following the publication anybody shall be at liberty to hand in to the patent commission an objection to a grant of the patent applied for. Such objection shall be in writing, and shall be accompanied by the reasons on which it is based, which must also be presented in writing.

20. Before the expiration of sixteen weeks after the publication the commission shall come to a decision concerning the application. Before its decision it can demand more particular declarations or explanations from those interested in the matter. It shall also be entitled to obtain statements of men conversant with the same, or make other necessary arrangements to throw light upon the matter.

21. If the applicant shall be dissatisfied with the decision of the patent commission in conformity to section 16 or section 20, and he shall think himself able to give explanation or information which would convey another result, he shall have the right during the next ensuing six weeks after the giving of the decision to hand in to the commission a representation, which in such a case shall bring the matter under a renewed consideration. Should this also not bring it to a decision satisfactory to the applicant, he shall still, during four weeks more, have the option of making an application to the patent commission asking for a decision of a supreme patent commission, consisting of seven men specially selected by the King for this case, and with an eye to the circumstances of the case. With the request the applicant shall pay a fee of one hundred and fifty kroner, which, however, shall be returned to him if the former decision be not confirmed. The supreme patent commission shall decide the case from the documents handed over by the patent commission.

22. When the final decision shall be given that a patent be granted, the commission shall draw up the letters patent, stating the nature of the patent, as well as the day from which its duration is to be counted, in accordance with section 5. As soon as possible after the drawing up of the letters patent the commission shall make a public notification of the same, containing also the essential part of the specification, &c., and other documents, as the case may

demand, together with the name and residence of the deputy. When a final decision shall have been made that the patent be refused, this shall also be published.

23. If the patentee leave the country, or the patent be transferred to an owner not residing in Norway, such a deputy must be made known to the patent-office, and such authorized power be forwarded as stated in section 13.

24. A register shall be kept at the patent-office of all the completed patents. This shall show the nature of the patent and date, as well as the name and residence of the patentee, or, as the case may be, those of his deputy. When a patent expires, becomes void; is by judgment abolished, or is wholly or partly declared invalid, this shall be noted in the register and publicly notified. The same shall hold good with respect to transfer of patent right and choice of deputy or substitution of a new one (sections 13 and 23) when notice concerning the same with necessary legitimation shall be handed in to the office. As long as this latter shall not have taken place, the transfer or the choice shall be without effect with the public authorities, as well as with third persons. Both the register and the specifications, drawings, models, &c., connected with patents shall be accessible to everybody who might wish to make themselves acquainted with the same.

25. A patent shall expire (1) if the fixed fee in section 6 be not paid into the office within the time stated in the said section ; (2) if the notified deputy will not or cannot any longer undertake the charge, and the patentee within three months after he has been notified about it in the newspaper for publications of patents has not registered new deputy with the patent commission.

26. A patent shall by judgment be found wholly or partly invalid if it be shown that in accordance with the provisions of sections 1, 2, 3, and 4, either in whole or in part, it ought not to have been granted.

27. A patent shall by judgment be made void if the patentee shall not have worked the patent within the termination of three years from the date of the patent either himself or through others in the kingdom or have offered the patented object for sale ; also, if after that period the working or the offering for sale has been discontinued during one year. If this be caused by a casual incident, the last-mentioned period can be increased by the patent commission on application. In particular cases the patent commission shall have power after representation to make exceptionally distinct

provision for what is required for the working or arrangement for sale within the kingdom.

28. Anybody who may desire to have a patent declared void (section 26) or abolished (section 27) can prosecute the patentee to accept judgment. Such questions shall come within the jurisdiction of Christiania town court. The summons shall be four weeks regardless of the summoned person's residence. Settlement by arbitration will not be allowed. The chairman of the patent commission shall always be summoned.

29. Any person who shall encroach upon the rights belonging to any one pursuant to a patent shall be obliged to compensate the injured person for all damage to him thereby caused. Should the infringer have knowingly committed such violation of rights he shall besides, provided he be not liable at law to a more severe punishment, be fined (the penalty to be paid into the state treasury) from fifty to one thousand kroner, and in case of repetition up to two thousand kroner; also, all unlawfully manufactured goods offered for sale, in case the article itself be patented, may by judgment be confiscated.

30. The public authority shall not prosecute the offense treated in section 29. The prosecution concerns the patentee himself or any other person to whom he wholly or partly transferred his right or in any other person who by the offense shall have sustained loss.

31. If the defendant, in a case of infringement of a patent, shall base his claim for acquittal on the ground that the patent is invalid (section 26) or forfeited (section 27), the court shall, if requested, if it be any other court than the town court of Christiania, give him such delay that he can have an opportunity to obtain judgment in conformity to section 28. If the matter is taken before the town court of Christiania, he can, through counter prosecution, without arbitration, obtain a hearing under the procedure to get the patent made null and void or abolished.

32. No punishment or compensation shall be decreed under this law if the infringement complained of at the court shall have been committed more than two years before the commencement of the action, or if the action has not been commenced by the injured party within a year from the time when he was first acquainted by established proof, through judicial act of the infringement complained of, or if he delay to prosecute for a full year a trial already judicially commenced.

33. If any one who shall have in a foreign country applied for

patent for an invention within a period of seven months after such foreign application hands in an application for patent in this country for the same invention, this last application shall (in case the said foreign country grants reciprocal rights to Norwegians) be considered in relation to other applications, as if it had been handed in at the same time that the application was made in the foreign state.

34. The present law has no application to patents issued before the law comes into force. However, after the period of one year the inventor of such a patent shall be at liberty to apply for change of patent so as to come under the rules of the present law, which in such a case will be fully applied to such patent. The question of the novelty of the invention (section 2) shall be decided, however, according to the condition of the time when the application of the older patent was given in. If a new patent is granted, its duration shall (section 5) be counted from the issue of the older patent and the yearly fee (section 6) shall be determined according to its age.

35. The particular provisions of the administration of the patent commission, the form and contents of patents, and what more may be required for the execution of this law shall be in the jurisdiction of the King.

36. The present law shall come into force on the 1st of January, 1886, after which time section 82 in the artisan's law of the 15th of July, 1839, shall be null and void.

We hereby accept and ratify this resolution as law under our hand and Seal of the Realm.

Given at Stockholm Castle on the 16th of June, 1885.

OSCAR. [L. S.]

From *Carp. Pat. L. of World*, 443.

NOVA SCOTIA.

See CANADA.

ONTARIO.

See CANADA.

ORANGE FREE STATE.

See APPENDIX OF RECENT LAWS, near end of Vol. II.

PARAGUAY.

Under a law of May 20, 1845, citizens or foreigners are alike entitled to protection, and the term of the grant varies from two to ten years. Where there is a previous foreign patent for the same invention, the patent is not valid for more than six months beyond the termination of the foreign patent. The invention patented must be worked within two years from the date of the grant.

Encyc. Brit. ed. 9, art. Patents.

PERSIA.

According to a report of Mr. R. F. Thomson, of the British Legation, published October 28, 1873, in 4 *Pat. Off. Gaz.* 447, there was not, at the time of his writing, any law in Persia respecting patent rights for inventions, but every one there was free to invent or imitate.

PERU.

See APPENDIX OF RECENT LAWS, near end of Vol. II.

PHILIPINE ISLANDS.

See SPAIN.

PORTO RICO.

• See SPAIN.

PORTUGAL.*Civil Code.***CHAPTER III.****PROPERTY IN INVENTIONS.****SECTION I.****GENERAL PROVISIONS.**

ARTICLE 613. Any one who invents any manufacture, product, or article of commerce, who perfects and improves any known product or manufacture of the same nature, or discovers any easier and less expensive means of obtaining it, shall enjoy the property in his invention or discovery for a period of fifteen years, on the terms hereinafter set forth in this chapter.

1. An inventor who has obtained a privilege in a foreign country can only obtain a patent in the kingdom on the conditions of this code, and for the term which has still to run in the foreign country before the invention falls into the public domain.

ART. 614. The property in the invention gives the exclusive right of producing or manufacturing the articles which constitute or embody the said invention.

ART. 615. Inventions or discoveries relating to unlawful industries or articles cannot be patented.

ART. 616. The duration of the exclusive property in inventions commences from the date of the grant of the patent.

ART. 617. The exclusive property is limited to the article specified, and can never be interpreted as extending to others, under pretext of intimate relation or connection.

ART. 618. The appropriation of inventions can only be decreed by law, in cases wherein it may be necessary for the public good.

SECTION II.**ADDITIONS TO INVENTIONS.**

ART. 619. The patentee or his representatives may, during the existence of the patent, add to the invention any improvements and modifications which they may conceive.

ART. 620. The person making additions enjoys, so far as concerns the additional improvements, the same rights as those conferred by the principal patent; but only for the time that this may last.

ART. 621. The person making additions may, however, apply for a new patent for the improvements, providing he submits himself to the provisions regulating principal patents.

ART. 622. The grant of a patent for an improvement cannot be made during the first year of the patent granted for the principal invention, save to the person who obtained that patent.

ART. 623. Third parties who solicit such a patent may, before the end of the year, deliver their petition, closed and sealed, to the proper department, and thereupon note shall be taken of such delivery.

The deposit mentioned in this article serves to confer on the depositor priority over all others, not being the patentee, who may subsequently present themselves. The patentee has in every case the preference, provided he applies within the year.

ART. 624. Third parties who apply for a patent of improvement are deemed, for the issue of their titles, to be principal inventors.

ART. 625. The exclusive property in inventions is authenticated and secured by the laws and administrative regulations.

SECTION III.

TRANSMISSION OF PROPERTY IN INVENTIONS.

ART. 626. Property in inventions is governed by the general laws which regulate movable property, except as is hereinafter provided.

ART. 627. The transfer of the patent, whether gratuitously, or for a consideration, can only be effected by notarial deed.

ART. 628. Licensees under a principal patent shall enjoy additions granted to the inventor or his representatives, and so reciprocally if the case arises, unless there exists any agreement to the contrary.

SECTION IV.

THE PUBLICATION OF INVENTIONS.

ART. 629. The descriptions, designs, models and specifications required for the grant of a patent shall be shown gratuitously to all

persons who may apply for them, and copies thereof shall be supplied on payment of the cost.

It pertains to the government to make the necessary regulations respecting this matter.

ART. 630. On the expiration of the second year of the patent the designs and descriptions shall be published in full or by extract.

ART. 631. It is the duty of the government to announce officially those inventions which have become public property.

SECTION V.

THE NULLITY AND LOSS OF PATENTS.

ART. 632. Patents granted in the following cases are null:

1. If the inventions or discoveries were known to the public, practically or theoretically, through any technical description divulged in home or foreign documents, or by any other means :

2. If a patent had already previously been granted for the same object: [Art. 635.]

3. If the invention or discovery should be found prejudicial to public security or health, or contrary to the laws :

4. If the title given to the invention fraudulently comprises a different object:

5. If the description lodged of the invention does not indicate everything which is necessary for working the invention, or the real means of the inventor:

6. If the patent was obtained contrary to the formalities prescribed by law :

7. If a patent for a modification or improvement does not relate to something which facilitates the working, or increases the utility of the invention, but merely to a change of form or of proportions, or to mere ornament.

ART. 633. Any one who fails to carry out his invention within two years counted from the date of the signature of the patent, or who ceases to use it for two consecutive years, without proving a legitimate impediment, shall forfeit the said patent.

SECTION VI.

ACTIONS FOR NULLITY AND WITHDRAWAL OF THE PATENT.

ART. 634. Either the public prosecutor, or persons having a direct interest in the withdrawal of the patent, may bring suitable

actions. If the action is brought by the public prosecutor, the interested party shall be allowed to intervene therein as assistant, but the public administration must always intervene in actions brought by interested parties. [Civil Code, Art. 329.]

ART. 635. The right of action for nullity, in the case of No. 2 of article 632, lapses on the expiration of a year without opposition by the parties interested: in other cases it shall exist as long as the exclusive privilege of invention lasts.

SECTION VII.

THE RESPONSIBILITY OF INFRINGERS.

ART. 636. Whosoever, during the exclusive privilege of invention, injures the patentee in the exercise of his rights by reproducing, without his authorization, the object of the said invention, or by selling, concealing, or introducing with deliberate intent, any similar article manufactured abroad, is responsible for the reparation of the damage caused, besides being subject to the penalties of the Criminal Code.

ART. 637. Patentees or their representatives may require, in case of suspected infringement, and on their first giving security, the seizure of the infringing articles, or of implements that can only serve for their manufacture. [Civil Code, Art. 363.]

In this case, however, if the party seizing should not commence his action within fourteen days, the seizure becomes void at law, and the holder may sue the party making the seizure for losses and damages.

ART. 638. If the action for infringement is brought to final judgment at criminal or civil law, the articles seized shall be awarded to the complainant, on account of the compensation due to him; but if the matter is tried by a criminal suit, the plaintiff can only sue by civil action for anything that may be wanting for his complete indemnification.

ART. 639. The party injured by the infringement may proceed either by criminal action, or merely by civil action for losses and damages; in either case the Public Prosecutor shall be heard.

ART. 640. The tribunal which tries criminally the infringement shall pronounce on the objections the defendant may raise as to the nullity of the patent or the loss of the rights of the plaintiff.

From *Carpm. Pat. L. of World*, 445.

Report by Mr. Wm. Doria, of the British Legation, published 1873.

On the 17th of March, 1868, the present law in force was published for regulating the concession of patents, and regulations were introduced in the Civil Code for the protection of public interests against the too excessive exercise of particular privileges granted by patents, and the regulations were assimilated more to those adhered to in other countries granting such patents.

It is, therefore, to the Civil Code that reference must be made for those provisions of the law which protect patent rights from being infringed. The punishment to be awarded to those persons who infringe those rights is to be found inscribed in the Penal Code of the country.

Patents are granted for a term of years not exceeding fifteen, to the inventor or discoverer, to enjoy during that time the right of property.

From the right of property to an invention is derived the exclusive right of producing or manufacturing the articles which constitute the said invention. Persons making additions to their inventions enjoy the advantage of the additional improvements, and they may apply for a French patent.

The exclusive right of property over inventions is secured by the administrative laws and regulations—that is to say, by the laws having reference to movable property, except in cases where the patent has been granted gratuitously, or as compensation in return for service performed.

The publication of patents, their drawings, models, and specifications, which are required for obtaining the concession, must be shown gratuitously to every one who desires to see them. Applicants, by payment, can procure copies. On the government devolves the duty to announce officially what patents have fallen into the dominion of the public.

Patentees who have been injured by the infringement of their patent can institute a criminal suit, or enter a civil action to recover damages.

The right of property conferred by a patent is transmissible by will to heirs and successors.

A register of all patents is kept in the department of public works.

A tax of 120,000 reis is exacted on granting a patent for fifteen years, equivalent to about \$140.00. Of this amount 75,000 reis, or \$88.00, is set apart for a fund for the advancement of industry. The remaining sum is absorbed in stamps and fees paid to government.

Medicines, articles of food, simple changes in the form of an object patented, and ornaments are excluded from obtaining patents.

The civil governor of the district is charged with the duty of granting patents, on whom devolves the duty also of forwarding to the office of public works information for their due registration.

An invention which involves danger to public safety is prohibited from obtaining a patent.

A foreigner can only obtain a patent subject to the rules laid down by the Civil Code of Portugal, and that also only for the period of time before it falls under the dominion of the public, in conformity with those rules.

No concession of patent for an improvement of an article already patented is granted, except to the patentee himself, during the first year after the patent is granted. Application by another person may be made before the expiration of the year to the proper department, where such application will be taken into consideration.

This provision is to insure to the first applicant the preference over other persons, with the exception of the original patentee, who always has the preference accorded to him, provided his application is also made during the first year.

Exclusive right to import foreign patents is not granted; only the privilege for their manufacture in Portugal is guaranteed by patent.

The punishment awarded by the Penal Code to persons who infringe patent rights is subjection to a fine, which is imposed by the judge at his discretion, varying from 30,000 reis to 300,000 reis, or from \$35 to \$350, and the confiscation of the articles which have been employed in the violation of the patent.

For losses sustained by the patentee through the infringement of his rights, he can obtain indemnity by a civil action.

From 4 *Pat. Off. Gaz.* 447.

See also, INTERNATIONAL CONVENTION.

PRINCE EDWARD ISLAND.

See CANADA.

PRUSSIA.

*Extracts from a report by Mr. T. N. Plunkett, of the British Legation, published October 14, 1873.**

The legislation of Prussia on patents is based on a rescript of October 14, 1815, on various ministerial decisions as to the precise meaning of particular portions of it, which have been given from time to time when occasion arose; and also on the agreement come to in September, 1842, between the different States of the Zollverein respecting patents.

In the main, however, the practice in Prussia is as follows:

Patents can be obtained both for discoveries and for improvements; and also for the introduction into Prussia of inventions patented abroad.

New goods, new machines, new tools, and new modes of fabrication can be patented; but only on the condition that they are useful to industry and manufacture, and afford new means of industrial development.

Patents are never granted in Prussia for inventions of an artistic nature; the only excuse for a patent is that the invention shall have industrial value. No invention which is not entirely new, or which is not certain to be useful to industry, has a chance of receiving a patent, for the rules are administered with the greatest severity.

Articles or inventions patented abroad may also be patented in Prussia, provided, however, that no description of them shall have been published either here or elsewhere, and that no use shall have yet been made of the invention in Prussia.

When once the details of an invention have been published, either in Germany or elsewhere, officially or unofficially, before the application for the Prussian patent has been made in Berlin, it is invariably refused.

* The date of this report was not long after the adoption of the Imperial Constitution of the German empire, article 4 of which declares that questions concerning patents and patent laws are reserved to the Reichsrath; but before a general law

had been established for the empire. The subject is now governed, for Prussia, as for the other kingdoms, by the general law; for which see GERMAN EMPIRE. This report has value in connection with unexpired Prussian Patents.

An article which is patented abroad may be patented in Prussia, if it fulfills the necessary requirements, by anybody.

No rights whatever are reserved to the original patentee, except in the case of patents taken out in other German countries.

Under the agreement concluded between the Zollverein States in 1842, when a patent has been given for an invention in any one of those States, it secures to the patentee the sole right of applying for a patent for the same article in all the other States of the Confederation ; but it does not necessarily follow from this that the Prussian authorities will give patents in every case where other German governments have done so.

In Saxony, Bavaria, and Würtemberg, for instance, patents are much more easily obtained than they are in Prussia.

Patents are granted only to natives, or to the subjects of such countries as by treaty are entitled to most-favored-nation treatment. Therefore, under the treaty of commerce concluded in 1865, British subjects are entitled to take out patents in this country. Subjects of those foreign countries which are not entitled to most-favored-nation treatment, if they wish to patent their inventions in Prussia, must appoint a native as their representative, and have the patents made out in his name.

The application for a patent is made direct to the minister of commerce in Berlin, and must be accompanied by full descriptions, and, if necessary, also by models. These are, however, kept secret from everybody except from the persons whose special duty it is to examine and report upon them.

The applications are registered immediately on receipt at the ministry, and take their precedence accordingly.

Under the ministry of commerce is a special department called the technical deputation for industrial matters, to whom all these applications are referred. It is their duty to examine the models, descriptions, &c., to see whether patents for similar or kindred inventions have been already given, and to ask for any further explanations which they may require. They then decide absolutely and without appeal whether they will grant the patent or not. They fix the length of time for which the patent is to hold good, and have, moreover, the right of declaring whether they will give a patent for the whole invention or only for some portion of it.

The deputation consists, at present, of nine members, under the presidency of a director of the ministry of commerce, and meets

once a week or oftener to examine the application for patents which have been made to the minister.

Their verdict is communicated to the person who has applied for the patent, and he is allowed a period of six weeks to decide whether he accepts or not the conditions proposed by the deputation.

If he agrees to accept them, the patent is then issued under the signature of the minister of commerce.

The following conditions are invariably imposed in the case of every patent which is granted :

1. The patentee must give practical effect to his invention in Prussia within the time fixed by the minister (usually six months, never more than a year), on pain of forfeiting his patent; and he must produce before the end of that term an official certificate from the local police, or at least from some government employe, that his invention is or has been actually in work within the Prussian dominions.

2. If at any time during the period for which the patent is granted his invention shall have been unemployed during twelve consecutive months, the patentee shall forfeit all his rights.

3. The patent shall equally be forfeited if at any time afterward it can be proved that the invention was neither new nor original.

The period for which a patent is to run is laid down, specially for each case, in the rescript of the minister of commerce. The law is, that it shall not be less than six months nor more than fifteen years; but it is now usually fixed at three years.

A patent which is near expiring may, in some cases, be renewed; but the entire period for which it can last must never exceed fifteen years. Such prolongations, however, have lately been more difficult to obtain than they were formerly.

Unless in cases where the applicant himself demands a special exception, patents extend to the whole Kingdom of Prussia.

The publication of the fact of a patent having been granted to an inventor is made in the official journals free of cost. Merely the fact itself is mentioned of a patent having been granted for such a number of years to such or such a person, for such or such an invention. No details are entered into, and no description is given. The exact particulars of the invention are kept in sealed covers at the office of the technical deputation for industrial matters in Berlin; and, although in the patent commission itself there is a special proviso that the government do not guarantee secrecy, they prac-

tically never allow the secret to ooze out. It would indeed appear that everything connected with this department is conducted with the view of preventing the outside world from learning what takes place within its walls.

The expenses of taking out a patent in Prussia are almost nominal.

The application for a patent must be written on stamped paper of 5 silber-groschen—say 12 cents.

The answer of the technical deputation is given on stamped paper of 15 silber-groschen—say, 36 cents—and the patent itself, if granted, is liable to a stamp duty of 1 thaler—say, 73 cents. There is no further tax or duty whatever.

A patent can be sold or inherited like any other property, on condition, however, that the new proprietor shall be a Prussian, or a subject either of one of the Zollverein States or of a country entitled by treaty to most-favored-nation treatment. In these cases no notice need be given to the government, which always applies direct to the original patentee or his heirs.

Corporate bodies have the same rights as individuals in regard to the acquisition of patents.

A patent in Prussia gives to the patentee the exclusive right of working his invention—that is to say, the sole right of making the article in question; and also, in the case of machinery, the sole right of employing it when made. It does not give the right of prohibiting the sale or importation of articles which are like the article for which the patent has been obtained.

A patentee whose rights have been infringed can invoke the aid of the police to confiscate the pirated articles; but the offending party must be named before they can be seized; and it is only in case of a second offense that the articles in question can actually be confiscated. The decision in these questions lies, in the first instance, with the authorities of the "bezirk" (district), with an appeal, in second instance, to the minister of commerce.

Claims for damages must be laid before the ordinary civil tribunal; and such claims may be made without the previous formality of a warning to the offending parties being required.

Patents which have been granted before 1866 by the Prussian Government, and by the former Governments of Hanover, Hesse, Nassau, or Frankfort, and which have not yet expired, have force only in those special districts which at that time were under each of those governments; but all patents issued by the Prussian Gov-

ernment since 1866 have force throughout the whole monarchy as now consituted, unless in those few cases where, at the request of the patentee himself, a special reservation is made.

From 4 *Pat. Off. Gaz.* 395.

See GERMAN EMPIRE.

QUEBEC.

See CANADA.

QUEENSLAND.

An Act to Amend and Consolidate the Law relating to Patents for Inventions, and the Registration of Designs and Trade-Marks, assented to October 13, 1884.

Be it enacted by the Queen's Most Excellent Majesty, by and with the advice and consent of the Legislative Council and Legislative Assembly of Queensland in Parliament assembled, and by the authority of the same, as follows :

PART I.

PRELIMINARY.

1. This act may be cited as "The Patents, Designs, and Trade Marks Act, 1884."

2. This act is divided into parts, as follows :

Part I.—Preliminary ;

Part II.—Patents ;

Part III.—Designs ;

Part IV.—Trade-Marks ;

Part V.—International and Intercolonial Arrangements ;

Part VI.—General.

GENERAL DEFINITIONS.

3. (1.) In and for the purposes of this act, unless the context otherwise requires :

"*Examiner*" includes examiners, if more than one.

"*The court*" means the Supreme Court of Queensland.

"*Law officer*" means her Majesty's attorney-general for Queensland.

"*The minister*" means the colonial secretary or other minister charged with the execution of this act.

"*Registrar*" means the registrar of patents, designs, and trade-marks.

"*Prescribed*" means prescribed by any of the schedules to this Act, or by general rules under or within the meaning of this Act.

"*Patent*" means letters patent for an invention.

"*Patentee*" means the person for the time being entitled to the benefit of a patent.

“*Invention*” means any manner of new manufacture, the subject of letters patent and grant of privilege within section 6 of the statute of monopolies—that is, the act of the twenty-first year of the reign of King James the First, chapter 3, entitled “An Act concerning Monopolies, and Dispensations with Penal Laws, and the forfeiture thereof”—and includes an alleged invention.

“*Design*” means any design applicable to any article of manufacture, or to any substance, artificial or natural, or partly artificial and partly natural, whether the design is applicable for the pattern, or for the shape or configuration, or for the ornament thereof, or for any two or more of such purposes, and by whatever means it is applicable, whether by printing, painting, embroidering, weaving, sewing, modeling, casting, embossing, engraving, staining, or any other means whatever, manual, mechanical, or chemical, separate or combined, not being a design for a sculpture, or other thing within the protection of “The Sculpture Copyright Act” of the year 1814, (fifty-fourth George the Third, chapter 56).

“*Copyright*” means the exclusive right to apply a design to any article of manufacture or to any such substance, as aforesaid, in the class or classes in which the design is registered.

“*British possession*” means any territory or place situate within her Majesty’s dominions, and not being or forming part of the United Kingdom, or of the Channel Islands, or of the Isle of Man; and all territories and places under one legislature, as hereinafter defined, are deemed to be one British possession for the purposes of this Act.

“*Legislature*” includes any person or persons who exercise legislative authority in the British possession, and, where there are local legislatures as well as a central legislature, means the central legislature only.

“*Summary conviction*” means a conviction under the summary jurisdiction Acts—that is to say, the acts regulating the duties of justices of the peace and any acts amending or in substitution for them.

TRANSITIONAL PROVISIONS.

4. The Acts mentioned in the first schedule to this Act are hereby repealed to the extent in the said schedule indicated. But this repeal shall not:—

(a.) Affect the past operation of any of those enactments, or any patent or copyright or right to use a trade-mark granted or

acquired, or application pending or appointment made, or compensation granted, or order or direction made or given, or right, privilege, obligation, or liability acquired, accrued, or incurred, or anything duly done or suffered under or by any of those enactments before or at the commencement of this act ; or

(b.) Interfere with the institution or prosecution of any action or proceeding, civil or criminal, in respect thereof, and any such proceeding may be carried on as if this Act had not been passed ; or

(c.) Take away or abridge any protection or benefit in relation to any such action or proceeding.

5. (1.) There shall be an office, called the "patent-office," at a convenient place, with such officers and clerks as the Governor in Council shall appoint, at which the business of this Act required to be transacted at the patent-office shall be transacted.

(2.) The patent-office shall be under the immediate control of an officer, called the "registrar of patents, designs, and trade-marks," acting under the superintendence and direction of the minister.

(3.) Any act or thing directed to be done by or to the registrar may, in his absence, be done by or to any officer for the time being in that behalf authorized by the minister.

(4.) Until other provision is made in that behalf, the registrar-general shall be and act as registrar of patents, designs, and trade-marks.

6. This Act, except where it is otherwise expressed, shall commence from and immediately after the 31st day of December, 1884.

PART II.

PATENTS.

APPLICATION FOR AND GRANT OF PATENT.

7. (1.) Any person whether a British subject or not, may make an application for a patent.

(2.) Two or more persons may make a joint application for a patent, and a patent may be granted to them jointly.

8. (1.) An application for a patent must be made in the form set forth in the second schedule to this Act, or in such other form as may be from time to time prescribed ; and must be left at or sent by post to the patent-office in the prescribed manner.

(2.) An application must contain a declaration to the effect that

the applicant is in possession of an invention, whereof he, or, in the case of a joint application, one or more of the applicants, claims or claim to be the true and first inventor or inventors, and for which he or they desires or desire to obtain a patent, and must be accompanied by either a provisional or complete specification.

(3.) In the case of a joint application, the declaration may be made by one of the applicants.

(4.) A provisional specification must describe the nature of the invention, and be accompanied by drawings, if required.

(5.) A complete specification, whether left on application or subsequently, must particularly describe and set forth the nature of the invention, and in what manner it is to be performed, and must be accompanied by drawings, if required.

(6.) A specification, whether provisional or complete, must commence with the title, and in the case of a complete specification must end with a distinct statement of the invention claimed.

9. The registrar shall refer every application to an examiner or examiners, who shall ascertain and report to the registrar whether the nature of the invention has been fairly described, and the application, specification, and drawings (if any) have been prepared in the prescribed manner, and the title sufficiently indicates the subject-matter of the invention.

10. (1.) If the examiner reports that the nature of the invention is not fairly described, or that the application, specification, or drawings has not or have not been prepared in the prescribed manner, or that the title does not sufficiently indicate the subject-matter of the invention, the registrar may require that the application, specification, or drawings be amended before he proceeds with the application.

(2.) Where the registrar requires an amendment, the applicant may appeal from his decision to the law officer.

(3.) The law officer shall, if required, hear the applicant, and the registrar, and may make an order determining whether and subject to what conditions, if any, the application shall be accepted.

(4.) The registrar shall, when an application has been accepted, give notice thereof to the applicant.

(5.) If after an application has been made, but before a patent has been sealed, an application is made, accompanied by a specification bearing the same or a similar title, it shall be the duty of the examiner to report to the registrar whether the specification appears to him to comprise the same invention; and, if he reports

in the affirmative, the registrar shall give notice to the applicants that he has so reported.

(6.) Where the examiner reports in the affirmative, the registrar may determine, subject to an appeal to the law officer, whether the invention comprised in both applications is the same, and if so, he may refuse to recommend that a patent be granted on the application of the second applicant.

11. (1.) If the applicant does not leave a complete specification with his application, he may leave it at any subsequent time within nine months from the date of application.

(2.) Unless a complete specification is left within that time, the application shall be deemed to be abandoned.

12. (1.) Where a complete specification is left after a provisional specification the registrar shall refer both specifications to an examiner for the purpose of ascertaining whether the complete specification has been prepared in the prescribed manner, and whether the invention particularly described in the complete specification is substantially the same as that which is described in the provisional specification.

(2.) If the examiner reports that the conditions hereinbefore contained have not been complied with, the registrar may refuse to accept the complete specification unless and until the same shall have been amended to his satisfaction ; but any such refusal shall be subject to appeal to the law officer.

(3.) The law officer shall, if required, hear the applicant and the registrar, and may make an order determining whether and subject to what conditions, if any, the complete specification shall be accepted.

(4.) Unless a complete specification is accepted within twelve months from the date of application, then (save in the case of an appeal having been lodged against the refusal to accept) the application shall at the expiration of those twelve months become void.

(5.) Reports of examiners shall not in any case be published or be open to public inspection, and shall not be liable to production or inspection in any legal proceeding other than an appeal to the law officer under this act, unless the court or officer having power to order discovery in such legal proceeding shall certify that such production or inspection is desirable in the interests of justice and ought to be allowed.

13. On the acceptance of the complete specification the registrar shall advertise the acceptance in the Gazette, and the application

and specification or specifications with the drawings (if any) shall be open to public inspection.

14. (1.) Any person may at any time within two months from the date of the advertisement of the acceptance of a complete specification give notice at the patent-office of opposition to the grant of the patent on the ground of the applicant having obtained the invention from him, or from a person of whom he is the legal representative, or on the ground that the invention has been patented in this colony on an application of prior date, or on the ground of an examiner having reported to the registrar that the specification appears to him to comprise the same invention as is comprised in a specification bearing the same or a similar title and accompanying a previous application, but on no other ground.

(2.) Where such notice is given the registrar shall give notice of the opposition to the applicant, and shall, on the expiration of those two months, after hearing the applicant and the person so giving notice, if desirous of being heard, decide on the case, but subject to appeal to the law officer.

(3.) The law officer shall, if required, hear the applicant and any person so giving notice and being, in the opinion of the law officer, entitled to be heard in opposition to the grant, and shall determine whether the grant ought or ought not to be made.

(4.) The law officer may, if he thinks fit, obtain the assistance of an expert, who shall be paid such remuneration as the law officer shall appoint.

15. (1.) If there is no opposition, or, in case of opposition, if the determination is in favor of the grant of a patent, the registrar shall report the facts to the minister.

(2.) The minister shall thereupon submit the application for the consideration of the Governor in Council, who may direct a patent to be sealed with the Great Seal of the Colony.

(3.) A patent shall be sealed as soon as may be, and not after the expiration of fifteen months from the date of application, except in the cases hereinafter mentioned—that is to say :

(a.) Where the sealing is delayed by an appeal to the law officer, or by opposition to the grant of the patent, the patent may be sealed at such time as the law officer may direct.

(b.) If the person making the application dies before the expiration of the fifteen months aforesaid, the patent may be granted to his legal representative and sealed at any time within twelve months after the death of the applicant.

16. Every patent shall take effect and be expressed to take effect as of the day of the application : Provided, That no proceedings shall be taken in respect of an infringement committed before the publication of the complete specification : Provided, also, That in case of more than one application for a patent for the same invention the sealing of a patent on one of those applications shall not prevent the sealing of a patent on an earlier application.

PROVISIONAL PROTECTION.

17. Where an application for a patent in respect of an invention has been accepted, the invention may during the period between the date of the application and the date of sealing such patent be used and published without prejudice to the patent to be granted for the same ; and such protection from the consequences of use and publication is in this act referred to as provisional protection.

PROTECTION BY COMPLETE SPECIFICATION.

18. After the acceptance of a complete specification, and until the date of sealing a patent in respect thereof, or the expiration of the time for sealing, the applicant shall have the like privileges and rights as if a patent for the invention had been sealed on the date of the acceptance of the complete specification : Provided, That an applicant shall not be entitled to institute any proceeding for infringement unless and until a patent for the invention has been granted to him.

PATENT.

19. Every patent when sealed shall have effect throughout the colony and its dependencies.

20. (1.) The term limited in every patent for the duration thereof shall be fourteen years from the date from which it takes effect.

(2.) But every patent shall, notwithstanding anything therein or in this Act, cease if the patentee fails to make the prescribed payments within the prescribed times.

(3.) If, nevertheless, in any case, by accident, mistake, or inadvertence, a patentee fails to make any prescribed payment within the prescribed time, he may apply to the registrar for an enlargement of the time for making that payment.

(4.) Thereupon the registrar shall, if satisfied that the failure has arisen from any of the above mentioned causes, on receipt of the

prescribed fee for enlargement, not exceeding ten pounds, enlarge the time accordingly, subject to the following conditions :

(a.) The time for making any payment shall not in any case be enlarged for more than three months.

(b.) If any proceeding shall be taken in respect of an infringement of the patent committed after a failure to make any payment within the prescribed time and before the enlargement thereof, the court before which the proceeding is proposed to be taken may, if it shall think fit, refuse to award or give any damages in respect of such infringement.

AMENDMENT OF SPECIFICATION.

21. (1.) An applicant or a patentee may, from time to time, by request in writing left at the patent-office, seek leave to amend his specification, including drawings forming part thereof, by way of disclaimer, correction, or explanation, stating the nature of such amendment and his reasons for the same.

(2.) The request and the nature of such proposed amendment shall be advertised in the prescribed manner, and at any time within one month from its first advertisement any person may give notice at the patent-office of opposition to the amendment.

(3.) Where such notice is given the registrar shall give notice of the opposition to the person making the request, and shall hear and decide the case subject to an appeal to the law officer.

(4.) The law officer shall, if required, hear the person making the request and the person so giving notice, and being in the opinion of the law officer entitled to be heard in opposition to the request, and shall determine whether and subject to what conditions, if any, the amendment ought to be allowed.

(5.) Where no notice of opposition is given or the person so giving notice does not appear, the registrar shall determine whether and subject to what conditions, if any, the amendment ought to be allowed.

(6.) When leave to amend is refused by the registrar, the person making the request may appeal from his decision to the law officer.

(7.) The law officer shall, if required, hear the person making the request and the registrar, and may make an order determining whether, and subject to what conditions, if any, the amendment ought to be allowed.

(8.) No amendment shall be allowed that would make the speci-

fication, as amended, claim an invention substantially larger than or substantially different from the invention claimed by the specification as it stood before amendment.

(9.) Leave to amend shall be conclusive as to the right of the party to make the amendment allowed, except in case of fraud ; and the amendment shall in all courts and for all purposes be deemed to form part of the specification.

(10.) The foregoing provisions of this section do not apply when and so long as any action for infringement or other legal proceeding in relation to a patent is pending.

22. (1.) In an action for infringement of a patent, and in a proceeding for revocation of a patent, the court or a judge may at any time order that the patentee shall, subject to such terms as to costs and otherwise as the court or a judge may impose, be at liberty to apply at the patent-office for leave to amend his specification by way of disclaimer, and may direct that in the meantime the trial or hearing of the action shall be postponed.

23. Where an amendment by way of disclaimer, correction, or explanation has been allowed under this Act, no damages shall be given in any action in respect of the use of the invention before the disclaimer, correction, or explanation, unless the patentee establishes to the satisfaction of the court that his original claim was framed in good faith and with reasonable skill and knowledge.

24. Every amendment of a specification shall be advertised in the prescribed manner.

COMPULSORY LICENSES.

25. If on the petition of any person interested it is proved to the Governor in Council that by reason of the default of a patentee to grant licenses on reasonable terms—

(a.) The patent is not being worked in the colony ; or

(b.) The reasonable requirements of the public with respect to the invention cannot be supplied ; or

(c.) Any person is prevented from working or using to the best advantage an invention of which he is possessed, the Governor in Council may order the patentee to grant licenses on such terms as to the amount of royalties, security for payment, or otherwise as the Governor in Council, having regard to the nature of the invention and the circumstances of the case, may deem just, and any such order may be enforced by mandamus.

REGISTER OF PATENTS.

26. (1.) There shall be kept at the patent-office a book, called the "Register of Patents," wherein shall be entered the names and addresses of grantees of patents, notifications of assignments, and of transmissions of patents, of licenses under patents, and of amendments, extensions, and revocations of patents, and such other matters affecting the validity or proprietorship of patents as may from time to time be prescribed.

(2.) The Register of Patents shall be *prima facie* evidence of any matters by this act directed or authorized to be inserted therein.

(3.) Copies of deeds, licenses, and any other documents affecting the proprietorship in any letters patent, or in any license thereunder, must be supplied to the registrar in the prescribed manner for filing in the patent-office.

FEES.

27. (1.) There shall be paid in respect of the several instruments described in the third schedule to this Act the fees in that schedule mentioned, and there shall likewise be paid, in respect of other matters under this part of the Act, such fees as may be from time to time prescribed by the Governor in Council; and such fees shall be paid into the consolidated revenue.

(2.) The Governor in Council may from time to time reduce any of those fees.

EXTENSION OF TERM OF PATENT.

28. (1.) A patentee may, after advertising in manner directed by any rules made under this section his intention to do so, present a petition to the Governor in Council, praying that his patent may be extended for a further term; but such petition must be presented at least six months before the time limited for the expiration of the patent.

(2.) Any person may enter a caveat, addressed to the clerk of the executive council at the council office, against the extension.

(3.) If the Governor in Council shall be pleased to refer any such petition to the court, the court shall proceed to consider the same, and the petitioner and any person who has entered a caveat shall be entitled to be heard by himself or by counsel on the petition.

(4.) The court shall, in considering their decision, have regard to the nature and merits of the invention in relation to the public to the profits made by the patentee as such, and to all the circumstances of the case.

(5.) If the court report that the patentee has been inadequately remunerated by his patent, it shall be lawful for the Governor in Council to extend the term of the patent for a further term not exceeding seven, or in exceptional cases, fourteen, years ; or to order the grant of a new patent for the term therein mentioned, and containing any restrictions, conditions, and provisions that the court may think fit.

(6.) It shall be lawful for the judges of the Supreme Court, or any two of them, of whom the Chief Justice shall be one, to make from time to time rules of procedure and practice for regulating proceedings on such petitions, and subject thereto such proceedings shall be regulated according to the existing procedure and practice in cases of petitions to the court.

(7.) The costs of all parties of and incident to such proceedings shall be in the discretion of the court, and the orders of the court respecting costs shall be enforceable in the same manner as other orders of the court.

REVOCATION.

29. (1.) The proceeding by scire facias to repeal a patent is hereby abolished.

(2.) Revocation of a patent may be obtained on petition to the court.

(3.) Every ground on which a patent may, at the commencement of this Act, be repealed by scire facias shall be available by way of defense to an action of infringement, and shall also be a ground of revocation.

(4.) A petition for revocation of a patent may be presented by—

(a.) The attorney-general ;

(b.) Any person authorized by the attorney-general ;

(c.) Any person alleging that the patent was obtained in fraud of his rights, or of the rights of any person under or through whom he claims ;

(d.) Any person alleging that he, or any person under or through whom he claims, was the true inventor of any invention included in the claim of the patentee ;

(e.) Any person alleging that he, or any person under or through whom he claims an interest in any trade, business, or manufacture, had publicly manufactured, used, or sold, within the colony, before the date of the patent, anything claimed by the patentee as his invention.

(5.) The plaintiff must deliver with his petition particulars of the objections on which he means to rely, and no evidence shall, except by leave of the court or a judge, be admitted in proof of any objection of which particulars are not so delivered.

(6.) Particulars delivered may be from time to time amended by leave of the court or a judge.

(7.) The defendant shall be entitled to begin and give evidence in support of the patent, and if the plaintiff gives evidence impeaching the validity of the patent the defendant shall be entitled to reply.

(8.) Where a patent has been revoked on the ground of fraud the registrar may, on the application of the true inventor, made in accordance with the provisions of this Act, grant to him a patent in lieu of and taking effect from the same date as the date of revocation of the patent so revoked, but the patent so granted shall cease on the expiration of the term for which the revoked patent was granted.

CROWN.

30. (1.) A patent shall have to all intents the like effect 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, and others, at any time after the application, use the invention for the service of the crown on terms to be before or after the use thereof agreed on, with the approval of the minister, between those officers or authorities and the patentee, or, in default of such agreement, on such terms as may be settled by the minister after hearing all parties interested.

LEGAL PROCEEDINGS.

31. (1.) In an action or proceeding for infringement or revocation of a patent, the court may, if it thinks fit, and shall on the request of either of the parties to the proceeding, call in the aid of an assessor specially qualified, and try and hear the case wholly or

partially with his assistance. The action shall be tried without a jury, unless the court shall otherwise direct.

(2.) The remuneration, if any, to be paid to an assessor under this section shall be determined by the court, and be paid in the same manner as the other expenses of the execution of this Act.

32. (1.) In an action for infringement of a patent the plaintiff must deliver with his statement of claim, or by order of the court or the judge, at any subsequent time, particulars of the breaches complained of.

(2.) The defendant must deliver with his statement of defense, or by order of the court or a judge, at any subsequent time, particulars of any objections on which he relies in support thereof.

(3.) If the defendant disputes the validity of the patent, the particulars delivered by him must state on what grounds he disputes it, and, if one of those grounds is want of novelty, must state the time and place of the previous publication or use alleged by him.

(4.) At the hearing no evidence shall, except by leave of the court or a judge, be admitted in proof of any alleged infringement or objection of which particulars are not so delivered.

(5.) Particulars delivered may be from time to time amended, by leave of the court or a judge.

(6.) On taxation of costs regard shall be had to the particulars delivered by the plaintiff and by the defendant, and they respectively shall not be allowed any costs in respect of any particular delivered by them unless the same is certified by the court or a judge to have been proven, or to have been reasonable and proper, without regard to the general costs of the case.

33. In an action for infringement of a patent, the court or a judge may on the application of either party make such order for an injunction, inspection, or account, and impose such terms and give such directions respecting the same and the proceedings thereon as the court or a judge may see fit.

34. In an action for infringement of a patent, the court or a judge may certify that the validity of the patent came in question, and if the court or judge so certifies, then in any subsequent action for infringement the plaintiff in that action, on obtaining a final order or judgment in his favor, shall have his full costs, charges, and expenses as between solicitor and client, unless the court or judge trying the action certifies that he ought not to have the same.

35. When any person claiming to be the patentee of an invention, by circulars, advertisements, or otherwise, threatens any other person with any legal proceedings or liability in respect of any alleged manufacture, use, sale, or purchase of the invention, any person or persons aggrieved thereby may bring an action against him, and may obtain an injunction against the continuance of such threats, and may recover such damage, if any, as may have been sustained thereby, if the alleged manufacture, use, sale, or purchase to which the threats related was not in fact an infringement of any legal rights of the person making such threats: Provided, That this section shall not apply if the person making such threats with due diligence commences and prosecutes an action for infringement of his patent.

MISCELLANEOUS.

36. Every patent may be in the form in the second schedule to this Act, and shall be granted for one invention only, but may contain more than one claim; but it shall not be competent for any person in an action or other proceeding to take any objection to a patent on the ground that it comprises more than one invention.

37. (1.) If a person possessed of an invention dies without making application for a patent for the invention, application may be made by, and a patent for the invention granted to, his legal representative.

(2.) Every such application must be made within six months of the decease of such person, and must contain a declaration by the legal representative that he believes such person to have been the true and first inventor of the invention.

38. A patent granted to the true and first inventor shall not be invalidated by an application in fraud of him, or by provisional protection obtained thereon, or by any use or publication of the invention subsequent to that fraudulent application during the period of provisional protection.

39. A patentee may assign his patent for the whole colony or any place in or part of the colony.

40. If a patent is lost or destroyed, or its non-production is accounted for to the satisfaction of the registrar, the Governor in Council may at any time cause a duplicate thereof to be sealed.

41. The law officer may examine witnesses on oath and administer oaths for that purpose under this part of this Act, and may

from time to time make, alter, and rescind rules regulating references, and appeals to the law officer and the practice and procedure before him under this part of this Act; and in any proceeding before the law officer under this part of this Act the law officer may order costs to be paid by either party, and any such order may be made a rule of the court.

42. The exhibition of an invention at an industrial or international exhibition, certified as such by the minister, or the publication of any description of the invention during the period of the holding of the exhibition, or the use of the invention for the purpose of the exhibition in the place where the exhibition is held, or the use of the invention during the period of the holding of the exhibition by any person elsewhere, without the privity or the consent of the inventor, shall not prejudice the right of the inventor or his legal personal representative to apply for and obtain provisional protection and a patent in respect of the invention or validity of any patent granted on the application: Provided, That both the following conditions are complied with, namely:

(a.) The exhibitor must, before exhibiting the invention, give the registrar the prescribed notice of his intention to do so; and

(b.) The application for a patent must be made before or within six months from the date of the opening of the exhibition.

43. The registrar shall from time to time prepare and publish such indexes, abridgments of specifications, catalogues, and other works relating to inventions as the minister may direct.

44. The minister may at any time require a patentee to furnish him with a model of his invention on payment to the patentee of the cost of the manufacture of the model, the amount to be settled in case of dispute by the auditor-general.

45. (1.) A patent shall not prevent the use of an invention for the purposes of the navigation of a foreign vessel within the jurisdiction of the Supreme Court of Queensland, or the use of an invention in a foreign vessel within that jurisdiction: Provided, It is not used therein for or in connection with the manufacture or preparation of anything intended to be sold in or exported from Queensland.

(2.) But this section shall not extend to vessels of any foreign State of which the laws authorize subjects of such foreign State having patents or like privileges for the exclusive use or exercise of inventions within its territories, to prevent or interfere with the use of such inventions in British vessels while in the ports of such for-

eign State, or in the waters within the jurisdiction of its courts, where such inventions are not so used for the manufacture or preparation of anything intended to be sold in or exported from the territories of such foreign State.

EXISTING PATENTS.

46. (1.) The provisions of this Act relating to applications for patents and proceedings thereon shall have effect in respect only of applications made after the commencement of this Act.

(2.) Every patent granted before the commencement of this Act, or on an application then pending, shall remain unaffected by the provisions of this Act relating to patents binding the crown, and to compulsory licenses.

(3.) In all other respects (except with regard to fees payable in respect of granting a patent) this Act shall extend to all patents granted before the commencement of this Act, or on applications then pending, in substitution for such enactments as would have applied thereto if this Act had not been passed.

(4.) All instruments relating to patents granted before the commencement of this Act required to be left or filed in the Supreme Court shall be deemed to be so left or filed if left or filed before or after the commencement of this Act in the patent-office.

PART III.

DESIGNS.

REGISTRATION OF DESIGNS.

47. (1.) The registrar 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 Queensland, register the design under this part of this Act.

(2.) The application must be made in the form set forth in the first schedule to this Act or in such other form as may be from time to time prescribed, and must be left at or sent by post to the patent-office in the prescribed manner.

(3.) The application must contain a statement of the nature of the design, and the class or classes of goods in which the applicant desires that the design be registered.

(4.) The same design may be registered in more than one class.

(5.) In case of doubt as to the class in which a design ought to be registered, the registrar may decide the question.

(c.) The registrar may, if he thinks fit, refuse to register any design presented to him for registration, but any person aggrieved by any such refusal may appeal therefrom to the law officer.

(7.) The law officer shall, if required, hear the applicant and the registrar, and may make an order determining whether and subject to what conditions, if any, registration is to be permitted.

48. (1.) On application for registration of a design the applicant shall furnish to the registrar the prescribed number of copies, of drawings, photographs, or tracings of the design, sufficient, in the opinion of the registrar, for enabling him to identify the design; or the applicant may, instead of such copies, furnish exact representations or specimens of the design.

(2.) The registrar may, if he thinks fit, refuse any drawing, photograph, tracing, representation, or specimen which is not, in his opinion suitable for the official records.

49. (1.) The registrar shall grant a certificate of registration to the proprietor of the design when registered.

(2.) The registrar may, in case of loss of the original certificate, or in any other case in which he deems it expedient, grant a copy or copies of the certificate.

COPYRIGHT IN REGISTERED DESIGNS.

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.

(2.) Before delivery on sale of any articles to which a registered design has been applied the proprietor must (if exact representations or specimens were not furnished on the application for registration) furnish to the registrar the prescribed number of exact representations or specimens of the design, and if he fails to do so the registrar may erase his name from the register and thereupon his copyright in the design shall cease.

51. Before delivery on sale of any articles to which a registered design has been applied the proprietor of the design shall cause each such article to be marked with the prescribed mark or with the prescribed word or words or figures denoting that the design is registered, and if he fails to do so the copyright in the

design shall cease unless the proprietor shows that he took all proper steps to insure the marking of the article.

52. (1.) During the existence of copyright in a design the design shall not be open to inspection except by the proprietor or a person authorized in writing by the proprietor, or a person authorized by the registrar or by the court, and furnishing such information as may enable the registrar to identify the design, nor except in the presence of the registrar or of an officer acting under him, nor except on payment of the prescribed fee; and the person making the inspection shall not be entitled to take any copy of the design or of any part thereof.

(2.) When the copyright in a design has ceased, the design shall be open to inspection, and copies thereof may be taken by any person on payment of the prescribed fee.

53. On the request of any person producing a particular design, together with its mark of registration, or producing only its mark of registration, or furnishing such information as may enable the registrar to identify the design, and on payment of the prescribed fee, it shall be the duty of the registrar to inform such person whether the registration still exists in respect of such design, and if so, in respect of what class or classes of goods, and stating, also, the date of registration and the name and address of the registered proprietor.

54. If a registered design is used in manufacture in any foreign country and is not used in this colony within six months of its registration in this colony, the copyright in the design shall cease.

REGISTER OF DESIGNS.

55. (1.) There shall be kept at the patent-office a book, called the "Register of Designs," wherein shall be entered the names and addresses of proprietors of registered designs, notifications of assignments and of transmissions of registered designs, and such other matters as may from time to time be prescribed.

(2.) The register of designs shall be *prima facie* evidence of any matters by this Act directed or authorized to be entered therein.

FEEES.

56. There shall be paid in respect of applications and registration and other matters under this part of this Act such fees as may be from time to time prescribed by the Governor in Council, and such fees shall be paid into the consolidated revenue.

INDUSTRIAL, INTERNATIONAL, AND INTERCOLONIAL EXHIBITIONS.

57. The exhibition at an industrial, international, or intercolonial exhibition, certified as such by the minister, or the exhibition elsewhere during the period of the holding of the exhibition, without the privity or consent of the proprietor of a design or of any article to which a design is applied, or the publication during the holding of any such exhibition of a description of a design, shall not prevent the design from being registered or invalidate the registration thereof: Provided, That both the following conditions are complied with, namely:

(a.) The exhibitor must, before exhibiting the design or article, or publishing a description of the design, give the registrar the prescribed notice of his intention to do so; and

(b.) The application for registration must be made before or within six months from the date of the opening of the exhibition.

LEGAL PROCEEDINGS.

58. During the existence of copyright in any design—

(a.) It shall not be lawful for any person, without the license or written consent of the registered proprietor, to apply such design or any fraudulent or obvious imitation thereof in the class or classes of goods in which such design is registered, for purposes of sale, to any article of manufacture or to any substance artificial or natural or partly artificial and partly natural; and

(b.) It shall not be lawful for any person to publish or expose for sale any article of manufacture or any substance to which such design or any fraudulent or obvious imitation thereof shall have been so applied, knowing that the same has been so applied without the consent of the registered proprietor.

Any person who acts in contravention of this section shall be liable for every offense to forfeit a sum not exceeding fifty pounds to the registered proprietor of the design, who may recover such sum as a simple contract debt by action in any court of competent jurisdiction.

59. Notwithstanding the remedy given by this Act for the recovery of such penalty as aforesaid, the registered proprietor of any design may (if he elects to do so) bring an action for the recovery of any damages arising from the application of any such design or of any fraudulent or obvious imitation thereof, for the purpose of sale, to any article of manufacture or substance, or from the publication, sale, or exposure for sale, by any person, of any article or

substance to which such design or any fraudulent or obvious imitation thereof shall have been so applied, such person knowing that the proprietor had not given his consent to such application.

60. The author of any new and original design shall be considered the proprietor thereof, unless he executed the work on behalf of another person for a good or valuable consideration, in which case such person shall be considered the proprietor; and every person acquiring for a good or valuable consideration a new and original design, or the right to apply the same to any such article or substance as aforesaid, either exclusively of any other person or otherwise, and also every person on whom the property in such design or such right to the application thereof shall devolve, shall be considered the proprietor of the design in the respect in which the same may have been so acquired, and to that extent, but not otherwise.

PART IV.

[Omitted because relating to trade-marks.]

PART V.

INTERNATIONAL AND INTERCOLONIAL ARRANGEMENTS.

And whereas by the one hundred and third section of the Act of the Imperial Parliament, called "The Patents, Designs, and Trade-Marks Act, 1883," it is enacted as follows, that is to say: [See the section, *ante*, 244.]

And by the one hundred and fourth section of the said Act it is further enacted as follows, that is to say: [See the section, *ante*, 245.]

Be it enacted as follows:

80. (1.) If her Majesty is pleased by order in council to apply the provisions of the said one hundred and third section of the imperial act, called "The Patents, Designs, and Trade-Marks Act, 1883," to the Colony of Queensland, then any person who has applied for protection for any invention, design, or trade-mark in England, or in any foreign State with the government of which her Majesty has made an arrangement under the said section for mutual protection of inventions, designs, or trade-marks, or any of them, shall be entitled to a patent for his invention or to registration of his design or trade-mark (as the case may be) under this Act in priority to other applicants, and such patent or registration shall

take effect from the same date as the date of the protection obtained in England or such foreign State, as the case may be: Provided, That his application is made in the case of a patent within twelve months and in the case of a design or trade-mark within six months from his applying for protection in England or the foreign State with which the arrangement is in force. [Proviso relative to trade-marks.]

(2.) The publication in Queensland, during the respective periods aforesaid of any description of the invention, or the use therein during such periods of the invention, or the exhibition or use therein during such periods of the design, or the publication therein during such periods of a description or representation of the design, or the use therein during such periods of the trade-mark, shall not invalidate the patent which may be granted for the invention or the registration of the design or trade-mark.

(3.) The application for the grant of a patent, or the registration of a design, or the registration of a trade-mark under this section must be made in the same manner as an ordinary application under this Act. [Proviso relative to trade-marks.]

(4.) The provisions of this section shall in the case of foreign States apply only in the case of those foreign States with respect to which her Majesty shall from time to time by order in council declare the provisions of the aforesaid section of the said imperial Act to be applicable, and so long only in the case of each State as the order in council shall continue in force with respect to that State.

81. (1.) Where it is made to appear to the Governor in Council that the legislature of any British possession has made satisfactory provision for the protection of inventions, designs, and trade-marks, or any of them, patented or registered in Queensland, the Governor in Council may from time to time, by order in council, apply all or any of the provisions of the last preceding section relating to the protection of inventions, designs, and trade-marks patented or registered in England, with such variations or additions, if any, as to the Governor in Council may seem fit, to inventions, designs, and trade-marks, or any of them, patented or registered in such British possession.

(2.) An order in council under this section shall, from a date to be mentioned for the purpose in the order, take effect as if its provisions had been contained in this Act; but it shall be lawful for the Governor in Council to revoke any such order in council.

PART VI.

GENERAL.

PROCEEDINGS AT PATENT-OFFICE.

82. There shall be a seal for the patent-office, and impressions thereof shall be judicially noticed and admitted in evidence.

83. There shall not be entered in any register kept under this Act, or be receivable by the registrar, any notice of any trust expressed, implied, or constructive.

84. The registrar may refuse to recommend that a patent be granted for an invention, or to register a design or trade-mark, of which the use would, in his opinion, be contrary to law or morality.

85. Where a person becomes entitled by assignment, transmission, or other operation of law, to a patent or to the copyright in a registered design, or to a registered trade-mark, the registrar shall on request and on proof of title to his satisfaction cause the name of such person to be entered as proprietor of the patent, copyright in the design, or trade-mark, in the register of patents, designs, or trade-marks, as the case may be. The person for the time being entered in the register of patents, designs or trade-marks as proprietor of a patent, copyright in a design, or trade-mark as the case may be, shall, subject to any rights appearing from such register to be vested in any other person, have power absolutely to assign, grant licenses as to, or otherwise deal with, the same, and to give effectual receipts for any consideration for such assignment, license, or dealing: Provided, That any equities in respect of such patent, design, or trade-mark may be enforced in like manner as in respect of any other personal property.

86. Every register kept under this Act shall at all convenient times be open to the inspection of the public, subject to such regulations as may be prescribed; and certified copies, sealed with the seal of the patent-office, of any entry in any such register shall be given to any person requiring the same on payment of the prescribed fee.

87. Printed or written copies or extracts, purporting to be certified by the registrar and sealed with the seal of the patent-office, of or from patents, specifications, disclaimers, and other documents in the patent-office, and of or from registers and other books kept

there, shall be admitted in evidence in all courts of justice and in all proceedings without further proof or production of the originals.

88. (1.) The court may on the application of any person aggrieved by the omission without sufficient cause of the name of any person from any register kept under this Act, or by any entry made without sufficient cause in any such register, make such order for making, expunging, or varying the entry as the court thinks fit, or the court may refuse the application, and in either case may make such order with respect to the costs of the proceedings as the court thinks fit.

(2.) The court may in any proceeding under this section decide any question that it may be necessary or expedient to decide for the rectification of a register, and may direct an issue to be tried for the decision of any question of fact, and may award damages to the party aggrieved.

(3.) Any order of the court rectifying a register shall direct that due notice of rectification be given to the registrar.

89. The registrar may, on request in writing, accompanied by the prescribed fee—

(a.) Correct any clerical error in or in connection with an application for a patent, or for registration of a design or trade-mark; or

(b.) Correct any clerical error in the name, style, or address of the registered proprietor of the patent, design, or trade-mark; or

(c.) Cancel the entry or part of the entry of a trade-mark on the register: Provided, That the applicant accompanies his request by a statutory declaration made by himself, stating his name, address, and calling, and that he is the person whose name appears on the register as the proprietor of the said trade-mark.

90. (1.) The registered proprietor of any registered trade-mark may apply to the court for leave to add to or alter such mark in any particular, not being an essential particular within the meaning of this Act, and the court may refuse or grant leave on such terms as it may think fit.

(2.) Notice of any intended application to the court under this section shall be given to the registrar by the applicant, and the registrar shall be entitled to be heard on the application.

(3.) If the court grants leave, the registrar shall, on proof thereof and on payment of the prescribed fee, cause the register to be altered in conformity with the order of leave.

91. If any person makes or causes to be made a false entry in any register kept under this Act, or a writing falsely purporting to be a copy of an entry in any such register, or produces or tenders or causes to be produced or tendered in evidence any such writing knowing the entry or writing to be false, he shall be guilty of a misdemeanor.

92. Where any discretionary power is by this Act given to the registrar, he shall not exercise that power adversely to the applicant for a patent, or for amendment of a specification, or for registration of a trade-mark or design, without (if so required within the prescribed time by the applicant) giving the applicant an opportunity of being heard personally or by his agent.

93. The registrar may in any case of doubt or difficulty arising in the administration of any of the provisions of this Act apply to the minister for directions in the matter.

94. A certificate purporting to be under the hand of the registrar as to an entry, matter, or thing which he is authorized by this Act, or any general rules made thereunder, to make or do, shall be *prima facie* evidence of the entry having been made, and of the contents thereof, and of the matter or thing having been done or left undone.

95. (1.) Any application, notice, or other document authorized or required to be left, made, or given at the patent-office or to the registrar, or to any other person under this Act, may be sent by a prepaid letter through the post, and if so sent shall be deemed to have been left, made, or given respectively at the time when the letter containing the same would be delivered in the ordinary course of post.

(2.) In proving such service or sending it shall be sufficient to prove that the letter was properly addressed and put into the post.

96. Whenever the last day fixed by this Act, or by any rule for the time being in force, for leaving any document or paying any fee at the patent-office shall fall on Christmas Day, Good Friday, or on a Saturday or Sunday, or bank holiday, or any day observed as a day of public fast or thanksgiving, herein referred to as excluded days, it shall be lawful to leave such document or to pay such fee on the day next following such excluded day, or days, if two or more of them occur consecutively.

97. If any person is, by reason of infancy, lunacy, or other inability incapable of making any declaration or doing anything required or permitted by this Act or by any rules made under the

authority of this Act, then the guardian or committee, if any, of such incapable person, or if there be none, any person appointed by any court or judge possessing jurisdiction in respect of the property of incapable persons, upon the petition of any person on behalf of such incapable person, or of any other person interested in the making such declaration or doing such thing, may make such declaration or a declaration as nearly corresponding thereto as circumstances permit, and do such thing in the name and on behalf of such incapable person, and all acts done by such substitute shall for the purpose of this Act be as effectual as if done by the person for whom he is substituted.

98. (1.) The Governor in Council may from time to time make such general rules and do such things as they think expedient, subject to the provisions of this Act—

(a.) For regulating the practice of registration under this Act ;

(b.) For classifying goods for the purposes of designs and trademarks ;

(c.) For making or requiring duplicates of specifications, amendments, drawings, and other documents ;

(d.) For securing and regulating the publishing and selling of copies, at such prices and in such manner as the Governor in Council think fit, of specifications, drawings, amendments, and other documents ;

(e.) For securing and regulating the making, printing, publishing, and selling of indexes to and abridgments of specifications and other documents in the patent-office, and providing for the inspection of indexes and abridgments and other documents ;

(f.) For regulating the presentation of copies of patent-office publications to patentees and to public authorities, bodies, and institutions at home and abroad ;

(g.) Generally for regulating the business of the patent-office and all things by this Act placed under the direction or control of the registrar or of the minister.

(2.) Any of the forms in the first schedule to this Act may be altered or amended by rules made by the Governor in Council as aforesaid.

(3.) General rules may be made under this section at any time after the passing of this Act, but not so as to take effect before the commencement of this Act, and shall, subject as hereinafter mentioned, be of the same effect as if they were contained in this Act, and shall be judicially noticed.

(4.) Any rules made in pursuance of this section shall be published in the Gazette, and shall forthwith be laid before both houses of Parliament, if Parliament be in session at the time of making thereof, or if not, then as soon as practicable after the beginning of the next session of Parliament.

(5.) If either house of Parliament, within the next forty days after any rules have been so laid before such house, resolve that such rules, or any of them, ought to be annulled, the same shall after the date of such resolution be of no effect, without prejudice to the validity of anything done in the meantime under such rules or rule or to the making of any new rules or rule.

99. The registrar shall in every year make a report respecting the execution by or under him of this Act which shall be laid before both houses of Parliament, and therein shall be included for the year to which each report relates all general rules made in that year under or for the purposes of this Act, and an account of all fees, salaries, and allowances, and other money received and paid under this Act.

OFFENSES.

100. (1.) Any person who represents that any article sold by him is a patented article, when no patent has been granted for the same, or describes any design or trade-mark applied to any article sold by him as registered which is not so, shall be liable for every offense on summary conviction to a fine not exceeding five pounds.

(2.) A person shall be deemed, for the purposes of this enactment, to represent that an article is patented or a design or a trade-mark is registered if he sells the article with the word "Patent," "Patented," "Registered," or any word or words expressing or implying that a patent or registration has been obtained for the article stamped, engraved, or impressed on, or otherwise applied to the article.

101. [Omitted because relating only to use of royal arms.]

102. The registers of patents and of proprietors kept under any enactment repealed by this Act shall respectively be deemed parts of the same book as the register of patents kept under this Act.

103. Nothing in this Act shall take away, abridge or prejudicially affect the prerogative of the Crown in relation to the granting of any letters patent or to the withholding of a grant thereof.

From 31 *Pat. Off. Gaz.* 122.*

* Schedules omitted because not given in the Patent Office Gazette.

RUSSIA.

*Code of Laws of the Russian Empire.—Vol. XI., Part II.
Statute of Manufacturing Industry, Section 3.**

PATENTS FOR NEW INVENTIONS AND DISCOVERIES.

CHAPTER I.

NATURE OF PATENTS FOR INVENTIONS AND DISCOVERIES.

ARTICLE 73. Every discovery or invention of any new and useful art, machine, manufacture, or composition of matter, and every improvement on any art, machine, manufacture, or composition of matter, is the property of the person or persons by whom such discovery, or invention, or improvement has been made, and that person, in order to secure his rights to such property, may make application to the government for an exclusive privilege or patent for it.

ART. 74. A patent is therefore a document granted by the government to certify that the individual or individuals specified therein has or have laid the description of the discovery, invention, or improvement before the government, and conveys to the aforesaid individual or individuals the sole right to make, use, or dispose of the new invention, discovery, or improvement described, for a certain specified period.

ART. 75. In granting such patent, the government neither guarantees that the discovery, invention, or improvement described actually belongs to the individual or individuals specified therein, nor answers for the utility of the said discovery, invention, or improvement, but merely certifies that such discovery, invention, or improvement has actually been laid before the government, stating the time and the name or names of the individual or individuals applying for the patent.

ART. 76. Consequently, a patent granted by the government does not deprive any person or persons of the right of proving, by legal process, that the discovery, invention, or improvement belongs

* A concise, practical statement of the substance of this law is given in a report by Mr. Ford, of the British Legation, published October 28, 1873, 4 Pat. Off. Gaz. 448.

to him or them, or has been in use prior to the grant of the patent.

ART. 77. Until it shall have been proved, however, before a court of law that the person to whom the patent has been granted was not the inventor and has no right to it, he enjoys the following privileges :—

(1.) He has the sole right during the time specified to take the benefits of the discovery, invention, or improvement as property belonging exclusively to him, to make, use, sell, dispose of, bequeath, or make over by any other lawful means, the object for which the patent was granted, as well as the patent itself, or to allow any other person to make use of it, during the whole term for which it was granted, or for a shorter period.

(2.) To prosecute by law all infringements, and to seek for redress for the losses he may have sustained by such.

ART. 78. An exact imitation of all the essential parts of the discovery, invention, or improvement for which the patent was granted, notwithstanding there may be some slight alterations in it, not affecting its individuality, or even should there be improvements on it, but in which the essential parts remain, is considered an infringement.

ART. 79. Patents may be taken out for discoveries, inventions, or improvements made in foreign countries, and for which the term of the patent granted in those countries has not expired ; in such case, however, the term of the patent granted in Russia cannot extend beyond the term for which the patent was taken out by the inventor abroad. A patent for the introduction of an invention previously known and in use in foreign countries, and for which no patent has been taken out in those countries, can only be granted by way of exception and by special favor of the government, with a view to the advantages and utility to be derived from such introduction. Patents granted for foreign inventions have the same force and effect as patents taken out for inventions made in Russia.

ART. 80. Patents cannot be granted for fundamental or elementary principles, as for instance, distilling brandy by steam, or boiling sugar by means of steam in a vacuum, unless their application or combination produces some new result in the arts, presenting a special and new apparatus.

ART. 81. Patents shall not be granted for trifling or unimportant discoveries, inventions, or improvements indicative only of inventive genius, without offering any real advantage or utility,

nor for such inventions as may become dangerous to society, or detrimental to the government revenues.

ART. 82. No patents shall be granted for inventions and improvements relating to implements of war and the defense of the State, such as cannons, shells, fuses, and other appurtenances of ordnance, armor for ships, torpedoes, powder magazines, revolving turrets, &c., the exclusive use of which belongs to the government. But patents shall be granted for inventions and improvements the objects of which, though applicable to military purposes, are useful also to private persons, such as small fire-arms, metallic cartridges, bullets, and other appurtenances of hand weapons. Patents for these inventions shall, however, be granted solely on the condition that the same shall not hinder the army and navy administrations in the trial and use of such inventions and improvements for military purposes.

ART. 83. Patents are granted to aliens, who are allowed to construct manufactories, mills, &c., without turning Russian subjects, as well as to Russian subjects.

CHAPTER II.

ORDER OF GRANT OF PATENTS.

ART. 84. The application for a patent for any new discovery, invention, or improvement in the arts, manufactures, and trades, must be made by petition to the department of manufactures and home trade, praying for the exclusive right to the invention, discovery, or improvement, specifying the term for which the patent is solicited, and there shall be annexed the necessary drawings and plans, together with a written description of the invention or discovery, and of the matter and process of making, constructing, using, and compounding the same, in such full, clear, 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, without having recourse to conjecture, or filling up omissions in the defective specification.

In this description the applicant must particularly specify and point out the part, improvement, or combination which he claims as his own invention or discovery. The description must be written in Russian, and in the event of its having been translated from a foreign language, the original must be annexed for the purpose of verification. The description of the discovery, invention, or

improvement in a foreign language may be presented without a Russian translation, in order to obtain an official certificate of the applicant's right of property in the invention, but not for the purpose of taking out a patent; the grant of a patent can only be obtained by supplying a description, or translation of it, in the Russian language. In the event of non-fulfillment of the above by the petitioner, or his agent, within three months from the date on which the description in a foreign language was presented, the petition will be null and void. The applicant shall deliver a model of his invention, discovery, or improvement, when the same admits of a model, and should it be necessary for the better understanding of it. On presenting the petition, drawings, and description, the applicant shall pay into the treasury of the department the amount of duties according to the following scale:—

(1.) For discoveries, inventions, or improvements of the discoverers, inventors, and improvers themselves :

	S. Rs.
For 3 years.....	90
“ 5 “	150
“ 10 “	450

(2.) For the introductions of inventions, discoveries, or improvements already existing and known abroad :

	S. Rs.
For 1 year.....	60
“ 2 “	120
“ 3 “	180
“ 4 “	300
“ 6 “	360

ART. 85. On the filing of such an application (consisting of petition, specification, model, or drawings), and on payment of the duty, the department of trade and manufactures will, on the same day, hand the applicant a receipt for the same, signed by the director of the department, with the government seal affixed. To persons living in other towns, the department may send such receipt by post. This certificate, or receipt, shall specify the year, month, day, and hour when the application was received by the department.

ART. 86. Petitions for the grant of patents for any discovery, invention, or improvement in arts, manufactures, and crafts, shall be examined by the council of trade and manufactures, at the session of which the director of the department of the ministry to whose province the application pertains shall be invited to attend.

The examination is only made with a view of ascertaining whether a patent has already been granted to another for the same invention or discovery, and whether the description delivered by the applicant is sufficiently exact, clear, and full ; and finally, whether the invention or discovery for which the patent is solicited offers any advantage or utility. Special attention shall be paid by the council of trade and manufactures to the investigation of the invention, discovery, or improvement, with a view of ascertaining whether it contains anything unhealthy, or likely to endanger the lives of people. When necessary, and in order to decide with the more certainty on this latter question, the council of trade and manufactures may confer with the medical board.

ART. 87. Should the council of trade and manufactures, on examination of such application, decide that the invention, discovery, or improvement for which a patent has been solicited has been described with a sufficient accuracy, clearness, and fullness ; that no patent has been granted for such to any other person prior to the alleged invention or discovery thereof by the applicant ; and that it does not contain anything unhealthy or likely to endanger the lives of people, or be in any way detrimental to the government revenues ; they shall then, having first fixed the term of the patent according to the condition of the branch of industry to which it belongs ; recommend to the minister of finance that a patent be granted, and one shall then be issued under the hand of the minister. If, on the contrary, it be known to the council of trade and manufactures that the invention for which a patent is solicited has already been described, or has been made use of anywhere, they shall refuse the patent : moreover, should the applicant's alleged invention or improvement be considered dangerous to the health and lives of people, he shall be bound by an undertaking signed by him not to put it into action, under penalty of the rigor of the law. The council shall publish the reasons for the refusal of a patent in the Official Gazette, in the newspapers of both capitals, and in the Warsaw Gazette.

ART. 88. An applicant who has been refused the grant of a patent by reason of or on account of defective or insufficient description or drawings, may again make application by presenting an amended specification containing the necessary explanations and amplifications ; and should such be found satisfactory the issue of patent will be effected according to the rule herein contained.

ART. 89. Should there be more than one applicant for the same

invention or discovery, pending the examination, the patent shall not be granted at all; an exception to this rule is made, however, in the event of one of the applicants proving by legal process that the other has appropriated his invention.

ART. 90. In case of the refusal of a patent, the money paid in by the applicant will be repaid to him without delay.

CHAPTER III.

TERM OF PATENTS.

ART. 91. Patents for discoveries, inventions, and improvements are granted to the discoverer, inventor, and improver himself, as he may wish, and according to the discrimination of the government, for three, five, or ten years, but not for longer. The term of patents for the introduction of inventions already known in foreign countries shall not exceed six years, or as is provided for in article 79.

ART. 92. No extension of a patent can be granted after the expiration of the term for which it was originally issued.

ART. 93. The term of a patent commences from the day on which it is signed, but the power of taking legal proceedings for infringement of a patent dates from the day of issue of the certificate of filing the application for the patent. A publication of each certificate delivered is made in the newspapers of both capitals and in the Warsaw Gazette.

CHAPTER IV.

FORM OF PATENTS AND THEIR PUBLIC NOTIFICATION.

ART. 94. A patent must always be headed by the words "By order of His Imperial Majesty."

The patent contains:

- (1.) The name of the applicant.
- (2.) The day on which the application was made.
- (3.) A full and detailed description of the discovery, invention, improvement, or introduction.
- (4.) The term of the patent.
- (5.) The amount of duty paid for the same into the treasury.
- (6.) A certificate, to the effect that no privilege has been granted for the same discovery, invention or improvement, to any other than the person who holds it.
- (7.) A notice that the government does not guarantee that the

discovery, invention, or improvement for which the applicant has solicited a patent actually belongs to him, or that it is a success.

(8.) The signature of the minister to whose province the granting the patent belongs.

(9.) The countersignature of the director of the department.

ART. 95. Patents shall be written on parchment.

ART. 96. A full and detailed account of the discovery, invention, or improvement, shall be published immediately on delivery, in the publications of the ministry to which it appertains, in the Senate Gazette, in the newspapers of both capitals, and in the Warsaw Gazette. Independently of the above, the departments that have granted the patent are bound to show the register of new inventions for which patents have been granted, to any one who may wish to see it.

CHAPTER V.

THE RIGHTS AND DUTIES OF PATENTEE.

ART. 97. The holder of a patent is bound to put into complete practice or execution, during the first quarter of the term specified, the discovery, invention, or improvement for which the patent was granted, and before the expiration of the six months after this to present to the department from which the patent was issued a certificate from the local authorities, to the effect that it has actually been put into execution—*i. e.*, that the patented invention or improvement has been put into practical use.

ART. 98. Should the patentee wish to transfer the patent to another person, or to enter into partnership in respect to such patent, such matters must be effected through the proper courts, and according to the laws. On making such transfer, or on entering into partnership, the original patentee must communicate the same to the department, and the latter shall publish it in the newspapers.

ART. 99. A patentee has not the right of forming a joint stock company for the purpose for which the patent was taken out, nor of transferring his patent to such a company without special permission from the government.

ART. 100. Should a patentee make any new improvement on his invention or discovery, or introduce any important alteration in it, readjusting and simplifying his process, he is at liberty to take out a patent for it, but in any case he is bound to give notice of

such improvement or alteration to the department, together with a detailed and accurate description of the said improvement or alteration.

ART. 101. Should any other person than the original patentee make an improvement on the patentee's invention or discovery, the former cannot take out a patent for it unless he can prove that he has entered into an agreement with the original patentee, by which the latter has consented to his making use of his improvement. At the expiration of the term of the first patent, however, he may take out a patent for his improvement on the first patentee's invention.

ART. 102. In the cases provided for in the preceding articles (100 and 101), the following rules must be observed:—

(1.) In applications for patents for improvements made by the inventor himself, the term specified for the patent must be shorter than that of the patent for the original invention.

(2.) That the effect of such patent is entirely independent of the patent granted for the principal invention, so that the term of the latter cannot be extended, though the term of the patent granted for the improvement may not have expired.

(3.) That the term of a patent taken out for an improvement made by any other person on the original patentee's invention shall not be more than half the term granted to the original patentee.

ART. 103. Patents shall cease:—

(1.) At the expiration of the term for which they are issued.

(2.) When it shall be proved before a court of law that the same discovery, invention, or improvement for which the patent was granted, was, before the patentee presented his petition, already introduced in the Russian empire, or was known by descriptions or specifications, by which the same apparatus or process in essential respects could be produced or carried out without the new description or specification.

(3.) When it shall be proved before a court of law that the discovery, invention, or improvement for which a patent has been granted, was already in use somewhere without being patented, with the exception, however, of the introduction of inventions, discoveries, and improvements from foreign countries admitted by special favor, as provided for in article 79.

(4.) When it shall be proved by judgement of a court of justice that the person to whom a patent has been granted appropriated the discovery, invention, or improvement of another person, and the real inventor petitions for the repeal of such patent.

(5.) When it shall be proved that the description or specification is not complete, that the details of some of the essential parts or properties of the discovery or invention, without which the expected results could not possibly be obtained, have been left out or kept back ; or that essential alterations and improvements have been made, without which it is impossible to obtain the desired result, or generally that the specification does not disclose the real mode of procedure.

(6.) Should the patentee not present, within the time specified, to the department to which it pertains, the certificate from the local authorities, as provided for in article 97.

ART. 104. In any and all of the cases referred to in article 103, the department from which the patent was issued shall publish an advertisement in the newspapers of both capitals, and in the Warsaw Gazette, that the patent no longer exists, and after such publication every one has the right to make use of the discovery, invention, or improvement for which the patent was granted.

From *Carpn. Pat. L. of World*, 453.

ST. CHRISTOPHER.

See LEEWARD ISLANDS.

ST. HELENA.

Ordinance No. 3 of 1872. An Ordinance made by the Governor of St. Helena for the extension to this Island of Letters Patent granted under the Great Seal of the United Kingdom of Great Britain and Ireland.

Preamble. Whereas it is expedient that letters patent granted under the Great Seal of the United Kingdom of Great Britain and Ireland should have the same force and effect within the Island of St. Helena as such letters have in the said United Kingdom ; be it enacted as follows :

1. *Privileges granted by letters patent in the United Kingdom extended to St. Helena.* The grantee of any such letters patent, and the executors, administrators and assigns of the said grantee shall be entitled to the sole and exclusive privileges of making, selling and using in the Island of St. Helena, the invention patented by such letters, and of authorizing others so to do, for and during the unexpired residue of the term granted in and by such letters, and if the said letters patent shall by competent authority be renewed in and for the United Kingdom, the term of the privileges granted in respect of the inventions comprised in such letters which may be so renewed, shall *ipso facto* thereupon be also prolonged in and for the Island of St. Helena for and during such renewed term subject to the following conditions and provisions :

2. *Grantee to file copy of such letters in the Supreme Court.* The grantee or grantees of such letters patent shall file in the registry of the Supreme Court a copy of such letters patent and specification, or in case of a renewal a copy of the renewal thereof, such copy of the letters patent and specification or of the renewal thereof, to be signed and certified as a true copy by one of the officers to whose custody the original is entrusted, and if such filing be not so effected, the privileges granted by this ordinance in respect of the inventions comprised in such letters shall cease to have effect.

3. *Letters to be open to inspection.* Every such copy so filed, shall, if purporting to be so signed and certified, be *prima facie* evidence of the document of which it purports to be a copy, and shall be open at all reasonable times at the office of the registrar of the Supreme Court for the inspection of any person ; and the

said registrar shall permit to be made by any person a copy of the whole or any part of such copy of the said letters patent and specification, and shall on application certify the same to be a true copy.

4. *Fees payable to the registrar.* The following fees shall be payable to and accounted for by the registrar of the Supreme Court, viz :

	£	s.	d.
For filing copy of letters patent and specification.....	1	1	0
For inspection and permission to copy the same.....	0	2	6
For registrar's certificates to copy.....	0	5	0

5. *All cases of doubt to be settled by law of England.* In all cases of doubt or difficulty not provided for by this ordinance, or by the local laws of this island, the same shall be guided and governed, so far as practicable, by the law in force in England.

From *Carp. Pat. L. of World*, 464.

ST. PIERRE.

See FRANCE.

SALVADOR.

A report by Mr. Corbett, of the British Legation, published October 7, 1873, in 4 *Pat. Off. Gaz.* 372, under the head of San Salvador, states that: "Our Constitution gives power to the executive to award and concede privileges to the authors of useful inventions; but this faculty is not arranged as it should be, by a secondary law; and in the few cases which have occurred, the spirit of this constitutional disposition has been followed in accordance with the practice of civilized governments."

See also INTERNATIONAL CONVENTION.

SAXONY.

See GERMAN EMPIRE.

SCOTLAND.

See GREAT BRITAIN AND IRELAND.

SENEGAMBIA.

See FRANCE.

SERVIA.

See INTERNATIONAL CONVENTION.

SOUTH AUSTRALIA.

An Act to Consolidate and Amend the Laws Relating to Patents for Inventions. No. 78 of December 21, 1877.

[NOTE.*—The words in italics in sections 4, 6, 25, and schedule B are alterations made by Act No. 101, 1878, and Act No. 201, 1881.]

Preamble. Whereas it is expedient to amend the law relating to the grant of patents for inventions in the province of South Australia: Be it therefore enacted by the Governor of the province of South Australia, with the advice and consent of the Legislative Council and House of Assembly of the said province, in this present Parliament assembled, as follows:

1. *Repeal.* From and after the passing hereof, "The Patent Act, 1859," being Act No. 18 of 1859, and "The Provisional Registration of Patents Act, 1875," being Act No. 3 of 1875, are hereby repealed; but this repeal shall not affect the validity of any letters of registration or any provisional registration granted, made, or entered under the said repealed Acts or either of them, nor the rights, remedies, or liabilities of any parties or persons in respect of any such letters of registration, or of such provisional registration, nor affect or prevent the grant of any letters of registration under "The Patent Act, 1859," pursuant to any application therefor made before the passing of this Act, but such application shall be proceeded with and granted, and the letters of registration when granted shall have the same effect as if this Act had not passed, provided that the applicant may at any time before the granting of letters of registration to him, in pursuance of such application, apply for and obtain a patent under this Act in place of such letters of registration, without any further payment than he shall have made under "The Patent Act, 1859."

2. *Short title.* This Act may be cited for all purposes as "The Patent Act, 1877."

* Notes printed in this manner are from Carpmals' edition.

The law as presented there and in the text consists of Act No. 78, of December 21, 1877, with which are consolidated the

alterations made by Act No. 101, 1878, and Act No. 201, 1881. The Acts No. 78 of 1877, and No. 101 of 1878, are published separately and in full in 20 Pat. Off. Gaz. 1088-1092.

3. *Division of Act.* This Act is divided into seven parts, relating to the following subject-matters:—

Part I.—Patent-Office, sections 4 to 8:

Part II.—Who may obtain patents, sections 9 to 13:

Part III.—How patents obtained, sections 14 to 29:

Part IV.—Effect, conditions and extension of patents, sections 30 to 37:

Part V.—New patents, disclaimers, alterations and confirmations, sections 38 to 45:

Part VI.—Caveats; and revocation and assignment of patents, sections 46 to 52:

Part VII.—Miscellaneous provisions, sections 53 to 72.

PART I.

PATENT-OFFICE.

4. *Establishment of patent-office.* There shall be attached to the department of the attorney-general or to a branch of such department, an office to be called the patent-office, and the commissioner of patents under this Act shall receive and have the custody of all applications, papers, documents, models, machines, books, and records relating to patents, and shall receive all fees, and perform all acts and things incidental to the grant, issue, or renewal of patents under this Act.

5. *Seal of patent-office to be received in evidence.* The commissioner of patents shall have a seal, to be called “the Seal of the Patent-Office,” and such seal and any impression thereof shall be taken judicial notice of by all courts, judges, and magistrates, tribunals, and persons authorized to receive evidence in the said province, who shall receive in evidence any document bearing an impression of the said seal, and purporting to be a copy of or extract from any document or book deposited or kept in the said patent-office under the provisions hereof, without the production of the original.

6. *Commissioner.* The secretary to the attorney-general for the time being shall be commissioner of patents.

7. *Governor may make rules and prescribe forms.* The Governor may from time to time, by proclamation in the government Gazette, make, prescribe, repeal, and alter such regulations and forms as he shall deem necessary or expedient for the purposes of this Act.

8. *Governor may appoint clerks and officers.* The Governor may from time to time appoint and remove such clerks and officers as he may deem expedient for carrying out the purposes of this Act, and no commissioner of patents, nor any clerk or officer, appointed as aforesaid shall, unless he shall be the original inventor or the legatee of the rights of the original inventor, buy, sell, acquire, or otherwise deal in any patent or right to a patent, and every purchase, sale, acquisition, or other dealing contrary to the provisions of this section, shall be null and void.

PART II.

WHO MAY OBTAIN PATENTS.

9. *Power to issue patents.* The true and first inventor of 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 publicly used or offered for sale within the said province prior to the date of the patent for the same, may, on petition to the commissioner, and on complying with the requirements of this Act, obtain a patent under the hand of the commissioner and the seal of the patent-office for the sole making, using, exercising, and vending of any such art, machine, manufacture, or composition of matter, or improvement within the said province.

10. *Inventions for which foreign patents have been obtained.* An inventor shall not be entitled to a patent for his invention if a patent or other similar privilege therefor shall have been in existence in any country other than the said province, and shall have expired before a patent shall be granted to him under this Act; and whenever a patent or other similar privilege in any other country than the said province in respect of any invention is in existence, at the time when a patent is granted for the same invention under this Act, such last named patent shall not confer any rights for any period beyond the earliest date at which the patent or other similar privilege in such other country shall expire.

11. *Inventor's representatives may obtain patent.* A patent may be granted by the commissioner to any person to whom any inventor, entitled to obtain a patent, has assigned or bequeathed the right of obtaining it, or in default of such assignment or bequest, to the executor or administrator of any deceased inventor.

12. *Patent for improvements on patented invention.* A patent

may be granted under this Act in respect of any improvement on or modification of any previously patented or registered invention, but shall not be deemed to confer any right to make, use, exercise, or vend such last named invention.

13. *Patents to several persons jointly.* Where several persons shall make a joint application for a patent it shall be granted to them jointly, and any assignment from one or more of them to the other or others, or to any other person, shall be registered like any other assignment of a patent.

PART III.

HOW PATENTS OBTAINED.

14. *Repealed.* See sections 3 and 7 of Act of 1881.

15. *Petition for patent to be accompanied by specification.* The petition shall contain the name or title of the invention, and shall state an address within the City of Adelaide, to which notices in respect of such petition may be sent, and shall be accompanied by a specification in duplicate of the invention for which the patent is sought. The petition and specification shall be filed in the patent-office, and the day of such filing shall be recorded at the said office, and indorsed on the petition, and a certificate thereof, under the seal of the patent-office, given to the applicant, or his agent, and thereupon, except in case of application for a patent by any person to whom the commissioner shall have already refused to grant a patent for an invention substantially the same as that for which such application for a patent is made, and subject to the provisions hereinafter contained, the invention shall be protected under this Act for the term of six months next after such filing, and the applicant shall during such term have the like powers, rights, and privileges as would have been conferred upon him by a patent for such invention issued under this Act, and duly sealed, as of the day of such filing: Provided that in case the specification be too large or insufficient, the commissioner may, during the said term of six months, and before the grant of the patent, allow or require the specification to be amended, or another and sufficient specification to be filed in lieu thereof, and every such amended or new specification shall have the same force and effect as if it had been filed in its amended or new form on the day of the filing of the original specification.

16. *Requisites of specifications.* Every such specification shall

correctly and fully describe and ascertain the nature and principle of the invention, and in what manner it is to be made, used, worked, or performed, and shall be signed by the inventor if he be alive, and if not by the applicant, which signature shall be attested by two witnesses, who shall specify when and where the same was signed; and in any case where the invention admits of a model or drawing, illustration, or explanation by means of drawings, the specification shall contain or be accompanied by a model or by drawings in duplicate, showing clearly all parts of the invention, which drawings, if not comprised in the specification, shall be signed and attested in the same manner as the specification: Provided that in any case the commissioner may in his discretion dispense with any such drawings.

[NOTE.—See section 4 of Act of 1881.]

17. Commissioner to publish notice in Gazette. The commissioner shall cause to be published in the Government Gazette a notice that the applicant has applied for a patent in respect of the specified invention, giving the name or title thereof, and stating that the specification thereof may be inspected at the patent-office; and that any person may within one month, or within such longer period not exceeding three months to be specified in such notice as the commissioner may determine, object to the grant of the patent by lodging at the patent-office notice in writing, stating his name and address and the nature and grounds of his objection, and also an address within the City of Adelaide, to which notices in respect of such objection or of the application for the patent may be sent.

18. Applicant to publish notice. The applicant shall within one week after the filing of his petition, cause notice to be given by advertisement to be inserted three times in at least two of the daily newspapers published in Adelaide, stating that he has applied for a patent for the invention, giving its title or name, and stating that the specification may be inspected at the patent-office.

19. If no objections lodged, commissioner to grant patent. If there shall be no objection lodged within the period limited for that purpose by the notice of the government Gazette, the commissioner shall, on the expiration of such period, determine upon the application for the patent and no person shall be entitled to object to such application.

20. If objection lodged, commissioner to give notice. If during the period limited as aforesaid any objection to the grant of the patent shall have been duly lodged in the patent-office under the

provisions of this Act, the commissioner shall, immediately on the expiration of such period, send through the general post-office, or otherwise, to the applicant and to every objector at the respective addresses given as hereinbefore prescribed for that purpose, a notice in writing that he will, at a time and place to be specified in the notice, such time to be not less than ten nor more thirty days from the time of posting or otherwise sending such notice, attend to hear and determine upon the application and the objections.

21. Commissioner may summon witnesses. The commissioner shall, at the request of the applicant or of any objector, issue summonses under the seal of the patent-office for the attendance of witnesses, and every witness so summoned shall be bound to attend at the time and place mentioned in such summons on being paid his expenses according to the scale for the time being allowed to witnesses on trials in local courts, and to continue in attendance until the matter shall be disposed of, and to produce any documents which he shall by any such summons be required to produce, if they are in his possession, power, custody, or control.

22. Penalty for non-attendance of witness. Any witness neglecting to attend, or continue to attend, or to produce any documents in accordance with such summons, shall be liable to a penalty of twenty pounds, in addition to the costs of service of the summons upon him, and the amount paid him for expenses, which penalty, costs, and amount may be recovered by the person on whose behalf such summons shall be issued by information before any two justices of the peace in a summary way, together with the costs of, and incidental to, and resulting from such information.

23. Commissioner to determine application. At the time and place appointed the commissioner shall attend and hear the applicant and the objectors either personally or by their respective solicitors or agents, and any evidence adduced either by declaration or *vivâ voce* in support of the application and objections respectively, and may adjourn or postpone any such hearing, and shall at such hearing, or some adjournment or postponement thereof, either grant or in his discretion refuse the application for the patent.

24. Cost of application or objection. The commissioner may, by writing under his hand, order the applicant or any objector to pay to any objector or to the applicant such costs of and attending the application or objection as the commissioner shall think fit, and every such order may be made a rule of the Supreme Court.

25. Commissioner may refer to examiners. The commissioner

may at any time, if he shall think fit, refer any petition for a patent, whether opposed or not, to one or more competent person or persons to be appointed by him to examine and consider the matters stated in such petition, and to report thereon to the commissioner for his information ; and the applicant for such patent shall, prior to such reference, pay to the commissioner such sum not exceeding five pounds five shillings, as the commissioner shall in each case direct, such sum to be paid by the commissioner to the person or persons so appointed as aforesaid as a recompense for his or their trouble.

26. *Determination of commissioner final.* The determination of the commissioner upon any such application shall be final, but any applicant whose application has been refused may, on giving not less than four weeks' previous notice in the government Gazette of his intention so to do, make one or more fresh applications for a patent in respect of the same invention.

27. *When patent to issue.* When the commissioner has determined to grant a patent, he shall, upon payment of the proper fee, cause the same to be sealed and issued accordingly ; but except as hereinafter mentioned no patent shall be sealed after the expiration of the six months' term of protection conferred under this Act by reason of the filing of the petition and specification, nor unless the applicant shall pay the fee for the sealing of the patent within ten days after the commissioner has sent to the applicant notice of his intention to grant the same : Provided that where the sealing of any patent shall have been delayed by reason of opposition to the grant thereof, such patent may be sealed at such time as the commissioner shall direct.

28. *Patent may issue after prescribed time in certain cases.* When the sealing of the patent has been delayed from accident and not from the neglect or willful default of the applicant, then the patent may be sealed at such time not being more than one month after the expiration of the six months' term of protection hereinafter referred to as the Governor shall direct ; and where the applicant for the patent dies during the continuance of such protection, the patent may be granted to his executors or administrators during the continuance of such protection, or at any time within three months after the death of the applicant, notwithstanding the expiration of the term of such protection, and the patent so granted shall be of the like force and effect as if it had been granted to the applicant during the continuance of such protection.

29. *Patent to relate back to filing of petition.* Every patent to be issued in pursuance of this Act shall be signed and sealed and bear date as the day of the filing of the petition and specification as aforesaid, and shall be of the same force and validity as if it had been signed and sealed on the day of which it is expressed to be signed and sealed and bear date ; and after any patent shall have been signed and sealed, it shall not be necessary or material to inquire or ascertain whether any advertisement or notice directed by this Act shall have been published, given, or sent as herein directed.

PART IV.

EFFECT, CONDITIONS, AND EXTENSION OF PATENTS.

30. *Rights conferred by patent.* Every patent granted under this Act shall be in duplicate, and shall contain the title or name of the invention, with a reference to the specification, and shall be in the form in the schedule A. hereto, or as near thereto as the circumstances will permit, and shall, subject to the provisions of this Act and to all such restrictions, conditions, and provisos as the commissioner shall deem necessary or expedient, and shall insert in such patent, confer upon the patentee, his executors, administrators, and assigns, for the term of fourteen years, and for such further term, not exceeding seven years, as the Governor may grant under section 37 of this Act, the sole right of making, using, exercising, and vending such invention : Provided that no patent shall be construed to prohibit the subsequent use or sale of any article once lawfully obtained.

31. *Duplicate patent to be filed.* One duplicate part of every patent issued under this Act shall be delivered to the patentee or his agent, and the other duplicate part shall be filed in the patent-office.

32. *Prerogative of crown preserved.* Nothing herein contained shall extend to abridge or affect the prerogative of the Crown in relation to granting or withholding the grant of any patent or letters patent ; and it shall be lawful for the Governor to direct the commissioner to grant or withhold the grant of any patent or letters patent as aforesaid, or to direct the insertion in any patent issued under this Act of any restrictions, conditions, or provisos which the Governor may think fit, in addition to or in substitution for any restrictions, conditions, or provisos which would otherwise be inserted therein under this Act ; and it shall also be lawful for the Governor to direct any specification filed under this Act, and in

respect of the invention described in which no patent shall at the time of such direction have been granted, to be canceled, and thereupon the protection obtained by the filing of such specification shall cease.

33. *Conditions of patent.* All patents granted under this Act shall be made subject to the conditions that the same shall be void if at any time during the term thereby granted it shall appear that the grant of the patent was contrary to law or prejudicial or inconvenient to the general public, or that the said invention was not a new and useful art, machine, manufacture, or composition of matter, or a new and useful improvement on any art, machine, manufacture, or composition of matter, or that the said invention had been publicly used or offered for sale within the said province prior to the date of such patent, or that the patentee was not the true and first inventor of the patented invention; or if the patent shall have been granted to him as assignee, legatee, executor, or administrator, then that he was not the assignee, legatee, executor, or administrator, as the case may be, of the true and first inventor of the patented invention, or if the specification does not correctly and fully describe and ascertain the nature and principle of the invention, and in what manner it is to be made, used, worked or performed.

34. *Patent to cease on non-payment of fees.* All patents under this Act shall also be made subject to the condition that the same shall be void, and that the rights and privileges thereby granted shall cease and determine at the expiration of three years from the date thereof, unless the patentee, his executors, administrators, or assigns, shall pay at the patent-office the sum of five pounds before the expiration of such three years from the date thereof, and at the expiration of seven years from the date thereof, unless the patentee, his executors, administrators, or assigns, shall pay at the patent-office the sum of five pounds before the expiration of such seven years.

35. *Patented invention may be used in foreign vessels.* No patent for any invention granted after the passing of this Act shall extend to prevent the use of such invention in any foreign ship or vessel, or for the navigation of any foreign ship or vessel which may be in any port of South Australia or its dependencies, or in any of the waters within the jurisdiction of any of the courts of the said province, where such invention is not so used for the manufacture of any goods or commodities to be vended within or exported from the said province or its dependencies: Provided that

this enactment shall not extend to the ships or vessels of any foreign State of which the laws authorize subjects of such foreign State having patents or the like privileges for the exclusive use or exercise of inventions within its territories to prevent or interfere with the use of such inventions in British ships or vessels, or in or about the navigation of British ships or vessels while in the ports of such foreign State, or in the waters within the jurisdiction of its courts, where such inventions are not so used for the manufacture of goods or commodities to be vended within or exported from the territories of such foreign State.

36. *Government may use patented invention.* The Government may use any invention patented under this Act, paying to the patentee such sum for the use thereof as shall be agreed upon between the Government and the patentee, or, in case of dispute, such sum as may be fixed by two arbitrators, one of whom shall be appointed by the Government, and one by the patentee ; or, in case of disagreement between the arbitrators, by an umpire to be named by them before entering upon the consideration of the matter referred to them.

37. *Government may extend term of patent.* The Governor, on petition by any patentee, or his executors, administrators, or assigns, presented at least six months before the expiration of any patent, and on being satisfied that the patentee, his executors, administrators, or assigns, have been unable to obtain due remuneration for the expense and labor of perfecting the invention, the subject of the patent may, by order under his hand, to be filed in the patent-office, grant an extension of the term of such patent for any term not exceeding seven years from the expiration of the term for which the patent was originally granted : Provided that the Governor may require such petition to be advertised in such manner as he shall think fit, and may hear any person desirous of opposing such extension.

PART V.

NEW PATENTS, DISCLAIMERS, ALTERATIONS AND CONFIRMATIONS.

38. *When commissioner may grant new patent.* Whenever any patent shall be deemed defective or inoperative by reason of insufficient description or specification, or by reason of the patentee having claimed as new more than he had a right to claim, the commissioner may, upon petition by the patentee, and upon being satisfied

that the error arose from inadvertence, accident, or mistake, without any fraudulent intention, and upon the surrender of such patent and payment of the fee for that purpose specified in the schedule B. hereto, and the filing of an amended description and specification, to be filed in the like manner as hereinbefore provided with respect to applications for patents, grant to the patentee, his executors, administrators, or assigns, a new patent for the same invention, for any part or the whole of the then unexpired term for which the original patent was granted.

39. *Disclaimer or memorandum of alteration may be filed.*

Any patentee, his executors, administrators, or assigns, may, on payment of the fee for that purpose specified in the schedule B. to this Act, and on obtaining the leave of the commissioner, file in the patent office a disclaimer of any part, either of the title or the specification of the invention in respect of which he is the patentee, or the executor, administrator, or assignee of the patentee, stating the reasons for such disclaimer, or a memorandum of any alteration in such title or specification, not being such disclaimer or alteration as shall extend the exclusive right granted by the patent. Such disclaimer or memorandum of alteration shall be attached to the patent or specification filed in the patent-office, and a memorandum thereof shall be entered upon the patent in possession of the patentee, his executors, administrators, or assigns, and thereupon such disclaimer or memorandum of alteration shall be deemed and taken to be part of the patent or specification in all courts in the said province: Provided that no such disclaimer or alteration shall, except, in proceedings by scire facias, be receivable in evidence to support any patent in any action or suit pending at the time that such disclaimer or alteration was filed, or brought in respect of any infringement of any patent committed prior to the filing of such disclaimer or memorandum of alteration; but in every such action or suit, except as aforesaid, the original title and specification alone shall be given in evidence, and deemed to be the title and specification of the invention for which the patent shall have been granted.

40. *Commissioner may require notices to be given.* The commissioner may require any patentee, his executors, administrators, or assigns, applying for a new patent, or for leave to file a disclaimer or memorandum of alteration, to give such notices by advertisement or otherwise of his application as the commissioner shall think fit, and may hear any person in opposition to such

application. The filing of any disclaimer or memorandum of alteration in pursuance of the leave of the commissioner obtained under the last preceding section shall, except in cases of fraud, be conclusive as to the right of the party to file such disclaimer or memorandum of alteration under this Act, and no objection shall be made in any proceeding upon or touching such patent, specification, disclaimer, or memorandum of alteration on the ground that the party filing such disclaimer or memorandum of alteration had not sufficient authority in that behalf.

41. *Mode of obtaining confirmation of invalid patent.* If in any suit or action it shall be proved, or specially found by the verdict of a jury, that any person who shall have obtained a patent for any invention or supposed invention was not the first inventor thereof, or of some part thereof, by reason of some other person having invented the same, or some part thereof, before the date of such patent, or if such patentee, his executors, administrators, or assigns, shall discover that some other person had unknown to such patentee invented the same, or some part thereof, before the date of such patent, such patentee, his executors, administrators, or assigns, may petition the Governor to confirm the said patent, or to grant a new patent in respect of such invention; and it shall be lawful for the Governor to refer the consideration of the said petition to commissioners to be appointed for that purpose in the manner hereinafter mentioned.

42. *Appointment of commissioners.* The Governor may issue to three or more persons, of whom one shall be a judge of the Supreme Court, a commission reciting such petition, and requiring and authorizing such persons, or any three of them, of whom the said judge shall be one, to meet at some time, not being less than two months from the publication of the said commission in the government Gazette, and at some place to be respectively fixed in the said commission, and then and there to consider the said petition, and to report to the Governor whether such confirmation should or should not be made.

43. *Notice of commission published; caveat.* Six weeks at least before the time named in the said commission for the consideration of any such petition as aforesaid, the petitioner shall cause to be published twice in the government Gazette, and three times in some daily newspaper published in Adelaide, an advertisement of the contents of the said commission; and any person having an interest in opposing the said petition shall be at liberty to enter a

caveat against the same at the office of the commissioner of patents at any time not being less than one week before the time named in the said commission for the execution thereof.

44. *Commissioners to hear all parties and report.* At the time and place fixed in the said commission for that purpose, the commissioners shall meet and proceed to consider such petition, and the petitioner shall be heard in person, or by his solicitor or agent, and may call witnesses to prove his case as stated in such petition, and the publication of the last mentioned advertisement as required by this Act; and the persons entering caveats shall likewise be heard in person, or by their solicitors or agents, and may also call witnesses; and all witnesses shall be examined upon oath or affirmation (which oath or affirmation such commissioners as aforesaid are hereby authorized and required to administer); and thereupon, and upon hearing and inquiry of the whole matter, such commissioners, upon being satisfied that such patentee as aforesaid believed himself to be the first and original inventor, and being satisfied that the invention, or part thereof, has not been publicly and generally used, or offered for sale within the said province prior to the date of such patent, may report to the Governor their opinion that the prayer of such petition ought to be complied with; whereupon the Governor may, if he shall think fit, grant such prayer; and the confirmed or new patent (as the case may be) shall thereupon be available at law and in equity to give to such petitioner the sole right of making, using, exercising, and vending such invention as against all persons whomsoever, anything hereinbefore contained to the contrary notwithstanding: Provided that any person party to any former suit or action touching the first patent shall be entitled to have notice in writing of the time and place fixed as aforesaid for the first meeting of the said commissioners to consider the said petition; and after any such report shall have been made it shall not be material or necessary to inquire or ascertain whether any such advertisement as last aforesaid has or has not been published, or whether any such notice as last aforesaid has or has not been given in the manner hereinbefore directed.

45. *Where patent only partly assigned.* When a patentee, his executors, administrators, or assigns, shall have assigned a part only of his or their interest in any patent, no petition or application under any of the preceding sections numbered respectively 37, 38, 39, and 41, shall be allowed unless joined in by all persons having any legal interest in the patent.

PART VI.

CAVEATS AND REVOCATION AND ASSIGNMENT OF PATENTS.

46. *Caveat may be filed.* Any intending applicant for a patent may file in the patent-office, on payment of the fee specified for that purpose in the schedule B. hereto, a document to be signed by him and containing a description of any invention claimed by him as his own (with or without plans at his option), and giving an address within the City of Adelaide to which any notice by the next following clause required to be sent to him may be addressed; such document, which shall be called a caveat, may be amended by the caveator, at any time within one year from the filing thereof, and shall, until the expiration of such year, be preserved in secrecy in the patent-office, the commissioner being at liberty, however, to furnish copies of the same to the caveator on payment of the proper charges for such copies.

47. *In certain cases commissioner to send notice.* If at any time before the expiration of one year from the filing of any caveat an application shall be made by any person other than the caveator for a patent for any invention, and the commissioner shall consider that the granting of such application may interfere with or affect the right of the caveator to obtain a patent for the invention described in the caveat, the commissioner shall forthwith send notice thereof through the general post-office to the caveator at the address given by him for that purpose.

48. *Patent may be revoked by governor.* Every patent shall be liable to be revoked by the Governor upon the application of any person after the expiration of three years from the granting thereof, if it shall be made to appear to the Governor that neither the patentee nor his assignee or licensee has, before the time of such application, used the patented invention to a reasonable extent for the public benefit: Provided that the Governor may in his absolute discretion refuse any such application upon such terms and conditions as he may see fit.

49. *Proceedings to revoke patent.* The Supreme Court of the said province shall have jurisdiction to revoke and cancel any patent issued under this Act, upon a writ of scire facias, issued out of the said court; and in case any person having an interest in such patent shall not reside in the said province at the time of the issue of such writ, it shall be sufficient as against such person to file such

writ in the office of the Supreme Court, and serve notice of such filing at his last known place of business or residence within the said province (if any), and if no such place can be found, then to give notice of such filing by advertisement, or otherwise, as the said court may in each case direct.

50. *Patent may be filed in the Supreme Court.* Any person desiring to impeach a patent issued under this Act may obtain from the patent-office a copy of the patent, and of the petition, declaration, specification, and drawings thereunto relating, certified under the seal of the patent-office and the hand of the commissioner, and may file the same in the office of the said Supreme Court to be held of record therein.

51. *Certificate of judgment to be filed.* A certificate of the judgment voiding any patent shall be filed in the patent-office by the prosecutor on the writ of scire facias, and shall be noted on the duplicate patent in the patent-office, and thereupon the patent shall be and be held to have been void and of no effect from the time of the grant thereof.

52. *Assignment of patent.* Every patent shall be assignable either as to the whole interest of the patentee, his executors, administrators, or assigns, or as to any part of such interest by instrument in writing under the hand of the assignor or his agent thereunto authorized in writing; and every such assignment shall be in duplicate, and shall be registered by deposit of one duplicate part in the patent-office. Every assignment shall be deemed null and void against any subsequent assignment for valuable consideration, unless such prior assignment shall be registered before the registration of the subsequent assignment.

PART VII.

MISCELLANEOUS PROVISIONS.

53. *Patents, &c., to be open to public inspection.* All patents, specifications, drawings, models, disclaimers, and other papers, except caveats, filed in the patent-office, shall be open to the inspection of the public, subject to such regulations as the Governor may make in that behalf.

54. *Fees.* The fees mentioned in schedule B. to this Act shall be paid in respect of the several matters and things therein respectively referred to. Such fees shall form part of the general revenue

of the said province, and be paid, applied, and disposed of accordingly.

55. *Commissioner may correct clerical errors.* No patent or other instrument under this Act shall be invalidated by any clerical error in the framing or copying thereof, but any such error may be corrected by or under the authority of the commissioner.

56. *Lost patent.* In case any patent be lost or destroyed, any person entitled to such patent may obtain from the patent-office, on payment of the proper fee, a copy of such lost or destroyed patent, to be certified under the seal of the patent-office.

57. *Declarations, before whom to be made.* Every declaration under this Act may be made before the commissioner or any justice of the peace or notary public in South Australia; or if the declaration shall be made out of the said province, then before any person who, in the country in which the declaration is made, shall be authorized to administer an oath.

58. *Licensed patent agents.* It shall be lawful for the commissioner, with the sanction of the Governor, to license fit and proper persons to be patent agents for transacting business under the provisions of this Act, and upon proof to his satisfaction of the malfeasance or incapacity of any such licensed patent agent, or on non-payment of any annual fee for any such license, as prescribed by schedule B. hereto, and with such sanction as aforesaid, to revoke any such license. Before granting any such license the commissioner shall receive bond from the person to be licensed in the sum of five hundred pounds, with two sureties each in the sum of two hundred and fifty pounds, conditioned that such person shall duly and faithfully act in the capacity of a licensed patent agent, in accordance with the provisions of this Act, and shall also administer to such person the oath following:—

I, A. B., do solemnly swear that I will faithfully and to the best of my ability execute and perform all such business or duties as may be entrusted to or imposed upon me as a licensed patent agent. So help me God.

59. *Certificate of correctness; false and negligent certificate.* The commissioner shall not receive any petition, disclaimer, memorandum of alteration, caveat, assignment, or other instrument under this Act, unless there shall be indorsed thereon a certificate that the same is correct for the purposes of this Act, signed by the applicant or the principal party filing such instrument, or by his solicitor, or by a patent agent licensed under this Act, or by a land broker lic-

ensed under the provisions of the "Real Property Act of 1861," or any Act substituted therefor ; and any person who shall falsely and negligently certify to the correctness or any such instrument shall incur a penalty therefor not exceeding fifty pounds, to be recovered by any person before two or more justices of the peace in a summary manner.

60. *In actions for infringements; particulars of breaches and objections.* In any action for the infringement of a patent the plaintiff shall deliver with his declaration particulars of the breaches complained of in the said action, and the defendant on pleading thereto shall deliver with his pleas, and the prosecutor in any proceedings by scire facias to revoke and cancel any patent shall deliver with his declaration, particulars of any objections on which he means to rely at the trial in support of the pleas in the said action, or of the suggestions of the said declaration in the proceedings by scire facias respectively ; and at the trial of such action or proceeding by scire facias no evidence shall be allowed to be given in support of any alleged infringement, or of any objection impeaching the validity of such patent, which shall not be contained in the particulars delivered as aforesaid : Provided always, that the place or places at or in which and in what manner the invention is alleged to have been used or offered for sale in the said province prior to the date of the patent shall be stated in such particulars : Provided also, that it shall and may be lawful for any judge at chambers to allow such plaintiff, or defendant, or prosecutor, respectively, to amend the particulars delivered as aforesaid upon such terms as to such judge shall seem fit : Provided also, that at the trial of any proceedings by scire facias to revoke and cancel a patent the defendant shall be entitled to begin and to give evidence in support of such patent ; and in case evidence shall be adduced on the part of the prosecutor impeaching the validity of such patent the defendant shall be entitled to the reply.

61. *Particulars to be regarded in taxing costs.* In taxing the costs in any action commenced after the passing of this Act for infringing any patent, regard shall be had to the part of such case which has been proved at the trial, which shall be certified by the judge before whom the case shall be tried, and the costs of each part of the case shall be given according as either party has succeeded or failed therein, regard being had to the particulars of objections and breaches as well as the counts in the declaration, and the plaintiff and defendant respectively shall not be allowed any

costs in respect of any particular unless certified by the judge before whom the trial was had to have been proved by such plaintiff or defendant respectively, without regard to the general costs of the cause ; and it shall be lawful for the judge before whom any such action shall be tried to certify on the record that the validity of the patent in the declaration mentioned came in question ; and the record with such certificate being given in evidence in any suit or action for infringing the said patent, or in any proceeding by scire facias to revoke and cancel the patent, shall entitle the plaintiff in any such suit or action, or the defendant in any such proceeding by scire facias, on obtaining a decree, decretal order, or final judgment, to his full costs, charges, and expenses, to be taxed as between attorney and client, unless the judge making such decree or order, or the judge trying such action or proceeding, shall certify that the plaintiff or defendant respectively ought not to have such full costs.

62. Register of Patents. There shall be kept at the patent-office a book or books to be called the "Register of Patents," wherein shall be entered and recorded, in chronological order, all patents granted under this Act, the deposit and filing of specifications, disclaimers, and memoranda of alterations filed in respect of patents, all amendments in specifications and patents, all assignments, confirmations, and extensions of patents, the expiry, determination, vacating, revoking, or canceling of patents, with the dates thereof respectively, and all other matters and things affecting the validity of patents as the Governor may direct ; and such register or a copy thereof shall be open at all convenient times to the inspection of the public, subject to such regulations as the Governor may make in that behalf.

63. Register of Proprietors to be kept. There shall also be kept at the patent-office a book or books entitled "The Register of Proprietors," wherein shall be entered every assignment of a patent, or of any share or interest therein, every license under a patent, and the place or district to which such license relates, with the name or names of every person having by assignment any patent, or any share or interest in any patent, or, having any license, the date of his or their acquiring such patent, share, interest, or license, and any other matter or thing relating to or affecting the proprietorship in such patent or license ; and a copy of any entry in such book, certified under the seal of the patent-office, shall be given to any person requiring the same, and shall be *prima facie* evidence of the

proprietorship or assignment of such patent, or share or interest therein, or license as therein expressed : Provided always, that until such entry shall have been made the grantee or grantees of the patent shall be deemed and taken to be the sole and exclusive proprietor or proprietors of such patent, and of all the licenses and privileges thereby given and granted, and such register, or a copy thereof, shall be open to public inspection, subject to such regulations as the Governor may make.

64. *Expungement, &c., of entries in Register.* If any person shall deem himself aggrieved by any entry made under color of this Act in any such register as aforesaid, he may apply to the Supreme Court, or any judge thereof, for an order that such entry may be expunged, vacated, or varied, and such court or judge may thereupon make such order as to the expunging, vacating, or varying of such entry, and as to the costs of such application, as to such court or judge shall seem fit; and the officer having the custody of such register shall, on the production of any such order, expunge, vacate, or vary such entry in accordance with the order.

65. *Falsification or forgery of entry.* If any person shall willfully make or cause to be made any false entry in any such register, or shall willfully make or forge, or cause to be made or forged, any writing falsely purporting to be a copy of any entry in any such register, or shall produce or tender, or cause to be produced or tendered in evidence, any such writing or any such false entry, knowing the same to be false or forged, he shall be guilty of a misdemeanor, and shall be liable to be imprisoned for any term not exceeding five years.

66. *Punishment on false oath or declaration.* Every person who shall make any false oath or declaration under this Act shall be guilty of a misdemeanor, and shall on conviction be liable to imprisonment, with or without hard labor for any period not exceeding five years.

67. *Penalty for unauthorized use of name of patentee, &c.* If any person shall write, paint, print, mould, cast, carve, engrave, stamp, or otherwise mark upon anything made, used, or sold by him, for which he has not or shall not have obtained a patent, the name or any imitation of the name of any other person who has or shall have obtained a patent for such thing without leave in writing of such patentee, his executors, administrators, or assigns, or if any person shall, upon such thing not having been purchased from the patentee, his executors, administrators, or assigns, or some per-

son who purchased it from or under such patentee, his executors, administrators, or assigns, or not having had the license or consent in writing of such patentee, his executors, administrators or assigns, write, paint, print, mould, cast, carve, engrave, stamp, or otherwise mark the word "patent," the words "letters patent," or the words "By the Queen's patent," or any words of the like kind, meaning, or import, with a view of imitating or counterfeiting the stamp, mark, or other device of the patentee, his executors, administrators, or assigns, or shall in any other manner imitate or counterfeit the stamp, mark, or other device of the patentee, his executors, administrators, or assigns, he shall for every such offense forfeit and pay the sum of one hundred pounds, one half to Her Majesty, her heirs and successors, and the other half with full costs of suit to any person who shall sue for the said penalty, by action of debt, or in a summary manner before any two justices of the peace of the said province: Provided always, that nothing herein contained shall be construed to extend to subject any person to any penalty in respect of stamping or in any way marking the word "patent" upon anything in respect of which the patent before obtained shall have expired or otherwise determined.

68. *Proceedings before justices.* The proceedings before justices shall be conducted as appointed by and shall be regulated under the Ordinance No. 6 of 1850, entitled "An Ordinance to facilitate the performance of the duties of Justices of the Peace out of Sessions with respect to summary convictions and orders."

69. *Non-payment of penalty.* In every case of the adjudication of a fine or pecuniary penalty or amends under this Act, and of the non-payment of such fine or pecuniary penalty or amends, any justice of the peace may commit the offender or person making default in payment to any jail in the said province for any time not exceeding three calendar months, the imprisonment to cease on payment of the sum and costs due; but this section shall not affect any remedy for the recovery of any fine or pecuniary penalty or amounts under the said Ordinance No. 6 of 1850, or any other ordinance or Act.

70. *Appeal.* There shall be an appeal from any order of justices of the peace made under the provisions hereinbefore contained, or from any order of justices of the peace dismissing any information laid under this Act, or from any conviction by justices for any offense against this Act, which appeal shall be to the local court of Adelaide of full jurisdiction only, and the proceedings in such

appeal shall be conducted in manner appointed by the said Ordinance No. 6 of 1850 for Appeals to Local Courts, but the local court of Adelaide aforesaid may make such order as to payment of costs of appeal as such court shall think fit, although such costs may exceed ten pounds.

71. *Local court may state a case for Supreme Court.* It shall be lawful for the local court of Adelaide, upon the hearing of any appeal under the last preceding section, to state one or more special case or cases for the opinion of the Supreme Court and the Supreme Court shall hear and decide such special case or cases according to the practice of the Supreme Court on special cases; and the Supreme Court shall make such order as to the costs of any such special case as to the said court shall appear just; and any two or more justices, or the local court of Adelaide, shall make an order in respect of the matters referred to the Supreme Court, in conformity with the certificate of the said Supreme Court, or of any judge thereof, which order of the justices of the peace or local court shall be enforced in manner provided by this Act for the enforcement of orders of justices of the peace; and, save as herein provided, no order or proceeding of justices or of any local court made under the authority of this Act, shall be appealed against or removed by certiorari or otherwise into the Supreme Court of the said province.

72. *Definition clause.* In the construction of this Act the following expressions shall have the meanings hereby assigned to them unless such meaning shall be repugnant to or inconsistent with the context: "patent" shall mean letters patent granted under this Act; "patentee" shall mean a person to whom a patent shall have been granted under this Act; "commissioner" shall mean the commissioner of patents.

SCHEDULE A.

VICTORIA, by the grace of God, of the United Kingdom of Great Britain and Ireland Queen, Defender of the Faith, to all to whom these presents shall come, greeting:

Whereas _____, of _____, hath, by his petition, represented unto us that he is [or _____, of _____, is or was] the true and first inventor of a certain invention for _____, and that the same has not been publicly used or offered for sale within the province of South Australia more than twelve months prior to the date of the said petition [and that the said _____ is the assignee, legatee, executor, or administrator,

as the case may be, of the said], and hath, therefore, humbly prayed for letters patent for the sole making, using, exercising, and vending of the said invention within our said province for the term of fourteen years, pursuant to "The Patent Act, 1877:" And whereas the said hath correctly and fully described and ascertained the nature and principle of the said invention, and in what manner the same is to be made, used, worked, or performed, by a specification in writing under his hand, and has caused the same to be duly filed in the patent office of our said province on the day of , 18 : And We, being willing to give encouragement to all arts and inventions which may be for the public good, are graciously pleased to condescend to the petitioner's request: Know ye, therefore, that we of our especial grace, certain knowledge, and mere motion, have given and granted, and by these presents for us, our heirs and successors, do give and grant unto the said , his executors, administrators, and assigns, our special license, full power, sole privilege, and authority, that he, the said , his executors, administrators, and assigns, and every of them, by himself and themselves, or by his and their deputy or deputies, servants or agents, or such others as the said , his executors, administrators, or assigns, shall at any time agree with, and no others, from time to time, and at all times hereafter during the term of years herein expressed, shall and lawfully may make, use, exercise, and vend his said invention within our said province, in such manner as to him, the said , his executors, administrators, and assigns, or any of them, shall in his or their discretion seem meet; and that he, the said , his executors, administrators, and assigns, shall and lawfully may have and enjoy the whole profit, benefit, commodity, and advantage from time to time coming, growing, accruing, and arising by reason of the said invention for and during the term of years herein mentioned, to have, hold, exercise, and enjoy the said licenses, powers, privileges, and advantages herein before granted or mentioned to be granted to the said , his executors, administrators, and assigns, for and during and unto the full end and term of fourteen years from the day of , A. D. , according to the statute in such case made and provided; and to the end that he, the said , his executors, administrators, and assigns, and every of them, may have and enjoy the full benefit and sole use and exercise of the said invention, according to our gracious intention hereinbefore declared, we do by these presents for us, our heirs and successors, require and strictly command all and every person and persons, bodies politic and corporate, and all other our subjects whatsoever, of what estate, quality, degree, name, or condition soever they be, within our said province, that neither they nor any of them, at any time during the continuance of the said term of fourteen years hereby granted, either directly or indirectly, do make, use, exercise, or vend the said invention, or any part of the same, so attained unto by the said as aforesaid, nor in anywise counterfeit, imitate, or resemble the same, nor make or cause to be made any addition thereunto, or subtraction from the same, whereby to pretend himself or themselves the inventor or inventors, deviser or devisers thereof, without the consent, license, or agreement of the said , his executors, administrators, or assigns, in writing under his or their hands or seals first had and obtained in that behalf, upon such pains and penalties as can or may be justly inflicted on such offenders for their contempt of this our royal command, and further to be answerable to the said , his executors, administrators, and assigns, according to law for his and their damages thereby occasioned: And, moreover, we do by these presents, for us, our heirs and successors, will and command all and singular the justices of the peace, sheriffs, bail-

iffs, constables, and all other officers and ministers of us, our heirs and successors for the time being, that they or any of them do not nor shall at any time during the said term hereby granted in anywise molest, trouble, or hinder the said , his executors, administrators, and assigns, or any of them, or his or their deputies, servants, or agents, in or about the due and lawful use or exercise of the aforesaid invention, or anything relating thereto: Provided always, and these our letters patent are and shall be upon this condition, that if at any time during the said term hereby granted it shall appear that this our grant is contrary to law, or prejudicial or inconvenient to the general public, or that the said invention is not a new and useful art, machine, manufacture, or composition of matter, or a new and useful improvement on any art, machine, manufacture, or composition of matter, or that the said invention has been publicly used or offered for sale within our said province prior to the date of these our letters patent, or that the said petitioner is not the true and first inventor thereof [or the assignee, legatee, executor, or administrator, *as the case may be*, of the true and first inventor thereof], or if the said specification, filed as aforesaid, does not correctly and fully describe and ascertain the nature and principle of the said invention, and in what manner the same is to be made, used, worked, or performed, or if the said , his executors, administrators, or assigns, shall not supply or caused to be supplied for our service all such articles of the said invention as he or they shall be required to supply by the officers or commissioners administering the department of our service, for the use of which the same shall be required, in such manner, at such times, and at or upon such reasonable prices and terms as shall be settled for that purpose by the said officers or commissioners requiring the same, then and in any of the said cases these our letters patent shall forthwith cease, determine, and be utterly void to all intents and purposes, anything hereinbefore contained to the contrary thereof in anywise notwithstanding: Provide also, that these our letters patent or anything herein contained, shall not extend or be construed to extend to give privilege unto the said , his executors, administrators, and assigns, or any of them, to use or imitate any invention or work whatsoever which hath heretofore been found out or invented by any other of our subjects whatsoever, and publicly used or exercised, unto whom our like letters patent or privileges have been already granted for the sole use, exercise, and benefit thereof, it being our will and pleasure that the said , his executors, administrators, and assigns, and all and every other person and persons to whom like letters patent or privileges have been already granted as aforesaid, shall distinctly use and practice their several inventions by them invented and found out according to the true intent and meaning of the same respective letters patent, and of these presents: Provided likewise, and these our letters patent are upon this express condition, that the same shall be void, and that the rights and privileges hereby granted shall cease and determine at the expiration of three years from the date hereof, unless the said , his executors, administrators, or assigns, shall pay at the said patent-office the sum of five pounds before the day of , A. D. 18 and further upon condition that the same letters patent shall be void, and the said rights and privileges cease and determine at the expiration of seven years from the date hereof, unless the said , his executors, administrators, or assigns, shall pay at the said patent-office the sum of five pounds before the day of , A. D. 18 : Provided that nothing herein contained shall prevent the granting of licenses in the manner and for the considerations in and for which they may by law be granted; and lastly we do by these presents for us, our heirs and successors, grant

unto the said _____, his executors, administrators, and assigns, that these our letters patent or the filing thereof shall be in and by all things good, firm, valid, sufficient, and effectual in the law, according to the true intent and meaning thereof, and shall be taken, construed, and adjudged in the most favorable and beneficial sense, for the best advantage of the said _____, his executors, administrators, and assigns, as well in all our courts of record as elsewhere, and by all and singular the officers and ministers whatsoever of us, our heirs and successors, in this our said province, and amongst all and every the subjects of our heirs and successors, whatsoever and where-soever. In witness whereof we have caused these our letters patent to be made patent this _____ day of _____, A.D. _____, and to be sealed with the seal of the said patent-office, and bear date as of the said _____ day of _____, A.D., in the _____ year of our reign.

SCHEDULE B.

(As Amended by Act of 1881.)

Fees to be paid in respect of the several matters hereunder specified:—

	£	s.	d.
On filing every petition.....	2	10	0
On grant of patent.....	1	1	0
On every patent before the expiration of three years from its date.....	2	10	0
And before the expiration of seven years.....	2	10	0
For taking any declaration.....	0	8	6
For every certificate of filing.....	0	2	6
On filing every amended or substituted specification.....	1	0	0
On lodging objections against grant of patent.....	0	10	6
On every summons to witnesses....	0	5	0
On hearing of every opposed application.....	1	0	0
On filing duplicate patent.....	0	5	0
On extention of patent.....	20	0	0
On granting new patent under Part V.....	10	0	0
On filing every disclaimer or memorandum of alteration.....	2	10	0
On confirmation of invalid patent.....	50	0	0
On filing caveat under part VI.....	1	0	0
On amending any caveat.....	0	10	6
For every office copy (including the seal) per folio of 72 words.....	0	0	6
On filing every certificate voiding a patent.....	0	5	0
On deposit of any assignment of patent.....	1	0	0
On every search, including inspection.....	0	2	6
Annual fee for license to patent agent.....	5	0	0

From *Carpman. Pat. Law of World*, 466.

An Act to amend "The Patent Act, 1877." No. 201, 1881.

Preamble. Whereas it is desirable to amend "The Patent Act, 1877," by affording greater facilities for the obtaining of patents—Be it therefore enacted by the Governor of the Province of South Australia, with the advice and consent of the Legislative Council and House of Assembly of the said province, in this present Parliament assembled, as follows :

1. *Short title.* This Act may be for all purposes cited as "The Patent Act Amendment Act, 1881."

2. *Incorporation.* This Act and "The Patent Act, 1877," except so far as the same is altered by this Act, shall be incorporated and read and construed together.

3. *Petition for patent.* Every petition for a patent shall be addressed to the commissioner, and shall be accompanied by a declaration by the applicant, or his duly authorized attorney or agent, that the several allegations contained in the petition are true, and stating that the person making the declaration verily believes that the inventor mentioned in the petition is the true and first inventor of the invention for which the patent is sought.

4. *Requisites of specifications.* For the purposes of section 16 of the said Act, it shall be sufficient, whether the inventor be alive or not, if the specification therein mentioned be signed by the applicant, or his duly authorized attorney or agent, and if such signature be attested as provided in the said section.

5. *Exhibition not ground for refusing patent.* The mere fact of any inventor having exhibited or tested his invention, either publicly or privately, shall not in itself be deemed any ground for refusing him a patent, or justify any other person in using such invention, provided that such exhibiting must have been within six months of the date of the inventor filing his petition for a patent.

6. *Schedule of fees.* The fees mentioned in the schedule of this Act shall be paid in respect to the several matters and things therein respectively referred to, in lieu of the fees mentioned in schedule B of the Patent Act, 1877. Such fees shall form part of the general revenue of the said province, and be paid, applied, and disposed of accordingly. [NOTE.—See end of 1877 Act.]

7. *Repeal.* Section 14 of the said Act is hereby repealed.

From *Carym. Pat. L. of World*, 493.

See also AUSTRALASIA.

SPAIN.

*Law of July 30, 1878.**

SECTION I.

GENERAL PROVISIONS.

ARTICLE 1. Every Spaniard or foreigner who intends to establish or has established in the Spanish dominions a new branch of industry shall have the exclusive right to work the same during a certain number of years, subject to the rules and conditions laid down by the present law.

ART. 2. The right referred to in the preceding article shall be acquired by obtaining from the Government a patent of invention.

ART. 3. The following objects shall be patentable:—

Machinery, apparatus, instruments, processes, or mechanical or chemical operations, being entirely or partly a new and original (*i. e.*, the applicant's own) invention, or which, without fulfilling these conditions, have not been established or executed in the same way or form in the Spanish dominions.

New industrial products or results [obtained by new or known means, provided their working tends to establish a new industry in the country.

ART. 4. Patents having for their objects products or results mentioned in the second paragraph of the previous article shall not prevent other patentees of objects mentioned in the first paragraph from obtaining the same products or results.

ART. 5. Objects which are not known, nor have been executed, or worked in the Spanish dominions or abroad, shall be considered as new according to article 3 of this law.

ART. 6. The right which is conferred by the patent of invention, or as the case may be, the right derived from the application, can be transferred entirely or partly by the various ways established by our laws relating to private property.

ART. 7. A patent of invention can be granted to one person or to several, or to a society, whether they be natives or foreigners.

* Another translation of this law, differing slightly from that given in the text, may be found in 26 Pat. Off. Gaz. 108.

ART. 8. All patents shall be considered as granted, not only for the Peninsula and adjacent islands, but also for the provinces beyond the sea.

ART. 9. The following shall not be the objects of patents:—

(1.) The result or product of the machines, apparatus, instruments, processes or operations mentioned in the first paragraph of article 3, unless they are contained in the second paragraph of the same article.

(2.) The use of natural products.

(3.) Scientific principles or discoveries, so far as they are of a mere speculative nature, and are not likely to be applicable to machinery, apparatus, instruments, processes, or mechanical or chemical operations of a practical industrial nature.

(4.) Pharmaceutical or medical preparations of all sorts.

(5.) Schemes or combinations of credit or finance.

ART. 10. No patent shall be delivered for more than one object of industry.

ART. 11. Patents of invention shall be delivered without previous examination as to novelty or utility, and must not therefore be considered in any case as a declaration or certificate of the novelty or utility of the object to which they refer. Qualifications of this nature concern the person interested, who must act on his own responsibility, and will be subject to the consequences resulting from the provisions of the present law.

SECTION II.

THE DURATION OF PATENTS AND THE GOVERNMENT FEES.

ART. 12. The duration of patents of invention shall be twenty years without prolongation, if they have for their object new and original inventions. The duration of patents for all objects that are not original inventions, or being so, are not new, shall only be five years without prolongation.

Nevertheless, patents shall be granted for ten years for all original inventions, even when the inventor has obtained a patent for the same object in one or more foreign countries, provided he applies therefor in Spain before the expiration of two years from the obtaining of the first foreign patent.

ART. 13. For working a patent there must be paid in Government paper an annual and progressive tax, as follows:—10 pesetas for the first year, 20 pesetas for the second year, 30 pesetas for the

third year, and so on to the fifth, tenth, or twentieth year, when the tax will be respectively 50, 100, and 200 pesetas.

ART. 14. The annual taxes mentioned in the previous article shall be paid in advance, and they will in no case be dispensed with.

SECTION III.

FORMALITIES FOR THE GRANT OF PATENTS.

ART. 15. Every person who desires to obtain a patent shall deliver at the office of the secretary of the civil government of the province in which he is domiciled, or at that of any other province where he elects domicile for this purpose :—

(1.) A petition to the minister of commerce, in which he indicates a single object for the patent, stating whether the said object is a new and original invention, or not, and the domicile of the applicant, or his attorney. In the latter case the power must be annexed to the petition. It must contain neither conditions, restrictions, nor reservations.

(2.) A specification in duplicate, in which shall be described the machine, apparatus, instrument, process, or mechanical or chemical operation forming the object of the patent, all with the greatest possible clearness, so that there can at no time be the least doubt as to the object or the particular represented to be a new and original invention, or as to its not having been practiced or established in the same mode or form in Spain. At the foot of the specification there must be a note expressing clearly, distinctly, and particularly which part, piece, movement, mechanism, operation, process, or matter is claimed as the object of the patent. The patent will depend entirely on the contents of the said note.

The specification must be written in Spanish, without abbreviations, corrections, or erasures of any kind, on sheets folded and numbered. References to weights and measures must be given according to the metrical decimal system.

The specification must not contain conditions, restrictions, or reservations.

(3.) The drawings, samples, or models which the interested party thinks necessary for the comprehension of the descriptive specification, all in duplicate.

The drawings must be made on cloth-paper in ink, and according to the metrical decimal scale.

(4.) The receipt for the payment to the State of the first annual tax.

(5.) A signed list of all the documents and objects presented, which latter must also be signed by the applicant or his attorney.

ART. 16. The secretary of the civil government upon receiving the documents and objects mentioned in the preceding article, shall enter, in a special register, the day, the hour, and the minute of the presentation ; sign the list jointly with the interested party or his representative, and deliver a proper receipt. The same secretary shall close and seal the box or packet containing the two copies of the specification, and of the drawings, samples, or models, and write underneath the inscription on the box or packet "Presented on such a month, day, hour, and minute," signing the same, and affixing the official seal.

The entry in the register of presentation indicating the day, hour, and minute of presentation shall establish the right of priority of the applicant.

ART. 17. Within a term not exceeding five days from the date of the presentation of the application, and of the aforesaid documents and objects, the civil governor shall remit to the director of the Conservatory of Arts at Madrid the application, together with the documents and objects, also a certificate of the secretary, countersigned by the governor, of the entry in the register, and the contents of the box or packet. The cost of remittance shall be borne by the interested party.

ART. 18. The secretary of the Conservatory of Arts shall examine the contents of the box or packet, and shall sign and seal, at the foot of the certificate mentioned in the preceding article, a statement as to their completeness or defects.

ART. 19. The secretary of the conservatory shall at once compare the two copies of the specification and drawings or models for the sole purpose of satisfying himself of their identity, and having found them consistent and that the specification has written at the end the note mentioned in the second paragraph of article 16 (*query 15?*), he shall sign and seal both copies, in proof of the compliance with this formality.

If he discovers any defects in the documents, he shall point them out in his dispatch, and they must be corrected by the interested parties themselves, or their attorneys ; for which purpose they shall be allowed a term of two months, counting from the day of the presentation of the petition to the government of the province,

if it is in the Peninsula or the adjacent islands, and of four months if in the Canaries or Antilles, and of eight months for the Philippine Islands.

These terms cannot be prolonged, and when once expired without the defects pointed out having been amended, such application shall not proceed, and the petition for the patent shall be considered as of no effect.

ART. 20. When the requirements mentioned in two preceding article have been observed, the director of the Conservatory of Arts, bearing in mind the provisions of article 11, shall send the petition to the minister of commerce, together with a report stating—

(1.) Whether the form of the petition is in conformity with the provisions of article 15.

(2.) Whether the specification and the above-mentioned drawings, samples and models, all in duplicate, and the receipt for the government tax for the first year, have been delivered.

(3.) Whether there is perfect conformity between the duplicates of the specifications, drawings, samples or models and the originals.

(4.) Whether the object of the patent is comprised among one of the cases of article 9.

(5.) Whether, taking all circumstances into consideration, it is advisable to grant or refuse the petition.

ART. 21. If the application results favorably, the minister of commerce shall inform the director of the Conservatory of Arts thereof, who shall publish this decision by means of the Madrid Gazette ; and within a term, which cannot be prolonged, of one month from the date of publication, the interested party or his representative shall appear at the Conservatory or Arts to pay in Government paper the value of the stamp, which must be put on the patent document. Should this not be done within the prescribed term, the proceedings shall be stayed and the petition for the patent shall be considered as of no effect.

ART. 22. When the payment mentioned in the preceding article has been made, the director of the Conservatory of Arts shall inform the minister of commerce thereof, who shall immediately issue the patent of invention, and send it to the Conservatory of Arts, whose director shall communicate it to the governor of the province where the application was originally made, for the purpose of having it duly entered in the register mentioned in article 16, and of having it copied by the secretary of the conservatory in a special register, after which it shall be delivered by him to the interested party or

his representative, against a receipt which shall be attached to the documents.

ART. 23. At the head of the patent there shall be printed in letters of a larger type than the largest employed in the body of the same the following words:—

“Patent of invention, without guarantee of the government as to the novelty, fitness, or utility of the object for which it is granted.”

ART. 24. The secretary of the Conservatory of Arts shall likewise deliver to the interested party or his representative, against a receipt, at the same time as the patent, one of the copies of the specification and of the drawings, samples and models accompanying it, and the whole shall be considered as an integral part of the patent and so designated therein.

ART. 25. The special register of patents at the office of the secretary of the Conservatory of Arts shall remain at the disposition of the public during the hours fixed by the director. The dates in this register shall be considered as evidence in the courts.

SECTION IV.

THE PUBLICATION OF PATENTS AND THE PUBLICITY OF SPECIFICATIONS, DRAWINGS, SAMPLES, OR MODELS.

ART. 26. The director of the Conservatory of Arts shall deliver to the Madrid Gazette, within the second half of the months of January, April, July, and October, for immediate publication in that official periodical, a report of all patents granted during the preceding quarter, clearly expressing their objects.

The provincial governors shall have these reports reproduced in the official bulletins in the same form as in the Gazette.

ART. 27. The specifications, drawings, samples, and models relating to the patents shall be open for public inspection at the office of the secretary of the Conservatory of Arts during the hours fixed by the director of the same.

Any one wishing to make copies thereof may do so at his own expense, after previous consent of the director of the conservatory, who will fix the place, days, and hours at which they can be made.

ART. 28. After the expiration of patents, the specifications, drawings, samples, and models shall remain at the Conservatory of Arts, in the museum of which shall be placed those which appear worthy of being exhibited there.

SECTION V.

CERTIFICATES OF ADDITION.

ART. 29. The owner of a patent of invention, or those interested through him, shall during the term of the grant have the right of making any alterations, modifications, or additions to the object of the patent, they may think proper, in preference to all others applying at the same time for a patent for an object similar to the alterations, modifications, or additions.

Such alterations, modifications, or additions shall be established by certificates of addition, delivered in the same way and with the same formalities as the original patent, and after application and proceedings as prescribed by article 15.

ART. 30. The applicant for a certificate of addition shall pay a single tax of 25 pesetas in government paper.

ART. 31. Certificates of addition shall form part of the original patent, and shall have from the respective dates of the application and grant the same effect. The time for working a certificate of addition terminates at the same time as that for the original patent.

SECTION VI.

CESSION AND TRANSFER OF PATENT RIGHTS.

ART. 32. All total or partial cessions of the rights conferred by a patent of invention or certificate of addition, whether gratuitously or for a consideration, and every other act involving a modification of the original right must indispensably be made by deed on which there shall be a certificate of the secretary of the Conservatory of Arts, signed by the director, proving the payment up to date of the taxes prescribed by this law, and that the assignor is the real owner of the patent or certificate of addition according to the entries in the records.

ART. 33. No assignment or other deed involving a modification of the right can prejudice a third party, unless it has been registered at the office of the secretary of the civil government of the province where the original deposit took place.

ART. 34. The registration of cessions and of all deeds involving a modification in the right shall be effected by the presentation and delivery to the secretary of the provincial government of an attested copy of the deed or contract of cession or modification.

On this copy the secretary shall mark the day and the page of the register.

ART. 35. The civil governor of the province where the assignment or other deed or contract involving a modification in the right is registered, shall, within five days after it has been entered in the register, transmit to the director of the Conservatory of Arts a copy, certified by the secretary and countersigned by the governor, both of the deed or contract of cession or modification, and of the entry on the register made by the secretary.

ART. 36. The secretary of the Conservatory of Arts shall note in the special register of patents all modifications occurring in the right of each of them, after having taken cognizance of the certified copy of the deed or contract of cession annexed to the records.

ART. 37. The director of the Conservatory of Arts shall transmit to the Gazette with the report mentioned in article 26 all modifications of rights that have taken place in the patents.

SECTION VII.

LIABILITIES OF PATENTEES.

ART. 38. The owners of a patent or certificate of addition shall be required to prove before the director of the Conservatory of Arts, within a term of two years counting from the date of the patent or of the certificate of addition, that they have put it in practice on Spanish territory, establishing a new industry in the country.

The above mentioned term of two years can only be prolonged by a law on equitable grounds, and for a term not exceeding six months.

ART. 39. The director of the Conservatory of Arts shall ascertain the fact, either by himself or through a practical engineer, or any competent person appointed for that purpose, by means of steps the least onerous he considers necessary, and for this end he may demand the assistance of all authorities and corporations, who are bound to aid him in the most efficacious manner with their influence and all means they can employ for that purpose.

ART. 40. When the director of the Conservatory of Arts thinks that the report concerning the working of the patent is sufficiently proved, he shall transmit the same, together with his report, to the minister of commerce for final decision.

ART. 41. The costs caused by the inquiries necessary to prove

that the object of a patent or of a certificate of addition has been worked establishing a new industry in the country, shall be borne by the interested party, who need only pay them when approved by the director of the Conservatory of Arts.

ART. 42. The director of the Conservatory of Arts shall cause the secretary to make on the register of patents a note of the decision recognizing the working, and communicate the same to the governor of the proper province.

SECTION VIII.

NULLITY AND ANNULMENT OF PATENTS.

ART. 43. Patents of invention are void :—

(1.) Whenever it is proved, with respect to the object of the patent, that the circumstances ; of originality and novelty ; of not having been established or practiced in essentially the same mode and form within the dominions ; or any other circumstance, alleged as fundamental in the application ; are not borne out.

(2.) Whenever it is found that the object of the patent is contrary to public order, or safety ; to morals, or to the laws of the country.

(3.) Whenever the object for which the patent was applied for is different from that which is worked in virtue of it.

(4.) Whenever it is shown that the specification does not contain all that is required for the complete understanding and working of the object of the patent, or when it does not completely indicate the real means of manufacturing or working.

ART. 44. Actions for annulment can only be instituted by an interested party.

The public prosecutor, however, may demand the annulment when the patent comes under the second paragraph of article 43.

ART. 45. Where the provisions mentioned in article 43 apply, all certificates of alterations, modifications, or additions to the original patent shall equally be null and void.

ART. 46. Patents of invention shall be annulled :—

(1.) At the expiration of the term of the grant.

(2.) When the owner does not pay the annual tax before the beginning of each year of the duration of the patent.

(3.) When the object of the patent has not been worked in the Spanish dominions within the time mentioned in article 38.

(4.) When the owner has ceased to work for one year and one day, unless he can show good cause for such interruption.

ART. 47. The declaration of annulment of patents coming under the first, second, and third paragraphs of article 46, belongs to the minister of commerce, on the previous advice of the director of the Conservatory of Arts. Against the decision of the minister there may be lodged an appeal to the Council within 30 days. The declaration of annulment of a patent coming under the fourth paragraph of the same article 46, belongs to the courts of justice on the application of an interested party.

ART. 48. The director of the Conservatory of Arts, after having caused the required entries to be made in the register of patents, shall transmit to the Madrid Gazette, together with the report mentioned in article 26, a further list of the patents annulled by the minister of commerce.

The civil governors shall cause such lists to be published in the official bulletins of their provinces, and have copies made in the registers of patents at the offices of their secretaries.

SECTION IX.

INFRINGEMENTS AND FALSIFICATION OF PATENTS, AND THE PENALTIES TO WHICH THEY ARE SUBJECT.

ART. 49. Infringers of patents are those who knowingly encroach on the rights of the legal owner by manufacturing or executing the object of the patent by the same means.

Accomplices are these who knowingly assist in the manufacture, execution, and sale or expedition of the counterfeit patent articles.

ART. 50. Infringement shall be punished by a fine of from 200 to 2,000 pesetas.

In case of a second offense the fine shall be from 2,001 to 4,000 pesetas.

It is a second offense when the infringer has been convicted of the same offense within the five preceding years.

Complicity in infringement shall be punished by a fine of from 50 to 200 pesetas, and a second offense by a fine of from 201 to 2,000 pesetas.

All products obtained by infringement shall be delivered to the patentee, besides damages for the loss he may have sustained. Insolvents shall suffer, in both cases, imprisonment, as prescribed by article 50 of the Criminal Code.

ART. 51. Falsifiers of patents of invention shall suffer the penalties mentioned in the first section of chapter 4, book ii., of the Criminal Code.

ART. 52. Actions for the offense of infringement provided for and punishable by the present section can only be entered by the public prosecutor on the complaint of the injured party.

SECTION X.

JURISDICTION IN PATENT MATTERS.

ART. 53. Civil and criminal actions concerning patents of invention shall be instituted before industrial juries. Until the organization of the industrial juries, such actions shall be brought before the ordinary courts.

ART. 54. Whenever the action is brought at the same time against the grantee and against one or more licensees, the competent tribunal shall be that of the domicile of the grantee.

ART. 55. Civil actions shall be governed by the rules prescribed for them by the laws relating to ordinary justice; and criminal actions shall be regulated by the criminal procedure.

ART. 56. The public prosecutor shall be a party to all actions having for their object the annulment of a patent of invention.

ART. 57. In the case of the preceding article, all parties interested in the grant according to the register of the Conservatory of Arts shall be summoned.

ART. 58. As soon as a patent of invention has been judicially declared null or extinct, the tribunal shall communicate the judgment to the Conservatory of Arts for entry, and the annulment or expiry shall be published in the Madrid Gazette in the manner prescribed by this law for the publication of patents.

The civil governors shall republish such annulments or expiries in the official bulletins of their provinces, and make in the registers of their offices the corresponding entries.

SECTION XI.

TRANSITORY DISPOSITIONS.

ART. 59. From the day the present law comes into force, all anterior dispositions relating to patents of invention, of importation, and of improvement shall be abrogated.

ART. 60. Existing patents of invention, importation, and

improvement, obtained under the old law, shall continue to be in force during the term for which they were granted.

ART. 61. Applications made before the publication of the present law shall be regulated in accordance with the old law; the applicants, however, may choose the terms and mode of payment of the present law.

ART. 62. All actions for infringement, counterfeiting, annulment, or extinction of patents, which were not begun before the commencement of the present law, shall be pursued according to the provisions of the same.

From *Carpn. Pat. L. of World*, 495.

See also INTERNATIONAL CONVENTION.

Operation of the general patent law of Spain over her provinces abroad. Spain, like France and unlike Great Britain, has pursued the policy of providing a law suitable for her colonies and dependencies as well as for the mother country. Thus article 8 of the general law (see p. 511 of the text), enacts that "all patents shall be considered as granted not only for the peninsula and adjacent islands but also for the provinces beyond the sea." Article 19 (p. 514)

allows an extended time for the correcting defects in applications presented in the Canaries or Antilles, or in the Philippine Islands. The mention, here, of the Antilles of course embraces only those few of the islands known by that general name which belong to Spain. Cuba and Porto Rico deserve mention as provinces of Spain important to inventors and patentees. There are many others, but they are small, or the authority of Spain over them is disputed.

STRAITS SETTLEMENTS.

An Ordinance for Granting Exclusive Privileges to Inventors; being Ordinance No. XII. of 1871.

PART I.

PRELIMINARY RULES.

1. *Short title.* This ordinance may be cited as the Inventions Ordinance, 1871.

2. *Interpretation clause.* In the construction of this ordinance, the following words and expressions shall have the meanings hereby assigned to them, unless there be something in the subject or context repugnant to such construction :

The word "invention" shall include an improvement.

The word "manufacture" shall include any art, process, or manner of producing, preparing, or making an article, and also any article prepared or produced by manufacture.

The word "inventor," when not used in conjunction with the word "actual," shall include the importer of an invention not publicly known or used in the colony.

The words "inventor" and "actual inventor" shall include the heirs, executors, administrators, or assigns of an inventor, or actual inventor, as the case may be.

The word "assigns" shall include grantees of the sole use or benefit in the colony of an invention, or of the sole use of any exclusive privilege for a limited time.

3. *Invention.* An invention shall be deemed a new invention within the meaning of this ordinance, if it shall not, before the time of applying for leave to file the specification, have been publicly used in the United Kingdom, in this colony, or in any British Possession. The public use of an invention prior to the application for leave to file a specification shall not be deemed a public use within the meaning of this section, if the knowledge thereof shall have been obtained surreptitiously, or in fraud of the inventor, or shall have been communicated to the public in fraud of the inventor, or in breach of confidence. Provided that the inventor shall, within six months after the commencement of such public use, apply for leave to file his specification, and shall not previously

have acquiesced in such public use. Provided also, that the use of an invention in public by the inventor thereof, or by his servants or agents, or by any other person by his license in writing, shall not be deemed a public use thereof, within the meaning of this ordinance.

4. *When exclusive privilege does not attach.* No person shall be entitled to any exclusive privilege under the provisions of this ordinance ;

If the invention is of no utility ; or,

If the invention, at the time of presenting the petition for leave to file the specification, was not a new invention within the meaning of this ordinance ; or,

If the petitioner is not the inventor thereof ; or,

If the specification filed, or the amended specification (if any), does not particularly describe and ascertain the nature of the invention, and in what manner the same is to be carried out, with the particulars required by section 11 of this ordinance ; or,

If the original or any subsequent petition relating to the invention, or the original or any amended specification, contain a willful or fraudulent misstatement.

5. *Prerogative in respect of letters patent saved.* Nothing in this ordinance contained shall abridge or effect the prerogative of the Crown, in relation to the granting or withholding the grant of any letters patent for inventions, or otherwise, or affect or interfere with any letters patent for an invention heretofore granted, or hereafter to be granted by the Crown.

PART II.

ACQUISITION OF EXCLUSIVE PRIVILEGES.

6. *Inventor may petition for leave to file specification ; form, &c., of petition.* The inventor of any new manufacture may petition the Governor in Council for leave to file a specification thereof. Every such petition shall be in writing, in the form or to the effect mentioned in the schedule A, and shall be signed by the petitioner, or in case the petitioner shall be absent from the colony, by an authorized agent, and shall state the name, condition, and place of residence of the petitioner, and the nature of the invention.

7. *An alien ami may petition.* An *alien ami*, whether resident in the colony or not, may petition for leave to file a specification under this ordinance.

8. *Order for filing specification.—Power to refer petition for inquiry and report.—Fee for report.—Governor in Council may refuse order.* Upon such petition the Governor in Council may make an order authorizing the petitioner to file a specification of the invention. Provided always, that at any time before such order is made, the Governor may, if he think fit, refer the petition to any person or persons for inquiry and report, and such person or persons shall be entitled to a reasonable fee for such inquiry and report, to be paid by the petitioner, the amount of fee, in case of dispute, to be settled by a judge of the Supreme Court in a summary manner.

And provided further, that it shall be lawful for the Governor in Council to refuse to make any order under this section in any case in which it may appear to him that the granting of exclusive privileges under this ordinance would be prejudicial to the public interests, or of doubtful public utility.

9. *Petition and specification to be left with the colonial secretary, and to be accompanied by declaration by petitioner, or if absent, by agent.—To be recorded.* Every petition for leave to file a specification, and every specification filed under this ordinance, shall be left with the colonial secretary, and shall be accompanied by a declaration in writing, signed by the petitioner, in the form in the schedules B and C respectively; and if the inventor be absent from the colony, the petition and specification shall also be accompanied by a declaration in the form in the schedule D, signed by the agent, who shall present or file the same, to the effect that he verily believes that the declaration, purporting to be the declaration of the inventor, was signed by him, and that the contents thereof are true. The date of the delivery of every such petition and specification shall be indorsed on the same respectively, and shall also be recorded in the office of the colonial secretary.

10. *Order to file specification may be made subject to conditions.* An order, authorizing the filing of a specification, or for extending the term of such exclusive privilege as aforesaid, may be made, subject to such conditions and restrictions as the Governor in Council may think expedient.

11. *Specification to describe invention and manner of working, &c.—Plans and further particulars.* Every specification of an invention filed under this ordinance shall be in writing, and shall be signed by the petitioner, and shall clearly and minutely describe and define the nature and purpose of the invention, and how and in

what manner it is to be worked and carried into practical operation, and shall be accompanied by such explanatory plans, and shall contain such further or other particulars and information as the Governor in Council may require.

12. *Petitioner to be entitled to exclusive privilege for 14 years.—*
Extension of term. If, within the space of six months from the date of such order, the petitioner cause a specification of his invention to be filed in manner required by this ordinance, the Governor in Council may, in the form E in the schedule, under the public seal of the colony, grant to the petitioner, his heirs, executors, administrators, and assigns, the sole and exclusive privilege of making, selling, and using the said invention in the colony, and authorizing others so to do, for the term of fourteen years from the time of filing such specification ; and for such further term, if any, not exceeding fourteen years from the expiration of the first fourteen years, as the Governor in Council may think fit to direct, upon petition to be presented by such inventor at any period, not more than one year, and not less than six months, before the expiration of the exclusive privilege hereby granted.

13. *Petitions for disclaimer, how drawn; order; notice opposing; proviso.* If, after the filing of the specification, the inventor or his assignees shall have reason to believe that through mistake or inadvertence he has erroneously made any misstatement in his petition or specification, or included therein something which at the date of his petition was not new, or whereof he was not the inventor, or that such specification is in any particular defective or insufficient, he may petition the Governor in Council for leave to file a memorandum, pointing out such error, defect, or insufficiency, and disclaiming any part of the alleged invention, or for leave to file an amended specification, in case of any defect or insufficiency of the specification.

The petition shall state how the error, defect, or insufficiency occurred, and that it was not fraudulently intended, and shall be accompanied by a declaration in writing, signed by the petitioner, or, if he be absent from the colony, by his agent, stating that the contents of such petition are true to the best of his knowledge and belief. Upon such petition, the Governor in Council may make an order, allowing such memorandum or amended specification to be filed.

All the provisions of the 3d part of this ordinance applicable to petitions and specifications shall be applicable to the petitions, orders

and memoranda, or amended specifications, referred to in this section, but the stamp fee chargeable on the petition shall be five dollars in lieu of fifty dollars.

Every petition under this section shall be published in the Government Gazette of the colony, and at the same time notice shall be given in the said Gazette of the time when the petition will be taken into consideration by the Governor in Council, and any person interested in opposing the prayer of the petition may serve on the colonial secretary a notice, on a stamp paper of the value of one dollar, of his intention to oppose, and every person so serving a notice may be heard by the Governor in Council, in opposition to the prayer of the said petition.

Every memorandum of alteration filed under the provisions of this section shall be added to and form part of the original specification, and, except as to suits or proceedings relating to the exclusive privilege which shall be pending at the time of the filing of such memorandum of alteration, or of the filing of an amended specification, the memorandum of alteration, or the amended specification, shall have the same effect as if it had formed part of or had been the specification first filed; provided that nothing contained in an amended specification shall extend or enlarge any exclusive privilege before acquired.

14. *Patentee in England may petition for extension here.—Proviso.* If an inventor who, prior to the time of applying for leave to file a specification of an invention under this Ordinance, shall have obtained Her Majesty's letters patent for the exclusive use of such invention in any part of the United Kingdom, or shall have obtained a grant of exclusive privileges in any British Possession, but not extending to this colony, shall petition the Governor in Council for leave to file a specification of such invention, it shall be competent to the Governor in Council to make an order authorizing the petitioner to file a specification of the invention and exemplification of the letters patent or grant of exclusive privileges granted to him. On this being done, the petitioner shall be entitled to the sole and exclusive privilege of making, using, and selling the said invention in this Colony, during the remainder of the term for which the said letters patent or grant of exclusive privileges or any renewal of the same may be in force, or for the term or terms mentioned in section 12. Provided that the petition for leave to file the specification shall state that such letters patent or grant of exclusive

privileges have been granted, and shall also state the date thereof, and the term during which the same are to continue in force.

15. *Rule for Indian patents before April 1, 1867.—Stamp fee.* Every person who, before the first day of April, 1867, shall have obtained from the Governor General of India in Council a grant of exclusive privileges under the Indian Act No. 15 of 1859, for India, as defined in the said Act, shall be entitled to use and exercise in the colony after the first day of April, 1867, all the rights and privileges conferred by such grant, on registering at the office of the colonial secretary a certified copy of such grant, and of the specification filed in India on which such grant was made.

For every such register a fee of 5 dollars shall be paid, by a stamp or stamps impressed on the said copy.

16. *Disclaimers or memorandum of alterations made elsewhere, and amendments under section 3, how to be filed.—Proviso.* Whenever it shall be made to appear to the Governor in Council that a disclaimer or memorandum of alterations relating to any invention as to which privileges have been obtained in the colony under section 14 of this ordinance, or under the provisions of the Electric Telegraph Exclusive Privileges Ordinance, 1870, has been entered according to the law of England, or the law of the British Possession in which the exclusive privilege may have been granted, and whenever any amendments are made under section 35 of this ordinance, it shall be lawful for the Governor in Council to order that a copy of such disclaimer or memorandum of alteration or amendment shall be filed in the office of the colonial secretary, with and as part of the specification of the invention and exemplification of the letters patent, or of grant of exclusive privileges to which the same relates ; whereupon the said specification of invention and exemplification of letters patent, or of grant of exclusive privileges, shall be read as if such disclaimer or memorandum of alterations or amendment had formed a part thereof when filed in the office of the colonial secretary. Provided that no such disclaimer, memorandum of alteration, or amendment shall be held to extend the exclusive rights granted by such letters patent, or grant of exclusive privileges.

PART III.

GENERAL RULES.

17. *Stamp on petition.* Every petition for leave to file a specification under the provisions of this ordinance, or for the extension

of the term of an exclusive privilege, shall be written or printed on a stamped paper of the value of fifty dollars.

18. *All fees to be paid before filing.* No specification shall be filed until the petitioner shall have paid all fees and stamp duties payable under this ordinance.

19. *Specification to be open to inspection.—Fee for inspection.* The specification, or a copy thereof, shall be open at all reasonable times at the office of the colonial secretary to public inspection, upon payment of a fee of one dollar.

20. *Register for the registry of petitions, specifications, &c.* A register shall be kept in the office of the colonial secretary, wherein shall be entered every such petition and specification, and every order made upon such petition, or relating to the invention therein mentioned, and every grant of exclusive privilege. Every specification and every grant as aforesaid shall be numbered according to the order in which they are entered in such book, and a reference shall be made in such book, in the margin of the entry of each specification, to every order relating to the invention.

21. *Inspection of register.—Fee.—Certified copy of entry to be given.* Such register, or a copy thereof, shall be open at all convenient times for the inspection of any person, upon payment of a fee of one dollar, and the colonial secretary shall cause a copy of any entry therein, certified under his hand, to be given to any person requiring the same, on payment of the expense of copying.

22. *Certified copy to be primâ facie evidence.* Every copy of a document filed in the office of the colonial secretary under the provisions of this ordinance, purporting to be certified as a true copy under the hand of the colonial secretary, shall be *primâ facie* evidence of the document of which it purports to be a copy.

23. *Specifications.—Service of notices, &c.—Names and addresses of proprietors.* A book shall be kept in the office of the colonial secretary (such book to be open to inspection without fee), wherein every person filing a specification under this ordinance shall cause to be stated, under a number corresponding with the number of the specification, some place in the settlement where service of any rules or proceedings for the purpose of canceling or revoking his exclusive privilege, or of any other process may be made. Any person, partnership, or company, from time to time, being proprietors of, or having shares or interests in, such exclusive privilege, shall cause to be entered in such book, under such numbers as aforesaid, their names, together with the name of some

place for the service of such proceedings and process as aforesaid. All such rules, proceedings, and process shall be deemed sufficiently served on any such person, partnership, or company, if a copy thereof be left at the place entered in such book, or (if any other place be substituted for the same by entry in said book) at the place last substituted, by delivering the same to any person resident at or in charge of such place; or if there be no person resident at or in charge of such place, and if such person, partnership, or company shall neglect to make or cause to be made such entry, then service of such rule, proceeding, or process may be effected by affixing a copy thereof to a conspicuous part of the Supreme Court house, or in such other manner as the court may direct.

24. *Governor may determine exclusive privilege.* Every exclusive privilege under this ordinance shall cease if the Governor in Council shall declare by notification in the Government Gazette, that the same, or the mode in which it is exercised, is mischievous to the State, or generally prejudicial to the public; or if a breach of any special condition, on which the petitioner shall have been authorized to file a specification, or upon which the term of the exclusive privilege shall have been extended, shall be proved to the satisfaction of the Supreme Court, and if the Governor in Council shall thereupon declare that such exclusive privilege shall cease.

PART IV.

LEGAL PROCEEDINGS.

25. *Actions for infringements.* An action may be maintained in the Supreme Court by an inventor against any person who, during the continuance of any exclusive privilege granted by this ordinance, shall, without the license of the said inventor, make, use, sell, or put in practice the said invention, or who shall counterfeit or imitate the same.

26. *Particulars to be delivered.—Evidence at trial.—Court may amend particulars.* In any such action the plaintiff shall deliver with his plaint particulars of the breaches complained of in the said action; and the defendant shall deliver a written statement of the particulars of the grounds (if any) upon which he means to contend that the plaintiff is not entitled to an exclusive privilege in the invention. In like manner, upon any application to the Supreme Court under sections 30 and 31 of this ordinance, the applicant shall deliver particulars of the objections on which he means to rely. At

the trial of any action or issue, no evidence shall be allowed to be given in support of any alleged infringement, or of any objection impeaching the validity of such exclusive privilege, which shall not be contained in the particulars delivered as aforesaid. If it be alleged that the invention was publicly known or used prior to the date of the petition for leave to file such specification, the places where, and the manner in which the invention was so publicly known or used, shall be stated in such particulars: Provided always, that it shall be lawful for the court to allow the plaintiff or defendant respectively to amend the particulars delivered as aforesaid upon such terms as shall seem fit.

27. Action for infringement not to be defended for defect in specification or petition, or for want of novelty in invention. No such action shall be defended upon the ground of any defect or insufficiency of specification of the invention, nor upon the ground that the original or any subsequent petition relating to the invention, or the original or any amended specification, contains a misdescription, nor upon the ground that the invention is not useful; nor shall any such action be defended upon the ground that the plaintiff was not the inventor, unless the defendant shall show that he, the defendant, is the actual inventor, or has obtained a right from the actual inventor to use the invention, either wholly or in part.

28. The actual use of an invention in the colony, or the United Kingdom, or any British Possession before the date of petition, a defense to such action. Any such action may be defended upon the ground that the invention was not new, if the person making the defense, or some person through whom he claims, shall, before the date of the petition for leave to file the specification, have publicly or actually used in the colony or in some part of the United Kingdom, or in any British Possession, the invention or that part of it of which the infringement shall be proved, but not otherwise.

29. In what case actual inventor entitled to assignment of an exclusive privilege fraudulently obtained. If, upon proceedings instituted by a person claiming to be the inventor, within two years from the date of a petition to file a specification, he shall prove to the satisfaction of the Supreme Court that the petitioner was not the inventor, and that at the time of the petition he knew or had good reason to believe that the knowledge of the invention was obtained by himself or by some other person surreptitiously or in fraud of the inventor, or by means of a communication made in confidence by the actual inventor to him or to any person through

whom he derived such knowledge, the court may compel the petitioner to assign to the inventor any exclusive privilege obtained under this ordinance, and to account for and pay over the profits thereof.

30. *Application by attorney-general on breach of special conditions.—Costs.* It shall be lawful for the attorney-general or solicitor-general to apply to the Supreme Court, calling upon any petitioner under this ordinance, his executors, administrators, or assigns, to show cause why the question of the breach of any special condition, upon which the leave to file a specification has been granted, or any other question of fact on which the revocation of the exclusive privilege by the Governor in Council, under the power reserved in section 24, may, in the judgment of the said Governor in Council, depend, should not be tried in the form of an issue directed by the said court, and if the rule be made absolute, the court, unless the breach or other matter of fact be admitted, may thereupon direct such issue to be tried, and shall certify the result of such trial to the Governor in Council. The costs of such trial, and also the costs of such proceedings, shall be in the discretion of the said court.

31. *Application to Supreme Court to declare exclusive privilege not to have been acquired.* It shall be lawful for any person to apply by motion to the Supreme Court for a rule to show cause why the court should not declare that an exclusive privilege in respect of an invention or part of an invention has not been acquired under the provisions of this ordinance, by reason of all or any of the objections following (to be specified in the rule); that is to say:—

That the said invention or part of invention was not at the time of presenting the petition for leave to file the specification a new invention; or,

That the petitioner was not the inventor thereof, and, in addition thereto, either that the applicant was the inventor, or that the inventor has dedicated or made known the invention or part of invention to the public, or has acquiesced in the public use thereof; or,

That the specification filed does not particularly describe and define the nature of the invention or part of invention, or in what manner the same is to be carried out; or,

That the petitioner has fraudulently inserted in the petition or specification, as part of his invention, something which was not new, or whereof he was not the inventor; or,

That the petitioner has willfully made a false statement in his petition or specification ; or,

That some part of the invention, or the manner in which that part is to be carried out as described in the said specification, is not thereby sufficiently described and defined, and that such defect or insufficiency was fraudulent, and is injurious to the public.

32. Service of proceedings on all persons interested. Notice of any rule obtained or proceeding taken under either of the last three preceding sections shall be served on all persons appearing to be proprietors, or to have shares or interests in the exclusive privilege under the provisions of section 23 of this ordinance, and it shall not be necessary to serve such notice on any other persons.

33. Court may direct issue for trial. The Supreme Court may, if it think fit, direct an issue for trial of any question of fact arising upon an application under sections 30 or 31 of this ordinance, and such issue shall be tried in the usual manner for trying issues of fact in the said court.

34. Judgment.—Costs. If it shall appear to the Supreme Court, at the hearing of any application under the provisions of sections 30 or 31 of this ordinance, that, by reason of any of the objections therein mentioned, the said exclusive privilege in the invention, or in any part thereof, has not been acquired, the court shall give judgment accordingly, and shall make such order as to the costs of, and consequent upon, the application, as it may think just ; and thereupon the petitioner, his heirs, executors, administrators, and assigns, shall, so long as the judgment continues in force, cease to be entitled to such exclusive privilege.

35. Amendment of specification by court.—Proviso. If the court, at the hearing of any application under this ordinance, shall think that the petitioner has, in the description of the invention given in his petition or specification, included something which at the date of the petition was not new, or whereof he was not the inventor, or that the specification is in any particular defective or insufficient, but that the error, defect, or insufficiency was not fraudulently intended, the said court may adjudge the said exclusive privilege to have been acquired and to be valid, save as to the part thereof affected by such error, defect, or insufficiency ; or if the court shall think that the error, defect, or insufficiency can be amended without injury to the public, it may adjudge the exclusive privilege in the whole of the invention to be valid, and may, upon such terms as shall appear reasonable, order the specification to be

amended in any of the said particulars; and thereupon the petitioner, his heirs, executors, administrators, or assigns, shall, within the time limited by the court for the purpose, file a specification amended according to such order.

Provided that no such amended specification shall have the effect of extending or enlarging the exclusive privilege before acquired.

36. *Misdescription in the petition, if not fraudulent, not to defeat the privilege.* An exclusive privilege shall not be defeated upon the ground that there is any misdescription of the invention in the petition, unless such misdescription was fraudulent.

37. *Entry in registry book, of judgment declaring privilege not to have been acquired.* Whenever it shall be adjudged by the said court that an exclusive privilege as to the whole or any part of an invention has not been acquired, the colonial secretary shall, upon the production of a certified copy of the judgment or order of the court, cause an entry thereof to be made in the register hereinbefore in section 20 directed to be kept, and shall cause a reference to such entry to be made in the margin of the entry of the specification contained in such register.

38. *Appeal to Privy Council.* Nothing in this ordinance contained shall be held to affect the right of appeal to Her Majesty in Her Privy Council. Every such appeal may be had, and proceedings therein shall be subject to the rules, orders, and regulations in force, or to be in force, in the colony for appeals to Her Majesty in Her Privy Council from decisions of the Supreme Court of the Colony.

SCHEDULE.

A.

Form of Petition.

To His Excellency the Governor of the Colony of the Straits Settlements in Council:

The petition of [*here insert name, addition, and place of residence*], for leave to file a specification under the Inventions Ordinance, 1871, sheweth,—

That your petitioner is in possession of an invention for [*state the title of the invention*], which invention he believes will be of public utility; that he is the inventor or owner of the said invention [*or, as the case may be, the assignee, or the executor, or administrator, or heir of the inventor or owner of the said invention*]; and that the

same is not publicly known or used in the colony, to the best of his knowledge and belief [or, as the case may be, that he is the first importer into the colony of the said invention, and that the same is not publicly known or used in the colony].

N. B.—If letters patent have been obtained for the invention, state according to the requirements of section 14.

The following is a description of the invention [here describe it as required by section 11].

Your petitioner therefore prays for leave to file a specification of the said invention, pursuant to the provisions of the Inventions Ordinance, 1871. And your petitioner, &c.

(Signed.)

The day of

B.

Declaration to accompany a Petition.

I [here insert name, addition, and place of residence], do solemnly and sincerely declare that I am in possession of an invention for [state the title of the invention as in the petition]; that I believe the said invention will be of public utility; that I am the inventor [or owner] of the said invention [or, as the case may be, the assignee, or executor, or administrator, or heir of the inventor or owner of the said invention, or that I am the first importer of the said invention into this colony], and that the same is not publicly known or used in the colony to the best of my knowledge and belief; and that, to the best of my knowledge and belief, my said invention is truly described in my petition for leave to file a specification thereof.

(Signed.)

The day of

C.

Declaration to accompany a Specification.

I [here insert name, addition, and place of residence], do solemnly and sincerely declare that I am in possession of an invention for [state the title of the invention], which invention I believe will be of public utility; that I am the inventor or owner of the said invention [or, as the case may be, the assignee, or executor, or administrator, or heir of the inventor or owner of the said invention, or that I am the first importer of the said invention into this colony], and the same is not publicly known or used in this colony to the best of my knowledge and belief; and that, to the best of my belief, the instrument in writing under my hand, hereunto annexed, particularly describes and defines the nature of the said invention and in what manner the same is to be carried out.]

(Signed.)

The day of

D.

Declaration by Agent.

I _____, of _____, do solemnly and sincerely declare that I have been appointed by the said _____, his agent for the purpose of _____, and I verily believe that the

declaration purporting to be the declaration of the said _____, marked (_____), was signed by him, and that the contents thereof are true.

(Signed.)

The _____ day of _____

E.

Form of Grant.

VICTORIA, by the grace of God, of the United Kingdom of Great Britain and Ireland Queen, Defender of the Faith, &c.

(Signed.) [Signature of Governor.]

To all to whom these presents shall come,

Greeting:

Whereas *A. B.* of *C. D.*, has presented to [insert name of Governor], Governor of the Colony of the Straits Settlements, a petition (numbered _____ in the book of petitions for exclusive privileges in inventions in the office of the colonial secretary) praying for leave to file a specification of a certain invention entitled [here insert the title of invention], and an Order in Council, dated the _____ day of _____, 18____, was made thereon, authorizing the said *A. B.* to file a specification of the said invention: And whereas the said *A. B.* did on the _____ day of _____, 18____, file a specification in accordance with the said order, and the same is entered in the Book of Specifications of the colonial secretary, and bears the number _____ therein: And whereas all things have been done to entitle him to exclusive privilege in the invention in the said petition and specification instituted, mentioned, and described for the term of _____ years: It is hereby ordered that the said *A. B.*, his heirs, executors, administrators, and assigns, shall have the exclusive privilege of making, selling, and using (as the case may be) the said invention in the said specification described in the Colony of the Straits Settlements for the term of _____ years, in terms of and subject to the provisions of the Inventions Ordinance, 1871 [here insert any condition under which the grant is made].

(Signed.)

Colonial Secretary.

From *Carp. Pat. L. of World*, 510.

SWEDEN.

*Law of May 16, 1884.**

His royal majesty's gracious order respecting patents, given at the Castle of Stockholm on the 16th of May, 1884.

We, OSCAR, by the grace of God, King of Sweden, Norway, Gothland, and Vendland, make known that, in accordance with a proposition of the Riksdag, dated the 25th of January last, we have agreed to declare annulled (with some small exceptions herein noted) our gracious order respecting patents, of the 19th of August, 1856, and are graciously pleased to order as follows:

§ 1. Patents may, under the conditions hereinafter prescribed, be granted for inventions of industrial productions or of special methods of manufacturing such productions.

Inventors only, Swedish or foreign, or the legal representatives of inventors, are entitled to obtain patents.

§ 2. Patents shall not be granted for inventions the working of which would be contrary to law or morals. With regard to inventions relating to provisions or medicines, patents shall not be granted for the commodity itself, only for special methods for its manufacture.

§ 3. An invention shall not be considered as new, if it has, prior to filing the application for a patent with the patent authorities, been described in any published journal, or is so openly worked that any person conversant with the subject may, guided by the information thus gained, work the invention, or if the object of the invention does not essentially differ from products or methods of manufacture which have before become known in such a way.

The publication of an invention in print by foreign patent authorities or the exhibition of the same in any international exhibition shall not be an obstacle to the granting of a patent, provided the application is filed within six months from the date of publication or the day the exhibition commenced.

§ 4. (1.) Whoever wishes to obtain a patent shall lodge a writ-

*Another translation of this law, differing slightly from that given in the text, and from which the title and enact-

ing clause commencing and ending the law in the text are taken, may be found in 28 Pat. Off. Gaz. 1103.

ten application with the patent authorities or send it prepaid by post. The application must be accompanied by a duplicate description of the invention and the drawings in duplicate which are required to explain the description ; and when necessary, also by models, samples or the like.

The application shall contain the name, profession and postal address of the applicant, likewise the title of the invention.

The description must be given in so explicit and complete a manner that any person conversant with the subject may, thus guided, work the invention.

The description must also state what the inventor considers to be novel in the invention.

When the applicant does not reside in the country he must also deposit a power of attorney to an agent, residing in the country, authorizing him to represent the inventor in everything pertaining to the patent.

If patents are applied for for several inventions, separate applications must be lodged for each.

(2.) If the applicant names another person as the inventor he shall produce papers authorizing him to represent the inventor.

(3.) The applicant is also required to pay a fee amounting to fifty crowns according to section 11.

§ 5. If the patent authorities find that the applicant has not fulfilled the provisions of section 4 (1.) a written notice to that effect will be kept at the office for him ; or, if a full postal address is furnished, the notice will be sent to him by post. Should the applicant not supply the deficiency within the date fixed by the patent authorities the application will be considered abandoned.

§ 6. Should it be deemed that the object of the invention is of such a character that a patent may not be granted, or that the invention evidently is not new, or if the applicant upon stating that another person is the inventor has not proved himself to be the legal representative of the inventor, or if the applicant has failed to pay the fee prescribed by section 4 (3.) ; the patent authorities shall immediately reject the application.

Notice of such a decision together with the reasons for rejection will be communicated to the inventor in accordance with section 5.

§ 7. If the several documents for application are complete, and there is no cause for immediate rejection of the application as provided in section 6, the patent authorities shall give notice of the ap-

plication in the newspapers, stating the main features thereof ; likewise it shall be the duty of the said authorities to keep the documents of application accessible to every person desiring to obtain knowledge of the same. And every one intending to contest the application for the patent shall, within a period of two months from the date of the announcement of the application, be permitted to file with the patent authorities a written protest.

At the end of that period the patent authorities shall take up the case under consideration.

If there is nothing to impede the granting of the application the patent may be granted and letters patent be issued, saving, however, the right of contest provided for in section 18. It shall be the duty of the patent authorities to enter the grant in a register kept for that purpose and to make it public by notices in the newspapers and to have the description, with the necessary supplements in their essential parts, printed and published in a suitable way.

If the application is rejected the decision shall be communicated to the applicant in the form enacted by section 6.

§ 8. In cases where an application for a patent has been rejected in pursuance of sections 6 and 7, and the applicant declares himself dissatisfied with this decision, he may appeal to the King before twelve o'clock upon the sixtieth day after the date of the decision or the privilege of appeal shall be lost.

§ 9. When several persons desire to obtain a patent for the same or a similar invention, the right of preference will be granted to the inventor whose documents for application, prepared in conformity to law, were earliest lodged with the patent authorities.

§ 10. Letters patent shall, except in the case hereinafter stated, be issued for a period of fifteen years from the day the application was filed.

Any person desiring to obtain a patent of addition for improvements upon inventions patented before as his own, without applying for a new patent, may upon complying with the conditions hereinbefore stated, have this granted for the same period as that for which the prior patent is valid.

§ 11. On each application for a patent a fee amounting to fifty crowns shall be paid to the patent authorities as provided in section 4. Should the application be rejected or forfeited half that sum will be returned to the applicant.

Upon each patent granted, with the exception of patents of

addition, the patentee shall pay to the patent authorities an annual fee amounting for the second, third, fourth and fifth years of the patent to twenty-five crowns, each year, and for each of the following five years fifty crowns, and for each of the remaining five years seventy-five crowns. The fee may be sent prepaid by post, and shall for each year of the patent be paid before the commencement of that year, under penalty of the fee for that year being increased by one-fifth. Should the payment of the increased fee be afterwards neglected, then at the end of the first ninety days of the new year of the patent, the patent shall be considered as forfeited. The patentee has not to pay, over and above the fees here prescribed, the expenses of publishing the patent or the description.*

§ 12. If the patent is assigned to another person, notice of such proceeding, together with the documents proving the assignment, shall be presented to the patent authorities. Unless such notice is given, the patentee latest entered in the records shall be considered by the patent authorities as patentee.

§ 13. In case a patentee is about to reside abroad, or the patent has been assigned to a person who does not live within the country, it shall be the duty of the patentee to deposit with the patent authorities a power of attorney to a legal representative as provided under section 4 (1). Should the agent of the patentee go away to reside abroad, or his charge be otherwise discontinued, the patentee must deposit a power of attorney to another agent. If these provisions are not observed, the judge of the court shall upon being duly notified of the matter appoint an agent for the patentee.

* The matter corresponding to section 11 is stated in the Patent-office Gazette translation, as follows:

With each application for patent shall be paid to the patent authority, as stated in § 4, 50 kroner (about fourteen dollars). One half of this, however, shall be returned to the applicant if the application fall through or be rejected. On every patent, with the exception of patents of addition, shall be paid by the holder of the patent to the patent authority a yearly duty amounting for each of the second, the third, the fourth, and the fifth patent years twenty-five kroner (about seven dollars), for each of the five following years

fifty kroner (about fourteen dollars), and for each of the five last years seventy-five kroner (about twenty-one dollars). The duty (which must be forwarded in prepaid letter) shall for each patent year be paid before the beginning of that year; otherwise the duty for the same shall be increased one-fifth. If, furthermore, the increased duty be not paid within ninety days after the beginning of the patent year, the patent shall be forfeited. The holders of patent are not obliged to pay beyond the above-named duties for the expenses of publication of the patent or for the announcement of the detailed description.

§ 14. If the fees are paid and the proceedings completed as provided by sections 12 and 13, the patent authorities shall register the payment in the records pursuant to section 7.

§ 15. It shall be the duty of the patentee within three years from the date at which the patent was granted to have the invention worked within the country to an adequate extent. But the patent authorities may allow at the time the patent is granted, or afterwards, should it be requested, and having regard to the character and extent of the invention, a prolongation of the period up to four years. They may also determine in exceptional cases what measures, taken by the patentee, shall be considered to have complied with the conditions of working the invention.*

If the patentee has within the period prescribed failed to comply with the conditions required for working the invention, or if the working of the invention is subsequently abandoned and not afterward resumed within a year, the patent shall be forfeited.

§ 16. Claims in relation to patents shall not be valid against any person who at the time the application for the patent was filed had worked the patented invention or made extensive preparations for such working.

§ 17. If the King considers it necessary that a patented invention shall be open to the free use of the public, or appropriated on account of the State, the patent shall be no obstacle, the patentee shall however be entitled to full compensation. If the amount of compensation cannot be agreed upon, it shall be fixed by a special jury, appointed by the court, according to the provisions for expropriation of land or homesteads required for public purposes.

§ 18. Should a patent have been obtained contrary to the provisions of sections 1, 2 and 3, any person who considers his rights violated through the patent granted, and also the public prosecutor, when the interest of the public demands such proceedings, may contest before the court the validity of the patent.

* This point is thus stated in the translation given in the Patent-Office Gazette:

The holder of the patent is required within three years from the date of when the patent was granted to bring into operation his invention to some practical extent within the realm. At the same time the patent authority shall have power to allow at the grant of the patent or afterward, if representations be made

to him, and if the nature of the invention and other causes make it desirable in his opinion) to extend the said period for beginning working to four years, and also in remarkably exceptional cases the patent authority may direct that the holder of the patent be considered as having fulfilled the conditions for the working of the invention.

§ 19. All and every one who alleges that a patentee through negligence in complying with the regulations prescribed by section 15 has forfeited his patent, may proceed before the court.

§ 20. The court before whom it shall be lawful to proceed in cases coming under sections 17, 18 and 19, shall be the Court of the City of Stockholm.

§ 21. If the validity of a patent has been contested, and the contest has been decided, the decision shall through the court, be transmitted to the patent authorities.*

§ 22. Any person who without the permission of the patentee, except in cases coming under sections 16 and 17, manufactures goods in the country with an intent to sell, or for such manufacture employs a method of which he knows another person to be the lawful patentee; or who sells in the country or imports into the country for sale, goods patented here or made according to methods of manufacturing which he knows to be patented here, which methods he appropriates without permission of the patentee, shall be liable to a fine varying from twenty to two thousand crowns, and he shall be also liable to all the damages. No one but the patentee has the right to take proceedings for these penalties.

Goods unlawfully manufactured or unlawfully imported into the country shall, when the complainant so demands, be delivered up to him against compensation for the value, or against deduction therefor from the damages due to the complainant. Implements exclusively applicable for the unlawful manufacture may, when the complainant requires it, be destroyed to prevent further mischief.

Persons accused under this section (section 22) who continue the offense during the proceedings shall, when legally convicted be called to account for each separate time a warrant has been issued and served.

Money fines according to this section go to the crown. In cases of destitution when the fine cannot be fully paid, imprisonment may be substituted according to the general penal code.†

§ 23. Should any person be accused of interfering with the

* Section 21 is translated as follows in the Patent-Office Gazette:

The verdict in any action about the validity of the patent, when the plea of invalidity has been approved, shall be sent by the court to the patent authority.

† Section 22 is thus translated in the Patent-Office Gazette.

Any one who shall, except in the cases mentioned in sections 16 and 17, without the permission of the holder of the patent within the realm, offer for sale, manufac-

rights of another person under a patent, and in the course of the proceedings the patent be found invalid, forfeited, or the claim unfounded, the person under prosecution shall be acquitted.

§ 24. When a patent has ceased to be valid, either in consequence of the provisions prescribed by this law, or when the patentee has notified to the patent authorities his intention to give up the patent, it shall be the duty of the patent authorities to cause the same to be canceled in the register, and also to have notices of the cancellation published in the newspapers.

§ 25. With regard to patents granted in a foreign State, where patents granted in this country are treated with corresponding consideration, be it enacted that persons, who within seven months from the day the application was filed in the foreign State, apply for a patent for the same invention in this country, shall with regard to this application in relation to earlier applications for patents, be considered as if the application was filed in this country at the same date as the application was filed in the foreign State.

§ 26. More detailed provisions relating to the character of the documents required when an application is lodged, to the entering of patents, and to the publication of the descriptions of patents, will be issued by the King.

§ 27. The regulations contained in this law shall take effect from the first day of January, 1885, and applications for patents filed prior to that date shall be proceeded with in accordance with the

ture goods or make use of a mode of manufacture, by manufacturing for sale, for which he is aware patent has been obtained, or keep knowingly for sale within the realm or for sale imports into the realm the patented article or articles which he knows to be produced by the patented mode of manufacturing of goods without the permission of the holder of the patent, shall be punished with fines of not less than twenty kroner (about five dollars and fifty-five cents), or more than two thousand kroner (about five hundred and fifty-five dollars), and all costs and damages. At the same time no one but the holder of the patent shall be allowed to prosecute. Unlawfully manufactured goods or unlawfully imported goods shall, if the plaintiff demands it, be delivered up

to him for compensation for the value or in part payment of damages. All tools exclusively applicable for the unlawful manufacture shall, if the plaintiff demands it, be dealt with in such manner that abuse with the same may not take place. Anybody that during the time when he is being proceeded against for infringement under this section continues the same offense, shall, when he is lawfully convicted, be fined separately for each and every time summons for the offense has been made out and served upon him. Fines which are imposed in conformity to this section fall to the crown. If the full value of the fines be not forthcoming, common penal punishment shall be imposed in their place.

provisions hitherto observed, also any court, where the validity of a patent has been contested prior to the said date, may, notwithstanding the provisions of section 20, proceed with the case.

If letters patent have been issued according to prior laws and a patentee desires the same to be exchanged for another, granted pursuant to this law, he may lodge an application for that purpose with the patent authorities, when the provisions stated in this law shall be observed relative to the application, questions as to the novelty of the invention being decided with regard to the period when the former patent was granted. If a second patent is granted the period of its validity shall be considered to commence at the same date as that of the patent previously issued, and the annual fees to be paid shall be according to the date of the first patent.

Let all whom it concerns be obediently ruled by this law. For further confirmation of this Act, we have ratified it with our autograph signature and our royal seal, at the Castle of Stockholm, on the 16th of May, 1884.

(Signed)

OSCAR. [L. S.]

E. VON KRUSENSTJERNA. (Signed.)

From *Carpn. Pat. L. of World*, 527.

SWITZERLAND.

According to a report by Mr. Gould, of the British Legation, published November 18, 1873, in 4 *Pat. Off. Gaz.* 523, there were not, at the time of his writing, any special laws in the Swiss Confederation for the encouragement and protection of inventors.

According to dispatches from Frank H. Mason, United States Consul at Basle, dated in 1882, and published September 19, 1882, in 22 *Pat. Off. Gaz.* 947, the Federal Congress at Switzerland had then recently enacted an amendment to the Constitution of the Confederacy, the purpose of which amendment was to enable the Federal Assembly to enact a general patent law ; this prerogative having been previously reserved by the several cantonal governments. By the requirement of the Constitution, such amendment after its adoption by the assembly must be submitted to popular vote for ratification. Such submission took place July 20, 1882 ; when the proposed amendment was defeated. By the Constitutional Law of Switzerland, ten years must elapse before a defeated amendment can be again presented for popular approval.

See also INTERNATIONAL CONVENTION.

TAHITI.

See FRANCE.

TASMANIA.

An Act to Regulate the Granting of Letters Patent for Inventions ; No. XXII. of November 5, 1858.

[NOTE.*--The words "registrar of patents" † in italics are alterations made by the Amending Act of 1883.]

Preamble. Whereas it is expedient to promote and encourage the discovery and use of new manufactures, and to afford greater facilities for obtaining for a limited period the exclusive enjoyment thereof by means of letters patent : Be it therefore enacted by His Excellency the Governor of Tasmania, by and with the advice and consent of the Legislative Council and House of Assembly, in Parliament assembled, as follows :—

1. *Interpretation.* In the construction of this Act the following expressions shall have the meanings hereby assigned to them, unless such meanings are repugnant to or inconsistent with the context :

"Law officer" shall mean Her Majesty's attorney-general or solicitor-general for the time being of the Colony of Tasmania :

"Invention" shall mean any manner of new manufacture the subject of letters patent and grant of privilege within the meaning of this Act :

"Petition," "declaration," "specification," "appointment to hear application," "warrant," and "letters patent," respectively, shall mean instruments in the form and to the effect in the schedule, subject to such alterations as may, from time to time, be made therein under the powers and provisions of this Act.

2. *Power to grant letters patent for inventions.* It shall be lawful for the Governor, with the advice of the Executive Council, in the name and on behalf of Her Majesty the Queen, to make and issue, in the manner hereinafter mentioned, letters patent and grants of privilege for any term not exceeding fourteen years from the date thereof of the sole working or making of any manner of new manufactures within this colony to the true and first inventor of such manufactures, which others at the time of making such letters

* Notes printed in this form are from *Gaz.* 771, as act of November 5, 1885, and without the insertion of "Registrar

† This law is published in 32 Pat. Off. of Patents."

patent and grants do not use, so as also they be not contrary to law nor mischievous to the community by raising prices of commodities, or hurt of trade, or generally inconvenient.

3. *Governor to make rules for executing Act.* It shall be lawful for the Governor, with the advice of the Executive Council from time to time, to make such rules and regulations, not inconsistent with the provisions of this Act, as may appear to be necessary and expedient for the purposes of this Act; and all such rules and regulations shall be laid before both Houses of the Parliament of Tasmania within fourteen days after the making thereof if Parliament is then sitting, and if Parliament is not then sitting, then within fourteen days after the next meeting of Parliament.

4. *Mode of applying for letters patent for inventions.* Every application for the grant in this colony, under this Act, of letters patent for inventions, shall be made by petition to the Governor, the allegations of which petition shall be supported by a declaration, to be made and subscribed by the applicant, that he is the true and first inventor, and that the article has not to his knowledge or belief been before made or used in this colony; and such petitions and declarations shall be lodged at the office of the *registrar of patents*, and shall be in the form in the schedule, or to the like effect.

5. *On application for letters patent, inventor to deposit specification.—Specification may be amended before patent issues.* The applicant for letters patent for an invention shall, at the time of lodging such petition and declaration as aforesaid, deposit at the said office of the *registrar of patents* an instrument in writing under his hand and seal, hereinafter called a specification, particularly describing and ascertaining the nature of the said invention, and in what manner the same is to be performed, which specification shall be mentioned in and annexed to the declaration; and shall also then deposit at the said office a copy of such instrument, and of the drawings accompanying the same, if any; and the day of the deposit of every such specification shall be recorded at the said office and indorsed on such specification, and a certificate thereof given to such applicant or his agent; and thereupon, subject and without prejudice to the provisions hereinafter contained, the said invention shall be protected under this Act for the term of six months from the day of such deposit, and the applicant shall have during such term the like powers, rights, and privileges as might have been conferred upon him by letters patent for such invention issued under

this Act, and duly sealed as of the day of such deposit; and during the continuance of such powers, rights, and privileges under this provision, such invention may be used and published without prejudice to any letters patent to be granted for the same; and where letters patent are granted in respect of such invention, such letters patent shall be conditioned to become void if such specification does not particularly describe and ascertain the nature of the said invention, and in what manner the same is to be performed: Provided always, that in case the title of the invention or the said specification is too large or insufficient, it shall be lawful for the law officer during the said term of six months, and before the grant of the letters patent, to allow or require the same to be amended, or another and sufficient specification to be deposited in lieu of such specification as aforesaid; and every such amended or new specification shall have the same force, effect, and operation as if it had been originally deposited in its amended or new state.

6. *Forms and size of specification and copy.* Every such specification shall be in the form in the schedule, or to the like effect, and shall be written upon parchment upon both sides, and every page thereof shall be of the exact size of twenty inches in length by fifteen inches in breadth, leaving a margin of at least one inch and a-half on each side of every such page in order and to the intent that the same may be bound into books for safe custody, but the drawings accompanying such specifications, if any, may be made upon larger sheets of parchment, leaving a margin of the size and for the purpose aforesaid; and every copy of any such specification as aforesaid, and of the drawings accompanying the same, if any, shall in like manner be written upon paper of the size and with the margins aforesaid.

7. *Petition of true inventor not to be affected by protection obtained in fraud of true inventor.* In case of any application for letters patent for an invention, and the obtaining of protection for the same by reason of the deposit of any such specification as aforesaid in fraud of the true and first inventor, any letters patent granted to the true and first inventor of such invention shall not be invalidated by reason of such application or of such protection as aforesaid, or of any use or publication of the invention subsequent to such application and before the expiration of the said term or protection.

8. *Mode of proceeding after deposit of specification.* The applicant, so soon as he thinks fit after the deposit of such specification as

aforesaid, and of the drawings and models accompanying the same, if any, may give notice in writing at the office of the law-officer of his intention to proceed with his application for letters patent for the said invention, stating in such notice the title of the said invention, and the day on which the specification thereof was deposited at the office of the *registrar of patents*, and shall at the time of giving such notice produce the certificate of deposit; and thereupon the law-officer shall deliver to the applicant or his agent an appointment to hear the application in the form in the schedule, or to the like effect; and such applicant or agent shall cause the said appointment to be published once in the Gazette and twice in some newspaper published in Hobart Town and in Launceston; and any person having an interest in opposing the grant of letters patent for the said invention shall be at liberty to leave particulars in writing of their objections to the said application at the office of the law officer within such time, not being less than one month, as the law officer by such appointment may direct.

9. *Law officer to hear application and objections.* At the time and place named in the said appointment the applicant shall produce the Gazette and newspapers containing the same; and the law officer shall thereupon hear and consider the said application, and all objections to the same mentioned in the said particulars, if any, and for that purpose shall obtain from the office of the *registrar of patents* the copy of the specification and of the drawings and models accompanying the same, if any; and the law officer may call to his aid such scientific or other person as he may think fit, and may cause such remuneration to be paid to such person as he thinks proper: Provided always, that the applicant, the objectors, and their respective witnesses and evidence, shall be respectively heard, examined, and considered separately and apart from and in the absence of the other and his witnesses and evidence.

10. *Law officer may order by and to whom costs to be paid.* It shall be lawful for the law officer, if he sees fit, by certificate under his hand, to order by and to whom the costs and expenses of any hearing or inquiry upon any objection, or otherwise in relation to the grant of such letters patent, shall be paid, and in what manner and by whom such costs are to be ascertained; and if any costs so ordered to be paid are not paid within four days after the amount thereof is so ascertained, it shall be lawful for such law officer to make an order for the payment of the same; and every such order may be made a rule of the Supreme Court.

11. *Law officer may issue warrant for sealing letters patent.* It shall be lawful for the law officer, after such hearing and consideration as he may think fit, to issue a warrant under his hand and seal for the sealing of letters patent for the said invention, and such warrant shall set forth the tenor and effect of the letters patent thereby authorized to be granted, and shall direct the insertion in such letters patent of all such restrictions, conditions, and provisos as the law officer may deem usual and expedient in such grants, or necessary in pursuance of the provisions of this Act; and the said warrant shall be the warrant for the making and sealing of letters patent under this Act according to the tenor of the said warrant; and every such warrant shall be in the form in the schedule or to the like effect.

12. *Writ of scire facias.* The writ of scire facias shall lie for the repeal of any letters patent issued under this Act in the like cases as the same would lie in England for the repeal of letters patent which may now be issued under the Great Seal; and in case the grantee does not reside in this colony, it shall be sufficient to file such writ in the proper office of the Supreme Court, and serve notice thereof in writing at the last known residence or place of business of such grantee.

13. *Nothing to affect prerogatives of Crown in granting or withholding letters patent.* Nothing herein contained shall extend to abridge or affect the prerogatives of the Crown in relation to the granting or withholding the grant of any letters patent; and it shall be lawful for the Governor in Council to direct such law officer to withhold such warrant as aforesaid, or that any letters patent for the issuing whereof he may have issued a warrant as aforesaid shall not issue, or to direct the insertion in any such letters patent of any restrictions, conditions, or provisos, in addition to or in substitution of any restrictions, conditions, or provisos which would otherwise be inserted therein under this Act; and it shall also be lawful for the Governor in Council to direct the specification in respect of the invention described to be canceled in any case in which letters patent may have been refused to be granted, and thereupon the protection obtained by the deposit of such specification shall cease.

14. *Letters patent to be void on non-performance of conditions.* All letters patent for inventions granted under this Act shall be in the form in the schedule or to the like effect, and be made subject to the condition that the same shall be void, and that the powers

and privileges thereby granted shall cease and determine, at the expiration of three years and seven years respectively from the date thereof, unless there is paid before the expiration of the said three and seven years respectively the sum or sums of money in that behalf by this Act required to be paid; and the colonial treasurer shall issue under his hand a certificate of such payment, and shall indorse a receipt for the same on the letters patent.

15. *Registrar of patents to issue letters patent.* The registrar of patents, so soon after the receipt by him of the said warrant as he is required by the applicant, shall cause to be prepared letters patent for the invention according to the tenor of the said warrant; and it shall be lawful for the Governor in Council to cause such letters patent to be sealed with the seal of the colony; and such letters patent shall be made applicable to this colony, and shall be valid and effectual within the same.

16. *Letters patent to be issued within certain time.* Save as hereinafter mentioned, no letters patent shall issue on any warrant granted as aforesaid unless application is made to seal such letters patent within three months after the date of the said warrant, nor shall any letters patent be issued or be of any force or effect unless such letters patent are granted during the continuance of the protection conferred under this Act by reason of such deposit as aforesaid.

17. *Letters patent may issue after that time in certain cases.* Where the letters patent have not been sealed during the continuance of such protection as aforesaid, and the delay in such sealing has arisen from accident and not from the neglect or willful default of the applicant, it shall be lawful for the Governor, if he thinks fit, to seal such letters patent at any time, not being more than one month after the expiration of such protection; and where the applicant for letters patent dies during the continuance of such protection as aforesaid, such letters patent may be granted to the executors or administrators of such applicant during the continuance of such protection, or at any time within three months after the death of such applicant, notwithstanding the expiration of the term of such protection; and the letters patent so granted by virtue of this section shall be of the like force and effect as if they had been granted to such applicant during the continuance of such protection; and in case any letters patent are destroyed or lost, other letters patent of the like tenor and effect, and sealed and dated as of the same day, may, subject to such regulations as the Governor in

Council may direct, be issued under the authority of the warrant in pursuance of which the original letters patent were issued.

18. *Letters patent to bear date of the deposit of specification and to be conclusive as to preliminary steps and proceedings.* Notwithstanding any law to the contrary, all letters patent to be issued in pursuance of this Act shall be sealed and bear date as of the day of the deposit of such specification as aforesaid ; and such letters patent shall be of the same force and validity as if they had been sealed on the day as of which the same are expressed to be sealed and bear date ; and after any letters patent have been issued under this Act it shall not be necessary or material to inquire or ascertain whether such appointment to hear the application as aforesaid has or has not been delivered and published in the manner hereinbefore mentioned and directed.

19. *Letters patent for foreign inventions not to continue after expiration of foreign patent.* Where upon any application made under this Act letters patent are granted for or in respect of any invention first invented in parts out of this colony, and a patent or the like privilege for the monopoly or exclusive use or exercise of such invention in any part out of this colony is there obtained before the grant of such letters patent in this colony, all rights and privileges under such letters patent shall, notwithstanding any term in such letters patent limited, cease and be void immediately upon the expiration or other determination of the term during which the patent or like privilege obtained in such part out of this colony continues in force, or where more than one such patent or like privilege is obtained abroad, immediately upon the expiration or determination of the term which first expires or is determined of such several patents or like privileges : Provided always, that no letters patent for or in respect of any invention for which any such patent or like privilege as aforesaid has been obtained abroad, granted in this colony after the expiration or determination of the term for which such patent or privilege was granted or was in force, shall be of any validity.

20. *Letters patent not to prevent the use of inventions on foreign ships resorting to ports of this colony.* No letters patent for any invention granted in pursuance of this Act shall extend to prevent the use of such invention in any foreign ship or vessel, or for the navigation of any foreign ship or vessel which may be in any port of this colony, or in any of the waters within the jurisdiction of any of Her Majesty's courts in this colony, where such invention is not

so used for the manufacture of any goods or commodities to be vended within or exported from this colony : Provided always that this enactment shall not extend to the ships or vessels of any foreign State, the laws of which authorize subjects of such foreign State having patents or like privileges for the exclusive use or exercise of inventions within its territories to prevent or interfere with the use of such inventions in British ships or vessels, or in or about the navigation of British ships or vessels while in the ports of such foreign State, or in the waters within the jurisdiction of its courts, where such inventions are not so used for the manufacture of goods or commodities to be vended within or exported from the territories of such foreign State.

21. *Specifications, &c. to be filed.* Every specification deposited at the office of the *registrar of patents* as aforesaid, and the drawings and models accompanying the same, if any, and all such petitions and declarations, as aforesaid, shall forthwith after the grant of the letters patent, or if no letters patents are granted then immediately on the expiration of six months from the time of such deposit, or upon the specification being so canceled as aforesaid, be transferred to, kept, and filed in such office as the Governor in Council from time to time appoints for that purpose ; and the copies of such specifications, and the drawings and models, if any, accompanying the same, shall also be forwarded to and kept at the same office.

22. *Application to disclaim or make alterations.* Any person who obtains letters patent under this Act, or in case such person parts with the whole or any part of his interest by assignment, such person together with the assignee if part only has been assigned, or the assignee alone if the whole has been assigned, may apply to the law officer for leave to enter a disclaimer of any part of either the title of the invention or of the specification, or a memorandum of any alteration in the said title or specification, not being such a disclaimer or such an alteration as extends the exclusive right granted by the said letters patent; and thereupon the law officer shall deliver to such applicant or his agent an appointment to hear such application in the form in the schedule or to the like effect ; and such applicant or his agent shall thereupon cause such disclaimer, stating the reason for the same, or such memorandum of alteration, to be written at the foot of the said appointment, and cause the same respectively to be published in the manner hereinbefore required with respect to the publication of the appointment

to hear an application for letters patent ; and any person having an interest in opposing the said application shall be at liberty to leave particulars in writing of their objections to the same at the office of the law officer, within such time not being less than one month as the law officer, by such appointment, may direct : Provided always, that where such application as aforesaid is for leave to enter a disclaimer of any part of the title of the said invention or a memorandum of any alteration in such title, the law officer may dispense with such appointment and publication, and in that case shall certify in the fiat hereinafter mentioned that he has dispensed with the same.

23. *Law officer to hear applications for leave to disclaim.* At the time and place named in such appointment the applicant shall produce the Gazette and newspapers containing the same, and the said disclaimer, or memorandum of alteration at the foot thereof ; and the law officer shall thereupon hear and consider the said application, and all objections to the same mentioned in the said particulars, if any, and all such power and authority shall and may be exercised upon that occasion by the law officer as by virtue of the provisions hereinbefore contained can and may be exercised in relation to the hearing and considering an application for letters patent and objections to the same, and shall and may be enforced in like manner.

24. *Disclaimers and alterations to be entered and filed.* After such hearing and consideration, or without such hearing and consideration where the said appointment and publication have been dispensed with as aforesaid, such applicant may, by leave of the law officer, to be certified by a fiat under his hand to be written at the foot of the same parchment with the disclaimer or memorandum, enter such disclaimer, stating the reason for the same, or such memorandum of alteration ; and such disclaimer or memorandum of alteration and fiat shall be filed in the office in which specifications are appointed to be filed as aforesaid, with the specification of the invention to which the same relate ; and such disclaimer or memorandum of alteration, being so filed in such office, shall be deemed and taken to be part of the letters patent or the specification, and subject to the several incidents thereof, in all courts whatever, and shall be valid and effectual in favor of any person in whom the rights under the said letters patent may then be or thereafter become legally vested ; and such filing of any disclaimer or memorandum of alteration in pursuance of the leave of the law officer certified as aforesaid shall, except in cases of fraud, be con-

clusive as to the right of the party to enter such disclaimer or memorandum of alteration under this Act, and no objection shall be allowed to be made in any proceeding upon or touching such letters patent, specification, disclaimer or memorandum of alteration, on the ground that the person entering such disclaimer or memorandum of alteration had not sufficient authority in that behalf : Provided always, that no action shall be brought upon any letters patent in which or on the specification of which any disclaimer or memorandum of alteration has been filed in respect of any infringement committed prior to the filing of such disclaimer or memorandum of alteration, unless the law officer certifies in his said fiat that any such action may be brought, notwithstanding the entry or filing of such disclaimer or memorandum of alteration ; and that no such disclaimer or memorandum of alteration shall be receivable in evidence in any action or suit, save and except in any proceeding by scire facias pending at the time when such disclaimer or alteration was filed as aforesaid, but in every such last mentioned action or suit the original title and specification alone shall be given in evidence, and be deemed and taken to be the title and specification of the invention for which the letters patent have been granted : Provided also, that when any such fiat has been issued under this Act, it shall not be necessary or material to inquire or ascertain whether such appointment as last aforesaid has or has not been delivered and published or dispensed with in accordance with this Act.

25. Specifications, &c., to be open to inspection. All specifications, and the drawings and models accompanying the same, if any, and all petitions, declarations, disclaimers, and memoranda of alterations filed in the office appointed for filing specifications under and in pursuance of this Act, and also the copies of the specifications, and drawings and models accompanying the same, if any, kept at the said office, shall be open to the inspection of the public at all reasonable times, subject to such regulations as the Governor in Council may appoint in that behalf.

26. Mode of obtaining extension of the term. If any person having obtained letters patent under this Act, or in case such person has parted with his whole or any part of his interest by assignment, if such person, together with the assignee where part only has been assigned, or if the assignee alone where the whole has been assigned, six months before the expiration or other determination of such letters patent, presents to the Governor a petition

for the extension of the term in such letters patent mentioned, and sets forth in such petition that he has been unable to obtain a due remuneration for his expense and labor in perfecting such invention, and that an exclusive right of using and vending the same for some further period to be named in such petition, in addition to the said term, is necessary for his reimbursement and remuneration, it shall be lawful for the Governor in Council to refer the consideration of the said petition to commissioners to be appointed for that purpose in the manner hereinafter mentioned.

27. Mode of obtaining confirmation of invalid patent. If in any suit or action it is proved or specially found by the verdict of a jury that any person who has obtained letters patent for any invention or supposed invention was not the first inventor thereof, or of some part thereof, by reason of some other person having invented or used the same or some part thereof in this colony, before the date of such letters patent, or if such patentee or his assigns discover that some other person had, unknown to such patentee, invented or used the same or some part thereof in this colony before the date of such letters patent, such patentee or his assigns may petition the Governor to confirm the said letters patent, or to grant new letters patent, and it shall be lawful for the Governor in Council to refer the consideration of the said petition to commissioners to be appointed for that purpose in the manner hereinafter mentioned.

28. Appointment of commissioners. For the purpose of considering any such petition as aforesaid, it shall be lawful for the Governor in Council, if he thinks fit, to issue and direct a commission in the name of Her Majesty to five or more persons, of whom the judges of the Supreme Court shall be two, reciting such petition and requiring or authorizing such persons or any three of them, of whom one of the said judges shall be one, to meet at some time, not being less than two months from the publication of the said commission in the Gazette, and at some place to be fixed in the said petition, and to report to the Governor, in case the petitioner prays for an extension of the term in the letters patent mentioned, whether any, and if any what, further extension of the said term should be granted, or in case the petitioner prays for a confirmation of the letters patent or for a grant of new letters patent, whether such confirmation or grant should be made, and upon what, if any, conditions the prayer of any such petition should be complied with.

29. Notice of commission to be published and caveats entered.

Two months at least before the time named in the commission for the consideration of any such petition as aforesaid, the petitioner shall cause an advertisement of the contents of the said commission, in the form in the schedule or to the like effect, to be published in the same manner as is hereinbefore required with respect to the publication of the appointment to hear an application for letters patent ; and any person having an interest in opposing the said petition shall be at liberty to enter a caveat against the same at the office of the *registrar of patents*, at any time not being less than one week before the time named in the commission for the execution thereof.

30. *Commissioners to hear all parties and report.* At the time and place fixed in the commission for that purpose the commissioners, shall meet and proceed to consider such petition ; and the petitioner shall be heard by his counsel and witnesses to prove his case as stated in such petition, and the publication of the said last mentioned advertisement as required by this Act ; and the persons entering caveats shall likewise be heard by their counsel and witnesses ; and all such witnesses shall be examined upon oath, which oath any one of the commissioners is hereby authorized and required to administer ; and the proceedings before the said commissioners may be adjourned from time to time as may be necessary.

31. *Extension of term may be granted.—Invalid patents may be confirmed.—Parties to actions to have notice of petitions.* If upon hearing and inquiry of the whole matter the commissioners, in case the petitioner prays for an extension as aforesaid, are of opinion, and so report, that a further extension of the said term should be granted, it shall be lawful for the Governor in Council, if he thinks fit, to grant to the petitioner new letters patent for the said invention for any term not exceeding fourteen years after the expiration of the term of the first letters patent, anything hereinbefore contained to the contrary in anywise notwithstanding ; and if the commissioners, in case the petitioner prays for a confirmation or grant as aforesaid, upon examining the said matter, and being satisfied that such patentee as aforesaid believed himself to be the first and original inventor, and that such invention, or part thereof, had not been publicly and generally used in this colony before the date of the first letters patent, report their opinion that the prayer of such petition ought to be complied with, the Governor in Council may, if he thinks fit, grant such prayer ; and the said letters patent shall be available at law and in equity to give to such peti-

tioner the sole right of using, making, and vending such invention as against all persons whatsoever, anything hereinbefore contained to the contrary notwithstanding : Provided, that any person, party to any former suit or action touching any such first letters patent as in this section are mentioned, shall be entitled to have notice in writing of the time and place fixed as aforesaid for the first meeting of the said commissioners to consider the said petition ; and that after any such report has been made it shall not be material or necessary to inquire or ascertain whether any such advertisement as last aforesaid has or has not been published, or whether any such notice as last aforesaid has or has not been given in the manner hereinbefore directed in that behalf.

32. *Conditions may be inserted in new patents.—Date of new patents.* It shall be lawful for the Governor in Council to insert in any such new letters patent as in the preceding section are mentioned any restrictions, conditions, and provisions which may be recommended by the commissioners in their report, or which to the Governor in Council may seem proper ; and such new letters patent shall be sealed and bear date as of the day after the expiration of the term of the first letters patent.

33. *Indexes to specifications, &c.* The Governor may cause indexes to all specifications, declarations, disclaimers, and memoranda of alterations, deposited and filed as aforesaid, to be prepared in such form as may be thought fit ; and such indexes shall be open to the inspection of the public, subject to the regulations to be made by the Governor.

34. *Register of patents to be kept.* There shall be kept at the office appointed for filing specifications as aforesaid a book, to be called the “Register of Patents,” wherein shall be entered and recorded in chronological order all letters patents granted under this Act,—the deposit and filing of specifications, disclaimers and memoranda of alterations filed in respect of such letters patent,—all amendments in such letters patent and specifications,—all confirmations and extensions of such letters patent, the expiry, determination, vacating, or canceling of such letters patent, with the dates thereof respectively,—and all such other matters and things affecting the validity of such letters patent as the Governor in Council may direct ; and such register or a copy thereof, shall be open at all convenient times to the inspection of the public, subject to such regulations as the Governor may make in that behalf.

35. *Register of Proprietors to be kept.* There shall be kept at

the same office a book, entitled the "Register of Proprietors," wherein shall be entered, in such manner as the Governor directs, the assignment of any letters patent, or of any share or interest therein,—any license under letters patent, and the district to which such license relates, with the name or names of any person having any share or interest in such letters patent or license,—the date of his or their acquiring such letters patent, share, and interest,—and any other matter or thing relating to or affecting the proprietorship in such letters patent or license; and a copy of any entry in such book, certified as hereinafter mentioned, shall be given to any person requiring the same, and shall be *prima facie* proof of the assignment of such letters patent, or share or interest therein, or of the license or proprietorship, as therein expressed; and such register or a copy thereof shall be open to public inspection, subject to such regulations as the Governor may make: Provided always, that until such entry has been made, the grantee of the letters patent shall be deemed and taken to be the sole and exclusive proprietor of such letters patent, and of all the licenses and privileges thereby given and granted.

36. *More than twelve persons may be interested in patent.* It shall be lawful for a larger number than twelve persons to have a legal and beneficial interest in letters patent granted under this Act.

37. *Certified copies to be evidence.* The Governor may cause a seal to be made for the purposes hereinafter mentioned; and all courts, judges, and other persons whomsoever shall take notice of such seal, and receive impressions thereof in evidence in like manner as impressions of the seal of the colony are received in evidence; and copies or extracts, certified and sealed with such seal, of letters patent, specifications, disclaimers, memoranda of alterations, and all other documents or books recorded, filed, and kept in pursuance of this Act, shall be received in evidence in all proceedings relating to letters patent for inventions in all courts, and by all judges and other persons whomsoever.

38. *Falsification or forgery of entries.* If any person willfully makes, or causes to be made, any false entry in the said Register of Proprietors, or willfully makes or forges, or causes to be made or forged, any writing falsely purporting to be a copy of any entry in the said book, or produces or tenders, or causes or suffers to be produced or tendered in evidence, any such writing knowing the same to be false or forged, he shall be guilty of a misdemeanor, and shall

be liable to be imprisoned, with or without hard labor, for any term not exceeding two years, or to be fined and imprisoned at the discretion of the court.

39. *Entries may be expunged from Register of Proprietors.* If any person deems himself aggrieved by any entry made under color of this Act, in the said Register of Proprietors, it shall be lawful for such person to apply by motion to the Supreme Court in term time, or by summons to a judge of such court in vacation, for an order that such entry may be expunged, vacated, or varied; and upon any such application, such court or judge respectively may make such order for expunging, vacating, or varying such entry, and as to the costs of such application, as to such court or judge may seem fit; and the officer having the care and custody of such Register, on the production to him of any such order, shall expunge, vacate, or vary the said entry according to the requisition of such order.

40. *Penalty for unauthorized use of word "patent."* If any person writes, paints, prints, moulds, casts, carves, engraves, stamps, or otherwise marks upon anything made, used, or sold by him, for the sole making or selling of which he has not obtained letters patent, the name or any imitation of the name of any other person who has obtained letters patent for the sole making and vending of such thing, without leave in writing of such patentee or his assigns, or if any person upon such thing, not having been purchased from the patentee, or some person who purchased it from or under such patentee, or not having had the license or consent in writing of such patentee or his assigns, writes, paints, prints, moulds, casts, carves, engraves, stamps, or otherwise marks the word "patent," the words "letters patent," or the words "by the Queen's patent," or any words of the like kind, meaning, or import, with a view of imitating or counterfeiting the stamp, mark, or other device of the patentee, he shall for every such offense forfeit and pay the sum of one hundred pounds, one half to Her Majesty, and the other half with full costs of suit to any person who sues for the said penalty by action of debt: Provided always, that nothing herein contained shall be construed to extend to subject any person to any penalty in respect of stamping or in any way marking the word "patent" upon anything made for the sole making or vending of such letters patent before obtained have expired or been otherwise determined.

41. *In actions for infringement, particulars of breaches and objections to be delivered.* In any action for the infringement of letters patent the plaintiff shall deliver with his declaration particu-

lars of the breaches complained of in the said action, and the defendant on pleading thereto shall deliver with his pleas, and the prosecutor in any proceeding by scire facias to repeal letters patent shall deliver with his declaration, particulars of any objections on which he means to rely at the trial in support of the pleas in the said action, or of the suggestions of the said declarations in the proceeding by scire facias respectively ; and at the trial or proceeding by scire facias no evidence shall be allowed to be given in support of any alleged infringement or of any objection impeaching the validity of such letters patent which are not contained in the particulars delivered as aforesaid : Provided always, that the place at or in which and in what manner the invention is alleged to have been used or published prior to the date of the letters patent shall be stated in such particulars : Provided also, that it shall and may be lawful for any judge at chambers to allow such plaintiff or defendant or prosecutor respectively to amend the particulars delivered as aforesaid, upon such terms as to such judge seems fit. Provided also, that at the trial of any proceeding by scire facias to repeal letters patent the defendant shall be entitled to begin and to give evidence in support of such letters patent ; and in case evidence is adduced on the part of the prosecutor impeaching the validity of such letters patent, the defendant shall be entitled to the reply.

42. *Court may grant injunction in case of infringement.* In any action for the infringement of letters patent, it shall be lawful for the court, if the court is then sitting, or if the court is not sitting then for a judge, on the application of the plaintiff or defendant respectively, to make such order for an injunction, inspection, or account, and to give such direction respecting such action, injunction, inspection, and account, and the proceedings therein respectively, as to such court or judge may seem fit.

43. *Particulars to be regarded in taxing costs.* In taxing the costs in any action for infringing letters patent, regard shall be had to the particulars delivered in such action, and the plaintiff and defendant respectively shall not be allowed any costs in respect of any particular unless certified by the judge before whom the trial was had to have been proved by such plaintiff or defendant respectively, without regard to the general costs of the cause ; and it shall be lawful for the judge before whom any such action is tried to certify on the record that the validity of the letters patent in the declaration mentioned came in question : and the record with such

certificate being given in evidence in any suit or action for infringing the said letters patent, or in any proceeding by scire facias to repeal the letters patent, shall entitle the plaintiff in any such suit or action, or the defendant in such proceeding by scire facias, on obtaining a decree, decretal order, or final judgment, to his full costs, charges, and expenses, taxed as between attorney and client, unless the judge making such decree or order, or the judge trying such action or proceeding, certifies that the plaintiff or defendant respectively ought not to have such full costs.

44. *Fees on obtaining patents.* There shall be paid in respect of letters patent applied for or issued under or in pursuance of this Act, the depositing of specifications, the filing of disclaimers and memoranda of alterations, certificates, entries, and searches, and other matters and things respectively mentioned in the schedule, such fees as are enumerated in the schedule; and such of the said fees as are hereby made payable to the law officer shall and may be received and retained by such law officer for his own proper use; and the residue of the said fees shall form part of the general revenue, and shall be forthwith paid into the colonial treasury by the persons receiving the same in pursuance of this Act.

45. *English patents.* All letters patent which are granted in the United Kingdom of Great Britain and Ireland after the 30th day of June, 1859, for any invention, shall, so far as the same relate to this colony, be utterly void and of none effect, and in nowise be put in execution; but all such letters patent granted in the said United Kingdom on or before that day, and which if this Act had not been passed would have been valid in this colony, shall be deemed and taken to have been granted under this Act, and may be dealt with accordingly.

46. *Forms in schedule may be varied.* The Governor in Council may, if he thinks fit, vary and alter the several forms in the schedule as occasion may require.

47. *Short title.* In referring to this Act it shall be sufficient to use the expression the Patent Law Act.

SCHEDULE.

FORMS.

Petition.

No.

To His Excellency the Governor of the Colony of Tasmania.

The humble petition of [*here insert name and address of petitioner,*] for, &c.
Showeth,—

That your petitioner is in possession of an invention for [*the title of the invention,*] which invention he believes will be of great public utility; that he is the true and first inventor thereof; and that the same has not been before made or used in this colony by any other person or persons, to the best of his knowledge and belief.

Your petitioner therefore humbly prays that Your Excellency will be pleased to grant unto him, his executors, administrators, and assigns, letters patent for the term of fourteen years, pursuant to the provisions of the Patent Law Act.

And your petitioner will ever pray, &c.

Declaration.

No.

I, *A. B.*, of _____, in Tasmania, do hereby solemnly and sincerely declare that I am in possession of an invention for, &c. [*the title as in petition*], which invention I believe will be of great utility; that I am the true and first inventor thereof; and that the same has not been before made or used in this colony by any other person or persons, to the best of my knowledge and belief; and that the instrument in writing under my hand and seal, hereunto annexed, particularly describes and ascertains the nature of the said invention, and the manner in which the same is to be performed; all which matters I conscientiously believe to be true; and I make this declaration under the provisions of the Act of Council, entitled *An Act for the abolition of extra-judicial and unnecessary Oaths*.

A. B.

Taken before me, this _____ day of _____, 18 _____.

*C. D.,
Justice of the Peace.*

Specification.

No.

To all to whom these presents come,

I, *A. B.*, of _____, in Tasmania, Engineer, send greeting:—

Whereas I am desirous of obtaining letters patent for securing unto me Her Majesty's special license that I, my executors, administrators, and assigns, or such others as I or they should at any time agree with, and no others, should and lawfully might from time to time, and at all times during the term of fourteen years, to be computed from the day on which this instrument is left at the office of the *registrar of patents* at Hobart Town, make, use, exercise, and vend within the Colony of Tasmania, an invention for

[insert the title of the invention] ; and in order to obtain the said letters patent, I must by an instrument in writing under my hand and seal particularly describe and ascertain the nature of the said invention, and in what manner the same is to be performed: Now know ye, that I, the said *A. B.*, do hereby declare the nature of the said invention, and the manner in which the same is to be performed, to be particularly described and ascertained in and by the following statement ; that is to say [describe the invention].

In witness whereof I, the said *A. B.*, have hereunto set my hand and seal this
day of _____, 18 . *A. B.* (L. S.)

Appointment to hear Application for Letters Patent.

Patent for [insert the title as in specification]. This is to notify that *A. B.*, of _____, in Tasmania, Engineer, did on the _____ day of _____ instant [or last] deposit at the office of the registrar of patents at Hobart Town a specification or instrument in writing under his hand and seal particularly describing and ascertaining the nature of the said invention, and in what manner the same is to be performed, and that by reason of such deposit the said invention is protected and secured to him exclusively for the term of six months then next ensuing: And I do further notify that the said *A. B.* has given notice in writing at my office of his intention to proceed with his application for letters patent for the said invention, and that I have appointed [Thursday] the _____ day of _____ next, at _____ o'clock in the noon, at my office, to hear and consider the said application, and all objections thereto ; and I do hereby require all persons having an interest in opposing the grant of such said letters patent, to leave before that day at my office at Hobart Town particulars in writing of their objections to the said application, otherwise they will be precluded from urging the same.

Given under my hand this _____ day of _____, 18 .
F. S., [Attorney] General,
Macquarie Street, Hobart Town.

Warrant.

I have heard and considered the application of *A. B.*, of _____, in Tasmania, Engineer, for letters patent for [insert the title as in the specification], and [also all objections to the same, if any], and having perused the specification and the usual and necessary advertisements, am of opinion that as it is entirely at the hazard of the said applicant whether the said invention is new and will have the desired success, letters patent may be issued to the said *A. B.*, in the form contained in the schedule to the Patent Law Act ; [with the following additional clauses ; that is to say, here set them out if any].

Given under my hand and seal, this _____ day of _____, 18 .
F. S. (L. S.),
[Attorney] General.

Letters Patent.

VICTORIA, by the Grace of God, of the United Kingdom of Great Britain and Ireland
Queen, Defender of the Faith:—

To all whom these presents come, greeting:—

Whereas *A. B.*, of _____, in _____, Tasmania, Engineer, has represented

that he is desirous of obtaining letters patent for securing unto him our special license that he, his executors, administrators, and assigns, and such others as he or they should agree with, and no others, should and lawfully might, make, use, exercise, and vend within our Colony of Tasmania an invention for [*insert the title of the invention*]; and by an instrument in writing under his hand and seal deposited in the office of the *registrar of patents*, the said *A. B.* has particularly described and ascertained the nature of the said invention, and in what manner the same is to be performed.

And we, being willing to give encouragement to all arts and inventions which may be for the public good, are graciously pleased to confer upon the said *A. B.* the privileges hereinafter mentioned: Know ye, therefore, that we, of our especial grace, certain knowledge, and mere motion, have given and granted, and by these presents, for us, our heirs, and successors, do give and grant under the said *A. B.*, his executors, administrators, and assigns, our especial license, full power, sole privilege, and authority that he the said *A. B.*, his executors, administrators, and assigns, and every of them, by himself and themselves, and his or their deputy or deputies, servants or agents, or such others as he or they at any time agree with, and no others, during the term herein expressed, shall and lawfully may, make, use, exercise, and vend his said invention within our said colony, in such manner as to him, his executors, administrators, and assigns, or any of them, seems meet, and that he, his executors, administrators, and assigns, shall and lawfully may have and enjoy the whole profit, benefit, commodity, and advantage, from time to time coming, growing, accruing, and arising by reason of the said invention during the said term; to have, hold, exercise, and enjoy the said licenses, powers, privileges, and advantages unto and by the said *A. B.*, his executors, administrators, and assigns, for and during and unto the full end and term of fourteen years now next ensuing: And to the end that the said *A. B.*, his executors, administrators, and assigns, and every of them, may have and enjoy the full benefit, and the sole use and exercise, of the said invention according to our gracious intention, we do by these presents, for us, our heirs and successors, require and strictly command all and every person and persons, bodies politic and corporate, and all other our subjects whatsoever of what estate, quality, degree, name, or condition soever they be, within our said colony, that neither they nor any of them at any time during the said term, either directly or indirectly, do make, use, or put in practice the said invention or any part of the same so attained unto by the said *A. B.* as aforesaid, nor in anywise counterfeit, imitate, or resemble the same, nor make or cause to be made any addition thereunto or subtraction from the same whereby to pretend himself or themselves the inventor or inventors, deviser or devisors thereof, without the consent, license, or agreement of the said *A. B.*, his executors, administrators, or assigns, in writing under his or their hands and seals first had and obtained in that behalf, upon such pains and penalties as can or may be justly inflicted on such offenders for their contempt of this our Royal command, and further to be answerable to the said *A. B.*, his executors, administrators, and assigns, according to law, for his and their damages thereby occasioned: Provided always, and these our letters patent are and shall be upon this condition, that if at any time during the said term hereby granted it appears that this our grant is contrary to law or prejudicial or inconvenient to our subjects in general, or that the said invention is not a new invention as to the public use and exercise thereof, or that the said *A. B.* is not the true and first inventor thereof within this colony, these our letters patent shall forthwith cease, determine,

and be utterly void to all intents and purposes, anything hereinbefore contained to the contrary thereof in anywise notwithstanding: Provided also, that these our letters patent, or anything herein contained, shall not extend or be construed to extend to give privilege unto the said *A. B.*, his executors, administrators, or assigns, or any of them, to use or imitate any invention or work whatsoever which has heretofore been found out or invented by any other of our subjects whatsoever and publicly used or exercised, unto whom our like letters patent or privileges have been already granted for the sole use, exercise, and benefit thereof, within our said colony: It being our will and pleasure that the said *A. B.*, his executors, administrators, and assigns, and all and every other person and persons to whom like letters patent or privileges have been already granted as aforesaid, shall distinctly use and practice their several inventions by them invented and found out according to the true intent and meaning of the same respective letters patent, and of these presents: Provided likewise nevertheless, and these our letters patent are upon this express condition, that if the said instrument in writing does not particularly describe and ascertain the nature of the said invention, and in what manner the same is to be performed, and also if the said *A. B.*, his executors, administrators, and assigns, shall not pay at the office of the colonial treasurer of our said colony the sum of fifteen pounds within three years next after the date of these presents, and the sum of twenty pounds within seven years next after such date, and also if the said *A. B.*, his executors, administrators, or assigns shall not supply or cause to be supplied for our service all such articles of the said invention as he or they are required to supply by the persons administering the department of our service for the use of which the same are required, in such manner, at such times and at and upon such reasonable prices and terms as are settled for that purpose by the said persons requiring the same, that then and in any of the said cases these our letters patent, and all liberties and advantages whatsoever hereby granted, shall utterly cease, determine, and become void, anything hereinbefore contained to the contrary thereof in anywise notwithstanding: Provided that nothing herein contained shall prevent the granting of licenses in such manner and for such considerations as they may by law be granted: And lastly we do by these presents, for us, our heirs, and successors, grant unto the said *A. B.*, his executors, administrators, and assigns, that these our letters patent shall be in and by all things good, firm, valid, sufficient and effectual in the law according to the true intent and meaning thereof, and shall be taken, construed, and adjudged in the most favorable and beneficial sense for the best advantage of the said *A. B.*, his executors, administrators, and assigns, as well in all our courts of record as elsewhere, and by all and singular the officers and ministers whatsoever of us, our heirs and successors, in our said colony, and amongst all and every the subjects of us, our heirs and successors, whatsoever and wheresoever, notwithstanding the not full and certain describing the nature or quality of the said invention, or of the materials thereunto conducing and belonging. In witness whereof we have caused these our letters patent to be made patent, and to be sealed and bear date as of the day of , 18 .

—

Appointment to hear Application for Leave to enter Disclaimer.

Patent for [*insert the title*]. This is to notify that C. D., of , in Tasmania, has applied to me for leave to enter a disclaimer of part of [*or, a memorandum of*

alteration in] the title of the said invention [*or as the case may be*] the particulars whereof are stated below; I do therefore appoint [*Thursday*], the day of next, at o'clock in the noon, at my office, to hear and consider the said application, and all objections to the same; and I do hereby require all persons having an interest in opposing the said application, to leave before that day, at my office at Hobart Town, particulars in writing of their objections to the same; otherwise they will be precluded from urging such objections.

Given under my hand, this day of , 18 .

*F. S. [Attorney] General,
Macquarie Street, Hobart Town.*

The following is the disclaimer [*or, as the case may be*] which I desire to make in, &c. [*The applicant must here set forth what he wishes to enter, and the reasons for the disclaimer, and sign it.*]

Notice of Appointment of Commission.

Patent for [*insert the title*]. Notice is hereby given that I have presented a petition to His Excellency the Governor, praying for the confirmation of [*or, extension of the term in, or, as the case may be*] the said patent; and that a commission has issued authorizing and requiring certain commissioners therein named to consider and report upon the subject to His Excellency the Governor, which said commissioners will meet for that purpose on the day of next, at o'clock in the noon at : All persons objecting to the said confirmation [*or extension, or, as the case may be*] must enter a caveat against the same at the office of the registrar of patents, Hobart Town, not less than one week before the time named for the said meeting, otherwise they will be precluded from objecting to the said petition.

Dated this day of , 18 .

A. B.

FEES.

Fees on obtaining Patents.

	£	s.	d.
On depositing specification.....	2	10	0
To the law officer for any appointment.....	2	4	6
On obtaining letters patent.....	2	10	0
At or before the expiration of the third year.....	15	0	0
At or before the expiration of the seventh year.....	20	0	0
To the law officer with particulars of objections.....	2	4	6
On presenting petition for extension or confirmation.....	2	10	0
Every search and inspection.....	0	1	0
Entry of assignment or license.....	0	10	0
Certificate of assignment or license.....	0	10	0
Filing disclaimer or memorandum of alteration.....	2	10	0
Entering any caveat.....	2	10	0
Copy or extract of any writing per common law folio.....	0	0	6

From *Carpin. Pat. L. of World*, 535.

•See also, AUSTRALASIA.

TRINIDAD.

Ordinance No. 25, of (September 2), 1867.

An Ordinance enacted by the Governor of Trinidad, with the advice and consent of the Legislative Council thereof, for amending the Law for granting Patents for Invention.

Be it it enacted by his Excellency the Governor, with the advice and consent of the Legislative Council, as follows :—

I. *On delivery of declaration and specification, the registrar-general to issue certificate to inventor.* The registrar-general, on an application by or on behalf of any person claiming to be the inventor within this colony of any invention, and on the delivery to such registrar-general of a declaration in writing according to the form in the schedule to this Ordinance, together with a specification signed by the applicant or his agent, particularly describing and ascertaining the nature of the invention and in what manner the same is to be performed, shall deliver to such person or his agent a certificate according to the form in the schedule to this ordinance, and a copy of such certificate shall be inserted by the registrar-general in the Royal Gazette.

II. *Specification may be open or if closed, opened in six months.* Any specification of an invention may be delivered to the registrar-general, open or closed, in an envelope, with a note of the name of the invention to which the specification refers indorsed on such envelope, and signed by the applicant or his agent, and where any such specification shall be so delivered closed, the registrar-general shall, on the expiration of six calendar months from the day of granting the certificate, or at any earlier day, on the request of the applicant, his executors, administrators, or assigns, break the seal of such envelope and enregister the specification.

III. *Inventions to be duly recorded, and specifications numbered.* The registrar-general shall number with a distinguishing number, and shall, in a book to be kept by him for that purpose, to be called The Book of Inventions, enter and record in its chronological order every such invention, and the christian and surnames of the inventor, and the day of the date of the certificate of such invention, and shall cause every specification to be marked with the distinguishing number of the invention to which the specification refers, and such

Book of Inventions and such specifications shall be open to the inspection of the public.

IV. *Certificate to vest exclusive right for fourteen years.* Every certificate granted under this ordinance shall vest in the applicant, his executors, administrators, or assigns, the sole right and benefit of using within this island the invention mentioned in such certificate for and during the space of fourteen years next after the granting of such certificate.

V. *Disclaimer may be entered.* Any person who, as grantee, assignee, or otherwise, shall obtain a certificate under this ordinance, may, if he think fit, enter with the registrar-general a disclaimer or disclaimers, of any part or parts of either the title of the invention or of the specification, stating the reason for such disclaimer, or may enter a memorandum of any alteration in such title of specification, not being such disclaimer or such alteration as shall extend the exclusive right vested by such certificate; and such disclaimer or memorandum of alteration, being filed by the said registrar-general, shall be deemed and taken to be part of such specification in all courts whatever; provided always, that no action shall be brought on any certificate in any case where any disclaimer or memorandum shall have been filed in respect of any infringement committed prior to the filing of such disclaimer or memorandum of alteration.

VI. *Where the invention assigned, who may enter disclaimer.* In case any person obtaining such certificate shall part with his or their whole or their part or any part of his or their interest by assignment to any other person or persons, it shall be lawful for the person obtaining such certificate, together with such assignee or assignees, if part only hath been assigned, and for the assignee or assignees, if the whole hath been assigned, to enter a disclaimer and memorandum of alteration under the powers of this ordinance; and such disclaimer and memorandum of such alteration, having been so entered and registered as in this ordinance mentioned, shall be valid and effectual in favor of any person or persons in whom the rights under the said certificate may then be or thereafter become legally vested; and no objection shall be made in any proceeding whatsoever on the ground that the party making such disclaimer or memorandum of such alteration had not sufficient authority in that behalf.

VII. *Disclaimer recorded, and note thereof indorsed on specification.* The registrar-general shall cause every such disclaimer and memorandum to be entered in a book to be kept by him for

that purpose, and to be marked with the distinguishing number of the invention and specification to which such disclaimer or memorandum shall refer, and shall indorse on the declaration and specification to which such disclaimer or memorandum shall refer a memorandum in writing of the date and entry of every such memorandum and disclaimer.

VIII. *Penalties for infringement of exclusive right.* If any person shall, during the said term of fourteen years from the granting of a certificate for an invention, directly or indirectly make, use, or put in practice the said invention, or any part of the same, or in anywise counterfeit or imitate the same, or make or cause to be made any addition or subtraction from the same, whereby to pretend himself the inventor thereof, without the license in writing of the inventor, his executors, administrators, or assigns, the inventor, his executors, administrators, or assigns, shall have and be entitled to such and the like remedies against such persons, both in law and in equity, as the grantee of any letters patent for any invention would be entitled to in the like case by the law of England.

IX. *Exclusive right to cease in certain cases.* Provided always, that if at any time during the said fourteen years, it shall be made to appear that the said invention is not a new invention as to the public use and exercise thereof in this colony, or that the said invention is prejudicial or inconvenient to the subjects of our Lady the Queen in general, then all privileges and advantages hereby granted to the inventor, his executors, administrators, and assigns, in respect of such invention, shall utterly cease, determine, and become void, anything hereinbefore contained to the contrary in anywise notwithstanding.

X. *Fees to be paid.* There shall be paid to the registrar-general the several fees mentioned in the schedule to this ordinance, and such fees shall be paid over monthly by the registrar-general to the receiver-general for the use of the colony.

Form of Declaration.

I of declare that I am in possession of an invention for
(state the title of the invention), which invention I believe will be of great public utility, and that the same is not in use by any person or persons in the Island of Trinidad to the best of my knowledge and belief, and that the instrument in writing under my hand herewith delivered particularly describes and ascertains the nature of the said invention and the manner in which the same is to be performed.

Signature.

Form of Certificate.

I, J. B., Registrar General of the Island of Trinidad, do hereby certify that on the day of _____ has been delivered to me by (or on behalf of _____ *the name and place of abode of the inventor*), a declaration in writing, signed by the said _____ of a certain invention whereof the said _____ claims to be the inventor in this island, being an invention (*state the name of the invention*), together with a specification (*open or under seal, as the case may be,*) describing the nature of the said invention, and the manner in which the same is to be performed.

In witness whereof, I have hereunto put my hand at Port of Spain, in the Island of Trinidad; this _____ day of _____ in the year one thousand eight hundred and _____.

Fees to be paid to the Registrar-General.

	£	s.	d.
On leaving any declaration of invention and specification.....	10	0	0
Every disclaimer.....	2	0	0
Publication in the Royal Gazette of any declaration, disclaimer, or memorandum of alteration.....	0	10	0
Every search or inspection of the Book of Inventions.....	0	1	0
Every inspection of any specification.....	0	2	0
For every copy of any specification, for every 120 words.....	0	1	0

From *Carp. Pat. L. of World*, 561.

TUNIS.

See FRANCE.

See also INTERNATIONAL CONVENTION.

TURKEY.

*Law of the 20th Day of the Month of Rabia I., A. H. 1297
(February 18, 1879 *).*

SECTION I.

GENERAL PROVISIONS.

ARTICLE 1. Every new discovery, invention, or improvement in any branch of industry, confers on its author, under the conditions and for the time hereinafter mentioned, the right to work the said discovery, invention, or improvement for his own benefit. This right is confirmed by a *berat* (patent) delivered by the government.

ART. 2. The following shall be considered as new inventions :

The invention of new industrial products.

The invention of new means, or a new application of known means, for obtaining an industrial result or product.

ART. 3. The following are not patentable :—

1. Pharmaceutical compounds and medicines of all kinds.

2. Devices or combinations relating to banking or finance.

ART. 4. The duration of patents delivered in accordance with article 1 will be five, ten, or fifteen years. Every patent shall be subject to the payment of a fixed tax, as follows :—

Ten Turkish pounds for a patent for five years.

Twenty Turkish pounds for a patent for ten years.

Thirty Turkish pounds for a patent for fifteen years.

This tax shall be paid in installments of two Turkish pounds, payable at the commencement of each year, under penalty of forfeiture if the patentee omits the payment of any annuity.

SECTION II.

THE FORMALITIES IN RELATION TO THE DELIVERY OF PATENTS.

CHAPTER I.

APPLICATIONS FOR PATENTS.

ART. 5. Whoever shall desire to obtain a patent shall deposit, in

* A translation of this law differing very slightly from that presented in the text may be found in 20 Pat. Off. Gaz. 2. The date of the law as stated in the text is that given in Carpmaels' edition. The Patent Office Gazette, and the Encyclopædia Brit. assign March 2, 1880, as the date.

a sealed envelope, if in Constantinople, at the ministry of commerce and agriculture, and if in the provinces at the office of the provincial government, or, if he prefers it, at the said ministry :—

(1.) His application for a patent.

(2.) A specification of the discovery, invention, or appliance forming the subject of the application.

(3.) The drawings or samples which may be necessary to the understanding of the description.

(4.) A memorandum of the papers deposited.

If the applicant complies with these formalities in a place in which he has no domicile, he must elect domicile there.

ART. 6. The application shall be limited to a single main subject with its details. It shall mention the duration which the applicant wishes to assign to his patent, within the limits fixed by article 4, and shall contain neither restrictions, conditions, nor reservations. It shall have a title giving a short and precise designation of the object of the invention. The application and the specification shall be written without erasures, alterations, or interlineations. The drawings shall be made in ink, to a metrical scale. A duplicate of the specification and drawings shall accompany the application. All the papers shall be signed by the applicant or by his attorney, whose power shall be annexed to the application.

ART. 7. No deposit will be accepted unless accompanied by a receipt showing that the applicant has paid to the authorities, to whom he presented his application, the sum of two Turkish pounds on account of the tax on the patent. An official memorandum shall be drawn up, in Constantinople, at the ministry of commerce and agriculture, or in the provinces at the office of the provincial government. This memorandum will authenticate each deposit, showing the date of the remission of the application papers, and shall be signed by the applicant. A copy of the said memorandum will be sent to the depositor on prepayment of postage.

ART. 8. The term of the patent will begin from the date of the deposit prescribed in article 5.

CHAPTER II.

THE DELIVERY OF PATENTS.

ART. 9. After the application has been filed and the deposits made in the province, in accordance with article 5, the governor-general will transmit the application to the ministry of commerce

and agriculture within five days, accompanied by a letter, a certified copy of the memorandum, the receipt for the tax, the power of attorney (if there be one), and the memorandum of the pieces deposited, all under the seal of the applicant. If the applicant is at Constantinople, these formalities must be complied with at the ministry of commerce and agriculture.

ART. 10. The papers sent from the provinces and those remitted directly to the ministry of commerce and agriculture will be filed in the order of their reception on a special file, and the patent applied for will be delivered.

ART. 11. Patents applied for in due form shall be delivered without previous examination, at the risk and peril of the applicant and without guarantee either of the reality, novelty, or merit of the invention, or of the accuracy or exactness of the specification.

ART. 12. In case of the invention of arms, tools, or apparatus of war which may be used by the army and navy of the State, the inventors and their applications are directed at once to the grand masters of artillery and to the imperial admiralty. A patent will be given for any invention which is shown after examination to be useful and advantageous to the State, and will be bought, in conformity with a contract with the inventor, and paid for, in proportion to its usefulness, by that department of the army and navy which the invention chiefly concerns. A medal of invention is also conferred upon the inventor in accordance with article 14. Inventions not found useful or advantageous will be rejected.

ART. 13. The *berat* (patent) is the official document confirming the regularity of the application, and is delivered to the applicant. It will bear at the top the imperial arms, and at the bottom the seal of the ministry of commerce and agriculture. This document will be accompanied by a certified copy of the specification and drawings mentioned in article 6. Subsequent copies of the patent asked for by the patentee or parties interested require the payment of a fee of one Turkish pound for expenses, the cost of the drawings, if any, being borne by the applicant.

ART. 14. Gold, silver, and copper medals will be ordered. Ottoman subjects and foreigners who shall invent articles useful to the State and to the country will receive as a compensation for and according to the importance of their inventions, gold, silver, or copper medals. They will be required to use the design of the medal as a trade-mark for the object invented.

ART. 15. The first copy of a patent is delivered without charge.

ART. 16. Every application not in conformity with the formalities prescribed by numbers 2 and 3 by article 6 will be rejected. Half of the sum prepaid will remain in the treasury, but it will be placed on account of the sum payable by the applicant if he repeats his application within three months, counting from the date of the notification of the rejection of the application.

ART. 17. When an application is rejected in accordance with article 3 the tax prepaid will be returned.

ART. 18. A list of patents issued by the ministry of commerce and agriculture with a description of the inventions will be published every six months. This publication will be in the usual form of the proclamations of the laws of the Empire.

ART. 19. The duration of patents can be prolonged only by special law.

CHAPTER III.

CERTIFICATES OF ADDITION.

ART. 20. Patentees or parties interested will have the right during the whole term of the patent to make changes, improvements, or additions in the invention by complying with the formalities laid down in articles 5, 6, and 7. These changes, improvements, or additions will be confirmed by certificates, which will have from the date of their delivery, the same effect as the original patent, and will expire with them. Every application for a certificate of addition requires the payment of one Turkish pound. A certificate of addition taken by any person interested inures to the benefit of all the others.

ART. 21. Every patentee who, instead of a certificate of addition, wishes to take out a new patent for a change, improvement, or addition, shall comply with the formalities prescribed in articles 5, 6, and 7, and pay the fees mentioned in article 4.

ART. 22. Those who have transferred their patents to others lose the right of applying for a certificate of addition according to article 20.

ART. 23. No one besides the patentee or persons interested through him may, during one year from the date of the patent, apply for a patent for a change, improvement, or addition to the invention which was the subject of the original patent. Nevertheless, if such an application is received in the course of the aforesaid year, the application and the papers annexed will remain deposited under seal of the ministry of commerce and agriculture. When

the year has expired the seal will be broken and the patent issued. In all cases the original patentee will have the preference in the matter of changes, improvements, or additions for which he himself shall during the year apply for a certificate of addition or a patent.

ART. 24. Any one having taken out a patent for a discovery, invention, or appliance connected with the object of another patent shall have no right to work the invention already patented, and, reciprocally, the owner of the original patent shall not have the right to work the object of the new patent.

CHAPTER IV.

ASSIGNMENT AND TRANSFER OF PATENTS.

ART. 25. The right of ownership of a patent for an invention is divisible. Every patentee may assign the whole or a part of his patent. The assignment, total or partial, of a patent, either gratuitously or for a consideration, can only be made by notarial deed, or by an Act passed before a civil tribunal of first instance in localities where there are no notaries. This formality requires the payment of all the fees mentioned in article 4. No assignment will be valid until registered at Constantinople, at the ministry of commerce and agriculture, or in the provinces at the office of the local authorities of the place in which the Act was passed. The entry of assignments or transfers shall be accomplished by the deposit of a certified copy of the act of assignment or transfer. A copy of each official entry made in the provinces shall be sent by the local authorities to the ministry of commerce and agriculture within five days from the date of the official report. This copy will be accompanied by an extract of the Act aforementioned.

ART. 26. Every patentee may, in accordance with a contract, assign in part the right to work his patent for the manufacture or preparation of the article invented in any quantities, and for any time agreed upon. The owner of a patent for any object dangerous to the community can only work it with caution and under surveillance of the government. The assignee of such a patent is subjected to the same conditions.

ART. 27. The ministry of commerce and agriculture will keep a register of the assignments and transfers of all patents. Every six months an official publication will announce in a form laid down in article 18, the assignments and transfers that have occurred during the half-year just expired.

ART. 28. Licensees under a patent and all who have acquired from a patentee or his agents the right to a patent shall have the full benefit of certificates of addition issued to the original patentee or to persons interested through him. In the same way the patentee and persons interested through him will profit by a certificate of addition issued to the licensees. All those who have the right to profit by a certificate of addition may obtain a copy of it from the ministry of commerce and agriculture on payment of a fee of one Turkish pound.

CHAPTER V.

INSPECTION AND PUBLICATION OF THE SPECIFICATIONS AND DRAWINGS OF PATENTS.

ART. 29. The specifications, drawings, samples, and models of patents issued will remain until the expiration of the patents deposited at the ministry of commerce and agriculture, where they may be inspected without expense by any applicant. Any one may obtain, at his own expense, copies of the said specifications and drawings.

ART. 30. After payment of the second annual fee the specifications and drawings will be published either entire or by extract only. Besides, there will be published every year a catalogue of the patents issued during the preceding year.

ART. 31. The specifications and drawings and the catalogue, when published, will be deposited at Constantinople, at the ministry of commerce and agriculture, and in the provinces, at the office of the secretary of the administrative council, where they can be consulted without charge.

ART. 32. At the expiration of the patents the original specifications and drawings will be deposited at the conservatory of the school of arts and trades at Constantinople.

SECTION III.

RIGHTS OF FOREIGNERS.

ART. 33. Foreigners may obtain patents in Turkey.

ART. 34. The formalities and conditions prescribed by the present law are applicable, without exception, to foreigners applying for patents.

ART. 35. The author of an invention already patented in a for-

foreign country may obtain a patent in Turkey ; but the duration of this patent shall not exceed that of the patent previously obtained in the foreign country.

SECTION IV.

ANNULMENTS AND FORFEITURES AND MATTERS RELATING THEREUNTO.

CHAPTER I.

ANNULMENTS AND FORFEITURES.

ART. 36. Patents issued in the following cases will be null and void.

(1.) If the discovery or invention is not new.

(2.) If in accordance with article 3 the discovery or invention is not patentable.

(3.) If the patents relate to theoretical principles, methods, systems, discoveries, and conceptions, without indication of their industrial application.

(4.) If the discovery or invention is contrary to public order or safety, to morals, or to the laws of the empire.

(5.) If the title under which the patent was applied for gives a false or fraudulent indication of the real object of the invention.

(6.) If the specification annexed to the patent is insufficient for the execution of the invention or if it does not indicate completely and faithfully the true means employed by the inventor.

(7.) If the patent was obtained contrary to the provisions of article 23.

The manufacture and sale of articles prohibited by paragraphs 3 and 4 of this article incur the penalties enacted by the laws of the empire.

All certificates for alterations, improvements, and additions which do not relate to the subject of the original patent are likewise null and void.

ART. 37. No invention will be considered new which, up to the date of the application, has received, either in Turkey or elsewhere, sufficient publicity to enable the same to be worked.

ART. 38. The following persons shall be deprived of all rights :—

(1.) Patentees who neglect to pay the yearly tax before the beginning of each year of their patent's duration.

(2.) Any patentee who has not worked his invention in Turkey within two years from the date of the issue of the patent or who has at any time ceased to work the same for any consecutive period of two years, unless in either case he can give a sufficient reason for his inaction.

(3.) Any patentee who shall have introduced into Turkey articles of foreign manufacture and similar to those forming the subject of his patent.

Nevertheless, the minister of commerce and agriculture may authorize the introduction into the empire of models of machines, and articles manufactured abroad intended for public exhibitions or for experiments made with the consent of the government.

ART. 30. Whoever shall in a sign, announcement, prospectus, advertisement, trade-mark, or stamp, pretend to the possession of a patent according to law without really possessing one, or after the same has expired, or shall, while having a patent, mention the same without adding the words "without guarantee of the government," shall be punished by a fine of not less than two nor more than forty-five Turkish pounds. For the second offense the fine shall be doubled.

CHAPTER II.

ACTIONS FOR ANNULMENT AND FORFEITURE.

ART. 40. Actions for annulment or forfeiture may be brought by any person having an interest in the matter, or who can be injured by the act of the defendant. These actions, as well as all disputes relating to the ownership of patents, shall be brought before a civil tribunal of first instance.

ART. 41. If the action is brought at the same time against the owner of a patent and against a licensee, it shall be brought before the tribunal of the domicile of the owner.

ART. 42. Whenever the annulment or forfeiture of a patent has been pronounced, notice of the same shall be sent to the ministry of commerce and agriculture, and it shall be published in the form prescribed by article 13 for the proclamation of patents.

SECTION V.

INFRINGEMENTS, PROSECUTIONS, AND PENALTIES.

ART. 43. Every interference with the rights of a patentee, either by the manufacture of articles or by the use of means forming the

subject of his patent, constitutes the offense of infringement. Every person who shall be judged guilty of this offense shall be punished by a fine of not less than five nor more than a hundred Turkish pounds.

ART. 44. All persons who shall have knowingly received, sold, or exposed for sale or introduced into Ottoman territory, infringing articles shall be considered guilty of infringement.

ART. 45. Any person who shall, without authority from the government, sell or expose for sale arms, tools, or apparatus of war, mentioned in article 12, and that could be used to the detriment of the country, shall be amenable to the penalties imposed by the appendix to article 166 of the Penal Code, without regard to the fact of these inventions having been accepted or rejected by the army and navy departments.

ART. 46. The penalties established by the present law are not cumulative. The heaviest penalty only can be inflicted for all acts committed prior to the prosecution.

ART. 47. For a second offense, in addition to the fine imposed by articles 42 and 43, there shall be inflicted a penalty of imprisonment for not less than one nor more than six months. Any act will be considered as a second offense when the accused shall have at any time during the previous five years been found guilty of any offense provided for by the present law. An imprisonment of not less than one month, nor more than six months, may likewise be inflicted upon any infringer who is or has been employed in any capacity in the shops or establishments of the patentee, or who has been associated with any one so employed in such a manner as to obtain knowledge from him of the processes described by the patent. In the latter case the employe from whom the knowledge was derived may be prosecuted as an accomplice.

ART. 48. At the request of the patentee and on presentation of the patent the president of the tribunal may issue an order providing that an officer of the court shall, assisted, if need be by an expert, make an inventory of articles alleged to be infringements. When a seizure is to be made, the order may require security of the person making the requisition. Security shall always be required of foreigners. The owner of the articles seized shall be provided with copies both of the ordinance and of the order requiring security, if there be one, under pain of annulment of the proceedings and of damages against the officer to the profit of the party injured.

ART. 49. In default of the party making the requisition presenting himself before the tribunal within a period of seven days, in addition to the time necessary to travel the distance between the place in which the objects seized or inventoried were found and the place or residence of the infringer, receiver, importer, or retailer, the seizure or inventory shall be void without prejudice to any damages that may be claimed.

ART. 50. The objects declared infringements must, and the implements and tools intended specially for the manufacture of the said objects may, at the discretion of the tribunal, be confiscated, even in case of the acquittal of the infringer, receiver, importer, or retailer. The objects, implements, and tools so confiscated shall, at the discretion of the judge, be delivered to the owner of the patent without prejudice to further damages or to the publication of the judgment.

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PATENT LAWS OF ALL NATIONS.

VOL. II.

UNITED STATES—WURTEMBERG.

UNITED STATES.

I. CONSTITUTIONAL AND GENERAL PRINCIPLES.

1. *The Constitutional Grant of Power.*

The Congress shall have power

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

2. *Extent of the Power Granted.**

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

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

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

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

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

3. *Its Limitations and Exceptions.*

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

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

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

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

4. *History of the Acts of Congress.*

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

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

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

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

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

more convenient to one studying patent law exclusively, if the three sorts of laws were distinguished from each other.

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

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

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

5. Construction of Acts of Congress.

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

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

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

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

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

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

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

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

6. *Nature of a Patent Right.*

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

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

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

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

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

* The opinion gives an extended and interesting account of the rise in England, of opposition to monopolies, and of the reasons why grants of patent rights were and should be excepted from

it. See, on the same subject, op. Bradley, J., in *Butcher's Union Co. v. Crescent City Co.*, 111 U. S. 746, 761 ; and, for the Act Concerning Monopolies, 2 post, 1, and note.

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

7. *No Right Reserved to Government.*

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

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

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

The Court of Claims has jurisdiction in an action brought

* As long ago as 1858 a claim was preferred to the secretary of war for payment for government use of a patent cut-off. The government contracted with M. to build a steamboat. M. attached the cut-off to the engine without paying royalty, considering that government was entitled to the free use of the invention. The inventor applied to the secretary of

war, and that officer asked the opinion of the attorney-general. The attorney-general of the day, Judge Black, advised that the government was equally bound with an individual to pay a royalty ; and that the secretary might pay one if there were an appropriation available. 9 *Op. Att.-Gen.* 135. Patents, &c. act, 1883, § 27, disclaims right of the crown.

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

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

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

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

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

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

† Inasmuch as officers of the United States, when they use articles manufactured in violation of the rights of patentees, are liable to suit therefor, therefore, where articles are advertised for by the

United States, and it is claimed by another party that the successful bidder, in order to furnish the articles, must make them in violation of his patent, it is proper that the successful bidder should be required to furnish a satisfactory bond of indemnity for the security of the officer against any suit for infringement of patent by the use of the articles. 16 *Op. Att.-Gen.* 136.

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

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

8. Powers of State Legislatures.

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

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

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

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

9. Analogous Decisions Relative to Copyright.

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

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

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

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

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

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

10. *Relative to Trade-marks.*

The trade-marks legislation of Congress, particularly the act of Aug. 14, 1876 (19 *Stat.* 141), is unconstitutional; because the patent and copyright power does not extend to trade-marks; and the legislation in question is not sufficiently limited to foreign and interstate commerce to admit of sustaining it under the commercial power. *Trademark Cases*, 160 *U. S.* 82; 25 *Law. ed.* 550; 10 *Pat*

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

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

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

II. THE PATENT-OFFICE.

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

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

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

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

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

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

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

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

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

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

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

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

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

† The sections of the Revised Statutes purporting to fix the salaries of the above mentioned officers, and to enumerate the subordinate employes, and fix their salaries, are Nos. 477 and 440. They are omitted from this compilation not merely because they are of small importance in connection with the law of patents, but chiefly because they are likely to mislead, inasmuch as the appropriations made often vary from them. Thus, section 477 fixes the salary of the commissioner at \$4,500 ; the appropriation for the year

1885-86 is \$5,000. Stat. 1885, c. 343. Section 440 allows the office seventy-two assistant examiners arranged in three ranks ; the appropriation gives it one hundred and twenty-one, arranged in four ranks. Theoretically, such changes should be authorized by some previous, independent law ; and in many cases they are. Often, however, without any previous legislation, the appropriation for a subordinate post is reduced, or even omitted, for a year or two ; or, on the other hand, a temporary need of additional force is supplied by appropriations continued only while the need lasts, without, in either case, taking the trouble to change the general law. The result is that the actual organization and personnel of the office is best ascertained by collating with the enactments of the Revised Statutes the items in the appropriation act for the year current.

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

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

14. *Restrictions upon Officers and Employes.*

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

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

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

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

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

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

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

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

15. *Duties of Commissioner.*

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

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

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

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

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

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

16. *Acting Commissioner.*

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

respect to that office is greatly diminished by the creation of the office of "assistant commissioner." See *Rev. Stat.* §§ 476, 178.

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

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

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

17. *Duties of Examiners in chief.*

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

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

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

18. *Establishment of Regulations.*

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

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

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

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

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

* The substance of the important rules is embodied in this work, in connection with the statutes or decisions on the subjects to which the rules relate. The edition in use at the time of writing,

March, 1886, is: Eighth revised edition, November 16, 1885, under which rules 31, 32, 33, 34, 35, 36, 37, 38, 39, 40, 41, 44, 45, 47, 86, 140, 144, and 145 were amended.

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

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

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

20. *Library.**

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

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

21. *Correspondence with the Office.*

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

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

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

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

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

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

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

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

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

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

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

When a letter concerns an application, it should state the name of the applicant, the title of the invention, the serial number of the application (see Rule 31), and the date of filing the same. *Id. No. 10.*

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

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

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

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

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

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

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

22. *Patent Agents and Attorneys.**

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

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

* The rules advise that the assistance of competent counsel will, in most cases, be of advantage to an applicant; that the office cannot aid an inventor in selecting an attorney, or assume any responsibility for an attorney's acts; that it will be unsafe to trust those who pretend to the

possession of any facilities except capacity and diligence for procuring patents in a shorter time, or with broader claims than others, and that applicants should not impose on senators or representatives, labor in attending to applications.

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

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

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

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

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

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

* The death of the inventor revokes a power of attorney given by him to a patent agent. *Eagleton Manuf. Co. v. West, &c. Manuf. Co.*, 2 *Fed. Rep'r*, 774 ; 18 *Blatchf.* 218 ; 5 *Bann. & A.* 475 ; 17 *Pat. Off. Gaz.* 1504. This is the ordinary rule as to principal and agent. *Hunt*

v. Rousmanier, 8 *Wheat.* 174 ; and applies even to an act of agency performed while the death of the principal is yet unknown to the agent. *Galt v. Galloway*, 4 *Pet.* 331. See also, as to effect of death of principal, 19 *Am. L. Reg. N. S.* 401 ; and 39 *Am. Dec.* 81, note.

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

25. *Copies of Foreign Letters Patent.*

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

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

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

27. *Annual Report of the Commissioner.*

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

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

28. *Disbursements for Patent-Office.*

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

III. AUTHORITY FOR ISSUING PATENTS.

29. *How issued, attested and recorded:*

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

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

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

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

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

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

30. *Contents and Duration.*

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

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

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

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

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

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

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

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

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

32. *Issuing several Patents for one Invention.*

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

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

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

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

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

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

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

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

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

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

34. *Joint Inventors and Patents.*

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

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

v. Atkinson, 23 *Pat. Off. Gaz.* 940; 1 *Macar. & M.* 382. Where a patent was issued to B., J. and L., jointly, in conformity to their application as joint inventors, when in fact the device patented was not the joint invention of all of the applicants, but the sole invention of B., the others (J. and L.) being his assignees only,—*Held*, that it was not within the power of the interior department to correct the patent thus issued so as to show that B. was the inventor of the device and that J. and L. are the assignees thereof; the patent issued upon such application being void, the department cannot, by means of alterations or corrections, impart validity thereto. 16 *Op. Att. Gen.* 116

35. *Date of Patent.*

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

It has been held that to antedate a patent is not unlawful, unless special circumstances render it so, as where it might override an intermediate improvement by another person (5 *Op. Att. Gen.* 722); indeed, the Act of 1836 expressly allowed it within limits (*Re Cushman*, 1 *Macarthur Pat. Cas.* 577), and under that Act an infringer might, in a proper case, be held liable for profits realized between the nominal date of the patent and the actual issue, *Burdett v. Esty*, 3 *Fed. Rep'r*, 566; 19 *Blatchf.* 1. But the present rule of the patent-office is that a patent will not be antedated. *Rules of Prac.* No. 161. Were a patent antedated to be issued by mistake, and accepted by the patentee, it might probably be sustained, as towards an infringer, upon the principle that the error operated as a waiver of part of the term (*Re Cushman, supra*; also, *Op. Att. Gen.* Gilp. ed. 168); though no similar suggestion can be made in behalf of a patent which should be inadvertently dated *after* the time allowed by law. Compare the copyright cases: *Myers v. Callaghan*, 10 *Biss.* 139; *Baker v. Taylor*, 2 *Blatchf.* 82.

36. *Delivery.*

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

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

37. *Correction of Errors.*

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

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

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

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

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

Where a patent is obtained from the United States by fraud, the proper remedy is a simple bill in equity brought by the United States against the defendant, praying that the patent be annulled and surrendered by a decree in chancery, without any attempt of assimilating the proceeding to an information brought by the attorney-general on behalf of the crown, in England, to repeal a patent. *United States v. Hughes*, 11 *How.* 552; *Mowry v. Whitney*, 14 *Wall.* 434; *Attorney-General v. Rumford Chemical Works*, 9 *Pat. Off. Gaz.* 1062.

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

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

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

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

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

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

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

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

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

IV. WHO MAY OBTAIN PATENTS; AND FOR WHAT.

39. *The general Statutory Definition.*

Any person who has invented or discovered any new and useful art, machine, manufacture or composition of matter, or any new and useful improvement thereof, not known or used by others in this country, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof, and not in public use or on sale for more than two years prior to his application, unless the same is proved to have been abandoned, may upon payment of the fees required by law, and other due proceedings had, obtain a patent therefor. *Rev. Stat.* § 4886.

40. *What constitutes Inventing.*

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

It is no new invention to use an old machine or process for a new purpose. The inventor of a machine is entitled to the benefit of all the uses to which it can be put, no matter whether he had conceived the idea of the use or not. *Evans v. Eaton*, 7 *Wheat.* 353; aff'g 3 *Wash.* 443; 1875, *Roberts v. Ryer*, 91 *U. S.* 150. See also, *Ames v. Howard*, 1 *Sumn.* 482; *Howe v. Abbott*, 2 *Story*, 190; *Winans v. Boston & Providence R. R. Co.*, *Id.* 412; *Matter of Arkell*, 15 *Blatchf.* 437; *Crandall v. Watters*, 9 *Fed. Rep'r*, 659; 20 *Blatchf.* 97; 21 *Pat. Off. Gaz.* 945; *Western Electric Manuf. Co. v. Ansonia Brass, &c. Co.*, 9 *Fed. Rep'r.* 706; 20 *Blatchf.* 170; *Couse v. Johnson*, 16 *Pat. Off. Gaz.* 719; 4 *Bann. & A. Pat. Cas.* 501; *Rowell v. Lindsay*, 6 *Fed. Rep'r*, 290; 10 *Biss.* 217; 19 *Pat. Off. Gaz.* 1565.

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

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

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

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

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

It is the development of something new, and not the arrival at comparative superiority or greater excellence in that which was always known, which the law protects as exclusive property, and which it secures by patent. *Putnam v. Yerrington*, 9 *Pat. Off. Gaz.* 689. But a result which required calculation and experiment beyond mechanical skill and good workmanship is entitled to be classed as inventive. *Davis v. Fredericks*, 19 *Fed. Rep'r*, 99. There cannot, however, be a patent for a mere form, unless the form is of the essence of the invention. *Wilson Packing Co. v. Clapp*, 8 *Rep'r*, 262. Thus, merely reducing the size of a thing in common use, though with effect to render it available for a new use, cannot support a claim to a patent. *Double Pointed Tack Co. v. Mann*, 5 *Bann. & A. Pat. Cas.* 465.

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

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

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

the power exist; the invention is not in discovering them, but in applying them to useful objects. The principle may be the new and valuable discovery, but the practical application of it to some useful purpose is the test of its value. *Leroy v. Tatham*, 14 *How.* 156, 175; *American Bell Telephone Co. v. Dolbear*, 15 *Fed. Rep'r*, 448; 23 *Pat. Off. Gaz.*, 535; 28 *Alb. L. J.* 69. In other words, where the discoverer of a new principle or force has gone beyond the mere domain of discovery, and has laid hold of the new principle, force, or law, and connected it with some particular medium or mechanical contrivance by which or through which it acts on the material world, then he can secure the exclusive control of it under the patent law, through the means by which he has brought it into practical action; for it is then an invention, although it embraces a discovery. Every invention may, in a certain sense, embrace more or less of discovery, for it must always include something that is new; but it by no means follows that every discovery is an invention. *Morton v. New York Eye Infirmary*, 5 *Blatchf.* 116; 2 *Am. L. Reg.* 672; 2 *Irish. Pat. Cas.* 320. He who has discovered some new element or property of matter may secure to himself the ownership of his discovery so soon as he has been able to illustrate it practically and to demonstrate its value. His patent in such case will be commensurate with the principle which it announces to the world, and may be as broad as the mental conception itself. But the mental conception must have been embodied in some mechanical device or some process of art. The patent must be for a thing, not for an idea merely. *Detmold v. Reeves*, 4 *Am L. J. N. S.* 188. Thus, where a patentee claimed the application of the expansive and contractive power of a metal rod, by various degrees of heat, to open and close a damper governing the admission of air into a stove, it was *held*, that this claim was not one for a mere principle, and that the patent was good. *Silsby v. Foote*, 20 *How.* 378; *aff'g* 2 *Blatchf.* 260. Likewise, where a person discovered that articulate sounds could be transmitted by undulatory vibrations of electricity, and invented the art or process of transmitting such sounds by means of such vibration, it was *held* that the mere fact that such art or process is the only way by which speech can be transmitted by electricity, did not lessen the merit of the invention, or the protection which the patent law would give to it. *American Bell Telephone Co. v. Dolbear*, 15 *Fed. Rep'r*, 448; 23 *Pat. Off. Gaz.* 535; 28 *Alb. L. J.* 69.

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

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

45. *Discoveries of "Processes."*

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

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

And a process may be patentable, irrespective of the particular form of the instrumentalities used. If one of the steps of a process be that a certain substance is to be reduced to a powder, it may not be at all material what instrument or machinery is used to effect that object, whether a hammer, a pestle and mortar, or a mill. Either may be pointed out; but (if the patent is not confined to that particular tool or machine), the use of the other would be an infringement, the general process being the same. So the machinery pointed out as suitable to perform the process may or may not be new or patentable, whilst the process itself may be altogether new, and produce an entirely new result. The process requires that certain things should be done with certain substances, and in a certain order; but the tools to be used in doing this may be of secondary consequence. *Cochrane v. Deener*, 94 *U. S.* 780.

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

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

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

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

46. *Patentability of Effects and Products.*

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

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

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

He who produces an old result by a new mode or process is entitled to a patent for the mode or process (*Howe v. Abbott*, 2 *Story*, 190); and although an inventor has obtained a patent for a process, he may have another for the product, if new. *Jones v. Sewall*, 3 *Cliff.* 583 ; 6 *Fish. Pat. Cas.* 343 ; 3 *Pat. Off. Gaz.* 630. A patentee who has invented a new process in the arts, whereby an article of manufacture is produced, new in kind and not before known, may separately claim and patent both the art and the manufacture ; he cannot indeed properly combine them in one claim ; but he may claim broadly the new product, however made, or may claim the new product when made by his described process. *Merrill v. Yeomans*, 1 *Holmes*, 331. But the fact that the product is new as an article of commerce, is not enough to warrant granting a patent ; there must have been an exercise of invention in devising the means of producing it. There is no inventing in reducing an article formerly sold in chunks to a powder—comminuting glue—when it is not improved by adding some new ingredient, or by subtracting one or more. *Milligan, &c. Glue Co. v. Upton*, 6 *Pat. Off. Gaz.* 837. The process of making and the article made are, in legal contemplation, distinct inventions, which may both be included in a single patent, though a full, clear and exact description, according to the statute, is indispensable in each case. *Kelleher v. Darling*, 14 *Pat. Off. Gaz.* 673.

47. *Machines.*

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

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

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

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

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

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

48. *Compositions.*

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

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

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

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

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

49. *Improvements.*

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

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

But to warrant a patent for an improvement, the change made must be one involving invention, and the result must be new and useful. There must be something accomplished beyond what is obvious in the thing itself, to persons skilled in the art to which it relates. *Mulford v. Pearce*, 102 *U. S.* 112; 18 *Pat. Off. Gaz.* 1223; rev'g 14 *Blatchf.* 141; 2 *Bann. & A. Pat. Cas.* 542; also, 13 *Blatchf.* 173; 9 *Pat. Off. Gaz.* 204; 2 *Bann. & A. Pat. Cas.* 190; *Hall v. Wiles*, 2 *Blatchf.* 194; *McCormick v. Seymour*, 3 *Id.* 209; aff'd 19 *How.* 96. A mere enlargement of the parts of a machine, a merely colorable change or re-arrangement of relative location of parts, is not a patentable improvement. *Phillips v. Page*, 24 *How.* 164; *Re Greeley*, 4 *Pat. Off. Gaz.* 612; *Pearl v. Ocean Mills*, 11 *Pat. Off. Gaz.* 2; *Miller's Falls Co. v. Backus*, 17 *Pat. Off. Gaz.* 852; 5 *Bann. & A. Pat. Cas.* 53. There are many changes which may be suggested by the manufacturer, or by the particular uses to which the article produced is to be applied, as well as many exhibitions of superior skill in producing an article of greater excellence, which are not invention. The law gives no monopoly to industry, to wise judgment, or to mere mechanical skill in the use of known means, nor to the product of either, if it be not new. It is invention of what is new, and not comparative superiority or greater excellence in what was before known, which the law protects as exclusive property, and it is that alone which is secured by patent. Thus if a fabric be already known and in use, change of color, change of mere material, or change in its degree of fineness—if these changes involve nothing new in construction, nor in the relations of its parts, nor in the office or function of either part—does not constitute invention. *Smith v. Elliott*, 5 *Fish. Pat. Cas.* 315; 1 *Pat. Off. Gaz.* 331.

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

50. *Combinations.*

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

51. *Various Specific Objections to Patenting Them.*

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

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

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

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

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

Moreover, it is not necessary, in order to make a valid claim for a combination, that the several elementary parts of the combination should act simultaneously; but if such parts are so arranged that the successive action of each contributes to produce one result, and this result is the product of the simultaneous or successive action of all such parts, a patent for combining such elementary parts may be obtained. *Forbush v. Cook*, 2 *Fish. Pat. Cas.* 668; 20 *L. Rep'r*, 664; *Hoe v. Cottrell*, 1 *Fed. Rep'r*, 597; 17 *Blatchf.* 546; 18 *Pat. Off. Gaz.* 59; 5 *Bann. & A. Pat. Cas.* 256; *Hoffman v. Young*, 2 *Fed. Rep'r*, 74; 26 *Int. Rev. Rec.* 155; 10 *Rep'r*, 259; 18 *Pat. Off. Gaz.* 794; 5 *Bann. & A. Pat. Cas.* 310; *Birdsell v. McDonald*, 6 *Pat. Off. Gaz.* 682.

52. *How Patents for Combinations Should be Issued*

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

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

A patent may be obtained for a machine combining several distinct improvements, if each is the invention of the patentee, and may include a right to each of the several and distinct improvements; in other words, the patentee may in such case take out a valid patent for the combination, and also include therein a right to each distinct improvement severally contained in the same machine. *Pitts v. Whitman*, 2 *Story*, 669, 681.

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

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

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

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

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

To entitle one claiming as an inventor, to a patent, his invention must be "new;" novelty is, by the statute, an essential condition. *Bedford v. Hunt*, 1 *Mas.* 362; *Perfection Window Cleaner Co. v. Bosley*, 2 *Fed. Rep'r.* 574; 9 *Biss.* 365; 5 *Bann. & A. Pat. Cas.* 449; 10 *Rep'r.* 67; *Wood v. Pacher*, 17 *Fed. Rep'r.* 650. If his invention is a combination, his claim can be sustained only by establishing the novelty of the combination as a whole; though novelty of all or any of the parts need not be shown. *Le Roy v. Tatham*,

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

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

54. Rule that it must be "Useful."

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

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

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

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

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

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

55. *The Completeness or Perfection necessary.*

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

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

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

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

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

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

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

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

If the thing patented was actually described in a published work previous to the discovery or invention of it by the applicant for a patent in this country, he cannot obtain a valid patent for it, even though he had no knowledge of such prior publication, but his invention of it was original with himself ; the restriction in the law is founded on a presumption that he may have known it, which is not allowed to be rebutted. This was so held under early patent laws (in *Evans v. Eaton*, 3 *Wheat.* 454, 514 ; rev'g *Pet. C. Ct.* 323 ; *Reutgen v. Kanowrs*, 1 *Wash.* 148), and under the act of 1836, in *Allen v. Hunter*, 6 *McLean*, 303, 314. Under the Revised Statutes the restriction has been modified (by § 4887, formerly Act of July 8, 1870, c. 230, § 25, 16 *Stat.* 201), so far as effect of a foreign patent is concerned ; and an inventor can obtain a patent here, by proving that he is the original inventor here, unless the thing has been introduced into use here for more than two years prior to his application ; the only effect of the foreign patent being to limit the term of the American. *Cornely v. Marekwald*, 17 *Fed. Rep'r*, 83 ; 24 *Pat. Off. Gaz.* 498 ; 16 *Rep'r*, 102. See *Rev. Stat.* § 4887, *infra*.

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

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

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

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

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

58. *Public use or Sale.*

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

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

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

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

59. *Abandonment.*

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

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

60. *Patents for Inventions previously patented Abroad.*

No person shall be debarred from receiving a patent for his invention or discovery, nor shall any patent be declared invalid, by reason of its having been first patented or caused to be patented in a foreign country, unless the same has been introduced into public use in the United States for more than two years prior to the application. But every patent granted for an invention which has been previously patented in a foreign country shall be so limited as to expire at the same time with the foreign patent, or, if there be more than one, at the same time with the one having the shortest term, and in no case shall it be in force more than seventeen years. *Rev. Stat. § 4887.*

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

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

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

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

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

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

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

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

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

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

* By rule of the Austrian Office taking effect July 16, 1884, all patents are granted for the term of 15 years subject to the payment of an annual tax. Formerly they were granted for one year with the privilege of prolongation to 15 years, and the Bate, and Gramme cases, cited in

the text, *held*, that the U. S. patent granted after an Austrian patent applied for after the U. S. patent was applied for, lasted only one year. See commissioner's decision in Exp. Mann, 17 *Pat. Off. Gaz.* 330. For the rule, see 1 *ante*, 31.

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

V. APPLICATION AND ISSUE.

62. *Requisites of Application, Description, Specification, and Claim.*

Before any inventor or discoverer shall receive a patent for his invention or discovery, he shall make application therefor, in writing, to the commissioner of patents, and shall file in the patent-office a written description of the same, and of the manner and process of making, constructing, compounding, and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the same; and in case of a machine, he shall explain the principle thereof, and the best mode in which he has contemplated applying that principle, so as to distinguish it from other inventions; and he shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery. The specification and claim shall be signed by the inventor and attested by two witnesses.—*Rev. Sta'. § 4888.*

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

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

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

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

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

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

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

63. *General requisites of Description or Specification.*

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

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

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

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

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

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

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

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

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

1. Preamble stating the name and residence of the applicant, and the title of the invention, and, if the invention has been patented in any country, the country or countries in which it has been so patented, and the date and number of each patent.
2. General statement of the object and nature of the invention.
3. Brief description of the several views of the drawings (if the invention admits such illustration).
4. Detailed description.
5. Claim or claims.
6. Signature of inventor.
7. Signatures of two witnesses. *Rules of Pract.* No. 39.

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

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

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

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

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

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

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

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

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

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

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

65. *In the case of Improvements.*

In case of a mere improvement, the specification must particularly point out the parts to which it relates, and must by explicit language distinguish between what is old and what is claimed as new, and the description and the drawings, as well as the claims, should be confined to the specific improvement and such parts as necessarily co-operate with it. *Rules of Prac.* No. 36.

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

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

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

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

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

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

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

66. *Of Compositions of Matter.*

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

67. *Of Combinations.*

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

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

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

68. *The Claim.*

The specification must conclude with a specific and distinct claim or claims of the part, improvement, or combination which the applicant regards as his invention or discovery. *Rules of Prac.* No. 37.

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

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

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

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

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

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

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

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

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

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

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

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

69. *Amendment of Application.*

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

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

70. *Drawings, When Requisite.*

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

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

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

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

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

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

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

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

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

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

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

71. *Office Rules as to Drawings.*

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

72. *Specimens of Ingredients, &c.*

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

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

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

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

73. *Model, when requisite.*

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

74. *Oath required from Applicant.*

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

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

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

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

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

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

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

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

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

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

75. *Examination, and Issuing Patent.*

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

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

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

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

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

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

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

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

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

76. *Limitation upon Time of completing Applications.*

All applications for patents shall be completed and prepared for examination within two years after the filing of the application, and in default thereof, or upon failure of the applicant to prosecute the same within two years after any action therein, of which notice shall have been given to the applicant, they shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the commissioner of patents that such delay was unavoidable. *Rev. Stat.* § 4894.

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

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

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

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

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

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

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

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

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

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

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

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

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

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

78. *Applications Renewed after Withdrawal.*

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

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

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

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

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

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

79. *Patents Granted to Assignee.*

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

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

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

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

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

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

patent may be valid when issued to any assignee of record. Nothing in the language of section 4895 or other sections of the patent laws, implies that a patent cannot be properly issued to any assignee whose assignment is duly recorded, when it can be done without impairing the rights of any other person having a paramount title to the invention. *Consolidated Electric Light Co. v. Edison Electric Light Co.*, 25 *Fed. Rep'r*, 719 ; 33 *Pat. Off. Gaz.* 1597. See also, *Selden v. Stockwell Self-Lighting Gas-Burner Co.*, 19 *Blatchf.* 514 ; 9 *Fed. Rep'r*, 390 ; *Read v. Bowman*, 2 *Wall.* 591 ; *U. S. Stamping Co. v. Jewett*, 18 *Blatchf.* 469 ; 7 *Fed. Rep'r*, 869 ; *Perkins v. U. S. Electric Light Co.*, 21 *Blatchf.* 308 ; 10 *Fed. Rep'r*, 513.

In every case where it is desired that the patent shall issue to an assignee, the assignment must be recorded in the patent-office at a date not later than the day on which the final fee is paid. The date of the record is the date of the receipt of the assignment at the office. *Rules of Prac.* No. 206.

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

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

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

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

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

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

VI. ASSIGNMENTS, LICENSES AND OTHER CONTRACTS.

§2. *Assignments of Patents.*

Every patent or any interest therein shall be assignable in law, by an instrument in writing ; and the patentee or his assigns or legal representatives may, in like manner, grant and convey an exclusive right under his patent to the whole or any specified part of the United States. An assignment, grant, or conveyance shall be void as against any subsequent purchaser or mortgagee for a valuable consideration, without notice, unless it is recorded in the patent-office within three months from the date thereof. *Rev. Stat. § 4898.*

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

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

1 *Holmes*, 149 ; *Hill v. Whitcomb*, *Id.* 317 ; 5 *Pat. Off. Gaz.* 430 ; 1 *Bann. & A. Pat. Cas.* 34. See *post*, 98.

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

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

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

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

83. *Parties to Assignments.*

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

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

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

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

84. *Requisites and Sufficiency.*

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

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

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

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

Validity.

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

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

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

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

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

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

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

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

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

86. *What Property of Interest passes.*

A patent is a triple right; it includes to make, to use and to sell, the patented invention. *Adams v. Burke*, 17 *Wall.* 453; *Dorsey Rake Co. v. Bradley Manuf. Co.*, 12 *Blatchf.* 202; 1 *Bann. & A.* 330. A patentee may grant to another the right to make, or to make and sell for use here, and retain to himself the exclusive right to make and sell for export, or use in other countries. *Dorsey R. H. Rake Co. v. Bradley M'g Co.*, *supra*. A patentee has the exclusive right to make, use and vend the device patented, and it is his privilege to grant the exclusive right to make to one person, to use to another, and to vend to another. *Steam Stone Cutter Co. v. Sheldon*, 5 *Fish.* 477; 10 *Blatchf.* 1; *Adams v. Burke*, 4 *Fish.* 392; 1 *Holmes*, 40; 1 *Pat. Off. Gaz.* 282; *Bicknell v. Todd*, 5 *McLean*, 233. A patentee may convey the right to make so as to include the right either to sell or use. He also may convey the right to use so as to imply the right to sell. The circumstances, nature, and terms of each grant must decide the construction. *Woodworth v. Curtis*, 2 *Woodb. & M.* 524. A grant of an exclusive right to make, use, and vend patented articles within certain territory, confers the right to make and vend within said territory for use elsewhere, and any person who manufactures said machines within said territory without the consent of the grantee, infringes his right, although the machines may neither be sold nor used within said district. *Jenkins v. Greenwald*, 2 *Fish. Pat. Cas.* 37; 1 *Bond*, 128. See *ante*, 94.

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

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

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

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

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

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

Refusal of assignee to perform conditions subsequent, cannot re-vest the title to the invention in the assignor ; his remedy is action for damages. *Mallory v. Mackaye*, 22 *Pat. Off. Gaz.* 945 ; 12 *Fed. Rep.* 328.

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

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

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

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

Whether one of two persons holding a patent as trustees, administrators, or the like, can assign it, acting alone, see *Barker v. Stowe*, 11 *Fed. Rep'r*, 303 ; 22 *Pat. Off. Gaz.* 258 ; *Wintermute v. Redington*, 1 *Fish. Pat. Cas.* 239. Under a conveyance of the entire legal title to patents to joint trustees, with full power to dispose of them at their discretion, the joint deed of both is required to convey any title to, or interest in, the patents. *Westcott v. Wayne Agricultural Works*, 11 *Fed. Rep.* 298.

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

89. *Recording.*

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

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

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

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

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

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

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

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

The term of three months is merely directory ; any subsequent recording of an assignment of a patent will suffice to vest the assignee with title except as to intermediate *bona fide* purchasers without notice. *Pitts v. Whitman*, 2 *Story*, 609 ; *Brooks v. Byam*, 2 *Story*, 525 ; *Boyd v. McAlpin*, 3 *McLean*, 427 ; *Case v. Redfield*, 4 *McLean*, 526. And with respect to the assignment of an invention, recording at any time before the issuing of the patent is sufficient. *Gay v. Corneil*, 1 *Blatchf.* 503.

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

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

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

90. *What is a License.*

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

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

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

A patentee, in consideration of weekly payments, assigned and

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

Where A. erected, on his own premises and at his own expense, a machine, the invention of B., and B. then leased the machine of A. for a term of years, covenanting to deliver the same to A. at the end of the term, it was *held*, that this amounted to a license or a consent in writing (under the patent act of 1790, § 4), to use the machine after the end of such term. *Keutgen v. Kanowrs*, 1 *Wash.* 163.

91. *Presumption or Proof of a License.*

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

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

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

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

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

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

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

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

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

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

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

92. Construction.

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

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

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

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

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

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

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

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

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

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

A license to use a patented invention upon the locomotives used by a railroad company on its road, or on "any road or roads now owned or that may hereafter be owned or operated by said company," was *held* to embrace not only locomotives in use at the date of the license upon roads then owned and operated by the company, but also such other locomotives as it might thereafter use and other roads which it might thereafter operate. *Mathew v. Pennsylvania R. Co.*, 8 *Fed. Rep'r*, 45; 27 *Int. Rev. Rec.* 234; 12 *Rep'r*, 294.

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

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

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

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

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

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

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

93. *Validity and Obligations.*

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

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

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

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

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

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

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

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

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

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

94. *Estoppel, arising from a License.*

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

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

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

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

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

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

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

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

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

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

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

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

95. *Rights Created by License.*

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

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

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

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

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

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

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

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

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

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

The general doctrine as to licenses is, that express words of assignability are needful to render them transferable; a grant of a license to a person or persons, only, does not pass to an assignee. *Troy Iron & Nail Co. v. Corning, 14 How. 193; Oliver v. Rumford Chemical Works, 100 U. S. 75; 3 Sup. Ct. Rep'r, 61; Baldwin v. Sibley, 1 Cliff. 150; Goodyear v. Providence Rubber Co., 2 Cliff. 351; 2 Fish. Pat. Cas. 351; Lightner v. Boston & Albany R. R. Co., 1 Low. 338; Curran v. Craig, 22 Fed. Rep'r, 101; Eclipse Windmill Co. v. Woodmansee Windmill Co., 21 Fed. Rep'r, 650; 32 Pat. Off. Gaz. 1605.* Thus a license to manufacture at a specified place, or to use a patented process at the licensee's place of business, and associate others with him in it, is not transferable. *Searls v. Bouton, 20 Blatchf. 426, 12 Fed. Rep'r, 140; 21 Pat. Off. Gaz. 1784; Gibbs v. Hoefner, 19 Fed. Rep'r, 323.* An agreement between a patentee and an individual by which the former licenses and grants to the latter, without adding "executors, administrators or assigns," or anything equivalent, the exclusive right to manufacture, sell, &c., during a specified term of years, and that he will engage in the manufacture and sale, will use all his business tact and skill, &c., is a mere license to the grantee personally; is not assignable; and on his death, even before the specified term has expired, no right to manufacture or to sue infringers under it passes to the representatives of the licensee. *Oliver v. Rumford Chemical Works, 100 U. S. 75.* Generally, however, whether a license is or is not assignable is to be determined not merely by the term "license," but by an inquiry into the intention of the parties; not only by the words of the license, but by the nature of the transaction, the consideration paid, and other circumstances showing that an assignable right was conferred. *Dorsey R. II. Rake Co. v. Bradley Manuf. Co., 12 Blatchf. 202; 1 Barn. & A. 330.*

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

Although where there appears to be a subsisting license between the complainant and the respondent, the jurisdiction of the circuit court, under the patent law, will not be extended to cover a suit to enforce the terms of the license or to forfeit the license, on the ground that the terms thereof have been violated, yet where a suit is brought for infringement, and the existence of a license is alleged by the respondent and denied by the complainant, it is competent for the court to determine whether, at the time of the filing of the bill, there was a subsisting license between the parties. *Hammacher v. Wilson*, 26 *Fed. Rep'r*. 239.

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

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

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

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

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

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

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

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

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

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

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

A mere license, although exclusive, to manufacture and sell a patented article does not authorize the licensee to maintain actions for damages against infringers who are not infringing the patent in those respects. *Hayward v. Andrews*, 103 *U. S.* 672.

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

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

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

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

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

99. *Revocation or Forfeiture.*

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

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

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

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

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

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

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

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

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

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

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

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

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

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

101. *Construction and effect of such Contracts.*

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

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

Where a contract stipulates that an arbitration is to be a condition precedent to the right to sue upon the contract, or even if that may be inferred upon construction, no suit can be maintained until the plaintiff has made all reasonable efforts to procure arbitration. *Perkins v. United States Electric Light Co.*, 24 *Pat. Off. Gaz.* 234;

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

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

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

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

102. *In particular Cases.*

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

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

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

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

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

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

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

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

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

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

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

Under an agreement between the owners of conflicting patents,

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

104. *Sales and Purchases of Patented Articles.*

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

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

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

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

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

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

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

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

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

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

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

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

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

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

The right to make carries the right to sell, but not necessarily the right to use the machine when made and sold. *Jenkins v. Greenwald*, 2 *Fish.* 37; 1 *Bond*, 123; *Bicknell v. Todd*, 5 *McLean*, 236.

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

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

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

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

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

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

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

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

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

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

The right to use a machine after the expiration of the patent is an incident to the right to use it during the original term; if that fails (here, on account of fraud), the incident falls with it. *Union Paper-Bag Machinery Co. v. Nixon*, 9 *Pat. Off. Gaz.* 391; 1 *Flippin*, 491; 2 *Mann. & A. Pat. Cas.* 244.

Articles manufactured without right during the lifetime of a

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

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

VII. MARKING ARTICLES "PATENTED." FALSE MARKING.

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

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

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

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

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

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

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

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

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

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

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

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

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

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

The purpose of prohibiting under penalties the marking of an unpatented article is to prevent deceiving the public (*Wilson v. Singer Manuf. Co.*, 9 *Biss.* 173 ; 16 *Pat. Off. Gaz.* 1091 ; 4 *Bann. & A. Pat. Cas.* 637) ; and in order to render a person liable, the marking must not only give the public to understand the fact of a patent, but it must be done *quo animo*, with intent to deceive. *Walker v. Hawxhurst*, 5 *Blatchf.* 494. The intent to create a belief in a present subsisting patent is necessary. If the patents marked upon the machine have all expired, and there is no subsisting patent upon the machine or any part of it, the offense is incomplete (*Wilson v. Singer Manuf. Co.*, 12 *Fed. Rep'r*, 57 ; 11 *Biss.* 293 ; 28 *Int. Rev. Rec.* 176) ; as where the patentee continued to stamp the patented article with the word "patented" and the date when the patent was issued, after the patent had expired. *Wilson v. Singer Manuf. Co.*, 9 *Biss.* 173 ; 16 *Pat. Off. Gaz.* 1091 ; 4 *Bann. & A. Pat. Cas.* 637, (See *ante*, pp. 10, 11). The question of the intent to deceive is for the jury. *Walker v. Hawxhurst*, *supra* ; *Oliphant v. Salem Flouring Mills*, 5 *Sawyer*, 128 ; 3 *Bann. & A. Pat. Cas.*

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

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

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

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

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

VIII. CAVEATS.

109. *Filing and Effect of Caveats.*

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

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

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

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

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

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

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

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

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

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

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

110. *Requisites and Sufficiency.*

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

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

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

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

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

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

**IX. REJECTIONS AND INTERFERENCES. MOTIONS.
TESTIMONY.***111. Notice of Rejection of Claim for Patent to be given
to Applicant.*

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

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

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

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

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

The decision of the commissioner of patents rejecting an application for a patent on the ground of abandonment of the invention is not final. Abandonment is a question of fact, and the decision is reviewable. This is so when the decision was made on renewal of an application equally as when made on the original application. *United States Rifle, &c. Co. v. Whitney Arms Co.*, 14 *Blatchf.* 94; 11 *Pat. Off. Gaz.* 373; 2 *Bann. & A. Pat. Cas.* 493.

Upon the abolition, by the act of 1839, of the board of examiners created by the act of 1836, the original jurisdiction of the board vested in the commissioner of patents ; and under sections 6 and 7 of the act of 1836, he was authorized to investigate and determine questions of public use of an alleged invention arising upon an application for a patent. The negative requirement—that the invention has not been in the public use or on sale, &c., stands in the statute in the same category with the other requisites, and their existence is to be determined by the commissioner according to a due course of proceeding had by him. *Hunt v. Howe*, 1 *MacArthur Pat. Cas.* 366 ; *Mowry v. Barber*, *Id.* 563. And see *Ellithorp v. Robertson*, *Id.* 585.

Proof of a public use of a device for two years prior to the application (Act of 1839, § 7) requires the commissioner to reject the application. *Rugg v. Haines*, 1 *MacArthur Pat. Cas.* 420.

The commissioner of patents was authorized, under section 7 of the act of 1839, to reject an application for a patent upon proof that the invention had been abandoned to the public. *Mowry v. Barber*, 1 *MacArthur Pat. Cas.* 563; *Ellithorp v. Robertson*, *Id.* 585; *Same v. Same*, *Id.* 634; *Wickersham v. Singer*, *Id.* 645, 678.

The withdrawal of an application for a patent and the return of part of the patent fee is not of itself an abandonment or dedication of the invention to the public ; but is an equivocal act, to be interpreted by surrounding circumstances, and to be affected upon a second application by the subsequent conduct of the party—his diligence or his neglect or delay—in the same manner as his conduct is to be weighed in regard to an original application. *Wickersham v. Singer*, 1 *MacArthur Pat. Cas.* 645, 689.

The rejection by the commissioner of patents, of the application of Wickersham for a patent for improvements in the feed mechanism of sewing machines, upon an interference with patents issued to Singer—affirmed, upon appeal, notwithstanding Wickersham appeared to have been the prior inventor, on the grounds that he had abandoned the invention by failing to use due diligence in applying for and prosecuting his application for a patent; that his application subsequent to that of Singer, did not, under the circumstances, relate back to the date of an earlier application; and that the invention had been in public use, with his knowledge and consent, more than two years before his second application. *Wickersham v. Singer*, 1 *McArthur Pat. Cas.* 645.

112. *Statement of Reasons and References.*

If, upon the re-examination, the application is again rejected, the reasons therefor will be fully and precisely stated. See *Rules of Prac.* Nos. 64, 89.

The rules further provide that upon the rejection of an application for want of novelty, the examiner must cite the best references at his command. If patents be cited, their dates and numbers, the names of the patentees, and the classes of invention must be stated. Where the reference shows or describes inventions other than that claimed by the applicant, the particular part relied on will be designated as nearly as practicable. The pertinence of the reference, if not obvious, must be clearly explained and the anticipated claim specified. If printed publications be cited, the title, date, page, or plate, and place of publication, or place where a copy can be found, will be given. When reference is made to facts within the personal knowledge of an employé of the office, the data will be as specific as possible, and the reference must be supported by the affidavit of such employé, which shall be subject to contradiction, explanation, and corroboration by the affidavits of the applicant and other persons. If the patent or other printed matter, plates, or drawings, so referred to, are in the possession of the office, copies will be furnished at cost upon the order of the applicant. *Rules of Prac.* No. 65; and see *Id.* 171. And whenever, in the treatment of an *ex parte* application, an adverse decision is made upon any preliminary or intermediate question, without the rejection of any claim, notice thereof, together with the reasons therefor, will be given to the applicant, in order that he may judge of the propriety

of the action. If, after receiving such notice, he traverse the propriety of the action, the matter will be reconsidered. *Id.* No. 66.

113. *Interferences.*

Whenever an application is made for a patent which, in the opinion of the commissioner, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be, and shall direct the primary examiner to proceed to determine the question of priority of invention. And the commissioner may issue a patent to the party who is adjudged the prior inventor, unless the adverse party appeals from the decision of the primary examiner, or of the board of examiners-in-chief, as the case may be, within such time, not less than twenty days, as the commissioner shall prescribe. *Rev. Stat.* § 4904.

114. *What constitutes an Interference.*

An interference is a proceeding instituted for the purpose of determining the question of priority of invention between two or more parties claiming substantially the same patentable invention. *Rule of Prac.* No. 92.

Two patents "interfere" only when they claim, wholly or partially, the same invention. *Gold, &c., Separating Co. v. United States Disintegrating Ore Co.*, 6 *Blatchf.* 307; 3 *Fish. Pat. Cas.* 439. The provision of *Rev. Stat.* § 4918, respecting interfering patents, cannot be invoked, unless it is asserted that the two patents are substantially for the same invention; that the patentee, in whose behalf the statute is pleaded, is the real discoverer of the invention therein set forth; and that the defendant has wrongfully appropriated the fruits of his invention. *Celluloid Manuf. Co. v. Goodyear Dental Vulcanite Co.*, 10 *Pat. Off. Gaz.* 1. Interferences are confined by the statute to cases where an applicant claims that for which a patent has already been granted, or that which is claimed or can be claimed in a previous pending application. Hence a reissue applicant cannot be placed in interference with an unexpired patent in which the record-date of original

application filed is subsequent to that of the reissue patentee, and which does not claim the subject-matter in conflict. *Exp. Platts, 15 Pat. Off. Gaz. 827.*

115. *When Declared.*

Interferences will be declared in the following cases, when all the parties claim substantially the same patentable invention: 1. Between two or more original applications. 2. Between an original application and an unexpired patent, when the applicant, having been rejected on the patent, shall file an affidavit showing that he made the invention before the patentee's application was filed. 3. Between an original application and an application for the reissue of a patent granted during the pendency of such original application. 4. Between an original application and a reissue application, when the original applicant shall file an affidavit showing that he made the invention before the patentee's original application was filed. 5. Between two or more applications for the reissue of patents granted on applications pending at the same time. 6. Between two or more applications for the reissue of patents granted on applications not pending at the same time, when the applicant for reissue of the latter patent shall file an affidavit showing that he made the invention before the application on which the earlier patent was granted was filed. 7. Between a reissue application and an unexpired patent, if the original applications were pending at the same time, and the reissue applicant shall file an affidavit showing that he made the invention before the original application of the other patentee was filed. 8. Between an application for reissue of a later unexpired patent and an earlier unexpired patent granted before the original application of the latter patent was filed, if the reissue applicant shall file an affidavit showing that he made the invention before the original application of the earlier patent was filed. *Rules of Prac. No. 93.*

The fact that one of the parties has already obtained a patent will not prevent an interference; for, although the commissioner has no power to cancel a patent, he may grant a patent for the same invention to another person who proves to be the prior inventor. *Id. No. 92.*

116. *When Refused.*

An applicant whose foreign patent is antecedent to any record-date of the domestic patent cited in refusal of the application, is entitled to the issue of his patent, without interference; when the domestic patent makes no claim to the common subject-matter. *Exp. Bland*, 15 *Pat. Off. Gaz.* 828.

A claim, by an applicant for a patent, of that which is shown but not claimed in a previous patent, is not ground for declaring an interference. *Marvin v. Lillie*, 27 *Pat. Off. Gaz.* 299.

An interference should not be declared merely because the purpose of both parties is the same, and both have invented improved means which are supposed to be adequate for the purpose, unless the means are substantially the same. That the specification of one party is, in some of its terms, broad enough to cover some of the forms of the invention of the other, is not conclusive. *O'Reilly v. Smith*, 1 *MacArthur Pat. Cas.* 218.

No interference will be declared between pending applications, nor between a pending application and an unexpired patent, unless there are conflicting claims; but where an application is involved in an interference in part and shows and describes, without claiming, a patentable invention claimed by another party thereto, the applicant may, at any time within twenty days after the statements of the parties have been received and approved, on motion duly made, as provided in Rule 149, file an amendment of his application duly claiming such invention, and on the admission of such amendment the invention shall be included in the interference. [Subsequent proceedings thereon prescribed.] *Id.* No. 94.

Before the declaration of interference all preliminary questions must be settled by the primary examiner, and that issue must be clearly defined; the invention which is to form the subject of the controversy must be decided to be patentable, and the claims of the respective parties must be put in such condition that they will not require alteration after the interference shall have been finally decided, unless the testimony adduced upon the trial shall necessitate or justify such change. *Id.* No. 95.

Where, however, a party who is required to put his case in a condition proper for an interference fails to do so within a reasonable time specified, the declaration of interference will not be delayed. After final judgment of priority the application of such

party will be held for revision and restriction, subject to interferences with other applications or new references. *Id.* No. 46; and see *Id.* No. 93.

117. *Examiner of Interferences. Notices. Disclaimer.*

When an interference is found to exist and the applications are prepared therefor, the primary examiner will forward to the examiner of interferences, together with the files and drawings, notices of interference for all the parties, as specified in Rule 102 (*post*, p. 155), which will disclose the name and residence of each party and that of his attorney, and if any party, as such, be a patentee, the date and number of the patent, and the date of its application, the ordinals of conflicting claims, and the invention claimed, which shall be clearly and concisely defined, in so many counts or branches as may be necessary in order to include all interfering claims. Whenever it shall be found that two or more parties whose interests are in conflict are represented by the same attorney, the examiner in charge will notify each of said principal parties, and also the attorney, of this fact. *Rules of Prac.* No. 97.

Upon receipt of the notices of interference, the examiner of interferences will make an examination thereof, in order to ascertain whether the issue between the parties has been clearly defined, and whether it is otherwise correct. If he be of opinion, upon such examination, that the notices are ambiguous in this particular, or are imperfect in any material point, he will transmit his objections to the primary examiner, who will promptly notify him of his decision to amend or not to amend them. *Id.* No. 98.

In case of a material disagreement between the examiner of references and the primary examiner, they shall refer the points of difference to the commissioner for decision. *Id.* No. 99.

The primary examiner will retain jurisdiction of the case until the declaration of interference is made. *Id.* No. 100.

When the notices of interference have been settled, the examiner of interferences will add thereto a designation of the time within which the statements required by Rule 105 (*post*, p. 156) must be filed, and will, *pro forma*, institute and declare the interference by forwarding the notices to the several parties to the interference. *Id.* No. 101.

Notices of interference will be forwarded by the examiner of interferences to all the parties, or to their attorneys, or, in case the

application or patent in interference has been assigned, to the assignees. When one of the parties has received a patent, a notice will be sent to the patentee and to his attorney of record. When one of the parties resides abroad and has no known agent in the United States, notice, in addition to that sent by mail, may be given by publication in the *Official Gazette* for such period of time as the commissioner may direct. *Id.* No. 102.

Upon the institution and declaration of the interference, as provided in Rule 101 (*ante*, p. 154), the examiner of the interferences will take jurisdiction of the same, which will then become a contested case; but the primary examiner will determine the motions mentioned in Rule 116 (*ante*, p. 158), as herein provided. *Id.* No. 103.

An applicant involved in an interference may, with the written consent of the assignee, when there has been an assignment, before the date fixed for the filing of his statement, in order to avoid the continuance of the interference, disclaim under his own signature, attested by two witnesses, the invention of the particular matter in issue, and upon such disclaimer and the cancellation of any claims involving such interfering matter judgment shall be rendered against him, and the disclaimer shall be embodied in and form part of his specification. *Id.* 104.

118. *Preliminary Statements.*

Each party to the interference will be required to file a concise statement, under oath, showing the date of his original conception of the invention, of the making of a drawing, of the making of a model, of its disclosure to others, of its reduction to practice, and of the extent of its use. The parties will be strictly held in their proof to the dates set up in their statements. The statement must be sealed up before filing (to be opened only by the examiner of interferences), and the name of the party filing it, the title of the case, and the subject of the invention indicated on the envelope. The statements shall not be opened to the inspection of the opposing parties until both shall have been filed, or the time for filing both with any extension thereof shall have expired, nor then unless they have been examined by the proper officer and found to be satisfactory. When the invention was made abroad the statement should set forth when and where, if ever, the invention was patented (giving the date and number of the patent) and when, if ever,

it was described in a printed publication (giving the title, date and place of publication), and when, if ever, it was introduced, or knowledge of it was introduced, into this country (giving the circumstances which are thought to establish the facts thereof). *Rules of Prac.* No. 105.

If, on such examination, a statement is found to be defective in any particular, the party shall be notified of the defect, and a time assigned within which he must cure such defect by an amended statement; but in no case will any original or amended statement be returned after it has been once filed. If a party shall refuse to file the amended statement herein referred to, he will be restricted to his record date in the further proceedings in the case. *Id.* No. 106.

If the junior party to an interference fail to file a statement, or if his statement fail to overcome the *prima facie* case made by the respective dates of application, the other may demand an immediate adjudication of the case upon the record. When there are more than two parties to the interference, and any one of them fails to file his statement, judgment may be rendered upon the record as to the party failing to file his statement, unless he be the senior party, and the interference will proceed between the remaining parties. *Id.* 107.

If any party to an interference fail to file a statement, no testimony will subsequently be received from him to prove that he made the invention at a date prior to his application. The statement can in no case be used as evidence in behalf of the party making it. *Id.* No. 108.

If either party require a postponement of the time for filing the statements, he will present his motion duly served on the other parties, with his reasons therefor, supported by affidavit, prior to the day previously fixed upon. But the examiner of interferences may, in his discretion, dispense with service of notice of such motion. *Id.* No. 109.

In case of material error in the statement, arising through inadvertence or mistake, it may be corrected on motion, upon showing to the satisfaction of the commissioner that its correction is essential to the ends of justice. The motion to correct the statement must be made, if possible, before the taking of any testimony, and as soon as practicable after the discovery of the error. *Id.* No. 110.

119. *Presumptions and Evidence.*

In original proceedings in cases of interference the several parties will be presumed to have made the invention in the chronological order in which they filed their completed applications for patents clearly illustrating and describing the invention; and the burden of proof will rest upon those who shall seek to establish a different state of facts. *Rules of Prac.* No. 111.

A time will be assigned in which the junior applicant shall complete his testimony in chief, and a further time in which the other party shall complete the testimony on his side, and a further time in which the junior applicant may take rebutting testimony, but shall take no other. If there be more than two parties, either patentees or applicants, the times for taking testimony will be so arranged that each shall have an opportunity to prove his case against prior applicants and to rebut their evidence, and also to meet the evidence of junior applicants. *Id.* No. 112.

If either party fail to take his testimony within the time assigned to him, all junior applicants having duly taken theirs, the case may, on motion duly made and served on such party, be set for hearing at any time not less than ten days after the hearing of the motion. *Id.* No. 113.

Powers of the commissioners in cases of interferences, and the usual practice of the office in respect to such cases, stated. *Potter v. Dixon*, 2 *Fish. Pat. Cas.* 381; *Hanford v. Westcott*, 16 *Pat. Off. Gaz.* 1181; *United States v. Thatcher*, 2 *MacArthur*, 24.

The rules as to the admissibility of evidence in an interference are the same as at common law. *Nichols v. Harris*, 1 *MacArthur Pat. Cas.* 302.

The applicant in an interference must show that he was the first original inventor, and it is not sufficient to show that he was an original inventor merely. *Spain v. Gamble*, 1 *MacArthur Pat. Cas.* 358.

Admissions of an applicant in derogation of his rights, made *ante litam motam*, are admissible against him in the interference proceedings. *Clarke v. Cramer*, 1 *MacArthur Pat. Cas.* 473.

In an interference case, the fact of invention, and not a knowledge of the degree of its utility, is the proper subject of inquiry. If a party omit to test the value of his invention, and fail to bring it into use, and himself remain ignorant of the extent of its value, yet if it be the same with that of a subsequent discoverer, he is

entitled to a patent over the latter. *Farley v. National Steam-Gauge Co.*, 1 *MacArthur Pat. Cas.* 618.

120. *Motions and Incidental Practice.*

If either party desire to have the hearing postponed, he will make application for such postponement by motion, and will show sufficient reason therefor by affidavit. *Rules of Prac.* No. 114; see *Id.* 149.

If either party desire an enlargement of the time assigned to him for taking testimony, he will make application therefor as provided for in Rule 150, subd. 5. *Id.* No. 115.

Motions to dissolve an interference upon the ground that no interference in fact exists, or that there has been such irregularity in declaration the same as will preclude a proper determination of the question of priority between the parties, or which deny the patentability of an applicant's claim, should, if possible, be made within twenty days after the statements of the parties have been received and approved. Such motions, when in proper form, will be transmitted by the examiner of interferences, with the files and papers, to the proper primary examiner for his determination, and he will return the files and papers to the examiner of interferences, with his decision, at the expiration of the time limited for appeal if no appeal shall have been taken, or sooner if the party entitled to appeal shall file a waiver in writing of his right of appeal, and such decision will be binding on the examiner of interferences unless reversed or modified on appeal. *Id.* No. 116; see *Id.* 118.

All lawful motions, except those mentioned in Rule 116, will be made before and determined by the tribunal having jurisdiction at the time. The filing of motions will not operate as a stay of proceedings in any case. To effect this, motion should be made before the tribunal having jurisdiction of the interference, which will, sufficient grounds appearing therefor, order a suspension of the interference pending the determination of such motion. *Id.* 117.

Appeal may be taken directly to the commissioner from decisions on all motions, except motions to dissolve interferences denying the patentability of applicants' claims, or their right to make the claims, and other lawful motions involving the merits of the case, which, when appealable, may be appealed to the board of examiners-in-chief. From a decision affirming the patentability of

the claim or the applicant's right to make the same no appeal can be taken. *Id.* No. 118.

After the interference is finally declared, it will not, except as herein otherwise provided, be determined without judgment of priority founded either upon the testimony, or upon a written concession of priority by one of the parties, signed by the inventor himself, and also, in the case of an assignment, by the assignee, or upon a written declaration of abandonment of his application, as provided by Rule 165. *Id.* No. 119.

In their decision of the question of priority, or before such decision, the examiner of interferences and the examiners-in-chief will direct the attention of the commissioner to any matter not relating to priority which may have come to their notice, and which, in their opinion, establishes the fact that no interference exists, or that there has been irregularity in declaring the same (Rule 116), or which amounts to a statutory bar to the grant of a patent to either of the parties for the claim or claims in interference. The commissioner may, before judgment on the question of priority of invention, suspend the interference and remand the case to the primary examiner for his consideration of the matters to which attention has been directed, and his decision will be subject to appeal, as in other cases. If the case shall not be so remanded, the primary examiner will, after judgment, consider any matter affecting the rights of either party to a patent which may have been called to his attention, unless the same shall have been previously disposed of by the commissioner. *Id.* No. 120; see *Id.* No. 116.

A second interference will not be declared upon a new application on the same invention filed by either party, nor will a decision be set aside after judgment, except in accordance with the principles governing the granting of new trials. *Id.* No. 121.

If at any time during the pendency of an interference the primary examiner discover new references, he may request a suspension of the interference for their consideration *ex parte* until their pertinency shall be determined, when the files and papers will be returned to the examiner of interferences and the interference dissolved or reinstated in accordance with such determination. *Id.* No. 122.

The primary examiner may request a suspension of an interference for the purpose of adding new parties; but no new parties will be added after the taking of testimony without the special order of the commissioner. *Id.* No. 123.

No amendments to the specification will be received during the pendency of an interference, except as provided in Rules 94, 104, 125. *Id.* No. 124.

When a part only of the claims of an application are involved in an interference, the applicant may withdraw from his application the claims adjudged not to interfere, and file a new application therefor, if the application can be legitimately divided, and if no more of the devices claimed in one is shown or described in the other than is necessary to an intelligent understanding of the invention claimed in the latter: Provided, That no claim shall be made in the second application, broad enough to include matter claimed in the first application as amended. *Id.* No. 125; see *Id.* No. 42.

When applications are declared to be in interference, the interfering parties will be permitted to see or obtain copies of the interfering claims, and of so much of the specifications as relate thereto, after the statements referred to in Rule 105 have been received and approved; but no information of an application will be furnished by the office to an opposing party, except as provided in Rules 97 and 102, until after the approval of such statement. *Id.* No. 126.

When it shall appear, on motion duly made, and upon satisfactory proof, that, by reason of the inability or refusal of the inventor to prosecute or defend an interference, or from other cause, the ends of justice shall require that an assignee of an undivided interest in the invention be permitted to prosecute or defend the same, the commissioner may so order. *Id.* No. 127.

121. *Principles of Decision.*

In an interference between an applicant and a patentee, the only question raised is whether the former was the prior inventor. *Warner v. Goodyear*, 1 *MacArthur Pat. Cas.* 60; *Burlew v. O'Neil*, *Id.* 168.

The jurisdiction of the commissioner in an interference is not limited to the naked question of priority; he may inquire into the patentability of the invention and determine questions relating to the public use and abandonment. *Hunt v. Howe*, 1 *MacArthur Pat. Cas.* 366.

Upon an objection, in interference proceedings, to a specification, as being vague and indefinite, the construction to be given to the specification should not be too strict and technical; if it communicates to the public the manner of carrying the invention into

effect, so that a skillful workman can carry into execution the plan of the inventor, it is sufficient. *Stephens v. Salisbury*, 1 *MacArthur Pat. Cas.* 379.

Where, in an interference proceeding, it appears that the idea or suggestion of the invention was communicated by one of the parties to the other, by whom it was practically applied, producing the desired result, the former is the sole inventor; and the latter can acquire no right to the invention by the failure of the real inventor to perfect it with due diligence. *Stearns v. Davis*, 1 *MacArthur Pat. Cas.* 696.

A decision upon the question of interference is necessary to confer jurisdiction upon the question of priority; and the jurisdictional matter must be first determined. *Bain v. Morse*, 1 *MacArthur Pat. Cas.* 90; *Stephenson v. Hoyt*, *Id.* 292.

An application for a patent may be rejected on the ground of interference, although the invention of the applicant may be a better and improved mode of accomplishing the object of the patented invention, if the former be a substantial interference with the principle of the latter. *Stephenson v. Hoyt*, 1 *MacArthur Pat. Cas.* 292.

122. *Effect of Commissioner's Decision.*

Even where an interference is claimed, and as against the parties to that hearing, the commissioner's decision is not conclusive. Upon reasoning and on authority the new patent granted after a hearing merely makes out a *prima facie* case for the successful applicant. *Union Paper Bag Machine Co. v. Crane*, 1 *Holmes*, 429; 6 *Pat. Off. Gaz.* 80; 1 *Bann. & A. Pat. Cas.* 494.

The decision of the patent-office upon an interference proceeding is sufficient to entitle the successful party, as against the defeated party or his privies, to a preliminary injunction upon the question of priority of invention; but the defeated party is not precluded from raising in another action the question of novelty. *Smith v. Halkvard*, 23 *Pat. Off. Gaz.* 1832; 16 *Fed. Rep'r*, 414.

An interference in the patent-office in which priority of invention was awarded against the patent in suit does not conclude the complainant from maintaining an action thereon, if the parties are not the same. *Perry v. Starrett*, 14 *Pat. Off. Gaz.* 599; 3 *Bann. & A. Pat. Cas.* 485

The decision of the commissioner on a question of interference

will be sustained in the courts, and a preliminary injunction granted according to the priority of right as declared by him, unless it is shown to have been manifestly wrong. *Pentlarge v. Beeston*, 14 *Blatchf.* 352 ; 3 *Bann. & A. Pat. Cas.* 142.

The decision of the patent-office in an interference suit as to the priority of a certain invention binds the assignees of the inventors and purchasers from them. *Peck, &c. Co. v. Lindsay*, 2 *Fed. Rep'r*, 688 ; 18 *Pat. Off. Gaz.* 63 ; 5 *Bann. & A. Pat. Cas.* 390.

The decision of the patent office in favor of one of the parties in interference proceedings is not conclusive as an adjudication upon the question of priority of invention between them, in a suit between them as interfering patents under Rev. Stat. § 4918. *Hubel v. Tucker*, 24 *Fed. Rep'r*, 701.

123. *Affidavits and Depositions.*

The commissioner 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. *Rev. Stat.* § 4905.

The following rules have been established for taking and transmitting testimony in extensions, interferences, and other contested cases :

1. Before the depositions of witnesses are taken by either party due notice shall be given to the opposite party, as hereinafter provided, of the time and place when and where the depositions will be taken, of the cause or matter in which they are to be used, and of the names and residences of the witnesses to be examined, so that the opposite party shall have full opportunity, either in person or by attorney, to cross-examine the witnesses. If the opposite party shall attend the examination of witnesses not named in the notice, and shall either cross-examine such witnesses or fail to object to their examination, he shall be deemed to have waived any objection to their examination based on want of notice thereof. Neither party shall take testimony in more than one place at the same time, or so nearly at the same time as not to allow reasonable time to travel from one place of examination to the other.

2. The notice for taking testimony or for motions must be served (unless otherwise stipulated in an instrument in writing filed in the case) upon the attorney of record, if there be one, or, if there be no attorney of record, then upon the adverse party; and it must give the opposite party reasonable time to reach the place of examination. Such service may be made by delivering a copy of the notice to the adverse party or attorney, by leaving a copy at the usual place of business of the party or attorney with some one in the employment of such party or attorney, or by leaving a copy at the party's usual place of residence with a member of his family, or by transmission by registered letter, or by express, or when it shall be shown, to the satisfaction of the commissioner, that neither of the other modes of service herein prescribed is practicable, by publication in the *Official Gazette*; and such notice shall, with sworn proof of the fact, time, and mode of service thereof, be attached to the deposition or depositions, whether the opposing party shall have cross-examined or not.

3. Each witness before testifying shall be duly sworn according to law by the officer before whom his deposition shall be taken. The depositions shall be carefully read over by the witness, or by the officer in his hearing, and shall then be subscribed by the witness, in the presence of the officer. The officer shall annex to the deposition his certificate showing, (1) the due administration of the oath by the officer to the witness before the commencement of his testimony; (2) the name of the person by whom the testimony was written out, and the fact that, if not written by the officer, it was written in his presence; (3) the presence or absence of the adverse party; (4) the place, day and hour of commencing and taking the depositions; and (5) the fact that the officer was not connected, by blood or marriage, with either of the parties, nor interested directly or indirectly in the matter in controversy. The officer shall sign the certificate and affix thereto his seal of office, if he have such seal. He shall then, without delay, securely seal up all the evidence, notices, and paper exhibits, inscribe upon the envelope a certificate, giving the title of the case, the name of each witness, and the date of sealing, address the package, and forward the same to the commissioner of patents. If the weight or bulk of an exhibit shall exclude it from the mails, it shall be authenticated by the officer and transmitted in a separate package, marked and addressed as above provided.

4. In cases of extension, where no opposition shall be made, *ex*

parte testimony will be received from the applicant; and such testimony as may have been taken by the applicant prior to notice of opposition will be received unless taken within thirty days after filing the petition for the extension. But upon receiving notice of opposition, the applicant shall immediately give notice to the opposing party or parties of the names and residences of the witnesses whose testimony shall have been thus taken.

5. If either party shall be unable to procure the testimony of a witness within the time limited, any motion which he may make for an extension of his time must be accompanied by a statement, under oath, of the cause of such inability, the name of such witness, the facts expected to be proved by him, the steps which have been taken to procure said testimony, and the dates at which efforts have been made to procure it.

6. When a party relies upon a caveat to establish the date of his invention, the caveat itself, or a certified copy thereof, must be filed in evidence, with due notice to the opposite party.

7. Upon notice given to the opposite party before the closing of the testimony, any official record, and any special matter contained in a printed publication, if competent evidence and pertinent to the issue, may be used as evidence at the hearing. *Rules of Prac.* No. 150.

The pages of each deposition must be numbered consecutively, and the name of the witness plainly and conspicuously written at the top of each page. The testimony must be taken upon legal-cap or foolscap paper, with a wide margin on the left-hand side of the page, and with the writing on one side only of the sheet. *Id.* No. 151.

The testimony will be taken in answer to interrogatories, with the questions and answers committed to writing in their regular order by the officer, or, in his presence, by some person not interested in the case, either as a party thereto or as attorney. But, with the written consent of the parties, the depositions may be written out by other persons in the presence of the officer. No officer who is connected by blood or marriage with either of the parties, or interested, directly or indirectly, in the matter in controversy, either as counsel, attorney, agent, or otherwise, is competent to take depositions, unless with the written consent of all the parties. *Id.* 152.

By leave of the commissioner, first obtained, testimony may be taken in foreign countries:

1. Such permission will be granted only upon motion duly made. *Id.* No. 153 ; See *Id.* No. 149.

The motion must designate a place for the examination of the witnesses, at which an officer duly qualified to take testimony under the laws of the United States in a foreign country shall reside, and it must be accompanied by a statement, under oath, that the motion is made in good faith, and not for purposes of delay or of vexing or harassing any party to the case ; it must also set forth the names of the witnesses, the particular facts to which it is expected each will testify, and the grounds on which is based the belief that each will so testify.

2. It must appear that the testimony desired is material and competent, and that it cannot be taken in this country at all, or cannot be taken here without hardship and injury to the moving party greatly exceeding that to which the opposite party will be exposed by the taking of such testimony abroad.

3. Upon the granting of such motion, a time will be set within which the moving party shall file in duplicate the interrogatories to be propounded to each witness and serve a copy of the same upon each adverse party, who may, within a designated time, file, in duplicate, cross-interrogatories. Objections to any of the interrogatories may be filed at any time before the depositions are taken, and will be considered and determined upon the hearing of the case.

4. As soon as the interrogatories and cross-interrogatories are decided to be in proper form, the commissioner will cause them to be forwarded to the proper officer, with the request that, upon payment of, or satisfactory security for, his official fees, he notify the witnesses named to appear before him within a designated time and make answer thereto under oath ; and that he reduce their answers to writing, and transmit the same, under his official seal and signature, to the commissioner of patents, with the certificate prescribed in Rule 150, subd. 3.

5. By stipulation of the parties the requirements of paragraph 3, as to written interrogatories and cross-interrogatories may be dispensed with, and the testimony may be taken before the proper officer upon oral interrogatories by the parties or their agents.

6. Unless false swearing in the giving of such testimony before the officer taking it shall be punishable as perjury, under the laws of the foreign state where it shall be taken, it will not stand on the same footing, in the patent-office, as testimony duly taken in the

United States ; but its weight in each case will be determined by the tribunal having jurisdiction of such case.

No evidence touching the matter at issue will be considered on the hearing which shall not have been taken and filed in compliance with these rules. But no notice will be taken of any merely formal or technical objection which shall not appear to have wrought a substantial injury to the party raising it ; and in case of such injury it must be made to appear that, as soon as the party became aware of the ground of objection, he gave notice thereof to the office, and also to the opposite party, informing him at the same time that, unless it should be removed, he should urge his objection at the hearing. This rule is not to be so construed as to modify established rules of evidence, which will be applied strictly in all practice before the office. *Id.* No. 154.

The law requires the clerks of the various courts of the United States to issue subpoenas to secure the attendance of witnesses whose depositions are desired as evidence in contested cases in the patent-office. *Id.* No. 155.

After testimony is filed in the office it may be inspected by any party to the case, but it cannot be withdrawn for the purpose of printing. It may be printed by some one specially designated by the office for that purpose, under proper restrictions. *Id.* No. 156.

Six or more printed copies of the testimony must be furnished—five for the use of the office, and one for the use of each of the opposing parties. The statement required by Rule 105 must be printed as a part of the record. These copies must be filed not less than one week before the day of hearing. They will have wide margins, with the names of the witnesses at the top of the pages over their testimony, and will contain indexes with the names of all witnesses, and references to the pages where their testimony may be found, and also to the pages where copies of papers and documents introduced as exhibits are shown. Printing can only be dispensed with on special application based upon satisfactory reasons, in which case manuscript copies must be furnished—one for the office and one for each adverse party. *Id.* No. 157.

It is desirable that arguments and briefs in all contested cases should be submitted in printed form, and filed before the hearing. If either party fail to comply with this regulation, no extension of time will be granted for the purpose, except upon consent of the adverse parties. *Id.* 158.

Rules to govern the taking and transmission of evidence, made

by the commissioner in conformity to statutory provisions, have all the binding force of statutes; both as regards the commissioner himself and parties litigant before him. *Arnold v. Bishop*, 1 *MacArthur Pat. Cas.* 27. And no notice of the taking of testimony before the examiner is waived by an appearance and cross-examination. *Ib.*

An objection to the formal sufficiency of a deposition must be raised at the hearing before the commissioner or it is unavailable on appeal. But the deposition may be considered on an application for an adjournment, although too informal to be admissible on final hearing. *Smith v. Flickmyer*, 1 *MacArthur Pat. Cas.* 46.

Informality in the caption of a deposition is not waived by a notice to have the deposition produced before the commissioner for inspection. *Perry v. Cornell*, 1 *MacArthur Pat. Cas.* 66.

Depositions taken in an interference may be used in a subsequent interference, when the issue is the same and the parties or their predecessors in title are the same. *McCormick v. Howard*, 1 *MacArthur Pat. Cas.* 238; *Carter v. Carter*, *Id.* 388.

Depositions used upon the original hearing before the commissioner may be used upon a re-hearing against a new party who came in subsequently to the taking of them. *Carter v. Carter*, 1 *MacArthur Pat. Cas.* 388.

124. *Subpœnas to Witnesses.*

The clerk of any court of the United States, for any district or Territory wherein testimony is to be taken for use in any contested case pending in the patent-office, shall, upon the application of any party thereto, or of his agent or attorney, issue a 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. *Rev. Stat.* § 4906

125. *Witness Fees.*

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. *Rev. Stat. § 4907.*

126. *Penalty for failing to Attend, or refusing to Testify.*

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. *Rev. Stat. § 4908.*

X. APPEALS. BILL IN EQUITY127. *Appeals from Primary Examiners to Examiners-in-chief.*

Every applicant for a patent or for the reissue of a patent, any of the claims of which have been twice rejected, and every party to an interference, may appeal from the decision of the primary examiner, or of the examiner in charge of interferences in such case, to the board of examiners-in-chief; having once paid the fee for such appeal. *Rev. Stat. § 4909.*

The fee prescribed is ten dollars. See *Rev. Stat.* § 4934 ; *Rules of Prac.* 128.

To allow such appeal there must have been two rejections of the claims as originally filed, or, if amended in matter of substance, of the amended claims, and all the claims must be passed upon, and all preliminary and intermediate questions relating to matters not affecting the merits of the invention settled, before the case is appealed to the examiners-in-chief. *Rules of Prac.* No. 129.

Upon the filing of the appeal the same shall be submitted to the primary examiner, who, if he find the appeal to be regular in form, shall furnish the examiners-in-chief with a written statement of the grounds of his decision on all the points involved in the appeal, with copies of the rejected claims, and with the references applicable thereto. If the primary examiner shall decide that the appeal is not regular in form, an appeal from such decision may be taken directly to the commissioner, as provided in Rule 140. *Id.* No. 130.

The appellant shall, before the day of hearing, file a brief of the authorities and arguments on which he will rely to maintain his appeal. *Id.* No. 131.

If the appellant desire to be heard orally before the examiners-in-chief, he will so indicate when he files his appeal ; a day of hearing will then be fixed, and due notice of the same given to him. *Id.* No. 132.

In contested cases the appellant shall have the right to make the opening and closing arguments unless it shall be otherwise ordered by the tribunal having jurisdiction of the case. *Id.* No. 133.

The examiners-in-chief in their decision will affirm or reverse the decision of the primary examiner only on the points on which appeal shall have been taken. (See Rule 128.) If they shall discover any apparent grounds not involved in the appeal for granting or refusing letters patent in the form claimed, or in any other form, they will annex to their decision a statement to that effect, with such recommendation as they shall deem proper. *Id.* No. 134.

From any judgment of the primary examiner, on points embraced in the recommendation annexed to the decision adverse to the appellant, appeal may be taken on questions involving the merits to the board of examiners-in-chief and on other questions to the commissioner, as in other cases. *Id.*

If an appeal shall be taken from the decision of the examiners-in-chief to the commissioner, the commissioner, whenever, in his opinion, substantial justice shall require it, may, either before or

after final judgment, remand the case to the primary examiner for consideration of any amendment or action based upon the recommendation annexed to the decision of the examiners-in-chief. *Id.*

If the commissioner, in revising the decision of the examiners-in-chief, shall discover any apparent grounds for granting or refusing letters patent not involved in the appeal, he will, before or after final judgment, whenever, in his opinion, substantial justice shall require, give reasonable notice thereof to the parties; and if any amendment or action based thereon shall be proposed, he will remand the case to the primary examiner for consideration. *Id.*

From decisions of the primary examiner, in cases remanded, as herein provided, appeal will lie to the board of examiners-in-chief, or directly to the commissioner, as in other cases.

If affidavits be received, under Rule 75 or 86, after the case has been appealed, the application will be remanded to the primary examiner for reconsideration. *Id.* No. 135.

128. *From Examiners-in-chief to Commissioner.*

If such party is dissatisfied with the decision of the examiners-in-chief, he may, on payment of the fee prescribed, appeal to the commissioner in person. *Rev. Stat.* § 4910.

The fee prescribed is twenty dollars. See *Rev. Stat.* § 4934; *R. les of Prac.* No. 136.

Cases which have been heard and decided by the commissioner on appeal will not be reopened except by the commissioner; cases which have been decided by the examiners-in-chief will not be reheard by them, when no longer pending before them, without the written authority of the commissioner; and cases which have been decided by either the commissioner or the examiners-in-chief will not be reopened by the primary examiner without like authority, and then only for the consideration of matters not already adjudicated upon, sufficient cause being shown. *Rules of Prac.* No. 137. See also *Id.* No. 67.

Cases will be regarded as pending before a tribunal until appeal has been taken from its decision, or until the limit of appeal which must be fixed in contested cases has expired. *Id.* No. 138.

Cases which have been deliberately decided by one commissioner will not be reconsidered by his successor except in accordance with

the principles which govern the granting of new trials. *Id.* No. 139.

Upon receiving a petition which shall state concisely and clearly any proper question, which has been twice acted upon by the examiner, and which does not involve the merits of the case, or the rejection of a claim, and which shall also state the facts involved and the point or points to be reviewed, an order will be made fixing a time for hearing such petition by the commissioner, and directing the examiner to report upon or answer the matters averred in such petition at least five days before such day of hearing. *Id.* 140.

In cases of interference parties have the same remedy by appeal to the examiners-in-chief and to the commissioner as in *ex parte* cases; but no appeal lies in such cases from the decision of the commissioner. *Id.* No. 141.

Appeals in interference cases must be accompanied with brief statements of the reasons therefor; and both parties will be required to file briefs of their arguments before the day of hearing. Printed briefs are in all cases preferred. *Id.* No. 142.

The commissioner may, in his discretion, order a rehearing, and upon such rehearing may revise his original decision. *Matthews v. Weede*, 1 *MacArthur Pat. Cas.* 144; *Re Rouse*, *Id.* 286; *Nichols v. Harris*, *Id.* 362.

129. *From the Commissioner to the Supreme Court, District of Columbia.*

If such party, except a party to an interference, is dissatisfied with the decision of the commissioner, he may appeal to the Supreme Court of the District of Columbia, sitting in banc. *Rev. Stat.* § 4911.

It is no longer customary in the patent-office to allow *pro forma* proceedings, in order to give opportunity for an appeal to the Supreme Court of the District. *Rules of Prac.* No. 145.

The rules and forms for these appeals are given in the Appendix to the Rules.

The refusal by the commissioner of patents to grant a patent to an assignee does not form the subject of an appeal to a judge at chambers in the Supreme Court of the District of Columbia. *Whitney v. Fisher*, 4 *Fish. Pat. Cas.* 248.

No appeal lies from a decision of the commissioners upon the

relative priority of two pending interfering applications for a patent. *Exp. Gower*, 15 *Pat. Off. Gaz.* 828.

Patentee has no right of appeal from the decision of the commissioner in an interference between the patentee and the applicant for a patent; the latter only has the right, the patentee being left to his remedy by action. *Pomeroy v. Connison*, 1 *McArthur Pat. Cas.* 40.

An appeal did not lie from the refusal of a commissioner to reopen a hearing upon an application under the acts of 1836 and 1839. *Re Janney*, 1 *MacArthur Pat. Cas.* 86. Under the act of 1839, the reasons of appeal filed upon appealing from a decision of the commissioner limit the jurisdiction of the appellate court, and where these reasons are vague and indefinite they will not be considered by the court. *Re Winslow*, 1 *MacArthur Pat. Cas.* 123; *Jillson v. Winsor*, *Id.* 136; *Burlew v. O'Neil*, *Id.* 168.

Upon appeal the court will pass upon the merits of the case without regard to the reasons which the commissioner assigned for his decision; those reasons may be wrong and still the decision be correct. *Re Aiken*, 1 *MacArthur Pat. Cas.* 126; *Re Aiken*, *Id.* 130; *Re Crooker*, *Id.* 134.

Upon appeal the ruling of the commissioner upon the admission of evidence cannot be reviewed, unless such ruling was specifically set forth in the reasons of appeal. *Jillson v. Winsor*, 1 *MacArthur Pat. Cas.* 136.

The right to appeal from the decision of the commissioner, given by section 11 of the act of 1839, is lost by failing to file the reasons of appeal within the time prescribed therefor, although a motion for a rehearing is pending, unless a special order enlarging the time is made. *Greenough v. Clark*, 1 *MacArthur Pat. Cas.* 173.

Refusal of the commissioner to admit competent and material evidence offered by an applicant was ground for appeal from his decision, under the acts of 1836 and 1839, and upon each appeal an order might be made directing the case to be reheard and the evidence to be admitted before the commissioner. *Re Fultz*, 1 *MacArthur Pat. Cas.* 178.

The court cannot review the commissioner's exercise of his discretionary power in extending time for taking testimony in an interference proceeding; granting a rehearing, &c. *Mathews v. Weede*, 1 *MacArthur Pat. Cas.* 144; *O'Reilly v. Smith*, *Id.* 218; *Re Rouse*, *Id.* 287; *Nichols v. Harris*, *Id.* 362.

A decision of the commissioner rejecting an application for a patent for want of novelty, upon references to other inventions, should be reversed upon appeal, where the references originally relied upon are virtually abandoned and others presented for the first time on the appeal. *Re Jewett*, 1 *MacArthur Pat. Cas.* 259.

That a commission to take testimony in interference proceedings was executed before a magistrate who was of counsel for one of the parties is ground for reversal of a decision of the commissioner founded upon the depositions so taken. *Nichols v. Harris*, 1 *MacArthur Pat. Cas.* 302.

Decision of the commissioner against an applicant in an interference case upon the ground that the invention was not operative, reversed upon appeal, the testimony of witnesses that they had tested the device and found that it would not work being overcome by the production and operation in court of the machine itself. *Bell v. Hill*, 1 *MacArthur Pat. Cas.* 351.

In determining an appeal from the commissioner of patents, the supreme court of the District of Columbia will look only into the reasons of appeal, and into the records and proceedings in the case which are applicable to these reasons. *Re Conklin*, 1 *MacArthur Pat. Cas.* 375 ; 5 *Pat. Off. Gaz.* 235.

The jurisdiction of the appellate court in interference cases is not limited to cases where the commissioner has awarded priority ; but an appeal may be taken from his refusal to grant any patent. *Carter v. Carter*, 1 *MacArthur Pat. Cas.* 388.

Decision of the commissioner in an interference case, reversed, upon the evidence, the negative testimony of a single witness who was in a position to know the fact testified being deemed sufficient, under the circumstances, to outweigh the positive testimony of two witnesses, whose answers appeared to be evasive and unfair. *Cornell v. Hyatt*, 1 *MacArthur Pat. Cas.* 423.

No appeal lies from an interlocutory decision of the commissioner, such as a refusal to extend the time for taking testimony. *Wellman v. Blood*, 1 *MacArthur Pat. Cas.* 432.

A claim filed upon an application for a patent, construed, upon appeal from a rejection, by giving it the interpretation most favorable to the applicant, and held to be for a patentable combination, although in each of the features of the improvement, separately considered, there was strong resemblance to known things and known results ; the combination differing from each and all in the

specific result, and appearing by the united action to accomplish the desired result with a saving of material and of operative force. *Re Cole*, 1 *MacArthur Pat. Cas.* 539.

Under section 8 of the act of 1836, an appeal from a decision of the commissioner of patents in an interference case might be taken by a patentee where the decision was in favor of the patentee. *Babcock v. Degener*, 1 *MacArthur Pat. Cas.* 607. Overruling on this point, *Pomeroy v. Connor*, *Id.* 40, which had been followed in the following cases: *Brown v. Herrick*, *Id.* 310; *Whipple v. Renton*, *Id.* 332; *Hopkins v. Barnum*, *Id.* 334; *Drake v. Cunningham*, *Id.* 378; *King v. Gedney*, *Id.* 443.

The commissioner of patents had the power, under section 11 of the act of 1839, to enlarge the time for taking an appeal from his decision. *Justice v. Jones*, 1 *MacArthur Pat. Cas.* 635.

The owner of a label entitled to registration made application to the commissioner for its registration, and had complied with all the requirements of the law; but the examiner rejected the application on the ground that the label was not of the class entitled to registration. The applicant, instead of appealing to the commissioner, petitioned the Supreme Court of the District of Columbia for a mandamus to compel the commissioner to register his label. The commissioner, in his answer to the rule to show cause, recited the facts of the failure of the applicant to appeal to the commissioner from the examiner's decision, but at the same time approved of and indorsed the reasons of the examiner for refusing to register the label. It was *held*, that a peremptory mandamus to register the label should issue. *United States v. Marble*, 1 *Mackey*, 284; 2 *Pat. Off. Gaz.* 1366.

Under the act of 1839 the attorney general advised, that, in order to be effectual, the certificate of the proceedings and decision of a justice of the Supreme Court of the District of Columbia in an appeal from the commissioner of patents, required to be delivered and returned by him to the commissioner, must be made and certified by the justice while he is in office; but, if so made and certified, it may be transmitted by him to the commissioner after he has ceased to be a justice. 13 *Op. Att. Gen.* 265.

The requirement of section 7 of the act of 1836 that the applicant shall make oath anew when he persists in his application after having been informed by the commissioner of the errors or defects of his specification, does not make a new oath necessary to enable

him to appeal when his application is finally rejected. *Re Crooker*, 134.

130. *Notice of and Proceedings on such Appeals.*

When an appeal is taken to the supreme court of the District of Columbia, the appellant shall give notice thereof to the commissioner, and file in the patent-office, within such time as the commissioner shall appoint, his reasons of appeal, specifically set forth in writing. *Rev. Stat.* § 4912.

The court shall, before hearing such appeal, give notice to the commissioner of the time and place of the hearing, and on receiving such notice the commissioner shall give such notice of such time and place in such manner as the court may prescribe, to all parties who appear to be interested therein. The party appealing shall lay before the court certified copies of all the original papers and evidence in the case, and the commissioner shall furnish the court with the grounds of his decision, fully set forth in writing, touching all the points involved by the reasons of appeal. And at the request of any party interested, or of the court, the commissioner and the examiners may be examined under oath in explanation of the principles of the thing for which a patent is demanded. *Rev. Stat.* § 4913.

131. *Determination of such Appeal, and its Effect.*

The court, on petition, shall hear and determine such appeal, and revise the decision appealed from in a summary way, on the evidence produced before the commissioner, at such early and convenient time as the court may appoint; and the revision shall be confined to the points set forth in the reasons of appeal. After hearing the case the court shall return to the commissioner a certificate of its proceedings and decisions, which shall be entered of record in the patent-office, and shall govern the further proceedings in

the case. But no opinion or decision of the court in any such case shall preclude any person interested from the right to contest the validity of such patent in any court wherein the same may be called in question. *Rev. Stat.* § 4914.

The Revised Statutes of the District of Columbia, Provide, on the subject of "Appeals from Commissioner of Patents," as follows: "The supreme court" [of the District of Columbia], "sitting in banc, shall have jurisdiction of and shall hear and determine all appeals from the decisions of the commissioner of patents," in accordance with the provisions of section 4911 to section 4915, inclusive of the Revised Statutes of the United States. *Rev. Stat. Dist. Col.* § 780.

132. *Patents obtained by Bill in Equity.*

Whenever a patent on application is refused, either by the commissioner of patents or by the supreme court of the District of Columbia upon appeal from the commissioner, the applicant may have remedy by bill in equity; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim, or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent on the applicant filing in the patent-office a copy of the adjudication, and otherwise complying with the requirements of law. In all cases, where there is no opposing party, a copy of the bill shall be served on the commissioner; and all the expenses of the proceedings shall be paid by the applicant, whether the final decision is in his favor or not. *Rev. Stat.* § 4915; and see *Id.* § 629.

Rev. Stat. § 4915 does not give the courts general appellate jurisdiction in cases of interference. And it would be improper for a court to enjoin the applicant who prevails before the commissioner from receiving his patent, upon the mere suggestion that the commissioner erred in his decision. *Whipple v. Miner*, 15 *Fed. Rep'r*, 117 ; 23 *Pat. Off. Gaz.* 2236.

The jurisdiction of the circuit courts to grant a patent, notwithstanding an adverse decision of the commissioner of patents, is an independent original jurisdiction ; it is not within the discretion of the defeated party to say when and under what circumstances the action of the office shall be suspended. *Ib.*

If an applicant is dissatisfied with limitations imposed by the commissioner, he should resort to the courts in the same manner as from a rejection of his application. *New York Belting, &c. Co. v. Sibley*, 15 *Fed. Rep'r*, 386 ; 23 *Pat. Off. Gaz.* 1444.

The circuit court has jurisdiction of a bill to obtain the issue of a patent refused by the commissioner of patents ; and the commissioner, by accepting service of process has been *held* to subject himself to such jurisdiction in a district in which he did not reside. *Vermont Farm Machine Co. v. Marble*, 20 *Fed. Rep'r*, 117.

The suit in equity authorized under Rev. Stat. § 4915, is an original and not an appellate proceeding. It is conducted according to equity rules, and a party contesting his right to a patent thereunder need not be confined to matters existing of record in the patent-office or in the supreme court of the District of Columbia. In this case a motion to appoint a special examiner, under the rules of the court, for the purpose of taking additional testimony, was accordingly granted. *Re Squire*, 12 *Pat. Off. Gaz.* 1025 ; 3 *Bann. & A. Pat. Cas.* 133.

Upon a suit under Rev. Stat. § 4915, a court of equity will not aid the inventor to obtain a patent himself in direct violation of his agreement transferring the property in his invention. *Runstetler v. Atkinson*, 23 *Pat. Off. Gaz.* 940.

Rev. Stat. § 4915, providing a remedy by bill in equity for an erroneous decision on an interference case, means a proceeding in a court of the United States having original equity jurisdiction under the patent laws, according to the ordinary course of equity practice and procedure ; not a technical appeal confined to the case as made in the record of the patent-office, but a suit prepared and heard upon all competent evidence, and the whole merits ; the

decree in which is conclusive on the department. Matthews, J., in *Butterworth v. Hoe*, 112 *U. S.* 50, 61.

Such bill is the only mode allowed, of reviewing a commissioner's decision on an interference; there is no appeal from such decision. *Butler v. Shaw*, 21 *Fed. Rep'r*, 321.

The commissioner need not be a party to such bill; an assignee of defendant's patent should be a defendant. *Graham v. Teter*, 25 *Fed. Rep'r*, 555; 33 *Pat. Off. Gaz.* 758.

XI. SURRENDER AND REISSUE.

133. *Reissue of Defective Patents.*

Whenever any patent is inoperative or invalid, by reason of a defective or insufficient specification, or by reason of the patentee claiming as his own invention or discovery more than he had a right to claim as new, if the error has arisen by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, the commissioner shall, on the surrender of such patent and the payment of the duty required by law, cause a new patent for the same invention, and in accordance with the corrected specification, to be issued to the patentee, or, in the case of his death or of an assignment of the whole or any undivided part of the original patent, then to his executors, administrators, or assigns, for the unexpired part of the term of the original patent. Such surrender shall take effect upon the issue of the amended patent. The commissioner may, in his discretion, cause several patents to be issued for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for a reissue for each of such reissued letters patent. The specifications and claim in every such case shall be subject

to revision and restriction in the same manner as original applications are. Every patent so reissued, together with the corrected specifications, shall have the same effect and operation in law, on the trial of all actions for causes thereafter arising, as if the same had been originally filed in such corrected form ; but no new matter shall be introduced into the specification, nor in case of a machine patent shall the model or drawings be amended, except each by the other : but when there is neither model nor drawing, amendments may be made upon proof satisfactory to the commissioner that such new matter or amendment was a part of the original invention, and was omitted from the specification by inadvertence, accident, or mistake, as aforesaid. *Rev. Stat. § 4916.*

134. *General Nature, Scope and Extent of the Right of Reissue.*

A reissue is granted to the original patentee, his legal representatives, or the assignees of the entire interest, when, by reason of a defective or insufficient specification, or by reason of the patentee claiming as his invention or discovery more than he had a right to claim as new, the original patent is inoperative or invalid, provided the error has arisen from inadvertence, accident, or mistake, and without any fraudulent or deceptive intention. In the cases of patents issued and assigned prior to July 8, 1870, the applications for reissue may be made by the assignees ; but in the cases of patents issued or assigned since that date the applications must be made and the specification sworn to by the inventors, if they be living. *Rules of Prac. No. 84.*

Matter which is shown and described, and might have been lawfully claimed, in an unexpired patent, but was not claimed by reason of a defect or insufficiency in the specification, arising from inadvertence, accident or mistake, and without fraud or deceptive intent, cannot be subsequently claimed by the patentee in a separate patent, but only in a reissue of the original patent. *Rules of Prac. No. 91.*

If an inventor has produced a new and useful combination, which composes an organized machine, and also made new inventions of a less number of elements of the same combination than what compose the entire machine, he may, with the proper descriptions, claim the whole combination, and also the lesser ones, or ones composed of fewer elements than what make up the whole machine. He may, if he choose, make the several claims in one patent. If by inadvertence, accident, or mistake, he has failed in his original patent to claim any of the lesser combinations not embracing the whole machine, he can surrender his patent, and obtain a reissue for any additional claims so omitted in the original. *Stevens v. Pritchard*, 4 *Cliff.* 417 ; 10 *Pat. Off. Gaz.* 505 ; 2 *Bann. & A. Pat. Cas.* 390.

Prior use under a defective patent will not authorize the use of the invention after the issue of a renewed patent. *McWilliams Manuf. Co. v. Blundell*, 11 *Fed. Rep'r*, 419 ; 22 *Pat. Off. Gaz.* 177 ; *Hussey v. Bradley*, 5 *Blutchf.* 134 ; 2 *Fish. Pat. Cas.* 362.

As to reissue of patents which have been already extended, see *Woodworth v. Edwards*, 3 *Woodb. & M.* 120 ; *Gibson v. Harris*, 1 *Blutchf.* 167 ; *Wilson v. Rousseau*, 4 *How.* 646.

That a patent may be amended and reissued as often as errors are discovered,—see *Morse v. Bain*, 9 *West. L. J.* 106.

135. *Surrender ; How Made, and its Effect.*

The surrender of a patent extinguishes it ; cancels it ; and no right can afterward be asserted upon it. Suits pending for an infringement of a patent fall with its surrender, because the foundation upon which they were commenced no longer exists (*Mosfitt v. Garr*, 1 *Black*, 273 ; *Peck v. Collins*, 103 *U. S.* 660) ; but a person who under an honest misapprehension surrenders a valid patent, and takes out a reissue which proves to be void, is entitled to a reissue of the first patent in the identical language originally used. *Giant Powder Co. v. Safety Nitro Powder Co.*, 19 *Fed. Rep'r*, 509.

That when a reissue is adjudged invalid, the surrender which preceded it will also be invalidated ; and the original patent will be treated as remaining in force,—see *Woodworth v. Hall*, 1 *Woodb. & M.* 248 ; 6 *Pa. L. J.* 178 ; *Woodworth v. Hall*, 1 *Woodb. & M.* 389 ; *Woodworth v. Edwards*, 4 *Woodb. & M.* 129.

136. *Loss of the Right, by Delay.*

The right to have corrections made by reissue may be abandoned and lost by unreasonable delay. *Miller v. Brass Co.*, 104 *U. S.* 350 ; aff'g 14 *Blatchf.* 282 ; 12 *Pat. Off. Gaz.* 667 ; 3 *Bann. & A. Pat. Cas.* 20 ; *Turrell v. Bradford*, 23 *Pat. Off. Gaz.* 1623 ; 15 *Fed. Rep'r*, 808 ; *Wollensak v. Reiher*, 115 *U. S.* 96.

Where a specific device or combination is claimed, the non-claim of other devices or combinations apparent on the face of the specification is, in law, so far as the patentee is concerned, a dedication of them to the public, and will so be enforced, unless he with all due diligence surrenders his patent for reissue, and proves that his omission to claim them arose wholly from inadvertence, accident, or mistake. *Miller v. Brass Co.*, *supra*. Followed, in case of a patent reissued 14 years after the original. *Baltimore Car Wheel Co. v. North Baltimore Passenger R. Co.*, 21 *Fed. Rep'r*, 47.

The right to have a mistake in a patent corrected does not depend upon what information the patentee or his assignee actually had of the mistake, but as to what they might have had if they had availed themselves of the opportunities at their command to discover it. *Ives v. Sargent*, 17 *Fed. Rep'r*, 447.

Action of the patent-office in granting a reissue is not conclusive on the question of laches of the patentee in applying for it ; the question is ultimately one of law for the court, and if there was delay and it cannot be accounted for, it may invalidate the reissue. *Wollensak v. Reiher*, 115 *U. S.* 96. Two years' delay in applying for a reissue, was *held* not unreasonable where no adverse rights had accrued meantime. *Stutz v. Armstrong*, 20 *Fed. Rep'r*, 843. The application for a reissue is not an application for a patent, but for the amendment of one, and is not such an application as must be made before two years of public use have been had. *Shaw v. Colwell Lead Co.*, 11 *Fed. Rep'r*, 711 ; 20 *Blatchf.* 417.

The facts that a patentee was a foreigner, unfamiliar with the English language, and ignorant of the omission from his patent of a claim contained in his application but rejected, the rejection having been acquiesced in by his solicitors, was *held*, not sufficient to excuse delay of more than two years in applying for a reissue. *Boland v. Thompson*, 26 *Fed. Rep'r*, 633.

137. *Who may Surrender for Reissue : Rights of Assignees.*

In respect to the right of a patentee to surrender a defective patent and take out a new one, there is no difference between a citizen and an alien. *Shaw v. Cooper*, 7 *Pet.* 292, 315.

A patentee, to be entitled to a reissue, must have been the first to disclose the invention in the record existing in the patent-office. *Exp. Platts*, 15 *Pat. Off. Gaz.* 827.

There was nothing in the act of 1836 to restrict the right of surrendering a patent and taking a renewal thereof upon amended specifications because of special or limited grants or licenses previously made. *Smith v. Plympton*, 4 *West. L. J.* 49. Compare *Brooks v. Bicknell*, 4 *McLean*, 64 ; 3 *West. L. J.* 35 ; *Smith v. Mercer*, 5 *Pa. L. J.* 529.

Where a patent had by the death of the patentee devolved upon his executor, and had been by him assigned, the assignee may take a reissue in his own name and for his own benefit ; the statutory provisions authorizing a reissue are remedial, and are to be liberally construed. *Carew v. Boston Elastic Fabric Co.*, 1 *Holmes*, 45. And see another proceeding in same case, 3 *Cliff.* 356 ; 1 *Pat. Off. Gaz.* 91 ; 5 *Fish. Pat. Cas.* 90.

Under Rev. Stat. § 4895,—which provides for reissues of patents to assignees, the ultimate assignee may apply, though there may be intermediate ones through whom he derived the interest of the inventor ; and if the inventor parted with his interest before July 8, 1870, it is not necessary that he join in the application. *Selden v. Stockwell Self-lighting Gas-burner Co.*, 9 *Fed. Rep'r*, 390 ; 19 *Blatchf.* 544 ; 20 *Pat. Off. Gaz.* 1377. To same effect, under previous statutes, *Swift v. Whisen*, 2 *Bond*, 115 ; 3 *Fish. Pat. Cas.* 343.

Where there has been an assignment of an undivided part of the whole original patent, the assignee of such part and the patentee become joint owners of the patent, and should join in the surrender ; if they do not, it will be invalid, unless the part owner not joining shall ratify it. *Potter v. Holland*, 4 *Blatchf.* 206 ; 1 *Fish. Pat. Cas.* 327. And see *Commissioner of Patents v. Whiteley*, 4 *Wall.* 522.

A patentee cannot, by a surrender of his patent, affect the rights of third persons, to whom he had previously, by assignment, passed

his interest in the whole or a part of the patent, without the consent of such assignee. *Woodworth v. Stone*, 3 *Story*, 749. Such persons are entitled, upon the surrender of the patent and the obtaining of a reissued patent by the patentee, to the same right, under the reissued patent, that they had to the old one; but they cannot be compelled to take under the reissued one. *Potter v. Holland*, 4 *Blatchf.* 206; 1 *Fish. Pat. Cas.* 327. Where a patentee had sold all his right, title, and interest in his patent, except as to a little town; and subsequently, at the request of the assignees, applied for, and obtained, a reissue of the patent in his own name, which reissued patent he assigned as before, it was *held*, that the surrender of the original patent, at the request of the true owners, was valid; and that if the reissue to the patentee was a clerical error, he had corrected it by the subsequent assignment. *Wing v. Warren*, 5 *Fish. Pat. Cas.* 548.

Assent to the surrender of a patent by a transferee of an interest in it, who is not an assignee within the meaning of the statute, is not essential to the validity of a reissued patent. *Meyer v. Bailey*, 2 *Bann. & A. Pat. Cas.* 73; 3 *Pat. Off. Gaz.* 437. If an assignee accepts the reissue of a patent and transfers a part of the interest in it which was originally vested in him by the patentee, it is a ratification by him of the act of the patentee in securing the reissue, although he did not join in the surrender of the original patent. *Ib.*

Although an inventor has conveyed all his interest, yet if his assignment has not been recorded, the assignee cannot, after the patent has been reissued, demand issue of a patent to himself. *Whitely v. Fisher*, 4 *Fish. Pat. Cas.* 248; 5 *Id.* 528.

Amendments to a patent made on a reissue thereof will inure to the benefit of the assignees and grantees under the patent as it stood before such reissue; but such grantees may, if they prefer, rest their claims upon the specification as it stood when they purchased their right. *Smith v. Plympton*, 4 *West. L. J.* 49. See, also, *Smith v. Mercer*, 5 *Pa. L. J.* 529.

138. *The Application for a Reissue.*

The petition for a reissue must be accompanied with a certified copy of the abstract of title, giving the names of all assignees owning any undivided interest in the patent; and in case the appli-

cation is made by the inventor, it must be accompanied with the written assent of such assignees. *Rules of Prac.* No. 85.

Applicants for reissue, in addition to the requirements of rule 45, must also file with their petitions a statement on oath as follows :

1. That applicant verily believes the original patent to be inoperative or invalid, and the reason why.

2. Where it is claimed that such patent is so inoperative or invalid "by reason of a defective or insufficient specification," particularly specifying such defects or insufficiencies.

3. Where it is claimed that such patent is inoperative or invalid "by reason of the patentee claiming as his own invention or discovery more than he had a right to claim as new," distinctly stating such part or parts so alleged to have been so improperly claimed as new.

4. Particularly specifying the errors which it is claimed constitute the inadvertence, accident, or mistake relied upon, and how they arose or occurred.

5. That said errors arose "without any fraudulent or deceptive intention" on the part of the applicant. *Rules of Prac.* No. 86.

A reissue claiming matters not in the original patent, and which did not infringe it, was *held* invalid, where, owing to the death of the inventor before the application for reissue, it was not supported by his oath as to inadvertence, accident or mistake. *Wooster v. Handy*, 22 *Blatchf.* 307 ; 21 *Fed. Rep'r*, 51 ; 28 *Pat. Off. Gaz.* 629.

The applicant for a reissue is not required to take any oath on the subject of the invalidity of his original patent. *Hartshorn v. Eagle Shade Roller Co.*, 18 *Fed. Rep'r*, 90 ; 25 *Pat. Off. Gaz.* 1191. He need not use the exact phraseology of the statute, if he employs language which conveys its legal meaning. *Gold, &c. Telegraph Co. v. Wiley*, 17 *Fed. Rep'r*, 234 ; 16 *Rep'r*, 129.

Where an applicant for reissue of a patent has done all in his power to make his application effectual—has filed his application with the acting commissioner and paid the requisite amount of fees—the application is to be considered as properly before the commissioner. *Commissioner of Patents v. Whiteley*, 4 *Wall.* 522. A mandamus will lie to compel the commissioner of patents to receive an application for a reissue of a patent ; or to allow an appeal from his decision refusing a reissue. *Ib.*

Although a surrender of an original patent is the act of the

party making the application, still the application for a surrender and reissue may be withdrawn, under leave of a commissioner, for good cause shown, at any time before the proceedings are fully completed. *Forbes v. Barstow Stove Co.*, 2 *Cliff.* 379.

The application for a reissue must be accompanied by a surrender of the original patent, or, if that is lost, by an affidavit to that effect, and a certified copy of the patent; but if a reissue be refused, the original patent will, upon request, be returned to the applicant. *Rules of Prac.* No. 90.

139. *The Hearing.*

In cases of application for reissue, an original claim, if reproduced in the amended specification, is subject to re-examination, and the entire application will be revised and restricted in the same manner as original applications. *Rules of Prac.* 89.

A patentee is not entitled to have his patent reissued, unless he shows, by satisfactory evidence, that the error he seeks to have corrected was owing to "inadvertence, accident or mistake, and without any fraudulent or deceptive intention," and states particularly wherein the inadvertence, accident or mistake consisted. *Conklin's Case*, 5 *Pat. Off. Gaz.* 235; S. C., 1 *MacArthur*, 375.

In the case of the surrender for a defective or insufficient specification, under the act of 1836, the commissioner is to decide whether the invention claimed in the original patent and that claimed in the amended one is substantially the same. He is to inquire and ascertain whether the specification is defective or insufficient in point of law or fact, and whether the inventor has claimed more than he has invented, and in each case whether the error has arisen from inadvertency, accident, or mistake, or with a deceptive or fraudulent intention. *Allen v. Blunt*, 3 *Story*, 742; 8 *L. Rep'r*, 165. He is not confined to the claims, nor even to the evidence furnished by the specification, models and drawings accompanying the original application; but any legal proof to show it to be the same invention should be received. Even a statement, in an original patent, that a part is old, or a disclaimer of a part, does not necessarily prevent such part from being claimed in a reissued patent, though it would have that effect if made advisedly. *Hussey v. Bradley*, 5 *Blatchf.* 134; 2 *Fish. Pat. Cas.* 362. The commissioner has no jurisdiction to hear testimony as to what the original

invention was, and to allow the claims and specification to be amended so as to embrace what the proofs show was invented, where the reissue may thus show improvements neither described, suggested, nor indicated in the model, drawings, or specification of the original. *Cahart v. Austin*, 2 *Cliff.* 528.

140. *Powers and Duties of the Commissioner.*

The power of accepting the surrender of the original patent and of granting a reissue of it is confided exclusively to the commissioner, and is to be exercised judicially by him. *Parham v. American Buttonhole, &c. Co.*, 4 *Fish. Pat. Cas.* 468; *Parham v. Machine Co.*, 1 *Leg. Gaz.* 145; *Carew v. Boston Elastic Fabric Co.*, 1 *Pat. Off. Gaz.* 91; 5 *Fish. Pat. Cas.* 90; 3 *Cliff.* 356; *Thomas v. Shoe Machinery Co.*, 16 *Pat. Off. Gaz.* 541; *Dunbar v. White*, 15 *Fed. Rep'r*, 747; 4 *Woods*, 116; 23 *Pat. Off. Gaz.* 1446.

The commissioner has power to reissue a patent to cure defects in the specification; but not to cure false statements in the application; as, that the applicant is a citizen, when in fact he is an alien. *Mini v. Adams*, 3 *Wall. Jr.* 20.

It is for the commissioner to decide whether an applicant for a reissue is an assignee within the meaning of the act. *Commissioner of Patents v. Whiteley*, 4 *Wall.* 522.

The power of the commissioner to cancel a patent and issue another for the purpose of correcting an error in it not embraced by the statute authorizing reissue, considered. *Dental Vulcanite Co. v. Wetherbee*, 2 *Cliff.* 555; 3 *Fish. Pat. Cas.* 87.

Under the act of 1836, where a patent was antedated in supposed accordance with the provisions of that act, and upon the express request of the patentee, who acquiesced in and accepted the patent so granted, it was *held* that the commissioner could not subsequently alter the date of the patent, the error, if any, being not merely clerical, but an error of judgment as to his duty and authority under the law. *Re Cushman*, 1 *MacArthur Pat. Cas.* 577.

146. *What Defects in a Patent, warrant a Reissue.*

The statute, only authorizes a reissue when, from an unintentional error in the description of the invention, the patent is invalid or inoperative, or when the claim of the patentee exceeds his invention. *Giant Powder Co. v. California Vigorit Powder Co.*, 4 *Fed. Rep'r*, 720; 6 *Saywer*, 508; 18 *Pat. Off. Gaz.* 1339. Whenever a patent fails to secure all that the patentee was by his specifications entitled to claim, it is inoperative within the meaning of the statute, and he is entitled to a reissue. *Giant Powder Co. v. Safety Nitro Powder Co.*, 19 *Fed. Rep'r*, 509. If a patentee, in the description and claim in his original patent, erroneously set forth something short of his real invention, it is a proper case for a reissue, although his real invention may be fully shown in the drawings and model. *Wilson v. Coon*, 6 *Fed. Rep'r*, 611; 18 *Blatchf.* 532; 19 *Pat. Off. Gaz.* 482. A reissue is not invalid merely because the claim of the original patent was valid, and suit could be sustained thereon. *Ib.*

A reissue is valid when made in order to correct a claim which might not fully secure the invention, and which was so ambiguous as to suggest doubt of its sufficiency; and where the mistake was not so obvious as to be instantly suggested on reading the claim. *Western Union Tel. Co. v. Baltimore, &c., Telegraph Co.*, 25 *Fed. Rep'r*, 30.

Where, on application for a patent, the examiner denied the application on the ground that he deemed certain claims anticipated by a prior device, this is not a "mistake or inadvertence" such as will entitle the assignee of the patentee to a reissue; the remedy in such cases is by appeal. *Putnam v. Hutchinson*, 12 *Fed. Rep'r*, 127; 11 *Biss.* 233; 28 *Int. Rev. Rec.* 177.

Where, upon application for a patent, one of the claims presented is rejected because covered by previous inventions, and thereupon the duly authorized attorney of the applicant orders such claim to be erased and withdrawn, and a patent for the remaining claims is issued and is accepted by the applicant, he is not entitled to a reissued patent containing the claim so erased and withdrawn. There is, under such circumstances, no error arising by inadvertence, accident or mistake, within the meaning of the patent law, which would authorize an application for a reissue. *Re Hatchman*, 3 *Mackey*, 288; 26 *Pat. Off. Gaz.* 738.

Under the act of 1836, whether the defect be in the specification or claim, the patentee may surrender his patent, and, by an amended specification or claim, cure the defect. When the specification or claim is so vague as to be inoperative and invalid, an amendment might give it validity and protect the rights of the patentee against subsequent infringements. *Battin v. Taggart*, 17 *How.* 74. A specification may be insufficient or defective so as to allow a reissue, either by a mistake of law as to what is required to be stated therein in respect to the claim of the inventor, or by a mistake of fact in omitting things which are indispensable to the completeness and exactness of the description of the invention, or of the mode of constructing, or making, or using the same. *Allen v. Blunt*, 3 *Story*, 742; 8 *L. Rep'r*, 165.

The practice of surrendering valid patents and of granting reissues thereon in cases where the original patent was neither inoperative nor invalid, and where the specification was neither defective nor insufficient, condemned. *Burr v. Duryee*, 1 *Wall.* 531; aff'g 2 *Fish. Pat. Cas.* 275.

142. *What Changes may be made by a Reissue.*

No new matter shall be introduced into the reissue specification, nor in case of a machine shall the model or drawings be amended except each by the other; but when there is neither model nor drawing, amendments may be made upon proof satisfactory to the commissioner that such new matter or amendment was a part of the original invention, and was omitted from the specification by inadvertence, accident, or mistake. *Rules of Prac.* No. 87.

It is a legitimate and important function of a reissue of a patent to modify or change the claims of the original patent so as to cover the invention set forth therein. *Westinghouse v. Garden, &c. Air-brake Co.*, 9 *Pat. Off. Gaz.* 538; 2 *Bann. & A. Pat. Cas.* 55. Compare *Cornell v. Downer, &c. Brewing Co.*, 7 *Biss.* 346.

The commissioner may allow the original specification to be amended in the reissue, and he may permit the applicant for a reissue to re-describe his invention, including in the new description and claims not only what was well described before, but also what was suggested or indicated in the original specification, drawings or patent-office model. *Carew v. Boston Elastic Fabric Co.*, 3 *Cliff.* 356; 1 *Pat. Off. Gaz.* 91; 5 *Fish. Pat. Cas.* 90; *Tucker v. Tucker*,

Manuf. Co., 10 *Pat. Off. Gaz.* 464 ; 4 *Cliff.* 397 ; 2 *Bann. & A. Cas.* 401 ; *Draper v. Potomska Mills Corp.*, 13 *Pat. Off. Gaz.* 276 ; 3 *Bann. & A. Pat. Cas.* 214 ; *Woven Wire Mattrass Co. v. Wire Web Bed Co.*, 8 *Fed. Rep'r*, 87 ; *Gold, &c., Tel. Co. v. Wiley*, 17 *Fed. Rep'r*, 234 ; 16 *Rep'r*, 129.

In case of a reissue of a patent, the patentee may claim something when he is informed of its importance which he had before described as one mode of making his machine or article. *Atwood v. Portland Co.*, 10 *Fed. Rep'r*, 283 ; 5 *Bann. & A. Pat. Cas.* 533.

The provision of Rev. Stat. § 4916, forbidding amending model and drawings of a machine patent except by each other, does not preclude an amendment which does not affect the claim. *Pearl v. Appleton Co.*, 3 *Fed. Rep'r*, 153 ; 5 *Bann. & A. Pat. Cas.* 553. The specifications for the reissue of a patent may be amended by the model deposited in the patent-office as well as by the drawings. *Hendy v. Golden State, &c., Iron Works*, 17 *Fed. Rep'r* 515 ; 8 *Sawyer*, 468.

A patent for a combination of old elements may be reissued for a combination of a fewer elements than were contained in the combination originally claimed. *Herring v. Nelson*, 14 *Blatchf.* 293 ; 3 *Bann. & A. Pat. Cas.* 55 ; *Christman v. Rumsey*, 17 *Blatchf.* 148 ; 17 *Pat. Off. Gaz.* 903 ; 4 *Bann. & A. Pat. Cas.* 506 ; 58 *How. Pr.* 114.

In the absence of an error arising from inadvertence, accident or mistake, a patent for a machine will not sustain a reissue for a process. *Eachus v. Broomall*, 115 *U. S.* 489, 529.

Reissued patent in 1879 for an improvement in electric lamps, known as the "clamp patent," considered, and *held* anticipated by the invention of the same clamp in 1876, although only one clamp and one lamp were ever made by the latter inventor, and were used together two and one-half months only ; such use having been public and practical, in ordinary work and with reasonable success. *Brush v. Condit*, 22 *Blatchf.* 246 ; 20 *Fed. Rep'r*, 826.

The legal effect of the changes which, in various cases, may be introduced into the language of a patent, by surrender and reissue, explained. *Dunbar v. White*, 4 *Woods*, 116 ; 23 *Pat. Off. Gaz.* 1146 • 15 *Fed. Rep'r* 747.

143. *Dividing a Patent by Reissue.*

The commissioner may, in his discretion cause several patents to be issued for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for each division of such reissued letters patent. Each division of a reissue constitutes the subject of a separate specification descriptive of the part or parts of the invention claimed in such division; and the drawing may represent only such part or parts, subject to the provisions of rule 49. Unless it shall be otherwise ordered by the commissioner, all the divisions of a reissue will issue simultaneously; if there be controversy as to one, the others will be withheld from issue until the controversy is ended, unless he shall otherwise order. *Rules of Prac.* No. 88.

Where a patent claims a combination of several devices, it may be reissued to claim the devices separately, if new and useful, even though the aggregate combination claimed in the original patent was not, by itself, useful, or was even impracticable; provided the reissue points out how the devices, separately claimed, may be reduced to practical use. *Wheeler v. Clipper Mower, &c., Co.*, 2 *Pat. Off. Gaz.* 442; 10 *Blatchf.* 181; 6 *Fish. Pat. Cas.* 1. But the patent cannot be broadened by reissuing it in divisions any more than if reissued together. *New v. Warren*, 22 *Pat. Off. Gaz.* 587. The thing patented may be separated on the reissue of a reissued patent as on the first reissue. *Selden v. Stockwell Self-lighting Gas-burner Co.*, 9 *Fed. Rep'r*, 390; 19 *Blatchf.* 544; 20 *Pat. Off. Gaz.* 1377.

Where a patentee has, in his original patent, patented an aggregate of several devices, he may, in obtaining a separate reissue for each device, give the same identical description in each issue, of all the devices in the original. If, in such case, the claim of each reissue is for a distinct and severable part of the invention described and shown in the original patent, the reissues are not open to the objection that there are several patents for the same invention. *Wheeler v. McCormick*, 4 *Pat. Off. Gaz.* 692; 6 *Fish. Pat. Cas.* 551; 11 *Blatchf.* 334. Where an application for reissue for two or more divisions is made whilst the original patent is in existence, the commissioner of patents has power to issue a patent for one or more of the divisions of the reissue application, and subsequently to issue a patent for the remaining divisions, if it be

deemed that otherwise the applicant is entitled thereto. Until such application is ended in all its divisions, the vitality of the original patent continues, so far as required to support that portion of the application which remains undecided. 16 *Op. Att. Gen.* 560

Where an original patent describes a new article made by a new process, the reissue may be in two parts, one for the process, and one for the article of manufacture. *Tucker v. Burditt*, 4 *Bann. & A. Pat. Cas.* 569; *Badische Anilin, &c. Fabrik v. Hamilton Manuf. Co.*, 13 *Pat. Off. Gaz.* 273; 3 *Bann. & A. Pat. Cas.* 235, *Same v. Higgins*, 15 *Blatchf.* 290; 3 *Bann. & A. Pat. Cas.* 462.

A division of the original patent, upon a reissue, into two claims, though unnecessary to effectuate the invention, will not necessarily impair the validity of the reissues. *Salt Manuf. Co. v. Thomas*, 3 *Leg. Gaz.* 316; 1 *Leg. Gaz. Rep'r*, 275.

144. *The Invention must not be Enlarged.*

The general rule that reissued letters patent expanded beyond the claim of the original letters, are void, is sustained by *Miller v. Brass Co.*, 104 *U. S.* 360; *aff'g* 14 *Blatchf.* 282; 12 *Pat. Off. Gaz.* 667; 3 *Bann. & A. Pat. Cas.* 20; *James v. Campbell*, 104 *U. S.* 356; *rev'g* 17 *Blatchf.* 42; 18 *Pat. Off. Gaz.* 979; 8 *Rep'r*, 455; 4 *Bann. & A. Pat. Cas.* 456; *Nye v. Allen*, 23 *Pat. Off. Gaz.* 2328; 15 *Rep'r*, 114; *Lorillard v. McAlpin*, 14 *Fed. Rep'r*, 112; 22 *Pat. Off. Gaz.* 1208; *Dryfoos v. Wiese*, 19 *Fed. Rep'r*, 315; 22 *Blatchf.* 19; 26 *Pat. Off. Gaz.* 639; *Adjustable Window Screen Co. v. Boughton*, 10 *Phila.* 251; 1 *Bann. & A. Pat. Cas.* 327; *Edgerton v. Furst, &c. Manuf. Co.*, 9 *Fed. Rep'r*, 450; 10 *Biss.* 402; 27 *Int. Rev. Rec.* 383; 21 *Pat. Off. Gaz.* 267; *Wood Paper Patent*, 23 *Wall.* 566; *Russell v. Dodge*, 93 *U. S.* 460; *Powder Co. v. Powder Works*, 98 *U. S.* 126; *Ball v. Langles*, 102 *U. S.* 128; *Manufacturing Co. v. Ladd*, *Id.* 408; *Manufacturing Co. v. Corbin*, 103 *U. S.* 786; *Carew v. Boston Elastic Fabric Co.*, 3 *Cliff.* 356; 5 *Fish. Pat. Cas.* 90; 1 *Pat. Off. Gaz.* 91; *Rayer, &c., Seaming Machine Co. v. American Printing Co.*, 19 *Fed. Rep'r*, 428; *Tarr v. Webb*, 10 *Blatchf.* 96; 5 *Fish. Pat. Cas.* 593; 2 *Pat. Off. Gaz.* 568; *Meyer v. Maxheimer*, 9 *Fed. Rep'r*, 99; 20 *Blatchf.* 15; 20 *Pat. Off. Gaz.* 1162; *Averill Chemical Paint Co. v. National Mixed Paint Co.*, 9 *Fed. Rep'r*, 462; 20 *Blatchf.* 42; 22 *Pat. Off. Gaz.* 585; *Dunbar v. White*, 4 *Woods*, 116; 23 *Pat. Off. Gaz.* 1146; 15 *Fed. Rev.* 747.

Vogler v. Semple, 7 *Biss.* 382 ; 23 *Int. Rev. Rec.* 112 ; 11 *Pat. Off. Gaz.* 923 ; 2 *Bann. & A. Pat. Cas.* 556 ; Driven Well Cases, 16 *Fed. Rep'r*, 387 ; 26 *Pat. Off. Gaz.* 1011.

The privilege of surrendering a patent and obtaining a reissue cannot be extended to afford the patentee an opportunity to expand his exclusive privilege, so as to enable him to suppress an invention made subsequent to his own, which does not conflict with the invention prescribed in the patent which he surrenders. *Gill v. Wells*, 22 *Wall.* 1.

Where a reissued patent is granted upon a surrender of the original, for its alleged defective or insufficient specification, such specification cannot be substantially changed in the reissued patent, either by the addition of new matter or the omission of important particulars, so as to enlarge the scope of the invention, as originally claimed. A defective specification can be rendered more definite and certain, so as to embrace the claim made, or the claim can be so modified as to correspond with the specification ; but, except under special circumstances, this is the extent to which the operation of the original patent can be changed by the reissue. *Russell v. Dodge*, 93 *U. S.* 460 ; *Yale Lock Manuf. Co. v. Scovill Manuf. Co.*, 3 *Fed. Rep'r*, 288 ; 18 *Blatchf.* 248 ; 5 *Bann. & A. Pat. Cas.* 519. By new matter, with reference to the reissue of a composition, is meant not merely the introduction of a new ingredient, but any change in the original specification and claim, whereby a new and substantially different composition is secured. *United States, &c., Felting Co. v. Haven*, 1 *L. & Eq. Rep'r*, 16 ; 2 *Bann. & A. Pat. Cas.* 164. It is in cases where a patent is inoperative or invalid, by reason of a defective or insufficient description, specification, or claim, and not where the device is not described or specified at all, that permission is given to reissue the patent ; devices, not described or specified, may, if they are the invention of the patentee, be the subject of a patent, subject to all other rules governing the inventor's right ; but it is not the office of the reissue to embrace them. *Sarven v. Hall*, 9 *Blatchf.* 524 ; 1 *Pat. Off. Gaz.* 437 ; 5 *Fish. Pat. Cas.* 415.

A reissued patent shown to be broader than the original cannot be sustained by proof that the patentee had invented, before making his original application, all the things added in the reissue, and might rightfully have claimed them at first. *Manufacturing Co. v. Ladd*, 102 *U. S.* 408 ; aff'g 2 *Bann. & A. Pat. Cas.* 488. And see *Atwater Manuf. Co. v. Beecher Manuf. Co.*, 8 *Fed. Rep'r*,

608 ; *Kells v. McKenzie*, 9 *Fed. Rep'r*, 284 ; 20 *Pat. Off. Gaz.* 1363 ; *Dederick v. Cassell*, 9 *Fed. Rep'r*, 306 ; 27 *Int. Rev. Rec.* 400 ; 20 *Pat. Off. Gaz.* 1263. Where it appears, as matter of law, on a comparison of the two instruments, that a reissued patent is not for the same invention as that embraced and secured in the original patent, the reissued patent is invalid. *Sickles v. Evans*, 2 *Cliff.* 203 ; 2 *Fish. Pat. Cas.* 417 ; *Tucker v. Tucker Manuf. Co.*, 10 *Pat. Off. Gaz.* 464 ; 2 *Bann. & A. Pat. Cas.* 201. If a patent, containing a single claim for a combination, is reissued, with the same description as before, but with two claims, the one a repetition of the original claim, and the other for a combination of some of the elements only, the reissue is valid as to the repetition of the original claim but invalid as to the new claim ; to uphold the latter would be to enlarge the claim, which must not be done by reissue. *Gage v. Herring*, 107 *U. S.* 640 ; 2 *Sup. Ct. Rep'r*, 819. Compare *McMurray v. Mallory*, 111 *U. S.* 97 ; *Washburn, &c., Manuf. Co. v. Fuchs*, 16 *Fed. Rep'r*, 661 ; *Terrell v. Bradford*, 15 *Fed. Rep'r*, 808 ; 23 *Pat. Off. Gaz.* 1623.

145. Illustrations.

A patent for a machine cannot be broadened on reissue to cover a process described in the original patent ; if the process were patentable it should have been included in the original patent. *New v. Warren*, 22 *Pat. Off. Gaz.* 587. Neither can a patent limited to a product when made in a certain method be expanded to cover the product without reference to the manner in which it is produced. *Vacuum Oil Co. v. Buffalo Lubricating Oil Co.*, 22 *Blutchf.* 266 ; 28 *Pat. Off. Gaz.* 1101.

Where the original patent covers a mechanism to accomplish a specific result, and the reissued patent covers the process by which that result is attained, without regard to the mechanism used to accomplish it, the reissue is broader than the original patent, for it covers every mechanism which can be contrived to carry on the process ; it is, therefore, void. *Bedford v. Burton*, 106 *U. S.* 338 ; 1 *Sup. Ct. Rep'r*, 98 ; *Powder Co. v. Powder Works*, 98 *U. S.* 126 ; rev'g 3 *Sawyer*, 448 ; 2 *Bann. & A. Pat. Cas.* 131 ; *James v. Campbell*, 104 *U. S.* 356 ; rev'g 17 *Blutchf.* 42 ; 18 *Pat. Off. Gaz.* 979 ; 8 *Rep'r*, 455 ; 4 *Bann. & A. Pat. Cas.* 456. The patentee may not strike out the entire description of one of the ingredients of a combination, and insert in lieu thereof a descrip-

tion of other devices, unless it be alleged that such other devices are equivalents of the device stricken out. *Tucker v. Tucker Manuf. Co.*, 10 *Pat. Off. Gaz.* 464.

A patent granted for a combination, one element of which was described in the specification as being adapted by its shape to perform specified functions, was surrendered and a reissue taken which expanded some of the claims so as to cover any form of this element, whether adapted to perform these functions, or not. It was *held* that as to these expanded claims the reissue was void. *McMurray v. Mallory*, 111 *U. S.* 97.

When divisional reissues are granted for a part of the original invention, they must not contain anything substantially new or different; thus original letters for a process will not support reissued letters for a composition, unless it is the result of the process, and the invention of the one involves the invention of the other; so letters granted for certain processes of exploding nitro-glycerine will not support reissued letters for a composition of nitro-glycerine and gunpowder or other substances, even though the original application claimed the invention of the process and the compound; these are distinct inventions. *Powder Co. v. Powder Works*, 98 *U. S.* 126; *rev'g* 3 *Sawyer*, 448; 2 *Bann. & A. Pat. Cas.* 131.

Where the specification of the original patent suggested no invention, save the one contained in the entire combination, the claim in the reissue for a lesser number of elements than it embraced was declared void. Had it been intimated in the original patent that the lesser number of elements could be used in combination, this would have justified a claim to them on reissue; but without such suggestion the claim was invalid, for departure from the original invention. *Miller v. Bridgeport Brass Co.*, 14 *Blatchf.* 282; 12 *Pat. Off. Gaz.* 667; 3 *Bann. & A. Pat. Cas.* 20. See *affirmance*, 104 *U. S.* 350.

When form is of the substance of an invention it is not to be disregarded; thus where the original invention was for a particular form of wooden bushing, wooden bushings having been previously patented, a broad claim in a reissue for any form of wooden bushings was *held* invalid. *New York Bung, &c. Co. v. Hoffman*, 9 *Fed. Rep'r.*, 199; 20 *Pat. Off. Gaz.* 1451; 20 *Blatchf.* 3.

Where the patent was for a process of treating bark-tanned lamb or sheep-skin, by means of a compound in which heated fat liquor was an essential ingredient, and a change was made in the

original specification, by eliminating the necessity of using the fat liquor in a heated condition, and making, in the new specification, its use in that condition a mere matter of convenience, and by inserting an independent claim for the use of fat liquor in the treatment of leather generally, the character and scope of the invention as originally claimed were held to be so enlarged as to constitute a different invention. *Russell v. Dodge*, 93 *U. S.* 460.

146. *Scope and Limits of the above Rule.*

Where the amended specification and new claim only secure to the applicant what he had originally described, the reissue is valid. *Richardson v. Lockwood*, 4 *Cliff.* 128; *Wells v. Gill*, 6 *Fish. Pat. Cas.* 574; *Draper v. Wattles*, 16 *Pat. Off. Gaz.* 629; 3 *Bann. & A. Pat. Cas.* 618; *Putnam v. Yerrington*, 9 *Pat. Off. Gaz.* 689; 2 *Bann. & A. Pat. Cas.* 237.

Upon reissue of a patent, the claim may be enlarged where there was clearly mistake or inadvertence and no unreasonable delay in applying for the correction, and no rights of others have intervened. *Wooster v. Handy*, 21 *Fed. Rep'r*, 51; *Odell v. Stout*, 22 *Fed. Rep'r*, 159; 29 *Pat. Off. Gaz.* 862. The mistake must not be from mere error of judgment, but a *bona fide* mistake inadvertently committed, such as a court of chancery, in cases within its ordinary jurisdiction, would correct. *Jones v. Barker*, 11 *Fed. Rep'r*, 597; 22 *Pat. Off. Gaz.* 771.

A reissue may be had for any invention substantially described, though not claimed, in the original specification. *Pennsylvania Salt Manuf. Co. v. Thomas*, 8 *Phila.* 144; 5 *Fish.* 149. See *McArthur v. Brooklyn Railway Supply Co.*, 19 *Fed. Rep'r*, 263; *Lorillard v. McDowell*, 11 *Pat. Off. Gaz.* 640; *Combined Patents Can Co. v. Lloyd*, 11 *Fed. Rep'r*, 149; 21 *Pat. Off. Gaz.* 713. Or whatever was substantially suggested or indicated in the surrendered specifications, drawings or patent-office model. *Stevens v. Pritchard*, 4 *Cliff.* 417; 10 *Pat. Off. Gaz.* 505; 2 *Bann. & A. Pat. Cas.* 390. Compare *Kelleher v. Darling*, 14 *Pat. Off. Gaz.* 673; *Stephenson v. Second Ave. R. R. Co.*, 5 *Bann. & A. Pat. Cas.* 116; *Meyer v. Goodyear's India Rubber Glove Manuf. Co.*, 22 *Pat. Off. Gaz.* 681; *Seymour v. Marsh*, 6 *Fish. Pat. Cas.* 115; 9 *Phila.* 330; *Reissner v. Anness*, 13 *Pat. Off. Gaz.* 870.

It is of no consequence that a reissue states that certain con-

binations are found in the machine which will act in a certain way and effect certain results, when the original did not contain these statements, provided the combinations in fact existed in a machine made according to the drawings and description in the original patent, or provided the modes of operation and results in fact followed in a machine so made. *Potter v. Stewart*, 7 *Fed. Rep'r*, 215; 18 *Blatchf.* 561; 19 *Pat. Off. Gaz.* 997.

The reissue of a patent in which nothing more is done than to make a correction in the description in the original patent, without any enlargement of claim or material variation in terms, and where the effect is identical, is valid. *Sewing Machine Co. v. Frame*, 24 *Fed. Rep'r*, 596; 28 *Pat. Off. Gaz.* 96.

Where the patentee, when he applied for his patent, evidently attached more importance to one form of his invention than the other, but afterward changed his opinion and reissued, laying more stress on the second form, it was *held*, that such modification of opinion on his part did not disturb the fact that both forms were described, though imperfectly, in his first specifications. *American Nicolson Pavement Co. v. Elizabeth*, 6 *Fish. Pat. Cas.* 424.

Where the claim in a reissue, while differing verbally from the claim in the original patent, is substantially and in legal effect a mere repetition of that claim, the claim in the reissue may be sustained. *National Pump Cylinder Co. v. Gunnison*, 17 *Fed. Rep'r*, 812. If new claims in the reissue are only restatements of the functions and mode of operation of the elements of one of the claims of the original, in combination with the other parts of the machine, then they are valid. *Fay v. Fraser*, 11 *Biss.* 422.

The original patent having called the absorbent material with which the nitro-glycerine was mixed, "inexplosive," it was *held*, that to omit the term upon reissue was no enlargement of the invention. The word was ambiguous, since it was clear from the original description that the patentee did not contemplate the use of materials which, though explosive, were not so in comparison and under like conditions with nitro-glycerine. *Atlantic Giant Powder Co. v. Goodyear*, 13 *Pat. Off. Gaz.* 45.

Whether a reissued patent is (as it always should be) for the same invention as the original, is a question, not of fact, but of legal construction of the two instruments. *Stevens v. Pritchard*, 4 *Cliff.* 417; 10 *Pat. Off. Gaz.* 505; 2 *Bann. & A. Pat. Cas.* 390; *Tucker v. Tucker Manuf. Co.*, 10 *Pat. Off. Gaz.* 464; 4 *Cliff.* 397; 2 *Bann. & A. Pat. Cas.* 401.

147 *Effect of the Commissioner's Decision : Presumptions.*

The action of the commissioner of patents in accepting a surrender and granting a reissue of letters-patent is judicial in its character, and presumed correct, but is not conclusive upon the court. *Flower v. Rayner*, 5 *Fed. Rep'r*, 793 ; 19 *Pat. Off. Gaz.* 425 ; 11 *Rep'r*, 555. It is final and conclusive as to all matters of fact involved in the hearing of the application (*Judson v. Bradford*, 16 *Pat. Off. Gaz.* 171 ; 3 *Bann. & A. Pat. Cas.* 539), and as to the mere necessity of a reissue (*Smith v. Merriam*, 6 *Fed. Rep'r*, 713 ; 19 *Pat. Off. Gaz.* 601. Compare *Conklin's Case*, 1 *MacArthur*, 375 ; 5 *Pat. Off. Gaz.* 235); but it is not conclusive as to his own jurisdiction (*Cahart v. Austin*, 2 *Cliff.* 528. Compare *Whitley v. Swayne*, 4 *Fish. Pat. Cas.* 117 ; *Giant Powder Co. v. California Vigorit Powder Co.*, 4 *Fed. Rep'r*, 720 ; 6 *Sawyer*, 503 ; 18 *Pat. Off. Gaz.* 1339), nor as to the reasonableness of the delay. *Wollensak v. Recher*, 115 *U. S.* 96.

The correct performance of all those preliminaries on which the validity of a reissued patent depends is always examinable in the court in which a suit for its violation is brought. *Odell v. Stout*, 22 *Fed. Rep'r*, 159.

The general rule is that the decision of commissioner of patents is conclusive in a suit for infringement, unless it is apparent on the face of the patent that he has exceeded his authority. *Wells v. Gill*, 2 *Pat. Off. Gaz.* 590 ; 6 *Fish. Pat. Cas.* 89. *S. P., American Nicolson Pavement Co. v. Elizabeth*, *Id.* 424 ; *Spaeth v. Barney*, 22 *Fed. Rep'r*, 828 ; 30 *Pat. Off. Gaz.* 997.

The commissioner's authority being limited to a reissue for the same invention, the two patents may be compared to determine the identity of the invention. If the reissued patent, when thus compared, appears on its face to be for a different invention, it is void, the commissioner having exceeded his authority in issuing it. *Russell v. Dodge*, 93 *U. S.* 460 ; *Sickles v. Evans*, 2 *Fish. Pat. Cas.* 417 ; 2 *Cliff.* 203 ; *Cahart v. Austin*, 2 *Fish. Pat. Cas.* 543 ; *Swift v. Whisen*, 2 *Bond*, 115 ; 3 *Fish. Pat. Cas.* 343 ; *Goodyear v. Berry*, *Id.* 189 ; 3 *Fish. Pat. Cas.* 439.

The decision of the commissioner can only be impeached in the courts on the ground of, 1. Fraud or collusion between the commissioner and the applicant ; 2. An excess of authority on the part of the commissioner, apparent on the face of the patents ; or, 3. A

clear repugnance between the new and old patent. *House v. Young*, 3 *Fish. Pat. Cas.* 335; *Hussey v. Bradley*, 5 *Blatchf.* 134; 2 *Fish. Pat. Cas.* 362; *Blake v. Stafford*, 6 *Blatchf.* 195; 3 *Fish. Pat. Cas.* 294; *Swift v. Whisen*, 2 *Bond*, 115; 3 *Fish. Pat. Cas.* 343; *Crompton v. Belknap Mills*, 3 *Fish. Pat. Cas.* 536; *Jordan v. Dobson*, 2 *Abb. U. S.* 398; 7 *Phila.* 533; *Stimpson v. Westchester R. R. Co.*, 4 *How.* 380, 404; *Battin v. Taggart*, 17 *How.* 74; *Woodworth v. Stone*, 3 *Story*, 749; *Reissner v. Anaess*, 13 *Pat. Off. Gaz.* 870; *Miller, &c. Manuf. Co. v. Du Brul*, 12 *Pat. Off. Gaz.* 351; 2 *Bann. & A. Pat. Cas.* 618; *Andrews v. Wright*, 6 *Rep'r*, 193.

Some cases hold that the action of the commissioner is conclusive against a charge of fraud in obtaining the reissue, as well as all other objections, unless it appears upon the face of the papers that the new patent is not for the same invention as the original. *La Baw v. Hawkins*, 6 *Pat. Off. Gaz.* 724; 1 *Bann. & A. Pat. Cas.* 428; *Milligan, &c. Glue Co. v. Upton*, 6 *Pat. Off. Gaz.* 837; *Union Paper Collar Co. v. White*, 7 *Pat. Off. Gaz.* 698, 877. To justify the rejection of a reissue, therefore, on the ground of "new matter," it must clearly appear that such matter has been introduced. Nothing plainly embraced in the specifications, model or drawings of the original, is "new matter." *Dederick v. Cassell*, 9 *Fed. Rep'r*, 306; 27 *Int. Rev. Rec.* 400; 20 *Pat. Off. Gaz.* 1233. Compare *Kells v. McKenzie*, 9 *Fed. Rep'r*, 284; 20 *Pat. Off. Gaz.* 1663.

An objection to the validity of a reissued patent that the surrendered patent was not inoperative by reason of a defective specification, on which ground the application for a reissue was made, is conclusively decided by the commissioner's granting the reissue, and will not be reviewed by the circuit court. *Selden v. Stockwell Self-lighting Gas-burner Co.*, 9 *Fed. Rep'r*, 390; 19 *Blatchf.* 544; 20 *Pat. Off. Gaz.* 1377; *Kerosene Lamp Heater Co. v. Littell*, 3 *Bann. & A. Pat. Cas.* 312; 1 *N. J. L.* 195.

When the commissioner has decided that an applicant for a reissue is not an assignee within the meaning of the act of 1836, a mandamus will not lie commanding him to refer the application to "the proper examiner, or otherwise examine or cause the same to be examined according to law;" the preliminary question was within the scope of his authority. *Commissioner of Patents v. Whiteley*, 4 *Wall.* 522.

The granting of a reissue is *prima facie* evidence of inadvert-

tence, accident or mistake, as the granting of original letters is *prima facie* evidence of invention. *Odell v. Stout*, 22 *Fed. Rep'r.*, 159.

It is the duty of the commissioner to see that a reissued patent does not cover more than the original one; and the presumption is, until the contrary appears, that it does not. *O'Reilly v. Morse*, 15 *How.* 62, 112. Compare *Tatham v. Lowber*, *Mir. Pat. Off.* 146; *Stevens v. Pritchard*, 4 *Cliff.* 417; 10 *Pat. Off. Gaz.* 505; 3 *Bann. & A. Pat. Cas.* 390; *Jordan v. Dobson*, 2 *Abb. U. S.* 398; 7 *Phila.* 533; *Guidet v. Barber*, 5 *Pat. Off. Gaz.* 149; *Morris v. Royer*, 2 *Bond*, 66; *Smith v. Whisen*, *Id.* 115; 3 *Fish. Pat. Cas.* 343; *Bantz v. Elsas*, 6 *Fish. Pat. Cas.* 117; *Chicago Fruit House Co. v. Busch*, 4 *Fish. Pat. Cas.* 395. But such inference or presumption in respect to identity may be rebutted by evidence, which should be submitted to the jury. *Allen v. Blunt*, 2 *Woodb. & M.* 121, 139.

In an action for an infringement, the duty devolves upon the court to determine whether the reissue claims more than the original specification shows the patentee to have invented. *Woodward v. Dinsmore*, 4 *Fish. Pat. Cas.* 163. Compare *Parham v. Machine Co.*, 1 *Leg. Gaz. Rep.* 145.

When as a defense to a reissue patent, it is set up that the reissue covers more than was embraced in the original, the respondent must introduce in evidence the original to support the allegation; otherwise it will be assumed that the invention described in the reissue is the same as that secured by the original. *Doherty v. Haynes*, 4 *Cliff.* 291; 6 *Pat. Off. Gaz.* 118; 1 *Bann. & A. Pat. Cas.* 289.

Reissued patent, *held* valid, notwithstanding errors apparent on its face in stating the number of the surrendered patent for which it was re-issued, and in expressing the claim. *Reed v. Street*, 34 *Pat. Off. Gaz.* 339.

148. *Validity of Reissued Patents.*

A reissue can only be impeached for fraud by a bill in equity brought for the purpose by the government. *Birdsell v. McDonald*, 6 *Pat. Off. Gaz.* 682.

The fact of procuring a patent for a machine under the assumption of a reissue, which was not useful as patented in the surrendered

patent, for want of some parts used in the reissued patent, would present a question of fraud committed on the public by the patentee, by giving his reissued patent date as an original discovery, made at the time of the original patent, and thereby overreaching similar inventions made between the time of the original patent and the time of the reissued patent. *Brooks v. Fiske*, 15 *How.* 212.

A reissued patent need not contain any recitals that the prerequisites to the grant of it,—as, that it was reissued for errors arising not from inadvertency, accident, or mistake,—have been duly complied with ; for the law makes the presumption that they have been. *Philadelphia & Trenton R. R. Co. v. Stimpson*, 14 *Pet.* 448, 458.

A reissued patent is not the less valid because it contains a full account of processes, which, although adverted to in the original, were not described at length, because they were well known in the art. *Goodyear Dental Vulcanite Co. v. Smith*, 5 *Pat. Off. Gaz.* 585; 1 *Holmes*, 354.

Where the reissue covers only claims which do not appear on the face of the original, it is invalid. *Singer Manuf. Co. v. Goodrich*, 15 *Fed. Rep'r*, 455.

It is no objection to the validity of a reissue, that the object of it was to extend the monopoly secured by the patent beyond the limits assigned to it by a judicial decision upon it in its original form. *Poppenhusen v. Falke*, 5 *Blatchf.* 46 ; 2 *Fish. Pat. Cas.* 213.

A reissue is not invalidated by immaterial difference between it and the original. *McCreary v. Pennsylvania Canal Co.*, 26 *Int. Rev. Rec.* 379 ; 10 *Rep'r*, 723 ; S. C., *sub nom.* *McCrary v. Pennsylvania Canal Co.*, 5 *Fed. Rep'r*, 367. See, also, *Smith v. Mercer*, 5 *Pa. L. J.* 529.

A reissue of a patent is not void for stating modes of operating the invention not stated in the original, the invention being the apparatus or combination of parts and not any particular instrumentality by which it is operated. *Broadnax v. Central Stock Yard, &c. Co.*, 5 *Bann. & A. Pat. Cas.* 609 ; 4 *Fed. Rep'r*, 214 ; 11 *Rep'r*, 6.

A reissued patent to John Deuchfield is not void because the original was granted to John Denehfield, the change of the letter being a clerical mistake. *Bignall v. Harvey*, 4 *Fed. Rep'r*, 334 ; 18 *Blatchf.* 353 ; 18 *Pat. Off. Gaz.* 1275 ; 5 *Bann. & A. Pat. Cas.* 636.

A reissued patent may be valid, notwithstanding the invalidity of one of its claims, if it appears that such claim was made in good faith by the inventor, and was not intended to broaden the original claims for the purpose of covering intermediate inventions or improvements. *Odell v. Stout*, 22 *Fed. Rep'r*, 159; 29 *Pat. Off. Gaz.* 862.

A reissue granted on an application made after unreasonable delay, and for the purpose of enlarging the specification and claims in order to bring within the exclusive privilege an invention, patented after the original patent was granted, is void as to the new claims. *Torrent Arms Lumber Co. v. Rodgers*, 112 *U. S.* 659.

149. *Reissued Patents void in Part only.*

Although the reissue of a patent may be void as to new or expanded claims, it may be good as to claims not expanded or which do not show a different invention from the original patent. A patentee may recover on an infringement of the valid claim. *Havemeyer v. Randall*, 21 *Fed. Rep'r*, 404; *Havemeyer v. Bonnell*, *Id.* 406; *Gage v. Herring*, 107 *U. S.* 646; 2 *Sup. Ct. Rep'r*, 819; *Worden v. Searls*, 21 *Fed. Rep'r*, 406; *Gould v. Spicer*, 15 *Fed. Rep'r*, 344; *Cote v. Moffitt*, *Id.* 345; *Starrett v. Athol Machine Co.*, 14 *Fed. Rep'r*, 910; 23 *Pat. Off. Gaz.* 1729; *Reay v. Raynor*, 19 *Fed. Rep'r*, 308; *Dryfoos v. Wiese*, *Id.* 315; *Wood v. Packer*, 17 *Fed. Rep'r*, 650.

When a patent is reissued in several divisions, no one of them is void merely because they, every one, describe all the mechanism shown in the original, provided the claim in each is for a different device which is already described, and there is no conflict between them. *Wheeler v. McCormick*, 4 *Pat. Off. Gaz.* 692; 11 *Blatchf.* 334; 6 *Fish. Pat. Cas.* 551.

150. *Grounds on which they may be adjudged Void.*

Reissued patent declared invalid because the affidavit filed to obtain it was not drawn in compliance with the statute. *Poage v. McGowan*, 15 *Fed. Rep'r*, 398.

Whenever the power of reissue has been fraudulently or corruptly abused, the renewal will be avoided. *Woodworth v. Edwards*, 3 *Woodb. & M.* 120.

An application for a patent was rejected because of want of novelty, on reference to a prior invention; but on a re-application it was granted because of a disclaimer by the patentee of certain claims made on the prior application; it was *held*, that a reissue to the assignee of the inventor, on claims including those disclaimed by the prior patentee, is invalid as to such claims. *Putnam v. Hutchinson*, 12 *Fed. Rep'r*, 127; 11 *Biss.* 233; 28 *Int. Rev. Rec.* 177.

Where, upon the application for a patent for an improvement in cotton presses, a claim of the applicability of the invention to a certain class of presses was abandoned; it was *held*, that a reissue of the patent by which the invention was made applicable to that class of presses was improper and void. *Wicks v. Stevens*, 2 *Woods*, 310; 2 *Bann. & A. Pat. Cas.* 318.

On an application by J., as assignee of a patent, for a reissue, the commissioner declared an interference between it and a patent previously issued to S., and rendered his decision in favor of S. On appeal, the decision of the commissioner was reversed and a reissue ordered to J. Before the reissue was granted, the owner of a patent issued to W., prior to the application of J., applied to the commissioner to declare an interference between it and the application of J. The interference was declared, and the commissioner decided in favor of the patent to W. On appeal by J. from this decision, the second interference was held to have been wrongfully declared, on the ground that no second interference could be declared under the statute (act of 1836, § 8), and the reissue to J. was peremptorily ordered. The reissue was granted, and the owner of the patent to W. then filed a bill against the owners of the reissued patent to J., to have that patent declared void. On an application for a preliminary injunction,—it was *held*, that the order declaring the second interference and directing the reissue to J. was a nullity, and the reissued patent void; and the injunction was granted. *Potter v. Dixon*, 5 *Blutchf.* 160.

151. *Construction and Effect of reissued Patents.*

A reissued patent has the same effect and operation in law as though it had been originally filed in the corrected form, only on the trial of actions brought on it for causes thereafter arising, and has no such effect in any other case, or for any other purpose. *United States Stamping Co. v. King*, 7 *Fed. Rep'r*, 830; 17

Blatchf. 55 ; 17 *Pat. Off. Gaz.* 1399 ; 4 *Bann. & A. Pat. Cas.* 469.

The correction of the patent by reissue relates back, and, except as to suits for infringements before the reissue, it operates from the date of the original. *Woodworth v. Hall*, 1 *Woodb. & M.* 248 ; 6 *Pa. L. J.* 178 ; *Stanley v. Whipple*, 2 *McLean*, 35 ; *Smith v. Pearce*, *Id.* 176 ; *Bloomer v. Stolley*, 5 *McLean*, 158 ; 8 *West. L. J.* 158 ; *Grant v. Raymond*, 6 *Pet.* 218. And being only a continuation of the first one, the rights of the patentee are to be ascertained by the law under which the original application was made. *Shaw v. Cooper*, 7 *Pet.* 292, 315.

Where in the case of a reissued patent, the complainants had adopted the surrender and accepted the new patent, it was *held*, that they were estopped from denying either the authority of the applicant, or that of the commissioner. *Dental Vulcanite Co. v. Wetherbee*, 2 *Cliff.* 555 ; 3 *Fish. Pat. Cas.* 87.

Where one paragraph in a reissue specification would seem to lead to a construction which would make void the reissue, explanation of its meaning may be sought in a succeeding one. *Carew v. Boston Elastic Fabric Co.*, 3 *Cliff.* 356 ; 1 *Pat. Off. Gaz.* 91 ; 5 *Fish. Pat. Cas.* 90.

Where the process and purpose are plainly suggested and understood, and the language in an original specification is suggestive of new terms and names used in the reissue, such new names and terms do not show that the reissue is descriptive of an invention different from that set out in the original. *Ib.*

If a patentee uses certain words in his first specification and afterwards withdraws them in his amended specification in a reissued patent, he is not estopped by the words which have been so withdrawn and canceled. *Allen v. Blunt*, 2 *Woodb. & M.* 121, 143.

Reissuing a patent which has been adjudged void for want of novelty cannot give it validity. *Jones v. McMurray*, 2 *Hughes*, 527 ; 3 *Bann. & A. Pat. Cas.* 130. Nor will the invalidity of a claim in a reissue impair the validity of a claim in the original patent which is repeated and separately stated in the reissue. *Schillinger v. Greenway Brewing Co.*, 17 *Fed. Rep'r*, 244 ; 24 *Pat. Off. Gaz.* 495 ; *Fetter v. Newhall*, 17 *Fed. Rep'r*, 841 ; 25 *Pat. Off. Gaz.* 502 ; 16 *Rep'r*, 360.

The novelty of a patented invention is not impeached by a prior patent which did not originally describe the invention, but has since been enlarged by reissue so as to include it. *Vogler v. Semple*, 7

Biss. 382; 11 *Pat Off. Gaz.* 923; 23 *Int. Rev. Rec.* 112; 2 *Bann. & A. Pat. Gaz.* 556.

Where, by a prior decision of a case involving the validity of a patent, it was decided that the present reissue was not patentable by reason of an earlier patent, argument against the propriety of such decision will not be entertained. *Meyer v. Goodyear India-Rubber Manuf. Co.*, 11 *Fed. Rep'r*, 891; 20 *Blatchf.* 91.

Features of an invention which have been disclaimed by the patentee on applying for and obtaining a patent cannot be afterward secured by surrendering the patent and taking a reissue embracing them. If such reissued patent is erroneously granted by the commissioner, it will not sustain a suit for infringement of the parts of the invention originally disclaimed. *Leggett v. Avery*, 101 *U. S.* 256.

Where an inventor inserts a description of a modified or improved form in an application for reissue, and is required, by the commissioner of patents, to disclaim this description as a condition precedent to granting of the reissue, he is not estopped from enjoining the use of machines containing such modification or improvement. The admission or disclaimer is not of a fact of invention, but of the propriety of inserting a certain clause in the descriptive part of the specification. If the patentee's invention and his patent rightly included a certain form as an equivalent, it was a mere nullity to confess that it did not include it. *Union Metallic Cartridge Co. v. United States Cartridge Co.*, 7 *Fed. Rep'r*, 344.

Where a patentee invented an apparatus for breaking coal, and combined it with an apparatus for screening coal, which he did not invent, and took a patent for the combination only, and afterward took a patent for the breaking apparatus, and then surrendered both patents and took one for the breaking apparatus alone; it was *held*, that his describing and not claiming the breaking apparatus in his first patent and the surrender and cancellation of the second did not deprive him of his right to a patent for the breaking apparatus. *Battin v. Taggart*, 17 *How.* 74. And see 2 *Wall. Jr.* 101.

XII. DISCLAIMERS. INTERFERENCE SUITS.152. *Disclaimers authorized.*

Whenever, through inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, a patentee has claimed more 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. *Rev. Stat. § 4917.*

See also *Rev. Stat. § 4922* ; which is as follows :

Whenever, through inadvertence, accident, or mistake, and without any willful default or intent to defraud or mislead the public, a patentee has, in his specification, claimed to be the original and first inventor or discoverer of any material or substantial part of the thing patented, of which he was not the original and first inventor or discoverer, every such patentee, his executors, administrators, and assigns, whether of the whole or any sectional interest

in the patent, may maintain a suit at law or in equity, for the infringement of any part thereof, which was *bona fide* his own, if it is a material and substantial part of the thing patented, and definitely distinguishable from the parts claimed without right, notwithstanding the specifications may embrace more than that of which the patentee was the first inventor or discoverer. But in every such case in which a judgment or decree shall be rendered for the plaintiff no costs shall be recovered unless the proper disclaimer has been entered at the patent-office before the commencement of the suit. But no patentee shall be entitled to the benefits of this section if he has unreasonably neglected or delayed to enter a disclaimer.

Rev. Stat. § 973 also provides :

When judgment or decree is rendered for the plaintiff or complainant, in any suit at law or in equity, for the infringement of a part of a patent, in which it appears that the patentee, in his specification, claimed to be the original and first inventor or discoverer of any material or substantial part of the thing patented, of which he was not the original and first inventor, no costs shall be recovered, unless the proper disclaimer, as provided by the patent laws, has been entered at the patent office before the suit was brought.

153. *Nature and Uses of a Disclaimer.*

The disclaimers mentioned in section 4917 must be distinguished from those which are embodied in original or reissue applications, as at first filed or subsequently amended, referring to matter shown or described, but to which the disclaimant does not choose to claim title ; and also from those made to avoid the continuance of interferences, which require no fee, but must, like all other disclaimers, be signed by the applicants in person and duly witnessed. *Rules of Prac.* No. 168.

When an applicant makes two or more applications relating to the same subject matter of invention, all showing, but only one claiming, the same thing, those not claiming it must contain disclaimers thereof, with references to the application claiming it.

The law requiring and permitting a patentee to disclaim is not penal, but remedial. It is intended for the protection of the patentee as well as the public, and should not receive a construction

that would restrict its operation within narrower limits than the words of the law fairly import. Whether a patent is illegal in part because of claiming more than the inventor has described, or more than he has invented, the patentee must in either case disclaim in order to save the portion to which he is entitled; and he is allowed to do this when the error was committed by mistake. *O'Reilly v. Morse*, 15 *How.* 61, 121.

Where, in a disclaimer, the party states that he was the patentee, and nothing is said in respect to a transfer of any interest, the fair presumption is, that he still owns the whole; and it is a sufficient compliance with the requirement of the act of 1837,—that the party making a disclaimer should state the extent of his interest in the patent,—to say “that such disclaimer is to operate to the extent of his interest therein.” *Silby v. Foote*, 14 *How.* 218; *aff'g 1 Blatchf.* 445.

It is not competent for a patentee who has surrendered his letters-patent and made oath that he believes that by reason of an insufficient or defective specification the surrendered letters are inoperative and void, and has taken out reissued letters on a new specification and for new claims, to abandon the reissue and resume the original patent by a disclaimer. *McMurray v. Mallory*, 111 *U. S.* 97.

Where a patent for the infringement of which suit is brought, appears to cover separate and distinct inventions, without connection between them, either in purpose, design or operation, other than that all are designed for use upon the same article, each being a distinct improvement, the court may, as a condition of granting the relief sought, require the complainants to file in the patent-office a disclaimer of all the claims except that alleged to be infringed. *Sessions v. Romadka*, 21 *Fed. Rep'r*, 124.

An acquiescence in a decision requiring a disclaimer as a condition precedent to granting a patent (here, an extension) and filing a disclaimer pursuant to it, are as operative to estop the disclaimant from afterward recovering on the invention disclaimed as from claiming it on a subsequent reissue. *Cartridge Co. v. Cartridge Co.*, 112 *U. S.* 624, 644.

Justice BLATCHFORD suggests that “the word ‘claimant’ is an evident error* for disclaimant.” *Ib.*

* As one of the late commissioners to revise the statutes, I will say that I do not remember whether the board had special discussion over the word “claimant” in this section; but I think it is correct. The sense is, *the person claiming the inven-*

What persons, under act of 1870, c. 230, § 54 (Stat.) 205, might make a disclaimer, of what, and its effect, explained. *Ib.*

Limitations and provisos introduced by an inventor into his application, especially if it has been rejected, must be deemed equivalent to disclaimers. *Sargent v. Hall Safe and Lock Co.*, 114 *U. S.* 63.

If the patentee has assigned his patent in part, and a joint suit is brought in equity for a perpetual injunction, a disclaimer by the patentee alone without the assignee's uniting in it will not entitle the parties to the benefit of the act of 1837, §§ 7 and 9. *Wyeth v. Stone*, 1 *Story*, 273 ; 4 *L. Rep'r*, 54.

Where the thing claimed without right is a part of a machine, if it is not an essential part and was not introduced into the patent through the willful default of the patentee, or with intent to defraud or mislead the public, the want of a disclaimer in regard to it affords no ground for invalidating the patent. *Hall v. Miles*, 2 *Blatchf.* 194.

A disclaimer may embrace subject-matter set up for the first time without right in the reissue patent ; and it may apply not only to the invalid claim, but to statements in the body of the specification upon which the invalid claim or part of claim is founded. The reissue specification is to be thereafter read as if the disclaimer were incorporated in it. *Schillinger v. Gunther*, 17 *Blatchf.* 66 ; 16 *Pat. Off. Gaz.* 905 ; 4 *Bann. & A. Pat. Cas.* 479. Where the statements in the specification and claim of the reissue patent, which the disclaimer seeks to modify, were mistakes in fact and were founded upon experiments made after the date of the original patent, it was *held*, that the disclaimer was lawful both to remedy the misstatements and to save the reissue from impeachment as for a different invention, it appearing that the inventor had acted, throughout, in good faith. *Ib.*

tion. In the preceding sentences the statute is speaking of the person filing the disclaimer, and disclaimant is used, properly. In this sentence the sense changes to that of the person who in the "original specification" laid claim to the invention. Were "disclaimant" substituted for "claimant," in this sentence, what would be the force of the clause "to the interest possessed by the disclaimant?"

How can a disclaimant, strictly as such, possess an interest? In so far as he is a disclaimant he disavows interest. Take, also, the words next following: "and by those claiming under him." How can persons be said to "claim under" a disclaimant, as contrasted with a claimant? The change of term corresponds to the change of sense. B. V. A.

Where parts of the thing patented in claims which had been infringed were definitely distinguishable from parts claimed in other claims made by mistake, without any willful default, or intent to defraud or mislead the public, and the complainant had not been unreasonably negligent in not entering a disclaimer,—*held*, that he might, on entering a disclaimer, maintain the suit brought for infringement, but without costs. *Matthew v. Spangenberg*, 10 *Fee Rep'r*, 823 ; 20 *Blatchf.* 482.

A disclaimer limiting the actual invention of the patentee, the result of an error or mistake on the part of the patent-office, may be omitted in a reissue. *American Shoe Tip Co. v. National Shoe Toe Protecting Co.*, 11 *Pat. Off. Gaz.* 740 ; 2 *Bann. & A. Pat. Cas.* 561.

Where on application for a patent, the specification, as filed, disclaims a certain principle, the generality of such disclaimer will be restricted to the purpose for which it is used, as intended to be considered upon that application ; it will not estop the applicant from subsequently claiming, in another application, the invention so disclaimed. *Hill v. Dunklee*, 1 *MacArthur Pat. Cas.* 475.

154. *Effect.*

Where, upon the purchase of a patent, the purchaser in a reissue of such patent disclaims a portion of the mechanism as insufficient to produce the desired result, a third person has the right to improve such part of the machine by changing its internal form so as to effect a result which the purchaser of the patent, in his reissue, disclaims for it. *Hatch v. Moffitt*, 15 *Fed. Rep'r*, 252.

Where a patentee has defectively or insufficiently described his invention, and claimed more than he has a right to claim as new, he is entitled to a reissue of his patent upon his surrender of the original ; but it is not the office of a disclaimer to reform the description of an invention. *Hailes v. Albany Store* ; 15 *Fed. Rep'r*, 240 ; 24 *Pat. Off. Gaz.* 391 ; 16 *Rep'r*, 65.

Where there are several claims, some of which belong to another, and the part of the invention which is his own can be clearly distinguished from that which is not his own, a disclaimer before suit brought will put him right, and enable him to recover upon his patent as though it had originally been confined to the proper claims ; but he cannot convert a claim for one thing into a claim

for something else, and amend the description to effectuate such claim. *Ib.*

A disclaimer can add nothing to the patent. It can take away from what was described as the invention and claimed as such, so as to be covered by the grant of the patent, but it has no office to make the patent cover any thing, however clearly shown in the patent, not described and claimed as a part of the invention. *White v. E. P. Gleason Manuf. Co.*, 17 *Fed. Rep'r*, 159; 24 *Pat. Off. Gaz.* 205.

If inventions not new or original with the patentee are included in the specification by mistake, accident, or inadvertence, or without willful defraud or intent to defraud or mislead the public, the patent is good and valid for so much of the invention or discovery as is truly and *bona fide* the invention of the patentee. But if no disclaimer be entered in the patent-office before suit is brought, the plaintiff cannot recover costs against the defendant, although infringement of the valid claim be proved. But if, when the patentee applied for a reissue of his original patent, he well knew he was not the first inventor of the invention mentioned in any of his claims, then his patent is void, and no recovery can be had thereon. *Singer v. Walmsley*, 1 *Fish. Pat. Cas.* 558.

A disclaimer of part of an invention cannot affect a prior grantee under the patent, unless he accepts it; he may refuse to be affected by it. *Smith v. Mercer*, 5 *Pa. L. J.* 529.

A motion for a preliminary injunction in a suit for infringement may be granted, notwithstanding the filing by plaintiffs of a disclaimer after suit was brought, if the defendants' rights have not been in any degree prejudiced by the disclaimer. *Libbey v. Mt. Washington Glass Co.*, 26 *Fed. Rep'r*, 757.

155. *Neglect or Delay in filing.*

A disclaimer may be made after as well as before a suit for infringement; but the court has power to protect the defendant from surprise, &c., and to take into consideration the fact of delay. *Smith v. Nichols*, 21 *Wall.* 112; aff'g 1 *Holmes*, 172; 2 *Pat. Off. Gaz.* 649; 6 *Fish. Pat. Cas.* 61.

The disclaimer, to be effectual under the act of 1837, §§ 6, 7 (now Rev. Stat. § 4922), must be filed in the patent-office before suit is brought. If it is filed during the pendency of the suit, the

plaintiff will not be entitled to the benefit thereof in that suit. Unless it is so filed, the plaintiff will not be entitled to recover costs in such suit, even if he should establish at the trial that a part of the invention not disclaimed has been infringed by the defendant. But whether filed before or after suit brought, the plaintiff will not be entitled to the benefit of a disclaimer if he has unreasonably neglected and delayed to file it. Such neglect or delay is a good defense to the suit. *Reed v. Cutter*, 1 *Story*, 590

Section 7 of the act of 1837 (5 Stat. 193),—providing for the making of a disclaimer when a claim to a patent is too broad,—does not affect a suit pending when the disclaimer is filed, so as to prevent the plaintiff from recovering in it, unless there was unreasonable neglect or delay in filing the disclaimer. *Tuck v. Bramhill*, 6 *Blatchf.* 95 ; 3 *Fish. Pat. Cas.* 400.

Where, on the hearing of a bill to enjoin infringement of a patent, the claim appears too broad, but the complainant offers to disclaim the excess, there may be a decree for an injunction without waiting for filing an actual disclaimer in the patent-office ; but the complainant cannot have costs. *Aiken v. Dolan*, 3 *Fish. Pat. Cas.* 196.

It is not a good objection to the grant of a preliminary injunction under a valid claim, that a disclaimer was not filed as to other claims before suit was brought. Such claims having the sanction of the commissioner, and the question of their validity being one of law, to be ultimately decided by the courts, it cannot be said that the plaintiffs have unreasonably neglected or delayed to enter a disclaimer. *Duff v. Calkins*, 25 *Pat. Off. Gaz.* 601.

A disclaimer in a suit on a patent, under Rev. Stat. § 4922, need not be filed, except where costs are sought, until the court has passed upon the contested claims alleged to contain that of which the patentee was not the inventor. *Stutz v. Armstrong*, 20 *Fed. Rep'r*, 843.

What amounts to unreasonable delay or neglect in filing a disclaimer. *Silsby v. Foote*, 20 *How.* 378 ; modifying 2 *Blatchf.* 278 ; *Seymour v. McCormick*, 19 *How.* 96 ; aff'g 3 *Blatchf.* 209 ; *O'Reilly v. Morse*, 15 *How.* 62.

As to effect upon right to costs, under Rev. Stat. § 4922, of failure to file disclaimer before bringing suit for infringement,—see *Elastic Fabrics Co. v. Smith*, 100 *U. S.* 110 ; aff'g 1 *Holmes*, 340 ; 5 *Pat. Off. Gaz.* 329 ; 1 *Bann. & A. Pat. Cas.* 58 ; *Reed v.*

Cutter, 1 *Story*, 590; *Hall v. Wiles*, 2 *Blatchf.* 194; *Aiken v. Dolan*, 3 *Fish. Pat. Cas.* 197; *Stutz v. Armstrong*, 20 *Fed. Rep'r*, 843.

156. *Suits touching interfering Patents.*

Whenever there are interfering patents, any person interested in any one of them, or in the working of the invention claimed under either of them, may have relief against the interfering patentee, and all parties interested under him, by suit in equity against the owners of the interfering patent; and the court, on notice to adverse parties, and other due proceedings had according to the course of equity, may adjudge and declare either of the patents void in whole or in part, or inoperative, or invalid in any particular part of the United States, according to the interest of the parties in the patent or the invention patented. But no such judgment or adjudication shall affect the right of any person except the parties to the suit and those deriving title under them subsequent to the rendition of such judgment. *Rev. Stat.* § 4918.

Where two patents have been issued, each claiming, broadly, the same invention, and the earlier patentee is held to be the first inventor, the claim in the second patent must be restricted to the particular devices specially described. *Richardson v. Noyes*, 10 *Pat. Off. Gaz.* 507; 2 *Bann. & A. Pat. Cas.* 398.

It is not material to the patentee's right that in the interval of delay, other inventors have devised and patented the same thing, if this was wholly without the knowledge or acquiescence of the first inventor. *Sprague v. Adrianee*, 14 *Pat. Off. Gaz.* 308; 3 *Bann. & A. Pat. Cas.* 124.

In an action under *Rev. Stat.* § 4918, where the plaintiff seeks to have the defendant's patent declared void on the ground that it is for the same invention as, and subsequent to, the plaintiff's patent, a plea in bar which admits the priority of the plaintiff's patent for the same invention, but sets out a fact which would render the plaintiff's patent void for want of novelty, must be over-

ruled, because the fact is immaterial in such proceeding. *Pentlarge v. Pentlarge*, 19 *Fed. Rep'r*, 817.

Where a patentee has been defeated in an interference proceeding and a patent has been granted to the other party on the ground that he was the prior inventor, the defeated party will not be allowed to plead, in an action against him for the continued use of the invention, that neither party was in fact the first inventor, if he acted in bad faith. *Greenwood v. Bracher*, 5 *Bann. & A. Pat. Cas.* 302; 1 *Fed. Rep.* 856; 17 *Pat. Off. Gaz.* 1151.

In a suit against an interfering patentee under Rev. Stat. § 4918, the defendant need not file a cross-bill to obtain affirmative relief. *Lockwood v. Cleveland*, 6 *Fed. Rep'r*, 721; 11 *Rep'r*, 557.

The sole question that can be litigated under Rev. Stat. § 4918, is the question of priority between two interfering patents. *Lockwood v. Cleveland*, 20 *Fed. Rep'r*, 164.

Under the provisions of Rev. Stat. § 4918,—in respect to interfering patents,—the circuit court has authority to adjudge either of the interfering patents void in whole or in part, and, upon proper issues and proof, to authorize a decree that both patents are void. *Foster v. Lindsay*, 3 *Dill.* 123; 2 *Bann. & A. Pat. Cas.* 172.

There is no provision of law whereby in proceedings for relief against owners of an interfering patent, under Rev. Stat. § 4918, persons who are not inhabitants of and cannot be served in the district, can be brought in as defendants; a service of a mere notice that the suit is pending is inoperative. *Liggett, &c. Tobacco Co. v. Miller*, 1 *Fed. Rep'r*, 203; 1 *McCrory*, 31; 17 *Pat. Off. Gaz.* 798; 5 *Bann. & A. Pat. Cas.* 237.

XIII. INFRINGEMENT.

157. *Nature of the Right which must not be infringed.*

The invention itself, before the patent is issued, is "property" in the inventor, and continues to be such, without the protection of a patent, until he abandons the same to the public, unless he suffers the patented product to be in public use or on sale, with his consent and allowance, for more than two years before he files his applica-

tion for a patent. *Jones v. Sewell*, 6 *Fish. Pat. Cas.* 343 ; 3 *Cliff.* 563 ; 3 *Pat. Off. Gaz.* 630.

But the right which an inventor has to control the exclusive use of his invention after he has suffered it to be used in public, is the creature of the statute ; the supreme court has always held that he has no right upon which he can maintain suit, unless he obtains letters patent according to the statute ; and his right is regulated and measured by the provisions of the act, and cannot go beyond them. *Brown v. Duchesne*, 19 *How.* 183 ; *aff'g* 2 *Curt.* 371. S. P., *Morton v. New York Eye Infirmary*, 5 *Blatchf.* 116 ; 2 *Am. L. Reg. N. S.* 672 ; 2 *Fish. Pat. Cas.* 320 ; *Waterbury Brass Co. v. Miller*, 9 *Blatchf.* 77 ; 5 *Fish. Pat. Cas.* 48 ; *Sisson v. Gilbert*, *Id.* 109 ; 9 *Blatchf.* 185 ; *Re Brosnahan*, 18 *Fed. Rep'r*, 62. The exclusive right does not rest alone upon the discovery, but also upon the legal sanctions which have been given to it, and the forms of law with which it has been clothed. *Shaw v. Cooper*, 7 *Pet.* 292, 320.

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

But (in this country) it is a matter of right, on complying with the conditions prescribed by law. *Whitney v. Emmett*, *Baldw.* 303. It is not a "monopoly," but resembles a contract between the government and the inventor, securing to him, for a limited time, the exclusive enjoyment of the practice of his invention, in consideration of his disclosure of the secret to the public, and his relinquishment of his invention to the public at the end of the term (*Attorney-General v. Rumford Chemical Works*, 9 *Pat. Off. Gaz.* 1062 ; *McKeever v. United States*, 14 *Ct. of Cl.* 396 ; 23 *Pat. Off. Gaz.* 1325 ; *Ames v. Howard*, 1 *Summ.* 482 ; *Blanchard v. Sprague*, 3 *Summ.* 535 ; 2 *Story*, 164) ; though it is a contract only as between the parties to it, namely, the United States on one side and the patentee on the other. *Re Brosnahan*, 18 *Fed. Rep'r*, 62.

No right of property vests in the public, in the sense of the 5th amendment of the Constitution, because of the consent of the inventor to the public use of his invention, such as will prevent the subsequent allowance, by act of Congress, of a patent for such invention, unless there was, in a particular case, a reduction of the invention to use and practice, by its embodiment in some apparatus, prior to the issue of such patent. *Page v. Holmes Burglar Alarm Co.*, 1 *Fed. Rep'r*, 304 ; 17 *Blatchf.* 484 ; 17 *Pat. Off. Gaz.* 737 ; 5 *Bann. & A. Pat. Cas.* 165.

But a patent if valid, gives to the patentee a right of property in the thing patented, which is entitled to full protection in the courts. *Whitney v. Emmett*, *Baldw.* 303. And see *Kittle v. Merriam*, 2 *Curt.* 475 ; *Smith v. Pearce*, 2 *McLean*, 176.

Although a patentee was the first to conceive of the convenience and utility of the mechanism patented by him, his right to a patent rests upon the novelty of the means he contrives to carry his idea into practical application. Changes in old instrumentalities, made to adapt them to a use for which they were not originally intended, which involve only the exercise of ordinary mechanical skill, do not sanction the patent. *Aron v. Manhattan R. Co.*, 26 *Fed. Rep'r*, 314 ; 34 *Pat. Off. Gaz.* 1508.

As invention is an intellectual process or conception, he who first makes an invention known sufficiently, by describing it in words or drawings, will be considered to be the first discoverer, and vested with an inchoate right to its exclusive use, which he may embody, perfect and make absolute, by proceeding to mature it in the manner which the law requires. Delay in so doing, caused by poverty of the inventor and his inability to engage in the manufacture of the invention, does not prejudice his rights. *Hill v. Dunklee*, 1 *MacArthur Pat. Cas.* 475.

With respect to cases where one person conceives a new and useful idea, which others co-operate with him in developing, the general rule is that the invention and the patent belong to him who forms the conception, especially if he employs them to assist him, pays their wages, and, generally, furnishes means for carrying on the necessary experiments. *McClurg v. Kingsland*, 1 *How.* 202 ; *Worley v. Tobacco Co.*, 104 *U. S.* 340 ; *Sparkman v. Higgins*, 1 *Blatchf.* 205 ; 5 *N. Y. Leg. Obs.* 122 ; 6 *Pa. La. J.* 344 ; *Soder v. Mills*, 25 *Fed. Rep'r*, 321. Employes may make and patent independent inventions, even though improvements in the machinery used in the employer's business (*Hapgood v. Hewitt*, 11 *Biss.* 184 ; 21 *Pat. Off. Gaz.* 1786 ; 11 *Fed. Rep'r*, 422 ; *Berdan Fire Arms Manuf. Co. v. Remington*, 3 *Pat. Off. Gaz.* 688 ; *Damon v. Eastwick*, 14 *Fed. Rep'r*, 40 ; 14 *Rep'r*, 644 ; 22 *Pat. Off. Gaz.* 1709); but assistance rendered to an employer in development of his conceptions ; and suggestions and advice, incidental thereto, do not, in general, give a right under the patent laws. *Agawan Co. v. Jordan*, 7 *Wall.* 583 ; *Pennock v. Dialogue*, 4 *Wash.* 538 ; *aff'd*, 2 *Pet.* 2 ; *Watson v. Bladen*, 4 *Wash.* 580.

158. *Its Scope and Extent.*

Not only is a patentee's right bounded by the law, it is limited by the patent even though the patent is not as broad as the law under which it is issued, yet the right is under the patent, and not under the law. See *Evans v. Eaton*, *Pet. C. Ct.* 322, 340. See reversal, 3 *Wheat.* 454.

An inventor must be assumed to know of what his invention consists, and his patent does not secure him the exclusive right in anything more than he claims to have invented. *Rich v. Close*, 8 *Blatchf.* 41 ; 4 *Fish. Pat. Cas.* 279.

The grant of a patent gives an exclusive right to the patented invention for all uses to which it can be put, whether contemplated by the inventor or not. But the invention must in some way be covered by the patent before he can acquire an exclusive right to it for any purpose. *Tinker v. Wilber Eureka Mower, &c. Co.*, 1 *Fed. Rep'r*, 273 ; 5 *Bann. & A. Pat. Cas.* 92.

A patentee is entitled to all benefits which result from his invention, whether he has specified all the benefits in his patents or not. *California Artificial Stone Paving Co. v. Perine*, 8 *Fed. Rep'r*, 821 ; 7 *Sawyer*, 190 ; 20 *Pat. Off. Gaz.* 813.

In reducing his patent to practical application a patentee is not held to strictly and entirely follow the mere mechanical device shown in his drawings, but he may deviate so long as he does not violate the principle involved in his patent. *Weir v. North Chicago Rolling Mill Co.*, 23 *Pat. Off. Gaz.* 191 ; 14 *Fed. Rep'r*, 42 ; 9 *Biss.* 508.

A patentee is not generally limited by the literal import of his description of his invention, but may, in construction, make such modifications of it as do not involve a departure from its principle, or a material change in its mode of operation. *Grier v. Castle*, 17 *Fed. Rep'r*, 533 ; 24 *Pat. Off. Gaz.* 1176.

A naked principle is not patentable ; nor is the application of the effect of a principle ; the same effect may therefore be produced by various persons by different means without infringement. *Bain v. Morse*, 1 *MacArthur Pat. Cas.* 90 ; *Re Halsey*, *Id.* 459.

A patentee has the right to grant the right to make and sell the patented invention within specified territory, and to make that right exclusive in the grantee, and yet limit the use of the thing so made and sold, within specified limits ; or, while granting to another

a right to make or to make and sell, he may retain to himself the exclusive right to make and sell for export or use in other countries. *Dorsey, &c. Rake Co. v. Bradley Manuf. Co.*, 12 *Blatchf.* 202.

The owner of a useful invention has the right to sell it to all who will purchase, subject only to restraint from some party having a conflicting patent. He holds the right from the general law of the land, and needs no act of Congress to enable him to make or vend his article, and obtains no such right from Congress. He obtains from the patent laws only the power to restrain another from unlawfully making, using or vending his invention. *Celluloid Manuf. Co. v. Goodyear Dental Vulcanite Co.*, 13 *Blatchf.* 375; 10 *Pat. Off. Gaz.* 41; 2 *Bann. & A. Pat. Cas.* 334.

The sole object and purpose of the patent laws is to give to the inventor a monopoly of what he has discovered. What is granted to him is the exclusive right; not the abstract right, but the right in him to the exclusion of everybody else. He is not authorized by the patent laws to manufacture and sell the patented article in violation of the laws of the state. His enjoyment of the right may be modified by the exigencies of the community to which he belongs, and regulated by laws which render it subservient to the general welfare, if held subject to State control. *Re Brosnahan*, 18 *Fed. Rep'r*, 62.

One who invents a new machine never used before, and procures letters patent therefor, acquires a monopoly as against all merely formal variations thereof; but if the advance toward the thing desired is gradual, and proceeds step by step, so that no one can claim the complete thing, each inventor is entitled only to his own specific form of device. *Railway Co. v. Sayles*, 97 *U. S.* 554.

When an invention is simply an improvement on a known machine, by a mere change of form or of combination of parts, the inventor is entitled only to the specific form of device which he has produced; and he cannot invoke the doctrine of equivalents to suppress other improvements except such as are mere colorable invasions of his own. But where an inventor precedes others, and his machine performs a function never performed by any earlier machine, the court will treat as infringers all who accomplish the same result by substantially the same or substantially equivalent means. *Morley Sewing Machine Co. v. Lancaster*, 23 *Fed. Rep'r*, 344.

An inventor who first applies an old device to a new use is not entitled to the exclusive use of such device when applied in other

mechanisms not analogous to produce a new effect. *Judd v. Babcock*, 8 *Fed. Rep'r*, 695 ; 23 *Pat. Off. Gaz.* 92.

Where a patent clearly shows and describes a machine whose use necessarily involves the production of a certain process, no other person can afterwards patent that process. The patentee is entitled to his mechanism for every use of which it is capable, and there is no invention in the use of an old machine for a new purpose. *New Process Fermentation Co. v. Koch*, 21 *Fed. Rep'r*, 586 ; 29 *Pat. Off. Gaz.* 535.

Although an invention be a primary one and the machine invented be the first practical one for accomplishing the result, and although the patent for it declares that the machine described is only one of different mechanisms contemplated by the patentee which may be effectually employed for carrying out the main feature of his invention, he is entitled only to the exclusive use of the particular contrivance to make the idea practically useful ; the patent does not give an exclusive right to the principle, or to groups of instrumentalities, independent of the mechanism desired. *Morley Sewing Machine Co. v. Lancaster*, 23 *Fed. Rep'r*, 344.

159. *How long it endures.*

Congress having power to secure, "for limited times," to inventors, the exclusive right to their discoveries, in consideration of the benefit which the public will derive from the invention after the expiration of the term, whatever was patented to the inventor and enjoyed by the inventor and those operating in any way under him during the term, belongs to the public and is free to all at the expiration of the term. *Wilcox, &c. Sewing Machine Co. v. The Gibbons Frame*, 17 *Fed. Rep'r*, 623 ; 21 *Blatchf.* 431 ; 24 *Pat. Off. Gaz.* 1272 ; *McCormick v. Manny*, 6 *McLean*, 539 ; 4 *Am. L. Reg.* 277. The patentee cannot claim to continue the exclusive use on the ground that the shape, name, design, etc., under which he has been accustomed to sell the invention has become a trademark. *Wilcox, &c. Sewing Machine Co. v. The Gibbons Frame*, *supra* ; *Fairbanks v. Jacobus*, 14 *Blatchf.* 337 ; *Consolidated Fruit Jar Co. v. Dorflinger*, 2 *Am. L. T. N. S.* 571 ; *Singer Manuf. Co. v. Stanage*, 6 *Fed. Rep'r*, 279 ; 2 *McCrury*, 512 ; 11 *Rep'r*, 661 ; *Same v. Riley*, 11 *Fed. Rep'r*, 706 ; *Singer Manuf. Co. v. Larsen*, 8 *Biss.* 151 ; 3 *Bann. & A. Pat. Cas.* 246 ; *Tucker Manuf. Co. v. Boying-*

ton, 9 *Pat. Off. Gaz.* 455 ; Leclanché Battery Co. v. Western Electric Co., 21 *Fed. Rep'r*, 538. But see Lorillard v. Wight, 15 *Fed. Rep'r*, 383.

Devices made according to a patent, but which have been made and combined since the expiration of the patent, are not an infringement of the patent, or violative of an injunction order restraining infringements during the term of the patent. American Diamond Rock-Boring Co. v. Sutherland Falls Marble Co., 2 *Fed. Rep'r*, 353 ; 18 *Blatchf.* 148 ; 10 *Rep'r*, 9 ; 5 *Bann. & A. Pat. Cas.* 247.

A patent, bearing date May 15, 1855, does not expire until the last hour of May 15, 1869. Johnston v. McCullough, 4 *Fish. Pat. Cas.* 170.

Where, under the acts of July 4, 1836, and March 3, 1839, a patent was taken out for a machine for the manufacture of a specific article, and subsequently, and within two years, patents were granted for the process of manufacturing such article, and also for the product of such process as a new article of manufacture,—it was held, that the patents for the process and product did not terminate with the expiration of the patent for the mechanism, although it might be of no value except to carry on such patent process and manufacture such patent product. McKay v. Dibert, 5 *Fed. Rep'r*, 587 ; 19 *Pat. Off. Gaz.* 1351 ; 11 *Rep'r*, 386.

The burden of proof is on a party seeking to limit the duration of a patent, to show the facts which limit it. American Diamond Rock-Boring Co. v. Sheldon, 17 *Blatchf.* 303 ; 4 *Bann. & A. Pat. Cas.* 603.

The intent of the act of 1861, declaring that all patents hereafter issued shall remain in force for seventeen years, and repealing inconsistent acts, was simply to increase the duration of all patents thereafter issued, giving to each an additional period of three years. Siemens v. Sellers, 23 *Pat. Off. Gaz.* 2234 ; 16 *Fed. Rep'r*, 856.

For the statute and decisions limiting patents for inventions patented abroad, see Rev. Stat. § 4887 ; *ante*, pp. 60–65.

160. *General Rules for Construction of Patents.*

A patent must be construed and passed upon according to the laws in force at the time of granting it ; the repeal of such acts cannot impair the right of property existing in a patentee. McClurg v. Kingsland, 1 *How.* 202 ; Hogg v. Emerson, 6 *How.* 437, 479 ; *aff'g* 2 *Blatchf.* 1.

Patents are to be construed in a liberal manner, so as to give them effect, and to secure the rights of the patentees. *Grant v. Raymond*, 6 *Pet.* 218; *Simpson v. Wilson*, 4 *How.* 709; *Turrill v. Michigan Southern, &c. R. R. Co.*, 1 *Wall.* 491; *Ames v. Howard*, 1 *Sumn.* 482; *Blanchard v. Sprague*, 3 *Sumn.* 535; 2 *Story*, 264; *Ryan v. Goodwin*, *Id.* 514; 3 *L. Rep'r*, 220; *Davoll v. Brown*, 1 *Woodb. & M.* 53; *Carew v. Boston Elastic Fabric Co.*, 3 *Cliff.* 356; 5 *Fish. Pat. Cas.* 90; 1 *Pat. Off. Gaz.* 91; *Goodyear Dental Vulcanite Co. v. Gardiner*, 3 *Cliff.* 408; 5 *Pat. Off. Gaz.* 586; 4 *Fish. Pat. Cas.* 224; *Goodyear v. Railroad*, 2 *Wall. Jr.* 356; 1 *Fish. Pat. Cas.* 626; *Davis v. Palmer*, 2 *Brock. Marsh.* 298; *Bloomer v. Stolley*, 5 *McLean*, 158; 8 *West. L. J.* 158; *Allen v. Hunter*, 6 *McLean*, 303; *Latta v. Shawk*, 1 *Fish. Pat. Cas.* 465; 1 *Bond*, 259.

That they should be construed strictly, because in derogation of common right, see *Re Kemper*, *MacArthur Pat. Cas.* 1.

The true rule of construction is to apply plain and ordinary principles, and not to yield to subtleties and technicalities unsuited to the subject, and not in keeping with the liberal spirit of the age, and likely to prove ruinous to a class of the community so inconsiderate and unskilled in business as men of genius and inventors usually are. *Hogg v. Emerson*, 6 *How.* 437, 485. See also, *Davoll v. Brown*, 1 *Woodb. & M.* 53; *Woodworth v. Hall*, *Id.* 248; 6 *Pa. L. J.* 178; *Winans v. Denmead*, 15 *How.* 332; *Imlay v. Norwich & Worcester R. R. Co.*, 4 *Blatchf.* 227; 1 *Fish. Pat. Cas.* 340; *Henderson v. Cleveland Co-operative Stove Co.*, 2 *Bann. & A. Pat. Cas.* 604.

The rule that patents are to be construed liberally, so as, if possible, to carry out the construction claimed by the patentee, and sustain the patent, applies to a reissue as well as an original patent; thus, where the meaning of the specification and claim in the reissue is not perfectly clear, they may be read by the light of the specification and claim of the original patent, and, if consistent with the language there used, be sustained by them. *Klein v. Russell*, 19 *Wall.* 433. See, also, *Bussey v. Wager*, 9 *Pat. Off. Gaz.* 200.

In patents for combinations of mechanism, limitations and provisos imposed by the inventor, especially such as were introduced into an application after it had been persistently rejected, must be strictly construed, against the inventor. *Sargent v. Hall Safe & Lock Co.*, 114 *U. S.* 63, 29.

In construing a patent, the court looks through the whole patent and specification, in order to ascertain what is the thing claimed and patented in it. There is no artificial or universal rule of interpretation of such an instrument beyond that which common sense furnishes, which is, to construe the instrument as a whole, and extract from the descriptive words and the claim what the invention is which is intended to be patented, and how far it is capable of exact ascertainment, and how far it is maintainable in point of law, supposing it clear from all ambiguity. *Carver v. Braintree Manuf. Co.*, 2 *Story*, 432, 446. S. P., *Pitts v. Whitman*, 2 *Story*, 609; *Carew v. Boston Elastic Fabric Co.*, 3 *Cliff.* 356; 1 *Pat. Off. Gaz.* 91; 5 *Fish. Pat. Cas.* 90; *Sullivan v. Redfield*, 1 *Paine*, 441; *Goodyear v. Railroad*, 2 *Wall. Jr.* 356; 1 *Fish. Pat. Cas.* 626; *National Car Brake Shoe Co. v. L. S. & M. S. Ry. Co.*, 4 *Fed. Rep'r*, 219; 9 *Biss.* 503; 18 *Pat. Off. Gaz.* 1179.

In deciding on the sufficiency of a patent, the court inspects the whole description as one paper, which they assume to be true in fact; and if found to be in conformity with the requisitions of the law, so that it appears with reasonable certainty, either from the words used or by necessary implication, in what the invention consists, though the description may be somewhat obscure, or imperfect, or defective, in form or mode of explanation, as claimed by the patentee, it will be adjudged sufficient. *Carver v. Braintree Manuf. Co.*, 2 *Story*, 432; *Whitney v. Emmett*, *Baldw.* 303.

The power to correct mistakes in letters patent does not belong to the courts, but it is confided to the commissioner. The court can only construe the specification and claim as they stand, and determine the legal effect of the claim. *Kittle v. Merriam*, 2 *Curt.* 475.

A patent, being a pioneer and foundation patent, both as to process and machine, is not to be construed as confined to specific details, if it fairly admits of the liberal construction to which such a patent is entitled. *Hammerschlag v. Seamoni*, 7 *Fed. Rep'r*, 584; 20 *Pat. Off. Gaz.* 75.

In the construction of letters patent, reference will be made to the existing state of the art at the time of the invention. *Wollensak v. Reiher*, 115 *U. S.* 87, 29. Patents are to be construed in the light of what was before known to persons skilled in the art to which they relate, in order to give effect to the true meaning of what is there described. *Webster Loom Co. v. Higgins*, 16 *Pat. Off. Gaz.* 675.

Decisions and opinions as to the validity of a patent are authorities in all similar cases, but not estoppels in any, except such as may arise between those very parties, or others claiming under them. But where there was no *prima facie* evidence to impeach the validity of a patent sustained in previous cases, it was construed with reference to prior existing devices to ascertain its scope. *Day v. Combination Rubber Co.*, 2 *Fed. Rep'r*, 570 ; 17 *Pat. Off. Gaz.* 1347 ; 5 *Bann. & A. Pat. Cas.* 385.

An inventor is supposed to describe in his patent the best mode of practicing his invention ; but it is not necessarily limited to the precise constructions shown, so as to exclude a method differing from it only in a single detail, but producing the same result. *Lorillard v. McDowell*, 11 *Pat. Off. Gaz.* 640 ; 23 *Int. Rev. Rec.* 90 ; 13 *Phila.* 461 ; 2 *Bann. & A. Pat. Cas.* 531.

Whether two patents cover the same invention must be determined by the tenor and scope of their claims, not by the description in the patent. *McMillan v. Rees*, 1 *Fed. Rep'r*, 722 ; 17 *Pat. Off. Gaz.* 1272 ; 9 *Rep'r*, 544 ; 5 *Bann. & A. Pat. Cas.* 269.

The court should sustain the interpretation of a patent claimed for it by the patentee, if this can be done consistently with the language he has employed. *Bradley v. Dull*, 19 *Fed. Rep'r*, 913 ; 27 *Pat. Off. Gaz.* 625.

A construction of a patent which would render a disclaimer altogether nugatory should not be adopted. *Atlantic Giant Powder Co. v. Hulings*, 21 *Fed. Rep'r*, 519.

Though the construction of the patent must certainly depend on the words of the instrument, where the words are ambiguous, there may be circumstances which ought to have great influence in expounding them. The intention of the parties, if that intention can be collected from sources which the principles of law permit the courts to explore, are entitled to great consideration. Therefore, a special act may be referred to, as well as the patentee's petition, and such construction should be given to the grant as will make it, with such documents forming a part of it, not contradictory with itself. *Evans v. Eaton*, 3 *Wheat.* 454, 506 ; *rev'g Pet. Ct. Ct.* 322.

Declarations of a patentee and former owner of a patent, undertaking to restrict the invention within a narrower compass than that stated in his specification, will not be allowed to vary the construction which would otherwise be given to the patent. *Union*

Paper Bag Machine Co. v. Pultz, &c. Co., 15 *Blatchf.* 160 ; 15 *Pat. Off. Gaz.* 423 ; 3 *Bann. & A. Pat. Cas.* 403.

161. *Of Specifications.*

The schedule or specification annexed to the letters-patent is, under our laws and practice, to be regarded as a competent part of the letters-patent, and may be referred to explain or add to the title of the patent. *Hogg v. Emerson*, 6 *How.* 437, 478 ; aff'g 2 *Blatchf.* 1. See *Evans v. Eaton*, *Pet. C. Ct.* 322.

The patent and specification are connected together and dependent upon each other for support. The specification should maintain the title of the patent ; the latter should not indicate one thing, and the former describe another, as to the subject of the grant. *Sullivan v. Redfield*, 1 *Paine*, 441 ; *Goodyear v. Railroad*, 2 *Wall. Jr.* 356 ; 1 *Fish. Pat. Cas.* 626.

Sometimes the preamble, even, may be resorted to for ascertaining the object of the specification, sometimes the body of the specification, sometimes the summing up, and sometimes the formal clause at the end of the specification. Generally, all of them are examined together, unless the formal clause seems explicitly to exclude the rest. *Davoll v. Brown*, 1 *Woodb. & M.* 53.

If the specification of a patent, taken as a whole, leaves no reasonable doubt concerning the intention of the patentee to include in his claim a certain part of a combination, though there may be an error in describing it, it will be considered as included. *Kittle v. Merriam*, 2 *Curt.* 475.

If the specification is wholly ambiguous and uncertain, so loosely defined and so inaccurately expressed, that the court cannot, upon fair interpretation of the words, and without vague conjecture of intention, gather what it is, the patent is void for such defect. But if the court can fairly see, by a reasonable use of the means of interpretation of the language used, taking the whole into connection, what is the nature and extent of the claim, then the plaintiff is entitled to the benefits of it, however imperfectly and inartificially he may have expressed himself. *Ames v. Howard*, 1 *Sumn.* 482. S. P., *Ryan v. Goodwin*, 3 *Sumn.* 514 ; 3 *L. Rep'r*, 220 ; *Emerson v. Hogg*, 2 *Blatchf.* 1. See affirmance, 6 *How.* 437 ; *Parker v. Stiles*, 5 *McLean*, 44, 57 ; 7 *West. L. J.* 168. Such a construction as will allow an inventor to couch his speci-

eration in such ambiguous terms that its claims may be expanded or contracted to suit the emergency should not be allowed. *Detmold v. Reeves*, 5 *Pa. L. J. Rep* 99.

The words of the specification are to be taken together, and they are to be so construed as to give effect to the meaning and intention of the persons using them. Words are not to be distorted so as to effect what may be supposed to have been the intention of the one using them ; but they are to have a reasonable construction, as connected with the sentence in which used. *Allen v. Hunter*, 6 *McLean*, 303.

A general description of the nature of the invention at the beginning of a specification, is not to be taken alone, in determining what is covered by the patent, but should be construed with a description of the invention itself, also contained in the specification, which gives instructions as to how the patented device is made, and specific directions as to characteristics which it must possess. *Holt v. Kendall*, 26 *Fed. Rep'r*, 622

162. Claims

In general, when a patentee describes a machine and then claims it as described, he is understood to intend to claim, and by law does actually cover, not only the precise forms he has described, but all other forms which embody his invention. *Winans v. Denmead*, 15 *How.* 342. Followed, *Grier v. Castle*, 17 *Fed. Rep'r*, 523 ; 24 *Pat. Off. Gaz.* 1176.

Where the "claim" immediately follows the description, it may be construed in connection with the explanations contained in the specification ; and be restricted accordingly. *Turrill v. Michigan Southern, &c. R. R. Co.*, 1 *Wall.* 491. See, also, *Hovey v. Stevens*, 3 *Woodb. & M.* 17 ; *Winans v. Denmead*, 15 *How.* 330 ; *Matthews v. Shoneberger*, 4 *Fed. Rep'r*, 635 ; 18 *Blatchf.* 357 ; 18 *Pat. Off. Gaz.* 1464 ; *Roberts v. Diekey*, 4 *Brews.* 260 ; 3 *Pittsb.* 352 ; 1 *Pat. Off. Gaz.* 4 ; 4 *Fish. Pat. Cas.* 532 ; *McMillin v. Rees*, 5 *Bann. & A. Pat. Cas.* 269.

A claim for a combination of several devices, so combined together as to produce a particular result, is not good as a claim for "any mode of combining those devices which would produce that result," and can only be sustained as a valid claim for the peculiar combination of devices invented and described. *Case v. Brown*, 2 *Wall.* 320 ; *aff'g* 2 *Fish. Pat. Cas.* 268.

The courts of this country cannot always indulge the same latitude which is exercised by English judges in determining what parts of a machine are or are not material. Our law requires the patentee to specify particularly what he claims to be new, and if he claims a combination of certain elements or parts, the court cannot declare that any one of these elements is immaterial. The patentee makes them all material by the restricted form of his claim. The courts can only decide whether any part omitted by an alleged infringer is applied by some other device or instrumentality which is its equivalent. *Water Meter Co. v. Desper*, 101 *U. S.* 332. And see *Lefever v. Remington*, 22 *Pat. Off. Gaz.* 1537.

The courts should be careful not to enlarge, by construction, the "claim" which the patent-office has admitted, and which the patentee has acquiesced in, beyond the fair interpretation of its terms. *Burns v. Meyer*, 100 *U. S.* 671.

The scope of letters patent should be limited to the invention covered by the claim, and this cannot be enlarged by the language in other parts of the specification. *Western Electric Manuf. Co. v. Ansonia Brass & Copper Co.*, 114 *U. S.* 447, 29.

Where, after an application for a patent for combination is rejected, the applicant, in order to obtain a patent, upon a new application, narrows his claim by the introduction of a new element, and a patent is thereupon issued to and accepted by him, he cannot afterwards, in a suit for infringement, enlarge the patent by construction so as to cover elements not falling within its terms and which he had explicitly abandoned. *Shepard v. Carrigan*, 116 *U. S.* 593.

Where a wholly new method or art has been discovered by a patentee, the courts will construe the claims of his patent broadly, and so as to cover all such mechanical means as embody the real invention. *Standard Measuring Machine Co. v. Teague*, 15 *Fed. Rep'r*, 390. *S. P., Kimball v. Hess*, *Id.* 393 ; 15 *Rep'r*, 583.

Where two patents have been issued, each claiming, broadly, the same invention, and the earlier patentee is held to be the first inventor, the claim in the second patent must be restricted to the particular devices there specially described. *Richardson v. Noyes*, 10 *Pat. Off. Gaz.* 507 ; 2 *Bann. & A. Pat. Cas.* 398.

The technical claims in a patent are to be construed with reference to the state of the art, so as to limit the patentee to, and give him the full benefit of, the invention he has made. *Estabrook v. Dunbar*, 19 *Pat. Off. Gaz.* 909 ; 2 *Bann. & A. Pat. Cas.* 427.

Although it is true that in the construction of a claim, reference may be had to the specification, to ascertain the true interpretation of the claim, yet, where the claim is such as to leave no room for construction, where it is clear and explicit, and especially, where there is nothing in the specification which shows that the patentee did not mean just what the plain language of the claim imports, the court is not aided by, and has no need of aid from, such specification. *Rich v. Close*, 8 *Blatchf.* 41 ; 4 *Fish. Pat. Cas.* 279.

A patent covers only the devices which are claimed, although others are described by way of explaining them or illustrating the way in which they operate. *Wheeler v. McCormick*, 4 *Pat. Off. Gaz.* 692 ; 11 *Blatchf.* 334 ; 6 *Fish. Pat. Cas.* 551. S. P., *Couse v. Johnson*, 16 *Pat. Off. Gaz.* 719 ; 4 *Bann. & A. Pat. Cas.* 500.

Where a claim is not limited to a particular form of construction of device, and the specification does not assign as a peculiar merit or claim, any new result of a product of its conformation, such form cannot be considered as an essential part of the invention. *Couse v. Johnson*, *supra*.

Where a claim of the patent appears to be for a result, produced substantially "in the manner and for the purposes" described, the claim will be construed to be for the mechanism set forth in the specifications, by which the result is produced, and not for the result itself. The principle, of construing a claim for a result to be a claim for the means by which the result is produced, is applied to all cases where a result is claimed, whether there is any reference to the specifications in the claim or not. *Henderson v. Cleveland Co-operative Stove Co.*, 2 *Bann. & A. Pat. Cas.* 604.

Where a particular result is claimed by an inventor of an improvement, the patent protects only such result as a whole ; not each particular entering into it. *Huggins v. Hubby*, 3 *West. L. Month.* 347.

A patent claim must be construed in the light of the specifications ; and where the specifications describe the entire article, parts of the description cannot be separately considered, to show an infringement of one of the parts. *Evans v. Kelly*, 13 *Fed. Rep'r.* 903 ; 9 *Biss.* 251 ; 26 *Int. Rev. Rec.* 349 ; 23 *Pat. Off. Gaz.* 192 ; 5 *Bann. & A. Pat. Cas.* 71. See *Haselden v. Ogden*, 3 *Fish. Pat. Cas.* 378.

Where there is a slight change in a machine, by which a new result is brought about, and which might be the subject of a patent, courts do not feel inclined to extend the invention beyond the mere

change, although they may be inclined to sustain the patent ; but where something elementary has been discovered and constitutes fairly a part of the invention of the patentee, no other inventor or manufacturer ought to be permitted to use that elementary part without paying tribute to the first inventor or originator. *Cornell v. Downer, &c. Brewing Co.*, 7 *Biss.* 346 ; 11 *Pat. Off. Gaz.* 331 ; 2 *Bann. & A. Pat. Cas.* 514.

The claim in a patent cannot be enlarged by construction, even though it might have been made broader, in view of the invention described in the specifications and drawings. *Becker v. Hastings*, 22 *Fed. Rep'r*, 827 ; 28 *Pat. Off. Gaz.* 98. S. P., *Wyeth v. Stone*, 1 *Story*, 274.

A claim, in a patent for a new manufacture, of a coloring matter obtained "substantially in the manner set forth, or by any other method which will produce a like result," was construed as covering any method of treatment the equivalent of the process described, producing like results ; and chemical identity of an article produced by alleged infringers, *held, prima facie* sufficient proof of infringement by them. *Pickhardt v. Packard*, 22 *Fed. Rep'r*, 530 ; 20 *Pat. Off. Gaz.* 179. See *Knox v. Murtha*, 9 *Blatchf.* 205 ; 5 *Fish.* 176.

In the construction of claims in a patent, however careful the courts should be not to enlarge a claim, they may apply intelligently and fairly, for the purpose of ascertaining the actual meaning, every part of the specification to which it refers ; and may consider as embodied in the claim, whatever by fair interpretation is drawn into it from the other parts. Thus, where the form and proportions and arrangement and position of the elements of a combination are mentioned in the claim, it may be understood as referring to a combination of those elements when they are formed or proportioned or placed substantially as there described, and for the purpose there stated. *Fisk v. Hollander*, *MacArthur & M.* 355.

163. *Drawings, Models, &c.*

Models and drawings are a part of the letters-patent, and may be resorted to for clearer information respecting the invention described in the specification. *Hogg v. Emerson*, 6 *How.* 437, 435 ; aff'g 2 *Blatchf.* 1. Compare *Grant v. Mason*, 1 *L. Int. & Rev.* 22.

Drawings annexed and referred to in the specification constitute

a part thereof ; and they may be resorted to to aid the description, and to distinguish the thing patented from other things known before. *Earle v. Sawyer*, 4 *Mas.* 1 ; *Washburn v. Gould*, 3 *Story*, 122 ; 1 *West. L. J.* 465 ; 7 *L. Rep'r*, 276 ; *Knight v. Gavit*, *Mir. Pat. Off.* 153. S. P., *Hogg v. Emerson*, 11 *How.* 587, 606 ; 2 *Blatchf.* 1 ; *Howes v. Nute*, 4 *Fish. Pat. Cas.* 263 ; *Heinrich v. Luther*, 6 *McLean*, 345.

The question as to the sufficiency of a description must be determined, like a question of construction, from what is written, aided by the drawings, and, if need be, by the patent-office model. Particular passages in a description must not be separated from what precedes or follows them in the same connection ; but one part of the instrument must be compared with another, and the whole considered together, in order to determine whether it is incomplete and ambiguous, or sufficient to uphold the claim. If the drawings are clear, reference to them may be made in the written description, to aid in an understanding of the nature of the invention. *Howes v. Nute*, 4 *Cliff.* 173. See *Seymour v. Osborne*, 11 *Wall.* 516.

The drawing may be examined by the court in an infringement case to explain an ambiguity in the specification, but not to supply a part lacking. *Tinker v. Wilbers Eureka Mower, &c. Manuf. Co.*, 5 *Bann. & A. Pat. Cas.* 92 ; 1 *Fed. Rep'r*, 138 ; 9 *Rep'r*, 273 ; *Banker v. Bostwick*, 5 *Bann. & A. Pat. Cas.* 463.

When the invention patented consists of a combination of old elements to produce a new result, mere matters of adjustment of the individual elements are not limited or controlled by the drawings, unless, 1. They are expressly so limited by the specifications as well ; or, 2. Such limitation and control are essential to produce the result claimed. *Hamilton v. Ives*, 3 *Pat. Off. Gaz.* 30 ; 6 *Fish. Pat. Cas.* 244.

For the weight to be given to drawings filed with a patent issued prior to December 15, 1836, by virtue of the act of March, 1837, § 1 (5 Stat. 191), see *Emerson v. Hogg*, 2 *Blatchf.* 1 ; and *affirmance*, 6 *How.* 437 ; *Winans v. Schenectady & Troy R. R. Co.*, 2 *Blatchf.* 279, 298.

164. Referring to Application, &c

The original application for letters-patent (with its accompanying drawings and model), filed by an inventor, should possess great weight in showing what his invention really was, especially where

it remains unchanged for a considerable period, and is afterward amended so as to have a broader scope. But amendments embracing any material variation from the original application cannot be sustained on the original application, and should not be allowed; if they were, great injustice might be done to others who may have invented or used the same things in the meantime. *Railway Co. v. Sayles*, 97 *U. S.* 554.

Neither the correspondence between the commissioner of patents and the applicant nor the proceedings in the patent-office, pending an application, are admissible as evidence to enlarge, diminish, or vary the language of the claim of a patent. *Goodyear Dental Vulcanite Co. v. Gardiner*, 3 *Cliff.* 408; 5 *Pat. Off. Gaz.* 586; 4 *Fish. Pat. Cas.* 224.

In an action for infringement of a patent, letters of the plaintiff to the patent-office, containing his application for a patent, and inclosing a specification substantially agreeing with his patent afterward issued, and asserting his claim as inventor to the invention described, are properly admissible in evidence to show the existence of such facts. *Pettibone v. Derringer*, 4 *Wash.* 215. Ambiguity in a patent and specification may be explained by the affidavit annexed to the specification. *Ib.*

In interpreting the language of a patent, in order to know what construction the patentee himself placed upon it, recourse may be had to the files of the application, to ascertain what changes were made in the original specification and claims, and the significance of those changes as revealed by the history of the case. *Trader v. Messmore*, 7 *Pat. Off. Gaz.* 385; 1 *Bann. & A. Pat. Cas.* 639.

If the field of invention be bounded by prior patents, though referring to the objects of the patent in issue only by general terms known in the art to which they belong, to include them, the description of what the inventor undertook to cover must be construed in the light of their existence. *Parsons v. Colgate*, 15 *Fed. Rep'r*, 600; 24 *Pat. Off. Gaz.* 203.

165. Consulting Experts on Questions of Construction.

The opinion of experts cannot be received as to the construction of a patent. Experts may be examined as to the meaning of terms of art, on the principle of *cuique in sua arte credendum*; but not as to the construction of written instruments. *Corning v. Burden*,

15 *How.* 252, 270 ; *Winans v. New York & Erie R. R. Co.*, 21 *How.* 88, 100.

The established practice of taking testimony of experts on the diversity of the inventions embraced in two different patents, instead of requiring courts to compare the specifications and give the jury instructions on the question as one of law, does not trench upon the doctrine that the construction of written instruments is the province of the court alone: for it is not the construction of the instrument, but the character of the thing invented, which is sought in questions of identity and diversity of inventions. *Bischoff v. Wethered*, 9 *Wall.* 812.

Whether a patent is void for uncertainty or ambiguity in the description, is a matter of fact to be decided upon the evidence of experts. *Washburn v. Gould*, 3 *Story*, 122, 138 ; 7 *L. Rep'r*, 276 ; 1 *West. L. J.* 465

Two different translations of a phrase in a French patent for a firearm, equivalent to "breech-loading," were urged upon the court, supported by testimony of experts. The court adopted that which was more literal, which better accorded with the other parts of the instrument not involved in doubt, and was germane to the invention and more in harmony with the other language of the patent. *White v. Allen*, 2 *Cliff.* 224 ; 2 *Fish. Pat. Cas.* 440.

The mere opinion of an expert, that two pieces of machinery constructed to produce the same results and working out those results by means so nearly identical as to create a strong presumption of a common origin, are essentially different in mechanical structure and mode of operation, when he does not point out the particular differences or coincidences between the two, is not enough to determine the right to a preliminary injunction. *United States Annunciator, &c. Manuf. Co. v. Sanderson*, 3 *Blatchf.* 184.

166. *Application of Rules of Construction in peculiar cases.*

Patent granted to Goodwin, in 1876, for improvements in harvesters, was construed, as to its claim of a pivotal rock-shaft, and held to be restricted to the specific device claimed, and therefore not infringed by a different, although perhaps substantially equivalent device. *Goodwin v. Randolph*, 21 *Fed. Rep'r*, 575.

Patent granted to Lull and Porter, in 1854, for an improvement

in shutter hinges, was construed, and *held* to include in its claim, substantially two claims ; one for such of the described mechanism as is necessary to secure the described swinging and locking of the shutter, and the other for such of the described mechanism as is necessary to secure the result described as to strain on the spindle. The former claim was *held* infringed by a device which was a mere formal variation therefrom, having the same mode of operation. *Lull v. Clark*, 21 *Blatchf.* 95.

Patent granted to Adams, in 1869, for an improvement in the electro-deposition of nickel, was construed, with regard to the validity and extent of its claims, and *held* infringed by the use of a solution which, though not the same as that described by Adams, accomplished the same results by the same electro-chemical mode of operation, by the same process, with the absence of the same injurious elements. *United Nickel Co. v. Pendleton*, 21 *Blatchf.* 226.

A claim in a patent for a combination, the elements or parts of which were old, was construed, in connection with the state of the art, as limited substantially to the special character of parts and the particular organization described ; and *held*, not infringed by a machine differing from that described in the specifications in construction and organization, and also in mode of operation and the result produced. *Buzzell v. Andrews*, 25 *Fed. Rep'r*, 822 ; 34 *Pat. Off. Gaz.* 830.

Patent granted to Clark in 1877, for an improvement in lubricators, construed, and compared with the device for which a patent was granted to Swift, in 1884. That device was *held* not an infringement of the patent to Clark ; the doctrine of equivalents not being applicable to the case, and the difference in details of construction of the Swift device, from the earlier patents, appearing to be so great that it might fairly be deemed a patentable invention. *Jenks v. Swift*, 25 *Fed. Rep'r*, 722 ; 34 *Pat. Off. Gaz.* 609.

The claim of the original patent granted to Garner, in 1869, to a circular-shaped harrow tooth "constructed and used in the manner and for the purposes herein specified," construed, with the drawings and specifications referred to, and *held* to include within its grant the exclusive right not only to harrow teeth made literally according to the drawings and descriptions of the specifications, but also all similar harrow teeth fastened at one end to the bars or frame of the harrow, and curved so as to form an arch, above the plane of the bars or frame of the harrow, and descend between the bars, in a curve, to the ground, their points inclining forward ; and

therefore to cover everything embraced in the seven claims of the reissued patent for the same invention granted in 1880. *Reed v. Chase*, 25 *Fed. Rep'r*, 94 ; 33 *Pat. Off. Gaz.* 996.

Patents issued to Black, in 1870, and to Garland in 1871, for improvements in automatic relief valves, were construed, with reference to prior inventions, and *held* to be limited to the specific mechanisms described in the patents, or their equivalents ; and that, so limited, neither patent was infringed by mechanism substantially different from that described in it. *Shaw Relief Co. v. City of New Bedford*, 26 *Fed. Rep'r*, 331.

Patent issued to Martin, in 1877, for improvement in furniture casters, was construed, with reference to the prior state of the art. It was *held* to be limited to certain details of construction, and therefore was not infringed in the particular case. It appeared that the combination patented accomplished no new result in mechanics, and differed from previous known combinations designed for the same and similar purposes, only in the construction of one or two of the parts, whereby perhaps a better but certainly not a different kind of result was accomplished than had been before effected. *Phoenix Caster Co. v. Spiegel*, 26 *Fed. Rep'r*, 272.

A patentee who accepts a narrow claim can not be allowed to extend it by construction so as to cover devices not within its terms. *Rocmer v. Peddie*, 27 *Fed. Rep'r*, 702.

167. *What constitutes Infringement, generally.*

Inventions pertaining to machines may be divided into four classes. 1. Where the invention embraces the entire machine. 2. Where the invention embraces one or more of the elements of the machine, but not the entire machine. 3. Where the invention embraces both a new element and a combination of elements previously known. 4. Where all the elements are old, and a new combination, producing a new result, is made out of them. *Union Sugar Refinery v. Mathiessen*, 3 *Cl.* 639 ; 2 *Fish. Pat. Cas.* 600 ; *Sanford, v. Merrimac Hat Co.*, 10 *Pat. Off. Gaz.* 466.

A person is an infringer of a patent of the first class who, without license, makes any portion of the machine ; of the second when the part new and patented is made or used ; of the third, when the new element or new combination is used ; of the fourth, when the patented combination is pirated. *Union Sugar Refinery*

v. Mathiessen, supra. See *Haseldean v. Ogden*, 3 *Fish. Pat. Cas.* 378.

There may be an infringement by the use of the patented article for a purpose not mentioned in the patent and for which it was not intended. *Zinn v. Weiss*, 7 *Fed. Rep'r*, 914.

A change in the mode of a device, where all its benefits are secured thereby, is an infringement. *Union Paper Bag Co. v. Nixon*, 9 *Pat. Off. Gaz.* 691 ; 1 *Flippin*, 491 ; 2 *Bann. & A. Pat. Cas.* 240.

Every manufacture for sale abroad, followed by actual sale, of a machine on which an American patent has been issued, is an infringement of the American patentee's rights of property and exclusive use. *Ketchum Harvester Co. v. Johnson Harvester Co.*, 8 *Fed. Rep'r*, 586 ; 19 *Blatchf.* 367 ; 12 *Rep'r*, 553.

If a machine is so constructed as to conform to the description in the patent except as to one particular, but with the design that this effect shall be attained by the action or wearing of the parts in use, there is an infringement. *American Diamond Rock-boring Co. v. Sullivan Machine Co.*, 14 *Blatchf.* 119 ; 2 *Bann. & A. Pat. Cas.* 522.

Where a party sells an article to persons who intend to use it in the combination claimed in the patent, and it is advertised and sold for that very purpose, such sale is an infringement, although the manufacture and sale would not, *per se*, be an infringement. *Bowker v. Dows*, 15 *Pat. Off. Gaz.* 510 ; 3 *Bann. & A. Pat. Cas.* 518. Thus the making and sale by defendants of an article, which, of necessity, to their knowledge, was to be used for the purpose of infringing the complainant's patent was *held* to render them liable as infringers. *Travers v. Beyer*, 26 *Fed. Rep'r*, 450.

It is not necessary to constitute an infringement that a man should work by the specification contained in the patent. He might not even know that there was such a patent, and still infringe it. *Matthews v. Skates*, 1 *Fish. Pat. Cas.* 602 ; *Parker v. Haworth*, 14 *McLean*, 370.

Infringement of a patent can occur only by actually making, using or selling the patented device. Advertising it for sale, though not of itself a violation of an injunction restraining sales, is yet strong evidence of an intent to violate ; but to warrant convicting a defendant of selling in contempt of court, a clear case must be made out. *Allis v. Stowell*, 19 *Pat. Off. Gaz.* 727.

A machine is not infringed if the same result is produced by

the defendant by instrumentalities other than those which were claimed in the patent. *Toohey v. Harding*, 1 *Fed. Rep'r*, 174 ; 4 *Hughes*, 253 ; 5 *Bann. & A. Pat. Cas.* 195 ; *Dittmar v. Rix*, 1 *Fed. Rep'r*, 342 ; 17 *Pat. Off. Gaz.* 973 ; 5 *Bann. & A. Pat. Cas.* 240 ; *Hall v. Stern*, 15 *Fed. Rep'r*, 463 ; 25 *Pat. Off. Gaz.* 206 ; *Rich v. Lippincott*, 2 *Pittsb.* 38.

Use of old devices is not an infringement, although they are equivalents for those in the patent. *Dennis v. Cross*, 6 *Fish. Pat. Cas.* 138 ; 3 *Biss.* 389.

The fact that the infringement is not perfect because the machine is imperfect does not exonerate defendant ; it is still an infringement. *Union Paper Box Co. v. Binney*, 5 *Fish. Pat. Cas.* 106.

If changes of form or arrangement introduce a new principle, power, or mode of operation producing a new kind of result, the patent is not infringed. *Many v. Sizer*, 1 *Fish. Pat. Cas.* 17.

Dividing an invention and making two operations where only one is necessary is an infringement. *Baldwin v. Bernard*, 5 *Fish. Pat. Cas.* 75 ; 9 *Blatchf.* 509 n. ; 2 *Pat. Off. Gaz.* 320.

Where a plaintiff claims several distinct and independent improvements in the same machine, and procures a patent for them in the aggregate, he is entitled to recover against any person who shall use any one of the improvements so patented, notwithstanding there has been no violation of the other improvements. *Moody v. Fiske*, 2 *Mas.* 112.

A party may sue for an infringement of any one of the separate and distinct inventions that may be covered by his patent. *McComb v. Ernest*, 1 *Woods*, 195.

If a patent is for two distinct machines conducing to a common end, to use either one is an infringement. *Wyeth v. Stone*, 1 *Story*, 273 ; 4 *L. Rep'r*, 54 ; *Emerson v. Hogg*, 2 *Blatchf.* 1 ; and see *affirmance*, 6 *How.* 437, 485.

It is no infringement of a patent embracing an old invention, to imitate the old part, so long as there is no interference with the new. *Simon v. Neumann*, 20 *Fed. Rep'r*, 196.

Where the machine described and claimed in complainant's patent, and respondents' machines, each contained four elements operating together to produce the same result, although formal differences existed between certain of the elements of the two, yet, the same not being substantially different in object or operation, it was held that the respondents' machine was an infringement of

complainant's patent. *Storrs v. Howe*, 4 *Cliff.* 388 ; 10 *Pat. Off. Gaz.* 421 ; 2 *Bann. & A. Pat. Cas.* 420.

Where a portion of the structure was useless ; was not sold to be used, and was not used in any infringing structure, the patent is not infringed in making and selling it ; an article is not an infringement, unless it is to be used in the manner pointed out in the patent. *Campbell v. Kavanaugh*, 11 *Ibid. Rep'r.*, 83 ; 20 *Blatchf.* 256.

Where a patentee claims three distinct improvements in the same patent, he must show himself entitled to each, to sustain an action for an infringement. *Heinrich v. Luther*, 6 *McLean*, 345.

If a machine in its mechanical operation and effect is the same as the patentee's, a difference in cost, adjustability or other peculiarity in construction, will not prevent its being an infringement. *Poss v. Hubert*, 2 *Fish. Pat. Cas.* 31 ; 1 *Biss.* 21.

If the result is the same in kind it is not necessary that it be the same in degree. *Whipple v. Middlesex Co.*, 4 *Fish. Pat. Cas.* 41.

A substitute for the original invention, or an old instrument used to accomplish a new result, is no infringement, unless the defendant uses substantially the same instrument in substantially the same manner as that set forth in the patent. *Johnson v. Root*, 1 *Fish. Pat. Cas.* 351.

A patent depending on a novel use of water is infringed by a similar use of water in less quantity. *Roberts v. Roter*, 5 *Fish. Pat. Cas.* 529.

Two patents may both be valid where the second is an improvement on the first ; and, if the second includes the first, neither of the two owners can lawfully use the invention of the other without such other's consent. *Star Salt Castor Co. v. Crossman*, 4 *Cliff.* 508 ; 3 *Bann. & A. Pat. Cas.* 281.

The use of all the elements of a patented improvement, with an addition which does not take the place of the device patented, is as much an infringement as the use without such addition. *Roemer v. Simon*, 28 *Pat. Off. Gaz.* 194. And see *Williams v. B. & O. R. Co.*, 16 *Pat. Off. Gaz.* 905 ; 17 *Blatchf.* 21 ; 4 *Bann. & A. Pat. Cas.* 441.

Embodying a patentee's invention in defendant's machinery, however it may be combined with other machinery, is an appropriation, the same as if it were used alone and separate from those connections. *Sickels v. Borden*, 3 *Blatchf.* 535 ; *Pitts v. Wemple*, 6 *McLean*, 558 ; *Foster v. Moore*, 1 *Curt.* 279 ; *Johnson v. Root*, 1

Fish. Pat. Cas. 351 ; *Mallory v. White*, 4 *Fish.* 628 ; 8 *Blatchf.* 552 ; *Hoffheins v. Brandt*, 3 *Fish. Pat. Cas.* 218 ; *Waterbury Brass Co. v. N. Y. Brass Co.*, 3 *Fish. Pat. Cas.* 43 ; *Flint v. Roberts*, 4 *Bann. & A. Pat. Cas.* 165.

The general principle is that, where the claim of a patent is limited to a particular product when produced in a particular way, there is no infringement unless the article described is produced, by employment of substantially the same means to accomplish the result. This principle was applied, in a case of a new article of manufacture in the form of a cast copper tube or cylinder free from blow-holes and other similar defects. *Adams v. Bridgewater Iron Co.*, 26 *Fed. Rep'r*, 324 ; 34 *Pat. Off. Gaz.* 1045.

Where a modification displaces and supersedes the patented invention it is not an infringement. *Whipple v. Middlesex Co.*, 4 *Fish. Pat. Cas.* 41.

Unless the same result is produced by the same means, there is no infringement of the invention ; hence in an action for infringement on letters patent for a lock, where the defendant does not use the same combination, and employs no device as an equivalent and substitute for the omitted element, he will not be liable as an infringer. *Yale Lock Manuf. Co. v. Sargent*, 117 *U. S.* 373.

An improvement on a patent may infringe the original patent. *Tate v. Thomas*, 27 *Fed. Rep'r*, 306.

Where a patentable improvement on a device contains all the essentials of the original patent, it infringes. *Hoff v. Iron-Clad Manuf. Co.*, 27 *Fed. Rep'r*, 307.

Results the same in kind, though not the same in degree, constitute an infringement. *May v. County of Fond du Lac*, 27 *Fed. Rep'r*, 691.

Embodiments of the new idea and similarity of mechanical construction are what constitutes infringement. *May v. County of Fond du Lac*, 27 *Fed. Rep'r*, 691.

Where a party avails himself of the invention of another without such variation as constitutes a discovery, there is an infringement. *May v. County of Fond du Lac*, 27 *Fed. Rep'r*, 691.

168. *Motive.*

To constitute an infringement for which an action will lie, the making of a machine must be with intent to infringe the patent

right, and deprive the owner of the lawful rewards of his discovery. *Sawin v. Guild*, 1 *Gall.* 485.

The question of infringement is one irrespective of motive. The defendant may have infringed without intending, or even knowing it; but he is no less the infringer. *Parker v. Hulme*, 1 *Fish. Pat. Cas.* 44; 7 *West. L. J.* 417.

The making of a patented machine, fit for use, and with a design to use it for profit, in violation of the patent right, is an infringement. *Whittemore v. Cutter*, 1 *Gall.* 429; 1 *Robb.* 28; *Bloomer v. Gilpin*, 4 *Fish. Pat. Cas.* 50.

The making of a patented machine merely for philosophic experiments, or for the purpose of ascertaining the sufficiency of the machine to produce its described effects, is not an infringement of the right. *Whittemore v. Cutter*, 1 *Gall.* 429; *Poppenhusen v. Falke*, 2 *Fish. Pat. Cas.* 181; 5 *Blatchf.* 493.

Whoever erects or uses a patented machine does it at his peril. He takes upon himself all the chances of the patent being originally valid; or being afterward made so by a surrender and the grant of a new one, which may cure all defects. *Ames v. Howard*, 1 *Summ.* 482. And see *Evans v. Weiss*, 2 *Wash.* 342; 3 *Am. L. J.* 180; *McClurg v. Kingsland*, 1 *How.* 202; 17 *Pat.* 228; *Simpson v. Westchester R. R. Co.*, 4 *How.* 380; *Simpson v. Mad River R. R. Co.*, 6 *McLean*, 603.

The keeper of a hotel who uses a patented hotel register without right, is liable as an infringer, and not the less so because he did not intend to violate the rights of the patentee, and desisted when notified. *Hawes v. Washburne*, 5 *Pat. Off. Gaz.* 491.

One selling a machine to be used for the purpose of infringing a patented combination is liable as an infringer himself. *Holly v. Vergennes Machine Co.*, 4 *Fed. Rep'r.* 74; 18 *Blatchf.* 327; 18 *Pat. Off. Gaz.* 1177.

169. *Identity of Devices.*

To constitute identity of invention, and therefore infringement, not only must the result obtained be the same, but in case of a combination of known elements, the elements combined must be the same, and combined in the same way, so that each element shall perform the same function; provided, however, that the differences alleged are not merely colorable, according to the rule forbidding

the use of known equivalents. *Electric R. Signal Co. v. Hall R. Signal Co.*, 114 *U. S.* 87.

If two machines, having the same mode of operation, do the same work in substantially the same way and accomplish substantially the same result, they are the same, though differing in form, shape, or name. *Union Sugar Refinery v. Mathiesen*, 3 *Cliff.* 639; 2 *Fish. Pat. Cas.* 600. *S. P., Alden v. Dewey*, 1 *Story*, 336; 3 *L. Rep'r*, 333; *Dixon v. Moyer*, 4 *Wash.* 68; *Rich v. Lippincott*, 1 *Pittsb.* 31; 2 *Fish. Pat. Cas.* 1; *Spring v. Domestic Sewing Machine Co.*, 9 *Fed. Rep'r*, 505; 21 *Pat. Off. Gaz.* 633.

Where the end to be accomplished by two devices is the same, and the substantial means to accomplish the end are the same, the two devices are identical, though one may accomplish the end more effectually than the other. *Inlay v. Norwich & Worcester R. R. Co.*, 4 *Blatchf.* 227; 1 *Fish. Pat. Cas.* 340.

If there is infringement, a person of competent skill will be able to make a machine like defendants from the description given in plaintiff's patent. *Schneider v. Lovell*, 22 *Pat. Off. Gaz.* 499; 10 *Fed. Rep'r*, 666; *Many v. Sizer*, 1 *Fish. Pat. Cas.* 17.

If mechanical differences exist, but the two products and the general mode of construction are the same, as would appear by a comparison of the two manufactures, the court will hold that infringement is proved. This doctrine applied in a suit for infringement of patent for improvement in billiard tables. *Collender v. Came*, 4 *Cliff.* 393; 10 *Pat. Off. Gaz.* 467; 2 *Bann. & A. Pat. Cas.* 412.

Where, in mechanics, one device does a particular thing, or accomplishes a particular result, every other known device which skilled workmen know will do the same thing or produce the same result is a known mechanical substitute (*Carter v. Baker*, 1 *Sawyer*, 512; 4 *Fish. Pat. Cas.* 404); *e. g.*, a handle used in place of a lever to produce the same result. *Brown v. Guild*, 23 *Wall.* 181. See also *Cahoon v. Ring*, 1 *Fish. Pat. Cas.* 397; 1 *Cliff.* 592; *Smith v. Downing*, 1 *Fish. Pat. Cas.* 64; *Johnson v. Root*, 1 *Fish. Pat. Cas.* 351; *Burden v. Corning*, 2 *Fish. Pat. Cas.* 477. Mechanical equivalents are not those merely which produce the same result. *Smith v. Marshall*, 10 *Pat. Off. Gaz.* 375; 2 *Bann. & Ard.* 371.

A person, to invoke the doctrine of equivalents, must be the first inventor of the principle and not only of the machine which carries it out. *Singer v. Walmsley*, 1 *Fish. Pat. Cas.* 558. As to the term equivalents in chemicals, see *Tyler v. Boston*, 7 *Wall.* 327. Known

equivalents to ingredients in a composition are covered by a patent for such composition. *Matthews v. Skates*, 1 *Fish. Pat. Cas.* 602; *Woodward v. Morrison*, 5 *Fish. Pat. Cas.* 357; 1 *Holmes*, 124; 2 *Pat. Off. Gaz.* 120.

It is an infringement of a patented machine to make and use a machine which operates, or may operate if the owner is disposed to use it so, in the manner pointed out by the patent. *Holbrook v. Small*, 10 *Pat. Off. Gaz.* 508.

Where a device effects the same results in substantially the same way, it is an infringement on plaintiff's patent, although it presents great simplicity and cheapness as compared to complainant's patent. *Eyory v. Burt*, 15 *Fed. Rep'r*, 112; 23 *Pat. Off. Gaz.* 312. That it was not known at the date of plaintiff's invention, is immaterial. *Potter v. Stewart*, 18 *Blatchf.* 561; 19 *Pat. Off. Gaz.* 997; 7 *Fed. Rep'r*, 215.

Where a greater number of persons have to be employed in the operation of a machine formerly in use than in a patented machine, this tends to prove that the machines are not alike. *Coupe v. Weatherhead*, 16 *Fed. Rep'r*, 673; 23 *Pat. Off. Gaz.* 1927.

It is not necessary, to continue an infringement, that the whole invention be taken. *Fetter v. Newhall*, 17 *Fed. Rep'r*, 841; 25 *Pat. Off. Gaz.* 502; 16 *Rep'r*, 360; 21 *Blatchf.* 415.

Where a patented machine is capable of performing several functions, as Blanchard's machine for turning irregular forms, and a person constructs a machine to perform but one of such functions, as the turning of wagon spokes, it is an infringement. *Blanchard v. Beers*, 2 *Blatchf.* 411.

In order to constitute an infringement, it is not necessary that the arrangement and combination of the party charged with the infringement should be the same to the eye as the patented invention. If they embody the ideas of the patentee, and the machinery of the defendant operates by such adoption and appropriation, then, though the arrangement may be apparently different, in reality and in judgment of law an infringement exists. *Smith v. Higgins*, 1 *Fish. Pat. Cas.* 537.

Where the defendant in an action for infringement uses substantially the same devices as plaintiff, and produces the same result and certain other results differing from those produced by plaintiff, it will still be considered that the patent of plaintiff has been infringed and that defendant appropriates the invention of

complainant. *New York Rubber Co. v. Chaskel*, 9 *Pat. Off. Gaz.* 923.

The true test of identity between two designs is their sameness of effect upon the eye of an ordinary observer, bringing to the examination of the designs that degree of observation which men of ordinary intelligence give. In what cases the court may make the comparison. *Jennings v. Kibbe*, 10 *Fed. Rep'r*, 669 ; 20 *Blatchf.* 353 ; 22 *Pat. Off. Gaz.* 331.

To constitute an infringement there must be similarity of design, and substantial identity of purpose and result. Where similarity of design exists and a similar result is attained, in substantially the same way, by the use of a device which, although intended to operate in a different way, did not so operate, such use will nevertheless be an infringement. *Henderson v. Co-operative Stove Co.*, 2 *Bann. & A. Pat. Cas.* 604.

It must always be very much a matter of judgment to the eye, in the examination of two machines, and in observing their mode of operation, whether the one, in the whole, or in any of its parts, is a mere colorable or formal alteration of the other. If a patentee has invented a combination of two or more old things, so as to produce a new and useful result, he has a right to treat as infringers all who have used his invention, in order to accomplish something more or better, when, without the aid of such invention, it could not be effected. *Sayles v. Chicago & North-western R. R. Co.*, 4 *Fish. Pat. Cas.* 584 ; but see reversal, 97 *U. S.* 554.

A patent cannot be defeated by dividing a patented device into two parts, which, when combined, produce the same result in substantially the same way. *Strobridge v. Lindsay*, 6 *Fed. Rep'r*, 510 ; 19 *Pat. Off. Gaz.* 1285 ; 11 *Rep'r*, 734.

A patent for the application of heat to a particular purpose is infringed by the use of the same process for the same purpose, and with the same result, although a higher degree of heat is used. *Cary v. Wolff*, 24 *Fed. Rep'r*, 139 ; 32 *Pat. Off. Gaz.* 257 ; *Cary v. Lovell Manuf. Co.*, 24 *Fed. Rep'r*, 141 ; 32 *Pat. Off. Gaz.* 1009 ; *Cary v. Domestic Spring Bed Co.*, 34 *Pat. Off. Gaz.* 1158.

A patent for a fabric is infringed by the use, without license, of the fabric, although less is used than the patentee uses in the manufacture of similar articles. *Celluloid Manuf. Co. v. Chlorithion Collar, &c. Co.*, 23 *Fed. Rep'r*, 397 ; 31 *Pat. Off. Gaz.* 519. Adhered to on rehearing, 25 *Id.* 482.

Where contrivances or devices are substantially identical, there

is an infringement *Yale Lock Manuf. Co. v. Sargent*, 117 *U. S.* 536.

170. *Identity in Principle, sufficient.*

A difference in mechanism, such that the same result is produced in a different way, is a difference in principle. *Silsby v. Foote*, 14 *How.* 218 ; 1 *Blatchf.* 445.

To constitute an infringement, the thing used by the defendant must be such as substantially to embody the patentee's mode of operation, and thereby attain the same kind of result as was reached by his invention. It is not necessary that the defendant should employ the plaintiff's invention to as good advantage as he employed it, or that the result should be precisely the same in degree ; but it must be the same in kind. But, generally, where a patentee describes a machine, and then claims it as described, to copy the principle, or mode of operation described, is an infringement, however unlike the original the copy may be. *Winans v. Denmead*, 15 *How.* 330.

That is a substantial identity which comprehends the application of the principle of the invention. If a defendant's device merely adopts a different mode of carrying the same principle into effect, and the principle admits a variety of forms, there is an identity of principle, although not an identity of mode. *Page v. Ferry*, 1 *Fish. Pat. Cas.* 298.

An improvement in the principle of a machine is no invasion of the rights of the inventor and patentee of such machine. The rule is otherwise when it is only an improvement in the form. *Reutgen v. Kanowrs*, 1 *Wash.* 168 ; *Park v. Little*, 3 *Wash.* 196 ; *Smith v. Pearce*, 2 *McLean*, 176.

It is generally true that when a patentee describes a machine, and then claims it as described, he covers not only the precise forms he has described, but all other forms which embody his invention ; and to copy a principle or mode of operation described, is an infringement, although such copy is totally unlike the original in form or proportions. *Grier v. Castle*, 17 *Fed. Rep'r*, 523 ; 24 *Pat. Off. Gaz.* 1176.

It is no defense to an infringement that the machine or product is not as good as the patentee's, if it operates or is produced in substantially the same way (*Roberts v. Harnden*, 2 *Cliff.* 500); nor that defendant's machine is superior to the patentee's, unless it is

shown that there is a substantial difference. *Alden v. Dewey*, 1 *Story*, 336 ; 3 *L. Rep'r*, 383.

If the principle on which the machinery works is the same, and the effect is similar in both, the machines are identical in law. *Brooks v. Bicknell*, 3 *McLean*, 250 ; 1 *West. L. J.* 150.

To establish an infringement, it is not necessary that the structure or machine used by the defendant should be the same in appearance, form or proportions, as that invented and patented by the plaintiff. If the operative principles of the two machines be the same, the substantial identity contemplated by the patent law is established. *Parker v. Stiles*, 5 *McLean*, 44 ; 7 *West. L. J.* 168.

A well known principle or truth of natural science, as well as a newly discovered one, is patentable to the first applicant of it in the useful arts ; but having once been made known and applied, any subsequent application must, to insure a patent, rest upon new machinery or combination of machinery, and not upon the principle the novelty of which has been exhausted. Even though the application of the principle, in prior patents, was not so perfectly made as it might have been or as it would be made by using the forms of machinery suggested in the specifications of an applicant for a new patent, this does not entitle the latter to a patent for the principle. *Re Henry*, 1 *MacArthur Pat. Cas.* 467.

Patent issued to Nobel, in 1865, relating to use of nitro-glycerine as a substitute for gunpowder, was *held* not to cover the use of a capsule or percussion cap, operating by its detonation, as a means of exploding nitro-glycerine ; the principle of the patent being explosion effected by heat and pressure. *Atlantic Giant Powder Co. v. Hulings*, 21 *Fed. Rep'r*, 519.

Two devices or inventions infringe if they are substantially alike. In determining the question of infringement, the court or jury are not to judge about similarities or differences by the names of things, but are to look at the machines or their several devices or elements in the light of what they do or what office or function they perform, and to find that one thing is substantially the same as the other, if it performs substantially the same function in substantially the same way, to obtain the same result ; and should always bear in mind that devices in a patented machine are "different" in the sense of the patent law when they perform different functions, or in a different way, or produce a substantially different result. *Cantrell v. Wallick*, 117 *U. S.* 689.

171. *What is the "Principle" of a Machine.*

In an action for an infringement, the first question for consideration is whether the machine used by the defendant is substantially, in its principles and mode of operation, like the plaintiff's. If so, it is an infringement to use it. *Odiorne v. Winkley*, 2 *Gall.* 51 ; *Howe v. Abbott*, 2 *Story*, 190 ; *Grant v. Mason*, 1 *L. Int. & Rev.* 22 ; *Parker v. Haworth*, 4 *McLean*, 370.

What constitutes form, and what principle, is often a nice question to decide. The safest guide to accuracy in making the distinction is to ascertain what is the result to be obtained by the discovery ; and whatever is essential to that object, independent of the mere form and proportions of the thing used for the purpose, may generally, if not universally, be considered as the principle of the invention. *Treadwell v. Bladen*, 4 *Wash.* 703, 706 ; *Gray v. James*, *Pet. Ct. Ct.* 394 ; *Olcott v. Hawkins*, 2 *Am. L. J. N. S.* 319 ; *Inlay v. Railroad Co.*, 1 *Fish. Pat. Cas.* 340 ; 4 *Blatchf.* 227.

Principle, in machines, is not a new mechanical power—none such have been discovered for centuries. That is a principle which applies, modifies or combines mechanical powers to produce a certain result. *Smith v. Pearce*, 2 *McLean*, 176.

Where two machines or things are made to operate substantially in the same way, so as to produce the same result, they are considered the same in principle. Thus, where any of the mechanical powers, the lever, screw, wheel, &c., are used to accomplish certain purposes, the same powers being used, the fact that they are used in a somewhat different form, to do the same thing, will not constitute a difference in principle. Whether the mechanical instruments be larger or smaller, whether their action be horizontal or vertical, the principle is the same. *Roberts v. Ward*, 4 *McLean*, 565.

The principle of a machine is the particular means of producing a given result by a mechanical contrivance (*Parker v. Stiles*, 5 *McLean*, 44, 63 ; 7 *West. L. J.* 168 ; *Brooks v. Jenkins*, 3 *McLean*, 432 ; 2 *West. L. J.* 11), independent of mere form. *Olcott v. Hawkins*, 2 *Am. L. J. N. S.* 317. And see *Le Roy v. Tatham*, 22 *How.* 132 ; *Tatham v. LeRoy*, 2 *Blatchf.* 474 ; 7 *West. L. J.* 431.

The machinery or apparatus by which a principle is applied to practical uses is not of the essence of the invention, when a patent

is sought for the process ; and lack of novelty or utility in the mere arrangement of machinery described in the specification is no objection to such an application. *Re Henry*, 1 *MacArthur Pat. Cas* 467.

172. Formal Changes.

A change in or variation from the plaintiff's machine, which affects merely its form or proportions, &c., or involves merely the substitution of one mechanical equivalent for another, does not constitute such a change as will relieve the defendant from the charge of infringement. *Winans v. Denmead*, 15 *How.* 330, 342 ; *Wyeth v. Stone*, 1 *Story*, 273 ; 4 *L. Rep'r*, 54 ; *Gorham v. Mixer*, 1 *Am. L. J. N. S.* 543 ; 19 *Hunt Mer. Mag.* 296 ; 5 *West. L. J.* 525 ; *Sargent v. Larned*, 2 *Curt.* 310 ; *Miller's Falls Co. v. Backus*, 17 *Pat. Off. Gaz.* 852 ; 5 *Bann. & A. Pat. Cas.* 53 ; *McWilliams Manuf. Co. v. Blundell*, 11 *Fed. Rep'r*, 419 ; 22 *Pat. Off. Gaz.* 177 ; *Blanchard v. Beers*, 2 *Blatchf.* 411 ; *American Pin Co. v. Oakville Co.*, 3 *Blatchf.* 190 ; 3 *Am. L. Reg.* 136 ; *Sickels v. Borden*, 3 *Blatchf.* 535 ; *Poppenhusen v. Falke*, 5 *Wash.* 46 ; *Dixon v. Moyer*, 4 *Wash.* 68.

Where one particular geometrical form alone is capable of embodying the invention, that form must be used, to amount to an infringement. Otherwise, where that form is the best, but other forms may and do embody the invention. *Winans v. Denmead*, 15 *How.* 330.

Form, when of the essence of an invention, is necessarily material ; and, if it be inseparable from the successful operation of the machine, the attainment of the same object by a machine different in form is not an infringement. *Werner v. King*, 96 *U. S.* 219.

Patent issued to Tate, in 1871, for an improvement in quilting machines, was held to be infringed by a machine involving a change by which no new result was obtained, although an aggregation of results was accomplished. *Tate v. Thomas*, 22 *Fed. Rep'r*, 660 ; 30 *Pat. Off. Gaz.* 345.

Except where form is of the essence of the invention, it has but little weight in the decision of an issue whether two patents have been issued for the same invention. The correct rule is, that in determining the question of infringement, the court or jury, as the case may be, are not to judge about similarities or differences

by the name of things, but are to look at the machines or their several devices or elements in the light of what they do, or what office or function they perform, and how they perform it, and to find that one thing is substantially the same as another, if it performs substantially the same function in substantially the same way, to obtain the same result ; always bearing in mind that devices in a patented machine are "different" in the sense of the patent law when they perform different functions, or in a different way, or produce a substantially different result. *Machine Co. v. Murphy*, 97 *U. S.* 120.

A formal change in an important part of a machine, requiring a modification of other parts to meet the change, is an infringement. *Union P. B. M. Co. v. P. & U. Co.*, 15 *Pat. Off. Gaz.* 423 ; 15 *Blatchf.* 160 ; 3 *Bann. & A. Pat. Cas.* 403.

Where a patent extends only to the form or parts of the machine as set out, and made of any kind of materials, or saying nothing as to materials, the right would be violated by a machine of like form, as the form would be the only matter patented. But if the patentee chooses to go further, and cover the material of which a part of his machine is made, he entirely endangers his right to prosecute when a different and inferior material is employed, and especially one rejected by himself. *Aiken v. Bemis*, 3 *Woodb. & M.* 348.

Though, as a general rule, a patent only covers the improvement precisely described, and is not violated unless the defendant make use of the precise thing described in the patent, yet if the imitation be so nearly exact as to satisfy the jury that the imitator attempted to copy the model, and to make some almost imperceptible variation for the purpose of evading the right of the patentee, this will be considered a fraud upon the law, and such slight variation will be disregarded. *Davis v. Palmer*, 2 *Brock. Marsh.* 298.

Where the differences are merely in the form and not in the substance, and defendant's machine really shows the various parts described in the complainant's patent ; or where the various parts of defendant's machine exhibit mechanical parts equivalent to those in complainant's machine, and producing the same result, an infringement is established. *Graham v. Geneva Lake Crawford Manuf. Co.*, 11 *Fed. Rep'r*, 138 ; 21 *Pat. Off. Gaz.* 1536.

The use of a patented device, with all its beneficial results, is an infringement of the patent, notwithstanding a mechanical change in the form and arrangement of the parts, by which an effect addi-

tional to the one previously produced is obtained. *Hartford Woven Wire-Mattress Co. v. Peerless Wire-Mattress Co.*, 23 *Fed. Rep'r*, 587.

A patent for a machine is infringed by another machine which does the same work, in the same manner, and by the same means, although there are structural differences in parts of the infringing machine, and the manner of using it is different. *Sewing Machine Co. v. Frame*, 24 *Fed. Rep'r*, 596; 28 *Pat. Off. Gaz.* 96.

A patent for a new manufacture was *held* to be infringed by manufacturing a similar article with a change in the method employed, which, while it might be an improvement upon the patent or upon the specific arrangements therein detailed, was merely a change in construction. *Reed v. Street*, 34 *Pat. Off. Gaz.* 339.

A patent for an improvement in apple-paring machines consisted in so attaching the knife-block to the rod which moved it as to allow the knife-block to rotate round the rod at right angles, to accommodate itself to any irregularities in the surface of the fruit. The defendants, instead of making the knife movable in the rod, made the rod movable in its socket, but the knife-block had the same motion. This was *held* only a change of form, and therefore an infringement. *Sargent v. Larned*, 2 *Curt.* 346.

A change in the size of a machine, making it larger or smaller, while its mode of operation is not improved or affected, is not a patentable change; and when there is nothing in the patent as to the size of the machines to be made under it, the patentee has a right to make a machine just as large or just as small as he chooses under the specification of his patent. *Montross v. Bullard*, 27 *Fed. Rep'r*, 64.

Simple difference in size, form and degree does not escape the charge of infringement. *Armus v. Alden*, 27 *Fed. Rep'r*, 684.

Where two devices are essentially similar in construction of a particular element thereof, with a slight and immaterial variation in the method of attachment, but perform the same functions in each, there is an infringement. *Thayer v. Spaulding*, 27 *Fed. Rep'r*, 66.

173. *Nature and Measure of the Protection accorded to patented Process or Product.*

A person who, after a patent issued for a process, discovers a new mode of carrying out the process, and obtains letters patent

therefor, is not entitled to use the process without the consent of the prior patentee. *Tilghman v. Proctor*, 102 *U. S.* 707.

Unauthorized making an article according to a patented process, or selling it, is an infringement. *Bridgeport Wood Finishing Co. v. Hooper*, 5 *Fed. Rep'r*, 63 ; 18 *Blatchf.* 459 ; 20 *Pat. Off. Gaz.* 156.

A patent for a new manufacture is infringed by the manufacture of the new product by any process whatever. *Badische Anilin, &c. Fabrik v. Hamilton Manuf. Co.*, 13 *Pat. Off. Gaz.* 273 ; 3 *Bann. & A. Pat. Cas.* 235.

A patent for "ornamenting bracelets and other articles of jewelry" was *held* to be infringed by using the process on buttons. *Royce v. Fifield*, 18 *Fed. Rep'r*, 262.

A patent containing two claims,—one for a certain process set forth and the other for the compound made by the process,—is not infringed by the manufacture of a similar compound not made by the patented process. *Dittmar v. Rix*, 1 *Fed. Rep'r*, 342 ; 17 *Pat. Off. Gaz.* 973 ; 5 *Bann. & A. Pat. Cas.* 240.

In a patent for a process, every successive step enumerated in the claim must be regarded as an essential part, and must be employed by defendants in order to render them liable to the charge of infringement. *Hammerschlag v. Garrett*, 10 *Fed. Rep'r*, 479 ; 28 *Int. Rev. Rec.* 40.

Where a patent process consists of a number of steps, all well known except the first and last, the use of all except the first and last steps will not infringe the patent. *Heller v. Bauer*, 19 *Fed. Rep'r*, 96.

To constitute an infringement of a patented process, the process must be substantially followed. *Royer v. Chicago Manuf. Co.*, 20 *Fed. Rep'r*, 853.

If the patent does not fully describe everything essential to the making of the thing patented, there will be no infringement by the invention of processes which the patentee has withheld from the public. An infringement will not take place unless the invention can be practiced completely by following the specifications. *Page v. Ferry*, 1 *Fish. Pat. Cas.* 298.

Difference in degree of the process by which an end or result is attained is not a new or different process. *Commercial Manuf. Co. v. Fairbank Canning Co.*, 27 *Fed. Rep'r*, 78.

It being known to an art that a certain process will accomplish a certain result, the discovery that a better result may be obtained

by pursuing the process further is not a patentable discovery. *Smith v. Murray*, 27 *Fed. Rep'r*, 69.

A process the exact equivalent of an earlier patented process is an infringement. *Hobbie v. Smith*, 27 *Fed. Rep'r*, 656.

174. Protection accorded to an Improvement of a Device already patented.

If improvements be made upon an invention which has been patented, by any person other than the inventor or patentee, the inventor of the original thing and those claiming under him have no right to use the improvements without a license from the inventor thereof; nor can the inventor of such improvements or any other person lawfully use the principal machine without the license of the inventor thereof. *Gray v. James*, *Pet. C. Ct.* 394; *Washburn v. Gould*, 3 *Story*, 122; 1 *West. L. J.* 465; 7 *L. Rep'r*, 276. S. P., *Goodyear v. Railroad*, 2 *Wall. Jr.* 356; 1 *Fish. Pat. Cas.* 626; *Filley v. Littlefield*, 25 *Fed. Rep'r*, 282; *Pitts v. Wemple*, 6 *McLean*, 558; *Whipple v. Baldwin Manuf. Co.*, 4 *Fish. Pat. Cas.* 29.

The fact that defendant has made improvements upon, or additions to, the invention patented by plaintiff, gives him no right to use the plaintiff's invention. *Alden v. Dewey*, 1 *Story*, 336; 3 *L. Rep'r*, 383; *Woodworth v. Rogers*, 3 *Woodb. & M.* 135; *Gorham v. Mixer*, 1 *Am. L. J. N. S.* 543; 19 *Hunt Mer. Mag.* 296; 5 *West. L. J.* 525; *Foster v. Moore*, 1 *Curt.* 279; *Howe v. Merton*, 13 *L. Rep'r, N. S.* 70; *Howes v. Nute*, 4 *Cliff.* 173; *White v. Heath*, 10 *Fed. Rep'r*, 291; 22 *Pat. Off. Gaz.* 500; *Parkhurst v. Kinsman*, 1 *Blatchf.* 488; 8 *N. Y. Leg. Obs.* 146; *Howes v. McNeal*, 15 *Pat. Off. Gaz.* 608; 15 *Blatchf.* 103; 3 *Bann. & A. Pat. Cas.* 376; *La Baw v. Hawkins*, 6 *Pat. Off. Gaz.* 724; 1 *Bann. & A. Pat. Cas.* 428; *Union Stone Co. v. Allen*, 14 *Fed. Rep'r*, 353; *Westinghouse v. Gardner, &c. Air Brake Co.*, 9 *Pat. Off. Gaz.* 538; 2 *Bann. & A. Pat. Cas.* 55; *Foye v. Nichols*, 13 *Fed. Rep'r*, 125; 8 *Sawyer*, 201; 22 *Pat. Off. Gaz.* 2243; 13 *Fed. Rep'r*, 125.

Any person may improve a patented invention, but all that he can patent is his improvement. *Colt v. Mass. Arms Co.*, 1 *Fish. Pat. Cas.* 108.

A mere change of form in arrangement of parts does not enable

him who has devised it to treat as an infringer one who improves the form or combination. Otherwise, when something elementary is newly discovered which fairly constitutes a part of the invention. *Taylor v. Garretson*, 5 *Fish. Pat. Cas.* 116; 9 *Blatchf.* 156; *Merriam v. Van Nest*, 13 *Pat. Off. Gaz.* 597; *Cornell v. D. & B. Brewing Co.*, 11 *Pat. Off. Gaz.* 331; 7 *Biss.* 346; 2 *Bann. & A. Pat. Cas.* 514.

A patent for an improvement embraces nothing more than the improvement described and claimed as new; any one who afterward discovers a method of accomplishing the same object, substantially and essentially differing from the one described, has a right to use it. *O'Reilly v. Morse*, 15 *How.* 62, 119.

If an invention is only an improvement on a known machine, the patentee cannot treat another as an infringer who has improved the original machine by using a different form or combination performing the same functions. *McCormick v. Talcott*, 20 *How.* 403.

Where a party having made application for a patent for certain improvements, afterward, with his claim still on file, makes application for another but distinct improvement, but does not in such second application claim it as original, the description in such second application, and non-claim of it there, is not a dedication of the first invention to the public. *Suffolk County v. Hayden*, 3 *Wall.* 315.

When several patents are issued for improvements upon the same general structure, each patentee is liable to all prior patentees to the extent to which he adopts their improvements. *Warth v. Browning*, 17 *Pat. Off. Gaz.* 624; 5 *Bann. & A. Pat. Cas.* 341.

Although improvements may be made in the separate devices constituting a combination, which improvements may be the proper subject of a patent, yet if the combination made by the defendant embraces and shows the elements of the plaintiff's invention, operating substantially in the same manner to produce the same results, it must be treated as an infringement. *Hartshorn v. Shorey*, 9 *Pat. Off. Gaz.* 595.

An improvement in the construction of a portion of a patented mechanism, by which it performs an additional function to that in the original invention, does not justify the use of the original invention. Nor does the fact that some of the devices of the combination are old defeat the validity of the patent. *Strobridge v. Lindsay*, 2 *Fed. Rep'r.* 692; 18 *Pat. Off. Gaz.* 62; *Bann. & A. Pat. Cas.* 411.

A patent for a mere improvement if limited in its scope to the method of arrangement of devices described and claimed in it as new, is not infringed by the use of substituted devices, different in character and dissimilar in form, although they may perform some of the functions of the patented devices, or may effect the same general result. *Dyer v. National Hod Elevating Co.*, 24 *Fed. Rep'r.* 182.

Letters patent for an improvement on a patented invention cannot be declared void because they include such patented invention. And a party who is infringing both the improvement and the original invention cannot set up the existence of the first patent as an excuse for infringing the improvement. *Cantrell v. Wallick*, 117 *U. S.* 689.

A patent for an improvement can not be so extended as to include the older process of the art of the process or science. *Globe Nail Co. v. Superior Nail Co.*, 27 *Fed. Rep'r.*, 450.

Where there are a number of devices, all acting substantially upon the same principle, and a patent is granted for a device which has, in addition to the elements common to all, a special feature possessed by it alone, the patent can be upheld so as to protect such special feature; but it cannot be so construed as to include other machines which are mere adaptations or simplifications of other older devices. *Montross v. Bullard*, 27 *Fed. Rep'r.*, 64.

175. *To a Combination.*

To constitute an infringement of a patent for a combination of several elements, the defendant must have used all the elements of the combination. If he has used some of them only, omitting one or more, without substituting any equivalent therefor, there is no infringement. *Prouty v. Ruggles*, 16 *Pet.* 336; *aff'g* 1 *Story*, 568; *Stimpson v. Baltimore & Susquehanna R. R. Co.*, 10 *How.* 329; *Brooks v. Fiske*, 15 *How.* 210; *McCormick v. Talcott*, 20 *How.* 402; *Eames v. Godfrey*, 1 *Wall.* 78; *Barrett v. Hall*, 1 *Mas.* 447; *Moody v. Fiske*, 2 *Mas.* 112; *Howe v. Abbott*, 2 *Story*, 190; *Aiken v. Bemis*, 3 *Woodb. & M.* 348; *Gorham v. Mixer*, 1 *Am. L. J. N. S.* 543; 19 *Hunt Mer. Mag.* 296; 5 *West. L. J.* 525; *Evans v. Eaton*, *Pet. Ct.* 322; *Gray v. James*, *Id.* 394; *Brooks v. Bicknell*, 4 *McLean*, 70; 3 *West. L. J.* 109; *Root v. Ball* 4 *McLean*, 177; *Parker v. Haworth*, *Id.* 370; *McCormick*

v. Manny, 6 *McLean*, 539 ; 4 *Am. L. Reg.* 277; *Pitts v. Wemple*, 6 *McLean*, 558 ; *Fay v. Allen*, 24 *Fed. Rep'r*, 804 ; 32 *Pat. Off. Gaz.* 1355 ; adhered to on rehearing, 25 *Pat. Off. Gaz.* 201. And see *Foster v. Moore*, 1 *Curt.* 279 ; *Sands v. Wardell*, 3 *Cliff.* 277 ; *Storrs v. Howe*, 4 *Cliff.* 388 ; 10 *Pat. Off. Gaz.* 421 ; 2 *Bann. & A. Pat. Cas.* 421 ; *Sanford v. Merrimac Hat Co.*, 10 *Pat. Off. Gaz.* 466 ; *Gould v. Spicers*, 20 *Fed. Rep'r*, 317 ; *Matteson v. Caine*, 17 *Fed. Rep'r*, 525 ; *Huggins v. Hubby*, 3 *West. L. Month.* 347 ; *Howe v. Neemes*, 18 *Fed. Rep'r*, 40 ; *Saladee v. Racine Wagon, &c. Co.*, 20 *Fed. Rep'r*, 686 ; 27 *Pat. Off. Gaz.* 1133 ; *Hovey v. Henry*, 3 *West. L. J.* 153 ; *Westlake v. Carter*, 4 *Pat. Off. Gaz.* 636 ; 6 *Fish. Pat. Cas.* 519.

Where, in an action for an infringement of a patent for an invention, which, as claimed in the patent, consists of several elements in combination, the defendant shows that in his article one of the elements claimed by the plaintiff is not used, the plaintiff will not be allowed to avoid that defense by setting up that such element is immaterial. *Vance v. Campbell*, 1 *Black*, 427 ; rev'g 1 *Fish. Pat. Cas.* 483.

Where a patent is made up of several constituent steps of which the patentee is not the inventor, he has no claim to the constituents singly ; his patent only secures him their use when arranged in the process. *Mowry v. Whitney*, 14 *Wall.* 620.

If the subsequent combination is new, or if the ingredient substituted for the one withdrawn is a newly discovered one, or even an old one performing some new function, and was not known at the date of the patent as a proper substitute for the ingredient withdrawn, there is no infringement; for a new combination, or a newly discovered ingredient substituted for the one omitted, or even an old one performing a new function not known at the date of the patent as a proper substitute for the one withdrawn, is not an equivalent for the ingredient omitted, within the meaning of the patent law. *Fuller v. Seutzer*, 94 *U. S.* 299 ; 1 *Bann. & A. Pat. Cas.* 520 ; *Seymour v. Osborne*, 11 *Wall.* 516.

Where the thing patented is an entirety, consisting of a separate device, or of a single combination of old elements incapable of division or separate use, a defense on the ground of want of novelty cannot be established by proving that a part of the entire invention is found in one prior patent, printed publication or machine, and another part in another, and so on indefinitely, and from the whole or any given number allowing the court to determine the issue of

novelty adversely to the complainant. Common justice forbids such a defense, as it would work a virtual repeal of so much of the patent act as gives to inventors the right to a patent consisting of old elements, where the combination itself is new and produces a new and useful result. New elements in such a patent are not required, and if such a defense were allowed, not one patent of the kind in a thousand of modern date could be held valid. Nor is such a defense consistent with the regulations enacted by Congress in respect to the procedure in litigations in respect to patent rights. *Parks v. Booth*, 102 *U. S.* 96; aff'g 1 *Elippin*, 281; 1 *Bann. & A. Pat. Cas.* 225.

A patent for a combination is not infringed by using one part of it combined with other devices substantially different from those described in the patent, in form or mode of arrangement and combination with the other parts. *McMurray v. Mallory*, 111 *U. S.* 97.

A patent for a combination is not infringed by a use of one element in the combination unless it be used in connection with mechanical equivalents known when the patent was granted, substituted for the omitted element. *Rowell v. Lindsay*, 113 *U. S.* 97; *Voss v. Fisher*, *Id.* 213. S. P., *Schillenger v. Cranford*, 2 *Cent. Rep'r*, 680.

A subordinate device is not an "element," within the rule which requires the use of all the elements of a combination to constitute an infringement. *Smith v. Fay*, 6 *Fish. Pat. Cas.* 446.

If a substance was not known as a substitute for a certain element in a combination, at the time of the invention of the combination, the use of it in lieu of that element is not an infringement. *Colgate v. Law Tel. Co.*, 5 *Bann. & A. Pat. Cas.* 437.

If the patentee names a specific material for one element of his combination, using another material for that element is not an infringement. *Harris v. Allen*, 15 *Fed. Rep'r*, 106.

The improvement of one element of a combination does not give the right to use or appropriate the original combination. *Stainthorp v. Humiston*, 4 *Fish.* 107; *Converse v. Cannon*, 2 *Woods*, 7; 9 *Pat. Off. Gaz.* 105.

If the defendant has merely substituted an equivalent for one of the elements of the patented combination, he infringes it, although his combination includes other functions and produces other effects not attainable by the patented combination. *Sarven v. Hall*, 5 *Fish.* 415; 9 *Blatchf.* 524; 1 *Pat. Off. Gaz.* 437; *Whee-*

ler v. Clipper Co., 6 *Fish.* 1 ; 10 *Blatchf.* 181 ; 2 *Pat. Off. Gaz.* 442.

If the defendant has a patent for a combination which contains as one of its elements the principle embodied in the complainant's patent, it is an infringement. *Cleveland v. Towle*, 3 *Fish. Pat. Cus.* 525.

A combination is patentable only when the several elements of which it is composed produce by their joint action a new and useful result, or an old result in a cheaper or otherwise more advantageous way. *Stephenson v. Brooklyn Cross-Town Railroad Company*, 114 *U. S.* 149 ; 5 *Sup. Ct. Rep'r.* 781.

Where a defendant, in constructing his machine, omits entirely one of the ingredients of the plaintiff's combination, without substituting another, he does not infringe ; nor does he infringe in case he substitutes another in place of the one omitted, which performs a different function, or which is new, or which, though old, was not known, at the date of the plaintiff's invention, as a proper substitute for the omitted ingredient. *Gould v. Rees*, 15 *Wall.* 187.

Inasmuch as a combination of old elements is only an improvement upon what was before known, and without the new combination the whole would have been the property of the public, when such a combination is patented, it is infringed by every subsequent combination of the same elements as those which compose it ; and no subsequent combination is substantially different from the patented one, merely because it was in a single device different from one of its elements, provided such substituted device was at the date of the patent a well-known substitute for the omitted one. *Sands v. Wardell*, 3 *Cliff.* 277.

Where all the elements of a machine are old, and the invention consists solely in the combination, by which a new and useful result is effected, as compared with the old machine on which the improvement is made, no one can be held as an infringer who does not use all of the elements of the new combination. But if defendant uses the same elements in substantially the same way and so as to produce substantially the same result, he is liable. *Roberts v. Harden*, 2 *Cliff.* 500.

Although one person has patented a combination, which, however, turns out to be useless, if another adds to the combination another element, and thereby makes the whole practically useful, the person who adds this last element is not an infringer, but is

entitled to use, not merely his improvement,—requiring first a license to use the former combination,—but he may use the whole. *Robertson v. Hill*, 4 *Pat. Off. Gaz.* 132 ; 6 *Fish. Pat. Cas.* 465.

A patent for a mere combination of three distinct devices is not infringed by the use of only two of such devices without the other, if there is a substantial difference between the two machines. *Rich v. Close*, 8 *Blatchf.* 41 ; 4 *Fish. Pat. Cas.* 279.

If a patent is for a mere arrangement or combination of old devices to produce a somewhat better result in a known art, the substitution of a new element, not known at the date of the patent, may avoid infringement. *American Bell Telephone Co. v. Spencer*, 8 *Fed. Rep'r*, 509 ; 20 *Pat. Off. Gaz.* 299.

The use of a worthless patented combination, in connection with a new element that renders the whole useful, cannot be punished as an infringement of the patent for the worthless combination. *Bliss v. Brooklyn*, 6 *Fish. Pat. Cas.* 289.

Where a patented invention is merely a combination subordinate to pre-existing devices and has been limited to such sub-combination by the language of the claim, the patentee cannot successfully insist that he is entitled to cover by such claim the pre-existing devices ; and this is true where one of the joint inventors of the junior invention is also the inventor of the senior inventions. *The Hopkins, &c. Manuf. Co. v. Corbin*, 14 *Blatchf.* 396.

A patent for a combination of new elements with old may secure the new elements by themselves as well as the combination. *American Diamond Rock Boring Co. v. Sutherland Falls Marble Co.*, 2 *Fed. Rep'r*, 353 ; 18 *Blatchf.* 148 ; 10 *Rep'r*, 9 ; 5 *Bann. & A. Pat. Cas.* 347.

Where a patent for a combination of known parts is not infringed by the use of any number of the parts less than the whole, yet if some of the parts are new, the like use of such parts, though with different devices from the rest of the combination, is an infringement to that extent. *Sharp v. Tiffit*, 2 *Fed. Rep'r*, 697 ; 18 *Blatchf.* 132 ; 17 *Pat. Off. Gaz.* 1282 ; 5 *Bann. & A. Pat. Cas.* 39^a.

Complainant filed a bill for infringement of a patent for a combination against one who had erected a machine containing all the parts of the patented combination but one. After the filing of the bill this latter part was added. It was *held* that the bill must be dismissed, as there was proof that this part was not a necessary incident to the machine, and that its use was not contemplated at

the time of the construction of the machine. *Maynard v. Pawling*, 3 *Fed. Rep'r*, 711; 18 *Pat. Off. Gaz.* 244; 5 *Bann. & A. Pat. Cas.* 551.

If a patented combination of numerous parts includes in it other new and useful combinations of less of the parts, the patentee is entitled to the exclusive use of the lesser combinations as well as the exclusive use of the whole. *Holly v. Vergennes Machine Co.*, 4 *Fed. Rep'r*, 74; 18 *Blatchf.* 327; 18 *Pat. Off. Gaz.* 1177.

Using a part of a patented combination is an infringement, if that part is separable and was new and patentable to the inventor. *Adair v. Thayer*, 4 *Fed. Rep'r*, 441; 17 *Blatchf.* 468; 9 *Rep'r*, 401; 4 *Bann. & A. Pat. Cas.* 118.

A combination for a fruit-preserving jar, all the elements of which, except a device to secure more effectual sealing are old, is a new and original invention. If all the essential elements of the combination have not been before embodied and employed together, it is to be taken as original. *McCulley v. Cunningham*, 3 *Pittsb.* 366.

The elements of a combination being old *per se*, the essence of the invention consists in the novelty of their combination and its adaptation to the use for which it is intended; and its infringement will consist in the use of a machine substantially embodying the combination in its entirety for the same purpose. *Smith v. Marshall*, 10 *Pat. Off. Gaz.* 375; 2 *Bann. & A. Pat. Cas.* 371.

A distinct claim for each of the constituents of a combination of old elements will not protect such combination where there has been no specific claim for the same. *Delaware Coal, &c. Co. v. Packer*, 1 *Fed. Rep'r*, 851; 24 *Pat. Off. Gaz.* 1273; 5 *Bann. & A. Pat. Cas.* 296.

Any new combination of old ingredients is patentable when any new, useful results follow; but the mere exercise of judgment or mechanical skill in selecting a few ingredients from a larger number already known and specified in prior patents is not an invention. *Welling v. Crane*, 14 *Fed. Rep'r*, 571; 23 *Pat. Off. Gaz.* 189.

It is not essential to a patentable combination that the several devices or elements should co-act upon each other, provided all cooperate. *Stutz v. Armstrong*, 20 *Fed. Rep'r*, 843; 28 *Pat. Off. Gaz.* 367.

The manufacture and sale by a defendant of stove-pipes, elbows, valves and the like apparatus, such as are used and which are intended to be used in a patented combination of such articles with

others not manufactured and sold by the defendant, but which may be and are used in other combinations, do not necessarily infringe the patent for the particular combination. *Millner v. Schofield*, 4 *Hughes*, 258.

A patent claiming combinations separate in their nature but capable, if desired, of separate use, was *held* not to be a unit, and use of all the parts was adjudged not necessary to constitute an infringement. *Densmore v. Schofield*, 4 *Fish. Pat. Cas.* 148.

No one infringes a patent for a combination who does not employ all the ingredients of the combination; but if he employs all the ingredients, or adopts mere formal alterations, or substitutes for one ingredient another which was well known at the date of the patent as a proper substitute for the one withdrawn, and which performs substantially the same function as the one withdrawn, he does infringe. *King v. Louisville Cement Co.*, 4 *Pat. Off. Gaz.* 181; 6 *Fish. Pat. Cas.* 336.

If the patent is for a combination, and on that a recovery is sought, the complainant may recover for the element that he has added. *Ingels v. Mast*, 1 *Flippin*, 424; 2 *Bann. & A. Pat. Cas.* 24.

Where the invention consists not only in the combination, but in the improvement of several of the parts of the combination, the violation of one of them is an infringement for which an action will lie. *Parker v. Haworth*, 4 *McLean*, 370.

If the whole of the combination be taken, though something be added, still it is an infringement. *Pitts v. Wemple*, 6 *McLean*, 558.

A patent for a combination of known parts is not infringed by the use of any number of the parts less than the whole; or by the substitution of a new element, or of one that performs a substantially different function; or by the substitution of an old element not known at the date of the patent as a proper substitute for the omitted ingredient; or by a new combination of the existing elements of the patented combination. A combination must be maintained as an entirety, and no one separate element can be regarded as the distinctive and essential feature of the invention. *Rowell v. Lindsay*, 6 *Fed. Rep'r*, 290; 10 *Biss.* 217; 17 *Pat. Off. Gaz.* 1565.

A patent for the combination of old parts is not infringed by a different combination of the same parts to produce the result. *Pattee v. Moline Plow Co.*, 9 *Fed. Rep'r*, 821; 10 *Biss.* 377; 22.

Pat. Off. Gaz. 173 ; Washburn, &c. Manuf. Co. v. Griesche, 16 *Fed. Rep'r*, 669 ; 5 *McCrary*, 246.

A patent for a combination of mechanical devices is not infringed by the use of a mere element of the combination previously well known. *Underwood v. Warren*, 24 *Fed. Rep'r*, 182.

Using one of the important parts of a combination may be an infringement of a patent for the combination. *Matthews v. Spangenberg*, 15 *Rep'r*, 261.

Where old devices are brought together to co-operate in producing a result which has not been produced before by the same elements, the invention is patentable although the same result may have been produced before by some of the elements of the combination acting with others, but in a substantially different way. *Hoe v. Knap*, 27 *Fed. Rep'r*, 204.

In patents for combinations of mechanisms, limitations and provisos imposed upon the inventor are to be strictly construed. The production of an old result by a more effective combination of old elements, by one patentee, will not prevent another patentee from making new combinations of such elements to produce the same result, if the latter does not use the combination of parts claimed in the first patent. *Otis Bros. Manuf. Co. v. Crane Bros. Manuf. Co.*, 27 *Fed. Rep'r*, 550.

A device is patentable although the elements are old, if the combination is new, and produces a new and useful result, and if to produce it required more than mere mechanical skill. *May v. County of Fond du Lac*, 27 *Fed. Rep'r*, 691.

A combination of old elements for a new purpose is patentable. *Donoughe v. Hubbard*, 27 *Fed. Rep'r*, 742.

A patent for an improved baggage-check holder, claiming only a combination which included flanges bent over for holding the check securely, was *held* not infringed by a device for the same purpose having such flanges but no other element of the combination. *Abbott v. Hoole Manuf., &c. Co.*, 31 *Pat. Off. Gaz.* 156.

The claim of a specific device or combination in a patent, and the omission to claim other devices or combinations apparent on its face, are in law a dedication to the public of that which is not claimed. *Hill v. Comrs. of Patents*, 1 *Cent. Rep'r*, 91.

In a patent for a new and useful improvement in the mode of forming rails for railroad carriages, for use in cities, &c., "where it is desirable that the wheels of ordinary carriages should not be subjected to injury or obstruction," the patentee claimed the em-

ployment of plates or rails having narrow grooves on each side of the track for the flanges of the car wheels to run in, by which they were adapted to the unobstructed passing over them of the various kinds of common carriages, such rails being also sunk to a level with the surface of the street. It was *held* that such patent consisted of the combination of such grooves with the rail, on both sides of a railroad track, such combination being depressed to a plane corresponding with the street; and that the use by the defendant of a double iron rail, with a groove or interval between large enough for the flange of the wheel, placed on the inner side of a curve, the ordinary flat iron rail being used on the exterior line of the same curve, and the whole constructed on the same plane with the general track of the road, without regard to the convenience of carriages to pass over it, was not an infringement of such combination, it having used but one element of the plaintiff's combination. *Stimpson v. Baltimore & Susquehanna R. R. Co.*, 10 *How.* 329, 346.

In a patent for a combination, with other elements, of heating pipes described in the specification as constructed with flexible tubes, gum tubing or suitable rock-joints, so as to permit the elevation and lowering of the pipes without interfering with the circulation of steam through them, the flexible joints are distinguishing and essential features of the construction of the pipes; and a machine without hinge joints is not an infringement of the combination. *Sheeler v. Shannon*, 25 *Fed. Rep'r*, 824.

176. *To a Composition of Matter.*

In a patent for an improvement in making friction matches, the invention was not a compound of new ingredients, but was simply a new combination of materials before in use for that purpose, consisting of a composition formed of phosphorus with the earthy material and glutinous substance only, without chlorate of potash or other like objectionable ingredients. It was *held* that any person might use any one or all the materials forming the composition, provided he did not use them in the combination patented, or that any one might use them in combination with chlorate of potash, as they were formerly used. But a mere colorable difference or slight variation of such a combination will not exempt a person from the charge of infringement. *Byam v. Eddy*, 2 *Blatchf.* 521; 23 *Vt.* 666.

In an action for an infringement of a patent for a compound, if the defendants do not use the entire combination, but use another ingredient producing another result, they do not infringe. *Smith v. Murray*, 27 *Fed. Rep'r*, 69.

177. *The Doctrine of Equivalents, in General.*

In the administration of the patent law the substantial equivalent of a thing is deemed the same as the thing itself. Two devices which perform the same function in substantially the same way, and accomplish substantially the same result, are treated as the same, though they may differ in name or form. *Machine Co. v. Murphy*, 97 *U. S.* 120.

Where all the elements of a machine are old, the patentee cannot invoke the doctrine of equivalents to suppress all other improvements on the old machine. But he is an infringer who makes or vendes the patented improvement with no other change than the employment, as a substitute for one of its elements, of a device well known in the state of the art to be such at the date of the invention, and which any constructor acquainted with the art would then know how to employ. Such substitution of one well-known element for another is a mere colorable evasion of the patent. *Union Sugar Refinery v. Mathiessen*, 3 *Cliff.* 639; 2 *Fish. Pat. Cas.* 600.

The term "equivalent" has two meanings; the one relates to the results that are produced, and the other to the mechanism by which those results are produced. Two things may be equivalent, that is, the one equivalent to the other as producing the same result when they are not the same mechanical means. In other words there may be equivalents in the sense of producing the same result, each of which is an independent matter of invention. *Johnson v. Root*, 1 *Fish. Pat. Cas.* 351; *Burden v. Corning*, *Id.* 477.

The action of the commissioner of patents, in requiring a disclaimer of so much of the reissued patent as claimed in specific terms the use of a specified equivalent, is not conclusive upon complainants. The patentee, without describing equivalents, is entitled to use equivalents and to treat the use of equivalents by others as an infringement. *Union Metallic Cartridge Co. v. United States Cartridge Co.*, 11 *Pat. Off. Gaz.* 1113.

One substance does not constitute the equivalent of the other

when each produces a different product under the same conditions. *Clarke v. Johnson*, 4 *Fed. Rep'r*, 437; 18 *Blatchf.* 450; 18 *Pat. Off. Gaz.* 1276.

The defendant employed the plaintiffs' patented process of treating tobacco, with the exception that he made use of an equivalent for the gum arabic used by the plaintiffs to produce the same effect as that rendered by the plaintiffs' process. This was held an infringement. *Kimball v. Hess*, 15 *Fed. Rep'r*, 393; 15 *Rep'r*, 583; 26 *Pat. Off. Gaz.* 107.

Mechanical equivalents are not those merely which produce the same result; a mechanical equivalent, as generally understood, is where one device may be adopted instead of another to perform the known function of the latter, by a person skilled in the art, from his knowledge of the art. *Smith v. Marshall*, 10 *Pat. Off. Gaz.* 375; 2 *Bann. & A. Pat. Cas.* 371; *Johnson v. Root*, 1 *Fish. Pat. Cas.* 351; *Burden v. Corning*, 2 *Id.* 477.

Though the defendant's machine may be simpler, cheaper, and possibly better than the complainant's patented machine, yet if its chief efficiency arises from the use of equivalents to the complainant's patent, it is infringement. *Odiorne v. Denney*, 3 *Bann. & A. Pat. Cas.* 287; 1 *N. J. L. J.* 183.

Where a person procures a patent for the building of a machine which produces certain novel and useful results by means of certain mechanical contrivances and appliances, any application of known mechanical powers which will produce such results, although different in form from the means employed by the original patentee, is a mechanical substitute and equivalent of the same. *Wilt v. Grier*, 5 *Fed. Rep'r*, 450; 19 *Pat. Off. Gaz.* 427.

A device is the equivalent of one that is patented, if it performs substantially the same function, in the same way, and produces the same result; though it may be of a different form and bear a different name, its use will be an infringement. *Westlake v. Cartter*, 4 *Pat. Off. Gaz.* 579; 6 *Fish. Pat. Cas.* 519.

Devices are equivalents when those skilled in the science or art know that one will produce the same result as the other. *May v. County of Fond du Lac*, 27 *Fed. Rep'r*, 691.

One patent infringes another when the second device works out the same result as the first by substantially the same means, using equivalent parts to perform the functions performed by the elements of the first mechanism. *Holliday v. Covel*, 27 *Fed. Rep'r*,

217 ; *Conover v. Roach*, 4 *Fish. Pat. Cas.* 12 ; *Merriam v. Drake*, 5 *Id.* 259 ; 9 *Blatchf.* 336.

A rod is the known equivalent of an endless chain in machinery, where it can be used for the same purpose and with like effect. According to the principles of patent law, they are not substantially different. *Spain v. Gamble*, 1 *MacArthur Pat. Cas.* 358.

A contrivance which is used for the same general purpose as a patented device, which performs the same kind of duties, or is applicable to the same object as the latter, will be regarded as its equivalent and is not patentable. *Re Nutting*, 1 *MacArthur Pat. Cas.* 455.

The doctrine of mechanical equivalents is *held* not applicable to a case of alleged infringement where the inventors of complainant's device were not the first to show the use of such a device for the particular purpose. *Tobey Furniture Co. v. Colby*, 26 *Fed. Rep'r*, 100 ; 34 *Pat. Off. Gaz.* 1276.

178. *Application of the Doctrine of "Equivalents" to Combinations.*

Bona fide inventors of a combination are as much entitled to equivalents as the inventors of other patentable improvements ; by which is meant that a patentee in such a case may substitute another ingredient for any one of the ingredients of his invention, if the ingredient substituted performs the same function as the one omitted in the patented combination. Hence, it is clear that an alteration in a patented combination which merely substitutes another (old) ingredient for one of those in the combination, is an infringement, if the substitute merely performs the same function and was well known, at the date of the patent, as a proper substitute for the omitted ingredient. *Gould v. Rees*, 15 *Wall.* 187. S. P., *Water Meter Co. v. Desper*, 101 *U. S.* 332 ; *Imhauser v. Burke*, *Id.* 647 ; *Storrs v. Howe*, 4 *Cliff.* 388 ; 10 *Pat. Off. Gaz.* 421 ; 2 *Bann. & A. Pat. Cas.* 420 ; *Welling v. Rubber Coated Harness Trimming Co.*, 7 *Pat. Off. Gaz.* 606 ; 2 *Bann. & A. Pat. Cas.* 1 ; *Dederick v. Cassell*, 9 *Fed. Rep'r*, 306 ; 27 *Int. Rev. Rec.* 400 ; 20 *Pat. Off. Gaz.* 1233 ; *King v. Louisville Cement Co.*, 4 *Pat. Off. Gaz.* 181 ; 6 *Fish. Pat. Cas.* 336 ; *Whittlesey v. Ames*, 13 *Fed. Rep'r*, 893 ; 9 *Biss.* 225 ; 18 *Pat. Off. Gaz.* 357 ; 5 *Bann. & A. Pat. Cas.* 96.

It is not always sufficient evidence that two combinations of elements are equivalent, to show that each element of the combination in one may be regarded, under some circumstances, as the equivalent of the corresponding element in the other, when the elements are separately considered. If the mechanical combinations of the members of the two machines are such that the action and mode of operation differ in the two machines, then one is something more than a new mechanical equivalent for the other. *Blake v. Rawson*, 3 *Biss.* 77; 3 *Pat. Off. Gaz.* 122; 6 *Fish. Pat. Cas.* 74.

When a substitute is used for one ingredient in a patented combination which has every property and performs every function of the original in the combination, it does not cease to be an equivalent because, in addition, it does something more and better. *Atlantic Giant Powder Co. v. Goodyear*, 13 *Pat. Off. Gaz.* 45; *Adams v. Joliet Manuf. Co.*, 12 *Pat. Off. Gaz.* 93.

Where, by a claim in a patent for an improvement in grain drills, a lever or its equivalent as a mechanical instrument was made an essential element, it was *held*, that the use of the human hand instead of the lever was not a mere equivalent constituting an infringement, although in the patented machine the hand was applied to work the lever. *Brown v. Davis*, 116 *U. S.* 237.

A different arrangement of the parts of the machine from that of the complainant's, and producing a different and better result, is not an infringement. *Habeman v. Whitman*, 5 *Bann. & A. Pat. Cas.* 530.

A patent for an "improvement in floating mowing machines," arranged and adapted to cut weeds and grass under water, claimed only the combination of the old cutting device of a mowing machine with a boat to float upon the water, transmitting motion to the cutter by means of a vibrating lever. It was *held* that the substitution of a vertical crank-shaft for such vibrating lever, the shaft performing the same functions as the lever and no other, and being a known equivalent for the lever, was an infringement of the patent. *Piper v. Shedd*, 26 *Ed. Rep'r*, 151.

A patent for a machine for washing bottles, which claimed the combination of a stationary water supply-pipe, a sleeve shaft mounted upon and adapted to be revolved about said stationary pipe, and a brush or scraper, with other devices, was *held* to be infringed by a machine with a revolving supply pipe covering the brush at its forward end and joined at its rear to the stationary

supply-pipe, these devices being fairly equivalents. *Hoyt v. Slocum*, 26 *Fed. Rep'r*, 329.

Patent granted to Walworth and Buschick, in 1867, for improvements in looms was *held* not infringed by a device which did not contain an important element of the claim or any equivalent therefor. *Taft v. Steere*, 26 *Pat. Off. Gaz.* 1020.

A patent for an improvement in hammocks, claiming six elements, was *held* not infringed by a hammock in which three of them were not used. *Travers v. Palmer*, 23, *Fed. Rep'r*, 511 ; 31 *Pat. Off. Gaz.* 382.

A patent for an improvement in wardrobe bedsteads, covering a device for an arrangement of folding doors, which used, described, and specifically claimed three doors, was *held* not infringed by a device which accomplished, substantially the same result, by the use of only two folding doors. *Tobey Furniture Co. v. Colby*, 26 *Fed. Rep'r*, 100 ; 34 *Pat. Off. Gaz.* 1276.

179. *To Compositions of Matter.*

The substitution of a mere known equivalent in place of one element in a composition of matter is an infringement of a patent for such composition ; but where the patentee of a composition does not embrace equivalents in his claim, but confines himself to the specific ingredients or things, and expressly excludes all others, or expressly excludes some or one other, a use, in a similar combination, of the thing disclaimed is no infringement. Where a patent was for sawing matches in sheets, so as to leave them united at one end, and then wrapping them in paper in a particular manner, it was *held* that the patent was for the entire and complete mode described, and was not infringed by putting up matches attached at one end, but not wrapped in slips of paper. *Byam v. Farr*, 1 *Curt.* 260.

Patents are infringed by the substitution of chemical equivalents, as well as of mechanical equivalents ; even if in some respects they are improvements on the original process patented. To constitute an infringement of a chemical process, it is not necessary that the substituted ingredient be the equivalent in every respect, and for every purpose, of that in place of which it is used ; it must only be an equivalent in the particular process, contributing to produce the same composition of matter, by substantially the same

chemical action. Thus a paste consisting of flour, salt, alum, and corrosive sublimate, is infringed by a compound consisting of flour, chloride of zinc, alum, corrosive sublimate and oil of cloves; and where the patentee of an improved paste used the chloride of sodium mainly for increasing the solubility of the antiseptic agent employed, and assisting in its diffusion through the mass of the paste, the use of the chloride of zinc, which in the particular process produced practically the same result, was *held* to be an infringement. *Woodward v. Morrison*, 1 *Holmes*, 124; 2 *Pat. Off. Gaz.* 120; 5 *Fish. Pat. Cas.* 357.

The substitution in a patented mixture, of an ingredient which, although not precisely the same in its action, produces all the valuable and beneficial results attending that for which it was substituted, and in substantially the same manner, is an equivalent, and an infringement of the patent. *Atlantic Giant Powder Co. v. Mowbray*, 12 *Pat. Off. Gaz.* 560; 2 *Bann. & A. Pat. Cas.* 442; *Knox v. Great Western Quicksilver Mining Co.*, 14 *Pat. Off. Gaz.* 897; 6 *Sawyer*, 430; 7 *Rep'r*, 325; 4 *Bann. & A. Pat. Cas.* 25.

Where the ingredients in a compound are the same, and the change is merely in the mode of combining them, or there is a substitute of one ingredient having the same qualities and producing the same result, there is an infringement. *Allen v. Hunter*, 6 *McLean*, 303, 313.

Selling materials in dry packages with printed directions whereby an article or effect can be produced essentially similar to that covered by a patent, infringes such patent. *Alabastine Co. v. Payne*, 27 *Ibid. Rep'r*, 559.

150. *Rights of Purchaser of a Specific Article from the Patentee or his Licensee.*

For Rev. Stat. § 4899, securing this right, see *ante*, 135.

By the sale of a patented machine, it becomes the property of the purchaser, and is no longer protected by the patent laws. The purchaser may use it, repair it, improve it, &c., in the same manner as any other chattel belonging to him. *Chaffee v. Boston Belting Co.*, 22 *How.* 217.

Use of an invention with knowledge and without prohibition of an inventor, before application, entitles the person so using to continue the use after the patent has been granted. *McClurg v. Kingsland*, 1 *How.* 202; 17 *Pet.* 228

Repairing partial injuries, whether they occur from accident or wear, is only refitting a machine for use. And it is no more than that, though it shall be a replacement of an essential part of a combination. But if a patented machine as a whole should happen to be broken so that its parts could not be re-adjusted, or be so much worn as to be useless, a purchaser cannot make or replace it by another, but must buy a new one. To do either would be reconstruction. *Wilson v. Stimson*, 9 *How.* 109, 124.

Thus the right to replace the cutters in Woodworth's planing machine was *held* to vest in a purchaser; as the use of the machine depends upon the replacement of such cutters, and as a machine will last several years, whereas the cutters must be replaced every sixty or ninety days. *Ib.*

A grant of a right, by a patentee, to make and use a patented machine within a term for which it has been granted, will give the purchaser of machines from such grantee the right to use the individual machine as long as the machine itself lasts; nor will this right to use a machine cease because an extension of the patent, not provided for when the patentee made his grant, has since been allowed, and the machine sold has lasted and is used by the purchaser within the term of the time covered by this extension. *Bloomer v. Millinger*, 1 *Wall.* 340. S. P., *Bloomer v. Stolley*, 5 *McLean*, 158; 8 *West. L. J.* 158.

A patented article, when rightfully bought, may be used anywhere. *Hobbie v. Smith*, 27 *Fed. Rep'r*, 656.

Where a patentee has assigned his right to manufacture, sell and use within a limited district an instrument, machine or other manufactured product, a purchaser of such instrument or machine, when rightfully bought, within the prescribed limits, acquires by such purchase the right to use it anywhere, without reference to other assignments of territorial rights by the same patentee. The right to the use of such machines or instruments stands on a different ground from the right to make and sell them, and inheres in the nature of a contract of purchase, which carries no implied limitation of the right of use within a given locality. The assignee, for a limited district, of a patent for an improvement in coffins, made and sold within the district, coffins containing the patented improvements; it was *held*, that the purchaser of a coffin could put it to use in an interment anywhere. He was not restricted to use within the district designated in the assignment. *Adams v. Burke*,

17 *Wall.* 453. S. P., *McKay v. Wooster*, 6 *Am. L. T. Rep.* 169 ; 3 *Pat. Off. Gaz.* 441 ; 2 *Sawyer*, 373 ; 6 *Fish. Pat. Cas.* 375. .

The assignee of a particular territory may sell within that territory, although he knows the article is to be used in the territory of another assignee. *Hobbie v. Smith*, 27 *Fed. Rep'r*, 656.

To entitle the purchaser of a machine to the benefits of the act of 1839, § 7, he must be one who has used the invention before the application for a patent by license from the inventor himself, and not a fraudulent purchaser, or a purchaser from a wrong-doer, without the knowledge or against the will of the inventor. *Pier-son v. Eagle Screw Co.*, 3 *Story*, 402.

When a patentee has himself constructed a machine, and sold it without any conditions, or has authorized another to construct, sell and deliver it, or to construct and use and operate it without any conditions, and the consideration has been paid to him for the thing patented, the rule is well established that the patentee must be understood to have parted to that extent with all his exclusive right, and that he ceases to have any interest whatever in the patented machine so sold and delivered, or authorized to be constructed and operated. When such circumstances appear, the owner of the machine, whether he built it or purchased it, if he has also acquired the right to use and operate it during the continuance of the patent, may continue to use it until it is worn out, in spite of any and every extension subsequently obtained by the patentee or his assigns. *Wooster v. Seidenberg*, 13 *Blatchf.* 88 ; 10 *Pat. Off. Gaz.* 244. See, also, *Wooster v. Taylor*, 12 *Blatchf.* 384 ; 8 *Pat. Off. Gaz.* 644.

If one has a right to a patented machine, and to the use of it, he has a right to work it himself, or by his servants, or to lease it out to any other person. *Reutgen v. Kanowrs*, 1 *Wash.* 168.

An agreement between the patentee and his licensees, that the latter will not manufacture certain articles, cannot prevent third persons, who purchase from the licensees articles which they are authorized to make and sell, from afterward converting them into the prohibited articles. The public cannot be compelled to notice or regard agreements between the patentee and his licensees as to the limitation of the use of the article made by them. Such a contrivance to destroy competition may be valid, but the covenant binds only the parties to it. If a stranger purchase the product from one licensed to use the process, he need look no further, and may use it for his own purposes, without inquiring for or regard-

ing any private agreement of licensees not to compete with one another. *Metropolitan Washing Machine Co. v. Earle*, 2 *Fish. Pat. Cas.* 203.

Buying and using a second time articles stamped "licensed to use once only," and sold to defendants' vendor upon that express condition, *held* an infringement. *American Cotton Tie Supply Co. v. Bullard*, 17 *Blatchf.* 160; 17 *Pat. Off. Gaz.* 388; 9 *Rep'r.* 70; 4 *Bann. & A. Pat. Cas.* 520; *Same v. Simmons*, 106 *U. S.* 89.

181. *Rights of Purchaser from an Infringer*

The purchaser of a manufactured article made in violation of a patent of a third person, but without any connection on the part of such purchaser with the manufacturer except as a purchaser, will not make the party buying guilty of an infringement of the rights of the patentee, as having used the patented invention. Thus, in general, a contract to buy all the product of a patented machine, during a certain period, does not render the purchaser liable to an action of infringement for the use of the machine on which it is made. Otherwise, if such contract is only a colorable purchase of the products, and is in reality a hiring of the machine. *Keplinger v. De Young*, 10 *Wheat.* 358.

Purchasers of an article manufactured by infringers of a patented machine, are not liable as infringers. *Goodyear v. Railroad*, 2 *Wall. Jr.* 356; 1 *Fish. Pat. Cas.* 626; *Anon.*, 3 *West. L. J.* 144; *Blanchard's Gun-stock Turning Factory v. Jacobs*, 2 *Blatchf.* 69.

The sale of the products of a patented machine is not an infringement. The products cannot be reached except in the hands of some one in some manner connected with the use of the patented machine. *Boyd v. McAlpine*, 3 *McLean*, 427; *Goodyear v. Railroad*, 2 *Wall. Jr.* 356; 1 *Fish. Pat. Cas.* 626.

When a patentee recovers from an infringing manufacturer full damages and profits on account of the infringement, the purchaser from the manufacturer, who is a user of the machine, will be protected in such use against a suit for infringement, as he would be if he were a licensee from the patentee. But this could only be held on a clear showing that the purchaser was using the same patented machine or instrument as that involved in the suit between the patentee and the infringing manufacturer, and that the user was a vendee of such manufacturer. Probably, it must further

appear that the patentee's claim to profits and damages against the manufacturer has been actually paid and satisfied. *Allis v. Stowell*, 16 *Fed. Rep'r*, 783.

An agreement between owners of a patent and infringers, by which the former release to the latter all claims against them by reason of the manufacture and sale of the patented article, and also all claims against all other persons who had purchased or sold the same article when manufactured by the infringers, makes purchasers from the infringers lawful owners of the articles so purchased; and a re-sale by them of such articles is not an infringement. *Alabastine Co. v. Richardson*, 26 *Fed. Rep'r*, 620.

182. *What has been held to be or not to be Infringement, in peculiar Cases.*

A patent claiming only a particular style of spring was *held* not to be infringed by employing for the same purpose a spring differing somewhat in style. *Field v. De Conneau*, 116 *U. S.* 187.

A patent for covering the upper surface and front edge of a keyboard with a single sheet of plaster composition was *held* infringed by covering the surface with a strip and the front edge with another strip of such composition. *Celluloid Manuf. Co. v. Pratt*, 22 *Blatchf.* 367; 21 *Fed. Rep'r*, 313. See 23 *Id.* 38.

Patent for covering piano keys with celluloid, in a "continuous strip or roll"—was *held* not infringed by a device using a separate strip for each key. *Celluloid Manuf. Co. v. Comstock*, 23 *Fed. Rep'r*, 38.

A patent for improving locks by making part of the mechanism more yielding than the rest, was *held* not infringed by the device of making the other parts stronger than those which in the patentee's lock were weakened. *Newbury v. Mossman*, 21 *Fed. Rep'r*, 579; 29 *Id.* 271.

A patent for causing a steamboat capstan to revolve by connecting it with the vessel's engine, *held* not infringed by accomplishing the same thing by connecting an independent engine with the capstan. *McMillin v. St. Louis & Vicksburg Anchor Line*, 22 *Fed. Rep'r*, 169.

A patent for forming a pavement by laying concrete in sections so that any single block could be raised separately, was *held* infringed by laying the concrete in a mass while yet plastic, and

immediately dividing it into blocks. *Kuhl v. Mueller*, 21 *Fed. Rep'r*, 510 ; 28 *Pat. Off. Gaz.* 541.

A plainly declared element of a combination cannot be eliminated by judicial construction, although using it is not necessary to the result. Thus a patent for straining out sand by a screen working in water in a closed vessel is not infringed by disusing the vessel and using the same strainer in the open river. *Williams v. Stoltzenback*, 23 *Fed. Rep'r*, 39 ; 30 *Pat. Off. Gaz.* 891.

A patent for an improvement in telegraphic printing instruments, the principal feature of which was the independent rotation of the two type wheels, standing contiguous, "so as to be impressed separately or jointly upon the same strip of paper," was *held* infringed by a machine the type wheels of which could not rotate together, although they could not print simultaneously. *Gold & Stock Tel. Co. v. Commercial Tel. Co.*, 23 *Fed. Rep'r*, 340 ; 31 *Pat. Off. Gaz.* 1559. See *Same v. Same*, 22 *Fed. Rep'r*, 838.

A patent for improving flanging machines by throwing the lower roll beyond the upper, is infringed by the device of throwing the upper roll back of the lower roll. *Phillips v. Carroll*, 23 *Fed. Rep'r*, 249 ; 31 *Pat. Off. Gaz.* 265.

A patent for "a horse collar, consisting of a frame combined with a number of detachable pads" was *held* not infringed by the use of detachable pads, or sweat-cloths with detachable pads, independent of a collar. *Osmer v. J. B. Sickles Saddlery Co.*, 23 *Fed. Rep'r*, 724.

A patent for a leather cutting-press, claiming "the revolving cutting-block, in combination with the cutting-press," was *held* not infringed by a machine using a revolving block and cutting-die, but not *the* cutting-press described in the specification and drawings of the patent. *Richardson v. Bresnahan*, 23 *Fed. Rep'r*, 897.

A patent for an air-cooling apparatus, using ice as the cooling agent was *held*, not infringed by an apparatus in which the refrigerating effect was produced by the compression and expansion of air, not by contact with ice. *Bate Refrigerating Co. v. Eastman*, 24 *Fed. Rep'r*, 645 ; 32 *Pat. Off. Gaz.* 517.

Patent for improvement in pocket check-books was *held* not limited to any particular manner of binding, and therefore infringed by a device in which the checks were unbound. *Norrington v. Merchants' Nat. Bank*, 25 *Fed. Rep'r*, 199.

Patent for improvements in tilting chairs was construed ; and *held*, that it included a chair whose seat and occupant were sup-

ported by a central spiral spring interposed between the seat frame and the base, but not a chair where the weight of the occupant was sustained by rockers, and the only function of the spring was to impart the tilting motion. *Bunker v. Stevens*, 26 *Fed. Rep'r*, 245.

A patent for an improvement in cultivators, consisting in runners pivoted to the wheel spindles or axle, so as to be held out of contact with the ground when the machine was used for field operations, and to be held in contact with the ground when the plows were suspended from the axle for transportation, was *held* not infringed by the use of hinged runners, which were folded up by hand for field operations, and folded down and locked for transportation. *Pattee Plow Co. v. Kingman*, 23 *Fed. Rep'r*, 801.

A patent for a combination, constituting an improvement in tables for tile machines, was *held* not infringed by similar mechanism not employing a flexible standard which appeared to be an indispensable part of the patented combination. *Leach v. Chandler*, 24 *Fed. Rep'r*, 791 ; 33 *Pat. Off. Gaz.* 237.

The use of celluloid in the fitting of artificial teeth was *held* not an infringement of a patent involving the use of hard rubber or vulcanite for the same purpose. *Goodyear Dental Vulcanite Co. v. Brightwell*, *MacArthur & M.* 74.

Patent for improvements in the construction of lumber-driers, was *held* infringed by a drier in the construction of which the main features of the patented devices were involved, and which was, in principle, the same as that intended to be described in the patents, notwithstanding some slight mechanical deviations from the specific directions given in the patents for the construction of the driers described. *Burdsall v. Curran*, 27 *Pat. Off. Gaz.* 1320

A patent covering the process of maturing and browning coffee in an uncured condition by subjecting it to the direct action of steam, is not infringed by the application of heat only to the coffee in that condition. *Arnold v. Phelps*, 29 *Pat. Off. Gaz.* 538.

XIV. JURISDICTION OF COURTS OVER INFRINGEMENTS.

183. *Distinction between the Legal and the Equitable Remedy.*

Different rules for the assessment of damages prevail in suits of equity, from those which are recognized in actions at law, but in all other respects the rights of the parties depend upon the same considerations. *Hudson v. Draper*, 4 *Fish. Pat. Cas.* 256 ; 4 *Cliff.* 178.

In case of infringement, the patentee may elect to sue at law for damages, usually measured by his royalty, or in equity—for profits and an injunction. *Cowing v. Rumsey*, 4 *Fish. Pat. Cas.* 275 ; *Bragg v. City of Stockton*, 27 *Fed. Rep'r*, 509.

Even when a suit at law will lie for infringement of a patent, proceedings in equity may usually be maintained, as affording a more practical and efficient remedy. *Hill v. Whitcomb*, 5 *Pat. Off. Gaz.* 430 ; 1 *Holmes*, 317 ; 1 *Bann. & A. Pat. Cas.* 34.

A bill for an accounting of profits is not maintainable unless a right to an injunction or some other substantive ground of equitable relief is shown. *Spring v. Domestic Sewing Machine Co.*, 13 *Fed. Rep'r*, 446 ; 22 *Pat. Off. Gaz.* 1445 ; 29 *Int. Rev. Rec.* 22 ; 14 *Rep'r*, 711.

A bill in equity will not lie solely to recover damages for the infringement of a patent ; but if it pray for an injunction, or for a discovery and account of profits, it will be maintained. *Vaughan v. East Tennessee, Virginia, &c. R. R. Co.*, 11 *Pat. Off. Gaz.* 789 ; 1 *Flippin*, 621 ; 2 *Bann. & A. Pat. Cas.* 537.

The principle upon which courts of equity have jurisdiction in patent cases, and upon which injunctions are granted to patentees, is not that there is no remedy at law in favor of those whose property is invaded, but that the remedy at law involves a multiplicity of suits, and does not afford means of taking an account of profits. *Motte v. Bennett*, 2 *Fish. Pat. Cas.* 642.

184. *Original Jurisdiction of Circuit Courts.*

The circuit courts shall have original jurisdiction as follows :

Ninth. Of all suits at law or in equity arising under the patent or copyright laws of the United States. *Rev. Stat.* § 629.

Originally the circuit courts had not jurisdiction of a suit for infringement of patents. *Livingston v. Van Ingen*, 1 *Paine*, 45 ; 4 *Am. L. J.* 46. This jurisdiction was conferred by section 7 of the act of 1836. *Smith v. Plymouth*, 4 *West. L. J.* 49 ; *Goodyear v. Hullihen*, 3 *Fish. Pat. Cas.* 251 ; ? *Hughes*, 492. See note to *Rev. Stat.* 4921, *post*.

When a controversy turns, not upon the letters patent themselves, but only upon contracts concerning them, the circuit court has no jurisdiction except as citizenship of the parties may give it. The subject-matter of such contracts, where neither the validity of the patent nor a question of infringement of it is involved, does not give a court of the United States jurisdiction ; such court can act only where rights of the patentee under the patent laws are directly brought in question. *Burr v. Gregory*, 2 *Paine*, 426 ; *Landolph v. Robinson*, 2 *N. J. L. J.* 171 ; *Teas v. Albright*, 13 *Fed. Rep'r*, 406 ; 28 *Int. Rev. Rep'r*, 290 ; 22 *Pat. Off. Gaz.* 2069 ; 14 *Rep'r*, 712.

In a suit where all the parties to the suit were citizens of New York, the circuit court was *held* powerless to decree that defendant execute to plaintiff a transfer of letters patent. *Perry v. Littlefield*, 17 *Blatchf.* 272 ; 17 *Pat. Off. Gaz.* 51 ; 4 *Bann. & A. Pat. Cas.* 624.

Where one circuit court has sustained a patent, another circuit court should, unless plain mistake be shown, follow such decision in a suit upon the same patent in which the same evidence is relied on. *Hammerschlag v. Garrett*, 9 *Fed. Rep'r*, 43 ; 27 *Int. Rev. Rec.* 309. S. P., *McCloskey v. Hamill*, 15 *Fed. Rep'r*, 750 ; 23 *Pat. Off. Gaz.* 2122.

Where suit is brought in a circuit court upon a patent the validity of which has been sustained by judgments of other circuit

courts, the respect due to such decisions and the importance of consistency and uniformity of decisions in courts of co-ordinate jurisdiction where the same subject-matter is involved, require the court to adopt such judgments. *American Ballast Log Co. v. Cotter*, 11 *Fed. Rep'r*, 728 ; 31 *Pat. Off. Gaz.* 1030.

Where a patent has been established by a decision of a circuit court, after careful consideration, that decision is entitled to very great weight in a subsequent application, either before the same court or any other, for a preliminary injunction or for any preliminary relief. *American Middlings Purifier Co. v. Christian*, 3 *Bann. & A. Pat. Cas.* 42.

The provision of section 11 of the judiciary act of 1789 (now Rev. Stat. 739), that no civil suit shall be brought against an inhabitant of the United States, in any other district than that in which he is an inhabitant or in which he is found at the time of serving the writ, applies to suits for infringement, notwithstanding the legislation of Congress giving exclusive jurisdiction of such writs to courts of the United States. *Chaffee v. Hayward*, 20 *How.* 208; *Allen v. Blunt*, 1 *Blatchf.* 480; *Day v. Newark India Rubber Manuf. Co.*, 1 *Blatchf.* 628. The decisions have settled that, under section 11, in order to give jurisdiction to a circuit court, the defendant must be an inhabitant of the district in which the suit is brought, or be found within that district at the time of service of original process. *Day v. Newark India Rubber Manuf. Co.*, *supra*. The provision applies to a suit in equity brought under Rev. Stat. § 4915. *Butterworth v. Hill*, 114 *U. S.* 128.

For the jurisdiction of district courts over actions for penalties for false marking, see Rev. Stat. § 4901, *ante*.

185. *Their Jurisdiction does not embrace Suits to enforce Licenses.*

A suit, the real nature and object of which appears upon hearing to be to recover an additional license fee or royalty for the use of a patent under an agreement between a patentee and the defendant, and which does not involve the validity of the patent, is not within the jurisdiction of the circuit court as a suit under the patent laws, but can only be entertained there upon the ground of citizenship of the parties. The fact that the pleadings may aver facts sufficient to authorize taking cognizance of the suit, is not conclu-

sive ; if it appears at the trial that no question arising under the patent laws is involved in the case, the suit must be dismissed. *Blanchard v. Sprague*, 1 *Cliff.* 288.

The subject-matter of an action to enforce or annul a license to use a patent right, is not within the jurisdiction of the courts of the United States; and is not brought within their jurisdiction by the fact that the controversy ultimately turns upon the validity of the patent ; to give a circuit court jurisdiction of such a cause the plaintiff must aver himself and defendant to be citizens of different States. *Merserole v. Union Paper Collar Co.*, 6 *Blatchf.* 358; 3 *Fish. Pat. Cas.* 483. S. P., *Goodyear v. Union India Rubber Co.*, 4 *Blatchf.* 63. And see *McKay v. Jackman*, 17 *Fed. Rep'r*, 641; 24 *Pat. Off. Gaz.* 1177; 19 *Rep'r*, 163. Whether a suit be one by a licensor, to enforce the covenants contained in a license granted under a patent, or by a licensee, to destroy and annul a license and its covenants, the rule is the same ; the suit is not within the jurisdiction of a circuit court. *Ib.*

The courts of the United States have no power under the patent laws to determine upon the fulfillment of a contract of license. *Tilghman v. Hartell*, 11 *Phila.* 500 ; 2 *Bann. & A. Pat. Cas.* 260. See 99 *U. S.* 547.

Where a license provides that the patentee may terminate it by giving notice, and he does so, his suit to enjoin subsequent sales by the licensee is a suit for infringement, of which the circuit court has jurisdiction irrespective of citizenship of parties, rather than a suit to establish rights under the license. *Smith v. Standard Laundry Machinery Co.*, 19 *Fed. Rep'r*, 825; 20 *Blatchf.* 360.

A license was granted under a patent, with covenants that the licensee should pay certain tariffs, keep correct accounts, and permit his books to be examined, but there was no express provision that if the covenants were broken, the rights granted should revert to the licensor ; and a bill was filed by the licensor against the licensee, praying for a decree that the covenants should be performed, and for an injunction to prevent the use of the patent under the license, until the covenants should be performed ; but the citizenship of the parties was not such as to give jurisdiction. It was *held*, that the suit was not one to prevent the violation of any right secured by any law of the United States, but was one to prevent the violation of the rights secured by the covenants ; and therefore the court had no jurisdiction of the case from the subject matter. *Goodyear v. Union India Rubber Co.*, 4 *Blatchf.* 63.

B., a patentee, granted to S. the exclusive right to make and vend the invention during the life of the patent, for a royalty; and S. sued B. in the circuit court sitting in equity, alleging that he was infringing the patent. It was *held* that whether S. was a licensee or a grantor, he was suing B. on an infringement, and therefore the court had jurisdiction of the suit. *Stanley Rule, &c. Co. v. Bailey*, 14 *Blatchf.* 510; 3 *Bann. & A. Pat. Cas.* 297.

186. *Or other Contracts.*

The jurisdiction of courts of the United States in reference to patent rights, does not extend to protecting one who purchases a patented article for the purpose of using it in right of property. A purchaser of a patented article exercises no rights created by the acts of Congress, nor does he derive title by virtue of the franchise or privilege granted to the patentee. When the machine passes to the hands of the purchaser, it is no longer under the protection of Congress, but becomes private property, protected by the laws of the State where it is situated; and if the right to it is infringed, redress is to be sought in the courts of the State, according to the laws of the State, and not in the courts of the United States, nor under the laws of Congress. *Bloomer v. McQuewan*, 14 *How.* 539, 550; *Chaffee v. Boston Belting Co.*, 22 *How.* 217.

A suit between citizens of the same State can not be sustained in the circuit court as arising under the patent laws of the United States, where the defendant admits the validity and his use of the plaintiff's letters patent, and a subsisting contract is shown, governing the rights of the parties in the use of the invention. Relief in such a suit is founded on the contract, and not on those laws. *Hartell v. Tilghman*, 99 *U. S.* 547.

The circuit court cannot take jurisdiction of a suit between citizens of the same State, brought to recover for violation of a contract, merely because the subject-matter of the contract is a patent right.* *Goodyear v. Day*, 1 *Blatchf.* 565. *S. P., Hill v. Whitcomb*, 5 *Pat. Off. Gaz.* 430; 1 *Holmes*, 317; 1 *Bann. & A. Pat. Cas.* 34; *Ingalls v. Tice*, 14 *Fed. Rep'r*, 552; 22 *Pat. Off.*

* Upon like grounds it has been *held* that a suit brought upon an agreement for the publication of a manuscript, to determine the rights of the parties under

it, is not a suit under the copyright laws, of which the circuit court can take jurisdiction by reason of the subject matter. *Pulte v. Derby*, 5 *McLean*, 328.

Gaz. 2160 ; 14 *Rep'r*, 714 ; *Nesmith v. Calvert*, 1 *Woodb. & M.* 34 ; *Burr v. Gregory*, 2 *Paine*, 426 ; *Brooks v. Stolley*, 3 *McLean*, 523 ; 2 *West. L. J.* 396.

One who purchases a patented article for the purpose of using it, stands on different grounds from a purchaser of the right to make and sell it. In the former case, when the patented article rightfully passes from the patentee to the purchaser, the article is no longer within the limits of the monopoly, or under the protection of the patent act. Redress for injury in such a case must be sought in the State courts. *Aiken v. Manchester Print Works*, 2 *Cliff.* 435.

Where the controversy does not involve the validity of letters patent, but turns upon the effect and force of some contract under them, the State courts are the proper tribunals for the adjudication and the Federal courts cannot properly assert jurisdiction, unless the residence or citizenship of the parties confers it. *Consolidated Fruit Jar Co. v. Whitney*, 2 *Bann. & A. Pat. Cas.* 30.

An original patentee may, in selling rights by districts, prohibit each assignee from vending the article beyond his district. But, in such case, his remedy is on the contract, and not under the patent law. *Boyd v. Brown*, 3 *McLean*, 295:

187. *Jurisdiction of the Supreme Court of the District of Columbia.*

The powers and jurisdiction of the supreme court of the district in patent cases are the same (as well in equity as at law), as those of a circuit court. *Cochrane v. Deener*, 94 *U. S.* 780.

That the supreme court of the district has power to issue a mandamus, but whether the power is so broad as to embrace compelling the issue of a patent, see *Secretary v. McGarrahan*, 9 *Wall.* 298 ; *United States v. Schurz*, 102 *U. S.* 378, 393.

The supreme court of the District of Columbia, being charged with the special jurisdiction of appeals from the commissioner of patents, must decide on the merits, with the assistance of determinations upon the same subjects of the circuit and district courts of the United States ; but the decrees of those courts will not be considered as *res judicata*. *Schillinger v. Cranford*, 2 *Cent. Rep'r*, 680.

For the appeals allowed to be taken by a party dissatisfied with

a decision of the commissioner, to the supreme court of the district, see *Rev. Stat.* §§ 4911–4914 ; *Id.* § 780 ; *ante.*

For the jurisdiction of a bill in equity, filed to procure issue of a patent which the commissioner has refused, see *Rev. Stat.* § 4915, *ante.*

188. *Jurisdiction of the Court of Claims.*

The court of claims cannot take jurisdiction of claims against government founded on mere torts (*Milwaukee, &c. Canal Co. v. United States*, 1 *Ct. of Cl.* 187 ; *Spicer v. United States*, *Id.* 316 ; *Dennis v. United States*, 2 *Ct. of Cl.* 210 ; *Johnson v. United States*, 2 *Ct. of Cl.* 391); and, therefore, cannot entertain a suit founded on an infringement considered as a tort merely ; but may entertain a suit as founded on contract, where the circumstances under which the invention was used are such as warrant a finding of a promise, express or implied, to make compensation, or pay a license fee. See *ante*, 7.

189. *Appellate Jurisdiction of Supreme Court.*

The supreme court shall have appellate jurisdiction in the cases hereinafter specially provided for. *Rev. Stat.* § 690.

The right of appeal or error, without regard to value, given by *Rev. Stat.* § 699, in cases arising under the patent laws, applies to controversies between a patentee and alleged infringers, as well as to those between rival patentees (*Philip v. Nock*, 13 *Wall.* 185) ; but does not apply to controversies arising upon enforcement of contracts relative to patents. *Brown v. Shannon*, 20 *How.* 55.

190. *It is not Dependent on Amount in Controversy.*

A writ of error may be allowed to review any final judgment at law, and an appeal shall be allowed from any final decree in equity hereinafter mentioned, without regard to the sum or value in dispute :

First. Any final judgment at law or final decree in equity of any circuit court, or of any district court acting as a circuit court, or of the supreme court of the District of Columbia, or of any Territory, in any case touching patent rights or copyrights. *Rev. Stat.* § 699.

The supreme court has no appellate jurisdiction of a suit to enforce the specific performance of a contract in relation to a patent unless the value of the matter in controversy exceeds the jurisdictional amount; although it may exercise jurisdiction when a far less amount is in dispute, if the suit be for the infringement of a patent right. *Brown v. Shannon*, 20 *How.* 55.

191. *Exclusive Jurisdiction of Courts of the United States.*

The jurisdiction vested in the courts of the United States in the cases and proceedings hereinafter mentioned, shall be exclusive of the courts of the several States :

Fifth. Of all cases arising under the patent right or copyright laws of the United States. *Rev. Stat.* § 711.

State courts, although they may adjudicate on assignments and other contracts involving patent rights, have no jurisdiction to enjoin infringement of patent, even in a case depending on extent of the right which has been vested by an assignment. The jurisdiction of the United States courts is exclusive. *Continental Store Service Co. v. Clark*, 1 *Cent. Rep'r*, 530.

XV. RIGHT OF ACTION AT LAW FOR DAMAGES.192. *Suits for Infringement ; Damages.*

Damages for the infringement of any patent may be recovered by an action on the case, in the name of the party interested, either as patentee, assignee, or grantee. And whenever in any such action a verdict is rendered for the plaintiff, the court may enter judgment thereon for any sum above the amount found by the verdict as the actual damages sustained, according to the circumstances of the case, not exceeding three times the amount of such verdict, together with the costs. *Rev. Stat.* 4919.

193. *Limitation of Time for bringing an Action.*

While there is no act of Congress limiting the time for suing under the patent laws, the statute of limitations of the State in which the court is held, governs, so far at least as actions at law are concerned. The act of Congress of July 8, 1870, c. 230, § 55 (10 *Stat.* 206), prescribed a limitation of six years. But this statute is generally considered to have been repealed by the omission of it from the Revised Statutes. See *Sayles v. Oregon Central R. R. Co.*, 6 *Sawyer*, 31 ; 3 *Rep'r*, 424 ; 4 *Bann. & A. Pat. Cas.* 429 ; *Sayles v. Richmond, Fredericksburgh, &c. R. R. Co.*, 4 *Bann. & A. Pat. Cas.* 239 ; *Sayles v. Oregon Central R. R. Co.*, 8 *Rep'r*, 424 ; *Vaughn East Tennessee, Virginia, &c. R. R. Co.*, 11 *Pat. Off. Gaz.* 789 ; 1 *Flippin*, 621 ; 2 *Bann. & A. Pat. Cas.* 537 ; *Hayden v. Oriental Mills*, 15 *Rep'r*, 742 ; 24 *Pat. Off. Gaz.* 601 ; 17 *Fed. Rep'r*, 605 ; *Rich v. Ricketts*, 7 *Blatchf.* 230. But the decisions have been somewhat conflicting. See *Hayward v. St. Louis*, 11 *Fed. Rep'r*, 427 ; 3 *McCrary*, 614 ; *Anthony v. Carroll*, 9 *Pat. Off. Gaz.* 199 ; 2 *Bann. & A. Pat. Cas.* 195 ; *Read v. Miller*, 2 *Biss.* 12 ; 3 *Fish. Pat. Cas.* 310 ; *Sayles v. Louisville City R. Co.*, 9 *Fed. Rep'r*, 512 ; *Sayles v. Dubuque & Sioux City R. Co.*, *Id.* 516, *note* ; 5 *Gill*, 561.

The above mentioned phrases of the question of the application of the statute of limitations have lost interest by lapse of time. The present question of importance is whether to consider the State statute as applying directly in the case of an action at law, and by an analogy to a suit in equity, to actions and suits now brought. The affirmative is held in *Hayden v. Oriental Mills*, 15 *Rep'r*, 742 ; 24 *Pat. Off. Gaz.* 601 ; 17 *Fed. Rep'r*, 605 ; *Parker v. Hawk*, 2 *Fish. Pat. Cas.* 58 ; *Rich v. Ricketts*, 7 *Blatchf.* 239 ; *Sayles v. Louisville City R. Co.*, 9 *Fed. Rep'r*, 512 ; *Sayles v. Dubuque & Sioux City R. Co.*, *Id.* 516, *note*. Contrary views have been expressed in *Anthony v. Carroll*, 2 *Bann. & A. Pat. Cas.* 195 ; 9 *Pat. Off. Gaz.* 199 ; *Parker v. Hallock*, 2 *Fish. Pat. Cas.* 543, *note* ; *Wetherill v. New Jersey Zinc Co.*, 1 *Bann. & A. Pat. Cas.* 489 ; *Collins v. Peebles*, 2 *Fish. Pat. Cas.* 540. See *Reed v. Miller*, 2 *Biss.* 12 ; 3 *Fish. Pat. Cas.* 310.

194. *Nature of the Remedy by Action at Law.*

The sale of machines embodying the patented inventions of another, to one for use, is an invasion of the patentee's rights, and such a conversion of his property as will render the party so selling the invention liable in an action for tort ; though in such case, the plaintiff may waive the tort and sue in assumpsit for the money received from the sale. *Steam Stone Cutter Co. v. Sheldons*, 15 *Fed. Rep'r*, 608 ; 24 *Pat. Off. Gaz.* 703. In an action or proceeding for the money, the measure of damages would be the amount of money received, not the amount of damages done, and all right of recovery beyond that would be waived. This is the effect of waiving the tort. The recovery of satisfaction in either form would pass the right to that for which satisfaction was had, and there could be no damages beyond. Consequently, when the plaintiff has recovered and received satisfaction for the tort committed, the title to so much of his property as was wrongfully converted, will have passed by the sale and conversion, and no damages will accrue to him on account of further use of that property. *Ib.*

The infringement of a patent is a tort ; but the wrongful act not being committed with direct force, the form of action is that description of tort called trespass on the case. *Stein v. Goddard*, *McAll.* 82. A reiteration of infringements of a patent, like a

repetition of torts of any other kind, may be sued for in one action. *Wilder v. McCormick*, 2 *Blatchf.* 31.

The granting of a patent confers upon the patentee the right to bring suits thereon for its infringement, and a court is not authorized to grant an injunction to restrain him from so doing pending a suit to invalidate his patent, especially when such patent was granted after an interference. *Asbestos Felting Co. v. United States, &c. Felting Co.*, 10 *Pat. Off. Gaz.* 828 ; 13 *Blatchf.* 453 ; 2 *Bann. & A. Pat. Cas.* 369

195. *Right of Action of Patentee.*

An action for an infringement cannot be maintained by an inventor before patent obtained. *Gayler v. Wilder*, 10 *How.* 477.

By the statute (act of 1836, § 14, last cl.), requiring an action for damages for infringement of a patent to be brought in the name of the person interested, the right of action is given to the person owning the patent at the time the infringement is committed ; and a transfer of the exclusive right is no bar to an action to recover damages for an infringement committed before such transfer. *Moore v. Marsh*, 7 *Wall.* 515.

Where a patentee has a partner in the manufacture and sale of his patented article, such patentee is entitled to recover full damages for an infringement, notwithstanding such partnership. *Yale Lock Manuf. Co. v. Sargent*, 117 *U. S.* 536.

No person who is not the patentee or such an assignee or grantee as the statute points out can bring a suit for profits or infringement. And a claim to recover profits or damages for past infringement cannot be severed from the title by assignment or grant so as to give a right of action for such claim in disregard of the statute. The profits or damages for infringement cannot be sued for except on a basis of a title as patentee, or as such assignee, or grantee to the whole or a part of the patent ; nor on the basis merely of an assignment of a right to a claim for profits and damages severed from such title. *Gordon v. Anthony*, 16 *Pat. Off. Gaz.* 1135.

An action for infringement must be brought in the name of the real and beneficial party in interest. *Goldsmith v. American Paper Collar Co.*, 2 *Fed. Rep'r*, 239 ; 18 *Blatchf.* 82 ; 18 *Pat. Off. Gaz.* 192 ; 9 *Rep'r*, 640 ; 5 *Bann. & A. Pat. Cas.* 300.

A patentee is entitled to recover for a violation of his patent,

no matter what private agreement subsists between him and any other one, as to an interest in his invention, unless he has made a legal assignment and transfer of his interest in the invention. *Park v. Little*, 3 *Wash.* 196.

Two patents cannot support or supplement each other ; and in a suit for infringement, the question is whether the defendant uses the combination shown in each patent, and not whether parts in each combination can be found in each patent. *Blades v. Rand, McNally & Co.*, 27 *Fed. Rep'r*, 93.

A patentee whose rights are fully covered and protected by a suit he has brought against a manufacturer may, in a proper case, be enjoined from suing purchasers from the manufacturer. *Birdsall v. Hagerstown Agricultural Implement Manuf. Co.*, 1 *Hughes*, 64.

A patentee who has sold the exclusive right to use his invention for a term of years short of the full life of the patent can maintain an action for an infringement during such term. The petition in such action, however, is demurrable, unless it affirmatively shows that the alleged infringer is not using the invention under the authority of the licensee. *Still v. Reading*, 9 *Fed. Rep'r*, 40 ; 4 *Wood's*, 345 ; 20 *Pat. Off. Gaz.* 1025.

A patentee may reserve to himself the right to prosecute for piracies within the particular district where the right of use is conveyed. But if he afterward assigns all his right to such district, owner of the patent may sue. *Bicknell v. Todd*, 5 *McLean*, 236.

196. *Of Joint, or Deceased, Patentee.*

Upon the death of the patentee his interest passes to the personal representative in the State of the domicile of the patentee, and remains in him until assignment to the parties beneficially interested therein. In order that he may sue for an infringement it is not necessary that letters patent should be taken out in the State in which the suit is brought. *Hodge v. North Missouri R. R.*, 1 *Dill.* 103 ; 34 *Fish. Pat. Cas.* 161.

A suit by one of two joint inventors to establish his right and interest as such in an improvement for which his fellow inventor has fraudulently taken out a patent alone, and to restrain him from using the patent except for their joint benefit, is within the juris-

diction of the circuit court irrespective of citizenship of parties. *Duke v. Graham*, 19 *Fed. Rep'r*, 647.

Actions may be maintained by joint owners of a patent, who have not transferred their claims for damages and profits, to recover past damages for infringement within the period of time of their ownership, though when the suit was instituted neither of the joint owners had any interest in the title to the patent. *Spring v. Domestic Sewing Machine Co.*, 13 *Fed. Rep'r*, 446 ; 22 *Pat. Off. Gaz.* 1445 ; 29 *Int. Rev. Rec.* 22 ; 14 *Rep'r*, 711.

S. and W. conveyed to S. and B. all their right, title and interest in and to an invention, within the State of Massachusetts, except the right to build the patented machines. In a suit against one who had infringed by making the patented invention, it was *held*, that the suit was properly brought in the name of S. and W., without joining S. and B. *Sanford v. Messer*, 2 *Pat. Off. Gaz.* 470 ; 5 *Fish. Pat. Cas.* 411

197. *Of Assignee.*

The grantee of an exclusive right under a patent, though such right may be limited to the use of a certain number of machines within a certain territory or district, has such an exclusive right as will enable him to sue for an infringement of the patent within that district, under the act of 1836, § 14. *Wilson v. Rousseau*, 4 *How.* 646, 686 ; *Nellis v. Pennoch Manuf. Co.*, 13 *Fed. Rep'r*, 451 ; 28 *Int. Rev. Rec.* 297 ; 22 *Pat. Off. Gaz.* 1131 ; 14 *Rep'r*, 260.

An assignor who retains an interest in a patent may be joined as a party complainant with an assignee of the exclusive interest in a certain territory in which such assignor has no interest, in a bill for an injunction to restrain the violation of the patent in that territory. *Woodworth v. Wilson*, 4 *How.* 712. Compare *Railroad Co. v. Trimble*, 10 *Wall.* 367 ; *Brooks v. Bicknell*, 3 *McLean*, 250 ; 1 *West. L. J.* 150 ; *Whittemore v. Cutter*, 1 *Gall.* 429.

To enable an assignee of a sectional interest in a patent to sue in his own name, he must have the exclusive right, or entire and unqualified monopoly which the patentee held in the territory specified, excluding the patentee as well as others. *Gayler v. Wilder*, 10 *How.* 477 ; *Blanchard v. Eldridge*, 1 *Wall. Jr.* 387. S. P., *Littlefield v. Perry*, 21 *Wall.* 205 ; *Washburn v. Gould*, 3 *Story*, 122 ; 1 *West. L. J.* 465 ; 7 *L. Rep'r*, 276.

In case of infringement subsequent to an assignment of an

undivided part of a patent, action must be brought in the joint names of the parties owning the entire interest. Per CLIFFORD, J. *Moore v. Marsh*, 7 *Wall.* 515.

Under the patent laws of the United States, an assignee of a patent must be regarded as acquiring his title to it with a right of action in his own name, only by force of the statute. *Suydam v. Day*, 2 *Blatchf.* 20.

An exclusive right of action exists in favor of a sole assignee of a patent only in two cases: namely, where he acquires by assignment the whole interest in the patent; or, by a grant or conveyance, the whole interest within some particular district or territory. *Suydam v. Day*, 2 *Blatchf.* 20. And see *Tyler v. Tuel*, 6 *Cranch*, 324; *Washburn v. Gould*, 3 *Story*, 122; 1 *West. L. J.* 465; 7 *L. Rep'r*, 276.

An absolute assignment of a patent, for a valuable consideration, although limited to a specified territory, if it is, as to such district, unqualified, and excludes the patentee from any interest in or control over the rights secured by the letters patent, is a grant of the exclusive right under the patent to use and to grant to others to make and use the thing patented within and throughout a specified part of the United States, and warrants a suit in the name of the grantee or assignee for an infringement within the territory named. *Perry v. Corning*, 7 *Blatchf.* 195.

A grant of a right, though exclusive, to manufacture or sell under a patent within a limited territory, does not carry an interest in the patent such as will enable the grantee to maintain a suit for infringements, though committed within that territory. *Ingalls v. Tice*, 14 *Fed. Rep'r*, 297; 22 *Pat. Off. Gaz.* 2160; 13 *Rep'r*, 676.

The assignee of an exclusive right to use, but not to make the thing patented, within specified territory, may maintain an action against an infringer in his own name. *Chambers v. Smith*, 5 *Fish. Pat. Cas.* 12; 7 *Phila.* 575.

A declaration in a patent suit which avers an assignment of the invention before the issuing of the patent, and claims title under such an assignment, is not demurrable; such assignment being sufficient in law. *Rathbone v. Orr*, 5 *McLean*, 131.

Under the provision of Rev. Stat. § 4919, that damages for infringement may be recovered in the name of the party interested, an assignee of a patent whose assignment includes, in terms, all claims for prior infringements, may sue in his own name for all infringements, including those of date prior to the assignment to

him. *Adams v. Bellaire Stamping Co.*, 25 *Fed. Rep'r*, 270 ; 33 *Pat. Off. Gaz.* 623.

The right to sue for infringements of a patent is assignable. It is not within the rule prohibiting assignments of unliquidated damages. *Jenkins v. Greenwald*, 1 *Bond*, 126 ; 2 *Fish. Pat. Cas.* 37 ; *Hamilton v. Rollins*, 4 *L. & Eq. Rep'r*, 561 ; 5 *Dill.* 495 ; 3 *Bann. & A. Pat. Cas.* 157.

The assignees of a patent, though their title accrues to them by several deeds, may all join, as the holders of the title, in an action for the recovery of damages for an infringement of the patent. *Stein v. Goddard*, *McAll.* 82.

Certain instruments,—*Held* not to amount to such an assignment by a patentee for a process patent, as to preclude him from suing third persons who infringe his patent. *Downton v. Yaeger*, *Milling Co.*, 3 *McCrary*, 414.

Where a patent has been assigned for a particular territory, the assignor retaining the right to use in common with assignee in part of such territory, the assignee may sue alone for an infringement outside of the reserved territory. *Hobbie v. Smith*, 27 *Fed. Rep'r*, 656.

The claims for profits or damages arising from infringement prior to a purchase of the patent are choses in action, and the assignee takes the title subject to all the equities existing against the assignors. Such claims do not pass by a mere assignment of the patent. The assignee of a patent seeking to recover for infringements before the assignments must allege an assignment of the claims for past infringement. *New York Grape Sugar Co. v. Buffalo Grape Sugar Co.*, 18 *Fed. Rep'r*, 638 ; 25 *Pat. Off. Gaz.* 1076 ; 21 *Blatchf.* 519.

The mere assignment of a patent would give the assignee no right to damages or profits already accrued ; otherwise where the language of the assignment, or the circumstances attending it, show that the parties did not intend to transfer such already existing claims. *Merriam v. Smith*, 11 *Fed. Rep'r*, 588 ; *Dibble v. Auger*, 7 *Blatchf.* 86. See *Consolidated O. W. P. Co. v. Eaton*, 12 *Fed. Rep'r*, 865.

A suit may be maintained to recover past damages for infringement, although at the time when the suit was brought, the parties plaintiff had parted with their interest in the patent. *Spring v. Domestic Sewing Mach. Co.*, 22 *Pat. Off. Gaz.* 1445 ; 13 *Fed. Rep'r*, 446 ; 29 *Int. Rev. Rec.* 22 ; 14 *Rep'r*, 711.

198. *Licensee.*

A licensee cannot, as such, sue for an infringement, but must assert his rights in the name of the original patentee. *Paper Bag Cases*, 105 *U. S.* 766; *Grover & Baker Sewing Machine Co. v. Sloat*, 2 *Fish. Pat. Cas.* 112.

A mere license to make and use, without the right to grant to others to make and use the thing patented, though exclusive, will not authorize the licensee to bring suit in his own name for infringement, without joining the patentee. *Wilson v. Chickering*, 14 *Fed. Rep'r*, 917; 23 *Pat. Off. Gaz.* 1730; *North v. Kershaw*, 4 *Blatchf.* 70; *Bogart v. Hinds*, 25 *Fed. Rep'r*, 484; 33 *Pat. Off. Gaz.* 1268. S. P., *Cottle v. Krementz*, 25 *Fed. Rep'r*, 494.

Where an exclusive license has been granted, the licensee and the patentee are both necessary parties to a suit for infringement. *Hammond v. Hunt*, 4 *Bann. & A. Pat. Cas.* 111.

An action at law, brought in the name of the patentee for the benefit of his licensee, cannot be discontinued by the nominal plaintiff; but the real parties in interest will be permitted to show their interest, in answer to a release by the nominal plaintiff. The nominal plaintiff may, however, claim indemnity against costs, and the court, on a proper application, will provide for it. *Goodyear v. Bishop*, 4 *Blatchf.* 438; 2 *Fish. Pat. Cas.* 96.

Where a license includes a large number of patents, and provides that the licensee shall pay a stipulated royalty on all machines manufactured by him embodying in their construction or mode of operation the inventions and improvements shown and described in each, all or either of said letters patent," as long as the licensee uses either of the patents he will be liable to pay the stipulated royalty. *Pope Manf. Co. v. Owsley*, 27 *Fed. Rep'r*, 100.

Where a license to manufacture and sell under a patent is subject to revocation by written notice by the licensor, a postal card reading: "Your royalty return for February has not come to hand. Failure to forward same for five days from March 10th, subjects your license to revokement," is not notice in writing of the revocation or termination of the license. *Ib.*

A reservation of a right to sue for a royalty, held inconsistent with a license to use which accompanied a sale of the thing patented, by the patentee. *Bigelow v. Louisville*, 3 *Fish. Pat. Cas.* 602.

Money voluntarily paid under license for use of a patent cannot be recovered on subsequent determination of invalidity of patents. *Schwarzenbach v. Odorless Excavating Co.*, 2 *Cent. Rep'r*, 859.

199. *Who may or should be Sued.*

Where a structure consisting of several parts is patented as a combination, one who manufactures and sells some of the parts, they being useless without the residue, with the understanding and intent that such residue should be supplied by another and the whole go into use in its complete form, is liable as an infringer. *Wallace v. Holmes*, 9 *Blatchf.* 65 ; 1 *Pat. Off. Gaz.* 117. S. P., *Craig v. Fisher*, 2 *Sawyer*, 345; 5 *Pac. L. R.* 52.

One joint owner of a patent for a machine can use and sell machines made according to the patent, only in respect to his own right. If he uses or sells them without the authority of his co-owner as respects the right of the latter, he is liable to an action by such co-owner for an infringement of the patent. In such action the plaintiff may recover his actual and proper damages, proportioned to the value and extent of his undivided interest, without regard to the amount which his co-proprietor has received by means of the infringement. *Pitts v. Hall*, 3 *Blatchf.* 201.

An agent selling an article which infringes on the plaintiff's patent may be joined as a party defendant with the one who manufactures such article, as they are joint trespassers, and are liable to be sued jointly. *Buck v. Cobb*, 1 *Brunner Col. Cas.* 550.

That the assignee of gains and profits assigned after the decree awarding them can recover them in his own name, see *Campbell v. James*, 5 *Bann. & A. Pat. Cas.* 630.

The use of a patented invention by an officer of the government, in the performance of his duties for the benefit of the government, may render him liable as an infringer. *Campbell v. James*, 17 *Blatchf.* 42 ; 18 *Pat. Off. Gaz.* 979 ; 4 *Bann. & A. Pat. Cas.* 456 ; 8 *Rep'r*, 455 ; reversed on another point, 104 *U. S.* 357.

Armor for a vessel was constructed by Q., under an order given for that purpose by the secretary of the navy, and was applied to a vessel built for the United States, and was paid for to Q. by the secretary of the navy. It was *held*, that although the armor might have been the same in arrangement as that covered by a patent for the application or employment of armor on vessels, Q.

was not liable in a suit on the patent for any value which the armor may have been to the United States. The putting of the armor on a vessel owned by the United States was not a making, or using, or a vending to be used, of the armor. *Heaton v. Quintard*, 7 *Blatchf.* 73.

A mere workman employed by a person other than the patentee to make parts of a patented article is not liable to an action for damages. *Delano v. Scott*, *Gilp.* 480.

Manufacturers of an article are not liable as infringers where the infringement consists in a special use of it made by one who procured it from them. Their privity with the unlawful use will not be presumed. *Keystone Bridge Co. v. Phœnix Iron Co.*, 9 *Phila.* 374.

Action against administrator survives, if there has been an infringement; the latter being held as a trustee for the owner. *Atterbury v. Gill*, 2 *Illippin*, 239; 13 *Pat. Off. Gaz.* 276.

An action for infringement will lie against the parties making a machine which is patented, though such persons are employed by others to do the work. But if such parties have acted without a knowledge of the plaintiff's rights, only nominal damages should be found against them. *Bryce v. Dorr*, 3 *McLean*, 582.

A part owner of a patent has no right to use an infringing device. If he does, he is liable to his co-owner for the wrong done. *Herring v. Gas Consumers' Assoc.*, 9 *Fed. Rep'r*, 556; 3 *McCrary*, 206; 21 *Pat. Off. Gaz.* 203.

Suit cannot be sustained against an administrator to charge the estate for his having undertaken to sell patented articles in violation of a patent right. He cannot charge the estate for a tort. *Thompson v. Canterbury*, 2 *McCrary*, 332; 12 *Fed. Rep'r*, 485.

One who is manufacturing and selling a patented article under a license from the patentee cannot be sued as an infringer; the only remedy which the patentee can claim against him is such as may be afforded by the contract of license. *Kelly v. Porter*, 17 *Fed. Rep'r*, 519; 8 *Sawyer*, 482.

In what case, and to what extent a landlord is liable for an infringement because the manufacture is carried on in his building and he receives a rent graduated by the amount of sales, see *Starrett v. Athol Machine Co.*, 14 *Fed. Rep'r*, 910; 23 *Pat. Off. Gaz.* 1729.

One who sells a compound he knows cannot be applied without

making the user a trespasser, is accessory to the infringement. *Albertine Co. v. Payne*, 27 *Fed. Rep'r*, 559

200. *Cases involving Corporations.*

A town which had maintained a ferry in violation of an exclusive franchise granted to a corporation by the legislature of the State was *held*, liable for damages. *East Hartford v. Hartford Bridge Co.*, 10 *How.* 541.

The only persons who can be held for damages for the infringement of a patent are those who own or have some interest in the business of making, using or selling the thing which is an infringement; an action at law cannot be maintained against the directors, shareholders or workmen of a corporation which infringes a patented improvement. *United Nickel Co. v. Worthington*, 13 *Fed. Rep'r*, 392; 23 *Pat. Off. Gaz.* 939.

The board of directors of a railroad company authorized their chairman to make a certain contract. Pursuant to that authority he made and signed in behalf of the corporation a contract with a manufacturer for the construction of a number of cars, to be delivered to the railroad company. The cars were to be furnished with a certain patented improvement, which the manufacturer had no license to use. In a suit by the patentee against the chairman for an infringement of the patent, it was *held*, that the contract of the chairman could not be construed as authorizing or contemplating any trespass upon the rights of the patentee, and that he was not liable. The fact that the cars were run on the road after completion gave no right of action against the chairman, as his authority extended only to the making of the contract. *Lightner v. Brooks*, 2 *Cliff.* 287.

A transportation company was organized for the purpose of providing a through line for freight between certain cities in the eastern and others in the western States; and contracted with the companies owning railroads between those cities, to furnish cars for use throughout the line. The defendant was the general agent of the transportation company, with power to contract for the carriage of goods, but without power to say in what cars they should be carried, or what axle-boxes should be used on the cars. Axle-boxes which infringed the plaintiff's patent were used on the cars in which the goods were so forwarded by the transportation com-

pany. It was *held*, that defendant was not liable to an action as an infringer of the plaintiff's patent. *Lightner v. Kimball*, 1 *Low*. 211. The defense of the agent in such a case is not that he is the servant of the transit company in doing the wrong, but that he is a stranger to the wrong done; that he has neither the property, the custody, nor the control of the cars in which this contrivance is used; that he can neither command the use nor the discontinuance of it; and that his duties have relation to an entirely distinct subject-matter. *Ib.*

An action may be maintained against a corporation for the infringement of a patent, upon proof of a wrongful manufacture by agents of the corporation with its approval and for its benefit. Corporations can act only by their agents. They can act only by those who are in their employ. And when one in the employment of a corporation, in the business of his employment, does an act for their benefit, and which they adopt and approve and take advantage of, they will be deemed to have authorized the act, and will be as much bound by it as though expressly authorized. *Poppenhusen v. New York Gutta Percha Comb Co.*, 2 *Fish. Pat. Cas.* 62; 4 *Blatchf.* 184.

If a few persons form themselves into a corporation under the Missouri statute, the business of which is a necessary infringement of a patent, they cannot escape individual liability for the acts done in the corporate name. *St. Louis Stamping Co. v. Quinby*, 18 *Pat. Off. Gaz.* 571; 5 *Bann. & A. Pat. Cas.* 275.

One who was president and sole shareholder of a corporation, was *held*, under the circumstances, personally liable for an infringement committed in the course of the company's business. *Smith v. Standard Laundry Machinery Co.*, 19 *Fed. Rep'r*, 826; 25 *Pat. Off. Gaz.* 393; 15 *Rep'r*, 74.

A corporation is responsible for the conduct of its superintendent in affixing the word "patented" to unpatented articles. *Tompkins v. Butterfield*, 25 *Fed. Rep'r*, 556.

A city is liable in its corporate capacity for the infringement of a patent. *Munson v. New York*, 5 *Fed. Rep'r*, 388; 18 *Blatchf.* 237; 10 *Rep'r*, 135; 5 *Bann. & A. Pat. Cas.* 486.

A city will be held responsible for infringements of patents by its fire department, though separately incorporated. *Brickill v. New York*, 7 *Fed. Rep'r*, 479; 18 *Blatchf.* 273; 18 *Pat. Off. Gaz.* 463.

The act of the legislature of New York, passed March 28, 1862

(Laws 1862, c. 63), has no effect to relieve the corporation of the city of Brooklyn from liability to pay the patentee of a patent for an improvement in hose-couplings used by it without his license. *Bliss v. Brooklyn*, 8 *Blatchf.* 533 ; 4 *Fish. Pat. Cas.* 596.

The city of Brooklyn is not liable to the patentee of a patented seat, for the use thereof in the public schools of the city, under the direction of the board of education, which purchased and owns the seats ; the corporation of the city not using them and having no power by law, to direct the discontinuance of their use. *Allen v. Brooklyn*, 8 *Blatchf.* 535 ; 4 *Fish. Pat. Cas.* 598.

The board of education of the city of New York purchased patented seats for use in public schools. It was *held*, that the city was liable in a suit for infringement, notwithstanding the board was an independent corporation created by the State government. *Allen v. New York*, 17 *Blatchf.* 350 ; 17 *Pat. Off. Gaz.* 1281 ; 5 *Bann. & A. Pat. Cas.* 57.

XVI. GROUNDS OF DEFENSE.

201. *Interest of the Public in Inventions and Patents.*

From the principle established by many decisions, that the application of an old process or machine to a similar or analogous subject, with no change in the manner of application and no result substantially distinct in its nature, will not sustain a patent, it follows that where the public has acquired in any way the right to use a machine or device for a particular purpose it has the right to use it for all the like purposes to which it can be applied ; and no one can take out a patent to cover the application of the device to a similar purpose. *Blake v. San Francisco*, 113 *U. S.* 679.

A patentee is bound either to use his patent himself or permit others to do so on reasonable and equitable terms. *Hoe v. Knap*, 27 *Fed. Rep'r*, 204.

The public have an equity in patents which must always be regarded. *Consolidated Fruit Jar Co. v. Bellaire Stamping Co.*, 27 *Fed. Rep'r*, 377.

One who invents, or discovers and keeps secret, a process of manufacture, has a property therein, which the courts will protect. *Salomon v. Hertz*, 2 *Cent. Rep'r*, 182.

202. *Fraud.*

A patentee brought a suit for damages against a British corporation on the following facts: The "managing agent" of the British corporation had been sent to this country and had fraudulently pretended, in a series of negotiations, to conclude an agreement with the plaintiff, to make use of his patent. The real purpose of the agent, as alleged by the plaintiff, had been, by means of protracted consultations and drafts of agreements, to prevent him (the plaintiff) from using his invention during a certain period, and thus gain time for his principal to introduce another invention in which it was largely interested. A charge that, if the corporation never gave any authority to its managing agent to assent to the draft of agreement in its behalf and in its name, and never sanctioned it as a corporate act, suit for such a fraud as above indicated could not be maintained, was *held* erroneous, upon the ground that the suit not being upon a contract, the corporation might be responsible for the fraud, notwithstanding its authority and sanction were never given. *Butler v. Watkins*, 13 *Wall.* 456.

In a case of alleged infringement, if the parties deal at arms-length, and the defendant is given his choice between a settlement on the terms offered by the complainant, and a law-suit with time sufficient for reflection and investigation, the fact that the defendant feared the result of litigation on his business, and therefore settled, is not sufficient to support the charge of fraud. *Pope Manuf. Co. v. Owsley*, 27 *Fed. Rep'r*, 100. The mere fact that the owner of a patent alleges an infringement, and threatens suit unless a settlement is made with him, cannot be held to make such settlement void for fraud or intimidation. *Ib.*

Where a patentee claims an infringement, the fact that at the time of making a settlement of the claim for past manufacturing and sale, and granting a license, the patent had expired, though in force when negotiations were begun, does not render the transaction fraudulent. *Ib.*

A party who has owned the recorded title of a patent for more than six months, may, for a valuable consideration, convey the

same to a corporation competent to purchase and hold it ; and the title thus conveyed will not be open to attack for fraud in the assignor. *Racine Seeder Co. v. Joliet Wire-Check Row Co.*, *Fed. Rep'r*, 367.

203. *Estoppel.*

Declarations on the part of an inventor that he intended not to take out a patent, but to let the public have his invention, will estop such party, or any one holding under him, from asserting his right against a person acting on the faith of such declarations. *Pitts v. Hall*, 2 *Blatchf.* 229.

A mechanic, working at his employment for wages, who permits his employer to apply for and obtain a patent without objection, upon a machine which the mechanic has perfected, will be deemed to have waived any rights he may have had as a prior inventor. *Fraim v. Keen*, 25 *Fed. Rep'r*, 820 ; 34 *Pat. Off. Gaz.* 1048. S. P., *Ruggles v. Young*, 1 *MacArthur Pat. Cas.* 160 ; *Warner v. Goodyear*, 1 *MacArthur Pat. Cas.* 60 ; *McCormick v. Howard*, *Id.* 238.

A disclaimer at the close of a specification estops the patentee from setting up any privilege to the part disclaimed. *Whitney v. Emmett*, *Baldw.* 303.

A disclaimer made by an attorney in the prosecution of an application for a patent, does not necessarily estop the patentee from maintaining that his claim embraces the matter so referred to. *Mann v. Bayliss*, 10 *Pat. Off. Gaz.* 789.

A patentee is not estopped by his silence in omitting to assert his claim to an invention, unless it has misled another to his hurt. *Railroad Co. v. Dubois*, 12 *Wall.* 47.

A certified copy of the model does not conclude the defendant, but he may show that the model has been changed. *Johnson v. Beard*, 8 *Pat. Off. Gaz.* 435 ; 2 *Bann. & A. Pat. Cas.* 50.

A patentee can not repudiate one of the parts of his combination after another inventor has taught him how to dispense with it. *Hale v. Stimpson*, 2 *Fish. Pat. Cas.* 565 ; *Cooledge v. McCone*, 2 *Sawyer*, 571 ; 5 *Pat. Off. Gaz.* 458 ; 1 *Am. L. T. N. S.* 214 ; 1 *Bann. & A. Pat. Cas.* 78.

Where one has advertised a patented article as one of the most useful of inventions, and one which has superseded all other similar articles ; and has also sold such article for use ; such person is

estopped, in an action against him for an infringement, from denying the utility of the invention. *Stanely v. Whipple*, 2 *McLean*, 35, 39.

In a suit for infringement of a patent, against a purchaser from a licensee, in which the complainant treats the license as no longer in force, the defendant is not estopped from denying the validity of the patent. *Baltimore Car Wheel Co. v. North Baltimore Passenger R. Co.*, 21 *Fed. Rep'r*, 47.

Estoppel of patentee, as against assignee of patent, to allege its invalidity in suit for infringement. *Rumsey v. Buck*, 20 *Fed. Rep'r*, 697; *Underwood v. Warren*, 21 *Fed. Rep'r*, 578.

A licensee under a patent is not estopped to deny its validity, when he has not done or claimed anything under it, and the licensor has had knowledge of his position. *Brown v. Lapham*, 27 *Fed. Rep'r*, 77. He is estopped to deny its validity on any question arising out of that relation between the parties (*Ib.*), so long as the license remains in force. *Pope Manuf. Co. v. Owsley*, 27 *Fed. Rep'r*, 100.

A licensee who agrees not to contest the validity of the patent or the title of the licensor thereby admits the validity of the patent, and waives all questions of limiting or escaping the claims by the prior art; the only question being whether the machines made are within the terms of the patent. The date and duration of a patent are matters of public record which the licensee is as much bound to know as the licensor. *Ib.*

Where it is claimed that a patentee has estopped himself to deny that his American patent was for the same invention as was patented to him in prior foreign patents, by representing that it was for the same, in his application, if the patentee was laboring under a mistake as to this point, his rights ought not to be defeated, or seriously abridged by such mistake. *Commercial Manuf. Co. v. Fairbank Canning Co.*, 27 *Fed. Rep'r*, 78.

A decree dismissing a former bill for failure to show infringement, does not estop the plaintiff, or his assignees, from suing the same defendant for infringing the same patent. *Steam-Guage & Lantern Co. v. Meyrose*, 27 *Fed. Rep'r*, 213.

The equitable doctrine of estoppel is applied to a patentee who, after unreasonable delay, applies for an amendment and enlargement of his claim. *Asmus v. Alden*, 27 *Fed. Rep'r*, 684.

Where the terms of a claim in a patent are clear and distinct, the patentee, in a suit brought upon the patent, is bound by it, and

cannot show that his invention is broader than the terms of his claim ; or, if the invention is broader, he must be held to have surrendered the surplus to the public. *Blades v. Rand, McNally & Co.*, 27 *Fed. Rep'r*, 93.

Where a patentee, in the first instance, made broad claims, which were denied, it was *held* that by accepting a patent for a restricted claim, he abandoned his claim by construction, so far as what was in terms refused him was concerned ; and that his action became part of the law of the patent, and controlled the assignee as well as the original patentee. *Blades v. Rand, McNally & Co.*, 27 *Fed. Rep'r*, 93 ; *Otis Bros. v. Crane Bros. Manuf. Co.*, 27 *Fed. Rep'r*, 550 ; *Roener v. Peddie*, 27 *Fed. Rep'r*, 702.

The inventor of a certain mechanism assigned the invention to a manufacturing company of which he was superintendent, by which it was patented ; and he caused mechanism to be made by the company, representing it to be one of the modifications of the invention patented ; for the construction of which the company had special tools made, and which it introduced to the public as covered by the patent. It was *held*, after he had left the company, that he and all in privity with him, were estopped from denying that the mechanism so constructed was covered by the patent ; and that, as to him and them, an injunction against its reproduction should issue. *Time Telegraph Co. v. Himmer*, 19 *Fed. Rep'r*, 322.

Patent was issued to Armstrong and Hutchinson, in 1875, for an improvement in machines for finishing horse-shoe nails. It was *held* to be shown by a preponderance of evidence in a suit for infringement, to have been obtained by them for devices invented and put in use by them while they were in the employ of the defendant under such terms as to preclude them from making any claims against the defendant for such devices. *Bensley v. Northwestern Horse Nail Co.*, 26 *Fed. Rep'r*, 250.

A patentee of an improvement consisting in securing a loose case or jacket around a hydrant, in such manner that the hydrant might be withdrawn without disturbing the case, was *held* not estopped by procuring a patent therefor, from patenting a further improvement, consisting in so connecting the case with the hydrant that the upheaval of the case a few inches by the frost would not injure or break the hydrant. *Mathews v. Flower*, 25 *Fed. Rep'r*, 830 ; 33 *Pat. Off. Gaz.* 887.

A patent for the change of old parts of a combination to effect efficient co-operation must be limited to the express improvement

made. *Troy Laundry Machinery Co. v. Bunnell*, 27 *Fed. Rep'r*, 810.

The holder of a patent for a combination of devices for a sliding door for railroad cars, claiming as part of the combination guiding rods and staples, and expressly disclaiming the use of grooves as an equivalent, is estopped from insisting, to establish an alleged infringement, that the grooves are equivalent to the rods, or that the rods and staples are not essential to his combination. *Watson v. Cincinnati, I. & C. R. Co.*, 23 *Fed. Rep'r*, 443.

204. *Former Adjudication.*

A former verdict, or dismissal of a bill filed for an injunction to restrain the use of a patented invention, is not a bar to a subsequent action at law for damages, in another State, unless a judgment was rendered on such verdict against the plaintiff, or the dismissal was on the merits. *Allen v. Blunt*, 2 *Woodb. & M.* 121, 132.

The defendant in a suit at law for infringement agreed with the plaintiff, for a valuable consideration, to discontinue the manufacture of the infringing article; and subsequently suffered interlocutory judgment to be entered against himself by default. Afterward he continued to make and sell an article differing but slightly from the former, and a clear infringement of the one patented. A bill in equity having been brought to restrain the unlicensed manufacture, and it appearing that the defenses set up in the answer were within the defendant's knowledge at the time of the action at law, it was *held*, that he was concluded by the agreement of compromise; and should not be permitted to contest the validity of the patent. *Brooks v. Moorhouse*, 13 *Pat. Off. Gaz.* 499; 3 *Bann. & A. Pat. Cas.* 229.

A verdict sustaining a patent, and judgment thereon, in an action between an owner of a territorial right under such patent and an infringer is not admissible in evidence in an action brought by another owner of another territorial right under the same patent for the purpose of establishing his right; but would be admissible on a notice for a provisional injunction, as affording strong evidence of the validity of the patent and of the title. *Buck v. Hermance*, 1 *Blatchf.* 322; 1 *L. Rep'r, N. S.* 321.

A patentee and his assignee brought a suit in equity, in the

circuit court of Louisiana, against a junior patentee, seeking to have the junior patent declared void for interference with their patent. The bill was dismissed on the merits. Subsequently the same plaintiffs brought an action at law, in another circuit for infringement of their patent, against a person who had not been a party to the record in the suit in Louisiana, but who had obtained an interest in the junior patent, after the commencement of the Louisiana suit, and before the judgment of dismissal. It was *held*, that the rights of the parties to the action at law would have been bound by a judgment in the Louisiana suit declaring either patent void; but that the judgment of dismissal did not import the invalidity of the senior patent, and could not be pleaded in bar of the action at law. To constitute such a judgment a bar to such subsequent action, it should have been direct and affirmative in its terms, and have asserted the interference of the patents, and have declared the patent void in whole or in part, or inoperative and invalid in some part of the United States. *Tyler v. Hyde*, 2 *Blatchf.* 308.

The validity of a patent having been in part sustained in one circuit, suit was brought in another circuit for infringement by a party who had contributed to the payment of the counsel who had defended the first suit. The defendant was *held* estopped by the adjudication in the other circuit, and that the proper practice to introduce new evidence as to prior use, would be to move for a rehearing in the other circuit. *Miller v. Liggett, &c. Tobacco Co.*, 7 *Fed. Rep'r*, 91; 2 *McCrary*, 375; 27 *Int. Rev. Rec.* 295; 19 *Pat. Off. Gaz.* 1138.

A judgment recovered in a prior action, was *held*, under the circumstances, not to preclude impeaching the patent in a subsequent suit. *Russell v. Place*, 94 *U. S.* 606.

An adjudication against the defendant in a suit for infringement of a patent binds his servants or agents only through their relation to their employer or principal, and they are not thereby precluded from setting up any defense to a new suit against them for an alleged new infringement by them acting in their own right. *Hayes v. Bickelhaupt*, 24 *Fed. Rep'r*, 806; 32 *Pat. Off. Gaz.* 136.

In an action at law, by patentees, for damages for the use of machines covered by their patent, an answer which sets up the recovery by the plaintiffs against a third person of a decree in equity for an accounting of profits in manufacturing and selling such machines in infringement of the patent; an accounting had

a certain sum awarded to them as such profits; and that the machines for the use of which the action at law is brought were purchased by defendant from such third person, and the profits of their manufacture and sale included in such decree, but which does not allege that such decree has been satisfied by payment or otherwise, or that the accounting included the machines in question, does not state a defense. *Fisher v. Consolidated Amador Mine, &c.*, 25 *Fed. Rep'r*, 201.

Where a licensee accepts a license agreeing not to contest the licensor's title or the validity of the patent, a subsequent decision of a court declaring the patent void will not affect the license. *Pope Manuf. Co. v. Owsley*, 27 *Fed. Rep.* 100.

The rule that parties directly interested in the subject-matter of a suit and a right to make a defense, are concluded by the judgment therein is applied in patent cases. *American Bell Telephone Co. v. National Improved Telephone Co.*, 27 *Fed. Rep'r*, 633.

205. *That the Device Patented does not Involve Invention.*

“Invention,” in the sense of the patent law, means finding out, contriving or creating, by intellectual act, something which did not previously exist. *Conover v. Roach*, 4 *Fish. Pat. Cas.* 12. The word implies exercise of genius, and production of a new idea. *New York Belting & Packing Co. v. Magowan*, 27 *Fed. Rep'r*, 362. See also, pages 36, 37, *ante*.

There may be invention in the adaptation of an old article to a new purpose, producing a useful result. *Yale Lock Manuf. Co. v. Norwich Nat. Bank*, 19 *Blatchf.* 123; 6 *Fed. Rep'r*, 377; *Washing Machine Co. v. Lincoln*, 4 *Fish. Pat. Cas.* 379. But merely bringing old devices into such juxtaposition as will allow each to work out its own effect, but without causing either to contribute any new function or mode of operation, is not invention. *Troy Laundry Machinery Co. v. Bunnell*, 27 *Fed. Rep'r*, 810.

The mere selection, for a particular purpose, from materials known to possess the proper qualities, of materials specially adapted to that purpose—as a choice of steel, or case-hardened iron, for combination with softer metal, in gun-cartridges—is not invention. *Re Maynard*, 1 *MacArthur Pat. Cas.* 536. S. P., *Putnam v. Yerrington*, 2 *Bann. & A. Pat. Cas.* 237; 9 *Pat. Off. Gaz.* 689. And

so, of the substitution of a more appropriate or economical material for one previously in use. *New York Bung, &c. Co. v. Doelger*, 23 *Fed. Rep'r*, 191; 32 *Pat. Off. Gaz.* 651; *Hotchkiss v. Greenwood*, 11 *How.* 248. But the substitution of one material for another may involve contrivance or ingenuity; may involve a new mode of construction, or result in developing new properties or uses; and where this is the case, the rule that there must be exercise of invention is satisfied, and the process or result is patentable. *Hicks v. Kelsey*, 18 *Wall.* 673; *Smith v. Goodyear Dental Vulcanite Co.*, 93 *U. S.* 486; *aff'g 1 Holmes*, 354; *Goodyear Dental Vulcanite Co. v. Root*, 1 *Bann. & A. Pat. Cas.* 384; 6 *Pat. Off. Gaz.* 154; *Goodyear Dental Vulcanite Co. v. Willis*, 1 *H'lipin*, 385; 1 *Bann. & A. Pat. Cas.* 568; 7 *Pat. Off. Gaz.* 41; *Putnam v. Weatherbec*, 1 *Holmes*, 497; 2 *Bann. & A. Pat. Cas.* 78; 8 *Pat. Off. Gaz.* 320; *Dalton v. Nelson*, 13 *Blatchf.* 357; 2 *Bann. & A. Pat. Cas.* 225; 9 *Pat. Off. Gaz.* 1112; *United States Stamping Co. v. King*, 17 *Blatchf.* 55; 4 *Bann. & A. Pat. Cas.* 469; 7 *Fed. Rep'r*, 860; 17 *Pat. Off. Gaz.* 1399.

206. *But only Mechanical Skill.*

To sustain a patent, the device must involve exercise of the inventive faculties; that it is merely new, or useful, or shows mechanical skill, is not enough. *Thompson v. Boisselier*, 114 *U. S.* 1, 29; *Yale Lock Manuf. Co. v. Greenleaf*, 117 *U. S.* 554; *Brown v. Guild*, 23 *Wall.* 181; 6 *Pat. Off. Gaz.* 731; *Celluloid Manuf. Co. v. Comstock & Cheney Co.*, 27 *Fed. Rep'r*, 358; *May v. Fond du Lac County*, 27 *Fed. Rep'r*, 691. See *Hill v. Biddle*, *Id.* 560.

A change in an old device, producing a new and useful result, in which invention is involved, is patentable. *Sewing Machine Co. v. Frame*, 24 *Fed. Rep'r*, 596; 28 *Pat. Off. Gaz.* 96. *S. P.*, *Reed v. Street*, 34 *Pat. Off. Gaz.* 339.

A patent for a combination is not necessarily invalid because all the parts are old; yet merely assembling them together, or placing them in juxtaposition does not indicate invention; but some new or peculiar function, produced by such a combination, must be developed, or the new arrangement is the mere exhibition of mechanical skill (*Scott Manuf. Co. v. Sayre*, 26 *Fed. Rep'r*, 153); and a device which does not involve invention, but mechanical skill simply, is not patentable. *Butler v. Steckel*, 27 *Fed. Rep'r*,

219; *Calkins v. Oskosh Carriage Co.*, *Id.* 296. Though new and useful, an invention, to be patentable, must be the result of something more, and different from, mechanical skill. *Celluloid Manuf. Co. v. Comstock & Cheney Co.*, 27 *Fed. Rep'r*, 358.

Mere mechanical skill applied to an old idea, modifying it and making it more practical, is not patentable unless some new and useful result is obtained. *New York Belting & Packing Co. v. Magowan*, 27 *Fed. Rep'r*, 362.

207. *Novelty in the Invention, Lacking*

It is a valid defense to a suit for infringement (as well as a sound objection to the original application for a patent), to show that the device for which the patent has been granted was not new. Novelty is essential; the patent law requires a thing to be new as well as useful, in order to entitle it to protection by patent. *Stanley Works v. Sargent*, 8 *Blatchf.* 344; 4 *Fish. Pat. Cas.* 443. If there is nothing new in the process, or the machinery for applying it, the result is not patentable. *Collar Co. v. Van Deusen*, 23 *Wall.* 530; 5 *Pat. Off. Gaz.* 919; aff'g 5 *Fish. Pat. Cas.* 597; 10 *Blatchf.* 109; 2 *Pat. Off. Gaz.* 361. Novelty and utility combined determine patentability. *Celluloid Manuf. Co. v. Comstock & Cheney Co.*, 27 *Fed. Rep'r*, 358. See also *ante*, p. 55.

Novelty is variously defined; but the cases agree that the substance or article need not have been non-existent, prior to the invention patented; the inventor's right is secured if his ingenuity, method, or device has given the thing new properties, brought it into uses before impracticable, imparted to it a new value, invested it with a new mode of operation, made it substantially better or cheaper, or the like. *Glue Co. v. Upton*, 97 *U. S.* 3; aff'g 4 *Cliff.* 237; 1 *Bann. & A. Pat. Cas.* 497; 6 *Pat. Off. Gaz.* 837; *Salt Manuf. Co. v. Thomas*, 3 *Leg. Gaz.* 316; 1 *Leg. Gaz. Rep.* 275; *Furbush v. Cook*, 2 *Fish. Pat. Cas.* 668; *Strong v. Noble*, 3 *Id.* 586; 6 *Blatchf.* 477.

Novelty in the result or effect only, is not, in general, sufficient; there must be evidence that the effect is produced by some new process, device, contrivance, mode, manner, or means, or by some new machinery; for a patent cannot be granted for an effect only. Where, however, such a result is shown, slight evidence only of the existence of novelty and invention will suffice. *Yearsley v. Brookfield*, 1 *MacArthur Pat. Cas.* 193.

Where the principle of an alleged invention has been previously discovered and applied, although there may be in the new application some degree of novelty, and something may have been discovered or found out that was not known before, it is not patentable unless the new occasion on which the principle is applied, leads to some kind of new manufacture, or to some new result. *Re Blandy*, 1 *MacArthur Pat. Cas.* 552.

Although a mere analogous use is not patentable, yet where a new or improved manufacture is produced by new contrivances, combinations or arrangements, a new principle may be constituted, and the application or practice of old things will of course be new also in the result. The usual test is whether the production of the article is as good in quality at a cheaper rate, or better in quality at the same rate, or with both these consequences partly combined; and so is the like principle in mechanism. That a combination appears to be simple, and the invention not very great, is not sufficient objection if the invention be not frivolous and foolish. *Re Smith*, 1 *MacArthur Pat. Cas.* 255.

In order to constitute patentable novelty and utility, it must appear that, in a *new process* of manufacture, the result produced was an improvement in the trade, and for the public good or advantage, by the manufacture either of a new or better article, or one cheaper to the public than that produced by the old method. *Jones v. Wetherill*, 1 *MacArthur Pat. Cas.* 409.

In the case of combinations, the fact that one or more of the elements of which it is formed have been used before for other purposes, is not such want of novelty as will defeat an application for a patent; if the combination is substantially new, the invention of the combination is patentable. *Re Watson*, 1 *MacArthur Pat. Cas.* 510. See *Brown v. Whittemore*, 5 *Fish. Pat. Cas.* 524; 2 *Pat. Off. Gaz.* 248.

If the article or result patented can be produced without the aid of the description given in the patent, there is lack of novelty. *Lockwood v. Faber*, 27 *Fed. Rep'r*, 63.

208. *Utility Lacking.*

Although a mere change of form or proportion is not a patentable invention, if by such a change a new effect is produced, and proof of its practical utility is given, it may be patentable. *Re Fultz*, 1 *MacArthur Pat. Cas.* 178.

The question of utility pertains chiefly to the examination of the application before the commissioner ; it can seldom be raised with good effect as a defense to a suit for infringement, for the courts will not usually revise the decision of the patent-office as to utility (*Doherty v. Haynes*, 4 *Cliff.* 291 ; 6 *Pat. Off. Gaz.* 118 ; 1 *Bann. & A. Pat. Cas.* 289), but are inclined to treat the fact that defendant thought worth his while to appropriate plaintiff's invention as sufficient proof that it was a useful one. See *ante*, p. 56 ; *Hobbie v. Smith*, 27 *Fed. Rep'r*, 656.

In order to sustain a patent as well as to obtain one, the machine, device, improvement, combination or other thing for which it has been granted must appear to be useful, as well as new. But a high degree of utility is not required ; nor is utility the sole test of patentability. *Stanley Works v. Sargent*, 8 *Blatchf.* 314 ; 4 *Fish. Pat. Cas.* 443. If an invention produces either a new result which is useful, or an old result more cheaply or advantageously, than was formerly practicable, it is "useful." *Niles Tool Works v. Betts Machine Co.*, 27 *Fed. Rep'r*, 301 ; *Hobbie v. Smith*, 27 *Ib.* 656.

A change in the construction and mode of operation of a mechanical device, although but slight, may be patentable, where the consequences of the change are considerable, resulting in a very great saving of expense. *Re Walsh*, 1 *MacArthur Pat. Cas.* 530. But see *Re Littlefield*, *Id.* 574.

209. *Typical Cases illustrating Application of the Rules requiring Invention, Novelty, Utility, &c.*

The decisions are very numerous which, without establishing any new principles of the law of patents, determine the application of the principles presented in the last three sections to particular inventions. *The following are the more instructive examples of THINGS NOT PATENTABLE which have been adjudged so for want of invention, novelty, utility, or for like objections.*

A combination of machinery used to form lead pipes in a new way ; such machinery in principle being the same as that commonly employed to make maccaroni, and clay pipes. *Le Roy v. Tatham*, 14 *How.* 156.

A wagon-reach made of iron instead of wood as formerly used. *Hicks v. Kelsy*, 18 *Wall.* 670.

A combination which consists only of the application of a piece

of rubber to one end of the piece of wood which makes a lead pencil. *Rubber Tip Pencil Co v. Howard*, 20 *Wall.* 498 ; aff'g 5 *Fish. Pat. Cas.* 377 ; 9 *Blatchf.* 490 ; *Reckendorfer v. Faber*, 92 *U. S.* 347 ; aff'g 12 *Blatchf.* 68 ; 1 *Bann. & A. Pat. Cas.* 229.

A claim of a woven elastic fabric, differing from those previously used only in being more tightly woven, and more elastic by reason of a greater proportion of elastic strands. *Smith v. Nichols*, 21 *Wall.* 112.

A product consisting merely of a metallic ring envelope in a composition of ivory or similar material,—being an improved form of rings for martingales. *Rubber-Coat Harness Trimming Co. v. Welling*, 97 *U. S.* 7.

The grinding or powdering an article of commerce,—in this instance glue,—to render it easier of handling, and more readily dissolved for use. *Glue Co. v. Upton*, 97 *U. S.* 3 ; aff'g 4 *Cliff.* 237 ; 6 *Pat. Off. Gaz.* 837 ; 1 *Bann. & A. Pat. Cas.* 497.

The use of wedge-shaped blocks in making a pavement ; that being the principle long since applied in laying cobble-stone pavements ; also the mere exercise of judgment as to the amount of force or degree of force to be used in ramming or swaging. *Stow v. Chicago*, 8 *Biss.* 47 ; 8 *Bann. & A. Pat. Cas.* 83 ; aff'd, 104 *U. S.* 547.

A contrivance consisting merely in putting an additional pane of glass in a fare-box in a street car, opposite the side next the driver, so that the passengers can see the interior of the box through it ; for this requires no more invention than the placing of an additional pane of glass in a show-case, or the putting of an additional window in a room. *Slawson v. Grand Street R. R. Co.*, 107 *U. S.* 649.

The use in succession of two distinct pairs of dies, of well-known kinds, not combined in one machine, nor co-operating to one result, but each pair doing by itself its own work. *Beecher Manuf. Co. v. Atwater Manuf. Co.*, 114 *U. S.* 523.

A combined hose-carriage and fountain-standard, consisting in the combination of “a wheeled carriage provided with a foot or brace to sustain it in an upright vertical position, a nozzle-holding device, and a reel of large diameter to allow water to flow through the hose when partially wound there ;” the proof showing that a fountain-standard and hose-reel, similarly mounted, had been previously used in combination. *Preston v. Manard*, 116 *U. S.* 661

The making of a part of an old manufacture as a separate article of trade. *Seligman v. Day*, 14 *Blatchf.* 72 ; 2 *Bann. & A. Pat. Cas.* 467.

A paper bag made with a notch cut with jagged or serrated edges with a view to facilitate the opening of the mouth, instead of with smooth edges as previously used. *Matter of Arkell*, 15 *Blatchf.* 437.

An improvement in distributors for copy for compositors, which, instead of the device previously in use, of a series of hooks lettered to correspond with letters systematically placed upon the leaves of copy, also marked upon the type, employed a galley holder with compartments for galleys permanently lettered to correspond with the lettering on the hooks. *Brainard v. Evening Post Assoc.*, 22 *Blatchf.* 61.

An improvement in the application of palm-leaf to stuffing beds, &c., which same process had been used in preparing hair for like uses, so that there was no invention of any new process. *Howe v. Abbott*, 2 *Story*, 190.

An improvement consisting only in a change in the manner of attaching several knives, instead of one, on a cylinder by screws, instead of attaching it to the cylinder by rings at the end. *Hovey v. Stevens*, 1 *Woodb. & M.* 290.

An improvement in the known mode of making car-wheels by placing a heated tire of cast steel in a mould, and then pouring in molten cast iron at the center of the mould, thus producing a weld or union between the iron and the steel ; which consisted merely in introducing the molten iron through a series of openings or "sprues" just inside the heated rim or tire. *Needham v. Washburn*, 4 *Cliff.* 254 ; 7 *Pat. Off. Gaz.* 649 ; 1 *Bann. & A. Pat. Cas.* 537.

An improvement in locks and door-fastenings, consisting in making them double-faced, so that the same lock or fastening may be used for a right or left-hand door ; locks that might be applied in the same way, though not used or made for that precise purpose, being in public use. *Livingston v. Livingston*, 1 *Fish. Pat. Cas.* 521.

Where the patentee of an improvement in chewing-gum took the crude chicle of commerce, washed it in hot water to remove the coloring matter and impurities, and claimed the product as a new invention ; but there was proof that the same process had long been used for washing and purifying India rubber and gutta-percha,

which are products of the same vegetable family as chickly. *Adams v. Loft*, 8 *Rep'r*, 612 ; 4 *Bann. & A. Pat. Cas.* 495.

The preparing and cutting up meat, and putting it in a can which is then hermetically sealed ; and the construction of the can of a particular form. *Wilson Packing Co. v. Clapp*, 8 *Rep'r*, 262 ; 8 *Biss.* 545 ; 4 *Bann. & A. Pat. Cas.* 355.

A method by which hair is put in small packages and compressed into convenient shape for sale to plasterers, so that the compressed bale may be separated into convenient smaller packages as desired. *King v. Frostel*, 8 *Rep'r*, 490 ; 8 *Biss.* 510 ; 4 *Bann. & A. Pat. Cas.* 236.

The mere change of the form of a die so as to change the form of that which was manipulated under the die. *Smith v. American Bridge Co.*, 8 *Biss.* 312 ; 3 *Bann. & A. Pat. Cas.* 565.

The mere change of the spaces of lines embossed on paper so that they might be used for writing. *Cone v. Morgan Envelope Co.*, 4 *Bann. & A. Pat. Cas.* 107.

Merely attaching prongs to a disk to serve the same purpose as the disk. *Lorillard v. Ridgway*, 4 *Bann. & A. Pat. Cas.* 564 ; 16 *Pat. Off. Gaz.* 1231.

A lady's hair-net made of coarse threads interspersed with fine threads, instead of fine threads alone, as already in use. *Dalton v. Jennings*, 5 *Pat. Off. Gaz.* 615.

A patent for apparatus in which the acid and alkaline solutions for forming carbonic acid gas were kept separate until required to extinguish a fire, when they could be readily mingled ; it appearing that similar apparatus had been employed in soda-fountains for the supply of beverages. *Northwestern Fire Extinguisher Co. v. Philadelphia Fire Extinguisher Co.*, 6 *Pat. Off. Gaz.* 34 ; 10 *Phila.* 227 ; 1 *Bann. & A. Pat. Cas.* 177.

The mere making of a model of an invention, was held not to constitute invention, as against a patent subsequently granted to another for the same thing. *Stilwell, &c. Manuf. Co. v. Cincinnati Gas-light, &c. Co.*, 7 *Pat. Off. Gaz.* 829.

A claim for making in iron, a frame which has before been made in wood. *Holbrook v. Small*, 10 *Pat. Off. Gaz.* 503.

Combining a curved metal receiver with an elevated, instead of a horizontal, delivery. *Mann v. Bayliss*, 10 *Pat. Off. Gaz.* 789.

The putting a second cover on a base-ball, to harden it ; there being proof that a double cover had previously been used for the

like purpose upon softer balls. *Mahn v. Harwood*, 3 *Bann. & A. Pat. Cas.* 515 ; 14 *Pat. Off. Gaz.* 859.

The fastening of one or more fire-lighters to each bundle of the common article known as bundle or kindling wood ; or the " accompanying " the bundle with a fire-lighter. *Alcott v. Young*, 16 *Pat. Off. Gaz.* 403.

The use of kerosene oil in a stove by means of prior devices ; though such prior devices were intended for illuminating purposes, and alcohol or other combustible fluids were to be used. *Couse v. Johnson*, 16 *Pat. Off. Gaz.* 719 ; 4 *Bann. & A. Pat. Cas.* 501.

A metallic roofing or covering, made of a series of corrugated shingles, to be secured to the roof by nails, as are ordinary wooden shingles, one shingle overlapping another, so as to cover the nail holes in the lowest shingle. *American Iron Co. v. Anglo-American Roofing Co.*, 16 *Fed. Rep'r*, 915 ; 24 *Pat. Off. Gaz.* 1274 ; 15 *Rep'r*, 779.

A change in form of corrugated iron to be applied to a building, or making the nail-holes in it elongated. *Belt v. Crittenden*, 2 *Fed. Rep'r*, 82 ; 1 *McCrary*, 209 ; 18 *Pat. Off. Gaz.* 191 ; 5 *Bann. & A. Pat. Cas.* 131.

A window cleaner, consisting of a holder with an elastic strap attached. *Perfection Window Cleaner Co. v. Bosley*, 2 *Fed. Rep'r*, 574 ; 9 *Biss.* 385 ; 10 *Rep'r*, 67 ; 5 *Bann. & A. Pat. Cas.* 449.

The use of the same mechanism for the purpose of applying a blast of hot air to the interior of beer casks to heat them, as had been previously used to apply a blast of hot air, of the same character, to the interior of moulds and other receptacles for the same purpose. *Gottfried v. Crescent Brewing Co.*, 9 *Fed. Rep'r*, 762 ; 22 *Pat. Off. Gaz.* 497.

The employment of sheet metal as a lining for the bottom of a vessel to obtain liquids. *New York Grape Sugar Co. v. American Grape Sugar Co.*, 10 *Fed. Rep'r*, 835 ; 20 *Blatchf.* 386 ; 13 *Rep'r*, 548.

An improvement in stoves, consisting in the substitution of a flat grate for a dished grate (*Perry v. Co-operative Foundry Co.*, 12 *Fed. Rep'r*, 149) ; or the substitution of an old grate made in two parts for another old grate made in one part. *Id.* 436.

A can adapted to hold liquids, constructed after a device previously patented for a can to hold dry substances. *Norton v. Haight*, 22 *Fed. Rep'r*, 787.

A composition for an artificial ivory, consisting of a mechanical mixture of kaolin and shellac ; where it appeared that the use of

those ingredients in combination was not new, and that the proportions stated in the patent did not produce any new or useful result. *Welling v. Crane*, 21 *Fed. Rep'r*, 707; 29 *Pat. Off. Gaz.* 451.

Alleged improvements in dissolving xyloidine, consisting in the use of camphor in conjunction with alcohol as a solvent; and in bleaching zyloidine, consisting in the application of ordinary bleaching materials, which had not before been used. *Spill v. Celluloid Manuf. Co.*, 22 *Blatchf.* 441; 21 *Fed. Rep'r*, 631.

An improvement in sectional honey-frames, consisting of making them by bending and uniting the ends of a blank consisting of a single piece. *Fornerook v. Root*, 21 *Fed. Rep'r*, 328; 29 *Pat. Off. Gaz.* 775.

Application to the turning of machine awls and needles, from metal, of mechanism old and familiar in the art of wood-turning. *Howe Machine Co. v. National Needle Co.*, 21 *Fed. Rep'r*, 630.

A claim of a process for preserving animal and vegetable substances, which process had been previously known; although the apparatus described might carry out the process better than that previously in use. *Alden Evaporating Fruit Co. v. Bowen*, 24 *Fed. Rep'r*, 787; 32 *Pat. Off. Gaz.* 1355.

An improvement in bushings for bungs, consisting in a change, in an old device, of one known material for another which had been previously used for kindred purposes. *New York Bung, &c. Co. v. Doelger*, 23 *Fed. Rep'r*, 191; 32 *Pat. Off. Gaz.* 651.

A patent for an improvement in construction of mosaic flooring, consisting of laying such flooring of hard wood upon a foundation of soft wood, tongued and grooved together. *Kappes v. Hartung*, 23 *Fed. Rep'r*, 187; 32 *Pat. Off. Gaz.* 652.

A claim of an improved tap-sole for rubber boots; the essence of the invention being in the form or shape. *Woonsocket Rubber Co. v. Candee*, 23 *Fed. Rep'r*, 797.

An improvement in type-writers, covering a combination of key levers of the third order of levers, and shields for covering the exposed ends of the levers; both of which were previously known and used in type-writers, although not in combination; the improvement involving a mere change of location of the shields to meet the different points of exposure. *Phipps v. Yost*, 26 *Fed. Rep'r*, 447.

An improvement in spittoons, consisting in loading the bottom

with sand secured by a metal plate. *Havemeyer v. Randall*, 21 *Fed. Rep'r*, 404 ; *Havemeyer v. Bonnell*, *Id.* 406.

An improvement in soldering process, involving a mere change of process from that of turning the article to be soldered in molten solder, while heated, to that of pouring melted solder into the joint from a ladle. *Adams & Westlake Manuf. Co. v. Wilson Packing Co.*, 21 *Fed. Rep'r*, 648.

An improved mode of uniting small biscuit pans together in clusters, consisting in providing the pans with horizontal flanges and riveting them. *Lalace & Grojean Manuf. Co. v. United States Stamping Co.*, 23 *Fed. Rep'r*, 800.

An improvement in a process of treating oleaginous seeds, consisting only in certain mechanical changes in carrying into effect the well-known old steps of the process. *Lowther v. Hamilton*, 21 *Fed. Rep'r*, 811 ; 29 *Pat. Off. Gaz.* 449.

An improvement in dummies for displaying clothing, consisting in the substitution of paper or papier mache for the wire previously used in making such dummies ; but that material had been used before in constructing lay figures, representing celebrated personages clothed with costumes. *Palmenburg v. Buchholz*, 21 *Blatchf.* 162.

Patent for an improvement in the manufacture of hydrogen peroxide, or oxygenated water ; the alleged improvement consisting merely in the stirring, by a well-known and simple mechanical device, of a liquid which, in the prior process, had been stirred by hand. *Marchand v. Emken*, 26 *Fed. Rep'r*, 629 ; 34 *Pat. Off. Gaz.* 1275.

An improvement in tools for reaming and squaring pipes ; being only an adaptation, perhaps to a new use, of a tool long previously well known, requiring mere mechanical change. *Barry v. Crane Bros. Manuf. Co.*, 22 *Fed. Rep'r*, 396.

An improvement in scale-pans for weighing, describing the scale-pans as "made entire of glass," with strong lugs, on each side, through holes in which were passed double suspending bows ; there having been prior knowledge and use of scale-pans made of glass and glazed porcelain, and of metallic scale-pans suspended on bows similar to those described. *Forschner v. Baumgarten*, 26 *Fed. Rep'r*, 858.

An improvement in marking plug, claiming, as a new article of manufacture, a plug of tobacco marked with indentations to serve as guides for cutting the plug into measured quantities ; the same

device having been applied to other articles, and for the same purpose. *Drummond v. Venable*, 26 *Fed. Rep'r*, 243.

A corset with an elastic gore or gusset, for wearing apparel; the difference between these and previous patents for similar articles appearing to involve only the substitution of one material for another, and to require no inventive ability, but mere mechanical skill or adaptation. *Florsheim v. Schilling*, 26 *Fed. Rep'r*, 256.

A peculiar form of packing ice, for shipment or storage, consisting in placing the blocks close together, in a manner to prevent percolation of water. *Re Kemper*, 1 *MacArthur Pat. Cas.* 1.

The discovery that attaching an advertisement permanently to a balloon is a good mode of advertising. *Gould v. Commissioner*, 1 *MacArthur*, 410 ; 5 *Pat. Off. Gaz.* 121.

The application of a known and ordinary power to an ordinary purpose,—such as the combination of an endless screw and cog-wheel for steering apparatus to vessels. *Cochrane v. Waterman*, 1 *MacArthur Pat. Cas.* 52. *S. P., Walker v. Rawson*, 4 *Bann. & A. Pat. Cas.* 128.

The application of a mere mechanical device, requiring no invention, to a machine which was conceived by another and is being actually reduced to practice. *Marshall v. Mee*, 1 *MacArthur Pat. Cas.* 229.

The mere repetition of a well known process by which a metallic paint, heretofore known, may be obtained from waste matter. *Re Maule*, 1 *MacArthur Pat. Cas.* 271.

The use, in illuminated vault covers, of polygonal glasses of an inverted pyramidal form instead of lens-shaped glasses previously used, there being no evidence of the actual results in practice. *Re Jackson*, 1 *MacArthur Pat. Cas.* 485.

An improvement which consists merely in the employment of an obvious substitute, but does not involve, to any considerable extent, the exercise of ingenuity. *Re Everson*, 1 *MacArthur Pat. Cas.* 406 ; *May v. Fond du Lac County*, 27 *Fed. Rep'r*, 691.

Otherwise, if the substitute is not obvious, and is new and useful. *Ladd v. Tucker Manuf. Co.*, 4 *Bann. & A. Pat. Cas.* 344.

A mere change in the details of mechanical construction of a device, as in the relative position and mode of attachment of its parts, but producing no new effect (*Re Bishop*, 1 *MacArthur Pat. Cas.* 518 ; *Dane v. Illinois Manuf. Co.*, 6 *Fish. Pat. Cas.* 124 ; 3 *Biss.* 374 ; *Hancock Inspirator Co. v. Lally*, 27 *Fed. Rep'r*, 88) ; though a change in arrangement of old parts of a combination

which effects efficient co-operation may involve invention. *Troy Laundry Machinery Co. v. Bunnell*, 27 *Fed. Rep'r*, 810.

An alleged invention of an improved mode of protecting objects from the effect of lightning, by surrounding that part of the lightning-rod which is imbedded in the earth with a galvanic battery. *Re Cushman*, 1 *MacArthur Pat. Cas.* 569.

211. *Cases of Patents sustained against Objections of Want of Invention, Novelty, Utility, &c.*

A process of nickel plating, doubts existing whether nickel plating was reduced by previous discoveries to a practical art. *United Nickel Co. v. California Electrical Works*, 25 *Fed. Rep.* 475.

A process of manufacturing spoons and forks from steel, and the product resulting from such process; the result being attained by a succession of processes, which, though separately old, had not previously been practically grouped in the order employed. *Wallace v. Noyes*, 21 *Blatchf.* 83.

The subjection of spiral steel wire springs to heat, not merely for the purpose of tempering the steel, but also to restore strength and elasticity of the wire, lost by the displacement of its particles from being made into springs. *Cary v. Wolff*, 24 *Fed. Rep'r*, 139; 32 *Pat. Off. Gaz.* 257; *Cary v. Lovell Manuf. Co.*, 24 *Fed. Rep'r*, 141; 32 *Pat. Off. Gaz.* 1009; *Cary v. Domestic Spring Bed Co.*, 34 *Pat. Off. Gaz.* 1158.

An improved automatic fire extinguisher, in which the seal was placed at the extreme outer end of the water pipe, and so near to the distributor, that, when the joint of the seal was melted, the seal itself was forced into the distributor and the water was left unobstructed. *Parmelee v. Burritt Hardware Co.*, 24 *Fed. Rep'r*, 735; 33 *Pat. Off. Gaz.* 237.

The creation of a new device from an old one, by altering the structure at tops of childrens' carriages, so as to abandon the principal thing which the old device was created to do, and so as to change the principle of the mechanism in order to accomplish what the old structure did not undertake to do. *Parker v. Stow*, 23 *Fed. Rep'r*, 252; 31 *Pat. Off. Gaz.* 117; *Parker v. Montpelier Carriage Co.*, 23 *Fed. Rep'r*, 886; 31 *Pat. Off. Gaz.* 1688; *Parker v. McKee*, 24 *Fed. Rep'r*, 808; 32 *Pat. Off. Gaz.* 137.

An improvement in cake-pans, where all the parts were known before, but not in the same connection and arrangement. *Bell v. United States Stamping Co.*, 22 *Blatchf.* 27.

An improvement in kerosene stoves, consisting in holding the chimneys between upper and lower plates, so that the lower plate rested directly over the burners, while the upper plate furnished facilities for holding the cooking utensils. The fastening the chimney between the two plates, in this device, caused its success. *Adams & Westlake Manuf. Co. v. Rathbone*, 26 *Fed. Rep'r*, 262.

An improvement in friction drums for pile-drivers and hoisting machines, being for new combination, making a more compact, economical and useful machine than those previously in use. *Mundy v. Lidgerwood Manuf. Co.*, 27 *Pat. Off. Gaz.* 718.

The substitution in a pendulum level of an entire graduated circle for a graduated semi-circle; the improvement involving a difference of construction which was shown to fit the new instrument for use in places where the old form could not be used; although opportunities for its use were rare. *Chandler v. Ladd*, 1 *MacArthur Pat. Cas.* 493.

An improved brick machine adapted to the manufacture of tubular or perforated brick, by providing the mold box with a core and an annular bottom or plunger for expelling the brick; held more than a mere change in the form of previous machines. *Re Wagner*, 1 *MacArthur Pat. Cas.* 510.

A pavement composed of stone blocks, of which the ends lying in the end of travel were smooth and fitted close together, while the sides lying across the street were left rough, with spaces between them in which the horses' feet might take hold. *Guidet v. Barber*, 5 *Pat. Off. Gaz.* 149.

A blank book with spaces numbered for bonds and coupons outstanding against the proprietor of the book, arranged for keeping them for reference as they should come in and be paid. *Munson v. New York*, 3 *Fed. Rep'r*, 338; 18 *Blatchf.* 237; 10 *Rep'r*, 135;

A hotel register, whose side margin was occupied with advertisements, and the middle left vacant for names of guests. *Hawes v. Washburne*, 5 *Pat. Off. Gaz.* 491. See also *Hawes v. Cook*, *Id.* 493; *Hawes v. Gaze*, *Id.* 494.

A fare register and recorder, consisting of a new arrangement of working together of old devices. *Railway Register Manuf. Co. v. Broadway & Seventh Ave. R. R. Co.*, 22 *Fed. Rep'r*, 655; 30 *Pat.*

Off. Gaz. 180 ; but see decision granting rehearing, 32 *Pat. Off. Gaz.* 257 ; and decision on rehearing, 34 *Pat. Off. Gaz.* 921.

An improvement in manufacturing artificial teeth by substituting a vulcanizable rubber plate in place of other material formerly used. *Smith v. Goodyear Dental, &c. Co.*, 93 *U. S.* 486.

An improvement in a bottle-stopper fastener, consisting in forming the fastener at the part that comes over the cork, of a piece of wire of a **U** form, with the ends returned and connected to the bottle in order that the pressure on the cork or stopper, may cause the fastener to hold more securely ; a prior patent having been issued for a similar fastener made of tin. *Putnam v. Yerrington*, 9 *Pat. Off. Gaz.* 689.

An improvement in a compressed steam-gauge cock, consisting in the substitution of vulcanized rubber in the opposing surfaces in place of brass or lead, leather or cork, as previously used. *Dalton v. Nelson*, 13 *Blatchf.* 357.

An improvement consisting in the substitution of an intermittent rotary seed-wheel for an oscillatory seed-wheel. *Brown v. Deere*, 6 *Fed. Rep'r*, 484.

An improvement in regulating the draft of stoves, consisting in the application of the principle of expansion or contraction of a metallic rod by means of the heat produced by the stove itself, thereby producing a self regulator. *Foote v. Silsby*, 1 *Blatchf.* 445 ; 2 *Blatchf.* 260 ; aff'd 20 *How.* 378.

A number of rollers, acting in pairs, arranged for a particular purpose. *Knight v. Gavit*, *Mir. Pat. Off.* 132. *S. P.*, *Parker v. Hulme*, 7 *West. L. J.* 417 ; 1 *Fish. Pat. Cas.* 45.

An invention of a peculiar form of a last. *Mabie v. Haskell*, 2 *Cliff.* 507.

The placing of a rivet at the corners of a pocket opening. *Strauss v. King*, 17 *Pat. Off. Gaz.* 1450 ; 18 *Blatchf.* 88 ; 5 *Bann. & A. Pat. Cas.* 338 ; 2 *Fed. Rep'r*, 236.

The discovery that the foam in beverages can be increased by the use of soapine. *Bowker v. Dows*, 15 *Pat. Off. Gaz.* 510 ; 3 *Bann. & A. Pat. Cas.* 518.

A float-valve placed at the mouth of an air eduction-pipe in a night-soil cask, so as to close such pipe and stop the operation of the air-pump when the cask is filled ; notwithstanding similar valves had been before used in steam-boilers and water-tanks to close eduction passages. *Odorless Excavating Apparatus Co. v. Clements*, 16 *Pat. Off. Gaz.* 854 ; 4 *Bann. & A. Pat. Cas.* 540.

An improvement in the art of curing fish, by removing a part of the mucous membrane not before known to be injurious to the keeping quality of the fish. 1 *Fed. Rep'r*, 140 ; 3 *Bann. & A. Pat. Cas.* 478.

A vulcanized rubber packing for boxes of pistons, sustained against the objection of lack of invention, because it disclosed a new and better method of obtaining a tight joint between the packing and the piston-rod than had been before obtained. *New York Belting, &c. Co. v. Magowan*, 34 *Pat. Off. Gaz.* 1159.

An improvement in floating mowing machines, consisting of the combination of the cutting apparatus of a mowing-machine with a boat, in such a way as to make it operate successfully for mowing under water. *Piper v. Shedd*, 26 *Fed. Rep'r*, 151.

Where an old device, with serious defects, was changed, and an improved result obtained. *Asmus v. Alden*, 27 *Fed. Rep'r*, 684.

A new combination of old and well-known mechanical appliances, the patent being limited to the *combination* alone. *Re Boughton*, 1 *MacArthur Pat. Cas.* 278 ; *Frink v. Petry*, 11 *Blatchf.* 422 ; 5 *Pat. Off. Gaz.* 201 ; 1 *Bann. & A. Pat. Cas.* 1 ; *Forbush v. Cook*, 2 *Fish. Pat. Cas.* 668 ; *Re Hebbard*, 1 *MacArthur Pat. Cas.* 543.

An imitation honey, which could be made more cheaply than real honey, and was not unwholesome ; although purchasers might easily mistake it for the real. *Re Corbin*, 1 *MacArthur Pat. Cas.* 521.

212. *Irregularities or Defects in the Patent or the Proceeding to obtain it.*

Although an inventor cannot obtain a valid patent until he has in some sense completed or perfected his invention (*Colt v. Massachusetts Arms Co.*, 1 *Fish. Pat. Cas.* 108 ; *National Oil Co. v. Arctic Oil Co.*, 4 *Id.* 514 ; 8 *Blatchf.* 416 ; and see p. 58, *ante*), yet a patent duly issued will not be adjudged void because the invention was not literally and completely reduced to practice before the patent was issued ; the phrase "reduced to practice," simply means that the thing must be so described, modeled, or otherwise exhibited in working condition, as to demonstrate that it does not rest in mere theory. *Heath v. Hildreth*, 1 *MacArthur Pat. Cas.* 12 ; *Re Seely*, *Id.* 243. It is in this sense that an invention is said not to be

patentable until "perfected." *Moore v. Thomas*, 3 *Bann. & A. Pat. Cas.* 13.

The filing of an application containing a clear and distinct description of the invention by specification and drawing, is a sufficient compliance with the requirement of a reduction to practice to entitle the applicant to a patent; and the fact that it has been used by others, although the applicant has not himself been able to use it successfully, is sufficient evidence of its capability of being used in the manner described. *Burrows v. Wetherill*, 1 *MacArthur Pat. Cas.* 315.

The descriptive language in a specification or claim, if clear, should be followed in its natural and ordinary meaning (*Mitchell v. Tilghman*, 19 *Wall.* 287; and see *ante*, pp. 68-76; 220-229), or, if ambiguous, should be favorably read, so as to give effect to the true intention of the patentee, considered as probably inexpert in the use of scientific language (*French v. Rodgers*, 1 *Fish. Pat. Cas.* 133; *Page v. Ferry*, *Id.* 298); and disregarding an error of expression which is apparent, and by which no one could be misled (*Kneass v. Schuylkill Bank*, 4 *Wash.* 9), without, however, forcing it beyond the true meaning of the language used. *Masury v. Anderson*, 6 *Fish. Pat. Cas.* 457; 11 *Blatchf.* 162; 4 *Pat. Off. Gaz.* 55.

But the description must clearly specify the various elements which the patentee claims as his invention, so fully that a competent artisan, skilled in the art, could construct the invention from the description given, without other aid (*Webster Loom Co. v. Higgins*, 16 *Pat. Off. Gaz.* 675), and so distinctly that the court can say what is the improvement or invention claimed by the patentee, and to what it is limited (*Barrett v. Hall*, 1 *Mas.* 447, 476; *Lowell v. Lewis*, 1 *Mas.* 182; *Langdon v. De Groot*, 1 *Paine*, 203; *Parker v. Stiles*, 5 *McLean*, 44; 7 *West. L. J.* 168; *Tyler v. Deval*, 1 *Code Rep'r*, 30); or can determine what parts or features of the machine, &c., are essential to the proposed result; without this (even though they may be distinguishable in the patent-office model), other persons are not forbidden to imitate them (*Barry v. Gugenheim*, 5 *Fish. Pat. Cas.* 452; 1 *Pat. Off. Gaz.* 382). Portions of the invention, which are omitted from the description, are not protected by the patent (*Burden v. Corning*, 2 *Fish. Pat. Cas.* 477); if, however, the description states lucidly what the patentee claims, it need not characterize what he does not claim as

“old” (*Brown v. Guild*, 23 *Wall.* 181), or describe it otherwise than in general terms. *Ib.*; *Many v. Jagger*, 1 *Blatchf.* 372.

An original patent is said to be entitled to a broader construction than a mere improvement. *May v. Fond du Lac County*, 27 *Fed. Rep'r*, 691.

A claim in the patent for more than plaintiff was the first and original discoverer and inventor of, will not avoid as to that which is new; and if his process in the separate preparation of either of the ingredients named in his patent was before named and used, yet if his combination of them is new, and the result produced is new and useful, his patent is valid. *Stephens v. Felt*, 11 *Hunt Mer. Mag.* 266.

When the claim expresses a combination of several elements without particularly pointing out the special construction of one embodying the actual novelty and invention, and the general combination is old, the patent is broader than the actual invention, and invalid. *Terry Clock Co. v. New Haven Clock Co.*, 17 *Pat. Off. Gaz.* 908; 3 *Bann. & A. Pat. Cas.* 332.

If it is apparent from the specifications that the patent is for an invention which is frivolous, the court may declare it inoperative. *Wilson v. Janes*, 3 *Blatchf.* 227.

A patent for a composition, where the specification clearly describes the composition and all the ingredients and proportions, in language intelligible to those skilled in the art, cannot be invalidated by evidence of a failure to deposit in the patent-office a sample of one of the ingredients. It is for the commissioner to decide, before granting the letters-patent, whether this requirement has been complied with. A patent once granted cannot be subsequently impeached by evidence tending to show a want of compliance with the law as to giving notice, or paying fees, or performing the other acts required to be done before the patent is granted, and the performance of which is to be proved to the satisfaction of the commissioner, whose decision on these questions is final where he has jurisdiction. *Tarr v. Folsom*, 1 *Holmes*, 312; 5 *Pat. Off. Gaz.* 92; 1 *Bann. & A. Pat. Cas.* 24.

A claim to a patent for a compound is not void because the specification does not prescribe exact and unvarying proportions in the ingredients of the compound. *Klein v. Russell*, 19 *Wall.* 433.

Subject to general principles such as these (more fully explained *ante*, pp. 68-76, 220-229), not only may the commissioner reject an application for its obscurity or deficiency of language, but an

alleged infringer may object that the scope of a patent cannot be extended beyond its language (see *Rapp v. Bard*, 1 *Fish. Pat. Cas.* 196 ; *Renwick v. Pond*, 10 *Blatchf.* 39 ; 5 *Fish. Pat. Cas.* 569 ; 2 *Pat. Off. Gaz.* 392 ; *Roemer v. Neumann*, 26 *Fed. Rep'r*, 102); that the grant must be limited to the invention covered by the claim, and while the claim may be illustrated, it cannot be enlarged by language used in other parts of the specification (*Yale Lock Manuf. Co. v. Greenleaf*, 117 *U. S.* 554); or where the claims and specifications are repugnant, and the claim does not cover what is covered or described in the specifications, may contend that the patent is void for uncertainty. *Smith v. Murray*, 27 *Fed. Rep'r*, 69.

Whether alterations made in an application, after it has been filed, impair the validity of a patent issued upon it, see *Gill v. Wells*, 22 *Wall.* 1 ; *Robertson v. Secombe Manuf. Co.*, 10 *Blatchf.* 481 ; 3 *Pat. Off. Gaz.* 412 ; 6 *Fish. Pat. Cas.* 268 ; *Globe Nail Co.*, 27 *Fed. Rep'r*, 450 ; also *ante*, p. 78.

With respect to official errors in preparing and issuing the patent, the cases have *held*, that the point that a patent was issued unintentionally, through the blunder of a subordinate in the patent office, cannot be raised in a suit brought on the patent. The seal of the United States and the signature of the proper officers to the grant must be respected, in the absence of fraud, so long as the United States do not themselves question the grant. *Doughty v. West*, 6 *Blatchf.* 429 ; 3 *Fish. Pat. Cas.* 580. See also, *Tarr v. Folsom*, *supra* ; *Railway Reg. Manuf. Co. v. North Hudson C. R. Co.*, 23 *Fed. Rep'r*, 593 ; 32 *Pat. Off. Gaz.* 519.

A grant (here, letters-patent) is not necessarily void by reason of an error in the Christian name of the grantee ; and where it contains any other matter descriptive of the person for whom it was intended, extrinsic proof of such matter is admissible to identify the grantee. *Northwestern Fire Extinguisher Co. v. Philadelphia Fire Extinguisher Co.*, 10 *Phila.* 227 ; 6 *Pat. Off. Gaz.* 34 ; 1 *Bann. & A. Pat. Cas.* 177.

The decision of the commissioner of patents in the allowance and issue of a patent creates a *prima facie* right only ; and, upon all the questions involved therein, the validity of the patent is subject to examination by the courts. *Reckendorfer v. Faber*, 92 *U. S.* 347. *S. P.*, *Agawam Co. v. Jordan*, 7 *Wall.* 583, 596 ; *Union Paper Bag Machine Co. v. Crane*, 1 *Holmes*, 429 ; 6 *Pat. Off. Gaz.* 801 ; 1 *Bann. & A. Pat. Cas.* 494 ; *Whipple v. Miner*, 15 *Fed.*

Rep'r, 117 ; 23 *Pat. Off. Gaz.* 2236 ; Gloucester Isinglass, &c. Co. v. Brooks, 19 *Fed. Rep'r*, 426.

The decision of the commissioner of patents is conclusive as to the law and facts arising under the application for a patent, unless it be impeached for fraud or connivance between him and the patentee, or unless his excess of authority be manifest on the face of the papers. *Allen v. Blunt*, 3 *Story*, 742 ; 8 *L. Rep'r*, 165. But compare *Allen v. Blunt*, 2 *Woodb. & M.* 121.

The questions of the regularity of the proceedings in petitioning for and obtaining a patent, and of the correctness of the judgment of the officer in awarding it, cannot be inquired into. *Wilder v. McCormick*, 2 *Blatchf.* 31.

The decision of the commissioner of patents that the drawings and model required by statute have been presented, that the attorney of the applicant was properly so constituted and had authority to amend or alter the specification, and that the specification was duly sworn to, cannot be reviewed collaterally ; but only in a proceeding to set aside the patent. *Hoe v. Cottrell*, 1 *Fed. Rep'r*, 597 ; 17 *Blatchf.* 546 ; 18 *Pat. Off. Gaz.* 59.

In a suit for infringement of a patent issued under the act of 1836, regular upon its face, and which recited that the patentee had made oath to his application therefor, it was *held*, that an objection to the validity of the patent, upon the ground that the records of the patent-office showed that the supplementary or amended application upon which the patent was granted was verified, not by the oath of the patentee, but by that of his attorney, could not be considered. *Hancock Inspirator Co. v. Jenks*, 21 *Fed. Rep'r*, 911 ; *De Florez v. Reynolds*, 14 *Blatchf.* 505.

213. *Disputing Plaintiff's Title to the Invention.*

As to the right of an alleged infringer to defend, on the ground that the patent was wrongfully issued to plaintiff, who is not the true inventor, or not the sole inventor, or that another person is jointly interested with him. *Pitts v. Wemple*, 1 *Biss.* 87 ; 2 *Fish. Pat. Cas.* 10 ; *Worden v. Fisher*, 11 *Fed. Rep'r*, 505 ; 21 *Pat. Off. Gaz.* 1957 ; *Barker v. Woodruff*, 1 *Pat. Off. Gaz.* 256 ; *Collar Co. v. Deussen*, 23 *Wall.* 530 ; *aff'g* 10 *Blatchf.* 109 ; *ante* 41, 280-286.

The relation between employer and employee may be such, and the suggestions of the latter in aid of developing a device or

machine, may involve so much independent invention, that the employee ought to be joined with the employer in the patent, and, consequently in an action for infringement. *Collar Co. v. Deussen, supra*; *Hoe v. Kahler*, 12 *Fed. Rep'r*, 111.

The employee in such cases is, however, at most only a joint inventor; he cannot sustain a patent in his own name alone. *Arnold v. Bishop*, 1 *MacArthur Pat. Cas.* 27; *Id.* 36. But where the inventor assigned the improvement to another person, on the agreement that the latter should take out a patent, and pay a royalty on manufactures under it, and a patent was obtained in the name of the assignee which the parties acted on as good, the invalidity of the patent as toward the public was *held* no defense to an action by the true inventor, against the assignee and patentee for agreed royalty. *Milligan v. Lalance, &c. Manuf. Co.*, 21 *Fed. Rep'r*, 570; 29 *Pat. Off. Gaz.* 367.

The right to a patent for a practical application of a known principle is in the person who first conceived that application; any subsequent patent issued for an improved application must rest upon and be limited to the improvement the second patentee has made. *Re Henry*, 1 *MacArthur Pat. Cas.* 467.

A new application for a patent, made by an attorney without authority, is invalid; and a subsequent ratification does not relate back. *Consolidated Fruit Jar Co. v. Bellair Stamping Co.*, 27 *Fed. Rep'r*, 377.

A party sued for infringement by one claiming sole interest who procures an assignment and release from infringement of claims, takes with notice and subject to equities. *Kearney v. Lehigh Valley R. Co.*, 27 *Fed. Rep'r*, 699.

214. *Defenses Allowable under General Issue and Notice, by Rev. Stat. § 4920 (Act of 1836, § 15).*

In any action for infringement the defendant may plead the general issue, and having given notice in writing to the plaintiff or his attorney, thirty days before, may prove on trial any one or more of the following special matters:

First. That for the purpose of deceiving the public the description and specification filed by the patentee in the

patent-office was made to contain less than the whole truth relative to his invention or discovery, or more than is necessary to produce the desired effect ; or,

Second. That he had surreptitiously or unjustly obtained the patent for that which was in fact invented by another, who was using reasonable diligence in adapting and perfecting the same ; or,

Third. That it had been patented or described in some printed publication prior to his supposed invention or discovery thereof ; or,

Fourth. That he was not the original and first inventor or discoverer of any material and substantial part of the thing patented ; or,

Fifth. That it had been in public use or on sale in this country for more than two years before his application for a patent, or had been abandoned to the public.

And in notices as to proof of previous invention, knowledge, or use of the thing patented, the defendant shall state the names of patentees and the dates of their patents, and when granted, and the names and residences of the persons alleged to have invented, or to have had the prior knowledge of the thing patented, and where and by whom it had been used ; and if any one or more of the special matters alleged shall be found for the defendant, judgment shall be rendered for him with costs. And the like defenses may be pleaded in any suit in equity for relief against an alleged infringement ; and proofs of the same may be given upon like notice in the answer of the defendant, and with the like effect. *Rev. Stat. § 4920.*

215. *First. Fraudulent Defect or Excess in Specification.*

A patent from the government cannot, in a collateral proceeding, be impeached for fraud in procuring it. The allegation, that

“the same was procured by fraud, misrepresentation, and in violation of law,” is simply an allegation of a conclusion of law from facts, which facts are not pleaded. *Gear v. Grosvenor*, 1 *Holmes*, 215 ; 3 *Pat. Off. Gaz.* 380 ; 6 *Fish. Pat. Cas.* 314.

The degree of evidence required to prove a fraudulent intent in a defective specification of a patent rests with the jury. Positive evidence is not necessary. The intention may be presumed from circumstances,—*e. g.*, when the parts concealed are so essential and so obviously necessary to be disclosed, that no mechanic skilled in the art could reasonably be expected to understand the subject so as, from the description given, to make the machine. But such a presumption would be weakened by the testimony of skillful persons that they could not hesitate in supplying the omissions. *Gray v. James*, *Pet. C. Ct.* 394.

216. *Second. Patent Surreptitiously or Unjustly Obtained.*

A charge that the original patentee of an invention fraudulently and surreptitiously obtained a patent on what he well knew was invented by another, constitutes no defense to the charge of infringement, unless accompanied by the further allegation that the alleged first inventor was at the time using reasonable diligence in adapting and perfecting the invention. *Agawam Co. v. Jordan*, 7 *Wall.* 583. S. P., *Reed v. Cutter*, 1 *Story*, 590.

If a patent has been obtained by the plaintiff, upon the defendant's refusal to submit to an arbitration, according to the act of February 21, 1793, § 9 (1 Stat. 318), and the defendant subsequently obtains a patent for the same invention, this is not conclusive proof that the latter was obtained surreptitiously, or upon false suggestion. *Stearns v. Barrett*, 1 *Mas.* 153, 174.

In the race of diligence between two independent inventors, he who first reduces his invention to a fixed position and practical form would seem to be entitled to a priority of right to a patent therefor. But this right was qualified by the act of 1836, § 15,—which provided that in such cases the first inventor shall have the prior right, if he is using reasonable diligence in adopting and perfecting the same, although the second inventor has, in fact, first perfected the same and reduced the same to practice in a positive form. *Reed v. Cutter*, 1 *Story*, 590 ; *Reed v. Robinson*, 4 *L. Rep'r*, 342. S. P., *Washburn v. Gould*, 3 *Story*, 122 ; 1 *West. L. J.* 465 ; 7 *L.*

Rep'r, 276; *Bedford v. Hunt*, 1 *Mas.* 302; *Many v. Jagger*, 1 *Blatchf.* 372; *Parkhurst v. Kinsman*, *Id.* 488; 8 *N. Y. Leg. Obs.* 146; *Allen v. Hunter*, 6 *McLean*, 303.

That a person constructed and used his machine before another took out a patent for a similar machine is not a justification, if in fact the former was copied from the machine subsequently patented. *Hovey v. Stevens*, 1 *Woodb. & M.* 290.

In order to bring a case within the meaning of the clause of the act of July 4, 1836, § 15 (now Rev. Stat. § 4920, subd. 2),—which specifies, as a defense to an action for the infringement of a patent, that the “plaintiff had surreptitiously or unjustly obtained the patent for that which was in fact invented or discovered by another, who was using reasonable diligence in adapting and perfecting the same,”—it is not necessary to implicate the good faith of the plaintiff or his assignees. The injustice relied on may be rather injustice in the abstract than injustice resulting from any intentional wrong. The term was used and intended to be used in its broadest sense. *Phelps v. Brown*, 4 *Blatchf.* 362; 1 *Fish. Pat. Cas.* 479; 18 *How.* 7.

Sections 12 and 15 of the act, taken together, were designed to protect the right of the first inventor, although he may not have been the first to adapt his invention to practical use, provided he has filed his caveat and has used reasonable diligence in perfecting his discovery. The purpose of the caveat is to save the discoverer from the effect of the rule of law which gives to the inventor who first adapts his invention to practical use the right to the grant of the patent. *Ib.* A. filed a caveat in the patent-office April 17, 1854. B. made application for a patent for the same invention November, 1854. No notice was given to A. of this application, but a patent was granted to B., January 9, 1855. A patent was subsequently granted to A. In a suit by the assignees of B. against the assignees of A., it was *held*, that the omission to give notice to A. might be set up as one of the defenses under section 15 of the act of July 4, 1836, as proof that B. “had surreptitiously or unjustly obtained the patent for that which was, in fact, discovered by another,” &c. A patentee should not be prejudiced for the error or oversight of the patent-office. *Ib.*

In an action for infringement of a patent, the minutes of a company of which the plaintiffs were members and at whose suggestion and expense the subject of the patent was claimed to have been invented, may be read in evidence to prove that the

plaintiffs were not the original inventors of the thing patented ; but not to show that the plaintiffs had surreptitiously obtained a patent for another's invention, unless notice of such defense and intention has been given to the plaintiffs. *Pennock v. Dialogue*, 4 *Wash.* 538.

The mere existence of a previous patent, or specification of an improvement, is not sufficient to establish the fact of fraud in obtaining a subsequent patent for a similar improvement ; actual knowledge of the former patent by the subsequent patentee must be proved. *Delano v. Scott*, *Gilp.* 489.

217. *Third. Prior Patent or Published Description.*

Prior printed publications relied upon to defeat a patent, are sufficient for the purpose, if they describe the process covered by the patent so fully and clearly, as to enable persons skilled in the art to which the invention relates, to carry on the process. *Downton v. Yeager Milling Co.*, 108 *U. S.* 466 ; aff'g 1 *Fed. Rep'r*, 199 ; 1 *McCrary*, 26 ; 17 *Pat. Off. Gaz.* 906 ; 9 *Rep'r*, 462 ; 5 *Bann. & A. Pat. Cas.* 112.

When properly pleaded and proven, the statutory defense "that the invention had been patented, or described in some printed publication, prior to the supposed invention" by the patentee, is sustained, if the conflicting patent, whether foreign or domestic, was duly issued or the complete description was published prior to the date of the patent in contest. *Kelleher v. Darling*, 14 *Pat. Off. Gaz.* 673 ; 4 *Cliff.* 424. Whether the rival patent or the printed description must in all cases have appeared before the patentee's invention was made ; and whether a crude machine, made and used only as an experiment or specimen, may be introduced in proof that such invention existed, see *Ib.* ; *Elizabeth v. Pavement Co.*, *infra* ; *Gottfried v. Phillip Best Brewing Co.*, 17 *Pat. Off. Gaz.* 675 ; 5 *Bann. & A. Pat. Cas.* 4 ; *Bartholomew v. Sawyer*, 4 *Blatchf.* 347 ; 1 *Fish. Pat. Cas.* 516 ; 11 *Hunt Mer. Mag.* 575.

Upon a question of the validity of a patent, it is admissible to show that the invention had been described in publications prior to the issuing of the patent ; and such publication may be proved by the production of the book, or by parol testimony. *Allen v. Hunter*, 6 *McLean*, 303, 314.

Use or sale of an invention before it is perfected, necessarily

made as an aid to the inventor in ascertaining its usefulness and deficiencies and in perfecting it, is not such a use or sale as defeats the right to a patent. *Graham v. McCormick*, 11 *Fed. Rep'r*, 859 ; 10 *Biss.* 39 ; 21 *Pat. Off. Gaz.* 1533 ; 5 *Bann. & A. Pat. Cas.* 244.

Under the act of 1836, § 6, it was *held* that a prior construction and use of the thing patented, in one instance only, never made public, and which had been finally forgotten, or abandoned, so that, at the time of the invention by the patentee, the invention did not exist, would not render a patent invalid; for, by the phrase, "knowledge and use" referred to in the act, was meant knowledge and use existing in a manner accessible to the public. *Gayler v. Wilder*, 10 *How.* 477.

A foreign patent or publication describing an invention, unless published anterior to the making of the invention or discovery secured by letters-patent issued by the United States, is no defense to a suit upon them. *Elizabeth v. Pavement Co.*, 97 *U. S.* 126.

The only exception to the rule, that in order to confer an exclusive right on the patentee, the thing patented must have been original with the inventor and not known to others, is where an individual obtains a patent believing the invention to be original, and it is made to appear that it had been known in a foreign country, but not patented there, nor described in any printed publication. *Parker v. Stiles*, 5 *McLean*, 44, 61 ; 7 *West. L. J.* 168.

The mere fact that an invention patented was known and used in a foreign country before its discovery by the patentee, is not sufficient (under the act of 1836) to avoid the patent, provided the patentee, at the time of making his application for a patent, believed himself to be the first inventor of the thing patented. *Bartholomew v. Sawyer*, 4 *Blatchf.* 347 ; 1 *Fish. Pat. Cas.* 516 ; 41 *Hunt Mer. Mag.* 575 ; *Boemer v. Simm*, 5 *Pat. Off. Gaz.* 555 ; *Doyle v. Spaulding*, 19 *Fed. Rep'r*, 744.

No description, in any printed publication, of the thing patented, can avoid the patent, unless such description was prior, in point of time, to the invention of the patentee ; that the description in the printed publication was prior to the application for the patent, is not enough. *Bartholomew v. Sawyer*, *supra*.

The fact that the use of the invention before the patentee originated it was unknown to him, will not prevent such use from avoiding the patent, if the use was in this country. *Boemer v. Simm*, *supra*.

If it is proved that the invention, or something substantially like it, has been described in a book, or has been the subject of a patent in a foreign country, this is a good defense to an action for infringement in this country. *Judson v. Cope*, 1 *Fish. Pat. Cas.* 615 ; 1 *Bond*, 327.

If the jury find that the patentee, when he made application for his patent, believed himself to be first inventor, his patent will not be invalidated by the existence of the thing abroad. *Forbush v. Cook*, 10 *L. Rep'r, N. S.* 664.

Previous use or knowledge of an invention abroad is no defense against a patent, unless such invention was described in some printed publication so clearly as to enable others to put it in practice. *Jones v. Sewall*, 3 *Cliff.* 563 ; 6 *Fish. Pat. Cas.* 343 ; 3 *Pat. Off. Gaz.* 630. *S. P.*, *Cahill v. Brown*, 15 *Pat. Off. Gaz.* 697 ; 3 *Bann. & A. Pat. Cas.* 580 ; *Atlantic Giant Powder Co. v. Parker*, 16 *Pat. Off. Gaz.* 495 ; *Roberts v. Dickey*, 1 *Pat. Off. Gaz.* 4 ; 4 *Fish. Pat. Cas.* 532 ; 4 *Brews.* 260 ; 3 *Pittsb.* 352.

Foreign patents urged as anticipations of domestic patents, where the article is not properly proved to have been known or used in this country, or the patentee's circular to the trade was not a printed publication, or his provisional specification did not make the invention described in it patented, within the meaning of the act of 1836, §§ 7, 15, will not be considered. *Parsons v. Colgate*, 15 *Fed. Rep'r*, 600 ; 24 *Pat. Off. Gaz.* 203.

An English patent, taken out surreptitiously by any person, who, without the knowledge of the American inventor, and without authority from him, endeavored to appropriate the benefits of his invention, would not thereby deprive the real inventor of any of his rights. *Kendrick v. Emmons*, 9 *Pat. Off. Gaz.* 201 ; 2 *Bann. & A. Pat. Cas.* 208.

An invention is not patented in England within the meaning of *Rev. Stat.* § 4920, subd. 3, until the completed specification has been filed; unless it has been described in some printed publication within the meaning of *Rev. Stat.* § 4920, subd. 3. *Coburn v. Schroeder*, 11 *Fed. Rep'r*, 425 ; 20 *Blatchf.* 392 ; 22 *Pat. Off. Gaz.* 419.

In 1861, a certain description and drawings were published in England, from which the United States, in 1863, caused to be constructed and placed on a vessel, certain armor. One Heaton conceived, in 1856, the idea of armor, and experimented by firing pistols at small pieces of wood and iron. In 1861, he began to make

a model of a war vessel. In 1862, it was completed. It was *held*, that his invention was later than the publication in England. An idea, to be considered an invention, in the frequent sense of the word, must be embodied in some distinct form. *Webb v. Quintard*, 9 *Blatchf.* 352 ; 1 *Pat. Off. Gaz.* 525 ; 5 *Fish. Pat. Cas.* 276.

The patent law protects simplicity and economy of construction as against prior complex and expensive combinations ; and although the general and abstract effect may be analogous, if the two mechanisms produce their respective results by essentially different processes, the one being more simple and capable of being operated with greater economy than the other, it is not anticipated thereby. In order that a prior patent or publication should anticipate a patent, the description must appear to embody substantially the same organized mechanism, operating substantially in the same manner as that described in the patent claimed to have been anticipated. *Gottfried v. Phillip Best Brewing Co.*, 17 *Pat. Off. Gaz.* 675 ; 5 *Bann. & A. Pat. Cas.* 4.

Apparently a description is not in a "printed publication" in the sense of the statute, unless copies have been printed and disseminated to render the work somewhat generally accessible. *Coburn v. Schroeder*, 20 *Blatchf.* 392. See *Keene v. Wheatley*, 9 *Am. L. Reg.* 33 ; 5 *Pa. L. J.* 501. And so *held* of printed circulars, limited in distribution, and giving a meager description of the invention. *New Process Fermentation Co. v. Koch*, 21 *Fed. Rep'r*, 580 ; 29 *Pat. Off. Gaz.* 535.

Test proposed, for determining whether the inventions described in an American and a foreign patent are the same, see *Commercial Manuf. Co. v. Fairbanks Canning Co.*, 27 *Fed. Rep'r*, 78.

218. *Fourth. Patentee not "First Inventor."*

By "the original and first inventor" is meant not necessarily he who first conceived the idea of the invention, but he who first gave to the idea a useful and practical form and matured for it a plan of material means by which it could have actual operation. *Boote v. Silsby*, 14 *How.* 218 ; aff'g 1 *Blatchf.* 445 ; *Teese v. Phelps*, *McAll.* 48 ; *Goodyear v. Day*, 2 *Wall. Jr.* 283.

In the sense of the term above indicated, "first inventor" means the person who first devises means to put the invention into practice ; he, and he only, is entitled to the patent. *Bedford v. Hunt*, 1 *Mas.* 302 ; *Union Sugar Refinery v. Matthiesen*, 3 *Cliff.* 639 ; 2

Fish. Pat. Cas. 600 ; Jones *v.* Sewall, 6 *Fish. Pat. Cas.* 343 ; 3 *Cliff.* 563 ; 3 *Pat. Off. Gaz.* 630 ; Ellithorp *v.* Robertson, 4 *Blatchf.* 307 ; 2 *Fish. Pat. Cas.* 83 ; Evans *v.* Weiss, 2 *Wash.* 342 ; 3 *Am. L. J.* 180 ; Parker *v.* Hulme, 1 *Fish. Pat. Cas.* 44 ; 7 *West. L. J.* 417 ; Reeves *v.* Keystone Bridge Co., 1 *Pat. Off. Gaz.* 466 ; 5 *Fish. Pat. Cas.* 456 ; 5 *Am. L. T. U. S. Cts.* 150 ; 9 *Phila.* 368 ; Miller *v.* Force, 9 *Fed. Rep'r*, 603 ; 21 *Pat. Off. Gaz.* 947 ; Allen *v.* Hunter, 6 *McLean*, 303, 321 ; Teese *v.* Phelps, *McAll.* 48 ; Brodie *v.* Ophir Silver Mining Co., 4 *Fish. Pat. Cas.* 137 ; 5 *Sawyer*, 608 ; Nichols *v.* Harris, 1 *MacArthur Pat. Cas.* 362.

In determining questions of priority of invention, it is not so much he who made and perfected the first machine or instrument who is to be considered the first inventor, as he who first conceived the idea and so described it by words or drawings as to have been sufficient to enable a skillful workman to bring it into useful practical operation. Such a person will be protected against the claim of any subsequent inventor who may have been first in adapting a machine or instrument to the invention, provided such first discoverer has been using due diligence in effecting the same end, so that, although he may have been unsuccessful in some of his experiments, by following them up he at length succeeds. Davidson *v.* Lewis, 1 *MacArthur Pat. Cas.* 599.

An inventor who reduces to practice his invention with reasonable diligence, has priority over one who subsequently conceives, though actually reducing to practice first, the device. Marshall *v.* Mee, 1 *MacArthur Pat. Cas.* 229 ; Heath *v.* Hildreth, *Id.* 12 ; Perry *v.* Cornell, *Id.* 60 ; McCormick *v.* Howard, *Id.* 238 ; Chandler *v.* Ladd, *Id.* 493.

He who invents first has the prior right, if he uses reasonable diligence in adapting and perfecting his invention, although a second inventor in fact perfects it and reduces it to practice in positive form before him. Electric R. R. Signal Co. *v.* Hall R. R. Signal Co., 6 *Fed. Rep'r*, 603. S. P., Reeves *v.* Keystone Bridge Co., 1 *Pat. Off. Gaz.* 466 ; 5 *Fish. Pat. Cas.* 456 ; 5 *Am. L. T. U. S. Cts.* 150 ; 9 *Phila.* 368 ; 2 *Bann. & A. Pat. Cas.* 256.

Even before a patent has been granted, the property in an invention belongs, generally, to him who is the first inventor ; therefore, any person who, knowing that another is the first inventor, yet doubting whether that other will ever apply for a patent, proceeds to construct a machine so invented by another, acts at his peril and with the full knowledge of the law that a subsequent

patent may put him out of the use of the machine thus created (*Evans v. Weiss*, 2 *Wash.* 342 ; *Evans v. Jordan*, 1 *Brook. Marsh.* 248 ; *aff'd*, 9 *Cranch*, 199) ; *a fortiori*, where the party constructing knew that the inventor had obtained a patent which was afterward declared invalid, but under a subsequent act of Congress a valid patent was secured. *Evans v. Weiss, supra.*

Where plaintiff's patented machine is anticipated by a machine containing parts different in form but performing the same functions as the like parts in complainant's machine, the scope of his patent will be limited to the improvements in form made in his patented machine. *Williams v. Barker*, 2 *Fed. Rep'r*, 649 ; 18 *Pat. Off. Gaz.* 243 ; 5 *Bann. & A. Pat. Cas.* 453.

The first inventor is entitled exclusively to a patent right, though a subsequent person may have also been an original inventor. The law gives the right, as among inventors, to him who is first in point of time. *Lowell v. Lewis*, 1 *Mas.* 182 ; *Reed v. Cutter*, 1 *Story*, 590 ; *Reed v. Robinson*, 4 *L. Rep'r*, 342 ; *Allen v. Blunt*, 2 *Woodb. & M.* 121.

A complete invention is not anticipated by a partial embodiment of the idea which was lacking in just those features necessary to its success (*Richardson v. Noyes*, 10 *Pat. Off. Gaz.* 507 ; 2 *Bann. & A. Pat. Cas.* 398) ; nor will crude and imperfect experiments, equivocal in their results, and therefore abandoned and given up, be permitted to prevail against an original inventor who has perfected his improvement and obtained his patent. *Union Sugar Refinery v. Mathieson*, 3 *Cliff.* 639 ; 2 *Fish. Pat. Cas.* 600 ; *Roberts v. Dickey*, 1 *Pat. Off. Gaz.* 4 ; 4 *Fish. Pat. Cas.* 532 ; 4 *Brews.* 260 ; 3 *Pittsb.* 352 ; *Roberts v. Schreiber*, 2 *Fed. Rep'r*, 855 ; 18 *Pat. Off. Gaz.* 125 ; 5 *Bann. & A. Pat. Cas.* 491 ; *Whittlesey v. Ames*, 9 *Biss.* 225 ; 18 *Pat. Off. Gaz.* 357 ; 5 *Bann. & A. Pat. Cas.* 96 ; *Fay v. Allen*, 24 *Fed. Rep'r*, 804 ; *Yale Lock Manuf. Co. v. Berkshire National Bank*, 26 *Id.* 104.

Although a person has engaged in producing some new and useful instrument or contrivance, and has embodied it in a machine and endeavored to reduce it to practice by experiment, yet if those trials fail, if he fail in success and abandon the effort, the consideration affords no impediment to another person who has taken up the same idea, or class of ideas, and who has gone on perseveringly in his studies, trials and experiments, until he has perfected the new idea and brought it into practical and useful operation. The latter is the person, the meritorious inventor, who is entitled to the

protection of the law. *Winans v. New York & Harlem R. R.*, 31 *Jour. Tr. Inst.* 3rd S. 322.

Although a party had conceived of the invention before the patentee, and made some progress toward completing a model, yet, if he suspended his labors, and before he resumed them, the patentee perfected the invention, and embodied it in a practical working machine, the patent will be sustained. *Smith v. O'Connor*, 4 *Pat. Off. Gaz.* 633 ; 6 *Fish. Pat. Cas.* 469.

Where the anticipatory device of defendant was discontinued, but not until its practicability had been demonstrated, it was held, sufficient to defeat the plaintiff's patent. *McNish v. Everson*, 5 *Bann. & A. Pat. Cas.* 484 ; 2 *Fed. Rep'r*, 899 ; 17 *Pat. Off. Gaz.* 1506.

The chance operation of a principle unrecognized at the time, without the knowledge of its method of employment, will not defeat the claim of one who first puts it into practical use, and makes it available. *Andrews v. Carman*, 13 *Blatchf.* 307 ; 9 *Pat. Off. Gaz.* 101 ; 2 *Bann. & A. Pat. Cas.* 277.

Mere speculations, not practically used, do not deprive a subsequent inventor who puts his invention into practice, of the proper reward. *Rich v. Lippincott*, 1 *Pittsb.* 31 ; 2 *Fish. Pat. Cas.* 1.

To constitute such a prior invention as will avoid a patent, there must be proof that some one, before the patentee, not only conceived the idea of doing what the patentee has done, but also reduced his idea to practice, and embodied it in some practical and useful form. The making of drawings of conceived ideas is not such an embodiment of such conceived ideas in a practical and useful form, as will defeat a patent which has been granted. *Ellithorp v. Robertson*, 4 *Blatchf.* 307 ; 2 *Fish. Pat. Cas.* 83 ; *Reeves v. Keystone Bridge Co.*, 1 *Pat. Off. Gaz.* 466 ; 5 *Fish. Pat. Cas.* 466 ; 5 *Am. L. T. U. S. Cts.* 150 ; *Detroit Lubricator Manuf. Co. v. Renchard*, 9 *Fed. Rep'r*, 293.

Although drawings by an inventor before application for a patent by him, may carry back the date of the invention, if reasonable diligence is shown, merely making drawings is not such an embodiment of an invention as will defeat a patent subsequently granted. *Odell v. Stout*, 22 *Fed. Rep'r*, 159 ; 29 *Pat. Off. Gaz.* 862.

Where the invention described and claimed is of a machine of specified construction, it is anticipated by a prior machine of substantially the same construction although a new, and perhaps

patentable use of the machine is suggested in the specification of the patent. *Boston Elastic Fabrics Co. v. East Hampton Rubber Thread Co.*, 1 *Holmes*, 372 ; 9 *Pat. Off. Gaz.* 745 ; 1 *Bann. & A. Pat. Cas.* 222.

It is no objection to a patent for a combination of machinery that any part of the structure existed before, unless the combination has existed before. *Re Halsey*, 1 *MacArthur Pat. Cas.* 459.

A patentee cannot embrace in a subsequent patent any invention embraced in a prior one granted to himself. *Hill v. Commissioner of Patents*, 1 *Cent. Rep'r*, 91.

Contract by employee of inventor of undisclosed process of manufacture, not to divulge the secret, is limited to term of employment. *Salomon v. Hertz*, 2 *Cent. Rep'r*, 132.

219. *Anticipation of an Invention by one earlier. Priority between Competitors.*

The first inventor is entitled to the benefits of his invention if he reduce it to practice and obtain a patent therefor, and a subsequent inventor cannot, by obtaining a patent, oust the first inventor of his right, or maintain an action against him. *Woodcock v. Parker*, 1 *Gall.* 438.

As between rival inventors he is entitled to a patent whose inceptive invention was the earliest, who was diligent in perfecting and adapting it, and in applying for a patent. *Kneeland v. Sheriff*, 5 *Bann. & A. Pat. Cas.* 482 ; 2 *Fed. Rep'r*, 901 ; 10 *Rep'r*, 234 ; 18 *Pat. Off. Gaz.* 242.

If two machines be substantially the same, and operate in the same manner, to produce the same result, though they may differ in form, proportions, and utility, they are the same in principle ; and the one last discovered has no other merit than that of being an improved imitation of the one before discovered and in use, for which no valid patent can be granted to any one ; because he cannot be considered as the original inventor of the machine. And it makes no difference as to the patentee's rights, whether the prior machine or invention has fallen into disuse or not ; if it was used before his discovery he cannot obtain a patent for it. *Evans v. Eaton*, 3 *Wash.* 443 ; *aff'd*, 7 *Wheat.* 356.

A patent relates back to the date of the application ; and

patents granted to other inventors during the pendency of such application, so far as they cover the same invention, are void, and no protection to an infringer. *Johnson v. Fassman*, 1 *Woods*, 138 ; 5 *Fish. Pat. Cas.* 471.

Where a dispute arises as to priority of invention, a patentee is allowed to show the real date of it, and to have his rights as fully secured as if he had taken out his patent. *Parker v. Hulme*, 1 *Fish. Pat. Cas.* 44 ; 7 *West. L. J.* 417. And see *MacDonald v. Blackmer*, 4 *Bann. & A. Pat. Cas.* 78

An article which could be made only as a mere curiosity, and not as an article for the trade, will not defeat a subsequent invention of a machine to make it. *Lamb v. Hamblen*, 11 *Fed. Rep'r*, 722.

In order to determine whether the mechanism of two machines is the same, an examination should be made not only of the mechanism itself, that is, the devices and their arrangements, but also of their mode of operation and their effects and results. *Eames v. Cook*, 2 *Fish. Pat. Cas.* 146.

Whether the one device is the same in substance or principle as another, depends on whether it is the same kind of instrument or not, and whether it acts in the same way in substance, and produces the same result in substance. *Colt v. Mass. Arms Co.*, 1 *Fish. Pat. Cas.* 108, 118 ; *Platt v. Manuf. Co.*, 5 *Fish. Pat. Cas.* 265 ; 9 *Blatchf.* 342 ; 1 *Pat. Off. Gaz.* 524 ; *Rumford Works v. Lauer*, 5 *Fish. Pat. Cas.* 615 ; 10 *Blatchf.* 122 ; 3 *Pat. Off. Gaz.* 249 ; *Singer v. Braunsdorf*, 7 *Blatchf.* 521 ; *Wilcox v. Komp*, 7 *Blatchf.* 126.

Where the real inventor obtains the later patent he may have the prior patent canceled. *Sturges v. Van Hagan*, 6 *Fish. Pat. Cas.* 572.

Making a device which will serve the same useful purpose as one afterward perfected, is not necessarily anticipating the latter. Where the mechanical means of two machines employed are different, and the mechanical result is different, one does not anticipate the other. *Buerk v. Valentine*, 5 *Fish. Pat. Cas.* 366 ; 9 *Blatchf.* 479 ; 2 *Pat. Off. Gaz.* 295.

Where two devices are similar in construction, but there is a difference in the elements of which they are necessarily composed, and in the use to which they are to be applied, there is a patentable difference. *Thayer v. Spaulding*, 27 *Fed. Rep'r*, 66.

If the inventor produced a new article he is entitled to a patent, although others approached very near to the invention without

producing it exactly. *M. & P. Manuf. Co. v. Du Bruil*, 2 *Bann. & A. Pat. Cas.* 618.

Where the claim of a patent is a combination claim, consisting of several elements that co-operate together to produce the device claimed, such device can only be anticipated by a prior device, having identically the same elements, or the mechanical equivalents, of those that are not used. It will not do to find a portion of these elements in one machine, and a portion in a second, and a third, and so on, and then say that the device is anticipated. *Worswick Manuf. Co. v. Steiger*, 17 *Fed. Rep'r*, 250.

220. *Examples of Anticipation and Priority.*

A patent for an improvement in tools for attaching sheet metal mouldings was *held* to be invalid, the invention having been anticipated by a machine for putting moldings on combs, although the latter was comparatively small, and was used only for combs; nothing appearing in the patented invention more than an adaptation of that machine not requiring the exercise of the inventive faculty. *Peters v. Active Manuf. Co.*, 21 *Fed. Rep'r*, 319; 28 *Pat. Off. Gaz.* 1102.

Improvements, by Bell, in telegraphy and electric telephony, covering the electric speaking-telephone, were *held* patentable to him, notwithstanding a claim that they had been anticipated by Drawbaugh; it appearing that the latter had made no effort to secure a patent for his invention for ten years after the time he claimed to have completed and demonstrated it. *American Bell Telephone Co. v. People's Telephone Co.*, 22 *Blatchf.* 531; 22 *Fed. Rep'r*, 309; 29 *Pat. Off. Gaz.* 1029.

In an action for damages for infringement of a patent for an improvement in perches for dump-cars, it was shown that dump-cars embodying the same invention were constructed some years before the patent, and that forty such cars were ordered built for a foreign railroad company, and were shipped to that company, presumably for use. Upon this showing, the court *held* the defense of want of novelty established. *Stitt v. Eastern R. Co.*, 22 *Fed. Rep'r*, 649.

In an action between patentees under different patents, in which the senior patentee alleged an infringement of his patent by the junior patentee, an adjudication that the senior patentee was not

the first inventor of the thing patented to him, was *held*, not to enlarge or affect the estate of the junior patentee ; where the thing patented to junior was not the same as that claimed by the senior ; although the junior could not make the article the subject of his invention without using the invention patented by the senior patentee ; and it was further *held* that such adjudication was not a bar to a subsequent suit by the senior patentee against a licensee of the junior, whose license was taken after the commencement of the first suit, and with notice thereof. *Brush v. Naugatuck R. Co.*, 24 *Fed. Rep'r*, 371 ; 32 *Pat. Off. Gaz.* 894.

221. *Fifth. Public Use or Sale before Application.*

The cases collected under this topic were decided, a part of them, under the act of 1836, § 15 (usually read in connection with the act of 1839, § 7, the others under the act of 1870, § 61, *Rev. Stat.* § 4920, subd. 5).

The language of the two acts is different, but the supreme court, per SAWYNE, J., in *Consolidated Fruit Jar Co. v. Wright*, 94 *U. S.* 92, 94, seems to have treated the difference as unimportant ; the cases are therefore gathered without special discrimination.

Upon the general rule, under the successive statutes, that the fact that an inventor permits public use or sale of his invention (by the existing law) "for more than two years before his application for a patent" renders any patent he may obtain, void,—see *McClurg v. Kingsland*, 1 *How.* 202 ; *Egbert v. Lippman*, 104 *U. S.* 333 ; *Consolidated Fruit Jar Co. v. Wright*, 94 *U. S.* 92 ; *Worley v. Tobacco Co.*, 104 *U. S.* 340 ; *Manning v. Cape Ann Isinglass, &c. Co.*, 108 *U. S.* 462 ; *aff'g 9 Rep'r*, 337 ; 4 *Bann. & A. Pat. Cas.* 612.

If an invention has, through the acts of the inventor, gone into public use beyond his control, his right to a patent is forfeited. *Jones v. Sewall*, 3 *Cliff.* 563 ; 3 *Pat. Off. Gaz.* 630 ; 6 *Fish. Pat. Cas.* 343. To same effect, *Plimpton v. Winslow*, 14 *Fed. Rep'r*, 919 ; 23 *Pat. Off. Gaz.* 1731 ; *Rich v. Lippincott*, 1 *Pittsb.* 31.

If an inventor allows his machine to be used by other persons generally, or if it is, with his consent, put on sale for such use, then it will be in public use and on public sale, within the meaning of the law. *Elizabeth v. Paving Co.*, 97 *U. S.* 126.

The public use of an invention, by its inventor, for more than two years prior to his application for a patent, deprives him of his

right and invalidates a patent obtained after such use. *Russell Manuf. Co. v. Mallory*, 10 *Blatchf.* 140; *Guidet v. Palmer*, *Id.* 217; *McMillan v. Barclay*, 5 *Fish. Pat. Cas.* 189; 4 *Breics.* 275; 3 *Pittsb.* 377.

The effect of allowing public use of an invention cannot be avoided by afterward assigning an interest in the invention to the persons who were allowed to use it. *Worley v. Tobacco Co.*, 104 *U. S.* 340.

The fact that an invention was in public use and on sale, with the consent and allowance of the inventor, more than two years before his application for a patent; renders the patent invalid, however great the hindrances to the application, and whether caused by the want of pecuniary means or other misfortune. *Sisson v. Gilbert*, 9 *Blatchf.* 185; 5 *Fish. Pat. Cas.* 109.

Mere delay in applying for a patent after invention made, works no forfeiture of right. But if other persons practice the invention in this country, whether with or without the knowledge or consent of the patentee, more than two years prior to the filing of his application, the patent is invalid. *Kelleher v. Darling*, 14 *Pat. Off. Gaz.* 673; 4 *Cliff.* 424.

The effect of the act of March 3, 1839, § 7, is to require that an inventor shall not permit his invention to be used in public at a period earlier than two years prior to his application for a patent, under the penalty of having his patent rendered void by such use. Consent and allowance by the inventor are not necessary to such invalidity. But *a fortiori*, consent to a use in public, not followed by an application for a patent within two years afterward, makes the patent, when granted, invalid. *Egbert v. Tappan*, 15 *Blatchf.* 295; 14 *Pat. Off. Gaz.* 822; *aff'd*, 104 *U. S.* 333.

As to when the two years' limitation for filing the application for a patent on an invention in public use begins to run,—see *Graham v. McCormick*, 5 *Bann. & A. Pat. Cas.* 244; 11 *Fed. Rep'r.* 859; 10 *Biss.* 39; 21 *Pat. Off. Gaz.* 1533.

222. *What Constitutes a Public Use.*

Use of an invention made by the inventor in good faith, for the purpose of testing its operation, ascertaining defects and maturing improvements, is not a public use which debars from obtaining a patent. The fact that he does not find need to make improvements; that the use is long continued; that it is on premises

not owned by the inventor ; that it is open to public inspection, and the public incidentally derive benefit from it, makes no difference. So long as he does not voluntarily allow others to make it and use it, and so long as it is not on sale for general use, he keeps the invention under his own control, and does not lose his title to a patent. *Elizabeth v. Pavement Co.*, 97 *U. S.* 126.

If an inventor, having made his device, gives or sells it to another, to be used by the donee or vendee without limitation or restriction, or injunction of secrecy, and it is so used, such use is public, even though the use and knowledge of the use may be confined to one person. *Egbert v. Lippman*, 104 *U. S.* 333.

Where an inventor allows the unrestricted use of his invention by another without injunction of secrecy or other condition, for more than two years prior to his application for a patent, although such use may be secret, this will constitute a public use and render the patent subsequently issued void. *Manning v. Cape Ann Isinglass, &c. Co.*, 108 *U. S.* 462 ; aff'g 9 *Rep'r*, 337 ; 4 *Bann. & A. Pat. Cas.* 612 ; *Burton v. Greenville*, 3 *Fed. Rep'r*, 642 ; 5 *Bann. & A. Pat. Cas.* 541 ; 18 *Pat. Off. Gaz.* 411.

Public use, in the sense of the patent law, is proved by a single unrestricted use by any person not the inventor, or by the inventor in an open way, provided the use is not experimental. *Jones v. Barker*, 11 *Fed. Rep'r*, 597 ; 22 *Pat. Off. Gaz.* 771. *S. P.*, *Clark Pomace Holder Co. v. Ferguson*, 17 *Fed. Rep'r*, 79 ; 24 *Pat. Off. Gaz.* 1090.

The use of an invention in a factory where any person may see it, is a public use ; and after two years of such use the invention becomes a public right. *Manning v. Cape Ann Isinglass, &c. Co.*, 108 *U. S.* 462 ; aff'g 9 *Rep'r*, 337 ; 4 *Bann. & A. Pat. Cas.* 612 ; see *Adams v. Edwards*, 1 *Fish. Pat. Cas.* 1.

The phrase means a use in a public manner, not use by the public generally. *Hunt v. Howe*, 1 *MacArthur Pat. Cas.* 366 ; *Henry v. Providence Tool Co.*, 14 *Pat. Off. Gaz.* 855 ; 3 *Bann. & A. Pat. Cas.* 501. But compare to the contrary, *American Hide, &c. Dressing Machine Co. v. American Tool Co.*, 1 *Holmes*, 503 ; 4 *Fish. Pat. Cas.* 284 ; and *Egbert v. Lippman*, 104 *U. S.* 333, 336.

The decisions are not agreed whether consent of the inventor to the public use, or sale, is necessary to render it operative in avoidance of the patent ; though the language of the opinion of Justice Wood, in *Manning v. Cape Ann Isinglass & Glue Co.*, 108 *U. S.* 462, implies that its necessity is not recognized. To like effect, see

Egbert v. Lippman, 15 *Blatchf.* 295, aff'd on other points, 104 *U. S.* 333 ; *Andrews v. Hovey*, 16 *Fed. Rep'r*, 387, 403 ; *Kelleher v. Darling*, 14 *Pat. Off. Gaz.* 673 ; and to the effect that unless the inventor consents to the prior use he does not lose his right, *Davis v. Fredericks*, 19 *Fed. Rep'r*, 99 ; *Emery v. Cavanagh*, 17 *Fed. Rep'r*, 242 ; *Campbell v. Mayor*, 9 *Fed. Rep'r*, 500 ; *Elizabeth v. Paving Co.*, 97 *U. S.* 126, 136.

Under the act of 1793, §§ 3, 6, and the act of 1836, §§ 6, 15, the public use or sale of an invention, in order to deprive the inventor of his right to a patent, must be a public use or sale by others with his knowledge and consent, before his application for a patent. If the use or sale is without such knowledge or consent, or if the use be merely experimental, to ascertain its value or utility, or the success of the invention by putting it into practice, that is not such a use as will deprive the inventor of his title. *Ryan v. Goodwin* 3 *Summ.* 514 ; 3 *L. Rep'r*, 220 ; *Wyeth v. Stone*, 1 *Story*, 273 ; 4 *L. Rep'r*, 54 ; *Pierson v. Eagle Screw Co.*, 3 *Story*, 402 ; *Jones v. Sewall*, 3 *Cliff.* 563 ; *Winans v. New York & Harlem R. R.*, 31 *Jour. Fr. Inst.* 3rd S. 32 ; *Campbell v. New York*, 9 *Fed. Rep'r*, 500 ; 20 *Blatchf.* 67 ; 20 *Pat. Off. Gaz.* 1817.

223. *Limits and Exceptions to the Rule Restricting Public Use.*

The use of an invention by the inventor himself, for the purposes of experiment, though continued for more than two years, will not deprive him of his right to a patent (*Jones v. Sewall*, 3 *Cliff.* 563 ; 3 *Pat. Off. Gaz.* 650 ; 6 *Fish. Pat. Cas.* 343 ; *Sisson v. Gilbert*, 9 *Blatchf.* 135 ; 5 *Fish. Pat. Cas.* 109 ; *Morris v. Huntington*, 1 *Paine*, 348 ; *McMillin v. Barclay*, 4 *Brews.* 275 ; 3 *Pittsb.* 377 ; 5 *Fish. Pat. Cas.* 189 ; *Birdsell v. McDonald*, 6 *Pat. Off. Gaz.* 682), especially where it has resulted in a change in the construction of the machine. *Andrews v. Carman*, 13 *Blatchf.* 307.

Public use of an invention, unless by the patentee himself, for profit, or by his consent or allowance, will not work a forfeiture of his title, as forfeiture is not favored, unless it clearly appears that the use was solely for profit, and not with a view of further improvements or of ascertaining its defects, or for any other purpose of experiment in reducing the invention to practice. *Emery v. Cavanagh*, 17 *Fed. Rep'r*, 242 ; 16 *Rep'r*, 100.

Under the laws of 1793 and 1839, § 7, it was *held*, that the

public use, to avoid a patent, must not be a private or surreptitious use in fraud of the patentee, but a public use by his consent, by a sale by himself, or by others with his acquiescence, by which he abandoned his right, or disabled himself from complying with the law; a patentee might take a reasonable time to try experiments with his invention, or might exhibit and explain it to persons whom he desired to consult; only such prior use as implied an abandonment involved a forfeiture of the right. *Sanders v. Logan*, 2 *Pittsb.* 241; *Whitney v. Emmett*, *Baldw.* 303.

Proof of use of the thing patented between the dates of the original and the reissued patents, will not defeat an action for infringement of the reissued patent. *Battin v. Taggart*, 17 *How.* 74, 84.

To constitute a prior use in public, which impairs a patent, the use must have been of the very improvement patented. Where it was of a less perfect article (not merely a colorable variation), no dedication results, although such article may embody features in common with what was patented thereafter. *Draper v. Wattles*, 16 *Pat. Off. Gaz.* 629; 3 *Bann. & A. Pat. Cas.* 618.

224. *Effect of Placing Invention on Sale.*

A single conditional sale of an invention, more than two years before an application, works a forfeiture of the patent. *Henry v. Francetown Soapstone Co.*, 2 *Fed. Rep'r*, 78; 17 *Pat. Off. Gaz.* 569; 9 *Rep'r*, 706; 5 *Bann. & A. Pat. Cas.* 108.

A patent is void, if, more than two years before the application therefor was filed, the patentee sold the patented articles for the double purpose of realizing the proceeds and of seeing if they would sell, and others had them in actual use. *Consolidated Fruit Jar Co. v. Wright*, 6 *Pat. Off. Gaz.* 327; 12 *Blatchf.* 149.

If necessary, in making tests, an inventor may sell a machine on trial so as to get it fully and fairly tested in practical use, by the class of persons for whose use it is intended; and such sale or use, even for more than two years, if made for the purpose of practical test, will not be a sufficient sale or public use to invalidate the patent. *Graham v. Geneva Lake Crawford Manuf. Co.*, 11 *Fed. Rep'r*, 138; 21 *Pat. Off. Gaz.* 1536.

The claim to an invention is not invalidated by a stipulation for its sale, made before it was completed. *Sparkman v. Higgins*, 1 *Blatchf.* 205.

The law permits an inventor to place a machine he is developing in friendly hands for the purpose of testing it, and if the machine is strictly an experiment, made solely with a view to perfect the device, the exclusive right of the inventor remains unimpaired. But when he puts his incomplete device upon the market, and sells it as a manufacturer more than two years before he applies for his patent, he gives to the public the device in the stage of development in which he sells it, and the patent cannot relate back to cover the forms it then had. *Lyman v. Maypole*, 19 *Fed. Rep'r*, 735.

225. *Decisions Illustrating the Doctrine as to Public Use or Sale.*

Laying a new kind of wooden pavement in a public city street, where it was in public view and was traveled upon for several years, done after filing a caveat for the invention and for purposes of experiment and improvement, was *held* not such public use as would avoid a patent. *Elizabeth v. Pavement Co.*, 97 *U. S.* 126.

A machine used for a number of years in the ordinary course of business, was *held* not an experimental machine; and, that such use was "public" although the shop where the machine was operated was kept locked, and no one but the workmen were allowed to examine it. *Perkins v. Nashua Card, &c. Co.*, 2 *Fed. Rep'r*, 451; 17 *Pat. Off. Gaz.* 1852; 10 *Rep'r*, 7; 5 *Bann. & A. Pat. Cas.* 395.

In the case of an improvement in the construction of cars for railroads, it was *held*, that as experiments to test the value of the invention could not be made except by putting the car into the service of lines of railroads, the use of cars, for such purpose, did not render the patent void. *Winans v. Schenectady & Troy R. R. Co.*, 2 *Blatchf.* 279. To the contrary, in a case of a prolonged use of an improvement upon steamboats. *McMillin v. Barclay*, 4 *Brews.* 275; 3 *Pittsb.* 377.

Nearly eight years before applying for a patent, the inventor voluntarily, and without reserve, sold a device embodying the invention, to a third party; knowing that it would be (and it was) publicly used. Such public use was *held* to have invalidated the patent. *Schneider v. Thill*, 5 *Bann. & A. Pat. Cas.* 565.

The public use of an invention was *held* not experimental, where the inventor himself manufactured and sold machines containing the invention, and allowed such machines to be used for

several years before applying for his patent. *Sisson v. Gilbert*, 9 *Blatchf.* 185 ; 5 *Fish. Pat. Cas.* 109.

A public use of an invention (an improvement in steam fire-engine pumps), which was in its nature intended for public use, was *held*, under the circumstances, experimental merely, and not to render subsequent patent invalid. *Campbell v. New York*, 9 *Fed. Rep'r.*, 500 ; 20 *Blatchf.* 67 ; 20 *Pat. Off. Gaz.* 1817.

Where a machine, for which a patent was afterwards claimed, was freely put into numerous mills which the inventors were employed to construct, throughout a period exceeding two years the facts were *held* to show a clear case of abandonment ; as such use of the invention could not be called experimental. *Sanders v. Logan*, 2 *Fish. Pat. Cas.* 167 ; 9 *Am. L. Reg.* 475 ; 2 *Pittsb.* 241.

The use of an invention for a fare register and recorder upon street railway cars, in the only manner in which it could be conveniently used, for the purpose of actual experiment to ascertain the best mode of construction, was *held* not such a public use as would invalidate a patent for the invention applied for more than two years afterwards. *Railway Register Manuf. Co. v. Broadway & Seventh Ave. R. Co.*, 22 *Fed. Rep'r.*, 655 ; 30 *Pat. Off. Gaz.* 180. But see decision granting rehearing, 32 *Pat. Off. Gaz.* 257 ; and in action on rehearing, 34 *Pat. Off. Gaz.* 921.

In an action for infringement of a patent for corset steels, it appeared that more than two years before applying for a patent the inventor made a pair of steels, and afterwards another pair for a lady to whom he was engaged, and who wore them until they were worn out ; also that he made a third pair for another lady. It was *held* that this was a use of the invention which was equivalent to an abandonment. It was not a use for experiment, or a use in private ; but a practical use of the completed article. No secrecy was maintained or enjoined. It was a disposal of the article for the general use of the recipient. *Egbert v. Lippman*, 15 *Blatchf.* 295 ; 14 *Pat. Off. Gaz.* 822 ; *aff'd*, 104 *U. S.* 333.

226. *The Invention had been Abandoned to the Public.*

The question of abandonment does not turn upon the intention of the inventor ; whatever may be his intention, if he suffers his invention to go into public use, through any means whatever, without an immediate assertion of his right, he is not entitled to a patent ; nor will a patent, obtained under such circumstances, protect

his right. And it makes no difference by what means an invention may be communicated to the public before a patent is obtained ; any acquiescence in public use, by the inventor, will be an abandonment as towards the public. *Shaw v. Cooper*, 7 *Pet.* 292, 320.

Acts of an inventor claimed to be a dedication, are to be construed liberally ; that is, he is not estopped by licensing a few persons to use his invention, in order to ascertain its utility, or by any such acts of peculiar indulgence and use, as may fairly consist with the clear intention to hold the exclusive privilege. *Mellus v. Silsbee*, 4 *Mass.* 108.

The inventor alone is competent to abandon his invention, and no use by the public, except with his knowledge and consent, can be deemed an abandonment of his patent. *Pierson v. Eagle Screw Co.*, 3 *Story*, 402.

Acquiescence by the patentee in the use by the defendant of an original defective patent, does not authorize the use of the invention after the issuing of a reissued patent. *McWilliams Manuf. Co. v. Blundell*, 22 *Pat. Off. Gaz.* 177 ; 11 *Fed. Rep'r*, 419.

Neither a stipulation for the sale of an invention before it is completed, nor a sale of such invention during the application for the patent, is an abandonment, or such a use as gives it to the public. *Sparkman v. Higgins*, 1 *Blatchf.* 205 ; 5 *N. Y. Leg. Obs.* 122 ; 6 *Pa. L. J.* 313.

Abandonment or dedication of an invention is in the nature of a forfeiture of a right. The law does not favor it, and it should be made out beyond all reasonable doubt. *Pitts v. Hall*, 2 *Blatchf.* 229. And, see *Seymour v. McCormick*, 16 *How.* 480 ; rev'g 2 *Blatchf.* 240 ; *McMillin v. Barclay*, 4 *Brews.* 275 ; 3 *Pittsb.* 377 ; *Hovey v. Henry*, 3 *West. L. J.* 153.

An invention may be abandoned to the public within two years prior to the procurement of a patent. The mere use or sale of the invention, however, within the two years, will not alone or of itself work an abandonment. The use or sale must be accompanied by some declaration or acts going to establish an intention on the part of the inventor to give to the public the benefit of the improvement. *Pitts v. Hall*, 2 *Blatchf.* 229.

But declarations of an intention to dedicate an invention to the public will not be regarded as equivalent to an actual dedication. Besides words, there must be acts, in order to fasten on a patentee the intention, which, in judgment of law, will work an abandonment of his invention. *Ib.*

Adverse knowledge and use of the device claimed, prior to the patentees' invention thereof, on a machine which was never completed, the device itself not being patented or otherwise given or made accessible to the public until long after the issue of complainant's patent, will not invalidate the exclusive right of the patentees. *Bullock Printing Press Co. v. Jones*, 13 *Pat. Off. Gaz.* 124 ; 3 *Bann. & A. Pat. Cas.* 195.

The omission by an inventor to claim a combination or device apparent upon the face of his patent, amounts to a dedication of the neglected contrivance to the uses of the public. *Swift v. Jenks*, 19 *Fed. Rep'r*, 641. To same effect, *Hawes v. Gage*, 5 *Pat. Off. Gaz.* 494 ; *Re Conklin*, 1 *MacArthur*, 375.

Where a device has been used by a prior inventor, but discontinued, a subsequent inventor cannot take it up and appropriate it exclusively. The invention thus becomes public property. *Shoup v. Henrici*, 22 *Int. Rev. Rec.* 114 ; 11 *Phila.* 514 ; 2 *Bann. & A. Pat. Cas.* 249.

An abandonment of a mechanical structure, the operative merit of which has been demonstrated by trial, will inure to the public, and an injunction cannot be obtained by a subsequent (even though original), inventor of substantially the same machine, who has obtained a patent therefor. *Pickering v. McCullough*, 6 *Rep'r*, 101.

The abandonment of a practical device by its inventor furnishes no warrant for a subsequent patentee to claim it as inventor. *McNish v. Everson*, 2 *Fed. Rep'r*, 899 ; 17 *Pat. Off. Gaz.* 1506 ; 5 *Bann. & A. Pat. Cas.* 484.

An abandoned experiment is not such a publication as will render invalid a patent subsequently granted for an invention similar to the thing experimentally produced. *Pickering v. Miller*, 15 *Rep'r*, 645 ; 25 *Pat. Off. Gaz.* 89.

The rule on the question of abandonment of an invention after application for letters patent is, that after the issue of letters patent, the abandonment must be shown to be positive, actual and intentional, by some act or declaration of the inventor, or by such gross laches as indicates unmistakably an intention to abandon the invention to the public. *Johnsen v. Fassman*, 1 *Woods*, 138 ; 5 *Fish. Pat. Cas.* 471.

The true meaning of the word "abandonment," as used in the acts of Congress relating to patents, is an abandonment of the invention to the public ; a dedication by the inventor of his discov-

cry to the free use of his fellow-beings. His merely withholding his invention from the public can never amount to an abandonment, however it may increase the difficulty of asserting and proving priority over another inventor. *Babcock v. Degener*, 1 *MacArthur Pat. Cas.* 607.

If an inventor abandon his invention, any patent subsequently issued to him therefor is invalid. *Consolidated Fruit Jar Co. v. Bellaire Stamping Co.*, 27 *Fed. Rep'r*, 377.

227. *By Delay in applying for Patent, or in prosecuting Application.*

Although the invention was original with the patentee and he was otherwise entitled, on seasonable application, to a patent, yet if the inventor delayed applying, and made his invention known, and suffered it to be used by the public without objection, his doing so will operate as an abandonment or dedication of it to the public. *Pennock v. Dialogue*, 2 *Pet.* 1; aff'g 4 *Wash.* 538; *Kendall v. Winsor*, 21 *How.* 322; *Whittemore v. Cutter*, 1 *Gall.* 478; *Mellus v. Silsbee*, 4 *Mass.* 108; *Thompson v. Haight*, 1 *U. S. L. J.* 575; *Winans v. Schenectady & Troy R. R. Co.*, 2 *Blatchf.* 270; *Evans v. Eaton*, *Pat. C. Ct.* 322; see reversal, 3 *Wheat.* 454; *Treadwell v. Bladen*, 4 *Wash.* 703; *Whitney v. Emmett*, *Baldw.* 303.

The mere forbearance on the part of an inventor to apply for a patent during the progress of experiments, and until he has perfected his invention, and tested its value by actual practice, affords no just grounds for any presumption that he has abandoned his invention, and surrendered or dedicated it to the public. *Agawan Co. v. Jordan*, 7 *Wall.* 573; *Jones v. Sewell*, 8 *Pat. Off. Gaz.* 630; 3 *Cliff.* 563; 6 *Fish. Pat. Cas.* 343; *Henry v. Francestown Soapstone Stove Co.*, 9 *Pat. Off. Gaz.* 408; 2 *Bann. & A. Pat. Cas.* 221; *Russell, &c. Manuf. Co. v. Mallory*, 10 *Blatchf.* 140; 2 *Pat. Off. Gaz.* 495; *Fish. Pat. Cas.* 632; *Locomotive Engine Safety Truck Co. v. Pennsylvania R. R. Co.*, 10 *Phila.* 252; 1 *Bann. & A. Pat. Cas.* 470.

If the prior invention was only an experiment, never perfected, but abandoned, the mere fact of an unsuccessful application for a patent makes no difference; it can only have a bearing on the

question of prior invention or discovery. *Brown v. Guild*, 23 *Wall.* 181; *Putnam v. Hutchinson*, 12 *Fed. Rep'r.* 127.

Inventors may, if they can, keep their inventions secret, and, if they do, no neglect to petition for a patent will forfeit their right to apply for one. *Bates v. Coe*, 98 *U. S.* 31.

Where an invention is voluntarily broken up and laid aside, through discouragement or dissatisfaction, yet not wholly with the intention of abandonment, and without any controlling impediment in the way of an application for a patent, and another, in the meantime, invents the same thing, without any knowledge of that which was so suspended, and having reduced the same to practice, applies for and takes out his patent, and introduces the patented invention into public use, the latter must be considered as the original inventor, rather than the one who laid his invention aside. But where some of the parts used in an inventor's experiment were preserved by him and finally embodied in his model for the patent office, and the evidence indicates that he only intended to postpone his application for the patent until certain objections to his making such application, not relating to the completeness of his invention, ceased to exist, it was *held* that the invention had not been abandoned. *White v. Allen*, 2 *Cliff.* 224; 2 *Fish. Pat. Cas.* 440.

Unavoidable delay while an application for a patent is pending is no ground for imputing abandonment. *Jones v. Sewall*, 3 *Cliff.* 563; 3 *Pat. Off. Gaz.* 630; 6 *Fish. Pat. Cas.* 343.

While an inventor has an application for a patent pending in the patent-office, and presses it from time to time as his means allow, he cannot be charged with having abandoned his improvement, although eight years elapse before he succeeds. *Goodyear Dental Vulcanite Co. v. Smith*, 1 *Holmes*, 354; 5 *Pat. Off. Gaz.* 585.

Where it appeared, by the admissions of the patentee, that the improvement claimed was invented in 1844, and that it was not embodied in the original patent of 1845, or noticed therein, until more than fourteen years after the invention, it was *held* that this rendered the claim void. *Sickels v. Falls Co.*, 4 *Blatchf.* 508; 2 *Fish. Pat. Cas.* 202.

If a party, upon the rejection of his application, withdraws all the papers except a drawing, and then permits his invention to go into notorious public use for a long time, the application will be deemed to be abandoned. *Bevin v. East Hampton Bell Co.*, 5 *Fish. Pat. Cas.* 23; 9 *Blatchf.* 50.

The effect of the provision of the act of 1870, § 35 (now Rev. Stat. § 4897),—that upon the hearing of the renewed application therein referred to, abandonment should be considered as a question of fact,—is that delay is not, of itself, conclusive evidence of abandonment, but the decision of each case depends upon the peculiar circumstances, treating the question as one of fact and not of law. *United States Rifle, &c. Co. v. Whitney Arms Co.*, 11 *Pat. Off. Gaz.* 373; 14 *Blatchf.* 94; 2 *Bann. & A. Pat. Cas.* 493.

Rev. Stat. § 4894, —which provides that upon failure to prosecute an application within two years after action is had thereon by the patent-office, it shall be regarded as abandoned,—refers to the application, not the invention; and does not prevent a subsequent application for the same invention. But such subsequent application can derive no aid as to the time from the prior abandoned application. The applicant must stand as to defenses in suits on the patent, as if the new application were the first. *Lindsay v. Stein*, 10 *Fed. Rep'r*, 997; 20 *Blatchf.* 370; 21 *Pat. Off. Gaz.* 1613.

Delay caused by public officials or courts cannot affect the rights of an applicant for a patent, where gross laches cannot be imputed to him; but one who does not prosecute his application with reasonable diligence may justly be treated as having abandoned it. *Adams v. Jones*, 2 *Pittsb.* 73.

So, if two distinct improvements in the same machine, are applied for jointly and covered by one patent, and if the inventor is mistaken as to one of the improvements claimed, but is entitled to a patent as to the other, he cannot be justly said to have abandoned either, during a litigation as to his right to both. *Ib.*

Delay in filing an application for a patent, or in prosecuting one punctually filed is no ground for charging the inventor with abandonment where the cause was, that he resided in the insurrectionary States during the rebellion. *Knox v. Loweree*, 6 *Pat. Off. Gaz.* 802; 1 *Bann. & A. Pat. Cas.* 589.

A patentee cannot be charged with having abandoned his invention because his solicitors, without his knowledge, neglect to file his application in the patent-office for more than two years after it has been sworn to, and was in all respects complete. *Birdsell v. McDonald*, 6 *Pat. Off. Gaz.* 682.

The provision of the act of 1870, § 35, for the renewal of rejected and withdrawn applications, is subject to the implied condition that the applicant has not lost his right to make the

application by abandonment or surrender of the same. *Marsh v. Commissioner of Patents*, 3 *Biss.* 321 ; S. C., *sub nom. Marsh v. Sayles*, 2 *Pat. Off. Gaz.* 340 ; 5 *Fish. Pat. Cas.* 610.

A patentee, who delays prosecuting infringers, for the reason that his patent is defective, and a reissue is necessary, but who meantime collects information which will enable him to sue the infringers, is not guilty of laches. *American Middlings Purifier Co. v. Christian*, 3 *Bann. & A. Pat. Cas.* 42.

As to abandonment of drawings, or of a model, of a machine made in the course of experiments which the inventor did not prosecute, and a patent for which he never applied. See *Lyman V. & R. Co. v. Lalor*, 12 *Blatch.* 303 ; 1 *Ban. & Ard.* 403 ; 6 *Pat. Off. Gaz.* 642 ; *Eickemeyer Machine Co. v. Pearce*, 6 *Fish.* 219 ; 3 *Pat. Off. Gaz.* 150 ; 10 *Blatch.* 403.

If an application for a patent on an invention is refused, and the inventor casts aside his invention, he thereby makes it public property, and cannot take it back and make it again his own. *Consolidated Fruit Jar Co. v. Bellaire Stamping Co.*, 27 *Fed. Rep'r.* 377.

228. *Examples of Abandonment under Peculiar Circumstances.*

One sued for an infringement has the right to show long delay of the inventor to prosecute his application for a patent when at first rejected ; it is an abandonment. W., in 1849, applied for letters patent for an improvement in planing machines. It was rejected, and he was notified he might "withdraw or appeal." He did not appeal ; and in 1852 the attorney by whom the application was made withdrew it. W. made no attempt to have it reinstated until 1870. During the intervening period he was not prevented by sickness or poverty from prosecuting the claim, had he desired ; for he took out other patents. And machines embodying the principle of his invention came into use. It was *held*, that his delay was an abandonment ; and avoided a patent which was finally granted to him on the application made in 1870. *Woodbury Planing-machine Co. v. Keith*, 4 *Bann. & A. Pat. Cas.* 100 ; *aff'd*, 101 *U. S.* 479.

When an inventor takes out a patent founded on a claim which does not include his whole invention, and rests for twelve years, and then surrenders his patent and takes a reissue with a broader

claim, under circumstances which warrant the conclusion that the act is caused by successful competition of a rival, he will be held to have dedicated to the public so much of his invention as was not included in the original claim. *Turner & Seymour Manuf. Co. v. Dover Stamping Co.*, 111 *U. S.* 319.

An inventor, at the time of making his invention, intended to apply for a patent, but was misled and induced to believe his invention had been anticipated by a patent of prior date. While laboring under this impression he decided to keep the invention secret, and practice it for his own benefit. As soon as he was undeceived, he began his preparations for an application for a patent. It was *held*, that such delay did not render him liable to forfeit his right to the patent. *Ayling v. Hull*, 2 *Cliff.* 494.

Where a machine similar to that described in the plaintiff's patent existed twenty years before, and only a single person testified to more than an experimental use of it, and it was soon after abandoned, it was *held*, that it did not invalidate the patent. *Blake v. Rawson*, 3 *Biss.* 77 ; 3 *Pat. Off. Gaz.* 122 ; 6 *Fish. Pat. Cas.* 74.

A machine was constructed in 1852, was kept in the cellar of the maker, was occasionally used there, and existed at the time of the plaintiff's invention, but its existence and use were not made public; the defendant, though the son of the maker, constructed a different machine for the same purpose, until he heard of the machine of plaintiff, in 1864, when he remembered and brought out and used the old machine. It was *held*, that this machine was an abandoned and lost invention, and its existence was no bar to a recovery by plaintiff, especially as the plaintiff had no knowledge of its existence at the time of his invention. *Hall v. Bird*, 6 *Blatchf.* 438 ; 3 *Fish. Pat. Cas.* 595.

An invention was *held* to have been abandoned when the author, after having reduced it to perfection and actual practice, took no further measures with it for nine years and suffered the molds to be lost, and meanwhile others, independently of him, reduced it to practice and introduced it extensively into market. *Consolidated Fruit Jar Co. v. Wright*, 6 *Pat. Off. Gaz.* 327 ; 12 *Blatchf.* 149.

Where an inventor perseveres in his application for a patent, although he may file several applications, some of which are withdrawn, and merely suspended operations until he could obtain means, the delay was *held* not an abandonment. *Adams v. Edwards*, 1 *Fish. Pat. Cas.* 1, 11.

Where an inventor made application for a patent for his invention, which was denied by the commissioner and affirmed on appeal to the circuit court, but afterward allowed by a new commissioner, the inventor continually insisting upon his rights, it was *held* that these involuntary delays, being mistakes of public officers or the delays of courts, and not caused by laches of the inventor, should not work an abandonment. *Adams v. Jones, Id.* 527; see also, *Sayles v. Chicago & Northwestern R. R. Co., 2 Fish. Pat. Cas.* 523.

Where an inventor has delayed eighteen years after completion of his invention before applying for a patent, and after having obtained a patent, delayed five years before applying for a reissue, and during this time made several improvements for which he obtained patents; it was *held* that the subject-matter not claimed in the original was abandoned to the public. *Re Conklin, 1 MacArthur, 375.*

As to what amounts to abandonment, see, also, *Bell v. Daniels, 1 Fish. Pat. Cas.* 372; *American Hide, &c. Dressing Machine Co. v. American Tool, &c. Co., 1 Holmes, 503*; *4 Fish. Pat. Cas.* 284; *Thompson v. Haight, 1 U. S. L. J.* 563; *McGaw v. Bryan, Id.* 582.

Where an inventor applied for a patent and his application was rejected, he making no appeal, nor any application for a re-examination, until ten years had elapsed, when he made a new application, paying a new fee; and where, in the meanwhile, his invention had gone into general use, it was *held*, that the first application had been abandoned, and that the patent upon the second was void, because of the public use, long continued, with the inventor's approval. *Bevin v. East Hampton Bell Co., 9 Blatchf.* 50; *5 Fish. Pat. Cas.* 23.

H. and T. filed their application January 27, 1855. It was rejected, and they withdrew it June 11, 1856, for the purpose of filing a new application, which was prepared and sent to their attorney in April, 1857; but the latter failed to file it until February 26, 1858, and the patent was issued thereon March 15, 1858. It was *held*, that there was a continuous application, and no evidence of abandonment. *Howes v. McNeal, 15 Pat. Off. Gaz.* 608; *15 Blatchf.* 103; *3 Bann. & A. Pat. Cas.* 376.

Where nothing was relied upon to defeat complainant's patent but the inventor's delay in prosecuting his application, it having been finally rejected by the commissioner April 11, 1857, and not appealed until August 16, 1860, during four years of which time

the patent-office was closed to him, by reason of his residence in a State that was in rebellion, it was *held*, that no direct or implied abandonment was shown. *Johnsen v. Fassman*, 5 *Fish. Pat. Cas.* 471 ; 1 *Woods*, 138.

Where an inventor whose application was rejected and withdrawn in 1851, delayed to renew it until 1869, and meanwhile, in 1859, a patent, on substantially the same improvement, was granted to another, the existence of which patent became known to the first inventor in 1865, it was *held*, that the legal inference from these facts was, that he acquiesced in the action of the patent office, and abandoned whatever claim he had to the public. *Marsh v. Commissioner of Patents*, 3 *Biss.* 321 ; S. C., *sub nom.* *Marsh v. Sayles*, 2 *Pat. Off. Gaz.* 340 ; 5 *Fish. Pat. Cas.* 610.

It is not material whether the rejection of his claim was right or wrong. Even if wrong, he was obliged, if he insisted on his claim, to take some action on the subject within a reasonable time, either by an appeal from the commissioner, or by a bill in equity, in the proper court. *Ib.*

An application for a patent made within the two years required by the statute, was rejected, the claim being defective and not covering the real invention. Another application was made within a reasonable time, but not within the two years from the date of public use, upon the same specifications and drawings, with a corrected claim covering the invention, upon which a patent issued. It was *held*, that under the circumstances, the two applications, for the purposes of the two years, would be regarded as one continuous proceeding dating from the filing of the first application. *Smith v. Prior*, 2 *Sawyer*, 461 ; 4 *Pat. Off. Gaz.* 633 ; 6 *Fish. Pat. Cas.* 469.

A claim in a reissued patent of a device not suggested in the original patent or in the drawing annexed thereto, but only by a model preserved in the patent-office, was *held*, under the circumstances of the case, invalid ; the omission of the patentee, for a period of eight years, to obtain a correction of his patent being deemed to operate as a dedication to the public of all not claimed by him in the original. *Flower v. Detroit*, 22 *Fed. Rep'r*, 292. And see *Matthews v. Flower*, 25 *Id.* 830.

Continued poverty, sickness and mental alienation are *held* sufficient excuses for delay in procuring a patent, there being no circumstances in the case showing any intention of abandonment.

Celluloid Manuf. Co. *v.* Crofut, 24 *Fed. Rep'r*, 796 ; 33 *Pat. Off. Gaz.* 235.

229. *Failure to Mark the Article "Patented."*

By Rev. Stat. § 4900, it is made a good defense to a recovery of damages for infringement, that the article was sold without being marked "patented" (with date of patent) unless the defendant continued dealing in it after notice that he was infringing. (See *ante*, p. 141.)

The defense of omission of the stamp "patented," fails if the word was affixed in any manner or on any part of the article ; or if defendant had even oral notice of the patent. New York Pharmaceutical Assoc. *v.* Tilden, 23 *Pat. Off. Gaz.* 272 ; 15 *Fed. Rep'r*, 98.

It is not defeated by proof that the nature of the article was such as to render affixing the mark specially expensive. Putnam *v.* Sudhoff, 1 *Bann. & A. Pat. Cas.* 198.

That this defense should be set up by answer, see Rubber Co. *v.* Goodyear, 9 *Wall.* 788 ; Herring *v.* Gage, 15 *Blatchf.* 124 ; 3 *Bann. & A. Pat. Cas.* 396.

230. *Matters of Defense Peculiar to Reissue Patents.*

Rights upon a reissue patent will not be defeated because the reissue appears not to be for the same invention as the original, if such result may be avoided by giving it a liberal construction. Glue Co. *v.* Upton, 4 *Cliff.* 237 ; 1 *Bann. & A. Pat. Cas.* 497 ; 6 *Pat. Off. Gaz.* 837 ; see *aff'ce* 97 *U. S.* 3.

No action can be brought for acts infringing a patent, where, after the acts complained of, the patent has been surrendered for reissue ; for surrender for reissue is equivalent to a distinct admission that the original patent has no such validity as will entitle the patentee to an action for infringement ; and the new patent, as a ground of action, can be operative only from its date. Moffitt *v.* Farr, 1 *Black*, 273 ; *aff'g* 1 *Bond*, 315.

A reissued patent for a process of compressing the coating used in the insulation of telegraph wires, was *held* void for anticipation by English patents ; and the patent for the process being void, the invalidity of the patent for the product follows as a consequence.

Western Electric Manuf. Co. v. Ansonia Brass, &c. Co., 114 *U. S.* 447.

The fact that a new claim embodied in a reissue patent is adjudged void, does not impair the validity of another, which is only a restatement of one in the original patent ; but the patentee, upon disclaiming the void claim, may have a decree (without costs) for infringement of the old and valid one. *Yale Lock Manuf. Co. v. Sargent*, 117 *U. S.* 536.

A patentee cannot be charged with fraud for asserting the validity of his reissue and claiming damages for its infringement, when the reissue was valid at the time of reissue, but by reason of a subsequent change in the rule of construction in the courts, has become invalid. *Pope Manuf. Co. v. Owsley*, 27 *Fed. Rep'r*, 100.

A reissue is void if there is an unwarrantable enlargement of the original patent. *Hoe v. Knap*, 27 *Fed. Rep'r*, 204.

When a patent has been surrendered for the purpose of securing a wider monopoly, and the specifications and claims of the reissue are identical with those of the original, the patent is abandoned and the reissue is a nugatory grant, because the precedent conditions therefor did not exist. *Celluloid Manuf. Co. v. Zylonite Brush & Comb Co.*, 27 *Fed. Rep'r*, 291.

The taking of a second or subsequent reissue, in order to reinstate the specification and claims of the original, precludes the assumption that the original was inoperative or invalid. A reissue of a patent granted merely to re-instate a patentee to an invention which he had surrendered, in order to obtain a wider monopoly, is valid. Where a patentee accepts a reissue containing the same claims as the original, he thereby declares that as to the invention he now claims, the original was not inoperative and void. *Ib.*

A reissue which seeks to cover something not suggested in the original patent, is void because of unlawful expansion. *Schultz v. Ostrander*, 27 *Fed. Rep'r*, 295.

The appropriate remedy where integral portions of an invention, proper subject-matter for a patent have been omitted from it, is a reissue ; the rights omitted cannot be secured by a distinct patent for them ; nor can the legal effect of the patent first issued be removed, except by surrender. *Hill v. Commissioner of Patents*, 1 *Cent. Rep'r*, 91.

Charge of fraud in a reissue will not be considered in a suit for infringement. *Schillenger v. Crawford*, 2 *Cent. Rep'r*, 680.

231. *Various Excuses for the Infringement Charged.*

It is no excuse for infringing a part of a patented invention that such part is not necessary to the successful working of the invention as patented. *Blaisdell v. Puffer*, 4 *Bann. & A. Pat. Cas.* 500.

An agreement for the transfer of the invention for the joint benefit of the inventors and those who will advance money for the manufacture or use of the machines invented, not carried into execution, and unaccompanied by any public use of the machine, but being prospective in its character, not consummated until within two years of the application, does not affect the validity of the patent. *Elm City Co. v. Wooster*, 6 *Fish. Pat. Cas.* 452 ; 4 *Pat. Off. Gaz.* 83.

Defendants were authorized to use one patented machine, and only one. They constructed and used two. It was *held* that they were not relieved from liability, by proof that both were never in operation at the same time. *Bloomer v. Gilpin*, 4 *Fish. Pat. Cas.* 50.

A person who infringes a patent is liable for the infringement, although what he does may be an improvement upon the patented device. *De Florez v. Reynolds*, 14 *Blatchf.* 505 ; 3 *Bann. & A. Pat. Cas.* 292. S. P., *Turrell v. Spaeth*, *Id.* 458.

When a license has been revoked by a plaintiff, and a defendant is sued as a naked infringer, he is at liberty to avail himself of any defense ordinarily open to a defendant charged with infringement. *Wooster v. Singer Manuf. Co.*, 23 *Pat. Off. Gaz.* 5513 ; 15 *Rep'r*, 524.

It is no defense to an infringement suit that the complainant has not put his alleged invention into practical use. *Broadnax v. Central Stock Yard, &c. Co.*, 5 *Bann. & A. Pat. Cas.* 609 ; 4 *Fed. Rep'r*, 214 ; 11 *Rep'r*, 6.

A license under a patent, other than the one sued upon, can have no independent efficacy in protecting the defendants. If such patent is for the same invention as the patent sued upon and of earlier date, it renders the patent sued upon void. If not for the same invention as the patent sued upon, it can confer no right to appropriate that invention. *Stuart v. Shantz*, 2 *Pat. Off. Gaz.* 524 ; 6 *Fish. Pat. Cas.* 35 ; 9 *Phila.* 376.

The manufacture of a separate element of a patented combina-

tion without intent of aiding an infringement, and not proved to be made for use in connection with the other elements, is not an infringement. *Saxe v. Hammond*, 1 *Bann. & A. Pat. Cas.* 629
1 *Holmes*, 456 ; 7 *Pat. Off. Gaz.* 781.

XVII. MEASURE OF RECOVERY OF DAMAGES, OR PROFITS, FOR INFRINGEMENT.

232. *Compensation for Actual Injury the General Rule.*

The plaintiff can recover only for actual damages, and he must show the damages by evidence. Where his profit is in the form of a royalty paid by licensees, and there are no peculiar circumstances, the recovery will be regulated by that standard. An instruction to the jury to award to the plaintiff "such sum as they should find to be required to remunerate him for the loss sustained by the wrongful act of the defendants, and to reimburse him for all such expenditures as have been necessarily incurred by him in order to establish his right," was *held* to be too broad and vague, and under which the jury could hardly doubt that it was their duty to allow counsel fees, and perhaps other charges and expenditures equally inadmissible. *Philip v. Noek*, 17 *Wall.* 460.

In cases where profits are the proper measure of damages, such profits as the infringer has made, or ought to have made, govern, and not those which the plaintiff can show that he might have made. This rule applies peculiarly and mainly to cases in equity, and is based upon the idea that as to such profits the infringer of the patent should be treated as a trustee for the owner thereof. In actions at law, the rate at which sales of licenses of machines were made, or the established royalty, constitutes the primary and true criterion of damages. In the absence of satisfactory evidence of that class, which is more appropriate in the forum where the case is pending, the other class may be resorted to as furnishing one of the elements on which the damages, or the compensation may be ascertained. *Burdell v. Denig*, 92 *U. S.* 716.

Although the defendant may have made no profits, and no license fee was established, yet where the sale of the infringing device has caused an enforced reduction of the price of the patented

device, this is the proper measure of damage. *Yale Lock Co. v. Sargeant*, 117 *U. S.* 536.

The rule is, that the verdict of the jury must be for the actual damages sustained by the plaintiff, subject to the right of the court to enter judgment for any sum not exceeding three times the amount of the verdict, together with costs. *Birdsall v. Coolidge*, 93 *U. S.* 64 ; 10 *Pat. Off. Gaz.* 748.

Where the unlawful acts consist in making and selling a patented improvement, or in its extensive and protracted use, without palliation or excuse, evidence of an established royalty will, in an action at law, undoubtedly furnish the true measure of damages ; but where the use is a limited one and for a brief period, the arbitrary and unqualified application of that rule is erroneous. *Ib.*

The plaintiffs must furnish evidence by which the jury may estimate actual damages. Damages cannot be calculated without certain data on which to proceed. If the plaintiff rest his case after merely proving an infringement, he is only entitled to nominal damages. *New York v. Ransom*, 23 *How.* 487. To same effect, *Blake v. Robertson*, 94 *U. S.* 728 ; *Black v. Thorne*, 111 *U. S.* 122 ; *Whittemore v. Cutter*, 1 *Gall.* 429. And see *Knight v. Gavit*, *Mir. Pat. Off.* 135 ; *Whitney v. Emmet*, *Baldw.* 363 ; *Schillinger v. Gunther*, 15 *Blatchf.* 303 ; 14 *Pat. Off. Gaz.* 713 ; *Garretson v. Clark*, 15 *Blatchf.* 70 ; 14 *Pat. Off. Gaz.* 485 ; *Matthews v. Spangenberg*, 14 *Fed. Rep'r*, 350 ; 14 *Rep'r*, 773 ; *Burdell v. Denig*, 2 *Fish. Pat. Cas.* 588.

The owner of a patent granted his interest in it to another, in consideration of certain payments to be made by the latter to third parties, &c. None of the payments were ever made ; and by mutual consent no part of the contract was ever carried out, because of the inability of the grantee. The grantor was obliged to pay the money which the grantee had agreed to pay ; and the latter, during his life, claimed no interest in the contract, but, on the contrary, recognized the exclusive right of the grantor, and acted as his agent in the patent, under a power of attorney, paying him part of the profits for the privilege. It was *held*, after the grantee's death, that the agreement did not prevent the grantor's bringing suit for the infringement of the patent without joining the grantee. *Railroad Co. v. Trimble*, 10 *Wall.* 367.

The price for which the plaintiff has sold his rights to certain territory is no criterion by which to determine the value of his patent, or the damages sustained from its infringement. Nor are

such damages to be estimated solely by the profits which the defendant actually realized, for he may have conducted his business unskillfully. The true question is, what advantage might the defendant, by skill, have obtained by using the patented device instead of the old device. *Campbell v. Barclay*, 5 *Biss.* 179.

In applying the provision of the statute, § 4921, that in a suit in equity the court may award, "in addition to the profits to be accounted for by the defendant, the damages complainant has sustained," it is pertinent to inquire as to whether the plaintiff has seen fit to retain a close monopoly of his invention, in which case the damages are computed by investigating the defendant's profits; or whether he saw fit to grant licenses to every one who offered to pay the stipulated fee, in which case the amount of such fee would be the proper measure of damage, except in cases of wanton infringement. *Goodyear Dental Vulcanite Co. v. Van Antwerp*, 2 *Bann. & A. Pat. Cas.* 252.

The rate of damages may now be said to be generally, 1. That the plaintiff may recover in equity the profits which the infringer has made from the use of the invention; or, 2. That he may recover at law the profits which were lost; and where it can properly be done, these profits will be regarded as simply the fee which would have been charged if the infringer had procured a license. But where the plaintiff has evinced an intention to exercise an exclusive user of his invention, and where the sales of licenses have been too few to establish a criterion of their actual or market value, courts have sought for other elements or evidences to determine the profits lost. *McKeever v. United States*, 14 *Ct. of Cl.* 396; 23 *Pat. Off. Gaz.* 1525; *aff'd, Id.* 1530; 18 *Ct. of Cl.* 757.

A patentee may either proceed in equity for the profits the defendant has made; or he may sue at law for the loss he has suffered. In the first case, if the defendant has realized no profit there can be no recovery; in the second, he may recover the damages he has sustained, whether the defendant has made any profit or not. *Cowing v. Rumsey*, 4 *Fish. Pat. Cas.* 275. But see *Dental Vulcanite Co. v. Van Antwerp*, 2 *Bann. & A. Pat. Cas.* 252.

There must be injury and damage; injury by a violation of the right, and damage, at least nominal, presumed by law to arise from such violation. *Byam v. Bullard*, 1 *Curt.* 100; 1 *Am. L. Reg.* 139.

But a sale of the thing patented to an agent of the patentee, employed by him to make the purchase, and on account of the

patentee, is not an act from which damage will be presumed, as it must be supposed to have been done for the patentee's benefit, or at least not to have been to his loss. Such a sale, however, accompanied by other circumstances, may warrant a jury in finding an infringement by sales to others than the patentee. *Ib.*

The general principle is, that the plaintiff is entitled to recover a fair and adequate compensation for the loss or injury he has sustained by the infringement. *Taylor v. Carpenter*, 2 *Woodb. & M.* 1; 10 *L. Rep'r*, 35; *Hall v. Wiles*, 2 *Blatchf.* 194; *Pitts v. Hall*, *Id.* 229; *McCormick v. Seymour*, 2 *Blatchf.* 240; *Buck v. Hermance*, 1 *Blatchf.* 398; *Kneass v. Schuylkill Bank*, 4 *Wash.* 9; *Parker v. Hulme*, 1 *Fish. Pat. Cas.* 44; 7 *West. L. J.* 428.

When a user of a machine in violation of a patent is proved, the value of the use of such a machine during the time of the illegal user is the measure of damage. *Whittemore v. Cutter*, 1 *Gall.* 478.

It is difficult to establish any general rule as to damages. The better course is not to lay down any particular rule of damages, but to leave the jury at large to estimate the actual damages according to the circumstances of each particular case. *Earle v. Sawyer*, 4 *Mas.* 1, 14.

The scope of a patented invention having been defined, and the court having declared that the damages could not exceed the profits arising from the use of the improvement, a failure to show any such profits makes nominal damages alone recoverable. *Gould's Manuf. Co. v. Cowing*, 14 *Blatchf.* 315; 12 *Pat. Off. Gaz.* 942; 3 *Bann. & A. Pat. Cas.* 75. And it was held no compliance with the rule that the profits arising from the use shall be proven, to show that wherever the particular patented improvement was introduced, other kindred devices could not be sold. *Id.*; *Black v. Munson*, 14 *Blatchf.* 265; but see 105 *U. S.* 253.

Where a patentee fraudulently leads a party to infringe his patent, and then brings an action against him, only nominal damages should be given. *Washburn v. Gould*, 3 *Story*, 122, 137; 7 *L. Rep'r*, 276; 1 *West. L. J.* 465.

When a patented invention, which is useless in itself, has been made useful by being combined with something else invented by another, or has been changed in its operation by an invention to which the owner of the worthless machine had no title or claim, the patentee of such worthless machine is not entitled to damages

for the use of it, although an injunction will be granted. *Whitney v. Emmett*, *Baldw.* 303, 329.

That, where a patent has been surrendered, and a reissue granted, no damages can be recovered for any acts of infringement committed prior to the reissue, see *Peck v. Collins*, 103 *U. S.* 660.

Upon a reference to ascertain the profits recoverable for infringement of a patent for improvements of devices previously in use, the burden is upon the complainant to prove the proportion of profits justly ascribable to his invention, and failing to prove this, he is entitled to only nominal damages. *Bostock v. Goodrich*, 25 *Fed. Rep'r*, 819 ; 34 *Pat. Off. Gaz.* 1047.

The profits of which the patentee is deprived by the manufacture or use of the device, only a single element of which is covered by his patent, constitute the measure of damages. *Putnam v. Lomax*, 10 *Biss.* 546 ; 9 *Fed. Rep'r*, 448.

Each claim of a patent covers a complete invention, and is, in substance, an independent patent. *Celluloid Manuf. Co. v. Zylonite Brush & Comb Co.*, 27 *Fed. Rep'r*, 291.

Where there is no evidence as to the value of the use of a patent, only nominal damages can be allowed. *Moffit v. Cavanagh*, 27 *Fed. Rep'r*, 511.

The measure of damages for infringement is the amount the plaintiff would have made, had it not been for defendant's unlawful action. *Hobbie v. Smith*, 27 *Fed. Rep'r*, 656.

Where the claims infringed are unimportant, only nominal damages can be allowed. *Moffit v. Cavanagh*, 27 *Fed. Rep'r*, 511.

233. *Exemplary or Punitive Damages not Allowable.*

The jury are not to award what are known as exemplary, vindictive, or punitive damages. *Seymour v. McCormick*, 16 *How.* 480, 489 ; *Whittemore v. Cutter*, 1 *Gall.* 478 ; *Hall v. Wiles*, 2 *Blatchf.* 194 ; *Pitts v. Hall*, *Id.* 229, 238 ; *Stimpson v. The Railroads*, 1 *Wall. Jr.* 164, 169. To the contrary, *Parker v. Corbin*, 4 *McLean*, 492.

Punitive damages for infringement are not to be visited upon a defendant who is not a willful infringer, but manufactures under a rival patent. *Buerk v. Imhaeser*, 10 *Pat. Off. Gaz.* 907 ; 14 *Blatchf.* 19 ; 2 *Bann. & A. Pat. Cas.* 452.

The question of damages is exclusively with the jury, and if

they are of the opinion that the defendant has unlawfully infringed, they ought to award plaintiff such sum, as, in their judgment, founded upon the evidence, would fully indemnify him for the actual damages he had suffered beyond the taxable costs. *Foote v. Silsbee*, 1 *Blatchf.* 445, 459 ; aff'd, 14 *How.* 218.

Where the defendants entered upon the violation of the plaintiff's patent, after having been warned of the consequences, and went on with their eyes open, disregarding the claims of the patentee, and showing a willingness to avail themselves of the profits of his discovery, and to deprive him of the fruits of his genius, time and expense ; it was *held*, that liberal damages were warrantable. *Ib.* 467.

When the defendant purchased the machine in the open market, not knowing that it was patented, and abandoned all the patented appliances on being notified of their infringement, it was *held*, that the case was not one for exemplary damages. *Emerson v. Simm*, 3 *Pat. Off. Gaz.* 293 ; 6 *Fish. Pat. Cas.* 281.

In patent cases, damages should be compensatory, not vindictive. The object is not punishment, but indemnity. The profits which the defendant has derived should be regarded, and the amount of loss which the plaintiff has sustained should be regarded also. *Knight v. Gavit*, *Mir. Pat. Off. Gaz.* 135.

234. Referring to License Fees, Royalties, &c., to Fix Damages.

The general rule is that if a patentee has established a fixed price at which he is accustomed to sell rights to manufacture under his patent, the jury may take that license fee as their guide in estimating damages against an infringer. *Hogg v. Emerson*, 11 *How.* 587, 607 ; *Seymour v. McCormick*, 16 *How.* 480, 488 ; *McCormick v. Seymour*, 3 *Blatchf.* 209 ; aff'd in part, 19 *How.* 96 ; *Sickles v. Borden*, 3 *Blatchf.* 535 ; *Wooster v. Simonson*, 20 *Fed. Rep'r*, 316 ; 28 *Pat. Off. Gaz.* 918 ; *May v. Fond du Lac County*, 27 *Fed. Rep'r*, 691.

So when it is difficult to ascertain the profits with exactness, a license fee may be adopted as the standard of profits. *Emigh v. Baltimore & O. R. R. Co.*, 4 *Hughes*, 271 ; 19 *Pat. Off. Gaz.* 935 ; 6 *Fed. Rep'r*, 283.

The above rule may be applied in determining the sum to be paid to a patentee, in a case where the user had been by consent of

the patentee but without any stipulation as to compensation, as well as in cases of unqualified infringement; the reason being even stronger in such a case. *Packet Co. v. Sickles*, 19 *Wall.* 611.

The license fee or royalty must have become uniform to warrant making it a measure of recovery against an infringer who has not assented to it; and proof of a single license is not sufficient to establish a market price for licenses. *Westcott v. Rude*, 19 *Fed. Rep'r*, 830; 27 *Pat. Off. Gaz.* 719.

Thus, if the patentee has been accustomed to take small fees in many cases, in order to get his invention introduced, the jury must take that fact into account in making their award. *Sickles v. Borden*, 3 *Blatchf.* 535.

A transfer of "the sole and exclusive right and monopoly of manufacturing" under a patent, by the owners, of their entire interest in the patent, to be paid for by a certain royalty, is not the establishment of an "ordinary license fee" within the rule, and the sum cannot be invoked as a safe criterion of damages, unless evidence is offered showing that the licensees of the complainants were deprived of the sale of the number of machines which the defendants manufactured and sold. *La Baw v. Hawkins*, 2 *Bann. & A. Pat. Cas.* 561.

An agreement by a licensee to pay a certain price, whether he use the entire invention or a part only, is no criterion by which to estimate the damages for an infringement of only one or two distinct claims in the patent, each of value. *Westcott v. Rude*, 19 *Fed. Rep'r*, 830; 27 *Pat. Off. Gaz.* 719. So the amount of plaintiff's established license fee cannot be adopted as a measure of damages where a part only of the patented invention is used by defendant. *Burdsall v. Coolidge*, 93 *U. S.* 64.

A rescinded contract for payment of a royalty is not competent in determining the measure of damages for an infringement. *Bussey v. Excelsior Manuf. Co.*, 1 *Fed. Rep'r*, 640; 1 *McCrary*, 161; 5 *Bann. & A. Pat. Cas.* 135.

It has been held that the award of damages reached by comparison with the patentee's usual license fee may be mitigated, if the maker of the machine was ignorant of the existence of the patent right, and did not intend any infringement, although such ignorance will not completely exonerate from damages. *Hogg v. Emerson*, 11 *How.* 587, 607.

If there is not an established, uniform license fee, the plaintiff must produce general evidence of actual damages sustained; such

as proof of the utility and advantage of the invention over the old modes or devices that had been used for working out similar results (*Suffolk Co. v. Hayden*, 3 *Wall.* 315); and if the proofs show that the same results were produced by other methods in common use, nominal damages only are recoverable. *Black v. Thorne*, 111 *U. S.* 122.

Occasional contracts of license cannot be considered a measure of damages. *Greenleaf v. Yale Lock Manuf. Co.*, 17 *Blatchf.* 253; 17 *Pat. Off. Gaz.* 625; 4 *Bann. & A. Pat. Cas.* 583.

235. *Damages Awarded in Peculiar Cases.*

When the language used by the judge in instructions to the jury was "exemplary damages," and open to be construed beyond this rule, but the jury appeared not to have gone beyond the actual injury sustained, it was *held*, that the verdict should not be disturbed. *Taylor v. Carpenter*, 2 *Woodb. & M.* 1; 10 *L. Rep'r*, 35.

Where the case admitted of only general evidence on the part of the plaintiff, and the defendants offered no proof on the question of damages, it was *held*, that the jury were warranted in exercising a liberal discretion. The defendants should have shown the amount of their sales, if necessary to prevent an excessive award. *Stephens v. Felt*, 2 *Blatchf.* 37.

When the invention was one of improvements in a pump only, numerous parts of which were in general use prior to the patent, and where plaintiff fails to show that the profits or damages arose from the improvement as distinguished from the entire machine, nominal damages only can be recovered. *Gould's Manuf. Co. v. Cowing*, 12 *Blatchf.* 243; 8 *Pat. Off. Gaz.* 277; but see 105 *U. S.* 253.

The distinction in respect to the measure of damages between a patent which covers an entire machine, and one for improvement on a machine, stated. *Seymour v. McCormick*, 16 *How.* 480, 491; *Tuttle v. Gaylord*, 28 *Med. Rep'r*, 97.

The patentee of a hotel register book is entitled to recover, as damages, not only the profit he might have made upon the book if he had sold it, but what he might have obtained from those who advertised in it. *Hawes v. Washburne*, 5 *Pat. Off. Gaz.* 491.

In an action for damages for the infringement of a patent of a water-wheel, one-fourth of the proceeds being estimated as the

profits of the mill, the damages were assessed at that amount. *Parker v. Banker*, 6 *McLean*, 631.

If the defendants used other improvements with the patented device which enhanced their value, they should have a corresponding reduction. The burden rests upon the defendant to show the value of such improvements. *Mulford v. Pearce*, 14 *Blatchf.* 141.

They will also be allowed to deduct royalty paid for improvement and cost of introducing the improvement. *American Nicolson Pavement Co. v. Elizabeth*, 6 *Pat. Off. Gaz.* 764.

When the patented device is distinguishable as an improved article of manufacture from that which is open to the public, the damages are not limited to the advantages derived by defendant in using improved article over that open to the public. *Mulford v. Pearce*, 14 *Blatchf.* 141.

Where a part owner of a patent sues a co-owner for using an infringing device, the recovery, if any, will be in proportion to their respective interests. *Herring v. Gas Consumers' Assoc.*, 9 *Fed. Rep'r*, 556 ; 3 *McCrary*, 206 ; 21 *Pat. Off. Gaz.* 203.

In what cases jury may consider costs in fixing damages, see *Day v. Woodworth*, 13 *How.* 363.

Principle on which damages should be computed where the injury caused by the infringement consists in compelling patentee to reduce his price. See *Fitch v. Bragg*, 16 *Fed. Rep'r*, 243 ; 21 *Blatchf.* 302 ; *Stephens v. Felt*, 2 *Blatchf.* 37 ; *Yale Manuf. Co. v. Sargeant*, 7 *Sup. Ct. Rep'r*, 934.

The measure of damages for the infringement of patents, determined, in view of particular facts. *Buerk v. Imhaeuser*, 10 *Pat. Off. Gaz.* 907 ; 14 *Blatchf.* 19 ; 2 *Bann. & A. Pat. Cas.* 452 ; *Cowing v. Ramsey*, 8 *Blatchf.* 36 ; *McKeever v. United States*, 14 *Ct. of Cl.* 396 ; 23 *Pat. Off. Gaz.* 1525.

In a suit for infringement of a patent for a machine, the infringement was limited to eighteen months as to four machines, and to three years as to two machines ; and the damages therefor were assessed by the master at the rate per machine of a sum which he found to be the fixed royalty for the term of the patent, the patentee having made his patent available exclusively by the sale of licenses for its use at such fixed sum. It was *held*, that this rule of damages was, under the circumstances, properly applied ; the infringement by the defendants having been deliberate, and their use of the invention, considering the nature of it and the business to which it was applied, having been extensive and protracted. *Stutz v. Armstrong*, 25 *Fed. Rep'r*, 147.

236. *Trebling the Damages.*

The proper course is for the jury to find the actual damages sustained by the patentee by the infringement, and it is discretionary with the court, in view of the circumstances of the case, to render judgment for any sum not exceeding three times the amount of the verdict. *Wilbur v. Beecher*, 2 *Blatchf.* 132, 143; *Conover v. Dohrman*, 3 *Fish. Pat. Cas.* 382; *Judson v. Bradford*, 16 *Pat. Off. Gaz.* 171; 3 *Bann. & A. Pat. Cas.* 539; *Stephens v. Felt*, 2 *Blatchf.* 37; *Guyon v. Serrell*, 1 *Blatchf.* 244; *Hall v. Wiles*, 2 *Id.* 194; *Parker v. Hulme*, 1 *Fish. Pat. Cas.* 44, 56. To nearly same effect, *Seymour v. McCormick*, 16 *How.* 480; *Livingston v. Woodworth*, 15 *How.* 546; *Saunders v. Logan*, 2 *Fish. Pat. Cas.* 167; 9 *Am. L. Reg.* 475; 2 *Pittsb.* 241.

The actual damages are, as a general rule, all that can be reasonably claimed for an infringement, though cases may arise where the circumstances are aggravated, and such as to repel altogether the *bona fides* of the infringement, in which the power to increase the verdict should be exercised. Each case must depend upon its own circumstances. *Guyon v. Serrell*, 1 *Blatchf.* 244; *Peck v. Frame*, 9 *Blatchf.* 194; 5 *Fish. Pat. Cas.* 113. See, also, *Russell v. Place*, *Id.* 134. They may be increased notwithstanding plaintiff, by reason of delay in filing a disclaimer, cannot recover costs. *Guyon v. Serrell*, 1 *Blatchf.* 244.

Previous to the act of 1836, the courts were compelled to treble the damages. Since that act they are not compelled to do so, but may increase them or not, at their discretion, within the threefold limit. In the exercise of that discretion, the court will not increase them if, in their opinion, the jury have already exceeded their proper measure (*Stimpson v. Railroads*, 1 *Wall. Jr.* 164; see, also, *Allen v. Blunt*, 2 *Woodb. & M.* 121); or where no special reasons are shown, such as malice, insufficiency of the verdict, or the like, for trebling (*Schwarzel v. Holenshade*, 2 *Bond*, 29; 3 *Fish. Pat. Cas.* 116); or when the action was brought after the expiration of the patent, and is prosecuted merely to collect damages (*Bell v. McCullough*, 1 *Bond*, 194; 1 *Fish. Pat. Cas.* 389); or in favor of a mere assignee of the right of action. *Schwarzel v. Holenshade*, 2 *Bond*, 29; 3 *Fish. Pat. Cas.* 116.

The power has been granted chiefly for the purpose of empowering the courts to remunerate parties driven to litigation to sustain

their patents, by wanton and persistent infringement. *Brodie v. Ophir Silver Mining Co.*, 5 *Sawyer*, 608 ; 4 *Fish. Pat. Cas.* 137.

The Federal courts sitting in equity had no power, under the act of July 4, 1836, § 14, to treble the damages found by them for violating a patent right, as they might do when sitting at law, and on a verdict and judgment. *Livingston v. Jones*, 3 *Wall. Jr.* 330 ; 2 *Fish. Pat. Cas.* 207.

That the power of "trebling," as conferred by Rev. Stat. §§ 4119, 4121, does not extend to profits, but is limited to damages, see *Campbell v. James*, 5 *Bann. & A. Pat. Cas.* 630 ; rev'd on other points, 104 *U. S.* 356. But under Rev. Stat. § 4919, where it appeared, in a suit in equity for infringement of a patent, that the defendant's profits derived from the use of the plaintiff's invention, did not amount to as much as the plaintiff's damages arising from the infringement, it was *held* that the court might add to the amount of such profits, a sum sufficient to make the amount decreed equal to the plaintiff's damages. *Simpson v. Davis*, 22 *Blatchf.* 113 ; 22 *Fed. Rep'r*, 444 ; *Willimantic v. Clark Co.*, 27 *Fed. Rep'r*, 865.

237. *Right to recover Profits.*

Another mode of ascertaining the damages is by inquiring what profits the infringer has realized from his unlawful use of the invention. In this class of cases, the plaintiff's measure of damages is the amount of profits actually received by the defendant from the sales complained of. *Lowell v. Lewis*, 1 *Mas.* 182 ; *Wilbur v. Beecher*, 2 *Blatchf.* 132, 143. S. P., *Hall v. Wiles*, *Id.* 194 ; *Pitts v. Hall*, *Id.* 229, 239.

In an action on the case for an infringement, it is erroneous to instruct the jury that the true rule in regard to damages is the profits made by the defendant by the infringement. The true rule is, what the plaintiff has lost, and not what the defendant has gained. *Cowing v. Rumsey*, 4 *Fish. Pat. Cas.* 275.

Where a patentee claims as damages a loss of profits caused by a loss of sales, resulting from an infringement, he must establish, by satisfactory evidence, that he would have sold more of the patented articles than he did sell, if the infringing articles had not been sold, and what profit he would have made on them, and what part of such profit is to be assigned to the invention patented. Such evidence must not be conjecture and speculation. *Ingersoll*

v. Musgrove, 14 *Blatchf.* 541 ; 13 *Pat. Off. Gaz.* 966 ; 3 *Bann. & A. Pat. Cas.* 304.

The measure of damages for infringement of a patent is the profits that the plaintiffs would have made on the sales of the patented article had they supplied the customers to whom the defendants sold such article. In estimating the amount of such profits the cost of manufacture and sale should be deducted, and on sales of a large amount, clerk-hire, storage, freight, &c., should be considered as part of such cost. *Zane v. Peck*, 23 *Pat. Off. Gaz.* 191.

The measure of damages for an infringement, where the defendant sold articles similar to those patented, at a loss, was *held* to be the profits the plaintiff would have made on the trade he would have had, and not on the amount of sales made by the defendant ; since it was to be inferred that the plaintiff at his price would not have sold as many as the defendant did at his. *Hall v. Stern*, 20 *Fed. Rep'r*, 788.

Should a party invent a machine having no value alone, and unsalable, and then use, in connection with his machine, the invention of another, which gives to the former a market value, the measure of damages is not the entire amount of profit, but the profit derived from the connection. *Whitney v. Mowry*, 4 *Fish. Pat. Cas.* 141 ; *rev'd* on other points, 14 *Wall.* 620.

Where the patent is for an improvement, the patentee is not entitled to all the profits that accrued in the manufacture of the whole article, but merely to the profits which were realized as the consequence of the improper use of the improvement. *Littlefield v. Perry*, 21 *Wall.* 205 ; 7 *Pat. Off. Gaz.* 964 ; *Ingels v. Mast*, 1 *Illippin*, 424 ; 2 *Bann. & A. Pat. Cas.* 24 ; *Gould's Manuf. Co. v. Cowing*, 12 *Blatchf.* 243 ; 8 *Pat. Off. Gaz.* 277 ; 1 *Bann. & A. Pat. Cas.* 375 ; *Gould's Manuf. Co. v. Cowing*, 14 *Blatchf.* 315 ; 12 *Pat. Off. Gaz.* 942 ; 3 *Bann. & A. Pat. Cas.* 75 ; *Black v. Munson*, 14 *Blatchf.* 265 ; 2 *Bann. & A. Pat. Cas.* 623 ; *Vaughan v. Cent. Pac. R. R. Co.*, 4 *Saw.* 280 ; 3 *Bann. & A. Pat. Cas.* 27 ; *Star S. C. Co. v. Crossman*, 4 *Bann. & A. Pat. Cas.* 566 ; *Maier v. Brown*, 17 *Fed. Rep'r*, 736. See *Manuf. Co. v. Cowing*, 105 *U. S.* 253.

On an injunction bill to restrain the infringement of a patent, where there is no dispute as to the title, the circuit court has jurisdiction, under the act of 1836, § 17 (5 Stat. 124), to refer the case to a master to take an account of the profits of which the plaintiff has been deprived by reason of the infringement. The defendant

is regarded as having been in the use and enjoyment of the property of the patentee, and as being bound in equity to account for the profits. *Allen v. Blunt*, 1 *Blatchf.* 480 ; 8 *N. Y. Leg. Obs.* 105

An infringer of a patent is, in equity, a trustee of the patentee, of the gains derived by him from the infringement. *Wetherill v. New Jersey Zinc Co.*, 1 *Bann. & A. Pat. Cas.* 485.

A party who has earned profits by the infringement of a patent is chargeable as trustee for the use of the real owner. *Vaughan v. East Tennessee, Virginia, &c. R. R. Co.*, 11 *Pat. Off. Gaz.* 798 ; 1 *Flippin*, 621 ; 2 *Bann. & A. Pat. Cas.* 537.

There is no right of action recognized, to recover profits for infringing a patent, founded on the theory that such profits should be treated as trust funds, and the infringer considered as a trustee *de son tort*. The act of infringement is but a simple taking and using another's property, without authority, for one's own advantage ; and this, of itself, does not confer equity jurisdiction. *Sayles v. Richmond, Fredericksburgh, &c. R. R. Co.*, 3 *Hughes*, 172 ; 25 *Int. Rev. Rec.* 209 ; 16 *Pat. Off. Gaz.* 43 ; 7 *Rep'r*, 743 ; 4 *Bann. & A. Pat. Cas.* 239.

The profits recoverable in equity by the owner of a patented invention from an infringer are such only as result directly and immediately from the infringement. Remote and contingent profits are not recoverable. Where the defendants in a suit in equity, by their use of the complainant's patented process of preserving fish, were enabled to withdraw fish from the market and thus obtain a higher price for their unpreserved fish than they would otherwise have received, it was *held*, that the profits resulting from such increased price were too remote and indirect to be charged against the defendants as profits realized from their infringement. *Piper v. Brown*, 1 *Holmes*, 196 ; 6 *Fish. Pat. Cas.* 240.

Where a patentee is entitled to profits, he is entitled to any profit the infringer has made by the unlicensed use of the contrivance included in the monopoly, and of that alone, without regard to profit or loss on the whole structure or machine of which such mechanism forms a part, and without recoupment for losses on other infringing mechanisms made or sold. *Graham v. Mason*, 1 *Holmes*, 88 ; 5 *Fish. Pat. Cas.* 290 ; 1 *Pat. Off. Gaz.* 609. Compare *Calkins v. Bertrand*, 8 *Fed. Rep'r*, 755 ; *Putnam v. Lomax*, 9 *Fed. Rep'r*, 448 ; 10 *Biss.* 546 ; 23 *Wall.* 261.

Where the infringer has made a profit on one fraction of the

mechanisms made and sold, but has met with losses on a larger fraction, so that a correct account of the whole operation would show a loss on the total manufacture, the patentee is entitled to the profits made on a bill counting generally against the infringer, without offset or deduction for losses made in the manufacture and sale of other infringing mechanism. *Graham v. Mason, supra.*

Where the patented invention consisted of a "bridle-motion" attachment for looms,—*held*, that the complainants had no right to any portion of the profits which the defendants made upon the looms to which the infringing mechanism was attached. *Ib.*

Where some of the infringing mechanisms made and sold by the defendant in a suit in equity on a patent, were made after a pattern of his own, differing from the complainant's in form, which was claimed to increase the value, and lessen the cost of manufacture of the mechanism,—*held*, that the complainants were entitled to recover all the profits on all the articles sold, including those made according to the defendant's own pattern. *Ib.*

And where an infringer sold parts of infringing mechanisms to repair and restore such mechanisms previously sold by him,—*held*, that the complainants were entitled in equity to recover the profits made on the sales of such parts, as well as on the sales of the original mechanism. *Ib.*

In cases in which gains and profits alone are to be awarded, when the defendant has used the infringing machine so unskillfully, or in a manner so unbusiness-like, that he has made no profit, the complainant can recover none. But the defendant cannot prejudice complainant's right to recover, by applying the gains arising from the use of an infringing machine, to make up losses on other branches of his business. *Conover v. Mers*, 11 *Blatchf.* 197; 6 *Fish. Pat. Cas.* 506.

An infringer is liable for profits although he might have employed some other contrivance than the one used to quite the same profit. *Burdett v. Estey*, 3 *Fed. Rep'r*, 566; 19 *Blatchf.* 1.

No profits will be decreed on accounting for infringement where none have accrued; but in proper cases damages may be had under Rev. Stat. § 4921. *Ib.*

The rule, that the profits which a plaintiff, who has made and patented an improvement upon an existing machine or manufacture, is to recover, must be those only which can be proved to have resulted from his own particular improvement upon the existing machine or manufacture, and that the burden of proof of such

profits is upon him, stated and applied. *Star Salt Caster Co. v. Crossman*, 4 *Bann. & A. Pat. Cas.* 566. See, also, *Garretson v. Clark*, 15 *Blatchf.* 70; 14 *Pat. Off. Gaz.* 485; 4 *Bann. & A. Pat. Cas.* 536; also 16 *Pat. Off. Gaz.* 806; 4 *Bann. & A. Pat. Cas.* 536; *Kirby v. Armstrong*, 5 *Fed. Rep'r*, 801; 10 *Biss.* 135; 19 *Pat. Off. Gaz.* 661; *Calkins v. Bertrand*, 8 *Fed. Rep'r*, 755; 10 *Biss.* 445; *Willimantic Thread Co. v. Clark Thread Co.*, 27 *Fed. Rep'r*, 865.

In cases of willful infringement, respondents ought to be held to the most rigid accountability, and no intendment ought to be made in their favor founded upon the alleged inconclusiveness of the complainant's proof of loss. Such proof ought to be interpreted most liberally in favor of complainants, within the limit of an approximately accurate ascertainment of their damages. *Bigelow Carpet Co. v. Dobson*, 10 *Fed. Rep'r*, 385; 13 *Rep'r*, 265.

Where a patentee is himself the infringer of rights under the patent which he has assigned, equity looks upon him as a trustee faithless to his trust; the violator of rights which he was bound to protect. It will accordingly charge him for all profits improperly made, as well for profits on original patents, the subject of original bill, as for profits made on reissues obtained *pendente lite*, and the subject of a supplemental bill. *Littlefield v. Perry*, 21 *Wall.* 205.

No stipulations between a patentee and his assignee, as to royalty to be charged, can prevent the latter from recovering from an infringer the whole profits realized by reason of the infringement. *Elizabeth v. Pavement Co.*, 97 *U. S.* 126.

Where it appears that some of the defendants have not been jointly concerned in the infringement for the whole time covered by the account, the several liability of all must be apportioned in making up the decree. *Tatham v. Lowber*, 4 *Blatchf.* 86.

In a suit against three defendants, it is proper to award against all three the profits made by them jointly, while partners, and against two of them the profits they made after their partnership with the third defendant was dissolved, and while they were using the patented invention in conjunction with a fourth person, not a defendant. *Herring v. Gage*, 15 *Blatchf.* 124; 3 *Bann. & A. Pat. Cas.* 396.

Where the thing patented was made in one district and used in another, and the bill prays for profits from both making and using and for an injunction, plaintiff may recover profits resulting from either making or using within the jurisdiction of the court,

and obtain an injunction against making, using and vending within the same. *Locomotive Engine Safety Truck Co. v. Erie Ry. Co.*, 6 *Fish. Pat. Cas.* 187; 10 *Blatchf.* 292; 3 *Pat. Off. Gaz.* 93.

Since Rev. Stat. § 4921, a court of equity has power, in a suit for infringement, to award damages for such loss as complainant has sustained, in addition to the profits he has lost. But profits continue to be proper measure of damages in equity, except where the injury is greater than the aggregate of what was made by defendant. *Willimantic Thread Co. v. Clark Thread Co.*, 27 *Fed. Rep'r*, 865.

238. *How Profits are Ascertained or Estimated.*

The damages recoverable upon a bill in equity for an infringement, do not extend to the entire profits realized by the infringer; whether the patent is for a machine or a process of manufacture. The question is as to the advantage derived by the infringer by his act. Such advantage is the measure of profit to be accounted for. *Mowry v. Whitney*, 14 *Wall.* 620; *Cawood Patent*, 94 *U. S.* 695. S. P., *Knox v. Great Western Quicksilver Min. Co.*, 7 *Rep'r*, 325; 14 *Pat. Off. Gaz.* 897; 4 *Bann. & A. Pat. Cas.* 25; 6 *Sawyer*, 430.

If the patentee does not sell rights to others, but uses his invention exclusively himself, and furnishes the products to the community himself out of his own manufactory, the profits of sales may become the criterion of the actual damages of the patentee. *Seymour v. McCormick*, 16 *How.* 480, 490; rev'g 2 *Blatchf.* 240; see *Seymour v. McCormick*, 19 *How.* 96; aff'g 3 *Blatchf.* 209, 225.

The measure is, the difference between cost of manufacture and price upon sale; and a controlling consideration is that the wrongdoer shall not reap an advantage from his wrong. *American S. Co. v. Emerson*, 8 *Fed. Rep'r*, 806.

Where the profits made by a defendant from the unlawful use of a patented invention amount to more than the license fees for such use would amount to, the plaintiff, although exercising his monopoly by the granting of licenses, is entitled to recover such profits on an accounting for profits, and is not limited to such license fees. *Wooster v. Taylor*, 14 *Blatchf.* 403; 3 *Bann. & A. Pat. Cas.* 241.

Where the infringement shown is of the invention as an entirety;)

as, where not merely the new parts in a combination of new and old, but the entire combination was used, the whole profits of infringer's sales are profits of infringement. *Ruggles v. Eddy*, 2 *Bann. & A. Pat. Cas.* 627 ; 12 *Pat. Off. Gaz.* 716.

Where the entire value of the whole machine as a marketable article is properly and legally attributable to the patented features, the profits may be estimated by showing the profits derived from making and selling the article containing the patented features, and the profits realized from the manufacture and sale of other forms of the same article not embodying the same features. *Garretson v. Clark*, 16 *Pat. Off. Gaz.* 806 ; 4 *Bann. & A. Pat. Cas.* 536.

Where the infringed patent is for an art, a fair measure of the infringer's actual profits is the saving in cost of production by the use of the appropriate invention, over the cost of production by cognate means, used and available. *Wetherill v. New Jersey Zinc Co.*, 1 *Bann. & A. Pat. Cas.* 435. Compare *Munson v. New York*, 16 *Fed. Rep'r*, 560 ; 16 *Rep'r*, 99.

When a patent covers but one of many features of a machine, the gains on the whole machine cannot be reckoned as damages for infringement thereof, but only the gains arising from the use of the special device or element claimed by such patent. The burden of proof is upon the complainant to separate or apportion the defendant's profits and complainant's damages between the features infringed and not infringed, and such evidence must be reliable and tangible, not conjectural or speculative ; or he must show by equally reliable and satisfactory evidence that the profits and damages are to be calculated on the whole machine for the reason that the entire value of the whole machine as a marketable article is properly and legally attributable to the patentable features. *Calkins v. Bertrand*, 8 *Fed. Rep'r*, 755 ; 10 *Biss.* 445.

The general principle is that a patentee is limited in his recovery of damages for infringement to such profits as may be properly apportioned to the use of his improvement. He can only recover profits upon the entire article when such article is wholly his own invention, or when its entire value is properly and legally attributable to the patented feature. Thus, if one discovers a new composition of matter, such as gun-cotton, nitro-glycerine, or vulcanized rubber, or invents some new machine, such as the telephone, or some new article of manufacture, such as barbed wire, or a new pavement, he is entitled to damages arising from the manufacture

and sale of the entire article. But if his invention be limited to some particular part of a large machine, such as the cut-off of an engine, the axle of a wagon, or the seat upon a mowing-machine, it is equally clear that his recovery must be limited to such profits as arise from the manufacture and sale of the patented feature. His damages, too, must be proved, and not left to conjecture; and the fact that it is impossible to separate the profits arising from the improvement from those incident to the manufacture of the whole machine, is an insufficient reason for awarding the plaintiff more than he is justly entitled to receive. In case he is unable to prove how much of the entire profit upon the machine is due to his patent, he can recover only nominal charges. *Maier v. Brown*, 17 *Fed. Rep'r*, 736; 10 *Biss.* 546; 16 *Rep'r*, 585; *Fitch v. Bragg*, 16 *Fed. Rep'r*, 243; 21 *Blatchf.* 302.

In estimating profits made by the infringer,—the saving to him by the use of the patented machine,—comparison must be made between the use of the patented invention, and the use of what was known and open to the public before the date of the patent, not with subsequent appliances. *Turrell v. Illinois Central Ry. Co.*, 20 *Fed. Rep'r*, 912; *Knox v. Great Western Quicksilver Mining Co.*, 14 *Pat. Off. Gaz.* 897; 7 *Rep'r*, 325; 4 *Bann. & A. Pat. Cas.* 25.

In estimating the profits realized from infringement of a patent, compensation is not allowed the infringer for his time and labor. *Piper v. Brown*, 1 *Holmes*, 198; 6 *Fish. Pat. Cas.* 240.

An allowance to the respondents of charges for extra work and materials upon condition of their assignment of the charges to the complainant will, if the arrangement is an equitable one, be confirmed by the court. *Brady v. Atlantic Works*, 15 *Pat. Off. Gaz.* 965; 3 *Bann. & A. Pat. Cas.* 577.

The profits for which an infringer is chargeable are to be computed, for a machine, by deducting from the articles made all the elements of costs in their production. *Troy Iron, &c. Factory v. Corning*, 6 *Blatchf.* 328; 3 *Fish. Pat. Cas.* 497.

In an accounting for profits, the defendant cannot be credited with a sum of money as a salary earned by, and paid to himself, while engaged in the business which earned the profits. *Williams v. Leonard*, 9 *Blatchf.* 476; 5 *Fish. Pat. Cas.* 381.

Interest on the cost of a device, and the cost of power, are to be allowed as deductions from profits, only when it is shown they

have been paid or incurred as debts. *Herring v. Gage*, 15 *Blatchf.* 124; 3 *Bann. & A. Pat. Cas.* 396.

In what cases the defendant is accountable only for what profits he actually made, not for what, by diligence and skill, he might have received, see *Livingston v. Woodworth*, 15 *How.* 546, *Dean v. Mason*, 20 *How.* 198; *Brady v. Atlantic Works*, 15 *Pat. Off. Gaz.* 965; 3 *Bann. & A. Pat. Cas.* 577.

Where the defendants are manufacturing under a patent which, although an infringement of the complainant's patent, contains valuable improvements upon it, and for which the defendants pay a royalty, the amount of the royalty paid by them is a proper item to be deducted from the aggregate amount of profits realized by them. The fact that the defendants have not actually paid the license fee to the owner of the subsequent patent does not change the rule, when it is shown that they are liable for the amount of such royalty. *La Baw v. Hawkins*, 2 *Bann. & A. Pat. Cas.* 561.

There cannot be any rule for estimating profits which will apply equally to all cases. The mode of estimating profits must depend upon the peculiar nature of the monopoly granted. *Mason v. Graham*, 5 *Fish.* 290; 1 *Holmes*, 88; 1 *Pat. Off. Gaz.* 608; reversed on other points, 7 *Pat. Off. Gaz.* 833; 23 *Wall.* 261.

239. *What Awards of Profits have been made under Special Circumstances.*

A question of infringement had been settled in favor of plaintiffs, and reference made to a master to report the amount of damages sustained by plaintiffs for the use by defendants of their invention. The master in his report based his opinion upon the productive capacity of the machines employed. It was *held*, that the calculation should have been made on the actual production of such machines of the article manufactured. *Webster v. New Brunswick Carpet Co.*, 9 *Pat. Off. Gaz.* 203; 2 *Bann. & A. Pat. Cas.* 67.

Where the suit was for infringing patents for certain improvements in coal stoves (coal stoves generally and various improvements on them having been long known), and decretal order directed account of all the profits which the defendants have received from the manufacture, use, or sale "of stoves, &c., embracing the improvements described in and covered by the said letters patent and the reissues thereof, or any of them," it was

held, that the order was too broad. The true question is, "What advantage did the defendant derive from using the complainant's invention over what he had in using other processes then open to the public, and adequate to enable him to obtain an equally beneficial result?" And the fruits of that advantage are his profits, and to be accounted for. *Littlefield v. Perry*, 21 *Wall.* 205.

The defendants, vendors of organs generally, and selling, sometimes organs having a patented invention consisting of a combination of what was called a "tremolo attachment" with the organ, and sometimes organs without the attachment, were decreed guilty, in their sales of organs with the attachment, of infringing the complainant's patent. It was *held*, that in ascertainment of profits made by them from the sales of the organs with the tremolo attachment, it was proper to let them prove the general expenses of their business in effecting sales of organs generally, and deduct a ratable proportion from the profits made by the tremolo attachment. *The Tremolo Patent*, 23 *Wall.* 518; *aff'g* 9 *Blatchf.* 385, 550; 5 *Fish. Pat. Cas.* 310, 537.

An order in a suit in equity, requiring the defendant to file a monthly account, on oath, of all "iron safes hereafter manufactured and sold by him," will be sufficiently complied with, by giving their number and inside dimensions, without stating the prices at which sold, or the names of the purchasers. It is sufficient to describe the articles in the account, so that persons in the trade can determine the value or price of them in the market, with a view to the amount of profits. *Wilder v. Gayler*, 1 *Blatchf.* 511.

The proper principles on which profits are to be computed against an infringer, explained, where the patent infringed was for an improved kind of fuel, and the master proceeded on the principle of charging as profits the value of the wood which, but for the use of the patented fuel, defendant must have burned. *Black v. Thorne*, 12 *Blatchf.* 20; 7 *Pat. Off. Gaz.* 176; 1 *Bann. & A. Pat. Cas.* 155.

Proper mode of computing profits determined, in a case where the master allowed the plaintiff for each article sold by defendant, the plaintiff's selling price, less cost and commission for making sales; and this was *held* erroneous because there was no proof that all who bought from defendant would have bought from plaintiff. *Buerk v. Imhaeuser*, 14 *Blatchf.* 19; 10 *Pat. Off. Gaz.* 907; 2 *Bann. & A. Pat. Gaz.* 452.

The proper mode of ascertaining the profits made by an infringer

explained ; and *held*, that in the particular case the proper inquiry was, not what saving the defendant had made by using the patented device, over the saving which he might have made if he had used any or all of various other devices, but what saving he had made directly by using the patented device. *Herring v. Gage*, 15 *Blatchf.* 124 ; 3 *Bann. & A. Pat. Cas.* 396.

An interlocutory decree directing an account of the gains, savings and advantages due to the infringement of a patent, in addition to the *profits*, and awarding *costs*, was *held* proper. *Coburn v. Schroeder*, 8 *Fed. Rep'r*, 521 ; 19 *Blatchf.* 493 ; 20 *Pat. Off. Gaz.* 1085 ; 12 *Rep'r*, 389.

In a former action against the maker of the infringing machine, there was a stipulation "that the amount of recovery to be adjudged against the defendants in case of a decree for complainant shall be fixed and determined upon the evidence in the case submitted at final hearing, and both parties request the court, in case of a decision against the defendant, to fix, as the amount of recovery, such amount of damages as is proved by such testimony." It was *held*,

1. The court, by giving nominal damages in the absence of proof, did not thereby adjudge in that case that one dollar was the value of the invention.

2. The amount of damages to be recovered against the user of the infringing machine was the profit which the plaintiff ordinarily received on the sale of a machine of the same size, using the patent so infringed; if such profits could not be ascertained, they could not be recovered. *Blake v. Greenwood Cemetery*, 16 *Fed. Rep'r*, 676 ; 25 *Pat. Off. Gaz.* 89 ; 15 *Rep'r*, 741.

Plaintiff was the owner of a patented improvement in trunks, which consisted in covering the frame of the trunk with narrow strips of wood, laid in close proximity to each other, all around its top and sides. Defendant infringed by manufacturing and selling trunks containing the patented covering. It was *held*, that plaintiff could not recover the net profits made by defendant in the manufacture and sale of the entire trunk, but was limited to such as were properly attributable to his improvement. A proper method of estimating damages would be to take the profits made by the defendant upon one of these trunks, and deduct from them the profits upon an ordinary trunk of similar size and general description. The difference might be properly credited to plaintiff's invention. *Maier v. Brown*, 17 *Fed. Rep'r*, 736 ; 16 *Rep'r*, 585 ; 10 *Biss.* 546.

Where Congress consent to an action "for damages occasioned by the annulment" of the claimant's contract, "and also for the use of said Nock's patent in the manufacture of mail locks subsequent to such annulment," the claimant may recover the profits which he would have made under his contract as manufacturer, or a royalty under the patent; but he cannot have both. Damages for the use of his patent are included in his profits as manufacturer. *Nock v. United States*, 2 *Ct. of Cl.* 451.

Various principles governing the estimate and allowance of profits against a corporation found chargeable with infringement; and the computation of expenses of manufacture which the corporation is entitled to have deducted from the gross prices realized from sales, explained. *Steam Stone Cutter Co. v. Windsor Manuf. Co.*, 17 *Blatchf.* 24; 4 *Bann. & A. Pat. Cas.* 445.

How profits are to be ascertained, in cases when they may be allowed, are determined, with references to the circumstances of particular cases. *Wilbur v. Beecher*, 2 *Blatchf.* 132, 143; *Tatham v. Lowber*, 4 *Blatchf.* 86; *Marsh v. Warren*, 14 *Blatchf.* 265; *Bigelow Carpet Co. v. Dobson*, 10 *Fed. Rep'r.*, 385; 13 *Rep'r.*, 265; *Kendrick v. Emmons*, 15 *Pat. Off. Gaz.* 966.

240. *Effect of Recovery and Payment of Damages.*

The recovery of a verdict by the plaintiff, in an action for infringement, does not pass any legal right to the defendant to use the machine made by him. Every future use will be an infringement of the plaintiff's patent. *Whittemore v. Cutter*, 1 *Gall.* 478, 484. S. P., *Suffolk Co. v. Hayden*, 3 *Wall.* 315. But compare *Sickels v. Borden*, 3 *Blatchf.* 535.

When a patentee gets his remuneration by the sale of his patented machine for use by others, a recovery of profits and damages from the manufacturer of an infringing machine, followed by payment, is a full compensation for his injury, and places him in the same position as if he had made and sold the machine himself; and confers on defendant the right to use the machine while it lasts. The patentee has obtained all that the law gives him, and the particular article or machine becomes, in effect, licensed by the patentee. *Perrigo v. Spaulding*, 13 *Blatchf.* 389; 12 *Pat. Off. Gaz.* 352; 2 *Bann. & A. Pat. Cas.* 348. S. P., *Booth v. Seevers*, 19 *Pat. Off. Gaz.* 1140; *Spaulding v. Page*, 1 *Sawyer*, 702; 4 *Fish. Pat. Cas.* 461; 4 *Am. L. T. U. S. Cts.* 166.

When a patentee gets his remuneration in the exclusive use of his machine and the sale of its products, a recovery will not give the infringer any right to the further use of the infringing machine. *Ib.*

The damages recovered in a suit for infringement are merely a satisfaction for prior use, and do not free the parties infringing from the operation of the patent. *Matthews v. Spangenberg*, 23 *Pat. Off. Gaz.* 1624 ; 15 *Fed. Rep'r*, 813.

The recovery of nominal damages in an action for infringement of a patent, and the tender of such sum by the maker of the machine so infringing, do not operate as a license to the maker or his vendees as to existing infringing machines so made, nor as a bar to a recovery in another action against a subsequent user of the same machine. *Blake v. Greenwood Cemetery*, 16 *Fed. Rep'r*, 676 ; 25 *Pat. Off. Gaz.* 89 ; 15 *Rep'r*, 741.

A party who has elected to take judgment for profits in an action for damages for infringement of a patent, which judgment has not been reversed, cannot prosecute a second action for other damages arising out of the same acts of infringement. For a single wrong, the damages for which are capable of ascertainment, and which is not in the nature of a continuing nuisance or trespass, only one action will lie, and the damages must be assessed once for all. *Child v. Boston, &c. Iron Works*, 19 *Fed. Rep'r*, 258.

The owner of a patent who, in an action against an infringer who has made and sold for use machines covered by the patent, has recovered the profits of such sales, cannot afterwards recover from a purchaser of such machines profits derived by him from the use of them. *Steam Stone Cutter Co. v. Sheldon*, 22 *Blatchf.* 484 ; 21 *Fed. Rep'r*, 875.

241. *Statutory Recovery of Damages, in Equity.*

The object of the new provision in the act of July 8, 1870, § 59 (now Rev. Stat. § 4921),—that a complainant in equity may recover, in addition to the profits accounted for by defendant, the damages the complainant has sustained,—was to enable the plaintiff, by bringing a suit in equity, to recover in such suit, not only the profits made by the defendant by means of the infringement, but also the damages sustained by the plaintiff thereby. In the absence of this provision, this could not have been done. But under this provision a plaintiff cannot recover, as damages, any items which

he could not recover as damages in an action on the case. *Bancroft v. Acton*, 7 *Blatchf.* 505.

In a suit in equity for an infringement, brought before the passage of the act of 1870, both profits and damages could not be recovered. *Williams v. Leonard*, 9 *Blatchf.* 476 ; 5 *Fish. Pat. Cas.* 381.

Where a decree is entered for complainant, he may recover, in addition to the profits to be accounted for by the respondent, the damages he has sustained, and the court may, in its discretion, assess the same. Profits are to be accounted for in such case by the respondent whenever the decretal order to that effect is entered ; and if the injuries sustained by the complainant from the infringement are greater than the gains and profits realized by the respondent, then the complainant is entitled to recover compensation for the excess of the injuries beyond the amount estimated for profits of the respondent. *Carew v. Boston Elastic Fabric Co.*, 3 *Cliff.* 356 ; 5 *Fish. Pat. Cas.* 90 ; 1 *Pat. Off. Gaz.* 91.

A suit in equity for infringement may be maintained for damages sustained from the infringement as well as for an account of profits ; but if the profits exceed the damages the former only will be allowed. And the damages must be confined to the direct and immediate consequences of the infringement, and not embrace those which are both remote and conjectural. *Buerk v. Imhaeuser*, 10 *Pat. Off. Gaz.* 907 ; 14 *Blatchf.* 19 ; 2 *Bunn. & A. Pat. Cas.* 452.

The terms "profits" and "damages," as used in the patent act, are not convertible. Damages are to be awarded "in addition" to profits. "Profits" refers to what the defendant has gained by the unlawful use of the patented invention, and "damages" to what the claimant has lost. In equity, under the existing laws, a complainant can recover both profits and damages. But the amount of the license fee fixed by the complainant is usually considered a proper compensation in damages, except in those cases where the evidence warrants an allowance of exemplary or punitive damages by reason of a wanton infringement. *Goodyear Dental Vulcanite Co. v. Van Antwerp*, 9 *Pat. Off. Gaz.* 497.

The damages to be recovered by Rev. Stat. §§ 4917, 4921, are "actual damages," and may properly be awarded in a case where sale of an infringing device has enforced a reduction of price of plaintiff's device, even though defendant made no profits and the

defendant may have had no license fee. *Yale Lock Manuf. Co. v. Sargent*, 117 *U. S.* 536.

Where it appeared that the defendant had derived no gains profits or advantages by reason of his infringement, the complainant was *held* entitled to damages only, to be limited to the amount of the license fee established by him. *Locomotive Engine Safety Truck Co. v. Pennsylvania R. R. Co.*, 2 *Fed. Rep'r*, 677 ; 10 *Rep'r*, 39 ; 5 *Bann. & A. Pat. Cas.* 514 ; *Williams v. Rome, Watertown, &c. R. Co.*, 2 *Fed. Rep'r*, 702 ; 18 *Blatchf.* 181 ; 17 *Pat. Off. Gaz.* 1447 ; 5 *Bann. & A. Pat. Cas.* 423.

In an accounting before a master in an infringement suit, it appeared that the defendants had made no profits on the articles sold by them. It was *held*, that the complainant company could not recover as damages the profits it would have made on the articles sold by the defendants. *St. Louis Stamping Co. v. Quinby*, 5 *Bann. & A. Pat. Cas.* 275.

A court of equity has no jurisdiction of a suit to recover damages for the infringement of a patent, unless there is a valid demand in the bill for an injunction against further infringement. *Burdell v. Comstock*, 15 *Rep'r*, 742.

Profits are the net gains of the infringer from the use of the patented invention, while damages are the losses sustained by the owner in consequence of the infringement. Sometimes the profits of the infringer form the sole criterion of the actual damages sustained by the patentee, and then a report of the net gains covers the whole ground of profits and damages. In other instances it would be the duty of the master to add together the net gains of the infringer and the license fee which the patentee has fixed, and to make the aggregate the measure of the profits and damages which the wrongdoer ought to pay. *La Baw v. Hawkins*, 2 *Bann. & A. Pat. Cas.* 561.

Compensatory damages for the infringement of letters patent may be allowed in equity, notwithstanding the business of the infringer was so improvidently conducted as to yield no substantial profits. *Marsh v. Seymour*, 97 *U. S.* 348.

No profits will be decreed on accounting for infringement, where none have accrued, but in proper cases damages may be had under Rev. Stat. § 4921. *Burdett v. Estey*, 3 *Fed. Rep'r*, 566 ; 19 *Blatchf.* 1.

Where the master reported that there were no damages and no profits, but that the use of the patent restored the salable character

of the article the defendant made, and thus saved the defendant from loss. It was *held*, that the money value of such advantage could be recovered as compensation. *Sargent v. Yale Lock Manuf. Co.*, 17 *Blatchf.* 249 ; aff'd, 117 *U. S.* 536 ; 17 *Pat. Off. Gaz.* 106 ; 4 *Bann. & A. Pat. Cas.* 579.

242. Interest.

Under the general rule that interest upon unliquidated damages is not recoverable, interest is not allowable upon profits awarded to be paid over by an infringer of a patent, to the patentee, until from date of final decree. *Mowry v. Whitney*, 14 *Wall.* 620. To same effect, *Silsby v. Foote*, 20 *How.* 378 ; rev'g 2 *Blatchf.* 260 ; *Parks v. Booth*, 102 *U. S.* 96 ; *Brady v. Atlantic Works*, 15 *Pat. Off. Gaz.* 965 ; 3 *Bann. & A. Pat. Cas.* 577 ; *Holbrook v. Small*, 17 *Pat. Off. Gaz.* 55.

As a general rule, interest on profits is not allowable. Special circumstances may, however, justify the addition of interest. *Littlefield v. Perry*, 21 *Wall.* 205.

Interest allowed, in particular cases, on the damages reported by a master for an infringement of patent. *Illinois Central R. R. Co. v. Turrill*, 110 *U. S.* 301 ; *Tatham v. Lowber*, 4 *Blatchf.* 86 ; *Burdett v. Estey*, 3 *Fed. Rep'r.* 566 ; 19 *Blatchf.* 1 ; *Steam Stone Cutter Co. v. Windsor Manuf. Co.*, 18 *Blatchf.* 47 ; 5 *Bann. & A. Pat. Cas.* 335.

Interest is properly allowable on a decree for profits on the infringement, from the time the report is in proper form for exceptions. *Turrill v. Illinois Central Ry. Co.*, 20 *Fed. Rep'r.* 912.

Interest on amounts received by infringer, and how affected by filing of a disclaimer under Rev. Stat. § 4922, considered. *Burdett v. Estey*, 5 *Bann. & A. Pat. Cas.* 308.

Interest may be allowed on damages for infringement. *May v. Fond du Lac County*, 27 *Fed. Rep'r.* 691.

243. Allowance for Counsel Fees, and other Expenses.

Counsel fees are not a proper element for the consideration of the jury in the estimation of damages, in an action for an infringement. *Teese v. Huntington*, 23 *How.* 2 ; *Phillip v. Nock*, 17 *Wall.* 460. And see *Whittemore v. Cutter*, 1 *Gall.* 429 ; *Pierson*

v. Eagle Screw Co., 3 *Story*, 402; *Stimpson v. Railroads*, 1 *Wall. Jr.* 164; *Parker v. Hulme*, 1 *Fish. Pat. Cas.* 44; 7 *West. L. J.* 429; *Simpson v. Leiper*, 2 *Whart. Dig.* 414; *Blanchard Gun-Stock Turning Factory v. Warner*, 1 *Blatchf.* 258; 272, *note* 1. To the contrary, *Boston Manuf. Co. v. Fiske*, 2 *Mas.* 119; *Parker v. Corbin*, 4 *McLean*, 462; *Allen v. Blunt*, 2 *Woodb. & M.* 121.

In an action for infringement, copies of an assignment of the patent, made by the plaintiff, being proved by the defendant for the purpose of showing that the plaintiff had not retained an interest which authorized him to recover, the charge of the copies is taxable. But a copy of the plaintiff's patent, procured by the defendant, is not taxable, as the plaintiff is bound by law to offer it in evidence. *Hathaway v. Roach*, 2 *Woodb. & M.* 63.

The expense of making or procuring models cannot be included among the taxable costs, nor can models properly be classed as "exemplifications," under the act of February 26. *Parker v. Bigler*, 1 *Fish. Pat. Cas.* 285; 14 *Leg. Intel.* 18.

Models of the invention described in the plaintiff's patent, procured by the defendant in good faith, may be included in the taxation of costs; but not other models. *Woodruff v. Barney*, 1 *Bond*, 528; 2 *Fish. Pat. Cas.* 244. Copies of patents, either that of the plaintiff or others, procured by the defendant, cannot be taxed as costs to the plaintiff. *Ib.*

A patentee is not entitled to reimbursement for counsel fees paid or expenses incurred by him, other than his taxable costs. *Parks v. Booth*, 102 *U. S.* 96; *aff'g* 1 *Flippin*, 381; 1 *Bann. & A. Pat. Cas.* 225.

Profits recoverable in a suit for infringement do not include expenses of suit. *Holbrook v. Small*, 17 *Pat. Off. Gaz.* 55; 2 *Bann. & A. Pat. Cas.* 596.

Counsel fees paid by complainant in a suit in equity for infringement of a patent are not recoverable as damages, under the act of 1870, § 55 (16 *Stat.* 206), any more than they were under the corresponding provisions of the act of 1836, § 14. *Bancroft v. Acton*, 7 *Blatchf.* 505.

XVIII. REMEDY BY INJUNCTION.

244. *Power of United States Courts to Grant Injunctions and Estimate Damages.*

The several courts vested with jurisdiction of cases arising under the patent laws shall have power to grant injunctions according to the course and principles of courts of equity, to prevent the violation of any right secured by patent, on such terms as the court may deem reasonable ; and upon a decree being rendered in any such case for an infringement, the complainant shall be entitled to recover, in addition to the profits to be accounted for by the defendant, the damages the complainant has sustained thereby ; and the court shall assess the same or cause the same to be assessed under its direction. And the court shall have the same power to increase such damages, in its discretion, as is given to increase the damages found by verdicts in actions in the nature of actions of trespass upon the case. *Rev. Stat. § 4921.*

245. *General Nature of the Jurisdiction to Enjoin.*

Section 7 of the act of 1836 has removed the objection to the jurisdiction in equity over infringement, that the patentee might have a remedy at law, and has conferred a jurisdiction of cases arising under the patent laws, which is exclusive. *Goodyear v. Hullihen*, 3 *Fish. Pat. Cas.* 251 ; *Smith v. Plymouth*, 4 *West. L. J.* 49. See *McMillin v. St. Louis & Mississippi Valley Transp. Co.*, 18 *Fed. Rep'r*, 260.

Although the machine may be constructed or used beyond the jurisdiction of the court, yet if the court have jurisdiction of the defendant, he may be restrained from using the machine and selling

the product. *Boyd v. McAlpine*, 3 *McLean*, 427 ; *Wilson v. Sherman*, 1 *Blatchf.* 536.

The jurisdiction of the circuit courts sitting in equity over controversies under the patent laws is not merely a jurisdiction ancillary to courts of law, but a substantive jurisdiction conferred by direct grant from Congress. *Blank v. Manufacturing Co.*, 3 *Wall. Jr.* 196 ; *Saunders v. Logan*, 2 *Pittsb.* 241 ; *Jenkins v. Greenwald*, 1 *Bond*, 126 ; 2 *Fish. Pat. Cas.* 37.

History of equity jurisdiction and of the statutes conferring it on the circuit courts, in patent cases, explained ; with special reference to the question whether an injunction suit begun after expiration of a patent can be maintained, even for the purpose of compelling an accounting. *Root v. Railway Co.*, 105 *U. S.* 189. See also *post*, note 249.

An accounting may be decreed, in a proper case, notwithstanding no right to a discovery or an injunction or other distinct head of equitable relief is shown ; as, where the patent expired pending the suit, leaving nothing in litigation but the right to an account. *Blank v. Manufacturing Co.*, 3 *Wall. Jr.* 196. To same effect, *Gottfried v. Moerlein*, 14 *Fed. Rep'r.*, 170 ; *Burdell v. Comstock*, 15 *Fed. Rep'r.*, 395.

A single infringement will not warrant a suit for an injunction ; there being no threat to continue infringing ; the remedy is by suit for damages. *Smith v. Sands*, 20 *Rep'r.*, 326.

Where the injury done to a patentee by infringement is not in the use of his invention, but in making use of it without compensating the patentee therefor, it being the interest of the patentee that his invention should be used and adopted by all, the proper remedy is not an injunction but an award of damages, viz : the price or value of a license to use it. *Sanders v. Logan*, 2 *Fish. Pat. Cas.* 167 ; 9 *Am. L. Reg.* 475 ; 2 *Pittsb.* 241.

On an injunction bill filed by a patentee, where there is no dispute as to title, a circuit court has power to refer the case to a master to take and state an account of the profits made by the defendant instead of sending it to a court of law to assess the damages. *Allen v. Blunt*, 1 *Blatchf.* 480.

As the circuit courts have jurisdiction of patent cases conferred upon them by statute, and are not confined to such jurisdiction as is ancillary to that of courts of law, the rule of the English cases that if an injunction is refused a decree for an account cannot be made, but that the plaintiff must sue at law, does not apply in this

country. *Sickles v. Gloucester Manuf. Co.*, 1 *Fish. Pat. Cas.* 222. S. P., *Sanders v. Logan*, 9 *Am. L. Reg.* 475 ; 2 *Fish. Pat. Cas.* 167 ; 2 *Pittsb.* 241.

A circuit court has power to enjoin infringement of a patent, independently of making award of any other relief thereon. *American Cotton Tie Supply Co. v. McCready*, 17 *Blatchf.* 291 ; 17 *Pat. Off. Gaz.* 565 ; 4 *Bann. & A. Pat. Cas.* 588.

If the validity of the patent has been established, or is admitted, a bill will lie for an injunction, upon well-grounded proof of an apprehended intention of the defendant to violate the patent right. Such bill is substantially a bill *quia timet*, which is an ordinary remedial process in equity. *Woodworth v. Stone*, 3 *Story*, 749.

The circuit court has jurisdiction of a suit demanding a discovery of the extent of an infringement of a patent and an account of the profits realized therefrom (as being a case arising under the patent laws), as well as of one where an injunction is asked. *Nevins v. Johnson*, 3 *Blatchf.* 80.

An injunction will issue to restrain the use of a machine differing from a patented machine only by slight and unimportant alterations which the description of the invention would naturally, if not necessarily, suggest, without the aid of much ingenuity or skill. *Gibson v. Harris*, 1 *Blatchf.* 167.

Under peculiar circumstances, where the defendant commenced his manufacture without notice of plaintiff's patent, and plaintiff had no knowledge of the infringement for a considerable time, so that there had been no fault on either side,—it was *held*, that the court should grant an injunction as to the future, and an accounting from the date of defendant's first notice of plaintiff's rights. *Merriam v. Smith*, 11 *Fed. Rep'r*, 588.

An injunction ought not to issue where the special circumstances render granting one inequitable between the parties ; as where the defendant was engaged in fulfilling a contract for the manufacture of articles containing the invention, which contract had been entered into on the understanding, on the part of the defendant, that the question between him and the plaintiff was one of compensation, and defendant was willing to make compensation. *Smith v. Sharp's Rifle Manuf. Co.*, 3 *Blatchf.* 545.

Where the court is itself satisfied that the defendants are infringing the plaintiff's rights, although the majority of experts called as witnesses are of the opinion that there is no infringement, it is its duty to grant an injunction to restrain such infringement.

Wilson v. Barnum, 1 *Wall. Jr.* 347 ; 6 *West. L. J.* 464 ; 2 *Fish. Pat. Cas.* 635.

Where the defendant, sued for an infringement, admitted the infringement but pleaded his lunacy at the time, ascertained by a commission, as a defense, it was *held*, that a perpetual injunction, accounting, and costs should be awarded the plaintiff, and that expenses incurred by the defendant by reason of his lunacy should not be deducted. *Avery v. Wilson*, 20 *Fed. Rep'r*, 856.

Injunction, in case of infringement, issues on the principle of a clear and certain right to the enjoyment of the subject in question, and an injurious interruption of that right, which on just and equitable grounds ought to be prevented. Property in a patent is as much under the protection of the law as property in land. *Cook v. Ernest*, 2 *Pat. Off. Gaz.* 89 ; 5 *Fish. Pat. Cas.* 396.

Where, on a final hearing of a bill to restrain an infringement, the court finds that the patent is valid, that the defendant is chargeable with infringing, and that the complainant is entitled to a permanent injunction, and refers the case to a master to ascertain damages, the injunction should be allowed at once ; and not suspended until the master's report comes in, unless some special reasons for that course are shown. *Potter v. Mack*, 3 *Fish. Pat. Cas.* 428. To same effect, *Parker v. Halfield*, 4 *McLean*, 61.

A court of equity should not sustain a suit to enjoin infringement, where the nature of the invention is such that there can be no profits, in a proper sense of the term, of which an account can be decreed ; but the limit of the injury for the use of the invention must necessarily be the value of the license fee ; for here the patentee has a full, speedy, complete and adequate remedy at law. *Vaughan v. Central Pacific R. R. Co.*, 4 *Sawyer*, 280.

246. *Various Relief obtainable in Equity.*

Where, upon trial, the plaintiff abandons one claim of his patent and the defendant does not dispute his liability upon the other, a decree should issue against defendant. *New York Coffee Polishing Co. v. Wilson*, 2 *Fed. Rep'r*, 904.

After a decree against an infringer he cannot be restrained from paying the proceeds of the decree by the suit of a third party, seeking to recover them, where the party claims title to the patent

adversely to the plaintiff in the original suit. *Secombe v. Campbell*, 5 *Fed. Rep'r*, 804 ; 10 *Rep'r*, 686 ; 5 *Bann. & A. Pat. Cas.* 632.

A bill in equity cannot be maintained in behalf of an individual patentee to procure an adjudication that his patent does not interfere with a patent previously granted to another person for an invention apparently similar. Such a bill would be in effect a suit to limit the operation of the earlier patent. A suit of this description can be brought only by the attorney-general in the name of the United States. *Celluloid Manuf. Co. v. Goodyear Dental Vulcanite Co.*, 10 *Pat. Off. Gaz.* 41 ; 13 *Blatchf.* 375 ; 2 *Bann. & A. Pat. Cas.* 334. The jurisdiction granted by the patent laws to the courts to entertain suits in equity brought in behalf of patentees can be exercised only in protecting the right of a patentee to exclude other persons from manufacturing or selling the thing covered by his patent. Presumably every patentee has the right to maintain such a suit against any infringer of his patent. *Ib.*

Where the plaintiffs in a bill for infringements have obtained a decree for an account, and have commenced suits in the courts of other districts for like infringements, the court may, on motion, stay the accounting in the original suit, as to any matters which the plaintiffs have precluded themselves from recovering in it by equitable proceedings. But the court will not, on mere motion, enjoin the plaintiffs from prosecuting suits which they have commenced before other courts, for the recovery of damages such as they are endeavoring to obtain in the suit pending before it, especially after the plaintiffs have been allowed to proceed so far in the foreign suits as to commence taking accounts. *Rumford Chemical Works v. Hecker*, 5 *Pat. Off. Gaz.* 644 ; 5 *Fish. Pat. Cas.* 629.

Where an injunction was obtained, in a suit for license fees, upon condition that the disputed fees should be deposited in court, it was *held*, upon an application by each party to have the fund paid over to him, that though the money belonged to complainant, yet the protection he had received from the court gave the defendant an equitable lien upon the same, and hence, it would be retained until the final determination of the controversy. *Florence Sewing Machine Co. v. Singer Manuf. Co.*, 4 *Fish. Pat. Cas.* 348.

Where a bill discloses an agreement by which the defendants were to report monthly the number of machines made under their license to manufacture and sell, and a covenant not to make machines, except of a certain description, and not to dispute the validity of the patents mentioned in the license ; and that the

defendants had violated all their agreements in these particulars, clear case is established for the interposition of a court of equity. The covenant to make monthly reports is, in fact, a covenant for a monthly discovery by defendants of the work done by them under the complainant's patents. Where the licenses do not give an unlimited use of any of the patents, but only a restricted right to make machines of certain sizes and descriptions, if the licensees make machines not in conformity to these licenses, they violate, not only their express covenant not to do so, but also the licensor's patents, or some of them, covering such machines. *Pope Manuf. Co. v. Owsley*, 27 *Fed. Rep'r*, 100.

Equity cannot entertain a bill for an accounting of royalties under a license, upon allegations that the patentee does not know the number of machines which defendant has sold under the license and therefore cannot collect the royalties at law. *Crandall v. Piano Manuf. Co.*, 20 *Rep'r*, 237.

To show that a decree has been recovered against a manufacturer, for infringing, does not constitute a defense in favor of one who purchased from him, although such decree included defendant's machine. Satisfaction of the decree must be shown. *Fisher v. Consolidated Amador Mine Co.*, 20 *Rep'r*, 452.

247. *Suit to Annul a Patent on the Ground of Interference.*

Jurisdiction of United States courts in equity to adjudge a patent void because of interfering with an earlier one does not rest wholly on their general equity jurisdiction, but is supported by *Rev. Stat.* § 4918. See *ante*, p. 213. Such a suit is not, however, treated as a mere statutory remedy, it is an adversary suit, to be commenced by service of process; though no specific provision of law is made whereby a person who is not an inhabitant of and cannot be served within the district in which such suit has been brought, can be brought in as defendant. *Liggett, &c. Tobacco Co. v. Miller*, 1 *Fed. Rep'r*, 203; 1 *McCrary*, 31; 17 *Pat. Off. Gaz.* 798; 5 *Bann. & A. Pat. Cas.* 237.

A preliminary injunction may be issued in an interference suit; it is authorized by the general principles of equity, though not

expressly mentioned in section 4918. *Potter v. Dixon*, 5 *Blatchf.* 160.

The suit thus authorized raises only the question of relative priority of the competing inventions (*Lockwood v. Cleaveland*, 20 *Fed. Rep'r*, 164); if the defendant concedes that plaintiff's patent is first in date, he cannot prevail by attacking that patent for want of novelty (*Pentlarge v. Pentlarge*, 19 *Fed. Rep'r*, 817); either by plea or answer (*Pentlarge v. Pentlarge*, 22 *Blatchf.* 10); still less may he deny that either party was the first inventor; see *Greenwood v. Bracher*, 5 *Bann. & A. Pat. Cas.* 302; 1 *Fed. Rep'r*, 856; 17 *Pat. Off. Gaz.* 1151.

A decree dismissing a bill seeking relief under section 4918 is not conclusive in a subsequent suit; the decree must be such as asserts the interference of the patents and declares one of them void. *Tyler v. Hyde*, 2 *Blatchf.* 310.

A cross bill is not required in these suits in order to enable defendant to have the affirmative relief of a decree annulling the complainant's patent. *Lockwood v. Cleaveland*, 6 *Fed. Rep'r*, 721.

After a decision by the commissioner of patents in an interference proceeding awarding letters patent to an inventor whose application was filed subsequently to that of another applicant, who had obtained letters patent covering the invention in controversy, priority of invention constitutes the material issue between the parties, when the defeated party files his bill in equity to have the patent of his adversary declared void. *Sawyer v. Massey*, 25 *Fed. Rep'r*, 144.

The substantial question on an interference is as to the identity of the two inventions, in principle. *Tyson v. Rankin*, 1 *MacArthur Pat. Cas.* 262.

The court has authority to adjudge either of the interfering patents void in whole or in part, or may, upon proper issues and proof, decree that both patents are void. *Foster v. Lindsay*, 3 *Dill.* 126; 2 *Bann. & A. Pat. Cas.* 172. But see 19 *Fed. Rep'r*, 817; 22 *Blatchf.* 11; 20 *Fed. Rep'r*, 164; 6 *Id.* 721; *contra*.

Where two patents have been issued, each claiming, broadly, the same invention, and the earlier patentee is adjudged to be the first inventor, the claim in the second patent must be restricted to the particular devices specially described. *Richardson v. Noyes*, 10 *Pat. Off. Gaz.* 507; 2 *Bann. & A. Pat. Cas.* 398. General evidence that the patentee in the junior patent applied for it with such

knowledge of the invention as would debar him from obtaining a patent, may be received as warranting the court in declaring the junior patent null. *Hutchinson v. Everett*, 26 *Fed. Rep'r*, 531.

248. *Necessity of Establishing Plaintiff's Title by Action at Law, before Resorting to Equity.*

A circuit court may entertain a bill to restrain infringements of a patent, without waiting until a trial at law establishing the validity of the patent, has been had. *Cochrane v. Deener*, 94 *U. S.* 780 ; *Goodyear v. Gloucester Manuf. Co.*, 3 *Wall. Jr.* 196 ; *Sickels v. Mitchell*, 3 *Blatchf.* 548 ; *Goodyear v. Day*, 2 *Wall. Jr.* 283 ; *Sanders v. Logan*, 2 *Pittsb.* 241 ; 2 *Fish. Pat. Cas.* 167 ; 9 *Am. L. Reg.* 475 ; *McMillin v. Barclay*, 4 *Brews.* 275 ; 3 *Pittsb.* 377 ; 5 *Fish. Pat. Cas.* 189.

The courts of the United States are authorized to take up a patent, and, upon final hearing, to pass upon it, without reference to the fact whether it has been before a jury or not. *Doughty v. West*, 2 *Fish. Pat. Cas.* 553.

The supreme court of the District of Columbia has the same power in this respect as the circuit courts. *Cochrane v. Deener*, 94 *U. S.* 780.

The former rule that the circuit courts would interfere in aid of a patentee only where his patent had been established by long acquiescence, or by a trial at law, is now relaxed. The current of decisions of the last few years has been that the grant of jurisdiction is as full in equity as it is at law. *Sanders v. Logan*, 2 *Fish. Pat. Cas.* 167 ; *Hoffheins v. Brandt*, 3 *Fish. Pat. Cas.* 218 ; *Shelly v. Brannan*, 4 *Id.* 198. See *Buchanan v. Howland*, 2 *Fish. Pat. Cas.* 341.

It appeared on the final hearing on pleadings and proofs, of a suit in equity for an injunction and an account, that the bill was filed within three months after the issuing of the patent, that the defendant denied the infringement and the novelty of the invention, and that there had been no trial at law. It did not appear that there had been any exclusive possession under the patent, or any public acquiescence in the exclusive right of the patentee. Objections were made to the sufficiency of the specification, and the evidence on the question of infringement was indefinite and unsatisfactory. The court, under the circumstances, ordered the

cause to stand over a sufficient time for the bringing of a suit at law against the defendant for an infringement. *Muscan Hair Manuf. Co. v. American Hair Manuf. Co.*, 4 *Blatchf.* 174 ; 1 *Fish. Pat. Cas.* 320.

Even after the validity of a patent has been established in a suit, it may be shown in another suit on the patent against another defendant, or on a motion for a preliminary injunction, that the right claimed by the plaintiff in the new suit was not, either as to its nature or its extent, fairly in controversy in the former suit, or that there are relevant matters not considered in the former suit. *Page v. Holmes Burglar Alarm Tel. Co.*, 2 *Fed. Rep'r*, 330 ; 18 *Blatchf.* 118 ; 9 *Rep'r*, 775 ; 5 *Bann. & A. Pat. Cas.* 439.

For some decisions recognizing the former rule requiring an adjudication of the right, at law, before equity would act on a bill for an injunction, most of which cases, however, were rendered many years ago, see *Orr v. Merrill*, 1 *Woodb. & M.* 376 ; *Day v. Hartshorn*, 3 *Fish. Pat. Cas.* 32 ; *Thomas v. Weeks*, 2 *Paine*, 92 ; *Pentlarge v. Pentlarge*, 14 *Rep'r*, 579 ; 22 *Blatchf.* 10.

219. Or of showing long Possession and Public Acquiescence.

For many years before the jurisdiction of the circuit courts to entertain a bill for an injunction without awaiting a trial at law was established as firmly as it now is by the cases cited in the preceding note, there was a large body of decisions holding if there had been an exclusive possession of some duration, and without serious dispute, of the rights of a patentee, under a patent, such claim and public acquiescence would warrant a court of equity in granting an injunction without requiring the holder of the patent to first establish his right at law. *Washburn v. Gould*, 3 *Story*, 122 ; 1 *West. L. J.* 465 ; 7 *L. Rep'r*, 276 ; *Orr v. Littlefield*, 1 *Woodb. & M.* 13 ; 8 *L. Rep'r*, 314 ; *Sullivan v. Redfield*, 1 *Paine*, 441 ; *Ogle v. Ege*, 4 *Wash.* 584 ; *Foster v. Moore*, 1 *Curt.* 279 ; *Sargent v. Seagrave*, 2 *Curt.* 553 ; *Miller v. Androscoggin Pulp Co.*, 5 *Fish. Pat. Cas.* 340.

Injunctions in patent right cases are granted without a previous trial at law, in cases where the owner of a patent shows a clear case of infringement and has been in the possession and enjoyment of the exclusive right for a term of years without any successful

impeachment of its validity. Such possession and enjoyment, aided by the presumptions arising from the patent itself, are sufficient to warrant an injunction to restrain infringement. There is no fixed rule as to the length of time the possession and enjoyment of the right under the patent shall have continued. It must be sufficient to justify a presumption in favor of the validity of the patent. *Potter v. Muller*, 2 *Fish. Pat. Cas.* 465.

It is not possible to fix any term of years during which the exclusive possession must have continued in order to entitle the proprietor to a provisional injunction. Each case must depend upon its own circumstances,—*e. g.*, the extent of the use or sales by the patentee, the degree of the utility of the invention, and the number of persons whose business is affected by it, and who are interested to question the exclusive right, and the completeness of the acquiescence under it. *Foster v. Moore*, 1 *Curt.* 279 ; *Sargent v. Seagrave*, 2 *Curt.* 553.

The acquiescence of the public in the use by the patentee of his invention before applying for a patent is entitled to more or less weight, according to the degree of the utility of the machine, and the number of persons whose trade or business is affected by it. An exclusive possession of about eight years, under a patent for a useful machine which affected the trade and business of large numbers of persons ; many of such machines having been constructed and put in operation in different States, was *held* sufficient. *Foster v. Moore*, *supra*.

The sale of an invention, and its use by the inventor and his vendors, is sufficient evidence of an exclusive possession by claim and color of title, to entitle him to be protected in the continued enjoyment, whatever doubts may exist as to the validity of the patent. *Cooper v. Matthews*, 8 *L. Rep'r*, 413, 419.

Long possession and use under one patent and recoveries upon it will not inure in favor of another patent, as to which an injunction is asked, even though the two patents are very useful and necessary for each other, unless there is some connection in law between them, or one is auxiliary to or part of the other. *Hovey v. Stevens*, 1 *Woodb. & M.* 290.

To entitle a patentee to the extraordinary writ of injunction, it is not sufficient for him merely to show his patent and infringement of it. His right must be further substantiated, either by a possession accompanied by an actual use and enjoyment of the right for a sufficient length of time to afford a reasonable presumption of the

acquiescence of the public in its validity, or, by a judgment in his favor in a trial at law. *Brown v. Hinkley*, 3 *Pat. Off. Gaz.* 384 ; 6 *Fish. Pat. Cas.* 370.

On an application for an injunction against the infringement of a patent, the bill should show, either that the validity of the patent has been established in an action at law, or that the right of the complainant under the patent has been recognized and acquiesced in by long unquestioned use and enjoyment, or other equivalent acts. *Gutta-percha Co. v. Goodyear Co.*, 3 *Sawyer*, 542 ; 2 *Bann. & A. Pat. Cas.* 212.

A court of equity will not grant an injunction to restrain a party using, and in possession of, an invention, where he has been so for a long time, and under color of right. *Hall v. Speer*, 1 *Pittsb.* 513.

200. *Effect of Expiration of Patent on the Jurisdiction of Equity.*

A circuit court has not jurisdiction, upon a bill filed after the expiration of a patent, to ascertain a past infringement, and decree an accounting of profits, unless the bill shows citizenship of parties in different States, or the existence of some special ground of equitable jurisdiction, or that complainant has not an adequate remedy at law. The fiction that the infringer holds the profits he has realized, as a trustee for the patentee, will not support the suit. *Root v. Railway Co.*, 105 *U. S.* 189 ;* *Lord v. Whitehead, &c. Machine Co.*, 24 *Fed. Rep'r*, 801 ; 3 *Pat. Off. Gaz.* 498 ; *Vaughan v. Cen-*

* Before the decision of the Supreme Court in *Root v. Railway Co.*, 105 *U. S.* 189, there appears to have been some conflict of opinion in the circuit courts, as to whether a suit for a discovery and account of profits could be maintained, after the expiration of the patent had terminated the right to an injunction. The preponderance of authority, however, was that the jurisdiction of equity continued. *Howes v. Nute*, 4 *Fish. Pat. Cas.* 263 ; 4 *Cliff.* 173 ; *McComb v. Beard*, 10

Blatch. 350, 361 ; *Smith v. Baker*, 5 *Pat. Off. Gaz.* 496 ; *Nevins v. Johnson*, 3 *Blatch.* 80 ; *Gordon v. Anthony*, 16 *Pat. Off. Gaz.* 1135 ; *Atwood v. Portland Co.*, 10 *Fed. Rep'r*, 283 ; 5 *Bann. & A. Pat. Cas.* 533 ; *Stevens v. Kansas Pacific Ry. Co.*, 5 *Dill.* 486. *S. P.*, *Sayles v. Dubuque & Sioux City R. R. Co.*, *Id.* 561.

But see *Draper v. Hudson*, 1 *Holmes*, 208 ; *Sayles v. Richmond & Fredericksburgh R. R. Co.*, 4 *Bann. & A. Pat. Cas.* 239 ; 7 *Rep'r*, 743.

tral Pacific R. R. Co., 4 *Swoyer*, 280; *Burdell v. Comstock*, 15 *Fed. Rep'r*, 395; *Davis v. Smith*, 19 *Fed. Rep'r*, 823.

Where the assignee of damages for an infringement has an adequate remedy at law for an infringement of the patent which expired before the assignment was made, a demurrer to a bill will be sustained; without prejudice to a suit at law for damages. *Hayward v. Andrews*, 12 *Fed. Rep'r*, 786; *aff'd*, 106 *U. S.* 672.

Equity will not refuse to entertain a bill for an injunction and account, merely because the patent is about to expire, unless the time it has to run is so short as to show that the bill was a mere device to oust the common law jurisdiction. *Dick v. Struthers*, 25 *Rep'r*, 103.

Where a bill in equity, alleging infringement of a patent and praying for an injunction and an account was filed only five days before the expiration of the patent and no effort was made to obtain an injunction, it was *held* that the court never acquired jurisdiction. *Burdell v. Comstock*, 15 *Fed. Rep'r*, 395.

The intricacy of the accounting claimed is not ground for jurisdiction of equity over infringements of a patent expired. *Lord v. Whitehead & Atherton Machine Co.*, 24 *Fed. Rep'r*, 801.

Bills were filed about a month before an extended term of a patent expired, one of them seeking to recover for infringements during the original term, the other for those during the extended term. It was *held*, that the court had no jurisdiction of the bill relating to the original term; but, that as there were grounds of equitable relief for the bill for the extended term, at the time when it was filed, and there was nothing to show that the suit was a mere desire to transfer the jurisdiction of law to equity, by commencing suit at this late day, the court did not lose jurisdiction by expiration of the patent. *Adams v. Bridgewater Iron Co.*, 26 *Fed. Rep'r*, 324; 34 *Pat. Off. Gaz.* 1045. S. P., *Gottfried v. Moerlein*, 14 *Fed. Rep'r*, 170.

An injunction against an infringing machine, made during the life of the patent, will continue in force after the expiration of the patent. But an injunction will not issue against the use of a patented device, after the expiration of the term of the patent, upon a bill which does not allege that defendant is using machines made during the term of the patent and infringing it, or that the complainant fears such use. *American Diamond Rock Boring Co. v. Rutland Marble Co.*, 2 *Fed. Rep'r*, 355; 1 *Blatchf.* 146; 5 *Bann. & A. Pat. Cas.* 346.

Although a patent has expired, and the device covered by it can be used only in connection with other devices embraced in a patent still in life, the latter cannot be used without the consent of the patentee, though in connection with the first. *Wheeler v. McCormick*, 4 *Pat. Off. Gaz.* 692 ; 11 *Blatchf.* 334 ; 6 *Fish. Pat. Cas.* 551.

There is a broad distinction between the use of an invention and the use of a patented machine. While the right to use the invention expires with the end of the term of the original patent, the right to the continued use of the machine, which embodies it, is protected. *Wetherill v. Passaic Zinc Co.*, 6 *Fish. Pat. Cas.* 50 ; 16 *Int. Rev. Rec.* 156 ; 2 *Pat. Off. Gaz.* 471 ; 9 *Phila.* 385.

Courts of equity are authorized to grant an injunction after the expiration of a patent, to prevent the sale of articles manufactured during its life. *New York Belting & Packing Co. v. Magowan*, 27 *Fed. Rep'r*, 111 ; 34 *Pat. Off. Gaz.* 1278.

A bill in equity filed more than a year after the expiration of a patent cannot be sustained, merely because it seeks relief by way of injunction, against the use or sale by the defendants of articles embodying the patented invention, should any be found in their possession, and also against the use of the tools and paraphernalia of infringement made during the life of the patent, for the purpose of infringement. *Consolidated Safety Valve Co. v. Ashton Valve Co.*, 26 *Med. Rep'r*, 319.

In a suit in equity for infringement of a patent, a preliminary injunction against the defendants was denied, but they were required to give bond and make a monthly statement, under oath, of their sale. Before a final decision on the merits, the patent expired. It was *held*, that under the circumstances, a decree in favor of the complainants should include an injunction against the defendants using or selling the infringing articles manufactured by them during the life of the patent. *New York Belting & Packing Co. v. Magowan*, 27 *Fed. Rep'r*, 111 ; 34 *Pat. Off. Gaz.* 1278.

251. *Effect of Expiration in Particular Instances.*

A., to whom letters-patent had been assigned, filed, after their expiration, which took place July 6, 1873, his bill against B., charging that the latter had during their term infringed them by using the patented invention, whereby he realized gains, profits and

savings, which he should be compelled to account for and pay to the complainant. The bill was, on demurrer, dismissed. It was *held*, that the decree below was proper, the bill being merely for an account of profits and damages against an infringer, and it not appearing from the case thereby made that any ground of equitable jurisdiction existed, or that A. had not a complete remedy at law whereby damages for the wrongs complained of could be recovered. History and limits of the jurisdiction explained. *Root v. Railway Co.*, 105 *U. S.* 189.

A bill was sustained, under the circumstances of the case, notwithstanding the patent had expired, on the ground that it was not necessarily to be treated as a bill for infringement, but might be deemed founded on an agreement proved between the parties, and which amounted to an executed license ; and that, viewed in this aspect, the bill was not open to the objection that there was a complete and adequate remedy at law, because an account and a discovery were necessary to ascertain the facts from which the damages to the plaintiffs could be computed, and the bill was a bill for an account and a discovery. *Magic Ruffle Co. v. Elm City Co.*, 13 *Blatchf.* 151 ; 8 *Pat. Off. Gaz.* 773.

After a bill in equity had been filed for the infringement, the patent was surrendered, and a reissued patent was granted. The plaintiff then moved for leave to file a supplemental bill founded on the reissued patent and for an injunction. It was *held*, that the motions must be denied, on the ground that, by the surrender and reissue, the suit was at an end, and that the plaintiff must proceed by original bill founded on the reissued patent. *Fry v. Quinlan*, 13 *Blatchf.* 205. To same effect, *Jones v. Barker*, 11 *Fed. Rep'r*, 597 ; 22 *Pat. Off. Gaz.* 771.

Filley invented and patented a new stove, known as the "Charter Oak ;" but for a long time allowed Jacobus to make and sell it, and to use that name. It was *held*, that he could not, after the patent expired, have an injunction to forbid Jacobus from continuing the sale under the name "Charter Oak," so long as the latter did not represent the stoves he sold as having been made by Filley. *Filley v. Child*, 16 *Pat. Off. Gaz.* 261 ; 16 *Blatchf.* 376 ; 4 *Bann. & A. Pat. Cas.* 353.

A manufacturer of scales cannot claim protection, after expiration of his patent for scales, against another person's making scales in imitation of the form, color, &c., of those manufactured by plaintiff. Neither a patent or a trade-mark relates to the accidental

exterior appearance of such an article. The patent (while it lasted) protected only the novel, substantial mechanism ; and the trademark only forbids representing defendant's article as being of the manufacture of plaintiff. *Fairbanks v. Jacobus*, 14 *Blatchf.* 337.

The use of machines made in the life-time of a patent and infringements thereof when made,—enjoined after it had expired. *Reay v. Raynor*, 19 *Fed. Rep'r*, 308; 22 *Blatchf.* 13 ; 26 *Pat. Off. Gaz.* 1111.

A bill in equity for infringement of a patent, asking an account of profits and damages, and an injunction, provisional and perpetual, was filed only four days before the expiration of the patent. It was *held*, that as notice of eight days of a motion for an injunction was required by the rules of the court, and no injunction could therefore be obtained, and the sole object of the bill appeared to be pecuniary compensation in the form of profits or damages, a demurrer should be sustained. *Mershon v. J. F. Pease Furnace Co.*, 24 *Fed. Rep'r*, 741 ; 32 *Pat. Off. Gaz.* 1011.

But where a bill, although filed only twenty-six days before the expiration of the patent, set forth that the plaintiff, having retained the exclusive right to make and sell the patented article, was exercising it, and was able to supply the market, and that defendants were making machines containing the invention, and threatened to make them in large quantities, and intended to put on the market, after the expiration of the patent, infringing machines made before it expired, and prayed an injunction restraining the sale, after as well as before the expiration of the patent, of machines unlawfully made before it expired ; it was *held*, that a demurrer to the bill should be overruled. *Toledo Mower, &c. Co. v. Johnston Harvester Co.*, 24 *Fed. Rep'r*, 739 ; 32 *Pat. Off. Gaz.* 1010.

A bill in equity for infringement of a patent was filed May 5th, 1885, and process was served on the defendants two days afterward, but no steps were taken to secure a preliminary injunction. The patent expired June 16th, 1885. It was *held*, that a demurrer to the bill should not be sustained because of the expiration of the patent, the case being cognizable in equity at the time the bill was filed. *Dick v. Struthers*, 25 *Fed. Rep'r*, 103 ; 34 *Pat. Off. Gaz.* 131.

Three patents were used in one process, and therefore must be considered in connection in estimating profits. One of them had only three months to run, when the bill was filed. This was *held*

no ground for dismissing the bill. *New York Grape Sugar Co. v. Peoria Grape Sugar Co.*, 21 *Fed. Rep'r*, 878 ; 32 *Pat. Off. Gaz.* 138.

In a suit in equity for infringement of a patent, in which an injunction and accounting were sought, several changes of parties were made by amendment of the bill, by one of which the heirs at law of one of the patentees were made parties. Pending the suit, the patent expired, and not until afterwards was the administrator of the deceased patentee made a party, by a further amendment of the bill. It was *held* that the suit must be regarded as commenced when such administrator was brought in, and, the patent having then expired, a court of equity had no jurisdiction. *Hewitt v. Pennsylvania Steel Co.* 24 *Fed. Rep'r*, 367 ; 31 *Pat. Off. Gaz.* 1687.

252. *Effect of Abandonment, Acquiescence, or Delay, on the Jurisdiction.*

Equity will not interfere in behalf of patentee, either to grant an injunction, or give him any other relief in respect to an alleged violation of his patent, if, after having obtained his patent, he has dedicated it to the public, or acquiesced for a long period in the public use thereof, without objection ; in such a case his own conduct may be considered as having led to the use of the invention complained of. *Wyeth v. Stone*, 1 *Story*, 273 ; 4 *L. Rep'r*, 54.

A court of equity is reluctant, even when satisfied that a patent is valid, to enforce it by enjoining infringements, where the patentee is chargeable with laches in seeking relief. And this principle extends to assignees of the patent under an extension. *Goodyear v. Honsinger*, 3 *Fish. Pat. Cas.* 147 ; 2 *Biss.* 1.

Mere delay in bringing suit for infringement is not sufficient to establish an abandonment or dedication. There must be an acquiescence in the appropriation of the right, of such character as reasonably to induce the belief that the owner intended to relinquish it to the public. *Williams v. Boston & Albany R. R. Co.*, 16 *Pat. Off. Gaz.* 906 ; 17 *Blatchf.* 21 ; 4 *Bunn. & A. Pat. Cas.* 441

Thus, if a patentee has neglected to file a disclaimer, in a case where he ought to do so, until after suit is brought, a court of equity will not interfere to grant a perpetual injunction, whatever

may be his right and remedy at law. *Wyeth v. Stone*, 1 *Story*, 273 ; 4 *L. Rep'r*, 54.

Where there were satisfactory reasons for the delay, it will be excused. Thus, where the validity of a patent was in litigation, it was *held* not laches on the part of the patentee to wait until a decision was rendered, before bringing suit against infringers. *Green v. Barney*, 19 *Fed. Rep'r*, 420. And a patentee will not be deemed to have acquiesced in the use of his invention so as to deprive him of the right to an injunction, because he first proceeded against only the more palpable and obvious violations of his patent, or because he has not brought suit against all persons infringing upon it. *Van Hook v. Pendleton*, 1 *Blatchf.* 187.

253. *Effect of Delay, &c. in Particular Instances.*

Twenty days before the expiration of a patent for a "self-raising" flour, motions for injunctions in over fifty suits, to restrain the infringement of the patent, were made. All of the suits but one were against grocers who were selling the flour. One was against a manufacturer. The patent had been sustained on final hearing in other suits, but had been much litigated, and until recently. Since then, there had been no unnecessary delay. It was *held*, that no laches could be imputed to the plaintiff. An apprehension that the grocers may fear to sell non-infringing flours, and thus cause injury to the manufacturers of such flours, was no ground for withholding injunctions against the grocers. *Rumford Chemical Works v. Vice*, 14 *Blatchf.* 179 ; 2 *Bann. & A. Pat. Cas.* 584.

Where the patentee gave prompt notice to an infringer to cease infringing, and, within two years thereafter, and before the commencement of legal proceedings, repeated the notice three times, and the business engagements of the patentee were many and pressing, and he gave no affirmative encouragement to the infringer. It was *held*, that the right to a preliminary injunction, in a case otherwise plain, would not be affected by the delay. *Collignon v. Hayes*, 8 *Fed. Rep'r*, 912 ; 20 *Pat. Off. Gaz.* 447.

Where the patentee had knowledge of the infringement for nearly two years before applying for an injunction, and had warned the defendants that they were infringers. It was *held*, that a motion for an injunction should be denied for want of diligence. *Sperry v. Ribbands*, 3 *Bann. & A. Pat. Cas.* 260 ; 1 *N. J. L. J.* 115.

The loss of a patent issued under the act of 1793, and which by that act was required to be recorded, is no excuse for delay in applying for an injunction for its infringement. A copy would be as good evidence of the right as the original, or as a new patent issued under the act of 1837. *Cooper v. Matthews*, 8 *L. Rep'r*, 413.

From a bill in equity for infringement of a patent, it appeared that the patent had been in existence for about 15 years, and that the infringement had continued 13 years; and no excuse for the delay on the part of complainant was shown. It was *held*, that a demurrer should be sustained, on the ground of laches. *McLaughlin v. People's R. Co.*, 21 *Fed. Rep'r*, 574; 29 *Pat. Off. Gaz.* 277.

Delay for more than seven years in proceeding against open infringers of complainants' patent was *held*, ground for refusing a preliminary injunction against the same parties, notwithstanding the owners of the patent had, during that time, been engaged in disputes among themselves, and in establishing their rights against other infringers. *Ladd v. Cameron*, 25 *Fed. Rep'r*, 37.

254. *Proper Persons to be Complainants in a Suit in Equity.*

Only the patentee, or an assignee of the entire and exclusive right for a specific territory can bring suit in equity for infringement. An assignee of a part only of the right, as an assignee of the right to use and sell but not to manufacture cannot sue in his own name. *Hill v. Whitecomb*, 5 *Pat. Off. Gaz.* 430; 1 *Holmes*, 317; 1 *Bann. & A. Pat. Cas.* 34.

In a suit in equity brought on letters patent for a machine, to restrain the defendant from making the patented machines and selling them to parties who buy them for exportation to and use in foreign countries, the owner of the legal title to the patent should be joined as plaintiff with the holder of the exclusive right to make and vend the patented invention for use in foreign countries. *Dorsey, &c. Rake Co. v. Bradley Manuf. Co.*, 12 *Blatchf.* 202.

In a suit for infringement, those who have a title to the patent are necessary parties; if others are joined as parties, it is not necessary to dismiss the bill, but merely strike off their names. *Edgar-ton v. Breck*, 5 *Bann. & A. Pat. Cas.* 42.

A bill to enjoin infringement, which does not join all the owners of the patent, is fatally defective; but this rule requires the joinder of only those persons to whom interests have been transferred by assignments in writing duly authenticated. *Jordan v. Dobson*, 2 *Abb. U. S.* 398; 7 *Phila.* 533.

A motion to dismiss a bill for an injunction, on the ground that complainant has parted with all his interest in the suit, will be denied if it appears that the assignment was made after the computation of profits ended. *Dean v. Mason*, 20 *How.* 198.

A patent granted to the administrator of an inventor is held by him, *prima facie*, in trust for the heirs; and they must be parties to a suit in equity on the patent, so long as they retain such an interest; if, however, the inventor sold his interest prior to his decease, the assignee must be made the party, and not the heirs. *North-western Fire Extinguisher Co. v. Philadelphia Fire Extinguisher Co.*, 6 *Pat. Off. Gaz.* 34; 10 *Phila.* 227; 1 *Bann. & A. Pat. Cas.* 177.

One of a number of joint tenants in a patent cannot enjoin the other from the use or sale of the patent; nor can the equitable owner of a patent be enjoined from using it, upon a bill filed by one holding the legal title only. *Clum v. Brewer*, 2 *Curt.* 506.

Where the legal and the equitable right to a patent are in different persons, both should join as plaintiffs in a suit in equity for an injunction and an account. *Stimpson v. Rogers*, 4 *Blatchf.* 333.

The next of kin of a patentee cannot be united with the personal representatives, as parties plaintiff in a bill to enjoin the infringement of the rights secured by the patent, and for an accounting. *Hodge v. North Missouri R. R. Co.*, 1 *Dill.* 104; 4 *Fish. Pat. Cas.* 161.

A former owner of a patent, who, in the instrument conveying it, reserved to himself the right to use and to license others to use the patented process to a certain specified extent, is not a necessary party to a suit by the person to whom he conveyed, as against third persons, to restrain infringement. *Frankfort Whisky Process Co. v. Pepper*, 26 *Fed. Rep'r*, 336.

If the owner of an equitable right or interest in a patent institute a suit in equity for his own benefit in the name of the owner of the legal title, for an injunction and an account, he will be made a co-plaintiff with the owner of the legal title upon application to the court, even after answer is filed, testimony published, and the

case is placed on the term calendar for final hearing. *Patterson v. Stapler*, 7 *Fed. Rep'r*, 210 ; 27 *Int. Rev. Rec.* 171 ; 11 *Repr.*, 731.

A party alleged to have an interest in a patent sued on may disclaim all interest in favor of complainant, and thus obviate the objection that he should be joined as a party. *Graham v. Geneva Lake Crawford Manuf. Co.*, 11 *Fed. Rep'r*, 138 ; 21 *Pat. Off. Gaz.* 1536.

A bill for an infringement was founded not on the title of the original patentee, but on the derivative title of the complainant first named in the bill, to whom, as executor of the deceased inventor, the patent was reissued. It was *held* that the objection to the right of the complainants to maintain their bill, because only one of the persons named as executors in the last will and testament of the original patentee was made a party to the bill, could not be sustained ; the reissued patent, under the circumstances, was a new contract between the government and the executor, subsequent to the decease of the original patentee. *Goodyear v. Providence Rubber Co.*, 2 *Cliff.* 351 ; 2 *Fish. Pat. Cas.* 499.

A suit for an accounting of profits for infringement of a patent by a corporation cannot be sustained on behalf of parties who, as officers and managers of the corporation, were actively engaged in such infringement, but subsequently sold their stock in the corporation and purchased the patent. *New York Grape Sugar Co. v. Buffalo Grape Sugar Co.*, 24 *Fed. Rep'r*, 604 ; 32 *Pat. Off. Gaz.* 1356.

Who is such assignee as may sue in his own name. See *Littlefield v. Perry*, 21 *Wall.* 205.

The fact that an assignee cannot sue at law in his own name does not entitle him to resort to equity. *Hayward v. Andrews*, 106 *U. S.* 672.

A patentee may maintain an action at law upon a patent, in his own name, although he is under a contract to assign it to others so long as the assignment has not been executed ; but equity regards that as already done which the patentee has agreed to do, and will require that the proposed assignees be made parties to any bill in chancery brought against infringers. If, however, the other parties to such a contract release to the patentee all their interest in the patent, he may maintain a bill in his own name for all subsequent infringements, but not for those committed previous to the release ; neither can he recover damages for any infringements committed after he has sold and assigned the patent.

Wheeler v. McCormick, 4 *Pat. Off. Gaz.* 692 ; 11 *Blatchf.* 334 ; 8 *Fish. Pat. Cas.* 551.

One who is only a licensee cannot sue in equity in his own name, but must join with him the owner of the legal title as plaintiff. *Nelson v. McMann*, 16 *Pat. Off. Gaz.* 761 ; 16 *Blatchf.* 139 ; 4 *Bann. & A. Pat. Cas.* 203.

In an equitable suit brought by a married woman in the circuit court in the district of New York for infringement, the husband need not be joined. *Lorillard v. Standard Oil Co.*, 21 *Alb. L. J.* 492.

The receiver of a corporation appointed under the law of Pennsylvania, being, by the law of that State, the mere custodian of the property of the corporation, cannot maintain in his own name a suit for infringement of a patent owned by the corporation. *Dick v. Struthers*, 25 *Fed. Rep'r*, 103 ; 20 *Rep'r*, 643

255. *Proper Persons to be Made Defendants.*

A patentee should not be joined with his licensee, as defendant in a suit for infringing an earlier patent by manufacturing and selling the licensed machine, if the patentee made defendant has no other connection with the infringement than receiving the royalty. The licensee is the party liable for his sales. *Hussey v. Bradley*, 5 *Blatchf.* 134 ; 2 *Fish. Pat. Cas.* 362.

The use of a patented machine under a license by an assignee of the license may be enjoined, where the assignee refuses to pay the tariff agreed upon as the consideration for such license ; but the assignee cannot be enjoined by reason of a default in paying the tariff happening prior to the assignment ; he is liable only for his own default. *Goodyear v. Congress Rubber Co.*, 3 *Blatchf.* 449.

In a suit for infringement the bill alleged that the defendants had "jointly and collectively, and also separately," used and sold bottle-stoppers containing the patented invention. It was held that although no joint sale or use was shown, yet as the bill was framed to recover for separate infringements and was not demurred to on that ground, and the case went on upon that issue, that the plaintiff could maintain the suit as a suit against each defendant separately. *Putnam v. Hollander*, 6 *Fed. Rep'r*, 882 ; 19 *Blatchf.* 48 ; 19 *Pat. Off. Gaz.* 1423.

The unauthorized use of a patent by the agent of a joint stock

association, in its business, for the benefit of its stockholders, must be considered as a use by each of them, from which each of them may be enjoined ; notwithstanding that under the laws of the State, there being more than seven shareholders, the association might have been sued as a whole by suing the president, without making all the shareholders parties. *Tyler v. Galloway*, 13 *Fed. Rep'r*, 477 ; 22 *Pat. Off. Gaz.* 1294 ; 14 *Rep'r*, 771 ; 21 *Blatchf.* 66.

256. *In what Cases Agents, Contractors, Laborers, Corporate Officers, may be Sued.*

An injunction will not be granted against a person, restraining him from using a patented machine, unless it is shown that he actually used it, or employed others to use it for him, or received profits from its use ; except that, to prevent evasions, a workman on a machine, though not interested in it, is liable to be restrained. *Woodworth v. Hall*, 1 *Woodb. & M.* 248. Later it was *held*, in the same district, that a decree for an account cannot be had against a mere workman, who has been instrumental, while in the employment of another, in the infringement ; he having had nothing to do with the profits. *Sargent v. Larned*, 2 *Curt.* 340. Where a person runs a machine which others own, and which machine is a violation of a patent, an injunction may issue against all for the violation. *Woodworth v. Edwards*, 3 *Woodb. & M.* 120.

When contractors laid, for a city, a pavement which infringed the patent of N. ; and the city paid them as much therefor as it would have had to pay him had he constructed the improvement, it was *held*, in a suit in equity, to recover profits, brought against the city and the contractors, that the latter alone were responsible. The city might have been enjoined before the completion of the work, and perhaps would have been liable in an action for damages ; but it was not chargeable for profits, because it had not realized any ; the profits had inured to the benefit of the contractors. *Elizabeth v. Pavement Co.*, 97 *U. S.* 126.

The directors of a manufacturing corporation, who manage and superintend its business, and under whose direction it manufactures and sells articles which are an infringement of a patent, and its agents, who conduct its business of selling such articles, are responsible for such infringement, and may be joined as defendants in an injunction suit. *Goodyear v. Phelps*, 3 *Blatchf.* 91. So an officer

of a corporation owning a patent, who has personally executed an agreement on behalf of the corporation, a third person to furnish the infringing machines under a tariff as rent, is a proper defendant to a suit to restrain such manufacture, brought on the ground that it is an infringement of a prior patent owned by the complainant. *Nichols v. Pearce*, 7 *Blatchf.* 5. But see a case where officers were *held* not liable for royalty, where they had derived no personal benefit, and had acted in good faith (*Phillips v. Detroit*, 16 *Pat. Off. Gaz.* 627); and a case where corporate officers were *held* liable, because they refused to disclose to the patentee the names of the persons really responsible. *American Cotton Tie Supply Co. v. McCready*, 17 *Blatchf.* 291 ; 17 *Pat. Off. Gaz.* 565 ; 4 *Bann. & A. Pat. Cas.* 588.

The fact that a defendant who has sold an article which infringes on a patent, sold it on behalf of its owner, and had no interest in it or its sale, is no ground for refusing to grant an injunction against him. *Maltby v. Bobo*, 14 *Blatchf.* 53 ; 2 *Bann. & A. Pat. Cas.* 459.

A man worked for the defendant by the piece, in the defendant's manufactory, and there used, in the defendant's business, folding-guides, his own property, which infringed the plaintiff's patent. It was *held*, in a suit in equity, that the defendant had infringed the patent. *Wooster v. Marks*, 17 *Blatchf.* 368 ; 9 *Rep'r.* 201 ; 5 *Bann. & A. Pat. Cas.* 56.

An employee may be liable to account for the commissions derived by him from the sale of infringing goods, and may be enjoined from making any further sales. And a suit against the employer, brought in another district, for such sales, cannot be pleaded in bar to a suit against such employee for an account and injunction. *Steiger v. Heidleberger*, 4 *Fed. Rep'r.* 455 ; 18 *Blatchf.* 426 ; 18 *Pat. Off. Gaz.* 1463 ; 11 *Rep'r.* 212.

An assignment of the revenues of a railroad to a preferred creditor, and the use, by the assignee, of cars which have patented brakes attached to them, does not render him liable to account for infringement of the patent, if the brakes had been licensed to the company ; the assignee uses the brakes as agent of the company, not as purchaser. *Emigh v. Chamberlain*, 1 *Biss.* 367 ; 2 *Fish. Pat. Cas.* 192 ; 1 *Am. L. Reg. N. S.* 207.

In a suit for infringement of a patent, against a corporation, its president, L., and another, the subpoena was not served on L., but a solicitor appeared for the defendants, without naming them, and

their answer was sworn to by L. as one of the defendants and signed by his individual name. It was *held*, that he had become personally a party, so that a decree for relief asked in the bill against him personally might properly be made. *Lewis v. Standard Laundry Machinery Co.*, 21 *Blatchf.* 184.

A bill for a discovery may be maintained, in aid of an action at law for damages for infringement of a patent, against a corporation as defendant, without making its officers parties. That similar relief could be obtained by the complainant in his action at law under the local practice, does not deprive the court of its equitable jurisdiction to compel a discovery in such cases. *Colgate v. Compagnie Francaise du Telegraphe*, 23 *Fed. Rep'r*, 82.

A son, who is employed in the shop of his father as superintendent, having no interest in the business, is not liable for an infringement of a patent, merely because the infringing machine is used in the shop under his direction. *McDonald v. Whitney*, 24 *Fed. Rep'r*, 600 ; 32 *Pat. Off. Gaz.* 1465.

257. *The Right to a Preliminary Injunction in General.*

To entitle complainant in equity to the remedy of a preliminary injunction, his title by the patent, and the proof of infringement by defendant must be free from doubt. *Marks v. Corn*, 11 *Fed. Rep'r*, 900 ; 23 *Pat. Off. Gaz.* 94 ; *Steam Gauge, &c. Co. v. Miller*, 11 *Fed. Rep'r*, 718 ; *Steam Gauge & Lantern Co. v. Miller*, 8 *Fed. Rep'r*, 314 ; 20 *Pat. Off. Gaz.* 889 ; *Bradley, &c. Manuf. Co. v. Charles Parker Co.*, 17 *Fed. Rep'r*, 240 ; 24 *Pat. Off. Gaz.* 995 ; *Illingworth v. Spaulding*, 9 *Fed. Rep'r*, 154 ; 12 *Rep'r*, 354. See *Isaacs v. Cooper*, 4 *Wash.* 259 ; *Woodworth v. Hall*, 1 *Woodb. & M.* 248 ; *Id.* 389 ; 6 *Pa. L. J.* 178.

The mere fact that the complainant has obtained a patent is not enough, standing alone, to entitle him to an injunction, before a hearing upon the merits. *Orr v. Littlefield*, 1 *Woodb. & M.* 13 · 8 *L. Rep'r*, 314.

The grant of a patent by the patent-office is not, of itself, a bar to an interlocutory injunction in favor of a person claiming to be a prior patentee of the same thing ; particularly when such person had no notice to appear and be heard at the patent-office, and the court is satisfied that the last granted patent was an interference. *Wilson v. Barnum*, 1 *Wall. Jr.* 347 ; 6 *West. L. J.* 464 ; 2 *Fish. Pat. Cas.* 635.

Where an interference between complainant and defendants' assignor was decided in favor of complainant, to whom a patent was granted, and he subsequently moved for an injunction thereon, it was *held*, that the interference proceedings did not estop defendants from setting up as a defense that the invention patented was anticipated by another device. *Peck, &c. Co. v. Lindsay*, 5 *Bann. & A. Pat. Cas.* 390. Compare *Smith v. Halkyard*, 16 *Fed. Rep'r*, 414; 23 *Pat. Off. Gaz.* 1832.

Where the commissioner of patents has granted a reissue with an expanded claim, a preliminary injunction may be awarded to restrain infringement of the patent. *Lorillard v. McDowell*, 23 *Int. Rev. Rec.* 90.

Where the validity of a patent is fully established, the plaintiff is entitled to protection by an injunction; and the fact that great injury may thereby be caused to the infringer by interrupting his business as a common carrier, even though to the inconvenience of the public, is no ground for refusing it. *Hodge v. Hudson River R. R. Co.*, 6 *Blatchf.* 165.

Where a defendant sued for infringement of plaintiff's patent shows that he is acting under a patent which has been issued to himself, an injunction before the trial should not be allowed. *Good-year v. Dunbar*, 1 *Fish. Pat. Cas.* 472.

Where the defendant has done the acts complained of under the authority of a patent, and with the knowledge of the plaintiff, and unmolested for a length of time, and has invested money in the business sought to be stopped, plaintiff is not entitled to ask a preliminary injunction; except in a case free from all reasonable doubt. *North v. Kershaw*, 4 *Blatchf.* 70.

If defendant has used the patented invention unlawfully and without making compensation, the plaintiff is not deprived of his right to a preliminary injunction by the fact that defendant has discontinued such use and disclaims any intention of resuming it. *Sickles v. Mitchell*, 3 *Blatchf.* 548; *Rumford Chemical Works v. Vice*, 14 *Blatchf.* 179; 2 *Bann. & A. Pat. Cas.* 584; *Poppenhusen v. New York Comb Co.*, 4 *Blatchf.* 184; 2 *Fish. Pat. Cas.* 79. S. P., *Buck v. McGill*, 4 *McLean*, 174; *Potter v. Crowell*, 1 *Abb. U. S.* 89; 3 *Fish. Pat. Cas.* 112. The complainant in such a case is not obliged to rest his interests on the mere asseveration of the party that he will not repeat the act of infringement. Having once been a wrongdoer, the law supposes the possibility of his being so again, and will impose the proper restraint to prevent the repetition

of the wrongful act. *Jenkins v. Greenwald*, 1 *Bond*, 126 ; 2 *Fish. Pat. Cas.* 37.

258. *The Application; how Made, and how Heard and Determined.*

In patent causes, the United States courts may, in a proper case, grant a preliminary injunction without requiring notice to be given. *Yuengling v. Johnson*, 1 *Hughes*, 607 ; 3 *Bann. & A. Pat. Cas.* 99.

Informality in the notice of motion is cured by appearance of the defendant. *Brammer v. Jones*, 3 *Fish. Pat. Cas.* 340.

To grant a motion for a preliminary injunction on a patent, on a theory, which, although it may be true, is not supported by affidavits, is not proper. *American Diamond Rock Boring Co. v. Sullivan Machine Co.*, 14 *Blatchf.* 119 ; 2 *Bann. & A. Pat. Cas.* 522.

Upon a motion for an injunction to restrain an infringement, the plaintiff should include in or subjoin to his bill a special affidavit to the truth of the allegations therein, and that he was the original and first inventor, as he believed, of the thing patented, and that the same had not been in use or described anterior to his invention. The formal oath to originality of the invention, made when applying for the patent, does not suffice, for the motion. *Rogers v. Abbott*, 4 *Wash.* 514. S. P., *Sullivan v. Redfield*, 1 *Paine*, 441.

The applicant for a preliminary injunction should state facts sufficient to allow the court to decide whether or not there has been an infringement ; his affidavit merely that there has been one is not sufficient. *Kirby Bung Manuf. Co. v. White*, 5 *Bann. & A. Pat. Cas.* 263 ; 1 *Fed. Rep'r*, 604 ; 1 *McCrary*, 155 ; 17 *Pat. Off. Gaz.* 974.

Where the bill states an exclusive possession of the invention for which the plaintiff has obtained a patent, a preliminary injunction may be granted, although the court may feel doubts as to the validity of the patent. *Issacs v. Cooper*, 4 *Wash.* 259. To nearly same effect, *Woodworth v. Hall*, 1 *Woodb. & M.* 248 ; 6 *Pa. L. J.* 178.

Under the rules of the circuit court in the second circuit, the court, or a judge out of a court, has power, on a motion for a provisional injunction where the defendant sets up a license in defense,

to permit the plaintiff to put in proofs in rebuttal of the proofs put in by the defendant ; and the order to admit such rebutting proofs, when made by the court, is regular, although not made till such rebutting proofs are received. The defendant is not entitled to reply to such rebutting proofs by further proofs on his part. *Day v. New England Car Spring Co.*, 3 *Blatchf.* 154.

On a motion for a preliminary injunction to restrain the infringement of letters patent, the court will not look further into the case than to ascertain whether or not, upon established principles of equity, the interference of the court is required to prevent an irreparable injury pending the litigation. And unless the right is clear upon the papers and proofs presented in favor of the plaintiffs, the injunction will be refused. *Sickels v. Youngs*, 3 *Blatchf.* 293.

An application for a provisional injunction, to restrain a defendant from continuing an alleged infringement of a patent owned by the complainant, is addressed to the discretion of the court. *Wyeth v. Stone*, 1 *Story*, 273, 295 ; 4 *L. Rep'r*, 54 ; *Orr v. Badger*, 7 *L. Rep'r*, 465 ; 1 *Brunner Col. Cas.* 537 ; *Forbush v. Bradford*, 21 *L. Rep'r*, 471 ; 1 *Fish. Pat. Cas.* 317 ; *Orr v. Littlefield*, 1 *Woodb. & M.* 13 ; 8 *L. Rep'r*, 314 ; *Earth Closet Co. v. Fenner*, 5 *Fish. Pat. Cas.* 15 ; *Irwin v. Dane*, 4 *Fish. Pat. Cas.* 359.

In granting injunctions against the violation of patent rights, the court proceeds according to the course and principles of courts of equity in similar cases. *Sullivan v. Redfield*, 1 *Paine.* 441.

On an application for a preliminary injunction to restrain infringements of a patent which had been reissued, and had been frequently adjudicated upon and sustained, it was *held*, that the court would not entertain questions as to the originality of the invention, or the validity of the reissued patent. *Gibson v. Betts*, 1 *Blatchf.* 163.

Although, on a motion for an injunction to restrain an infringement of letters-patent, the proofs should show that, on the trial of an issue awarded in the cause, on the question of infringement, the jury found in favor of the plaintiff, still the court will not, as a matter of course, adopt the verdict, but will examine the whole case, including the evidence given before the jury, and will grant or withhold the injunction according to its own judgment thereon. *Sickels v. Youngs*, 3 *Blatchf.* 293.

Where the answer in an infringement suit denies that the patentee was the true inventor, or denies that the defendant uses the plaintiff's invention, an injunction will be refused. *American Car-*

pet Lining Co. v. Beale, 5 *Bann. & A. Pat. Cas.* 529 ; Isaacs v. Cooper, 4 *Wash.* 259.

If the complainant's patent has been sustained in a suit to the defense of which the defendants contributed, he is entitled to a provisional injunction against them, although they allege in their answer that they have a witness to the prior use of the invention, who was not examined on the trial. *Birdsall v. Hagerstown Agricultural Implement Manuf. Co.*, 6 *Pat. Off. Gaz.* 604 ; 1 *Bann. & A. Pat. Cas.* 426.

The person who originally took out the patent will not be allowed, when sued to enjoin him from infringing it, to dispute the novelty or utility of the invention. *Onderdonk v. Fanning*, 4 *Fed. Rep'r*, 148 ; 5 *Bann. & A. Pat. Cas.* 85.

In a suit to restrain an infringement, where issues of fact are presented, supported on one side by affidavits and contradicted by affidavits on the other side, so that they neutralize each other, a motion for the allowance of such an injunction will be denied. *Beane v. Orr*, 9 *Pat. Off. Gaz.* 255.

If, on a motion for an injunction, there appears, from the affidavits of the parties or witnesses, such a repugnancy in point of fact, as makes it necessary to decide on the relative truth of their conflicting statements, or the credibility of the affirmants, the injunction will not be granted. *Cooper v. Matthews*, 8 *L. Rep'r*, 413. But where a motion for an injunction against infringement rests upon affidavits of dealers in the article, stating their opinion as to its composition, and is opposed by counter-affidavits of the manufacturer of the article, who states the composition from his personal knowledge, the repugnancy is not irreconcilable ; but the statements founded on personal knowledge are deemed more reliable, and the injunction will be denied. *Gutta percha Co. v. Good-year Co.*, 3 *Sawyer*, 542 ; 2 *Bann. & A. Pat. Cas.* 212.

A preliminary injunction ought never to be issued, unless the right of a patentee is an established or admitted one, and unless the alleged invasion of the right is proved beyond reasonable doubt. *Parker v. Sears*, 4 *Pa. L. T. Rep.* 443 ; 1 *Fish. Pat. Cas.* 93 ; *Batten v. Sillman*, 3 *Wall. Jr.* 124 ; *American Nicholson Pavement Co. v. Elizabeth*, 4 *Fish. Pat. Cas.* 189 ; 3 *Pat. Off. Gaz.* 522 ; *Bailey Wringing Machine Co. v. Adams*, 5 *Cent. L. J.* 425 ; 3 *Bann. & A. Pat. Cas.* 96 ; *Irwin v. Dane*, 4 *Fish. Pat. Cas.* 359 ; *Evans v. Kelly*, 13 *Fed. Rep'r*, 903 ; 9 *Biss.* 251 ; 26 *Int. Rev. Rec* 349 ; 23 *Pat. Off. Gaz.* 192 ; 5 *Bann. & A. Pat. Cas.* 71.

Application for preliminary injunction may be granted as to articles embraced in the suit which are clearly infringements and denied as to others which are doubtful. *Allis v. Stowell*, 23 *Pat. Off. Gaz.* 1033 ; 15 *Fed. Rep'r*, 242.

A district judge cannot sign a writ of injunction by himself in vacation when the circuit court is sitting and can be applied to. *Goodyear Dental Vulcanite Co. v. Folsom*, 5 *Bann. & A. Pat. Cas.* 590 ; 3 *Fed. Rep'r*, 509 ; 26 *Int. Rev. Rec.* 251.

The patent having been sustained upon final hearing against a corporation intimately connected with the defendant, the latter, in adducing new matter, must show a strong probability, that if it had been put in evidence in former suit, a different result would have been reached. *Colgate v. Gold & Stock Telegraph Co.*, 16 *Pat. Off. Gaz.* 583.

Although the court should examine anew the case, the defendant not having been a party to any former suits, yet if the points presented are the same, former decisions must be given great weight. *Potter v. Whitney*, 3 *Fish. Pat. Cas.* 77.

Where a plaintiff moves for an injunction, and it is denied on defects pointed out, it is too late, after defendant has closed his proofs for final hearing, to renew his motion upon papers designed to cure such defects. *Wooster v. Howe Sewing Machine Co.*, 16 *Pat. Off. Gaz.* 314.

259. *Necessity of First Establishing Plaintiff's Title at Law.*

A patent is *prima facie* evidence of a right ; but to grant an injunction upon the mere exhibition of a patent, and an allegation that it has been infringed, is not matter of course; the court should be reasonably satisfied as to the validity of the patent, either by result of some judicial investigation or by proof of long public acquiescence. *Sullivan v. Redfield*, 1 *Paine*, 441 ; *Grover, &c. Sewing Machine Co. v. Williams*, 2 *Fish. Pat. Cas.* 133 ; *Tappan v. National Bank Note Co.* *Id.* 195.

So long as there is room for doubt whether the patent under which the complainant claims is valid, the court will not grant a provisional injunction, but will require him first to establish its validity, in an action at law. *Washburn v. Gould*, 3 *Story*, 122 ; 1 *West. L. J.* 465 ; 7 *L. Rep'r*, 276 ; *Concord v. Norton*, 16 *Fed.*

Rep'r, 477 ; *Sullivan v. Redfield*, 1 *Paine*, 441 ; *Thomas v. Weeks*, 2 *Paine*, 92 ; *Isaac v. Cooper*, 4 *Wash.* 259 ; *Ogle v. Ege*, *Id.* 584 ; *Miller v. McElroy*, 1 *Pa. L. J. Rep.* 304 ; *Brooks v. Bicknell*, 4 *McLean*, 70 ; 3 *West. L. J.* 109.

In general, a preliminary injunction is granted only, 1, where the right of the complainant has been established at law ; or, 2, where he has enjoyed the patent, avowedly and as against the public, for a considerable period unquestioned ; or, 3, where his right is clear and unquestionable. *North v. Kershaw*, 4 *Blatchf.* 70 ; *Toppan v. National Bank Note Co.*, *Id.* 509 ; 2 *Fish. Pat. Cas.* 202 ; *Irwin v. McRoberts*, 16 *Pat. Off. Gaz.* 853. To nearly same effect, *Doughty v. West*, 2 *Fish. Pat. Cas.* 553.

Although a decision has been made against the validity of the original patent on account of defects in the specifications, yet a preliminary injunction may be granted on a reissue. *Schneider v. Bassett*, 13 *Fed. Rep'r*, 351 ; 22 *Pat. Off. Gaz.* 1447.

Whether the judgment at law relied upon to support an application for a preliminary injunction must have been rendered in the same circuit or district as that wherein the suit in equity is filed, or whether a judgment in another circuit or district is sufficient, see *Wells v. Gill*, 2 *Pat. Off. Gaz.* 590 ; 6 *Fish. Pat. Cas.* 89 ; *Pennsylvania Salt Co. v. Myers*, 1 *Week. N. of Cas.* 377 ; *Spring v. Domestic Sewing Machine Co.*, 2 *N. J. L. J.* 274 ; *De Ver Warner v. Bassett*, 7 *Fed. Rep'r*, 468 ; 12 *Rep'r*, 35.

Prior adjudications on the same issues in other circuits will be sufficient for the purpose of granting a temporary injunction. *American Bell Telephone Co. v. National Improved Telephone Co.*, 27 *Fed. Rep'r*, 663.

Whether a judgment rendered upon consent of the parties is such an adjudication as will sustain the plaintiff in making application for a provisional injunction against a third person, see *Orr v. Littlefield*, 1 *Woodb. & M.* 13 ; 8 *L. Rep'r*, 314 ; *De Ver Warner v. Bassett*, 7 *Fed. Rep'r*, 468 ; 12 *Rep'r*, 35.

For decisions of the courts in former years which determine questions of detail in the application of the rule that a patent must have been sustained at law before equity will grant a preliminary injunction, see the following : Verdict without judgment sufficient. *Orr v. Badger*, 7 *L. Rep'r*, 465 ; 1 *Brunner Col. Cas.* 537. Recoveries against other persons sufficient against an infringer. *Hovey v. Stevens*, 1 *Woodb. & M.* 290 ; *Woodworth v. Hall*, *Id.* 248 ; 6 *Pa. L. J.* 178. Efforts to obtain adjudications, causing great delay

and loss, but frustrated by disagreements of juries, sufficient. *Buck v. Cobb*, 9 *L. Rep'r*, 545 ; 1 *Brunner Col. Cas.* 550. Where there had been an adjudication sustaining the claim of the patent which defendant was infringing, although the patent contained another claim which was in dispute. *Colt v. Young*, 2 *Blatchf.* 471. Where there had been an adjudication sustaining the patent, but it was under review in the supreme court. *Wells v. Gill*, 2 *Pat. Off. Gaz.* 590 ; 6 *Fish. Pat. Cas.* 89. Decree against buyers and users, sufficient against manufacturer. *United States, &c. Salamander Felting Co. v. Asbestos Felting Co.*, 10 *Pat. Off. Gaz.* 828.

For decisions holding simply that adjudications or public acquiescence in a patent, or both combined, will warrant a preliminary injunction, see *Van Hook v. Pendleton*, 1 *Blatchf.* 187 ; *Robertson v. Hill*, 4 *Pat. Off. Gaz.* 132 ; 6 *Fish. Pat. Cas.* 465 ; *Odorless Excavating Co. v. Lauman*, 12 *Fed. Rep'r*, 788 ; 4 *Woods*, 129 ; *Kirby Bung Manuf. Co. v. White*, 5 *Bann. & A. Pat. Cas.* 263 ; 1 *Fed. Rep'r*, 604 ; 1 *McCrary*, 155 ; 17 *Pat. Off. Gaz.* 974.

Previous adjudications in favor of a patent entitle complainants to the relief of a preliminary injunction against what seems to be a clear infringement. *Thayer v. Wales*, 9 *Blatchf.* 170 ; 5 *Fish. Pat. Cas.* 130. S. P., *Blaisdell v. Dows*, 4 *Bann. & A. Pat. Cas.* 499.

Long public acquiescence in the complainant's patent, together with the adjudications in favor of its validity, are *prima facie* sufficient reasons for the grant of a preliminary injunction when the infringement is palpable. *American Shoe Tip Co. v. National Shoe Toe Protector Co.*, 11 *Pat. Off. Gaz.* 740 ; 2 *Bann. & A. Pat. Cas.* 551.

A decision upon an interference, although not conclusive in an action between the parties for an infringement of the patent granted in pursuance of such decision, is an adjudication upon the patentability of the invention and the right of the successful party to the patent, to lay a foundation for a preliminary injunction. Alleged anticipation of the invention by others, or prior invention by defendants themselves, unless made clearly to appear, will not avail them to prevent an injunction. *Celluloid Manuf. Co. v. Chrolithian Collar, &c. Co.*, 24 *Fed. Rep'r*, 275 ; 32 *Pat. Off. Gaz.* 383.

Acquiescence for a considerable time, by a complainant in the infringement of his patent, is ground for refusing him a preliminary injunction in his suit for such infringement. *Mundy v. Kendall*, 23 *Fed. Rep'r*, 591 ; 32 *Pat. Off. Gaz.* 1237.

The fact that a patent is recent, and has not been judicially declared to be valid, is not, alone, ground for refusing a preliminary injunction in a suit for infringement. 1885, *Foster v. Crossin*, 23 *Fed. Rep'r*, 400.

Where the patent was not disputed, it was *held*, that the fact that the defendant had accepted and operated under a license was proof enough of validity of the patent, to sustain a temporary injunction. *Brown v. Lapham*, 27 *Fed. Rep'r*, 77.

Where in previous litigation a patent has been sustained against all the defenses ordinarily set up in patent cases, the question of its validity is hardly an open one on an application for a preliminary injunction. *Cary v. Domestic Spring Bed Co.*, 27 *Fed. Rep'r*, 299.

260. *Or by Long Public Acquiescence.*

Where acquiescence alone is relied upon as a basis for the motion for a preliminary injunction, the infringement must be palpable; if the defendants are using a machine openly made, sold and used under patents, and manufactured in good faith in open competition, there is reason why the court should hesitate to interfere before final decree. *Burleigh Rock-Drill Co. v. Lobdell*, 1 *Holmes*, 450; 7 *Pat. Off. Gaz.* 836; 1 *Bann. & A. Pat. Cas.* 625.

An inventor may make and sell his invention for two years before his patent, and the public may acquiesce in his claim during such period; and such acquiescence may be entitled to weight, in considering his right to a temporary injunction; and where sufficient possession is thus established, a doubt concerning the validity of the patent will not necessarily prevent an injunction. *Sargent v. Seagrave*, 2 *Curt.* 553.

To show lapse of time without objection raised, does not prove public acquiescence; there must be circumstances indicating that no doubt existed of the patent. *Guidet v. Palmer*, 10 *Blatchf.* 217; 6 *Fish. Pat. Cas.* 82.

Where complainant has for a number of years been in the extensive and undisputed use of patents, and during all that period there has been a public acquiescence in the monopoly, a provisional injunction to restrain infringement will be granted, unless some special facts appear to take it out of the general rule. *McKay v. Dibert*, 5 *Fed. Rep'r*, 587; 19 *Pat. Off. Gaz.* 1351; 11 *Rep'r*, 386.

So held, as to acquiescence in the claim to the invention during the two years preceding the application. *Sargent v. Seagrave*, 2 *Curt.* 553.

Where an invention is new and useful, want of public acquiescence cannot avail parties infringing the patent therefor, to defeat a preliminary injunction. *Hussey Manuf. Co. v. Deering*, 20 *Fed. Rep'r*, 795.

A reissue patent, containing claims not in the original, is to be treated as a new patent so far as its standing as to acquiescence and acceptance by the public is concerned. *Irwin v. McRoberts*, 16 *Pat. Off. Gaz.* 854.

261. *Equitable Reasons for Granting a Preliminary Injunction on the Merits.*

A preliminary injunction is grantable where, upon appearance of defendant to notice, he contests plaintiff's title without successfully rebutting the allegation of infringement. *Blackwell v. Armistead*, 5 *Am. L. T. U. S. Cts.* 85.

Under an agreement to manufacture and sell a patented article, equity will enjoin the breach of negative covenants and decree a specific performance of the agreement between the parties. *Hapgood v. Rosenstock*, 23 *Fed. Rep'r*, 86.

Under a contract giving the exclusive right of sale of a patented article, an injunction against sales by the grantor will be allowed, until the contract is set aside, although he claims that the contract was obtained by fraud. *Goddard v. Wilde*, 17 *Fed. Rep'r*, 845 ; 16 *Rep'r*, 617.

Although equity might have decreed a surrender and cancellation of the contract giving plaintiff the exclusive right in the patent, yet until this has been done he must be deemed to continue in the enjoyment of the right, and to be entitled to an injunction against infringement. *Gibson v. Barnard*, 1 *Blatchf.* 388.

A person who has a license to use a patented machine, upon certain conditions, may be enjoined from using it except upon those conditions, but a failure to perform such conditions is not necessarily a forfeiture of his license, such as entitles the plaintiff to an absolute injunction against all use of the machine. *Brooks v. Stolley*, 3 *McLean*, 523 ; 2 *West. L. J.* 396 ; *Wilson v. Sherman*, 1 *Blatchf.* 536.

But where it appeared that the licensee had violated the restriction under a misapprehension of his rights, and had discontinued the violation, the injunction was refused. *Wilson v. Sherman*, 1 *Blatchf.* 536.

One who, for a good consideration, has covenanted not to further infringe a patent, may be enjoined from further infringing, unless he shows some equitable reason why the agreement should not be enforced. *Sargent v. Larned*, 2 *Curt.* 340.

A party to a mutual and reciprocal covenant respecting a patent, who has broken it, cannot obtain the aid of a court of equity to restrain the other covenantor from its violation. Otherwise, where the covenants are independent, or only collaterally connected; or where the breach is of such a nature that it may be fully repaired. *Clum v. Brewer*, 21 *L. Rep'r*, 390.

262. *Preliminary Injunctions Granted Under Special Circumstances.*

A corporation, owner of certain patents, granted an exclusive license to the complainant to sell machines, and agreed to furnish the machines at a certain price; but, afterward, refused to deliver them; assigning the patent to one having knowledge of the contract, in trust for another association; and took measures for its own dissolution. At the suit of the licensee, a preliminary injunction was granted restraining the corporation from dissolving its organization, and the assignee in trust of the patents from transferring them. *Singer Sewing Machine Co. v. Union Button-hole, &c. Co.*, 1 *Holmes*, 253; 4 *Pat. Off. Gaz.* 553.

After the lapse of much time, the affidavit of a single witness that the patentee was not the first inventor was *held* not enough to outweigh the oath of the patentee and the general presumption arising from the grant of the letters-patent; and that an injunction should be granted. *Woodworth v. Sherman*, 3 *Story*, 171; 7 *L. Rep'r*, 279.

The complainant having been long in the enjoyment of his patent, a preliminary injunction was ordered, restraining the defendants from infringing, notwithstanding affidavits were filed, showing that articles embodying the alleged invention had been in use before the complainant made it, there being evidence to the contrary, and none of the alleged anticipating articles being produced.

Chase v. Wesson, 4 *Pat. Off. Gaz.* 476 ; 1 *Holmes*, 274 ; 6 *Fish. Pat. Cas.* 517.

Where a party held a license under a patent, in which the patentee reserved the power, upon default of payment of the agreed price for the privilege, to claim and take back the right ; and an action was brought to recover the arrears, the patentee was *held* entitled to an injunction to restrain the licensee from further use of privilege ; the action for the arrears, and judgment therein, being adjudged no waiver of the forfeiture. *Armstrong v. Hanlenbeck*, 3 *N. Y. Leg. Obs.* 431.

The right to a patent having been established in a suit at law, a preliminary injunction against a like apparatus was granted, although the defendant claimed that the apparatus used by him was patented and had been adopted by him in good faith. *Sickles v. Tileston*, 4 *Blatchf.* 109.

Preliminary injunction in a suit for infringement of a patent was granted, where it appeared that a refusal would work great and perhaps irreparable injury to complainant's business, and defendant, being a merchant and not a manufacturer, would not be materially injured by being required to discontinue his sales until the questions at issue should be finally determined. *Covert v. Curtis*, 25 *Fed. Rep'r*, 43.

In the case of a license to use a patented machine in consideration of the licensee's promissory notes, with a stipulation in writing that if any one of the notes should become due and be unpaid, the license should be void, and should revert, a provisional injunction against further use was granted, unless the licensee should in sixty days pay the amount of the due and unpaid note. *Woodworth v. Weed*, 1 *Blatchf.* 165.

Notwithstanding the use of the infringed combination was stopped upon suit brought, an injunction and account were decreed, where the defendants had made no disclaimer of the right to use, and it did not appear that the previous use, though disadvantageous to themselves, was without damage to complainants ; and where other evidence as to profits might be given on an accounting *Bullock Printing Press Co. v. Jones*, 13 *Pat. Off. Gaz.* 124 ; 3 *Bann. & A. Pat. Cas.* 195.

The fact that defendant has, by government grants, the exclusive right to operate a submarine telegraph, so that patentee of an invention which defendant is using could not make use of his invention over the line, does not exempt defendant from injunction

to restrain his use of the invention. *Colgate v. International Ocean Tel. Co.*, 17 *Blatchf.* 308 ; 9 *Rep'r*, 166 ; 4 *Bann. & A. Pat. Cas.* 609.

A decree for an injunction and account granted upon the circumstances in the particular case, against several defendants who owned, rented or occupied premises in which were placed driven wells which were used by them, and against a defendant who purchased and rented out, but never personally occupied premises containing a driven well. *Green v. Gardner*, 22 *Pat. Off. Gaz.* 683 ; 5 *N. J. L. J.* 174.

The main and principal feature of the art of canning foods of various kinds, being old and well known, a patent for any particular article of canned goods "as a new article of commerce," must be clearly sustained, by proof in order to sustain an injunction against other manufacturers of similar goods. *Wilson Packing Co. v. Clapp*, 8 *Biss.* 154 ; 3 *Bann. & A. Pat. Cas.* 243.

263. *Equitable Reasons for Refusing a Preliminary Injunction, on the Merits.*

A circuit court will not enjoin a patentee from manufacturing under his patent, upon allegations that he surreptitiously procured a patent right for an improvement, for which complainant made application for a patent. Until the complainant succeeds in obtaining a patent, he is not in a position to contest the validity of the defendant's patent, by a suit against him for an infringement. *Hoeltge v. Hoeller*, 2 *Bond*, 386.

An injunction ought not to issue to restrain infringement when it does not appear from the record that the defendant has ever made or sold any of the goods in the district. *Wilson Packing Co. v. Clapp*, 8 *Biss.* 154 ; 3 *Bann. & A. Pat. Cas.* 243. Compare *Goodyear v. Chaffee*, 3 *Blatchf.* 268.

A probability that irreparable injury may be done by granting a preliminary injunction may be reason for refusing it. *North v. Kershaw*, 4 *Blatchf.* 70. But see *Sickles v. Tileston*, 4 *Blatchf.* 109.

Where the defendant is manufacturing under letters-patent, the presumption is that he is not infringing, and unless the court can see, from an inspection alone of the patent, that his article is an infringement, the court will not issue an injunction until after a

full hearing. *Sargent Manuf. Co. v. Woodruff*, 5 *Diss.* 444; 1 *Fish. Pat. Cas.* 277.

A preliminary injunction will not be granted where defendants have manufactured under the sanction of a patent of prior date, which patent of prior date has expired, and no proceedings have, at any time, been instituted by complainants to secure or protect their rights under their patents. *Whitney v. Rollstone Machine Works*, 8 *Pat. Off. Gaz.* 908. See also *Sargent v. Carter*, 21 *L. Rep'r*, 651.

A preliminary injunction will be refused where grave doubt exists, on the evidence, whether there has been any infringement, and there is some doubt as to the validity of the patent. *Cross v. Livermore*, 9 *Fed. Rep'r*, 607.

The existence of a substantial doubt whether a reissued patent is for the same invention as the original, and as to the true construction to be given to the reissued patent, is a proper ground for denying a motion for a provisional injunction to restrain the infringement of the reissued patent. *Poppenhusen v. Falke*, 4 *Blatchf.* 493; 2 *Fish. Pat. Cas.* 181.

Where a reissue is in terms broader than the original, preliminary injunction denied, there being a doubt as to whether the patentee had applied for a reissue within a proper time. *Brewster & Co. v. Parry*, 14 *Fed. Rep'r*, 694.

Where there was no danger of loss to the plaintiff, the defendant being shown to be fully responsible for profits and damages, and great loss will result to the defendant, and where the latter does not make or vend the patented article, it was *held*, that a preliminary injunction should be denied, the title of plaintiff not being fully established. *Morris v. Lowell Manuf. Co.*, 3 *Fish. Pat. Cas.* 67; 3 *Wall. Jr.* 310; *Potter v. Whitney*, *Id.* 77.

A preliminary injunction will not be granted where the plaintiff has acquiesced in the infringement, and unreasonably delayed suit against infringers. *Green v. French*, 16 *Pat. Off. Gaz.* 215; *Morris v. Lowell Manuf. Co.*, 3 *Fish. Pat. Cas.* 67; 3 *Wall. Jr.* 310.

'Two years' use by defendant of complainant's patent with the latter's knowledge, who took no steps to stop it, was *held* sufficient to defeat a motion for a preliminary injunction. *Spring v. Domestic Sewing Machine Co.*, 16 *Pat. Off. Gaz.* 721.

264. *Refusal of Preliminary Injunctions, under Special Circumstances.*

The patent having been reissued just after the bringing of the suit ; and no exclusive possession of the invention for any considerable time, accompanied by acquiescence by the public, or any verdict, judgment, decree, or judicial order, recognizing the validity of the claim, being shown, nor irreparable injury to the complainant averred, a provisional injunction was refused. *Earth Closet Co. v. Fenner*, 5 *Fish. Pat. Cas.* 15.

Where, on a motion for a provisional injunction, the novelty of the invention was denied, and it was admitted that the plaintiff had sold, before his application for a patent, large quantities of the article in packages marked as "imported from Paris," the injunction was denied until the plaintiff should establish his right by a suit at law. *Booth v. Garely*, 1 *Blatchf.* 247 ; 6 *N. Y. Leg. Obs.* 99.

The infringing articles were made and sold in Rhode Island, and the defendant resided there and carried on there the business of making and selling them. It was *held*, that a motion in New York must be denied on the grounds that defendant was beyond the process of injunction, and issuing it would be inoperative and useless ; and that the proper place to apply was in Rhode Island. *Goodyear v. Chaffee*, 3 *Blatchf.* 268.

The plaintiff moved for an injunction to restrain the infringement of a patent. It was shown by the defendant that he had used the patented apparatus for nearly three years before any claim was made by the plaintiff. The court refused an injunction until the alleged acquiescence should be explained. *Sykes v. Manhattan Elevator, &c. Co.*, 6 *Blatchf.* 496.

Where the alleged infringement consisted in using a stone crusher in repairing roads in a public cemetery, the court denied a preliminary injunction ; because the use was for public convenience ; and also, defendants had tendered a compensation to abide event of the suit. *Blake v. Greenwood Cemetery*, 14 *Blatchf.* 342 ; 13 *Pat. Off. Gaz.* 1046 ; 3 *Bann. & A. Pat. Cas.* 112.

A decree, in a suit founded on a patent, rendered in favor of plaintiff because the defendants abandoned the defense and allowed the decree to be entered without objection and without a hearing, is not sufficient ground upon which to grant a preliminary injunc-

tion in a subsequent suit in another district and against other parties, founded on the same patent. *Hayes v. Leton*, 5 *Fed. Rep'r*, 521.

The patent was for an improvement on the horizontal wheel for gaining power to propel boats, but the specifications did not state the nature of the original invention upon which it was an improvement, nor whether it had been patented, nor give any information respecting it. An injunction was refused, on the ground that the nature of the improvement was unintelligible. *Isaacs v. Cooper*, 4 *Wash.* 259.

Special injunction to stop one hundred mills on an alleged infringement of the patent for the Parker water-wheel, was refused; where defendants had had many years' unchallenged possession of the machines, which they purchased from patentees with *prima facie* evidence of title. An injunction is not employed to create, but to prevent mischief. *Parker v. Sears*, 4 *Pa. Law J. Rep.* 443; 1 *Fish. Pat. Cas.* 93.

The plaintiff's patent was for the combination of a flat, horizontal iron plate, in connection with a chamber or recess below the plate. The defendant put horizontal plates into fire-places already provided with recesses which he had no agency in constructing. It was *held*, that the question of infringement was so far doubtful as to forbid the granting of an injunction. *Dodge v. Card*, 1 *Bond*, 393; 2 *Fish. Pat. Cas.* 116.

Plaintiff's patent had been upheld in another court, and the first claim declared to have been infringed; but there was no evidence in the present suit to show that defendant's contrivance was the same as the infringing articles in the former suit. Defendant denied infringement, and set up another patent. The moving papers contained no evidence of infringement. Preliminary injunction was denied, but defendant ordered to keep an account. *Blake v. Boisselier*, 5 *Bann. & A. Pat. Cas.* 352.

In a suit brought by a patentee, alleging an infringement and claiming only a royalty or license for the use of the patented device, a motion for a provisional injunction *simpliciter* will not be granted of course, even where the patent alleged to have been infringed has been held valid in other cases; the defendant will be held only to give bond to the plaintiff, to secure him to the full extent of his demand, with costs, &c. *McMillan v. Conrad*, 16 *Fed. Rep'r*, 123; 5 *McCrory*, 140.

A license to use a machine, the patent for which was assigned

by the licensee who invented it, to the licensor, was *held*, independent of a license previously granted by the same licensor to the same licensee, to use a process in which the machine subsequently patented was employed, so that failure to pay royalties under the earlier license did not entitle the licensor to an injunction restraining the use of such machine by the licensee. *Washburn, &c. Manuf. Co. v. Wilson*, 19 *Fed. Rep'r*, 233.

Motion for a preliminary injunction was denied in a case where complainants had known of the manufacture by the defendants of the alleged infringing machines for several years, and had neither warned nor proceeded against them, and some doubt existed as to the infringement. *Ballou Shoe Machine Co. v. Dizer*, 5 *Bann. & A. Pat. Cas.* 540.

Preliminary injunction denied, where the infringing machine was not identical with the one declared in a prior suit to be an infringement; defendant having been granted a patent since then on the present machine; and the patent of complainant never having been upheld on final hearing. *Onderdonk v. Fanning*, 5 *Bann. & A. Pat. Cas.* 562; 2 *Fed. Rep'r*, 568; 9 *Rep'r*, 737.

Preliminary injunction denied, because stopping the use of the invention would greatly embarrass defendant's entire business (the publication of newspapers) and was not necessary to secure justice for plaintiff. *Hoe v. Boston Daily Advertiser Corp.*, 14 *Fed. Rep'r*, 914; 23 *Pat. Off. Gaz.* 1124. *S. P., Swift v. Jenks*, 19 *Fed. Rep'r*, 641.

Preliminary injunction refused, on account of delay in suing, coupled with other circumstances indicating that patentee had no important right. *Tillinghast v. Hicks*, 23 *Pat. Off. Gaz.* 739; 13 *Fed. Rep'r*, 388; 14 *Rep'r*, 578.

Equities in favor of an infringer of a patent which may prevent an injunction, see *New York Grape Sugar Co. v. Buffalo Grape Sugar Co.*, 18 *Fed. Rep'r*, 638; 25 *Pat. Off. Gaz.* 1076.

Preliminary injunction against alleged infringement denied, where plaintiff had failed to press a pending suit at law for the same infringement against the same defendant, and the latter was pecuniarily responsible. *United Nickel Co. v. New Home Sewing Machine Co.*, 17 *Fed. Rep'r*, 528.

Effect of words "to be held to the full end of the term for which said letters patent are or may be granted," when used in the habendum of a deed, reconsidered. Where the assignor from whom complainant derived title had never done anything with the patent

in the State where the suit is pending during its extended term, and defendants bought their machines in ignorance of his rights, and the existence of the machines now set up as prior to the patent was the subject of different issues from those in the former suit on the patent, in which its validity was sustained, it was *held*, that the court would not, upon preliminary motion, enjoin the defendants from using the machines; but that the court would have acted differently if it had appeared that the defendants were not responsible; also, that if the court were sitting in any other state, it would grant an injunction against uses of the machine there, as the assignor's neglect would not affect complainant's rights in a state where complainant's title was not derived through him. *Gear v. Holmes*, 6 *Fish. Pat. Cas.* 595.

A preliminary injunction in a suit by licensor against licensee under a patent, was refused on the ground of fraud by complainant in concealing an arrangement with another licensee for the manufacture of the patented article at royalties less than the rates agreed upon between the parties; it appearing also that complainant had lost control of the market, and left it to be supplied by infringers who paid no royalties. *Washburn & Moen Manuf. Co. v. Cincinnati Barbed Wire Fence Co.*, 22 *Fed. Rep'r*, 712. And see *Washburn & Moen Manuf. Co. v. H. B. Scutt & Co.*, *Id.* 710.

A preliminary injunction in a suit for infringement of a patent was refused, there being some doubt as to the novelty of the invention; upon defendants giving security for profits and damages for infringement, if the patent should be sustained. *New York Belting, &c. Co. v. Magowan*, 23 *Fed. Rep.* 597.

Preliminary injunction in suit for infringement of a reissued patent was refused, the validity of the reissued patent, in respect of the alleged infringement, being doubtful, and the defect appearing to be, under the circumstances, incurable. *Arnheim v. Finster*, 24 *Fed. Rep'r*, 276; 32 *Pat. Off. Gaz.* 256.

Where the claims of a reissued patent appear to have been made so comprehensive and elastic as to embrace all subsequent inventions which might be made within the same field of improvement, which is more than belongs to the patentee a preliminary injunction will not be granted in suit for infringement, even of a claim held valid against a defendant who has acted on the assumption that such reissued patent could not be sustained. *Western Union Tel. Co. v. Baltimore, &c. Tel. Co.*, 25 *Fed. Rep'r*, 30.

Preliminary injunction in suit for infringement of various pat-

ents for dies for forging ox-shoes, and for the process of forging by the use of the dies, was refused until final hearing of doubtful questions of validity of reissues, and of novelty and patentability of devices described. *Gunn v. Savage*, 25 *Fed. Rep'r*, 101.

In a suit for infringement of a patent for the use of chloride of lime as a sizing ingredient in the manufacture of pulp-size paper, it appeared that chloride of lime had long previous to the patent been used in the manufacture for bleaching, and was usually washed out, at least in part, before the sizing materials were applied; but that the defendant had, long before the date of the patent, in manufacturing such paper, allowed the chloride of lime, introduced for bleaching, to remain, which was the method of manufacturing complained of as an infringement. It was *held*, that equity would not interfere to restrain a continuance of the defendant's business or manufacture as pursued anterior to the patent. *Dorlan v. Guie*, 25 *Fed. Rep'r*, 816; 34 *Pat. Off. Gaz.* 702.

Preliminary injunction was refused in a suit for infringement, notwithstanding a decision of the supreme court of the United States sustaining the complainant's patent as valid, where there was doubt as to whether the device alleged to infringe was covered by the patent. *Consolidated Safety Valve Co. v. Ashton Valve Co.*, 26 *Fed. Rep'r*, 319.

Preliminary injunction in a suit for infringement of a patent was refused, the averments in the affidavits in support of the motion being insufficient, and the opposing affidavits making the case a doubtful one. *International Tooth Crown Co. v. Mills*, 30 *Pat. Off. Gaz.* 662.

Preliminary injunction in suit for infringement of a patent was refused, where there was doubt as to the title of the complainant, who claimed as an assignee of the patent. *Continental Store Service Co. v. New York Store Service Co.*, 31 *Pat. Off. Gaz.* 1561.

265. *Granting or Refusing Injunction, upon Terms as to Security, &c.*

An application for a provisional injunction may be granted or refused unconditionally, or terms may be imposed on either of the parties, as conditions for making or refusing the order. The state of the litigation (where the plaintiff's title is denied), the nature of the improvement, the character and extent of the infringement

complained of, and the comparative inconvenience which will be occasioned to the respective parties, by allowing or disallowing the motion, must all be considered in determining whether the injunction should be allowed or refused; and if allowed, whether absolutely or upon some and what conditions. *Forbush v. Bradford*, 21 *L. Rep'r*, 471; 1 *Fish. Pat. Cas.* 317.

Where the defendants were using but not making, certain looms having a patented improvement, and an injunction would stop their whole business, it was *held*, that they might be allowed to give security to keep and render an account. *Ib.*

If an injunction will lead to serious injury in suspending the works of the defendant, the court may require security of the complainant, to indemnify the defendant for such loss, if the patent is held void. Or it can make an order to expedite a final hearing and decision. *Orr v. Littlefield*, 1 *Woodb. & M.* 13; 8 *L. Rep'r*, 314.

An injunction should not be granted where the plaintiff is made secure of receiving all the profits which may arise from the use of the machine until the final hearing. *Foster v. Moore*, 1 *Curt.* 279.

When the infringement is clear and the patent valid, an injunction will not be refused because the defendant offers to give bond with surety to pay any damages awarded against him. *McWilliams Manuf. Co. v. Blundell*, 11 *Fed. Rep'r*, 419; 22 *Pat. Off. Gaz.* 177. S. P., *Gibson v. Van Dresar*, 1 *Blatchf.* 532; *Tracy v. Torrey*, 2 *Blatchf.* 275.

Where an injunction had been granted against a person for an infringement of a patent, and while such proceedings were being taken, a third party, with full knowledge of all the circumstances connected with such injunction, became the assignee of all the rights and interests of the persons first enjoined, it was *held*, that such assignee stood in the light of the other's substitute, and that he could not be allowed, by giving security and giving an account, to continue the business till final hearing, but an injunction should issue against him. *Parkhurst v. Kinsman*, 2 *Blatchf.* 78.

Injunction to restrain infringement was refused, against a *bona fide* purchaser, upon the defendant's giving bond to account, although the plaintiff's patent had been established in two trials at law in suits between other parties. *United States Annunciator, &c. Manuf. Co. v. Sanderson*, 3 *Blatchf.* 184.

Although the defendant's machine may infringe, yet if it contain other valuable improvements not covered by plaintiff's patent,

an order for account and security may be substituted for an injunction. *Stainthorp v. Humiston*, 2 *Fish. Pat. Cas.* 311.

Upon an application for an injunction, the defendants offered to pay the plaintiff a reasonable sum for the use of the invention. It was *held*, that the defendant ought not to be enjoined, unless he preferred to be enjoined rather than pay the plaintiff a reasonable sum for the use of the invention; such sum not to exceed the license fee usually charged in like cases, and to be ascertained by reference to a master. *Hodge v. Hudson River R. R. Co.*, 6 *Blatchf.* 162.

Injunction withheld upon the giving of a bond by defendant, when the prior adjudication upon which the right to a preliminary injunction was based is pending on appeal to the supreme. *Wells v. Gill*, 6 *Fish. Pat. Cas.* 89.

On a motion for a preliminary injunction to restrain the infringement of a patent for a dredging machine, the validity of the patent was denied, on the ground of a prior public use. The patent had never been adjudicated upon, and the general allegation of public acquiescence in the bill, and which was the only proof thereof, was denied. The defendant was constructing, for his own use, a single machine. It was *held*, that the injunction ought not to be granted, provided the defendant should give security sufficient to protect the plaintiff against all loss and damages by reason of the construction and use of the machine, and to pay any sum which might be awarded to the plaintiff in the suit. *Morris v. Shelbourne*, 8 *Blatchf.* 266; 4 *Fish. Pat. Cas.* 377.

The plaintiffs in a suit in the circuit court against T. for manufacturing and selling gas machines, obtained a decree requiring T. to account for his gains and profits from such manufacture and sale, and for all damages sustained by the plaintiffs from such infringement by T. No final decree had been entered. The plaintiffs then brought this suit against B. for infringing the patent by the use of a machine purchased by him from T. and applied for a provisional injunction to restrain the further use of the machine. It was *held*, that B. ought to be allowed to give security for the payment of any decree that might be rendered against him, and that, if he would do so, the injunction ought not to be granted. *Gilbert, &c. Manuf. Co. v. Bussing*, 12 *Blatchf.* 426; 1 *Bann. & A. Pat. Cas.* 621; 8 *Pat. Off. Gaz.* 144.

Where a preliminary injunction against the use of a device claimed to be patented would work great injury to one party with-

out corresponding benefit to the other, it should not issue ; but that a bond to keep and file a verified account and to pay the amount of any decree for damages should be given. *Swift v. Jenks*, 19 *Fed. Rep'r*, 641. S. P., *Hoe v. Boston Daily Advertiser Corp.*, 14 *Fed. Rep'r*, 914 ; 23 *Pat. Off. Gaz.* 1134.

Where a party has only some vague and indistinct right, and an order may work an injury to defendant's business, a preliminary injunction will not be granted *simpliciter*, without a bond or security. *Blake v. Boisselier*, 16 *Pat. Off. Gaz.* 854.

Where the judges differed as to the question of infringement, and the jury had failed to agree, the court directed that an injunction already granted should be dissolved, upon the defendant giving proper security to keep an account ; or, if he should fail so to do, then, that it should remain, upon the plaintiff giving proper security. *Wilson v. Barnum*, 1 *Wall. Jr.* 347 ; 2 *Fish. Pat. Cas.* 635 ; 6 *West. L. J.* 464.

If the owner of a patent has never made, used, or sold to others to be used, the invention covered by his patent, an injunction will be denied, in the interlocutory decree, against its use by an infringer, on his giving bond to secure any damages which may be awarded on final hearing. *Hoe v. Knap*, 27 *Fed. Rep'r*, 204.

The fact that defendants are well able to pay ultimate damages is not a sufficient ground for the refusal of a preliminary injunction. *American Middlings Purifier Co. v. Christian*, 3 *Bann. & A. Pat. Cas.* 42.

The validity of the patents having been passed upon in one case, and restraining orders granted upon an *ex parte* application against other defendants, it was *held*, upon application for a preliminary injunction based upon the same proof as to infringement, that a preliminary injunction should be denied, there being a doubt as to infringement, upon condition that a bond be given for any damages that might be awarded, and an account of sales kept. *Steam Guage Co. v. St. Louis Ry. Supply Co.*, 25 *Fed. Rep'r*, 494 ; 33 *Pat. Off. Gaz.* 889.

266. *Dissolution or Suspension of Preliminary Injunctions.*

An injunction is not necessarily to be dissolved because the right of the patentee is made to appear doubtful. *Orr v. Badger*, 7 *L. Rep'r*, 465 ; 1 *Brummer Col. Cas.* 537.

An injunction issued on an injunction bill which alleges long possession and sales under the patent, and that the validity of the patent has been supported by several trials, will not be dissolved on an answer of mere general denials of the originality of the patent, and the defendant's use of the invention, unless the denial is justified by the facts, or the claim of defendant is strengthened by some evidence. *Orr v. Merrill*, 1 *Woodb. & M.* 376.

An injunction once granted should not be dissolved for mere doubts ; particularly when they relate to form, and the time for a trial on the merits is near. *Woodworth v. Hall*, 1 *Woodb. & M.* 389.

The suspension of an interlocutory decree perpetually enjoining the infringement, until the final decision, upon defendants giving a bond, rests in the sound discretion of the court. *Brown v. Deere*, 6 *Fed. Rep'r*, 487 ; 19 *Pat. Off. Gaz.* 1217.

If the defendants contest the validity of the plaintiff's invention, the injunction will be granted to continue only until the validity of the patent can be determined by a trial at law ; and will be dissolved if such suit is not brought before the next term of the court. *Woodworth v. Edwards*, 3 *Woodb. & M.* 120.

A motion to dissolve an injunction will not be heard on the same evidence on which it was granted, nor upon new evidence which defendant, without good excuse neglected to offer before ; though upon new and material evidence it may be. *Woodworth v. Rogers*, 3 *Woodb. & M.* 135. *S. P., Union Paper Bag Co. v. Newell*, 11 *Blatch.* 549 ; 5 *Pat. Off. Gaz.* 459 ; 1 *Bann. & A. Pat. Cas.* 113.

Where an answer is filed to a bill, denying the validity of the patent, and evidence supporting the answer, *prima facie*, is offered, the injunction will be dissolved, unless the other side file counter-evidence sustaining the validity of the patent. *Ib.* A common injunction is usually dissolved, as a matter of course, on the coming in of an answer denying merits, or a legal title in the plaintiffs, and without any inquiry into the truth of the allegations ; otherwise, of a special injunction. *Ib.*

Unless the proof offered on motion to dissolve an injunction granted on a bill, overcomes the equity of the bill and the evidence supporting it, the motion will be denied. *Sparkman v. Higgins*, 1 *Blatch.* 205 ; 5 *N. Y. Leg. Obs.* 122 ; 6 *Pa. L. J.* 344.

Affidavits filed in support of a motion to dissolve an injunction against infringement, showed that the infringing articles made by

defendant were made under license from the patentee ; it was *held*, that the injunction must be dissolved. *Goodyear v. Bourn*, 3 *Blatchf.* 266.

Defendant will not be allowed to present, on a motion to dissolve an injunction, facts which he might have presented, but did not, in opposing a motion for a preliminary injunction, and in opposing afterward a motion to punish him for a contempt in violating such injunction. *National School Furniture Co. v. Paton*, 16 *Blatchf.* 563 ; 4 *Bann. & A. Pat. Cas.* 432.

The mere failure to join a proper party will not be sufficient ground for dissolving an injunction, where the defendant is using the infringing machine for purposes in respect to which the plaintiff has an exclusive right under his patent. *Bassett v. Malone*, 11 *Fed. Rep'r*, 801.

The fact that the complainant, after obtaining an injunction, parted with all his interest in the patent, was *held* not sufficient ground for dissolving the injunction. *Thompson v. Barry*, 2 *Week. N. of Cas.* 100.

After a final decree establishing an exclusive right to the use of a patent and awarding an injunction to protect it, the injunction will not be suspended while the decree stands unreversed, unless some extraordinary cause outside of the interests of the parties is shown. Public necessity may be a cause for such suspension. *Munson v. New York*, 19 *Fed. Rep'r*, 313 ; 22 *Blatchf.* 45.

Where the bill or affidavits of the complainant did not state with certainty the infringement of the defendant, and the complainant did not swear at the time of the filing of the bill that he believed he was the original and true inventor of the thing patented to him, and the defendant denied on oath the originality, novelty and utility of the invention, the preliminary injunction was dissolved. *Wilson v. Curtius*, 2 *West. L. J.* 511. But in such case the injunction may be revived on further affidavits setting forth the particulars of the infringement complained of, and alleging priority of invention in the patentee. *Ib.*

The suspension of an interlocutory decree, perpetually enjoining the infringement of a patent, until an accounting can be had and a decree entered from which an appeal can be taken, rests in the discretion of the court which granted the decree. *Brown v. Deere*, 6 *Fed. Rep'r*, 487 ; 2 *McCrary*, 425 ; 19 *Pat. Off. Gaz.* 1217.

In a suit for infringement of a patent for a machine the complainant obtained a decree for the profits of the manufacture and

sale by the defendant of machines embodying the patented invention, upon which some money was recovered, and real estate was set off, on execution, in satisfaction of the balance. It was *held*, that this was, *prima facie*, a satisfaction of the decree; and that in a subsequent suit by the same complainant for infringement of his patent by the use of machines purchased from the defendant in the former suit, and for the manufacture and sale, for use of which the complainant had recovered therein, a preliminary injunction should not be continued. *Steam Stone Cutter Co. v. Sheldon*, 21 *Blatchf.* 260.

Injunction restraining employes of inventor of undisclosed process of manufacture from divulging the secret, continued until final hearing. *Salomon v. Hertz*, 2 *Cent. Rep'r*, 18^o

267. *Operation and Effect of Injunctions in Patent Cases.*

Purchasers from an infringer who has been enjoined by a circuit court, cannot be permitted to use the machine purchased in another circuit while the injunction remains in full force. *Woodworth v. Edwards*, 3 *Woodb. & M.* 120.

An injunction in a patent case does not extend beyond the right of the plaintiff, as set up in his bill. *Byam v. Eddy*, 2 *Blatchf.* 521; 24 *Vt.* 666; *Wire Railing Co. v. Walker*, 2 *Fish. Pat. Cas.* 179.

To sell parts of a patented device necessary to its operation but not covered by the patent, does not constitute a new infringement, when they have already been charged in the accountings for the sale of the patented portion. *Buerk v. Imhauser*, 11 *Pat. Off. Gaz.* 112.

The words "perpetual injunction," in a decree, mean only for the life-time of the patent; and that must be determined by the statute and the facts of the case, and not merely by the terms of the patent. *De Florez v. Reynolds*, 8 *Fed. Rep'r*, 434; 17 *Blatchf.* 436; 17 *Pat. Off. Gaz.* 503; 5 *Bann. & A. Pat. Cas.* 140.

The sending of circulars by complainants to parties engaged in the trade, notifying them of a preliminary injunction, is improper. *Wilson Packing Co. v. Clapp*, 8 *Biss.* 154; 13 *Pat. Off. Gaz.* 368.

A decree for a perpetual injunction is not final where it also

directs a reference to ascertain the damages by reason of the infringement. *Barnard v. Gibson*, 7 *How.* 650.

268. *Violation of Injunctions, in Patent Cases.*

Where a person had been enjoined not to use a machine substantially like the one mentioned in the complainant's bill, it was held, that he was chargeable with a contempt, by the purchase and use of a machine which had been enjoined in another circuit as being substantially like the plaintiff's. *Woodworth v. Rogers*, 3 *Woodb. & M.* 135.

To supply an infringing device after service of an injunction is a violation, although done pursuant to a contract made before. *Colgate v. Gold, &c. Tel. Co.*, 17 *Pat. Off. Gaz.* 193 ; 4 *Bann. & A. Pat. Cas.* 559 ; *Colgate v. Western Union Tel. Co.*, 17 *Pat. Off. Gaz.* 195 ; 4 *Bann. & A. Pat. Cas.* 562.

An injunction founded upon consent, enjoining the use of a patented invention, is not necessarily deprived of vitality by the granting of a conditional license. But an attachment will not be issued for the violation of such injunction while the license itself is in litigation. *Pentlarge v. Beeston*, 1 *Fed. Rep'r*, 862 ; 18 *Blatchf.* 38 ; 9 *Rep'r*, 774 ; 5 *Bann. & A. Pat. Cas.* 326.

One who has been enjoined from infringing a patent and who continues to sell, is equally guilty of a contempt and liable to attachment, whether he sells in his own right or as agent for another. *Potter v. Muller*, 1 *Bond*, 601 ; 2 *Fish. Pat. Cas.* 631.

It is no excuse for the violation of a preliminary injunction that the patent is invalid. *Phillips v. Detroit*, 16 *Pat. Off. Gaz.* 627.

Where an injunction has been issued restraining a defendant from using patented parts of a machine, he is not at liberty to use his own judgment as to which parts are infringements, and continue the use of the remainder of the machine. *Hamilton v. Simons*, 5 *Biss.* 77.

The fact that several persons are acting in concert in the use of an infringed article as the stockholders, managers and servants of a corporation does not exempt them from the restraints of an injunction. *Poppenhusen v. Falke*, 4 *Blatchf.* 493 ; 2 *Fish. Pat. Cas.* 181. So of the fact that the person committing the acts of infringement is minor son of defendant. *Dunks v. Grey*, 3 *Fed. Rep'r*, 862 ; 10 *Rep'r*, 721 ; 5 *Bann. & A. Pat. Cas.* 634.

A sale of a patent after suit brought, but before injunction issued, is not a contempt. *United States v. Day*, 6 *Am. L. Reg.* 632.

Injunction may be violated by selling outside the territorial jurisdiction, although the goods were not sent to purchasers within the jurisdiction. *Macaulay v. White Sewing Machine Co.*, 9 *Fed. Rep'r*, 698 ; 21 *Pat. Off. Gaz.* 496.

Partial use of a thing may be adjudged a contempt of an injunction forbidding use of it. *Matthews v. Spangenberg*, 23 *Pat. Off. Gaz.* 1624 ; 15 *Rep'r*, 813.

The sale and use by defendant of a machine containing a feature not claimed in plaintiff's combination, if not a mere colorable evasion, will not render the defendant liable for violation of an injunction forbidding sale, &c. of that combination ; and the fact that a patent was issued to defendant, subsequent to granting the injunction, affords ground for him to insist that the alteration was not plainly colorable. *Onderdonk v. Fanning*, 2 *Fed. Rep'r*, 568 ; 9 *Rep'r*, 737.

The continued infringement of a patent after an interlocutory decree in a suit between the same parties for infringement, constitutes a new cause of action, notwithstanding such continued infringement is also a violation of an injunction awarded by the decree in the former suit. *Roemer v. Neumann*, 23 *Fed. Rep'r*, 447.

269. *Proceedings to Punish a Violation.*

A motion to punish violation of an injunction for an infringement as a contempt, requires clear proof that the infringement is continued. *Smith v. Halkyard*, 19 *Fed. Rep'r*, 602.

Upon a motion to punish a violation of an injunction against infringement as a contempt, such questions as whether the patentee was original inventor, whether the article as sold was an infringement, whether the patent was correctly construed in issuing the injunction, whether the patent was valid ; do not arise. They are foreclosed by the order of injunction, which must be obeyed if the court had jurisdiction to make it. *Whipple v. Hutchinson*, 4 *Blatchf.* 190 ; *Liddle v. Cory*, 7 *Id.* 1 ; *Burnett v. Estey*, 16 *Id.* 105 ; 4 *Bann. & A. Pat. Cas.* 141 ; *Roemer v. Newman*, 19 *Fed. Rep'r*, 98.

The motion to commit for contempt properly involves the ques-

tion whether what defendant has done since the injunction was issued constitutes a contempt; and the plaintiff is entitled to have this question decided on the proofs; the motion should not be denied merely because the court entertains doubt upon it. *Wetherill v. New Jersey Zinc Co.*, 1 *Bann. & A. Pat. Cas.* 105. Whether to determine the question of infringement by inspection or by testimony of experts, is a question of discretion for the court. *Burdett v. Estey*, 16 *Blatchf.* 105; 4 *Bann. & A. Pat. Cas.* 141. The question whether the machine as made by the defendant since the injunction is the same as that enjoined, is one of fact to be determined on the evidence; models first, and testimony of experts next, being the evidence. *Birdsell v. Hagerstown Agric. Imp. Manuf. Co.*, 1 *Hughes*, 59.

Should the proofs show that defendant did not intend disobedience to the order of the court, but acted in good faith, upon the advice of counsel, &c. in the exercise of what he supposed were rights reserved to him under the injunction, the court will not inflict punishment, but will limit its order to payment of plaintiff's actual damages or loss of profits, and costs. *Ready Roofing Co. v. Taylor*, 15 *Blatchf.* 94; 3 *Bann. & A. Pat. Cas.* 368; *Matthews v. Spangenberg*, 15 *Fed. Rep'r*, 813; 23 *Pat. Off. Gaz.* 1624; *Carstaedt v. United States Corset Co.*, 13 *Blatchf.* 371; 10 *Pat. Off. Gaz.* 3; 3 *Bann. & A. Pat. Cas.* 331.

Circumstances arising since or independent of the injunction, rendering it inequitable for the complainant to enforce it,—such as conduct or negotiations on his part which should operate as a release or an estoppel,—may be shown in answer to a motion to attach for contempt, and will induce the court to deny such motion. *Smith v. Patton*, 3 *Pa. L. J. Rep.* 508; 6 *Pa. L. J.* 189.

Attachment for contempt in violating an injunction restraining infringements of a patent, was refused; no sufficient service of notice of motion for the attachment upon any person responsible for the acts complained of being shown. *Bate Refrigerating Co. v. Gillett*, 24 *Fed. Rep'r*, 696; 32 *Pat. Off. Gaz.* 1466.

270. *Enjoining Prosecution of Suits for Infringement.*

Resort to injunction in patent matters is not confined to infringements; there are instances of suits brought by alleged infringers seeking to restrain the prosecution of suits against them.

These cases have not, however, according to the reports, been very frequent, or often successful, especially as respects grants of preliminary injunctions.

Patentees of an improvement in fire-engines having brought a suit against the city of Dover for using infringing engines, the city filed a bill seeking to enjoin the prosecution of that suit; alleging as grounds thereof that the invention covered by the patent had been anticipated, that the city had bought its engines in good faith from the prior inventor, and that the patentees were debarred by laches and estopped from prosecuting their suit. The patentees having filed an answer denying both the anticipation and the laches, &c., it was *held* that the prosecution of the suit could not be enjoined. *City of Concord v. Norton*, 16 *Fed. Rep'r*, 477.

The United States cannot be heard to ask an injunction restraining the commencement or prosecution of suits for infringement of a patent for the repeal of which they have begun an action. *United States v. Colgate*, 22 *Blatchf.* 412; 21 *Fed. Rep'r*, 318.

The circuit court for the southern district of New York, in an infringement suit pending in that district, refused to make an order enjoining or restraining the defendant in that suit from prosecuting suits he had begun in other districts against the plaintiff. *Rumford Chemical Works v. Hecker*, 11 *Blatchf.* 552; 5 *Pat. Off. Gaz.* 664; 5 *Fish. Pat. Cas.* 629.

An injunction should not be granted upon application of a senior patentee to restrain the order of a junior patent alleged to conflict with it, from bringing suits for infringement of his patent; at least until the junior patent has been adjudged invalid. *Asbestos Felting Co. v. United States, &c. Salamander Felting Co.*, 13 *Blatchf.* 453; 10 *Pat. Off. Gaz.* 828; 2 *Bann. & A. Pat. Cas.* 369.

Where a suit is pending against a defendant who is manufacturing and vending an article claimed to be an infringement, and the defendant is responsible for damages and profits, the court in its discretion may enjoin the complainant from bringing other suits against vendees of the defendant, and this although complainant enjoined may not be within the district at the time of the injunction. *Birdsell v. Manuf. Co.*, 1 *Hughes*, 64.

The court, upon a proper showing and in a proper case, in order to avoid a multiplicity of suits, may require the prosecution of suits against mere users and purchasers from the principal infringer to be suspended, and await the determination of the suit pending

between the patentee and the principal infringer ; but the proof should be conclusive that the patented article involved in the suit against the users was purchased of the defendant in the principal suit, and that it is identical in character with that involved in the suit against the principal infringer. *Allis v. Stowell*, 11 *Fed. Rep'r*, 783.

XIX. PLEADINGS ; AT LAW OR IN EQUITY.

271. *Declaration at Law, for Infringement.*

A declaration in an action for damages for infringement is not necessarily bad because it begins in trespass on the case and ends in debt ; nor because it claims for successive, distinct infringements of the same patent ; nor because it avers the patent to be in language of the *import* (instead of *tenor*), following, setting it out in words and figures. *Wilder v. McCormick*, 2 *Blatchf.* 31.

If the declaration professes to set forth the specification as a part of the grant, "according to its tenor" the slightest variation, —*e. g.*, using the word "wheel" for "whirl,"—is fatal. *Tyron v. White*, *Pet. C. Ct.* 96.

If the declaration designates the patent by the terms used in the patent, the specification need not be set out in the declaration ; it is matter of evidence on the trial. The defendant can have it put on the record by asking oyer of it. *Gray v. James*, *Pet. C. Ct.* 476. See *Pitts v. Whitman*, 2 *Story*, 609 ; *Cutting v. Myers*, 4 *Wash.* 220.

A statement of the plaintiff's patent and a general allegation that the defendant has infringed are sufficient to put the defendant upon answer ; and proof of an infringement of one of several claims in the patent, without proving an infringement of all, will sustain the suit. *Thatcher Heating Co. v. Carbon Stove Co.*, 15 *Pat. Off. Gaz.* 1051 ; 7 *Rep'r*, 199 ; 4 *Bann. & A. Pat. Cus.* 68 ; 2 *N. J. L. J.* 25.

A declaration in a patent suit which shows that the plaintiff has partial interest, only, in the patent is demurrable. *Suydam v. Day*, 2 *Blatchf.* 20. But where the declaration did not aver that the

plaintiff *had* a patent, but that he *claimed* a patent, and that the defendant enjoyed the right, it was *held*, that, although the objection would have been fatal on general demurrer, yet, after verdict, the court would presume that the facts showing the right were proved at the trial; and it therefore would not arrest judgment. *Stanley v. Whipple*, 2 *McLean*, 35.

The declaration for an infringement of a patent need not aver the specific date of the invention; this is immaterial; it must tender an issue upon the novelty and utility of the discovery patented; but it need not aver the regularity of the preliminary proceedings in the issue of the patent. *Wilder v. McCormick*, 2 *Blatchf.* 31.

Where titles to the original patent and an improvement on it are united in the same person, they constitute an entire right, and must be asserted as such in the declaration in an action for infringement; damages cannot be claimed separately for infringements of them. *Case v. Redfield*, 4 *McLean*, 526.

The declaration for infringement of an improvement must set out in what the improvement consists. *Peterson v. Wooden*, 3 *McLean*, 248.

The declaration need not set out in what or by what means the defendant has infringed; averring that the defendant had made, constructed, used and sold the thing patented is enough. *Case v. Redfield*, 4 *McLean*, 526. So is averring that the defendant has made the thing "in imitation of the plaintiff's patent." *Parker v. Haworth*, 4 *McLean*, 370.

The declaration need not state that the stages preliminary to the issuance of the patent were observed, but it must set up the attestation of the President of the United States, and that the patent was delivered. *Cutting v. Fulton*, 4 *Wash.* 220.

Averment that defendant's acts were done "contrary to the statute," is not necessary in an action for infringement, but only in an action brought on a penal statute. *Parker v. Haworth*, 4 *McLean*, 370. S. P., *Tryon v. White*, *Pet. Ct.* 96.

The state of the art and steps which have been taken by the patentee or others are a necessary part of the testimony, and proper averments in a bill, and it is also proper to recite the prior litigation over the same patent. *Steam Gauge & Lantern Co. v. McRoberts*, 36 *Pat. Off. Gaz.* 822.

272. *Plea, or Answer, at Law.*

When an abandonment is relied on, it should be not only stated in the plea, but the facts on which the pleader relies as showing an abandonment should be stated. *Root v. Ball*, 4 *McLean*, 177.

A plea of prior use or sale should aver that it took place more than two years before the application for the patent ; such at least was the rule under the act of 1839, § 7. *Root v. Ball*, 4 *McLean*, 177.

Where, in an action for infringement, no plea or answer is put in, the charge in the declaration is considered as admitted. *Parker v. Banker*, 6 *McLean*, 631.

A special plea that the selling alleged in the declaration, if any such was done, was made by defendant solely as agent and not for his own profit, was *held* bad on special demurrer, because hypothetical, and because it did not state the name of the person for whom the defendant claimed to have acted as agent. *Morse v. Davis*, 5 *Blatchf.* 40.

In order to rely upon a defect of title as a defense under the New York Code, it must be pleaded. *Hobbie v. Smith*, 27 *Fed. Rep'r*, 656.

By taking issue upon a plea its sufficiency is admitted in point of form and substance, and the truth of the facts therein having been established, defendants are entitled to judgment. *Birdseye v. Heilner*, 26 *Fed. Rep'r*, 147.

The proper mode of pleading special matter in defense to an action for infringement of a patent, is considered with reference to the practice under the Oregon Code, in *Cottier v. Stimson*, 9 *Sawyer*, 435 ; 10 *Sawyer*, 212 ; 18 *Fed. Rep'r*, 689 ; 20 *Fed. Rep'r*, 906

273. *Necessity and Uses of Notice Additional to the General Issue.*

The defenses authorized by section 15 of the act of 1836 to be proved under a notice accompanying a plea of the general issue are not required to be set up in that manner. The defendant may, if he prefers, plead specially, setting up the matters of which he

could give notice. The right to plead the general issue and give notice is an enlargement of the defendant's mode of defense; it does not take away the privilege of a special plea. *Wilder v. Gayler*, 1 *Blatchf.* 597; *Day v. New England Car Spring Co.*, 3 *Blatchf.* 179; *Read v. Miller*, 3 *Fish. Pat. Cas.* 310; 2 *Biss.* 12; *Phillips v. Comstock*, 4 *McLean*, 525; *Root v. Davis*, *Id.* 370; *Cottier v. Stimson*, 18 *Fed. Rep'r*, 689.

To entitle a defendant to contest on the trial the novelty of plaintiff's invention under the general issue, he must serve a notice in compliance with the statute. If he fails to do so he cannot introduce evidence to controvert the presumption of novelty deducible from the production of a patent on the part of a plaintiff. *Blanchard v. Putnam*, 8 *Wall.* 420; *rev'g* 2 *Bond*, 84; 3 *Fish. Pat. Cas.* 186. See *Judson v. Bradford*, 16 *Pat. Off. Gaz.* 171; 3 *Bann. & A. Pat. Cas.* 539; *La Baw v. Hawkins*, 6 *Pat. Off. Gaz.* 724; 1 *Bann. & A. Pat. Cas.* 428; *Root v. Ball*, 4 *McLean*, 177; *Westlake v. Carter*, 4 *Pat. Off. Gaz.* 636; 6 *Fish. Pat. Cas.* 519; *Pickering v. Phillips*, 10 *Pat. Off. Gaz.* 420; 4 *Cliff.* 383; 2 *Bann. & A. Pat. Cas.* 417; *Bragg v. City of Stockton*, 27 *Fed. Rep'r*, 509.

Evidence of what is old and was in general use at the time of an alleged invention is admissible in actions at law under the general issue, and in equity cases, without any particular averment in the answer. *Brown v. Piper*, 91 *U. S.* 37.

Persons sued for infringement may, on complying with the statutory condition as to notice, give the special defenses mentioned in the patent act in evidence under the general issue; or in a suit in equity, such notice may be given in the answer; and if any one of those defenses is proved, the judgment or decree must be in favor of the defending party, with costs. But in a case where the invention consists in a combination of old elements incapable of division or separate use, such defenses must be addressed to the entire invention and not merely to separate parts of the thing patented. *Bates v. Coe*, 98 *U. S.* 31. S. P., somewhat more fully. *Parks v. Booth*, 102 *U. S.* 96; *aff'g* 1 *Flippin*, 381; 1 *Bann. & A. Pat. Cas.* 225.

Evidence on the part of the defendant as to whether the machine used by him is like the model of plaintiff's machine, produced in court, is proper under the general issue; no notice is necessary. *Evans v. Hettich*, 7 *Wheat.* 453, 469; *aff'g* 3 *Wash.* 408.

Notice is not necessary to warrant the introduction of evidence of the state of the art to which the plaintiff's invention belongs, at the alleged date of his invention. *Vance v. Campbell*, 1 *Black*, 427; rev'g 1 *Fish. Pat. Cas.* 483. S. P., *La Baw v. Hawkins*, 6 *Pat. Off. Gaz.* 724; 1 *Bann. & A. Pat. Cas.* 428; *Westlake v. Carter*, 4 *Pat. Off. Gaz.* 636; 6 *Fish. Pat. Cas.* 519.

Where no question is made by the pleadings as to the novelty and originality of the invention, and the prior use relied on in defense is a use by the inventor or under his license, notice of the persons using the invention, or of the places where it was used, is not required. *American Hide, &c. Dressing Machine Co. v. American Tool, &c. Co.*, 1 *Holmes*, 503; 4 *Fish. Pat. Cas.* 284.

The statute does not enumerate all the defenses of which the defendant may avail himself. Others are allowable; such as a denial of infringement; an averment of a license. *Whittemore v. Cutter*, 1 *Gall.* 429, 435.

Evidence, taken under objection that no notice was given of it in the answer, will not be received because the answer is afterward amended so as to include such a notice. *Roberts v. Blake*, 3 *Pat. Off. Gaz.* 268.

The rule is that if the thing patented is an entirety, the statutory defenses must be addressed to the invention itself, not merely to some one or more of its features. This does not prevent each patent in suit, or each invention contained in it, as set forth in the distinct claims, from being made the subject of separate pleas in defense. *Kelleher v. Darling*, 14 *Pat. Off. Gaz.* 673; 4 *Cliff.* 424. S. P., *Parks v. Booth*, 102 *U. S.* 96; aff'g 1 *Flippin*, 381; 1 *Bann. & A. Pat. Cas.* 225.

All the defenses which the statute authorizes may be made as well in respect to patents granted upon renewed applications under Rev. Stat. § 4897, as in respect to those issued upon original applications. *United States Rifle, &c. Co. v. Whitney Arms Co.*, 11 *Pat. Off. Gaz.* 373; 14 *Blatchf.* 94; 2 *Bann. & A. Pat. Cas.* 493.

Where the defense to an action for infringement is, that the plaintiff is not the original inventor, defendant is not forbidden to prove former use by certain persons because he specified other persons in his notice. *Evans v. Kremer*, *Pet. C. Ct.* 215; *Treadwell v. Bladen*, 4 *Wash.* 703.

274. *Requisites and Sufficiency of such Notice.*

No order of court is necessary to entitle a defendant to serve and file the notice of special matter; it may be given after the depositions relied on have been filed in court; and if at first defective, or not sufficiently comprehensive, the defendant may give another. All that is required is a notice in writing, served thirty days before trial. *Teese v. Huntingdon*, 23 *How.* 2.

A mere general reference, in a notice of special matter accompanying the general issue, to an entire and large volume, such as "Ure's Dictionary of Arts, Manufactures, and Mines,"—in which an invention has been described, is not sufficient notice. There must be a more particular reference to the parts relied on, either by pages, titles, or otherwise. Nor can such book, under such a notice, be introduced as "evidence of prior knowledge and use, by said Ure," because the notice does not state at what places the thing was used. *Silsby v. Foote*, 14 *How.* 218; *aff'g* 1 *Blatchf.* 445

A notice under the act of 1836, § 15, in a suit for infringing a patent for mill-stones, which states the names and residences of the witnesses, is sufficiently particular; the particular mill in which the stones were used need not be designated. *Wise v. Allis*, 9 *Wall.* 737.

The true construction of the act, is that the names of those only who invented or used the anticipating machine or improvement, not the names of those who are to testify as to its invention or use, must be pleaded; this is enough to protect a patentee against surprise. *Wilton v. Railroads*, 1 *Wall. Jr.* 192; *Planing Machine Co. v. Keith*, 101 *U. S.* 479; *Judson v. Bradford*, 16 *Pat. Off. Gaz.* 171; 3 *Bann. & A. Pat. Cas.* 539; *Many v. Jagger*, 1 *Blatchf.* 372. Compare *Judson v. Cope*, 1 *Fish. Pat. Cas.* 616; 1 *Bond*, 327.

Notice specifying certain mining establishments where defendant will show the invention to have been in use is sufficient compliance with the requirement as to specifying places and persons. *Smith v. Frazer*, 2 *Pat. Off. Gaz.* 174; 5 *Fish. Pat. Cas.* 543; 3 *Pittsb.* 397.

Where an answer relies on a previous use of the invention, and witnesses are examined to sustain the defense without objection by the complainant, he cannot afterward have their testimony struck out for want of the notice of their residences required by Rev. Stat. § 4920. *Lock v. Pennsylvania R. R. Co.*, 1 *N. J. L. J.* 227.

275. *Reception of Evidence under It.*

Under a notice of evidence that the machine had been in use in various places in the United States, evidence cannot be given of a prior use in England. *Dixon v. Moyer*, 4 *Wash.* 68.

The act of 1836 did not make the "public work" mentioned in the notice evidence of any other fact than that such description of the improvement was published; statements in such book, that the machine described was operated successfully in specified years will not authorize the jury to infer that it was in operation during the intermediate time. *Seymour v. McCormick*, 19 *How.* 96; aff'g 3 *Blatchf.* 209.

Where a defendant gives notice of a prior use of the invention in suit by a specified person, he is not obliged to call that person, but may prove the fact by another. *Planing Machine Co. v. Keith*, 101 *U. S.* 479, 492; *Many v. Jagger*, 1 *Blatchf.* 376.

Objection that witnesses produced to show a prior use of the invention were not named in the notice must be made when the testimony is taken, otherwise it will be disregarded. *Roemer v. Simm*, 5 *Pat. Off. Gaz.* 555.

Where no notice of prior use has been given, and it has not been set up in the answer, testimony taken, under objection, before a commissioner, will be rejected by the court. *Bragg v. City of Stockton*, 27 *Fed. Rep'r*, 509.

276. *Bill in Equity for Infringement.*

In a suit for infringement of a patent, an allegation in the complaint, of the residence of the parties, is not necessary to impart jurisdiction. *Teese v. Phelps*, *McAll.* 17.

Where the bill shows that defendant resides in another district, the marshal's return of service must show affirmatively that the subpoena was served within the district in which the suit is brought, to give the court jurisdiction; unless there is a voluntary appearance, which is a submission to the jurisdiction, and will cure the defect. *Thayer v. Wales*, 5 *Fish. Pat. Cas.* 448.

The bill itself, or an affidavit accompanying it on the motion for a preliminary injunction, must contain an averment that the complainant (if the patentee), was the inventor; the usual oath in

making application for the patent, to the originality of the invention will not supply the place. *Sullivan v. Redfield*, 1 *Paine*, 441. To same effect, *Rogers v. Abbott*, 4 *Wash.* 514.

The bill should set forth that, after the issuing of the patent, the complainant had put his invention into use, or had sold the same for a valuable consideration, and is, at the time of the filing of the bill, in the exclusive possession of such patent. *Isaacs v. Cooper*, 4 *Wash.* 259.

Where a patent is void on its face for want of novelty, a bill in a suit for infringement may be dismissed without regard to the answer. *Quirolo v. Ardito*, 1 *Fed. Rep'r*, 610 ; 17 *Blatchf.* 400 ; 5 *Bann. & A. Pat. Cas.* 80.

Allegations, in a bill of equity for infringement of a patent, describing prior patents to the same inventor involving the same principle, upon exceptions to them as immaterial and impertinent, were *held* proper as showing the the history of the invention. *Steam-guage & Lantern Co. v. McRoberts*, 26 *Fed. Rep'r*, 765.

It is not necessary to allege, in a bill for the infringement of a patent for a machine, what articles were made by the use of the machine, in addition to the fact that it was used. *Fischer v. Hayes*, 6 *Fed. Rep'r*, 76 ; 19 *Blatchf.* 26.

The bill need not specify the particulars of the infringement ; a general charge of infringement is all that is necessary to require the defendant to answer the bill. *Turrell v. Cammerer*, 3 *Fish. Pat. Cas.* 462 ; *Haven v. Brown*, 6 *Ill.* 413.

Infringement must be shown to have occurred prior to filing the bill therefor. *Slessinger v. Buckingham*, 17 *Fed. Rep'r*, 454 ; 8 *Sawyer*, 469.

The bill need not contain an express prayer for damages ; they are recoverable under the prayer for general relief. *Emerson v. Simm*, 3 *Pat. Off. Gaz.* 293 ; 6 *Fish. Pat. Cas.* 281.

A bill in equity for infringement of a reissued patent need not aver, specifically, the ground on which the original patent was surrendered and the reissue obtained ; nor need it allege facts to show that the commissioner of patents had jurisdiction to entertain the application. *Spaeth v. Barney*, 22 *Fed. Rep'r*, 828 ; 30 *Pat. Off. Gaz.* 997.

An assignee of a patent need not aver in his bill the recording of the instrument, but may treat the defendant as a wrongdoer, and put him to set up in his answer that he is a *bona fide* purchaser for value without notice. *Perry v. Corning*, 7 *Blatchf.* 195.

A bill for infringement filed by the assignee of a patent, set forth the infringement as having occurred while the patent was owned by the assignor, the assignment of "all the right, interest and claim for and to the past use of said invention," and prayed for an injunction and an accounting, and for "such other and further relief as shall be agreeable to equity." This was *held* sufficient to entitle complainant to recover for infringement before as well as after the assignment to him. *Campbell v. James*, 2 *Fed. Rep'r*, 338; 18 *Blatchf.* 92; 18 *Pat. Off. Gaz.* 1111; 10 *Rep'r*, 103; 5 *Bann. & A. Pat. Cas.* 354. See also, 5 *Fed. Rep'r*, 806; 10 *Rep'r*, 686.

It is unnecessary to set up in a bill, the various facts from which complainant's title may be deduced; a simple averment that the title was vested in the plaintiff is sufficient. *Nourse v. Allen*, 4 *Blatchf.* 376; 3 *Fish. Pat. Cas.* 63.

277. Multifariousness in such Bills.

A bill is not necessarily obnoxious to the charge of multifariousness because the suit is brought upon more than one patent. Courts encourage this to avoid multiplicity of suits, but in such cases the bill must allege and the proof show that the inventions embraced in several patents are capable of conjoint use and are so used by defendants. *Lilliendahl v. Detwiller*, 18 *Fed. Rep'r*, 176; 16 *Rep'r*, 775.

When a bill in equity alleges infringements of several patents for different inventions, to escape the objection of multifariousness it must aver that the inventions are capable of conjoint use, and that they are in fact so used by the defendant. *Barney v. Peck*, 16 *Fed. Rep'r*, 413; 15 *Rep'r*, 548; 24 *Pat. Off. Gaz.* 101. *S. P.*, *Gamewell Fire Alarm Tel. Co. v. Chillicothe*, 7 *Fed. Rep'r*, 351; *Gillespie v. Cummings*, 3 *Sawyer*, 259; 1 *Bann. & A. Pat. Cas.* 587; *Nourse v. Allen*, 4 *Blatchf.* 376; 3 *Fish. Pat. Cas.* 63; *Shickle v. South St. Louis Foundry Co.*, 22 *Fed. Rep'r*, 105; *Pope Manuf. Co. v. Marqua*, 15 *Fed. Rep'r*, 400.

A bill can not be brought for the infringement of distinct patents which are not capable of being used together in making a single structure. *Hayes v. Dayton*, 8 *Fed. Rep'r*, 702; 18 *Blatchf.* 420; 18 *Pat. Off. Gaz.* 1406; 10 *Rep'r*, 802; *Hayes v. Bickelhaupt*, 19 *Pat. Off. Gaz.* 177; *Barney v. Peck*, 24 *Pat. Off. Gaz.* 101; *S. C.*, 16 *Fed. Rep'r*, 413.

Upon the alleged infringement of five distinct patents by the use of one machine, each invention being capable of separate use, it was *held* that the trial of the validity and infringement of each must be upon separate issues, and that a bill uniting the cause was multifarious. *Consolidated Electric Light Co. v. Brush-Swan Electric Light Co.*, 20 *Fed. Rep'r*, 502 ; 22 *Blatchf.* 206 ; 28 *Pat. Off. Gaz.* 544.

A bill brought by a patentee to recover profits and damages for an alleged infringement of thirty-eight claims in six different patents, is demurrable on the ground of multifariousness, where there is nothing in the bill to show that any two or more of the patents are in fact, or are capable of being, used in making a single structure, and where the defendant would be prejudiced by being compelled to defend himself in one suit against so many alleged causes of action. *Hayes v. Dayton*, 8 *Fed. Rep'r*, 702 ; 18 *Blatchf.* 420 ; 18 *Pat. Off. Gaz.* 1406 ; 10 *Rep'r*, 802.

Where suit is brought for the infringement of several patents for different improvements not necessarily embodied in the construction and operation of any one machine, the bill must contain an explicit averment that the infringing machines contain all the improvements embraced in the several patents, or it will be bad for multifariousness. *Nellis v. McLanahan*, 6 *Wish. Pat. Cas.* 286.

A bill which, under Rev. Stat. § 4918, prays an adjudication concerning conflicting patents, and also alleges an infringement of the plaintiff's patent by the defendant, and prays an accounting and damages, is not demurrable for misjoinder of causes of action. *Leach v. Chandler*, 18 *Fed. Rep'r*, 262.

Where the right to both patents alleged to be infringed, for the State of California, has been assigned to complainant, the bill is not bad for multifariousness because the assignment of one of the patents also embraces other territory than the State of California. *Gillespie v. Cummings*, 3 *Sawyer*, 259 ; 1 *Bunn. & A. Pat. Cas.* 587.

A bill in equity against a corporation and its assignee under a State insolvent law, alleged the making of such assignment infringement of complainant's patent by the corporation, and by the assignee after the assignment to him, and that he was threatening to distribute to the creditors of the corporation the moneys realized by him from its property and assets ; and prayed an injunction, an accounting of profits, damages, &c. It was *held* that the bill was not multifarious ; and that the jurisdiction of the circuit court to

entertain the suit was not affected by the insolvent law of the State. *Gordon v. St. Paul Harvester Works*, 23 *Fed. Rep'r*, 147.

273. *What Faults in such Bills may be Reached by Demurrer.*

As to all merely formal defects in the bill, the objection must be taken by way of demurrer. *Pelham v. Edelmyer*, 25 *Pat. Off. Gaz.* 292 ; 15 *Fed. Rep'r*, 262 ; 21 *Blatchf.* 188.

In a suit for infringement of a patent, a demurrer to the complaint on the ground that it did not state where the complainant, a corporation, was located or did business, was overruled. *National Hay-rake Co. v. Herbert*, 2 *Week. N. of Cas.* 100.

If one who has no interest in the subject-matter of the suit, or in the relief prayed, be joined as a party complainant, the defect may be reached by a general demurrer for want of equity. *Hodge v. Northern Missouri & Iron Mt. R. R. Co.*, 1 *Dill.* 104 ; 4 *Fish. Pat. Cas.* 161.

A bill in equity, based on two patents, which alleged that the defendant was using machines containing, in one and the same apparatus, the inventions secured by each of the two patents, was sustained on demurrer. *Horman Patent Manuf. Co. v. Brooklyn City R. R. Co.*, 15 *Blatchf.* 444 ; 4 *Bann. & A. Pat. Cas.* 86 ; 7 *Rep'r*, 295.

A bill in equity for the infringement of a patent alleged that the complainant "was the true, original and first inventor of a certain new and useful improved application of steam power to the capstans of vessels, not known or used before," and made profert of his letters-patent and the specifications thereto annexed ; and further alleged "that the defendant is now constructing, using and selling steam power capstans for vessels, in some parts thereof substantially the same in construction and operation as in the said letters-patent mentioned." It was *held*, upon demurrer to the bill, that it sufficiently described the patent and alleged infringement of it. *McMillin v. St. Louis & Mississippi Valley Transp. Co.*, 5 *McCrory*, 561 ; 18 *Fed. Rep'r*, 260.

A bill in equity for injunction and an accounting, alleged that one of the defendants made a machine infringing complainant's patent, and sold it to the other defendant, who had ever since used it and still continued to use it ; but it appeared that the machine

was made more than three years before the complaint was filed, and there was no claim of any threat to repeat the wrongful act; and it also appeared that the extent of the injury to complainants from the use of the machine was a suitable license fee. It was *held*, on demurrer, that there was an adequate remedy at law, and no ground of equity jurisdiction. *Smith v. Sands*, 24 *Fed. Rep'r*, 470; 32 *Pat. Off. Gaz.* 1467.

Upon a bill in the usual form for infringement, a demurrer on the sole ground that the complainant is not entitled to equitable relief, should not be sustained, where there is nothing in the bill to indicate laches on the part of the complainant, or that he has granted or intends to grant licenses, or that a money judgment for damages alone will indemnify him, or that ultimately an injunction should not issue for his protection. *Brick v. Staten Island R. Co.*, 25 *Fed. Rep'r*, 553.

A bill in equity alleged the invention of a new and original design for a curtain and loop, and that letters patent therefor, of a specified number and date were granted and delivered to the inventor, and contained the usual averments in regard to the execution of the letters patent; but no other description of the invention was given, and no reference was made to the patent for a further description. It was *held*, upon demurrer, that the bill did not sufficiently describe the invention as patented. *Post v. T. C. Richards Hardware Co.*, 25 *Fed. Rep'r*, 905.

Where it appears from a bill founded on a reissue patent that the sole object of the reissue was to enlarge and expand the claims of the original patent; and that a delay of more than two or more years took place in applying for the reissue, which is not explained by special circumstances showing it to be reasonable, a general demurrer lies to the bill for want of equity. The decision of the patent-office as to the reasonableness of the delay is not conclusive. And the delay being *prima facie* unlawful, the party seeking to establish the jurisdiction of the patent-office to grant the reissue has the burden of proving the facts on which it rests. *Wollensak v. Reiher*, 22 *Fed. Rep'r*, 651; *aff'd*, 115 *U. S.* 96.

A bill which, under section 9818 Revised Statutes, upon proper averments prays an adjudication concerning conflicting patents and also alleges infringement by reason of the manufacture and sale by defendant of articles constructed under his patent, and prays an accounting and damages, is not demurrable for misjoinder of causes of action. *Leach v. Chandler*, 18 *Fed. Rep'r*, 262.

In an action for infringement of patent, an assignment of the patent, profert of which is formally made in the complaint, is for all purposes presented to the court as part of the pleading, and a demurrer for a cause arising therefrom may be sustained as if it appeared upon the face of the complaint. *Bogart v. Hinds*, 25 *Fed. Rep'r*, 484.

279. *Plea, or Answer, in Equity.*

A plea filed in answer to a bill against a single defendant for infringement, which alleged that the sales were not made by defendant alone, but were made by him and another person named in the plea, was held bad, because it failed to allege that such other person was yet living within the jurisdiction of the court. *Good-year v. Toby*, 6 *Blatchf.* 130.

Where, in answer to a bill of complaint for infringement, the defendants filed a plea involving three distinct grounds of defense, such plea was held bad for duplicity. The several matters, although relating in a general way to but a single defense,—viz. : the invalidity of the complainant's patent,—were essentially independent of one another, and by their retention destroyed the very office of the plea, which is to secure singleness in the issue. *Reissner v. Anness*, 12 *Pat. Off. Gaz.* 842 ; 3 *Bann. & A. Pat. Cas.* 148. The general rule is that a plea must not contain more than one defense. It is not limited to one fact ; it may embrace various facts ; but they must all conduce to a single point on which the defendant rests his defense. If there is more than one distinct ground of defense to be urged, the defendant should set the matter forth by way of answer and not of plea. *Ib.*

To a bill for infringement, which by sworn allegations fully vested the court with jurisdiction, the defendant filed a sworn plea which admitted the validity and infringement of the patents, but denied the jurisdiction, as it alleged a right to use the patented processes under a contract emanating from the only complainant in interest, and as such complainant was a citizen of the same State with himself, in the absence of further proof,—the plea was held insufficient. *Lilienthal v. Washburn*, 8 *Fed. Rep'r*, 707.

Ex parte affidavits introduced without notice to complainant, or without tender of affiant for cross-examination, and writings under private signature unauthenticated, are inadmissible upon the hearing of such plea. *Ib.*

Where parties in their answer, as originally filed, to a bill for infringing a patent, admit that they did manufacture and sell the articles alleged to have been patented, the fact thus admitted in the answer must be accepted as established; but the court will, when justice will be promoted, assume that the smallest number of articles consistent with the circumstances, were made. *Jones v. Morehead*, 1 *Wall.* 155.

Where, in a suit for the infringing of letters patent for a combination of old elements or devices, the parts of which are not susceptible of division or separate use, the answer sets up that the complainant is not the first and original inventor, the defense must apply to the combination as an entirety, and not to a part of it, or to one or more of the claims of the letters, if they do not cover the entire invention. *Parks v. Booth*, 102 *U. S.* 96.

An answer to a bill which avers that the defendant will in future, as he has heretofore done, violate the rights secured by the patent as established on the trial at law, unless restrained by injunction, is not sufficient if defendant merely alleges that what he has done since the trial has not been in violation of the plaintiff's rights; but should state distinctly that the defendant does not intend in future to do the specific things which the court has determined he has no right to do. *Poppenhusen v. New York Gutta Percha Comb Co.*, 4 *Blatchf.* 184; 2 *Fish. Pat. Cas.* 74.

The defense that the specification is insufficient is not available unless properly pleaded. *Goodyear v. Providence Rubber Co.*, 2 *Cliff.* 351; 2 *Fish. Pat. Cas.* 499.

Persons charged as infringers may set up the defense that the patentee was not the original and first inventor of the alleged improvement; but, if the suit is in equity, they must allege in the answer the names and places of residence of those whom they intend to prove have possessed the prior knowledge of the thing, and where the same has been used. Such notice is required for the benefit of the complainant to prevent surprise; but an answer does not meet that requirement if it furnishes to the complainant no means of knowing the respondent's theory of the construction of the patent. *Graham v. Mason*, 4 *Cliff.* 88; 5 *Fish. Pat. Cas.* 1. *S. P.*, *Orr v. Merrill*, 1 *Woodb. & M.* 376; *Teese v. Huntington*, 23 *How.* 2, 10.

Unless the answer contains notice of prior patents, or persons by whom, and places where, the patented improvement was known or used before the alleged invention of the patentee, copies of the

drawings of prior patents, and testimony respecting them, are not admissible in evidence, against the complainant's objection, to show that the patentee was not the original and first inventor of the patented improvement. *Earl v. Dexter*, 1 *Holmes*, 412 ; 6 *Pat. Off. Gaz.* 729 ; 1 *Bann. & A. Pat. Cas.* 400.

In suits for infringement the pleadings should be single, clear, and free from evasion, and the issue tendered clear and unconditional. More than one defense may be presented in an answer, but each should be separately and clearly alleged without condition or qualification. *Graham v. Mason*, 4 *Cliff.* 88 ; 5 *Fish. Pat. Cas.* 1. To same effect, *Jordan v. Wallace*, 5 *Fish. Pat. Cas.* 185 ; 8 *Phila.* 165 ; 1 *Leg. Gaz.* 355.

Defenses not set up in the answer will not be considered by the court in rendering its decision. *Howes v. Nute*, 4 *Cliff.* 173 ; *Wonson v. Peterson*, 13 *Pat. Off. Gaz.* 548.

Evidence of what is old and in general use at the time of an alleged invention, is admissible in equity cases without any averment in the answer. *Brown v. Piper*, 9 *U. S.* 37. See also, *Slawson v. Grand St. R'y Co.*, 107 *U. S.* 649.

An averment, in the answer, that a patent "was obtained upon false and fraudulent representations by the plaintiffs, or some of them, made to the commissioner of patents, and is wholly void in law," is too general to raise any traversable issue. *Clark v. Scott*, 5 *Fish. Pat. Cas.* 245 ; 9 *Blatchf.* 301 ; 2 *Pat. Off. Gaz.* 4.

The defense that the patentee had allowed the invention to be in public use or on sale for more than two years before he applied for a patent is distinct from the defense that he had abandoned it to the public, and should not be blended with it in the same pleading. *Jones v. Sewall*, 3 *Cliff.* 563 ; 3 *Pat. Off. Gaz.* 630 ; 6 *Fish. Pat. Cas.* 343.

If defendant wishes to claim that the supposed invention is not new, that defense should be set up in the plea or answer ; otherwise the evidence in support of the defense is not admissible ; but the pleadings need not specify that the subject of the invention is not patentable in its character ; this may be shown under the general issue. *Guidet v. Barber*, 5 *Pat. Off. Gaz.* 149.

The defenses of a prior patent or previous description in a printed publication, specified in Rev. Stat. § 4920, subd. 3, must, in a suit in equity, be set up in an answer and not in a technical plea. *Carrick v. McKesson*, 8 *Fed. Rep'r*, 807 ; 19 *Blatchf.* 369.

In a suit for infringement, a plea which sets up in general terms

the single defense of non-infringement, without answering, will be stricken out on motion. *Sharp v. Reissner*, 9 *Fed. Rep'r*, 445 ; 20 *Blatchf.* 10 ; 20 *Pat. Off. Gaz.* 1161 ; 12 *Rep'r*, 611.

A licensee under a patent cannot, by a plea in bar, raise such issues as are usually made in answer to a suit for infringement. *White v. Lee*, 4 *Fed. Rep'r*, 916.

In an equity suit against a licensee for an account of profits and damages, and for an injunction for infringement of a patent, it is not inconsistent to allege in an answer that respondent was acting under a license, or that the patent was invalid, where the recital or covenants of the instrument do not forbid the setting up of such a defense. *National Manuf. Co. v. Myers*, 7 *Fed. Rep'r*, 355.

Though an answer denying information as to the infringement of a patent, and denying damages, is insufficient, the orator by replying admits its sufficiency, and assumes the burden of proving the infringement. *Wooster v. Muser*, 20 *Fed. Rep'r*, 162 ; 28 *Pat. Off. Gaz.* 286.

An answer which only denies that the defendants used the patented invention "with a full knowledge of the premises mentioned in said bill of complaint, and in violation of the complainant's exclusive right secured by the patent of 1864," is an implied admission of its actual use, and complainant is not required to make any further proof of infringement. *Jordan v. Wallace*, 5 *Fish. Pat. Cas.* 185 ; 8 *Phila.* 165 ; 1 *Leg. Gaz.* 355.

280. *Amended, Supplemental, or Cross Bill.*

The bill having been brought, answered and tried upon the theory that a recovery upon the assigned claims was sought, the assignee of a patent, in a suit against an alleged infringer, was allowed to amend his bill, before the signing of an interlocutory decree, so as to include assigned claims for damages and profits due to mesne assignors. *New York Grape Sugar Co. v. Buffalo Grape Sugar Co.*, 20 *Fed. Rep'r*, 505.

In order to continue an injunction granted on an original patent as to the amended patent, issued upon the surrender of the original patent, a supplemental bill must be filed. *Woodworth v. Stone*, 3 *Story*, 749.

Where a bill in equity was filed in a case of infringement of reissued letters patent, to which answer was made by respondents,

and complainant closed his *prima facie* case by taking proofs, it was held that such complainant would be allowed to file a subsequent bill for infringement of the letters-patent after the filing of the first bill of complaint, and that in such proceedings the testimony taken in the first proceeding, so far as relevant, could be used and considered in the subsequent proceedings. *Turrell v. Spaeth*, 9 *Pat. Off. Gaz.* 1163.

Where the question of priority of invention was put in issue in the original suit, evidence of other alleged anticipations than those set up in that suit is merely cumulative, and is not a ground for granting leave to file a supplemental bill. *Blandy v. Griffith*, 6 *Fish. Pat. Cas.* 434.

Leave to file a supplemental bill, in the nature of a bill of review, after dismissal of the original bill in a suit for infringement, for the purpose of introducing new evidence, was refused, where it was not sufficiently shown that the petitioner could not with reasonable diligence, have obtained the new evidence before the hearing on the original bill, and the new matter was itself not material. *Spill v. Celluloid Manuf. Co.*, 29 *Pat. Off. Gaz.* 773.

A cross-bill is properly filed to establish an equitable title to letters-patent, the legal title to which is in the plaintiff in the original bill filed for an infringement of such patent. *Brandon Manuf. Co. v. Prime*, 14 *Blatchf.* 371 ; 3 *Bann. & A. Pat. Cas.* 191. Where a cross-bill brought for relief as well as defense shows that persons not parties to the original bill are necessary parties to the cross-bill, they may properly be made such. *Ib.*

In a suit against an interfering patentee, under section 4918 of the Revised Statutes, the defendant is not required to file a cross-bill in order to obtain affirmative relief. *Lockwood v. Cleaveland*, 6 *Fed. Rep'r*, 721.

281. *Amended or Supplemental Answer.*

Where, after setting up the defense of prior knowledge and use, and giving the names and residences of witnesses intended to be called to prove the defense, the answer to a bill for infringement alleges that the names and residences of certain other witnesses are unknown to the defendant, and prays leave to insert and set forth in the answer such names and residences when they shall be discovered, such amendment may be allowed, on subsequent discovery

of the facts ; and leave to make it may be granted *nunc pro tunc*. *Roemer v. Simon*, 95 *U. S.* 214.

In view of certain circumstances the court permitted an amendment, at the hearing, of the answer with relation to the notice, *nunc pro tunc* as of the time the answer was filed. *Roberts v. Ryer*, 11 *Blatchf.* 11, 34.

The objection to the omission, in an answer, to set forth the defense of want of novelty with sufficient distinctness ought to be taken by exceptions ; as the answer may be amended under special order. *Graham v. Mason*, 4 *Cliff.* 88 ; 5 *Fish. Pat. Cas.* 1.

Upon a motion to open a decree and amend the answer by setting up the prior issue of a French patent for the same invention, it was *held* that such patent could be admitted only as affecting the question of the duration of the United States patent, and not upon the question of novelty. *De Florez v. Raynolds*, 8 *Fed. Rep'r*, 434 ; 17 *Blatchf.* 436 ; 17 *Pat. Off. Gaz.* 503.

A motion will be denied which was made after reference to a master to amend an answer by setting up a new defense denying the manufacture of the articles alleged to be an infringement of plaintiffs' patent, where the omission was not due to inadvertence or mistake. *Evory v. Candee*, 5 *Bann. & A. Pat. Cas.* 67.

A motion will not be granted for an amendment to answer and commission to take testimony in a foreign country to prove who is the original inventor of a patent, when the affidavits filed by plaintiff show that the answer, if amended as proposed, cannot be sustained by proof. *Hicks v. Otto*, 17 *Fed. Rep'r*, 539.

After answering a bill for infringement, setting up that defendants held an assignment from plaintiffs, the defendants discovered reason to believe that the patent was invalid. It was *held* that they might file a supplemental answer denying the validity of the patent. *Morehead v. Jones*, 3 *Wall. Jr.* 306.

XX. EVIDENCE.

282. *Judicial Notice.*

The courts of the United States, in determining a question whether the production of a particular patented article has involved an exercise of the inventive faculties, may take judicial knowledge of matters of common knowledge, and of things in common use. *Brown v. Piper*, 91 *U. S.* 37; *Terhune v. Phillips*, 99 *U. S.* 592; *King v. Gallun*, 109 *U. S.* 99; *Dunbar v. Myers*, 94 *U. S.* 187; *Slawson v. Railroad Co.*, 107 *U. S.* 649.

283. *Presumptions.*

As a patent is allowed by law to be issued only upon preliminary proofs to be laid before the commissioner, upon the sufficiency of which he is to decide, the fact that a patent has been granted raises a presumption that sufficient proof of the required facts was duly made, and found satisfactory, and that all proceedings upon which he was required to pass were regularly taken. *Philadelphia & Trenton R. R. Co. v. Stimpson*, 14 *Pet.* 448, 458; *Potter v. Holland*, 1 *Fish. Pat. Cas.* 382; 4 *Blatchf.* 238; *Cahoon v. Ring*, 1 *Fish. Pat. Cas.* 397; *Hays v. Sulsor*, *Id.* 532; 1 *Bond*, 279; *Judson v. Moore*, 1 *Bond*, 285; 1 *Fish. Pat. Cas.* 544; *Matthews v. Skates*, *Id.* 602; *Wayne v. Holmes*, 2 *Fish. Pat. Cas.* 20; 1 *Bond*, 27; *Poppenhusen v. N. Y. Gutta Percha Comb Co.*, 2 *Fish. Pat. Cas.* 62; *Hussey v. Whiteley*, *Id.* 120; 1 *Bond*, 407; *Cox v. Griggs* 2 *Fish. Pat. Cas.* 174; 1 *Biss.* 362; *Poppenhusen v. Falke*, 2 *Fish. Pat. Cas.* 181; 5 *Blatchf.* 493; *Clarke Patent Steam, &c. Co. v. Copeland*, 2 *Fish. Pat. Cas.* 221; *Union Sugar Refinery Co. v. Matthiessen*, *Id.* 600; 3 *Cliff.* 639; *Giant Powder Co. v. Safety Nitro Powder Co.*, 19 *Fed. Rep'r*, 509.

This is so even though no recital to such effect appears in the patent. *Gear v. Grosvenor*, 3 *Pat. Off. Gaz.* 380; 1 *Holmes*, 215; 6 *Fish. Pat. Cas.* 314.

And the rule applies to the granting of reissues; the presumption of law being, that the commissioner of patents has done his duty in granting a reissue, thoroughly, faithfully and properly, and the question of its propriety is not open for re-examination,

except on the ground of fraud. *Miller, &c. Manuf. Co. v. Du Brul*, 2 *Bann. & A. Pat. Cas.* 618; 12 *Pat. Off. Gaz.* 351. The reissue is presumed right, and the burden of proving the reverse is on the party alleging the invalidity. *American Middlings Purifier Co. v. Atlantic Milling Co.*, 3 *Bann. & A. Pat. Cas.* 168; *Allen v. Blunt*, 2 *Woodb. & M.* 121, 138; *Stimpson v. Westchester R. R. Co.*, 4 *How.* 380. And where the infringement consists in the defendant's using a machine for which a patent has been issued to him, he should have the benefit of a like presumption in his favor, arising from the official investigation of the originality of his invention, as the plaintiff has by reason of his patent. *Corning v. Burden*, 15 *How.* 252, 271.

But the action of the commissioner in issuing a patent does not preclude one charged with infringing, from impeaching the patent by proof that before it was issued, the patentee had abandoned his invention to the public. *Planing Machine Co. v. Keith*, 101 *U. S.* 479.

Issuing the patent is presumptive evidence of the novelty and utility of the invention, and throws the burden of disproving them upon the defendant. *Alden v. Dewey*, 1 *Story*, 336; 3 *L. Rep'r*, 383. *S. P., Needham v. Washburn*, 4 *Cliff.* 254; 7 *Pat. Off. Gaz.* 649; 1 *Bann. & A. Pat. Cas.* 537; *Storrs v. Howe*, 10 *Pat. Off. Gaz.* 421; 4 *Cliff.* 388; 2 *Bann. & A. Pat. Cas.* 420; *Parker v. Stiles*, 5 *McLean*, 44, 62; 7 *West. L. J.* 168; *Teese v. Phelps*, *McAll.* 48; *Corvallis Fruit Co. v. Curran*, 8 *Fed. Rep'r*, 150; 7 *Sawyer*, 270; 27 *Int. Rev. Rec.* 272. A renewal of the patent strengthens the presumption, though it still may be overthrown. *Ransom v. New York*, 1 *Fish. Pat. Cas.* 252; *Smith v. Plympton*, 4 *West. L. J.* 49.

When the question is as to issuing a preliminary injunction, presumptions of the novelty of a patented invention may arise: 1. From the oath of the patentee that he was the first and original inventor. 2. From the action of the patent-office in granting the patent after full examination. 3. Undisturbed enjoyment of all the benefits of the exclusive rights granted by the patent. 4. Direct adjudications, either at law or in equity, establishing the validity of the patent. 5. Injunctions granted to restrain infringement of the patent. When such grounds exist, courts will not refuse an injunction, or, if granted, will not dissolve it, unless the patent is impeached by the most conclusive evidence. *Hussey v. Whitely*, 1 *Bond*, 407; 2 *Fish. Pat. Cas.* 120.

The issuing of a patent raises a presumption that the patentee, at the time of making his application for a patent, believed himself to be the original inventor or discoverer of the thing patented (*Union Sugar Refinery Co. v. Mathiessen*, 3 *Cliff.* 639 ; 2 *Fish. Pat. Cas.* 600); and this presumption, arising from the oath of the applicant that he believes himself to be the first inventor or discoverer of the thing for which he seeks letters patent, remains until the contrary is proved. *Elizabeth v. Pavement Co.*, 97 *U. S.* 126.

The presumption of patentability arising from the grant of a patent, was *held* not repelled, where the device in question, though common, was shown never to have been used for the purpose patented. *Patterson v. Duff*, 20 *Fed. Rep'r*, 641.

The issue, reissue and extension of a patent, and the fact that it has been sustained in previous suits, create a strong presumption against a defense of want of novelty in the invention. *Jordan v. Dobson*, 2 *Abb. U. S.* 398 ; 7 *Phila.* 533. And see *Tyler v. Crane*, 7 *Fed. Rep'r*, 775 ; 19 *Pat. Off. Gaz.* 128

Inasmuch as letters-patent for an invention are issued upon adjudication of public officer, the presumption is that he adjudicated the facts correctly ; if in due form, they raise a presumption that the person named as inventor is the original and first inventor of what is therein described as the improvement ; and the burden of proof to sustain an opposite conclusion is on the party attacking the patent. *Sands v. Wardwell*, 3 *Cliff.* 277 ; *Union Sugar Refinery Co. v. Mathiessen*, 2 *Fish. Pat. Cas.* 600 ; *Hudson v. Draper*, 4 *Fish. Pat. Cas.* 256 ; 4 *Cliff.* 178 ; *Goodyear Dental Vulcanite Co. v. Gardner*, 3 *Cliff.* 408 ; 5 *Pat. Off. Gaz.* 586 ; 4 *Fish. Pat. Cas.* 224 ; *Storrs v. Howe*, 4 *Cliff.* 388 ; 10 *Pat. Off. Gaz.* 421 ; 2 *Bann. & A. Pat. Cas.* 420 ; *Haskell v. Shoe Machinery Manuf. Co.*, 3 *Bann. & A. Pat. Cas.* 553.

A patentee has a right to rest upon his patent for his invention, till its validity is overthrown ; thus, if there is reasonable doubt as to defendant's claim to priority of invention, the patentee is entitled to the benefit of that doubt. *Crouch v. Spear*, 6 *Pat. Off. Gaz.* 187 ; 1 *Bann. & A. Pat. Cas.* 145 ; *Washburn v. Gould*, 3 *Story*, 122, 142 ; 7 *L. Rep'r*, 276 ; 1 *West. L. J.* 465.

Priority in the construction of a mechanical appliance is ground for a presumption of priority of invention. *Atkinson v. Boardman*, 1 *MacArthur Pat. Cas.* 80 ; *Warner v. Goodyear*, *Id.* 60.

The presumption arising from the letters patent, that the paten-

tee was the original and first inventor, in the absence of the application for the patent, extends back only to the date of the letters patent, and in no case does it extend further back than to the time of the filing of the original application ; when a patentee needs to show that his invention was made prior to the date of his application, he must prove the fact by other sufficient evidence. *Wing v. Richardson*, 2 *Fish. Pat. Cas.* 535 ; 2 *Cliff.* 449. S. P., *Jones v. Sewall*, 6 *Fish. Pat. Cas.* 343 ; 3 *Cliff.* 563 ; 3 *Pat. Off. Gaz.* 630 ; *Union Sugar Refinery Co. v. Mathiessen*, 2 *Fish. Pat. Cas.* 600 ; 3 *Cliff.* 639.

In order to overcome the presumption raised by a patent that the patentee is the first inventor of the article monopolized, it must be shown that there was a prior knowledge of the invention under such circumstances as to give the public a right to continue the use of it. This presumption prevails over a reasonable doubt existing as to the truth of the evidence adduced to impeach the novelty of invention. *Crouch v. Speer*, 6 *Pat. Off. Gaz.* 187 ; 1 *Bann. & A. Pat. Cas.* 145. To same effect, *Patterson v. Duff*, 20 *Fed. Rep'r*, 641 ; *Comstock v. Sandusky Seat Co.*, 3 *Cin. L. Bul.* 73.

The issuance of a patent raises a presumption that the patentee was first inventor ; in other words, the courts presume the decision of the commissioner in favor of the originality of the patentee to be correct. *Donoghe v. Hubbard*, 27 *Fed. Rep'r*, 742 ; *Pitts v. Hall*, 2 *Blatchf.* 229 ; *Rogers v. Beecher*, 3 *Fed. Rep'r*, 639 ; 5 *Bann. & A. Pat. Cas.* 619 ; 18 *Pat. Off. Gaz.* 793 ; *Konold v. Klein*, 5 *Rep'r*, 427 ; *McMillin v. Barclay*, 4 *Brews.* 275 ; 3 *Pittsb.* 377 ; 5 *Fish. Pat. Cas.* 189 ; *Brodie v. Ophir Silver Mining Co.*, 5 *Sawyer*, 608 ; 4 *Fish. Pat. Cas.* 137.

This presumption of originality of invention is not overcome by evidence introduced to impeach novelty, which does not clearly establish that the alleged anticipating device embodied the same construction and mode of operation. *Brady v. Atlantic Works*, 10 *Pat. Off. Gaz.* 702 ; 4 *Cliff.* 408 ; 2 *Bann. & A. Pat. Cas.* 436.

The claim that the patentee was the first inventor of the improvement patented is not defeated by showing the construction of the improvement before the patent issued ; there must be proof that the construction preceded the invention of the patentee ; that is, before the conception of the improvement was applied in practice. *Brodie v. Ophir Silver Mining Co.*, 5 *Sawyer*, 608 ; 4 *Fish. Pat. Cas.* 137.

Clear and satisfactory proof is required to rebut the presump-

tion of priority of invention arising from the issuing of a patent. *Rogers v. Beecher*, 5 *Bann. & A. Pat. Cas.* 619 ; 3 *Fed. Rep'r*, 639 ; 18 *Pat. Off. Gaz.* 793 ; *Konold v. Klein*, 5 *Rep'r*, 427.

When the invention consists of an improvement on an old machine, it may be taken for granted that a practical mechanic is acquainted with the construction of the machine on which the improvement is made. *Ives v. Hamilton*, 92 *U. S.* 426 ; 6 *Fish. Pat. Cas.* 244 ; 1 *Pat. Off. Gaz.* 336.

There is a presumption that any person who takes out a patent will ascertain, so far as possible, from the public records what patents of the same nature have previously been taken out. *Odiorne v. Winkley*, 2 *Gall.* 51.

The presumption of right in a patentee, because of the acquiescence of the public in his claim, is not changed in consequence of the original patent being surrendered on account of its informality. *Orr v. Badger*, 7 *L. Rep'r*, 465 ; 1 *Brunner Col. Cas.* 537.

A presumption of abandonment cannot arise from the sale or use of an invention with the knowledge and consent of the patentee, intermediate the application for a patent, and the grant. *Howe v. Newton*, 2 *Fish. Pat. Cas.* 531.

The patentee must have had such an exclusive possession, as, with his claim and the acquiescence of the public, lays a reasonable foundation for the presumption of the validity of his patent. An unsuccessful attempt to interrupt a possession strengthens the presumption which arises from it. *Sargent v. Seagrave*, 2 *Curt.* 553.

The plaintiff had a patent for a pavement, and had been employed to lay some fourteen miles of it by the authorities of the cities of New York and Brooklyn, during the past four years. This, standing alone, was *held* not sufficient proof of acquiescence to raise a presumption in favor of the validity of the patent. *Guidet v. Palmer*, 10 *Blatchf.* 217 ; 6 *Fish. Pat. Cas.* 82.

The action of the commissioner of patents usually makes a *prima facie* case for or against an application for an interlocutory injunction. *Yuengling v. Johnson*, 1 *Hughes*, 607 ; 3 *Bann. & A. Pat. Cas.* 99.

It is a presumption of law that all mechanics interested in upholding or defeating a patent were fully acquainted with the state of their art when they took out their patent, or when they built their machine. *Crompton v. Knowles*, 7 *Fed. Rep'r*, 199.

When a party claiming an exclusive right to an invention has used it publicly and notoriously, for any considerable length of

time, the public are presumed to have acquiesced in that claim. *American Middlings Purifier Co. v. Christian*, 3 *Bann. & A. Pat. Cas.* 42.

Knowledge by the public of an invention is presumed where the means of such knowledge have existed. *Perkins v. Nashua Card, &c. Co.*, 2 *Fed. Rep'r*, 451 ; 17 *Pat. Off. Gaz.* 1285 ; 10 *Rep'r*, 7 ; 5 *Bann. & A. Pat. Cas.* 395.

There is no obligatory presumption that third persons would have purchased of the patentee what they are shown to have bought of the infringer, in case the latter had not made and sold the thing patented. *Seymour v. McCormick*, 16 *How.* 480 ; rev'g 2 *Blatchf.* 240.

A jury are not authorized in presuming that a machine was in continuous operation for twenty-four years, from the mere facts that it was described in a book in 1829, and was in use in 1853. *Seymour v. McCormick*, 19 *How.* 96.

Patented articles are presumed to be patentably different from those covered by other patents. *Buerk v. Imhauser*, 11 *Pat. Off. Gaz.* 112.

Where a joint application is filed for a patent, the presumption is that the invention is joint, and clear and unequivocal evidence will be required to rebut this presumption. *Gottfried v. Phillip Best Brewing Co.*, 5 *Bann. & A. Pat. Cas.* 4 ; 17 *Pat. Off. Gaz.* 675.

The mere deposit in the patent-office of a model does not raise the inference that the application for a patent was completed at that date. *Draper v. Wattles*, 16 *Pat. Off. Gaz.* 629 ; 3 *Bann. & A. Pat. Cas.* 618.

In a suit for infringement, the patentee will be presumed to be still the owner, where no assignment has been alleged or proved. *Fischer v. Neil*, 6 *Fed. Rep'r*, 89 ; 19 *Pat. Off. Gaz.* 603.

The fact of the granting of a patent has no tendency to show that the invention described in it does not infringe a prior patent ; and the decision of the patent-office, on a question of interference between the two, is evidence of such fact on a motion for injunction. *Holliday v. Pickhardt*, 12 *Fed. Rep'r*, 147 ; 22 *Pat. Off. Gaz.* 420.

Where a patentee is in the employ of another, and uses the latter's tools and materials in perfecting his inventions, and such other person uses such inventions for a number of years without payment of royalty, a special license will be presumed. *Jencks v. Langdon Mills*, 27 *Fed. Rep'r*, 622.

284. *Burden of Proof.*

The burden is on the defendant to show that the proper notice has been given under the statute to enable him to examine witnesses to prove that the invention of the plaintiff had been known or used before his invention. *Philadelphia & Trenton R. R. Co. v. Stimpson*, 14 *Pet.* 448 ; *Id.*, Banks' ed. *note*.

In order to avoid liability for profits, made by an infringer who uses an article patented as an entirety or product, the burden is upon him to show that a portion of these profits is the result of some other thing used by him. *Elizabeth v. Pavement Co.*, 57 *U. S.* 126. But compare *Fitch v. Bragg*, 16 *Fed. Rep'r*, 243 ; 21 *Blatchf.* 302.

In a suit for infringement of a patent for an improvement and not for an entirely new machine or contrivance, the burden rests upon the patentee to show in what particulars his improvement has added to the usefulness of the machine or contrivance, and he must separate its results distinctly from those of the other parts, so that the benefits derived may be distinctly seen and appreciated. *Garretson v. Clark*, 111 *U. S.* 120 ; *aff'g* 15 *Blatchf.* 70 ; 14 *Pat. Off. Gaz.* 485.

Upon the question whether what has been done by the defendant amounts to infringement, the complainant universally has the burden of proof ; he must show satisfactorily that his right has been violated. *Washburn v. Gould*, 3 *Story*, 122 ; 7 *L. Rep'r*, 276 ; 1 *West. L. J.* 465 ; *Graham v. Mason*, 4 *Cliff.* 88 ; 5 *Fish. Pat. Cas.* 1 ; *Hudson v. Draper*, 4 *Cliff.* 178 ; 4 *Fish. Pat. Cas.* 256 ; *Storrs v. Howe*, 4 *Cliff.* 388 ; 10 *Pat. Off. Gaz.* 421 ; 2 *Bann. & A. Pat. Cas.* 420 ; *American Middlings Purifier Co. v. Atlantic Milling Co.*, 3 *Bann. & A. Pat. Cas.* 168 ; *Brooks v. Jenkins*, 3 *McLean*, 432, 453 ; *S. C.*, *sub nom.* *Brooks v. Bicknell*, 2 *West. L. J.* 11 ; *Parker v. Stiles*, 5 *McLean*, 44.

Section 7 of the act of 1839,—allowing the use and sale of an invention for two years before the application for a patent,—is in the nature of a statute of limitations ; and the defendant setting up a sale more than two years before must establish the fact of such a sale, in a manner that will justify a jury in taking away the property of the plaintiff. *Hovey v. Henry*, 3 *West. L. J.* 153.

In an action for infringement, if the defendant contests the originality of the invention, the burden of proof is upon him to

show that it was known before the invention of plaintiff. *Hovey v. Henry*, 3 *West. L. J.* 153; *Winans v. New York & Harlem R. R. Co.*, 31 *Jour. Fr. Inst.* (3rd S.) 320; *Brooks v. Jenkins*, 3 *McLean*, 432; S. C., *sub nom.* *Brooks v. Bicknell*, 2 *West L. J.* 11; *Parker v. Stiles*, 5 *McLean*, 44; 7 *West L. J.* 417. To same effect, *Doherty v. Haynes*, 4 *Cliff.* 291; 6 *Pat. Off. Gaz.* 118; 1 *Bann. & A. Pat. Cas.* 289; *Hoe v. Cottrell*, 1 *Fed. Rep'r*, 597; 17 *Blatchf.* 546; 18 *Pat. Off. Gaz.* 59; 5 *Bann. & A. Pat. Cas.* 256; *Worswick Manuf. Co. v. Buffalo*, 20 *Fed. Rep'r*, 126. And see *Parker v. Remhoff*, 17 *Blatchf.* 206; 3 *Bann. & A. Pat. Cas.* 550.

The date of the patent is to be taken, in the absence of other evidence, as the date of invention; and the burden of proof is upon the defendant to show, beyond any fair doubt, prior knowledge and use. *Webster Loom Co. v. Higgins*, 16 *Pat. Off. Gaz.* 675. To same effect, *Eagleton Manuf. Co. v. West, &c. Manuf. Co.*, 2 *Fed. Rep'r*, 774; 18 *Blatchf.* 218; 17 *Pat. Off. Gaz.* 1504; 10 *Rep'r*, 297.

Where an equitable title to an interest in a patent is set up against a *bona fide* purchaser and holder of the legal title, the burden of proof lies upon him who impeaches the legal title. *Gibson v. Cook*, 2 *Blatchf.* 144, 151. Compare *Calais Steamboat Co. v. Scudder*, 2 *Black*, 372.

The burden of proof is on the defendant who alleges a prior sale or use. *Allen v. Blunt*, 2 *Woodb. & M.* 121, 145; *Hide & Leather Co. v. American Tool Co.*, 1 *Holmes*, 503; 4 *Fish. Pat. Cas.* 284; *Roemer v. Sinn*, 5 *Pat. Off. Gaz.* 555.

Power to grant reissued as well as original patents is vested in the commissioner; and, when lawfully exercised, a patent has been duly granted, whether reissued or original, it is, of itself, if introduced in evidence where a party claims redress for alleged infringement, *prima facie* evidence that the patentee is the original and first inventor. Its effect may, however, be overcome by proof that the improvement was previously made by another in this country, or had previously been described in some printed publication, prior to the supposed invention by the patentee. *Judson v. Bradford*, 16 *Pat. Off. Gaz.* 171; 3 *Bann. & A. Pat. Cas.* 539.

Under the act of 1861, § 13,—requiring the word “patented,” with the date when granted, to be affixed to patented articles offered for sale,—the burden of proof is upon the defendant to show that the plaintiff has failed to mark patented, as required, articles made

or sold under a patent, and then the burden is shifted upon the plaintiff to show that defendant had notice that he was infringing. *Goodyear v. Allyn*, 6 *Blatchf.* 33 ; 3 *Fish. Pat. Cas.* 374.

In a case where the application fails to take the date of invention back of the date of the patent, and the defendant shows, beyond a reasonable doubt, knowledge and use before the date of the patent, the burden of proof is shifted on to the plaintiff, to show the date of invention to be prior to the knowledge and use shown by defendant. *Eagleton Manuf. Co. v. West, &c. Manuf. Co.*, 2 *Fed. Rep'r*, 774 ; 18 *Blatchf.* 218 ; 17 *Pat. Off. Gaz.* 1504 ; 10 *Rep'r*, 297 ; *Thayer v. Hart*, 20 *Fed. Rep'r*, 693.

Where the bill alleges that defendant's infringement was without the consent of the plaintiff, which was not specifically denied by the answer or any consent or license alleged, the burden of proof does not rest upon the plaintiff to show want of consent, but upon the defendant to prove consent. *Fischer v. Hayes*, 6 *Fed. Rep'r*, 76 ; 4 *Bann. & A. Pat. Cas.* 317.

The burden is on the plaintiff, in an infringement suit, to prove that defendant's article is like plaintiff's. *Francis v. Mellor*, 4 *Am. L. T. U. S. Cts.* 237 ; 1 *Leg. Gaz. Rep.* 291 ; 8 *Phila.* 157.

The burden is upon the defendant to establish the defense that the invention is not so described as to enable a skillful mechanic to construct a machine. *Brooks v. Jenkins*, 3 *McLean*, 432, 445 ; S. C., *sub nom.* *Brooks v. Bicknell*, 2 *West. L. J.* 11.

In a suit for infringement, the allegation of a license is an affirmative defense, and must be made out by the proof. *Watson v. Smith*, 7 *Fed. Rep'r*, 350 ; 20 *Pat. Off. Gaz.* 300.

Where complainant seeks to recover damages on the basis of an established royalty for the use of several claims, only a part of which have been infringed, the burden of proof is upon him to show the relative value of the claims which have been infringed. *Willimantic Thread Co. v. Clark Thread Co.*, 27 *Fed. Rep'r*, 865.

In an action for infringement of letters patent, where the defendant sets up want of novelty, the burden is on him to establish this defense, and prove the facts set up by him beyond a reasonable doubt. *Cantrell v. Wallick*, 117 *U. S.* 689.

In a suit for infringement of a patent, the burden is upon the defendants to establish a defense of prior knowledge and use beyond a reasonable doubt. *Dreyfus v. Schneider*, 25 *Fed. Rep'r*, 481.

A party asserting, as a defense to a suit for infringement, that

the device covered by the patent has been in public use, or on sale, for more than two years prior to the application for the patent, assumes the burden of proof, and is bound to sustain this defense by clear and convincing testimony. Proof resting wholly in the recollection of persons who claim to have seen or used such prior devices twenty years before they testified, where none of such devices is produced, and it does not appear that more than one of each kind was ever made, is too unreliable to form a safe basis for judicial action. *Adams & Westlake Manuf. Co. v. Rathbone*, 26 *Fed. Rep'r*, 262.

The decision of the patent-office is not conclusive upon the court where priority of invention between interfering patents is in question, but is of sufficient weight to cast the burden of proof upon the party against whom it was rendered. *Wire Book Sewing Machine Co. v. Stevenson*, 11 *Fed. Rep'r*, 155 ; 13 *Rep'r*, 422.

285. *General Rules of Evidence as to the Construction and Validity of the Patent, and Extent of the Right it Confers.*

Evidence is admissible to show the meaning of terms used in letters patent, as well as the state of the art. *Loom Co. v. Higgins*, 105 *U. S.* 580 ; rev'g 15 *Blutchf.* 446 ; 16 *Pat. Off. Gaz.* 675 ; 4 *Bann. & A. Pat. Cas.* 88.

In determining the question as to whether the patentee believed himself to be the first inventor, it is competent for the defendant to show that the patentee knew of the existence of the invention abroad. But in considering whether the patentee did believe himself to be the first inventor, it is material to determine whether he was the first inventor. *Forbush v. Cook*, 10 *L. Rep'r, N. S.* 664 ; 2 *Fish. Pat. Cas.* 668.

The question of novelty is to be settled by a comparison of prior machines with the machine patented, rather than the form of the machine in use. *Blake v. Rawson*, 3 *Biss.* 77 ; 3 *Pat. Off. Gaz.* 122 ; 6 *Fish. Pat. Cas.* 74.

In an action at law, where the issue of novelty is raised, it is not competent to compare prior machines with the one used by defendant ; the only comparison admissible is with that used by the patentee. *Judson v. Cope*, 1 *Bond*, 327 ; 1 *Fish. Pat. Cas.* 615.

Where a patent is assailed for lack of novelty, sketches and drawings may be consulted to fix the date of inceptive invention, and if there has been no unreasonable delay subsequently in adapting the invention and applying for patent, the protection of the patent will be carried back to the date thus established. *Draper v. Potomska Mills Corp.*, 13 *Pat. Off. Gaz.* 276 ; 3 *Bann. & A. Pat. Cas.* 214 ; *Kneeland v. Sheriff*, 2 *Fed. Rep'r*, 901 ; 10 *Rep'r*, 234 ; 18 *Pat. Off. Gaz.* 242 ; 5 *Bann. & A. Pat. Cas.* 482.

The patent itself is *prima facie* evidence that the alleged inventor had made the invention at the date the specification was filed. *Jones v. Sewall*, 3 *Cliff.* 563 ; 3 *Pat. Off. Gaz.* 630 ; 6 *Fish. Pat. Cas.* 343. S. P., *Dane v. Chicago Manuf. Co.*, 3 *Biss.* 380.

Defendants in a suit on a reissue patent, may read the original patent in evidence at the trial, although it may not have been put in evidence before the examiner, in order to show that the reissue is, in fact, for a different invention from the original. *Knapp v. Shaw*, 23 *Pat. Off. Gaz.* 2236 ; 15 *Fed. Rep'r*, 115. S. P., *National Cylinder Co. v. Simmons Hardware Co.*, 18 *Fed. Rep'r*, 324.

Against an allegation that a patentee had abandoned his discovery, the lapse of time from the grant of the patent to the commencement of the action being urged as proof of that fact, he may give evidence of his filing of drawings, or of any other act done by him in assertion of his right. *Emerson v. Hogg*, 2 *Blatchf.* 1.

The fact that a patent has been issued for an invention does not, of itself, prove the introduction of the invention into public and common use. *Weston v. White*, 13 *Blatchf.* 364 ; 9 *Pat. Off. Gaz.* 1196 ; 2 *Bann. & A. Pat. Cas.* 321.

In an action for infringement, where there was proof that a machine constructed before the plaintiff's invention, and identical with it, for a person who lived some distance from the place of construction, was taken away by him to be put up ; but it was never afterward seen by the witness who assisted in its construction, it was *held*, that the evidence was sufficient to establish the fact of want of novelty in the plaintiff's invention, though there was no proof to show that the prior machine was ever used. *Parker v. Ferguson*, 1 *Blatchf.* 407.

When an alleged invention proves superior to what has been known before, this superiority is evidence in favor of its novelty. *Birdsell v. McDonald*, 6 *Pat. Off. Gaz.* 682 ; *Judson v. Cope*, 1 *Bond*, 327 ; 1 *Fish. Pat. Cas.* 615. S. P., *Carter v. Baker*, 4 *Fish. Pat. Cas.* 404 ; *Smith v. Woodruff*, 1 *MacArthur*, 459 ; 6 *Fish.*

Pat. Cas. 476. But except to show a difference between the two inventions, evidence that the defendant's is superior to plaintiff's is not admissible. *Alden v. Dewey*, 1 *Story*, 336 ; 3 *L. Rep'r*, 383.

The facts that many persons tried to accomplish the result, and that the patentee alone succeeded, are legitimate evidence that his invention was new and useful. *Western Electric Manuf. Co. v. Chicago Electric Manuf. Co.*, 14 *Fed. Rep'r*, 691 ; *Ward v. Grand Detour Plow Co.*, 14 *Fed. Rep'r*, 696 ; 11 *Biss.* 427.

Rejected applications for patents are not alone evidence of the existence of perfected inventions at their dates of filing ; there should be proof that, at such dates, machines embodying the inventions were in existence and operation. *Howes v. McNeal*, 15 *Pat. Off. Gaz.* 608 ; 15 *Blatchf.* 103 ; 3 *Bann. & A. Pat. Cas.* 376 ; *Lyman Ventilating Co. v. Chamberlain*, 10 *Pat. Off. Gaz.* 588 ; 2 *Bann. & A. Pat. Cas.* 433.

In connection with evidence of the construction of an operative machine embodying the invention, a rejected application for a patent for it may be received. *Northwestern Fire Extinguisher Co. v. Philadelphia Fire Extinguisher Co.*, 6 *Pat. Off. Gaz.* 34 ; 10 *Phila.* 227 ; 1 *Bann. & A. Pat. Cas.* 177.

File wrappers are not competent as evidence, in a suit on a patent, to show the reduction to practice and use of inventions claimed to be prior, so as to invalidate such patent. *Howes v. McNeal*, 4 *Fed. Rep'r*, 151 ; 17 *Blatchf.* 396 ; 17 *Pat. Off. Gaz.* 799 ; 11 *Rep'r*, 362 ; 5 *Bann. & A. Pat. Cas.* 77.

If the signature of a letter acknowledging the receipt of an application for a patent is proved, the letter is competent as an official act and document of a public officer in relation to such a subject, and a part of the transaction ; for, being made at the time, and in relation to the subject-matter, it is competent as a part of the *res gestæ*, and explanatory of what took place. *Pike v. Potter*, 3 *Fish. Pat. Cas.* 55.

A different result is evidence of some new cause or means, although the mechanism may apparently be substantially the same. Hence a greater degree of utility achieved by one machine is evidence of novelty. *Eames v. Cook*, 2 *Fish.* 146.

It is decisive evidence that a new mode of operation has been introduced if the practical effect of the invention is either a new effect or a materially better effect, or as good an effect more economically attained. *Furbush v. Cook*, 2 *Fish. Pat. Cas.* 668.

Public demand for an article when its existence is made known,

is not conclusive evidence of novelty and invention. *Hill v. Bid-
dle*, 27 *Fed. Rep'r*, 560.

The extensive use of a device, however simple, is evidence of its utility, and consequently of its patentable merit. *Lorillard v. McDowell*, 23 *Int. Rev. Rec.* 90 ; 11 *Pat. Off. Gaz.* 640 ; 2 *Bann. & A. Pat. Cas.* 531 ; 13 *Phila.* 461.

The fact that defendant chose to use the invention patented by complainant, has been *held* sufficient evidence of utility in the invention to sustain it as patentable for the purposes of that suit. *Smith v. Glendale Elastic Fabric Co.*, 1 *Holmes*, 340 ; 5 *Pat. Off. Gaz.* 429 ; 1 *Bann. & A. Pat. Cas.* 58 ; *Lee v. Blandy*, 1 *Bond*, 361 ; 2 *Fish. Pat. Cas.* 89. Otherwise, of evidence that strangers to the suit offered to take licenses from the plaintiff. *Evans v. Hettick*, 3 *Wash.* 408 ; *aff'd* on other points, 7 *Wheat.* 453.

The fact that a mill for grinding bark would grind double the quantity that could be ground by the old mills, is evidence enough of utility to sustain a patent. *Wilbur v. Beecher*, 2 *Blatchf.* 132.

Where the evidence establishes the facts that the patentee was the first to conceive the idea of constructing the device described in his patent, whereby improved results were accomplished, and that the public has attested its superior utility and value by adopting the same, instead of the constructions previously used, there is sufficient proof of patentable merit. *Miller v. Pickering*, 16 *Fed. Rep'r*, 540.

On a motion for a preliminary injunction, the defense of prior public use will be entertained, although unsuccessfully made in former cases, where such defense is much more strongly fortified than before by corroborative evidence, and it is reasonable to believe that a different result would have been reached if the new evidence had been presented. *Lockwood v. Faber*, 27 *Fed. Rep'r*, 63.

Clear proof is required of mistake in drawings on file, after destruction of model. *Royer v. Russell*, 9 *Fed. Rep'r*, 696 ; 20 *Pat. Off. Gaz.* 1819.

The defense of a prior knowledge and use is established when the evidence shows that the invention was complete and capable of working, and had been put in public use, and was known to any considerable number of persons. *Judson v. Bradford*, 16 *Pat. Off. Gaz.* 171 ; 3 *Bann. & A. Pat. Cas.* 539.

Where there has been a public acquiescence in the validity of a

patent, the court will scrutinize evidence of its invalidity with the greatest care. *Hobbie v. Smith*, 27 *Fed. Rep'r*, 656.

A claim to prior use needs to be proved beyond a reasonable doubt. *Coffin v. Ogden*, 18 *Wall.* 120 ; *Troy Iron, &c. Factory v. Corning*, 1 *Blatchf.* 467 ; *Campbell v. James*, 17 *Blatchf.* 42 ; 4 *Bann. & A. Pat. Cas.* 456 ; 18 *Pat. Off. Gaz.* 979 ; 8 *Rep'r*, 455 ; see reversal, 104 *U. S.* 357 ; *Campbell v. New York*, 9 *Fed. Rep'r*, 500 ; *Troy Iron, &c. Co. v. Odiorne*, 17 *How.* 72 ; 20 *Blatchf.* 67 ; 20 *Pat. Off. Gaz.* 1817 ; *Doubleday v. Beatty*, 11 *Fed. Rep'r*, 729 ; 22 *Pat. Off. Gaz.* 859 ; *Hawes v. Antisdell*, 8 *Pat. Off. Gaz.* 685 ; *Washburn, &c. Manuf. Co. v. Haish*, 4 *Fed. Rep'r*, 900 ; 10 *Biss.* 55 ; 19 *Pat. Off. Gaz.* 173 ; *Everest v. Buffalo Lubricating Oil Co.*, 20 *Fed. Rep'r*, 848 ; *Wetherell v. Veith*, 27 *Fed. Rep'r*, 364 ; *Hobbie v. Smith*, *Id.* 656. See also *infra*, p. .

The fact that a manufacturer for a long period does not make use of a means of production important in the business, shows that he did not have the idea. *Roots v. Hyndman*, 4 *Pat. Off. Gaz.* 29 ; 6 *Fish. Pat. Cas.* 439.

Making and exhibiting a new article is presumptive proof of invention ; but if the exhibitor makes no claim at the time to having invented it, this tends to rebut the presumption. *Pennock v. Dialogue*, 4 *Wash.* 538.

Evidence that in operating a prior machine a greater number of persons necessarily have to be employed than are required in the operation of a patented machine, tends to prove that the machines are not alike. *Coupe v. Weatherhead*, 23 *Pat. Off. Gaz.* 1927.

If two devices produce different results, this is some evidence that the devices themselves are different. *Waterbury Brass Co. v. New York Brass Co.*, 3 *Fish. Pat. Cas.* 43.

286. *Rules of Evidence as to Matters Connected with Reissues.*

The question of the identity of an invention described in the original and the reissued letters patent is one of law for the court, whenever it can be determined solely from their face by mere comparison of specifications, without the aid of extrinsic evidence. *Heald v. Rice*, 104 *U. S.* 737.

A defective patent was surrendered and a new one taken out. In an action for a violation thereof, in which the infringement was

laid subsequent to the date of the reissue, evidence of a use of a machine prior to the date of the second patent, but subsequent to that of the first, is not admissible in defense. *Stimpson v. West Chester R. R. Co.*, 4 *How.* 380.

Where the defendant sets up as a defense in a suit for infringement of reissued letters patent, that they are broader than the original, and therefore invalid, and the plaintiff fails to introduce the original in evidence, the defendant may introduce them, and the question of the validity of the reissued patent may be passed upon by a comparison. *National Pump Cylinder Co. v. Simmons Hardware Co.*, 18 *Fed. Repr.*, 324. S. P., *Knapp v. Shaw*, 23 *Pat. Off. Gaz.* 2236 ; 15 *Fed. Rep'r.*, 115.

287. *Evidence as to Plaintiff's Title to the Patent or to the Damages.*

In a court of equity, an equitable title is sufficient, as against the patentee, and those claiming under him if with notice of the complainant's title, and that notice appears by the records of the complainant's title. *Ruggles v. Eddy*, 10 *Blatchf.* 52 ; 5 *Fish. Pat. Cas.* 581.

A decree obtained for infringement cannot be introduced on the trial of an action against one not a party nor privy to the former suit, for the purpose of proving his acquiescence in the rights of plaintiff under the patent. Such decrees, although admissible upon motions for a provisional injunction, are proceedings *inter alios*, and are not competent evidence on a trial upon the merits. *Matthews v. Iron Clad Manuf. Co.*, 19 *Fed. Rep'r.*, 321.

A license granted by the patentee of an invention, permitting the invention to be manufactured and used upon certain terms and conditions, cannot be deemed evidence of an acquiescence in infringements of his right ; it is, rather, an assertion of an exclusive right in the invention. *Jordan v. Dobson*, 2 *Abb., U. S.* 398 ; 7 *Phila.* 533.

A patentee who has given another person a writing showing that he has an interest in the patent, may show by parol that the writing does not contain the contract nor express the intention of the parties. *Kearney v. Lehigh Valley R. Co.*, 27 *Fed. Rep'r.*, 699.

288. *As to the Charge of Infringement.*

Evidence that third persons who, as defendant has shown, have used a machine like plaintiff's, prior to his invention, and paid plaintiff for licenses, is competent, though not important. *Evans v. Eaton*, 3 *Wheat.* 454, 505.

When, upon appeal in an action for an infringement, it appears that the parties have admitted that the defendants have used machinery constructed in conformity with the plaintiff's patent, the admission is sufficient to make a *prima facie* case of infringement. *Chaffee v. Boston Belting Co.*, 22 *How.* 217.

The fact that the device defendant manufactures works better than another which is patented, and has driven it out of market, is *prima facie* evidence that the use of it does not violate the patentee's monopoly. *Smith v. Woodruff*, 1 *MacArthur*, 459 ; 6 *Fish. Pat. Cas.* 476.

Where the answer, under oath, is responsive to a bill seeking an injunction against infringement, and denies the infringement, something more than the evidence of a single witness must be produced to overcome it and justify an injunction. *Woodworth v. Hall*, 1 *Woodb. & M.* 248 ; 6 *Pa. L. J.* 178.

Exclusive right in the person under whom the defendants claim a right to use the machine in controversy, cannot be shown by evidence that the defendants have for several years used the machine, with the plaintiff's knowledge, and without any objection on his part. *Baldwin v. Sibley*, 1 *Cliff.* 150.

A failure on the part of a defendant charged with infringement to bring into court the article in question, when it is within his power so to do, will be taken as an admission of infringement. *Ely v. Monson, &c. Manuf. Co.*, 4 *Fish. Pat. Cas.* 64.

Parol evidence of a written contract for the use of a patent article, was *held* admissible in a suit for infringement. *Andrews v. Creegan*, 7 *Fed. Rep'r.* 477 ; 19 *Blatchf.* 113 ; 19 *Pat. Off. Gaz.* 1140 ; 11 *Rep'r.* 527.

In defense of a suit for infringement of a prior patent, a licensee may put in evidence the patent of his licensor. *Blanchard v. Puttman*, 3 *Fish. Pat. Cas.* 186 ; 2 *Bond.* 84.

Proof of the charge of infringement must be clear. *Racine Seeder Co. v. Joliet Wire Check Sower Co.*, 27 *Fed. Rep'r.* 367.

In a suit for infringement of a patent for improvement in ovens,

evidence that defendant put up the oven constituting the infringement; and controlled and managed it, was *held* sufficient to establish the infringement alleged. *Peterson v. Simpkins*, 25 *Fed. Rep'r*, 486 ; 33 *Pat. Off. Gaz.* 1392.

Where the answer under oath denies infringement, the testimony of one witness is insufficient, unless corroborated by circumstances. *Slessinger v. Buckingham*, 17 *Fed. Rep'r*, 454. See *Spring v. Domestic Sewing Mach. Co.*, 21 *Pat. Off. Gaz.* 633 ; *Bennett v. Fowler*, 8 *Wall.* 445.

When the proof showed that defendant's machine did not correspond with the description of the patent, and the functions of plaintiff's devices would not work in defendant's machine, it was held no infringement. *Kirby v. Dodge & Stevenson Manuf. Co.*, 10 *Blatchf.* 307.

When the answer does not explicitly deny infringement, the court may infer from the testimony of a witness who saw infringing machines in the possession of the defendants, some of which were in use, that all the machines had been used by all the defendants. *Gear v. Fitch*, 16 *Pat. Off. Gaz.* 1231.

When, from the evidence, it appears that the defendant is simply pursuing the same process of manufacturing, which he followed before the patent in question was issued, the court will not interfere to restrain defendant from continuing its use. *Dorlan v. Guie*, 34 *Pat. Off. Gaz.* 702.

289. *As to Matters of Affirmative Defense.*

Evidence that for a long time after making an invention, and without special cause, the inventor neglected to make and prosecute an application for letters patent, under attendant circumstances evincing an intent to abandon, may suffice to prove abandonment. *Planing Machine Co. v. Keith*, 101 *U. S.* 479. S. P., *Re Rowley*, 2 *Am. L. T. U. S. Cts.* 106.

It is strong evidence for a jury, of an intent to abandon, that a claimant of an invention withdrew it from use, and neglected or discarded it, and did not attempt to resume it until a rival device had been brought forward. *Johnson v. Root*, 2 *Cliff.* 108 ; 2 *Fish. Pat. Cas.* 291 ; *Parkhurst v. Kinsman*, 1 *Blatchf.* 488 ; 8 *N. Y. Leg. Obs.* 146 ; *aff'd* on other points, 18 *How.* 289.

Evidence of abandonment of a part only, and that not the most

important part of the claim of a patent, does not warrant a general finding of abandonment. *New York Grape Sugar Co. v. Buffalo Grape Sugar Co.*, 18 *Fed. Rep'r*, 638 ; 25 *Pat. Off. Gaz.* 1076.

Evidence that a person abandoned the use of a particular machine, is not evidence that the machine itself was a new abandoned experiment. *Pickering v. McCulloch*, 13 *Pat. Off. Gaz.* 818.

Clear proof is necessary to establish the defense of anticipation (*Donoghe v. Hubbard*, 27 *Fed. Rep'r*, 742 ; *Gottfried v. Phillip Best Brewing Co.*, 17 *Pat. Off. Gaz.* 675 ; 5 *Bann. & A. Pat. Cas.* 4) ; especially where the allegation is that an invention was long ago anticipated by one which never became generally known. *Lane v. Peck*, 9 *Fed. Rep'r*, 101.

Where the alleged prior inventor was shown to be very near the realization of the invention, but could not, at a period long subsequent, make a practical machine embodying the invention, it was held that his operations were not sufficient to defeat a patent, although witnesses testified that they were successful. *American Bell Telephone Co. v. People's Telephone Co.*, 34 *Pat. Off. Gaz.* 561.

290. *As to Amount of Damages and Profits.*

Evidence of amounts received by patentee in settlements for other infringements cannot be received in aid of determining the amount which ought to be paid by defendant for his infringement of the same patent. *Westcott v. Rude*, 19 *Fed. Rep'r*, 830.

A license for future use of a patented invention, given wholly or partly in consideration of a settlement for past infringements, is not admissible, as against a stranger, to establish the amount of a royalty. *Gottfried v. Crescent Brewing Co.*, 22 *Fed. Rep'r*, 433 ; 30 *Pat. Off. Gaz.* 892.

Proof of sales of patented machines, and an agreement between patentees for their manufacture and sale was *held* admissible, although not conclusive, in a suit for infringement, as tending to show the value of the invention ; although the sales had not been numerous or uniform enough to establish a license fee. *Gottfried v. Crescent Brewing Co.*, *Ib.*

Admissibility, in a suit for infringement of one of several claims in a patent, of evidence of profits derived from the use of the patented invention, as an entirety, considered. *Fischer v. Hayes*, 22 *Fed. Rep'r*, 529.

Evidence for plaintiff in suits for infringement, was *held* inconclusive, and not sufficient, under the circumstances, to sustain the bills. *Deplanque v. Ripka*, 24 *Fed. Rep'r*, 278.

Where complainant's device was but of little value, and the defendant added improvements which rendered the device marketable, it was *held*, that the complainant must show what proportion of profits was due to the original invention ; and failing in that, the complainant is entitled to nominal damages, only. *Bostock v. Goodrich*, 34 *Pat. Off. Gaz.* 1047.

291. *Declarations of Inventor, &c.*

The conversations and declarations of an inventor stating that he had made an invention, and describing its details, and explaining its operations, are properly deemed an assertion of his right, at that time, to the extent of the facts and the circumstances which he then makes known, although not of their existence at any anterior time, and is competent evidence to fix the date of invention as of that time. *Philadelphia & Trenton R. R. Co. v. Stimpson*, 14 *Peters*, 448.

The statements of a person claiming to be an inventor, made *prior* to the proceedings for interference, in which he graphically describes the invention, are admissible as part of the *res gestæ*. *Yearsley v. Brookfield*, 1 *MacArthur Pat. Cas.* 193.

The declarations of an inventor in describing the details of a device and its mode of operation, are admissible in his favor as part of the *res gestæ*, when the priority of invention is in question. *Richardson v. Hicks*, 1 *MacArthur Pat. Cas.* 335 ; *Stephens v. Salisbury*, *Id.* 379.

292. *Testimony of Ordinary Witnesses.*

Since the rules of evidence prescribed by the State are rules of decision for the United States courts, it was *held*, that a plaintiff in an action for infringement was competent as a witness ; it appearing that under the laws of the State where the trial was had, parties to a suit were declared competent witnesses. *Vance v. Campbell*, 1 *Black*, 427 ; *rev'g* 1 *Fish. Pat. Cas.* 483 ; *Haussknecht v. Claypool*, 1 *Black*, 431.

In considering the question of originality, the oath of the inventor, made prior to the issue of the letters-patent, that he was the first inventor of the thing patented, may be opposed to the oath of a witness offered to show that the invention was not original. *Alden v. Dewey*, 1 *Story*, 336 ; 3 *L. Rep'r*, 383.

The testimony of a witness who had no knowledge as to how the articles resembling complainant's invention were made, is insufficient to invalidate plaintiff's patent on the ground that he was not the original inventor, or that the same was in use before his invention. *Treadwell v. Bladen*, 4 *Wash.* 703.

The priority of knowledge and use of an invention is a question of fact, which a jury may decide from one witness ; the question is on the credibility and not on the number of witnesses. *Whitney v. Emmett*, *Baldw.* 303, 310.

The fact that the maker of the alleged prior machine is not examined, where priority is attempted to be proved, though present, is a circumstance to be considered in weighing other testimony as to the existence and character of the machine. *Wood v. Cleveland Rolling Mill Co.*, 4 *Fish. Pat. Cas.* 550.

293. *Experts.*

Where a patent is attempted to be invalidated by a prior patent, it is proper to take the testimony of experts as to the diversity in the inventions, and submit the evidence to the jury with proper instructions, leaving them to determine the question of identity. The court cannot be required to compare the two specifications, and to instruct a jury, as matter of law, whether the inventions are or are not identical. *Bischoff v. Wethered*, 9 *Wall.* 812.

Experts may be examined to explain, if necessary, models and drawings. *Winans v. New York & Erie R. R. Co.*, 21 *How.* 88, 100.

The opinions of skillful persons, whether the principles of two machines are the same, are competent evidence to be introduced in a patent cause. *Barrett v. Hall*, 1 *Mas.* 447, 470 ; *Blanchard v. Beers*, 2 *Blatchf.* 411 ; *Parker v. Stiles*, 5 *McLean*, 44, 64 ; 7 *West. L. J.* 168.

The patent law contemplates two classes of persons as appropriate witnesses in patent cases.

1. Artisans, engaged in the trade, employment, or business of

the particular branch of mechanics to which the patent right applies, as to whether the specification sufficiently described the invention so that it could be constructed and used.

2. Persons who, although not practical artisans, are thoroughly conversant with the subject of mechanics as a science, as to the questions of novelty of invention, or identity or diversity of mechanical apparatus, and contrivances, and equivalents. *Allen v. Blunt*, 3 *Story*, 742, 747 ; 8 *L. Rep'r*, 165. S. P., *Olcott v. Hawkins*, 2 *Am. L. J. N. S.* 321.

The testimony of a chemist, who has analyzed the ingredients of a composition of matter, as to the nature of such composition, is not matter of opinion, but evidence of a fact demonstrated. *Allen v. Hunter*, 6 *McLean*, 303.

Where the opinions of experts are expressed in *ex parte* affidavits, and there is no opportunity for the court to ascertain in what sense important words are used, nor what facts they take in view, nor what standards of comparison they assume, their opinions are of very little value. *Sargent v. Carter*, 1 *Fish. Pat. Cas.* 277 ; 11 *L. Rep'r, N. S.* 651.

In a suit for infringement the testimony of a mechanical expert is to be tried by the tests applied to the evidence of other witnesses. *May v. County of Fond du Lac*, 27 *Fed. Rep'r*, 691.

Expert testimony is not essential to prove an alleged infringement of a patent. *Hayes v. Bickelhaupt*, 23 *Fed. Rep'r*, 183 ; 32 *Pat. Off. Gaz.* 133.

Experts assume the duty of the court when they undertake to tell what the patent is for, or what is or is not a violation of the patent. *Waterbury Brass Co. v. New York & Brooklyn Brass Co.*, 3 *Fish. Pat. Cas.* 43.

294. *Evidence, with Reference to Particular Pleadings.*

Where, in an action to recover the consideration for an assignment of a patent, the declaration alleged that a certain improvement containing one principal and three minor improvements, all of which were included in a patent, which patent was reissued in four reissues, and that the original described all, and no more than the improvements specified in the four reissues, it was *held* that the reissues related back and were included within the assignment, and that the declaration was sufficient. *Read v. Bowman*, 2 *Wall.* 591.

In a suit for an infringement, letters patent granted earlier than those under which complainant claims, describing the same invention, may be read in evidence to disprove priority of his invention, notwithstanding such letters are not set up in the answer. *Atlantic Works v. Brady*, 107 *U. S.* 92 ; 2 *Sup. Ct. Rep'r*, 225.

Where a bill was filed for an injunction to restrain the running of a machine in violation of the plaintiff's rights, and the defendants justified under a license, which the complainant alleged had been abandoned, and no issue of abandonment was raised by the pleadings, it was *held*, that no evidence of abandonment could be received, and therefore, an injunction could not issue. *Wilson v. Stolley*, 4 *McLean*, 275 ; 4 *West. L. J.* 412.

The plaintiff is confined to giving evidence of infringements during the period which he specifies in his declaration. *Eastman v. Bodfish*, 1 *Story*, 528 ; 2 *Robb*, 72.

In a suit in equity to restrain an infringement, a prior patent not alleged in the answer is admissible as evidence of the state of the art at the date of the complainant's invention, only ; and not to show want of novelty in that invention. *American Saddle Co. v. Hogg*, 1 *Holmes*, 133 ; 6 *Fish. Pat. Cas.* 67.

In a suit for an infringement for a design, testimony as to the prior knowledge and use of the patented design by persons not named in the answer is incompetent. *Collender v. Griffith*, 11 *Blatchf.* 212 ; 3 *Pat. Off. Gaz.* 689.

Testimony offered by the defendants respecting a prior rejected application of a third person, the use of his invention, and his prior knowledge of the thing patented, is not admissible to show that the patentee was not the original inventor, unless these facts are set up in the answer. *Union Paper Bag Machine Co. v. Pultz, & Co.*, 15 *Blatchf.* 160 ; 15 *Pat. Off. Gaz.* 423 ; 3 *Bann. & A. Pat. Cas.* 403.

Evidence of the manufacture and use of an article similar to that covered by the patent at the time of its issuance, was *held* proper, as tending to show what was in existence at the time, though knowledge had not been pleaded. *Zane v. Loffe*, 2 *Fed. Rep'r*, 229 ; 5 *Bann. & A. Pat. Cas.* 284.

XXI. MATTERS OF PRACTICE INCIDENTAL TO PATENT SUITS.

295. *Abatement of Suit.*

A suit in equity seeking relief against an infringement does not abate by the death of the plaintiff, but may be prosecuted to final judgment by his legal representative. *Illinois Central R. R. Co. v. Turrill*, 110 *U. S.* 301.

A bill in equity for an injunction and account of profits for an infringement does not abate by the death of the defendant, the infringer, but may be revived against his representatives. In the equity suit for an infringement, the complainant is allowed, instead of bringing action at law to recover damages, to sue the infringer as a trustee of the profits realized by him, and to enforce his accountability for them in that character; and this being the basis of the suit, the equitable liability of an infringer is clearly not determined by his death. The fact that the suit cannot be prosecuted against the representatives for the injunction, does not negative the right to revive the suit for the accounting; as the jurisdiction of the circuit courts to enforce an accounting in patent causes is not altogether dependent on the jurisdiction to enjoin. *Smith v. Baker*, 5 *Pat. Off. Gaz.* 496; 19 *Int. Rev. Rec.* 149; 10 *Phila.* 221; 1 *Bann. & A. Pat. Cas.* 117.

296. *Compulsory Disclosure*

It has been ruled that a defendant who both attacks the validity of the patent, and also denies that he is infringing it, cannot be compelled to disclose the name of customers to whom he has sold the articles said to infringe. *Roberts v. Walley*, 14 *Fed. Rep'r*, 167; 29 *Int. Rev. Rec.* 47; 26 *Pat. Off. Gaz.* 107; 15 *Rep'r*, 39.

On hearing of an application for an injunction against an infringement, the court may adjudge the patented article unpatentable and the patent void, from inspection, and without taking evidence. *Everett v. Thatcher*, 16 *Pat. Off. Gaz.* 1046. But it has been *held*, that exhibition of models of the machines of the

respective parties will not suffice to determine such applications; there must be an examination into the detail of the construction, combination and operation of all their parts, by competent mechanics. *Cooper v. Matthews*, 8 *L. Rep'r*, 413.

On a bill for an infringement, if the defendants refuse to allow the plaintiffs to examine the machines used by them, the court may order an inspection; or may order that the defendants run their machines in the presence of some expert, and that the expert may bring into court specimens of the work produced. *Sloat v. Patten*, 24 *Jour. Fr. Inst.* 3rd S. 23.

297. *Motions.*

Motion to allow a patent cause to be carried up to the supreme court, notwithstanding the amount of damages in controversy is less than the jurisdictional limit, ought not to be granted except in exercise of a sound discretion, and in cases where questions important and doubtful, and arising on the construction of the patent law itself, are involved. *Allen v. Blunt*, 2 *Woodb. & M.* 121, 155.

Decrees sustaining the validity of the patents involved were entered in certain suits, by consent of parties; but the fact that they were upon consent did not appear in the decrees. A stranger to the suits made a motion for leave to intervene, for the purpose of having these decrees vacated or modified; alleging, as a reason for requesting such relief, that the decrees were being used to support applications for injunctions pending against himself or his agents, in other circuits. It was *held*, that such motion must be denied. *Matter of Iowa Barb Steel Wire Co.*, 5 *Bann. & A. Pat. Cas.* 279.

Application, in a suit for infringement, for leave to amend the answer, and for a rehearing, for the purpose of setting up a new defense of prior use, was denied; because there was nothing to show but that the facts constituting the new defense could have been discovered by the exercise of reasonable diligence before the hearing. *Hicks v. Otto*, 22 *Blatchf.* 122. To nearly the same effect, where the new defense was want of novelty, *Lockwood v. Cleveland*, 20 *Fed. Rep'r*, 164.

A motion to consolidate several bills in equity founded on different patents and pending against different persons, may be granted when all the mechanical devices alleged to be infringed are used

in one machine. *Deering v. Winona Harvester Works*, 24 *Fed. Rep'r*, 90; 32 *Pat. Off. Gaz.* 654.

A motion to stay proceedings upon an order for an accounting, will not be granted merely because the patent has, since the order was made, been declared void, by another court, if an appeal has been taken, and the facts in the two cases are not alike. *Celluloid Manuf. Co. v. Comstock & Cheney Co.*, 27 *Fed. Rep'r*, 358.

298. *Trial.*

Whether an application for a patent claimed to be new, was really a continuance of a former one; whether a machine embodied in a patent required or admitted of invention, whether a patent described and claimed a novel device, and whether important parts of defendant's machine are merely equivalents for corresponding parts of the patented one; are questions of fact for the jury. *Bevin v. East Hampton Co.*, 5 *Fish. Pat. Cas.* 23; 9 *Blatchf.* 50; *Poppenhusen v. Falk*, 5 *Blatchf.* 49; *Bischoff v. Withired*, 9 *Wall.* 812; *May v. County of Fond du Lac*, 27 *Fed. Rep'r*, 691.

Upon trial of an infringement suit before a jury, if, after the plaintiff's evidence is all in, the court is of opinion that it is insufficient in law to establish the infringement and warrant a judgment on the verdict if one should be rendered for the plaintiff, the court may direct a verdict for the defendant and discharge the jury. (*Millner v. Schofield*, 4 *Hughes*, 258); but the defect of evidence must be undoubted. *Klein v. Russell*, 19 *Wall.* 433.

On a motion for a new trial after verdict for plaintiff, in an action for infringement, he may in a proper case have leave to retain his verdict on consenting to a remission of damages. *Russell v. Place*, 9 *Blatchf.* 173; *Conway v. Rumsey*, 4 *Fish. Pat. Cas.* 275.

299. *Hearing, and Rehearing.*

If complainant's patent is seen to be void because the device or contrivance described is not patentable, the court at the hearing should dismiss the cause on that ground, whether defendant raises the objection or not. *Slawson v. Grand St. R. Co.*, 107 *U. S.* 649.

A decree for an injunction against the infringement of a patent and for an accounting is interlocutory, and a rehearing may be

ordered before the report of the master and final decree thereon. *Reeves v. Keystone Bridge Co.*, 2 *Week. N. of Cas.* 523.

Applications for rehearing have been denied, in cases where the reasons assigned were: Newly-discovered evidence to establish anticipation, *Kerosene Lamp Co. v. Littell*, 2 *N. J. L. J.* 150; Newly-discovered evidence to establish prior use, *Hicks v. Ferdinand*, 20 *Fed. Rep'r*, 111; Because defendant did not have proper expert testimony on the original hearing, *Hitchcock v. Tremaine*, 9 *Blatchf.* 550; 4 *Fish. Pat. Cas.* 598.

A petition by the defendant for a rehearing because of newly-discovered evidence in a suit for infringement, should ask leave to file a supplemental bill to bring in the new evidence, and that when the proofs are made thereunder, the cause may be reheard. *Hitchcock v. Tremaine*, *supra*.

Rehearing, in a suit for infringement of patent, was granted to allow further proofs that claims in the patent had been rejected upon a previous application by the same inventor for a patent, and such rejection acquiesced in and right of appeal waived by him. *Railway Register Manuf. Co. v. Broadway & Seventh Ave. R. R. Co.*, 32 *Pat. Off. Gaz.* 257.

A motion for a rehearing was granted on the condition, that in case there should be the same decree rendered, the testimony already taken upon an accounting by the master should stand for use in the case as if taken by the parties respectively upon such new accounting. *American Diamond Rock Boring Co. v. Sheldon*, 24 *Fed. Rep'r*, 374; 32 *Pat. Off. Gaz.* 1240. And see S. C., 25 *Fed. Rep'r*, 768; 33 *Pat. Off. Gaz.* 1598.

Application by the defendant for a re-argument of a suit for infringement of a patent, was denied, upon the same evidence,—the only ground stated being that one of the defenses was not fully presented at the argument. *Railway Register Manuf. Co. v. North Hudson County R. Co.*, 26 *Fed. Rep'r*, 411.

300. *Jury Trial in Equity.*

Allowance of a jury to settle the question of infringement arising in a suit in equity, is not matter of right, but rests in discretion; it is granted when the equity judge entertains reasonable doubts and wishes the aid of a jury. *Brooks v. Norcross*, 2 *Fish. Pat. Cas.* 361.

The differences of witnesses as to the fact of infringement, should be submitted to a jury, either by action at law, or by an issue directed by the court. *Brooks v. Bicknell*, 3 *McLean*, 250 ; 1 *West. L. J.* 150.

On the trial of a feigned issue the patent is not admissible, if it has no tendency to support the issue. Where the feigned issues presented no issue of fraud or mistake, and the bill of complaint was founded exclusively upon the reissued letters patent, it was *held*, that the original letters patent, if objected to, were not admissible on the trial. *Caboon v. Ring*, 1 *Cliff.* 592.

A court of equity is not bound to try by a jury, the issue, as to whether a reissue is for the same invention as the original, although the fact that there is considerable doubt may be a reason for so doing. *Poppenhusen v. Falke*, 4 *Blatchf.* 493 ; 2 *Fish. Pat. Cas.* 181.

The act of February 16, 1875, provides :

That said courts, [circuit courts] when sitting in equity for the trial of patent causes, may impanel a jury of not less than five and not more than twelve persons, subject to such general rules in the premises as may, from time to time, be made by the Supreme Court, and submit to them such questions of fact arising in such cause as such circuit court shall deem expedient.

And the verdict of such jury shall be treated and proceeded upon in the same manner and with the same effect as in the case of issues sent from chancery to a court of law and returned with such findings. Act of Feb. 16, 1875, c. 77, § 2 ; 1 *Supp. to Rev. Stat.* 136.

The above enactment does not affect the established rules of equity practice governing the effect of the verdict on a feigned issue and the mode of seeking a review. *Watt v. Starke*, 101 *U. S.* 247.

301. *Reference to Ascertain Damages or Profits.*

Where infringement to any extent is admitted, and the patent held to be valid, the proper practice is, to enter an interlocutory decree for complainant and send the cause to a master to ascertain the amount the complainant is entitled to recover. *Carew v. Boston Elastic Fabric Co.*, 3 *Cliff.* 356; 1 *Pat. Off. Gaz.* 91; 5 *Fish. Pat. Cas.* 90; *Jackson v. Breck*, 11 *Pat. Off. Gaz.* 112.

The defendants, adjudged infringers, must go forward in the accounting ordered, and pay the master's fees. *Urner v. Kayton*, 17 *Fed. Rep'r*, 539; 24 *Pat. Off. Gaz.* 1178; 16 *Rep'r*, 225. To the contrary, as to payment of fees, *MacDonald v. Shepard*, 10 *Fed. Rep'r*, 919.

The amount of profits or damages to be allowed in a suit for infringement is matter of fact calling for proof, and if affirmative proof is not made, a master's report of a substantial sum, founded on conjecture, must be disallowed on proper exceptions filed; and a decree entered for nominal damages only. *Ingersoll v. Musgrove*, 13 *Pat. Off. Gaz.* 966; 14 *Blatchf.* 541; 3 *Bann. & A. Pat. Cas.* 304.

The master should simply examine and decide as to the extent of the infringement as to the particular machine used by the defendants; and should not enter into the general question of infringement, nor consider the general scope and extent of the patent. *Turrill v. Illinois Central R. R. Co.*, 5 *Biss.* 344.

The master may take the account down to the time of the hearing before him, if the infringement continues to that period. *Tatham v. Lowber*, 4 *Blatchf.* 86. S. P., *Knox v. Great Western Quicksilver Min. Co.*, 14 *Pat. Off. Gaz.* 897; 7 *Rep'r*, 325; 4 *Bann. & A. Pat. Cas.* 25; 6 *Sawyer*, 430.

The defendants, having been adjudged infringers of a patent for a process, claimed on the accounting, to have so altered their apparatus that its use thereafter no longer infringed the patent; and exhibited to the master such portions of it as were not in use, but, though requested, refused to exhibit the portions that were in use. It was *held*, that the master was justified in finding that the defendants still infringed the patent. *Piper v. Brown*, 1 *Holmes*, 196; 6 *Fish. Pat. Cas.* 240.

Masters charged with the duty of computing and reporting the profits of respondents in infringement suits may examine the res-

pondents, and, if necessary, inspect their books; but it is incumbent upon the complainant to furnish whatever additional proof may be necessary to enable the master to make the proper computation. *Brady v. Atlantic Works*, 15 *Pat. Off. Gaz.* 965; 3 *Bann. & A. Pat. Cas.* 577. Compare *Fisher v. Shaughnessy*, 15 *Rep'r*, 613.

A subpoena *duces tecum* may be issued. Its proper form. *Turrell v. Speath*, 8 *Pat. Off. Gaz.* 986; 2 *Bann. & A. Pat. Cas.* 185; Right of defendant to demand production of plaintiff's books, in connection with cross-examining him. *Wisner v. Dodd*, 14 *Fed. Rep'r*, 655.

The evidence adduced upon an accounting for profits made by the use of a patented bond and coupon register was *held* insufficient to sustain the master's report on an arbitrary estimate based on comparison with a different system, and not tending to show the profits actually derived by the defendants from their use of the patented system as they used it. *Munson v. New York*, 21 *Blatchf.* 342.

302. Costs.

A verdict for nominal damages only, for infringement, under the act of 1836, carried costs. *Merchant v. Lewis*, 1 *Bond*, 172. Under the Revised Statutes, assessment of costs in such cases depends on the circumstances. *Calkins v. Bernard*, 8 *Fed. Rep'r*, 755; 10 *Biss.* 445.

On the taking of an account of profits, the plaintiff exaggerated his claim, introduced irrelevant evidence, and recovered only a small sum. It was *held*, that neither party should recover, against the other, any costs or expenses that accrued before the master, embracing the fees of witnesses, the taking and printing of the evidence, and all disbursements before him, but each party should bear his own. *Troy Iron, &c. Factory v. Corning*, 6 *Fish. Pat. Cas.* 85; 10 *Blatchf.* 223.

Where the complainants united in their bill two causes of action on different patents, and by the allegation that the defendants infringed both, compelled them to litigate both, and as to one of these causes of action the defendants prevailed, it was *held*, that neither party should recover costs as against the other. *Adams v. Howard*, 19 *Fed. Rep'r*, 317; 22 *Blatchf.* 47; 26 *Pat. Off. Gaz.* 825.

Costs of taking testimony, to be used in two suits between the same parties for infringement, should be equally divided between the suits. *Thayer v. Hart*, 30 *Pat. Off. Gaz.* 776.

In an action for infringement, the expense of obtaining a model of the infringing machine, is not taxable as a disbursement by the plaintiff. *Cornely v. Markwald*, 24 *Fed. Rep'r*, 187.

Where the defendants have in good faith obtained models of the devices shown in plaintiff's patent, they may be taxed as costs. *Woodruff v. Barney*, 1 *Bond*, 528. So also such models as are copies of models deposited in the patent-office, and procured for use as a part of the evidence, may be taxed. *Hussey v. Bradley*, 5 *Blatchf.* 210. But see *Parker v. Bigler*, 1 *Fish. Pat. Cas.* 285. Where the plaintiff obtains a decree for nominal damages only, but the defendant persistently contests the validity of the patent, and the question of infringement, as well as the amount of damages, the court will award all costs against the defendant. *Calkins v. Bertrand*, 10 *Bissell*, 445.

303. *Costs, as Affected by Disclaimer.*

When judgment or decree is rendered for the plaintiff or complainant, in any suit at law or in equity, for the infringement of a part of a patent, in which it appears that the patentee, in his specification, claimed to be the original and first inventor or discoverer of any material or substantial part of the thing patented, of which he was not the original and first inventor, no costs shall be recovered, unless the proper disclaimer, as provided by the patent laws, has been entered at the patent-office before the suit was brought. *Rev. Stat.* § 973.

Rev. Stat. §§ 4917, 4922, see *ante*, 206, 207, permit the filing of disclaimers; and section 4922, see *infra*, contains the following proviso :

But in every such case in which a judgment or decree shall be rendered for the plaintiff no costs shall be recovered unless the proper disclaimer has been entered at the patent-office before the commencement of the suit.

For the nature and uses of disclaimers, their effect, and the effect of neglect or delay in filing, see *ante*, pp. 207-211.

Under act of 1837, section 9, the fact that after verdict the plaintiff had disclaimed one of several claims in the patent, did not

necessarily deprive him of costs. *Peck v. Frame*, 5 *Fish. Pat. Cas.* 211. But under Rev. Stat. 4922, where a patent containing two claims was, as to one claim, held invalid, and as to the other sustained; the court *held* that complainant was not entitled to costs *Stewart v. Mahoney*, 5 *Fed. Rep'r*, 360; 4 *Bann. & A. Pat. Cas.* 84.

But this provision does not mean that claims not in issue should be contested for the mere purpose of settling the costs. *American Bell Telephone Co. v. Spencer*, 8 *Fed. Rep'r*, 509; 20 *Pat. Off. Gaz.* 299.

And it applies only to patentees claiming without original right, not to those whose claims have been abandoned by laches in applying for a reissue. *Mundy v. Lidgerwood Manuf. Co.*, 20 *Fed. Rep'r*, 191.

Costs should not be allowed to a complainant in a suit for infringement, who prevails only on account of a disclaimer filed after suit brought, and fails as to a large part of his case. *Hayes v. Bickelhaupt*, 23 *Fed. Rep'r*, 183; 32 *Pat. Off. Gaz.* 133.

304. *Decrees.*

In a suit for infringement of two patents, after the testimony as to one of them was closed, and the cause set down for hearing, an application for leave to discontinue so much of the bill as related to that patent, was made by the plaintiffs. It was *held* that the decree upon granting such leave should contain the condition that the evidence taken by the defendants in relation to the patent might be stipulated into any future suit upon the same patent by the plaintiffs against the defendants. *Brush v. Condit*, 22 *Blatchf.* 246; 20 *Fed. Rep'r*, 826; 28 *Pat. Off. Gaz.* 451.

In an interlocutory decree in a suit for infringement of a patent, awarding profits and damages, and directing a reference to a deputy clerk of the court to take an account of profits, and to assess the damages, no special reason for the appointment of such clerk as referee was assigned, as is required by the act of March 3, 1879 (20 Stat. 415.) It was *held* not a ground for setting aside his report, where the appointment was made upon the assent in open court of solicitors for both parties, and they had proceeded before him for several months with knowledge that he was such deputy clerk; and the decree amended to recite such facts as special reason

for the appointment. *Fischer v. Hayes*, 22 *Blatchf.* 505 ; 22 *Fed. Rep'r*, 92.

The fact, that, upon a decree dismissing, with costs, a bill for infringement of patents, execution for the costs has been issued and returned unsatisfied, is not ground for the appointment of a receiver of the patents as equitable assets, to be disposed of for the satisfying of the decree. *Thayer v. Hart*, 24 *Fed. Rep'r*, 558.

When the decree is interlocutory and not final, the court has power to open the same and allow a new defense, on motion, and without the formality of a bill of review ; but when the application is in fact and substance for a rehearing on newly discovered evidence, it must be supported by the same sort of proof as is required in order to give a party relief upon a bill of review, or a supplemental bill, after a final decree. Application denied as it did not show that the newly discovered evidence could not, with reasonable diligence, have been discovered. *Willimantic Linen Co. v. Clark Thread Co.*, 24 *Fed. Rep'r*, 799 ; 32 *Pat. Off. Gaz.* 1356.

An interlocutory decree in a suit for infringement of a patent, entered *pro confesso*, which finds the patent valid, but leaves open the questions of profits, damages and costs, and orders a reference to take an account, is not conclusive upon the defendant as to the validity of the patent in a suit between the same parties for subsequent infringements ; even where an agreement was entered into between them, whereby the complainant waived damages, profits and costs, so that he might have had the interlocutory decree made final. *Roemer v. Neumann*, 26 *Fed. Rep'r*, 332.

XXII. CASES OF SPECIFICATION TOO BROAD ; OR PRIOR FOREIGN INVENTION.

305. *Suit for Infringement Where Specification is too Broad.*

Whenever, through inadvertence, accident, or mistake, and without any willful default or intent to defraud or mislead the public, a patentee has, in his specification, claimed

to be the original and first inventor or discoverer of any material or substantial part of the thing patented, of which he was not the original and first inventor or discoverer, every such patentee, his executors, administrators, and assigns, whether of the whole or any sectional interest in the patent, may maintain a suit at law or in equity, for the infringement of any part thereof, which was bona fide his own, if it is a material and substantial part of the thing patented, and definitely distinguishable from the parts claimed without right, notwithstanding the specifications may embrace more than that of which the patentee was the first inventor or discoverer. But in every such case in which a judgment or decree shall be rendered for the plaintiff no costs shall be recovered unless the proper disclaimer has been entered at the patent-office before the commencement of the suit. But no patentee shall be entitled to the benefits of this section if he has unreasonably neglected or delayed to enter a disclaimer. *Rev. Stat. § 4922*

For the nature and uses of disclaimers, their effect, and the consequences of neglect or delay in filing, see *ante*, pp. 207-211. As to costs as affected by disclaimer, see *ante*, p. 478.

306. *Patent not Void on Account of Previous Use in Foreign Country.*

Whenever it appears that a patentee, at the time of making his application for the patent, believed himself to be the original and first inventor or discoverer of the thing patented, the same shall not be held to be void on account of the invention or discovery, or any part thereof, having been known or used in a foreign country, before his invention or discovery thereof, if it had not been patented or described in a printed publication. *Rev. Stat. § 4923.*

The use of copies of certified copies of foreign letters-patent is provided for by *Rev. Stat.* § 893, *ante*, p. 27. The subjection of United States patents to foreign patents for the same invention is governed by *Rev. Stat.* § 4887, *ante*; p. 63. In addition to the cases on that subject there cited, the following should be mentioned: Time when a United States patent would expire, as governed by the date of an English patent, in a particular case, determined, see *Weston v. White*, 13 *Blatchf.* 364; 9 *Pat. Off. Gaz.* 1196; 2 *Bann. & A. Pat. Cas.* 321. The life of a foreign patent limits that of an American patent for the same invention, *Globe Nail Co. v. Superior Nail Co.*, 27 *Fed. Rep'r.*, 450; provided the foreign patent is valid, *Bate Refrigerator Co. v. Gillett*, 20 *Id.* 192.

It is only a patent for an invention which has been *previously* actually patented in a foreign country that is limited by the foreign patent. *Holmes Electric Protective Co. v. Metropolitan Burglar Alarm Co.*, 22 *Fed. Rep'r.*, 341; 32 *Pat. Off. Gaz.* 384.

As to the question of identity between the invention described in the foreign patent and the U. S. patent, it was *held*, that the inventor was not estopped from showing a lack of identity, by reason of having represented their identity to be a fact in his application for a U. S. patent, when he labored under a mistake as to this point. *Commercial Manuf. Co. v. Fairbanks Canning Co.*, 27 *Fed. Rep'r.*, 78.

A fair test of identity is to inquire whether the invention described in the U. S. patent will infringe the invention described in the foreign patent. *Ib.*

An error in designating the date from which the patent for an invention which has been patented in a foreign country is to begin to run, may be corrected by a reissue. *Buerk v. Valentine*, 5 *Fish. Pat. Cas.* 366; 9 *Blatchf.* 479; 2 *Pat. Off. Gaz.* 295.

A capacity of being prolonged so as to have a duration of fifteen years is not equivalent to having a term of fifteen years, when the patent is granted for one year, and then prolonged so as to expire at the end of ten years. *Gramme Electrical Co. v. Hochhausen Electric Co.*, 17 *Fed. Rep'r.*, 838; 25 *Pat. Off. Gaz.* 193. But see *Holmes Electrical Protective Co. v. Metropolitan Burglar Alarm Co.*, 28 *Pat. Off. Gaz.* 1189.

Section 4887, is not to be construed as requiring the limitation to be expressed upon the face of the patent, but merely as controlling the effect or duration of the grant. *Canan v. Pound Manuf. Co.*, 31 *Pat. Off. Gaz.* 119.

XXIII. EXTENSIONS.**307. *The former Law Granting and Regulating Extensions of Patents.***

The five sections of the Revised Statutes relating to extensions, viz. §§ 4924 to 4928 inclusive, and numerous decisions to which they gave rise, are omitted, for the reason that the authority for granting extensions by the commissioner, has long been abrogated. The commissioner cannot by the existing law entertain an application to extend a patent, and all extensions heretofore granted have expired. See *ante*, p. 4. Congress can, however, grant an extension of a particular patent (see *ante*, p. 2), and may condition such a grant upon the results of an inquiry to be made before the commissioner. The rules of the patent-office prescribe the manner of conducting such an inquiry. See *Rules of Prac.* Nos. 172–186.

XXIV. PATENTS FOR DESIGNS.**308. *Patents for Designs authorized.***

Any person who, by his own industry, genius, efforts, and expense, has invented and produced any new and original design for a manufacture, bust, statue, alto-relievo, or bas-relief; any new and original design for the printing of woollen, silk, cotton, or other fabrics; any new and original impression, ornament, patent, print, or picture to be printed, painted, cast, or otherwise placed on or worked into any article of manufacture; or any new, useful, and original shape or configuration of any article of manufacture, the same not having been known or used by others before his invention or production thereof, or patented or described in any printed publication, may, upon

payment of the fee prescribed, and other due proceedings had the same as in cases of inventions or discoveries, obtain a patent therefor. *Rev. Stat.* § 4929.

309. *Practice in the Patent Office, as to design patents.*

A patent for a design may be granted to any person, whether citizen or alien, in the cases specified in Rule 24, upon payment of the duty required by law, and other proceedings had, as in other cases of inventions or discoveries. *Rules of Prac.* No. 78.

Patents for designs are granted for the term of three and one-half years, or for seven years, or for fourteen years, as the applicant may, in his application, elect. *Id.* 79.

The proceedings in the applications for patents for designs are substantially the same as in applications for other patents. The specification must distinctly point out the characteristic features of the design, and carefully distinguish between what is old and what is believed to be new. The claims also, when the design admits of it, should be as distinct and specific as in the case of other patents. The following order of arrangement should be observed, when convenient, in framing the specification.

1. Preamble showing name and residence of the applicant, title of the design, and the name of the article for which the design has been invented.

2. Detailed description of the design as it appears in the drawing or photograph, letters or figures of reference being used.

3. Claim or claims.

4. Signature of inventor.

5. Signatures of two witnesses.

When the design can be sufficiently represented by drawings or photographs, a model will not be required. *Id.* No. 81.

Whenever a photograph or an engraving is employed to illustrate the design, it must be mounted upon Bristol board, 10 by 15 inches in size, and properly signed and witnessed. The applicant will be required to furnish ten extra copies of such photograph or engraving (not mounted), of a size not exceeding 7½ inches by 11. Negatives are not required. *Id.* No. 82.

Whenever the design is represented by a drawing made to conform to the rules laid down for drawings of mechanical inventions, but one copy need be furnished. Additional copies will be sup-

plied by the photolithographic process at the expense of the patent-office. *Id.* No. 38.

(Forms to be used in applications for design patents, are given in appendix to the Rules, Forms 9 and 15.)

310. *What Designs are Patentable.*

The patent allowed by the law authorizing design patents (formerly act of March 2, 1861, § 11, now *Rev. Stat.* § 4929), is simply for the design itself, not for the means of producing the design. *Clark v. Bousfield*, 10 *Wall.* 133.

The law authorizing patents for designs contemplates its appearance rather than utility ; and that, not an abstract impression, or picture, but an aspect given to one of the objects mentioned in the acts. The thing for which a patent is granted is that which gives a peculiar or distinctive appearance to the manufacture, or article to which it may be applied, or to which it gives form ; not the mode in which those appearances are produced, but the appearance itself. It is the appearance, no matter how caused, that is the patentable element. *Gorham Co. v. White*, 14 *Wall.* 511.

If a new idea is embodied in the method of arrangement, a design patent is not defeated merely because scrolls and ornamentation similar in effect to the scrolls and ornamentation described in the patent have before been employed. The statute permits a patent for any new, useful, and original shape or configuration of any manufacture ; and where these conditions are complied with, the invention is patentable. *Simpson v. Davis*, 12 *Fed. Rep'r*, 144 ; 20 *Blatchf.* 413.

Design patents stand on as high a plane as utility patents, and require as high a degree of exercise of the inventive or originaive faculty ; a person cannot be permitted to select an existing form, and to claim a patent merely for putting it to a new use, any more than he can be permitted to patent a double use of a machine ; but the selection and adaptation of an existing form may amount to patentable design, just as the adaptation of an existing mechanical device may amount to patentable invention. *Western Electric Manuf. Co. v. Odell*, 18 *Fed. Rep'r*, 321.

Although a drawing or casting or pattern of a letter of the alphabet is not, alone, patentable as a new design, the requisite novelty and usefulness may exist in a combination for some pur-

pose, with something else ; as the shape or configuration of the Roman letter G., for a sewing machine, to which configuration the working machinery of the sewing machine is to be applied. *Gibbs v. Ellithorp*, 1 *MacArthur Pat. Cas.* 702.

To show that a design lacked novelty when patented, it is proper to introduce specimens of it as made before complainant's invention. *Theberath v. Rubber & Celluloid Harness Trimming Co.*, 15 *Fed. Rep'r*, 246 ; 6 *N. J. L. J.* 77 ; 23 *Pat. Off. Gaz.* 1121.

Mechanical and design patents, distinguished. See *Cone v. Morgan Envelope Co.*, 4 *Bann. & A. Pat. Cas.* 107.

A beautiful appearance or color which is the mere result of the common efforts of persons ordinarily skilled in a particular art, such as workers in enamel, is not such a design as may be patented ; the law requires that it should be new and original, and the result of invention and genius. *Matter of Niedringhaus*, 2 *MacArthur*, 149.

The law does not require utility in a design in order to sustain a patent, but it does require that the shape or design shall be the result of industry, effort, genius, or expenditure ; the shape or configuration sought to be secured must be new and original, as applied to articles of manufacture. When a well known form was given to a new device, and no advantage whatever was derived from the adoption of such form, except the incidental one of a trade-mark, and the selection was but an arbitrary, chance selection of one of many well known shapes, all equally adapted to the purpose, it was *held*, that the patent could not be sustained. *Wooster v. Crane*, 5 *Blatchf.* 282 ; 2 *Fish. Pat. Cas.* 583.

A design for a card holding buttons arranged in rows, upon spaces marked on the cards, is not "new and useful" in such sense as to be patentable under the law authorizing design patents ; such cards have long been in use. *Pratt v. Rosenfeld*, 3 *Fed. Rep'r*, 335 ; 18 *Blatchf.* 231 ; 10 *Rep'r*, 328 ; 21 *Pat. Off. Gaz.* 866.

An improvement in spelling-blocks, consisting in the placing of two or more letters on each block, is not patentable, although the inventor was the first one to place the letters systematically, with a view to enlarge the usefulness of the blocks. *Hill v. Houghton*, 6 *Pat. Off. Gaz.* 3 ; 1 *Bann. & A. Pat. Cas.* 291.

Modifying the form of sieves by "flaring," so that a number may be "nested," is not new, and therefore is not patentable, even if the idea were a patentable design. *Adams & Westlake Manuf. Co. v. St. Louis Wire Goods Co.*, 3 *Bann. & A. Pat. Cas.* 77.

The mere substitution of one material for another, in the construction or for the purposes of an ornament, the ornament to be "of any approved form," cannot properly be patentable. Thus a design described as "a curtain and loop, consisting of an ornamental metallic chain, in connection with a curtain adapted to be gathered to the side of the window, and be held by said chain;" the claim covering merely the substitution for the old loop, composed of silk or woolen, of one made of metal, no new form or shape being given to the curtain or to the loop, is not patentable as a design, even if such a change can properly be called a design. *Post v. Richards Hardware Co.*, 26 *Fed. Rep'r*, 618. See *Post v. Richards Hardware Co.*, 25 *Fed. Rep'r*, 905; *Theberath v. Rubber & Celluloid Harness Trimming Co.*, 3 *Fed. Rep'r*, 151; 5 *Bann. & A. Pat. Cas.* 584.

311. *Validity of Design Patents.*

The patent is *prima facie* evidence of both the novelty and utility of the design. *Lehnbetter v. Holthaus*, 105 *U. S.* 94; 21 *Pat. Off. Gaz.* 1755.

Where a bill founded on a design patent with a claim for a pattern, and separate claims for each of its parts, is taken as confessed, it alleging infringement of the "invention," the patent will be held valid for the purposes of the suit. *Dobson v. Hartford Carpet Co.*, 114 *U. S.* 439.

A claim of "the design for a carpet, substantially as shown," refers to the description and the drawing, and is valid. *Ib.*

A claim to "the configuration of the design," is a claim to the design, figure, or pattern. *Dobson v. Dorman*, 35 *Pat. Off. Gaz.* 750; 6 *Sup. Ct. Rep'r*, 946.

To constitute a valid patent it is not necessary that the "inventor" (of a design) should personally have the manual skill and dexterity to make the drafts; if the ideas are furnished by him, he may avail himself of the mechanical skill of others to carry them out. *Sparkman v. Higgins*, 1 *Blatchf.* 205; 5 *N. Y. Leg. Obs.* 122.

A preliminary injunction may be granted in a proper case, although there has not been a decision at law sustaining the validity of the patent, nor any long continued public acquiescence. *So held*, in a case of a design patent, but on grounds applicable to cases of mechanical patents. *Foster v. Crossin*, 23 *Fed. Rep'r*, 400.

The claim in a patent for a design for figured silk buttons, was

for the radially formed ornaments on the face of the mould of the button, combined with the mode of winding the covering of the same. The specification described the configuration of the mould and the winding it with various colored threads, but did not describe the process of winding the silk. It was *held*, that the claim did not cover that process, but was for the arrangement of the different colored threads in such manner as to produce the ornaments as described. *Booth v. Garely*, 1 *Blatchf.* 247; 6 *N. Y. Leg. Obs.* 99.

An inventor of a design for buttons manufactured such buttons, and put them upon the market two or three months before he applied for a patent for the design. It was *held*, that the question whether his doing so was an abandonment of his design, was a question of intention, to be determined as a question of fact, on a trial at law; and that a preliminary injunction might well be withheld until such trial should be had. *Ib.*

Billiard tables with beveled ends are old; hence a design for a billiard table, having a greater bevel than has heretofore been used, is void, as not involving any sufficient invention or discovery. *Collender v. Griffith*, 11 *Blatchf.* 212; 3 *Pat. Off. Gaz.* 630. See *Collender v. Griffith*, 18 *Blatchf.* 110.

A combination or aggregation of old designs producing no new appearance, is not patentable; thus a design patent for a rectangular provision-safe, was held invalid, the only originality consisting in the use of two vertical panels in each wall, and a familiar moulding around the top and bottom. *Northrup v. Adams*, 12 *Pat. Off. Gaz.* 430; 2 *Bann. & A. Pat. Cas.* 567.

A design patent is valid when the specification and claim refer for the entire description of the design to a photographic illustration accompanying the specification. *Dobson v. Dorman*, 35 *Pat. Off. Gaz.* 750; 6 *Sup. Ct. Rep'r*, 946.

But where the prominent claim in a design patent is necessarily for figures in relief, a photograph of the design, since it does not show the relief, fails to sufficiently describe the design, in the absence of a minute description in the specification. *Untermeyer v. Jeannot*, 20 *Fed. Rep'r*, 503.

Regulations and provisions applicable to the obtaining or prohibition of patents for inventions or discoveries, not inconsistent with the existing patent act, apply to patents for designs without modification or variation. *Miller v. Smith*, 5 *Fed. Rep'r*, 359; 18 *Pat. Off. Gaz.* 1047.

Design patents, as well as mechanical patents, are avoided by

having been in public use or on sale for more than two years prior to the application. *Theberath v. Rubber & Celluloid Harness, &c. Co.*, 6 *N. J. L. J.* 77; 15 *Fed. Rep'r*, 246.

312. *Infringement of Design Patents.*

It is not essential to constitute infringement, that the appearance of the imitation should be the same as that of the genuine, to the eye of an expert. The test of a patent for a design is the eye of an ordinary observer. If, to an ordinary observer, giving such attention as a purchaser usually gives, two designs are substantially the same, if the resemblance is such that the imitation would deceive such an observer, inducing him to purchase one supposing it to be the other, the one first patented is infringed by the other. *Gorham Manuf. Co. v. White*, 14 *Wall.* 511; reversing 7 *Blatchf.* 513; *Miller v. Smith*, 5 *Fed. Rep'r*, 359; 18 *Pat. Off. Gaz.* 1047; *Dryfoos v. Friedman*, 18 *Fed. Rep'r*, 824; 21 *Blatchf.* 563; *Jennings v. Kibbe*, 10 *Fed. Rep'r*, 669; 22 *Pat. Off. Gaz.* 331; 20 *Blatchf.* 353; *Wood v. Dolby*, 7 *Fed. Rep'r*, 475; *Dreyfus v. Schneider*, 25 *Fed. Rep'r*, 481. In a proper case the court may determine this question of identity by an inspection of the two designs. *Jennings v. Kibbe, supra.*

A patent for a design which covers the ornamentation shown in it, is not infringed by the use of the principal figure without the ornamentation. *Collender v. Griffith*, 11 *Blatchf.* 212; 3 *Pat. Off. Gaz.* 689.

It is an infringement where the difference between the two designs is not appreciable by observing their artistic effect, such differences being merely in detail. *Wood v. Dolby*, 7 *Fed. Rep'r*, 475.

It is an infringement to adopt the design so as to produce substantially the same appearance; adoption of the design in every particular is not necessary. *Root v. Ball*, 4 *McLean*, 177.

Infringement of a design patent may exist notwithstanding the fact that the alleged infringing article is made to carry a distinguishing name or distinguishing marks of other character. *Perry v. Starrett*, 14 *Pat. Off. Gaz.* 599; 3 *Bann. & A. Pat. Cas.* 485.

There may be an infringement of a design without taking the whole of it; but in such cases the part taken must be a part covered by the patent. *Dryfoos v. Friedman*, 18 *Fed. Rep'r*, 824; 21 *Blatchf.* 563.

To constitute an infringement of a patent for a design, there is no necessity that the patented design should be copied in every particular. If the infringing design has the same general appearance, if to the eye of an ordinary person the two are substantially similar there is actionable infringement. *Tomkinson v. Willets Manuf. Co.*, 23 *Fed. Rep'r*, 895; 31 *Pat. Off. Gaz.* 918.

A patent for a design for a fringed lace fabric, the novelty of which appertains to the fringe alone, is not infringed by articles similar to the body of the fabric, but differing as to the fringe. *Jennings v. Kibbe*, 24 *Fed. Rep'r*, 697; 32 *Pat. Off. Gaz.* 653.

313. *Damages or Profits for Such Infringement.*

To warrant an award of more than nominal damages for an infringement of a design, plaintiff must introduce some evidence either of what sum he lost or defendant realized, by the infringement, or of what value was added to the manufactured article by the design; the award of damages or profits in patent cases is a subject of proof, not of mere inference or conjecture. *Dobson v. Hartford Carpet Co.*, 114 *U. S.* 439.

In a suit for infringement of a patent for a design, the remainder of the price realized by defendant from the sale of articles of the patented design, after deducting the cost of making them, and a fair profit for their manufacture, may be presumed to represent the profit realized by the defendant from his adoption of the design; and this presumption is not dispelled by proving that defendant realized the same profit from adopting, in the manufacture of similar articles, a different and unpatented design. *Simpson v. Davis*, 22 *Blatchf.* 113; 22 *Fed. Rep'r*, 444.

Damages for infringement of design patents are to be computed on the same principle as in the case of machine patents; they cannot include the entire profits of the manufacture, but must be confined to the profits which arise from the use of the particular design. *Dobson v. Dorman*, 35 *Pat. Off. Gaz.* 750; 6 *Sup. Ct. Rep'r*, 946; following *Dobson v. Hartford Carpet Co.*, *supra*.

In a suit for infringement of a design for carpets, the evidence showed the quantity of complainant's carpet sold during the season of its introduction, its cost, the profit upon it, the quantity of respondent's carpet sold during the next season, and that there was then a decline in complainant's sales. The measure of damages was *held* to be the profits which would have accrued to complain-

ants on the quantity of carpet sold by defendant. *Bigelow Carpet Co. v. Dobson*, 10 *Fed. Rep'r*, 385 ; 13 *Rep'r*, 265.

314. *Additional Provisions as to Design Patents. Models of Designs.*

The commissioner may dispense with models of designs when the design can be sufficiently represented by drawings or photographs. *Rev. Stat.* § 4930

315. *Duration of Patents for Designs.*

Patents for designs may be granted for the term of three years and six months, or for seven years, or for fourteen years, as the applicant may, in his application, elect. *Rev. Stat.* § 4931.

316. *Extension of Patents for Designs*

Patentees of designs issued prior to the second day of March, eighteen hundred and sixty-one, shall be entitled to extension of their respective patents for the term of seven years, in the same manner and under the same restrictions as are provided for the extension of patents for inventions or discoveries, issued prior to the second day of March, eighteen hundred and sixty one. *Rev. Stat.* § 4932.

This section has become obsolete. See notes to *Rev. Stat.* 4924, *ante*, 483.

317. *Patents for Designs Subject to General Rules of Patent Law.*

All the regulations and provisions which apply to obtaining or protecting patents for inventions or discoveries not inconsistent with the provisions of this title, shall apply to patents for designs. *Rev. Stat.* § 4933.

318. *Copyright of Designs.*

Act of June 18, 1874, c. 301, § 1, contains the following provision, relative to copyright of a class of designs.

No person shall maintain an action for the infringement of his copyright, unless he shall give notice thereof by inserting in the several copies of every edition published . . . if a . . . model or design intended to be perfected and completed as a work of the fine arts, by inscribing upon some visible portion thereof, or of the substance on which the same shall be mounted, the following words, viz: "Entered according to act of Congress, in the year ——, by A. B., in the office of the Librarian of Congress, at Washington;" or, at his option, the word "Copyright," together with the year the copyright was entered, and the name of the party by whom it was taken out; thus— "Copyright, 18—, by A. B." 18 *Stat.* p. 78, § 1. 1 *Supp. Rev. Stat.* 40, § 1.

Where a design patent for a billiard table was declared void, and the defendant had a right to make them as he did, it was *held*, that there was no infringement of a copyright, which was a mere copy of the design, in defendant's publishing an engraving of his tables. *Collender v. Griffith*, 11 *Blatchf.* 212; 3 *Pat. Off. Gaz.* 689.

A copyrighted design for playing cards is infringed by cards which, though differing in some respects, exhibit a striking similarity in those distinctive features of the main design, wherein the cards registered differ from other playing cards previously used. *Richardson v. Miller*, 12 *Pat. Off. Gaz.* 3.

319. *Registration of Prints or Labels.* •

Act of June 18, 1874, c. 301, § 3, contains the following provision relative to registration, in the patent-office, of prints or labels :

No prints or labels designed to be used for any other articles of manufacture shall be entered under the copyright law, but may be registered in the patent-office. And the commissioner of patents is hereby charged with the supervision and control of the entry or registry of such prints or labels, in conformity with the regulations provided by law as to copyright of prints, except that there shall be paid for recording the title of any print or label not a trade-mark, six dollars, which shall cover the expense of furnishing a copy of the record under the seal of the commissioner of patents, to the party entering the same. 18 *Stat.* p. 79, § 3; 1 *Supp. Rev. Stat.* 41, § 3.

The doctrine that the several acts of Congress relating to the registration of prints designed to be used as labels, allow registration of a label which might also be registered as a trade-mark; and that the question whether the commissioner of patents shall regard an application submitted to him for registration as being a trade-mark or a label, depends wholly upon the will of the proprietor (*United States v. Marble*, 1 *Mackey*, 284; 22 *Pat. Off. Gaz.* 1366); has since been overruled in *United States v. Butterworth*, 30 *Pat. Off. Gaz.* 97.

XXV. FEES AND CHARGES.

320. *Fees in obtaining Patents.*

The following shall be the rates for patent fees.

On filing each original application for a patent, except in design cases, fifteen dollars.

On issuing each original patent, except in design cases, twenty dollars.

In design cases: For three years and six months, ten

dollars ; for seven years, fifteen dollars ; for fourteen years, thirty dollars.

On filing each caveat, ten dollars.

On every application for the reissue of a patent, thirty dollars.

On filing each disclaimer, ten dollars.

On every application for the extension of a patent, fifty dollars.

On the granting of every extension of a patent, fifty dollars.

On an appeal for the first time from the primary examiners to the examiners in chief, ten dollars.

On every appeal from the examiners in chief to the commissioner, twenty dollars.

For certified copies of patents and other papers, including certified printed copies, ten cents per hundred words.

For recording every assignment, agreement, power of attorney, or other paper, of three hundred words or under, one dollar ; of over three hundred and under one thousand words, two dollars ; of over one thousand words, three dollars.

For copies of drawings, the reasonable cost of making them. *Rev. Stat.* § 4934.

The above are the fees prescribed by the *Revised Statutes*. The table given in Rule 209 Rules of Practice in the patent-office, is somewhat more minute ; and covers a number of services as to which the statutes have not made any express provision.

The rules of the patent-office prescribe that :

An order for a copy of an assignment must give the liber and page of the record, as well as the name of the inventor ; otherwise an extra charge will be made for the time consumed in making any search for such assignment (*Rules of Prac. No. 210*); and that :

No person will be allowed to make copies or tracings from the files or records of the office. Such copies will be furnished, when ordered, at the rates already specified. *Id.* 211.

The list of prices of publications may be found in the Rules of Practice, Nos. 217, 218.

321. *The Exemption of Government Officers from Payment of Fees.*

The act of March 3, 1883, c. 143, contains the following provision :

The secretary of the interior and the commissioner of patents are authorized to grant any officer of the Government, except officers and employees of the patent-office, a patent for any invention of the classes mentioned in section forty-eight hundred and eighty-six of the Revised Statutes, when such invention is used or to be used in the public service, without the payment of any fee ; *Provided*, That the applicant in his application shall state that the invention described therein, if patented, may be used by the Government, or by any of its officers or employees, in the prosecution of work for the Government, or by any other person in the United States, without the payment to him of any royalty thereon, which stipulation shall be included in the patent. Act of March 3, 1883, 22 Stat. c. 143, p. 625.

322. *Mode of Payment.*

Patent fees may be paid to the commissioner of patents, or to the treasurer, or any of the assistant treasurers of the United States, or to any of the designated depositaries, national banks, or receivers of public money, designated by the secretary of the treasury for that purpose ; and such officer shall give the depositor a receipt or certificate of deposit therefor. All money received at the patent-office, for any purpose, or from any source whatever, shall be paid into the treasury as receiver, without any deduction whatever, *Rev. Stat. § 4935.*

The Rules of Practice numbers 208, 212, 213 and 214, also relate to the mode of payment.

323. *Refunding.*

The treasurer of the United States is authorized to pay back any sum or sums of money to any person who has through mistake paid the same into the treasury, or to any receiver or depository, to the credit of the treasury, as for fees accruing at the patent-office, upon a certificate thereof being made to the treasurer by the commissioner of patents. *Rev. Stat.* § 4936.

See also Rules of Practice No. 215.

FORMS.

[From the Pamphlet: *Rules of Practice in the United States Patent-Office*; ed. 1885.]

PETITIONS.**1. BY A SOLE INVENTOR.**

To the Commissioner of Patents:

Your petitioner, A. B., a citizen of the United States residing at S., in the county of M., and State of N. [*or*, subject, &c.], prays that letters patent be granted to him for the improvement in sewing-machines set forth in the annexed specification.

A. B.

2. BY JOINT INVENTORS.

To the Commissioner of Patents:

Your petitioners, A. B. and C. D., citizens of the United States residing respectively at L., in the county of M., and State of N., and at G., in the county of H., and State of I. [*or*, subject, &c.], pray that letters patent may be granted to them, as joint inventors, for the improvement in washing-machines set forth in the annexed specification.

A. B.

C. D.

3. BY AN INVENTOR FOR HIMSELF AND AN ASSIGNEE.

To the Commissioner of Patents:

Your petitioner, A. B., a citizen of the United States residing at L., in the county

of M., and State of N. [*or*, subject, &c.], prays that letters patent may be granted to himself and C. D., a citizen of the United States residing at L., in the county of M., and State of N., as his assignee, for the improvement in printing presses set forth in the annexed specification.

A. B.

4. PETITION WITH POWER OF ATTORNEY.

To the Commissioner of Patents :

Your petitioner, A. B., a citizen of the United States residing at L., in the county of M., and State of N. [*or*, subject, &c.], prays that letters patent may be granted to him for the improvement in lamps set forth in the annexed specification ; and he hereby appoints C. D.,* of the city of R., State of S., his attorney, with full power of substitution and revocation, to prosecute this application, to make alterations and amendments therein, to receive the patent, and to transact all business in the patent-office connected therewith.

A. B.

5. BY AN ADMINISTRATOR.

To the Commissioner of Patents :

Your petitioner, A. B., a citizen of the United States residing at L., in the county of M., and State of N. [*or*, subject, &c.], administrator of the estate of C. D., late a citizen of S., deceased (as by reference to the duly certified copy of letters of administration, hereto annexed, will more fully appear), prays that letters patent may be granted to him for the invention of the said C. D. (improvement in fire-hose) set forth in the annexed specification.

A. B., *Administrator, &c.*

6. BY AN EXECUTOR.

To the Commissioner of Patents :

Your petitioner, A. B., a citizen of the United States residing at L., in the county of M., and State of N. [*or*, subject, &c.], executor of the last will and testament of C. D., late a citizen of S., deceased (as by reference to the duly certified copy of letters testamentary, hereto annexed, will more fully appear), prays that letters patent may be granted to him for the invention of the said C. D. (improvement in churns), set forth in the annexed specification.

A. B., *Executor, &c.*

7. FOR A REISSUE (BY THE INVENTOR).

To the Commissioner of Patents :

Your petitioner, A. B., a citizen of the United States residing at L., in the county of M., and State of N. [*or*, subject, &c.], prays that he may be allowed to surrender the letters patent for an improvement in coal-scuttles, granted to him May 16, 1867, whereof he is now sole owner [*or*, whereof C. D., on whose behalf and with whose assent this application is made, is now sole owner, by assignment], and that letters patent may be reissued to him [*or*, the said C. D.] for the same invention, upon the annexed amended specification. With this petition is filed an abstract of title, duly certified, as required in such cases.

A. B.

* If the power of attorney is to a firm, the name of each member of the firm must be given in full.

ASSENT OF ASSIGNEE TO REISSUE.

The undersigned, assignee of the entire [or, of an undivided] interest in the above-mentioned letters patent, hereby assents to the accompanying application.

C. D.

8. FOR A REISSUE (BY ASSIGNEE).

(To be used only when the inventor is dead or the original patent was issued and assigned prior to July 8, 1870.)

To the Commissioner of Patents :

Your petitioners, A. B., a citizen of the United States residing at L., in the county of M., and State of N. [or, subject, &c.], and C. D., a citizen of the United States residing at H., in the county of I., and State of K. [or, subject, &c.], pray that they may be allowed to surrender the letters patent for an improvement in coal-scuttles, granted May 16, 1867, to E. F., now deceased, whereof they are now owners, by assignment, of the entire interest, and that the letters patent may be reissued to them for the same invention, upon the annexed amended specification. With this petition is filed an abstract of title [or, an order for making and filing the same, &c.].

A. B.

9. FOR LETTERS PATENT FOR A DESIGN.

To the Commissioner of Patents :

Your petitioner, A. B., a citizen of the United States residing at L., in the county of M., and State of N. [or, subject, &c.], prays that letters patent may be granted to him for the term of three and one-half years [or, seven years, or, fourteen years]* for the new and original design for carpets set forth in the annexed specification.

A. B.

10. CAVEAT

The petition of A. B., a citizen of the United States residing at L., in the county of M., and State of N. [or, subject, &c., see Rule 191], represents :

That he has made certain improvements in cotton-gins, and that he is now engaged in making experiments for the purpose of perfecting the same, preparatory to applying for letters patent therefor. He therefore prays that the subjoined description of his invention may be filed as a caveat in the confidential archives of the patent office.

A. B.

11. FOR THE RENEWAL OF A FORFEITED APPLICATION.

To the Commissioner of Patents :

Your petitioner, A. B., a citizen of the United States residing at L., in the county of M., and State of N. [or, subject, &c.], represents that on May 8, 1868, he filed an application for letters patent for an improvement in fences, serial number 885, which application was allowed July 7, 1868, but that he failed to make payment of the final fee within the time allowed by law. He now makes renewed application for letters patent for said invention, and prays that the original specification, oath, drawings, and model may be used as a part of this application.

A. B.

* Section 4931 of the R. S. requires the election to be made in the original application.

SPECIFICATIONS.

12. FOR AN ART OR PROCESS.

To all whom it may concern :

Be it known that I, A. B., a citizen of the United States residing at L., in the county of M., and State of N. [or, subject, &c.], have invented certain new and useful improvements in purifying and increasing the illuminating power of gas without appreciable loss of bulk (for which I have received letters patent in England, No. 750, dated July 6, 1878*); and I do hereby declare that the following is a full, clear, and exact description of the invention, which will enable others skilled in the art to which it appertains to make and use the same.

Heretofore gas has been purified by passing it through animal charcoal; but when this is used alone, after a short time it loses its power of absorbing impurities, and must then be washed with steam or water, or have atmospheric air blown through it, or be revived by heat. Used alone, animal charcoal also reduces the candle-power of the gas passed through it and diminishes its bulk.

The object of my invention is thoroughly to purify illuminating gas, to make the operation continuous, and to purify the gas without detracting from its illuminating power, and without causing any appreciable diminution in bulk; and to this end my invention consists in increasing the power of animal charcoal to eliminate from illuminating gas those substances which are considered impurities, in charging the charcoal with a substance which will prevent it from depriving the gas of illuminants, and in passing the gas to be purified with atmospheric air through the animal charcoal.

To carry my invention into effect, I moisten the charcoal (which may be either new or spent) with coal-tar, or with coal-tar and water, or in some cases with water only, and then charge this mass into one or more vessels, which then constitute the purifiers. I may put the mass into the vessels while still wet, or, unless water alone is used, after it has dried. Through these vessels the gas is to pass; but before it is admitted I introduce into it at the retorts, or at the stand-pipe or mains beyond, in order to insure a thorough admixture, a small quantity of atmospheric air—say, from eight-tenths to two and a half per cent. of the bulk of the gas to be purified. The quantity of air will depend directly upon the impurities of the gas. Any suitable mixing device for thoroughly mixing the admitted air with the gas may be located at any point in the mains between the retorts and the bone-black purifiers, or even at the point of admission to the purifier. For water-gas, the charcoal wet with water alone will suffice, air being introduced into the gas.

The oxygen of the air partly unites with the sulphur to form soluble salts, and the rest combines totally with the hydrogen of the sulphureted and other hydrogen sulphur compounds to form water, and part of the sulphur of the sulphureted hydrogen and other sulphur compounds is precipitated in a free state in the charcoal, while its nitrogen partly goes to form, with part of the remaining hydrogen, ammonia bases. No free oxygen passes off with the purified gas, while if any nitrogen goes over, the quantity is so small that it is not detrimental.

* If no foreign patent has been obtained, the words in parenthesis should be omitted.

By the application of air in this manner the process is rendered continuous as the charcoal is kept constantly active for a great length of time.

When the absorbing power of the charcoal finally becomes exhausted, it may either be sold for the valuable ammoniacal salts it contains, or it may be revived, or be washed and freed from sulphur by a suitable sulphur solvent for re-use.

By charging the bone-black with coal-tar, I prevent it from taking out of the gas any olefiant gas or other heavy hydrocarbons serving as illuminants.

I may treat the black, either before or after putting it into the vessels, as may be most convenient or suitable, with any substance correlative to the illuminants of the gas—that is, with any substance which will impregnate the black in such a manner that it will not take up such illuminants. I have particularly described coal-tar because that is most readily at hand ; but its hydrocarbon distillates or the benzole series will answer.

In the case of coal-gas, not only is the sulphureted hydrogen with which it is contaminated taken up, as just described, but the illuminating power of the gas, which is somewhat reduced if passed through dry animal charcoal or bone-black, is not decreased when air is used and the animal charcoal or bone-black is wet with tar, but is actually improved, inasmuch as it gives a whiter flame, of the same candle power as the gas not passed through animal charcoal or bone-black at all.

By the old method, when purification was effected by the use of lime, the sulphureted hydrogen and carbonic acid were absorbed by the lime, and the result was, of course, a loss of the original bulk of the gas. Now, by my process the sulphur and hydrogen are separated, the sulphur remaining in the charcoal and the hydrogen passing through with the gas while the carbonic acid passes through entire ; and although it passes through unchanged, it is sufficiently carbureted not to detract from the illuminating power of the gas. I thus have practically the same bulk of gas after purification as before this operation, and loss is prevented without detriment to the consumer.

A striking advantage of my process is, that it unites the scrubbing and purifying operations, for the gas may be passed directly from the condenser into my purifiers.

To eliminate sulphureted hydrogen, I may also mix with the charcoal a substance which will of itself decompose sulphureted hydrogen contained in gas, such as oxide of iron, tin, manganese ore, &c.

When the gas issues from my purifiers it is entirely free from ammoniacal and sulphur compounds, and is nearly inodorous.

When the charcoal is removed from the purifiers it is also inodorous, and is in no sense offensive and disgusting like gas-lime.

Having fully described my invention, what I desire to claim, and secure by letters patent, is—

1. In the purification of illuminating-gas by means of animal charcoal, the process of preventing absorption of illuminants of the gas by the charcoal, which consists in supplying the charcoal with a suitable correlative to such illuminants, as described.

2. The process of purifying illuminating-gas, which consists in mixing the same with air and then passing it through animal charcoal impregnated with coal-tar, all substantially as described.

A. B.

Witnesses :

P. G.
J. D.

13. FOR A MACHINE.

To all whom it may concern :

Be it known that I, A. B., a citizen of the United States residing at L., in the county of M., and State of N. [*or, subject, &c.*], have invented a new and useful Meat chopping Machine (for which I have obtained a patent in Great Britain, No. 870, bearing date June 24, 1878), of which the following is a specification :

My invention relates to improvements in meat-chopping machines in which vertically reciprocating knives operate in conjunction with a rotating chopping-block ; and the objects of my improvements are, first, to provide a continuously lubricated bearing for the block ; second, to afford facilities for the proper adjustment of the knives independently of each other in respect to the face of the block ; and third, to reduce the friction of the reciprocating rod which carries the knives.

I attain these objects by the mechanism illustrated in the accompanying drawing, in which*

A. B.

Witnesses :

C. D.

E. F.

14. FOR A COMPOSITION OF MATTER.

To all whom it may concern :

Be it known that I, A. B., a citizen of the United States residing at L., in the county of M., and State of N. [*or, subject, &c.*], have invented a new and useful composition of matter to be used for the removal of hair and grease from hides preparatory to tanning, of which the following is a specification :

My composition consists of the following ingredients, combined in the proportions stated, viz :

Pure water	500 gallons.
Unslacked lime	32 gallons.
Soda-ash	100 pounds.
Saltpetre	20 pounds.
Flowers of Sulphur	10 pounds.

These ingredients are to be thoroughly mingled by agitation.

In using the above-named composition the hides should first be freed from all salt and impurities, by soaking green hides one day and dry hides eight days, and then placing the hides so cleaned in the said solution, and allowing them to remain in it 48 hours. The hides are then to be removed from the solution and unhaired in the usual way.

By the use of the above composition the hair is speedily and thoroughly loosened and the hides, while retaining all of that portion of the substance which can be converted into leather, are at the same time entirely cleaned from grease and other substances which would prevent them from being tanned quickly.

I am aware that a composition consisting of soda-ash, water, lime, and sulphur has been used for the same purpose, and that a patent therefor was granted to C. D.,

* For the drawing referred to, and the description of the machine see the Rules and directions, p. 58.

July 10, 1875, No. 95,726. I am also aware that saltpetre has been used in depilatory processes; but I am not aware that all of the ingredients of my composition, in the proportion stated, have been used together.

What I claim, and desire to secure by letters patent of the United States, is—

The herein-described composition of matter to be used for depilating hides and preparing them for being tanned, consisting of water, unslacked lime, soda-ash, saltpetre, and flowers of sulphur, in the proportions specified.

A. B.

Witnesses :

C. D.

E. F.

15. FOR A DESIGN.

To all whom it may concern :

Be it known that I, A. B., a citizen of the United States residing at L., in the county of M., and State of N. [*or, subject, &c.*], have invented, and produced a new and original design for watch-cases or lockets, of which the following is a specification, reference being had to the accompanying drawings, forming part thereof.

Figure 1 is a sectional view of my newly-designed case, Fig. 2 a side elevation of same, and Fig. 3 an edge view, these three views being deemed necessary to fully illustrate my design.

Heretofore watch-cases and lockets have been made which presented, when viewed in elevation, as in Fig. 2, a scalloped outline or periphery, some being made to imitate shells. In these the scallops extend entirely across from lid to lid, and in a watch-case the center which holds the movements is also scalloped to correspond.

The leading feature of my design consists in a raised or "struck up" scalloped surface, the outlines of which, when viewed in elevation, as in Fig. 2, will fall entirely within the circular outline or circumference of the center.

A is the center of the case, which is circular in its general contour, and B B are the lids. These are also circular in their outer contour where they join the center, but have scallops C C C formed in some way upon them, substantially as represented in the several figures. The indented outline of the scalloped surface falls within the outer contour line of the case, thus presenting to the eye the combined effect of a smooth circular outline or center and an indented or scalloped outline within it.

I claim—

1. The design for a watch-case or locket herein shown and described, the same consisting of the raised scallops C C C on the lid, forming an indented outline wholly within the circular outline of the edge of the lid and the center A.

2. The design for a watch-case or locket herein shown and described, the same consisting of a circular lid, B, having a connected series of raised scallops, C C C, the contour of the same being entirely within the contour of the lid.

A. B.

Witnesses :

C. D.

E. F.

16. FOR A CAVEAT.

To the Commissioner of Patents :

Be it known that I, A. B., a citizen of the United States residing at L., in the county of M., and State of N. [*or, subject, &c. See Rule 191.*], having invented an

improvement in velocipedes, and desiring further to mature the same, file this my caveat therefor, and pray protection of my right until I shall have matured my invention.

The following is a description of my newly-invented velocipede, which is as full, clear, and exact as I am able at this time to give, reference being had to the drawing hereto annexed.

This invention relates to that class of velocipedes in which there are two wheels connected by a beam forming a saddle for the rider, the feet being applied to cranks that revolve the front wheel.

The object of my invention is to render it unnecessary to turn the front wheel so much as heretofore, and at the same time to facilitate the turning of sharp curves. This I accomplish by fitting the front and the hind wheels on vertical pivots, and connecting them by means of a diagonal bar, as shown in the drawing, so that the turning of the front wheel also turns the back wheel with a position at an angle with the beams, thereby enabling it easily to turn a curve.

In the drawing, A is the front wheel, B the hind wheel, and C the standards extending from the axle of the front wheel to the vertical pivot E, in the beam F, and D is the cross-bar upon the end of E, by which the steering is done. The hind wheel B is also fitted with jaws G and a vertical pivot H.

A. B.

Witnesses :

C. D

E. F

OATHS.

17. BY AN INVENTOR.

(To follow specification.)

STATE OF _____, County of _____, ss :

_____, the above-named petitioner, citizen of _____, and resident of _____ in the county of _____ and State of _____, being duly sworn (or affirmed), depose and say that² _____ verily believe³ _____ to be the original, first, and⁴ _____ inventor of the improvement in⁵ _____ described and claimed in the foregoing specification ; that the same has not been patented to⁶ _____, or to others with⁷ _____ knowledge or consent, except in the following countries :⁸ _____ ; that the same has not to⁹ _____ knowledge been in public use or on sale in the United States, for more than two years prior to this application, and¹⁰ _____ do not know and do not believe that the same was ever known or used prior to¹¹ _____ invention thereof.

(Inventor's full name):

¹ If the applicant be an alien, he will state of what foreign or sovereign state he is a citizen or subject.

² "He" or "they."

³ "Himself" or "themselves."

⁴ "Sole" or "joint."

⁵ Insert title of invention.

⁶ "Himself" or "themselves."

⁷ "His" or "their."

⁸ Here insert, if previously patented, the country or countries in which it has been so patented, giving the date and number of each patent. If not previously patented, erase the words "except in the following countries" and insert the words "in any country."

⁹ "His" or "their."

¹⁰ "He" or "they."

¹¹ "His" or "their."

of March, 1869, being duly sworn [or, affirmed], deposes and says that he verily believes himself to be the original and first inventor of the improvement as described and claimed in the foregoing amendment, in addition to that which was embraced in the claims originally made, and that he does not know and does not believe that the same was ever before known or used, and that the matter sought to be inserted formed a part of his original invention at the date of filing said application.

A. B.

Sworn to and subscribed before me this 11th day of July, 1870.

C. D.,

[Official title.]

22. OATH AS TO THE LOSS OF LETTERS PATENT.

STATE OF I., County of K., ss :

A. B., of said county, being duly sworn [or, affirmed], doth depose and say that the letters patent No. 12,213, granted to him, and bearing date on the 9th day of January, A. D. 1855, have been either lost or destroyed; that he has made diligent search for the said letters patent in all places where the same would probably be found, if existing, and that he has not been able to find them.

A. B.

Subscribed and sworn to before me this 5th day of October, 1868.

C. D.,

[Official title.]

23. OATH OF ADMINISTRATOR AS TO THE LOSS OF LETTERS PATENT.

STATE OF I., County of K., ss :

A. B., of said county, being duly sworn, doth depose and say that he is administrator of the estate of E. F., deceased, late of L., in said county; that the letters patent No. 12,219, granted to said E. F., and bearing date of the 9th day of January, A. D. 1855, have been lost or destroyed, as he verily believes; that he has made diligent search for the said letters patent in all places where the same would probably be found, if existing, and especially among the papers of the decedent, and that he has not been able to find said letters patent.

A. B.,

Administrator, &c.

Subscribed and sworn to before me this 5th day of October, 1868.

C. D.,

[Official title.]

24. POWER OF ATTORNEY AFTER APPLICATION FILED.

If the power of attorney be given at any time other than that of making application for letters patent, it will be in substantially the following form :

To the Commissioner of Patents :

The undersigned having, on or about the 20th day of July, 1859, made application for letters patent for an improvement in horse-powers (Serial Number 982), hereby appoints C. D., of L., in the county of M., and State of N., his attorney, with full power of substitution and revocation, to prosecute said application, to make alterations and amendments therein, to receive the patent, and to transact all business in the patent-office connected therewith.

Signed at L., in the county of M., State of N., this 6th day of June, 1870.

A. B.

25. REVOCATION OF POWER OF ATTORNEY.

To the Commissioner of Patents :

The undersigned having, on or about the 26th day of December, 1867, appointed C. D., of L., in the county of M., and State of N., his attorney to prosecute an application for letters patent, which application was filed on or about the 1st day of June, 1868, for an improvement in the running gear of wagons (Serial Number 870), hereby revokes the power of attorney then given.

Signed at L., in the county of M., and State of N., this 21st day of July, 1869.

A. B.

26. AMENDMENT.*

To the Commissioner of Patents.:

In the matter of my application for letters patent for an improvement in sewing machines, filed May 1, 1879 (Serial Number 540), I hereby amend my specification as follows :

By striking out all between the 5th and 20th lines, inclusive, of page 3 ;

By inserting the words *connected with* after the word " and " in the 1st line of the 2d claim ; and

By striking out the 3d claim, and substituting therefor the following :

" 3. The combination, with the driving shaft, the needle-bar, and mechanism for reciprocating the same, of the shuttle-carrier, the shuttle-lever, and a cam carried by the driving-shaft, whereby the proper reciprocating movement is imparted to the shuttle-carrier, and the needle-bar is caused to operate in unison therewith, substantially as described."

Signed at L., in the county of M., and State of N.

A. B.,

By S. Z.,

His Attorney in Fact.

DISCLAIMERS.

27. DISCLAIMER AFTER PATENT.

To the Commissioner of Patents :

Your petitioner, A. B., a citizen of the United States, residing at L., in the county of M., and State of N. [*or, subject, &c.*], represents that in the matter of a certain improvement in printing-presses, for which letters patent of the United States No. 76,000 were granted to C. D., on the 12th day of June, 1879, here is [here state the exact interest of the disclaimant; if assignee, set out liber and page where assignment is recorded], and that he has reason to believe that, through inadvertence [accident or mistake], the specification and claims of said letters patent are too broad, including that of which said patentee was not the first inventor. Your petitioner therefore, hereby enters his disclaimer to that part of the claim in said specification which is in the following words, to wit :

" I also claim the sleeves A B, having each a friction-cam, C, and connected,

* In the preparation of all amendments a separate paragraph should be devoted to each distinct erasure or inser-

tion, in order to aid the office in making the entry of the amendment into the case to which it pertains.

respectively, by means of chains or chords K L and M N, with an oscillatory lever, to operate substantially as herein shown and described."

A. B.

Witness:
C. D.

28. DISCLAIMER DURING INTERFERENCE.

Interference.

A. B. }
v. } Before the examiner of interferences.
C. D. }

Subject-matter: Sewing machines.

To the Commissioner of Patents:

SIR: In the matter of the interference above noted, under the provisions of and for the purpose set forth in Rule 104, I disclaim [set forth the matter as given in declaration of interference], as I am not the first inventor thereof, and I herewith transmit an amendment to my application (Serial Number 1556), for the purpose of having the above disclaimer embodied as part of my specification.

Signed at L., in the county of N, and State of N., this 15th day of June, 1879.

A. B.

Witnesses:
E. F.
G. H.

APPEALS.

29. FROM A PRINCIPAL EXAMINER TO THE EXAMINERS-IN-CHIEF.

To the Commissioner of Patents:

SIR: I hereby appeal to the examiners-in-chief from the decision of the principal examiner in the matter of my application for letters patent for an improvement in wagon-brakes, filed January 10, 1869, which on the 20th day of July, 1869, was rejected the second time. The following are the points of the decision on which the appeal is taken: [*Here follows a statement of the points on which the appeal is taken, as provided in Rule 128.*]

[*Place and date of signing.*]

A. B.

30. FROM A PRINCIPAL EXAMINER TO THE COMMISSIONER.

To the Commissioner of Patents:

SIR: I hereby appeal to you in person from the decision of the principal examiner, made April 7, 1879, in the case of my application for letters patent for an improvement in harvesters, filed January 10, 1879, wherein he refused to consider the case upon its merits until certain alleged inaccuracies of expression in the specification should be corrected. The following are the points of the decision on which the appeal is taken: [*Here follow points on which appeal is taken.*]

[*Place and date of signing.*]

A. B.

31. FROM THE EXAMINERS-IN-CHIEF TO THE COMMISSIONER.

To the Commissioner of Patents:

SIR: I hereby appeal to you in person from the decisions of the examiner-in-chief made April 7, 1879, in the interference between my application for letters patent for

improvement in sewing-machines and the letters patent of A. B., in which priority of invention was awarded to said A. B. The following are assigned for reasons of appeal: [*Here should follow an explicit statement of the alleged errors in the decision of the examiners-in-chief.*]

C. D.

32. FROM THE EXAMINER IN CHARGE OF INTERFERENCES TO THE EXAMINERS-IN-CHIEF.

To the Commissioner of Patents:

SIR: I hereby appeal to the examiners-in-chief from the decision of the examiner of inferences in the matter of the interference between my application for letters patent for improvement in sewing machines and the letters patent of A. B., in which priority of invention was awarded to said A. B. The following are assigned for reasons of appeal: [*Here should follow an explicit statement of the alleged errors in the decision of the examiner of interferences.*]

C. D.

33. FROM THE EXAMINERS-IN-CHIEF TO THE COMMISSIONER.

To the Commissioner of Patents:

SIR: We hereby appeal to the commissioner in person from the decision of the examiners-in-chief in the matter of our application for the reissue of letters patent for an improvement in cotton-presses, granted to A. B., May 18, 1865. The following are assigned for reasons of appeal: [*Here follow the reasons as in Form 31.*]

C. D.

E. F.

34. FROM THE COMMISSIONER TO THE SUPREME COURT OF THE DISTRICT OF COLUMBIA.

WASHINGTON, D. C., July 20, 1871.

To the Supreme Court of the District of Columbia, in banc:

The petition of A. B., of L., in the county of M., and State of N., respectfully sheweth: That he has heretofore invented a new and useful improvement in velocipedes; that on or about the 1st day of May, 1870, he applied to the patent-office of the United States for a patent for the same [*or, for the reissue of a patent granted therefor under date of June 10, 1862*], and complied with the requirements of the several acts of congress, and with the rules of the patent-office prescribed in such cases; that his said application was rejected by the commissioner of patents, on appeal to him, on or about June 20, 1871; that he has filed in said office due notice to the commissioner of patents of this his appeal, accompanied with the reasons of appeal; and that the commissioner has furnished him with complete copies of all the original papers and evidence in the case, all of which, together with a copy of the reasons of appeal, accompany this petition, and are to be taken as a part hereof.

And the said A. B. prays that his said appeal may be heard and determined by your honorable court at such early time as may be appointed for that purpose; and that the commissioner of patents may be duly notified of the same, and directed in what manner to give notice thereof to the parties interested.

A. B.

To the Commissioner of Patents:

A. B., of L., in the county of M., and State of N., hereby gives notice that he has appealed from your decision, rendered on or about the 20th day of June, 1871, rejecting his application for a patent [*or, for a reissue of a patent granted to him June 10,*

1862], for an improvement in velocipedes ; and of this you are respectfully requested to take notice.

And the said A. B. assigns the following reason for appealing from the said decision of the commissioner of patents, viz:

[*Here follow reasons, which should be full and explicit, and constitute a brief of the appellant's argument.*]

A. B.

35. PRELIMINARY STATEMENT.

A. B. } Interference in the U. S. patent-office.
 vs. } Preliminary statement of A. B.
 C. D. }

A. B., of L., in the county of M., and State of N., being duly sworn, doth depose and say that he is a party to the interference declared by the commissioner of patents June 3, 1879, between A. B.'s application for letters patent, filed May 6, 1879, and the patent of C. D., granted April 20, 1879, for a twine-machine; that he conceived the invention set forth in the declaration of interference, on or about the 1st of June, 1877; that during the said month he made drawings of the invention and explained it to others; that he made a model showing the invention on or about July 20, 1877; that he embodied it in a full-sized machine, which was completed on or about August 15, 1877; that on the 21st day of the last-named month he successfully operated the said machine at his shop in the town of L., county of M., and State of N., and that he has since continued to use the same machine, and has also manufactured others for use and sale.

A. B.

Subscribed and sworn to before me this 10th day of April, 1879.

E. F.,

[*Official title.*]

36. RULES OF THE SUPREME COURT IN APPEALS FROM THE COMMISSIONER OF PATENTS, ADOPTED NOVEMBER 30, 1870.

1. The appellant's petition shall be addressed to the court, and shall be substantially as follows :

" *To the Supreme Court of the District of Columbia, in banc, ———— 187—.*

" The petition of _____, a citizen of _____, in the [*State, Territory district*] of _____, respectfully shows as follows :

" (1.) About the _____ day of _____, 18____, I invented [*describe the subject of the desired patent in the identical words of the application to the patent-office.*]

" (2.) On the _____ day of _____, 18—, in the manner prescribed by law, I presented my application to the patent-office, praying that a patent be issued to me for said invention.

" (3.) Such proceedings were had in said office, upon said application, that on the _____ day of _____, 18____, it was rejected by the commissioner of patents.

" (4.) I thereupon appealed to this court, and gave notice thereof to the commissioner, and filed in his office the following reasons for said appeal :

" (5.) The commissioner of patents has furnished me a complete copy of all the proceedings in his office upon my said application, which copy has been filed herewith, and is to be taken as part hereof.

"(6.) And thereupon I pray that the court do revise and reverse said decision, to the end that justice may be done in the premises.

"_____."

2. This petition shall be filed in the clerk's office of this court ; and as soon as the petitioner has made the deposit required by law at the commencement of suits in this court, or said deposit has been dispensed with, the clerk shall enter the case in a docket to be provided by him for the purpose, and in which a brief of said filing and of all subsequent proceedings in the case shall be entered as and when they successively occur, down to and including the final decision.

3. The clerk shall provide a minute-book of his office, in which he shall record every order, rule, judgment, or decree of the court in each case, in the order of time in which said proceedings occur ; and of this book there shall be two alphabetical indexes, one showing the name of the party applying for the patent, and the other designating the invention by its subject-matter or name.

4. The cases in the docket of causes shall be successively numbered from No. 1 onward, and each case shall also be designated by the number assigned to it on the records of the patent-office.

5. This docket shall be called for the trial of the cases thereon on the first day of each session of this court in general term, provided the petition has been filed ten days before the commencement of the term.

6. The opinions of the court, when written, shall be kept by the clerk, in the order of their delivery and in a temporary book-file, indexed ; and when so many have been delivered as will make a volume of convenient size, he shall cause them to be bound.

7. The clerk shall furnish to any applicant a copy of any paper in any of said appeals on payment of the lawful fees.

8. Hearings of said appeals shall be subject to the rules of the court provided for other causes therein.

9. When the testimony of the commissioner, or of any examiner, touching the principles of invention in question, shall be deemed necessary, it shall be taken orally in open court, unless otherwise ordered by the court. And, in such case, the court may order it to be reduced to writing, and filed or entered on its minutes, if it think proper.

10. The final judgment or order of the court shall not recite any of the facts made to appear in the case, but shall be to the following effect :

" This appeal having been heard upon the record from the patent office [*add* and upon the testimony of the commissioner of patents [*or*, of one of the examiners] [touching the principles of the invention], and having been argued by [counsel for] the petitioner and [for] the commissioner :

" It is thereupon ordered and adjudged that the [petition be dismissed] [*or*, commissioner do issue to the petitioner a patent] [as prayed], [granting the petitioner (*so and so*)]. -

" And that the clerk of this court transmit to the commissioner of patents a copy of this decree duly authenticated."

ASSIGNMENTS.

37. OF AN ENTIRE INTEREST IN AN INVENTION BEFORE THE ISSUE OF LETTERS PATENT.

Whereas I, A. B., of L., county of M., State of N., have invented a certain new and useful improvement in harvesters [giving title of the same], for which I am about to make application for letters patent of the United States; and whereas G. D., of R., county of S., State of N., is desirous of acquiring an interest in said invention, and in the letters patent to be obtained therefor:

Now, therefore, to all whom it may concern, be it known that, for and in consideration of the sum of five thousand dollars to me in hand paid, the receipt of which is hereby acknowledged, I, the said A. B., have sold, assigned, and transferred, and by these presents do sell, assign, and transfer unto the said G. D., the full and exclusive right to the said invention, as fully set forth and described in the specification prepared and executed by me on the —— day of ——, 188—, preparatory to obtaining letters patent of the United States therefor; and I do hereby authorize and request the Commissioner of Patents to issue the said letters patent to the said G. D., as the assignee of my entire right, title, and interest in and to the same, for the sole use and behoof of the said G. D. and his legal representatives.

In testimony whereof I have hereunto set my hand and affixed my seal this 4th day of May, A. D. 1879.

A. B. [SEAL.]

In presence of—

O. P.

S. T.

38. OF THE ENTIRE INTEREST IN LETTERS PATENT.

Whereas I, A. B., of L., county of M., State of N., did obtain letters patent of the United States for an improvement in car-wheels, which letters patent are numbered 95,000, and bear date the 5th day of June, in the year one thousand eight hundred and sixty-nine, and whereas I am now the sole owner of said patent and of all rights under the same; and whereas E. F., of R., county of S., State of N., is desirous of acquiring the entire interest in the same:

Now, therefore, to all whom it may concern, be it known that, for and in consideration of the sum of five thousand dollars to me in hand paid, the receipt of which is hereby acknowledged, I, the said C. D., have sold, assigned, and transferred, and by these presents do sell, assign, and transfer unto the said E. F., the whole right, title, and interest in and to the said improvement in car-wheels, and in and to the letters patent therefor aforesaid; the same to be held and enjoyed by the said E. F., for his own use and behoof, and for the use and behoof of his legal representatives, to the full end of the term for which said letters patent are or may be granted [thus including extension], as fully and entirely as the same would have been held and enjoyed by me had this assignment and sale not been made.

In testimony whereof I have hereunto set my hand and affixed my seal at L., in the county of M., and State of N., this 25th day of July, A. D. 1878.

A. B. [SEAL.]

In presence of—

N. P.

O. T.

39. OF AN UNDIVIDED INTEREST IN LETTERS PATENT.

Whereas I, A. B., of L., county of M., State of N., did obtain letters patent of the United States for an improvement in hay-rakes, which letters patent are numbered 89,920, and bear date the 3rd day of August, in the year one thousand eight hundred and sixty; and whereas C. D., of R., county of S., State of N., is desirous of acquiring an interest in the same:

Now, therefore, to all whom it may concern, be it known that, for and in consideration of the sum of five hundred dollars to me in hand paid, the receipt of which is hereby acknowledged, I, the said A. B., have sold, assigned, and transferred, and by these presents do sell, assign, and transfer unto the said D. E., the undivided one-half part of the whole right, title, and interest in and to the said invention, and in and to the letters patent therefor aforesaid; the said undivided one-half part to be held and enjoyed by the said C. D., for his own use and behoof, and for the use and behoof of his legal representatives, to the full end of the term for which said letters patent are or may be granted [thus including extension], as fully and entirely as the same would have been held and enjoyed by me had this assignment and sale not been made.

In testimony whereof I have hereunto set my hand and affixed my seal at L., in the county of M., and State of N., this 7th day of June, A. D. 1862.

A. B. [SEAL.]

In the presence of—

N. P.

O. T.

40. TERRITORIAL INTEREST AFTER GRANT OF PATENT.

Whereas I, A. B., of L., county of M., State of N., did obtain letters patent of the United States for improvement in grain-binders, which letters patent are numbered 87,564 and bear date the 8th day of June, in the year one thousand eight hundred and sixty; and whereas I am now the sole owner of the said patent and of all rights under the same in the below-recited territory; and whereas C. D., of R., county of S., State of N., is desirous of acquiring an interest in the same:

Now, therefore, to all whom it may concern, be it known that, for and in consideration of the sum of five thousand dollars to me in hand paid, the receipt of which is hereby acknowledged, I, the said A. B., have sold, assigned and transferred, and by these presents do sell, assign, and transfer, unto the said C. D., all the right, title, and interest in and to the said invention, as secured to me by said letters patent, for, to, and in the State of N., and for, to, or in no other place or places; the same to be held and enjoyed by the said C. D. within and throughout the above-specified territory, but not elsewhere, for his own use and behoof, and for the use and behoof of his legal representatives, to the full end of the term for which said letters patent are or may be granted (thus including extension), as fully and entirely as the same would have been held and enjoyed by me had this assignment and sale not been made.

In testimony whereof I have hereunto set my hand and affixed my seal at L., in the county of M., and State of N., this 3rd day of May, A. D. 1861.

A. B. [SEAL.]

In the presence of—

S. T.

R. D.

41. LICENSE—SHOP-RIGHT.

In consideration of the sum of fifty dollars, to be paid by the firm of S. J. & Co., of L., in the county of M., State of N., I do hereby license and empower the said S. J. & Co. to manufacture in said L. [or other place agreed upon] the improvement in cotton-seed planters, for which letters patent of the United States No. 71,846 were granted to me, November 13, 1868, and to sell the machines so manufactured throughout the United States, to the full end of the term for which said letters-patent are granted.

Signed at L., in the county of M., and State of N., this 22d day of April, 1869.

A. B.

42. LICENSE—NOT EXCLUSIVE—WITH ROYALTY.

This agreement, made this 12th day of September, 1868, between A. B., of L., in the county of M., and State of N., party of the first part, and C. D. & Co., of O., in the county of R., and State of S., party of the second part, witnesseth, that whereas letters patent of the United States No. 67,540, for an improvement in horse-rakes were granted to the party of the first part, dated October 4, 1867; and whereas the party of the second part is desirous of manufacturing horse-rakes, containing said patented improvement: Now, therefore the have agreed as follows:

I. The party of the first part hereby licenses and empowers the party of the second part to manufacture, subject to the conditions hereinafter named, at their factory in O., and in no other place or places, to the end of the term for which said letters patent were granted, horse-rakes containing the the patented improvements, and to sell the same within the United States.

II. The party of the second part agrees to make full and true returns to the party of the first part, under oath, upon the first days of July and January in each year, of all horse-rakes containing the patented improvements manufactured by them.

III. The party of the second part agrees to pay to the party of the first part five dollars as a license-fee upon every horse-rack manufactured by said party of the second part containing the patented improvements; provided, that if the said fee be paid upon the days provided herein for semi-annual returns, or within ten days thereafter, a discount of fifty per cent. shall be made from said fee for prompt payment.

IV. Upon a failure of the party of the second part to make returns or to make payment of license-fees, as herein provided, for thirty days after the days herein named, the party of the first part may terminate this license by serving a written notice upon the party of the second part; but the party of the second part shall not thereby be discharged from any liability to the party of the first part for any license-fees due at the time of the service of said notice.

In witness whereof the parties above named have hereunto set their hands the day and year first above written, at L., in the county of M., and State of N.

A. B.

C. D. & CO.

EXTENSIONS.

Forms numbered 43 to 48 inclusive are omitted because they relate to proceedings to obtain extensions, only.

DEPOSITIONS.

49. NOTICE OF TAKING TESTIMONY.

BOSTON, MASS., *March 29, 1869.*

In the matter of the interference between the application of A. B. for a paper-collar machine, and the patent No. 25,038, granted December 15, 1868, to C. D., now pending before the commissioner of patents.

Sir: You are hereby notified that on Wednesday, March 31, 1869, at the office of E. F., esq., No. 30 Court street, Boston, Mass., at nine o'clock in the forenoon, I shall proceed to take the testimony of G. H., J. K., and L. M., all of B., as witnesses in my behalf.

The examination will continue from day to day until completed. You are invited to attend and cross-examine.

A. B.,
By R. S., *his Attorney.*

[Place and date of signing.]

Proof of service.

STATE OF M., *County of N., ss:*

Personally appeared before me, a justice of the peace [or other officer], the above-named A. B., who, being duly sworn, deposes and says that he served the above notice upon O. P., the attorney of the said C. D., at one o'clock p. m. of the 30th day of March, 1869, by leaving a copy at his office in R., in the county of S., and State of N., in charge of his partner, R. S.

A. B.

Sworn to and subscribed before me at L., in the county of M. and State of N., this 31st day of March, 1869.

E. F.,
[*Official title.*]

[*Service may be acknowledged by the party upon whom it is made, as follows:*

Service of the above notice acknowledged this 30th day of March, 1869.

C. D.,
By E. F., *his Attorney.*]

50. FORM OF DEPOSITION.

Before the commissioner of patents, in the matter of the interference between the application of A. B. for a paper-collar machine and letters patent No. 25,038, granted December 15, 1868, to C. D.

Depositions of witnesses examined on behalf of A. B., pursuant to the annexed notice, at the office of E. F., No. 30 Court street, Boston, Mass., on Wednesday, March 31, 1869. Present, S. T., esq., on behalf of A. B., and V. W., esq., on behalf of C. D.

G. H., being duly sworn [*or, affirmed*], doth depose and say, in answer to interrogatories proposed to him by S. T., esq., counsel for A. B., as follows, to wit:

Question 1. What is your name, age, residence, and occupation?

Answer 1. My name is G. H.; I am forty-three years of age; I am a manufacturer of paper collars, and reside at C., in the State of M.

Question 2, &c.

And in answer to cross-interrogatories proposed to him by V. W., esq., counsel for C. D., he saith:

Cross-question 1. How long have you known A. B.?

Answer 1. G. H.

51. CERTIFICATE OF OFFICER.

(To follow deposition.)

STATE OF M., County of N., ss :

I, A. B., a notary public within and for the county of M., and State of N. [or other officer, as the case may be], do hereby certify that the foregoing deposition of C. D. was [or, depositions of C. D., E. F., &c., were] taken on behalf of G. H., in pursuance of the notice hereto annexed, before me at—, in the city [or, town, &c.] of K., in said county, on the—day [or days] of August, 1879; that said witness [or, each of said witnesses] was by me duly sworn before the commencement of his testimony; that the testimony of said witness [or, of each of said witnesses] was written out by myself [or, by O. P. in my presence]; that the opposing party, X. Y., was present [or, absent] during the taking said testimony; that said testimony was taken at—, and was commenced at 9 o'clock a. m. on the 21st of August, 1879, was continued pursuant to adjournment on the 22d, 23d [&c.], and was concluded on the 28th of said month; that I am not connected by blood or marriage with either of said parties, nor interested directly or indirectly in the matter in controversy.

In testimony whereof I have hereunto set my hand and affixed my seal of office, at —, in said county, this 1st day of September, 1879.

S. T.,

[Official title.]

The magistrate will then append to the deposition the notice under which it was taken, and will seal up the testimony, and direct it to the commissioner of patents, placing upon the envelope a certificate, in substance as follows:

I hereby certify that the within deposition of G. H. [if the package contains more than one deposition give all the names], relating to the matter of interference between A. B. and C. D., was taken, sealed up, and addressed to the commissioner of patents by me this 26th day of April, A. D. 1869.

E. F.,

[Official title.]

URUGUAY.

*Law of Industrial Patents, November 13, 1885.**

CHAPTER I.

GENERAL PROVISIONS.

ARTICLE 1. Authorizes the Executive Power to issue patents with exclusive rights for inventions, or improvements upon inventions.

ART. 2. It has the same power with respect to the persons who, having taken out a patent in a foreign country, solicit a privilege to carry on the industry in the country, provided the application be made within the first year of the original patent and the applicant be either the inventor himself, his attorney, or lessee of the patent.

ART. 3. New discoveries or inventions of any description entitle the authors thereof to the exclusive right of working the same for the period and under the conditions expressed in this Law.

ART. 4. The following are considered discoveries or new inventions: New products of industry, new methods or means and new application of known methods or means for the attainment of a result or industrial product.

ART. 5. Patent rights will not be granted for financial schemes discoveries or inventions well known in the country or abroad, in written works, or printed periodicals, which are purely theoretic and which do not show practically their proper application, chemical compositions, and such as be contrary to the laws of morality and the republic.

ART. 6. The Government does not guarantee either the merit or the priority of discoveries or inventions.

ART. 7. Patents will be granted for 3, 6 or 9 years according to the request of the applicant.

ART. 8. Upon each patent an annuity of \$25 shall be paid whilst the privilege lasts.

ART. 9. The payment of the annuities referred to shall be effected in the Credito Publico office within the first ten days of

* There is a later decree which regulates only the granting of patents, the conduct of the patent-office, &c.

each year, under penalty of loss or cancelment of the privilege, and the letters patent will not be issued until the first of these annuities be paid by the applicant or applicants for the patents.

ART. 10. The term of ten days mentioned in the preceding article having expired without the payment being effected, the Executive Power will entertain, and in such case give preference to applications for privileges of the same nature which may be presented by other interested parties.

ART. 11. In all cases where a privilege is granted the Executive Power, previously informed by the council of public health upon privileges for unhealthy industries, shall designate a reasonable term within which to commence working the industry to which the patent refers.

ART. 12. Upon the commencement of working the industry within the term stipulated by the Executive Power, the patentee in a petition to the patent-office shall give notice of the said working stating the place where the work is carried on, which petition shall be annexed to the despatch and forwarded to the head office of public works and the board of health for their report as to the full observance of the terms of the privilege.

ART. 13. In the case of *force majeure* or difficulties occurring which can possibly justify delay in the establishment of the industry within the term designated by the Executive Power under article 11, the patentee shall be able to petition the Legislative Power for a prolongation of the term to commence working.

This petition for prolongation should be made at least three months before the termination of such term.

CHAPTER II.

PATENT-OFFICE.

ART. 14. The letters patent referred to in the preceding articles shall be inscribed upon the stamped paper designated by the law and by the department of trade and commercial marks, which from the promulgation of this law shall be styled "Office of Patents of Inventions, Trade and Commercial Marks."

The letters patent shall be sealed and signed by the *ministro de gobierno*, whose signature shall be countersigned by the chief of the aboved-named office.

ART. 15. The staff of the office shall be composed of a chief and a secretary with the salaries allowed by the budget.

ART. 16. No employe of this office may have, directly or indirectly, any interest in the privileges he may have to deal with, under penalty of immediate dismissal after the fact be proved.

ART. 17. The chief of the office is responsible to the government for all papers and objects deposited which he shall preserve with the greatest care and order.

ART. 18. This office will be under the direction of the *ministro de gobierno*.

CHAPTER III.

FORMALITIES FOR THE CONCESSION OF PATENTS.

ART. 19. Any person wishing to obtain a patent shall present a petition on paper, bearing a stamp of one dollar on each sheet, addressed to the *ministro de go'erno*, and hand it to the chief of the "patent and marks of factories and commerce office" who will despatch it immediately upon its receipt so that it may be duly dealt with.

On the said petition the last named office must note the day and hour at which it was presented.

ART. 20. A specification in duplicate must be attached to the petition giving a clear and sufficient description of the invention, together with samples, drawings, or models, according to the nature of the case, and also an oath declaring the invention to be the property of the applicant and asking for a patent securing his rights.

The samples, models, etc., presented with and accompanying the petition, must be substantial and well made.

ART. 21. The petition shall simply ask for the privilege (patent) stating the term for which it is desired, and must not contain restrictions, conditions, or reserves; it must indicate the title under which the inventor may designate it and describe the invention precisely, and must be written in Spanish with all corrections or erasures which may appear in the text being duly testified. The drawings accompanying it must be made in ink and according to the metric scale established in the republic.

ART. 22. The patent will be granted in the name of the nation and will be guaranteed by the decree granting it, which will be accompanied by the specifications and drawings.

ART. 23. The grant of the patent will not affect the dispositions of article 35.

ART. 24. Every three months the chief of the patent-office will send to the Government a concise and detailed report upon patents issued, for publication.

ART. 25. He will also send an annual report to the general directory of statistics of the patents granted, the term of their duration and the amount paid by the patentees.

ART. 26. Every two years the patent-office shall publish, in one volume, all the despatches of patents granted with descriptions of same and their respective drawings and models.

CHAPTER IV.

CERTIFICATES OF ADDITION OF IMPROVEMENTS UPON INVENTIONS.

ART. 27. Any one who may improve upon a patented discovery or invention shall have the right to solicit an extra certificate which will in no case be granted for a longer period than the remainder of the term of the original patent.

The extra certificate shall be issued on the stamped paper designated by the law, and be signed and sealed by the *ministro de gobierno* and indorsed by the chief of the patent-office. The stamp on this certificate is \$100.

ART. 28. To obtain an extra certificate the same formalities shall be observed as for a patent, excepting the tax, of which only a third part of that corresponding to the patent shall be paid when the applicant be the original patentee and two thirds when he be a third party.

ART. 29. When the extra certificate is obtained by a third party, he shall not enjoy the entire exploration of the invention without paying a share to the original inventor, the amount of which shall be determined by two experts appointed by the interested parties, and a third in case of disagreement, taking into consideration the importance of the improvement and that part still held by the original invention.

ART. 30. The original inventor shall be able to retain the right to the share (or royalty) decided upon in the previous article, or the adoption of the improvement in competition with the inventor of such improvement.

If he decide upon the latter course, an equal extra certificate with the same rights and privileges will be granted to him with the inventor of the improvement.

ART. 31. The inventor of the improvement can in no case acquire the right to carry out the original invention.

Neither can the original inventor make use of the improvement except in the second case provided for in the preceding article.

ART. 32. If two or more persons solicit a patent at the same time for the same industry, or extra certificate for the same improvement, none of the documents will be despatched unless the applicants make an agreement together beforehand.

CHAPTER V.

TRANSFER OF PATENTS.

ART. 33. Any one having obtained a patent, or an extra certificate, shall be able to transfer his rights under the conditions he may think proper, but the transference must be made public and the patent-office be advised previously, without which observance the transference to a third party will be of no value.

ART. 34. Comprised with the patent shall be included all rights conceded to the patentee, and they shall be transferred with it excepting when the deed of transfer contains a special clause to the contrary.

CHAPTER VI.

NULLITY AND LAPSE OF PATENTS.

ART. 35. Patents or certificates acquired in defiance of the prescriptions in article 5 shall be null. Those shall also be null that are obtained by false witness or information, when the drawings or specifications be imperfect and incomplete, and when, being a foreign invention, its origin has been represented as of the country (Uruguay), in which case the defaulter shall be fined \$500, or be sentenced to 6 months imprisonment.

ART. 36. Valid patents shall lapse when the working of the patented industry be not commenced within the term fixed and under the conditions expressed in the letters patent ; when the time for which it was granted is lapsed ; if working be stopped for the space of a year, excepting cases of accident or *force majeure*, which events must be proved by the interested party with sufficient proofs within the term of one month, when, if such be not produced, the chief of the patent-office shall publish in the newspapers the forfeiture of the patent.

ART. 37. If the conditions prescribed by article 12 be not ful-

filled by the patentee, the office of that branch of the service shall call upon him to appear, by means of advertisements during one month, at the end of which time if he does not present himself, the patent granted shall be declared lapsed, and the fact made public as prescribed in the latter part of the preceding article.

ART. 38. A suit for annulment can only be brought by the interested party before the civil court.

ART. 39. For the patented discovery or invention to become public property, a judicial declaration is not indispensable; it is sufficient that it has become null or forfeited, that all be at liberty to explore the patented industry.

ART. 40. In the event of the proprietor of a patent, which has been forfeited or become void, disputing the free exploration of the invention or industry to which it refers by law, suit or other means, any person can request the civil judge for a declaration proving its forfeiture or invalidity.

ART. 41. The judgment shall be summary, allowing the proofs of right, the patentee not being able to show proofs against the documents issued by the patent-office, in support of his privilege. The term for proof shall not exceed twenty days, and ten days after the term for proof the judge shall pass judgment with costs against the loser of the suit.

From this judgment there shall be an appeal to the Supreme Tribunal of Appeals, which may be sitting, which with previous report from the patent-office, shall definitely decide the question without further proceedings.

ART. 42. A patent, once declared null or forfeited, the judge who passed the sentence shall announce the fact to the chief of the patent-office, who will immediately make it public.

CHAPTER VII.

INFRINGEMENTS, THEIR SUPPRESSION AND FINES.

ART. 43. The infringement of the patent right shall be deemed crime of counterfeiture, and punished with a fine of from \$100 to \$500, or by imprisonment for from one to six months, the loss of the objects counterfeited and indemnification of damages and losses.

ART. 44. Those who, knowing of the counterfeiture, aid it by any means, shall suffer the same penalties as those laid down in the preceding article.

ART. 45. The penalties imposed previously shall be doubled for him who renews counterfeiture within five years after being first condemned.

ART. 46. Having been a workman or employe of the patentee, or having obtained knowledge of the invention by stealth or bribery, shall be considered aggravating circumstances.

ART. 47. The suit for the application of penalties above-mentioned is private, and shall be heard before the criminal judge in office, and be accompanied by the letters patent, without which judgment will not be passed.

ART. 48. The only opposition to the suit are the proofs of nullity, forfeiture, participation in the patent, or the exclusive possession thereof.

ART. 49. The plaintiff can exact caution money from the defendant so as not to interrupt him in the working of the patent if the latter wishes to continue working.

In default of the caution money, the plaintiff can ask for suspension of the working of the patent and embargo the effects constituting it, and, if required, sufficient caution money.

ART. 50. He shall be considered an infringer and be subject to the penalties established for such, who, not being the patentee, and not enjoying the privileges of same, may raise a suit as if he were being deprived of same.

CHAPTER VIII.

FINAL DISPOSITIONS.

ART. 51. The copies of the despatches of the patent, models, etc., shall be asked for in writing from the patent-office by their owners, or those who represent them, in person or by right, during the term of the privilege, after which any person may apply for them who may require them.

ART. 52. The *ministro de gobierno* will give order that they be delivered on 2nd-class stamped paper, at the cost of the applicant, who must pay in addition, as copy duty, two dollars per folio, and cost of plans, drawings, models, etc., as public works tax at the request of the *ministro de gobierno*.

ART. 53. The amount of the duties and fines imposed by this law shall be applied to general expenses of the nation.

ART. 54. The chief of the patent-office shall present the indis-

pensable and necessary books, all duly signed on each page, to the chief official of the *ministry de gobierno*.

These books shall show respectively : 1. The patents granted, their class, the date and term of the patent, and all other observations which may be judged useful for this branch of the service. 2. The date of entry, name of the applicant, and nature of the privilege asked for in each case.

These notes must be signed in the book by the applicants for the patent.

ART. 55. The law of June 20, 1853, and all other dispositions opposed to the present law, are repealed.

ART. 56. The Executive Power will administer the present law.

Furnished for this work from the collection of Patent Laws, of Mr. W. E. Richards.

VENEZUELA.

Act of May 25, 1882.

The Congress of the United States of Venezuela ordains :

ARTICLE 1. Any one who has invented or discovered any new and useful manufacture, a machine, a process, or a combination of materials, or also any new and useful improvement on the same, can obtain a patent therefor upon payment of the sum fixed by this law, and subject to the other provisions of the said law : Provided : That the invention, discovery, or improvement be not already known to or used by others dwelling in this country, that it has not been either patented or described in a public print published either in the republic or abroad, or that it has neither been in public use nor offered for sale for more than two years preceding the application, or that the discontinuance of same has not been proved.

ART. 2. The patent documents are to be issued by the Executive in the name of the United States of Venezuela, and only countersigned by the minister.

ART. 3. The government guarantees neither the correctness nor the utility nor the priority of the patented invention or discovery.

ART. 4. Any person desirous of obtaining a patent must accompany the application with a description of the invention or discovery, machine, manufactures, composition, or improvement, wherein the nature and object of same are clearly set forth, together with the corresponding drawings or samples.

ART. 5. The applicant must in his application make a declaration under oath that he is the true inventor or discoverer of the art, machine, process, composition, or improvement for which he desires to obtain a patent, and any opposition calling the correctness of this declaration in question must be decided in ordinary course of law by the interested parties before the state courts.

ART. 6. Patents are granted for five, ten, or fifteen years, and become void six months, one year, and two years, respectively, after the grant, unless the invention or discovery to which they relate has been carried into operation within the specified time. The patent will state the duration and time of expiration. Its duration dates from the day of grant.

ART. 7. Applications for patents are to be addressed to the State Executive through the minister of commerce.

ART. 8. If the conditions stipulated by this law have been fulfilled, a patent will be granted to the applicant, which empowers him to make use of his invention, discovery, or improvement in the whole territory of the United States of Venezuela and its territories. The patent will be granted by the State Executive through the minister of commerce in the form prescribed below. It must contain a title or a short description exactly setting forth the nature and object of the invention or discovery, as also the exclusive permission to the patentee, his heirs and assigns to produce, use, or sell the invention or discovery.

“The President of the Republic with the assent of the Federal Council :

Whereas——has appeared before the Federal Executive and has applied for a patent for the purpose of, [here give the nature of the application,] and having complied with the conditions prescribed in the law of May 25, 1882, in accordance with article 8 of the above-cited law, and in the name of the United States of Venezuela, I grant unto him the present patent for the period of——years for the sole use of the above-mentioned industry for his own profit, or the profit of his heirs or assigns, but in such manner that the Executive does not guarantee either the utility, the correctness, or the priority of the patented discovery or invention.

“After——from the present date this patent shall cease and determine, unless the invention has been put into operation in the interim.

“Signed, sealed, and countersigned, in the palace of the federation at Caracas, the——, &c.”

ART. 9. Patents are subject to the payment of a tax of 80 francs (Bolivars) annually in the case of an invention or discovery, and of 60 francs (or Bolivars) annually when the subject is an improvement of a known process.

ART. 10. The tax prescribed in the previous article is payable into the national treasury of the public service. Every applicant for a patent who applies to the Executive according to article 7 must accompany the application with a certificate that he has paid the half of the duty corresponding to the period of protection required. If, conformably to the provisions of this law, the patent cannot be granted, the applicant shall lose the sum deposited, which shall be applied for popular education. If the patent be granted,

the amount paid shall be deducted from that which the applicant has to pay for the period of the patent. The Executive shall have power to relieve such patentees of industrial discoveries or products of the taxes due under article 9 of this law as are in their opinion worthy of this favor.

ART. 11. Every person who has obtained a patent may publish the fact in advertisements and in his trade-mark without this publication constituting a guarantee of the government for the quality of the product, or of the priority of the invention or discovery, or becoming of any undue value whatever to the prejudice of the prior rights of a third party.

ART. 12. Every person who has had a patent granted to him for an invention or discovery in a foreign country can also obtain a patent in this : Provided : That it has not already been granted to any one. In such case the patent shall only be granted for a period equal to the unexpired term of the patent in the foreign country.

ART. 13. On the expiration of a patent the description of the discovery or invention shall be published in the Official Gazette, and from this time forward the use of the discovery or invention, together with the manufacture or sale of the industrial product hitherto protected by the patent, shall be open to any one.

ART. 14. The patent shall also be published if the same, according to article 6 of this law, lapse before the invention or discovery has been carried into operation, conformably to article 6 of this law, or when before its expiration or lapse it is declared null and void, except in the case provided for under article 18.

ART. 15. All specifications, drawings, and samples necessary for obtaining a patent are to be deposited with the minister of public affairs.

ART. 16. After an application for a patent has been accepted by the Executive, the same shall be notified in the Official Gazette ; but the patent (in the event of its being granted) shall not be issued until the expiration of thirty days after this notification has appeared.

ART. 17. Inventions, improvements, or new manufactures prejudicial to health, public order, morals, or prior rights shall not be patentable. Pharmaceutical preparations and medicines in any shape or form cannot be patented, but remain subject to the special legislation and regulations therefor provided.

ART. 18. Besides the cases provided for under article 6, patents are null and void if the Executive Government decide that the

patent granted is detrimental to the rights of a third person, as well as if the actual working of the patented industry has been discontinued for a whole year, excepting unforeseen circumstances or *force majeure*.

ART. 19. Infringements of the rights secured by patent will be adjudicated upon by the federal courts in conformity with the laws.

ART. 20. The patent law made on May 20, 1878, is hereby annulled.

Given in the palace of the Executive Government, at Caracas, May 25, 1882, &c.

From 35 *Pat. Off. Gaz.* 388.

VICTORIA.

An Act to consolidate the Law concerning Letters Patent for Inventions, being Act No. CCXL., of May 9, 1865.

(NOTE*—The words “registrar-general” in italics are alterations made by the Act, No. 432, 17th Dec., 1872.)

Be it enacted by the Queen’s most excellent Majesty, by and with the advice and consent of the Legislative Council and the Legislative Assembly of Victoria, in this present Parliament assembled, and by the authority of the same, as follows:

1. *Title.* This Act shall come into operation on the first day of June, in the year of our Lord one thousand eight hundred and sixty-five, and shall be called and may be cited as “The Patents Statute, 1865.” Its sections are divided into parts as follow:

Part I.—Mode of obtaining Letters Patent, §§ 4–19.

Part II.—Disclaimers and Alterations, §§ 20–23.

Part III.—Extension of Term and Confirmation of Invalid Patents, §§ 24–28.

Part IV.—Miscellaneous Provisions, §§ 29–39.

2. *Repeal of Acts.* The Acts mentioned in the first schedule hereto, to the extent to which the same are in and by the said schedule expressed to be repealed, shall be and the same are hereby repealed. Nothing herein contained shall affect any proceedings or things lawfully taken, done, or commenced, or any letters patent granted, or any protection or right conferred, or any rules and regulations, or any register or appointment made, or any notice or particulars given or published, or any warrant issued or caveat entered under the said repealed Acts, or either of them, before the coming into operation of this Act; and all such proceedings and things shall be as valid and may be continued, and all such letters patent, protections, rights, rules, and regulations, registers, appointments, notices, particulars, warrants, and caveats shall have the same force and efficacy as if this Act had not been passed. Letters patent may be granted in respect of applications made before the coming into operation of this Act in like manner as if this Act had

* Notes printed in this form are from Carpmael’s edition.

not been passed ; and where letters patent have been granted before the commencement of this Act, or shall in respect of any application made before the commencement of this Act be hereafter granted for any invention, such letters patent may be confirmed, or the term thereof extended or new letters patent granted for such invention in like manner as if the original or first letters patent had been granted under this Act.

3. *Interpretation.* In the interpretation of this Act the word "invention" shall mean and include any manner of new manufacture the subject of letters patent and grant of privilege within the meaning of the enactment next hereinafter contained.

PART I.—MODE OF OBTAINING LETTERS PATENT.

4. *Power to grant patents.* It shall be lawful to make and issue, in the manner hereinafter mentioned, letters patent and grants of privilege for any term not exceeding fourteen years from the date thereof of the sole working or making of any manner of new manufactures within Victoria and its dependencies to the true and first inventor of such manufactures, which others at the time of making such letters patent and grants shall not use, so as also they be not contrary to the law nor mischievous to the State by raising prices of commodities, or hurt of trade, or generally inconvenient. And all other monopolies, commissions, grants, licenses charters, and letters patent hereafter to be made or granted to any person of or for the sole buying, selling, making, working, or using of anything within Victoria or its dependencies, or of any other monopolies, or of power, liberty, or faculty to dispense with any others, and all matters and things whatsoever in anywise tending to the instituting, erecting, or countenancing of the same, or any of them, shall be utterly void and of none effect, and in nowise to be put in execution.

5. *Governor in Council to make rules for executing this Act.* It shall be lawful for the Governor in Council, from time to time to make such rules and regulations (not inconsistent with the provisions hereof), as may appear to be necessary and expedient for the purposes of this Act ; and all such rules and regulations shall be laid before both Houses of Parliament within fourteen days after the making thereof if Parliament be sitting, and if Parliament be not sitting, then within fourteen days after the next meeting of Parliament.

6. *Inventor to deposit specifications ; same may be amended before patent issues.* All applications under this Act for the grant of letters patent for an invention shall be made as follows : (that is to say,) the applicant shall deposit at the office of the *registrar-general* an instrument in writing under his hand and seal, particularly describing and ascertaining the nature of the said invention, and in what manner the same is to be performed, and also a copy of such instrument, and of the drawings accompanying the same (if any) ; and the day of the deposit of every such specification, shall be recorded at the said office and indorsed on such specification, and a certificate thereof given to such applicant or his agent ; and thereupon, subject and without prejudice to the provisions hereinafter contained, the said invention shall be protected under this Act for the term of six months next after the said deposit, and the applicant shall have during such term the like powers, rights, and privileges as might have been conferred upon him by letters patent for such invention issued under this Act, and duly sealed as of the day of such deposit ; and during the continuance of such powers, rights, and privileges under this provision, such invention may be used and published without prejudice to any letters patent to be granted for the same ; and where letters patent are granted in respect of such invention, such letters patent shall be conditioned to become void if such specification does not particularly describe and ascertain the nature of the said invention, and in what manner the same is to be performed : Provided always, that in case the title of the invention or the said specification be too large or insufficient, it shall be lawful for the law officer during the said term of six months, and before the grant of the letters patent, to allow or require such specification to be amended, or another and sufficient specification to be deposited in lieu thereof ; and every such amended or new specification shall have the same force, effect, and operation as if it had been originally deposited in its amended or new state.

7. *Form and size of specification and copy.* Every such specification as aforesaid shall be in the form contained in the second schedule to this Act, or to the like effect, and shall be written upon both sides of one or more skin or skins of parchment, and every page thereof shall be of the exact size of twenty inches in length by fifteen inches in breadth, leaving a margin of at least one inch and a half on each side of every such page in order and to the intent that the same may be bound into books for safe custody ; but the drawings accompanying such specification (if any) may be made

upon larger sheets of parchment, leaving a margin of the size and for the purpose aforesaid; and every copy of any such specification as aforesaid, and of the drawings accompanying the same (if any), shall in like manner be written upon one or more sheet or sheets of paper of the size and with the margins aforesaid.

8. *Patent of true inventor not to be affected by specification of pretended inventor.* In case of the deposit of any such specification as aforesaid in fraud of the true and first inventor, any letters patent granted to the true and first inventor of such invention shall not be invalidated by reason of such deposit, or of any use or publication of the invention subsequent to such deposit and before the expiration of the said term of protection.

9. *Mode of proceeding after deposit of specification.* The applicant, so soon as he shall think fit after the deposit of such specification as aforesaid, and of the drawings and models accompanying the same (if any), may give notice in writing at the chambers of the law officer of his intention to proceed with his application for letters patent for the said invention, stating in such notice the title of the said invention; and the day on which the specification thereof was deposited at the office of the *registrar-general*, and at the time of giving such notice shall produce the said certificate of deposit; and thereupon the said law officer shall deliver to the applicant or his agent an appointment in the form contained in the third schedule to this Act, or to the like effect; and such applicant or agent, not less than twenty-one clear days prior to the day appointed by the law officer, shall cause the said appointment to be published once in the Government Gazette, once in some newspaper published in the city of Melbourne, and twice in some newspaper published in the town or place at or near to which the applicant uses or exercises the said invention, or (in case he does not use or exercise the same) in or near to which he resides, or if there shall be no newspaper published in such town or place then twice in some newspaper circulating in the neighborhood where he uses or exercises the said invention or (in case he does not use or exercise the same) where he resides; and any person having an interest in opposing the grant of letters patent for the said invention shall be at liberty, not less than three clear days prior to the day so appointed, to leave particulars in writing of his objections to the said application at the chambers of the law officer.

10. *Law officer to hear applications and objections and award costs.* At the place and time named in the said appointment the

applicant shall produce the newspapers containing the same ; and the law officer shall thereupon hear and consider the said application and all objections to the same mentioned in the said particulars (if any), and for that purpose shall obtain from the office of the *registrar-general* the said copy of the said specification, and of the drawings and models accompanying the same (if any), and may call to his aid such scientific or other person as he may think fit, and may, by writing under his hand, order to be paid to such persons some remuneration for his attendance ; and may also in like manner order that the costs of any hearing upon any objection, or otherwise in relation to the grant of such letters patent, or the protection acquired by the applicant under this Act, shall be paid, and in and by such writing shall fix the amount of such remuneration or costs, and by or to whom the same respectively shall be paid ; and every such order shall be in the form contained in the fourth schedule to his Act, or to the like effect, and may be made a rule of the Supreme Court : Provided always, that the applicant, the objectors, and respective witnesses and evidence shall be respectively heard, examined, and considered separately and apart from and in the absence of the other and his witnesses and evidence.

11. *Law officer may issue warrant for letters patent.* The law officer, after such hearing and consideration, may issue a warrant under his hand and seal for the granting of letters patent for the said invention, and by such warrant shall direct the insertion in such letters patent of all such restrictions, conditions, and provisos as he may deem usual and expedient in such grants, or necessary in pursuance of this Act : and the said warrant shall be the warrant for the making and sealing of letters patent under this Act according to the tenor of the said warrant ; and every such warrant shall be in the form contained in the fifth schedule to this Act, or to the like effect.

12. *Letters patent may be repealed or withheld, and specification canceled.* The writ of *scire facias* shall lie for the repeal of any letters patent granted under this Act and may be issued into the circuit district in which the grantee resided when the said letters patent were granted ; and in case such grantee does not reside in Victoria, it shall be sufficient to file such writ in the proper office of the Supreme Court, and serve notice thereof in writing at the last known place of residence or business of such grantee ; and nothing herein contained shall extend to abridge or affect the prerogative of the Crown in relation to the granting or withholding

the grant of any letters patent; and it shall be lawful for the Governor in Council to order such law officer to withhold such warrant as aforesaid, or that any letters patent for the granting whereof he may have issued a warrant as aforesaid, shall not issue, or to order the insertion in any such letters patent of any restrictions, conditions or provisos, in addition to or in substitution for any restrictions, conditions, or provisos which would otherwise be inserted therein under this Act; and it shall also be lawful for the Governor in Council to order any specification in respect of the invention described in which no letters patent may have been granted to be canceled, and thereupon the protection obtained by the deposit of such specification shall cease.

13. *Letters patent to be void on non performance of conditions.* All letter patent for inventions granted under this Act shall be in the form contained in the sixth schedule to this Act, or to the like effect, and be made subject to the condition that the same shall be void, and that the powers and privileges thereby granted shall cease and determine, at the expiration of three years and seven years respectively from the date thereof, unless there be paid within the said three and seven years respectively the sum or sums of money in that behalf hereby required to be paid; and the *registrar-general* shall issue under his hand a certificate of such payment and shall indorse a receipt for the same on the letters patent.

14. *Letters patent to be issued within three months after warrant, and during the protection.* The *registrar-general*, so soon after the receipt by him of the said warrant as required by the applicant, shall cause to be prepared letters patent for the invention according to the tenor of the said warrant; and it shall be lawful for the Governor in Council to cause such letters patent to be sealed with the seal of the colony; and such letters patent shall be made applicable to the said colony and its dependencies, and shall be valid and effectual as to the whole of the same respectively; but except as hereinafter-mentioned, no letters patent shall issue on any warrant granted as aforesaid unless application be made to seal such letters patent within three months after the date of the said warrant; nor unless such letters patent be granted during the continuance of the protection conferred under this Act by reason of such deposit.

15. *Letters patent may issue after that time in certain cases.* Where the application to seal such letters patent has been made during the continuance of such protection as aforesaid, and the seal-

ing of such letters patent has been delayed from accident and not from the neglect or willful default of the applicant, then such letters patent may be sealed at such time not being more than one month after the expiration of such protection as the Governor in Council shall direct ; and where the applicant for such letters patent dies during the continuance of such protection aforesaid, such letters patent may be granted to the executors or administrators of such applicant during the continuance of such protection or at any time within three months after the death of such applicant, notwithstanding the expiration of the term of such protection ; and the letters patent so granted shall be of the like force and effect as if they had been granted to such applicant during the continuance of such protection ; and in case any letters patent shall be destroyed or lost other letters patents of the like tenor and effect, and sealed and dated as of the same day, may (subject to such regulations as the Governor in Council may direct) be issued under the authority of the warrant in pursuance of which the original letters patent were issued.

16. *Letters patent to bear date of the deposit of specification and to be conclusive as to preliminary steps and proceedings.* Notwithstanding any enactment to the contrary, all letters patent to be issued in pursuance of this Act shall be sealed and bear date as of the day of the deposit of such specification as aforesaid, and shall be of the same force and validity as if they had been sealed on the day as of which the same are expressed to be sealed and bear date ; and after any letters patent shall have been granted or issued under this Act it shall not be necessary or material to inquire or ascertain whether such appointment as aforesaid has or has not been delivered and published in the manner hereinbefore mentioned and directed.

17. *Letters patent for foreign inventions not to continue after expiration of foreign patent.* Where upon any application made under this Act letters patent are granted for or in respect of any invention first invented in parts out of Victoria and its dependencies, and a patent or like privilege for the monopoly or exclusive use or exercise of such invention in any parts out of Victoria and its dependencies is obtained before the grant of such letters patent in Victoria, all rights and privileges under such letters patent shall (notwithstanding any term in any such letters patent limited) cease and be void immediately upon the expiration or other determination of the term during which the patent or like privilege obtained in such part out of Victoria and its dependencies shall continue in

force, or where more than one such patent or like privilege is obtained abroad, immediately upon the expiration or determination of the term which shall first expire or be determined of such several patents or like privileges: Provided always, that no letters patent for or in respect of any invention (for which any such patent or like privilege as aforesaid shall have been obtained abroad) granted in Victoria after the expiration or determination of the term for which such patent or privilege was granted or was in force shall be of any validity.

18. *Letters patent not to prevent the use of inventions in foreign ships resorting to ports in Victoria.* No letters patent for any invention granted after the coming into operation of this Act shall extend to prevent the use of such invention in any foreign ship or vessel, or for the navigation of any foreign ship or vessel, which may be in any port of Victoria or its dependencies or in any of the waters within the jurisdiction of any of Her Majesty's courts of Victoria, where such invention is not so used for the manufacture of any goods or commodities to be vended within or exported from the same: Provided always, that this enactment shall not extend to the ships or vessels of any foreign State, the laws of which authorize subjects of such foreign State having patents or like privileges for the exclusive use or exercise of inventions within its territories, to prevent or interfere with the use of such inventions in British ships or vessels, or in or about the navigation of British ships or vessels while in the ports of such foreign State, or in the waters within the jurisdiction of its courts, where such inventions are not so used for the manufacture of goods or commodities to be vended within or exported from the territories of such foreign State.

19. *Specification to be filed after issue of patent or expiring of protection.* Every specification deposited at the office of the registrar general as aforesaid, and the drawings and models accompanying the same (if any), shall, forthwith after the grant of the letters patent, or if no letters patent be granted then immediately on the expiration of six months from the time of such deposit, be transferred to and kept in such office as the Governor in Council shall from time to time appoint for that purpose.

PART II.—DISCLAIMERS AND ALTERATIONS.

20. *Notice of application to disclaim or make alterations.* Any person who shall obtain letters patent under this Act, or in case

such person shall part with his whole or any part of his interest by assignment, such person together with the assignee (if part only has been assigned), or the assignee alone (if the whole has been assigned), may apply to the law officer for leave to enter a disclaimer of any part of either the title of the invention or of the specification, or a memorandum of any alteration in the said title or specification, not being such disclaimer or such alteration as shall extend the exclusive right granted by the said letters patent; and thereupon the law officer shall deliver to such patentee and assignee, or either of them, or to their or either of their agents, an appointment in the form contained in the seventh schedule to this Act, or to the like effect; and such patentee or assignee shall thereupon cause such disclaimer (stating the reason for the same), or such memorandum of alteration, to be written at the foot of the said appointment, and shall cause the same respectively to be published in the manner hereinbefore required with respect to the said first mentioned appointment; and any person having an interest in opposing the said application shall be at liberty to leave particulars in writing of his objections to the same at the chambers of the law officer within such time not being less than three clear days prior to the day so appointed: Provided always, that where such application as aforesaid shall be for leave to enter a disclaimer of any part of the title of the said invention, or a memorandum of any alteration in such title, the law officer may dispense with such appointment and publication, and in that case shall certify in the fiat hereinafter mentioned that he has dispensed with the same.

21. *Application for disclaimer to be heard.* At the time and place named in such appointment the said patentee and assignee, or one of them, shall produce the newspapers containing the same and the said disclaimer or memorandum of alteration at the foot thereof; and the law officer shall thereupon hear and consider the said application, and all objections to the same mentioned in the said particulars (if any), and all such power and authority shall and may be exercised upon that occasion by the law officer as by virtue of the provisions hereinbefore contained can and may be exercised in relation to the hearing and considering an application for letters patent and objections to the same, and shall and may be enforced in like manner.

22. *How disclaimer may be entered and alterations made.* After such hearing and consideration, or without such hearing and consideration where the said appointment and publication shall have

been dispensed with as aforesaid, such patentee and assignee, or either of them, may by leave of the law officer (to be certified by a fiat under his hand to be written at the foot of the same parchment with the said disclaimer or memorandum) enter such disclaimer (stating the reason for the same) or such memorandum of alteration, and at the time of entering such disclaimer or memorandum of alteration shall deposit a copy thereof in the office next hereinafter mentioned; and such disclaimer or memorandum of alteration, being filed in such office as the Governor in Council shall from time to time appoint for that purpose, shall be deemed and taken to be part of such letters patent or such specification, and subject to the several incidents thereof, in all courts whatever, and shall be valid and effectual in favor of any person in whom the rights under the said letters patent may then be or thereafter become legally vested; and no objection shall be allowed to be made in any proceeding upon or touching such letters patent, specification, disclaimer or memorandum of alteration, on the ground that the person entering such disclaimer or memorandum of alteration had not sufficient authority in that behalf: Provided always, that no action shall be brought upon any letters patent in which or on the specification of which any disclaimer or memorandum of alteration shall have been filed in respect of any infringement committed prior to the filing of such disclaimer or memorandum of alteration (unless the law officer shall certify in his said fiat that any such action may be brought), notwithstanding the entry or filing of such disclaimer or memorandum of alteration; and no such disclaimer or alteration shall be receivable as evidence in any action or suit (save and except in any proceeding by *scire facias*) pending at the time when such disclaimer or alteration was filed as aforesaid; but in every such last mentioned action or suit the original title and specification alone shall be given in evidence, and be deemed and taken to be the title and specification of the invention for which the letters patent have been or shall have been granted: Provided also, that when any such fiat shall have been granted or issued under this Act, it shall not be necessary or material to inquire or ascertain whether such appointment as last aforesaid has or has not been delivered and published or dispensed with in accordance with this Act, and such filing of any disclaimer or memorandum of alteration in pursuance of the leave of the law officer certified as aforesaid shall (except in cases of fraud) be conclusive as to the right of the party to enter such disclaimer or memorandum of alteration under this Act.

23. *Copies of specifications, disclaimers, &c., to be open to inspection.* The copies of all specifications and the drawings and models accompanying the same (if any) and of all disclaimers and memoranda of alterations respectively deposited under or in pursuance of this Act shall be open to the inspection of the public at all reasonable times after the grant of letters patent, or if no letters patent be granted then immediately on the expiration of six months from the time of such deposit; but subject to such regulations as the Governor in Council may make in that behalf.

PART III.—EXTENSION OF TERM AND CONFIRMATION OF INVALID PATENTS.

24. *Mode of obtaining extension of the term.* If any person who has obtained letters patent under this Act or any other Act relating to letters patent heretofore in force in Victoria, or (in case such person shall have parted with his whole or any part of his interest by assignment) if such person, together with the assignee where part only has been assigned, or of the assignee alone where the whole has been assigned, shall, six months before the expiration or other determination of such letters patent, present to the Governor in Council a petition for the extension of the term in such letters patent mentioned, and shall set forth in such petition that he or they has or have been unable to obtain a due remuneration for his or their expense and labor in perfecting such invention, and that an exclusive right of using and vending the same for some further period to be named in such petition, in addition to the said term, is necessary for his or their reimbursement and remuneration, it shall be lawful for the Governor in Council to refer the consideration of the said petition to commissioners to be appointed for that purpose in the manner hereinafter mentioned.

25. *Mode of obtaining confirmation of invalid patent.* If in any suit or action it shall be proved or specially found by the verdict of a jury that any person who shall have obtained letters patent for any invention or supposed invention was not the first inventor thereof, or of some part thereof, by reason of some other person having invented or used the same, or some part thereof, before the date of such letters patent, or if such patentee or his assigns shall discover that some other person had, unknown to such patentee, invented or used the same, or some part thereof, before the date of such letters patent, such patentee or his assigns may

petition the Governor to confirm the said letters patent or to grant new letters patent; and it shall be lawful for the Governor in Council to refer the consideration of the said petition to commissioners to be appointed for that purpose in the manner hereinafter mentioned.

26. *Appointment of commissioners.* For the purpose of considering any such petition as aforesaid, it shall be lawful for the Governor in Council (if he shall think fit) to issue and direct in the name of Her Majesty, her heirs or successors, to five or more persons (of whom some of the judges of the Supreme Court shall be two) a commission reciting such petition, and requiring and authorizing such persons, or any three of them, of whom one of the said judges shall be one, to meet at some time (not being less than two months from the publication of the said commission in the Government Gazette) and at some place to be respectively fixed in the said commission, and then and there to consider the said petition, and to report to Her Majesty, her heirs and successors (in case such petitioner shall have prayed for an extension of the term in the letters patent mentioned), whether any and, if any, what further extension of the said term should be granted according to the prayer of the said petition, and upon what, if any, conditions, or (in case such petitioner shall have prayed for a confirmation of the letters patent or for a grant of new letters patent) whether such confirmation or grant should be made.

27. *Notice of commission to be published and caveats entered.* Two months at least before the time named in the said commission for the consideration of any such petition as aforesaid, the petitioner shall cause to be published in the same manner as is hereinbefore required with respect to the said first mentioned appointment an advertisement of the contents of the said commission in the form contained in the eighth schedule to this Act, or to the like effect; and any person having an interest in opposing the said petition shall be at liberty to enter a caveat against the same at the office of the *registrar-general* at any time not being less than one week before the time named in the said commission for the execution thereof.

28. *Commissioners to hear all parties and report.* At the time and place fixed in the said commission for that purpose the commissioners shall meet and proceed to consider such petition; and the petitioner shall be heard by his counsel and witnesses to prove his case as stated in such petition, and the publication of the said

last mentioned advertisement as required by this Act; and the persons entering caveats shall likewise be heard by their counsel and witnesses; and all such witnesses shall be examined upon oath or affirmation (which oath or affirmation such commissioners as aforesaid are hereby authorized and required to administer); and thereupon and upon hearing and inquiry of the whole matter (in case such petitioner shall have prayed for an extension as aforesaid) the said commissioner may report whether any and, if any, what further extension of the said term should be granted; and the Governor in Council is hereby authorized and empowered, if he shall think fit, to grant to the petitioner new letters patent for the said invention for a term not exceeding fourteen years after the expiration of the first term, anything hereinbefore contained to the contrary thereof in anywise notwithstanding; and such new letters patent shall be sealed and bear date as of the day after the expiration of the term of the first letters patent. Or (in case such petitioner shall have prayed for a confirmation or grant as aforesaid, such commissioners, upon examining the said matter and being satisfied that such patentee as aforesaid believed himself to be the first and original inventor, and being satisfied that such invention, or part thereof, had not been publicly and generally used before the date of such first letters patent, may report to Her Majesty, her heirs and successors, their opinion that the prayer of such petition ought to be complied with, whereupon the Governor in Council may, if he shall think fit, grant such prayer; and the said letters patent shall be available at law and in equity to give to such petitioner the sole right of using, making, and vending such invention as against all persons whomsoever, anything hereinbefore contained to the contrary thereof notwithstanding: Provided that any person, party to any former suit or action touching such first letters patent as last aforesaid, shall be entitled to have notice in writing of the time and place fixed as aforesaid for the first meeting of the said commissioners to consider the said petition; and after any such report shall have been made it shall not be material or necessary to inquire or ascertain whether any such advertisement as last aforesaid has or has not been published, or whether any such notice as last aforesaid has or has not been given in the manner hereinbefore directed in that behalf.

PART IV.—MISCELLANEOUS PROVISIONS.

29. *Index to specifications, disclaimers, &c.* The Governor in Council may cause indices to all specifications, disclaimers, and memoranda of alterations heretofore or to be hereafter enrolled or deposited as aforesaid to be prepared in such form as may be thought fit; and such indices shall be open to the inspection of the public, at such places as the Governor in Council shall appoint, and subject to the regulations to be made as hereinbefore provided.

30. *Register of patents to be kept.* There shall be kept at the office to be appointed as aforesaid a book or books, to be called The Register of Patents, wherein shall be entered and recorded in chronological order all letters patent granted under this Act and any other Act relating to letters patent heretofore in force in Victoria, the deposit and filing of specifications, disclaimers, and memoranda of alterations filed in respect of such letters patent, all amendments in such letters patent and specifications, all confirmations and extensions of such letters patent, the expiry, determination, vacating, or canceling such letters patent, with the dates thereof respectively, and all other matters and things affecting the validity of such letters patent as the Governor in Council may direct; and such register, or a copy thereof, shall be open at all convenient times to the inspection of the public, subject to such regulations as the Governor in Council may make in that behalf.

31. *Register of Proprietors to be kept.* There shall be kept at the same office a book or books, entitled The Register of Proprietors, wherein shall be entered, in such manner as the Governor in Council shall direct, the assignment of any letters patent, or of any share or interest therein, any license under letters patent, and the district to which such license relates, with the name or names of any person having any share or interest in such letters patent or license, the date of his or their acquiring such letters patent, share, and interest, and any other matter or thing relating to or affecting the proprietorship in such letters patent or license; and a copy of any entry in such book, certified as hereinafter mentioned, shall be given to any person requiring the same, and shall be *prima facie* proof of the assignment of such letters patent, or share or interest therein, or of the license or proprietorship, as therein expressed: Provided always, that until such entry shall have been made, the grantee or grantees of the letters patent shall be deemed and taken to be the

sole and exclusive proprietor or proprietors of such letters patent, and of all the licenses and privileges thereby given and granted; and such register or a copy shall be open to public inspection, subject to such regulations as the Governor in Council may make.

32. *Certified copies to be evidence.* The Governor in Council may cause a seal to be made for the purposes hereinafter mentioned; and all courts, judges, and other persons whomsoever shall take notice of such seal, and receive impressions thereof in evidence in like manner as impressions of the seal of the colony are received in evidence; and copies or extracts, certified and sealed with such seal, of letters patent, specifications, disclaimers, memoranda of observations, and all other documents or books recorded, filed, and kept in pursuance of this Act, shall be received in evidence in all proceedings relating to letters patent for inventions in all courts, and by all judges and other persons whomsoever.

33. *Falsification or forgery of entries.* If any person shall willfully make or cause to be made any false entry in any such register, or shall willfully make or forge or cause to be made or forged any writing falsely purporting to be a copy of any entry in the said book, or shall produce or tender or cause or suffer to be produced or tendered in evidence any such writing, knowing the same to be false or forged, he shall be guilty of a misdemeanor, and shall be liable to be imprisoned for any term not exceeding five years.

34. *Entries may be expunged.* If any person shall deem himself aggrieved by any entry made under color of this Act in any such register, it shall be lawful for such person to apply by motion to the Supreme Court in term time, or by summons to a judge of such court in vacation, for an order that such entry may be expunged vacated, or varied; and upon any such application such court or judge may make such order for expunging, vacating, or varying such entry, and as to the costs of such application, as to such court or judge may seem fit; and the officer having the care and custody of such register, on the production to him of any such order, shall expunge, vacate, or vary the said entry according to such order.

35. *Penalty for unauthorized user of the word "patent."* If any person shall write, paint, print, mould, cast, carve, engrave, stamp, or otherwise mark upon anything made, used, or sold by him, for the sole making or selling of which he has not or shall not have obtained letters patent, the name or any imitation of the name of any other person who has or shall have obtained letters patent for the sole making and vending of such thing, without leave in writ-

ing of such patentee or his assigns, or if any person shall upon such thing, not having been purchased from the patentee, or some person who purchased it from or under such patentee, or not having had the license or consent in writing of such patentee or his assigns, write, paint, print, mould, cast, carve, engrave, stamp, or otherwise mark the word "patent," the words "letters patent," or the words "by the Queen's patent," or any words of the like kind, meaning, or import, with a view of imitating or counterfeiting the stamp, mark, or other device of the patentee, he shall for every such offense forfeit and pay the sum of one hundred pounds, one-half to Her Majesty, her heirs and successors, and the other half with full costs of suit to any person who shall sue for the said penalty by action of debt: Provided always, that nothing herein contained shall be construed to extend to subject any person to any penalty in respect of stamping or in any way marking the word "patent" upon anything for the sole making or vending of which letters patent before obtained shall have expired or otherwise determined.

36. *In Actions for infringement, particulars of breaches and objections to be delivered.* In any action for the infringement of letters patent the plaintiff shall deliver with his declaration particulars of the breaches complained of in the said action, and the defendant on pleading thereto shall deliver with his pleas, and the prosecutor in any proceeding by scire facias to repeal letters patent shall deliver with his declaration, particulars of any objections on which he means to rely at the trial in support of the pleas in the said action, or of the suggestions of the said declaration in scire facias respectively; and at the trial of such action or proceeding by scire facias no evidence shall be allowed to be given in support of any alleged infringement or of any objection impeaching the validity of such letters patent which shall not be contained in the particulars delivered as aforesaid: Provided always, that the place or places at or in which and in what manner the invention is alleged to have been used or published prior to the date of the letters patent shall be stated in such particulars: Provided also, that it shall and may be lawful for any judge at chambers to allow such plaintiff or defendant or prosecutor respectively to amend the particulars delivered as aforesaid, upon such terms as to such judge shall seem fit. Provided also, that at the trial of any proceeding by scire facias to repeal letters patent the defendant shall be entitled to begin and to give evidence in support of such letters patent; and in case evidence shall be adduced on the part of the

prosecutor impeaching the validity of such letters patent, the defendant shall be entitled to the reply.

37. Particulars to be regarded in taxing costs. In taxing the costs in any action for infringing letters patent regard shall be had to the particulars delivered in such action, and the plaintiff and defendant respectively shall not be allowed any costs in respect of any particular unless certified by the judge before whom the trial was had to have been proved by such plaintiff or defendant respectively, without regard to the general costs of the cause ; and it shall be lawful for the judge before whom any such action shall be tried to certify on the record that the validity of letters patent in the declaration mentioned came in question ; and the record with such certificate being given in evidence in any suit or action for infringing the said letters patent, or in any proceeding by *scire facias* to repeal the letters patent, shall entitle the plaintiff in any such suit or action, or the defendant in such proceeding by *scire facias*, on obtaining a decree, decretal order, or final judgment, to his full costs, charges, and expenses to be taxed as between attorney and client, unless the judge making such decree or order, or the judge trying such action or proceeding, shall certify that the plaintiff or defendant respectively ought not to have such full costs.

38. Fees on obtaining patents. There shall be paid in respect of letters patent applied for or issued as herein mentioned, the depositing of specifications, disclaimers, and memoranda of alterations, warrants, certificates, entries, and searches, and other matters and things respectively mentioned in the ninth schedule of this Act, such fees as are enumerated in that schedule ; and such of the said fees as are thereby made payable to the law officer shall and may be received and retained by such law officer for his own proper use ; and the residue thereof shall form part of the the consolidated revenue of Victoria, and be paid, applied, and disposed of accordingly.

39. English patents to be subject to this Act. All letters patent which shall have been or which shall be granted in the United Kingdom of Great Britain and Ireland after the thirty-first day of December in the year of our Lord one thousand eight hundred and fifty-seven, for any invention, shall, so far as the same relate to Victoria and its dependencies, be and be deemed to have been utterly void and of none effect, and in nowise be put in execution ; but all such letters patent granted in the said United Kingdom on or before that day, and which would be or would have been valid

in Victoria if this Act or any other Act relating to letters patent heretofore in force in Victoria had not been passed, shall be deemed and taken to have been granted under this Act, and may be dealt with accordingly.

SCHEDULES.

SCHEDULE I.

Section 2.

Date of Act.	Title of Act.	Extent of Repeal.
18 Vict. No. 1 ..	"An Act to protect the rights of inventors " of articles at the Exhibition in Victoria " of one thousand eight hundred and " fifty-four."	The whole.
20 Vict. No. 3 ..	"An Act concerning Letters Patent for In- " ventions."	The whole.

SCHEDULE II.

Section 7.

To all to whom these presents shall come, I [John Doe, of Taradale, in the county of Talbot, engineer,] send greeting:

Whereas I am desirous of obtaining Royal letters patent for securing unto me Her Majesty's special license that I, my executors, administrators, and assigns, and such others as I or they should at any time agree with, and no others, should and lawfully might from time to time, and at all times during the term of fourteen years (to be computed from the day on which this instrument shall be left at the office of the *registrar-general*), make, use, exercise, and vend within the colony of Victoria and its dependencies an invention for [*insert the title of the invention*]; and in order to obtain the said letters patent I must by an instrument in writing under my hand and seal particularly describe and ascertain the nature of the said invention, and in what manner the same is to be performed, and must also enter into the covenant hereinafter contained: Now know ye, that the nature of the said invention, and the manner in which the same is to be performed, is particularly described and ascertained in and by the following statement; (that is to say,) [*describe the invention*]. And I do hereby, for myself, my heirs, executors, and administrators, covenant with Her Majesty, her heirs, and successors, that I believe the said invention to be a new invention as to the public use and exercise thereof, and that I do not know or believe that any other person than myself is the true and first inventor of the said invention, and that I will not deposit these presents at the office of the *registrar-general* with any such knowledge or belief as last aforesaid.

In witness, &c.

SCHEDULE III.

Section 9.

Patent for [*insert the title of the specification*]. This is to notify that *A. B.* of &c., did on the day of instant [*or last*] deposit at the office of the *registrar-general* in Melbourne a specification or instrument in writing under his hand and seal particularly describing and ascertaining the nature of the said invention, and in what manner the same is to be performed, and that by reason of such deposit the said invention is protected and secured to him exclusively for the term of six calendar months thence next ensuing; and I do further notify that the said *A. B.* has given notice in writing at my chambers of his intention to proceed with his application for letters patent for the said invention, and that I have appointed [*Thursday*] the day of next, at o'clock in the noon, at my chambers to hear and consider the said application and all objections thereto; and I do hereby require all persons having an interest in opposing the grant of such letters patent to leave on or before the day of at my chambers in Melbourne particulars in writing of their objections to the said application, otherwise they will be precluded from urging the same.

Given under my hand this day of 18 .
T. H. F.,
General.

SCHEDULE IV.

Section 10.

Upon hearing the objection of *A. B.* to grant to *C. D.* of letters patent for [*insert the title as in the specification*], I do by this writing under my hand order that the said *A. B.* shall pay to the said *C. D.* the sum of for the costs of such hearing [*or to E. F.* the sum of as a remuneration for his attendance at such hearing].

Given under my hand this day of 18 .
G. H.,
General.

SCHEDULE V.

Section 11.

I have heard and considered the application of *A. B.* for letters patent for [*insert the title as in the specification*], and also all objections to the same, and having perused the specification and the usual and necessary advertisements, am of opinion that as it is entirely at the hazard of the said applicant whether the said invention is new and will have the desired success, Her Majesty's Royal letters patent may be issued in the form contained in the sixth schedule to the "Patents Statute, 1865," [with the following additional clauses (that is to say,) *here set them out if any*].

Given under my hand and seal this day of
(L. S.) W. F. S.,
General.

SCHEDULE VI.

Section 13.

Victoria, by the Grace of God, of the United Kingdom of Great Britain and Ireland Queen, Defender of the Faith, to all to whom these presents shall come, greeting :

Whereas *A. B.* of _____ in the county of _____, engineer, hath represented that he is desirous of obtaining our Royal letters patent for securing unto him our special license that he, his executors, administrators, and assigns, and such others as he or they should agree with, and no others, should and lawfully might make, use, exercise, and vend within our Colony of Victoria and its dependencies an invention for [*insert the title of the invention*]; and by an instrument in writing under his hand and seal, deposited in the office of the *registrar-general*, the said *A. B.* hath particularly described and ascertained the nature of the said invention, and in what manner the same is to be performed; and we, being willing to give encouragement to all arts and inventions which may be for the public good, are graciously pleased to confer upon the said *A. B.* the privileges hereinafter mentioned: Know ye, therefore, that we, of our especial grace, certain knowledge, and mere motion, have given and granted, and by these presents, for us, our heirs, and successors, do give and grant unto the said *A. B.*, his executors, administrators, and assigns, our special license, full power, sole privilege, and authority that he the said *A. B.*, his executors, administrators, and assigns, and every of them, by himself and themselves, or his and their deputy or deputies, servants or agents, or such others as he or they shall at any time agree with, and no others during the term herein expressed, shall and lawfully may make, use, exercise, and vend his said invention within our said colony and its dependencies, in such manner as to him, his executors, administrators, and assigns, or any of them shall seem meet, and that he, his executors, administrators, and assigns, shall and lawfully may have and enjoy the whole profit, benefit, commodity, and advantage, from time to time coming, growing, accruing, and arising by reason of the said invention during the said term; to have, hold, exercise, and enjoy the said licenses, powers, privileges, and advantages unto and by the said *A. B.*, his executors, administrators, and assigns, for and during and unto the full end and term of fourteen years now next-ensuing; and to the end that he, his executors, administrators, and assigns, and every of them, may have and enjoy the full benefit and the sole use and exercise of the said invention according to our gracious intention, we do by these presents, for us, our heirs and successors require and strictly command all and every person and persons, bodies politic and corporate and all other our subjects whatsoever, of what estate, quality, degree, name, or condition soever they be, within our said colony and its dependencies, that neither they nor any of them at any time during the said term, either directly or indirectly, do make, use, or put in practice the said invention or any part of the same so attained unto by the said *A. B.* as aforesaid, nor in anywise counterfeit, imitate, or resemble the same, nor shall make or cause to be made any addition thereunto or subtraction from the same whereby to pretend himself or themselves the inventor or inventors, deviser or devisors thereof, without the consent, license, or agreement of the said *A. B.*, his executors, administrators, or assigns, in writing under his or their hands and seals first had and obtained in that behalf, upon such pains and penalties as can or may be justly inflicted on such offenders for their contempt of this our

royal command, and further to be answerable to the said *A. B.*, his executors, administrators, and assigns, according to law for his and their damages thereby occasioned: Provided always, and these letters patents are and shall be upon this condition, that is at any time during the said term hereby granted it shall appear that this our grant if contrary to law or prejudicial or inconvenient to our subjects in general, or that the said invention is not a new invention as to the public use and exercise thereof, or that the said *A. B.* is not the true and first inventor thereof within this colony or its dependencies, these our letters patent shall forthwith cease, determine, and be utterly void to all intents and purposes, anything hereinbefore contained to the contrary thereof, in anywise notwithstanding: Provided also, that these our letters patent, or anything herein contained, shall not extend or be construed to extend to give privilege unto the said *A. B.*, his executors, administrators, or assigns, or any of them, to use or imitate any invention or work whatsoever which hath heretofore been found out or invented by any other of our subjects whatsoever and publicly used or exercised unto whom or like letters patent or privileges have been already granted for the sole use, exercise, and benefit thereof, within our said colony or its dependencies, it being our will and pleasure that the said *A. B.*, his executors, administrators, and assigns, and all and every other person and persons to whom like letters patent or privileges have been already granted as aforesaid, shall distinctly use and practice their several inventions by them invented and found out according to the true intent and meaning of the same respective letters patent and of these presents: Provided likewise nevertheless, and these our letters patent are upon this express condition, that if the said instrument in writing does not particularly describe and ascertain the nature of the said invention, and in what manner the same is to be performed, and also, if the said *A. B.*, his executors, administrators, or assigns, shall not pay at the office of the *registrar-general* of our said colony the sum of fifteen pounds within three years next after the date of these presents, and the sum of twenty pounds within seven years next after such date, and also if the said *A. B.*, his executors, administrators, or assigns, shall not supply or cause to be supplied for our service all such articles of the said invention as he or they shall be required to supply by the persons administering the department of our service for the use of which the same shall be required, in such manner, at such times, and at and upon such reasonable prices and terms as shall be settled for that purpose by the said persons requiring the same, that then and in any of the said cases these our letters patent, and all liberties and advantages whatsoever hereby granted, shall utterly cease, determine, and become void, anything hereinbefore contained to the contrary thereof in anywise notwithstanding: Provided that nothing herein contained shall prevent the granting of licenses in such manner and for such considerations as they may by law be granted. And lastly, we do by these presents, for us, our heirs and successors, grant unto the said *A. B.*, his executors, administrators, and assigns, that these our letters patent shall be in and by all things, good, firm, valid, and sufficient and effectual in the law, according to the true intent and meaning thereof, and shall be taken, construed, and adjudged in the most favorable and beneficial sense, for the best advantage of the said *A. B.*, his executors, administrators, and assigns, as well in all our courts of record as elsewhere, and by all and singular the officers and ministers whatsoever, of us, our heirs and successors, in our said colony and its dependencies, and amongst all and every the subjects of us, our heirs and successors whatsoever and wheresoever, notwithstanding the not full and certain describing the nature or quality of the said invention, or of the materials

thereunto conducing and belonging. In witness whereof we have caused these our letters to be made patent, and to be sealed and bear date as of the day of

SCHEDULE VII.

Section 20.

Patent for [*insert the title*]. This is to notify to all whom it may concern, that C. D., of &c., has applied to me for leave to enter a disclaimer of part [*or memorandum of alteration, as the case may be*] of the said invention, the particulars whereof are stated below; I do therefore appoint [*Thursday*], the day of next, at o'clock in the noon, to hear and consider the said application and all objections to the same; and I do hereby require all persons having an interest in opposing the said application to leave on or before the day of at my chambers in Melbourne particulars in writing of their objections to the same, otherwise they will be precluded from urging such objections.

Given under my hand, this day of

W. F. S.,
General.

The following is the disclaimer [*or as the case may be*] which I desire to make in, &c. [*The applicant must here set forth what he wishes to enter, and sign it*].

SCHEDULE VIII.

Section 27.

Patent for [*insert the title*]. Notice is hereby given, that I have presented a petition to his Excellency the Governor, praying for the confirmation of [*or extension of the term in*] the said patent, and that a royal commission has issued authorizing and requiring certain commissioners therein named to consider and report upon the subject to Her Majesty, which said commissioners will meet for that purpose on the day of next, at o'clock in the noon, at . All persons objecting to the said confirmation [*or extension*] must enter a caveat against the same, at the office of the *registrar-general* in Melbourne, otherwise they will be precluded from objecting to it.

Dated this day of

A. B.

SCHEDULE IX.

Section 38.

	£	s.	d.
On depositing specification.....	2	10	0
To the law officer for any "appointment".....	2	4	6
On obtaining letters patent.....	2	10	0
At or before the expiration of the third year.....	15	0	0
At or before the expiration of the seventh year.....	20	0	0
To the law officer with particulars of objections.....	2	4	6
On presenting petition for extension or confirmation.....	2	10	0
Every search and inspection.....	0	1	0

Entry of assignment or license.....	0	10	0
Certificate of assignment or license.....	0	10	0
Filing of memorandum of alteration or disclaimer.....	2	10	0
Entering any caveat.....	2	10	0
Copy or extract of any writing per common law folio.....	0	1	0

From *Carpin. Pat. L. of World*, 615.

An act to amend the laws concerning Letters Patent for Inventions. No. DCCCVIII. December 12, 1884.

Be it enacted by the Queen's Most Excellent Majesty, by and with the advice and consent of the Legislative Council and the Legislative Assembly of Victoria in this present Parliament assembled, and by the authority of the same, as follows—that is to say :

1. This Act may for all purposes be cited as “The Patents Act, 1884” and shall be read and construed as one with “The Patent Statute 1865,” (hereinafter referred to as the “Principal Act”) as amended by the Act No. CCCXXXII, except so far as such construction would be inconsistent with or repugnant to the provisions of this act.

2. In this Act and the principal Act the word “patentee” shall mean the person for the time being entitled to the benefit of any letters patent in Victoria, and the words “the true and first inventor” shall mean the person who is the actual inventor or his nominee or assignee, and shall not include the unauthorized importer of an invention from elsewhere.

3. The acts specified in the first schedule hereto shall be and the same are hereby repealed to the extent specified in the third column of the said schedule : Nothing herein contained shall affect any proceedings or things lawfully taken, done, or commenced, or any letters patent granted, or any protection or right conferred, or any register or appointment made, or any notice of particulars given or published, or any warrant issued, or caveat entered under any of the repealed portions of the said Acts, before the passing of this Act ; and all such proceedings and things shall be as valid and may be continued, and all such letters patent, protections, rights, registers, appointments, notices, particulars, warrants, and caveats shall have the same force and efficacy as if this Act had not been passed. When letters patent have been granted to any person before the passing of this Act, or shall in respect of any application

made before the passing of this Act be hereafter granted to any person for any invention, such person shall with respect to all matters and things which might lawfully have been done, and with respect to all fees which might lawfully have been paid after the passing of this Act, be entitled to avail himself of the provisions of this Act as if this Act had been passed before the grant of such letters patent.

MODE OF OBTAINING LETTERS PATENT.

4. In section 6 of the principal Act the words "twelve months shall be substituted for the words "six months," wherever the same occur in the said section.

5. For the purposes of the hearing and consideration of any application in accordance with the provisions of section 10 of the principal Act, the law officer may by summons under his hand require the attendance of all such persons as he thinks fit to call before him for examination, and may under his hand order to be paid by the applicant or objector to such persons such remuneration for their attendance as to him may seem reasonable. In opposed cases where applicants and objectors consent the law officer may hear all the parties in the presence of one another.

6. If any person whose attendance has been so required and on whom any such summons has been served by the delivery thereof to him or by the leaving thereof at his usual place of abode, neglect or fail to appear or refuse to make answer to such questions as are put to him touching such application as aforesaid, such person shall forfeit and pay a penalty not exceeding twenty pounds, to be recovered by any person authorized so to do by the law officer in a summary way before a justice of the peace.

7. If any applicant for a grant of letters patent be dissatisfied with the refusal of the law officer to issue his warrant for the granting of letters patent, such applicant may appeal to the Supreme Court, and the mode of such appeal and all matters relating to pleading, practice, and procedure therein shall be in accordance with rules of court for the time being in force. For the purpose of regulating such appeals the Supreme Court may at any time, with a concurrence of a majority of the judges thereof present at any meeting for that purpose held, make rules of court, and may from time to time annul any such rules and make further or additional rules; and the Supreme Court may direct a warrant for the granting of letters patent, and such warrant shall be to all intents and

puposes as valid and effectual as though it were a warrant for the granting of letters patent for an invention under the hand and seal of the law officer.

8. Notwithstanding anything in any Act of Parliament contained, where any patent or like privilege for the monopoly or exclusive use or exercise in any parts out of Victoria and its dependencies has been obtained for or in respect of any invention first invented in parts out of Victoria and its dependencies, letters patent may be granted for or in respect of such invention at any time within one year from the date of the granting of the first of any such patents or privileges for such monopoly, exclusive use, or exercise as aforesaid, notwithstanding that such invention has been used or published in Victoria within such period of one year, and such letters patent, when granted, shall have the same force and effect as if such prior publication or use had not taken place : Provided, however, That if such use or publication have been made in Victoria with the consent of the inventor, such inventor shall not be entitled to a grant of letters patent under the authority of this section.

9. (1.) If the Governor in Council is pleased to make any arrangement with the government or governments of any Australian colony, or with the government of the colony of New Zealand, or of the colony of Fiji for the mutual protection of inventions, then any person who has applied for the protection of any invention in any such colony shall be entitled to a patent for his invention under this Act in priority to other applicants, and such patent shall have the same date as the date of the protection obtained in such colony : Provided, That his application is made within six months from his applying for protection in the colony with which the arrangement is in force : Provided, That nothing in this section contained shall entitle such person to recover damages for infringements happening prior to the date of the actual acceptance of his complete specification in Victoria.

(2.) The publication in Victoria during the period aforesaid of any description of such invention, or the use therein during such period of invention (whether with or without the consent of such person as aforesaid), shall not invalidate the patent which may be granted for the invention.

(3.) The application for a grant of a patent under this section must be made in the same manner as an ordinary application under this Act.

(4.) The provisions of this section shall apply only to such of the colonies aforesaid with respect to which the Governor shall from time to time by order in Council declare them to be applicable, and so long only in the case of each colony as the order in Council shall continue in force with respect to that State.

10. Where Her Majesty has by order in Council applied the provisions of section 103 of an Act of the Imperial Parliament, called "The Patents, Designs, and Trade-Marks Act, 1883," or any portion thereof, to Victoria, the provisions of the last preceding section may, by order of the Governor in Council, be applied for the protection of inventions patented in the United Kingdom or Isle of Man: Provided, That such order in Council may be at any time revoked.

EXTENSION OF TERM AND CONFIRMATION OF INVALID PATENTS.

11. Where any commissioners have been appointed by the Governor in Council, under Part III. of the principal Act, to consider the petition of any person for the confirmation of letters patent, or for the grant of new letters patent, or for an extension of the term in any letters patent mentioned, such commissioners may, if in their report to Her Majesty, her heirs and successors, they recommend that such confirmation, grant, or extension should not be made, also recommend that all the costs and expenses of or relating to the consideration of such petition by the commissioners, and of and relating to the appearance of the law officers of the Crown and the crown solicitor to oppose the prayer of such petition, shall be borne by such petitioner; and the Governor in Council may thereupon make an order that such costs and expenses, or any part thereof as he thinks fit, shall be borne by such petitioner.

MISCELLANEOUS PROVISIONS.

12. Any person who writes, paints, prints, molds, casts, carves, engraves, stamps, or otherwise marks upon anything made, used or sold by him, and for the sole making or selling of which he has not obtained letters patent, the name or any imitation of the name of any other person who has, as patentee, obtained letters patent for the sole making and selling of such thing, without leave in writing of such patentee or his assigns, or who, upon such thing not having been purchased from the patentee or some person who purchased it

from or under such patentee, or not having had the license or consent in writing of such patentee or his assigns, writes, paints, prints, molds, casts, carves, engraves, stamps, or otherwise marks the word "patent" or "patented," or the words "letters patent," "royal letters patent," or "Queen's patent," or any word or words of like import, with the intent of counterfeiting or imitating the stamp, mark, or device of the patentee, or of deceiving the public and inducing them to believe that the thing in question was made or sold by or with the consent of the patentee, or who puts to sale as patented any article not patented in Victoria, for the purpose of deceiving the public, shall be guilty of a misdemeanor, and on conviction thereof be liable to a fine not exceeding one hundred pounds or imprisonment for a period not exceeding three months.

13. Whenever, through inadvertence, accident, or mistake, and without any willful default or intent to defraud or mislead the public, any person who has, as patentee, obtained letters patent for the sole making and selling of anything, has (in his specification) claimed to be the true and first inventor or discoverer of any material or substantial part of the thing patented of which he was not the true and first inventor as aforesaid, every such patentee, his executors, administrators, and assigns, whether of the whole or any interest in such letters patent, may maintain a suit at law or in equity for the infringement of any part thereof which was *bona fide* his own, provided it be a material and substantial part of the invention in respect of which the letters patent were rightfully granted, and that it be definitely distinguishable from the parts so claimed without right as aforesaid, notwithstanding the specifications may embrace more than that of which such patentee was the true or first inventor or discoverer; but in every such case in which judgment is given or a decree is made for the plaintiff, no costs shall be recovered unless the proper disclaimer has been entered at the chambers of the law officer before the commencement of the action or suit, nor shall he be entitled to the benefit of this section if he have unreasonably neglected or delayed to enter said disclaimer.

14. A patent shall have to all intents the like effect as against her Majesty the Queen, her heirs, and successors, as it has as against a subject, but the minister at the head of any department of the public service may use for the public service any patented article or any patented manufacturing process on such terms as may be agreed on with the patentee of such article or process, or in default of such agreement on such terms as may be settled by arbitration

conducted under regulations to be made by the Governor in Council.

REVOCATION.

15. (1.) The proceeding by scire facias to repeal a patent is hereby abolished.

(2.) Revocation of a patent may be obtained on petition to the Supreme Court.

(3.) Every ground on which a patent might, at the commencement of this act, be repealed by scire facias shall be a ground of revocation.

(4.) A petition for revocation of a patent may be presented by—

(a.) The law officer ;

(b.) Any person authorized by the law officer ;

(c.) Any person alleging that the patent was obtained in fraud of his rights, or of any person under or through whom he claims ;

(d.) Any person alleging that he, or that any person under or through whom he claims, was the true inventor of any invention included in the claim of the patentee ;

(e.) Any person alleging that he, or any person under or through whom he claims an interest in any trade, business, or manufacture, had publicly manufactured, used, or sold, within this realm, before the date of the patent, anything claimed by the patentee as his invention.

(5.) The plaintiff must deliver with his petition particulars of the objections on which he means to rely, and no evidence shall, except by leave of a judge of the court, be admitted in proof of any objection of which particulars are not so delivered.

(6.) Particulars delivered may be from time to time amended by leave of the court in which such action is pending or a judge thereof.

(7.) The defendant shall be entitled to begin, and give evidence in support of the patent, and if the plaintiff gives evidence impeaching the validity of the patent the defendant shall be entitled to reply.

(8.) Where a patent has been revoked on the ground of fraud the law officer may, on the application of the true and first inventor made in accordance with the provisions of this Act, grant to him a patent in lieu of and bearing the same date as the patent so revoked ; but the patent so granted shall cease on the expiration of the term for which the revoked patent was granted.

LEGAL PROCEEDINGS.

16. (1.) In an action for infringement of a patent, the judge who is trying the action may, if he thinks fit, and shall on the request of either of the parties to the proceeding, call in the aid of an assessor specially qualified and try and hear the case wholly or partially with his assistance. The action shall be tried without a jury, unless the court shall otherwise direct.

(2.) A judge of any court having jurisdiction to deal with matters and things relating to letters patent may, if he sees fit, in any proceeding before him call in the aid of an assessor as aforesaid.

(3.) The remuneration, if any, to be paid to an assessor under this section shall be determined by the judge or judges who have called such assessor to his or their aid, and be costs in the cause.

17. (1.) In an action for infringement of a patent the plaintiff shall deliver with his statement of claim, or by order of a judge of the court in which such action is brought at any subsequent time, particulars of the breaches complained of.

(2.) The defendant on pleading thereto shall deliver with his statement of defense, or by order of the Supreme Court or a judge thereof at any subsequent time, particulars of any objections on which he relies in support thereof.

(3.) If the defendant disputes the validity of the patent, the particulars delivered by him must state on what grounds he disputes it, and if one of those grounds is want of novelty, must state the time and place of the previous publication or user alleged by him.

(4.) At the hearing no evidence shall, except by leave of the judge, be admitted in proof of any alleged infringement or objection of which particulars are not so delivered.

(5.) Particulars delivered may be from time to time amended by leave of the court in which the action is then pending or a judge thereof.

(6.) On taxation of costs, regard shall be had to the particulars delivered by the plaintiff and by the defendant, and they, respectively, shall not be allowed any costs in respect of any particular delivered by them unless the same is certified by the court in which the action was tried, or a judge thereof, to have been proven, or to have been reasonable and proper, without regard to the general costs of the case.

18. In an action for infringement of a patent, the court in which such action is pending, or a judge thereof, may on the application of either party, make such order for an injunction, inspection, or account, and impose such terms and give such directions respecting the same and the proceedings thereon as the said court or such judge may see fit.

19. In an action for infringement of a patent, the court in which the action was tried, or a judge thereof, may certify that the validity of the patent came in question, and if such court or judge so certifies, then in any subsequent action for infringement the plaintiff in that action, on obtaining a final order or judgment in his favor, shall have his full costs, charges, and expenses, as between solicitor and client, unless such court or judge before whom the action was tried certifies that he ought not to have the same.

20. Every patent may be in the form in the second schedule to this Act, and shall be granted for one invention only, but may contain more than one claim; but it shall not be competent for any person in an action or other proceeding to take any objection to a patent on the ground that it comprises more than one invention.

21. If a person possessed of an invention dies without making application for a patent for the invention, application may be made by and a patent for the invention granted to his legal representative. Every such application must be made within six months of the decease of such person, and must contain a declaration by the legal representative that he believes such person to be the true and first inventor of the invention.

22. The exhibition of an invention at an industrial or international exhibition, or the publication of any description of the invention during the period of the holding of the exhibition, or the use of the invention for the purpose of the exhibition in the place where the exhibition is held, or the use of the invention during the period of the holding of the exhibition by any person elsewhere without the privity or consent of the inventor, shall not prejudice the right of the inventor or his legal personal representative to apply for and obtain provisional protection and a patent in respect of the invention or the validity of any patent granted on the application: Provided, That both the following conditions are complied with, namely;

(a.) The exhibitor must, before exhibiting the invention, give the law officer one month's notice of his intention to do so; and,

(b.) The application for a patent must be made before or within twelve months from the date of the opening of the exhibition.

23. The Governor in Council may, subject to the provisions of this act, from time to time, make, alter and repeal rules and regulations to regulate the issue of licenses to persons to practice as agents for the procuring and taking out of letters patent for inventions, and fixing the amount or fee to be charged for each such license per annum.

24. The second and third schedules to this Act shall be respectively substituted for the sixth and third schedules to the principal Act.

25. The fees set out in the fourth schedule to this Act shall be payable for and in respect of the matters and things therein mentioned in lieu of the fees prescribed by the ninth schedule to the principal Act, and the said fourth schedule hereto shall be substituted for the said ninth schedule to the principal Act.

Notwithstanding anything in the principal Act contained, a fee due in respect of letters patent for any invention at the expiration of the third or seventh year from the date therefrom, may be paid at any time within six months of such due date on payment of an additional fee by way of penalty of two pounds and ten shillings, and may be paid at any time within twelve months of such due date on payment of an additional fee by way of penalty of ten pounds; and on payment of such fee and penalty the powers and privileges granted by such letters patent shall be as good and effectual to all intents and purposes as though such fee had been paid on such due date as aforesaid.

From 32 *Pat. Off. Gaz.* 774.

VIRGIN ISLANDS.

See LEEWARD ISLANDS.

WALES.

See GREAT BRITAIN AND IRELAND.

WESTERN AUSTRALIA.

An Act to Regulate Grants of Patents for Inventions in the Colony of Western Australia. No. 1, Aug. 15, 1872.

Whereas it is expedient to make provision for granting patents for inventions in the Colony of Western Australia : Be it therefore enacted by His Excellency the Governor of Western Australia and its dependencies, by and with the advice and consent of the Legislative Council thereof, as follows :—

1. *Holder of letters patent under this Act entitled to same privileges as patentees in England.* From and after the passing of this Act, any person to whom, as the originator or discoverer of any new invention or improvement in the arts or manufactures, His Excellency the Governor shall, according to the provisions hereinafter contained, grant letters patent, or an instrument in the nature of letters patent, shall have within the said Colony of Western Australia, for a term of fourteen years next after the granting of such letters patent or instrument, the exclusive enjoyment and advantage in the said colony of such invention or improvement, and such and the same protection, and such and the same remedies at law and in equity against any person in the colony infringing the said letters patent or instrument, and generally such and the same rights, powers, and privileges throughout the said colony, with respect to the invention for which such letters patent or instrument shall be granted, as any person to whom letters patent for a new invention have been granted under the Great Seal of England has by the law of England in and throughout the realm of England (save so far as such protection, remedies, rights, powers, and privileges may be inconsistent with the provisions of this Act) : Provided that so much of the provisions contained in an Act of the United Parliament of Great-Britain and Ireland passed in the session of the fifth and sixth years of the reign of His late Majesty King William the Fourth, entitled “An Act to amend the law touching letters letters patent for inventions,” as relates to the confirming of letters patent or granting new letters patent to a patentee acting under an erroneous belief that he was the first and original inventor, and for the prolongation of letters patent, and the several provisions contained in an Act of the United Parliament of

Great Britain and Ireland passed in the session of the fifteenth and sixteenth years of the reign of Her present Majesty, entitled "An Act for amending the law for granting patents for inventions," shall not be deemed applicable to the Colony of Western Australia : Provided further, that any of the penalties recoverable by any person holding letters patent under the Great Seal of England in any court of Great Britain, under the said first-mentioned Act, for any unauthorized person using or imitating the name of any such patentee, or using the word "patent," or the like words, or counterfeiting the mark of any such patentee, may be recoverable and recovered in similar courts in the said colony by any person to whom letters patent, or an instrument in the nature of letters patent, shall be granted under the provisions hereof, or by his assignee, for similar injuries to such last mentioned patentee or his assignee in the said colony.

2. *Mode of application for letters patent.* Any person being the originator or discoverer of any new invention or improvement as aforesaid, for which no patent or instrument in the nature of letters patent has been issued in Western Australia or any other country, and being desirous of obtaining letters patent or an instrument as aforesaid under this act, shall deposit with the colonial treasurer the sum of twenty-five pounds, and leave in the office, or in the custody of such person as the Governor may appoint, a petition addressed to His Excellency, stating clearly and succinctly the object to be attained by his invention or discovery, setting forth that he has deposited the sum of twenty-five pounds as aforesaid, and praying that letters patent, or an instrument as aforesaid, may be granted to him for the exclusive use thereof in the said colony ; and every such person shall also send with his said petition a written specification, signed by him, of his invention or discovery, and of the manner and process of making, constructing, using, and compounding the same, in such terms, avoiding unnecessary prolixity, as to enable any person skilled in the art or scheme to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the same ; and in case of any machine, a statement of the principle and of the several modes in which he has contemplated the application of that principle or character by which it may be distinguished from other inventions ; and shall in the said specification particularly specify and point out the part, improvement, or combination which he claims as his own invention and discovery : he shall also send a drawing and written

references, where the nature of the case admits, of drawings or specimens of ingredients, and of the composition of matter, sufficient in quantity for the purpose of experiment, when the invention or discovery is a composition of matter ; and he shall moreover, if required by such person so appointed as aforesaid, furnish with the said petition a model of his invention, in all cases which admit of a representation by model, of a convenient size to exhibit advantageously its several parts ; and he shall also send a solemn affirmation or declaration, made before some justice of the peace of the said colony (and which affirmation or declaration such justice is hereby authorized to take), that the petitioner is, as he believes, the first and true originator or discoverer of such new invention or improvement, and shall affirm or declare the object intended to be attained thereby.

3. *Notice of application to be published in Gazette.* The Governor in his discretion may thereupon cause notice of the said application to be inserted in the Government Gazette, and thereby require any person who may conceive that he would be prejudiced by the granting of such letters patent or instrument, to send within two months of the said publication to the office or address of such person so appointed as aforesaid, a statement in writing setting forth the grounds of such objection, subscribed with his proper name and address.

4. *Governor may refer objection to appointees who shall report to him.* It shall be lawful for the Governor, upon receipt within the time aforesaid of such objection, to refer the consideration thereof to one or more competent person or persons to be appointed by the said Governor, and also to direct the applicant for such letters patent or instrument, and the opponent of the grant or issue thereof, to attend before such person or persons so appointed, who shall investigate the said matter, and shall be at liberty to call to his or their aid such scientific or other witnesses as he or they may think fit, and to cause to be paid to such witnesses by the applicant such remuneration as he or they may direct ; and such person or persons so appointed shall report to the Governor whether in his or their opinion such letters patent should be issued, and if any such objection shall be sustained, the said specification, drawings, and models shall be returned to the said applicant, and the said sum of twenty-five pounds shall be paid to Her Majesty as hereinafter mentioned.

5. *Costs of inquiry to be given.* It shall be lawful for such

person or persons so appointed, to whom the consideration of any such objection as aforesaid is referred, if he or they see fit, by certificate under his or their hand, to determine the amount of the costs of any hearing or inquiry upon such objection, and to order by and to whom such costs shall be paid ; and if any such costs so ordered to be paid be not paid within seven days after the date of such order, every such order may be made a rule of the Supreme Court of such colony.

6. *If no objection, letters patent may be issued.* In case no objection shall be made to the issuing of the said letters patent or instrument within the time aforesaid, or in case such person or persons so appointed shall report that such letters patent or instrument should be issued, the Governor may direct, by writing under his hand, that such letters patent or instrument shall be issued by the colonial secretary or other proper officer, and shall thereupon cause such specifications, drawings, and models so sent as aforesaid, to be deposited with the colonial secretary of the said colony.

7. *Amount to be paid for letters patent.* The person applying for such letters patent or instrument shall, within one month after the issuing of such direction, pay into the office of the colonial treasury of the said colony and obtain a receipt for the sum of twenty-five pounds sterling, which sum and the said sum of twenty-five pounds, and all other moneys received by the colonial treasurer under this Act, shall be paid to Her Majesty, her heirs and successors, for the use of the said colony and in support of the government thereof.

8. *Colonial secretary to issue letters patent.* The colonial secretary or other proper officer, upon such directions as aforesaid, and production to him of the receipts of the colonial treasurer, shall forthwith cause letters patent to be prepared in the form in the schedule hereunto annexed marked A, and the Governor shall sign his name and cause the seal of the said colony to be annexed to such letters patent, and deliver the same to the person to whom the same shall be granted, or to his agent or legal representative.

9. *Letters patent to be delivered to colonial secretary.* The person to whom such letters patent shall be issued shall thereupon deliver or cause to be delivered the said letters patent at the office of the said colonial secretary, and the said letters patent shall be operative from the time of such delivery.

10. *More than ten persons may be interested in letters patent.* It shall be lawful for a larger number than ten persons to have a

legal or beneficial interest in any such letters patent or instrument in the nature of letters patent, issued under the provisions of this Act.

11. *Assignment of a patent and record thereof.* Every patent or instrument in the nature of letters patent granted under this Act shall be assignable in law either as to the whole interest or any undivided part thereof by any instrument in writing, which assignment, and also every grant and conveyance of the exclusive right under any patent to make and use and to grant to others to make and use the thing patented within the said colony, shall be recorded in the office of the colonial secretary within three months from the execution thereof upon payment by the assignee or grantee to the colonial treasurer of the sum of ten pounds.

12. *Injunction may be granted.* In any action in the Supreme Court of the said colony for the infringement of any letters patent, or instrument in the nature of letters patent, issued under the provisions of this Act, it shall be lawful for the court, as well in its common law as equity jurisdiction, or if the court be not sitting, then for a judge of such court, on the application of the plaintiff or defendant respectively, to make such order for an injunction, inspection, or account, and to give such direction respecting such action, injunction, inspection, and account, and the proceedings therein respectively, as to such court or judge shall seem fit.

13. *Letters patent may be repealed by scire facias.* Any letters patent or instrument in the nature of letters patent granted by virtue of this Act shall be liable to be repealed by writ of scire facias for the same causes and in the same manner as any grants of the crown are liable to be repealed.

14. *Letters patent and specifications, &c., to be enrolled.* The said colonial secretary shall cause both the said letters patent and description to be kept in his office, and shall also cause a book to be kept in his office containing an index to all such letters patent, or instruments which may be issued or assigned; the object to be attained by the invention to be protected thereby, the date thereof, the name of the person to whom the same is issued or assigned, and such description of the enrollment thereof as may be necessary to facilitate reference; and all persons whosoever may have access to the said books, and may inspect the same, and may have copies thereof, or of such parts thereof as they may require, certified by the colonial secretary, upon payment of reasonable expenses actually incurred in taking the same, and copies of, or extracts from the

said letters patent, instrument, and specification certified by the said colonial secretary to be true copies or extracts shall be received as evidence of the contents of the said letters patent, instrument, and specification respectively in all proceedings whatsoever.

15. *Specification may be corrected.* Whenever any patent or instrument in the nature of letters patent granted under the authority of this Act shall be inoperative or invalid by reason of defective or insufficient description or specification, or by reason of the patentee claiming, as his own invention, more than he had or shall have a right to claim as new, if the error has or shall have arisen by inadvertency, accident, or mistake, and without any fraudulent or deceptive intention, it shall be lawful for His Excellency the Governor, upon the surrender of such patent or instrument, and the payment to the colonial treasurer of the sum of ten pounds, to cause a new patent or instrument as aforesaid to be issued to the said inventor for the same invention for the residue of the period then unexpired for which the original patent was granted in accordance with the patentee's corrected description and specification, and in case of his death or any assignment by him made of the original patent a similar right shall vest in his executors, administrators, or assigns; and the patent so reissued, together with the corrected description and specification, shall have the same effect and operation in law on the trial of all actions hereinafter commenced for causes subsequently accruing as though the same had been originally filed in such corrected form before the issuing out of the original patent: And whenever the original patentee or his assignee shall be desirous of adding the description and specification of any new improvement of the original invention or discovery which shall have been originated or discovered by him subsequent to the date of his patent, he may, like proceedings being had in all respects as in the case of original applications, and on the further payment of twenty pounds in manner hereinbefore provided, have the same annexed to the original description and specification, and the colonial secretary shall certify on the margin of such annexed description and specification the time of its being annexed and recorded, and the same shall thereafter have the same effect in law to all intents and purposes as though it had been embraced in the original description and specification.

16. *Disclaimer may be entered.* Any person who shall obtain such letters patent or instrument, or his assignee, may, if he think fit, enter with the said colonial secretary (having first obtained the

permission in writing of the Governor) a disclaimer of any part of either the title of the invention or of the specification, stating the reason for such disclaimer, or may, with such permission as aforesaid, enter a memorandum of any alteration in the said title or specification, not being such disclaimer or such alteration as shall extend the exclusive right granted by the said letters patent or instrument, and such disclaimer or memorandum of alteration being deposited with the said colonial secretary shall be deemed and taken as part of such letters patent or instrument, or such specification, and subject to the several incidents thereof, in all courts of justice in the said colony : Provided that no such disclaimer or alteration shall be receivable as evidence in any action or suit (save and except in any proceeding by scire facias) pending at the time when such disclaimer or alteration was enrolled, but in every such action or suit the original title and specification alone shall be deemed and taken to be the title and specification of the invention for which the letters patent have been or shall have been granted.

17. *Punishment for false entries or false affirmations.* If any person shall willfully make or cause to be made any false entry or alteration in any register or assignment of patents or instruments as aforesaid, or in any specification, or shall willfully make or forge, or cause to be made or forged, any false writing purporting to be a copy of an entry in the said book, or of any such patents, instruments, or specifications, or shall produce or tender or cause to be produced or tendered in evidence any such writing, knowing the same to be false or forged, or shall willfully make any false affirmation before any justice of the peace respecting any of the matters concerning which an affirmation is hereby required to be made as aforesaid, he shall be guilty of a misdemeanor, and on conviction thereof shall be punished by fine and imprisonment at the discretion of the court.

18. *Foreign patentees or their assignees may obtain letters of registration.* No person shall receive a patent or an instrument in the nature of letters patent under this Act for an invention or discovery which has been previously patented in Great Britain, or any other country, but it shall be lawful for the Governor, in his discretion, on the application of any person being the holder or assignee of any patent granted or issued in Great Britain, or any other country, for any new discovery or invention, and upon such proof as the Governor may deem sufficient that such person is the *bonâ fide* holder or assignee of the said patent, and that the same

is in full force, and upon payment to the colonial treasurer of the sum of twenty-five pounds, to grant letters of registration under the seal of Western Australia to the holder of such patent as aforesaid, or his assignee, and such letters of registration shall be deposited in the office of the colonial secretary in the manner herein provided, and shall be deemed to be letters patent issued under this Act for such invention or improvement, and shall have the same force and effect as letters patent issued thereunder, and shall, unless repealed by writ of scire facias or otherwise, inure to the benefit of the holder during the continuance of the original patent in the country in which it was issued or granted, and no longer; and all the provisions of this Act shall apply to such letters of registration in the same way *mutatis mutandis* and as fully as to letters patent or an instrument in the nature of letters patent issued under this Act.

19. *Interpretation clause.* In the construction of this Act, the word "person" shall include bodies corporate and companies as well as individuals, unless the context be repugnant thereto.

20. *Royal Prerogative saved.* Nothing in this Act contained shall be deemed to interfere with Her Majesty's Royal Prerogative in granting or issuing or withholding the grant or issue of any letters patent.

From Carpm. Pat. L. of World, 641.

See also AUSTRALASIA.

WURTEMBERG.

A report by Mr. George Petre, of the British Legation, published December 2, 1883, in 4 *Int. Off. Gaz.* 579, with an appendix, *Id.* 607, gives an extended account of the law and practice relative to patents which prevailed throughout Wurtemberg at the time of his writing; and which, presumably, continued in force until the adoption of the general law of July 1, 1877, for the German Empire, for which, see GERMAN EMPIRE.

INTERNATIONAL CONVENTION FOR THE PROTECTION OF INDUSTRIAL PROPERTY.*

Signed at Paris, March 20, 1883. Ratifications exchanged at Paris, June 6, 1884.

ARTICLE I. The Governments of Belgium, Brazil, Spain, France, Guatemala, Italy, Holland, Portugal, Salvador, Servia, and Switzerland, constitute themselves into a Union for the protection of industrial property.

[NOTE.†—*The following Governments have since adhered to the Convention in accordance with article XVI.:* Great Britain, (Order in Council, under § 103 of the Patents Act, dated June 26, 1884), Ecuador and Tunis.]

ART. II. The subjects or citizens of each of the contracting States shall, in all the other States of the Union, in matters concerning patents, industrial designs or models, trade and commercial

* A conference to establish an International Union, like the Postal Union, for the protection of patents, designs, models, trade-marks and trade-names, met in Paris, March 6, 1883, and adjourned after adopting a draft of a convention at a second sitting on March 13th. The main points were settled at the first conference held at Paris two years before. The convention then proposed was communicated by the French Government to the other participating States. Some of the particulars were objected to by several of the States, and it was to harmonize their views on these minor points that the second conference was held. A much larger number of governments was represented. Representatives were present from the United States, France, England, Italy, Spain, Portugal, Russia, Sweden and Norway, Holland, Belgium, Switzerland, Roumania, Servia, Luxemburg, Brazil, the Argentine Republic, Uruguay,

Guatemala, and San Salvador. The plan is to have a union sitting at Berne, which will represent the States whose patent laws are sufficiently in harmony, and endeavor to secure greater assimilation, and the enjoyments of the rights possessed by citizens of each, by the citizens of all the others. One of the main points is, that a patentee or proprietor of a trade-mark or design, will have a prior right of registration throughout the Union. This will protect him against being forestalled by dishonest agents. Regulations for the protection of patentable devices, designs and trade-marks, during international exhibitions are recommended. The convention proposes, also, to protect trade-names without registration whether they form part of a trade mark or not. 8 Am. Annual Cyclopædia, 1883, tit. Patents.

† From Carpmaels' edition. Add St. Domingo; Sweden, Norway, Turkey.

marks and trade-names, enjoy the advantages that their respective laws now grant, or shall hereafter grant, to natives.

Consequently, they shall have the same protection as the latter, and the same legal remedy against any infringement of their rights, subject to the fulfillment of the formalities and conditions imposed on natives by the internal legislation of each State.

ART. III. Subjects or citizens of States not forming part of the Union, who are domiciled or have industrial or commercial establishments in the territory of any of the States of the Union, shall be assimilated to the subjects or citizens of the contracting States.

ART. IV. Any person who has duly lodged an application for a patent, an industrial design or model, or trade or commercial mark in one of the contracting States, shall enjoy, for lodging the application in the other States, and reserving the rights of third parties, a right of priority during the terms hereinafter stated.

Consequently, a subsequent application in any of the other States of the Union before the expiration of these periods shall not be invalidated through any acts accomplished in the interval, either, for instance, by another application, by publication of the invention, or by the working of it by a third party; by the sale of copies of the design or model, or by the use of the mark.

The above mentioned terms of priority shall be six months for patents, and three months for industrial designs and models and for trade and commercial marks. The terms will be increased by a month for countries beyond the sea.

ART. V. The introduction by the patentee into the country where the patent has been issued of objects manufactured in any of the States of the Union shall not entail forfeiture.

Nevertheless, the patentee shall remain subject to the obligation to work his patent in conformity with the laws of the country into which he introduces the patented objects.

ART. VI. Every trade or commercial mark duly deposited in the country of its origin shall be admitted for registration, and protected in like manner in all the other countries of the Union.

The country where the applicant has his chief establishment shall be deemed the country of origin.

If this chief establishment is not situated in one of the countries of the Union, the country to which the applicant belongs shall be deemed the country of origin.

The deposit may be refused if the object for which it is solicited is considered contrary to morality or public order.

ART. VII. The nature of the goods on which the trade or commercial mark is used can, in no case, be an obstacle to the registration of the mark.

ART. VIII. A trade-name shall be protected in all the countries of the Union, without the necessity of registration, whether it form part or not of a trade or commercial mark.

ART. IX. All goods illegally bearing a trade or commercial mark or trade-name may be seized on importation into those States of the Union where this mark or trade-name has a right to legal protection.

The seizure shall be effected at the request of either the public prosecutor or of the interested party, pursuant to the internal legislation of each country.

ART. X. The provisions of the preceding article shall apply to all goods falsely bearing the name of any locality as indication of their place of origin, when such indication is associated with a trade-name either fictitious or assumed with fraudulent intent.

Any manufacturer or merchant engaged in the manufacture or sale of such goods, established in the locality falsely designated as the place of origin, shall be deemed an interested party.

ART. XI. The high contracting parties agree to grant temporary protection to patentable inventions, to industrial designs or models, and trade and commercial marks, for articles exhibited at official or officially recognized international exhibitions.

ART. XII. Each of the high contracting parties agrees to establish a special department for industrial property, and a central office for the communication to the public of patents, industrial designs or models, and trade and commercial marks.

ART. XIII. An international office shall be organized under the name of the "Bureau International de l'Union pour la Protection de la Propriété Industrielle."

This office, the expense of which shall be defrayed by the governments of all the contracting States, shall be placed under the high authority of the Central Administration of the Swiss Confederation, and shall work under its supervision. Its functions shall be determined by agreement between the States of the Union.

ART. XIV. The present convention shall be submitted to periodical revisions, with a view to introducing improvements calculated to perfect the system of the Union.

To this end conferences shall be successively held in one of the

contracting States by delegates of the said States. The next meeting shall take place in 1885 at Rome.

ART. XV. It is agreed that the high contracting parties respectively reserve to themselves the right to make separately, between themselves, special arrangements for the protection of industrial property, in so far as such arrangements do not contravene the provisions of the present convention.

ART. XVI. States which have not taken part in the present convention shall be permitted to adhere to it at their request.

Such adhesion shall be notified officially through the diplomatic channel to the Government of the Swiss Confederation, and by the latter to all the others. It shall imply complete accession to all the clauses, and admission to all the advantages stipulated by the present convention.

ART. XVII. The execution of the reciprocal engagements contained in the present convention is subordinated, in so far as necessary, to the observance of the formalities and rules established by the constitutional laws of those of the high contracting parties who are bound to procure the application of the same, which they engage to do with as little delay as possible.

ART. XVIII. The present convention shall come into operation one month after the exchange of ratifications, and shall remain in force for an unlimited time, till the expiration of one year from the date of its denunciation.

This denunciation shall be addressed to the government commissioned to receive adhesions. It shall only affect the denouncing State, the convention remaining in operation as regards the other contracting parties.

ART. XIX. The present convention shall be ratified, and the ratifications exchanged in Paris, within one year at the latest.

ON THE SIGNATURE OF THE CONVENTION THE PLENIPOTENTIARIES
AGREED AS FOLLOWS:—

1. The words "industrial property" shall be understood in their broadest sense; they are not to apply simply to industrial products properly so called, but also to agricultural products (wine, corn, fruits, cattle, &c.), and to mineral products employed in commerce (mineral waters, &c.).

2. Under the word "patents" are comprised the various kinds

of industrial patents recognized by the legislation of each of the contracting States, such as patents of importation, patents of improvement, &c.

3. The last paragraph of article II. of the Convention does not affect the legislation of each of the contracting States as regards the procedure to be followed before the tribunals, and the competence of those tribunals.

4. Paragraph 1 of Article VI. is to be understood as meaning that no trade or commercial mark shall be excluded from protection in any State of the Union, from the fact alone that it does not satisfy, in regard to the signs composing it, the conditions of the legislation of that State ; provided that on this point it comply with the legislation of the country of origin, and that it had been properly registered in the said country. With this exception, which relates only to the form of the mark, and reserving the provisions of the other articles of the convention, the internal legislation of each State remains in force.

To avoid misconstruction, it is agreed that the use of public armorial bearings and decorations may be considered as being contrary to the public order in the sense of the last paragraph of article VI.

5. The organization of the special department for industrial property mentioned in article XII., shall comprise, so far as possible, the publication in each State of a periodical official paper.

6. The common expenses of the international office, instituted by virtue of article XIII., are in no case to exceed each year a total sum representing an average of 2,000 fr. for each contracting State.

[Here follows directions for classifying the States and assessing expenses upon them, proportionately.]

The Swiss government will superintend the expenses of the international office, advance the necessary funds, and render an annual account, which will be communicated to all the other administrations.

The international office will centralize information of every kind relating to the protection of industrial property, and will bring it together in the form of a general statistical statement which will be distributed to all the administrations. It will interest itself in all matters of common utility to the Union, and will edit, with the help of the documents supplied to it by the various administrations, a periodical paper in the French language, dealing with questions regarding the object of the Union.

The numbers of this paper, as well as all the documents published by the international office, will be circulated among the administrations of the States of the Union in the proportion of the number of contributing units as mentioned above. Such further copies as may be desired, either by the said administrations or by societies or private persons, will be paid separately.

The international office shall at all times hold itself at the service of the members of the Union, in order to supply them with any special information they may need on questions relating to the international system of industrial property.

The administration of the country in which the next conference is to be held will make preparation for the transactions of that conference, with the assistance of the international office.

The director of the international office will be present at the meetings of the conferences, and will take part in the discussions but without the privilege of voting.

He will furnish an annual report upon his administration of the office, which shall be communicated to all the members of the Union.

The official language of the international office will be French.

7. The present final protocol, which shall be ratified together with the convention concluded this day shall be considered as forming an integral part of, and shall have the same force, validity, and duration as the said convention.

From Carpm. Pat. L. of World, 653.

See also GREAT BRITAIN AND IRELAND.

APPENDIX OF RECENT LAWS.

[The following laws have been obtained since the first volume of the work was all in type. They are from the collection of Patent Laws, of W. E. RICHARDS.]

ARGENTINE REPUBLIC.

Provisional Regulations of the Patent-Office.

“Provisional regulations of the patent-office in the Argentine Republic” contain some directions which are of interest to residents of foreign countries, as showing the proper methods of conducting correspondence with the patent-office ; *e. g.*:

NUMBER 5 prescribes that all correspondence shall be conducted in the name of the commissioner.

No. 6 provides that the office cannot give information as to applications, etc., but furnishes “only the following documents :” the law of Congress constituting the office, the decree of the National Government establishing it ; the quarterly reports or annual volumes ; the written descriptions ; the designs and specimens or articles for which patents have been granted.

No. 7 provides that “under no circumstances shall an employe or officer become a representative or agent for an applicant for letters patent.”

No. 8 regulates the appointment and substitution of agents or attorneys.

No. 9 directs the mode of preparing and sending applications

for letters patent, and the payments to be made, accompanying them.

Other regulations relate to the manner of preparing and transmitting models and specimens, and applications for designs ; also the ordinary course of procedure in the office.

ECUADOR.

Law of October 15, 1880.

The Congress of the Republic of Ecuador, after due consideration of the expediency of regulating the patent laws in such a manner as shall facilitate the obtaining of letters patent for useful inventions, and at the same time provide that the privileges granted shall not become a species of monopoly, has passed the following regulations.

ART. 1. The law secures to every inventor the full and entire use of his invention, provided it is not contrary to established laws and good customs.

ART. 2. The methods and instruments which may be invented or discovered for the improvement of a manufacture or industry, are themselves to be considered as inventions.

ART. 3. A contrivance which introduces only a slight modification (in the methods already known and practiced), or merely relates to objects of adornment, shall not be considered as an invention.

ART. 4. The State has right to purchase the secret of whatsoever invention or discovery which it may consider advantageous to the whole community.

ART. 5. To secure to an originator of an invention or an improvement, the exclusive use of his property, a privilege shall be granted to him for a term not under ten years, and not exceeding fifteen years.

ART. 6. Exclusive rights shall not be granted to inventors of secret remedies ; it being the duty of the inventor to make them known for a reasonable compensation.

ART. 7. Importers of machines and of new methods and processes in the useful arts which are not already known and practiced in

the republic, shall be entitled to exclusive right, to be obtained conformably to the following rules.

ART. 8. If the introduction of an imported machine or manufacturing process requires a preliminary outlay of 25,000 pesos, the term for the grant shall be three years ; if the outlay amounts to 50,000 pesos, the term shall be six years. If the expense reaches 100,000 pesos, the term shall be extended to ten years.

ART. 9. The right granted to importers of machines or new industrial processes which are already known and practiced abroad, shall be limited to the locality where the machine is put in operation, or to a territory or district sufficiently extensive to allow of their adequate carrying on.

REGULATIONS RELATING TO THE GRANTING OF A PATENT RIGHT.

ART. 10. The person who applies for a patent of whatsoever class or description, shall present to the Executive Department of the administration, a specification containing a description of the invention or improvement, reserving for himself the secret of his method, and the constituents, principles and instruments which he makes use of. His application must be accompanied by a specimen of the article or work produced by means of his invention or improvement.

ART. 11. When the privilege applied for relates to an importation, the specification shall be accompanied by drawings or models of the machine which he intends to introduce, and by a detailed account of the principle, methods and manipulations of the industry which he wishes to import into the territory of the republic ; he shall also present a sample of the product which he purposes to perfect.

ART. 12. The government shall thereupon appoint a commission of three competent persons to test the matter and to examine into the *modus operandi* or secret which constitutes the invention, improvement or importation.

ART. 13. This commission shall always be superintended, by the chief civil officer of the district where the patent right is to be exercised. If the right extends over the whole republic, this commission shall be presided over by the chief civil officer of the district where the application was made, and by the municipal council, who shall examine into the matters set forth in the preceding article.

ART. 14. Before the same presiding officer, two functionaries and the three commissioners appointed by the government, shall take oath not to disclose the secret, and explicitly declare that they shall faithfully perform their duties.

ART. 15. The commission and the two officials shall thereupon examine into the matter, in the absence of the interested party, and draw up an official report of the result, carefully recording any difference of opinion or views that may arise between the individuals of the commission.

ART. 16. The report referred to in the preceding article shall then be remitted to the ministry of the interior, with a notice on the envelope that the enclosed document or communication is of a *reserved* description. The document shall be accompanied by the description of the method, machines, &c., which constitute the invention, improvement or importation.

ART. 17. Within three weeks, at the most, after the receipt of the report of the commission appointed to examine into the invention, improvement or importation of a new manufacturing process, the government shall issue the respective letters patent on stamped paper, and give order for the sealing up and preservation in the ministry of the interior, of the package containing the report mentioned in the 11th article.

ART. 18. To avoid an improper use of the privilege accorded, the government shall expressly state in the letters patent, that it does not in any way guarantee the importance, merit or usefulness of the invention, improvement or importation; the entire accountability remaining solely with the patentee.

ART. 19. The patentee who desires to make a modification in his invention, or in his first application, before he has obtained letters patent, or after such have been granted, must present a written declaration, accompanied by a description of the new method, according to the directions given in the 10th article. A mere modification in the letters patent will not, however, entitle the patentee to a prolongation of the term originally granted.

RIGHTS OF THE PATENTEE.

ART. 20. The patentee has exclusive right to utilize the invention, improvement or importation for which letters patent were granted.

ART. 21. The patentee has right to do business in every part of

the republic, if the grant is not limited to a certain place or district. He can also authorize other persons to apply and utilize the methods with the same right as himself, and to dispose of them as with movable property.

ART. 22. The patentee can also assign his right, in part or in its entirety, by means of a public document which must be duly recorded by the proper authorities, at the risk of forfeiting his privilege.

ART. 23. If doubt or uncertainty should arise, respecting the priority of two applications for letters patent, the matter shall be settled by a certificate from the sub-secretary of the interior who has in charge the recording of the date and hour when similar applications were filed.

TERM OF THE PRIVILEGE.

ART. 24. The term granted for the utilization of an invention, improvement and importation, commences with the date of the letters patent.

ART. 25. The respective privileges granted to the patentee by the government, shall be recorded in a special register at the ministry of the interior. The original application, specification and other documents mentioned in the 10th article, shall also be deposited with the same authority, until the expiration of the term.

ART. 26. The granting of the patent right shall be officially communicated by the ministry of the interior to the provincial governors, and be published in the official journal. The grant shall also be registered in the collection of laws and decrees.

RIGHTS OF THE STATE AT THE EXPIRATION OF THE TERM.

ART. 27. When the term fixed for the working of the invention, improvement or importation expires, the new process or industrial method becomes the property of the community.

ART. 28. At the expiration of the term, the application, the description and the other documents referred to in the 10th article shall be published and deposited in the public library of the capital of the republic.

ART. 29. If from any of the causes specified by this law, the privilege becomes void or forfeited, a similar publication and deposition shall be made, and with the same effect as stated in the 27th article.

ART. 30. The government shall give orders relating to the printing of the specifications and the making of models and drawings, necessary to explain the processes which may become public property. A sufficient number of copies shall be sent to the provincial governors.

THE PROTECTION GUARANTEED TO THE PATENTEE AGAINST
INFRINGEMENTS.

ART. 31. On presenting reliable and sufficient security, the patentee has a right to apply for an interim injunction for the immediate seizure, conformably to the prescribed order of the law, of the machines, instruments and products which are being used in violation of his privilege.

ART. 32. The party who is found guilty of infringement shall be subjected to the confiscation of the sequestered goods, which devolve to the patentee. The guilty party shall, moreover, pay an indemnification for the loss and injury which he has occasioned, proportionate to the extent of the infringement.

ART. 33. If the infringement cannot be proved, the plaintiff shall be sentenced to pay the damages occasioned by the seizure to the defendant, and also to pay a pecuniary penalty equal in amount to that which would have been imposed upon the defendant, if he had been proved guilty of the infringement.

ART. 34. When the patentee is obstructed by any party in the free exercise of his right, he can apply for redress at the ordinary courts of justice. Should any objection or charge be made against (or relating to) the validity or illegality of the privilege, the matter shall be placed before the administrative tribunal in the ministry of the interior.

ART. 35. In case there is an absolute similarity between two inventions, and uncertainty and dispute arise between the patentees relating to their respective rights, the precedence shall be adjudged to the holder of the letters patent earliest granted.

ART. 36. The "posterior" patentee shall in this case be considered as the perfecter of the invention.

PROTECTION OF THE STATE AGAINST ABUSES ON THE PART OF
PATENTEES.

ART. 37. Patent rights are void, if granted for an invention, improvement or importation which the civil authorities shall con-

sider contrary to the laws of the State or the public safety, and the regulations of the police. The patentee in such contingencies loses also his claims for indemnification.

ART. 38. The privilege granted becomes void and null, not only under the circumstances already specified, but also in the following cases :

1. When it is proved that the inventor has concealed in his description, the actual means of which he makes use in working his process.

2. When it is proved that the inventor has employed secret methods which were not specified either in the description, or in the subsequent declaration (memorandum of alteration) referred to in the 19th article.

3. When it is proved that the inventor (or he who calls himself so) has obtained his privilege for an invention already described and published by the press, within or outside the republic.

4. When the patentee has allowed one year and one day to elapse from the date when the letters patent were granted, without having put his invention into operation, or brought forward any legally valid reasons for his omission.

5. When the inventor or his assignee, under whatsoever pretense, acts contrary to the obligations connected with the use of the privilege.

ART. 39. In all cases of forfeiture and nullification of the privilege, the disposition stated in the 27th article shall be applicable.

ART. 40. It is the duty of the patentee to declare himself willing to obey and submit to the laws of the country under all circumstances. With regard to the privilege conferred upon him, he must explicitly renounce all diplomatic interference or influence.

ART. 41. All persons to whom privileges have been granted in the republic are subject to the provisions of the present law with regard to the expiration of terms and forfeiture of rights.

The Executive Department has in charge to publish this law, and watch over its observance and proper execution.

NATAL.

Proclamation of January 12, 1872.

Whereas, by Law No. 4, 1870, entitled Law "To provide for the granting in this Colony of Patents for Inventions," it is enacted that it shall be lawful for the Lieutenant Governor, with the advice of the Executive Council, to make rules and regulations for carrying out said law :

Now therefore, I do, under and by virtue of the provisions of the said Law No. 4, 1870, and with the advice of the Executive Council aforesaid, proclaim the following rules and regulations thereunder, that is to say :—

1. Every application for letters patent and every title of invention and provisional specification, must be limited to one invention only.

2. The title of the invention must point out distinctly and specifically the nature and object of the invention.

3. Every provisional protection of an invention shall be forthwith advertised by the applicant in the Natal Government Gazette ; and the advertisement shall set forth the name and address of the applicant, the title of the invention, and the date and deposit of provisional specification in the attorney-general's office.

4. In each case the notice of the applicant of his intention to proceed for letters patent for his invention shall be left at the office of the attorney-general eight weeks at least before the expiration of the term of provisional protection thereon, and no notice to proceed shall be received unless the same shall have been left in the said office eight weeks at the least before the expiration of such provisional protection : Provided always that the attorney-general may, upon special circumstances, allow a further extension of time on being satisfied that the same has become necessary by accident, and not from the neglect or willful default of the applicant or his agent.

5. No warrant will be issued for the granting of letters patent for two or more distinct substantive inventions combined.

6. The office of the registrar of the Supreme Court has been, and is, appointed the office to which the attorney-general is to transfer specifications, drawings, &c., for safe custody in terms of said law.

7 and 8 make it the duty of the registrar of the Supreme Court to keep the Register of Patents, Register of Proprietors, Indices to Specifications, Disclaimers, and Memoranda of Alterations, open to inspection by the public, subject to payment of fees ; and to collect fees for copies of writings before giving out such copies.

Act No. 32, 1884.

Enacted by the Governor, with the advice and consent of the Legislative Council, November 8, 1884.*

1. The thirty-eighth section of Law No. 4, 1870, shall be and the same is hereby repealed ; and it is hereby further enacted that from and after the date of the promulgation in this colony of the Order in Council referred to in section 104 of the Patents, Designs, and Trade-Marks Act, 1883, all letters patent granted in the United Kingdom of Great Britain and Ireland shall be deemed and taken to be granted under the provisions of Law No. 4, 1870, and may be dealt with accordingly : Provided that this law shall only apply to patents granted for inventions in the said United Kingdom, and not to designs or trade-marks.

2. This law shall come into operation from and after the date of the promulgation in the Natal Government Gazette of the order in Council referred to in section 1 hereof, and shall be read and construed together with Law No. 4, 1870, as one law.

ORANGE FREE STATE.

Act No. 12, 1884.

The Parliament of the Orange Free State, considering it necessary to issue general orders whereby sole privileges are granted to inventions, promoting art and industry, has resolved and does hereby resolve :

ARTICLE 1. Sole privileges may be granted, for a certain termination, through the President of State, after consultation with and

* Preambles recite that this act was passed in order to obtain the benefit of section 103 of the British Patents, Designs and Trade-Marks Act of 1883, Stat. 46 and 47 Viet. c. 57 ; for which see Vol. 1, *ante*, p. 244.

consent of the Executive Council, on any kind of inventions and improvements, useful to art and industry ; and this be done by open letters, named *octroys* (patents), after written application for the same has been furnished to the President of State.

ART. 2. These patents shall be given without regard to right or ownership, and shall then be void, whenever it is seen that the object of the invention or improvement has already, before the granting of applicant's patent, been given, planned or carried into effect by an other party within this State.

ART. 3. Patents shall be granted for a period of five, ten or fifteen years, and a tax therefor be paid to the Treasury, in accordance with the termination and the more or less privileges belonging to same, which must never be higher than £750, or amount to less than £150.

These privileges shall be separately fixed for each application by the executive authority.

ART. 4. A patent granted for a period of five or ten years may also by the expiration of such term, be prolonged whenever very important reasons advise the same, on such conditions as herein explained ; though never for the duration of more than altogether 15 years.

ART. 5. The granting of patents on first introduction, or of patents on inventions or considerable improvements, worked or being worked out by foreigners, shall, in case they are already protected or patented, be given for no longer period than the duration of the granted exclusive right, and expressly upon condition of the granted exclusive right, and expressly upon condition of the patented object being made use of within this State.

ART. 6. The patents give to the proprietors or their lawful attorneys, the following preferences : *a.* Exclusive right to use and sell during the ordered period the patented invention over the entire State. *b.* The right to prosecute by civil action those infringing that exclusive right ; and to proceed against them for the purpose of having declared forfeited all manufactures yet unsold, for the sale price of the patented objects already sold, and for any further damages for loss of profits, and interest, to which he may show himself entitled.

ART. 7. In making application, the applicant shall be obliged to furnish a distinct, specific, sealed description drawn by himself, of the secret connected with the patent : together with the plans, drawings, calculations, etc.; which description, after the expiration

of the original or prolonged termination of patent, or on its expiration within the term from any of the herein mentioned causes, shall be made public, unless important reasons may compel the government to dispense with this publication.

ART. 8. A patent shall be declared void from the following reasons: *a.* Whenever it shall be seen that the patentee in his application has with fraudulent intentions omitted points or falsely explained the same. *b.* Whenever it shall be seen that the matter in reference to which a patent is applied for, has already, before the granting of the same, been published in some printed work. *c.* Whenever the owner within a term of two years from the dating of the patent granted him, has made no use of same; except from important reasons, to be decided by the executive authorities. *d.* Whenever the owner of a patent, on acquiring the same, has already been granted exclusive rights in another country for the same object. *e.* Whenever it shall be seen that the object of a patent, used according to its principles, will oppose the safety of the State or its inhabitants.

ART. 9. The forfeiture of a patent mentioned in the preceding article shall be declared through the president of State and with consent of the executive council, when the patent owner has been informed.

ART. 10. The forfeiture of a patent shall be published at the cost of the owner in the Government Courant and in the different newspapers of the State, by the secretary of the government; which publication in the Government Courant shall form a sufficient proof in court.

ART. 11. A proper register of patents granted shall be sent to the government office through the secretary of the government; and every patent, therein mentioned, shall be signed by the president of State and the government-secretary.

ART. 12. No application for the granting of a patent shall be taken into consideration before at least six weeks have passed after notice of such application has been made public in the Government Courant.

PERU.*Translation of the Patent Laws.*

ARTICLE 1. Every discovery or invention, in whatever branch of industry, gives to the inventor the exclusive right to use it to his benefit ; under the conditions and for the time determined by this law. This right will be judicially conceded in the deed of patent granted by the Government.

ART. 2. The following will be considered as inventions or discoveries : (1) New industrial products. (2) New methods, or new applications of existing methods, for obtaining an improvement in industrial products.

ART. 3. In the patents granted, the following will be excepted : (1) Pharmaceutical preparations, and remedies of every description. (2) All projects for financial operations. (3) All operations to improve known industries the use of which is free, both in and out of the republic.

ART. 4. In the third clause of the last article, only proposals relating to contracts permitted by law, will be permitted. Said contracts to be adjudged by public auction.

ART. 5. No patent will be granted for a greater term than 10 years ; and any one obtaining a patent shall pay one hundred dollars per annum, which sum shall be applied to the Public Works Fund of the province in which the patent may be used.

ART. 6. All persons soliciting patents or the introduction of inventions from other countries shall be required to present themselves to the prefect of the department in which they intend to make use of the invention, or in case of the patent extending over one or more departments, to the prefect of the department in which the petitioner may reside.

ART. 7. The petition shall contain : (1) A description of the invention or improvement proposed. (2) Plans or models descriptive of the same. (3) An inventory and description of the models presented. (4) A clear and correct explanation of the main object of the patent, with all its details and indication of its appliances. (5) The term for which the patent is asked. (6.) The description of security offered for the proper carrying out of the invention.

ART. 8. The petition shall be clearly written in the Spanish lan-

grage, and all numbers, weights and measures to be those in use in the republic. If one of the petitioners shall be a foreigner, the petition must contain a clause expressly renouncing all diplomatic intervention, in the event of there arising any question relative to the patent solicited; and that such question shall be submitted absolutely and exclusively to the laws and courts of the republic. Without this clause no proposal will be entertained.

ART. 9. The prefect and municipal corporation, will consult the fiscal, or agent of the fiscal, and the other functionaries, to which the class of patent may pertain, and will also hear the judgment of the experts, if necessary; after the above formulas, and respective report, the plans, models, etc. will be passed to the ministry at the expense of the supplicant.

ART. 10. The minister to whom this branch of privilege appertains, will consult the fiscal of the Supreme Court and the various offices through which he may deem fit to refer it.

ART. 11. The extension of a privilege or any modification or alteration of the same, can be given, only by a vote of the Legislature, on the solicitation of the interested parties showing good reasons and documents why such should be conceded.

ART. 12. The patentee is the only person allowed to make use of the patent during the time conceded. Any other person using the same will require a deed of transfer or other form expressed by law.

ART. 13. All patents shall be considered null and void: (1.) If the discovery or application is not new. (2.) If they are not comprehended in the provisions of Art. 2. (3.) If based on principles, methods, systems, discoveries, theories, or sciences, whose application to the industries have not been specified. (4.) If the discovery, invention, or application should be contrary to the public order, the public security, or the laws; without prejudice in such case, to the fines against the manufacture or sale of prohibited articles expressed by law. (5.) If any fraud be discovered, on the part of the patentee, to obtain, under his patent, any object distinct from the true invention. (6.) If on putting in practice the invention, it should be found not to conform to the description that accompanied the application for same. (7.) If the patent has been obtained otherwise than in conformity with the above laws. (8.) If on giving the concession of the patent any pecuniary subversion should be conceded, or other special concession contrary to the laws, that is not embraced in the Budget of the republic.

Any grant shall also be declared null and void which refers to changes, improvements, or additions to concessions, that are not expressed in the original application for the patent.

ART. 14. Any discovery, invention, or application, either in Peru or any foreign country, that may exist, anterior to the date of application, and which shall have had sufficient publicity to have been put into use, will not be considered as new.

ART. 15. The patent will forfeit all its rights: (1.) If the yearly tax or amount stated in Art. 5 is not paid. (2.) If the discovery or invention shall not be put into use within the term of two years or in the term expressed in the patent, unless the cause of its detention can be legally justified. (3.) If articles manufactured in foreign countries should be introduced similar to those patented by the patentee, with the exception, only, of models of machinery whose introduction shall be authorized, after formal inspection, by the government.

ART. 16. Any person that by advertisement, prospectus, placard, mark or stamp, claiming to himself the title of patentee, without legally holding a patent, or after the patent has expired, will be fined 50 to 1000 soles without exempting him from the penalties against the crime of fraud.

ART. 17. Any person who may consider himself lawfully interested, has the right to solicit the nullity or cessation of a patent; in which case the fiscal will intervene, and should the patent be declared null and void, whatever may be the cause, he will give due notice through the proper person, to the respective office.

ART. 18. Every infringement on the right of a patent, be it for the manufacture of products, or the employment of means embraced in the patent, constitutes the crime of fraud; and will be prosecuted according to the gravity of the case, with a fine in favor of the party interested, and the confiscation of the industry or manufacture falsified.

ART. 19. Any exclusive concessions or patents that may exist at the present date, and that may have been given in compliance with former laws, will retain their rights for the full term conceded.

TASMANIA.

Law No. 2, of October 20, 1884.

AN ACT to make provision for the mutual protection of patents for inventions and trade-marks granted or registered in Tasmania or the United Kingdom.

Whereas, by section 104 of the act of the Imperial Parliament to amend and consolidate the law relating to patents for inventions, registrations of designs and of trade-marks, known as the "Patents, Designs and Trade-Marks Act, 1883," provision is made whereby it is rendered lawful for her Majesty, where it is made to appear that the legislature of any British possession has made satisfactory provision for the protection of inventions, designs and trade-marks patented or registered in England, by order in Council to apply the provisions of section 103 of said act, with such variations or additions, if any, as to her Majesty in Council may seem fit, to such British possession.

And whereas it is expedient that the legislature of Tasmania should make such provision as aforesaid,

Be it therefore enacted : &c., &c.

1. In this act "the said acts" mean "the patent law act" and "the merchandise marks act, 1864."

2. (1.) Any person who has applied for protection for any invention or trade-mark in the United Kingdom shall be entitled to a patent for his invention, or to registration of his trade-mark, (as the case may be,) under the said acts, in priority to other applicants ; and such patent or registration shall have the same date as the date of the protection obtained in the United Kingdom : Provided, That his application is made, in the case of a patent, within seven months, and in the case of a trade-mark within four months, from his applying for protection in the United Kingdom : Provided, That nothing in this section contained shall entitle the patentee or proprietor of a trade-mark to recover damages for infringements happening prior to the date of the actual acceptance of his complete specification or the actual registration of his trade-mark in Tasmania, as the case may be.

(2.) The publication in Tasmania during the respective periods aforesaid of any description of the invention, or the use therein

during such periods of the invention, or the use therein during such periods of the trade-mark, shall not invalidate the patent which may be granted for the invention or the registration of the trade-mark.

(3.) The application for the grant of a patent or the registration of a trade-mark under this act must be made in the same manner as an ordinary application under the said acts, and shall be subject to the payment of the same fees: Provided, That in the case of trade-marks, any trade-mark the registration of which has been duly applied for in the United Kingdom may be registered under the merchandise marks act, 1864.

This act shall not come into operation until her Majesty shall, by order in Council, apply the provisions of section 103 of the patents, designs and trade-marks act, 1863, to Tasmania, with such variations or additions, if any, as to her Majesty in Council may seem fit; but this act shall thereafter come into operation as soon as such order in Council shall have been publicly made known in the colony.

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